

In The
Supreme Court of the United States

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ALICE CORPORATION PTY. LTD.,
Petitioner,

v.

CLS BANK INTERNATIONAL, *et al.*,
Respondents.

————— ♦ —————
ON WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

————— ♦ —————
BRIEF OF AMICUS CURIAE
CONEJO VALLEY BAR ASSOCIATION
IN SUPPORT OF NEITHER PARTY

————— ♦ —————
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Dated: January 28, 2014

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**Brief Of *Amicus Curiae*
Conejo Valley Bar Association
In Support Of Neither Party¹**

INTEREST OF THE *AMICUS CURIAE*

Based in the heart of Southern California's 101 Technology Corridor, the Conejo Valley Bar Association draws its membership from local law firms and in-house attorneys serving small, mid-market and large companies. Our members' clients are predominantly high tech, high growth companies in fields such as software, biotech, e-commerce, telecommunications, semiconductors and medical devices. Our members' clients are innovators who vend in some of the world's most competitive markets.

When public policies of the patent system are at issue, the Conejo Valley Bar Association regularly participates as *amicus curiae* in cases before the Court and *en banc* panels of the Court of Appeals for the Federal Circuit. We are unconcerned with the outcome of the cases, though decidedly concerned about the issues. We wish to see the American public benefit from innovation, from technical disclosure,

¹ Pursuant to Supreme Court Rule 37.6, Amicus states that no counsel for a party authorized this brief in whole or in part and that no person or entity other than Amicus, its members, and its counsel contributed monetarily to the preparation or submission of this brief. On December 11, 2013, counsel for the respondents and counsel for the petitioner consented to the filing of *amicus curiae* briefs, in support of either party or of neither party. With the consent of the parties, the Conejo Valley Bar Association submits this brief *amicus curiae* in support of neither party.

and from competition in product and service markets. In short, we support the purpose of the patent system. The Conejo Valley Bar Association believes that the patent laws should be interpreted in ways that best serve these important public policies.

INTRODUCTION AND SUMMARY OF ARGUMENT

The underlying purpose of patent law is to encourage the development of inventions that provide value and benefit for society. The Patent Act makes clear that any new and useful process, machine or article of manufacture is patent-eligible. Whether software is claimed as a method (process), a computer/system (machine) or manufacture (storage medium) is irrelevant. None of these broad categories is “abstract” and, therefore, all are inherently patent-eligible. As a result, any new test to determine which kinds of software are patentable under § 101 is unnecessary. Unless other sections of the Patent Act prevent a patent’s issuance, all software, whether claimed as a process, machine or article of manufacture, is patentable.

Instead, through scrupulous application of other key provisions in the Patent Act, especially 35 U.S.C. §§ 102 (novelty), 103 (obviousness) and 112 (specification), the Patent and Trademark Office and the courts protect the public from software patents that seek to take too much from society. These other provisions of the Patent Act, not § 101, serve as more than adequate gatekeepers to restrict patents to new, novel and unobvious inventions that meet the requirements of all provisions in the Patent Act. In particular, these other provisions of the Patent Act already provide an adequate measure of whether a claimed invention is “abstract” because abstract ideas are inherently in the prior art.

Therefore, if a patent or patent application passes muster under all provisions of the Patent Act, the inventor can have a patent – but only for the “limited times” of the grant mandated by the Constitution and embodied in 35 U.S.C. § 154. Limiting the form of patent-eligible software will reduce the incentive to patent and decrease the number of patentable inventions, causing vital and important inventions to be lost or otherwise secreted from society contrary to the purpose of patent law.

ARGUMENT

“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and the useful Arts.’”² “The public interest, of course, favors the maintenance of a well-functioning patent system.”³ The Court’s “statutory subject matter” jurisprudence has made this impossible. In trying to solve the problem of bad patents, the Court has set loose a massive Category F5⁴ tornado, leaving random carnage and uncertainty in its path. As Judge Rader said in the Federal Circuit *en banc* decision leading up to this case, one must “consult the statute!”⁵ to understand the proper place of § 101 in the Patent Act.

² *Mazer v. Stein*, 347 U.S. 201, 219 (1954).

³ *Medtronic v. Mirowski Family Ventures, LLC*, 571 U.S. ____ (2014).

⁴ In the immortal words of Amblin Entertainment’s 1996 film, *Twister*:

Bill Harding: It’s the Fujita scale. It measures a tornado’s intensity by how much it eats.

Melissa Reeves: Eats?

Bill Harding: *Destroys*.

Brian Laurence: That one we encountered back there was a strong F2, possibly an F3.

[. . .]

