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Sent: Thursday, March 12, 2015 1:09 AM
To: 2014_interim_guidance
Subject: Comments on the 2014 Interim 101 Guidance and Abstract Ideas Examples
Sensitivity: Confidential

Dear Colleagues,

I've helped with comments being submitted from various other groups, but I wanted to reiterate a few points on my own in advance of the March 16 end to the comment period:

1. Preemption is a key aspect of the concerns highlighted by the Court in both *Alice* and *Mayo*. However, I've heard from multiple examiners that preemption does not form any significant part of the training materials or guidance to the examiners. Rather than being an ancillary side effect, a preemption analysis should be paramount when reviewing claims for 101 eligibility. In particular, if the claims do not nicely and neatly match a statement in the examiner training materials or an abstract idea example provided by the Office, a preemption analysis should be used to determine whether the claims qualify as patent eligible under 35 USC 101.
2. Consistency and transparency in examination are important. It seems that different art units are approaching 101 analyses differently, even when provided with the same training materials and examples. This shouldn't be the case. Additionally, at least certain technology centers (e.g., 3600, 3700) appear to have "101 subject matter experts" who are reviewing all claims from examiners to give a thumbs up or thumbs down regarding patent eligibility. However, Applicants do not seem to be allowed to interview these "experts", and their names do not appear in the record of the particular patent application. If these people are having ultimate authority on the 101 subject matter eligibility of an Applicant's patent claims, the Applicant should be allowed to identify and request an examiner interview to include that person as well as the other named examiners listed in the office action.
3. Abstract Ideas examples – additional examples would be helpful to further guide examiners and applicants in claim drafting, amendment, and analysis. For example, two graphical user interface examples – one patent eligible and the other ineligible – would be greatly instructive to the art units dealing with such inventions. Now, many such examiners haven't been able to allow cases since last summer. In one instance, I'm dealing with an examiner who agrees our claims are allowable over the prior art but has not been able to allow a single application since June 2014 due to 101 issues. Another area in which to provide both eligible and ineligible examples for guidance would be a more pure "business method" set of claim examples. Examiners do not want to (and should not be asked to) act like judges; they want to be able to compare a set of claims to provided examples and criteria, so more examples and clearer criteria are important to make the results less subjective. Right now, judgment seems to be extremely subjective, and examiners are nervous.
4. "Methods of organizing human activity" are not necessarily ineligible subject matter. While I've seen (and heard about) examiners rely on an interpretation that methods of organizing human activity are abstract and not patent eligible subject matter, such a statement (typically without any associated detailed reasoning) is an invalid crutch and not based on the statutes or case law. Rather, while the phrase "a method of organizing human activity" was mentioned in *Bilski*, the statement was made in response to a statement in one of the briefs and not to define a test or category of ineligible subject matter. In fact, many methods of organizing human activity are and should be patent eligible, as many systems and tools can be patent eligible, inventive, and

help to organize some human activity. Further, I've seen this phrase used extensively and very broadly to lump extremely detailed and system-driven claims into "methods of organizing human activity". Such over-generalization should not be allowed.

5. As frequently discussed in the patent vernacular, the name of the game is the claim, and the particular language of the claims should be carefully and thoroughly reviewed, for 101, 102, 103, and 112, rather than swept aside or over-generalized into a simple category or brief phrase. While such over-generalization may make it quite easy in the short term for examiners to quickly reject and maintain a rejection of pending claims, it isn't fair, reasonable, contemplated in the statutes or case law, or productive in the long term.
6. Similarly, "directed to" does not and should not mean "includes". Just because one element or a few words in a claim may lean toward a judicial exception in subject matter eligibility does not mean that the entire claim, taken as a whole, is "directed to" an abstract idea.

I definitely appreciate the dialog with the PTO and the opportunity to give feedback, and I hope the dialog continues to improve examination practice and other guidance. A section 101 analysis should continue to remain a fairly coarse filter, with 112, 102, and 103 serving the primary role to determine patentability of claims.

Best regards,
Chris

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