Rethinking the Scope of § 101 Patent-Eligibility: A New Proposal

Attached to the pdf version of this note is a draft of a paper, Rethinking Patent-Eligibility: Whither Alice (A Non-Statutory Fix to Overcome Alice).

**Overcoming Alice**: The paper proposes a non-statutory, case law reform of Section 101 case law in the wake of Alice Corp. Pty. Ltd. v. CLS Bank to open the door once again to patenting innovations in the biotechnology and software areas that are currently difficult or impossible to patent under Alice.

Comments would be appreciated.

Thank you.

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RETHINKING PATENT-ELIGIBILITY: WHITHER ALICE  
(A NON-STATUTORY FIX TO OVERCOME ALICE)*

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DETAILED TABLE OF CONTENTS  

I. OVERVIEW  

II. ALICE “PATENT PREEMPTION” TO DENY PATENT-ELIGIBILITY  

III. A TRANSFORMATIVE METHOD  

IV. “SUMMARY”, A CHANGE IN THE RULES OF PRACTICE  

V. CONCLUSION  

ABOUT THE AUTHOR  

* This paper focuses upon a practical, non-statutory approach to deal with the patent practice consequences of Alice Corp. Pty. Ltd. v. CLS Bank Intern., 134 S.Ct. 2347 (2014)(Thomas, J.),

This paper benefits from appearances this week with co-panelists before several groups in Tokyo and Osaka. The writer thanks his colleagues on these panels for their contributions and inspiration as reflected in this paper. This paper: June 18, 2017.

** This paper is without sponsorship from any other person or organization. Biographical information is found on the last page.
DETAILED TABLE OF CONTENTS

I. OVERVIEW 3

II. ALICE “PATENT PREEMPTION” TO DENY PATENT-ELIGIBILITY 5

A. Mueller Study of “Experimentation On” a Patented Invention 8
B. The Ghost of Deuterium 10
   1. The Mischief of Deuterium 10
   2. The State of the Law Today 11
   3. An En Banc Exorcism 12

III. A TRANSFORMATIVE METHOD 13

A. The Diehr Model 13
B. Multi-Step Process Claims 17

IV. “SUMMARY”, A CHANGE IN THE RULES OF PRACTICE 17

V. CONCLUSION 19

ABOUT THE AUTHOR 20
I. OVERVIEW

In the wake of *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*., 134 S.Ct. 2347 (2014)(Thomas, J.), the attempts of the patent community to claim subject matter within the scope of patent-eligibility under 35 USC § 101 has been severely tested in both the areas of software and biotechnology. The extreme situation has been underscored by various intellectual property organizations which have drafted proposed legislation for introduction into the Congress, each taking slightly different approaches where the common goal is to eviscerate *Alice.*

This paper takes a different approach and instead focuses upon a practical way to distinguish some Supreme Court case law or to provide a disclaimer to avoid other case law.

Essential is the need to return the law to the state before the notorious *Deuterium* case where experimentation “on” a patented invention is free from infringement. This point is critical to distinguish the *Alice* case. As a short term fix, a disclaimer of enforcement is proposed for use of the claimed invention solely for an experimentation “on” the patented invention. *See § II, Alice “Patent Preemption” to Deny Patent-Eligibility.*
Also essential to this proposal is whether the invention is to software or a biotechnology method, the essence of the invention should be married in the claim to a physical object. See § III, A Transformative Method. At the heart of this proposal is the inclusion in the Summary of the Invention of an express limitation of the claimed invention to a combination of all elements of the claim, which distinguishes this case from Supreme Court rulings that have dissected claims into their elements.

Although not absolutely essential, it is desirable that the Rules of Practice in Patent Cases should be amended to encourage applicants to include statements of criticality of all components of the claimed invention as part of the Summary of the Invention. See § IV, “Summary”, A Change In The Rules Of Practice
II. **ALICE “PATENT PREEMPTION” TO DENY PATENT-ELIGIBILITY**

The heart of this proposal is a Disclaimer of Scope and Enforcement that should appear immediately after the Title in a new application:

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**DISCLAIMER OF SCOPE AND ENFORCEMENT**

[to appear immediately after the Title]

Applicant hereby expressly disclaims (a) any right to exclude others as to any claim where an embodiment otherwise within the scope of such a claim involves less than all the elements of such claim and thus is not an infringement under the “all elements” rule of *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed. Cir. 1987) (en banc)(requiring that “all elements” of a claim be practiced for a finding of infringement), particularly inasmuch as Applicant hereby defines “all elements” of each claim as critical features of each such claim and limits the interpretation of each claim to a combination of all features defined in each such claim; and (b) enforcement of any claim against any member of the public who operates under any claim with activities strictly limited to an “experimentation on” the patented invention as the quoted term is defined by Professor Janice M. Mueller, *No ‘Dilettante Affair’: Rethinking the Experimental Use Exception to Patent Infringement for Biomedical Research Tools*, 76 Wash. L.Rev. 1 (2001).