Melissa Reeves: Is there an F5? What would that be like?

Jason ‘Preacher’ Rowe: The Finger of God.

⁵ *CLS Bank Int’l. v. Alice Corp.*, 717 F.3d 1269, 1335 (Fed. Cir. 2013) (*en banc*) (Rader, C.J., Additional Reflections)

I. Limiting the Kinds of Patentable Processes Can Only Be Overreaching Judicial Legislation

It is within the purview of Congress to change what constitutes patentable subject matter.⁶ This is not a judicial task. Such is the case here. The Court is faced with deciding whether claims to computer-implemented inventions are directed to patentable subject matter under § 101. In deciding this issue, the Court needs merely to rely on the Patent Act. The broadness of § 101 is limited by the gatekeeper provisions of §§ 102, 103 and 112. Unnecessarily limiting § 101 likely will damage a significant part of the U.S. economy.⁷ Section 101 was intended to be interpreted broadly and the Court should reinforce such an understanding.

Any tests by the judiciary to limit processes deemed patentable are directly contrary to the language and intent of the Patent Act. The Patent Act says what it means and means what it says when it states that a patent may be obtained for “**any** new and useful process, machine, and article of manufacture or composition of matter.”

⁶ In addressing changes to the Copyright Act, the Court reached the same conclusion: “The [Copyright Term Extension Act] reflects judgments of a kind Congress typically makes, judgments we cannot dismiss as outside the Legislature’s domain.” *Id.* at 205.

⁷ *CLS Bank v. Alice Corp.*, 717 F.3d at 1313 (Moore, J., dissenting-in-part) (stating that under the reasoning of the plurality opinion, 320,799 patents granted from 1998-2011 would presumably also be invalid).

The Patent Act does not recite that only chemical processes or machine-based processes may be patented, and the Act does not recite that business methods and software may not be patented. It simply recites that “**any** new and useful process, machine, article of manufacture or composition of matter” may be patented.

Nothing in the Patent Act or its history hints that the kinds of inventions that are patentable subject matter should be less than “any.”

Reading limitations that Congress did not intend into the statute risks stifling instead of encouraging innovation. Inventors and investors need encouragement to invest in research and innovation. They should know their successful research and innovation will be rewarded. Limiting the ways in which an inventor can claim software and software-related inventions hinders inventors from passionately pursuing their ideas since there would be no reward for investing time, capital, resources and effort in pursuing their innovative ideas.

The Patent Act reflects a balance created by Congress between public and private interests, one which this Court has been loath to alter.⁸ Excluding software inventions from patentability or requiring that inventions be claimed in specific forms, forces companies to maintain more valuable knowledge in secrecy. This will decrease the pool of prior art and

⁸ See *Stewart v. Abend*, 495 U.S. 207, 230 (1990) (“[I]t is not our role to alter the delicate balance Congress has labored to achieve”).

will create little incentive for inventors to disclose their inventions. The underlying Constitutional purpose of the patent system and Congress' balances will be upset. "Calibrating rational economic incentives, however, like fashioning new rules in light of new technology is a task primarily for Congress not the courts."⁹

II. The Statutory Language of § 101 and the Legislative Intent Support a Broad Interpretation of § 101's Processes, Machines, Manufactures and Compositions of Matter

The Constitution grants Congress broad power to legislate 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."¹⁰ The Constitution expresses a public policy of promoting innovation. In exchange for innovation, the inventor receives the exclusive right to commercialization of the claimed invention for a limited time.

Abraham Lincoln stated in his "Second Lecture on Discoveries and Inventions":

Next came the Patent laws. These began in England in 1624; and, in this country, with the adoption of our constitution. Before then, any man might instantly use what another had

⁹ *Eldred v. Ashcroft*, 537 U.S. 186, 207 (2003).

¹⁰ *Diamond v. Chakrabarty*, 447 U.S. 303, 307 (1980) (citing Art. I, § 8, cl. 8).

invented; so that the inventor had no special advantage from his own invention. The patent system changed this; **secured to the inventor, for a limited time, the exclusive use of his invention; and thereby added the fuel of interest to the fire of genius, in the discovery and production of new and useful things.** (emphasis added)

The Patent Act embodies these ideals by striking a careful balance between competing public and private interests in order to promote innovation. In this regard, the statute promises:

Whoever invents or discovers **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.^{11,12}

The central inquiry in this case turns on how broadly to construe “*process*,” “*machine*,” and “*manufacture*,” when determining what constitutes patentable subject matter. This Court in *Bilski v.*

¹¹ 35 U.S.C. § 101 (emphasis added).

