

SUBJECT MATTER ELIGIBILITY WORKSHEET:

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.

For purposes of simplicity in this workshop, the questions below only refer to *abstract ideas* and will be used to walk through several of the [abstract ideas examples](#) published on the website. (A blank generic worksheet is available on the training website.) It is suggested that the worksheet be used with the [2014 Interim Eligibility Guidance Quick Reference Sheet](#), which includes an overview of the analysis, along with the flowchart and form paragraphs referenced herein.

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 8, claim 1

I. What did applicant invent?

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

Applicant invented:

A method for distributing media products over the Internet where the consumer receives a copyrighted media product at no cost in exchange for viewing an advertisement, and the advertiser pays for the copyrighted content.

This can be a brief description and should not merely reproduce the claim. The important take away here is that applicant's invention is focused on the distribution of content based on advertising.

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 steps, which is a process.

Continue with the SME analysis.

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.*

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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. Assistance in identifying such abstract ideas can be obtained by referring to the [case law chart](#) available on the website and the court case discussions in the 2014 Interim Eligibility Guidance. 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 claims describe the abstract idea of showing an advertisement before delivering free content, which in effect is a scheme that uses advertising as an exchange or currency. The process of receiving copyrighted media, selecting an ad, offering the media in exchange for watching the selected ad, displaying the ad, allowing the consumer access to the media, and receiving payment from the sponsor of the ad all describe this abstract idea.

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

The idea of showing an advertisement before delivering content is "an idea, having no particular concrete or tangible form." This is similar to the concepts involving human activity relating to commercial practices (e.g., hedging in *Bi/ski*) that have been found by the courts to be abstract ideas. The limitations that narrow the idea, such as receiving copyrighted media, selecting an ad, offering the media in exchange for watching the selected ad, displaying the ad, allowing the consumer access to the media, and receiving payment from the sponsor of the ad, do not make the concept less abstract.

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:

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

Accessing and updating an activity log, requiring a request from the consumer to view the advertising, restricting public access, and using the Internet as an information transmitting medium are additional limitations in the claimed method of distributing products.

As these steps are not intrinsic to the scheme for using advertisement as currency, they are treated as additional limitations

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.

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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:

The additional elements must show an "inventive concept." Many of these considerations overlap, and more than one can often be applied to describe an element. It is not important how the elements are characterized or how many considerations apply from this list. It is important to evaluate the significance of the additional elements relative to applicant's invention.

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

Requiring a consumer request and restricting public access are necessary and routine activities in using advertising as currency. In other words, it is routine that currency is tendered upon a request for a good.

The claimed logging activity is merely gathering data.

Using the Internet merely limits the idea to a particular technological environment and does not add a meaningful limitation in this case.

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

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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 None of the limitations, considered individually, provide eligibility, because consulting and updating an activity log represent routine, insignificant data-gathering steps, restricting public access represents only routine, insignificant pre-solution activity, and narrowing the idea to the Internet is an attempt to limit the use of the abstract idea to a particular technological environment.

The invention uses these steps to perform routine functions.

None of the limitations, considered as an ordered combination, provide eligibility, because the claims simply instruct the practitioner to implement the abstract idea with routine, conventional activity.

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 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:

The disclosure does not contain any such features. For example, the disclosed computer is only a general purpose computer operating on conventional steps. The disclosed invention addresses controlling a transaction of goods, rather than, for example, providing a solution necessarily rooted in computer technology to overcome a problem specifically arising in the realm of computer networks.

See Sample Rejection that follows:

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Sample Rejection:

Use Form Paragraphs 7.05 and 7.05.015

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/are directed to the abstract idea of showing an advertisement before delivering free content. This is a concept involving human activity relating to commercial practices. The process of receiving copyrighted media, selecting an ad, offering the media in exchange for watching the selected ad, displaying the ad, allowing the consumer access to the media, and receiving payment from the sponsor of the ad all describe the abstract idea.

The claim(s) does/do not include additional elements that are sufficient to amount to significantly more than the judicial exception because the additional limitations of consulting and updating an activity log represent insignificant data-gathering steps, restricting public access represents only insignificant pre-solution activity, and narrowing the idea to the Internet is an attempt to limit the use of the abstract idea to a particular technological environment. None of the limitations, considered as an ordered combination, provide eligibility, because taken as a whole, the claims simply instruct the practitioner to implement the abstract idea with routine, conventional activity.