

July 2015 Update Appendix 3: Subject Matter Eligibility Court Decisions

The tables in this appendix provide further information on selected eligibility cases from the U.S. Supreme Court and the U.S. Court of Appeals for the Federal Circuit. Examiners may find this information useful in identifying those applications that may require a detailed eligibility analysis during examination. Future decisions will be added to this chart as they become available. It should be noted that the courts' analyses in these decisions do not necessarily employ the *Alice Corp.-Mayo* eligibility framework, which is explained in the *2014 Interim Guidance on Subject Matter Eligibility* (2014 IEG), because most of the cases were decided prior to *Alice Corp.*

For each case (arranged by court and in reverse chronological order), the tables provide the following information:

- (1) a legal citation and, if available, a link to the entire court opinion (if no link is available, a parallel citation to the U.S.P.Q reporter is also provided),
- (2) the U.S. patent number(s) or application number(s) at issue,
- (3) the subject matter of the patent/application,
- (4) whether the claims were eligible or ineligible (note that a finding applies to all claims in the patent/application unless otherwise noted),
- (5) the USPC/CPC classification, and
- (6) a notation of where the case is discussed (if applicable) in the 2014 IEG and/or the eligibility examples. An index to the eligibility examples is provided in Appendix 2.

It is important to remember that each case turns on its own facts. Therefore, the mere fact that a pending application may be similarly classified to a patent or an application in this chart, or have similar subject matter, does not necessarily indicate an eligibility issue. Identification of a judicial exception in a claim merely indicates further analysis for eligibility should be conducted.

NOTE: This appendix is an updated version of the case summary chart that was used in conjunction with the Abstract Idea Workshop Training. Legal citations and more decisions have been added since the training.

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Supreme Court Decisions

| Case Name & Citation | Patent(s) or App. No(s). | Title or General Subject Matter | Judicial Conclusion | Classification (USPC & CPC) | Where Discussed |
|--|--|--|--|-----------------------------|-------------------------------------|
| <i>Alice Corp. Pty. Ltd. v. CLS Bank Int'l</i> , 573 U.S. __, 134 S. Ct. 2347 (2014). | 5,970,479 6,912,510 7,149,720 7,725,375 | Formulation and trading of risk management contracts <i>- Methods, systems, computer readable media</i> | Ineligible '479: asserted claims 33-34. '510, '720, and '375: all claims. | 705/37 G06Q10/06 | 2014 IEG in Section III |
| <i>Association for Molecular Pathology v. Myriad Genetics, Inc.</i> , 569 U.S. __, 133 S. Ct. 2107 (2013). | 5,747,282 5,837,492 5,693,473 | Breast and ovarian cancer susceptibility gene <i>- Products</i> | Ineligible '282: claims 1, 5-6 '473: claim 1 '492: claims 1 & 6 Eligible '282: claims 2 & 7 '492: claim 7 (other claims from these patents were addressed in <i>Myriad CAFC</i> and <i>Ambry Genetics</i>) | 435/69.1 C07K14/4703 | 2014 IEG in Section III |
| <i>Mayo Collaborative Svcs. v. Prometheus Labs.</i> , 566 U.S. __, 132 S. Ct. 1289 (2012). | 6,355,623 6,680,302 | Optimizing drug therapeutic efficacy for treatment of immune-mediated gastrointestinal disorders <i>- Methods</i> | Ineligible | 514/45 G01N33/94 | 2014 IEG in Section III |
| <i>Bilski v. Kappos</i> , 561 U.S. 593 (2010). | 08/833,892 | Energy Risk Management Method <i>- Methods</i> | Ineligible | 705/412 | 2014 IEG in Section IV |
| <i>Diamond v. Diehr</i> , 450 U.S. 175, 209 U.S.P.Q. 1 (1981) | 4,344,142 | Direct Digital Control of Rubber Molding Presses <i>- Methods</i> | Eligible | 700/198 B29C35/0288 | 2014 IEG in Section III, Example 25 |
| <i>Diamond v. Chakrabarty</i> , 447 U.S. 303, 206 U.S.P.Q. 193 (1980). | 4,259,444 | Microorganism having plasmids and preparation thereof <i>- Product and methods</i> | Eligible | 435/479 C12N15/00 | 2014 IEG in Section III |
| <i>Parker v. Flook</i> , 437 U.S. 584, 19 U.S.P.Q. 193 (1978). | 05/194,032 | Method for updating alarm limits <i>- Methods</i> | Ineligible | N/A | 2014 IEG in Section III, Example 24 |

