PATENTLYO
The nation's leading patent law blog

Patent Law Blog (Patently-O)
Patent Law Analysis by Professors Dennis Crouch and Jason Rantanen

Jun 25, 2013

Did the Federal Circuit Just Adopt Functional Claiming Through the Back Door?

Guest Post by Mark Lemley. Professor Lemley is the William H. Neukom Professor at Stanford Law School and a founding partner of the successful law firm of Durie Tangri where he litigates intellectual property cases.

In *Ultramercial v. Hulu*, decided on Friday, the Federal Circuit held that a series of steps for serving ads to customers over the Internet, phrased at a high level of abstraction, was patent-eligible subject matter under section 101. Chief Judge Rader wrote the opinion, which Judge O'Malley joined. Perhaps more surprising, Judge Lourie, who wrote the plurality opinion in CLS Bank, found the requirements of that test satisfied by these claims despite the lack of evident tie to any particular hardware device or limitation to any particular software algorithm.

Part of the explanation for the result in Ultramercial stems from the procedural posture of the case. The district court had granted a motion to dismiss, reasoning that patentable subject matter is a pure question of law and so not dependent on factual conclusions. The district court's position was defensible, given that every prior Federal Circuit opinion has called patentable subject matter a pure question of law. But the majority goes out of its way to suggest that factual questions are likely to predominate in a section 101 inquiry, though the court is a bit vague on just what those factual disputes might be. The court also suggests that claim construction will normally be required before resolving a 101 issue, but that here, the court was opting to construe the patent in the way most favorable to the patentee (that is, in the narrowest way possible) to evaluate 101 on a motion to dismiss. Curiously, however, the court never explicitly tells us what that narrow construction is.

Then the majority does something very odd: it proceeds to discuss in great detail the technology disclosed in the specification but not mentioned in the claims. The court clearly viewed Ultramercial's claims as patent-eligible because the specification contained detailed technical implementations and a complex flow-chart, even though none of those were included as limitations in the claim.

What is going on here? One possibility is that three of the most experienced patent judges in the country have forgotten the single most fundamental rule of patent law -- that as Judge Rich put it, the name of the game is the claim. But I doubt it. If a lawyer arguing before the court tried to read in limitations from the specification in claim construction or for infringement or validity, these judges would (quite properly) tear that lawyer apart for violating this fundamental rule and ignoring the language of the claim. It seems unlikely that each of them simply forgot that it is the claims that define the invention.

A second possibility is that the court thinks that the rule that the claims define the invention simply doesn't apply to patentable subject matter: that as long as you have a specific idea somewhere in your specification we don't care what you claim. But that seems equally unlikely. To begin, it directly contradicts controlling Supreme Court precedent such as *O'Reilly v. Morse*, where the court held narrow claims patent-eligible but a broader claim ineligible. Beyond that, it simply makes no sense. The patentable subject matter rule is against patenting abstract ideas. A claim that covers only an abstract idea doesn't somehow become less abstract simply because the patentee could have claimed a narrower, more tangible invention.

There is a third possibility: that the court is implicitly construing the broad, functional elements of Ultramercial's method claim as

means-plus-function claims under section 112(f), with the result that they are accordingly limited to the particular implementations in the specification. Doing so would be consistent with approach I suggested in my article "Software Patents and the Return of Functional Claiming". It would explain why the court said it was adopting the narrowest construction of Ultramercial's claims but then never told us what that narrow construction was. And it is the only reasonable explanation for why the Federal Circuit would suddenly drop its focus on the language of the claims and start to talk about whether the algorithms in the specification were patent-eligible subject matter.

The court didn't explicitly say what it was doing. I hope that its focus on the specification signals a narrowing construction that saved the claim from ineligibility. That would be a major step forward for both patentable subject matter law and for reining in overbroad software patents. And the alternative -- that the court has decided that the scope of the claim doesn't matter anymore -- would represent a major step backward.

Posted on Jun 25, 2013 at 08:45 PM | Permalink
Digg This | Save to del.icio.us

Comments

Goldplatedpatents said...
You might want to take a closer read of Research Corp.

Reply Jun 25, 2013 at 09:17 PM
NWPA said in reply to Goldplatedpatents...
Comment has been removed by moderator.

Jun 25, 2013 at 09:51 PM
NWPA said in reply to NWPA...
Comment has been removed by moderator.

Jun 25, 2013 at 09:56 PM
AAA JJ said in reply to NWPA...
"...how do you resolve the inherent conflict of making money at law firm with your position as a 'professor?'"

What is this inherent conflict?

Reply Jun 26, 2013 at 07:56 AM
LB said in reply to AAA JJ...
^ What he said.

Reply Jun 26, 2013 at 08:07 AM
NWPA said in reply to LB...
I am surprised LB that you don't see this. One academic on here said regarding claiming that software has no structure "but, that's what you want." The academics that are attacking patent law seem to have no integrity or sense of responsibility to represent the facts or law in a fair light.

That is not a work of an academic.

Reply Jun 26, 2013 at 08:13 AM
anon said in reply to LB...
The conflict is obvious: which master do you service first: the Left or the Right?

Sure, they are in bed for the destruction of the patent system, but what then?

