No. 19-521

IN THE

Supreme Court of the United States

CHARGEPOINT, INC.,

Petitioner,

v.

SEMACONNECT, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF IN OPPOSITION

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December 23, 2019

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20002

QUESTION PRESENTED

1. Whether a patent claim directed to an abstract idea can be rendered patent eligible by adding an instruction to "apply it" to a generic machine or process?

2. Whether the Court should overrule 150 years of precedent that holds laws of nature, natural phenomena, and abstract ideas ineligible for patents?

RULE 29.6 STATEMENT

SemaConnect, Inc. has no parent corporation. No parent company or publically held corporation owns 10% or more of SemaConnect, Inc.'s stock.

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INTRODUCTION

Respondent SemaConnect, Inc. ("SemaConnect") respectfully submits this brief in opposition to the petition for a writ of certiorari filed by ChargePoint, Inc. ("ChargePoint"). The Federal Circuit's unanimous decision affirming the district court and subsequent decision to deny ChargePoint's petition for rehearing en banc reflect routine and correct applications of the this Court's longstanding jurisprudence on patent eligibility under 35 U.S.C. § 101.

In determining patent eligibility, analysis properly focuses on what a patent actually claims: does the patent claim "building blocks of human ingenuity," or does it "integrate the building blocks into something more"? *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014) (quotation marks and alterations omitted). "The former 'would risk disproportionately tying up the use of the underlying' ideas," while "[t]he latter pose[s] no comparable risk of pre-emption." *Id.* (citations omitted). This Court recently so held in *Alice*, the Federal Circuit applied that teaching in straightforward fashion, and the instant petition supplies no warrant for this Court to revisit the well-worn ground it has already tread. Tellingly, whereas ChargePoint's patent claims should be the focus of the analysis, ChargePoint runs from its patent claims. Its petition does not present so much as a single, complete patent claim for this Court's review, and its appendix omits the patents at issue here.

Once analysis focuses on the patent claims, as this Court has held it must, the decision below reflects a straightforward application of the framework the Court set forth in *Alice*. Each claim is an abstract idea (remote control over a network) coupled with an instruction to "apply it" to a technological environment

(electrical vehicle charging stations). Every claim limitation is either a well-understood, routine, conventional component for connecting a machine (*any* machine) to a network or a well-understood, routine, conventional component of a charging station. The claims thus lack an inventive concept that could transform the abstract idea of remotely controlling an electric vehicle charging station over a network into something patentable. The claims do not, for example, specify "how" network control is accomplished beyond referring to generic computer components. Accordingly, ChargePoint's claims threaten to preempt the abstract idea of network control in the field of electric vehicle charging stations.

Instead of addressing the *Alice* framework or seeking clarification on either step set forth in that decision, ChargePoint seeks to overturn that framework altogether. First, ChargePoint argues that its patents are valid because they claim "actual improvements to machines." Pet. at 2; *see also* ChargePoint's Question No. 1. But no statutory category enumerated in Section 101—including "machine"—is immune from invalidity under *Alice* because the patents are improvements. Otherwise, "patent eligibility [would] 'depend simply on the draftsman's art.'" *Alice*, 573 U.S. at 226. Ignoring *Alice*, ChargePoint instead cites language from *Diehr*, taken out of context, to argue that "incorporation of an abstract idea into . . . a machine[] does not render a claim patent ineligible." Pet. at 3. But ChargePoint thereby misrepresents the decision below: the Federal Circuit did not hold ChargePoint's claims invalid because they "incorporat[e]" or "involve" an abstract idea; rather, the Federal Circuit found the claims invalid because they were "directed to" the abstract idea and lacked an inventive concept. The abstract idea is the focus of ChargePoint's

claims, and the recitation of a machine is a generic technological environment. In contrast, the majority in *Diehr* found that the claims "describe a process of curing rubber" that happens to incorporate a mathematical formula. *Diamond v. Diehr*, 450 U.S. 175, 193 n.15 (1981) (disagreeing with the dissent's "characterization of respondents' claims"). Here, the abstract idea (remote control over a network) is the invention itself—unlike in *Diehr*, there is no incorporation of the abstract idea to transform the invention into something more.

Second, ChargePoint describes "[t]he abstract-idea exception to Section 101" as "a failed experiment" and calls on the Court to "reevaluate" the exception by finding that any patent meeting the statutory language "should be eligible under Section 101." Pet. at 3-4; *see also* ChargePoint's Question No. 2. With this second question, ChargePoint gives away its real game, which is to hope that precedent will yield so as to forgive glaring deficiencies the court below identified in the specific patent claims at issue. In effect, ChargePoint is asking this Court to overturn more than 150 years of *stare decisis* by eliminating the judicial exceptions to Section 101. There is no reason for this Court to revisit its longstanding statutory interpretation. Any such statutory revision, especially one as drastic as ChargePoint seeks, should be left for Congress to decide. Alternatively, even if this Court might reconsider its relevant precedent in an appropriate case, this is not such a case. To the contrary, the claims at issue here epitomize those this Court has deemed problematic in their abstraction and fundamentally ineligible for patent protection under the Patent Act as it stands today.

For all these reasons, the petition should be denied.

LEGAL BACKGROUND

35 U.S.C. § 101 sets forth categories of subject matter covered by the Patent Act:

> Whoever 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.

For "more than 150 years," however, this Court has interpreted Section 101 to "contain[] an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable." *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208, 216 (2014). This exception is driven by concerns over "preemption." *Id*. Granting patents on these "basic tools of scientific and technological work" "might tend to impede innovation more than it would tend to promote it." *Id*. (quoting *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 589 (2013) and *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012)).

