



Patent Law Committee Newsletter Fall 2016



Chair: [Paul Kitch](#)



Vice-Chair: [Sarah Knight](#)

Hello and welcome to the Fall 2016 issue of the Patent Law Committee (PLC) Newsletter during my term as Chair of the Committee. We hope to see you all at [AIPLA's 2016 Annual Meeting](#) in Washington, DC from October 27th to 29th, and encourage you to [register here](#).

Sarah Knight and I would like to invite you all to our committee's CLE program, being held in conjunction with the Patent Relations with the USPTO section, on **Thursday, October 27th at 3:30 pm**. The CLE is titled: ***Claim Interpretation Throughout Your Patent's Lifecycle: From Obtaining Your Patent Through Litigation***, and the panelists will provide a discussion and comparison of claim interpretation, with an emphasis on the broadest reasonable interpretation (BRI) standard, and how it is applied during the three phases of the patent lifecycle — from patent prosecution through possible litigation and inter partes review. Updates after *Cuozzo* will also be considered.

We also encourage everyone to attend the Patent Law Committee **Business Meeting** on **Thursday, October 27th at 5:00** immediately following the Committee's CLE, we will present on the activities of the Committee and each of the Subcommittees.

We appreciate your involvement in the PLC, and I would like to reiterate volunteers are always welcome and I encourage everyone interested to become involved with the Committee. In this regard, please feel to reach out to Sarah Knight and myself if you would like to get involved with and/or if you have ideas or suggestions for the Committee. The contact information for each subcommittee leader is listed on the last page of this Newsletter. You can also reach out to us at the Annual Meeting.

Very truly yours,

Paul R. Kitch
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Have you registered for the 2016 Annual Meeting yet?

AIPLA's 2016 Annual Meeting will take place **October 27-29**
at the **Marriott Wardman Park Hotel** in Washington, DC!

Click [here](#) for more information and to register.

Upcoming Events...

Annual Meeting Program Highlights

Tuesday, October 25th & Wednesday, October 26th

9:00 am – 5:00 pm **Patent Prosecution Boot Camp**
Separate Registration Required – [CLICK HERE TO REGISTER](#)

Thursday, October 27th

6:30 am – 8:00 am **Law Practice Management Breakfast**
Business Development: Where is Your Next Client Going to Come From?

9:00 am – 12:00 pm **Track 1: Patent Prosecution**
Information Disclosure Statements and the Duty of Disclosure: When Is Enough Enough?

- The Current Standard of Disclosure, the Tools to Conform, and Tales to Consider from the USPTO Office of Enrollment and Discipline
- Enough is Enough – Round 1 Goes to the Patent Practitioner
- Enough is Enough – Round 2 Goes to the Litigator
- Enough is Enough – Rebuttal Time

12:30 pm – 2:00 pm **Luncheon**
The Honorable David Ruschke, Chief Judge, Patent Trial and Appeals Board

3:30 pm – 5:00 pm **Committee Educational Sessions**
Patent Law Committee / Patent-Relations with the USPTO (Joint Session)

- Claim Interpretation Through-out Your Patent's Lifecycle: From Obtaining Your Patent Through Litigation
- The Broadest Reasonable Interpretation of BRI
- Claim Interpretation in IPR – BRI from the PTAB Perspective
- A Prosecutor's View: BRI During Patent Prosecution
- Examiner Training and Objectives When Applying BRI

5:00 pm – 5:30 pm **Committee Meetings**
Patent Law Committee – Business Meeting – All members welcome

Friday, October 28th

8:45 am – 11:45 am **Track 1: PTAB Reloaded**
PTAB Trials: A Live PTAB Hearing

12:15 pm – 1:45 pm **Luncheon**
The Honorable Michelle Lee, Director, US Patent and Trademark Office, Alexandria, VA

Upcoming Events...

AIPLA Webinars

Thursday
October
13

12:30 - 2:00 pm EDT

Conflicts of Interest in Patent Law: Novel Problems with Non-obvious Solutions

1.5 Ethics credits available!

[Click here for more information and to register.](#)

Tuesday
October
18

12:30 - 2:00 pm EDT

Best Practices for IP Hiring Managers

A FREE webinar for AIPLA Members!

[Click here for more information and to register.](#)

Thursday
October
20

3:00 – 4:00 pm EDT

Advice from In-House Counsels to New Associates on Handling IP Matters

*A presentation from the Education Committee's
Law School Outreach Program Subcommittee*

[Click here for more information and to register.](#)

Features...

Avoiding Pitfalls in Patent Preparation and Prosecution in the Electrical and Computer Arts

By [Theresa Stadheim](#) of Schwegman, Lundberg & Woessner, PA.



Introduction

Subject matter eligibility and functional claiming issues have bedeviled patent practitioners in the electrical and computer arts in recent years. Adding to the uncertainty, *Alice Corp. v. CLS Bank International*¹ was decided on June 19, 2014. *Alice* presented the issue of whether claims directed to a computer-implemented service for facilitating financial transactions were ineligible for patent protection because they contained an abstract idea. Within a month of this decision, which determined that such claims were indeed invalid, allowed cases were withdrawn from allowance, and Applicants in certain art classes began receiving massive numbers of 35 USC §101 rejections.

To further the confusion, in *Williamson v. Citrix Online*,² the Federal Circuit weakened the strong presumption against the application of 35 USC §112(f) against claim language that did not use the word “means.” After *Williamson*, Examiners began interpreting claim language under §112(f) even when practitioners did not intend such interpretation, and indefiniteness rejections were made whenever it was alleged that adequate corresponding structure could not be found in the specification.

This paper provides some insight and practice tips for drafting with functional claiming in mind, so as to simultaneously address eligibility issues.

I. Avoiding Pitfalls in Subject Matter Eligibility

A. 2014 Interim Guidance on Patent Subject Matter Eligibility

The *Alice* decision was a dramatic turning point for subject matter eligibility and practitioners looked to the USPTO for guidance and clarity. On December 16, 2014,³ the USPTO published Interim Guidance for use by USPTO personnel in determining subject matter eligibility under 35 USC §101. The Interim Guidance was meant to supplement preliminary instructions issued in view of *Alice*.

