

INTERIM EXAMINATION INSTRUCTIONS FOR EVALUATING SUBJECT MATTER ELIGIBILITY UNDER 35 U.S.C. §101



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August 2009
United States Patent and Trademark Office



IMPLEMENTATION PLAN

- OVERVIEW OF INTERIM EXAMINATION INSTRUCTIONS FOR SUBJECT MATTER ELIGIBILITY
- INSTRUCTIONS WILL BE POSTED ON USPTO INTERNET WEBSITE
- TC SPECIFIC TRAINING TO FOLLOW
- QUESTIONS SHOULD BE DIRECTED TO SPEs, THEN TO TC 101 REPRESENTATIVES



OVERVIEW

TRAINING OVERVIEW:

- THE TWO-STEP 101 ANALYSIS
- PRODUCT FLOWCHART AND EXAMPLES
- PROCESS FLOWCHART AND EXAMPLES



STEP 1

- Is the claim directed to one of the four patent-eligible subject matter categories?
 - Process, Machine, Manufacture, Composition of Matter
- If not in one of the four categories, the claim is not eligible.
 - Examples of claims that are not eligible:
 - Transitory signals *per se*, humans *per se*, a company *per se*, or a set of instructions *per se* (such as a game or software *per se*)



STEP 2

- A claim satisfying Step 1 is subject-matter eligible under 101 unless it wholly embraces a judicially recognized exception.
 - Does the claim wholly embrace a judicially recognized exception?
 - Abstract Idea
 - Law of Nature
 - Natural Phenomena
 - The exceptions also include, for example:
 - Mental Processes
 - Mathematical Algorithms
 - Scientific Principles
- **If the claim is directed to a judicial exception itself, it is not eligible.**
- **A particular practical application of a judicial exception is eligible.**