When the Left wakes up and realizes that they have been whored by the Right, which side does Mark zealously represent?

Reply Jun 26, 2013 at 08:15 AM
MM said in reply to anon...
Trollboy: *which master do you service first: the Left or the Right?*

This is the question Trollboy asks himself every day before deciding which hand to wank with.

Reply Jun 26, 2013 at 09:54 AM
anon said in reply to MM...
LOL - another vacuous (and accuse-others-of-that-which-he-does) post by Malcolm.

Attaboy.

Reply Jun 26, 2013 at 10:00 AM
NWPA said in reply to AAA JJ...
The conflict between academic integrity vs. advocating for your clients positions. I think what we see in Lemley is a person that has abandoned academic integrity for advocating for his clients (and his positions.)

How AAA JJ, do you explain an academic that knowingly makes false statements in journal articles? His "journal" articles, in fact, read very much like briefs.

Reply Jun 26, 2013 at 08:10 AM
AAA JJ said in reply to NWPA...
"How AAA JJ, do you explain an academic that knowingly makes false statements in journal articles?"

I've asked you numerous times to point out these "false statements" but you never do.

If Lemley makes a statement about what he believes the law to be, or ought to be, that is not a "false statement" simply because you disagree with it. It is a difference of opinion.

As for whether "software has no structure" is a false statement, a lot of people think that. I don't. There's a reason that "state machine" is (or maybe was) a term of art. But I don't think that any and everybody who disagrees with me on that lacks integrity. They just disagree with me.

Reply Jun 26, 2013 at 08:44 AM
NWPA said in reply to AAA JJ...
AAA JJ: a false statement is one like "software has no structure" where Lemley does not discuss journal articles by some of the best academics in the field saying it does. I posted a link to that article of his. In fact at the time of his article there were other articles that clearly discussed the structure of software (including Ginsburg from NYU).

Whether software has structure is not a subjective opinion you can form or not. There is science behind it. There are academics in law and scientific journals. One cannot simply take a position counter to law articles and science (and not even reference them.) That is an academic integrity violation. And, to be clear, Lemley knows the implications of what it would mean not to have structure. We see it here in this post of his. If the method conveys no structure then it is functional claiming and if a computer configured conveys no structure then it is also functional claiming.

Look! This is not some minor issue that he happened to step off the path on. The structure issue is huge and academics understand the implications. I took a PLI course about 5 years ago where a professor at NH law school even discussed this very issue.

Lemley knowingly made false statements to get a result. That is a rule 11 violation and it is an academic integrity violation. I am not why you see this as gray. It could not be more black and white.

Reply Jun 26, 2013 at 08:54 AM
NWPA said in reply to NWPA...
And really! Think about it. He knows exactly the implications of this assertion of his. Exactly. Everyone that understands patent law does. And yet he makes these claims on his own that are not supported by science or law.

And, you act as if it is some kind of subjective opinion that he is entitled to. It is a devious man that knows exactly where to press to get the result he wants. That by the way is a good description of Stern as well the architect behind Benson.

Reply Jun 26, 2013 at 09:00 AM
6 said in reply to NWPA...
" In fact at the time of his article there were other articles that clearly discussed the structure of software (including Ginsburg from NYU)."

Well why not repeat it here or post a link? Is it behind a paylolwall?

Reply Jun 26, 2013 at 11:05 AM
6 said in reply to NWPA...
"Whether software has structure is not a subjective opinion you can form or not. There is science behind it."

The meaning of the word "structure" may be simply be being used in different ways mah brosef. Which is literally the root of the conflict. Some people, ta rds like yourself, started misusing the word to describe magical things which exist outside the spec of your patent apps, or, in the alternative, "algorithms". The word was never meant to be used in that fashion in the field of patents. It's that simple. Your bad. Just say "my bad" and we'll forgive ya bro.

Reply Jun 26, 2013 at 11:08 AM
anon said in reply to AAA JJ...
AAA JJ,

It is a false statement to say that the claims at issue were "*A claim that covers only an abstract idea.*"

Let's *not* pretend that a 'clever 1ie' is not a 1ie because of the way it is couched.

Reply Jun 26, 2013 at 08:59 AM
MM said in reply to anon...
Trollboy: *It is a false statement to say that the claims at issue were "A claim that covers only an abstract idea."*

It's equally "false" to say that isolated nucleic acids are "products of nature." Not really the end of the world, though, in the context of an ongoing conversation. I'd put statements like this more in the realm of "conclusory". Lemley's statement sounds like what he believes is the correct holding.

Reply Jun 26, 2013 at 10:02 AM
anon said in reply to MM...
"*It's equally 'false' to say that isolated nucleic acids are 'products of nature.'*"

Your statement is clearly not supportable Malcolm.

Come back to this world soon.

Reply Jun 26, 2013 at 10:12 AM
MM said in reply to anon...
Your statement is clearly not supportable

You're clearly wrong, Trollboy. And also you're clearly a ly ing skumbag. You just proved that to everyone here. Again.

Reply Jun 26, 2013 at 11:30 AM
anon said in reply to MM...
Again with the accuse-others-of-what-you-do rhetoric Malcolm.

What is the 1ie?