The Interim Guidance provided a flowchart to illustrate subject matter eligibility analysis to be used during examination to evaluate whether a claim was drawn to patent-eligible subject matter. The Interim Guidance provided a list of claim examples of claims that are not subject-matter eligible, being directed to a

¹ *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2356 (US 2014).

² *Williamson v. Citrix Online, LLC*, 115 USPQ2d 1105 (Fed. Cir. 2015).

³ <https://www.gpo.gov/fdsys/pkg/FR-2014-12-16/pdf/2014-29414.pdf>

law of nature or natural phenomenon, or an abstract idea. When a claim falls under one of these judicial exceptions, in order to be patent-eligible, the claim must “include additional features to ensure the claim describes a process or product that applies the exception in a meaningful way, such that it is more than a drafting effort designed to monopolize the exception.” The whole claim is to be considered, because, as the USPTO acknowledged, “individual elements viewed on their own may not appear to add significantly more... but when combined may amount to significantly more than the exception.” What is enough to qualify as “significantly more” has been subject to great debate, but some examples were given in the Interim Guidance. The Interim Guidance also gave examples of what would not be considered “significantly more.”

B. July 2015 Update: Subject Matter Eligibility⁴

An update in July 2015 built on the 2014 Interim Guidance and responded to user comments. The July 2015 Update was intended to provide “pathways to eligibility.” While the Update did not (and legally could not) provide a definition of an “abstract idea,” Examiners were instructed to make findings that a claim was directed to an abstract idea when the concept was “similar to at least one concept that the courts have identified as an abstract idea.” The July 2015 Update provided more information about the types of concepts that were considered by the courts to be abstract ideas. These were described in categories: 1.) fundamental economic practices; 2.) certain methods of organizing human activity; 3.) an idea “of itself,” which includes ideas “standing alone such as an uninstigated concept, plane or scheme, as well as a mental process...that can be performed in the human mind; and 4.) mathematical relationships/formulas.

The July 2015 Update also gave more examples, “particularly for claims directed to abstract ideas and laws of nature” including “claims directed to abstract ideas, particularly in the business method, graphical user interface (GUI), and software areas.” The July 2015 Update stressed the importance of the step 2B analysis as to whether “the claim as a whole amounts to significantly more than an exception.” Several of the examples provided in the July 2015 Update were specifically directed to this “significantly more” analysis.

The July 2015 Update also provided clarification on the role of preemption in the eligibility analysis, including whether and when preemption should be considered in the streamlined analysis. The 2014 Interim Guidance established a streamlined eligibility analysis for certain claims that clearly do not attempt to preempt use of a judicial exception. However, as pointed out in the July 2015 Update, “while a preemptive claim may be ineligible, the absence of complete preemption does not guarantee that a claim is eligible.”

After the 2015 Update, a slight uptick was observed in allowance rates. In at least some art units, allowance rates were back to or near pre-*Alice* levels.⁵

C. Memorandum-Formulating a Subject Matter Eligibility Rejection and Evaluating the Applicant’s Response to a Subject Matter Eligibility Rejection⁶

In a memorandum dated May 4, 2016, Robert W. Bahr, Deputy Commissioner for Patent Examination Policy provided examination instructions relating to subject matter eligibility. Examiners were instructed to identify any abstract idea (found in step 2A) in their 35 USC §101 rejections, and explain why the so-called abstract idea corresponds to a concept that the courts have identified as an abstract idea. If the Examiner alleges that a claim is directed a law of nature or a natural phenomenon, such law of nature or natural

⁴ <http://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf>

⁵ <https://knobbe.com/news/2016/09/impact-uspto-examination-guidelines-software-patents-post-alice> (last visited September 17, 2016)

⁶ <http://www.uspto.gov/sites/default/files/documents/ieg-may-2016-memo.pdf>

phenomenon must be identified. For the second part of the analysis (step 2B), the rejection should identify the additional elements in the claim and explain why the elements taken individually and in combination do not amount to significantly more than the exception identified in step 2A.

D. Memorandum-Recent Subject Matter Eligibility Decisions⁷

On May 19, 2016, Deputy Commissioner Bahr sent a memorandum to the Patent Examining Corps regarding recent subject eligibility decisions (specifically, the *Enfish, LLC v. Microsoft Corp.* and *TLI Communications LLC v. A.V. Automotive, LLC* decisions).

Deputy Commissioner Bahr stated that, in *Enfish*, the Federal Circuit held that claimed database software designed as a “self-referential” table is patent eligible because it is not directed to an abstract idea. According to Deputy Commissioner Bahr, *Enfish* did not change the subject matter eligibility framework, but provided additional information and clarification on how to identify abstract ideas.

As summarized by Deputy Commissioner Bahr, the Federal Circuit noted that “when determining whether a claim is directed to an abstract idea, it is appropriate to compare the claim to claims already found to be directed to an abstract idea in a previous court decision.” As pointed out by Bahr, “the fact that a claim is directed to an improvement in computer-related technology can demonstrate that the claim does not recite a concept similar to previously identified abstract ideas.” Bahr mentioned that the Federal Circuit noted in its *Enfish* decision that “some improvements in computer-related technology, such as chip architecture or an LED display, when appropriately claimed, are undoubtedly not abstract.” Further, “claims directed to software...also are not inherently abstract.”

Bahr told Examiners that they “may determine that a claim directed to improvements in computer-related technology is not directed to an abstract idea under Step 2A of the subject matter eligibility examination guidelines (and is thus patent eligible), without the need to analyze the additional elements under Step 2B.” Thus, the way to determine whether any particular claim is patent eligible is to subjectively determine whether the claim resembles a claim that has been previously determined to be abstract, or whether it is more like a claim that has previously been determined not to be abstract.

Bahr also mentioned the *TLI* decision, which found that the claims at issue were abstract and did not add substantially more, which made the claims patent ineligible. Bahr explained that the Federal Circuit found that performing the steps of “using a telephone unit and a server did not add significantly more to the abstract idea because they were well-understood, routine, conventional activities.”

Bahr cautioned Examiners against “describing a claim at a high level of abstraction untethered from the language for the claim when determining the focus of the claimed invention.”