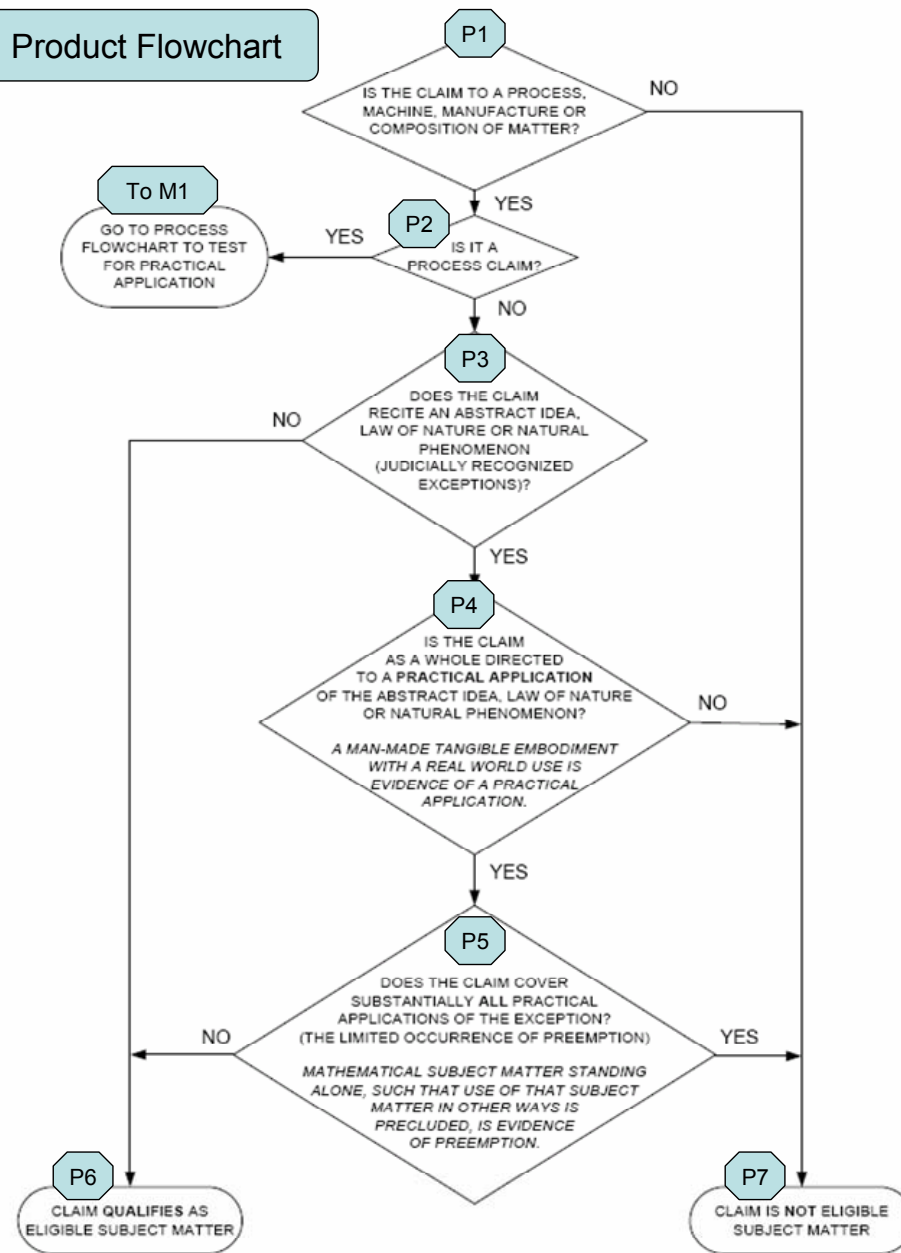
PRODUCT CLAIM ANALYSIS

- Begin with the broadest reasonable interpretation (BRI) of the claim in view of the specification consistent with the interpretation those skilled in the art would reach. MPEP 2111
- Product Focus:
 - Does the claim meet definitions of machine, manufacture or composition of matter?
 - Is there a judicial exception recited in the claim?



SUBJECT MATTER ELIGIBILITY TEST

Product Flowchart





PRODUCT EXAMPLE: CLAIM 1

No Judicial Exception

Claim 1. A hand tool, comprising:

- a handle; and
 - a head coupled to the handle having a striking surface and a claw.
- Is the claim directed to a machine or manufacture? (P1)
 - YES - it is an article produced from prepared materials.
 - Does it recite a judicial exception? (P3)
 - NO.
- The claim is **eligible** (P6).



PRODUCT EXAMPLE: CLAIM 2

Judicial Exception Claimed

Claim 2. A machine for evaluating search results, comprising:

- a microprocessor coupled to a memory,
 - wherein the microprocessor is programmed to evaluate search results by:
 - sorting the results into groups based on a first characteristic;
 - ranking the results based on a second characteristic using a mathematical formula [f]; and
 - comparing the ranked results to a predetermined list of desired results to evaluate the success of the search.
-
- Is the claim directed to a machine? (P1)
 - YES - it is a concrete thing, consisting of parts.
 - Does it recite a judicial exception? (P3)
 - YES - the ranking step includes a mathematical algorithm.
 - Is it directed to a practical application? (P4)
 - YES - evidenced by the tangible embodiment of the microprocessor for evaluating search results, which is a real world use.
 - Is the claim directed to substantially all practical applications of the mathematical algorithm? (P5)
 - NO – the algorithm is limited to use in evaluating search results in the particular claimed machine that is programmed to perform certain steps. As there are other ways to use the algorithm, for example, with different programmed steps, not every use is covered by the claim.
- The claim is **eligible** (P6).



PRODUCT EXAMPLE: CLAIM 3

Computer-Readable Medium

Claim 3. A non-transitory computer-readable storage medium with an executable program stored thereon, wherein the program instructs a microprocessor to perform the following steps:

- sorting results of a search into groups based on a first characteristic;
- ranking the results based on a second characteristic using a mathematical formula [f]; and
- comparing the ranked results to a predetermined list of desired results to evaluate the success of the search.

- Is the claim directed to a manufacture? (P1)
 - YES - it is an article (a non-transitory storage medium) produced from raw or prepared materials.
- Does it recite a judicial exception? (P3)
 - YES - it recites a mathematical algorithm.
- Is it directed to a practical application? (P4)
 - YES - evidenced by the tangible embodiment of the computer-readable storage medium.
- Is the claim directed to substantially all practical applications of the mathematical algorithm? (P5)
 - NO – there are other substantial uses of the algorithm than using it in evaluating search results in a program stored on the particular claimed manufacture. As there are other ways to use the algorithm, for example, with different programmed steps, not every use is covered by the claim.
- The claim is **eligible** (P6).



