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FOUNDED 1866

July 31, 2006

By email – AB98.Comments@uspto.gov

Mail Stop Comments – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

Re: *Request for Comments on Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility*, 70 Fed. Reg. 75451 (December 20, 2005)

Sir:

We submit the following comments on behalf of the Motion Picture Association of America, Inc. ("MPAA") in response to the Office's notice concerning the Examination Guidelines for subject matter eligibility under 35 U.S.C. § 101.

The MPAA is a trade association whose members include the largest motion picture producers and distributors in the United States. Founded in 1922, the MPAA serves as the voice and advocate of the domestic motion picture, home video, and television industries. The MPAA appreciates the opportunity to offer these comments for the Office's consideration.

Introductory remarks

In general terms, the MPAA considers that the revised Guidelines will be helpful to examiners. The usefulness of the Guidelines can be enhanced, however, by addressing issues specific to patents involving creative and artistic works and by supplementing the Guidelines with corresponding training materials.

Creative and artistic works play an important role in society and in the economy. Thus, it is likely that the Office will see a greater number of patent applications that involve such works in some capacity. Quite properly, the Interim Guidelines set out a rational analytical process that is applicable to all types of subject matter. Nevertheless, the focus appears to be on issues that relate directly to the examination of claims involving software and business methods. It would be useful and appropriate to also provide specific guidance for the examination of patent applications involving creative and artistic works.

As is the case for every statutory patentability requirement, understanding what is claimed depends on properly analyzing the claims to define the functional elements they require, and the way those functional elements interact with each other. In this regard, analyzing claims that recite creative or artistic content in the format of a process will often present unfamiliar and unique challenges for Office personnel.

Training examples focused specifically on the treatment of “artistic content” claims would be an invaluable supplement to the Guidelines. Such examples would provide practical guidance to Office personnel for analyzing different claim structures. Of equal importance, they would illustrate the application of the broader legal principles incorporated in the Guidelines, to the benefit of the public. Indeed, the courts have found such analyses helpful in applying evolving areas of the law to particular fact situations. *See, e.g., Enzo Biochem v. Gen-Probe Inc.*, 323 F.3d 956, 964, 63 USPQ2d 1609, 1615 (Fed. Cir. 2002) (citing analysis in the Office’s Written Description Guidelines).

Because the evaluation of “artistic content” claims relates to an evolving area of the law that has the potential to affect a spectrum of interested parties, the MPAA encourages the Office to publish its training examples for public comment.

1. Office personnel should analyze each process claim as a whole to determine whether recited events are functional elements of the claim.

An evaluation of a process claim should take into account how the various steps it recites relate to the process as a whole. Claims that recite “artistic content” raise unique issues: not everything in a claim that can be phrased in language that describes an action is necessarily a step that contributes to a useful, concrete, and tangible result. The Interim Guidelines recognize that certain constructions, such as statements of intended use or “whereby” clauses, may be entitled to no patentable weight in evaluating what a claim actually requires.

The Office should provide guidance for evaluating the effect of “artistic content” limitations in process claims. When such limitations are not functional elements of the claims, they should be entitled to no patentable weight, both for assessing the patent-eligibility of the claim as a whole and for assessing patentability over the prior art.

Elements of a process claim that require specific structures or events that are integral to the series of events that leads to a useful, concrete, and tangible result should be accorded patentable weight in evaluating a claim. *See In re Miller*, 418 F.2d 1392, 1396, 164 USPQ 46, 48-49 (CCPA 1969) (functional relationships between elements of claimed apparatus establish patent-eligibility and patentability over prior art). An action that is taken by the person or entity that performs the claimed process, or a step that effects or results in a transformative event, is such a functional element. In contrast, an action that merely takes place coincident to the execution of a process, but does not contribute to a useful, concrete, and tangible result of the process as a whole, does not serve a functional role in the

process. Accordingly, a claim limitation reciting such an element may be entitled to little or no patentable weight in evaluating the claim as a whole.

As an example, a recitation of actions depicted in a television program in a claim to a method for displaying such a program is process language that does not correspond to a functional claim element. Consider the following claim:

- A. A method for displaying a presentation relating to a cowboy and a horse, comprising accessing a stored video presentation and displaying the presentation, wherein, in said presentation, said cowboy rides said horse.

The limitation that specifies that the cowboy rides the horse does not require an action that is integral to the series of steps that leads to the useful, concrete, and tangible result of displaying a presentation.

In contrast, the actions of accessing a video presentation and displaying the presentation plainly relate directly to the useful, tangible, and concrete objective recited in the preamble of the claim.

