

No. _____

**In The
Supreme Court of the United States**

NETSCOUT SYSTEMS, INC., NETSCOUT SYSTEMS
TEXAS, LLC, fka TEKTRONIX TEXAS, LLC
dba TEKTRONIX COMMUNICATIONS,

Petitioners,

v.

PACKET INTELLIGENCE LLC,

Respondent.

**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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QUESTIONS PRESENTED

This case presents unresolved issues regarding proof of willfulness, an allegation that arises regularly in patent litigation, and the standard for determining when technological subject matter is eligible for patent protection, another recurring issue. These issues are critically important for technology companies across the United States, like NetScout, which lead their industries by offering innovative new products but face uncertainty in how to respond properly to patent infringement claims.

The patent laws provide that courts “may increase the damages up to three times the amount found or assessed.” 35 U.S.C. § 284. This Court has held that these enhanced damages are available as a “‘punitive’ or ‘vindictive’ sanction for egregious infringement behavior.” *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1932 (2016). “[E]gregious infringement behavior” is often referred to as “willful infringement” or “willfulness.” *Ibid.*

With respect to willful infringement, the questions presented are:

1. Whether a finding of willful infringement justifying treble damages may be based solely on the defendant’s conduct following the filing of the suit.
2. If the defendant’s post-filing conduct can provide a basis for willful infringement, whether such a finding is adequately supported by evidence

that (1) high-level executives did not read the asserted patents in detail but instead relied upon conversations with counsel to confirm good-faith and reasonable defenses; and (2) the defendant continued to sell the accused products while suit was pending, in reliance on its good-faith defenses.

This case also provides a vehicle for this Court to provide guidance on an important and recurring aspect of patent eligibility under 35 U.S.C. § 101.

With respect to Section 101, the question presented is:

3. Whether a purported solution to a technological problem is necessarily eligible for patent protection and cannot be directed to an abstract idea.

**PARTIES TO THE PROCEEDINGS AND
RULE 29.6 STATEMENT**

The parties to the proceedings include those listed on the cover.

BlackRock Inc. owns 10% or more of NetScout Systems, Inc. NetScout Systems Texas, LLC is a wholly-owned subsidiary of NetScout Systems, Inc.

RELATED PROCEEDINGS

United States District Court (E.D. Tex.):

Packet Intelligence LLC v. NetScout Sys., Inc.,
No. 2:16-cv-00230-JRG (Sept. 7, 2018)

United States Court of Appeals (Fed. Cir.):

Packet Intelligence LLC v. NetScout Sys., Inc.,
No. 19-2041 (July 14, 2020), petition for
reh'g denied, Oct. 16, 2020

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PETITION FOR A WRIT OF CERTIORARI

Petitioner NetScout respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS AND ORDERS BELOW

The panel opinion affirming-in-part and reversing-in-part the district court's judgment (App. 1a-42a) is reported at 965 F.3d 1299. The opinion and order of the district court denying judgment as a matter of law of no willful infringement (App. 178a-201a) is unreported and available at 2019 WL 2375218. The opinion and order of the district court denying partial judgment of patent ineligibility (App. 68a-114a) is unreported and available at 2019 WL 2330059.

STATEMENT OF JURISDICTION

The court of appeals filed its opinion on July 14, 2020, and denied each parties' respective petitions for rehearing on October 16, 2020. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 101 of Chapter 35 of the United States Code (the "Patent Act") 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.

Section 284 of the Patent Act provides, in pertinent part:

Upon finding for the claimant the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty for the use made of the invention by the infringer, together with interest and costs as fixed by the court.

When the damages are not found by a jury, the court shall assess them. In either event the court may increase the damages up to three times the amount found or assessed.

SUMMARY OF THE ARGUMENT

This petition presents the Court with the opportunity to resolve important, unsettled issues of patent law.

The first two questions presented concern the test for willful infringement, a finding that permits a court to award enhanced damages, potentially trebling a plaintiff's recovery. Although this Court has cautioned that enhanced damages are reserved only for "egregious cases," *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1932 (2016), in practice, requests for enhanced damages are routine. And when included in the verdict form, "[a] majority of juries have found any infringement to be willful." See Rachel Weiner Cohen, et al., *The Halo Effect: Willful Infringement and Enhanced Damages in Light of Halo*, 69 Am. U. L. Rev. 1067, 1085 (2020).

Before this Court's 2016 decision in *Halo*, the Federal Circuit recognized that willfulness "in ordinary circumstances . . . will depend on an infringer's prelitigation conduct." *In re Seagate Tech., LLC*, 497 F.3d 1360, 1374 (Fed. Cir. 2007); see also *id.* ("[W]illful infringement in the main must find its basis in prelitigation conduct."). Enhanced damages are neither necessary nor appropriate to address post-filing conduct because the plaintiff may "move for a preliminary injunction, which generally provides an adequate remedy for combating post-filing willful infringement." *Ibid.* "A patentee who does not attempt to stop an accused infringer's activities in this

manner should not be allowed to accrue enhanced damages based solely on the infringer's post-filing conduct." *Ibid.*

In *Halo*, this Court overturned *Seagate's* test for willfulness, without addressing this portion of *Seagate's* analysis. And in the wake of *Halo*, the Federal Circuit has steadfastly refused to clarify whether willfulness requires pre-suit misconduct.

As a result, the district court decisions addressing this issue have been mixed. Some have refused attempts to base willfulness on post-filing conduct. Others—like the decision below—have permitted willfulness (and enhanced damages) based solely on a defendant's post-filing conduct during the course of litigation. Both conflicting lines of cases have been affirmed by Federal Circuit panels without any attempt to harmonize them. And when the Federal Circuit was provided with an opportunity to resolve this question in *Mentor Graphics Corp. v. EVE-USA, Inc.*, 851 F.3d 1275 (Fed. Cir. 2017), it declined to do so. This state of affairs leaves the law on this recurring issue uncertain, causes the district courts to issue conflicting decisions, and deprives companies like NetScout of guidance on how they should act when sued for patent infringement.

The standard for willfulness is critically important, potentially exposing defendants to millions (or even tens or hundreds of millions) of dollars in additional liability. The issue recurs frequently, and

the Federal Circuit has not provided clarity. This Court should grant certiorari.

