

Frequently Asked Questions (FAQs) on the 2019 Revised Patent Subject Matter Eligibility Guidance (“2019 PEG”)

The following FAQs should be used in conjunction with the 2019 PEG. These FAQs are designed to assist examiners in understanding the 2019 PEG. They are being shared with the public as a tool to better understand the 2019 PEG and its application by examiners.

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A. General

A-1. When should examiners begin implementing the 2019 PEG?

Answer: Immediately. The 2019 PEG became effective as of its publication on January 7, 2019.

A-2. *When and where will information on the 2019 PEG be available?*

Answer: Information on the 2019 PEG is posted to the external website (and the 101 microsite). The website and microsite will be updated with training materials, FAQs, and other informational materials as they become available.

The external website link is: <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>

The 101 microsite link is:

<http://ptoweb.uspto.gov/patents/exTrain/101.html>

A-3. *To whom should I direct my examination questions about the 2019 PEG?*

Answer: Each Technology Center has a list of POCs that can be consulted for questions regarding § 101. The list of POCs can be viewed on the 101 microsite.

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A-4. Will I receive training on the 2019 PEG?

Answer: Yes. All patent examiners (except those in TC 2900) will be trained on the 2019 PEG. Some examiners may receive more in depth training than others, depending on the technology area in which they work. All training materials will be posted on the 101 microsite.

A-5. Why is the 101 guidance being revised?

Answer: As explained in more detail in the Federal Register Notice announcing the 2019 PEG, the Office’s subject matter eligibility guidance was revised for several reasons:

1. To increase clarity, predictability and consistency in how Section 101 is applied during examination; and
2. To enable examiners to more readily determine if a claim does (or does not) recite an abstract idea.

A-6. Does the 2019 PEG change the overall subject matter eligibility framework?

Answer: No. The 2019 PEG still follows the *Alice/Mayo* two-step framework. In addition, there are no changes to many portions of the existing guidance: Step 1 (statutory categories), the streamlined analysis, and Step 2B.

A-7. What changes does the 2019 PEG make to existing guidance?

Answer: There are two changes. First, the 2019 PEG revises the procedure at Step 2A for determining whether a claim is directed to a judicial exception (laws of nature, natural phenomena, abstract ideas) by using a two-prong inquiry. Under this two-prong inquiry, a claim is eligible at revised Step 2A unless it: 1) recites a judicial exception; and 2) the exception is not integrated into a practical application of the exception. Second, the 2019 PEG explains that the abstract idea exception includes the following groupings of subject matter (“enumerated groupings of abstract ideas”): mathematical concepts, certain methods of organizing human activity, and mental processes. Examiners are to use these enumerated grouping of abstract ideas to identify abstract ideas. In addition, examiners are no longer to use the document entitled “Eligibility Quick Reference Sheet Identifying Abstract Ideas” when determining whether a claim recites an abstract idea.

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A-8. *I have an application where it is a “close call” as to whether the claim is eligible. Should I go ahead and make the rejection under the 2019 PEG or should I find the claim to be eligible?*

Answer: Section 706(I) of the Manual of Patent Examining Procedure (MPEP¹) discusses that the standard to be applied in all cases is the “preponderance of the evidence” test. The examiner should not reject a claim under 35 U.S.C. § 101 as being directed to patent ineligible subject matter unless the examiner concludes that it is more likely than not that the claim is patent ineligible.

A-9. *Has Step 1 or the streamlined analysis changed in view of Revised Step 2A?*

Answer: No. Step 1 and the streamlined analysis have not changed under the 2019 PEG.

B. Existing Guidance and Training Materials

B-1. *Does the 2019 PEG supersede MPEP 2106? Are there any other MPEP sections that are impacted?*

Answer: The 2019 PEG supersedes section 2106.04(II) (Eligibility Step 2A: Whether a Claim Is Directed to a Judicial Exception), along with any other portion of the MPEP that conflicts with the guidance. A chart indicating the MPEP sections that are affected by the 2019 PEG is posted on the 101 microsite.

