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## Overcoming 101 Rejections for Computer and Electronics Related Patents

Leveraging USPTO Guidance and Recent Decisions to Meet 101 Patent Eligibility Requirements

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THURSDAY, JUNE 25, 2020

1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

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Today's faculty features:

Charles Bieneman, Member, **Bejin Bieneman**, Detroit

Michael P. Shepherd, Principal, **Fish & Richardson**, Redwood City, Calif. & New York

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# § 101 REJECTIONS AND COMPUTER-IMPLEMENTED INVENTIONS

Charles Bieneman of Bejin Bieneman  
Michael Shepherd of Fish & Richardson

June 25, 2020



# OVERVIEW OF THE *MAYO/ALICE TEST*

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

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

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

# THEMES OF RECENT SECTION 101 CASE LAW

- Major Refusals by the Supreme Court to Intervene
  - *Athena, Vanda, Berkheimer*
- The Growing Life Sciences Divide
- Continued Invalidations of Overly Result-Oriented Claims
- Lingering Questions for 2020 and Beyond

**FISH.**

# SUPREME COURT REFUSALS: *ATHENA DIAGNOSTICS*

- Fed. Circuit in 2019 held that new method of diagnosing neurological disorders is ineligible under *Mayo*
  - “Claiming a natural cause of an ailment and well-known means of observing it is not eligible for patent because such a claim in effect only encompasses the natural law itself. But claiming a new treatment for an ailment, albeit using a natural law, is not claiming the natural law.”
- Denial of petition for *en banc* rehearing resulted in 8 different opinions
- The Solicitor General and many amicus briefs urged the Supreme Court to review the case
- Supreme Court nevertheless declined to intervene

**FISH.**

## SUPREME COURT REFUSALS: *VANDA PHARMACEUTICALS*

- Fed. Circuit held that a new method of treatment is eligible
- Supreme Court declined to review on same day it declined to review *Athena*, apparently sensing no conflict

# SUPREME COURT REFUSALS: *BERKHEIMER*

- Fed. Circuit held that some eligibility questions require fact finding
- In particular, whether something is “well-understood, routine, or conventional” is a question of fact under *Alice* step 2
- Supreme Court declined the request to modify this rule

# THE GROWING LIFE SCIENCES DIVIDE

- Even brilliant or groundbreaking methods of *diagnosis* or *observation* are ineligible if they rely on a natural law
- In contrast, methods of *treatment* are eligible, even if simple methods of administering naturally occurring substances

# THE GROWING LIFE SCIENCES DIVIDE: *ATHENA* (FEB. 2019)

- Claims directed to new technique for diagnosing neurological disorders is ineligible
- The Fed. Circuit felt that it was bound by *Mayo* policy concerns notwithstanding
  - “We would add further that, in our view, providing patent protection to novel and non-obvious diagnostic methods would promote the progress of science and useful arts. But, whether or not we as individual judges might agree or not that these claims only recite a natural law . . . the Supreme Court has effectively told us in *Mayo* that correlations between the presence of a biological material and a disease are laws of nature[.]”

**FISH.**

## THE GROWING LIFE SCIENCES DIVIDE: *NATURAL ALTERNATIVES* (MAR. 2019)

- Claims directed to administering a naturally-occurring dietary supplement was eligible
- The Fed. Circuit further distinguished diagnostic claims from method of treatment claims
  - “The Method Claims at issue are treatment claims. They cover using a natural product in unnatural quantities to alter a patient’s natural state, to treat a patient with specific dosages outlined in the patents. We hold, therefore, that the Method Claims are not directed to ineligible subject matter.”

# THE GROWING LIFE SCIENCES DIVIDE: *CLEVELAND CLINIC* (APR. 2019)

- Fed. Circuit held that the claims for predicting cardiovascular disease are directed to a natural correlation

“The claims are not directed to new techniques for performing an immunoassay to detect a patient’s blood MPO levels. They only recite applying known methods to detect MPO levels in plasma, comparing them to standard MPO levels, and reaching a conclusion: that the patient’s blood MPO levels are elevated in comparison to a control group. This conclusion is simply another articulation of the natural law that blood MPO levels correlate with atherosclerotic CVD.”

