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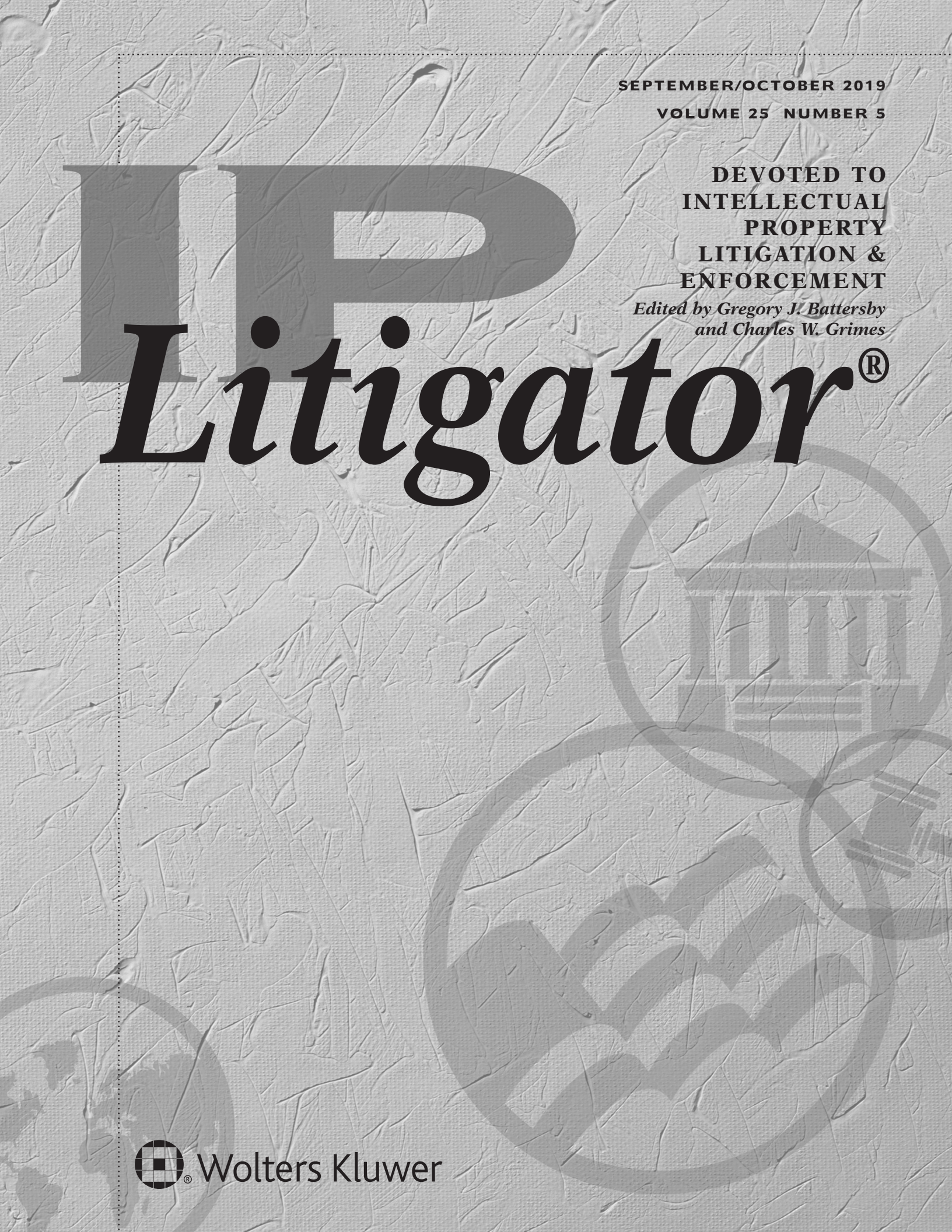

Wolters Kluwer

PTO Practice

Ryan N. Phelan

Four Decisions to Know regarding the PTAB's Treatment of the new 2019 Patent Eligibility Guidelines

On July 1, 2019, The Patent Trial and Appeal Board (PTAB) designated as "informative" four decisions applying the Patent Office's 2019 patent eligibility guidance (PEG) regarding 35 U.S.C. § 101. While the decisions are not binding on future PTAB panels, the decisions provide useful insights into how the PTAB may approach issues of patent eligibility on ex parte appeal, and what type of claims are likely to be found patent-eligible.