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A. **Alice “Preemption”**

Patent “preemption” to preclude further research is the basis for the broad denial of patent-eligibility in the *Alice* case.\(^1\) Thus, in the *Alice* case, the entire reason to deny patent-eligibility was patent preemption:

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\(^1\) *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*., 134 S.Ct. 2347 (2014)(Thomas, J.).
Section 101 of the Patent Act defines the subject matter eligible for patent protection. It provides:

“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.” 35 U.S.C. § 101.

“We have long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.” Association for Molecular Pathology v. Myriad Genetics, Inc., 133 S.Ct. 2107, 2116 (2013) (internal quotation marks and brackets omitted). We have interpreted § 101 and its predecessors in light of this exception for more than 150 years. Bilski v. Kappos, 561 U.S. 593, 601-02 (2010); see also O'Reilly v. Morse, 15 How. 62, 112–120 (1854); Le Roy v. Tatham, 14 How. 156, 174–175 (1853).

We have described the concern that drives this exclusionary principle as one of pre-emption. See, e.g., Bilski, supra, at 611–612 (upholding the patent “would preempt use of this approach in all fields, and would effectively grant a monopoly over an abstract idea”). Laws of nature, natural phenomena, and abstract ideas are “‘the basic tools of scientific and technological work.’” Myriad, supra, 133 S.Ct. at 2116. “[M]onopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it,” thereby thwarting the primary object of the patent laws. Mayo, supra, 132 S.Ct., at 1923; see U.S. Const., Art. I, § 8, cl. 8 (Congress “shall have Power ... To promote the Progress of Science and useful Arts”). We have “repeatedly emphasized this ... concern that patent law not inhibit further discovery by improperly tying up the future use of” these building blocks of human ingenuity. Mayo, supra, 132 S.Ct., at 1301 (citing Morse, supra, at 113).

At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law. Mayo, 132 S.Ct. at 1293–1294. At some level, “all inventions ... embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” Id., 132 S.Ct., at 1293. Thus, an invention is not rendered ineligible for patent simply because it involves an abstract concept. See Diamond v. Diehr, 450 U.S. 175, 187 (1981). “[A]pplication[s]” of such concepts “‘to a new and useful end,’ ” we have said, remain eligible for patent protection. Gottschalk v. Benson, 409 U.S. 63, 67 (1972).
Accordingly, in applying the § 101 exception, we must distinguish between patents that claim the “‘building block[s]’ ” of human ingenuity and those that integrate the building blocks into something more, Mayo, 132 S.Ct., at 1303, thereby “transform[ing]” them into a patent-eligible invention, id., 132 S.Ct., at 1294. The former “would risk disproportionately tying up the use of the underlying” ideas, id., 132 S.Ct., at 1294, and are therefore ineligible for patent protection. The latter pose no comparable risk of pre-emption, and therefore remain eligible for the monopoly granted under our patent laws.  

The Court in Alice continued to confirm the patent-eligibility of the Diehr invention:

In Diehr, 450 U.S. 175, by contrast, we held that a computer-implemented process for curing rubber was patent eligible, but not because it involved a computer. The claim employed a “well-known” mathematical equation, but it used that equation in a process designed to solve a technological problem in “conventional industry practice.” Id., at 177, 178. The invention in Diehr used a “thermocouple” to record constant temperature measurements inside the rubber mold—something “the industry ha[d] not been able to obtain.” Id., at 178, and n. 3. The temperature measurements were then fed into a computer, which repeatedly recalculated the remaining cure time by using the mathematical equation. Id., at 178–79. These additional steps, we recently explained, “transformed the process into an inventive application of the formula.” Mayo, supra, 132 S.Ct., at 1299. In other words, the claims in Diehr were patent eligible because they improved an existing technological process, not because they were implemented on a computer.  

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2 Alice v. CLS Bank, 134 S.Ct. at 2354-55 (emphasis supplied).

