Overcoming §101 Rejections for Computer and Electronics Related Patents
Leveraging USPTO Guidance and Recent Decisions to Meet 101 Patent Eligibility Requirements

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Today’s faculty features:

Charles Bieneman, Member, Bejin Bieneman, Detroit
Michael P. Shepherd, Principal, Fish & Richardson, Redwood City, Calif. & New York

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§ 101 Rejections and Computer-Implemented Inventions

Charles Bieneman of Bejin Bieneman
Michael Shepherd of Fish & Richardson

April 19, 2018
**Overview of the Mayo/Alice Test**

*Alice*, following *Mayo*, outlined a two-step framework to determine whether claims are patent-eligible:

- Under *Alice* step 1, “We must first determine whether the claims at issue are directed to a patent-ineligible concept.”
- Under *Alice* step 2, if the answer to step 1 is no, “we ‘consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent eligible application.”

A claim that recites an abstract idea must include “additional features” to ensure “that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].” *citing Mayo v. Prometheus.*
**But... What is an “Abstract Idea”?**

- Nearly four years after *Alice*, courts still spend vast amounts of time trying to figure out what it means to be an abstract idea.

- Judges talk about there being “silos” of things that qualify:
  1. Things that are not well-defined enough. These types of inventions mesh with the dictionary definition of “abstract.”
  2. A hodgepodge of other things that you can’t patent no matter how well defined the claims are and no matter how valuable or useful the technology is:
     1. too business-like
     2. things performed by humans
     3. things with non-technological analogues (electronic spreadsheets?)
     4. mundane software systems (filling out forms?)
• What does it mean to be inventive?

  • “The ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possible patentable subject matter.” *Diamond v. Diehr*.

  • *But for example...*”The claims of the ’298 patent fail to provide an inventive concept. The ’298 patent teaches a method that is repeatedly and explicitly referred to as “computer-implemented.” . . . It further teaches a “computer system” comprised of “a server” and a “file identification application,” id. col. 13 l. 7, 8, 11, but it never suggests that any of these computer components are non-generic.” *IV v. Erie* (2017)
Examiners also find the Alice inquiries hard to apply.

There are many pro forma Section 101 rejections

- “The claims are directed to an abstract idea without significantly more.”
- “The claims do not include additional elements that are sufficient to amount to significantly more than the judicial exception.”
Recent case law suggests a shift towards more predictability in the *Alice* test

*Alice* step 1 v2: “Is there a technological improvement to a technological problem?”
- Can the hodgepodge of abstract idea categories be coherently analyzed as non-“technological improvements”?

*Alice* step 2 v2: “Is the technology well-understood, routine, and conventional?”
- I.e. no inventive concept if there are no unconventional elements or combinations
Finding available real estate is not a technological problem

“...  
  f) selecting a second area having boundaries within the zoomed first area;  
   g) displaying the second area and a plurality of points within the second area, each point representing the appropriate geographic location of an available real estate property; and  
      h) identifying available real estate properties within the database which are located within the second area.”

While the ideas of storing available real estate properties in a database and selecting and displaying a particular geographic area may well be improvements in the identification of available real estate properties, there is no evidence that these ideas are technological improvements.” Move, Inc. v. Real Estate Alliance et al. (Feb. 2018).
• Selling more gelato is a nontechnological problem.

1. An interactive selling system comprising:
   a data processing device;
   a human consumable product;
   a concealed flavor associated with said human consumable product; and
   a code carried by said human consumable product that by itself cannot reveal said concealed flavor to a consumer;
   said code and said data processing device induce the consumer to purchase said human consumable product because the consumer can relay said code to said data processing device which then determines for the consumer said concealed flavor based upon said code.

• *Ex Parte John Brian Bartels (PTAB 2018)*
Berkheimer v. HP Sheds Light on “Conventional”

• Berkheimer provides important clue about what it means to be conventional.
• In particular, “conventional” means being more well-known than appearing in a single prior art reference.
• “conventional” > prior art
  • “Whether a particular technology is well-understood, routine, and conventional goes beyond what was simply known in the prior art. The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional.” Berkheimer v. HP.
Roughly 95% of Section 101 rejections are affirmed on appeal by the PTAB.

The Board is more than willing to rescue deficient examiner rejections.

Unlike a Section 103 rejection, the Board can provide all pieces of the Section 101 analysis.

