



From left to right: Alexandra B. Urban, The Honorable Michael R. Fleming

**Summary of NYIPLA CLE Program (Feb. 24, 2006)**

On Friday, February 24, 2006, the NYIPLA Committees on Meetings and Forums and Continuing Legal Education co-sponsored a CLE Luncheon Program at the Columbia/Princeton Club on the topic of the Interim Guidelines for Examination of Patent Applications for Subject Matter Eligibility, which were issued on October 24, 2005 and can be found online at [http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101\\_20051026.pdf](http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf).

The Honorable Michael R. Fleming, Chief Administrative Patent Judge of the Board of Patent Appeals and Interferences at the U.S. Patent and Trademark Office, was the honored speaker. Judge Fleming is the recipient of numerous awards and distinctions, including the U.S. Department of Commerce Gold Medal for his role in creating the USPTO's Examination

Guidelines for Computer Related Inventions in 1996. Alexandra B. Urban, Esq. of MeadWestvaco Corporation hosted the CLE Program.

Judge Fleming outlined the step-by-step analysis of patent applications to determine eligibility under 35 U.S.C. § 101 for patentable subject matter. He noted that before focusing on specific statutory requirements, examiners must determine what the applicant has invented and is seeking to patent by reviewing the entire specification, and must conduct a thorough search of the prior art. Once the examiner has determined what the invention is, and can identify and understand any utility and/or practical application for the invention, he should next consider the breadth of 35 U.S.C. § 101 and determine whether the claimed invention falls within one of the four enumerated categories of patentable subject matter (process, machine, manufacture or composition of matter).

According to the new Guidelines, even if the examiner can establish a prima facie case that a claim does not fall into a statutory category, the examiner must continue with the analysis by determining whether the claimed invention falls within one of the three judicially determined exceptions (abstract ideas, laws of nature, natural phenomena). The claim must be considered as a whole, so that the examiner can ascertain whether the claim is directed to one of the exceptions, or to a practical application of the exception, and may thus be eligible for patent protection. A claim that otherwise falls into a judicial exception of patentability may be rendered patentable “if the claimed invention transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.”

Judge Fleming gave examples of what would constitute a practical application by physical transformation, and he explained what is meant by “useful, tangible and concrete result.” He noted that the examiner must further consider whether the claimed invention

preempts one of the judicial exceptions (i.e., covers every substantial practical application thereof), and gave examples of such preemption.

The new Guidelines follow the release in September 2005 of a precedential decision by the BPAI, *Ex parte Lundgren* (Appeal No. 2003-2088, Application No. 08/093,516, available online at <http://www.uspto.gov/go/dcom/bpai/prec/2003-2088.pdf>), in which the Board held that there is no judicially recognized “technological arts” test to determine patent eligibility of subject matter under § 101 and that there are no other recognized exceptions to patentable subject matter other than ideas, laws of nature and natural phenomena. Judge Fleming noted that in addition to the “technological arts” test, the new Guidelines also instruct the Examiners not to apply the *Freeman-Walter-Abele* test, the mental step or human step test, the machine implemented test or the *per se* data transformation test. The new Guidelines confirm that the practical application test broadly defines which subject matter is eligible for patent protection and is the only test that will be used by the USPTO. The CLE Program was attended by 65 guests and concluded with a lively question and answer session.