DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
[Docket No. PTO-P–2018–0053]

2019 Revised Patent Subject Matter Eligibility Guidance


ACTION: Examination Guidance; Request for comments.

SUMMARY: The United States Patent and Trademark Office (USPTO) has prepared revised guidance (2019 Revised Patent Subject Matter Eligibility Guidance) for use by USPTO personnel in evaluating subject matter eligibility. The 2019 Revised Patent Subject Matter Eligibility Guidance revises the procedures for determining whether a patent claim or patent application claim is directed to a judicial exception (laws of nature, natural phenomena, and abstract ideas) under Step 2A of the USPTO’s Subject Matter Eligibility Guidance in two ways. First, the 2019 Revised Patent Subject Matter Eligibility Guidance explains that abstract ideas can be grouped as, e.g., mathematical concepts, certain methods of organizing human activity, and mental processes. Second, this guidance explains that a patent claim or patent application claim that recites a judicial exception is not “directed to” the judicial exception if the judicial exception is integrated into a practical application of the judicial exception. A claim that recites a judicial exception, but is not integrated into a practical application, is directed to the judicial exception under Step 2A and must then be evaluated under Step 2B (inventive concept) to determine the subject matter eligibility of the claim. The USPTO is seeking public comment on its subject matter eligibility guidance, and particularly the 2019 Revised Patent Subject Matter Eligibility Guidance.

Applicable Date: The 2019 Revised Patent Subject Matter Eligibility Guidance is effective on January 7, 2019. The 2019 Revised Patent Subject Matter Eligibility Guidance applies to all applications, and to all patents resulting from applications, filed before, on, or after January 7, 2019.

Comment Deadline Date: Written comments must be received on or before March 8, 2019.

FOR FURTHER INFORMATION CONTACT: June E. Cohan, Senior Legal Advisor, at 571–272–7744 or Carolyn Kosowski, Senior Legal Advisor, at 571–272–7688, both with the Office of Patent Legal Administration.

SUPPLEMENTARY INFORMATION: Patent subject matter eligibility under 35 U.S.C. 101 has been the subject of much attention over the past decade. Recently, much of that attention has focused on how to apply the U.S. Supreme Court’s framework for evaluating eligibility (often called the Alice/Mayo test). 1 Properly applying the Alice/Mayo test in a consistent manner has proven to be difficult, and has caused uncertainty in this area of the law. Among other things, it has become difficult in some cases for inventors, businesses, and other patent stakeholders to reliably and predictably determine what subject matter is patent-eligible. The legal uncertainty surrounding Section 101 poses unique challenges for the USPTO, which must ensure that its more than 8500 patent examiners and administrative patent judges apply the Alice/Mayo test in a manner that produces reasonably consistent and predictable results across applications, art units and technology fields.

Since the Alice/Mayo test was announced and began to be extensively applied, the courts and the USPTO have tried to consistently distinguish between patent-eligible subject matter and subject matter falling within a judicial exception. Even so, patent stakeholders have expressed a need for more clarity and predictability in its application. In particular, stakeholders have expressed concern with the proper scope and application of the “abstract idea” exception. Some courts share these concerns, for example as demonstrated by several recent concurrences and dissents in the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) calling for changes in the application of Section 101 jurisprudence. 2 Many stakeholders, judges, inventors, and practitioners across the spectrum have argued that something needs to be done to increase clarity and consistency in how Section 101 is currently applied.

To address these and other concerns, the USPTO is revising its examination procedure with respect to the first step of the Alice/Mayo test 3 (Step 2A of the USPTO’s Subject Matter Eligibility Guidance as incorporated into the Manual of Patent Examining Procedure (“MPEP”) 2106) by: (1) Providing groupings of subject matter that is considered an abstract idea; and (2) clarifying that a claim is not “directed to” a judicial exception if the judicial exception is integrated into a practical application of that exception.


2 The first step of the Alice/Mayo test is to determine whether the claims are “directed to” a judicial exception. Alice, 573 U.S. at 217 (citing Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66 (2012)).

3 The first step of the Alice/Mayo test is to determine whether the claims are “directed to” a judicial exception. Alice, 573 U.S. at 217 (citing Mayo, 566 U.S. at 77).

