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

Financial Patent Resurrected After Court *Sua Sponte* Reverses *Alice* Decision

By Patrick T. Muffo

Since the Supreme Court *Bilski* case, financial patents have been routinely denied patentability by the Patent Office, or have been invalidated before the PTAB or district court. A court in the Southern District of New York had previously invalidated a finance-based patent on *Alice* grounds, finding it related to no more than an abstract idea. After a new judge received the case, the new court found the claims patent-eligible and, as an early Christmas gift to the patentee, reversed the prior invalidity finding.

The case of *Tivo Research and Analytics, Inc. v. TNS Media Research LLC*, 11-cv-4039 (S.D.N.Y. November 29, 2016) involved a patent with claims directed to analyzing a return on an investment in advertising campaigns by matching multiple data sources. The invention specifically allows for "accountability regarding the financial resources spent on advertising." The court conducted a detailed analysis of the specification, noting the many proffered advantages of the invention and the "four dozen figures."

The takeaway portion of the case relates to the court's discussion of the abstract idea analysis. The court, in reviewing the claims and specification, found the invention to be quite complex and the defendant's summarization of the invention to be exceptionally simplistic. The claim required more elements and limitations than the abstract idea suggested by the defendant, which the court noted "[t]he Court must look to the remaining elements aside from those directed to an abstract idea, either in isolation or combination with the other non-patent-ineligible elements." In general, the court found the additional elements to be probative to patent-eligibility, as they were drawn to much more than the simplistic abstract idea set forth by the defendant "[t]he key question is whether the abstract summary embodies the totality of the invention is all that the invention is—in other words, is the invention nothing more than the abstract concept? Here, the answer is plainly no."

Takeaway:

Alice challenges, whether from defendants in litigation or the Patent Office, tend to simplify the invention to an "abstract idea" while ignoring other key, non-abstract portions of the claim. These other portions of the claim may be nominal additions or otherwise separate from what the invention is really directed towards. But as the court held in this case "[t]he fact that a claim is directed to a patent-ineligible concept does not necessarily mean it is patent-ineligible under § 101." The additional limitations of the claim must be considered when conducting an Alice analysis, and if such limitations

are not covered by the suggested "abstract idea," the claim could be considered patentable under §101 as drawn to more than the abstract idea, namely, the "abstract idea" plus additional, non-abstract features.

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