



American Intellectual Property Law Association

August 13, 2018

The Honorable Andre Iancu
Under Secretary of Commerce for Intellectual Property and
Director of U.S. Patent and Trademark Office
U.S. Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314
Attn: *Carolyn Kosowski, Senior Legal Advisor,*
Via email: eligibility2018@uspto.gov

Re: AIPLA Comments on Determining Whether a Claim Element Is Well-Understood, Routine, Conventional for Purposes of Subject Matter Eligibility [Docket No.: PTO-P-2018-0033]

Dear Under Secretary Iancu:

The American Intellectual Property Law Association (AIPLA) is pleased to have this opportunity to present its views on the Memorandum from Robert W. Bahr to the Patent Examining Corps dated April 19, 2018 and entitled Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*) (hereinafter “the Memorandum”). Written comments were requested in a Federal Register Notice titled “Request for Comments on Determining Whether a Claim Element Is Well-Understood, Routine, Conventional for Purposes of Subject Matter Eligibility,” dated April 20, 2018, 83 Fed. Reg. 17536.

The American Intellectual Property Law Association is a national bar association of approximately 13,500 members who are primarily lawyers engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public’s interest in healthy competition, reasonable costs, and basic fairness. AIPLA provides these comments and suggestions, regarding the Memorandum.

A. General Comments.

AIPLA applauds the Office for publishing the Memorandum to promote uniform application of the guidance provided by the Federal Circuit in *Berkheimer v. HP Inc.* While we find the Memorandum to be helpful, we have a few suggestions on how it might be improved.

First, AIPLA is concerned about two phrases used throughout the Memorandum. These phrases are “additional elements” and “whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity.” In particular, AIPLA is concerned that the use of the word “additional” in “additional elements” indicates that some elements of a claim may be analyzed independently of the other elements. This usage may confuse examiners and is contrary to the guidance provided in MPEP 2106(II) that the claim must be analyzed “as a whole.” As stated in *Alice*, after determining that a claim is directed to a patent-ineligible concept, “we then ask, ‘[w]hat else is there in the claims before us?’ To answer that question, we consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent eligible application.” (134 S. Ct. 2347, 2355 (2014), citations omitted).

AIPLA suggests dropping the word “additional” in all uses of this phrase. The objection to the second phrase is similar to the objection to the first phrase. We believe that instructing the examiners to determine “whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity” will invite them to incorrectly analyze the claim in a piecemeal manner. In particular, we believe the use of the word “or” may be misinterpreted to allow the examiner to reject the claim as non-patent-eligible if it includes a single conventional recitation. We suggest that this phrase be replaced by language that instructs the examiner to determine whether all elements of a claim, both alone and in combination, are well-understood, routine, and conventional.

B. Section I Summary of *Berkheimer v. HP, Inc.*

AIPLA has only one issue with respect to section I of the Memorandum. This concerns the use of the phrase “well-understood, routine, conventional.” As noted in section I, the language used in the decision includes the connecting word “and” furthermore, the uses in the Memorandum fail to limit the finding to “as of the effective filing date of the claimed invention” for AIA applications and “when the invention was made” for pre-AIA applications. The phrase as it is used in the Memorandum, however, does not include the word “and,” allowing the examiner to believe that a broader standard may be applied to find that a particular claim term is “well-understood, routine, or conventional.” The Office in fact does use the erroneous “or” language later at section III A. 1. of the Memorandum. We urge the Office to revise the Memorandum to use the language from the decision. Furthermore, Memorandum should be revised to indicate that the determination of whether each claim element and the combination of claim elements is well-understood, routine and conventional should be at the time the application was filed or at the time the invention was made.

C. Section II Well-Understood, Routine [and] Conventional Activity.

AIPLA agrees with the substance of section II of the Memorandum but is concerned with the mention of 35 U.S.C. § 112(a). Although the language in the Memorandum is clear that this reference only applies to consideration of “whether an element is so well-known that it need not be described in detail in the patent specification,” we believe that the examiners may confuse the eligibility analysis with an analysis of whether the claim meets the enablement

and written description requirements. We suggest removing the specific reference to section 112(a).

