

New Patent Office Guidance Released on Subject Matter Eligibility

As the law regarding patent eligibility for certain subject matter continues to evolve, the U.S. Patent and Trademark Office (USPTO) recently clarified its examination procedure relating to subject matter eligibility in a memorandum to the Examining Corps, dated April 19, 2018. The USPTO is now soliciting public comments.

The revised rule and memorandum address the recently issued decision by the U.S. Court of Appeals for the Federal Circuit in *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), which held that whether certain claim limitations represent well-understood, routine, conventional activity, raised a disputed factual issue precluding summary judgment on the issue of subject matter eligibility. In response to this decision, the USPTO has updated the examination procedure set forth in MPEP § 2106.07(a) and (b).

Under the new procedure, a rejection based on the conclusion that an additional element (or combination of elements) is well-understood, routine or conventional must be expressly supported in writing by one or more of the following:

1. A citation to an express statement in the specification or a statement by applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the element(s) in question. Applicant's mere silence with respect to describing such element(s) is not sufficient to conclude the above.
2. A citation to one or more court decisions discussed in MPEP § 2106.05(d)II finding the element(s) as well-understood, routine, conventional.
3. A citation to a publication, other than patent literature (i.e., printed publications under 35 U.S.C. § 102), that demonstrates the well-understood, routine, conventional nature of the additional element(s). An appropriate publication can be a book, article, or other source that discusses the state of the art and what is well-known and common in the relevant industry. A disclosure of the additional element(s) in a U.S. patent or application publication is generally not sufficient to support the conclusion of well-understood, routine or conventional unless the publication demonstrates that the additional element(s) are widely prevalent or in common use in the relevant field.
4. A statement that the Examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s), compliant with the procedure for

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taking official notice as discussed in MPEP § 2144.03.

This revised procedure provides some much-needed guidance to practitioners and applicants for assessing the merits of a Section 101 rejection. On the one hand, the memorandum emphasizes that the inquiry into well-understood, routine, conventional activity is distinct from the question of patentability over prior art under 35 U.S.C. §§ 102 and 103, and clearly outlines the evidentiary standard for supporting a rejection, thus providing practitioners additional tools for challenging a deficient rejection. On the other hand, the revised rule more directly ties the inquiry into well-understood, routine, conventional to the contours of Section 112(a) analysis. Thus, practitioners and applicants should take particular care in the manner in which elements of the claimed technology are discussed in the application and during prosecution to avoid the inadvertent and unintentional characterization of an element of the invention as well-understood, routine, or conventional.