No. 22-1220

In The Supreme Court of the United States

JEFFREY A. KILLIAN,

Petitioner,

v.

KATHERINE K. VIDAL, Director,
United States Patent and Trademark Office,

Respondent.

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

AMICUS BRIEF OF US INVENTOR INC. AND EAGLE FORUM EDUCATION & LEGAL DEFENSE FUND IN SUPPORT OF PETITIONER

ROBERT GREENSPOON
Counsel of Record
DUNLAP BENNETT & LUDWIG
333 N. Michigan Avenue,
Suite 2700
Chicago, IL 60601
(312) 551-9500
rgreenspoon@dbllawyers.com

ANDREW L. SCHLAFLY
939 Old Chester Road
Far Hills, NJ 07931
(908) 719-8608
aschlafly@aol.com

COCKLE LEGAL BRIEFS (800) 225-6964
WWW.COCKLELEGALBRIEFS.COM

QUESTION PRESENTED

Do the judicial exceptions created by Article III courts under 35 U.S.C. § 101 exceed the constitutional authority of the courts?

TABLE OF CONTENTS

TABLE OF AUTHORITIES

Page

CASES

TABLE OF AUTHORITIES – Continued

TABLE OF AUTHORITIES – Continued

Page

OTHER AUTHORITIES

TABLE OF AUTHORITIES – Continued

INTERESTS OF *AMICI CURIAE*[1]

Amicus US Inventor is a non-profit 501(c)(4) membership organization founded in 2015 with the mission of restoring the ability of an inventor to stop the theft of a patented invention. US Inventor opposes the erosion of inventor rights in recent years due in part to judicial decisions. US Inventor educates, supports, and inspires inventors, and advocates on their behalf in order to protect inventor rights and strengthen the patent system.

Amicus Eagle Forum Education & Legal Defense Fund ("Eagle Forum ELDF") was founded in 1981 by Phyllis Schlafly, who vocally defended traditional patent rights. Eagle Forum ELDF advocates that the bedrock of our Nation's prosperity is our traditional American patent system. In addition to publishing materials on this topic, Eagle Forum ELDF has filed multiple *amicus curiae* briefs in this Court on the side of small inventors for more than a decade, including in *Bilski v. Kappos*, 561 U.S. 593 (2010). *Amici* therefore have strong interests in this Petition for a Writ of Certiorari.

---

[1] *Amici* file this brief after providing the requisite ten days' prior written notice and receiving written consent by all the parties. Pursuant to Rule 37.6, counsel for *amici curiae* authored this brief in whole, no counsel for a party authored this brief in whole or in part, and no such counsel or a party made a monetary contribution intended to fund the preparation or submission of this brief. No person or entity – other than *amici*, its members, and its counsel – contributed monetarily to the preparation or submission of this brief.

SUMMARY OF ARGUMENT

Dire consequences flowed from this Court's decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014). "No U.S. Supreme Court patent case has ever had so large an effect in so short a time as *Alice*," observed Kenneth Adamo from Kirkland & Ellis LLP.[2] In the first two years after the *Alice* test was created by that decision, more than "8400 applications got abandoned while 60,000+ applications got rejected due to the decision. The district court decisions clocked around 247 – invalidating 70% of them – and Federal Circuit at 40 – invalidating 95% of the patents under 35 USC 101."[3]

At the root of this havoc is the judicial narrowing of patent eligibility. Seven different opinions were written by the Federal Circuit in one case attempting to apply *Alice*. *See Athena Diagnostics, Inc. v. Mayo Collaborative Services, LLC*, 927 F.3d 1333 (Fed. Cir. 2019). As a Federal Circuit judge candidly observed there, "Your only hope lies with the Supreme Court or Congress. I hope that they recognize the importance of these technologies, the benefits to society, and the market incentives for American business." *Id*. at 1363 (Moore, J., joined by O'Malley, Wallach, and Stoll, JJ., dissenting from the denial of the petition for rehearing en banc).

---

[2] GreyB Services, https://www.greyb.com/post-alice-patent-cases-surviving-101-rejection/ (viewed July 6, 2023).

