

No. 19-103

IN THE
Supreme Court of the United States

STRIKEFORCE TECHNOLOGIES, INC.,
Petitioner,
v.
SECUREAUTH CORPORATION,
Respondent.

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

REPLY BRIEF FOR PETITIONER

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CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, petitioner StrikeForce Technologies, Inc. makes reference to its corporate disclosure statement in its Petition for a Writ of Certiorari filed on July 19, 2019.

INTRODUCTION

In its Brief in Opposition to Petition for Writ of Certiorari ("Opposition"), Respondent presents three brief arguments against granting the Petition for a Writ of Certiorari ("Petition"), arguing that Petitioner did not properly allege error by the court below, Petitioner waived its argument, and that Petitioner failed to show how the resolution of *HP Inc., fka Hewlett-Packard Company, Petitioner v. Steven E. Berkheimer, Respondent*, 18-415 (petition filed September 28, 2018) ("*Berkheimer SCT*") would affect the outcome of this case. At base, Respondent's arguments all ultimately suffer from the same basic flaw. Respondent presumes that this Court, should it grant certiorari in *Berkheimer SCT*, will merely reverse or affirm the Federal Circuit's opinion in *Berkheimer v. HP, Inc. fka Hewlett-Packard Co.*, 881 F.3d 1360 (Fed. Cir. 2018) ("*Berkheimer CAFC*") without providing any comment to or alteration of that opinion.

Respondent's presumption, however, of a binary choice for this Court in deciding *Berkheimer SCT*, is implausible. As set forth in detail in the Petition, there is considerable debate within the Federal Circuit itself as to the proper interpretation of *Berkheimer CAFC* and the multitude of issues that the decision raised. These various views, as well as other issues raised by the Federal Circuit's *Berkheimer CAFC* decision, are specifically discussed in the *Berkheimer SCT* certiorari submissions of the parties and the amici, and are all issues to be considered by this

Court should it grant certiorari in *Berkheimer SCT*. Respondent essentially ignores, and thereby does not challenge, the aspects of the Petition that describe these various views of *Berkheimer CAFC*, as well as the explanation of why this Court's decision, should it grant certiorari in *Berkheimer SCT*, will almost certainly require reversal and remand of this case. Once these aspects of the Petition are considered, as they should be, it becomes evident that Respondent's arguments are no reason to deny the Petition. The Court should hold this Petition pending its decision on whether to grant certiorari in *Berkheimer SCT*, and should it do so, hold this Petition pending its decision in *Berkheimer SCT*.

**I. Petitioner Has Properly Identified Error
In the Decision Below**

With almost no explanation, Respondent merely asserts that the Petition does not allege any error below or advocate for any specific change to any existing legal standard. Opposition at 4. Respondent is wrong. The entire thrust of the Petition is that the Federal Circuit committed error because it did not analyze *Berkheimer CAFC* properly in this case. That is why the Petition discusses in detail the different ways in which various judges in the Federal Circuit view *Berkheimer CAFC*, as well as the multitude of open issues from *Berkheimer CAFC*. Petition at 8-13. To complete the circle, the Petition then explains exactly why the resolution of those issues by this Court will almost certainly require a reversal and remand. Petition at 13-17. And as in any hold petition, Petitioner asks this Court to direct the lower court to decide this case in accordance with this Court's *Berkheimer SCT* decision. The reason for this presentation in the Petition is simple; it explains the reasons

why the Federal Circuit erred in this case and it requires the appropriate relief from this Court.

Of course, no one can identify a specific error in the Federal Circuit's decision below in this case with certainty because it issued its decision without an opinion under Federal Circuit Rule 36. But that is exactly why the Petition's approach to assigning error was the correct one. The Petition, quite correctly, pointed out the various views and explained why a reversal and remand should occur after *Berkheimer SCT* is decided to correct the error by the Federal Circuit. No more is required.

