Urge the Drafters of the New Section 101 to Support Inventor-Friendly Reform

By Mark Marrello / May 13, 2019

"It is beyond belief that the United States would cripple itself by limiting innovation in these crucial fields. Computer implemented inventions, biotechnology, medical innovations, and other critical fields must explicitly be protected and made patent eligible in the language of section 101."

Senators and Representatives Coons, Tillis, Collins, Johnson, and Stivers recently announced in a press release a proposed framework to fix patent eligibility law in the United States. If written as proposed in the draft framework, section 101 may do harm to the patent system. The senators and representatives are now soliciting feedback on the draft framework**.** They are likely to take additional action on the framework as soon as early this week.

Please send the following text with any of your edits to **IntellectualProperty@tillis.senate.gov**.

Honorable Senators and Representatives:

I would like to thank you for your initiative to resolve the 101 mayhem. Many concerns remain with your draft framework.

I applaud eliminating the terms "new and useful" from the current section 101, since "new" is covered in sections 102 and 103, and "useful" is irrelevant. However, I have the following concerns:

- Concerning the categories of ineligible subject matter, the Supreme Court created incredible mayhem and caused enormous damage to the patent system by creating its categories of ineligible subject matter (i.e. "judicial exceptions") and setting the fire. Codifying any categories of ineligible subject matter would reward the arsonist for setting the fire and provide additional fuel for the fire.

Any rational person would think that to solve the 101 mayhem one would eliminate the categories of ineligible subject matter just like depriving the fire of fuel would extinguish it. I implore the senators and representatives to see this obvious logic, to not perpetuate the 101 mayhem, and to extinguish the fire.

- Concerning the "practical application" test to ensure that the statutorily ineligible subject matter is construed narrowly, this is far from a viable line of defense for inventors in a world in which the courts have proven over at least a decade that they cannot be trusted with interpreting the patent law as written. The Supreme Court outright ignored the law as explicitly written and created its own law illegally when it created the "judicial exceptions" to patent eligibility. I wish we lived in a more perfect world, but given the courts' long, definitively proven unwillingness and inability to interpret the patent law as written, the only rational solution is to eliminate the categories of ineligible subject matter altogether and not allow the courts the flexibility to make further damage to the patent system.
- The concept of what a claim is "directed to" is far too vague and has been proven to be abused by the courts and many USPTO examiners in almost all cases of patent ineligibility. The concept of what a claim is "directed to" is a true disaster since anything can be said that it is directed to something else, and the courts and many USPTO examiners have used this concept to relate matters that do not have any relation. Therefore, it is critical to include in the language of section 101 that the courts and the USPTO must not use the concept of what a claim is "directed to," but instead use what a claim "explicitly recites."
- Concerning the phrase "simply reciting generic technical language or generic functional language does not salvage an otherwise ineligible claim," this is perhaps the most dangerous and misleading part of the draft framework and it absolutely must not be included in the final section 101. The Supreme Court in *Alice* wrongly created this notion to apply only to well established business practices (see the Supreme Court opinion in, 134 S. Ct. 2347 2014). To compound the damage, circuit courts have extended this notion to computer implemented inventions (i.e. artificial intelligence, robotics, autonomous vehicles and devices, image processing, databases, computer/video games,

computer simulations, content processing, and many more) that arise out of or are inherently implemented on a generic computer. It is unimaginably irrational to attempt to make computer implemented inventions that arise out of or are inherently implemented on a generic computer patent ineligible simply because they are implemented on a generic computer. Again, I wish we lived in a more perfect world, but the history has definitively proven that the courts cannot be trusted with interpreting this kind of language as written, therefore, the only rational solution is to eliminate this language altogether and not allow the courts the flexibility to cause further harm to the patent system.

