

No. \_\_\_\_\_

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In The  
Supreme Court of the United States

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Jeffrey A. Killian,

*Petitioner*

v.

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

*Respondent*

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

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**CORRECTED PETITION FOR WRIT OF  
CERTIORARI**

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## QUESTIONS PRESENTED

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The present case is directed to a rejection under Title 35 U.S.C. § 101 from the United States Patent and Trademark Office (USPTO) under the *Alice/Mayo* doctrine. In conducting this § 101 rejection, the present record shows that the United States Patent and Trademark Office (hereinafter “the USPTO”) violated Supreme Court precedent when holding the present claims patent ineligible under the *Alice/Mayo* test. The questions presented by Petitioner are as follows:

I. Have the numerous departures of the Supreme Court’s *Alice/Mayo* jurisprudence by the Court of Appeals of the Federal Circuit (hereinafter “the Federal Circuit”) enabled the USPTO to violate the Title 5 of the United States Code (hereinafter “the Administrative Procedure Act” or “the APA”) and the Due Process Clause of the Fifth Amendment of the Constitution?

II. Do the exceptions created by Article III courts of Title 35 U.S.C. § 101 exceed the constitutional authority of the courts?

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## **Petitions**

Petitioner Jeffrey A. Killian respectfully submits this petition for writ of certiorari.

## **Parties**

Petitioner is Jeffrey A. Killian of Grove City, Ohio. Respondent in this case is Director Kathi Vidal of the USPTO.

## **Opinions Below**

The opinion of the Court of Appeals for the Federal Circuit (App. 2a-27a) is listed as Appeal No. 21-2113. The opinions of the Patent Trial and Appeal Board (App. 28a-63a) are unreported.

## **Jurisdiction**

The Court of Appeals for the Federal Circuit issued its decision on May 3, 2021. A petition for rehearing *en banc* was denied on December 20, 2021. App. 64a-65a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1). This Court graciously granted Petitioner a 35 day extension of time.

## I. Argument

### A. Statement of the Case

Petitioner's arguments are three-fold. The first contention is that, as this case demonstrates, the lower courts have rendered step one of *Alice/Mayo* capricious. Step one of *Alice/Mayo* is satisfied by nothing more than a bald assertion that defies evidence, common-sense analysis, and scientific principles.

Petitioner's second argument is that the term "inventive concept" under step two of *Alice/Mayo* is capricious, and this capriciousness cannot be remedied. As with the standard of "flash of creative genius,"<sup>1</sup> the requirement of an "inventive concept" is a rebranding of "invention" which Congress wrote out of the Patent Law<sup>2</sup> and 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." *McClain v. Ortmyer*, 141 U.S. 419, 427 (1891); *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*,

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<sup>1</sup> See *Cuno Eng. Corp. v. Automatic Devices Corp.* 314 U.S. 84, 91 (1941).

<sup>2</sup> Rich, Giles S., *The Vague Concept of "Invention" as Replaced by Section 103 of the 1952 Patent Act* (1964) (Reprinted with permission in *Nonobviousness – The Ultimate Condition of Patentability* (1978) at pp. 1:401-416).

340 U.S. 147, 154 (1950) at fn 6; *Graham v. John Deere Co.*, 383 U.S. 1, 11 (1966).

Petitioner's third argument is that the *Alice/Mayo* doctrine should be set aside by the Supreme Court using the analysis set forth in *Dobbs v. Jackson Women's Health Organization*, 142 S. Ct. 2228 (2022). Every factor discussed in *Dobbs* demands that each judicially-created exception to patent eligibility be set aside.

## **B. Description of the Claims**

### **Representative Claim 1**

1. A computerized method for determining overlooked eligibility for social security disability insurance (SSDI)/adult child benefits through a computer network, the method comprising the steps of:

(a) providing a computer processor and a computer readable media;

(b) providing access to a Federal Social Security database through the computer network, wherein the Federal Social Security database provides records containing information relating to a person's status of SSDI adult child benefits and/or parental and/or marital information relating to SSDI adult child benefit eligibility;

(c) providing access to a State database through the network, wherein the State database provides

records containing information relating to persons receiving treatment for developmental disabilities and/or mental illness from a State licensed care facility;

(d) selecting at least one person from the State database who is identified as receiving treatment for developmental disabilities and/or mental illness;

(e) creating an electronic data record comprising information relating to at least the identity of the person and social security number, wherein the electronic data record is recorded on the computer readable media;

(f) retrieving the person's Federal Social Security record containing information relating to the person's status of SSDI adult child benefits through the network;

(g) determining whether the person is receiving SSDI adult child benefits based on the SSDI status information contained within the Federal Social Security database record through the computer network;

(h) indicating in the electronic data record whether the person is receiving SSDI adult child benefits or is not receiving SSDI adult child benefits;

for at least one electronic data record of persons indicated as not receiving SSDI adult child benefits, comprising the steps of:

- (a) providing a caseworker display system;
- (b) generating a data collection input screen display to the caseworker display system relating to the electronic data record of persons indicated as not receiving SSDI adult child benefits;
- (c) caseworker identifying and inputting parental and/or marital names and Social Security numbers into the electronic data record of the person indicated in the electronic data record as not receiving SSDI adult child benefits;
- (d) retrieving parental and/or marital Social Security record(s) from the Federal Social Security database through the computer network in order to identify information for determining eligibility for SSDI adult child benefits;
- (e) determining whether the person indicated in the electronic data record is eligible for receiving SSDI adult child benefits based on the identified information for determining eligibility of SSDI adult child benefits and current SSDI benefit legal requirements; and
- (f) indicating in the electronic data record whether the person is eligible for SSDI adult child benefits or is not eligible for SSDI adult child benefits.

Petitioner's representative claim above (from U.S. Patent Application No. 14/450,402) is 433

words long and represents a detailed solution to a problem that was never before solved in the history of the social security system, i.e., successfully addressing SSDI adult child benefits for overlooked people by using, *inter alia*, “parental and/or marital Social Security record(s).” The claim above passes all statutory requirements of the Patent Law, including Title 35 U.S.C. §§ 101, 102, 103, and 112. The claim above does not preempt any system or method that preexisted Petitioner’s application, and indeed Petitioner amassed fifty-five (55) separate documents proving Killian’s claim to be patent eligible, all of which the USPTO refused to consider.

