Keywords: **35 U.S.C. § 101, patent eligible subject matter**

General: **Courts are not required to provide a single, inflexible rule for the abstract idea inquiry in view of current case law**.

In re Jeffrey A. Killian
United States Court of Appeals for the Federal Circuit
No. 2021-2113
Decided: August 23, 2022

I. Facts

Killian filed a patent application, U.S. Patent Application No. 14/450,042 ("the '042 application"), for systems and methods "for determining eligibility for Social Security Disability Insurance [SSDI] benefits through a computer network." The process outlined in the '042 application entailed looking up information from a state database containing records for patients receiving treatment for certain conditions, and corresponding social security numbers from a Federal Social Security database. For patients identified in the state database as meeting certain criteria, the method claimed in the '042 application used relevant information to determine if a patient is entitled to SSDI, thereby reducing the workload of staff members.

The examiner rejected all pending claims of the '042 application under 35 U.S.C. § 101, finding that they were directed to an abstract idea and lacked additional elements amounting to significantly more than the abstract idea because the additional elements were simply generic recitations of generic computer functionalities. Killian appealed to the Board, which affirmed the examiner's rejection. The Board determined that the two essential steps recited by the claim 1 of the '042 application of "selecting at least one person from the State database…" and "determining whether the person is receiving SSDI adult child benefits…" can be performed in the human mind and are thus "an abstract mental process."

The Board found that the remaining steps of claim 1 of the '042 application were merely directed to data gathering or data output, which do not integrate the processes into a "practical application," and which do not recite an "inventive concept."

Killian appealed this decision.

II. Issue

Did the Board correctly reject the claims of the '042 application as being patent ineligible under 35 U.S.C. § 101?

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III. Discussion

Yes. The Federal Circuit affirmed the Board's decision that the claims of the '042 application are patent-ineligible. The court cited *FairWarning IP, LLC v. Iatric Sys., Inc*. and *Electric Power Group* as precedence for finding claims pertaining to data gathering analysis, and notification on generic computers to be directed to abstract ideas at step one of *Alice/Mayo*.

Killian argued that the standard promulgated in *Alice/Mayo* is indefinite, that is, so poorly defined that it renders all court and Board decisions finding a claim patent ineligible under the Alice/Mayo standard arbitrary and capricious under the Administrative Procedure Act (APA), 5 U.S.C. § 706(2)(A), and the Due Process Clause of the Fifth Amendment. Killian asked the court for a single non-capricious definition or limiting principle to replace the allegedly vague terms "abstract idea" and "inventive concept" used in *Alice/Mayo.*"

The court rejected Killian's argument, stating that the APA 5 U.S.C. § 706(2)(A) does not apply to decisions by courts, as courts are not agencies under that statute. Additionally, the court rejected Killian's argument that finding a claim patent ineligible under the *Alice/Mayo* standard is arbitrary in regards to the Due Process Clause of the Fifth Amendment, stating that the void-for-vagueness doctrine requires establishing vagueness *as applied to the particular case*. The court went on to state that because the claims of the '042 application are clearly ineligible, the '042 application does not present a "close case" under the *Alice/Mayo* standard, thus vagueness cannot be established.

Furthermore, the court rejected Killian's request for a single non-capricious definition or limiting principle to replace the allegedly vague terms "abstract idea" and "inventive concept" used in *Alice/Mayo*, stating there is no single, hard-and-fast rule that automatically outputs an answer in all contexts because there are different types of abstract ideas. The court added that instead of a hard-and-fast definition, the courts have provided guidance as to what constitutes an abstract idea. The court cited *Affinity Labs* as explaining that the "abstract idea" step of the abstract idea inquiry calls upon us to look at the "focus of the claimed advance over the prior art" to determine if the claim's "character as a whole" is directed to excluded subject matter.

The court went on to state that the court has previously explained that claims that simply demand the production of a desired result, without any limitation on how to produce that result, are directed to an abstract idea, as decided in *Interval Licensing*. Additionally, the court stated that in the context of mental processes, such as that claimed by the '042 application, if a claim's steps "can be performed in the human mind, or by a human using a pen and paper," and the elements in the claim do not contain a sufficient inventive concept under *Alice/Mayo* step two, the claim is for a patent-ineligible subject matter, citing *Ericsson Inc. v. TCL Commc'n Tech. Holdings*.

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The court also stated that case law provides guidance as to an "inventive concept", stating that the courts have determined that claims for methods that "improve an existing technological process" include an inventive concept at step two of *Alice/Mayo*, citing *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*.

Killian argued that the search for an "inventive concept" at the second step of the *Alice/Mayo* framework is improper because Congress did away with an "invention" requirement when it enacted the Patent Act of 1952. The court rejected this argument, stating that unlike *Hotchkiss v. Greenwood*, the *Alice/Mayo* precedent has never required, for an inventive concept inquiry, an examination of whether the "degree of skill and ingenuity" expressed in the claimed invention is beyond that possessed by one of ordinary skill in the art.

Finally, Killian argued that "mental steps" has no modern precedence in patent law, asserting that the doctrine regarding "mental steps" was repudiated in *Bilski* and *Diamond v. Diehr*. The court rejected this argument, stating the Supreme Court did not hold in *Diehr*, *Bilski*, or any other case that steps performed in a computer are not 'mental steps' even if the steps performed in the computer are identical to steps that could theoretically be performed by a human mind.

IV. Conclusion

The Board correctly rejected the claims of the '042 application as being patent ineligible. The court is not required to provide a single hard-and-fast definition of the terms "abstract idea" or "inventive concept" due to sufficient precedence regarding each step of the *Alice/Mayo* standard.

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