From: Martin, Heath D. (SHB)
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To: Eligibility2018
Cc: Martin, Heath D. (SHB)
Subject: New Part 2A "directed to" analysis as New Ground for Rejection

To Whom It May Concern:

I would like to suggest, in cases when an examiner can see multiple interpretations of the claims each of which would suggest the claims are directed towards ineligible abstract ideas, that the official PTO policy be to include all such interpretation, presented as alternatives, in the earliest possible office action. Additionally, as a natural consequence of this policy change, I suggest that later Office Action that include § 101 rejections asserting that the claims are directed to abstract ideas *unrelated to the earlier identified abstract ideas* should be considered new bases of rejection, and therefore should not be made final.

It is common practice for examiners, in a non-final office action, to reject the claims as directed to an abstract idea. Then, in response to persuasive arguments to the contrary, the examiner will change the rejection by identifying a different abstract idea that the claims are now purportedly directed towards, and issue a final rejection. It is respectfully submitted that this approach fails to provide Applicants with sufficient notice of the reasons for the rejection prior to the final rejection of the claims.

The question of what the claims are “directed to” is fundamental to the rejection under § 101 for patent eligibility and, likewise, to the arguments that would be set forward in rebutting such a rejection. The arguments or amendments that would serve to distinguish a set of claims from, for example, nothing more than a set of mental steps, would likely not be of the character and quality that would effectively distinguish the claims from a fundamental business practice. As such, changing the reason for rejecting a set of claims from being purportedly directed to one category of abstract idea to an entirely different category fails to provide the Applicant with the opportunity to respond effectively.

Additionally, it does not seem that the subject matter that a set of claims is “directed to” can reasonably be said to have changed from one Office Action to the next, even if the response includes amendments. I would argue assertions by the examiner that claims, when considered as a whole, are foundationally directed to subject matter that is completely different between one Office Action and the next must, by necessity, be recognized as a new grounds of rejection. Even in situations when claims are significantly amended between Office Actions, it is hard to argue that such claims, when considered as a whole, have been so changed in their meaning and purpose as to be directed to categorically different subject matter. It is respectfully submitted that this type of fundamental shift in the purpose of the claims is what would logically be required in order to justify the assertion that the claims were found to be “directed to” a different abstract idea as a result of the Applicant’s amendments. More likely it would be the case that, prior to submitting the Office Action, the examiner could have interpreted the claims in more than one way and, after the applicant has persuasively argued that the claims are not directed to a particular abstract idea, the examiner puts forward the alternative interpretation as a new reason to reject the claims. Clearly, such an alternative rejection could have been put forward prior to Applicant’s responsive arguments to the first subject matter rejection. This piecemeal approach is contrary to the principles of compact prosecution, as the examiner should put forward any and all possible grounds for rejection as soon as they can be raised.

It is my belief that treating § 101 rejections based on assertions that the claims are “directed to” new and unrelated subject matter as new grounds for rejection would better align the notice function of the Office Action with the reality of the rejection and encourage compact prosecution.

Thank you for your kind consideration of this matter,

Heath D. Martin
Patent Agent
Reg. No. 75954
Shook, Hardy & Bacon L.L.P.

816.559.2077 |