

No. 19-521

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

CHARGEPOINT, INC.  
*Petitioner,*

*v.*

SEMACONNECT, INC.,  
*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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**MOTION FOR LEAVE TO FILE AND BRIEF OF  
JEREMY C. DOERRE AS *AMICUS CURIAE*  
SUPPORTING PETITIONER**

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**MOTION FOR LEAVE TO FILE BRIEF AS  
*AMICUS CURIAE* SUPPORTING PETITIONER**

Pursuant to Supreme Court Rule 37.2(b), Amicus Jeremy C. Doerre respectfully moves for leave to file the accompanying brief as *amicus curiae*.

Amicus timely notified counsel of record for both parties more than 10 days before the filing deadline of Amicus' intent to file this brief. Counsel for Petitioner provided written consent to the filing of this brief. Counsel for Respondent indicated that Respondent will not oppose filing of this brief. Amicus therefore moves to file this brief under Rule 37(2)(b).

Amicus notes that Respondent has secured a thirty-day extension from the Court to file a response to the Petition, so Respondent will have the ability to read this brief in full while preparing its response.

Amicus is a registered patent attorney who practices before the United States Patent and Trademark Office, the Office's Patent Trial and Appeal Board, and the United States Court of Appeals for the Federal Circuit. Amicus has no stake in any party or in the outcome of this case.

The Petitioner asks "[w]hether th[is] Court should reevaluate the atextual exception to Section 101." Pet. i. Amicus moves for leave to file the accompanying brief to suggest that this Court may wish to consider whether, in accord with this Court's "standard approach of construing a statutory exception narrowly to preserve the primary operation of the general rule,"

*Commissioner v. Clark*, 489 U.S. 726, 727 (1989), the implicit exception to 35 U.S.C. § 101 should be narrowly construed to not apply for prior art ideas because 35 U.S.C. § 103 already ensures that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354-55 (2014) (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

Therefore, Amicus Jeremy C. Doerre respectfully moves for leave to file the accompanying brief as *amicus curiae*.

Respectfully submitted,

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### INTEREST OF AMICUS CURIAE<sup>1</sup>

Amicus Curiae Jeremy C. Doerre is a registered patent attorney who practices before the United States Patent and Trademark Office, the Office's Patent Trial and Appeal Board, and the United States Court of Appeals for the Federal Circuit. Amicus has no stake in any party or in the outcome of this case. Amicus believes that this Court's guidance is needed regarding the implicit judicial exception to 35 U.S.C. § 101.

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<sup>1</sup> No counsel for a party authored this brief in whole or in part, and no party or counsel for a party made a monetary contribution intended to fund the preparation or submission of this brief. No person or entity other than amicus curiae or amicus curiae's counsel made such a monetary contribution to the preparation or submission of this brief. Petitioner provided written consent to the filing of this brief. Counsel for Respondent indicated that Respondent will not oppose filing of this brief. Amicus therefore moves to file this brief under Rule 37(2)(b). A copy of written consent from the Petitioner and indication of lack of opposition by the Respondent was provided to the Clerk upon filing. Counsel of record for each of the parties received timely notice of amicus curiae's intent to file this brief.

## SUMMARY OF THE ARGUMENT

This Court has “long held that [35 U.S.C. § 101] contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.”<sup>2</sup> This Court has “described the concern that drives this exclusionary principle as one of pre-emption.”<sup>3</sup>

In accord with this, this Court has indicated that in contrast to claims that “would risk disproportionately tying up the use of the underlying’ ideas, ... and are therefore ineligible for patent protection,” claims that “pose no comparable risk of pre-emption... remain eligible for the monopoly granted under our patent laws.”<sup>4</sup>

In the context of a newly discovered law of nature or natural phenomenon, or a newly articulated abstract idea, it makes sense that pre-emption concerns might necessitate resort to an implicit exception to 35 U.S.C. § 101 in order to ensure that claims do not “disproportionately t[ie] up the use of []

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<sup>2</sup> *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014).

<sup>3</sup> *Id.*

<sup>4</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 73 (2012)).

underlying’ ideas.”<sup>5</sup> Amicus would suggest, however, that there is no similar need to resort to use of an implicit judicial exception to prevent undue pre-emption of prior art ideas, as the *Hotchkiss* condition for patentable invention codified in 35 U.S.C § 103 already ensures that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>6</sup>

In this regard, this Court in *Flook* suggested that determining whether a claim directed to an abstract idea contains an “inventive concept in its application”<sup>7</sup> involves considering whether, “once that [abstract idea] is assumed to be within the prior art, the [claim], considered as a whole, contains no patentable invention.”<sup>8</sup>

Although this Court offered various formulations of the inventive concept inquiry in *Alice* and *Mayo*, these formulations are consistent with this indication in *Flook*, as a combination of claim elements that satisfies the *Hotchkiss* condition for patentable invention even when the abstract idea “is assumed to

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<sup>5</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>6</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>7</sup> *Parker v. Flook*, 437 U.S. 584, 594 (1978).