As a counterexample, consider another claim:

- B. A method for displaying a video presentation using a cowboy and a horse, comprising providing a display mounted on said horse, accessing a stored video presentation, and displaying the presentation on the display, wherein said cowboy rides said horse while the presentation is displayed.

In this case, the horse and the cowboy play a functional role in the way the video presentation is displayed. The limitation that requires that the cowboy ride the horse requires an action that is integral to the useful, concrete, and tangible result of displaying the video presentation in the manner claimed.

Generally, creative or artistic content that is recited as something that is observed, depicted, indicated, or represented may not correspond to a functional element of a process claim. However, the acts of observing, depicting, indicating, or representing will often correspond to functional elements that contribute to a useful, tangible, and concrete result of a claimed process. In the examples above, the "said cowboy rides said horse" limitation bears a functional relationship to the useful, tangible, and concrete result of claim B, but not of claim A. Thus, for purposes of assessing compliance with the patent-eligibility requirements of § 101 and the patentability requirements of §§ 102 and 103, that limitation should be given less weight in the first claim than the second.

2. An analysis of the actions that would be required to establish infringement is a useful tool to identify the functionally significant process steps in a claim.

An infringement analysis provides a helpful framework for identifying whether actions or events recited in a process claim correspond to functional elements. A patentee who wishes to enforce a process claim against an accused infringer must provide evidence that the accused party actually performed the discrete process steps – the series of acts – that the process requires. See *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607, 85 USPQ 328, 330 (1950) (infringement requires that asserted claims be compared against accused product or process); *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29, 41 USPQ2d 1865, 1871 (1997) (“Each element contained in a patent claim is deemed material to defining the scope of the patented invention ...”).

With reference to the example claim A above, involving the display of a presentation that depicts a cowboy riding a horse, the patentee seeking to establish infringement of claim would need to establish that the accused infringer (1) accessed a stored video presentation, and (2) displayed the presentation. See *id.* The patentee would not need to show that the infringer was a cowboy who rode a horse. The fact that evidence might be needed to show that the infringer’s presentation depicted such activity does not convert the activity into a step that is actually performed in the claimed method.

Creative or artistic content elements recited in a process claim, such as a painting of a specified scene or particular fictional events in a screenplay, may be no more than abstract ideas, divorced from any practical implementation of the idea. See, e.g., *Diamond v. Diehr*, 450 U.S. 175, 185, 209 USPQ 1, 7 (1980). The fact that a claim recites or uses abstract ideas does not render the claim nonstatutory. See *id.*, 450 U.S. at 187, 209 USPQ at 8. However, the mere depiction of an abstract idea, even though couched in the phrasing of a process limitation, is insufficient, by itself, to define patent-eligible subject matter. See, e.g., *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373-74, 47 USPQ2d 1596, 1600-01 (Fed. Cir. 1998). A claim that contained nothing more than such a step, or a series of such steps, would not be directed to statutory subject matter. Moreover, a claim with only a minimal actual process step could dominate access to the idea, for example:

C. A method comprising providing a presentation, wherein the presentation depicts a cowboy and a horse, and said cowboy rides said horse.

This claim would preempt the use or appreciation of the abstract idea, and accordingly would run afoul of the doctrine of *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ 673 (1972).

A touchstone for identifying actions that serve as functional claim elements is whether they correspond to events that actually take place. See *Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77 (invention patent-ineligible because for “no substantial practical application.”).

In the example of claim A, “accessing” and “displaying” are events that take place in the tangible world. The step of riding – and, for that matter, the cowboy that rides and the horse that is ridden – are not tangible. The event of riding the horse in the method of claim A is a mere representation of an event; it does not produce any result or cause any transformation in the tangible world.

Any element in a process claim that is inherently incapable of playing a functional role in producing a useful, concrete, and tangible result – pure information, an artistic expression, a plot or story line, music, an abstract idea – should not be accorded patentable weight as a step in the process. This is so, even if the element is framed as an “event” or series of “events” in the language and phrasing of a patent process limitation. This is in accord with the treatment of such elements in product or apparatus claims as nonfunctional descriptive material. See, e.g., *In re Warmerdam*, 33 F.3d 1354 (Fed. Cir. 1994); see also M.P.E.P. § 706.03(a) (printed matter doctrine).

3. Office personnel should evaluate process language involving the presentation of “artistic content” with reference to the requirement under § 101 for a specific, substantial, and credible utility.

