



THINK FORWARD

USPTO Issues Examination Instructions for Determining Subject Matter Eligibility in View of *Alice Corp. v. CLS Bank*

June 27, 2014

The U.S. Patent and Trademark Office has issued preliminary examination instructions for the Patent Examining Corps to follow when examining claims for compliance with 35 U.S.C. § 101. The instructions are effective as of June 25, 2014, and the USPTO has indicated that additional guidance will be forthcoming after further consideration of the decision and public feedback.

The purpose of the instructions is to implement the principles set forth in the recent Supreme Court decision *Alice Corp. v. CLS Bank* (*'Alice'*). *Alice* held that several patent claims directed to mitigating settlement risk are patent ineligible under § 101. Notably, the instructions state the USPTO's view that "*Alice Corp.* neither creates a *per se* excluded category of subject matter, such as software or business methods, nor imposes any special requirements for eligibility of software or business methods."

The instructions make it clear that examination must adhere to the following two-part framework for all claims:

Part 1 : Determine whether the claim is directed to an abstract idea.

Part 2 : If an abstract idea is present in the claim, determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to **significantly more** than the abstract idea itself.

The instructions provide some guidance on both parts. For Part 1, the instructions provide four examples of abstract ideas (as set forth in *Alice*):

- Fundamental economic practices;
- Certain methods of organizing human activities;
- An "idea of itself"; and
- Mathematical relationships/formulas.

For Part 2, the instructions provide several examples that may qualify as "significantly more":

- Improvements to another technology or technical fields;
- Improvements to the functioning of the computer itself; and
- Meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment.

Examples of limitations that are not enough to qualify as "significantly more" include:

- Adding the words “apply it” (or an equivalent) with an abstract idea, or mere instructions to implement an abstract idea on a computer; and
- Requiring no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.

If the claim lacks 'meaningful' limitations sufficient to demonstrate a patent eligible application of the abstract idea, then the claim should be rejected under § 101.

[Click here to read the Preliminary Examination Instructions.](#)

[Click here to read *Alice*.](#)

If you have any questions about the USPTO’s examination instructions or how they may impact your business, [please contact one of our patent attorneys.](#)