Patenting Computer Implemented Inventions in the US

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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
<table>
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<tr>
<th>Transparency</th>
<th>Bad News</th>
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<td>• Predictability of fees</td>
<td>• Appeal necessary</td>
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<td>• Direct contacts to the person managing a case</td>
<td>• Missed convention priorities</td>
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<td>• Risk management</td>
<td>• Patent eligibility refusals</td>
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<td>• Predictability of results</td>
<td>• Close partners split – forced choice</td>
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Patent Eligibility
Eligible Subject Matter

35 USC § 101:

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.

Similar to Article 52 EPC
Exceptions to Eligible Subject Matter

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

• Similar to Article 52(2 and 3) EPC exceptions
State of the Law Before 2014

Claimed invention is patent-eligible if:

1) it is tied to a particular machine or apparatus; or
   – similar to the European approach of commonly known technical means being sufficient to confer technical character and fulfill the requirements of Art 52 EPC

2) it transforms a particular article into a different state or thing
Current State of the Law: Two-Part Test

- 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
US Is More Strict than Europe

• To be non-abstract, there must be improvement to operation of computer or another field of technology
  – Unlike Europe, these improvements are measured relative to state of the art at the time of invention/filing

• To recite inventive concept, claim must recite more than conventional implementation using generic computer components or machinery
  – Unlike Europe where “commonly known technical means in a claim are sufficient to confer technical character and fulfill the requirements of Art 52”
Strategies for Patent Eligibility

• Focus the claims and the specification on technical improvements to computer technology or another field of technology
  – Submit evidence showing state of the art and significance of claimed technology during prosecution
• Analogize the claims to eligible claims in the Patent Office Guideline and Examples
• 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!
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