Andrei Iancu Will Resolve the PE-Problem as Required by Incentivizing Innovation.

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And he clearly repeats: PE is the biggest PTO problem — as it is the biggest threat to the US innovativity[1.a)].

This mail confirms his being right with both of them, the PE-problem's solvability and the threat to the US society's innovativity[b)]. He made these very strong statements last week, during his 'fire site chat' about PE[518].

Iancu started with briefly summarizing various improvements that he achieved in the year of his USPTO responsibility[c)]. But his progress in solving the PE-problem by the PE-Guideline 2019 was mixed. Also the preceding PE-panel — opening the patent track of the Conference[518] — presented only complaints by all panelists and part of the auditory about the Supreme Court's allegedly nonsensical PE decisions and their disaster for the US economy.

Thus, during his following PE chat's 90-minutes, Andrei Iancu told exactly the contrary: He explained the comprehensibility of the Supreme Court's PE-framework by emphasizing that nothing is principally wrong with rejections by exempting certain subject matters from PE[d)], such as plain escrow transactions. Also — when attendees raised doubts about his positive PE-view that Congress might terminate[e)] — he very firmly reconfirmed his above target.

The latter evidently means that Andrei Iancu has correctly recognized that the CAFC's recent PE-decisions — *Athena v. Mayo* & *Cleveland v. True Health*, and cases pending at the Supreme Court waiting for the USPTO's feedback (i.e. *HP v. Berkheimer* & *Hikma v. Vanda*) — don't resolve the PE-problem, as they contradict *Mayo/Alice*: In each of the 4 cases, the CAFC namely requires from the resp. application[f)] itself, i.e. PER SE, to comprise a '**Super inventive concept**'. But this is definitively wrong[g)]. The next paragraph and[g)-i)] explain, why this requirement is totally untenable.

Alice's PE-specification — provided on p. 7 of *Alice's* opinion — namely explicitly requires that this inventive concept **1.)** is comprised by an application of the original claim, and **2.)** only needs to be basically independent[488ftn1.b)] of the original claim (for so guaranteeing that the combination of both is significantly more than the original claim alone[354ftn5.d)]) and **3.)** establishes a novel combination[i)]. In its ETCI (i.e. 'locally'), it then is already creative and hence an '***Alice* inventive concept**' (of the combination of the original claim and the application, i.e. of this ETCI). Thereby it does not matter whether in the application per se (i.e. 'globally') this concept is inventive or not.

Thus, the *Alice* inventive concept[i)] is evidently much easier to find than the Super inventive concept and does render this ETCI LP≡PE≡PE robust≡MI[503]. In total: All 4 CAFC decisions comprise the same serious legal error[i)], and Andrei Iancu's 2019 PE-Guideline is indeed already close to the solution of the PE-problem incentivizing innovation.[i)]

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[1] **a** This FSTP-mail[520] is a continuation of[503] about ETCIs'[495ftn1.b)] being 'nPE/PE' resp. '(un)limited preemptive'[503ftn2.a)]. Therefore no doubt exists as to the above enormous threat to the US society's wealth — by the Supreme Court explained in its *Mayo* decision. Consequently, this mail may focus on ●commenting Andrei Iancu's intention to resolve the fundamental[b)] PE-problem, and thereby clarify ●why the CAFC's PE-decisions are none (as its interpretation of *Alice's* PE-specification this is grossly wrong).
For a summary of the important pragmatic aspects of Andrei Iancu's presentation see[519].

.b The Supreme Court recognized the need of this fundamental 'non/limited/unlimited preemptive' notion a decade ago when refining the interpretation of classic SPL by an ETCI 'framework' for improving ETCIs' SPL-protectability.
This 21st century, then semiotic[171], Mathematical Philosophy and innovations based, fundamental notion of 'preemptivity' is tightly related to the 19th/20th century, then semiotic, just Mathematical Philosophy based, fundamental notion of 'undecidability'.
The reason for creating the 'undecidability' notion, i.e. that there is a need for it, was that historically it was unknown, but Frege's refinement of logic thinking[130] led to recognizing that there is a boundary to mathematical provability in solving problems.
Its Mathematical Philosophy — adumbrated by Kant[3230,32] — required notionally refined thinking about a world of ●mentally pre-existing items, as in classic Physics, teaching us that its problems may be undecidable, and now also of ●mentally creatable items, as in Semiotics, teaching us that its 'existentially preemptive' problems may be unlimited, too. These refinements would have been impossible without contributions from Analytic Philosophy, Set Theory, First Order Logic, Mathematical Logic, Context Free & Natural Languages & AI. *cont'd on p2*

.c First of all, he replaced the notionally undefinable as 'baseless' hitherto claims' 'broadest reasonable interpretation, BRI' — in spite of its popularity among examiners & lawyers, yet long time embarrassing the more crucial part of the patent community[37,296], including most US district courts (yet not many CAFC boards!!!) — by the notionally defined as resp. ETCI-based *Phillips* BRI of claims.

