

**PATENT ELIGIBILITY UNDER 35 U.S.C. 101 – THE FOUR STAGES OF
MESTASTATIC CANCER DESTROYING INVENTORS’ RIGHTS © MARK A.
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THIS IS THE FIRST OF AT LEAST FOUR DOCUMENTS THAT WILL BE PUBLISHED ON-
LINE ADDRESSING THIS ISSUE WHICH IS CRITICAL TO INVENTORS’ RIGHTS.

THE AUTHOR OF THIS PAPER DOES NOT APOLOGIZE FOR THE ACCUSATORY, IF NOT
CONDEMNATORY POSITION TAKEN AGAINST THE USPTO AND THE CAFC IN THIS
OPINION. LET THE READER DECIDE THE FACTS.

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SUMMARY

The USPTO and the Court of Appeals for the Federal Circuit have created a cancerous legal environment that has devoured the foundation of Patent Rights as identified in the enumerated powers of the U.S. Constitution, specifically Article 1, Section 8, Clause 8:

“Clause 8: To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;”

This article asserts and evidences that, contrary to the enumerated powers authorizing promotion of the progress of science and useful arts, the USPTO and the Court of Appeals for the Federal Circuit (CAFC) have created a system implying a technological hierarchy of merit, interpreting “progress” and “useful” according to arbitrary if not personal standards rather than consideration of the invention as a whole within the art most relevant to the invention. (*cf, In re Marco Guldenaar Holding B.V.*, No. 17-2465 (Fed. Cir. 2018); and *In re Smith*, 815 F.3d 816 (Fed. Cir. 2016).)

Although the USPTO and CAFC application of doctrine stretches across numerous technical fields (medicine, pharmacology, computer science and “business methods”), this first article will focus on gaming technology, where this practice has been most clearly invasive and insidious.

LEGAL BACKGROUND

In its simplest terms, a primary issue addressed in this document asserts that the entire line of cases excluding subject matter from patent-eligibility on the basis of including abstract subject matter has been consistently and wrongly interpreted as a generic statement, rather than addressing the specific authorization of the U.S. Supreme Court. That is a mutation of the original document that has metastasized into a fatal disease of the U.S. Patent system.

From the inception of the doctrine of patent-eligibility, since at least 1852, that doctrine has been nearly uniformly and consistently defined by and limited to the concept of:

“Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, **as they are the basic tools of scientific and technological work.**” *Le Roy v. Tatham*, 14 How. 156, 55 U. S. 175 (1852). (**emphasis** added)

Every single US Supreme Court case, C.A.F.C. decision, US District Court and U.S. Court of Appeals decision has used essentially this identical language in citing a basis for its decision, yet the most recent cases (beginning with *Bilski v. Kappos*, *U.S. Commissioner of Patents*, 130 S.Ct. 3218; 561 U.S. 593, 2010 began to ignore the **highlighted** critical limiting phrase present throughout the entire line of precedents. Appellant has not found a single decision after *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*, 134 S. Ct. 2347 (2014), where the scope of the technology has been compared literally to its **direct relationship** to “basic tools of scientific and technological work.” In effect, decisions subsequent to *Bilski, supra* and then especially since *Alice, supra* have ignored that limiting phrase and has interpreted “abstract intellectual concepts” as a generic patent-eligibility exclusion without giving thought or technical analysis to the qualifying language. This is in spite of the fact that the underlying foundation of the doctrine

since its inception should have required an analysis as to whether or not the subject matter was a “basic tool[s] of scientific and technological work.”

This is a doctrinal mutation and the first observable sign of the cancer that exists as the failure to have considered that substantive, qualifying limitation in decisions for the past 160 years (since at least. *Le Roy v. Tatham, supra*). The faulty determination of patent-ineligibility is now based on subject matter being claimed as asserted to be within a generic “abstract intellectual concept.” That is a legal and factual deviation from the 150 years of doctrine and is error. That statement literally applies to the subject matter of current gaming technology claims under examination or under court review. This recent deviation (since 2010) lack of consistent use of the fundamental proper rational underlying justification for this entire realm of legal authority in the field of gaming technology is an embodiment of lack of reasoned guidance across the entire topic of patent-ineligibility of an “abstract idea.”