B-2. *How does the 2019 PEG impact the existing guidance materials?*

Answer: The 2019 PEG changes Step 2A in a way that supersedes MPEP section 2106.04(II), but otherwise the existing guidance remains in effect. The memoranda issued in 2018, specifically the memos in response to *Finjan* and *Core Wireless, Berkheimer, and Vanda*, have not been superseded by this guidance and remain in effect. It is noted that any claim considered eligible under prior guidance since 2014 should still be considered eligible under this guidance. See FAQ A-7 for more information about how the 2019 PEG changes Step 2A, and FAQ B-1 for more information about how the 2019 PEG affects the MPEP.

B-3. *What subject matter eligibility guidance should I rely on today?*

Answer: As of the date of publication of the 2019 PEG, you should rely on the current version of the MPEP (except for the superseded sections noted in FAQ

¹ All reference to the MPEP in the 2019 PEG are to the Ninth Edition, R-08.2017, of the MPEP (published January 2018).

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B-1), the 2019 PEG, and the memoranda issued in response to *Finjan* and *Core Wireless, Berkheimer, and Vanda*.

B-4. Can I still rely on the Eligibility Quick Reference Sheet Identifying Abstract Ideas (“Abstract Idea QRS”)?

Answer: No. The 2019 PEG supersedes all versions of the Abstract Idea QRS. The Abstract Idea QRS is no longer to be relied upon when determining whether a claim recites an abstract idea. Examiners are now to rely upon the abstract ideas as enumerated in the 2019 PEG.

B-5. Will the Chart of SME Court Decisions continue to be updated?

Answer: Yes. The Chart of SME Court decisions will continue to be updated.

B-6. Which of the published examples should I rely on today to help me understand how to apply the 2019 PEG?

Answer: You should rely on new Examples 37-42 to help you understand how the Office applies the 2019 PEG in certain fact-specific situations. Existing examples 1-36 were issued prior to the 2019 PEG, and some of them present analyses that may not be entirely consistent with the 2019 PEG. Thus, although all the claims indicated as eligible in prior Examples 1-36 are still eligible today, you should use these examples with caution.

C. Finality and Applications Currently In Prosecution

C-1. How should an examiner handle applications that are currently in prosecution when, prior to the issuance of the 2019 PEG, the examiner rejected the claims as being ineligible? For example, my prior § 101 rejections did not analyze the claim to determine whether it integrated the abstract idea into a practical application.

Answer: When the application is next due for examiner action, the examiner must analyze the claim(s) under § 101 in light of the 2019 PEG.

- If the examiner determines that the claim(s) does not recite a judicial exception, then it is eligible. The previous § 101 rejection should be withdrawn.
- If the examiner determines that the claim(s) integrates the judicial exception into a practical application, then it is eligible. The previous § 101 rejection should be withdrawn.
- If the examiner determines that the claim(s) provides an inventive concept (also called “significantly more”), then it is eligible. The previous § 101 rejection should be withdrawn.

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If the examiner determines that the claim(s) remains ineligible under the 2019 PEG, the rejection can be made final if the basic thrust of the rejection under § 101 in the present Office action will remain the same from a previous Office action issued before the 2019 PEG. If the basic thrust of the § 101 rejection is changed in the next rejection, that rejection cannot be made final. See FAQ C-2 for more information about determining what constitutes a new ground of rejection, and FAQ C-3 for more information about identifying abstract ideas under the 2019 PEG.

C-2. How do I know when the basic thrust of a rejection under § 101 rejection has changed, such that there is a new ground of rejection?

Answer: The MPEP provides general guidance on determining what constitutes a new ground of rejection in MPEP 706.07(a) and 1207.03(a), and specific guidance with respect to § 101 issues in MPEP 2106.07(b). In addition, with respect to the 2019 PEG, situations that do not constitute a new grounds of rejection include:

- Maintaining the position that the claim recites an abstract idea, but changing the supporting explanation to refer to the enumerated groupings of abstract ideas instead of to a particular judicial decision (see FAQ C-3 for more information); and
- Relying on the same Step 2B considerations under Revised Step 2A – Prong 2 and Step 2B as were previously relied upon; and
- Changing the form paragraph(s) used in the rejection. See FAQ E-2 for more information about the new form paragraphs.

