From: [e-mail address redacted]
Sent: Monday, September 27, 2010 11:37 PM
To: Bilski_Guidance
Cc: [e-mail address redacted]
Subject: Accenture Comments on USPTO Bilski Guidelines

Dear Sir or Madam:

Attached please find comments submitted on behalf of Accenture to the proposed Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of Bilski v. Kappos. Thank you very much.

Sincerely,

Wayne Sobon

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September 27, 2010

The Honorable David J. Kappos
Under Secretary of Commerce for Intellectual Property
and Director of the U.S. Patent and Trademark Office
Mail Stop Comments—Patents, Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Submitted by e-mail to: Bilski_Guidance@uspto.gov

I am writing to provide Accenture's comments on the Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*, issued July 27, 2010 ("Interim *Bilski* Guidance").

Accenture is one of the world's leading management consulting, technology services, and outsourcing organizations, serving 96 of the Fortune Global 100 and more than three-quarters of the Fortune Global 500. With approximately 200,000 people serving clients in more than 120 countries, Accenture collaborates with clients to help them become high-performance businesses. This strategy builds on Accenture's expertise in consulting, technology, and outsourcing to help clients create sustainable value for their customers and shareholders.

Accenture submits these comments in response to the U.S. Patent and Trademark Office ("PTO") request for comments on its Interim *Bilski* Guidance. Accenture commends the PTO for timely issuing this guidance and thanks the PTO for the opportunity to provide comments. The Interim *Bilski* Guidance supplements the PTO's previous Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101 ("Interim Instructions"), dated August 24, 2009, and Accenture incorporates its earlier comments responding to the Interim Instructions, which were filed on September 28, 2009.

Accenture filed an *amicus curiae* brief to the U.S. Supreme Court in support of the petitioners in *Bilski v. Kappos*, and nothing in these comments constitutes a change in Accenture's position as set forth in its *amicus curiae* brief. Furthermore, Accenture is mindful of, and does not believe it useful to repeat, a number of the very useful comments already submitted by organizations such as IPO and AIPLA.

We thank you for the opportunity to provide these comments.

Sincerely,

Wayne Sobon
Assistant General Counsel
Director of Intellectual Property

Accenture's Comments on the Interim Guidance for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*

- Accenture fully supports the PTO's goal of providing clear guidance for its examiners regarding examination of claims for patent-eligibility under 35 U.S.C. § 101 in light of the Supreme Court's recent decision in *Bilski v. Kappos*.

- In its decision, the Supreme Court exercised restraint, leaving many questions for future cases. Accenture advocates such a careful, case-by-case application of section 101 and commends the Interim *Bilski* Guidance for directing examiners to apply a prudent case-by-case analysis. Because section 101 is purposefully broad, the Supreme Court affirmed that a flexible approach is needed. Accenture therefore cautions against adopting any hard-and-fast rules or exhaustive lists for what constitutes patentable subject matter.

- Accenture shares the PTO's position in favor of compact prosecution and applauds the Interim *Bilski* Guidance for instructing examiners to complete a full examination of all patentability requirements, even when claims may appear questionable under section 101. We urge the PTO to continue to train examiners to engage applicants early, for example using personal interviews, to discuss and clarify any section 101 issues early in prosecution.

- Accenture encourages the PTO to caution examiners against interpreting *Bilski* too narrowly by treating the machine-or-transformation test as a default and then shifting the burden to applicants to rebut an "abstract idea" rejection. In the Summary section, the Interim *Bilski* Guidance states that it "supplements" the memorandum to the Patent Examining Corps on the Supreme Court Decision in *Bilski v. Kappos* dated June 28, 2010 ("Memorandum"). Accenture believes that the Interim *Bilski* Guidance should in fact replace the memorandum because the memorandum instructs examiners to reject a method claim that does not meet the machine-or-transformation test. (Memorandum, p. 2). As the PTO acknowledges in the Interim *Bilski* Guidance, the Supreme Court held that the machine-or-transformation test is not the sole test for patent-eligibility. Because the Memorandum instructions could lead examiners to continue rejecting all claims that are not tied to a machine or transformation, in conflict with the Supreme Court's ruling, we believe the Interim *Bilski* Guidance should clearly state that the Memorandum instructions are superseded by the Interim *Bilski* Guidance and should no longer be followed.

- In Section III of the Interim *Bilski* Guidance, regarding the "abstract idea" exception to patent-eligible subject matter, we believe the PTO should clarify that no machine is necessary to render a process eligible for patenting. For example, the Interim *Bilski* Guidelines could be amended to clarify that a process performed by humans is not automatically an "abstract idea." This would be consistent with the more flexible factors the PTO has set forth, such as noting that

an "observable and verifiable" process is more likely to be patentable. Human-implemented processes can often by observable and verifiable.[1]

- In Section IV.A, we encourage the PTO to clarify the "particular machine" analysis to be consistent with controlling Federal Circuit law. For example, the Federal Circuit has held that a process tied to a general purpose computer is sufficient to satisfy section 101. *In re Allapat*, 33 F.3d 1526 (Fed. Cir. 1994) (en banc). Several months after its decision in *In re Bilski*, the Federal Circuit cited several cases as examples where "we have found processes involving mathematical algorithms used in computer technology patentable because they claimed practical applications and were tied to specific machines." *In re Comiskey*, 554 F.3d 967, 979 n.14 (Fed. Cir. 2009). These cases included:

    a. "a [m]ethod for use in a telecommunications system" in *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1354, 1358 (Fed. Cir. 1999);

    b. a method claim inherently tied to "electronic equipment programmed to perform mathematical computation" in *Arrhythmia Research Tech., Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1058-59 (Fed. Cir. 1992); and

    c. a "rasterizer for converting vector list data" in *In re Alappat*, 33 F.3d 1526 (Fed. Cir. 1994) (en banc).

- In Section IV.B, we believe the PTO should specifically explain that the transformation of electronic data may be patent-eligible. The Federal Circuit in *In re Bilski* gave the specific example of the data transformation in *In re Abele* as an example of a patent-eligible transformation of data. *In re Bilski*, 545 F.3d 943, 962-63 (Fed. Cir. 2008) (en banc).

- In Section IV.D, in addition to stating that the presence of a "general concept" can be a clue to the claiming of an abstract idea, we believe it is important for the Office to add that the Supreme Court has long held that the practical application of an abstract idea is patent-eligible. *Diamond v. Diehr*, 450 U.S. 175 (1981).

- Section IV.D.6 includes a list of "general concepts" that can be a clue to a claim to an abstract idea. Consistent with its position that section 101 should be applied on a flexible, case-by-case basis, Accenture suggests that the PTO provide legal support for these possible exclusions to patentable subject matter. Citations to particular cases would give examiners and applicants further guidance on how section 101 has been applied in particular cases for these areas. Because the Supreme Court rejected categorical limitations on patentable subject matter, we encourage the PTO to limit its use of lists of excluded subject matter as much as possible.

[1] Accenture maintains its position that any "useful" process that is reasonably definite should be patent-eligible, even if it is human-implemented.