Moreover, if *Halo* truly allows willfulness to be based on post-filing conduct, then it becomes critically important for this Court to provide guidance for defendants as to what conduct would support such a finding.

Here, NetScout did not violate any rule of court, disobey any order of the judge, or engage in any other post-filing misconduct. The trial court found that NetScout had asserted good faith defenses for non-infringement and invalidity.

Nonetheless, the decision below held that NetScout engaged in “egregious infringement behavior” because of evidence that (1) its senior executives did not read the patents in sufficient detail; and (2) it continued to sell the accused products during the litigation in reliance on its good-faith noninfringement and invalidity defenses. If such conduct truly exposes defendants to the risk of treble damages, then this Court should say so clearly and unambiguously. Defendants should not be found willful based on post-filing conduct running afoul of some unwritten and inconsistently applied standard.

The third question presented concerns Section 101. Although this Court has recently denied petitions in this area, this case provides a vehicle for this Court to provide narrow but important guidance

regarding application of this Court’s patent eligibility standard to technological patents. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217-18 (2014) (“First, we determine whether the claims at issue are directed to [a] patent ineligible concept. If so, we then ask, ‘what else is there in the claims before us?’”) (citations omitted).

Federal Circuit decisions often (but not always) draw a false dichotomy between patents that purport to solve a technological problem and patents directed to an abstract idea. Some Federal Circuit decisions apply a “technological problem” test, finding any claim directed to solving a technological problem to be non-abstract and patent eligible. As a result, and as the decision below illustrates, this Federal Circuit test holds eligible patents that claim the abstract idea of a conceptual solution to a technological problem.

Here, the patents purport to solve a technological problem relating to monitoring computer networks. According to the patents, prior art network monitors classified data packets into “connection flows.” These “connection flows” are defined by the ports and addresses of the source and destination computer equipment for each packet in the flow. But, according to the patent, an “activity” may involve multiple, distinct “connection flows.” Prior art network monitors purportedly could not recognize these different connection flows as related.

The asserted patents purport to solve this problem by grouping together the packets from multiple connections flows that all involve an activity. The patent uses the coined term “conversational flow” to refer to all of the related connection flows.

But rather than claim a specific method of recognizing “conversational flows,” the patents claim the idea of doing so. The claims recite the standard components of a conventional network monitor and then claim identifying conversational flows, regardless of the means by which this identification is achieved.

The majority resolved the eligibility question by finding that because the patents are directed to a “technological solution to a technological problem,” they cannot be directed to an abstract idea. This “technological problem” test has created confusion and uncertainty, and certiorari is warranted for this Court to address the Federal Circuit’s application of *Alice* to technological patents.

NetScout respectfully requests that this Court grant certiorari on the questions regarding willfulness and the question regarding Section 101.

STATEMENT

I. Legal Background

When a defendant is found liable for patent infringement, by statute, the court “may increase the damages up to three times the amount found or assessed.” 35 U.S.C. § 284.

Five years ago, in *Halo*, this Court addressed the meaning of this provision and the circumstances in which these enhanced damages should be awarded.

This Court explained that “[e]nhanced damages are as old as U.S. patent law.” *Id.* at 1928. Under current law, this enhancement is discretionary. *Id.* at 1931 (“[T]he ‘word ‘may’ clearly connotes discretion.”). But a district court’s discretion is not boundless. *Ibid.*

Enhanced damages are available as a “‘punitive’ or ‘vindictive’ sanction for egregious infringement behavior,” when an infringer engages in conduct that is “willful, wanton, malicious, bad-faith, deliberate, consciously wrongful, flagrant, or—indeed—characteristic of a pirate.” *Id.* at 1932.

Before 2007, the Federal Circuit applied a duty-of-care standard to determine whether a patent infringement verdict warranted enhancement. See, e.g., *Underwater Devices Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389-90 (Fed. Cir. 1983). Under this standard, once a party was on notice of another’s

patent rights, the party had the obligation to exercise “due care” to determine whether it was infringing. *Ibid.* After receiving notice, a party had “the duty to seek and obtain competent legal advice from counsel *before* the initiation of any possible infringing activity.” *Id.* at 1390 (emphasis in original). Only if it received an exculpatory opinion of counsel before initiating the potential infringing activity could a party proceed with confidence that it had not acted willfully. This provided clear guidance on how to behave pre-suit.

But even under this earlier “duty of care” rubric, it was unclear what was required of a party who first learned of a patent in an infringement complaint filed in court. To rebut a claim of willfulness, some parties relied on the assertion of good-faith litigation defenses while others sought out and relied on a written opinion of counsel.

In 2007, the *en banc* Federal Circuit abrogated the duty-of-care standard in *Seagate*. It replaced the duty of care with a two-part test with objective and subjective prongs. 497 F.3d at 1371. To prove willfulness, the patentee was first required to “show by clear and convincing evidence that the infringer acted despite an objectively high likelihood that its actions constituted infringement of a valid patent.” *Ibid.* The patentee was then required to demonstrate, also by clear and convincing evidence, that the risk of infringement “was either known or so obvious that it should have been known to the accused infringer.” *Ibid.*

Seagate's objective prong eliminated the requirement that defendants develop defenses or obtain a written opinion of counsel before suit. As long as a defendant could present an objectively reasonable noninfringement or invalidity argument at trial, the defendant could not be found willful.

As noted above, in *Seagate*, the Federal Circuit recognized that willfulness generally “depends on an infringer’s prelitigation conduct.” 497 F.3d at 1374. Post-filing conduct could be addressed by way of injunctive relief, and a patentee who chose not to pursue such relief was not allowed to benefit from that decision by recovering enhanced damages based solely on post-filing conduct. *Ibid.*

In *Halo*, this Court rejected the *Seagate* two-prong test as “unduly rigid” because it “mak[es] dispositive the ability of the infringer to muster a reasonable . . . defense at the infringement trial.” 136 S. Ct. at 1932-33. The *Seagate* standard, this Court explained, “excludes from discretionary punishment many of the most culpable offenders, such as the ‘wanton and malicious pirate’ who intentionally infringes another’s patent—with no doubts about its validity or any notion of a defense—for no purpose other than to steal the patentee’s business.” *Id.* at 1932. In rejecting *Seagate*, this Court explained that “culpability is generally measured against the knowledge of the actor at the time of the challenged conduct.” *Ibid.*

Halo did not, however, address *Seagate's* analysis of post-filing conduct. This has created uncertainty regarding whether (and when) a defendant can act willfully when it first learns of the alleged infringement from a complaint, a common occurrence.

