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Subject: comments from Lee & Hayes, P.C., on 2019 PEG

Lee & Hayes, P.C.'s Comments on Section 101 Guidance

The patent practitioners at Lee & Hayes generally agree with and support the Office's January 7, 2019 Revised Patent Subject Matter Eligibility Guidance. Instructing examiners in the Step 2A analysis to additionally determine whether a claim integrates an abstract idea into a practical application, before concluding that the claim is "directed to" the abstract idea, should help avoid many improper Section 101 rejections in the future. Our practitioners raised the following points on the Guidance.

Requirements for making a prima facie case of ineligibility under Section 101:

The Guidance does not address the requirements for an examiner to set forth a prima facie case of ineligibility (e.g., as other Office guidance does for obviousness). The Office's express guidance to the Examining Corps on this topic would help eliminate cursory and/or conclusory Section 101 rejections, particularly now that Step 2A has changed.

For example, some examiners reject a claim without specifically identifying the alleged abstract idea, showing that the alleged abstract idea is well-known in a relevant field, or explaining how the actual claim language is directed to the alleged abstract idea. Instead, these examiners may tend to oversimplify, paraphrase, or eliminate claim language in their analyses and thus not address the claim language individually or as a whole. Sometimes examiners also reject dependent claims without analysis.

Without guidance on the requirements of a prima facie case, some examiners may take a similar approach with revised Step 2A, contending that the claim language does not integrate an alleged abstract idea into a practical application without a proper explanation. We have already seen some office actions to this effect. For example, in one recent office action received by our firm, the examiner asserted that the claims did not integrate an alleged abstract idea into a practical application because they did not provide "a technical solution to a technical problem." Aside from the problem of the examiner applying European patent law to a U.S. patent application, the examiner provided no explanation for this conclusion. Additionally, the notion of a "practical application" is broader than a "technical solution to a technical problem." Thus, it appears that the Corps could benefit from additional guidance on establishing a prima facie case.

Failure to follow the Guidance:

The Guidance states that "[t]he guidance was developed as a tool for internal USPTO management and does not create any right or benefit, substantive or procedural, enforceable by any party against the USPTO." Page 7. Additionally, "[f]ailure of USPTO personnel to follow the guidance, however, is not, in itself, a proper basis for either an appeal or a petition." *Id.*

Some practitioners feel this statement removes the "teeth" from the Guidance and suggested that the Office create a procedure or other mechanism for early review of an alleged failure of an examiner to

follow the Guidelines. The Office's Pre-appeal Brief Conference seems like a good choice, but the language above appears to prohibit using this tool to raise an examiner's failure to follow the Guidance (because the applicant must file a Notice of Appeal with a Pre-appeal Brief Conference Request).

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