
USPTO Issues Revised Patent Subject Matter Eligibility Guidance and Guidance for Examining Computer-Implemented Functional Claims under Section 112

JANUARY 10, 2019

Summary: The USPTO has issued updated guidance for examiners and administrative patent judges (APJs) relating to subject matter eligibility under 35 U.S.C. 101 and examining computer-implemented functional claim limitations under 35 U.S.C. 112. The updated guidance suggests the USPTO will be more likely to find claims patent-eligible but will also more strictly scrutinize the specifications of computer implemented inventions for disclosure of how the claimed functions are performed.

The US Patent and Trademark Office (USPTO) has issued updated guidance for examiners and administrative patent judges (APJs) relating to subject matter eligibility under 35 U.S.C. 101 and examining computer-implemented functional claim limitations under 35 U.S.C. 112. This Alert summarizes this new guidance and how it may be relevant to practitioners. The updated guidance is available [here](#) and [here](#).

Subject Matter Eligibility Guidance: The USPTO states that its guidance for evaluating subject matter eligibility stems from the USPTO's view that the US Supreme Court's framework under *Alice/Mayo* has created uncertainty for examiners and stakeholders. *Alice/Mayo* step 1 (also referred to as USPTO step 2A) analyzes whether a claim is "directed to" matter excluded from patent eligibility based on a "judicial exception," namely a law of nature, natural phenomenon, or abstract idea. If not, the claim is patent-eligible and no further analysis is necessary. If so, step 2 (also referred to as USPTO step 2B) analyzes whether the claim involves an "inventive concept." If it does, the claim is patent-eligible. The guidance lays out a revised procedure for step 1 and maintains the existing procedure for step 2.

Under the revised step 1, examiners and APJs are instructed to determine whether the claim "recites" a judicial exception (law of nature, natural phenomenon, or abstract idea). With regard to the abstract idea exception, the guidance further specifies that the claim must recite mathematical concepts, methods of organizing human activity, or mental processes to qualify as an abstract idea, except in "rare circumstances." If no judicial exception is recited, no further analysis is necessary and the claim is patent-eligible.

If a judicial exception is “recited,” the examiner or APJ next determines whether the claim “integrate[s] the exception into a practical application.” The guidance explains the “integrates” prong as follows: “A claim that integrates a judicial exception into a practical application will 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 judicial exception.” The guidance notes that “a claim that includes conventional elements may still integrate an exception into a practical application.” If the claim integrates the exception, the claim is patent-eligible, and the analysis ends. If not, the analysis proceeds under the existing procedure for step 2.

The updated guidance suggests the USPTO will be more likely to find claims patent-eligible, because the guidance generally limits the abstract ideas exception to enumerated categories and because the guidance allows applicants to demonstrate patent eligibility by showing the claim “integrate[s] the exception into a practical application,” even using conventional elements. In doing so, the revised procedures also provide guidelines for applicants to avoid patent eligibility rejections by not reciting a judicial exception or by integrating any such exception into a practical application.

Guidance on Computer-Implemented Claims: The USPTO indicates it is issuing guidance on examining computer-implemented functional claim limitations to address “problems with broad functional claiming without functional support in the specification.”

The section 112 guidance first reviews the procedures for determining whether a claim should be interpreted as a means-plus-function claim under section 112(f). The examiner is instructed to apply a three-prong analysis to evaluate 1) whether the claim recites a “means” or a similar generic placeholder term, 2) whether the term is modified by functional language, and 3) whether the term is not modified by sufficient structure performing the function.

The guidance also reviews the requirements for definiteness under section 112(b) for computer-implemented means-plus-function claims interpreted under section 112(f). The revised guidance clarifies that the corresponding specification for a computer-implemented claim limitation under section 112(f) “must disclose an algorithm for performing the claimed specific computer function, or else the claim is indefinite.” The algorithm must be sufficient to perform “the entire claimed function(s).”

The guidance suggests that the algorithm can be expressed in any understandable terms such as “a mathematical formula, prose or flow chart or in any other manner that provides sufficient structure.” It also notes that “the corresponding structure for performing the specific computer function is not simply a general purpose computer by itself but a special purpose computer as programmed to perform the disclosed algorithm.”

Finally, the guidance reviews the enablement and written description requirements under section 112(a), with an emphasis on describing the relevant algorithm: “a specification must describe the claimed invention in sufficient details (e.g., by disclosure of an algorithm).”

The USPTO’s guidance suggests it will more strictly scrutinize the specifications of computer-implemented inventions for disclosure of how the claimed functions are performed. It will be

important for applicants to describe the relevant algorithms in detail and to ensure such descriptions cover “the entire claimed function(s).” This will be important to satisfy the corresponding structure and definiteness requirements under sections 112(b) and 112(f) and to satisfy the enablement and written description requirements under section 112(a).

For those working on computer-implemented inventions, the USPTO has provided aids to obtain patentability through claim drafting and a sufficiently detailed disclosure that follows the USPTO’s guidance.

Authors



**David L.
Cavanaugh**

PARTNER

Chair, Post-Grant Proceedings
Group

✉ david.cavanaugh@wilmerhale.com

☎ +1 202 663 6025