<sup>8</sup> *Id.*

be within the prior art,”<sup>9</sup> i.e. a combination of elements that is nonobvious over that abstract idea, clearly qualifies as an inventive concept under all of these formulations in that it “transform[s] the [claim] into an inventive application of the [abstract idea]”<sup>10</sup> and is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [[abstract idea]] itself.”<sup>11</sup>

Thus, with respect to abstract ideas that were already in the prior art, any pre-emption concern that a claim might “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas”<sup>12</sup> is already addressed by the requirement that the claim satisfy the *Hotchkiss* condition for patentable invention over all known prior art ideas, i.e. 35 U.S.C. § 103’s requirement that the claim be nonobvious over all prior art ideas, with no need to resort to an implicit judicial exception to 35 U.S.C. § 101 to guard against such pre-emption.

Accordingly, Amicus urges that this Court may wish to consider whether, in accord with this Court’s “standard approach of construing a statutory exception narrowly to preserve the primary operation

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<sup>9</sup> *Id.*

<sup>10</sup> *Alice*, 134 S. Ct. at 2358 (quoting *Mayo*, 566 U.S. at 81).

<sup>11</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>12</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

of the general rule,”<sup>13</sup> the implicit exception to 35 U.S.C. § 101 should be narrowly construed to not apply for prior art ideas because 35 U.S.C. § 103 already ensures that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>14</sup>

## ARGUMENT

The Petitioner asks “[w]hether th[is] Court should reevaluate the atextual exception to [35 U.S.C. §] 101.”<sup>15</sup> Amicus submits this brief to suggest that this Court may wish to consider whether, in accord with this Court’s “standard approach of construing a statutory exception narrowly to preserve the primary operation of the general rule,”<sup>16</sup> the atextual exception to 35 U.S.C. § 101 should be narrowly construed to not apply for prior art ideas because the *Hotchkiss* condition for patentable invention codified in 35 U.S.C. § 103 already ensures that claims do not

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<sup>13</sup> *Commissioner v. Clark*, 489 U.S. 726, 727 (1989).

<sup>14</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>15</sup> Pet. i.

<sup>16</sup> *Clark*, 489 U.S. at 727.

“disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>17</sup>

**I. This Court long ago addressed the issue of how to determine whether a novel application of prior art ideas is worthy of a patent, positing the *Hotchkiss* condition for patentable invention that was codified in 35 U.S.C. § 103.**

Over one hundred and fifty years ago in *Hotchkiss v. Greenwood*,<sup>18</sup> this Court addressed the problem of whether every novel combination of prior art elements should be entitled to a patent by “positing the condition that a patentable invention evidence more ingenuity and skill than that possessed by an ordinary mechanic acquainted with the business.”<sup>19</sup>

This Court has indicated that this *Hotchkiss* condition for patentable invention, and the “judicial test[ of] ‘invention’ -- i.e., ‘an exercise of the inventive

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<sup>17</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>18</sup> *Hotchkiss v. Greenwood*, 52 U.S. 248 (1851).

<sup>19</sup> *Graham v. John Deere Co.*, 383 U.S. 1, 11 (1966).

faculty,”<sup>20</sup> were codified by Congress in 35 U.S.C. § 103 “as a requirement of ‘nonobviousness.’”<sup>21</sup>

In particular, in *Graham*, this Court found that “the [1952 Patent Act] was not intended by Congress to change the general level of patentable invention,” and “conclude[d] that [35 U.S.C. § 103] was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition” for patentable invention.<sup>22</sup> Similarly, in *Dann v. Johnston*,<sup>23</sup> this Court indicated with respect to “a judicial test[ of] ‘invention’ -- i.e., ‘an exercise of the inventive faculty,’”<sup>24</sup> that “Congress... articulated th[is] requirement in a statute, framing it as a requirement of ‘nonobviousness.’”<sup>25</sup>

In the present case, the Federal Circuit suggested that “the invention of the patent ... [involves] the [] idea of communication over a network for interacting with a device, applied to ... electric vehicle charging stations.”<sup>26</sup>

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<sup>20</sup> *Dann v. Johnston*, 425 U.S. 219, 225-226 (1976) (quoting *McClain v. Ortmyer*, 141 U.S. 419, 427 (1891)).

