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THE USPTO'S NEW GUIDANCE SIMPLIFIES PROSECUTION BY CLARIFYING SUBJECT-MATTER ELIGIBILITY OF PATENTS

The U.S. Patent and Trademark Office (PTO) issued new guidance on Dec. 8, 2015 that provides improved clarity to those prosecuting patent applications in the computer-implemented and biochemical arts. Although many questions remain on the issue of subject matter eligibility, this guidance will be a useful tool to move prosecution of such applications past rejections under 35 U.S.C. § 101. It is available at the following link: http://www.gpo.gov/fdsys/pkg/FR-2014-12-16/pdf/2014-29414.pdf.

The Interim Guidance on Patent Subject Matter Eligibility (the "Guidance") will be available to examiners for prosecution immediately. This long-awaited document aims to provide better clarity on the subject matter eligibility of computer-implemented patents and patents in the biological, chemical and biochemical arts. For the past several months, navigating the eligibility of such patent applications has been difficult, in part due to unclear PTO rules and procedures following the Supreme Court decisions of *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) and *Mayo Collaborative Serv. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012).

The Guidance primarily focuses on adding details to the two-step subject matter eligibility test of *Alice Corp.* and *Mayo*. The first step of this test is to "determine whether the claim is directed to a law of nature, a natural phenomenon, or an abstract idea." Here, the Guidance affirms the PTO's broad power to find claims pending before the office as being directed to such judicially created exceptions.

Although the Guidance provides several examples of abstract ideas and natural phenomenon, it is clear that these examples are **non-limiting**. As such, the Guidance confirms the substantial discretion that has been used by examiners, courts and the Patent Trial and Appeal Board (PTAB) to find that claims are directed to abstract ideas or laws of nature. In light of this broad discretion, applicants should avoid only arguing that their claims are not directed to such exceptions. Such arguments will likely fail, therefore applicants should not rely solely on this approach.

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The second step is to "determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to significantly more than the judicial exception." The Guidance provides applicants with new methods of showing "significantly more" than previously provided.

First, the Guidance re-affirms the validity of the "machine or transformation" test. Specifically, "applying the judicial exception with, or by use of, a particular machine" and "effecting a transformation or reduction of a particular article to a different state or thing" both can constitute "significantly more" than the abstract idea, law of nature or natural phenomenon. Second, the Guidance states that "adding a specific limitation other than what is well-understood, routine and conventional in the field, or adding unconventional steps that confine the claim to a particular useful application" may also constitute "significantly more". This language appears to give PTO examiners significant latitude to overcome rejections under 35 U.S.C. § 101.

The Guidance also clarifies that "extrasolution activity" and "linking the use of the judicial exception to a particular technological environment or field of use" will not constitute "significantly more", resolving an open question since *Alice Corp*. It also specifies that when a claim recites "a plurality of exceptions," failing to find "significantly more" for any one of those exceptions will cause the claim to fail subject matter eligibility.

Additionally, the Guidance provides a new option for applicants with claims that "clearly do not seek to tie up any judicial exception such that others cannot practice it." Though the meaning of this statement is unclear, the PTO has offered an option of "streamlined eligibility analysis" for such claims.

There are some notable limitations to the Guidance. First, the Guidance does not constitute substantive rulemaking and lacks the force of law. As a result, examiners are not formally required to follow it. (Practically, however, we anticipate it will be used by most examiners.) Second, the Guidance is not binding on or applicable to litigation proceedings or proceedings at the Patent Trial and Appeal Board (PTAB). Third, these are truly "interim" guidelines.

We anticipate that final rules and laws are still in development and this area of law will continue to change over the coming months. More information on the Interim Guidance can be found here: http://www.uspto.gov/patents/law/exam/interim_guidance_subject_matter_eligibility.jsp