Navigating Patent Eligibility Concerns Under New PTO Alice/Mayo Guidance

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Introduction

- Discussing the 2019 Revised Patent Subject Matter Eligibility Guidance
  - Notice announcing this revision to examination procedure and requesting public comments published on January 7, 2019
  - Guidance applies to all applications, and to all patents resulting from applications, filed before, on, or after pushing of the Guidance
  - Written comments on the guidance must be received by March 8, 2019
  - Comments must be sent by electronic mail message over the internet addressed to: Eligibility2019@ uspto.gov
- Also discussing new Examples 37-42 accompanying the Guidance
- These materials are intended to make examination under 101 more clear, consistent, and predictable for applicants

Introduction

- What's new in the guidance?
  - Groupings of subject matter that are considered to be an abstract idea
  - Clarification that a claim is not "directed to" a judicial exception if the judicial exception is integrated into a practical application of that exception
- What's the same?
  - Any claim considered patent eligible under prior guidance should be considered patent eligible under this guidance
  - Failure of USPTO personnel to follow the guidance is not, in itself, a proper basis for either an appeal or a petition

Groupings of Abstract Ideas

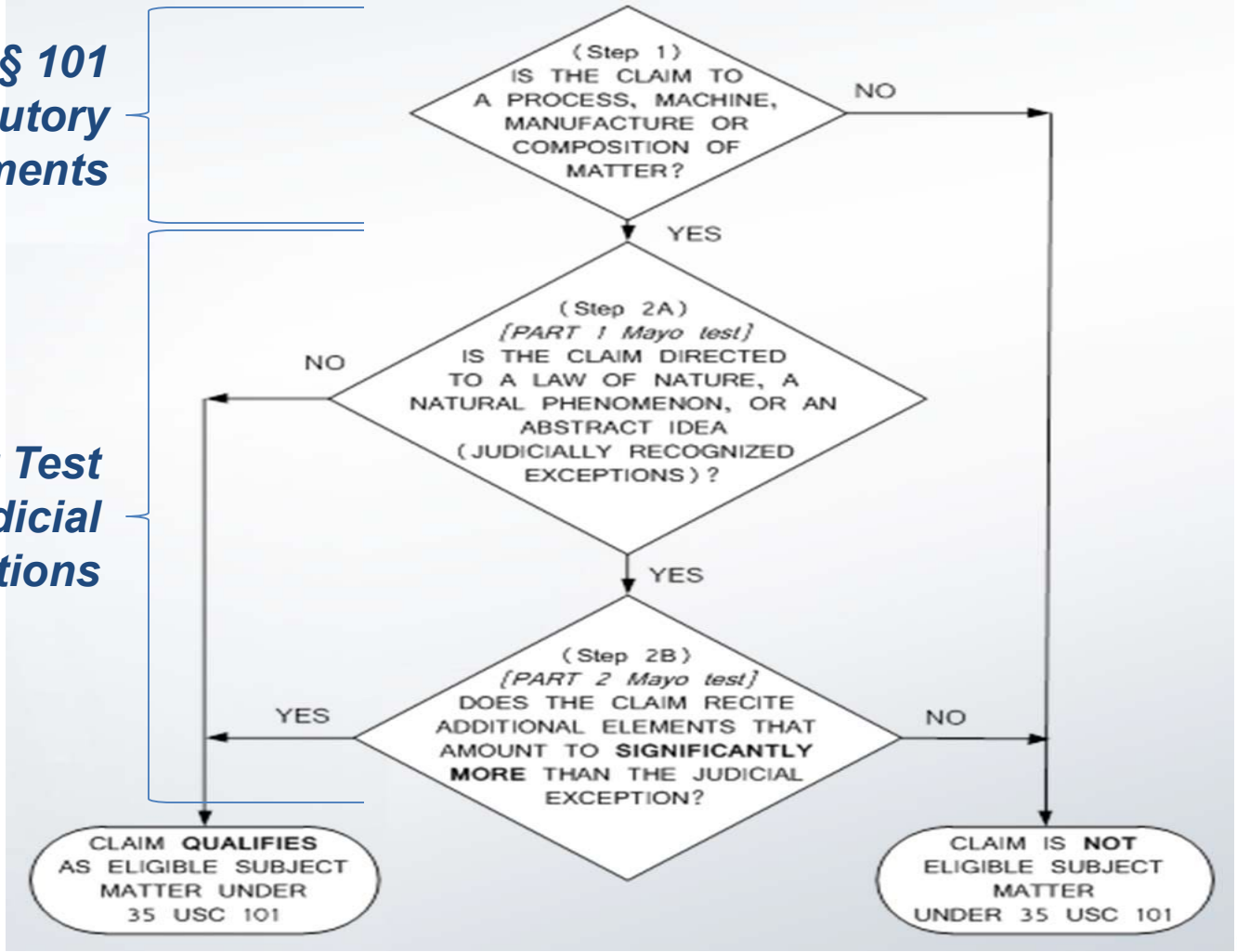
- Revised Groupings:
- (a) **Mathematical concepts** — mathematical relationships, mathematical formulas or equations, mathematical calculations
- (b) **Certain methods of organizing human activity** — fundamental economic principles or practices (including hedging, insurance, mitigating risk); commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations); managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions)
- (c) **Mental processes** — concepts performed in the human mind (including an observation, evaluation, judgment, opinion)

