PRESENTED AT

21st UT Advanced Patent Law Institute

November 3-4, 2016
Austin, Texas

Navigating Patent Eligible Subject Matter for Computer Implemented Inventions under the USPTO Guidelines: A Practical Discussion

Speaker: Michael W. Piper

Author Contact Information:
Michael W. Piper
Andrew Metrailer
Elexis A. Jones
Timothy Dunbar
Conley Rose, P.C.
Plano, Texas

mpiper@dfw.conleyrose.com
972-731-2288

Table of Contents

I. Introduction

To help understand the perspective of this discussion let me start with the fact that I am a patent prosecutor who works on patents for computer implemented inventions in the USPTO (and more specifically frequently in Art Unit 3600). While I spent time earlier in my career working on litigation matters in the district court and at the appellate level, the bulk of my career has been invested in developing disclosures, working with the inventors to build the stories that will become patent applications, and sharing the stories with Examiners in working to creatively define and protect the intellectual property developed by my clients. While my background starts with a mechanical engineering degree, time and circumstance (and some misspent youth writing basic programs on a Commodore 64) led to a large portion of my practice dealing with software and IT related inventions. As such, I watched that area of my practice develop significantly after State Street Bank and I have watched the Supreme Court and parts of the PTO slowly bring it under increasing levels of scrutiny ever since. I could say I have been on the front lines in prosecution in the PTO as this particular pendulum has been swinging, but to set a metaphor it may be appropriate to suggest I have been out at sea watching the storm roll up and am now trying to work my way through to calmer waters in the future.

My goal with this discussion is to consider the best views I and my co-authors have at this particular moment in time responding to some of the fundamental questions of a patent prosecutor in the face of this storm. Knowing the future remains uncertain, how do I develop my disclosures to best prepare for what might be in store for me? What are approaches I can take to try and protect my ability to draft claims as broadly as the state of the law will allow without implicating only abstract ideas? Or worse – what do I do with this case drafted 5 years ago and now trapped in Art Unit 3600 being assessed under a set of standards I did not perfectly anticipate when I drafted it?

This discussion is not an effort to divine the latest case law from every district court to determine every angle to attack or defend an issued patent at trial or on appeal. Rather it is a patent prosecutor's observations on how to most effectively work in the Office where the Examiners are much more likely to use the internal PTO guidelines than to interpret obscure case law. For this reason, and to address the questions about approach to disclosures and prosecution, we are trying to provide a practical discussion of the PTO guidelines and their examples to help navigate a sound path from disclosure development through application drafting to launch into difficult and changeable seas. The discussion also adds in current experiences through regular interviews in the office to the PTO's most recent guidance to provide suggestions for prosecution

for those applications already at sea in boats that were hopefully constructed well enough to hold up against the wind and waves of this present storm.

II. Overview of USPTO Official Guidance

On December 16, 2014, the USPTO issued new interim guidance in light of *Alice Corp. v. CLS Bank Int'l.*, 134 S. Ct. 2347 (2014). Following feedback from patent stakeholders, the UPSTO issued Supplemental Guidance and Examples in July 2015 (July 2015 Update). This supplemental guidance supersedes the previous guidance issued by the USPTO. Both the interim and supplemental guidance made clear that all claims should be subject to the same test for whether the claims are directed to a judicial exception. In other words, we need to consider the bio world of products of nature in the same framework as the abstract idea challenges we have been experiencing in computer-implemented inventions. Since the July 2015 Update, the Federal Circuit continued issuing decisions involving patent eligibility, and in May of 2016 the USPTO issued a Subject Matter Eligibility Update and Memorandum (May 2016 Update). The May 2016 Update continued to clarify and provide Patent Examiners with instructions for applying the guidance and considering patent subject matter eligibility. The guidance has taken the form of documenting an overall approach and framework for assessing eligibility, some specific direction on how an Examiner is to make their case (and how not to) in an office action, and, perhaps most impactfully, a set of examples exploring the application of these standards to particular claims with reasoning supporting that application. We will address the first and last of these elements of the guidance in the following section and address the guidance's specific prosecution directions intermittently here and there and in more detail in the section addressing practical suggestions for prosecution.

A. A Framework for Assessing Eligibility

The PTO provided the following flowchart outlining initial considerations for determining patent eligibility.

Title search: Navigating Patent Eligible Subject Matter for Computer Implemented Inventions under the USPTO Guidelines: A Practical Discussion

First appeared as part of the conference materials for the
21st Annual Advanced Patent Law Institute session
"Section 101 and *Alice*: Prosecution Tips and New USPTO Guidelines"