Berkheimer: An Overcorrection in the Law of Patentable Subject Matter

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For a patent to be valid, various patentability requirements must be met. Patentable subject matter is a patentability doctrine that has had revived importance over recent years. Under this doctrine, a patent must claim a patentable invention. If a patent fulfills this requirement, it is patent eligible, and it cannot be invalidated under the patentable-subject-matter doctrine.

The way that courts interpret the patentable-subject-matter doctrine is critical to the determination of whether a patent meets the requirement. Over the years though, courts have changed their interpretation of this doctrine. Most recently, the Supreme Court has weighed in on the patentable-subject-matter issue, and in a string of cases, it has renewed the importance of the doctrine in patent law.

The Supreme Court revived the importance of the patentable-subject-matter issue when it created a two-part framework for use in analysis of the issue. The law surrounding this two-part framework has created procedural standards unique to the issue. Specifically, summary-judgment standards specific to the patentable-subject-matter context have been promulgated by the Supreme Court and the Federal Circuit. Over the years, these special standards have proven to be very defendant friendly.

In February of 2018, the Federal Circuit, issued an opinion, Berkheimer v. HP Inc., which attempted to remove some of the special summary-judgment standards for patentable subject matter, and attempted to better align the doctrine with other patentability doctrines. The Federal Circuit did successfully remove some summary-judgment standards specific to patentable subject matter. The Federal Circuit though did not stop there. It also created new summary-judgment standards specific to patentable subject matter, standards that arguably are plaintiff biased. In light of this additional step, which appears be an attempt to remedy the defendant-friendly bias of the doctrine, the Berkheimer decision appears to be an overcorrection in the law of patentable subject matter.

This article will start with an analysis of how courts apply summary-judgment in general, and in the context of patentable-subject-matter. An analysis of the summary-judgment standards applied to patentable subject matter will follow. This analysis will show that in this context, both before and after the Berkheimer decision, courts apply special summary-judgment standards. Furthermore, this article will present an analysis of the Berkheimer decision, and the changes that it enacted. This analysis will show that the case, in fact, promulgates an overcorrection of the doctrine of patentable subject matter. Finally, this article will end by discussing how the Berkheimer overcorrection can be fixed by simply cabining it to the specific case without disturbing the correction promoted by the case.

I. Introduction

To receive patent protection, an invention must, among other requirements, claim patentable subject matter.[2] In the not-so-distant past, patent eligibility was a "dead letter."[3] Recently though, in a string of decisions, the Supreme Court has brought patentable subject matter into the spotlight as an increasingly important patentability doctrine.[4]

In its reinvigoration of the patentable-subject-matter doctrine, the Supreme Court has created a new, two-part framework under which to analyze patent eligibility.[5] Under this two-part framework, courts must first determine if the claimed invention is directed toward any of three categories of patent-ineligible material: laws of nature, products of nature, or abstract ideas.[6] If the invention is directed toward any of the three categories of patent-ineligible material, then the court must move onto the second step of the analysis: the search for an inventive concept.[7] If the claimed invention does have an inventive concept, then it is patent eligible.[8]

This two-step, patent-eligibility framework though has proven to be very bad for patentees and consequently, good for defendants.[9] Procedural considerations are at the center of this defendant-friendly bias of the reinvigorated patent-eligibility doctrine.[10] This paper will focus on summary judgment, a procedural shortcut to end a case before trial, in the patentable-subject-matter context.

The procedure of patent eligibility, and specifically the use of summary-judgment with regard to patent eligibility, is affected by how the courts define what is patentable subject matter. An issue that is central to summary judgment in the patentability context is whether patent eligibility is a question of law or a question of fact. Until recently, patent eligibility was generally understood as a pure question of law with no relevant facts.[11] That being said, in February of 2018, the Federal Circuit,

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2 *General Information Concerning Patents*, U.S. PAT. & TRADEMARK OFF. (Oct. 2015), https://www.uspto.gov/patents-getting-started/general-information-concerning-patents#heading-4 ("The examination of the application consists of a study of the application for compliance with the legal requirements and a search through U.S. patents, publications of patent applications, foreign patent documents, and available literature, to see if the claimed invention is new, useful and non-obvious and if the application meets the requirements of the patent statute and rules of practice. If the examiner's decision on patentability is favorable, a patent is granted.")("[C]ourts have defined the limits of the field of subject matter that can be patented, thus it has been held that the laws of nature, physical phenomena, and abstract ideas are not patentable subject matter.").

3 Paul Gugliuzza, *The Procedure of Patent Eligibility*, 97 TEX. L. REV. 571, 573 (2019) ("For most of the past forty years, the patent-eligible subject matter requirement was a dead letter.").

4 *Id.* ("Most controversially, the Court, in a string of four decisions, has reinvigorated the patent-eligible subject matter requirement. . . .").

5 *Id.* (stating that the Supreme Court has held "that inventions directed to laws of nature, natural phenomena, or abstract ideas are not eligible for patenting unless they also contain an 'inventive concept.'").

6 Alice Corp. Pty. Ltd. v. CLS Bank Intern., 573 U.S. 208, 217 (2014).

7 *Id.*

8 *Id.*

9 *See* discussion *infra*, Section I.C.

10 Gugliuzza, *supra* note 2, at 578 ("Despite what the Federal Circuit's precedent (or lack thereof) might suggest, procedural considerations are key to evaluating the consequences of eligibility doctrine's resurgence.").

11 *See* discussion *infra*, Section II.B.1.

in *Berkheimer v. HP Inc.*, changed that general understanding when it held that patent eligibility is a mixed question of law and fact.[12] Beyond this holding, *Berkheimer* also changed summary judgement in the patent-eligibility context by lowering the burden for a patent owner to overcome a motion for summary judgement on this issue.[13]

The analysis in this paper will show that special summary-judgment standards have been applied in the patent-eligibility context, both before and after the *Berkheimer* decision.[14] This paper will also discuss that *Berkheimer* was a step in the right direction, as it did work to bring the law of patent eligibility in line with the law of other patentability doctrines.[15] In addition though, analysis of *Berkheimer* will show that the case did more than just correct the doctrine of patentable subject matter.[16] In fact, this analysis will build to the main point of this paper: that in *Berkheimer*, the Federal Circuit overcorrected the doctrine of patentable subject matter.[17]

This paper will be split into five substantive parts. Part I provides background on the doctrine of patentable subject matter. Part II will analyze the general rules of summary judgement, and the summary-judgment standards applied in the patentable-subject-matter context, both before and after *Berkheimer*. Part III will analyze the special summary-judgment standards applied to patent eligibility, both before and after *Berkheimer*. Part IV will analyze the impact of *Berkheimer*, completing the final analysis necessary to show that *Berkheimer* is not just a correction in the doctrine of patentable subject matter; it is an overcorrection. Finally, in part V, a possible solution to the overcorrection of the law of patentable subject matter propounded by *Berkheimer* will be proposed.

II. Background: Patent Eligibility

Since this paper is focused on patent eligibility and specifically, summary judgement in the patent-eligibility context, it is necessary to briefly overview patent eligibility. This section of the paper will start out by introducing patent eligibility and providing a brief history of the patentable-subject-matter doctrine. Subsequently, this section will outline three things: (1) the standards currently underlying the doctrine, (2) the doctrine's bias against patent owners, and (3) the updates to the doctrine promoted in *Berkheimer*, a recent Federal Circuit case on patent eligibility.

A. An Introduction to Patent Eligibility

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[12] Berkheimer v. HP Inc., 881 F.3d 1360, 1368 (Fed. Cir. 2018), cert. denied, 18-415, 2020 WL 129532 (U.S. Jan. 13, 2020).

[13] *See* discussion *infra*, Section II.B.2.

[14] *See* discussion *infra*, Section III.

[15] *See* discussion *infra*, Section IV.A.

[16] *See* discussion *infra*, Section IV.B.

[17] *See* discussion *infra*, Section IV.C.

In order to receive a patent in the United States, an inventor must show that the invention for which patent protection is desired qualifies for a patent.[18] United States Patent Law requires that an invention be patent eligible, new, useful, and non-obvious to qualify for patent protection.[19] Patent eligibility, as one of these requirements, is critical to patentability of an invention. In fact, courts have even held that the patent-eligibility requirement is a threshold issue, similar to subject matter jurisdiction, that must be decided at the outset of the case before any other issues are analyzed.[20]

Patent eligibility is governed by 35 U.S.C. § 101. This statute states that "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."[21] Over time, the interpretation of this statute, and consequently, the scope and force of the patentable-subject-matter doctrine, has changed.[22]

In the recent past, courts had a broad definition of what qualifies as patentable subject matter.[23] In 1980, the Supreme Court, in *Diamond v. Chakrabarty*, held that Congress intended patentable subject matter to "include anything under the sun that is made by man."[24] That being said, even under this broad interpretation of what is patent eligible, the Supreme Court still recognized that laws of nature, products of nature, and abstract ideas were not patentable.[25] From the time of *Diamond v. Chakrabarty* to the early 2000's though, the Federal Circuit and the Patent Office narrowed the scope of, and rarely utilized these three exceptions, consequently relaxing the eligibility requirement.[26]

Recently though, the Supreme Court has pivoted, and narrowed its interpretation of what is patent eligible.[27] The Supreme Court began this pivot in 2010, when it

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18 Richard Sim, *Getting a Patent on Your Own*, NOLO, https://www.nolo.com/legal-encyclopedia/getting-patent-yourself-29493.html (last visited March 5, 2019).