E. Case Law Updates

Case Name	Court	High Level	Take-away
<i>Enfish, LLC v. Microsoft Corp.</i> , 822 F.3d 1327 (Fed. Cir. 2016)	Fed Cir	Abstractness inquiry should ask “whether the focus of the claims is on the specific asserted improvement in computer capabilities” or “a process that qualifies as an ‘abstract idea’ for	Draft software-related claims that are directed to a specific improvement in computer operation

⁷ http://www.uspto.gov/sites/default/files/documents/ieg-may-2016_enfish_memo.pdf

		which computers are invoked merely as a tool.”	
<i>Elec. Power Group, LLC v. Alstom S.A.</i> , Case No. 2015-1778 (Fed. Cir. Aug. 1, 2016)	Fed Cir	Claimed steps could have been done mentally, therefore the claim was abstract.	Claim <u>how</u> things are done rather than just <u>which</u> things are done. Provide algorithms for any operations.
<i>McRO, Inc. v. Bandai Namco Games Am. Inc.</i> , 2016 US App. LEXIS 16703 (Fed. Cir. Sept. 13, 2016)	Fed Cir	Focused on preemption issue. Patent automated a 3D animation method using rules. Rules do not need to provide a tangible result for claim to be patent-eligible.	When claiming rules, the process should use a combined order of specific rules to create a desired result. The specific structure and order of the rules will then not preempt other uses of the same rules.

F. Practice Tips

1. Drafting Cases with Patent Eligibility in Mind

Practitioners should add structure to claims, and draft with functional claiming in mind even if the drafter does not intend to include means-plus-function claims. This could overcome 35 USC §101 rejections as well as providing §112(b) support in the event claims are interpreted to fall under §112(f). Some of the more recent cases described lack of specifically-programmed computers and algorithms as part of the reasoning for the 35 USC §101 rejections. Accordingly, the author especially recommends adding structure to claims for software-related inventions, and providing specific algorithms wherever possible. Given the application of 35 USC §101 to electrical inventions, it may be wise to provide algorithms for functions performed by circuits and subsystems as well.

Second, practitioners should spell out how individual actions are accomplished, using flowcharts, algorithms, and pseudocode wherever possible. Practitioners should ask inventors what circuits, computers, processors, etc., are performing each action in the inventive process (with particular attention to the core or “nugget” of the invention), and obtain diagrams, flowcharts, and/or algorithms to support the disclosure wherever possible. This will help in the arena of patent eligibility as well as functional claiming (described below).

Third, practitioners should state the technical problem being solved, to overcome any possible assertions that the claims are directed to an abstract idea. Point out specific improvements in computer capabilities, and point out a correspondence between solution in the claim and the problem faced by technology. It is also helpful to mention this correspondence during Examiner interviews.

2. After the Fact-Arguing before the PTO

The author recently undertook a study of various 35 USC §101 rejections before the USPTO and Applicant arguments that successfully overcame these rejections. It is unknown whether some of the successful arguments would work with every Examiner. However, it should be useful to review common elements found in the winning arguments.

Applicants should determine exactly what the Examiner alleges is the abstract idea. If the alleged abstract idea merely relates to the technical problem being solved, and not to the claims or the invention itself, this should be pointed out to the Examiner.

Most successful Applicants stepped through the two-part *Mayo* test in their responses. The first part of this test relates to whether the claims at issue are directed to an abstract idea by requiring the Examiner to determine “whether the claims at issue are directed to a patent-ineligible concept.” Applicants should refer to the May 19, 2016 Memorandum discussed above, particularly when improvements in computer-related technology are involved, to argue that a claim is not directed to an abstract idea.

Even assuming that the claims are directed to an abstract idea, Step II of the *Mayo* test must still be applied (however, if Step I does not apply, Applicants should argue that no Step II analysis should be done). In that step, the elements of the claim are examined to determine whether it contains an “inventive concept” sufficient to “transform” the claimed abstract idea into a patent-eligible application. Several factors should be considered. Some of the successful arguments cited non-preemption, the idea that the claims provided “significantly more” beyond the alleged abstract idea, and the idea that the invention provided concrete improvements in a technological area.

However, Examiners have informally admitted that it is difficult for them to see how a combination of known items acting in known ways can unexpectedly operate in a new way that is distinct from the abstract idea found in Step I of the *Mayo* test. Accordingly, if the analysis does get this far, practitioners should expect an appeal, or at the very least, to have to bring their arguments before a more senior Examiner to remove the rejection.

Keep in mind that Examiners may be more amenable to your point of view when an amendment is made. This is not to say that practitioners should not present arguments without amendment, particularly when the arguments are strong. However, sometimes non-limiting amendments can be made that appease the Examiner, and gain allowance.

In various Examiner interviews over the last two years, while observing the success and failure of various amendments, the author and the author’s colleagues received some Examiner guidance on limitations that stand a better chance of being found eligible. In method claims, for instance, it can be helpful to provide some physical operation as a last step of the method. For example, connection to a network can be added as a final step for a network authentication method. Generic and abstract limitations will not be helpful in overcoming rejections. For example, one Examiner gave this list of unhelpful limitations:

- receiving, storing, transmitting, or displaying data that is recited as already being in existence (too generic)
- manipulating or altering data from one state to another (too abstract)
- configuring a device (too generic)

The same Examiner suggested removing any “business methody” terms, reciting how a machine responds to technical triggers or conditions, and reciting data generation (as opposed to merely displaying data).

II. Avoiding Pitfalls in Functional Claiming

The patent statutes specifically permit functional claiming in 35 USC §112(f). Sufficient structure must be provided in the specification to perform any functional limitations. Sufficient structure is typically in the form of flowcharts, algorithms, or pseudocode.

Prior to *Williamson*, discussed below, Applicants could typically avoid §112(f) treatment (and a requirement to provide specific structure to avoid indefiniteness rejections) by avoiding the use of “means” language. However, in June 2015, software claims began to receive harsher treatment and were interpreted under §112(f) even when it was not the Applicants’ desire or intent. Those Applicants who did not provide the required structure found themselves in a bind.

A. *Williamson*

Williamson was the first decision to introduce these difficulties. The patent in question described methods for distributed learning that utilized industry-standard computer hardware and software, linked by a network, to provide a virtual classroom environment. At issue was “a distributed learning control module.”

