

PATENT PROSECUTION TIPS FROM THE TRENCHES

By Marin Cionca; OCIPLA Luncheon - May 17, 2018

1. The use of Functional Claim Language in view of recent court decisions and the January 2018 update to the MPEP

CONFIGURED TO v. ADAPTED TO v. CAPABLE OF

2. New Subject Matter Eligibility approaches available to patent practitioners in view of the April 2018 USPTO memo titled Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc*)

WELL-UNDERSTOOD, ROUTINE, CONVENTIONAL?



Functional Claiming

A claim limitation is functional when it recites a feature by what it does rather than by what it is. MPEP 2173.05(g)

- (means- (or step-) plus- function claim limitations, 35 U.S.C. 112(f)
- Other permissible language for functional limitations
 - CONFIGURED TO, ADAPTED TO, CAPABLE OF
 - ETC.



In Re Giannelli

In re Giannelli, 739 F.3d 1375 (Fed. Cir. 2014)

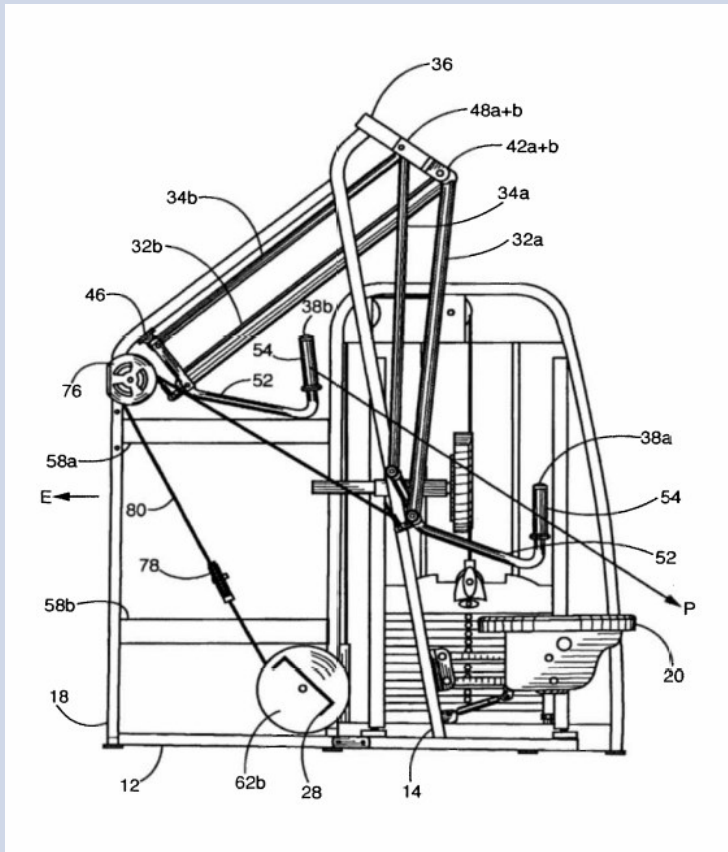
Claim 1

A row exercise machine comprising an input assembly including a first ***handle portion adapted to be moved from a first position to a second position by a pulling force exerted by a user on the first handle portion in a rowing motion***, the input assembly defining a substantially linear path for the first handle portion from the first position to the second position.

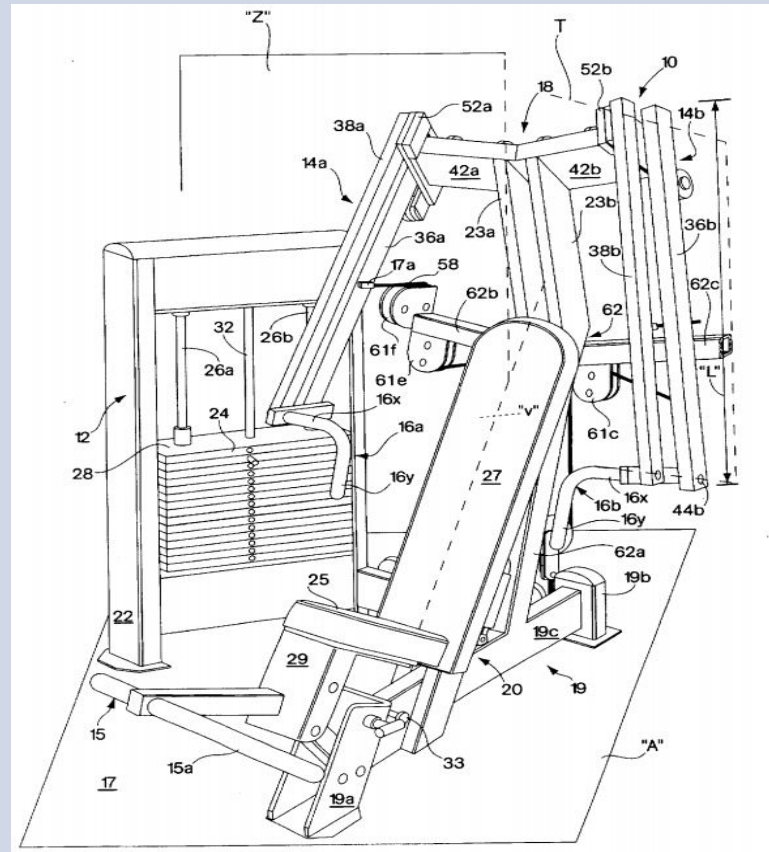
Examiner rejected first under 102 and later under 102/103 over Patent No. 5,997,447