You do realize that everytime without fail you accuse me of this and I have asked for you to provide a valid example that you have FAILED?

This is all archived.

Put.
The.
Shovel.
Down.

Reply Jun 26, 2013 at 11:33 AM
MM said in reply to anon…
Trollboy: *It is a false statement to say that the claims at issue were "A claim that covers only an abstract idea."*

Except that Lemley never said that. Lemley said this:

A claim that covers only an abstract idea doesn't somehow become less abstract simply because the patentee could have claimed a narrower, more tangible invention.

which is surely true. Man, Trollboy, you're even skummier today than usual. P.U.

Reply Jun 26, 2013 at 11:17 AM
anon said in reply to MM…
You quite miss the deception Malcolm.

See the post at 8:59 AM for an explanation why.

Reply Jun 26, 2013 at 11:30 AM
MM said in reply to anon…
Trollboy: *You quite miss*

You "quite" enjoy digging yourself into a deeper hole, Trollboy. Please continue demonstrating to everyone the depth of your skummy skumbagginess.

See the post at 8:59 AM

LOL.

Reply Jun 26, 2013 at 11:33 AM
anon said in reply to MM…
"*enjoy digging yourself*"

LOL - continue to use that accuse-others-of-what-you-do tool, my friend.

Reply Jun 26, 2013 at 11:36 AM
anon said in reply to MM…
"*you're even skummier today than usual*"

Since you are clearly engaged in the opposite-of-reality Malcolm 'dialogue' mode, this is a great compliment.

Thank you.

Reply Jun 26, 2013 at 11:35 AM
D. C. Toedt said in reply to NWPA…
NWPA says: *And, Lemley, you have position on me, but not knowledge, intelligence, or integrity. You have position and time or your arguments and reputation would be toast.*

NWPA, why don't we defer the question of comparative knowledge and intelligence until your writings have been cited by the Supreme Court as often as Mark Lemley's writings have been in recent years.

(Your comments about integrity aren't worth dignifying with a response.)

Reply Jun 26, 2013 at 10:13 AM
EG said in reply to D. C. Toedt…
Citation by SCOTUS (9 technologically-challenged and patent law-ignorant Justices) is hardly a "stamp of approval," especially by the patent bar.

Reply Jun 26, 2013 at 10:30 AM
NWPA said in reply to D. C. Toedt…
Not worth dignifying? You mean calling out someone as a liar and having committed an academic integrity violation with a specific example is not worth dignifying?

I think you mean that you have no respect for integrity.

Reply Jun 26, 2013 at 10:44 AM
anon said in reply to D. C. Toedt…
Being quoted by the Court that is royaly messing up patent law (101) is NOT an indicator of comparative knowledge and intelligence. Go ask Alice.

That you would make such a mistake is an indicator - but not in the direction you might think.

On the other hand… you have a great website!

Reply Jun 26, 2013 at 10:51 AM
NWPA said in reply to Goldplatedpatents…
No is the answer to your question. The Federal Circuit properly construed the claims.

Reply Jun 26, 2013 at 04:49 AM

NWPA said...
Comment has been removed by moderator.

Jun 25, 2013 at 09:36 PM
NWPA said in reply to NWPA...
So, Lemley, do you really think that anyone in patent law doesn't know that you wrote that column to provoke? We all are very aware of 112, 6 and what it takes and means to be put in that bucket. Clearly they were not in this opinion.

Reply Jun 25, 2013 at 09:38 PM
NWPA said in reply to NWPA...
I have to give it to you, though. I guess having Stanford at your back gives one a lot of nerve.

Reply Jun 25, 2013 at 09:40 PM
NWPA said in reply to NWPA...
So, according to you (Lemley) computer programs have no structure. That is wrong. And, so it is not surprising that you would incorrectly think that a recitation of an information processing machine would convey no structure. Under your reasoning a circuit has no structure.

So, Lemley, tell us how computer programs have no structure. And, given this gross intentional misrepresentation why should we trust anything you write?

Reply Jun 25, 2013 at 09:49 PM
6 said...
"reasoning that patentable subject matter is a pure question of law and so not dependent on factual conclusions"

Correctly reasoning I think you mean.

And I only just now, a day ago had it pointed out to me that Rader has now back-doored in some factual inquiries into the legal question of law all patent legal questions of law. It's preposterous, so much so that I had skipped over much of his blabbering in those sections as being merely more stuff I'd likely eventually disagree with but weren't the real holding.

Turns out, the Federal Circuit is 100% completely off their rocker, flip ped their sht so to speak. Apparently now 101 is a mixed question of fact and lawl, or at least a question of lawl predicated on a bunch of factual findings. I must humbly disagree, as others have already brought up this possibility and I disagreed with it then. I could go on and on as to why, but I'll wait until anon, true to form, trolls me into telling him.

Reply Jun 25, 2013 at 09:40 PM
anon said in reply to 6...
LOL - still waiting for you NOT to be chickensht and deliver what you said you would on the other thread.

And son, that is not 'tr011ing' you.

The word you are looking for: accountability

Reply Jun 25, 2013 at 09:49 PM
Candi Kayne said...
Comment has been removed by moderator.

