

4 Tips For Overcoming 'Abstract Idea' Rejection

Law360, New York (October 5, 2016, 12:16 PM EDT) -- The case law has been pretty brutal for patent owners and patent applicants as of late regarding 35 U.S.C. §101 abstract idea rejections for computer-based inventions. However, there have been a few Federal Circuit cases that have provided a little hope and guidance for trying to overcome such rejections, if you are unfortunate enough to get one in the future. Absent a computer-based invention that improves the operability of the computer itself or that improves an existing technological process, such as the Enfish self-referential database that improves the operability of a computer, provided below are a few things that may improve your chances before a U.S. patent examiner.



Phillip Articola

Enfish Guidance — Blow Your Own Horn!

In *Enfish v. Microsoft Corporation* (Fed. Cir., May 12, 2016), the Federal Circuit found that the claims were not directed to an abstract idea, and thus, under the first step of the two-step Alice/Mayo inquiry, the claims passed muster as reciting patent eligible subject matter. In making this determination, the Federal Circuit noted that “the claims are directed to an improvement of an existing technology [that] is bolstered by the specification’s teachings that the claimed invention achieves other benefits over conventional databases, such as increased flexibility, faster search times, and smaller memory requirements.” The Federal Circuit cited with approval a prior case, *Openwave Sys. Inc. v. Apple Inc.* (Fed. Circ. 2015), in which a patent specification’s disparagement of the prior art was found to be relevant to determine the scope of the invention and the differences of the invention with respect to the prior art.

A lesson learned from the Enfish case is to describe in some detail in the patent application the advantages of the invention over the prior art, to the extent known by the applicant. This is especially the case for computer-based inventions if those advantages improve the operability of a computer or a network on which the computer resides in some manner. That way, an argument can be made in response to a rejection of the claims under 35 U.S.C. §101 that the claims are directed to an improvement in the functionality of a computer as opposed to being directed to an abstract idea, and thus pass muster under step one of the Alice/Mayo two-step test.

Affinity Labs Guidance — Check Your Title and Amend if Necessary

In *Affinity Labs v. DirecTV* (Fed. Cir., Sept. 23, 2016), the Federal Circuit found that Affinity’s claims were directed to an abstract idea. The Federal Circuit first stripped the claims of excess verbiage, and determined that claims are “directed to a network-based media system with a customized user interface, in which the system delivers streaming content from a network-based resource upon demand to a handheld wireless electronic device having a graphical user interface.” The Federal Circuit then determined that the claims do not represent “an improvement in the functioning of a computer,” but rather

merely “add conventional computer components to well-known business practices.” As such, by applying step one of the Alice/Mayo two-step test, the Federal Circuit determined that the claims were directed to an abstract idea.

The Federal Circuit then moved to step two of the Alice/Mayo two step test, in which a determination was made as to whether the claims include “significantly more” than an ineligible abstract idea. In making a determination that the claims did not include “significantly more,” the Federal Circuit noted that the title of the patent, “System and Method to Communicate Targeted Information,” was pretty much unrelated to the pending claims. Since the title of the invention was presumably the initial basis of patentability of the application in the mind of the applicant, and since the claims did not include features similar to those of the title, the Federal Circuit appeared to conclude that the claims on appeal are directed to something different than what was originally considered to be inventive. While this determination does not appear to be the primary basis of the Federal Circuit’s decision that the claims did not pass muster under step two of the Alice/Mayo two-step test, it certainly did not help the patentee’s cause in asserting that the claims did recite significantly more than an abstract idea. The scary thing here was that the patented claims were exactly the same as the originally filed claims, and so the applicant should have chosen a better title more suitable to the original filed claims at the time the application was filed.

A lesson learned from the Affinity case is to make sure that the title of the application as filed is commensurate with the broadest claim. Further, while this did not occur in the Affinity patent prosecution, one should amend the title during prosecution if necessary, based on amendments made to the claims to overcome a 35 U.S.C. §101 abstract idea rejection.

Bascom Guidance — Recite Claim Features That Provide a Practical Application to Abstract Idea

In *Bascom Global Internet v. AT&T Mobility LLC* (Fed. Cir., June 27, 2016), the Federal Circuit analyzed Bascom’s claims, and found that while they were directed to an abstract idea based on application of step one of the Alice/Mayo two-step test, the ordered combination of claim limitations in Bascom’s claims “transform the abstract idea of filtering content into a particular, practical application of that abstract idea,” and thus those claims “pass step two of Alice’s two-part framework.” In Bascom’s patent, the innovation was providing an internet content filter at a particular network location “to give users the ability to customize filtering for their individual network accounts.”

The lesson learned from the Bascom case is to try to recite in the claims a practical application for the invention, such as a different location of a claim element as compared to conventional approaches. That way, one can get around the rejection of an abstract idea of “the idea of itself.” Providing such an explanation in the specification of the practical application of the invention would also be very helpful in trying to overcome a 35 U.S.C. §101 abstract idea rejection.

McRO Guidance — Add Specific Limitations to the Claims

In *McRO Inc. v. Bandai Namco Games America* (Fed. Cir., Sept. 13, 2016), the Federal Circuit held that McRO’s claims directed to automating a 3-D animator’s tasks recite the use of rules with specific characteristics, in which the rules are applied to “each sub-sequence ... of timed phonemes.” From this determination, the Federal Circuit found that “[t]he specific

claimed features of these rules allow for improvements realized by the invention.” Due to the recitation of rules in the claims, the Federal Circuit went on to find that the “limitations of claims 1 prevent preemption of all processes for achieving automated lip-synchronization of 3-D characters,” which is an important consideration when determining whether a claim does not recite patent eligible subject matter. This is based on the U.S. Supreme Court holding in *Mayo*, that “the concern underlying the exceptions to § 101 is not tangibility, but preemption.” Since McRO’s claim 1 “requires that the rules be rendered in a specific way,” the Federal Circuit found that there is no preemption of “all rules-based means of automated lip synchronization, unless the limits of the rules themselves are broad enough to cover all possible approaches.” Since that was not the case regarding McRO’s rules, the claims passed muster as being patent eligible under 35 U.S.C. §101.

A lesson learned from the McRO case is to work with the inventor(s) and draft your patent specification to include one or more rules that can be applied to the invention, if possible, to overcome any potential preemption issues if/when you get a 35 U.S.C. §101 abstract idea rejection.

—By Phillip Articola, Banner & Witcoff Ltd.

Phillip Articola is of counsel in Banner & Witcoff's Washington, D.C., office.

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