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# The Relative Importance of Intrinsic Evidence in the *Alice* "Directed to" Inquiry

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In *SRI International, Inc. v. Cisco Systems, Inc.*,[1] a divided panel of the Federal Circuit held that a claim reciting a method for detecting computer network intrusions was patent-eligible.[2] This decision is the latest in a growing list of decisions holding software claims eligible under the first step of the inquiry set forth in *Alice Corp. v. CLS Bank International*.[3] The majority and dissenting opinions in *Cisco* highlight an issue underlying the Federal Circuit's patent eligibility jurisprudence that has yet to be resolved: the relative importance of the patent specification and the claim language in the eligibility analysis.

The patents-in-suit, U.S. Patent Nos. 6,484,203 and 6,711,615, claim methods and systems for detecting suspicious computer network activity based on analyzing network traffic data.[4] The district court denied Cisco's motion for summary judgment on ineligibility.[5] After a jury trial and post-trial briefing, Cisco appealed from the final judgment on several issues: eligibility, claim construction, anticipation, willful infringement, enhanced damages, attorneys' fees, and ongoing royalties.[6]

The Federal Circuit affirmed-in-part, vacated-in-part, and remanded.[7] The Court vacated the district court's decision on willful infringement, enhanced damages, and attorneys' fees, but affirmed the district court on eligibility, claim construction, no anticipation, and ongoing royalties.[8] Taking claim 1 of the '615 patent as representative,[9] the Court held that the asserted claims are not directed to an abstract idea, and resolved the eligibility issue at *Alice* step one.[10] The Court concluded that the claims are directed to a technological solution for solving a technological problem.[11] The Court identified the solution as "using a plurality of network monitors that each analyze specific types of data

[1] No. 2017-2223 (Fed. Cir. Mar. 20, 2019).

[2] SRI Int'l, Inc. v. Cisco Sys., Inc., No. 2017-2223, slip op. at 8 (Fed. Cir. Mar. 20, 2019).

[3] 573 U.S. 208 (2014).

[4] *Cisco*, slip op. at 4–5.

[5] *Id.* at 7.

[6] *Id.* at 2, 7.

[7] *Id.* at 2.

[8] *Id.* at 2.

[9] *Id.* at 4–5.

[10] *Id.* at 8; *see* Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 573 U.S. 208, 217 (2014) ("First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts.").

[11] Cisco, slip op. at 8.

on the network and integrating reports from the monitors," and identified the problem as "identifying hackers or potential intruders into the network."[12] The majority noted that the focus of the claims is on "providing a network defense system that monitors network traffic in real-time to automatically detect large-scale attacks," and pointed to the specification's descriptions of vulnerabilities in conventional computer networks that the invention purported to solve.[13]

The Court rejected all of Cisco's arguments to the contrary. The Court distinguished the instant claims from the claims in *Electric Power Group, LLC v. Alstom S.A.*,[14] finding that the claims in *Electric Power Group* dealt with using computers as tools to solve "a power grid problem," while the instant claims dealt with "improving the functionality of computers and computer networks themselves"[15]—in other words, solving "a specific computer problem."[16] The Court also disagreed with Cisco's argument that the claims are so broad as to encompass human mental activity, finding that "the human mind is not equipped to detect suspicious activity by using network monitors and analyzing network packets as recited by the claims."[17]

Judge Lourie dissented from the majority's holding that the asserted claims were patent-eligible.[18] He noted that no technological improvement is claimed; in his view, the claims only recite the moving of information.[19] Judge Lourie found the instant case "hardly distinguishable from *Electric Power Group*," with respect to both steps of the *Alice* inquiry.[20] He further noted that the claims as written "do not recite a *specific way* of enabling a computer to monitor network activity," and that the majority relied on language in the specification that "only recites results, not means for accomplishing them."[21] Because he would have found the claims to be ineligible, Judge Lourie would not reach the other issues.[22]

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[12] *Id.*
[13] *Id.* at 9.
[14] 830 F.3d 1350 (Fed. Cir. 2016).
[15] *Cisco*, slip op. at 9–10.
[16] Ancora Techs. v. HTC Am., Inc., 908 F.3d 1343, 1348 (Fed. Cir. 2018).
[17] *Cisco*, slip op. at 10–11.
[18] *Id.* at 1 (Lourie, J., dissenting).
[19] *Id.* at 3.
[20] *Id.* at 3–4.
[21] *Id.* at 4.
[22] *Id.*

In the immediate aftermath of the Supreme Court's decision in *Alice*, the lower courts and the United States Patent and Trademark Office relied on reasoning by analogy to determine whether claims were directed to an abstract idea.[23] This methodology then gradually shifted to one based on clustering of ideas previously identified by courts as abstract based on common characteristics. New claims were compared to these conceptually broader categories to determine whether they were directed to an abstract idea.[24] But even then, the methodology for analyzing step one of *Alice* was based on analyzing the degree of similarity between the instant claims and claims that came before.