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|---|--------------------------|---|-------------------------------------|-----------------------------|------------------------|
| <i>Gottschalk v. Benson</i> , 409 U.S. 63, 175 U.S.P.Q. 673 (1972). | 04/315,050 | Conversion of numerical information - <i>Methods</i> | Ineligible | N/A | 2014 IEG in Section IV |
| <i>Mackay Radio</i> , 306 U.S. 86, 40 USPQ 199 (1939). | 1,974,387 | Antenna - <i>Products</i> | Eligible claims 15 and 16 | 343/809 H01Q11/06 | 2014 IEG in Section IV |

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Federal Circuit Decisions

| Case Name & Citation | Patent(s) or App. No(s). | Title or General Subject Matter | Judicial Conclusion | Classification (USPC & CPC) | Where Discussed |
|--|-------------------------------------|--|--|---|-----------------|
| <u>Versata Development Group, Inc. v. SAP America, Inc.</u> , No. 2014-1194, - F.3d – (Fed. Cir. July 9, 2015). | 6,553,350 | Pricing products in multi-level product and organizational groups <i>- Methods, system, and computer readable media</i> | Ineligible Claims 17 & 26-29 | 705/20 G06Q 20/201 | |
| <u>Intellectual Ventures I LLC v. Capital One Bank (USA)</u> , No. 2014-1506, - F.3d – (Fed. Cir. Jul. 6, 2015). | 8,083,137 7,603,382 | Administration of financial accounts, and advanced internet interface providing user display access of customized webpages <i>- Methods and Systems</i> | Ineligible '137: claims 5-11 '382: claims 1-5, 16, 17, & 19-22 | 235/380 G06Q 20/12 707/999.104 G06F 17/30899; | |
| <u>In re Webb</u> , No. 2014-1652, __ Fed. Appx. __ (Fed. Cir. Jul. 1, 2015).* | 12/429,724 | Poker games with varying position advantage <i>- Methods</i> | Ineligible | 273/292 A63F 3/00157 | |
| <u>Internet Patents Corp. v. Active Network, Inc.</u> , No. 2014-1048, – F.3d – (Fed. Cir. Jun. 23, 2015). | 7,707,505 | Dynamic tabs for a graphical user interface <i>- Methods, systems, computer readable media</i> | Ineligible | 715/738 G06F 17/30893 | |
| <u>Ariosa Diagnostics, Inc. v. Sequenom, Inc.</u> , 788 F.3d 1371 (Fed. Cir. 2015). | 6,258,540 | Non-invasive prenatal diagnosis <i>- Methods</i> | Ineligible Claims 1, 2, 4, 5, 8, 19-22, 24 & 25 | 435/6.12 C12Q 1/6879 | |
| <u>OIP Technologies, Inc. v. Amazon.com, Inc.</u> , 788 F.3d 1359 (Fed. Cir. 2015). | 7,970,713 | Automatic pricing in electronic commerce <i>- Methods and computer readable media</i> | Ineligible | 705/400 G06Q 30/0211 | |
| <u>Federal Home Loan Mortgage Corp. aka Freddie Mac v. Graff/Ross Holdings LLP</u> , __ Fed. Appx. __ (Fed. Cir. May 15, 2015).* | 7,908,202 7,685,053 6,192,347 | Securitizing property into separately valued components <i>- Methods and Systems</i> | Ineligible All claims in '202 and '053 '347: claims 101 and 102 | 705/37 G06Q 30/06 705/36R G06Q 30/06 | |
| <u>Dietgoal Innovations LLC v. Bravo Media LLC</u> , 599 Fed. Appx. 956 (Fed. Cir. 2015).* | 6,585,516 | Computerized meal planning <i>- Methods and Systems</i> | Ineligible | 434/127 G06F 19/3475 | Example 22 |

