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RULE 29(c) STATEMENT OF *AMICUS CURIAE*
ROBERTA J. MORRIS, ESQ., PH.D.

Identity: Roberta J. Morris, Esq., Ph.D., is a lecturer on patent law and related subjects. She was an adjunct professor at the University of Michigan Law School from 1991 to 2005 and a lecturer at Stanford Law School from 2006 to 2007. She will be at Stanford again in Fall 2008. Her law degree is from Harvard and her Ph.D. in Physics is from Columbia. She is a member of the patent bar and of the bars of New York and Michigan. She has practiced law at several firms, including the patent litigation firm of Fish & Neave (now Ropes & Gray) where she was an associate from 1986 to 1990. Following this Court's decision in *State Street v. Signature*, she was a speaker at Practising Law Institute conferences on business method patents.

Interest in the Case: Morris has no stake in this case; her interest in it lies in the opportunity it provides to make patent law more sane; better able to serve the needs of the public, including inventors, businesses, and consumers; and more worthy of the respect and support that every part of our legal system deserves.

Authority to File: This Court's order of February 15, 2008 setting this case for rehearing en banc invited the filing of amicus briefs without leave of court, so no motion has been filed.

RESPONSES TO THE COURT'S QUESTIONS

The five questions posed by this Court for supplemental and amicus briefing when it ordered this case to be reheard en banc (*In re Bilski*, No. 2007-1130 slip op. (Fed Cir. Feb. 15, 2008)), and the responses of this amicus, are as follows:

"Question 1. Whether claim 1 of the 08/833,892 patent application claims patent-eligible subject matter under 35 U.S.C. § 101?"

Response: YES.

"Question 2. What standard should govern in determining whether a process is patent-eligible subject matter under section 101?"

Response: The standard of "patentable-eligible subject matter" for processes, as for other forms of inventions, should encompass "anything under the sun that is made by man." *Diamond v. Chakrabarty*, 447 U.S. 303, 315 (1980). Whether a patent ought not to be granted as a matter of public policy -- the true reason for seeking a subject matter requirement in the simple words of the Constitution, Art. 1, sec. 8, cl. 8, and 35 USC § 101 and predecessor statutes going back to the Statute Of Monopolies of 1623 -- should be considered only after the requirements of 35 U.S.C §§ 102, 103 and 112 are determined to have been met. That way (1) the United States Patent and Trademark Office ("the Patent Office") and the courts will need

to consider far fewer claims under 101; (2) applicants will have the opportunity to craft valid claims, thus often overcoming problems with claiming "abstract ideas;" and (3) the Patent Office and the courts will not waste time, money and effort grappling with claims that could not survive examination for validity. Instead, all concerned can focus on articulating the standards for any needed public policy prohibition against otherwise patentable inventions.

The suggestion in *Parker v. Flook*, 437 U.S. 584, 593 (1978), and most recently followed by this Court in *In re Comiskey*, 499 F.3d 1365, 1371 (Fed. Cir. 2007), that the Patent Office must address Section 101 as a threshold issue, arises from a misunderstanding of the Constitutional patent provision and ignores Supreme Court cases since *Flook*, particularly the careful commentary found in *Diamond v. Chakrabarty*, 447 U.S. 303, 315-316 (1980). (See below, p. 18)

"Question 3. [a] Whether the claimed subject matter is not patent-eligible because it constitutes an abstract idea or mental process; [b] when does a claim that contains both mental and physical steps create patent-eligible subject matter?" [bracketed letters added]

Response: [a] The claimed subject matter IS patent-eligible; and
[b] Assuming the claim meets the requirements of 35 U.S.C. §§ 102, 103 and 112, ALWAYS.

Sections 102, 103 and 112 of the patent statute sections will invariably invalidate claims that are no more than abstract ideas or mental processes because either (a) such claims will read on vast amounts of prior art going back to the beginning of time; or (b) such claims will not be supported by a specification that enables ordinary artisans to make and use the abstract idea or mental process; or both.