## C. Procedural History

### 1. *The Final Office Action*

The Examiner rejected Killian’s claims under the alleged *Alice/Mayo* doctrine. Present Counsel says “alleged” because there is nothing in any of the Supreme Court’s *Alice Corp. (Alice Corp. PTY. Ltd. v. CLS Bank Int’l*, 573 U.S. 208 (2014)), *Bilski (Bilski v. Kappos*, 561 U.S. 593 (2010)), or *Mayo (Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012)) decisions that justifies the rejection. The Examiner’s errors, however, are not important given that the Patent Trial and Appeal Board of the USPTO (hereinafter “the Board”) substituted all of the Examiner’s

*Alice/Mayo* theories of rejection with new theories of rejection.

## ***2. The Board's Decision***

Upon review, the Board rejected the Examiner's analysis stating "[t]he Appellant's arguments begin with the contention that the 'claimed process is not *merely* 'the concept of determining eligibility for Social Security Disability Insurance benefits (hereinafter '**SSDI**') as specifically recited by the Examiner, but *identifies overlooked individuals* who are currently eligible for **SSDI** . . . relating to persons receiving treatment for developmental disabilities and/or mental illness from a State licensed care facility." App. 48a-49a.

The Board (App. 53a) later stated that, "[n]either the Appellant nor the Examiner contemplate on the record that the claim recites an abstract mental process," then engaged in a discussion as to why processing on a generic computer can never result in a claim that is patent eligible by cherry-picking Federal Circuit cases and omitting conflicting cases such as *Berkheimer v. HP*, 881 F.3d 1360 (2018) (Fed.Cir. 2018) as well as the holding of *Diamond v. Diehr*, 405 U.S. 175 (1981). The Board stated, "[n]one of Appellant's arguments are persuasive, because they misunderstand the holding *Berkheimer*, and of the 'inventive concept' in subject matter eligibility." App. 60a. However, the Board

failed to inform Petitioner as to exactly what the “misunderstanding” was and failed to admit that “inventive concept” is a term without meaning. One thing Petitioner does know about *Berkheimer* is the following wisdom penned by Judge Moore:

“Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination. Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional.” *Berkheimer*, 881 F.3d at 1369.

The Board also refused to consider a mountain of evidence provided by Killian. See, e.g., App. 71a-73a. However, no employee at the USPTO has ever questioned the veracity or efficacy of Appellant’s evidence, and indeed the USPTO took great steps to ignore Appellant’s evidence. Thus, there are fifty-five separate documents of unquestioned veracity and efficacy that Petitioner entered into evidence that support patent eligibility and exactly zero words of evidence supporting the Board’s position.



### ***3. The Board's Rehearing Decision.***

Consistent with the initial Decision, the Board's Rehearing Decision (App. 28a-39a) is silent on evidence. Of significance, however, in that the Board admitted:

“We do not dispute that the application of the method of claim 1 may have numerous benefits, and that this may represent both a ‘practical application’ and an ‘inventive concept’ when relying on the colloquial meanings of those terms.

However, *as we noted in our Decision, the concepts of ‘practical application,’ ‘inventive concept,’ and ‘insignificant extra-solution activity’ are specific legal concepts, articulated in the body of case law emanating from the Court of Appeals for the Federal Circuit, and the Supreme Court, and explained in the Manual of Patent Examining Procedure (“MPEP”) and the Guidance.*” (emphasis added) App. 34a-35a.

The above-emphasized text above is false.

The Board never “noted” anything akin to the text above. Further, there is no legal definition of “practical application” or “inventive concept.” The Board provided no such definitions, no such special definitions appear in the MPEP, no special definitions appear in any Federal Circuit decision, and no such special definitions appear in Supreme Court case law. No court in the United States has

ever meaningfully defined the term “inventive concept.” No court in the United States has ever asserted that the term “practical application” has a legal meaning different from its plain meaning.

While the Supreme Court has opined in dicta that an “inventive concept” is “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to *significantly more* than a patent upon the [ineligible concept] itself,” (emphasis added), the problem with “significantly more” is that no court has ever supplied the most minor limiting principle for the term.

A definition that relies on a totally meaningless term is a totally meaningless definition.

As to evidence, the entirety of evidence cited by the Board came from a quote from Killian’s application, i.e., that the claimed method may be performed by “any suitable computer system.” App. 25a, 57a. The remaining 400+ words of independent claim 1 went unaddressed.

#### ***4. The Federal Circuit’s Decision***

The Decision below of Judges Chen, Taranto, and Clevenger (hereinafter “the Panel”) is problematic for a large number of errors. While Petitioner outlined many of these errors in his Request for Rehearing *en banc* (App. 99a-105a), it is not possible

to address but a small number of such errors in this petition.

**D. The Federal Circuit’s Adaptation of Step One of *Alice/Mayo* Is a Capricious Departure from Supreme Court Precedent that Enables the USPTO to Violate Due Process and the Administrative Procedure Act**

The Fifth Amendment of the United States Constitution states in part:

“*No person shall* be held to answer for a capital, or otherwise infamous crime, unless on a presentment or indictment of a Grand Jury, . . . nor *be deprived of life, liberty, or property, without due process of law*; nor shall private property be taken for public use, without just compensation” (emphasis added).

The Federal Circuit reviews the Board’s legal conclusions *de novo*, *In re Elsner*, 381 F.3d 1125, 1127 (Fed. Cir. 2004), and the Board’s factual findings underlying those determinations for substantial evidence, *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000). A finding is supported by substantial evidence if a reasonable mind might accept the evidence to support the finding. *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938).

A determination of patentability must be based on the entire record by a preponderance of evidence. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992).

Further, a decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. *Id.*

Ultimately, the determination of whether an asserted claim is invalid for lack of subject matter patentability under Title 35 U.S.C. § 101 is a question of law. *See Berkheimer v. HP*, 881 F.3d 1360, 1369 (Fed.Cir. 2018) However, the question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact. *Id.* at 1368.

Proceedings of the Board are governed by the APA, Title 5, U.S.C. §§ 551 et seq. *Allentown Mack Sales & Serv., Inc. v. NLRB*, 522 U.S. 359, 374 (1998). Section 706 of the APA recites the following:

“To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall—

. . .

(2) hold unlawful and set aside agency action, findings, and conclusions found to be—

(A) arbitrary, capricious, an abuse of discretion, or *otherwise not in accordance with law*;

. . .

(E) *unsupported by substantial evidence in . . . reviewed on the record of an agency hearing provided by statute*;

. . .