- Also “tentative abstract ideas” in rare cases where USPTO personnel deem it necessary

Two-Part Subject Matter Eligibility Test

35 U.S.C. § 101 / Statutory Requirements

Two-Part Test / Judicial Exceptions



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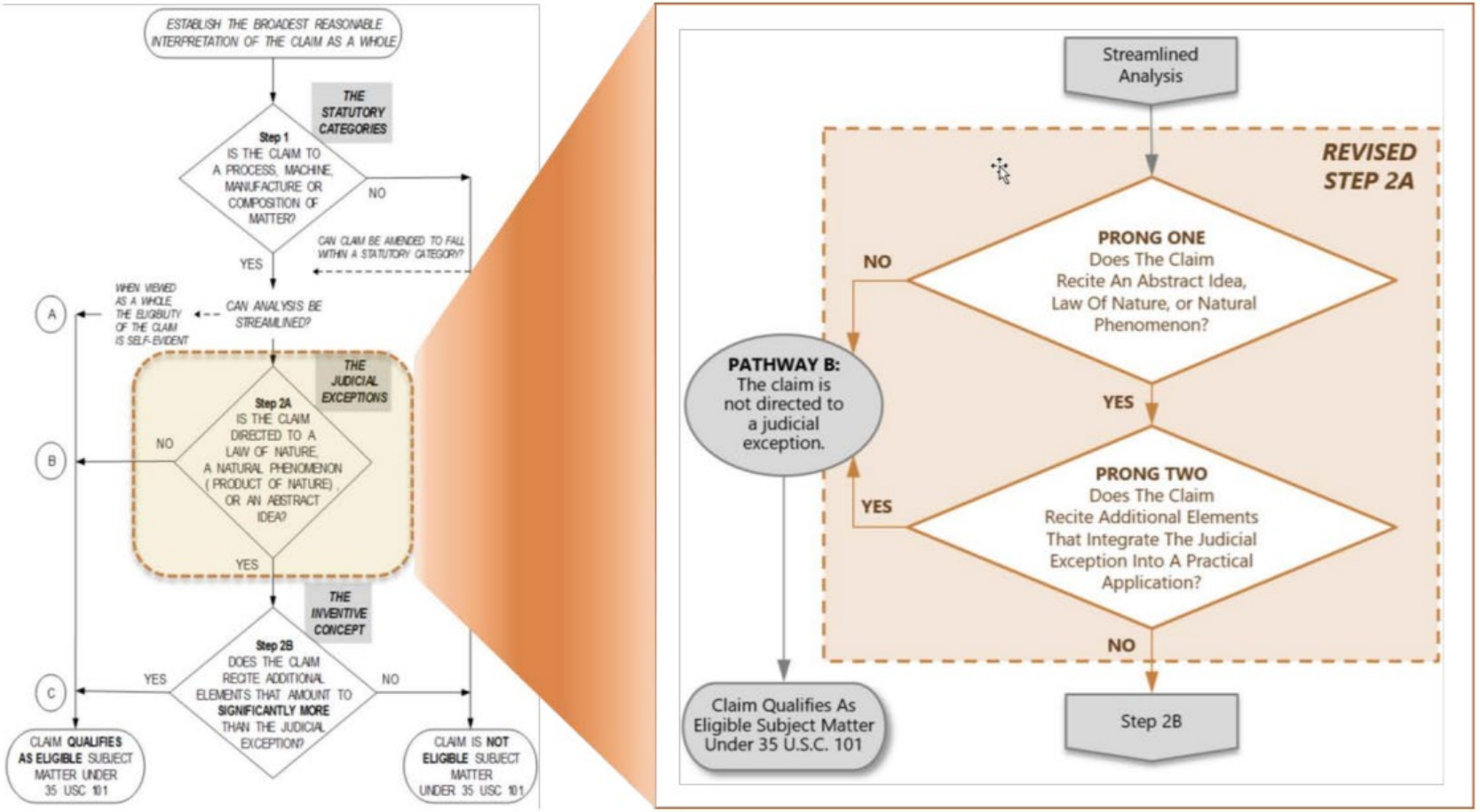
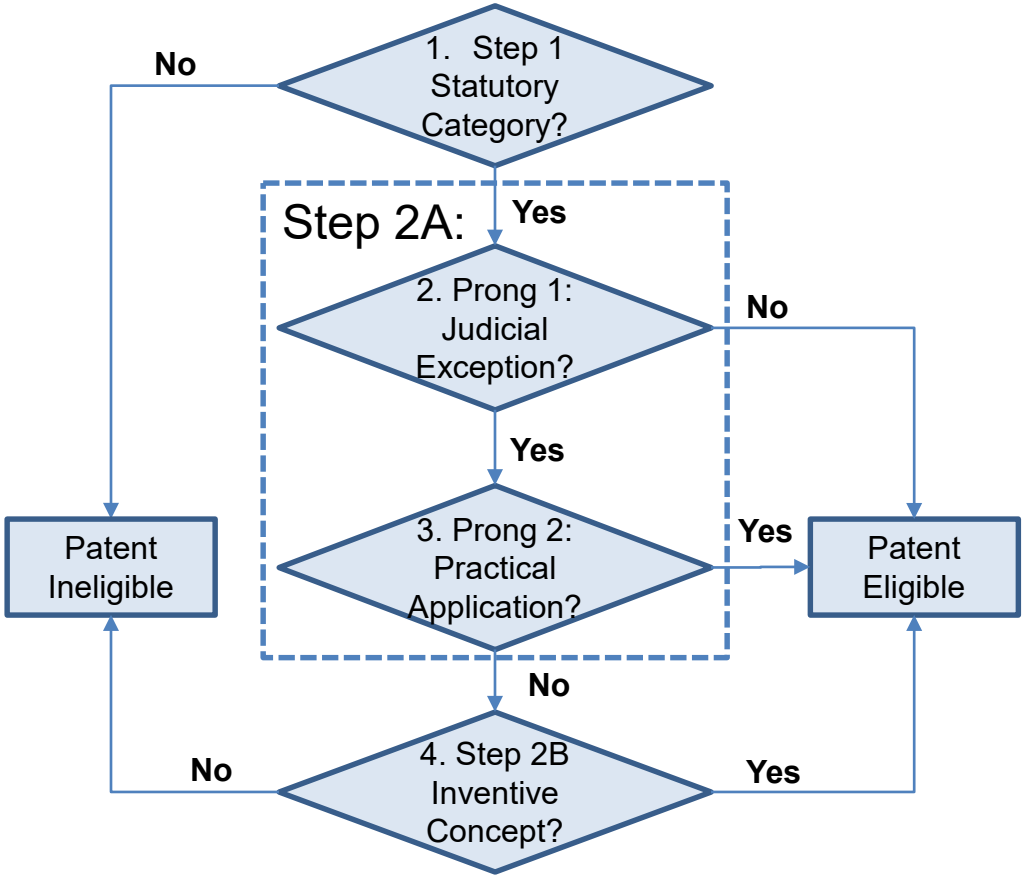
Including Revised Step 2A



Simplified Flow Chart to Include Revised Step 2A



Examination Changes under Prong One

- In Prong One, examiners evaluate whether the claim recites a judicial exception. To determine whether a claim recites an abstract idea in Prong One, examiners are now to:
  - (a) Identify the specific limitation(s) in the claim under examination (individually or in combination) that the examiner believes recites an abstract idea; and
  - (b) determine whether the identified limitation(s) falls within the subject matter groupings of abstract ideas enumerated in Section I of the 2019 Revised Patent Subject Matter Eligibility Guidance.