A new ground of rejection may be present when a rejection relies upon new facts or a new rationale not previously raised to the applicant. If the basic thrust of the § 101 rejection is changed in the next rejection, that rejection cannot be made final.

C-3. My prior rejection under § 101 relied on a court decision to support the identification of the claim as reciting an abstract idea. I have re-evaluated the claim under the 2019 PEG and it is still ineligible, but I am having difficulty determining whether I can make the next action final. What are some examples of changes to the supporting explanation for why a claim recites an abstract idea that would not constitute a new ground of rejection?

Answer: Here are three examples.

Example 1: assume that the previous § 101 rejection had identified particular claim limitations as an abstract idea because they recited mathematical calculations (*i.e.*, multiplying numbers), and cited *Flook* in support of this identification. It would not change the basic thrust of this rejection if the examiner were now to state that those same claim limitations are an abstract

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idea because these calculations are “mathematical concepts” as enumerated in the 2019 PEG.

Example 2: assume that the previous § 101 rejection had identified particular claim limitations as reciting an abstract idea of local processing of payments for remotely purchased goods, and cited the *Inventor Holdings* decision in support of this identification. It would not change the basic thrust of this rejection if the examiner were now to state that those same claim limitations are an abstract idea because they are a fundamental economic concept or sales activity that falls within the enumerated group of “certain methods of organizing human activity” in the 2019 PEG.

Example 3: assume the previous § 101 rejection had identified particular claim limitations as an “idea of itself”-type abstract idea because they were mental steps of evaluating loan terms in connection with performing anonymous loan shopping, and cited the *Mortgage Grader* decision in support of this identification. It would not change the basic thrust of this rejection if the examiner were now to state that those same claim limitations are an abstract idea because they are mental steps that fall within the “mental processes” group of abstract ideas in the 2019 PEG. It would also not change the basic thrust of this rejection if the examiner were now to state that those same claim limitations are an abstract idea because they are a fundamental economic concept that falls within the enumerated group of “certain methods of organizing human activity” in the 2019 PEG.

- C-4. *My prior rejection under § 101 identified a particular claim limitation as an abstract idea and relied on a court decision to support the identification of the claim as reciting an abstract idea. I have re-evaluated the claim limitation under the 2019 PEG and determined that it does not fall within the enumerated groupings of abstract ideas, but I still believe this claim limitation is an abstract idea. What do I do?*

Answer: You should follow the procedure for “tentative abstract ideas” that is described in the 2019 PEG, and obtain approval of the Technology Center Director before mailing a rejection of this claim. This situation should be rare.

- C-5. *If applicant argues in a response to a final rejection that an examiner has applied the past guidance in the § 101 rejection and should apply the 2019 PEG, how should the examiner proceed?*

Answer: Assuming that the basic thrust of the rejection will remain the same and the examiner determines that it is appropriate to maintain the rejection, the examiner should indicate such in an Advisory Action and provide an analysis under the 2019 PEG. If the examiner determines that it is appropriate to maintain the rejection, but the thrust of the § 101 rejection has changed under the 2019 PEG, the examiner will need to re-open prosecution. When prosecution is re-opened for this reason, the next Office action cannot be final.

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If the examiner determines that it is appropriate to withdraw the § 101 rejection, the examiner should indicate such in an Advisory Action or other action as appropriate. See FAQs C-1 through C-4 for more information about how to handle applications currently in prosecution in which a § 101 rejection was made prior to the issuance of the 2019 PEG.

- C-6. *I previously did not reject a claim as being ineligible under § 101 because the claimed concept was not similar to a concept previously found to be abstract by the court. However, upon reevaluating the claim in light of the 2019 PEG, I have determined that the claim is ineligible. Should I make a new rejection under § 101?*

Answer: Any claim considered patent eligible under the current version of the MPEP and subsequent guidance should be considered patent eligible under the 2019 PEG. Because the claim at issue was considered eligible under the current version of the MPEP, the examiner should not make a rejection under § 101 in view of the 2019 PEG.

