

A POST SCRIPTUM TO THE *Motio* DECISION OF THE EASTERN TEXAS DISTRICT COURT

Sigram Schindler,
TU Berlin & TELES Patent Rights International GmbH

Berlin, 11.01.2016 The US District Court of the Eastern District of Texas on 04.01.2016 decided the *Motio vs. BSP Software* (“*Motio*”) patent-eligibility case, following the CAFC’s reasoning in its earlier *DDR* decision, which is in line with the Supreme Court’s *Mayo/Biosig/Alice* (“*MBA*”) framework.

It thus confirmed my 05.01.2016 email to you, called “The Patent-Eligibility Puzzle is Over” [251]. It showed that the CAFC had created this patent-eligibility puzzle by openly contradicting its own *DDR* decision as well as the Supreme Court’s *MBA* framework by several more recent decisions (e.g. in the *Myriad* case) – being legally erroneous, as felt by parts of the patent community and seen scientifically.

To show the latter, [251] provided a tutorial explaining the reason for this patent-eligibility confusion. Namely: The CAFC, in these several allegedly legally erroneous opinions, did not refine the notions of the direction pointing *MBA* framework – as the Supreme Court explicitly asked for [251^{2.c)}] – but just applied it. The CAFC thus completely ignored that the *MBA* framework also implicitly but nevertheless indispensably requires this refinement. The drawback of using solely the original^{1.a)} notions in analyzing an invention’s subject matter for its patent-eligibility – i.e. of not supporting this subject matter’s such analysis by refining its A-level representation to its “elementary level, E-level” representation – is that on its A-level it usually is hard to unquestionably present this subject matter’s patent-eligibility^{1.b)}.

This [251] tutorial^{1.c)} explained in detail the correct application of the refined *Alice* alias PEG test to the *DDR* and *Myriad* ETCIs – thus commenting on the respective CAFC decisions and showing that the above mentioned patent-eligibility puzzle indeed does not exist anymore as resolved by the PEG test.

This PS to the [251] tutorial now complements it by applying the PEG test also to the *Motio* ETCI, which confirms the scientific correctness of the above ET DC’s decision. It ends by clarifying a crucial remark in this decision, which the latter cited from the CAFC’s *DDR* decision – being misleading already there.

The following explanation of the PEG test application to the *Motio* ETCI tightly follows the scheme presented by its application to the *DDR* and *Myriad* ETCIs in [251]^{1.e)}. This explanation again uses – as in *DDR*’s ETCI – that by the *MBA* framework the refined claim interpretation [241] of the ‘678 Claims 1 or 4 rests not only on its individual wording but also on its specification (especially other claims’ wordings) and the knowledge of the pposc^{1.f)}. I.e.: It is in line with the ET DC’s *Motio* decision^{1.e)}.

¹ .a These non-refined, coarse, and just direction-pointing notions provided by the specification of the subject matter at issue are the notional basis of its “abstract level, A-level” representation, i.e. its A-level paradigm – to be refined to this subject matter’s E-level paradigm as ‘specification disclosed’.
 .b The Supreme Court’s *Alice* decision per se is no test, at all, but – just as the USPTO’s/IEG’s identical “**two step Alice test**” – a declarative requirement statement to be met by any patent-eligibility test for uniformly&objectively applying SPL in testing ETCIs (always raising the patent-eligibility question as being unlimited preemptive [251]). The “refined *Alice*” alias “PEG” test is just the procedural refinement of this declarative requirement statement.
 .c The [251] tutorial also explained what notional refinement the *MBA* framework implies and that this always possible refinement (if needed at all) of whatsoever subject matter^{1.d)} enables this for all ETCIs uniform and objective refined *Alice* test alias “Patent Eligibility Granted/-ing, PEG” test^{1.b)}.
 .d also denoted as “emerging technology claimed invention, ETCI”, whereby the notion subject matter \equiv ETCI ::= <invention/TT0, application/A> is also implied by the *MBA* framework. More generally: This PS assumes the reader’s familiarity with the notions explained by the tutorials [241,244,251]
 .e This ‘678-patent exposes very clearly that the difficulty to find this A- to E-level refinement of its ETCI representation at issue is caused by its deficient presentation in this patent’s specification – as incomplete and inconsistent, e.g. its wording to its graphics or its wording within Claim1. This evidences the often observable incapability of many otherwise potentially highly qualified inventors to deliver a reasonable presentation of their insights/creations/results – with which the patent system unfortunately must live, as this incapability frequently is a dark companion of their potential talent, as the author professionally frequently encountered, when bringing up “Informatik” in German universities (see its CV [9]). Thus, even evident wording failures are tolerable under appropriate circumstances, what the ET DC practiced in this ‘678-case – and the author sees alike.
 .f as of the Supreme Court’s *KSR* decision, FSTP-Technology (see the Reference List) talks of the “person of pertinent ordinary skill and creativity”.