19 *See generally General Information Concerning Patents*, U.S. PAT. & TRADEMARK OFF. (Oct. 2015), https://www.uspto.gov/patents-getting-started/general-information-concerning-patents#heading-4 ("In the language of the statute, any person who 'invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent,' subject to the conditions and requirements of the law.").

20 Gugliuzza, *supra* note 2, at 591 ("[A] surprising amount of Federal Circuit case law states that courts must decide patent eligibility before analyzing other issues, regardless of what the parties want or what the court thinks is most efficient. This puzzling insistence that patent eligibility is, like subject matter jurisdiction, a mandatory threshold issue has spurred some Federal Circuit judges and scholars to embrace another extreme. . . .").

21 35 U.S.C § 101 (2018).

22 *See generally* Gugliuzza, *supra* note 2, at 573-74 (describing the evolution of the doctrine of patentable subject matter).

23 *See id.* at 573 ("For most of the past forty years, the patent-eligible subject matter requirement was a dead letter.").

24 Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980) (internal quotation marks omitted).

25 *Id.* at 309 ("This is not to suggest that § 101 has no limits or that it embraces every discovery. The laws of nature, physical phenomena, and abstract ideas have been held not patentable.").

26 *See* Gugliuzza, *supra* note 2, at 582 ("By many accounts, in the 1990s and early 2000s, the Federal Circuit and the Patent Office significantly relaxed the eligibility requirement. They regularly approved patents on computer software and methods of doing business despite the frequently abstract nature of those inventions. They also approved patents on isolated DNA sequences even though those sequences appear in nature.").

27 *Id.* at 571, 573-74.

decided *Bilski v. Kappos*, holding that a method of hedging financial risk was not patentable because it was an abstract idea and consequently did not qualify as patentable subject matter.[28] In 2012, in *Mayo Collab. Servs. v. Prometheus Labs, Inc.*, the Supreme Court held that a patent claiming measurement of a drug's metabolite levels in the body and comparison of those levels with ranges to decide on dosage adjustments was not patentable, as it claimed a law of nature.[29] In 2013, the Supreme Court held that a specific human gene, extracted from a human DNA sequence, was patent ineligible as a product of nature in *Ass'n for Molecular Pathology v. Myriad Genetics, Inc*.[30] Finally, in 2014, in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, the Supreme Court held that patent claims covering the use of a computer system that serves as a third-party intermediary to facilitate exchange of financial obligations were ineligible as an abstract idea.[31]

Bilski, *Mayo*, *Myriad*, and *Alice* reinvigorated the patentable-subject-matter requirement for patents, and as a result, after these decisions, courts have grown increasingly likely to strike down patents on this ground.[32] In fact, these cases have spurred a sea-change in patent litigation; patent eligibility has now become "the central concern in many cases."[33] In turn, it is important to look at the patentable-subject-matter standards that these cases have created.

B. Current Standards for Patentable Subject Matter

The recent Supreme Court cases on patentable subject matter have proffered a two-part test to determine whether a patent claims patent-eligible material. The first step of this framework is the determination of whether patent claims are directed toward one of the three patent-ineligible concepts: laws of nature, products of nature, or abstract ideas.[34] If a claim is not directed toward one of the three types of patent-ineligible concepts, the inquiry is complete, and the claims are patent eligible.[35] In contrast, if a claim is directed toward one of the three types of patent-ineligible concepts, the inquiry continues to step two.[36]

Step two of the patentable subject matter inquiry asks whether the claims, individually, or as an ordered combination, contain an inventive concept that is sufficient to ensure that the patent does more than just cover the patent-ineligible

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28 Bilski v. Kappos, 561 U.S. 593, 599, 609 (2010). ("Indeed, all Members of the Court agree that the patent application at issue here falls outside of § 101 because it claims an abstract idea.").

29 566 U.S. 66, 72 (2012).

30 569 U.S. 576, 591 (2013).

31 573 U.S. at 219-220.

32 Gugliuzza, *supra* note 2, at 573-74 ("[T]he Court, in a string of four decisions, has reinvigorated the patent-eligible subject matter requirement, holding that inventions directed to laws of nature, natural phenomena, or abstract ideas are not eligible for patenting unless they also contain an 'inventive concept.'").

33 *Id.* at 574 ("The Supreme Court's decisions on eligibility have transformed patent litigation. Eligibility was rarely litigated less than a decade ago, but it is now the central concern in many cases.").

34 *Alice Corp. Pty. Ltd.*, 573 U.S. at 217.

35 *Id.*

36 *Id.* at 217-218.

concept itself.[37] Claims directed to one of the three patent-ineligible concepts must recite more than performance of well-understood, routine, and conventional activity in the field with regard to the patent-ineligible concept in order to contain an inventive concept.[38] If this second step of the patent-eligibility test is satisfied, the claims are patent-eligible, and the patent is valid under patentable subject matter.[39] On the contrary, if on the second step of the patent-eligibility test, no inventive concept is found, and consequently this step is not satisfied, the patent does not claim patentable subject matter and is invalid.[40]

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[37] *Id.* ("To answer that question, we consider the elements of each claim both individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application. We have described step two of this analysis as a search for an 'inventive concept'—i.e., an element or combination of elements that is 'sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.'" (internal citations omitted)(quoting *Mayo Collaborative Servs. v. Prometheus Labs.*, Inc., 566 U.S. 66, 72, 77-79 (2012))).

[38] *See* Mayo Collaborative Servs., 566 U.S. at 73 (stating, when holding that the claims did not contain an inventive concept, that "[i]n particular, the steps in the claimed processes (apart from the natural laws themselves) involve well-understood, routine, conventional activity previously engaged in by researchers in the field.").

[39] *Alice Corp. Pty. Ltd.*, 573 U.S. at 221 ("At Mayo step two, we must examine the elements of the claim to determine whether it contains an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application.").

[40] *Id.*

C. Patentable Subject Matter's Bias Against Patent Owners

The two-part patent-eligibility test developed by the Supreme Court has not been beneficial to patentees.[41] In fact, since 2014, patent owners have lost over sixty percent of eligibility decisions in the district courts.[42] Furthermore, when looking at the Federal Circuit's patent eligibility decisions, the numbers are shockingly biased. At the Federal Circuit, patent owners have lost over ninety percent of patent-eligibility disputes.[43] This bias against patent owners seems especially harsh considering that when patent owners lose these disputes, their patent is invalidated, and rendered essentially useless.[44]

D. Recent Changes to the Doctrine in *Berkheimer*

Until recently, courts have reasoned that patent eligibility is a pure "question of law devoid of factual considerations."[45] In February of 2018 though, this all changed when the Federal Circuit issued its opinion in *Berkheimer v. HP Inc.* *Berkheimer* was the first Federal Circuit opinion to acknowledge that patent eligibility was a mixed question of law and fact.[46]

It is important to note that *Berkheimer* decided the patent-eligibility issue at the procedural posture of a motion for summary judgement.[47] As we will discuss later in the paper, changing patentable subject matter to a mixed question of law and fact, from a pure question of law, changes how the standards of summary judgement are applied to the issue.[48] This makes *Berkheimer* a case of first impression on how summary judgement will be applied to patentable subject matter when it is regarded as a mixed question of law and fact. Later in the paper, there will be discussion about *Berkheimer* and how it creates a special summary-judgment standard for patent eligibility in addition to making the issue a mixed question of law and fact.[49] Considering that *Berkheimer* reasoned through patentable subject matter in the posture of summary judgement and considering that this paper focuses on summary judgement in that context, *Berkheimer* will be at the center of the analysis in this paper.

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41 Gugliuzza, *supra* note 2, at 574 ("This change has been bad for patentees.").

42 *Id.*

43 *Id.*

44 *See id.* at 576 ("[T]here are several reasons to pause before praising this trend toward quick invalidations as an unalloyed good. To begin with, patents invalidated as ineligible frequently cover complex technologyFalse").

45 *Id.* ("Courts justify resolving eligibility at such an early stage by reasoning that it presents a question of law devoid of factual considerations.").

46 *Berkheimer* , 881 F.3d at 1368 (holding that "whether a claim recites patent eligible subject matter is a question of law which may contain underlying facts.").

47 *Id.* at 1362.

48 *See* discussion *infra* Section IV.

49 *See* discussion *infra* Section III.B.1.

III. Patent Eligibility and Summary Judgement

It is not uncommon for defendants to file pre-trial motions on patent eligibility in an attempt to get out of the case at an early stage. In fact, the statistics regarding, and the law underlying patentable subject matter serve to encourage use of pre-trial motions. First of all, considering that defendants are likely to win a dispute over patent eligibility 60% of the time at the district court, defendants are incentivized to file pre-trial motions on the issue.[50] With assurance that they more likely than not will win pre-trial motions on patent eligibility, defendants have significant motivation to file such motions in an attempt to end the case pre-trial, and potentially benefit from significant cost savings.[51] Additionally, pre-*Berkheimer*, when no factual considerations were relevant to patent eligibility, defendants had an increased incentive to move to get out of the case early, sometimes even before discovery, as courts condoned early, pre-discovery rulings on the issue.[52] Post-*Berkheimer*, these pre-trial motions have continued importance, and in fact, some courts have continued to decide patent-eligibility issues at the pre-trial-motion stage.[53]

Generally, defendants trying to get out of a patent case early can file two types of pre-trial motions on patent eligibility: (1) a motion to dismiss, and (2) a motion for summary judgement. This paper focuses on summary judgement in the patent-eligibility context. Analysis of summary judgement in the patent-eligibility context requires an understanding of summary judgement in general, and how it is applied specifically in this context. Accordingly, this section of the paper analyzes summary judgement in general, and the application of summary judgement in the patent-eligibility context, both before and after *Berkheimer*.