Section I of this 2019 Revised Patent Subject Matter Eligibility Guidance explains that the judicial exceptions are for subject matter that has been identified as the “basic tools of scientific and technological work,” which includes “abstract ideas” such as mathematical concepts, certain methods of organizing human activity, and mental processes; as well as laws of nature and natural phenomena. Only when a claim recites a judicial exception does the claim require further analysis in order to determine its eligibility. The groupings of abstract ideas contained in this guidance enable USPTO personnel to more readily determine whether a claim recites subject matter that is an abstract idea.

Section II explains that the USPTO has set forth a revised procedure, rooted in Supreme Court caselaw, to determine whether a claim is “directed to” a judicial exception under the first step of the Alice/Mayo test (USPTO Step 2A). Section III explains the revised procedure that will be applied by the USPTO. The procedure focuses on two aspects 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. Only when a claim recites a judicial exception and fails to integrate the exception into a practical application, is the claim “directed to” a judicial exception, thereby triggering the need for further analysis pursuant to the second step of the Alice/Mayo test (USPTO Step 2B). Finally, if further analysis at Step 2B is needed (for example to determine whether the claim merely recites well-understood, routine, conventional activity), this 2019 Revised Patent Subject Matter Eligibility Guidance explains that the examiner or administrative patent judge will proceed in accordance with existing USPTO guidance as modified in April 2018.

The USPTO is seeking public comment on its subject matter eligibility guidance, and particularly the 2019 Revised Patent Subject Matter Eligibility Guidance. The USPTO is determined to continue its mission to provide predictable and reliable patent rights in accordance with this rapidly evolving area of the law. The USPTO’s ultimate goal is to draw distinctions between claims to principles in the abstract and claims that integrate those principles into a practical application. To that end, the USPTO may issue further guidance, or modify the current guidance, in the future based on its review of the comments received, further experience of the USPTO and its stakeholders, and additional judicial actions.

Implementation of examination guidance on eligibility is an iterative process and may continue with periodic supplements. The USPTO invites the public to submit suggestions on eligibility-related topics to address in future guidance supplements as part of their comments on the USPTO’s subject matter eligibility guidance. Impact on Examination Procedure and Prior Examination Guidance: This 2019 Revised Patent Subject Matter Eligibility Guidance supersedes MPEP 2106.04(I) (Eligibility Step 2A: Whether a Claim Is Directed to a Judicial Exception) to equate claims “reciting” a judicial exception with claims “directed to” a judicial exception, along with any other portion of the MPEP that conflicts with this guidance. A chart identifying portions of the MPEP that are affected by this guidance will be available for viewing via the USPTO’s internet website (http://www.uspto.gov). This 2019 Revised Patent Subject Matter Eligibility Guidance also supersedes all versions of the USPTO’s “Eligibility Quick Reference Guide to Identifying Abstract Ideas” (first issued in July 2015 and updated most recently in July 2018). Eligibility-related guidance issued prior to the Ninth Edition, R-08.2017, of the MPEP (published Jan. 2018) should not be relied upon. However, any claim considered patent eligible under prior guidance should be considered patent eligible under this guidance.

This guidance does not constitute substantive rulemaking and does not have the force and effect of law. The guidance sets out agency policy with respect to the USPTO’s interpretation of the subject matter eligibility requirements of 35 U.S.C. 101 in view of decisions by the Supreme Court and the Federal Circuit. The guidance was developed as a tool for internal USPTO management and does not create any right or benefit, substantive or procedural, enforceable by any party against the USPTO. Rejections will continue to be based upon the substantive law, and it is those rejections that are appealed to the Patent Trial and Appeal Board (PTAB) and the courts. All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance. Failure of USPTO personnel to follow the guidance, however, is not, in itself, a proper basis for either an appeal or a petition.

I. Groupings of Abstract Ideas

The Supreme Court has held that the patent eligibility statute, Section 101, contains an implicit exception for “[l]aws of nature, natural phenomena, and abstract ideas,” which are “the basic tools of scientific and technological work.” Yet, the Court has explained that “[a]t some level, all inventions embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas,” and has cautioned “to tread carefully in construing this exclusionary principle lest it swallow all of patent law.”