Sitting *en banc*, the Federal Circuit withdrew its earlier opinion and reversed the precedent from *Lighting World* and *Inventio* creating a “strong” presumption that a limitation does not invoke §112(f) unless the word “means” is used. Instead, the new standard would be “whether the words of the claim are understood by a person of ordinary skill in the art to have a sufficiently definite meaning as the name for a structure.”⁸

Here, the word “module” did not indicate structure. Instead, it was deemed to represent a black box recitation of structure. The court looked to the specification for corresponding structure and did not find it. Therefore, the claim was pronounced indefinite.⁹

B. Means-Plus-Function Case Law after *Williamson*

When functional claiming is used, leaving out the term “means” may not always serve to rebut the presumption against invoking §112(f). Since *Williamson*, the district courts have had many opportunities to address this issue. Particularly interesting, at least from the point of view of software patent practitioners, is that several (though not all) courts have held that using the word “processor” does not necessarily invoke means-plus-function interpretation. Some of these cases are discussed below.

Case Name	Court	High Level	Take-away
<i>Media Rights Technologies, Inc. v. Capital One Financial Corp.</i> , 800 F.3d 1366 (Fed. Cir. September 4, 2015)	Fed Cir	112(f) and 112(b) applied because “compliance mechanism” did not have a commonly understood meaning and is not generally viewed as connoting a particular structure	Provide algorithms for each of the functions. Provide inputs and outputs for the mechanism.

⁸ *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1348 (Fed. Cir. 2015)

⁹ *Id.* at 1351.

<i>Collaborative Agreements, LLC v. Adobe Sys.</i> , 2015 US Dist. LEXIS 161809 (N.D. Cal. Dec. 2, 2015)	NDCA	“code segment” and “computer readable medium encoded with a program” recite sufficient structure to avoid 112(f) interpretation	provide structural interactions between code segments or inputs/outputs
<i>SyncPoint Imaging, LLC v. Nintendo of Am. Inc.</i> , 2016 US Dist. LEXIS 677 (E.D. Tex. Jan. 5, 2016)	EDTX	Citing <i>Apple v. Motorola</i> : The correct inquiry, when 'means' is absent from a limitation, is whether the limitation, read in light of the remaining claim language, specification, prosecution history, and relevant extrinsic evidence, has sufficiently definite structure to a person of ordinary skill in the art	“processor” does not invoke 112(f) interpretation
<i>Enfish, LLC v. Microsoft Corp.</i> , 822 F.3d 1327 (Fed. Cir. 2016)	Fed Cir	sufficiency of the structure is viewed through the lens of a person of skill in the art and without need to disclose structures well known in the art	Algorithms are sufficient structure
<i>Advanced Ground Info. Sys. v. Life360, Inc.</i> , 2016 US App. LEXIS 13707, 7-8 (Fed. Cir. July 28, 2016)	Fed Cir	is "symbol generator" a nonce word	algorithm for performing the functions of a “symbol generator” might have provided sufficient structure to avoid the indefiniteness rejection

E. Practice Tips for Functional Claiming after *Williamson*

1. Avoidance of nonce words, with a word of caution

When a §112(f) interpretation is not desired, practitioners should avoid the use of nonce words. Nonce words are defined in the context of functional claiming as words that will lead to a §112(f) interpretation. MPEP §2181 provides a list of known nonce words, and a list of words held not to be nonce words. It should be kept in mind that this list was formulated pre-*Williamson*, and accordingly it may not be sufficient to avoid these words, and no others. Rather, the entire discussion in this section should be taken into account.

The nonce words listed in MPEP §2181 all used the word “for,” but that does not mean that by avoiding “for,” practitioners can avoid §112(f) treatment. After *Williamson*, some Examiners started treating the phrase “configured to” similarly to the word “for.” In other words, any noun followed by the phrase “configured to” may be at risk of interpretation as a nonce word. However, this is not universal among Examiners, and some practitioners are of the opinion that “configured to” is still less likely than “for” to trigger the use of §112(f).

In general,¹⁰ if the noun preceding “configured to” or “for” would seem to a layperson to go together with the operation provided in the claim limitation, then the Examiner may be less likely to apply §112(f) treatment. For example, the following hypotheticals should be less likely to trigger 112(f) scrutiny:

- a receiver configured to receive input
- a processor configured to calculate a score
- a GUI configured to display a menu
- a controller configured to manage the device

If the noun and operation seem to be mismatched or disconnected, then the claim is at risk of treatment under §112(f). If it is unclear whether a noun could perform the operation (without a specialized algorithm), then Examiners are more likely to treat the noun as a nonce word. Consider the following hypotheticals:

- a receiver configured to convert a signal
- a processor configured to predict a preference
- a GUI configured to select a menu option
- a controller configured to map a device to another device

In such cases, an Examiner might argue that the specification should provide two things (1) some structure corresponding to the noun, and (2) an algorithm that the noun could perform to accomplish the operation. For example, the receiver might need to execute a conversion algorithm to convert the signal in the first example above. The processor might need to perform according to a prediction algorithm, etc.

As one colleague put it, nouns seem less likely to be treated as nonce words if the operations they perform do not sound too amazing or surprising. However, a word of caution is in order. If the operation is meant to be novel (i.e., amazing and/or surprising), then practitioners should refrain from trying to overcome §112(f) treatment by arguing that the noun goes together with the claimed operation. Doing otherwise risks an obviousness rejection, especially if one of ordinary skill in the art would understand the noun and operation as being joined together, as part of their natural or inherent characteristics.

To summarize the above points, nouns should seem capable of performing the claimed operations without special programming, if §112(f) treatment is to be avoided. However, care should be taken when amending to overcome prior art rejections because, unless there is support in the specification for novel algorithms, §112(f) treatment and an indefiniteness rejection may result.

3. Drafting to avoid indefiniteness rejections

In general, applications should present details with respect to how a computer performs each claimed function (for computer-implemented claims). Detailed flowcharts should be provided for every function (and in some cases, even for non-software inventions) in the event case law moves even further afield, where means-plus-function interpretation outside the software arts becomes a common occurrence. As described earlier, practitioners should ask inventors what circuits, computers, processors, etc., are performing each action in the inventive process (with particular attention to the core or “nugget” of the invention), and obtain diagrams, flowcharts, and/or algorithms to support the disclosure wherever possible.

¹⁰ Based on Examiner interviews and conversations with colleagues.