A. Summary-Judgment Standards in General

In federal civil cases, a party can make a pre-trial motion for summary judgement in an attempt to receive a judgment before going through a full trial.[54] Summary judgement is governed by Rule 56 of the Federal Rules of Civil Procedure.[55] Under Rule 56(a), a party may move for summary judgement on claims or defenses, or parts of claims or defenses.[56] Additionally, under this rule, summary judgement is proper "if the movant shows that there is no genuine dispute as to any

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50 *See* discussion *supra* Section II.C.

51 Gugliuzza, *supra* note 2, at 575 (stating that pleading-stage dismissal allowed in the patent eligibility context is a cost-saving procedural shortcut).

52 *Id.* at 575-576.

53 Biajal Vakil, Daren Orzechowski, Cale Tolbert, Michael Anthony Jaoude, *Months after Berkheimer and Aatrix: Business as Usual*, White & Case (Aug. 28, 2018), https://www.whitecase.com/publications/article/months-after-berkheimer-and-aatrix-business-usual ("Although only a few months have passed, District Courts seem generally unfazed by the Federal Circuit's decisions in *Berkheimer* and *Aatrix*, continuing to decide cases at the motion to dismiss and summary judgment stages. Further time will tell whether these cases cause the disruption that many experts predicted five months ago or whether challenging eligibility will continue as usual.").

54 *Summary Judgment*, CORNELL LAW SCHOOL: LEGAL INFORMATION INSTITUTE, https://www.law.cornell.edu/wex/summary_judgment (last visited Feb. 24, 2019) ("In civil cases, either party may make a pre-trial motion for summary judgment.").

55 *Id.*

56 Fed. R. Civ. P. 56(a) ("A party may move for summary judgment, identifying each claim or defense—or the part of each claim or defense—on which summary judgment is sought.").

material fact and the movant is entitled to judgment as a matter of law."[57] Rule 56(a) provides two elements that must be met for summary judgement to be proper: (1) there must be no genuine issue of material fact relevant to the claim or defense on which the party moves for summary judgement; and (2) in the situation at hand, the movant must be entitled to judgment as a matter of law.[58]

For example, a court should grant summary judgement in a situation where a nonmoving party fails to provide evidence to show the existence of an element that is essential to its case and with which it bears the burden of proof.[59] First of all, in this situation, there is "no genuine issue as to any material fact" because the nonmoving party has failed to provide evidence showing the existence of an element of its case.[60] Additionally, in this situation, the moving party is entitled to a judgment as a matter of law when the nonmoving party has failed to sufficiently show an essential element of its case upon which it carries the burden of proof.[61] Because both summary-judgment elements have been met, summary judgement should be granted.[62] Considering that summary judgement is only appropriate where both of its elements have been met, it is important to evaluate the standards upon which each of these elements are evaluated.

1. No Genuine Issue of Material Fact

The first element that must be met for summary judgement to be granted is a showing of no genuine issue of material fact regarding the claim or defense on which the movant moves for summary judgement. A party seeking summary judgement bears the initial responsibility for informing the district court of the basis for its motion for summary judgement—the lack of a genuine issue of material fact.[63] This means that a moving party must identify the basis of its motion by identifying where it asserts that no genuine issue of material fact exists.[64]

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57 *Id.*

58 *See id* ("The court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.").

59 Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986) (stating that the federal rules of civil procedure mandate entry of summary judgment, "after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial").

60 *Id.* at 323 ("[T]here can be 'no genuine issue as to any material fact,' since a complete failure of proof concerning an essential element of the nonmoving party's case necessarily renders all other facts immaterial.").

61 *Id.*

62 *See id.* at 322-23 ("[T]he plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial.").

63 *Celotex Corp.*, 477 U.S. at 325 (stating that the moving party has the burden "'to show initially the absence of a genuine issue concerning any material fact.'"(quoting *Adickes v. S.H. Kress & Co.*, 398 U.S. 144, 159)).

64 *Id.*at 323. ("Of course, a party seeking summary judgment always bears the initial responsibility of informing the district court of the basis for its motionFalse").

To support a motion for summary judgement, a moving party can identify portions of the pleadings, depositions, answers to interrogatories, or admissions on file, together with any affidavits that it believes demonstrate the lack of a genuine issue of material fact.[65] That being said, it is not required that the moving party support its motion for summary judgement and its assertion of the lack of a genuine issue of material fact with affidavits or other similar materials negating the opponent's claim.[66] In fact, the opposite is true.[67] Regardless of whether the moving party's summary-judgment motion contains affidavits, the motion may and should be granted where whatever is before the district court demonstrates that there is no genuine issue of material fact.[68]

Non-moving parties, to counter a showing that there is no genuine issue of material fact, must go beyond the pleadings and designate specific facts in the record that show a genuine issue for trial.[69] Under Rule 56(c)(1) of the Federal Rules of Civil Procedure, "[a] party asserting that a fact . . . is genuinely disputed must support the assertion by: (A) citing to particular parts of materials in the record, including depositions, documents, electronically stored information, affidavits or declarations, stipulations (including those made for purposes of the motion only), admissions, interrogatory answers, or other materials; or (B) showing that the materials cited do not establish the absence . . . of a genuine dispute . . . ."[70] Pleadings alone cannot be used to show there is a genuine issue of material fact.[71] Finally, to show that a fact is genuinely disputed under Rule 56, a nonmoving party is not required to produce evidence of the genuine dispute in a form that would be admissible at trial.[72]

A showing of a genuine issue of material fact requires two things: (1) a showing that the facts being designated are material; (2) a showing that there is a genuine dispute of fact.[73] Facts that are material are defined by the substantive law.[74] Only disputed facts that might affect the outcome of a case under the governing law are

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[65] *Id.* ("[A] party seeking summary judgment always bears the initial responsibility of . . . identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any,' which it believes demonstrate the absence of a genuine issue of material fact." (quoting Fed. R. Civ. P. 56(c)).

[66] *Id.* ("[W]e find no express or implied requirement in Rule 56 that the moving party support its motion with affidavits or other similar materials *negating* the opponent's claim.").

[67] *See Celotex Corp*., 477 U.S. at 323 ("The import of these subsections is that, regardless of whether the moving party accompanies its summary judgment motion with affidavits, the motion may, and should, be granted so long as whatever is before the district court demonstrates that the standard for the entry of summary judgment, as set forth in Rule 56(c), is satisfied.").

[68] *Id.*

[69] *Id.* at 324 (requiring that the "nonmoving party go beyond the pleadings and by her own affidavits, or by the 'depositions, answers to interrogatories, and admissions on file,' designate 'specific facts showing that there is a genuine issue for trial.'" (quoting Fed. R. Civ. P. 56(e))).

[70] Fed. R. Civ. P. 56(c)(1).

[71] *Celotex Corp*., 477 U.S. at 324 (stating that a proper summary judgment motion can be "opposed by any kinds of evidentiary materials listed in Rule 56(c), except the mere pleadings themselves. . . .").

[72] *Id.* ("We do not mean that the nonmoving party must produce evidence in a form that would be admissible at trial in order to avoid summary judgment.").

[73] *See* Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986) ("This materiality inquiry is independent of and separate from the question of the incorporation of the evidentiary standard into the summary judgment determination.").

[74] *Id.*

material.[75] Therefore, factual disputes that are irrelevant, or unnecessary cannot create a genuine issue of material fact.[76]

For a genuine issue of fact to exist, there must be evidence such that a reasonable jury could return a verdict for the nonmoving party.[77] To raise a fact issue, it is not required that a party resolve the factual dispute conclusively in its favor.[78] Instead, as long as there is sufficient evidence to support a claimed factual dispute—evidence showing that a judge or jury is necessary to resolve the dispute—then a genuine issue of fact has been raised.[79]

As discussed previously, to show that there is a genuine issue of fact for trial, specific facts must be set out.[80] Existence of some alleged factual dispute between parties does not create a genuine issue of material fact and will not defeat a proper motion for summary judgement.[81] This means that mere allegations or denials in a pleading do not raise a genuine issue of material fact.[82] Furthermore, in practice, conclusory allegations, improbable inferences, or unsupported speculation cannot be used to raise a genuine issue of material fact.[83]

When evaluating whether a genuine issue for trial exists, the absence of any plausible motive to engage in the conduct charged can be highly relevant.[84] Lack of motive limits the range of permissible conclusions to be drawn from ambiguous

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75 *Id.*

76 *Id.* ("Factual disputes that are irrelevant or unnecessary will not be counted.").

77 *Id.* ("[S]ummary judgment will not lie if the dispute about a material fact is 'genuine,' that is, if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.").

78 *Anderson*, 477 U.S. at 248-49 ("[T]he issue of material fact required . . . to be present to entitle a party to proceed to trial is not required to be resolved conclusively in favor of the party asserting its existence . . . ." (quoting *First Nat'l Bank v. Cities Serv. Co.*, 391 U.S. 253, 288-89 (1967))).

79 *Id.* at 249 ("[A]ll that is required is that sufficient evidence supporting the claimed factual dispute be shown to require a jury or judge to resolve the parties' differing versions of the truth at trial." (quoting *First Nat'l Bank v. Cities Serv. Co.*, 391 U.S. 253, 288-89 (1967))).

