

Patent Claim Preambles Post-Alice

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What is in the preamble of a patent claim? And, can the contents of the preamble influence the claim examination process? Ever since the US Supreme Court ruling in ***Alice Corporation Pty. Ltd. v. CLS Bank International, et al.***, patent claims have faced an elevated possibility of being rejected under 35 USC §101 as being directed to an abstract idea, or being not significantly more than an instruction to implement an abstract idea on a generic computer. The preamble introduces the limitations of the patent claim, and in so doing, sets the stage for interpretation of the claim and examination of the claim. Often, the preamble acts as a sort of title for the claim, and suggests a focus or primary subject matter for the claim.

We patent practitioners have seen, in Office actions from the **USPTO (United States Patent and Trademark Office)**, rejections of claims in which the material in the claim preamble is paraphrased or even quoted word for word as an abstract idea to which the claim is allegedly directed. This suggests a strategy for claim preambles. We may consider writing claim preambles that set forth just enough of an abstract idea to where there is plenty of material in the claim limitations, outside of the claim preamble, that can act as the “significantly more” that the Alice ruling suggests claims that have patent eligible subject matter should have. Too narrow a claim preamble might leave not enough in the claim limitations to convince an Examiner that the claim has significantly more than an instruction to implement the abstract idea (as set forth in the preamble) on a generic computer. Too broad a claim preamble, for example claiming just A method, comprising:, or A system, comprising:, does not set forth anything that the Examiner could grab as an alleged abstract idea and so does not shape the examination process.

An article, [“Judge Lourie Suggests Jepson Claims For Patent Eligibility”](#), by Courtenay C. Brinckerhoff (December 8, 2015), reviews the suggestion that returning to Jepson format claims might be helpful in patent eligibility. Although this suggestion is made with regard to diagnostic methods in medical innovations, it might apply to other types of claims. Generally, a Jepson format claim (to review) is of the form, An improved [article, method, system, etc., having certain features, often a quite detailed description], wherein the improvement comprises: [the limitations of claim]. This has a similar effect of setting forth the subject matter of the claim, by introducing in a preamble a brief description of subject matter from which the remaining claim limitations distinguish.

So, in both of the above ideas for preambles, the first of setting forth in the claim preamble a just right level of detail to frame an abstract idea, the second of setting forth in the claim preamble a known subject, presumably with patent eligible subject matter, the presentation of the remaining claim

limitations has a similar effect. The remaining claim limitations distinguish from the material in the claim preamble. During examination, if the claim is rejected as patent ineligible, directed to an abstract idea without significantly more, the argument is then to show that the remaining claim limitations constitute the significantly more.

And that is where inventiveness comes in. When the claim limitations have tangible aspects, and show inventiveness (for example, as argued in the Office action response under 35 USC §102 and 103 rejections), this can be argued as showing substantially or significantly more than an instruction to implement an alleged abstract idea on a generic computer, in the claims. This can be a stronger argument, if the preamble of the claim shapes perception of what the abstract idea is. It can then be argued in a straightforward manner that the distinguishing limitations, showing the inventiveness, are not shown anywhere in the abstract idea in and of itself. The abstract idea, per se, doesn't say how the generic computer implements the abstract idea, and doesn't say anything about the new distinguishing limitations, so these distinguishing limitations are substantially more. If the Examiner says otherwise, this can be challenged as not factually shown by the Examiner. In the Jepson format, one could even argue that the preamble shows the claim is directed to patent eligible subject matter, and the further limitations narrow that and show an improvement to a known process or article, which is patentable subject matter. This is all part of the art of patenting.

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