

No. 18-1448

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

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GLASSWALL SOLUTIONS LIMITED,  
GLASSWALL (IP) LIMITED,

*Petitioners,*

v.

CLEARSWIFT, LTD.,

*Respondent.*

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**On Petition For Writ Of Certiorari  
To The United States Court Of Appeals  
For The Federal Circuit**

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**BRIEF FOR THE RESPONDENT IN OPPOSITION**

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## QUESTIONS PRESENTED

Glasswall's petition asserts that the Federal Circuit is inconsistently applying 35 U.S.C. § 101 because that court sometimes affirms dismissals under Fed. R. Civ. P. 12(b)(6) on grounds that patent claims are directed to ineligible subject matter (*e.g.*, in the instant case), and sometimes concludes that questions of fact preclude dismissal (*e.g.*, in the *Berkheimer* case). But there is no inconsistency. When, as here, the claims are directed to an abstract idea and clearly include no transformative inventive concept, Rule 12 dismissal is appropriate. In contrast, when there are genuine issues of fact as to whether a claim element or combination of elements was well-understood, routine or conventional to a skilled artisan, dismissal on the pleadings may be inappropriate.

The questions presented are:

1. Whether the district court and the Federal Circuit correctly held that the claims asserted here are patent-ineligible because they are directed to an abstract concept and require nothing more than routine application of a general-purpose computer.
2. Whether the district court and the Federal Circuit properly held that the issue of patent-eligibility could be resolved at the pleading stage even though Glasswall's Amended Complaint contained conclusory allegations of improved computer performance.

**RULE 29.6 STATEMENT**

Clearswift Holding Ltd. and RUAG Holding AG  
hold 10% or more of Respondent's stock.

## TABLE OF CONTENTS

	Page
I. INTRODUCTION .....	1
II. BACKGROUND .....	3
A. Legal Background.....	3
B. The Patents at Issue.....	6
C. Procedural History .....	8
III. ARGUMENT .....	12
A. The Federal Circuit’s Standard for De- ciding Patent-Eligibility Issues on Mo- tions to Dismiss is Clear.....	12
1. <i>Berkheimer</i> and <i>Aatrix</i> Did Not An- nounce a New Standard.....	12
2. The Federal Circuit Has Been Con- sistent in Analyzing Section 101 Chal- lenges.....	13
B. The District Court and the Federal Cir- cuit Reached the Correct Outcome .....	17
1. The District Court and the Federal Circuit Correctly Disregarded Con- clusory Allegations Contained in Glasswall’s Amended Complaint .....	18
2. The District Court and the Federal Circuit Correctly Analogized the Claims Here to Those Previously Held Patent-Ineligible .....	21
3. The District Court and the Federal Circuit Considered Sufficient Evi- dence, Including the Patents’ Com- mon Specification.....	23

TABLE OF CONTENTS – Continued

	Page
C. This Case is a Poor Vehicle to Resolve the Questions Presented by Glasswall.....	26
IV. CONCLUSION.....	27

## TABLE OF AUTHORITIES

	Page
CASES	
<i>Aatrix Software, Inc. v. Green Shades Software, Inc.</i> , 882 F.3d 1121 (Fed. Cir. 2018).....	17
<i>Aatrix Software, Inc. v. Green Shades Software, Inc.</i> , 890 F.3d 1354 (Fed. Cir. 2018).....	5, 12
<i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i> , 573 U.S. 208, 134 S. Ct. 2347 (2014) .....	<i>passim</i>
<i>Ashcroft v. Iqbal</i> , 556 U.S. 662, 129 S. Ct. 1937 (2009).....	18, 20
<i>Ass’n for Molecular Pathology v. Myriad Genetics, Inc.</i> , 569 U.S. 576, 133 S. Ct. 2107 (2013).....	3
<i>Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC</i> , 915 F.3d 743 (Fed. Cir. 2019).....	14, 15
<i>Berkheimer v. HP Inc.</i> , 881 F.3d 1360 (Fed. Cir. 2018) .....	<i>passim</i>
<i>Cleveland Clinic Found. v. True Health Diagnostics LLC</i> , No. 2018-1218, slip op. (Fed. Cir. Apr. 1, 2019) .....	13, 14, 16, 18
<i>Elec. Power Grp., LLC v. Alstom, S.A.</i> , 830 F.3d 1350 (Fed. Cir. 2016) .....	4
<i>Enfish, LLC v. Microsoft Corp.</i> , 822 F.3d 1327 (Fed. Cir. 2016) .....	15, 22, 24
<i>Finjan, Inc. v. Blue Coat Sys., Inc.</i> , 879 F.3d 1299 (Fed. Cir. 2018) .....	15, 24
<i>Intellectual Ventures I LLC v. Capital One Bank (USA)</i> , 792 F.3d 1363 (Fed. Cir. 2015) .....	21

