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PATENT AND TRADEMARK OFFICE



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**Patent Quality Chat**  
**Subject Matter Eligibility: Revised Guidance**  
**in view of *Berkheimer v. HP, Inc.***

May 8, 2018

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### Highlights



#### [Patent Quality Chat](#)

Our next Patent Quality Chat will be on May 8<sup>th</sup> discussing "Subject Matter Eligibility: Revised Guidance in view of *Berkheimer v. HP, Inc.*".

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#### [Stakeholder Training on Examination Practice and Procedure \(STEPP\)](#)

Sign up for an upcoming training developed for those interested in a better understanding of the examination process at the USPTO.

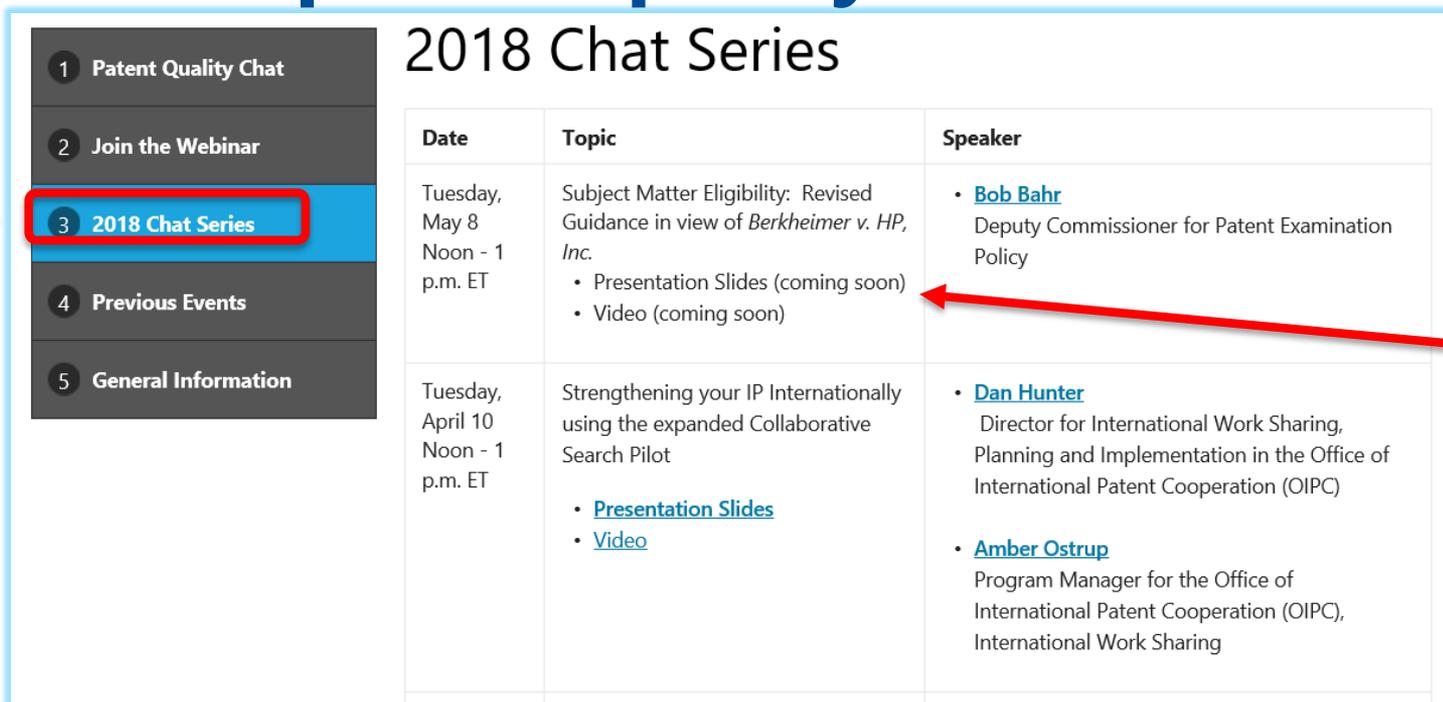
### Areas of Focus

Collaboration with our stakeholders has directed our focus within three areas, where we can best improve patent quality.



