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

Once Again, the Purpose of the Invention Determines Patent-Eligibility

By Vincent Smolczynski

In ruling on a motion for judgment on the pleadings, the Northern District of Ohio recently determined that a patent for searching and unifying data was invalid for lack of patentable subject matter. *See DATATRAK International, Inc. v. Medidata Solutions, Inc.*, 1-11-cv-00458 (N.D. Ohio Nov. 6, 2015 Order). Of particular note, the court stated that the problems the patent at issue purportedly solved – "data overload," "costs for organizing data," "data permissions," and "downstream proliferation of data" – were not necessarily rooted in computer technology as those same problems affect noncomputerized data storage as well. This case fits into a broader trend where courts analyze the purpose of the invention to determine whether it complies with § 101.

U.S. District Judge Patricia A. Gaughan first determined that U.S. Patent Number 7,464,087, directed toward organizing and retrieving data from multiple sources, was thus tied to an abstract idea. As noted by Judge Gaughan, "the use of tables and indexes to sort data for retrieval" has been used by humans for ages and in fact can be done by humans themselves without computers.

Continuing along the second part of the two-part test articulated by the Supreme Court in *Alice*, the court then determined the patent failed to articulate an "inventive concept." Plaintiff argued that the '087 patent was necessarily rooted in computer technology and thus overcame problems specifically arising in the realm of computer networks. One by one, the court rejected Plaintiff's arguments, further disagreeing that the claims required a "specific computer" or any "additional features" that may have provided an inventive concept sufficient for patent eligibility. Rather, the limitations argued by Plaintiff were simply generic terms that do not imply any specific functionality.

The decision provides some additional judicial analysis of the ever uncertain landscape of patent eligibility as it relates to computer technology. Indeed, although these problems and issues have undoubtedly been compounded by the proliferation of computer networks and data, solutions like those articulated and argued in the '087 patent were nonetheless determined to be abstract ideas. And once again, the purpose of the claimed invention seems to be an important factor in determining patent-eligibility.

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