



SHIMOKAJI & ASSOCIATES, P.C.

Intellectual Property Lawyers
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NEWSLETTER

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We specialize in the litigation, registration, and monetization of patent, trademark, and copyright matters. The clients we serve range from start-ups to Fortune 500 companies, government entities, and universities. Though located in the US, our expertise and representation has an emphasis in Asia.

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Quick Path Information Disclosure Statement

A pilot program continues to exist at the USPTO whereby, after payment of the issue fee, an information disclosure statement (IDS) can be examined without the filing of a request for contined examination (RCE).

More information can be obtained at info@shimokaji.com



USPTO Guidelines For Claims Involving Laws of Nature, Natural Principles, Natural Phenomena, Natural Products

Earlier this month, the USPTO issued examiner guidelines to address subject matter eligibility under Section 101 and the recent Supreme Court decisions in *Myriad* and *Prometheus*.

The Guidelines are intended to assist the determination of whether a claim "reflects a significant difference from what exists in nature and thus is eligible, or whether a claim is effectively drawn to something that is naturally occurring."

A "significant difference" can be shown, for example, by the claim including "features or steps" that demonstrate that the claimed subject matter is "markedly different" from what exists in nature - i.e., from the judicial exceptions to eligible subject matter.

Factors that weigh in favor of eligibility include:

1. a product claim is determined to be non-naturally occurring and "markedly different in structure" from naturally occurring products
2. the claim recites elements/steps so that others are not "substantially foreclosed" from using the judicial exceptions.
3. the claim recites elements/steps that are "more than nominally, insignificantly, or tangentially related" to the judicial exceptions.
4. the claim recites elements/steps that do more than "apply or use" the judicial exceptions.
5. the claim includes a "particular machine or transformation of a particular article".