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Sent: Tuesday, February 23, 2016 7:14 PM
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Subject: A Suggested Improvement to the Interim Guidance on Patentable Subject Matter

Pomcor thanks the USPTO for the opportunity to comment on the Interim Guidance on Subject Matter Eligibility. We would like suggest an improvement to the guidance, based in part on observations of how the guidance has been applied to the examination of patent applications submitted by Pomcor.

The guidance states that "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". However, "is directed to" is not synonymous with "recites".

That a claim recites a judicial exception means only that a law of nature, a natural phenomenon, or an abstract idea is mentioned in the claim. That a claim is directed to a judicial exception means much more than that. Literally, "a claim is directed to a judicial exception" means that the claim seeks to tie up, i.e. to preempt others from using, a law of nature, a natural phenomenon or an abstract idea. However this literal interpretation cannot be what the Supreme Court had in mind in Part 1 of the Mayo test, because if the claim does seek to tie up a judicial exception, then the subject matter of the claim is not eligible, and there is no point in proceeding to Part 2 of the Test. Perhaps the court intended "a claim is directed to a judicial exception" to mean "the claim appears to tie up the judicial exception", or "the claim may tie up the judicial exception and further analysis is required in Part 2 of the test to determine if it does indeed tie it up".

The interim guidance implicitly relies on the latter interpretation when it supplements the flowchart provided in the guidance with the provision for a "streamlined eligibility analysis": "...a streamlined eligibility analysis can be used for a claim that...clearly does not seek to tie up any judicial exception... Such claims do not need to proceed through the full analysis herein...". This interprets "is directed to" as "requires the full analysis", and "is not directed to" as "clearly does not seek to tie up any judicial exception".

The interpretation implied by the streamlined analysis provision is a reasonable and useful one. Unfortunately, based on our observations, it seems that examiners do not use the streamlined analysis in cases where it would be applicable. This is not surprising, since the streamlined analysis does not appear in the flowchart and is introduced in Section I.B.3 only as an optional tool available to the examiner: "For purposes of efficiency in examination, a streamlined eligibility analysis can be used...".

Checking whether a claim seeks to tie up a judicial exception should not be optional. It is the first thing that an examiner should do after finding that the judicial exception is recited in the claim.

The risk of tying up a law of nature, a natural phenomenon or an abstract idea is the very reason for the existence of the judicial exceptions. If it is possible to determine by simple and objective

considerations that such risk does not exist because the claim does not seek to tie up any judicial exception, the examiner should declare the subject matter of the claim eligible without embarking upon the complex, subjective and error-prone process of determining whether the claim recites additional elements that "amount to significantly more" than the judicial exception.

In the flowchart, there is a need for a step, following Step 1, that checks whether a judicial exception is recited in the claim. But that step should come before the two-part Mayo test instead of being part of it. The purpose of the Mayo test, as stated in Alice (page 7 lines 3-5), is "to distinguish patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts". Therefore the Mayo test is concerned with claims that have already been found to recite a judicial exception, and is only applicable to such claims.

Therefore we would like to suggest a flowchart with four steps:

Step 1 (Same as the current Step 1):

IS THE CLAIM TO A PROCESS, MACHINE, MANUFACTURE OR COMPOSITION OF MATTER?

If the answer is NO, the claim is not eligible subject matter. If the answer is YES, go to step 2.

Step 2 (Precondition for the Mayo test to be applicable):

DOES THE CLAIM RECITE A JUDICIALLY RECOGNIZED EXCEPTION (I.E. A LAW OF NATURE, A NATURAL PHENOMENON OR AN ABSTRACT IDEA)?

If the answer is NO, the claim qualifies as eligible subject matter. If the answer is YES, go to Step 3.

Step 3 (Part 1 of the Mayo test):

IS IT CLEAR THAT THE CLAIM DOES NOT SEEK TO TIE UP THE JUDICIALLY RECOGNIZED EXCEPTION?

If the answer is YES, the claim qualifies as eligible subject matter. If the answer is NO, go to Step 4.

Step 4 (Part 2 of the Mayo test, same as the current Step 2B):

DOES THE CLAIM RECITE ADDITIONAL ELEMENTS THAT AMOUNT TO SIGNIFICANTLY MORE THAN THE JUDICIAL EXCEPTION?

If the answer is YES, the claim qualifies as eligible subject

matter. If the answer is NO, the claim is not eligible subject matter.

Respectfully submitted,

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