

No. 18-1199

In the
Supreme Court of the United States

INVESTPIC, LLC,

Petitioner,

v.

SAP AMERICA, INC.,

Respondent.

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

**Amicus Brief of Mario Villena and Jose Villena
in Support of Investpic**

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Question Presented

This case raises a fundamental issue concerning patent eligibility under Section 101 of the Patent Act given that preemption has been the *only* recognized basis for an exception to patent eligibility for over two-hundred years. The issue *Amici* raises before the Court in this case is:

Does a requirement of “inventive concept” and “physical realm improvement” under the *Alice/Mayo* framework violate the statutory language of Title 35 U.S.C. § 101, legislative intent, and the Supreme Court’s edict of *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014) that preemption is the sole criteria for determining exceptions to patent eligibility?

In addition, *Amici* ask the additional question

Is Title 35 U.S.C. § 101 the appropriate section of the Patent Law to address functional claiming, or is Title 35 U.S.C. § 112?

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I. Identity and Interests of *Amici Curiae*, and Motion for Leave to File

The *Amici Curiae* Mario Villena and Jose Villena are inventors and businessmen. *Amici Curiae* promote policies that foster innovation, growth and a competitive marketplace for innovation, such as protection of software and other related technologies. *Amici Curiae* have a strong stake in the proper functioning of a predictable U.S. patent system. *Amici Curiae* also have a particularly strong interest in the development of appropriate standards for evaluating the patent-eligibility standards for patents pursuant to 35 U.S.C. § 101. Accordingly, *Amici Curiae* respectfully urge the Court to grant leave to file the present Brief, to grant Investpic's Petition and to reverse the decision below. *Amici Curiae* have no stake in the parties or in the outcome of the case beyond the deleterious effects of the instant Decision.¹

¹ No party's counsel authored this brief in whole or part; no party or party's counsel contributed money intended to fund preparing or submitting the brief. No person other than the *Amici Curiae* or its counsel made a monetary contribution to its preparation or submission.

Amici Curiae provided notice to both parties on April 3, 2019, of intent to file on behalf of Petitioner Investpic. Petitioner and Respondent have both granted blanket permission to file an amicus brief.

II. The Statutory Regime Enacted by Congress Is the Sole Legal Authority for Determining the Requirements of Patent Eligibility

Article I, Section 8, of the United States Constitution states “*Congress* shall have power . . . to promote the progress of science and useful arts” (emphasis added).

To this end, *Congress* enacted the 1952 Patent Act.

Three significant changes made to the patent laws by the 1952 Patent Act were: (1) to codify the holding of *Hotchkiss v. Greenwood*, 11 How. 250 (1850), so as to define patentability in terms of nonobviousness under 35 U.S.C. § 103 (*Graham v. John Deere Co.*, 383 U.S. 1, 2 (1966)); (2) to remove “invention” as a prerequisite to patentability (*Id.*); and (3) to replace the word “act” under then 35 U.S.C. § 31 with “process” under § 101 while defining the word “process” in § 100(b).

Section 101 states: “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 . . .” (emphasis added).

Relevant to the word “process,” Congress defined the word in § 100(b) as follows: “The term ‘process’ means process art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.”

While it is fully within the courts’ powers to interpret statutes, it is *not* within the courts’ powers to de facto rewrite a single word of the statutory patent laws, or to replace congressional intent with

biases that the courts feel better suited to patent law. That is, it is *not* within the constitutional powers of the courts to place a single additional burden on patentability that Congress did not sanction by its statutory scheme.

As to the meaning of individual words, “[s]tatutory definitions control the meaning of statutory words.” *Lawson v. Suwannee Fruit & S. S. Co.*, 336 U.S. 198, 201 (1949). See also *Stenberg v. Carhart*, 530 U.S. 914, 942 (2000) (“When a statute includes an explicit definition, we must follow that definition[.]”). As to the meaning of individual words that are not defined by statute, this Court declared that such “words will be interpreted as taking their ordinary, contemporary, common meaning.” *Bilski v. Kappos*, 561 U.S. 593, 594 (2010); *Diamond v. Diehr*, 450 U.S. 175, 182 (1981).

