



To: Commissioner of the United States Patent and Trademark Office  
From: Ericsson  
Date: March 16, 2015  
Re: Comments regarding the 2014 Interim Guidance on Patent Subject Matter Eligibility

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Ericsson submits these comments in response to the *Interim Guidance on Patent Subject Matter Eligibility* published in Volume 79, No 241 of the Federal Register (the *Guidelines*).

The question of what is patentable subject matter is one that may be easy to answer in theory but which can pose significant hurdles in practice. As detailed in the *Guidelines*, this question is answered through a two-step process that begins with deciding whether or not a claim is directed to a law of nature, a natural phenomenon, or an abstract idea (for simplicity, these shall be collectively referred to as a “Judicial Exception”). Having answered the first question in the affirmative, the next question is whether the claim’s recited elements amount to significantly more than the Judicial Exception. Either question can, in practice, be difficult to answer with reasonable minds arriving at different, reasonable, conclusions. For this reason, Ericsson certainly appreciates the aid the *Guidelines* should provide to both the Applicant and the Examiner.

## **IS IT A JUDICIAL EXCEPTION**

While the old adage “I know it when I see it” may work in certain scenarios, it is not the approach taken by the U.S.P.T.O. in granting or rejecting patent applications. Accordingly, with respect to the first test, Ericsson would like to see the *Guidelines* set forth procedures that form a framework around which Applicants and Examiners can discuss the claim elements, rather than having an argument of opinion. To that end, the procedure for taking official notice, as set forth in § 2144.03 of the M.P.E.P., is a good parallel that aligns well with the way the courts have addressed the issue. For example, in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l* the Supreme Court cites to multiple financial articles showing the use of third party clearinghouses to support the conclusion that the claims in *Alice* were directed to the abstract idea of intermediated settlement. See page 9 of the slip opinion for *Alice*.

Should an Examiner identify a claim directed to a Judicial Exception, the Examiner must state that “Judicial Exception Official Notice” is taken with respect to the claim and then clearly identify the basis on which the Judicial Exception Official Notice is taken. The Applicant should be presented with the explicit basis on which the Examiner regards the claim as subject to official notice so as to adequately traverse the rejection in the next reply after the Office Action in which the Judicial Exception Official Notice is taken. The identified Judicial Exception must be capable of instant and unquestionable demonstration as being the identified Judicial Exception.

If the Applicant challenges the assertion as being not properly officially noticed or not properly based upon a recognized Judicial Exception, the Examiner must support the finding with

adequate evidence. To adequately traverse such a finding, the Applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the claim is not considered to be directed to a Judicial Exception or why the Judicial Exception Official Notice was not properly taken.

If the Applicant adequately traverses the Examiner's assertion of Judicial Exception Official Notice, the Examiner must either provide documentary evidence in the next Office Action or defer providing such evidence as outlined below, if the rejection is to be maintained. The Examiner must point to some concrete evidence in the record in support of the finding that the claim is in fact directed to a Judicial Exception. This explicit evidence should bring about a resolution of the issue quicker than if the Applicant has to go through multiple Office Action/Response cycles trying to understand the "what," the "how," or the "why" of the Judicial Exception on which the Examiner is basing the 35 U.S.C. §101 rejection.

Providing support for a Judicial Exception Official Notice may be easy where the evidence for such demonstration is within the application itself. For example, in the third example in *Examples: Abstract Ideas* (available at [http://www.uspto.gov/patents/law/exam/abstract\\_idea\\_examples.pdf](http://www.uspto.gov/patents/law/exam/abstract_idea_examples.pdf)) the background section of the specification identified the claimed blue noise mask as an iterative mathematical operation; and in the fourth example in *Examples: Abstract Ideas* the claims themselves recited creating a mathematical model. In other cases it may be a bit more difficult. For example in examples five through eight in *Examples: Abstract Ideas* an analogy was drawn to things that were found to be abstract in prior court decisions. While this is helpful in a first Office Action as part of the Examiner's Judicial Exception Official Notice, if the Applicant adequately traverses the Examiner's official notice Ericsson would like to see the Examiner provide more than just analogies to prior case law. For example, with respect to examples five through eight in *Examples: Abstract Ideas* Ericsson would like to see the following types of additional information:

- for the fifth example, a citation to a data processing book discussing the abstract idea of combining two data sources into a single data source;
- for the sixth example, a citation to a Bingo rule book, or some other source explaining how the game is played;
- for the seventh example, a citation to a finance book explaining how a third-party guaranty works; and
- for the eighth example, a citation to a marketing book explaining ways to get people to view advertisements (or a citation to any time-share pitch given since the creation of time-shares).