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and *due account shall be taken of the rule of prejudicial error*” (emphasis added).

The “substantial evidence” requirement for USPTO findings of fact was solidified by the Supreme Court in *Dickenson v. Zurko*, 527 U.S. 150 (1999) where the Supreme Court “stressed the importance of not simply rubber-stamping agency fact-finding.” *Zurko, Id.* at 162. “The APA requires meaningful review; and [the APA’s] enactment meant stricter judicial review of agency factfinding than Congress believed some courts had previously conducted.” *Id.*

In view of the *Zurko* decision, the Federal Circuit held that the USPTO is obligated not only to come to a sound decision, but to fully and particularly set out the bases upon which it reached that decision. *In re Sang-Su Lee*, 277 F.3d 1338, 1342 (2002). The

Federal Circuit also held that the PTO “must set forth its findings and the grounds thereof, as supported by the agency record, and explain its application of the law to the found facts.” *Id.* “Judicial review of a Board denying an application for patent is thus founded on the obligation of the agency to make the necessary findings and provide an administrative record showing the evidence on which the findings are based, accompanied by the agency’s reasoning in reaching its conclusions.” *Id.* Factual inquiries “must be based on objective evidence of record.” *Id.* at 1343. “[R]eview of an administrative decision must be made on the grounds relied on by the agency.” *Id.* at 1345. “If those grounds are inadequate or improper, the court is powerless to affirm the administrative action by substituting what it considers to be a more adequate or proper basis.” *Id.* at 1345-46 (quoting *Securities & Exchange Comm’n v. Chenery Corp.*, 332 U.S. 194, 196 (1947)).

**E. The Panel’s Decision Misrepresents Every Supreme Court Patent Eligibility Opinion in the Last Forty-Three Years**

The Decision below not only misrepresents, but constantly contradicts, the last four decades of this Court’s holdings in patent eligibility. For instance, the Federal Circuit erroneously asserts that an “independent review” showed “[a]t bottom, *Diehr* did not comment on or overrule the mental steps

doctrine” established by *Gottschalk v. Benson*, 409 U.S. 63 (1972). App. 23a.

Did not even comment on the mental steps doctrine?

Respectfully, this is false. A word search of *Diehr*<sup>3</sup> shows that the terms “mental step(s)” occurs fifteen times, “mental operation(s)” four times, “mental processes” twice, and “mentally” once. Further, *Diehr* spends copious amounts of text characterizing *Benson* as merely a bar on claims having a mathematical formula and expressly stated/quoted, *inter alia*: (1) ‘It is said that the [*Benson*] decision precludes a patent for any program servicing a computer. We do not so hold.” *Diehr*, 450 U.S. at 187) (2) “While a mathematical formula, like a law of nature, cannot be the subject of a patent, *cf. Gottschalk v. Benson*.” (*Id.* at 185) (3) “A mathematical formula, as such, is not accorded the protection of our patent laws, *Gottschalk v. Benson*.” (*Id.* at 191) (4) “In *Gottschalk v. Benson*, we held that a program for the solution by a digital computer of a mathematical problem was not a patentable process within the meaning of § 101.” *Id.* at 216.

*Benson* is unquestionably narrowed by *Diehr*.

The Panel below also stated that “[t]he Supreme Court did not hold in *Diehr*, *Bilski*, or any other case

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<sup>3</sup> *Diamond v. Diehr*, 405 U.S. 175 (1981).

that “steps performed in a computer are not ‘mental steps’ even if the steps performed in the computer are identical to steps that could theoretically be performed by a human mind,” as Mr. Killian contends.” App. 22a. Respectfully, the double-negative expression makes this statement difficult to parse and is made completely incomprehensible in light of the fact that there is no “computer” recited in the *Bilski* claims. However, as best as Killian may reply, the *Diehr* majority absolutely cited *Benson* as merely a ban on claiming mathematical formulae. Even Justice Stevens’ dissent expressed *Diehr* as a rejection of *Benson*’s mental steps doctrine stating, “Under the ‘mental steps’ doctrine, processes involving mental operations were considered unpatentable.” *Diehr*, 450 U.S. at 195. “The broad question whether computer programs should be given patent protection involves policy considerations that this Court is not authorized to address.” *Id.* at 216-217.

Turning to *Bilski*, to understand what the *Bilski* holding represents, one first needs to start with a recognition that the claims in *Bilski* recite a business method untethered from any machine. *Bilski*, 595 F.3d at 949. Lacking a machine or physical transformation, the Federal Circuit majority *en banc* rejected the *Bilski* claims under the mental steps doctrine. *Id.* at 960. In contrast, Judge Newman criticized the majority stating that



*Bilski's* process "is not a mental process or a law of nature" but a "process" that was "set out in successive steps, for obtaining and analyzing information and carrying out a series of commercial transactions." *Id.* at 995.

This Court, however, rejected the Federal Circuit's mental steps theory and held that the word "process" includes business methods stating, "Section 101 similarly precludes the broad contention that the term 'process' categorically excludes business methods. . . . The Court is unaware of any argument that the 'ordinary, contemporary, common meaning,' . . . of 'method' excludes business methods." *Bilski*, 561 U.S. at 607. Thus, the Supreme Court adopted Judge Newman's interpretation of "process" while rejecting the mental steps theory of the Federal Circuit majority.

As to evidence, the Panel below determined that the only evidence required related to the recitation of the word "computer" (App. 25a, 57a) whereas Petitioner repeatedly stated that the existence of a computer in a claim makes no difference. App. 67a-73a, 90a-94a, 101a, 104a. Without question, this Court's *Bilski* and *Alice Corp.* decisions were all about addressing evidence relating to the underlying processes. Specifically, in *Alice Corp.* the Supreme Court deferred to textbooks published in 1896. The Supreme Court's *Bilski* decision also

relied on published textbooks. As is stated in the *Alice Corp.* decision:

“On their face, the claims before us are drawn to the concept of intermediated settlement, i.e., the use of a third party to mitigate settlement risk. Like the risk hedging in *Bilski*, the concept of intermediated settlement is ‘a fundamental economic practice long prevalent in our system of commerce.’ *Ibid.*; see, e.g., Emery, *Speculation on the Stock and Produce Exchanges of the United States*, in *7 Studies in History, Economics and Public Law* 283, 346–356 (1896) (discussing the use of a “clearing-house” as an intermediary to reduce settlement risk). The use of a third-party intermediary (or “clearing house”) is also a building block of the modern economy. See, e.g., Yadav, *The Problematic Case of Clearinghouses in Complex Markets*, 101 *Geo. L. J.* 387, 406–412 (2013); J. Hull, *Risk Management and Financial Institutions* 103–104 (3d ed. 2012). Thus, intermediated settlement, like hedging, is an ‘abstract idea’ beyond the scope of §101.” *Alice Corp.*, 573 U.S. at 219.

