



Tips For Drafting And Prosecuting Patent Applications After *Bilski v. Kappos*, 561 U.S. ____ (2010)

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As a result of *Bilski v. Kappos*, 561 US ___, 70 USLW 4802, 2010 U.S. LEXIS 5521 (June 28, 2010) (“*Bilski III*”), the breadth of patent-eligible subject matter remains broad under 35 U.S.C. § 101, and categorical exclusions from patent-eligible subject matter continue to be rejected. A claim directed to a “method of doing business” is not *per se* ineligible subject matter for patent protection, and the so-called “machine-or-transformation” test is not the only test for determining patent-eligibility of process claims.

Despite the Court’s holding in *Bilski III* that the “machine-or-transformation” test is not the “sole” or “governing” test for determining patent-eligibility of process claims, it still remains prudent, where possible, to draft patent specifications and claims in accordance with that test and the PTO’s interpretations of that test. While the following tips are not necessarily required by the law, following them can expedite patent claim allowance and limit the likelihood that future changes in the law might invalidate granted claims.

Tip # 1: Include a Computer or Other Machine in the Specification

In order to make sure that there is support down the road to tie a claimed process to a machine, where possible, the disclosure in a patent specification should make reference to specific machines (computers, processors, or other devices). Most business processes can be tied to a computer implementation. Disclosure allowing for claims so tied should be included, so that during prosecution at least claim coverage of computer-implemented embodiments of the process can be obtained.

Tip # 2: Beware of Overly Broad Definitions in the Specification

Specifications should continue to avoid using overly broad definitions of terms of art, like “computer readable media” or “processor readable media,” which may turn concrete structures into non-concrete structures. For example, in an effort to address issues associated with wireless communication, patent applications that redefined such terms in terms of a signal under transmission, and not necessarily in terms of a physical, tangible



object (like memory, a disk, a memory stick, etc.), have been found to be abstract and not patent-eligible by the PTO. See, e.g., *Ex Parte Rodriguez*, App. No. 2006-3362, Slip op. at 9-10 (BPAI Sept. 21, 2007).

Tip # 3: Consider Including Other Types of Concrete Structures or Transformations in the Specification

For inventions that involve contracts, and are not necessarily tied to a computer or other device, disclosure that ties the contractual obligations to tangible media, like a written or electronic contract, and demonstrates some sort of transformation of matter should be included (to the extent possible).

Methods of diagnosing a disease should likewise include a disclosure that coordinates the process steps to the use of particular equipment and the transformation of particular objects (e.g., blood, diseased cells, tested fluids, etc.).

Tip # 4: Claims Should Not Be Drafted to Cover Software Per Se

The PTO has taken the position that software per se is not patent-eligible subject matter. See, e.g., *Ex Parte Forman*, App. No. 2007-1546, Slip op. at 5 (BPAI Dec. 21, 2007). Whether this position will survive is an open question, but in order to avoid the issue, claims directed to computer-implemented inventions that are carried out with software should be written, if possible, in a manner that ties the software to the machine that will implement the process.

Thus, in *Forman*, a claim directed to “[a] computer tool ... comprising: computer code for, computer code for” was rejected as improperly claiming software *per se*. On the other hand, in the same case, when a *Beauregard* form of claim was used, i.e., “computer readable medium having instructions for causing a computer to execute a method”, the same tribunal found the claim to be patent-eligible.

The key distinction in the second instance was that the software was tied to a particular structure (the computer memory on which it was stored and a processor to execute the instructions).

Tip # 5: Tie Steps in a Claimed Process to Particular Structures Which Perform Such Steps

A number of decisions from the BPAI have rejected claims that merely recite in the preamble “an automated process” or “a computer implemented process,” and did not also tie at least some of the steps of such processes to particular structures to perform such steps, e.g., a processor, memory, a communications portal, etc. See, e.g., *Ex Parte Wasynczuk*, App. No. 2008-1496, Slip op. at 22, 25-26 (BPAI June 2, 2008); *Ex Parte Kinzhalin*, App. No. 2007-1416, 2007 WL 3114968 (BPAI Oct. 24, 2007). Thus, while not necessarily every step in a claimed process needs to be tied to a particular structure, to the extent practical, it is a better practice to tie as many claimed steps as possible to such a



structure.