Of the newly designated PEG decisions, two demonstrate how to overcome an examiner's patent eligibility rejection regarding 35 U.S.C. § 101:

1. *Ex parte Olson*, Appeal No. 2017-006489 (March 25, 2019) (Catheter Navigation)
2. *Ex parte Fautz*, Appeal No. 2019-000106 (May 15, 2019) (MR Tomography)

The remaining two decisions demonstrate claims that are not eligible, even under the new PEG:

3. *Ex parte Kimizuka*, Appeal No. 2018-001081 (May 15, 2019) (Fitting a Golf Club)
4. *Ex parte Savescu*, Appeal No. 2018-003174 (Apr. 1, 2019) (Life-Cycle Workflow)

Summaries of these decisions are provided below.

A common theme that develops from these decisions is that even though claims may include abstract ideas (*e.g.*, mathematical concepts), such claims can be patent-eligible if the claims incorporate and demonstrate use of the abstract idea to show improvement over prior art systems or methods. This can satisfy the "practical application" test of the PEG's new step 2A, Prong 1.

An overview of the PEG, including a description of how to analyze abstract ideas under the Patent Office's newly revised step 2A, may be found in at: https://www.ptabwatch.com/2019/03/how-the-ptab-reviews-software-inventions-under-the-2019-revised-subject-matter-eligibility-guidance/ in an article titled, *How the PTAB Reviews Software Inventions Under the 2019 Revised Subject Matter Eligibility Guidance.*

1. *In re Olson*, Appeal No. 2017-006489 (March 25, 2019) (Catheter Navigation)

The claims-at-issue concerned mapping coordinates of a catheter navigation system. Of note, the claims included elements reciting mathematical formulas, *e.g.*, "using at least two fiducial pairs (Xi, Y) to generate a mapping function *f* that transforms points within [] X to [] Y such that, for each fiducial pair[], an error function f (Xi) — Y is approximately equal to 0".

Because of these claim elements, the PTAB found that the claims recited a mathematical concept (*i.e.*, a type of abstract idea) under Step 2A, Prong 1 of the PEG.

Under Step 2A, Prong 2, however, the PTAB found that the claims included elements that integrated the mathematical concept into a practical application, and, thus, made the claims patent eligible. In particular, the claims included elements addressing problems arising in the context of mapping a catheter navigation system to a three-dimensional image in connection with cardiac procedures. These limitations included (1) "placing a tool on a surface location X of the heart"; (2) "measuring position information for [] Xi relative to a coordinate frame X"; (3) "identifying a corresponding location Y on the three-dimensional image"; and (4) "associating the position information for [] Xi as measured by the catheter navigation system relative to [] X with position information for [] Y on the three-dimensional image relative to [] Y as a fiducial pair (Xi, Yi)."

Even though the claims included mathematical concepts, such concepts were integrated into the practical application of improving registration of a catheter navigation system into a three-dimensional image of a heart by accounting for nonlinearities, which resulted in reduced errors in cardiac procedures.

Thus, the PTAB concluded the claimed invention was patent-eligible under the PEG.

2. *In re Fautz*, Appeal No. 2019-000106 (May 15, 2019) (MR Tomography)

The claims-at-issue concerned transforming an MR tomography device configured to perform slice-imaging. The claims included elements reciting three mathematical equations. As in *in re* Olson, the

PTAB found that the claims recited a mathematical concept under Step 2A, Prong 1 of the PEG.