<sup>21</sup> *Dann*, 425 U.S. at 225-226.

<sup>22</sup> *Graham*, 383 U.S. at 17.

<sup>23</sup> *Dann v. Johnston*, 425 U.S. 219 (1976).

<sup>24</sup> *Dann*, 425 U.S. at 225-226 (quoting *McClain*, 141 U.S. at 427).

<sup>25</sup> *Dann*, 425 U.S. at 225-226.

<sup>26</sup> Pet. App. 13a.



Thus, this would seem to present the straightforward question of whether application of the prior art idea of “communication over a network for interacting with a device”<sup>27</sup> to prior art “electric vehicle charging stations”<sup>28</sup> represents an inventive application that satisfies the *Hotchkiss* condition for patentable invention, i.e. whether “differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious ... to a person having ordinary skill in the art to which the claimed invention pertains.”<sup>29</sup>

Instead, this case involves resort to an atextual exception to 35 U.S.C. § 101 to find claims patent ineligible as being “directed to’ the [prior art] abstract idea of communication over a network to interact with network-attached devices.”<sup>30</sup>

**II. There is no need to resort to use of an implicit judicial exception to 35 U.S.C. § 101 to prevent pre-emption of prior art ideas because the *Hotchkiss* condition for**

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<sup>27</sup> Pet. App. 13a.

<sup>28</sup> Pet. App. 13a.

<sup>29</sup> 35 U.S.C. § 103.

<sup>30</sup> Pet. App. 16a; see also Pet. App. 19a (“claims 1 and 8 are also directed to the abstract idea of communicating over a network”); Pet. App. 20a (“claims 1 and 2 of the ’967 patent are directed to the abstract idea of communicating over a network.”)

**patentable invention codified in 35 U.S.C. § 103 already ensures that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>31</sup>**

This Court has “long held that [35 U.S.C. § 101] contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.”<sup>32</sup> This Court has “described the concern that drives this exclusionary principle as one of pre-emption.”<sup>33</sup>

In accord with this, this Court has indicated that in contrast to claims that “would risk disproportionately tying up the use of the underlying’ ideas, ... and are therefore ineligible for patent protection,” claims that “pose no comparable risk of pre-emption... remain eligible for the monopoly granted under our patent laws.”<sup>34</sup>

In the context of a newly discovered law of nature or natural phenomenon, or a newly articulated abstract idea, it makes sense that pre-emption concerns might necessitate resort to an implicit

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<sup>31</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>32</sup> *Alice*, 134 S. Ct. at 2354.

<sup>33</sup> *Id.*

<sup>34</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

judicial exception to 35 U.S.C. § 101 in order to ensure that claims do not “disproportionately t[ie] up the use of [] underlying’ ideas.”<sup>35</sup> Amicus would suggest, however, that there is no similar need to resort to use of an implicit judicial exception to prevent undue pre-emption of prior art abstract ideas, as the *Hotchkiss* condition for patentable invention codified in 35 U.S.C § 103 already ensures that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>36</sup>

**A. This Court’s precedent suggests that determining whether a claim directed to an abstract idea contains an “inventive concept in its application”<sup>37</sup> involves considering whether, “once that [abstract idea] is assumed to be within the prior art, the [claim], considered as a whole, contains no patentable invention.”<sup>38</sup>**

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<sup>35</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>36</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>37</sup> *Parker v. Flook*, 437 U.S. 584, 594 (1978).

<sup>38</sup> *Id.*

In *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*,<sup>39</sup> this Court “set forth a framework for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.”<sup>40</sup> This framework involves “[f]irst, [] determin[ing] whether the claims at issue are directed to one of those patent-ineligible concepts.”<sup>41</sup> If so, the analysis proceeds to “a search for an ‘inventive concept’ — i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’”<sup>42</sup>

Although *Mayo* was the first occasion on which this Court explicitly articulated the current two-part eligibility framework, “step two of this analysis [involving] a search for an ‘inventive concept’ ”<sup>43</sup> appears to have been derived from this Court’s prior precedent. In this regard, this Court’s definition of

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<sup>39</sup> *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012).

<sup>40</sup> *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. 66).

<sup>41</sup> *Alice*, 134 S. Ct. at 2355 (citing *Mayo*, 566 U.S. at 77).

<sup>42</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 72-73) (alteration in original).