[3] *Id*.

"I grow more concerned with each passing decision that we are, piece by piece, allowing the judicial exception to patent eligibility to 'swallow all of patent law.'" *Am. Axle & Mfg. v. Neapco Holdings LLC*, 966 F.3d 1347, 1365 (Fed. Cir. 2020) (Stoll, J., joined by Newman, Moore, O'Malley, and Reyna, JJ., dissenting) (quoting *Alice*, 573 U.S. at 217, and *citing Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70-73 (2012) ("*Mayo*")).

"What hath God wrought" – this was the famous first message communicated by Morse code on a telegraph line stretching from Washington to Baltimore, in 1844.[4] *See* John M. Harris, "What Hath God Wrought?" Tippecanoe County Historical Association.[5] Samuel Morse received a patent for his invention, but the government declined to purchase it because many mistakenly felt it was merely a useless toy of science. *Id*.

Today inventors are observing, "What hath *Alice* wrought!" The application by lower courts of the *Alice* test has departed far from the text of 35 U.S.C. § 101 ("§ 101"), in service of a judicially created test about abstractness that is mostly in the eye of the beholder. The malleable *Alice* test requires an inquiry into the character and focus of the patent claims to determine if they are directed to an abstract idea, or other patent ineligible matter. If so, then *Alice* step two requires a

---

[4] This immortal phrase is from the Bible, Numbers 23:23 (KJV).

[5] https://tippecanoehistory.org/finding-aids/what-hath-god wrought/ (viewed Aug. 2, 2022).

consideration of "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." *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78-79). Lower courts are unfortunately using the *Alice* test to invalidate patents – and the USPTO to withhold their issuance – before genuine factual inquiries into their novelty and non-obviousness (hence their value to society) are even performed.

The Petition concerns a novel technology that gives disabled people help they deserve, by locating persons eligible for disability benefits who might otherwise fall through society's cracks through failure to claim them. It presents a pristine vehicle for review by this Court. A government agency rejected a patent application, whereby at every stage, government-supplied reasons for its *Alice* rejection constantly shifted and morphed. The Petition offers a straightforward opportunity for this Court to end the confusion wrought by its *Alice* test, and to restore broad patent eligibility that would spur much-needed innovation in the future.

ARGUMENT

The engine of American prosperity is innovation, which depends for its protection on broad patent eligibility. It is time to revisit what the judicial rewriting of patent eligibility has caused, and to restore the wide eligibility for patents that turbocharged our Nation's

prosperity for two centuries. Interpreting the Patent Act should begin and end with its words – and those words lack any hint about judicial exceptions to the eligibility inquiry. "If the words of a statute are unambiguous, this first step of the interpretive inquiry is our last." *Rotkiske v. Klemm*, 140 S. Ct. 355, 360 (2019) (unanimous).

I. The Petition Should Be Granted to Adopt a Textualist Interpretation of the Statute, and End the Judicially Created Exceptions to Patent Eligibility.

A textualist interpretation of the statute for patent eligibility, 35 U.S.C. § 101, permits no implied exception to patent eligibility. The applicable statute is simply as follows:

> 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 [35 U.S.C. §§ 1 et seq.].

35 U.S.C. § 101. This statutory scope is expressly broad, plainly covering any "process" as well as any "machine, manufacture, or composition of matter." *Id*. Its legislative history underscored the purpose of § 101 as a wide-open entry point to the patent system – qualified solely by meeting the "conditions and requirements of this title." *See* H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952) ("A person may have 'invented' a

machine or a manufacture, which may include anything under the sun that is made by man, but it is not necessarily patentable under section 101 unless the conditions of the title are fulfilled."). Those "conditions," in turn, expressly and solely refer to 35 U.S.C. §§ 102 and 103 – respectively entitled: "Conditions for patentability; novelty" and "Conditions for patentability; non-obvious subject matter." Meanwhile, 35 U.S.C. § 101 is simply entitled, "Inventions patentable" – implying strongly that it contains no "conditions" of its own.

