

SRI International v. Cisco: Patent Eligibility Unresolved Tension between Highest Courts

Apr 01, 2019

Categories:

Publications

Authors:

William S. Morriss

The case of *SRI International, Inc. v. Cisco Systems, Inc.* exposed an apparent inconsistency between two approaches used to determine if a claim is directed to patent-eligible subject matter. In *Alice v. CLS Bank*, the Supreme Court indicated a claim that recites an abstract idea needs to be treated as "directed to" the abstract idea, and would only be patent eligible if it included additional features sufficient to ensure that it was more than a drafting effort designed to monopolize the abstract idea itself.[1] However, while not explicitly departing from the Supreme Court's guidance, the Federal Circuit has endorsed another approach, in which a claim is treated as directed to eligible subject matter if it provides a technical solution to a technical problem.[2] The existence of these two approaches raises the question: should a claim that both provides a technical solution to a technical problem and explicitly recites an abstract idea to be treated as directed to the eligible subject matter?

SRI International presented an excellent opportunity for the Federal Circuit to address and resolve this apparent inconsistency. The invention in *SRI International* related to network intrusion detection technology that was praised as "a 'gem in the world of cyber defense' and 'a quantum leap improvement over' previous technology."[3] However, as claimed, it included "analysis of network traffic data," and, in the extremely broad decision of *Electric Power Group, LLC v. Alstom, S.A.*, the Federal Circuit had already identified "analyzing information" as an abstract idea.[4] Accordingly, the Federal Circuit could have used *SRI International* to explain how the approaches could be harmonized, to lay out some kind of framework for deciding which approach to use on a particular case, or to otherwise provide guidance for practitioners on how to determine what a claim that both provides a technical solution to a technical problem and recites an abstract idea is "directed to."

2026 FBT Gibbons LLP. All rights reserved. ADVERTISING MATERIAL.

FBT Gibbons

Unfortunately, rather than resolving the inconsistency, the Federal Circuit simply applied its rule[5] without explaining why the rule that a claim reciting an abstract idea is directed to the abstract idea didn't control. This failure to provide any explanation, or even to address that "analyzing information" had previously been identified as an abstract idea, was made particularly disappointing by the fact that the Federal Circuit actually distinguished *Electric Power Group*, saying that SRI's claims were more like those found to be eligible in *DDR Holdings, LLC v. Hotels.com, L.P.*[6] However, in *DDR Holdings*, the Federal Circuit specifically noted that the claims did not include the type of subject matter that was previously treated as an abstract idea.[7] This was entirely different from SRI's claims, which explicitly recite subject matter the Federal Circuit previously identified as an abstract idea in *Electric Power Group*. Additionally, in *DDR Holdings*, the Federal Circuit didn't simply declare the claims eligible because they weren't "directed to" an abstract idea, but instead explained that they included additional features sufficient to establish eligibility.[8] Accordingly, even if SRI's claims were more like those from *DDR Holdings* than those from *Electric Power Group*, that would do nothing to explain why SRI's claims could be declared eligible because they weren't "directed to" an abstract idea.

Considering *SRI International*, practitioners analyzing claims that both provide a technical solution to a technical problem and recite an abstract idea should follow the Federal Circuit's lead and treat those claims as directed to eligible subject matter regardless of their additional features. However, such analysis should be made with knowledge that apparently inconsistent rules exist, and that the uncertainty associated with such claims is greater than it would be if the Federal Circuit had taken the opportunity to explain itself.

---

[1] *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 573 U.S. 208, 221 (2014) ("[a] claim that recites an abstract idea **must** include 'additional features' to ensure 'that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].'") (*quoting Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012)) (emphasis added).

[2] *E.g.*, *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016) ("we find that the claims at issue in this appeal are not

2026 FBT Gibbons LLP. All rights reserved. ADVERTISING MATERIAL.

directed to an abstract idea within the meaning of *Alice*. Rather, they are directed to a specific improvement to the way computers operate, embodied in the self-referential table.")

[3] *SRI International, Inc. v. Cisco Systems, Inc.*, — F.3d — 2019 WL 1271160 (Fed. Cir. Mar. 20, 2019) at *1.

[4] *Electric Power Group, LLC. v. Alstom, S.A.*, 830 F.3d 1350, 1353-54 (Fed. Cir. 2016).

[5] *SRI International, Inc. v. Cisco Systems, Inc.*, — F.3d — 2019 WL 1271160 (Fed. Cir. Mar. 20, 2019) at *4:

The claims are directed to using a specific technique—using a plurality of network monitors that each analyze specific types of data on the network and integrating reports from the monitors—to solve a technological problem arising in computer networks: identifying hackers or potential intruders into the network.

[6] *SRI International, Inc. v. Cisco Systems, Inc.*, — F.3d — 2019 WL 1271160 (Fed. Cir. Mar. 20, 2019) at *4:

Cisco argues that the claims are analogous to those in *Electric Power Group, LLC v. Alstom S.A., 830 F.3d 1350 (Fed. Cir. 2016)*, and are simply directed to generic steps required to collect and analyze data. We disagree. The *Electric Power* claims were drawn to using computers as tools to solve a power grid problem, rather than improving the functionality of computers and computer networks themselves. *Id. at 1354*. We conclude that the claims are more like the patent-eligible claims in *DDR Holdings*.

[7] *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256-57 (Fed. Cir. 2014):

We begin our § 101 analysis at *Mayo/Alice* step one: determining whether the computer-implemented claims at issue here are "directed to" a patent-ineligible abstract idea. Here, we note that the □B99 patent's asserted claims do not recite a mathematical algorithm. Nor do they recite a fundamental economic or longstanding commercial practice. Although the claims address a business challenge (retaining website visitors), it is a challenge particular to the Internet.

2026 FBT Gibbons LLP. All rights reserved. ADVERTISING MATERIAL.

Indeed, identifying the precise nature of the abstract idea is not as straightforward as in *Alice* or some of our other recent abstract idea cases.

[8] *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) ("NLG characterizes the allegedly abstract idea in numerous ways … [b]ut, as discussed below, under any of these characterizations of the abstract idea, the '399 patent's claims satisfy *Mayo/Alice* step two.").

© 2026 FBT Gibbons LLP. May be considered attorney advertising in some jurisdictions.

2026 FBT Gibbons LLP. All rights reserved. ADVERTISING MATERIAL.

FBT Gibbons