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# <http://www.uspto.gov/patent/initiatives/patent-quality-chat>



## 2018 Chat Series

Date	Topic	Speaker
Tuesday, May 8 Noon - 1 p.m. ET	Subject Matter Eligibility: Revised Guidance in view of <i>Berkheimer v. HP, Inc.</i> <ul style="list-style-type: none"><li>• Presentation Slides (coming soon)</li><li>• Video (coming soon)</li></ul>	<ul style="list-style-type: none"><li>• <a href="#">Bob Bahr</a> Deputy Commissioner for Patent Examination Policy</li></ul>
Tuesday, April 10 Noon - 1 p.m. ET	Strengthening your IP Internationally using the expanded Collaborative Search Pilot <ul style="list-style-type: none"><li>• <a href="#">Presentation Slides</a></li><li>• <a href="#">Video</a></li></ul>	<ul style="list-style-type: none"><li>• <a href="#">Dan Hunter</a> Director for International Work Sharing, Planning and Implementation in the Office of International Patent Cooperation (OIPC)</li><li>• <a href="#">Amber Ostrup</a> Program Manager for the Office of International Patent Cooperation (OIPC), International Work Sharing</li></ul>

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# Patent Quality Chat

## Subject Matter Eligibility: Revised Guidance in view of *Berkheimer v. HP, Inc.*

**Robert Bahr**

Deputy Commissioner for Patent Examination Policy

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# ***Berkheimer v. HP, Inc.***

- Federal Circuit issued this precedential decision on February 8, 2018
  - *Berkheimer* holds that the question of whether certain claim limitations represent well-understood, routine, conventional activity raised a disputed factual issue, which precluded summary judgment that all of the claims at issue were not patent eligible
  - Shortly thereafter, the Federal Circuit reaffirmed the *Berkheimer* standard in two additional decisions, in the context of a judgment on the pleadings, and judgment as a matter of law
- In the examination context, the *Berkheimer* standard informs the inquiry into whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity in Step 2B



# USPTO Response to *Berkheimer*

- Memorandum revising examination procedure in view of *Berkheimer* issued on April 19, 2018:

*Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.)*

- Notice announcing this revision to examination procedure and requesting public comments published on April 20, 2018:

*Request for Comments on Determining Whether a Claim Element Is Well-Understood, Routine, Conventional for Purposes of Subject Matter Eligibility, 83 Fed. Reg. 17537*

[Click here for a copy of the \*Berkheimer\* Memorandum](#)

[Click here for a copy of the Federal Register Notice](#)

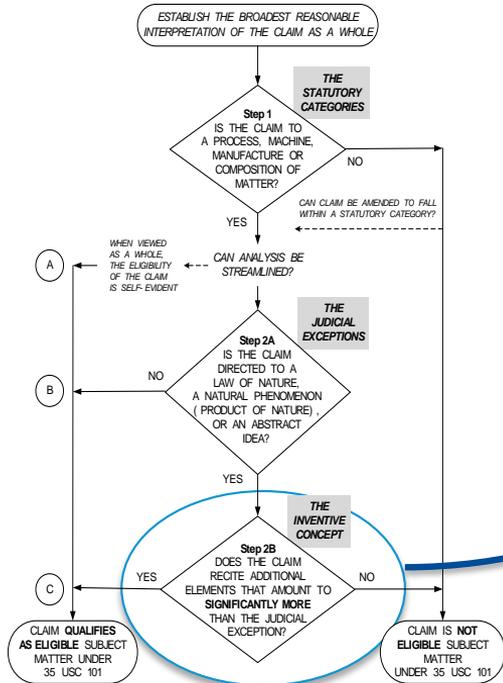
# New Memorandum to the Examining Corps

*Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (Berkheimer v. HP, Inc.) 4/19/18*

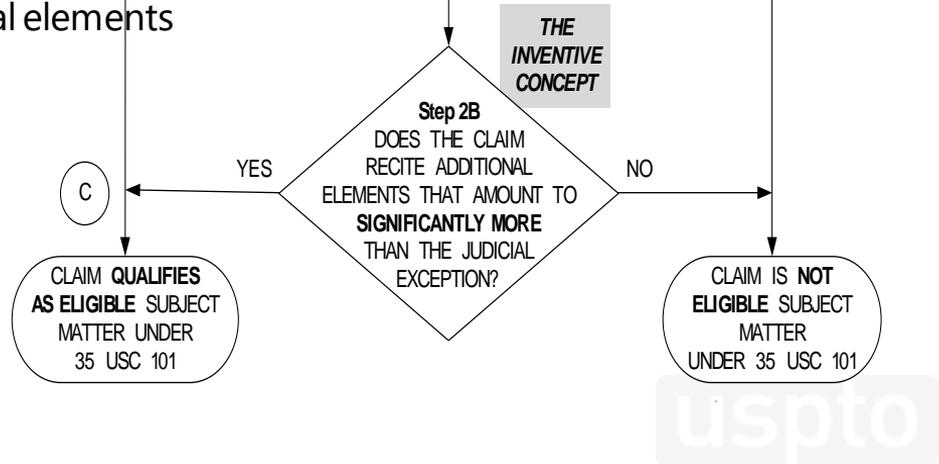
- No change to basic subject matter eligibility framework, but clarifies how to determine whether an additional element (or combination of additional elements) represents well-understood, routine, conventional activity in Step 2B
  - An examiner should conclude that an element (or combination of elements) is well-understood, routine, conventional activity **only** when the examiner can readily conclude that the element(s) is widely prevalent or in common use in the relevant industry, as explained in MPEP § 2106.05(d)(I)
  - **NEW:** Conclusion must be based upon factual determinations



