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Mail Stop Comments – Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

Attention: Carolyn Kosowski, Senior Legal Advisor, Office of Patent Legal Administration

Via email: Eligibility2018@uspto.gov**Re: Comments on Determining Whether a Claim Element Is Well-Understood, Routine, Conventional for Purposes of Subject Matter Eligibility**

Dear Director Iancu:

I write on behalf of the American Bar Association Section of Intellectual Property Law (“Section”) to respond to the United States Patent and Trademark Office’s (the “Office” or the “USPTO”) invitation for comments on the USPTO’s *Berkheimer* memorandum, which provides guidance on the limited question of when a claim element represents “well-understood, routine, conventional activity” for purposes of assessing subject-matter eligibility. The views expressed herein have not been approved by the House of Delegates or the Board of Governors of the American Bar Association and, accordingly, should not be construed as representing the policy of the ABA.

The Section thanks the Office and Director Iancu for involving stakeholders as the Office provides examination guidance and encourages the Office to continue its outreach. The Section welcomes opportunities to provide further assistance to the Office, and looks forward to continuing to work with the Office on future reforms to examination guidelines.

The *Berkheimer* memorandum reflects another commendable effort by the USPTO in proactively addressing ambiguity and uncertainty created by current jurisprudence on subject-matter eligibility. The Section believes that the memorandum is a valuable resource for stakeholders and the examining corps and that it will help to reduce eligibility rejections that lack factual foundation.

Opportunities remain, however, for the USPTO to clarify further how the limited question addressed by the *Berkheimer* memorandum fits into the *Alice* framework and to address broader aspects of the underlying Federal Circuit *Berkheimer* decision regarding technology-specific improvements, beyond the limited question from the memorandum.

The Section believes that the memorandum provides clear and practical guidance with regard to the limited question it addresses, namely, “whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity.”

The memorandum’s guidance could be improved by clarifying how the limited question addressed by the *Berkheimer* memorandum fits into step two of the *Alice* framework. The examining corps commonly encounters situations in which each additional element beyond the abstract idea *independently* may be considered conventional, but the *combination* of elements cannot be definitively recognized as conventional. The memorandum and the MPEP do not squarely address whether, in this situation, the combination of additional elements supplies the required inventive concept for patent eligibility. The MPEP currently indicates that, if the combination of added elements is unconventional, the combination will “in most cases” amount to an inventive concept. MPEP 2106.05(d). But it remains unclear after the memorandum precisely when an unconventional combination will be inventive, and when it will not be. The *Berkheimer* memorandum should emphasize to the examining corps that claim elements should not be considered individually to determine whether they are well-understood, routine, and conventional activity. Rather, each claim should be considered as a whole in the ordered combination it is presented to assess whether the claim is directed to an abstract idea, and if so, whether the claim as a whole represents significantly more than the abstract idea.

Current jurisprudence indicates that an otherwise unconventional combination of elements can supply an inventive concept if it provides a technology-specific improvement. *See, e.g., Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1351 (Fed. Cir. 2016) (Claims recited “a technology-based solution . . . to filter content on the Internet that overcomes existing problems with other Internet filtering systems.”). The outcome for each claim in *Berkheimer* ultimately turned on whether the claim recited an inventive “improvement in computer functionality.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1370 (Fed. Cir. 2018). In claim 1, for example, the combination included undisputedly “conventional limitations” that were “combined with” other limitations not identified as conventional. *Id.* Even though the entire combination was not proven to be conventional, the Federal Circuit nevertheless held the claim invalid because the combination failed to “transform the abstract idea into a patent-eligible invention.” *Id.* Specifically, the invalid claims did not provide an improvement in computer functionality or other technology-specific improvement as a matter of law. *Id.* The remaining claims, however, arguably recited such an improvement because they required data to be stored in a “reconciled object structure” that allowed a computer system to operate more efficiently. *Id.* For those remaining claims only, the additional question of whether the claimed combination was conventional presented a material question of fact. *Id.* Thus, the factual question of whether the combination was conventional had to be reached for some claims, but not others. The USPTO’s guidance could be improved by clarifying this aspect of the analysis within the *Alice* step-two framework.

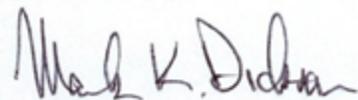
During prosecution, some eligibility rejections do not address certain claim limitations at *Alice* step two because examiners erroneously regard those limitations as “part of” the abstract idea previously identified at step one. *Berkheimer* applies the correct analysis. For example, in *Berkheimer*’s claim 4, the abstract idea was “parsing, comparing, and storing data.” The critical limitation in claim 4 was “storing a reconciled object structure in the archive without substantial redundancy.” Some examiners might believe that this entire limitation need not be considered at *Alice* step two because “storing” was already identified as part of the abstract idea. But the particular structure (“reconciled object structure”) and benefits (“without substantial redundancy”) of the claimed data storage approach were not part of the abstract idea, and the *Berkheimer* decision relied on those particulars to find that the claim recited an inventive concept. As *Berkheimer* shows, even if a claimed feature is abstract at a high level, specific recitations of that feature can represent a technology-specific improvement.

The Section recommends that future guidance by the USPTO on *Berkheimer* clarify how the limited question addressed by the memorandum fits into the *Alice* framework, particularly with regard to the issue of whether a combination reflects a technology-specific improvement. Consistent with the *Berkheimer* decision, to identify a technology-specific improvement, examiners should consider 1) whether the claim recites a purported improvement, 2) whether the purported improvement is technology-specific, and 3) whether the purported improvement is conventional. If any part of a claim limitation recites a purported improvement that is technology-specific and not provably conventional, then the claim contains an inventive concept.

Section III.A.1 of *Berkheimer* memorandum provides that an examiner may find that a claim element is well-understood, routine, and conventional if the specification or a statement by the applicant during prosecution demonstrates that the claim element is well-understood, routine, and conventional. The *Berkheimer* memorandum should be revised to require applicant admissions to be clear and express for an examiner to rely on such admissions to find that a claim element is well-understood, routine, and conventional. In addition, the Section recommends that the Office encourage examiners to support any examiner declarations or affidavits with factual evidence. In general, citations to the specification or a publication (e.g., another patent) should be preferred over the other options set forth in Section III.A.1 for the examiner to support a finding that a claim element is well-understood, routine, and conventional.

The Section appreciates the USPTO’s proactive steps toward clarifying the state of subject-matter eligibility jurisprudence and believe the foregoing comments would even further assist stakeholders and the examining corps in understanding how the *Berkheimer* decision fits into that jurisprudence. We would be pleased to further discuss these comments with the USPTO and others as appropriate.

Very truly yours,



Mark K. Dickson
Chair, ABA Section of Intellectual Property Law