There is nothing in this statute that excludes an invention or discovery merely because it is "abstract," which is chameleon-like in its ability to justify invalidating many valuable inventions. With already-extant *textual* exceptions (*i.e.*, excluding subject matter that fails "conditions and requirements of this title"), precedent supplies no room for *judicial* exceptions. "When Congress provides exceptions in a statute, it does not follow that courts have authority to create others. The proper inference, and the one we adopt here, is that Congress considered the issue of exceptions and, in the end, limited the statute to the ones set forth." *United States v. Johnson*, 529 U.S. 53, 58 (2000) (unanimous). The judicially created exception to patent eligibility, based on whether something might be deemed as "abstract," began as harmlessly limited suggestion but has turned into a raging fire in lower courts that is destroying much that was good about our patent system.

Patent eligibility should be an undemanding threshold test that is easily surmountable except in

the rarest of situations. When an invention satisfies the more demanding tests of enablement, definiteness, novelty and nonobviousness, then it is often counterproductive and contrary to the statute to declare such an invention patent ineligible. It would be like trying to resolve nearly every lawsuit on the grounds of standing, and folding more substantive issues back into that threshold issue. The contortion of the patent eligibility statute places the cart before the horse, with a dysfunctional result.

Textualism is useful across many fields of law, and absolutely essential in patent law. Courts are not suited for crafting policy exceptions to patent eligibility. Courts operate without the benefit of congressional hearings, public commentary, and feedback by inventors. When there is a valid reason for rejecting a patent, it can be better stricken based on its obviousness or lack of novelty, rather than philosophical musings about abstractness. Congress did not enact a high bar against patent eligibility, and this Court should not cling to one. Restoring broad patent eligibility as enacted by Congress is overdue, as abstractness is not even mentioned in the statute. "Bad" patents will still get weeded out as they always have, through application of traditional "conditions and requirements" baked into the Patent Act – enablement, definiteness, novelty and nonobviousness.

II. Judicially Created Exceptions Impose Limitations and Conditions onto § 101 Never Sought by Congress.

Prior to the embrace by this Court in *Alice* of patent eligibility as an immense impediment to patentability, "Rule 12(b)(6) dismissal for lack of eligible subject matter [was] the exception, not the rule." *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, 1339 (Fed. Cir. 2013). *Alice* and its progeny changed that by modifying § 101 and ignoring the words of then-Associate Justice Rehnquist who said: "[w]e have more than once cautioned that courts should not read into the patent laws limitations and conditions which the legislature has not expressed." *Diamond v. Diehr*, 450 U.S. 175, 182 (1981) (internal citations and quotation marks omitted). The outer limit of those exceptions is a question of policy which belongs solely to Congress.

Despite Justice Rehnquist's admonition, at least four Court decisions concerning patent subject matter eligibility have read limitations and conditions into § 101 that were not expressed by Congress, *i.e.*, the judicially created exceptions. *See Alice, Bilski, Mayo,* and *Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576 (2013). These cases confirm that exceptions to § 101 were made by the courts and not by Congress. However, a court "cannot rewrite a statute to be what it is not. [A]lthough this Court will often strain to construe legislation so as to save it from constitutional attack, it must not and will not carry this to the point of perverting the purpose of a statute . . . *or judicially rewriting it.*" *Nat'l Fed'n of Indep. Bus. v.*

Sebelius, 567 U.S. 519, 662 (2012) ("*NFIB*") (Joint Opinion of Scalia, Kennedy, Thomas, and Alito, JJ., dissenting) (internal citations and quotation marks omitted, emphasis added). In short, these court decisions have increasingly assumed the legislative function. This *Alice* line of cases has destabilized patent subject matter eligibility jurisprudence to such an extent that it takes the United States Patent and Trademark Office more than 50 pages to discuss judicial exceptions to patent subject matter eligibility in Section 2106 of the Manual of Patent Examination Procedure.[6] "Judicial exception" is mentioned there 290 times, an astounding amount for something nonexistent under a textualist approach.[7]

