

No. _____

In the
**Supreme Court of the
United States**

In re VOTER VERIFIED, INC., Petitioner,

VOTER VERIFIED, INC.,
Plaintiff-Appellant,
v.
ELECTION SYSTEMS & SOFTWARE LLC,
Defendant-Appellee.

Federal Circuit Case No. 2017-1930

PETITION FOR A WRIT OF MANDAMUS
AND/OR PROHIBITION

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QUESTION PRESENTED

The Petitioner brought suit for patent infringement for a second period of infringement of its '449 Patent, which had been previously litigated through appeal in the Federal Circuit under 35 U.S.C. § 271 for a first period of infringement, in which the Federal Circuit affirmed the validity of most of the claims of the '449 Patent attacked by counterclaim for invalidity by the Respondent. In the second suit the Petitioner asserted preclusion of the issues of patent validity decided in the first suit, but the district court dismissed the second suit under Fed.R.Civ.P. 12(b)(6) holding that all of the claims of the '449 Patent were invalid as directed to an "abstract idea" and unpatentable under 35 U.S.C. § 101. This Petition arises in the appeal of the district court decision in the second suit.

During the first suit Circuit Judges Lourie and Reyna sat on the panel which decided the invalidity of claim 49 of the '449 Patent adversely to the Petitioner, supporting their decision with a fiction expressed by Judges Lourie and Reyna, a clear departure from the evidence regarding the status as prior art of a reference which was asserted to support an obviousness invalidationn under 35 U.S.C. § 103. This circumstance was presented to this Court in a Petition for Certiorari in the first suit that was denied. Such conduct on the part of Judges Lourie and Reyna was raised as a reason to question their impartiality in this the second suit, thus requiring their recusal from any panel hearing of this appeal

under 28 U.S.C. § 455(a). A motion thus questioning under §455(a) was made to the Federal Circuit, but was denied by the motions Panel, comprising Judges Lourie and Reyna joined by Judge Newman. This Petition for extraordinary writ has been filed to prevent and nullify the very actions that have been taken now by all three judges to defeat the rights of the Petitioner in the '449 Patent in their Opinion of April 20, 2018. The question therefore presented is: Whether the recusal of the currently constituted merits Panel is required by 28 U.S.C. § 455(a) upon the presentation of Petitioner's motion reasonably questioning the impartiality of the Circuit Judges who comprise the current merits Panel.

PARTIES TO THE PROCEEDINGS

The Petitioner is Voter Verified, Inc., and is the plaintiff and the appellant below. A Respondent is Election Systems & Software LLC the defendant and appellee below. Also Respondents are certain Circuit Judges of the United States Court of Appeals for the Federal Circuit that comprised the motion Panel and the merits Panel below, the Honorable Alan D. Lourie, Jimmie V. Reyna, and Pauline Newman.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 29.6 of the Rules of this Court, the petitioner, Voter Verified, Inc., states that it has no parent company, and no public company holds any of its stock.

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PETITION FOR WRIT OF MANDAMUS
AND/OR PROHIBITION

The Petitioner, Voter Verified, Inc., the Plaintiff-Appellant below, respectfully applies, pursuant to Section 1651, Title 28, United States Code, and Rule 20.3 of the Supreme Court Rules, for a writ of mandamus and/or for a writ of prohibition, directed to a certain Panel of Judges of the United States Court of Appeals for the Federal Circuit Court, the Honorable Pauline Newman, Circuit Judge presiding, the Honorable Alan D. Lourie, and the Honorable Jimmie V. Reyna (“merits Panel”), in Case No. 2017-1930. In support of this application Petitioner shows as follows:

(References to “App __” are to the Appendix bound together with this petition, which begins with page 10 of the Petition with a blank page (9) followed by “App 1” as the first page of Appendix documents.

ORDER BELOW

On, January 18, 2018 the merits Panel in Federal Circuit Case No. 2017-1930 made and entered an Order denying the Petitioner’s Motion for Disqualification of Prior Panel Circuit Judges by Plaintiff-Appellant, Voter Verified, Inc. (“Motion”), as follows:

“Appellant Voter Verified, Inc.
moves to disqualify the circuit judges
who sat on the panel that decided

appeal nos. 2011-1553 and 2011-1559, Voter Verified, Inc. v. Premier Election Solutions, Inc., from sitting on the panel assigned to hear this current appeal and from consideration of this motion.

“ Upon consideration thereof,
“IT IS ORDERED THAT:
“The motion is denied.”

FOR THE COURT

<u>January 18, 2018</u>	<u>/s/ Peter R.</u>
<u>Marksteiner</u>	date
Peter R. Marksteiner	
Clerk of Court	

The docket entry for this Order did not reveal that the motion panel that ruled on the motion was the same as the merits Panel or otherwise indicated the composition of the merits panel:

“ORDER filed denying [31] motion to recuse judge filed by Voter Verified, Inc. By: Merits Panel (Per Curiam). Service as of this date by Clerk of Court. [490691] [SMJ] [Entered: 01/18/2018 01:48 PM]”

JURISDICTION

The district court had jurisdiction over this patent litigation under 28 U.S.C. §§ 1331 and 1338. The jurisdiction of the Federal Circuit is under 28 U.S.C. § 1295(a)(1) over appeals from all District Courts in those cases in which jurisdiction is based upon 28 U.S.C. § 1338. The United States Supreme Court has jurisdiction to hear and determine this Petition For Writ Of Mandamus and/or Writ of Prohibition under 28 U.S.C. § 1651(a) and Supreme Court Rule 20.3..

This Petition is timely filed within 90 days of February 9, 2018, the date of the oral argument at which the identity of the Circuit Judges on the Panel was first revealed to the parties under the unwritten but consistently followed policy of the that Court; and also within 90 days of April 20, 2018, the date of the decision of the Federal Circuit in Case No. 2017-1930 (in which the Petitioner's Motion for Disqualification of Judges Lourie and Reyna was denied by the merits Panel presided over by Circuit Judge Newman and included Circuit Judges Lourie and Reyna).

STATUTORY PROVISIONS INVOLVED

28 U.S.C. § 455:

(a) Any justice, judge, or magistrate judge of the United States shall disqualify himself in any proceeding in which his impartiality might

reasonably be questioned.

28 U.S.C. § 1651:

(a) The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.

STATEMENT OF THE CASE

The facts necessary to an understanding of the issues presented by this Petition are most clearly presented by the documents central thereto provided in the Appendix.

