

USPTO Refreshes Examination Guidelines Relating to Patentable Subject Matter

May 9, 2016

Author: [Paul Horbal](#)

An abstract idea – by itself – is not patentable. This basic tenet is found in patent systems all over the world. However, it turns out to be surprisingly difficult to draw the line between an abstract idea and an invention that is patentable. This helps to explain why the United States Patent & Trademark Office (USPTO) has supplemented examination guidelines concerning patentable subject matter for the third time in as many years with its [May 2016 Subject Matter Eligibility Update](#).

In 2014, the U.S. Supreme Court delivered what is currently the last word on patentable subject matter. In the case of *Alice Corp v. CLS Bank International* (*Alice*), the Court confirmed that a two-part test it had set out in a 2012 decision (*Mayo Collaborative Service v. Prometheus Laboratories, Inc.*) was indeed to be used in evaluating all inventions for patentability. The test requires that patent claims: 1) belong to a statutory category of invention, such as a process, machine or composition of matter; and 2) either not be directed to a judicial exception from patentability, such as a law of nature, a natural phenomenon or an abstract idea, or else that they contain “significantly more” than the law of nature or abstract idea.

The question of what amounts to “significantly more” is not an easy one to answer. In the immediate aftermath of the *Alice* decision, patent examiners had few signposts to reference when evaluating applications. Earlier tests set down by the courts – which examiners previously had relied upon – were no longer dispositive. Recognizing this, the USPTO issued interim guidance in December 2014 to aid examiners, which were supplemented in July 2015 with additional examples and guidance.

Even with the benefit of regular updates to the examination guidelines, there has been considerable variability in the application of subject matter rules by USPTO examiners. The most recent guidance aims to enhance uniformity across all application areas.

In the May 2016 Subject Matter Eligibility Update, examiners are given [detailed and point-by-point instructions](#) for formulating a proper rejection on subject matter grounds.

First, when deciding that a claim recites an abstract idea, examiners are instructed to identify the specific abstract idea and to explain why the identified abstract idea corresponds to a concept that the courts have identified as such. Examiners are also expected to be reasonably familiar with relevant court cases, so that decisions are not taken out of context, and to avoid going beyond those abstract ideas that have been identified by the courts. Similar procedures are to be followed for laws or products of nature.

If an abstract idea or natural product or law has been identified, examiners are directed to consider whether “significantly more” can be found in the claims. In particular, examiners should assess the additional elements in the claims both individually and as a combination. The guidelines note that “it is particularly critical to address the combination of additional elements, because while individually-viewed elements may not appear to add significantly more, those additional elements when viewed in combination may amount to significantly more than the exception by meaningfully limiting the judicial exception.”

Where “significantly more” cannot be found, examiners are directed to explain their rationale in sufficient detail to allow the applicant to respond effectively.

The guidelines also provide specific instructions for certain categories of invention. For example, regarding “generic computer” components, the supplement notes that although some routine, conventional computer functions have been determined not to add “significantly more”, the courts have also found computer-implemented methods to be eligible where generic computer components perform activities that are not merely generic.

This is an area of patent law that is actively evolving. Not surprisingly, the USPTO has received a significant amount of public comment, and intends to continue accepting comments for the foreseeable future. Therefore we can expect the USPTO to issue further guidance for its examiners in the coming years as the law regarding patentable subject matter settles.