From: Clark Jablon [e-mail redacted]
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Subject: Comment submission

I wish to submit the text of my presentation as a comment submission.

Presentation of Clark A. Jablon, Esq. at USPTO's public form on subject matter eligibility on the USPTO, January 21, 2015

Thank you for giving me the opportunity to speak at this forum. My clients are significant stakeholders regarding 101 eligibility which is why I am here today, although the views being expressed are solely my own. As a brief background, I was a Primary Examiner in the original Art Unit 236 that examined the very first business method patent applications so my experience with this issue extends back to 1983. As some of you old-timers may remember, Jerry Smith headed up that art unit before he became an APJ.

When I left the PTO for private practice, I took with me three principles regarding 101 eligibility that I have diligently practiced for the past 21 years. First, business method patents should have a technological nature to them to be 101 eligible. *Bilksi* confirmed my view on this issue in 2010. Second, automating known business processes with computer technology is not likely patentable under 101. *Alice* confirmed my view on this issue in 2014. The third piece of knowledge is that the invention cannot preempt an abstract idea. This has been in the case law for dozens of years and has been re-affirmed in more recent 101 cases.

Despite following these principles, since June 2014 when the USPTO's initial *Alice* Memorandum was published, I have been unable to obtain allowances on highly technological inventions that do not preempt any abstract idea and which automate novel and unobvious business methods, including inventions that have required years of man-hours to develop workable software code to implement.

There are no holdings that I am aware of in the controlling 101 case law that would preclude patenting such inventions. In fact, the USPTO's updated Interim Eligibility Guidance document now correctly reflects that fact by including new guidance that the second prong of *Mayo* can be met by "[a]dding a specific limitation other than what is well-understood, routine and conventional in the field, or adding unconventional steps that confine the claim to a particular useful application." The updated guidance document also provides for a new "Streamlined Eligibility Analysis" that instructs Examiners to skip the 101 two-part *Mayo* test if no abstract idea is being preempted. I am thus satisfied that the updated guidance document has properly codified 101 case law for software inventions, which includes computer-implemented business methods. To repeat, my reason for speaking today is that I am still unable to get 101 eligible applications allowed.

First, Examiners are informing me at interviews held just within the past few weeks that they are being trained to ignore the "Streamlined Eligibility Analysis" for software inventions and to always perform the full *Mayo* analysis under the reasoning that there is always some doubt as to

whether a judicial exception is being preempted in software cases. This is happening in applications where the prior art of record clearly shows that there are other ways to practice the asserted "abstract idea."

Second, Examiners are also informing me at the interviews that they are also being trained not to allow applications which have limitations other than what is well-understood, routine and conventional in the field, or which add[s] unconventional steps if these limitations are implemented with generic computer structure that does not improve the functioning of the computer itself. This is happening in applications that have overcome the prior art rejections, and thus are solely being rejected under 101. Going back to *Alice* and predecessor cases, there is simply no basis for asserting that novel and unobvious software-implemented inventions must improve the functioning of the computer itself to be 101 eligible.

In a nutshell, here is what I would like to convey regarding the updated guidance document:

First: The training process and the guidance document itself should be modified to make it clear that generic computer structure may be used to implement a limitation that is "other than what is well-understood, routine and conventional in the field, or add[s] unconventional steps that confine the claim to a particular useful application." This clarification does not conflict with *Alice* and will make it clear that "improvements to the functioning of the computer itself" is not an additional test to be imported into this way of meeting the "significantly more" test.

Second: The training process should not presume that there will always be doubt as to whether software inventions preempt a judicial exception, thereby requiring Examiners to always perform the two-part *Mayo* test. If the prior art of record shows that there are other ways to perform the identified judicial exception, Examiners should be instructed that the claim is 101 eligible.

Third: The word "clearly" should be deleted from the guidance document in the sentence "clearly does not seek to tie up any judicial exception such that others cannot practice it." There is no case law that I am aware of to support the "clearly" emphasis. The word "clearly" unnecessarily gives fodder to the Examiners to ignore the "Streamlined Eligibility Analysis."

Fourth: The guidance document needs to explain that an abstract idea is rarely ALL of the claim limitations. This "*Alice* Gone Wild" scenario, as described in a recent IPWatchdog.com article, contradicts the 101 case law that an abstract idea is a fundamental principle/truth, a building block of human ingenuity, or a basic tool of science and technology.

Thank you again for giving me the opportunity to speak.

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