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Subject: Comments on "DRAFT OUTLINE OF SECTION 101 REFORM."
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I am a practicing patent attorney. **I am strongly in favor** of your effort to fix 101 law. I comment below on each bullet in your "DRAFT OUTLINE OF SECTION 101 REFORM."

- "Keep existing statutory categories" – **Agree.**
- "Eliminate, within the eligibility requirement, that any invention or discovery be ... 'new.'" – **Agree.**
- "[S]imply require that the invention meet existing statutory utility requirements" – **Agree.**

- "Define, in a closed list, exclusive categories of statutory subject matter which alone should not be eligible for patent protection." **Disagree!** Your list of categories does not clearly enough define what is not eligible. A useful invention, such as a process of using a "Fundamental scientific principle[]," for example, can also claim the fundamental scientific principle. Your definition that these categories are "categories of statutory subject matter which alone should not be eligible for patent protection" is insufficient to constrain the Supreme Court from finding a useful claim ineligible under 101. You need to more carefully limit the description of the "exclusive categories of statutory subject matter which alone should not be eligible for patent protection" to specify that the claims are limited to those categories in that they do not include any additional limitation that is part of a "process, machine, manufacture, or composition of matter, or any useful improvement thereof." For example, you might define - - An exclusive categories of statutory subject matter, such that, if a claim is contained entirely within one or more of these categories, that claim does not define subject matter eligible for patent protection.- - "Fundamental scientific principles;" – **Suggest - - Fundamental scientific principles, not limited to a practical application."**
 - "Products that exist solely and exclusively in nature;" – **Disagree.** This category is not definite enough to avoid for example the fiasco in *Myriad* while preserving the holding in *Funk Brothers*. *Myriad's* decision was fatally flawed because the claimed product did not exist in the exact form in nature. The Courts however discounted the chemistry and claim construction to analogize the claimed subject matter to abstract computer code. To avoid that rather absurd result you need to specifically define what "exist solely ... in nature" means. For example, - - exist solely and exclusively, and in exactly the same form and arrangement, in nature."
- "Pure mathematical formulas;" – **Suggest - - Pure mathematical formulas, not limited to a practical application."**
- "Economic or commercial principles" – **Suggest - - Economic or commercial principles, not limited to a practical application-**
- "Mental activities." – **Agree.**
- "Create a "practical application" test to ensure that the statutorily ineligible subject matter is construed narrowly." – **Agree, in part.** You could merely define a claim to a practical application to be any claim not wholly within one or more of the "exclusive categories of statutory subject matter" as clarified by my suggestion above.
- "Ensure that simply reciting generic technical language or generic functional language does not salvage an otherwise ineligible claim." – **Disagree. Limiting functional claiming does not**

belong in 101! This is the purview of 35 USC 112(f), which already deals in part with functional claiming. To address the functional claiming/overbreadth issue, revise 112(f) to specify how functional clams are to be construed.

112(f) current reads: “(f) Element in Claim for a Combination.-An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

Add to 112(f) another sentence construing functional claiming. Such as “An element in a claim defining a function or goal shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.”

“Statutorily abrogate judicially created exceptions to patent eligible subject matter in favor of exclusive statutory categories of ineligible subject matter.” – **Agree.**

“Make clear that eligibility is determined by considering each and every element of the claim as a whole and without regard to considerations properly addressed by 102, 103 and 112.” – **Agree.**

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