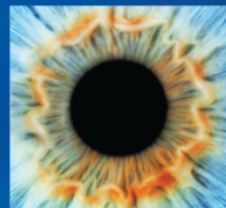
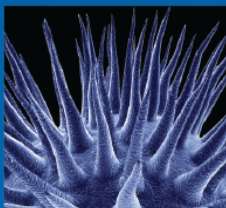
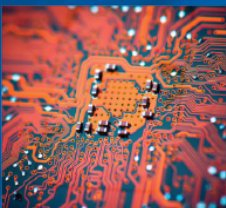


Patenting Computer Implemented Inventions in the US

Vlad Teplitskiy

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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

Transparency

- Predictability of fees
- Direct contacts to the person managing a case
- Risk management
- Predictability of results

Bad News

- Appeal necessary
- Missed convention priorities
- Patent eligibility refusals
- Close partners split – forced choice

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

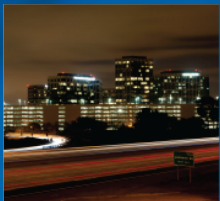
US Is More Strict than Europe

- 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”

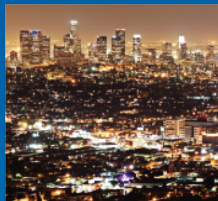
Strategies for Patent Eligibility

- 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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Orange County



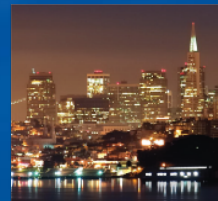
Los Angeles



New York



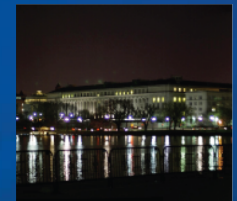
San Diego



San Francisco



Seattle



Washington DC