In appreciation of the work load and time constraints Examiners are faced with, Ericsson would propose that if the Applicant provides adequate traversal of the Examiner's Judicial Exception Official Notice, the Examiner would have the option to defer providing the required support until such time as the Applicant has overcome all rejections based on prior art. The first Office Action issued in which the Examiner provides support for the Judicial Exception Official Notice, and which does not contain any prior art based rejections, must be made non-final. This would free the Examiners from having to find sources to support their Judicial Exception Official Notice when such sources may not be needed (e.g., the Applicant amends the claims to overcome a prior-art reference which in turn provides a significant limitation that would remove the §101 rejection), while still providing an opportunity for the record to reflect the Applicant's challenge to the Judicial Exception Official Notice.

If the Applicant does not traverse the Examiner's assertion of Judicial Exception Official Notice or if the Applicant's traversal is not adequate, the Examiner should clearly indicate in the next Office Action that the Judicial Exception is taken to be an admitted Judicial Exception because the Applicant either failed to traverse the Examiner's assertion or the traverse was inadequate. If the traverse was inadequate, the Examiner should include an explanation as to why it was inadequate.

If the Examiner adds a reference in the next Office Action after the Applicant's traversal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office Action may be made final. If no amendments are made to the claims, the Examiner must not rely on any other teachings in the reference if the rejection is made final.

## **IS IT MORE THAN THE JUDICIAL EXCEPTION**

With respect to the second test, Ericsson submits that the same procedure used for addressing the first test as to whether or not the claim is directed to a Judicial Exception, would be suitable in the second test where the Examiner asserts that the claim elements do not amount to significantly more than the identified Judicial Exception. However, while Ericsson would certainly prefer to have a detailed explanation as to why each element of a claim found to be directed to a Judicial Exception does not recite significant limitations, Ericsson recognizes the practical difficulties such a requirement would impose on the Examiner. What Ericsson would propose is that if in response to an Office Action, the Applicant explicitly identifies elements that are believed to provide significant limitations, and explains what those limitations are, the Examiner must then provide a detailed explanation as to why the identified elements do not impose significant limitations if the rejection is to be maintained.

In addition to the procedure detailed above, when an Examiner is determining whether or not a claim recites more than a Judicial Exception, in particular when the Examiner is considering an argument that the claim elements could be performed by a human, Ericsson would submit that the Examiner should consider the practicality in addition to the possibility of a human performing the steps. For example, there are things that are just not possible for a human to accomplish. One such example can be found in the fourth example in *Examples: Abstract Ideas*. The method claim recites "calculating pseudo-ranges, at a mobile device comprising a GPS receiver, a microprocessor, a display, and a wireless communication transceiver, by averaging PN codes received by the GPS receiver from a plurality of GPS satellites." Even if it were assumed that a human could be the mobile device, a human does not comprise a GPS receiver and it would not only be impractical, but impossible, for a human to receive information from a GPS satellite. Should it be determined, however, that it is possible for a human to perform the steps, the next question should be is it actually practical to do so. Section 101 requires that a patentable invention be useful, which implies that it be practical. Ericsson would submit that many useful inventions comprise functions that could be performed by a human but it is only through the computer implementation of such inventions that they become practical. For example, in the third example in *Examples: Abstract Ideas*, it is possible for a human to generate a blue noise mask for all the pixels of an image and then to compare, on a pixel-by-pixel basis, the pixel values of an image to the corresponding value in the blue noise mask. However, due to the large number of pixels contained in an image, the length of time it would take for a human to conduct such calculations would render the exercise impractical, and therefore not useful. It is only through a computer implementation of the invention that it become useful. In contrast to the two examples above, the fifth example in *Examples: Abstract Ideas* provides a scenario in

which the recited elements are both possible and practical for a human to perform. In the fifth example, it would be possible for a human, given adequate time, to generate the two data sets and then combine them into a device profile. While a computer would be able to perform such operations quicker than a human, the extra time a human would need to perform the calculations would render the claim impractical. That is, unlike in the third example in *Examples: Abstract Ideas* in which the human would have to perform the calculations for every pixel of every single image, in the fifth example in *Examples: Abstract Ideas*, the human would only need to perform the calculation once for a particular pair of input and output devices. For example, once the device profile is calculated for a camera/printer pair, the same device profile would be used for each image taken with the camera that the user prints from the printer.

## **CONCLUSION**

The *Guidelines*, as they currently stand, and any future guidance provided by the U.S.P.T.O., will certainly help both Applicants and Examiners ensure that the patents issued by the U.S.P.T.O. are directed to patent eligible subject matter. Ericsson appreciates the opportunity to provide these comments to the U.S.P.T.O. and hopes that they are of value to the U.S.P.T.O.