Comments regarding the **Patent Eligibility Jurisprudence Study**, Docket No. PTO-P-2021-0032

Submitted October 15, 2021 by Stephen S. Mosher, Registered Patent Attorney No. 33,974

I am a patent attorney currently practicing as a patent prosecutor in Fort Worth, Texas with the law firm Whitaker, Chalk, Swindle & Schwartz PLLC. The comments and opinions submitted respectfully herein are my own and do not represent the policies of this law firm.

In my practice I have received and responded to a number of Examiner's Office Actions that reject the claims of an application that embodies a computer on eligibility grounds under 35 U. S. C. §101, the utility requirement for patent-eligible subject matter. These rejections typically cite and apply the Two-Part Test required by the 2019 Patent Eligibility Guidelines (the "PEG") issued by the U. S. Patent and Trademark Office.

While this test is useful to guide the analysis of a patent claim that includes computing elements, this test and the case law referenced in the PEG sets a higher standard for utility of a computer than a "process, machine, manufacture, or composition of matter." The PEG interprets utility under §101 for claimed subject matter considered abstract under the "Judicial Exceptions" to §101 because a computer requires program instructions. These exceptions are typically stated as "abstract ideas (such as a mathematical formula or equation), natural phenomena, and laws of nature." See, e.g., MPEP, Ninth Ed., §2106.04, Part I. Computer-based inventions are especially susceptible to examination under these Judicial Exceptions to Section 101.

A computer or processor is a versatile computational apparatus whose parts and functions can be organized or utilized in specific, defined ways by its programmed instructions to perform a specific operation or a sequence of operations that solves a defined problem. A software programmer, if given sufficient information about the purpose and structure of the system that embodies a computer or processor and how it should be configured, along with the process steps that the computer needs to execute the sequence of operations, can write the program instructions from the given and sufficient information contained in the claims as further informed by the written description. A computer can thus provide utility in a wide variety of purposeful embodiments.

In inventions that include a computer and/or the program instructions in their embodiments, the program instructions are often analyzed as lists of instruction steps that could each be carried out by pencil and paper or as mental steps and characterized during examination as abstract ideas executed by well-understood, routine, conventional, computer activity. But it is a serious error when the process step or element is considered in isolation out of context. This kind of consideration occurs all too often in the Detailed Actions returned to the applicants for patent.

One example concerns a claimed invention that embodies a computer controlled by programmed instructions wherein the computer processor is one functional element of a claimed system or method organized to solve a problem and produce a specific improvement to the field of subject matter of the invention. During examination, one criterion from the PEG often cited is

that the claimed invention must provide an improvement to the operation of the computer. However, in many inventions that use a programmed computer, improvement to the operation of the computer is not the point of the invention. Thus it is not an applicable standard by which to evaluate the eligibility of such claimed system or method.

In a second example, a Detailed Action alleged that the independent claims are ineligible under Section 101 because they are directed to an abstract idea. But the Examiner's 101 rejection remarks stated little more than a restatement of the PEG rationales themselves. Citing and quoting the PEG alone is not evidence to support a rejection under Section 101. It is respectfully submitted that such examination is conclusory and improper.

In a third example, a Detailed Action asserted that it has considered all elements and steps of each claim, both individually and as a whole combination. Yet the basis for the rejection in fact considered each element and step *in isolation* from the claimed combination, which in that case included a computer executing several routine or conventional steps along with other elements. The Examiner concluded thereby that the claims as a whole combination lacked utility under Section 101. There was no evidence provided, that the *concise, ordered combinations* of the claims that included other elements besides the computer, was ineligible for patenting.

These problems arise because the patent examination system, in particular the regulations that govern the examination of inventions that include programmed computational apparatus, lack clear definitions and guidance in analyzing such inventions. The resulting ambiguity permits Examiners in their discretion to sidestep consideration of a claim as a whole combination, when that claim includes a computer that executes specific process steps. When the Examiner's analysis is mistaken, the Applicant is placed under a heavy and often costly burden to prove the Examiner's error. In this way, Article I, Section 8, Paragraph 8 of the U. S. Constitution is not well served.

What is needed in the Eligibility Examination Guidelines – or better, in the Regulations of the U. S. Patent and Trademark Office – are requirements for examination of patent claims under 35 U. S. C. §101 that (a) state the context of the invention claimed and that the whole claimed combination has been examined in the context of the invention; and (b) state the evidence relied on to support a rejection under §101 of the Patent Statute. This information would be more useful to an Applicant in explaining bona fide rejections for eligibility and should lead to better patents.

What may be needed in the Patent Statute is: (1) add the term "computer" to the list of patentable subject matter under §101; and (2) add a definition of "computer" such as: "A computer is a computational apparatus or machine having program instructions expressed as a process in symbolic terms." Further, regulation of examination of applications for patent might be improved by: A computer may be patent-eligible subject matter as (a) configured for a specific new purpose; (b) a novel, improved configuration; or (c) part of a new combination including either (a) or (b).

Respectfully Submitted,

Stephen S. Mosher, Reg. No. 33,974