

No. 20-1809

IN THE
Supreme Court of the United States

VOIP-PAL.COM, INC.,

Petitioner,

v.

APPLE INC.; AMAZON.COM, INC.;
AMAZON TECHNOLOGIES, INC.,

Respondents.

**On Petition For A Writ Of Certiorari
To The United States Court of Appeals
For The Federal Circuit**

BRIEF FOR APPLE INC. IN OPPOSITION

MARK A. PERRY

Counsel of Record

ANDREW WILHELM

VLADIMIR J. SEMENDYAI

GIBSON, DUNN & CRUTCHER LLP

1050 Connecticut Avenue, N.W.

Washington, DC 20036

(202) 955-8500

mperry@gibsondunn.com

RYAN IWAHASHI

GIBSON, DUNN & CRUTCHER LLP

1881 Page Mill Road

Palo Alto, CA 94304

Counsel for Respondent Apple Inc.

QUESTION PRESENTED

Whether the asserted patent claims are ineligible under 35 U.S.C. § 101, as the district court correctly concluded in an opinion summarily affirmed by the Federal Circuit.

CORPORATE DISCLOSURE STATEMENT

Apple Inc. does not have a parent corporation, and no publicly held corporation owns 10% or more of the stock of Apple Inc.

TABLE OF CONTENTS

	<u>Page</u>
OPINIONS BELOW	2
JURISDICTION	2
STATEMENT	2
REASONS FOR DENYING THE PETITION	11
I. There Is No Basis To Hold This Case Pending <i>American Axle</i>	11
A. The Asserted Claims Here Are Nothing Like The Asserted Claims In <i>American Axle</i>	11
B. The Asserted Claims Here Are Ineligible For Patenting No Matter The Outcome Of <i>American Axle</i>	13
II. The Asserted Claims Are Not Patent- Eligible	21
CONCLUSION	28

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Affinity Labs of Tex., LLC v. DIRECTV, LLC,</i> 838 F.3d 1253 (Fed. Cir. 2016)	23
<i>Alice Corp. v. CLS Bank Int’l,</i> 573 U.S. 208 (2014).....	1, 5, 20, 22, 26, 27
<i>American Axle & Mfg., Inc. v. Neapco Holdings LLC,</i> 967 F.3d 1285 (Fed. Cir. 2020)	11
<i>Ass’n for Molecular Pathology v. Myriad Genetics, Inc.,</i> 569 U.S. 576 (2013).....	23
<i>Bartlett v. Stephenson,</i> 535 U.S. 1301 (2002).....	21
<i>Black v. Cutter Labs.,</i> 351 U.S. 292 (1956).....	22
<i>Bridge & Post, Inc. v. Verizon Commc’ns, Inc.,</i> 778 F. App’x 882 (Fed. Cir. 2019).....	23
<i>BSG Tech LLC v. Buyseasons, Inc.,</i> 899 F.3d 1281 (Fed. Cir. 2018)	10
<i>California v. Rooney,</i> 483 U.S. 307 (1987).....	22

TABLE OF AUTHORITIES *(continued)*

	<u>Page(s)</u>
<i>Credit Acceptance Corp. v. Westlake Servs.</i> , 859 F.3d 1044 (Fed. Cir. 2017)	6, 23
<i>DDR Holdings, LLC v. Hotels.com, L.P.</i> , 773 F.3d 1245 (Fed. Cir. 2014)	10
<i>Diamond v. Diehr</i> , 450 U.S. 175 (1981)	18
<i>Elec. Power Grp., LLC v. Alstom S.A.</i> , 830 F.3d 1350 (Fed. Cir. 2016)	23
<i>Enfish, LLC v. Microsoft Corp.</i> , 822 F.3d 1327 (Fed. Cir. 2016)	23
<i>Gottschalk v. Benson</i> , 409 U.S. 63 (1972)	26
<i>Innovation Scis., LLC v. Amazon.com, Inc.</i> , 778 F. App'x 859 (Fed. Cir. 2019)	23
<i>Intellectual Ventures I LLC v. Symantec Corp.</i> , 838 F.3d 1307 (Fed. Cir. 2016)	23
<i>Le Roy v. Tatham</i> , 55 U.S. (14 How.) 156 (1852)	15, 16, 24

TABLE OF AUTHORITIES *(continued)*

	<u>Page(s)</u>
<i>Martin v. Blessing</i> , 571 U.S. 1040 (2013)	21
<i>Mayo Collaborative Servs. v. Prometheus Labs., Inc.</i> , 566 U.S. 66 (2012).....	16, 18, 20, 24, 26
<i>O'Reilly v. Morse</i> , 56 U.S. (15 How.) 62 (1853).....	15, 25
<i>Parker v. Flook</i> , 437 U.S. 584 (1978).....	18
<i>Parus Holdings, Inc. v. Sallie Mae Bank</i> , 137 F. Supp. 3d 660 (D. Del. 2015).....	23
<i>RecogniCorp, LLC v. Nintendo Co.</i> , 855 F.3d 1322 (Fed. Cir. 2017)	23
<i>Ross v. Moffitt</i> , 417 U.S. 600 (1974).....	21
<i>Smith v. Goodyear Dental Vulcanite Co.</i> , 93 U.S. 486 (1876).....	17
<i>Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC</i> , 874 F.3d 1329 (Fed. Cir. 2017)	22, 23, 24

