

No.

IN THE
Supreme Court of the United States

THE CHAMBERLAIN GROUP, INC.,
Petitioner,

v.

TECHTRONIC INDUSTRIES CO.,
TECHTRONIC INDUSTRIES NORTH AMERICA, INC.,
ONE WORLD TECHNOLOGIES, INC.,
OWT INDUSTRIES, INC., RYOBI TECHNOLOGIES, INC.,
Respondents.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

This Court has held that any machine or process is eligible for patent protection under 35 U.S.C. § 101, subject only to narrow exceptions where the patent seeks to monopolize an abstract idea or law of nature. This Court has further held repeatedly that a court must make that determination by evaluating the claims “as a whole.” The Federal Circuit, however, routinely declares inventions ineligible for patent protection by dissecting the patent’s claim into purportedly new versus old elements, and then isolating just the new ones for analysis. It applied that approach here to strip The Chamberlain Group’s novel garage door opener of patent protection. The question presented is:

Whether the Federal Circuit improperly expanded § 101’s narrow implicit exceptions by failing to properly assess Chamberlain’s claims “as a whole,” where the claims recite an improvement to a machine and leave ample room for other inventors to apply any underlying abstract principles in different ways.

CORPORATE DISCLOSURE STATEMENT

Pursuant to Rule 29.6, Petitioner The Chamberlain Group states that The Duchossois Group, Inc., is a parent corporation.

RELATED PROCEEDINGS

The Chamberlain Group, Inc. v. Techtronic Industries Co., Ltd., No. 16 C 6097 (N. D. Ill. Judgment entered Jan. 25, 2017)

The Chamberlain Group, Inc. v. Techtronic Industries Co., Ltd., No. 2018-2103, -2228 (Fed. Cir. Judgment entered Aug. 21, 2019)

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INTRODUCTION

This is a patent emergency. A few years ago, the Federal Circuit adopted a rule that it is now applying with abandon across technologies to strip novel inventions of patent protection right at the threshold. Invoking § 101 of the Patent Act, the Federal Circuit is declaring a wide range of inventions unpatentable, from diagnostic tools to automotive parts, credit cards to microchips. The common denominator in each is a conclusion that some aspect of the claimed invention implicates an abstract idea or law of nature, and that suffices to strip it entirely of patent protection. A patent law issue does not get more foundational than that.

Rarely has this Court encountered such a widespread clamor to intervene and provide clarity. Multiple Federal Circuit judges (including the author of the opinion below) have begged this Court to step in. The Patent and Trademark Office (PTO) has complained that the uncertainty surrounding § 101 is making it impossible for thousands of examiners to do their jobs. The Solicitor General has lambasted the Federal Circuit's approach and urged this Court to fix it. Just about every major industry has sought review: Manufacturing. Home appliances. Automotive. Computing. Software. Diagnostics. Medical treatments. Biotech.

The root cause of all this ire and uncertainty is the Federal Circuit's insistence once again on crafting an elaborate test that strays from—and here, contradicts—the plain text of the Act. The statute Congress passed provides that an inventor may seek patent

protection for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. This Court has long recognized that § 101’s expansive language contemplates implicit exceptions that prevent inventors from locking up the building blocks of scientific inquiry—natural laws, physical phenomena, and abstract ideas. This Court has crafted a test that ensures that those narrow exceptions defeat patent protection only where necessary to prevent an inventor from using a patent to preempt the basic tools necessary for others to innovate.

The Federal Circuit has expanded the narrow exceptions to swallow the rule for vast swaths of innovation. Instead of evaluating the preemptive risk of a patent by reading the claim as a whole, as this Court has directed, the Federal Circuit reduces each claim to a single supposed point of novelty and asks only whether that one feature reflects an abstract idea, law of nature, or physical phenomenon. Wielding this test, the Federal Circuit characterizes patents as impermissible regardless of how concrete and specific the claimed invention is, and even where the patent leaves plenty of room for other inventors to devise their own particularized applications of the same underlying ideas. Thus, the Federal Circuit has expanded a narrow, text-bound exception into a barrier to patent protection that is often insurmountable and always unpredictable.

This case exemplifies the problem. Chamberlain’s patent claims a “smart” garage door opener with features to control and monitor a garage door from afar. There is no disputing that the invention is a “new and

useful ... machine” within the meaning of § 101. The jury found it novel and nonobvious. Yet, the Federal Circuit declared it ineligible for patent protection. It held that the claims are directed to an abstract idea even though they describe a physical machine with specific hardware and software.

If this Court has been waiting for the right vehicle for resolving the § 101 morass, this case is it. It satisfies all the criteria the Solicitor General has enumerated for the perfect vehicle. There is no need to wait for another erroneous decision by the Federal Circuit.

And there is no time. Innovators are adapting their behavior right now to the Federal Circuit’s new patent-hostile regime. Investors are deciding now to withhold investments they would have made before the Federal Circuit changed the law. Waiting any longer to intervene could inflict irreparable harm on U.S. industry.

The Court should grant this petition.

OPINIONS AND ORDERS BELOW

The Federal Circuit’s opinion is reported at 935 F.3d 1341 and reproduced at Pet. App. 1a-19a. The Federal Circuit’s denial of rehearing en banc is not reported and is reproduced at Pet. App. 116a-117a. The district court’s decision denying respondent’s motion for judgment as a matter of law is reported at 315 F. Supp. 3d 977 and reproduced at Pet. App. 20a-115a.

JURISDICTION

The Federal Circuit entered judgment on August 21, 2019. Pet. App. 1a. It denied Chamberlain’s timely petition for rehearing on December 17, 2019. Pet. App. 117a. On March 2, 2020, the Chief Justice extended the time for filing a petition for writ of certiorari to May 15, 2020. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 101 of the Patent Act, 35 U.S.C. § 101, provides:

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.

STATEMENT OF THE CASE

Alice Articulates A Two-Step § 101 Framework That Assesses The Preemptive Effect of Claims “As A Whole”

The Constitution authorizes Congress to enact laws to “promote the Progress of Science and useful Arts.” U.S. Const. art. I, § 8, cl. 8. In the service of that “primary object,” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014), the Patent Act grants patent protection for a broad range of innovations. Section 101 defines patent-eligible subject matter in expansive terms, encompassing “any new and useful

process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. In crafting such broad language, Congress meant to “include anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (quoting legislative history).

