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## Patent office issues new guidance on patentability of software patent applications

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The USPTO recently released revised guidelines on 35 U.S.C. §§ 101 (patentability) and 112 (indefiniteness). The guidelines account for recent developments in case law, particularly around software-based realization and computer-implemented methods but also extend to medicine, robotics, electronics, manufacturing, wearables and networking systems. The issued guidelines further distinguish a “patentable” invention and an “abstract idea” and address the use of functional language in computer-implemented inventions

### Updated guidance for 35 USC § 101

The USPTO will continue to evaluate claims by first determining whether the claims are directed to an abstract idea. If so directed, the USPTO will determine whether the claims amount to significantly more than abstract ideas. The new guidance provides a more detailed eligibility analysis than required under prior guidance.

Examiners will now identify the specific claim limitations that recite an abstract idea and determine whether the identified limitations fall within the subject matter groupings of abstract ideas enumerated in the guidelines. If examiners find that the identified limitations are abstract ideas, the examiners will evaluate integration into a practical application by (i) identifying whether there are any additional elements recited in the claim beyond the judicial exceptions and (ii) evaluating those additional elements individually and in combination to determine whether they integrate the exceptions into a practical application. The Patent Office has explained that this new detailed eligibility analysis will promote early and efficient resolution of patent eligibility and increase certainty and reliability.

The new guidelines also provide examples of additional claim elements that integrate exceptions into practical applications (the second step), including:

- Elements that improve the functioning of a computer or other technology
- Elements that apply a judicial exception to effect a particular treatment for a disease or medical condition
- Elements that implement a judicial exception with a particular machine or manufacture

that is integral to the claim

- Elements that affect a transformation of a particular article to a different state
- Elements that apply the judicial exception in a meaningful way beyond generally linking the judicial exception to a particular technological environment

The guidelines also provide examples of additional claim elements that are not sufficient to integrate exceptions into practical applications, including:

- Elements that merely recite the words “apply it” or an equivalent
- Elements that merely include instructions to implement an abstract idea on a computer or use a computer to perform an abstract idea
- Elements that add insignificant extra-solution activity to the judicial exception
- Elements that do no more than generally link the identified claim elements to a particular technological environment or field of use

Before filing a patent application, we recommend performing a cursory review of the claims and the specification to ensure practical application elements are recited. We have already begun incorporating these guidelines into our practice to draft new patent claims and amend pending claims to overcome the revised eligibility analysis set forth in the guidelines.

### **Updated guidance for 35 USC § 112**

The USPTO also issued guidelines to address the examination of computer-implemented functional language. Claims of software patents often run into problems at the USPTO for claiming purely functional methods without reciting how the claimed function is achieved, in any specificity.

Examiners will now determine whether one of ordinary skill in the art would consider the claim to include sufficiently definite structure for performing the claimed function. If the claims include functional limitations—limitations that define an element in terms of the function it performs—without reciting the structure, materials or acts that perform the function, the examiner will determine whether the claims has proper written description and enablement support in the disclosure of the application.

This new guidance serves as an additional checklist during patent drafting. It will be important to include claims in computer-based patent applications that include non-functional claim elements. It will also be important to draft specifications for computer-based patent applications such that functions are tied to particular components and those components are adequately described so that computer inventions can still be functionally claimed.

### **Conclusion**

The guidelines synthesize case law in a way that is practical for examiners to provide more reliable and predictable results across the USPTO. These new guidelines also provide a framework for responding to claim rejections at the USPTO and drafting better patent claims and specifications.

The full text of the notices can be found online [here](#) (§101) and [here](#) (§112).

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