No. 22-1220

In The
Supreme Court of the United States

Jeffrey A. Killian,

Petitioner

v.

Kathi Vidal, Director of the United States Patent and Trademark Office,

Respondent

On Petition for Writ of Certiorari from the United States Court of Appeals for the Federal Circuit

REQUEST FOR REHEARING

Burman Y. Mathis
471 Riverside Road
Harper's Ferry, WV. 25425
(703) 901-1683
budmathis@yahoo.com

Attorney for Petitioner

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Constitution, Statutes and Rules

PETITION FOR REHEARING

Petitioner Jeffrey A. Killian petitions for rehearing of this Court's October 2, 2023, Order denying his petition for a writ of certiorari.

REASONS FOR GRANTING REHEARING

This Court's Rule 44.2 authorizes a petition for rehearing based on "intervening circumstances of a substantial . . . effect."

Recently, Senators Tillis and Coons released the "Patent Eligibility Restoration Act of 2023" for the purpose of reversing the judicially-created exceptions to patent eligibility. Among the Senate's findings include: (1) patent eligibility jurisprudence interpreting § 101 requires significant modification and clarification; (2) the Supreme Court and other courts created judicial exceptions to the wording of that section, thereby rendering an increasing number of inventions ineligible for patent protection; and (3) efforts by judges to apply the exceptions to specific circumstances have led to extensive confusion and a lack of consistency. See Appx3.

None of this is surprising. *Alice/Mayo*, as with every judicial exception to patent eligibility, has been a resounding failure.

However, of particular importance, the Senate has declared "***All judicial exceptions to patent eligibility***

are eliminated." See Appx4. This statement represents a challenge to this Court by *de facto* declaring that the judicial exceptions to patent eligibility under *Alice/Mayo* are nothing but badly conceived policy preferences having no constitutional basis. The question therefore arises as to whether this Court believes its exceptions to patent eligibility are necessary to comply with the Constitution, or whether *Alice/Mayo* is unconstitutional judicial activism. That is, if Congress sets aside the judicial exceptions to patent eligibility, would such an act violate the Constitution or is the judiciary presently in violation of the Constitution?

I. Argument

Title 35 U.S.C. § 101 ("Inventions patentable") recites as follows:

> 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.

Section 101 is thirty-six (36) words. The language is clear. Notably absent are the terms "abstract idea" and "inventive concept." Yet despite the clear language of this handful of words, the courts have turned § 101 into a nightmare of confusion in a manner that appears to the outside world (e.g., to managers,

scientists, and attorneys not wearing black robes) in defiance of the will of Congress and Article I of the Constitution.

The exceptions to patent eligibility have no basis in the express statutory language of § 101, but do they have a constitutional basis? The Supreme Court has never answered this fundamental question.

The Supreme Court "normally interprets a statute in accord with the ordinary public meaning of its terms at the time of its enactment." *Bostock v. Clayton County*, 140 S.Ct. 1731, 1738 (2020). That is, "only the words on the page constitute the law adopted by Congress and approved by the President." *Id.* "If judges could add to, remodel, update, or detract from old statutory terms inspired only by extratextual sources and our own imaginations, we would risk amending statutes outside the legislative process reserved for the people's representatives." *Id.*

While Petitioner agrees that statutes should be interpreted to avoid an unconstitutional outcome, e.g., to avoid a statutory interpretation that could impede progress rather than promote it, the Supreme Court has never: (1) stated whether it's various exceptions to patent eligibility were necessary under the Constitution, and (2) certainly never addressed the judicial exceptions using the entirety of Title 35 of the United States Code (hereinafter "the Patent Law").

In addressing Title 35 U.S.C. § 101 and only 35 U.S.C. § 101, the Supreme Court identified three specific exceptions to patent-eligibility principles including: (1) laws of nature, (2) physical phenomena, and (3) abstract ideas. *Bilski v. Kappos,* 561 U.S. 593, 601 (2010)." In declaring these exceptions, the Supreme Court stated, "these exceptions have defined the reach of the statute as a matter of statutory *stare decisis* going back 150 years." *Id.* at 602.