II. Proceedings Below

On March 15, 2016, without providing NetScout with any prior notice of its allegations, Packet Intelligence sued NetScout for infringement of U.S. Patent Nos. 6,954,789 (“the ’789 patent”), 6,665,725 (“the ’725 patent”), and 6,839,751 (“the ’751 patent”), and two other patents not at issue here, in the Eastern District of Texas.

Packet Intelligence agreed that claim 19 of the ’789 patent is representative of the asserted claims, and this was the claim the district court focused on for its Section 101 analysis. App. 78a. Claim 19 relates to using a packet monitor to collect packet information flowing through a network, to compare information in collected packets to other stored information, and to classify the packets as belonging to the same “conversational flow” as other packets. The specification explains that “[w]hat distinguishes this invention from prior art network monitors is that it has the ability to recognize disjointed flows as belonging to the same conversational flow.” App. II-142.

After being sued for infringement of Packet Intelligence’s patents, NetScout’s executives did

what was appropriate under the circumstances: they assessed the claims and worked with their in-house counsel to retain and consult with specialized outside counsel and technical experts to evaluate whether the company disputed the infringement claim and, if so, to develop and present noninfringement and invalidity defenses. App. 131a-133a.

Packet Intelligence did not allege copying. The accused products were designed years before Packet Intelligence provided NetScout with notice of its claims through its complaint. App. 206a; App. 211a-213a.

The case proceeded to trial. Following a week-long jury trial in the Eastern District of Texas, the jury found that NetScout infringed the asserted patents. Like most juries presented with a verdict form asking whether any infringement had been willful, the jury found that it had. See Cohen, et al. at 1085 (“A majority of juries have found any infringement to be willful.”). Of the over \$15 million sought by Packet Intelligence, the jury awarded \$3.5 million in pre-suit damages and \$2.25 million in post-suit damages. C.A. Appx121. After trial, Packet Intelligence sought and obtained an ongoing royalty for future sales of the accused products.

After trial, NetScout renewed its motion for judgment as a matter of law on willfulness. NetScout argued that there was insufficient evidence to support the willfulness finding because there was no evidence of copying or intent to harm,

it had no pre-suit knowledge of Packet Intelligence's patents, and NetScout's noninfringement and invalidity arguments were presented in good faith. App. 198a.

It was undisputed that NetScout was unaware of Packet Intelligence's infringement allegations until suit, so there were no allegations of pre-suit misconduct. App. 209a; App. 211a-213a. NetScout argued there was also no evidence of post-filing conduct that could provide a reasonable jury with a basis to find that NetScout willfully infringed. App. 198a.

The district court denied NetScout's motion, even though it found that NetScout had relied upon and presented reasonable and good-faith defenses throughout the case and at trial. App. 131a-132a. Its denial was based on two pieces of evidence.

First, the district court noted evidence regarding the extent to which NetScout's senior executives personally studied the asserted patents. App. 199a-200a. NetScout's CEO, Anil Singhal, testified he read the patents "at a high level and enough to have a good discussion with my Counsel." App. 215a-216a. And NetScout's President of New Markets, Richard Kenedi—a marketing executive with no legal training who took the stand simply to provide background on the company—testified that he did not personally read the patents but instead relied upon consultation with "the experts within"

NetScout and “both internal and external counsel[.]” App. 209a; App. 210a.

Second, the district court noted that NetScout continued to sell the accused products after it was sued. App. 199a-200a. Notably, there was no injunction in place (or even an injunction requested by Packet Intelligence) that prohibited NetScout from selling the accused products. Packet Intelligence does not make or sell any products and would not be impacted by any ongoing sales. Rather, after trial, Packet Intelligence sought and secured a compulsory royalty on any ongoing sales.

Based solely on these two forms of post-filing conduct, the district court denied NetScout’s motion for judgment as a matter of law on willfulness. App. 178a-179a; App. 150a-151a. Having accepted the jury’s willfulness finding, the district court enhanced the jury’s damages award by \$2.8 million. App. 144a-145a; App. 124a-125a.

NetScout also contended that the asserted patents were invalid because they were directed to ineligible subject matter. NetScout argued that the patents are directed to the abstract idea of collecting, comparing, and classifying packet information. App. 103a. NetScout also argued that the asserted claims recited elements that were nothing more than the conventional components found in network monitors arranged in the conventional manner. App. 111a. The claims describe a conventional mon-

itor but simply recite that the monitor is used to classify “conversational flows” instead of “connection flows.”

The district court determined that the claims were not directed to an abstract idea but instead that “the claims as read in the context of the specification” “are directed to an improvement in computer functionality rather than an abstract idea.” App. 109a.

On appeal, among other issues, NetScout challenged both the willfulness and eligibility determinations. The Federal Circuit affirmed both in an opinion authored by Judge Lourie, joined by Judge Hughes, with Judge Reyna dissenting regarding eligibility.

With respect to willfulness, NetScout raised on appeal the same arguments as in its motion for judgment as a matter of law: all of the allegedly “willful” conduct at issue occurred post-filing and was not wrongful.

The Federal Circuit affirmed, relying on the same evidence as the district court. The panel cited the trial testimony of NetScout’s executives and the continued sales of accused products. App. 31a-32a. Based on this evidence, the panel held that the jury’s finding of willfulness was supported by legally sufficient evidence.

The Federal Circuit majority also affirmed the determination that the claims are eligible for patent protection under Section 101. App. 15a. The majority reasoned that the claims are not directed to an abstract idea because they “meet a challenge unique to computer networks” and “solve[] a technological problem.” App. 17a. Having determined that the claims are not directed to an abstract idea under Step 1 of *Alice*, the majority did not address whether, under Step 2 of *Alice*, the claims include an inventive concept. App. 19a.

Judge Reyna dissented on the grounds that the asserted claims lacked a “concrete technological solution” and therefore failed at *Alice* Step 1. See App. 33a-42a. He explained that the claims needed to be examined at *Alice* Step 2 to determine “whether the components and operations recited in each claim contain anything inventive beyond the abstract concept of classifying by conversational flow.” App. 41a.

