

From: Tom Isaacson [email redacted]
Sent: Wednesday, July 23, 2014 5:04 PM
To: myriad-mayo_2014
Subject: Comments on Alice Corp. Examination Instructions

Dear PTO:

I write to comment about the guidelines for handling Examination under Alice Corp. v. CLS Bank. The Supreme Court has put the PTO in a difficult position. I have reviewed the guidelines and they are almost impossible to apply in a coherent and predictable manner. I would suggest the following revised approach which would help bring the examination process back in line with predictability and more in line with well-known Section 101/102/103 principles.

The concept of whether a claim “includes” an abstract idea is impossible to apply. Even in the guidelines, it concedes this point - “All inventions embody, use, reflect, rest upon, or apply abstract ideas...” The problem with the analysis is that it enables one to pick one abstract idea out of larger claim. Rather, the abstract idea should be directed to the claim itself. Here is an abstract claim:

1. A concept comprising the color blue.

The problem with the guidelines (and Alice v. CLS) is that it conflates abstract ideas with prior art issues. An abstract idea that is a “fundamental economic practice” is merely a prior art issue, not an abstractness issue. If there is a fundamental economic practice, it could be embodied in this kind of claim:

1. A method comprising:
performing, via a processor, a fundamental economic practice.

This is not a section 101 issue as the claim recites a processor, and thus a machine and is not an abstract idea. The examiner would simply then find prior art under section 102 to establish with evidence that the “fundamental economic practice” is known.

Part 1 of the guidelines could be improved by striving to work the analysis back to the basic 101/102/103 analysis that would work just as well and not cause such disruption to the examination of claimed inventions.

Part 2 is also problematic in that it essentially asks whether there is a claim element that is not obvious over the prior art. For example, asking whether the limitation is “significantly more” involves no more than the computer performing functions that are “well-understood, routine and conventional activities previously known to the industry” is just a simply prior art question. If it is well-known, then cite the prior art and explain in the normal manner that it is well known as is evidenced by reference X. To even analyze this prong, the Examiner must look at the prior industry practice through searching prior art. Otherwise, how would one know if the limitation was “previously known?”

The definition of abstract is “existing in thought or as an idea but not having a physical or concrete existence.” These guidelines greatly expand the concept to simply include prior art concepts such as whether the concept recited in the claim is a fundamental economic practice or whether it is previously known in the industry.

I would urge guidelines that follow this basic pattern, in view of Alice:

Part 1: Study the entire scope of the claim and if the claim does not recite any machine or article or is a method that is practice in an abstract way such that the entire scope of the claim can “exist in thought or as an idea but does not have a physical or concrete existence”. If the entire scope of abstract, the reject under Section 101. Ideas unto themselves, pure mathematical formulae could be rejected under this prong. Provide example claims like I have done above.

Part 2: Assuming that a physical embodiment of the claim exists and it is not abstract, consider whether the claim covers a fundamental economic practice by searching the prior art (how else will an examiner determine this?). Ask whether the claim recites a feature that is an improvement to another technology or field, or improves the functioning of the computer itself. Determining if the claim recites features which are “well-understood, routine and conventional activities previously known to the industry” by doing a prior art search to ascertain what the previous industry process was. The Examiner will be required to provide citations to any “well known” practice or activity in rejecting the claims under this part.

If such simpler and more coherent guidelines cannot be established, rather than implementing the proposed guidelines as is, I suggest seeking Congressional help to correct the analysis. I do worry that the guidelines are so vague that they can ultimately violate the constitution in that they can prevent an inventor from securing exclusive rights to their discoveries, merely because it is a discovery or invention related to a financial service.

Best regards,

Tom

Thomas M. Isaacson

Partner | Novak Druce Connolly Bove + Quigg LLP

2810 Laurian Lane | Second Floor | Dunkirk, Maryland 20754

t: 410.286.9409 | f: 410.510.1433 | e: [REDACTED] | w: www.novakdruce.com