WINSTON & STRAWN LLP

SPEAKING ENGAGEMENT

Kathi Vidal Speaks at 24th Annual BCLT/BTLJ Symposium: The Roles of Technology Expertise in Law and Policy

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Where are we in terms of the 101 pendulum?

Post-*Alice*, the 101-based rejection rate in the Patent Office is up to 40% (from 20%) in key (and emerging) tech areas. The rejection rate in the courts has seen a 1056% increase. To date, there has been no authority that Step 1 of *Alice* involves underlying factual issues.

Indeed, *Berkheimer* and *Aatrix* stand only for the proposition that there may be underlying factual issues under *Alice* Step 2 as to whether what has been "added" to the abstract idea (or by extension the other two judicial-created exceptions to patentability) is "well-understood, routine, and conventional."

Kathi Vidal—Winston's Silicon Valley Office Managing Partner—was be joined by **Judge Jon Tigar** (ND Cal); **Judge Alan Albright** (WD Tex); **Judge Maryellen Noreika** (D Del), **John Desmarais,** Desmarais LLP; and **Sonal Mehta,** WilmerHale; on the panel **The Use of Technical Expertise in Patent Litigation: Claim Construction, Patent Validity, and Patent Infringement** moderated by **Morgan Chu,** Irell & Manella.

The panel explored the use of expert testimony on the issue of whether what was added to the abstract idea was "well-understood, routine, and conventional" and weighing that testimony against admissions in the specification and prior case law finding similar technology well-known. The panel discussed whether there is any role for expert testimony at Alice Step 1, including on the issue of preemption. Lastly, the panel discussed the conundrum of engaging in any Step 2 analysis if there is not a finding of abstract idea under Step 1. Other panel topics will include claim construction, obviousness and patent infringement.

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