In re:
Docket No.: PTO-P-2014-0036

For: Request for Comments and Extension of Comment Period on Examination Instruction and Guidance Pertaining to Patent-Eligible Subject Matter

Comments on the “Preliminary Examination Instructions in view of the Supreme Court Decision in Alice Corporation Pty. Ltd. v. CLS Bank International, et al.”

Via Internet to: alice_2014@uspto.gov

Mail Stop Comments – Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Margaret A. Focarino, Commissioner for Patents

Dear Commissioner:

In response to the Request for Comments and Extension of Comment Period on Examination Instruction and Guidance Pertaining to Patent-Eligible Subject Matter signed June 25, 2014, the undersigned respectfully submit the following comments.

General Comments

The Preliminary Examination Instructions state that “Alice Corp. neither creates a per se excluded category of subject matter, such as software or business methods, nor imposes any special requirements for eligibility of software or business methods.”¹ We agree. The focus of the Preliminary Examination Instructions is on “claims that involve abstract ideas” and the two-part analysis originally set forth in Mayo Collaborative Services v. Prometheus Laboratories, Inc., 566 U.S. _ (2012) (“Mayo”) and states that “inventions that integrate the building blocks of human ingenuity into something more by applying the abstract idea in a meaningful way are eligible.”² While we agree with this statement, we

¹ Preliminary Exam Instructions, p. 1, emphasis in original.
² Preliminary Exam Instructions, p. 2.
believe that *Alice Corp.* does not clearly define when an abstract idea is applied in a “meaningful” way. These comments are primarily directed to Part 2 of the two-part analysis.

Part 2 of the analysis states that “[i]f an abstract idea is present in the claim, determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to **significantly more** than the abstract idea itself.”\(^3\) The issue here is the meaning that is attached to the word “significantly,” which is commonly used with a fairly general understanding.\(^4\) The Preliminary Exam Instructions also state that “inventions that integrate the building blocks of human ingenuity into something more by applying the abstract idea in a **meaningful** way are eligible.”\(^5\) Again, the issue is the meaning that is attached to a commonly used term with a fairly general understanding.\(^6\) Unfortunately, neither of these terms, without more detailed examples, clearly assists one in determining whether a claim satisfies the analysis.

*Alice Corp.* contains three references to limitations that “may be enough to qualify as ‘significantly more’ when recited in a claim with an abstract idea.”\(^7\) However, only the third reference is directed to “meaningful” or “significantly.” That example is as follows:

- **Meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment**\(^8\)

However, *Alice Corp.* fails to provide any specific examples of what is a meaningful limitation in a particular technological environment.

**Claim Drafting Approaches that Likely Provide Meaningful Limitations with Abstract Ideas in a Particular Technological Environment**

The Office should provide specific guidelines to the Examiners, and to the patent community, on what type of limitations in a specific technological environment would be considered meaningful. For example, we believe the following three types of limitations would satisfy the “significantly more” requirement:

- When the technological environment is in the preamble of the claim and is also referenced in the body of the claim.

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\(^3\) Preliminary Exam Instructions, p. 3, emphasis in original.

\(^4\) Dictionary definitions fail to provide any real guidance, *e.g.*, Collins English Dictionary – 10th Ed. (2009) defines *significantly* as “important, notable, or momentous.”

\(^5\) Preliminary Exam Instructions, p. 2, emphasis added.

\(^6\) Collins English Dictionary – 10th Ed. (2009) defines “meaningful” as “having great meaning or validity” and something that is “eloquent” or “expressive.”

\(^7\) Preliminary Exam Instructions, p. 3, emphasis omitted.

\(^8\) Preliminary Exam Instructions, p. 3.
• The claim body contains multiple references to a limitation that is not linked to a specific technological environment.

• The claim contains the point of novelty with references to a technological environment where the technological environment is more specific than a broad field of use.

Specific Examples Are Needed

In addition to publishing guidelines for claim drafting, the Office should also provide specific examples of acceptable and unacceptable limitations. For example, the Preliminary Exam Instructions point to Alice Corp. in defining when a limitation is not enough to qualify as “significantly more” when that limitation “Requir[es] no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.”

We recommend that the Office publish example claims, in multiple subject areas, e.g., data processing, web applications, smart grid, etc., that indicate when a claim satisfies, and also when a claim does not satisfy, the “significantly more” component of the two-part analysis.

For example, it may be clear that a data processing based claim does not qualify as “significantly more” when it recites nothing more than an obvious abstract idea implemented on a generic computer such as:

1. A computer implemented method for summing numbers, comprising:
   adding, using a computer-based system, a first number and a second number; and
   displaying, using a computer-based system, the result of adding the first number and the second number.

However, in a claim involving a web application where the only possible implementation of a web-based application involves a computer, the following example should satisfy the “significantly more” test and therefore would be statutory:

9 Id.
1. A computer implemented method for execution of a web application, comprising:
   loading, using a computer-based system, a code module to perform a novel task and generate a result; and
   displaying, using a computer-based system, the novel result of the code module.

Conclusion

We believe that the Office, given the decision in Alice Corp., should provide specific
guidelines for the drafting of claims that would be considered patent-eligible and also
eamples of what the Office considers acceptable and unacceptable limitations.
Consideration of the above comments is respectfully requested.

Respectfully submitted,

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