Jun 25, 2013 at 09:45 PM
NWPA said in reply to Candi Kayne...
For someone with no morals.

Reply Jun 25, 2013 at 09:50 PM
6 said...
"But the majority goes out of its way to suggest that factual questions are likely to predominate in a section 101 inquiry, though the court is a bit vague on just what those factual disputes might be. "

Obviously, because there are none, and the questions he does attempt to shoe horn into being factual inquiries are far from it.

" Curiously, however, the court never explicitly tells us what that narrow construction is. "

Because there is no such construction. Which is, as far as I've been made aware, why the DC didn't write it down in the first place.

"Then the majority does something very odd"

Then? Then? After all that odd sht it just did that you pointed out you say "then"?

"it proceeds to discuss in great detail the technology disclosed in the specification but not mentioned in the claims. The court clearly viewed Ultramercial's claims as patent-eligible because the specification contained detailed technical implementations and a complex flow-chart, even though none of those were included as limitations in the claim. "

I know where you're going with this, but I disagree already before you even say it. No, they didn't adopt your pet suggestion, they're just went plain bonkers.

"It seems unlikely that each of them simply forgot that it is the claims that define the invention. "

Actually, the suggestion that perhaps they simply forgot the lawl is the most generous suggestion anyone could possibly make regarding this "decision".

"The court didn't explicitly say what it was doing."

And it just so happens that doing that is what certain types of crazy people do.

In any event, after I got done reading this decision all the way through my jaw literally nearly hit the floor at how amateurish the whole came across as. It seemed to me to be deliberately so, in order perhaps to provoke the supremes into making themselves even more clear that the law is the law just as they've said it is for the last 100 years. And I guess I can support that.

Reply Jun 25, 2013 at 09:49 PM
6 said in reply to 6...
I should add, that I hope that the USSC resolves this case by a simple one page opinion stating the abstract idea preempt and that the Federal Circuit needs to get off of its pato ot and with the program.

Reply Jun 25, 2013 at 10:01 PM
anon said in reply to 6...
" *stating the abstract idea preempt* "

Still waiting for you 6. What is the abstract idea that you think is here? Where on the ladder do you think you are? Why does it matter if there are abstraction rungs above the one claimed?

Reply Jun 25, 2013 at 10:28 PM
MM said in reply to 6...
Lemley: *"it proceeds to discuss in great detail the technology disclosed in the specification but not mentioned in the claims."*

That's how the game is played by the proponents of these kinds of patents. Somehow these "inventions" are all very "complex" and "technical", in spite of the fact that they were surely dreamed up in five seconds. Did you notice Rader's hilarious use of the "flow chart" figure? Very impressive. Also irrelevant.

Reply Jun 26, 2013 at 11:06 AM
6 said in reply to MM...
"That's how the game is played by the proponents of these kinds of patents. Somehow these "inventions" are all very "complex" and "technical", in spite of the fact that they were surely dreamed up in five seconds. Did you notice Rader's hilarious use of the "flow chart" figure? Very impressive. Also irrelevant.
"

Mhmmm, I know, and yes, I noticed.

Reply Jun 26, 2013 at 11:12 AM
anon said...
One serious bucket of chum and straw. Thankfully, I read this on an empty stomach.

Reply Jun 25, 2013 at 09:59 PM
NWPA said in reply to anon...
Quite right, anon. I wonder if Lemley will have the guts to engage us. Probably not. The academics tend to rely on their perch for safety.

Reply Jun 25, 2013 at 10:06 PM
Candi Kayne said in reply to anon...
Ewwww, even I think that's gross.

Reply Jun 25, 2013 at 10:18 PM
EG said in reply to anon...
Thoroughly agree, anon. What Lemley does is look for the devious instead of the obvious: a computer-implemented method, i.e., via the Internet. There is no "functional claiming through the back door" either. This is a method, how else do you claim it other than by the "steps" carried out by it? My disdain for Lemley's thinking continues to grow.

Reply Jun 26, 2013 at 07:37 AM
anon said in reply to EG...
He does not look for the devious, EG, he employs the devious.

In essence, he offers the following 'logic':
Ridiculous strawman 1,
Ridiculous strawman 2,
An **implicit** adoption of my latest pet theory - because nothing else can possibly make sense given that Mark has *assumed* that the claims are merely an abstract idea in clear violation of the law.

Complete fallacy from top to bottom.

NWPA, I would beg to differ: this most assuredly does NOT read like a brief, as a brief would be governed by Rule 11 and this piece of obvious claptrap would earn a very quick slap down under that Rule. I do not see any part of (b) that is not violated here.

Reply Jun 26, 2013 at 08:26 AM
AAA JJ said in reply to EG...
"There is no 'functional claiming through the back door' either. This is a method, how else do you claim it other than by the 'steps' carried out by it?"

This is, of course, 100% correct. Lemley is completely out in the weeds on this one.

Reply Jun 26, 2013 at 08:46 AM
anon said in reply to AAA JJ...
AAA JJ,

What you are not acknowledging is that Lemley is very much aware that he is standing completely in the weeds, that he has no colorful argument (570nm notwithstanding) for a "nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law," and that he is merely spewing propaganda with his fallacious presentation. He has stepped well beyond presenting an idea for a different law system.