¹² Citations herein are to the Pre-AIA Patent Act. Amendments to the Patent Act have been made in these sections, but as the case is based upon several Pre-AIA patents, Pre-AIA citations have been used. Changes under the AIA are not significant to this case.

*Kappos*¹³, *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*¹⁴ and in *Diamond v. Chakrabarty*¹⁵ recognized that § 101 has broad scope.¹⁶ The Court in *Chakrabarty* stated:

The subject-matter provisions of the patent law have been cast in broad terms to fulfill the constitutional and statutory goal of promoting “the Progress of Science and the useful Arts” with all that means for the social and economic benefits envisioned by Jefferson. Broad general language is not necessarily ambiguous when congressional objectives require broad terms.¹⁷

In the middle of the nineteenth century, the Court stated: “[A process] is included under the general term ‘useful art’. An art may require one or more processes or machines to produce a certain result or manufacture.”¹⁸ Many years later, the Court explained: “A process is an act or mode of acting, . . . a conception of the mind, seen only by its effects when being executed or performed.”¹⁹ Though these cases do not address the term “process” in § 101, they demonstrate the historically broad interpretation of § 101.

¹³ *Bilski v. Kappos*, 130 S. Ct. 3218, 3225 (2009).

¹⁴ *J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.*, 534 U.S. 124 (2001).

¹⁵ *Chakrabarty*, 447 U.S. at 303.

¹⁶ *J.E.M. Ag Supply, Inc.*, 534 U.S. 130-131.

¹⁷ *Chakrabarty*, 447 U.S. at 315.

¹⁸ *Corning v Burden*, 56 U.S. 252, 267 (1854).

¹⁹ *Tilghman v. Proctor*, 102 U.S. 707, 728 (1881).

In addition, the legislative intent calls for a broad interpretation of § 101. In *Chakrabarty*, the Court noted that by choosing expansive terms such as “manufacture,” “compositions of matter” and the comprehensive modifier “any” in § 101, Congress intended that the patent laws would receive broad scope.²⁰ Similarly, Congress’ intent in choosing an expansive word such as “process” ensured that § 101 would be construed broadly for processes that could be patented.

Section 100(b) also supports a broad construction of “process.” The section states that “process” “means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”²¹ If Congress intended a narrow interpretation of “process,” it could have defined the term with limiting language. However, Congress nowhere expressed such intent. Instead, §§ 100(b) and 101 use expansive language to define “process.” Thus, any narrow interpretation of § 101 is contrary to its language.

The Court in *Chakrabarty* also explained that the legislative history supported a broad construction of the § 101.²² In particular, the Court stated:

The Patent Act of 1793, authored by Thomas Jefferson, defined statutory subject matter as “any new and useful

²⁰ *Chakrabarty*, 447 U.S. at 308.

²¹ 35 U.S.C. § 100(b).

²² *Chakrabarty*, 447 U.S. at 308.

art, machine, manufacture, or composition of matter, or any new or useful improvement [thereof].” The Act embodied Jefferson’s philosophy that “ingenuity should receive a liberal encouragement.” Subsequent patent statutes in 1836, 1870, and 1874 employed this same broad language. In 1952, when the patent laws were recodified, Congress replaced the word “art” with “process,” but otherwise left Jefferson’s language intact. The Committee Reports accompanying the 1952 Act inform us that Congress intended statutory subject matter to **“include anything under the sun that is made by man.”**

Even more recently, the Court declined to impose limitations on the meaning of “process” in 35 U.S.C. § 100(b).²³ The Court also made clear that the machine-or-transformation test was insufficient to act as the sole arbiter of whether a “process” was statutory.²⁴ Instead, the Court held that “the § 101 patent-eligibility inquiry is only a threshold test.”²⁵

Thus, an examination of the patent laws and the legislative intent all indicate that § 101 ensures that any process, machine or manufacture is patentable so long as it withstands the Patent Act’s other requirements.

²³ *Bilski*, 130 S. Ct. at 3128.

²⁴ *Id.* at 3226.

²⁵ *Id.* at 3225.

