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SUBJECT MATTER ELIGIBILITY WORKSHEET
Abstract Idea Workshop

This worksheet can be used to assist in analyzing a claim for “Subject Matter Eligibility” (SME) under 35 U.S.C. 101 for any judicial exception (law of nature, natural phenomenon, or abstract idea) in accordance with the [2014 Interim Eligibility Guidance](#). As every claim must be examined individually based on the particular elements recited therein, a separate worksheet should be used to analyze each claim. The use of this worksheet is optional.

Worksheet Summary: Section I is designed to address the first activity in examination, which is to determine what applicant invented and to construe the claim in accordance with its broadest reasonable interpretation (BRI). Next, referring to the eligibility flowchart reproduced in the *Quick Reference Sheet*, Section II addresses *Step 1* regarding the four statutory categories of invention. Section III addresses *Step 2A* by determining whether the claim is directed to an abstract idea. Section IV addresses *Step 2B* by identifying additional elements to determine if the claim amounts to significantly more than an abstract idea.

Application/Example No. and claim: Example 21, claim 1

This claim is referred to as “original claim 1” in the July 2015 Update Training.

I. What did applicant invent?

Review the disclosure to identify what applicant considers as the invention. (MPEP 2103(I))

Applicant invented:

a process for generating customized stock quotes and alerting a remote subscriber that the quotes can be accessed from their computer. The stock quote alerts are generated by filtering received stock quotes, building stock quote alerts and formatting the alerts into data blocks based upon subscriber preference information. The data blocks are transmitted to the subscriber's wireless device which, when connected to the computer, causes the computer to auto-launch a stock viewer application to display the alert and provide access to more detailed information about the stock quote.

Establish the broadest reasonable interpretation (BRI) of the claim.

II. Does the claimed invention fall within one of the four statutory categories of invention (process, machine, manufacture or composition of matter) (Step 1)?

Choose A or B:

A. Yes, the claimed invention is a series of acts, which is a process.

Continue with the SME analysis.

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- B. No, the claimed invention is not one of the four statutory categories. Make a rejection of the claim as being drawn to non-statutory subject matter. *Use Form Paragraphs 7.05 and 7.05.01 available in Custom OACs.*

If the claim could be amended to fall within one of the statutory categories, it is recommended to **continue with the SME analysis** under that assumption. Make the assumption clear in the record if a rejection is ultimately made under *Step 2*, and consider suggesting a potential amendment to applicant that would result in the claim being drawn to a statutory category.

If no amendment is possible, **conclude the SME analysis** and continue with examination under each of the other patentability requirements.

III. Is the claim directed to an abstract idea (Step 2A)?

Courts have found certain concepts to be “abstract ideas”, for example fundamental economic practices, certain methods of organizing human activity, ideas themselves (standing alone), or mathematical relationships/formulae. Identify the claim limitation(s) that correspond to the abstract idea, and explain how such is similar to concepts previously held by the courts to be abstract (Refer to the July 2015 Update Quick Reference Sheet, page 2). A claim is “directed” to an abstract idea when the abstract idea is recited (*i.e.*, **set forth or described**) in the claim.

Choose A, B, or C:

- A. No, the claim does not recite a concept that is similar to those found by the courts to be abstract. **Conclude SME analysis** and continue with examination under each of the other patentability requirements. If needed, the record can be clarified by providing remarks in the Office action regarding interpretation of the claim (*for example*: the broadest reasonable interpretation of the claim is not directed to an abstract idea.)
- B. Yes, but the streamlined analysis is appropriate as the eligibility is self-evident, and a full eligibility analysis is not needed. Applicant’s claimed invention, explained in Section I above, is not focused on the abstract idea, and the claim clearly does not attempt to tie up an abstract idea such that others cannot practice it. (Refer to the [February 2015 Training Slides](#) for information and examples of a streamlined analysis.) **Conclude SME analysis** and continue with examination under each of the other patentability requirements.

- C.** Yes, identify the limitation(s) in the claim that recite(s) the abstract idea and explain why the recited subject matter is an abstract idea. After identifying the abstract idea, **continue with SME analysis**.