- Similar to prior guidance except now uses new groupings of abstract ideas

Examination Changes under Prong Two

- In Prong Two, examiners evaluate whether the claim recites additional elements that integrate the exception into a practical application of that exception. This prong adds a more detailed eligibility analysis to step one of the Alice/Mayo test (USPTO Step 2A) than was required under prior guidance.

- A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.

Examination Changes under Prong Two

- Examiners evaluate integration into a practical application by:
  - (a) Identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and
  - (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application

- Revised Step 2A specifically excludes consideration of whether the additional elements represent well-understood, routine, conventional activity. Examiners should ensure that they give weight to all additional elements, whether or not they are conventional.

Examination Changes under Prong Two

- Additional Elements examples:
  - an improvement in the functioning of a computer
  - an improvement to other technology or technical field
  - applies or uses a judicial exception to effect a particular treatment or prophylaxis for a disease or medical condition
  - implements a judicial exception with, or uses a judicial exception in conjunction with, a particular machine or manufacture that is integral to the claim
  - effects a transformation or reduction of a particular article to a different state or thing
  - applies or uses the judicial exception in some other meaningful way beyond generally linking the use of the judicial exception to a particular technological environment, such that the claim as a whole is more than a drafting effort designed to monopolize the exception

Examination Changes under Step 2B

- In Step 2B, examiners determine whether the claim recites additional elements that provide an inventive concept (i.e., whether the additional elements amount to significantly more than the exception itself)

- While many considerations in Step 2A need not be reevaluated in Step 2B, examiners should continue to consider in Step 2B whether the additional elements represent well-understood, routine, conventional activity

- A step could be insignificant extra-solution activity in revised Step 2A, but done in an unconventional way to pass Step 2B

Example 37, Claim 3 - Relocation of icons on a GUI

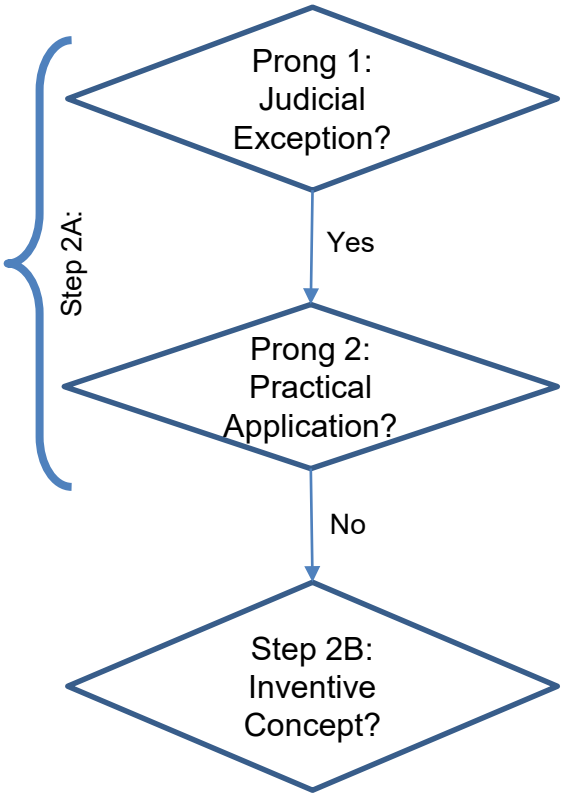
Claim 3:

A method of ranking icons of a computer system, the method comprising:

determining, by a processor, the amount of use of each icon over a predetermined period of time; and

ranking the icons, by the processor, based on the determined amount of use.

Example 37, Claim 3 - Relocation of icons on a GUI



Yes. "Determining the amount of use of each icon over a predefined time," which other than "by a processor", nothing precludes this step from practically being performed manually.

No. Both steps in this claim are recited at a high level of generality and do not integrate the abstract idea into a practical application because it does not impose any meaningful limits on practicing the abstract idea.

No. The additional elements in the claims amount to no more than mere instructions.

