June 30, 2019

Senator Thom Tillis  
Chair, Senate IP Subcommittee  
113 Dirksen Senate Office Building  
Washington, DC 20510  
Representative Hank Johnson  
Chair, House IP Subcommittee  
2240 Rayburn House Office Building  
Washington, DC 20510

Senator Chris Coons  
Ranking Member, Senate IP Subcommittee  
218 Russel Senate Office Building  
Washington, DC 20510  
Representative Steve Stivers  
2234 Rayburn House Office Building  
Washington, DC 20515

Representative Doug Collins  
Ranking Member, House Judiciary Committee  
1504 Longworth House Office Building  
Washington, DC 20515

RE: Patent Eligibility

Dear Senator Tillis, Senator Coons, Representative Collins, Representative Johnson and Representative Stivers:

We applaud your efforts over the last several months to engage stakeholders on the important issue of patent eligibility reform. We view this effort as critical for the future of a variety of high-tech and life sciences industries in the United States.

As was discussed during testimony in recent hearings of the Senate IP Subcommittee, the Supreme Court has refused four (4) dozen petitions for certiorari on the issue of patent eligibility since issuing its decision in *Alice Corp. v. CLS Bank Int’l*, 134 S.Ct. 2347 (2014). The assumption must, therefore, be that the Supreme Court is content with its patent eligibility jurisprudence.

Unfortunately, Supreme Court jurisprudence on patent eligibility is irreconcilable and has created tremendous uncertainty in an area where long term certainty is absolutely essential. Innovation typically takes a great deal of time, and commercializing that innovation takes even more time. Without long term stability and predictability investment decisions and incentives become skewed.

The United States Court of Appeals for the Federal Circuit has explained in at least several decisions that they feel handcuffed by Supreme Court jurisprudence. But even more problematic is the wide divergence of outcomes among Federal Circuit panels. Put simply, the Supreme Court test for patent eligibility is subjective and unpredictable. Congress must act.

Amidst this uncertainty, and with the fifth anniversary of the Supreme Court’s *Alice* decision having just passed, last week IPWatchdog.com held a two-day symposium to discuss the state of patent eligibility in the United States. During this symposium overwhelming consensus was achieved by the Patent Masters™ faculty and symposium attendees on a variety of principles and recommendations.
The following statements received unanimous consent during the Patent Masters™ Symposium:

1. Supreme Court decisions interpreting 35 U.S.C. 101 have harmed the U.S. economy.
2. Supreme Court decisions interpreting 35 U.S.C. 101 are impeding the progress of the useful arts.
3. Supreme Court decisions interpreting 35 U.S.C. 101 are impeding the progress of innovations relating to medical diagnostics.
4. Supreme Court decisions interpreting 35 U.S.C. 101 are impeding the progress of innovations relating to important areas of software innovations, such as artificial intelligence and machine learning.
5. Supreme Court decisions interpreting 35 U.S.C. 101 have diminished America's global competitiveness.
6. The Supreme Court was unquestionably incorrect in AMP v. Myriad Genetics when they said discoveries are not patent eligible. The Constitution explicitly says otherwise, as does 35 U.S.C. 101.

The following statements achieved consent from at least eighty-percent (80%) of those attending the symposium:

1. The Supreme Court's decisions on patent eligibility in Funk Brothers, Benson, Flook, Diehr, Chakrabarty, Bilski, Mayo, Myriad and Alice are hopelessly irreconcilable. [92% consensus]
2. Supreme Court decisions interpreting 35 U.S.C. 101 are driving innovation and investment overseas. [87% consensus]
3. Supreme Court decisions interpreting 35 U.S.C. 101 violate separation of powers by adding "judicial exceptions" and usurping Congressional authority to define what is patent eligible. [85% consensus]
4. The 2019 Revised Patent Subject Matter Eligibility Guidance published by the USPTO creates the proper analytical framework for approaching questions of patent eligibility. [83% consensus]

Therefore, it is the recommendation of the undersigned faculty and attendees of the Patent Masters™ Symposium that:

1. Congress should legislatively overrule Alice v. CLS Bank.
2. Congress should legislatively overrule Mayo v. Prometheus.
3. Congress should explicitly prohibit "judicial exceptions" to patent eligibility.

In conclusion, we greatly appreciate your work on this important matter, and we enthusiastically support your efforts. We stand ready to help in any way possible. Strengthening the U.S. patent system for future generations is of paramount importance.

Very truly yours,

Eugene R. Quinn, Jr.  Chief Judge Paul Michel (ret.)
President & CEO, IPWatchdog, Inc.  U.S. Court of Appeals for the Federal Circuit
Meredith Addy  
Founding Partner, AddyHart, P.C.

James Carmichael  
Founding Partner, Carmichael IP

Brad Close  
Executive Vice President, Transpacific IP

Nicholas D’Andrea  
Patent Agent

Kate Gaudry, PhD  
Patent Attorney (on behalf of myself)

Robert Greenspoon  
Partner, Flachsbart & Greenspoon, LLC

Chris Israel  
Executive Director, Alliances for U.S. Startups and Inventors for Jobs

Efrat Kasznik  
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c. Andrei Iancu, Director of the United States Patent & Trademark Office