The limitation(s) in the claim that set(s) forth or describe(s) the abstract idea is (are):

the steps of receiving stock quotes, filtering the received stock quotes by comparing the received stock quotes to specified stock price values, generating a stock quote alert from the filtered stock quotes that contain a

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stock name, stock price and universal resource locator, which specifies the location of the data source, formatting the stock quote alert into data blocks according to a specified format, and transmitting the formatted stock quote alert based upon a specified address and schedule. The steps of receiving, filtering, and generating describe manipulating information by comparing and sorting the information based on a subscriber's preferences. The step of formatting organizes the information into blocks to facilitate transmission. These steps describe the abstract idea of comparing and organizing information for transmission.

The reason(s) that the limitation(s) are considered an abstract idea is (are):

comparing and organizing information for transmission as described in the claim can be performed mentally. The steps are similar to concepts and ideas that have been identified as abstract by the courts. For example, the idea of using categories to organize and store information for transmission was considered to be abstract in *Cyberfone*, and the idea of comparing new and stored information and using rules to identify options was considered to be abstract in *SmartGene*. These cases can be used as guidance for what type of ideas courts have considered to be abstract. Specifying the type of information being manipulated, which in this case relates to stock quotes and user preferences, does not render the idea of comparing and organizing information any less abstract.

Judicial exceptions need not be old or long-prevalent.

IV. Does the claim as a whole amount to significantly more than the abstract idea (Step 2B)?

- A. Are there any additional elements (features/limitations/step) recited in the claim beyond the abstract idea identified above?

Choose 1 or 2:

1. No, there are no other elements in the claim in addition to the abstract idea.
Conclude SME analysis by making a § 101 rejection and continue with examination under each of the other patentability requirements. *Use Form Paragraphs 7.05 and 7.05.015 available in Custom OACs.*

Are there elements in the disclosure that could be added to the claim that may make it eligible? Identify those elements and consider suggesting them to applicant:

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2. Yes, the claim elements (features/limitations/steps) in addition to the abstract idea are:

a transmission server with a memory that stores subscriber preferences and a microprocessor that performs the steps of comparing and organizing information for transmission to a remote subscriber computer (i.e., the steps of receiving, filtering, generating, formatting, and transmitting).

Continue with the SME analysis.

- B. Evaluate the significance of the additional elements. Identifying additional elements and evaluating their significance involves the search for an “inventive concept” in the claim. It can be helpful to keep in mind what applicant invented (identified in Section I above) and how that relates to the additional elements to evaluate their significance.

Consider all of the identified additional elements individually and in combination to determine whether the claim as a whole amounts to significantly more than the abstract idea identified above. Reasons supporting the significance of the additional elements can include one or more of the following:

- improves another technology or technical field
- improves the functioning of a computer itself
- applies the abstract idea with, or by use of, a particular machine
 - *not* a generic computer performing generic computer functions
 - *not* adding the words “apply it” or words equivalent to “apply the abstract idea”
 - *not* mere instructions to implement an abstract idea on a computer
- effects a transformation or reduction of a particular article to a different state or thing
- adds a specific limitation other than what is well-understood, routine and conventional in the field
 - *not* appending well-understood, routine, and conventional activities previously known to the industry, specified at a high level of generality
 - *not* a generic computer performing generic computer functions
- adds unconventional steps that confine the claim to a particular useful application
 - *not* adding insignificant extrasolution activity, such as mere data gathering

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- adds meaningful limitations that amount to more than generally linking the use of the abstract idea to a particular technological environment

Complete (1) or (2) below:

1. Yes, the additional elements, taken individually or as a combination, result in the claim amounting to significantly more than the abstract idea because

If any elements, individually or as a combination, amount to the claim reciting significantly more than the abstract idea, **conclude SME analysis** and continue with examination under each of the other patentability requirements. If needed, the record can be clarified by providing remarks in the Office action regarding interpretation of the claim (*for example*: the claim recites the abstract idea of “x”, but amounts to significantly more than the idea itself with the additional element “y” because “abc”.)

2. No, the additional elements, taken individually and as a combination, do not result in the claim amounting to significantly more than the abstract idea because

the transmission server is recited at a high level of generality and its broadest reasonable interpretation comprises only a microprocessor and memory that simply perform generic computer functions, including receiving, manipulating and transmitting information to a remote subscriber computer. Generic computers performing generic computer functions to apply an abstract idea do not amount to significantly more than the abstract idea. The additional computer limitations do not add an inventive concept to the abstract idea of comparing and organizing information for transmission. It is also noted that the Internet limitations are simply a field of use that attempt to limit the abstract idea to a particular technological environment and do not add significantly more. Viewing the limitations as a combination does not add anything further than looking at the limitations individually.

