

**Chart of MPEP Sections Affected by the
2019 Revised Patent Subject Matter Eligibility Guidance (“2019 PEG”)**

| MPEP Section | Title of Section or Part | Portions That May Need Revision |
|---------------|--|---|
| 706.03(a)(II) | Rejections Under 35 U.S.C. 101 – Subject Matter Eligibility | <ul style="list-style-type: none"> Revise high level discussion of the 1st and 2nd steps of the <i>Alice/Mayo</i> test (Steps 2A and 2B in PTO guidance) and reference to Form Paragraphs |
| 2103 | Patent Examination Process | No Change |
| 2104 | Inventions Patentable - Requirements of 35 U.S.C. 101 | <ul style="list-style-type: none"> Revise high level discussion of the 2nd step of the <i>Alice/Mayo</i> test, i.e. Fourth Paragraph –include reference to integration in (b) |
| 2105 | Patent Eligible Subject Matter – Living Subject Matter | No Change |
| 2106 | Patent Subject Matter Eligibility | (see rows below for Parts I through III of this section) |
| | I. Two Criteria For Subject Matter Eligibility | <ul style="list-style-type: none"> Throughout all MPEP sections on eligibility, but particularly in this section, revise use of “application” so that it is not confused with “practical application” in prong two (e.g. Third para, last sentence, Fourth para, 1st sentence) Revise discussion that the second step is where “additional elements” are considered. (e.g. Fifth para, 2nd sentence – the machine-or-transformation test should be considered in both “significantly more” and “integration” determinations) |
| | II. Establish Broadest Reasonable Interpretation Of Claim As A Whole | <ul style="list-style-type: none"> Either add an example of how claim interpretation affects the “integration” determination in new Step 2A Prong Two, or revise the high level discussion of the 2nd step of the <i>Alice/Mayo</i> test to address both “significantly more” and “integration” determinations. |
| | III. Summary Of Analysis And Flowchart | <ul style="list-style-type: none"> May need to revise discussion to reflect that both Step 2A Prong Two and Step 2B include evaluation of “additional elements” Second para, 3rd sentence – remove statement that “inventive concept” is synonymous with a “practical application” |

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| 2106.03 | Eligibility Step 1: The Four Categories of Statutory Subject Matter | No Change |
| 2106.04 | Eligibility Step 2: Whether a Claim is Directed to a Judicial Exception | (see rows below for Parts I and II of this section; printing error in the title of this section will be fixed to reflect that this guidance pertains to “Step 2A” and not “Step 2”) |
| | I. Judicial Exceptions | <ul style="list-style-type: none"> • First para, first sentence – revise to use phrase “mathematical concepts” instead of “mathematical algorithms” to match the abstract idea grouping in the proposed guidance • Second para, first sentence – consider removing “mental processes” and “mathematical algorithms and formulas” as another name for judicial exceptions generally, because these phrases are now use to describe a grouping of abstract ideas • Second para, last sentence – delete as superseded by new approach to identifying abstract ideas in proposed guidance |
| | II. Eligibility Step 2A: Whether A Claim Is Directed To A Judicial Exception | <p>Section superseded by proposed guidance to the extent that it equates “recite” with “directed to”. Will be revised as described below.</p> <ul style="list-style-type: none"> • Add discussion of Revised Step 2A: (1) whether the claim recites a judicial exception; and (2) whether a recited judicial exception is integrated into a practical application. • Keep first para and second para discussion of “recited” • Add discussion of integration as second prong of 2A • Fifth para – remove any language equating “recited” and “directed to.” Can still keep as examples of “recited” • Last para – revise to reflect proposed guidance’s requirement that examiners “slot” abstract ideas into a single abstract idea grouping |