Paul R. Michel, the former Chief Judge of the United States Court of Appeals for the Federal Circuit has criticized the *Alice* line of cases. "These exclusions exist because the Court said so." The State of Patent Eligibility in America, Part I: Hearing Before the Subcomm. on Intellectual Property of the S. Comm. on the Judiciary, 116th Cong. (June 4, 2019) (testimony of Hon. Paul R. Michel (Ret.), United States Court of Appeals for the Federal Circuit). "No statutory term [was] interpreted in [those] decisions. Nor was any of the Constitution's language being construed." *Id*. In Judge Michel's view, those cases, as well as Federal Circuit cases, "are unclear, inconsistent with one another and confusing." *Id*. He further indicated that over the last

---

[6] https://www.uspto.gov/web/offices/pac/mpep/s2106.html (viewed July 6, 2023).

[7] *Id*.

few years, the increasing reliance on judicially created exceptions has led to chaos for all stakeholders including inventors, investors, and others. "Massive uncertainty pervades all determinations, whether by 8,300 patent examiners, 1,000 federal trial judges, or 18 Federal Circuit judges." *Id*. at 6. Numerous decisions by the Federal Circuit and district courts have expressly acknowledged the "uncertainty associated with the Supreme Court's patent-eligibility rulings." *Id*.

Thomas Edison did not face the judicially created barrier of patent eligibility when he obtained his then record 1,093 patents. While most of Edison's patents did not increase wealth, several of them did in phenomenal ways. As a result, by the time he was in his 30s, Edison was the best-known American in the entire world. Edison would likely have been baffled by a judicially created impediment to patent eligibility, and frustrated by it. That might have caused him to pursue other interests, thereby depriving the world of his inventions.

Rejecting innovation on the basis of a lack of patent eligibility is fraught with risks of failure to encourage beneficial innovations in the future, and does not reduce mischief allegedly caused by clever patent abusers. From 2012 to 2016 the United States was ranked number 1 in the world for our patent system,

but in 2017 fell to 10th place and in 2018 declined to 12th place in the strength of our system.[8]

The loss in the vitality of our patent system has corresponded with economic decline in the United States. Beginning the year after *Alice* was decided, real wages in the United States have grown by less than 1% per year.[9] During that same period government spending and the national debt have nearly doubled, such that average real wages adjusted for the increase in debt has decreased. Without incentivizing new inventions to lift our economy, a downward spiral in the United States in real wages adjusted for debt looms. In contrast, between 1869 and 1891 while inventions were encouraged by our then-strong patent system from the likes of Thomas Edison and Alexander Graham Bell, real wages for manufacturing jobs increased from 21.9 to 28.9 cents per hour,[10] an increase of 32% that surpassed the wages available in economically similar England and the remainder of Europe.[11]

---

[8] Lewis M. Rambo, Ph.D., Blog (June 7, 2022) https://lmrambo.com/2022/06/07/thomas-edison-couldnt-get-a-patent-today-and-heres-why/ (viewed July 6, 2023).

[9] St. Louis Federal Reserve, https://fred.stlouisfed.org/series/LES1252881600Q (viewed July 6, 2023).

[10] 93 Cong. Rec. A3455 (1947).

[11] David Khoudour-Casteras, "Exchange Rate Regimes and Labor Mobility: The Key Role of International Migration in the Adjustment Process of the Classical Gold Standard," ResearchGate (July 5, 2015) https://www.researchgate.net/publication/242155098_Exchange_Rate_Regimes_and_Labor_Mobility_The_Key_Role_of_International_Migration_in_the_Adjustment_Process_of_the_Classical_Gold_Standard (viewed July 6, 2023).

III. The Judicial Narrowing of Patent Eligibility Is Contrary to the Constitution, Further Warranting a Grant of the Petition.

The drafters of the Constitution considered and three times rejected a proposal that would have allowed members of the judiciary to participate in the legislative process as part of a "Council of Revision." *See generally* Note, James T. Barry, III, The Council of Revision and the Limits of Judicial Power, 56 Univ. Chi. L. Rev. 235, 257 (1989). *See also NFIB*, 567 U.S. at 692 (Opinion of Scalia, Kennedy, Alito, and Thomas, JJ., dissenting) ("The Judiciary, if it orders uncritical severance, then assumes the legislative function; for it imposes on the Nation, by the Court's own decree, its own new statutory regime, consisting of policies, risks and duties that Congress did not enact.").