Under Step 2A, Prong 2, however, the PTAB found that claim elements integrated the mathematical concept into a practical application. In particular, the independent claims recited elements regarding determining reception sensitives of each of a series of surface coils. The determination was made using relative phases and amplitudes (*i.e.*, mathematical concepts) to improve the shortcomings of prior art systems and methods. For example, the independent claims recited determining each single coil's reception sensitivities (via a claimed formula, *e.g.*, "$B1_i^-(r)$") with relative phases and amplitudes. The use of the mathematical equations addressed shortcomings of known prescan-normalize methods, which were inferior as they could not determine reception sensitivities of individual channels.

On this basis, the PTAB concluded the mathematical concept, as claimed, was integrated into a practical application and was, thus, patent-eligible under the PEG.

3. *In re Kimizuka*, Appeal No. 2018-001081 (May 15, 2019) (Fitting a Golf Club)

The claims-at-issue concerned fitting a golf club to a player, where claims recited methods for selecting a club with a suitable loft angle for the player. The claims included elements such as "determining, by a processor, a suitable dynamic loft"; "determining a dynamic loft difference"; and "determining a recommended loft angle."

Because of these claim elements, the PTAB found that the claims recited a mental process under Step 2A, Prong 1 of the PEG. The PTAB explained that each recited "determining" claim element could be practically performed in the mind or with the assistance of pen and paper.

While the claims recited use of a "database" and "a processor," this did not save the claims under Step 2A, Prong 2 because such claim elements, alone, did not integrate the mental process of fitting a golf club into a practical application.

In addition, even though the claims required storing a database of a user's golf swing data, such additional claim elements were well understood, routine, and conventional, such that the claim, as a whole, did not recite an inventive concept under step 2B.

Hence, the PTAB sustained the examiner's rejection of the claims under 35 U.S.C. § 101 pursuant to the PEG.

4. *In re Savescu*, Appeal No. 2018-003174 (April 1, 2019) (Life-Cycle Workflow)

The claims-at-issue concerned a life-cycle workflow project planning, where projects, proposals, and business cases are submitted through a governance process. The claims included elements involving workflow "stages," including, for example, "creating one or more identifiable workflow stages for the project," and where "each of the one or more workflow stages" correspond to "a specific sequence of workflow activities."

Because of these claim elements, the PTAB found that the claims recited certain methods of organizing human activity, under Step 2A, Prong 1 of the PEG. The PTAB explained that each of the recited claims merely included "steps for creating a workflow that organizes how people perform project tasks."

The PTAB addressed the remaining claim elements, which included a server for storing data and creating web pages related to the project tasks: "the recited server contributes only nominally and insignificantly to the recited method." According to the PTAB, such claims failed to integrate the life-cycle workflow into a practical application under Step 2A, Prong 2.

Finally, under Step 2B, the PTAB found that the claims failed to recite elements other than those that were well known, routine, and conventional. Instead, the PTAB found that the claims were similar to those of the Federal Circuit's *Interval Licensing* decision, where the claims "merely [recite] routine and conventional steps in carrying out the well-established practice of accessing data from an external source and displaying that data on a user's device."

Hence, the PTAB sustained the examiner's rejection of the claims under 35 U.S.C. § 101 pursuant to the PEG.

* * *

While the above decisions are not binding on future PTAB panels, the decisions provide insight into how the PTAB may approach patent eligibility on *ex parte* appeal, and what type of claims are likely to be found patent-eligible.

Therefore, practitioners may use these set of cases as a sort of litmus test, comparing a draft set of claims to the claims of these cases to determine whether or not the draft set of claims would likely be found eligible if ever appealed to the PTAB.

Ryan N. Phelan is a registered patent attorney who counsels and works with clients in intellectual property (IP) matters, with a focus on patents. As a former technology consultant with Accenture and with a background in computer science and engineering, Ryan has extensive experience in computer system and software design, engineering, development and related technologies. He has represented

numerous Fortune 500 clients with patent matters in technical areas including electrical and software engineering, machine learning, virtual reality, imaging, internet and e-commerce, computer networking, encryption and security, mobile telecommunications, consumer electronics, insurance and finance applications.