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Example 37, Claim 1 - Relocation of icons on a GUI

Claim 1:

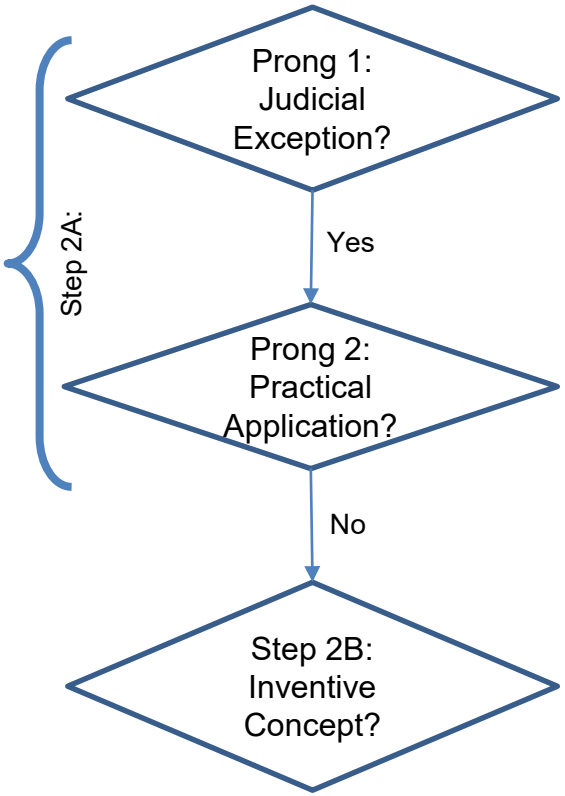
A method of rearranging icons on a graphical user interface (GUI) of a computer system, the method comprising:

receiving, via the GUI, a user selection to organize each icon based on a specific criteria, wherein the specific criteria is an amount of use of each icon;

determining, by a processor, the amount of use of each icon over a predetermined period of time; and

automatically moving the most used icons to a position on the GUI closest to the start icon of the computer system based on the determined amount of use.

Example 37, Claim 1 - Relocation of icons on a GUI



Yes. "Determining the amount of use of each icon over a predefined time," which other than "by a processor", nothing precludes this step from practically being performed manually.

Yes. The claim as a whole integrates mental processes into a practical application of *automatically* displaying icons based on usage, which provides for an improved user interface for electronic devices.

N/A

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Example 37, Claim 2 - Relocation of icons on a GUI

Claim 2:

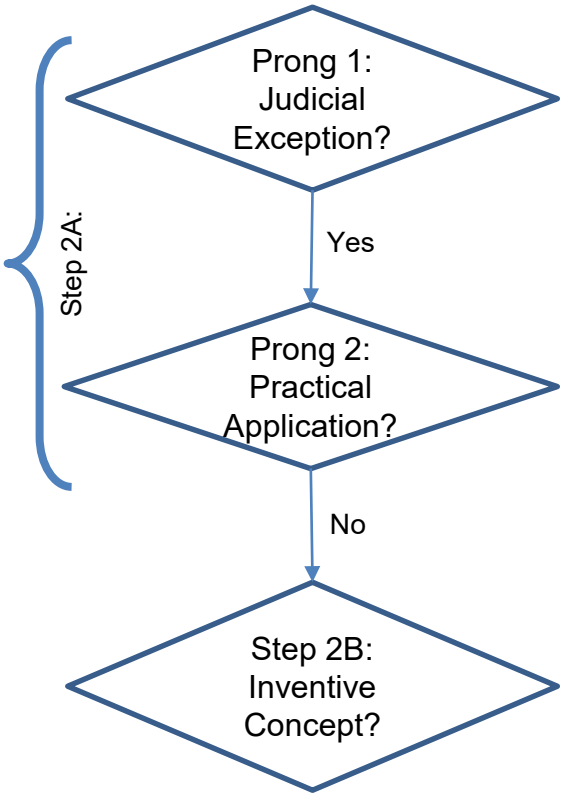
A method of rearranging icons on a graphical user interface (GUI) of a computer system, the method comprising:

receiving, via the GUI, a user selection to organize each icon based on a specific criteria, wherein the specific criteria is an amount of use of each icon;

determining the amount of use of each icon **using a processor that tracks how much memory has been allocated to each application associated with each icon over a predetermined period of time**; and

automatically moving the most used icons to a position on the GUI closest to the start icon of the computer system based on the determined amount of use.

Example 37, Claim 2 - Relocation of icons on a GUI



No. “[U]sing a processor that tracks how much memory has been allocated to each application associated with each icon over a predetermined period of time” is not practically performed in the human mind because it requires a processor accessing computer memory indicative of application storage.

