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Re: Proposed amendment to S.1546, the Patent Eligibility Restoration Act, to grandfather preexisting business method, artificial intelligence, and similar patents

Dear Senator Tillis, Senator Coons, Rep. Kiley, Rep. Peters, and Members of the Judiciary Committees:

NAPP is the National Association of Patent Practitioners, an organization of patent professionals in the United States. NAPP generally favors S.1546, the Patent Eligibility Restoration Act (PERA), and appreciates your leadership on reforming the patent system to benefit American innovators. However, NAPP is concerned with one feature and suggests a correction. As pending today, PERA introduces a novel legal test that has no parallel in the law of any other country and is unanticipated by the patent bar. This novel test may be utilized to revoke too many existing patents. NAPP urges that proposed § 101(b)(2)(A) be amended to track current USPTO examination guidance¹. The amendment we propose here does not move the lines drawn in PERA, only the type of facts that may be used to meet one of those lines. Because our suggestion tracks current USPTO guidance, it is well within the mainstream of patent law doctrine and follows an established baseline that will be necessary to appropriately grandfather existing patents and applications.

NAPP is the third-largest organization of patent professionals in the United States and the only national organization dedicated exclusively to patent practice before the United States Patent and Trademark Office (USPTO). Our members include patent attorneys, patent agents, and other practitioners who work daily with inventors, businesses, and the USPTO. As active participants in the patent system, we are committed to promoting improvements that strengthen innovation while preserving a balanced and predictable legal framework.

NAPP is concerned that the existing language of proposed § 101(b)(2)(A), “cannot practically be performed without the use of a machine,” excludes inventions that constitute an improvement to technology,

¹ For example, see Manual of Patent Examining Procedure (MPEP) § 2106.04(d)(1).

but that could theoretically be performed by a human at a small scale. To cure this, we believe that the language of proposed § 101(b)(2)(A) should be amended to track existing USPTO guidance. That guidance allows eligibility for business method, artificial intelligence (and similar) inventions that *enable* improvement to technology that results in performance beyond that of human capability, even if beyond-human performance *itself* is not recited in the claim. The guidance allows that performance beyond human capability (for example, at the large scale or within the short timeline required by industry) may be taught in the specification rather than in a claim itself, as long as the claim includes limitations that reflect the improvement described in the specification.

Many computer-implemented inventions *can* be conducted manually if the transaction volume is small enough or the permitted time is long enough. For example, many new computer products, during testing or during the first few days of commercial use, operate at a volume that *could* be handled by a human. This fact alone should not invalidate the claims. The existing PERA language could be read to *require* language that excludes *all possible* performance by a human (“if the invention cannot practically be performed without the use of a machine or manufacture”). In practice, that could require claim language such as “at least 10,000 transactions per day” or “in no more than 50 milliseconds.”

That standard is completely novel: NAPP has found no equivalent anywhere in any country of the world, and no equivalent in existing law. PERA’s pending § 101(b)(2)(A) is directly contrary to the Patent Office’s examination guidance. Because there is no historical or international analogy, essentially no existing patent claims include language that would *necessarily exclude all possible* manual implementation. As a practical matter, essentially no existing patents would be grandfathered. Further, *very* few pending applications would support an amendment to fit PERA as it is currently proposed.

The USPTO’s current guidance for examiners offers a standard that better squares with international norms and practice. The guidance explains that a showing that an invention “cannot practically be performed without the use of a machine” can be found in the *specification*, as long as a claim has correlative language relating to the specific enabling technology in the specification, even if the claim *as written* is capable of human performance at small scale. MPEP § 2106.04(d)(1) reads as follows:

[I]f the specification sets forth an improvement in technology, the claim must be evaluated to ensure that the claim itself reflects the disclosed improvement. That is, the claim includes the components or steps of the invention that provide the improvement described in the specification. The claim itself does not need to explicitly recite the improvement described in the specification (e.g., “thereby increasing the bandwidth of the channel”).

NAPP strongly believes that PERA’s pending § 101(b)(2)(A) should be amended to track this principle. MPEP § 2106.04(d)(1) sets a standard that current issued patents and pending patent applications can meet, that conforms to international norms, and that U.S. applicants have relied on for nearly a decade. Under this guidance, hundreds or thousands of patents are issued each year; PERA should grandfather them.

This concern is not merely theoretical. In *Trinity Info Media, LLC v. Covalent, Inc.*, 72 F.4th 1355 (Fed. Cir. 2023), the Federal Circuit considered a data-processing invention that, as a practical matter, required computerized implementation for meaningful real-world use. Nevertheless, the court focused on the theoretical possibility that the claimed process could be performed manually at small scale. The case illustrates the importance of distinguishing between theoretical human performance and practical real-world implementation

when evaluating patent eligibility. NAPP believes that theoretical uses should not result in ineligibility if the specification describes an invention that enables results not reasonably achieved by unaided humans.

Accordingly, NAPP believes that claims should be eligible if the *specification* teaches techniques that *enable* operation at scale that would be impractical without the use of a machine (as opposed to excluding *all possibility* of human performance), provided that the claims reflect the improvement. A patent document that describes how an invention improves performance above the capacity of an unaided human should confer patent eligibility, even if (taken literally) the claims also cover some situations that *could* theoretically be performed manually. That results in a clear standard consistent with current practice that would grandfather a significant number of existing patents. Most currently pending applications could be easily amended to meet the standard we propose here.

NAPP is suggesting the concept, not particular language. For sake of discussion, NAPP suggests amending § 101(b)(2)(A) as follows:

“(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: ...

(B) A process that is substantially economic, financial, business, social, cultural, or artistic, even though at least 1 step in the process refers to a machine or manufacture.

(2) CONDITIONS.—For the purposes of—

(A) subparagraphs (A) and (B) of paragraph (1), the claimed invention shall not be excluded from eligibility for a patent if the invention’s specification practically enables or substantially improves performance beyond that ~~cannot~~ practically available be performed without the use of a machine or manufacture , provided that the claims reflect the improvement;

NAPP understands the general concern that claim language amounting to merely “do it on a computer” should not be sufficient to establish eligibility. The law should require a nexus between the claim and the resulting improvement, to ensure that the use of a machine is a substantial feature of the invention. NAPP believes a standard consistent with MPEP § 2106.04(d)(1) is the best way to strike this balance.

NAPP strongly supports the general direction of reform embodied in PERA, because it advances fairness, predictability, and incentives for American software, finance, and artificial intelligence innovators. We deeply appreciate your leadership on this pro-innovation, pro-economic growth statute. We appreciate your continued leadership on patent policy and your efforts to restore clarity and predictability to patent eligibility law through the Patent Eligibility Restoration Act (PERA), S.1546, and suggest that our amendment contributes to those goals.

Of course, we would be happy to answer any questions.

Respectfully submitted,
National Association of Patent Practitioners (NAPP)



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