KILPATRICK TOWNSEND

5 KEY TAKEAWAYS

Section 101 & Spec Drafting: Preparing Your Patents for a 101 Attack

Kilpatrick Townsend's Karam J. Saab recently joined a panel of other industry leaders at the The 21st Annual Rocky Mountain Intellectual Property Institute -- the premier forum for bringing together intellectual property professionals from across the U.S. and beyond – to discuss "Section 101 & Spec Drafting: Preparing Your Patents for a 101 Attack."

Mr. Saab provides the following five key takeaways from the panel discussion:

1. With the denial of certiorari in ***American Axle & Manufacturing Inc. v. Neapco Holdings LLC,*** the Supreme Court continues to avoid taking cases that address subject matter eligibility under 35 U.S.C. Section 101. Two notable opportunities presented themselves so far in 2023: ***Interactive Wearables, LLC v. Polar Electro, Inc.*** and ***Tropp v. Travel Sentry, Inc.*** While the Solicitor General advised via an amicus curiae brief in each case that the Supreme Court should grant certiorari, in both cases the Supreme Court declined.

2. For the foreseeable future, Applicants need to be prepared for an enablement analysis to bleed into any court's analysis of 35 U.S.C. Section 101 subject matter eligibility in light of American Axle. While an analysis under 35 U.S.C. § 101 should focus on whether the patent application's claims are directed to eligible subject matter, courts can be expected to review an application's specification for enablement of the claimed concepts.

3. Broad claim language can be problematic for a subject matter eligibility analysis under 35 U.S.C. Section 101 in view of recent decisions. For example, conclusory claim language (e.g., "configured to"), which defines the end result of a step or the output of a component without specifically detailing how the step is performed or component functions, has helped sway courts toward finding ineligible subject matter.

4. While conclusory claim language is useful for creating broad claims, having separate independent claims that avoid such language is advisable. American Axle indicated that at least the Federal Circuit is unlikely to give much weight to dependent claims, as specifically pointed out by Judge Moore in her dissent.

5. Regardless of how the claims are drafted, applicants should take increased care to expand the technical aspects detailed in their patent applications' specifications. Technical benefits and technical details, even when not claimed, that are relevant to the claimed embodiments can help claims survive an enablement-tinged subject matter eligibility analysis.

3

and technical details, even when not claimed, that are relevant to the claimed embodiments can help claims survive an enablement-tinged subject matter eligibility analysis.

For more information, please contact Karam J. Saab: ksaab@kilpatricktownsend.com.

www.kilpatricktownsend.com