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U.S. Patent and Trademark Office announces revised guidance for determining subject matter eligibility

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Press Release



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CONTACT: (Media Only)

Paul Fucito, Eric Atkisson, or Chris Shipp
(571) 272-8400 or paul.fucito@uspto.gov,
eric.atkisson@uspto.gov, christopher.shipp@uspto.gov

U.S. Patent and Trademark Office announces revised guidance for determining subject matter eligibility

USPTO also announces guidance for the application of Section 112 to computer-implemented inventions

WASHINGTON – The United States Patent and Trademark Office (USPTO) today announced revised guidance for subject matter eligibility under 35 U.S.C. § 101. The USPTO also announced guidance on the application of 35 U.S.C. § 112 to computer-implemented inventions. The documents take effect Monday, January 7, 2019.

“These guidance documents aim to improve the clarity, consistency, and predictability of actions across the USPTO,” said Under Secretary of Commerce for Intellectual Property and Director of the USPTO Andrei Iancu. “The USPTO will provide training to examiners and administrative patent judges on both documents to ensure that guidance is being properly administered.”

The “2019 Revised Patent Subject Matter Eligibility Guidance” makes two primary changes to how patent examiners apply the first step of the U.S. Supreme Court’s *Alice/Mayo* test, which determines whether a claim is “directed to” a judicial exception.

- First, in accordance with judicial precedent and in an effort to improve certainty and reliability, the revised guidance extracts and synthesizes key concepts identified by the courts as abstract ideas to explain that the abstract idea exception includes certain groupings of subject matter: mathematical concepts, certain methods of organizing human activity, and mental processes.
- Second, the revised guidance includes a two-prong inquiry for whether a claim is “directed to” a judicial exception. In the first prong, examiners will evaluate whether the claim recites a judicial exception and if so, proceed to the second prong. In the second prong, examiners evaluate whether the claim recites additional elements that integrate the identified judicial exception into a practical application. If a claim both recites a judicial exception and fails to integrate that exception into a practical application, then the claim is “directed to” a judicial exception. In such a case, further analysis pursuant to the second step of the *Alice/Mayo* test is required.

The “Examining Computer-Implemented Functional Claim Limitations for Compliance with 35 U.S.C. § 112” guidance emphasizes various issues with regard to § 112 analysis, specifically as it relates to computer-implemented inventions. The guidance describes proper application of means-plus-function principles under § 112(f), definiteness under § 112(b), and written description and enablement under § 112(a).

These guidance documents have been issued concurrently to ensure consistent, predictable, and correct application of these principles across the agency.

The USPTO is seeking public comment on all the issues addressed by the two guidance documents. Additionally, we invite the public to submit suggestions to address future guidance supplements as part of their comments. Please submit written comments on these issues to Eligibility2019@uspto.gov on or before March 8, 2019.

The complete text of the revised guidance is published in the Federal Register:

[Section 101 guidance](#)
[Section 112 guidance](#)



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