The problem with this statement is that ***there is no language in the thirty-six words of § 101*** to support such a notion of "statutory stare decisis." While *Bilski* did state that "[a] conclusion that business methods are not patentable . . . would violate the canon against interpreting any statutory provision in a manner that would render another provision superfluous," the *Bilski* holding rendered 35 U.S.C. § 102 superfluous. The *Bilski* claims, being well-known, routine, and conventional, necessarily fall to the plain language of § 102 even as the *Bilski* claims perfectly comply with § 101. Thus, *Bilski* needlessly stepped outside the statutory framework Congress created while erroneously proclaiming the various exceptions to patent eligibility to be based on an interpretation of the above thirty-six words.

Turning to *Mayo Collaborative Services* v. *Prometheus Laboratories, Inc.*, 566 U.S. 66, 70 (2012) the Supreme Court stated that it "has long held that [Title 35 U.S.C. § 101] contains an important ***implicit***

exception. '[L]aws of nature, natural phenomena, and abstract ideas'" (emphasis added) citing, *inter alia*, *O'Reilly v. Morse,* 15 How 62 (1853).[1] This theory of "implicit exception," however, is incompatible with the idea of statutory stare decisis. An interpretation of existing text is not the same as an exception based on nonexistent text.

The real problem, however, is that the phrase "implicit exception" is nomenclature that turns every statute into the plaything of the judiciary. To merely declare that a statute contains an "implicit exception" is to ignore statutory language in favor of unconstitutional judicial activism. The natural result of this judicial activism in the realm of patent eligibility is that everything under the sun created by man is now patent ineligible. Statutory language now takes a backseat to needless and destructive judicial meddling. How these imaginary "implicit exceptions" fit within the express language of § 101's from a constitutional perspective has <u>never</u> been addressed by the courts when considering the Patent Law as a whole.

Furthermore, the exceptions to patent eligibility literally read out the statutory text of § 101. Section 101 expressly covers <u>both</u> inventions and discoveries.

---

[1] Recently this Court realized in *Amgen v. Sanofi*, 598 U.S. ____ (2003) that, after 51 years of erroneous citations, *Morse* relates to enablement under § 112(a), not patent eligibility under § 101.

The word "invention" implies some form of creation. The word "discovery," however, requires a finding of a preexisting thing. To discover is to "obtain sight or knowledge of for the first time."[2] It is therefore within the scope of the Patent Law that the "new" in § 101 includes "newly discovered," and without question Congress chose to reward those who discovered, *inter alia*, the healing properties of plants as well as previously unknown natural laws, e.g., the first uses of electromagnetism to convey information, so long as such uses were well-described and enabled. It is impossible to reconcile the "or discovers" language in § 101 with the "implicit exceptions" doctrine of the judiciary. Why "any new and useful process" in § 101 no longer means "any new and useful process" is an issue this Court has refused to address.

Granted, as with all statutes, Petitioner is fully aware that patent eligibility has a constitutional dimension. However, the Supreme Court has never claimed its exceptions were necessary to keep the Patent Law constitutional and never addressed a patent claim directed to a natural law or a physical phenomenon under, *inter alia*, § 102 to determine whether such is "in public use, on sale, or otherwise available to the public." Furthermore, "abstract ideas" are covered by Title 35 U.S.C. § 112, and the business methods of *Alice Corp.* and *Bilski* were anything but

[2] https://www.merriam-webster.com/dictionary/discover

an "abstract idea" within the plain meaning of the term.

This judicial activism by the Supreme Court has morphed patent eligibility into absurdity. Now, claims are held patent ineligible for preempting a law of physics having nothing to do with the underlying claim (*American Axle v. Neapco*), preempting science fantasy in a manner that should cause the judiciary to collectively blush with embarrassment (*Killian v. Vidal*), and for the crime of creating a new and useful improved medical breakthrough (*CareRX v. Natera*) using known tools and techniques in a new way. *Alice/Mayo* as practiced by courts and the USPTO is a capricious judicial veto based on no policy other than a wholesale appreciation of technical ignorance.