TABLE OF AUTHORITIES *(continued)*

	<u>Page(s)</u>
<i>Vehicle Intelligence & Safety LLC v. Mercedes-Benz USA, LLC</i> , 635 F. App'x 914 (2015)	23
<i>Voip-Pal.com, Inc. v. Apple Inc.</i> , 375 F. Supp. 3d 1110 (N.D. Cal. 2019)	2
<i>VoIP-Pal.com, Inc. v. Apple Inc.</i> , 411 F. Supp. 3d 926 (N.D. Cal. 2019).....	2
<i>VoIP-Pal.com, Inc. v. Apple, Inc.</i> , 828 F. App'x 717 (Fed. Cir. 2020).....	2
<i>Voip-Pal.com, Inc. v. Twitter, Inc.</i> , 798 F. App'x 644 (Fed. Cir. 2020).....	2
<i>Voit Techs., LLC v. Del-Ton, Inc.</i> , 757 F. App'x 1000 (Fed. Cir. 2019).....	23
<i>Wyeth v. Stone</i> , 30 F. Cas. 723 (C.C.D. Mass. 1840).....	15, 16, 26

Rules

Sup. Ct. R. 10.....	21
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BRIEF IN OPPOSITION

The Federal Circuit summarily affirmed the district court’s thorough order applying the patent-eligibility framework set forth in *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014), to conclude that petitioner’s claims are drawn to an abstract idea and do not recite any inventive concept. This routine application of settled law does not remotely warrant this Court’s review, and the petition doesn’t contend otherwise. Rather, petitioner seeks a “hold” pending the disposition of *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC*, No. 20-891, in which the Court has requested the views of the United States regarding the application of 35 U.S.C. § 101 to the particular patent claims in that case.

The outcome in this case would not change regardless of how *American Axle* is resolved. Indeed, the very Federal Circuit judges that were divided in *American Axle* unanimously agreed that *these claims* are ineligible under Section 101. The panel in this case was comprised of one judge, who supported the majority in *American Axle*, and two judges who supported the dissent—indeed, now-Chief Judge Moore *wrote* the panel dissent in *American Axle*, yet she and her colleagues agreed that the claims here are so obviously ineligible that no opinion was even required. Three other Federal Circuit judges who disagreed with *American Axle* also agreed that other related patents in petitioner’s portfolio are ineligible. This should not surprise: According to Chief Judge Moore, “[w]hether a claim is directed to Hooke’s Law [the question in *American Axle*] is a different question than whether a claim is directed to an abstract idea [the question presented here].” *Am. Axle Pet.*

App. 82a. Thus, any divisions within the Federal Circuit regarding patent-ineligibility do not extend to *these claims*, which are ineligible under any conceivable implementation of Section 101.

The petition for a writ of certiorari should be denied.

OPINIONS BELOW

The district court granted Apple’s motion to dismiss. *VoIP-Pal.com, Inc. v. Apple Inc.*, 411 F. Supp. 3d 926 (N.D. Cal. 2019); Pet. App. 3a–102a. The Federal Circuit summarily affirmed without opinion under Federal Circuit Rule 36. *VoIP-Pal.com, Inc. v. Apple, Inc.*, 828 F. App’x 717 (Fed. Cir. 2020); Pet. App. 1a–2a. The Federal Circuit’s order denying VoIP-Pal’s combined petition for panel rehearing and *en banc* rehearing is unreported. Pet. App. 105a–107a.

JURISDICTION

The court of appeals denied rehearing on January 26, 2021. Petitioner filed a petition for a writ of certiorari on June 25, 2021. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATEMENT

1. In 2016, petitioner sued respondent Apple Inc. and various other companies for alleged infringement of two patents. The district court granted Apple’s motion to dismiss on Section 101 grounds, *Voip-Pal.com, Inc. v. Apple Inc.*, 375 F. Supp. 3d 1110 (N.D. Cal. 2019), and the court of appeals (Newman, Lourie, and O’Malley, JJ.) unanimously affirmed without opinion. *Voip-Pal.com, Inc. v. Twitter, Inc.*, 798 F. App’x 644 (Fed. Cir. 2020). Petitioner did not seek review of that decision in this Court.

2. In 2018, petitioner sued Apple and Amazon for allegedly infringing three patents, which are all related to the two patents ruled ineligible in the previous litigation. The asserted patents are each titled “Producing routing messages for voice over IP communications,” and describe the field of the purported invention as “voice over IP communications and methods and apparatus for routing and billing.” C.A. App. 322. Voice-over-IP (“VoIP”) generally involves sending telephone calls over an Internet Protocol (“IP”) network, like the internet. *Ibid.*

Prior to VoIP, calls typically occurred over a system like the public switched telephone network (“PSTN”), which allows users to make telephone calls to one another over a “landline.” The PSTN has existed since the early days of telephony and includes switches or nodes within one or more networks. C.A. App. 322. PSTN calls are routed between two users through a circuit established by those switches. Initially, switches were operated by human operators using physical switch boards, but that process has since been modernized.

VoIP involves routing communications over the internet instead of a traditional PSTN. C.A. App. 322. But the common specification’s “Background of the Invention” acknowledges that petitioner did not invent VoIP systems or routing. Certain prior art VoIP systems used VoIP software to enable sending and receiving of voice, data, and video calls as of the alleged priority date of the Asserted Patents. *Ibid.*

As petitioner explains, large organizations created their own internal private networks, called a private branch exchanges, that avoided PSTN dialing constraints. Pet. 12. This allowed employees to com-

municate with each other via the private network, often by using some sort of abbreviated dialing convention. These private networks also allowed employees to call users on the broader PSTN network, for example, by dialing “9” to get an outside line. Pet. App. 9a.

The specification purports to improve upon existing methods of routing communications to public or private networks, based on information about the participants. Each of the 20 asserted claims in this case is directed to the abstract idea of routing a communication based on characteristics of the participants. Pet. App. 27a–47a.

3. Apple and Amazon filed a consolidated motion to dismiss, which the district court granted. In a 68-page order, the district court thoroughly analyzed the language of the asserted claims, as read in light of the specification and the invention’s purported improvements as alleged in the pleadings. Pet. App. 3a–102a. Applying this Court’s *Alice* framework, the district court concluded that the asserted claims are ineligible for patenting under Section 101. Pet. App. 101a–102a.

