



THE BOSTON PATENT LAW ASSOCIATION

PRESIDENT

Rory P. Pheiffer
Nutter McClennen & Fish LLP
Seaport West
155 Seaport Boulevard
Boston, MA 02210-2604
Phone: (617) 439-2879
Email: rpp@nutter.com

August 20, 2018

PRESIDENT - ELECT

Deirdre E. Sanders
Hamilton, Brook, Smith
& Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, MA 01742-9133
Phone: (978) 341-0036
Email: deirdre.sanders@hbsr.com

Via E-Mail: Eligibility2018@uspto.gov
Office of Patent Legal Administration
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

VICE PRESIDENT

Michael Bergman
Bergman & Song LLP
10 Bower Street
Medford, MA 02155-3655
PO Box 400198
Cambridge, MA 02140-0002
Phone: (781) 648-8870
Email: mbergman@bergmansong.com

Re: Comments on Changes in Examination Procedure Pertaining to
Subject Matter Eligibility, in response to requests for comments at
83 Fed. Reg. 17536 (April 20, 2018)

TREASURER

Daniel W. Young
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206
Phone: (617) 646-8245
Email: daniel.young@wolfgreenfield.com

Dear Sir:

SECRETARY

Keith Toms
McCarter & English, LLP
265 Franklin Street
Boston, MA 02210-2206
Phone: (617) 449-6591
Email: ktoms@mccarter.com

The Boston Patent Law Association (“BPLA”) thanks the United States Patent and Trademark Office (“USPTO”) for the opportunity to comment on the USPTO’s Memorandum regarding Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*) (April 19, 2018) (“the Memorandum”). The BPLA is an association of intellectual property professionals, providing educational programs and a forum for the exchange of ideas and information concerning patent, trademark, and copyright laws in the First Circuit, focusing on the greater Boston area. These comments were prepared with the assistance of the Patent Office Practice Committee of the BPLA. The BPLA submits these comments solely as its consensus view. They are not necessarily the views of any individual member, any firm, or any client.

PAST PRESIDENT

Monica Grewal
Wilmer Cutler Pickering
Hale & Dorr, LLP
60 State Street
Boston, MA 02109
Phone: (617) 526-6223
Email: monica.grewal@wilmerhale.com

BOARD OF GOVERNORS

Joshua M. Dalton
Morgan, Lewis & Bockius LLP
One Federal Street
Boston, MA 02110-1726
Phone: (617) 951-8284
Email: josh.dalton@morganlewis.com

Rachel L. Emsley
Finnegan, Henderson, Farabow,
Garrett & Dunner LLP
Two Seaport Lane
Boston, MA 02110-2001
Phone: (617) 646.1624
Email: rachel.emsley@finnegan.com

Rebecca M. McNeill
McNeill Baur, PLLC
125 Cambridge Park Drive, Suite 301
Cambridge, MA 02140
Phone: (617) 489-0002
Email: rebecca.mcneill@mcneillbaur.com

The BPLA thanks the USPTO for its efforts to provide guidance to clarify how the USPTO will determine subject matter eligibility in accordance with prevailing jurisprudence. The BPLA supports the changes in examination procedure pertaining to subject matter eligibility based on the recent *Berkheimer* decision, as set forth in the Memorandum. The BPLA believes that the guidance in the Memorandum will help both examiners and applicants navigate the factual analysis regarding whether certain claim limitations represent well-understood, routine, or conventional activity. While future case law will further demarcate the bounds of what is or is not well-understood, routine, or conventional, the



THE BOSTON PATENT LAW ASSOCIATION

Memorandum's description of four categories of evidence an examiner can use to show that an additional element is well-understood, routine, or conventional provides a helpful framework for the analysis under step 2B of the USPTO's subject matter eligibility test. This framework will help examiners better articulate a finding that additional claim limitations do or do not add significantly more than a recited judicial exception, and will also help applicants to better respond to such findings. We offer these comments on the Memorandum to assist the USPTO in its efforts to implement the proposed changes.¹

I. The BPLA agrees with the portion of Paragraph 1 of the Memorandum that requires more than a finding that the specification is silent about an additional element to establish that the additional element is well-understood, routine, and conventional

Section III(A), Paragraph 1 of the Memorandum states that an examiner can cite the specification to demonstrate that an additional element is well-understood, routine, and conventional if the specification describes the additional element in a manner that indicates that it is sufficiently well-known that the particulars of the additional element need not be described to satisfy 35 U.S.C. § 112(a). The Memorandum states, however, that the examiner cannot base a finding that an additional element is well-understood, routine, and conventional *only* on the fact that the specification is silent with respect to describing such an element. The BPLA agrees with the portion of the guidance that requires more than a finding that the specification is silent about an additional element to establish that the additional element is well-understood, routine, and conventional.