Tip # 6: Use Different Types of Claims

There are many different forms of claims that can be used to cover the same invention. Where possible, a variety of such claim types should be used. The way the law is evolving, and the fact that a patent can last for 20 years from filing, argues in favor of flexibility in presenting claims.

For example, a computer-implemented invention can be claimed in the form of “a method” comprising carrying out certain steps, including storing electronic information (or data) in memory, receiving and transmitting electronic information (or data) to/from a processor via a communications portal, and modifying electronic information (or data) using a processor.

Similarly, the same invention can be claimed in the form of “a system” comprising “a processor,” “memory,” and a “communication portal,” where the memory has “instructions for causing the processor to execute” process steps that match the above method.

Likewise, the same invention can also be claimed in the form of “a system” comprising “components” that correspond to the various tasks to be performed by the system.

Tip # 7: Avoid Fancy Forms of Claims

Ironically, although the purpose of the patent system is to foster innovation, the PTO and the courts have been reluctant to accept innovation in claim drafting. *Bilski III* has reaffirmed the four statutory classes of patent-eligible subject matter: processes, machines, manufacturers, and compositions of matter. While these terms will be broadly construed, straying from one of these types of claims will most likely result in a swift rejection by the PTO, and should be avoided to the extent possible. For example, as *In re Ferguson*, 558 F.3d 1359 (Fed Cir. 2009), cert. denied, 79 USLW 3007 (U.S. June 29, 2010) demonstrates, it is not a good idea (unless you are seeking to create a test case) to create a new form of claim (e.g., “a paradigm”).

Tip # 8: Try to Show a Transformation

To the extent possible, when drafting a claim, it is best to also show a “transformation of matter,” even when a claim is tied to a machine, to enable additional arguments in the future.

For example, even when a process involves data that is stored on a computer, the PTO still looks to see whether the data is transformed (*i.e.*, manipulated in some way) to determine whether the process is patent-eligible.

Tip # 9: Rely on Historical Supreme Court Precedent in Arguments Against Section 101 Rejections



As Justice Kennedy phrased it, “times change,” and the law of patent-eligible subject matter is a good example of this. Naturally, legal arguments in Office actions are presented and analyzed in terms of the law as it exists today, and thus should be addressed accordingly. However, where the Federal Circuit’s seemingly immutable pronouncements of law have recently become more uncertain in view of heightened scrutiny by the Supreme Court, when addressing patent-eligible subject matter it is important to argue more than the most current Federal Circuit precedent (e.g., *State Street*, or *Bilski II*), but to also argue conformance with historical Supreme Court precedent (e.g., *Diehr*, *Benson*, *Flook*, *Bilski III* etc.).

This point is hit home hard in *Fort Properties, Inc. v. American Master Lease, LLC*, 609 F. Supp. 2d 1052 (C.D. Cal. 2009), *appeal stayed*, No. 2009-1242 (Fed. Cir. June 11, 2009), where the PTO, in granting the asserted claim as patent-eligible subject matter, relied upon the “useful, concrete and tangible result” test set forth in *State Street*, but the District Court ignored that finding in view of *Bilski II*.

While certainly the current state of the law as expressed by the Federal Circuit, the BPAI, and PTO guidelines needs to be addressed in arguments against Section 101 rejections, it is also prudent to support such arguments with Supreme Court precedent, and to explain why a claim falls within one of the four statutory categories of patent-eligible subject matter and why the claim is a practical application of fundamental principle, like in *Diehr*, and thus does not preempt a fundamental principle, like in *Flook* and *Benson*.