80 *Id.* (stating that when opposing a properly supported motion for summary judgment, a party "'may not rest upon the mere allegations or denials of . . . [its] pleading, but . . . must set forth specific facts showing that there is a genuine issue for trial.'" (quoting Fed. R. Civ. P. 56(e)) (internal quotations omitted)).

81 *Id.* at 247-48 ("[T]his standard provides that the mere existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; the requirement is that there be no genuine issue of material fact."(emphasis omitted)).

82 *Id.* at 248 ("[A] party opposing a properly supported motion for summary judgment 'may not rest upon the mere allegations or denials of his pleading . . . .'" (quoting Fed. R. Civ. P. 56(e))).

83 Medina-Munoz v. R.J. Reynolds Tobacco Co., 896 F.2d 5, 8 (1st Cir. 1990) ("[S]ummary judgment may be appropriate if the nonmoving party rests merely upon conclusory allegations, improbable inferences, and unsupported speculation."); Jeffreys v. City of New York, 426 F.3d 549, 554 (2d Cir. 2005) ("To defeat summary judgment, . . . nonmoving parties must do more than simply show that there is some metaphysical doubt as to the material facts, and they may not rely on conclusory allegations of unsubstantiated speculation." (internal quotations omitted)).

84 Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 596 97 (1986) ("[T]he absence of any plausible motive to engage in the conduct charged is highly relevant to whether a 'genuine issue for trial' exists . . . .") ("[I]n light of the absence of any rational motive to conspire, neither petitioners' pricing practices, nor their conduct in the Japanese market, nor their agreements respecting prices and distribution in the American market, suffice to create a 'genuine issue for trial.'").

evidence.[85] In *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, the Supreme Court factored lack of motive into the determination of whether there was a genuine issue of material fact as to a television-receiver-pricing conspiracy.[86] The Supreme Court held that in light of the absence of any rational motive to conspire, the alleged conspirators' pricing practices, conduct, and agreements regarding prices and distribution did not create a genuine issue for trial.[87] If under these standards, the movant has met its burden and has shown that no genuine issue of material fact exists, and if the nonmovant has not pointed to evidence showing a genuine issue of material fact, the second element of summary judgement comes into play.

2. Entitled to Judgment as a Matter of Law

The second element required for a grant of summary judgement is a showing that in the situation at hand, the movant is entitled to judgment as a matter of law. This inquiry evaluates whether, in the absence of a genuine issue of material fact, the law requires a directed verdict for the moving party.[88] In this step of the inquiry, the judge assesses the governing law, and determines whether in the situation, and under the law, there is only one reasonable conclusion as to the verdict.[89] If there is only one reasonable conclusion as to the verdict, then the judge should direct a verdict.[90]

In many situations, this step of the inquiry can be hard to distinguish from the resolution of whether there is a genuine issue of material fact.[91] An example of such a situation is the hypothetical from Section II.[92] That hypothetical noted that when a nonmoving party fails to provide evidence to show the existence of an element that is essential to its case, and with which it bears the burden of proof, summary judgement is proper.[93] In this hypothetical, because there is no evidence showing the existence of an essential element, there is no genuine issue of material fact as to that element.[94] Additionally, because evidence has not been provided to show the existence of an essential element of the claim, as a matter of law, the moving party is entitled to a directed verdict and summary judgement should be granted.[95]

It can be seen that in this type of a situation, both elements of summary judgement rise or fall together. If there is no genuine issue of material fact, then as a matter of law, a directed verdict is required for the movant. In contrast, if there is a genuine issue of material fact, then as a matter of law, a directed verdict should not

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85 *Id.* at 596-97 ("Lack of motive bears on the range of permissible conclusions that might be drawn from ambiguous evidence: if petitioners had no rational economic motive to conspire, and if their conduct is consistent with other, equally plausible explanations, the conduct does not give rise to an inference of conspiracy.").

86 *Id.* at 578-79, 597-98.

87 *Id.* at 597.

88 *Anderson*, 477 U.S. at 251 ("The Court has said that summary judgment should be granted where the evidence is such that it 'would require a directed verdict for the moving party.'" (quoting *Sarlor v. Arkansas Gas Corp.*, 321 U.S. 620, 624 (1994))).

89 *Id.* at 250 ("[T]he trial judge must direct a verdict if, under the governing law, there can be but one reasonable conclusion as to the verdict.").

90 *Id.*

91 *See supra* text accompanying notes 58-61.

92 *See supra* text accompanying note 58.

93 *See supra* text accompanying note 58.

94 *See supra* text accompanying note 59.

95 *See supra* text accompanying note 60-61.

be entered for the movant. This example, from Section II, shows that the inquiry into a genuine issue of material fact, and the inquiry into whether the movant is entitled to judgment as a matter of law can, and often do, blend together.

These two inquiries don't always blend together though. In certain situations, the second element of summary judgement, the requirement that the movant be entitled to judgment as a matter of law, can become the central focus of the summary-judgment inquiry. This is especially true in situations where the question raised at the summary-judgment stage is purely a question of law.

A question of law is "[a]n issue to be decided by the judge, concerning the application or interpretation of the law."[96] A pure question of law involves no factual issues.[97] Because pure questions of law leave decisions to the judge, and do not involve factual issues, they have no material facts, as facts are material only if they will affect the outcome of the case.[98] Therefore, pure questions of law cannot involve a genuine issue of material fact. As a result, in situations where the issue on which summary judgement is based is a pure question of law, the second prong of the summary-judgment test, which requires that the movant be entitled to judgment as a matter of law, is decisive, and consequently, has increased importance.

In sum, for summary judgement to be granted, two elements must be shown: (1) there is no genuine issue of material fact relevant to the claim or defense on which the party moves for summary judgement; and (2) in the situation at hand, the movant is entitled to judgment as a matter of law.[99] If a movant can show appropriate, specific evidence to show an issue of fact that is material, then, there is a genuine issue of material fact.[100] Additionally, if, based on the situation, the law, as determined by the judge, entitles the movant to a judgment in its favor, summary judgement should be granted.[101]

B. Summary Judgement for Patent Eligibility

Considering that the purpose of this paper is to analyze summary judgement in the patentable-subject-matter context, it is important to first understand how summary judgement is applied in this context. This section of the paper will evaluate how summary judgement is applied to patent-eligibility disputes.

1. Summary Judgement for Patent Eligibility Before Berkheimer

Before *Berkheimer*, the patentable-subject-matter issue was generally regarded as a pure question of law that involved no factual considerations.[102] This precedent

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96 *Question of Law*, BLACK'S LAW DICTIONARY (11th ed. 2019).

97 *See* Gugliuzza, *supra* note 2, at 602 ("[E]ligibility is a purely legal question that involves no factual issues.").

98 Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986); *See supra* text accompanying note 74.

99 Fed. R. Civ. P. 56(a).

100 *See* discussion *supra* Section III.A.1.

101 *See* discussion *supra* Section III.A.2.

102 *See* Gugliuzza, *supra* note 2, at 601 ("[T]he reason courts are able to decide eligibility at the 'threshold' via a motion to dismiss or for judgment on the pleadings is that they often view it as a question

on patentable subject matter is rooted in holdings by the Supreme Court indicating that the ultimate question of patent validity is a question of law.[103] The Federal Circuit, in light of this Supreme Court precedent, regarded patent eligibility as a pure question of law that involved no factual issues.[104] In fact, the Federal Circuit even held, at the time, that when deciding whether a patent contains an inventive concept in step two of the patentable-subject-matter test, a court may exclude evidence of an invention's innovations because that evidence is irrelevant to the patent-eligibility inquiry.[105] Unsurprisingly, before *Berkheimer*, district courts followed this precedent, declining to consider any factual considerations in the eligibility analysis, and holding that patent eligibility is a pure question of law.[106]

The viewpoint that patent eligibility is a pure question of law changes how patent eligibility is evaluated at the summary-judgment stage. As discussed previously, when a court is evaluating a pure question of law at the summary-judgment stage, factual considerations are not relevant.[107] This means that there cannot be any genuine issues of material fact regarding a pure question of law.[108] As discussed, before *Berkheimer*, patent eligibility was regarded as a pure question of law. Therefore, before *Berkheimer*, there could be no genuine issues of material fact regarding patent eligibility.

With no genuine issues of material fact for patent eligibility, judges could only use the second prong of the summary-judgment test to resolve such a motion.[109] Under that second prong, judges determined whether in the situation, the movant was entitled to judgment as a matter of law.[110] This means that before *Berkheimer*, a judge would resolve summary judgement on patent eligibility by simply deciding, as a matter of law, and irrespective of any facts in the case, whether the patent claimed patentable subject matter under the two-part eligibility test.[111]

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of law involving no factual considerations.").

[103] *See id.* ("At the broadest level, the Supreme Court has said, repeatedly, that 'the ultimate question of patent validity is one of law.'" (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966))).

[104] *Id.* at 602 ("As for eligibility, the Federal Circuit has frequently stated that it is a question of law . . . . Judges on both the Federal Circuit and in the district courts have at times interpreted those statements as meaning that eligibility is a *purely* legal question that involves no factual issues.").

[105] Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC, 874 F.3d 1329, 1339-40 (Fed. Cir. 2017), cert. denied, 139 S. Ct. 378 (2018) ("Two-Way Media argues that the district court erred by excluding its proffered evidence from prior cases relating to the purported technological innovations of its invention. We find no error in the district court's determination to reject Two-Way Media's proffered material, as the court correctly concluded that the material was relevant to a novelty and obviousness analysis, and not whether the claims were directed to eligible subject matter.").