As expansive as § 101 is, it is not boundless. “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70 (2012) (quotation marks and alteration omitted). This Court has described these as “implicit” “exception[s],” *id.*, but they are more accurately understood as limitations implicit in § 101’s grant of patent eligibility only to an inventive “process, machine, manufacture,” etc. No one may claim an exclusive right in these “basic tools of scientific and technological work.” *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972). As this Court long ago explained, far from promoting the progress of science, allowing monopolies to preempt others from using such basic tools “would discourage arts and manufactures, against the avowed policy of the patent laws.” *LeRoy v. Tatham*, 55 U.S. 156, 175 (1852); *accord Mayo*, 566 U.S. at 71 (“[M]onopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it.”).

Reading § 101 in light of that imperative to reward innovation without allowing “pre-emption,” *Alice* articulated a two-step framework for assessing patent eligibility. 573 U.S. at 216. At step one, courts ask “whether the claims at issue are directed to a patent-ineligible concept” at all. *Id.* at 218. If not, the claims automatically satisfy § 101. Otherwise, courts

proceed to the second step, which requires courts to “examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 221.

At both steps, courts must assess the claims “as a whole” to gauge whether and to what extent the patent confers a monopoly on the use of a natural law or abstract idea. *Id.* at 218 n.3, 225; see *Diamond v. Diehr*, 450 U.S. 175, 188 (1981).

Chamberlain Patents An Innovative Garage Door Opener With Specific Hardware And Software Configurations

This case concerns the eligibility of Chamberlain’s U.S. Patent No. 7,224,275, which claims an innovative type of garage door opener.¹ Founded in Illinois in the 1950s, Chamberlain has been the country’s leader in garage door opener technology for more than half a century, developing hundreds of industry advancements. Trial Tr. 84-86. Today, Chamberlain sells market-leading garage door openers under both the LiftMaster and Chamberlain brands. CAFC Appx. 441.

Thanks in large part to Chamberlain’s innovations, modern garage door openers perform a variety of tasks beyond simply raising and lowering doors.

¹ For simplicity, we refer to “garage door openers,” though the patent covers any sort of “movable barrier operator,” including those used to operate gates and commercial doors. Pet. App. 4a-5a; see Trial Tr. 89 (D. Ct. Doc. 693).

Pet. App. 3a. Customers now demand additional features, like the ability to activate and deactivate peripherals such as ambient lighting or alarms. *Id.* Customers also increasingly expect their home appliances to have “smart” functionality—the ability to communicate with them, and receive updates from them, from afar. CAFC Appx. 437-438.

Traditionally, communication with a garage door opener was one-way. Users could send directions to perform functions, like closing the door or turning off ambient lighting. *See* Pet. App. 29a. But the devices could not *respond back* with information about the status of the system. *See id.*; CAFC Appx. 370. So a homeowner could issue a remote command to close the garage door, but could not check whether the door was left open or the light was on. *See* CAFC Appx. 370.

Years before the advent of the “smart home”—indeed, even before the iPhone—Chamberlain devised a way to make that communication a two-way street. Claims 1, 5, and 15 pioneered a new garage door opener with specific hardware and software configurations that can do more than simply receive commands; they can also detect, analyze, and then transmit information about the system. First, a hardware “controller” integrated into the opener detects the condition of each component. Pet. App. 4a. The controller’s software assesses conditions known as “operating states,” chosen from a programmed list of alternatives. *Id.*; CAFC Appx. 465-466. The controller describes the garage door, for example, as either “[c]losed, open, closing, opening,” or malfunctioning. CAFC Appx. 466. Second, a hardware component

called a “wireless status condition data transmitter,” also integrated into the opener and “coupled” to the controller, sends that “status condition” information to peripheral devices—such as an external display or a lighting control unit. Pet. App. 4a-5a. The transmitter’s software also appends an “identifier” unique to that particular garage door opener. *Id.*

In specifying those precise hardware and software requirements, Chamberlain opted against several alternative configurations. For example, Chamberlain chose to send status information wirelessly, rather than through physical wiring. Pet. App. 4a. That lowered “the overall cost of a given platform” by eliminating the need for an expensive “physical peripheral interface,” part of which would go “unused” in most installations. CAFC Appx. 216-17 (’275 patent at 1:60-62, 3:20-23). Chamberlain’s wireless approach also could be updated more easily “to remain compatible with evolving features and legal and/or regulatory requirements,” yielding “a longer useful service life.” CAFC Appx. 217 (’275 patent at 3:23-26).

To minimize “cost and complexity,” Chamberlain’s patent also required that the controller and wireless transmitter be integrated into the garage door opener, rather than installed as standalone devices or modules. CAFC Appx. 441; Pet. App. 34a-35a. And Chamberlain chose to program those components to detect and transmit a defined “operating state” for each part of the system, rather than sending raw data from which peripheral devices would have to derive the operating state. *See* Pet. App. 36a-37a. For example, Chamberlain’s programming would communicate whether the garage door is “open” or “closed.” It would

not send “the number of times the [garage door opener’s] motor has turned”—raw data from which a peripheral device would then have to work to determine the door’s status. *Id.*

The Chamberlain products that practice this patent have revolutionized the market, making garage door openers part of the modern smart home. Customers can now receive updates about the system. Their garage door openers can alert them on their smartphones that they forgot to close the door or arm the alarm, or that a child has returned home. *See* CAFC Appx. 441. Chamberlain’s technology has been recognized for innovation. CAFC Appx. 440. Other leading smart-home companies—including Apple and Nest—have sought out partnerships. *Id.* Most importantly, the enhanced security and “emotional benefit” of Chamberlain’s products have won rave reviews from customers, as well as major publications like *The Wall Street Journal*. CAFC Appx. 440-441.

Chamberlain Secures A Verdict For Techtronic’s Willful Infringement

In 2015, years after the ’275 patent issued, Techtronic decided to make a rapid entry into the garage door opener market. The company had never made a garage door opener; it was in the power tool business. So Techtronic’s engineers “acquired Chamberlain [garage door openers] which practice the ’275 patent” and “disassembled the devices” to replicate their specific components. Pet. App. 84a. They even “used the internal parts” from Chamberlain’s garage

door openers “to make a demo” of their product for retailers, simply replacing Chamberlain’s housing with one of their own. *Id.*

Chamberlain sued Techtronic for infringing the ’275 patent. Techtronic asserted several defenses, contending that the claims covered ineligible subject matter under § 101, were anticipated under § 102, and were obvious under § 103. *See* Amended Answer (D. Ct. Doc. 365). Techtronic also sought inter partes review before the PTO, arguing that the ’275 patent claims were anticipated or obvious.