Unrelated to the present petition, the panel reversed the award of pre-suit damages on the ground that Packet Intelligence failed to comply with the marking statute. 35 U.S.C. § 287(a). The panel vacated the compensatory and enhanced damages and remanded both for recalculation.

Both parties filed combined petitions for panel rehearing and rehearing en banc. The Federal Circuit denied both petitions on October 16, 2020.

NetScout now petitions for certiorari.

REASONS FOR GRANTING THE PETITION

I. This Court Should Grant Review To Decide Whether Willfulness Can Be Based Solely On Post-Filing Conduct.

In *Halo*, this Court rejected the Federal Circuit's *Seagate* test, which allowed an infringer who engaged in pre-suit misconduct to avoid a finding of willfulness by presenting reasonable defenses during suit. 136 S. Ct. at 1932-33. Although *Halo* made clear that pre-suit willful misconduct could not be cured by asserting plausible trial defenses, it did not address whether willfulness could be based on post-filing conduct alone. This situation recurs frequently, as it arises whenever there is no pre-suit knowledge of the patent or of the alleged infringement.

This unsettled issue has resulted in conflicting court opinions and uncertainty for plaintiffs and defendants alike. See Cohen, et al. at 1082 (discussing inconsistent court opinions addressing whether pre-suit knowledge of the infringed patent is a prerequisite for willfulness).

In a section of *Seagate* not addressed by this Court in *Halo*, the Federal Circuit held that “willful infringement in the main must find its basis in pre-litigation conduct.” *Seagate*, 497 F.3d at 1375. Believing this Federal Circuit guidance to still control, many district courts have held that a claim of willful

infringement must be dismissed absent an allegation that the accused infringer knew of the patent before the filing of the lawsuit. See, e.g., *Software Research, Inc. v. Dynatrace LLC*, 316 F. Supp. 3d 1112, 1137 (N.D. Cal. 2018) (dismissing complaint’s claim for willful infringement where there were no allegations of pre-suit knowledge of the patent); *Wis. Alumni Research Found. v. Apple, Inc.*, 261 F. Supp. 3d 900, 917-18 & n.6 (W.D. Wis. 2017), *aff’d in part, rev’d in part*, 905 F.3d 1341 (Fed. Cir. 2018) (same); *Välinge Innovation AB v. Halstead New England Corp.*, No. 16-1082-LPS-CJB, 2018 WL 2411218, at *13 (D. Del. May 29, 2018) (same).

But because the Federal Circuit has not squarely affirmed this understanding, other district courts have taken the opposite view. These decisions often cite a post-*Halo* opinion of the Federal Circuit, where the panel declined to resolve the split in district court authority, yet noted there is no “rigid rule” that a party must seek a preliminary injunction before “seek[ing] enhanced damages.” *Mentor Graphics Corp. v. EVE-USA, Inc.*, 851 F.3d 1275, 1295-96 (Fed. Cir. 2017). Viewing this as an implicit abrogation of *Seagate*’s admonition that willfulness is mainly focused on pre-suit conduct, these courts allow willfulness to be based entirely on conduct that occurs after the filing of the complaint. See, e.g., *Apple Inc. v. Samsung Elecs. Co., Ltd.*, 258 F. Supp. 3d 1013, 1027 (N.D. Cal. 2017) (“[P]ost-filing conduct alone can serve as the basis of a jury’s willfulness

finding and an award of enhanced damages.”); *Ericsson Inc. v. TCL Commc'n Tech. Holdings, Ltd.*, No. 2:15-cv-00011-RSP, 2017 WL 5137401, at *5 (E.D. Tex. Nov. 4, 2017) (same); *Vaporstream, Inc. v. Snap Inc.*, No. 2:17-cv-220, 2020 WL 136591, at *20 (C.D. Cal. Jan. 13, 2020) (same).

These conflicting interpretations of *Halo* have led to different results on the same fact pattern. At the moment, the availability of enhanced damages based on post-filing conduct depends on which judge is presiding over the case or in which district court the plaintiff files suit. The Federal Circuit has refused, in this case and others, to clarify the standard, leaving the district courts divided. Guidance from this Court is necessary.

In NetScout’s view, the right answer is that willful infringement must be based on wrongful pre-suit conduct. If a defendant had no pre-suit notice of the plaintiff’s infringement allegations, willful infringement did not occur.

Although patent law has long held an infringer to account for deliberate and wanton infringement before suit, willfulness provides an inapt standard to govern the conduct of parties in litigation, where the issue of infringement is fully joined. During suit, rules are already in place to prevent frivolous defenses, and remedies (such as sanctions) are available to punish and compensate for a litigant’s misconduct. And the question whether a defendant may continue to sell an accused product

while suit is pending should be determined by a judge deciding whether to issue a preliminary injunction, not by the threat of a jury deciding willfulness. Once the complaint is filed, the law of willfulness should give way to the long-settled rules and procedures of the federal courts.

If NetScout is wrong, parties and courts would benefit from the certainty that would come from this Court clearly holding that post-filing conduct, alone, may justify a willfulness finding, and, as NetScout addresses below, explaining what conduct could justify such a finding.

Without guidance from this Court, the uncertainty in the law will remain. The Federal Circuit has affirmed district court opinions adopting conflicting approaches and has refused the opportunity to resolve this question when it was presented in *Mentor Graphics* and subsequent cases (like the decision below). Further percolation will not resolve the issue.

This case is an appropriate vehicle to resolve this question. The issue is squarely presented: all of the evidence of willfulness occurred post-filing. Indeed, it was undisputed that NetScout was not aware of Packet Intelligence's infringement allegations until the filing of the complaint. App. 198a. If, as NetScout contends, willfulness must be based on pre-suit conduct, then there is no question that NetScout did not willfully infringe and cannot be subject to enhanced damages.

II. If Willfulness Can Be Based On Post-Filing Conduct, This Court Should Clarify What Post-Filing Conduct Is Sufficient For Willfulness.

If post-filing conduct alone can be sufficient for willfulness, then this Court should address what post-filing conduct can constitute “egregious infringement behavior” that would warrant enhanced damages.

