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View from the Chair

Members:

As the new Chair of the Intellectual Property Law Section & Council, I am proud to report that the Council and the Institute of Continuing Legal Education (ICLE) have weathered the Covid storm and for the first time since 2019, both our spring and summer programs will be held in person. I would like to thank the previous Chair, Matthew Kendall, as well as ICLE and former council members Mary Margaret O'Donnell and Elizabeth Brock, for their contributions over these past few challenging years. Please mark your calendars for these upcoming events:

- **Spring Seminar** – Thursday, March 2, 2023 - Kellogg Center, East Lansing. We have lined up some exciting national and international speakers to present on timely topics and we hope you can all join us.
- **48th Annual IP Law Institute** – July 20-22, 2023 - Grand Hotel, Mackinac Island. Information will soon be sent out to all members, including programming and information on reserving rooms using our block rates.

In addition to planning our educational seminars, the Council has been busy working on Diversity, Equity and Inclusion (DEI) initiatives, including how we can reach out to high school and younger aged students to educate them about careers in IP. To that end, I am happy to report that the IP Section will be a sponsor at four robotics competitions held throughout Michigan in 2023, including the Calvin University Robotics Competition, the Bloomfield Girls Robotics Competition, the Rainbow Rumble and the Grand Rapids Girls Robotics Competition. We have also partnered with the COMETS 3357 Robotics Team to award a number of scholarships to students interested in IP careers who are participating in each of these competitions. Please contact Stuart Atwater (stu@atwaterattorneys.com) if you would like to get involved.

Other continuing initiatives include IPLS' support of the Michigan Pro Bono Patent Project which makes it easy to provide meaningful assistance to patent pro bono clients. It can also be a great training experience for newer patent attorneys and agents. Please contact David Willoughby (david.willoughby@gm.com) if you have any questions or if you would like to volunteer.

In addition, over the past few years IPLS has begun the process of establishing endowed scholarships at our law schools here in Michigan. In addition to the current scholarships at Wayne State University and Michigan State University, I am happy to report that we have now also established a scholarship at the University of Detroit

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View from the Chair

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Mercy. We are currently in the process of creating links on our State Bar website that will allow our members to make their own contributions to these endowments if they are interested.

In closing, I would like to give a great big "thank you" to you, all of our members, for your continued support as we adapted our programming the past few years to try to continue to meet your needs. We are so happy to be back in person and I can't wait to see you all in East Lansing and on Mackinac.

--Kimberly A. Berger

Upcoming Events

Intellectual Property Law Spring Seminar 2023

Live March 02, 2023, Kellogg Center, East Lansing

Join us in person for critical updates, expert insight from local and international IP leaders, and interactive discussions. There's something for everyone, whether you specialize in patent or trademark law. Gain strategies to protect brands from counterfeiters in both the real world and the metaverse. Grasp key differences between the Chinese and U.S. trademark systems and how they impact business. Decide whether to use Europe's new Unitary Patent System or avoid it.

You will be able to:

- Uncover the top 10 things in-house lawyers want outside counsel to know
- Understand the new procedures and changes brought by patent reform initiatives
- Employ effective takedown strategies involving trademarks in China
- Effectively opt in or out of the Unitary Patent System

To register, go to ICLE | Intellectual Property Law Spring Seminar 2023 or call 877-229-4350. We look forward to seeing you there in person!

48th Annual IP Law Summer Institute

July 20-22, 2023, Grand Hotel, Mackinac Island.

SAVE THE DATE! Information will soon be sent out to all members, including programming and information on reserving rooms using our block rates.

Interested in sponsorship opportunities? There's still time to be a sponsor for the IP Law Summer Institute. For more information, go to https://icle.org/sponsorship/ip/ and contact Lisa Geherin with any additional questions.

Including a Description of Technical Advantages During Patent Application Drafting May Help Patent Eligibility

By Gerald B. Halt Jr., Brandon R. Theiss

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Discussing the technical advantages of an invention, a standard practice in many jurisdictions such as before the European Patent Office, has long been disfavored in the US. However, recent Federal Circuit case law suggests that there may be significant value to be gained by discussing the advantages of the claimed invention in the context of the prior art in order to establish patent eligibility under 35 U.S.C. §101.

In the recent Federal Circuit Court of Appeals case of *Cooperative Entertainment, Inc. v. Kollective Tech, Inc.*, the Court reaffirmed the importance of the specification in establishing an inventive concept that is sufficient to pass the Supreme Court's two-step Alice framework for patent eligibility under 35 USC §101.

