No. 24-827

In The
Supreme Court of the United States

BROADBAND ITV, INC.,

Petitioner,

v.

AMAZON.COM, INC., ET AL.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

A patent claim is invalid under § 101 if it is directed to ineligible subject matter and fails to recite an inventive concept. *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014). While the § 101 inquiry "may be based on underlying factual findings," such as whether a patent claim recites only well-understood, routine, conventional limitations that carry out an abstract idea, *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018), subject matter eligibility under § 101 may be resolved on summary judgment so long as there is not a genuine dispute of material fact, *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018).

Here, the Federal Circuit affirmed the district court's grant of summary judgment that BBiTV's patents are invalid under § 101 because they are directed to unpatentable subject matter, based in part on its determination that the record contained admissions by BBiTV concerning the well-understood, routine, and conventional nature of the claim limitations.

The question presented is:

(1) Whether the Federal Circuit erred in affirming summary judgment of invalidity where it determined that the record contained no genuine dispute of material facts.

CORPORATE DISCLOSURE STATEMENT

In accordance with United States Supreme Court Rule 29.6, Respondents make the following disclosures:

Amazon.com, Inc. has no parent corporation and no publicly held corporation is known to own 10% or more of its stock.

Amazon.com Services LLC is a wholly owned subsidiary of Amazon.com, Inc.

Amazon Web Services, Inc. is a wholly owned subsidiary of Amazon.com, Inc.

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INTRODUCTION

This case does not merit review, nor is it necessary to hold the petition pending the outcome of others currently before the Court.

The Federal Circuit has never adopted, nor did it apply in this case, any "patent-specific exception to Rule 56 that permits summary judgment despite genuine factual disputes." Pet. at 3-4. Instead, it affirmed a summary judgment ruling applying the usual legal standard and determining that there were no such disputes. BBiTV's characterization of the record as "hotly disputed" does not transform this ruling into a break with precedent. Instead, it reveals that BBiTV's petition argues a naked claim of error particular to the evidence in this case. The Court does not review such questions, but, even if it did, the Federal Circuit opinion reflects no error in any event.

BBiTV thus makes no meaningful argument in favor of a grant. Instead, it asks the Court merely to hold the petition pending consideration of *Island Intellectual Property LLC v. TD Ameritrade, Inc.*, No 24-461. Pet. at (i). But that extra step is unnecessary at best. The petitions in both *Island IP* and *ParkerVision, Inc., v. TCL Industries Holdings Co.*, No 24-518, challenge the Federal Circuit's practice of summarily affirming judgments without a written opinion. That practice is not at issue in

this case, since here the Circuit issued a lengthy reasoned opinion explaining the basis of its ruling. And while *Island IP* additionally seeks review of a summary judgment ruling under § 101, that issue is equally record-bound and thus unrelated. *See* No. 24-461, Br. for Resp'ts at (i) (framing § 101 question presented in *Island IP* as "[w]hether patent claims drawn to managing funds held in aggregated accounts are ineligible under 35 U.S.C. § 101.")

The Court previously denied a petition from this same petitioner, BBiTV, requesting review of the same question presented, and concerning the § 101 invalidity of a patent from the same family. *Broadband iTV, Inc. v. Hawaiian Telcom, Inc.*, 581 U.S. 1000 (2017). The Court can and should reach the same result here without delay.

STATEMENT OF THE CASE

A. BBiTV accuses Amazon of infringing patents related to video-on-demand menus.

BBiTV filed suit against Amazon in the Western District of Texas, asserting that Amazon's Prime Video services infringe five patents: U.S. Patent Nos. 10,028,026 ('026 patent); 9,648,388 ('388 patent); 10,536,750 ('750 patent); 10,536,751 ('751 patent); and 9,973,825 ('825 patent). The first four of these (the '026 patent family) are related

and claim priority to the same application. App. 2a. The '825 patent is not formally related but concerns similar subject matter. *Id.* All the patents name the same inventor, Milton Diaz. *Id.* at 29a, 35a-36a.

