From: Garth Richmond [mailto:]
Sent: Friday, November 24, 2017 8:41 AM
To: 2014_interim_guidance <2014_interim_guidance@USPTO.GOV>
Subject: Comments re May 2016 IEG Update

Now that courts have identified inventive concepts that are not abstract ideas, the instruction to Examiners (July 2015 Update) to "refer to the body of case law precedent in order to identify abstract ideas by way of comparison to concepts already found to be abstract," should be expanded to also include a comparison to court-identified, patent-eligible concepts. In this regard, please consider the following rewrite of the paragraph bridging pages 2-3 of the subject guidance:

When the Examiner has determined the claim recites an **abstract idea**, the rejection should identify the abstract idea as it is recited (*i.e.*, set forth or described) in the claim, and explain why it corresponds to a concept that the courts have identified as an abstract idea and explain why it does not correspond to a concept that the courts have identified as not being abstract. See, for example, the concepts identified on the July 2015 Update: Interim Eligibility Guidance Quick Reference Sheet, page 2, and October 2017: Interim Eligibility Guidance Quick Reference Sheet, *Decisions Holding Claims Eligible*. Citing to an appropriate court decision that supports the identification of the subject matter recited in the claim language as an abstract idea--while distinguishing any court decision that potentially rebuts such identification--is a best practice that will advance prosecution. Examiners should be familiar with any cited decision relied upon in making or maintaining a rejection to ensure that the rejection is reasonably tied to the facts of the case and to avoid relying upon language taken out of context. Examiners should not go beyond those concepts that are similar to what the courts have identified as abstract ideas. Examiners are reminded that a chart of court decisions is available on the USPTO's Internet Web site.

Sample explanation: The claim recites the steps of sorting information by X, which is an abstract idea similar to the concepts that have been identified as abstract by the courts, such as organizing information through mathematical correlations in *Digitech* or data recognition and storage in *Content Extraction*, and the claim is not directed to an improvement in computer technology as the court identified in *Enfish* in distinguishing *Digitech*, or as the court identified in *Visual Memory* in distinguishing *Content Extraction*.

Regards,

Garth D. Richmond