

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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](mailto:alice_2014@uspto.gov)

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

Due: July 31, 2014

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.”<sup>1</sup> 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.”<sup>2</sup> While we agree with this statement, we

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<sup>1</sup> Preliminary Exam Instructions, p. 1, emphasis in original.

<sup>2</sup> 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.”<sup>3</sup> The issue here is the meaning that is attached to the word “significantly,” which is commonly used with a fairly general understanding.<sup>4</sup> 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.”<sup>5</sup> Again, the issue is the meaning that is attached to a commonly used term with a fairly general understanding.<sup>6</sup> 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.”<sup>7</sup> 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<sup>8</sup>

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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<sup>3</sup> Preliminary Exam Instructions, p. 3, emphasis in original.

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

<sup>5</sup> Preliminary Exam Instructions, p. 2, emphasis added.

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

<sup>7</sup> Preliminary Exam Instructions, p. 3, emphasis omitted.

<sup>8</sup> 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.”<sup>9</sup>

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:

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<sup>9</sup> 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 examples of what the Office considers acceptable and unacceptable limitations. Consideration of the above comments is respectfully requested.

Respectfully submitted,

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