Turning to *Mayo*, the Supreme Court stated:

“As the patents state, methods for determining metabolite levels were well known in the art. ’623 patent, col. 9, ll. 12–65, 2 App. 11. Indeed, scientists routinely

measured metabolites as part of their investigations into the relationships between metabolite levels and efficacy and toxicity of thiopurine compounds. '623 patent, col. 8, ll. 37–40, *id.*, at 10.” *Mayo*, 566 U.S. at 78-79.

Thus, the Supreme Court never declared any man-made thing to be well-known, routine, and conventional without evidence on the record. Furthermore, the Supreme Court’s *Alice Corp.* and *Bilski* decisions never dismissed a single claim because the underlying process could in theory be performed by a human mind or by a computer.

While the Panel (App. 20a) correctly states that “the Supreme Court has decided cases arising under § 101 through comparison to its prior opinions,” the Federal Circuit missed the entire point of this Court’s guidance. Specifically, this Court’s comparison between *Bilski’s* risk hedging and *Alice Corp.’s* intermediated settlement is not based on the mere idea that both sets of claims were directed to business methods. To the contrary, *Bilski* and *Alice Corp.* are comparable because there was record evidence showing that the underlying processes in both cases were ubiquitous.

Continuing, the Decision below gives the USPTO an unfettered right to violate this Court’s direction in *Diehr*. Specifically, the *Diehr* opinion held that, in determining patent eligibility, “claims must be considered as a whole, it being inappropriate to

dissect the claims into old and new elements . . . .” *Diehr*, 450 U.S. at 188. *Alice Corp.* later clarified that, not only must claims be considered as a whole, but that all claim limitations must be considered both individually and “as an ordered combination.” *Alice Corp.*, 573 U.S. at 217, 225.

Not once did the Board or Federal Circuit address Killian’s claims as a whole, ordered combination as this Court has directed. Not once in all history has the USPTO ever rejected a single claim under *Alice/Mayo* while addressing limitations as a whole, ordered combination. See, e.g., *Villena v. Iancu*, Petition No. 18-1223 (2018) at pp. 18-20.

The Decision below gives the lower courts and USPTO unfettered right to ignore this Court’s holdings in every patent eligibility opinion in the last 43 years. In view of the Federal Circuit’s refusal to follow this Court’s precedent, this Court must choose: accept certiorari and correct the many departures of this Court’s guidance by the Federal Circuit or cede judicial supremacy.

**F. The Panel’s Decision Give the USPTO License to Violate Fifth Amendment Due Process of Law and the Administrative Procedure Act**

The *Alice/Mayo* test as routinely practiced by the USPTO violates both the statutory due process guaranteed by the Administrative Procedure Act

(APA) as well as Fifth Amendment due process of law guaranteed by the Constitution of the United States by depriving patent applicants of a property right using nonexistent definitions and factual finding without evidence. What is “well-known, routine, and conventional,” without question, is an issue of fact.

The Panel below asserts that:

“Although Mr. Killian alludes to Fifth Amendment Due Process Clause violations stemming from the alleged imprecision of the *Alice/Mayo* standard, he never argues that the standard runs afoul of the void-for-vagueness doctrine. Nor could he, as vagueness *as applied to the particular case* is a prerequisite to establishing facial vagueness” (emphasis in original).

As an initial issue, the Federal Circuit does not contest the fact that the Board made factual assertions without evidence, applied a test using non-existent definitions, and refused to consider a mountain of evidence favoring Killian to deprive Killian of a property right. In any other area of law such violations by an administrative agency would constitute constitutional due process violations as well as violations of § 706 of the APA. Further, Petitioner never stated that the term “inventive concept” was “vague” or “imprecise.” To the contrary, the term is meaningless – so meaningless

that the Board lied to Killian about the issue – an issue that the USPTO Solicitor never contested.

Respectfully, it is not necessary to argue void-for-vagueness to recognize that a decision violates due process of law. The void-for-vagueness doctrine was derived from the Fifth and Fourteenth Amendments, not the other way around. The precedential Decision below allows the USPTO the unfettered right to violate due process under an erroneous theory that somehow any violation of statutory or constitutional due process rights made under the umbrella of *Alice/Mayo* cannot be a violation of due process rights.

Certiorari is necessary as the Federal Circuit has announced that *Alice/Mayo* renders the USPTO free from the statutory and constitutional norms that rightfully constrain the rest of administrative law.

#### **G. The Panel Evaded Issues of Evidence Important to Determining *Alice/Mayo* Decisions**

The Opinion below asserts that, “[w]e find that Mr. Killian forfeited any argument on appeal based on those fifty-five documents by failing to present anything more than a conclusory, skeletal argument.” citing *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312 (Fed. Cir. 2006).

Petitioner responds that even a cursory review shows that Petitioner spent most of his brief on the

evidence issue including three pages in his Opening Brief (App. 71a-73a) outlining that:

(A) the Board refused to consider a large amount of evidence favoring Killian,

(B) the Board changed the theory of rejection precisely to avoid addressing Killian's evidence, and

(C) that “[t]here are 55 documents of unquestioned veracity and efficacy entered into evidence that support Appellant's position and exactly zero words of evidence supporting the Board's position that Killian's underlying business method is abstract.”

While the Panel lamented (App. 26a) that Killian refers to the 55 documents “obliquely,” just the opposite is true. Petitioner's entire point is that the USPTO violated the statutory requirements of the APA and decades of established Federal Circuit caselaw. Yet despite this, the Panel put an additional burden on Petitioner using a case having no relevance to the facts before them. According to *SmithKline Beecham*, a skeletal argument must be so underdeveloped that its difficult to see. “Judges are not like pigs, hunting for truffles buried in briefs.” *Id.* at 1320. However, there are three pages of argument by Petitioner versus zero words of rebuttal by the USPTO on the issue, and yet the Panel below laments that they were subjected to hunting for truffles like pigs by Petitioner while never questioning the USPTO as to why the Board

refused to follow the statutory requirements of the APA and long-established case law.