<sup>43</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 72-73).

the “search for an ‘inventive concept’”<sup>44</sup> as “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’”<sup>45</sup> is directly in line with this Court’s indication in *Mayo* that “th[is] Court’s precedent[] ... insist[s] that a process that focuses upon the use of a natural law also contain other elements or a combination of elements, sometimes referred to as an ‘inventive concept,’ sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the natural law itself.”<sup>46</sup>

This Court cited *Parker v. Flook*<sup>47</sup> as supporting this proposition. In *Flook*, this Court indicated that “the discovery of [] a phenomenon cannot support a patent unless there is some other inventive concept in its application,”<sup>48</sup> which is directly in line with this Court’s more recent indication that “[a]t *Mayo* step two, we must examine the elements of the claim to determine whether it contains an ‘inventive concept’

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<sup>44</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 72-73).

<sup>45</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 72-73) (alteration in original).

<sup>46</sup> *Mayo*, 566 U.S. at 72-73.

<sup>47</sup> *Parker v. Flook*, 437 U.S. 584 (1978).

<sup>48</sup> *Flook*, 437 U.S. at 594.

‘ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.’<sup>49</sup>

This Court in *Flook* explicitly outlined its reasoning for finding that there was no inventive concept sufficient to confer eligibility, making clear that the claimed “process [wa]s unpatentable under § 101, not because it contains a mathematical algorithm as one component, but because once that algorithm is assumed to be within the prior art, the application, considered as a whole, contains no patentable invention.”<sup>50</sup>

Thus, this Court in *Flook* suggested that determining whether a claim directed to an abstract idea contains an “inventive concept in its application”<sup>51</sup> involves considering whether, “once that [abstract idea] is assumed to be within the prior art, the [claim], considered as a whole, contains no patentable invention.”<sup>52</sup>

**B. A combination of claim elements that satisfies the *Hotchkiss* condition for patentable invention “once [an abstract idea] is assumed to be within**

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<sup>49</sup> *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 566 U.S. at 72).

<sup>50</sup> *Id.*

<sup>51</sup> *Id.*

<sup>52</sup> *Id.*

**the prior art”<sup>53</sup> would seem to qualify as an “ ‘inventive concept’ ‘ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application”<sup>54</sup>**

Although this Court offered various formulations of the inventive concept inquiry in *Alice* and *Mayo*, Amicus would urge that these formulations are consistent with this Court’s indication in *Flook* that determining whether a claim directed to an abstract idea contains an “inventive concept in its application”<sup>55</sup> involves determining whether, “once that [abstract idea] is assumed to be within the prior art, the [claim], considered as a whole, contains no patentable invention.”<sup>56</sup>

In this regard, Amicus would urge that a combination of claim elements that satisfies the *Hotchkiss* condition for patentable invention even when the abstract idea “is assumed to be within the prior art,”<sup>57</sup> i.e. a combination of elements that is nonobvious over that abstract idea, clearly qualifies as an inventive concept under all of these formulations in that it “transform[s] the [claim] into an inventive

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<sup>53</sup> *Flook*, 437 U.S. at 594.

<sup>54</sup> *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 566 U.S. at 72).

<sup>55</sup> *Flook*, 437 U.S. at 594.

<sup>56</sup> *Id.*

<sup>57</sup> *Id.*

application of the [abstract idea],”<sup>58</sup> is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [[abstract idea]] itself,”<sup>59</sup> and “adds [some]thing to the [abstract idea] that is not already present when the [elements] are considered separately.”<sup>60</sup>

Amicus would suggest that this conclusion is supported by this Court’s characterization of this particular portion of the analysis as a “search for an ‘inventive concept’ ,”<sup>61</sup> as this Court has previously suggested with respect to “a judicial test[ of] ‘invention’ -- i.e., ‘an exercise of the inventive faculty,’”<sup>62</sup> that “Congress... articulated th[is] requirement in a statute, framing it as a requirement of ‘nonobviousness.’”<sup>63</sup> Amicus would suggest that this characterization equating nonobviousness with “invention” supports the proposition that a combination of elements that satisfies the *Hotchkiss* condition for patentable invention even when the

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<sup>58</sup> *Alice*, 134 S. Ct. at 2358 (quoting *Mayo*, 566 U.S. at 81).

<sup>59</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>60</sup> *Mayo*, 566 U.S. at 79.

<sup>61</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 72-73).

<sup>62</sup> *Dann v. Johnston*, 425 U.S. 219, 225-226 (1976) (quoting *McClain v. Ortmyer*, 141 U.S. 419, 427 (1891)).

