

Is 'Alice' in the Chemical Wonderland?

The Possible Impact of Alice v. CLS Bank on Chemical Inventions

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Patentability Requirements in the United States

- In the U.S., a patent application will generally be examined to ensure compliance with:
 - **35 U.S.C. 101 – Something that can be patented?**
 - 35 U.S.C. 102 – Is it new in view of the prior art?
 - 35 U.S.C. 103 – Is it non-obvious in view of the prior art?
 - 35 U.S.C. 112 – Does the application have
 - (1) An adequate description of the invention?
 - (2) Enough details to practice the invention?

So What Can Be Patented?

35 U.S.C. 101:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Inventions must be useful, novel, and non-obvious

Broad Types of Chemical Innovation

- Chemicals/Biochemistry, Instrumentation, Informatics
 - Compounds
 - Syntheses/manufacture
 - Modeling
 - Analytical instruments
 - Analytical processes
 - Diagnostic kits/diagnostic reagents
 - Microorganisms, virology, genetics
 - Vaccines
 - Plants
 - Medical devices

Alice v. CLS Bank (June 2014)

- Invalidated claims generally directed to a computerized method for performing a “form of escrow” designed to mitigate the risk that only one party to a financial transaction will perform its contractual obligations at settlement.
- Invalidated claims recite computer-implemented methods of settling financial transactions, as well as computer-readable media capable of storing, and generic computer systems capable of running, programming instructions for performing the claimed method.
- Claims directed to an “abstract” idea or a “generic computer” implementation of an abstract idea are ineligible for patent protection
- Imposed significant additional requirements

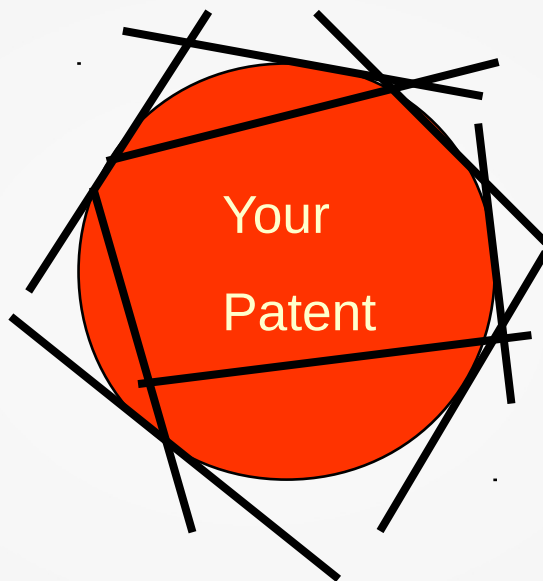
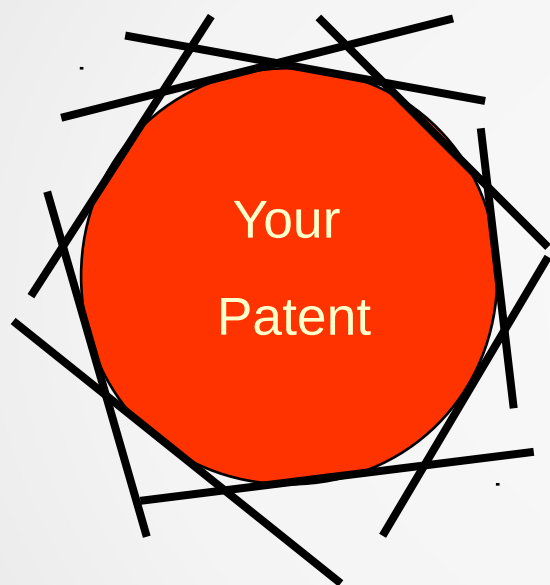
What is “Software?”

- Generally two main aspects for any type of software:
 - Algorithms, methods, and other general concepts that describe, at a high level, how the software operates; and
 - Actual computer code for implementing these concepts.
- Patents – generally seek to protect the former

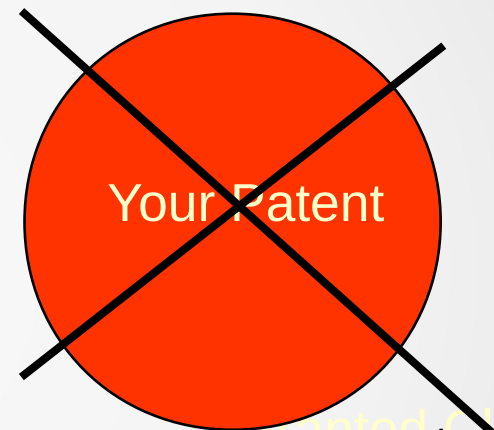
Software-Based Patents After Alice v. CLS?

- USPTO Examination (still developing)
 - (1) Is the claim directed to an “abstract” idea?
 - (2) If so, are there other claim features that show a patent-eligible application of the abstract idea, e.g., more than a mere instruction to apply the abstract idea?
- What does this mean?
 - Does the claim recite a way to use the abstract idea solve a technical problem?; or
 - Does the abstract idea provide some type of technical advantage?
- Is there a problem/solution or technical step type approach to determine patent eligibility?

Potential Impact to Chemical Patent



Granted Claims



Granted Claims

What Chemical Innovation Involves Software?

- Chemicals/Biochemistry, Instrumentation, Informatics
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Highly Speculative Risk Continuum

Lower Risk

Higher Risk

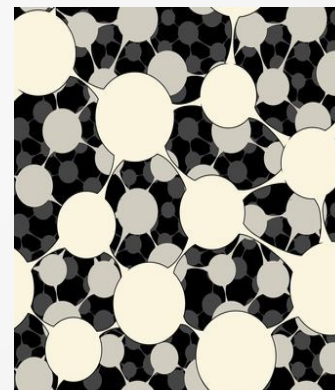
Compounds



Instrument
Post-processing



Informatics



Patented Claims

Valuation/Licensing?

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Questions?

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