

U.S. Patent Office Issues Interim Examination Instructions
Re: Subject Matter Eligible for Patent Protection

In an effort to address an apparent uncertainty surrounding what constitutes patentable subject matter, the Patent Office has posted new Interim Instructions for Patent Examiners. A court decision addressing the eligibility of subject matter for patent protection is pending by the U.S. Supreme Court in *Bilski v. Kappos*. Accordingly, the Patent Office has issued the new Instructions as suggestive guidelines for Examiners, and clearly notes that any failure to follow the Instructions is “neither appealable nor petitionable.”

The Instructions address a way for patent examiners to determine whether subject matter is eligible for patent protection under 35 U.S.C. §101. Under the statute, patent claims that meet at least one of four categories (i.e., process, machine, manufacture or composition of matter) are eligible for patent protection. There are, however, exceptions to the statute that are based on judicial decisions (the “Judicially Recognized Exceptions”), and include abstract ideas, mental processes or practical uses of laws of nature (“preemption”). The Instructions state that any patent claim that is “wholly directed” to one of these Judicially Recognized Exceptions is not eligible for patent protection and, therefore, should be rejected under 35 U.S.C. §101.

In spite of the Judicially Recognized Exceptions, the Instructions state that a patent claim that is “limited to a particular practical application of a Judicially Recognized Exception” may be eligible for patent protection. The Instructions identify that a “practical application” of an invention is shown when it is applied in “a real world product or a process, and not merely the result achieved by the invention.” Such “real world” products or processes provide evidence that particular subject matter is at least not abstract or purely mental and does not, therefore, fall under one of the Judicially Recognized Exceptions. If subject matter is merely non-functional or descriptive, however, such as “data (e.g., music) stored in a memory,” and has no functional relationship to an underlying structure, then that subject matter would not be eligible for patent protection under the Judicially Recognized Exceptions.

The discussion in the Instructions regarding tangible limitations applies to claims directed to machines, manufactures and compositions of matter. With regard to claims directed to processes, claims “must pass the machine or transformation test,” pursuant to the Court of Appeals for the Federal Circuit holding in *In re Bilski*. In other words, the process must be tied to a particular machine or apparatus, or particularly transform a particular article to a different state or thing. The Patent Office Instructions indicate that this test ensures that a claimed process is limited to a practical application and not merely an abstract idea, a mental process or preempting a law of nature.

It is expected that the Guidelines will be revised after the decision is rendered by the U.S. Supreme Court in *Bilski v. Kappos*.

Click here for a copy of the Interim Guidelines

http://www.ostrolenk.com/clientfiles/Info/2009-08-25_interim_101_instructions.pdf

Click here for a PowerPoint presentation on the Interim Guidelines.

http://www.uspto.gov/web/offices/pac/compexam/interim_101_business_partnership_rev_4-201.ppt