This Court integrated its 150 years of jurisprudence into a workable, two-step framework in *Mayo* and further refined this framework in *Alice*. Under Step One, "we determine whether the claims at issue are directed to . . . patent-ineligible concepts," such as "abstract ideas." *Id.* at 217. Abstract ideas include "building block[s] of the modern economy." *Id.* at 220. Under Step Two, "we consider the elements of each claim both individually and 'as an ordered combination' to determine whether the additional elements 'transform the nature of the claim' into a patent-eligible application," *i.e.*, whether the claim includes

an "inventive concept" that ensures "'the patent in practice amounts to significantly more than a patent upon'" an abstract idea. *Id.* at 217-218 (quoting *Mayo*, 566 U.S. at 72-73, 78-79). Limiting the abstract idea "'to a particular technological environment,'" including by reciting "a mere instruction to 'implemen[t]' an abstract idea 'on . . . a computer'" "cannot impart patent eligibility." *Id.* at 223 (quoting *Bilski v. Kappos*, 561 U.S. 593, 610-11 (2010) and *Mayo*, 566 U.S. at 72-73, 78-79). Nor can adding "'well-understood, routine, conventional activities' previously known to the industry." *Id.* at 225 (quoting *Mayo*, 566 U.S. at 73) (alternations omitted).

The *Alice* decision also stressed the importance of putting substance over form. The result of the analysis should not "depend simply on the draftsman's art," lest the judicial exceptions to Section 101 be "eviscerat[ed]." *Id.* at 224 (citations and quotation marks omitted). As such, whether claims are "in the physical, rather than purely conceptual, realm is beside the point." *Id.* (citations, quotation marks, and alterations omitted). Similarly, "system claims" (a "machine" under Section 101) are "no different" from "method claims" (a "process" under Section 101) where they "add nothing of substance to the underlying abstract idea." *Id.* at 226-27.

Importantly, this Court's *Alice* decision did not impose qualifying criteria for patent eligibility different from those the Court articulated in earlier cases. Instead, *Alice* explained the significance of *Flook* and *Diehr* in the context of Step Two. Thus, the Court observed, "'*Flook* stands for the proposition that the prohibition against patenting abstract ideas cannot be circumvented by attempting to limit the use of [the idea] to a particular technological environment.'" *Id.*

at 222-23 (quoting *Bilski*, 561 U.S. at 610-11). And the claimed invention in *Diehr*, "employed a 'well-known' mathematical equation, but it used that equation in a process designed to solve a technological problem." *Id*. at 223 (*Diehr*, 450 U.S. at 177-78). While these earlier decisions shed light on the proper application of the *Alice* framework to patent claims, *Alice* supplied the governing framework under which the Federal Circuit analyzed ChargePoint's patents and correctly found them invalid.

STATEMENT OF THE CASE

A. The Patents-In-Suit

The patents-in-suit are directed to adding network control to existing charging stations. Representative claim 1 of U.S. Patent No. 8,138,715 ("'715 patent")[1] recites:

> An apparatus, comprising:
>
> a control device to turn electric supply on and off to enable and disable charge transfer for electric vehicles;
>
> a transceiver to communicate requests for charge transfer with a remote server and receive communications from the remote

[1] The other claims at issue are claim 2 of the '715 patent; claims 1 and 8 of U.S. Patent No. 8,432,131; claims 1 and 2 of U.S. Patent No. 8,450,967; and claims 31 and 32 of U.S. Patent No. 7,956,570. While the Federal Circuit analyzed each claim individually, it concluded the claims at issue are all directed to the same abstract idea and lacked an inventive concept. *ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 773, 775 (Fed. Cir. 2019). ChargePoint's petition does not address these claims individually or otherwise challenge the Federal Circuit's reasoning on any subset of claims.

> server via a data control unit that is connected to the remote server through a wide area network; and
>
> a controller, coupled with the control device and the transceiver, to cause the control device to turn the electric supply on based on communication from the remote server.

The '715 patent states the claimed "control device" is a "solid state device" (*i.e.*, a chip) capable of turning an electric supply on and off. CAFC Joint Appendix[2] at Appx139 ('715 patent at 7:42-44). As shown in ChargePoint's own infringement allegations, this is the same function performed by a common light switch. *Id*. at Appx098 (ChargePoint's Complaint at 18) ("control device" limitation allegedly met by "switching" a charging station "on" or "off"). The claimed "transceiver" can be a commercially available "Wi-Fi® transceiver." *Id*. at Appx139 ('715 patent at 8:23-24). Indeed, ChargePoint contends merely incorporating "wireless technology" and "communicating" with another system meets this limitation, including the "data control unit" element. *Id*. at Appx098 (ChargePoint's Complaint at 18). Finally, the claimed "controller" is any component, such as a processor, capable of controlling the "control device" based on communication received via the "transceiver." *Id.* at Appx098-099 (ChargePoint's Complaint at 18-19) (alleging "controller" limitation is met based on evidence allegedly showing other two limitations). Moreover, according to ChargePoint, "there are no

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[2] The term "CAFC Joint Appendix" refers to the appendix submitted in connection with the appeal below; specifically, Joint Appendix, *ChargePoint, Inc. v. SemaConnect, Inc.*, Appeal No. 2018-1739, Dkt. 37 (filed June 19, 2018).

terms that require construction" because all claims "use[] plain and ordinary language." *Id.* at Appx423-427 (ChargePoint's Memorandum in Support of Motion for Emergency Injunctive Relief at 15-19).