Practitioners should provide, and claim, inputs and outputs for each structure in a claim, and include structure within claims if means-plus-function treatment is not desired. This approach can include descriptions of memory, ports, etc. This style of claiming can provide the added benefit of making it easier to overcome rejections of an “abstract idea” based on *Alice*. Most importantly, practitioners should invoke terms that are commonly understood to be hardware: structural, physical, real-world objects (such as cameras, sensors, processor chips, memory, etc.).

Even with the noted difficulties, practitioners should not necessarily avoid functional claiming. This type of claiming allows practitioners to control the scope of the claim, while providing some degree of equivalents for elements amended for reasons of patentability. Finally, when functional claims form part of a claim set, Examiners may be led away from interpreting the other claims under the means-plus-function statute.

Conclusion

In several of the above summarized cases, the courts either explicitly or implicitly equate patent eligibility analysis (in particular, step I analysis for abstractness) with the indefiniteness determinations. Software patent practitioners should therefore understand that it is the best practice to include structure throughout their specifications, so that amendments can easily be made to overcome a potential 35 USC §101 rejection, or an indefiniteness rejection. By thinking ahead, and beginning with the disclosure interview, Applicants can kill two birds with one stone: by reciting and describing structure for all claim limitations to avoid both patent eligibility and indefiniteness issues during patent prosecution.

Analyzing *Ex Parte* Decisions at the PTAB Shows Wide Variability in Reversal Rates by Rejection

By [Trent Ostler](#), [Adam Stephenson](#), [Donald Steinberg](#), [Michael Varco](#), [Michael Folkerts](#), [Roy Gross](#), [Heather Johnston](#), [Derrick Carman](#), [Leia Dingott](#), [Kevin Hawkes](#), and [Thomas F. Lebens](#), members of the [PTAB Sub-committee](#).

Since July 25, 2016 the AIPLA PTAB subcommittee has been analyzing ex parte appeals decisions for specific issues and outcomes. We are not aware of such a granular examination of these types of decisions. Since July 25, we have reviewed 1009 of the 1776 total decisions for that time frame.¹¹ The results reveal interesting differences in the reversal outcomes. Rather than the Board wholly affirming or reversing the rejections on appeal, we found that the reversal rates were more based on the type of rejection. Thus, not all rejections are decided equally at the board.

We discuss the results of each type of the most frequently decided rejections at the PTAB. They are: 1) §101 subject matter eligibility; 2) § 112; 3) § 102 Anticipation; 4) § 103 Obviousness; and 5) Non-Statutory Obviousness-type double patenting.

In general, the Board can decide each of these rejections in six different ways. First, it can affirm the rejection meaning that all claims at issue are sustained as rejected. Second, the board can reverse the rejection meaning that all claims at issue are overturned as rejected. Third, the board can affirm in part, meaning that at least one claim is reversed and at least one claim is affirmed. Fourth the board can affirm as new, meaning that the rejection is sustained, but by using a different rationale or grounds, which necessitates designating it as a new ground of rejection. Fifth, the board can sua sponte introduce a new rejection. Sixth, the rejection can be summarily affirmed, meaning that the appellant did not argue the rejection so the board affirms the rejection, but not on the merits.

It is noteworthy to highlight the Board's disparate treatment of multiple rejections within decisions. There were a total of 294 decisions that substantively decided more than one issue. Of these, 34% had conflicting outcomes with regard to at least one claim (i.e., with regard to one rejection, it was affirmed in part, but with regard to another issue, it was exclusively affirmed). A surprisingly high 22% of the total 294 decisions had completely conflicting outcomes with regard to different rejections (i.e., with regard to one rejection, the board reversed all the claims and with regard to another rejection, the board affirmed all the claims).

We discuss each in relation to six possible outcomes. We found that §101 Subject matter eligibility rejections, § 103 obviousness rejections and obviousness-type double patenting are affirmed more often than reversed. We also found that §§ 112 and 102 are reversed more often than affirmed. Even with a small sample size for some of the rejections, the different rejections have statistically significant different outcomes.

1) Section 101 non-statutory subject matter

¹¹ Data was automatically extracted from the USPTO website <https://e-foia.uspto.gov/Foia/PTABReadingRoom.jsp>, organized and annotated using the platform <http://www.patentboardferret.com>, which will soon become <http://anticipat.com>.

We reviewed a total of 31 decisions that decided § 101 patent-eligibility. Of these, here is the following breakdown:

Affirmed	Affirmed-in-part	Reversed	New	Summarily Affirmed
20	0	8	2	1

Thus, for Section 101, the reversal rate is 26% for at least one claim.

2) Section 112

For Section 112, we discuss the various sub-sections separately.

a) *Written Description/New Matter/Lack of Enablement*

Affirmed	Affirmed-in-part	Reversed	New	Summarily Affirmed
21	0	38	0	4

The 112(a) types (including written description, new matter, and enablement) had 21 affirmances, 38 reversals, and two summarily affirmed. This means that of the 63 decisions, 60% were reversed. This is significantly higher than subject matter patent-eligibility.

b) *112(b) - Indefiniteness*

Affirmed	Affirmed-in-part	Reversed	New	Summarily Affirmed
18	4	47	2	12

Section 112(b) indefiniteness had 18 affirmances, 47 reversals, four affirmed-in-part, two new and twelve summarily affirmed. Thus, of the 83 decisions, 61% of issues had at least one claim reversed and 57% of the issues were completely reversed. These reversal numbers are high. Plus, considering the high number of summarily affirmed decisions, where the appellant did not even argue the case, the real reversal rate can be considered to be even higher than the percentages listed above.

c) *112(d)*

Affirmed	Affirmed-in-part	Reversed	New	Summarily Affirmed
5	0	1	0	1

112(d) rejections had 5 affirmances, 1 reversal and 1 summarily affirmance. Thus, the reversal rate is only 14% for this small sample size, going against the high percentages of other Section 112 rejections.

3) Section 102 – Anticipation

Affirmed	Affirmed-in-part	Reversed	New	Affirmed As New
106	22	135	1	3

The reversal rates for anticipation are high: of the 267 decisions, 59% reversed at least one claim and 51% reversed all claims of the rejection.

4) Section 103 – Obviousness

Affirmed	Affirmed-in-part	Reversed	New	Affirmed As New
437	76	266	2	7

Obviousness is our biggest sample size of 787 decisions. Of these, there were 437 affirmed, 76 affirmed in part, 266 reversed, two new, and seven affirmed as new. Thus, with obviousness issues, 43% reverse at least one claim while 34% reverse all the claims. This is much lower than the § 112 and § 102 outcome rates. Still, this reversal rate is higher than might be expected in the post KSR era.

