

March 16, 2015

Dear Commissioner,

I am writing to suggest an addition to the 2014 Interim Guidance on Patent Subject Matter Eligibility. The views expressed below are my personal opinions and not necessarily those of any current, past, or future clients or colleagues. I am not submitting these views on behalf of anyone other than myself.

THE ASSERTION OF AN ABSTRACT IDEA SHOULD BE SUPPORTED BY CONCRETE EVIDENCE

The guidance currently does not instruct the examining corps that the assertion of an abstract idea must be supported by concrete evidence. This should be corrected. The Federal Circuit has noted that patent subject matter eligibility is a question of law informed by underlying facts. Moreover, in order for the Federal Circuit to review a determination of patent ineligibility, there must be substantial evidence supporting the administrative agency's determination.

First, the Federal Circuit noted as early as 1992 that:

“Whether a claim is directed to statutory subject matter is a question of law. Although determination of this question may require findings of underlying facts specific to the particular subject matter and its mode of claiming . . .”
Arrhythmia Research Technology v. Corazonix Corp., 958 F.2d 1053 (Fed. Cir. 1992).

This standard is similar to other standards of patent examination. For example, with respect to utility under 35 U.S.C. §101, the MPEP states in section 2107:

IV. INITIAL BURDEN IS ON THE OFFICE TO ESTABLISH A PRIMA FACIE CASE AND PROVIDE EVIDENTIARY SUPPORT THEREOF

To properly reject a claimed invention under 35 U.S.C. 101, the Office must (A) make a prima facie showing that the claimed invention lacks utility, and (B) provide a sufficient evidentiary basis for factual assumptions relied upon in establishing the prima facie showing. *In re Gaubert*, 524 F.2d 1222, 1224, 187 USPQ 664, 666 (CCPA 1975) "Accordingly, the PTO must do more than merely question operability - it must set forth factual reasons which would lead one skilled in the art to question the objective truth of the statement of operability." If the Office cannot develop a proper prima facie case and provide evidentiary support for a rejection under 35 U.S.C. 101, a rejection on this ground should not be imposed. See, e.g., *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992)

Similarly, with respect to obviousness under 35 U.S.C. §103 — which is also a question of law supported by underlying questions of fact — the MPEP states:

2142 Legal Concept of Prima Facie Obviousness [R-11.2013]

The legal concept of prima facie obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See In re Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); In re Saunders, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); In re Tiffin, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), amended, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit secondary evidence to show nonobviousness.

And, with respect to ornamentality, the MPEP section 1504.01(c) (II) states:

II. ESTABLISHING A PRIMA FACIE BASIS FOR REJECTIONS UNDER 35 U.S.C. 171

To properly reject a claimed design under 35 U.S.C. 171 on the basis of a lack of ornamentality, an examiner must make a prima facie showing that the claimed design lacks ornamentality and provide a sufficient evidentiary basis for factual assumptions relied upon in such showing. The court in In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), stated that “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability.”

These portions of the MPEP emphasize that factual issues should be supported by evidence. Thus, the assertion that a claim includes an abstract idea should similarly be supported by supplying evidence of the abstract idea.

Second, for a USPTO decision to withstand appellate review, there must be substantial evidence in the record. The Federal Circuit observed this with respect to reviewing an obviousness determination in In re Zurko, 258 F.3d 1379, 1385 (Fed. Cir. 2001):

We cannot accept these findings by the Board. This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience — or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.[2] To hold otherwise would render the process of appellate review for substantial evidence on the record a

meaningless exercise. Baltimore & Ohio R.R. Co. v. Aderdeen & Rockfish R.R. Co., 393 U.S. 87, 91-92, 89 S.Ct. 280, 21 L.Ed.2d 219 (1968) (rejecting a determination of the Interstate Commerce Commission with no support in the record, noting that if the Court were to conclude otherwise "[t]he requirement for administrative decisions based on substantial evidence and reasoned findings — which alone make effective judicial review possible — would become lost in the haze of so-called expertise"). Accordingly, we cannot accept the Board's unsupported assessment of the prior art.

This holding was repeated by the Federal Circuit less than a year ago in K/S HIMPP v. Hear-Wear Technologies, LLC, 751 F.3d 1362 (Fed. Cir. 2014):

We agree with Hear-Wear that the Board was correct to require record evidence to support an assertion that the structural features of claims 3 and 9 of the '512 patent were known prior art elements. The patentability of claims 3 and 9 with the limitation "a plurality of prongs that provide a detachable mechanical and electrical connection" presents more than a peripheral issue. See In re Zurko, 258 F.3d 1379, 1386 (Fed.Cir.2001) ("[Board] expertise may provide sufficient support for conclusions as to peripheral issues."). The determination of patentability of claims with this limitation therefore requires a core factual finding, and as such, requires more than a conclusory statement from either HIMPP or the Board. See id. ("With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience...."). HIMPP must instead "point to some concrete evidence in the record in support of these findings." Id.

Clearly, for a factual determination by the Office to withstand appellate review, the Office must establish concrete evidence in the record. Therefore, the assertion by the Office that a claim recites an abstract idea — which is clearly a core factual finding — must be supported by concrete evidence in the record.

I hope you will tailor the interim guidance to reflect that an Examiner must support any assertion of an abstract idea by supplying factual evidence, just as you have previously required the examining corps to do in MPEP sections 2107, 2142, and 1504.01(c) (II).

Finally, I think it is wise to take to heart the remarks of Judge Lourie from the oral argument of K/S HIMPP v. Hear-Wear Technologies, LLC:

"We have an examination system based on citation of references. I may have used the word 'slippery slope' already. But, I worry about that — where an examiner who is of some skill and training in a particular art could simply say 'Aha, I think, I think, and it is my common knowledge' And, they start rejecting claims based on what they 'think.' Isn't that a serious departure from our system of citation of references to reject claims?"

Sincerely,

William F. Vobach