Therefore, the merits are more important to the PTAB than procedural deficiencies.
PTAB practice largely already aligns with the new formulations
  • The claims had a technological improvement
  • The claims recited unconventional features
Procedural attacks sometimes work, but not nearly as well
  • The examiner provided insufficient analysis
  • The examiner made only conclusory statements
• Emphasize the merits of the shifting Section 101 inquiries and hammer home the examiner’s failure to raise or rebut

1. The claims provide a technological improvement to a technological problem (and the examiner has not rebutted the improvements)

2. The claims recite features that are unconventional (and the examiner has not demonstrated that the claim features are conventional)

3. Place less priority on perceived procedural deficiencies or failure to follow USPTO guidance
What’s Next?

- New USPTO Director Andrei Iancu goal: more predictability

- "Folks need to be able to make investments into their own technologies, they need to be able to invest and invent around technologies. ... For the whole system to work, we all need to know whether the rights are good rights and what the boundaries of those rights are."

- Expect the shifting eligibility inquiries from recent case law to make their way more prominently into USPTO guidance and practice
Thank You

Michael Shepherd
Principal – Silicon Valley
650-839-5165
mshepherd@fr.com

FISH.
• Patent-eligibility is highly subjective (obviously)
  • The two-part test is really a one-part test
  • Different judges (whether Article III or PTAB) reach different results
    • Gray area: software “per se” is not patent-ineligible, but odds approach zero for claims performed manually / mentally
• Draft applications to state a technical solution to a technical problem
• Argue patent-eligibility by showing a technical solution to a technical problem
• Interview examiners
• The filing calculus has changed (Some subject matter is now out)
  • More emphasis on trade secrets
Inventions patentable. 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 therefor, subject to the conditions and requirements of this title, so long as the claimed invention (1) is not an abstract idea or law nature without (2) significantly more.

- 35 U.S.C. § 101 (as modified by the courts in Mayo, Alice, etc.).
• Go to USPTO’s “Subject matter eligibility” page

• Select “Chart of subject matter eligibility court decisions”
ULTRAMERCIAL, INC. v. HULU, LLC (Nov. 14, 2014)

• Went to S. Ct. twice; Fed. Cir. (Judges Lourie, Mayer, and O’Malley) invalidated on third go-round Claims were directed to a “method for distribution of products over the Internet via a facilitator,” i.e., to select and display content in exchange for payment.

• Judge Mayer concurs: “I agree that the claims . . . are ineligible for a patent, but write separately to emphasize three points.”
  • First, whether claims meet the demands of 35 U.S.C. § 101 is a threshold question, one that must be addressed at the outset of litigation.
  • Second, no presumption of eligibility attends the section 101 inquiry.
  • Third, [Alice], for all intents and purposes, set[s] out a technological arts test for patent eligibility.
    • “Because the purported inventive concept in Ultramercial’s asserted claims is an entrepreneurial rather than a technological one, they fall outside section 101.”
• Patent claims at issue were directed to managing the look and feel of e-commerce web pages to provide “store within a store” functionality to product pages.

• Majority (Judges Chen and Wallach): “problem of retaining website visitors,” which had no analog in the bricks-and-mortar world.
  • “[T]he claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.”

• Judge Mayer dissented: claimed abstract idea is “that an online merchant’s sales can be increased if two web pages have the same “look and feel”—and apply that concept using a generic computer.”

• Thus, majority stated that Problem was “the problem of retaining website visitors that, if adhering to the routine, conventional functioning of Internet hyperlink protocol, would be instantly transported away from a host’s website after ‘clicking’ on an advertisement and activating a hyperlink.”
Can Ultramercial and DDR be Reconciled?

• Judge Chen: Ultramercial claims “broadly and generically claim ‘use of the Internet,’” whereas DDR Holdings claims “how interactions with the Internet are manipulated to yield a desired result—a result that overrides the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink.”

• Judge Mayer in DDR did not bother to mention Ultramercial: the DDR patent claims simply took the old and well-known idea of having a “store within a store” and applied it to the Internet.
  • Under Alice, the appropriate test is a “technological arts” test.

• Both cases were designated “precedential.”

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“Patented logical model” of U.S. Patent Nos. 6,151,604 and 6,163,775 “include[d] all data entities in a single table, with column definitions provided by rows in that same table.”