Giannelli Exercise Machine - handles for pulling force -



Patent 5,997,447 - handles for pushing force -



PTAB Affirms 103 Rejection

The Board characterized the dispositive issue as being whether the chest press machine of the '447 patent was

“capable of being used by exerting a pulling force on the handles in a rowing motion.”

- a user *could* face the handles of the prior art chest press machine and exert a pulling force on its handles in a rowing motion
- claim simply recited the *new intended use of rowing* for the '447 patent chest press apparatus.



Federal Circuit Reverses

- Obviousness is a question of law, based on *underlying factual findings*.
- The PTO bears the initial burden of showing a prima facie case of obviousness.
- “the phrase ‘*adapted to*’ is frequently used to mean ‘*made to*,’ ‘*designed to*,’ or ‘*configured to*,’ . . .” *Aspex Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1349 (Fed. Cir. 2012).
- Although the phrase can also mean “‘*capable of*’ or ‘*suitable for*,’” *id.*, here the written description makes clear that “‘adapted to,’ as used in the ’261 application, has a narrower meaning, viz., that the claimed machine is **designed or constructed to** be used as a *rowing machine* whereby a *pulling force* is exerted on the handles.”



Federal Circuit Reverses - *Cont'd*

- Giannelli Spec.: the exercise machine “enables a user to maintain biomechanical alignment of the user’s wrist...”
- There is no question that the ’447 patent does not have handles that are *adapted to* be pulled in a rowing motion.
- the mere *capability* of pulling the handles is not the inquiry that the Board should have made; it should have determined whether it would have been obvious to modify the prior art...
- **Physical capability alone does not render obvious that which is contraindicated.**
 - sure-fire way to cause injury...



Aspex Eyewear, Inc. v. Marchon Eyewear, Inc., (Fed. Cir. 2012).

“adapted to” = “**capable of**” or “suitable for”



“adapted to” = “made to,” “designed to,” or “**configured to**”

Aspex: “adapted to” = “suitable for”

Court: **Context** in *Aspex* dictated narrower meaning “made to” :

- Claim language context
- Specification including Abstract
- **Adjacent claim using “capable of”**

