
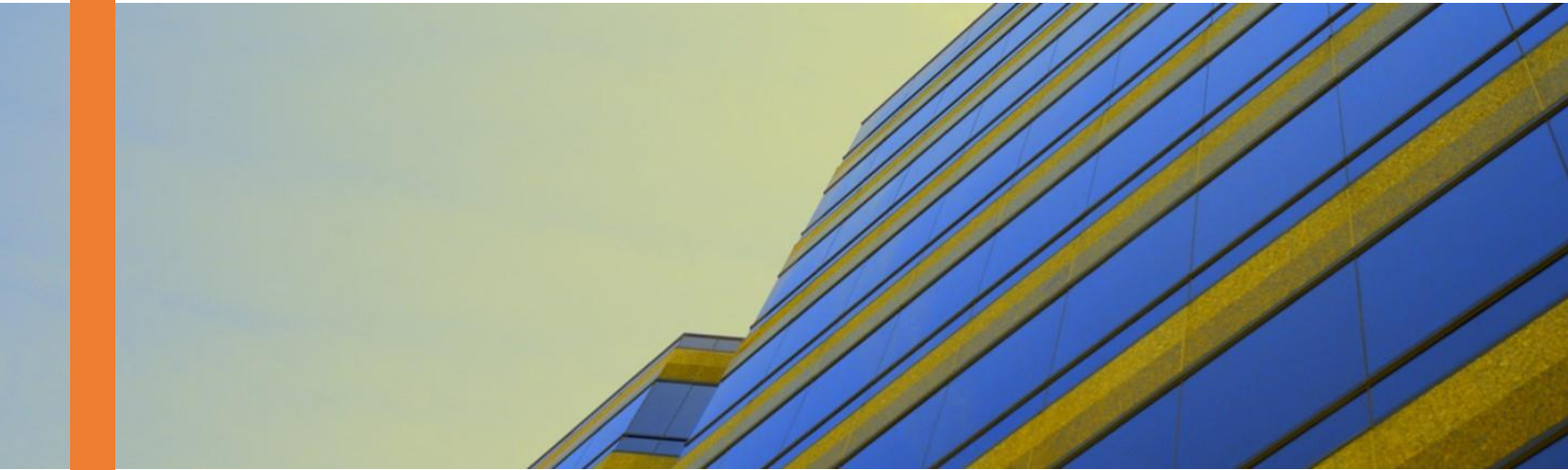




STEVEN E. BERKHEIMER V. HP INC.



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Steven E. Berkheimer v. HP Inc.

In *Steven E. Berkheimer v. HP Inc.*, 2017-1437 (Fed. Cir. Feb. 8, 2018), the Federal Circuit affirmed the district court's summary judgment that claim 1 (among other claims) of U.S. Patent No. 7,447,713 (the '713 Patent) is patent-ineligible under 35 U.S.C. 101, but reversed the district court's summary judgment that claims 4 and 5 (among other claims) of the '713 Patent are patent-ineligible.

The '713 Patent is directed to archiving files. Different files can have portions (objects) that are the same. A main aspect of the invention in the '713 Patent is to archive files by linking the objects (that are in common) to one another, such that an update to one of the objects of one file can be reflected in linked objects of other files.

The specification of the '713 Patent provides the following:

By eliminating redundancy in the archive 14, system operating efficiency will be improved, storage costs will be reduced and a one-to-many editing process can be implemented wherein a singular linked object, common to many documents or files, can be edited once and have the consequence of the editing process propagate through all of the linked documents and files. The one-to-many editing capability substantially reduces effort needed to up-date files which represent packages or packaging manuals or the like as would be understood by those of skill in the art.

Claims 1, 4, and 5 of the '713 Patent read:

1. A method of archiving an item comprising in a computer processing system:
 - presenting the item to a parser;
 - parsing the item into a plurality of multi-part object structures wherein portions of the structures have searchable information tags associated therewith;
 - evaluating the object structures in accordance with object structures previously stored in an archive;
 - presenting an evaluated object structure for manual reconciliation at least where there is a predetermined variance between the object and at least one of a predetermined standard and a user defined rule.
4. The method as in claim 1 which includes storing a reconciled object structure in the archive without substantial redundancy.
5. The method as in claim 4 which includes selectively editing an object structure, linked to other structures to thereby effect a one-to-many change in a plurality of archived items.

The Federal Circuit found that claim 1 is not patent eligible under 35 U.S.C. 101, since parsers and parsing functions are conventional in the art, the analysis and comparison of data, to reconcile differences between two objects, fail to transform the abstract idea into something patent-eligible, and the claim does not contain limitations that relate to the benefits of the invention.

In contrast, the Federal Circuit found that dependent claims 4 and 5 may be patent eligible, since these claims contain limitations relating to the benefits of the invention—i.e., the recitation “without substantial redundancy” in claim 4 and the recitation “to thereby effect a one-to-many change in a plurality of archived items” in claim 5 relate to the benefit of redundancy elimination, which leads to increased operating efficiency and reduces storage costs.

This opinion illustrates the potential importance of including claim limitations that directly relate to the technological improvements described in the patent's specification, since this might help with the question of subject matter eligibility (particularly Step 2 of the Alice test).