



Examining Confusion Between

the *Chamberlain* and *Berkheimer* Decisions at the Federal Circuit

By Wen Xie / September 9, 2019

“Rather than look to the improvement as the possible ‘something more’ that overcomes the well-understood, routine and conventional standard, the Chamberlain panel took that standard and applied it right back to the improvement itself.”

If you’re reading this blog, then you likely are an avid follower of the Section 101 saga. The most recent episode in this saga, *Chamberlain v. Techtronic* at the Federal Circuit, is about so much more than a garage door operator being an abstract idea. It’s about the fact that we still have no clue what’s supposed to happen in the 2A and 2B steps of the judicially-created *Alice/Mayo* test.

From *Mayo* to Mess

In *Mayo* and *Alice*, the Supreme Court told us that an abstract idea needed “something more” than what is well-understood, routine and conventional (WRC) to be patentable.

Sure.

Then, *Berkheimer v. HP* came along a year and a half ago and said something very interesting: if you have an abstract idea under 2A, you can overcome the abstract idea finding by showing that the claim is directed to a purported improvement under 2B. (“[W]e must . . . ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea.” *Berkheimer* at 11.) In other words, the improvement to the computer functioning is a showing of

that “something more,” rendering an abstract idea (the computer functioning alone) to be more than WRC.

However, now, we have to question whether this standard established by *Berkheimer* will be sustained in light of the Federal Circuit’s more recent precedential *Chamberlain* decision.

I know what you’re thinking: Isn’t that what *Chamberlain* did? The panel assessed the CGI’s improvement after all. (“The asserted claims here are not limited to a specific implementation of a technological improvement to communication systems. Rather, they simply recite a system that wirelessly communicates status information. Nor do the asserted claims ‘focus on a specific means or method that improves the relevant technology.’” *Chamberlain* at 7.)

Reading *Berkheimer* Backwards

No. The *Chamberlain* panel applied the *Alice/Mayo* test completely backwards compared to what the *Berkheimer* panel said. First, the question of improvement was assessed in *Chamberlain*’s “Step One” (or 2A). Not only that, the panel then immediately went on to find that “(t)he specification admits that the act of transmitting data wirelessly is ‘well understood in the art,’ and no other changes to the generically claimed movable barrier operator are recited in the asserted claims or described in the specification.” *Chamberlain* at 7.

What is happening in *Chamberlain*? Rather than look to the improvement as the possible “something more” that overcomes the WRC standard, the *Chamberlain* panel took the WRC standard and applied it right back to the improvement itself. The purported improvement here was to improve a garage door opening system by providing a wireless communication system to communicate status information for a garage door opener. The panel limited the improvement here to just wireless communication of status, ignoring the setting of

its implementation, which was to a garage door, and then found the method of wirelessly communicating status to be well-understood in the art. In other words, the purported improvement is not an improvement to a garage door system by providing a wireless communication system, which I believe is what the appellant was arguing. Rather, the improvement is just limited to a wireless communication system, which greatly enhances the standard of what that improvement must be under a patentability analysis.

This means that the *Chamberlain* panel took the very obstacle the improvement was supposed to overcome and applied it right back to the improvement. That’s like putting the cart on the horse!

The table below outlines the main differences between *Berkheimer* and *Chamberlain* in terms of how they applied the *Alice* test:

