

## **New Form Paragraphs for Subject Matter Eligibility Rejections under the 2019 Revised Patent Subject Matter Eligibility Guidance**

The 2019 Revised Patent Subject Matter Eligibility Guidance (2019 PEG) published in the Federal Register ([84 FR 50](#)) on January 7, 2019 affects some of the eligibility-related form paragraphs in MPEP § 706.03(a). In particular, form paragraph 7.05.015 has been superseded and should no longer be used. Starting immediately, examiners are to follow the guidance below when making an eligibility rejection under Step 1 or Step 2B.

- For “Step 1” rejections based on a failure to claim an invention that falls within the statutory categories of invention (i.e., the claim is not to a process, machine, manufacture, or composition of matter and is thus rejected at Step 1 of the eligibility analysis), continue to use existing form paragraphs 7.04.01, 7.05 and 7.05.01.
- 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 TC Director approval is required.

No changes have been made to the form paragraphs for rejections based on a claim directed to or encompassing a human organism or to the procedures for handling subject matter that is limited by the Atomic Energy Act. Examiners should continue to follow the procedures in MPEP §§ 706.03(a)(II) and 706.03(b) for such claims.

Form paragraphs 7.04.01, 7.05, 7.05.01, 7.05.016, and 7.05.017 are reproduced below for convenience. New form paragraphs 7.05.016 and 7.05.017 will be made available in OACS and OC. The examiner notes accompanying form paragraphs 7.05 and 7.05.01 are being modified to provide instructions for the proper use of the new form paragraphs. A TC Director’s signature is required when form paragraph 7.05.017 is used. See the examiner notes accompanying form paragraph 7.05.017.

### **¶ 7.04.01 Statement of Statutory Basis, 35 U.S.C. 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

#### **Examiner Note:**

This form paragraph must precede the first use of 35 U.S.C. 101 in all first actions on the merits and final rejections.

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### **¶ 7.05 Rejection, 35 U.S.C. 101, -Heading Only- (Utility, Nonstatutory, Inoperative)**

Claim [1] rejected under 35 U.S.C. 101 because

#### **Examiner Note:**

1. This form paragraph must be preceded by form paragraph 7.04.01 in first actions and final rejections.
2. This form paragraph must be followed by a detailed explanation of the grounds of rejection using one or more of form paragraphs 7.05.01, 7.05.016, 7.05.02, 7.05.03, or another appropriate reason.
3. See MPEP §§ 2105 - 2107.03 for additional guidance.

### **¶ 7.05.01 Rejection, 35 U.S.C. 101, Nonstatutory (Not One of the Four Statutory Categories)**

the claimed invention is directed to nonstatutory subject matter. The claim(s) does/do not fall within at least one of the four categories of patent eligible subject matter because [1]

#### **Examiner Note:**

1. This form paragraph should be preceded by form paragraph 7.05.
2. In bracket 1, explain why the claimed invention is not patent eligible subject matter by identifying what the claim(s) is/are directed to and explain why it does not fall within at least one of the four categories of patent eligible subject matter recited in 35 U.S.C. 101 (process, machine, manufacture, or composition of matter), e.g., the claim(s) is/are directed to a signal *per se*, mere information in the form of data, a contract between two parties, or a human being (see MPEP § 2106, subsection I).
3. For a claim that is directed to a judicial exception and is nonstatutory, use form paragraph 7.05.016.

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### ¶ 7.05.016 Rejection, 35 U.S.C. 101, Nonstatutory (Directed to a Judicial Exception without an Inventive Concept/Significantly More)

the claimed invention is directed to [1] without significantly more. The claim(s) recite(s) [2]. This judicial exception is not integrated into a practical application because [3]. The claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because [4].

#### Examiner Note:

1. This form paragraph should be preceded by form paragraph 7.05. For claims that recite a limitation that does not fall within the enumerated groupings of abstract ideas, this form paragraph should be accompanied by form paragraph 7.05.017.
2. This form paragraph is for use with all product (machine, manufacture, and composition of matter) and process claims, and for all claims directed to a law of nature, natural phenomenon, or abstract idea.
3. In bracket 1, identify whether the claim(s) are directed to a law of nature, a natural phenomenon, or an abstract idea.
4. In bracket 2, identify the exception by referring to how it is recited in the claim and explain why it is considered an exception (e.g., identify the enumerated abstract idea grouping in Section I of the 2019 Revised Patent Subject Matter Eligibility Guidance published in the Federal Register (84 FR 50) on January 7, 2019. For example, "the Arrhenius equation, which is a law of nature and a mathematical concept which describes the relationship between temperature and reaction rate" or "the series of steps instructing how to hedge risk, which is a fundamental economic practice and thus grouped as a certain method of organizing human interactions." For a product of nature exception, refer to how it is recited in the claim and explain why its characteristics are not markedly different from the product's naturally occurring counterpart in its natural state. For example, "the naturally occurring DNA segment, which is not markedly different from its naturally occurring counterpart because it conveys the same genetic information." Provide additional explanation regarding the exception and how it has been identified when appropriate.
5. In bracket 3, explain why the combination of additional elements fails to integrate the judicial exception into a practical application. For example, if the claim is directed to an abstract idea with additional generic computer elements, explain that the generically recited computer elements do not add a meaningful limitation to the abstract idea because they amount to simply implementing the abstract idea on a computer; or, if the claim is directed to a method of using a naturally occurring correlation, explain that data gathering steps required to use the correlation do not add a meaningful limitation to the method as they are insignificant extra-solution activity. Similarly, if the claim recites a "naturally occurring DNA segment" with an additional element of a test tube, explain that merely placing the product of nature into a generic container such as a test tube does not add a meaningful limitation as it is merely a nominal or token extrasolution component of the claim, and is nothing more than an attempt to generally link the product of nature to a particular technological environment.

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6. In bracket 4, identify the additional elements and explain why, when considered separately and in combination, they do not add significantly more (also known as an “inventive concept”) to the exception. For example, if the additional limitations only store and retrieve information in memory, explain that these are well-understood, routine, conventional computer functions as recognized by the court decisions listed in MPEP § 2106.05(d).

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**¶ 7.05.017 Rejection, 35 U.S.C. 101, TC Director Approval for Non-Enumerated Abstract Idea**

The identified claim limitation(s) that recite(s) an abstract idea do/does not fall within the enumerated groupings of abstract ideas in Section I of the 2019 Revised Patent Subject Matter Eligibility Guidance published in the Federal Register ([84 FR 50](#)) on January 7, 2019. Nonetheless, the claim limitation(s) is/are being treated as reciting an abstract idea because [1].

This rejection has been approved by the Technology Center Director signing below.

[2]

**Examiner Note:**

1. This form paragraph should be preceded by form paragraph 7.05.016.
2. Approval from the TC Director is required to treat a tentative abstract idea (i.e., a claim limitation(s) that does not fall within the enumerated groupings of abstract ideas) as an abstract idea. This form paragraph should be used to demonstrate that this approval has been obtained.
3. In bracket 1, provide the justification for why the claim limitation(s) is/are being treated as an abstract idea. For example, provide an explanation of why the claim limitation is among the “basic tools of scientific and technological work.”
4. In bracket 2, insert the TC Director’s signature. Approval of the TC Director is required to treat a claim limitation that does not fall within the enumerated groupings of abstract ideas as reciting an abstract idea. See the 2019 Revised Patent Subject Matter Eligibility Guidance published in the Federal Register ([84 FR 50](#)) on January 7, 2019.