"Question 4. Whether a method or process must result in a physical transformation of an article or be tied to a machine to be patent-eligible subject matter under section 101?"

Response: NO, provided the claim to that method or process meets the requirements of 35 U.S.C §§ 102, 103 and 112. A claim that does not explicitly recite a physical transformation or machine is likely to be invalid for reasons similar to those mentioned in Response 3.

"Question 5. Whether it is appropriate to reconsider *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998), and *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), in this case and, if so, whether those cases should be overruled in any respect?"

Response: NO. Neither case needs to be reconsidered nor overruled.

ARGUMENT

Amicus Roberta J. Morris, Esq., Ph.D. respectfully submits that the Board's decision affirming the "patentable subject matter" rejection of the

claims of SN 08/833,892 of inventors Bernard L. Bilski and Rand A. Warsaw, *Ex Parte Bilski*, No. 2002-2257 (Bd. Pat. App. & Int. 2006) should be reversed so that the Examiner can consider whether the requirements of 35 USC §§ 102, 103 and 112 ("102, 103 and 112") are met. If any claims survive unamended, they will then be ripe for consideration of 35 U.S.C. § 101 ("101"). If they are abandoned or amended, the § 101 issue will likely disappear.

I. THE "PATENTABLE SUBJECT MATTER" INQUIRY IS A DIVERSION AND A DISTRACTION FROM THE REAL BUSINESS OF THE PATENT OFFICE AND THE PATENT SYSTEM

The question of "patentable subject matter" is a diversion and distraction from what the United States Patent and Trademark Office (the "Patent Office") is supposed to do, and what it should do.

A. The Patent Office's Special Expertise

The Patent Office's special expertise is in understanding inventions and comparing them to the prior art. Congress recognized this when in 1979 it enacted the reexamination statutes, 35 USC §§ 301-307 (see 126 Cong. Rec. 29,895 (1980)), as noted by this Court in *Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 601-602 (Fed. Cir. 1985).

Examiners must have a technical background to apply for their jobs.

(See "Patent Examiner Positions," Part 3. Qualification Requirements, <http://www.uspto.gov/web/offices/pac/exam.htm> (last visited April 3, 2008).) Once hired, they learn at the Patent Academy and on the job how to find prior art which may anticipate or render obvious an applicant's claims. (*Ibid.*, Part 4. Responsibilities, Training and Advancement.) By focusing on the questions of validity over the prior art and the adequacy of the inventor's disclosure to the public, the Patent Office employs its special expertise.

By contrast, what constitutes patentable subject matter under 101 is a philosophical and abstract inquiry, unrelated to the essential question "What did applicants invent?" (*see, e.g.*, Manual of Patent Examining Procedure § 2106 (8th ed., Rev. 6, Sept. 2007)), and to what the prior art teaches. If the Patent Office must consider 101, then from the point of view of both reason and efficiency, it should do so only after the claims are in condition for allowance under 102, 103 and 112. This would greatly reduce the number of cases where patentable subject matter is an issue. It would also improve the quality of the debate: just as bad cases make bad law, bad patent claims make bad rules about what should, in the abstract, be patentable.

B. Patentable Subject Matter's Deceptive Charm

1. Avoiding the Technology

The "patentable subject matter" inquiry has a certain attraction for

some patent examiners as well as journalists, academics and others: it can be argued in a vacuum, without needing to grapple with the technology. But understanding the technology, scrutinizing the claim language, and comparing the claims to the prior art, is the heart of patent law.

2. Ignorance of Basic Patent Law

When people who are not well versed in patent law, whether they are new examiners, law students, judges or justices, confront a broad patent claim, they cast around for a legal concept to express their unease that the claim might issue or be enforced. "Patentable subject matter" is often the straw at which they grasp. People with a solid knowledge of patent law instead respond with the basic patent validity issues: anticipation, obviousness, lack of enablement, lack of written description, or failure to particularly point out and distinctly claim what the applicants regarded as their invention ("indefiniteness"). These doctrines from 102, 103 and 112 are adequate to the task of dealing with overly broad claims.