III. The Statutory Regime Enacted by Congress Does Not Support The Federal Circuit’s Categorical Rules Denying Patent Eligibility

Using the above-discussed principles of claim construction, the Supreme Court correctly held that there is no “ordinary, contemporary, common meaning of ‘process’ that would require [a process] to be tied to a machine or the transformation of an article.” *Bilski*, 561 U.S. at p. 594.

Just as evident from the statutory language of § 100(b) and § 101, it is facially apparent that there is no ordinary, contemporary, common meaning of ‘process’ that requires a process to be tied to “physical realm improvement” or an “inventive concept.”

For quite a while, the Federal Circuit erroneously interpreted patent eligibility as requiring some form of improvement. See, e.g., *McRo, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016) (“We therefore look to whether the claims in these patents ***focus on a specific means or method that improves the relevant technology***[.]” (emphasis added)); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016) (“Therefore, we find it relevant to ask ***whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea***[.]”).

Now, the Federal Circuit one-ups the extra-statutory “improvement” requirement to be a “physical realm improvement.” To wit, the Federal Circuit declared:

“Similarly, in *Thales Visionix Inc. v. United States* the improvement was in a physical tracking system. The use of mathematics to achieve an improvement no more changed the conclusion that improved physical things and actions were the subject of the claimed advance than it did in *Diamond v. Diehr*. Here, in contrast, ***the focus of the claims is not a physical-realm improvement*** but an improvement in wholly abstract ideas—the selection and mathematical analysis of information, followed by reporting or display of the results.” (internal citations omitted) (emphasis added) Pet.App. 14a.

Clearly, every year since *Alice Corp.* was decided, the Federal Circuit’s ever more bizarre categorical

rules and outlandish theories continue to warp 35 U.S.C. § 101.

As this case demonstrates it is the Federal Circuit's belief that a claim must provide not just an improvement, but a physical realm inventive concept sort of improvement that must be "the focus of the claims," or the claim is abstract. However, this is a *de facto* rewrite of § 101 from its present state:

"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 . . ." – 35 U.S.C. § 101,

to:

"Whoever invents or discovers any new and useful improvement of a physical realm process, machine, manufacture, or composition of matter that incorporates an inventive concept may obtain a patent therefor. . ." – Investpic 101.

The Federal Circuit often quotes § 101, but apparently never reads it. The Federal Circuit is not entitled to take the simple and clear text of § 101 and remove half its language while adding new requirements.

As was recently observed by this Court in *Henry Schein, Inc. v. Archer and White Sales, Inc.*, No. 17-1272, 586 U.S. _____, slip. op. at. pp. 4, 8 (2019), it is improper for the courts to embed "wholly groundless" exceptions inconsistent with statutory language and this Court's precedent. "[W]e may not rewrite the statute simply to accommodate that policy concern."

Id. at p. 8. While preemption may or may not be a valid policy concern to the exceptions to § 101, “physical realm improvement” and “invention,” are certainly not valid policy concerns.

IV. The Supreme Court Clearly Contemplated Non-Tangible Subject Matter (Improvement or Not) As Patent-Eligible

The Federal Circuit’s “physical realm” position cannot be reconciled with 35 U.S.C. §101 and it cannot be reconciled with *Bilski v. Kappos*, 561 U.S. 593 (2010).

As the Supreme Court stated in *Bilski*, 561 U.S. at 605 “the machine-or-transformation test would create uncertainty *as to the patentability of software*, advanced diagnostic medicine techniques, and inventions based on linear programming, *data compression*, and *the manipulation of digital signals*” (emphasis added).

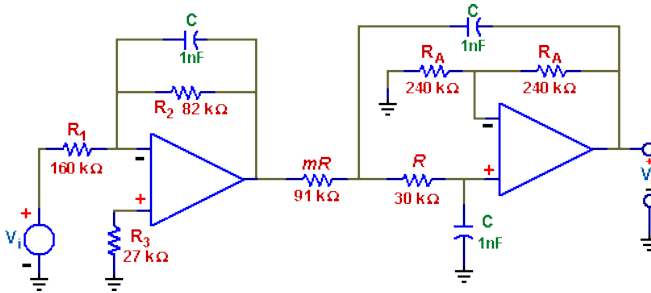
Clearly, the Supreme Court contemplated that software patents, data compression, and the manipulation of digital signals as patent-eligible subject matter (subject to the preemption doctrine) as a categorical rule, and indeed it is not disputed by the Federal Circuit that computer software, data compression, and the manipulation of digital signals each qualify as a “process” under § 101.