The district court first determined that the 20 asserted claims could be grouped into four categories:

- (1) those to a five-step method for classifying and routing a communication, represented by claim 1 of the ’002 patent;
- (2) those to a method for classifying the communication, represented by claim 9 of the ’549 patent;
- (3) those to a method for blocking a communication, represented by claim 26 of the ’002 patent; and

- (4) those to producing an error message, represented by claim 21 of the '762 patent.

Pet. App. 26a–28a. The court thoroughly detailed its reasoning for selecting those four claims, Pet. App. 26a–47a, and petitioner has abandoned its challenge to the district court’s selection of them as representative.

The district court then considered the eligibility of each representative claim, read in light of the specification and the complaint’s allegations. The district court correctly set forth this Court’s *Alice* framework:

First, we determine whether the claims at issue are directed to [laws of nature, natural phenomena, or abstract ideas]. If so, we then ask, “[w]hat else is there in the claims before us?” To answer that question, we consider the elements of each claim both individually and “as an ordered combination” to determine whether the additional elements “transform the nature of the claim” into a patent-eligible application. We have described step two of this analysis as a search for an “inventive concept”—*i.e.*, an element or combination of elements that is “sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.”

Pet. App. 16a–17a (second and third alterations in original) (quoting *Alice*, 573 U.S. at 217).

At *Alice* step one, the district court found each representative claim to be directed to an abstract idea. The district court first determined that representative claim 1 of the '002 patent is directed to the abstract idea “of routing a communication based on characteristics of the participants.” Pet. App. 49a. It explained

that the claim “is worded in such broad, functional terms, so as to describe a desired result—routing the communication—without explaining *how* that result is achieved.” Pet. App. 51a–52a. It then considered each limitation in detail, explaining that they recite: “generic ‘identifiers’”; a “purely generic” database; “any form of data manipulation”; a “similarly vague” classifying step; and displaying a “routing message [that] simply displays the results of some unrevealed, unexplained process for identifying the appropriate Internet address.” Pet. App. 53a–57a. The district court concluded that “Representative Claim 1 ultimately amounts to nothing more than the abstract idea of collecting data, analyzing it, and displaying the results,” akin to numerous other cases where the Federal Circuit has found similar claims ineligible. Pet. App. 57a–58a.

The district court explained that claim 1’s abstract nature is supported by two additional observations. First, claim 1 is “analogous to preexisting practices of manual call routing, a ‘fundamental practice long prevalent in our system.’” Pet. App. 60a. Concluding that the claim “provides simple automation of a task previously performed manually,” the district court noted that the Federal Circuit “has ‘made clear that mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.’” Pet. App. 63a (quoting *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017)).

Second, the court rejected petitioner’s argument that claim 1 is directed to an improvement in computer functionality because it provides “user-specific handling,” “transparent routing,” “resiliency,” and “communication blocking.” Pet. App. 68a–75a. Given

the Rule 12(b)(6) stage of the case, the court accepted petitioner’s allegations that “user-specific handling” would be an unconventional improvement in call routing but concluded that the claim “is not directed to this improvement because [it] does not disclose *how* to achieve the alleged improvement.” Pet. App. 69a. The court also disagreed with petitioner that claim 1 was directed to “transparent routing.” Pet. App. 72a. But even accepting that the claim obviated “the need for the caller to actively specify the appropriate network,” the court determined “that alone is not sufficient to make Representative Claim 1 non-abstract.” *Ibid.* Finally, the court recognized that claim 1 does not recite “resiliency” or “communication blocking.” Pet. App. 73a–75a.

The court then analyzed the other three representative claims to determine whether they similarly are directed to an abstract idea.

Turning to representative claim 9 of the ’549 patent, the district court began by noting the difference between it and representative claim 1: while claim 1 classifies a call “based on” the second participant identifier, claim 9 adds that the classification is based on whether the second participant identifier “exists in a database.” Pet. App. 77a. While claim 9 is narrower than claim 1, the court concluded that “searching a database for a particular entry—a generic ‘identifier’—is no less abstract than the broader idea of ‘classifying’ the communication.” Pet. App. 78a.

Claim 26 of the ’002 patent, the district court explained, “is identical to Representative Claim 1,” except for two “blocking” steps: accessing communication blocking information in a database and blocking the communication based on that information. Pet. App. 79a. The court explained that while claim 1 “is

directed to the abstract idea of routing a communication based on characteristics of the participants,” claim 26 further adds “that such routing may require blocking the communication” *Ibid.* After noting that the communication blocking is recited “in purely functional terms” and that it is a long-standing communication practice that petitioner agreed it did not invent, the court turned to petitioner’s argument that communication blocking was a technological improvement. *Ibid.* The court disagreed because claim 26 does not require any details about the blocking information or its source. The court also noted that declining calls from certain callers was conventionally done by humans, so any benefit “arises entirely from automation of a manual process using generic computer components.” Pet. App. 83a. As a result, the court concluded that claim 26 is “directed to the abstract idea of routing a communication based on characteristics of the participants, where routing may include blocking the communication.” *Ibid.*

Finally, the court explained that claim 21 of the ’762 patent is substantially similar to claim 1, but that it produces an error message and prevents a communication from being routed in the event a “third network classification criterion” is met. Pet. App. 45a–46a. It noted the limitation “is written in such broad, functional terms as to cover the entire abstract idea of producing an error message,” and that the claim does not specify any detail about the third classification criterion. Pet. App. 85a. Because “[a]pplying an unspecified criterion is the height of abstraction,” the court concluded that claim 21 is directed to an abstract idea. *Ibid.*