C. The Haphazard and Unfair Effects of 101 Jurisprudence

For the last 35 years, there have been many judicial and agency attempts to employ the concept of "patentable subject matter" to prevent inventors of software or business methods from obtaining the limited exclusivity to their discoveries that other inventors receive under the

Constitution. These attempts have suffered in part from the fact that they were formulated based on claims that were invalid under 102, 103 and 112. Like a guillotine for a headache, the cure was worse than, and certainly out of proportion to, the disease. Administrative Patent Judge Barrett in his concurrence-in-part/dissent-in-part in *Ex Parte Lundgren*, 76 USPQ2d 1385, 1393 (Bd. Pat. App. & Int. 2006) recognised the difficulties with the law:

"Statutory subject matter is a complicated issue and the caselaw over the last 35 years has not been consistent in part due to broad pronouncements that, while sensible in the context of the facts of each case, proved to be ambiguous when applied to more general process claims. Therefore, the cases and tests cannot be completely reconciled."

Despite or because of these unreconcilable tests, patents to software processes have been and continue to be issued. Each test became, not a barrier and not a trap for the unwary, but a trap for the unpersevering, the unclever, and the unlucky.

The lucky, clever, persevering ones should not, however, be denigrated as having "gamed the system." Lawyers have an obligation to their clients to use the law, in all its contradictions, inconsistencies, incomprehensibilities and sheer foolishness, to assist their clients. Otherwise the lawyers are not living up to their professional responsibilities.

It is wrong to drive a truck through a loophole, but the state of 101 jurisprudence created not loopholes but a black hole.

II. BASIC PATENT LAW REQUIREMENTS CAN MOOT THE PATENTABLE SUBJECT MATTER QUESTION

The Supreme Court has often stated that laws of nature, physical phenomena and abstract ideas cannot be patented. (*see, e.g., Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) . A claim drawn only to one of those excluded categories is, however, invariably invalid because it is indefinite, not new, obvious, not enabled, or inadequately supported in the specification. The same infirmities plague claims that supposedly fail any of the various tests devised by the Supreme Court, this Court and its predecessors to limit further the concept of "patentable subject matter."

A. History

Cases that are cited to support patentable subject matter exclusions often address that subject in dicta, while the holdings involve basic concepts of validity.

- In *O'Reilly v. Morse*, 56 U.S. 62 (1853), most of Morse's claims to the telegraph were upheld, but the one whose invalidity is often cited for the proposition that abstract ideas cannot be patented was, in today's parlance, held not enabled. This was a genus claim to "the use of ... electro-

magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances" Morse had enabled the species claims with his telegraph, but not the broad genus claim. (Cf., *In re Goodman*, 11 F.3d 1046, 1050 (Fed. Cir. 1993).)

- *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. 498, 507 (U.S. 1874) provides another example. In *In re Comiskey*, 499 F.3d 1365, 1376 (Fed. Cir. 2007), this Court quoted only the first phrase of the decision's last paragraph. The complete passage, however, shows that the statement about the unpatentability of ideas is dicta; the holding was for lack of novelty:

"An idea of itself is not patentable, but a new device by which it may be made practically useful is. The idea of this patentee was a good one, but his device to give it effect, though useful, was not new. Consequently he took nothing by his patent." (emphasis added)

- In *Parker v. Flook*, 437 U.S. 584, 593 (1978), what the Supreme Court did not like about the claims would more accurately be described as lack of enablement, not unpatentable subject matter (see below, pp. 19-20).