5) Obviousness-type double patenting

Affirmed	Affirmed-in-part	Reversed	Summarily Reversed (hold in abeyance)	Summarily Affirmed
19	5	5	1	20

Of the 50 decisions deciding obviousness-type double patenting, only 20% reversed at least one claim and only 10% reversed all the claims. This appears to be a low reversal category of rejection. However, by excluding the large number of summarily affirmed decisions, in which the appellant did not argue the rejection on appeal, the reversal rate jumps up closer to 33% for at least one claim. While not as high as others, it suggests that such issues are winnable on appeal.

Conclusion

Much can be learned and inferred from analyzing the rejection-specific outcomes of ex parte appeals decisions. Through the lens of the preliminary data, we can see a more nuanced perspective of Examiners' rejections. Rather than a wholesale overturning or sustaining of the Examiner's rejections, the issues are more granularly decided. This seems to suggest that a notion of an Examiner being "good" or "bad" in light of the appeals data is overly simplistic. A more accurate takeaway message is that the probability of an Examiner's rejections being sustained or overturned depends on the type of rejection.

Also, analyzing the individual issues on appeal sheds additional light on norms of various rejection outcomes. For example, the data show that obviousness rejections are more favorable to Examiners than anticipation rejections. Practice would support such an interpretation, as there may be more wiggle room for Examiners regarding obviousness than anticipation. However, even with obviousness, a 43% reversal rate involving at least one claim means that ex parte appeals of obviousness rejections are far from futile endeavors.

Section 112 rejections are the highest reversed rejections. This may indicate that Examiners disproportionately do not apply the law with respect to 112 as they should. Thus, after receiving a 112 rejection, it may be beneficial to look closely at the rejection for possible error.

In sum, the many thousands of Final (or Routine) decisions, while not binding authority or policy of the PTO, can be extremely useful in determining how the Board collectively decides issues and determines when Examiners are wrong. The trends can never be a perfect predictor of future events of a particular application, but considering the actual data can allow for more effective client strategizing when faced with particular rejections.

Interview with Wynn Coggins, Deputy Chief Administrative Officer, USPTO



As Deputy Chief Administrative Officer (CAO), Wynn Coggins is responsible for supporting all aspects of administrative management as it applies to the operation of a large government agency. Specifically, she provides management, policy and oversight support to the CAO for human resources, space, security and Agency-wide human capital programs at the USPTO.

Elise Selinger: Tell me a little about your career progression through the USPTO

Wynn Coggins: I began my career in December of 1990 as a GS-7 patent examiner working in mechanical class 52. It wasn't my first job – I had spent the first four years out of college working for an engineering consulting firm in Fairfax, Virginia. But it wasn't the right skill match – I was attracted to the USPTO because of the mix of engineering and law that was required. So I applied, was thankfully hired and have loved it for almost 26 years!

I came to my current position as the Deputy Chief Administrative Officer initially on a detail from the patent organization. I had been a supervisory patent examiner and patent group director in the business method technologies for a long time period, and then a group director in the electrical areas, and they needed someone to assist the Chief Administrative officer as his deputy for what was supposed to be on a temporary basis! But it turned out to be a great fit. Working in the Patents organization was an amazing experience and gave me such a valuable perspective into that side of the organization, but what I now really enjoy is supporting the agency across all the business units and organizational levels. It's a different viewpoint and allows me insight into how the entire agency functions. And in OCAO organization, we handle all human resources, space, security, telework and human capital programs for the agency which is a variety that I just love!

Elise Selinger: We all know that there's an examination and registration core, but probably not the overall structure of the USPTO and where or how that core falls within the overall structure of the USPTO. Can you fill in some of the blanks?

Wynn Coggins: Sure. As most of us know, the Patent and Trademark organizations directly support the mission and goals for the agency, which are to support and strengthen our intellectual property system by properly granting patents and registering trademarks. So the majority of the attention to the agency is directed to those two areas. But like any business or large corporation, we also have legal, financial, IT,

human capital, space, security and communication functions that also provide the proper support and governance to the agency. These make up the 7 other separate business units that are dedicated to supporting the patent and trademark organizations in their efforts to meet their goals, which feed into the overall agency goals. So our structure is really no different than any standard corporate structure having the various departments that are needed to keep the business running smoothly. And the Patent and Trademark organizations are a part of that corporate structure.

Elise Selinger: What are the responsibilities of the other functional areas of the USPTO?

Wynn Coggins: Those areas are the Office of Policy and International Affairs, the Office of the Chief Administrative Officer, the Office of the Chief Communications Officer, the Office of the Chief Financial Officer, the Office of the Chief Information Officer, the Office of Equal Employment Opportunity and Diversity, and the Office of the General Counsel. They all do very different things as you can see by their titles.

Elise Selinger: What are three unexpected aspects/challenges/opportunities of your current position? What skills do you have that have helped you be successful?

Wynn Coggins: I like to say that “every day is a journey!” and it is! There have been many, many unexpected aspects, challenges and opportunities in my role as the DCAO. The administrative functions of any business typically are dealing with the day-to-day activities and “surprises” of keeping things running smoothly and effectively. And while my background in patents has been so helpful in managing many of these, it’s really just having good communication skills, knowing how and what to prioritize and then to elevate and “knowing how to navigate” - who to really go to when something needs attention – that has served me well!

Elise Selinger: What other organizations do you interface with? Why?

Wynn Coggins: All of them! It’s my job to support them all in their hiring, human capital, space management and security needs, and we also work together daily to support overall agency operations. And it helps to have those solid working relationships in place when something comes up expectantly.

Elise Selinger: That feeds nicely into my next question – how do you manage in a crisis? Can you touch on the power outage that occurred just before Christmas last year? How did you, your office and the other areas of the USPTO come together to manage that?

Wynn Coggins: Sure. For background, on December 22, the clean power supply provided to us by our contractors suffered a shortage due to what we believe was a mechanical failure. This outage knocked out both separate power supply sources and required taking our systems offline. But the Agency’s underlying IT or data were not affected.

