

# ICT Law | Technology Group, pllc

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**SUBJECT:** Docket No.: [PTO –P-2014-0036] Request for Comments and Extension of Comment Period on Examination Instruction and Guidance Pertaining to Patent-Eligible Subject Matter

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**Request for Comments and Extension of Comment Period on Examination Instruction and Guidance Pertaining to Patent-Eligible Subject Matter**

Dear Ms. Focarino, Mr. Tamayo, and Ms. Dennison:

ICT Law and Technology Group, pllc appreciates the opportunity to respond to the PTO's Federal Register/ Vol. 79, No. 125/ Monday, June 30, 2014 Notice regarding the invitation to comment.

### **Background on ICT Law and Technology Group, pllc**

ICT Law and Technology Group, pllc, ("ICT Law") is a legal-services firm that represents several privately-held companies that devise technical innovations. ICT Law's clients have inventors that include many of the significant innovators in the United States spanning many of the groups of the U.S. Patent and Trademark Office ("PTO"). ICT Law's legal services team is unique in that it has dozens of years of cumulative experience in cradle-to-grave patent prosecution, patent evaluation, licensing, and enforcement. While ICT Law is a small firm, it represents significant prosecution customers of the PTO, filing several several new applications per month and providing legal services of all types with respect several hundred cases in active prosecution before the PTO and post-issuance. ICT Law's interests are aligned with the PTO's role in: (a) rewarding innovation; (b) providing objective and fair patent examination proceedings that allow an attorney to satisfy her client duties under her controlling State Bar Ethics Rules, and (c) creating a rational and objectively fair examination system consistent with United States Statutory Law and Federal Court Jurisprudence..

One of our undersigned attorneys --- Dale Cook -- at significant personal expense to both himself and ICT Law, filed three (3) separate Amicus Briefs on behalf of ICT Law with the Court of Appeals for the Federal Circuit, and at both the Petitions Stage and the Merits stage in the litigations of

Alice Corporation Pty. Ltd. v. CLS Bank International ("CLS-Alice").

Another of our undersigned attorneys -- Brian Johnson -- was awarded the privilege of serving as a Patent Examiner simultaneously in two different art units of Technology Center 2600 of the PTO after being awarded a Law License by the State of Texas and prior to being awarded a Law License by the State of Washington.

Both of the undersigned attorneys have been awarded the privilege of serving as active duty, and thereafter reserve duty for a period of time, Commissioned Officers in different branches of the United States Military. Attorney Brian Johnson served as an U.S. Air Force Officer in four different Commands (Tactical, Systems, Communication, and Intelligence) working on a variety of

projects involving information-computer, aerospace and other advanced weapons system technologies. Attorney Dale Cook served as an active duty soldier with the U.S. Army JAG Corps at Fort Lewis, Washington.

Both express appreciation for their Registrations to Practice before the PTO.

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**I. The PTO Was Not “Mistaken” When It Issued, And The Patent Bar Was Not “Mistaken” When It Argued, Those “Hundreds Of Thousands Of Patents, Including All Business Method, Financial System, And Software Patents As Well As Many Computer Implemented And Telecommunication Patents,” *CLS Bank Int’l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1313 (Fed. Cir. 2013), Referenced By Judge Moore As Imperiled By The Alice Patents; Rather, What is Missing In The Alice Patents AND THE ENTIRE ALICE LITIGATION Is Evidence of How “One of Skill in the Art”<sup>1</sup> In Electrical, Electronic, or Computer Engineering Would Have Understood The Patents, And When That Context Is Supplied Almost All Issued Patents To Date And Pending Would Pass The Alice Tests**

As shown in Section “**V. Supporting Remarks**,” the PTO did not make “mistakes” in issuing “hundreds of thousands of patents, including all business method, financial system, and software patents as well as many computer implemented and telecommunication patents.” *CLS Bank Int’l v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1313 (Fed. Cir. 2013) (referring to Judge Moore’s observation regarding the consequences if the claims at issue in the case were not patent-eligible); rather, the technical context of “one skilled in the art” against which those patents were issued needs to be exposed.

The Patent Attorney bar did not make “mistakes” in arguing those: rather, the technical context of “one skilled in the art” against which those patents were argued to the Patent Examiner (Administrative Judge) needs to be exposed.