The PTO denied Techtronic’s petition, reaffirming that Chamberlain’s claims are novel and nonobvious. IPR2016-01772, Paper 8 (Feb. 21, 2017 PTAB). Then, after an eight-day trial, the jury rejected all of Techtronic’s invalidity defenses and found that it had willfully infringed the ’275 patent. Pet. App. 21a. The jury awarded nearly \$4 million in damages for the short period of infringement, which the district court trebled under 35 U.S.C. § 284 in light of Techtronic’s willful infringement. Pet. App. 114a.

The District Court Upholds The Verdict, Finding The ’275 Claims Patent-Eligible Under § 101

After trial, Techtronic sought judgment as a matter of law that Chamberlain’s claims are ineligible for patent protection under § 101. In Techtronic’s view, the claims impermissibly monopolize an abstract idea—“the transmission of data.” Pet. App. 24a-25a. The court rejected that argument as an “over-abstraction” of the claims. *Id.* The court instead concluded that the claims are patent-eligible at *Alice*’s first step

because they are “directed to” an improved garage door opener—one that can “wirelessly transmit status information” thanks to “particular and unconventional improvements” over the prior art. Pet. App. 25a, 29a. The claims thus do not monopolize the use of any abstract principle or create a risk of preemption. Pet. App. 29a. Rather, “the particularity of the claims—specifically, that the controller must experience the status conditions—diminishes the preemption concerns that undergird the *Alice* inquiry.” Pet. App. 30a. Having found the claims patent-eligible at *Alice* step one, the district court did not need to proceed to step two.

The district court also denied Techtronic’s motion for judgment as a matter of law under §§ 102 and 103, confirming the jury’s view that Chamberlain’s chosen components and programming distinguished the claims from prior art. Pet. App. 31a-39a.

The Federal Circuit Reverses, Finding The Claims Ineligible Under § 101

On appeal, the Federal Circuit reversed the district court’s § 101 ruling and held Chamberlain’s claims ineligible for patent protection. To determine whether the claims are “directed to” an abstract idea at *Alice* step one, the panel examined only “the focus of the claimed advance over the prior art.” Pet. App. 6a. The panel thus ignored any claim element that did not, by itself, constitute a “difference” from “prior art movable barrier operator systems.” Pet. App. 7a. Applying that interpretation of *Alice*’s framework, the Federal Circuit decided that the only novel aspect of the claims is that “the status information about the

system is communicated wirelessly.” *Id.* Isolating that element, the panel held that the claims are “directed to wirelessly communicating status information about a system,” which the panel classified as an “abstract idea.” Pet. App. 6a-7a.

Also under the rubric of step one, the panel further reasoned that the claims “merely limit[] the field of use of the abstract idea to a particular existing technological environment”—namely, “movable barrier operator[s].” Pet. App. 10a. The panel held that this aspect of the claims “does not render [them] any less abstract.” *Id.*

Turning to *Alice*’s second step, the Federal Circuit held that the claim limitations apart from “the act of wireless communication” are not “sufficient to transform the abstract idea of communicating status information about a system into a patent-eligible application of that idea.” Pet. App. 12a-13a. The panel observed that “[s]imply appending conventional steps, specified at a high level of generality, [i]s not enough to supply an inventive concept” to an otherwise abstract claim. Pet. App. 11a (quoting *Alice*, 573 U.S. at 222). In the panel’s view, the claims do just that because their individual hardware “components”—such as the controller and wireless transmitter—are “all recited in a generic way.” *Id.* The panel thus concluded that the “ordered combination of ... elements” could not be “inventive,” either. *Id.* In so holding, the Federal Circuit did not discuss the various selections Chamberlain made in designing its system—including incorporating the controller and wireless transmitter into the garage door opener itself, rather than a distinct module, and specifying

software programming that conveyed status information in the form of states, rather than less-processed data. *See* Pet. App. 6a-13a; *infra* 22.

Having held the claims ineligible for patent protection under § 101, the Federal Circuit vacated the corresponding infringement verdict and damages award. *See* Pet. App. 19a.

REASONS FOR GRANTING THE WRIT

I. The Federal Circuit’s Persistent Refusal To Analyze Claims “As A Whole” Under § 101 Defies This Court’s Precedents And Divorces The Statute’s Implicit Exceptions From The Statutory Language And Preemption Concerns.

As this Court has emphasized, § 101 strikes a critical balance between rewarding innovation and preventing an inventor from preempting an entire field of innovation. § I.A. In recent years, the Federal Circuit has upset that balance by refusing to analyze claims “as a whole,” yielding a drastic expansion of the atextual exceptions to patent eligibility. This case illustrates just how far the Federal Circuit has strayed from § 101’s text and motivating principles. § I.B. But this is no isolated error. The Federal Circuit has entrenched its expansion of the exceptions in a large body of case law—incorrectly insisting that this Court’s cases demand it. § I.C. Only this Court can fix the Federal Circuit’s latest effort to redraft the statute Congress passed.

A. Section 101 strikes a critical balance between rewarding innovation and preventing an inventor from preempting an entire field of innovation.

Section 101 balances two competing considerations. On one hand, its expansive language ensures that genuine innovations are encouraged and rewarded with patent protection. “[A]ny new and useful process, machine, manufacture, or composition of matter,” is eligible for patent protection. 35 U.S.C. § 101. So is “any... improvement” thereon. *Id.* On the other hand, the statute’s implicit exceptions ensure that the inventor cannot unfairly preempt other genuine innovations before they happen. All inventions rely “[a]t some level” on the fundamental “building blocks of human ingenuity”: “laws of nature, natural phenomena, or abstract ideas.” *Alice*, 573 U.S. at 216-17 (quotation marks omitted). Allowing a patentee to preempt other inventors from harnessing those building blocks—under the guise of protecting a “machine” or “process”—would stifle progress. *Id.*

This balance defines the contours of § 101’s implicit exceptions. Claims that “monopolize” natural laws or abstract ideas are ineligible. *Id.* at 221. But claims that instead “apply” those basic tools to a “new and useful end” in a particularized way must remain patentable. *Id.* at 217 (quotation marks omitted); see *Mackay Radio & Tel. Co. v. Radio Corp. of Am.*, 306 U.S. 86, 94 (1939) (“While a scientific truth, or the mathematical expression of it, is not [a] patentable invention, a novel and useful structure created with the aid of knowledge of scientific truth may be.”). Courts must therefore “tread carefully in construing [§ 101’s]

exclusionary principle lest it swallow all of patent law” by stripping protection from the very innovative uses the statute serves to protect. *Alice*, 573 U.S. at 217.

