

Arguing Alice- Down the Rabbit Hole

With some exceptions, patent practitioners have primarily focused on rejections under 35 U.S.C. 102, 103 in the computer arts. In the past, Office Actions did not regularly include rejections under section 101. Like technology, the law and examination practice has changed. Office Actions today routinely present rejections under section 101. Over the years, courts have provided some guidance about whether a claim is directed to patentable subject matter. As more patent applications are reviewed under section 101 and as additional decisions are issued by the courts, the jurisprudence of patentable subject matter begins to take shape inside and outside of the computer arts.

Alice and other more recent cases, along with guidelines issued by the Patent & Trademark Office, give us an idea of how to address rejections under section 101. There is still a long way to go because many of the patents being litigated were not necessarily written with the foreknowledge of today's decisions. However, there are a few steps that prosecutors can take that will help them navigate Alice and her progeny. The application of Alice is not limited to prosecution. The lessons learned from Alice can also be applied to patent preparation.

When preparing and prosecuting patents, the claims should be considered in the context of addressing technical problems, practical applications of the invention, and structure. Legal positions can also be considered. Is the invention similar to an existing case or example? Has the Examiner established a prima facie case in the Office Action?

A rejection under section 101 is not a death rattle of the patent. It is an opportunity to strengthen the claim for the future.