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From: Therkorn, Linda
Sent: Thursday, March 23, 2006 2:34 PM
To: AB98 Comments
Cc: Thompson, Annette
Subject: FW: Comments on the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility

Ms. Thompson,
Thank you for your comments. They have been forwarded as appropriate.

-----Original Message-----

From: Thompson, Annette
Sent: Thursday, March 23, 2006 2:29 PM
To: Therkorn, Linda
Cc: Thompson, Annette
Subject: Comments on the Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility

Good afternoon,
Following are my comments. To whom should they be directed?

I.

Annex IV: Computer-Related Nonstatutory Subject Matter

In second paragraph, the holding of Warmerdam is incorrect; the last four lines referencing Warmerdam should be deleted. In *In re Warmerdam*, 31 USPQ2d 1754 (Fed. Cir. 1994), *the one claim that was affirmed by the Federal Circuit was not the subject of a 35 USC 101 rejection*. Rather it was the subject of a 35 USC 112, second paragraph rejection. The Federal Circuit in *In re Warmerdam*, therefore, did not address any 35 USC 101 rejections related to that one affirmed claim ("Whether such a programmed machine is new, useful, unobvious or otherwise patentable is not at issue in this appeal, and we express no opinion thereon.") Id. at 1760.

II.

Annex IV, Part (a): The first line of this section is misleading and requires a more precise statement: For example, a data structure is also a database; so does the first line also imply that a database has to be claimed as embodied in computer-readable media?

Also, with respect to Part (a): it may be more precise to state that information is considered descriptive if a **logical relationship** *does not exist* between the information and the computer media. The idea of a logical relationship would be a key idea to advance when discussing computer related inventions and relationships. Please find attached a proposed revision of part (a).

<< File: Guidelines Annex draft for Functional Descriptive Material.doc >>

III.

The Guidelines propose that "a claim reciting a signal encoded with functional descriptive matter does not fall within any of the categories of patentable subject matter". One such claim example is as follows:

A carrier wave encoded with instructions which when executed perform the method of claim 1.

In such a case, the claim as a whole is directed to a process, the method of claim 1. Therefore, such a claim would be treated as a process claim. In the majority of such claimed cases, Applicants are not seeking to patent or protect the computer media. Applicants are seeking protection for an executable process, the steps of which are stored on the media. An encoded signal is constitutes transmission media and is a form of computer storage.

Annette Thompson

JEF-5D89

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(a) Functional Descriptive Material

A data structure is a physical or logical relationship among data elements designed to support specific data manipulation functions. The Authoritative Dictionary of IEEE Standard Terms (7th ed. 2000) Further, as it relates to software, a data structure constitutes the template by which data is stored in a computer memory. Id. Computer memory includes semiconductor, internal and external computer storage media and encompasses, but is not limited to, nonvolatile media, volatile media, and transmission media. Non-volatile media include CD-ROMs, magnetic tapes, E²PROMs, flash memory, and other optical media. Volatile media includes dynamic memory, caches, RAMs. Transmission media includes carrier waves or other signal-bearing media. Commonly used terms for computer memory are *computer-readable media* or *computer-executable media*.

In determining whether an invention drawn to a software data structure is statutory, it is important to distinguish between claims that recite physical data structure relationships, i.e. non-functional descriptive material, and claims that recite logical data structure relationships, i.e. functional descriptive material. Physical data structure relationships possessing non-functional descriptive material are non-statutory because they represent a collection of information stored together that may or may not be interrelated and have no defined structural or functional relationship with its media. It is not capable of operating to produce any known functionality or utility.

By contrast, a logical data structure relationship comprises information that exists together in a uniquely defined structural and/or functional relationship with its media. Claims drawn to logical data structure relationship define structural and/or functional interrelationships between the data elements, the media, and other claimed aspects of an invention, are considered statutory if the functionality of the logical data structure may be realized, i.e. has utility, when the invention is operational.

Computer programs are often recited as part of a claim. Computer programs claimed as computer listings or computer instructions *per se* represent physical data relationships and non-functional descriptive material. Computer program listings or computer instructions *per se* lack any structural and/or functional relationship to a computer media. Such claimed computer programs or computer instructions are therefore non-statutory. Only when the claimed invention taken as a whole is directed to a mere

descriptive program listing or program instructions without a media should the claim be held nonstatutory.

However, when a computer program is claimed as existing on computer-readable or computer-executable media, the computer program then represents a logical data relationship. It is therefore considered statutory if its functionality may be realized when the computer program is operational.

When computer programs are recited as part of a claim, Office personnel should determine whether the computer program is being claimed as part of a statutory manufacture or machine. If so, the claim remains statutory irrespective of the fact that a computer program is included as part of the claim.

Office personnel should treat a claim as a product claim when a claim recites a computer program in conjunction with a physical structure, such as a computer program product. Additionally, claims reciting a computer-readable or –executable media storing program instructions should also be treated as a product claim because it is capable of producing a tangible output. See paragraph IV.B.2(a), below.

When a computer program is claimed in a process where the computer executes or will execute the computer program instructions, Office personnel should treat the claim as a process claim. See paragraph IV.B.2(a), below. If the process being executed is statutory, then this type of process claim remains statutory irrespective of the fact that a computer program is included in the claim. Diamond v. Diehr, 450 U.S. 175, 185, 209 U.S.P.Q. 1, 8 (1981) (“A claim drawn to subject matter otherwise statutory does not become nonstatutory simply because it uses a mathematical formula, computer program, or digital computer.”)