All CLS-Alice is really saying is that -- in those rare and limited instance where the evidence is such that claims appear to be drawn to that which is already in the existing corpus of human knowledge (e.g., "abstract ideas") -- Patent Attorneys and Patent Examiners should work to describe specific technologies such that a patent may be understood as deeply technical even without being an electrical, electronic, or computer engineer (e.g., by a lawyer with no technological experience or training and without resort to experts).

In *CLS Bank Int’l v. Alice Corp. Pty. Ltd.*, 573 U.S. \_\_\_\_ (2014) (No. 298, 2013 Term) (hereinafter “CLS-Alice”) the Court provides a step-by-step analysis algorithm that if followed will result in a written record (1) from which general practice attorneys can understand that the technologies involved are very specific and deep, and not superficial or generic, and (2) overtly written in such a

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<sup>1</sup> See, e.g., oral argument at the Court when a likely 2 year engineering project was admitted as “doable over a weekend.” One skilled in the art would have never made this gaffe, understanding that in the absence of the supporting programs/automations circuitry implementing the claim at issue in Alice would have been unworkable.

way that lay judges won't/can't be misled that the patents are somehow generic or non-technical even in the absence of expert testimony.

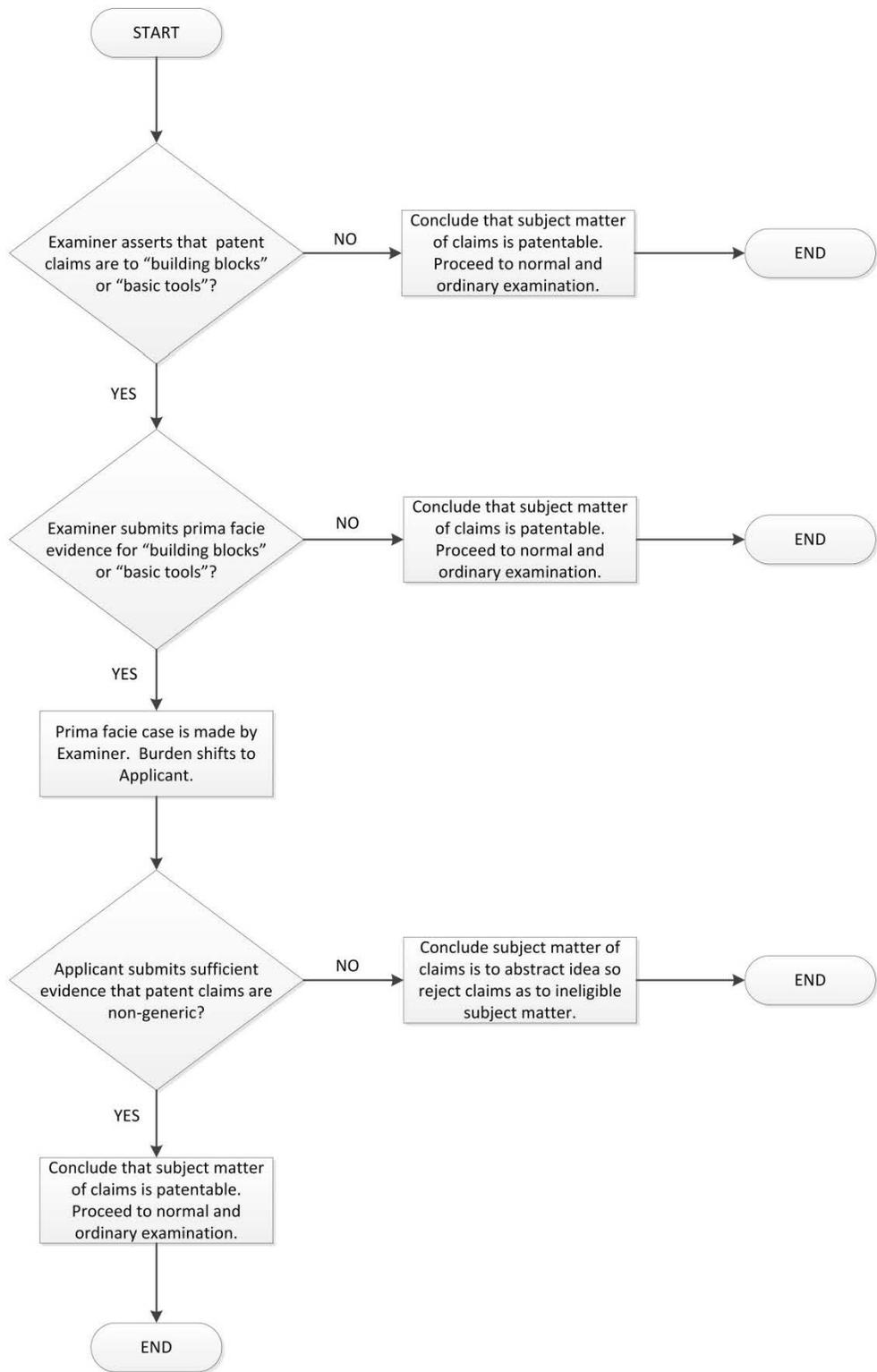
That way, the patent owner will be protected even if a trial attorney declines to roll up her sleeves and put on evidence as to what one of skill in the art would have understood the patents to have meant

