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Sent: Monday, September 28, 2009 8:48 PM
To: AB98 Comments
Subject: Submission by Accenture re Interim Examination Instructions

Please see the attached comments submitted on behalf of Accenture on the proposed Interim Examination Instructions for Determining Subject Matter Eligibility under 35 U.S.C. § 101.

Respectfully submitted,

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September 28, 2009

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property and
Director of the U.S. Patent and Trademark Office
Mail Stop Comments—Patents, Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313–1450

ATTN: Caroline D. Dennison
Submitted by email to: AB98.Comments@uspto.gov

Re: Comments on “Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101”

I am writing to provide Accenture’s comments on the interim examination instructions dated August 24, 2009 related to subject matter eligibility in advance of a Supreme Court decision in *Bilski v. Kappos*.

Accenture is one of the world’s leading management consulting, technology services, and outsourcing organizations, serving 96 of the Fortune Global 100 and more than three-quarters of the Fortune Global 500. With approximately 177,000 people serving clients in more than 120 countries, Accenture collaborates with clients to help them become high-performance businesses. This strategy builds on Accenture’s expertise in consulting, technology and outsourcing to help clients create sustainable value for their customers and shareholders.

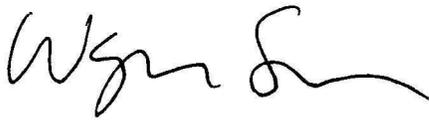
Accenture presents these remarks in response to the United States Patent and Trademark Office ("PTO") request for comments on its Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. §101 ("Instructions"). Accenture appreciates the opportunity to comment on the Instructions, and fully supports the PTO's goal of providing clear and correct guidance to Examiners for determining patent eligible subject matter, given the current state of the law. In that regard, Accenture notes that it has filed an *Amicus Curiae* brief in support of Petitioner in the *Bilski v. Kappos* Supreme Court case. That brief states Accenture's position with respect to the exclusive and unduly rigid approach that the Federal Circuit established in *Bilski* for determining patent eligibility. The comments below are directed to the PTO's specific formulation of the

Instructions given the current state of the law, and the comments below in no way constitute a shift or change in Accenture's position as set forth in its *Amicus Curiae* brief.

Additionally, Accenture is mindful of, and does not believe it useful to repeat, a number of the very useful comments already submitted by organizations such as IPO and AIPLA. Further, Accenture trusts that the PTO will speedily revise the Instructions as soon as possible following the Supreme Court's decision in the *Bilski* case, as provided at 74 FR 47780.

We thank you for the opportunity to provide these comments.

Sincerely,

A handwritten signature in black ink, appearing to read "Wayne Sobon". The signature is fluid and cursive, with a long horizontal stroke at the end.

Wayne Sobon
Associate General Counsel,
Director of Intellectual Property

Appendix

Accenture's Comments on August 2009 Interim Examination Instructions for Evaluating Subject Matter Eligibility

We believe the Instructions need clarification in at least the following areas:

- Page 1, explaining the "process" category: In practice, putting undue stress on "tied to a particular machine" can be both vague and potentially too limiting under the clear import of the *Bilski* decision. We suggest that a more practical application of this requirement can be achieved by revising the Instructions to require Examiners to ask whether the claim as a whole involves or in some fashion interacts with a particular machine, or transforms an article of manufacture from one state to another. We also suggest that, later in the Instructions, the PTO provide a relatively broad range of examples of claims that involve or interact with a particular machine and also claims that do not involve or interact with a particular machine, etc.. The Instructions should also be revised to note that it is the claim as a whole that needs to involve or interact with a machine or transform an article, and that not every recited process step needs to separately involve or interact with a particular machine or transform an article. We suggest that the Instructions provide Examiners with more specific guidance about how to properly assess whether the claim as a whole has the requisite connection to real-world processes involving particular machines or transforming articles, and Accenture notes that the discussion concerning data as a transformed article is welcome and helpful in this regard.
- Page 2, regarding the list of non-statutory subject matter: We suggest that the PTO cite the key cases that carve out the listed exceptions. These citations will facilitate meaningful discussions with Examiners to distinguish particular claims from the specific facts of those cases. The Instructions already designate a few of the exceptions as "*per se*" exceptions, but most, if not all, of the exceptions probably need this designation. Take, for example, the "game defined as a set of rules" that is clearly at best "*per se*," as we believe that the patent office regularly issues game utility patents that involve nothing more than novel game pieces and boards, along with the rules for playing, or games implemented on computer systems (for example, gambling equipment), but where the machine is simply an existing general purpose computer.