# INVALIDATION OF RESULTS-ORIENTED CLAIMS: AMERICAN AXLE (OCT. 2019)

- Claims covered a technique for manufacturing a drive shaft liner to attenuate two types of vibration

1. A method for manufacturing a shaft assembly of a driveline system. . .  
providing a hollow shaft member;  
tuning at least one liner to attenuate at least two types of vibration  
transmitted through the shaft member; and  
positioning the at least one liner within the shaft member such that the at least one liner is configured to damp shell mode vibrations in the shaft member by an amount that is greater than or equal to about 2%, and the at least one liner is also configured to damp bending mode vibrations in the shaft member, the at least one liner being tuned to within about  $\pm 20\%$  of a bending mode natural frequency of the shaft assembly as installed in the driveline system.

# INVALIDATION OF RESULTS-ORIENTED CLAIMS: AMERICAN AXLE (OCT. 2019) (CONT.)

- Fed. Circuit held that the claims covered only the concept of the result
  - "What is missing is any physical structure or steps for achieving the claimed result of damping two different types of vibrations. The focus of the claimed advance here is simply the concept of achieving that result, by whatever structures or steps happen to work."
- The result garnered interest in a legislative fix to Section 101
  - "It's unthinkable the courts found this invention, a manufacturing process for making a key automotive part, as patent ineligible." -Doug Collins, Ranking Member of the House Judiciary Committee

# INVALIDATION OF RESULTS-ORIENTED CLAIMS: AMERANTH v. DOMINO'S (Nov. 2019)

- The claim covered “real-time synchronous communications” with a hand-held menu device

**...wherein the system is enabled for real time synchronous communications to and from the wireless handheld computing device utilizing the programmed handheld menu configuration including the capability of real time synchronous transmission of the programmed handheld menu configuration to the wireless handheld computing device and real time synchronous transmissions of selections made from the handheld menu configuration on the wireless handheld computing device...**

## INVALIDATION OF RESULTS-ORIENTED CLAIMS: AMERANTH V. DOMINO'S (Nov. 2019) (CONT.)

- Fed. Circuit held that the claims were too result-oriented
- “[The] claims ‘fail[]to recite a practical way of applying an underlying idea... [and] instead were drafted in such a result-oriented way that they amounted to encompassing “the principle in the abstract” no matter how implemented.”

# INVALIDATION OF RESULTS-ORIENTED CLAIMS: ERICSSON V. TCL (APR. 2020)

- Claims directed to limiting access to resources in a telephone communications system
1. ...an interception module for receiving a request from the requesting application domain software to access the software services component; and a decision entity for determining if the request should be granted wherein the decision entity is a security access manager, the security access manager holding access and permission policies; and wherein the requesting application domain soft-ware is granted access to the software services component via the at least one interface if the request is granted.

# INVALIDATION OF RESULTS-ORIENTED CLAIMS: ERICSSON V. TCL (APR. 2020) (CONT.)

- Fed. Circuit held that the claims failed to recite the technological advance
  - “[The] allegedly novel aspect of the invention is wholly missing from claims 1 and 5. Neither claim recites any particular architecture at all—much less the specific three layered architecture advocated by Ericsson. Nor does either claim recite software stacks or units—vertical, horizontal, or otherwise.”
- Judge Newman’s dissent criticizes the apparent new requirement to recite all technological information in the claims themselves

# INVALIDATION OF RESULTS-ORIENTED CLAIMS: CISCO V. UNILOC (MAY 2020)

- Claims directed to ranking ad-hoc radio communication systems

6. A method of operating an ad-hoc radio communication system having a plurality of stations formed into at least one network, the method comprising the step of:

determining a master/slave rank of each station in the network representative of the station's suitability for acting as master in the network using antenna performance characteristics of each station in view of the antenna's local environment; and

enabling a station with the highest rank to be master.