On January 9, 2018, prior to the date set for oral argument, the Petitioner filed its Motion for Disqualification of prior panel Circuit Judges by Plaintiff-Appellant, Voter Verified, Inc. (“Motion”) (App 1) in Case No. 2017-1930 pending before the United States Circuit Court for the Federal Circuit. That Motion recounts the circumstance under which the Petitioner has been induced to question the impartiality of Circuit Judges Lourie and Renya who now sit on the current merits Panel in Case No. 2017-1930. The circumstance charged under oath in the Motion is the fabrication by Circuit Judges Lourie and Reyna to qualify a reference as prior art, a reference that could not otherwise qualify as prior art under the facts in the record. That Motion was presented for decision to the current merits Panel that also includes Circuit Judge Newman, who is now

involved in participation and acquiescence in the denial of that Motion (App 15): the denial of that Motion as it occurred immediately upon the Defendant-Appellee's Response to the Motion without time for consideration of a reply by the Petitioner thereto allowed under Federal Circuit Rule 27(c).

REASONS FOR GRANTING THE PETITION

Statement of Reasons

The reasons presented herein are as follows:

1. The current merits Panel's recusal was required by 28 U.S.C. § 455(a) upon the presentation of Petitioner's motion reasonably questioning the impartiality of the Circuit Judges who comprise the current merits Panel.

2. The remedy on appeal to this Court is not adequate to relieve the wrong committed by the members of the current merits Panel in refusing to recuse themselves under 28 U.S.C. § 455(a)

3. The Supreme Court's ability to assign a case to a different Panel of the Federal Circuit on remand with the statutory power to 'require such further proceedings to be had as may be just under the circumstances,' should be exercised where a party has presented irrefutable showing of wrongdoing by members of the Federal Circuit directed at the Petitioner's Patent rights.

The fabrication of an embellishment of evidence in the record by a Circuit Judge upon which a reference is qualified as prior art, particularly to defeat the validity of a patent claim, is clearly an act which would lead the patent owner to reasonably question the Circuit Judge's impartiality. It matters not what the motivation of the Circuit Judge is to perform such an act; the act speaks for itself with hostility to the rights of the patent owner. It is the clearly objective manifestation of a less than impartial disposition on the part of a Circuit Judge, regardless of who or what might benefit therefrom, or the allegiance of the Circuit Judge. Having performed such an act in itself invokes the operation of 28 U.S.C. § 455(a) to require recusal of a Circuit Judge, without any subjective inquiry for bias or prejudice on the part of the Circuit Judge; any inquiry of whether the act was judicial or extrajudicial being completely beside the point. Having witnessed such an act against it, the Petitioner must avail itself of common sense that such hostility does not have an end, and will extend to any further participation of the Circuit Judge in the adjudication of the Petitioner's rights.

It is also clear that the Response to the Motion of the Defendant-Appellee presents only epithets against the Petitioner with obfuscation, and without any attempt to support from the record the embellishment practiced by the Circuit Judges.

Given the clarity of the disposition of Circuit Judges Lourie and Reyna with the wrong committed

with their embellishment of the evidence in earlier infringement litigation involving the same parties, the Petitioner is forced to reasonably question the impartiality of Circuit Judge Newman, in view of her participation and acquiescence in the denial of the Motion for disqualification.

The only effective remedy contemplated by 28 U.S.C. § 455(a) can only be served by the writs of mandamus and prohibition adjunct to the appellate jurisdiction of this Court, simply because there is no other form of relief that can prospectively affect the judicial process to avoid the hardship of imposed by judicial impropriety in this case. That such hardship appears certain in this case as indicated by the exceptional circumstance of the embellishment of evidence by Circuit Judges to provide an unwarranted opportunity for infringement upon and even destruction of the Petitioner's patent rights. It is also clear that only the Supreme Court can adjust the judicial process in the Federal Circuit, an adjustment that is fully justified under the circumstances presented by the conduct of the current merits Panel.

Statement of Relief Sought

The relief sought by Petitioner herein is as follows:

Petitioner respectfully prays that a writ of mandamus and/or a writ prohibition be issued by this Court directed to the current merits Panel in Case

Nol 2017-1930 with the following mandates and directions:

1. Vacate the Opinion filed in Federal Circuit Case No. 2017-1930 authored by the current merits Panel;

2. Prohibit the Circuit Judges comprising that merits Panel from acting any further in Federal Circuit Case No. 2017-1930, including a rehearing of that appeal, or the entry of any order or other means, but excepting the entry of an order of recusal;

3. Require the appointment of a new merits panel to rehear Federal Circuit Case No. 2017-1930.

CONCLUSION

For all the reasons stated above, the Petitioner respectfully requests that this Court issue the writs of mandamus and prohibition for the remedies requested herein.

Respectfully submitted,

/s/Anthony I. Provitola
Anthony I. Provitola
ANTHONY I. PROVITOLA, P.A.
Attorney of Record

APPENDIX

APPENDIX DOCUMENTS BEGIN

WITH PAGE 10 "App 1"

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App 1
2017-1930

United States Court of Appeals
for the Federal Circuit

VOTER VERIFIED, INC.,
Plaintiff-Appellant

v

ELECTION SYSTEMS & SOFTWARE LLC,
Defendant-Appellee

Appeal from the United States District Court for
the Northern District of Florida
in Case No. 1:16-cv-0267-MW-GRJ,
Judge Mark E. Walker

MOTION FOR DISQUALIFICATION
OF PRIOR PANEL CIRCUIT JUDGES
BY PLAINTIFF-APPELLANT, VOTER
VERIFIED, INC.

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January 9, 2018

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The Plaintiff-Appellant moves this Court pursuant to 28 U.S.C. § 455(a) and 28 U.S.C. § 47 to disqualify the Circuit Judges who sat on the Panel that decided the consolidated Federal Circuit Case Nos. 11-1553 and 11-1559 in 2011 (“2011 cases”), reported as *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374 (Fed. Cir. 2012), Circuit Judges Lourie, Reyna, and Wallach (collectively hereinafter “the Circuit Judges” or “the Panel”), from participating in any hearing or decision in the present case, Federal Circuit Case No. 2017-1930 (“2017 case”), which is an appeal involving an action for infringement of the same United States Patent, No. RE40,449 (“ ‘449 Patent”) against the same person in interest in the 2011 cases; and from ruling on this Motion and participation in any subsequent proceedings in this case, whether in panel or en banc; and in support thereof shows as follows:

STATEMENT OF FACTS

1. The Circuit Judges sought to be disqualified hereby constituted the Panel that held in the opinion dated November 5, 2012 in the 2011 cases that:

“ . . . Starting in January 1995, however, all content published in the Risks Digest (including the Benson article) became available worldwide on the internet through the website <http://catless.ncl.ac.uk/Risks>. Furthermore, unrebutted testimony in the record indicated that (1) the Risks Digest was

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well known to the community interested in the risks of computer automation, including those concerned with electronic voting technologies, . . .” (Emphasis supplied.)

