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Comments on the guideline:

A. Wholly and limited application:

From MPEP 2106:

(The commentor has added emphasis by italics in several places)

"While abstract ideas, physical phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, physical phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of **35 U.S.C. 101**, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, physical phenomenon, or law of nature, and not for the abstract idea, physical phenomenon, or law of nature itself. *Diehr,* 450 U.S. at 188, 209 USPQ at 7.

In addition to the terms laws of nature, physical phenomena, and abstract ideas, judicially recognized exceptions have been described using various other terms, including natural phenomena, scientific principles, systems that depend on human intelligence alone, disembodied concepts, mental processes and disembodied mathematical algorithms and formulas, for example. The exceptions reflect the courts' view that the basic tools of scientific and technological work are not patentable.

The claimed subject matter must not be *wholly* directed to a judicially recognized exception. If it is, the claim is not eligible for patent protection and should be rejected under **35 U.S.C. 101**. *However, a claim that is limited to a particular practical application of a judicially recognized exception is eligible for patent protection*. A "practical application" relates to how a judicially recognized exception is applied in a real world product or a process, and not merely to the result achieved by the invention. *When subject matter has been reduced to a particular practical application having a real world use, the claimed practical application is evidence that the subject matter is not abstract (e.g., not purely mental) and does not encompass substantially all uses (preemption) of a law of nature or a physical phenomenon.* See, e.g., *Ultramercial v. Hulu,* 657 F.3d 1323, 1329, 100 USPQ2d 1140,1145 (Fed. Cir. 2011) (stating that the patent "does not claim a mathematical algorithm, a series of purely mental steps, or any similarly abstract concept. It claims a particular method . . . a practical application of the general concept.").

Reference to some of MPEP 2106 is made in the 12/16/14 guideline on page 7, and then the word and concept "wholly directed" and the notion of limited application of the judicial exception rendering a claim patentable under 101 are both conspicuously dropped. It is as

though the author(s) of this guideline, and indeed most of the examiners and their supervisors who have been applying it have never read the very clear definition in MPEP 2106.

At the beginning of the two-part analysis explanation Part 1 of the the Mayo test is stated as "Determine whether the claim is *directed* to a law of nature, a natural phenomenon, or an abstract idea (judicial exceptions)." What happened to "wholly directed"?
The explanation of part 1 begins: "A claim is directed to a judicial exception when a law of nature, a natural phenomenon, or an abstract idea is recited (*i.e.,* set forth or described) in the claim." Again, by dropping the requirement for "wholly directed" the guideline rakes in any and all claims that recite anywhere in the claim an abstract idea (and all claims do), greatly expanding the scope of the analysis. The guideline actually subjects claims that recite two or several judicial exceptions to the analysis, and danger of rejection, when such claims could not possibly be considered to be "wholly directed to an exception".

This omission and clear misdirection from MPEP 2106 to the present guideline needs to be seriously addressed and corrected, because the patent rights of thousands of US Citizens are being seriously abused, and the USPTO is the US Agency responsible for protecting the citizen's rights in this regard.

Further to this MPEP 2106 very clearly requires that once an examiner decides upon and states the judicial exception in the claim, that, if the claim recited a limited application of the judicial exception, that claim is patentable under 101. From the MPEP: "*However, a claim that is limited to a particular practical application of a judicially recognized exception is eligible for patent protection*."
This concept is covered quite well in the section on page 14 titled "Streamlined Eligibility Analysis". What is missing in the application by many examiners thus far in regard to this section is that it is largely being ignored. It is rather rare that any registered practitioner *ever* submits a claim that recites an abstract idea, but does *not* provide limitations to the application of the abstract idea. It is the nature of invention to find a better way to apply an abstract idea and to limit the claim to the better way.

This streamlined eligibility analysis needs to be put at the *front* of the guideline, and promoted to the examining corps as to proper application. Almost all claims that are being rejected under the Alice provisions of Section 101 as of now fall in this category, and are clearly patentable under this test.

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