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ABSTRACT COMPUTING, COLLECTING, AND ANALYSIS

By [Subaru Kanosaka](#)

[Int'l Bus. Machs., Corp. v. Zillow Group, Inc.](#), Appeal No. 2021-2350
(Fed Cir., October 17, 2022, Reyna, Hughes, and Stoll)

- Identifying, analyzing, and presenting certain data to a user is not an improvement specific to computing. Merely requiring the selection and manipulation of information to provide a ‘humanly comprehensible’ amount of information useful for users, by itself, does not transform the otherwise-abstract processes of information collection and analysis.
- 특정 데이터를 식별, 분석하고 사용자에게 제시하는 것은 컴퓨팅에 특화된 개선 사항이 아닙니다. 사용자에게 유용한 ‘인간이 이해하기 쉬운’ 양의 정보를 제공하기 위해 정보 선택 및 처리를 요구하는 것만으로는 정보 수집 및 분석의 추상적인 과정을 변형 (Transformation) 시키지 않습니다.
- 识别、分析并向用户呈现某些数据并不是特定于计算的改进。仅要求选择和处理信息以提供“人类可理解的”对用户有用的信息量，本身并不能改变信息收集和抽象过程。
- 特定データを特定し、解析し、そしてユーザに提供することは、演算に対する特定の改良ではない。‘人間的見地から理解し得る’ユーザにとって便利な情報の量を提供するための単なる情報の選択と操作の要件は、それ自体によって、他の点で抽象的な情報収集と解析のプロセスを変換(transform)することにはならない。

International Business Machines Corporation (hereinafter “IBM”) sued *Zillow Group, Inc. and Zillow, Inc.* (hereinafter “Zillow”) in the US District Court for the Western District of Washington, alleging infringement of seven patents related to graphical display technology. Regarding two of the asserted patents, US 9,158,789 (‘789 Patent) and US 7,187,389 (‘389 Patent), the district court granted Zillow’s motion for judgment on the pleadings, holding that the claims of those patents recite ineligible subject matter under 35 USC § 101.

Each of the ‘789 Patent and the ‘389 Patent is directed to technology that allows users to select and view results on a display. The district court concluded that the ‘789 Patent is directed to an abstract idea because the recited method “could be performed by hand, using a printed map and related list of items on the map, a transparent overlay, a wet-erase marker, a blank sheet of opaque paper, and a knife or scissors,” and that the claims in ‘789 Patent do not recite an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application of the abstract idea. The district court also concluded that the ‘389 Patent is directed to an abstract idea because the recited method “could be similarly performed using colored pencils and translucent paper; each sheet of paper would display a ‘layer’ within the meaning of the ‘389 Patent, and the sheets could be arranged, rearranged, and perhaps redrawn as desired to highlight particular objects or groups of objects,” and that the ‘389 Patent contained no inventive concept because “it was not directed to a computer specific problem and merely used well-understood, routine, or conventional technology (a general-purpose computer) to more quickly solve the problem of layering and displaying visual data.”

On appeal, IBM argued that the ‘789 patent is directed to patent-eligible “specific asserted improvement[s] in computer capabilities,” specifically, “an improved [graphical user interface] for displaying, filtering, and interacting with geospatial data on a map and list display.” Arguing for the ‘389 Patent, IBM analogized to *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356 (Fed. Cir. 2018), which held claims “directed to particular or specific implementations of presenting information in electronic devices” patent-eligible. *Core Wireless* reviewed claims that address problems specific to navigating applications on small screens, as repeatedly emphasized by the patent’s specification.

The Federal Circuit disagreed with IBM, explaining that “mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.” *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017). The reviewing court distinguished *Core Wireless*, explaining that the language of the specification in *Core Wireless* “clearly indicates that the claims are directed to an improvement in the functioning of computers, particularly those with small screens.” In contrast, the problem that the ‘389 patent purportedly solves, that the display of “any system that has large numbers of objects in many categories with relationships can be difficult to understand,” is not specific to a computing environment. Thus, the Federal Circuit affirmed the judgment of the district court, concluding that the ‘389 patent addresses problems arising from the space limitations of a finite two-dimensional display generally, but does not improve any computer function or recite claim limitations specific to a computing environment.

