



Showing ‘Meaningful Limits’ in Patent Claims

By Dennis Carleton / March 19, 2019

“It is always useful to be able to show, by example, that other ways of achieving the desired result exist which are not covered by the recited claim limitations.”

The USPTO’s 2019 Revised Patent Subject Matter Eligibility Guidance provides that if an abstract idea represented in one or more claim elements is integrated into a practical application by other limitations in the claim, then the claim as a whole would not be directed to a judicial exception and, as such, would be considered patentable under section 101.

The revised guidance states that “a claim that integrates a judicial exception into a practical application will apply, rely on or use the judicial exception in a manner *that imposes a meaningful limit* on the judicial exception, such that the claim is more than a drafting effort designed to monopolize the judicial exception.” This would seem to be in line with the public policy underlying the judicial exception of not allowing a claim to preempt all means of achieving a desired result. Often, patent claims are drafted such as to contain claim elements directed to desired outcomes as opposed to specific ways of achieving the desired outcomes. Claim elements directed only to desired outcomes have the effect of preempting all ways of achieving the desired outcome, and, as such, are considered to “monopolize the judicial exception”. The public policy behind the judicial exception seeks to prevent the monopolization of the judicial exception by a claim reciting only the desired outcome.

Meaningful Advice from *McRo*

The question, however, remains as to how to show that a “meaningful limit” has been placed on the judicial exception. The patent office has suggested using considerations provided by Supreme Court and Federal Circuit decisions. The case of *McRo v. Bandai* (Fed. Cir. 2016) has been particularly useful in overcoming rejections under section 101, even prior to the issuance of the revised guidance. The so-called “*McRo*

Test” states that claims are not directed to an abstract idea if the claim uses *limited rules* in a process specifically designed to achieve *an improved technological result* in conventional industry practice. In other words, if the improved technological result was achieved in a specific way, this would render the claim non-abstract. As such, claiming a specific way of achieving the desired result may be one way to show that “meaningful limitations” have been placed on the abstract idea. The “practical application” analysis of the revised guidance appears to be an attempt by the patent office to formalize this concept.

As an example, consider a claim limitation directed to selecting promotional materials for presentation to a user. Such a claim limitation is directed to all methods of selecting the promotional materials and may therefore be considered abstract. However, adding specific limitations as to how the promotional materials are selected places a “meaningful limit” on the abstract idea. For example, if the promotional materials are selected based upon the user’s affinity for a particular subject as expressed in a social graph, then other methods of selecting the promotional materials are not covered by the claim limitation. As such, the claim limitation does not preempt all methods of selecting the promotional materials, and the goal of the public policy underlying the judicial exceptions is satisfied.

More Help From *Vanda*

Additional assistance may be found in the recent case of *Vanda Pharma, Inc. v. West-Ward Pharma*. (Fed. Cir. 2018), in which the patent at issue was directed to a method to treat schizophrenia involving a combination of various compounds. The court found the method of treatment to be directed to patentable subject matter because the claims *applied* natural relationships between the various compounds instead of being *directed* to the combination of compounds. In other words, the claims at issue practically applied a natural relationship of the compounds. The case also cited the importance of evaluating the claims *as a whole* in a step 2A *Alice* analysis.

How meaningful do the limitations need to be to transform the abstract idea into a practical application of the abstract idea? No guidance is given on the issue; however,

it is always useful to be able to show, by example, that other ways of achieving the desired result exist which are not covered by the recited claim limitations. That is, a convincing argument that the claim limitation is non-abstract because it has “meaningful limits” on its scope may be demonstrated by showing that other methods achieving the same desired result exist. When this is the case, the goal of the public policy of not allowing preemption of all methods of achieving the desired result is met.

The 2019 Revised Guidance represent a first step toward a long-awaited formalization of the *Alice/Mayo* test that will hopefully provide consistent application of the abstract idea judicial exception from examiner to examiner.

The Author

Dennis Carleton has many years of experience working in innovative engineering environments, allowing him to speak the language of an innovator and apply his legal skills to guide his clients through the intellectual property process. While at Fox Rothschild, Dennis provided infringement and right-to-use analyses, including the drafting of opinion letters. He often assisted clients to identify and design around existing IP roadblocks, helping them avoid costly litigation. He also garnered extensive experience negotiating and drafting development agreements, licenses, confidentiality and non-disclosure agreements and employment and contractor agreements, as well as having significant experience in the procurement and licensing of trademark assets.

For more information or to contact Dennis, visit his [Firm Profile Page](#).