A Positive Step for Software Patent Eligibility in the United States – Clarifying the “Well-Understood, Routine, and Conventional”

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The recent U.S. decision in Berkheimer v. HP Inc. provides long-awaited guidance on the eligibility test for software-implemented innovations set out in Alice Corp. v. CLS Bank International.

In Alice, the Supreme Court set out a two-part eligibility test that first requires an examination of whether a patent claim is directed to an exception from patentable subject matter. If the claim is found to be directed to an exception, then the test further requires a determination of whether the claim, as a whole, amounts to “significantly more” than the exception. The Supreme Court indicated that “specific limitations other than what is well-understood, routine, and conventional in the field” can satisfy the “significantly more” requirement.

Since Alice, both Applicants and the U.S. Patent and Trademark Office (USPTO) have struggled with the phrase, “well-understood, routine, and conventional”. The USPTO followed an expansive approach and often alleged claim elements were “well-understood, routine, and conventional” using broad, conclusory statements. Any requests from Applicants for evidence demonstrating those allegations were often ignored.

In Berkheimer, the U.S. Court of Appeals for the Federal Circuit (CAFC) provided much needed clarification on interpreting “well-understood, routine, and conventional” activities. The CAFC partially reversed a District Court’s summary judgement in which several claims of U.S. Patent No. 7,447,713 were held to be invalid for being directed to ineligible subject matter under the Alice test. The CAFC affirmed that the determination of whether claim elements are well-understood, routine, and conventional to a skilled person in the relevant field is a question of fact, and that such a conclusion must be supported by clear and convincing evidence. The CAFC also clarified that the disclosure of the claim elements in the prior art does not necessarily make those elements well-understood, routine, and conventional.

Following Berkheimer, the USPTO issued guidelines outlining the types of evidence that Patent Examiners are required to show when alleging claim elements are “well-understood, routine, and conventional”. These include:

- an express statement in the specification or by the Applicant during prosecution;
- a court decision demonstrating that the claim elements are well-understood, routine, and conventional; or
- a printed publication that describes the state of the art and discusses what is well-known and in common use in the relevant industry. The guidelines indicate that a mere mention of the claim element in a patent publication is inadequate evidence.

The guidelines also permit the Examiner to take Official Notice that the claim elements are well-understood, routine, and conventional, but require that the Examiner provide one of the other types of evidence if the Official Notice is challenged by the Applicant.

Berkheimer and the new USPTO guidelines make clear that any allegation that the claim elements are “well-understood, routine, and conventional” must be supported by factual evidence. Despite the guidance offered by the growing U.S. jurisprudence and prior USPTO guidelines, many uncertainties still surround the patent eligibility test. However, Berkheimer provides a welcome clarification that should lead to a more meaningful dialogue between Applicants...
and the USPTO.


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