After concluding that the representative claims are directed to abstract ideas, the district court turned

to *Alice* step two and considered whether the claims include an inventive concept beyond the abstract idea itself. Pet. App. 86a. Considering the individual limitations of claim 1 of the '002 patent, the district court concluded that each is directed to a component of a conventional communication system as “can be discerned from the patent itself—no outside evidence is needed.” Pet. App. 88a. The court explained why each limitation is conventional and that “none of the five steps in the claimed method enlists the computing elements to do anything other than operate in their expected manner.” Pet. App. 90a. The court next considered petitioner’s argument that Apple’s motion had “stripped” out elements of the claim. Pet. App. 92a. Because the only details supporting that argument to which petitioner pointed were certain flowcharts in the '002 patent, the court reviewed those flowcharts and concluded “that they too contain only conventional, generic steps.” *Ibid.*

The court then considered the ordered combination of steps recited in claim 1. Pet. App. 92a. It explained that the claim uses “a conventional ordering of steps—first receiving the identifiers, then processing them, then using the results in some unspecified way to produce the routing message—implemented on generic technology.” Pet. App. 93a. It considered each of petitioner’s step-two arguments regarding the ordered combination, specifically: (i) that the claim overcomes the limitations of prior technology; (ii) that the claim provides “[u]ser-specific customization of network functionality”; and (iii) that the claim solves problems “rooted in network technology.” Pet. App. 94a–96a (alteration in original; emphasis omitted). It rejected the first argument because the claim lacks detail and fails to explain how the asserted improvements are achieved. Pet. App. 94a. The claim does not provide

an inventive concept, the court explained, because it simply restates what the court already determined was abstract. *Ibid.* (citing *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018)). Turning to the second argument, the court explained that the customization of network functions simply restated petitioner’s first argument that the claim improves prior technology. Pet. App. 94a–95a. Last, the court considered petitioner’s theory that the claim solves a problem “rooted in network technology” and rejected petitioner’s analogy to *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1256 (Fed. Cir. 2014). The district court noted that the claim here is “wholly unlike” *DDR Holdings* because it merely recites conventional steps performed on a generic computer carrying out “routine steps using generic elements (e.g., identifiers, user profiles, databases) that the patent does not invent.” Pet. App. 95a–96a.

The court then considered whether any of the other representative claims satisfy *Alice* step two. Concluding they do not, the court explained that “[t]here is nothing in the [other] three representative claims beyond purely functional language describing the abstract result.” Pet. App. 99a. Similarly, the additional limitations require nothing more than “conventional computer equipment, performing their ordinary functions.” *Ibid.* And because petitioner had not identified an inventive concept in any of claims 9, 26, and 21, the court explained that it “need not labor any further to find one.” *Ibid.*

4. The court of appeals (Moore, Reyna, and Tarranto, JJ.) summarily affirmed without opinion under Federal Circuit Rule 36. Pet. App. 1a–2a. The court of appeals also denied petitioner’s combined petition

for panel rehearing and *en banc* rehearing with no recorded dissent. Pet. App. 105a–107a.

REASONS FOR DENYING THE PETITION

There is no reason to hold this case pending the disposition of *American Axle*. The lower courts correctly concluded that the asserted claims are ineligible under the framework set forth in *Alice*. The petition should be denied.

I. There Is No Basis To Hold This Case Pending *American Axle*

Petitioner doesn't dispute that its claims are ineligible under Section 101 as construed by this Court in *Alice* and the Federal Circuit in a long series of post-*Alice* decisions. Rather, the real thrust of the petition is that this Court should hold this case pending the resolution of the petition in *American Axle*. There is no reason to do so, both because this case bears no resemblance to *American Axle* and because the claims here are ineligible regardless of how *American Axle* is ultimately decided.

A. The Asserted Claims Here Are Nothing Like The Asserted Claims In *American Axle*

As the district court concluded (and as described more fully in Part II below), the asserted claims here are directed to the abstract idea of classifying and/or routing a communication. Thus, these claims are much different from those in *American Axle*, which are directed to a new process for tuning automobile drive shafts. 967 F.3d 1285, 1290 (Fed. Cir. 2020). The *American Axle* claims recite providing a hollow shaft, tuning a liner, and inserting it into the shaft. The entire three-step process is allegedly inventive,

even though the tuning step implicates a natural law (Hooke's law). *See ibid.* The parties dispute whether the claims are directed to only that natural law (which is invoked in a single step) or to the process for tuning drive shafts (all of the steps).

There is no such dispute here. The asserted claims recite (1) receiving caller and callee identifiers; (2) collecting further information about one or both call participants; (3) analyzing the information collected; (4) classifying the call as a system or external communication based on undefined criteria; and (5) taking an action based on that classification (routing the call, blocking the call, or producing an error message). Each of these simply states, in functional language, a step for classifying or routing a communication. That is the abstract idea to which the claims are directed.

According to Chief Judge Moore, “[w]hether a claim is directed to Hooke’s Law is a different question than whether a claim is directed to an abstract idea.” *Am. Axle* Pet. App. 82a. Accordingly, the issue that six Federal Circuit judges had with the analysis in *American Axle* simply does not apply to the district court’s order here.

Indeed, it would be difficult to find another case with such stark contrast to *American Axle* because whatever disagreement may exist within the Federal Circuit regarding the eligibility of certain patent claims (or even the reach of Section 101 more generally), there is complete agreement—from judges ascribing to *all* of the Federal Circuit’s decisions in *American Axle*—that *these* asserted claims flunk Section 101. Chief Judge Moore, who dissented vigorously in *American Axle*, voted to affirm the district court’s ineligibility finding in his case. Likewise,

Judge Reyna dissented from denial of rehearing *en banc* in *American Axle* yet voted to affirm here. Had those judges thought that these asserted claims satisfied (or could satisfy) Section 101 if considered properly, they would not have voted to affirm. Judge Taranto, who joined the majority in *American Axle*, completed the unanimous panel in this case. And all three judges who voted to summarily affirm dismissal of the previous case on Section 101 grounds (Newman, Lourie, and O'Malley, JJ.) dissented from rehearing *en banc* in *American Axle*.