The undersigned attorney(s) think we can do that.

## **II. Supreme Court's CLS-Alice Decision Provides Objective Step-By-Step Guidance Of The Analysis Of Patent Claims To Ensure Such Are Not Drawn To Unpatentable Subject Matter In The Form Of "Abstract Ideas"**

- A. Justice Clarence Thomas' authored decision in Alice v. CLS Bank offers exceptionally clear guidance to exclude Anti-Technologists from efforts in pilfering from those making worthwhile technological contributions.**
- B. Justice Thomas's decision is crystal clear and diamond hard. It is a step-by-step algorithm. It is OBJECTIVE.**
- C. The algorithm is so clear that it can be – via direct quotation of the Court:**
  - 1) be expressed as a flowchart (please see Section III below); or**
  - 2) equivalently written as pseudo-C code complete with function calls (please see Section IV below).**

### III. CLS-Alice Analysis Algorithm Expressed As A Flowchart<sup>2</sup>



<sup>2</sup> Please see endnotes of Pseudo C Code (Section IV below) for Support/Citations.

#### IV. CLS-Alice Algorithm Expressed As Pseudo C Code<sup>3</sup>

IF (a patent examiner asserts that a “patent[] ... claim[s] the ““buildin[g] block[s]”” of human ingenuity”)<sup>i</sup> OR

(a patent examiner asserts that a “patent[] ... claim[s] the “ “the basic tools of scientific and technological work.”” )<sup>ii</sup>

THEN

{

IF (objective prima facie evidence has been proffered that would establish the underlying facts that would establish a prima facie case of the underlying factual allegations as to ““buildin[g] block[s]”” of human ingenuity”)<sup>iii</sup> OR

(objective prima facie evidence has been proffered that would establish a prima facie case of the underlying factual allegations as to “the basic tools of scientific and technological work.””)<sup>iv</sup>

THEN

{

\* Conclude prima facie case of unpatentability has been made;

\* Burden shifts to patent attorney to supply objective evidence of non-generic machines/articles/compositions/processes;

IF (Patent Attorney points to objective evidence<sup>v</sup> that would constitute prima facie evidence of non-generic technologies)

THEN

{

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<sup>3</sup> For clarity, direct quotation support for the flowchart and this Pseudo C code -- which was originally listed as footnotes -- has been moved to endnotes which appear at the very end of this document.

IF (evidence is sufficient that patent is not to generic, but rather to specific circuitry, such as Integrated Circuits, Application Specific Integrated Circuits, special purpose circuits assembled from the circuits of general purpose processor (e.g., VLSIC) under program control (e.g., binary, assembly, C, Python, etc. programming), FPGAs, etc. from which, e.g., claimed process would emerge or which would constitute a claimed machine, etc.)

THEN

{

- \* Conclude evidence sufficient to establish a prima facie case that claims are drawn to NON-Generic Circuits/processes emerging from NON-Generic circuits,<sup>vi</sup> and thus that the claim is to an “inventive concept”—i.e., an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself”;
- \* Proceed to normal and ordinary examination;

}

ELSE

{

- \* Conclude evidence NOT sufficient (or insufficient) to establish claims drawn to NON-Generic circuits/processes emerging from NON-Generic

circuits and thus that “patent[] ... claim[s] the  
“buildin[g] block[s]” of human ingenuity ...” and  
are therefore ineligible for patent protection”;

\* Conclude that prima facie evidence is such that the  
claims, in unamended form, are drawn to abstract  
ideas;

