



## I. INTRODUCTION

On behalf of Dell, Inc., we are pleased to submit these comments in response to the United States Patent and Trademark Office's ("Office") Request for Comments on Determining Whether a Claim Element Is Well-Understood, Routine, Conventional for Purposes of Subject Matter Eligibility published at 83 Fed. Reg. 17536 (2018) (Docket No. PTO-P-2018-0033). ("Berkheimer Patentability Guidelines"). At the outset, we would like to thank the Office for its continued efforts to clarify patent examination criterion under the subject matter eligibility portion of the Patent Statute.

The Berkheimer Patentability Guidelines clarify how an Examiner should make factual determinations regarding whether a claim element is well-understood, routine, or conventional from the perspective of a skilled artisan in the relevant field. Under the proposed rules, Examiners can provide evidence of the well-understood, routine, or conventional nature of a pending claim element or combination of elements in one of four ways: (1) a citation to an express statement in the specification or to a statement made by an applicant during prosecution; (2) a citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II); (3) a citation to a publication; or (4) a statement that the examiner is taking official notice.

After issuing these guidelines, the Office requested comments from interested constituents. As an American, multinational computer technology computer that develops, sells, repairs, and supports computers and related products and services including personal computers, servers, data storage devices, network switches, software, computer peripherals, HDTVs,

cameras, printers, MP3 players, and electronics, we actively seek patent protection for our innovations in these areas. Presently, we have more than 5000 pending U.S. Patent Applications.

While we suggest certain clarifications regarding the Berkheimer Patentability Guidelines, we wish to emphasize our appreciation for the Office's attempts to bring clarity and uniformity to its Section 101 patent examination. In terms of clarifications to the Berkheimer Patentability Guidelines, we believe allowing Examiners to merely cite to previous court decisions without analysis or to take official notice of the well-understood, routine or conventional nature of an element will not achieve the Office's stated goals. Accordingly, we recommend clarification regarding a substantive threshold for case law citations as a means of showing the well-understood, routine, or conventional nature of a claim element. We further recommend omitting the availability of official notice as a means for Examiners to show the well-understood, routine or conventional nature of an element.

## II. ANALYSIS

### A. Allowing Examiners to Take Official Notice Regarding the Well-Known Nature of a Pending Claim Element Increases Cost and Delay in Patent Prosecution

Under the Berkheimer Patentability Guidelines, the Office allows an Examiner to take official notice regarding the well-understood, routine, conventional nature of pending claim elements. *See* Berkheimer Memo § III(A)(4). Perhaps to balance the unfettered, subjective nature of this option, the Office cautions:

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This option should be used only when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a).

*Id.* If the Applicant challenges the Examiner’s position, “the examiner must then provide one of the items discussed in paragraphs (1) through (3) of section (III)(A) above, or an affidavit or declaration under 37 CFR 1.104(d)(2) setting forth specific factual statements and explanation to support his or her position.” *Id.* § III(B). While it is beneficial for an Applicant to be able to challenge the Examiner’s position, this trajectory injects additional cost and delay to patent prosecution. If, for example, the Examiner takes official notice of the well understood nature, conventional or routine nature of a claim element in a final office action, the Applicant has two choices: file an appeal or a Request for Continued Examination. Both of these options require payment of additional fees, and both inject additional delay in the prosecution timeline. Even if the office action is non-final, requiring an applicant to challenge the official notice still injects delay in patent prosecution, which negatively impacts otherwise applicable Patent Term Adjustment. *See* MPEP § 2730(b)(1)(B)(i) (not including “any time consumed by continued examination of the application requested by the applicant” in the delay “due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application”) (quoting 35 U.S.C § 154).

Dell believes that the option for an Examiner to take official notice of the well-understood, routine or conventional nature of a claim element should either be omitted or clarified. At a minimum, the Office should make clear whether there is a streamlined and cost-effective means of challenging the Examiner’s position. Additionally, it would be beneficial if there were disincentives for Examiners to routinely rely upon official notice as a means of rejecting claims under Section 101, lest the exception swallow the rule.