## TABLE OF AUTHORITIES – Continued

	Page
<i>Intellectual Ventures I LLC v. Capital One Fin. Corp.</i> , 850 F.3d 1332 (Fed. Cir. 2017).....	22, 23
<i>Intellectual Ventures I LLC v. Erie Indem. Co.</i> , 850 F.3d 1315 (Fed. Cir. 2017) .....	13, 23
<i>Intellectual Ventures I LLC v. Symantec Corp.</i> , 838 F.3d 1307 (Fed. Cir. 2016) .....	4, 5, 8, 22, 23
<i>Interval Licensing LLC v. AOL, Inc.</i> , 896 F.3d 1335 (Fed. Cir. 2018) .....	15, 22, 23
<i>Marder v. Lopez</i> , 450 F.3d 445 (9th Cir. 2006) .....	19
<i>Mayo Collaborative Servs. v. Prometheus Labs., Inc.</i> , 566 U.S. 66, 132 S. Ct. 1289 (2012) .....	3, 4, 5, 9
<i>OIP Techs., Inc. v. Amazon.com, Inc.</i> , 788 F.3d 1359 (Fed. Cir. 2015) (Mayer, J. concurring).....	16
<i>RecogniCorp, LLC v. Nintendo Co., Ltd.</i> , 855 F.3d 1322 (Fed. Cir. 2017) .....	4
<i>Secured Mail Sols. LLC v. Universal Wilde, Inc.</i> , 873 F.3d 905 (Fed. Cir. 2017) .....	<i>passim</i>
 STATUTES	
35 U.S.C. § 101 .....	<i>passim</i>
35 U.S.C. § 282 .....	18
 OTHER AUTHORITIES	
Fed. R. Civ. P. 12.....	1
Fed. R. Civ. P. 12(b)(6) .....	<i>passim</i>

## I. INTRODUCTION

The decisions of the district court and the Federal Circuit in this case present no questions worthy of review by this Court. The patent claims at issue are directed to reviewing incoming content and forwarding only content that corresponds with an approved format. The patent contrasts this approach with the prior art approach of comparing incoming content to see if it matches an objectionable format (*e.g.*, a virus signature). In other words, the claims are directed to taking a “whitelist” approach to reviewing content as opposed to a “blacklist” approach.

The district court and the Federal Circuit applied this Court’s precedent, construed the claims as a matter of law, and properly held that they were directed to an abstract concept. Although there are circumstances where the second step of the *Alice* test involves underlying questions of fact, this case is not one of them. In this case, the claims preempt the use of a whitelist approach, and conclusory allegations that a whitelist approach is an advantage over the prior art and improves the performance of a computer do not render the patents immune from invalidation at the pleading stage.

Glasswall contends that the Federal Circuit is irreconcilably split over whether patents can be invalidated at the pleading stage. Glasswall suggests that the invalidity ruling in this case, issued in the context of a Rule 12 motion, necessarily conflicts with decisions refusing dismissal on grounds that there were



questions of fact as to whether the claims added an inventive concept that required more than well-understood, routine and conventional applications of technology in the relevant field.

There is no inherent inconsistency, however, with courts holding that some patent claims are directed to ineligible subject matter as a matter of law, while the analysis for other patent claims involves underlying issues of fact. *See Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018). All patents are not the same. Moreover, even in *Berkheimer*, where the Federal Circuit held there was an underlying issue of fact, the Federal Circuit noted that “[n]othing in [its] decision should be viewed as casting doubt on the propriety of those cases [deciding eligibility as a matter of law].” *Id.* As the court observed, “not every § 101 determination contains genuine disputes over the underlying facts material to the § 101 inquiry.” *Id.*

The Federal Circuit’s approach to eligibility is consistent with *Alice* and other Section 101 precedent from this Court. There are times when the scope of the claims can be determined to be ineligible as a matter of law. There are other times when there are genuine disputes of material fact that must first be addressed. This does not create any “disarray” or inconsistency in the law.

Further, to the extent that Glasswall seeks to change Section 101 law, that would be more appropriate for the legislative branch. Indeed, Congress is

currently exploring statutory revisions relating to Section 101.

For all these reasons, Glasswall’s petition should be denied.

## II. BACKGROUND

### A. Legal Background

Under 35 U.S.C. § 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. . . .” But the Court has consistently held that “[l]aws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216, 134 S. Ct. 2347 (2014) (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589, 133 S. Ct. 2107, 2116 (2013)). These exceptions exist because abstract ideas, laws of nature, and natural phenomena are the “basic tools of scientific and technological work[.]” *Alice*, 134 S. Ct. at 2354.

The Court has established a two-step framework to identify patents that are invalid for claiming patent-ineligible concepts. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 132 S. Ct. 1289, 1293 (2012). At step one, a court must determine whether the claim is “directed to” a patent ineligible concept, such as an abstract idea. *Alice*, 134 S. Ct. at 2355. To distinguish claims that are directed to abstract ideas

from those that merely involve abstract ideas, the lower courts have looked to “the ‘focus’ of the claims” and “their ‘character as a whole.’” *Elec. Power Grp., LLC v. Alstom, S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (citations omitted).

