Insights: Alerts

Key Takeaways: Software Patent Prosecution Requires Data-Based Strategies Due to Patent Office Inconsistencies

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Kilpatrick Townsend attorneys Kate Gaudry, Ph.D. and Thomas D. Franklin recently presented at the Practising Law Institute's 11th Annual Patent Law Institute regarding "Software/EE: Are We There, Yet?".

Key Takeaways from the presentation include:

- Patent-Eligibility Test – Poorly Suited for Consistency
  - Almost all software innovations are vulnerable to an abstract idea accusation under patent eligibility guidelines. For example, patent office examination guidelines indicate that a claim "comparing new and stored information using rules to identify options" is abstract.
  - Patent office instructions require a deep analysis of case law, although very few examiners are lawyers.
  - "Significantly more" qualification is ill-defined.
- Post-Alice, Allowance Rates Vary
  - Allowance prospects in business-method art units where eligibility rejections are common are an order of magnitude lower than in other areas with similar technology.
  - Recently, business-method allowance rates have been inching higher (coinciding with management personnel change).
- Crafting Strategies in View of Examiner and Art Unit Variability Improve Prosecution Results and Costs
  - There is no one-size-fits-all prosecution strategy, as examination tendencies vary across art units and over time.
  - Examiner statistics predict post-amendment allowance prospects.
  - Art unit allowance rates predict prospects of pre-decision allowances in appeal cycle.
  - Empirical data is useful to determine whether (and how) to file an amendment, appeal, abandon, etc.

Kilpatrick Townsend Partner Thomas D. Franklin focuses his practice on aggressive patent prosecution, strategic patent management and pre-litigation strategies with twenty years of patent experience. Kilpatrick Townsend Attorney Kate Gaudry, Ph.D. uses data-based approaches to identify portfolio- and application-level prosecution strategies for individual clients. Her goal is to provide clients with client-specific advice on how to intelligently and deliberately select drafting and prosecution strategies to achieve their patent goals. Dr. Gaudry's technical background is in software, computer systems and quantitative biology.