

June 23, 2018

United States Patent and Trademark Office  
Mail Stop Comments-Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Attn: Carolyn Kosowski and Matthew Sked, Senior Legal Advisors, Office of Patent Legal Administration

Re: Request for Comments on Determining Whether a Claim Element Is Well-Understood, Routine, Conventional for Purposes of Subject Matter Eligibility

To Whom It May Concern:

Thank you for the opportunity to comment on the *Berkheimer* memorandum in accordance with 83 Fed. Reg. 17536. Briefly, the *Berkheimer* memorandum requires Examiners to support an assertion that a claim element is well-understood, routine, conventional (hereinafter “conventional”) under 35 U.S.C. § 101 with certain forms of evidence. This evidence can include an Applicant admission of conventionality, a citation to a court decision discussed in MPEP § 2106.05(d)(II), a publication demonstrating the conventionality of the claim element, or a statement that the Examiner is taking Official Notice of conventionality.

I applaud the United States Patent and Trademark Office (“USPTO”)’s ongoing efforts to increase predictability in this uncertain area of patent law. In accordance with that effort, it is my opinion that any evidence of conventionality should include an indication of the date as of which the claimed subject matter was conventional.

For example, consider a patent application claiming subject matter that is not conventional as of its effective filing date. Some time after the application is filed, a reference is published characterizing the claimed subject matter as conventional. Clearly, an Examiner should be prohibited from using this reference as evidence of conventionality because it establishes conventionality only as of the publication date of the reference.

This follows a similar rationale as the well-established requirements for Examiners to indicate the date of a reference that is used to formulate a rejection under 35 U.S.C. §§ 102 or 103. Just as a claim cannot be anticipated or rendered obvious by a later reference, a claim also should not be rejected as conventional based on a reference that fails to establish conventionality prior to the effective filing date of the claimed subject matter.

It appears the USPTO has acknowledged this point, albeit informally, in training materials on subject matter eligibility posted to the USPTO website on May 7, 2018. Slide thirteen of the training materials state that a publication must be dated on or before the effective filing date of the application, or establish conventionality on or before the effective filing date of the application.

I believe the USPTO should enforce this requirement for any evidence of conventionality. For example, if an Examiner cites an Applicant admission, the Examiner should point to the portion of the admission that establishes conventionality prior to the effective filing date of the application. Likewise, any Official Notice of conventionality should include an indication of conventionality as of the effective filing date.

Similarly, Examiners should be permitted to establish conventionality on the basis of a court decision discussed in MPEP § 2106.05(d)(II) only if the effective filing date of the relevant claim elements are on or earlier than the claims at issue in the pending application. This would eliminate any “corner cases” in which a pending application has an effective filing date before the claims in a court decision discussed in MPEP § 2106.05(d)(II).

Accordingly, I respectfully request the USPTO to clarify that any *Berkheimer* evidence of conventionality must include an indication of the date as of which the claimed subject matter was determined to be conventional. Thank you for your consideration of this comment.

Respectfully Submitted,

/David J. Zuckerman/

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Reg. No. 71892