At step two, if the claim is directed to an abstract idea, the court examines specific claim limitations to determine whether they furnish an “inventive concept” that transforms the abstract idea into a patent-eligible application of the idea. *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1294); see also *RecogniCorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (“[A]n inventive concept must be evident in the claims.”). Step two is a “search for . . . 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.” *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1294; internal quotations omitted and emphasis added). An attempt “to limit the use of the [abstract idea] to a particular technological environment” is not sufficient. *Mayo*, 132 S. Ct. at 1297 (internal quotations and citation omitted). Nor is it enough to “append[] . . . well-understood, routine, conventional activities previously engaged in by workers in the field.” *Intellectual Ventures I LLC v. Symantec Corp.* 838 F.3d 1307, 1313 (Fed. Cir. 2016) (hereinafter “*Symantec*”) (quoting *Alice*, 134 S. Ct. at 2357, 2359; internal quotations omitted and alterations incorporated). “Claims that amount to nothing significantly more than an instruction to apply [an] abstract idea . . .

using some unspecific, generic computer and in which each step does no more than require a generic computer to perform generic computer functions do not make an abstract idea patent-eligible. . . .” *Symantec*, 838 F.3d at 1315 (internal quotations and citations omitted).

Following this Court’s holdings in *Mayo* and *Alice*, the Federal Circuit has applied that two-step test to uphold or reject the eligibility of patents throughout various stages of litigation, including motions to dismiss, judgments on the pleadings, and motions for summary judgment. *See Aatrix Software, Inc. v. Green Shades Software, Inc.*, 890 F.3d 1354, 1358 (Fed. Cir. 2018) (listing cases). The Federal Circuit has recognized, however, that not every Section 101 challenge can be resolved during earlier stages of litigation and that the second step of some Section 101 inquiries may involve questions of fact as to whether claim elements are well-understood to a skilled artisan in the relevant field. *Berkheimer*, 881 F.3d at 1368. But that does not mean that *every* Section 101 analysis involves disputed questions of fact that prevent finding claims patent-ineligible during the early stages of a litigation. Even in decisions finding that issues of fact prevent judgment of invalidity as a matter of law, the Federal Circuit has made clear that such issues do not exist for all patents. *Id.* (“Patent eligibility has in many cases been resolved on motions to dismiss or summary judgment. Nothing in this decision should be viewed as casting doubt on the propriety of those cases. When there is no genuine issue of material fact regarding whether the claim

element or claimed combination is well-understood, routine, conventional to a skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law.”).

### **B. The Patents at Issue**

This case involves two patents from the same family: United States Patents 8,869,283 and 9,516,045.<sup>1</sup> Both patents are directed to virus-protection software. Unlike “traditional” virus-protection software, both patents teach extracting approved content from a file and putting that content into another file of the same type. The patents claim methods or systems of “receiving an electronic file, determining the data format [from predefined and well-accepted formats such as CSV files], parsing the content data to determine whether it conforms to the predetermined data format, and if so, regenerating the parsed data to create a regenerated electronic file.” Pet. App. 7a.<sup>2</sup>

This is analogous to an executive assistant opening the executive’s mail, removing anything that does not conform to a certain standard (*e.g.*, business or personal correspondence), and then repackaging the approved content. It is simply passing approved content,

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<sup>1</sup> Because the ’045 patent is a continuation of the ’283 patent, they share nearly-identical specifications. Pet. App. 7a. All citations in this brief are to the ’283 specification.

<sup>2</sup> Claim 1 of the ’283 patent and claim 1 of the ’045 patent were treated as representative of all the claims in the proceedings below. Pet. App. 10a n.2.

as opposed to the traditional filtering of disapproved content.

Figure 1C lays out the steps of the method as carried out by the “AV Application 105” to “determine whether the electronic file 101 is allowed to pass through to the destination operating system 107”:

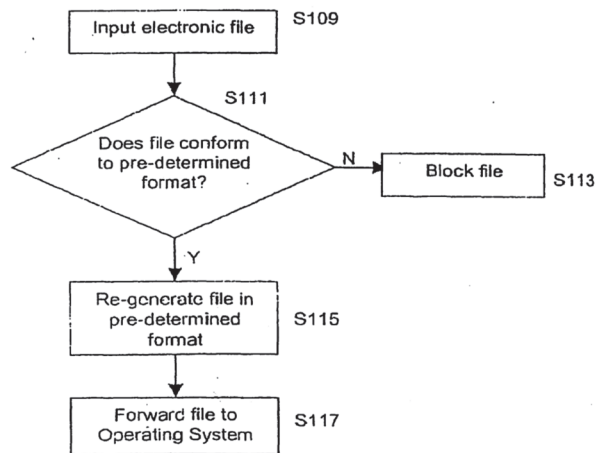


FIG. 1C

C.A. App. 022, col. 5, ll. 41-49.

The AV Application allows through only electronic files that “conform to one of a plurality of stored known, allowable, pre-defined formats.” C.A. App. 022, col. 5, ll. 53-55. As the patents explain:

If the electronic file does not conform to any pre-determined format it is not regenerated, and so is effectively blocked. . . . However, if the electronic file does conform to the pre-determined format, the content data is extracted from it . . . and is re-generated . . . by the conformity analyzing device in the

pre-determined format associated with that electronic file type, to make up a substitute file, as shown at step S115.