ChargePoint's claims thus allegedly cover *all* solutions for adding network control to an electric vehicle charging station. Of course, ChargePoint did not invent computer networking, charging stations, or a technical improvement to either. As such, the only allegedly inventive aspect of these claims is the addition of generic network control to a generic charging station. As the named inventor of the patents-in-suit acknowledged, "Prior to their invention by ChargePoint (then Coulomb) there were no networked electric vehicle charging stations, although *non-networked electric vehicle charging stations had existed for many years*." *Id.* at Appx179 (Declaration of David Baxter ¶ 5) (emphasis added). Moreover, ChargePoint's counsel repeatedly confirmed this understanding during the February 6, 2018 hearing at the district court level on SemaConnect's Motion to Dismiss. *Id.* at Appx798-799 (admitting that the claimed "network-enabled charging station" is different from prior art charging stations "[p]recisely" because "it's network enabled"); *id.* at Appx800 ("[Y]es, the novelty of that physical device is how it is controlled and what goes into controlling it."); *id.* at Appx808 (admitting that ChargePoint is "claiming that what's novel is the ability to do this controlling remotely by [ChargePoint's] system"); *id.* at Appx809 (admitting that "the essence of [ChargePoint's] invention is a system where these things can be controlled remotely and not by somebody just physically at the charging station"); *id.* at Appx839 ("We invented networked, remote-controllable charging stations for electric vehicles."). Before the Federal Circuit,

ChargePoint again reiterated that the "essence" of its patents "is to enable electric-vehicle charging stations to 'be controlled remotely.'" ChargePoint's Opening Brief, *ChargePoint, Inc. v. SemaConnect, Inc.*, Appeal No. 2018-1739, Dkt. 27, at 42 (filed April 19, 2018).

That ChargePoint claimed nothing more than an abstract idea (network control) and an instruction to apply this abstract idea to a particular technological environment (charging stations) is apparent from the claims themselves. Replacing a single word in representative claim 1 of the '715 patent would allow ChargePoint to claim *any* machine (*e.g.*, a coffee maker) that could be connected to a network:

> 1. An apparatus, comprising
>
> a control device to turn electric supply on and off to enable and disable charge transfer for electric vehicle *[coffee maker/dishwasher/dryer/hot water heater]*;
>
> a transceiver to communicate requests for charge transfer with a remote server and receive communications from the remote server via a data control unit that is connected to the remote server through a wide area network; and
>
> a controller, coupled with the control device and the transceiver, to cause the control device to turn the electric supply on based on communication from the remote server.

ChargePoint thus did not invent an improved charging station. Instead, its claims take the idea of network control and instruct one to "apply it" to a charging station, without specifying any inventive networking solution, any inventive charging stations,

or, indeed, any details regarding how either concept would need to be implemented or modified in order to achieve ChargePoint's claimed inventions.

B. The Parties and the Underlying Dispute

The current dispute arises from Volkswagen's settlement of its diesel emissions scandal. As part of this settlement, Volkswagen agreed to invest $2 billion in electric vehicle charging stations in order to encourage the use of electric vehicles. Volkswagen created a wholly-owned subsidiary called Electrify America to oversee and administer this project.

On March 24, 2017, Electrify America invited several companies, including SemaConnect and ChargePoint, to bid on the first phase of this project. Electrify America ultimately awarded contracts to three companies: SemaConnect, Greenlots, and EV Connect. Unhappy with Electrify America's decision, ChargePoint filed its District Court complaint against SemaConnect, the smallest of the three companies, alleging that SemaConnect infringed the '715, '570, '131, and '967 patents.

The district court denied ChargePoint's motion for emergency injunctive relief and set an expedited schedule for SemaConnect's motion to dismiss under 35 U.S.C. § 101. The district court then found all claims at issue invalid for claiming patent ineligible subject matter. *ChargePoint, Inc. v. SemaConnect, Inc.*, No. MJG-17-3717, 2018 WL 1471685 (D. Md. Mar. 23, 2018). When ChargePoint appealed, a unanimous panel affirmed. All four judges to consider the matter have thus agreed that the claims at issue are ineligible for patent protection under settled law.

C. The Decision Below

The Federal Circuit panel analyzed each of the claims-in-suit individually and concluded, unanimously, that their "essence" of remotely controlling a device using a network is an abstract idea under this Court's *Alice* framework. As the Federal Circuit explained in connection with Step One:

> [T]he eight claims on appeal . . . are all directed to the abstract idea of communicating over a network for device interaction. *Communication over a network for that purpose has been and continues to be a "building block of the modern economy." . . . [T]his "is an 'abstract idea' beyond the scope of § 101"*, and the asserted claims are directed to that abstract idea.

ChargePoint, 920 F.3d at 773 (emphasis added).

The panel also analyzed all claim limitations (individually and as an ordered combination) in connection with Step Two of the *Alice* framework, but concluded the only allegedly "inventive" aspect of the claims was the abstract idea itself:

> [T]he alleged "inventive concept" that solves problems identified in the field is that the charging stations are network-controlled. *But network control is the abstract idea itself*, and "a claimed invention's use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention 'significantly more' than that ineligible concept."

Id. at 774 (emphasis added).

Based on these findings, the Federal Circuit affirmed the District Court's decision invalidating all claims-in-suit. *Id.* at 777. ChargePoint filed a petition for rehearing en banc, but the Federal Circuit denied its petition. *ChargePoint, Inc. v. SemaConnect, Inc.*, Appeal No. 2018-1739, Dkt. 73 (Fed. Cir. July 23, 2019).

REASONS FOR DENYING THE WRIT

I. THE DECISION BELOW CORRECTLY APPLIED THE FRAMEWORK SET FORTH IN *ALICE*

The Federal Circuit's decision below reflects a correct, straightforward application of this Court's framework on patent eligibility set forth in *Alice*. None of the four judges who considered the matter at the trial and appellate stages had any disagreement on the dispositive point. And the only amicus who supports ChargePoint's instant bid for certiorari is an individual, a patent practitioner, who does not speak for any larger organization

The decision below follows inexorably from *Alice*. Under *Alice* Step One, the Federal Circuit first concluded that the claims "involve" the abstract idea of "communication over a network." *ChargePoint*, 920 F.3d at 766. Quoting this Court's *Alice* and *Bilski* decisions, the court below held that "[c]ommunication over a network . . . has been and continues to be a 'building block of the modern economy'" and thus is an abstract idea. *Id.* at 773. The Federal Circuit did not stop there, however, but further determined the claims were "directed to" this abstract idea by ascertaining their "focus." *Id.* at 767. ChargePoint does not and cannot contest this conclusion. Time and again, ChargePoint admitted that the "essence" of its claims is enabling a pre-existing charging station "to

