



35 USC 101 Subject Matter Eligibility Cases Involving Software-Related Inventions

Eligible and Ineligible Court of Appeals for the Federal Circuit (CAFC) cases are described along with practice hints on how to be consistent with the eligible cases and distinguish the ineligible cases.

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¹ Opinions stated in this paper may not be consistent with the firms, corporations, or clients affiliated with the authors.

Introduction

Overview: In 2014, the U.S. Supreme Court decided *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, which dealt with whether patent claims directed to a computer-implemented scheme for mitigating “settlement risk” were patent eligible under 35 U.S.C. §101, or were instead drawn to a patent-ineligible abstract idea. The Court found that the claims were drawn to the abstract idea of intermediated settlement, and that merely requiring generic computer implementation failed to transform that abstract idea into a patent-eligible invention.

This document provides a digest of the current patent eligibility caselaw in the wake of *Alice* from a software related inventions perspective.

Discussion: The constitutional basis for the patent system is in Article I, Section 8, Clause 8 of the U.S. Constitution, which states that “[c]ongress shall have the power... [t]o promote the progress of science and **useful arts**, by securing for limited times to authors and **inventors** the exclusive right to their respective writings and **discoveries**” (emphasis added). Of particular note in this passage is that there is no mention of business methods or “abstract ideas.”

Congress:

The Patent Act states that “[w]hoever 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.” Therefore, the code establishes broad categories of patent protection -- processes, machines, manufacture, or composition of matter.

The Patent Act expands on what is “new” in §§ 102 and 103. For example § 102 prohibits patenting of inventions that were previously disclosed or patented, identically, by others (i.e., requiring novelty in view of the prior art) and §103 prohibits patenting of inventions that were previously disclosed or patented, with only obvious differences, by others (i.e., requiring non-obviousness in view of the prior art). Moreover, § 112 of the Patent Act provides additional conditions and requirements with regard to clarity and specificity.

The America Invents Act (AIA) touched on patent eligibility concerns by providing additional mechanisms to challenge issued patents. For example, Covered Business Method (CBM) protection is a transitional program that sunsets on September 16, 2020 and provides the ability to challenge the validity of granted business method patents at the PTO (lack of novelty, obviousness, lack of clarity/specificity). In order to trigger CBM review, the challenger must show that the patent claims are directed to “financial products or services” and the patent claims do not recite a “technological invention.” A technological invention as a whole claims a technological feature that is novel and unobvious over the prior art and solves a technical problem using a technical solution. CBM eligibility therefore includes patentability considerations. The AIA also includes Post Grant Review (PGR) and Inter Partes Reexamination (IPR) as other administrative options for challenging patent validity. PGR and IPR challenges are not limited to business method patents. The AIA provisions of CBM, PGR and IPR do not mention the concept of “abstract ideas.”

Courts:

State Street Bank -- In *State Street Bank & Trust Co. v. Signature Fin. Grp.*, 149 F.3d 1368 (Fed. Cir. 1998), the court considered whether claims directed to pooling the assets of mutual funds were directed to statutory subject matter. The court took an expansive view of § 103, stating that "[t]he plain and unambiguous meaning of § 101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103, and 112." *Id.* at 1372. The court ultimately found that the claims were patent eligible because they produced a useful, concrete and tangible result.

Mayo -- Following the *State Street Bank* decision, filings for business method patents experienced an uptick in the U.S. Patent & Trademark Office. In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 132 S. Ct. 1289 (2012), the Court considered the eligibility of patent claims covering processes that help doctors who use thiopurine drugs to treat patients with autoimmune diseases determine whether a given dosage level is too low or too high. The Court articulated a two step framework in which it is first determined whether the claims at issue are directed to a patent-ineligible concept (i.e., law of nature, natural phenomena, or abstract ideas). If so, the Court then asks whether the claim's elements, considered both individually and as an ordered combination, transform the nature of the claim into a patent-eligible application. The Court determined that the claimed processes were natural laws that had not been transformed into patent eligible applications of those laws.

Alice -- The Court applied the two step framework of Mayo to claims directed to using a third-party intermediary to mitigate settlement risk in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014). The Court found that, under the first step of the Mayo framework, the claims were directed to the abstract idea of intermediated settlement. The Court also found that the claims failed under step two of the Mayo framework as not transforming the nature of the claim into a patent-eligible application. More particularly, the Court described step two as a search for an "inventive concept." *Id.* at 2355 (citing *Mayo*).

We finally note that the lineage for the term "abstract idea" from Alice is: *Alice* (US 2014) - > *Myriad* (US 2012) -> *Diehr* (US 1981) -> *Rubber Tip Pencil* (US 1874) and *Le Roy* (US 1853). For example, in *Rubber Tip*, the Court held that "[e]verybody **knew**" the idea and in *Le Roy*, the Court noted that "if the principle is stated to be applicable to any special purpose, so as to produce any result **previously unknown**, in the way and for the objects described, the patent is good. It is no longer an abstract principle."

Instructions

- Mappings:** The mappings table can be used to quickly index into the caselaw analysis on the basis of technology (i.e., position in the software stack) or legal issue. Simply selecting the "X" in a given column/row intersection will jump you to the relevant portion of the discussion.
- Judge Tracker:** The judge tracker table provides an eye chart of which judges were involved in which decisions.
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John Brink, Siemens Corporation
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- Additional** <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/subject-matter-eligibility>

Mappings

Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
		User Interface	Data Structure	Data Transfer/Network Transfer	Data Storage		Directed To (Alice Step 1)	Inventive Concept (Alice Step 2)	Procedural Considerations	
Trading Technologies (graphical user interface)	Y	X					<p>The Federal Circuit found that "the patents describe a trading system in which a graphical user interface 'display[s] the market depth of a commodity traded in a market' including various static and dynamic displays and this graphical user interface solves "'problems of prior graphical user interface devices...relating to speed, accuracy and usability.'" Further, the Federal Circuit found that "the challenged patents do not simply claim displaying information on a graphical user interface" but rather "require a specific, structured graphical user interface paired with a prescribed functionality directly related to the graphical user interface's structure that is addressed to and resolves a specifically identified problem in the prior state of the art."</p>	<p>The Federal Circuit found that "the static price index as an inventive concept" that permits more efficient and accurate trade placement when using electronic trading systems. In addition, Federal Circuit found that the claimed trading system presents "specific technologic modifications to solve a problem or improve the functioning of a known system."</p>	<p>Fed.Cir. 2017 appeal from ND Ill. – Affirmed. Non-Precedential</p>	George

Mappings

Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
		User Interface	Data Structure	Data Transfer/Network Transfer	Data Storage		Directed To (Alice Step 1)	Inventive Concept (Alice Step 2)	Procedural Considerations	
Core Wireless (user interface with an application summary)	Y	X					The Federal Circuit found that the claims were directed an “improved user interface,” a non-abstract idea, rather than the abstract idea of an index. Specifically, the claims were “directed to a particular manner of summarizing and presenting information in electronic devices.”	The court concluded that the claims an improvement to computer technology because they improved the ability of a user to use the computer.	Fed.Cir. 2018 appeal from ED Texas – Affirmed denial of LG’s motion for summary judgement under 35 USC 101 and for JMOL that claims are anticipated and not infringed	George
McRO (set of phoneme sequence rules that define an output morph weight set stream)	Y	X					The Federal Circuit found that the "specific structure of the claimed rules would prevent broad preemption of all rules-based means of automating lip-synchronization, unless the limits of the rules themselves are broad enough to cover all possible approaches." According to the Federal Circuit, the "limitations in claim 1 prevent preemption of all processes for achieving automated lip-synchronization of 3-D characters." The Federal Circuit thus held the representative claim was not directed to an abstract idea, and thus did not meet Alice step one, thereby ending the inquiry.	Step 2 not reached given determination that claims recite eligible subject matter.	Appeal from Central District of California reversing grant of judgment on the pleadings	Kukkonen

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Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
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DDR Holdings (composite web page generation)	Y	X	X				Cited several abstract ideas proposed by both parties and the dissent, but did not settle on one. Resolved at Step 2.	Clicking on a link to a vendor website from a host website results in the creation of a hybrid page that shows vendor content in a look and feel of the host website containing the link.	Fed.Cir. 2018 appeal from ED of Texas - Affirmed. Denial of JMOL appealed. Reviewed de novo.	Forrest