## INVALIDATION OF RESULTS-ORIENTED CLAIMS: CISCO V. UNILOC (MAY 2020) (CONT.)

- Fed. Circuit held that the claims did not recite any particular technique

“[The patent] broadly claims solving the problem of master stations potentially having inefficient antennas by choosing the station with the best antenna. The claim does not specify any particular metric or method for ranking. The entirety of the claim is simply the abstract idea and nothing more.”

## UPHOLDING SPECIFIC TECHNOLOGICAL ADVANTAGES: UNILOC V. LG (APR. 2020)

- Claims directed to a communication network that includes a data field for polling as part of an inquiry message, thus reducing latency for suspended devices
2. A primary station for use in a communications system comprising at least one secondary station, wherein means are provided
- for broadcasting a series of inquiry messages, each in the form of a plurality of predetermined data fields arranged according to a first communications protocol, and
  - for adding to each inquiry message prior to transmission an additional data field for polling at least one secondary station.

## UPHOLDING SPECIFIC TECHNOLOGICAL ADVANTAGES: UNILOC v. LG (APR. 2020) (CONT.)

- Fed. Circuit held that the claims did not merely recite an observation or a result
  - The claims at issue do not merely recite generalized steps to be performed on a computer using conventional computer activity. Instead, they are directed to “adding to each inquiry message prior to transmission an additional data field for polling at least one secondary station.” *See, e.g.*, ’049 patent at Claim 2. And this change in the manner of transmitting data results in reduced response time by peripheral devices which are part of the claimed system.

## UPHOLDING SPECIFIC TECHNOLOGICAL ADVANTAGES: CARDIONET V. BRAEMAR MANUFACTURING (APR. 2020)

- Claims directed to an improved cardiac monitoring technology that considers variability in beat-to-beat timing caused by premature ventricular beats

21. A device, comprising:

...

relevance determination logic to identify a relevance of the variability in the beat-to-beat timing to at least one of atrial fibrillation and atrial flutter; and an event generator to generate an event when the variability in the beat-to-beat timing is identified as relevant to the at least one of atrial fibrillation and atrial flutter in light of the variability in the beat-to-beat timing caused by ventricular beats identified by the ventricular beat detector.

## UPHOLDING SPECIFIC TECHNOLOGICAL ADVANTAGES: CARDIONET V. BRAEMAR MANUFACTURING (APR. 2020) (CONT.)

- Fed. Circuit held that the claims are directed to a technological improvement
- The technology was new rather than simply automating old techniques

“By analyzing the ‘variability in the beat-to-beat timing’ for ‘atrial fibrillation and atrial flutter in light of the variability in the beat-to-beat timing caused by ventricular beats identified by the ventricular beat detector,’ the claimed invention more accurately detects the occurrence of atrial fibrillation and atrial flutter, as distinct from V-TACH and other arrhythmias.”

# LINGERING QUESTIONS FOR 2020 AND BEYOND

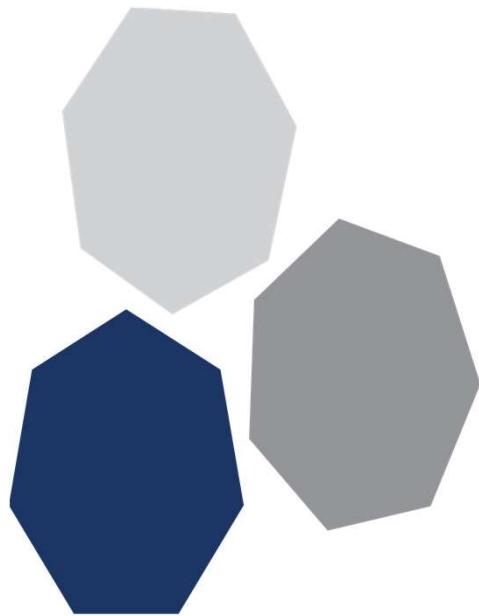
- How do you determine that claim elements will be considered “conventional” under *Berkheimer* (and thus essentially ignored for *Alice* step 2)?
- When and how do elements recited *in combination* matter under *Alice* step 2?
  - “Bozeman instead argues that the ordered combination of the elements in claim 1 of the ’840 patent is a specific implementation of an invention that was not routine or conventional. But Bozeman fails to identify what about the ordering of the steps in claim 1 provides an inventive concept.” *Bozeman v. Federal Reserve Bank* (Apr. 2020)