- In *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999), just six months after this Court reversed a summary judgment under 101, the trial court granted the infringer summary judgment of invalidity under 102 and 103. *AT&T Corp. v. Excel Communications, Inc.*, 52 U.S.P.Q.2d 1865 (D.Del. 1999).)

- In *In re Comiskey* itself, the Board had upheld the rejection of all the applicant's claims on the grounds of obviousness. This Court did not review that determination, however, because it chose to affirm the rejection on the alternate ground of lack of patentable subject matter. Had it affirmed the art rejections, and given the applicant the opportunity to prosecute allowable claims, 101 might not have been an issue for applicant Comiskey at all.

- The Business Method Prohibition Story: Ten years ago, when there was still controversy over whether "business methods" were per se unpatentable, this Court in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368 (Fed. Cir. 1998) reviewed the supposed precedents for the "doing business" prohibition and found them to be dicta, not holdings. (See 149 F.3d at 1375-6, especially footnote 15, citing Rinaldo Del Gallo III, *Are 'Methods of Doing Business' Finally Out of Business as a Statutory Rejection?*, 38 IDEA 403 (1998)). For example, the Manual of Patent Examining Procedure through its Sixth Edition (January 1995) cited two cases in support of the business method prohibition (see Roberta J. Morris, *Business Method Patents: Old or New, Good or Bad*, 609 PLI/Pat 95, 105 (2000)). The cases were *Hotel Security Checking Co. v. Lorraine Co.*, 160 F. 467 (2 Cir. 1908) and *In re Wait*, 73 F.2d 982 (CCPA 1934), and both in fact were decided on grounds of lack of newness:

This question [whether a new and useful system of cash-registering and account-checking is such an art as is patentable under the statute] seems never to have been decided by a controlling authority and its decision is not necessary now unless we find that Hicks has made a contribution to the art which is new and useful. We are decidedly of the opinion that he has not [W]e are convinced that there is no patentable novelty either in the physical means employed or in the method described and claimed in the Hicks patent." *Hotel Security*, 160 F. at 472 (emphasis added).

"Surely these [the steps of applicant Wait's claimed process:

'1. The process which comprises posting an offered figure for a commodity causing the figure to be visible at a remote point, contacting the stations of a buyer and a seller through a central point, causing such contact to be indicated at the point of posting and consummating a sale through such connection and removing said posted figure']

are, and have always been essential steps in all dealings of this nature, and even conceding, without holding, that some methods of doing business might present patentable novelty, we think such novelty is lacking here." *In re Wait*, 73 F.2d at 824. (emphasis added)

Interestingly, the observation that all the cases cited for business method unpatentability did so in dicta and never in holdings had been made in 1921 in an article in the Journal of the Patent Office Society. (Cf. Morris, 609 PLI/Pat at 112, citing Frank W. Dahn, *Methods of Doing Business*, 4 JPOS 85 (1921)). The business method cases after 1921 (such as *Wait*) were the same as the ones before 1921 (such as *Hotel Security*): dicta with broad philosophical pronouncements, and then a holding of invalidity because the invention was not new.

B. Logic

Claims that recite only an abstract idea will be anticipated by statements about that idea since the beginning of time. Claims like Morse's in *O'Reilly* (discussed above, pp. 9-10) that try to preempt an entire new field of endeavor, instead of sticking to what the inventor teaches how to do, are invalid for lack of enablement. Such claims should be examined and, if found wanting under 102, 103 and 112, can be amended or abandoned the same as claims to other inventions. If they do issue, they may never be asserted. If they are asserted, and the matter is not settled by negotiation, the patent claims can be invalidated in litigation just like any other patent claims, such as those for adjustable gas pedals. *Cf.*, *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007).

III. NEITHER THE CONSTITUTION NOR THE STATUTE SUPPORTS DISCRIMINATION AMONG INVENTORS BASED ON SUBJECT MATTER

A. The Constitution

The Constitution's patent provision, Art. I, sec. 8, cl. 8, gives Congress power "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The parallel construction is

understood as associating Science, Authors and Writings with copyright, and useful Arts, Inventors, and Discoveries with patents.