\* Reject claims, in unamended form, as patent  
ineligible subject matter;

}

}

}/\* termination of did patent attorney point to objective evidence  
sufficient to demonstrate that objective evidence establishes prima facie  
patentability if-then-else cascade \*/

ELSE

{

\* Conclude no prima facie case of unpatentable subject matter has been  
made for want of evidence;

\* Proceed to normal and ordinary examination;

}

}/\* termination of did PTO proffer objective evidence that demonstrates prima facie  
case of unpatentability if-then-else cascade \*/

ELSE

{

\* No prima facie case of unpatentable subject matter asserted;

\* Proceed to normal and ordinary examination;

}/\* termination of PTO asserted unpatentable subject matter if-then-else cascade \*/

/\* termination of CLS-Alice analysis algorithm \*/

## V. Supporting Remarks

**A. "Person Skilled In The Art," 35 U.S.C. S 112 (Written Description, Enablement, And Claim Requirements) Is THE LODESTAR Under Which PTO Patent Examiners And PTO-Registered Patent Attorneys Have Labored, Yet The Supreme Court's Decision In CLS-Alice Omits Any Reference To "One Of Skill In The Art" And Thus Suggests That The Safe Course Is To Make Overt What One of Skill Would have Understood The Patents To Mean**

A "person of skill in the art" is THE LODESTAR for EE/CE PTO Patent Examiner and PTO-Registered Patent Attorneys with respect to written description, enablement, and claim interpretation,<sup>4</sup> yet the Supreme Court Decision in CLS-Alice is **ABSOLUTELY SILENT** on that Lodestar principle. For example, string search of the CLS-Alice opinion yields the following:

- \* string search of CLS-Alice opinion for "person skilled in the art" – 0 matches;
- \* string search of CLS-Alice opinion for "skill in the art" – 0 matches;
- \* string search of CLS-Alice opinion for "ordinary skill" – 0 matches;
- \* string search of CLS-Alice opinion for "skilled in the art" – 0 matches;
- \* string search of CLS-Alice opinion for "artisan" – 0 matches;
- \* string search of CLS-Alice opinion for "having skill" -- 0 matches
- \* string search of CLS-Alice opinion for "skill" – 0 matches;

etc.

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<sup>4</sup> *See*, e.g., **MPEP 2161.01**, Determining Whether There Is **Adequate Written Description** For A Computer-Implemented Functional Claim Limitation ("Specifically, the **specification must describe the claimed invention in a manner understandable to a person of ordinary skill in the art** and show that the inventor actually invented the claimed invention." (citing *Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1340, 94 USPQ2d 1161, 1167 (Fed. Cir. 2010) (*en banc*))); **MPEP 2164.01, Test of Enablement** ("Any **analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained** sufficient information regarding the subject matter of the claims as to **enable one skilled in the pertinent art to make and use the claimed invention.**" (citing *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916))); **MPEP 2111.01, "Plain Meaning" Refers To The Ordinary And Customary Meaning Given To The Term By Those Of Ordinary Skill In The Art**, ("[T]he **ordinary and customary meaning of a claim term** is the meaning that the term would have to a **person of ordinary skill in the art** in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 75 USPQ2d 1321, 1326 (Fed. Cir. 2005) (*en banc*))); **2173.01, Interpreting the Claims** ("The **focus of the inquiry regarding the meaning of a claim** should be what would be reasonable **from the perspective of one of ordinary skill in the art.**" *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260, 94 USPQ2D 1640, 1644 (Fed. Cir. 2010))."

Not only is the Court's CLS-Alice decision silent on this point. The Alice patents-in-suit were/are written for one of HIGH skill in the art (so much so that their Detailed Descriptions omit almost any overt reference to the deeply complex technologies involved),<sup>5</sup> yet throughout the entire line of CLS v. Alice jurisprudence the undersigned attorney(s) have found no reference or evidence as to what the claims would have meant to “one of skill in the art” of at least electrical, electronic, or computer engineering, yet as noted in the MPEP this was/is the fundamental context into which the Alice patents were drafted and against which the PTO issued the claims.

Importantly, “one skilled in the art” of electrical/electronic/computer engineering – e.g., what the Patent Examiner or Attorneys would have likely understood the patents to “mean” -- is not overtly present in the Alice patents, and neither is it present in the decision at the District Court level.