The Federal Circuit's unanimity in the cases involving petitioner's patent portfolio is not, as petitioner contends, a "distressing" indication of uncertainty about Section 101's application to borderline cases. Pet. 34. To the contrary, it demonstrates how irredeemably abstract these claims are. Wherever Section 101's "boundary is," *ibid.*, multiple judges who have expressed disagreement with *American Axle* concluded that these claims lie beyond that boundary. Indeed, of the six Federal Circuit judges to review petitioner's patent portfolio, five disagreed with *American Axle*. Yet they all found these claims so obviously ineligible as to not even require an opinion. That fact—nowhere mentioned in the petition—conclusively establishes the vast gulf between petitioner's patent claims and those at issue in *American Axle*.

B. The Asserted Claims Here Are Ineligible For Patenting No Matter The Outcome Of *American Axle*

Petitioner argues that the district court here committed the same errors alleged in the *American Axle* petition. That is both wrong and irrelevant.

1. The Asserted Claims Are Ineligible Under The *American Axle* Majority’s Analysis

If this Court denies certiorari or grants certiorari in *American Axle* and affirms, there would be no question that the asserted claims here are ineligible. The district court’s Section 101 analysis in this case is a routine application of this Court’s *Alice* framework. Petitioner does not dispute that a denial of certiorari or an affirmance in *American Axle* would result in an affirmance of the district court’s analysis here.

2. A Reversal In *American Axle* Will Not Impact This Case

Even if this Court grants certiorari and reverses in *American Axle*, the outcome here would not change because this case implicates none of the concerns that permeate the *American Axle* dissents.

The dissenters in *American Axle* took issue with the majority for supposedly (1) conflating Sections 101 and 112, and (2) not being able to explain what “more” was needed to overcome the *American Axle* claims’ application of the natural law. According to the dissenters, these infirmities with the majority’s approach would expand the eligibility analysis beyond its statutory bounds and conflict with this Court’s precedent. Regardless of whether these concerns are well-founded, they simply are not implicated in this case. The district court’s Section 101 analysis here differs from that in *American Axle* and remains a faithful application of the requirements of Section 101 under almost two centuries of this Court’s eligibility precedent and the Federal Circuit’s post-*Alice* caselaw aside from *American Axle*. That analysis, therefore, will not

be undermined even if the Court were to grant and reverse in *American Axle*.

1. Petitioner argues that this case suffers from the same conflation of eligibility under Section 101 and enablement under Section 112 as *American Axle* because the district court focused exclusively on the specification instead of the claims. Petitioner is wrong. The district court’s eligibility analysis did not stray into enablement territory, but precisely followed this Court’s eligibility precedent by focusing on the language of the claims.

For centuries, in determining eligibility, this Court has considered whether the *claims* contained a recitation of the manner in which the abstract idea or natural law was *applied* to achieve a useful result. *See, e.g., O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 120 (1853) (holding in 1853 that a claim essentially “for an effect produced by the use of electro-magnetism distinct from the process or machinery necessary to produce it” was ineligible); *Le Roy v. Tatham*, 55 U.S. (14 How.) 156, 175–76 (1852) (explaining in 1852 that “we must look to the claim of the invention” to determine whether it recites eligible “processes used to extract, modify, and concentrate natural agencies” or seeks to improperly monopolize “an effect, or the result of a certain process”); *Wyeth v. Stone*, 30 F. Cas. 723, 727–28 (C.C.D. Mass. 1840) (rejecting in 1840 “a claim for an art or principle [of cutting ice] in the abstract,” but upholding a claim for a “particular method of the application of th[at] principle”). In other words, if the manner of applying an abstract idea or natural law was missing from the *claims*, then the Court concluded that the claims were ineligible because they tried to claim the abstract idea or natural law itself.

Section 112, on the other hand, asks whether the **specification** supports the claims. This Court explained that Section 112's purpose is distinct from that of Section 101 because the former "does not focus on the possibility that a law of nature (or its equivalent) that meets these conditions will nonetheless" risk preempting the natural law or abstract idea. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 90 (2012). Thus, eligibility is concerned with asking how the **claim** is limited to an *application* of an abstract idea in a non-abstract form to achieve a useful result, whereas Section 112 is concerned with asking whether the **specification** has enough detail for a person to make and use the claimed invention.

Contrary to petitioner's arguments, the district court properly focused its eligibility analysis on the direction of the **claims**. *See, e.g.*, Pet. App. 55a (holding that claim 1 of the '002 patent was "so broadly worded that it encompasses literally any form of data manipulation" (cleaned up)); 70a (explaining that a claim was ineligible because it "in effect encompass[ed] all solutions" instead of "a particular concrete solution to the problem of user-specific calling styles" (cleaned up)); 75a (rejecting a claim that "does not focus on a specific means or method that improves the relevant technology and is instead directed to a result or effect that itself is the abstract idea" (cleaned up)); *cf. Le Roy*, 55 U.S. at 176; *Wyeth*, 30 F. Cas. at 727–28. Indeed, unlike the petition, which does not quote the claim language even once, the district court quoted extensively from the claims in its explanation of their ineligibility. *See, e.g.*, Pet. App. 53a–57a.