- C-7. *If an applicant amends the claim(s) sufficiently to necessitate new grounds of rejection under § 102 or § 103, but a new § 101 rejection is going to be made in view of the 2019 PEG, can the next action be made final?*

Answer: If the new § 101 rejection is necessitated by applicant’s amendment of the claims, then it would be appropriate to make the next action final under this scenario. An example of such a scenario is when applicant amends an existing claim to newly recite (or adds a new claim that recites) a judicial exception such as a mathematical formula, but the claim does not recite additional elements that practically apply that exception or provide an inventive concept. As discussed in FAQ C-6, however, examiners should keep in mind that the 2019 PEG should not result in the rejection of any claim considered patent eligible under the current version of the MPEP.

- C-8. *What should I do if I get a call from applicant after publication of the 2019 PEG requesting a supplemental Office action with reconsideration of an outstanding 35 U.S.C. § 101 rejection that was made prior to publication of the 2019 PEG?*

Answer: If applicant has specific arguments as to how the prior rejection does not comply with the new guidance, Applicant should file a response that specifically points out the errors in the examiner’s action in accordance with 37 CFR 1.111(b). An interview may be conducted to clarify the issues, in accordance with MPEP 713, however a new Office action should not be issued solely in response to an oral request. See 37 CFR 1.2 (“All business with the Patent and Trademark Office should be transacted in writing.”). See FAQ C-1 through C-4 for more information about how to handle applications containing an outstanding Section 101 rejection that was made prior to publication of the 2019 PEG.

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D. Appeals

D-1. After a Notice of Appeal has been filed and the final rejection rejected one or more claims under §101, does a Technology Center need to reopen prosecution to provide a new §101 rejection in view of the 2019 PEG or can it be applied as a new grounds of rejection in the examiner’s answer?

Answer: It is at the discretion of the Technology Center as to whether prosecution needs to be reopened or whether to designate a new grounds of rejection in the examiner’s answer. Examiners should confer with their SPE if they are aware of an application on appeal that potentially has these issues. See MPEP 1207.03 for more information about new grounds of rejection in an examiner’s answer.

E. Drafting An Office Action

E-1. How will my rejections change from prior § 101 rejections?

Answer: If it is determined that the claim does not recite eligible subject matter, a rejection under § 101 is appropriate. There are new form paragraphs that should be used when drafting a rejection, as explained in FAQ E-2. When making the rejection, the Office action must provide an explanation as to why each claim is patent ineligible, which must be sufficiently clear and specific to provide applicant sufficient notice of the reasons for ineligibility and enable the applicant to effectively respond.

For other judicial exceptions, a subject matter eligibility rejection in view of the 2019 PEG will differ from prior rejections in the following ways:

- For abstract ideas, the rejection will explain why a specific limitation(s) recited in the claim corresponds to an enumerated grouping of abstract ideas or provide a justification for why a specific limitation(s) recited in the claim is being treated as an abstract idea if it does not fall within the enumerated groupings of abstract ideas (The latter situation will be rare and Technology Center Director approval is required); and
- The rejection will provide an explanation as to why the claim does not integrate the judicial exception (law of nature, natural phenomenon, abstract idea) into a practical application.

Because the 2019 PEG did not change the Step 2B analysis, the explanation of Step 2B in a rejection written after the 2019 PEG will not necessarily differ from the explanation of Step 2B in a rejection written prior to the 2019 PEG. It

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is likely, however, that the explanation of Step 2B in a rejection written after the 2019 PEG will be shorter than in previous rejections, because many of the judicial considerations evaluated in revised Step 2A are not reevaluated in Step 2B.

E-2. What form paragraph(s) do I use when making a rejection under the 2019 PEG?

Answer: Form paragraph 7.05.015 has been superseded and should no longer be used. For “Step 2B” rejections based on a failure to claim an invention that is directed to patent-eligible subject matter (*i.e.*, the claim is directed to a judicial exception without providing an inventive concept/significantly more at Step 2B of the eligibility analysis), use existing form paragraphs 7.04.01, 7.05 and the following new form paragraph(s):

- If the recited judicial exception is an abstract idea enumerated in the 2019 PEG, a law of nature, or a natural phenomenon, use new form paragraph 7.05.016; or
- If the recited judicial exception is an abstract idea that is not enumerated in the 2019 PEG, use new form paragraph 7.05.016 and new form paragraph 7.05.017 because Director approval is required.