Alice’s two-step framework enforces this balanced approach by barring only those claims that impermissibly monopolize natural laws or abstract ideas. *Id.* Step one is a relatively coarse “stage-one filter.” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016). It asks “whether the claims at issue are directed to” a natural law or abstract idea. *Alice*, 573 U.S. at 217. If not, the claim poses no danger of disproportionate preemption and the invention is patent eligible. If, however, the claim is “directed to” a natural law or abstract idea, step two then serves as a finer filter to determine whether the claim is written in a way that tries to monopolize all applications of the law or idea, or leaves room for others in the same field to develop their own particularized applications of the same law or idea. *Id.* at 222. Courts ask whether the claim augments the natural law or abstract idea with a distinct and particularized “inventive concept.” *Id.*

Critical to that balance is this Court’s direction, at each step, to examine “all claim elements, both individually and in combination.” *Id.* at 218 n.3. As this case illustrates, it is all too easy to find an abstraction in a single element of a claim. When a court zooms in on the more abstract element rather than considering the entire “machine” or “process,” it skews the balance heavily toward disqualifying the invention from patent protection.

That is why this Court long ago rejected an approach of parsing claims and examining the inventiveness of only certain elements. Some litigants attributed such a fragmentary approach to *Parker v. Flook*, 437 U.S. 584 (1978). In *Diehr*, for reasons recounted more fully below, this Court condemned that as a misreading of *Flook*. In keeping with prior cases, this Court held that it is “inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements” when evaluating patent eligibility. *Diehr*, 450 U.S. at 188-89 & n.12 (citing *Benson* and *Cochrane v. Deener*, 94 U.S. 780 (1877)). In the four decades since *Diehr*, this Court has maintained § 101’s balance by never departing from that rule.

B. The Federal Circuit refuses to examine the claims “as a whole,” and therefore fails to properly assess preemption concerns, at either step of *Alice*.

Over the past four years, the Federal Circuit has adopted new tests that flout this Court’s direction that the eligibility inquiry “must” consider the claims “as a whole.” *Diehr*, 450 U.S. at 188; *see Alice*, 573 U.S. at 218 n.3. Its incorrect tests skew outcomes against eligibility at both steps of the *Alice* analysis.

1. The error skews at step one.

The skew starts at step one, which asks “whether the claims at issue are directed to” a patent-ineligible concept. 573 U.S. at 217. This is a big-picture inquiry, surveying the territory the inventor has attempted to stake out for exclusive rights. The entire claim, not

any one part of it, defines “the subject matter which the inventor ... regards as the invention.” 35 U.S.C. § 112(b). And so step one asks about the nature of that subject matter, to see whether an abstract idea (or a natural law, or a physical phenomenon) is front and center.

This Court’s most recent § 101 decisions all embody that holistic approach. Each case examined all elements together and found the claims at issue were “directed to” ineligible concepts only because those concepts were the sum and substance of the claims. The claims in *Alice* amounted to little more than “the abstract idea of intermediated settlement,” 573 U.S. at 218—using a middleman to settle claims. The claims in *Bilski v. Kappos* did the same for “the concept of hedging risk.” 561 U.S. 593, 599, 609 (2010). And the claims in *Mayo* consisted of “relationships between concentrations of certain metabolites in the blood” and the efficacy of a drug dosage. 566 U.S. at 77. These ineligible concepts were unmistakably the focus of the entire invention.

The Federal Circuit has invented a fundamentally different step-one test. As exemplified by this case, the court *says* it is assessing the “claim’s character as a whole,” but in the next breath it does the opposite: It separates claims into purportedly old and new elements and “look[s]” only “at the focus of the claimed *advance* over the prior art,” ignoring more familiar aspects of the invention. Pet. App. 6a (quoting *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016) (emphasis added)). But this approach necessarily misses the forest for

some cluster of the trees. The only way to see the nature of the proverbial forest is to assess claims in their entirety, as this Court instructs.

The Federal Circuit’s distorted test has improperly invalidated, at step one, all sorts of inventions that are plainly directed to concrete machines or specific processes. *Infra* 27-28. This case is a prime example. Under the proper analysis, Chamberlain’s claims “as a whole” are “directed to” a specific sort of “moveable barrier operator” (such as a garage door opener) with integrated two-way wireless communication. Pet. App. 23a-24a. None of that is abstract. It is about as concrete as a physical machine gets, with specified hardware components arrayed in a specified way along with specified other features that yield specified results. Only by dissecting the claims into what it believed to be new and old features of garage door openers could the Federal Circuit conclude that Chamberlain’s claim to the entire physical machine was actually only “directed to wirelessly communicating status information about a system.” Pet. App. 7a. And only by isolating that one feature could the court further hold that the claims were “not limited to a specific implementation of a technological improvement to communication systems. Rather, they simply recite a system that wirelessly communicates status information.” Pet. App. 8a.

That conclusion ignores the many other elements of the claim—like its physical “moveable barrier operator,” “controller,” “moveable barrier interface,” “transmitter,” and the specific signals and signal identifiers that work in a specific way. And it actually says nothing about whether the claims *as a whole*—

that is, considering all of the subject matter that the inventor defined as the invention, and not just those pieces the court believes are an “advance over the prior art”—are directed to ineligible subject matter. Pet. App. 6a. It also distorts any inquiry into whether the claims preempt the use of an abstract idea. When the claim’s many limiting features are stripped away, of course the remainder seems expansive.