Rejected the idea “that claims directed to software, as opposed to hardware, are inherently abstract.”

Claims here “are directed to a specific implementation of a solution to a problem in the software arts.

- The self-referential table achieved computing efficiencies.
- No abstract idea (2nd prong of Alice/Mayo test not reached).

“Technical effect” test!
• Affirmed invalidity of claims of U.S. Patent Nos. 7,233,843; 8,060,259; and 8,401,710, directed to “real-time performance monitoring of an electric power grid.”
  • Representative claim, over a page long, recites “[a] method of detecting events on an interconnected electric power grid in real time over a wide area and automatically analyzing the events on the interconnected electric power grid.”

• Abstract idea: “a process of gathering and analyzing information of a specified content, then displaying the results.”

• No significant additional innovation: claims were simply directed to analyzing data, and not (unlike claims in *Enfish*) to improving computing performance.

• Claims could preempt other from solving the problem of “monitor[ing] and analyze[ing] data from multiple distinct parts of a power grid.”

• **Technical environment not enough without technical solution.**

• Opinion by Judge Taranto, joined by Judges Bryson and Stoll.
Federal Circuit held that claims to “automatically animating lip synchronization and facial expression of animated characters” are patent-eligible.

Parties tried to rely on 1980s U.S. S. Ct. cases: *Diamond v. Diehr* (patent owner) and *Parker v. Flook* (accused infringer).

Fed. Cir. Applied *Alice* test:

*By incorporating the specific features of the rules as claim limitations, claim 1 is limited to a specific process for automatically animating characters using particular information and techniques and does not preempt [different rules or] approaches.*

*When looked at as a whole, claim 1 is directed to a patentable, technological improvement over the existing, manual 3-D animation techniques . . . to achieve an improved technological result.*
• Claims U.S. 5,987,606, directed to "content filtering information retrieved from an internet computer network," recited an "inventive concept“ and held patent-eligible.
  
  • “a remote ISP server coupled to said client computer and said Internet computer network, said ISP server associating each said network account to at least one filtering scheme and at least one set of filtering elements, said ISP server further receiving said network access requests from said client computer and executing said associated filtering scheme utilizing said associated set of logical filtering elements.”

• Rare case where 2\textsuperscript{nd} prong of test saved the claim; majority opinion (Judges Chen and O’Malley) agreed claim was drawn to abstract idea of filtering content (Judge Newman concurred in the result).

• Claim recited generic computer technology but also recited "a technology-based solution (not an abstract-idea-based solution implemented with generic technical components in a conventional way) to filter content on the Internet that overcomes existing problems with other Internet filtering systems."
  
  • The dynamic filtering system improved a computer's performance.
• Independent claims of U.S. Patent No. 6,474,159:

  1. A system for tracking the motion of an object relative to a moving reference frame, comprising:

   a first inertial sensor mounted on the tracked object;

   a second inertial sensor mounted on the moving reference frame; and

   an element adapted to receive signals from said first and second inertial sensors and configured to determine an orientation of the object relative to the moving reference frame based on the signals received from the first and second inertial sensors.

   * * *

  22. A method comprising determining an orientation of an object relative to a moving reference frame based on signals from two inertial sensors mounted respectively on the object and on the moving reference frame.
• District Ct.: “the claims (1) are directed to the abstract idea of using laws of nature governing motion to track two objects, and (2) provide no inventive concept beyond the abstract idea.”

• Federal Circuit: “[f]or the purpose of evaluating patent eligibility, the ’159 patent claims are nearly indistinguishable from the claims at issue in” *Diamond v. Diehr*, 450 U.S. 175 (1981) (claims directed to use of known formula for curing rubber were patent-eligible).
  
  • Claims were “not merely directed to the abstract idea of using "mathematical equations for determining the relative position of a moving object to a moving reference frame.”
  
  • Rather, the claims are directed to systems and methods that use inertial sensors in a non-conventional manner to reduce errors in measuring the relative position and orientation of a moving object on a moving reference frame.
US Patent No. 8,005,303 claimed “[a] method for creating a composite image” of facial features.

- “[S]electing a facial feature image from the first area . . ., [and incorporating] the selected facial feature image into a composite image . . . associated with a composite facial image code having at least a facial feature element code . . . derived by performing at least one multiplication operation on a facial code using one or more code factors . . .”