The plaintiff's (principally^{1.e)} correct) analysis as to the *Motio* ETCI's A-level representation stated²⁾:

- It is made-up from $N ::= 3$ elements: $X1 ::=$ business intelligence system, $X2 ::=$ business intelligence artifact, $X3 ::=$ automated agent, whereby
- their 3 abstract (allegedly) creative properties describing the '678-ETCI as by the '678-specification disclosed, are for:
 - X1 modeled by $A\text{-cr}C1 ::=$ is independently creating by selecting and executing an X2.
 - X2 modeled by $A\text{-cr}C2 ::=$ is its "version, V" created by selection from given report specifications and analysis cubes.
 - X3 modeled by $A\text{-cr}C3 ::=$ is interfacing with X1 for automated version control as to $X2 \wedge$ detecting request to X1 to modify X2 \wedge verifying consistency of modification requested \wedge storing created X2 in given version control system.

The *Motio* ETCI's A-level representation by its 3 elements' properties $A\text{-cr}C1 \wedge A\text{-cr}C2 \wedge A\text{-cr}C3$ – even if completed^{2.a)} – seems obvious (as the defendant argues).

But – due to its coarseness being not exact [251^{9.b)}] – there also is no unquestionable indication (as the plaintiff argues) that for the *Motio* subject matter it is possible to apply the *Alice* decision, i.e. to separate its alleged invention/TT0* (then not existent although by *Alice* decision's applicability required) from latter's application/A*.

These naturally occurring "too coarse representation problems" of an ETCI's A-level representation always are overcome by refining its $A\text{-cr}Cn$'s into conjunctions of its $E\text{-Cnk}$'s \wedge V $E\text{-cr}Cnk$'s, such that this separation of its invention/TT0* from the latter's application/A* is clearly exposed. This refinement consults the ETCI's specification for further details disclosed for it – which here are found as to $A\text{-cr}C3$.

Thus^{1.a)}, let $\bullet E\text{-cr}C11 ::= A\text{-cr}C1$, $\bullet E\text{-cr}C21 ::= A\text{-cr}C2$, $\bullet E\text{-cr}C31 ::=$ is interfacing with X1 for automated version control as to $X2 \wedge$ detecting request to X1 to modify X2 \wedge verifying consistency of modification requested \wedge storing created X2 in given version control system, $\bullet E\text{-cr}C32 ::=$ is starting executing the most current X2 (determined by the given information by the given user), $\bullet E\text{-cr}C33 ::=$ is pre-/post-/ (periodic at a given frequency) automatic correctness testing of $E\text{-cr}C21$.

These 5 $E\text{-cr}Cnk$ of the '678-ETCI enable exactly modeling also its 3 $A\text{-cr}Cn$, thus defining this ETCI's "E-level representation" (and therein its unquestionable split into aTT0* and latter's application/A*):

- $A\text{-cr}C1 ::= E\text{-cr}C11 \wedge$
- $A\text{-cr}C2 ::= E\text{-cr}C21 \wedge$
- $A\text{-cr}C3 ::= E\text{-cr}C31 \wedge E\text{-cr}C32 \wedge E\text{-cr}C33$.

The version control invention/TT0* $::= \{E\text{-cr}C11, E\text{-cr}C21, E\text{-cr}C31\}$ is by the '678-ETCI coupled to TT0's automated agent application/A* $::= \{E\text{-cr}C31 \wedge E\text{-cr}C32 \wedge E\text{-cr}C33\}$. I.e., the obvious '678-invention/TT0* is creatively coupled by the *Motio* ETCI to the '678-application/A* by $E\text{-cr}C31$ – as *Alice* requires.

Finally, the clarification of the quotation by the ET DC from the CAFC's *DDR* decision, saying that "... claims [may] add too little ...". As shown by [251], this concern may be interpreted only as telling for an ETCI: "Either a claim adds nothing to an invention/TT0 therein, i.e. the latter's application/A= Φ , or this ETCI is patent-eligible, as the existence of only a single $E\text{-in}C^{Alice}$ transforms already TT0 into patent-eligibility". How fine the – due to the application/A adding something to TT0 – by the application thereby added separation line addressed by the CAFC may be: For *Alice* only counts that its $\text{in}C^{Alice}$ is there.

² For this PS is assumed to be acceptable that the A- and E-level representations of the '678 Claim 1 comprise only its limitations impacting on its patent-eligibility. This also facilitates recognizing the principle of applying the refined *Alice* test alias PEG test. The meta-language used for specifying the A-/E-crCs is self-explaining.

