

## 5 KEY TAKEAWAYS

# Rolling with the Legal Punches: Resetting Patent Strategy to Address Changes in the Law

Kilpatrick partners [Tina McKeon](#), [Michael Bertelson](#), and [Michael Turton](#) recently joined [Laura Fritts](#) (Vice President, Intellectual Property, Legal, Azurity Pharmaceuticals, Inc.) to present at the annual **Kilpatrick Intellectual Property Seminar** on the topic of “**Rolling with the Legal Punches: Resetting Patent Strategy to Address Changes in the Law.**” This panel discussed how changes in case law related to patentable subject matter (35 USC § 101), obviousness (35 USC § 103), or enablement and written description (35 USC § 112) impact strategies related to patent prosecution and litigation across different technology areas.

Dr. McKeon offers the following five takeaways from the presentation:

1

**Remain vigilant as to the vulnerability of claims under 35 U.S.C. § 101.**

About 50% of motions to invalidate claims based on unpatentability of the claimed subject matter have been successful for the last three years in U.S. district courts, although the Federal Circuit is more likely to find claims unpatentable under 101.

2

**Watch for changes in the test for patentable subject matter in the next few years.** The Alice/Mayo two-step test continues to be applied to determine whether claims are directed to a patent ineligible concept, but the Patent Eligibility Restoration Act of 2023 (currently in the Senate Judiciary Committee) seeks to broaden the categories of eligibility.

3

**Rely on dependent claims and sound reasoning to ensure non-obvious claim scope.** The U.S. Patent Office recently released Updated Guidance regarding obviousness under 35 U.S.C. 103, indicating the flexible approach to obviousness remains largely unchanged since KSR but explicit and clear reasoning for an obviousness determination is required.

4

**Consider arguing lack of motivation to combine teachings of multiple references and lack of a reasonable expectation of success to rebut an obviousness challenge.** Such arguments are particularly useful in claims related to life sciences.

5

**Back up broad genus claims with multiple dependent claims.** Case law has evolved with the evolution of biotechnology so as to result in few genus claims being considered enabled to the full scope of the claim, but the requirement for “full scope enablement” reaches beyond biotechnology claims.