

Enfish, LLC v. Microsoft Corp. (May 2016) The Federal Circuit affirmed the general proposition that claims directed to providing a technological solution to a technological problem are patent eligible. In contrast to *DDR Holdings*, which applied the preceding principle to the second prong of the *Mayo* test, the *Enfish* court applied the principle to the first prong of the *Mayo* test – the court identified an inventive concept in the claims to decide in favor of the patentee and to conclude that the claims were not abstract.

Significantly, the court refused to subscribe to a high-level characterization of the claims as asserted by the defendant. The court wrote, “describing the claims at such a high level of abstraction and untethered from the language of the claims all but ensures that the exceptions to § 101 swallow the rule” (opinion at 14).

It seems that any claim, if simplified by pruning its limitations without any constraints, can be characterized as abstract. The court’s approach may rein in such arbitrariness in applying the first prong of the *Mayo* test.

BASCOM Global Internet Services Inc., v. AT&T Mobility LLC (June 2016) *DDR Holdings, Enfish*, and *BASCOM* are the only recent Federal Circuit cases in which patentees obtained favorable decisions on the issue of 101 patent eligibility for software. Judge Chen reiterated what he articulated in *DDR Holdings* - patent eligibility depends on whether the claims are directed to “an inventive concept.”

The court’s opinion reflected the Background section of the 5,987,606 patent and explained the technical nuances of a problem the claims solved. The explanation gives the impression that the claims are highly technical and, therefore, bear “an inventive concept.”

The defendants appear to have addressed why the claims are directed to a patent-ineligible abstract idea and why the claims do not amount to significantly more. In hindsight, given that the court accepted the plaintiff’s version of the “inventive concept,” the defendants might have fared better had they specifically argued against the plaintiff’s version.