3 Alice v. CLS Bank, 134 S.Ct. at 2358.
B. Mueller Study of “Experimentation On” a Patented Invention

When properly understood, a patent does not (or at least should not) preclude further research using the patented invention. Professor Mueller points out that the NIH Working Group, made a comparative study of international patent systems. She concludes that an experiment “on” a patented invention which is necessary to conduct further research should be a noninfringing event versus a commercial experimentation “with” a patented invention. She provides the following analysis of the NIH study:

The NIH Working Group contends that these foreign patent systems properly distinguish between “experimenting on a patented invention – i.e., using a patented invention to study the underlying technology or perhaps to invent around the patent,” and “experimenting with a patented invention to study something else.”


“It is difficult to imagine how a broader research exemption could be formulated without effectively eviscerating the value of patents on research tools. Researchers are ordinary consumers of patented research tools, and if these consumers were exempt from infringement liability, the patent holder would have nowhere else to turn to collect patent royalties. An excessively broad research exemption could eliminate incentives for private firms to develop and disseminate new research tools, which could on balance do more harm than good to the research enterprise.” The Working Group's position that a broadened experimental use rule should not be available to those “working with” a patented invention (e.g., those using the

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patented invention as a research tool) is reasonable only if such workers are truly “ordinary consumers” of the tool. In other words, these research workers can freely acquire the tools they need in the marketplace at reasonable cost via anonymous purchasing without the need for licensing transactions. The growing incidence of high transaction costs associated with accessing multiple patented research tools contravenes the ordinary consumer assumption, however. When research tool transaction costs are severe enough to impede or stop the development of new biomedical products, line-drawing between “experimenting on” and “experimenting with” is no longer justified. In such cases, access to the experimental use doctrine should not turn on the relatively fine distinction between experimenting on or experimenting with the patented invention. [The general notion of discerning whether a patented invention has been “experimented on” rather than “experimented with” may be an exercise in semantics. Consider, for example, the case of a widget manufacturer who seeks to avoid infringement liability by designing around the widget patent of a competitor. The manufacturer's goal is to develop an acceptable but non-infringing alternative. Has the manufacturer experimented on the competitor's widget in designing around it, or experimented with it?] The Working Group's concern that a broadened experimental use doctrine would leave holders of research tool patents uncompensated and without sufficient incentives to develop new research tools is a valid one if all non-consensual tool users were given a complete exemption from liability. A more viable alternative, however, is the adoption of a liability rule under which the patent holder cannot enjoin the researcher's use, but will obtain an ex post royalty based on the marketplace valuation of products developed through use of the tool. The research user’s access problem is alleviated because a license need not be negotiated prior to the use and an appropriate level of royalty to the patent holder will ensure that incentives to innovate are not significantly decreased.5

5 Id., 76 Wash. L.Rev. at 39-40 (footnotes integrated into text in brackets or omitted).
C. The Ghost of Deuterium

1. The Mischief of Deuterium

The 1990 Deuterium opinion has cast a dark shadow over the patent system that has manifested itself in several high profile cases including Madey v. Duke⁶ and Integra Lifesciences I v. Merck.⁷ Deuterium was authored by a freshly minted jurist (the youngest member in the history of the Federal Circuit), just a matter of months removed from his position as a Hill staffer (his only occupation

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⁶ Madey v. Duke University, 307 F.3d 1351, 1355 (Fed. Cir. 2002)(Gajarsa, J.) (“The district court acknowledged a common law ‘exception’ for patent infringement liability for uses that, in the district court's words, are ‘solely for research, academic or experimental purposes.’ Summary Judgment Opinion at 9 (citing Deuterium Corp. v. United States, 19 Cl.Ct. 624, 631 (1990); Whittemore v. Cutter, 29 F. Cas. 1120 (C.C.D.Mass.1813) (No. 17,600); and citing [Janice M. Mueller, No ‘Dilettante Affair’: Rethinking the Experimental Use Exception to Patent Infringement for Biomedical Research Tools, 76 Wash. L.Rev. 1, 17 (2001); 5 Chisum on Patents § 16.03[1] (2000)]).. The district court recognized the debate over the scope of the experimental use defense, but cited this court's opinion in Embrex, Inc. v. Service Engineering Corp., 216 F.3d 1343, 1349 (Fed.Cir.2000) to hold that the defense was viable for experimental, non-profit purposes. Summary Judgment Opinion at 9 (citing Embrex, 216 F.3d at 1349 (noting that courts should not construe the experimental use rule so broadly as to allow a violation of the patent laws in the guise of ‘scientific inquiry,’ when that inquiry has definite, cognizable, and not insubstantial commercial purposes’ (quoting Roche Prods., Inc. v. Bolar Pharm. Co., 733 F.2d 858, 863 (Fed.Cir.1984)))).” (footnotes omitted or integrated into text in brackets).

