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Navigating Patent Eligible Subject Matter (November 2021 Update)

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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 USPTO slowly bring it under increasing levels of scrutiny over the following years. I could say I have been on the front lines in prosecution in the USPTO as this particular pendulum has been swinging, but to set a metaphor it may be appropriate to suggest I was out at sea watching the storm roll up and have worked my way through the rough seas to what appears to be calmer (although still somewhat choppy) waters.

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 on both sides of the pond trying to gather their bearings in the calmer waters on the backside of this storm. Knowing the future still remains uncertain, how do I develop my disclosures to best prepare for what might be in store for me? What approaches can I 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 years ago and now trapped in Art Unit 3600 being assessed under a set of standards or guidelines I did not perfectly anticipate when I drafted it?

This discussion is not an effort to divine the latest caselaw 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 USPTO guidance than to interpret obscure caselaw. For this reason, and to address the questions about approach to disclosures and prosecution, we are trying to provide a practical discussion of the USPTO guidance and their examples to help navigate a sound path from disclosure development through application drafting to launch into choppy and potentially changeable seas. The discussion also adds in current experiences through regular interviews in the Office to the USPTO'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 lengthy storm.

II. A Quick Overview of The Last Guidance Developments in the PTO

A. *The Impact of the Guidance: Immediate Improvement but Uncertain Future*

In early 2019, the PTO released the Revised Subject Matter Eligibility Guidance and new Examples 37-42 illustrating the application of the Revised Guidance. This was followed by the release of an update to the Revised Guidance and further new Examples 43-46 in October 2019. The examples from the various Guidances are the focus of much of the discussion to follow. At its initial release, the guidance (and likely some underlying messages to the Examiners that came with them) had a remarkable effect at the Examiner level, especially in Technology Center 3600 where many examining groups seem to be almost abandoning 101 positions in favor of other pathways or allowance. This has since been retrenched in some art units within 3600 although most have still improved from the darkest days.

However, we have not seen similar results at the Board of Appeals. Instead, my group has seen a set of old appeal results from the Board arrive which almost universally applied lip service to the new guidance while upholding 101 rejections that in our current view would not have been made by the Examiners under the current guidance. In particular, the decisions cite and discuss the new guidance, but they do not actually apply the new guidance the way we are seeing the Examiners apply it. Instead, the Board in each of the decisions paints the limitations of the claims with a broad brush and then dismisses them as well-understood, routine, and conventional very much reminiscent of how the Examiners were applying 101 prior to the 2019 Revised SME Guidance. While Examiners are precluded under Step 2A, Second Prong from considering whether an element is well-understood, routine, and conventional, in some of the earlier decisions, the Board was not. We also note that in each of the decisions, the Board confirmed their finding of a recitation of an abstract idea at Step 2A, First Prong with citations to the specification that support their alleged category of abstract idea. At Step 2A, second prong, the Board in each of the decisions classifies almost all of the elements as abstract such that the only remaining elements in the claims that are not abstract are generic computer components recited at a high level of generality. The Board then tends to find that the additional elements merely apply the

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