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A legal look at Patent Trial and Appeal Board decisions and trends

Image Scanning Patent Found Patent Subject Matter Eligible By Delaware District Court

By Christopher A. Baxter

Intellectual Ventures I, LLC and Intellectual Ventures II, LLC sued multiple Canon business entities in the United States District Court for the District of Delaware alleging infringement of nine patents, including patent no. 6,130,761 (“the ‘761 patent”), titled “Image Scanning Method.” Claim 1 of the ‘761 patent recites:

An image scanning method for a scanner, the method comprising the steps of:

determining a driving signal, a triggering signal, and a number of rotation steps according to a predetermined resolution, wherein a period T_G of the triggering signal equals a period T_M of the driving signal multiplied by the number of rotation steps N within the period T_G ;

driving a motor by the driving signal;

outputting an image signal by the triggering signal; and

storing the image signal within the period of the triggering signal.

Intellectual Ventures I, LLC v. Canon Inc., No. 13-473-SLR, slip op. at 40 (D. Del. Nov. 9, 2015).

As part of the opinion, the court determined the patent subject matter eligibility of claim 1 of the ‘761 patent. In doing so, the court analyzed claim 1 under the subject matter eligibility framework set out in *Alice v. CLS Bank Int’l*. 573 U.S. ____, 134 S. Ct. 2347 (2014) [hereinafter *Alice*]. The *Alice* framework contains two steps. First, it is determined whether the claims are directed to a law of nature, natural phenomena, or abstract idea. *Intellectual Ventures I, LLC*, Civ. No. 13-473-SLR, at *42. The claims are then analyzed to determine whether the claims amount to significantly more than the patent ineligible concept. *Id.* at *42-43. The second step is only performed if the claims are determined as being directed to one of the subject matter ineligible concepts under the first step. *Id.* at *42. Claims that amount to significantly more are subject matter eligible. Claims that do not amount to significantly more are patent subject matter ineligible.

Regarding step 1, the court held claim 1 of the ‘761 patent subject matter eligible. The court stated claim 1 includes steps for determining multiple parameters that meet a certain mathematical formula, and applies the parameters to operate a specific device, i.e., a scanner. *Id.* at *47. The court thus reasoned that claim 1 neither merely claims a mathematical formula nor seeks to merely implement a mathematical formula, and therefore held claim 1 is not directed to an abstract idea. *Id.*

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Even though the framework under *Alice* would have allowed the court to stop their analysis after step 1, the court additionally analyzed the asserted claims under step 2 of the *Alice* framework. The court noted the language of claim 1 contains the steps of determining three parameters used to “drive a motor, output an image signal, and store the image signal.” *Id.* at *48 (internal quotation marks omitted). The court reasoned that these “limitations are of sufficient specificity and describe a particular method for a scanner;” and therefore held claim 1 contains an inventive concept that renders the claim subject matter eligible. *Id.*

The court also considered the issue of pre-emption. As the court noted, “[t]he pre-emption inquiry focuses on whether the patent ‘would risk disproportionately tying up the use of the underlying ideas.’” *Id.* (citing *Alice*, 134 S. Ct. at 2354). The court held “the claimed solution [of the ‘761 patent] is described with enough specificity to place meaningful boundaries on the inventive concept.” *Id.* Part of the ‘761 patent states:

Th[e] invention relates to an image scanning method for a scanner. More particularly, this invention relates to an image scanning method that can improve the image scanning rate by determining the period of the driving signal and the number of rotating steps of the driving motor, and calculating the period of triggering signal for the light-sensitive devices according to a predetermined resolution.

Id. at *39. Even though the court did not explicitly provide rationale with respect to its preemption holding, it may be deduced from the court’s analysis of steps 1 and 2 above that the court found no pre-emption because the invention is limited to a scanner.

Takeaways

District courts are willing to hold patents, subject to *Alice* scrutiny, patent subject matter eligible. Claim 1 of the ‘761 patent and the court’s analysis suggest it may be beneficial to limit claims subject to *Alice* attacks to a particular device.

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