Since the Alice case, courts have been “compare[ing] claims at issue to those claims already found to be directed to an abstract idea in previous cases.” Likewise, the USPTO has issued guidance to the patent examining corps about Federal Circuit decisions applying the Alice/Mayo test, for instance describing the subject matter claimed in the patent in suit and noting whether or not certain subject matter has been identified as an abstract idea.

---

5 Mayo, 566 U.S. at 71 (“Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work” (quoting Gottschalk v. Benson, 409 U.S. 63, 67 (1972))).

---

7 See Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1334 (Fed. Cir. 2016); see also Amdocs (Israel) Ltd. v. Openet Telecom, Inc., 841 F.3d 1288, 1294 (Fed. Cir. 2016) (“[T]he decisional mechanism courts now apply [to identify an abstract idea] is to examine earlier cases in which a similar or parallel descriptive nature can be seen—what prior cases were about, and which way they were decided.”).

51
While that approach was effective soon after Alice was decided, it has since become impractical. The Federal Circuit has now issued numerous decisions identifying subject matter as abstract or non-abstract in the context of specific cases, and that number is continuously growing. In addition, similar subject matter has been described both as abstract and not abstract in different cases. The growing body of precedent has become increasingly more difficult for examiners to apply in a predictable manner, and concerns have been raised that different examiners within and between technology centers may reach inconsistent results.

The USPTO, therefore, aims to clarify the analysis. In accordance with judicial precedent and in an effort to improve consistency and predictability, the 2019 Revised Patent Subject Matter Eligibility Guidance extracts and synthesizes key concepts identified by the courts as abstract ideas to explain that the abstract idea exception includes the following groupings of subject matter, when recited as such in a claim limitation(s) (that is, when recited on their own or per se):

(a) Mathematical concepts—mathematical relationships, mathematical formulas or equations, mathematical calculations; 12
(b) Certain methods of organizing human activity—fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions); 13 and
(c) Mental processes—concepts performed in the human mind 14 (including an observation, evaluation, judgment, opinion). 15

12 Bliski v. Kappos, 561 U.S. 593, 611 (2010) ("[T]he concept of hedging would wholly preclude the mathematical formula in practical effect would be a patent on the algorithm itself"); Mackay Radio & Telegraph Co. v. Radio Corp. of Am., 306 U.S. 86, 94 (1939) ([A] scientific truth, or the mathematical expression of it, is not patentable invention"); SAP America, Inc. v. InvestEC, 116 F.3d 1333, 1364 (Fed. Cir. 2019) (holding that claims to a "series of mathematical calculations based on selected information" are directed to abstract ideas); Digital Tech Image Techs., LLC v. Elecs. for Imaging, Inc., 758 F.3d 1344, 1350 (Fed. Cir. 2014) (holding that claims to a "process of organizing information through mathematical correlations" are directed to an abstract idea); Bancorp Servs., LLC v. Sun Life AssurCo of Can. (U.S.), 687 F.3d 1266, 1280 (Fed. Cir. 2012) (identifying the concept of "managing a stable value protected life insurance policy by performing calculations and manipulating the results" as an abstract idea).

13 E.g., compare TLI Commc’ns, 823 F.3d at 611, with Enfish, 822 F.3d at 1335, and Visual Memory LLC v. NVIDIA Corp., 867 F.3d at 1253, 1258 (Fed. Cir. 2017). While computer operations such as "output of data analysis. . .can be abstract," Credit Acceptance Corp. v. Westlake Servs., 859 F.3d 1044, 1048 (Fed. Cir. 2017), "software-based innovations can also make 'non-abstract improvements to computer technology' and be deemed patent-eligible subject matter at step 1 (of the Mayo/ Alice test)," Finjan, 879 F.3d at 1304 (quoting Enfish, 822 F.3d at 1335). Indeed, the Federal Circuit has held that "[i]n improvements in computer-related technology and claims directed to software are not inherently abstract." Enfish, 822 F.3d at 1335; see also Visual Memory, 867 F.3d at 1258. These developments in the caselaw can create complications for the patent-examination process. For example, claims in one application could be deemed to be abstract, whereas slightly different claims directed to the same or similar subject matter could be deemed to not reflect a patent-eligible "improvement." Alternatively, claims in one application could be found to be abstract, whereas claims to the same or similar subject matter in another application, containing additional or alternative embodiments in the specification, could be deemed eligible as not directed to an abstract idea. In other words, the finding that the subject matter claimed in a prior patent claim may not have been patent-eligible, and therefore patent ineligible.

