

**United States Patent and Trademark Office  
Docket No. PTO-P-2018-0053  
2019 Revised Patent Subject Matter Eligibility Guidance**

**Written Comments of Michael J. Mehrman, USPTO Reg. 40086**

**Identification of the Commenter:** Mr. Mehrman has been a member of the Patent Bar since 1995 with a background in electrical engineering. He has prosecuted many patent applications on behalf of a wide range of clients, many of which were small entities in early stages of emerging technologies.

**Summary of the Requested Clarification:** Please clarify that, with respect to the category of abstract ideas, Step 2A of the rules require that:

**Computer-controlled procedures executable by a general purpose computer claimed as part of a practical application are to be considered part of the technology of the practical application.**

**Reason for the Requested Clarification:** Although the proposed rules and the prior Office guidance and relevant judicial decisions would appear to require this construction, certain examiners have steadfastly taken a contrary position with respect to prior Office guidance and judicial precedent. For example, despite acknowledging that a claim recites a non-obvious “improvement” to a claimed practical application, certain examiners have still rejected the claims as ineligible on the basis that the improvement results from computer software running on a general-purpose computer by holding that “computer software running on a general-purpose computer is not part of the technology” recited by the claim.

In other words, these examiners have been effectively ignoring “computer software running on a general-purpose computer” when evaluating whether a claim recites an “improvement to technology” in the eligibility analysis. Their reasoning contends that the eligibility analysis requires that the “improvement” recited by the claim must improve the operation of the computer itself or some component of another technology, other than software running on a general-purpose computer, to qualify as “technology.” This rationale is based on a constrained definition of the term “technology” that appears strategically designed to create an eligibility requirement that goes beyond the plain language of the previous guidance.

This current examination approach is similar to a prior, now overruled argument based on an alleged “lack of tangibility” of computer software running on a general-purpose computer. Before that, the arguments focused on “functional claim language” as an asserted basis for rejecting claims to software-based innovations. The reality is that U.S. patent applicants have faced shifting and extremely tenacious examination arguments over a period of decades contending that computer software running on a general-purpose computer should not be allowed to stand as the “point of novelty” or the “source of the improvement” for U.S. patents. The current argument contending that “software is not part of the technology” when conducting Section 101 eligibility analysis is only the latest iteration in the decades-long struggle for recognition of patentability of software-based inventions.

Examiners have long relied on these types of anti-software arguments to force applicants to appeal their final rejections, causing the applicants to endure the cost and delay of the appeal process to secure their patents. The approach to eligibility examination described above has not been limited to a few examiners in isolated cases, but extends to some supervisors, AFCP decisions, and panels in pre-appeal review. Of course, this greatly increases the cost and delays the issuance of the patents, and may effectively deny applicants patents on eligible inventions, which can seriously undermine the financial viability of emerging technology companies at the most sensitive early stages their development.

Unfortunately, it appears from the current wording and discussion of the rule that certain examiners who appear to be “intrinsically dug in” against software-related inventions could bring up yet another line of argument by contending that “computer software running on a general-purpose computer is not part of the *practical application*” just as they have been arguing that “computer software running on a general-purpose computer is not part of the *technology*” recited by the claims. And once again, emerging technology companies would face the prospect of “dying on vine” while the latest anti-software argument works its way through various appeals. The requested clarification is designed to expressly “head this argument off at the pass” under the new rules, which certainly appears to be the intent of the rules. The requested clarification is well justified in view of the fraught, contentious and lengthy history of the seminal issue of the patentability of software-related inventions. A little extra clarity and emphasis on the very crux of the issue is not too much to ask for at this point in the process.

The requested clarification is supported by a long line of Supreme Court and Federal Circuit decisions expressly finding claims eligible where the “improvement” arises from computer software executable by general purpose computers, provided that the claim is directed to a practical application (or technology), including (at least) *Diamond v Diehr*, *RCT*, *Enfish*, *McRo*, and *Thales* as well as the current Office Guidance in MPEP § 2106.04(a).<sup>1</sup> The examining corps, the courts, the emerging technology community, and the business community in general will therefore benefit from the Office taking this opportunity to expressly include the requested clarification in the proposed rules.

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<sup>1</sup> *Diamond v Diehr*, 450 U.S. 175 (1981); *Research Corporation Technologies Inc. v. Microsoft Corp.*, 627 F.3d 859 (Fed. Cir. 2010); *Enfish, LLC v. Microsoft Corp.* 822 F.3d 1327 (Fed. Cir. 2016); *McRo, Inc. DBA Planet Blue v. Bandai Namco Games America, et al.*, 837 F.3d 1299 (Fed. Cir. 2016); *Thales Visionix, Inc. v. United States*, 850 F.3d 1343 (Fed. Cir. 2017).