2. The decision in the 2011 cases regarding invalidity of Claim 49 of the ‘449 Patent as obvious under 35 U.S.C. § 103 turned on the status of the Benson article on the website with the Uniform Resource Locator (“URL”) [http:// catless. ncl. ac. uk/ Risks](http://catless.ncl.ac.uk/Risks) (“catless”) as a prior art reference in support of the assertion of invalidity.

3. The only testimony offered in evidence in the 2011 cases before the District Court and the Panel regarding the public accessibility of the Benson article on the catless website on the critical date was the “Declaration of Dr. Lindsay Marshall”, a copy of which is attached hereto without exhibits, with the speculation stated in Paragraph 11 thereof being disregarded as stricken by the District Court (Orders dated August 9, 2010, Pages A66 and A35 in the Joint Appendices of the 2011 cases on appeal, and Docs. 112 and 153 of the District Court records of the 2011 cases).

4. Paragraph 11 of the Marshall Declaration having been stricken, there exists no evidence in the record of the 2011 cases regarding the status of the Benson Article as publicly accessible through indexing on internet search engines on the critical date.

5. There exists no testimony or other evidence

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in the record in the 2011 cases that “the Risks Digest was well known to . . . those concerned with electronic voting technologies”.

6. There existed no evidence in any records in the 2011 cases, including the records in the District Court, that the URL for the catless website was in any way indicative of the nature of the content thereof.

7. There existed no testimony in any records of the 2011 cases, including in the records in the District Court, that “a person of ordinary skill interested in electronic voting would have been independently aware of the Risks Digest as a prominent forum for discussing such technologies” as of the critical date.

8. The Panel found that “although commercial internet search engines were available by 1999, the record is devoid of evidence indicating whether or not the Risks Digest website had been indexed by any such services as of the critical date.

. . . .”

9. The principal issue on this appeal is the propriety of the granting Appx001 the Defendant’s Motion to Dismiss Appx128 under Fed.R.Civ.P. 12(b)(6) by allowing the relitigation of a prior determination against the defense under 35 U.S.C. § 101 that had been decided against the Defendant in the 2011 cases, involving actions for infringement for the first 6 year period of damages, with the notion of a change in the law. The Trial Court apparently accepted the prior determination in the 2011 cases on the issue of claim validity under 35 U.S.C. §101 as

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supporting the issue preclusion, but on Page 5 Appx005 of the Order found that *Alice Corp. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014) “substantially changed the law” so that “the issue of patent validity is not precluded from further litigation”. The Trial Court then erroneously decided the defense under 35 U.S.C. § 101 in favor of the Defendant.

ARGUMENT AND LEGAL AUTHORITY

Every federal judge takes an oath to “faithfully and impartially discharge and perform all the duties” of judicial office, 28 U.S.C. 493; and the Due Process Clause of the Fourteenth Amendment to the United States Constitution has been construed to guarantee litigants the right to a “neutral and detached,” or impartial, judge. *Ward v. Village of Monroeville*, 409 U.S. 57 (1972). The Code of Conduct for United States Judges therefore admonishes judges to “act at all times in a manner that promotes public confidence in the integrity and impartiality of the judiciary” and to “avoid impropriety and the appearance of impropriety in all activities.” Code of Conduct for United States Judges, Canon 2A.

As noted by the United States Supreme Court, however, disqualification rules may be and often are more rigorous than the Due Process Clause requires. Thus it is with disqualification requirements for federal judges, which require disqualification when a judge’s impartiality “might reasonably be questioned.” 28 U.S.C. § 455(a). The ethical aspect of disqualification is governed by Canon 3C of the

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Code of Conduct for United States Judges, as construed by the Codes of Conduct Committee of the Judicial Conference of the United States. *United States v. Microsoft Corp.*, 253 F.3d 34, 113 (D.C. Cir. 2001). The procedural aspect is governed by the statutes of Title 28 of the United States Code.

Application of 28 U.S.C. § 455(a)

The disqualification law in the federal judicial system applicable here is 28 U.S.C. § 455(a), which provides: “Any justice, judge, or magistrate judge of the United States shall disqualify himself in any proceeding in which his impartiality might reasonably be questioned.” This section codifies an objective standard to determine disqualification: whether a judge’s impartiality might be questioned from the perspective of a reasonable person. Thus, need for disqualification “is to be determined by examining the record facts and the law, and then deciding whether a reasonable person knowing and understanding all the relevant facts would recuse the judge.” *In re Drexel Burnham Lambert Inc.*, 861 F.2d 1307, 1313 (2nd Cir. 1988).

It is clear from the record facts in the 2011 cases that the Panel decided the appeals based upon the Panel’s improper embellishment of the testimony in the Marshall Declaration concerning the “well known” aspect of the catless website containing information concerning “computer automation” with the phrase “including those concerned with electronic voting technologies”. This gratuitous inclusion was

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the Panel's basis for their finding that "a person of ordinary skill interested in electronic voting would have been independently aware of the Risks Digest as a prominent forum for discussing such technologies". Moreover, whether or not the catless website included articles regarding "electronic voting technologies", or that such may fall under the general category of "computer automation", is not evidence that a person of ordinary skill would have been independently aware of the catless website.

It is important to note that the Panel claims to uphold and affirm the decisions of the District Court in the 2011 cases. However, the District Court erroneously decided in favor of the public accessibility of the Benson article without regard to the fact that it was not indexed on a search engine, but only based on the fact that the catless website was merely well known and internally searchable. The District Court did not resort to the embellishment entertained by the Panel, and such a finding from the evidence is not present in Orders or the Final Judgments of the District Court.

The Panel decision in the 2011 cases was discussed with approval by this Court in *Blue Calypso, LLC v. Groupon, Inc.*, 816 F.3d 1331 (Fed. Cir. 2012), in which this Court underscored the specificity in the knowledge of a website that must be possessed by an artisan in order to assert the prominence of the website for the location of information that would supplant web indexing for the location of that information. However, this Court in *Blue Calypso* was not aware of the defects in the

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evidence claimed in support of the decision in the 2011 cases. Indeed, this Court in *Blue Calypso* (at page 1351) contrasted the evidence before it with the facts claimed by the Panel in the 2011 cases, to find that “Groupon failed to carry its burden of proving public accessibility of the Ratsimor Reference” [815 F.3d 1351]

In the present case, the Board found that Groupon had failed to carry its burden of establishing that an interested party exercising reasonable diligence would have located Ratsimor.

