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**MEMORANDUM**

**DATE:** May 19, 2016  
**TO:** Patent Examining Corps  
**FROM:**   
Robert W. Bahr  
Deputy Commissioner  
for Patent Examination Policy  
**SUBJECT:** Recent Subject Matter Eligibility Decisions (*Enfish, LLC v. Microsoft Corp.* and *TLI Communications LLC v. A.V. Automotive, LLC*)

On May 12, 2016, the U.S. Court of Appeals for the Federal Circuit (Federal Circuit) in *Enfish, LLC v. Microsoft Corp.* held that the claimed database software designed as a “self-referential” table is patent eligible under 35 U.S.C. § 101 because it is not directed to an abstract idea. While the decision does not change the subject matter eligibility framework, it provides additional information and clarification on the inquiry for identifying abstract ideas (Step 2A of the subject matter eligibility examination guidelines).

In reaching its conclusion, the Federal Circuit highlighted several important points regarding the subject matter eligibility analysis, in particular regarding whether a claim is directed to an abstract idea (Step 2A). First, the court noted that when determining whether a claim is directed to an abstract idea, it is appropriate to compare the claim to claims already found to be directed to an abstract idea in a previous court decision. Second, the court emphasized that the “directed to” inquiry applies a filter to claims, when interpreted in view of the specification, based on whether their character as a whole is directed to a patent ineligible concept. Third, the Federal Circuit cautioned against describing a claim at a high level of abstraction untethered from the language of the claim when determining the focus of the claimed invention. Fourth, the court stated that an invention’s ability to run on a general purpose computer does not automatically doom the claim. The subject matter eligibility examination instructions, as set out in the 2014 Interim Eligibility Guidance, July 2015 Update, and May 4, 2016 memorandum to examiners, are consistent with these points.

The Federal Circuit in *Enfish* stated that certain claims directed to improvements in computer-related technology, including claims directed to software, are not necessarily abstract (Step 2A). The court specifically noted that some improvements in computer-related technology, such as chip architecture or an LED display, when appropriately claimed, are undoubtedly not abstract. Explaining that software can make non-abstract improvements to computer technology just as hardware can, the court noted that claims directed to software, as opposed to hardware, also are

not inherently abstract. Therefore, an examiner may determine that a claim directed to improvements in computer-related technology is **not** directed to an abstract idea under Step 2A of the subject matter eligibility examination guidelines (and is thus patent eligible), without the need to analyze the additional elements under Step 2B. In particular, a claim directed to an improvement to computer-related technology (*e.g.*, computer functionality) is likely not similar to claims that have previously been identified as abstract by the courts.

The claims of the patents at issue in this case describe the steps of configuring a computer memory in accordance with a self-referential table, in both method claims and system claims that invoke 35 U.S.C. § 112(f). The court asked whether the focus of the claims is on the specific asserted improvement in computer capabilities (*i.e.*, the self-referential table for a computer database), or instead on a process that qualifies as an “abstract idea” for which computers are invoked merely as a tool. To make the determination of whether these claims are directed to an improvement in existing computer technology, the court looked to the teachings of the specification. Specifically, the court identified the specification’s teachings that the claimed invention achieves other benefits over conventional databases, such as increased flexibility, faster search times, and smaller memory requirements. It was noted that the improvement does not need to be defined by reference to “physical” components. Instead, the improvement here is defined by logical structures and processes, rather than particular physical features. The Federal Circuit stated that the *Enfish* claims were not ones in which general-purpose computer components are added after the fact to a fundamental economic practice or mathematical equation, but were directed to a specific implementation of a solution to a problem in the software arts, and concluded that the *Enfish* claims were thus **not** directed to an abstract idea (under Step 2A).

Closely following *Enfish*, the Federal Circuit decided *TLI Communications LLC v. A.V. Automotive, LLC* on May 17, 2016, which provides a contrast between non-abstract claims directed to an improvement to computer functionality and abstract claims that are directed, for example, to generalized steps to be performed on a computer using conventional computer activity. Specifically, the court stated that the TLI claims describe steps of recording, administration and archiving of digital images, and found them to be directed to the abstract idea of classifying and storing digital images in an organized manner (Step 2A). The court then found that the additional elements of performing these functions using a telephone unit and a server did not add significantly more to the abstract idea because they were well-understood, routine, conventional activities (Step 2B).

In summary, when performing an analysis of whether a claim is directed to an abstract idea (Step 2A), examiners are to continue to determine if the claim recites (*i.e.*, sets forth or describes) a concept that is similar to concepts previously found abstract by the courts. The fact that a claim is directed to an improvement in computer-related technology can demonstrate that the claim does not recite a concept similar to previously identified abstract ideas.