



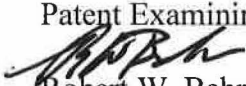
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MEMORANDUM

DATE: April 2, 2018

TO: Patent Examining Corps

FROM: 
Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy

SUBJECT: Recent Subject Matter Eligibility Decisions

The most recent revision of the MPEP¹ was published on January 29, 2018 (the January 2018 MPEP Publication), and is current as of August 31, 2017. The January 2018 MPEP Publication incorporates the case law and guidance relating to patent subject matter eligibility under 35 U.S.C. § 101 as of August 31, 2017 into MPEP §§ 2106 through 2106.07. This memorandum discusses subject matter eligibility case law developments since August 31, 2017 through January of 2018.

The U.S. Court of Appeals for the Federal Circuit (Federal Circuit) recently issued two precedential decisions finding claims to software-related inventions patent eligible under 35 U.S.C. § 101 because they are not directed to an abstract idea. These cases are consistent with a growing body of case law, including *Enfish* and *McRO*, confirming that software-based innovations can make “non-abstract improvements to computer technology” and be deemed patent-eligible subject matter at the first step of the *Alice/Mayo* analysis (Step 2A in the Office’s subject matter eligibility guidance, see MPEP § 2106.04 *et seq.*).

In *Finjan Inc. v. Blue Coat Systems, Inc.*, 879 F.3d 1299 (Fed. Cir. 2018), the claimed invention involves a method of virus scanning that scans an application program, generates a security profile identifying any potentially suspicious code in the program, and links the security profile to the application program. The claims were held patent eligible because the court concluded that the claimed method recites specific steps that accomplish a result that realizes an improvement in computer functionality. In particular, the method generates a security profile that identifies both hostile and potentially hostile operations, and can protect the user against both previously unknown viruses and “obfuscated code.” This is an improvement over traditional virus scanning, which only recognized the presence of previously-identified viruses.

¹ The January 2018 Publication of Revision 08.2017 of the Ninth Edition of the MPEP.

The method also enables more flexible virus filtering and greater user customization. The invention in *Finjan* was found by the district court to be similar to the hypothetical claim published by the Office as Abstract Idea Example 1 (eligible).

In *Core Wireless Licensing S.A.R.L., v. LG Electronics, Inc.*, 880 F.3d 1356 (Fed. Cir. 2018), the claimed invention involves a graphical user interface (GUI) for mobile devices that displays an application summary of each application on the main menu while those applications are in an unlaunched state. The claims to computing devices were held patent eligible because the court concluded that they are directed to an improved user interface for electronic devices, not to the abstract idea of an index. In particular, the claims contain precise language delimiting the type of data to be displayed and how to display it, thus improving upon conventional user interfaces to increase the efficiency of using mobile devices. Finding the claims eligible, the court compared the improved user interface in the patent claims to the improved systems claimed in *Enfish*, *Thales*, *Visual Memory*, and *Finjan*.

These two decisions demonstrate that a claim reciting a software-related invention focused on improving computer technology may not be directed to an abstract idea. The Office's current subject matter eligibility guidance is consistent with these decisions.

The Federal Circuit has also issued several precedential decisions finding claims to be ineligible as directed to an abstract idea without including an inventive concept (see MPEP § 2106.05) in the claim. *Inventor Holdings, LLC v. Bed Bath & Beyond, Inc.*, 876 F.3d 1372 (Fed. Cir. 2017) (local processing of payments for remotely purchased goods); *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329 (Fed. Cir. 2017) (sending, directing, monitoring receipt of, and accumulating records about information; monitoring delivery of real-time information to users; measuring delivery of real-time information for commercial purposes); *Smart Systems Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364 (Fed. Cir. 2017) (collection, storage, and recognition of data related to financial transactions for a mass transit system); *Secured Mail Solutions LLC v. Universal Wilde, Inc.*, 873 F.3d 905 (Fed. Cir. 2017) (using a marking affixed to the outside of a mail object to communicate information about the mail object). These decisions are referenced in the Chart of Subject Matter Eligibility Decisions and Eligibility Quick Reference Sheet (each updated monthly), which are available on the USPTO [Subject Matter Eligibility webpage](#).

Examiners should continue to assess patent eligibility in view of the current subject matter eligibility guidance, which has now been integrated into the recently released revision of the MPEP, particularly MPEP § 2106. See MPEP § 2106.04(a)(1) for abstract ideas and MPEP § 2106.06(b) for improvements to computer functionality.