.d — as otherwise '**unlimited preemptive**, **ULP**'[503ftn2.a)] ETCIs would threaten to put the US SPL socioeconomically into jeopardy, as the Supreme Court's *Mayo* decision explained as to ULP ETCIs.

.e This expectation (by part of the patent community) is not aware that Congress would notice — due to this discussion — that simplifying the interpretation of §101 such that it deviates from its Supreme Court interpretation other than by its refining (i.e. its sublimation), as this would mathematically provably create inconsistency and unpredictability of court decisions about ETCIs, as indicated in[503].

.f — transforming the resp. original claim of 'nPE nature' into a claim of 'PE nature' (in *Alice*'s wording on p. 7 of its opinion) —

.g The CAFC criticizes in all 4 cases that the applications **PER SE** have no inventive concept — i.e. it misses therein a '**Super-inventive concept**' of the application involved in the resp. ETCI. But the Supreme Court requires no such Super-inventive concept — it requires much less.h)/i)

.h Upfront, the Supreme Court's *Myriad* opinion on its p. 17, bottom, clearly anticipates *Alice's* *Alice*-inventive concept(s), by stating that, as: "*… the first party with knowledge of the* **[BRCA1** and **BRCA2**, in general terms: 'of nPE/exceptional inventive concepts'**]** *sequences, Myriad was in an excellent position to claim applications of that knowledge. Many of its unchallenged claims are limited to such applications."* I.e.: These applications' novel concepts are evidently *Alice*-inventive concepts.

.i The **SOLE** objective[508] of the Supreme Court's framework is to increase the robustness of ETCIs' patents by assessing their being LP=PE[503]/g). I.e.: Its objective is not to increase the creativity of ETCI-patents by Super-inventive concepts — as this would dramatically disincentivize inventors & investors — what the CAFC with its current PE-decision practices efficiently does.j)

NOTE: For an nPE claim and any application of it all its concepts are by **1., 2.),3.)** easily testable for being an *Alice*-inventive one. Such a 'streamlined' version of the FSTP-Test enables replacing the current 2019-PE-Guideline's wrong 2-step-test by a correct one — and dramatically simplifying it by reduction to much fewer but 'blueprint' examples that may stereotypically be copied and yet are '**SPL**-robust'.

.j No other NPS has hitherto noticed that there are serious SPL-problems with unlimited preemptive ETCIs, recognized by the Supreme Court's 'SPL-framework' decisions — as spoiling, in ETCIs' SPL-precedents, consistency&predictability in PE=LP=**PE**-robustness=provability=MI[503]. For (re)establishing this scientificy of ETCIs' SPL, the only way is to refine the classic SPL interpretation as the Supreme Court's framework requires.

Especially the EPC's highly metaphysical '*technicity*' property of an ETCI has nothing to do with rationally guaranteeing its PE=LP=.....

The FSTP-Project's Reference List (Version of 17.04.2019)

Many FSTP-Project mails, including this one, are written in preparation of the textbook[182] – i.e. are not fully self-explanatory independent of other FSTP-mails.

[2] The term 'Artificial Intelligence' here denotes specific cutting edge deterministic IT & Mathematics areas, e.g. in Knowledge Representation (KR)/ Description Logic (DL)/ Natural Language (NL)/ Semantics/ Semiotics/ (Nonsequential) System Design/…, i.e. a resilient fundament for analyzing 35 USC/SPL by AI-based "Facts Screening/Transforming/Presenting, FSTP"-Technology, developed here, induced by the US Supreme Court's framework decisions[182]. All the ETCIs' meanings, especially Molecular Biology meanings of all 'BIO-prefixed ' acronyms, are based on so understood AI.

[5] S. Schindler: "Math. Modeling SPL Top-Down vs. Bottom-Up", Yokohama, 2012*)

[9] S. Schindler, "Patent Business – Before Shake-up", 2013/2015/2019 (to be publ. in Q)*).

[37] D. Bey, C. Cotropia, "The Unreasonableness of the BRI Standard", AIPLA, 2009*).

[46] S. Schindler: "Autom. Deriv. of Leg. Arg. Chains (LACs) from Arguable Subtests (ASTs) of a Claimed Invention's Test for Satisfying. SPL", U Warsaw, 24.05.2014*).

