

5 KEY TAKEAWAYS

35 U.S.C. § 101 in 2023 - Prosecution and Litigation Perspectives

[Kilpatrick Townsend](#) partners [Megan Bussey](#) and [Karam J. Saab](#) recently presented “35 U.S.C. § 101 in 2023 - Prosecution and Litigation Perspectives” at the firm’s annual three-day “Ski-LE” in Colorado.

Five key takeaways on “35 U.S.C. § 101 in 2023 - Prosecution and Litigation Perspectives” include:

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American Axle was expected to bring clarity to how courts should perform patent eligibility analyses under the Alice framework. With the Supreme Court having defined certiorari, courts continue to allow 35 U.S.C. § 112 to creep into their § 101 Alice framework analyses. *Interactive Wearables, LLC v. Polar Electro, Inc.*, which currently has a writ of certiorari pending before the Supreme Court, could provide clarity on this issue later in 2023.

Conclusory claim language (e.g., “configured to”), which defines the end result of a step or the output of a component without specifically detailing how the step is performed or component functions, has both advantages and disadvantages. Such claim language tends to be broad and can cover many ways of achieving the same end result. However, Federal Circuit opinions throughout 2022 highlight that such conclusory claim language is more likely to be found patent ineligible under 35 U.S.C. § 101 and be unlikely to survive scrutiny under either Step 1 or Step 2 of the *Alice* framework.

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In a litigation context, consider the strength of the claims vis-à-vis your goals, budget, and other intangibles, such as what type of motion you want to bring (Motion to Dismiss/ Motion for Summary Judgment) and who your audience is (where is your Court? Who is your Judge?).

While an analysis under 35 U.S.C. § 101 should focus on whether the patent application’s *claims* are directed to eligible subject matter, in 2022 courts continued to investigate patent specifications in performing their patent eligibility analyses. To the extent possible, while courts continue this practice, disclosure in a patent’s specification that highlight various technical embodiments and the technical benefits of the claimed invention is helpful to applicants in arguing for eligibility under § 101.

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A complaint asserting a claim that may be vulnerable to invalidity under 35 U.S.C. § 101 should include reference to the language in the specification supporting a finding that the claim is valid under the two-step Alice inquiry as well as additional allegations in support of the two-step analysis.

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