Note that absence of complete preemption does not equate to eligibility.

The claim is ineligible.

If no elements, taken individually and as a combination, amount to the claim reciting significantly more than the abstract idea, **conclude the SME analysis** by making a § 101

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Note:
There may be other limitations that could potentially be added such that the claim would amount to significantly more than the abstract idea.

rejection and continue with examination under each of the other patentability requirements. *Use Form Paragraphs 7.05 and 7.05.015 available in Custom OACs.*

Are there elements in the disclosure that could be added to the claim that may make it eligible? Identify those elements and consider suggesting them to applicant:

Yes, e.g., the disclosed elements of transmitting the alert over a wireless communication channel to activate a stock viewer application, and causing the alert to display and enable connection of the remote subscriber computer to the data source over the Internet. For an example of a claim reciting these elements in a manner that results in the claim as a whole amounting to significantly more, see claim 2 of Example 21 (referred to as "amended claim 1" in the July 2015 Update Training).

Sample Rejection:

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Claim 1 is directed to

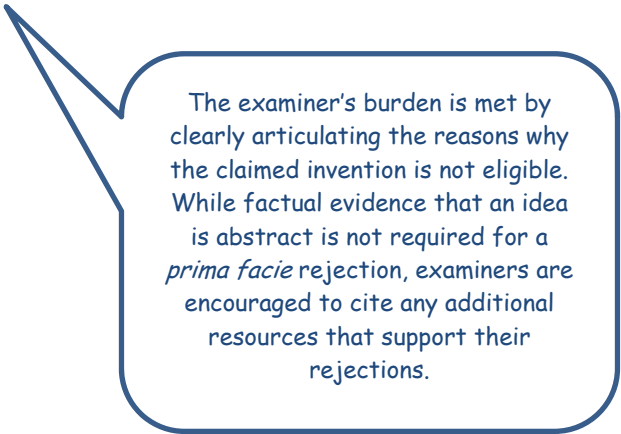
comparing and organizing information (i.e., the steps of receiving, filtering, generating, and formatting) for transmission, which is similar to concepts that have been identified as abstract by the courts, such as using categories to organize, store and transmit information in *Cyberfone* or comparing new and stored information and using rules to identify options in *SmartGene*.

The claim does not include additional elements that are sufficient to amount to significantly more than the judicial exception because

the additional elements when considered both individually and as a combination do not amount to significantly more than the abstract idea. The claim recites the additional elements of a transmission server with a memory to store subscriber preferences and a microprocessor to perform the receiving, comparing, organizing, formatting and transmitting steps. The transmission server is recited at a high level of generality and only performs generic functions of manipulating information and transmitting that information to a remote subscriber computer. Generic computers performing generic computer functions, without an inventive concept, do not amount to significantly more than the abstract idea. The Internet limitations are simply a field of use that attempt to limit the abstract idea to a particular technological environment. The type of information being manipulated does not

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impose meaningful limitations or render the idea less abstract. Looking at the elements as a combination does not add anything more than the elements analyzed individually. Therefore, the claim does not amount to significantly more than the abstract idea itself. The claim is not patent eligible.



The examiner's burden is met by clearly articulating the reasons why the claimed invention is not eligible. While factual evidence that an idea is abstract is not required for a *prima facie* rejection, examiners are encouraged to cite any additional resources that support their rejections.

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Worksheet Summary: Section I is designed to address the first activity in examination, which is to determine what applicant invented and to construe the claim in accordance with its broadest reasonable interpretation (BRI). Next, referring to the eligibility flowchart reproduced in the *Quick Reference Sheet*, Section II addresses *Step 1* regarding the four statutory categories of invention. Section III addresses *Step 2A* by determining whether the claim is directed to an abstract idea. Section IV addresses *Step 2B* by identifying additional elements to determine if the claim amounts to significantly more than an abstract idea.

Application/Example No. and claim: Example 21, claim 2

This claim is referred to as “amended claim 1” in the July 2015 Update Training.

I. What did applicant invent?

Review the disclosure to identify what applicant considers as the invention. (MPEP 2103(I))

Applicant invented:

a process for generating customized stock quotes and alerting a remote subscriber that the quotes can be accessed from their computer. The stock quote alerts are generated by filtering received stock quotes, building stock quote alerts and formatting the alerts into data blocks based upon subscriber preference information. If the subscriber's computer is offline, the data blocks are transmitted to the subscriber's wireless device which, when connected to the computer, causes the computer to auto-launch a stock viewer application to display the alert and provide access to more detailed information about the stock quote.