<i>Berkheimer:</i>	<i>Chamberlain:</i>
<p><i>Alice</i> Step 2A – is the claim directed to an abstract idea?</p> <p>“At <i>Alice</i> step one, we must ‘determine whether the claims at issue are directed to a patent-ineligible concept.’” <i>Berkheimer</i> at 8.</p> <p><i>Alice</i> Step 2B – is there something more than WRC?</p> <p>“The second step of the <i>Alice</i> test is satisfied when the claim limitations involve more than performance of ‘well understood, routine, [and] conventional activities previously known to the industry.’” <i>Berkheimer</i> at 12.</p> <p>- a purported improvement creates a factual dispute that the claim is directed to something more than WRC activities.</p> <p>“Whether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination.” <i>Berkheimer</i> at 14.</p> <p>“The improvements in the specification, to the extent they are captured in the claims, create a factual dispute regarding whether the invention describes well-understood, routine, and conventional activities.” <i>Berkheimer</i> at 15.</p>	<p><i>Alice</i> Step 2A – is the claim directed to an abstract idea?</p> <p>Wirelessly communicating status information about a system is similar to abstract ideas we have found in our previous cases. <i>Chamberlain</i> at 6.</p> <p>– is the purported improvement WRC?</p> <p>“Nor do the asserted claims ‘focus on a specific means or method that improves the relevant technology’ . . . or ‘effect an improvement in any other technology or technical field’ . . . The specification admits that the act of transmitting data wirelessly is ‘well understood in the art,’ and no other changes to the generically claimed movable barrier operator are recited in the asserted claims or described in the specification.” <i>Chamberlain</i> at 7.</p> <p><i>Alice</i> Step 2B – is the claim as a whole WRC?</p> <p>[T]here are two distinct questions: (1) whether each of “the [elements] in the claimed [product] (apart from the natural laws themselves) involve well-understood, routine, conventional activity previously engaged in by researchers in the field.</p> <p>(2) whether all of the steps “as an ordered combination add nothing to the laws of nature that is not already present when the steps are considered separately’ . . . In other words, beyond the idea of wirelessly communicating status information about a movable barrier operator, what elements in the claim may be regarded as the ‘inventive concept’?”</p>

Confusing the Search for Something More

Notice the key difference: in *Berkheimer*, the improvement is assessed in Step 2B, while the improvement is assessed in Step 2A in *Chamberlain*. And yes, it matters when you assess the improvement. Why? Because, as stated before, when the improvement is assessed in 2B, it becomes a showing of something more. But if the improvement is assessed in 2A, the claim now needs to have something more than the improvement in 2B. And if *Chamberlain*'s assessment of patentability is utilized, once the purported improvement is found to be an abstract idea under 2A, then there's nothing to save the claim from unpatentability under 2B, practically speaking. The purported improvement is always a claim's basis. So, if that's an abstract idea, what is even the point of looking at the rest of the claim in 2B?

Another reason the disparity between these decisions is not a good thing is because it confuses us! On the heels of *Berkheimer*, the USPTO promulgated the new Section 101 Guidelines in January. These are lovely, lovely guidelines that told the Examining Corp to look for an improvement as a separate step from the traditional 2A "is this an abstract idea?" step. (Prong Two considerations: "Limitations that are indicative of integration into a practical application: Improvements to the functioning of a computer or to any other technology or technical field – see MPEP 2106.05(a).")

Could Have, Should Have

What if the *Chamberlain* panel had found that the main reason for a finding of unpatentability was that the claim failed to recite how the wireless communication was for specific implementation to a special purpose machine? That is, CGI's wireless communication system could have been implemented generically to many types of machines and apparatuses, not just to a garage door.

The *Chamberlain* panel actually suggested that they considered this issue into their finding of patentability. ("[T]he '275's claims, like Bascom's, are patent-eligible

because they ‘carve out’ a specific implementation (a specific type of operator with an integrated controller and wireless transmitter to transmit status information) that provide [sic] greater flexibility than the prior art physical interfaces approach.” *Chamberlain* at 10.)

If that’s the case, then it’s not the most unreasonable grounds for a finding of unpatentability. The panel could have said that CGI’s improvement (the wireless communication system) failed to show something more than what is WRC because the claim failed to recite how the wireless communication was specifically to be implemented into a special machine or apparatus. But they could have done all of that in 2B and remained consistent with *Berkheimer*, without turning the WRC standard onto the purported improvement in 2A. The Patent Trial and Appeal Board actually does it all the time. (See *Ex Parte Olson*, **Appeal 2017-006489 (PTAB Mar. 25, 2019)**; *Ex Parte Kimizuka*, **Appeal 2018-001081 (PTAB May 15, 2019)**; *Ex Parte Savescu*, **Appeal 2018-003174 (PTAB Apr. 1, 2019)**; *Ex Parte Fautz*, **Appeal 2019-000106 (PTAB May 15, 2019)**).

There was no need to parse out the purported improvement in 2A and apply the WRC test to the improvement in 2A. The *Chamberlain* decision cites a lot of precedent that appears to have done something similar, namely *Core Wireless v. LG*. But if the Federal Circuit was telling us that they were willing to change course in *Berkheimer*, what is the point of *Chamberlain*? Really, what is “something more” anyway?