

2018-1451

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re: ALLSCRIPTS SOFTWARE, LLC,

Appellant.

Appeal from the United States Patent and Trademark Office,
Patent Trial and Appeal Board in Application Serial No. 14/320,355

UNOPPOSED MOTION FOR REMAND

Appellee, the Director of the United States Patent and Trademark Office (USPTO), respectfully moves pursuant to Fed. Cir. R. 27(f) to remand this appeal to the Agency to permit further proceedings in light of this Court's decision in *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), *reh'g and reh'g en banc denied*, 2018 WL 2437140 (Fed. Cir. May 31, 2018). Counsel for Appellant Allscripts Software, LLC, Mr. Jeremy Doerre, has been contacted and states that his client will not oppose this motion.

This appeal arises from the *ex parte* appeal decision of the Patent Trial and Appeal Board (Board), affirming the final rejection of claims 1-20 under 35 U.S.C. § 101 in Application Serial No. 14/320,355. In reaching its decision, the

Board held that § 101 is an issue of law and that while evidence “may be helpful in certain situations,” there is no requirement to support a § 101 rejection with evidence under the patent-eligibility analysis articulated in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014). After the Board issued the decision on appeal, this Court issued its decision in *Berkheimer*, holding that the question of whether a claim element is well-understood, routine, and conventional under *Alice* Step #2 is a question of fact and requires evidentiary support, particularly where the issue is disputed. Appellant Allscripts asserts that the Board decision here is inconsistent with *Berkheimer*. Additionally, the USPTO has since issued guidance implementing *Berkheimer* in *ex parte* examinations like this one. See *Changes in Examination Procedure Pertaining to Subject Matter Eligibility, Recent Subject Matter Eligibility Decision* (Berkheimer v. HP, Inc.) (Apr. 19, 2018) (available at <https://www.uspto.gov/sites/default/files/documents/memo-berkheimer-20180419.PDF>).

The Director believes that it is in the best interest of the parties and this Court to remand the case to the USPTO to allow the Agency to reconsider the patent eligibility of the pending claims in light of *Berkheimer* and related USPTO guidance. A remand to permit further administrative proceedings in light of these subsequent developments would prevent this Court, Allscripts, and the USPTO from needlessly expending resources. See, e.g., *In re Gould*, 673 F.2d 1385, 1387 (CCPA 1982). That is particularly true under these circumstances, where the intervening developments relate to factual issues that should be considered by the Agency in the first instance. This

Court has previously granted remands to the Agency for further proceedings to reconsider issues in light of intervening legal precedent. *See, e.g., In re Helferich Patent Licensing, LLC*, Appeal No. 2017-1293, ECF No. 28 (May 19, 2017) (nonprecedential) (remanding to USPTO for further proceedings in light of intervening decision in *Perfect Surgical Techniques, Inc. v. Olympus America, Inc.*, 841 F.3d 1004 (Fed. Cir. 2016)); *see also SKF USA Inc. v. United States*, 254 F.3d 1022, 1028 (Fed. Cir. 2001) (discussing agency remands based on “intervening events outside of the agency’s control, for example a new legal decision or the passage of new legislation”).

The Director therefore moves for the decision of the Patent Trial and Appeal Board to be vacated and the appeal to be remanded to the USPTO for further proceedings. Because this motion “if granted, would terminate the appeal,” the Director respectfully requests that the time to serve and file the Director’s brief (currently due June 13, 2018) be suspended. *See* Fed. Cir. R. 31(c).

June 4, 2018

Respectfully submitted,

/s/ Robert J. McManus

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RULE 32(g) CERTIFICATE OF COMPLIANCE

I certify pursuant to Fed. R. App. P. 32(g) that the foregoing UNOPPOSED MOTION FOR REMAND complies with the type-volume limitation required by the Court's rule. The total number of words in the foregoing motion is 550 words as calculated using the Word® software program.

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CERTIFICATE OF SERVICE

I hereby certify that on June 4, 2018, I electronically filed the foregoing UNOPPOSED MOTION FOR REMAND using the Court's CM/ECF filing system. Counsel of record was electronically served via e-mail through and by the electronic filing system per Fed. Cir. R. 25(e).

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