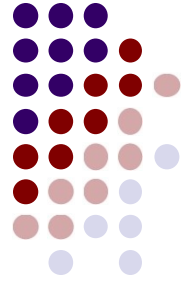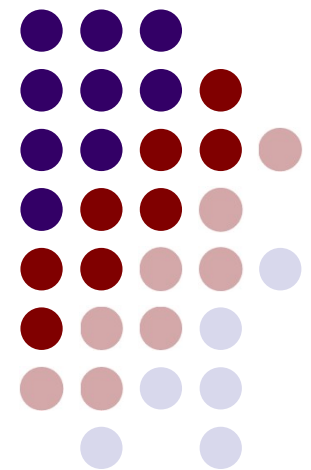# Overview of Recent Federal Circuit decisions concerning Section 101

Irene Lin

February 24, 2021

# USPTO Latest Guidance (October 2019)

- **Evaluating Whether A Claim Recites A Judicial Exception At Step 2A Prong One**

- **The Groupings Of Abstract Ideas Enumerated In The 2019 PEG**

- **Evaluating Whether A Judicial Exception Is Integrated Into A Practical Application At Step 2A Prong Two**

- **Requirements Of A *Prima Facie* Case**

USPTO Latest Guidance (October 2019)
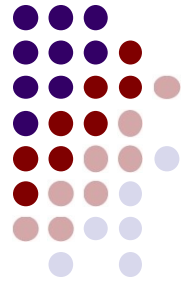
- **Evaluating Whether A Judicial Exception Is Integrated Into A Practical Application At Step 2A Prong Two**

  - If the additional limitations reflect an improvement in the functioning of a computer, or an improvement to another technology or technical field, the claim integrates the judicial exception into a practical application and thus imposes a meaningful limit on the judicial exception.

  - The limitations containing the judicial exception as well as the additional elements in the claim besides the judicial exception need to be evaluated together to determine whether the claim integrates the judicial exception into a practical application.

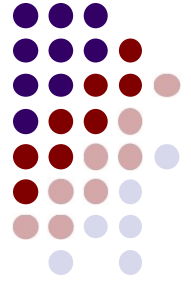# *EcoServices, LLC v. Certified Aviation Serv., LLC* **Eligible**
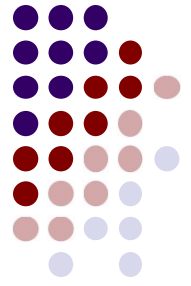
1. A system for washing turbine engines comprising:

a washing unit for providing a washing liquid to the turbine engines;

an information detector configured to gather information related to engine type; and

a control unit configured to accept the information related to engine type from the information detector and to determine a washing program to be used as a function of the information relating to engine type from a set of preprogrammed washing programs, and further configured to regulate the washing unit according to washing parameters associated with the washing program used.

# *EcoServices, LLC v. Certified Aviation Serv., LLC* Eligible
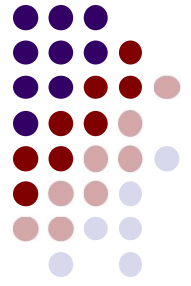
- EcoServices: the recited subject matter was simply an automated human process for washing turbine engines.

- The Court:

  - Claim 1 was eligible because it recites claim language directed to a specific system that improves jet engine washing.

  - the invention to which the claim language was directed was more than a desired result or a computer merely practicing a known process.

  - the claimed subject matter achieved a level of automation that provides an improvement over the prior art human-operated washing systems by reciting a *specific combination* of a type of washing unit, information detector, and control unit.

EcoServices, LLC v. Certified Aviation Serv., LLC Eligible

- **The key:**
  - Technical advantages can be found in the Specification

  - Technical advantages were tied to the language of claim.

  - Technical improvements can be identified in the claims over prior art (McRO).

TecSec v. Adobe (Fed. Cir. 2020) **Eligible**
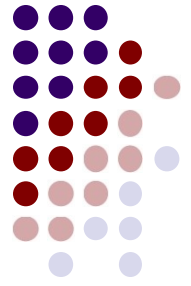
A method for providing multi-level multimedia security in a data network, comprising the steps of:

A) accessing an object-oriented key manager;

B) selecting an object to encrypt;

C) selecting a label for the object;

D) selecting an encryption algorithm;

E) encrypting the object according to the encryption algorithm;

F) labelling the encrypted object;

G) reading the object label;

H) determining access authorization based on the object label; and

I) decrypting the object if access authorization is granted.