Thanks to our team working around the clock over the holidays, we were able to get everything up and running again by Monday, December 28. But that was only possible through the combined and collaborative

efforts of USPTO leadership. It really is the best executive team I have ever had the privilege to work with. We came together, prioritized actions, identified who had the lead for the various actions and executed - and it took all of us working together to manage the situation and get us back on line. My office was directly involved since we oversee the campus facilities and deal directly with the building lessor.

Elise Selinger: What are your goals for the next six to 12 months? What programs would you like practitioners to be aware of?

Wynn Coggins: There are two major human capital projects that I think practitioners would really enjoy knowing more about. The first is our USPTO-wide Customer Experience Excellence Program. This program is dedicated to helping the agency become an organization that consistently maintains an exceptional and integrated customer service program, and to optimize its internal and external customer experience. We want to imbed the idea of exceptional customer experience into the work that we do and the services that we provide. We collaborated with a contractor throughout most of FY 2016 to baseline and identify best practices and recommendations for us to consider. Some practitioners may be familiar with this project because we worked very closely with external stakeholders like AIPLA, IPO, INTA, PPAC and TPAC to get their input and feedback. I'm really excited about the next phase of the project!

The second project is another agency-wide human capital project that is focused specifically on executive leadership development. Again, through collaborations this year with a contractor, we developed the concept and structure for a future USPTO leadership academy for our Senior Executive Service to promote a culture of leadership excellence from the top down and across the agency. This is another exciting project for us and we are currently in the next stages of development. So stay tuned for more updates!

Elise Selinger: What are the top three things you wish people knew about the USPTO and/or your position specifically?

Wynn Coggins: There are many things that come to mind, but there is one thing that I'd really like to share about the USPTO – and it's about the people that I work with every day! There is something just so very special about this agency. There is an energy that is just palpable the moment you walk in the door. People really enjoy being here and working here. And what has kept me here for almost 26 years are the relationships and support that I have had throughout my career. People really do want you to be successful and that comes across. It's a special place.

Elise Selinger: Twenty-six plus years is impressive in any organization, what advice would you give to someone looking to go into or advance within government service?

Wynn Coggins: Thank you! It's been fun and so very rewarding. When I think of our future leaders and the younger generations considering a career in the engineering or STEM fields my advice is to stick with it! Because it gets hard. And when it gets hard, stay strong and find ways to advocate for yourself. For young girls, my advice is to don't let anyone ever tell you that engineering is just for the boys! Resiliency with a positive attitude has been the key for me. And that advice extends really to anyone who wants to be successful in the government or the private sector. We all make mistakes, stumble along the way and

sometimes lose our balance, but never give up and don't be afraid to ask for help. Find a mentor and be a mentor. We all need to find avenues to seek out advice, guidance and feedback. And don't dwell on perfection – if you do, you'll rarely achieve true success. Also a good sense of humor is very important. There are just going to be too many things that can and do go wrong, and just monumentally wrong – and finding ways to laugh and relieve some of the stress is just so important and will help you get through the day!

Cases of Note

The following chart lists a number of cases that the Editors of this newsletter thought may be of interest to the committee.

Case Name	Court	Topic(s)	High Level / Take-Away
Medicines Co. v. Hospira, No. 2014-1469 (Fed. Cir. July 11, 2016) (en banc)	CAFC	On-sale Bar	The <i>en banc</i> Federal Circuit held that in order to be a commercial sale or offer to sell that would satisfy the first prong of the <i>Pfaff</i> rule, the activity at issue must bear the general hallmarks of a sale pursuant to Section 2-106 of the UCC.
Veritas Technologies LLC v. Veeam Software Corporation, No. 2015-1894 (Fed. Cir. August 30, 2016)	CAFC	Amendment During IPR	The Board's basis for denying the motion to amend--merely discussing the newly added feature in combination with other known features rather than a full analysis of each features of the amended claims--was arbitrary and capricious. Describing that it is only the combination that was the new feature in proposed amended claims as compared to the prior art is enough to have the motion to amend granted.
Liberty Ammunition Inc. v. U.S., No. 2015-5057 (Fed. Cir. August 26, 2016)	CAFC	28 U.S.C. § 1498	The Army's lead-free bullets do not infringe Liberty's patents because they do not have the same surface area contact with the inside of the gun barrel as required by the patent patent and their "interface," or jacket, covers more of the round.
Brent E. Smith, Aes Raptor, LLC v. Garlock Equip. Co., No. 2015-1758 (Fed. Cir. August 23, 2016)	CAFC	Literal Infringement, Piercing Corporate Veil	The Federal Circuit held that for literal infringement, all claim limitations must be present in the accused device and expert testimony is not a substitute for the need to have substantial evidence to support the existence of each element. The Court also held that a parent company is not responsible for the conduct of a subsidiary company if there is no evidence to support piercing the corporate veil.
Apotex Inc., v. Wyeth LLC, No. 2015-1871 (Fed. Cir. August 16, 2016)	CAFC	Obviousness, Review of PTAB Final Written Decisions	The Federal Circuit affirmed the PTAB's final written decision of nonobviousness Apotex failed to explain why a person having ordinary skill in the art would have substituted one composition for another. The court also held that it reviews "the Board's legal determinations de novo" and the "factual findings underlying those determinations" (e.g., what a reference teaches, reason to combine) "for substantial evidence".
ScriptPro LLC, ScriptPro USA, INC., v. Innovation Associates, Inc., No. 2015-1565 (Fed. Cir. August 15, 2016)	CAFC	Written Description	The Federal Circuit held that a "specification's focus on one particular embodiment or purpose cannot limit the described invention where that specification expressly contemplates other embodiments or purposes".
Ubisoft, Inc. v. Uniloc USA, Inc., IPR2016-00414 (June 2, 2016)	PTAB	Decision Denying Inter Partes Review and Joinder	The one year bar to granting an IPR does not apply to a motion for joinder, but the Board will not grant joinder to a terminated proceeding.