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Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
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Aatrix (form file creation)	Y	X	X				<p>"Like many claims that focus on software innovations, [claim 1] is a system claim [directed to] a data processing system which clearly requires a computer operating software, a means for viewing and changing data, and a means for viewing forms and reports. This is very much a tangible system." <i>Aatrix</i>, 882 F.3d 1121 at 1125. Fed. Cir. ruled that "district court erred in holding claim 1 ineligible because it was directed to intangible matter [i.e., abstract idea of collecting and organizing data] and should have instead performed an Alice/Mayo analysis of claim 1...and the remaining claims." <i>Id.</i> 1125-26.</p> <p>Thus, although Fed. Cir. found that Alice/Mayo could be resolved at step 1 (i.e., not abstract but "a tangible system"), also looked to Alice step 2 in to find "inventive concept" elements.</p>	<p>The claimed inventions "allowed data to be imported from an end user application without needing to know proprietary database schemas and without having to custom program the form files to work with each outside application." <i>Aatrix</i>, 882 F.3d 1121 at 1127. And also, "permit data to be retrieved from a user application and inserted into a form, eliminating the need for hand typing in the values and eliminating the risk of transcription error." <i>Id.</i></p>	<p>Fed. Cir. 2018, appeal from M.D. Florida - vacated the district court's motion to dismiss based on every claim being ineligible under 35 USC 101, reversed its denial of Aatrix's motion for leave to file a second amended complaint, and remanded for further proceedings</p>	Burton

Mappings

Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
		User Interface	Data Structure	Data Transfer/Network Transfer	Data Storage		Directed To (Alice Step 1)	Inventive Concept (Alice Step 2)	Procedural Considerations	
Finjan (behavior based virus scanning)	Y		X	X			A method of providing computer security by scanning a downloadable and attaching the results of that scan to the downloadable itself in the form of a "security profile."	A security profile identifies code in an inspector received downloadable that performs hostile or potentially hostile operations. The security profile is linked the downloadable before the downloadable is made available to web clients.	Fed.Cir. 2018 appeal from ND Cal. - Jury Decision Affirmed	Forrest
BASCOM (distributed networking based content filters)	Y		X	X			"Claims and their specific limitations do not readily lend themselves to a step-one finding that they are directed to a nonabstract idea" in contrast to Enfish.	"an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces"	Appeal from US District Court for ND Texas- Granted Motion to Dismiss is Vacated and Remanded	Brink

Mappings

Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
		User Interface	Data Structure	Data Transfer/Network Transfer	Data Storage		Directed To (Alice Step 1)	Inventive Concept (Alice Step 2)	Procedural Considerations	
Amdocs (distributed networking enhancement of network accounting records)	Y		X	X	X		Held as directed to abstract idea of "correlating two network accounting records to enhance the first record". This was not refuted by the appeals court.	Claim entails an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases).	Appeal from US District Court for ED Virginia - Reversed and Remanded	Brink
Enfish (self-referential database)	Y		X		X		The Federal Circuit held that the claims are not directed to an abstract idea and that the 101 inquiry must consider whether the claims' "character as a whole is directed to excluded subject matter." The Court then stated, "[w]e do not read Alice to broadly hold that all improvements in computer-related technology are inherently abstract" and noted that software can "make non-abstract improvements to computer technology just as hardware improvements can" under <i>Alice</i> .	Step 2 not reached given determination that claims recite eligible subject matter.	Appeal from Central District of California reversing summary judgment finding all claims invalid as ineligible under 101.	Kukkonen

Mappings

Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
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Berkheimer (storing object structures with reduced redundancy)	Y			X	X		Claims 1–3 and 9 are directed to the abstract idea of parsing and comparing data; claim 4 is directed to the abstract idea of parsing, comparing, and storing data; and claims 5–7 are directed to the abstract idea of parsing, comparing, storing, and editing data. Resolved under Alice step 2 with respect to dependent claims 4-7.	Claims 1-3 and 9 do not capture the purportedly inventive concepts. "Claims 4-7, in contrast, contain limitations directed to the arguably unconventional inventive concept [of] storing object structures in the archive without substantial redundancy [, which] improves system operating efficiency and reduces storage costs." <i>Berkheimer v. HP Inc.</i> , 881 F.3d 1360, 1370 (Fed. Cir. 2018).	Fed. Cir. 2018, appeal from N.D. Illinois - affirmed indefiniteness of claims 10-19 and claims 1–3 and 9 are ineligible under Alice test; but vacated grant of summary judgment that dependent claims 4–7 are ineligible under § 101 because there is a fact question as to whether the claims 4-7 "contain limitations directed to the arguably unconventional inventive	Burton

Mappings

Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
		User Interface	Data Structure	Data Transfer/Network Transfer	Data Storage		Directed To (Alice Step 1)	Inventive Concept (Alice Step 2)	Procedural Considerations	
Visual Memory (memory system with programmable operational characteristics)	Y			<u>X</u>	<u>X</u>		The court found that the claims were directed to a technological improvement: an enhanced computer memory system.	The court concluded that the claims were not directed to an abstract idea, and thus did not analyze the claims under step two of the Alice test.	Fed. Cir. 2017. Appeal from U.S. District Court for District of Delaware. Reversed - Claims were directed to an improvement to computer memory systems and not directed to an abstract idea.	Bednarz
Electric Power (real-time performance monitoring of an electric power grid)	N	<u>X</u>				<u>X</u>	Collecting, displaying, and analyzing information	Did not go beyond the abstract idea	Appeal from C.D. California - Decided August 1, 2016	Forrest
Fairwarning	N					<u>X</u>	Collecting, analyzing and providing a notification	Sending a notification is not significantly more. An old practice in a new environment.	Appeal from Appeal from the United States District Court for the Middle District of Florida	Forrest

Mappings

Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
		User Interface	Data Structure	Data Transfer/Network Transfer	Data Storage		Directed To (Alice Step 1)	Inventive Concept (Alice Step 2)	Procedural Considerations	
Classen	N/Y					X	Collecting and comparing known information	Claims that only provide the information were not eligible. Claims that implement an immunization schedule were eligible.	Appeal from the United States District Court for the District of Maryland on Summary Judgment	Forrest
Int. Ventures (2015)	N	X				X	Three patents in different fields. See case tab.	No technology based problem and solution.	Appeal from the United States District Court for the Eastern District of Virginia Summary Judgment finding of invalidity based on claim construction	Forrest
Int. Ventures (2017)	N	X				X	Remotely accessing and retrieving user specified information	The claim lacked detail of how high level functions were done.	Appeal from the United States District Court for the Western District of Pennsylvania Motion to Dismiss	Forrest

Mappings

Case	Eligible?	Software Category				Data Processing/Other	Legal Issue			Contributor
		User Interface	Data Structure	Data Transfer/Network Transfer	Data Storage		Directed To (Alice Step 1)	Inventive Concept (Alice Step 2)	Procedural Considerations	
CyberSource	N	X				X	Focusses on machine or transformation. Correlating credit card numbers with IP addresses to detect fraud	Claims were interpreted very broadly and could be performed by a human mind - mental process.	Appeal from the United States District Court for the Northern District of California Summary Judgment of ineligibility	Forrest
Digitech	N	X	X			X	A data structure	Not tangible - cites Nuijten	Appeal from the United States District Court for the Central District of California Summary Judgment of ineligibility	Forrest
Ameranth	N					X	PTAB: generating a second menu from a first menu and sending the second menu to another location/CAFC: the ability to generate menus with certain features.	Nothing significantly more - "claims the addition of conventional computer components to well-known business	Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board CBM decision of ineligibility	Forrest

Aatrix

Overview: Appeal from M.D. Florida - Decided February 14, 2018

Aatrix Software appealed grant of Green Shade’s Rule(b)(6) motion to dismiss complaint based on the district court’s holding that all asserted claims of the two patents-in-suit (US Patent No. 7,171,615 and US Patent No. 8,984,393) are invalid as ineligible subject matter under 35 USC 101. Aatrix also appealed the district court’s denial of Aatrix’s motion for leave to file a second amended complaint.

Federal Circuit Holding: The Federal Circuit vacated the district court’s motion to dismiss, reversed its denial of Aatrix’s motion for leave to file a second amended complaint, and remanded for further proceedings. The Federal Circuit based its decision on the district court denying Aatrix leave to amend without claim construction and in view of the proposed second amended complaint providing factual allegations that, taken as true, would directly affect the district court’s Alice patent eligibility analysis that the asserted claims include inventive concepts that are not routine or conventional.

Judge Reyna concurred with the majority’s decision to vacate both the motion to dismiss and denial for leave to file a second amended complaint. But Judge Reyna disagreed with the majority’s broad statements on the role of factual evidence in a §101 inquiry.

Technology: Both patents are directed to “systems and methods for designing, creating, and importing data into a viewable form on a computer so that a user can manipulate the form data and create viewable forms and reports.” [1]

Discussion: The Federal Circuit found that the district court effectively ignored Aatrix Software’s declarations regarding its claimed inventions having inventive concepts that were substantially more than routine and conventional. The Federal Circuit indicated that the proposed second amended complaint provided “evidence” of inventive concepts for analysis under prong 2 of the Alice test for eligible subject matter. The Court explained that “plausible factual allegations may preclude dismissing a case under §101 inquiry where...’nothing on th[e] record...refutes those allegations as a matter of law or justifies dismissal under Rule 12(b)(6).” [2]

In coming to its decision, the Court found that “[i]n assessing the claims under Alice/Mayo step two, the district court found that the claimed ‘data file containing data from a user application for populating the viewable form’ describes a ‘well understood’ and ‘routine’ component and function of a computer.” [3] But “[t]he district court supplied no reasoning or evidence for its finding that the claimed data file “describes a ‘well understood’ and ‘routine’ component and function of a computer”. [4]

Representative claim: 1. A data processing system for designing, creating, and importing data into, a viewable form viewable by the user of the data processing system, comprising:
(a) a form file that models the physical representation of an original paper form and

establishes the calculations and rule conditions required to fill in the viewable form;

(b) a form file creation program that imports a background image from an original form, allows a user to adjust and testprint the background image and compare the alignment of the original form to the background test-print, and creates the form file;

(c) a data file containing data from a user application for populating the viewable form; and

(d) a form viewer program operating on the form file and the data file, to perform calculations, allow the user of the data processing system to review and change the data, and create viewable forms and reports.