⁷ Integra Lifesciences I, Ltd. v. Merck KGaA, 331 F.3d 860, 863 n.2 (Fed. Cir. 2003)(Rader, J.), judgment vacated sub nom Merck KGaA v. Integra Lifesciences I, Ltd., 545 U.S. 193 (2005)(“Judge Newman's dissent *** does not mention that the Patent Act does not include the word “experimental,” let alone an experimental use exemption from infringement. See 35 U.S.C. § 271 (2000). Nor does Judge Newman's dissent note that the judge-made doctrine is rooted in the notions of de minimis infringement better addressed by limited damages. Embrex v. Service Eng'g Corp., 216 F.3d 1343 (Fed.Cir.2000) (Rader, J., concurring); see also Deuterium Corp. v. United States, 19 Cl.Ct. 624, 631 (Cl.Ct.1990) (“This court questions whether any infringing use can be de minimis. Damages for an extremely small infringing use may be de minimis, but infringement is not a question of degree.”).
as a member of the legal profession). Yet, the ghost of Deuterium casts its shadow over the past more than twenty-five years as manifested by the reluctance of the Court to create an *en banc* panel to exorcise the ghost of its departed Chief Judge.

The author of the *Embrex* concurrence went so far as to pejoratively label the experimental use basis for noninfringement as “an *experimental use excuse*”.

2. The State of the Law Today

It makes no sense to have a patent system that discourages further research on a patented invention. It is only in the past generation that ambiguous holdings have crept into the Federal Circuit which have denied the right to “experiment on” a patented invention, yet the Federal Circuit sends at best mixed messages through its opinions.

To date, a Federal Circuit majority has not seen fit to grant *en banc* review to the mixed messages the various panels of the court signal concerning the viability of the right to experiment on a patented invention.

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One jurist flatly denies the existence of the right to experiment on a patented invention. He has unqualifiedly stated that “during the term of the patent, unauthorized parties are ‘preempted’ from practicing the patent * * *.” The Myriad case, Ass’n for Molecular Pathology v. U.S. Patent & Trademark Office, 689 F.3d 1303, 1331 (Fed. Cir. 2012)(Lourie, J.), subsequent proceedings, Association for Molecular Pathology v. Myriad Genetics, Inc., 133 S.Ct. 2107 (2013). A resigned member of the Federal Circuit has denied the existence of a right to experiment on a patented invention by “question[ing] whether any infringing use can be de minimis. Deuterium Corp. v. United States, 19 Cl.Ct. 624 (Cl.Ct.1990)(Rader, J.). The same jurist also said that “in my judgment, the” Patent Act leaves no room for any de minimis or experimental use excuses for infringement.” Embrex v. Service Eng’g Corp., 216 F.3d 1343, 1352 (Fed.Cir.2000) (Rader, J., concurring). He adds that “no room remains in the law for a de minimis excuse.” Id. (emphasis added).

3. An En Banc Exorcism

The time has come for the Federal Circuit to sit en banc and exorcise the ghost of Deuterium and its progeny.
III. A TRANSFORMATIVE METHOD

A. The Diehr Model

Perhaps the best model of a claim that is focused upon an algorithm but in the context of a physical process is the Diehr case\(^9\) where the claim is to “a method of operating a rubber-molding press” but where the steps of the algorithm are spelled out in detail. Representative claim 1 claims a method of operating a rubber-molding press keyed to software:

“1. A method of operating a rubber-molding press for precision molded compounds with the aid of a digital computer, comprising:
   “providing said computer with a data base for said press including at least,
   “natural logarithm conversion data (ln),
   “the activation energy constant (C) unique to each batch of said compound being molded, and
   “a constant (x) dependent upon the geometry of the particular mold of the press,
   “initiating an interval timer in said computer upon the closure of the press for monitoring the elapsed time of said closure,
   “constantly determining the temperature (Z) of the mold at a location closely adjacent to the mold cavity in the press during molding,
   “constantly providing the computer with the temperature (Z),
   “repetitively calculating in the computer, at frequent intervals during each cure, the Arrhenius equation for reaction time during the cure, which is
   “ln v = CZ + x
   “where v is the total required cure time,

“repetitively comparing in the computer at said frequent intervals during the cure each said calculation of the total required cure time calculated with the Arrhenius equation and said elapsed time, and “opening the press automatically when a said comparison indicates equivalence.”