'be controlled remotely.'" ChargePoint's Opening Brief, *ChargePoint, Inc. v. SemaConnect, Inc.*, Appeal No. 2018-1739, Dkt. 27, at 42 (filed April 19, 2018); *see also* CAFC Joint Appendix at Appx809 (District Court Hearing Tr. at 43:10-13) (admitting that "the essence of [ChargePoint's] invention is a system where these things can be controlled remotely and not by somebody just physically at the charging station"). And the concept of remote control is little different from the idea of communicating "at any distance" using technology "however developed," which this Court found "too broad" more than 150 years earlier in *O'Reilly v. Morse*. 56 U.S. 62, 112-13 (1853). The Federal Circuit thus correctly concluded ChargePoint's claims were *not* "directed to" an improved charging station or any specific solution for introducing network control. Instead, ChargePoint sought to claim the abstract idea of network control in the context of electric vehicle charging stations.

Under *Alice* Step Two, the Federal Circuit marched through all limitations of all claims at issue, both individually and as an ordered combination, before concluding that "the alleged 'inventive concept' that solves problems" identified by ChargePoint is the very same "ineligible concept" identified in Step One. *ChargePoint*, 920 F.3d at 774; *see also id.* ("This . . . merely mirrors the abstract idea itself and thus cannot supply an inventive concept."). This is consistent with *Alice*, where the Court specified that a claim "must include '*additional* features' to ensure 'that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].'" *Alice*, 573 U.S. at 221 (emphasis added). If the abstract idea itself can supply an inventive concept under Step Two of the *Alice* framework, then patentees would be able to monopolize abstract ideas that are not "'well-understood, routine,

conventional activities' previously known to the industry." *Id.* at 225 (quoting *Mayo*, 566 U.S. at 73) (alternations omitted). Accordingly, the Federal Circuit correctly concluded that "network communication is the only possible inventive concept" and that "the abstract idea itself" "cannot supply the inventive concept." *ChargePoint*, 920 F.3d at 775.

Even beyond the Federal Circuit's analysis, ChargePoint's claims parallel the claims held ineligible in *Alice*. In *Alice*, this Court addressed application of an abstract idea to a generic computer, finding that "if a patent's recitation of a computer amounts to a mere instruction to 'implemen[t]' an abstract idea 'on . . . a computer,' that addition cannot impart patent eligibility." *Alice*, 573 U.S. at 223 (quoting *Mayo*, 566 U.S. at 84) (citation omitted). Here, ChargePoint sought to patent the abstract idea of network control by adding an instruction to "apply it" to a particular technological environment—a generic charging station. ChargePoint contends that its claims are not limited to any specific solution for achieving network control (much less an innovative solution) and purport to cover all charging stations embodying this abstract idea. ChargePoint's recitation of a charging station and other generic hardware thus does not "provide[] any 'practical assurance that the process is more than a drafting effort designed to monopolize the [abstract idea] itself.'" *See id* at 224. (quoting *Mayo*, 566 U.S. at 77); *see also id.* at 226 ("recit[ing] a handful of generic computer components configured to implement the same idea" does not confer patent eligibility).

In sum, the Federal Circuit's application of *Alice* is beyond reproach, as is its ultimate conclusion that ChargePoint's claims are patent ineligible. Any contrary view threatens to grant ChargePoint a monopoly

over *all* use of the abstract idea of network control in the technological environment of electric vehicle charging stations. No such monopoly should be entertained, nor should the instant petition.

II. THE DECISION BELOW REFLECTS A STRAIGHTFORWARD APPLICATION OF THIS COURT'S LONGSTANDING PRECEDENT

ChargePoint does not substantively discuss *Alice* or argue the Federal Circuit misapplied either step of the *Alice* framework. Instead, ChargePoint attempts to undermine that framework altogether by invoking earlier decisions of this Court and arguing the Federal Circuit's analysis (while consistent with *Alice*) contravenes those earlier cases. Contrary to ChargePoint's account, however, there is no inconsistency between the Federal Circuit's decision and this Court's older precedents.

A. ChargePoint's Claims Do Not Merely "Involve" An Abstract Idea; But Are "Directed" To The Abstract Idea

ChargePoint faults the Federal Circuit for invalidating its claims because they "involve" or "incorporate" an abstract idea. Pet. at 18 (emphasis added; citations omitted):

> [T]he Federal Circuit observed that [ChargePoint's] claims also 'involve[] an abstract idea . . . . *This involvement of an abstract idea, according to the court, rendered the claims patent ineligible under Section 101*. This holding conflicts directly with the Court's decision in *Diamond v. Diehr* and the long-standing principles it embodies."

In this important respect, ChargePoint mischaracterizes the Federal Circuit's decision. The court below expressly acknowledged that "involv[ing]" an abstract idea is "not enough"; instead, courts must "determine whether th[e] patent-ineligible concept is what the claim is '*directed to*.'" *ChargePoint*, 920 F.3d at 766 (emphasis added). The Federal Circuit performed this analysis precisely as instructed by this Court and concluded, "looking at the problem identified in the patent, as well as the way the patent describes the invention, . . . the invention of the patent is nothing more than the abstract idea of communication over a network for interacting with a device, applied to the context of electric vehicle charging stations." *Id.* at 768; *see also id.* at 770 ("[T]he claim language and the specification indicate that the focus of the claim is on the abstract idea of network communication for device interaction."). In other words, the Federal Circuit did not invalidate ChargePoint's claims merely because they "involve" an abstract idea; it deemed these claims invalid because they are "directed to" that abstract idea.