Google v. ContentGuard Holdings, CBM2015-00040 (June 24, 2015)	PTAB	Motion to Amend at PTAB	The PTAB held that patent owner demonstrated by a preponderance of the evidence that its proposed, substitute independent claim satisfied the requirements of 37 C.F.R. § 42.221 and that its amended claim is substantially identical in scope to the original claim within the meaning of 35 U.S.C Sec. 252, which potentially bestows upon accused infringers the protection of "intervening rights" when an amendment is made during post-issuance proceedings that changes the scope of a claim.
Twilio Inc. v. TeleSign Corporation, IPR2016-00450 (July 8, 2016)	PTAB	Decision on Denial of Institution of Inter Partes Review	The Board held that claim terms of an unexpired patent are given their broadest reasonable construction in light of the specification of the patent in which they appear, but any proposed interpretation must still be reasonable.
ClearCorrect Operating LLC et al. v. International Trade Commission, No. 2014-1527 (Fed. Cir. Nov. 10, 2015)	CAFC	"Articles" and ITC	The Federal Circuit held that "articles" can only refer to physical objects, not digital files. The ITC decided not to appeal this decision to the Supreme Court last week so it is relevant once again.
Certain Portable Electronic Devices and Components Thereof (Inv. 337-TA-994)	ITC	ITC 100 day Pilot Program	The first time in which the ITC 100 day pilot program was used to address patent eligibility under sec 101 (and found invalidity) and the first investigation in the pilot program to be decided in favor of respondents
Affinity Labs of Texas, LLC v. DIRECTV, LLC et al., No. 2015-1845 (Fed. Cir. Sept. 23, 2016)	CAFC	§ 101	Affirmed 101 invalidation for claims directed not to an improvement in cellular telephones but simply to the use of cellular telephones as tools in the aid of a process focused on an abstract idea, which is NOT enough to constitute patentable subject matter. The Court is creating a "technological improvement" safe harbor from the Supreme Court's abstractness doctrine.
Novo Transforma Technologies v. Sprint Spectrum LP et al., No. 2015-2012 (Fed. Cir. Sept. 23, 2016)	CAFC	§ 101	Affirmed (without opinion) District Court ruling that a patent on a method of sending communications between different types of media by converting formats is invalid under Alice because it claims only the abstract idea of translation. Thus, digital context for translation methods is not enough.
Rapid Litigation Management v. Cellzdirect, No. 2015-1570 (CAFC. July 5, 2016)	CAFC	§ 101	Even if a patent is directed to a law of nature, it may be eligible under step two if there is an inventive concept; Pre-emption is not the test for determining patent-eligibility, but findings that the patent "does not lock up the natural law in its entirety" and that another has designed around the patent support eligibility.
Bascom Global Internet Services, Inc. v. AT&T Mobility LLC., No. 2015-1763 (CAFC. Jun 27, 2016)	CAFC	§ 101	Patent directed to filtering Internet content are patent-eligible because, unlike claims at issue in English, the instant claims do not readily lend themselves to a step-one finding that they are directed to a nonabstract idea, but do contain an inventive concept by way of the ordered combination of claim limitations. Inventive concept can be found in a non-conventional and non-generic arrangement of known, conventional pieces.

TLI Communications LLC v. AV Automotive LLC, No. 2015-1372 (CAFC. May 17, 2016)	CAFC	§ 101	Claims directed to the use of conventional or generic technology in a well-known environment without indicating that the claims solved a problem presented by combining the two is not enough and lack of structure or details (i.e., only functional descriptions) of the tangible components did not help.
Certain Network Devices, Related Software and Components Thereof (Inv. No. 337-TA-944)	ITC	§ 101	Both commission and ALJ conclude claims are patent eligible under § 101.
Certain Activity Tracking Devices, Systems, and Components Thereof (Inv. No. 337-TA-963)	ITC	§ 101	First example of the ITC finding patents invalid under § 101. Commission did not review the ALJ's decision.

Update on USPTO Pilot Programs and Initiatives

As part of its [Enhanced Patent Quality Initiative \(EPQI\)](#), the USPTO has initiated a number of programs to ensure that the Office continues to issue high-quality patents in order to enable certainty and clarity of rights. The following is a list of programs that fall under the umbrella of EPQI. For more information about the EPQI, tune in to the USPTO's [Patent Quality Chats](#), which take place on the second Tuesday of each month at Noon Eastern.

Search and training enhancement programs

- **Automated Pre-Examination Search Pilot** - Providing relevant prior art through an automated pre-examination search to an examiner for review before the examiner begins examination and conducts a manual search in the application.
- **[Clarity of the Record Training](#)** - Educating examiners on the latest legal developments and effective ways to convey their positions and reasons to applicants for purposes of improving the clarity of the prosecution record.
- **[Scientific and Technical Information Center \(STIC\) Awareness Campaign](#)** - Raising examiners' awareness of available search tools and resources to find better prior art in an application.
- **[Stakeholder Training on Examination Practice and Procedure \(STEPP\)](#)** – Provides perspective on patent examination to our external stakeholders. This program was launched July 12th and is one effort to enhance patent quality through customer service. Visit the [STEPP](#) web page for more information and to take a short survey to help the USPTO determine future training topics.

Prosecution enhancement programs

- **[Clarity of the Record Pilot](#)** - Identifying and developing best practices for examiners to enhance the clarity of the prosecution record.
- **[Interview Specialist](#)** - Providing a point of contact to facilitate applicant-examiner interviews by serving as a resource on interview policy and assisting examiners and applicants with interview logistics.
- **[Post-Prosecution Pilot \(P3\)](#)** - Explores a new after final program that combines features of the Pre-Appeal Brief Conference and After Final Consideration 2.0 pilot programs and adds in new features requested by our stakeholders.
- **[Reevaluation of Quick Path Information Disclosure Statement \(QPIDS\)](#)** - Investigating improvements to the existing program, which provides for submission of an IDS after payment of the issue fee without an RCE, to make the process more efficient.

Post-examination enhancement programs

- **Design Patent Publication Quality** - Improving the quality of images in published design patents.
- **[Post Grant Outcomes Program](#)** – Aimed at putting related AIA trial proceedings, including their prior art, in front of the examiners of pending related applications.

Evaluation enhancement programs

- [Clarity and Correctness Data Capture \(Master Review Form or MRF\)](#) - Developing and implementing a new agency-wide consistent and transparent process and form to capture minable data about the correctness and clarity of examiners' work products.
- [Quality Metrics](#) - Developing and implementing new measures for understanding, evaluating, and reporting the correctness and clarity of examiners' work products.
- The USPTO received over 135 qualified topics and selected six for the [Topic Submission for Case Study Pilot Program](#). Check back periodically for case study results.

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