Taken as a whole, I would most definitely sanction him if this was presented in my courtroom.

Reply Jun 26, 2013 at 09:05 AM
MM said in reply to AAA JJ...

"There is no 'functional claiming through the back door' either. This is a method, how else do you claim it other than by the 'steps' carried out by it?"

You recite in the claim all of the "complex programming" that makes this alleged "invention" patentable, instead of simply waving your hands in the air about what the magical functions of the allegedly "new" computer.

Reply Jun 26, 2013 at 11:00 AM
anon said in reply to MM…
You recite in the claim the structural limitation of "programmed to."

You know - just like you voluntarily admitted.

LOL - strike that match, get the marshmallows ready.

Reply Jun 26, 2013 at 11:16 AM
MM said in reply to anon…
Trollboy: *just like you voluntarily admitted.*

Right, just like you voluntarily admitted that your parole officer caught you again in the stairwell of the elementary school, dressed in a bathrobe. Thanks for the voluntary admission. When you stop beating your wife, you should let her know about your admission, too.

Reply Jun 26, 2013 at 11:28 AM
anon said in reply to MM…
Another vacuous comment from Malcolm.

Attaboy.

I LOVE the fact that you cannot deny the admissions that you have made.

The archive feature is wonderful. But maybe if you ***beg*** Prof. Crouch again, all the past posts will be wiped out and you can engage in blatant 1ying without the risk of me posting your own words and rubbing your nose in your own CRP - again (and again, and again, and again…).

Reply Jun 26, 2013 at 11:39 AM
MM said in reply to anon…
Trollboy: *if you beg Prof. Crouch again, all the past posts will be wiped out*

I never begged Prof. Crouch to wipe out any past posts.

You really are a deluded, ly ing skumbag. Keep it up.

Reply Jun 26, 2013 at 12:20 PM
anon said in reply to MM…
You *implicitly* **begged** him to do that when one of your smarmy replies hinted that the archives might 'disappear,' and I replied that I had made copies already.

You then let loose an improper Jane Fonda reference and I noted that such from the acclaimed 'master' of English of a first language was pretty pitiful.

This too, is archived.

Again with the accusation of 1ying. Let's see you give ONE valid example, Malcolm. Like last time, you will (can) only run away.

Your accusations are themselves blatant 1ies.

Funny, how *those* blatant 1ies are not expunged.

C'est La Vie

Reply Jun 26, 2013 at 01:18 PM
MM said in reply to anon…
Trollboy: *You implicitly begged him*

You are a truly disturbed freek, Trollboy. Get help.

Reply Jun 26, 2013 at 01:58 PM
anon said in reply to MM…
LOL - having WAY too much fun at your expense Malcolm.

But hey, I've told you how you get improve things…

Reply Jun 26, 2013 at 02:16 PM
AAA JJ said in reply to MM…
"You recite in the claim all of the 'complex programming' that makes this alleged 'invention' patentable, instead of simply waving your hands in the air about what the magical functions of the allegedly 'new' computer."

It's a method claim. You're not required to "claim all of the 'complex programming'" in a method claim. It's a method. Methods are defined by acts or steps to be taken, not by "complex programming."

It's a method claim.

Reply Jun 26, 2013 at 12:20 PM
anon said in reply to AAA JJ…
AAA JJ,

you made a comment the other day about 6…

(but hey, I have no problem with you bagging on Malcolm - I like to share, and there is plenty to go around)

Reply Jun 26, 2013 at 01:21 PM
MM said in reply to AAA JJ...
You're not required to "claim all of the 'complex programming'" in a method claim. "

Uh ... sure. You can draft any claim you want. But if you want an eligible and patentable claim, maybe it's a good idea to distinguish it from the prior art and make sure it isn't just an ineligible abstraction with the term "computer" and some equally conventional hoohaw salted in.

Here's a claim:

1. A method for generating revenue, comprising requiring a recipient of information from a computer to sit through an advertisement before receiving said information.

I don't see any meaningful difference between this claim and Ultramercial's junk. Do you? What are the meaningful differences?

Reply Jun 26, 2013 at 01:57 PM
AAA JJ said in reply to MM...
"...and make sure it isn't just an ineligible abstraction..."

As long as the test for determinig that a claim is "just an ineligible abstraction" is "we know an ineligible abstraction when we see one" then I can't see any "meaningful difference" between the claim at issue and the claim you drafted. That's not to say, however, that I agree that the claim at issue is an "ineligible abstraction."

Reply Jun 26, 2013 at 02:16 PM
MM said in reply to AAA JJ...
That's not to say, however, that I agree that the claim at issue is an "ineligible abstraction."

Ok. Would you agree that the claim is j--k, or is it too complicated for you to do the analysis?

Reply Jun 26, 2013 at 03:48 PM
AAA JJ said in reply to MM...
"...is it too complicated for you to do the analysis?"

What is the analysis that needs to be done? As I said before, the analysis is, essentially, "We know an abstract idea when we see one."

I'm as capable of doing that analysis as you, and as capable as any of the nine. And as capable as, for example Ned, who stated that a claim discussed a couple weeks ago was "nothing more than using an internal combustion engine in running a business." When all you have to do is paraphrase the claim and declare it an abstract idea, does it really qualify as "analysis"?

