

February 10, 2016

Via Electronic Mail

TopicSubmissionForCaseStudies@uspto.gov

Attention: Michael Cygan, Senior Legal Advisor
Office of Patent Legal Administration, Office of the Deputy
Commissioner for Patent Examination Policy

IBM Corporation Comments in response to "Request for Submission of Topics for USPTO Quality Case Studies", 80 Fed. Reg. 244 (December 21, 2015)

Title: Evaluating USPTO Patent Application Examination Practices since the US Supreme Court's Decision in *Alice*

Proposal for Study: Evaluate the impact of the US Supreme Court decision in *Alice* on USPTO patent examination regarding patentable subject matter (35 USC §101).

Explanation:

IBM thanks the United States Patent and Trademark Office ("Office") for the opportunity to submit topics for USPTO quality case studies. We appreciate the Office's continuing commitment to enhance patent quality.

Patent-eligibility under 35 USC §101, and in particular the judicially-created "abstract idea" exception, is an issue of paramount importance to IBM as an innovator and a patentee in the field of information technology. We appreciate the Office's efforts to capture the recent holding of the Supreme Court in the *Alice* decision and the rulings by lower Federal courts in following such holding, as it instructs Examiners in the 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74618, Dec. 16, 2014 (herein after "Interim Guidance") and in the July 2015 Update on Subject Matter Eligibility, 80 Fed Reg. 45429, July 20, 2015 (herein after "Update Guidance"). The Interim Guidance, the Update Guidance, and the MPEP¹ recognize the importance of a well-reasoned rejection and the burden on the Examiner to present a *prima facie* case when making any rejection, particularly an eligibility rejection. It is critical that the Examiner clearly communicate and specifically articulate the reasoning and supporting evidence behind the subject matter eligibility rejection to allow the Applicant to effectively respond to such rejection.

IBM respectfully requests that the Office evaluate the thoroughness and consistency of patent application examination when alleging subject matter ineligibility. In

¹ See MPEP 2103(VI), 2106(III), and 2142.

particular, we encourage the Office to study whether Examiners identify the “judicial exception” by examining the claims as a whole, referring to where the exception is recited in the claim, and explaining why it is considered an exception. Further, the Office should review 35 USC §101 rejections to ensure that when a claim includes additional elements beyond the “judicial exception”, the Examiners identify those elements in the rejection, and explain why they do not add significantly more to the exception. We encourage the Office to evaluate and compare the thoroughness and consistency of the examination in 35 USC §101 rejections issued prior to the *Alice* decision, after the *Alice* decision, and after publication of the Interim Guidance and the Update Guidance.

Further, IBM respectfully requests that the Office evaluate and compare the 35 USC §101 rejection rates and the thoroughness and consistency of the rejections in each of various technology centers and/or art units. We also encourage the Office to gather statistics on how Applicants are responding to a 35 USC §101 rejection and how Examiners are reacting to such responses. The Office should study how often Applicants appeal a 35 USC §101 rejection, and how often they amend or cancel claims. The Office should also study Examiner’s actions in responding to each of Applicant’s prosecution decisions. The Office should further analyze the outcomes when an Applicant appeals a 35 USC §101 rejection: how often was the application reopened for prosecution, allowed, or sent to the Patent Trial and Appeal Board (PTAB) for a decision on the merits. If the application was sent to the PTAB, then the Office should assess whether the Examiner was affirmed or not.

Finally, we request that the Office evaluate whether Examiners practiced compact prosecution in applications where they alleged a 35 USC §101 rejection, by also fully examining all the claims under 35 USC §102, §103, and §112. For example, the Office should consider the rate at which examiners reject claims on new grounds in Office Actions subsequent to an Office Action including a 35 USC §101 rejection and the rate at which examiners newly reject claims under 35 USC §101 after all other grounds of rejection have been overcome. We believe that thorough examination and compact prosecution helps ensure that each and every claimed invention is appropriately examined and provides Applicants with the information needed to effectively respond to any and all Examiner actions.

We strongly encourage the Office to continue to evaluate how computer implemented inventions are being examined and consider where further guidance may be needed. IBM supports all efforts to increase patent quality, including the Office's Enhanced Patent Quality Initiative, and we thank the Office for considering this particular submission as a case study in its new pilot program.

Respectfully submitted,

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