Thus, the issue is raised: *what exactly do the present claims preempt under Alice/Mayo?*

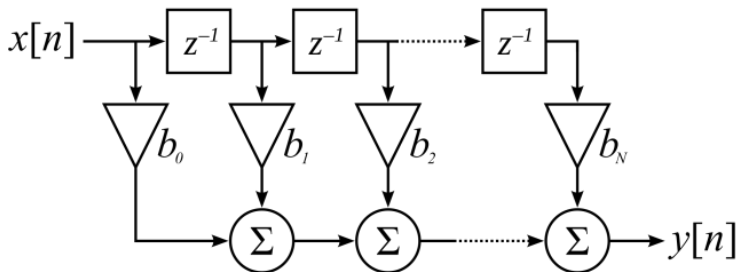
This is a fundamental question that should be *expressly* asked and *expressly* answered in every *Alice/Mayo* patent eligibility analysis.

In the present case, nothing is preempted.

According to the Federal Circuit, the analog filter below is patent-eligible because it performs a “physical realm” process by manipulating voltages and currents across two operational amplifiers to produce an output voltage V_o .



Also according to the Federal Circuit, the digital filter below is not patent eligible *as a categorical rule* even if the digital filter below performs the exact same filtering process as the analog filter above.



Why is the analog filter patent eligible but the digital filter not patent eligible? What non-capricious policy that promotes the useful arts makes such a distinction? Certainly § 101 makes no such distinction.

Clearly, the Federal Circuit’s “physical realm improvement” qualifier is not only a defiance of Supreme Court precedent under *Bilski*, but it

introduces an arbitrary and destructive wrinkle in patent eligibility that has no nexus to preemption and that violates the express statutory language that Congress enacted.

V. Congressional Intent Requires That This Court Reject “Invention” As a Requirement for Patent-Eligibility

As with many other decisions, the Federal Circuit now demands that the present claims comply with a meaningless and extra-statutory requirement of invention / inventive concept. For example, the Federal Circuit declared in the Decision below:

“What is needed is an *inventive concept* in the non-abstract application realm. Here, all of the claim details identified by InvestPic fall into one or both of two categories: they are themselves abstract; or there are no factual allegations from which one could plausibly infer that they are inventive. In these circumstances, judgment on the pleadings that the claims recite no ‘*inventive concept*’ is proper” (emphasis added) Pet.App. 16a.

What exactly qualifies as an “inventive concept?” The Federal Circuit constantly refers to this term but refuses to define the term beyond an incomprehensible and inconsistent circular argument. Regardless of whether or not a single Federal Circuit judge believes they understand the term, “invention” and “inventive concept” have no place in patent law.

The 1952 Patent Act was enacted in response to the Supreme Court’s anti-patent sentiment

prominent in the 1940s. This anti-patent sentiment was reported by Karl Lutz (*The New 1952 Patent Statute*, 35:3 *Journal of the Patent Office Society*, 155, 156-7 (1953)), who stated the 1952 Patent Act was enacted to remove “the recent apostasy” of the Supreme Court “from the benevolent policy of the Constitution.” Indeed, the “apostasy” was so harsh that Justice Jackson criticized the Supreme Court’s “strong passion” for striking patents down “so that the only patent that is valid is one which this Court has not been able to get its hands on.” *Jungersen v. Ostby & Barton Co.*, 335 U. S. 560, 572 (1949).

Accordingly, Congress codified the patent laws to address this malady in the 1952 Patent Act. See *Efforts to Establish a Statutory Standard of Invention: Study of the Subcommittee of Patents, Trademarks, and Copyrights of the Committee on the Judiciary*, United States Senate; Eighty-fifth Congress, First Session Pursuant to Senate Resolution 55, Study No. 7 (published 1958) (hereinafter “the 1958 Study”).

As stated on page 2 of the 1958 Study, Charles Kettering, who headed the National Patent Planning Commission, remarked that “[o]ne of the greatest technical weaknesses of the patent system . . . is the lack of a definitive yardstick as to what is invention.”

