

Seyfarth PTAB Blog



A legal look at Patent Trial and Appeal Board decisions and trends

Abstract Idea Implemented by “Automated Agent” Survives *Alice* Attack

By Patrick T. Muffo

It is well settled that “automating” a previously well-known invention is not enough to confer patentability. For the issues of novelty and obviousness, the famous *Leapfrog v. Fisher Price* case held that “modernizing” children’s books by creating talking books is an obvious technological improvement. For the issue of patent eligibility, courts have recently held that automating an abstract idea is not, by itself, enough to render the invention patent-eligible. But many courts have also explained that the purpose of the invention is an important clue in determining whether the abstract idea has been fully preempted. Tying these principles together, the Eastern District of Texas held an automated invention was patent-eligible because of the manner of automation, not the mere existence of it.

In *Motio Inc. v. BSP Software, LLC et al.*, Case No. 4:12-cv-647, (E.D. Tex. January 4, 2016), the invention related to a method of providing automatic version control to a business intelligence system. The patent owner conceded that document version control was not, by itself, a new concept. However, the patent owner argued the manner of version control in the patented invention was new, and did more than attempt to monopolize the entire field of version control.

The court first determined that the invention was directed to the abstract idea of version control. The court analogized the various “abstract ideas” from other cases to the patent-in-suit and found “Maintaining versions requires collection, recognition of an item to be copied or saved, and storing of that identified item.”

Turning to the second prong of *Alice*, the court first discussed what did not render the claims patent-eligible. For example, the court reiterated that the mere automation of an old idea would not confer patentability. Nor would the fact that the invention reported data that was “complicated and highly technical.” Rather, the court found the Defendants oversimplified the invention by arguing it was “just a form of computer software.” In fact, the Defendants’ own proposed construction of various claim terms was more detailed than computer software *per se*.

The court, like several before, focused on the purpose of the invention when declaring it patent-eligible: “It is the provision of this automated agent to solve the problem of a business intelligence system lacking native version control that amounts to significantly more than a patent on the idea of maintaining versions of electronic documents itself.”

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Takeaway

Defendants are always at a tension when proposing a claim construction of a particular term. On the one hand, a more narrow construction helps with noninfringement. On the other hand, a broader construction (especially during a PTAB proceeding) helps with invalidity. Going a step further, a more vague or abstract construction helps with patent-eligibility. In *Motio*, the Defendants successfully proposed a narrow construction for the term “automated agent” and later argued it amounted to no more than “just a form of software.” Defendants should be careful to recognize the tension of their constructions, especially when successful, and to avoid contradicting the narrow meaning of claims by characterizing the invention in a broader context for patent-eligibility purposes.

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