C.A. App. 023, col. 6, ll. 40-53.

The patent calls for the generic steps of this abstract idea to be implemented on a general-purpose computer. The claims do not call for creation of a new kind of file, nor do they call for any technological solution of a technical problem. Instead, the claims simply require “generic computer-implemented steps.” *Symantec*, 838 F.3d at 1318. Moreover, the claims do not specify *how* any of these generic steps are implemented; they are framed in functional terms with no indication that they rely on anything other than a conventional implementation of the abstract idea.

### **C. Procedural History**

Glasswall filed its Complaint for Patent Infringement in November 2016 and an Amended Complaint in January 2017. In its Amended Complaint, Glasswall included a conclusory paragraph for each patent in which it alleged that the “technical solutions claimed in [each patent] are inventive solutions eligible for patent protection rather than a mere abstract idea.” C.A. App. 078-79 ¶ 15; C.A. App. 085 ¶ 32. According to Glasswall’s pleading, the inventions in each patent “feature[] novel methods and devices that improve the technology used in electronic communications and electronic data exchange via computer” and “appl[y] technical solutions unique to electronic

communication and electronic data transfer to solve technical problems that are unique to electronic communications and electronic data transfer. . . .” C.A. App. 078-79 ¶ 15; C.A. App. 085 ¶ 32.

Clearswift filed a Rule 12(b)(6) motion to dismiss, asserting that the claims of both patents were directed to patent-ineligible subject matter. In its motion, Clearswift explained that the claims (1) were directed to an abstract idea of filtering and parsing electronic files and forwarding copies, and (2) recited only generic functionality and components rather than any inventive concept sufficient to save the claims under step two of the *Alice* analysis. Clearswift further explained that it was appropriate to address the eligibility of Glasswall’s claims at the Rule 12(b)(6) stage because the basic character of the claims was clear on their face and that, despite Glasswall’s conclusory assertions in the Amended Complaint, the claims are not directed to an improvement in computer functionality. C.A. App. 111-12, 123-26.

In response, Glasswall focused on what the patents were “directed to” at *Mayo/Alice* step one. Like the claims, Glasswall’s description was purely functional. *See, e.g.*, C.A. App. 154 (“The claims require receiving incoming electronic files, identifying the correct file type(s), analyzing the file content to identify conforming content then regenerating conforming content into a new file, and applying the ‘preapproval’ or ‘authorized’ analyses.”). Glasswall did not argue that interpretation of any terms in the patent was necessary to address the arguments in Clearswift’s motion



to dismiss. To the contrary, although Glasswall complained that Clearswift's challenge was premature, Glasswall stated that the "basic character of the claims" was evident upon review of the specification and claims. C.A. App. 158. Glasswall also provided two declarations with additional information about its products, and the legal conclusions of its technical consultant and a patent attorney. *Id.*; *see also* C.A. App. 161-69, 171-75.

The district court granted Clearswift's motion and dismissed the case. The court first rejected Glasswall's suggestion that it was improper to rule at the Rule 12(b)(6) stage because the "basic character of the claims [ould] be understood on their face . . .," as Glasswall itself had recognized. Pet. App. 12a (citations omitted). It likewise refused to consider Glasswall's declarations because they were outside the pleadings and provided information "not central to Plaintiff's claims." Pet. App. 6a n.1.

The court then applied the two-step framework set forth in *Alice*. At step one, the court concluded that the claims were directed to an abstract idea. It explained that the claim language in the '283 and '045 patents was comparable to other claims the Federal Circuit had found to be directed to the abstract idea of "filtering of electronic files and data." Pet. App. 14a-15a. Based on the language of the claims, it reasoned: "The file is analyzed to see if it conforms to certain parameters, and if data is found that does not conform, it is extracted and the file is regenerated without it. This is analogous to content censoring or the redaction of

private information from public documents. . . .” Pet. App. 15a.

The court rejected Glasswall’s attempt to rely on extraneous details from the specifications that were not recited in the claims, Pet. App. 16a, and concluded that even if details from the specifications were included, the claims were not directed to the type of improvement in computer functionality that the Federal Circuit has found patent-eligible. Pet. App. 16a-17a. The court also declined to rely on administrative guidance from the U.S. Patent and Trademark Office (“USPTO”) because that guidance was non-precedential and pre-dated the most recent Federal Circuit authority, and it further distinguished the exemplary claims set forth in the USPTO guidance cited by Glasswall. Pet. App. 17a-18a.

At step two, the court found no inventive concept sufficient to save the claims. Pet. App. 18a-19a (“None of these limitations in the claim language disclose new, specific components or techniques, or are directed toward an improvement in the way a computer functions, rather [they] are directed to the application of an abstract idea to a generic computer as an alternative to other ‘virus screening’ software.”).

On appeal, the Federal Circuit affirmed in a short (five-page), unanimous, non-precedential decision. Pet. App. 1a-5a. The Federal Circuit specifically agreed that Glasswall could not “render its complaint immune from dismissal by merely asserting that its methods

are ‘novel’ and ‘improve the technology used in electronic communications.’” Pet. App. 5a.

