



## AMSTER, ROTHSTEIN & EBENSTEIN LLP PATENT LAW ALERT

### U.S. PATENT AND TRADEMARK OFFICE PROPOSES NEW INTERIM GUIDELINES FOR DETERMINING PATENT ELIGIBILITY IN LIGHT OF *BILSKI V. KAPPOS*

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(July 28, 2010) On July 27, 2010, the U.S. Patent and Trademark Office (“PTO”) published for notice and comment Interim Guidelines for Determining Subject Matter Eligibility for Process Claims, 75 Fed. Reg. 43922 (July 27, 2010), in view of the Supreme Court’s decision in *Bilski v. Kappos*, 130 S. Ct. 3218 (2010). The comment deadline has been set for September 27, 2010. Any comments should be submitted to [Bilski-Guidance@uspto.gov](mailto:Bilski-Guidance@uspto.gov) or by mail or fax to (571) 273-0125.

Under the proposed Guidelines, the PTO sets forth a series of factors that can be considered and weighed to determine patent eligibility. While recognizing that the machine-or-transformation test is not the only test for determining patent eligibility, the rules recognize that it is “a useful and important clue” and “investigative tool” that should be considered.

The Guidelines continue to recognize that patent eligibility of each patent claim should be considered as a whole, and caution against using Section 101 rejections as a gatekeeper to avoid analyzing claims under other statutory prerequisites, e.g., 102, 103, 112, etc.

While recognizing that the proposed list of factors were not exhaustive and no factor in itself was determinative, the PTO’s Guidelines provide useful insight into how the PTO expects Examiners to draw the fuzzy line between claims directed to abstract ideas or natural phenomena which are excluded subject matter, and claims directed to practical applications which are not.

Look for additional publications on patent eligible subject matter after *Bilski* at our firm website at [www.arelaw.com](http://www.arelaw.com).

More information on the new interim guidelines can be accessed here:

[http://www.uspto.gov/patents/announce/bilski\\_guidance.jsp](http://www.uspto.gov/patents/announce/bilski_guidance.jsp)

A digital copy of the guidelines can be accessed here:

[http://www.uspto.gov/patents/law/exam/bilski\\_guidance\\_27jul2010.pdf](http://www.uspto.gov/patents/law/exam/bilski_guidance_27jul2010.pdf)

Please feel free to **contact us** to learn more about this decision and its impact on U.S. Design Patent law.

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