USPTO Provides Guidelines on Patenting Software-Related Inventions

Dec 18, 2014

Authors: Paul Horbal and Cameron Gale

On December 16, 2014, the United States Patent and Trademark Office (USPTO) released revised Guidelines for its patent Examiners regarding patent subject matter eligibility (Interim Eligibility Guidelines"). The guidelines take effect immediately, and supplement the Preliminary Guidelines that were issued June 25, 2014 in the wake of the Supreme Court's decision in *Alice Corp. v. CLS Bank International* (" *Alice*").

The Interim Eligibility Guidelines specify that all claims directed to a "judicial exception" from patentable subject matter (i.e., a law of nature, a natural phenomenon, or an abstract idea) are subject to the same two-step analysis for eligibility developed by the Supreme Court in *Mayo v. Prometheus* (the " *Mayo* test") and which was applied in Alice.

The first step of the judicial exception analysis is to determine whether the "claim as a whole" is directed to a judicial exception. The Interim Eligibility Guidelines indicate that this will be the case where a judicial exception specifically "is recited (i.e., set forth or described) in the claim". Abstract ideas are identified in the Interim Eligibility Guidelines through examples previously identified by the courts, such as "fundamental economic practices, certain methods of organizing human activities, an idea 'of itself', and mathematical relationships/formulas". The use of examples in lieu of more generalized rules suggests that much of the analysis performed here will be by way of analogy. This reflects the uncertainty surrounding "abstract ideas" that has followed in the wake of the *Alice* decision. Strategic drafting of software related patent applications will take into account these specific examples and other real world cases which have either cleared or have not cleared the *Alice* hurdle.

In the second step of the analysis, after determining that a claim is directed to a judicial exception, the claim is analyzed to determine "whether the elements of the claim, considered both individually and as an ordered combination, are sufficient to ensure that the claim as a whole amounts to significantly more than the exception itself". To be patentable, each claim must include elements such that the claim "describes a process or product that applies the exception in a meaningful way, such that it is more than a drafting effort designed to monopolize the exception". This suggests that dependent claims reciting particular implementation details may be useful in overcoming rejections raised on the basis that the claims are directed to an abstract idea.

The Interim Eligibility Guidelines also utilize examples to illustrate what will amount to the "significantly more" referenced in the second prong of the *Alice* analysis. The examples include improvements to another technology or technical field, improvements to a computer itself, and application of the judicial exception with a particular machine. Once again, patent applicants should pay careful attention to these examples, and make efforts to frame their inventions as analogous to inventions that have previously satisfied these considerations.

Although the Interim Eligibility Guidelines do not provide much new specific structure to the analysis of software patents, they further emphasize the importance of framing inventions in the description and during prosecution to highlight the technical and technological features of the invention. Moreover, these guidelines are likely not to be the end of the changes in the wake of the *Alice* decision. The USPTO is seeking public comments on the Interim Eligibility Guidelines and notes that further changes to the Guidelines may be forthcoming in view of the pending appeals currently before the Court of Appeal for the Federal Circuit.