Enter *Enfish, LLC v. Microsoft Corp.*[25] In *Enfish*, the Federal Circuit for the first time clearly held that a computer-implemented method was patent-eligible at *Alice* step one.[26] And soon after, the Court followed up with a similar holding in *McRO, Inc. v. Bandai Namco Games America Inc.*[27] The key rationale underlying both *Enfish* and *McRO* was that the claims at issue were directed to improvements in computer-related technology.[28] Thus, for computer-related technologies, claims that were deemed to be directed to "improvements" to technological results in conventional industry practice were now patent-eligible under *Alice* step one. And because claims are not required to explicitly specify a field of technology or the claimed improvement thereto,[29] courts increasingly relied on inventors' assertions in the specification to bolster their conclusions that certain claims were directed to technological im-

[23] *See, e.g.*, 2014 Interim Guidance on Patent Subject Matter Eligibility, 79 Fed. Reg. 74618, 74622 (Dec. 16, 2014).

[24] *See, e.g.*, U.S. Patent and Trademark Office, July 2015 Update on Subject Matter Eligibility 3–5 (July 30, 2015), https://www.uspto.gov/sites/default/files/documents/ieg-july-2015-update.pdf.

[25] 822 F.3d 1327 (Fed. Cir. 2016).

[26] The Court did previously discuss similar rationales in holding that certain webpage display technologies were patent-eligible. *See* DDR Holdings, LLC v. Hotels.com, L.P., 773 F.3d 1245, 1257 (Fed. Cir. 2014) ("the claimed solution is necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks"). But in DDR, the Court did not explicitly resolve the *Alice* step one inquiry. Instead, it simply held that under any characterization of the alleged abstract idea proffered by the defendants or the dissent, *Alice* step two was satisfied. *Id.*

[27] 837 F.3d 1299 (Fed. Cir. 2016).

[28] *See* Enfish, LLC v. Microsoft Corp., 822 F.3d 1327, 1336 (Fed. Cir. 2016); McRO, Inc. v. Bandai Namco Games Am. Inc., 837 F.3d 1299, 1314 (Fed. Cir. 2016).

[29] None of the representative claims considered by the Federal Circuit in post-*Alice* patent eligibility decisions involved Jepson claims.

provements rather than abstract ideas. Thus, assertions in the specification regarding the state of the prior art and the purported problem solved by the claimed invention became relevant evidence of patent eligibility.

The result has been a bifurcated analysis at step one of *Alice*. On one hand, courts' determinations that claims are directed to abstract ideas are justified by comparing the claims at issue to similar claims that have been determined to be directed to abstract ideas in the past. On the other hand, courts' determinations that claims are *not* directed to abstract ideas are justified by looking to the purported technological improvements asserted in the specification and extrinsic evidence of the importance of the technology the claims purport to cover. Thus, it seems to follow that the argument a court will find more convincing must depend in part on the court's philosophy on the proper role of claim construction in the patent eligibility analysis. This prompts the question—what if a claim is literally similar to claims previously determined to be directed to an abstract idea, but the specification asserts that the claimed invention is a technological solution to a technological problem?

This conflict is clearly illustrated in *Cisco* by the difference in how the majority opinion and the dissenting opinion characterized the representative claim. The majority relied heavily on the specification and characterized the *focus* of the claim as "providing a network defense system that monitors network traffic in real-time to automatically detect large-scale attacks,"[30] despite real-time monitoring and large-scale attack detection not literally being recited in the claim. In contrast, the dissenting opinion noted that the claim recites detecting suspicious activity based on "analysis" of traffic data, but does not *actually* claim any improvement, because "[t]here is no specific technique described for improving computer network security."[31] In short, the majority leaned on the specification's assertion of technical improvements to find eligibility, and the dissent leaned on the claim's similarity to previously adjudged abstract ideas to find ineligibility.

Currently, there is no requirement that claims be construed before any eligibility determination. While the Supreme Court has repeatedly cautioned against interpreting Section 101 "in ways that make patent

[30] *Cisco*, slip op. at 9.
[31] *Id.* at 3 (Lourie, J., dissenting).

eligibility 'depend simply on the draftsman's art,' "[32] the development of this bifurcated *Alice* step one analysis—especially in the absence of clear guidance on the relative weights to be given to different types of intrinsic evidence—is likely to result in continued uncertainty in patent eligibility jurisprudence. ■

[32] *Alice*, 573 U.S. at 226 (quoting Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66, 72 (2012)).