Eligibility: Which Case Will the SCT Choose as its Vehicle?

September 29, 2021Dennis Crouch

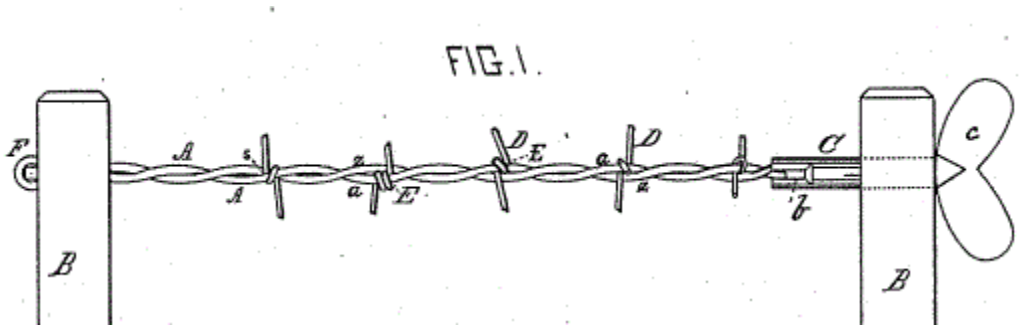
ENCO Systems, Inc. v. DaVincia, LLC (Supreme Court 2021)

In March 2021 the Federal Circuit sided with the patent challenger DaVincia — affirming that ENCO's patent claims were invalid as directed to an abstract idea. Now, ENCO has petitioned the Supreme Court with the following general question:

> *What is the appropriate standard for determining whether a patent claim is directed to a patent-ineligible concept when determining whether an invention is eligible for patenting under 35 U.S.C. § 101?*

[Petition]

ENCO and DaVincia compete in the market for automated captioning of audio signals. ENCO did not invent the general concept, but its patent brings together a number of important features make it workable and with a 2000 application priority filing date.



In some ways, this case reminds me of the Supreme Court's Barbed-Wire decision in *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U.S. 275 (1892) where the court explained:

The difference between the [prior art] Kelly fence and the Glidden fence [at issue] is not a radical one, but, slight as it may seem to be, it was apparently this which made the barbed–wire fence a practical and commercial success.

Id. The 1892 case focused on obviousness rather than abstraction. And, barbed-wire was generally seen as a fundamental and transformative invention of American westward expansion. It allowed for 'taming' of the land and closing of the open range.

The invention here is directed to a method of automated captioning of an AV signal. The inventors did not invent this general idea, but the claims include a number of features that make it more workable.

- Choosing how many lines of text to see at once;
- automatically identifying voice and speech patterns;
- training on new words and using that training to improve the captioning;
- synchronizing the caption data with one or more cues in the AV signal;
- etc.

Unlike Barbed-wire Glidden who did have a novel way of wrapping wire compared with the prior art, I don't believe that any of ENCO's individual elements have a point of novelty. Rather, the novelty of the invention involves putting them all together into a method that works.

In its decision, the Federal Circuit ruled that ENCO's claims were directed to "simply the abstract idea of automating the AV captioning process." But, the claims did not provide any specific technological improvement: "The advance is only at the abstract level of computerization because claim 1 fails to set forth specific techniques for processing the data, instead reciting known computer techniques for automation of known processes."

ENCO's petition argues that "the Federal Circuit reached the wrong result" since the patent claims a "method of solving a technological problem using physical components executing defined steps to produce a tangible result."

The petition also boldly makes a prediction: “The question is not whether the Court will review its eligibility test, but which case it will choose as its vehicle.”