E-3. If I determine that a claim that was previously rejected as being ineligible is eligible in light of the 2019 PEG, how can I best clarify the record? Should I explain on the record the reason for withdrawing a 35 U.S.C. § 101 rejection after publication of the 2019 PEG?

Answer: If a 35 U.S.C. § 101 rejection was made in a previous Office action using the previous guidance and the claim is considered patent-eligible under the new guidance, it is helpful if the examiner clarifies the record by briefly discussing why the rejection is being withdrawn. MPEP 2106.07(c) discusses clarifying the record. When the claims are deemed patent eligible, the examiner may make clarifying remarks on the record. For example, if a claim is found eligible because it does not recite an abstract idea, the examiner could indicate as such in the Office action. The clarifying remarks may be made at any point during prosecution as well as with a notice of allowance.

E-4. I am responding to arguments from applicant in which I relied upon a case to support my identification of the claimed concept as abstract. The applicant argues that the pending claim is different from the case. How should I proceed if I decide to maintain the rejection? For example, do I need to address applicant’s arguments with respect to the specific case? Can I simply cite to one of the enumerated groupings of abstract ideas to show that the claimed concept is abstract?

Answer: The examiner should indicate that the 2019 PEG is now applicable, and point out which of the enumerated groupings of abstract ideas applies to

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the claimed concept previously identified as an abstract idea. The 2019 PEG is consistent with the Supreme Court and Federal Circuit subject matter eligibility decisions. Thus, an examiner should consider and address applicant’s arguments with respect to any specific case in the manner that an examiner would consider and address a specific case cited by an applicant in response to a rejection on another patentability ground (e.g., 35 U.S.C. § 103 or non-statutory double patenting). The examiner may wish to explicitly state in the action that merely pointing out the appropriate grouping(s) into which the previously-identified abstract idea falls does not change the basic thrust of the rejection. See FAQ C-2 for more information about determining what constitutes a new ground of rejection, and FAQ C-3 for more information about identifying abstract ideas under the 2019 PEG.

F. Step 2A – Prong 1

F-1. Can I still cite a court decision in my Office actions to support the identification of the subject matter recited in the claim language as an abstract idea?

Answer: Under the 2019 PEG, you should cite to one of the enumerated groupings of abstract ideas. You may cite a court decision to support identification of the subject matter recited in the claim language as an abstract idea, but the identification of the subject matter recited in the claim language as an abstract idea should be consistent with the 2019 PEG.

F-2. It seems the definitions sweep in more types of claims than under the prior guidance. Is this true?

Answer: No. The definitions are not intended to sweep in more types of claims than under prior guidance since 2014. Any claim considered eligible under the current version of the MPEP and subsequent guidance should still be considered eligible under the 2019 PEG.

F-3. How do I determine if a claim I am examining falls into one of the enumerated groupings of abstract ideas?

Answer: Under the 2019 PEG, you should continue the existing practice of establishing, prior to examining a claim for eligibility, the broadest reasonable interpretation of the claim in view of the specification as it would be understood by one of ordinary skill in the art (the BRI). If at least one embodiment within the BRI of the limitation(s) when viewed in the context of the claim as a whole falls within the scope of one of the enumerated groupings of abstract ideas, then the claim recites an abstract idea in Step 2A Prong One. Such a claim requires further analysis at Step 2A Prong Two to determine if the judicial exception is integrated into a practical application of the exception. See MPEP 2111 for more information about determining the BRI, and MPEP

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2106(II) for more information about how the BRI affects subject matter eligibility determinations.