Specifically, in Cooperative, the Court found that claims in US 9,432,452 directed to a "system for virtualized computing peer-based content sharing" were potentially patent eligible because the patent describes "several alleged inventive concepts which the specification touts as specific improvements in the distribution of data compared to the prior art." For example, the court observed that "[t]he specification explains how claim 1's dynamic P2P network structure is different from and improves upon the prior art." In addition, the Court further observed that the specification expressly states the technical effect of the invention by stating "the present invention systems and methods provide increased reliability, more redundancy, and more efficient delivery than those of the prior art." As a result, the Court reasoned that because "useful improvements to computer networks are patentable regardless of whether the network is comprised of standard computing equipment," the claims of US 9,432,452 were potentially patent eligible under the two-step Alice framework.

Similarly, in *SRI Int'l, Inc. v. Cisco Sys.*, the Federal Circuit held that the claims in US 6,711,615 "improve the technical functioning of the computer and computer networks by reciting a specific technique for improving computer network security" were patent eligible under the two-step Alice framework based on the contents of the specification. Specifically, the court concluded that "[t]he specification bolsters our conclusion that the claims are directed to a technological solution to a technological problem" and identified that "[t]he specification explains that the claimed invention is directed to solving [identified] weaknesses in conventional networks." As a result of the teachings in the specification, the claims were found to be eligible under the two-step Alice framework because the specification explained how the "focus of the claims is on the specific asserted improvement in computer capabilities" —that is, providing a network defense system that monitors network traffic in real-time to automatically detect large-scale attacks." In view of these opinions, the specification of a patent can be the source of intrinsic evidence that the claimed invention is patent-eligible subject matter under the two-step Alice framework. However, the MPEP does not require explicit intrinsic support in the

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If interested, please contact LeKeisha Suggs (lekeisha.suggs@schaeffler.com).

specification to evidence eligibility under the two-step Alice framework. Instead, the MPEP states, "[t]he specification need not explicitly set forth the improvement, but it must describe the invention such that the improvement would be apparent to one of ordinary skill in the art." The MPEP further explains that "if the specification sets forth an improvement in technology, the claim must be evaluated to ensure that the claim itself reflects the disclosed improvement." Accordingly, although intrinsic evidence of the technical improvement recited in the specification is helpful in the determination of patent eligibility under the two-step Alice framework, the omission of an express disclosure does not necessarily doom the patent.

Nonetheless, the specification provides a significant opportunity for the Applicant for a US Patent to explain to a person of ordinary skill in the art the technological improvement of the invention as required to confer patentability before the USPTO. Perhaps more importantly, the specification provides an opportunity for the Applicant to explain to a court in a future litigation how the claimed invention provides a technological improvement over the prior art so that the Court, like in Cooperative and SRI, may find the claimed invention to be patent eligible under the two-step Alice framework.

Accordingly, an Applicant for a US patent should carefully consider putting at least a brief explanation of potential advantages of the claimed invention in the specification during drafting, balancing the risks against the difficulty in getting past a potential 35 U.S.C. § 101 rejection.

About the Authors

***Gerald B. Halt Jr.**, Shareholder, Volpe Koenig. Clients appreciate Jay's holistic and inventive approach to optimizing the value of their intellectual property portfolios. He collaborates with clients at all stages of development—from startup entrepreneurs to teams of engineers at Fortune 500 companies—to secure, manage and protect their IP, devising and implementing results-oriented strategies in order to provide peace of mind that those assets are secure. Well regarded for his skill in drafting and negotiating patent licensing agreements, agreements of sale, confidentiality agreements and non-disclosure agreements, Jay is also known for his experience and aptitude in performing due diligence, patentability, validity, and state-of-the-art analyses and opinions.*

***Brandon R. Theiss,** Attorney, Volpe Koenig. Brandon is an independent contractor with Volpe Koenig. He is a technology-first patent attorney with extensive experience in the complete patent lifecycle, from prosecution before the US Patent and Trademark Office through monetization and post grant challenges. As an inventor himself, Brandon appreciates the unique challenges associated with commercializing an idea and the value of obtaining the maximum patent prosecution. Drawing from his 10 years of industrial experience developing industrial control and automation systems, Brandon focuses primarily on medical devices, cloud computing and big data analytics.*

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