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|---|--|--|--|-----------------------------|-----------------------------------|
| <u>Gametek LLC v. Zynga Inc.</u> , 597 Fed. Appx. 644 (Fed. Cir. 2015).* | 7,076,445 | Obtaining advantages and transacting the same in a computer gaming environment <i>- Methods</i> | Ineligible | 705/14.12 G06Q30/02 | |
| <u>Fuzzysharp Technologies Inc. v. Intel Corporation</u> , 595 Fed. Appx. 996 (Fed. Cir. 2015).* | 6,618,047 | Visibility Calculations for 3D Computer Graphics <i>- Method</i> | Ineligible Claim 67 | 345/421 G06T15/40 | |
| <u>Content Extraction and Transmission LLC v. Wells Fargo Bank, N.A.</u> , 776 F.3d 1343 (Fed. Cir. 2014). | 5,768,416 5,258,855 5,369,508 5,625,465 | Scanning and Information Processing Methodology <i>- Methods and machines (interface/system)</i> | Ineligible | 382/180 G06K9/2054 | |
| <u>Univ. of Utah Research Found. v. Ambray Genetics Corp.</u> , 774 F.3d 755 (Fed. Cir. 2014). Also known as <i>In re BRCA1- and BRCA2-Based Hereditary Cancer Test Patent Litigation</i> . | 5,747,282 5,753,441 5,837,492 | Breast and ovarian cancer susceptibility gene <i>- Methods and products</i> | Ineligible '441: claims 1 & 7-8 '282: claims 16-17 '492: claims 29-30 (See also <i>Myriad</i> and <i>Myriad</i> CAFC) | 435/69.1 C07K14/4703 | |
| <u>DDR Holdings, LLC v. Hotels.com, L.P.</u> , 773 F.3d 1245 (Fed. Cir. 2014). | 7,818,399 | Expanding commercial opportunities for internet websites <i>- Methods and system</i> | Eligible Claims 1, 3, 19 | 709/218 G06Q30/06 | 2014 IEG in Section IV, Example 2 |
| <u>Ultramercial, Inc. v. Hulu, LLC</u> , 772 F.3d 709 (Fed. Cir. 2014). | 7,346,545 | Payment of intellectual property royalties by interposed sponsor over a telecommunications network <i>- Methods</i> | Ineligible | 705/14.73 G06Q30/02 | 2014 IEG in Section IV, Example 8 |
| <u>buySAFE, Inc. v. Google, Inc.</u> , 765 F.3d 1350 (Fed. Cir. 2014). | 7,644,019 | Safe Transaction Guaranty <i>- Methods and computer readable media</i> | Ineligible Claims 1, 14, 39 and 44 | 705/35 G06Q10/10 | 2014 IEG in Section IV, Example 7 |

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|---|--------------------------|--|--|-----------------------------|-----------------------------------|
| <u>Planet Bingo, LLC v VKGS LLC</u> , 576 Fed. Appx. 1005 (Fed. Cir. 2014) | 6,398,646 6,656,045 | Storing preselected numbers for use in games of bingo <i>- Methods and systems</i> | Ineligible | 463/19 G07F17/32 | 2014 IEG in Section IV, Example 6 |
| <u>Digitech Image Techs., LLC v Electronics for Imaging, Inc.</u> , 758 F.3d 1344 (Fed. Cir. 2014). | 6,128,415 | Device profiles for use in a digital image processing system <i>- Device profile and methods</i> | Ineligible Claims 1-6, 9-15, 26-31 | 382/276 G06T1/00 | 2014 IEG in Section IV, Example 5 |
| <u>In re Roslin Institute (Edinburgh)</u> , 750 F.3d 1333 (Fed. Cir. 2014). | 09/225,233 | Cloned mammals produced by somatic cell nuclear transfer <i>- Product</i> | Ineligible Claims 155-159 and 164 | 800/015 | |
| <u>Cyberfone Systems, LLC v. CNN Interactive Group, Inc.</u> , 558 Fed. Appx. 988 (Fed. Cir. 2014). | 8,019,060 | Telephone/transaction entry device and system for entering transaction data into database <i>- Methods and Systems</i> | Ineligible | 379/93.01 G06F17/243 | 2014 IEG in Section IV |
| <u>SmartGene, Inc. v Advanced Biological Labs.</u> , 555 Fed. Appx. 950 (Fed. Cir. 2014). | 6,081,786 6,188,988 | Systems, methods and computer program products for guiding the selection of therapeutic treatment regimens <i>- Methods, Systems, Computer Program Products</i> | Ineligible | 705/3 G06F19/3443 | 2014 IEG in Section IV |
| <u>Accenture Global Services, GmbH v. Guidewire Software</u> , 728 F.3d 1336 (Fed. Cir. 2013). | 7,013,284 | Component based interface to handle tasks during claim processing <i>- Methods and Systems</i> | Ineligible | 705/4 G06Q10/06311 | |
| <u>PerkinElmer Inc. v Intema Ltd.</u> , 496 Fed. Appx. 65 (Fed. Cir. 2012). | 6,573,103 | Antenatal screening for Down's syndrome <i>- Methods</i> | Ineligible | 436/65 G01N33/689 | |