14 Ultraincercial, Inc. v. Hula, LLC, 772 F.3d 709, 715 (Fed. Cir. 2014) (holding that claim describing[ing] only the abstract idea of showing an advertisement before delivering free content is patent ineligible); In re Ferguson, 558 F.3d 1359, 1364 (Fed Cir. 2009) (holding methods directed to organizing business or legal relationships in the structuring of a sales force (or marketing campaign) to be ineligible); Credit Acceptance, 859 F.3d at 1044 at 1054 ("The Board determined that the claims are directed to the abstract idea of 'processing an application for financing a purchase.' . . . We agree."); Interval Licensing, 896 F.3d at 1344–45 (concluding that ([s]l)anding alone, the act of providing someone an additional set of information about a transaction, providing the ongoing provision of an initial set of information is an abstract idea," observing that the district court "pointed to the non-technical human activity of passing a note to a person at the middle of a meeting or conversation as further illustrating the basic, longstanding practice that is the focus of the [patent ineligible] claimed invention."); Vger Verif., Inc. v. Elec. Trading Software, LLC, 887 F.3d 1376, 1385 (Fed. Cir. 2018) (finding the concept of "voting, verifying the vote, and submitting the vote for tabulation," a "fundamental activity that has been performed for perhaps hundreds of years, to be an abstract idea); In re Smith, 815 F.3d 816, 818 (Fed. Cir. 2016) (concluding that ([s]applicants', claimed to rules for conducting a wagering game) are abstract.

15 Mayo, 560 U.S. at 71 (“[M]ethodical processes . . . and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work”); Myriad Genetics, Inc. v. Molecular Genetics, Inc., 558 U.S. at 164 (Fed. Cir. 2009) (holding that claim describing concepts performed in the human mind is patent ineligible).
Claims that do not recite matter that falls within these enumerated groupings of abstract ideas should not be treated as reciting abstract ideas, except as follows: In the rare circumstance in which a USPTO employee believes a claim limitation that does not fall within the enumerated groupings of abstract ideas should nonetheless be treated as reciting an abstract idea, the procedure described in Section III.C for analyzing the claim should be followed.

II. “Directed To” a Judicial Exception

The Supreme Court has long distinguished between principles themselves (which are not patent eligible) and the integration of those principles into practical applications (which are patent eligible).16 Similarly, would do it by head and hand.”); Symopsys, Inc. v. Mentor Graphics Corp., 839 F.3d 1138, 1139, (Fed. Cir. 2016) (referring to the mental process of “translating a functional description of a logic circuit into a hardware component description of the logic circuit” as directed to an abstract idea, i.e., “read on an individual performing the claimed steps mentally or with pencil and paper”); Mortg. Grader, 811 F.3d at 1324 (concluding that concept of “anonymous loan shopping” is an abstract idea because it could be “performed by humans without a computer”); In re BRCA1 & BRCA2-Based Hereditary Cancer Test Patent Litig., 774 F.3d 755, 763 (Fed. Cir. 2014) (explaining that concept of “comparing BRCA sequences and determining the existence of alterations” is an “abstract mental process”); In re Brown, 645 F. App’x, 1014, 1017 (Fed. Cir. 2016) (non-precedential) [claim limitations “encompass the mere idea of applying different known hair styles to balance one’s head. Identifying head shape and applying hair designs accordingly is an abstract idea capable, as the Board notes, of being performed entirely in one’s mind”].