As the Guidelines recognize, there is significant interplay between the utility and subject matter eligibility requirements of § 101. The need for a “real-world” nexus between the actions recited in a claim and the actions required to practice a claimed process invention also relates to the “practical utility” requirement. The principles relating to the criteria for demonstrating a specific, substantial, and credible utility may be used to evaluate whether a process element is integral to producing a useful, concrete, and tangible result according to a claim of which it is a part. See *In re Alappat*, 33 F.3d 1526, 1544, 31 USPQ2d, 1545, 1557 (Fed. Cir. 1994) (claim was to a practical implementation of abstract idea because it produced a useful, concrete, and tangible result). A process that, as a whole, comprises only steps that lack a specific, substantial, and credible utility likely fails to meet not only the utility requirement, but also the patent-eligibility requirement of § 101.

The Guidelines should make clear that simply alleging that the claimed process may have some – even significant – commercial value does not satisfy the requirement for a practical utility. For example, playing a song involves the creation of sound corresponding to a sequence of notes. The result may be extremely appealing to a broad sector of the public and may thereby have significant commercial value. However, few would suggest that playing the sequence of notes corresponding to a song is a process having “practical utility” under § 101. See *Nelson v. Bowler*, 626 F.2d 853, 856, 206 USPQ 881, 883 (CCPA 1980) (practical utility exists where claimed discovery can be used in a manner that provides immediate benefit to the public).

A claimed process that merely augments the informational content of an abstract idea – such as a method for making music cited in the claim more melodious, or a screenplay more humorous – is unlikely (by itself) to have a specific and substantial utility. If the

underlying claim elements, other than those related to the recited creative content, are framed in general terms that are anticipated by the prior art (*i.e.*, the elements are conventional but for the creative content recited in the claim), the Office may legitimately question whether the utility of the process is “specific” to the claimed process, or whether the utility of the process as a whole is “substantial.” *See generally, e.g., Knapp v. Anderson*, 477 F.2d 588, 590, 177 USPQ 688, 690-91 (general statement of potential field of utility insufficient to establish specific utility for claimed subject matter). At a minimum, focusing examination practices to critically review assertions of utility will improve the examination process by inducing applicants to more specifically identify the critical aspects of their claims.

Training examples should be provided to illustrate these concepts. In particular, it would be helpful to present examples that contrast cases such as those discussed above with situations in which the augmentation of informational content leads to a useful, concrete, and tangible result. For example, whereas a method that requires no more than playing a specified musical composition does not yield a useful, concrete, and tangible result, a method for rendering data sorted according to an algorithm that is useful (within the meaning of § 101) likely would produce such a result.

4. Claims directed to no more than depicting, presenting, or performing creative or artistic content raise practical concerns regarding the examination resources they may consume.

The MPAA notes with some alarm a trend toward claiming inventions related to the creative arts using claim steps that recite events that are conveyed through an artistic expression (*e.g.*, the actions a character in a story may perform). It is neither appropriate nor practical to evaluate the novelty and non-obviousness of a claimed invention through an assessment of the “quality” or “merits” of an artistic expression. Such claims are properly addressed through the application of the substantive requirements for patent eligibility.

Beyond that, it would be inappropriate for the Office to devote any of its limited examination resources to comparing creative or artistic content in screenplays, musical compositions, or plot synopses to the prior art. The Office simply lacks the wherewithal to assemble a comprehensive reference collection in the artistic, musical, and literary arts. It hardly needs to be said that the Office lacks the examining personnel that would be needed to search such collections and evaluate claims against the “prior art.”

A proper application of the law will limit inappropriate expenditures of the Office’s resources. Doctrines that deny patentable weight to nonfunctional descriptive material are effective to prevent applicants from presenting claims to articles of manufacture consisting of printed copies of newly drafted novels, and the like. *See, e.g., In re Stirling*, 77 F.2d 910, 21 USPQ 519 (CCPA 1934) (claim to checkbook unpatentable over prior art where only novel feature was information printed on checks).

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It is appropriate to extend such doctrines to the treatment of individual process steps involving nonfunctional artistic expressions. Thus, a process step that recites performing or displaying a depiction of events or information, where the depicted events or information play no functional role in the claimed process, should be evaluated against the prior art only for the recitation of “performing” or “displaying,” and not for the informational content of the events or information performed or depicted.

In this regard, the Office should explore the appropriate limits of the “nonfunctional descriptive matter” doctrine and related doctrines in light of its experience examining process claims relating to artistic expressions. Training examples to illustrate the proper application of such doctrines to the examination of patent claims that refer to creative or artistic works would provide a valuable supplement to the Guidelines.

Conclusion

The MPAA thanks the Office for the opportunity to offer these comments and would be pleased to offer its support and assistance in respect of the issues raised by the Guidelines.

Sincerely yours,



Jeffrey P. Kushan