[106] Gugliuzza, *supra* note 2, at 605 ("All of this Federal Circuit case law downplaying the role of facts—either implicitly or explicitly—makes it unsurprising that district courts, too, have frequently discounted the potential for factual considerations to enter the eligibility analysis. . . . In fact, numerous district courts have explicitly stated that patent eligibility is a 'pure' question of law.").

[107] *See* discussion *supra* Section III.A.2.

[108] *See* discussion *supra* Section III.A.2.

[109] *See* discussion *supra* Section III.A.2.

[110] *See* discussion *supra* Section III.A.

[111] *See* Laurie,*supra* note 51. (". . . Judge Mayer limits his recommendation for early resolution of subject matter eligibility to those cases where, 'there is no reasonable construction' of the claims at issue that would pass muster under 101. The practical problem is, how does the court come to that conclusion without hearing from persons of skill in the art as to the meaning of claim terms.").

2. Summary Judgement for Patent Eligibility After Berkheimer

In February 2018, the Federal Circuit issued its opinion in *Berkheimer*, making the issue of patent eligibility a mixed question of law and fact.[112] In *Berkheimer*, the Federal Circuit had to determine whether patent claims on digital processing and archiving of files in a digital asset management system were patent eligible or not.[113] The Federal Circuit determined that as a matter of law, the claims at issue were directed to an abstract idea, which is one of the three categories of patent-ineligible concepts contemplated in step one of the patent-eligibility test.[114] Consequently, the Federal Circuit moved to the next step of the patent-eligibility test, determining whether the claims individually, or as an ordered combination, transform the nature of the claim into a patent-eligible concept.[115] The *Berkheimer* court noted that this second step is satisfied if the claim limitations include more than performance of well-understood, routine, and conventional activities previously known to the industry.[116] Additionally, the Federal Circuit made this second step of the patent-eligibility test a mixed question of law and fact, noting that the question of whether a claim is well-understood, routine, or conventional to a skilled artisan is a question of fact.[117]

By making the patent-eligibility inquiry a mixed question of law and fact, the Federal Circuit, in *Berkheimer*, changed how summary judgement is applied to patent eligibility. Under *Berkheimer*, if a claim is directed toward one of the three categories of patent-ineligible subject matter, then the factual issue of what is well-understood, routine, or conventional in the art must be resolved.[118] This means that under *Berkheimer*, there are factual inquiries that are material to the issue of patent eligibility. Therefore, after *Berkheimer*, unlike before *Berkheimer*, on a motion for summary judgement on patent eligibility, the inquiry whether there is a genuine issue of material fact is relevant. This means that after *Berkheimer*, both prongs of the summary-judgment inquiry must be met for a motion for summary judgement to be granted.

It is important to note that in *Berkheimer*, the Federal Circuit did provide some guidance on what can create a genuine issue of material fact for the second prong of the patent-eligibility test. In *Berkheimer*, the Federal Circuit held that there was a genuine issue of material fact as to step two of the patent-eligibility test, which asks whether the invention was well-understood, routine, or conventional to a skilled

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[112] *Berkheimer*, 881 F.3d at 1368 (holding that "whether a claim recites patent eligible subject matter is a question of law which may contain underlying facts.").

[113] *Id.* at 1362-1363.

[114] *Id.* at 1367 ("[T]he claims are directed to an abstract idea . . . ."); *Id.* at 1366 ("Because patent protection does not extend to claims that monopolize the 'building blocks of human ingenuity,' claims directed to laws of nature, natural phenomena, and abstract ideas are not patent eligible."(quoting *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014))).

[115] *Id.* at 1367.

[116] *Id.*

[117] *Id.* at 1368.

[118] *Id.*

artisan.[119] To reach this conclusion, the Federal Circuit relied on specification statements discussing the invention's "inventive feature," and how it improved on the current technology.[120] In holding that these statements created a genuine issue of material fact, the Federal Circuit stated that the specification described "an inventive feature of the invention that stores parsed data in a purportedly unconventional manner."[121]

The specification statements, relied on in *Berkheimer* to show a genuine issue of material fact, were simply the patentee's own conclusory statements, which allege that the invention itself is innovative. In fact, the patentee in *Berkheimer* did not even have to substantiate the relied-upon conclusory statements about the inventiveness of the invention to show that there was a genuine issue of material fact. The reasoning and the statements relied on in *Berkheimer* show that, at a minimum, the patentee's own conclusory patent-specification statements regarding the innovativeness of the invention will raise a genuine issue of material fact for patent eligibility.

In fact, *Berkheimer's* reliance on mere conclusory specification statements about the invention's inventive features suggests that such statements can be used to show the existence of a genuine issue of material fact.[122] In light of the reasoning in *Berkheimer*, these relied-upon statements don't even have to be corroborated with other evidence to raise a genuine issue of material fact.[123] Therefore, under *Berkheimer*, which makes patent eligibility a mixed question of law and fact, a patent owner can produce only conclusory statements from the patent specification about the invention's inventiveness to successfully oppose a motion for summary judgement on patent eligibility.

IV. Patentable Subject Matter and Its Special Summary-Judgment Standard

With background on general summary-judgment standards, and how summary judgement is applied to the patentable-subject-matter inquiry, there is sufficient context to turn to analysis of the application of summary judgement in this context. In particular, this section of the paper will analyze how the application of summary judgement in general differs from its application in the patentable-subject-matter context. Through this analysis, it will be evident that, both before and after *Berkheimer*, a special summary-judgment standard has been applied in the patentable-subject-matter realm.[124]

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[119] *Id.* at 1370.

[120] *Id.* at 1369.

[121] *Id.*

[122] *See generally id.* at 1369; *See* Gugliuzza, *supra* note 2, at 612 ("[J]ust like in *Berkheimer*, the court has arguably made it too easy for patentees to prevail by allowing them to avoid dismissal by simply offering their own statements about their patent's inventiveness.").

[123] Gugliuzza, *supra* note 2, at 611 ("The Federal Circuit in *Berkheimer* . . . [allowed] the patentee to avoid summary judgment without offering any evidence to substantiate its patent's assertions about inventiveness.").

[124] It is important to note that summary judgment is not the only issue where the patentable-subject-matter doctrine has received special, doctrine-specific standards. In fact, the patentable-subject-matter doctrine has been characterized as a "real mess." Terms including "chaos," and "crisis" have been used to describe the current state of the patentable-subject-matter doctrine, and the jurisprudence surrounding the doctrine. *See generally* Kristen Osenga, *The Problem with PTAB's Power*

A. Patentable Subject Matter's Special Pre-*Berkheimer* Summary-Judgment Standard

Before *Berkheimer*, patent eligibility was generally regarded as a pure question of law.[125] Understandably, as will be discussed in this section, this general rule affected how summary-judgment standards were applied in the patent-eligibility context. This section of the paper will analyze how the pre-*Berkheimer* summary-judgment standards applied to patentable subject matter were special, differing from general summary-judgment standards. Furthermore, this section will analyze the consequences of having these special summary-judgment standards for patentable subject matter.

1. How the Pre-Berkheimer Summary-Judgment Standard is Special

Before *Berkheimer*, the doctrine of patentable subject matter had a special summary-judgment standard in light of the precedent making the issue a pure question of law. The Federal Circuit, before *Berkheimer*, interpreted patent eligibility as a purely legal question, involving no factual issues.[126] This meant that no genuine issue of material fact could be raised as to patent eligibility.[127] Therefore, before *Berkheimer*, at summary judgement, courts would analyze patent eligibility purely as a matter of law, with no regard to any factual issues.[128] This disregard of factual issues at summary judgement was a departure from general summary-judgment standards, which require analysis of factual issues and the law before summary judgement can be granted.[129] The fact that the summary-judgment inquiry for patent eligibility differed from the general summary-judgment inquiry indicates that patent eligibility, in fact, did have special summary-judgment standards before *Berkheimer*.

The idea that patent-eligibility has a special summary-judgment standard that disregards factual inquiries is bolstered by the fact that in many cases there seem to be factual issues relevant to patent eligibility. Before *Berkheimer*, courts, at summary judgement, would analyze patent eligibility purely as a question of law, even though there seemingly were factual issues underlying the issue.[130] In fact before *Berkheimer*, the Federal Circuit even acknowledged that there were factual disputes relevant to patent eligibility.[131] For example, in *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, the Federal Circuit acknowledged that the patent-eligibility inquiry

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Over Section 101, 17 CHI. -KENT J. INTELL. PROP. 405 (2018).

125 *See* discussion *supra* Section III.B.1.

126 *See* discussion *supra* Section III.B.1.

127 *See* discussion *supra* Section III.B.1.

128 *See* discussion *supra* Section III.B.1.

129 *See* discussion *supra* Section III.B.1.

130 *See* Gugliuzza, *supra* note 2, at 602 ("But a long line of often-overlooked Federal Circuit cases actually recognizes that the eligibility requirement can implicate questions of fact.").

131 *Id.* ("In that case, the court stated that analyzing eligibility 'may require findings of underlying facts specific to the particular subject matter and its mode of claiming.'" (quoting Arrhythmia Research Tech., Inc. v. Corazonix Corp., 958 F.2d 1053, 1056 (Fed. Cir. 1992))).

