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**Sent:** Friday, October 16, 2009 11:48 AM  
**To:** AB98 Comments  
**Subject:** Comments for Section 101 Interim Examination Instructions

Enclosed to this email are comments on the Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility, according to the notice for comments posted in 74 FR 47780 (September 17, 2009) and the extension of the comment period as posted on the USPTO website on September 29, 2009.

Best Regards,  
Robert Hirning  
on behalf of the patent practitioners at Oppenheimer, Wolff and Donnelly, LLP

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October 16, 2009

Caroline D. Dennison  
Office of the Deputy Commissioner for Patent Examination Policy  
United States Patent and Trademark Office  
Alexandria, VA 22313

Dear Ms. Dennison:

The following letter concerns the Interim Eligibility Instructions for Evaluating Patent Subject Matter Eligibility (hereinafter “Interim Instructions”) provided via the USPTO’s website. In accordance with the Request for Comments posted in the Federal Register on September, 17, 2009, the patent practitioners at the law firm of Oppenheimer, Wolff and Donnelly, LLP wish to submit the following comments. These comments are intended to address issues with certain inconsistent text in the Interim Instructions that we feel does not fully reflect the current state of patentability standards under 35 U.S.C. §101.

We applaud the Office’s efforts to provide constructive and timely guidelines for Examiners to employ during examination when considering patentability of claims under §101. In light of the changes in this area of law, we recognize the importance of updating the existing guidelines to provide Examiners with current direction for considering §101 issues, and we believe that the Interim Instructions are useful and generally consistent with the current state of the law. However, we have particular concern regarding the “non-limiting examples of claims that are not directed to one of the statutory categories” on Page 2 of the Interim Instructions. Seven examples are provided:

- (i) transitory forms of signal transmission,
- (ii) a naturally occurring organism,
- (iii) a human *per se*,
- (iv) a legal contractual agreement between two parties,
- (v) a game defined as a set of rules,
- (vi) a computer program *per se*, and
- (vii) a company.

While the non-patentability of broad claims exclusively directed to the subject matter in these examples may be self-evident, providing such a list of examples without additional explanation or instructive context raises a number of concerns. All the more, because use of the Interim Instructions is not an appealable or petitionable matter by itself, any misinterpretation of or failure to properly use these examples may result in final rejections under §101 that require time-consuming and costly appeals by applicants.

From our experience with the Office’s examination of patentable subject matter, we have observed that Examiners often issue §101 rejections upon the basis of a close review of guidelines, such as the MPEP and the Interim Instructions, and Examiners may directly compare the prosecuted claims to the textual examples provided in those guidelines. Even if the example is not directly on point or is intended to only cover exclusively broad claims, such examples lead to rejections that must be rebutted by applicants in a detailed response. This is particularly frustrating for applicants if the subject matter eligibility of the claim is not otherwise in question on the basis of the other substantive portions of the Interim Instructions. Thus, during the examination of a claim that recites, but is not exclusively directed to, a signal, a human, a natural organism, a game, a computer program, or a company, rejections may interpret text in the Interim Instructions as prohibiting *any* recitation of these subjects within claims. Section 101 and current case law do not provide such a broad prohibition.

Rather, as explained elsewhere in the Interim Instructions, current case law may be summarized into a logical series of “steps” when assessing §101 subject matter eligibility. The first step, as set forth in the Interim Instructions, is determining whether the claim is “directed to one of the four patent-eligible subject matter categories: process, machine, manufacture, or composition of matter.” The second step, after assessing that the claim is directed to one of the four categories, is determining whether the claim does “wholly embrace a judicially recognized exception.” These two steps, standing alone, are the standards set forth in the Supreme Court and Federal Circuit’s precedential cases. There is no intermediate step, such as evaluating whether a claim is “directed” to specific prohibited examples. A claim either falls into one of the four categories, or it does not; a claim falls under the purview of a judicially recognized exception, or it does not. There is no gray area for “non-limiting examples.”

We appreciate that the purpose for providing examples within the Interim Instructions is to illustrate some of the types of claims that are not directed to a process, machine, manufacture, or composition. Thus, it is accurate to point out that an example of a claim directed to “transitory forms of signal transmission” such as the rejected claim within *in re Nuijten*, 84 USPQ 2d 1495 (Fed. Cir. 2007), does not fall under any of the four statutory classes. (*But see Id.* at 1501, noting allowance of method claim despite its recitation of a signal). Nevertheless, other examples within the Interim Instructions are notably misleading.

