

THE MASTER REVIEW FORM PROVIDES INSIGHT INTO HOW THE U.S. PATENT & TRADEMARK OFFICE TREATS ELIGIBLE SUBJECT MATTER REJECTIONS UNDER § 101

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INTRODUCTION

On February 9, 2018, the United States Patent and Trademark Office ("USPTO") held its first Chicago Regional Seminar, hosted by Northwestern University Pritzker School of Law. Stefanos Karmis, the Acting Director of the Office of Patent Quality Assurance, participated in several of the panels and discussed ongoing patent quality initiatives at the USPTO. Many of those panel discussions centered on the Master Review Form, [1] especially a "Patent Quality Review" segment on patent subject matter eligibility under 35 U.S.C. § 101. Practitioners and applicants should go through the Master Review Form because it sets forth how the USPTO evaluates a subject matter eligibility rejection under 35 U.S.C. § 101.

THE MASTER REVIEW FORM

The Master Review Form was established by a 2016 Federal Register Notice. [2] It is a standard checklist used by reviewers from the Office of Patent Quality Assurance [3] who randomly sample Office Actions from each stage of examination and analyze them for improper rejections and failures to make statutorily required rejections. [4] The Master Review Form contains criteria for recording correctness for each substantive patentability requirement, as well as criteria for the clarity and rationale of each rejection in an Office Action. [5] In the seminar, Mr. Karmis commented that the Master Review Form has undergone minor revisions since its introduction, and the Office of Patent Quality Assurance is continuing to review the checklist. The current version of the Master Review Form (version 3.01) was issued on June 15, 2017. Regarding patent eligibility under 35 U.S.C. § 101, the current version of the Master Review Form has three sections: the basis for the rejection, the correctness of the rejection, and the clarity of the rejection. [6]

Regarding the basis for the rejection, the Master Review Form presents options from which the category of ineligible subject matter can be selected by the reviewer: "Transitory signal," "Software per se," "Human Organism," "Law of Nature," "Natural Phenomenon," "Product of Nature," "Abstract Idea (e.g., fundamental economic practices, certain methods of organizing human activities, idea itself (standing alone), or mathematical relationships/formulas)." [7]

Under the section for correctness of a rejection made by the examiner, the reviewer determines whether the rejection to be "in compliance" and furthermore whether "the claim interpretation appear[s] to be reasonable." [8] Each of these two inquiries has answer options of "Yes," "In-Part," or "No." [9]

Under the section for clarity of the rejection made by the examiner, each characteristic has answer options for the reviewer to select from, namely "Above Average," "Average," or "Below Average." [10] The current version of the Master Review Form includes clarity criteria for an eligibility rejection based on a judicial exception. These criteria are "[t]he judicial exception was identified," "[t]he rejection identified specific claim(s) and its limitation(s) that recite(s) the judicial exception," "[t]here was an explanation as to why it is a judicial exception," "[a]ny additional elements were identified," "[t]here was an explanation as to why any additional elements, if present, are not significantly more," and "[i]f the judicial exception was a product of nature, there was an explanation as to why it does not include markedly different characteristics." [11] Notably, the section on clarity concludes with "[t]he Office action contained clear suggestions to overcome the rejection," [12] which suggests that examiners are encouraged by the USPTO to identify possible claim amendments that advance prosecution.

In the Chicago Regional Seminar, Mr. Karmis was asked whether "analysis of the claim as a whole" should be added as a criteria for correctness to the Master Review Form in view of recent case law. Mr. Karmis reiterated that the Master Review Form is being continually updated and revised by the Office of Patent Quality Assurance.

SIGNIFICANCE OF THE MASTER REVIEW FORM FOR PRACTITIONERS AND APPLICANTS

Although the Master Review Form does not have the force of law, it provides insight into the USPTO's criteria for subject matter eligibility rejections under 35 U.S.C. § 101. Furthermore, practitioners and applicants may use these criteria to identify factual or legal deficiencies in such rejections. For example, an applicant's arguments specifically identifying aspects of such a rejection as deficient based on the criteria set forth in the Master Review Form may be persuasive to an examiner. Such criteria include a reasonable claim interpretation, whether the characterization of the subject matter as a judicial exception was explained, whether additional elements in the claim were identified, and whether the characterization of any additional elements as not significantly more was explained. In addition, if the examiner has not provided any clear suggestions to overcome the eligibility rejection, a telephone interview with the examiner may ascertain such amendments.

Moreover, monitoring the Master Review Form to identify revisions therein by the Office of Patent Quality Assurance may identify changes in the analytical framework applied by examiners determining subject matter eligibility. Such changes to the way examiners are instructed to issue subject matter eligibility rejections may not be readily ascertainable based only on anecdotal personal experience. Changes to the Master Review Form also may reflect how the USPTO is reacting to new case law from the courts.

NOTES

[1] <https://www.uspto.gov/sites/default/files/documents/MRF%203.01.pdf>

[2] Federal Register 81(58):16142–16143 (March 25, 2016).

[3] Id. at 16144.

[4] Id. at 16143.

- [5] Id. at 16144.
[6] Master Review Form at pp. 15 and 17.
[7] Id. at p. 15.
[7] Id.
[8] Id.
[9] Id.
[10] Id.
[11] Id.
[12] Id.

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