

From: Sergey Vernyuk [e-mail address redacted]
Sent: Friday, January 23, 2015 1:38 PM
To: 2014_interim_guidance
Subject: Comments on the 2014 Interim Guidance on Patent Subject Matter Eligibility

Dear Sir or Madam,

Thank you for publishing the 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 FR 74618. I write to offer the following comments regarding the published Guidance. I am a registered patent attorney (Reg. 71,283) with Emerson, Thomson & Bennett, LLC; however the comments offered represent my personal views.

In *Alice Corp. v. CLS Bank Int'l*, the Supreme Court set forth a two-part test for analyzing subject matter eligibility under 35 U.S.C. 101. First, determine whether the claims at issue are directed to a patent-ineligible exception. If so, then determine whether the claims include an inventive concept. The Guidance does an admirable job discussing the second part of the test (inventive concept). However, I suggest that more guidance be provided on the first part of the test.

Per the *Alice* test, if a claim is not directed or drawn to an exception, then the claim is patent-eligible, ending the inquiry on eligibility. I'm sure that many patent drafters and inventors would prefer to draft claims that end the inquiry with part one. Because the *Alice* test is a two-part test, it should be possible to stop the test at part one (i.e., if the claims are not directed to an exception). I suggest that the USPTO provide more guidance on what claims are *not* directed to an exception (i.e., what claims stop at part one of the test), specifically the abstract idea exception.

Analysis of part one of the *Alice* test with regard to abstract ideas requires answering two preliminary questions.

1. What is an "abstract idea"?
2. How is a claim "directed to" an abstract idea (or any other exception)?

Alice did not elaborate on question 1. Indeed, *Alice* stated that "we need not labor to delimit the precise contours of the 'abstract ideas' category in this case." The Court simply concluded that the claims in *Alice* are similar to the claims in *Bilski* and thus are directed to an abstract idea, without explaining exactly why the claims are abstract or what test to use to determine whether any other claim is abstract. The Court cast aside a suggested test that an abstract idea is "a preexisting, fundamental truth." The Court indicated that the *Bilski* claims were directed to "a fundamental economic practice long prevalent in our system of commerce," suggesting that perhaps whether or not something is a fundamental practice may determine whether it is abstract. But whether or not something has been long used by our society shouldn't determine whether that thing is abstract or not. For example, pens have been long prevalent in our society, but surely a pen is not an abstract idea.

The Court pointed out that an idea of itself is not patentable. But every claim involves an idea. Indeed, every claim element reflects an idea. The Court acknowledged as much when it said that at some level, all inventions embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas. The Court further said that an invention is not rendered

ineligible for patent simply because it involves an abstract concept. But without knowing where to draw the line on whether a claim element is "abstract," how can a claim draftsman, the USPTO, or a court determine whether the claim is drawn to the "abstract idea" if it can't define what an "abstract idea" is or what makes an idea "abstract"? *See Accenture Global Servs. v. Guidewire Software*, 728 F.3d 1336 (Fed. Cir. 2013) (Rader, C.J., dissenting) (no one understands what makes an idea 'abstract').

Alice also did not elaborate on question 2. *Alice* merely stated that part one of the test asks whether a claim is "directed" or "drawn" to an exception. *Alice* did not give examples of claims that are not directed to an exception or explain why its claims were directed to an exception. More guidance is needed in this area.

The current Guidance contains only a brief section on whether a claim is directed to an exception (question 2). *See* 79 FR 74622. Per the Guidance, a claim is directed to an exception if an exception is "set forth," "described," or "recited" in the claim. Footnote 2 explains that a claim is not directed to an exception if the claim merely "involves" an exception (rather than recites or describes an exception). More guidance is needed to explain a claim "involving" an exception but not "setting forth" or "reciting" the exception, especially when the exception is an abstract idea. Footnote 2 states that "process claims that merely use a nature-based product are not necessarily subject to an analysis for markedly different characteristics." But if a claim recites the nature-based product as one of its elements, does it not by definition set forth a product of nature and is thus directed to an exception? Footnote 9 of the Guidance states that an "invention is not rendered ineligible for patent simply because it involves an abstract concept. Applications of such concepts 'to a new and useful end,' remain eligible for patent protection." However, it is not clear whether such inventions are patentable because they pass part one of the test (i.e., are *not* directed to an exception) or because they pass part two of the test (i.e., involve an inventive concept). Per Footnote 2, mere involvement (but not recital) of an exception results in a negative answer to part one of the test; however, Footnote 9 seems to indicate that such an invention is patentable because of the inventive concept (part two of the test) rather than part one of the test.

The Guidance indicates that the claims of *Diehr* and of *Flook* were directed to abstract ideas because a formula was recited in the claims. But there are no good cases giving examples of claims that were not directed to exceptions (i.e., part one of the *Alice* test was negative) and explaining why that is so. If every claim embodies or uses an abstract idea, then it is hard to see how part one of the *Alice* test can ever be answered in the negative.

In summary, I believe that part one of the *Alice* test needs more guidance. Part one of the test seems difficult conceptually, and unfortunately, the Court did not provide adequate guidance. Perhaps the USPTO can provide some guidance while we wait for the courts to address these difficulties.

Sincerely,

Sergey Vernyuk

Emerson Thomson Bennett, LLC

telephone: 330-434-9999

email: sv@etblaw.com