- F-4. Can I compare the claimed concept in my application to the claim in one of the § 101 examples to determine whether the claim recites an abstract idea?*

Answer: No. You should compare the claimed concept in your application to the enumerated groupings in the 2019 PEG. The examples should not be used as a basis for a subject matter eligibility rejection. The examples, however, may be considered as showing the application of the enumerated groupings in the 2019 PEG with respect to particular fact situations. While it may be acceptable for applicants to cite an example in support of an argument for finding eligibility in an appropriate factual situation, applicants should not be required to model their claims or responses after the examples to attain eligibility.

- F-5. Does the abstract idea grouping “certain methods of organizing human activity” encompass interactions between two or more people or could the interactions be between, for example, a person and a computer?*

Answer: This grouping encompasses both activity of a single person (for example a person following a set of instructions) and activity that involves multiple people (such as a commercial or legal interaction). Thus, some interactions between a person and a computer (for example a method of anonymous loan shopping that a person conducts using a mobile phone) may fall within this grouping.

G. Step 2A – Prong 2 (Integration into a practical application)

- G-1. How is the analysis of whether the claim integrates the exception into a practical application in Step 2A - Prong Two different than the analysis under Step 2B?*

Answer: The analysis in Step 2A – Prong Two is not found in the prior guidance. In Step 2A – Prong Two, examiners are to identify whether there are any additional elements recited in the claim beyond the judicial exception(s) and evaluate those additional elements to determine whether they integrate the exception into a practical application of the exception. The 2019 PEG defines the phrase “integration into a practical application of the exception” to require the additional element(s) or a combination of elements in the claim to apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the exception.

Step 2A – Prong Two is similar to Step 2B in that both analyses involve evaluating a set of judicial considerations (such as whether an additional

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element reflects an improvement to the functioning of a computer or other technology) to determine if the claim is eligible. While most of these considerations overlap (i.e., they are evaluated in both Step 2A – Prong Two and Step 2B), Step 2A – Prong Two does not include consideration of whether claim elements represents well-understood, routine, conventional activity. This consideration is evaluated in Step 2B. Because Step 2A – Prong Two does not evaluate whether an additional element is well-understood, routine, conventional activity, a claim that includes conventional elements may still integrate an exception into a practical application in Step 2A – Prong Two and thus be eligible.

G-2. How do I analyze whether a claim is directed to an improvement to the functioning of a computer or to another technology?

Answer: The 2019 PEG changes the improvement analysis previously performed at Step 2A. In particular, under the 2019 PEG, your analysis of the “improvements” consideration in Step 2A should determine whether the claim pertains to an improvement to the functioning of a computer or to another technology without reference to what is well-understood, routine, conventional activity. Examiners should refer to MPEP 2106.04(a) and 2106.05(a) for a discussion of improvements to the functioning of a computer or improvements to any other technology or technical field, insofar as those sections of the MPEP do not contradict the 2019 PEG.

G-3. Can a claim element that is well-understood, routine, conventional activity integrate a judicial exception into a practical application?

Answer: Yes. An additional element (or elements) in the claim can integrate a recited judicial exception(s) into a practical application even if the additional element is well-understood, routine, conventional activity. So in Step 2A – Prong Two, you should consider all additional elements, whether or not they are conventional, when evaluating whether a judicial exception has been integrated into a practical application.

H. Step 2B (Inventive Concept aka “Significantly More”)

H-1. Do I still need to provide proof to support an assertion that an element (or combination) is well-understood, routine, conventional activity in accordance with the guidance in the Berkheimer memo?

Answer: Yes. The guidance in the *Berkheimer* memo is still applicable when an examiner asserts that an element (or combination) is well-understood, routine, conventional activity. The examiner must support the statement with one of the memo options 1-4.

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H-2. If I concluded that the claim was not integrated into a practical application because an additional element was insignificant extra-solution activity, am I required to analyze the claim under Step 2B?

Answer: Yes. If you had previously concluded under revised Step 2A that an additional element was insignificant extra-solution activity, you should reevaluate that conclusion in Step 2B. If such reevaluation indicates that the element is unconventional or otherwise more than what is well-understood, routine, conventional activity in the field, this finding may indicate that an inventive concept is present and that the claim is thus eligible. Note, the other considerations besides insignificant extra-solution activity may not need to be reevaluated in Step 2B because the answer will be the same.