# Eligibility Flowchart



- Claims that do not recite a judicial exception or that are directed to an improvement in technology are eligible at Step 2A
- Claims that are directed to a judicial exception must be analyzed under Step 2B to look for an “inventive concept” in the additional elements



# Eligibility Framework MPEP 2106

- Step 1: The Four Categories of Statutory Subject Matter *MPEP 2106.03*
- Step 2A: Whether a Claim is Directed to a Judicial Exception *MPEP 2106.04*
- Step 2B: Whether a Claim Amounts to Significantly More *MPEP 2106.05*
  - 2106.05(a)-Improvements to the Functioning of a Computer or To Any Other Technology or Technical Field
  - 2106.05(b)-Particular Machine
  - 2106.05(c)-Particular Transformation
  - 2106.05(d)-Well-Understood, Routine, Conventional Activity
  - 2106.05(e)-Other Meaningful Limitations
  - 2106.05(f)-Mere Instructions To Apply An Exception
  - 2106.05(g)-Insignificant Extra-Solution Activity
  - 2106.05(h)-Field of Use and Technological Environment



# Limitations that the courts have found to qualify as “significantly more”

- Improvements to the functioning of a computer *MPEP 2106.05(a)*;
- Improvements to any other technology or technical field *MPEP 2106.05(a)*;
- Applying the judicial exception with, or by use of, a particular machine *MPEP 2106.05(b)*;
- Effecting a transformation or reduction of a particular article to a different state or thing *MPEP 2106.05(c)*;
- Adding a specific limitation other than what is well-understood, routine, conventional activity in the field, or adding unconventional steps that confine the claim to a particular useful application *MPEP 2106.05(d)*; or
- Other meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment *MPEP 2106.05(e)*.

# Limitations that the courts have found not to be enough to qualify as “significantly more”

- Adding the words “apply it” (or an equivalent) with the judicial exception, or mere instructions to implement an abstract idea on a computer *MPEP 2106.05(f)*;
- Simply appending well-understood, routine, conventional activities previously known to the industry, specified at a high level of generality, to the judicial exception *MPEP 2106.05(d)*;
- Adding insignificant extra-solution activity to the judicial exception *MPEP 2106.05(g)*; or
- Generally linking the use of the judicial exception to a particular technological environment or field of use *MPEP 2106.05(h)*.



# Well-Understood, Routine, Conventional Activity

- If the element is not widely prevalent or in common use, it should **not** be considered to be a well-understood, routine, conventional element
- The question of whether additional elements represent well-understood, routine, conventional activity is **distinct from patentability** over the prior art under 35 U.S.C. §§ 102 and 103
  - Obviousness or lack of novelty does not establish that the additional elements are well-understood, routine, conventional activities or elements to those in the relevant field. *See* MPEP 2106.05.



# Revised Examination Procedure in view of *Berkheimer*

- ***Formulating Rejections***: In a step 2B analysis, an additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following four options



# Option 1 – Statement(s) by Applicant

- An explanation based on an express statement in the specification (*e.g.*, citation to a relevant portion of the specification) that demonstrates the well-understood, routine, conventional nature of the additional element(s)
  - A specification demonstrates the well-understood, routine, conventional nature of additional elements when it describes the additional element(s) as conventional (or an equivalent term); as a commercially available product; or, in a way that shows the element is widely prevalent or in common use;

or

- A statement made by an applicant during prosecution, that demonstrates the well-understood, routine, conventional nature of the additional element(s)



# Option 2 – Court Decisions in MPEP § 2106.05(d)(II)

- A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s)
  - The additional element in the claim must be the same as the element addressed in the court case
  - Citation should be limited to the list of cases in the MPEP



# Option 3 – Publication(s)

- A citation to a publication (*e.g.*, book, manual, review article) that demonstrates the well-understood, routine, conventional nature of the additional element(s)
  - An appropriate publication can include a book, manual, review article, or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry
    - Does not include all items that might otherwise qualify as a “printed publication” under § 102
    - Merely finding the additional element in a single patent or published application would not be sufficient to demonstrate that the additional element is well-understood, routine, conventional, *unless* the patent or published application demonstrates that the additional element is widely prevalent or in common use in the relevant field