UTILITY DOES NOT MAKE AN ABSTRACT IDEA PATENTABLE

By James J Paige

In re Smith, Appeal No. 2022-1310

(Fed. Cir., September 9, 2022, Lourie, Dyk, and Hughes)

- A claim directed to collection of information, comprehending the meaning of that information, and indication of the results, all on a generic computer network operating in its normal, expected manner is directed to an abstract idea, and without transformative content, is not eligible for patenting.
- 일반적인 컴퓨터 네트워크에서 정보 수집, 수집된 정보의 의미 이해, 결과 표시를 포함하는 청구항은 추상적인 개념에 해당하며, 변형 (Transformation) 내용이 없으면 특허 등록이 불가능합니다.
- 一项针对信息收集、理解该信息的含义和结果指示的权利要求，所有这些都在于其正常、预期方式运行的通用计算机网络上进行，这是一个抽象概念，并且没有变革性内容，不符合申请专利的条件。
- すべてが通常の、期待された手法で動作する汎用コンピュータネットワーク上における情報の収集、その情報の意味の理解、そしてその結果の表示、に関するクレームは、変換する内容を欠いた抽象的概念であり、特許適格性がない。

The U.S. statute codified at 35 U.S.C. §101 defines what inventions are eligible for patenting. “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor....”

In April 2014, Jason Smith sought patent protection for a method for asset acquisition and management. The United States Patent and Trademark Office (“PTO”) rejected all claims as ineligible for patenting. Mr. Smith appealed the rejection to the Patent Trial and Appeals Board (“PTAB”), which affirmed the rejection on grounds that the claims do not recite a practical application of an abstract idea or a transformative inventive concept. Mr. Smith appealed the PTAB decision to the Court of Appeals for the Federal Circuit.

The claims of the application recite a method that includes providing a database with several linked tables, including user information, product information, inventory information, and other information, and providing user access to the database.

In analyzing claim 1 of Mr. Smith’s application, the reviewing court noted that the claim recites a method for collecting, analyzing, and displaying data. Applying the analytical framework of *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014), the court first determined that the claims are directed to “collection of information, comprehending the meaning of that information, and indication of the results, all on a generic computer network operating in its normal, expected manner,” which are abstract ideas. The court then determined that no claim recites an inventive concept that would transform the abstract idea into a patent eligible invention. As Mr. Smith’s application only claimed collecting, analyzing, and displaying data, without a transformation of the data (in a manner where a processor was necessary), the application was ineligible for patenting under §101.

The Federal Circuit rejected Mr. Smith’s argument that, if a claimed invention is useful it is patent eligible, explaining that utility is not the sole test for patent eligibility. The court also rejected Mr. Smith’s argument that the PTAB failed to consider the claims as a whole, finding that the PTAB expressly considered the “combination of various tables of data.”

PRIOR ART EFFECT OF GENERIC DISCLOSURE

By [David V. Lynch](#)

[Mylan Pharmaceuticals Inc. v. Merck Sharp & Dohme Corp.](#), Appeal No. 21-212
(Fed. Cir., September 29, 2022, [Lourie](#), Reyna, and Stoll)

- Without additional direction, mere disclosure of a genus having 957 species does not enable a person of ordinary skill in the art to “at once envisage” all species of the genus to support a conclusion that disclosure of the genus anticipates one of the species.
- 추가정보없이 957 개의 종 (species)을 가진 속 (genus)을 공개하는 것만으로는 당업자가 해당하는 모든 종들을 “즉시 상상할 수 있어서” 속의 계시가 어느 하나의 종을 예견한다고 결론내릴 수 있다고 보기는 어렵습니다.
- 在没有额外指示的情况下，仅仅公开一个有 957 个子属的属并不能使本领域的普通技术人员“立即设想”该属的所有子属来支持一个结论，即该属的公开可以预期一个子属。
- 追加の説明を伴わない、957個の種を有する属の単なる記載が、当業者を、その属のすべての種に関して、その属がその種のうちの1つを予期していると結論づけるサポートがあることを、“瞬時に予測”させるものではない。