On page 4 of the 1958 Study, the legendary Honorable Giles Rich remarked about the difficulty of overcoming the idea of invention concluding “[s]o long as invention is there they can say it isn’t good enough to be an invention.” Judge Rich’s words are especially relevant today. Assuming that something is new, useful, falls within the subject matter of § 101 and doesn’t preempt an abstract idea, what

standard constitutes “good enough to be an invention?”

As Judge Rich further noted in *The Principles of Patentability* (17:2 Journal of the Patent Office Society, 75, 87-8 (1960)):

“It has generally been stated to be the law that, in addition to being new and useful, an invention, to be patentable, must involve ‘invention.’

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In the final analysis . . . [the] requirement for ‘invention’ was the plaything of the judges who, as they became initiated into its mysteries, delighted to devise and expound their own ideas of what it meant, some very lovely prose resulting” (internal citations omitted).

Thus, at the behest of Congress the two primary authors of the 1952 Patent Act, Giles Rich and “Pat” Federico, replaced “invention” with nonobviousness and, according to Judge Rich, Congress intentionally replaced the phrase “lack of invention” in the patent law with “nonobvious subject matter.” See Rich, Giles, *Laying the Ghost of the “Invention” Requirement*, 1:1 APLA Quarterly Journal, pp. 26-45 (1972) (reprinted with permission in *Nonobviousness – The Ultimate Condition of Patentability* at pp. 1:506 et seq.). To this end Judge Rich expressly stated:

“The first policy decision underlying Section 103 was to cut loose altogether from the century-old term ‘invention.’ It really was a term impossible to define So Section 103 speaks of a condition of *patentability* instead of ‘invention.’ . . . As compared to finding or not finding ‘invention,’ Section 103 was a whole new way of thinking and a clear *directive* to the courts to think that way” (emphasis in original). *Nonobviousness – The Ultimate Condition of Patentability* at p. 1:508.

Judge Rich’s words were echoed in *Graham v. John Deere Graham v. John Deere Co.*, 383 U.S. 1 (1966), where this Court recognized that “[t]he truth is, the word [‘invention’] cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty.” *Graham*, 383 U.S. at 11 (Quoting *McClain v. Ortmyer*, 141 U.S. 419 (1891)). “Its use as a label brought about a large variety of opinions as to its meaning both in the Patent Office, in the courts, and at the bar. The *Hotchkiss* formulation, however, lies not in any label[.]” *Graham*, 383 U.S. at 12. “Congress used the phrase ‘Conditions for patentability; *non-obvious subject matter*’ (italics added), thus focusing upon ‘nonobviousness,’ rather than ‘invention.’” *Id.* at 14. “Congress has emphasized ‘nonobviousness’ as the operative test of the section, rather than the less definite ‘invention’ language of *Hotchkiss*[.]” *Id.* “We believe that strict observance of the requirements laid down here will result in the uniformity which Congress called for in the 1952 Act.” *Id.* at 18.

Thus, this Court cannot now stand by a meaningless standard that originated in 1851, was declared useless by this Court in 1891 in the *McClain* decision, rejected by Congress in the 1952 Patent Act, and disavowed by this Court in 1966 in the *Graham* decision.

VI. The Federal Circuit Abuses the *Alice/Mayo* Test

Among the patent gentry many of us have long wondered whether the Federal Circuit truly believes some of their own holdings, or whether the Federal Circuit's decisions are akin to children poking at the festering wound of a sleeping father to garner attention.²

As with the cliché of the frog placed in a slowly-heated pot of water, one Federal Circuit decision after another slowly pushes the boundaries of reason until all that is left is a cruel hoax of a patent system based on a serial joke that some pray will (sooner rather than later) be cleaned up by Congress because many in the judiciary and the public in general have lost faith in the Supreme Court.³

² See, e.g., Mathis, Burman, *The Federal Circuit's Hidden Agenda* <https://www.ipwatchdog.com/2018/09/06/federal-circuits-hidden-agenda/id=101025/>

³ See, e.g., <http://www.ipwatchdog.com/2019/04/04/judge-paul-michel-look-congress-not-courts-fix-u-s-patent-system/id=107948/>;
<https://patentlyo.com/patent/2018/06/lourie-newman-congress.html>