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| 2106.04(a) | Abstract Ideas | <ul style="list-style-type: none"> • Modify discussion of abstract ideas to use the terminology of the groupings of subject matter from the proposed guidance: Mathematical concepts, Certain methods of organizing human activity, and Mental processes • Remove discussion of comparing claimed concepts to concepts previously identified as abstract ideas by the courts (e.g. First & Third paras) • Revise last para to the extent it says improvement analysis is optional in Step 2A <p>(Also see rows below for Parts I and II of this section)</p> |
| | I. Claims That Are Directed To Improvements In Computer Functionality Or Other Technology Are Not Abstract | <p>Discussion of the 1st and 2nd steps of the <i>Alice/Mayo</i> test and flowchart eligibility pathways</p> <ul style="list-style-type: none"> • Incorporate into a larger “Integration” section <ul style="list-style-type: none"> ○ Include info from proposed guidance ○ Cite to appropriate sections of 2106.05 for considerations ○ Provide explanation of new consideration addressing <i>Vanda</i> and methods of treatment ○ Case Examples, if available |
| | II. More Information On Claims That Are, And Are Not, Directed To Abstract Ideas | <ul style="list-style-type: none"> • First para – may be removed • Remove second para referencing 2106.04(a)(2) and comparison to case law |
| 2106.04(a)(1) | Examples of Claims That Are Not Directed To Abstract Ideas | <ul style="list-style-type: none"> • Update with new eligible cases decided after August 2017 (although published in January 2018 the MPEP does not contain cases after August 2017 due in part to publication lag time), e.g., <i>Finjan</i> and <i>Core Wireless</i> • First para, second sentence – change language equating “directed to” with “recited” (add integration) <p>(Also see rows below for Parts I and II of this section)</p> |
| | I. If A Claim Is Based On Or Involves An Abstract Idea, But Does Not Recite It, Then The Claim Is Not Directed To An Abstract Idea | <ul style="list-style-type: none"> • Modify discussion of hypothetical examples to explain that the abstract idea exception includes the following groupings of subject matter in accordance with proposed guidance: Mathematical concepts, Certain methods of organizing human activity, and Mental processes • First para – remove language about similarity to previous abstract ideas |
| | II. If A Claim Recites An Abstract Idea, But The Claim As A Whole Is Directed To An Improvement Or Otherwise Clearly Does Not Seek To Tie Up The Abstract Idea, Then The Claim Is Not Directed To An Abstract Idea | <ul style="list-style-type: none"> • Change the focus of this section on cases or examples that integrate the abstract idea into a practical application |

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| 2106.04(a)(2) | Examples of Concepts The Courts Have Identified As Abstract Ideas | <ul style="list-style-type: none"> • Add section on treating claims that do not fall within the enumerated categories and the requirement for TC director approval to make a rejection. <p>(Also see rows below for Parts I through IV of this section)</p> |
| | I. "Fundamental Economic Practices" | <ul style="list-style-type: none"> • Remove section (certain methods of organizing human activity now includes fundamental economic practices) • Determine relevance to proposed guidance and add to section II on Certain Methods Of Organizing Human Activity <ul style="list-style-type: none"> ○ Section A is probably relevant to “commercial and legal interactions” ○ Section B is probably relevant to Fundamental Economic Concepts |
| | II. "Certain Methods Of Organizing Human Activity" | <ul style="list-style-type: none"> • Align with proposed guidance’s explanation of this grouping - Certain methods of organizing human activity – fundamental economic practices (including hedging, insurance, and mitigating risk); commercial and legal interactions (including agreements in the form of contracts, legal obligations, and business relations); managing relationships or interactions between people (including social activities, teaching, and following rules or instructions); and advertising, marketing, and sales activities or behaviors • Revise first para to match proposed guidance’s explanation • Revise the section breakdown to closer match proposed guidance’s definition <ul style="list-style-type: none"> ○ Section A is likely relevant to “managing relationships or interactions between people” ○ Section B is likely relevant to “advertising, marketing, and sales activities or behaviors” ○ Section C is likely relevant to “managing relationships or interactions between people” ○ Section D is likely not relevant and should be deleted |
| | III. "An Idea 'Of Itself'" | <ul style="list-style-type: none"> • Align with proposed guidance’s explanation of this grouping - Mental processes – concepts performed in the human mind (including an observation, evaluation, judgment, or opinion). • Combine sections A-C |
| | IV. "Mathematical Relationships/Formulas" | <ul style="list-style-type: none"> • Align with proposed guidance’s explanation of grouping - Mathematical concepts – mathematical relationships, mathematical formulas (equations), and mathematical calculations (including multiplying or adding numbers). • 1st para - Remove discussion of algorithms • Revise case cites for algorithms to use terminology consistent with proposed guidance |