<sup>63</sup> *Dann*, 425 U.S. at 225-226.



abstract idea “is assumed to be within the prior art,”<sup>64</sup> i.e. a combination of elements that is nonobvious over that abstract idea, also qualifies as an “ ‘inventive concept’ ‘sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application”<sup>65</sup> and “sufficient to ensure that the [claim] in practice amounts to significantly more than a patent upon the [abstract idea] itself.”<sup>66 67</sup>

**C. With respect to abstract ideas that were already in the prior art, any pre-emption concern that a claim might “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas” is**

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<sup>64</sup> *Flook*, 437 U.S. at 594.

<sup>65</sup> *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 566 U.S. at 72).

<sup>66</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 72-73).

<sup>67</sup> Amicus would further suggest that this proposition may also be supported by the reasoning that an inventive step is sufficient to ensure the existence of an inventive concept, which reasoning may be relevant because “the term[] ‘inventive step’ ... may be deemed ... to be synonymous with the term[] ‘non-obvious’.” Agreement Establishing the World Trade Organization, Annex 1C - Agreement on Trade-Related Aspects of Intellectual Property Rights, Section 5, note 5, available at [https://www.wto.org/english/docs\\_E/legal\\_E/31bis\\_trips\\_e.pdf](https://www.wto.org/english/docs_E/legal_E/31bis_trips_e.pdf).

**already addressed by the requirement that the claim satisfy the *Hotchkiss* condition for patentable invention over all known prior art ideas.**

As noted above, this Court has indicated that in contrast to claims that “would risk disproportionately tying up the use of the underlying’ ideas, ... and are therefore ineligible for patent protection,” claims that “pose no comparable risk of pre-emption... remain eligible for the monopoly granted under our patent laws.”<sup>68</sup>

As also noted above, in the context of a newly discovered law of nature or natural phenomenon, or a newly articulated abstract idea, it makes sense that pre-emption concerns might necessitate resort to an implicit judicial exception to 35 U.S.C. § 101 in order to ensure that claims do not “disproportionately t[ie] up the use of [] underlying’ ideas.”<sup>69</sup> However, there is no similar need to resort to use of an implicit judicial exception to prevent undue pre-emption of known prior art abstract ideas, as the *Hotchkiss* condition for patentable invention codified in 35 U.S.C § 103 already ensures that claims do not

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<sup>68</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>69</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

“disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>70</sup>

In particular, as detailed above, Amicus would urge that any element or combination of elements that is sufficient to satisfy the *Hotchkiss* condition for patentable invention even when the abstract idea “is assumed to be within the prior art,”<sup>71</sup> i.e. render the claim nonobvious under 35 U.S.C. § 103 over that abstract idea, is also “sufficient to ensure that the [claim] in practice amounts to significantly more than a patent upon the [abstract idea] itself.”<sup>72</sup>

Amicus respectfully suggests that if this is so, then with respect to abstract ideas that were already in the prior art, any pre-emption concern that a claim might “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas” is already addressed by the requirement that the claim satisfy the *Hotchkiss* condition for patentable invention over all known prior art ideas, i.e. 35 U.S.C. § 103’s requirement that the claim be nonobvious over all prior art ideas, with no need to resort to an implicit judicial exception to 35 U.S.C. § 101 to guard against such pre-emption.<sup>73</sup>

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<sup>70</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>71</sup> *Id.*

<sup>72</sup> *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 566 U.S. at 72-73).

<sup>73</sup> Amicus would note that if an element or combination of elements that might otherwise qualify as an inventive

That is, Amicus urges that there is no need to resort to use of an implicit judicial exception to 35 U.S.C. § 101 in order to prevent pre-emption of prior art ideas because the *Hotchkiss* condition for patentable invention codified in 35 U.S.C. § 103 already ensures that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>74</sup>

**III. This Court may wish to consider whether the implicit exception to 35 U.S.C. § 101 should be narrowly construed to not apply for prior art ideas because 35 U.S.C. § 103 already ensures that claims do not**

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concept is itself alleged to represent or be part of an ineligible abstract idea, e.g. a novel mathematical formula, then the claim could simply be alleged to be ineligible as directed to that abstract idea. Amicus would suggest that identification and emphasis of such a novel abstract idea at risk of being pre-empted, as contrasted with a blanket allegation of a claim as directed to a prior art idea coupled with dismissal of elements or a combination of elements as also abstract, has the advantage of requiring more explicit logical analysis, thus minimizing the likelihood of an error in application.

