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Patent Office Speechless!! Fed. Cir. Says Evidence Needed for Ineligibility

Despite contrary statements in certain board decisions,^[1] the patent office's guidance to the examining corps has been consistent: facts are unnecessary when rejecting a claim under 35 U.S.C. § 101. Early on, the patent office's July 2015 subject matter eligibility update responded to concerns about whether examiners were properly making out a prima facie case of ineligibility by stating that patent eligibility was a question of law, and that no facts were necessary to make out a prima facie case.^[2] The MPEP has also been amended to reflect this view,^[3] and the superfluity of facts to eligibility appears to be a foundational assumption for the application of section 101 during examination.^[4]

However, in light of the Federal Circuit's recent decision in *Berkheimer v. HP, Inc.*, the end of fact-free subject matter eligibility determinations may be near. In *Berkheimer*, the claims at issue were found to be directed to an abstract idea, so the case turned on whether the claims included additional elements sufficient to transform the nature of the claim into a patent eligible application rather than a patent ineligible abstraction.^[5] The district court found that there were no such additional elements, because what additional elements the claims did recite described "steps that employ only 'well-understood, routine, and conventional' computer functions ... at a high level of generality."^[6] The patent owner disagreed, arguing that portions of the patent's specification referring to various benefits provided by the invention contradicted the finding that the claims described well, understood, routine, and conventional activities.^[7] The Federal Circuit then analyzed the claims and, because it found that some of them recited steps for providing the improvements described in the specification,^[8] vacated the district court's holding of ineligibility.^[9] More important than the result though, was the reasoning. The Federal Circuit specifically explained that the allegations of improved results from the specification created an issue of fact,^[10] and that "the district court erred in concluding that there are no underlying factual questions to the § 101 inquiry."^[11] It also stated explicitly

that “whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact” and that “[a]ny fact, such as this one, that is pertinent to the invalidity conclusion must be proven by clear and convincing evidence.”^[12] – i.e., the exact opposite of the patent office’s position on the issue.

Before posting this article, I called the PTO’s office of patent legal administration to ask if they were aware of the *Berkheimer* case and if they intended to update their guidance in light of its holding. While I was told that they were aware of the case, the person I spoke to did not know if there were plans to issue updated guidance based on its reasoning, or (if such updated guidance was in the works) when such updated guidance might be issued. Accordingly, at least for the foreseeable future, it appears that the primary channel for Examiners to be made aware of the *Berkheimer* case may be through their interactions with patent prosecutors.^[13] However, given the potential significance of treating eligibility as involving underlying questions of fact, it would seem highly inappropriate for the PTO not to react to *Berkheimer*. As a result, while they may not be saying anything about it now, this is an issue where they shouldn’t remain speechless for long.

This article was originally posted by William Morris on [EPHEMERALLAW](#), view the original here: [PTO Speechless!! Fed. Cir. Says Evidence Needed for Ineligibility](#)

^[1] See, e.g., *Ex parte Poisson*, Appeal No. 2012-011084 on application 12/427,040 (PTAB 2015) at 5:

The PTO bears the initial burden of establishing a prima facie case of patent-ineligible subject matter under 35 U.S.C. § 101. Because the facts and evidence do not support the finding that claim 1 is “an attempt to claim a new set of rules for playing a card game” and therefore, necessarily, is an abstract idea, a prima facie case of patent-ineligible subject matter under 35 U.S.C. § 101 has not been established in the first instance by a preponderance of the evidence.

^[2] July 2015 Update: Subject Matter Eligibility, *available at* <https://www.uspto.gov/sites/default/files/documents/ieg-july->

[2015-update.pdf](#) at 6:

Concern was expressed about examiners satisfying the proper burden for a prima facie case when making an eligibility rejection. ...

The courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings.

[3] See MPEP 2106.07(a)(III) (“the courts do not require any evidence when conducting the significantly more inquiry, even where additional elements were identified as well-understood, routine and conventional in the art.”).

[4] See, e.g., Office Action of August 28, 2015 on application 12/610,069 at 18–19:

Applicants argue that the Examiner “merely asserts the claim is directed to the abstract idea of generating, transmitting, and providing an advertisement to a consumer.” The undersigned notes that the unsupported assertion appears to be little more than boilerplate not supported by an[y] evidence or analysis.” Examiner replies that the “courts consider the determination of whether a claim is eligible (which involves identifying whether an exception such as an abstract idea is being claimed) to be a question of law. Accordingly, courts do not rely on evidence that a claimed concept is a judicial exception, and in most cases resolve the ultimate legal conclusion on eligibility without making any factual findings.”

[5] *Berkheimer* at 11–12:

Because the claims are directed to an abstract idea, we proceed to the second step of the *Alice* inquiry. At step two, we “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent eligible application.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 78–79).

[6] *Id.* at 13.

[7] *Id.*

[8] *Id.* at 17 (“These claims recite a specific method of archiving that, according to the specification, provides benefits that improve computer functionality.”).

[9] *Id.* (“We vacate the district court’s grant of summary judgment that claims 4–7 are ineligible under § 101 and remand for further proceedings.”).

[10] *Id.* (“there is at least a genuine issues of material fact in light of the specification regarding whether claims 4–7 archive documents in an inventive manner that improves these aspects of the disclosed archival system.”)

[11] *Id.* at 14.

[12] *Id.* at 12.

[13] Indeed, even in areas where the PTO does provide guidance, interactions with patent attorneys may constitute a type of on the job training that could have a significant impact on how applications are handled. See *Who Trains Whom*, just-n-examiner, available at <http://just-n-examiner.livejournal.com/25641.html> (visited Feb. 13, 2018).

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