. . . Further, in contrast to *Voter Verified*, the present case lacks any testimonial evidence that a person interested in e-commerce and peer-to-peer marketing would be independently aware of the web address for Dr. Ratsimor's personal page. In other words, there was no evidence that the ordinarily skilled artisan would know of Dr. Ratsimor's personal webpage or its web address. . . .”

In its approving discussion of the Panel's decision in the 2011 cases this Court assumed in *Blue Calypso* that the Panel's factual account of the supporting evidence was correct (at page 1349):

“Only more recently have we addressed the question of how to determine public

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accessibility of a reference housed on a webpage in one corner of the vast world wide web. “[I]ndexing is no more or less important in evaluating the public accessibility of online references than for those fixed in more traditional, tangible media.” *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1380 (Fed.Cir.2012). In *Voter Verified*, we found that a particular article that was available only through an on-line publication was publicly accessible. *Id.* We reached that conclusion based on “unrebutted testimony” in the record indicating that the particular on-line publication was well known to the community interested in the subject matter of the reference. *Id.* In addition, we noted that numerous related articles were also located within the same on-line publication. *Id.* These factors overcame the absence of evidence demonstrating that the website at which the article was located was indexed and thereby findable by an internet search engine. *Id.* at 1381. Thus, we concluded that “[w]hether or not the website itself had been indexed ... (through search engines or otherwise), the uncontested evidence indicates that a person of ordinary skill interested in electronic voting would

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have been independently aware of the [the on-line publication] as a prominent forum for discussing such technologies.” Id. Just as indexing plays a significant role in evaluating whether a reference in a library is publicly accessible, Voter Verified underscores that indexing, “[w]hether ... through search engines or otherwise,” id., is also an important question for determining if a reference stored on a given webpage in cyberspace is publicly accessible. [815 F.3d 1350]

By the manner in which this Court in *Blue Calypso* regarded the facts in the 2011 cases that they assumed were supported by the evidence demonstrates the difference in the result that would have been reached if the Panel in the 2011 cases honestly adhered to the evidence in the record without embellishment. *Blue Calypso* has thus shown that the result in the 2011 cases would have been completely different with an honest regard for the evidence, rather than that which they had to assume under the authority of the Panel’s decision in the 2011 cases. It is clear that the manner in which this Court scrutinized the evidence in *Blue Calypso* would have led this Court to the same conclusion and holding as they did with respect to the *Ratismor* reference.

By the decision in *Blue Calypso*, this Court has also demonstrated how it is that the impartiality of the Panel in the 2011 cases might be reasonably

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questioned in view of the clear impropriety of their consideration of nonexistent testimony with the claim that it was uncontested, and thus what can reasonably be expected with respect to other issues if they were to have this case assigned to them. The need for disqualification of the Circuit Judges of the Panel as moved for here is clearly determined for this case with the examination of the record facts in the 2011 cases and the law, where a reasonable person knowing and understanding all the relevant facts would recuse the Panel under the objective standard of 28 U.S.C. § 455(a).” In re Drexel Burnham Lambert Inc., 861 F.2d 1307, 1313 (2nd Cir. 1988).

Application of 28 U.S.C. § 47

The disqualification of the Panel to participate in the determination of this appeal is also required by 28 U.S.C. § 47: “No judge shall hear or determine an appeal from the decision of a case or issue tried by him.” The principal issue on this appeal is the propriety of the granting Appx001 the Defendant’s Motion to Dismiss Appx128 under Fed.R.Civ.P. 12(b)(6) by allowing the relitigation of a prior determination against the defense under 35 U.S.C. § 101 that had been decided against the Defendant in the 2011 cases. The 2011 cases were heard by the Panel of this Court in the Appeal of the 2011 cases which resulted in affirmance of the Final Judgments in the 2011 cases, including the summary judgment holding the ‘449 Patent to be not invalid under 35 U.S.C. § 101, and therefore “involve[d] a question which the judge has tried or heard”. Cramp & Sons

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Ship & Engine Building Co. v. International Curtiss Marine Turbine Co., 228 U.S. 645 (1913). The Panel which heard and affirmed the decisions in the 2011 cases is therefore disqualified by the operation of 28 U.S.C. § 47 from hearing this Motion or Appeal.

However, just as important is the disqualification of the Panel to participate in the determination of this Motion under 28 U.S.C. § 47. This Appeal clearly involves “the appeal from the decision of a case or issue” heard by the Panel in the 2011 cases. In *Rexford v. Brunswick-Balke-Collender Co.*, 228 U.S. 339 (1913) the Supreme Court observed that it makes no difference whether “the question may be easy of solution or that the parties may consent to the judge’s participation” because “the sole [statutory] criterion” is whether the case on appeal “involve[s] a question which the judge has tried or heard”. In *Cramp* the Supreme Court vacated an appellate decision notwithstanding the parties’ consent to the trial judge sitting on the appeal, holding that the appellate panel was “not organized in conformity to law.” Therefore the Circuit Judges here sought to be disqualified from hearing this appeal should also be disqualified from hearing this Motion under 28 U.S.C. § 47.

DATED: January 9, 2018

Respectfully submitted,
s/Anthony I. Provitola
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Declaration of Anthony I. Provitola

I, Anthony I. Provitola, declare under penalty of perjury that I am counsel for the Plaintiff-Appellant in the above-styled appeals and the Vice-President of Voter Verified, Inc.; that I have personal knowledge of the facts in Paragraphs 1-9 of the Statement of Facts contained in the foregoing Motion; and that the facts in Paragraphs 1-9 of the Statement of Facts in the foregoing are true and correct to the best of my knowledge.

Executed on January 9, 2018

/s/Anthony I. Provitola
Anthony I. Provitola

CERTIFICATE OF CONSULTATION

The Movant hereby certifies that consultation with counsel for the other party has occurred and that he has informed the Movant that they oppose the Motion but have not stated that he will file a response to the Motion.

/s/Anthony I. Provitola
Anthony I. Provitola

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CERTIFICATE OF SERVICE

I hereby certify that on January 9, 2018 the foregoing document was served by Email and CM/ECF upon the following Attorney for Defendant-Appellee, Election Systems & Software LLC: Robert M. Evans, Jr., Esquire, revans@senniger.com, Kyle G. Gottuso, Esquire, kgottuso@senniger.com, Marc Wade Vander Tuig, Esquire, mvandertuig@senniger.com, SENNIGER POWERS LLP, One Hundred North Broadway, 17th Floor, St. Louis, MO 63102.

s/Anthony I. Provitola

Anthony I. Provitola

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NOTE: This order is nonprecedential.
United States Court of Appeals
for the Federal Circuit

VOTER VERIFIED, INC.,
Plaintiff-Appellant

v

ELECTION SYSTEMS & SOFTWARE LLC,
Defendant-Appellee

2017-1930

Appeal from the United States District Court for
the Northern District of Florida in Case No. 1:16-cv-
0267-MW-GRJ, Judge Mark E. Walker

Appellant Voter Verified, Inc. moves to disqualify the
circuit judges who sat on the panel that decided
appeal nos. 2011-1553 and 2011-1559, Voter Verified,
Inc. v. Premier Election Solutions, Inc., from sitting
on the panel assigned to hear this current appeal and
from consideration of this motion.

