Suggestion for fixing 35 USC 101

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In a LinkedIn post at URL:
https://www.linkedin.com/pulse/what-patentable-alexander-poltorak/
Alexander Poltarak asked "But is it proper to expand a narrowly crafted judicial exemption [sic; exception] from a statute mandated by the U.S. constitution so wide that it swallows up all of patent law?"

I submit that is the wrong question. The correct question is, does the Supreme Court have judicial power to pronounce a "judicial exception" to constitutional or statutory law. My answer: It does not. The Supremes can only interpret, interpolate, and extrapolate to case specific facts. The Supremes cannot make the equivalent of statutory law.

The solution to Supremes overreach in 101 law is straightforward. Congress should rub the Supremes nose in that fundamental legal principle, by adding to 35 USC 101, "All judicial exceptions to patent eligibility are abrogated." That would overrule all 101 case law that does more than interpret, interpolate, and extrapolate from constitutional and statutory law.

In the context of 101 case law, that would reinstate *Cochrane v. Deener*, 94 U. S. 780 (1876)'s definition of a patentable process, as one or more "acts ... performed upon the subject-matter to be transformed and reduced to a different state or thing." The Supremes repeated cited this definition from *Cochrane*, in many cases in the intervening decades, until they erred by legislating "judicial exceptions" to 101.

Some argue that my proposed change to 101 would allow patents on pure mental steps and pure algorithms. Not so, because *Cochrane* requires the result to be "a different state or thing." That is, a physical change.

Some argue that my proposed change to 101 would allow a patent in which the 102 and 103 (novel and non-obviousness requirements) could be met by the mental steps and computer calculations and argue that would be contrary to public policy. In response, I note that case law already addressed and resolved that problem by treating mental steps as tantamount to “printed matter” and therefore being incapable of satisfying the novelty and non-obviousness requirements. *See for example Praxair Distribution, Inc. v. Mallinckrodt Hospital Products IP Ltd.,* 2016-2616, 2016-2656 (Fed. Cir. 5/16/2018).

Others have lobbied for a different kind of legislative fix. They have petitioned to more fully define 101, in what I see to be a convoluted manner, in order to carefully tailor 101 to include what they think should be patentable subject matter within the scope of 101. But I find that they are trying to plug a hole in the statute that does not exist. 101 as it stands is fine. It was the Supremes overreach, in creating "judicial exceptions," that is the problem. Attempting to remove from the statute something not present in the statute (the judicial exceptions), is why those efforts result in convoluted language. Language that Congress has for several years pretty much ignored.

Instead, adding to 35 USC 101, "All judicial exceptions to patent eligibility are abrogated," removes the problem, and would allow subsequent case law development to steer a proper path.

Finally, I note that Alexander’s LinkedIn post presented a putative apparatus claim and

not a process claim. However, apparatus claims that recite structures only by their functions, such as "to receive"; "to process"; and "to provide," have long been treated in case law as tantamount to process claims. Courts look to the substance of limitations defined by claims and not merely to whether the claim state that it is an apparatus or process.