

March 8, 2019

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United States Patent and Trademark Office  
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Attn: Andrei Iancu, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office

**RE: Comments on 2019 Revised Subject Matter Eligibility Guidance**

Dear Director Iancu:

Schwegman Lundberg & Woessner, P.A. (“SLW”) thanks the United States Patent and Trademark Office (“the Office”) for the opportunity to comment on its 2019 Revised Subject Matter Eligibility Guidance (“the Guidance”) set forth at 84 FR 50.

We commend the Office in its efforts, and believe the Guidance represents a substantial step towards achieving reasonably consistent and predictable results across applications, art units, and technological fields, and helping stakeholders and examiners navigate complex and changing Federal Circuit and Supreme Court precedent. Given such, we request that the Office consider the following:

**I. Step 2A, Prong 1, “tentative abstract ideas”**

The Guidance sets forth three distinct groups of abstract ideas: (a) Mathematical concepts; (b) Certain methods of organizing human activity; and (c) Mental processes. *See* 84 FR at 52. The Guidance then sets forth a process for determining additional, yet unknown “tentative abstract ideas”. *See id.* at 57. Although repeatedly describing occurrence of such “tentative abstract ideas” as “rare,” the Guidance does not provide any limits, boundaries, or clarity on any

processes taken by the Technology Center Director of declaring such, or any transparency of such processes or determination to stakeholders.

The existence of additional, undefined “*tentative abstract ideas*” substantially mitigates the benefit to stakeholders of designating the three distinct categories; the Guidance defines “what is”, while providing few boundaries for stakeholders to determine “what is not”, except a desire that such circumstances be “*rare*”. It is exceedingly difficult, for both examiners and stakeholders, to determine, in the context of a single examination, whether any one examination is a “*rare circumstance*”, which substantially mitigates stakeholders’ ability to overcome proposed application of such in the abstract, whether “*rare*” or not.

Moreover, the Guidance seemingly discourages any finding of a claim as not reciting an abstract idea by directing examination to proceed to Prong 2 and Step 2B regardless of whether a claim is not directed to any of the three distinct groups of abstract ideas. *See id.* at 56 – 57.

We commend the Office for its designation of three distinct groups of abstract ideas and its clear explanation that such ideas are still eligible if integrated into a practical application. We understand the need for such designations to remain fluid to accompany evolving Federal Circuit and Supreme Court precedent; however, we propose that the Office consider limiting the Guidance to the three distinct groups and exercise its authority to provide additional updated guidance, with notice, public comments, and transparency, at the time such additional groups are determined, instead of appearing to leave the decision of additional abstract ideas to the individual Technology Center Directors, separately, and outside the view of stakeholders.

## **II. Step 2A, Prong 2, “*additional elements*”**

The requirements of a claim as set forth in the CFR and captured in the MPEP require, e.g.: (1) a preamble; (2) a transitional phrase; and (3) elements, steps, and/or relationships which the application considers as new or improved. *See* MPEP 608.01(i); 37 CFR 1.75. “Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.” *Id.* Accordingly, the term “element” has particular meaning in the context of a patent claim, often referring to the separate indented clauses of a claim.

The Guidance clearly states that “examiners should evaluate whether the claim *as a whole* integrates the recited judicial exception into a practical application of the exception.” 84 FR at 54 (emphasis added). However, the Guidance then states that “Examiners evaluate

integration into a practical application by: (a) identifying whether there are any *additional elements* recited in the claim beyond the judicial exception; and (b) evaluating those *additional elements individually and in combination* to determine whether they integrate the exception into a practical application....” 87 FR at 54 – 55 (emphasis added).

Use of such terms “*additional elements*” and “*additional elements individually and in combination*” in the Guidance, even if originating from a judicial opinion, may result in examiners removing significant elements of a claim from their analysis for not being “*additional elements*” to the judicial exception, thereby improperly discounting substantial portions of the claim when determining whether the claim recites a practical application beyond the judicial exception. We propose that the Office consider rephrasing such “*additional elements*” language as “subject matter in addition to the judicial exception” to alleviate such concerns, and ensure the claim is considered *as a whole* when determining if a judicial exception is integrated into a practical application.

### **III. Step 2A, Prong 2, “meaningful limit”**

The Guidance states that, “A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a *meaningful limit* on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” *Id.* at 53; 54 (emphasis added). However, the Guidance provides no explanation as to what a “*meaningful limit*” may be. We propose that the Office add examples of meaningful limitations, such as when the claim limits the judicial exception to one of several possible implementations or a particular technological environment. *See* MPEP 2106.05(e).

### **IV. Step 2A, Prong 1, laws of nature and natural phenomena**

On June 7, 2018, the Office provided a memorandum to the Examining Corps concerning the Federal Circuit decision in *Vanda Pharmaceuticals, Inc. v. West-Ward Pharmaceuticals*. *See* R. Bahr, memorandum of June 2018: “Recent Subject Matter Eligibility Decision: *Vanda Pharmaceuticals, Inc. v. West-Ward Pharmaceuticals*” (“*Vanda Memorandum*”). Although the Guidance only briefly discusses laws of nature and natural phenomenon, we recommend that the Office add a citation to the *Vanda Memorandum* at the close of the paragraph at col. 3 of 84 FR

54 beginning, “For laws of nature and natural phenomena...” We propose that the additional footnote include language from the memorandum that, “(1) ‘method of treatment’ claims that practically apply natural relationships should be considered patent eligible under Step 2A of the USPTO’s subject matter eligibility guidance; and (2) it is not necessary for ‘method of treatment’ claims that practically apply natural relationships to include nonroutine or unconventional steps to be considered patent eligible under 35 USC s. 101.” *Id.* at 2 – 3.

In addition, we recommend that footnote 20 be amended to include a citation to the *Vanda Memorandum*. Although the Guidance states that it supersedes MPEP 2106(II) for all judicial exceptions, including laws of nature or natural phenomena, this position conflicts with MPEP 2016.04(b)(I), which states that if a claim “recites” – not “is directed to” – a law of nature or a natural phenomenon it is directed to a judicial exception and requires further analysis in Step 2B. *See* MPEP 2106.04(b)(I). Further, we recommend that the following portion of footnote 20 be amended as follows: “For more information about ~~laws of nature and natural phenomena~~ such claim limitations, including products of nature, see MPEP 2106.04(b) and (c).” *See* 84 FR at 54 n.20.

Lastly, we propose that footnote 31 be amended to more completely summarize the holding in *Mayo*, e.g., “concluding that additional steps of administering a drug to a subject and measuring the metabolites of the drug was insignificant extra-solution activity, which was insufficient to confer patent eligibility on the naturally-occurring diagnostic correlation recited in the claim.” *Id.* at 55 n.31.

## **V. Conclusion**

We commend and support the Office in its efforts, and believe the 2019 Revised Subject Matter Eligibility Guidance represents a substantial step towards achieving reasonably consistent and predictable results across applications, art units, and technological fields, and helping stakeholders and examiners navigate complex and changing Federal Circuit and Supreme Court precedent.

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Respectfully submitted,

/Steven W Lundberg/

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