



Patent Litigation

A graphic with the word "ALERT" in white capital letters on a blue background with technical drawings and gears.

MAY 2016

USPTO Issues Guidance on Subject Matter Eligibility

Nearly two years after the U.S. Supreme Court issued its ruling in *Alice Corp. v. CLS Bank*, patent examiners, applicants, practitioners and inventors continue to seek guidance on determining patentable subject matter under 35 U.S.C. §101. The United States Patent and Trademark Office has since issued its 2014 Interim Guidance on Patent Subject Matter Eligibility (2014 IEG), a July 2015 update and most recently the [May 2016 Subject Matter Eligibility Update](#), which provides the USPTO Examining Corps with instructions on how examiners should formulate detailed rejections under 35 U.S.C. §101 and how examiners should evaluate applicants' responses to those rejections.

The centerpiece of the May 2016 Subject Matter Eligibility Update is a memo from the USPTO to the Examining Corps instructing examiners to provide clear and specific explanations to applicants when a claim does not recite eligible subject matter under 35 U.S.C. §101. Rejections of claims for patent-ineligible subject matter should identify the judicial exception (such as an abstract idea, a law of nature or a natural phenomenon) and explain why each claim is unpatentable (Step 2A of the two-part analysis described in the 2014 IEG), and then identify any additional elements of the claim and explain why these additional elements (individually and as a combination) do not yield a claim that is patent eligible

(Step 2B of the two-part analysis described in the 2014 IEG). Examiners are urged to diligently consider the applicant's claim amendment(s) and/or argument(s) in response to a rejection under 35 U.S.C. §101 when evaluating whether a claim is directed to a judicial exception or is directed to something "significantly more" than an exception.

The May 2016 Subject Matter Eligibility Update includes additional subject matter eligibility examples in the life science fields including vaccines, diagnosis and treatment of disease states, genetic screening, and chemical reactions. Additionally, the USPTO updated the list of subject matter eligibility decisions from the U.S. Supreme Court and U.S. Court of Appeals for the Federal Circuit with decisions through April 2016. The decision chart is designed to assist examiners and practitioners in identifying the types of subject matter the courts have previously found to be patent ineligible.

The May 2016 update is intended to improve the quality of examiner correspondence with applicants regarding subject matter eligibility rejections as well as to help applicants respond to rejections under 35 U.S.C. §101. The USPTO now seeks public comment on subject matter eligibility on an ongoing basis.

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Further updates and refinements to the USPTO's examination strategy for determining patentable subject matter under 35 U.S.C. §101 can be expected as the courts continue to decide patent eligibility cases and as the USPTO receives additional comments.

For more information about the content of this alert, please contact [Bill Kramer](#) or [Joshua Harris](#).

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