Many of the most sophisticated and novel inventions can run on generic computing hardware and do not need specialized computing hardware. For example, facial recognition, speech recognition, language processing, various artificial intelligence applications, sophisticated computer game functionalities, advanced image processing, sophisticated database functionalities, computer simulations, advanced content processing, and many more, do not require anything other than a personal computer, smartphone, or other generic computing hardware. If the proposed "generic computing" language is included in the final section 101, it will exclude many eligible areas of innovation and become a complete disaster. This is the simplest point of all: what computing hardware a computer implemented invention runs on has nothing to do with patent eligibility and, therefore, should be excluded from section 101.

- Computer implemented inventions (i.e. artificial intelligence, robotics, autonomous vehicles and devices, image processing, databases, computer/video games, computer simulations, content processing, and many more), biotechnology, medical innovations, and others are fields of innovation critical in the global innovation economy and race for dominance in the world. It is beyond belief that the United States would cripple itself by limiting innovation in these crucial fields. Therefore, computer implemented inventions, biotechnology, medical innovations, and other critical fields must explicitly be protected and made patent eligible in the language of section 101.

You will notice that many of my points are driven by a genuine history-proven fear from the courts' unwillingness and inability to interpret patent laws as written. Please ponder on this carefully as you cannot ignore the courts' proven history. In the current attempt to reform section 101, you not only must include carefully written language as you would want it to be interpreted, but you must also account for the "courts' damage factor," because whatever language you think is well-written, the courts' will interpret it in flawed or outright wrong ways. The proof is that there was nothing wrong with the current section 101—it worked fine for decades—until the Supreme Court created the illegal "judicial exceptions".

Remember where China used to be relative to the United States in innovation ten years ago before *Mayo*, *Alice*, and the AIA came into being. China was not even on the radar as an innovation powerhouse. Today, after all the damage done by *Mayo*, *Alice*, and the America Invents Act (AIA), China is neck-in-neck with and even ahead of the United States in critical fields like artificial intelligence, biotechnology, medical innovation, and others. One who does not see the trend is blind or influenced by special interests. A partial so-called solution like the proposed draft framework will not reverse this trend or even slightly alter it. If you do not completely incentivize inventors like inventors were incentivized before *Mayo*, *Alice*, and the AIA, China will far outpace the United States in critical innovation fields in the next ten years beyond a point of return.

Gentlemen, you carry a great responsibility for ensuring a continued U.S. dominance in the world, which directly depends on the U.S. dominance in innovation. Indeed, you will be directly responsible if the United States falls behind other major powers because of the too limiting patent law, especially section 101. Just like the votes for or against NAFTA and other trade deals defined many politicians' careers and precluded some from becoming presidents and cabinet members, your choices in the section 101 reform will shape your careers and legacies. You will be remembered as saviors or destroyers of U.S. innovation.

On an issue where the balance is so hard to find and given the enormous importance of section 101 reform for the future of the United States, I would strongly advise a

section 101 that is flexible in favor of inventors. If you think about it, it is so much wiser to be at least a little more in favor of inventors than against them, as they are the very people who carry the torch of U.S. innovation. Many inventors have already given up on the U.S. patent system and have quit inventing. The remaining inventors will propel the United States forward or quit based on your reform of section 101.

The Author

Mark Marrello is a partner at Imperium Patent Works, LLP. While earning his M.S. and B.S. in Electrical Engineering, Mark worked at Qualcomm Incorporated as a Senior Radio Frequency Integrated Circuit Engineer. Mark's responsibilities included the design, test, and production ramp up of cutting edge multi-mode and multi-band communication devices. After attaining his M.S. in Electrical Engineering, Mark transitioned to Qualcomm's in-house legal department and began attending law school in the evening. Upon attaining his J.D., Mark became the second attorney at Bridgelux Incorporated where he singularly managed all intellectual property matters including building a broad patent and trademark portfolio, managing litigation issues, negotiating licensing agreements, drafting business and employee contracts, and advising the executive team on a variety of strategic initiatives. Mark is admitted to practice before the United States Patent & Trademark Office, all California State Courts, and the United States District Courts for the Northern and Southern Districts of California.

For more information or to contact Mark, please visit his Firm Profile Page.