16 See, e.g., Alice, 573 U.S. at 217 (explaining that “in applying the § 101 exception, we must distinguish between claims that claim the ‘building[ ] block[s]’ of human ingenuity and those that integrate the building blocks into something more” (quoting Mayo, 566 U.S. at 60) and stating that Mayo “set a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts”); Mayo, 566 U.S. at 80, 84 (noting that the Court in Diehr found “the overall process patent eligible because of the way the additional steps of the process integrated the equation into the process as a whole,” but the Court in Benson held that a simple implementing a mathematical principle on a physical machine, namely a computer, was not a patentable application of that principle); Bucki, 561 U.S. at 611 (“Diehr explained that while an abstract idea, law of nature, or mathematical formula could not be patented, ‘an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.’” (quoting Diehr, 450 U.S. at 187) [emphasis in original]); Diehr, 450 U.S. at 187, 192 n.14 (explaining that the process in Flook was ineligible because it “is not a patentable invention but rather a formulaic expression of the mathematical principle”); Bristow, 887 F.3d 1307, 1314, 1316 (Fed. Cir. 2018) (noting that the claimed invention is patent eligible because it is not directed to a patent-ineligible concept under step two or is an inventive application of a mathematical concept under step two).

17 See, e.g., Mayo, 566 U.S. at 39; 60 (recognizing that the “court must look to the claims at the ‘garment’ level to determine whether the recited judicial exception is integrated into a practical application of that exception. A claim is not ‘directed to’ a judicial exception, and thus is patent eligible, if the claim as a whole integrates the recited judicial exception into a practical application of that exception. 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.

III. Instructions for Applying Revised Step 2A During Examination

Examiners should determine whether a claim satisfies the criteria for subject matter eligibility by evaluating the claim in accordance with the criteria discussed in MPEP 2106, i.e., whether the claim is to a statutory category (Step 1) and the Alice/Mayo test for judicial exceptions (Steps 2A and 2B). The procedure set forth herein (referred to as “revised Step 2A”) changes how examiners should apply the first step of the Alice/Mayo test, which determines whether a claim is “directed to” a judicial exception.

As before, Step 1 of the USPTO’s eligibility analysis entails considering whether the claimed subject matter falls within the four statutory categories of some step one and step two considerations,” that its conclusion of eligibility at step one is “indirectly reinforced by some of [its] prior holdings under step two”.

These revised patent examination procedures are designed to more accurately and consistently identify claims that recite a practical application of a judicial exception (and thus are not “directed to” a judicial exception), thereby increasing predictability and consistency in the patent eligibility analysis. This analysis is performed at USPTO Step 2A, and incorporates certain considerations that have been applied by the courts at step one and at step two of the Alice/Mayo framework, given the recognized overlap in the steps depending on the facts of any given case.

In accordance with judicial precedent, and to increase consistency in examination practice, the 2019 Revised Patent Subject Matter Eligibility Guidance sets forth a procedure to determine whether a claim is “directed to” a judicial exception under USPTO Step 2A. Under the procedure, if a claim recites a judicial exception (a law of nature, a natural phenomenon, or an abstract idea as grouped in Section I, above), it must then be analyzed to determine whether the recited judicial exception is integrated into a practical application of that exception. A claim is not “directed to” a judicial exception, and thus is patent eligible, if the claim as a whole integrates the recited judicial exception into a practical application of that exception. 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 2019 Revised Patent Subject Matter Eligibility Guidance does not change Step 1 or the streamlined analysis, which are discussed in MPEP 2106.03 and 2106.06, respectively. Examiners may continue to use a streamlined analysis (Pathway A) if whether the claim recites a judicial exception. This prong adds a more detailed eligibility analysis to step one of the Alice/Mayo test (USPTO Step 2A) than was required under prior guidance. If the recited exception is integrated into a practical application of the exception, then the claim is eligible at Prong Two of revised Step 2A. This concludes the eligibility analysis. If, however, the additional elements do not integrate the exception into a practical application, then the claim is directed to the recited judicial exception, and requires further analysis under Step 2B (where it may still be eligible if it amounts to an “inventive concept”). The following discussion provides additional detail on this revised procedure.