As to the demands of the Panel to see details of evidence the Board refused to consider, what would the Federal Circuit do? Weigh the evidence? “We do not and should not reweigh evidence or make factual findings anew on appeal.” *Impax Lab’s. Inc. v. Lannett Holdings Inc.*, 893 F.3d 1372, 1382 (Fed.Cir. 2018).

The Federal Circuit cannot set forth a rule of evidence on appeal, then condemn Petitioner for following said rule.

#### **H. The Federal Circuit’s Step One Analysis Is Science Fantasy**

While the Board’s rejection is based on the mental steps doctrine, the Panel admitted that not all steps in representative claim 1 can be performed by mental steps. App. 12a. Unfortunately, instead of setting aside the Board’s decision based on such error as the APA and Chenery doctrine require, the Panel violated the *Chenery* doctrine by reformulating the “abstract idea” to:

“Mr. Killian’s claims must fail *Alice/Mayo* step one as they are directed to collection of information, ***comprehending the meaning of that collected information***, and indication of the results, all on a generic computer network operating in its normal, expected manner” (emphasis added). App. 13a.



The first glaring problem is that no “generic computer network” is capable of “comprehending the meaning of collected information” any more than might a hammer. Inanimate objects don’t think, even those executing predictive models often referred to as “AI,” and certainly don’t comprehend. The Decision relies upon wholesale fantasy to invalidate Killian’s claims.

The second problem is that Petitioner’s claims have nothing to do with comprehending data. In fact, the word “comprehend” or its equivalents appear nowhere in Petitioner’s claims or specification, in the Board’s decisions, or in any briefing before the Federal Circuit.

Fast-forward seventeen days from the publication of the *Killian* Decision, the Federal Circuit published *In re Jason Smith*, Appeal No. 22-1310 (Fed.Cir. Sept. 9, 2022), where the Federal Circuit (slip op. at p. 5) *sua sponte* rejected the *Smith* claims under the same impossible “comprehending” theory invented by the *Killian* Panel regardless of the fact that the Board held the “abstract idea” of the *Smith* claims relates to organizing business or sales activity. As with *Killian*, Appellant *Smith* never had an opportunity to be heard on the issue. Further, as with *Killian*, the *Smith* claims have nothing to do with “comprehending” anything.

The decisions against Killian and Smith are back-to-back violations of due process of law, the APA, and the *Chenery* doctrine whereby the Federal Circuit spontaneously invented a new theory of “abstract” based on things that never happened in *Killian*, then applied this new theory of abstract to things that never happened in *Smith* to come to a conclusion of patent ineligibility having no basis in anything that ever happened at the USPTO or before the Federal Circuit.

While the Decision (App. 15a) states that “the claims of the ’042 application are clearly patent ineligible in view of our precedent,” Petitioner Killian asks, “*What precedent is that?*” The Panel had to devise a new theory of “abstract” having nothing to do with preemption, based on things that never happened, and based on language not in any claim after the Board’s mental steps theory failed without giving Killian an opportunity to be heard.

Respectfully, *what legal precedent supports such judicial actions?*

Forget that the Federal Circuit violated the Supreme Court’s *Chenery* doctrine by formulating its novel concept of what it considers an abstract idea, there is no such thing as a generic computer network that comprehends data, and *the present claims cannot preempt a nonexistent device conjured from fantasy*. Judge Giles Rich, who co-authored the 1952 Patent Act, once commented on

opinions like this stating: “The laws of physics and chemistry . . . do not permit the judicially imagined magic according to which  $2 + 2 = 5$ . Whenever such a spurious test prevails all patents are invalid.”<sup>4</sup>

### I. The Federal Circuit’s Step Two Analysis Is Capricious

The problem with the *Alice/Mayo* test as promulgated by the lower courts is that words have no meaning. Regarding Petitioner’s assertions that the term “inventive concept” is meaningless, Petitioner again quotes the Board’s decision on rehearing, where the Board admits:

“We do not dispute that the application of the method of claim 1 may have numerous benefits, and that this may represent both a ‘practical application’ and an ‘inventive concept’ when relying on the colloquial meanings of those terms.

However, as we noted in our Decision, the concepts of ‘practical application,’ ‘inventive concept,’ and ‘insignificant extra-solution activity’ are specific legal concepts, articulated in the body of case law emanating from the Court of Appeals for the Federal Circuit, and the Supreme Court, and

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<sup>4</sup> Rich, Giles S., *Laying the Ghost of the “Invention” Requirement*, 1:1 APLA Quarterly Journal, pp. 26-45 (1972) (reprinted with permission in *Nonobviousness – The Ultimate Condition of Patentability*) at p. 1:517.

*explained* in the Manual of Patent Examining Procedure (“MPEP”) and the Guidance.” (p. 35a)

Specific legal concepts? This is false. There is no special legal definition of “practical application” or “inventive concept.” The Board provided no such definitions, no such special definitions appear in the MPEP, no special definitions appear in any Federal Circuit decision, and no such special definitions appear in Supreme Court case law.

How is it possible for any patent applicant to traverse a rejection or to amend a claim to incorporate an “inventive concept” if the USPTO and Federal Circuit refuse to define the term?

The failing of this idea of this judge-made standard of “inventive concept” is that “inventive concept” is “invention” rebranded, and (as shown above) this Court thrice acknowledged that “invention” useless as a standard for patentability. The vice of “inventive concept,” however, is much more insidious. Inventive concept is a quality that cannot be, and has never been, described or measured, and thus leaves every judge free to decide what the term means and how to apply it according to said judge’s personal biases and level of technical ignorance. This is too great a power for individual judges to hold because the standard of “invention” was written out of the Patent Law in 1952, because judges lack the education to understand the various

technologies they declare lack the quality of “invention,” and because the controlling policies of the patent system should be determined by Congress.

For every Federal Circuit holding that declares something qualifies as an “inventive concept,” Petitioner can name two Federal Circuit decisions that hold the opposite.

While the Opinion below (App. 19a) also states that “claims that ‘recite a specific, discrete implementation of the abstract idea’ rather than ‘preempt[ing] all ways of’ achieving an abstract idea using a computer may include an inventive concept” this alleged test is smoke.

First, this “specificity” requirement is meaningless noise given that there’s no limiting principle as to how much specificity might possibly be enough. If Killian’s claim of 433 words isn’t specific enough, then no claim is. How exactly does the 433 words of claim 1 not “recite a specific, discrete implementation,” i.e., what the Board freely admitted is a “practical application” that the Killian claims satisfy. Second, the Board never asserted that the present claims preempt anything, and certainly never provided evidence that the present claims preempt anything.