The patents all purport to claim improvements to electronic program guides—i.e., the menus by which a user selects programming in cable television and video-on-demand systems. *Id.* at 2a-3a, 5a. The '026 patent family describes presenting content in the guide as a "hierarchy" of categories and subcategories—such as genre and title—based on information uploaded by a third party. *Id.* at 3a-5a. A viewer may then use a conventional television remote control to "drill-down" or click through those categories to find a desired selection. *Id.* at 2a, 4a, 40a-41a.

The centerpiece of the alleged invention is a "web-based content management system" that constructs this hierarchical menu automatically based on the uploaded information. *Id* at 4a-5a, 40a. But the patents disclose no technology or programming for that hardware. *Id.* at 18a, 62a, 63a-64a. Instead, the patents describe it as a generic computer server that can perform the functions necessary to achieve the desired result. *Id.* at 18a., 62a., 63a-64a. The claims also recite using "templates" to construct the menu. *Id.* at 3a. But the patents describe these also as conventional, noting that the

reader may obtain them from a "template design firm." *Id.* at 46a.

The '825 patent instructs the reader to reorder program categories within an electronic program guide based on what a user has watched previously. *Id.* at 5a-8a. It describes tracking the user's viewing history, storing that information in a generic server, and reordering program categories in the guide at the start of a viewing session when the user logs in to the system. *Id.* at 10a, 30a, 55a-56a. But it does not disclose any new technology for performing these steps, which instead employ conventional methods. *Id.* at 22a-23a, 56a-57a.

Admissions from the inventor, Diaz, and BBiTV's technical experts confirmed that the patents do not describe any eligible technological improvements but instead recite carrying out abstract processes using conventional technology. *Id.* at 43a-47a. Relevant here:

- Diaz admitted that, at the time of his invention, the web-based content management system was available "off the market." *Id.* at 45a.

- BBiTV's expert, Dr. Smith, admitted that Diaz did not "invent the use of templates as part of creating screen displays," and that instead "templates were a known entity" at the

time of the invention. *Id.* at 46a-47a; C.A. App. 3970 (26:11-17).

- Diaz admitted that he did not invent the "hierarchical categories and subcategories" of the menu, and Dr. Smith conceded that Diaz did not invent navigating through them "in a drill down manner." App. 46a.

- Diaz admitted that "my patent doesn't specify" how to make a computer render a display using the claimed templates, and that he did not know whether or how the prior art did so. C.A. App. 4217-4220 (191:24-194:15).

Indeed, although not relied upon below, the record showed also that Diaz derived the subject matter of his patents from a third party, Navic Networks, that he had hired as a contractor to build a video-on-demand system. *E.g., id.* at 3635-3639. Navic provided Diaz with training and hundreds of pages of its proprietary technical documentation that describes what Diaz later claimed as his own invention—including both the "web-based content management system" and the use of templates to generate electronic program guides. *See id.* at 3655-3847; *id.* at 3829 (showing how BBiTV had highlighted the description of Navic's "web-based content management system" in the documentation); *id.* at 3662 (showing a "templatized display").

B. The Federal Circuit affirms the summary judgment order holding the patents ineligible under § 101.

The district court granted Amazon's motion for summary judgment that all asserted claims are ineligible for patenting under § 101. App. 8a. BBiTV appealed to the Federal Circuit. *Id.* at 2a.

A panel of the Federal Circuit affirmed in a unanimous written opinion. *Id.* at 1a-23a. The panel reviewed the district court's summary judgment order *de novo* under Fifth Circuit law.[1] *Id.* at 10a. It noted that Rule 56 requires the district court to grant summary judgment when, "viewing all evidence in the light most favorable to the nonmovant, there is no genuine dispute of material fact and the moving party is entitled to judgment as a matter of law." *Id.* (citing *Triple Tee Golf, Inc. v. Nike, Inc.*, 485 F.3d 253, 261 (5th Cir. 2007)).

