DICKINSON WRIGHT

UT Patent Law CLE's 2022 Advanced Patent Law Institute

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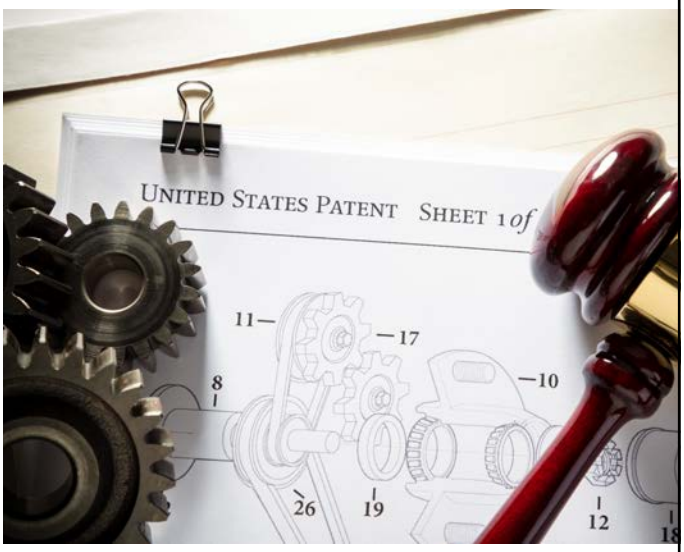

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Preferred Software Drafting Techniques

- Working with startups and mid-sized companies: initial applications
  - Tell a story with a technical problem and technical solution
  - Current, alternative, and future embodiments
  - ~50-100 page specifications; ~20 figures

- Claim scope: client computing device and server computing device
  - User interface examples
  - Flow charts
  - Sequence diagrams for multiple computing device interactions

Software and 101

- Revised Alice's two part test based on the 2019 Revised Patent Subject Matter Eligibility Guidance.
  - Step 2A, Prong One: Evaluate whether a claim recites a judicial exception (e.g., abstract idea, law of nature, or a natural phenomenon).
  - Step 2A, Prong Two: If the claim falls into a grouping, proceed with determining whether the claim is integrated into a practical application.
  - Step 2B: If the claim is directed to a judicial exception, determine whether elements amount to significantly more (well-understood, routine, conventional activity).

- The 2019 update includes examples of practical applications for claims drawn to abstract ideas.
  - 25% decrease in the likelihood of Alice-affected technologies receiving a first office action with a rejection for patent ineligible subject matter.

Software Patent Statistics

- Successfully overcoming any 101 rejections with the Examiner is critical during examination.
- Research indicates that in 2021 the PTAB affirms ~87% of 101 rejections from Examiners.
- Build a thorough specification that explicitly discusses practical applications of the technology.
  - Analyze the subject matter of the claims and analogize to cases and examples that have been determined to be eligible.
  - Interview the examiner to teach them about the invention and refer to portions of the specification.

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Artificial Intelligence and Patents

Example allowable AI eligible subject matter:

- Training of a neural network (specific process tailored for particularized machines that are not generic)
- Applications of the trained neural network
- Improved architecture for an AI system

Examples of claims that are integrated into practical applications:

- Network that detects suspicious activity by using network monitors and analyzing packets
- Improved user interface by automatically rearranging icons (include GUI's in figures)
- Standardizing data formats of health-care providers and patients and sending updated messages

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Also available as part of the eCourse
[Advanced Patent Drafting: Strategies and Tactics]

First appeared as part of the conference materials for the
27th Annual Advanced Patent Law Institute session
"Advanced Patent Drafting: Strategies and Tactics"