In particular, on the facts of this case, this Court should address whether, to avoid a finding of willfulness, a defendant must: (1) have each of its executives personally read each of the asserted patents in detail; and (2) cease sales of the accused products as soon as the complaint is filed, even when the defendant has good-faith defenses and the plaintiff has not sought an injunction.

To be clear, apart from the decision in this case, NetScout is aware of no authority requiring either. Neither the plaintiff nor the courts below cite any authority supporting the conclusion that these activities evidence willfulness.

This is an area in which the rules must be certain. Defendants should know what they must (and must not) do during the course of patent litigation to avoid the risk of a willfulness finding and punitive enhanced damages.

But the Federal Circuit’s jurisprudence fails to provide sufficient clarity for defendants to rely

upon in guiding their behavior. Even the most conscientious and prudent in-house counsel is left to guess at how to proceed during the course of litigation.

The rules regarding whether executives must personally read the patents are unclear. In a prior decision, the Federal Circuit reversed a finding of willfulness that was based on the failure of allegedly “key” employees to analyze the patents, correctly holding that it was “unremarkable” given their lack of legal training. *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1308-09 (Fed. Cir. 2019) (vacating willfulness finding and enhanced damages). In contrast, the decision below concluded that the failure of NetScout’s senior executives to analyze the patents in detail was evidence that a reasonable jury could rely upon to find that NetScout willfully infringed.

Nor has the Federal Circuit provided consistent guidance on whether a defendant must cease selling an accused product during suit. Several cases, unlike the decision below, have correctly recognized that ongoing sales of the accused products while a lawsuit is pending constitutes ordinary—not willful—patent infringement. See, e.g., *Gustafson, Inc. v. Intersystems Indus. Prods., Inc.*, 897 F.2d 508, 511 (Fed. Cir. 1990).

Because the Federal Circuit’s cases are inconsistent, guidance is needed from this Court.

A. This Court Should Address Whether A Company’s Executive Team Needs To Review In Detail The Asserted Patents While Suit Is Pending.

Before the panel’s decision, the Federal Circuit had held it was “unremarkable” that employees without legal training had not analyzed the patents. In *SRI International*, the district court denied judgment as a matter of law on willfulness based on “evidence that key . . . employees did not read the patents-in-suit” before testifying. 930 F.3d at 1308-09. On appeal, the plaintiff “ma[de] much of the fact that ‘key engineers’ did not look at [the plaintiff’s] patents,” alleging that failing to look at the patents constituted willful disregard. *Id.* at 1309. The panel readily (and, NetScout believes, correctly) rejected this argument, explaining that “[g]iven [the defendant’s] size and resources, it was unremarkable that the engineers—as opposed to [] in-house or outside counsel—did not analyze the patents-in-suit themselves.” *Ibid.*

The decision below reaches the opposite conclusion, holding that executives’ failure to review the patents evidences willful infringement. Such a holding (and conflict in the cases) creates uncertainty for defendants and their counsel and creates significant burdens on companies, unduly diverting attention from their business.

Here, NetScout’s testifying executives were neither legally trained nor called to offer an opinion regarding patent infringement or NetScout’s defenses. Mr. Singhal and Mr. Kenedi merely testified regarding the history and corporate structure of NetScout. App. 209a; App. 206a; App. 215a-216a; App. 211a-213a. Mr. Singhal provided historical context and background for NetScout’s pioneering development of network monitoring technology, and Mr. Kenedi testified about corporate history, the company’s independent development of the accused products, and the failure of Packet Intelligence to provide pre-suit notice.¹

Neither witness offered (nor was in a position to offer) a detailed explanation of NetScout’s legal defenses. There was no reason for either witness to have reviewed and studied the patents before testifying on unrelated matters.

If, as the panel held, evidence that these witnesses did not personally study the patents in detail was evidence of willfulness, then prudence will require every executive at a company accused of in-

¹ Mr. Kenedi testified about NetScout’s defenses only when cross-examined by opposing counsel and only to express “[his] belief through [] Counsel that the claims against NetScout are false.” App. 209a. Mr. Kenedi made clear that this belief “[was] formed from both internal and external counsel,” not from his own expertise or his own personal knowledge. *Id.*

fringement who might be a witness to study the patents at issue. Such a rule is facially unworkable, particularly when applied to a global public corporation such as NetScout.

Mr. Singhal testified at trial that he had reviewed the asserted patents “at a high level” that was “enough to have a good discussion with [his] [c]ounsel.” App. 215a-216a. Companies hire experts—such as outside counsel—because they rely on and trust their advice and judgment. A holding that senior executives of large companies cannot rely on lawyers but must instead personally review and analyze every patent that the company is accused of infringing would be disruptive and unworkable.

If post-filing conduct can provide the basis for willfulness, this Court should address what company executives must personally learn and understand about the patents during suit. This case provides the right vehicle. The issue is squarely presented: after learning about the infringement claims, NetScout’s CEO, Mr. Singhal, reviewed the patents in sufficient depth to be able to discuss them with counsel. NetScout believes this is evidence of commendable behavior (albeit not legally required) and certainly not evidence of willfulness. This Court should clarify whether—and if so, when—the personal familiarity of senior executives with patents can evidence willfulness.

B. This Court Should Address Whether Accused Infringers Must Cease Sales While Suit Is Pending.

The decision below also creates uncertainty regarding whether a defendant must immediately cease sales of the accused products when suit is filed to avoid a finding of willfulness, even when the plaintiff has not sought an injunction and even when the defendant has asserted good-faith, reasonable defenses.

This is an important issue that warrants the attention of this Court and threatens immediate impact in ongoing litigation across the country. If continuing to sell products during suit can justify treble damages, every defendant in every patent suit will be confronted with a dilemma: continue to sell and risk enhanced damages, or voluntarily withdraw their accused products from the market as soon as suit is filed. This risk of enhanced damages based on post-filing sales may induce defendants to withdraw products from the market, even when plaintiffs are not entitled to a preliminary injunction or a permanent injunction under *eBay Inc. v. MercExchange, L.L.C.*, 126 S. Ct. 1837 (2006).

Defendants who withdraw their products may suffer irreparable damage to their businesses not only in lost sales but also in damaged reputations due to failing to support their customers. These problems are compounded when a company like

NetScout, whose products play a critical role safeguarding computer networks, is put under pressure to withdraw them from the market. This harm will not be fully cured even if the defendant is ultimately exonerated of the infringement charge.