# THANK YOU



**Michael Shepherd**  
**Principal – Silicon Valley**  
650-839-5165  
[mshepherd@fr.com](mailto:mshepherd@fr.com)

**FISH.**



# § 101 LESSONS FROM THE PTAB

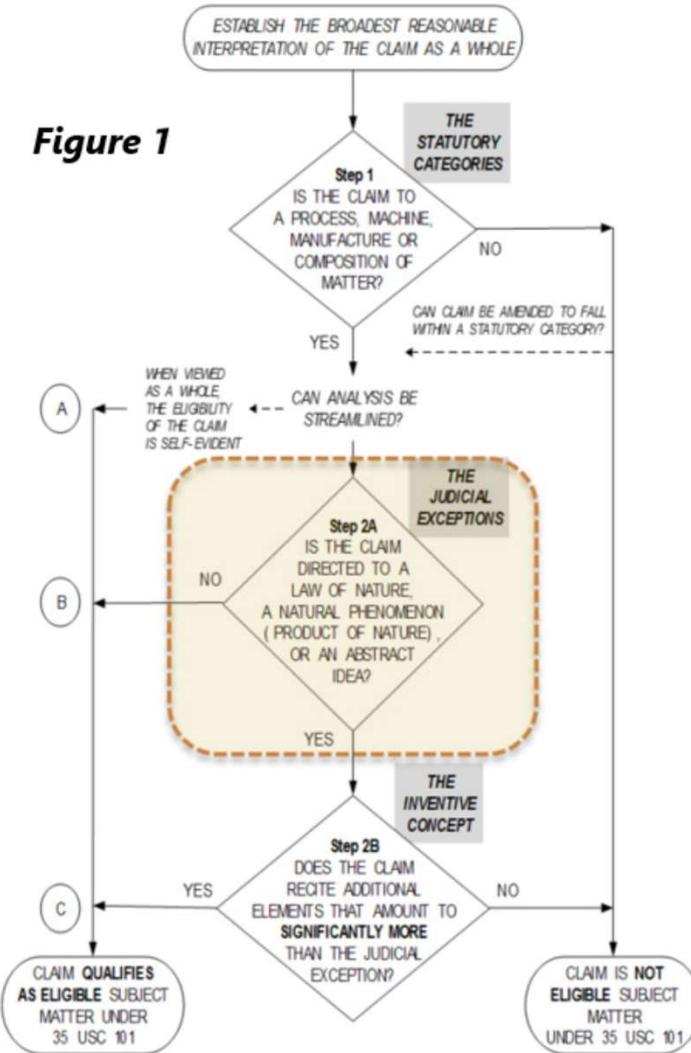
CHARLES BIENEMAN  
BEJIN BIENEMAN PLC  
JUNE 25, 2020

