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Federal Circuit Finds Computer-Based Patent Not Directed to Abstract Idea

By Christopher A. Baxter

The Federal Circuit, in *MCRO, Inc. v. Bandai Namco Games America Inc.*, recently ruled on an *Alice* challenge regarding U.S. patent nos. 6,307,576 and 6,611,278, directed to producing lip synchronization and facial expressions in animated characters. The court held the patents were not directed to an abstract idea, and therefore contained eligible subject matter, despite the patents essentially being directed to automating tasks that were previously performed by humans.

The following claim is representative of the asserted claims:

> A method for automatically animating lip synchronization and facial expression of three-dimensional characters comprising:
>
> obtaining a first set of rules that define output morph weight set stream as a function of phoneme sequence and time of said phoneme sequence;
>
> obtaining a timed data file of phonemes having a plurality of sub-sequences;
>
> generating an intermediate stream of output morph weight sets and a plurality of transition parameters between two adjacent morph weight sets by evaluating said plurality of sub-sequences against said first set of rules;
>
> generating a final stream of output morph weight sets at a desired frame rate from said intermediate stream of output morph weight sets and said plurality of transition parameters; and
>
> applying said final stream of output morph weight sets to a sequence of animated characters to produce lip synchronization and facial expression control of said animated characters.

To determine whether the patents were directed to an abstract idea, the court drew a distinction between claims that focus

on a specific means or method that improves the relevant technology, as compared to claims that are simply directed to a result or effect that itself is the abstract idea and that merely invoke generic processes and machinery. The court held the claims were directed to the former, as opposed to the latter.

The court stated the claims, while embodied in software processed by a general-purpose computer, were not directed to the abstract idea itself because the process embodied in the claims was not the same as the process used by previous animators. According to the court, the claims at issue in *Flook*, *Bilski*, and *Alice* encompassed computer-automated processes that were carried out in the same way as the prior methods specific to each case. In contrast, the court in *MCRO* noted the synchronization of animated characters by animators was previously driven by subjective determinations, whereas the claims at issue required specific, limited mathematical rules. The court thus held the claims, as a whole, use limited rules in a process specifically designed to achieve an improved technological result in conventional industry practice.

The court went a step further and determined that the claims also do not run afoul of the preemption principles underlying *Alice* jurisprudence. Specifically, the court stated the particularized rules of the claims and the fact that the claims require the rules be rendered in a specific way (i.e., as a relationship between sub-sequences of phonemes, timing, and the weight to which each phoneme is expressed visually at a particular timing), prevent the claims from preempting all processes for automated lip-synchronization of 3-D characters.

Takeaway

Patentees should focus on disclosing and claiming specific process steps that were not performed previously. Patentees would be disserved to simply disclose and claim results of a process. Simply claiming a result will more likely result in a court concluding the claims are directed to an abstract idea.

Patentees should also consider disclosing, with specificity, what prior methodology entailed as well as why the disclosed and claimed invention is different from the prior methodology. The more specific and technical the patentee is in drawing distinctions between the prior methodology and the present invention, the more likely a court is to find the claims are not directed to an abstract idea.

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