# *TecSec v. Adobe* (Fed. Cir. 2020) **Eligible**
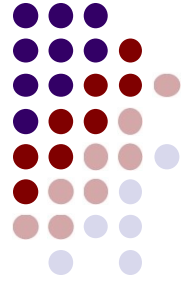
- The Court made two inquiries:
  - Whether the focus of the claimed advance is on a solution to a problem specifically arising in the realm of computer networks; and
  - Whether the claim identifies a specific improvement to computer capabilities.
- Adobe: the claims are directed to abstract idea of managing access to objects using multiple levels of encryption.
- The Court:
  - Adobe disregarded other express claim elements to proceed as a high level of abstraction (e.g., object-oriented key manager).
  - Both specification and prosecution history support the importance of the disregarded claim element which is part of the focus of the claimed advance.
  - The specification "elaborates in a way that simultaneously shows that the claims at issue are directed at solving a problem specific to computer data networks.

iLife Technologies v. Nintendo
Ineligible
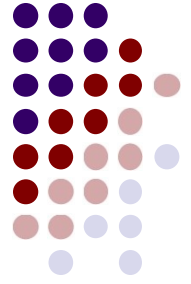
A system within a communication device capable of evaluating movement of a body relative to an environment, said system comprising:

a sensor, associable with said body, that sense dynamic and static accelerative phenomena and static accelerative phenomena of said body, and
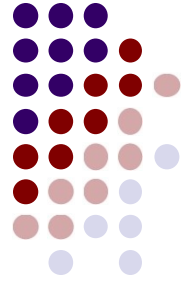
a processor, associated with said sensor, that processes said sensed dynamic and static accelerative phenomena as a function of at least one accelerative event characteristic to thereby determine whether said evaluated body movement is within environmental tolerance

wherein said processor generates tolerance indicia in response to said determination; and

wherein said communication device transmits said tolerance indicia.

protecting the product of your mind

iLife Technologies v. Nintendo
Ineligible

iLife: the claim recited a physical system incorporating *improved techniques* for using raw sensor data.

The Court:

- the claim failed to provide any concrete detail for performing the associated functions of the motion sensor system, and instead, "merely amount[ed] to a system capable of sensing information, processing the collected information, and transmitting processed information."

- the claim at issue merely recited a motion sensor system using static and dynamic acceleration information.

- the claim was distinguished from *Thales*, which recited "a particular configuration of inertial sensors and a specific choice of reference frame to more accurately calculate position and orientation of an object on a moving platform."

Simio, LLC. V. FlexSim Software Products, Inc. **Ineligible**
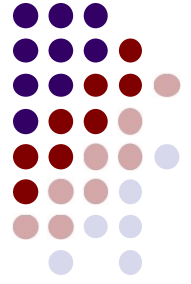
A computer-based system for developing simulation models on a physical computing device, the system comprising:

one or more graphical processes;

one or more base objects created from the one or more graphical processes;

wherein a new object is created from a base object of the one or more base objects by a user by assigning the one or more graphical processes to the base object of the one or more base objects;

wherein the new object is implemented in a three-tier structure comprising:

an object definition, wherein the object definition includes a behavior;

one or more object instances related to the object definition; and

one or more object realizations related to the one or more object instances;

wherein the behavior of the object definition is shared by the one or more object instances and the one or more object realizations; and

an executable process to add a new behavior directly to an object instance of the one or more object instances without changing the object definition and the added new behavior is executed only for that one instance of the object.

Simio, LLC. V. FlexSim Software Products, Inc. **Ineligible**
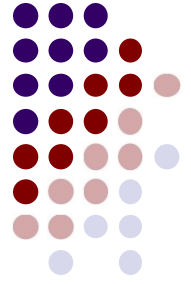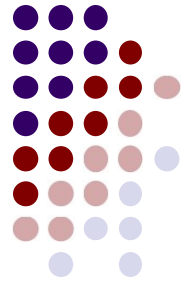
Simio: claim 1 improves a computer's functionality by improving computer-implemented simulations.

The Court:

- the focus of claim 1 is directed to the idea of using graphics instead of using programming to create object-oriented simulations ("maybe a new idea, but still an abstract one").
- the improvement was not to the computer's functionality, but rather to a user's experience (e.g., not having to program in order to generate simulations).
- "improving a user's experience while using a computer application is not, without more, sufficient to render the claims directed to an improvement in computer functionality."

