From: Karl Koster
Sent: Tuesday, February 26, 2019 4:37 PM
To: Jensen, Nicholas A.
Cc: 'Karl Koster'
Subject: Comments on 2019 PEG tutorial

Sandy:
I do appreciate the time and effort the USPTO provided in offering the patent eligibility training course. The case law is clearly not as definite as us practitioners would like, and patent eligibility is something I deal with on a daily basis.

But, I have to take exception to the analysis for Example 40:, which I have reproduced below for reference:

2B: Claim provides an Inventive Concept?	**No.** As discussed with respect to Step 2A Prong Two, the additional elements in the claim amount to no more than mere instructions to apply the exception using a generic computer component. The same analysis applies here in 2B, i.e., mere instructions to apply an exception on a generic computer cannot integrate a judicial exception into a practical application at Step 2A or provide an inventive concept in Step 2B. Under the 2019 PEG, a conclusion that an additional element is insignificant extra-solution activity in Step 2A should be re-evaluated in Step 2B. Here, the collecting step was considered to be extra-solution activity in Step 2A, and thus it is re-evaluated in Step 2B to determine if it is more than what is well-understood, routine, conventional activity in the field. The background of the example does not provide any indication that the network appliance is anything other than a generic, off-the-shelf computer component, and the *Symantec*, *TLI*, and *OIP Techs.* court decisions cited in MPEP 2106.05(d)(II) indicate that mere collection or receipt of data over a network is a well-understood, routine, and conventional function when it is claimed in a merely generic manner (as it is here). Accordingly, a conclusion that the collecting step is well-understood, routine, conventional activity is supported under *Berkheimer* Option 2. For these reasons, there is no inventive concept in the claim, and thus it is **ineligible**.

In the *Berkheimer* case, the court found that claim 4 potentially recited an inventive concept because of the specific limitations that recited **how** data was stored by an "asset management system. Specifically, as I had stated in prior comments to the USPTO:

> Thus, using claim 4 as an example, the court found the claim directed to an abstract idea ("parsing, comparing and storing data") and then identified the other limitations in that claim ("storing a reconciled object structure in the archive without substantial redundancy") to be analyzed as 'something more.' The court noted that conventional document management systems stored data (i.e., they archived documents), but "known

> asset management systems did not archive documents in this manner." (*Berkheimer*, slip op. 16.) In other words, existing systems did not perform "storing a reconciled object structure in the archive without substantial redundancy".

The point from *Berkheimer* is that the component used to perform the steps (i.e., a known asset management system or as can be stated otherwise, a 'generic-off-the-shelf computer configured as an asset management system') should not itself lead to the conclusion that the claims do not recite an inventive concept. The further limitations have to be analyzed. In *Berkheimer*, the court found that the limitations of how the data was stored was critical. Obviously, the inventions in *Enfish* (and every other patent eligible software patent claim) operate using a "conventional computer." But, without analyzing all the limitations, an incorrect result may be reached. It is insufficient to merely conclude that because the claims recite the generic computer "storing data", "retrieving data", and "processing data" and then ignoring how/what is stored, that the claims do not recite an inventive concept. Had the court done that in *Berkheimer*, a different conclusion would have been reached.

This is why I object to the analysis reproduced above. The "network appliance" may be a generic, off-the-shelf computer, but concluding that the "mere collection or receipt of data" is therefore well-understood, routine and conventional ("WURC") and is therefore lacking an inventive concept cannot be reconciled with *Berkheimer*. It may be that the information being collected and sent by the network appliance is not WURC (can we categorically conclude it is without analysis?) Without showing that as such, the USPTO's own guidelines in *Berkheimer* are not being followed. It is too easy for an examiner to consider the claims in *Berkheimer* using the same analysis above and conclude: "The asset management system in *Berkheimer* is merely a generic-off-the shelf computer which merely stores or archives data, and therefore based on *Symantec*, *TLI*, and *OIP Techs*, the claims do not recite an inventive concept." The above analysis would lead an examiner to ignore the very limitations the Federal Circuit found critical. This analysis essentially ignores the critical limitations.

It is quite clear all computers store, retrieve and process data generally speaking, and it is all too easy to conclude that regardless of the data being stored, how it is stored, or what is stored, that no inventive concept is recited. Had the example above stated, "The examiner should do an analysis on the data stored (e.g., whether the network appliance's collection of "traffic data comprising at least one of network delay, packet loss, or jitter" is WURC) and if it is shown to be WURC, then an inventive concept is not recited. If, however, the collection of "traffic data comprising at least one of network delay, packet loss, or jitter" was not WURC, then an inventive concept is recited.

I submit that the analysis for Example, 40, claim 2, is incomplete and incorrect.

Cheers,

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