Upon consideration thereof,

IT IS ORDERED THAT:

The motion is denied.

January 18, 2018
date

FOR THE COURT
/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

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**United States Court of Appeals
for the Federal Circuit**

VOTER VERIFIED, INC.,
Plaintiff-Appellant

v.

ELECTION SYSTEMS & SOFTWARE LLC,
Defendant-Appellee

2017-1930

Appeal from the United States District Court for
the Northern District of Florida in No. 1:16-cv-
00267-MW-GRJ, Judge Mark E. Walker.

Decided: April 20, 2018

ANTHONY ITALO PROVITOLA, DeLand, FL,
argued for plaintiff-appellant.

ROBERT M. EVANS, JR., Senniger Powers LLP,
St. Louis, MO, argued for defendant-appellee. Also
represented by KYLE G. GOTTUSO.

Before NEWMAN, LOURIE, and REYNA, Circuit
Judges.
LOURIE, Circuit Judge.

[Opinion Page 2]

Voter Verified, Inc. (“Voter Verified”) appeals from the United States District Court for the Northern District of Florida’s dismissal under Fed. R. Civ. P. 12(b)(6) of its claim for patent infringement, holding that the claims of U.S. Reissue Patent RE40,449 (“the ’449 patent”) are directed to patent-ineligible subject matter and are thus invalid under 35 U.S.C. § 101. See *Voter Verified, Inc. v. Election Sys. & Software LLC*, No. 1:16-cv-267, 2017 WL 3688148, at *2 (N.D. Fla. Mar. 21, 2017) (“Voter Verified NDFL”). For the reasons that follow, we affirm.

BACKGROUND

The ’449 patent, assigned to Voter Verified, was reissued on August 5, 2008 from U.S. Patent 6,769,613, and is directed to voting methods and systems that provide for “auto-verification” of a voter’s ballot. See ’449 patent Abstract. Generally, the patent discloses a process in which a voter enters a vote into a voting system; the system generates a corresponding printed ballot; and the voter verifies the printed ballot for accuracy and submits it for tabulation. See *id.* col. 1 l. 64–col. 2 l. 40, col. 2 l.53–col. 3 l. 11.

Before we address the issues in the current appeal, an overview of relevant events from a prior litigation is necessary. In November 2009, Voter Verified sued the predecessors of Election Systems &

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Software LLC (“Election Systems”)¹ in the Middle District of Florida alleging infringement of the ’449 Patent. Election Systems, which produces and markets automated voting systems, counterclaimed that the claims of the ’449 patent were invalid under §§ 101, 102, 103, and 112. In a series of summary judgment orders, the district court made various validity and infringement decisions. The court determined that

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claims 1–93 were not infringed and claim 94 was invalid as indefinite under § 112. The court then entered summary judgment in favor of Voter Verified concluding that all the claims of the ’449 patent, except for claim 94, were not invalid under §§ 101 and 112, because Election Systems failed to present any arguments or evidence regarding invalidity of these claims. See Summ. J. Order at 18–19, *Voter Verified, Inc. v. Premier Election Sols., Inc.*, No.6:09-cv-1968 (M.D. Fla. Sept. 15, 2010), ECF No. 155; Summ. J. Order at 20, *Voter Verified, Inc. v. Election Sys. & Software, Inc.*, No. 6:09-cv-1969 (M.D. Fla. Sept. 29, 2010), ECF No. 114; J.A. 239. No further analysis of § 101 was provided. Finally, the court dismissed without prejudice the claim of invalidity of claims 85 and 93 under § 102, having already determined that they were not infringed, but

¹ The parties do not dispute that this means Election Systems was a party to the prior litigation.

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held that claim 49 was invalid under § 103, even though the court had also already determined that it was not infringed. The court additionally held that the remaining claims 1–48, 50–84, and 86–92 were not invalid under §§ 102 and 103.

Voter Verified appealed the holding of invalidity of claim 49, but not of claim 94. See *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1379 (Fed. Cir. 2012). Election Systems cross-appealed the upholding of the validity of the remaining claims 1–48, 50–84, and 86–92. *Id.*

After briefing and oral argument, we affirmed the district court’s invalidity judgment of claim 49 under § 103. *Id.* at 1379–81. We also determined that the district court did not err in holding that claims 1–48, 50–84, and 86–92 were not proven invalid because, in failing to respond to these arguments in its summary judgment briefing, Election Systems had not met its burden to prove its invalidity counterclaims by clear and convincing evidence. *Id.* at 1381–82. Therefore, only claims 49 and 94 remain invalid.

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This brings us to the present case on appeal. In July 2016, Voter Verified again sued Election Systems, this time in the Northern District of Florida, alleging that certain voting systems and equipment made or operated by Election Systems infringed the ’449 patent. Election Systems filed a

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motion to dismiss the complaint under Rule 12(b)(6) arguing that Voter Verified failed to state a claim upon which relief could be granted because all the claims of the '449 patent are invalid under § 101. In response, Voter Verified argued that issue preclusion, or collateral estoppel, precludes Election Systems from relitigating the § 101 issue, which it argues had already been decided in the prior litigation. Election Systems countered that issue preclusion should not apply in this case because there was an intervening change in the law. Regardless, Election Systems contended that under Eleventh Circuit law, issue preclusion would still not apply because two of the four required elements of issue preclusion were not met. Specifically, Election Systems argued that the § 101 issue was not “actually litigated” and it was not “a critical and necessary part of the judgment” in the first litigation. See *CSX Transp., Inc. v. Bhd. of Maint. of Way Emps.*, 327 F.3d 1309, 1317 (11th Cir. 2003).

The district court granted Election Systems’s motion to dismiss. See *Voter Verified NDFL*, 2017 WL 3688148, at *2. The court concluded that the “two-step analysis” recited in *Alice Corp. v. CLS Bank International*, 134 S.Ct. 2347 (2014), constituted a “substantial change” in the law such that “the issue of patent validity is not precluded from further litigation.” *Voter Verified NDFL*, 2017 WL 3688148, at *1–2. The district court therefore did not reach an issue preclusion analysis under Eleventh Circuit law. The court then proceeded to analyze the claims of the '449 patent under the two-

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step § 101 framework. First, the court determined that the patent was based on the abstract idea of “vote collection and verification.” Id

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at *2. Second, the court determined that the voting system was made up of “generic computer components performing generic computer functions,” and that this was insufficient to transform the abstract idea into patent eligible subject matter. Id. As a result, the court held that all the claims of the ’449 patent were directed to patent-ineligible subject matter and thus invalid under § 101. Id.