NetScout contends that the correct answer is clear—selling accused product after a lawsuit is filed is not evidence of willfulness.

Here, Packet Intelligence did not seek a preliminary injunction and, if it had, would not have been able to show the required “irreparable harm.” Packet Intelligence does not make or sell anything and does not compete with NetScout in the marketplace. Far from being harmed by NetScout’s ongoing sales, Packet Intelligence was awarded a royalty (in the form of compensatory damages) for NetScout’s sales during suit, and it was awarded a compulsory royalty on any post-judgment sales.

But if NetScout is incorrect, then certiorari is even more necessary. If every defendant accused of infringement acts willfully (and risks treble damages) by not immediately ceasing sales of its products once suit is filed, this Court should announce such a draconian rule expressly and unambiguously, putting defendants on fair notice that patent law imposes such a requirement.

C. Uncertainty Regarding Willfulness Creates Unfair and Negative Consequences For Patent Litigation Defendants.

Without clarity from this Court, the significant uncertainty regarding the standard for willfulness will create real problems for defendants in patent litigation. Although enhanced damages should be reserved only for “egregious cases,” 136 S. Ct. at 1932, more often than not, juries find infringement to be willful when given the opportunity. See Cohen, et al. at 1085 (“A majority of juries have found any infringement to be willful.”). Given the harsh consequences of a willfulness finding—the potential exposure to treble damages in cases seeking tens or hundreds of millions of dollars—this is an area of the law in which uncertainty cannot be tolerated.

Under the Federal Circuit’s jurisprudence, defendants who seek to act in good faith and avoid “egregious infringement behavior”—like NetScout—have no way to know what post-filing conduct will subsequently be found to support enhanced damages. The existing precedent provided no warning to NetScout that enhanced damages would be imposed if (1) its senior executives relied on their lawyers rather than personally reviewing the asserted patents in detail; and (2) did not treat Packet Intelligence’s complaint as automatically enjoining NetScout from selling the accused products.

Given this uncertainty, lawyers cannot confidently advise their clients how to avoid enhanced damages. Defendants cannot conform their conduct to the law when they do not know what the law requires. This will lead many, out of caution, to adopt burdensome practices and to follow the most conservative possible interpretation of precedent.

Moreover, in evaluating the potential size of an adverse judgment, every defendant—no matter how reasonable its behavior and no matter the degree to which it acted in good faith—must account for the risk of enhanced damages in every patent infringement case in which willfulness is asserted. This risk of treble damages imposes significant settlement pressure, increasing the size of settlements and causing defendants to settle cases even where their defenses are strong.

Whatever the rules may be for whether and when post-filing conduct can support willfulness and enhanced damages, those rules should be clear. The Federal Circuit has not provided the necessary guidance, and certiorari is warranted.

III. This Case Presents An Appropriate Vehicle For Providing Guidance On Patent Eligibility Under Section 101.

Courts and private parties alike agree that the patent eligibility rules of Section 101 are in desperate need of clarification. Federal Circuit judges have repeatedly commented on the uncertainty of

Section 101 jurisprudence. See, e.g., *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1348, 1351-54, 1356 (Fed. Cir. 2018) (Plager, J., concurring in part and dissenting in part) (describing the law of patent eligibility as “incoherent,” a “real problem,” and a “conundrum”); *Berkheimer v. HP, Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Lourie and Newman, J.J., concurring in denial of rehearing en banc) (“the law needs clarification”); *Athena Diagnostics, Inc. v. Mayo Collaborative Servs., LLC*, 927 F.3d 1333, 1371 (Fed. Cir. 2019) (O’Malley, J., dissenting from denial of rehearing en banc) (acknowledging “confusion and disagreements over patent eligibility”). But the Federal Circuit will not grant *en banc* review because the uncertainty in its Section 101 analysis “is not a problem that we can solve.” *Id.* at 1337 (Fed. Cir. 2019) (Hughes, J., concurring in the denial of rehearing en banc). And the Solicitor General has urged that this Court “should grant review in an appropriate case to clarify the substantive Section 101 standards.” See Brief for the United States as Amicus Curiae at 10, *HP, Inc. v. Berkheimer*, No. 18-415 (pet. denied, Jan. 13, 2020).

Although this Court has repeatedly denied certiorari on petitions raising questions related to Section 101, many of these denials occurred while Congress was considering legislation related to Section 101. See, e.g., Brief in Opposition at 34, *Athena Diagnostics, Inc. v. Mayo Collaborative Services, LLC*, No. 19-430 (pet. denied, Jan. 13, 2020) (arguing that certiorari should be denied because, *inter*

alia, “Congress has been considering proposed legislation to amend § 101 to loosen the requirements for eligibility.”).

Since this Court’s denial of these petitions, the likelihood of congressional action now appears to have receded. See Dani Kass, *Senators’ PTAB Reform Efforts May Lose Steam Under Leahy* (Feb. 19, 2021), available at <https://www.law360.com/articles/1356250/senators-ptab-reform-efforts-may-lose-steam-under-leahy> (predicting that the head of the U.S. Senate’s intellectual property subcommittee, Sen. Patrick Leahy, will “probably not [be] as focused on [reforming Section 101] as his predecessors”). This case presents an appropriate vehicle for this Court to provide narrow—but important—guidance regarding the *Alice/Mayo* standard.

A. The Federal Circuit’s “Technological Problem” Test Erroneously Conflates *Alice*’s First and Second Steps.

In the first step of *Alice*, a court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as laws of nature, natural phenomena, or abstract ideas. *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 573 U.S. 208, 217 (2014). If the claims are found to be directed to a patent-ineligible concept in Step 1, then the court in Step 2 “examine[s] 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.” *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356, 1361 (Fed. Cir. 2018) (citation omitted).

The Federal Circuit has often (but not always) erroneously assumed that patents that purport to solve technological problems cannot be directed to abstract ideas under *Alice* Step 1. In applying this “technological problem” analysis as part of the Step 1 inquiry, cases frequently consider whether the patent includes concrete, specific elements of an implementation of a solution, considerations that are properly part of *Alice* Step 2.

Properly applied, few patents can be found eligible on the first step: “For all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012).