The latest of these unbelievable holdings from the Federal Circuit is known as *ChargePoint Inc. v. SemaConnect, Inc.*, Appeal No. 2018-1739 (Fed.Cir. 2019) where the Federal Circuit ignored every limitation in relatively narrow claims to arrive at an absurd conclusion that the claims preempted a string of random words that the Federal Circuit declared (without evidence or rational) must constitute an abstract idea. In the *ChargePoint* analysis (slip op. at p. 22), the Federal Circuit stated:

“Where a claim is directed to an abstract idea, the claim must include “additional features” to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’ These additional features cannot simply be “well-understood, routine, conventional activit[ies]” previously known to the industry.” Indeed, adding novel or non-routine components is not necessarily enough to survive a § 101 challenge. *See Ultramercial*, 772 F.3d at 715 (disagreeing with the patent owner’s argument that “the addition of merely novel or non-routine components to the claimed idea necessarily turns an abstraction into something concrete”)” (internal citations omitted)

This quote above is nothing less than mockery of the *Alice/Mayo* test and to reason itself.

In one sentence the Federal Circuit proclaims that additional claim features cannot be “well-understood, routine, conventional activit[ies]” previously known to the industry.”

However, in the very next sentence the Federal Circuit proclaims “adding novel or non-routine components” still isn’t enough.

So the test for avoiding preemption of abstract ideas by adding limitations that are not well-known, routine, and conventional is not satisfied by adding claim limitations that are not known, not routine, and not conventional?

Amici not only welcome, but beg on hands and knees for Respondent’s counsel, who participated in the ChargePoint decision, to explain how a claim with novel and non-conventional limitations preempts an abstract idea.

What *ChargePoint* and *Investpic* both clearly hold is that “abstract” is anything the Federal Circuit says it is, and that preemption is no longer relevant to the preemption concern that is the basis of *Alice/Mayo* test.

While the *ChargePoint* and *Investpic* both declare the need for a claim to be “concrete,” the Federal Circuit on one hand declares that “concrete” is “the specificity required to transform a claim from one claiming only a result to one claiming a way of achieving it,” (Pet.App. 14a) and nearly in the same breath declares that no amount of meticulous detail cures this deficiency because the details are used to realize the abstract idea “add nothing outside the abstract realm.” Pet.App. 19a.

So what sort of claim limitation turns the abstract into the concrete under § 101? According to *ChargePoint* (slip op at p. 22) “novel or non-routine components” don’t do the trick.

The first question that arises is: How do judges determine what man-made things (not just an idea of itself) are abstract without any evidence and without any legal standard? Do they just stare at the claims until they receive an epiphany from God? What are the exact processes used to determine what man-made things qualify as abstract?

Are all new mathematical solutions to practical problems mankind faces in industry and finance abstract?

Is a tire tread design based on a mathematical formula abstract?

How about a new functional design for an automotive drive shaft based upon a natural law that reduces sympathetic vibration? Abstract?

The second question that arises is: What transmutes the abstract into the concrete under § 101? What alchemy is involved? Is there some slight of hand the patent community should be aware of, or is industry left to wander the desert for the next forty years?

Is a new and improved tire tread design incurably abstract because the new and improved tire tread uses previously-known material as the Federal Circuit suggests in the present case?

Is a new and improved automotive drive shaft design incurably abstract because the steel alloys used to make said drive shaft are unremarkable?

Why are computer-based technologies discriminated against as compared to tires and drive shafts when rubber curing and steel-making predate computers by over a hundred years and are no less ubiquitous and versatile?

VII. Section 101 of the Patent Law Is the Wrong Tool to Determine “Concrete”

There is a cliché attributed to any number of historical figures from Siddhartha Guatama to Mark Twain that goes “When the only tool you have is a hammer, the entire world looks like a nail.” Apparently, the Federal Circuit has forgotten that the Patent Law contains a variety of tools including § 102, § 103, and § 112, and that not all patent issues should be addressed by § 101 and the meaningless standard of “invention.”

A. Whatever the Federal Circuit Means By “Concrete,” It Has No Relationship to *Alice/Mayo*’s Preemption Concern

In the present case the lack of any § 102 and § 103 issue is clear evidence that no abstract idea is preempted. The “coarse filter” of *Alice/Mayo* cannot be more onerous than the finely-tuned filters of § 102 and § 103 without violating the statutory scheme Congress enacted.

