

ELIGIBILITY HIGHLIGHTS POST *ALICE*

STEP 1:

- An idea itself is not patentable. “[A]t some level, all inventions embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” (*Alice*)
- Lack of technical details in specification, and broad, functional, pre-emptive claim limitations shows claim “directed to” an abstract idea. (*Chargepoint v. Semaconnect*)
- Prior art: (1) analysis of advancement over prior art and (2) prior art is used to show fundamental economic process or mathematical concept. (*Simio*)
 - ❑ Key sources – specification, prosecution history, admissions, extrinsic prior art?
- Does the claim improve functioning of the computer itself? (*Enfish, Finjan*)
- Does the claim recite technical solution to technical problem? (*Enfish*) Also, specific implementation for specific solution? (*McRO* (“specific process”), *Vanda Pharms, Data Engine, but see BSG Tech*)
- “We caution parties and tribunals not to conflate the separate novelty and obviousness inquiries under 35 U.S.C. §§ 102 and 103, respectively, with the step one inquiry under § 101.” (*PowerBlock Holdings v. iFit*)

ELIGIBILITY HIGHLIGHTS (cont'd)

■ STEP 1 (cont'd):

- “In cases involving software innovations, [the step-one] inquiry often turns on whether the claims focus on specific asserted improvements in computer capabilities or instead on a process or system that qualifies [as] an abstract idea’ ‘While the § 101 inquiry must focus on the language of the asserted claims themselves,’ the claim itself need not explicitly recite the improvement. Rather, our precedent supports a variety of analytical approaches including, for example, (1) looking to the written description to understand the problem facing the inventor and what the patent describes as the invention; (2) considering whether any technological improvement is ‘embodied in the claims’; and (3) analyzing whether the claims and written description ‘describe how [the] improvement was accomplished.’” (US Patent No. 7,679,637 v. Google) (citations omitted)

ELIGIBILITY HIGHLIGHTS (cont'd)

■ STEP 1 (cont'd) - EXAMPLES OF ABSTRACT IDEAS:

- Fundamental economic process (*Bilski, Alice* (“we need not labor to delimit the precise contours of the ‘abstract ideas’ category in this case. It is enough to recognize that there is no meaningful distinction between the concept of risk hedging in *Bilski* and the concept of intermediated settlement at issue here.”))
- Mental processes (*Benson, Trinity Info Media*)
- Method of organizing human activity (*Rideshare Displays*)
- Data gathering, analysis, and display (*Elec. Pwr. Group, TDE Petroleum, Clarilogic, Univ. of Fla.*)
- Filtering content (*Bascom*)
- Partitioning cells to be presented as a spreadsheet (*Data Engine*)
- Manually tracking modifications across multiple spreadsheets (*Data Engine*)
- Communication over a network for interacting with a device (*Chargepoint*)
- Delivering targeted advertising (*Customedia, Free Stream Media*)
- Controlling access to, or limiting permission to, resources (*Ericsson*)
- Tailoring information to a user’s characteristics, such as location (*British Telecom*)
- Format conversion (*Adaptive streaming*)

ELIGIBILITY HIGHLIGHTS (cont'd)

- **STEP 1 (cont'd) - EXAMPLES OF ABSTRACT IDEAS:**
 - Using graphics instead of programming to create object-oriented simulations (*Simio*)
 - Redeeming loyalty points for rewards (*CXLoyalty*)
 - Using one digital image and enhance it with another (*Yu*)
 - Each of the following: (1) Using content-based identifier, (2) comparing this identifier against other values, and (3) data-management (e.g., controlling access to data items, retrieving data items, and marking data for deletion) (*Personalweb*).
 - Automation of manual processes using generic computers (*Personalweb*).
 - Authentication (*USR, CosmoKey*)
 - Creating a travel log (*Weisner*)
 - Encoding and decoding image data and converting formats are each abstract ideas (*Hawk Tech.*)
 - Providing information based on meeting a condition, e.g., matching a GPS location indication with a geographic location (*Sanderling Management*)
 - Extracting and transferring information from a design file to a manufacturing machine (*Ficep Corp.*)

ELIGIBILITY HIGHLIGHTS (cont'd)

- **STEP 1 (cont'd) - EXAMPLES OF ABSTRACT IDEAS:**
 - Manipulating information using compression (*Realtime Data*)
 - Improving a user's experience without more (*Mobile Acuity, Customedia, Simio*)
 - Creating the appearance of movement, i.e., animation (*Plotagraph*)
 - Interacting with data objects on the WWW (*Eolas*)
 - Allowing/disallowing a bet based on where someone is located (*Beteiro*)
 - Performing a background check (*Miller*)
 - Arranging content in a particular order (*Broadband ITV*)
 - Collecting and using viewing history data to recommend categories of video content (*Broadband ITV*)
 - Identifying users in photos (e.g., tagging); determining associations between the users, photos, and other descriptive information; and storing an association between a user id and a photo id (*Angel Techs. Grp.*)
 - Recording authentication information—such as the customer's name, address, and telephone number—and including that information in a subsequent communication with the customer (*Elec. Commun. Techs.*)

ELIGIBILITY HIGHLIGHTS (cont'd)

- **STEP 1 (cont'd) - EXAMPLES OF ABSTRACT IDEAS:**
 - Selecting a fishing hook based on observed water conditions (*In re Rudy*)
 - Communicating information wirelessly (*Chamberlain Grp.*)
 - Rules for playing a dice game (*In re Marco Guldenaar Holding*)
 - Encoding and decoding image data (*RecogniCorp*)
 - Collecting, displaying, and manipulating XML data (*Intellectual Ventures v. Capital One*)
 - Providing out-of-region access to regional broadcast content (*Affinity Labs v. DirectTV*)
 - Delivering user-selected media content to portable devices (*Affinity Labs v. Amazon*)
 - Rules for playing a wagering game (*In re Smith*)
 - Use of conventional web browser navigational functions without data loss in an online form (*Internet Patents Corp.*)
 - Pricing a product for sale (*OIP Techs*)
 - Organizing information through mathematical correlations (*Digitech Image Techs*)

ELIGIBILITY HIGHLIGHTS (cont'd)

- **STEP 1 (cont'd) - EXAMPLES OF ABSTRACT IDEAS:**
 - Improving image quality by adjusting various aspects of an image (*Longitude Licensing*)
 - Scheduling of live events using machine learning (*Recentive Analytics*)
 - Generating an optimized TV network map using machine learning (*Recentive Analytics*)
 - Determining the location of a mobile device by collecting data about known locations, organizing that data in a database, and then comparing the data to measurements from the mobile device (*Geoscope Tech*)
 - Determining taxability status of aircraft (*Aviation Capital Partners*)
 - Depositing a check using a mobile device (*USAA v. PNC I & II*)
 - Mathematical formula (*Benson, Flook, Optis Cellular*)
 - Encoding and decoding data - converting formats (*DirectPacket*)
 - Discovering and publishing clearing prices of commodities within exchange markets (*In re Healy*)
 - Receiving, manipulating, and decoding data (*Technology in Ariscale*)

ELIGIBILITY HIGHLIGHTS (cont'd)

- **STEP 1 (cont'd) - EXAMPLES OF ABSTRACT IDEAS:**
 - Allowing asynchronous review of web-conferencing presentations (*US Pat. No. 7,679,637 v. Google*)
 - Sharing content using a unique identifier by matching the unique identifier with a location (*Q Technologies v. Walmart*)