Merck owns U.S. Patent 7,326,708 (‘708 Patent) directed to sitagliptin dihydrogenphosphate (DHP) in a 1:1 stoichiometric ratio, and hydrates thereof. The 1:1 formulation of sitagliptin DHP is an active ingredient in the diabetes drugs JANUVIA®, and JANUMET®. Mylan petitioned for IPR of certain claims of the ‘708 Patent, arguing the claims are anticipated by WO 2003/004498 (equivalent to another Merck patent, U.S. Patent No. 6,699,871) (collectively, “Edmondson”). Edmondson is directed to dipeptidyl peptidase-IV inhibitors, which can be useful in treating diabetes, and particularly type 2 diabetes. Sitagliptin appears among 33 such inhibitors listed in Edmondson. Edmondson also discloses that salts of the 33 chemicals can be made using 8 different “particularly preferred” acids, among them phosphoric acid. Mylan also argued that these claims would have been obvious over Edmondson in view of two additional publications, one teaching crystalline hydrates and another teaching salt selection and optimization for pharmaceutical compounds.

The Patent Trial and Appeals Board determined that there is no express or inherent disclosure of the claimed composition in Edmondson, and that a skilled artisan would not “at once envisage” all members of the genus disclosed in Edmondson, and because the 1:1 version of sitagliptin DHP does not form every time sitagliptin and phosphoric acid are reacted. The Board also determined that these claims would not have been obvious over Edmondson and the other cited references because Merck had reduced the claims to practice before publication of Edmondson, and because Edmondson was co-owned by Merck, it was excludable under the exception of 35 U.S.C. § 103(c)(1).

On appeal, Mylan argued that that sitagliptin DHP is effectively disclosed in Edmondson by separate disclosure of the 33 chemicals, one of which is sitagliptin, and the 8 acids, one of which is phosphoric acid. Mylan further asserts that a skilled artisan would “at once envisage” a 1:1 stoichiometry of the sitagliptin DHP salt because Edmondson Example 7 discloses a sitagliptin HCl salt with 1:1

stoichiometry. Mylan also argued that disclosure of sitagliptin hydrates in Edmonson precedes Mylan's reduction to practice of hydrates, recited in one dependent claim not at issue in the case, so Mylan cannot antedate Edmonson. Finally, Mylan argued that a reference teaching away from using HCl salts would have motivated a skilled artisan to replace the HCl of Edmonson's Example 7, making the DHP salt obvious, and a reference generally teaching hydrates would have made the hydrates obvious.

The Federal Circuit found, with regard to anticipation, the Board's decision was supported by substantial evidence, at least in the form of Mylan's own expert testimony "that nothing in Edmondson directs a skilled artisan to sitagliptin from among the 33 listed DP-IV inhibitors." The reviewing court held that the Board correctly found that nothing in Edmondson inherently disclosed a 1:1 sitagliptin DHP salt. The court explained that *In re Petering*, 301 F.2d 676, 681 (C.C.P.A. 1962), from which the "at once envisage" theory stems, "stands for the proposition that a skilled artisan may 'at once envisage each member of [a] limited class.'" As the court explained regarding Edmonson, "the list of 33 compounds... plus the eight 'pharmaceutically preferred' acids and various possibilities, results in 957 salts", which "is a far cry from the 20 compounds 'envisaged' by the narrow genus in Petering." The court warned, however, that no particular number defines a "limited class." The Court found the Board did not err in finding the class of 957 predicted compounds in Edmonson is insufficient to meet the "at once envisage" standard set forth in Petering.

With regard to obviousness, the Court agreed that Merck had shown that it developed a 1:1 sitagliptin DHP salt in December 2001, with experimental confirmation in early 2002, one year before Edmondson published, and thus could antedate and exclude the disclosure of Edmonson for obviousness purposes.

