From: John D. Vandenberg
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To: Eligibility2019
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Subject: 2019 Revised Patent Subject Matter Eligibility Guidance, Comments

I have worked on patent litigations continuously since the month the Federal Circuit began, May 1982, during which summer I attended a patent trial for several weeks as a summer associate at Kenyon & Kenyon. Since 1989, at Klarquist Sparkman LLP, I mostly have been defending software companies, but also represent plaintiffs and parties in other technical fields. I have authored www.patentdefenses.com since 2004. I am privileged and fortunate to have been able to work in this field.

I have seen firsthand, however, the harm caused to large and small businesses by the issuance and assertion of patents that anyone versed in governing legal precedents immediately would see are facially invalid under Sec. 101 or 112. I submit these comments, on my own behalf only, because the Revised Guidance is sure to exacerbate this problem.

Governing precedents of the Supreme Court and Federal Circuit identify five distinct categories of patent-ineligible abstract ideas. The Revised Guidance identifies only three of the five, and declares those three to be the only recognized categories. Specifically, the Revised Guidance limits abstract ideas to these three categories (with "rare" exception subject to a clearance procedure): "mathematical concepts, certain methods of organizing human activity, and mental processes." This omits the two other equally well-established categories of abstract idea:

1. Collecting, analyzing, classifying, organizing, filtering, storing, manipulating and/or displaying information. (See exemplary cases below.)
2. Results achieved and functions performed without reciting particular ways (i.e., particular structures and acts) to achieve or perform them. (See exemplary cases below.)

These categories are fundamental. Information is not patentable. Results achieved and functions performed are not patentable. Patents are reserved for *how* results are achieved and functions performed, in the physical realm. There should be no serious doubt about these basic principles.

The Office has many professionals extremely well-versed in the governing precedents, from the Director on down, so the omission of these two recognized categories surely was intentional. For example, while the Guidance cites many precedents, it conspicuously omits the precedents most associated with the two omitted categories. The omission of "functional claims" (or claims directed to a "result," or an "effect," or a "function") appears to be a decision to shift all concerns of "functional claiming" to Sec. 112, despite governing Federal Circuit precedents to the contrary.

The Office may have good reason to omit these two categories. But, it is unlikely, at best, that the Guidance will convince district courts or Federal Circuit panels to deviate from binding precedents. This is so especially because the Guidance does not purport to apply agency expertise to the question of what should or should not be deemed eligible for patenting.

Therefore, the Guidance essentially guarantees that many more patents will be granted that are sure to be declared invalid in court for patenting subject matter that is not entitled to patenting, incurring tremendous costs on established and upcoming businesses. That, of course, is an undesirable state of affairs.

It is particularly unfortunate given that this has happened before, with the Patent Office granting thousands of patents on subject matter that plainly was ineligible under *Benson*, *Flook* and *Diehr*. That past history does not mean, of course, that the Patent Office should not act, but does caution against intentionally deviating from governing precedents, for any reason.

Therefore, I respectfully urge the Office to reconsider its decision to omit two of the five established categories of abstract idea.

Thank you.

John D. Vandenberg

Collecting, Analyzing, Classifying, Organizing, Filtering, Storing, Manipulating And Displaying Information (Data) Are Abstract:

Post-*Alice* Fed. Cir. Opinion	Discussion in Revised Guidance
1. "Information as such is an intangible. Accordingly, we have treated collecting information, including when limited to particular content (which does not change its character as information), as within the realm of abstract ideas. In a similar vein, we have treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category. And we have recognized that merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis. Here, the claims are clearly focused on the combination of those abstract-idea processes. The advance they purport to make is a process of gathering and analyzing information of a specified content, then displaying the results, and not any particular assertedly inventive technology for performing those functions. They are therefore directed to an abstract idea." *Elec. Power Grp., LLC v. Alstom S.A.,* 830 F.3d 1350,	None.