The heart of *Alice* is its Step 2, which asks whether the claims contain an “inventive concept” that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [abstract idea or natural law] itself.” *Alice*, 573 U.S. at 217-18.

In this case—as in some other cases involving technology patents—the Federal Circuit has avoided reaching Step 2 of the *Alice* inquiry by holding, at Step 1, that the claims are “directed” to “a technological solution to a technological problem” rather than an abstract idea. App. 19a; see also *Enfish, LLC v.*

Microsoft Corp., 822 F.3d 1327, 1335-36 (Fed. Cir. 2016) (asking “whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea”); *SRI Int’l, Inc. v. Cisco Sys., Inc.*, 930 F.3d 1295, 1304 (Fed. Cir. 2019) (holding the claims eligible at Step 1 because “the representative claim improves the technical functioning of the computer and computer networks”).

The analysis in these cases relies on a false dichotomy: the assumption that claims that purport to improve computer functionality or solve technological problems cannot also be directed to patent-ineligible abstract ideas. It may well be that an inventor has an idea that would solve a technological problem. But the inventor cannot claim a monopoly on the idea of solving the technological problem but must instead claim a patent-eligible application of the idea.

In other cases, panels of the Federal Circuit have correctly recognized this principle, holding that claims purporting to solve technological problems were directed to abstract ideas under Step 1 (and ultimately ineligible under Step 2). See *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1240–41 (Fed. Cir. 2016) (invalidating patents that “d[id] not claim a particular way of programming or designing the software . . . [but] merely claim the resulting systems”); *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016) (claim related to wirelessly communicating regional broadcast content to an out-of-region recipient ineligible);

Intellectual Ventures I LLC v. Symantec Corp., 838 F.3d 1307, 1316 (Fed. Cir. 2016) (claims concerning email filtering ineligible). All of these claims purported to solve technological problems but were, nonetheless, directed to abstract ideas.

The Federal Circuit only created further confusion when it attempted to harmonize these lines of authority in *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299 (Fed. Cir. 2018). After acknowledging the diverging cases on the issue, the panel attributed the different results of the Step 1 inquiry to whether the claims “recite more than a mere result.” *Id.* at 1305. The claims at issue were not directed to an abstract idea because “they recite specific steps . . . that accomplish the desired result,” and “there is no contention that the only thing disclosed is the result and not an inventive arrangement for accomplishing the result.” *Id.* at 1305-06.

Far from clarifying the Step 1 analysis, *Finjan*’s analysis confuses the issue by conflating Step 1 of *Alice* with Step 2. Whether the claims “recite specific steps” and contain an “inventive arrangement” is part of Step 2. These Step 2 considerations—addressing whether the patent transforms the abstract idea into a patent-eligible application—are not part of the Step 1 inquiry of whether the claims are directed to an abstract idea in the first instance.

Because the Federal Circuit has conflated the inquiries, the analysis of the eligibility of technological patents is often prematurely concluded at *Alice* Step 1. By invoking the “technological problem” test many panels find claims eligible based on an abbreviated and inadequate consideration of factors properly addressed at Step 2, leading to uncertainty and inconsistency in its analysis of technological patents.

B. The Decision Below Relied On the “Technological Problem” Test To Hold That The Claims Are Not Directed To An Abstract Idea.

The decision below illustrates the unpredictability of this framework. Relying on *Enfish* and *SRI*, the majority “concluded that the claims are not directed to an abstract idea” and thus “d[id] not reach step two.” App. 19a. The majority reached this conclusion because the claims “purpor[t] to meet a challenge unique to computer networks” and “presented a technological solution to a technological problem.” App. 18a; App. 16a-17a (relying on *SRI* for the proposition that claims cannot be directed to an abstract idea if they are “rooted in computer technology”).

Because the claims purported to solve a technological problem, the majority assumed that they could not also be directed to the abstract idea of recognizing “conversational flows.” Thus, as a result of its erroneous analysis of Step 1, the majority never considered whether the patents claim the abstract

idea of recognizing “conversational flows” or claim a patent-eligible application of that idea.

In contrast, Judge Reyna, in dissent, correctly recognized that solving a technological problem does not guarantee that a patent is eligible under Section 101:

But if the technological problem at issue was that prior art monitors could not recognize packets from multiple connections as belonging to the same conversational flow, then the “solution” of classifying network traffic according to conversational flows rather than connection flows is conceptual, not technological, in the absence of specific means by which that classification is achieved.

App. 35a.

Within the Federal Circuit’s “technological problem” framework, Judge Reyna explained that “[t]he absence of a concrete technological solution in claim 19 distinguishes it from the claims at issue in *SRI*.” App. 37a. Even more fundamentally, the majority’s focus on whether the patent provides a “concrete” technological solution is out of place in Step 1. As this Court has explained, the concreteness of the solution is properly considered in Step 2, where the court evaluates the claim elements to determine

whether they add an inventive concept to the abstract idea that transforms it into a patent-eligible application.

Judge Reyna’s analysis of Step 2 confirms that the claims add nothing—certainly nothing inventive—to the abstract idea of tracking “conversations” rather than tracking “connections.” All of the physical components recited in the patents were admittedly well-known in the art. App. 40a-41a. “The only things identified by the district court as distinguishing the claimed monitors from these well-known prior art monitors was the ability to identify disjointed connection flows as belonging to the same conversational flow and the attendant benefits of that concept.” App. 40a-41a. But these distinctions are “nothing more than the abstract idea itself.” App. 41a.

Judge Reyna recognized that what the district court—and the majority—should have considered was “whether the components and operations recited in each claim contain anything inventive beyond the abstract concept of classifying by conversational flow.” *Ibid.*

But because of its error in Step 1—following Federal Circuit cases to hold that purported solutions to technological problems are, necessarily, not directed to abstract ideas—the majority found the patents eligible without addressing the crucial Step 2 inquiry: whether the patents claim the abstract

idea of recognizing conversational flows or whether they claim a patent-eligible application of that idea.

Moreover, as a result of conflating the Step 1 and Step 2 inquiries, the majority improperly relied on details from the specification not found in the claims. In particular, the majority found the claims eligible by erroneously relying on a concrete implementation disclosed in the specification that (the majority admitted) would have been irrelevant in considering Step 2. See App. 17a (relying on the specification to conclude that “the claimed invention presented a technological solution”).