The district court's analysis here does not come even close to implicating the concern raised by the dissenters in *American Axle*. The district court properly

considered whether the claims here identified “structures specified at some level of concreteness” that limited those claims to a specific manner of achieving the claimed functional result—which both the majority and the dissent sides in *American Axle* agreed was the proper inquiry under Section 101. *Am. Axle* Pet. App. 30a–31a (majority); 65a–66a (dissent); *cf.* Pet. App. 75a–76a (concluding that claim 1 of the ’002 patent is abstract because it “discloses only broad, functional steps” and “fails to provide any specific or concrete means for achieving the desired result”). Rather, the *American Axle* dissenters were concerned that the majority required a claim to recite more than a concrete application of an abstract idea, which in their view expanded Section 101 to overlap with Section 112’s requirement that the specification explain how to implement the concrete application recited in the claims. Nothing in the district court’s order suggests that a similar concern is present here.

Petitioner contends that the district court’s consideration of the specification *in addition* to the claims shows that the district court supposedly transformed its Section 101 analysis into consideration of enablement under Section 112. Pet. 24–26. Not so. The district court focused on the claims, but read them in light of the specification to determine whether any disclosure in the specification would limit the claims to an application of the claimed abstract idea. The district court properly determined that there was no such limit—in either the claims *or* the specification. It has been settled law for almost 150 years that a claim must be read “in connection with the preceding part of the specification, and construed in the light of the explanation which that gives.” *Smith v. Goodyear Dental Vulcanite Co.*, 93 U.S. 486, 494 (1876). In other words, the district court properly considered the

direction of the claims in light of the specification. *See, e.g.*, Pet. App. 54a (reading the claim in light of the specification to determine the nature of the claimed “attributes” because “[t]he claim does not . . . define the ‘attributes’”). No judge on either side of the *American Axle* dispute suggested that this settled principle should be overturned. Thus, this Court’s reversal in *American Axle* would have no impact on *these claims*.

Petitioner also points to the district court’s use of the word “how” as supposed evidence that it conflated the requirements of Section 101 and 112, and argues that this use of the word “how” necessarily ties this case to the outcome in *American Axle*. Pet. 23–28; *see also Am. Axle* Pet. App. 31a–32a. But the dissenting judges in *American Axle* never suggested that merely using this common word transforms the eligibility analysis into one of enablement. Indeed, this Court has invoked the word “how” as part of its Section 101 analysis for decades. *See, e.g., Mayo*, 566 U.S. at 82 (holding process claims for using thiopurine drugs ineligible because each process “simply tells doctors to . . . measure (*somehow*) the current level of the relevant metabolite” (emphasis added)); *Parker v. Flook*, 437 U.S. 584, 586 (1978) (holding that a patent claiming a formula for updating alarm limits using several variables was ineligible under Section 101 because it “does not purport to explain *how* to select” those variables (emphasis added)); *see also Diamond v. Diehr*, 450 U.S. 175, 186 (1981) (distinguishing *Flook* on this point).

Instead, the dissenters in *American Axle* argued that the claims already explained *how* to achieve the desired result, *see Am. Axle* Pet. App. 65a (“The ’911 patent claims one specific way to attenuate vibrations,

a concretely identified physical structure—a liner inserted inside the propshaft”), and thus any additional “how” requirement crossed the line between Sections 101 and 112. The district court here, by contrast, focused on the claims and concluded that nothing therein explained how those claims would be limited to an application of an abstract idea, instead of trying to cover the abstract idea itself. The district court’s analysis was firmly rooted in Section 101, and therefore even a reversal in *American Axle* will not impact the outcome in this case.

2. Petitioner also argues that the district court’s use of the words “nothing more” somehow means that it applied the same purported “Nothing More” test that the Federal Circuit did in *American Axle*. Pet. 14–16. Not so. Chief Judge Moore, the leading dissenter in *American Axle*, explained that “[u]nder the majority’s new ‘Nothing More’ test, claims are ineligible when they merely make use of a natural law.” *Am. Axle* Pet. App. 79a. Chief Judge Moore also noted that both parties in *American Axle* and their experts agreed that there were already “more” elements in those claims than those that invoked the natural law (Hooke’s Law). Thus, it was unclear to the dissenters in *American Axle* what “more” the majority there was requiring. This lack of clarity fed concerns about expanding ineligibility under Section 101 to cover the *application* of natural laws in addition to the natural laws themselves. *See, e.g., Am. Axle* Pet. App. 39a, 43a (Chief Judge Moore concerned about “[t]he majority’s expansion of ‘*directed to*’” because “[a] claim is not *directed to* a natural law simply because it touches upon, implicates, uses or involves a natural law”).

Again, no such concerns exist here. The district court held that the claims at issue here do not merely make use of an abstract idea—they are *directed* to an abstract idea because they recite only “result-focused steps and generic technology.” Pet. App. 53a; *cf. Alice*, 573 U.S. at 221 (adding “generic computer implementation” to the claims is not enough for eligibility because doing so is nothing “more than simply stating the abstract idea while adding the words ‘apply it’” (quoting *Mayo*, 566 U.S. at 72) (cleaned up)).

Petitioner’s quibbles with the district court’s language do not change the fact that the district court’s focus remained on the claims and faithfully applied the *Alice* framework, considering whether the claims were directed to an abstract idea or something more—“a patent-eligible application” of that idea. *Alice*, 573 U.S. at 221; *cf. Pet. App. 53a* (“[T]he *claim’s step* of ‘receiving’ ‘identifiers’ associated with the participants amounts to nothing more than collecting preexisting information” because the patents “*do not purport to invent or alter* such identifiers, which are preexisting components” of telephone systems (emphases added)). Thus, even a holding by this Court that the *American Axle* majority misused the phrase “nothing more” to frame its eligibility analysis will have no effect on the district court’s correct application of this Court’s eligibility test to these claims.