II. Petitioner Did Not Waive Its Argument

In an even shorter argument, Respondent alleges that Petitioner waived its argument because it did not set forth some new legal standard to be followed in the court below. Opposition at 4. Once again, Respondent's argument misses the point. The whole point of the Petition, as explained above, is that the court below did not analyze and apply *Berkheimer CAFC* correctly. That issue, as Respondent concedes, was raised before the court below. And that is exactly what Petitioner asserts in the Question Presented ("Whether the Federal Circuit conducted the proper analysis under step two of *Alice* . . .") (Petition at (i)). Accordingly, there is no waiver.

III. The Petition Explains In Detail How the Outcome of *Berkheimer SCT* Would Affect The Outcome Here

In what appears to be its principal argument, Respondent asserts that the Petition does not show how the result in *Berkheimer SCT* would affect the outcome in this case. According to Respondent, if the Court were to reverse *Berkheimer CAFC*, this Court would be ruling that no fact finding is ever necessary

in a patent-eligibility case, and thus, no fact finding would be required in this case. If this Court were to agree that *Berkheimer CAFC* was correctly decided, no remand would be necessary because the Federal Circuit already considered *Berkheimer CAFC* when issuing its decision below. Opposition at 5.

But Respondent can only make this “heads I win, tails you lose” binary choice argument by ignoring almost all of the arguments presented in the Petition. As explained in the Petition, there are multiple reasons why this Court’s decision would require a remand. In fact, the last few pages of the Petition (pp. 13-17) are devoted entirely to explaining exactly why this Court’s decision should require a remand in this case. Petitioner does not repeat those arguments here, but does reiterate that a reversal and remand will likely be required if this Court were to decide *Berkheimer SCT* either on the “substantive” question of what is required for patent-eligibility (e.g., the importance of the teachings in the specification, the role of novelty in a patent-eligibility analysis, the proper level of proof, etc. (Petition 13-15)), or the “procedural” aspects of *Berkheimer CAFC* (e.g., is some aspect of patent-eligibility decided as a matter of fact, and if so, what discovery will be allowed, the role of expert opinions, whether factual disputes are decided by the court or the jury, etc. (Petition 15-17)).

The only argument presented by Petitioner to which Respondent even tries to respond is Petitioner’s observation that it is impossible to know how the Federal Circuit analyzed this issue because its decision was rendered without opinion under Federal Circuit Rule 36. According to Respondent, the Federal Circuit must have considered the impact of *Berkheimer CAFC* because, as binding precedent, the panel was required

to follow *Berkheimer CAFC*. Opposition at 5-6. Once again, Respondent's observation misses the point. While it is correct that *Berkheimer CAFC* was cited and argued by the parties below, the *proper application* of *Berkheimer CAFC* is undoubtedly a hotly-debated topic within the Federal Circuit (as well as in the legal community). Precisely because there are so many differing views on this subject, Petitioner's reliance on Rule 36 is completely appropriate. The simple and undenied fact is that because the decision below was entered under Rule 36, no definitive conclusion can be made as to whether *Berkheimer CAFC* was properly applied in this case.¹

CONCLUSION

Respondent's narrow view of the issues confronting this Court, should it grant certiorari in *Berkheimer SCT*, is incorrect. Viewed in its proper context, Petitioner plainly alleged error below, waived nothing and explained in detail the many reasons why the decision of this Court in *Berkheimer SCT* would almost certainly require a reversal and remand. Accordingly, the Petition for Writ of Certiorari should be held pending this Court's decision whether to grant certiorari in *Berkheimer SCT* and if so, held pending this Court's decision in *Berkheimer SCT* and disposed of as appropriate in light of the Court's decision in that case.

¹ Respondent contends that Petitioner misidentified that panel below, and as a result, Petitioner's argument that the outcome in this case was panel driven is meritless. Opposition at 6-7. The important point that Petitioner was making is that, as observed by HP in its Petition for Writ of Certiorari, the outcome of appeals on this issue "will depend entirely on the membership of the panel." Petition at 14 (quoting the HP Petition at 34). That concern about decisions being driven by panel membership is a valid (and uncontested) one regardless of the specific membership of the Federal Circuit panel in this case.

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Respectfully submitted,

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