A. Revised Step 2A

1. Prong One: Evaluate Whether the Claim Recites a Judicial Exception

In Prong One, examiners should evaluate whether the claim recites a judicial exception, i.e., an abstract idea, a law of nature, or a natural phenomenon. If the claim does not recite a judicial exception, it is not directed to a judicial exception (Step 2A: NO) and is eligible. This concludes the eligibility analysis. If the claim does recite a judicial exception, then it requires further analysis in Prong Two. If the recited exception is integrated into a practical application, then the claim is eligible. When the exception is so integrated, then the claim is not directed to a judicial exception (Step 2A: NO) and is eligible. This concludes the eligibility analysis. If the additional elements do not integrate the exception into a practical application, then the claim is directed to the judicial exception (Step 2A: YES), and requires further analysis under Step 2B (where it may still be eligible if it amounts to an “inventive concept”), as explained in Section III.B of the 2019 Revised Patent Subject Matter Eligibility Guidance.

Prong Two represents a change from prior guidance. The analysis under Prong Two is the same for all claims reciting a judicial exception, whether the exception is an abstract idea, a law of nature, or a natural phenomenon. Examiners evaluate integration into a practical application by: (a) Identifying whether there are any additional elements recited in the claim beyond whether the claim recites additional elements that integrate the exception into a practical application of that abstract idea, the procedure described in Section III.C for analyzing the claim except in the rare circumstance described below.

2. Prong Two: If the Claim Recites a Judicial Exception, Evaluate Whether the Judicial Exception Is Integrated Into a Practical Application

In Prong Two, examiners should evaluate whether the claim as a whole integrates the recited judicial exception into a practical application of the exception. 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. When the exception is so integrated, then the claim is not directed to a judicial exception (Step 2A: NO) and is eligible. This concludes the eligibility analysis. If the additional elements do not integrate the exception into a practical application, then the claim is directed to the judicial exception (Step 2A: YES), and requires further analysis under Step 2B (where it may still be eligible if it amounts to an “inventive concept”), as explained in Section III.B of the 2019 Revised Patent Subject Matter Eligibility Guidance.

Prong Two represents a change from prior guidance. The analysis under Prong Two is the same for all claims reciting a judicial exception, whether the exception is an abstract idea, a law of nature, or a natural phenomenon. Examiners evaluate integration into a practical application by: (a) Identifying whether there are any additional elements recited in the claim beyond whether the claim recites additional elements that integrate the exception into a practical application of that abstract idea, the procedure described in Section III.C for analyzing the claim except in the rare circumstance described below.

20 This notice does not change the type of claim limitations that are considered to recite a law of nature or natural phenomenon. For more information about laws of nature and natural phenomena, including products of nature, see MPEP 2106.04(b) and (c).

21 Even if a claim is determined to be patent eligible under section 101, this or any other step of the eligibility analysis does not end the inquiry. The claim must also satisfy the other conditions and requirements for patentability, for example, under section 102 (novelty), 103 (nonobviousness), or 112 (enableness, written description, definitiveness). Bilski, 561 U.S. at 602. Examiners should take care not to confuse or intermingle patentability requirements of these separate sections with patent eligibility analysis under section 101.

22 See, e.g., Amdocs, 841 F.3d at 1300, 1303; Bascom GlobalTech, LLC v. RoviCorp, 827 F.3d at 1349–52; DDR Holdings, LLC v. Hotels.com, L.P., 773 F.3d 1245, 1257–59 (Fed. Cir. 2014); USPTO Berkheimer Memorandum; see also Rapid Litig. Mgmt. v. affirmative step 2A patent eligible because it is not directed to a patent-ineligible concept under step one or is an inventive application of the patent-ineligible concept under step two).
the judicial exception(s); and (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application, using one or more of the considerations laid out by the Supreme Court and the Federal Circuit, for example those listed below. While some of the considerations listed below were discussed in prior guidance in the context of Step 2B, evaluating them in revised Step 2A specifically excludes consideration of whether the additional elements represent well-understood, routine, conventional activity. Instead, analysis of well-understood, routine, conventional activity is done in Step 2B. Accordingly, in revised Step 2A examiners should ensure that they give weight to all additional elements, whether or not they are conventional, when evaluating whether a judicial exception has been integrated into a practical application.