Contrary to the apparent assertions by the Federal Circuit, the statutory Patent Law does not require every functional or structural nuance of an invention to be claimed – merely that detail necessary to distinguish a claim from the prior art under § 102 and § 103. Such a requirement 100% assures that a claim will not preempt a single man-made thing that came before, and a failure to adequately exclude the previously known, and obvious variants of the previously known, dooms a claim as invalid.

However, *Amici* digress. There is no assertion by the Federal Circuit that Investpic’s claims preempt anything. Why is this even an *Alice/Mayo* case?

B. Whatever the Federal Circuit Means By “Concrete,” It Has No Foundation in § 101

As best as *Amici* can tell, the Federal Circuit’s demand than claims have “the specificity required to transform a claim from one **claiming only a result** to one claiming a way of achieving it” (emphasis added) is *a condemnation of functional claiming* followed by an assertion that any amount of detail of an algorithm doesn’t count as “a way of achieving” the result. See, e.g., Pet.App. 14a.

Functional limitations by their nature claim only results. The Federal Circuit’s holding below is no less than a condemnation of functional claiming.

Functional claiming, however, is fully contemplated by the Patent Law and is fully addressed by Title 35 U.S.C. § 112, which includes:

- (1) a requirement that a claim be appropriately described and enabled (§ 112(a));
- (2) a requirement that a claim must particularly point out and distinctly claim its subject matter (§ 112 (b)); and
- (3) a mechanism that prevents overly-broad functional claiming by stating that such claims “shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof” (§ 112(f)).

There is genius in the Patent Law placed by brilliant visionaries in the mid 20th century. Such

genius should not be supplanted by a set of endless judicially-contrived contradictions that is the present state of the *Alice/Mayo* test thanks to a subset of Federal Circuit judges who, as they become initiated into the mysteries of “invention,” delight to devise and expound their own ideas of what “invention” means – the result being some very lovely (but totally meaningless) prose.

Section § 112 of the statutory Patent Law fully addresses this “concrete” issue in a manner Congress set forth.

Why can’t the non-statutory requirement of “invention” include functional claiming when functional claiming is allowed under the statutory rule of § 112(f)?

Amici do not make these unabashed, pro-functional claiming assertions in a vacuum. As was stated by Professor Mark Janis (page 1) in *Who’s Afraid of Functional Claims – Reforming the Patent Law’s 112, 6 Jurisprudence*, 15 Santa Clara Computer & High Tech. L. J. 231 (1999):

“A functional claiming’ phobia has long gripped U.S. patent jurisprudence. It is manifested doctrinally in decisions holding that functional expressions in patent claims are either so abstract, indefinite, or overbroad as to frustrate the patent law’s Constitutional mandate to promote the progress of useful arts. Its roots run deep, to early nineteenth century patent decisions. Today, it is manifested in the patent statute, at 35 U.S.C. § 112, paragraph 6 [hereinafter § 112 ¶6], which authorizes the use of certain types of functional expressions, but subjects them to a

potentially severe restriction in scope: the expression covers only the corresponding structure, material, or acts disclosed in the patent, plus ‘equivalents’ thereof”

What does the *Investpic* holding represent? It represents the Federal Circuit regressing seventy-three years in the past to *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946) (striking down the “overhanging threat” of functional claiming), a Supreme Court case that Congress overruled in the 1952 Patent Act using § 112(f).⁴ See, e.g., *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1582 (Fed. Cir. 1996) (“Congress enacted paragraph six . . . to overrule that holding.”); *Williamson v. Citrix Online, L.L.C.*, 792 F.3d 1339, 1357 (Fed. Cir. 2015) (en banc) (“it is generally accepted that § 112, para. 6 was passed in response to the Supreme Court’s decision in *Halliburton*”).

It’s past time the Federal Circuit understand that the Patent Law does not begin and end with § 101.

VIII. Conclusion

Certiorari is necessary to address the Federal Circuit’s lawless categorical rules.

/s/ Burman Y. Mathis
 Burman Y. Mathis
 Attorney for Amicus Curiae

⁴ Title 35 U.S.C. § 112, ¶ 6 was renumbered to 35 U.S.C. § 112(f) by the America Invents Act, but the substance remains identical.