D. Section III Impact on Examination Procedure

AIPLA notes that the word “combination” occurs only once in section III of the Memorandum, in the heading of subsection A. In view of the confusing use of the phrase “or combination of elements” described above, we recommend that this entire section be revised to make it clear that the formulation of a rejection must consider all of the claim elements. Furthermore, we note that Section III repeatedly uses the phrase “nature of the additional element(s).” This phrase is not used in the *Berkheimer* decision and may lead the examiner to impermissibly abstract a particular claim element so that it covers a broader class of elements. While, as described above, the word “nature” is used in *Alice*, it is used as “nature of the claim” not “nature of the additional element(s).” We recommend that all references to the “nature” of claim element(s) be removed. As a general principle, if there is no statutory, regulatory, or adjudicatory basis for any word or phrase, the notice provision is beyond its authority.

a. Formulating Rejections

Subsection A includes four sub-subsections. We will address each of these in turn.

- 1. Express Statements.** An applicant may describe a particular claim element as being “well-known,” or “conventional.” We expect such statements, however, will be directed to individual elements rather than to the combination of all of the claim elements which is in scope of the purpose of the notice. Examiners should carefully consider and explain which claim elements they believe the express statement covers.
- 2. Citation to a Court Decision.** This section allows an examiner to determine that a particular claim element is well-known, routine, and conventional when it conforms to one or more of the court decisions discussed in MPEP § 2106.05(d)(II)...” That MPEP section has three lists of well-known, routine, and conventional activities containing a total of 21 entries. Each entry starts off with a phrase identifying the purported well-known, routine, and conventional activity followed by a case citation. Again, AIPLA is concerned that the examiner may use these cases as an excuse to impermissibly generalize a particular claim element. We caution the Office to require examiners to make specific fact findings to support any analogy to the identity of the element in question relative to the corresponding element in the cited cases. Furthermore, to the extent that there really is factual analogy, we would expect the prior case to have involved references or other evidence that the activity is well-known, routine, and conventional. The Memorandum should be revised to require the examiners to consider such evidence directly when relying on a particular case.
- 3. Citation to a Publication.** The Memorandum correctly identifies several distinctions between 35 USC §102 “printed publications” and a publication that

may be considered evidence of activity that is well-known, routine, and conventional. Examiners should be encouraged, if not required, to make specific factfinding regarding such publication and provide specific reasoning as to why the cited publication is more than mere section 102 prior art. It is routine in § 103 practice for examiners to make conclusory assertions that a reference shows a well-known feature. It would be detrimental if this practice were translated to section 101 determinations because the possibilities for and consequences of abuse of such statements are even more significant as the nature of the test begins first with eligibility before progressing to novelty or unobviousness determinations.

- 4. Official Notice.** AIPLA has several concerns with this section. One concern involves the potential for abuse of official notice as a convenience to make a conclusory finding when an examiner cannot find actual evidence. As stated in the Memorandum, when such a statement is contested, the examiner must provide support based on one of the preceding sections of the Memorandum. AIPLA believes that official notice should be used only sparingly and only for material that would be well-understood as being well-known, routine, and conventional. We believe that the standard asserted in the Memorandum for examiners to take official notice is too broad.

Another concern relates to the assertion of official notice in a final office action. We recommend that examiners not be allowed to assert official notice for the first time in a final office action because, when an applicant contests the official notice in a response to the final office action, there will be no opportunity for examiners to provide the required evidence supporting the official notice or for the applicant to rebut the proffered evidence.

We note that both of these problems could be ameliorated by requiring the examiner to support, in detail, an assertion of official notice when the assertion is made. Specifically, in most cases, the examiner should articulate their claim interpretation and provide a description of any finding of officially noticed well-understood, routine, and conventional activity with at least general support for the finding of fact, so that the applicant has substance to which they can reasonably respond. This point is equally important to the applicant who is seeking a patent grant and to the public which is reacting to the patent grant. The record is made more substantial when the fact-finding is not conclusory.

AIPLA recommends that the memorandum be revised to state that official notice should be taken sparingly and only for material that the skilled person would understand as well-known, routine and conventional. In addition, we recommend that official notice should not be allowed if taken for the first time in a final official action.

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b. Evaluating Applicant's Response

As noted above, AIPLA believes that the applicant should be allowed to respond to an examiner who provides sufficiently detailed support for taking official notice without the constraints of finality.

CONCLUSION

AIPLA appreciates the effort by the USPTO to ensure that the guidance provided by the Federal Circuit in *Berkheimer v. HP, Inc.* is applied correctly and uniformly by the patent examining corps. These comments have been provided in the spirit of making these adjustments meet the goals announced by the USPTO in a way that is compatible with the needs of our members. Thank you for allowing AIPLA the opportunity to provide comments on the Memorandum.

Sincerely,



Myra H. McCormack
President
American Intellectual Property Law Association