

**From:** Warren Wolfeld

**Sent:** Wednesday, March 6, 2019 7:36 PM

**To:** Eligibility2019

**Subject:** Suggestion to establish a standard for which language from the claim is to be included in the identification of the "abstract idea" in Prong 1

In general, I believe the 2019 Guidance is an excellent step forward in bringing some consistency to post-Alice patent eligibility law. The now-deprecated Eligibility Quick Reference Sheet was perhaps necessary as an initial policy response to the confusion generated by Alice, but quickly became unworkable as examiners relied on the sound bite descriptions on that sheet to reject claims, rather than considering the case holdings and opinions themselves. Since nearly everything could be thought of as satisfying one or more of such sound bites, far more patent eligibility rejections were made than were warranted by legal precedent. Once rejected, such claims will never reach a court to receive a proper legal analysis. The 2019 Guidance appears to synthesize the majority of legal precedent, while simplifying and clarifying the analysis that Examiners should make when considering claims for patent eligibility. It is not necessary that the Guidance exactly match all precedent; that would frankly be impossible given the multiplicity of contradictory decisions since Alice. Rather, by drawing the line so as to possibly exclude certain outlier cases, or cases with broad, unsupportable dicta going far afield of the actual facts of the case, I am hopeful that future courts will have patents to review which can form the basis for limiting future precedential effect of such unwarranted dicta.

That said, I would like to bring to the attention of the Office an aspect of the 2019 Guidance which I believe could be clarified further. Under the Guidance, Alice Step I (USPTO procedure step 2A) is now divided into two Prongs. If in Prong 1 the Examiner identifies an Abstract Idea, he or she is required to identify the specific claim language that embodies the abstract idea. <https://www.federalregister.gov/d/2018-28282/p-62>. Then in Prong 2, the Examiner determines whether the "claim as a whole" integrates the recited judicial exception into a practical application of the exception. <https://www.federalregister.gov/d/2018-28282/p-66>.

However, the guidance also then says that Examiners evaluate integration into a practical application by evaluating whether "those additional elements individually and in combination", integrate the exception into a practical application. <https://www.federalregister.gov/d/2018-28282/p-68>. This latter instruction, which appears to focus the Examiner's attention only on the "additional elements", seems to contradict the former instruction that the Examiner is to determine whether the "claim as a whole" integrates the recited judicial exception into a practical application of the exception.

I urge the Office to clarify that the integration of the exception into the practical application does not exclude consideration of the limitations that recite the exception itself. That is, all the claim elements, whether or not part of the identified abstract idea (i.e., the "claim as a whole"), both individually and in combination, must be considered as to whether a practical application is

claimed. The Prong 2 analysis should not focus only on the additional limitations of the claim, that is, only the language of the claim other than the language that was identified as embodying the abstract idea. That would not be considering the "claim as a whole".

If that is not what the Office intends, then I urge the Office to clarify what the standard is for how much language from the claim is to be included in the identification of the "abstract idea" in Prong 1. Stated another way, if the Examiner identifies virtually all the claim language as embodying the abstract idea, then virtually nothing will remain as "additional limitations" for consideration of whether they place the abstract idea in a practical application. While some claims may warrant such treatment, our experience in the context of Step 2B is that some examiners go well beyond what is reasonable, to include virtually the entire claim as the "abstract idea" (excepting only typical computer components), so as to avoid having to engage in the Berkheimer analysis. Without some language in the Guidance which establishes a standard for how much language from the claim is to be included in the identification of the "abstract idea" in Prong 1, my concern is that some examiners will continue that same questionable practice in the context of Step 2A Prong 1, thereby defeating the purpose of the Guidance.

I would suggest that the proper amount of claim language to include in the identification of the abstract idea, in Step 2A Prong 1, is only the minimum amount of the claim language that is needed to establish that the idea fits within the identified one of the three groupings of abstract ideas. For example, if a claim recites a step of "summing the number of A items and the number of B items", then the "mathematical concept" should include only the word "summing", because whereas "summing" is a mathematical concept, "A items" and "B items" are not themselves mathematical concepts. They do not themselves fit within the "mathematical concept" grouping of abstract ideas. This standard would permit the Examiner to consider whether the fact that it is specifically A items and B items that are summed, rather than other items, is a "practical application" of the mathematical concept of "summing".

Thank you again for promulgating the new Guidance.

**Warren S. Wolfeld\***

Haynes Beffel & Wolfeld LLP

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2019 Eligibility Guidance – Excerpt from video of Quality Chat 1\_10\_2019

Q&A with Bob Bahr

**48:10**

Q: The new two-prong step 2A explicitly rejects an often used rationale of dismissing additional elements as merely conventional. However, another often used rationale is to dismiss claim limitations as part of the abstract idea. How will these new guidelines to combat this practice?

A: Well, I would say that under the old guidance you would say, you would identify what in the claim is the abstract idea. You're still doing that, and of course whatever is identified as the abstract idea - instead of matching it up to a case, now you're matching it up to one of these groups. So, whatever is identified in the claim as an abstract idea has to fit within one of the groups as an abstract idea. So obviously if the claim is directed to, you know includes computer components working in a specified arrangement - I mean obviously the argument would have to be that these are an abstract idea. And I don't think an Examiner is going to do that. So the bottom line is that whatever is considered to be the abstract idea has to fit in within one of the groupings of abstract ideas. So that will – to cabin in an Examiner who just takes an entire claim that goes beyond a judicial exception and calling it all a judicial exception to avoid any prong two or step 2B analysis.

**49:37**

**From:** [Jonas Weber](#)

**To:** [Eligibility2019](#)

**Subject:** Reject new guidelines on subject matter eligibility, Docket No. PTO-P-2018-0053

**Date:** Wednesday, February 6, 2019 3:31:48 PM

Hi,

I urge the USPTO not to adopt the guidance on subject matter eligibility set forth in the Request for Comments, Docket No. PTO-P-2018-0053.

Instead, the USPTO should provide guidance that ensures examiners apply the Supreme Court's Alice v. CLS Bank decision correctly.

The new guidance expands upon a small number of decisions finding patent claims eligible and ignores the far more numerous decisions in which courts have rejected claims as ineligible for patent protection. It distorts the law and will encourage examiners to grant invalid, abstract patents. Such patents wrongly claim basic ideas, increase litigation costs to no benefit, and harm the public interest.

The USPTO's role is not to narrow Supreme Court holdings, it is to apply them. Please abandon revisions to the Patent Subject Matter Eligibility Guidance.

Thanks,  
J. Weber