<sup>74</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

**“disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>75</sup>**

**A. The implicit judicial exception to 35 U.S.C. § 101, like other statutory exceptions, could reasonably be construed “narrowly in order to preserve the primary operation of the provision.”<sup>76</sup>**

This Court has suggested that statutory exceptions generally should be narrowly construed. For example, in *Commissioner v. Clark*<sup>77</sup> this Court referenced its “standard approach of construing a statutory exception narrowly to preserve the primary operation of the general rule,”<sup>78</sup> and noted that “[i]n construing provisions ... in which a general statement of policy is qualified by an exception, we usually read the exception narrowly in order to preserve the primary operation of the provision.”<sup>79</sup>

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<sup>75</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>76</sup> *Commissioner v. Clark*, 489 U.S. 726, 739 (1989) (citing *Phillips, Inc. v. Walling*, 324 U.S. 490, 493 (1945)).

<sup>77</sup> *Commissioner v. Clark*, 489 U.S. 726 (1989).

<sup>78</sup> *Clark*, 489 U.S. at 727.

<sup>79</sup> *Clark*, 489 U.S. at 739 (citing *Phillips, Inc. v. Walling*, 324 U.S. 490, 493 (1945)).

This Court has proffered at least one rationale for why statutory exceptions should be narrowly construed, articulating in *Phillips, Inc. v. Walling*<sup>80</sup> that: “[t]o extend an exemption to other than those plainly and unmistakably within its terms and spirit is to abuse the interpretative process and to frustrate the announced will of the people.”<sup>81</sup>

Amicus would query whether, if this is true for explicit statutory exceptions enacted as part of a statute by legislative representatives of the people, it is also true for implicit statutory exceptions inferred by the judicial branch.<sup>82</sup> The exception to 35 U.S.C. §

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<sup>80</sup> *Phillips, Inc. v. Walling*, 324 U.S. 490 (1945)

<sup>81</sup> *Phillips*, 324 U.S. at 493.

<sup>82</sup> This Court has recently suggested that in at least some contexts, courts may not “may not engraft ... exceptions onto the statutory text,” *Henry Schein, Inc. v. Archer and White Sales, Inc.*, 139 S. Ct. 524, 530 (2019), and “may not rewrite [a] statute simply to accommodate [a] policy concern.” *Id.* at 531. To the extent that the longstanding implicit judicial exception to 35 U.S.C. § 101 can be implied to be accepted or adopted by Congress, e.g. because “Congress is presumed to be aware of a[] ... judicial interpretation of a statute and to adopt that interpretation when it reenacts a statute without change,” *Lorillard v. Pons*, 434 U.S. 575, 580 (1978), Amicus suggests that this would not impact an argument that the implicit statutory exception, like other statutory exceptions, should be narrowly construed.

101 for abstract ideas is such an implicit statutory exception, as this Court made clear in noting that it has “long held that th[e] provision of [35 U.S.C. § 101] contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.”<sup>83</sup>

In accordance with this Court’s guidance regarding construction of statutory exceptions, the implicit statutory exception to 35 U.S.C. § 101 could reasonably be construed “narrowly in order to preserve the primary operation of the provision [of 35 U.S.C. § 101],”<sup>84</sup> as to do otherwise would risk “frustrat[ing] the announced will of the people.”<sup>85</sup>

Amicus would respectfully suggest that such a narrow construction may be especially appropriate with respect to the implicit exception to 35 U.S.C. § 101 for abstract ideas, as this Court has declined to “labor to delimit the precise contours of the ‘abstract ideas’ category,”<sup>86</sup> but has cautioned that one must

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<sup>83</sup> *Alice*, 134 S. Ct. at 2354.

<sup>84</sup> *Clark*, 489 U.S. at 739 (citing *Phillips*, 324 U.S. at 493).

<sup>85</sup> *Phillips*, 324 U.S. at 493.

<sup>86</sup> *Alice*, 134 S. Ct. at 2357. While this Court’s choice was eminently reasonable, it has left decision makers uncertain as to when to apply the implicit exception to 35 U.S.C. § 101 for abstract ideas.

“tread carefully in construing this exclusionary principle lest it swallow all of patent law.”<sup>87</sup>

**B. The implicit judicial exception to 35 U.S.C. § 101 for abstract ideas could reasonably be narrowly construed to not apply for prior art ideas because 35 U.S.C. § 103 already ensure that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>88</sup>**

As detailed above, although this Court has articulated an implicit statutory exception to 35 U.S.C. § 101 for abstract ideas driven by pre-emption concerns which exists to ensure that claims do not “disproportionately t[ie] up the use of the underlying’ ideas,”<sup>89</sup> Amicus urges that there is no need to resort to use of this implicit judicial exception to 35 U.S.C. § 101 in order to prevent pre-emption of prior art ideas because the *Hotchkiss* condition for patentable invention codified in 35 U.S.C. § 103 already ensures

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<sup>87</sup> *Alice*, 134 S. Ct. at 2354.