Practice tips and takeaways:

1) As noted in Berkheimer, when drafting your patent application, consider providing “problem/solution” in the specification to highlight the various inventive concepts of your software related invention as an improvement over known prior art (e.g., Aatrix’s claimed “data file contains an inventive concept directed to improved importation of data and interoperability with third-party software.” [5]) Explicitly stating advantages of your inventive concept may help support the inventive concept captured in your claims as not routine or conventional.

2) When filing a complaint, consider providing support from your patent specification that your asserted claims include inventive concepts that are not routine and conventional.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/17-1452.Opinion.2-12->

Art Unit, Examiner: 2176, Quoc Tran

Citations: [1] Aatrix, 882 F.3d 1121, 1123 (Fed. Cir. 2018).
[2] Aatrix, 882 F.3d at 1125, citing FairWarning IP, LLC v. Iatric Sys., Inc., 839 F.3d 1089, 1097 (Fed. Cir. 2016) (quoting BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC, 827 F.3d 1341, 1352 (Fed. Cir. 2016).
[3] Aatrix, 882 F.3d at 1129, citing J.A. 26.
[4] *Id.*
[5] *Id.*

Panelists: Moore, Taranto, Reyna (dissent)

Amdocs

Overview: Appeal from E.D. Virginia - Decided November 1, 2016

Amdocs appeals district court's granting of Openet's motion on the pleadings finding that the patents at issue were not directed to eligible subject matter under 35 USC 101.

Patents at issue: US Patent Nos. 7,631,065; 7,412,510; 6,947,984; and 6,836,797 (Continuations of 6,418,467, '797 being CIP)

Decision: Reversed and remanded.

The patents relate to accounting and billing problems encountered by network service providers.

Discussion: The '065 patent concerns a system, method, and computer program for merging data in a network-based filtering and aggregating platform as well as a related apparatus for enhancing networking accounting data records. The '510 patent concerns a system, method, and computer program for reporting on the collection of network usage information. The '984 patent concerns a system and accompanying method and computer program for reporting on the collection of network usage information from a plurality of network devices. The '797 patent concerns a system, method, and computer program for generating a single record reflecting multiple services for accounting purposes.

The court found the claims to involve a close decision of similarity to the claims of BASCOM and DDR Holdings versus Digitech and in re TLI, holdings, "In this case, the claims are much closer to those in BASCOM and DDR Holdings than those in Digitech, Content Extraction, and In re TLI Commc'ns. Indeed, even if we were to agree that claim 1 is directed to an ineligible abstract idea under step one, the claim is eligible under step two because it contains a sufficient 'inventive concept.'" [1]

The court points to the description, "As explained by the patent, this distributed enhancement was a critical advancement over the prior art", further finding "In other words, this claim entails an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases). The solution requires arguably generic components, including network devices and "gatherers" which "gather" information. However, the claim's enhancing limitation necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality." [2]

Representative 1. A computer program product embodied on a computer readable storage medium for processing network accounting information comprising:
computer code for receiving from a first source a first network accounting record;
computer code for correlating the first network accounting record with accounting information available from a second source; and
computer code for using the accounting information with which the first network

accounting record is correlated to enhance the first network accounting record.

Practice tips and takeaways:

When drafting specifications, consider being specific with respect to how the invention operates to provide an improvement over the state of the art. Consider carefully describing interactions and operations between components that may be considered conventional to relate a story of how these components act in an unconventional manner.

Case link:

<http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1180.Opinion.10-28->

Art Unit, Examiner:

2442, Robert Harrell (7,631,065); 2142 Robert Harrell (7,412,510); 2142, Hai Nguyen

Citations:

[1] Amdocs (ISRAEL) LTD. V. Openet Telecom, INC., 841 F. 3D 1288, 1300 (Fed. Cir. 2016).
[2] Id. at 1300-1301.

Panelists:

Plager, Newman, Reyna (dissent)

Ameranth

Overview:	Appeals from the PTAB - Decided November 29, 2016. U.S. Patent No. 6,384,850 involved generating menus on a computer - Covered Business Method decision review. [1]
Discussion:	The claims were found directed to an abstract idea of generating a second menu from a first menu. The additional elements were found to be routine and conventional giving the claims a broadest reasonable interpretation. No inventive concept was found in dependent claims. For at least some of the dependent claims, the specification provided no description of how to implement the claimed functions, such as linking an order to a table.
Representative claim:	1. An information management and synchronous communications system for generating and transmitting menus comprising:a. a central processing unit, b. a data storage device connected to said central processing unit, c. an operating system including a graphical user interface, d. a first menu consisting of menu categories, said menu categories consisting of menu items, said first menu stored on said data storage device and displayable in a window of said graphical user interface in a hierarchical tree format, e. a modifier menu stored on said data storage device and displayable in a window of said graphical user interface, f. a sub-modifier menu stored on said data storage device and displayable in a window of said graphical user interface, and g. application software for generating a second menu from said first menu and transmitting said second menu to a wireless handheld computing device or Web page, wherein the application software facilitates the generation of the second menu by allowing selection of categories and items from the first menu, addition of menu categories to the second menu, addition of menu items to the second menu and assignment of parameters to items in the second menu using the graphical user interface of said operating system, said parameters being selected from the modifier and sub-modifier menus.
Practice tips and takeaways:	See Electric Power tab - Consider making sure your specification contains details of how claimed functionality is performed and avoids characterization of elements that are claimed as conventional or typical or commonly known. Also avoid referencing well-known business practices. There was a technical problem involved here (how to hierarchically display a large menu on a small screen), but the claims lacked some specifics of how the technical problem was solved.
Case link:	http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1703.Opinion.11-28-
Art Unit, Examiner:	2173, Cao H. Nguyen
Citation:	[1] Apple, Inc. v. Ameranth, Inc. 842 F.3d 1229, 2016 U.S. App. LEXIS 21277, 120 U.S.P.Q.2d (BNA) 1844 (Fed. Cir. 2016).
Panelists:	Reyna, Chen, Stoll

BASCOM

Overview: Appeal from N.D. Texas - Decided June 27, 2016

BASCOM appeals grant of Motion to Dismiss for failure to state a claim based on invalidity under 35 USC 101.

Patent at issue: US Patent No. 5,987,606

Holding:

BASCOM has shown that claims of the '606 patent pass step two of the Alice two-part framework.

Motion to Dismiss is vacated and case remanded.

Technology:

Filtering Internet content remotely while providing individual filtering by user.

Discussion:

Claims recite an Internet filter installed on a remote server such as an ISP server. The filter is provided access to individualized filtering mechanisms for each user. When a user makes a request for data, the filter identifies the user making the request and associates that user with their individual filtering mechanism. Based on the request and the filtering mechanism, the requested data is provided or withheld based on the filtering policy.

The specification describes this as an improvement over the state of the art, which either required individual filtering mechanisms to be installed on each workstation, or for filters installed on local or ISP servers which use a one size fits all filter that is applied to all users.

The court found that the claims were directed to "content filtering system for filtering content retrieved from an Internet computer network" [1], and agreed with the district court that "filtering content is an abstract idea because it is a long-standing, well-known method of organizing human behavior." [2]

However, the court recognized that although the limitations of the claims, taken individually recite generic computer network and Internet components and are not inventive by themselves, the court considered the ordered combination and determined "an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces." [3]

The court noted that the claimed method of filtering did not pre-empt all ways of filtering content on the Internet, but recite a specific discrete implementation of the abstract idea of filtering content. "Filtering content on the Internet was already a known concept, and ***the patent describes how its particular arrangement of elements is a technical improvement over prior art ways*** of filtering such content." [4] The claims carve out a specific location for the filtering system (a remote ISP server) and require the filtering system to give users the ability to customize filtering for their individual network accounts.

Representative claim: 1. A content filtering system for filtering content retrieved from an Internet computer network by individual controlled access network accounts, said filtering system comprising:
a local client computer generating network access requests for said individual controlled network accounts;
at least one filtering scheme;
a plurality of sets of logical filtering elements; and
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.