(emphasis added)

In finding the claimed invention patent-eligible, the Court in Diehr explains:

We granted [review] to determine whether a process for curing synthetic rubber which includes in several of its steps the use of a mathematical formula and a programmed digital computer is patentable subject matter under 35 U.S.C. § 101.

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Our conclusion regarding [patent eligibility of the] claims is not altered by the fact that in several steps of the process a mathematical equation and a programmed digital computer are used. ***

*** Only last Term, we explained:

“[A] new mineral discovered in the earth or a new plant found in the wild is not patentable subject matter. Likewise, Einstein could not patent his celebrated law that \(E = mc^2\); nor could Newton have patented the law of gravity. Such discoveries are ‘manifestations of ... nature, free to all men and reserved exclusively to none.’”


II

Our recent holdings in [Gottschalk v. Benson, 409 U.S. 63 (1972), and Parker v. Flook, 437 U.S. 584 (1978)], both of which are computer-related, stand for no more than these long-established principles. In Benson, we held unpatentable claims for an algorithm used to convert binary code decimal numbers to equivalent pure binary numbers. The sole practical application of the algorithm was in connection with the programming of a general purpose digital computer. We defined “algorithm” as a “procedure for solving a given type of mathematical
problem,” and we concluded that such an algorithm, or mathematical formula, is like a law of nature, which cannot be the subject of a patent.

*Parker v. Flook*, *supra*, presented a similar situation. The claims were drawn to a method for computing an “alarm limit.” An “alarm limit” is simply a number and the Court concluded that the application sought to protect a formula for computing this number. Using this formula, the updated alarm limit could be calculated if several other variables were known. The application, however, did not purport to explain how these other variables were to be determined, nor *187 did it purport “to contain any disclosure relating to the chemical processes at work, the monitoring of process variables, or the means of setting off an alarm or adjusting an alarm system. All that it provides is a formula for computing an updated alarm limit.” 437 U.S. at 586.

In contrast, the respondents here do not seek to patent a mathematical formula. Instead, they seek patent protection for a process of curing synthetic rubber. Their process admittedly employs a well-known mathematical equation, but they do not seek to pre-empt the use of that equation. Rather, they seek only to foreclose from others the use of that equation in conjunction with all of the other steps in their claimed process. These include installing rubber in a press, closing the mold, constantly determining the temperature of the mold, constantly recalculating the appropriate cure time through the use of the formula and a digital computer, and automatically opening the press at the proper time. Obviously, one does not need a “computer” to cure natural or synthetic rubber, but if the computer use incorporated in the process patent significantly lessens the possibility of “overcuring” or “undercuring,” the process as a whole does not thereby become unpatentable subject matter.

Our earlier opinions lend support to our present conclusion that a claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula, computer program, or digital computer. In *Gottschalk v. Benson*, we noted: “It is said that the decision precludes a patent for any program servicing a computer. We do not so hold.” 409 U.S. at 71. Similarly, in *Parker v. Flook*, we stated that “a process is not unpatentable simply because it contains a law of nature or a mathematical algorithm.” 437 U.S. at 590. It is now commonplace that an *application* of a law of nature or mathematical formula to a
known structure or process may well be deserving of patent protection. See, e. g., Funk Bros. Seed Co. v. Kalo Inoculant Co., 333 U.S. 127 (1948); Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45 (1923); Cochrane v. Deener, 94 U.S. 780, 24 L.Ed. 139 (1877); O'Reilly v. Morse, 15 How. 62 (1854); and Le Roy v. Tatham, 14 How. 156 (1853). As Justice Stone explained four decades ago:

“While a scientific truth, or the mathematical expression of it, is not a patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.” Mackay Radio & Telegraph Co. v. Radio of America, 306 U.S. 86, 94 (1939).

We think this statement in Mackay takes us a long way toward the correct answer in this case. Arrhenius' equation is not patentable in isolation, but when a process for curing rubber is devised which incorporates in it a more efficient solution of the equation, that process is at the very least not barred at the threshold by § 101.

In determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made. The “novelty” of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.

* * *

IV

We have before us today only the question of whether respondents' claims fall within the § 101 categories of possibly patentable subject matter. We view respondents' claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula. We recognize, of course, that when a claim recites a mathematical formula (or scientific principle or phenomenon of nature), an inquiry must be made into whether the claim is seeking patent protection for that formula in the abstract. A mathematical formula as such
is not accorded the protection of our patent laws, *Gottschalk v. Benson*, 409 U.S. 63 (1972), and this principle cannot be circumvented by attempting to limit the use of the formula to a particular technological environment. *Parker v. Flook*, 437 U.S. 584 (1978). Similarly, insignificant post-solution activity will not transform an unpatentable principle into a patentable process. *Ibid.* To hold otherwise would allow a competent draftsman to evade the recognized limitations on the type of subject matter eligible for patent protection. On the other hand, *when a claim containing a mathematical formula implements or applies that formula in a structure or process which, when considered as a whole, is performing a function which the patent laws were designed to protect* (e. g., transforming or reducing an article to a different state or thing), *then the claim satisfies the requirements of § 101*. Because we do not view respondents' claims as an attempt to patent a mathematical formula, but rather to be drawn to an industrial process for the molding of rubber products, we affirm the judgment of the Court of Customs and Patent Appeals [holding the process patent-eligible].

**B. Multi-Step Process Claims**

Following the *Diehr* model, the claim should detail the various steps in the process.

**IV. “SUMMARY”, A CHANGE IN THE RULES OF PRACTICE**

To avoid or mitigate claim dissection and to compel consideration of the invention “as a whole” the claimed invention should be explained to *limit*

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10 *Diamond v. Diehr*, 450 U.S. at 177, 185-189, 191-93 (internal citations omitted; emphasis added in part).
consideration to the entirety of the stated elements, now, as outlined in the boxed statement at the beginning of this paper, but hopefully downstream as part of the proposed revision to Rule 73, discussed infra.

It is proposed that the following change be made to 37 CFR § 1.73, Summary of the Invention:

<table>
<thead>
<tr>
<th>37 CFR § 1.73</th>
<th>Summary of the invention.</th>
</tr>
</thead>
<tbody>
<tr>
<td>A brief summary of the invention may include:</td>
<td></td>
</tr>
<tr>
<td>(a) a definition of any term in the claims which shall cabin the scope of that term to that definition; terms not defined in this section shall be given their broadest reasonable interpretation; and</td>
<td></td>
</tr>
<tr>
<td>(b) a disclaimer as to protection any embodiment where that embodiment is used solely to “experiment on” that embodiment.</td>
<td></td>
</tr>
</tbody>
</table>

11 The rule is repeated, here, showing additions in underlined bold text with deletions in italics within brackets:

<table>
<thead>
<tr>
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</tr>
</thead>
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<td></td>
</tr>
<tr>
<td>(b) a disclaimer as to protection any embodiment where that embodiment is used solely to “experiment on” that embodiment.</td>
<td></td>
</tr>
</tbody>
</table>
V. CONCLUSION

The economic strength of the innovative community is being denied in the areas of software and biotechnology, areas where the United States has historically played a leadership role in the world economy. While it would be useful to have legislation enacted that would overrule Alice this may be a problematic approach to a problem that may be better served through a realistic approach as outlined in this paper.
About the Author

Prof. Wegner’s practice includes expert opinions; he develops strategies on complex claim drafting and prosecution matters at the Examiner level and at the Board; and he has been involved with appeals at the Federal Circuit.

Prof. Wegner’s patent career commenced with service at the U.S. Department of Commerce as a Patent Examiner.

His academic involvement started with a three year period in Munich and Kyoto first as a Wissenschaftliche Mitarbeiter at what is today the Max Planck Institute for Innovation and Competition.

Later, he was a Kenshuin at the Kyoto University Law Faculty in collaboration with the late Dr. Zentaro Kitagawa.

Prof. Wegner’s latest publication is the treatise:

FIRST TO FILE PATENT DRAFTING: A PRACTITIONER’S GUIDE (Thomson Reuters 2017)

Westlaw will also electronically publish the treatise this summer.

Prof. Wegner is President Emeritus of The Naples Roundtable, Inc., a 501(c)3 nonprofit corporation dedicated to “finding ways to strengthen and improve the patent system.” thenaplesroundtable.org/

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