### **III. ARGUMENT**

#### **A. The Federal Circuit’s Standard for Deciding Patent-Eligibility Issues on Motions to Dismiss is Clear**

##### **1. *Berkheimer* and *Aatrix* Did Not Announce a New Standard**

Glasswall’s petition rests on an alleged split among Federal Circuit judges on the correct standard for assessing patent-eligibility challenges under 35 U.S.C. § 101. Glasswall asserts that the *Berkheimer* and *Aatrix* decisions “signal a course correction by the Federal Circuit,” because the second step of the *Mayo/Alice* test can involve questions of fact. Pet. 14. Glasswall complains, however, that some post-*Berkheimer* and *Aatrix* decisions “continue to bypass proper analysis of fact questions under the Rule 12(b)(6) standard.” *Id.*

There is, however, no inconsistency. The Federal Circuit in *Berkheimer* confirmed that “[p]atent eligibility under 35 U.S.C. § 101 is ultimately an issue of law [that it] review[s] de novo.” *Berkheimer*, 881 F.3d at 1365. But the Federal Circuit also recognized that “[t]he patent eligibility inquiry may contain underlying issues of fact.” *Id.* The standard announced in *Berkheimer* and *Aatrix* was not a “course correction” by the Federal Circuit, but instead comported with the

standard of review long employed by the Federal Circuit in Section 101 cases.

Glasswall’s suggestion that a Section 101 inquiry *always* contains underlying factual issues is incorrect. For example, in *Intellectual Ventures I LLC v. Erie Indemnity Co.*, the patent itself observed that the claim elements recited were conventional. 850 F.3d 1315, 1331-32 (Fed. Cir. 2017) (hereinafter “*Erie*”). The fact that the patent confirmed that the claims employed only conventional, well-known steps eliminated any need for the Federal Circuit to consider anything outside the intrinsic evidence normally considered in a Rule 12(b)(6) determination. *Id.*; see also *Secured Mail Solutions LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 912 (Fed. Cir. 2017) (“Yet, this court has determined claims to be patent-ineligible at the motion to dismiss stage based on intrinsic evidence from the specification without need for extraneous fact finding outside the record.”) (internal quotations omitted).

## **2. The Federal Circuit Has Been Consistent in Analyzing Section 101 Challenges**

The cases cited by Glasswall did not bypass a factual analysis; they simply found no need to determine any disputed underlying factual issues before holding that the claims-at-issue were patent-ineligible.

For example, in *Cleveland Clinic Foundation v. True Health Diagnostics LLC*, the Federal Circuit clearly stated the standard that Glasswall alleges it

failed to follow. No. 2018-1218, slip op. at 8 (Fed. Cir. Apr. 1, 2019) (“Patent eligibility under § 101 is a question of law that can include subsidiary questions of fact.”). But the court recognized that “[s]uch factual issues may be resolved on the pleadings based on the sources properly considered on a motion to dismiss, such as the complaint, the patent, and materials subject to judicial notice.” *Id.* (internal quotations omitted). Similar to Glasswall’s complaint here, the patent owner in *Cleveland Clinic* claimed the district court had improperly resolved factual disputes against it. The Federal Circuit disagreed, however, because “[t]here is no reason to task the district court with finding an inventive concept that the specification and prosecution history concede does not exist.” *Id.* at 11-12; see also *Secured Mail*, 873 F.3d at 913 (stating that when ruling on a 12(b)(6) motion, the court need not accept as true allegations that contradict the claims and patent specification).

Similarly, in *Athena Diagnostics, Inc. v. Mayo Collaborative Services, LLC*, the court held the asserted claims patent-ineligible because purely conventional activity is insufficient to transform an unpatentable law of nature into patent-eligible subject matter. 915 F.3d 743, 753 (Fed. Cir. 2019). As Glasswall does here, the patent owner argued that the district court needed to conduct fact-finding before resolving the Section 101 issue. *Id.* at 755. But the Federal Circuit held that when there are no factual allegations that show that the claims recite anything other than standard elements “known per se in the art” (as confirmed by the

patent specification), patent-ineligibility can be determined on the pleadings. *Id.* The Federal Circuit held that the district court correctly did not consider the expert declaration submitted by the patent owner because the declaration made statements inconsistent with the patent and did not merge into the pleadings like the patent itself. *Id.* at 755-56.

Glasswall is incorrect in suggesting, Pet. 15, that the Federal Circuit's decision in *Interval Licensing LLC v. AOL, Inc.* failed to accept well-pleaded facts. Instead, the court recognized that a patent-eligibility analysis may turn on underlying issues of fact, but simply found that in that case "there [were] no disputed facts material to the issue of patent eligibility. . . ." 896 F.3d 1335, 1342 n.4 (Fed. Cir. 2018). That was so because the claims merely disclosed generic components that operated in a conventional way and "the patent [was] wholly devoid of details which describe[d] *how* [the purported improvement was] accomplished." *Id.* at 1346-47 (emphasis in original).