The law has rightly not chosen to freeze copyright protection to the 1789 conception of "science" (or for that matter, "writings") and it should not choose to freeze patent protection to the 1789 conception of "useful Arts." In both cases, the introductory statement of purpose in the Constitutional provision, "To promote Progress," is the key to understanding the whole.

Nothing in the Constitution's words suggests that the patent system should discriminate among "inventors" and their "discoveries" based on the subject matter of what they seek to patent. There is no subtext of exclusion in "useful Arts." Of the two evils -- patents of importation and patents protecting industry-wide monopolies -- mentioned in *Comiskey*, 499 F.3d at 1374-1375, the latter is squarely excluded already by the words "inventors" and "discoveries." Those words, not "useful Arts" may also have excluded the former, for all anyone knows. History is remarkably silent on this question. (see, e.g., Edward C. Walterscheid, *To Promote the Progress of Useful Arts: American Patent Law and Administration, 1798-1836* 126-128 (1998)).

Here, the Board of Patent Appeals said that "useful Arts" means

"technological arts" (*Ex Parte Bilski*, No. 2002-2257 (Bd. Pat. App. & Int. Sept. 26, 2006) at *4, quoting *Ex Parte Lundgren*, 76 USPQ2d 1385, 1393-94 (Bd. Pat. App. & Int. 2006)) but even that is putting a modern gloss on the term. Infusing that gloss with restrictive meaning, given the paucity of information about the drafting of the patent provision (Walterscheid, *op. cit.*), is unwarranted.

All that can be said about the patent provision is that its purpose was "To promote Progress" by doing what the patent system already did by 1789: encouraging the disclosure and thus the commercialization of new ideas, and spurring improvements on, and alternatives, to old ideas. These are the results of a system that gives time-limited exclusive rights to inventors in exchange for disclosure of their ideas. Why should some inventors be discriminated against? The Constitution does not mandate that.

In the eighteenth and nineteenth centuries, in both England and the United States, there was controversy over whether processes -- any kind of processes -- were patentable. (See Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedent (Part III Continued)*, 77 J. Pat. & Trademark. Off. Soc'y, 847, 855 et seq. (1995).) As a result, there was litigation, as well undoubtedly as lost opportunities, slower progress in some fields, and the attendant waste of time, money and energy.

Today, faced with whether or not to discriminate among different kinds of processes, this Court has the opportunity to prevent similar harms by finding that patentable subject matter includes "anything under the sun that is made by man," including processes.

B. Section 101

English language patent statutes, from the Statute of Monopolies on, have always included a noun or nouns about subject matter, as Judge Linn noted in his concurrence-in-part, dissent-in-part in *In re Nuijten*, 500 F.3d 1346, 1360 (Fed. Cir. 2007), *reh'g denied*, *reh'g en banc denied*, 515 F.3d 1361 (2008):

"As the majority recognizes, with the exception of the substitution of 'process' for 'art' [in the 1952 patent statute], the four categories of statutory subject matter in § 101 have remained unchanged since the 1793 Patent Act. Act of Feb. 21, 1793, ch. 11, § 1, 1 Stat. 318. 'Manufacture' was a statutory category even in the very first United States Patent Act of 1790. Act of Apr. 10, 1790, ch. 7, § 1, 1 Stat. 109. Indeed, 'manufactures' were the subject of the British Statute of Monopolies of 1623, 21 Jac. 1, ch. 3."

Perhaps the use of a noun or nouns reflects not so much a thoughtful choice as a stylistic one. Section 101 could be rewritten, and would have the same effect, with the added benefit of avoiding irrelevant argument, if it said

"Whoever wants to obtain a patent on something useful may do so, subject to the conditions and requirements of this title."

(See *Morris*, 609 PLI/Pat at 125).

