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INSIGHTS

"In both the U.S. and Europe, patents should detail, in the specification, the technical problems and technical solutions offered by the invention."

3 Tips on Drafting Patent Applications With an Eye Toward *Alice* and Section 101

Q: IN LIGHT OF THE FEDERAL CIRCUIT'S RULING IN *ANCORA V. HTC*, DO YOU HAVE ANY TIPS FOR PATENT DRAFTSPERSONS?

STEVEN G. SAUNDERS: The *Ancora* decision is the latest ruling in a string of post-*Alice* cases suggesting that patents should be drafted with an emphasis on both the technical problem and technical solution delivered by the claims. To make the claim technical, patent draftspersons should:

1. Highlight the improved functionality of a system or device, keeping in mind that this tip is not limited to improving computer functionality.
2. Demonstrate that the claims take advantage of a special quality of some known system component.
3. Discuss the technical problem and technical nature of the solution in the description, while avoiding being too limiting in the event of litigation.

Q: HOW IS "TECHNICAL" DEFINED IN TERMS OF PATENTS?

SGS: The Supreme Court has not defined "technical," but popular definitions focus on the "practical application of science." The PTO § 101 Guidelines issued in January 2019 affirm this approach, which splits Step 2A—i.e., ascertaining the abstract concept—into two prongs.

The first prong evaluates whether the claim recites one of three groups: mathematical concepts, a certain method of organizing human activity, or mental processes. Mathematical concepts encompass mathematical relationships, formulas, equations, or calculations. Examples of organizing human behavior would be hedging, insurance, advertising, controlling personal behavior and human interaction, and the like. Mental processes are performed in the human mind or have the capability of being performed in the human mind.

The second prong locates additional elements and evaluates whether those elements integrate the abstract idea into a practical application.

Q: WHAT ARE THE DIFFERENCES BETWEEN FAVORABLE AND UNFAVORABLE ELEMENTS IN THE SECOND PRONG?

SGS: Favorable elements could improve the functioning of a computer or other technology; be a part of a machine that is integral to the claim; or be an element that transforms an article to a different state or thing.

In contrast, unfavorable elements could be an insignificant extra-solution activity, such as general data gathering before running a calculation, measuring metabolites in a drug administered in a patient, or adjusting an alarm limit in the output of a formula. Another example is an element that merely links the exception to a particular technical environment or field of use.

Unlike Step 2B, which requires significantly more than the exception to provide an inventive concept, Step 2A does not require unconventional or novel use of the element.

Q: WHAT IS THE EUROPEAN PERSPECTIVE?

SGS: The U.S. and Europe use vastly different methods to arrive at similar places: claims should bring out the technical nature of the problem and solution.

European examiners effectively ignore the non-technical items and evaluate novelty and inventive steps without those ignored, non-technical elements. If the non-technical features interact with the technical subject matter to solve a technical problem, however, then they are considered in the inventive step analysis.

In both the U.S. and Europe, patents should detail, in the specification, the technical problems and technical solutions offered by the invention. Such descriptions must sufficiently correspond to the claimed language and, at least in Europe, avoid overreliance on industry buzzwords.

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