

Patentability 101: A Review of the 2019 Guidance and Update on
Subject Matter Eligibility
by Matthew Healey

For nearly a decade, the area of law concerning patent subject matter eligibility has been fraught with turbulence. Patent examiners, district courts, and the Patent Trial and Appeal Board (PTAB) have inconsistently, unreliably, and unpredictably applied the *Mayo/Alice* test provided by the US Supreme Court for determining whether a patent claim recites ineligible subject matter, such as an abstract idea (i.e., (1) whether a claim is directed to a patent eligible concept and (2) if the claim is directed to a patent ineligible concept, whether the claim recites an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept). This has made it difficult for inventors, businesses, and other patent stakeholders to determine what subject matter is patent eligible.

In 2019, the US Patent and Trademark Office (USPTO) provided guidance (the 2019 Revised Patent Subject Matter Eligibility Guidance and the October 2019 Update: Subject Matter Eligibility) to increase the reliability and consistency with which patent examiners and the PTAB judges apply the *Mayo/Alice* framework provided by the Supreme Court. For example, the recent guidance clarifies groupings and sub-groupings for abstract ideas, including mathematical concepts, certain methods of organizing human activity, and mental processes. Furthermore, in assessing whether a claim is “directed to” a judicial exception, the guidance clarifies that examiners must consider (1) whether the claim “recites” a judicial exception and (2) whether the claim integrates the judicial exception into a practical application. A claim “recites” a judicial exception when the claim “describes” or “sets forth” a judicial exception. A claim integrates the judicial exception into a practical application when the claim applies, relies on, or uses 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. For example, a claim that, when considered as a whole, improves the functioning of a computer or other technology is more likely to integrate a judicial exception, if any, into a practical application.

For those involved in filing patents, particularly in software, I strongly encourage you to review the recent 2019 Revised Patent Subject Matter Eligibility Guidance and the October

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2019 Update: Subject Matter Eligibility to gain a better idea of how the USPTO will examine your patent application(s) to assess whether your application is directed to patent-eligible subject matter.