Post-*Alice* Fed. Cir. Opinion	Discussion in Revised Guidance
1353–54 (Fed. Cir. 2016) (aff'g Summ. J. of invalidity) (emphasis added).	
2. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1366 (Fed. Cir. 2018) (claims directed to "abstract idea of parsing, comparing, storing, and editing data" similar to claims in *TLI Commc'ns* and *Content Extraction*).	Step One analysis not discussed. See Revised Guidance at n. 40.
3. *Glasswall Sols. Limited v. Clearswift Ltd.*, No. 2018-1407, 2018 WL 6720014, at *1 (Fed. Cir. Dec. 20, 2018) (non-precedential) ("The claims merely require the conventional manipulation of information by a computer. We have often held similar conventional data manipulation to be abstract.").	None.
4. *Move, Inc. v. Re/Max Int'l, Inc.*, 721 F. App'x 950, 954 (Fed. Cir. 2018) (non-precedential) ("while we do not suggest that every claim involving the collection, organization, manipulation, or display of data is necessarily directed to an abstract idea, claim 1 is not meaningfully distinct from claims we have held were directed to abstract ideas in previous cases").	None.
5. *Smart Sys. Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1372 (Fed. Cir. 2017) ("collection, storage, and recognition of data" is abstract).	None.
6. *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1056 (Fed. Cir. 2017) ("data processing to facilitate financing is a patent-ineligible abstract concept.").	Discussed at n. 11 (as conflicting with another decision), n. 13 (as "certain methods of organizing human activity"), n. 30 (Step Two).
7. *West View Research, LLC v. Audi AG*, 685 F. App'x 923, 926 (Fed. Cir. 2017) (non-precedential) (claims directed to an abstract idea because they "do not go beyond receiving or collecting data queries, analyzing the data query, retrieving and processing the information constituting a response to the initial data query, and generating	None.

Post-*Alice* Fed. Cir. Opinion	Discussion in Revised Guidance
a visual or audio response to the initial data query," and not improvement to computer functionality itself).	
8. *Intellectual Ventures I LLC v. Erie Indemnity Co.*, 850 F.3d 1315, 1327 (Fed. Cir. 2017) ("We have previously held other patent claims ineligible for reciting similar abstract concepts that merely collect, classify, or otherwise filter data….[T]he claimed creation of an index used to search and retrieve information stored in a database is similarly abstract.").	None.
9. *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) ("claims are, at their core, directed to the abstract idea of collecting, displaying, and manipulating data.").	None.
10. *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093, 1097–98 (Fed. Cir. 2016) (patent "is directed to or drawn to the concept of analyzing records of human activity to detect suspicious behavior"; "the practices of collecting, analyzing, and displaying data, with nothing more, are practices 'whose implicit exclusion from § 101 undergirds the information-based category of abstract ideas.'").	None.
11. *TDE Petroleum Data Sols., Inc. v. AKM Enter., Inc.*, 657 F. App'x 991, 993 (Fed. Cir. 2016) (non-precedential) (claims directed to "the abstract idea of storing, gathering, and analyzing data");	None.
12. *TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016) (aff'g mtn. to dismiss: "claims are directed to the abstract idea of classifying and storing digital images in an organized manner").	Referenced (e.g., as being inconsistent with another decision) but not otherwise discussed.
13. *Content Extraction and Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (claims "drawn to the abstract idea of 1) collecting data, 2) recognizing certain data within the collected data set, and 3) storing that recognized data in a memory.").	None.

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14. *Return Mail, Inc. v. U.S. Postal Service*, 868 F.3d 1350, 1368 (Fed. Cir. 2017) ("'receiving from a sender a plurality of mail items,' 'identifying undeliverable mail items,' 'decoding . . . encoded data,' 'creating output data,' and 'determining if the sender wants a corrected address,'" are analogous to those in *Content Extraction*).	None.
15. *Digitech Image Techs., LLC v. Elecs. For Imaging, Inc.*, 758 F.3d 1344, 1350 (Fed. Cir. 2014) ("claims an abstract idea because it describes a process of organizing information through mathematical correlations and is not tied to a specific structure or machine.").	Noted as example of mathematical concepts, at n. 12.

Results, Effects And Functions—Without Reciting *How* ("A Particular Way") They Are Achieved Or Performed—Are Abstract Ideas:

Post-*Alice* Fed. Cir. Opinion	Discussion in Revised Guidance
16. "A patent is not good for an effect, or the result of a certain process" because such patents "would prohibit all other persons from making the same thing by any means whatsoever." *Le Roy v. Tatham*, 55 U.S. 156, 175 (1853).	Case mentioned in n. 16, but not for this point.
17. *Corning v. Burden*, 56 U.S. 252, 268 (1853) (patents are granted "for the discovery or invention of some practicable method or means of producing a beneficial result or effect . . . and not for the result or effect itself". "A claimed invention must embody a concrete solution to a problem having 'the specificity required to transform a claim from one claiming only a result to one claiming a way of achieving it.'")	None.
18. *Interval Licensing LLC v. AOL, Inc.* 896 F.3d 1335, 1338, 1348 (Fed. Cir. 2018) ("the claimed 'attention manager,' broadly construed as any 'system' for producing that result ["our function-based construction of 'attention manager'"; the "result-centric construction"; "defining that term	Discussed in n. 13, but not for this point.