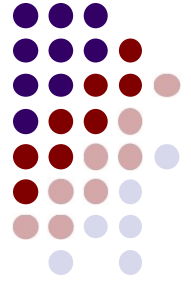# *Simio, LLC. V. FlexSim Software Products, Inc.* **Ineligible**

Simio: the "executable-process" feature of claim 1 reflects an improvement to computer functionality

The Court:
- by reviewing the Specification, the "character" of claim 1 is directed towards an abstract idea.
- the Specification focuses on the abstract idea of using graphics instead of programming to create object-oriented simulations, and does not articulate the functionality reflected in the executable process limitation.

Adaptive Streaming Inc. v. Netflix, Inc. **Ineligible**

A system to broadcast to at least one client device, the system comprising:

a processor; and

a broadcasting server coupled to the processor, the broadcasting server including:

an image retrieval portion to retrieve at least one incoming video signal having a first format;

a data structure usable to determine parameters for second compression formats for the at least one incoming video signal; and

at least one transcoding module coupled to the image retrieval portion and which has access to the data structure, the transcoding module being capable to transcode the at least one incoming video signal from the first format into multiple compressed output video signals having respective second compression formats based at least in part on the parameters;

wherein at least one of the second compression formats is more suitable for the at least one client device than the first format; and

wherein the multiple compressed output video signals having the at least one second compression format more suitable for the at least one client device can be provided by the broadcasting server, wherein any one of the multiple compressed output video signals can be selected to be presented at the at least one client device.

# *Adaptive Streaming Inc. v. Netflix, Inc.* **Ineligible**
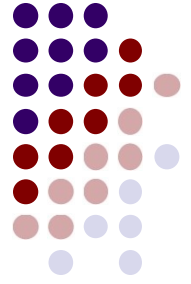
The Court:

- the claims are directed to the abstract idea of collecting information and transcoding it into multiple formats.
- the claims and specification "make clear that the focus of the claimed advance is the abstract idea of format conversion" and not "any specific advance in coding or other techniques for implementing that idea; no such specific technique is required."
- the claims recite only generic computer hardware, "no identification in the claims or written description of specific, unconventional encoding, decoding, compression, or broadcasting techniques."
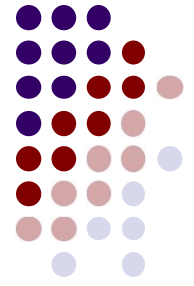
Practice tips

- Avoid
  - Purely functional terms to implement the abstract idea
  - Functional description in the Spec lacking specific explanations or technical details describing the technological improvement
  - No or vague discussion of focus of the claimed advance of over the prior art
  - Admitting "generic" "conventional" hardware used in the invention, performing "common function" "well known in the art"
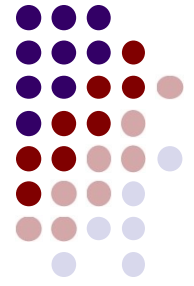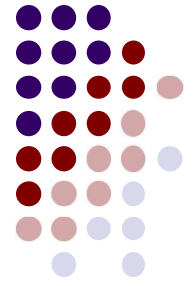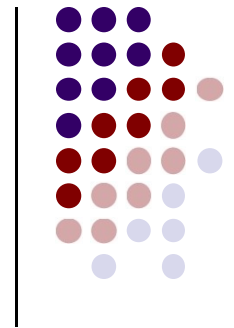
Practice tips

- ## Favorable if:

  - Actually claiming the technological solution

  - Providing a detailed discussion of the technical advantages of the invention (how the claimed invention operates differently to solve the technical problem and overcome the failure of the conventional technology)

  - Providing a Declaration explaining the technological improvements if the Specification does not explicitly describe the same (introducing evidence of along-felt or unresolved need that the prior art was unable to achieve, evidence of commercial success)

  - Elaborating in the response what the focus of the claimed advance over the prior art, with claimed language in light of the Specification

Practice tips

- Rebuttal points:
  - The Examiner has not establish a *Prima Facie* case.
  - Technological improvements do not need to be recited in the claims themselves.
  - What the claimed invention is directed to alleged by the Examiner is inaccurate, and misses important claim elements that are part of the focus of the claimed advance.

The End

protecting the product of your mind