

USPTO Updates Patent Eligibility Guidance in View of Federal Circuit Berkheimer Opinion

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The U.S. Patent and Trademark Office (USPTO) recently issued a memorandum to its patent examining corps that changes the way examiners should evaluate the question of whether a claim element is “well-understood, routine, conventional” when making a § 101 eligibility determination. The changes outlined in the memo were prompted by the recent Federal Circuit decision in *Berkheimer v. HP, Inc.*, which held the above question is an issue of fact that, if disputed, precludes a finding of subject matter ineligibility at the pleading or summary judgment stages. In the memo, the USPTO provides a new framework for how examiners are to formulate § 101 rejections using Step 2B of the *Alice/Mayo* analysis when a claim element potentially represents well-understood, routine, conventional activity.

The *Berkheimer* case involved patent claims directed to a digital file processing and archiving system. Under *Alice/Mayo* Step 1, the Federal Circuit determined that each of the claims at issue involved abstract ideas. Turning to Step 2, the court noted specifically-articulated improvements in the patent specification—such as reducing redundancy and enabling one-to-many editing—and found that certain dependent claims in the patent were directed to those improvements, raising a genuine issue of material fact as to whether the improvements went beyond well-understood, routine, and conventional activity previously known in the industry. The court also noted that mere disclosure of a feature in the prior art does not mean that the feature is well-understood, routine, and conventional.

In applying *Berkheimer*, the USPTO memo clarifies that claim elements are not well-understood, routine, and conventional unless the examiner finds, and expressly supports a rejection in writing with, one or more of the following:

1. A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine,

conventional nature of the additional element(s);

2. A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s);
3. A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s); or
4. A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s).

The memo notes that, for an examiner to conclude a claim element is well-understood, routine, and conventional, the specification must describe the additional elements as “well-understood or routine or conventional (or an equivalent term), as a commercially available product, or in a manner that indicates that the additional elements are sufficiently well-known that the specification does not need to describe the particulars of such additional elements to satisfy 35 U.S.C. § 112(a).” Also, for a printed publication or the examiner’s personal knowledge to satisfy the inquiry, it must reflect that “the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a).”

The updated guidance contained in the USPTO memo should have a significant impact on when and how examiners rely on a determination that claims are well-understood, routine, and conventional to support a § 101 rejection. In borderline cases—particularly where one or more dependent claims recite elements that embody technical improvements described in the specification—examiners may be less inclined to use this rationale absent clear support under one of the categories described above.

The USPTO memo also highlights the importance of a thorough, technically-rich specification to mitigate potential subject matter eligibility issues during prosecution. For software inventions, applicants would benefit from framing the ‘narrative’ of the subject technology using a technical problem-solution approach, taking care to include as much detail surrounding the technical operation of the system as possible—including physical hardware, networking configurations, encryption techniques, etc. Then, applicants have the ability to draft claims that encompass specific computer-centric improvements articulated in the specification. Such claims would potentially be less susceptible to an *Alice/Mayo* rejection, under the *Berkheimer*-based guidance set forth by the USPTO.

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