

# 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

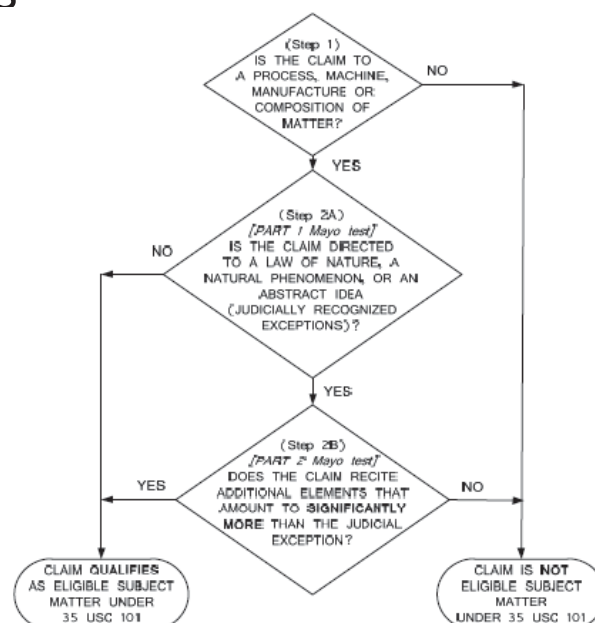
## USPTO Guidelines

- 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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## Title search: Patentable Subject Matter Keeping Up with § 101 in Software Patents

Also available as part of the eCourse

[2016 Advanced Patent Law eConference - Austin](#)

First appeared as part of the conference materials for the  
21<sup>st</sup> Annual Advanced Patent Law Institute session

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