Many in the patent bar detected this at the Federal Circuit's decision stage and were alarmed by it.

**B. Alarmed By The Lack Of Overt Technology In The Alice Patents, And Yet Further Alarmed By What Appeared To Be A Near-Complete Lack Of Presentation Of Evidence Of The Deep Technologies Of Alice's Patents At The District Court Level, The Patent Bar Went To Herculean Efforts To Try To SUPPLEMENT THE RECORD Before The Supreme Court**

Many Patent Bar Amici, at great personal expense to themselves, attempted to move heaven and earth and explain to the Court -- within the word limits of Supreme Court Briefs -- the extremely complicated and specific electronic circuitry that “one skilled in the art” of electrical/electronic/computer engineering would have understood from Alice yet in terms understandable by lay judges. This Patent Bar Amici further presented devastatingly objective demonstrations that the entire “software” versus “hardware” debate is technologically wrong in that Electrical/Electronic/Computer Engineers view them as functionally equivalent design choices. The CLS-Alice decision demonstrates that the Court has Heard, Understood, and Acknowledged (HUA!) this in that absent are any embarrassing references to a "digital computer ..., solving a problem by doing arithmetic as a person would do it by head and hand." These Amici -- whom the undersigned attorneys would here like to publically thank, include but are not limited to the

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<sup>5</sup> Yet the written descriptions are likely adjudged sufficient since they include that which is overtly present in the specification (e.g., specification includes the claims, 35 USC S 111) and what would have been understood by one of skill in the art at the time of priority data. **CITE**

following partial Amici list which briefly notes some Amici points): Mr. Ronald M. Benrey (Attorneys Robert Sachs and Daniel Brownstone)<sup>6</sup>; the Institute of Electrical and Electronic Engineers-USA (Attorney Chris J. Katopis)<sup>7</sup>; Mr. Dale Cook (Pro Se)<sup>8</sup>; International Business Machines Corporation (Attorneys include Manny W. Schecter And Paul D. Clement), and Margo Livesay, Ph.D. (Attorney Margo Livesay, PhD Computer Engineering)<sup>9</sup>, just to name a few.

**C. The Referenced Evidence Which Amici Tried to "Sneak In" At The Supreme Court Is Not In The Trial Record, And Hence The CLS-Alice Opinion Announces Risks Extant In A Patent Owner Directing His Advocate Attorney To "Go Light" In The Patent Applications On Overtly Technological Disclosure With The Expectation That The Trial Attorneys Will "Fill In The Technological Details" Post-Patent-Issuance And Through Expert Witness Testimony**

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<sup>6</sup> ("*Gottschalk v. Benson*, 409 U.S. 63 (1972), cited my book, *Understanding Digital Computers*, in support of the proposition: A digital computer, as distinguished from an analog computer, is that which operates on data expressed in digits, solving a problem by doing arithmetic as a person would do it by head and hand. *Benson*, 409 U.S. at 65 n.3, citing R. Benrey, *Understanding Digital Computers 4* (1964) (hereinafter UDC). This principle was argued by the Solicitor General, based on a partial quotation taken out of context from UDC: A digital computer solves a problem by actually doing arithmetic in much the same way a person would by hand. Brief of Solicitor General, *Gottschalk v. Benson*, 1972 WL 137527 \*4 (U.S.) (hereinafter "Solicitor General Brief") (citing Benrey [sic], *Understanding Digital Computers 4* (1964)) (hereinafter "the Benrey Quote"). I learned of the Court's mention of UDC in 1981 and was honored to see my words cited in a Supreme Court opinion. However, I was concerned that the quoted passage had been taken out of context, in support of an incorrect explanation of how computers operated. The quoted text was not meant to factually describe the inner workings of a digital computer, but rather as an easy-to-grasp analogy that would help lay readers understand the difference between digital and analog computers. The portion of the Benson opinion based upon the Benrey Quote has been adopted by many courts as controlling legal principle, and unfortunately it has worked to extend the doctrine of mental steps to computer-implemented inventions.... The Solicitor General Brief argued that Benson's claim was unpatentable because it covered merely the mental steps for a mathematical procedure, even though it recited specific computer operations by specific computer hardware. The argument was based on three premises: (1) that computers perform mental steps; (2) that Benson's claimed invention was a purely mathematical solution derived from axioms of mathematics; and (3) that all mathematical algorithms are scientific truths. These three premises are incorrect.")