Practice tips and takeaways: When drafting specifications, consider being specific in description of the arrangement and relative positioning of components of the system.
A specifically described arrangement provides a position supporting a technical improvement.
In addition, more specific arrangement precludes allegations of pre-emption.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1763.Opinion.6-23->

Art Unit, Examiner: 2785, Ly Hua

Citations: [1] BASCOM Global Internet Svcs v. AT&T Mobility, 827 F. 3D 1341 at 1348 (Fed. Cir. 2016).
[2] *Id.*
[3] *Id.* at 1350.
[4] *Id.*

Panelists: Chen, O'Malley, Newman (concur)

Berkheimer

Overview: Appeal from N.D. Illinois - Decided February 14, 2018

Berkheimer appeals grant of Summary Judgment holding claims 1-7 and 9 of patent-in-suit (US Patent No. 7,447,713) as invalid as ineligible subject matter under 35 USC 101. Berkheimer also appeals holding that claims 10-19 of the patent-in-suit are invalid for indefiniteness.

Federal Circuit Holding: Court affirmed indefiniteness of claims 10-19 of the patent-in-suit and that claims 1–3 and 9 of the patent-in-suit are ineligible under Alice test because they "do not capture the purportedly inventive concepts" identified in the specification as an unconventional improvement to storing parsed data to eliminate redundancies and improve efficiencies in data storage. [1] The court vacated, however, the district court's grant of summary judgment that dependent claims 4–7 are ineligible under § 101 because there is a fact question as to whether the claims 4-7 "contain limitations directed to the arguably unconventional inventive concept described in the specification". [2] The Court then remanded for further proceedings.

Technology: Digital processing and archiving of files. The system parses files into multiple objects and tags the objects to create relationships between them, and then compares the objects to archived objects to identify variations based on predetermined standards and rules. The system eliminates redundant storage of common text and graphical elements between stored documents.

Discussion: With respect to the appeal of patent eligibility, the Federal Circuit found that Berkheimer maintained that limitations included in dependent claims 4–7 bear on patent eligibility and never agreed to make claim 1 representative of all claims of patent-in-suit. In support of this finding, the Court stated that "Mr. Berkheimer advanced meaningful arguments regarding limitations found only in the dependent claims". [3] This is a key finding, not only that Berkheimer did not waive his patent eligibility arguments with respect to dependent claims 4-7, but provides guidance for the Court's abstract analysis under the Alice test step 2.

Under Alice test step 1, the Court found that the claims at issue were either directed to the "abstract idea of parsing and comparing data" (i.e., claims 1-3 and 9), "the abstract idea of parsing, comparing and storing data" (i.e., claim 4), or "the abstract idea of parsing, comparing, storing, and editing data" (i.e., claims 5-7). [4] The Court further found that, even though Berkheimer's patent teaches "the parser transforms data from source to object code [, that is not enough to] demonstrate non-abstractiveness without evidence that this transformation improves computer functionality in some way." [5]

Focusing on Alice test step 2, the Court held that "[t]he question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact." [6] The Court further held that, when there is no genuine issue of material fact when addressing this Alice test 2 question, "this issue can be decided on summary judgment as a matter of law." [7] However, the Court ruled that the district court judge erred in concluding there are no factual questions in its Alice step 2 inquiry and resolving this case at summary judgment.

In overturning the district court's ruling, the Court found that dependent claims 4-7 "contain limitations directed to the arguably unconventional inventive concept described in the specification" for "storing a reconciled object structure in the archive without substantial redundancy." [8] In support, the Court stated that "[t]he specification states that storing object structures in the archive without substantial redundancy improves system operating efficiency and reduces storage costs" and that "known asset management systems did not archive documents in this manner." [9] Accordingly, although the Court did not decide that claims 4-7 were patent eligible under § 101, the Court indicated that Berkheimer had sufficiently identified the inventive concept and advantage over known prior art in the specification and captured such inventive concept in the dependent claims such that specification's disclosure supports a fact question as to the eligibility of claims at issue so summary judgment is not warranted.

Representative claims:

1. A method of archiving an item in a computer processing system comprising:
presenting the item to a parser;
parsing the item into a plurality of multipart 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.

Note: Claim 1 found to be directed to abstract idea and not incorporate any inventive concept. But dependent claim 4 found to include an inventive concept under Alice step 2.

Practice tips and takeaways:

- 1) When drafting your patent application, consider providing "problem/solution" in the specification to highlight the various inventive concepts of your software related invention as an improvement over known prior art (e.g., Berkheimer's inventive concept of "archiv[ing] documents in an inventive manner that improves these aspects of the disclosed archival system"). Consider explicitly and repeatedly stating advantages of your inventive concept that supports the inventive concept captured in your claims as not routine or conventional.

- 2) When filing an appeal to a 101 rejection, do not always rely on your independent claim as representative of all the pending claims at issue. Consider identifying each dependent claim that has an additional limitation that is supported in the specification as an inventive concept improvement over known prior art.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/17-1437.Opinion.2-6->

Art Unit, Examiner: 2168, Thuy Pardo

Citations: [1] Berkheimer v. HP Inc., 881 F.3d 1360, 1370 (Fed. Cir. 2018).
[2] *Id.*
[3] *Id.* at 1365.
[4] *Id.* at 1367.
[5] *Id.*
[6] *Id.* at 1368.
[7] *Id.*
[8] *Id.* at 1370.
[9] *Id.*

Panelists: Moore, Taranto, Stoll

Classen

Overview:	Appeal from the D. of Maryland - Decided August 31, 2011. US Patent No. 5,723,283 involved collecting and comparing known information. [1]
Discussion:	Two other patents in the case were held eligible because they involved an immunization step. Claim 1 in the '283 patent was held ineligible because no immunization step was required. Note that the claim actually recites comparing, does not require a computer to do the comparing, and lacks any step based on the comparison.
Representative claim:	1. A method of determining whether an immunization schedule affects the incidence or severity of a chronic immune-mediated disorder in a treatment group of mammals, relative to a control group of mammals, which comprises immunizing mammals in the treatment group of mammals with one or more doses of one or more immunogens, according to said immunization schedule, and comparing the incidence, prevalence, frequency or severity of said chronic immune-mediated disorder or the level of a marker of such a disorder, in the treatment group, with that in the control group.
Practice tips and takeaways:	See Electric Power tab. This case is often cited for the bare proposition that any claim that performs: "collecting and comparing known information" is not eligible. However, the claim does not require a computer, and does not perform any step based on the comparison. Other claims in this case that did perform the immunization step were found eligible. Thus, if your claim performs any step based on a comparison of collected data, Classen actually supports eligibility.
Case link:	http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/06-1634-1649.pdf
Art Unit, Examiner:	1636, Nancy J. Leith
Citation:	[1] Classen Immunotherapies, Inc. v. Biogen Idec 659 F.3d 1057, 2011 U.S. App. LEXIS 18126, 100 U.S.P.Q.2d (BNA) 1492 (Fed. Cir. 2011).
Panelists:	Newman, Rader, Moore (dissent)

Core Wireless

Overview: Appeal from E.D. Texas - Decided January 25, 2018

LG Electronics appealed the District Court decision which denied LG's motion for summary judgment of subject matter ineligibility under 35 USC 101 and denied LG's motion for JMOL that the claims are anticipated and not infringed. The Federal Circuit decision affirmed the district court.

Patents-at-Issue: US Patent No. 8,713,476, US Patent No. 8,434,020, US Patent No. 6,415,164

Federal Circuit Holding: The court affirmed the finding of subject matter eligibility under 35 USC 101.

Technology: A graphical user interface that includes an application summary window to display a limited set of information related to one or more applications without actually launching those application(s).

Discussion: The Federal Circuit indicated that "[t]he claim further requires the application summary window list a limited set of data, '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.'" [1] The application summary window restricts a type of data that can be displayed in the summary window, and the claim recites that the summary window "is displayed while the one or more applications are in an un-launched state". [2] "These limitations disclose a specific manner of displaying a limited set of information to the user, rather than using conventional user interface methods to display a generic index on a computer." [3] The Federal Circuit referenced the patent specifications and their teaching of problems associated with prior art interfaces. For example, users of prior systems had to "drill down through many layers to get to desired data or functionality [which] could seem slow, complex and difficult to learn, particularly to novice users." [4] In contrast, the claimed invention involves "[d]isplaying selected data or functions of interest in the summary window allows the user to see the most relevant data or functions without actually opening the application up." [5] To the Federal Circuit, this represented a specific improvement over conventional user interfaces and associated methods. Using the summary window to provide information about an application that is in an unlaunched state "saves the user from navigating to the required application, opening it up, and then navigating within that application to enable the data of interest to be seen or a function of interest to be activated." [6] The Federal Circuit noted that the specification indicated the claims provided an improvement in the function of computers with small screens and presented a certain limited set of information to a user in a particular manner. For the section

101 analysis, the Federal Circuit notes: “At step one, we must 'articulate what the claims are directed to with enough specificity to ensure the step one inquiry is meaningful.' ... We also ask whether the claims are directed to a specific improvement in the capabilities of computing devices, or, instead, 'a process that qualifies as an `abstract idea' for which computers are invoked merely as a tool.’” [7] The court found that the claims were not directed to an abstract idea under step one of the Alice test. Therefore, an analysis under step two to evaluate whether the claims recite something more need not be completed. [8]

Representative claim: 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.