There is no express holding that a “naturally occurring organism” does not fit into one of the statutory classes of subject matter. An organism, at its lowest molecular and chemical level, is a composition of matter made up of “two or more substances.” As held by the Supreme Court, even living organisms may be considered a “composition of matter” or a “manufacture.” *See* *Diamond v. Chakrabarty*, 447 U.S. 303, 206 USPQ 193 (1980). Rather, the unpatentability of *naturally occurring* organisms and other natural phenomena is established by a judicial exception. *See id.* The examples within the Interim Instructions provide a confusing overlap between the role of the four statutory categories and the distinct judicial exceptions not directly tied to these statutory categories.

The example of a “computer program *per se*” also discounts the patentability of computer programs embodied within a statutory process, machine, or article of manufacture. *Post-Bilski*

BPAI decisions have clearly upheld the patentability of a computer program product embodied on a computer readable storage medium. *See, e.g.,* Ex parte Bo Li, Appeal 2008-1213 (BPAI 2008). As is implicitly acknowledged within *in re Bilski* itself, computer program process claims are patentable when at least tied to a machine or achieving an eligible transformation. *See in re Bilski*, 88 USPQ 2d 1385, Footnote 25 (Fed. Cir. 2008). We are concerned that even if a machine or transformation is undisputedly included within a claim, or a claim recites a valid computer program product embodied on a computer readable storage medium, a rejection may still be premised upon the categorical exclusion of the “computer program *per se*” example within the Interim Instructions.

The categorical exclusion of “a game defined as a set of rules” unnecessarily excludes eligible processes and machines involving gaming rules from patentability. First, it is unclear in what settings that a game may or may not be defined as “rules,” or how a comparable “set of rules” in a non-game setting might not fall within the four categories. Moreover, a game defined as a set of rules can be implemented as either a process (such as a process for playing a game according to a set of rules) or a machine (such as a machine configured to perform some function and produce a certain effect or result according to a set of rules). It is unclear in this setting why a game is singled out as not falling within one of the statutory categories, or why a “game defined as a set of rules” would be less statutory than any non-game or “process defined as a set of rules.”

The purpose of our comments above is not to dispute that under current §101 legal precedent a claim must fall into one of the statutory categories, that of a process, a machine, a manufacture, or a composition of matter, in addition to not wholly reading on a judicial exception. Rather, our comments above are intended to demonstrate that broad claim interpretation combined with the unfocused examples in the Interim Instructions may present an unnecessary hurdle for applicants having similar subject matter types.

### **Recommendations**

First, we recommend that any non-limiting examples of subject matter are given with additional context of *why* the examples are not directed towards one of the four statutory categories. Even the most basic explanation accompanied by a citation to relevant cases (such as *in re Nuijten*) would be instructive to Examiners and Practitioners alike.

Second, we recommend the removal of a “game defined as a set of rules” from the non-limiting examples due to its confusion with statutory processes and machines that operate with a defined set of rules or operate to facilitate games. Likewise, we suggest either removing the “computer program *per se*” example, or providing a standard definition within the Instructions and/or the MPEP about the difference between a computer program *per se* and a computer program embodied in a statutory process, machine, or article of manufacture. The Interim Instructions do provide helpful explanation on how claims reciting a computer-implemented process or computer readable storage medium may be patentable, but the distinction between these two patentable types of software and a purportedly unpatentable computer program “*per se*” should be fully clarified.

Finally, as a simple solution for many of the issues described above, we suggest explaining that the examples only concern subject matter “per se” or standing alone. Claims exclusively *directed* to these examples may not be patentable by themselves, but the subject matter used in these examples may be validly recited within process, machine, manufacture, or composition of matter claims. Thus, a machine that uses a transitory form of a signal to communicate is not excluded; likewise, a process that must be performed by a human being is not excluded simply because a human is recited.

Moreover, the instructions should clarify that a claim may include the recitation of a signal transmission, a naturally occurring organism, a human, a contractual agreement, a game, a computer program, and a company, and still be directed towards patentable subject matter under §101. The statement on Page 2 of the Interim Guidelines that “A claim that covers both statutory and non-statutory embodiments . . . embraces subject matter that is not eligible for patent protection and therefore is directed to non-statutory subject matter,” while apt, should also be refined to differentiate between a claim that is *directed* to non-statutory subject matter or covers non-statutory embodiments from a claim that merely *recites* a non-statutory limitation but is nonetheless directed exclusively to a statutory category. There are many examples of patents that demonstrate statutory eligibility and utility under §101 in the fields of these examples. It should be the purpose of the Interim Instructions to add clarity and not provide unnecessary confusion and misleading examples for this developing area of law.

Respectfully Submitted,

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