

Winston Solidifies Concrete Win in Patent Fight over Abstract Idea

MAY 15, 2018

Winston obtained another win for client SAP America on May 15, 2018, when the United States Court of Appeals for the Federal Circuit affirmed—in a precedential opinion—our client’s patent victory in the Northern District of Texas against InvestPic.

In May 2017, a Winston team won a victory for SAP when Judge Kinkeade granted SAP’s motion for judgment on the pleadings, invalidating all claims of the asserted patent as directed to a patent-ineligible abstract concept. Other major companies had tried to invalidate the same patent since 2010. Winston succeeded at the pleadings stage after only a few months of litigation, and on May 15, the win was affirmed by the Federal Circuit.

The Federal Circuit opinion confirmed that despite the recent holdings in the *Berkheimer* and *Aatrix* cases, if the alleged innovation lies entirely in the abstract realm, “with no plausibly alleged innovation in the non-abstract application realm,” the claims cannot survive scrutiny under § 101. As the Court explained, “[w]e may assume that the techniques claimed are “[g]roundbreaking, innovative, or even brilliant,” but that is not enough for eligibility. . . . Nor is it enough for subject-matter eligibility that claimed techniques be novel and nonobvious in light of prior art, passing muster under 35 U.S.C. §§ 102 and 103. . . . The claims here are ineligible because their innovation is an innovation in ineligible subject matter. . . . An advance of that nature is ineligible for patenting.” The Court concluded that “[w]hat is needed is an inventive concept in the non-abstract application realm.”

The Federal Circuit’s ruling confirms that patent ineligibility under section 101 and *Alice* may be determined early in cases at the pleading stage. The Court confirmed that where “there are no factual allegations from which one could plausibly infer that [the non-abstract claim elements] are inventive” then judgment on the pleadings is proper.

The Winston team was led by Kathi Vidal, who argued the appeal, and Tom Melsheimer. Michael Bittner played a key role.

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