

Looking back on this case, as with so many others recently, some will certainly decry the decision as a continuation of failed jurisprudence regarding patent eligibility. Others may shrug and note nothing groundbreaking or surprising in the Federal Circuit's decision. Maybe both at the same time. Thankfully, this note is directed not to whether a decision is "good" or "bad", but instead whether the analysis is instructive for our claim drafting moving forward.

The Federal Circuit reviewed this case on appeal from the District of Utah, which granted a motion for dismissal on the pleadings under 35 U.S.C. § 101, finding that the claims at issue in U.S. Patent No. 8,156,468 were directed to no more than an abstract idea.

Taking a cue from the decision, we set aside for now a detailed analysis of the claims, wherein the invention relates generally to a system for developing simulation models using graphical process descriptions. Detailed computer knowledge is however not critical to the take-aways from this case.

Citing to the '468 patent specification, the Federal Circuit noted that object-oriented simulations have existed since the 1960s- but require "programming-based tools" that were very complex in practice. The '468 patent also acknowledged that use of "graphical processes to simplify simulation building has been done since the 1980s and 1990s." Unfortunately (at least in view of the final decision), the '468 patent consistently described the innovation as building new intelligent objects with simply graphical process flows that require no programming from the user- arguably a straightforward combination of these two features.

The Federal Circuit reviewed the lower court's decision in view of the two-part test set out by the Supreme Court in *Mayo Collaborative Services v. Prometheus Laboratories, Inc.* (2012) and *Alice Corp. v. CLS Bank Int'l.* (2014), which we will not discuss in detail here. Briefly, courts must first decide whether the claim is directed to a judicial exclusion such as an abstract idea and, if so, must then decide whether the claim includes "significantly more" such that an "inventive concept" is present and the abstract idea is integrated into a "practical application" thereof.

In the first part of the test, the Federal Circuit determined that the claims are directed to an "abstract idea" of "simply applying the already-widespread practice of using graphics instead of programming to the environment of *object-oriented* simulations" The Court cited to *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1094 (Fed. Cir. 2016), noting that claims may be characterized as directed to an abstract idea if, among other things, they "merely implement[ed] an old practice in a new environment."

Simio protested that non-abstract improvements were made to computer-implemented

simulation and further to the computer functionality itself. But the Court was having none of it- ruling that improvements to user experience are not analogous to improvements in computer functionality. In other words, the Federal Circuit appears to be willing to consider software as eligible for patent if it improves a computer's speed or efficiency, but generally not when the "improved" computer system is merely established as improving the user's speed or efficiency.

Regarding the second part of the test, Simio presented arguments primarily based on the final limitation in the claim, but ultimately conceded that the recited feature was conventional in object-oriented programming and resorted to arguing the novelty of the claimed combination with graphics in a simulation. This argument found no traction with the Court, as being "just the abstract idea itself, which cannot supply the inventive concept that renders the invention significantly more than that abstract idea at step two."

Of critical importance to this decision, the Federal Circuit relied on the focus of the claimed advance being consistently described as the abstract idea itself. In other words, the '468 patent was characterized as lacking non-conventional functionality, instead relying on a novel combination of object-oriented simulation and graphical process flows, i.e., the abstract idea itself.

Did the Federal Circuit, without describing the issue as such, take exception with Simio's failure to identify a technical solution to a technical problem or otherwise non-conventional aspects of the solution offered? Did the Federal Circuit ignore or at least skim over details in the actual claim language? Arguably, yes on both counts.

The Federal Circuit has often admonished patent owners for presenting claims that were directed to a function or purpose (a "what" or solution of itself), without reciting or even disclosing a means for achieving such a function ("how" the invention provides the solution), but this decision gives no apparent consideration to any claim language that relates to "how" the alleged abstract idea is implemented.

Where does this leave us?

Simio's patent was deemed ineligible even though the claimed combination was arguably novel, seemingly on the basis that the combined features themselves were independently conventional. Was Simio's fault in describing the invention inappropriately, i.e., as an advantageous combination of known elements rather than as a technical achievement in making the combination itself? Probably- but is it a fool's errand to read too much into these decisions and futilely try adjusting our kicks to moving goalposts? Setting aside whether such requirements are appropriate, we shall continue to be prudent and draft patent applications to harmonize with the judicial decisions- limiting our descriptions of an invention to technical solutions for problems in

the prior art, and further reciting the technical solutions with specificity in at least some claims.