"may contain underlying [facts]."[132] Despite occasionally acknowledging the potential relevance of facts to patent eligibility, as it did in *Mortg. Grader*, the Federal Circuit still downplayed the relevance of facts to the issue.[133]

The Federal Circuit's and consequently district courts' pre-*Berkheimer* reluctance to address factual issues underlying the patentable-subject-matter determination is peculiar, considering that factual inquiries are relevant to that determination. Under step two of the patent eligibility test, a court must determine whether the patent claims contain an inventive concept.[134] Inventive is defined as, "showing creativity or original thought."[135] Based on the meaning of inventive, the search for an inventive concept in the second-step inquiry seems to implicate novelty and obviousness issues, which are regarded as questions of fact.[136] Considering that the search for an inventive concept has been regarded as a question of fact in other patentability doctrines—novelty and obviousness—it appears as though facts should be relevant to the same inquiry in the patent-eligibility context, and consequently relevant to the patent-eligibility determination.

Even though, through its inventiveness inquiry, patent eligibility seems to implicate factual inquiries, before *Berkheimer*, the Federal Circuit held that the issue was a pure question of law, and consequently that it is proper to disregard facts when evaluating the issue.[137] The Federal Circuit disregarded factual issues in the patent-eligibility determination, even though such disregard was in tension with other doctrines—in particular, novelty and obviousness—where inventiveness was also relevant but was regarded as a question of fact. This tension shows that before *Berkheimer*, the Federal Circuit created a special summary-judgment standard for the patentable-subject-matter inquiry by disregarding underlying facts, and by making the patent-eligibility issue a pure question of law.

2. The Consequences of the Special Pre-Berkheimer Summary-Judgment Standard

The pre-*Berkheimer* summary-judgment standard, which made patent eligibility a pure question of law, ended up being a very defendant-friendly method for invalidating a patent.[138] First, this special summary-judgment standard allowed early

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[132] Mortg. Grader, Inc. v. First Choice Loan Servs. Inc., 811 F.3d 1314, 1325 (Fed. Cir. 2016) (quoting *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1341 (Fed. Cir. 2013))(emphasis omitted).

[133] *See id.* ("But it is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving fact issues.").

[134] *See* discussion *supra* Section II.B.

[135] *Inventive*, ENGLISH OXFORD LIVING DICTIONARIES, https://en.oxforddictionaries.com/definition/inventive (last visited March 1, 2019).

[136] *See* Gugliuzza, *supra* note 2, at 591 ("[N]ovelty and nonobviousness . . . are widely acknowledged to involve questions of fact.").

[137] *Two-Way Media Ltd.*, 874 F.3d at 1339 ("We find no error in the district court's determination to reject Two-Way Media's proffered material, as the court correctly concluded that the material was relevant to a novelty and obviousness analysis, and not whether the claims were directed to eligible subject matter.").

[138] *See generally* Robert Sachs, *#AliceStorm: April Update and the Impact of TC Heartland on Patent Eligibility*, FENWICK & WEST: BILSKI BLOG: ANALYSIS AND COMMENTARY ON PATENT ELIGIBILITY AND STRATEGY (Jun. 1, 2017), https://www.bilskiblog.com/2017/06/alicestorm-april-update-and-the-impact-of-tc-heartland/.

motions on patent eligibility. Before *Berkheimer*, with patent eligibility regarded as a pure question of law, not only could defendants move for summary judgement on patent eligibility, but the issue could also be decided prior to discovery, expert testimony, or formal claim construction.[139] A defendant did not need to build a factual record to win summary judgement on patent eligibility.[140] Consequently, the bar for winning summary judgement was lowered, as defendants only needed to prevail as a matter of law to get the case dismissed. Additionally, in light of the fact that a summary-judgment win could save a defendant valuable time and money,[141] defendants had good reason to file summary-judgment motions on patent eligibility, and to file them early. Therefore, because it lowered the bar to prevail on summary judgement—by making the genuine issue of material fact inquiry irrelevant—and because it allowed early summary-judgment motions, the special pre-*Berkheimer* summary-judgment standards seemed to be very defendant friendly.

Furthermore, the special pre-*Berkheimer* summary-judgment standards also proved to be biased in favor of defendants considering that leaving the patent-eligibility decision to judges benefitted defendants. Statistics show that pre-*Berkheimer*, defendants, more likely than not, would win a motion for summary judgement on patent eligibility, invalidating the plaintiff's patent and resolving the lawsuit in the defendant's favor.[142] In fact, as of April 30, 2017, 64 percent of motions for summary judgement on patent eligibility at the district-court level resulted in the invalidity of the plaintiff's patent.[143] On appeal this number is even more drastic.[144] As of the same date, 93 percent of appeals of motions for summary judgement on patent eligibility resulted in the invalidity of the plaintiff's patent.[145] These statistics further confirm that the pre-*Berkheimer* summary-judgment standards proved to be very defendant friendly, making summary-judgment motions on patent eligibility an effective tool for defendants.

B. Patentable Subject Matter's Special Post-*Berkheimer* Summary-Judgment Standard

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[139] *See* Laurie, *supra* note 51. (criticizing *Ultramercial v. Hulu & Wild Tangent*, a Federal Circuit case that allowed a decision of patent eligibility only on the pleadings, and before discovery, expert testimony, or claim construction).

[140] *See id.* (acknowledging the Federal Circuit's decision in *Ultramercial v. Hulu & Wild Tangent* to affirm the "District Court's granting of defendants' Rule 12(b)(6) motion to dismiss based solely on the pleadings," and thus, to dismiss the suit before any discovery, expert testimony, and claim construction).

[141] Jason Beaulieu, *The Value of Summary Judgment*, TIMMERMAN BEAULIEU HINKLE & ESWORTHY LLC ATTORNEYS AT LAW (March 17, 2014), https://tbhelaw.com/value-summary-judgment/ ("The value of summary judgment is obvious: cases that need not go further are disposed of expeditiously, freeing up dockets and saving litigants (and taxpayers) time, effort, and money.").

[142] *See generally* Sachs, *supra* note 137 (outlining statistics regarding patent-eligibility decisions at the district-court, and Federal Circuit levels).

[143] *Id.*

[144] *Id.*

[145] *Id.*

In February of 2018, *Berkheimer* made the patent-eligibility inquiry a mixed question of law and fact.[146] As a result, *Berkheimer* also changed how courts should review a motion for summary judgement on patent eligibility.[147] Additionally, *Berkheimer* changed the summary-judgment standards applied in the patentable-subject-matter context, specifically with regard to how a genuine issue of material fact is raised, and created summary-judgment standards specific to the issue.[148] This section of the paper analyzes the special summary-judgment standards created by *Berkheimer*, and the consequences of those standards.

1. How the Post-Berkheimer Summary-Judgment Standard is Special

After *Berkheimer*, patentable subject matter still has a special summary-judgment standard that does not completely align with typical summary-judgment standards. In contrast to pre-*Berkheimer* precedent, *Berkheimer* makes the question of patent eligibility a mixed question of law and fact.[149] Specifically, *Berkheimer* held that the second step of the patent-eligibility inquiry involves questions of fact.[150] With the second step of the patent-eligibility test being a mixed question of law and fact, in contrast to pre-*Berkheimer* law on the issue, both elements of summary judgement are now relevant to such a motion on patent eligibility. This means that when deciding patent eligibility on summary judgement, courts now must ensure that there is no genuine issue of material fact relevant to the issue.

Even though *Berkheimer* made both prongs of summary judgement relevant to patent eligibility, it still created a special summary-judgment standard for patent eligibility by making it easier for plaintiffs to show a genuine issue of material fact in this context. As discussed previously, the patent-specification statements relied on in *Berkheimer*, at best, were uncorroborated, conclusory statements from the patent's specification about the invention's inventive features.[151] In fact, these statements constituted mere allegations of the inventiveness of the invention.[152] The Federal Circuit though, in *Berkheimer*, held that the specification statements were sufficient to show a genuine issue of material fact.[153] Therefore, under *Berkheimer*, a genuine issue of material fact regarding patent eligibility can be shown with only conclusory statements from the patent's specification, which present only allegations about the invention's inventive feature.[154]

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146 *See* discussion *supra* Section III.B.2.

147 *See* discussion *supra* Section III.B.2.

148 *See* discussion *supra* Section III.B.2.

149 *See* discussion *supra* Section III.B.2.

150 *Berkheimer*, 881 F.3d at 1367-68("The second step of the [patent eligibility] . . . test is satisfied when the claim limitations 'involve more than performance of well-understood, routine, [and] conventional activities previously known to the industry.' The question of whether a claim element or combination of elements is well-understood, routine and conventional to a skilled artisan in the relevant field is a question of fact." (quoting *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat. Ass'n*, 776 F.3d 1343, 1347-48 (Fed. Cir. 2014)(internal quotations omitted))).

151 *See* discussion *supra* Section III.B.2.

152 *See* discussion *supra* Section III.B.2.

153 *Berkheimer*, 881 F.3d at 1369.

154 *See* discussion *supra* Section III.B.2.