The Federal Circuit then applied this Court's *Alice* test to assess the patentability of BBiTV's patent claims. That test requires first that the court determine whether claims are "directed to" a judicial exception to patent eligibility, such as an abstract idea. If so, the court proceeds to the second step of the test, which asks whether the individual

[1] The Federal Circuit applies the law of the regional circuit where the district court sits for procedural issues. *Crocs, Inc. v. Effervescent, Inc.*, 119 F.4th 1, 3 (Fed. Cir. 2024).

claim elements add an "inventive concept" sufficient to transform the claim into "significantly more" than the abstract idea. *Id.* at 11a. While a question of law, this § 101 inquiry "may be based on underlying factual findings," *id.* at 10a (citing *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018)), that concern whether a claim recites only conventional limitations at the second step of the test, *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 73 (2012). The panel also recognized that § 101 disputes "may be resolved on summary judgment so long as there is not a genuine dispute of material fact." App. 10a (citing *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018)).

The Federal Circuit held at *Alice* Step 1 that BBiTV's patent claims are directed to abstract ideas. It determined that the '026 patent family is directed to the abstract idea of "receiving hierarchical information and organizing the display of video content." *Id.* at 12a, 59a. And that the '825 patent is directed to the "abstract idea of collecting and using a viewer's video history to suggest categories of video content." *Id.* at 21a, 49a. BBiTV's petition takes no issue with these determinations.

The Federal Circuit then held at *Alice* Step 2 that BBiTV's patent claims do not impart an inventive concept. As to the '026 patent family, the Federal Circuit rejected the argument that there

were material fact disputes concerning whether the "web-based content management system" or "templates" recited in the claims were inventive or conventional. *Id.* at 18a-19a. The panel pointed out that the record supported the district court's conclusion that the "web-based content management system" is a "conventional server" because the patents themselves do not assert that it provides any improvement in server technology and describe it as performing routine server functions. *Id.* at 18a. That, combined with the inventor Diaz's own admission that it could be bought "off the market," led it to conclude that BBiTV failed to show there was any genuine dispute of material fact. *Id.*[2] Diaz's

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[2] The Federal Circuit previously affirmed a different district court's determination that the same "web-based content management system" limitation referred to a generic server. *Broadband iTV, Inc. v. Oceanic Time Warner Cable, LLC*, 135 F. Supp. 3d 1175, 1193 (D. Haw. 2015), *aff'd sub nom. Broadband iTV, Inc. v. Hawaiian Telcom, Inc.*, 669 F. App'x 555 (Fed. Cir. 2016) (per curiam). That case involved BBiTV's U.S. Patent No. 7,631,336 (the '336 patent), which is related to the '026 patent family and recites a "web-based content management server." *Oceanic*, 135 F. Supp. 3d at 1177, 1183. The district court in that case held that the claims of '336 patent were invalid under § 101, including because the web-based content management system merely performs routine server functions—"data collection, recognition, and storage" that are "'undisputedly well-known' functions for servers." *Id.* at 1193. The district court declined to collaterally estop BBiTV from contesting the unpatentability of the '026 patent family's claim based on the prior invalidity ruling but noted

alleged efforts to program such an "off the market" server he purchased, Pet. at 8, was and is irrelevant to the court's analysis, because none of those programming details are described in the patents or recited in their claims.

The panel came to the same conclusion about the patents' instruction to use "templates" to create the program guide. App. 18a-19a. That was because the patents instruct the reader to use known templates from a "template design firm," and BBiTV's expert admitted that such templates "were a known entity" at the time of the invention. *Id.* at 19a (citations omitted).

As to the '825 patent, the Federal Circuit rejected BBiTV's argument that reciting a generic step requiring a user to "log in" to the system was unconventional and inventive. That was because the patent described no specific log-in technology or improvement thereto. *Id.* at 19a, 22a-23a. Indeed, according to the patent specification, the log in step could be any process that identifies a user implemented in any way. *Id.* at 22a-23a (citing C.A. App. 93 (3:30-35)). And while BBiTV had also argued that reordering the category listing in the menu upon login was an inventive concept, the court correctly held that was not new technology, but rather

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that prior district court order was "very persuasive authority." App. 49a.

a mere restatement of the abstract idea, insufficient as a matter of law to transform the claim into "something more than the abstract idea itself." *Id.* at 22a.

