

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: 2014 Interim Guidance on Patent
Subject Matter Eligibility

Docket No. PTO–P–2014–0058
79 Fed. Reg. 74618

COMMENTS OF PUBLIC KNOWLEDGE

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Public Knowledge respectfully submits the following comments in response to the above-identified Interim Eligibility Guidance dated December 16, 2014.

Public Knowledge is a non-profit organization dedicated to preserving the openness of the Internet and the public's access to knowledge, promoting creativity through balanced intellectual property rights, and upholding and protecting the rights of consumers to use innovative technology lawfully. In furtherance of that mission, Public Knowledge has developed substantial expertise in patent policy and the relation between patent law and the public interest. In particular, in the area of patentable subject matter, Public Knowledge has filed several *amicus curiae* briefs with the Supreme Court and the Federal Circuit,¹ has written extensively on the subject,² and has submitted comments before the USPTO,³ all advocating for a balanced view on patentable subject matter that both promotes invention through the exclusive patent right and protects the public interest in access to fundamental ideas.

¹ Briefs were filed in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) and *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (2014), for example.

² See, e.g., Tristan Gray–Le Coz & Charles Duan, *Apply It to the USPTO: Review of the Implementation of Alice v. CLS Bank in Patent Examination*, 1014 Patently-O Patent L.J. 1.

³ E.g., Comments of Public Knowledge on Examination Instruction and Guidance Pertaining to Patent-Eligible Subject Matter, 79 Fed. Reg. 36786 (July 31, 2014), available at <http://www.uspto.gov/sites/default/files/patents/law/comments/al-a-publicknowledge20140731.pdf>.

Briefly, Public Knowledge thanks the USPTO for preparing the Interim Eligibility Guidance, and believes that further refinements to that guidance are necessary to ensure consistent, accurate examination of patent applications for subject matter eligibility. In particular, the discussion of the “streamlined eligibility analysis” is very problematic and would likely result in clever claim drafting tactics to obtain patents on abstract ideas. Also, the use of only case law examples to direct examiners in performing eligibility analysis fails to sufficiently guide examiners to consistent and accurate determinations. As explained in detail below, we recommend changes to the guidance to resolve these issues and improve patent and examination quality.

I. The Proposed “Streamlined Eligibility Analysis” Is Overbroad and Encourages Gamesmanship in Claim Drafting

Section I.B.3 of the Interim Eligibility Guidance presents a “streamlined eligibility analysis” process as a shortcut for the full subject matter eligibility analysis in certain situations. While it is a reasonable sentiment that some claims obviously do not raise a subject matter eligibility issue, the section as written is overly broad and could lead to applicants attempting to cleverly draft applications directed to ineligible subject matter in a way that appears amenable to such streamlined eligibility analysis, thereby avoiding subject matter eligibility scrutiny.

For example, the section posits that “a claim directed to a complex manufactured industrial product or process that recites meaningful limitations along with a judicial exception may sufficiently limit its practical application so that a full eligibility analysis is not needed.” However, the whether a claim recites “meaningful limitations” is not a simple determination, as the term “meaningful limitations” essentially encompasses the entirety of the *Mayo* step 2 analysis. Thus, the reasoning for why “a full eligibility analysis is not needed” assumes the conclusion, failing to properly guide examiners as to when streamlined analysis is appropriate.

The example given in the section is even more problematic. That example suggests that full eligibility analysis is not required for a claim directed to “a robotic arm assembly having a control system that operates using certain mathematical

relationships.” But that is incorrect: such a claim would nevertheless fail § 101 if the robotic arm assembly were included in the claim as pre-solution or post-solution activity, or if the robotic arm assembly were a conventional element specified at a high level of generality. See *Parker v. Flook*, 437 U.S. 584, 590 (1978); *Mayo Collaborative Svcs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1300 (2012). Thus, this example could potentially lead examiners astray toward error in assessing subject matter eligibility.