This rule directly contradicts the general rule for raising a genuine issue of material fact for summary judgement and creates a special summary-judgment standard that is specific to patent eligibility. In contrast to the rule set forth in *Berkheimer*, generally, mere conclusory assertions, or mere allegations of a factual dispute, cannot create a genuine issue of material fact to escape summary judgement.[155] Instead, a party opposing summary judgement must point to specific facts in the record to show a genuine issue of material fact.[156]

Notably, the *Berkheimer* holding, by allowing conclusory statements as evidence of a genuine issue of material fact, seems to be a considerable departure from this general rule that conclusory assertions or mere allegations of a factual dispute cannot create a genuine issue of material fact.[157] In fact, by allowing conclusory statements to show a genuine issue of material fact, *Berkheimer* makes it easier to disprove this first prong of the summary-judgment inquiry because a patent owner no longer has to point to specific, corroborating evidence to do so. By making the first prong of the summary-judgment inquiry—the lack of a genuine issue of material fact, easier to disprove—*Berkheimer* creates a special summary-judgment standard for patent eligibility.

2. The Consequences of the Special Pre-Berkheimer Summary-Judgment Standard

Even if *Berkheimer* does not create noticeable change in the percentage of summary-judgment motions on patent eligibility that end in invalidation of a patent, the reasoning of the case stretches beyond just patent eligibility and could possibly have serious consequences. First of all, it is important to note that *Berkheimer* "may not be the revolutionary decision it has been portrayed to be."[158] In fact, the court in *Berkheimer* even notes that it does not cast doubt on the propriety of previous cases that resolved patent eligibility on motions for summary judgement.[159]

Additionally, the Federal Circuit further cabined *Berkheimer* in *BSG Tech LLC v. Buyseasons, Inc*. when it affirmed the district court's grant of summary judgement on patent eligibility.[160] In this case, the Federal Circuit held that "[i]f a claim's only 'inventive concept' is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible

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155 *See* discussion *supra* Section III.A.1.

156 *See* discussion *supra* Section III.A.1.

157 Gugliuzza, *supra* note 2, at 611 ("[S]tatements by a party or its own witnesses that are conclusory or uncorroborated by other evidence cannot raise a genuine issue of material fact to defeat summary judgment. The Federal Circuit in *Berkheimer* ignored that principle by allowing the patentee to avoid summary judgment without offering any evidence to substantiate its patent's assertions about inventiveness.").

158 *Id.* at 608.

159 *Berkheimer*, 881 F.3d at 1368 ("Patent eligibility has in many cases been resolved on . . . summary judgment. Nothing in this decision should be viewed as casting doubt on the propriety of those cases.").

160 BSG Tech LLC v. Buyseasons, Inc., 899 F.3d 1281, 1291 (Fed. Cir. 2018).

application of an abstract idea."[161] Finally, in the months following the *Berkheimer* decision, it is arguable that the decision did not really effect any change in the patentable-subject-matter field.[162]

The possible consequences of the reasoning in *Berkheimer* though are quite expansive. *Berkheimer*, as discussed previously, makes it easier for a patent owner to disprove the first prong of the summary-judgment inquiry—showing no genuine issue of material fact.[163] The precedent set forth in *Berkheimer* is arguably very biased towards plaintiffs as it seems to make it very easy for plaintiffs to show that there is a genuine issue of material fact to overcome summary judgement. With this precedent on the books, the Federal Circuit is armed with ammunition to create law, and possibly a patent system that is too plaintiff friendly. Therefore, even if *Berkheimer* does not significantly change how courts evaluate summary judgement on patentable subject matter, its reasoning could be harvested and used to effect significant changes beyond the area of patent eligibility.

V. The Impact of *Berkheimer* on The Doctrine of Patentable Subject Matter

Berkheimer impacted the doctrine of patentable subject matter by changing the relevant law. In one way, *Berkheimer* takes a step in the right direction through the changes in the law that it advances. That being said, even though the changes that were made are a step in the right direction, they appear to be an overcorrection. This section of the paper will explore the impact of *Berkheimer* and how it is an overcorrection in the doctrine of patentable subject matter.

A. *Berkheimer* Takes a Step to Correct the Patentable-Subject-Matter Doctrine

The Federal Circuit, in *Berkheimer*, does adjust the law of patentable subject matter, and in doing this, it appears to correct the doctrine. First of all, *Berkheimer* aligned the doctrine of patent eligibility with other patentability doctrines by allowing courts to make factual inquiries regarding the inventiveness of the invention when evaluating patent eligibility. As discussed previously, before *Berkheimer*, courts, when deciding the patentable-subject-matter issue, did not consider any factual issues, even though the issue of inventiveness, an issue that requires factual inquiry in other doctrines, was at the center of the analysis.[164]

Berkheimer is significant mainly because it makes patent eligibility a mixed question of law and fact.[165] Specifically, *Berkheimer* makes the second prong of the patent-eligibility inquiry—the existence of an inventive concept—a question of

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[161] *Id.* at 1290-91.

[162] Biajal Vakil, Daren Orzechowski, Cale Tolbert, Michael Anthony Jaoude, *Months after Berkheimer and Aatrix: Business as Usual*, White & Case (Aug. 28, 2018), https://www.whitecase.com/publications/article/months-after-berkheimer-and-aatrix-business-usual ("Despite early predictions of mass disruption, the process for deciding patent eligibility has mostly continued unchanged.").

[163] *See* discussion *supra* Section IV.B.1.

[164] *See* discussion *supra* Section IV.A.1.

[165] *Berkheimer*, 881 F.3d at 1368 ("[W]hether a claim recites patent eligible subject matter is a question of law which may contain underlying facts.").

fact.[166] This development in *Berkheimer* allows and encourages courts to consider relevant factual issues when deciding patent eligibility—specifically, whether the patent has an inventive concept—instead of ignoring the facts and making a decision on the issue as a matter of law.

Allowing courts to make factual inquiries when evaluating whether a patent has an inventive concept, corrects the patentable-subject-matter doctrine by bringing it in line with the novelty and obviousness inquiries. Both novelty and obviousness revolve around the question of the inventiveness of the invention, and in both of these doctrines, the question is generally considered to be a question of fact.[167] *Berkheimer* also considers this same question, which is central to the second step of the patent-eligibility inquiry, to be a question of fact. Therefore, *Berkheimer* brings the law for patent eligibility in line with the law for novelty and obviousness by making the evaluation of whether the patent contains an inventive concept a question of fact across all three doctrines. This alignment of these three patent doctrines is a correction in the law of patentable subject matter, as it eliminates special rules that are relevant only to patent eligibility.[168]

Furthermore, *Berkheimer* corrected the doctrine of patent eligibility in the summary-judgment context by allowing for a full summary-judgment inquiry on the issue. Before *Berkheimer*, the first summary-judgment element, a lack of a genuine issue of material fact, was not relevant in the patentable-subject-matter context.[169] As discussed previously, when *Berkheimer* made patent eligibility a question of law and fact, it made the first element of summary judgement—lack of a genuine issue of material fact—relevant to the issue.[170] This means that after *Berkheimer*, summary judgement was given its full scope with regard to patentable-subject-matter because both of its elements were made relevant to the issue. By bringing patent eligibility in line with other patentability doctrines, and by giving summary judgement its full scope in the patent-eligibility context, *Berkheimer* took steps to correct the doctrine.

B. *Berkheimer* Does More than Just Correct the Doctrine of Patentable Subject Matter

Berkheimer corrects the doctrine of patentable subject matter, but it doesn't stop there. In fact, *Berkheimer* creates a new rule that is specific to the patentable-subject-

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[166] *Id.* at 1367-68 (holding that the second step of the patent-eligibility test involves questions of fact).

[167] Gugliuzza, *supra* note 2, at 603-04 ("[D]istrict courts, when deciding whether a patent contains the inventive concept required by § 101, may completely ignore the testimony presented by the parties on the issues of novelty and nonobviousness, which are widely acknowledged to involve questions of fact. Allowing courts to ignore that evidence seems questionable given that eligibility, novelty, and nonobviousness all revolve around the similar question of what exactly, the inventor added to pre-existing technology. The Federal Circuit offered no justification for its approach besides the self-evident observation that eligibility and those other doctrines 'are separate inquiries.'" (quoting *Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017), cert. denied, 139 S. Ct. 378, 202 L. Ed. 2d 288 (2018))).

[168] *Id.*

[169] *See* discussion *supra* Section IV.B.1.

[170] *See* discussion *supra* Section III.B.2.

matter issue. Before *Berkheimer*, there was no rule specific to patent eligibility governing how a genuine issue of fact could be raised because at the time, factual inquiries were not relevant to the issue. In *Berkheimer* though, not only did the Federal Circuit make the inquiry into the existence of a genuine issue of fact relevant, it also eased the burden on the patent owner to show a genuine issue of material fact regarding patent eligibility. In contrast to general summary-judgment standards—where mere conclusory statements or allegations of a factual dispute do not raise a genuine issue of material fact—the reasoning in *Berkheimer* allows conclusory statements about an invention's inventiveness from the patent specification to raise a genuine issue of material fact for patent eligibility.[171] Therefore, *Berkheimer* does more than just correct the patentable-subject-matter doctrine; it again creates special rules that are specific to the doctrine.

C. *Berkheimer*: An Overcorrection in the Doctrine of Patentable Subject Matter

Considering the changes to the doctrine of patentable subject matter advanced in *Berkheimer*, it appears that the decision is an overcorrection of the doctrine. There is little doubt that *Berkheimer* corrected the patentable-subject-matter doctrine when it made patent eligibility a mixed question of law and fact, as that decision brought patent eligibility in line with other patentability doctrines and gave summary judgement its full scope in the context.[172] Furthermore, considering the patentable-subject-matter doctrine's pre-*Berkheimer* bias toward defendants, and considering *Berkheimer*'s plaintiff-friendly changes to the doctrine, it appears that, in *Berkheimer*, the Federal Circuit also attempted to remedy the doctrine's favorability toward defendants.