Glasswall also asserts that the Federal Circuit's *Enfish, LLC v. Microsoft Corp.* and *Finjan, Inc. v. Blue Coat Systems, Inc.* decisions were inconsistent with the decisions above. In those cases, however, the Federal Circuit concluded that the claims were not directed to an abstract concept in the first place. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016) (finding the claims not abstract under *Alice* step one); *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1305 (Fed. Cir. 2018) (same). In those cases, the court never needed to assess whether factual issues existed under

the second step of the analysis, the area where Glasswall asserts there is conflict.

Properly read, the cases cited by Glasswall raise no conflict over whether a Section 101 inquiry may include underlying questions of fact. All these cases confirm that patent-eligibility is a legal question that *may or may not* contain underlying issues of fact. *See Berkheimer*, 881 F.3d at 1368. Moreover, some factual issues can be resolved on the pleadings based upon sources properly considered at the motion to dismiss stage, including the complaint and the patent’s specification, and claim language. *Cleveland Clinic*, slip. op. at 8. In particular, a patent owner cannot manufacture questions of fact by including statements in the complaint that clearly contradict the patent’s specification. Pet. App. 5a. So “where, as here, asserted claims are plainly directed to a patent ineligible abstract idea, [the Federal Circuit] ha[s] repeatedly sanctioned a district court’s decision to dispose of them on the pleadings.” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1364-65 (Fed. Cir. 2015) (Mayer, J. concurring).

The Federal Circuit in *Berkheimer* expressly recognized that “[p]atent eligibility has in many cases been resolved on motions to dismiss or summary judgment.” 881 F.3d at 1368. The court also reinforced that “[n]othing in th[at] decision should be viewed as casting doubt on the propriety of those cases” because “[w]hen there is no genuine issue of material fact regarding whether the claim element or claimed combination is well-understood, routine, conventional to a

skilled artisan in the relevant field, this issue can be decided on summary judgment as a matter of law.” *Id.*

The Federal Circuit reinforced these same principles in *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1125 (Fed. Cir. 2018), reaffirming that “patent eligibility can be determined at the Rule 12(b)(6) stage.”

### **B. The District Court and the Federal Circuit Reached the Correct Outcome**

The district court and the Federal Circuit both applied longstanding precedent, and reached the correct result in holding that the claims of the ’283 and ’045 patents are ineligible for patenting under Section 101.

Glasswall complains that the district court and Federal Circuit erred by: (1) deeming allegations of fact in its Amended Complaint “conclusory legal assertions” that could be disregarded; (2) “analogizing the patent claims at issue to different claims determined as ineligible: claims in a different patent, owned by a different entity, directed to a different function;” and (3) concluding the claims were patent-ineligible without referring to any evidence. Pet. 2-3. But both rulings below followed established precedent from this Court and the Federal Circuit that distinguishes patent-eligible concepts from abstract ideas that are not patent-eligible.<sup>3</sup>

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<sup>3</sup> Glasswall’s Petition also alleges that the Federal Circuit ignored the presumption of validity to which the asserted patents



### **1. The District Court and the Federal Circuit Correctly Disregarded Conclusory Allegations Contained in Glasswall’s Amended Complaint**

First, Glasswall takes issue with the courts below labeling “pleaded facts” as conclusory legal assertions. But it is well-established that “[a] pleading that offers labels and conclusions or a formulaic recitation of the elements of a cause of action will not do.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678, 129 S. Ct. 1937 (2009). Instead, “[a] claim has facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference . . .” about the conduct alleged. *Id.*

Here, Glasswall’s amended complaint contains two paragraphs directed towards Section 101 – one paragraph for each asserted patent. C.A. App. 078-79 ¶ 15; C.A. App. 084-85 ¶ 32. These paragraphs do not plead facts, as Glasswall alleges. Instead, they are riddled with conclusory statements that the district court and the Federal Circuit were correct to disregard.<sup>4</sup>

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are entitled, and that invalidating a patent at the motion to dismiss stage creates “significant tension” with this presumption. Pet. 18-20. Glasswall’s subsequent analysis, however, fails to identify any such “tension,” and the Federal Circuit has previously recognized that there is none. *See Cleveland Clinic*, slip op. at 15 (finding that the district court recognized the “presumption of validity under 35 U.S.C. § 282” but that did not prevent claims from being held patent-ineligible in the early stages of a litigation).

