

USPTO Released Updated Guidance for Examining Claims Under Section 101

Jesse A. Hirshman, Shareholder
Brian J. Jackson, Associate

12-22-14

On December 15, 2014, the United States Patent and Trademark Office released updated Interim Guidance on Patent Eligible Subject Matter for use by patent examiners in determining how to examine claims under Section 101 of the patent laws. This guidance supplements previously-issued guidance released in the wake of the Supreme Court's decision in *Alice Corp Pty. Ltd. v. CLS Bank Int'l*, and supersedes prior guidance from March 2014, directed to analysis of patent claims reciting or involving natural laws or products. This new guidance was published for comment in the Federal Register on December 16, 2014, and the Patent Office will be holding a public forum to discuss the guidance in January 2015.

The new guidance should provide a more reasonable and consistent examination of claims. Most importantly, the guidance mandates a full examination of a claim under Section 101 only if the claim is "directed to a law of nature, a natural phenomenon, or an abstract idea." "Directed to" is defined as a claim that recites or describes one of these so-called judicial exceptions. Previously, if the claim merely involved one of these exceptions, it would be subjected to a full Section 101 analysis. If the claim under examination is directed to a judicial exception, prior guidance requiring an analysis of whether the claimed subject matter is "markedly different" from, or whether the claim as a whole adds "significantly more" to the exception, will continue to be applicable. Examples provided by the Patent Office should be helpful in discerning what distinguishes a claim that merely *involves* an exception from a claim *directed to* an exception.

In addition, the Patent Office has proposed use of a streamlined eligibility analysis for claims that recite a judicial exception, but that, when viewed as a whole, "clearly [do] not seek to tie up any judicial exception such that others cannot practice it." Thus, claims that, for example, include a mathematical equation but clearly do not preempt use of that equation, would completely bypass a full Section 101 analysis. Although determining whether a claim "ties up" an exception may require a subjective analysis by the patent examiner, and thus may not be applied uniformly, this streamlined analysis should result in more favorable treatment of claims in a number of technological fields.