

July 17, 2014

The Honorable Margaret Focarino
Commissioner for Patents
United States Patent and Trademark Office
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Comments on Preliminary Examination Instructions in view of the Supreme Court Decision in *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.* [Fed. Reg. Vol. 79, No. 125 (June 30, 2014)]

In response to the PTO's request for public comments on its Preliminary Instructions to examiners on applying section 101, SAS Institute Inc. submits the following comments.

First, we encourage the PTO to collect and publicly post information related to its examination of applications directed to computer-implemented inventions. While this information is already available on PAIR, that format does not allow for easy searching, browsing, or review. For applications based on computer-implemented inventions, the PTO should post, in a single location, the claims it allows, the claims it rejects under section 101, and most importantly, the claims it allows following a rejection under section 101. This information will enable the public to ascertain how the PTO treats different kinds of inventions as well as different claim types, and would also permit the public to ascertain how other applicants have successfully overcome rejections under section 101. If it is infeasible to post this information for all computer-implemented inventions (excluding, of course, any applications not published at all), then the PTO should do so for representative cases.

Second, while the Preliminary Instructions instruct the examiners about the process for decision making (e.g., when to "proceed to step 2" or when a "claim should be rejected under 35 U.S.C. § 101") they should also direct examiners to explain their actions. While MPEP 707.07 already requires examiners to clearly articulate the reasoning behind rejections, the PTO should supplement its Preliminary Instructions to explicitly require examiners to fully explain rejections under section §101, including (1) what they have identified as an "abstract idea" and (2) why the additional limitations do not make the claim patent eligible. A written explanation of the examiners' positions can enable an applicant to better understand the reasons supporting the rejection and to appropriately respond to that rejection.

Third, the two step process outlined in the Preliminary Instructions focuses on the second step while the first step appears meaningless. As written, the test in Part 1 is *always* satisfied regardless of the claim because, as the Instructions state, “all inventions embody, use, reflect, rest upon or apply abstract ideas....” If all inventions include abstract ideas, then there is no reason to perform a test at all in step 1 because it will always be true that “an abstract idea is present in the claim.” If this is indeed the PTO’s position, then it should eliminate step 1, treat every claim as including abstract ideas, and require the examiners to clearly and explicitly identify those abstract ideas to the applicant. If not, then it should make step one a meaningful test and clarify what kind of claim could possibly elicit a “no” answer at step 1.

We appreciate the opportunity to comment on this important matter.

Sincerely,



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