Practice tips and takeaways: Consider describing in your specification what technical problems are found in prior user interfaces and how your claimed graphical user interface solves those problems with improved technology. It appears to be helpful to claim the structure and/or process for the improvement, not just a result of the improvement. Try being specific as to how particular elements of the claims improve functioning of the computer system.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/16-2684.Opinion.1-23->

Art Unit, Examiner: 2175, Thanh Vu (8,713,476 & 8,434,020); 2682, Charles Appiah (6,415,164)

Citations: [1] Core Wireless Licensing S.A.R.L., v. LG Electronics, Inc., 880 F.3d 1356, 1362 (Fed. Cir. 2018).
[2] *Id.* at 1363.
[3] *Id.*
[4] *Id.*
[5] *Id.*
[6] *Id.*
[7] *Id.* at 1361-62.
[8] *Id.* at 1363.

Panelists: Moore, O'Malley, Wallach (cip/dip)

CyberSource

Overview:	Appeal from the N.D. of California - Decided August 16, 2011. US Patent No. 6,029,154 involved obtaining and comparing intangible data. [1]
Discussion:	CyberSource involved a method of obtaining IP addresses of transactions and constructing a map of credit card numbers based on other transactions and using the map to determine if a credit card transaction is valid. The court indicated this claim simply obtains and compares intangible data pertinent to business risk. Note that nothing is done with the comparison. The court noted that the claims appeared to attempt to cover all methods of detecting credit card fraud, and went to efforts to simplify the claim claimed generation of a map by indicating it could be a simple list of credit card numbers.
Representative claim:	2. A computer readable medium containing program instructions for detecting fraud in a credit card transaction between a consumer and a merchant over the Internet, wherein execution of the program instructions by one or more processors of a computer system causes the one or more processors to carry out the steps of: a) obtaining credit card information relating to the transactions from the consumer; and b) verifying the credit card information based upon values of a plurality of parameters, in combination with information that identifies the consumer, and that may provide an indication whether the credit card transaction is fraudulent, wherein each value among the plurality of parameters is weighted in the verifying step according to an importance, as determined by the merchant, of that value to the credit card transaction, so as to provide the merchant with a quantifiable indication of whether the credit card transaction is fraudulent, wherein execution of the program instructions by one or more processors of a computer system causes the one or more processors to carry out the further steps of: obtaining other transactions utilizing an Internet address that is identified with the credit card transaction; constructing a map of credit card numbers based upon the other transactions; and utilizing the map of credit card numbers to determine if the credit card transaction is fraudulent.
Practice tips and takeaways:	CyberSource involved a method of verifying validity of credit card transactions over the Internet and has been characterized in MPEP 2106 as “insignificant extrasolution activity” and “mere data gathering.” Characterize it as a business method. Point out that claims in Classen (often cited with CyberSource) that included immunization were found eligible. Point out how your claims actually do something, similar to the claims that were allowed in Classen. Argue that your claims are not related to any form of business method like CyberSource, but instead describe a technical solution to a technical problem. CyberSource is very limited to its facts and does not stand for the proposition that any case that collects and compares data in addition to other elements should be found ineligible.
Case link:	http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/09-1358.pdf
Art Unit, Examiner:	2765, Susanna M. Meinecke Diaz
Citation:	[1] CyberSource Corp. v. Retail Decisions, Inc. 654 F.3d 1366, 2011 U.S. App. LEXIS 16871, 99

U.S.P.Q.2d (BNA) 1690 (Fed. Cir. 2011).

Panelists: Dyk, Prost, Bryson

DDR Holdings

Overview: Appeal from E.D. Texas - Decided December 5, 2014

DDR Holdings, LLC sued multiple parties for infringement of US Patent No. 6,993,572 and other patents. The '572 patent was found eligible and infringed. Affirmed as the claims recite significantly more, reciting a claimed solution that "is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks. Mayer dissents, indicating the abstract concept is : "an online merchant's sales can be increased if two web pages have the same "look and feel". Only a generic computer is used to apply that concept. [1]

Discussion: The majority recites several of the proposed abstract ideas, and indicates it does not matter which one is used, as the claims recite significantly more than an abstract idea: "Instead, the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks." Conventional function of a computer when clicking on a link would direct someone away from the host website, not generate a hybrid page. Elements in claim 13 are referenced to support that view, including constructing and serving a hybrid web page that merges content from the vendor's page and includes elements from the host website. The dissent's view that it is the same concept as a kiosk in store is debunked by indicating one is not "suddenly and completely transported outside the warehouse store." No preemption is mentioned but not relied upon. Other cases (Alice, Ultramercial, buySAFE, Accenture, and Bancorp) are distinguished based on the claims not reciting "a commonplace business method aimed at processing business information, applying a known business process to the particular technological environment of the Internet, or creating or altering contractual relations using generic computer functions and conventional network operations."

Representative claim: Claim 13. An e-commerce outsourcing system comprising:
a) a data store including a look and feel description associated with a host web page having a link correlated with a commerce object; and b) a computer processor coupled to the data store and in communication through the Internet with the host web page and programmed, upon receiving an indication that the link has been activated by a visitor computer in Internet communication with the host web page, to serve a composite web page to the visitor computer with a look and feel based on the look and feel description in the data store and with content based on the commerce object associated with the link.

Practice tips and takeaways: Consider characterizing a technical problem/solution in a technical manner in terms of the infrastructure used to implement the idea when drafting the application, or look for same during prosecution/assertion. Avoid as much as possible (but not entirely) discussing the business problem addressed by the invention. Try to include at least some examples in the specification that are not related to a business process. In DDR, an additional example could have been related to searching for information on different websites and integrating the data into an original website with the same look and feel.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/13-1505.Opinion.12-3->

Art Unit, Examiner: 2145, Jason Cardone

Citations: [1] DDR Holdings, LLC v. Hotels.com, L.P. 773 F.3d 1245, 2014 U.S. App. LEXIS 22902, 113 U.S.P.Q.2d (BNA) 1097 (Fed. Cir. 2014).

Panelists: Chen, Wallach, Mayer (dissent)

Digitech

- Overview: Appeals from the C.D. of California - Decided July 11, 2014. US Patent No. 6,128,415 involved organizing and manipulating information through mathematical correlation. [1]
- Discussion: The claims are to a device profile and a method of generating a device profile. Nuijten is cited as support for not allowing a claim to just data, as the data was characterized as broader than even a signal. A profile alone is not tangible and hence not one of the statutory categories.
- Representative claim: 1. A device profile for describing properties of a device in a digital image reproduction system to capture, transform or render an image, said device profile comprising: first data for describing a device dependent transformation of color information content of the image to a device independent color space; and second data for describing a device dependent transformation of spatial information content of the image in said device independent color space.
- Practice tips and takeaways: See Electric Power Tab - Make sure you have a claim that uses the profile. In this case, the profile helped solve a technical problem, and a claim using the profile to capture both spatial and color properties of an imaging device to provide a better output on a display device would have had a much better chance. Also, if claiming a data structure, make sure to disclose and claim a tangible - non-transitory medium on which the profile/data structure is stored.
- Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/13-1600.Opinion.7-9->
- Art Unit, Examiner: 2721, Daniel G. Mariam
- Citation: [1] Digitech Image Techs., LLC v. Electronics for Imaging, Inc. 758 F.3d 1344, 2014 U.S. App. LEXIS 13149, 111 U.S.P.Q.2d (BNA) 1717, 2014 WL 3377201 (Fed. Cir. 2014).
- Panelists: Reyna, Moore, Hughes

Electric Power

Overview: Appeal from C.D. California - Decided August 1, 2016. US Patent No. 8,401,710 involved collecting information, analyzing it, and displaying certain results of the collection and analysis - Technology: Receives lots of information from other sources related to a power grid, analyzes, and displays information about the grid. Quote: Though lengthy and numerous, the claims do not go beyond requiring the collection, analysis, and display of available information in a particular field, stating those functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology. The claims, defining a desirable information-based result and not limited to inventive means of achieving the result, fail under § 101. [1]

Discussion: - Technology: Receives information from other sources related to a power grid, analyzes, and displays information about the grid. Quote: "Though lengthy and numerous, the claims do not go beyond requiring the collection, analysis, and display of available information in a particular field, stating those functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology." [2] The claims, defining a desirable information-based result and not limited to inventive means of achieving the result, fail under § 101.