Claim 1: “abstract idea of encoding and decoding image data.”
- “. . . an abstract concept long utilized to transmit information.”
- Analogous to “Morse code, ordering [fast] food . . . via a numbering system, and Paul Revere's 'one if by land, two if by sea' signaling system.”

Distinguished from *Diamond v. Diehr*: “[O]utside of the math, claim 1 . . . is not directed to otherwise eligible subject matter.”

Distinguished from *Enfish*: computers just a tool – not improved.

The “particular [claimed] encoding process” not “inventive” (*Alice* Step 2).

Claims analogous to old manual processes are in trouble!
• Claim 1 of U.S. Patent No. 5,953,740:

A computer memory system connectable to a processor and having one or more programmable operational characteristics, said characteristics being defined through configuration by said computer based on the type of said processor, wherein said system is connectable to said processor by a bus, said system comprising:

a main memory connected to said bus; and

a cache connected to said bus;

wherein a programmable operational characteristic of said system determines a type of data stored by said cache.
NVIDIA: the “programmable operational characteristic” was simply functionality for storing data.

Judge Hughes: the claims simply applied the abstract idea of categorical data storage in a generic computing environment.
   - Technical description (appended microfiche code) irrelevant because didn’t limit the claims.

Majority: claim 1 recited hardware and how it was configured; not just an abstract “black box”:
   - (1): ’740 patent included computer code in a microfiche appendix.
   - (3): Dissent wrongly assumed that the innovative effort lay in the programming; the “improved memory system is achieved by configuring a programmable operational characteristic of a cache memory based on the type of processor connected to the memory.”

Lessons:
   - (1) great example of how many cases could go either way.
   - (2) Put as much technical detail in your specification as possible – and try to “tether” the claims to it.
Seven patents:

- “[A] sender affixes an identifier on the outer surface of a mail object” prior to sending, and “[c]omputers and networks are used to communicate the information about the mail object’s contents and its sender after the mail object is delivered.”

Abstract idea: “using a marking affixed to the outside of a mail object to communicate information about the mail object...”

No inventive concept in actions based on “submitting a mail object to a mail carrier or affixing information to a mail object.”

This case is a classic example of how a “technical environment” by itself will not save.

- Processes that can be easily analogized to well-known or “routine” (human) practices are very susceptible to patent-ineligibility.
1. A computing device comprising a display screen, the computing device being configured to display on the screen a menu listing one or more applications, and additionally being configured to display on the screen an application summary that can be reached directly from the menu, wherein the application summary displays a limited list of data offered within the one or more applications, each of the data in the list being selectable to launch the respective application and enable the selected data to be seen within the respective application, and wherein the application summary is displayed while the one or more applications are in an un-launched state.

US 8,713,476

1. A method for transmitting message packets over a communications network comprising the steps of:

converting a plurality of streams of audio and/or visual information into a plurality of streams of addressed digital packets complying with the specifications of a network communication protocol,

for each stream, routing such stream to one or more users,

controlling the routing of the stream of packets in response to selection signals received from the users, and

monitoring the reception of packets by the users and accumulating records that indicate which streams of packets were received by which users, wherein at least one stream of packets comprises an audio and/or visual selection and the records that are accumulated indicate the time that a user starts receiving the audio and/or visual selection and the time that the user stops receiving the audio and/or visual selection.

US 5,778,187
• Claimed “method for transmitting message packets over a communications network” is just “abstract manipulation of data.”
  • Recitation of “functional results ‘converting,’ ‘routing,’ ‘controlling,’ ‘monitoring,’ and ‘accumulating records’ . . . does not sufficiently describe how to achieve these results in a non-abstract way.”

• No inventive concept at step 2.
  • Technical architecture was disclosed but not claimed.
  • Patent owner argued that the claims solve technical problems related to excessive loads, network congestion, and scalability, but the claim “only uses generic functional language to achieve these purported solutions.”
• Claim 1 of U.S. Patent No. 6,154,844:

A method comprising:

receiving by an inspector a Downloadable;

generating by the inspector a first Downloadable security profile that identifies suspicious code in the received Downloadable; and

linking by the inspector the first Downloadable security profile to the Downloadable before a web server makes the Downloadable available to web clients.

• Claims not abstract because they recite “specific steps – generating a security profile that identifies suspicious code and linking it to a downloadable – that accomplish the desired result.”