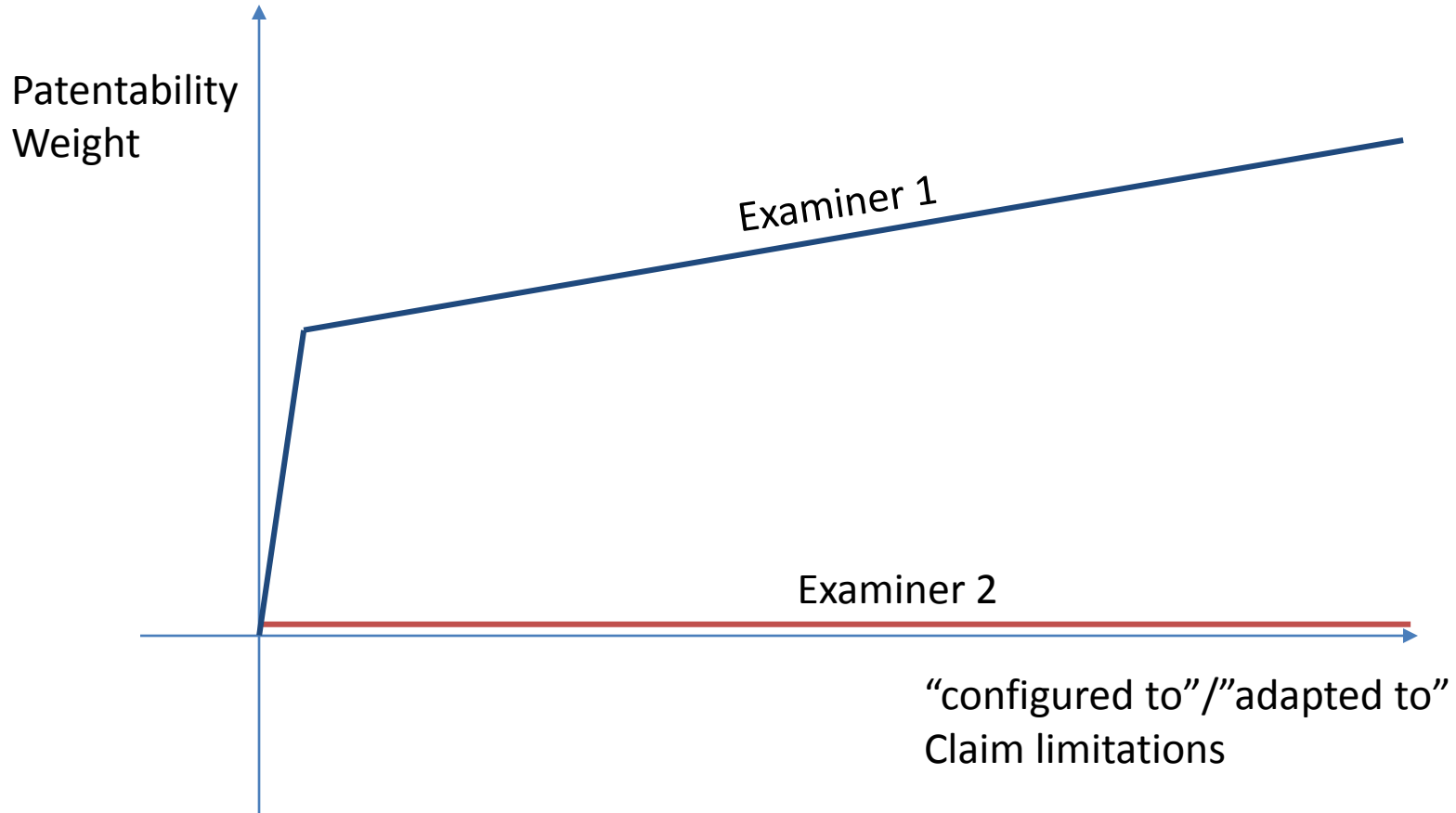


MPEP 2111.04 – January 2018 Update

In In re Giannelli, 739 F.3d 1375, 1378, 109 USPQ2d 1333, 1336 (Fed. Cir. 2014), the court found that an "adapted to" clause limited a machine claim where **"the written description makes clear that 'adapted to,'** as used in the [patent] application, has a narrower meaning, *viz.*, that the **claimed machine is designed or constructed to** be used as a rowing machine whereby a pulling force is exerted on the handles."



Observations from Practice



Takeaways – Functional Claim Language

- If you need to use functional language and the primary objective is:
 - a. **successful prosecution**; then use “adapted to”/”configured to” clauses and set the “context” (specification, claims, abstract) to support an argument that “adapted to” = “designed to” (< “capable of”)
 - b. **broader claims**; then use “capable of” and argue that prior art is not capable of performing the recited function



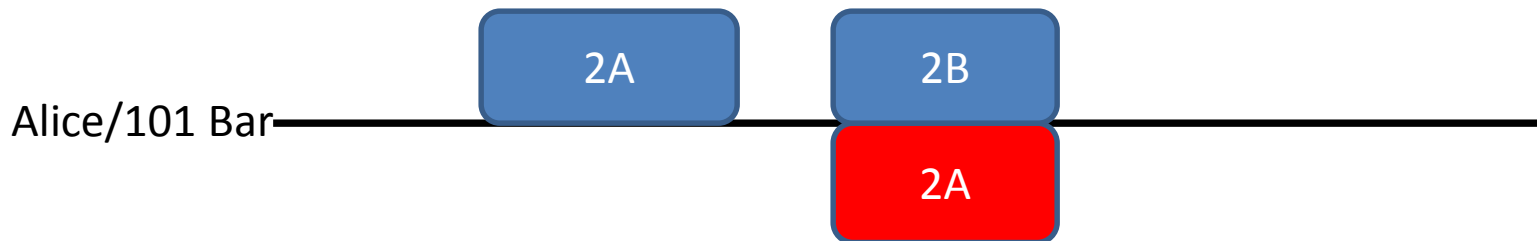
New Subject Matter Eligibility Approaches

2. New Subject Matter Eligibility approaches available to patent practitioners in view of the April 2018 USPTO memo titled Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc*)

WELL-UNDERSTOOD, ROUTINE, CONVENTIONAL?



WELL-UNDERSTOOD, ROUTINE AND CONVENTIONAL ACTIVITY (Step 2B)?