Even the phrase "on something useful" may be superfluous: anyone seeking patent protection thinks the invention is useful: it takes too much time, money and effort to obtain a patent just for fun. Plus, if the invention is not useful, the patent will never be asserted against anyone else. Its issuance will do no harm and, since the patent will then be on the books, it will be prior art to others who might think of patenting something else useless, unless they can explain why their subsequent invention is valid over the earlier useless one.

IV. *FLOOK* AND HOW THE PATENT OFFICE SHOULD HANDLE 101

A. *Flook* in light of *Chakrabarty* and *Diehr*

This Court in *Comiskey* chose to ignore the Examiner and Board's analyses of the prior art in order to address 101, and to affirm the rejection of the claims on that basis. 499 F.3d at 1371. It took this course in reliance on *Flook* (and later cases that cited *Flook*) that 101 must be considered before 103 (499 F.3d at 1371). While that order might make sense with an issued patent, it did not make sense in *Flook*, *Diehr* or *Chakrabarty* -- all of which involved claims that had not yet been examined for novelty and nonobviousness.

It would seem to be a disservice to inventors as well as to the public

and to the state of the law to consider the 101 issue before application claims have met the other requirements of Title 35. Fortunately, the last of those cases, *Chakrabarty*, sought to make 101 a non-issue with its "anything under the sun made by man" standard.

The Supreme Court in *Chakrabarty*, did, however, try to harmonize its decision with *Parker v. Flook*, 437 U.S. 584, 593 (1978):

"*Flook* did not announce a new principle that inventions in areas not contemplated by Congress when the patent laws were enacted are unpatentable *per se*. ...

"To read that concept into *Flook* would frustrate the purposes of the patent law." (447 U.S. at 315) (emphasis added)

and went on to note:

"A rule that unanticipated inventions are without protection would conflict with the core concept of the patent law that anticipation undermines patentability." (447 U.S. at 316)

Continued reliance on *Flook* is also problematic because, although *Diamond v. Diehr*, 450 U.S. 175 (1981) did not explicitly overrule it, the two decisions seem inconsistent. As this Court noted in *Arrhythmia Research Technology, Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1057n4 (Fed. Cir. 1992):

"Although commentators have differed in their interpretations of *Benson* [*Gottschalk v. Benson*, 409 U.S. 63 (1972)], *Flook*, and *Diehr*, it appears to be generally agreed that these decisions represent evolving views of the Court, and that the reasoning in *Diehr* not only elaborated on, but in part superseded, that of *Benson* and *Flook*. See,

e.g., R.L. Gable & J.B. Leaheey, *The Strength of Patent Protection for Computer Products*, 17 Rutgers Computer & Tech. L.J. 87 (1991); D. Chisum, *The Patentability of Algorithms*, 47 U. Pitt. L. Rev. 959 (1986)." (emphasis added)

The claimed inventions in *Diehr* and *Flook* are remarkably similar, yet the Supreme Court came to opposite conclusions: *Flook* involved a method to update alarm limits in an industrial process, using a mathematical formula. The formula was assumed to be in the prior art. (437 U.S. at 592). Applicant *Flook* lost. *Diehr* involved a method to turn off an oven in an industrial process using a mathematical formula, the Arrhenius equation, that was admittedly in the prior art. Applicant *Diehr* won, and in 1982, U.S. Patent No. 4,344,142 issued. (According to the LEXIS patent database, this patent was licensed but never litigated. It expired in 1999.)

