

# 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?
  - Examine the USPTO Guidance
  - Drafting conclusions and lessons
  - Prosecution conclusions and lessons
  - Summary

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## A Light for Subject Matter Eligibility

- In 2017 Tariq Hafiz became Director of Technology Center 3600 Business Methods coming from the 2600's
- In 2018 Andrei Iancu was confirmed as Director of the PTO
- Their arrival has been followed by positive movement in the trenches and at the policy level.

## The Initial Impacts

- A Marked Shift in Tone in 3600
- The Berkheimer Memo
  - Well-understood, Routine, Conventional Activity must be based in documented facts
- The Vanda Memo
  - Method of treatment claims are patent eligible
- 2019 Revised SME Guidelines
- Examples 37-46
  - Illustrating the application of the Revised Guidelines

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## Title search: Patentable Subject Matter Keeping Up with Section 101 In Software Patents

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24<sup>th</sup> Annual Advanced Patent Law Institute session

"Section 101 in Two Realms: Where We Are and Where We Might Be Going in Life Sciences and in Software"