



October 28, 2015

Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Raul Tamayo
Michael Cygan
Office of Patent Legal Administration

Via email: 2014_interim_guidance@uspto.gov

Re: Request for Comments on the 2015 Update on Subject Matter Eligibility

Microsoft is pleased to submit this response to the July 30, 2015, Federal Register notice requesting public comments on the *July 2015 Update on Subject Matter Eligibility* (hereinafter “2015 Update”).¹ We appreciate the diligent efforts of the U.S. Patent and Trademark Office (“USPTO” or “Office”) to update the eligibility guidance to reflect case law developments and to continually improve the accuracy and clarity of the information and materials provided to examiners. We also commend the office for its commitment to soliciting and considering feedback from the public and appreciate the opportunity to provide our views and to participate in to the ongoing dialogue between stakeholders and the Office on this important topic.

As with the previous revisions, the *2015 Update* incorporates a number of improvements to the previous *Interim Guidance*. For example, Microsoft welcomes the inclusion of additional examples illustrating the application of the Office’s *Interim Guidance* to assess the eligibility of a variety of claims in different fields of technology. We are particularly pleased with the inclusion of more positive examples that emphasize the types of considerations and factor that establish, rather than defeat, eligibility. These additional examples significantly improve the comprehensiveness and balance of the *Interim Guidance* and of the materials used in training examiners. We also appreciate the increased focus on the necessity of considering both the individual claim elements and the claims as a whole and the Office’s use of the examples to illustrate how individual claim elements, considered separately, are insufficient to satisfy the inventive concept requirement may nevertheless be eligible when considered in combination. While Microsoft continues to question the wisdom of adopting undefined terms from the case law as descriptors and believes clearer

¹ *July 2015 Update on Subject Matter Eligibility*, 80 Fed. Reg. 45429 (July 30, 2015).

guidance regarding the scope of the judicial exclusion is needed, the Office’s identification of “common characteristics” is a step in the right direction and is likely to encourage increased consistency in the interpretation and application of the judicial exclusions by examiners.

Although we appreciate these improvements and recognize that the Office has made significant progress toward addressing a number of concerns expressed by stakeholders, Microsoft continues to believe that both the *Guidance* and the manner in which it is applied by examiners could be improved. Specifically, we would respectfully urge the Office to:

- Provide additional clarification regarding the meaning of “certain methods of organizing human activity” and its relationship to the excluded subject matter described by the term “fundamental economic practices.”
- Incorporate additional examples illustrating inventions that implicate “certain methods of organizing human activities,” but are nevertheless eligible because they are directed to improvements to the functionality of computers or other technology.
- Adopt a more detailed and rigorous description of what is required for an examiner to satisfy the burden of establishing a *prima facie* case of ineligibility.

Inasmuch as concerns regarding use of the descriptor “certain methods of organizing human activity” and the need for eligibility rejections to include a more rigorous analysis and clear explanation of the examiner’s reasoning have been discussed at length by Microsoft and others in previous comments, it would provide little benefit to the Office for us to repeat these arguments here. Accordingly, we provide only a brief discussion of our views on these topics below and would respectfully direct the Office to the prior comments to the extent additional information or argumentation is desired.

1. USPTO should remove or clarify “certain methods of organizing human activity”

Although Microsoft sincerely appreciate the efforts reflected in the *2015 Update* to clarify the term “certain methods of organizing human activity,” we continue to believe that this descriptor has a questionable basis in the case law, is likely to cause more confusion than clarity, and should be removed from the guidance. If the term is not removed, we respectfully suggest that it requires further clarification and definition to avoid confusion over its intended scope and meaning. At a minimum, it would be helpful to more clearly explain the “certain” qualifier by illustrating more clearly what is **not** covered by the term. In particular, we believe the Office should explain in more detail that this term does not include the “human operations of machines” or machines and other tools designed used to assist human with organization (*e.g.*, Rolodex, closet organizers, electronic pocket calendars). As suggested in our previous comments (and as helpfully reflected in the *2015 Update*), the case law suggests that this phrase was intended to refer exclusively to abstract systems of structuring interaction among two or more people (*e.g.*, social, financial, and legal structures and relationships). Based on our experience, we believe that this point should be emphasized with examiners, many of whom appear to interpret the term according to its literal meaning as covering methods and machines that involve, aid, or enable the organization of any type of activity engaged in by a person.

Finally, it is unclear what distinguishes “fundamental economic activities” from “certain methods of organizing human activity,” which may lead to further confusion. If “methods of organizing human activity” is retained, we believe it would helpful either to provide additional clarity to examiners regarding the difference between the two or to merge both descriptors into a single category.

