

**Sample Rejection of Example 37 - Claim 3 - under the
2019 Revised Patent Subject Matter Eligibility Guidance (“2019 PEG”)**

The following sample rejection relies upon the fact pattern and claim 3 of “Example 37 – Relocation of Icons on a Graphical User Interface.” The eligibility analysis in the following rejection reflects both the 2019 PEG and the new form paragraphs published for use with the 2019 PEG. As always, under the principles of compact prosecution, it is expected that a full examination would be conducted on an actual application with an Office action that addresses all patentability requirements as appropriate.

The sample rejection uses form paragraphs 7.04.01, 7.05, and 7.05.016 and inserts as noted below.

SAMPLE § 101 REJECTION

[FP 7.04.01]

Claim Rejections – 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

[FP 7.05 and 7.05.016 with explanation provided]

Claim 3 is rejected under 35 U.S.C. 101 because the claimed invention is directed to an abstract idea without significantly more. The claim recites determining the amount of use of each icon over a predetermined period of time, and ranking the icons based on the determined amount of use.

The limitation of determining the amount of use of each icon over a predetermined period of time, as drafted, is a process that, under its broadest reasonable interpretation, covers performance of the limitation in the mind but for the recitation of generic computer components. That is, other than reciting “by a processor,” nothing in the claim element precludes the step from practically being performed in the mind. For example, but for the “by a processor” language, “determining” in the context of this claim encompasses the user manually calculating the amount of use of each icon. Similarly, the limitation of ranking the icons based on the determined amount of use, as drafted, is a process that, under its broadest reasonable interpretation, covers performance of the limitation in the

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mind but for the recitation of generic computer components. For example, but for the “by a processor” language, “ranking” in the context of this claim encompasses the user thinking that the most-used icons should be ranked higher than the least-used icons. If a claim limitation, under its broadest reasonable interpretation, covers performance of the limitation in the mind but for the recitation of generic computer components, then it falls within the “Mental Processes” grouping of abstract ideas. Accordingly, the claim recites an abstract idea.

This judicial exception is not integrated into a practical application. In particular, the claim only recites one additional element – using a processor to perform both the ranking and determining steps. The processor in both steps is recited at a high-level of generality (*i.e.*, as a generic processor performing a generic computer function of ranking information based on a determined amount of use) such that it amounts no more than mere instructions to apply the exception using a generic computer component. Accordingly, this additional element does not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea. The claim is directed to an abstract idea.

The claim does not include additional elements that are sufficient to amount to significantly more than the judicial exception. As discussed above with respect to integration of the abstract idea into a practical application, the additional element of using a processor to perform both the ranking and determining steps amounts to no more than mere instructions to apply the exception using a generic computer component. Mere instructions to apply an exception using a generic computer component cannot provide an inventive concept. The claim is not patent eligible.