N/A

N/A

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Example 38 – Simulating an analog audio mixer

Claim:

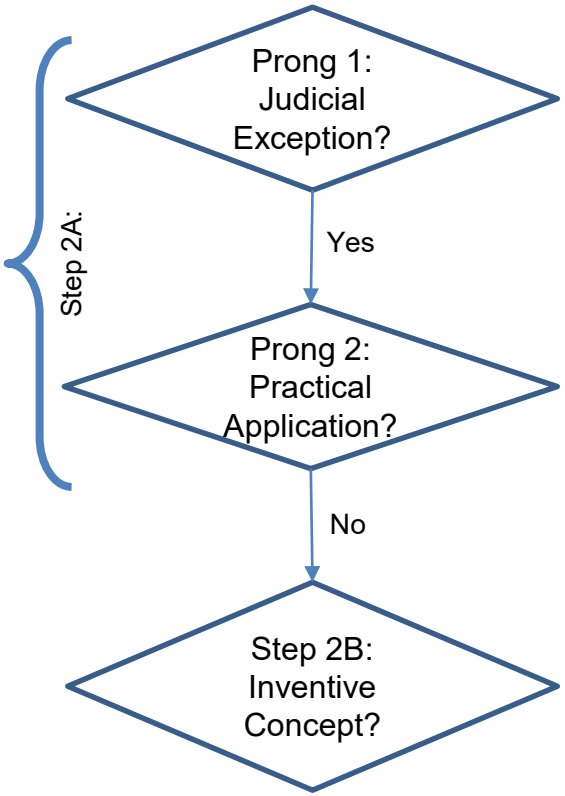
A method for providing a digital computer simulation of an analog audio mixer comprising:

initializing a model of an analog circuit in the digital computer, said model including a location, initial value, and a manufacturing tolerance range for each of the circuit elements within the analog circuit;

generating a normally distributed first random value for each circuit element, using a pseudo random number generator, based on a respective initial value and manufacturing tolerance range; and

simulating a first digital representation of the analog circuit based on the first random value and the location of each circuit element within the analog circuit.

Example 38 – Simulating an analog audio mixer



No. The claim does not recite a mathematical relationship, formula, or calculation. The claim does not recite a mental process because the steps are not *practically performed* in the human mind.

N/A

N/A

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Example 42, Claim 1 – Notifications when medical records are updated

Claim 1:

A method comprising:

a) storing information in a standardized format about a patient's condition in a plurality of network-based non-transitory storage devices having a collection of medical records stored thereon;

b) providing remote access to users over a network so any one of the users can update the information about the patient's condition in the collection of medical records in real time through a graphical user interface, wherein the one of the users provides the updated information in a non-standardized format dependent on the hardware and software platform used by the one of the users;

c) **converting, by a content server, the non-standardized updated information into the standardized format**,

d) storing the standardized updated information about the patient's condition in the collection of medical records **in the standardized format**;

e) automatically generating a message containing the updated information about the patient's condition by the content server whenever updated information has been stored; and

f) **transmitting the message to all of the users over the computer network in real time, so that each user has immediate access to up-to-date patient information**.

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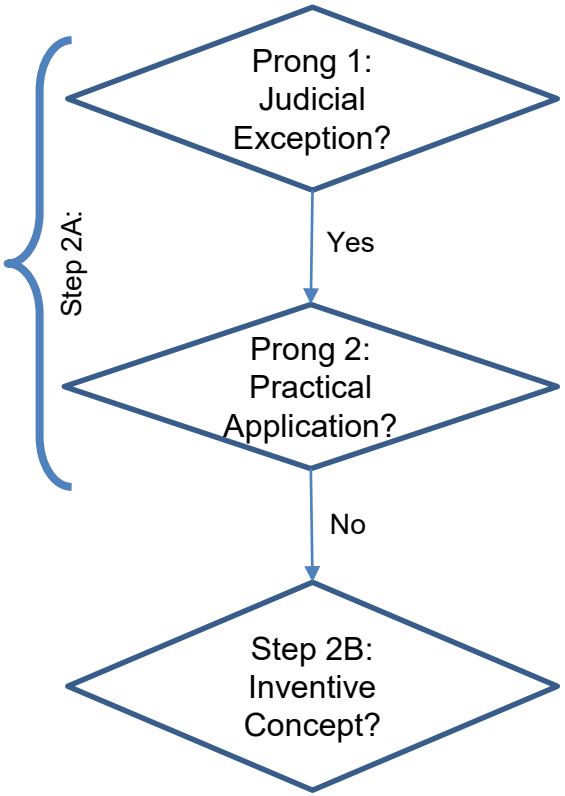
Example 42, Claim 1 – Notifications when medical records are updated



Yes. Claim as a whole recites a method or organizing human activity.

