

Before the
United States Patent and Trademark Office
Alexandria, VA

In re

Preliminary instructions regarding *Alice Corp. v. CLS Bank International*

**COMMENTS OF
COMPUTER & COMMUNICATIONS INDUSTRY ASSOCIATION**

Pursuant to the request for comments issued by the United States Patent and Trademark Office (“USPTO”) and published in the Federal Register at 79 Fed. Reg. 36,786 (June 30, 2014), the Computer & Communications Industry Association (“CCIA”)¹ submits the following comments regarding the USPTO’s preliminary instructions to examiners for applying the U.S. Supreme Court’s decision in *Alice Corp. v. CLS Bank International* (“*Alice*”).

I. Comments

The central issue addressed in *Alice* is: when is a patent claim that includes software eligible subject matter for patentability under 35 U.S.C. § 101? The Supreme Court’s decision is both an affirmation of earlier Supreme Court decisions as well as a significant departure from recent guidance from the U.S. Court of Appeals for the Federal Circuit. We applaud the USPTO for issuing its *Alice* instructions quickly and for seeking input from stakeholders in developing more detailed instructions.

The patent system functions best when patent boundaries are clear and easy to identify. Such clarity allows companies to determine whether current activities infringe and make rational decisions about seeking licenses. It also encourages more innovation by enabling companies to develop design-around solutions.

¹ CCIA is an international nonprofit membership organization representing companies in the computer, Internet, information technology, and telecommunications industries. Together, CCIA’s members employ nearly half a million workers and generate approximately a quarter of a trillion dollars in annual revenue. CCIA promotes open markets, open systems, open networks, and full, fair, and open competition in the computer, telecommunications, and Internet industries. A list of CCIA members is available at <http://www.ccianet.org/members>.

Unfortunately, patents claiming computer-implemented inventions frequently have unclear boundaries. This is largely because, to date, some patents have been allowed to issue without much more than a description and recitation in the claims of an abstract idea implemented on a conventional computer system. The *Alice* decision makes clear that this practice is not consistent with 35 U.S.C. § 101, because such patent claims preempt all practical implementations of the abstract idea and stifle innovation.

Further, the public notice function is best served by clear claims and a thorough prosecution history explaining the examiner's understanding of those claims, as well as express statements by the applicant regarding the meaning of the claims. Computer-implemented inventions are too often patented using ambiguous, vague, or overbroad language. When such poor quality patents issue, they can become weapons in the hands of patent assertion entities, which currently drain billions of dollars a year from U.S. businesses.

Accordingly, CCIA believes that it is critical for both the examiner and the patent applicant to create a clear prosecution history. In the context of § 101 rejections, the examiner should provide more than a conclusory rejection. Rather, any rejection should identify the abstract idea to which the claim is directed. Further, such a rejection should explain the examiner's understanding of the claim's scope, including why the combination of claim elements do not add "significantly more" to the abstract idea, either expressly or through interpretation under 35 U.S.C. § 112(f). This analysis should include an explanation of whether a claim qualifies as a "means-plus-function" claim under section 112(f) and why or why not.

Similarly, in responding to a § 101 rejection, an applicant should be required to identify those elements of the rejected claim that she believes constitute "substantially more" than an abstract idea. Or, if the applicant believes that the claim should be treated as a means-plus-function claim under 35 U.S.C. § 112(f), the applicant should be required to state that belief clearly on the record.

Discussions in interviews regarding § 101 rejections should be summarized sufficiently so that a reader with no prior knowledge of the case can understand any agreement reached and/or any representations by a patent applicant upon which a patent examiner relied.

Although we recognize the time constraints of patent examiners and the expense of patent prosecution, the prosecution record cannot be left as an afterthought. The public, including U.S. operating companies, are entitled to know the boundaries of the patents that issue. The *Alice* instructions give the USPTO an opportunity to emphasize the importance of that clarity and the importance of a complete record.

We urge the USPTO to take advantage of this opportunity.

II. Conclusion

We applaud the USPTO for its speed and diligence in producing the *Alice* preliminary instructions. *Alice* represents a significant change in the law, and it is critical that examiners receive strong guidance in how to apply that change.

In conclusion, we believe that the USPTO's final *Alice* instructions should include requirements for both patent examiners and patent applicants to make a clear and complete record of both rejections under 35 U.S.C. § 101 and responses to such rejections.

Respectfully submitted,

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