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Result Orientation Test for an Abstract Idea: Demise of the Means-Plus-Function Claim?

BY [JUN LIN](#)/ ON NOVEMBER 17, 2018



Patent is an important legal tool for inventors to protect their interests in their inventions. But what kind of inventions exactly? Statutorily, an eligible invention needs to be a “process, machine, manufacture, or composition of matter.”^[1] However, not every subject-matter that facially falls under one of the four categories may receive patent protection. Indeed, the Supreme Court has carved out exceptions to patentability: Laws of nature, natural phenomena, and abstract ideas are unpatentable.^[2] Among them, abstract ideas are the most difficult to define. As a result, the abstract idea exception generates the greatest legal uncertainty.

Whether a subject-matter can be patented is generally analyzed under the two-step *Alice* test.^[3] Under this test, the court first determines whether the patent claim is “directed to one of those patent-ineligible concepts” such as abstract ideas.^[4] If not, the claimed subject-matter is eligible for patent. But if it is directed to an ineligible concept, the court then “search[es] for an inventive concept” which can “transform the nature of the claim into a patent-eligible application.”^[5] The claim is determined to be ineligible if such search fails.

Commentators have criticized the obscurity of the *Alice* test, and particularly the difficulty in determining when an idea is abstract.^[6] In an attempt to clarify what constitutes an abstract

idea, the Federal Circuit recently articulated in *Interval Licensing LLC v. AOL, Inc.* a result orientation test.^[7]

The patent in *Interval Licensing* relates to an “attention manager” in a display device, which uses the “space in the display not used by the user’s primary interaction” to display other content.^[8] Put in another way, when the user opens an application that occupies a portion of a display screen, the attention manager displays other content in an unoccupied space of the display, such as an image provided by a content provider.^[9] The Federal Circuit found that the patent claim is directed to an abstract idea because “the term [attention manager] as properly construed simply demands the production of a desired result (non-interfering display of two information sets) without any limitation on how to produce that result.”^[10] Therefore, the Federal Circuit provided a seemingly categorical test for an abstract idea: If a claim’s language is result-oriented, the claim is directed to an abstract idea.

However, another name of a result-oriented claim may just be a means-plus-function claim, which allows claiming “not a particular machine, or even a particular series of steps for achieving a goal, but the goal itself.”^[11] It is well understood that a means-plus-function claim is not unpatentable *per se*. The Patent Act specifically permits a means-plus-function claim.^[12] Moreover, a means-plus-function claim has been allowed by courts and has become a popular practice, especially in software industry.^[13] In light of this, it is doubtful what the Federal Circuit really meant in its discussion about result-oriented claims. The Federal Circuit described the claim as “simply demand[ing] the production of a desired result.”^[14] Does it simply mean that the claim is a means-plus-function claim? If so, it is hard to imagine that the Federal Circuit wanted to deem all means-plus-function claims directed to abstract ideas and potentially unpatentable subject-matters. Such an understanding would effectively be an announcement of the death of a means-plus-function claim. Then, is the result orientation test simply a clue? And is that clue particularly useful as to software invention’s abstractness?

Perhaps the underlying concern of the *Interval Licensing* court is preemption:^[15] If a claim does not specify how to achieve its desired result, it may cover all the possible solutions that are capable of achieving the same result.^[16] But preemption should not be a problem because functional features in means-plus-function claims must be construed to be the “corresponding structure, material, or acts described in the specification and equivalents thereof.”^[17] That is, even if a means-plus-function claim facially covers all possible solutions that can achieve a desired result, the actual scope of the claim is narrowed to specific features, or specific algorithms in this case, disclosed in the patent specification and their equivalents.^[18] Therefore, the *Interval Licensing* claims are unlikely to preempt all possible solutions. If what the court meant was really a means-plus-function claim, its preemption rationale seems unrooted.

On the other hand, this case might not be just about the claim's result-oriented language. The Federal Circuit found that the patent specification "lack[ed] any description for how a display device would ensure the segregation of the two sets of information presented on a display screen."^[19] In other words, not only the claim but also the specification was result-oriented: The required corresponding features, which should serve as the bases of claim construction, did not exist. However, even if the patent specification failed to disclose how to achieve the result, this should be an enabling issue,^[20] instead of a subject-matter eligibility issue. The court's reasoning would confuse subject-matter eligibility inquiry with enabling inquiry and further complicate the problem. Ultimately, the effect and reach of the court's broad language rejecting result-oriented claims as directed to abstract ideas is unclear, and more clarifications are needed if the result orientation test is to bring certainty in the already-complicated *Alice* test.

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^[1] 35 U.S.C §101 ("Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.").

^[2] See, e.g., *Parker v. Flook*, 437 U.S. 584 (1978).

^[3] See *Alice Corp. Pty. v. CLS Bank Int'l*, 134 S. Ct. 2347.

^[4] *Id.* at 2355.

^[5] *Id.* (internal quotation marks omitted) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1303 (2012)).

^[6] See Gene Quinn, *It is time to define the term 'Abstract Idea'*, IPWatchdog (May 18, 2017), <https://www.ipwatchdog.com/2017/05/18/time-define-term-abstract-idea/id=83393/>.

^[7] See *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335 (Fed. Cir. 2018).

^[8] *Id.* at 1338-39.

^[9] *Id.* at 1339.

^[10] *Id.* at 1345.

[11] Mark A. Lemley, *Software Patents and the Return of Functional Claiming*, 2013 Wis. L. Rev. 905, 907 (2013).

[12] As 35 U.S.C. § 112 says:

An element in a claim for a combination may be expressed as a means or step for performing a specified function *without the recital of structure, material, or acts in support thereof*, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. § 112 (emphasis added).

[13] See Lemley, *supra* note 11, at 905.

[14] Interval Licensing, *supra* note 7, at 1345.

[15] See, e.g., *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 9, 12 (1946) (When “the claim thus describes [its limitation] in terms of what it will do rather than in terms of its own physical characteristics or its arrangement,” “the broadness, ambiguity, and overhanging threat of the functional claim” may frighten “the course of experimentation” and impede the evolution of inventive genius.).

[16] See Interval Licensing, *supra* note 7, at 1345 (“Instead of claiming a solution for producing that result, the claim in effect encompasses all solutions.”).

[17] 35 U.S.C. § 112.

[18] See, e.g., *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (It is “required by statute to look to [the] specification and construe the ‘means’ language recited . . . as limited to the corresponding structure disclosed in the specification and equivalents thereof.”).

[19] Interval Licensing, *supra* note 7, at 1345.

[20] See 35 U.S.C. § 112.