Yes. Allowing remote users to share information in real time *in a standardized format* is a practical application.

N/A

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Example 42, Claim 2 – Notifications when medical records are updated

Claim 2:

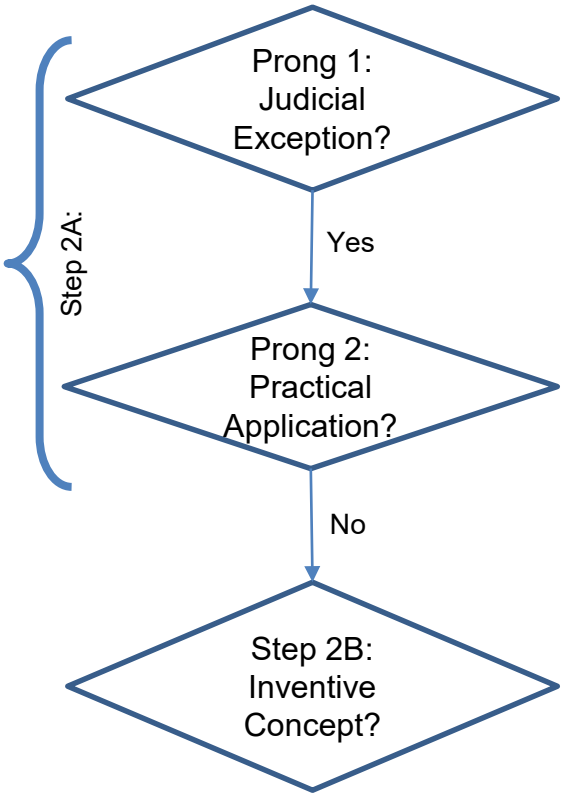
A method comprising:

a) storing information about a patient's condition in a plurality of network-based non-transitory storage devices having a collection of medical records stored thereon;

b) providing access, by a content server, to users so that any one of the users can update the information about the patient's condition in the collection of medical records, and;

c) storing the updated information about the patient's condition in the collection of medical records in the plurality of network-based non-transitory storage devices.

Example 42, Claim 2 – Notifications when medical records are updated



Yes. Claim as a whole recites a method or organizing human activity. The claim is still a method regardless of the nominal recitation of the generic content server and storage device.

No. The steps are recited at a high level of generality and simply store and update patient information.

No. The claims do not impart an inventive concept

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“Practical Application” of all this

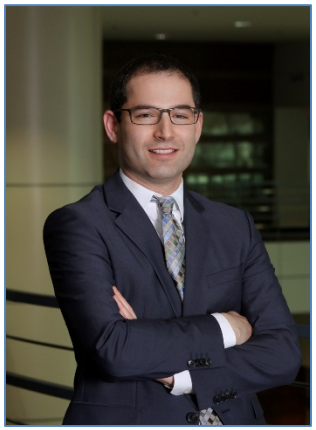
- Step 2A, Prong 1 - Argue not abstract
  - Use technical details in the claim that can’t be done manually
  - State that could not be done in one’s head as a practical matter
- Step 2A, Prong 2 - Argue claims integrate a practical application
  - Accomplish something using a result
  - Improve another technology
  - Improve functioning of the computer
  - Transformation or reduction to different state or thing, etc.
- Step 2B - Argue the claims recite “significantly more”
  - Reference practical application arguments above
  - Here want to focus on elements that are not well-understood, routine, conventional

Final Thoughts

- Big Picture - Consistency / Patent Quality
  - New role for *35 U.S.C § 112* over *35 U.S.C § 101* in addressing "Bad Patents"?

- Effect on Ongoing Prosecution?
  - Scope of Revised Categories
  - Consideration of whether a new rejection is required
  - Appropriateness of "Tentative Abstract Ideas"

Questions?



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