

Practice Tips for USPTO Patent Eligibility Guidelines

The U.S. Patent and Trademark Office released [Revised Patent Subject Matter Eligibility Guidance](#) (PEG) in January 2019, then released an [update](#) (PEG Update) in October 2019 to clarify certain issues in the PEG. The PEG and the PEG Update explain in detail the patent office's revised examination procedures for its subject matter eligibility examination under 35 U.S.C. § 101. Particularly, these guidelines were designed to simplify and focus the examiner's analysis surrounding the ever-expanding caselaw regarding the *Alice/Mayo* test. Although the patent office revised its examination guidance, this does not require that practitioners completely overhaul their approach.

This tip sheet's purpose is to highlight a few areas from the PEG and the PEG Update where practitioners can conform their responses to the patent office's revised guidelines.

1. Interview Your Case and Give the Examiner a Chance to Explain Why the Claim Is Ineligible

An interview gives you an opportunity to understand how the examiner is interpreting the claimed features (e.g., the breadth of the examiner's interpretation), which abstract idea grouping(s) are being applied and why, and to test the reasons why the examiner does not believe that the alleged abstract idea is integrated into a practical application. It also gives the examiner an opportunity to suggest amendments that can help overcome the rejection.

2. Analogize the Claim to the Closest Positive Example

Analogizing your claim to one or more of the claims in [USPTO examples 37-42](#) increases your chances of overcoming the 101 rejection because the examiners are trained on the PEG and PEG Update using these examples as guideposts.

3. In Drafting Claims, Form Sometimes Trumps Substance

Some examiners seem to be going back to the *Bilski* days when form trumped substance, so it is advisable to add hardware to each feature in method claims. This is something that can be discussed with the examiner during an interview with a specific focus on the practical application aspect of the PEG (see Tip 1).

4. Point to the Specification

In the case of a "mathematical concept," use support from the specification and claims to argue that the claims are only based on or involve a mathematical concept and are not limited to a mathematical concept. When an examiner analogizes the claims to the "certain methods of organizing human activity" category, use support from the specification to argue that the activities recited in the claims do not fall within the scope of this category's subgroupings. Remind the examiner that the PEG only lists certain, not all, methods of organizing human activity as ineligible subject matter.

Similarly, when arguing that the claimed features are integrated into a practical application, direct the examiner to portions of the specification that discuss solving a technical problem, and how prior art failed to solve that problem. It is also important to adequately describe the improvements in the specification, and to ensure that the improvement is reflected in the claims.

5. Avoid Overly Broad Claims to Circumvent Mental Process Rejections

Avoid claiming broadly because this allows the examiner, who applies the broadest reasonable interpretation, to construe the claims as capable of being performed in the human mind. Instead, draft the claims to recite specific steps that cannot practically or reasonably be performed in the human mind. Remind the examiner that the test is not whether something could be done in the human mind, given unlimited time and resources, but whether something could be reasonably done in a human mind in a reasonable amount of time.

Takeaway

Examiners are bound by the PEG and the PEG Update, so use the guidance to your advantage. Arguments that find support in the guidance will generally be more persuasive than arguments based exclusively on caselaw.

© 2020 Perkins Coie LLP

Authors



[Sumedha Ahuja](#)

Partner

SAhuja@perkinscoie.com [206.359.8081](tel:206.359.8081)

Explore more in

[Intellectual Property Law](#) [Patent Prosecution & Portfolio Counseling](#)

Related insights

Update

[Coming Soon: Judicial and Agency Interpretations of Washington's Pay Disclosure Law](#)

Update

[October Tip of the Month: U.S. Department of Labor Issues Guidance on AI in the Workplace](#)