

No.

IN THE

Supreme Court of the United States

STEVE MORSA,

Petitioner

v.

U.S. PATENT AND TRADEMARK OFFICE,

Respondent

AKA IN RE STEVE MORSA

*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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Pro Se

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QUESTIONS PRESENTED

This Court has held that any machine or process is eligible for patent protection under 35 U.S.C. § 101, subject only to narrow exceptions where the patent seeks to monopolize an abstract idea or law of nature.

Despite this, the Federal Circuit and Patent Office have both run ineligibility amok. *First*, by ignoring this Court's seminal *Cuno* flash of creative genius eligibility proof; *second*, by ignoring Patent Office proof of no undue preemption; and *third*, by usurping and overruling this Court's *Alice / Mayo* claims analysis framework of identifying no more than *one stated* abstract concept to which *all* the claims at issue are directed to.

Accordingly, the three questions presented are:

1. May the Federal Circuit and Patent Office ignore this Court's seminal *Cuno* decision?
2. May the Federal Circuit and Patent Office ignore Patent Office proof of no undue preemption?
3. May the Federal Circuit and Patent Office establish their own Section §101 Law?

RELATED PROCEEDINGS

None

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CONSTITUTIONAL PROVISION

U.S. CONST. art. I, § 8, cl. 8 2

OPINION AND ORDER BELOW

The opinion of the Federal Circuit is reproduced at App. 18a - 28a. The Federal Circuit’s order denying rehearing is reproduced at 29a – 30a.

JURISDICTION

The Federal Circuit entered judgment on April 10, 2020. The court denied Appellant’s timely petition for rehearing on June 11, 2020. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

35 U.S.C. 101 provides:

Inventions Patentable

“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.”

INTRODUCTION

“At the same time, we tread carefully in construing this exclusionary principle lest it swallow all of patent law.”

(Mayo, 566 U. S.)

With the startling CAFC decision below, this Court’s biggest innovation-crushing fear is now reality:

All of American patent law has indeed now been swallowed.

Only this Court -- our nation’s Supreme Court -- can save the convulsing patient.

STATEMENT OF THE CASE AND REASONS FOR GRANTING THE PETITION

Reference is made to my Federal Circuit *Rehearing Petition* (RP) and *Appendix* (App); and to the Federal Circuit’s *Decision on Appeal* (DOA).

I. The Federal Circuit and Patent Office Ignore *Cuno*

The Federal Circuit (twice), like the Patent Office before it (twice at the Patent Trial and Appeal Board (PTAB); once during examination), have both surprisingly and disappointingly ignored this Court’s seminal *Cuno* decision proof that the claims at issue – because the *Match Engine Marketing* invention was the result of a flash of creative genius -- are patent eligible (III; RP at 4 / App. at 4):

“That is to say, the new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling.” (*Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 91 (1941))

Starting with examination, I repeatedly declared for the written record that I did not take the path some others apparently have – merely taking some previously existing “bricks and mortar” / pre-Internet / offline (or some other previously-existing) process / system and “computerizing” and / or “Internetizing” it.

Instead, my invention’s 2004 genesis – *Bid on Demographics!* -- was an out-of-the-blue light bulb moment; an epiphany; what’s often referred to as a “flash of creative genius” (though I’m no genius). It did not result from thinking up / inventing a way to computerize or move to the Internet or computer networks something currently in existence or from the past.

While Congress removed via the 1952 Patent Act the *requirement* that an invention be the result of a flash of creative genius in order to be eligible for patenting, neither Congress nor this Court – including with the non-conflicting *Alice* and *Mayo* decisions – have ever abrogated, overruled, or otherwise eliminated this eligibility basis. *See, e.g., Kimble v. Marvel LLC*, 135 S. Ct. 2401 (2015); which says that precedent remains until Congress overturns it. *Shalala v. Ill. Council on Long Term Care*, 529 U.S. 1, 18 (2000) that reversal should be explicit to be effective.

Because Congress has not explicitly reversed *Cuno*, but rather only partially offset it, *Cuno* remains good law as to claims that do not take advantage of the part of the statute meant to address *Cuno*.

Accordingly, the claims of inventions which are, like here, the result of a flash of creative genius are, under *Cuno*, *patent eligible*.

This is eligibility dispositive. The eligibility analysis should have ended there.

