



3510-16-P

DEPARTMENT OF COMMERCE

Patent and Trademark Office

[Docket No. PTO-P-2019-0034]

October 2019 Patent Eligibility Guidance Update

AGENCY: United States Patent and Trademark Office, Department of Commerce.

ACTION: Notice.

SUMMARY: In January 2019, the United States Patent and Trademark Office (USPTO) prepared revised guidance (2019 Patent Eligibility Guidance) for use by USPTO personnel in evaluating subject matter eligibility. The USPTO published the 2019 Patent Eligibility Guidance in the *Federal Register* and sought public comment on the guidance. In view of the comments received in response to the 2019 Patent Eligibility Guidance, the USPTO has produced an update of its 2019 Patent Eligibility Guidance (the October 2019 Patent Eligibility Guidance Update), which is available to the public on the USPTO's website. The October 2019 Patent Eligibility Guidance Update includes a new set of examples as well as a discussion of various issues raised by the public comments. The Update is intended to assist Office personnel in applying the 2019 Patent Eligibility Guidance. The Office continues to welcome public feedback on an ongoing basis on the October 2019 Patent Eligibility Guidance Update or on any patent eligibility issue.

ADDRESSES: Comments must be submitted through the Federal eRulemaking Portal at <https://www.regulations.gov>. To submit comments via www.regulations.gov, enter docket number PTO-P-2019-0034 on the home page and click “search.” The site will provide a search results page listing all documents associated with this docket. Find a

reference to this notice and click on the “Comment Now!” icon, complete the required fields, and enter or attach your comments. Attachments to electronic comments will be accepted in ADOBE® portable document format or MICROSOFT WORD® format. Because comments will be made available for public inspection, information that the submitter does not desire to make public, such as an address or phone number, should not be included in the comments.

FOR FURTHER INFORMATION CONTACT: Carolyn Kosowski, at 571-272-7688, Matthew Sked, at 571-272-7627, or June Cohan, at 571-272-7744, all Senior Legal Advisors at the Office of Patent Legal Administration.

SUPPLEMENTARY INFORMATION: The USPTO prepared the 2019 Patent Eligibility Guidance for use by USPTO personnel in determining subject matter eligibility under 35 U.S.C. 101. The USPTO published the 2019 Patent Eligibility Guidance in the Federal Register on January 7, 2019, and sought public comment on the guidance. *See 2019 Revised Patent Subject Matter Eligibility Guidance*, 84 FR 50 (Jan. 7, 2019).

The USPTO received numerous comments from the public. The public comments include requests for further explanation of the following five major themes: (1) evaluation of whether a claim recites a judicial exception; (2) the groupings of abstract ideas enumerated in the 2019 Patent Eligibility Guidance; (3) evaluation of whether a judicial exception is integrated into a practical application; (4) the *prima facie* case and the role of evidence with respect to eligibility rejections; and (5) the application of the 2019 Patent Eligibility Guidance in the patent examining corps.

The USPTO has now produced the October 2019 Patent Eligibility Guidance Update responding to each of the major themes from the public comments. The October 2019 Patent Eligibility Guidance Update also includes three appendices. The first appendix (Appendix 1) provides new examples that are illustrative of major themes from the comments. The second appendix (Appendix 2) is a comprehensive index of examples for use with the 2019 Patent Eligibility Guidance, including examples issued prior to the publication of the 2019 Patent Eligibility Guidance. The third appendix (Appendix 3) lists and discusses selected eligibility cases from the Supreme Court and the U.S. Court of Appeals for the Federal Circuit.

The October 2019 Patent Eligibility Guidance Update, including the appendices, is available to the public on the USPTO's website (<https://www.uspto.gov/PatentEligibility>). Feedback on the October 2019 Patent Eligibility Guidance Update or on any patent eligibility issue is welcome on an ongoing basis. Instructions for submitting feedback are provided in the Addresses section of this notice.

Dated: October 11, 2019.

Andrei Iancu,

Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office.

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