The Federal Circuit's decision here is consistent with this Court's decision in *Diehr*. The claims in *Diehr* specified "a process for molding raw, uncured synthetic rubber into cured precision products." 450 U.S. at 177. Respondents in that case "characterize[d] their contribution to the art to reside in the process of constantly measuring the actual temperature inside the mold," which was "new in the art" and addressed a "shortcoming" in "conventional industry practice." *Id.* at 177-79. The Court agreed with Respondents' characterization: "We view respondents' claims as nothing more than a process for molding rubber products and not as an attempt to patent a mathematical formula." *Id.* at 191. This conclusion was supported

by the claim language itself, which requires "initiating an interval timer . . . upon the closure of the [rubber-molding] press," "constantly determining the temperature . . . of the mold," "repetitively calculating" an equation based on this data, "repetitively comparing" the result of the calculation with the "elapsed time," and finally "opening the press automatically when a said comparison indicates equivalence." *Id.* at 179 n.5. The claims in *Diehr* thus did not merely present the abstract mathematical formula coupled with an instruction to "apply it" to "a rubber-molding press." Instead, the claims set forth an innovative molding process from start-to-finish that leveraged the formula as part of a specific implementation. When the claims were "considered as a whole," they were "drawn to an industrial process for the molding of rubber products." *Id.* at 192.

In contrast, ChargePoint simply took a the abstract idea of network control and added it to a generic electric vehicle charging station. Under *Diehr* and *Alice* alike, this is insufficient to confer patent eligibility. This Court's *Flook* decision is especially on point in dooming the claims at issue. In *Flook*, the claims recited a series of steps for calculating and updating an "alarm limit," and only the preamble specified these calculation were "involved in a process [for] catalytic chemical conversion of hydrocarbons." *Parker v. Flook*, 437 U.S. 584, 596-97 (1978). Unlike in *Diehr*, none of the claim limitations in *Flook* specified any implementation for obtaining data from the specific process or what effect the updated alarm limit has on the overall process. In other words, calculating the alarm limit was not integrated into the claimed process, and simply replacing a few words in the preamble would have rendered the claim applicable to other processes. The same is true here, where replac-

ing a single word in ChargePoint's claim 1 of the '715 patent ("vehicle") would allow that claim to cover any other electronic machine (*e.g.*, a coffee maker). The core holding of *Flook* thus applies in force to ChargePoint's patents: "the prohibition against patenting abstract ideas cannot be circumvented by attempting to limit the use of [the idea] to a particular technological environment." *Alice*, 573 U.S. at 222 (quoting *Bilski*, 561 U.S. at 610-11).

ChargePoint's claims are thus distinguishable from the claims found patent eligible in *Diehr* and more akin to the claims found invalid in *Flook*. ChargePoint cannot monopolize the abstract idea of network control by appending a generic electric vehicle charging station.

B. Recitation Of A "Machine" Does Not Automatically Confer Patent Eligibility

ChargePoint also argues its patents ought to be found patent eligible based on this Court's precedent allegedly "distinguish[ing] between an ineligible 'patent for a principle' and 'a machine embodying a principle.'" Pet. at 19 (quoting *Morse*, 56 U.S. at 115[3]); *see also* Pet. at 21 ("The Federal Circuit recognized that ChargePoint's inventions 'build[] a better machine,' which under the plain terms of Section 101 should be enough.") (citation omitted).[4] But ChargePoint's alleged

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[3] The quoted portion of *Morse* was not part of this Court's holding. Instead, it was a quote from the earlier *Neilson v. Harford* decision delivered in the English Court of Exchequer.

[4] ChargePoint's citation to *Chamberlain Group, Inc. v. Techtronic Industries Co.*, 935 F.3d 1341, 1349 (Fed. Cir. 2019) is misplaced, as this petition is not an appeal from the *Chamberlain* decision. *See* Pet. at 21-22. ChargePoint's speculation regarding fictional inventions from a movie, *Back to the Future*, is similarly irrelevant. *See id.* at 22. There is no dispute a claim directed to a functioning flux capacitor would be patent eligible, and the

distinction oversimplifies this Court's precedent. A claim to a generic "machine embodying a principle," without any specificity to protect the "principle" from preemption, is just as invalid as a claim to the "principle" itself.

In *Flook* this Court warned that protection against monopolizing abstract ideas cannot be circumvented by "the draftsman's art." *Flook*, 437 U.S. at 593; *see also id.* at 590 ("A competent draftsman could attach some form of post-solution activity to almost any mathematical formula . . . . The concept of patentable subject matter under § 101 is not 'like a nose of wax which may be turned and twisted in any direction . . . .'"). Consistent with its warning, the Court required "additional features that provide practical assurance that the process is more than a drafting effort designed to monopolize the law of nature itself." *Mayo*, 566 U.S. at 77. Thus, in *Alice*, merely reciting generic computer components or presenting claims as being directed to systems did not confer patent eligibility. *Alice*, 573 U.S. at 224, 226-27 (quoting *Flook*, 437 U.S. at 590, 593). In *Alice*, "[t]here [wa]s no dispute that a computer is a tangible system (in § 101 terms, a 'machine)," but the Court nonetheless found "[t]he fact that a computer 'necessarily exist[s] in the physical, rather than purely conceptual, realm' is beside the point.'" *Id.* at 224.

Accordingly, merely appending a "particular machine" to an otherwise abstract idea, as ChargePoint has done here by adding limitations associated with

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same remains true for Dr. Brown's improved DeLorean with a plutonium-fueled nuclear reactor. The abstract idea of "time travel" is patent ineligible, however, even when coupled with an instruction to "apply it" to an electric vehicle charging station.

generic "electric-vehicle charging stations," is insufficient to confer patent eligibility. *See* Pet. at 18. The abstract idea of network control, coupled with an instruction to "apply it" to an electric-vehicle charging station, is no more patent eligible than the abstract mathematical formula in *Flook* coupled with an instruction to "apply it" to "catalytic chemical conversion of hydrocarbons." *See Flook*, 437 U.S. at 586. ChargePoint should not be permitted to patent and thus monopolize the concept of network control across an entire technological environment without contributing any innovative solution to networking or charging station technology other than an instruction to apply the former to the latter. Identifying a "particular machine" in the claims—just like a particular process in *Flook*—does not obviate this core preemption concern, and instead is nothing more than a drafting effort to circumvent this Court's jurisprudence on Section 101 "'by attempting to limit the use of [the idea] to a particular technological environment.'" *Alice*, 573 U.S. at 222-23 (quoting *Bilski*, 561 U.S. at 610-11.