# USPTO TEST ≠ *Alice/Mayo*

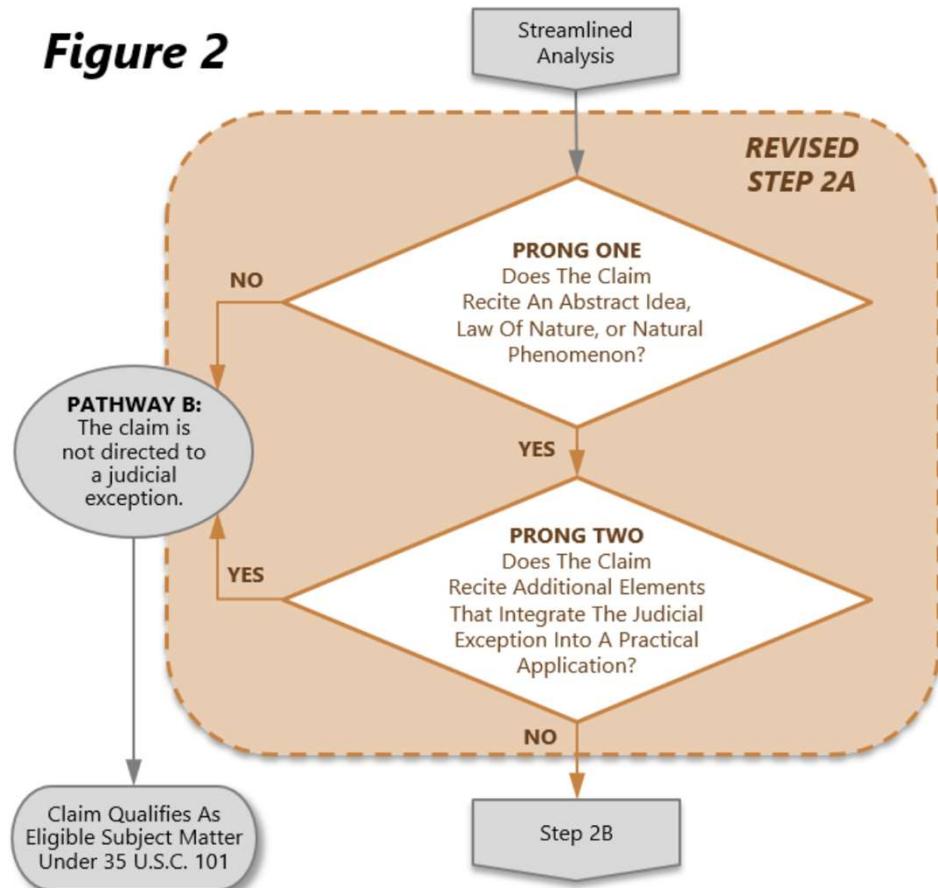
- *Alice / Mayo*
  - (1) Is the claim directed to an abstract idea and, if so,
  - (2) Does the claim recite significantly more (i.e., an inventive concept) so as to render the abstract idea patent-eligible?
- USPTO Jan. 2019 Guidance (plus Oct. update)
  - (1) Statutory claim? (transitory media/*Nuijten*, software *per se*)
  - (2A-1) Is the claim directed to a judicial exception (abstract idea), and
  - (2A-2) If the claim is directed to an abstract idea, **is the abstract idea integrated into a practical application?**
  - (2B) If the claim is directed to an abstract idea not integrated into a practical application, does the claim recite significantly more (i.e., an inventive concept) so as to render the abstract idea patent-eligible?
- USPTO April 2019 Guidance for *Berkheimer v. HP*.

# THE OCTOBER 2019 SURPRISE

**Figure 1**



**Figure 2**



# GUIDANCE 2A-1: ABSTRACT IDEAS

## (1) Mathematical concepts

- Mathematical relationships, mathematical formulas or equations, mathematical calculations.

## (2) Certain methods of organizing human activity

- Fundamental economic principles or practices (including hedging, insurance, mitigating risk);
- Commercial or legal interactions (including agreements in the form of contracts; legal obligations; advertising, marketing or sales activities or behaviors; business relations);
- Managing personal behavior or relationships or interactions between people (including social activities, teaching, and following rules or instructions).

## (3) Mental processes—concepts performed in the human mind (including an observation, evaluation, judgment, opinion)

- Can you successfully argue that your claim is NOT in one of these categories?

# GUIDANCE 2A-2: INTEGRATION INTO A PRACTICAL APPLICATION

- “A claim that integrates a judicial exception into a practical application will apply, rely on, or use the judicial exception in a manner that imposes a meaningful limit on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.”
- “Examiners evaluate integration into a practical application by:
  - (a) Identifying whether there are any additional elements recited in the claim beyond the judicial exception(s); and
  - (b) evaluating those additional elements individually and in combination to determine whether they integrate the exception into a practical application, using one or more of the considerations laid out by the Supreme Court and the Federal Circuit.”
- Does an “additional element”
  - improve a computer or a treatment?
  - implement judicial exception so machine/article is “integral to the claim”?
  - transform an article to a different state or thing?
  - or is there something else in the claim as a whole beyond just linking to particular technology?
- Not integrated into practical application:
  - “apply it,” “insignificant extra-solution activity,” field of use limitation.