INTERNET-SPECIFIC IMPLEMENTATION PATENTABLE

By [Nick Fan](#)

[Weisner v. Google LLC](#), Appeal No. 2021-2228
(Fed Cir., October 13, 2022, Reyna, Hughes, and [Stoll](#))

- Claims reciting methods of using location history to prioritize Internet search results were directed to a specific implementation of an abstract idea that purports to solve a problem unique to the Internet and, accordingly, these claims should not have been held ineligible under step two of *Alice* at the pleadings stage.
- 위치 기록을 사용하여 인터넷 검색 결과의 우선순위를 정하는 방법을 포함하는 청구항은 인터넷의 고유한 문제를 해결하는 추상적인 개념의 특정한 실행에 해당하며, 따라서 답변 및 소장제출 단계 (pleadings stage) 에서 Alice 의 Step 2 를 적용해서 이 청구항이 특허등록이 불가능하다고 판단되어서는 안되는 것이었습니다.
- 使用位置历史对互联网搜索结果进行优先排序的方法的权力要求是针对一个抽象思想的具体实现，该抽象思想旨在解决互联网独有的问题，因此，在诉状阶段，这些权力要求不应该在爱丽丝的第二步中被认为不合格。
- 인터넷의 검색 결과에 우선순위를付けるために位置履歴を用いる方法に係るクレームは、インターネット特有の課題を解決することを目的とした抽象的概

念の特定の実現であり、したがって、これらのクレームは、その答弁段階において、Alice のステップ 2 下で特許適格性を有していなかったと認定されるべきではない。

Mr. Weisner sued Google LLC in the US District Court for the Southern District of New York, alleging infringement of US Patents 10,380,202, 10,642,910, 10,394,905 and 10,642,911 (hereinafter '202 patent, '910 patent, '905 patent, and '911 patent). The claims of the '202 patent and the '910 patent are directed to methods of creating and/or using physical location histories of individual members that visit stationary vendor members in a member network. The claims of the '905 patent are directed to methods of combining enhanced computerized searching for a target business with use of humans as physical encounter links. The claims of the '911 patent are directed to computer-implemented methods of enhancing digital search results for a business in a target geographic area using uniform resource locators (URLs) of location histories.

The Federal Circuit affirmed the district court's holding that the asserted claims of the '202 and '910 patents are ineligible under § 101 but dismissed the district court's holding that the claims of the '905 and '911 patents are ineligible under § 101.

In reviewing the district court's holding, the Federal Circuit applied the familiar two-step test established by the Supreme Court in *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014). Upon addressing step one, the Federal Circuit agreed with the district court's analysis that the representative claims in the '202 patent, '910 patent, '905 patent, and '911 patent are directed to an abstract idea. Upon turning to step two, the reviewing court agreed with the district court that the components and features listed in the claims of '202 patent and '910 patent are conventional, not inventive, concepts in the patents. The asserted claims of the '202 and '910 patents are therefore ineligible under § 101.

The Federal Circuit, however, reversed the district court's analysis of the asserted claims of the '905 and '911 patents under step two, explaining that “[t]he '905 and '911 patent claims ... plausibly include more than merely the concept of improving computerized search results using travel histories. Instead, those claims add significantly more to that abstract idea by implementing a specific solution to a problem rooted in computer technology.” The court reasoned that “[t]he '905 and '911 patent claims are analogous to those we held eligible in *DDR*,” which held that “patent claims [are] eligible at step two when they provided a specific solution to an Internet-centric problem.” See, *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014). The reviewing court found that the '905 and '911 patent claims provide a specific way to solve the problem, unlike the claims in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709 (Fed. Cir. 2014). The '905 and '911 patent claims avoid the *Ultramercial* problem of broadly and generically claiming use of the Internet to perform an abstract business practice (with insignificant added activity). The court concluded that the '905 and '911 patent claims recite a specific implementation of the abstract idea that purports to solve a problem unique to the Internet, so the claims should not have been held ineligible at the pleadings stage.

ADDITIONAL INFORMATION

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