Voter Verified timely appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

We review a district court’s dismissal under Rule 12(b)(6) under the law of the regional circuit. *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1346 (Fed. Cir. 2014). The Eleventh Circuit reviews the grant of a Rule 12(b)(6) motion de novo, accepting as true the complaint’s factual allegations and construing them in the light most favorable to the plaintiff. *Speaker v. U.S. Dep’t of Health & Human Servs. Ctrs. for Disease Control & Prevention*, 623 F.3d 1371, 1379 (11th Cir. 2010).

Before we reach the merits of the § 101 issue, we must first determine whether the district court properly concluded that the § 101 judgment from the

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prior litigation does not have preclusive effect in this case for the reason that Alice was an intervening change in the law. See Wright et al., 18 Fed. Prac. & Proc. Juris. § 4425 (3d ed.) (“Preclusion is most readily defeated by specific Supreme Court overruling of precedent relied upon in reaching the first decision.”); see also Dow Chem. Co. v. Nova Chems. Corp. (Can.), 803 F.3d 620, 628–29 (Fed. Cir. 2015); Wilson v. Turnage, 791 F.2d 151, 157 (Fed. Cir. 1986) (determining that issue preclusion was inapplicable when there was an “intervening change in the legal atmosphere”). If there were a change in the law, then issue preclusion would not apply, which would allow us to reach

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the merits of the § 101 issue. If, however, there were not a change in the law, then issue preclusion would still be a viable issue that we need to evaluate.

I. Intervening Change in the Law

The district court held that Alice was a “substantial change” in the law such that issue preclusion does not apply here. See Voter Verified NDFL, 2017 WL 3688148, at *1. On appeal, Voter Verified argues that issue preclusion should apply because there was no change in the law, and Alice merely applied a rule from *Bilski v. Kappos*, 561 U.S. 593 (2010), which it states was the controlling law at the time the district court in the prior litigation entered summary judgment on the § 101 issue. Election Systems counters that there was a change in the law, because “the two-step analysis [was]

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established in Mayo and further refined in Alice.” Appellee’s Br. 23; see also Oral Arg. at 23:34–25:25, *Voter Verified, Inc. v. Election Sys. & Software LLC*, No. 17-1930 (Fed. Cir. Feb. 9, 2018), <http://oralarguments.cafc.uscourts.gov/default.aspx?fl=2017-1930.mp3>.

We agree with Voter Verified to the extent that it argues that Alice was not an intervening change in the law, so that it does not exempt a potential application of issue preclusion. However, we ultimately conclude for the reasons that follow that issue preclusion does not apply in this case.

For the change of law exception to issue preclusion to apply, three conditions must be satisfied. First, “the governing law must have been altered.” *Dow Chem.*, 803 F.3d at 629 (citations omitted). Second, “the decision sought to be reopened must have applied the old law.” *Id.* (citations omitted). Third, the change in the law “must compel a different result under the facts of the particular case.” *Id.* (citations omitted). Additionally, in order to be intervening, the change in the law must have occurred after the first case was finally decided. See *Wilson*, 791 F.2d at 157 (“[A] judicial declaration intervening between the two proceedings may so change the legal atmosphere as to render the rule of collateral estoppel inapplicable.” (quoting *Comm’r of Internal Revenue v. Sunnen*, 333 U.S.591, 600 (1948))).

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Turning to the first condition, we conclude that Alice, which was decided after the first litigation ended, did not alter the governing law of § 101. In Alice, the Court applied the same two-step framework it created in Mayo in its § 101 analysis. Alice, 134 S. Ct. at 2355 (citing Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66, 77–79 (2012)). The Court stated, “[f]irst, we determine whether the claims at issue are directed to one of those patent-ineligible concepts.” Id. (citing Mayo, 566 U.S. at 77–78). If so, it stated, one must then determine “what else is there in the claims before us?” Id. (quoting Mayo, 566 U.S. at 78). Just as it did in Mayo, the Court characterized the second inquiry “as a search for an inventive concept,” id. at 2355 (internal quotation marks and citation omitted), that is “sufficient to transform the claimed abstract idea into a patent-eligible application,” id. at 2357 (internal quotation marks and citation omitted). It is thus evident from the Court’s reliance on Mayo that it was merely applying the same test as it set out in Mayo, and did not materially change it. See id. at 2355, 2357 (citing Mayo for the rule of law). We therefore hold that Alice did not alter the governing law under § 101.

Moreover, to the extent that Election Systems argues that Mayo was an intervening change in the law, we disagree because Mayo was not intervening. Mayo was decided while the first appeal was still pending before this court. After that, the only controlling decision that could be considered to have intervened is Alice, which issued after the first

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litigation. And, as we have discussed above, Alice did not cause a change in the law.

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Because the first condition for avoiding issue preclusion has not been satisfied, we need not review the second and third conditions. Accordingly, the intervening change in the law exception does not preclude application of issue preclusion in this case.

II. Issue Preclusion

We continue our analysis by applying the doctrine of issue preclusion. Issue preclusion serves to “preclude parties from contesting matters that they have had a full and fair opportunity to litigate,” which “protects their adversaries from the expense and vexation attending multiple lawsuits, conserves judicial resources, and fosters reliance on judicial action by minimizing the possibility of inconsistent decisions.” *Mont. v. United States*, 440 U.S. 147, 153–54 (1979). We review a district court’s application of issue preclusion under the law of the regional circuit. *Aspex Eyewear, Inc. v. Zenni Optical Inc.*, 713 F.3d 1377, 1380 (Fed. Cir. 2013). “However, for any aspects that may have special or unique application to patent cases, Federal Circuit precedent is applicable.” *Id.* (citation omitted). The Eleventh Circuit reviews *de novo* a district court’s determination of issue preclusion, *EEOC v. Pemco Aeroplex, Inc.*, 383 F.3d 1280, 1285 (11th Cir. 2004), and requires a showing of all four of the following elements:

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“(1) the issue at stake must be identical to the one involved in the prior litigation; (2) the issue must have been actually litigated in the prior suit; (3) the determination of the issue in the prior litigation must have been a critical and necessary part of the judgment in that action; and (4) the party against whom the earlier decision is asserted must have had a full and fair opportunity to litigate the issue in the earlier proceeding.”

CSX Transp., 327 F.3d at 1317 (emphases added).