# *CLEVELAND CLINIC (FED. CIR. APR. 1, 2019)*

- Patent owner: *Skidmore v. Swift & Co.*, 323 U.S. 134 (1944), requires “appropriate deference to subject matter eligibility guidance published by the PTO,” specifically “Example 29,” published on May 4, 2016.
- Judge Lourie, writing for the court:
  - While we greatly respect the PTO’s expertise on all matters relating to patentability, including patent eligibility, **we are not bound by its guidance. And, especially regarding the issue of patent eligibility** and the efforts of the courts to determine the distinction between claims directed to natural laws and those directed to patent-eligible applications of those laws, **we are mindful of the need for consistent application of our case law.**

# LESSONS – INTEGRATE THE GUIDANCE!

1. “Software *per se*” rejection is almost always questionable.
2. Applicant must show claims are directed to more than “mental steps.”
3. Fight generic “collecting and analyzing data” rejections with specifics.
4. Argue “integration into a practical application” carefully with case law → beware *Cleveland Clinic*.
5. Don’t forget, but don’t bank on, the examiner’s burden (*Berkheimer*).
6. Matching the facts of a precedential case is still your best bet.

# GUIDANCE STEP 1 – “SOFTWARE *PER SE*”

- According to the MPEP, this is a statutory rejection, not a “judicial exception” (a/k/a *Alice*) rejection:
  - “Products that do not have a physical or tangible form, such as information (often referred to as "data per se") or a computer program per se (often referred to as "software *per se*") when claimed as a product without any structural recitations.” MPEP § 2106.03(I).
- Often made when examiners don’t understand what “software *per se*” means.
  - “Notably, claim 1 recites a workflow-based cloud-management system *incorporated within* a cloud-computing facility with *servers*, *data-storage devices*, and *networks*, where the system’s automated-application-release-management subsystem *executes* pipelines and *interfaces* to an artifact-management-subsystem.” (Emphases by PTAB.)
    - *Ex parte Khazanchi*, Appeal 2019-001944, App. 14/959,013 (TC 2100, 4/10/2020)
- If the examiner has properly stated the rejection (i.e., you really are claiming a data structure), it should be easily curable by amendment.
  - Interviews are very helpful.

# MENTAL STEPS

- *Ex parte Tristan*, Appeal 2018-008621, App. 14/599,272 (5/13/20; TC 2100) → determining “correlated words” in text document via statistical analysis. ([Aff'd.](#))
  - 2A: Techniques could be performed with massively parallel computing: technical improvement?
    - No → generic computing technology, and claims didn’t require massively parallel processing or hardware
    - “Analyzing text based at least in part on a topic model encompasses evaluations performed by a human mentally or with pen and paper.”
  - 2B: “Claim 1’s ordered combination of limitations amounts to nothing more than the abstract ideas implemented with generic computer components that perform generic computer functions.”
- *Ex parte Smith*, Appeal 2018-004335, App. 14/599,272 (8/30/19; TC 2400) → “determining options for a vehicle based on a vehicle identifier, manufacturer codes, and model codes” ([Aff'd.](#))
  - “the manufacturer codes encoding a build level configuration for the vehicle”
  - “decode the retrieved manufacturer codes to determine vehicle option information for the vehicle by accessing at least one mapping table in a mapping database that maps the manufacturer codes to the vehicle option information.”
  - Claims “recite an abstract mental process of collecting/gathering information (receive a vehicle identifier and retrieve manufacturer codes), analyzing it (decode by accessing a mapping table), providing the results (output the list of vehicle options), and storing data.” Appellant’s argument was simply that the claims recited “concrete computer system components performing computing operations using mapping tables, databases and processors.”