[47] S. Schindler: "Automatic Generation of All ASTs for an Invention's SPL Test".*).

[64] B. Wegner, S. Schindler: "A Mathe. Structure Modeling Inventions", Coimbra, CICM-2014*).

[69] USSC, Transcript of the oral argument in *Alice* Corp. v. CLS Bank, 31.03.2014*).

[113] S. Schindler: "The CAFC's Rebellion is Over – The USSC, by *Mayo*/Biosig/*Alice*, ...", publ. 07.08.2014*).

[130] G. Frege: "Function und Begriff", 1891.
G. Frege: "Sinn und Bedeutung".

[140] S. Schindler: "§ 101 Bashing or § 101 Clarification", published 27.10.2014*).

[157] USPTO: "2014 Int. Guidance on Pat. Subj. M. Eli. & Examples: Abs. Ideas"*).

[182] S. Schindler: "Basics of Innovation Theory and AI Based Patent Technology", Textbook, in prep.

[218] B. Russel: "Principles of Mathematics", see also Wikipedia.

[278] a.) D. Parnas: Personal Communications, Berlin, 1975.
b.) D. Parnas: "Software Fundamentals", ADDISON-WESLEY, 2001.

[296] S. Schindler: "A Com. on the 2016 IEG Update – Suggesting More Scrutiny ", publ. on 09.06.2016*).

[314] J. Duffy: "Counterproductive Notice in Literalistic v. Peripheral Claiming", U. of Virginia, June 2016*).

[332] S. Schindler: "The Notion of Claiming in SPL – pre&post Aufklärung", p. 10.10.2016*)

[335] T. Kuhn: "The Structure of Scientific Revolutions", UCP, 1962, see also Wikipedia

[348] B.Wegner: Invited paper, "Innovation, knowledge representation, knowledge management and paper, "Math. Modelling class. math. thinking", Corfu, Ionian University, 22.11.2016*)

[349] B. Wegner:: Invited paper, "Robust Claim Interpretation and Claim Construction for an ETCI, - Steps of a "Mathematical Theory of Innovation"", Bangkok, ICMA-MU, 17.-19.12.2016*)

[353] S. Schindler: "The Lesson to be Learned from the US PE Hype:", publ. 11.12.2016*).

[354] S. Schindler: "An Amazing SPL Cogn.: Any Pat. Appli. is Draft. Tot. Rob.", publ. 31.01.2017*).

[355] S. Schindler: "An Ama. SPL Cogn.: Any Pat. Appli. is Draft. Tot. Rob.", pub.07.03.2017*).

[361] J. Straus: „IPRs and Bioeconomy", Journal of IP Law&Practice, 14.07.2017

[372] S. Schindler: "'IDLs" & KRs, and Easily Drafting&Testing Patents for Robustn.', pbl., 16.05.2017*)

[374] Justice Thomas: Friendly Comment, 04.12.2015*)

[390] S. Schindler: "The Recent AIPLA Meeting's … §101-Guidelines …", publ., 14.06.2017*)

[391] S. Schindler: "ANNEX[391] to[390] — Trivializing & Semi-Automat. ETCIs' SPL-Satisf.-Tests*)

[400] S. Schindler: "MEMO: Sequenom — An Incomplete Interp. of §101/Alice by …", 17.07.2017*)

[406] S. Schindler: "The PE-Theorem, FSTP-Test, and the US Innovation Econo. … ', publ. 01.08.2017*)

[415] S. Schindler: "The USPTO's §101/Biotech WS: Its PE-Test is Too Vague …", 12.09.2017*)

[422] C. Shannon "A Mathematical Theory of Communication", 1948.

[423] S. Schindler: "The CAFC's Biotech/PE-Decisions — Reconsidered for the R&D-Investor Community", publ.15.10.2017*)

[433] S. Schindler: "An SPL's ETCI is 'Dig.' iff it is Totally-Rob. — Espec. PE.. Oil States", publ. 05.10.2017,*)

[443] D. Schoenberg, J. Schulze, J. Wang, C.Negrutiu, B. Wegner, R. Wetzler, S. Schindler: "The UI Design of the IES for Testing an ETCI's Satisfying SPL", 23.01.2018*)

[453] S. Schindler: "AI and US & German SPL will Boost R&D-Investments", publ.19.04.2018*)

[458] S. Schindler: "Comment on the Absurdity of §101 in MPEP-2018_Sect2106.", 16.03.2018*).