<sup>88</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>89</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).



that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>90</sup>

As also noted above, the implicit judicial exception to 35 U.S.C. § 101, like other statutory exceptions, could reasonably be construed “narrowly in order to preserve the primary operation of the provision.”<sup>91</sup>

Accordingly, Amicus respectfully suggests that the implicit statutory exception to 35 U.S.C. § 101 for abstract ideas could reasonably be narrowly construed to not apply for prior art ideas because 35 U.S.C. § 103 already ensures that claims do not “disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>92</sup>

**C. Narrowly construing the implicit judicial exception to 35 U.S.C. § 101 to not apply for prior art ideas would still allow the exception to operate to prevent claims from pre-empting newly discovered or novel ideas.**

Importantly, narrowly construing the implicit judicial exception to 35 U.S.C. § 101 to not apply for prior art ideas would not disrupt this Court’s

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<sup>90</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>91</sup> *Clark*, 489 U.S. at 739 (citing *Phillips*, 324 U.S. at 493).

<sup>92</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

precedent applying the implicit exception to 35 U.S.C. § 101 to guard against pre-emption of newly discovered or novel laws of nature, natural phenomena, and abstract ideas.

As an example, consider *Flook*, where this Court addressed a question regarding eligibility of a novel formula, considering whether, if a “formula is the only novel feature of [a] method[,] ... the discovery of this feature makes an otherwise conventional method eligible for patent protection.”<sup>93</sup> Narrowly construing the implicit exception to 35 U.S.C. § 101 to not apply for prior art ideas would not prevent application, as in *Flook*, of this implicit exception for a novel formula.

Similarly, in *Mayo*, this Court addressed claims involving newly discovered natural correlations, where “those in the field did not know the precise correlations between metabolite levels and likely harm or ineffectiveness,”<sup>94</sup> and “[t]he patent claims ... set forth processes embodying researchers' findings that identified these correlations with some

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<sup>93</sup> *Flook*, 437 U.S. at 588 (“For the purpose of our analysis, we assume that respondent's formula is novel and useful, and that he discovered it. We also assume, since respondent does not challenge the examiner's finding, that the formula is the only novel feature of respondent's method. The question is whether the discovery of this feature makes an otherwise conventional method eligible for patent protection.”)

<sup>94</sup> *Mayo*, 566 U.S. at 74.

precision.”<sup>95</sup> Narrowly construing the implicit exception to 35 U.S.C. § 101 to not apply for prior art ideas would not prevent application, as in *Mayo*, of this implicit exception for newly discovered natural laws.

Overall, narrowly construing the implicit judicial exception to 35 U.S.C. § 101 to not apply for prior art ideas would still allow the exception to operate to prevent claims from pre-empting newly discovered or novel laws of nature, natural phenomena, and abstract ideas.

**D. This Court has not previously addressed whether the implicit judicial exception to 35 U.S.C. § 101 should be narrowly construed to not apply for prior art ideas.**

Notably, this Court has at times applied the implicit judicial exception to 35 U.S.C. § 101 to find claims ineligible as directed to abstract ideas which clearly represent prior art ideas.

For example, in *Bilski v. Kappos*<sup>96</sup> this Court found claims ineligible as directed to “[t]he concept of hedging,”<sup>97</sup> which was found to be “a fundamental

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<sup>95</sup> *Id.*

<sup>96</sup> *Bilski v. Kappos*, 561 U.S. 593, 611 (2010).

<sup>97</sup> *Id.*

economic practice long prevalent in our system of commerce and taught in any introductory finance class,”<sup>98</sup> and in *Alice* this Court similarly found claims ineligible as directed to “the concept of intermediated settlement,”<sup>99</sup> which was likewise found to be “a fundamental economic practice long prevalent in our system of commerce.”<sup>100</sup> Thus, in each of these cases this Court applied the implicit judicial exception to 35 U.S.C. § 101 for a concept that was “long prevalent,” and thus clearly a prior art idea.

However, “appellate courts do not sit as self-directed boards of legal inquiry and research, but essentially as arbiters of legal questions presented and argued by the parties before them,”<sup>101</sup> and in neither of these cases, nor in any other case, so far as *Amicus* is aware, was this Court asked to consider whether the implicit statutory exception to 35 U.S.C. § 101 for abstract ideas should be narrowly construed to not apply for prior art ideas because 35 U.S.C. § 103 already ensures that claims do not

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<sup>98</sup> *Id.*

<sup>99</sup> *Alice*, 134 S. Ct. at 2356.