<sup>7</sup> ("The functional equivalence, between hardware and software, means that the choice, of how much of a particular system to implement with each, is really just a practical, market-driven, design issue.")

<sup>8</sup> (accord with Mr. Benrey and IEEE on illusory software-hardware dichotomy; in *Intelligence Amplification* "technologies ... engineer-designed machines create structured DATA (... machine-generated tangible differences, where tangible means perceivable by humans via some technology ..."), said DATA are structured to generate FIRST-ORDER-human-thought-SYMBOL-INFORMATION (e.g., English language words which have concrete meaning to English readers), and said DATA are further structured to generate SECOND-ORDER-human-thought-CONCEPT-INFORMATION (e.g., result of understood and humanly-useful currency trading concepts gleaned from the English words). So, engineers CREATE MACHINES to generate DATA structured to function as first-order English symbols AND generate second-order logical concepts at the same time— *IntellAmp* technology really is that complicated.")

<sup>9</sup> ("Over time, however, software-related system design and development evolved into something that is more akin to an engineer designing and developing things .... and the terms "system engineers" and "software engineers" became common parlance .... Such development is directly analogous to "building blocks" or "parts" used in other engineering disciplines (e.g., airplane design, automobile design, machine design, etc.... )

CLS-Alice merely stands for the in hindsight unremarkable proposition that, at some point and somewhere, some attorney needs to get into the written record the hyper-complex technologies that “one of skill in the art” would have read into superficially-easy-to-read-and-understand claims such as Alice’s. Patent owners can, after appropriate legal advice and consultation from their drafting attorneys, direct that their advocates do as the Alice drafting attorneys did, going “light” on the technical disclosure trusting that under the controlling law the trial attorneys could/would/should get such into the written record via expert testimony, but CLS-Alice shows that that course runs the risk – as likely happened in Alice’s cause – that in the course of “dumbing it down” for the jury the trial attorneys might fatally omit the very specific technologies as would be understood by “one of skill in the art” all together.

What is missing in CLS-Alice is the core or fundamental context against which electrical/electronic/computer engineering patent examiners work – HOW ONE SKILLED IN THE ART would have understood the claims/detailed descriptions.

Faced with an actual record wholly bereft of any overtly technological evidence as to what the Alice patents would mean to "one of the skill in the art," as a Court of Ultimate Review bound by a severely anemic record, the CLS-Alice opinion reads exactly as one would expect on such a record: the Alice claims/detailed descriptions are understood from the viewpoints of lay (i.e., non-electrical/electronic/computer engineering) judges or lawyers, since the only overt discussions of the incomprehensibly complicated technologies in the Alice proceedings were introduced at the Supreme Court stage by Amici such as discussed above.

And in view of that, and on the anemic evidentiary record, the Court -- comprised of lay judges of whom Justice Thomas comes closest to the men/women whom do typically comprise the EE/CE PTO patent examiners and PTO-registered patent attorneys -- understandably but obviously regrettably reached the conclusion of unpatentable subject matter.

**D. Conclusion: The Referenced Evidence Which Amici Tried to "Sneak In" at the Supreme Court is Not in the Trial Record, and Hence the CLS-Alice Opinion Announces Risks Extant in a Patent Owner Directing His Advocate Attorney to "Go Light" in the Patent Applications On Overtly Technological Disclosure With The Expectation that the Trial**

## **Attorneys will "Fill in the Technological Details" Post-Patent-Issuance and through Expert Witness Testimony**

Ironically -- in the absence of consulting "a person skilled in the art" -- to a general bar attorney or a member the lay public, the claims might appear so abstract as to be generic and as the lay Supreme Court read them. However, technologically adept electrical/electronic/computer engineering patent attorneys working hand and hand with technologically adept persons of skill in the art can demonstrate to general practice attorneys and members of the non-technological public the technologies of the claims, and unpacked in their full technological would appear "incomprehensible" to the non-technologist.

CLS-Alice shows that in order to play it safe, and in order to avoid being made to "look bad" by non-technical trial attorneys later, during patent examination technologically adept electrical/electronic/computer engineering patent examiners and technologically adept patent attorneys should work hand-in-hand to generate patents sufficient to demonstrate to general practice attorneys and members of the non-technological public that the technologies of the claims, but unpacked to show at least a part of their full technological complexity to ONE OF SKILL IN THE ART so that they appear "incomprehensible" to the non-technologist.