As discussed previously, data for decisions on patentable subject matter show that before *Berkheimer*, the doctrine was very defendant friendly, more often than not providing favorable outcomes to defendants.[173] The correction to the doctrine, enacted in *Berkheimer*, created an additional hurdle for defendants to overcome to receive summary judgement on patent eligibility. The *Berkheimer* correction made the first prong of the summary-judgment inquiry—the determination of whether there is genuine issue of material fact—relevant, and required for a grant of summary judgement on patent eligibility. In light of this information, it appears that the Federal Circuit corrected the doctrine of patentable subject matter in *Berkheimer* not only to bring it in line with other patentability doctrines, but also to remedy the pro-defendant bias of the doctrine.

The Federal Circuit though took too extreme of measures in its attempt to remedy issues with the patentable-subject-matter doctrine. In addition to making patent eligibility a mixed question of law and fact, *Berkheimer* lowered the standard for showing a genuine issue of material fact regarding the issue. In *Berkheimer*, the Federal Circuit allowed conclusory patent-specification statements to raise a genuine issue of material fact.[174] This measure lowered the bar that plaintiffs must meet to

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[171] *See* discussion *supra* Section IV.B.1.
[172] *See* discussion *supra* Section V.A.
[173] *See* discussion *supra* Section IV.A.2.
[174] *See* discussion *supra* Section III.B.2.

show that there is a genuine issue of material fact because generally, conclusory statements or allegations are insufficient to show that there is a genuine issue of material fact. In fact, this lowering of the bar directly contradicts the general standards that outline what is required to show a genuine issue of material fact.[175]

Additionally, considering that plaintiffs are most likely to be opposing motions for summary judgement on patent eligibility, this lowering of the bar for disproving the first element of summary judgement—a lack of a genuine issue of material fact—is a very plaintiff-friendly measure. This plaintiff-friendly measure though seems to be extreme and unnecessary in light of the fact that it contradicts summary-judgment precedent by setting a special standard for what raises a genuine issue of material fact regarding patent eligibility. Therefore, *Berkheimer*, and specifically, its lowering of the bar to show a genuine issue of material fact, could even be considered an overcorrection by the Federal Circuit in an attempt to correct the patent-eligibility doctrine and remedy its defendant-friendly bias.

In sum, the Federal Circuit took a step to correct the patentable-subject-matter doctrine and remedy its pro-defendant bias by making patent eligibility a mixed question of law and fact. That being said, in its attempt to correct the doctrine and remedy its bias in favor of defendants, the Federal Circuit overcorrected it by lowering the bar for a party opposing a motion for summary judgement on patent eligibility to show a lack of a genuine issue of material fact. Though this overcorrection does seem to provide a remedy for the pro-defendant bias of the patentable-subject-matter doctrine, it is still unfounded in, and directly contradictory to, the general standards for summary judgement. Therefore, even though *Berkheimer* does take a step in the right direction to correct the doctrine of patentable subject matter by making the issue a mixed question of law and fact, it also overcorrects the doctrine.

VI. Fixing the *Berkheimer* Overcorrection

Even though *Berkheimer* overcorrected the doctrine of patentable subject matter, the overcorrection is not unfixable. In fact, the fix is relatively simple. *Berkheimer* implemented two main changes to the doctrine of patentable subject matter: (1) making the question of patent eligibility a mixed question of law and fact; and (2) creating a special standard specific to patent eligibility for creating a genuine issue of material fact. The overcorrection, as discussed previously, lies only in the second change promoted in *Berkheimer*.[176] Therefore, to fix the overcorrection, the Federal Circuit should cabin the second change from the *Berkheimer* decision to that specific case while not cabining the first change at all.

The reasoning of *Berkheimer* itself can be used to cabin this second correction for patent eligibility promoted by the decision. In *Berkheimer*, the Federal Circuit noted that on issues not unique to patent law, it applies regional circuit law.[177]

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[175] *See* discussion *supra* Section IV.B.1.

[176] *See* discussion *supra* Section V.C.

[177] *Berkheimer*, 881 F.3d at 1365 ("In patent appeals, we apply the law of the regional circuit, here the

Summary judgement is an issue which is not unique to patent law. Therefore, the Federal Circuit purported to apply regional circuit law when determining whether there was a genuine issue of material fact that would preclude summary judgement in *Berkheimer*.[178]

This purported application of regional circuit law on the summary-judgment issue is the ammunition that the Federal Circuit can use to cabin the second change from *Berkheimer*. The second change outlines a standard for creating a genuine issue of material fact on summary judgement. Therefore, according to the reasoning in *Berkheimer*, this second change is just an application of regional-circuit law in a specific situation. With the second change classified as a specific application of regional-circuit law, the Federal Circuit can hold that the change is binding only in the narrow situation where the same facts are at issue, and where the Federal Circuit is applying law from the same regional circuit. Such a holding would cabin the second change, which lowered the standard for creating a genuine issue of material fact on summary judgement, to a very specific situation, limiting its power and ensuring that it will not be widely applied. Considering that the second change is the root of the overcorrection in the doctrine of patentable subject matter from *Berkheimer*, by cabining this second change as discussed, the overcorrection can be fixed without affecting the force of the first change, which made patent eligibility a mixed question of law and fact.

VII. Conclusion

Through a detailed analysis of summary judgement and its application in the patentable-subject-matter context, this paper has highlighted the fact that *Berkheimer* served as an overcorrection in the doctrine of patentable subject matter. To get to this conclusion, this paper first analyzed summary judgement, specifically, how courts apply it in general, and in the patentable-subject-matter context.[179] This analysis enabled a comparison of how summary judgement is applied in general and in the patentable-subject-matter context.[180] The comparison showed that in the patent-eligibility context, special summary-judgment standards are applied.[181] In fact, this was true both before and after *Berkheimer*, even though the decision affected changes in the interpretation of the patentable-subject-matter doctrine.[182]

Before *Berkheimer*, the patentable-subject-matter issue was generally understood as a pure question of law,[183] and as a result, facts were irrelevant to

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Seventh Circuit, to issues not unique to patent law.").

[178] Even though the Federal Circuit purported to apply regional circuit law to the summary-judgment inquiry in *Berkheimer*, it did not cite a single case from the Seventh Circuit—the appropriate regional circuit in the case—when articulating what summary-judgment standards would be applied. In fact, only Federal Circuit cases were cited when the Federal Circuit, in *Berkheimer*, articulated the summary-judgment standards that would be applied. Therefore, it is arguable that the Federal Circuit did not apply regional circuit law on the summary judgment issue in *Berkheimer*. *See generally Berkheimer*, 881 F.3d at 1364-65.

[179] *See* discussion *supra* Section III.

[180] *Id.*

[181] *See* discussion *supra* Section III.B.; *see* discussion *supra* Section IV.

[182] *See* discussion *supra* Section IV.

[183] *See* Gugliuzza, *supra* note 2, at 601 ("The reason courts are able to decide eligibility at the 'threshold' via a motion to dismiss or for judgment on the pleadings is that they often view it as a question

resolution of the issue.[184] The irrelevance of facts to patentable subject matter was in direct tension with other patentability doctrines. Additionally, this lack of relevance of factual issues created a special summary-judgment standard for patent eligibility where the first prong of the inquiry—whether there was a lack of a genuine issue of material fact—was irrelevant, and consequently, where judges would resolve the inquiry as a matter of law.[185] This application of summary judgement differed from the application of summary judgement to other patentability doctrines where underlying facts are relevant and must be considered.[186]

After *Berkheimer* though, the patent-eligibility doctrine was brought in line with other patentability doctrines because the decision recognized that patent eligibility is a mixed question of law and fact.[187] This change in *Berkheimer* made factual inquiries relevant to summary-judgment motions based on patent eligibility, just as they had been relevant to such motions based on other patentability doctrines.[188] *Berkheimer*, though, did more than just bring the patentable-subject-matter doctrine in line with other patentability doctrines. The decision also created a summary-judgment rule specific to the patent-eligibility context, which lowered the bar for showing a genuine issue of material fact.[189] Considering that *Berkheimer* seems to correct the patentable-subject-matter doctrine by aligning it with other patentability doctrines, this extra, patent-owner-friendly step that the case takes appears to be an overcorrection.[190] Therefore, *Berkheimer* does not just correct the law of patentable subject matter, it propounds an overcorrection of the doctrine.

Berkheimer's overcorrection, which is in direct tension with general summary-judgment standards, could have negative consequences if it is exploited, as it reasonably could be, to create law that is overly biased toward patent owners.[191] This overcorrection though is fixable. To avoid possible negative consequences, the Federal Circuit can, and should, fix the overcorrection by cabining it to the *Berkheimer* decision while also leaving in place the case's correction: its acknowledgement that patent eligibility is a mixed question of law and fact.[192]

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of law involving no factual considerations.").

184 *See* discussion *supra* Section III.B.1.

185 *See* discussion *supra* Section III.B.1.

186 *See* discussion *supra* Section IV.A.1.

187 *See* discussion *supra* Section II.D; *see also* discussion *supra* Section V.A.

188 *See* discussion *supra* Section V.A.

189 *See* discussion *supra* Section V.B.

190 *See* discussion *supra* Section V.C.

191 *See* discussion *supra* Section V.B; *See* discussion *supra* Section IV.B.2.

192 *See* discussion *supra* Section VI.