Establish the broadest reasonable interpretation (BRI) of the claim.

II. Does the claimed invention fall within one of the four statutory categories of invention (process, machine, manufacture or composition of matter) (Step 1)?

Choose A or B:

- A. Yes, the claimed invention is a series of acts, which is a process.

Continue with the SME analysis.

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- B. No, the claimed invention is not one of the four statutory categories. Make a rejection of the claim as being drawn to non-statutory subject matter. Use *Form Paragraphs 7.05 and 7.05.01 available in Custom OACs*.

If the claim could be amended to fall within one of the statutory categories, it is recommended to **continue with the SME analysis** under that assumption. Make the assumption clear in the record if a rejection is ultimately made under *Step 2*, and consider suggesting a potential amendment to applicant that would result in the claim being drawn to a statutory category.

If no amendment is possible, **conclude the SME analysis** and continue with examination under each of the other patentability requirements.

III. Is the claim directed to an abstract idea (Step 2A)?

Courts have found certain concepts to be “abstract ideas”, for example fundamental economic practices, certain methods of organizing human activity, ideas themselves (standing alone), or mathematical relationships/formulae. Identify the claim limitation(s) that correspond to the abstract idea, and explain how such is similar to concepts previously held by the courts to be abstract (Refer to the July 2015 Update Quick Reference Sheet, page 2). A claim is “directed” to an abstract idea when the abstract idea is recited (*i.e.*, **set forth or described**) in the claim.

Choose A, B, or C:

- A. No, the claim does not recite a concept that is similar to those found by the courts to be abstract. **Conclude SME analysis** and continue with examination under each of the other patentability requirements. If needed, the record can be clarified by providing remarks in the Office action regarding interpretation of the claim (*for example*: the broadest reasonable interpretation of the claim is not directed to an abstract idea.)
- B. Yes, but the streamlined analysis is appropriate as the eligibility is self-evident, and a full eligibility analysis is not needed. Applicant’s claimed invention, explained in Section I above, is not focused on the abstract idea, and the claim clearly does not attempt to tie up an abstract idea such that others cannot practice it. (Refer to the [February 2015 Training Slides](#) for information and examples of a streamlined analysis.) **Conclude SME analysis** and continue with examination under each of the other patentability requirements.

- C.** Yes, identify the limitation(s) in the claim that recite(s) the abstract idea and explain why the recited subject matter is an abstract idea. After identifying the abstract idea, **continue with SME analysis**.

The limitation(s) in the claim that set(s) forth or describe(s) the abstract idea is (are):

the steps of receiving stock quotes, filtering the received stock quotes by comparing the received stock quotes to specified stock price values, generating a stock quote alert from the filtered stock quotes that contain a

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stock name, stock price and universal resource locator, which specifies the location of the data source, formatting the stock quote alert into data blocks according to a specified format, and transmitting the formatted stock quote alert based upon a specified address and schedule. The steps of receiving, filtering, and generating describe manipulating information by comparing and sorting the information based on a subscriber's preferences. The step of formatting organizes the information into blocks to facilitate transmission. These steps describe the abstract idea of comparing and organizing information for transmission.

The reason(s) that the limitation(s) are considered an abstract idea is (are):

comparing and organizing information for transmission as described in the claim can be performed mentally. The steps are similar to concepts and ideas that have been identified as abstract by the courts. For example, the idea of using categories to organize and store information for transmission was considered to be abstract in *Cyberfone*, and the idea of comparing new and stored information and using rules to identify options was considered to be abstract in *SmartGene*. These cases can be used as guidance for what type of ideas courts have considered to be abstract. Specifying the type of information being manipulated, which in this case relates to stock quotes and user preferences, does not render the idea of comparing and organizing information any less abstract.



Judicial exceptions need not be old or long-prevalent.

IV. Does the claim as a whole amount to significantly more than the abstract idea (Step 2B)?

- A. Are there any additional elements (features/limitations/step) recited in the claim beyond the abstract idea identified above?

