Patent Public Advisory Committee
Quarterly Meeting

Subject Matter Eligibility

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Eligibility Guidance Is Now In the MPEP

• The MPEP has been updated to incorporate the 2014 Interim Eligibility Guidance (IEG) and its updates.

• MPEP now replaces the IEG and updates (as of August 2017).
The Eligibility Analysis

• MPEP 2106 discusses the eligibility analysis.

• Explains the two criteria for subject matter eligibility:
  – statutory category (USPTO Step 1)
  – judicial exceptions (Step 2: the Alice/Mayo test)
Flowchart

• Sets forth the only analysis for examination of subject matter eligibility under 35 U.S.C. 101

• MPEP includes updated flowchart that:
  – adds labels for each step
  – indicates three pathways to eligibility (including streamlined analysis)
Step 1: Statutory Categories

- MPEP 2106.03 discusses Step 1
Step 2A: Directed To A Judicial Exception

- MPEP 2106.04 discusses Step 2A
  - Introduces the judicial exceptions, and explains the Supreme Court’s concern about preempts basic tools of scientific and technological work
  - Sub-sections 2106.04(a) through 2106.04(c) provide detailed information on the judicial exceptions.
Step 2B: Evaluating Significantly More

• **MPEP 2106.05** discusses Step 2B
  – Explains the Supreme Court’s analysis of significantly more (also called an “inventive concept”)
  – Provides guidance on how to evaluate whether a claim encompasses an “inventive concept”
  – Sub-sections **2106.05(a) through 2106.05(h)** provide detailed information on the Step 2B considerations.
Streamlined Analysis

• MPEP 2106.06 discusses the Streamlined Analysis
  – Sub-section 2106.06(a) provides examples of claims having self-evident eligibility.
  – Sub-section 2106.06(b) provides examples of claims that have self-evident eligibility because they are directed to unambiguous improvements to a technology or to computer functionality.
Formulating Eligibility Rejections

- MPEP 2106.07 discusses how examiners should formulate and support subject matter eligibility rejections
  - Sub-section 2106.07(a) concerns formulating a subject matter eligibility rejection.
  - Sub-section 2106.07(b) concerns considering applicant’s arguments to an eligibility rejection.
  - Sub-section 2106.07(c) concerns clarifying the record both in rejections and when claims are found eligible.
Quick Reference Sheet (QRS) groups abstract ideas to help examiners identify pertinent cases and find related information in the MPEP.

Many cases on the QRS are explained in further detail in the MPEP.
QRS: Decisions Holding Claims Eligible

- QRS also identifies court decisions that held claims eligible, along with citations to related sections in the MPEP.
- Decisions are grouped by the court’s rationale for holding the claims eligible. For example:
  - *Finjan* and *Core Wireless* are listed with other cases holding that the claims at issue were not directed to abstract ideas.
  - *BASCOM* is listed with other cases holding that the claims at issue recited an inventive concept.
Case Law Chart

- Case law chart provides additional information so examiners can look at the patent(s) and claim(s) at issue in the case.
- QRS & Chart are updated periodically (usually monthly).

<table>
<thead>
<tr>
<th>Case Name</th>
<th>Decision Type</th>
<th>Citation</th>
<th>Decision Date</th>
<th>Patent(s) or App.Nos.</th>
<th>Title or General Subject Matter</th>
<th>Claim Type</th>
<th>Exception Type</th>
<th>Judicial Conclusion</th>
<th>Classification (USPC &amp; CPC)</th>
</tr>
</thead>
<tbody>
<tr>
<td>Alkermes Immunotherapies Inc. v. Biogen IDEC</td>
<td>Precedential</td>
<td>659 F.3d 1057, 109 USPQ2d 1492 (Fed. Cir. 2011)</td>
<td>8/31/2013</td>
<td>6,580,799</td>
<td>4,420,139</td>
<td>3,772,583</td>
<td>Method and composition for an early vaccine to protect against both common infectious diseases and chronic immune mediated disorders</td>
<td>Methods</td>
<td>Abstract ideas</td>
</tr>
<tr>
<td>Electric Power Group, LLC v. Alstom</td>
<td>Precedential</td>
<td>830 F.3d 1350, 119 USPQ2d 1799 (Fed. Cir. 2016)</td>
<td>8/1/2016</td>
<td>8,403,710</td>
<td>8,060,529</td>
<td>7,293,848</td>
<td>Real-time monitoring of an electric power grid</td>
<td>Methods and systems</td>
<td>Abstract ideas</td>
</tr>
<tr>
<td>Eastick LLC v. Microsoft Corp.</td>
<td>Precedential</td>
<td>822 F.3d 1327, 118 USPQ2d 1684 (Fed. Cir. 2016)</td>
<td>5/12/2016</td>
<td>8,151,604</td>
<td>8,168,778</td>
<td>Improved information and storage system using a self-referential table</td>
<td>Product</td>
<td>n/a</td>
<td>Eligible</td>
</tr>
</tbody>
</table>
Amgen Memoranda