REASONS FOR DENYING THE PETITION

I. BBiTV's Question Presented Lacks Merit.

The petition rests on the premise that the Federal Circuit has adopted a patent-specific rule concerning summary judgment that deviates from Rule 56. That premise is incorrect, as that court has done no such thing in this case or any other. Thus, the petition should be denied.

In this case, the Federal Circuit panel reviewed the summary judgment ruling *de novo* and determined that the district court had concluded correctly that no material factual disputes preclude summary judgment. *Id.* at 16a-19a; *id.* at 21a-23a. The court did not purport to announce any "exception" to Rule 56. Instead, it expressly applied the usual rule, agreeing with the district court that the record revealed "no genuine dispute of material fact that preclude[d] summary judgment." *Id.* at 18a, 22a.

To be sure, that ruling rested in part on admissions by BBiTV that the claim limitations it pressed as inventive and eligible for patenting un-

der § 101 were instead conventional and non-inventive. *Id*. at 18a, 22a. But relying on such party admissions is entirely consistent with Rule 56. *See* Fed. R. Civ. P. 56(c)(1)(A) ("A party asserting that a fact cannot be [] genuinely disputed must support the assertion by: (A) citing to particular parts of materials in the record, including … admissions ….''). And here again, that reliance is express in the Federal Circuit's decision: it notes that the district court's ruling rested on "the intrinsic record and BBiTV's fact and expert testimony regarding the nature of certain features of the claims." App. 17a. BBiTV's petition identifies no actual rule of law that the Federal Circuit adopted that contradicts the normal Rule 56 standards.

Thus, BBiTV's petition evidences only its disagreement with two federal courts' application of law to the facts of the case. But such a petition—one where "the asserted error consists of erroneous factual findings or the misapplication of a properly stated rule of law"—is "rarely granted." Supreme Court Rule 10; *United States v. Johnston*, 268 U.S. 220, 227 (1925) ("We do not grant a certiorari to review evidence and discuss specific facts."). That is particularly so where, as here, the petitioner has not argued that the particular result in its case itself raises a question of importance. Nor can BBiTV show otherwise in reply. The patents here concern long outdated cable television and video-on-demand systems, and the legal claims asserted

affect only private commercial interests. Moreover, BBiTV presented the identical question to the Court eight years ago, arguing that the Federal Circuit made the same error in affirming the invalidation of a patent from the same family on the same grounds. The Court denied that petition, *Broadband iTV, Inc. v. Hawaiian Telcom, Inc.*, 581 U.S. 1000 (2017), and it should treat BBiTV's latest petition no differently.

Even if this Court viewed its purpose as error correction, BBiTV's petition has shown no error by the Federal Circuit. While BBiTV characterizes the record as containing factual questions that were "hotly disputed," Pet. at 5, none of the purported fact disputes was material to the eligibility of the patents.

First, BBiTV contends that its expert's testimony raised triable issues concerning whether the "web-based content management system" or the use of "templates" described by the '026 patent family were conventional. Pet. at 6, 8. But the lower courts correctly concluded that the record showed no genuine dispute on those points. The patents describe the web-based content management system as a generic server, App. 18a, 62a, 63a-64a, and Diaz confirmed as much by testifying he bought it "off the market," *id.* at 45a.

BBiTV contends that the Circuit's ruling conflates the server hardware with the software application that runs on that server. Pet. at 8. It points to Diaz's testimony—that he programmed such a web server application—as purported evidence of an inventive concept. But this testimony is immaterial "because these [programming] details are not recited in the actual claims." *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1242 (Fed. Cir. 2016). Indeed, by focusing on the application Diaz alleges he programmed for a commercial system, rather than the server he described and claimed in his patent application, BBiTV only highlights its eligibility problem. The patents claim the results of an abstract process rather than any technology capable of achieving them.