Choose 1 or 2:

1. No, there are no other elements in the claim in addition to the abstract idea.
Conclude SME analysis by making a § 101 rejection and continue with examination under each of the other patentability requirements. *Use Form Paragraphs 7.05 and 7.05.015 available in Custom OACs.*

Are there elements in the disclosure that could be added to the claim that may make it eligible? Identify those elements and consider suggesting them to applicant:

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2. Yes, the claim elements (features/limitations/steps) in addition to the abstract idea are:

a transmission server with a memory that stores subscriber preferences and a microprocessor that performs the steps of comparing and organizing information for transmission (i.e., the steps of receiving, filtering, generating, formatting, and transmitting). The claim also recites using a wireless device to receive information over a data channel from the transmission server and locally transmit information to a subscriber computer. Finally, the claim recites a stock quote viewer application that is installed on the remote subscriber computer and causes the stock quote alert to display on the subscriber computer and enables a connection from the subscriber computer to the data source over the Internet when the subscriber computer comes online.

Continue with the SME analysis.

- B. Evaluate the significance of the additional elements. Identifying additional elements and evaluating their significance involves the search for an “inventive concept” in the claim. It can be helpful to keep in mind what applicant invented (identified in Section I above) and how that relates to the additional elements to evaluate their significance.

Consider all of the identified additional elements individually and in combination to determine whether the claim as a whole amounts to significantly more than the abstract idea identified above. Reasons supporting the significance of the additional elements can include one or more of the following:

- improves another technology or technical field
- improves the functioning of a computer itself
- applies the abstract idea with, or by use of, a particular machine
 - *not* a generic computer performing generic computer functions
 - *not* adding the words “apply it” or words equivalent to “apply the abstract idea”
 - *not* mere instructions to implement an abstract idea on a computer
- effects a transformation or reduction of a particular article to a different state or thing
- adds a specific limitation other than what is well-understood, routine and conventional in the field

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- *not* appending well-understood, routine, and conventional activities previously known to the industry, specified at a high level of generality
- *not* a generic computer performing generic computer functions
- adds unconventional steps that confine the claim to a particular useful application
 - *not* adding insignificant extrasolution activity, such as mere data gathering
- adds meaningful limitations that amount to more than generally linking the use of the abstract idea to a particular technological environment

Complete (1) or (2) below:

1. Yes, the additional elements, taken individually or as a combination, result in the claim amounting to significantly more than the abstract idea because

Although some of the claim elements when viewed individually do not amount to significantly more (e.g., storing subscriber preferences), when the additional limitations are viewed as a combination, the claim as a whole amounts to significantly more than simply organizing and comparing information (the abstract idea itself).

An explanation of why the claim is eligible is not necessary in the Office action unless there would be a question as to the reasoning such that the record would benefit from clarification.

The claimed invention addresses the Internet-centric challenge of alerting a subscriber with time sensitive information when the subscriber's computer is offline. This is applied by transmitting the alert over a wireless communication channel to activate the stock viewer application, which causes the alert to display and enables the connection of the remote subscriber computer to the data source over the Internet when the remote subscriber computer comes online. These are meaningful limitations that add more than generally linking the use of the abstract idea (the general concept of organizing and comparing data) to the Internet because they solve an Internet-centric problem with a claimed solution that is necessarily rooted in computer technology, similar to the additional elements in *DDR Holdings*. These limitations, when taken as a combination, provide unconventional steps that confine the abstract idea to a particular useful application, such that the claim as a whole amounts to significantly more than the abstract idea itself. Therefore, the claim recites patent eligible subject matter (*Step 2B: YES*).

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The claim is eligible.

If any elements, individually or as a combination, amount to the claim reciting significantly more than the abstract idea, **conclude SME analysis** and continue with examination under each of the other patentability requirements. If needed, the record can be clarified by providing remarks in the Office action regarding interpretation of the claim (*for example*: the claim recites the abstract idea of “x”, but amounts to significantly more than the idea itself with the additional element “y” because “abc”.)

2. No, the additional elements, taken individually and as a combination, do not result in the claim amounting to significantly more than the abstract idea because

If no elements, taken individually and as a combination, amount to the claim reciting significantly more than the abstract idea, **conclude the SME analysis** by making a § 101 rejection and continue with examination under each of the other patentability requirements. *Use Form Paragraphs 7.05 and 7.05.015 available in Custom OACs.*

Are there elements in the disclosure that could be added to the claim that may make it eligible? Identify those elements and consider suggesting them to applicant:

Sample Rejection:

Claim _ is rejected under 35 U.S.C. 101 because the claimed invention is directed to a judicial exception (i.e., a law of nature, a natural phenomenon, or an abstract idea) without significantly more. Claim _ is directed to

The claim does not include additional elements that are sufficient to amount to significantly more than the judicial exception because

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