# GATHERING AND ANALYZING DATA

- *Ex parte Carlson*, Appeal 2018-007757, App. 12/822,684 (TC 2100, 10/23/2019). ([Rev'd.](#))
  - Smartphone app included “displaying, proximate to each of the detected plurality of control components, the labels respectively corresponding to the shortcut keys assigned to the detected plurality of control components.”
  - Examiner relied on *Electric Power Group, LLC v. Altsom SA*, 830 F. 3d 1350 (Fed. Cir. 2016).
    - [Guidance gives three methods of organizing human activity → examiner failed to specify.](#)
  - PTAB liked *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1346 (Fed. Cir. 2018).
    - Claims were “directed to “an improved user interface for computing devices,” i.e., “a particular manner of summarizing and presenting information in electronic devices.”
    - Done at *Alice* step 1.
- *Ex parte Bushmitch*, Appeal 2018-008667, App. 14/499,297 (TC 2100, 3/12/2020) ([Rev'd.](#))
  - Training an adaptive learning system “configured to predict a set of predicted operational assessment data based, at least in part, on the set of raw technical performance data.”
  - Examiner relied on *Electric Power Group* – alleged mere collecting and analyzing of information.
  - PTAB: under Guidelines, no organization of human activity, or mental steps → done at *Alice* step one.

# GATHERING AND ANALYZING DATA

- Two lessons:
  1. Always better to win at *Alice* step one (*i.e.*, USPTO Step 2A).
  2. Can you simply argue the arrangement of a device (even if programming specific to a device)?  
→(Cf. arguing “integrated into a practical application.)

# PRACTICAL APPLICATION = TECHNICAL SOLUTION

- *Ex parte Varghese*, Appeal 2018-007176, App. 14/276,019 (TC2800; 7/31/2019)  
→ obtaining and analyzing ultrasound data for display. ([Rev'd.](#))
  - PTAB agreed claims “recite the abstract idea of a mathematical concept.”
  - **Practical application because the claims solved a technical problem:** “an ultrasonic probe” provides “an array of independently actuatable ultrasound elements having a predetermined spatial arrangement.”
    - Claims were like *Thales Visionix Inc. v. United States*, 850 F.3d 1343, 1349 (Fed. Cir. 2017).
  - Technical improvement: “the claimed system and method improve the output for three-dimensional elasticity reconstructions.”
- *Ex parte Chambliss*, Appeal 2018-008025, App. 14/746,905 (TC2800; 7/31/2019) → storage system organized into hierarchy of storage tiers. ([Rev'd.](#))
  - Claim recited a mathematical concept: “estimating a benefit metric as a value . . . the benefit metric including a sum of block scores.”
  - **Practical application because technical solution**, to better use more expensive higher tier storage: “to address the limited capacity of the higher tier, a maximum number of blocks and pages for selection and placement in the higher tier must be determined.”

# PRACTICAL APPLICATION?

- *Ex parte Mandava*, Appeal 2019-0001421, App. 15/262,516 (TC2100 2/21/2020) → “data processing, and more particularly to collaboration notification of [e.g., software] development based on artifact analysis.” (Rev’d.)
  - “creating or assigning a first artifact document that includes a description of a component of a product that is included in a product development cycle, and wherein the description is associated with a product development entity and includes a description of functionality of the product.”
- Majority → abstract idea (never explicitly identified) was integrated into a practical application: “the technology improvement of implementing artifact analysis with search engine text matches to transmit a collaboration notification to a product development entity when a collaboration criterion is satisfied, i.e., artifact-based, collaborative product development for an enterprise.”
  - Specification disclosed hardware (processor) and software (“artifact manager,” “search engine”)
- Dissent → claims recite a patent-ineligible mental process.
  - Generic computing technology, no technical improvement.
    - Claims improve a software process, but “that improvement results from the benefits provided by generic computer components performing generic computing functions to perform steps more quickly.”
  - Insignificant post-solution activity: “creating or assigning a document step [and transmitting step] is insignificant pre-solution activity because it is merely an information gather step necessary to perform the abstract idea—namely, analyzing the information to identify other relevant documents.”

