



COUNSEL TO GREAT COMPANIES

Tips & Tricks for Working with Patent Counsel to Obtain Valuable Patents

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Obtaining a Patent

- Patentability: **Is your invention patentable?**
- Filing a patent application: **What do we need to include?**
- Prosecution of the patent application: **When to file?**

How long does it take?

Patentability: **Is it patentable?**

- 35 U.S.C. § 101: **Patentable subject matter**
Utility – must be useful
- 35 U.S.C. § 102: **Novelty - must be new**
- 35 U.S.C. § 103: **Non-obvious – can't be obvious to a POSITA**

35 U.S.C. § 101: Patentable subject matter

- Manufactures
- Composition of matter
- Machine
- Process

35 U.S.C. § 101: Not patentable

Judicial Exceptions:

- **Abstract Ideas**
 - Mathematical concepts
 - Certain methods of organizing human activity (e.g., business methods)
 - Mental processes
- **Laws of nature**
 - *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289 (2012)
- **Natural phenomena/products of nature**
 - *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S.Ct. 2107, (2013)

35 U.S.C. § 101: USPTO Test for Eligibility

	Prior Guidelines	Revised Guidelines (2019):
Step 1	Do claims fall within the four statutory categories of patentable subject matter?	Do claims fall within the four statutory categories of patentable subject matter?
Step 2A	Is the claim directed to a law of nature, natural phenomenon, or abstract idea?	Prong 1: Is the claim directed to a law of nature, natural phenomenon, or abstract idea?
		Prong 2: Is judicial exception integrated into a practical application?
Step 2B	Does the claim recite additional elements that amount to “significantly more” than the judicial exception?	Does the claim provide an inventive concept?

35 U.S.C. § 101: *What a mess!*

- *Vanda Pharma Inc. v. West-Ward Pharma*, 887 F.3d 1117 (Fed. Cir. 2018)
 - Methods of treatment are patent eligible (affirmative administration steps)
- *Athena Diagnostics, Inc. v. Mayo Collaborative Services, LLC* (Fed. Cir. 2019)
 - Methods of diagnosing Myasthenia Gravis by detecting autoantibodies with labeled antigens not patent eligible
 - Holding that claims were directed to “well understood, routine, and conventional steps”
- *Cleveland Clinic v. True Health Diagnostics LLC* (Fed. Cir. 2019) (*non-precedential*)
 - USPTO’s guidance is not binding upon the Federal Circuit

Patentability: Barriers to getting a patent

- Prior art
 - First to File (AIA) – no more swearing behind references
 - 1-year “grace period” – but be mindful of foreign rights
- In public use, on sale, or otherwise available to the public
 - “secret sales” are still a bar

- Drafting the application: **What must be included?**

- Title
- Priority Claim
- Statement of federally sponsored research (if any)
- Background
- Figures
- Sequence Listing (if any)
- Detailed Disclosure
- Working Examples (if any)
- Abstract
- Claims
 - **Must be enabled**
 - **Must provide adequate written description**

- Drafting the application: **Where to start?**

- Working Examples
 - provide manuscripts, data, grant applications
- Claims
 - work with patent attorneys on:
 - commercial interest/embodiment(s)
 - case law pitfalls
 - potential competitor work-arounds
- Detailed Disclosure

Prosecution: **When to file & how long does it take?**