Reply Jun 27, 2013 at 08:33 AM
anon said in reply to AAA JJ...
"*When all you have to do is paraphrase the claim and declare it an abstract idea, does it really qualify as "analysis"?*"

I think 6 has a patent pending on that type of analysis.

Reply Jun 27, 2013 at 09:36 AM
MM said in reply to AAA JJ...
AAA JJ *"...is it too complicated for you to do the analysis?"*

What is the analysis that needs to be done?

You don't know how to analyze a claim under 103 either?

Reply Jun 27, 2013 at 12:07 PM
anon said in reply to MM...
LOL - Malcolm, is that an answer?

Are you always such a douche?

Reply Jun 27, 2013 at 12:10 PM
AAA JJ said in reply to MM...
"You don't know how to analyze a claim under 103 either?"

That's pretty funny coming from Mr. "It's not patentable under 101 because it's so obvious!!!"

I'm very familiar with the analysis required by 103.

If you're telling me that you know what analysis is required to determine whether a claim is nothing more than an abstract idea, then you're full of shite. You don't know, I don't know, and the judges who write the decisions don't know.

Reply Jun 27, 2013 at 12:24 PM
anon said in reply to AAA JJ...
" *Mr. "It's not patentable under 101 because it's so obvious!!!"*

LOL - Malcolm and his WHATEVER, all the law runs together.

Reply Jun 27, 2013 at 02:33 PM
anon said in reply to MM...
Such a pretty strawman.

Did you actually want to make a point? You seem to agree with AAA JJ, and then drift off into a frolic.

Reply Jun 26, 2013 at 02:18 PM

NWPA said…
>To begin, it directly contradicts controlling Supreme Court >precedent such as O'Reilly v. Morse, where the court held >narrow claims patent-eligible but a broader claim ineligible.

You really are shameless. Is that the holding in Morse? That narrow claims are eligible and broad claims are not. Shameless amoral devil.

Reply Jun 25, 2013 at 10:19 PM
NWPA said in reply to NWPA…
The worse breed of human there is. A litigator pretending to be an academic.

Reply Jun 25, 2013 at 10:20 PM
anon said in reply to NWPA…
Attacks from BOTH the Left and the Right.

Reply Jun 26, 2013 at 08:10 AM
anon said…
It looks like to Lemley, all ladders have only one rung.

Apply this philosophy across the board…

Reply Jun 25, 2013 at 10:24 PM
Candi Kayne said in reply to anon…
I don't get it? ^_^

Reply Jun 25, 2013 at 10:56 PM
anon said in reply to Candi Kayne…
Then pay better attention McCracken

Reply Jun 26, 2013 at 07:04 AM
101 Integration Expert said…
"…because the specification contained detailed technical implementations and a complex flow-chart, even though none of those were included as limitations in the claim. What is going on here?"

Correct me if I am wrong Professor Lemley but isn't the court supposed to read the claims in light of the specification and as the claims would be interpreted by a person of ordinary skill in the art?

Reply Jun 26, 2013 at 05:06 AM
NWPA said in reply to 101 Integration Expert…
Lemley's proposition is that information processing claims convey no structure to one of ordinary skill in the art. And, that computer programs have no structure. That is Lemley's contention despite the fact that he knows that is not true.

Reply Jun 26, 2013 at 05:20 AM
101 Integration Expert said…
"….the Federal Circuit held that a series of steps for serving ads to customers over the Internet, phrased at a high level of abstraction, was patent-eligible subject matter under section 101."

Professor Lemley, what exactly is this level of abstraction? Do you have a scale of some sorts? And if so what would be the next level of abstraction after Ultramecial's claims, as well as the level proceeding the claims, and how would both of those claims be recited at those specific levels?

Reply Jun 26, 2013 at 05:18 AM
anon said in reply to 101 Integration Expert…
"*phrased at a high level of abstraction*"

This "article" is loaded with such pretentious nonsense.

If this were 'journalism,' the wavelength would be about 570 nm.

Reply Jun 26, 2013 at 07:07 AM
Les said in reply to anon…
hehehe…. I got that…

Reply Jun 26, 2013 at 08:13 AM
6 said in reply to 101 Integration Expert…
"Professor Lemley, what exactly is this level of abstraction?"

I think he said it was a "high" one.

Reply Jun 26, 2013 at 02:10 PM
anon said in reply to 6…
Wow 6 - so very helpful.

Reminds me, still waiting for what you said that you would provide.

Reply Jun 26, 2013 at 02:19 PM
anon said…
"*Beyond that, it simply makes no sense. The patentable subject matter rule is against patenting abstract ideas.* **A claim that covers only an abstract idea** *doesn't somehow become less abstract simply because the patentee could have claimed a narrower, more tangible invention*."

Way to use both a strawman AND to assume the conclusion that you want.

One small problem, Mark: the claim in question isn't one that merely "covers only an abstract idea."

Otherwise, a real piece of CRP propaganda from you. And that's being generous.

Reply Jun 26, 2013 at 07:19 AM
NWPA said in reply to anon…
It is unbelievable that Stanford professors don't force him to resign for academic integrity violations.

