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Bryan McWhorter

Bryan.McWhorter@knobbe.com

T (206) 405-2000

Committee Chair  
Patent Office Rules and Practices Committee  
Washington State Patent Law Association

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**VIA EMAIL ONLY**  
2014 interim guidance@uspto.gov

Mail Stop Comments-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Raul Tamayo and Michael Cygan, Senior Legal Advisors, OPLA

Re: WSPLA Comments on Proposed “July 2015 Update on Subject Matter Eligibility,” 80 F.R. 45429

Dear Messrs. Tamayo and Cygan,

The Washington State Patent Law Association (“WSPLA”) wishes to provide the following comments in response to the July 2015 Update on Subject Matter Eligibility announced on July 7, 2015 in the Federal Register (80 F.R. 45,429) (“Updated Guidance”), which was published as an update to the 2014 Interim Guidance on Patent Subject Matter Eligibility, published on December 16, 2014 in the Federal Register (79 F.R. 74,618) (“Interim Guidance”), both of which regard examination for subject matter eligibility of patent claims.

The patent eligibility analysis set forth in the Interim Guidance (the “eligibility analysis”) requires that a claim be first compared to the four statutory categories of patentable subject matter set forth in 35 U.S.C. § 101. Should the claim do so, the Interim Guidance further instructs examiners to analyze the claim under the two-part analysis for identifying judicial exceptions, as set forth by the Supreme Court, e.g., in *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) and *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* 132 S. Ct. 1289 (2012). In this regard, the Interim Guidance states that an examiner should “determine

whether the claim [] is directed to a judicial exception” in Step 2A, and “determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to significantly more than the judicial exception” in Step 2B. Interim Guidance, pp. 74,622-74,624. With respect to this two-part analysis to identify judicial exceptions, WSPLA provides the following comments:

**A. The Updated Guidance should be revised to require identification of where a purported judicial exception is recited in the claim.**

To ensure clarity of rejections for alleged ineligible subject matter, WSPLA recommends that the Office revise the Updated Guidance to specifically instruct examiners, in Step 2A, to identify which portions of a claim recite or describe a judicial exception. The Interim Guidance and Updated Guidance arguably require this in their current form. Interim Guidance, p. 74,622 (instructing examiners to “identify the judicial exception recited in the claim”) (capitalization removed); Updated Guidance, p. 6 (stating that a prima facie burden is satisfied in part by “providing a reasoned rationale that identifies the judicial exception recited in the claim”). In practice, however, examiners often implement these instructions by simply stating that an alleged judicial exception is recited in a claim, without directly identifying the recitations of a claim that “set forth or describe” the judicial exception. This creates substantial uncertainty on the part of an applicant, because the applicant is unable to determine the rationale for the allegation. Moreover, failing to identify those recitations that actually form part of the judicial exception leaves ambiguity as to what “additional elements” are recited in the claim, hampering Step 2B of the eligibility analysis.

An explicit instruction for examiners to positively identify where a purported judicial exception is recited in the claims (e.g., with reference to individual elements of a claim) would ensure a more complete record, giving applicants sufficient notice of the rejection and a better opportunity to respond. It would also ensure the quality of Office Actions, by allowing claims that actually set forth or describe a judicial exception to be distinguished from those that merely “embody, use, reflect, rest upon, or apply” a judicial exception, as all claims do. *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67). These instructions would harmonize Patent Office procedure with the analysis of the Courts, which frequently discuss the actual recitations that cause a claim to be “directed to” a judicial exception. See, e.g., *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (“The process of receiving copyrighted media, selecting an ad, offering the media in exchange for

watching the selected ad, displaying the ad, allowing the consumer access to the media, and receiving payment from the sponsor of the ad[, as set forth in the claim at issue,] all describe an abstract idea”); *see also Context Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343 (Fed. Cir. 2015) (finding the claim at issue to be directed to the abstract idea of “collecting data,” “recognizing certain data within the collected data set,” and “storing that recognized data in a memory,” when the claim recited “receiving output,” “recognizing a first data field [from the output],” and “storing information from ... said first data field into a memory”). These instructions would further ensure that issued Office Actions satisfy the Office’s initial burden of establishing a prima facie case of ineligibility. *See PNC Bank v. Secure Access, LLC*, Patent Tr. & App. Bd., Case No. CBM2014-00100, at 20-21 (Sep. 9, 2014) (an allegation that “does not tie adequately the claim language to the purported abstract concept” is insufficient to establish prima facie ineligibility).

As noted above, the current Guidance already instructs examiners to identify any judicial exception recited in a claim. Thus, an explicit instruction to identify those claim elements that set forth or describe a judicial exception would not significantly increase an examiner’s duties in analyzing a claim. Instead, this modification merely makes the examiner’s analysis explicit, and thereby ensures a complete and accurate record to which an applicant may respond.

