



## Intellectual Property Law Section of the State Bar of Nevada

March 8, 2019

The Honorable Andrei Iancu  
Under Secretary of Commerce for Intellectual Property and  
Director of the United States Patent and Trademark Office  
U.S. Patent and Trademark Office  
600 Dulany Street  
Alexandria, VA 22314

Via email: [Eligibility2019@uspto.gov](mailto:Eligibility2019@uspto.gov)

### **Re: Request for Comments on 2019 Revised Patent Subject Matter Eligibility Guidance**

Dear Under Secretary Iancu:

The Intellectual Property Law Section of the State Bar of Nevada is pleased to have this opportunity to present its views on the USPTO's Patent Application Examination Procedures pertaining to Patent Subject Matter Eligibility. These comments are in response to the January 7, 2019 Federal Register Notice, Vol. 84, No. 4 requesting public comment on the USPTO's 2019 Revised Patent Subject Matter Eligibility Guidance.

This position is being presented only on behalf of the Intellectual Property Law Section of the State Bar of Nevada. This position should not be construed as representing the position of the Board of Governors or the general membership of the State Bar. The Intellectual Property Law Section is a voluntary section composed of lawyers practicing in intellectual property law.

The Intellectual Property Law Section of the State Bar of Nevada applauds the efforts of the USPTO in issuing the 2019 Revised Patent Subject Matter Eligibility Guidance. The USPTO's Examination Procedures pertaining to Patent Subject Matter Eligibility remains an important issue to members of the Intellectual Property Law Section of the State Bar of Nevada as several members represent entities that have been significantly affected by the USPTO's application of the U.S. Supreme Court's *Alice/Mayo* test. The following comments include suggestions intended

to provide additional clarity to applicants regarding the USPTO's analysis under the *Alice/Mayo* test for abstract ideas.

### **1. Examiners should apply Preponderance of the Evidence Test**

Eligibility under 35 U.S.C. § 101 is a question of law, based on underlying facts. *See Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1125 (Fed. Cir. 2018); *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1364-65 (Fed. Cir. 2018). When determining patent subject matter eligibility under the *Alice/Mayo* test, the U.S. Court of Appeals for the Federal Circuit and the U.S. Supreme Court compare claims at issue to those claimed inventions already found to be directed to an abstract idea in previous cases. *See Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1334 (Fed. Cir. 2016).

That is, rather than resolving eligibility under 35 U.S.C. § 101 by comparing claimed inventions to concepts of abstract ideas, courts use specific limitations of the claimed inventions already found to be directed to an abstract idea in previous cases as part of the underlying facts. The courts then resolve the patent subject matter eligibility question of law by comparing the recited claim language of the claimed invention at issue to the recited claim language of those claimed inventions already found to be directed to an abstract idea.

Moreover, Section 706 of the MPEP acknowledges that the standard to be applied during patent examination is the "preponderance of the evidence" test. In order to properly apply this test, Examiners are required to identify facts as evidence that is weighed during examination under 35 U.S.C. 101, 102, 103 and 112.

Under this backdrop, the USPTO should consider providing additional guidance on the underlying facts that Examiners should consider when resolving eligibility questions under 35 U.S.C. § 101. Such facts should include the actual claim language that the courts have determined to constitute an abstract idea.

For example, each of enumerated groups of abstract ideas defined in Section I of the 2019 Revised Patent Subject Matter Eligibility Guidance is based on a prior decision of the U.S. Federal Circuit or the U.S. Supreme Court. Each of those cases turned on the specific claim limitations recited in the representative claim of the claimed inventions at issue.

As such, the USPTO should consider providing Examiners with the specific claim language of the representative claimed invention in each of those prior court decisions to provide Examiners with the specific underlying facts necessary to resolve patent eligibility under the "preponderance of the evidence" test. The Examiners may then determine whether an examined claimed invention

recites an abstract idea under the "preponderance of the evidence" test by comparing the claim language of examined application with the specific claim language of the claimed invention at issue in the corresponding court decision.

Examiners can apply these underlying facts at Prong One of Step 2A. For example, at Prong One, once the Examiner has identified a claim limitation that appears to recite an abstract idea that falls within the enumerated groups of abstract ideas, the Examiner should be instructed to review the specific claim limitations recited in the representative claim(s) addressed in the corresponding cited court decision (*i.e.* underlying facts). The Examiners may then compare the claims of the examined application with the specific claim limitations recited in the representative claim(s) to identify the similarities in claim limitations and scope, and evaluate these similarities under the "preponderance of the evidence test" to determine whether the claims of the examined application recite an abstract idea. If the Examiner then concludes, based on the similarities in claim language and scope, that it is more likely than not that the claim limitation(s) recite the identified abstract idea, the Examiner may proceed to Prong Two of Step 2A.

If the examined claimed invention is ultimately rejected as being directed to patent ineligible subject matter, the Examiner may then present the findings under Prong One to inform the applicant of the identified similarities in claim language and scope.

## **2. Ensure the Enumerated Groups Are Not Overly Broad**

The USPTO should consider providing additional language to better define the scope of the abstract ideas listed in the enumerated groups of abstract ideas defined in Section I of the 2019 Revised Patent Subject Matter Eligibility Guidance. On its face, the subject matter groupings of abstract ideas appear overly broad, and may be interpreted to include subject matter not yet addressed by the courts.

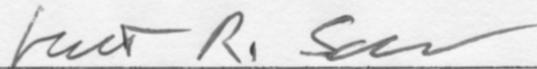
## **3. Clarify How Examiners Determine Whether a Recited Judicial Exception is Integrated into a Practical Application**

The USPTO should consider further clarifying how a recited judicial exception may be integrated into a practical application of the exceptions under Prong Two. That is, the 2019 Revised Patent Subject Matter Eligibility Guidance states that if a claim recites a judicial exception, but that exception is not integrated into a practical application, such claim must be then evaluated under Step 2B. The Examiner is tasked with evaluating whether a claim as a whole includes a judicial exception "such that the claim is more than a drafting effort designed to monopolize the judicial exception." It would be helpful if the USPTO provided Examiners with further guidance on

how to make this determination. This appears particularly necessary as the 2019 Revised Patent Subject Matter Eligibility Guidance only provides non-exclusive lists of examples of both integrating the exception into a practical application and where an exception has not been integrated. Such non-exclusive lists risk leaving much too how an individual Examiner applies the test.

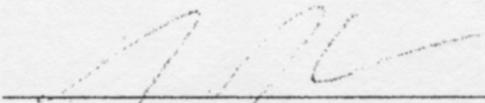
We appreciate the opportunity to provide these comments on the USPTO's Patent Application Examination Procedures, and look forward to additional guidance on Patent Subject Matter Eligibility.

Sincerely,



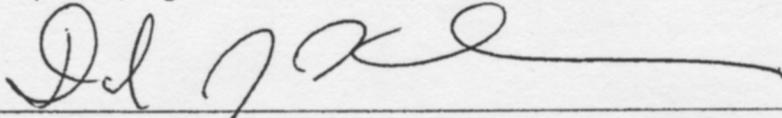
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