- Page 3, raising the issue of tangibility: Under section II.A, the second paragraph discusses "tangible" elements and the third paragraph refers to "tangible limitations." We suggest that the PTO further clarify what is meant by "tangible" in these contexts. This clarification should include an explanation that "tangible" does not require perceptibility by human senses, but instead can encompass a wide range of specific, practical, real-world implementation features that can vary widely depending on the claimed technology. The PTO should give examples of such tangible features in the Instructions, including computer program code stored in a memory, with both the computer code and the memory individually recognized as tangible claim features.
- Page 4 and in the Interim Examination Training Materials, page 10: It is asserted that "non-transitory" computer readable media qualify for patent eligible protection because a non-transitory storage medium is an article of manufacture. We suggest that the PTO provide explicit guidance on how the PTO interprets the terms "transitory" and "non-transitory." Furthermore, we suggest that the PTO clarify in the Instructions that Examiners may not interpret the claims as encompassing non-statutory subject matter, such as transitory signals, without first analyzing the specification and determining that it will support such an interpretation. In this regard, we suggest that the PTO consider the reasoning in *Ex Parte Azuma*, No. 2009-003902 (B.P.A.I., Sept. 14, 2009). In *Azuma*, the Board decided that the claimed feature of a "computer usable medium," even without a modifier such as "non-transitory," was statutorily permissible because a reading of the specification as a whole revealed that the medium should not be interpreted to encompass a transitory signal.
- Page 6, regarding "extra-solution" activity: The Instructions and the Process Claims Eligibility Flowchart require the Examiner to consider whether more is present than just insignificant "extra-solution" activity. We suggest that the PTO generate clearer guidelines for how an Examiner will execute the "extra-solution" activity analysis in a meaningful, consistent, and predictable way. At the very least, we suggest that the PTO generate a range of examples of both sufficient extra-solution activities, and insufficient extra-solution activities. We would further appreciate comments from the PTO regarding whether or not all "extra-solution" activity is insignificant or insufficient by definition because it is "extra-solution." On a more fundamental level, we note

that modern software implements complex functionality extending far beyond the mere calculation of values or "solutions." While past court cases such as *Diehr* and *Benson* have referred to "post-solution" or "extra-solution" activity, these concepts rarely have any clear meaning in systems executing anything other than the types of single calculations involved in those cases. Requiring Examiners to apply antiquated concepts like "post-solution" and "extra-solution" in the context of modern software is often a futile endeavor. A better approach is to view the claim as a whole and determine whether it is performing useful real-world functions without wholly preempting fundamental concepts.

- Pages 3 and 4, regarding structural elements: It would be helpful to have clarification from the PTO concerning the difference between the structure of "a machine" that fails to qualify a claim for patent eligibility (page 3) and the structure of a "computer readable storage medium" that does qualify a claim for patent eligibility (page 4).

We further believe that the Instructions need some additional clarification at:

- Page 1, regarding transformation: We suggest that the PTO provide additional examples of evidence of transformation, in addition to "a new or different function or use." For example, the Instructions should clarify that changes in physical properties, including changes in virtual properties of articles represented in computer memory, qualify as transformation that can make a claim patent eligible.
- Page 1, concerning a "machine": The definition of "machine" is confusing because it is defined in terms of "devices and combinations of devices" and "mechanical powers" which are not themselves defined. We recommend that the PTO expand the Instructions to further define the types of "machines" that satisfy the "particular machine" requirement.
- Page 3 and Subject Matter Eligibility Flowchart: In the last paragraph of page 3, the phrase "limited occurrence of preemption" appears. There is no explanation in the Instructions regarding what differentiates "limited occurrence of preemption" from "preemption" in general, and it would be helpful to have clarification regarding whether the Instructions truly intend to create such a distinction. If so, we

recommend that the Instructions explain the meaning and application of "limited occurrence of preemption" with regard to determining patentable subject matter.

- Page 4, regarding programmed computers: The phrase "general purpose" should be added in front of "computer programmed with executable instructions."
- Page 5, regarding transformation: The third line and eighth line, as examples, use the phrase "particularly transform." There is no explanation in the Instructions regarding what differentiates "particularly transform" from any other way of transforming, and it would be helpful to clarify whether the Instructions truly intend to create such a distinction. If so, we recommend either that the Instructions simply use "transform" or otherwise explain the meaning and application of "particularly transform" with regard to determining patentable subject matter in contrast to the transformation that *Bilski* requires.
- Page 5, regarding mental processes: We believe that the Instructions can be improved by including specific examples of ineligible transformations for "purely mental processes in which thoughts or human based actions are changed."
- Page 7, concerning preemption: The use of "i.e.," on line 21 conveys that "limited to a particular practical application" is the same as "no preemption." We do not understand these two concepts to necessarily be synonymous and request clarification from the PTO regarding whether the PTO considers them synonymous as a test for preemption.
- Page 7, regarding a machine or article is "particular": We believe it would be helpful to reword or further clarify the last full sentence, which seems difficult to parse and understand.

Finally, we note that the Instructions need correction of several important seemingly typographical errors:

- Page 7: On line 6, we believe that "Step 2" should read "Step 3."
- Page 7: On line 12, we believe that "Step 1" should read "Step 2."