

From: Bill Kramer <mailto:redacted>
Sent: Thursday, July 31, 2014 8:48 PM
To: alice_2014
Subject:Comments

Email to:alice_2014@uspto.gov

RE: June 25, 2014 "Preliminary Examination Instructions in view of the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank International , et al

Comments:

1. Prima facie conclusion of patent-eligibility

The two-part test proposed by the June 25, 2014 "Preliminary Examination Instructions in view of the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank International , et al (hereinafter "Office's guideline"), should be implemented as a prima facie element of patent-eligibility in a final guideline. As the prima facie conclusion of obviousness in MPEP 2142, a prima facie conclusion of patent-eligibility is "a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See also MPEP 2142. While Alice does not explicitly allocate the burden of production of evidence, the Court is explicit in identify what the "abstract idea" is throughout the Alice opinion. The Court's approach in identifying the exact "abstract idea" is also consistent in Mayo and Bilski.

Failure to assign the initial burden to the examiner to identify the "abstract idea" would render the subsequent "significant more" part of the analysis meaningless. As Alice Court and the Office recognize, "[a]t some level, "all inventions ... embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas," (Alice, at 2354, citing Mayo, 132 S.Ct., at 1293). Without knowing the nature of the abstract idea, what would be the context of "significant more"? Of course, this is not to suggest that the Office needs to define the breadth of the category of "abstract idea" based on case law, as indicated in Alice at 2357 (stating: "In any event, we need not labor to delimit the precise contours of the "abstract ideas" category in this case. It is enough to recognize that there is no meaningful distinction between the concept of risk hedging in Bilski and the concept of intermediated settlement at issue here. Both are squarely within the realm of "abstract ideas" as we have used that term"). However, even without defining it, the Court nevertheless identifies in both Bilski and Alice what the abstract idea entails in each case.

Hence, it is respectfully submitted that a reasonable reading of Alice would require the Office to identify the nature of the abstract idea as the initial burden if such rejection is warranted. A mere declaration of "abstract idea" in a 35 U.S.C. § 101 rejection of claims would not establish the prima facie conclusion of patent-eligibility.

2. Creating a 101 test in view of Supreme Court precedent

The Office should recognize the complexity of “abstract ideas” in the modern technological advancement. Many times, either in financial and computing technology, there is a combination of ideas and not a “pure initial idea”. The omnipresent application of “general purpose computer” is inevitable. However, the emphasis misses the point when aspects of the claims may be implemented using a “general purpose computer.”

There is no doubt that there are special purpose computers. However, if the recited claim elements can transform a general purpose computer to perform steps that are more efficient than having them performed in a special purpose computer, such transformation does not lie in the “abstract idea,” “significant more,” or “apply it” analysis. It is present in the recognition of the combination, correlation, or synergy of ideas that integrates the implementation in the general purpose computer and make such implementation possible and efficient. Therefore, patentable weight should be given for claims’ recognition of such combination, correlation, or synergy between ideas. This would be consistent with the Court’s instruction in Alice:

Thus, in applying the § 101 exception, this Court must distinguish patents that claim the “ ‘buildin[g] block[s]’ ” of human ingenuity, which are ineligible for patent protection, from those that integrate the building blocks into something more, see *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. —, —, 132 S.Ct. 1289, 1303, 182 L.Ed.2d 321, thereby “transform[ing]” them into a patent-eligible invention, *id.*, at —, 132 S.Ct., at 1294. Pp. 2354 – 2355 (emphasis added). *Alice*, at 2350.

Best regards,

William Kramer

Arthur Yuan

Reg. no. 46,229

Reg. no. 62,449

Email redacted

Email redacted

William J. Kramer

Partner

321 North Clark Street, Suite 2300 | Chicago, IL 60654

Direct Dial: 312.464.3350 | Fax: 312.276.8616 | Email: REDACTED

Los Angeles | New York | Chicago | Nashville | Washington, DC | Beijing | Hong Kong | www.loeb.com