

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