This mutated body of law has led to a highly disparate subjective application of the concept, which cannot be dispensed with as a mere mondegreen, Freudian slip or malaprop, but is an intentional misuse of the precedents, ignoring the critical limiting phrase with respect to “basic tools of scientific and technological works.”

Inventors’ Rights Background

A good starting point on this subsidiary consideration is to recall that patentability is based on a right of inventors to obtain a patent unless specific criteria are not established (as **highlighted** below). 35 U.S.C. 102 (pre AIA) “Conditions for patentability; novelty and loss of right to patent states that:

“A **person shall be entitled to a patent unless** — [followed by specific events that enumerate actions directly impacting novelty]” and AIA 35 U.S.C. 102 states,

“...[a] **person shall be entitled to a patent unless**—...”

35 U.S.C. 103 dovetails with 35 U.S.C. 102, in which a person shall be entitled to a patent with the further qualifications of:

“Conditions for patentability; non-obvious subject matter” states:

“A patent for a claimed invention may not be obtained [in spite of the entitlement of 35 U.S.C. 1102] , notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, **if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious** before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains. Patentability shall not be negated by the manner in which the invention was made.”

The import of both 35 USC 102 and 35 USC 103 is that they are **specific** with respect to the relationship of the patentability of claimed subject matter with respect to Prior Art, publicly available information relating to the subject matter of the claimed invention. Those two sections are specific as to the statutory requirements with respect to patentability vis-à-vis the prior art (as defined by the listings in 35 USC 102, paragraphs a)-g)).

35 USC 101 is directed towards the broad classification of types of technologies:

“...**any new and useful process, machine**, manufacture, or composition of matter, or any new and useful improvement thereof, **may obtain a patent therefor, subject to the conditions and requirements of this title.**” [Title 35] (**emphasis** added)

The M.P.E.P. states:

“706.03(a) Rejections Under 35 U.S.C. 101 [R-5]:

I. SUBJECT MATTER ELIGIBILITY

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted

only for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."

Note that the limitations stated under 35 U.S.C. 101 limits patentability specifically to "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." This does not specifically impose any heightened requirement form patentability under any other section of the Title (Title 35) and clearly only incorporates the other "conditions and requirements of this title." The additionally imposed limitations were started with *LeRoy, supra*, and were and remain appropriate to the scope of patentability

It is asserted herein that the course of conduct and administration of 35 U.S.C. 101 has extended the scope of authorized limits on patent-eligibility as stated in Title 35 and as defined by Supreme Court decisions (specifically, *Bilski v. Kappos*, 130 S.Ct. 3218; 561 U.S. 593, 2010; *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* 132 S.Ct. 1289, 566 U.S. 593, 2012; *Association for Molecular Pathology v. Myriad Genetics*, 569 U.S. ____ (2013) and *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*, 134 S. Ct. 2347 (2014)).

It is at this juncture that the recent history of 35 U.S.C. 101, beginning with *Bilski, supra*, mutates from an appropriate direction and becomes a cancer which has metastasized throughout court decisions and USPTO policy. In *Bilski, supra*, Justice Kennedy, in a logical process that flows with rational precision, wrote that the claimed invention was not patent-eligible, stating:

"The Court's precedents provide three specific exceptions to §101's broad patent-eligibility principles: 'laws of nature, physical phenomena, and abstract ideas.' *Chakrabarty, supra*, at 309. While these exceptions are not required by the statutory text, they are consistent with the notion that a patentable process must be 'new and useful.' And, in any case, these

exceptions have defined the reach of the statute as a matter of statutory stare decisis going back 150 years. See *Le Roy v. Tatham*, 14 How. 156, 174– 175 (1853). The concepts covered by these exceptions are ‘part of the storehouse of knowledge of all men . . . free to all men and reserved exclusively to none.’ *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U. S. 127, 130 (1948). The §101 patent-eligibility inquiry is only a threshold test. Even if an invention qualifies as a process, machine, manufacture, or composition of matter, in order to receive the Patent Act’s protection the claimed invention must also satisfy ‘the conditions and requirements of this title.’ §101. Those requirements include that the invention be novel, see §102, nonobvious, see §103, and fully and particularly described, see §112.