Further, under what theory can the courts reinstate the requirement of "inventive concept" into the Patent Law? Invention / inventive concept / flash of creative genius is a requirement that Congress not only wrote out of the Patent Law in 1952, but which this Court three times acknowledged is meaningless. "The truth is, the word ['invention'] cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty or not." *McClain v. Ortmayer,* 141 U.S. 419, 427 (1891); *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 154 (1950) at fn 6; *Graham v. John Deere Co.*, 383 U.S. 1, 11 (1966). The Supreme Court further

stated in *Graham* that "[i]t also seems apparent that Congress intended by the last sentence of § 103 to abolish the test it believed this Court announced in the controversial phrase 'flash of creative genius,' used in *Cuno Engineering Corp. v. Automatic Devices Corp.,* 314 U. S. 84 (1941)." *Id.* at p. 15.

Alice/Mayo was fated for failure the moment the courts resurrected "invention," a standard that Congress removed from the Patent Law and which has defied definition for over 172 years. Requiring "invention" as a pathway to a patent is not a statutory interpretation (see the thirty-six words above) and it is not part of any "implicit exception" consistent with the Constitution. "Inventive Concept" is a judicial test that no judge understands and which none of the presently sitting justices can articulate in any meaningful way.

II. Conclusion

Either Congress has the right to pen legislation without the judiciary capriciously rewriting it from the bench or it doesn't. The public also has the right to clarity. This Court owes the public clarity.

/s/ Burman Y. Mathis
Burman Y. Mathis
Attorney for Petitioner

CERTIFICATE OF COUNSEL

Pursuant to Rule 44.2, Counsel certifies that the Petition is restricted to the grounds specified in the Rule with substantial grounds not previously presented. Counsel certifies that this Petition is presented in good faith and not for delay.

_____

Burman York Mathis
Counsel for Petitioner

Appx1

APPENDIX

118TH CONGRESS
1ST SESSION **S. _____**

To amend title 35, United States Code, to address matters relating to patent subject matter eligibility, and for other purposes.

IN THE SENATE OF THE UNITED STATES

Mr. TILLIS (for himself and Mr. COONS) introduced the following bill; which was read twice and referred to the Committee on

---

A BILL

To amend title 35, United States Code, to address matters relating to patent subject matter eligibility, and for other purposes.

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,

SECTION 1. SHORT TITLE.

This Act may be cited as the "Patent Eligibility Restoration Act of 2023".

SEC. 2. FINDINGS.

Congress finds the following:

(1) As of the day before the date of enactment of this Act, patent eligibility jurisprudence interpreting section 101 of title 35, United States Code, requires significant modification and clarification.

(2) For many years after the original enactment of section 101 of title 35, United States Code, the Supreme Court of the United States and other courts created judicial exceptions to the wording of that section, thereby rendering an increasing number of inventions ineligible for patent protection.

(3) Efforts by judges of district courts and courts of appeals of the United States to apply the exceptions described in paragraph (2) to specific circumstances have led to extensive confusion and a lack of consistency —

(A) throughout the judicial branch of the Federal Government and Federal agencies; and

(B) among patent practitioners.

(4) Many judges of the United States Court of Appeals for the Federal Circuit and of various district courts of the United States have explicitly expressed the need for more guidance with respect to the meaning of section 101 of title 35, United States Code, and many patent owners, and persons that engage with patent owners, complain that the interpretation

of that section is extremely confusing and difficult to discern and apply with any confidence.

(5) Under this Act, and the amendments made by this Act, the state of the law shall be as follows:

(A) All judicial exceptions to patent eligibility are eliminated.

(B) Any invention or discovery that can be claimed as a useful process, machine, manufacture, or composition of matter, or any useful improvement thereof, is eligible for patent protection, except as explicitly provided in section 101 of title 35, United States Code, as amended by this Act, as described in subparagraphs (D) and (E) of this paragraph.

(C) Sections 102, 103, and 112 of title 35, United States Code, will continue to prescribe the requirements for obtaining a patent, but no such requirement will be used in determining patent eligibility.

