

# Patent Public Advisory Committee Quarterly Meeting

## 2014 Interim Guidance on Patent Subject Matter Eligibility



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# 2014 Interim Guidance

- **2014 Interim Guidance on Patent Subject Matter Eligibility** (Dec. 16, 2014)
  - Incorporates principles from the entire body of legal precedent, in particular *Alice Corp.*, *Myriad* and *Mayo*
  - Addresses areas highlighted by public feedback
    - Comments were solicited in response to *Myriad/Mayo* guidance (March 2014) and initial examination instructions based on *Alice Corp.* (June 2014)



# Analysis

Eligibility Guidance uses a two-step test:

- Step 1 asks whether a claim is directed to one of the patent-eligible subject matter categories (process, machine, manufacture, or composition of matter)
- Step 2 is a two-part analysis drawn from *Mayo* and *Alice Corp.* that evaluates whether a claim is directed to subject matter encompassing a judicial exception



# Two-part Analysis for Judicial Exceptions

The test drawn from *Mayo* and *Alice Corp.* for judicial exceptions asks:

- Is the claim directed to a law of nature, a natural phenomenon, or an abstract idea?
  - If not, the claim is eligible
- If so, does the claim recite additional elements that amount to significantly more than the judicial exception?
  - If so, the claim is eligible



# Changes From Prior Guidance

- New integrated approach for eligibility – applies to all claims
- Claims must be *directed* to a judicial exception to trigger full analysis, not merely *involve* or be *based upon* an exception (narrows the funnel)
- Evaluation of “significantly more” in the claim is simplified to focus on the “inventive concept”



# Changes From Prior Guidance

- For “products of nature”:
  - Markedly different characteristics can be shown in a product’s structure, function, and/or other properties as compared to its naturally occurring counterpart in its natural state
  - Eligibility can be shown by markedly different characteristics without evaluating “significantly more”



# Examples

- Two sets of examples have been developed to illustrate the application of the Interim Eligibility Guidance
  - Both show eligible and ineligible claims, in accordance with case law and based on hypothetical fact patterns
  - Examples of nature-based products (Dec. 2014)
    - Highlight how markedly different characteristics of a nature-based product can lead to eligibility
  - Examples of abstract ideas (Jan. 2015)
    - Highlight that software and computer inventions can be eligible



# Examples: Nature-Based Products

## Key Teaching Points

- Function and other non-structural characteristics can demonstrate markedly different characteristics
- Purified and isolated products may have markedly different characteristics and therefore be eligible
- A product that lacks markedly different characteristics may be eligible under Step 2B (significantly more)



# Examples: Abstract Ideas

## Key Teaching Points

- “Software” and business method claims are not automatically directed to abstract ideas
- Mere existence of a computer or routine and conventional elements in a claim does not mean that the claim is ineligible
- Claims that are directed to an exception may be eligible under Step 2B (significantly more)



# Public Forum

- A Public Forum was held Jan. 21, 2015
  - Approximately 300 people attended in person and on-line
  - Common themes:
    - A step in the right direction, but improvements are still needed
    - Responsive to many issues raised regarding the March 2014 guidance, for example the guidance represents a simplified, more flexible approach
    - Recognition that case law is developing and that gaps need to be fleshed out, especially with additional examples
    - Concerns regarding examiner implementation



# Examiner Training

- Multi-phased Examiner Training has started
  - Phase I – Training on Dec. 2014 Interim Guidance (completed)
  - Phase II – Training based on examples (underway)



# Next Steps

- Complete Phase II of Examiner Training
- Updates will be provided based on judicial developments and feedback from the public and the examining corps
  - A public comment period is open through March 16, 2015
- Additional examples are being developed



# Additional Resources

- General page for examination guidance and training materials
  - <http://www.uspto.gov/patents/law/exam/examguide.jsp>
- Specific page for the December 2014 Interim Eligibility Guidance
  - <http://www.uspto.gov/patent/laws-and-regulations/examination-policy/2014-interim-guidance-subject-matter-eligibility-0>
    - Includes the Guidance document, additional claim examples and relevant case law
    - All updates will be posted to this page



# Questions and Comments

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