

Concrete Analysis of Abstract Idea: *Alice/Mayo* Step One

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The Problem With “Abstract Idea”

- Undefined except by example in software cases
- At some level, almost any software-based claim can be said to be directed to an abstract idea
- Even something physical like controlling a robot’s movement

Alice/Mayo Step One - *Enfish*

- “We must first determine whether the claims at issue are directed to a patent-ineligible concept.”
 - *Alice*, 134 S. Ct. at 2355 (quoted in *Enfish*, 822 F.3d at 1335)
- “That formulation plainly contemplates that the first step of the inquiry is a meaningful one, i.e., that a substantial class of claims are *not* directed to a patent-ineligible concept.”
 - *Enfish*, 822 F.3d at 1335

Alice/Mayo Step One - *Enfish*

- “The ‘directed to’ inquiry, therefore, 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.”
 - *Enfish*, 822 F.3d at 1335

Software Does What Hardware Did

- Software is **supposed** to run on generic hardware (processor = a bunch of circuits and circuit elements)
- Software is **supposed** to reduce or eliminate the need for special-purpose hardware
- Software is **supposed** to accomplish what circuits and circuit elements accomplished

Back to *Alice/Mayo* Step One

- “Software can make non-abstract improvements to computer technology just as hardware improvements can,…”
- “...and sometimes the improvements can be accomplished through either route.”
- “Therefore, we find it relevant to ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea, even at the first step of the *Alice* analysis.”
 - *Enfish*, 822 F.3d at 1335

Software Does What Hardware Did

- A circuit arrangement clearly is **patent-eligible**
- **Patentability** (novelty and unobviousness) analysis proceeds immediately in circuits cases
- The circuit arrangement is **patentable** provided it is claimed sufficiently clearly

Back to *Alice/Mayo* Step One

- “For that reason, the first step in the *Alice* inquiry in this case asks whether the focus of the claims is on the specific asserted improvement in computer capabilities ...”
- “... or, instead, on a process that qualifies as an "abstract idea" for which computers are invoked merely as a tool.”
 - *Enfish*, 822 F.3d at 1335-1336

Software Runs on Generic Hardware

- That's really the point of having software
- Maybe software just needs to be disclosed and claimed at the same level of specificity that hardware does
- That's how the software can be shown to be more than “merely a tool”
- That's how the software can be shown to improve computer capabilities

But Does That Go Far Enough?

- What does it really mean to “improve computer capabilities”?
- Does the computer have to run better?
- Or is it enough that the programmed computer does its intended job better?
- If my robotic control is improved with better programming, shouldn't I be allowed to apply for a patent?
- Or do I have to be able to show that the software improves the functioning of the computer?

Thank you!

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