
USPTO Orders New Guidance: Hold the *Mayo*

USPTO Publishes 2019 Revised Patent Subject Matter Eligibility Guidance

On January 7, 2019, the United States Patent and Trademark Office (USPTO) published proposed guidance to assist its patent examiners and stakeholders in evaluating proposed claims in light of the *Mayo/Alice* line of cases and subsequent treatment by the Federal Circuit Court of Appeals.

Until now, when evaluating patent-subject-matter eligibility under 35 U.S.C. § 101, the USPTO has primarily relied upon tracking Federal Circuit post-*Alice* decisions addressing the patentability of abstract ideas. But Federal Circuit guidance, across the various cases and associated judge panels, has at times appeared to be contradictory and ambiguous, thereby reducing predictability and increasing the risk of inconsistent application of § 101 by USPTO examiners and practice groups.

The USPTO's new guidance first groups what the USPTO considers to be abstract ideas—namely, (1) mathematical concepts, (2) certain methods of organizing human activity, and (3) mental processes—and enumerates examples of each. Excepting the rare instance when a claim may recite matter that constitutes an abstract idea falling outside of these categories, if a claim does not recite matter within these three groupings, the claim should not be evaluated further for eligibility under § 101.

If a claim *does* fall within one of these three categories, further examination is required under the new guidance. The examiner will next determine whether the claim is “integrates,” instead of being merely “directed to,” a judicial exception, i.e., a law of nature, a natural phenomenon, or an abstract idea. The new guidance states that a claim may be patentable if, as a whole, it integrates a recited judicial exception into a practical application thereof. A claim integrates a judicial exception when it applies, relies on, or uses the judicial exception in a manner that imposes a “meaningful” limit on the exception such that the claim is more than an effort to monopolize the judicial exception.

Even if the claim does not integrate the exception, it may still be patent eligible if the use of the judicial exception represents an “inventive concept.” Typically, this standard will be met by the addition of other elements into a claim in a way that is “unconventional in combination.” But the additional elements must result in the claim being significantly more than the recited judicial exception, itself, for the claim to be patent eligible.

A recently affirmed summary judgment opinion provides a useful comparison of the judicial process when evaluating § 101 eligibility to this new guidance by the USPTO. See *Intellectual Ventures I LLC v. T-Mobile USA, Inc.*, 2017 WL 3706495 at *3-4 (D.Del. August 23, 2017) *aff'd* 748 Fed. Appx. 330 (Fed. Cir. 2019). The test articulated by the district court, citing precedent, states that *first* it must determine whether a claim “as a whole” is directed to “excluded subject matter.” Then, *second*, it must look to whether the claims contain an element, or combination of elements, that is sufficient to ensure that the claim amounts to significantly more than merely a patent on the patent ineligible subject matter itself. In practice, the USPTO's new guidance should closely mirror this two-step analysis, despite using different terminology and focusing on the analysis in a different way.