

Intellectual Property: 6 updates from the USPTO on patent eligibility



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The United States Patent and Trademark Office (USPTO) has released updated information for determining patent **subject matter eligibility**. The update addresses six common themes identified from public comments on the December 2014 **Interim Guidance on Patent Subject Matter Eligibility**.

1. Additional examples
2. Explanation of the “markedly different characteristics” analysis
3. Information regarding how examiners identify abstract ideas
4. Discussion of the *prima facie* case and the role of evidence with respect to eligibility rejections
5. Information regarding application of the 2014 Guidelines
6. Explanation of the role of preemption in the eligibility analysis, including a discussion of the streamlined analysis

1. Additional examples

The update provides several new examples, many of which address the “significantly more” standard that was introduced in the original *Alice Corporation Pty. Ltd. v. CLS Bank International* case. The examples focus on recent case law and seem to indicate that the USPTO will continue to update its practice as case law develops. The update also emphasizes that examiners should consider all elements of a claim both individually and in combination when they analyze whether a claim adds significantly more to patent ineligible subject matter (e.g., laws of nature, abstract ideas, natural phenomena, products of nature).

You should pay close attention to these guidelines and examples for pending and future applications. In pending applications, differentiating from unpatentable examples or relating to patentable examples may very well be the difference between securing patent protection and being vulnerable to competitors. In

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future applications, careful planning and drafting should allow the application to survive current and future developments in patent practice.

2. Markedly different characteristics (MDC)

The update reiterates that the MDC analysis is available for early identification of eligible subject matter. This analysis typically relates to product of nature claims. This analysis identifies claims as qualifying for patent protection if the claims recite a product of nature but with markedly different characteristics from what occurs in nature.

Applicants may be able to avoid needless rounds of prosecution if MDC analysis is identified early on. Applicants' counsel should thoroughly understand the nuances of the MDC analysis to navigate this fast-track to patent protection.

3. Examiners identify abstract ideas

Identifying whether a claim is directed to an abstract idea has proven to be a challenging concept, particularly with courts declining to define abstract ideas. The update notes that since there is no judicial definition, the 2014 Guidelines provide examples from various courts. To attempt to clarify and provide more guidance, the update identifies the following common judicial descriptors and provides a discussion on each.

- Fundamental economic practices
- Certain methods of organizing human activity
- An idea of itself
- Mathematical relationships/formulas

The update emphasizes that judicial exceptions are still patent ineligible even when they are not long-prevalent. This clarifies language previous presented in the 2014 Guidelines and in *Alice*. In these, the term long-standing led many to argue that otherwise ineligible subject matter was patentable because it was not long-standing. Here, the update seeks to curb this argument and clarify, for examiners and applicants alike, that an idea may be novel yet still not qualify for patent protection.

These clarifications and additional explanations in the update are particularly important for business methods, software, and certain bio-tech applications. You must be able to plan for and argue over rejections based on the abstract idea exception. Many inventions may be claimed in a way that makes them seem more or less akin to an abstract idea. Carefully crafted claims can protect an invention and safeguard against future challenges to the invention.

4. Discussion of the *prima facie* case and the role of evidence

Patent eligibility has been and remains a question of law. The burden of proving ineligibility is initially on the examiner. The examiner can meet this burden, "by clearly articulating the reason(s) why the claimed invention is not eligible." Once met, it is up to the applicant (and the applicant's counsel) to rebut or otherwise identify patent eligible subject matter. To do so requires understanding of case law, examples, USPTO procedures, and an ability to persuasively argue your point. It is further imperative that counsel remains up-to-date on current developments in the patent field.

5. Application of the 2014 Guidelines

This section of the update highlights that examiner training materials and guidance materials are available

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and open to the public. Advocates would be wise to review these materials.

6. Preemption and streamlined analysis

The USPTO and the courts have repeatedly emphasized a concern with patent claims that “tie-up” an abstract idea, law of nature, or other patent ineligible subject matter. This essentially comes down to the question of whether an applicant is trying to claim “too much.” Often, an applicant is able to overcome rejections by narrowing the scope of patent claims to a particular field, such as “a robotic arm,” as described in the examples. The update, however, reiterates that “the absence of complete preemption does not guarantee that a claim is eligible.”

With this update, many developments are highlighted and previously gray areas are addressed. The field of patent law, like other areas, is continuously developing and evolving. Many applications written today will not be examined for months or years. To successfully procure a patent, you should understand current developments and future trends. This understanding can strengthen your position both now and in the future.

The USPTO will accept written comments until Oct. 28, 2015, on the *Interim Eligibility Guidance* and Claim Example. Comments can be emailed to 2014_interim_guidance@uspto.gov. More information on how to submit comments is available on the USPTO's [website](#).

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