II. The BPLA believes that Paragraph 2 of the Memorandum should reiterate the requirement to consider the new elements in combination and the claim as a whole

Section III(A), Paragraph 2 of the Memorandum states that an examiner can cite to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s). The BPLA believes, however, that Paragraph 2 of the Memorandum should reiterate the requirements to consider the new elements in combination, and the claim as a whole. The Memorandum states that it “revises the procedures set forth in MPEP § 2106.07(a) (Formulating a Rejection For Lack of Subject Matter Eligibility) and MPEP § 2106.07(b) (Evaluating Applicant's Response).”² Both Sections 2106.07(a) and (b), which the Memorandum is intended to revise, state the examiner must consider the new elements in combination, and the claim as a whole. In particular, Section 2106.07(a) states that “[a]fter determining what the applicant invented and establishing the broadest reasonable interpretation of the claimed invention (see MPEP § 2111), the eligibility of

¹ The BPLA's comments are focused solely on the substance of the Memorandum, and are made separate and apart from any position the BPLA has, or may have, with respect to any possible amendments to 35 U.S.C. § 101 regarding subject matter eligibility.

² Memorandum at p. 3, Section III



THE BOSTON PATENT LAW ASSOCIATION

each claim should be evaluated *as a whole* using the analysis detailed in MPEP § 2106.” (Emphasis added.) Similarly, Section 2106.07(b) states that:

[E]ven if an element does not amount to significantly more on its own (e.g., because it is merely a generic computer component performing generic computer functions), it can still amount to significantly more when considered *in combination* with the other elements of the claim. For example, generic computer components that individually perform merely generic computer functions (e.g., a CPU that performs mathematical calculations or a clock that produces time data) in some instances are able *in combination* to perform functions that are not generic computer functions and therefore amount to significantly more than an abstract idea (and are thus eligible). (Emphasis added.)

The language in the Memorandum, however, does not make clear that the examiner must consider the new elements in combination, and the claim as a whole. Regarding analyzing claim elements in combination, Section III of the Memorandum merely states that “[i]n a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following:...”³ Section III of the Memorandum does not discuss the requirement to consider claims as a whole.

Noting that the guidance in the Memorandum is meant to revise Sections 2106.07(a) and (b) of the MPEP, the BPLA assumes that the USPTO intended for the new guidance to continue requiring examiners to consider claims as a whole, rather than on an element-by-element basis. Therefore, the BPLA believes that Paragraph 2 of the Memorandum should reiterate the requirement to consider the new elements in combination, and the claim as a whole.

III. The BPLA agrees with the portion of Paragraph 3 of the Memorandum that states that an examiner must show more than the disclosure of the additional element in a single prior art reference to establish that it is well-understood, routine, or conventional

Section III(A), Paragraph 3 of the Memorandum states that a citation to a publication can demonstrate the well-understood, routine, and conventional nature of the additional element(s). The Memorandum states, however, that under existing jurisprudence, finding that an additional element is well-understood, routine, or conventional requires more than showing the additional element in a single prior art reference. The BPLA understands that further demarcation of what constitutes conventional activity will require future case law. Nevertheless, we agree with the USPTO’s guidance that an examiner must show more than the disclosure of the additional element in a single prior art reference to establish that it is well-understood, routine, or conventional.

³ Memorandum at p. 3, Section III(A)



THE BOSTON PATENT LAW ASSOCIATION

IV. The BPLA agrees with the portion of Paragraph 4 of the Memorandum that restricts the use of judicial notice to limited circumstances

Section III(A), Paragraph 4 of the Memorandum states that an examiner can take official notice that an additional element is well-understood, routine, and conventional. The Memorandum states, however, that:

This option should be used *only* when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a).

Furthermore, the Memorandum states in Section III(B) that:

If the examiner has taken official notice per paragraph (4) of section (III)(A) above that an element(s) is well-understood, routine, conventional activity, and the applicant challenges the examiner's position, specifically stating that such element(s) is not well-understood, routine, conventional activity, the examiner must then provide one of the items discussed in paragraphs (1) through (3) of section (III)(A) above, or an affidavit or declaration under 37 CFR 1.104(d)(2) setting forth specific factual statements and explanation to support his or her position.

The Memorandum thus makes clear that an examiner should take official notice under only limited circumstances and, if challenged, must substantiate the assertion with either evidence or a sworn statement. Finally, the Memorandum refers examiners to the procedures set forth in MPEP § 2144.03, which includes the MPEP's existing guidance for taking official notice.

The BPLA recognizes that the MPEP has previously permitted examiners to take official notice in the context of determinations of anticipation and obviousness; thus examiners have experience applying official notice, and the USPTO has experience evaluating such cases. While a possibility exists that an examiner may attempt to invoke official notice improperly, in the experience of our membership, these situations have been rare. The BPLA therefore believes that the Memorandum has set forth adequate guidance and procedures to ensure that examiners apply official notice properly, and safeguards to ensure applicants have recourse against an improper application of official notice. The BPLA believes that the Memorandum will effectively guide examiners to apply official notice only in appropriate circumstances, while protecting applicants from any improper applications.



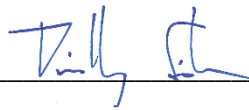
THE BOSTON PATENT LAW ASSOCIATION

Conclusion

The BPLA appreciates the opportunity to comment on the Memorandum, and thanks the USPTO for considering these comments. The BPLA would be delighted to participate in any further discussions and/or decision-making on these issues, or other issues related to patent examination, and encourages the USPTO to contact the BPLA to participate.

Sincerely,

Boston Patent Law Association

By: 

BPLA Patent Office Practice Committee Co-Chairs
Timothy V. Fisher
Nicole A. Palmer
Jonathan B. Roses