The Federal Circuit’s approach defies the statute’s text and structure and this Court’s precedent. To begin with, § 101 focuses on the inventive “machine” or “process,” not on any particular element of a patent’s claim. The Federal Circuit’s rejection of that plain language to give primacy to an individual claim element conflicts with the most basic rule about patent claims: that the entirety of the claim, and not any one element, defines the scope of the invention and the monopoly secured by the patent. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 344 (1961) (“[I]f anything is settled in ... patent law, it is that the combination patent covers only the totality of the elements in the claim and that no element, separately viewed, is within the grant.”); *see also, e.g., Cochrane*, 94 U.S. at 785-86 (explaining that the patent’s “improvement, therefore, does not consist in using drafts and currents of air, but in the process as a whole, comprising” a particular arrangement of components, and was patent eligible), cited in *Diehr*, 450 U.S. at 189 n.12. To determine what a claim is “directed to” and to assess its preemptive effect therefore requires an analysis of the *entire* claim, and does not allow artificial parsing into new and old elements. The Federal Circuit’s approach violates this basic rule

and improperly “ascrib[es] to one element of the patented combination the status of patented invention in itself.” *Aro*, 365 U.S. at 344-45.

The Federal Circuit’s approach also ignores the Patent Act’s structure, especially when it focuses its eligibility determination on “the claimed advance over the prior art.” Pet. App. 6a. That improperly imports other tests of validity into § 101. This Court has held that the determination, under § 101, of “what type of discovery is sought to be patented *must precede* the determination of whether that discovery is, in fact, new or obvious.” *Flook*, 437 U.S. at 593 (emphasis added). That is why this Court held in *Diehr* that those inquiries are not the province of § 101, but rather of § 102 (governing whether a claim is anticipated by prior art) and § 103 (governing whether a claim is obvious in light of prior art). *Diehr*, 450 U.S. at 189-91. “[A] new combination of steps in a process [or elements in a device] may be patentable even though all the constituents of the combination were well known and in common use before the combination was made.” *Id.* at 188. In light of these provisions, the novelty of any particular element (or the invention as a whole) “is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Id.* at 189; see *Bilski*, 561 U.S. at 602.

For example, *Diehr* involved an “improved process for molding rubber articles” which incorporated measuring the temperature inside a rubber press, coupled with a computer to process the measurements using a well-known mathematical formula. 450 U.S. at 181. Considering the claims as a whole, the Court held the

patent claims were not “directed to” an unpatentable “mathematical algorithm” but rather a useful process: a method of molding industrial rubber. *Id.* at 181, 192-93; *Bilski*, 561 U.S. at 611.

The majority in *Diehr* faulted the dissent for engaging in exactly the analysis the Federal Circuit now regularly undertakes: looking at whether “one or more of the” claim limitations is, “in isolation, ... novel or independently eligible for patent protection.” 450 U.S. at 181 n.15. That is “irrelevant to the question of whether the claims as a whole recite subject matter eligible for patent protection under § 101.” *Id.* The “new ... process” was not the mathematical formula reflected in one claim element; it was the whole invention. “To accept the analysis proffered by the petitioner” (and now followed by the Federal Circuit) “would, if carried to its extreme, make all inventions unpatentable because all inventions can be reduced to underlying principles of nature which, once known, make their implementation obvious.” *Id.* at 189 n.12.

Here, as in *Diehr*, the claims describe an invention that applies a particular technology (wireless communication) to a particular (and new) context in a way that improves upon physical machines (garage door openers). It bears mention that “wireless communication” is not an abstract idea to begin with, at least not of the sort that this Court has recognized before, such as mathematical algorithms (as in *Flook* and *Benson*) or “a method of organizing human activity” (as in *Alice* and *Bilski*). This erroneous expansion of the “abstract idea” category is itself entrenched in Federal Circuit precedent. *E.g.*, *DIRECTV*, 838 F.3d at 1258; *Affinity Labs of Texas, LLC v. Amazon.com*

Inc., 838 F.3d 1266, 1269 (Fed. Cir. 2016). But even setting that issue aside, these claims preempt nothing but a specific system with a particular combination of attributes: pairing wireless communication technology together with a controller and transmitter that process data in a very specific manner. *Supra* 8-9. The patent does not simply claim the concept of wireless communication. And it does not purport to monopolize all uses of wireless communication, or even all uses of wireless communication with garage door openers. The claims therefore do not implicate the preemption concerns driving § 101 jurisprudence. *Mayo*, 566 U.S. at 71. And the analysis should have ended at step one.

2. The error skews step two.

When the court improperly proceeded to step two, it skewed the analysis by, again, refusing to evaluate claims in their entirety, further divorcing § 101's implicit exceptions from their animating preemption concern.

Step two acts as a finer filter for undue preemption. It subjects claims to closer scrutiny, deeming eligible those that incorporate natural laws or abstract ideas more prominently (and so were not filtered into "eligibility" territory at step one), but that nonetheless pair those concepts with a specific, inventive component (and so pose no risk of undue preemption). *Alice*, 573 U.S. at 221-22. This step-two analysis reflects a critical distinction this Court has long drawn, even before refining its approach into a two-step process, between a particularized "application" of a natural law or abstract idea and an effort to monopolize

that law or idea in every application. *Benson*, 409 U.S. at 67.

On the eligible side of the line was the patent Alexander Graham Bell pressed in *The Telephone Cases*, 126 U.S. 1, 534-35 (1888). He claimed a specific telephone design—a particularized application of the principle that electricity can transmit sound. *Id.* His claim required “putting” electricity “into a certain specified condition.” *Id.* at 534. More recently, *Diehr* upheld claims to a specific process for curing rubber—a particularized application of the mathematical relationship among time, temperature, and rate of cure. *Supra* 20-21. In the language of step two, the claims in both these cases embraced an “inventive concept” beyond the natural law or abstract idea itself, *Alice*, 573 U.S. at 222, thereby narrowing the claimed monopoly and leaving room for others to devise their own applications.

On the ineligible side of the line, however, this Court has consistently rejected claims that capture *every conceivable* way of applying a natural law or abstract idea. The challenge is that inventors generally are not so bold as to declare, “I hereby claim all applications of idea X.” Sometimes, for example, they achieve the same result by purporting to narrow their monopoly to applying idea X in a specified “technological environment.” *Bilski*, 561 U.S. at 610. This Court has held that inventors cannot preempt the entire field with the artifice of such a “drafting effort designed to monopolize.” *Alice*, 573 U.S. at 221. The inventor must narrow the claim to a more particularized application within that field.