**B. Case Law Citations Have Historically Been an Ineffective Means of Evaluating Patentability Under Section 101**

The Berkheimer Patentability Guidelines allow Examiners to perform the so-called Step 2B analysis for patent ineligibility for a pending claim element or combination of elements by providing a “citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).” *See* Memorandum to Patent Examining Corp., “Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.)” § III(A)(2) (“Berkheimer Memo”). Based on past experience, Dell is concerned that this evidentiary option will allow inconsistent, cursory, and unpredictable patent examination to continue in the future.

The problems with Examiners citing prior case law are many. When Examiners simply cite a prior case and merely support it with a statement that “the pending claim elements are like those in *Content Extraction*,” without any substantive analysis as to *why* the claims are alike, Applicants are left guessing at how to overcome the rejection. These types of rejections stand in stark contrast to rejections under Sections 112, 102, and 103, which are typically spelled out in detail within Office Actions. In our experience, Section 101 rejections relying on prior patent cases finding unpatentability have been cited by Examiners without any analysis as to why the claim elements in the cited cases teach the same elements as those pending in Dell’s patent applications. To illustrate, we provide a few examples from the many Section 101 rejections we have received.

In the following example, the Examiner refers to a single case, without providing a page citation or any analysis as to the applicability of that case to the pending claim in order to formulate a Section 101 rejection. As can be seen, this type of a rejection does not provide the

patent applicant with a clear sense of the Examiner's reason. Yet, a conclusory rejection like this would satisfy the citation to case law portion of the evidentiary requirements established under the Berkheimer Patentability Guidelines.

Pending Claim	Examiner's Rejection
<p>A computer-implemented method for encryption with viewer identity- and content address-based identity protection, the method comprising:</p> <p>receiving a data stream transmitted from a source device intended for a destination device by an intercepting device other than the source device and collocated with the source device in a network at a location in a data path between the source device and the destination device before the data stream leaves the network;</p> <p>performing a contextual analysis of content of privacy-related portions of the data stream, by the intercepting device, wherein the data stream includes a destination address portion, a source address portion, and the content of privacy-related portions, further wherein the content of privacy-related portions includes metadata, wherein the intercepting device receives data streams from a plurality of devices, wherein the source device comprises the plurality of devices;</p> <p>encrypting the content of the privacy-related portions of the data stream according to the contextual analysis includes encrypting some but not all of the metadata according to the contextual analysis; and</p> <p>forwarding the encrypted portion of the data stream, together with a non-encrypted portion of the data stream, out of the network toward the destination device.</p>	<p>"The claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Claims 1-20 is/are directed to the abstract idea of reviewing and manipulating/combining data <i>See Digitech</i>. The claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because [t]he claims use are capable of being performed by a generic computer, and do not present significantly more than the judicial exception." Office Action, April 6, 2018, App. No. 13/247,623.</p>

The following example is a typical rejection where the Examiner generally states claim limitations in a very abstract manner, likens those generalized claims to cases where claims were found patent ineligible, and concludes our claims are like those in the previous cases. In this type of rejection, Examiners ignore the Federal Circuit’s caution to avoid “describing the claims at such a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule.” *Enfish LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016).

Pending Claim	Examiner’s Rejection
<p>A system for IO leveling comprising:  a storage device with an IO queue; wherein the IO queue is enabled to store a pending IO received from a device; and  computer-executable logic operating in memory, wherein the computer executable program logic is configured for execution of:  receiving an IO from the device;  determining if there is a delay for processing IO because of pending IO in the IO queue;  based on a positive determination there is a delay for processing IO;  determining a priority for the IO; and  based on the priority of IO determining whether to process the IO.</p>	<p>“The reason(s) that the limitation(s) are considered an abstract idea is (are): The processing unit performs a generic function and does not amount to significantly more. The step of receiving, and determining is a mental process that is similar to the concepts that courts have previously found abstract. Specifically these steps amount to ‘Collecting information, analyzing it, and displaying certain results of the collection and analysis (<i>Electric Power Group</i>)’ and ‘Data recognition and storage (Content Extraction).” June 28, 2017 Office Action at 4, Patent App. No. 14/501,808.</p>

In this exemplary Office Action, the Examiner admits to analyzing Dell’s pending claims “at a high level of generality.”