**B. The Updated Guidance should be revised to define “additional elements” as any element not setting forth or describing a judicial exception.**

In Step 2B, the Interim and Updated Guidance instruct examiners to consider whether “additional elements” of a claim amount to significantly more than a judicial exception. Updated Guidance, p. 1; Interim Guidance, p. 74,624. However, neither document provides direction as to what constitutes an “additional element.” Given that a recitation must constitute an “additional element” in order to satisfy Step 2B of the eligibility analysis, the lack of definition for this term creates substantial uncertainty in that eligibility analysis.

To correct this, WSPLA proposes that the Office define “additional elements” as any element of a claim not identified in Step 2A as an element that sets forth or describes a judicial exception. This definition comports to the apparent intentions of the Interim and Updated Guidance, which emphasize the importance of “additional elements” in ensuring that a claim is “more than a drafting effort designed to monopolize” a judicial exception set forth or described in a claim. Interim Guidance, p. 74,624 (citing *Alice*, 134 S. Ct. at 2357). Moreover, such a definition, when taken with an instruction that examiners specifically identify the elements of a

claim that set forth or describe a judicial exception (as proposed above), would harmonize Section 101 analysis with the current practices of the Office under other sections of the Patent Act, such as Sections 102 and 103. For example, such a definition would enable examiners to set forth each recitation of the claim, and identify whether that recitation i) forms part of a judicial exception (and therefore need not be further analyzed); or (ii) is an additional element that should be analyzed under Step 2B.

The eligibility analysis, as currently set forth in the Interim and Updated Guidance, relies heavily on consideration of “additional elements.” Thus, it is crucial that examiners and applicants be provided with a clear definition of this term. As with the proposal above, inclusion of this definition would not significantly increase an examiner’s duties in analyzing a claim, but would merely make the examiner’s analysis explicit. This change would thereby help to ensure a complete and accurate record to which an applicant may respond, and facilitate compact prosecution.

**C. The Updated Guidance should be revised to emphasize that Step 2B of the eligibility analysis is a well-defined question that should be answered directly.**

The Interim and Updated Guidance instruct examiners to “[d]etermine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to significantly more than the judicial exception.” Interim Guidance, p. 74, 624. The Interim Guidance provides a number of examples for when elements of a claim constitute “significantly more” than a judicial exception, such as whether a claim provides improvements to another technology or technological field. *Id.* While the Interim Guidance indicates that these examples are non-exhaustive, many Office Actions continue to base Step 2B of the eligibility analysis completely on these examples.

However, whether an element constitutes “significantly more” need not be analyzed according to an incomplete checklist of examples. The Supreme Court has explicitly defined the test for whether an additional element constitutes “significantly more”: to do so, an additional element (individually or in combination with other elements) must be “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* 132 S. Ct. 1289 (2012)). Thus, WSPLA proposes that the Office instruct examiners to address this question directly, by making an explicit finding as to whether each additional element, individually or in combination with other additional elements, is sufficient to

ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself. The existing Interim Guidance and Updated Guidance already include sufficient criteria to enable examiners to make this finding. For example, the Interim Guidance includes a number of rationales that may render an additional element insignificant under Step 2B (e.g., as a well-understood, routine and conventional activity, as insignificant post-solution activity, or as a general linking of the judicial exception to a particular field of use). Interim Guidance, p. 74,624. WSPLA further proposes that the Office explicitly note the failure of a claim to fit into the non-exhaustive examples provided in the Interim Guidance does not render the claim patent ineligible. Rather a claim should be found ineligible only when the claim does not include any element or combination of elements sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself. These additions to the current guidance would help to ensure a prima facie case of ineligibility is set forth in Office Actions, by encouraging examiners to explain why all additional elements are not significantly more (under the well-defined question above), rather than simply stating that each additional element does not fall into one of the non-limiting considerations noted in the Interim Guidance.

Because the Interim and Updated Guidance already instruct examiners to consider whether additional elements constitute “significantly more” than a judicial exception, this proposed modification can be implemented without significant cost to the Office. Moreover, this modification would greatly benefit both applicants and examiners, by encouraging use of the single, well-defined standard put in place by the Supreme Court in conducting Step 2B of the eligibility analysis.

#### **D. Conclusion**

In sum, WSPLA proposes that the Office: 1) instruct examiners to specifically identify which elements of a claim set forth or describe a judicial exception, 2) define “additional elements” as any elements not setting forth or describing that judicial exception, and 3) instruct examiners to directly consider whether those additional elements constitute “significantly more” than the judicial exception based on whether the additional elements, individually or in combination, are sufficient to ensure that the claim amounts to significantly more than the judicial exception. These proposals do not differ significantly from the current Guidance, and thus would not substantially increase the workload of Examiners under that Guidance. However,

these proposals would substantially increase the quality of Office Actions by establishing a clear record for any rejection and providing adequate rationale to which applicants may respond.

Best regards,

/Bryan McWhorter/

Bryan G. McWhorter

Reg. No. 70,780

Committee Chair

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