Post-*Alice* Fed. Cir. Opinion	Discussion in Revised Guidance
by the result it yields, not by its structural design or any mode for producing the result"], is not limited to a means of locating space on the screen unused by a first set of displayed information and then displaying the second set of information in that space. The claim limitations for accessing, scheduling, and then displaying the second information set are conventional functions stated in general terms and do not further define *how* the attention manager segregates the display of two sets of data on a display screen.").	
19. *Glasswall Sols.,* 2018 WL 6720014, at *1 ("The claims at issue in both patents do not purport to claim *how* the invention receives an electronic file, *how* it determines the file type, *how* it determines allowable content, *how* it extracts all the allowable data, *how* it creates a substitute file, *how* it parses the content according to predetermined rules into allowable and nonconforming data, or *how* it determines authorization to receive the nonconforming data. Instead, the claims are framed in wholly functional terms, with no indication that any of these steps are implemented in anything but a conventional way.").	None.
20. *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (The claims in *McRO* "had the specificity required to transform a claim from one claiming only a result to one claiming a way of achieving it.").	Identified in n. 12 as example of mathematical calculations.
21. *Move, Inc.*, 721 F. App'x at 954–56 (claim "is aspirational in nature and devoid of any implementation details or technical description that would permit us to conclude that the claim as a whole is directed to something other than the abstract idea…. While the claim limitations provide steps for using the computer to perform the search, they contain no technical details or explanation of how to implement the claimed abstract idea using the computer…. Instead of	None.

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focusing on the technical implementation details of the zooming functionality, for example, claim 1 recites nothing more than the result of the zoom.").	
22. *Two-Way Media Ltd. v. Comcast Cable Comm'ns, LLC,* 874 F.3d 1329, 1337 (Fed. Cir. 2017) (claim "recites a method for routing information using result-based functional language. The claim requires the functional results of 'converting,' 'routing,' 'controlling,' 'monitoring,' and 'accumulating records,' but does not sufficiently describe how to achieve these results in a non-abstract way," even under the patent owner's proposed constructions).	None.
23. *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1241, 1244, 1245 (Fed. Cir. 2016) ("the claims in these patents are directed to an abstract idea. The patents claim systems including menus with particular features. They do not claim a particular way of programming or designing the software to create menus that have these features, but instead merely claim the resulting systems. Essentially, the claims are directed to certain functionality—here, the ability to generate menus with certain features."; relying on absence of disclosure in the Spec. as to how result achieved: "the linked orders claim limitation calls for the desired result of associating a customer's order with said customer, and does not attempt to claim any method for achieving that result" and Spec. "refers to the use of handwriting and voice capture technologies without providing how these elements were to be technologically implemented").	None.
24. *Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1269 (Fed. Cir. 2016) ("The patent, however, does not disclose any particular mechanism for wirelessly streaming content to a handheld device. … The purely functional nature of the claim confirms that it is directed to an	None.

Post-*Alice* Fed. Cir. Opinion	Discussion in Revised Guidance
abstract idea, not to a concrete embodiment of that idea.").	
25. *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016) ("There is nothing in claim 1 that is directed to *how* to implement out-of-region broadcasting on a cellular telephone. Rather, the claim is drawn to the idea itself.").	None.
26. *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1348 (Fed. Cir. 06/23/15) ("the character of the claimed invention is an abstract idea: the idea of retaining information in the navigation of online forms"; "IPC's proposed interpretation of 'maintaining state' describes the *effect or result dissociated from any method* by which maintaining the state is accomplished upon the activation of an icon." "The end result of 'maintaining the state' is described as the innovation over the prior art," but "claim 1 contains no restriction on *how the result is accomplished*. The mechanism for maintaining the state is not described, although this is stated to be the essential innovation.").	None.
27. *Data Engine Tech. LLC v. Google LLC*, 906 F.3d 999, 1008, 110–11 (Fed. Cir. 2018) (rev'g R. 12(c) invalidity; patents "solved this known technological problem in computers in a particular way—by providing a highly intuitive, user-friendly interface with familiar notebook tabs for navigating the three-dimensional worksheet environment;" claims "recite a specific structure (i.e., notebook tabs) within a particular spreadsheet display that performs a specific function (i.e., navigating within a three-dimensional spreadsheet).").	None.
28. *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305 (Fed. Cir. 2018) (although "even an innovative result, is not itself patentable," claims	

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"recite specific steps—generating a security profile that identifies suspicious code and linking it to a downloadable—that accomplish the desired result").	
29. *Visual Memory LLC v. Nvidia Corp.*, 867 F.3d 1253, 1261 (Fed. Cir. 2017) (2-1) (rejecting dissent's position that claims directed to a result without specifying how achieved: "both the specification and the claims expressly state that this improved memory system is achieved by configuring a programmable operational characteristic of a cache memory based on the type of processor connected to the memory system").	Noted in n. 11 as being inconsistent with another decision.

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