# Publication Requirements

- Publication must:
  - Be dated on or before the effective filing date of the application, or
  - Establish that the well-understood, routine, conventional nature of the activity is on or before the effective filing date of the application
- Identify the publication in the Office action and on a PTO-892
  - *Practice Tip:* Check patents, PGPubs, and non-patent literature cited by applicant or found in the prior art search first as they will often discuss the state of the art – there should be no need for a separate search



# Option 4 – Official Notice

- A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s)
  - Used **only** when the examiner is certain, based upon his or her personal knowledge, that the additional element(s) represents well-understood, routine, conventional activity engaged in by those in the relevant art, in that the additional elements are widely prevalent or in common use
  - MPEP § 2144.03 discusses taking official notice in the context of making a rejection under 35 U.S.C. § 103
  - If the additional element(s) is well-known, a best practice is to provide a publication before resorting to official notice



# Official Notice Practice Reminders

- Should be used only where facts asserted to be well-known, or to be common knowledge in the art, are capable of instant and unquestionable demonstration as being well-known
  - Must provide specific factual findings predicated on sound technical and scientific reasoning to support the conclusion of common knowledge
  - Identify which element is subject to notice and explicitly explain the basis on which the notice is taken so that the applicant can adequately traverse the finding in the next reply
  - Should be rare when an application is under final rejection
- When properly traversed by the applicant, examiner must provide documentary support
  - Options 1-3 above; or
  - An affidavit or declaration must be provided setting forth specific factual statements and explanation to support the finding. See [37 CFR 1.104\(d\)\(2\)](#)



# ***Reminder: Consider Additional Elements Individually and in Combination***

- Additional elements must be evaluated individually and in combination to determine whether a claim includes significantly more than a judicial exception
- Must also consider the combination of elements
  - To support a rejection of a claim where the examiner takes the position that additional elements A and B are routine, the combination of A and B must be shown to represent well-understood, routine, conventional activity in the pertinent art



# Evaluating Applicant's Response

- If an applicant challenges the examiner's position that the additional element(s) is well-understood, routine, conventional activity by providing arguments and/or evidence:
  - Reevaluate whether it is readily apparent that the additional elements are in actuality well-understood, routine, conventional activities to those who work in the relevant field, and
  - If it is appropriate to maintain the rejection, specifically respond to the arguments and/or evidence as normal in accordance with MPEP 707.07(f)



# Evaluating Applicant's Response to Official Notice

- If the examiner has taken official notice and the applicant properly challenges the examiner's position by specifically pointing out the supposed errors and stating why the noticed fact is not considered common knowledge or well-known in the art
  - Reevaluate whether it is readily apparent that the additional elements are in actuality well-understood, routine, conventional activities to those who work in the relevant field, and
  - Provide one of the items in Options 1-3, or an affidavit or declaration under 37 CFR 1.104(d)(2) setting forth specific factual statements and an explanation that supports the position



# Finality and Applications in Process

- If the examiner cites to a new publication that was not previously of record in response to an argument by applicant, the next Office action may not be made final (except as discussed below)
- If the examiner responds to applicant's argument by relying upon applicant's own specification, a statement made by applicant during prosecution, or prior art already of record, or relies upon a court decision discussed in MPEP § 2106.05(d)(II), it may be appropriate to make the next action final
  - In addition, if the examiner cites a publication to rebut a challenge of official notice and that publication supports the facts taken as official notice, it may be appropriate to make the next action final



# Resources

- MPEP 2106 *et seq* for subject matter eligibility
- Subject Matter Eligibility website
  - <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>
  - Includes guidance documents, example sets, training materials, and information about relevant case law including the *Berkheimer* memorandum
  - Includes links to public comments
  - Any updates will be posted to this page



# Public Comments

- Public comment period is open through August 20, 2018
- Comments may be submitted to:  
[Eligibility2018@uspto.gov](mailto:Eligibility2018@uspto.gov)
- A link to the comments will be posted on the USPTO's Subject Matter Eligibility website



# Let's Chat about Subject Matter Eligibility: Revised Guidance in view of *Berkheimer v. HP, Inc.*

**Robert Bahr**

Deputy Commissioner for Patent Examination Policy

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# **Next Patent Quality Chat**

## **Best Practices Before the Patent Trial and Appeals Board**

June 12, 2018

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# Other Patent Quality-Related Events

<https://www.uspto.gov/about-us/events>

<b>May 9</b>	<b>2018 Big “A” Conference: Small Business Matchmaking</b> (in Alexandria)
<b>May 17</b>	<b>Inventor Info Chat</b> “Prior art and its use in determining patentability” (virtual)
<b>June 13</b>	<b>TC 2800 Circuits Customer Partnership</b> (in Alexandria and via webcast in all USPTO regional offices)

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# Thank you for joining us today!

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