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|--|---|--|---|-----------------------------|------------------------|
| <u>Association for Molecular Pathology v. USPTO</u> , 689 F.3d 1303 (Fed. Cir. 2012). (“ <i>Myriad CAFC</i> ”) | 6,033,857 5,753,441 5,747,282 5,710,001 5,709,999 | Breast and ovarian cancer susceptibility gene - <i>Methods</i> This decision’s ruling on product claims from various patents was subsequently affirmed-in-part and reversed-in-part by the Supreme Court. See <i>Myriad, supra</i> . | Ineligible ‘857: claims 1 & 2 ‘441: claim 1 ‘001: claim 1 ‘999: claim 1 Eligible ‘282: claim 20 (See also <i>Myriad & Ambry Genetics</i>) | 435/69.1 C07K14/4703 | |
| <u>Bancorp Services v. Sun Life</u> , 687 F.3d 1266, 1278 (Fed. Cir. 2012). | 5,926,792 7,249,037 | System for managing a stable value protected investment plan - <i>Methods and Computer Readable Media</i> | Ineligible ‘792: claims 9, 17, 18, 28, and 37 ‘037: claims 1, 8, 9, 17-21, 27, 28, 37, 42, 49, 52, 60, 63, 66-68, 72-77, 81-83, 87, 88, and 91-95 | 705/4 G06Q40/00 | |
| <u>Fort Properties, Inc. v. American Master Lease LLC</u> , 671 F.3d 1317 (Fed. Cir. 2012). | 6,292,788 | Methods and investment instruments for performing tax-deferred real estate exchanges - <i>Methods</i> | Ineligible | 705/36T G06Q30/04 | |
| <u>Dealertrack Inc. v Huber</u> , 674 F.3d 1315 (Fed. Cir. 2012). | 7,181,427 | Automated credit application system - <i>Methods</i> | Ineligible Claims 1, 3, and 4 | 705/38 G06Q20/10 | 2014 IEG in Section IV |
| <u>Classen Immunotherapies Inc. v. Biogen IDEC</u> , 659 F.3d 1057 (Fed. Cir. 2011). | 6,638,739 6,420,139 5,723,283 | Method and composition for an early vaccine to protect against both common infectious diseases and chronic immune mediated disorders - <i>Methods</i> | Eligible All claims in ‘739 and ‘139 Ineligible All claims in ‘283 | 435/69.3 A61K39/295 | |

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|---|--------------------------|---|--|---------------------------------|-----------------------------------|
| <i>Cybersource Corp. v. Retail Decisions, Inc.</i> , 654 F.3d 1366 (Fed. Cir. 2011). | 6,029,154 | Method and System for Detecting Fraud in a Credit Card Transaction over the Internet <i>- Computer Readable Media and Method</i> | Ineligible Claims 2-3 | 705/44 G06Q20/027 | |
| <i>Research Corporation Technologies Inc. v. Microsoft Corp.</i> , 627 F.3d 859 (Fed. Cir. 2010). | 5,111,310 5,341,228 | Method and Apparatus for Halftone Rendering of a Gray Scale Image Using a Blue Noise Mask <i>- Methods</i> | Eligible '310: Claims 1-2 '228: Claim 11 | 358/3.19 358/534 G06T3/40 | 2014 IEG in Section IV, Example 3 |
| <i>SiRF Tech. Inc. v. Int'l Trade Commission</i> , 601 F.3d 1319 (Fed. Cir. 2010). | 6,417,801 6,937,187 | Processing of GPS Signals <i>- Methods</i> | Eligible '801: Claims 1, 2, 11 '187: Claim 1 | 342/357.62 G01S5/0018 | 2014 IEG in Section IV, Example 4 |
| <i>In re Ferguson</i> , 558 F.3d 1359 (Fed. Cir. 2009). | 09/387,823 | New Paradigm for Bringing New Products to Market <i>- Methods and "paradigm"</i> | Ineligible | 705/14 | |
| <i>In re Comiskey</i> , 554 F.3d 967 (Fed. Cir. 2009). | 09/461,742 | Method and System for Mandatory Arbitration <i>- Methods and System</i> | Ineligible Claims 1-14, 16, 32-43, and 45 (remanded for consideration of eligibility of other claims; application currently pending with amended claims) | 705/1 | |
| <i>In re Grams</i> , 888 F.2d 835, 12 U.S.P.Q.2d 1824 (Fed. Cir. 1989). | 06/625,247 | Method of Diagnosing an Abnormal Condition in an Individual <i>- Methods</i> | Ineligible | 436/501 | |
| <i>In re Meyer</i> , 688 F.2d 789, 215 U.S.P.Q. 193 (CCPA 1982). | 05/465,574 | Process and Apparatus for Identifying Locations of Probable Malfunctions <i>- Methods and System</i> | Ineligible | N/A | |

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|---|--------------------------|---|---|-----------------------------|-----------------|
| <i>In re Abele</i> , 684 F.2d 902, 214 U.S.P.Q. 682 (CCPA 1982). | 4,433,380 04/850,892 | Tomographic Scanner <i>- Methods and System</i> | Ineligible Claims 5 and 7 of '892 application (not patent claims) Eligible Claims 6 and 33-47 of '892 application (note claim 6 is renumbered as claim 1 in '380 patent) | 382/131 A61B6/032 | |
| <i>In re Maucorps</i> , 609 F.2d 481, 203 U.S.P.Q. 812 (CCPA 1979). | 05/536,839 | Computer Systems for Optimizing Sales Organizations and Activities <i>- System</i> | Ineligible | N/A | |

* These cases were decided under Federal Circuit Rule 36, which provides for a judgment of affirmance without opinion.