The outcome below also accords with the Court's earlier decision in *Morse*. There, the Court held that the "[e]ighth" claim found invalid did not limit the claimed invention "to the specific machinery, or parts of machinery, described in the foregoing specification and claims" and instead sought to monopolize the abstract idea of "making or printing intelligible characters, letters, or signs, at any distances" using electro-magnetism "however developed." 56 U.S. at 112. But even the eighth claim required *some* machinery to "mak[e] or print[] intelligible characters, letters, or signs." The issue in *Morse* was thus not that the eighth claim did not require *any* machinery, but that it was not limited to "specific machinery" for implementing the abstract idea.

The Court's discussion of steam power is informative:

> No one, we suppose will maintain that Fulton could have taken out a patent for his invention of propelling vessels by steam, describing the process and machinery he used, and claimed under it *the exclusive right to use the motive power of steam, however developed, for the purpose of propelling vessels*. It can hardly be supposed that under such a patent he could have prevented the use of the improved machinery which science has since introduced; although the motive power is steam, *and the result is the propulsion of vessels*.

Id. at 113 (emphasis added). The Court thus observed that a claim directed to an abstract idea ("the motive power of steam") remains patent ineligible even when applied to a particular machine ("vessels") when the claim is broad enough to cover the abstract idea "however developed." The same reasoning applies here. ChargePoint may have claimed the abstract idea of network control when applied to electric vehicle charging stations, but its claims are not limited to any specific network implementation, and thus remain patent ineligible.

C. The Federal Circuit Correctly Considered ChargePoint's Claims "As A Whole"

Finally, ChargePoint contends the Federal Circuit "isolate[d] the supposedly 'new' aspects of ChargePoint's invention, dismissing the old aspects, and then determining the new parts abstract ideas that are ineligible for patenting." Pet. at 20. That, too, is wrong.

First, ChargePoint's argument seeks to manufacture dispute where there is none. The analysis cited in ChargePoint's petition relates to the Federal Circuit's effort in Step One of the *Alice* framework to ascertain the "focus" of ChargePoint's patents, *i.e.*, whether they were "directed to" this abstract idea. *ChargePoint*, 920 F.3d at 767-68; *see also Mayo*, 566 U.S. at 72 (describing Supreme Court precedent as "insist[ing] that a process that *focuses* upon the use of [a patent ineligible concept] also contain other elements . . . sometimes referred to as an 'inventive concept'") (emphasis added). Yet, far from denying this is in fact the "focus" of its patents, ChargePoint has repeatedly admitted that the "essence" of its patents "is to enable electric-vehicle charging stations to 'be controlled remotely.'" ChargePoint's Opening Brief, *ChargePoint, Inc. v. SemaConnect, Inc.*, Appeal No. 2018-1739, Dkt. 27, at 42 (filed April 19, 2018); *see also* CAFC Joint Appendix at Appx809 (District Court Hearing Tr. at 43:10-13) (admitting that "the essence of [ChargePoint's] invention is a system where these things can be controlled remotely and not by somebody just physically at the charging station"). Thus, regardless of the analysis employed by the Federal Circuit, the "essence" the Federal Circuit identified is the same "essence" that ChargePoint has repeatedly trumpeted. It is unsurprising that the Federal Circuit through its analysis reached the same conclusion ChargePoint itself has as to the focus of its patent claims.

Second, ChargePoint errs in its description of the Federal Circuit's methodology in Step One of the *Alice* framework. The Federal Circuit *first* identified the abstract idea at issue and *then* looked to the specification to ascertain the "focus" of ChargePoint's patents, *i.e.*, whether they were "directed to" this abstract idea. *ChargePoint*, 920 F.3d at 767-68; *see also Mayo*, 566

U.S. at 72 (describing Supreme Court precedent as "insist[ing] that a process that *focuses* upon the use of [a patent ineligible concept] also contain other elements . . . sometimes referred to as an 'inventive concept'") (emphasis added). Based on this review, the Federal Circuit concluded that "the problem perceived by the patentee was a lack of a communication network for these charging stations, which limited the ability to efficiently operate them *from a business perspective*"; it further concluded that there was no "suggest[ion] that the charging station itself is improved *from a technical perspective*." *ChargePoint*, 920 F.3d at 768 (emphasis added). The Federal Circuit then "return[ed] to the claim language itself to consider the extent to which the claim would preempt building blocks of science and technology." *Id*. at 768. Based on this analysis, the Federal Circuit concluded that "the claim language and the specification indicate that the focus of the claim is on the abstract idea of network communication for device interaction." *Id.* at 770; *see also id.* ("[T]he inventors here had the good idea to add networking capabilities to existing charging stations to facilitate various business interactions. *But that is where they stopped, and that is all they patented*.") (emphasis added).

The Federal Circuit thus did not dismiss any portion of ChargePoint's claims for including "old aspects," as ChargePoint now contends. Instead, the Federal Circuit correctly analyzed the claims and specification to ascertain the "focus" of ChargePoint's claims and whether they are as a whole "directed to" an abstract idea. The Federal Circuit sought to understand "the problem facing the inventor" and "what the patent describes as the invention." *ChargePoint*, 920 F.3d at 767. Whether individual claim elements were actually "new" or "old" was irrelevant to this analysis.

