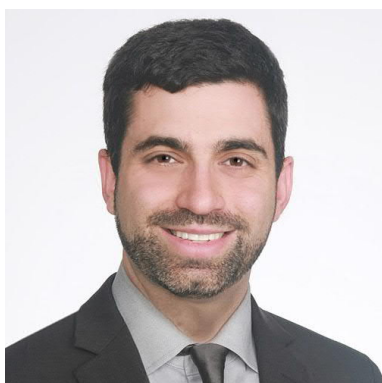


## **Abstract Guidance for Abstract Ideas: How 35 U.S.C. §101 Subject Matter Eligibility has Evolved Post-Alice and Tips for Strengthening Claims Directed to Computer-Implemented Inventions**

**Joel Gotkin (USA), Class of 2010/11**



Joel Gotkin is a 2011 graduate of the MIPLC and has been practicing as an attorney at Oliff PLC in the USA for eight years. Joel's work covers numerous aspects of patent law, including preparation, prosecution, post-grant actions and legal opinions. Joel counsels many clients, from individuals and small business owners to multinational corporations, about various aspects of intellectual property. Joel also travels frequently to lecture and train foreign and domestic clients about numerous issues relating to patent law. Joel focuses his practice mainly on software, biomedical and mechanical technologies.

### **Abstract**

Whether software-implemented inventions should be eligible for a patent has been a hotly contested topic in U.S. courts, particularly since the Supreme Court's 2014 Decision in *Alice Corp. v. CLS Bank*. This presentation will take a look back at the *Alice* decision, discuss the issues that the Supreme Court was trying to remedy, and highlight the issues that have developed as a result of the decision. In particular, the difficulties faced by the Patent Office to construct guidance to stay consistent with the *Alice* and subsequent Federal Circuit decisions, as well as with respect to interpretations being developed by the Federal Circuit and other courts will be discussed. The presentation will conclude with a discussion about a future outlook of subject matter eligibility in the U.S. and some considerations as to how the current approach can be improved.