
US Patent Office Issues Updated Guidance Regarding Patentable Subject Matter

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On July 30, 2015, the United States Patent and Trademark Office (USPTO) issued [updated guidance](#) on subject-matter eligibility under 35 U.S.C. 101, intended to “assist examiners in applying the 2014 Interim Patent Eligibility Guidance during the patent examination process.”¹ Below, we provide a brief summary of the updated guidance, which includes a “July 2015 Update,” three appendices and a Quick Reference sheet.

The USPTO is currently seeking comments from the public relating to the new guidance.

July 2015 Update: Subject Matter Eligibility

The July 2015 Update includes a description of six “major themes” the USPTO developed based on public comments received in response to its 2014 Interim Patent Eligibility Guidance (IEG):

1. In response to “requests for additional examples, particularly for claims directed to abstract ideas and laws of nature,”² the USPTO has provided additional examples in Appendix 1 to be used in conjunction with the examples from the 2014 IEG. These additional examples are intended to “assist examiners and the public in applying the principles of the 2014 IEG.”
2. For claims directed to nature-based products, the 2014 IEG states that Step 2A of the *Alice* test involves determining whether the claimed subject matter and its naturally-occurring counterparts have “markedly different characteristics” (MDC).³ Some commenters suggested moving the MDC analysis to Step 2B. In response, the USPTO explains in the July 2015 Update that it has decided to retain the MDC analysis in Step 2A because it allows claims to qualify as eligible earlier in the analysis, provides an additional pathway to eligibility for claims directed to ‘product of nature’ exceptions, and ensures “that all claims are consistently analyzed for eligibility regardless of statutory category or the type of exception recited.”
3. In response to requests for “further information regarding how examiners identify abstract ideas,” the updated guidance points out that “the 2014 IEG instructs examiners to refer to the body of case law precedent in order to identify abstract ideas by way of comparison to concepts already found to be abstract.” The July 2015 Update also provides further

clarification regarding certain categories of abstract ideas, including “Fundamental economic practices,” “Certain Methods of Organizing Human Activity,” “An Idea ‘Of Itself,’” and “Mathematical relationships/formulas.”

4. Following a “discussion of the *prima facie* case and the role of evidence with respect to eligibility rejections,” the July 2015 Update explains that to establish a *prima facie* case for lack of subject-matter eligibility, an Examiner must “clearly articulat[e] the reason(s) why the claimed invention is not eligible.” An Examiner’s rationale for finding a lack of subject matter eligibility can be based on “case law precedent, on applicant’s own disclosure, or on evidence.”
5. Regarding the “application of the 2014 IEG in the corps,” the USPTO explains that Examiners have been given guidance materials and additional training (in particular, the three appendices provided with the July 2015 Update are intended to assist Examiners during examination).
6. Regarding the USPTO’s “streamlined analysis” for making quick determinations regarding patent-eligibility, the July 2015 Update notes that the streamlined analysis procedure “provides an important benefit to applicants and examiners by permitting claims whose eligibility is self-evident to qualify as eligible without performing a full eligibility analysis.” In particular, the July 2015 Update states that the streamlined analysis procedure described in the 2014 IEG “is consistent with the case law precedent” regarding the question of preemption raised by the Supreme Court in *Alice*.

July 2015 Update Appendix 1: Examples

Appendix 1 includes additional examples of patent-eligible and patent-ineligible claims, to be used in conjunction with the examples provided in the 2014 IEG. These examples include claims directed to transmitting stock quote data, graphical user interfaces for meal planning and for relocating obscured textual information, methods for updating alarm limits using mathematical formulae, methods used in rubber manufacturing, internal combustion engines, and methods for loading a BIOS into a local computer system.

July 2015 Update Appendix 2: Index of Eligibility Examples

Appendix 2 includes a table of the examples included in the 2014 IEG and the July 2015 Update, explaining how the steps of the patent-eligibility test set forth in *Alice* were applied in each of the example cases.

July 2015 Update Appendix 3: Subject Matter Eligibility Court Decisions

Appendix 3 provides a list of representative cases decided by the Supreme Court and the Court of Appeals for the Federal Circuit that deal with subject-matter eligibility. For each of these cases, the Appendix provides background information regarding the subject matter of the patents at issue, as well as a summary of the conclusions reached by the relevant court.

July 2015 Update: Interim Eligibility Guidance Quick Reference Sheet

The Quick Reference Sheet provides a brief summary of the July 2015 Update and the appendices,

along with an infographic that provides further guidance on identifying abstract ideas.

¹ 80 Fed. Reg. 45429 (July 30, 2015).

² July 2015 Update: Subject Matter Eligibility.

³ See *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014). For a more detailed description of the *Alice* test, see [WilmerHale Client Update, “USPTO Issues Updated Guidance on Patent Subject Matter Eligibility”](#) (December 17, 2014).

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