Judge Reyna correctly noted the error in this approach: “[T]he relevant inquiry for § 101 purposes is not whether the patent as a whole teaches a concrete means for achieving an abstract result, but whether such a concrete means is *claimed*.” App. 38a.

The majority responded by holding that the prohibition on relying on a concrete embodiment from the specification is limited to *Alice* Step 2: “[A]t step *two*, the claim, not the specification, must include an inventive concept. . . . Here, because we have concluded that the claims are not directed to an abstract idea, we do not reach step two.” App. 19a.

Judge Reyna correctly explained the “anomalous result” of the majority’s reasoning:

Indeed, it would be an anomalous result if we were not permitted to look to

unclaimed details at *Alice* Step 2 in determining whether an asserted claim recites an inventive concept, but could use the same details as the “focus” of the claim at *Alice* Step 1 to avoid reaching Step 2.

App. 39a.

Unless this Court grants review, this will not be the last case in which such an “anomalous result” is reached. The Federal Circuit will continue to apply its unpredictable “technological problem” test as a substitute for *Alice*, conflating the Step 1 and Step 2 inquiries and allowing patentees to claim abstract ideas as solutions to technological problems.

The issue is squarely presented in this case, and no collateral issue would prevent this Court from addressing it. The Federal Circuit’s cases on the issue are inconsistent, and as noted above, the Federal Circuit does not believe it can solve the problems in Section 101. See *Athena*, 927 F.3d at 1337. Further percolation will not resolve the problem.

This case presents an appropriate vehicle for this Court to provide important yet narrow guidance on Section 101 and *Alice*’s steps.

C. Technological Patents Claiming Only A Desired Result Rather Than A Way Of Achieving It Pose An Important and Recurring Problem.

Not only does this case squarely present the legal issue regarding the propriety of the Federal Circuit’s “technological problem” test, but the patents at issue exemplify a broad class of problematic technological patents that claim conceptual solutions to technological problems.

The asserted patent claims are like software patent claims, which are often drafted “at too high a level, too abstract a level, [and thus] end up capturing way more than they invented.” Gene Quinn, *A Software Patent Discussion with Matt Levy*, IP Watchdog, <https://www.ipwatchdog.com/2017/04/18/software-patent-discussion-matt-levy/id=82166/> (Apr. 18, 2017). “And so they end up being able to block other people from doing things that they should be able to do.” *Ibid.*; see also Matt Levy, *Software Patents Will Survive: How Section 101 Law Is Settling Down*, IP Watchdog, <http://www.ipwatchdog.com/2016/11/30/software-patents-will-survive/id=75101/> (Nov. 30, 2016) (asking that the law provide “some form of predictability” because “the problem hasn’t been software patents per se; it’s been bad software patents that overclaim and block others from innovating”).

Here, the patents identify a technological problem: “prior art packet monitors classify packets into connection flows” but some activities “involve more than one connection.” ’789, 2:42-51. The patent posits that it would be beneficial to “link” the connection flows that relate to the an “activity” so that they can “be correctly identified as being part of the same conversational flow.” ’789, 3:8-14. To solve the problem, the patents say: “It is desirable to be able to identify and classify conversational flows rather than only connection flows.” ’789, 2:49-50.

But rather than claim some specific means of achieving this solution (i.e., a patent-eligible application of the idea), the patents claim the idea itself. As Judge Reyna explained, “[t]he claim does not recite how the individual packets are actually ‘identified’ as belonging to a conversational flow beyond the functional requirement that ‘identifying information’ is used.” App. 36a. “[T]he components and operations actually recited in the claims do not provide the specificity required to transform a claim from one claiming only a result to one claiming a way of achieving it.” App. 37a.

Such patents pose a real threat to innovation. Any person who has ever sat in front of a computer has encountered a “technological problem” of one stripe or another, and hypothesizing an idea for a solution is not hard. If the “technological problem” is “the technology cannot do *X*,” then “inventing” the “technological solution” of “technology that does *X*” requires no effort beyond merely articulating the

idea. Allowing patents to claim such an idea—that is little more than wishing away a problem— “inhibit[s] further discovery by improperly tying up the future use of th[e] building blocks of human ingenuity.” *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 573 U.S. 208, 216 (2014).

Here, the patents merely identify the purported problem of monitors failing to identify “conversational flows” and claim the idea of monitors that identify “conversational flows.” Such patents hinder innovation by companies like NetScout that have spent decades pioneering network monitoring technology by developing and refining actual real-world solutions to even the most daunting technological problems. This innovation is stifled by patents that claim the bare idea of improving the technology rather than claiming an inventive way to reach that result.

Technology companies should be free to invent and innovate without running afoul of a monopoly over abstract ideas that do nothing more than pose conceptual solutions. Here, the patentee was free to invent and claim a specific, patent-eligible application of the idea of recognizing “conversational flows.” But the asserted claims, which cover the idea itself, are not eligible for protection under Section 101.

These claims are typical of overly broad technological patents in another way as well. The claims are lengthy and contain a long catalog of components

described using technical language. There is, perhaps, some intuitive sense that such lengthy claims cannot be directed to an abstract idea and must necessarily be eligible under Section 101.

But as is all-too common, the claimed components merely list the well-known, conventional components used in a network monitor in a conventional way. App. 37a-38a. Indeed, every claim limitation merely recites a component that is found in a standard packet monitor, such as “an input buffer memory . . . configured to accept a packet from the packet acquisition device.” ’789, 36:37-39. And “the district court expressly found that ‘network monitors that could recognize various packets as belonging to the same connection flow were well-known in the prior art.’” App. 40a.

The length of the claims, their detailed recitation of conventional components, and their use of technical phrases cannot substitute for what *Alice* Step 2 requires for eligibility: an inventive concept that “transform[s] a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. at 223.

Granting certiorari would allow this Court to provide needed guidance on how to properly review the eligibility of technological patents. This court should reject the Federal Circuit’s “technological problem” test, which rests on a false dichotomy and has created uncertainty in the eligibility analysis mandated by this Court.

* * *

The Federal Circuit has made clear that it cannot, on its own, clarify the law of patent eligibility and that guidance from this Court is necessary. This case presents an opportunity for this Court to provide that guidance on how the law of patent eligibility should be applied to patents that purport to solve a technological problem.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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