• Improvement under Enfish: the method here “employs a new kind of file that enables a computer security system to do things it could not do before.”
Claim to a “computing device . . . configured to display on the screen a menu listing one or more applications” survives because “claims focused on various improvements of systems” are “patent-eligible under § 101.”

- *Visual Memory LLC v. NVIDIA Corp.* (Fed. Cir. 2017): improved computer memory system with “programmable operational characteristics” was patent-eligible.

Claims were directed not to the pre-existing “generic idea of summarizing information,” but rather encompassed “a particular manner of summarizing and presenting information in electronic devices.”

- Claims result “in an improved user interface for electronic devices.”
- **Patent specification supported finding that the claims recited an improvement to computing devices.**
  - Explained problems in scrolling and switching views in conventional mobile device interfaces.
  - Also talked discussed improving device efficiency by its organization of menu information.
1. A method of archiving an item comprising in a computer processing system:

   presenting the item to a parser;

   parsing the item into a plurality of multi-part object structures wherein portions of the structures have searchable information tags associated therewith;

   evaluating the object structures in accordance with object structures previously stored in an archive;

   presenting an evaluated object structure for manual reconciliation at least where there is a predetermined variance between the object and at least one of a predetermined standard and a user defined rule.

4. The method as in claim 1 which includes storing a reconciled object structure in the archive without substantial redundancy.
• Claim 1 was not necessarily representative of dependent claims.

While patent eligibility is ultimately a question of law, the district court erred in concluding there are no underlying factual questions to the § 101 inquiry. [Citation omitted.] **Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.**

• Claim 1 held directed to the abstract idea of parsing, comparing, and storing information with no significant inventive concept.

• Summary judgment vacated and remand to consider whether claims 4-7 “contain limitations directed to the arguably unconventional inventive concept” of, to quote claim 4, “storing a reconciled object structure in the archive without substantial redundancy.”

  • There were questions of fact concerning “whether claims 4-7 archive documents in an inventive manner that improves these aspects of the disclosed archival system.”
• Representative claim 1 of US 7,171,615 directed to “data processing system for designing, creating, and importing data into, a viewable form.”

• Unanimity that “[t]he district court erred in holding claim 1 ineligible because it was directed to intangible matter and should have instead performed an Alice/Mayo analysis of claim 1.

• Majority vacated and remanded Rule 12(b)(6) dismissal of all claims.
  • “[T]he proposed amended complaint . . . alleges facts directed to the inventive concepts in its claimed invention” that, if true, could allow the patent claims to survive an Alice challenge, e.g., that the recited data file was a technical improvement, and one that increased computing efficiency.
  • Patent-eligibility ultimately is a question of law, but, “like many legal questions, there can be subsidiary fact questions which must be resolved in route to the ultimate legal determination.”

• Judge Reyna objected to the majority’s attempt “to shoehorn a significant factual component into the Alice § 101 [legal] analysis.”
  • Majority opened the door to “an inexhaustible array of extrinsic evidence, such as prior art, publications, other patents, and expert opinion.”
  • Majority seem to suggest claim construction might be necessary even when claim constructions had not been presented.
Expert Testimony to Save Eligibility?


  - Patent owner argued that *Berkheimer* compelled reversing and remanding back to the district court based on an alleged “genuine issue of material fact” concerning whether the patent claims in dispute “improve remote data mirroring in ‘an inventive manner’ or perform ‘well-understood, routine, and conventional activities to a skilled artisan.’”

  - But the district court had in fact provided detailed findings that the claims did not encompass an inventive concept.

  - Patent owner offered no “evidence to show that the order of the steps was unconventional.”

  - IV could have provided expert testimony to show unconventionality, but it had not done so.
  - Claim 29 of U.S. 6,959,293 recites “[a] method of analyzing parameters associated with an event by an electronic device.”
  - Expert declaration stated that updating classification criteria while a histogram is being formed, based on statistical information, was an innovative approach to analyzing parameters associated with an event.
  - Court agreed claim 29 is directed to an abstract idea, “a general process of collecting data, and analyzing the data using techniques that could be accomplished mentally or with the aid of a pen and paper.”