- **Amgen v. Sanofi**, 872 F.3d 1367 (Fed. Cir. 2017)

- Written description (February 22, 2018): expressly stated that the so-called “newly characterized antigen” test should not be used in determining whether there is adequate written description under 35 U.S.C. § 112(a) for a claim drawn to an antibody.

- Prior art under pre-AIA 35 U.S.C. § 102(e) (April 5, 2018): critical reference date under pre-AIA 35 U.S.C. § 102(e) of a U.S. patent, a U.S. patent application publication, as well as an international application publication having prior art effect under pre-AIA 35 U.S.C. § 102(e), may be the filing date of a relied upon provisional application **only** if at least one of the claims in the reference patent, patent application publication, or international application publication is supported by the written description of the provisional application in compliance with 35 U.S.C. § 112(1)/(a).
Finjan – Core Wireless Memorandum

• Addresses subject matter eligibility case law developments since August 31, 2017 through January of 2018.

• Discusses two decisions finding claims to software-related inventions patent eligible under 35 U.S.C. § 101 because they are not directed to an abstract idea.

• Notes growing body of case law that software-based innovations can make “non-abstract improvements to computer technology” and be deemed patent-eligible subject matter at the first step of the *Alice/Mayo* analysis (USPTO Step 2A).
  – Claim reciting a software-related invention focused on improving computer technology not directed to an abstract idea.
Berkheimer Memorandum

• *Berkheimer* provides clarification regarding the inquiry into whether a claim limitation represents well-understood, routine, conventional activities (or elements) to a skilled artisan in the relevant field.

• Federal Circuit found that the question of whether certain claim limitations are well-understood, routine, conventional elements raised a disputed factual issue, which precluded summary judgment that all of the claims at issue were not patent eligible. See *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018).
Berkheimer Memorandum

- Current MPEP § 2106.05(d)(I): an examiner should conclude that an element (or combination of elements) is well-understood, routine, conventional activity only when the examiner can readily conclude that the element(s) is widely prevalent or in common use in the relevant industry.

- Federal Circuit explain in Berkheimer “Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional.” Berkheimer, 881 F.3d at 1369.
Berkheimer Memorandum

- Clarifies that a conclusion an element (or combination of elements) is well-understood, routine, conventional activity must be based upon an appropriately supported factual determination.

- Clarifies that the analysis as to whether an element (or combination of elements) is widely prevalent or in common use is the same as the analysis under 35 U.S.C. § 112(a) as to whether an element is so well-known that it need not be described in detail in the patent specification.

- The MPEP will be updated to incorporate the changes put into effect by Berkheimer memorandum.
• A conclusion an element (or combination of elements) is well-understood, routine, conventional activity must be supported by—
  – An express statement in the specification, or made by an applicant during prosecution, demonstrating the well-understood, routine, conventional nature of the additional element(s).
  – One or more of the court decisions discussed in MPEP § 2106.05(d)(II) noting the well-understood, routine, conventional nature of the additional element(s).
  – A publication demonstrating the well-understood, routine, conventional nature of the additional element(s).
  – Official notice of the well-understood, routine, conventional nature of the additional element(s)
  – May be used only when the examiner is certain that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art.
Berkheimer Memorandum

• If an applicant challenges the examiner’s position that the additional element(s) is well-understood, routine, conventional activity,
  – the examiner should reevaluate whether the additional elements are in actuality well-understood, routine, conventional activities.

• If the examiner has taken official notice, and the applicant challenges (specifically stating that the element(s) is not well-understood, routine, conventional activity), the examiner must
  – then provide one of the first three factual bases from previous slide, or
  – provide an affidavit or declaration under 37 CFR 1.104(d)(2) setting forth specific factual statements and explanation.
Questions and Comments

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