Instead, the Federal Circuit has capriciously decided that the present claims are incurably

abstract because of some impossible fantasy about generic computer networks that comprehend data.

Petitioner Killian does not ask this Court to take certiorari merely because the Federal Circuit made a large number of mistakes. To the contrary, Petitioner requests certiorari because the Federal Circuit's *Alice/Mayo* jurisprudence is so flawed that it systematically violates the APA, due process rights, and this Court's precedent using evidence-free assertions that defy common sense.

For example, the Panel (App. 17a) asserted “[t]he ‘abstract idea’ step of the inquiry calls upon us to look at the ‘*focus of the claimed advance over the prior art*’ to determine if the claim’s ‘character as a whole’ is directed to excluded subject matter” (emphasis added) citing *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016).

Respectfully, how is it possible to determine an “advance over the prior art” without evidence as to what “the prior art” is? Do judges simply stare into the sky until some divine epiphany is revealed, or do judges suddenly achieve God-like omniscience? So long as the lower courts refuse to incorporate this Court's guidance on evidence, *Alice/Mayo* will remain legerdemain disguised as law.

## J. The Federal Circuit’s Holding Endangers the Entire Patent System

The danger of *In re Killian* is that it threatens nearly half of all enforceable patents. That is, the Decision below (App. 11a) holds that the “Board correctly concluded that ‘[t]hese steps can be performed by a human, using ‘observation, evaluation, judgment, [and] *opinion*,’ because they involve making determinations and identifications, which are mental tasks humans routinely do” (emphasis added). The Panel also cited *Electric Power Group, LLC v. Alstom S.A.*, 850 F.3d 1350 (2016) stating “the essential steps recited by claim 1—the ‘*selecting*’ and ‘*determining*’ limitations—can be performed in the human mind and are thus ‘an abstract mental process.’” (emphasis added) (p 7a-8a).

Just as an initial issue, *machines don’t have “opinions.”* Most respectfully, Petitioner does not intend any disrespect, but this is more science fantasy; a product of judges who lack rudimentary technical knowledge.

Furthermore, there are approximately 4,360,000 active patents currently in existence. Of these, about 2,030,000 of these patents include the above-emphasized forbidden words of “selecting,” or

“determining.”<sup>5</sup> App. 132a-135a. This means that over 46% of all current patents issued by the USPTO are incurably abstract under the Federal Circuit’s “mental steps” jurisprudence.

## II. The Judicially Created Exceptions to Patent Eligibility Must Be Set Aside

No court has ever pointed to any language in the Patent Law or Constitution that allows Article III courts to rewrite the Patent Law. The more difficult question that must be addressed, however, is whether this Court will overrule fifty years of past precedent in light that:

- (1) the prior decisions to create judicial exceptions to patent eligibility are egregiously wrong;
- (2) the prior decisions to create judicial exceptions to patent eligibility have caused significant negative jurisprudence and real world consequences; and
- (3) overruling the prior decisions would not upset legitimate reliance interests.<sup>6</sup>

There is no factor the Supreme Court has ever enumerated that favors *stare decisis* over reversing

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<sup>5</sup> Petitioner attempted to run the same queries on the USPTO’s website. However, the USPTO’s equivalent website was not functional at the writing of this Petition.

<sup>6</sup> See *Dobbs* 142 S. Ct. at 2307.



the destructive policy preferences on patent eligibility created by the judiciary.

**A. The Constitution and the Patent Law Do Not Empower Judges to Create Exceptions to Patent Eligibility**

As stated by this Court in *Dobbs* 142 S. Ct. at 2244, “Constitutional analysis must begin with ‘the language of the instrument.’” However, Article I, Section 8, Clause 8, of the Constitution expressly provides Congress the sole authority to “promote the progress of science and useful arts.” Using its constitutional authority, Congress passed the Patent Act of 1952, which includes Title 35 U.S.C. § 101 (“Inventions Patentable”). Section 101 recites: “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*” (emphasis added).

Nowhere under the Constitution or under § 101 or any section of Title 35 are the courts granted authority to create exceptions to patent eligibility. This is not an issue of statutory interpretation as the Patent Law makes no mention of exceptions to patent eligibility, and the word “abstract” occurs nowhere in § 101. Despite the lack of empowering language, the courts nonetheless created an ever-

growing number of exceptions to patent eligibility including scientific principles, naturally occurring phenomena, mathematical algorithms, computer-based devices, and (most recently) computer networks that comprehend data and have opinions. However, such exceptions violate congressional prerogative and ignore the express limits Congress actually created under, *inter alia*, Title 35 U.S.C. § 102 of the Patent Act of 1952, which precludes the patenting of any invention that “was known or used by others in this country . . . before the invention thereof by the applicant for patent.”<sup>7</sup>

For example, hemoglobin cannot be patented because it’s a “naturally occurring phenomena,” but because hemoglobin is precluded under § 102 due to its use “by others” and “in public use” long before people knew hemoglobin existed. Similarly, the equation of  $f = m \times a$  (force = mass  $\times$  acceleration) cannot be patented as mankind has used this law of physics since before written language existed.

An idea in and of itself, which is truly “abstract” within the plain meaning of the word, cannot be patented because such ideas fail the written description and enablement clauses of 35 U.S.C. § 112(a). That is, the drafters of the 1952 Patent Act knew what they were doing, and it is not within the

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<sup>7</sup> The American Invents Act revised this language to “in public use . . . or otherwise available to the public.”

authority of Article III courts to rewrite the Patent Law in a way that bypasses the safeguards placed into the law by Congress. For instance, the eighth claim of *O'Reilly v. Morse*, 15 How 62 (1853) was not rejected because the claim involved a law of nature, but because the eighth claim failed to comply with what would be later codified as Title 35 U.S.C. § 112(a) of the Patent Law.

“In fine, [Morse’s] claims an exclusive right to use a manner and process which he has not described and indeed had not invented, and therefore could not describe when he obtained his patent. The court is of opinion that the claim is too broad, and not warranted by law.” *Id.* at p. 113.

The Patent Law works as Congress designed it.

Title 35 U.S.C. § 103 also provides its exclusions to patentability (not patent ineligibility), and every legitimate concern of the courts in limiting patentability can be taken from the existing language if §§ 102/103/112. If a concern of the courts cannot be met by the existing patent law, the courts have no authority to impose their policy preferences.