<sup>4</sup> The district court also correctly disregarded the two declarations Glasswall submitted in support of its opposition to

For example, paragraph 15 starts by stating that the patent “features novel methods and devices that improve the technology used in electronic communications and electronic data exchange via computer.” C.A. App. 078-79 ¶ 15. It then asserts that the invention “improve[s] the function of computers” by providing “methods and devices that promote safe electronic communications and data transfer, eliminating code or data that may perform unwanted operations on the user’s computer. . . .” *Id.* Glasswall concludes by asserting that “[t]he technical solutions claimed in the ’283 patent are inventive solutions eligible for patent protection rather than a mere abstract idea.” *Id.* Paragraph 32 is identical apart from the patent number. C.A. App. 084-85 ¶ 32

Glasswall’s statements are conclusory assertions and insufficient to save patent claims that, on their face, seek to preempt others from using the “whitelist” concept of forwarding only content that has an approved format. Like the claim language, the statements in Glasswall’s Amended Complaint do not provide any details about *why* the claimed technology is inventive or does not preempt others from using the concept of a whitelist to filter content. *See, e.g., Secured Mail*, 873 F.3d at 911-12 (finding claims patent-ineligible because they did not explain *how* the

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Clearswift’s motion to dismiss. Relying on Ninth Circuit precedent, the court found that the declarations were not central to Glasswall’s claims and, therefore, would not be considered. Pet. App. 6a n.1; *see Marder v. Lopez*, 450 F.3d 445, 448 (9th Cir. 2006).

technology functions in a way that was inventive); *see also Iqbal*, 556 U.S. at 678 (holding that “threadbare recitals” are not enough). Glasswall’s “factual assertions” focus on the intended result or effect, not on the specific means or method. *Secured Mail*, 873 F.3d at 909. Glasswall’s Petition points to no language in the Amended Complaint that contains “factual content” as required by this Court. *See Iqbal*, 556 U.S. at 678. If a district court were required to accept these conclusory allegations as true, as Glasswall contends, any patentee could escape dismissal at the pleading stage by adding boilerplate allegations that the “solutions” in the patent “are inventive solutions eligible for patent protection rather than a mere abstract idea.” C.A. App. 078-79 ¶ 15.

This Court in *Twombly* and *Iqbal* rejected Glasswall’s approach. *See Iqbal*, 556 U.S. at 678 (“Nor does a complaint suffice if it tenders naked assertions devoid of further factual enhancement.”) (internal quotations omitted). Instead, this Court observed that determining whether a complaint contains factual allegations or mere conclusions is a “context-specific task that requires the reviewing court to draw on its judicial experience and common sense.” *Id.* at 679. Using these tools, a reviewing court “considering a motion to dismiss can choose to begin by identifying pleadings that, because they are no more than conclusions, are not entitled to the assumption of truth.” *Id.* Both the district court and the Federal Circuit properly discounted the conclusory legal assertions that Glasswall attempts to characterize as factual statements. *Compare id.* at

680-81 (discussing conclusory assertions contained in the complaint and similar conclusory assertions struck down in *Twombly*), *with* C.A. App. 078-79 ¶ 15, C.A. App. 084-85 ¶ 32 (conclusorily asserting that “[t]he technical solutions claimed in the [asserted patent] are inventive solutions eligible for patent protection rather than a mere abstract idea”).

Neither court ignored any “why” allegation in the Amended Complaint, as Glasswall now alleges. Pet. 17. Instead, the district court recognized that “claiming improved speed or efficiency inherent [in] applying an abstract idea on a computer does not provide a sufficient inventive concept.” Pet. App. 18a (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir. 2015)). As both courts below recognized, none of the asserted claims are directed to new technology, and all instead recite the concept of applying a whitelist approach to content filtering. Pet. App. 3a, 19a.

## **2. The District Court and the Federal Circuit Correctly Analogized the Claims Here to Those Previously Held Patent-Ineligible**

Glasswall also complains that the district court improperly compared Glasswall’s patent claims to claims previously held ineligible “in a different patent, owned by a different entity, and directed to a different function.” Pet. 2, 16. But both this Court and the Federal Circuit “have found it sufficient to compare claims

at issue to those claims already found to be directed to an abstract idea in previous cases.” *Enfish*, 822 F.3d at 1334-35; *see Alice*, 134 S. Ct. at 2357.

A court should not have to reinvent the wheel and “labor or delimit the precise contours of the abstract ideas category” in every case. *Enfish*, 822 F.3d at 1334-35. “It is enough to recognize that there is no meaningful distinction” between the concepts of the claims at issue and the concept of previously-held ineligible claims. *Id.*; *Alice*, 134 S. Ct. at 2357. Glasswall fails to point to any error by the lower courts in performing this comparative analysis. *See Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1340 (Fed. Cir. 2017) (hereinafter “*Capital One*”) (comparing the asserted claims to other claims previously held abstract); *Berkheimer*, 881 F.3d at 1366 (same); *Interval Licensing*, 896 F.3d at 1344-45 (same); *Erie*, 850 F.3d at 1331 (same); *Symantec*, 838 F.3d at 1313-14 (same).