* * *

Neither the claims asserted by petitioner nor the district court’s analysis of those claims is anything like those in *American Axle*. Any action that the Court may or may not take with respect to *American Axle* will not render *these* claims eligible for patenting. There is no need to hold this petition pending disposition of that one.

II. The Asserted Claims Are Not Patent-Eligible

Contrary to petitioner’s unadorned assertion, this case would not be an “excellent vehicle for review.” Pet. 3. On the contrary, granting certiorari here would depart from this Court’s typical practice of reviewing decisions of “court[s] of appeals” that (unlike the district court opinion here) serve as binding precedent for future cases. Sup. Ct. R. 10; *see Bartlett v. Stephenson*, 535 U.S. 1301, 1304 (2002) (Rehnquist, C.J., in chambers) (noting that this Court does not exercise its “discretionary jurisdiction” to decide an issue that “has few if any ramifications beyond the instant case”). The Federal Circuit’s summary affirmance order demonstrates that clear precedent on Section 101 resolves this case, and that decision is necessarily limited to the patent portfolio asserted by petitioner in this and related litigation.

Moreover, while the district court’s order is entirely correct (as the Federal Circuit recognized in summarily affirming it), this Court does not sit as a “court of error correction.” *Martin v. Blessing*, 571 U.S. 1040, 1045 (2013) (Alito, J., respecting the denial of certiorari). And it does not normally grant certiorari if the lower court “properly stated” the applicable “rule of law.” Sup. Ct. R. 10; *see also Ross v. Moffitt*, 417 U.S. 600, 616–17 (1974) (“This Court’s review . . . is discretionary and depends on numerous factors other than the perceived correctness of the judgment we are asked to review”).

The petition does not dispute that the district court properly stated the *Alice* framework. Nor, tellingly, does it even dispute the court’s ultimate conclusion that these claims are ineligible under Section 101. The only dispute is whether the district court properly

articulated its reasoning in arriving at the uncontested conclusion. Pet. 2. That alone is reason to deny the petition. *See California v. Rooney*, 483 U.S. 307, 311 (1987) (“This Court ‘reviews judgments, not statements in opinions’” (quoting *Black v. Cutter Labs.*, 351 U.S. 292, 297 (1956))).

In any event, there is no analytical error here. Petitioner quibbles with a few words cherry-picked from the district court’s 68-page order, but that court faithfully applied the two-step analysis from this Court’s precedent to patent claims that cannot satisfy Section 101 under any rational application of the statute. These claims, like others in petitioner’s patent portfolio, are so clearly ineligible that only summary affirmance was required—as two successive Federal Circuit panels concluded.

1. Contrary to petitioner’s intimations (Pet. 22–29), the district court’s *Alice* step one analysis was sound.

This Court has not “delimit[ed] the precise contours of the ‘abstract ideas’ category,” *Alice*, 573 U.S. at 221, but the district court identified three “themes” from the jurisprudence of this Court and the Federal Circuit that demonstrate the abstract nature of the four representative claims: “(a) the claimed method discloses only generalized steps drafted in purely functional terms; (b) it is analogous to well-known, longstanding practices; and (c) it does not recite an improvement in computer functionality.” Pet. App. 49a. Petitioner does not challenge the district court’s identification of these themes or their application to the asserted claims.

The district court properly identified and applied circuit precedent in applying each theme. *See, e.g.*, Pet. App. 50a–51a (theme (a) supported by *Two-Way*

Media Ltd. v. Comcast Cable Commc'ns, LLC, 874 F.3d 1329, 1337 (Fed. Cir. 2017); *Bridge & Post, Inc. v. Verizon Commc'ns, Inc.*, 778 F. App'x 882, 894 (Fed. Cir. 2019); *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1356 (Fed. Cir. 2016); *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1326 (Fed. Cir. 2017); *Vehicle Intelligence & Safety LLC v. Mercedes-Benz USA, LLC*, 635 F. App'x 914, 916 (2015); *Innovation Scis., LLC v. Amazon.com, Inc.*, 778 F. App'x 859 (Fed. Cir. 2019)); Pet. App. 59a–64a (theme (b) supported by *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1316–17 (Fed. Cir. 2016); *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253 (Fed. Cir. 2016); *Parus Holdings, Inc. v. Sallie Mae Bank*, 137 F. Supp. 3d 660, 672 (D. Del. 2015), *aff'd*, 677 F. App'x 682 (Fed. Cir. 2017)); Pet. App. 70a–72a (theme (c) supported by *Two-Way Media*, 874 F.3d at 1339; *Credit Acceptance*, 859 F.3d at 1055; *Voit Techs., LLC v. Del-Ton, Inc.*, 757 F. App'x 1000, 1003–04 (Fed. Cir. 2019)).

Using that precedent as a guide, the district court correctly read the claim language in light of the specification to conclude that each representative claim is directed to an abstract idea. The district court centered its analysis on “determining the focus of the claims,” Pet. App. 48a (cleaned up), as required by this Court, *see, e.g., Ass'n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 593 (2013) (holding a patent ineligible because “the claims understandably *focus* on the genetic information” (emphasis added)). The district court also was “careful not to express the claim’s focus at an unduly ‘high level of abstraction . . . ,’ but rather at a level consonant with the level of generality or abstraction expressed in the claims themselves.” Pet. App. 48a (quoting *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir.

2016)); *cf. Mayo*, 566 U.S. at 71 (warning against “too broad an interpretation of this exclusionary principle” because “all inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas”).

