

UNITED STATES
PATENT AND TRADEMARK OFFICE



Subject Matter Eligibility: *Guidance & Examination Resources*

Robert Bahr

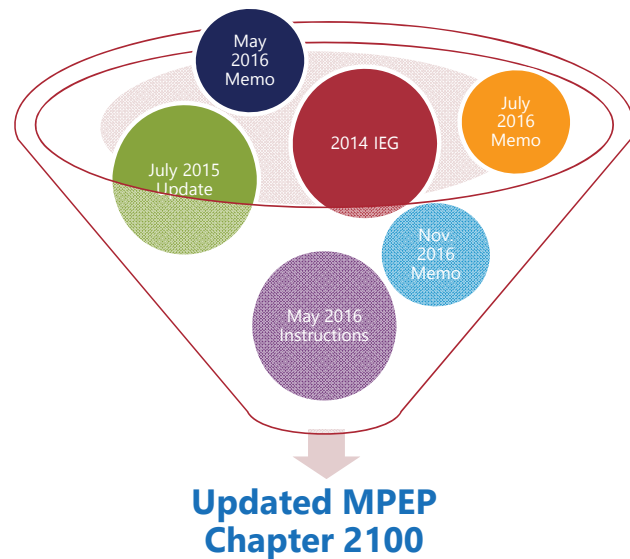
Deputy Commissioner for Patent Examination Policy

March 2018



Eligibility Guidance Is Now In the MPEP

- The MPEP has been updated to incorporate the 2014 Interim Eligibility Guidance (IEG) and its updates
- MPEP now replaces the IEG and updates (as of August 2017)



MPEP Organization

- Eligibility guidance is located in Chapter 2100
 - **2103** discusses how the eligibility analysis fits into the overall patent examination process
 - **2104** discusses the requirements of 35 U.S.C. § 101
 - **2105** discusses patentability of living subject matter
 - **2106 and its subparts** discuss the subject matter eligibility analysis
- Additional information is located in Chapter 700
 - **706.03** and **706.03(a)** discuss subject matter eligibility rejections, and provide appropriate form paragraphs

MPEP WALK-THROUGH

The Eligibility Analysis

- MPEP **2106** discusses the eligibility analysis
 - I. Explains the two criteria for subject matter eligibility: the claimed invention must be to a statutory category (Step 1) and qualify as patent-eligible subject matter (Step 2 aka the *Alice/Mayo* test)
 - II. Stresses the importance of establishing the broadest reasonable interpretation (BRI) of the claim prior to the eligibility analysis
 - III. Provides guidance on the analysis as a whole and introduces the flowchart

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Subject Matter Eligibility: Guidance & Examination Resources

Also available as part of the eCourse

[2018 Advanced Patent Law \(USPTO\) eConference](#)

First appeared as part of the conference materials for the
13th Annual Advanced Patent Law Institute session
"Section 101: Software and High Tech"