The single possible legitimate exception to patent eligibility is an exclusion of an actual human mental process. Freedom of human thought is arguably a right “objectively, deeply rooted in this Nation’s history and tradition.” *Washington v. Glucksberg*, 521 U.S. 702, 720-721 (1997). Freedom of human

thought, however, does not extend to the operations of a computer, which courts still bizarrely equate to human thought. Computers, like hammers, are but things. There is nothing in the Constitution or this nation's history or traditions that hints that the workings of "things" should be protected the same as human thought.

### **B. Supreme Court Jurisprudence on Patent Eligibility Makes no Reference to the Constitution**

This Court has never identified its authority to create judicial exceptions to patent eligibility. For example, *Gottschalk v. Benson* makes no reference to the Constitution. With regard to *Benson*, there were two separate theories of patent ineligibility. The first theory is whether or not software was a "process" under § 101.

Unfortunately, *Benson's* process analysis had no nexus to the plain, contemporary, and ordinary meaning of the word "process," but was instead determined using erroneous criteria, such as the USPTO's inability to address a new technology. "The Patent Office now cannot examine applications for programs because of a lack of a classification technique and the requisite search files." *Benson*, 409 U.S. at 72. "Even if these were available, reliable searches would not be feasible or economic because of the tremendous volume of prior art being

generated.” *Id.* “If these programs are to be patentable, considerable problems are raised . . . .” *Id.* at 73. That is, the *Benson* holding was based on the idea that the Patent Office was too incompetent to address new and emerging technologies.

Turning to *Parker v. Flook*, 437 U.S. 584 (1978), no mention of the Supreme Court’s authority to create exceptions to patent eligibility was made. It was merely assumed. While the *Flook* decision states that “[t]he plain language of § 101 does not answer the question of whether the discovery of a novel and useful feature ‘makes an otherwise conventional method eligible for patent protection,’”<sup>8</sup> most respectfully this is untrue. The plain language of § 101 provides express categories for patent eligibility, and to merely assume a new and useful process or machine is not patent eligible because math or a computer is used is a denial of the plain language of § 101.

The decision of *Bilski* at least applied the modern, common use of the word “process” as this Court held that at least some business methods were patent eligible. Unfortunately, instead of addressing a well-known and ubiquitous business method under §§ 102/103/112 as Congress intended, the Supreme Court twisted the word “abstract” (which again does not occur in the Constitution or §

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<sup>8</sup> *Flook*, 437 U.S. at 588.

101) to an unrecognizable form. That is, in one breath the Supreme Court observed the importance of using the plain and contemporaneous meaning of words, then in the next breath mangled the word “abstract” to mean something unrecognizable.

Turning to *Alice Corp.*, the Supreme Court recognized the absurdity of precluding a claim from patent eligibility merely because a computer was used while at the same time departing from the plain language of § 101 and again twisting the word “abstract.” Unfortunately, rather than follow the Patent Law as Congress intended and dispose of the *Alice Corp.* claims under § 103 using the well-thought-out principles of, *inter alia*, *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), this Court chose a path the Supreme Court had no constitutional authority to take. *Mayo* similarly could have and should have been addressed under §§ 102/103/112.

In sum, the quality of every single holding limiting patent eligibility to date is extraordinarily poor both from a constitutional perspective and from the idea that every single issue could have and should have been addressed under the statutory framework Congress created. Accordingly, the judicial exceptions to patent eligibility represent raw abuses of power, and *stare decisis* does not compel adherence to these judicial abuses.

### C. *Alice/Mayo* Contravenes Congressional Intent

Prior to the 1952 Patent Act, U.S. Courts relied on the arbitrary standard of “invention” where patents were routinely immolated for lacking “invention,” without ever defining “invention.” In response, Congress passed the 1952 Patent Act of 1952 with the intent that patentability would be determined on an objective basis. To this end, the non-obviousness standard of Title 35 U.S.C. § 103 was codified whereby patentability was determined using the objective standard of a person of ordinary skill in the art. In the same legislative act, Congress wrote out “invention” from the Patent Law.<sup>9</sup>

Unfortunately, rather than adhering to congressional intent, Article III courts have destroyed Congress’s intended scope of patent eligibility by importing the exact same “invention” requirement that Congress excluded. Unfortunately, the § 101 jurisprudence of the courts have re-introduced subjective “invention” approach by conflating the evidence-based tests of 35 U.S.C. §§ 102, 103, and 112 with a subjective § 101 analysis.

The first instance of the term “inventive concept” occurred in *Flook* where Justice Steven’s opined that a discovery “cannot support a patent unless there is

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<sup>9</sup> See, Rich, Giles S., The Vague Concept of “Invention” as Replaced by Section 103 of the 1952 Patent Act, *supra*.

some other inventive concept in its application.” *Flook*, 437 U.S. at 594. No authority was cited for this aberration. Shortly thereafter, Judge Giles Rich recognized that inventive concept is invention rebranded stating, “[t]erms like . . . ‘inventive concept’ no longer have any useful place in deciding questions [of patentability] in the 1952 Patent Act, notwithstanding their universal use in cases from the last century and the first half of this one.” *In re Bergy*, 596 F.2d 952, 961 (C.C.P.A. 1979).

The only attempt Killian is aware of any court attempting to define “inventive concept” occurred in the *en banc CLS Bank v. Alice Corp.* decision where Judge Lourie stated:

“An ‘inventive concept’ in the § 101 context refers to a genuine human contribution to the claimed subject matter. . . . Accordingly, an ‘inventive concept’ under § 101—in contrast to whatever fundamental concept is also represented in the claim—*must be ‘a product of human ingenuity’*” (emphasis added) *CLS Bank, Int’l v. Alice Corp.*, 717 F.3d 1269, 1283 (Fed. Cir. 2012).

The immediate problem with this human ingenuity standard is that “ingenuity” is a synonym for “inventiveness.” Such a definition makes the test for inventive concept an exercise in circular logic.

Judge Rader (joined by Judges Linn, Moore, and O’Malley) recognized the problem of “inventive



concept” issuing a lengthy warning on “invention” and the havoc it wrought before the 1952 Patent Act while stating that “[i]t is inconceivable to us that the Supreme Court would choose to undo so much of what Congress tried to accomplish in the 1952 Patent Act, and to do so by the use of one phrase in one opinion.” *Id.* at 1303, fn 5.

