

**Practical Advice and Future Outlook  
§101 and Patentable Subject Matter**

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**Discussion Topics**

- prosecution strategies
  - drafting approaches (targeting specific art units)
  - "magic" or "red flag" claim terms
  - leveraging examiner statistics, PTAB decisions
- business strategies
  - patents vs. trade secrets, copyright
  - investment decisions (other technologies, other countries)
- forward-looking efforts
  - recent cases
  - cases to watch
  - legislative proposals

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**Helpful Cases**

- *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016) (claims addressing ISP website filtering satisfied step 2 of the *Alice* analysis because of the unique ordered combination of the claim limitations).
- *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014) (claims to a system that addressed a problem particular to Internet businesses by implementing unconventional computer processes were directed to patent eligible subject matter because they satisfied step 2).

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### Recent Cases

- *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016) (claim for "self-referential" database software was not directed to an abstract idea because the plain focus of the claims was an improvement to computer functionality itself).
- *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) (patents directed to processes for automated lip synchronization animation methods were not directed to patent-ineligible abstract ideas).
- *Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042 (Fed. Cir. 2016) (method for producing pure cultures of mature hepatocytes sufficiently improved existing technological processes to satisfy step 2 and transform the natural phenomena into patent eligible subject matter).

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### Eliminate judicial exceptions to 101

"the judicial exceptions to patent eligibility, as applied, are unnecessary and overreaching"

"if what is claimed is a machine, manufacture, composition of matter, or process, or an improvement of any of these things, and if it is useful, it is an invention eligible for patenting, subject to the conditions and requirements of sections 102, 103, and 112"

AIPLA Comments to USPTO (Jan. 18, 2016)

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Exclusion only when claims preclude all practical applications of a law of nature, natural phenomenon or abstract idea

"A claim for a useful process, machine, manufacture, or composition of matter, or any useful improvement thereof, may be denied eligibility under this section 101 on the ground that the scope of the exclusive rights under such a claim would preempt the use by others of all practical applications of a law of nature, natural phenomenon, or abstract idea. Patent eligibility under this section shall not be negated when a practical application of a law of nature, natural phenomenon, or abstract idea is the subject matter of the claims upon consideration of those claims as a whole, whereby each and every limitation of the claims shall be fully considered and none ignored"

Resolution of ABA Section of IP Law, Mar. 7, 2017

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**Limited statutory exception for products of nature and mental processes**

"A claimed invention is ineligible under subsection (a) if and only if the claimed invention as a whole, as understood by a person having ordinary skill in the art to which the claimed invention pertains, exists in nature independently of and prior to any human activity, or exists solely in the human mind."

IPO Proposed Amendments to Patent Eligible Subject Matter Under 35 U.S.C. 101 (Feb. 7, 2017)

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