This principle too is moored in age-old law. *O'Reilly v. Morse* deemed ineligible Samuel Morse's claim to the "exclusive right to every improvement where the motive power is the electric or galvanic current, and the result is the marking or printing intelligible characters, signs, or letters at a distance." 56 U.S. 62, 112 (1853). Morse could patent his particular telegraph machine, but not every potential application of electromagnetism to the entire technological field of communications. *Id.* at 117. Similarly, when an inventor claimed *any* use of a formula for computing an updated alarm limit, this Court rejected the claim even though the inventor narrowed it to a particular field: "catalytic chemical conversion of hydrocarbons." *Flook* 437 U.S. at 586, 593.

Because the Federal Circuit refused to examine Chamberlain's claims as a whole, it misapplied the "technological environment" standard.² Plainly, Chamberlain did not claim *any* device—nor "*any* other method, and with *any* other combination," *Morse*, 56 U.S. at 117 (emphasis added)—for wirelessly communicating status information within the field of garage door openers. The claims instead require a particularized system, "a certain specified condition." *The Telephone Cases*, 126 U.S. at 534. Chamberlain chose to group the controller and wireless transmitter together, to incorporate them into the garage door opener rather than a separate module, and to require the controller and transmitter to

² Although the Federal Circuit placed this analysis under the "step one" heading, *Alice* makes clear that it belongs in step two. *See* 573 U.S. at 222-24.

signal status information in a particular form. *Supra* 8-9.

Given the Federal Circuit’s fragmentary claim analysis under § 101, however, none of that mattered. The court ignored those particularized claim elements and effectively asked only whether the claims fell *within* a specific “technological environment.” Pet. App. 10a. Of course they did. As the panel noted, the claims are confined to “the field” of “movable barrier operator[s],” *id.*, just as the claims in *The Telephone Cases* and *Diehr* were confined to the fields of electrified sound transmission and rubber curing. Most valid patent claims will be confined to a particular field of application. But that limitation, alone, does not make the invention unpatentable. The critical question is whether the claims—as in *Morse* and *Flook*—preempt *every imaginable* implementation of the abstract idea within that technological field, and so improperly monopolize the idea itself. The answer to that question here is no. But the Federal Circuit is asking the wrong question.

Relatedly, the panel suggested that the claims lack an inventive concept because they recite certain hardware “components”—like the controller and wireless transmitter—“in a generic way.” Pet. App. 11a. That was simply another way of warping the “technological environment” standard. Claims run afoul of § 101 when they specify technology so “generic” that it could encompass any application of an abstract idea within a given field. The classic example is a claim seeking to monopolize every use of a particular abstract idea just by performing it on a “generic computer.” *Alice*, 573 U.S. at 223-24. That is *Benson*: the

claims “purported to cover any use of the claimed method”—the algorithm for binary conversion—“in a general-purpose digital computer of any type.” 409 U.S. at 64. Chamberlain’s claims are not “generic” in that sense. They do not specify hardware and software configurations at such a high level as to preempt any conceivable implementation of wireless transmission regarding the status of a garage door. Again, however, the Federal Circuit missed this dispositive point because it dissected the claims and disregarded those elements that meaningfully narrow the invention’s scope.

C. The Federal Circuit’s errors are recurring and entrenched.

The Federal Circuit’s flawed approach to invalidating patents under § 101 is widespread and recurring.

The court routinely narrows step one by looking only to the “focus of the claimed advance.” *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 939 F.3d 1355, 1361 & n.2 (Fed. Cir. 2019) (quoting *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019) and collecting cases); *see, e.g., Genetic Techs. Ltd. v. Merial LLC*, 818 F.3d 1369, 1376 (Fed. Cir. 2016); *DIRECTV*, 838 F.3d at 1257; *Intellectual Ventures I LLC v. Capital One Fin. Corp.*, 850 F.3d 1332, 1338 (Fed. Cir. 2017); *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018).

This practice of ignoring swaths of the claim language to consider only a narrow subset of claim limitations has led to absurd results—in a wide range of

technologies from auto parts to treating antibiotic-resistant bacteria to radio communications to credit cards. Some examples:

- The Federal Circuit rejected claims to a method of making an automobile part requiring a hollow shaft and a liner to prevent undesirable vibrations in the car; it reduced these claims to “a directive to use one’s knowledge of Hooke’s law, and possibly other natural laws.” *Am. Axle*, 939 F.3d at 1362-64.
- The court found claims to a method of detecting and diagnosing antibiotic-resistant tuberculosis bacteria was merely “directed to naturally occurring phenomena,” even though the inventors had developed a unique DNA primer for detecting particular strains. *Roche Molecular Sys., Inc. v. CEPHEID*, 905 F.3d 1363, 1371-72 (Fed. Cir. 2018).
- The court ignored multiple physical and non-abstract radio frequency identification (RFID) components in claims to a system for improved automation and control of inventory; it found the claims were abstract because the novel elements were “directed to systems ‘for locating, identifying and/or tracking of an object using RFID components.’” *Automated Tracking Sols., LLC v. Coca-Cola Co.*, 723 F. App’x 989, 993 (Fed. Cir. 2018).
- The court rejected claims to a method of using personal bankcards or credit cards to directly

access mass transit systems—solving problems with how to use standard personal cards that cannot store information—as merely “directed to the collection, analysis, and classification of information.” *Smart Sys. Innovations, LLC v. Chi. Transit Auth.*, 873 F.3d 1364, 1373 (Fed. Cir. 2017).

By stripping out the detailed elements of these claims and isolating the eligibility analysis to a single element, the Federal Circuit’s § 101 jurisprudence threatens to “swallow all of patent law” in the very way this Court cautioned against. *Alice*, 573 U.S. at 217.

Also entrenched is the Federal Circuit’s step-two approach of applying the “technological environment” standard to invalidate claims drawn to a particularized invention within a broader field. For example, in *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1286-87 (Fed. Cir. 2018), the court invalidated claims to a particular way of creating and structuring a computer database using a particular type of “historical usage information” that made indexing more accurate. The Federal Circuit dismissed the inventors’ choice of particular database structures and inputs as “merely limit[ing] the abstract idea” at issue to the “particular technological environment” of computer databases. *Id.* But the claims did not cover *every* use of “historical usage information” to create and index a database, only uses with the particular claimed database structure, leaving ample room for others to devise their own applications within the same field.

