

## Berkheimer v HP Inc. Decision Leads to USPTO Update for Alice Step 2B



### Update for Alice Step 2B

- Examiner must now “expressly support a rejection” with one or more of 4 new methods listed
- This places a heavier burden on the Examiner to support and Alice 2B rejection

The USPTO issued a memorandum on April 19, 2018 further clarifying the continually evolving USPTO subject matter eligibility guidance, addressing an update to the procedure in evaluating step 2B of the eligibility guidance, i.e. step 2 of the Alice/Mayo test. Specifically, the memo outlines the manner in which an examiner can identify an element, or combination of additional elements, recited in a given patent claim, as well-understood, routine, and conventional activity. The memo is based on the February 2018 decision for *Berkheimer v HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), wherein the *Berkheimer* Court clarified that “whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination. Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood routine, and conventional”.

The *Berkheimer* decision, upheld by two subsequent Federal Circuit decisions, noted that although determining subject matter eligibility for a claim is a question of law, there can be “underlying facts” to be considered before making such a determination. *Id.* at 1369. As such, in *Berkheimer*, the Court held that the specification for the patent at issue describes a purported improvement in the respective system efficiency, thereby creating a “genuine issue of material fact” of whether the claims disclosing said improvement “perform well-understood, routine, and conventional activities to a skilled artisan”.

Currently, MPEP §2106 outlines the subject matter eligibility guidance, including details in evaluating the 2-part Alice/Mayo test. Though the “basic subject matter eligibility framework set forth in MPEP 2106” is not impacted by *Berkheimer*, it provides clarification regarding the basis that an examiner must rely to conclude an element, or combination of elements, of a claim, represent well-understood, routine, conventional activity as described in MPEP 2106.05(d). More specifically, the memo indicates the revisions to the procedures listed in MPEP 2106.07 (a), formulating a rejection for lack of subject matter eligibility, which currently indicates that the “rejection should explain why the courts have recognized, or those in the relevant field of art would recognize, those claim limitations as being well-understood, routine, conventional activities”. Instead, the memo indicates that an element, or combination of elements, as evaluated in an Alice step 2B analysis “is not well-understood, routine or conventional unless the examiner finds, and expressly supports a rejection” with one or more of the four methods listed. This places a heavier burden of proof on the examiner to support an Alice 2B rejection on such a basis.

The four methods listed in the memo are as follows:

- 1) “A citation to an express statement in the specification or to a statement made by an applicant during prosecution that demonstrates the well-understood, routine, conventional nature of the additional element(s).” Moreover, the memo indicates that an element, or combination of elements cannot be determined to be well-understood, routine or conventional based solely on the fact that the specification is silent to describing such element(s).
- 2) “A citation to one or more of the court decisions discussed in MPEP § 2106.05(d)(II) as noting the well-understood, routine, conventional nature of the additional element(s).
- 3) “A citation to a publication that demonstrates the well-understood, routine, conventional nature of the additional element(s). An appropriate publication could include a book, manual, review article, or other source that describes the state of the art and discusses what is well-known and in common use in the relevant industry.” The memo further describes that the publication may not include all “printed publications” as used in 35 U.S.C. 102, citing an example that an element described in a single copy of a “printed publication” located in a library may not be considered as well-understood, routine and conventional even though it is still a “printed publication”. Moreover, “the nature of the publication and the description of the additional elements in the publication would need to demonstrate that the additional elements are widely prevalent or in common use in the relevant field, comparable to the types of activity or elements that are so well-known that they do not need to be described in detail in a patent application to satisfy 35 U.S.C. § 112(a)”. Additionally, as held by the *Berkheimer* court, merely discovering an element in a prior art publication does not necessarily indicate the element is well-understood, routine, or conventional, unless as the memo indicates, the prior art publication “demonstrates that the additional element are widely prevalent or in common use in the relevant field”.
- 4) “A statement that the examiner is taking official notice of the well-understood, routine, conventional nature of the additional element(s)”. The memo clarifies that this method is only applicable when the examiner is certain based on his or her personal knowledge that the additional elements are well-understood, routine, or conventional. Moreover, the memo indicates an update to MPEP 2106.07(b), evaluating applicant’s response, wherein an applicant challenging the examiner’s official notice will require the examiner to prove the element(s) are well-understood, routine, or conventional by either satisfying one of the three aforementioned methods, or providing “an affidavit or declaration under 37 CFR 1.104(d)(2) setting forth specific factual statements and explanation to support his or her position”.

All in all, although a larger burden of proof is imposed on the examiners, the revised procedures outlined in the memo provide for a more defined manner in rejecting claims due to one or more elements being well-understood, routine, or conventional, which should make it easier for the applicant in understanding the basis of such rejections.



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