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3 Eligibility Rulings Show Risks Of Broad Claim Constructions

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Several recent cases illustrate the dispositive impact that claim construction can have on whether claims are patent-eligible under Section 101 of the U.S. Patent Act.

In Berkeley*IEOR v. W.W. Grainger Inc., the plaintiff patentee sought broad constructions of certain claim terms but, in doing so, broadened the claims so that the inventive element was not a required claim element. In its Sept. 21 ruling, the U.S. Court of Appeals for the Federal Circuit said that the patent claims were found to be ineligible.[1]

Two other Federal Circuit decisions this year — GoTV Streaming LLC v. Netflix Inc.[2] and Constellation Designs LLC v. LG Electronics Inc.[3] — illustrate different versions of the same problem. In each case, the specification described technical features or processes that the patentee characterized as inventive, but the Federal Circuit focused on what the claims actually required.

These cases highlight the importance of identifying the inventive aspects of a patent early in the case so that patentees do not inadvertently read the inventive features out of their own claims. This is essential regardless of whether the cases involve software, electronics, medical devices, medtech or other life sciences innovations.

Patent-eligibility under Section 101 often arises at the pleading stage when defendants file a motion to dismiss. If that motion is denied, in some cases, defendants may reraise a Section 101 challenge at summary judgment.

If that is also denied, then the issue is submitted to the jury at trial. Throughout the case, both parties ought to maintain consistency in how they construe claims with respect to the inventive features dispute.

What Happens During Motions to Dismiss?

The question of claim construction may first appear in a motion to dismiss under Section 101, which typically gets filed long before claim construction proceedings. Courts have recognized that claim construction disputes may affect the eligibility of the claims. But at the pleading stage, courts have virtually no information regarding the parties' positions on claim construction, and little information on how the claimed technology actually works.

Given the lack of early-stage claim construction guidance, courts often assume the patentees' broadest "plain and ordinary meaning" construction. The rationale is that by construing the claims in patentees' favor, patentees cannot complain.

For Section 101 purposes, however, a broad "plain and ordinary" meaning construction is not most favorable to patentees and is often detrimental because it renders the claims most vulnerable to ineligibility. Thus, at the motion-to-dismiss stage, patentees are particularly vulnerable to this "heads you win, tails I lose" phenomenon. If patentees are prepared from the start of the case with claim construction positions, however, they may be able to flag disputes to persuade the court to defer a Section 101 decision until after the claims have been construed.

For example, in CardioNet LLC v. InfoBionic Inc., a case relating to software innovation in remote cardiac monitoring devices, the U.S. District Court for the District of Massachusetts stated in its October 2018 ruling: "for purposes of a motion to dismiss, '[i]f there are claim construction disputes, ... the court [may] proceed by adopting the non-moving party's construction,' and construing the patent claims in a manner most favorable to the non-moving party."[4]

The court proceeded to grant the defendant's motion to dismiss under Section 101, applying a broad construction "most favorable" to the patentee.

On appeal to the Federal Circuit during oral argument, CardioNet argued the claims are bound by the specification, to which U.S. Circuit Judge Timothy Dyk asked, "Well, was that interpreted by the district court?" The answer, of course, was "It was not." In response, Judge Dyk said, "So maybe there's a claim construction issue here that hasn't been addressed."[5]

In April 2020, the Federal Circuit ultimately reversed the district court and held that the claims are patent-eligible, not directed to an abstract idea.[6] The claim construction issue gave at least one member of the court reason to pause.

Maintaining consistency in claim construction positions throughout the case is essential to preserving patent eligibility, whether at the pleading, summary judgment or trial stages.

Berkeley*IEOR v. W.W. Grainger

In this case, Berkeley proposed a broad construction of the term "independently calculate" that treated the alleged inventive concept as an optional feature, resulting in the claims being found patent-ineligible.

Berkeley sued W.W. Grainger for infringing patents directed toward a process for determining the profitability of objects using a relational database to calculate the marginal value of the objects based on a set of rules.

During claim construction, the parties disputed the meaning of the term "independently calculate" in the representative claim: "using the relational database management system to independently calculate at least one marginal value of profit for each object being measured using the established rules as applied to a selected set of prepared information."

Berkeley argued that the claims did not require simultaneous, parallel calculations. It explained that

although the specification had one embodiment that performed the independent calculations simultaneously, "there is no necessity to do so, and no such limitation is recited" in the claims. It further argued that the process could perform the calculations "simultaneously, sequentially, or if necessary, not perform some of them at all."[7] The U.S. District Court for the Northern District of Illinois ultimately adopted Berkeley's construction.

With respect to Section 101, Berkeley argued the claim element reciting "independently calculate" was an "unconventional combination" containing the inventive concept that "improves the functioning and operation of the computer itself by performing parallel computations in a faster amount of time."

It presented expert testimony that the inventiveness of the database's ability to calculate the "marginal value of profit" stems directly from the ability to independently calculate the profit, and that those independent calculations were allegedly inventive solely because the calculations could be done in parallel.

W.W. Grainger argued the claims were patent-ineligible because the at-issue limitation did not require parallel processing under the district court's broad construction of "independently calculate." The district court agreed its construction did not require parallel calculations and allowed for sequential calculations or no calculations at all.

The district court found the claims were patent-eligible. Under Step 1, it found the claims were directed to the abstract idea of calculating profitability. The court nonetheless found the claims to be patent-eligible because it determined the at-issue limitation contained the inventive concept. On appeal, the Federal Circuit agreed that the claims were directed to the abstract idea of calculating profitability under Step 1.

