

## ALERTS

### Intellectual Property Law Alert - USPTO Provides Meaningful Direction On Patentable Subject Matter Eligibility

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The U.S. Patent and Trademark Office (USPTO) published a Notice on July 30 updating procedures for determining patent eligible subject matter under 35 U.S.C. §101 with a request for public comments. Included in the Notice (hereafter July 2015 Update) is a series of appendices that provide new examples and guidance that may be used by both examiners and patent applicants to determine subject matter eligibility.

The July 2015 Update is particularly focused on analysis of abstract ideas, particularly in the business method, Graphical User Interface and software areas. The USPTO has indicated that a similar notice with examples in the biotechnology area, especially diagnostic and other method claims directed to laws of nature and natural phenomena, is presently being prepared and will take into account recent judicial developments regarding those areas.

The examples included in the July 2015 Update provide additional eligible/ineligible claims in various technologies, as well as sample analyses applying the Supreme Court and Federal Circuit's approaches for determining whether a claim with additional elements amounts to significantly more than the judicial exception itself. As a result, those examples should be equally valuable to USPTO examiners and applicants alike by providing all parties with better direction on the proper analysis for determining patent eligible subject matter.

The examples are categorized into six major themes identified in the public comments received by the Office in response to the Revised Guidance published Dec. 16, 2014, (2014 Interim Guidance on Patent Subject Matter Eligibility, 79 FR 74618) (December 2014 Interim Guidance). Those themes include:

1. requests for additional examples, particularly for claims directed to abstract ideas and laws of nature;
2. further explanation of the markedly different characteristics analysis;
3. further information regarding how examiners identify abstract ideas;
4. discussion of the prima facie case and the role of evidence with respect to eligibility rejections;
5. information regarding application of the December 2014 Interim Guidance in the Patent Examining Corps; and
6. explanation of the role of preemption in the eligibility analysis, including a discussion of the streamlined analysis.

The appendices also include an index of examples for use with the

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December 2014 Interim Guidance and a quick reference sheet that includes additional explanation of the required analysis to establish a prima facie case of eligibility. The USPTO has provided the index of examples to ensure subject matter identified as abstract ideas is “similar to at least one concept that the courts have identified as an abstract idea.” Those concepts include fundamental economic practices, an idea ‘of itself,’ certain methods of organizing human activity and mathematical relationships/formulas.

Both the December 2014 Interim Guidance and the July 2015 Update are evidence of the USPTO’s continued efforts to formulate and implement policy regarding the judicially recognized patent ineligible exceptions, which include laws of nature, natural phenomena and abstract ideas. The July 2015 Update provides additional direction regarding what is required for applicants to establish patent eligibility at the USPTO under the present standards.

However, as recognized by the July 2015 Update, a number of judicial proceedings have been decided recently in the federal courts and by the Court of Appeals for the Federal Circuit, and those proceedings may require rehearing by the Federal Circuit and/or certiorari to the Supreme Court. In turn, such proceedings may, and likely will, alter the judicially created exceptions themselves. Therefore, both the patent eligibility standards, and the scope of the judicially created exception to that eligibility, remain in flux.

For more information, contact the Barnes & Thornburg attorney with whom you work or a member of the firm’s Intellectual Property Law Department in the following offices: Atlanta (404-846-1693), Chicago (312-357-1313), Columbus (614-628-0096), Delaware (302-300-3434) Elkhart (574-293-0681), Fort Wayne (260-423-9440), Grand Rapids (616-742-3930), Indianapolis (317-236-1313), Los Angeles (310-284-3880), Minneapolis (612-333-2111), South Bend (574-233-1171), Washington, D.C. (202-289-1313).

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