BBiTV argues that the Federal Circuit failed to address "the particular three-layer template in many of the claims." Pet. at 8. But the admissions of record showed that the claimed templates "were a known entity" available from "template design firm[s]" and were thus conventional at the time of the invention. App. 46a-47a. Further, the claimed use of templates in the patents is merely to organize the information uploaded from the third-party content provider for display. Such a command to use templates or layers to organize information does not itself impart any new technological advance. *See IBM v. Zillow Grp., Inc.*, 50 F.4th 1371, 1381 (Fed. Cir. 2022). Finally, BBiTV never argued

to the district court that the use of three template layers made eligible the '026 patent claims that recited them. *See* Amazon.C.A.Br. 51-52. Instead BBiTV argued about use of templates generally throughout the '026 patent family. As such, even if BBiTV's contentions had merit, this issue would not warrant granting the petition because of BBiTV's forfeiture.

Second, BBiTV similarly contends that there was a dispute of material fact regarding whether the '825 patent's description of a user logging in and viewing a reordered program guide was conventional. Pet. at 6-7, 8. But the patent discloses no technology for this process. Instead, it instructs the reader to use any conventional login process, and it states only that the system should reorder categories based on "actual viewing habits," without describing any way to implement that aspirational goal on a computer. App. 22a-23a, 30a. The panel thus ruled correctly that BBiTV's argument did not preclude summary judgment because it did not identify any new technology but merely restated the same ineligible abstract idea to which the claim is directed. *Id.* at 22a.

II. The Court Need Not Hold BBiTV's Petition.

Holding BBiTV's petition pending resolution of *Island IP* is unnecessary. *Island IP* presents a separate and independent challenge to the Federal

Circuit's practice of summarily affirming judgments without issuing an accompanying reasoned opinion. The Court has regularly turned away similar challenges,[3] but did call for a response to one such petition recently in *Parkervision*. *See* No. 24-518, Response Requested Dec. 16, 2024. Setting aside the unlikelihood that the Court grants review, there is no reason to allow BBiTV's petition to linger while the Court assesses that issue. The Federal Circuit did not summarily affirm here but rather provided BBiTV a unanimous, precedential opinion explaining its reasoning. BBiTV's petition thus has nothing to do with the principal question under consideration in those other petitions.

Moreover, the Court should not hold BBiTV's petition just because the *Island IP* petition included an additional question presented concerning § 101. That question arises from the Federal Circuit's judgment that certain patents related to

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[3] *See* Memorandum Cases, *Schwendimann v. Neenah, Inc.*, 144 S. Ct. 2579 (2024); *Ameranth, Inc. v. Olo Inc.*, 142 S. Ct. 2814 (2022); *Ultratec, Inc. v. CaptionCall, LLC*, 142 S. Ct. 460 (2021); *Bobcar Media, LLC v. Aardvark Event Logistics, Inc.*, 142 S. Ct. 235 (2021); *Kaneka Corp. v. Xiamen Kingdomway Grp. Co.*, 140 S. Ct. 2768 (2020); *Chestnut Hill Sound Inc. v. Apple Inc.*, 140 S. Ct. 850 (2020); *Power Analytics Corp. v. Operation Tech., Inc.*, 140 S. Ct. 910 (2020); *Straight Path IP Grp., LLC v. Apple Inc.*, 140 S. Ct. 520 (2019); *Senju Pharm. Co. v. Akorn, Inc.*, 140 S. Ct. 116 (2019); *Capella Photonics, Inc. v. Cisco Sys., Inc.*, 586 U.S. 988 (2018).

"managing funds held in aggregated accounts" are ineligible under § 101. No. 24-461, Br. for Resp'ts at (i). The petitioner asserts that the evidence it presented to the district court raised a triable issue of fact as to whether the "use of interest allocation procedures to provide, on a non-pro rata basis, interest to customers whose funds are held in aggregated accounts for an enhanced insured product ... was unconventional, non-routine and inventive at the time of the invention." No. 24-461, Pet. at 6. That issue is bound entirely to the record in that case and is unrelated to any issue presented by BBiTV.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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