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| 2106.04(b) | Laws of Nature, Natural Phenomena & Products of Nature | Add discussion from <i>Vanda</i> memorandum about how treatment steps can render a claim reciting a law of nature eligible in Step 2A (as not directed to a law of nature). |
| 2106.04(c) | The Markedly Different Characteristics Analysis | No Change |
| 2106.05 | Eligibility Step 2B: Whether a Claim Amounts to Significantly More | (See rows below for Parts I and II of this section) |
| | I. The Search For An Inventive Concept | <ul style="list-style-type: none"> • Throughout all MPEP sections on eligibility, but particularly in this section, remove use of “integration” in discussions of 2B • Add discussion about when the analysis of considerations in 2A can carry over to 2B and when they should be reevaluated |
| | II. Eligibility Step 2B: Whether The Additional Elements Contribute An "Inventive Concept" | No Change |
| 2106.05(a) through (c) and (e) through (h) | (see below) | <p>The following changes are applicable to each of the referenced sections. Please refer to rows below for additional revisions particular to each section.</p> <ul style="list-style-type: none"> • Revise to indicate that these considerations are evaluated in both Step 2A Prong Two (with regard to “integration”) and Step 2B (with regard to “significantly more”) • Revise language describing overlap between these considerations and the Well-Understood, Routine, Conventional Activity (WURC) consideration to indicate that such overlap is evaluated only in Step 2B (and not in Step 2A Prong Two) • Modify discussion of each case exemplar to discuss “integration” (or lack thereof) in addition to “significantly more” |

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| 2106.05(a) | Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field | <ul style="list-style-type: none"> • Third para – reconsider use of “focus” in view of new integration analysis • Fourth para – need to modify discussion to explain the difference between the use of conventionality when evaluating improvements and the WURC consideration. For instance, the Federal Circuit improvements cases (e.g., <i>Finjan</i>, <i>Enfish</i>, and <i>McRO</i>) and this MPEP section discuss how a technical solution must be unconventional as compared to the prior art in order to qualify as an improvement, but the proposed guidance forbids examiners from evaluating the WURC consideration in Step 2A. Revision must distinguish between (i) conventionality vs. the prior art in the context of the improvements consideration and (ii) what is well-understood, routine, conventional activity in the context of the WURC consideration, so that examiners continue to give full weight to the improvements consideration in revised Step 2A. • Sixth para – remove reference to “2B considerations” <p>(no changes to Parts I and II of this section)</p> |
| 2106.05(b) | Particular Machine | <ul style="list-style-type: none"> • Make language more generic as applying to both 2A and 2B (i.e. machine can integrate as well as provide significantly more) • 4th para – remove reference to “2B considerations” <p>(no changes to Parts I through III of this section)</p> |
| 2106.05(c) | Particular Transformation | <ul style="list-style-type: none"> • Make language more generic as applying to both 2A and 2B (i.e. transformation can integrate as well as provide significantly more) • 4th para – remove reference to “2B considerations” |
| 2106.05(d) | Well-Understood, Routine, Conventional Activity | <ul style="list-style-type: none"> • Add indication that this consideration is only evaluated in 2B while others are evaluated in both 2A and 2B <p>(See rows below for Parts I and II of this section)</p> |
| | I. Evaluating Whether The Additional Elements Are Well-Understood, Routine, Conventional Activity | <ul style="list-style-type: none"> • Remove last para (discusses not needing to support WURC finding) • Add section on WURC requiring a factual determination and how examiners can support this determination (from <i>Berkheimer</i> memorandum) |
| | II. Elements That The Courts Have Recognized As Well-Understood, Routine, Conventional Activity In Particular Fields | No Change |
| 2106.05(e) | Other Meaningful Limitations | <ul style="list-style-type: none"> • Make language more generic as applying to both 2A and 2B (i.e. other meaningful limitations can integrate as well as provide significantly more) |