Berkheimer v. HP, Inc

Federal Circuit, February 8, 2018, Precedential Decision

- U.S. Patent No. 7,447,713
- The disputed patent relates to digitally processing and archiving files in a digital asset management system (*archival system*). This system eliminates redundant storage of common text and graphical elements, which *improves system operating efficiency and reduces storage costs*.
- The Court held that the question of whether certain claim limitations represent *well-understood, routine, conventional activity* raised a disputed factual issue, which precluded summary judgment that all of the claims at issue were not patent eligible



'713 Patent - archival system

2A

Claim 1: A method of archiving an item comprising in a computer processing system: *presenting* the item to a parser; *parsing* the item into a plurality of multi-part object structures wherein portions of the structures have searchable information tags associated therewith; *evaluating* the object structures in accordance with object structures previously stored in an archive; *presenting* an evaluated object structure for manual reconciliation at least where there is a predetermined variance between the object and at least one of a predetermined standard and a user defined rule.

2B

Claim 4: The method as in claim 1 which includes *storing a reconciled object structure in the archive without substantial redundancy*.

Claim 5: The method as in claim 4 which includes *selectively editing an object structure, linked to other structures to thereby effect a one-to-many change* in a plurality of archived items.

Specification: storing object structures in the archive *without substantial redundancy* improves system operating efficiency and reduces storage costs; *one-to-many editing* substantially reduces effort needed to update files because a single edit can update every document in the archive linked to that object structure



Berkheimer Decision

Whether claims 4–7 perform well-understood, routine, and conventional activities to a skilled artisan is a genuine issue of material fact making summary judgment inappropriate with respect to these claims.



USPTO Responds Quickly to *Berkheimer*

- Memorandum revising examination procedure in view of *Berkheimer* was issued on April 19, 2018:
Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision (*Berkheimer v. HP, Inc.*)

MPEP §2106.05(d)(I): An examiner should conclude that an element (or combination of elements) is well-understood, routine, conventional activity **only when** the examiner can readily *conclude* that the element(s) is widely prevalent or in common use in the relevant industry.

NEW: WRC conclusion must be based upon factual determinations



Step 2B Refresher- *MPEP 2106.05*

Limitations that the courts have found to qualify as “significantly more”

Improvements to the functioning of a computer *MPEP 2106.05(a)*; *DDR Holdings*

Improvements to any other technology or technical field *MPEP 2106.05(a)*; *McRO*

Applying the judicial exception with, or by use of, a particular machine *MPEP 2106.05(b)*;

Effecting a transformation or reduction of a particular article to a different state or thing
MPEP 2106.05(c);

Adding a specific limitation other than what is well-understood, routine, conventional activity in the field, or adding unconventional steps that confine the claim to a particular useful application *MPEP 2106.05(d)*; *BASCOM*; *DDR Holdings*

Other meaningful limitations beyond generally linking the use of the judicial exception to a particular technological environment *MPEP 2106.05(e)*.



BASCOM Global Internet v. AT&T Mobility LLC,

827 F.3d 1341, 119 USPQ2d 1236 (Fed. Cir. 2016)

- The district court properly identified the additional elements in the claims, such as a “local client computer,” “remote ISP server,” “Internet computer network,” and “controlled access network accounts”
- The district court properly considered the additional elements individually, for example by consulting the specification, which described each of the additional elements as “well-known generic computer components”
- The district court should have considered the additional elements in combination, because the “inventive concept inquiry requires more than recognizing that each claim element, by itself, was known in the art”

Based on this analysis, the Federal Circuit concluded that the district court erred by failing to recognize that when combined, an inventive concept may be found in the non-conventional and non-generic arrangement of the additional elements, i.e., the installation of a filtering tool at a specific location, remote from the end-users, with customizable filtering features specific to each end user.



EVALUATING WHETHER THE ADDITIONAL ELEMENTS ARE WELL-UNDERSTOOD, ROUTINE, CONVENTIONAL ACTIVITY

- WRC > Prior Art 102/103 Teaching
- Are Individual Elements WRC?
- Is the COMBINATION of additional elements WRC? - *Bascom*



Revised Examination Procedure in view of *Berkheimer*

An additional element (or combination of elements) is not well-understood, routine or conventional unless the examiner makes a factual finding, and expressly supports a rejection in writing with, one or more of the following four options:

- Admission by Applicant: Specification, Prosecution Statements
- Additional element in the claim must be the same as the element found to be WRC in the court case listed in the MPEP
- Publication describing the element or the combination of elements as WRC in that field
- Official Notice by Examiner



Takeaways – 101

- Clearly describe improvements to computer technology or other technology in the specification
- Contrast with the prior art
- Make sure that no admission is made in the specification or during prosecution that a critical element for 101 purposes is well-known, routine, conventional (i.e., cautiously use the phrase “as known in the art” or similar)
- Recite those technical improvements in the claims
- Be ready to push back, preferably via evidence, on the examiners or opposing party when they allege that the claims elements reciting the technical improvements are WRC both individually and in combination in the field
- Prior art knowledge ≠ WRC



Thank You!

Questions?

