

Factual Findings for Arguing a Post-Alice 35 USC §101 Patent Ineligible Subject Matter Rejection

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During patent prosecution, the **US Patent and Trademark Office (USPTO)** may reject claims in a patent application as being directed to an abstract idea as a judicial exception to patent eligible subject matter under 35 USC §101. The USPTO is considering cases on an individual basis, and has issued examination guidelines for patent subject matter eligibility (see USPTO 2014 Interim Guidance on Patent Subject Matter Eligibility), following the Federal and Supreme Court rulings in ***Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*** How do we, as patent practitioners, apply factual findings to argue for eligibility of subject matter in claims?

In a previous article by the present author, *Arguing a Post-Alice §101 “Abstract Idea” Rejection during Patent Prosecution*, the use of factual findings based on 35 USC §102 (anticipation) and/or 35 USC §103 (obviousness) analysis in answer to a 35 USC §101 “abstract idea” rejection was discussed, and various lines of inquiry and analysis were developed. Reg Ratliff, Esq., a colleague of mine here at the Silicon Valley branch of Womble Carlyle Sandridge & Rice has developed a specific model for a reply to an Office action regarding such a rejection, and has given permission for me to share and expound upon this. Below is an abstraction or template for a response to an Office action.

Setting up an example scenario, suppose the USPTO, during examination of a patent application, has issued an Office action rejecting the claims as patent ineligible subject matter, but has indicated some (or all) of the claims would be allowable under 35 USC §102 and 35 USC §103 provided the rejection under 35 USC §101 could be overcome. Or, the claims are rejected under 35 USC §102 and/or 35 USC §103, with various references cited. The patent practitioner finds a good, solid argument, or amends the claim(s) and then argues, that there are limitations in the claims that are not shown in the cited references. In these examples, the patent practitioner can present, in a reply, the USPTO acknowledgment that specified claim limitations are allowable, or the claim limitations argued by the patent practitioner as not found in the cited references, as factual findings. Let us call these the “distinguishing limitations”, as these limitations distinguish from that which is previously known, e.g., in the cited references.

Next, the patent practitioner can state, in the reply, the limitations which the Applicant acknowledges as known. These could be foundation elements, such as a processor (e.g., absent the novel instructions for performing the method), a server (absent the novel programming), a network, a substrate, a transistor (e.g., absent the novel circuit connections), a gear, cam or lever (e.g., absent

the novel mechanical connections), etc. By separating out the claim elements into a known foundation and the “distinguishing limitations”, the patent practitioner is setting up the argument.

The Office action, in this example, is seen to frame the claims in terms of an alleged abstract idea. One main argument to be made in a reply is that, while some or all of the foundational limitations can be found in the alleged abstract idea, the distinguishing limitations cannot. Particularly, the factual finding of allowable subject matter in the distinguishing limitations is a showing that the distinguishing limitations are not generally known, are not routine and conventional, are not found in the cited references, and are not found in the alleged abstract idea. The distinguishing limitations constitute the “significantly more” than the abstract idea, and constitute the “significantly more” than the instruction to implement the abstract idea on a generic computer (or a generic widget or whatever is being cited in the Office action).

The argument is then summed up as factual findings that the claim includes limitations not found in the alleged abstract idea, and that such distinguishing limitations, which are not generally known, show that the claim is significantly more than the abstract idea and significantly more than just implementing the abstract idea on a generic computer. The factual findings can also be presented as a showing that the claims do not attempt to preempt essentially all possible uses of the abstract idea, as the claims have narrower limitations, viz., the distinguishing limitations. And, the factual findings can be presented as a showing that the claims include concrete (i.e., non-abstract) limitations (these may be part of the known foundation), which are not part of the alleged abstract idea, and that the concrete limitations plus the distinguishing limitations (there may be some overlap) form a claim to a specific concrete article, or method involving a specific concrete article, etc., which, again, is not shown in the alleged abstract idea. Further arguments can be developed if there are factual findings that support that the claimed system, method or article shows improvements to computing technology or other technology, and that such improvements are not shown in the alleged abstract idea or in the known, cited art. In all of this, the patent practitioner emphasizes the factual findings.

Per a previous article by the author, “A Powerful Tool: Challenging Assertion during Patent Prosecution”, a USPTO attempt to dismiss relevant arguments as unconvincing, or an Office action that is unresponsive to factual findings, can be challenged as not properly Officially Noticed or not properly based upon common knowledge, per MPEP (the Manual of Patent Examining Procedure) 2144.03 “Reliance on Common Knowledge in the Art or ‘Well-Known’ Prior Art” section C, subtitled “If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or Not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence”. A USPTO Examiner assertion that the claims of the Applicant are not significantly more than an instruction to apply an alleged abstract idea to a generic computer (or other machine or article), or other 35 USC §101 rejection, can be challenged as not factually based, and not properly officially noticed nor properly based upon common knowledge, using the above factual findings.

By properly applying and properly insisting upon factual findings in a 35 USC §101 subject matter inquiry, the patent practitioner and the response to the Office action can argue for patent eligibility of the subject matter of the claims logically, with fact-based building blocks on a fact-based foundation. Such an approach also formally sets up for an appeal, should the subsequent Office action still reject the claims as patent ineligible subject matter under 35 USC §101. And, the prosecution history records all of the above, should a court challenge occur. This is part of the art of patenting.

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