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Patent Eligible Subject Matter: A Review of What Others Are Saying

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Discussion about patent eligibility of subject matter under 35 USC §101 continues to turn up insights. "An Appeal to Reason Post-*Myriad* and *Mayo* – to Follow the Statute and the Constitutional Plan for the U.S. Patent System When Deciding Questions of Patent Eligibility", by Garth Janke, in the 10/18/2013 edition of BNA's Patent Trademark & Copyright Journal discusses the judicial exceptions to §101 in light of the text of the Constitution, pointing out that the Constitution requires that patent subject matter promote Progress, and that the Progress must be "of useful Arts". From these constitutional requirements, Janke logically concludes, abstract ideas, mathematical algorithms, natural phenomena and so on are not patent eligible because they are not "useful". Making a practical use creates "the *type* of subject matter that is*capable* of being patented provided that it promotes Progress." He then continues with an hypothetical example of two black boxes that can predict earthquakes. One black box has a combination of electrical and mechanical components inside, and the other has a computer, with an equivalently complex algorithm. He asks, "does it make sense that there could be two machines producing identical useful results, only one of which would fall within judicial exceptions and therefore be ineligible for patenting?"

"Amici Support Supreme Court Review of Computer-Implemented Patent Eligibility", by Tony Dutra, also in the 10/18/2013 edition of BNA's Patent Trademark & Copyright Journal, reviews eight briefs filed by friends of the court in *WildTangent v. Ultramercial* and eleven briefs filed by friends of the court in Alice v. CLS "urging the Supreme Court to address software patent eligibility." His article has links to these briefs, which the interested reader is encouraged to explore. While we don't have space in this blog to comment on all of the briefs, two in particular resonate with ideas we have presented. Tony Dutra summarizes, "*Diehr*taught that the standard for Section 101 patent eligibility is 'whether there is at least one element that is neither "abstract" (purely in the human mind) nor "natural" (as opposed to man-made),' according to the IEEE." Tony Dutra further summarizes "Hollaar and Trzyna's brief identified a 'bright line that can be drawn between "abstract" and statutorily patentable that is a clear distinction in computer technology' via a definition in *Webster's Third New International Dictionary:* 'considered apart from any application to a particular object or specific instance; separated from embodiment.'" Hollaar and Trzyna's brief continues, "The answer to whether a computer-implemented invention is statutory subject matter when claimed is a computer or data processing system should be clear… Of course, it is a machine."

It is striking and encouraging how closely Hollaar and Trzyna's bright line distinction, between

abstract and statutorily patentable, parallels ideas we presented in the September 17, 2013 blog posting “Inquiries As to Patent Claims Possibly Preempting All Possible Uses of an Abstract Idea.” It is equally striking and encouraging how closely Garth Janke’s black box thought experiment parallels the two black boxes and thought experiments we presented in the September 20, 2013 blog posting “A Case for Patentability of Software-based Inventions.” The interested reader is invited to review these, or proceed directly to the following.

To further contemplate patent eligibility of inventions based on abstract ideas, let us add to the two black boxes of Garth Janke and the two black boxes of our September 20, 2013 blog, one more black box. This fifth black box appears externally identical to the two black boxes we presented then, but has inside all hardwired electronics, and no software per se. That is, this fifth black box is made of transistors, integrated circuits, resistors, capacitors and other electronic components, but does not have a reprogrammable memory and does not have software code in any recognizable form heretofore known. All of the aspects of the abstract idea upon which this invention is based, for example one or more algorithms or mathematical equations, are implemented using wires, circuit boards and the above-listed components. This is very clearly an electronic device. It should satisfy patent eligibility under 35 §101 as readily as any other electronic device. It produces the exact same useful result as the other two black boxes. It is as equally closely or equally distantly related to the abstract idea as the other two black boxes. Yet, under the present state of confusion of the courts, our first black box (the entirely mechanical one) would likely be ruled patent eligible subject matter under 35 USC §101, our second black box (the one with the computer and the software) might or might not be ruled patent ineligible subject matter, and our third black box (the entirely electronic one) would likely be ruled patent eligible subject matter.

However, according to the IEEE brief, and consistent with *Diehr*, all three of our black boxes have at least one element that is neither abstract nor natural, so all three black boxes should satisfy the standard for 35 USC §101 as to eligibility. The first black box has gears and other mechanical components, the second black box has transistors and wires (it is a computer, after all), and the third box has transistors and other electronic components. According to Hollaar and Trzyna’s bright line distinction, all three black boxes are not “separated from embodiment” (indeed, each of the three black boxes is an embodiment), so all three boxes should be considered not abstract. According to Janke’s brief, all three black boxes promote Progress of useful Arts, in accordance with the Constitution, and each black box has a practical use. All three boxes, therefore, should be considered patent eligible under 35 USC §101. The Supreme Court findings, and the insights and clarifications they will hopefully provide, are eagerly awaited.

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