

Federal Circuit Patent Bulletin: *Intellectual Ventures I LLC v. Symantec Corp.*

October 3, 2016

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On September 30, 2016, in *Intellectual Ventures I LLC v. Symantec Corp.*, the U.S. Court of Appeals for the Federal Circuit (Dyk,* Mayer, Stoll) affirmed-in-part and reversed-in-part the district court’s judgment that U.S. Patents No. 6,460,050 and No. 6,073,142, but not No. 5,987,610, all of which related to information screening, were invalid as patent ineligible under 35 U.S.C. § 101. The Federal Circuit stated:

In *Mayo* and in *Alice*, the Court set forth a framework for “distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” At *Mayo/Alice* step one, a court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” The category of abstract ideas embraces “fundamental economic practice[s] long prevalent in our system of commerce,” including “longstanding commercial practice[s]” and “method[s] of organizing human activity.” But the category of abstract ideas is not limited to economic or commercial practices or methods of organizing human activity. If a claim is directed to a patent-ineligible concept, the court must proceed to *Mayo/Alice* step two, and ask, “what else is there in the claims before us?” Step two is “a search for an inventive concept— i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” . . . And “[s]imply appending conventional steps, specified at a high level of generality,” which are “well known in the

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art” and consist of “well-understood, routine, conventional activit[ies]” previously engaged in by workers in the field, is not sufficient to supply the inventive concept.

The district court held patent-ineligible the asserted claims of the ‘050 patent—claims 9, 13, 16, 22, and 24—directed to filtering e-mails that have unwanted content. We agree with the district court. [R]eceiving e-mail (and other data file) identifiers, characterizing e-mail based on the identifiers, and communicating the characterization—in other words, filtering files/e-mail—is an abstract idea. . . . Here, it was long-prevalent practice for people receiving paper mail to look at an envelope and discard certain letters, without opening them, from sources from which they did not wish to receive mail based on characteristics of the mail. The list of relevant characteristics could be kept in a person’s head. Characterizing e-mail based on a known list of identifiers is no less abstract. The patent merely applies a well-known idea using generic computers “to the particular technological environment of the Internet.” . . .

Here, the jury’s general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of *Mayo/Alice*. The steps of the asserted claims of the ‘050 patent do not “improve the functioning of the computer itself.” . . . Rather, these claims use generic computers to perform generic computer functions.

IV argues that the ‘050 patent “shrink[s] the protection gap and moot[s] the volume problem.” According to IV, the protection gap is “the period of time between identification of a computer virus by an anti-malware provider and distribution of that knowledge to its users.” The volume problem is the “exponential growth in malware and spam,” increasing the amount of antivirus signatures to be downloaded. However, the asserted claims do not contain any limitations that address the protection gap or volume problem, e.g., by requiring automatic updates to the antivirus or antispam software or the ability to deal with a large volume of such software. We have explained that, “for a perceived abstract idea, if the claim ‘contains an “inventive concept” sufficient to “transform” the claimed abstract idea into a patent-eligible application,’ then the claims pass the test of eligibility under section 101.” But when a claim directed to an abstract idea “contains no restriction on how the result is accomplished . . . [and] [t]he mechanism . . . is not described, although this is stated to be the essential innovation[,]” then the claim is not patent-eligible. The asserted claims of the ‘050 patent are not patent-eligible under § 101.

The district court held ineligible claims 1, 7, 17, 22,24, and 26 of the ‘142 patent, which relate to systems and methods for receiving, screening, and distributing e-mail, and we agree. . . . The district court held that “the asserted claims of the ‘142 patent are directed to human-practicable concepts, which could be implemented in, for example, a brick-and-mortar post office.” We agree, and think the district court’s analogy to a corporate mailroom is also useful. Such mailrooms receive correspondence, keep business rules defining actions to be taken regarding correspondence based on attributes of the correspondence, apply those business rules to correspondence, and take certain actions based on the application of business rules. [W]ith the exception of generic computer-implemented steps, there is nothing in the claims themselves that foreclose them from being performed by a human, mentally or with pen and paper. . . .

IV argues that the claims do not merely require routine and conventional use of computers and the Internet because “applying business rules to email is not what computers and the Internet do in the absence of this claim limitation” and “because computers and the Internet do not have ‘rule engines’ as a matter of course.” But the inquiry is not whether conventional computers already apply, for example, well-known business concepts like hedging or intermediated settlement. Rather, we determine whether “each step does no more than require a generic computer to perform generic computer functions.” Here that is the case. The asserted claims of the ‘142 patent are not patent-eligible under § 101.

Claim 7 is the only asserted claim of the ‘610 patent. The district court held eligible claim 7 of the ‘610 patent. . . . Unlike the asserted claims of the ‘050 and ‘142 patents, claim 7 involves an idea that originated in the computer era—computer virus screening. But the idea of virus screening was nonetheless well known when the ‘610 patent was filed. Performing virus screening was along prevalent practice in the field of computers, and, as the patent admits, performed by many computer users. . . . Nor does the asserted claim improve or change the way a computer functions. Claim 7 recites no more than generic computers that use generic virus screening technology. . . .

IV argues that “[t]he claims of the ‘610 Patent include meaningful limitations that narrow the claimed invention to a specific way of screening for computer viruses within the telephone network . . . and does not preempt all virus detection.” A narrow claim directed to an abstract idea, however, is not necessarily patent-eligible, for “[w]hile preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” . . . Claim 7 of the ‘610 patent is not patent-eligible under § 101.