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One Weird Trick to Beat Alice Rejections (Examiners HATE This)

Alice v. CLS Bank has had a tremendous impact on how the patent office treats applications for business method inventions. Indeed, since the Supreme Court's decision in *Alice*, the allowance rate for class 705 (Data Processing: Financial, Business Practice, Management, or Cost/Price Determination) dropped from a pre-*Alice* high of 31.2% in 2013, to 23.5% in 2014, 9.4% in 2015, and 4.7% in 2016.^[1] [In a previous article](#)^[2] I explained that one way to try and deal with this was to avoid claims which described something which sounded like a business method, even if doing so meant that the claims had to be somewhat vague. However, that may not be possible in all cases, and so the question becomes what to do when you've already been pigeonholed as a business method and need to overcome a rejection based on *Alice*.

The allowance rate statistics for class 705 reflect how difficult it is for a patent applicant to overcome an *Alice* rejection, but a close reading of the Federal Circuit's opinion in *Enfish, LLC v. Microsoft Corporation*^[3] suggests a way forward. In that case, the Federal Circuit reversed a determination that a claim was directed to ineligible subject matter because "the district court oversimplified the self-referential component of the claims and downplayed the invention's benefits."^[4] However, the "self-referential component" wasn't explicitly recited in the claim in question. Instead, it was incorporated as part of the supporting structure for a "means for configuring" that the claim actually did recite.^[5] Given that how a claim's limitations should be treated when determining what it is "directed to" is often a point of contention when analyzing subject matter eligibility,^[6] the fact that means + function limitations are required by statute to be construed as covering the supporting structure described in the specification and its equivalents^[7] could provide a useful tool for responding to *Alice* rejections.

So can using means + function language in this way actually overcome *Alice* rejections? Yes, but examiners hate it. In one example from my practice, we were able to overcome an *Alice*

rejection using a pre-appeal brief by pointing out that the rejection relied on improperly interpreting a software implemented means + function limitation as simply “a computer configured to perform processes.” Unfortunately, rather than this leading to the application being allowed, the result was that prosecution was re-opened with an 89 page long office action that attacked the means + function language at length for (allegedly) being both indefinite and not properly supported. Ultimately, we were able to overcome those rejections as well, but it required submission of a declaration walking through the corresponding structure in the specification and explaining how it would be understood by one of ordinary skill in the art. I believe the fact that we got the rejections in the first place and had to make such a submission to overcome them reflects a significant level discomfort on the part of the examiner (which I believe is much less the exception than the rule within the PTO) with software implemented means plus function limitations. Nevertheless, despite the fact that it might require dealing with an unfamiliar mode of analysis, if you’re faced with an *Alice* rejection, means + function language might just be the one weird trick you need to get a patent.

[1] All figures taken from the Allowance Rate by USPC Class visualization in the patent office’s beta open data portal, available here: <https://developer.uspto.gov/visualization/allowance-rate-uspc-class>.

[2] William Morriss, *What’s Happened to Software Inventions? Five Unexpected Facts that will Change how you see Patent Eligibility*, available at <https://fbtgibbons.com/resources-what-happened-to-software-inventions-5-changes-in-patent-eligibility.html>.

[3] 822 F.3d 1327 (Fed. Cir. 2016).

[4] *Enfish*, 822 F.3d at 1338.

[5] *Id.* at 1337:

Here, the claims are not simply directed to *any* form of storing tabular data, but instead are specifically directed to a *self-referential* table for a computer database. For claim 17, this is reflected in step three of the “means for configuring” algorithm

described above.

[6] See, e.g., *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348–49 (Fed. Cir. 2016):

BASCOM asserts that claim 1 is “directed to the more specific problem of providing Internet-content filtering in a manner that can be customized for the person attempting to access such content while avoiding the need for (potentially millions of) local servers or computers to perform such filtering and while being less susceptible to circumvention by the user,” ... We recognize that this court sometimes incorporates claim limitations into its articulation of the idea to which a claim is directed. See *Enfish*, 822 F.3d at 1337 (relying on a step of an algorithm corresponding to a means-plus-function limitation in defining the idea of a claim for step-one purposes). This case, unlike *Enfish*, presents a “close call[] about how to characterize what the claims are directed to.”

[7] *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994):

The plain and unambiguous meaning of paragraph six is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure. Paragraph six does not state or even suggest that the PTO is exempt from this mandate, and there is no legislative history indicating that Congress intended that the PTO should be.

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