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Voter Verified does not specifically argue that issue preclusion applies under the Eleventh Circuit’s test. But Election Systems argues that issue preclusion should not apply because at least two of the required elements have not been met. First, Election Systems contends that by choosing not to respond to Voter Verified’s arguments against its § 101 invalidity counterclaim, the issue was never “actually litigated.” See Oral Arg. at 20:30–22:35. Second, Election Systems asserts that a determination of invalidity under § 101 was not critical or necessary to the ultimate judgment of noninfringement. See *id.* at 22:35–22:45.

We agree with Election Systems on both points. First, the § 101 issue was not actually litigated. It was in fact barely considered. The district

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court disposed of the § 101 issue when Election Systems chose not to respond. From the court's opinion, it appears, as Election Systems has argued, that the § 101 issue was never "actually litigated," because the court did not evaluate that question. See Restatement (Second) of Judgments § 27, cmt. e (1982) ("A judgment is not conclusive in a subsequent action as to issues which might have been but were not litigated and determined in the prior action.").

Second, the § 101 issue of invalidity was not necessary to the judgment in the first district court action. Whether issues of invalidity are critical or necessary to a judgment holding that a defendant is not liable for infringement is an aspect that is "special or unique" to patent cases. *Aspex Eyewear*, 713 F.3d at 1380. Validity and infringement are separate concepts. In *Cardinal Chemical*, the Supreme Court noted that invalidity and infringement were independent issues. See *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 96 (1993) (stating that a party seeking a judgment of invalidity "presents a claim independent of the patentee's charge of infringement"). Consequently, either an invalidity or a noninfringement

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determination is sufficient for a final judgment holding that a party is not liable for infringement.

In the first litigation, the Middle District of Florida held that Election Systems was not liable for infringement of the '449 patent. In so holding, the district court reached the conclusions that (1) claims 1–93 were not infringed; (2) claim 94 was invalid

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under § 112; (3) claims 1–93 were not invalid under §§ 101 and 112; (4) claim 49 was invalid under § 103; and (5) claims 1–48, 50–84, and 86–92 were not invalid under §§ 102 and 103. The court did not specify which of these determinations were critical or necessary to the final judgment. See Restatement (Second) of Judgments § 27, cmt. i (1982) (“If a judgment of a court of first instance is based on determinations of two issues, either of which standing independently would be sufficient to support the result, the judgment is not conclusive with respect to either issue standing alone.”); cf. *id.* § 27, cmt. h, illus. 14 (illustrating that in a suit for trademark infringement, a determination that the trademark is both valid and not infringed does not preclude the same defendant from the defense of invalidity in a subsequent action between the parties). Moreover, as we previously observed, the § 101 issue was not actually litigated. As a result, it is clear that the § 101 issue was not critical or necessary to the final judgment. We therefore conclude that issue preclusion does not apply in this case, not because there was a change in law as the district court held, but because the issue of patent eligibility under § 101 was not actually litigated and it was not necessary to the judgment rendered.

III. Patent Eligibility under § 101 Because issue preclusion does not apply here, we turn to the merits of the § 101 issue. Patent eligibility under § 101 “is ultimately an issue of law we review *de novo*.” *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018) (*italics added*). Patent eligibility can be determined

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at the Rule 12(b)(6) stage “when there are no factual allegations that, taken as true, prevent resolving the eligibility question as a matter of law.” *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1125 (Fed. Cir. 2018).

Under § 101, “[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.” 35 U.S.C. § 101. Under the two-step framework, we first “determine whether the claims at issue are directed to a patent-ineligible concept.” *Alice*, 134 S. Ct. at 2355. If so, then we “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.” *Id.* at 2357 (quoting *Mayo*, 566 U.S. at 72–73, 78).

Voter Verified argues that the claims of the ’449 patent are directed to patent-eligible subject matter because the specification and claims describe “physical” and “human cognitive actions,” which are not abstract ideas. Appellant’s Br. 11. And at step two of the framework, Voter Verified contends that the district court incorrectly found that only generic computer components were required because a voter performs some of the claimed steps as well.

In response, Election Systems argues that the

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claims are directed to the abstract idea of “voting and checking the accuracy of a paper election ballot.” Appellee’s Br. 30. Furthermore, Election Systems contends that this represents only a well-established human activity. Because the patent only discloses use of general purpose computers, Election Systems argues that this is nothing more than automating a fundamental human activity, which is insufficient to transform the claimed abstract idea into patent-eligible subject matter under step two. Election [Opinion Page 12]

Systems additionally argues that all of the claims recite nothing more than additional abstract ideas or generic computer components.

The claims before us are claims 1–48 and 50–93 (the “remaining claims”); this excludes claims 49 and 94, which were previously finally held to be invalid. Of the remaining independent claims, claims 85 and 93 recite “self-verification” voting methods, and claims 1, 25, and 56 recite closely related self-verifying voting systems. Method claim 85 and system claim 56 are exemplary of the method and system claims and read as follows:

85. A method for voting providing for selfverification of a ballot comprising the steps of:

(a) voting by a voter using a computer voting station programmed to present an election ballot,

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accept input of votes from the voter according to the election ballot,

temporarily store the votes of the voter;

(b) printing of the votes of the voter from the votes temporarily stored in the computer for the voting station;

(c) comparison by the voter of the printed votes with the votes temporarily stored in the computer for the voting station;

(d) decision by the voter as to whether a printed ballot is acceptable or unacceptable; and

(e) submission of an acceptable printed ballot for tabulation.

'449 patent col. 11 ll. 53–68.

56. A self-verifying voting system comprising:

one or more voting stations comprising:

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(a) one or more computer programs which operate in a computer to display

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general voting instructions, at least one election ballot showing the candidates and/or issues to be voted on, and directions to the voter for operation of the system;

present the election ballot for voting and input of votes by the voter;

accept input of the votes from the voter;

print out the election ballot according to which the voter voted with the votes of the voter printed thereon, so that the votes of the voter are readable on said election ballot by the voter and readable by a ballot scanning machine; and record the votes in the computer;

(b) at least one computer with at least one display device, at least one device to accept voting input from a voter, and sufficient memory to provide for the operation of said computer program;

(c) a printer connected to said computer for printing the election according to which the voter voted;

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(d) a ballot scanning machine for reading the votes on the printed ballot printed according to the election ballot which the voter voted and

a means for tabulating the printed ballots generated by said one or more voting stations.

Id. col. 10, ll. 7–33.

