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Subject: COMMENTS AND REMARKS TO Examination Instruction and Guidance Pertaining to Patent-Eligible Subject Matter

The U.S. Patent Office ("USPTO") issued a Fed. Reg. "Request for Comments...", to assist it in developing new examination guidelines for its Examining Corps to guide them in evaluating patent application claims for patent-eligible subject matter under 35 U.S.C. § 101. The following comments are made in view of the U.S. Supreme Court decision in *Alice Corp.* and the *Alice Corp.* preliminary instructions.

HISTORICAL CONTEXT TO THESE REMARKS

The *Alice Corp.* decision extended its two-step process for evaluation patent-eligible subject matter of patent claims directed to laws of nature, natural phenomena and abstract ideas of biotechnology patents to also include computer-implemented methods and systems.

Step 1: Is the patent claim directed to one of the three patent ineligible concepts of Laws of Nature, Natural Phenomena or an Abstract Idea, ("LNA")? If no, then the patent claim does not raise a § 101 issue. If yes, then step 2.

Step 2: If the claim is directed to a LNA, does the claim put meaningful limitations on the LNA and/or apply the LNA in a way that limits the LNA, e.g. does the patent claim recites a meaningful application of the LNA so that the claim is not merely the LNA performed in a computer environment, and thereby claims less than the LNA, itself?

PROPOSED GUIDANCE TO ASSIST EXAMINERS IDENTIFY PATENT ELIGIBLE SUBJECT MATTER (IN THE CONTEXT OF COMPUTER-IMPLEMENTED METHODS & SYSTEMS)

Step 1 Guidance: (identifying if a claim is directed to LNA)

- It is incumbent upon the USPTO to define "**abstract idea**" so that Examiners can faithfully do the analysis of Step 1. Although the *Alice Corp.* Court did not deem it necessary to define "abstract," based on its conclusion that there was consensus that the claims at issue were directed to an abstract idea (stating "we need not labor to delimit the precise contours of the 'abstract ideas' category in this case"), Examiners need guidance on how to evaluate whether claims that they examine are directed to an abstract idea. To do this, one must have a useful definition of "abstract" to apply. Mere examples of claims not patent eligible under § 101, citing U.S. Supreme Court precedent is insufficient and inadequate for guiding Examiners to determine whether a patent claim is directed to an abstract idea under the analysis of Step 1.
- *Alice Corp.* did not adopt the Solicitor General's definition of an abstract claim, namely "a claim that is not directed to a concrete innovation in technology, science, or the industrial arts...abstract

in the sense that it is not a concrete innovation in the traditional realm of patent law". Although Ruth Bader Ginsberg requested the Solicitor General give his definition of an abstract concept during Oral Arguments (page 53, lines 2-13), the Supreme Court has yet to adopt a definition of "abstract idea", "abstract concept" or "abstract claim."

- *Alice Corp.* did hint that *if* a claim *were* directed to innovation in technology or improve a computer's function, the claim *may* be patent eligible under § 101.
- One admonition is that a patent claim (including computer-implemented method/system) does **not necessarily** have to be an improvement of another technology or improve the function of a computer, to be patent eligible under § 101.
- The dictionary definitions of "**abstract**"....

1. **Abstract** according to Merriam-Webster...

- disassociated from any specific instance;
- expressing a quality apart from an object {the word poem is concrete, poetry is abstract}; and
- relating to or involving general ideas or qualities rather than specific people, objects, or actions of art: expressing ideas and emotions by using elements such as colors and lines; and without attempting to create a realistic picture.

2. **Abstract** according to Oxford Dictionary...

- existing in thought or as an idea but not having a physical or concrete existence;
- not based on a particular instance; theoretical; and
- ...denoting an idea, quality, or state rather than a concrete object: {*abstract words like truth or equality*};.
- ***The KEY to determining whether a patent claim is not Abstract is whether the patent claim recites a specific, concrete instance or application. Specific, concrete applications or specific instances are NOT abstract, per the definition of abstract by Merriam-Webster and Oxford Dictionary (see above).***

Examples of Abstract ideas / Concepts and Examples of NOT Abstract Ideas

- Poetry is abstract, a poem (a concrete example or instance) is NOT abstract (Merriam-Webster).
- Gaming or the idea of playing games is abstract, but performing the concrete, discrete steps of a game, following a set of rules (i.e. a concrete example or embodiment of a specific game) is NOT abstract (as a poem is the non-abstract embodiment of the abstract idea/concept of a poem. (see e.g. Merriam-Webster).
- Patent claims only reciting fundamental economic principles are abstract in view of *Alice Corp.* but claims reciting specific instances of a "new" financial transaction may be not abstract.
- Other NOT abstract examples are specific embodiments and concrete, specific instances including working examples which incorporate and form an invention.

Step 2 Guidance: (determining whether a claim, directed to LNA, recites an application of the LNA)

- Examples of applications of an LNA patent eligible under § 101 include computer code or software (operable on a computer) which is directed to improving / enhancing the function of a computer including, but not limited to...
 1. database management
 2. user interface
 3. optimization of computer searching
 4. updating user profiles
 5. data compression,
 6. biometric identification, and
 7. encryption.

- Other examples of applications of an LNA patent eligible under § 101 include methods or systems performing steps in a game, following a defined, claimed rule set, producing a determined claimed result, e.g. winners and losers, using the established, claimed rule set.

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