Introduction
Importance of Foreign Associates

• Important to have trusted partners in foreign countries who can provide assistance
  – Review specification and claims
  – Assist with best practices for local jurisdictions (e.g., patentable subject matter, deferral of costs, divisional strategy, assignments, etc.)
Value for Money

- Close relations between US/foreign practices
  - Reduce miscommunications
  - Matching of competence in IP and technology
  - Exchange of ideas
- Reduce divisional filings
- Proactive prosecution
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Patent Basics
What to Patent?

• Right to exclude others from making, using, selling, etc.
  – Does not give patent owner right to make, use or sell invention

• Commonly patented technologies
  – Devices, systems, components, materials
  – Methods of manufacturing or using
  – Computer-implemented methods (software)
Requirements for Patentability

• **Invention as claimed must be**
  - Novel (35 U.S.C. 102)
  - Non-obvious (have inventive step) (35 U.S.C. 103)

• **With respect to the “prior art”**

• **Prior art includes earlier patents and printed publications**
  - Can also include clinical trials and user evaluations if not done under NDA
  - Beware of pre-launch activities
Another Requirement: Patent Eligibility

• Is the invention even eligible for patenting?
• Also known as:
  – Statutory subject matter
  – Satisfies 35 U.S.C. 101 (or section 101)
Patent Eligibility
Eligible Subject Matter

§ 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor....
Exceptions to Eligible Subject Matter

- Judge-made exceptions to patent-eligible subject matter
  - Products of Nature
  - Natural Laws / Natural Phenomena
  - Abstract Ideas / Mental Processes (Alice)

These exceptions are “part of the storehouse of knowledge … free to all men and reserved exclusively to none.”

*Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127 (1948)
Why Focus on Patent-Eligibility?

• “What the Courts Did to Curb Patent Trolling-for Now”
  *The Atlantic* (December 2014)

• “Alice Corp. Patent Ruling Is Good For Software Firms, Bad News For Trolls”
  *Forbes* (June 2014)

• “US Supremes Uphold Troll-Busting Alice v CLS Bank decision”
  *The Register* (June 2014)
Greater Scrutiny for Certain Subject Matter

Rates for Section 101 rejections, relative to all office actions and notices of allowances issued in each “guidance” period

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Source: Bilski Blog
Two-Part Test for Patent Eligibility

• Threshold inquiry (Step 1)
  – Is the claimed invention directed to an abstract idea?
  – If not, then the claimed invention is patent eligible

• Inventive concept inquiry (Step 2)
  – Do the claimed elements alone or in combination state significantly more than the abstract idea?
  – If yes, then the claimed invention is patent eligible
Examples of Abstract Ideas

- Fundamental Economic Processes
- Idea “Of Itself”
- Mathematical Relationships/Formulas
- “Certain” Methods of Organizing Human Activity
Patent Eligible Example:
Specific Improvement in Computer Capabilities

*Enfish, LLC v. Microsoft Corp. (Fed. Cir. 2016)*

- Patent claims directed to specific type of data structure designed to improve the way a computer stores and retrieves data in memory

*FIG. 10*
Patent Eligible Example: Improving an Existing Technological Process

*McRO v. Bandai Namco (Fed. Cir. 2016)*

- Patent claims directed to the automatic lip synchronization and facial expression animation using computer-implemented rules
McRO: Improving an Existing Technological Process

- Claims a particular solution to a problem or a particular way to achieve a desired outcome (as opposed to merely claiming the idea of a solution or outcome)
  - Before the invention, human artists relied on subjective determinations to set the morph weights to match phonemes
  - Specification explained how the claimed rules enabled the automation of tasks that previously could not be automated
Patent Eligible Example: Unique Arrangement of Known Elements

**BASCOM v. AT&T Mobility LLC (Fed. Cir. 2016)**

- Claims directed to a system for filtering content retrieved from an Internet computer network are patent-eligible.
  - Filtering content is an abstract idea
  - **BUT** the non-conventional and non-generic arrangement of known, conventional elements can yield an inventive concept
Strategies for Patent Eligibility

• Focus the claims and the specification on technical improvements to computer technology or another field of technology
  – Federal Circuit decisions
• Analogize the claims to eligible claims in the Patent Office Examples
  – PTO Guidelines
• Avoid Technology Center (TC) 3600, which examines “business method” cases
  – Amend Title, Abstract, Field of Invention and Claim Preambles to present technical aspect of invention
  – If the application is in TC 3600, always interview (may require amending the claims)
Thank You!
vlad.tepltiskiy@knobbe.com