The language in *Diehr* explaining the difference between the two cases suggests that applicant *Flook* did not comply with section 112, neither enabling, nor providing an adequate description of, his invention:

"As we explained in *Flook*, in order for an operator using the formula to calculate an updated alarm limit the operator would need to know the original alarm base, the appropriate margin of safety, the time interval that should elapse between each updating, the current temperature (or other process variable), and the appropriate weighing factor to be used to average the alarm base and the current temperature. 437 U.S., at 586. The patent application did not 'explain how to select the approximate margin of safety, the weighing factor, or any of the other variables.' *Ibid.*" *Diamond v. Diehr*, 450 U.S. 175, 187 n.10 (1981)

Flook reflects its era's fear of computer-related patenting more than a thorough understanding of the invention or of patent law. The better course for the patent system would have been for Flook's claims to have been rejected under § 112. Very likely, he would not have been able to amend his specification without introducing "new matter" along the lines of the missing information identified by the Supreme Court. Because 35 U.S.C. § 132 prohibits adding new matter, he would then have had to decide whether to file a continuation-in-part application and get a new priority date, or abandon his claims. Without his original filing date, his own activities might be invalidating prior art under 35 U.S.C. § 102(b), and they, or other intervening prior art, might well convince him to abandon his claims. That would have been a result that was more in line with the patent system's twin goals of encouraging timely and full disclosure of inventions and of preventing the patenting of what is already in the public domain.

B. First, The Prior Art

The Manual of Patent Examining Procedure (8th ed., Rev. 6 (September 2007)) ("MPEP") has the correct order for examination of a new patent application. In Section 2106, Patent Subject Matter Eligibility, item III, "CONDUCT A THOROUGH SEARCH OF THE PRIOR ART" comes

before item IV, "DETERMINE WHETHER THE CLAIMED INVENTION COMPLIES WITH 35 U.S.C. 101." Item III begins:

"Prior to evaluating the claimed invention under 35 U.S.C. § 101, USPTO personnel are expected to conduct a thorough search of the prior art."

This is the right order. If there is invalidating prior art, that should be the first focus of the Patent Office and the applicant.

The MPEP explains that initially the Examiner must identify all grounds for rejection:

"It is essential that patent applicants obtain a prompt yet complete examination of their applications. ... Thus, USPTO personnel should state all reasons and bases for rejecting claims in the first Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, USPTO personnel should indicate how rejections may be overcome and how problems may be resolved." Section 2106 (II).

But because analysis under 101 is so abstract, the better course for the Patent Office would be to undertake it, if ever, only after the claims have been determined to be otherwise allowable. The MPEP does not have the force of law, of course (*Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180 n.10 (Fed. Cir. 1995), but it does reflect the accumulated wisdom of the Patent Office in trying to perform its functions in accordance with the law.

This Court's decision in this case could help the Patent Office do its job better, and use its limited resources better, by announcing that 101

rejections should be issued provisionally, just as obviousness-type double patenting rejections are (Manual of Patent Examining Procedure § 804 (8th ed, Rev 6 (Sept. 2007))). They should only be addressed after the claims are in condition for allowance under 102, 103 and 112. That way (1) the United States Patent and Trademark Office ("the Patent Office") and the courts will need to consider far fewer claims under 101; (2) applicants will have been given the opportunity to craft valid claims, thus often overcoming problems with claiming only "abstract ideas"; and (3) the Patent Office and the courts will not waste time, money and effort grappling with claims that could not survive examination for validity. Instead, all concerned can focus on articulating the standards for any needed public policy prohibition against otherwise patentable inventions.


V. CONCLUSION

Evaluation of Bilski's claims for patentable subject matter should, at a minimum, await their examination for compliance with 102, 103 and 112. If they survive, and if the Patent Office continues to believe that under the Constitution and 35 U.S.C. § 101, no patent should issue, then the matter will be ripe for analysis. Any modification to 101 jurisprudence will be the better for being fashioned to address an otherwise allowable claim.

For the reasons set forth above, amicus Roberta J. Morris, Esq., Ph.D.
respectfully requests this Court to reverse the Board's decision.

Respectfully submitted,

April 7, 2008

A handwritten signature in cursive script, appearing to read 'Roberta J. Morris', written in black ink.

Roberta J. Morris, Esq., Ph.D.
as attorney for herself as
amicus curiae