COMPUTER-READABLE MEDIA

Additional Information

- The functional/non-functional distinction is not an inquiry under 101. The 101 inquiry is whether a claim directed to one of the four statutory categories is wholly directed to a judicial exception.
- A tangible medium including a computer program should be evaluated to determine if there is a functional relationship between the computer program and the medium for purposes of distinguishing over prior art, not for subject matter eligibility.



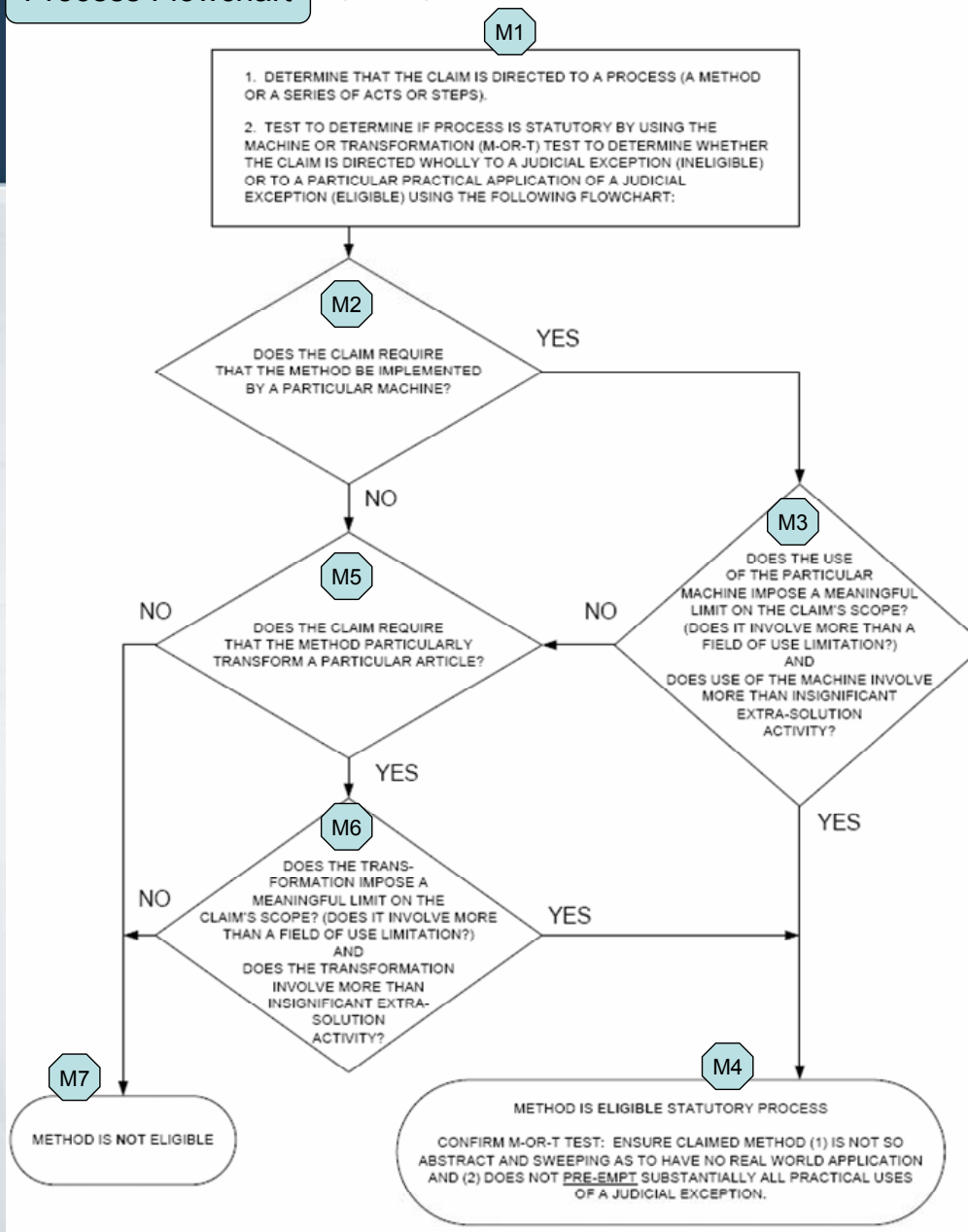
PROCESS CLAIM ANALYSIS

- Begin with the broadest reasonable interpretation (BRI) of the claim in view of the specification consistent with the interpretation those skilled in the art would reach. MPEP 2111.
- Process Focus:
 - Does the claim meet the machine or transformation (M-or-T) test? The claimed process must:
 - (1) be tied to a particular machine or apparatus, or
 - (2) particularly transform a particular article to a different state or thing.
 - Two corollaries: the particular machine or transformation must involve:
 - Meaningful limits
 - More than insignificant “extra-solution” activity



