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Via Electronic Mail
Eligibility2018@uspto.gov

Attention: Carolyn Kosowski, Senior Legal Advisor,
Matthew Sked, Senior Legal Advisor,
Office of Patent Legal Administration

IBM Corporation Comments in Response to "Request for Comments On Determining Whether a Claim Element is Well-Understood, Routine, Conventional for Purposes of Subject Matter Eligibility", 83 Fed. Reg. 17536 (April 20, 2018)

IBM thanks the United States Patent and Trademark Office ("Office") for the opportunity to provide comments on the Office's subject matter eligibility guidance provided in the *Berkheimer* memorandum ("the memo"). Patent-eligibility under 35 U.S.C. § 101 continues to be an issue of paramount importance to IBM as an innovator and patentee in the field of information technology.

We commend the Office for its prompt attention to recent subject matter eligibility case law developments. Although unable to ensure clarity in all facets of patent-eligibility under recent problematic Supreme Court case law, IBM appreciates the Office's progress toward establishing clearer guidance regarding the evidentiary requirements for the "significantly more" step in accordance with the prevailing jurisprudence. IBM believes that this guidance will lead to more meaningful rejections, supported by evidence, and a more uniform approach to examination for eligibility. We expect that such rejections will improve notice to applicants and afford applicants a better ability to respond to office actions, resulting in more constructive and compact prosecution.

While IBM agrees generally with the spirit of the *Berkheimer* memorandum, our comments respectfully request additional clarity and urge the Office to exercise caution.

At the onset, we emphasize that the elements of a claim must be considered individually **and** in combination when determining if they are well-understood, routine, conventional. Throughout the memo, and particularly in Section III A, references are made to "an element" or "additional element(s)" and the requirement to demonstrate that the element(s) are well-understood, routine, conventional when formulating a rejection. We assert that the fact that an individual element is well-understood, routine, conventional, does not necessarily mean that all the elements combined within a claim are well-understood, routine conventional, and thus, ineligible under 35 U.S.C. § 101.

Further, the memo implies that analysis as to whether an element is well-known, routine, conventional is the same as the analysis under 35 U.S.C. § 112(a) to determine whether an element is so well-known that it need not be described in detail in the patent specification. We assert that the analysis for compliance with the enablement and written description requirements under 35 U.S.C. § 112(a) is very different from the analysis of whether an element or combination of elements are well-understood, routine, conventional for purposes of 35 U.S.C. § 101. We caution that entwining an unnecessary and distinct statutory requirement with the analysis required in 35 U.S.C. § 101 may introduce confusion, rather than provide the clarification that this memo seeks to offer.

Section III of the memo instructs that an Examiner should not find that an additional claim element (or combination of claim elements) is well-understood, routine, conventional in a step 2B analysis unless the Examiner finds and expressly supports the rejection with evidence from one of four delineated categories. We provide our comments and ask for additional clarity in three of those four categories.

Citation to an Express Statement in the Specification or During Prosecution

IBM understands from the memo that a mere disclosure of the additional elements would not satisfy this evidentiary category, but rather that the Applicant must specify that the additional elements are well-known, routine, conventional. However, the memo further describes that a "specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional elements...as a commercially available product." IBM and other Applicants may describe in the specification the product space in which the invention may be implemented to provide context for the invention. These descriptions often include current or planned commercially available products or services in which the additional elements **are to be** implemented. Further, it is common for an invention to be embodied in a commercially available product, while being totally obscured and impossible to reverse engineer. It would be wholly inappropriate for the Office to conclude in those situations that the additional elements are well-known, routine, conventional.

We caution that the Office should not interpret mere mention of a commercially available product within the specification, or a description within the specification that an element will be implemented in a commercially available product or service, as a showing that the element is well-understood, routine, conventional. IBM recommends that the Office provide further guidance and examples regarding interpretation and application of applicant's statements, and particularly statements concerning commercially available products, in support of a 35 U.S.C. § 101 rejection.

Citation to Court Decisions

IBM notes, with great appreciation, that the Office limited the citations only to court decisions that are found in MPEP § 2106.05(d)(II). However, we fear that these examples may not provide needed certainty regarding what would be considered well-understood, conventional, routine without additional context.

Many of these case law examples are described in terms that are so broad in scope that they encompass entire fields of technology. We remind the Office that the analysis required in 35 U.S.C. § 101 is specific to each application and the elements of a claim must be considered individually **and** in combination when determining if they are well-understood, routine, conventional.

IBM requests that the Office provide further guidance to Examiners when citing from this evidentiary category. The guidance should be explicit that simply mentioning one of the ten cases that is discussed in MPEP § 2106.05(d)(II) does not meet the evidentiary burden. Rather, the cited case must also describe the same additional element or elements as well-understood, routine, conventional. And still further, the guidance should emphasize that although an individual element may be well-understood, routine, conventional, it does not necessarily follow that all the elements combined within the claim are well-understood, routine conventional, and thus, ineligible under 35 U.S.C. § 101.

Citation to a Publication

We thank the Office for unambiguously setting forth that merely finding the additional element in a single published document is not sufficient to demonstrate that the additional element is well-understood, routine, conventional. Rather, the memo clearly specifies the nature of the publication and the description of the additional elements in the publication need to demonstrate that the additional elements are widely prevalent or in common use in the relevant field.

We continue to urge the Office to reaffirm the principles of compact prosecution to maintain proper focus for all patentability inquiries. While the determination of whether something is disclosed in a document under 35 U.S.C. § 102 is a distinct inquiry from whether something is well-known, routine, conventional activity, they are also inextricably linked. It is impossible to evaluate the "significantly more" aspects in step 2B without also considering 35 U.S.C. §§ 102 and 103. For that reason, we would anticipate that any rejection that includes a rejection under 35 U.S.C. § 101 would also include a rejection under 35 U.S.C. §§ 102 and/or 103. IBM requests the Office to provide clear guidance to distinguish these inquiries and instruct Examiners how they can be performed in the context of compact prosecution.

Conclusion

IBM appreciates the opportunity to comment on the patent eligibility guidance in the Berkheimer memorandum. We thank the Office for its continuing efforts to improve eligibility guidance for examiners and the public. The Office's continuing collaboration with the public and attention to feedback is critical in developing workable subject matter eligibility guidelines.

Respectfully submitted,

Manny W. Schechter
Chief Patent Counsel
Intellectual Property Law
IBM Corporation
schechter@us.ibm.com
Voice: 914-765-4260

Jennifer M. Anda
Consulting Patent Agent
Intellectual Property Law
IBM Corporation
jmanda@us.ibm.com
Voice: 520-799-2485