Representative claim: 12. 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, the method comprising:

- receiving a plurality of data streams, each of the data streams comprising sub-second, time stamped synchronized phasor measurements wherein the measurements in each stream are collected in real time at geographically distinct points over the wide area of the interconnected electric power grid, the wide area comprising at least two elements from among control areas, transmission companies, utilities, regional reliability coordinators, and reliability jurisdictions;
- receiving data from other power system data sources, the other power system data sources comprising at least one of transmission maps, power plant locations, EMS/SCADA systems;
- receiving data from a plurality of non-grid data sources;
- detecting and analyzing events in real-time from the plurality of data streams from the wide area based on at least one of limits, sensitivities and rates of change for one or more measurements from the data streams and dynamic stability metrics derived from analysis of the measurements from the data streams including at least one of frequency instability, voltages, power flows, phase angles, damping, and oscillation modes, derived from the phasor measurements and the other power system data sources in which the metrics are indicative of events, grid stress, and/or grid instability, over the wide area;
- displaying the event analysis results and diagnoses of events and associated ones of the metrics from different categories of data and the derived metrics in visuals, tables, charts, or combinations thereof, the data comprising at least one of monitoring data, tracking data, historical data, prediction data, and summary data;

displaying concurrent visualization of measurements from the data streams and the dynamic stability metrics directed to the wide area of the interconnected electric power grid;

accumulating and updating the measurements from the data streams and the dynamic stability metrics, grid data, and non-grid data in real time as to wide area and local area portions of the interconnected electric power grid; and

deriving a composite indicator of reliability that is an indicator of power grid vulnerability and is derived from a combination of one or more real time measurements or computations of measurements from the data streams and the dynamic stability metrics covering the wide area as well as non-power grid data received from the non-grid data source.

Practice tips and takeaways:

Electric Power is used quite often by examiners in rejections. The examiners only cite the cases that they are briefed on in training. The 101 training materials identify such cases (Chart: <https://www.uspto.gov/sites/default/files/documents/ieg-qrs.pdf>; Training Materials: <https://www.uspto.gov/patent/laws-and-regulations/examination-policy/training-materials-subject-matter-eligibility>). **How to argue against:** Attack the identification of the abstract idea: As instructed in the May 4, 2016 Memorandum at page 3:

Examiners should be familiar with any cited decision relied upon in making or maintaining a rejection to ensure that the rejection is reasonably tied to the facts of the case and to avoid relying upon language taken out of context. Examiners should not go beyond those concepts that are similar to what the courts have identified as abstract ideas.

Use the McRo, Enfish, and Berkheimer memos

Argue a technical solution to a technical problem, clearly identifying why the problem and the solution are technical in nature.

Recite and emphasize generation of new information that did not previously exist, which sets up an analogy to Enfish.

Recite and emphasize user interactivity that improves data presentation, which sets up an analogy to Core Wireless.

Point to a particular inventive technological process to distinguish from Electric Power.

The claims in Electric Power Group failed to assert any particular inventive technology. To be sure, the Federal Circuit similarly distinguished the claims in Trading Technologies Inc. v. CQG, Inc. (hereinafter Trading Technologies), as follows:

The claims in Electric Power Group failed to assert any particular inventive technology. To be sure, the Federal Circuit similarly distinguished the claims in Trading Technologies Inc. v. CQG, Inc. (hereinafter Trading Technologies), as follows:

"Claims directed to the "process of gathering and analyzing information of a specified content, then displaying the results," without "any particular assertedly inventive technology for

performing those functions,” were held ineligible in *Electric Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016)

Indeed, Electric Power Group qualified its own holding, as follows:

And we have recognized that merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis.

Broadest reasonable interpretation: Argue that the interpretation of the claims is unreasonable.

Argue that the claims have been over simplified and improperly characterized broadly as “collecting information, analyzing it, and displaying certain results of the collection and analysis” in an attempt to compare the claims to Electric Power Group. The claims in *Enfish* and *McRoe* may be similarly over simplified and broadly characterized, but instead, the claims were found eligible. In both *DDR Holdings* and *McRO* the claims were found eligible under § 101 by the courts. Thus, reciting elements that can be reduced to a summary of collecting information, analyzing information, and providing certain results is insufficient to render a claim ineligible under § 101. Yet, this is what the Examiner has done. The Examiner has removed any of the actual recited elements until the caricature of the claim elements meets the notion of an abstract idea.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1778.Opinion.7-28->

Art Unit, Examiner: 2121, M. N. Von Buhr

Citations: [1] *Electric Power Group, LLC v. ALSTOM SA*, 830 F. 3d 1350.
[2] *Id.* at 1351.

Panelists: Taranto, Bryson, Stoll

Enfish

Overview: Appeal from C.D. California - Decided May 12, 2016. US Patent Nos. 6,151,604 and 6,163,775 involved a self-referential database. [1]

Enfish is a 2016 Federal Circuit decision in which the court, for the second time since the United States Supreme Court decision in *Alice Corp. v. CLS Bank* upheld the patent-eligibility of software patent claims. In particular, the Federal Circuit reversed a district court ruling that *Enfish*'s asserted software claims directed to a database using a self-referential table were ineligible under § 101 and also vacated the lower court's holding

Discussion: In *Enfish*, the Federal Circuit reversed the district court's grant of summary judgment, which found the claims of US Patent Nos. 6,151,604 and 6,163,775 not patent eligible under 35 U.S.C. § 101. In reversing, the court held, among other rulings, that the claims were not directed to an abstract idea under the first step of the *Alice* test (Step 2A). The court explained that this first step "is a meaningful one" and "cannot simply ask whether the claims involve a patent-ineligible concept, because essentially every routinely patent-eligible claim involving physical products and actions involves a law of nature and/or natural phenomenon—after all, they take place in the physical world." Rather, the inquiry must consider whether the claims' "character as a whole is directed to excluded subject matter." The court then stated, "[w]e do not read *Alice* to broadly hold that all improvements in computer-related technology are inherently abstract" and noted that software can "make non-abstract improvements to computer technology just as hardware improvements can" under *Alice*. The '604 and '775 patents claim a logical model for a computer database. A logical model is a system for a computer database that explains how the various elements of information in the database are related to one another. Contrary to conventional logical models, *Enfish*'s logical model includes all data entities in a single table, with column definitions provided by rows in that same table. The patents describe this as the "self-referential" property of the database.

Representative claim: 17. (6,151,604 Patent) A data storage and retrieval system for a computer memory, comprising: means for configuring said memory according to a logical table, said logical table including: a plurality of logical rows, each said logical row including an object identification number (OID) to identify each said logical row, each said logical row corresponding to a record of information; a plurality of logical columns intersecting said plurality of logical rows to define a plurality of logical cells, each said logical column including an OID to identify each said logical column; and means for indexing data stored in said table.

Practice tips and takeaways: The *Enfish* decision confirms that improvements in computer-related technology are not always, by definition, abstract ideas under the first step of the *Alice* test. Thus, applicants may wish to consider identifying the improvement offered by the claimed invention and inquiring as to whether that improvement represents a specific improvement to the technology itself.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1244.Opinion.5-10->

Art Unit, Examiner: 2161, Apu Mofiz

Citations: [1] Enfish, LLC v. Microsoft Corp., 822 F. 3d 1327 (Fed. Cir. 2016).

Panelists: Hughes, Taranto, Moore

Fairwarning

- Overview: Appeal from the M.D of Florida - Decided October 11, 2016. US Patent No. 8,578,500 involved collecting and analyzing information to detect misuse and notifying a user when misuse is detected. [1]
- Discussion: - Technology/quote: According to the specification, pre-existing systems were able to record audit log data concerning user access of digitally stored PHI (personal health information). The claimed systems and methods record this data, analyze it against a rule, and provide a notification if the analysis detects misuse... FairWarning's claims merely implement an old practice in a new environment.
- Representative claim: 1. A method of detecting improper access of a patient's protected health information (PHI) in a computer environment, the method comprising:
generating a rule for monitoring audit log data representing at least one of transactions or activities that are executed in the computer environment, which are associated with the patient's PHI, the rule comprising at least one criterion related to accesses in excess of a specific volume, accesses during a pre-determined time interval, accesses by a specific user, that is indicative of improper access of the patient's PHI by an authorized user wherein the improper access is an indication of potential snooping or identity theft of the patient's PHI, the authorized user having a pre-defined role comprising authorized computer access to the patient's PHI;applying the rule to the audit log data to determine if an event has occurred, the event occurring if the at least one criterion has been met;storing, in a memory, a hit if the event has occurred; andproviding notification if the event has occurred.
- Practice tips and takeaways: Consider making sure your claims do something with the information that is collected beyond merely providing a notice that an event has occurred. As in Classen's eligible claims that actually call for immunization to be performed, modify your claims to perform something beyond just a notification.
- Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/15-1985.Opinion.10-6->
- Art Unit, Examiner: 2495, Lisa C. Lewis
- Citation: [1] FairWarning IP, LLC v. Iatric Sys. 839 F.3d 1089, 2016 U.S. App. LEXIS 18313, 120 U.S.P.Q.2d (BNA) 1293 (Fed. Cir. 2016).
- Panelists: Stoll, Plager, Lourie

Finjan

Overview: Finjan sued in Northern District of California on multiple patents and received a jury award of about \$39.5 Million. US Patent No. 6,154,844 eligibility is discussed in the CAFC opinion. The claims were found eligible. Decided January 10, 2018. [1]

Discussion: A security profile identifies code in an inspector received downloadable that performs hostile or potentially hostile operations. The security profile is linked to the downloadable before the downloadable is made available to web clients. The claims were construed by the district court to be more specific than the plain language of the claim, and that construction was used by the Federal Circuit. The construction may have helped overcome a "too high a level of generality" attack. The claim was found to do a "good deal more" than a virus scan on an intermediary computer that was found conventional in *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F. 3d 1307, 1319 (Fed. Cir. 2016). Found eligible at Step 1 and compared favorably to Enfish "as it enables a computer security system to do things that it could not do before."