# PRACTICAL APPLICATION?

- *Ex parte Rios*, Appeal 2019-004130, App. 14/873,440 (TC3600, 2/26/2020) → “automatically routing, by a multi-currency transaction routing platform, data about the transaction to one of the first and second funding bank accounts.” ([Rev'd.](#))
  - Apparatus claims not rejected under 101 (by examiner or PTAB).
  - “Payment methods are characterized as fundamental economic practices in the Eligibility Guidance, which are categorized as the abstract idea of organizing human activity.”
  - BUT practical application: “the additional elements limit the conventional practice of transacting multi-currency payments by reciting a ‘multi-currency transaction routing platform’ that routes to one of two accounts, where each account has a different currency.”
    - Another way of saying inventive concept? Technical?
- *Ex parte Olson*, Appeal 2018-008524, App. 14/363,496 (TC3600, 3/3/2020) → electronically managing insurance data. ([Rev'd.](#))
  - Fundamental economic practice: “Claims 1 and 10 relate to insurance and sales activities.”
  - “By setting a storage limit for data stored on an external computer backup/storage system according to a maximum capacity that is defined by a user-selected insurance product, Appellant’s claims 1 and 10 recite a practical application.”
- The “integrated into a practical application” prong seems to save some business methods (TC 3600) applications that previously would have been in trouble.
  - [What will courts do?](#)

# *BERKHEIMER*

- USPTO Guidance (April 2019 *Berkheimer Memo*)  
→ examiner has burden of providing evidence  
claims “recite well-understood, routine,  
conventional activity in the relevant field.”
- Evidence can be:
  - 1. Admission in Specification
  - 2. Court decision
  - 3. Publication
  - 4. Official Notice

# BERKHEIMER

- *Ex parte Basu*, Appeal 2018-000158, App. 14/146,638 (TC 3600, 1/2/2020) → settling transactions with “different payment systems and protocols.” (Rev’d.)
  - Request, authorization, and clearing messages (including adjusted transaction amounts for settlement) sent between servers.
  - Examiner found claims involved routine transmitting of messages and data processing, but had not provided any of the 4 categories of evidence required by *Berkheimer*.
- *Ex parte Poletti*, Appeal 2019-002526, App. 13/608,457 (TC 3600, 3/4/2020) → “a process to proactively manage ergonomics risks for manufacturing.” (Rev’d.)
  - “We agree . . . the Examiner has not provided the evidence required by *Berkheimer* to support the finding that the additional limitation “manufacturing the plurality of subassemblies according to the plurality of work plans and thereby the engineering design of the vehicle” was well-understood, routine, and conventional.
  - “[W]e are constrained by the record to reverse.”

# *BERKHEIMER*

- *Ex parte Tristan*, Appeal 2018-008621, App. 14/599,272 (5/13/20; TC 2100) → determining “correlated words” in a text document via statistical analysis using “massively parallel computing.” ([Aff'd.](#))
  - Appellant argued Examiner has not made *Berkheimer* findings.
  - PTAB didn’t care: “court decisions have recognized that generic computer components operating to collect, manipulate, and communicate data are well understood, routine, and conventional to a skilled artisan.”
- *Ex part Lutnick*, Appeal 2019-004065, App. 11/857,915 (3/2/20; TC 3600) → managing transactions between users and content providers in a data service. ([Aff'd.](#))
  - Claims directed to the “abstract idea of exchanging content and using content as an asset for bartering is applied to generic computing infrastructure and does not provide any particular practical application.”
  - Applicant argued that the examiner “merely provides conclusory statements and does not comport with the Berkheimer Memo.”
  - PTAB skipped the burden shifting, and, applying caselaw, found that the claims were simply an application of generic computing technology.

# THOUGHTS ON PRACTICE

- Interview!
- Argue the law (minimally) in Office Action responses.
- Argue the law, practically integrating the Guidance, in Appeal Briefs.
  - The best 101 appeals are also good 103 appeals.

# LESSONS

1. “Software *per se*” rejection is almost always questionable.
2. Applicant must show claims are directed to more than “mental steps.”
3. Fight generic “collecting and analyzing data” rejections with specifics.
4. Argue “integration into a practical application” carefully with case law → beware *Cleveland Clinic*.
5. Don’t forget, but don’t bank on, the examiner’s burden (*Berkheimer*).
6. Matching the facts of a precedential case is still your best bet.



# THANK YOU!

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