

**From:** Rob Jacobson [e-mail redacted]  
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**To:** 2014\_interim\_guidance  
**Subject:** Comments on July Update

To whom it may concern,

Thank you very much for providing the additional guidance in the July Update. It provides much needed clarification on several key areas and represents meaningful progress in the understanding of the current §101 framework. That said, there are a few issues from the 2014 Interim Eligibility Guidance (IEG) not addressed by the July Update. Further, it should be understood that these comments represent my individual opinion and should not be attributed to any organization to which I am affiliated.

1) The use of “another” in “improvements to another technology”

The IEG notes that:

Limitations that may be enough to qualify as “significantly more” when recited in a claim with a judicial exception include:

- Improvements to another technology or technical field;
- Improvements to the functioning of the computer itself. (IEG at 74624).

However, in this recitation, it is unclear what the word “another” references. There are several possible interpretations, for example, “another” may mean a technology other than the one implicated by the general thrust of the claims. “Another” may also mean a technology other than one intertwined with concept identified as an abstract idea in Step 2A. Without any guidance, one may draw any number of different interpretations of the word “another.” However, the Supreme Court clearly and definitively resolved this issue.

To this end, in *Alice*, the claims were found ineligible, at least in part, because “[t]he method claims do not, for example, purport to improve the functioning of the computer itself. See *ibid.* (“There is no specific or limiting recitation of ... improved computer technology ...”); Brief for United States as *Amicus Curiae* 28–30. Nor do they effect an improvement in any other technology or technical field.” *Alice Corp. Pty. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2359 (2014). The use of the word “nor” makes clear the Supreme Court intended “the functioning of the computer itself” to be the “other” technology or technical field. Thus, the Supreme Court actually stated that improvements to *any* technology or technical field qualify as “significantly

more” under Step 2B. However, the IEG inverts the listing of the “other technology or technical field” improvements and the “functioning of the computer itself” improvement. This inversion removes the clarity provided by the Supreme Court.

This lack of clarity may cause inaccurate outcomes of the subject eligibility analysis. For example, consider Claim 2 of Example 21 provided as part of the July Update. In the corresponding Step 2A analysis, the analysis identifies the concept of “comparing and organizing data for transmission” as the abstract idea in Step 2A. Yet Claim 2 is eligible because it “addresses the Internet-centric challenge of alerting a subscriber with time sensitive information.” However, one may consider alerting (*i.e.*, transmitting) a subscriber with time sensitive info to be a part of the general field implicated by concept of “comparing and organizing data *for transmission*.” Said another way, the improvement recited in Claim 2 relates to the abstract idea. Thus, without clarity as to what the word “another” references, an examiner may inappropriately reject Claim 2 as only reciting an improvement to the abstract idea, and not *another* technology or technical field.

Further, the lack of clarity as to what “another” references leaves the interpretation up to the examiner. As a result, different examiners may interpret “another” to reference different concepts. Thus, the IEG, as it is currently worded, increases the variation in outcomes between and among different examiners.

To resolve these issues, it is recommended that the IEG is amended to clearly indicate that the use of the word “another” refers to a technology or technical field that is not “the functioning of the computer itself” and/or combines these example limitations into a single limitation of “improvements to any technology or technical field.” If the latter approach is chosen, additional instruction should be provided to examiners in order to reinforce that improvements to the functioning of the computer itself are considered a technology or technical field.

## 2) Claims that recite a plurality of judicial exceptions

The IEG states that “[f]or a claim that is *directed to* a plurality of exceptions, conduct the eligibility analysis for one of the exceptions.” IEG at 74625. However, the entire section on the recitation of multiple exceptions is devoid of a single citation. To this end, there is not a single court that has determined that a claim is *directed to* multiple exceptions in Step 2A. As a result, the USPTO is creating a new legal framework and not simply implementing a judicial framework.

Moreover, the USPTO-invented solution to this problem is inconsistent with the July Update and contradicts itself. The July Update makes clear that “examiners are to consider all *additional elements* both individually and *in combination* to determine whether the claim as a whole amounts to significantly more than an exception.” July Update at 1-2 (Underline original, italics added). Thus, examiners are to analyze the *combination of additional elements* in Step 2B. To this end, the IEG states that “[a]dditional elements that satisfy Step 2B for one exception will likely satisfy Step 2B for all exceptions in a claim.” IEG at 74625. However, the IEG then

states that “if the claim fails under Step 2B for one exception, the claim is ineligible, and no further eligibility analysis is needed.” IEG at 74625. However, this solution is only true if the additional elements are considered *individually*.

Consider a claim consisting of steps A, B, and C. The examiner identifies that A and B are abstract ideas and that the claim is directed to both of A and B individually. Thus, the July Update states that when analyzing the significance of the “additional elements,” the examiner is supposed to analyze the combination of both the combination of B+C and A+C when conducting the analysis with respect to abstract ideas A and B, respectively. Now consider that the particular synergies between A and C cause the A+C combination to recite “significantly more” than abstract idea B. Conversely, consider that the same synergies are absent in the B+C combination, causing the B+C combination not to recite “significantly more” than abstract idea. As a result, the Step 2B analysis results in the additional elements satisfy Step 2B with respect to abstract idea A and fails Step 2B with respect to abstract idea B. Paradoxically, the IEG solution instructs the examiner to find the claim both eligible and ineligible.

Since no court has found a claim to be *directed to* multiple exceptions, the examiner has no guidance on how to resolve this paradox. As a result, any action taken by the examiner will contradict both the IEG and the current judicial framework. Thus, in order to avoid USPTO-created paradoxes, it is recommended that the USPTO waits until the courts have provided guidance prior to establishing a framework for analyzing claims directed to multiple exceptions.

### Conclusion

I appreciated the opportunity to respond to the July Update and encourage the continuation of seeking public feedback on any further guidance with respect to the subject matter eligibility framework.

Sincerely,

Rob Jacobson