<sup>100</sup> *Alice*, 134 S. Ct. at 2356 (quoting *Bilski*, 561 U.S. at 611).

<sup>101</sup> *Carducci v. Regan*, 714 F.2d 171, 177 (D.C. Cir. 1983) (Scalia, J.).

“disproportionately t[ie] up the use of [] underlying’ [prior art] ideas.”<sup>102</sup>

**E. Narrowly construing the implicit judicial exception to 35 U.S.C. § 101 to not apply for prior art ideas would merely shift the role of screening out non-inventive applications of prior art ideas back to the statutory section where Congress intended it to lie: 35 U.S.C. § 103.**

Perhaps the closest this Court has come in its recent cases to addressing this issue was in *Mayo*, where this Court addressed a brief by the United States filing as *Amicus Curiae* which urged an exceedingly narrow construction of the implicit exception to 35 U.S.C. § 101<sup>103</sup> and argued that “other statutory provisions—those that insist that a claimed process be novel, 35 U.S.C. § 102, that it not be ‘obvious in light of prior art,’ § 103, and that it be

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<sup>102</sup> *Alice*, 134 S. Ct. at 2354-2355 (quoting *Mayo*, 566 U.S. at 73).

<sup>103</sup> See, e.g., *Mayo*, 566 U.S. at 89 (“the Government argues that virtually any step beyond a statement of a law of nature itself should transform an unpatentable law of nature into a potentially patentable application sufficient to satisfy § 101's demands.” (citing Brief for United States as *Amicus Curiae*)).

‘full[y], clear[ly], concise[ly], and exact[ly]’ described, § 112—can perform this screening function.”<sup>104</sup>

In addressing this argument, this Court “recognize[d] that, in evaluating the significance of additional steps, the § 101 patent-eligibility inquiry and, say, the § 102 novelty inquiry might sometimes overlap,” but noted that such overlap with another statutory section “need not always be so.”<sup>105</sup> Importantly, because *Mayo* dealt with newly discovered laws of nature, it did not offer this Court a chance to consider a situation where such overlap with another statutory section will always be present: when considering prior art laws of nature, natural phenomena, and abstract ideas.

Indeed, although this Court explicitly referenced the category of “newly discovered (and ‘novel’) laws of nature,”<sup>106</sup> and seemed to recognize that such newly discovered laws of nature, natural phenomena, and abstract ideas might sometimes have different implications than prior art laws of nature, natural phenomena, and abstract ideas,<sup>107</sup> the government’s

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<sup>104</sup> *Mayo*, 566 U.S. at 89.

<sup>105</sup> *Mayo*, 566 U.S. at 90.

<sup>106</sup> *Id.*

<sup>107</sup> See *Mayo*, 566 U.S. at 90 (“What role would laws of nature, including newly discovered (and ‘novel’) laws of nature, play in the Government’s suggested ‘novelty’ inquiry?”)

proposed approach did not differentiate between the two, and instead “suggest[ed] in effect that the novelty of a component law of nature may be disregarded when evaluating the novelty of the whole.”<sup>108</sup>

This Court reasonably declined to adopt the government’s proposed approach which attempted to shift the role of screening out newly discovered or novel ideas from the implicit judicial exception to 35 U.S.C. § 101 to other statutory sections, thus rendering the “exception to § 101 patentability a dead letter.”<sup>109</sup>

In contrast, narrowly construing the implicit judicial exception to 35 U.S.C. § 101 to not apply for prior art ideas would merely shift the role of screening out non-inventive applications of prior art ideas back to the statutory section where Congress intended it to lie: 35 U.S.C. § 103.<sup>110</sup> Unlike the approach proposed by the government in *Mayo*, narrowly construing the implicit judicial exception to not apply for prior art ideas would not render the exception a dead letter, as the exception would still operate to prevent claims

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<sup>108</sup> *Mayo*, 566 U.S. at 90.

<sup>109</sup> *Mayo*, 566 U.S. at 89.

<sup>110</sup> For example, 35 U.S.C. § 103 can often be applied in accord with *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) to reject and invalidate obvious claims which merely recite obvious computer implementations of prior art ideas using routine and conventional computer components and functionality.

from pre-empting newly discovered or novel laws of nature, natural phenomena, and abstract ideas, as detailed above.

### CONCLUSION

Amicus urges this Court to grant certiorari to “reevaluate the atextual exception to [35 U.S.C. §] 101.”<sup>111</sup>

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<sup>111</sup> Pet. i.