New USPTO Patent Subject Matter Eligibility Guidelines Raise More Questions Than They Answer

Eleven Patent Blog
March 17, 2014

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The USPTO has issued three new guidelines to help examiners apply the principles of 2014 Supreme Court decisions to any claim “reciting or involving laws of nature/natural principles, mathematical algorithms, or natural phenomena.” The guidelines stress that the analytical framework set forth in the Supreme Court’s 2014 decisions, including the analysis of inventive concept, applies “to any claim, and that the analysis may change because ‘developing case law may generate additional factors weighing in favor of or against patent eligibility.’”

Three Questions for Determining Patent Subject Matter Eligibility Under 35 USC § 101

The first section of the guidelines outlines the “three question flowchart” for making a subject matter eligibility determination: a) that includes a “claim question matrix,”

Question 1: Is the claimed invention directed to one of the four statutory patent-eligible subject matter categories: process, machine, manufacture, or composition of matter?

If yes, proceed to Question 2.

If no, the claim is not eligible for patent protection and should be rejected under § 101.

Question 2: Does the claim recite or involve one or more judicial exceptions?

If yes, the claim is not patent-eligible and the analysis is complete.

If no, or if it is unclear whether the claim recites or involves a judicial exception, proceed to Question 3.

Question 3: Does the claim recite or involve an abstract idea? If yes, answer this question using the judicial exception analysis used to evaluate enablement. The guidelines emphasize that not every factor will apply to every claim, and that the analysis may change because “developing case law may generate additional factors over time.”

Factors that weigh toward eligibility (significantly different):

i) Claim recites elements/steps in addition to the judicial exception(s) that must be used/taken by others as a condition of practice or use of the judicial exception(s).

ii) Claim recites elements/steps in addition to the judicial exception(s) with general instructions to apply or use the judicial exception(s).

iii) Claim recites elements/steps in addition to the judicial exception(s) that in a significant way change the function or manner of the judicial exception(s).

iv) Claim recites elements/steps in addition to the judicial exception(s) that are significantly different than the judicial exception(s).

The “Significantly Different” Test

The guidelines describe a “fact-based analysis for determining whether a claim recites something ‘significantly different’ from recognizable subject matter. The guidelines emphasize consideration of the claim as a whole, in view of “every relevant factor and related evidence,” similar to the question of whether a claim recites an abstract idea.]“

Factors that weigh against eligibility (significantly different):

i) Claim recites elements/steps in addition to the judicial exception(s) that are conventional or routine in the relevant field.

ii) Claim recites elements/steps in addition to the judicial exception(s) that must be used/taken by others as a condition of practice or use of the judicial exception(s).

iii) Claim recites elements/steps in addition to the judicial exception(s) that more than merely describe the judicial exception(s) with general instructions to apply or use the judicial exception(s).

iv) Claim recites elements/steps in addition to the judicial exception(s) that do more than describe the judicial exception(s) that are significantly different than the judicial exception(s) with general instructions to apply or use the judicial exception(s).

The Broad Reach of the New USPTO Patent Subject Matter Eligibility Guidelines

Although the Supreme Court’s Myriad decision was limited to human DNA sequences and its Patent ineligible status, “the guidelines include lists of factors that weigh towards and against patent eligibility. The guidelines also include several examples applying the one analytical framework to simple claims. The guidelines do not apply to claims that rely on ‘subject matter’ words that are still to be examined under Prometheus.”

Learning More About The New USPTO Patent Subject Matter Eligibility Guidelines

The guidelines themselves state that “to implement a new procedure for examining claims to a broad range of subject matter under 35 USC § 101, inclusive you are encouraged to discuss the new guidelines during law firm client seminars, ‘Pharma and ‘Pharma: New USPTO Examination Guidelines, scheduled for Thursday, March 20, 2014, at 3:30 PM EST. I am honored to be speaking on a panel with Raul Tamayo of the IPO and Susan Marks of Bio/Chemical Operations, Inc.”