

FACTUAL EVIDENCE NOW REQUIRED TO SUPPORT SUBJECT MATTER ELIGIBILITY REJECTIONS

On April 19, 2018, the USPTO issued a memorandum on Subject Matter Eligibility in view of *Berkheimer v. HP, Inc.*, 881 F.3d 1360 (Fed. Cir. 2018). In *Berkheimer*, the Federal Circuit found that whether a claim element or combination of elements is well-understood, routine, and conventional to a skilled artisan in the relevant field is a question of fact. *Id.* at 1367-68. The Federal Circuit further cautioned that the mere fact that something is disclosed in a piece of prior art does not mean it was a well-understood, routine, and conventional activity or element. *Id.* at 1369.

The April 19 Memo sets forth additional requirements that must now be met by an Examiner when alleging that a claimed feature or combination of features is well-understood, routine, and conventional to a skilled artisan in the relevant field. In particular, the Examiner must now find and expressly support a rejection in writing with one or more of the following:

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, and conventional nature of the additional 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, and conventional nature of the additional element(s).
3. A citation to a publication that demonstrates the well-understood, routine, and conventional nature of the additional element(s). This 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).
4. A statement that the examiner is taking official notice of the well-understood, routine, and conventional nature of the additional element(s). This taking of Official Notice may be challenged by the Applicant, requiring the Examiner to provide factual support based on one or more of paragraphs 1-3 above or an affidavit or declaration under 37 CFR 1.104(d)(2).

These new requirements finally provide applicants with the opportunity to effectively challenge Examiner allegations that claimed features are well-understood, routine, and conventional to a skilled artisan in the relevant field by attacking the factual basis underlying these allegations.