Justice Thomas CLS-Alice decision constitutes an algorithm that can/should be followed by EE/CE PTO Patent Examiners, PTO-Registered Patent Attorneys, and ONE WOULD HOPE, trial lawyers litigating PTO-issued patents so that a record is produced that is specific, and not generic as to technology

The supplied Flowchart and Pseudocode shows how.

Sincerely,

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## ENDNOTES

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<sup>i</sup> See **MPEP 2106, III. Establish on the Record a *Prima Facie* Case** ("USPTO personnel should review the totality of the evidence (e.g., the specification, claims, relevant prior art) before reaching a conclusion with regard to whether the claimed invention sets forth patent eligible subject matter. USPTO personnel must weigh the determinations made above to reach a conclusion as to whether it is more likely than not that the claimed invention as a whole either falls outside of one of the enumerated statutory classes or within one of the exceptions to statutory subject matter. "The examiner bears the initial burden ... of presenting a prima facie case of unpatentability....After USPTO personnel identify and explain in the record the reasons why a claim is for an abstract idea, physical phenomenon, or law of nature with no practical application, then the burden shifts to the applicant to either amend the claim or make a showing of why the claim is eligible for patent protection.... Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the initial review of the application, even if one or more claims are found to be deficient with respect to the patent-eligibility requirement of 35 U.S.C. 101." (citing *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d).

<sup>ii</sup> *Id.*

<sup>iii</sup> **"the analysis under § 101, while ultimately a legal determination, is rife with underlying factual issues.... Likewise, any inquiry into the scope of preemption—how much of the field is "tied up" by the claim—by definition will involve historic facts: identifying the "field," the available alternatives, and preemptive impact of the claims in that field. The presence of factual issues coupled with the requirement for clear and convincing evidence normally will render dismissal under Rule 12(b)(6) improper."** ...Finally, ... the question of eligible subject matter must be determined on a claim-by-claim basis. Construing every asserted claim and then conducting a § 101 analysis may not be a wise use of judicial resources." *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, 1339-1340 (Fed. Cir. 2013), Writ of certiorari granted on other grounds, Vacated by on other Grounds, and Remanded on other ground by *WildTangent, Inc. v. Ultramercial, LLC*, 2014 U.S. LEXIS 4647 (U.S., June 30, 2014).

<sup>iv</sup> *Id.*

<sup>v</sup> In light of the sworn statement of the Inventor Declaration, the patent application itself may constitute such evidence. Or, alternatively, the Patent Attorney may introduce other evidence as of the priority date.

<sup>vii</sup> First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts. *Id.*, at \_\_\_ (slip op., at 8). If so, we then ask, "[w]hat else is there in the claims before us?" *Id.*, at \_\_\_ (slip op., at 9). To answer that question, we consider the elements of each claim both individually and "as an ordered combination" to determine whether the additional elements "transform the nature of the claim" into a patent-eligible application. *Id.*, at \_\_\_ (slip op., at 10, 9). We have described step two of this analysis as a search for an "inventive concept"—i.e., an element or combination of elements that is "sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself." *Id.*, at \_\_\_ (slip op., at 3)... These cases demonstrate that the **mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention. Stating an abstract idea "while adding the words 'apply it'" is not enough** for patent eligibility. *Mayo, supra*, at \_\_\_ (slip op., at 3). **Nor is limiting the use of an abstract idea "to a particular technological environment."** *Bilski, supra*, at 610–611. **Stating an abstract idea while adding the words "apply it with a computer" simply combines those two steps, with the same deficient result.** Thus, if a patent's recitation of a computer amounts to a mere instruction to "implemen[t]" an abstract idea "on . . . a computer," *Mayo, supra*, at \_\_\_ (slip op., at 16), that addition cannot impart patent eligibility. This conclusion accords with the preemption concern that undergirds our §101 jurisprudence. Given the ubiquity of computers, see 717 F. 3d, at 1286(Lourie, J., concurring), **wholly generic computer implementation is not generally the sort of "additional featur[e]" that provides any "practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself."** *Mayo*, 566 U. S., at \_\_\_ (slip op., at 8–9). *CLS Bank Int'l v. Alice Corp. Pty. Ltd.*, 573 U.S. at pages 7 and 13 (2014) (No. 298, 2013 Term).