5 Takeaways: Strategies for Addressing Section 101 Eligibility Issues at the USPTO

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5 KEY TAKEAWAYS

Strategies for Addressing Section 101 Eligibility Issues at the USPTO

Kilpatrick Townsend's Rob Curylo recently participated in a panel discussing strategies for addressing patent-eligibility issues in business-oriented technologies. Kilpatrick Townsend hosted the event in partnership with the Patent Committee of the Intellectual Property Law Section of the State Bar of Georgia.

Key takeaways from the presentation include:

1

Draft for a non-business art unit

- Odds of allowance improve dramatically outside of Technical Center 3600
- Incorporate USPC definitional language throughout specification
- Emphasize technology-specific problems and terminology
- Business advantages should be omitted or characterized as secondary to technical improvements

Lead with a claim that favors eligibility over other concerns

- One claim should recite a highly-detailed, tech-heavy articulation of the core concept
- Use other independent claims to seek broader coverage once the examiner has decided that the core concept is patent-eligible

2

3

Borrow language from favorable eligibility decisions to frame the invention as addressing a technical improvement

Include use cases beyond improved analytics

- Describe embodiments where analytical result is used to perform some function beyond displaying the result itself (e.g., controlling access to a software function in a website)
- Use case can be recited inferentially in method claim or explicitly in system claim

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Rebutting eligibility rejections

- Procedural arguments alone tend to be ineffective with examiners
- Pair procedural arguments (e.g., *Berkheimer*) with substantive arguments

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