From: Charles Warner [e-mail redacted]
Sent: Tuesday, October 27, 2015 11:39 PM
To: 2014_interim_guidance
Subject: Comment on the July 2015 Update: Subject Matter Eligibility

THE COMMENTS HEREIN ARE MY OWN PERSONAL COMMENTS AND ARE NOT ATTRIBUTABLE TO THE FIRM AT WHICH I PRESENTLY WORK, NOR TO ANY FIRM AT WHICH I HAVE PREVIOUSLY WORKED, NOR TO ANY PRESENT OR PREVIOUS CLIENT OF ANY OF THOSE FIRMS.

In response to the July 30, 2015 Federal Register notice announcing a request for comments concerning July 2015 Update on Subject Matter Eligibility, please see my comments below.
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I. The 2014 Interim Guidance and the July 2015 Update thereto are either lacking in sufficient guidance for examiners or are being ignored, as discussed below.

(a) An examiner asserts that a claim is directed to an abstract idea, and states an allegedly abstract idea, but never points to any PTO guidance or case law which defines that idea, or anything similar, as an abstract idea. Further, the examiner's position is that he doesn't have to provide any support for his assertion.

(b) An examiner completely ignores all of the claim limitations and refuses to consider the rule that the claim must be considered AS A WHOLE.
The examiner generally does not even discuss any claim limitations. If the examiner does mention a claim limitation, it is in the form of a vague generality, such as "identifying," "comparing," or some other gerund, without ever considering or even mentioning the remainder of the terms in that claim element. Thus, the examiner also ignores the rule that EACH AND EVERY CLAIM TERM MUST BE CONSIDERED AND GIVEN MEANING AND EFFECT.

(c) An examiner does not discuss any dependent claim or even mention any limitation of any dependent claim. The examiner also does not discuss other independent claims, which have different elements. The examiner therefore also ignores the rule that EACH CLAIM MUST BE CONSIDERED SEPARATELY.

(d) An examiner does not use the streamlined analysis and will not even consider comments in a response which apply the streamlined analysis.
The examiner's position is that the streamlined analysis only applies if the claim is "clearly patent eligible", but the examiner has not received any direction as to what that means, so he refuses to consider it and will only apply the full analysis.

(e) An examiner jumps directly from "the claim is directed to an abstract idea" to "the claimed steps are performed by a general purpose computer and do not improve the performance or operation of the computer"
without actually considering and commenting upon the novelty and/or inventive nature of any of the claim elements.

II. The Interim Guidance be further amended to include the following.

(1) A definition of, and case law examples of, "clearly patent eligible" to indicate whether the streamlined analysis can or should be performed.

(2) A definition of, and case law examples of, "significantly more" for use with the full analysis.

(3) The computer implementation test should be updated to instruct examiners that a claim directed to performing a novel or inventive process is patent eligible, even if performed on a general purpose computer using basic or general computer functions. Words in the English language are composed of the letters A through Z. These well-known letters are selected and combined in particular sequences to make particular words, and those words are combined in novel and imaginative sequences to create works of authorship. Similarly, computer operations fall under the categories of input/read, output/write, add/subtract, multiply/divide, and jump/branch.

Specific ones of these computer operations are selected, specific variables are selected for those operations, and the computer operations are sequenced in a particular way to generate a desired result. Just as random combinations of the letters A-Z do not, per se, result in works of authorship (or even in anything intelligible), random combinations of the computer operations and variables do not, per se, result in the novel or inventive desired result. The S.Ct. presumed (or "took official notice", if you prefer) that the claimed steps and the order and variables in Alice and Bilski were well known and had been routinely performed by humans for some time, so the computer was merely implementing well-known and straightforward processes. The S.Ct. did not state that performing a novel or inventive process on a general purpose computer using basic or general computer functions was not a patent eligible process.

III. The Interim Guidance should be updated to include the following procedures after the current "Step 1".

(a) Review EACH claim, and ALL of the terms in EACH claim.

(b) For EACH claim, define the allegedly abstract idea.

(c) For EACH claim, cite a PTO directive and/or a case law which states that a claim directed to that idea, or to a similar idea, is an abstract idea; and state how the particular claim is directed to that abstract idea.

(d) For EACH claim, consider whether the claim is "clearly patent eligible" and state why it is, or is not, "clearly patent eligible," for determining whether to perform the streamlined analysis.

(1) If the claim is "clearly patent eligible," perform the streamlined analysis.

(A) If the claim passes the streamlined analysis, proceed with conventional 102, 103, 112 analysis.

(B) If the claim does not pass the streamlined analysis, state why, with particularity (that is, state why the claim pre-empts all applications of the abstract idea), and then perform the "significantly more" analysis.

(2) If the claim is not "clearly patent eligible," state why, with particularity (that is, state why the claim elements leave open the possibility that they are not patent eligible), and then perform the "significantly more" analysis.

(e) For EACH claim for which the "significantly more" analysis was performed,

(1) If the claim passes the "significantly more" analysis, proceed with conventional 102, 103, 112 analysis.

(2) If the claim does not pass the "significantly more"

analysis, state why with particularity (that is, state why the claim elements do not add significantly more with respect to known processes), and then perform the computer implementation analysis.

(f) For EACH claim for which the computer implementation analysis was performed,

(1) If the claim passes the computer implementation analysis, proceed with conventional 102, 103, 112 analysis.

(2) If the claim does not pass the computer implementation analysis, state why with particularity; that is, state why the claimed process is neither novel nor inventive and why implementation on a computer is a straightforward implementation of a stated, known process.