UT Patent Law CLE's 2022 Advanced Patent Law Institute

PREPARED BY:

Jonathan H. Harder
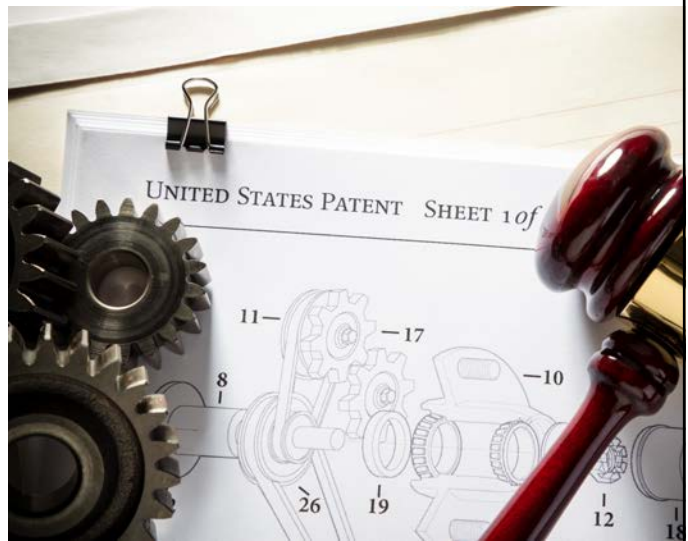
Table of Contents:

1. Preferred Software Drafting Techniques
2. Software and 101
3. Software Prosecution Statistics
4. Artificial Intelligence and Patents
5. Efficient Patent Prosecution
6. Bio

Preferred Software Drafting Techniques

- Working with startups and mid-sized companies: initial applications
  - Tell a story with a technical problem and technical solution
  - Current, alternative, and future embodiments
  - ~50-100 page specifications; ~20 figures

- Claim scope: client computing device and server computing device
  - User interface examples
  - Flow charts
  - Sequence diagrams for multiple computing device interactions

Software and 101

- Revised Alice's two part test based on the 2019 Revised Patent Subject Matter Eligibility Guidance.
  - Step 2A, Prong One: Evaluate whether a claim recites a judicial exception (e.g., abstract idea, law of nature, or a natural phenomenon).
  - Step 2A, Prong Two: If the claim falls into a grouping, proceed with determining whether the claim is integrated into a practical application.
  - Step 2B: If the claim is directed to a judicial exception, determine whether elements amount to significantly more (well-understood, routine, conventional activity).

- The 2019 update includes examples of practical applications for claims drawn to abstract ideas.
  - 25% decrease in the likelihood of Alice-affected technologies receiving a first office action with a rejection for patent ineligible subject matter.

Software Patent Statistics

- Successfully overcoming any 101 rejections with the Examiner is critical during examination.

- Research indicates that in 2021 the PTAB affirms ~87% of 101 rejections from Examiners.

- Build a thorough specification that explicitly discusses practical applications of the technology.
  - Analyze the subject matter of the claims and analogize to cases and examples that have been determined to be eligible.
  - Interview the examiner to teach them about the invention and refer to portions of the specification.

ARIZONA   CALIFORNIA   FLORIDA   ILLINOIS   KENTUCKY   MICHIGAN   NEVADA   OHIO   TENNESSEE   TEXAS   WASHINGTON D.C.   TORONTO   DICKINSON WRIGHT

5

Artificial Intelligence and Patents

Example allowable AI eligible subject matter:
- Training of a neural network (specific process tailored for particularized machines that are not generic)
- Applications of the trained neural network
- Improved architecture for an AI system

Examples of claims that are integrated into practical applications:
- Network that detects suspicious activity by using network monitors and analyzing packets
- Improved user interface by automatically rearranging icons (include GUI's in figures)
- Standardizing data formats of health-care providers and patients and sending updated messages

ARIZONA   CALIFORNIA   FLORIDA   ILLINOIS   KENTUCKY   MICHIGAN   NEVADA   OHIO   TENNESSEE   TEXAS   WASHINGTON D.C.   TORONTO   DICKINSON WRIGHT

6

Also available as part of the eCourse
[2022 Advanced Patent Law (Austin) eConference](#)

First appeared as part of the conference materials for the
27th Annual Advanced Patent Law Institute session
"Advanced Patent Drafting: Strategies and Tactics"