Further, the public is increasingly aware (and the lower courts do not dispute) that “inventive concept” is “invention.” “[W]hatever else one can say about the Court’s ‘inventive concept’ test, one certainly can say it runs afoul of Congressional intent” Andrew F. Halaby, *The “Inventive Concept” Test for Patent Eligibility Contravenes Congressional Intent*. 61 IDEA 38: *The Law Review of the Franklin Pierce Center for Intellectual Property*, p. 61 (2020); “The Supreme Court’s subjective interpretation of patent eligibility law is undermining the fundamental principles underlying the 1952 Patent Act on which our modern innovation economy rests.” *AIPLA Legislative Proposal and Report on Patent Eligible Subject Matter*, p. 1 (2017); “Congress, . . . has not granted the USPTO or courts the ability to create conditions and requirements of patentability that are not set forth in the patent statute.” *Id.* at p. 12. “The analysis developed in the 101 Decisions is contrary to Congressional intent, too restrictive, technologically incorrect, unsound from a policy

standpoint, and bad law.” *Intellectual Property Owners Association, Proposed Amendments to Patent Eligible Subject Matter under 35 U.S.C. § 101* (2017) at p. 2.

#### **D. The *Alice/Mayo* Doctrine is Unworkable**

As stated above, the prior decisions to create judicial exceptions to patent eligibility have caused significant negative jurisprudence and real-world consequences. Petitioner is unaware of a single law review article or academic that speaks positively of the *Alice/Mayo* doctrine. Since this Court’s decision in *Mayo*, the Federal Circuit has invalidated every diagnostic claim to come before it as ineligible subject matter. Not a single *Alice/Mayo* rejection appealed to the Federal Circuit from the USPTO has ever been set aside. Not a single medical diagnostic claim has survived the judiciary. Name a single Federal Circuit case favoring patent eligibility, Petitioner can name no less than two Federal Circuit decisions that say the exact opposite.

However, no single Federal Circuit decision expresses the absurdity of the *Alice/Mayo* doctrine like *In re Killian*. That is, the Federal Circuit would have people believe impossibilities, such as generic computer networks having opinions and comprehending data in a decision that has the power to invalidate 46% of all patents and 100% of

all computer-based patents on a legal theory that is science fantasy while violating the *Chenery* doctrine, the APA, and due process of law. The Federal Circuit would also have people believe judges are gifted with impossible knowledge to the degree that they don't need evidence to know all aspects of the state of the art in every technological field before them.

*Alice/Mayo* has swallowed nearly all of the Patent Law to the point where technical realities no longer have sway in the courts. "Abstract" can mean anything a technically uninformed judge say it means. The lower courts can assert that a claim of any detail preempts all ways of achieving an abstract idea by ignoring claim limitations. See also, e.g., *Villena v. Iancu*, Petition No. 18-1223 (2018), where the Board and Federal Circuit held that a claim (of over 200 words) can include five separate claim limitations that are completely unknown and non-obvious under §§ 102/103 (and provide a distinct advantage never before seen or considered) and still be "well-known, routine, and conventional" under § 101. See Opening Brief at pp. 9-12.<sup>10</sup> This is because the Federal Circuit decoupled evidence from *Alice/Mayo* in favor of capricious gut-feelings. Step One of *Alice/Mayo*, removed from any meaningful evidentiary requirement, divorced from the

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<sup>10</sup> The Solicitor's Opposition Brief in *Villena* does not contest Villena's assertions.

language of the subject claims, and divorced from preemption, has resulted in a capricious and meaningless exercise.

Other past petitions to this Court are further evidence of the confusion regarding step one of *Alice/Mayo*. One notorious example of this confusion is *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC, et al.*, No. 20-891 (2021) where the lower courts came to an irrational conclusion that a method for designing vibration dampeners for automobile engines preempted all uses of Hooke's Law. See Opening Brief, p. 3, ll. 9-16. Petitioner says "irrational" because the *American Axle* holding is a physical impossibility that the lower court judges, lacking rudimentary technical knowledge, could appreciate. Even more telling evidence is the brief provide to this Court by the Solicitor of the DOJ and the Solicitor of the USPTO in *American Axle* where, instead of the DOJ and UPSTO providing helpful guidance after thirteen months of contemplation, this Court received a brief that outlined the many problems of *Alice/Mayo* and concluded that clarification is desperately needed stating (page 20):

"Applying this Court's recent Section 101 decisions 'in a consistent manner has proven to be difficult'; 'has caused uncertainty in this area of the law'; has made it difficult for 'inventors, businesses, and other patent

stakeholders to reliably and predictably determine what subject matter is patent eligible'; and 'poses unique challenges for the USPTO' itself."

Petitioner cannot think of a better example of the futility of Step One of *Alice/Mayo* than the best legal minds of the DOJ and USPTO so politely opining that *Alice/Mayo* has devolved into a chaotic failure. Unfortunately, the Solicitors (see pp. 21-22) missed the bigger issue: it is impossible for any court or the USPTO to come to a sound determination that a claim preempts previously existing man-made things without evidence.

Turning to Step Two of *Alice/Mayo*, this process was fated for failure the moment the courts resurrected "invention," a term that has defied definition for over 172 years.

Without question, the prior decisions to create judicial exceptions to patent eligibility under § 101 have caused significant negative jurisprudence and real-world consequences.

#### **E. *Alice/Mayo* Serves No Legitimate Interests**

Petitioner fully concedes that bad patents are sometimes granted and cause problems in the free marketplace. The Supreme Court addressed this problem in *KSR v. Teleflex* using an approach fully within the scope of Congress' statutory framework. Unfortunately, instead of relying on *KSR* and

possibly building upon its wisdom, this Court’s patent eligibility jurisprudence broke with the Constitution, the statutory framework of the Patent Law, and every rule of statutory interpretation. This Court instead invested in an experiment that has failed because *Alice/Mayo* enables lower court judges to choose fantasy over evidence and to adjudge patent claims based on “invention,” a term this Court thrice acknowledged was meaningless.

There can be no legitimate reliance on words having no meaning. There can be no legitimate reliance on a test that contravenes congressional intent, a comprehensive statutory framework, and constitutional principles. *Alice/Mayo* is a failed experiment.

### III. Conclusion

Most respectfully, this Court must provide guidance on *Alice/Mayo* or end it.

/s/ Burman Y. Mathis

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