III. The Patent Act Already Limits What Inventions May Be Patented

Instead of the courts inventing their own restrictions on patentable subject matter through interpretation of § 101, the public policy of promoting innovation is best served by allowing the rest of the Patent Act, namely §§ 102, 103 and 112²⁶, to serve as the proper gatekeeper limiting those processes meriting a patent.

a. Inventions Must Be Novel

Section 102 describes the statutory novelty required for patentability:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country more than one

²⁶ *Id.* at 3229. (“[Sections 102, 103 and 112] serve a critical role in adjusting the tension, ever present in patent law, between stimulating innovation by protecting inventors and impeding progress by granting patents when not justified by the statutory design.”).

year prior to the date of application for patent in the United States. . .²⁷

In *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*,²⁸ the Court stated:

Sections 102(a) and (b) operate in tandem to exclude from consideration for patent protection knowledge that is already available to the public. They express a congressional determination that the creation of a monopoly in such information would not only serve no socially useful purpose, but would in fact injure the public by removing existing knowledge from public use.²⁹

Further, in *Pfaff v. Wells Elecs., Inc.*³⁰ the Court stated:

Consistent with these ends, § 102 of the Patent Act serves as a limiting provision, both excluding ideas that are in the public domain from patent protection and confining the duration of the monopoly to the statutory term.

²⁷ 35 U.S.C. § 102(a) and (b); see also *In re Bergstrom*, 427 F.2d 1394, 1401 (C.C.P.A. 1970) (holding “[T]he criteria for determining whether given subject matter is ‘new’ within the meaning of § 101 are no different than the criteria for determining whether that subject matter possesses the ‘novelty’ expressed in the title of § 102.

²⁸ 489 U.S. 141 (1989).

²⁹ 489 U.S. at 148.

³⁰ 525 U.S. 55 (1998).

That is, § 102 ensures that even subject matter patentable under § 101 nonetheless may not deserve patent protection because the subject matter is not “novel” under § 102. Thus, § 102 serves as an important constraint that ensures not *all* patent-eligible subject matter receives patent protection.

b. Patentable Inventions Cannot be Obvious Variations of the Prior Art

Section 103’s “nonobviousness” requirement further limits patent protection to material that cannot be readily created from publicly available material.³¹ Specifically, § 103(a) forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”³² Thus, subject matter patentable under § 101 may not receive patent protection when it is incapable of withstanding the nonobviousness requirements of § 103. In this way the Patent Act provides another significant limit on the broad term “process” used in § 101.

The Court’s recent decision in *KSR* further protects the public from the over breadth concerns that may arise from construing § 101 patent eligibility broadly:

³¹ *Bonito Boats* at 150.

³² *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007), quoting 35 U.S.C. § 103.

The principles underlying these cases are instructive when the question is whether a patent claiming the combination of elements of prior art is obvious. When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.³³

As technologies continue to advance, the threshold used to determine whether the innovation is ordinary or nonobvious continues to escalate.³⁴ Specifically, the Court stated:

We build and create by bringing to the tangible and palpable reality around us new works based on instinct, simple logic, ordinary inferences, extraordinary ideas, and sometimes even genius. These advances, once part of our shared knowledge, define a new threshold from which innovation starts

³³ *Id.* at 417.

³⁴ *Id.* at 427.

once more. And as progress beginning from higher levels of achievement is expected in the normal course, the results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, § 8, cl. 8. These premises led to the bar on patents claiming obvious subject matter established in *Hotchkiss* and codified in § 103. **Application of the bar must not be confined within a test or formulation too constrained to serve its purpose.**³⁵

As the Court recognized in *KSR*, by imposing constraints, we risk not achieving the fundamental purpose of the patent law. Just as the “teaching, suggestion, motivation” (TSM) test for nonobviousness which the Court rejected in *KSR* as too constraining, a narrow interpretation of § 101 also will be too constraining when deciding what constitutes patentable subject matter.

c. The Patent Act Requires Full Disclosure of the Invention

Section 112 limits patents to those that provide full disclosures of the inventions:

The specification shall contain a written description of the invention, and of the manner and process of making and

³⁵ *Id.* (emphasis added).

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, and shall set forth the best mode contemplated by the inventor of carrying out his invention.³⁶

Thus, through § 112, Congress limited patent protection to those patents having a clear and complete description of the invention. The patent must provide enough description to enable others to make and use the invention. And the patent must disclose the best mode of carrying out the invention. These requirements ensure that patentees do not receive overly broad scope in patent protection. Instead, patentees receive protection only for what they *really* invented. Consequently, the public receives a full and fair disclosure in exchange for the limited protection afforded by a patent.

d. Inventions must be Definite

Section 112, ¶ 2, places further limits on patentability by requiring the patentee to “particularly point out and distinctly claim the subject matter which the inventor regards as carrying out his invention.” Complying with section 112 requires patentees to definitively identify the subject matter being claimed. Through this section, Congress evinced an intent that the claims be clear about what subject matter is within the scope of the claim.

³⁶ 35 U.S.C. § 112, ¶ 1.