Were examiners to apply streamlined eligibility analysis any time a claim included some sort of mechanical limitation, patent applicants would likely draft applications to simply attach some sort of hardware to claims otherwise directed to an abstract idea. Such a possibility was the explicit concern of *Alice Corp. Pty. Ltd. v. CLS Bank International*. There, the claim recited a “a data processing system,” a “communications controller,” and a “data storage unit.” 134 S. Ct. 2347, 2360 (2014). But what the patentee characterized as “specific hardware,” said the Supreme Court, was “purely functional and generic,” and thus was not a “meaningful limitation” overcoming a finding of ineligibility. *Id.* *Alice* thus shows that an ineligible claim can be drafted to recite mechanical hardware. Accordingly, examiners must be wary even of claims “directed to a complex manufactured industrial product or process,” contrary to the Guidance.

A more refined test for streamlined eligibility analysis is as follows. If the examiner identifies a limitation that appears on its face to be a meaningful limitation beyond any judicial exception, then the claim may be amenable to streamlined analysis. The examiner must first determine, though, whether there is any possibility that (1) the limitation is pre-solution or post-solution activity, (2) the limitation is a conventional step, or (3) the limitation is functional or generic. If there is any chance that any of these is the case in the context of the claim, then the examiner must perform a full eligibility analysis. However, if it is strikingly and obviously clear that (1) the limitation is integral to the claim, (2) the limitation is not conventional, and (3) the limitation is not functional or generic, then the streamlined eligibility analysis may be appropriate.

II. The Guidance Should Provide Specific Factors for Evaluating the Two *Mayo* Steps, Rather Than Merely Examples of Cases

The purpose of the Interim Eligibility Guidance is to ensure accurate and consistent examination of subject matter eligibility in patent applications. For the Guidance to achieve that goal, it must provide examiners with a clear roadmap of what factors to consider during examination, so that all examiners apply consistent analysis.

However, the current Interim Eligibility Guidance does not do this. Sections III and IV are nothing more than summaries of previous cases. Sections I.A.2, I.A.3.b, and I.B.1, which discuss the particular tests for subject matter eligibility, similarly only explain those tests “by way of example” by reciting the particular facts of certain cases.

Case law examples do not provide sufficient guidance to examiners. It will be exceptionally unusual for a patent examiner to receive an application directed to subject matter precisely on point, or even substantially on point, with a previously decided case.⁴ So examiners will be forced to interpolate and guess at the principles underlying the case law decisions in order to apply § 101 to new facts and situations. Examiners will interpolate differently, potentially creating widespread inconsistency in examination.

Instead, the USPTO should take the opportunity to perform its own interpolation and interpretation of the case law, devising a set of factors for the two *Mayo* steps for subject matter eligibility. In previous comments, Public Knowledge suggested such factors that may be used, such as whether an idea is taught in basic textbooks (for *Mayo* Step 1) and whether an element of a claim is a commonplace part of a generic computer (for *Mayo* Step 2).⁵

Certainly there is a risk that the USPTO’s interpretation will later turn out to be inconsistent with a future decision, but that risk should not dissuade the USPTO from taking that step of interpretation. If the USPTO identifies a list of factors for examination, then that list is transparent to the public, experts can comment on it, and courts can quickly understand and assess its accuracy in future decisions. But if the USPTO leaves

⁴ Indeed, the patent system’s premises of novelty and nonobviousness should make it a virtual certainty that the facts of a litigated patent should never show up again in another patent application.

⁵ See Comments of Public Knowledge, *supra* note 3.

it to each individual examiner to develop his or her own interpretations of case law, then the resulting inconsistency in examination will almost guarantee an ongoing degree of erroneous examination, the public will have no opportunity to review or comment on the interpretation of the law, and courts will only slowly be able to identify and refine the rules of subject matter eligibility determination. There is certainly a risk in taking a position not explicitly supported by judicial precedent, but it is better for the USPTO to present a unified, publicly announced position than for each individual examiner to develop a hidden, idiosyncratic one.

Accordingly, the USPTO should provide detailed factors for assessing the *Mayo* two-step test, to guide examiners to consistent and accurate determinations of subject matter eligibility, rather than providing only summaries and quotations of case law and expecting examiners to perform independent, and likely divergent, legal analysis on their own.

III. Conclusion

Public Knowledge thanks the USPTO for the opportunity to submit these comments on the 2014 Interim Guidance on Patent Subject Matter Eligibility, and urges that the above-identified recommendations be adopted to further improve that Guidance. If any questions remain, the undersigned attorney would be happy to provide any further information desired.

Respectfully submitted,

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