

Patentable Subject Matter Keeping Up With § 101 In Software Patents

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Presentation Overview

- As a prosecutor, how do I:
 - Develop my disclosure prior to filing to address 101?
 - Still draft broadly without implicating only abstract ideas?
 - Prosecute the application to get to an issued patent?
- Outline
 - Examine the USPTO Guidance
 - Drafting conclusions and lessons
 - Prosecution conclusions and lessons
 - Summary

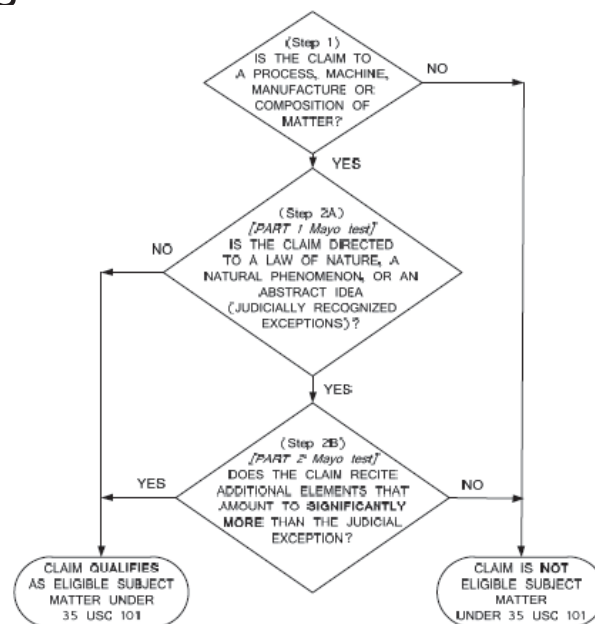
USPTO Guidelines

- 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).
- Supplemental Guidance and Examples issued July 2015.
- The guidance supersedes the previous guidance issued by the USPTO.
- All claims with a judicial exception are subject to the same test.
- May 2016 Subject Matter Eligibility Update - Memorandum issued to provide Examiners with examination instructions to assist them in applying the guidance.

Link to USPTO Interim Eligibility Guidance: <http://www.gpo.gov/fdsys/pkg/FR-2014-12-16/pdf/2014-29414.pdf>

USPTO Guidelines

- Flowchart of the test for patent-eligible subject matter:



USPTO Guidelines

- The USPTO Official Guidance: Step 1
 - Is the claim to a process, machine, manufacture, or composition of matter.
 - Computer-implemented methods are processes
 - A non-transitory computer-readable medium is a manufacture
 - A system with a computer server and computer store is a machine
 - A system with a mobile device and server is a machine
 - Most, if not all, claims can satisfy step 1.

USPTO Guidelines

- The USPTO Official Guidance: Step 2A – Part I
 - Determine whether the claim is directed to a judicial exception (including an abstract idea).
 - “Directed to” includes a recited element that is set forth or described in the claim.
 - Concerned with monopolization of ideas
 - Considers the BRI interpretation of the claims in light of the Specification.

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"Section 101 and *Alice*: Prosecution Tips and New USPTO Guidelines"