II. The Federal Circuit and Patent Office Ignore Patent Office Proof of No Undue Preemption

The Federal Circuit and Patent Office either misunderstood or ignored my no undue preemption argument (DOA footnote #4 at 6 / App. at 24). In stark contrast to my allegedly asserting that the claims “*do not preempt all advertising.*” (something I’ve never said or argued); I instead rely on the Patent Office’s 1,000’s of issued advertising patents to objectively and factually prove that mine preempt just that minimal amount of advertising permitted under *Alice*, *Mayo*, and 35 U.S.C. §101. And nothing more. *U.S. Constitution Article. I, § 8, Cl. 8.*

“We have described the concern that drives this exclusionary principle as one of pre-emption.”

(Alice, 134 S. Ct. at 2354)

As I first supplied during examination in 2015, then later to the PTAB, and most recently to the Federal Circuit; from the 10/19/2004 priority date of my two previously approved and issued *Match Engine Marketing* patents through 2014 (and now through 2019 for this Court), the United States Patent Office reports the following yearly issued advertising patent figures:

Number of Patents with “Advertising” in their Titles

2005: 56	2010: 118	2015:178
2006: 74	2011: 136	2016:164
2007: 55	2012: 199	2017:150
2008: 65	2013: 277	2018:151
2009: 81	2014: 284	2019:220
		Total: <u>2,208</u>

Number of Patents with “Advertisement” in their Titles

2005: 14	2010: 39	2015:120
2006: 18	2011: 71	2016:107
2007: 27	2012: 97	2017:122
2008: 23	2013: 126	2018:113
2009: 17	2014: 169	2019:155
Total: <u>1,218</u>		

Number of Patents with “Advertisements” in their Titles

2005: 11	2010: 47	2015:79
2006: 30	2011: 70	2016:64
2007: 10	2012: 86	2017:88
2008: 20	2013: 120	2018:91
2009: 23	2014: 126	2019:110
Total: <u>975</u>		

Patents with “Advertising” in their Specifications

(To insure accuracy, “Advertisement(s)” numbers not separately included due to potential count overlap with multiple forms of “Advertise” in some specifications.)

2005: 1,909	2010: 4,284	2015:6,648
2006: 2,591	2011: 4,948	2016:6,762
2007: 2,393	2012: 5,853	2017:7,145
2008: 2,507	2013: 6,848	2018:6,918
2009: 2,802	2014: 7,393	2019:8,153
Total: <u>77,754</u>		

As these eye-opening, irrefutable official government records objectively demonstrate and prove beyond a shadow of doubt (no subjective / arguable preemption crystal ball gazing needed here), advertising innovation – *and its resultant robust national and international competition* -- is flourishing since the *Match Engine Marketing* invention. Facts, not fiction.

Furthermore, these already impressive numbers don't even include the potentially up to 1,000's more of *additional* advertising-directed patents which (like mine) contain no form of "Advertise" at all in their titles. The only advertising (much less any other technology) my mere few patents preempt is just that minimal amount to which all inventors are legally and constitutionally entitled to at least under *Alice*, *Mayo*, and 35 U.S.C. §101. And nothing more. *U.S. Constitution Article. I, § 8, Cl. 8*

As the Patent Office's own actual government figures above make starkly and unmistakably clear; not only are my claimed inventions not broad (because if they were, why hasn't the Patent Office used them to prior-art-block 1,000's of post-2004 advertising patents / their claims from issuing – including many, most, or all of the 1,000's of patents above and their 10's of 1,000's of associated claims?); they in fact occupy a very limited -- *indeed only a tiny sliver of* -- the huge, continuously and rapidly expanding universe of myriad types and forms of advertising. Indeed, we're talking here about just a tiny few patents ... out of over 75,000 directed to, involving, or related to advertising.

My invention is not even a blip on the screen or drop in the bucket of this huge worldwide advertising marketplace. *Infinitesimal.*

No research or invention preemption has occurred or is occurring since the invention. No future innovations, or fields of research beyond the actual invention, have been foreclosed. No unwarranted obstruction to follow-on innovations. No building blocks of human ingenuity, fundamental principles or practices, or underlying ideas have been tied up.

No technological progress is being stifled. No unjustifiable impedance or monopolization of the free flow of future discoveries, ideas, and information. No inhibition of the progress of the useful arts. *No one has been or is being denied the same innovation / invention / patenting opportunity I had.*

Research and innovation in this technical field / industry are vibrant and alive ... *everywhere*. 1,000's of federal government vetted and approved, non-preempted patented advertising innovations since 2005 leave no doubt.

Accordingly, the Federal Circuit's *Ariosa Diagnostics, Inc.*, (DOA footnote #4 at 6 / App. at 25) (where such Patent Office eligibility proof – if it even existed-- *was not* provided) – along with any and all, “*absence of complete preemption does not demonstrate patent eligibility*” progeny and brethren Court, PTO examination, and PTAB decisions -- are all easily distinguished from the instant invention and its *PTO-proven-eligible* claims.