In the context of revised Step 2A, the following exemplary considerations are indicia that an additional element (or combination of elements) may have integrated the exception into a practical application:

- An additional element reflects an improvement in the functioning of a computer, or an improvement to other technology or technical field; 25
- An additional element that applies or uses a judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition; 26
- An additional element implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacturing process (e.g., a particular machine or process that is well-understood, routine, conventional activity; a computer, or an improvement to other technology or technical field; 25
- An additional element applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception. 29

This is not an exclusive list, and there may be other examples of integrating the exception into a practical application. The courts have also identified examples in which a judicial exception has not been integrated into a practical application:

- An additional element merely recites the words “apply it” (or an equivalent) with the judicial exception, or merely includes instructions to implement an abstract idea on a computer, or merely uses a computer as a tool to perform an abstract idea; 30

Also Besson, 409 U.S. 63 (holding that merely applying a mathematical formula on a general purpose computer is a patent ineligible abstract idea); Credit Acceptance Corp. v. Westlake Services, 859 F.3d 1044 (Fed. Cir. 2017) (using a computer as a tool to process an application for financing a purchase). 31

For example, a mere data gathering such as a step of obtaining information about credit card transactions so that the information can be analyzed in order to detect whether the transactions were fraudulent. See MPEP 2106.05(g) for more information concerning insignificant extra-solution activity, including a discussion of the example provided herein, which is based on CyberSource, 654 F.3d at 1375. See also Mayo, 566 U.S. at 79 (concluding that additional element of measuring metabolites of a drug administered to a patient was insignificant extra-solution activity, which was insufficient to confer patent eligibility); Flook, 437 U.S. at 590 (step of adjusting an alarm limit based on the output of a mathematical formula was “post-solution activity” and did not render method patent eligible). 32

For example, a claim describing how the abstract idea of hedging could be used in the commodities and energy markets, or a claim limiting the use of a mathematical formula to the petrochemical and oil-refining fields. See MPEP 2106.05(h) concerning generally linking use of a judicial exception to a particular technological environment or field of use, including a discussion of the exemplars provided herein, which are based on Bilski, 561 U.S. at 612, and Flook, 437 U.S. at 588–90. Thus, the mere application of an abstract method of organizing human activity in a particular field is not sufficient to integrate the judicial exception into a practical application. 33

If, of course, such claims do not satisfy the other conditions and requirements of patentability, for example, under section 102 (novelty), 103 (nonobviousness), and 112 (enablment, written description, definiteness). Bilski, 561 U.S. at 602.
B. Step 2B: If the Claim Is Directed to a Judicial Exception, Evaluate Whether the Claim Provides an Inventive Concept

It is possible that a claim that does not “integrate” a recited judicial exception is nonetheless patent eligible. For example the claim may recite additional elements that render the claim patent eligible even though a judicial exception is recited in a separate claim element. Along these lines, the Federal Circuit has held claims eligible at the second step of the Alice/Mayo test (USPTO Step 2B) because the additional elements recited in the claims provided “significantly more” than the recited judicial exception (e.g., because the additional elements were unconventional in combination). Therefore, if a claim has been determined to be directed to a judicial exception under revised Step 2A, examiners should then evaluate the additional elements individually and in combination under Step 2B to determine whether they provide an inventive concept (i.e., whether the additional elements amount to significantly more than the exception itself). If the examiner determines that the element (or combination of elements) is significantly more than the exception itself (Step 2B: YES), the claim is eligible, thereby concluding the eligibility analysis. If the examiner determines that the element and combination of elements does not amount to significantly more than the exception itself, the claim is ineligible (Step 2B: NO) and the examiner should reject the claim for lack of subject matter eligibility.

While many considerations in Step 2A need not be reevaluated in Step 2B, examiners should continue to consider in Step 2B whether an additional element or combination of elements:

- Adds a specific limitation or combination of limitations that are not well-understood, routine, conventional activity in the field, which is indicative that an inventive concept may be present; or
- simply appends well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception, which is indicative that an inventive concept may not be present.

For this reason, if an examiner had previously concluded under revised Step 2A that, e.g., an additional element was insignificant extra-solution activity, they should reevaluate that conclusion in Step 2B. If such reevaluation indicates that the element is unconventional or otherwise more than what is well-understood, routine, conventional activity in the field, this finding may indicate that an inventive concept is present and that the claim is thus eligible.