Representative claim: Claim 1: 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.

Practice tips and takeaways: Creating a new data structure based on conventional activity (virus scanning) can satisfy the second, significantly more, prong of the Alice test, provided your claims recite more than just the result. Include specific steps that accomplish the result. Include clear description of these steps and the claim language used so that an unreasonably broad interpretation of claim terms can be traversed by pointing to the specification. If post USPTO, ensure the claim construction includes the specific steps.

Case Link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/16-2520.Opinion.1-8->

Art Unit, 2785, Christopher Revak

Citations: [1] Finjan, Inc. v. Blue Coat Systems, Inc., 879 F. 3d 1299 (Fed. Cir. 2018).

Panelists: Dyk, Linn, Hughes

Int. Ventures v. Cap One Financial

Overview:	Appeal from the E.D. of Virginia - Decided July 6, 2015. US Patent Nos. 8,083,137, 7,603,382, and 7,260,587 involved collecting, displaying, and manipulating data. [1]
Discussion:	There were three sets of claims for different inventions involved in this case. The court pointed out that just because a computer can do something faster does not transform the invention into something eligible. The first patent was very business method related - calculating a budget for spending and sending summaries of spending. The second patent involved tailoring website information based on user preferences or browsing habits. The claim interpretation was very broad, bringing in prior art of selecting advertisements for broadcast television based on time of day. Be careful seeking an overly broad interpretation of your claims. This interpretation was also used to distinguish from DDR, as the problem was not limited to the realm of the Internet. The third patent involved organizing images that were scanned. Nothing pointed out as solving a technical problem in a technical manner.
Representative claims:	<p>First Patent: A method comprising: storing, in a database, a profile keyed to a user identity and containing one or more user-selected categories to track transactions associated with said user identity, wherein individual user-selected categories include a user pre-set limit; and causing communication, over a communication medium and to a receiving device, of transaction summary data in the database for at least one of the one or more user-selected categories, said transaction summary data containing said at least one user-selected category's user pre-set limit.</p> <p>Second patent: A system for providing web pages accessed from a web site in a manner which presents the web pages tailored to an individual user, comprising: an interactive interface configured to provide dynamic web site navigation data to the user, the interactive interface comprising: a display depicting portions of the web site visited by the user as a function of the web site navigation data; and a display depicting portions of the web site visited by the user as a function of the user's personal characteristics.</p> <p>Third Patent: A method of automatically organizing digital images obtained from a plurality of hard copy prints, each of said hard copy prints having an image thereon, comprising the steps of: digitally scanning a plurality of hard copy prints that have been grouped into one or more categories, each category separated by an associated machine readable instruction form as to obtain a digital file of each of said images and digitally associating said one or more categories with said digital images in accordance with said associated machine readable instruction form executed by a computer; storing said digital images files and associated categories on a digital storage medium; and producing a product incorporating images from one or more of said categories as required by a customer.</p>
Practice tips and takeaways:	See Electric Power tab - Distinguish in a manner similar to that used to distinguish Electric Power above. Alternatively, argue that the claims do not preempt all use of the claimed abstract idea. Assert a technical solution to a technical problem, but be sure to strongly

characterize the problem as uniquely arising from technology and not business method related.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/14-1506.Opinion.7-1->

Art Unit, Examiner: 2887, Thien Minh Le (USPN 8,083,137); 2167, Cheryl Renea Lewis (USPN 7,603,382, and 7,260,587)

Citation: [1] Intellectual Ventures I LLC v. Capital One Bank (USA) 792 F.3d 1363, 2015 U.S. App. LEXIS 11537, 115 U.S.P.Q.2d (BNA) 1636 (Fed. Cir. 2015).

Panelists: Dyk, Reyna, Chen

Int. Ventures v. Erie Indemnity

Overview:	Appeal from the W.D. of Pennsylvania - Decided November 3, 2017 (non-precedential). US Patent No. 7,757,298 involved remotely accessing and retrieving user specified information. [1]
Discussion:	The claims lacked sufficient detail regarding the generation of the identification value from the content of the file. The court generalized many of the decisions of ineligible subject matter to reach the decision.
Representative claim:	1. A computer-implemented method for identifying and characterizing stored electronic files, said method comprising: under control of one or more configured computer systems:selecting a file from a plurality of files stored in a computer storage medium, wherein selecting the file is performed according to at least one of: selecting the file based on the size of the file by determining whether an aggregate size of plural identically-sized files exceeds a predetermined threshold; selecting the file based on whether content of the file matches a file type indicated by a name of the file; orselecting the file based on whether the file comprises data beyond an end of data marker for the file; generating an identification value associated with the selected file, wherein the identification value is representative of at least a portion of the content of the selected file; comparing the generated identification value to one or more identification values associated with one or more of a plurality of unauthorized files; and characterizing the file as an unauthorized file if the identification value matches one of the plurality of identification values associated with the unauthorized files.
Practice tips and takeaways:	See Electric Power tab - consider indicating that this is a non-precedential decision and should not be relied upon to compare the pending claims to an abstract idea deemed ineligible by the courts. In addition, point to Classen if your claims do more with the analysis than merely characterizing a file. It may be helpful to try claiming something the computer is doing that helps the computer do it faster and does not merely replicate what a human would do.
Case link:	http://www.cafc.uscourts.gov/sites/default/files/17-1147.Opinion.11-1-2017.1.pdf
Art Unit, Examiner:	2435, PonsoReay Pich
Citation:	[1] Intellectual Ventures I LLC v. Erie Indem. Co., 711 Fed. Appx. 1012, 2017 U.S. App. LEXIS 22060 (Fed. Cir. 2017).
Panelists:	Wallach, Prost, Reyna

McRO

Overview: Appeal from C.D. California - Decided September 13, 2016.

The Federal Circuit in *McRO, Inc. v. Bandai Namco Games America* reversed the district court's holding that certain software patent claims in U.S. Patent Nos. 6,307,576 and 6,611,278 were directed to ineligible subject matter under 35 U.S.C. § 101. The claims in this case were directed to applying certain rules to automatically generate animated facial expressions based on a sound transcript, or "phoneme sequence." Because the claims were directed to a genus of rules, rather than the general concept of applying rules in the field, the Federal Circuit held there was no preemption of an abstract idea. Thus, the claims were not directed to ineligible subject matter under § 101. [1]

Discussion: As an initial matter, the Federal Circuit held the claim's lack of any tangible elements was not material. Expanding on § 101 jurisprudence, the Federal Circuit noted that the "concern underlying the exceptions to § 101 is not tangibility, but preemption." The Federal Circuit reiterated its caution that district courts "must be careful to avoid oversimplifying the claims by looking at them generally and failing to account for the specific requirements of the claims."

Taking a close look at the claim language, the Federal Circuit held that the claimed "first set of rules" were not unlimited or unbounded—rather, they must evaluate sub-sequences consisting of multiple sequential phonemes. The claimed rules thus did not preempt the field, but rather were directed to a set of "rules with common characteristics, i.e., a genus." While genus claims may implicate enablement and written description issues under 35 U.S.C. § 112, the Federal Circuit explained, their breadth generally does not implicate § 101 subject matter eligibility issues.

Thus, the "specific structure of the claimed rules would prevent broad preemption of all rules-based means of automating lip-synchronization, unless the limits of the rules themselves are broad enough to cover all possible approaches." Here, the "limitations in claim 1 prevent preemption of all processes for achieving automated lip-synchronization of 3-D characters." Following the earlier *Enfish* decision, the Federal Circuit thus held the representative claim was not directed to an abstract idea, and thus did not meet *Alice* step one, thereby ending the inquiry.

Representative claim: 1. A method for automatically animating lip synchronization and facial expression of three-dimensional characters comprising: obtaining a first set of rules that define output morph weight set stream as a function of phoneme sequence and time of said phoneme sequence; obtaining a timed data file of phonemes having a plurality of sub-sequences; generating an intermediate stream of output morph weight sets and a plurality of transition parameters between two adjacent morph weight sets by evaluating said plurality of sub-sequences against said first set of rules; generating a final stream of output morph weight sets at a desired frame rate from said intermediate stream of output morph weight sets and said plurality of transition parameters; and applying said final stream of output morph weight sets to a sequence of animated characters to produce lip synchronization and facial expression control of said animated characters.

Practice tips and takeaways:

The Federal Circuit's decision provides another data point for software patents generally. Key to the Federal Circuit's holding was that there are other alternatives to the claimed method (e.g., rules that only evaluated individual phonemes). Thus, although the representative claim was not directed to tangible material, it claimed patent-eligible subject matter because it did not preempt the underlying broader abstract concept.

