

Case Law Arguments for “Abstract Ideas” Rejection of Patent Claims

Article By:

Christopher M. Hall

Ever since the **Supreme Court** ruling on *Alice Corporation Pty. Ltd. v. CLS Bank International, et al.*, patent practitioners have seen an historic increase in the number of 35 USC §101 “abstract ideas” rejections of patent claims in patent prosecution. We write Office action responses, and have Examiner interviews, yet sometimes it is not enough to convince an Examiner that claims are directed to patent-eligible subject matter, for we have heard from Examiners that the **USPTO (United States Patent and Trademark Office)** has assembled a committee that looks at patent subject matter eligibility issues in cases. One hint that more than one Examiner has mentioned is that there may be a comfort zone about claims, established by case law with which they are familiar, and that positioning claims relative to this comfort zone may be beneficial towards a positive finding of subject matter eligibility.

On January 27, 2015, the USPTO published “Examples: Abstract Ideas” as a companion to the “2014 Interim Eligibility Guidance”. This cites Federal Circuit rulings, some of which have found claims that are not patent eligible subject matter, and others of which found the claims are patent eligible subject matter. Below are suggested arguments that can bolster the assertion that claims are directed to statutory subject matter under 35 USC §101, by citing case law from the USPTO Examples document and comparing to present claims. Since Examiners may be familiar with the cases in the Examples document, they may be more comfortable with claims that are either similar in some way to cases that have rulings of patent eligibility, and/or claims that are dissimilar to cases that have rulings of patent ineligibility.

As an example, suppose the present claims have been rejected as being directed to an abstract idea implemented on a computer. A good question to ask is, are the claims directed to an abstract idea with a mere field-of-use limitation, or are the claims inextricably tied to a particular technological field? For instance, if the computer-implemented claimed subject matter solves a particular problem in a particular branch of medicine, vehicle or machine control, computing or communication, etc., or improves a specific technological process, the patent practitioner can argue that the claim is inextricably tied to a particular technological field. Possibly, the narrower the technological field, the better. Another good question to ask is, is a computer merely an accessory to performance of the claimed method, or is the computer required? Many computer-implemented inventions would be impossible for a human to perform using purely mental processes in any reasonable amount of time and with any reasonable expectation of accuracy. The patent practitioner can argue that a computer

is required for performing the claimed method. The above can be followed up by comparison to appropriate case law, with analysis of aspects of the claims in light of relevant court cases, a few of which are discussed as examples below.

In *SmartGene*, according to the USPTO 2014 Interim 101 guidance (Section IV.B.4), “Claim 1 does no more than call on a ‘computing device’ with basic functionality for comparing stored and input data and rules, to do what doctors do routinely” (emphasis added). In other words, doctors (people, performing mental tasks) routinely compare stored and input data and rules, and the computing device was employed in the claim to do so “to identify medical options”. By contrast, doctors or other people, performing mental tasks, are not capable of performing the present claimed method, a computer is required, as discussed above. In the present claims, the computer (or processor or other machine) is not merely called on to do what doctors do routinely. The present claims are thus unlike the patent ineligible claims of *SmartGene*.

In *Diehr*, according to the USPTO 2014 Interim 101 guidance (Section III, Example 3), “The combination of steps recited in addition to the mathematical formula show that the claim is not to the formula in isolation, but rather that the steps impose meaningful limits that apply the formula to improve an existing technological process. Thus the claim amounts to significantly more than the judicial exception. The claim is eligible.” Like the claims in *Diehr*, the present claims are not to a formula in isolation, but rather have meaningful limits that apply to improve a specific technological process, namely here in [fill in the technological process].

In *Flook*, according to the USPTO 2014 Interim 101 guidance (Section III, Example 4), “there is no disclosure relating to that system, such as the chemical processes at work, the monitoring of process conditions, the determination of variables in the formula from process conditions, or the means of setting off an alarm or adjusting an alarm system... The claimed invention focuses on the calculation of the number representing the alarm limit value using the mathematical formula. Thus, the claim is directed to a mathematical formula, which is like a law of nature that falls within the exceptions to patent-eligible subject matter.” By contrast, the present specification discloses a large amount of detail in support of how the various steps or actions of the claimed method are performed, and the present claim does not broadly attempt to claim just a mathematical formula with no further limitations. Unlike *Flook*, but like *Diehr*, the present claims are not to a formula in isolation. In *Flook*, “Limiting the claim to petrochemical and oil refining industries, such that the claim does not seek to wholly preempt the mathematical formula, is a field-of-use limitation that does not impose meaningful limits on the mathematical formula.” In the present claims, [fill in the technical area to which the claims are inextricably tied] is not a mere field-of-use limitation. The claimed method is specifically useful in [deriving, solving, whatever it is the claimed method or apparatus, etc., does], and the claim is thereby inextricably tied to [the technical area].

The patent practitioner should follow up these arguments, or weave into the arguments, factual findings wherever possible. For example, a factual finding about the necessity of using a computer or other machine, as recited in the claims and described in the specification, supports the assertion that the computer is required and the claims are thus strongly tied to a machine. A factual finding about the technical problem specific in a technical field that is solved by the claimed method or device, etc., supports the assertion that this is not a mere field-of-use limitation. Then, the patent practitioner has a number of factual findings in support of patent eligible subject matter that can outweigh unsupported Office action assertions that the claims are patent ineligible. It is particularly useful to point out when an Office action assertion is unsupported, and contrasted to a factually supported assertion.

Takeaways:

- Examiners may have a comfort zone about claims that in some way resemble claims of familiar cases with patentable subject matter, or that are dissimilar to claims of familiar cases without patentable subject matter.
- Comparing claims in an application under patent prosecution to claims in familiar cases can draw similarities to cases with patentable subject matter and dissimilarities to cases found to not have patentable subject matter.
- Tying a claim inextricably to a technological field, and arguing that, can powerfully support an assertion to patentable subject matter.
- Arguing that a computer or other machine is required for performing a method, which cannot be reasonably performed as a series of mental steps with any expectation of timeliness or accuracy, can support an assertion to patentable subject matter as the claim is strongly tied to a machine.
- Factual findings supporting arguments that the claims are to patentable subject matter should outweigh unfounded assertions that they are not.

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