

## Federal Circuit Patent Bulletin: *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*

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July 14, 2014

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On July 11, 2014, in *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, the U.S. Court of Appeals for the Federal Circuit (Moore, Reyna,\* Hughes) affirmed the district court's summary judgment that U.S. Patent No. 6,128,415, which related to a device profile and a method for creating a device profile within a digital image processing system, was invalid under 35 U.S.C. § 101. The Federal Circuit stated:

Pursuant to section 101, an inventor may obtain a patent for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof." For all categories except process claims, the eligible subject matter must exist in some physical or tangible form. To qualify as a machine under section 101, the claimed invention must be a "concrete thing, consisting of parts, or of certain devices and combination of devices." To qualify as a manufacture, the invention must be a tangible article that is given a new form, quality, property, or combination through man-made or artificial means. Likewise, a composition of matter requires the combination of two or more substances and includes all composite articles.

Here, the device profile described in the '415 patent is not a tangible or physical thing and thus does not fall within any of the categories of eligible subject matter. [T]he device profile is comprised of two sets of data that describe a device dependent transformation—one set of data for color information and the other set of data for spatial information. The asserted claims are not directed to any tangible embodiment of this information (i.e., in physical memory or other medium) or claim any tangible part of the digital processing system. The claims are instead directed to information in its non-tangible form. Hence, the device profile claimed in the '415 patent does not fall within any of the categories of eligible subject matter under section 101. Digitech argues that a device profile is subject matter eligible because it is "hardware or software within a digital image processing system" and exists as a tag file appended to a digital image. Digitech's position is not supported by the claim language, which does not describe the device profile as a tag or any other

embodiment of hardware or software. The claims' only description of the device profile is that it comprises "first data for describing" color information and "second data for describing" spatial information. The claims encompass all embodiments of the information contained in the device profile, regardless of the process through which this information is obtained or the physical medium in which it is stored. Data in its ethereal, non-physical form is simply information that does not fall under any of the categories of eligible subject matter under section 101. . . .

There is no dispute that the asserted method claims describe a process. Claims that fall within one of the four subject matter categories may nevertheless be ineligible if they encompass laws of nature, physical phenomena, or abstract ideas. The Supreme Court recently reaffirmed that fundamental concepts, by themselves, are ineligible abstract ideas. In determining whether a process claim recites an abstract idea, we must examine the claim as a whole, keeping in mind that an invention is not ineligible just because it relies upon a law of nature or mathematical algorithm. As noted by the Supreme Court, "an application of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection." A claim may be eligible if it includes additional inventive features such that the claim scope does not solely capture the abstract idea. But a claim reciting an abstract idea does not become eligible "merely by adding the words 'apply it.'"

The method in the '415 patent claims an abstract idea because it describes a process of organizing information through mathematical correlations and is not tied to a specific structure or machine. [The] claim recites a process of taking two data sets and combining them into a single data set, the device profile. The two data sets are generated by taking existing information—i.e., measured chromatic stimuli, spatial stimuli, and device response characteristic functions—and organizing this information into a new form. The above claim thus recites an ineligible abstract process of gathering and combining data that does not require input from a physical device. [T]he two data sets and the resulting device profile are ineligible subject matter. Without additional limitations, a process that employs mathematical algorithms to manipulate existing information to generate additional information is not patent eligible. "If a claim is directed essentially to a method of calculating, using a mathematical formula, even if the solution is for a specific purpose, the claimed method is nonstatutory."