IP Musings with Learned Paw and Percy the Lizard

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Unwired Planet, LLC, v. Google Inc. (November 2016) Unwired Planet appealed a decision by the Patent Trial and Appeal Board ("Board"). The Federal Circuit 3-judge panel agreed with the Board that the claim in dispute was invalid on the ground that a combination of prior art references taught a method that would sometimes generate the output of the claimed method.

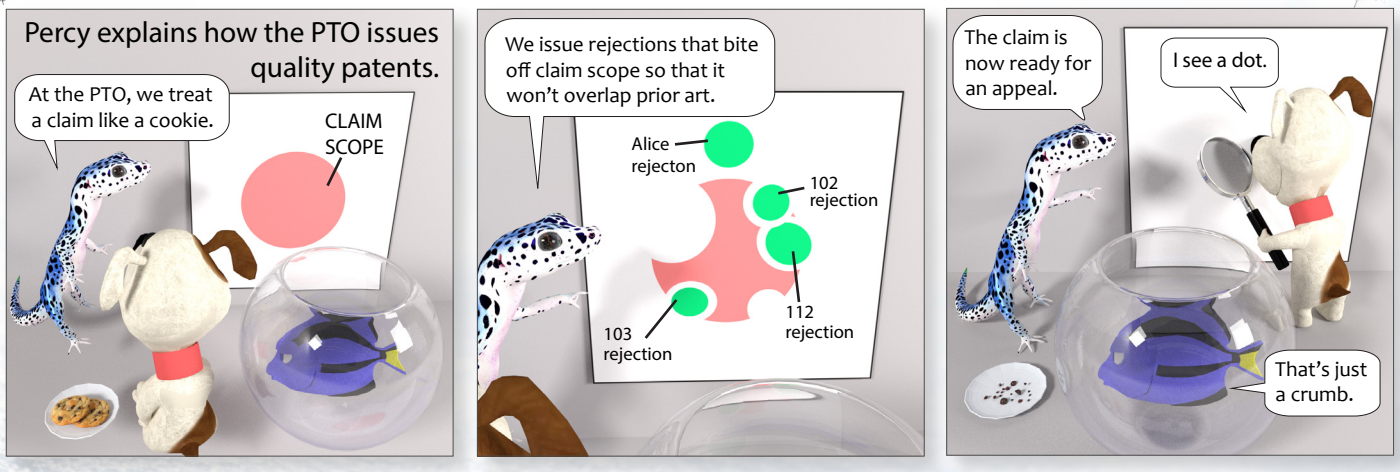
More specifically, the claim in dispute described outputting, on a mobile device, a result of an Internet search for a list of local service providers. In the list, a service provider that is farther away from the mobile device would be ranked higher than the nearer service provider based on user preferences. The Board invalidated the claim, asserting that a combination of prior art references disclosed a method that would alphabetically list local service providers, and the disclosed method would sometimes rank a service provider that is farther away from the mobile device higher than the nearer service provider.

What is troubling about the ruling is the suggestion that a prior art method that sometimes performs the claimed method *per se* renders the claim obvious. For example, a medical treatment procedure "A" that cures sickness in one out of 100 people should not necessarily render unpatentable a treatment procedure "B" that cures the sickness most of the time. Since the allegedly disclosed method and the claimed method are different, a patent challenger should have to make *a separate* showing that procedure B is obvious in view of procedure A to render procedure B unpatentable.

Amdocs (Israel) Limited v. Openet Telecom, Inc. (November 2016) The Federal Circuit ruled in favor of Amdocs, the patentee, in reversing the District court's decision that the claims were not patent eligible under 35 U.S.C. 101. In coming to its conclusion, the majority interpreted the term "enhancement" in the claim language in light of the specifications, and concluded that the claims contained an inventive concept under the *Alice* step two test.

Dissenting from the majority, Judge Reyna argued that some claims properly expressed the inventive concept, while other claims did not. Accordingly, Judge Reyna would reverse the District court's ruling only in part.

This particular case presents a clear progress in terms of 101 patent eligibility case law involving abstract ideas. It is the first Federal Circuit case that highlighted terms of the claims in light of the specifications, in determining whether the claims include an inventive concept.



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