HOWARD IP LAW GROUP, PC
Post Office Box 226
Fort Washington, PA 19034
Tel: 215-542-5824
Fax: 215-542-5825

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The Honorable Drew Hirshfeld
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re: Response to Request for Comments July 2015 Update on Subject Matter Eligibility
USPTO Docket No. PTO-P-2015-0034
80 Federal Register 45429 (July 30, 2015)

Dear Commissioner Hirshfeld:

Howard IP Law Group, PC (the "Firm") submits the following comments in response to the USPTO's Request for Comments, published in the Federal Register on July 30, 2015, requesting comments on the July 2015 Update on Subject Matter Eligibility ("July 2015 Update"). The Firm welcomes the opportunity to provide views in response to the request for comments, and appreciates the USPTO's willingness to consider the views of a wide variety of stakeholders in formulating examination instructions in this important area. The Firm commends the USPTO's willingness to consider comments on the July 2015 Update, including the additional Examples and related materials.

1) Introduction

a) The Firm has substantial experience in prosecution of patent applications relating generally to the financial services industry, including a substantial number of cases presently and formerly under examination in Art Units 3691-3696. The Firm has reviewed numerous Office Actions applying the 2014 Interim Patent Eligibility Guidance ("Interim Guidance") and the July 2015 Update and discussed the application of the Interim Guidance and the July 2015 Update with Examiners during numerous interviews. The Firm thus has substantial practical insight into the manner in which the Interim Guidance and the July 2015 Guidance have been applied, as well as generally into qualities of guidance that can assist Examiners in consistently and correctly applying the law.

b) The Firm wishes to express its appreciation for the Office's consideration of prior comments and relevant case law in development of the July 2015 Update.

c) In Section 2 of the comments below, a particular modification to the Guidance and the Examples: Abstract Ideas is recommended for the use of Examiners in connection with the application of the Examples: Abstract Ideas.

2) Recommendation for Modification

We recommend the following modifications to the Guidance and Examples.

We recommend providing statements in the Guidance and in the Examples: Abstract Ideas to clarify that the examples identifying claims as patent-eligible are examples, and are not to be read as limited to the particular technology in the example. We recommend that training of Examiners in subject matter eligibility emphasize that the Examiners should rely on the Guidance and the Examples, and should not seek to determine their own rules or interpretations of the Examples. In particular, we recommend modifying the discussion of the Federal Circuit decision in *DDR Holdings* to clarify that the holding is not limited to Internet-centric subject matter, but broadly applies to technology, and in particular to solutions rooted in *any* technology, in order to overcome problems arising as a result of *any* technology.

This recommendation arises from our experience in the characterization of the holding in reviewing rejections under 35 U.S.C. 103. In particular, Examiners in Office Actions and in telephone interviews have characterized the holding of the Court of Appeals in *DDR Holdings* as confined to Internet-based claims.

This narrow characterization is plainly contradicted by the opinion itself. A close reading of the following quote from the Court's opinion illuminates that the holding was not intended to be confined to the Internet:

> "As an initial matter, it is true that the claims here are similar to the claims in the cases discussed above in the sense that the claims involve both a computer and the Internet. But these claims stand apart because they do not merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet. Instead, the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks."

DDR Holdings, LLC v. Hotels.com, L.P., 773 F.3d 1245, 1257 (Fed. Cir. 2014). This quote strongly reinforces the conclusion that the holding of *DDR Holdings* is not confined to Internet-related inventions. The Court's opinion states that the fact that *DDR Holdings* involves computers and the Internet is a similarity with fact patterns in cases holding claims not to be patent-eligible. This statement makes clear that claims in technological areas other than the Internet are, if anything, more likely than Internet-centric claims to be considered patent-eligible.

Furthermore, the Court, in the quote above, employs the broad term "computer technology" in characterizing the inventive solution. The term "computer technology" itself clearly encompasses technologies other than Internet. Moreover, there is nothing in the opinion that suggests that the term "computer technologies" was employed to limit the scope of technologies that could be covered by the principles of the opinion. Rather, the phrase "computer technology" simply encompasses the type of technology at issue.

The identification of the problem addressed as "specifically arising in the realm of computer networks" does not restrict the holding of *DDR Holdings* to problems arising in computer networks. Rather, the Court was explaining that the problem, in contrast to prior cases, was not a type of problem encountered in the business world. The fact that the particular technology that

gives rise to the problem in *DDR Holdings* is the technology of computer networks, does not suggest that the holding of DDR Holdings is limited to computer networks.

The fact pattern in *DDR Holdings* involves an invention implemented on the Internet to address a problem arising from new technology, and in particular Internet-based technology. As the fact pattern involves the Internet and websites, the language of the opinion necessarily frequently references terms specific to the fact pattern, such as Internet, hyperlink, website and web server. The use of these terms throughout the opinion in no way should be interpreted as limiting the scope of the principles of the case to the Internet. In general, the scope of precedential opinions in patent cases is not limited to the particular technology at issue.

Further, the statement by the Court that "not all claims purporting to address Internet-centric challenges are eligible to for patent" (773 F.3d at 1258) does not limit the scope of the Court's holding to Internet technologies. Rather, the Court then proceeds with a discussion of distinctions between *DDR Holdings* and the holding in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014), *cert. denied sub. nom. Ultramercial v. Wildtangent, Inc.*, 2015 U.S. LEXIS 4411 (June 29, 2015). The *Ultramercial* decision represents an example of claims involving the Internet that are not patent-eligible. Thus, the Court was noting that the decision should not be read as a *per se* rule of patent-eligibility where the Internet is involved, but was not seeking to limit the holding to a particular technology.

Accordingly, we recommend clarifying the Guidance and the discussion of *DDR Holdings* in the Examples: Abstract Ideas, to state as follows:

> Claims reciting solutions rooted in *any* technology, in order to overcome problems arising as a result of *any* technology, are patent-eligible. The examples of patent-eligible claims are merely exemplary, and the principles illustrated are not limited to the technological fields of the examples.

Conclusion

We appreciate the opportunity to provide these comments in response to the request for comments on the July 2015 Update. We would be pleased to answer any questions that our comments may raise, and would welcome the opportunity to participate further in the development of examination instructions in this area.

Respectfully submitted,

/Robert E. Rosenthal/

Robert E. Rosenthal
For Howard IP Law Group, PC