Process Flowchart

SUBJECT MATTER ELIGIBILITY TEST (M-OR-T) FOR PROCESS CLAIMS





PROCESS EXAMPLE: CLAIM 4

No Machine or Transformation Claimed

- Claim 4. A method of evaluating search results, comprising:
- sorting the results into groups based on a first characteristic;
 - ranking the results based on a second characteristic; and
 - comparing the ranked results to a predetermined list of desired results to evaluate the success of the search.

Under the BRI, each step could be done by hand or on a programmed computer.

- Is there a particular machine? (M2)
 - NO - there is no machine explicitly recited or inherently required
 - Is there a transformation of an article? (M5) - NO
- Claim is **not eligible** (M7).



PROCESS EXAMPLE: CLAIM 5

Claim Tied to a Particular Machine

Claim 5. A method of evaluating search results, comprising:

- sorting the results into groups based on a first characteristic;
- ranking the results based on a second characteristic; and
- comparing, using a microprocessor, the ranked results to a predetermined list of desired results to evaluate the success of the search.

Under the BRI, the microprocessor must be programmed in a particular manner to perform the claimed comparing step.

- Is there a particular machine? (M2)
 - YES - under the BRI, the step of comparing requires a particularly programmed microprocessor.
- Does the machine impose a meaningful limit and is it more than insignificant extra-solution activity? (M3)
 - YES - the step of comparing is central to the method invented by applicant – it is not a mere field-of-use or insignificant extra-solution activity.
- The claim is **eligible** (M4).



PROCESS EXAMPLE: CLAIM 6

Extra-Solution Activity

Claim 6. A method of evaluating search results, comprising:

- obtaining the search results by electronically downloading the results from a database;
- sorting the results into groups based on a first characteristic;
- ranking the results based on a second characteristic; and
- comparing the ranked results to a predetermined list of desired results to evaluate the success of the search.

- Is there a particular machine? (M2)
 - YES - the step of obtaining the search results inherently requires a programmed microprocessor to download data from a database; under the BRI no other step requires a machine.
- Does the machine required for downloading impose a meaningful limit and involve more than insignificant extra-solution activity? (M3)
 - NO - the downloading step is not central to the purpose of the method invented by the applicant and is insignificant extra-solution activity.
- Is there transformation of an article? (M5)
 - NO
- The claim is **not eligible** (M7).



SUMMARY

- The Instructions supersede previous guidance on subject matter eligibility that conflicts with the Instructions, including MPEP 2106(IV), 2106.01 and 2106.02, as of 8/24/09.
 - To determine subject matter eligibility, follow the “Interim Examination Instructions for Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101”.
- Product claims are evaluated to determine if the claim is wholly directed to a judicial exception.
 - Functional/nonfunctional descriptive material (FDM/NFDM) is evaluated for patentable distinction over the prior art. See MPEP 2112.01(III).
- All process (method) claims are evaluated with the M-or-T test.



QUESTIONS

- TC SPECIFIC TRAINING WITH ADDITIONAL EXAMPLES WILL FOLLOW
- QUESTIONS SHOULD BE DIRECTED TO YOUR SPE, THEN TO THE FOLLOWING EMAIL HELP PANELS:
 - TC 1600: 101 Help-TC1600
 - TC 1700: 101 Help-TC1700
 - TC 3600: 101 Help-TC3600
 - TC 3700: 101 Help-TC3700
 - TC 2100: 101 Help-TC2100
 - TC 2400: 101 Help-TC 2400
 - TC 2600: 101 Help-TC2600
 - TC 2800: 101 Help-TC2800



THANK YOU

- The time code is ATRAIN-0000-090148.