(D) The following inventions shall not be eligible for patent protection:

(i) A mathematical formula that is not part of an invention that is in a category described in subparagraph (B).

(ii) A mental process performed solely in the mind of a human being.

(iii) An unmodified human gene, as that gene exists in the human body.

(iv) An unmodified natural material, as that material exists in nature.

(v) A process that is substantially economic, financial, business, social, cultural, or artistic.

(E) Under the exception described in sub paragraph (D)(v)—

(i) process claims drawn solely to the steps undertaken by human beings in methods of doing business, performing dance moves, offering marriage proposals, and the like shall not be eligible for patent coverage, and adding a non-essential reference to a computer by merely stating, for example, "do it on a computer" shall not establish such eligibility; and

(ii) any process that cannot be practically performed without the use of a machine (including a computer) or manufacture shall be eligible for patent coverage.

SEC. 3. PATENT ELIGIBILITY.

(a) IN GENERAL.—Chapter 10 of title 35, United States Code, is amended—

(1) in section 100—

(A) in subsection (b), by striking "includes a new use of a known process" and inserting

'includes a use, application, or method of manufacture of a known or naturally-occurring process"; and

(B) by adding at the end the following:

"(k) The term 'useful' means, with respect to an invention or discovery, that the invention or discovery has a specific and practical utility from the perspective of a person of ordinary skill in the art to which the invention or discovery pertains."; and

(2) by amending section 101 to read as follows:

"§ 101. Patent eligibility

"(a) IN GENERAL.—Whoever invents or discovers any useful process, machine, manufacture, or composition of matter, or any useful improvement thereof, may obtain a patent therefor, subject only to the exclusions in subsection (b) and to the further conditions and requirements of this title.

"(b) ELIGIBILITY EXCLUSIONS.—

"(1) IN GENERAL.—Subject to paragraph (2), a person may not obtain a patent for any of the following, if claimed as such:

"(A) A mathematical formula that is not 2 part of a claimed invention in a category described in subsection (a).

"(B)(i) Subject to clause (ii), a process that is substantially economic, financial, business, social,

cultural, or artistic, even though not less than 1 step in the process refers to a machine or manufacture.

"(ii) The process described in clause (i) shall not be excluded from eligibility for a patent if the process cannot practically be performed without the use of a machine or manufacture.

"(C) A process that—

"(i) is a mental process performed solely in the human mind; or

"(ii) occurs in nature wholly independent of, and prior to, any human activity.

"(D) An unmodified human gene, as that gene exists in the human body.

"(E) An unmodified natural material, as 23 that material exists in nature.

"(2) CONDITIONS.—For the purposes of sub paragraphs (D) and (E) of paragraph (1), a human gene or natural material shall not be considered to be unmodified if the gene or material, as applicable, is—

"(A) isolated, purified, enriched, or otherwise altered by human activity; or

"(B) otherwise employed in a useful invention or discovery.

"(c) ELIGIBILITY.—

"(1) IN GENERAL.—In determining whether, under this section, a claimed invention is eligible for a patent, eligibility shall be determined—

"(A) by considering the claimed invention as a whole and without discounting or disregarding any claim element; and

"(B) without regard to—

"(i) the manner in which the claimed invention was made;

"(ii) whether a claim element is known, conventional, routine, or naturally occurring;

"(iii) the state of the applicable art, as of the date on which the claimed invention is invented; or

"(iv) any other consideration in section 102, 103, or 112.

(2) INFRINGEMENT ACTION.—

"(A) IN GENERAL.—In an action brought for infringement under this title, the court, at any time, may determine whether an invention or discovery that is a subject of the action is eligible for a patent under this section, including on motion of a party when there are no genuine issues of material fact.

"(B) LIMITED DISCOVERY.—With respect to a determination described in subparagraph (A), the court may consider limited discovery relevant only to the eligibility described in that subparagraph before ruling on a motion described in that subparagraph.".

(b) TECHNICAL AND CONFORMING AMENDMENT.—

The table of sections for chapter of title 35, United States Code, is amended by striking the item relating to section 101 and inserting the following:

"101. Patent eligibility.".