He is knowingly making false statements in papers published in journal articles published by Stanford.

He should be forced to resign.

Reply Jun 26, 2013 at 07:22 AM
Les said in reply to anon…
Ahmen

Reply Jun 26, 2013 at 08:07 AM
NWPA said…
You know the arguments we have here at patentlyo are really examples of the same type of arguments that are going on in the greater society.

The Lemleys of the world are winning right now. Bill Moyers had a special regarding this topic about 10 years ago. How people like Lemley can make statements that are clearly wrong and not be held accountable for them. I think we should all try to find a way to hold Lemley accountable.

He has knowingly made false statements in journal articles. In the good old days that meant you spent the rest of your life as a carpenter.

Reply Jun 26, 2013 at 07:29 AM
Fish scales said in reply to NWPA…
Yes, they are winning because they conflate 101 and 103 and because they mischaracterize a decision by saying that a judicial body found an abstract idea to be patentable without even mentioning all of the details and limitations in the claim.

Reply Jun 26, 2013 at 12:43 PM
MM said in reply to Fish scales…
Fish Scales *they conflate 101 and 103*

You wish, Fishy.

We are "winning" because the game being played by the computer-implemented junketeers is getting really old.

On one hand, they want to pretend that the recitation of any old eligible subject matter is sufficient to make a claim eligible (it's not -- read Prometheus). On the other hand, they (along with no small number of incompetent goons at the USPTO) also want otherwise ineligible subject matter to be considered under 103. It's a nice trick. Or, more accurately, it was a nice trick.

all of the details and limitations in the claim.

LOL. Yes, this claim is really detailed and chock full of "meaningful" limitations!

Reply Jun 26, 2013 at 12:58 PM
Les said…
Please define "high level of abstraction", 'cause it doesn't look abstract to me. Are you confusing "abstract" with "broad"? In patent law professor, "too broad" is measured by comparison to the prior art: 35 USC 102 and 103.

In what sense is this abstract?

1. A method for distribution of products over the Internet via a facilitator, said method comprising the steps of:

a first step of receiving, from a content provider, media products that are covered by intellectual-property rights protection and are available for purchase, wherein each said media product being comprised of at least one of text data, music data, and video data;

a second step of selecting a sponsor message to be associated with the media product, said sponsor message being selected from a plurality of sponsor messages, said second step including accessing an activity log to verify that the total number of times which the sponsor message has been previously presented is less than the number of transaction cycles contracted by the sponsor of the sponsor message;

a third step of providing the media product for sale at an Internet website;

a fourth step of restricting general public access to said media product;

a fifth step of offering to a consumer access to the media product without charge to the consumer on the precondition that the consumer views the sponsor message;

a sixth step of receiving from the consumer a request to view the sponsor message, wherein the consumer submits said request in response to being offered access to the media product;
a seventh step of, in response to receiving the request from the consumer, facilitating the display of a sponsor message to the consumer;

an eighth step of, if the sponsor message is not an interactive message, allowing said consumer access to said media product after said step of facilitating the display of said sponsor message;

a ninth step of, if the sponsor message is an interactive message, presenting at least one query to the consumer and allowing said consumer access to said media product after receiving a response to said at least one query;

a tenth step of recording the transaction event to the activity log, said tenth step including updating the total number of times the sponsor message has been presented; and
an eleventh step of receiving payment from the sponsor of the sponsor message displayed.

Reply Jun 26, 2013 at 07:57 AM

Fish scales said in reply to Les…
Good comment, Les. That claim is NOT abstract.

Reply Jun 26, 2013 at 10:09 AM
Fish scales said in reply to Fish scales…
however, monetizing and distributing copyrighted products over the Internet is an abstract idea, as is using advertising as currency. But that is not the invention of claim 1 with its ten specific steps and its specific reference to an Internet website.

Reply Jun 26, 2013 at 01:14 PM
MM said in reply to Les…
In patent law professor, "too broad" is measured by comparison to the prior art: 35 USC 102 and 103.

Do you agree that Ultramercial's patent should be found invalid as obvious in view of (1) the ancient prior art in which content providers forced people to look at ads and (2) the ancient prior art of computers that provide content (including "copyrighted" content, as if the legal status of the content could possibly make any difference to the patentability of the claim).

Just say so, then. Or are y'all going to stick your heads in the sand like you usually do?

Reply Jun 26, 2013 at 10:44 AM
Les said in reply to MM…
Could there be some invalidating prior art. Maybe.

I am not aware of your alleged prior art (1). I'm aware that the Romans nailed people to wooden planks. However, I'm not aware that the ancients forced people to look at ads.

In any event, disclosure of forced ad watching wouldn't anticipate the voluntary quid pro quo of the present claim.

That I am not aware that (2) the ancients used computers for anything, goes without saying. Yet, in attempting to communicate with you, I feel compelled to say it.

Reply Jun 26, 2013 at 11:03 AM
anon said in reply to Les…
Compare "*that (2) the ancients used computers for anything, goes without saying. Yet, in attempting to communicate with you, I feel compelled to say it.*"

and "*Or are y'all going to stick your heads in the sand like you usually do?*"

More of Malcolm's infamous accus-others-of-that-which-he-does.