For example, when evaluating a claim reciting an abstract idea such as a mathematical equation and a series of data gathering steps that collect a necessary input for the equation, an examiner might consider the data gathering steps to be insignificant extra-solution activity in revised Step 2A, and therefore find that the judicial exception is not integrated into a practical application. However, when the examiner reconsider the data gathering steps in Step 2B, the examiner could determine that the combination of steps gather data in an unconventional way and therefore include an “inventive concept,” rendering the claim eligible at Step 2B. Likewise, a claim that does not meaningfully integrate a judicial exception into a practical application of the exception sufficient to pass muster at Step 2A, may nonetheless include additional subject matter that is unconventional and thus an “inventive concept” at Step 2B.

C. Treating a Claim Limitation That Does Not Fall Within the Enumerated Groupings of Abstract Ideas as Reciting an Abstract Idea

In the rare circumstance in which an examiner believes a claim limitation that does not fall within the enumerated groupings of abstract ideas should
requirements be analyzed in any particular order.

Dated: December 20, 2018.

Andrei Iancu,
Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

BILLING CODE 3510–16–P

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO–P–2018–0059]


ACTION: Examination guidance; request for comments.

SUMMARY: This guidance will assist United States Patent and Trademark Office (USPTO) personnel in the examination of claims in patent applications that contain functional language, particularly patent applications where functional language is used to claim computer-implemented inventions. Part I of this guidance addresses issues related to the examination of computer-implemented functional claims having means-plus-function limitations. Part II of this guidance addresses written description and enablement issues related to the examination of computer-implemented functional claims that recite only the idea of a solution or outcome to a problem but fail to recite details of how the solution or outcome is accomplished.

DATES: Applicable Date: The Computer-Implemented Functional Claim Limitations Guidance is effective on January 7, 2019. The Computer-Implemented Functional Claim Limitations Guidance applies to all applications, and to all patents resulting from applications, filed before, on or after January 7, 2019.

Comment Deadline Date: Written comments must be received on or before March 8, 2019.

ADDRESSES: Comments must be sent by electronic mail message over the internet addressed to: 112Guidance2019@uspto.gov.

Electronic comments submitted in plain text are preferred, but also may be submitted in ADOBE® portable document format or MICROSOFT WORD® format. Comments not submitted electronically should be submitted on paper in a format that facilitates convenient digital scanning into ADOBE® portable document format. The comments will be available for viewing via the USPTO’s internet website (http://www.uspto.gov). Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Nicole D. Haines, Senior Legal Advisor, at 571–272–7717 or Jeffrey R. West, Senior Legal Advisor, at 571–272–2226, both with the Office of Patent Legal Administration.

SUPPLEMENTARY INFORMATION: The patent examination process must ensure that: (1) The claims of an application have proper written description and enablement support under 35 U.S.C. 112(a) in the disclosure of the application, and (2) functional limitations [i.e., claim limitations that define an element in terms of the function it performs without reciting the structure, materials, or acts that perform the function] are properly treated as means (or step) plus function limitations under 35 U.S.C. 112(f), and are sufficiently definite under 35 U.S.C. 112(b), as appropriate. These requirements are particularly relevant to computer-implemented functional claims.

The U.S. Court of Appeals for the Federal Circuit ("Federal Circuit") has recognized a problem with broad functional claiming without adequate structural support in the specification. Williamson v. Citrix Online, LLC, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (en banc) (overruling the Federal Circuit’s previous application of a “strong” presumption that claim limitations lacking the word “means” are not subject to § 112(f) to address the resulting “proliferation of functional claiming untethered to § 112(f) and free of the strictures set forth in the statute”); Function Media, LLC v. Google, Inc., 708 F.3d 1310, 1319 (Fed. Cir. 2013) ("Section 112(f) is intended

42 Similarly, in the rare circumstance in which a panel of administrative patent judges (or panel majority) believes that a claim reciting a tentative abstract idea should be treated as reciting an abstract idea, the matter should be brought to the attention of the PTAB leadership by a written request for clearance.

43 See MPEP 2103 et seq. and 2106(III).