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



Software is Patentable When it is a “Specific and Concrete Implementation” of Abstract Idea

By Patrick T. Muffo

Courts have undoubtedly struggled to articulate when a claimed invention constitutes an “abstract idea” within the meaning given to that term in *Alice* and *Mayo*. The Eastern District of Texas provided some guidance recently when it held patent-eligible an invention that was a “specific and concrete implementation” of the abstract idea, rather than the abstract idea itself.

The Court in [Gonzalez v. Infostream Group](#), Case No. 2:14-cv-906-JRG-RSP (E.D. Texas, Feb. 6, 2016) held the claimed invention was not drawn to an abstract idea, and regardless, was directed to an “inventive concept” when read as a whole. The invention is a method for making digital labels for websites where each digital label represents a particular item of “qualitative information” about the website, posting, or owner. The digital labels are then produced on a computer or network.

Infostream challenged the claims as being unpatentable under §101. Infostream argued the claims were directed to the abstract idea of “using labels to facilitate searches” without any further inventive concept to transform the abstract idea into a patent-eligible invention. The Court disagreed, and spent much of the opinion focusing on the “abstract idea” prong of the *Alice/Mayo* test. In particular, the Court repeatedly declined to define an invention as an “abstract idea” where the invention was a “specific and concrete implementation” of the abstract idea:

For example, a claim directed at using a computer to issue “revolving credit” may be directed at an abstract idea, but a claim directed at a “credit card” is not directed at an abstract idea. A “credit card” works as a specific and concrete implementation of the abstract idea of “revolving credit.”

Applying this principle to the claims at hand, the Court held “[s]imilarly, using ‘labels’ serves as a concrete and specific way of conducting data storage and search.” The Court did not cite any authority for the “specific and

concrete implementation” language, but appeared to rely on the concept of preemption when holding the claims patent-eligible “Many ways of gathering information exist besides obtaining it by ‘guiding’ a subscriber.”

The Court also briefly held the claims were directed to an inventive concept, citing the *DDR Holdings* Federal Circuit decision.

Takeaway

Preemption has been a popular theory for overcoming *Alice* challenges and this case proves why. Once again, the analysis begins with the definition of the abstract idea, with a broader definition allowing for the argument that the invention is more specific, and therefore not the defined abstract idea itself. Of course, a more narrow abstract idea definition allows the argument that the “abstract idea” is not so abstract after all. The language “specific and concrete implementation” appears to be a new way of describing this balance between what constitutes an abstract idea, and what constitutes an invention that does not preempt the abstract idea.

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Seyfarth Shaw LLP PTAB Blog | March 1, 2016

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