

# USPTO ISSUES UPDATED GUIDELINES AFFECTING COMPUTER-IMPLEMENTED CLAIMS

*Intellectual Property & Technology Alert*  
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On December 15, 2014, the United States Patent & Trademark Office (USPTO) released Interim Guidance on Patent Subject Matter Eligibility.<sup>1</sup> The guidelines, titled Interim Guidance on Patent Subject Matter Eligibility (the Interim Guidance), became effective upon publication in the Federal Register on December 16, 2014.

The Interim Guidance establishes a single test for all inventions. This communication provides a summary of the Interim Guidance relevant to computer-implemented inventions. A summary relevant to laws of nature, natural phenomena, or natural products can be found at in the Hodgson Russ-issued client alert “USPTO Issues Updated Guidelines Affecting Natural Products and Phenomenon.”

While the Interim Guidance does not have the power of law, it will be used by patent examiners to determine subject matter eligibility during prosecution.

## **Updated Test for Eligibility**

The USPTO adopts an updated test for evaluating the subject matter eligibility of a claim. But prior to using the test, the examiner must first construe the claim in accordance with its broadest reasonable interpretation in light of the specification.

Under the Interim Guidance, the first step is to determine whether the claim is directed to statutory subject matter identified in 35 U.S.C. § 101. If the answer is no, the claims recite ineligible subject matter.

Most computer-implemented claims are directed to either a process (e.g., computer program) or a machine (e.g., computer hardware or systems). Both are patent-eligible subject matter under 35 U.S.C. § 101. Therefore, the test for eligibility continues to the second step.

The second step of the USPTO’s test is separated into two sub-parts.

In step 2A, the examiner first determines whether the claim is directed to a judicial exception to the statutory subject matter in 35 U.S.C. § 101. Abstract ideas are one such exception. The abstract idea exception is often applied to computer-implemented claims.

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Some practical examples of abstract ideas include:

- Mitigating settlement risk or hedging;
- Creating a contractual relationship;
- Using advertising as an exchange or currency;
- Processing information through a clearinghouse;
- Comparing new and stored information and using rules to identify options;
- Using categories to organize, store and transmit information;
- Organizing information through mathematical correlations;
- Managing a game of bingo;
- Using the Arrhenius equation for calculating the cure time of rubber;
- A formula for updating alarm limits;
- A mathematical formula relating to standing wave phenomena; and
- A mathematical procedure for converting one form of numerical representation to another.

The analysis ends if the examiner determines that the claims are not directed to an abstract idea. However, if the examiner determines that the claims are directed to an abstract idea, the analysis continues with step 2B. In step 2B, the examiner determines “whether the claims recited additional elements that amount to significantly more than the judicial exception.”<sup>2</sup>

### “Significantly More” Than an Abstract Idea

To aid examiners, the Interim Guidance summarizes Supreme Court precedent and identifies numerous considerations for determining whether a claim with additional elements amounts to significantly more than an abstract idea. Limitations that may be enough to qualify as “significantly more” when recited in a claim include:

- Improvements to another technology or technical field;
- Improvements to the functioning of a computer itself;
- Applying the abstract idea with, or by use of, a particular machine;
- Effecting a transformation or reduction of a particular article to a different state or thing;
- Adding a specific limitation other than what is well-understood, routine, and conventional in the field, or adding unconventional steps that confine the claim to a particular useful application; or
- Other meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment.

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Limitations that were found not to be enough to qualify as “significantly more” when recited in a claim include:

- Adding the words “apply it” (or an equivalent) with the abstract idea or mere instructions to implement an abstract idea on a computer;
- Appending well-understood, routine, and conventional activities previously known to the industry, specified at a high level of generality, to the abstract idea, e.g., requiring no more than a generic computer to perform generic computer functions that are well-understood, routine, and conventional activities previously known to the industry;
- Adding insignificant extrasolution activity to the judicial exception, e.g., mere data gathering in conjunction with an abstract idea; or
- Generally linking the use of the abstract idea to a particular technological environment or field of use.

### **Tying Up Subject Matter**

The USPTO’s rationale behind the Interim Guidance is important. The Interim Guidance suggests that claims directed to abstract ideas should be scrutinized because of the risk that the claim might “tie up” the subject matter and preempt others from using the abstract idea.

However, a claim is not ineligible simply because it involves an abstract concept.<sup>3</sup> The interim guidance gives one such an example: a robotic arm assembly having a control system that operates using certain mathematical relationships is clearly not an attempt to tie up use of the mathematical relationships. The example focuses on claims that sufficiently limit the abstract idea’s practical application.

### **Practical Claim Drafting Tips**

Wherever possible, claims should include limitations that provide “something more” than a mere computer implementation.

For example, frame computer-implemented claims in such a way that transforms one object into another. Apply meaningful limits to mathematical formulae such that they improve an existing technological process. Disclose processing systems and modules, especially for seemingly routine steps like monitoring, adjusting, and updating. Add structural limitations instead of field-of-use limitations. Lastly, develop a strong and detailed specification to support future claim amendments.

We expect that future drafting strategies will emerge as the case law in this area matures.

### **Long-Lasting Effects?**

The USPTO, Federal Circuit, and Supreme Court have not developed a bright line test for subject matter eligibility. Although the Interim Guidance attempts to add clarity, any subject matter analysis tends to be fact-specific.

Clearly, there will be many more § 101 cases to come. It’s important to remember that the Interim Guidance is precisely that—interim. The USPTO has invited public comment on the Interim Guidance, and we expect to see continuous changes in how the USPTO determines subject matter eligibility.

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1. The full text of the Interim Guidance can be found here: <http://www.gpo.gov/fdsys/pkg/FR-2014-12-16/pdf/2014-29414.pdf>
2. Interim Guidance at pg. 74624.
3. *Alice Corp.*, 134 S.Ct. at 2354 (quoting *Benson*, 409 U.S. at 67).