

# LAW WEEK

## COLORADO

# Finding Patentable Subject Matter Post-Alice

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As technology companies continue to surge in Colorado, both larger companies and startup ventures continue to seek protection for their innovations through patents.

In many cases, these innovations lie in the computer and software realm. However, in the wake of the landmark 2014 Alice Supreme Court decision on patent-eligible subject matter under

found in the high-tech patent space.

First, a court must determine whether the claims at issue are “directed to a patent-ineligible concept,” for example, an abstract idea. However, there is no bright line rule as to whether claims are directed to an abstract idea.

Instead, courts are instructed to compare a claim at issue against claims that have been held to be abstract ideas in past cases. If the court finds that the claim is not directed to a patent-ineligible concept, then the inquiry ends as the claim is subject matter eligible.



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35 U.S.C. section 101, approval rates for software-related patents plummeted. In cases invoking the Alice decision in the following year, the Federal Circuit only found a single invention to be subject-matter eligible.

Recent decisions from the Federal Circuit finding allowable subject matter have finally shined a pathway to patentability for many computer- and software-related patents, which have overwhelmingly remained in purgatory since the Alice decision. By analogizing patent claims to these allowed precedents, a pathway to allowance may be found. This article outlines the legal backdrop on which these decisions have arrived, then discusses approaches based on these allowed cases for a patent practitioner to succeed in drafting, prosecuting or litigating a computer- or software-related patent or patent application.

## OVERVIEW

In the Alice decision, the Supreme Court established that the Mayo two-step inquiry to determine whether a patent claims patent-eligible subject matter is to be used not only for “laws of nature,” as commonly found in the life sciences, but also for evaluating supposed “abstract ideas” typically

If, however, the court finds that the claim is directed toward a patent-ineligible concept, the court must then determine whether the claim contains an “inventive concept” sufficient to “transform” the claimed abstract idea into a patent-eligible application.

## WINNING ON STEP ONE OF ALICE

A determination that claims are not directed to patent-ineligible subject matter under step one of Alice is the surest way to overcome section 101 issues. Here are some practical techniques to reach this outright win based on the recent post-Alice cases that have found patent-eligible subject matter:

Frame the application in terms of how it may be used to improve a computer’s functionality to solve a technical problem or challenge, rather than as a software process that can be implemented on general hardware. This can be bolstered by explicitly describing the advantages of the invention over the prior art.

Get technical! In *Visual Memory v. NVIDIA*, the most recent Federal Circuit decision finding patent-eligible subject matter, the majority rejected the dissent’s argument that the claims merely combined a “black box” pro-

cess with generic conventional computer equipment in part because of an included appendix. Relying in part on this appendix of 263 frames of computer code, the court found the claims valid. In contrast, in *Clarilogic v. FormFree Holdings*, the court found the claims for a method of gathering financial information to be invalid in part because the specification did not provide technical details describing the claimed “algorithm engine.”

Consider whether the claims may be read as preempting a broad field covering many possible methods of achieving a particular result. If so, consider including a set of rules that can narrow the breadth of that field so that at least some methods of achieving the results may not be covered. Avoid excess abstraction, and include additional details in dependent claims for fallback positions.

## WINNING ON STEP TWO OF ALICE

If the court finds that a patent’s claims are directed to patent-ineligible subject matter under the Alice first step, a court must then advance to the second step. In step two, a court considers whether the claims contain an “inventive concept” sufficient to “transform” the nature of the claim into a patent-eligible application. The court must consider the claim as a whole and as individual claim elements to determine whether the claims contain an element or combination of elements sufficient to ensure that the patent amounts to significantly more than a patent upon the ineligible concept.

While more ambiguously defined than the first step, provided here are techniques for winning on the second step:

Highlight a particular inventive concept in both the claims and the specification. The Federal Circuit has stated that in “close calls” under step one, an analysis of whether there are arguably concrete improvements in the technology could take place under step two. Thus, in claiming and describing an inventive concept to win on step two, consider a particular problem solved by the patent’s implementation on a computer. Recite the claims in terms of a practical application for the invention. In the specification, explain the advantages this application has over the prior art, or what would not be possible without its invention.

Don’t neglect the U.S. Patent and Trademark Office’s official guidance. In patent prosecution particularly, citing an official USPTO publication can hold as much weight as any case law. Don’t pass over the low hanging fruit of appealing to the directives that have been sent to the entire Examiner Corps (e.g., the several memoranda on subject matter eligibility available online).

## CONCLUSION

Alice will certainly continue to present challenges to patentability for some patent applications for the foreseeable future. However, by employing the methods that have been demonstrated to lead to patentability, a patent practitioner can often ultimately navigate a patent application to patentability.

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