

Seyfarth PTAB Blog



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

The Importance of the Specification in *Alice* Challenges

By Patrick T. Muffo

It is axiomatic that the claims of a patent describe the invention, and for *Alice* challenges, define whether an invention is drawn to an abstract idea without an inventive concept. Of course, claims are construed in light of the specification and some courts delay ruling on *Alice* motions until after a *Markman* hearing is held. The Southern District of Texas continued this trend by denying a Motion to Dismiss on *Alice* grounds, holding the patent-in-suit must be construed before an *Alice* analysis can be performed.

In the case of *Mantissa Corporation v. Ondot Systems, Inc.*, Case No. 4:15-cv-1133 (S.D. Texas, August 12, 2016 Order on Motion to Dismiss) the court focused on the specification of the patent-in-suit and refused to view the claims in a vacuum on a Motion to Dismiss. Citing *Enfish*, the court held a proper *Alice* analysis requires “a stage-one filter to *claims, considered in light of the specification...*” (emphasis in original). The court discussed the more narrow situation where the invention is alleged to improve the function of the computer itself, again citing *Enfish*: “[whether] the claims are directed to an improvement of an existing technology *is bolstered by the specification’s teachings* that the claimed invention achieves other benefits over conventional databases...” (emphasis in original). The court then held the claims must be construed in light of the specification before determining whether the claims were invalid under §101.

The court appeared to be worried about a possible reversal if it conducted an *Alice* analysis pre-claim construction. In a frank passage of the opinion, the court summarized *Enfish* as follows: “This reversal was largely based on the Federal Circuit’s finding that the district court oversimplified ... the claims and downplayed the invention’s benefits... By first allowing claim construction, the Court hopes to avoid that situation in this case.”

Takeaway:

Courts tend to take up an *Alice* challenge early where the issue does not turn on any claim construction. It is unclear whether competing claim constructions were set forth here, so early in the case, but the court was obviously worried about a reversal and wanted to approach the situation cautiously. Patent owners may therefore consider raising the issue of claim construction to persuade a nervous court to push an *Alice* challenge to later in the case.

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