Applying this well-settled approach, the district court found claim 1 of the ’002 patent and claim 9 of the ’549 patent to be directed to “the idea of routing a communication based on characteristics of the participants.” Pet. App. 49a, 77a. The district court based its conclusion on the claim language, as read in light of the specification, and found that each step of the claims “[wa]s worded in such broad, functional terms” that they described only “result-focused steps and generic technology” and “describe a desired result—routing the communication—without explaining *how* that result is achieved.” Pet. App. 51a–52a. The district court explained that settled law requires some description of “how to achieve [the claimed] results *in a non-abstract way*.” Pet. App. 50a (quoting *Two-Way Media*, 874 F.3d at 1337) (emphasis added); *cf. Le Roy*, 55 U.S. (14 How.) at 175 (“A patent is not good for an effect, or the result of a certain process, as that would prohibit all other persons from making the same thing by any means whatsoever”). The district court further found that claims recited only “generic technology” in addition to “result-focused steps.” Pet. App. 53a.

For example, with respect to claim 1 of the ’002 patent, the district court concluded that:

- Step 1 recites the abstract idea of “collecting preexisting information” coupled with “receiving generic ‘identifiers’” that the patent “do[es] not purport to invent or alter” and “which are preexisting components of Voice-over-IP and PSTN communication systems.” Pet. App. 53a.

- Step 2 recites accessing a “generic” database using undefined “attributes,” which amounts to “an unpatentable abstract idea” of “reading a preexisting database and locating information.” *Id.* at 54a.
- Step 3 recites “processing” a generic “identifier ‘based on’ one or more of the attributes” without “disclos[ing] what the ‘processing’ entails, or how the attributes . . . are used in processing.” *Id.* at 55a. The district court explained that “this step is so broadly worded that it encompasses literally any form of data manipulation.” *Ibid.* (cleaned up).
- Step 4 recites “classifying the communication” without any “detail as to how the classification is accomplished,” which the district court explained was simply the abstract idea of collecting and analyzing information. *Id.* at 55a–56a.
- Step 5 recites “‘producing’ either a ‘system routing message’ or an ‘external routing message,’” which “simply displays the results of some unrevealed, unexplained process for identifying the appropriate [destination] Internet address.” *Id.* at 56a–57a.

Considered separately or in combination, the district court correctly held this claim to be “purely functional” and “amount[ing] to nothing more than the abstract idea of collecting data, analyzing it, and displaying the results.” Pet. App. 57a; *see Morse*, 56 U.S. (15 How.) at 113 (holding a claim ineligible where “it matters not by what process or machinery the result is accomplished”).

The district court reached a similar conclusion with respect to representative claim 9 of the '549 patent. The district court explained that although claim 9 contained one additional element not present in claim 1 (“classifying ‘based on’” the existence of a specific profile in a database), claim 9 was nonetheless ineligible for the same reasons as claim 1 because “searching a database for a particular entry—a generic ‘identifier’—is no less abstract than the broader idea of ‘classifying’ the communication.” Pet. App. 77a–78a. Based on a similar analysis, the district court found that claim 26 of the '002 patent “is directed to the abstract idea of routing a communication based on characteristics of the participants, where routing may include blocking the communication.” Pet. App. 83a. And it found claim 21 of the '762 patent to be “directed to the abstract idea of routing a communication based on characteristics of the participants, where routing may include preventing the communication from being established.” Pet. App. 86a.

The district court’s analysis was a straightforward application of *Alice* step one, grounded in this Court’s historic patent eligibility caselaw. *See Alice*, 573 U.S. at 217 (for a claim to be patent-eligible, it must “integrate the building blocks [of human ingenuity] into something more” by applying them “to a new and useful end”) (quoting *Mayo*, 566 U.S. 89, and *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (cleaned up)); *Wyeth*, 30 F. Cas. at 727 (Justice Story, riding circuit, holding that “a claim is utterly unmaintainable” if it is so result-oriented as to be “a claim for an art or principle in the abstract, and not for any particular method or machinery” of implementing it).

Tellingly, the petition never argues that the asserted claims are directed to anything other than an

abstract idea. Indeed, petitioner does not cite any combination of the claims as a whole that would allow a court to conclude that the asserted claims are directed to anything other than an abstract idea. Any purported error in the district court’s articulation of the applicable principles, therefore, is harmless and unworthy of this Court’s review.

2. At *Alice* step two, courts “must 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.” *Alice*, 573 U.S. at 221 (cleaned up). “A claim that recites an abstract idea must include additional features to ensure that the claim is more than a drafting effort designed to monopolize the abstract idea.” *Ibid.* (cleaned up). Satisfying step two “requires more than simply stating the abstract idea while adding the words ‘apply it.’” *Ibid.* (cleaned up). “The introduction of a computer into the claims does not alter the [step two] analysis.” *Id.* at 222; *see also id.* at 223 (“[T]he mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention”).

As with step one, the petition does not actually argue that the district court erred in its ultimate conclusion at step two. It does not argue, for example, that any additional elements of the asserted claims, individually or as an ordered combination, transform them into a patent-eligible application. *See Alice*, 573 U.S. at 217. Nor does the petition argue that the claims contain an inventive concept that would render them patent-eligible. *See ibid.* And it cannot do so because, again, the district court got it right. There is not a single element in the asserted claims—individ-

ually or as an ordered combination—that adds any inventive concept to the abstract ideas presented in the claims.

The claims asserted by petitioner are ineligible, as the district court concluded in a well-reasoned and thorough decision that was summarily affirmed by the Federal Circuit. Nothing about that decision warrants this Court’s review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

MARK A. PERRY
Counsel of Record
ANDREW WILHELM
VLADIMIR J. SEMENDYAI
GIBSON, DUNN & CRUTCHER LLP
1050 Connecticut Avenue, N.W.
Washington, DC 20036
(202) 955-8500
mperry@gibsondunn.com

RYAN IWAHASHI
GIBSON, DUNN & CRUTCHER LLP
1881 Page Mill Road
Palo Alto, CA 94304

Counsel for Respondent Apple Inc.

August 20, 2021