The lower courts properly analogized the claims of the asserted patents to the claims in *Symantec* because both were directed toward filtering of electronic files and data by regenerating an electronic file without the non-conforming data. Pet. App. 2a. Like the claims in *Symantec*, the claims here “simply require generic computer-implemented steps” to achieve a desired result. And courts have consistently held that claims that require no more than the manipulation of data by a computer are abstract and patent-ineligible. *See* Pet. App. 4a (listing cases). As in those cases, the manipulation steps in the claims asserted here do not specify *how* the any of the steps must be performed. Instead,

the claims are framed in wholly functional terms and are implemented in a conventional way. Pet. App. 2a; *see also Symantec*, 838 F.3d at 1316 (claims contain no restriction on *how* the result is accomplished); *Erie*, 850 F.3d at 1329 (nothing in the claims recite *how* the invention overcomes compatibility issues); *Secured Mail*, 873 F.3d at 910 (claims did not explain *how* the sender generates information or what is inventive about technology claimed); *Interval Licensing*, 896 F.3d at 1341 (claims did not describe *how* the alleged invention solved the purported problem); *Capital One*, 850 F.3d at 1341-42 (claim language only provided result-oriented solution without detail about *how* it is accomplished). As the Federal Circuit's analysis in this case shows, if a patent is devoid of any explanation of how the claimed result is accomplished, the claims are abstract and recite no inventive concept. *Erie*, 850 F.3d at 1331-32.

### **3. The District Court and the Federal Circuit Considered Sufficient Evidence, Including the Patents' Common Specification**

Contrary to Glasswall's suggestion, the Federal Circuit did not declare the claims ineligible without reference to any evidence. The patents' common specification was before the court and confirms that the claims merely require generic computer-implemented steps that rely on well-known concepts.

For example, claim 1 of the '283 patent first receives an electronic file containing data “arranged in accordance with a predetermined file type.” C.A. App. 027, col. 16, ll. 37-40. The specification confirms that most files come in well-known, standardized file formats and that the invention operates by detecting conformity with these well-known standards. C.A. App. 020, col. 2, ll. 50-53; C.A. App. 021, col. 4, ll. 29-30. Next, the purported file type is determined. C.A. App. 027, col. 16, ll. 40-43. The specification confirms that this determination step can be performed because data files must conform precisely to rigid standards that are widely known. C.A. App. 020, col. 2, ll. 64-66; C.A. App. 022, col. 5, ll. 53-62. Allowed content is extracted from the file, C.A. App. 027, col. 16, ll. 48-50, but the specification states that content is allowable only if it conforms to a pre-determined, well-known format. See C.A. App. 022, col. 6, ll. 43-47; *cf.* C.A. App. 022, col. 6, ll. 30-34 (stating that I-frames in HTML are an example of content that does not pass through because there are no widely recognized rules). Next, a substitute file is created containing only the content that conforms to the well-known formats. C.A. App. 027, col. 16, ll. 50-52. If the content is within “real world,” “normal” constraints, it is then forwarded. C.A. App. 027, col. 16, ll. 53-56; C.A. App. 021, col. 3, ll. 9-14; C.A. App. 021, col. 4, ll. 29-30. Alternatively, an entire file can be forwarded if the sender is pre-approved (on a whitelist). C.A. App. 027, col. 16, ll. 57-61.

Unlike the claims in *Finjan* and *Enfish*, the claims here do not require a new type of file or improved

functionality of the computer itself. Pet. App. 4a. The subsequent file generated is not a new file type; it merely contains content conforming to well-known standards with unwanted code excised. Pet. App. 4a. Further, the specification confirms that the claimed steps can be performed on any generic computer using conventional steps. C.A. App. 021, col. 4, ll. 65-67 (“The transmission medium may be any suitable medium for transmitting electronic files. . . .”); C.A. App. 022, col. 5, ll. 15-21 (using a generic micro-processor with well-known components such as a memory device); C.A. App. 022, col. 5, ll. 45-46 (“the electronic file is input into the AV application using any suitable means”); C.A. App. 023, col. 8, ll. 11-13 (“the AV application is a piece of computer code, which is implemented using known computer programming techniques”); C.A. App. 026, col. 14, ll. 52-56 (“It will be understood that the present invention may be implemented in any system wherein electronic files are moved from a source to a destination. The method of sending the electronic files for the purposes of this invention is not limited to any particular method.”); C.A. App. 027, col. 16, ll. 4-5 (“Further, it will be understood that an operating system as described in this application can be any system that uses files.”).

In short, the computer is simply used as a tool for the purpose of comparing content to approved formats and then forwarding only the content matching such formats. This procedure does nothing to improve the functioning of the computer itself. And as the Federal Circuit recognized, Glasswall cannot save its patents



“by merely asserting that its methods are novel and improve the technology used in electronic communications.” Pet. App. 5a.

### **C. This Case is a Poor Vehicle to Resolve the Questions Presented by Glasswall**

To the extent that the Court desires to address whether conclusory statements of fact preclude a finding of ineligible subject matter at the pleading stage, this case is not a good vehicle for clarification. The patent claims are written broadly to encompass the basic concept of a whitelist approach to filtering content, and the nature of the claims preempts the application of that concept to content filtering as a whole.

The issues Glasswall raises are better addressed in a case where a more plausible technical solution or improvement to computer functionality is claimed. In this case, generic-purpose computers are simply being used as tools to filter content, and the claims should be found patent-ineligible as a matter of law regardless of the pleading standard. What is more, Glasswall’s allegations are plainly conclusory and do not come close to raising genuine and material factual issues.

**IV. CONCLUSION**

Glasswall's petition for certiorari should be denied.

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