No. 22-604

In The

Supreme Court of the United States

GARTH JANKE,

Petitioner,

vs.

KATHERINE K. VIDAL, Director of the United States Patent and Trademark Office,

Respondent.

On Petition For A Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Can a known patentable product become ineligible for patenting when it is claimed to be made by applying a mathematical model of the product on a 3D printer, as no one is disputing follows from *Parker v. Flook*?

And, can it be too much patent "monopoly"[1] to pre-empt (in practical effect) a mathematical model of a product, as no one is disputing follows from *Gottschalk v. Benson*, when it is known that it is not too much patent monopoly to pre-empt the real product itself?

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[1] The Court's term for the exclusive rights associated with a patent. See, e.g., *Alice v. CLS Bank*, 573 U.S. at 216.

RELATED CASES

Ex parte Garth Janke, No. 2021-005284, Patent Trial and Appeal Board. Decision entered November 18, 2021.

In re: Garth Janke, No. 2022-1274, U.S. Court of Appeals for the Federal Circuit. Judgment entered October 6, 2022.

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TABLE OF AUTHORITIES

OPINIONS BELOW

The Judgement of the Federal Circuit is reproduced at App. 1-2, and the Decision of the Patent Trial and Appeal Board is reproduced at App. 3-6. As far as Petitioner can tell, neither was officially reported.

BASIS FOR JURISDICTION

Petitioner invokes this Court's jurisdiction under 28 U.S.C. §1254(1), having timely filed this petition for a writ of certiorari within ninety days of the October 6, 2022 date of the judgement or order of the Court of Appeals for the Federal Circuit.

STATUTES INVOLVED IN THIS CASE

"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.

"Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent." 35 U.S.C. § 271(a).

STATEMENT OF THE CASE

The Patent Trial and Appeal Board affirmed the patent examiner's rejections of certain process claims in Petitioner's patent application. Petitioner appealed the rejections under 35 U.S.C. § 141 to the Court of Appeals for the Federal Circuit, which affirmed the PTAB.

ARGUMENT

Introduction

This case presents facts and circumstances under which the Court's landmark patent subject matter eligibility principles established in *Gottschalk v. Benson* and *Parker v. Flook* lead to clearly erroneous results.

Petitioner respectfully submits it is important for the Court to see this because it shows, at least, that these principles are not incontrovertibly true, as they are currently held out to be.

The Invention

The invention in this case is an improved leaf rake head. It is the same as an ordinary leaf rake head except it has holes through the ends of the raking tines that enable provision of a clog-resisting feature. This clog-resisting feature may be provided by threading a line, such as string trimmer line, through the holes. The line substantially prevents leaves and other yard debris from migrating up the raking tines, past the holes, and clogging the head. It also allows the

raking tines to flex independently of one another, the same as in an ordinary leaf rake, thus preserving an important feature of this kind of rake.

Claims 1, 21, and 26 (App. 7-8) are representative, and can be summarized as follows:

1. A leaf rake head product, as described above.

21. Installing a mathematical model of the same leaf rake head product defined in Claim 1 on a computer.

26. Applying the mathematical model of Claim 21 on a conventional 3D printer to result in making the same leaf rake head product defined in Claim 1.

Where This Case Stands

No facts are in dispute, nor were there any disputes on the merits of any of Petitioner's arguments in either of the two proceedings below.

Claim 1

The product Claim 1 has been allowed,[2] and is therefore ready to issue in a patent as soon as Petitioner completes the necessary formalities. The allowance of Claim 1 provides an important point of reference for this case.

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[2] App. 3-4.

The Rejected Process Claims

There is no dispute that the rejected process claims satisfy all the statutory requirements for patenting, but are nevertheless ineligible for patenting according to *Benson* and *Flook*.

Rejected Claim 21

Claim 21 is ineligible for patenting according to *Benson* because a patent would pre-empt substantially all practical use of an "abstract idea," in this case a mathematical model of the product.[3]

It certainly would. There is no practical use for a mathematical model of any product that would not require, at least, installing it on a computer as recited in Claim 21.

But why would pre-empting (in practical effect) a mathematical model of a leaf rake head be a problem, if it is not a problem to pre-empt the product itself?