[459] S. Schindler: "Andrei Iancu's Promises of More Certainty in USPTO's PE-Decisions – Hope- or Harmful?", publ. 03.05.2018*)

[467] CAFC, Decision in VANDA, 13.04.2018*)

[468] S. Schindler: "Andrei Iancu's Further Pub. Discuss. about USPTO's Serv.", publ. 11.05.2018*)

[470] S. Schindler: "USPTO's Berkheimer PE-Guideline … & A Question – not asked – as to USPTO's DataBase-Searching for Patent(-Application)s", REMAKE publ.06.07.2018*)

[477] S. Schindler: "Rationality Returns in the US SPL-Drama – it now has a White Knight.", 21.06.2018*)

[478] A. Iancu: "Remarks delivered at the AEI", 21.06.2018*)

[479] S. Schindler: "Dropping the BRI-Standard is Necessary! But … ", publ.09.07.2018.

[480] S. Schindler: "A Fresh Look at the USPTO's PE-Guidance — …", publ.19.07.2018.

[482] S. Schindler: "Andrei Iancu — After 100+ Days Even Stronger on Track.", publ. 25.07.2018*)

[483] S. Schindler: "A PE-Guideline for Anybody — Framework-based, Precise, Short, and Simple!!", publ. 30.07.2018*)

[484] S. Schindler: Sliding Interpretations of AIA-§§ Threaten US Development of Emerging Technologies. Pertinent Supreme Court's Decisions Needed for Stabilizing the US NPS.", publ. 22.08.2018*)

[485] S. Schindler: Pers. Communications to P. Michel, DC, 30.07.2018.

[488] S. Schindler: 'UC's vs. *Broad/MIT/Harvard*'s CRISPR Patents & the Supreme Court's Framework', Part I, publ. 20.09.2018*)

[489] S. Schindler: UC's vs. *Broad/MIT/Harvard*'s CRISPR Patents & the Supreme Court's Framework', Part II, publ. 25.10.2018*)

[495] S. Schindler, B. Wittig: "*UC*'s vs. *Broad's* **CRISPR** Patents …", Part III, publ. 30.01.2019*)

[500] S. Schindler: "Andrei Iancu's § 101 Challenge — Becoming his § 101 Success Story? The USPTO's Recent Claim Interpretation May Render *Alice's* § 101 Test As Patent Champion.", 14.11.2018*)

[503] S. Schindler, B. Wittig: "*UC*'s vs. *Broad's* **CRISPR** Patents & the Supreme Court's Framework, AI-Support — About BIOETCIs & MBIOETCIs ", Part IV., 18.03.2019

[504] USPTO: The 2019 §§ 101&112 Guidelines, 04.01.2019*)

[508] B. Wittig, S. Schindler: "*UC*'s vs. *Broad/MIT/Harvard*'s CRISPR Patents & the Supreme Court's Framework — Graphical Support in (MBIO)ETCI Specification', Part V", , to be pub. In Q2/2019.

[510] S. Schindler: "Finally, CAFC & USPTO Started Friendly ….! One Year of Andrei Iancu's Spirit in the USPTO — and All US Legal Patent-Business is of Good-Will.", publ. 05.03.2019.*)

[511] CAFC, Decision in Athena, 06.02.2019*)

[512] G.Quinn: "Why the CAFC is to Blame ..", IPWATCHDOG, 25.02.2019*)

[513] A. Iancu: 'Opening Remarks of 14. APLI', USPTO, 21.03.2019.

[514] R. Taylor, USPTO, 21.03.2019..

[515] R. Taylor, see*)

[516] D. Reardon, G. Quinn: *Alice* is Due for Reversal: Science Proves Its Reasoning Unsound", 21.03.2019*)

[517] D. Carleton: "Showing 'Meaningful Limits' in Patent Claims", 19.03.2019*)

[518] A.Iancu: "Fire Side Chat about the PE-Problem", Arlington, ABA-IPL, 11.04.2019

[519] B. Stoll: "Courts Can Resolve Patent Eligibility Problems, Iancu Says", ABA-IPL, 12.04.2019*).

[520] S. Schindler::" Andrei Iancu Will Resolve the PE-Problem as Required by Incentivizing Innovation", ABA-IPL, this mail, 21.04.2019*)

[521] W. Stegmüller : "Unvollständigkeit und Unentscheidbarkeit: "Die Metamathematischen Resultate von Gödel, Church, Kleene, Rosser und ihre Erkenntnistheoretische Bedeutung", 1973, Springer.

[522] CAFC, Decision in Athena v. Mayo, 06.02.2019*)

[523] USSC: PfC in Berkheimer*)

[524] USSC: PfC in Hikma*)

[525] CAFC, Decision in Cleveland v. True Health,, 06.02.2019*)

) *documents and complete Ref.-list available at www.FSTP-expert-system.com