III. THE CASE PRESENTS A POOR VEHICLE FOR RECONSIDERING THE JUDICIAL EXCEPTIONS TO SECTION 101

Section II of ChargePoint's petition asks the Court to re-evaluate 150 years of *stare decisis* and upend this Court's precedent denying patent eligibility to abstract claims. Pet. at 23-24. Section III of ChargePoint's petition then launches into a frontal assault on this Court's *Alice* decision and the Federal Circuit's interpretation thereof based on cherry-picked statistics and counsel's policy arguments, unsupported by any amicus save one lone patent practitioner. None of these arguments begins to justify erasing 150 years of this Court's precedent in the absence of any action by Congress, which can always revise the Patent Act as and if it sees fit, but has declined to do so. And even if this Court were to reconsider its precedent on patent eligibility, it should await the right vehicle to do so. *Cf.* Brief of United States as Amicus Curiae, *HP Inc. v. Berkheimer*, Appeal No. 18-415, at 10 (arguing "[t]his case . . . would be an unsuitable vehicle to provide guidance" on the substantive standards for patent eligibility because "[t]he parties disagree as to what the claimed invention comprises"); Brief of United States as Amicus Curiae, *Hikma Pharmas. USA Inc. v. Vanda Pharmas. Inc.*, Appeal No. 18-817, at 8 (arguing "[t]his case . . . is not an optimal vehicle for bringing greater clarification because the court of appeals majority arrived at the correct result").

ChargePoint's patent claims present an especially poor vehicle for present purposes. Four judges have uniformly agreed that this is an easy case for denying patent eligibility under Section 101. To the extent ChargePoint would here challenge that judicial consensus surrounding its claimed inventions, its

arguments reduce to a fact-bound dispute that is confined to particulars of this case. The petition therefore supplies a poor vehicle for re-evaluating the framework set forth in *Alice*.

A. ChargePoint's Patents Present Grave Preemption Concerns

ChargePoint's patents should not prompt this Court to reexamine its interpretation of 35 U.S.C. § 101 for the simple reason that ChargePoint's patents exemplify the exact danger the Court's patent eligibility analysis was designed to protect against.

The Court's jurisprudence on Section 101 is designed to protect laws of nature, natural phenomena, and abstract ideas from preemption, and thereby, ensure "basic tools of scientific and technological work" remain available to all. *Alice*, 573 U.S. at 216. Otherwise, patents "might tend to impede innovation more than it would tend to promote it." *Id.* The relevant inquiry "is a *relative* one: how much future innovation is foreclosed relative to the contribution of the inventor." *Mayo*, 566 U.S. at 88.

Here, ChargePoint's only alleged invention comes down to the idea of adding network control to pre-existing charging stations. According to ChargePoint, it is now *impossible* to make, sell, or use a network-controlled charging station without infringing its patents. Tellingly, ChargePoint's infringement allegations do not specifically identify a single hardware component—they do not name the make or model of one modem, chip, conductor, switch, or outlet—in the accused products, but instead characterize the accused products entirely based on their functionalities. *See* CAFC Joint Appendix at Appx098-099 (ChargePoint's Complaint at 18-19). In fact, ChargePoint is accusing

of infringement charging stations that have not even been built. *See id.* Appx087 (ChargePoint's Complaint ¶ 18). The fact that ChargePoint somehow knows that non-existent charging stations—that have not even been built yet—will inevitably infringe its patents alone demonstrates that the patents seek to monopolize the entire industry.[5]

Finding ChargePoint's claims valid would "'tend to impede innovation more than it would tend to promote it.'" *See Alice*, 573 U.S. at 216. ChargePoint's infringement theories are based on the accused product's alleged "smart grid integration" which allows "chargers to operate with more solar and wind energy as it comes onto the grid." CAFC Joint Appendix at Appx098-099 (ChargePoint's Complaint at 18-19). ChargePoint's specification, however, is entirely silent on the use of solar, wind, and other clean energy sources, demonstrating that its inventors did not foresee that charging stations might be able to use network communication to leverage newly available power sources. In effect, ChargePoint seeks to exclude future generations of innovation in green technology based on its effort to monopolize the basic concept of network control. ChargePoint's monopolization efforts are the

[5] The only charging stations ChargePoint identified as allegedly not infringing its patents are "[n]on-networked charging stations." *Id.* at Appx327 (Declaration of Dr. Zygmunt Haas ¶ 62). Given the ubiquity of computer networks, this alleged non-infringement alternative does little to protect against ChargePoint's efforts to monopolize the charging station industry. *See Alice*, 573 U.S. at 223-24 (holding that, "[g]iven the ubiquity of computers, "wholly generic computer implementation" does not "provide[] any 'practical assurance'" against monopolization of the abstract idea).

exact type of conduct this Court's decisions in *Alice*, *Mayo*, *Bilski*, *Flook*, and *Morse* guard against.

Indeed, given the ubiquity of computer networks in today's world, finding ChargePoint's patents valid would effectively grant ChargePoint a monopoly over the entire charging station industry. Even worse, such a decision would set precedent harmful to other industries and future technology. As illustrated above, the structure of ChargePoint's patent claims allows them to be applied to *any* machine by simply replacing a single word, opening the door to similar monopolization of network control in the context of other technological environments. And nothing would prevent another entity from monopolizing artificial intelligence in connection with operating *any* machine simply by adding a claim element directed to "make a decision using AI" as one of the steps performed by that machine.

None of ChargePoint's arguments mitigate the damage that would result from allowing its patents to stand. ChargePoint cites various statistics on the rate at which patents are invalidated under this Court's *Alice* decision. Pet. at 25, 27-30. But invalidating bad patent claims that contravene *Alice* should not be lamented. By no means do these statistics indicate that *Alice* or the Federal Circuit's decision here needs to be overturned. Rather, they confirm that *Alice* has proved to be effective in tightening the overly-relaxed standard for patent eligibility that had formerly found currency with the Federal Circuit. *See*, *e.g.*, *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1374 (Fed. Cir. 1998) (finding any claim patent eligible as long as "it produces 'a useful, concrete and tangible result,'" even if that result is just momentarily fixing

a final share price "for recording and reporting purposes"). Such overly broad patents should have never issued, and the patent office and court's efforts to now invalidate such patents should be commended.