The initial clause of the Constitution, U.S. CONST. art. I, § 1 (the "Bicameral Clause"), must be read in conjunction with the Patent Clause, id. art. I, § 8, cl. 8. Together they prohibit courts from absconding with any legislative power. Judicial legislation is not permitted as it would derail the Constitution's procedural and substantive constraints that are designed to limit the legislative power of the federal government and its component branches.

Amici suggest that the judicially created exceptions to patent subject matter eligibility amount to "judicial legislation" and thereby operate outside both Article I and Article III. The Supreme Court has unequivocally stated: "the powers of Congress to legislate upon

the subject of patents is plenary by the terms of the Constitution. . . ." *McClurg v. Kingsland*, 42 U.S. (1 How.) 202, 206 (1843). This is clear from the Patent Clause which provides: "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. . . ." U.S. CONST. art. I, § 8, cl. 8. From the beginning of our Nation, Congress has exercised this power. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996).

Because Congress defined the scope of patentable subject matter eligibility in § 101, its express terms should have ended the judicial inquiry. The courts should have looked no further. *See* Amy Coney Barrett, Substantive Canons and Faithful Agency, 90 B.U. L. Rev. 109, 116 (2010) ("[T]he principle of legislative supremacy restrains federal courts from expanding and contracting unambiguous statutes. . . ."); Neil M. Gorsuch, A Republic, If You Can Keep It 50 (2020) ("[J]udges should be in the business of declaring what the law *is* . . . rather than pronouncing the law as they might wish it to be. . . .") (emphasis in original); *Connecticut National Bank v. Germain*, 503 U.S. 249, 254 (1991) ("When the words of a statute are unambiguous . . . judicial inquiry is complete.") (internal quotation marks omitted).

Reduced to its most fundamental level, this case is about the allocation of powers between and among the branches. It is not about what the law "ought to be" or "should be." It is about what the law "is." *Marbury v.*

Madison, 5 U.S. (1 Cranch) 137, 177 (1803) ("It is emphatically the province and duty of the judicial department to say what the law is.").

No court should create or apply a judicial exception to patent subject matter eligibility because the Judiciary should be prohibited from exercising legislative power in defiance of the Bicameral and Presentment Clauses. *See INS v. Chadha*, 462 U.S. 919, 951 (1983); *Clinton v. City of New York*, 524 U.S. 417, 439-40 (1998); *Metro. Wash. Airports Auth. v. Citizens for Abatement of Aircraft Noise*, 501 U.S. 252, 276 (1991) ("*MWAA*"). Those two clauses spell out the processes by which the two houses of Congress bring their diffused power to bear on federal lawmaking. In essence, the Court is "not at liberty to rewrite the statute passed by Congress and signed by the President." *Henry Schein, Inc. v. Archer & White Sales, Inc.*, 139 S. Ct. 524, 528 (2019) (unanimous). The Court should interpret § 101 as written, and "not engraft [its] own exceptions onto the statutory text." *Id*. at 530.

The power to "amend" an existing law is a legislative power, which the Constitution vests solely in Congress. *See Clinton*, 524 U.S. at 438; *Chadha*, 462 U.S. at 954; *see also MWAA*, 501 U.S. at 276 ("[W]hen Congress '[takes] action that ha[s] the purpose and effect of altering the legal rights, duties, and relations of persons . . . outside the Legislative Branch,' it must take that action by the procedures authorized in the Constitution.") (internal citation omitted).

CONCLUSION

For the foregoing reasons and those stated in the Petition, this Court should grant the Petition for a Writ of Certiorari.

Respectfully submitted,

ROBERT GREENSPOON
Counsel of Record
DUNLAP BENNETT & LUDWIG
333 N. Michigan Avenue,
Suite 2700
Chicago, IL 60601
(312) 551-9500
rgreenspoon@dbllawyers.com

ANDREW L. SCHLAFLY
939 Old Chester Road
Far Hills, NJ 07931
(908) 719-8608
aschlafly@aol.com