Case link:

<http://www.cafc.uscourts.gov/sites/default/files/s15-1080.Opinion.9-9-2016.2.pdf>

Art Unit, Examiner: 2672, Ryan Yang

Citations:

[1] McRO, Inc. v. Bandai Namco Games Am. Inc., 837 F.3d 1299 (Fed. Cir. 2016).

Panelists:

Reyna, Taranto, Stoll

Trading Technologies

Overview: Appeal from N.D. Illinois - Decided January 18, 2017

CQG appeals the district court's decision under 35 USC 101 that the asserted claims of US Patent Nos. 6,772,132 and 6,766,304 recite patent eligible subject matter. The appeal was limited to only the eligibility question under Section 101, and the Federal Circuit affirmed the district court's decision. This decision is a non-precedential decision.

Federal Circuit Holding: The court affirmed the finding of subject matter eligibility under 35 USC 101.

Technology: Methods and systems "for displaying market information relating to and facilitating trading of a commodity being traded in an electronic exchange...on a graphical user interface" including displaying market depth information and submitting a trade based on a user selection of a portion of the user interface.

Discussion: The Federal Circuit took claim 1 of the 304 patent as representative and analyzed the claim under the two-step Alice test. Going no farther than the first step, the Federal Circuit agreed with the district court's analysis that the patent claims are directed to solving problems found in prior graphical user interface devices used for computerized trading. For example, the Federal Circuit stated that "the patents describe a trading system in which a graphical user interface 'display[s] the market depth of a commodity traded in a market'" and the graphical user interface solves "'problems of prior graphical user interface devices...relating to speed, accuracy and usability.'" [1] The court found that these patents are directed to improvements in existing graphical user interface devices that have no "pre-electronic trading analog," and recite more than "'setting, displaying, and selecting' data or information that is visible on the [graphical user interface] device." [2] The court indicated that, "[f]or Section 101 purposes, the claimed subject matter is 'directed to a specific improvement to the way computers operate' because the claimed graphical user interface method imparts a specific functionality to a trading system 'directed to a specific implementation of a solution to a problem in the software arts.'" [3] The Federal Circuit liked the district court's analysis including their finding that "the challenged patents do not simply claim displaying information on a graphical user interface" but rather "require a specific, structured graphical user interface paired with a prescribed functionality directly related to the graphical user interface's structure that is addressed to and resolves a specifically identified problem in the prior state of the art." [4] With respect to step two of the Alice test, the Federal Circuit agreed with the district court, finding that the static price index was an inventive concept improving trade placement using an electronic trading system. Further, the electronic trading system is distinct from a conventional computer because the trading system provides "specific technologic modifications to solve a problem or improve the functioning of a known system." [5] Thus, the Federal Circuit found that the claims did not recite an abstract idea and, furthermore, recited something significantly more.

Representative claim: 1. A method for displaying market information relating to and facilitating trading of a commodity being traded in an electronic exchange having an inside market with a highest bid price and a lowest ask price on a graphical user interface, the method comprising: dynamically displaying a first indicator in one of a plurality of locations in a bid display region, each location in the bid display region corresponding to a price level along a common static price axis, the first indicator representing quantity associated with at least one order to buy the commodity at the highest bid price currently available in the market; dynamically displaying a second indicator in one of a plurality of locations in an ask display region, each location in the ask display region corresponding to a price level along the common static price axis, the second indicator representing quantity associated with at least one order to sell the commodity at the lowest ask price currently available in the market; displaying the bid and ask display regions in relation to fixed price levels positioned along the common static price axis such that when the inside market changes, the price levels along the common static price axis do not move and at least one of the first and second indicators moves in the bid or ask display regions relative to the common static price axis; displaying an order entry region comprising a plurality of locations for receiving commands to send trade orders, each location corresponding to a price level along the common static price axis; and in response to a selection of a particular location of the order entry region by a single action of a user input device, setting a plurality of parameters for a trade order relating to the commodity and sending the trade order to the electronic exchange.

Practice tips and takeaways: The Federal Circuit seemed to largely base its decision on the fact that the claimed graphical user interface addresses specific problems found in prior graphical user interfaces in this area (electronic trading). It is important to cast a problem in the prior art in terms of the technology and then make sure your claims recite an improvement to the technology that solves the problem. Judge Newman's opinion indicates that “[a]bstraction is avoided or overcome when a proposed new application or computer-implemented function is not simply the generalized use of a computer as a tool to conduct a known or obvious process, but instead is an improvement to the capability of the system as a whole.” The Federal Circuit panel found that close questions of subject matter eligibility should be “considered along with the understanding flowing from review of the patentability criteria of novelty, unobviousness, and enablement” because these statutory criteria provide context for the analysis of eligibility in light of the “patent-based incentive to technological progress.”

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/16-1616.Opinion.1-13->

Art Unit, Examiner: 3624, Richard Weisberger

Citations: [1] Trading Techs. Int'l, Inc. v. CQG, Inc., 675 F. App'x 1001, 1004 (Fed. Cir. 2017).
[2] *Id.*
[3] *Id.* at 1006.
[4] *Id.*

[5] *Id.*

Panelists: Newman, O'Malley, Wallach

Visual Memory

Overview: Appeal from D. Delaware - Decided August 15, 2017.

District court held that Visual Memory's US Patent No. 5,953,740 was drawn to patent-ineligible subject matter and that complaint failed to state a claim under 12(b)(6). The '740 patent applies to a common three-tiered memory hierarchy used in computer systems, which includes a bulk storage memory, a medium-speed main memory, and a high-speed processor cache memory. This hierarchal memory system allows executing programs quick access to required data, but lacks versatility because it has to be designed based on the particular type of processor selected for use in that system. The '740 patent purportedly overcomes this deficiency by using a memory system with programmable operational characteristics ("POC") that self-configure based on the type of processor connected to the memory system. Visual Memory appealed the district court's dismissal of patent infringement complaint against NVIDIA. Federal Circuit reversed and concluded that the claims were directed to an improvement to computer memory systems and not directed to an abstract idea.

Discussion: Federal Circuit noted that Enfish and Thales informed their evaluation of whether claims are "directed to" an abstract idea. The key question is whether the focus of the claims is on the specific asserted improvement in computer capabilities or instead on a process that invokes a computer as a tool. [1] The court found that the claims were directed to an improved computer memory system, not to the abstract idea of categorical data storage. [2] The court noted that the specification explains multiple benefits that flow from the '740 patent's improved memory system. Thus, the court found that the claims were directed to a technological improvement: an enhanced computer memory system. The distinction between the '740 patent and patent-ineligible claims in Content Extraction and TLI Communications is that the claims in '740 are directed at specific improvements to computer functionality, while Content Extraction was related to a method for using a computer to extract data from hard copy documents, and TLI was related a method of classifying and storing digital images that merely involved a computer and server. [3] The court concluded that the claims were not directed to an abstract idea, and thus did not analyze the claims under step two of the Alice test.

Representative claim: 1. 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.

Practice tips and takeaways: If you are drafting an application, it is important to include and explain benefits in the specification. This is one of a few recent Federal Circuit cases that look to the specification to see if there are improvements to computer functionality. If the application has already

been drafted and you are in prosecution, attempt to find something that you can hang your hat on.

Case link: <http://www.cafc.uscourts.gov/sites/default/files/opinions-orders/16-2254.Opinion.8-11->

Art Unit, Examiner: 4171, David Robertson

Citations: [1] Visual Memory LLC v. NVIDIA Corp., 867 F.3d 1253, 1258 (Fed. Cir. 2017).
[2] *Id.* at 1259.
[3] *Id.* at 1260.

Panelists: O'Malley, Stoll, Hughes (dissent)

	Judge																			
	Prost	Newman	Mayer	Plager	Lourie	Clevenger	Schall	Bryson	Linn	Dyk	Moore	O'Malley	Reyna	Wallach	Taranto	Chen	Hughes	Stoll	Rader	
Finjan									x	x (opinion)							x			
Berkheimer											x (opinion)				x			x		
DDR Holdings			x (dissent)											x		x (opinion)				
Trading Technologies		x (opinion)										x		x						
Core Wireless											x (opinion)	x		x (cip/dip)						
Aatrix											x (opinion)		x (dissent)		x					
BASCOM		x (concur)										x				x (opinion)				
Amdocs		x		x (opinion)									x (dissent)							
Enfish											x				x			x (opinion)		
Visual Memory												x (opinion)						x (dissent)	x	
McRO													x (opinion)		x				x	
Electric Power								x							x (opinion)				x	
Fairwarning				x	x														x (opinion)	
Classen		x (opinion) (add'l)									x (dissent)									x (add'l views)
Int. Ventures v Cap One										x (opinion)			x				x			
Int. Ventures v Erie		x											x	x (opinion)						
CyberSource		x						x		x (opinion)										
Digitech											x		x (opinion)					x		
Ameranth													x (opinion)				x		x	

Eligible
 Ineligible