2. Need for additional examples relating to “methods of organizing human activity”

While Microsoft appreciates the Office’s clarification that term “certain methods of organizing human activity” is not meant to cover “human operation of machines,” we continue to encounter objections from

examiners that appear to be incorrectly premised on the belief that this term covers both the human operation of machines and autonomous machine operations that do not involve a human operator. We also continue to encounter objections to claims directed to technological inventions that appear to be based on the fact that the use of the invention is intended to enable or improve the organization of “human activity.” Based on our experiences with office actions citing this descriptor as the basis for a rejection, and the resulting interaction we have had as we seek to understand their underlying concerns, we continue believe there is a need for continued emphasis and training on the appropriate analysis for determining whether claims are directed to “certain methods of organizing human activity.”

To illustrate our concern, our experience suggests that there would be a significant risk that the following claim (which is based on the claim in USPTO’s Example #23) would be rejected as being directed to certain methods of organizing human activity:

A computer-implemented method for displaying a calendar in a graphical user interface, the method comprising:

displaying a first window showing a calendar in a two-month format within a graphical user interface on a computer screen;

displaying a second window showing a to-do list within the graphical user interface;

constantly monitoring the boundaries of the first window and the second window to detect an overlap condition where the second window overlaps the first window such that the calendar in the first window is obscured from a user’s view;

automatically relocating the calendar, by a processor, to an unobscured portion of the first window in a single-month format during an overlap condition so that the calendar is viewable on the computer screen by the user; and

automatically returning the relocated calendar, by the processor, to the two-month format within the first window when the overlap condition no longer exists.

The only differences between this claim and the claim in Example #23 involve replacing references to textual information with references to calendar information, which should have no impact on the claim’s eligibility based on the same analysis contained in the USPTO’s example. This claim describes the same functionality (*i.e.*, automatically relocating information based on window overlapping) and benefit (*i.e.*, improving the function of the computer to display information and interact with the user).

Despite being substantially identical for purposes of the eligibility analysis, our experience suggests the claim above would be much more likely to receive a rejection as being directed to “certain methods of organizing human activity” based on a misperception that the reference to calendar information automatically results in the claim being “directed to” a method or organizing human activity.

To address this, we believe that it would be helpful for the Office to clarify for examiners that the fact that a claim may ultimately relate to, enable, or have an effect on the organization of human activity does not automatically render the claim ineligible. To that end, Microsoft would respectfully urge the Office to provide one or more examples illustrating the distinction between claims that merely “involve” and claims that are “directed to” certain methods of organizing human activity and making clear that – as with the other judicial exceptions – examiners cannot presume that a claim is ineligible based on mere references to an exclusion or based on the invention’s intended use, but must carefully assess whether the claim is actually “directed to” an exception in each case.

3. USPTO should provide more detailed and rigorous guidance on sufficiency of a *prima facie* case

In the *2015 Update*, the Office states that the “initial burden is on the examiner to explain why a claim or claims are unpatentable clearly and specifically, so that applicant has sufficient notice and is able to effectively respond” and that this “burden is met by clearly articulating the reason(s) why the claimed invention is not eligible, for example by providing a reasoned rationale that identifies the judicial exception recited in the claim and why it is considered an exception, and that identifies the additional elements in the claim (if any) and explains why they do not amount to significantly more than the exception.” While Microsoft agrees with these statements, it is not clear to us that they will be effective in guiding or altering examiner behavior unless coupled with more specific, practical guidance from the Office.

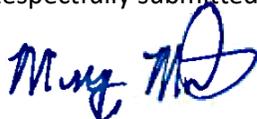
Currently, the eligibility rejections we receive generally communicate nothing more than the examiner’s conclusion that the claim is directed to a judicial exception and does not contain additional elements that would amount to significantly more than the judicial exception. Typically, the rejection does not provide any additional indication of the examiner’s reasons for these conclusions, making it difficult – often impossible – to respond effectively to the rejection. As Microsoft and others have noted in previously, these types of boilerplate or fill-in-the-box rejections, which contain no reasoning or reference to supporting evidence, present significant challenges for applicants.

In order to ensure that applicants have sufficient information to provide an effective response to rejections, Microsoft believes the USPTO should provide additional detail and training to examiners regarding what constitutes a “reasoned rationale.” At a minimum, the Office should make clear that the reasoned rationale must effectively communicate not just the examiner’s conclusion, but the reasoning and evidence that led to that conclusion. We would also encourage the Office to provide additional guidance to examiners regarding the limitations on taking official notice of facts and requiring inclusion of specific evidence.

Conclusion

In conclusion, Microsoft would again like to commend the Office its efforts to provide clear and timely guidance to examiners regarding the law and appropriate analysis for determining patent eligibility, and for its commitment to enhancing both the quality and the efficiency of examination. We appreciate the Office’s openness to receiving feedback from stakeholders and appreciate the opportunity to provide these comments.

Respectfully submitted,

A handwritten signature in blue ink, appearing to read "Micky Minhas".

Micky Minhas
Chief Patent Counsel
Microsoft Corp.