• *Move, Inc. v. Real Estate Alliance* (Fed. Cir. Feb 1, 2018) – aff’d summary judgment of Section 101 invalidity of “method using a computer for locating available real estate properties.”
  - Abstract idea: “a method for collecting and organizing information about available real estate properties in displaying this information on a digital map that can be manipulated by the user.”
  - Expert couldn’t save under *Alice* step 2: an “expert’s conclusory declaration” that the zoom feature was new, was not enough to “satisfy the inventive concept requirement.”
• Technical problem-solution approach.
• Don’t be you own lexicographer.
• The new importance of preambles.
• Defining terms.
• Take care with functional claiming.
• Interview! Talk to examiners.
The Problem-Solution Approach

- **Why:** claims pass *Alice* if they provide a technical solution to a technical problem.

- **Old thinking:** state a problem or need very broadly if at all. The drafter should take care that claim scope is not limited to solving a stated problem to avoid limiting claim construction.

- **New thinking:** the drafter should state a technical problem that is being solved to limit claim scope to a technical solution.
  - Describe technology in as much detail as possible; “tether” to claims.

- **Example:** “Computers running ABC apps typically receive data in X format. This is a problem because web browsers need data in Y format. Disclosed herein is receiving data in a computer in X format, and **more quickly and consuming less memory resources** converting the data to Y format.”

- **Authority:** Ultramercial (Mayer), DDR Holdings, Enfish; Epicor Software Corp. v. Protegrity Corp., (PTAB CBM April 18, 2016); *Core Wireless* (Jan. 2018); *Visual Memory* (2017).
Use Terms of Art

• **Why**: Claim terms that are not terms of art invite the problems of functional claiming, plus indefiniteness attacks.
  • Terms that are not terms of art are almost inherently non-technical abstractions.

• **Old thinking**: invented terms provide latitude in claim construction, so use them.

• **New thinking**: invented terms provide latitude for invalidity attacks, so avoid them.
  • Even if it seems counter-intuitive that you are describing and claiming the feared “generic computer technology.”

• **Examples**:
  • “a computer” and not “a weather analyzer”
  • a “lidar sensor” or “a camera,” and not “an image data mechanism”

• **Authority**: for starters, *Williamson v. Citrix* and *Alice*
**Explicitly Define Key Terms**

- **Why:** keep it technical: claim terms can be read as directed to an abstract idea if they can be read to encompass non-technical features.

- **Old thinking:** the drafter should be careful in defining terminology in a way that could subsequently limit a claim construction, i.e., an attempt to accuse an infringing product.

- **New thinking:** the drafter should define terms to preclude non-technical definitions from being included in claim scope.

- **Example:** claim recites “receiving image data.”
  - Define image data so it could only be found in a machine environment, *e.g.*, “image data” means “a digital representation of an image, i.e., a pixel map or other representation of an image including numeric values stored a file and usable to render an image in an electronic display.”

- **Authority:** *E.g.*, Electric Power Group, Two-Way Media; see also Epicor Software Corp. v. Protegrity Corp., CBM2015-00006 (PTAB April 18, 2016).
Provide Detailed Process Descriptions

- **Why:** more detail = less abstraction.

- **Old thinking:** none – detailed process flows have always been a good idea.

- **New thinking:** see above: supplement “black boxes” in block diagrams with as much detail as possible concerning algorithms implemented in the black boxes.
  
  - Talk about how specific process steps contribute to a technical improvement.

- **Example:** Claims recite an “actuator:” include flowcharts and, if appropriate, other diagrams, describing operation of the “actuator” and how you improve it.

- **Authority:** Visual Memory
Examiner has initial burden: *Mayo/Alice* is two-part test.

Abstract idea stated with specificity; all claim elements addressed?

- “Claims are directed to the abstract idea of processing data,” without additional explanation accounting for specific claim recitations, does not meet the burden.

- “Significantly more” addressed with more than conclusory statement?

Is the Examiner considering the claim as a whole?

- Watch out for piecemeal rejections – just as with prior art rejections.
ADDRESSING REJECTIONS

• Interview!
  • Different art units apply Mayo and Alice differently.
  • An amendment you might not think of may cure the rejection.

• Arguments:
  • Present claims are like a specific Fed. Cir case (or Example __ from the Guidelines).
  • Claims solve a technical problem.
    • *Enfish, McRO, Core Wireless*: improve machine or machine-only solution?
  • Non-abstractedness flows from elements not taught or suggested by the prior art (but only if responding to Examiner’s allegation).

• Amend for appeal (be sure claims support arguments).
THANK YOU!

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