After all, what substantial practical use could there be for this model, other than making, using, or selling this product, in the very limited number of ways

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[3] "It is conceded that one may not patent an idea. But, in practical effect, that would be the result if the formula . . . were patented in this case. . . . [It] has no substantial practical application except . . . [the one claimed], which means that . . . the patent would wholly pre-empt the mathematical formula and, in practical effect, would be a patent of the algorithm itself." *Gottschalk v. Benson*, 409 U.S. at 71-72.

that would require the use of a computer, all of which a patent on the product will pre-empt anyway?

Alternatively, how could pre-empting (again, in practical effect) a mathematical model of a leaf rake head "inhibit further discovery,"[4] more than pre-empting the real thing? Probably everyone has experience with leaf rakes and can see that at least the best way to learn more about them is not to model them on computers, but to actually use them in the real world to rake leaves.

No one is disputing that this conclusion which follows categorically from *Benson*, that pre-empting a computer model[5] of Petitioner's leaf rake head product would be too much patent monopoly, when it has already been decided that it is not too much patent monopoly to pre-empt the real product itself, is wrong.

Rejected Claim 26

Claim 26 is ineligible for patenting according to *Flook* because *Flook* requires treating the abstract idea of Claim 21[6] as if it were known, and asking if

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[4] The Court's concern according to *Alice*. 573 U.S. at 216.

[5] The mathematical model recited in Claim 21 is transformed into a computer model when it is installed on a computer, as recited in the claim.

[6] I.e., the mathematical model of the product of Claim 1.

there is anything more in Claim 26 that is inventive.[7] The answer is clearly "no." It was not even remotely inventive to apply a mathematical model of the product of Claim 1 on a conventional 3D printer to make the product as recited in Claim 26.

Yet, the product has been officially determined to be patentable. So how is it possible for a product to be patentable when it is claimed with no limitations at all on how it is made, but not even be eligible for patenting when it is claimed more specifically to be made with a 3D printer?

It makes no sense. Granted, 3D printing is a conventional and obvious means for making this kind of product. So it cannot add to the patentability of the product. But it cannot subtract from the patentability of the product either. It is the same product whether made with a 3D printer or not. It is exactly the same product in rejected Claim 26 as in allowed Claim 1.

Conflict Between *Flook* and § 271(a)

This Court acknowledges implying exceptions to the patent subject matter eligibility statute § 101.[8] This case shows something new – that *Flook* also

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[7] "[T]he discovery of such a phenomenon cannot support a patent unless there is some other inventive concept in its application." *Parker v. Flook*, 437 U.S. at 594.

[8] See *Alice v. CLS Bank*, 573 U.S. at 215 ("We have long held that this provision contains an important implicit exception").

implies an exception to the patent infringement statute § 271(a).

According to § 271(a), making a patented product without the patent owner's authority is actionable infringement no matter what kind of process is used to do it. Thus, Petitioner is entitled to pre-empt the process of Claim 26 for making the product of Claim 1 as a statutory consequence of being entitled to patent the product. These entitlements go hand-in-hand according to § 271(a).

But according to *Flook*, Petitioner is not entitled to pre-empt the process of Claim 26, no matter his right to patent the product. According to *Flook*, the process of Claim 26 is not even eligible to be pre-empted by a patent.

So these two authorities are in conflict. One of them must be wrong, and the consequences of § 271(a) being wrong, to allow patentees to protect their patented products from being made with 3D printing processes like Claim 26, are untenable.

CONCLUSION

Despite all the Court said in *Alice* explaining and reaffirming the principles of *Benson* and *Flook*, these principles have remained contentious. This case helps for seeing why. The results of applying these principles here, that Claims 21 and 26 cannot be patented when Claim 1 can, even though all three claims are directed

to exactly the same invention, are a prima facie showing that these principles arbitrarily discriminate against computer-based subject matter.

Neither the PTAB nor the Federal Circuit could address this case out of deference to this Court. It can only be addressed here, and it is important that it be addressed especially because the principles of *Benson* and *Flook* are Court-imposed exceptions to the controlling statute.[9] So it is especially important that they not be wrong, even sometimes.

DATED this 28th day of December, 2022.

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[9] See id.

APPENDIX
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