The Federal Circuit blames this Court for the extra-statutory gloss it has adopted—insisting *Alice* demands it and “we are not permitted to do otherwise.” *Smart Sys.*, 873 F.3d at 1368 n.5. In truth, the Federal Circuit is exploiting this Court’s recognition of narrow exceptions—really limitations implicit in the statutory language—as an invitation to craft an expansive embellishment of the statute Congress wrote. This Court has repeatedly overruled the Federal Circuit’s similar forays into legislative redrafting. *E.g.*, *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 967 (2017) (laches for patent damages claims brought within the statute of limitations); *Bilski*, 561 U.S. at 602-04 (atextual limitations on what qualifies as a patentable process); *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1931-34 (2016) (extra-statutory bifurcated test for enhanced damages); *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749, 1755-58 (2014) (non-statutory framework for attorneys’ fees); *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007) (atextual test for obviousness). Like the others, this error will persist until this Court corrects it.

II. The Federal Circuit’s Approach To § 101 Threatens Innovation And Investment Across A Wide Range Of Technologies.

This is as close to a patent emergency as this Court has ever encountered. Patent issues do not get more foundational than this. The Federal Circuit is shutting the door on patent protection at the threshold for innovations across every sector. Manufacturing. Home appliances. Automotive. Computing.

Software. Diagnostics. Biotech. You name it, the Federal Circuit is gutting it. Never mind that the invention is novel—as the jury found Chamberlain’s invention to be (with the Patent Office also rejecting Techtronic’s novelty and obviousness arguments). Never mind that the invention is for a physical machine with specific configurations. None of that matters under the Federal Circuit’s test. The Federal Circuit is stripping protection from applications of a law of nature or abstract idea that are concrete and highly specific.

Think about what is next. Just about every home appliance is now making the sort of transition Chamberlain pioneered, from noncommunicative hunks of hardware to integrated and interactive “smart home” capability. But the ramifications extend far beyond the so-called “Internet of Things.” Every industry at the cutting edge is harnessing natural phenomena and abstract ideas, in some form or another, into inventive machines and processes. As one Federal Circuit judge has worried, “the danger of getting [§ 101] wrong is greatest for some of today’s most important inventions in computing, medical diagnostics, artificial intelligence, the Internet of Things, and robotics, among other things.” *Smart Sys.*, 873 F.3d at 1378 (Linn, J., concurring in part). Each of these burgeoning areas is especially vulnerable to the Federal Circuit’s misguided test, because of the ways in which they combine prior knowledge with improvements that can be mischaracterized as abstract.

There is now near unanimous agreement that this Court must intervene to make order out of this chaos. The United States has urged this Court to remedy the

“lower courts’ confusion about the proper application of Section 101 and this Court’s precedents.” U.S. Br. at 9, 16, *Hikma Pharm. USA Inc. v. Vanda Pharm. Inc.*, No. 18-817 (U.S. Dec. 6, 2019) (“*Hikma Br.*”); U.S. Br. 10, *HP Inc. v. Berkheimer*, No. 18-415 (U.S. Dec. 6, 2019) (“*Berkheimer Br.*”).

Multiple Federal Circuit judges are begging this Court to intervene. The judge who authored the opinion below, for example, has protested that this Court’s “inventive concept/point of novelty framework” is “largely incompatible with *Diehr*’s core rationale,” and pleaded for the “Supreme Court’s guidance as to whether it intended to override central tenets of *Diehr*.” *Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC*, 927 F.3d 1333, 1344 (Fed. Cir. 2019) (Chen, J., concurring in denial of rehearing en banc), cert. denied, 140 S. Ct. 855 (2020). Other judges find the step two “‘inventive concept’ requirement” to be “a baffling standard.” *Id.* at 1371 (O’Malley, J., dissenting from denial of rehearing en banc). They protest further that “[t]he law ... renders it near impossible to know with any certainty whether the invention is or is not patent eligible.” *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1348 (Fed. Cir. 2018) (Plager, J., concurring). So they have requested “further illumination ... from the Supreme Court.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 809 F.3d 1282, 1287 (Fed. Cir. 2015) (Dyk, J., concurring in denial of rehearing en banc); see *Berkheimer v. HP Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Lourie, J., concurring in the denial of rehearing) (“the law needs clarification by higher authority, perhaps by Congress, to work its way out of what so many in the innovation field consider are § 101 problems”).

Joining the chorus, the PTO has complained that “[p]roperly applying the *Alice/Mayo* test in a consistent manner has proven to be difficult.” 2019 Revised Patent Subject Matter Eligibility Guidance, 84 Fed. Reg. 50, at 50, 52 (Jan. 7, 2019). Consequently, the office has struggled to develop consistent guidelines for examiners to apply to pending patent applications. *Id.*

Just about every major industry has urged this Court to step in. *See HP Inc. v. Berkheimer*, No. 18-415 (digital file management); *ChargePoint, Inc. v. SemaConnect, Inc.*, No. 19-521 (electric vehicles); *Maxell, Ltd. v. Fandango Media, LLC*, No. 19-852 (video streaming); *Cisco Sys., Inc. v. SRI Int’l, Inc.*, No. 19-619 (antivirus software); *Hikma Pharm. v. Vanda Pharm.*, No. 18-817 (medical treatments); *Athena Diagnostics, Inc. v. Mayo Collaborative*, No. 19-430 (medical diagnostics); *Allvoice Devs. US, LLC v. Microsoft Corp.*, No. 15-538 (speech-to-text software); *Genetic Techs. Ltd. v. Merial L.L.C.*, No. 15-1518 (detecting specific portions of DNA); *Synopsys, Inc. v. Mentor Graphics Corp.*, No. 16-1288 (design of microchips); *Cleveland Clinic Found. v. True Health Diagnostics LLC*, No. 17-997 (blood testing). These Federal Circuit decisions were infected by one or more of the flaws featured in this petition (though, as discussed below, the petitioners have often focused elsewhere).

