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**From:** info@strategies.fi <info@strategies.fi>

**Sent:** Monday, February 4, 2019 10:15 AM

**To:** West, Jeffrey <Jeffrey.West@USPTO.GOV>; Haines, Nicole D. <Nicole.Haines@USPTO.GOV>

**Subject:** the Technology Center 2019 Revised Patent Subject Matter Eligibility Guidance

Dear Ms. Nicole D. Haines, Senior Legal Advisor, and Mr. Jeffrey R. West, Senior Senior Legal Advisor  
I send you a mail previously.

I have a further question with regards to the new guidance. As per guidance when the examiner has first tried the invention for a machine other and if not moved on to the 2A.

Here the examiner goes through 1-5 points to see if the invention fits. Is it a requirement that the examiner should site her reasoning with regards to points 1-5?

If not stopped here then the examiner continues to 2B and tries for invention. Should she state some reasoning here?

Finally, after 2B if the examiner has found nothing she can “the examiner should bring the application to the attention of the Technology Center Director.”

36)In accordance with existing guidance, **an examiner’s conclusion that an additional element (or combination of elements) is well understood, routine, conventional** activity must be supported with a **factual determination**. For more information concerning evaluation of well-understood, routine, conventional activity, see MPEP 2106.05(d), as modified by the USPTO Berkheimer Memorandum.

routine and **conventional in the field**

Specifically, the Federal Circuit held that "[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination

As set forth in MPEP § 2106.05(d)(I), an examiner should conclude that an element (or combination of elements) represents well-understood, routine, conventional activity only when the examiner can readily conclude that the element(s) is widely prevalent or in **common use in the relevant industry**.

This means in other words that the invention is not an improvement or different to prior art and additionally, the current workings in the relevant field are doing or practicing the same thing?

Further, so in order for the examiner to arrive here she should state, write in the reply, and compare the invention to the prior art and relevant field today or at the time of filing?

In order to pass the 2 B and even become eligible for the technology director.

Is this the correct interpretation of the steps in the new guidance?

Specifically is interesting the written requirement to discuss and elaborate the invention at the different points and finally at 2B. What is the utility, what elements produce the utility and how is the utility and elements different to prior art and current workings in the field. It can be quite beneficial to write down and compare the products of different solutions in order to find clarity.

I think the steps are good because they specifically lift up certain points to focus and discuss so as not to aim "too widely".

Can you comment on this?

Specifically the elaboration and example seems beneficial in this context.

Thanks

Reg Mr. Bremer

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**From:** [info@strategies.fi](mailto:info@strategies.fi)

**Sent:** 27 January 2019 13:49

eligibility2019comments\_f\_Bremer\_2019jan27

**Subject:** 2019 Revised Patent Subject Matter Eligibility Guidance

Dear USPTO

And Ms. Nicole D. Haines, Senior Legal Advisor, and Mr. Jeffrey R. West, Senior Senior Legal Advisor  
2019 Revised Patent Subject Matter Eligibility Guidance

Concerning applications filed with the USPTO before 7.1.2019 and active. Falling under the new guideline.

In an office reply made before the 7.1.2019 where a 101 rejection has been made. Where the application is in a non-final or a final action. It is impossible for the applicant to address all adverse determines made by the examiner.

When the applicant is replying to such an action or considering the next action that action is not based or up to date with the new guidelines put in place by the USPTO.

As the applicant in her next action or reply must address all adverse determines made by the examiner regardless of whether the 101 is correct or not correct. The applicant cannot perform this as the examiner reply is not based on the guideline. Replying to arguments based on old guidelines is thus not correct.

In the next action the examiner can enter a decision based upon the new guidelines resulting in a final action or another decision. This would be incorrect as the applicant has not been able to reply or maybe unable to reply if a final action is entered.

A new examination should be made where the examiner provides a reply based upon the new guidelines which then can be properly addresses by the applicant. This examination should be made

as an extra examination not affecting the current state of the application. Especially as this change, albeit a good one, is due to USPTO action.

In a third case an office reply may not mention 101 at all or a 101 case may have been removed. In the next step a 101 rejection could be entered based upon the new guideline. At this stage the action may be non-final, but it may also be final making a reply difficult.

All these actions may result in more costs or in the worst case a final action without proper chance for argumentation by the applicant.

The bottom line is that it is impossible to address arguments that are not present or that should be present. And actions that may have not been entered at all under the new guidelines. This can result in considerable financial or other expense.

The USPTO should provide for a reexamination or an extra step in examination procedure that creates allowance for this new guideline.?

Mr. Bremer

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