Claims that are “abstract,” or lack definitive limitations, fail to meet the burden imposed by Section 112, paragraph 2, because they fail to put the public on notice as to the actual scope of the claims. Such claims, properly understood, are not attempts to claim patent ineligible subject matter — the subject matter remains patent eligible. Instead, they are attempts to claim so broadly or obliquely that the applicant/patentee fails to “particularly point out and distinctly claim” the subject of the claims under § 112. After a threshold inquiry regarding § 101, § 112, ¶ 2 addresses claims that are too broadly written.

e. Inventions Must Be Useful

In *Brenner v. Manson*³⁷, the Court explained:

The basic *quid pro quo* contemplated by the Constitution and the Congress for granting a patent monopoly is the benefit derived by the public from an invention with substantial utility. Unless and until a process is refined and developed to this point - where specific benefit exists in currently available form - there is insufficient justification for permitting an applicant to engross what may prove to be a broad field.³⁸

Section 101 explicitly limits patent protection to inventions with utility by requiring, “Whoever

³⁷ *Brenner v. Manson*, 383 U.S. 519 (1966).

³⁸ *Id.* at 534-35.

invents or discovers any new and *useful* process, machine [or] manufacture “ should be entitled to patent protection.³⁹ As such, § 101 does not allow all inventions to receive patent protection -- only those that provide some *utility*. The Court in *Brenner* recognized that allowing inventors to receive a patent on a process that has no utility would enable inventors to obtain a hunting license.⁴⁰ That is, it would reward them merely for searching for some invention, regardless of whether the invention provided any benefit to the public.⁴¹ This utility requirement is another constraint on patentable subject that is built into § 101.

Therefore, *any* process, machine, article of manufacture or composition of matter may constitute patentable subject matter, but it will receive patent protection only if it meets all other requirements of the Patent Act, including §§ 102, 103 and 112. The gatekeeper provisions of §§ 102, 103 and 112 reward true innovation by allowing that only worthy advances in the broad patentable subject matter of § 101 are granted patents.

IV. The Twenty Year Term is an Absolute Limit on Any Patent that Overcomes the Hurdles of Novelty, Nonobviousness and Disclosure

Patents are not diamonds; they do not last forever. They are more like cabbage, which takes some time to grow, but will eventually return to base

³⁹ 35 U.S.C. § 101

⁴⁰ *Brenner*, 383 U.S. at 534-35.

⁴¹ *Id.*

organic matter. In time, patents expire. Through the simple mechanism of expiration, the framers in the Constitution and Congress in the Patent Act provided absolute limits on what is patented. Under § 154, most patents expire twenty years after the inventor first applied for patent protection. Thus, even if an invention passes the novelty, nonobviousness and usefulness tests, and the patent specification satisfies the disclosure requirements, no matter how big or small the invention, the patent will expire.

The PTO's published statistics demonstrate that examination of applications for patents in some areas of technology take longer than applications in other areas. Congress and the PTO through resource allocation have in effect controlled the patent term of different types of inventions. The time from filing of a patent application to its grant for business methods has historically been some of the longest. Pendency grows for many different reasons. The PTO's own backlog leads to deferral of the start of examination on many patent applications. PTO procedures requiring several patent examiners to review allowance of patents in some fields has also delayed the grant of patents and limited the scope of their claims. Although informal, these procedures suppress some types of patents and, at times, have been particularly effective against software-related applications. This is long-standing practice and one that Congress can control. Court intervention is unnecessary.

CONCLUSION

In sum, a broad interpretation of § 101 is essential to maintain the public policy of promoting innovation. If an invention passes the tests Congress established in §§ 102, 103 and 112, it is patentable. The Patent Act neither expresses nor mandates any further test. “[T]he applicant whose invention satisfies the requirements of novelty, nonobviousness, and utility, and who is willing to reveal to the public the substance of his discovery and ‘the best mode . . . of carrying out his invention,’ is granted ‘the right to exclude others from making, using, or selling the invention throughout the United States’ for a limited time.”⁴² Accordingly, the public policy of promoting innovation is best served by maintaining the entire breadth of § 101 intended by Congress. Let §§ 102, 103, and 112 remain the primary limitations on all patentable subject matter.

For the foregoing reasons, we, the Conejo Valley Bar Association, urge the Court to construe § 101 broadly and find that claims directed to systems, machines, processes and items of manufacture are all patent-eligible, subject to the other limitations imposed by the Patent Act. Furthermore, we urge the Court not to place any additional limit on the form in which software may be claimed, and to overrule any prior limitations that exist, except those already expressed in the Patent Act.

⁴² *Bonito Boats*, 489 U.S. at 150 (citation omitted).

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January 28, 2014