The clear consensus is that this is now an innovation emergency. Waiting any longer will inflict incalculable harm on U.S. industry. Commentators believe “current U.S. law governing patent eligibility puts us

behind China and Europe in life sciences and information technology—two critical technical areas for national competitiveness.” *The State of Patent Eligibility, Part I: Before the Subcomm. on Intellectual Property*, 116th Cong. (2019) (Comments of Former PTO Director David Kappos), <https://tinyurl.com/y6v9rnxx>; Kevin Madigan & Adam Mossoff, *Turning Gold into Lead: How Patent Eligibility Doctrine is Undermining U.S. Leadership in Innovation*, 24 *Geo. Mason L. Rev.* 939, 940 (2017) (reporting on empirical data suggesting “China and the European Union [may] become forerunners in securing the new innovation that drives economic growth and flourishing societies” as a result of limitations on patent eligibility).

This Court fully understands that robust patent protection has been the engine of the United States’ technological dominance. Unpredictability is the enemy of innovation. As the Chief Intellectual Property Counsel of Johnson & Johnson testified, “[i]t is only because of the United States patent system, and the predictability that it has historically provided, that we have been able to make the investments, conduct the research, and take the risks required to develop” new solutions to the most challenging problems and “develop the groundbreaking treatments of tomorrow.” *The State of Patent Eligibility in America, Part III: Before the Subcomm. on Intellectual Property*, 116th Cong. (2019), <https://tinyurl.com/y7oc8nac> (written testimony of Robert Deberardine). “[W]ithout patent protection, there will be little incentive for companies to invest the monumental amount of time and money necessary to develop diagnostic kits, tools and techniques,” *Athena*, 927 F.3d at 1357 (Moore, J.,

dissenting from denial of rehearing en banc), or any of the other areas that are poised to explode.

Right now, the tech sector is responding to the Federal Circuit's gutting of patent protection, and the uncertainty surrounding § 101 by directing money "away from areas that are more difficult to protect," like medical diagnostics and bioscience advances, "and toward research where trade secrets are more viable," where the inventions and discoveries do not contribute to public knowledge. Jeffrey A. Lefstin, et al., *Final Report of the Berkeley Center for Law & Technology Section 101 Workshop: Addressing Patent Eligibility Challenges*, 33 *Berkeley Tech. L.J.* 551, 583-84 (2018). Investment is drying up in every cutting edge sector of technology, medicine, artificial intelligence, quantum computing, networking, manufacturing, internet-connected devices, 5G, and more. See David J. Kappos, *National Security Consequences of U.S. Patent (In)eligibility*, Morning Consult (Nov. 4, 2019), <https://tinyurl.com/ycbmc2bq> (noting increasing numbers of patents claiming artificial intelligence, quantum computing and 5G wireless technology are rejected under § 101).

III. This Case Is An Ideal Vehicle To Correct The Federal Circuit's § 101 Jurisprudence.

Given the consensus that the Federal Circuit's jurisprudence is a mess and the ramifications for American innovation are profound, this Court's review is desperately needed. Previous petitions have variously sought too much or too little. Some have blamed this Court for the confusion and urged it to overrule its precedents. See *Trading Techs. Int'l v. IBG*, Nos. 19-

353, 19-522 (cert. denied); *ChargePoint v. SemaConnect*, No. 19-521 (cert. denied). Others have presented more trivial aspects of § 101 confusion, such as procedural quirks or issues specific to one industry or even one patent. See *HP Inc. v. Berkheimer*, No. 18-415 (question about standard of review); *Garmin USA v. Cellspin Software*, No. 19-400 (same); *Hikma Pharms. v. Vanda Pharms.*, No. 18-817 (question specific to medical diagnostics); *Athena Diagnostics v. Mayo Collaborative Servs.*, No. 19-430 (same); *Maxell v. Fandango Media*, No. 19-852 (question about specific claims in a patent). Most were infected with vehicle problems.

This is a Goldilocks petition, in the right vehicle. We are not asking the Court to overrule the implicit exceptions to § 101, which “have defined the reach of the statute as a matter of statutory stare decisis going back 150 years.” *Bilski*, 561 U.S. at 602. And we are not raising procedural puzzles, best reserved for after this Court addresses § 101’s substantive reach. Instead, the clarification sought here—to reaffirm that courts must evaluate the claims “as a whole” and tether the § 101 inquiry to the preemption concerns embodied in the statute and the Constitution—targets the analytical misstep that has led the Federal Circuit down the wrong path in so many recent cases and will greatly reduce the confusion surrounding § 101 without a complete overhaul of established jurisprudence.

The Solicitor General’s recent invitation briefs have prescribed several criteria of the ideal vehicle for clarifying § 101. This case meets every one of those criteria.

First, “the current uncertainty” surrounding § 101 “stems from both steps in [the *Alice/Mayo*] framework.” *Berkheimer* Br. at 18. Because the Federal Circuit addressed both—and conflated them in at least one respect, *supra* 24 n. 2—this petition provides an opportunity to clarify both, without requiring a complete reworking or abandonment of that framework.

Second, this is “a case in which lower courts’ confusion about the proper application of Section 101 and this Court’s precedents makes a practical difference.” *Hikma* Br. at 9. There are no remaining validity issues to resolve in this case. A jury found Chamberlain’s claims novel and nonobvious, and the district court denied Techtronic’s post-trial motions. *Supra* 10-11. Thus, the jury verdict rises or falls on this Court’s ruling as to whether the claims are patent-eligible. *Compare Berkheimer* Br. at 15 (arguing case was a poor vehicle because other invalidity questions remained).

Third, there are no disputes that would “significantly impede, [or] complicate, efforts to clarify broader Section 101 principles in this case.” *Berkheimer* Br. at 10. The parties agree that Chamberlain’s claims cover a particular arrangement of physical parts, and there are no outstanding issues of claim construction to be resolved. Accordingly, the case affords the Court the opportunity to clarify and apply revised § 101 principles without necessitating remand or delving into claim construction issues best resolved by the lower courts.

Fourth, everyone knows what a garage door opener is, and remote controls and wireless communication are easy to understand. The technology at issue thus offers the Court the opportunity to clarify § 101 in the context of a “more familiar type[] of innovation[],” rather than “attempting to clarify” § 101’s “overarching principles in a comparatively unfamiliar context.” *Berkheimer* Br. at 16-17. This is not a case like *Berkheimer* or *Cisco Sys.*, involving pure software implemented on a computer. Yet, despite the simplicity of the technology, the § 101 principles presented in this petition will be broadly applicable to nearly all technologies and clarify § 101 for inventors and investors in many industries.

CONCLUSION

The Court should grant the petition.

Respectfully submitted,

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