Great quality blogging.

/off sarcasm

Reply Jun 26, 2013 at 11:13 AM
MM said in reply to Les…
Could there be some invalidating prior art. Maybe.

LOL. Classic t--b-gger: "I was born yesterday."

Reply Jun 26, 2013 at 11:35 AM
MM said in reply to Les…
Les *disclosure of forced ad watching wouldn't anticipate the voluntary quid pro quo of the present claim*

First of all, Les, by "ancient" I mean very old. I don't mean "ancient Roman". That was pretty funny, though, that you pretended that I meant "ancient Rome"! HAHAHAHHHAHAH! You patent t--b-ggers are really clever. Maybe later you can make some jokes about the "8 3/5 Justices" on the Supreme Court and we'll all have another huge laugh, just like we all laughed with Trollboy the other day.

As for the "anticipation" issue … nice goalpost move there. I was talking about obviousness. The prior art is filled with examples, hundreds of years old or older, where people who want to view content are presented first or simultaneously with promotional/advertising content. Performing that task on a computer is obvious and, given the very late filing date of this claim, there are no facts in existence that will make the method non-obvious. Are you aware of such facts? If so, let us know what those facts are, Les.

Readers should also be aware that Les believes that purely mental processes should be patentable. Just so everyone knows where good ol' Les is coming from!

Reply Jun 26, 2013 at 11:45 AM
Les said in reply to MM…
The topic of discussion is a ruling related to 101. Why are you ranting about 103?

Reply Jun 26, 2013 at 12:13 PM
MM said in reply to Les…
The topic of discussion is a ruling related to 101. Why are you ranting about 103?

LOL. I'm not "ranting about 103" Les.

You gotta love how the patent t--b-ggers never want to discuss 103. Les is SURE that it's eligible under 101 because it recites a computer. That's all anyone needs to know. And by golly let's not talk about how j--ky the claim is under the other statutes.

Sorry, Les: this is a forum for discussing patent law. All of the patent statutes work together. 101 is just one of the hurdles. If you want to take the simplistic (and legally incorrect view, in light of Prometheus) that any old, eligible element in a claim suffices to render the claim eligible, then go ahead. But such an approach puts all the pressure on 103, then. Is your position that non-obvious ineligible subject matter is sufficient to get around 103?

Do let us know, Les. I mean, you've thought this through already, right? Sure you have. You smart guy.

Reply Jun 26, 2013 at 12:51 PM
Les said in reply to MM…
"Is your position that non-obvious ineligible subject matter is sufficient to get around 103?"

Huh? Yes, non-obvious subject matter of all types gets around 103. However, ineligible subject matter does not get around 101.

What's your point?

Reply Jun 26, 2013 at 01:03 PM
anon said in reply to Les…
His point is that he his purposefully setting himself ablaze in FAIL and hoping that no one gets back to talking about how much CRP Mark Lemley has let loose with his guest post today.

Reply Jun 26, 2013 at 01:38 PM
MM said in reply to Les…
Les: *Yes, non-obvious subject matter of all types gets around 103.*

Okay, so let's summarize Les' position for Les and see where it takes us. Les believes that (1) any eligible subject matter in a claim suffices to make the claim eligible under 101.

So, an article of manufacture like a book is eligible subject matter according to Les. Okay. Moving right along to 103. Let's say that Les wants to patent a description of a new, non-obvious deity. So Les files the following (eligible) claim:

1. An article of manufacture, wherein said article is a piece of paper, and wherein said piece of paper comprises a description of a three horned purple elephant seal with zebra stripes on its hind legs.

According to Les, this paper is also patentable under 103 because of the non-obvious text on the paper.

So welcome to Les' world! You can patent your stories, books and sheet music now. Nothing will stop you.

Unless Les suddenly has some new caveat that he just thought up (because he couldn't possibly have seen this coming).

A question we might ask ourselves is: why should anyone care what someone like Les (or his good buddy, Trollboy) thinks about Mark Lemley? That's a rhetorical question, of course.

Reply Jun 26, 2013 at 01:41 PM
anon said in reply to MM…
"*your stories, books and sheet music now*"

LOL - except we both know the controlling law on this, don't we Malcolm? We both know what the 'useful arts' concept *really* entails don't we (notwithstanding your dissemlbing on this already today).

In fact, you volunteered that admission of controlling law.

Why don't you volunteer the controlling law again and help poor Les out.

I even have a marshmallow for you.

Reply Jun 26, 2013 at 02:24 PM
Les said in reply to MM…
Wow.

I didn't say something you wanted me to say so…. you can't stand that, so you say it for me…

"So, an article of manufacture like a book is eligible subject matter according to Les. Okay. Moving right along to 103. Let's say that Les wants to patent a description of a new, non-obvious deity. So Les files the following (eligible) claim"

I never said that. You did.

Reply Jun 26, 2013 at 02:31 PM
Show more comments…
Comment below or sign in with Typepad Facebook Twitter and more…

(You can use HTML tags like <b> <i> and <ul> to style your text. URLs automatically linked.)

Email address is not displayed with comment.

Name

Email Address

Web Site URL

Post Preview