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“Section 101 similarly precludes the broad contention that the term ‘process’ categorically excludes business methods. The term ‘method,’ which is within §100(b)’s definition of ‘process,’ at least as a textual matter and before consulting other limitations in the Patent Act and this Court’s precedents, may include at least some methods of doing business. See, e.g., Webster’s New International Dictionary 1548 (2d ed. 1954) (defining ‘method’ as ‘[a]n orderly procedure or process . . . regular way or manner of

doing anything; hence, a set form of procedure adopted in investigation or instruction’). The Court is unaware of any argument that the ‘ordinary, contemporary, common meaning,’ *Diehr*, *supra*, at 182, of “method” excludes business methods. Nor is it clear how far a prohibition on business method patents would reach, and whether it would exclude technologies for conducting a business more efficiently. See, e.g., Hall, *Business and Financial Method Patents, Innovation, and Policy*, 56 *Scottish J. Pol. Econ.* 443, 445 (2009) (‘There is no precise definition of . . . business method patents’).

“In *Benson*, the Court considered whether a patent application for an algorithm to convert binary-coded decimal numerals into pure binary code was a “process” under §101. 409 U. S., at 64–67. The Court first explained that ‘[a] principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.’ *Id.*, at 67 (quoting *Le Roy*, 14 *How.*, at 175). The Court then held the application at issue was not a ‘process,’ but an unpatentable abstract idea.

“It is conceded that one may not patent an idea. But in practical effect that would be the result if the formula for converting . . . numerals to pure binary numerals were patented in this case.” 409 U. S., at 71. A contrary holding “would wholly pre-empt the mathematical formula and in practical effect would be a patent on the algorithm itself.” *Id.*, at 72.”

It is important to note that even the minor elucidating deviations from the literal language of *LeRoy*, *supra* made by Justice Kennedy “...The concepts covered by these exceptions are ‘part of the storehouse of knowledge of all men . . . free to all men and reserved exclusively to none.’” still evoke the underlying concept of basic tools of scientific and technological works. There was no substantive movement

away from the original patent-eligibility doctrine, and in fact a cautionary note to focus on the original scope of the doctrine.

Contrary to the actual language and import of the Title, the USPTO, PTOAB and CAFC have taken the established exclusions against patent-eligibility under the guise of “abstract ideas” within *Alice, supra* and *Mayo, supra* and not only attempted to fundamentally alter the requirements of both 35 USC 102 and 35 USC 103. This has been done by requiring independent patentability under these provisions of Title 35 with respect to the “something more” indicated in *Mayo, supra* to evidence conversion of an abstract idea into a concrete patentable invention. This is clear legal error.

This first introduction to this topic concludes with the fact that the doctrine of patent-eligibility is now too often applied in a generic manner to specific levels of technology that are incapable of blocking access to or monopolizing “basic tools of scientific and technological works.” Such specific targets of this stage one of the cancerous mutation of the doctrine are playing card gaming content, novel sets of playing cards/tiles and novel game content on electronic gaming machines. These fields of invention are incapable of blocking these basic tools, and to apply the 150-year old doctrine to them is contrary to the basic Constitutionally mandated “[promoting] the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”

CONCLUSION

This paper has generally identified the first stage of the USPTO and CAFC mutation of centuries old legal doctrine. Subsequent papers will identify both specific areas of technology and possible reasons for this intentional error.

It is worth at least casual note that in the practice of Patent Law, practitioners are held to a well-defined and specific standard of clarity detailed in 35 U.S.C. §112(a) for drafting patent applications that:

“35 U.S.C. 112, The Specification, (a) IN GENERAL.—The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same...”²⁷

In spite of this legislated background of high standards for linguistic precision in the field of drafting patent applications, the U.S. Supreme Court, the Court of Appeals for the Federal Circuit and the U.S. Patent and Trademark office have issued decisions and published guidelines on Patent Law that would not satisfy the standards required for the patent documents impacted by their decisions and guidelines. (e.g., Mark A. Litman, *Deficiencies in the Decision and USPTO Application of Mayo Collaborative Services, d.b.a. Mayo Medical Laboratories,*