For Step 2, the Federal Circuit explained that "if a claim is so broad that it can be practiced without the alleged inventive concept, i.e., the alleged inventive concept is not required by the claim, then the claim cannot be 'significantly more' than the abstract idea itself and fails at step two." The court focused on whether the invention as claimed necessitates the alleged "improvement in ... [the] technology or technical field." If the claims do not require the alleged improvement, then that improvement cannot save them.

A few lessons can be taken away from the case.

For plaintiffs, the inventive concept should be anchored on limitations required by the claims. If the plaintiff needs to propose a broad claim construction for infringement, the plaintiff should describe the inventive concept itself more broadly. Berkeley argued both that parallel calculations were the inventive concept and that they were not required by the claims, to its own detriment.

For defendants, the case highlights the importance of maintaining consistency in Section 101 arguments throughout a case and not raising them only in the context of a motion to dismiss.

GoTV Streaming v. Netflix

In this case, GoTV provided a broad construction for the claim term "discrete low level rendering command," missing the opportunity to incorporate a concrete implementation described in the specification that could have saved the claims from ineligibility.

GoTV accused Netflix of infringing patents directed to a method for processing content data for a wireless device so the device can render the content. During claim construction, the parties disputed the meaning of the phrase "discrete low level rendering command" in the representative claim:
generating a page description based on said wireless device generic template and a capability of the wireless device, said page description having at least one discrete low level rendering command that is within said rendering capability of said wireless device but that is of a syntax that is wireless device generic.

The district court found the claim phrase was indefinite.

On appeal, the Federal Circuit rejected the U.S. District Court for the Central District of California's indefiniteness finding. GoTV proposed construing that phrase to mean "[a] discrete rendering command that is tailored based on wireless device capability," which the Federal Circuit adopted. Nonetheless, on Feb. 9, the Federal Circuit **found** the claims to be patent-ineligible.

Under Step 1, it found the representative claim was directed to the abstract idea of a template set of specifications that can be tailored to fit the user's constraints. It analogized this to a pattern for clothing that could be customized.

Under Step 2, GoTV had argued, relying on expert testimony, that the claims were an improved way of rendering content on a wireless user device using specific data structures that obviate the need to develop separate applications for each type of supported wireless device. In its briefing, GoTV argued that "not only are these specific data structures part of the actual claim language, but the specification provides ample discussion and examples."[8]

The Federal Circuit disagreed with GoTV. It found the claims did not require specific data structures or implementations, and concluded the claims were result-focused and functionally described ordinary computer processes. The Federal Circuit explained that the claims were directed to preparing tailored image descriptions to wireless devices, but provided no concrete implementation for how to do so. The claims failed to specify how the tailoring was to be accomplished.

The Federal Circuit observed that "only features that are claimed, not unclaimed details that appear in the specification, can supply something beyond ineligible matter" and thus, "[t]he proper understanding of what is claimed, i.e., claim construction, therefore matters for an ineligibility analysis."

The decision illustrates the risk of relying on technical details that appear in the specification but are absent from the claims. Patentees should propose a construction that includes more specific data structures or other details from the specification. Adding details to a claim can increase the odds of the claim surviving a Section 101 challenge.

Constellation Designs v. LG Electronics

In this case, the Federal Circuit determined that claims directed to optimizing the parallel decode capacity of a constellation were patent-ineligible because the claims were directed to the concept of optimizing without reciting a concrete technique for doing so.

The key element of the representative claim was "wherein the QAM symbol constellation is a geometrically spaced symbol constellation optimized for capacity using parallel decode capacity that provides a given capacity at a reduced signal-to-noise ratio compared to a QAM signal constellation that

maximizes dmin."

The Federal Circuit noted that details about how to optimize a constellation were described in the specification. However, on April 28, it found that the claim language did not include any of the details that describe the inventors' "process for selecting the points, and potentially the labeling ... ensur[ing] that the constellation size can support the desired capacity," and "iteratively optimiz[ing] the M-ary constellation for the specified capacity" as described in the specification. It therefore found the claims to be patent-ineligible.

Conclusion

The lesson from these cases is straightforward: Patentees should be careful what they ask for when construing their claims. The recent cases show that patentees can undermine their own Section 101 position by advocating constructions that make the alleged invention optional, or by relying on technical details that appear in the specification but not in the claims.

Claim construction and patent-eligibility determinations therefore should not be viewed as separate exercises. Parties should maintain consistency in their claim construction and Section 101 positions as the case progresses from a motion to dismiss, through claim construction and summary judgment, and ultimately to trial.

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Disclosure: Fukuda represented CardioNet in CardioNet v. InfoBionic, and Broughan represented CardioNet in related matters.

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[1] Berkeley*IEOR, DBA B*IEOR v. W.W. Grainger Inc., No. 2024-2353 (Fed. Cir. Sept. 21, 2026).

[2] GoTV Streaming LLC v. Netflix Inc., 166 F.4th 1053 (Fed. Cir. 2026).

[3] Constellation Designs LLC v. LG Electronics Inc., No. 2024-1822 (Fed. Cir. Aug. 31, 2026).

[4] CardioNet, LLC v. InfoBionic, Inc., 348 F. Supp. 3d 87, 90 (D. Mass. 2018).

[5] Audio of the oral argument available at: https://www.cafc.uscourts.gov/oral-arguments/2019-1149.MP3. See 8:59.

[6] CardioNet, LLC v. InfoBionic, Inc., 955 F.3d 1358 (Fed. Cir. 2020).

[7] Berkeley*IEOR, Slip Op. at 6.

[8] GOTV STREAMING, LLC, Plaintiff-Appellant, v. NETFLIX, INC., Defendant-Cross-Appellant, 2024 WL 7001206, at *55.