Pending Claim	Examiner’s Rejection
<p>A method for collecting data in an Internet of Things including a data center, at least one sensor and a communication network,</p>	<p>“The courts have held that collecting data (i.e. the receiving step) at a high level of generality amounts to mere data gathering,</p>

<p>including one or more nodes, wherein the communication network connects the data center and the at least one sensor, the method comprising:</p> <p>receiving status data at a first node of the one or more nodes from the at least one sensor node through the communication network;</p> <p>wherein the communication network processes at least a portion of the status data at designated nodes of the one or more nodes of the communication network, wherein a function of the designated nodes is adjusted to support processing the at least a portion of the status data at the designated nodes instead of at the data center to reduce processing at the data center, wherein the one or more nodes comprise the designated nodes;</p> <p>extracting content data, using a first node of the one or more nodes, from the status data received from the at least one sensor node;</p> <p>aggregating the content data; and</p> <p>transmitting the aggregated content data, via the communication network, to the data center.</p>	<p>which is a form of insignificant extra-resolution activity. Similarly, recognizing data (i.e. the processing, extracting and aggregating steps) at a high level of generality represents well- understood, routine, and conventional activities in the field of information retrieval which do not improve existing technological processes.” Feb. 12, 2018 Office Action at 4, Patent App. No. 14/173,105</p> <p>In applying step (2), the examiner has determined the additional elements in claims (i.e. the transmitting step) represents well-understood, routine and conventional activities in the field of information retrieval and therefore do not amount to significantly more. ... That is to say, they merely describe the functions of the abstract idea itself. Generic computers performing generic computer functions without an inventive step do not amount to significantly more than the abstract idea itself. Furthermore, the type of data being manipulated does not impose meaningful limitations to render the ideas less abstract. Therefore, the claims are not patent eligible.” <i>Id.</i></p>
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These examples are but a few of the many Section 101 rejections we routinely receive. We believe that the current wording of the Berkheimer Patentability Guidelines do not provide sufficient guidance as to what it means to provide a “citation to one or more court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).” *See* Berkheimer Memo § (III)(A)(2). Without more substantive guidance, it is likely that patent examination under Section 101 will not significantly change. Both Examiners and Applicants are without sufficient guidance on how to address section 101 issues, even under the proposed guidelines.

For example, the Berkheimer Patentability Guidelines do not articulate how similar the pending claim element should be to the claim element found ineligible in a prior court decision. Is one word enough, as was the case in some of the examples cited above? Is it enough to merely list a case, as in the first example above? Must the claim element found ineligible in a prior case have all of the limiting aspects of the pending claim? Most of the elements? Some of the elements? Do the patents in the cited cases have to be from similar art units? Must the Examiner “carefully analyze additional elements in a claim with respect to all relevant Step 2B considerations,” as required by MPEP §2016.05(d)(II)? These and many other questions regarding using prior case law as an evidentiary basis for finding patent ineligibility under Section 101 remain unanswered by the Berkheimer Patentability Guidelines.

### **III. CONCLUSION**

For the foregoing reasons, Dell respectfully asks the Office to provide further clarity regarding the evidentiary analysis Examiners should undertake when comparing pending claims to those that have been found patent ineligible in prior cases. Likewise, Dell requests that the Office removes the opportunity for Examiners to take official notice of the well-understood, routine, conventional nature of the additional element(s). Dell makes these requests because it believes they will streamline patent prosecution, reduce costs, and provide a measure of predictability to an area of patent law that has become chaotic.

Finally, and most importantly, Dell looks forward to continuing a dialogue with the Office regarding ways in which patent prosecution under Section 101 can become even more fair, accurate, and efficacious for all participants.

Sincerely,

A handwritten signature in black ink that reads "Krish Gupta". The signature is written in a cursive style with a large initial 'K'.

Krish Gupta  
SVP, Litigation & Intellectual Property

Dated: August 20, 2018