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| 2106.05(f) | Mere Instructions to Apply an Exception | <ul style="list-style-type: none"> • Make language more generic as applying to both 2A and 2B (i.e. “apply it” is relevant to integration as well as significantly more) |
| 2106.05(g) | Insignificant Extra-Solution Activity | <ul style="list-style-type: none"> • Make language more generic as applying to both 2A and 2B (i.e. insignificant extra-solution activity is relevant to integration as well as significantly more) |
| 2106.05(h) | Field of Use and Technological Environment | <ul style="list-style-type: none"> • Make language more generic as applying to both 2A and 2B (i.e. field of use is relevant to integration as well as significantly more) • 4th para – modify discussion of <i>Flook</i> and integration for consistency with proposed guidance, e.g., a field of use limitation fails to integrate a judicial exception into the claim as a whole and thus cannot “practically apply” and exception in Step 2A Prong Two or add an inventive concept in Step 2B |
| 2106.06, including 2106.06(a) and (b) | Streamlined Analysis | No Change |
| 2106.07 | Formulating and Supporting Rejections For Lack Of Subject Matter Eligibility | <ul style="list-style-type: none"> • Revise 5th para to discuss (at high level) the additional requirement to explain why the judicial exception is not integrated into a practical application |
| 2106.07(a) | Formulating a Rejection For Lack of Subject Matter Eligibility | <ul style="list-style-type: none"> • Revise specific discussion of the 1st and 2nd steps of the <i>Alice/Mayo</i> test (See rows below for Parts I through III of this section) |
| | I. When Making A Rejection, Identify And Explain The Judicial Exception Recited In The Claim (Step 2A) | <ul style="list-style-type: none"> • Align with proposed guidance throughout, but particularly: <ul style="list-style-type: none"> ○ Add requirement to identify the grouping of subject matter: Mathematical concepts, Certain methods of organizing human activity, and Mental processes ○ Remove discussion of comparing claimed concepts to concepts previously identified as abstract ideas by the courts. ○ Modify examples ○ Add section detailing requirement to explain why the judicial exception is not integrated into a practical application |
| | II. When Making A Rejection, Explain Why The Additional Claim Elements Do Not Result In The Claim As A Whole Amounting To Significantly More Than The Judicial Exception (Step 2B) | <ul style="list-style-type: none"> • Revise 3rd and 4th paras to address <i>Berkheimer</i> memorandum and examiner’s burden to provide factual support |

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| | III. Evidentiary Requirements In Making A § 101 Rejection | <ul style="list-style-type: none"> • Remove and replace with new section for <i>Berkheimer</i> memorandum explaining examiner’s burden to support the rejection and how to do so |
| 2106.07(b) | Evaluating Applicant's Response | <ul style="list-style-type: none"> • Revise to address <i>Berkheimer</i> memorandum and how to evaluate challenges to Official Notice |
| 2106.07(c) | Clarifying the Record | No Change |
| Form-Paragraph - Book | Form Paragraphs 7.01 – 7.214 | <ul style="list-style-type: none"> • Add new form paragraphs 7.05.016, 7.05.017, and 7.05.018 - e.g., to reflect that additional elements are now reviewed in both steps. • Remove FP 7.05.015 |