We agree with Election Systems that these claims are directed to patent-ineligible subject matter. The factual

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allegations here, taken as true, do not prevent a § 101 determination at the Rule 12(b)(6) stage. While these claims encompass both methods and systems, we find there to be no distinction between them for § 101 purposes, as they simply recite the same concept. See *Alice*, 134 S. Ct. at 2360 (“[T]he system claims are no different from the method claims in substance. The method claims recite the abstract idea implemented on a generic computer; the system claims recite a handful of generic computer components configured to implement the same idea.”).

First, the claims as a whole are drawn to the concept of voting, verifying the vote, and submitting the vote for tabulation. Humans have performed this fundamental activity that forms the basis of our

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democracy for hundreds of years. See '449 patent col. 2 ll. 62–66 (stating that the “voting process is ultimately founded upon the law which governs elections”); see also U.S. Const. art. I, § 1, cl. 1 (1789) (conveying a right in the “People of the several States” to vote). Even Voter Verified characterized these steps as “human cognitive actions.” Appellant’s Br. 11. These steps are therefore nothing more than abstract ideas. Cf. *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1373 (Fed. Cir. 2011) (“[M]ethods which can be performed entirely in the human mind are the types of methods that embody the ‘basic tools of scientific and technological work’ that are free to all men and reserved exclusively to none.” (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972))).

Second, there is no inventive concept in the claims sufficient to transform them into patent-eligible subject matter. Neither party disputes that the claims recite the use of general purpose computers that carry out the abstract idea. See '449 patent col. 6 l. 18–col. 12 l. 24 (reciting, inter alia, “a standard personal computer,” “a visual display device,” and “a keyboard”); see also *id.* col. 3 l. 12–col. 4 l. 28 (disclosing use of, inter alia, “data storage [Opinion Page 15] devices,” “a laser printer,” and a scanner “from the well known art”). The case law has consistently held that these standard components are not sufficient to transform abstract claims into patent-eligible subject

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matter.² Voter Verified’s argument that these steps are not only performed by generic computer components, but also performed by a voter, was addressed under step one when they were determined to be an abstract idea. Because all of the remaining claims only recite different variations of the same abstract idea being performed with other generic computer components, we therefore conclude that the district court properly determined that the claims of the ’449 patent are invalid under § 101.

² See, e.g., *Alice*, 134 S. Ct. at 2359–60 (holding that “implement[ing] the abstract idea . . . on a generic computer” was not sufficient “to transform an abstract idea into a patent-eligible invention”); *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1341–42 (Fed. Cir. 2017) (holding that “using generic computer components and conventional computer data processing activities” was not sufficient to find an “inventive concept”); *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 613–14 (Fed. Cir. 2016) (“These steps fall squarely within our precedent finding generic computer components insufficient to add an inventive concept to an otherwise abstract idea.”); *Mortg. Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1324–25 (Fed. Cir. 2016) (holding that generic computer components such as an “interface,” “network,” and “database” fail to satisfy the “inventive concept requirement” (internal quotation marks omitted)); *Content Extraction*, 776 F.3d at 1347–48 (“There is no ‘inventive concept’ in [Content

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Extraction's] use of a generic scanner and computer to perform wellunderstood, routine, and conventional activities commonly used in industry.").

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We have considered Voter Verified's remaining arguments, but find them unpersuasive.

CONCLUSION

For the foregoing reasons, we affirm the district court's dismissal of the complaint under Rule 12(b)(6) because all of the remaining claims of the '449 patent are invalid under § 101.

AFFIRMED

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698 F.3d 1374 (Fed. Cir., 2013)

VOTER VERIFIED, INC.,
Plaintiff–Appellant,
v.
PREMIER ELECTION SOLUTIONS, INC., et al
Defendant–Cross–Appellants,

* * *
[698 F.3d 1377]

Before LOURIE, REYNA, and WALLACH, Circuit Judges.

LOURIE, Circuit Judge.

These consolidated appeals stem from two related patent infringement actions brought in the United States District Court for the Middle District of Florida by Voter Verified, Inc. (“Voter Verified”) against Premier Election Solutions, Inc. (“Premier”), Diebold, Inc. (“Diebold”), and Election Systems & Software, Inc. (“Election Systems”) (collectively, “Defendants”) in which Voter Verified alleged infringement of claims 1–94 of U.S. Reissue Patent RE40, 449 (the “449 patent”).¹ As the respective appellate briefs are virtually identical, we consider the cases together.

On summary judgment, the district court held claims 1–93 not infringed and invalidated claims 49 and 94, but the court also dismissed the Defendants' counterclaim that claims 85 and 93 are invalid and held that claims 1–48, 50–84, and 86–92 are not

invalid. *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, No. 6:09-cv-1968 (M.D.Fla. Aug. 31, 2011) (Final Judgment), ECF No. 251; *Voter Verified, Inc. v. Election Sys. & Software, Inc.*, No. 6:09-cv-1969 (M.D.Fla. Sept. 1, 2011) (Final Judgment), ECF No. 197. On appeal, Voter Verified challenges a large number of the district court's rulings, including its judgments in favor of the Defendants on infringement and invalidity, while Premier and Election Systems cross-appeal as to the validity of the surviving claims of the ' 449 patent. For the reasons that follow, we affirm.

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[698 F.3d 1381]

2. Claims 1–48, 50–84, and 86–92

Premier and Election Systems argue in their cross-appeals that the district

[698 F.3d 1382]

court erroneously granted summary judgment in favor of Voter Verified on the validity of claims 1–48, 50–84, and 86–92. Premier and Election Systems contend that because Voter Verified (1) was not actively asserting most of those claims and (2) had moved to terminate the case, the district court lacked jurisdiction to make its ruling on validity. We disagree.

The initial complaint in this case alleged infringement of every claim of the '449 patent, and while Voter Verified later pared back its infringement contentions, it did so with the caveat that discovery might dictate reintroducing “other claims in the patents in suit.” In addition, Premier and Election Systems kept any “unasserted” claims before the district court by maintaining their respective counterclaims that alleged invalidity of “[e]ach claim of the '449 patent.” When Voter Verified moved for summary judgment on those counterclaims, Premier and Election Systems never responded with viable arguments or evidence to support their invalidity contentions regarding claims 1–48, 50–84, and 86–92, despite multiple opportunities to do so.³

As the district court recognized, it was ultimately up to Premier and Election Systems to establish each of their invalidity counterclaims by clear and convincing evidence; yet they failed to mount a response to Voter Verified's summary judgment motion on the claims now at issue. Furthermore, we fail to see how Voter Verified's intervening motion to suspend or terminate the proceedings for appeal—a motion that was never granted—absolves Premier and Election Systems of that fundamental burden. Because Premier and Election Systems failed to adequately support their own counterclaims, the district court did not err by granting Voter Verified's

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summary judgment motion that claims 1–48, 50–84, and 86–92 were not proven invalid.