ChargePoint's other policy arguments reflect pure speculation by counsel. ChargePoint thus argues that alleged uncertainty in the lower court's application of *Alice* will "harm innovation." Pet. at 25-28. This argument has no bearing on the law applicable to the present case. Indeed granting certiorari here cannot help resolve any alleged uncertainty, because ChargePoint's patents do not present a close case that might serve to clarify the law. Instead, as explained above, the claims at issue reflect a straightforward application of *Alice*: limiting the abstract idea of network control to the technological environment of charging stations cannot confer patent eligibility. ChargePoint also contends that the status quo "tend[s] to favor large companies with multi-billion-dollar research and development budgets," but it does not cite *anything* in support of that argument. In fact, the opposite is equally, if not more, likely: under *Alice*, large companies cannot use patents on abstract ideas to block small competitors from entering the same field. Ironically, that is exactly what ChargePoint is trying to do here, as it seeks to leverage its status as an early entrant to exclude a smaller competitor from the electric vehicle charging station industry. *See* CAFC Joint Appendix at Appx083-086 (Complaint ¶¶ 5, 14) (contrasting ChargePoint's network of "tens of thousands of stations that have been used more than 16 million times" with "SemaConnect's annual revenue [of] around $1 million").

This Court's 150-year jurisprudence on patent eligibility has been driven by a concern with protecting the

basic building blocks of research and our economy from monopolization. The whole thrust of this Court's precedent is to foreclose patents like those at issue here from inhibiting and retarding entire industries such as the electric vehicle charging station industry. Overturning all of those prior cases to find ChargePoint's patents valid would eviscerate vital protection, inject uncertainty, and invite abuse.

B. Any Re-Evaluation of Section 101 Should Be Reserved For Congress, Or, Alternatively, Reserved For Other Cases

Finally, ChargePoint's petition cites various other recent Federal Circuit decisions and even legislative efforts to potentially amend 35 U.S.C. § 101. Pet. at 25 (citing *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138 (Fed. Cir. 2016)); Pet. at 25 (citing *Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC*, 927 F.3d 1333 (Fed. Cir. 2019) (en banc); Pet. at 27 (citing testimony from a June Senate hearing on potential amendments to Section 101). None of these citations support granting *ChargePoint's* petition for writ of certiorari. To the contrary, they confirm that any statutory revision at this point can and should come from Congress.

The Court already denied the petition for writ of certiorari filed in *Synopsys*. *See* Case No. 2015-1599. And, contrary to ChargePoint's assertion, there is nothing inconsistent with refusing to import disclosure in the specification into the claims (as the Federal Circuit did in *Synopsys*) and looking to the specification to identify the focus of the claims (as the Federal Circuit did here).

The Federal Circuit's decision in *Athena* has no connection to this case. *Athena* may be closely watched by the medical industry, garnering *eleven* briefs amicus curiae, but ChargePoint's petition is not—it received a *single* brief amicus curiae from one patent practitioner. Moreover, whereas the original *Athena* decision prompted a dissent, and the en banc petition fractured the Federal Circuit and prompted eight different opinions, the Federal Circuit in this case was unanimous in affirming the district court's determination that ChargePoint's patents are invalid. Finally, *Athena* addresses the application of this Court's *Alice* and *Mayo* decision to "medical diagnostic patents," and whether such patents can ever be distinguished from the patents found invalid in *Mayo*. *Athena* thus poses questions specific to medical diagnostic patents:

- "[w]hether a new and specific method of diagnosing a medical condition is patent-eligible subject matter" (*see* Petition for a Writ of Certiorari, Case No. 2017-2508); and
- "[w]hether patent claims to a method of diagnosis are ineligible under 35 U.S.C. § 101" (*see* Brief in Opposition, Case No. 2017-2508).

Accordingly, even if Court decides to grant certiorari in *Athena*, the outcome of that decision will have no impact on the software-related patents at issue here.

Finally, ChargePoint's citation to Congressional proposals to amend Section 101 only counsels in favor of denying ChargePoint's petition. Suffice to note that Congress has yet to adopt ChargePoint's desired revisions and remains free to do so as and if it may please. Congress is better suited to receive testimony from industry and academics and evaluate competing policy considerations, as would be necessary in decid-

ing whether or not to overrule this Court's prior interpretation of Section 101. Especially while Congress is right now considering possible revisions to Section 101, this Court should not wade into choppy legislative waters to inject judicial revisions. To the extent policy counsels in favor of revising Section 101, these revisions should be expressly reflected in the statute and thus made by the legislative branch, and not by judicial re-interpretation of the current statute.

This Court is rightly loathe to overturn its statutory constructions, precisely because Congress can always correct any precedent it deems offensive. *See Illinois Brick Co. v. Illinois*, 431 U.S. 720, 736 (1977) ("[W]e must bear in mind that considerations of *stare decisis* weigh heavily in the area of statutory construction, where Congress is free to change this Court's interpretation of this legislation."). It follows *a fortiori* that the Court should not overturn a settled construction of Section 101 that Congress has left in place for over 150 years.[6] And the Court certainly should not entertain doing so in a posture where Congress is actively considering revisions that stand to moot or supersede any decision the Court might issue on the merits. In multiple respects, therefore, this case presents a poor vehicle for the Court to revisit its longstanding precedent governing ineligibility for patent protections under Section 101.

[6] The statutory language being interpreted has itself remained essentially since 1793. *See In re Bilski*, 545 F.3d 943, 966 (Fed. Cir. 2008) (Dyk,, J., concurring).

CONCLUSION

The petition should be denied.

Respectfully submitted,

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December 23, 2019