The Supreme Court and the Federal Circuit both use preemption as the mechanism to evaluate whether a claim is eligible or not. *See also, e.g., Mayo 132 S. Ct. at 1294*. And they are far from alone, as over 100 District Court decisions since *Alice* have expressly considered whether the claims preempt, even after applying the *Mayo / Alice* framework.

This is eligibility dispositive for the instant claims. The eligibility analysis should have ended there.

III. The Federal Circuit Overrules *Alice* and *Mayo* and establishes their own Section § 101 Law

Even if, *arguendo*, *Cuno* and *no undue preemption* didn't confirm the eligibility of the instant claims; and a proper *prima facie* case *had* been made; the Federal Circuit contravenes the *Alice* framework and improperly creates new Section § 101 law:

First: Though the Panel correctly initially acknowledges that *Alice* requires the identification of no more than one abstract concept (DOA at 6 / App. at 23): “A patent claim is patent ineligible when (1) it is ‘directed to’ a (singular / one) *patent-ineligible concept* (singular / one) . . .” (emphasis / parenthetical provided); the Panel then proceeds to overrule themselves by incorrectly affirming the Board's error of asserting *multiple* abstract ideas against the instant claims: “*The PTAB determined that independent claim 2 is ‘directed to the concepts* (improper plural) *of targeting advertisement for a user, and* (improper plural) *using a bidding system to determine how the advertisements will be displayed.*” (emphasis / parenthetical provided)

The Panel Decision then cements their legal error with the contradictory and conclusory: “*We disagree with Mr. Morsa.*” (the Panel saying that the PTAB's multiple abstract ideas is permissible). (DOA at 6 / App. at 24) (emphasis provided).

Yet, no reasoned basis for multiple abstract ideas was provided. *Why* did the Panel disagree? *What* is the authority? *When* and *where* has the Supreme Court – this Court -- ever said multiple abstract ideas are permissible? Footnote # 4 (DOA at 6 / App. at 24) is here unavailing; as it instead concerns preemption (addressed in II, above).

The Panel then stated: “*Independent claim 2 is directed to the abstract idea and fundamental economic practice of organizing human activities.*”(DOA at 7 / App. at 24); which incorrectly conflates *categories* of abstract ideas with actual abstract ideas themselves. *See, e.g., Alice* at 10 (emphasis / parentheticals provided):

“*Although hedging* (the actual abstract idea) *is a long-standing commercial practice, id., at 599, it is a method of organizing human activity* (the abstract idea category) ...”

Further, just what is the “abstract idea” the Panel’s statement referred to (as well as where else the Panel refers to the “abstract idea”) – given that the Board alleged *Alice* non-compliant *multiple* (both stated and unstated mystery) abstract concepts?

The Federal Circuit’s circular logic reliance on their own, no-authority, multiple-abstract-ideas *RecogniCorp* (DOA at 7; App. at 25) is inapposite. *Alice* – which *RecogniCorp* fundamentally contradicts and conflicts with (as do any and all other cases where multiple abstract ideas / concepts are posited / alleged) – is the controlling, Supreme Court authority on how many abstract ideas may be alleged (one). (emphasis following supplied):

“*We hold that the claims at issue are drawn to the abstract idea of intermediated settlement ...*”
Alice at 2352

“*First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts.*” *Alice* at 2355

“*We must first determine whether the claims at issue are directed to a patent-ineligible concept.*”
Alice at 2355

“The claims at issue in Bilski described a method for hedging against the financial risk of price fluctuations.” Alice at 2355

“These claims are drawn to the abstract idea of intermediated settlement.” Alice at 2355

“It follows from our prior cases, and Bilski in particular, that the claims at issue here are directed to an abstract idea.” Alice at 2356

“Because the claims at issue are directed to the abstract idea of intermediated settlement ...” Alice at 2357

“First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts.” Mayo at 1296-1297

In sharp contrast, neither the Patent Office, nor the Federal Circuit, nor even the Solicitor have ever identified any contrary multiple abstract ideas / concepts quotes from the controlling *Alice*, *Mayo*, and *Bilski*. Which is unsurprising, *as there are none*.

Enough is enough. There’s no confusion here. No subjectivity. No uncertainty. No gray area. No interpretation needed. This Court said what it means and means what it says: One stated abstract idea. All the claims at issue. Not two. Not three. Not four or more. One. One can’t be identified? Then the claims are §101 eligible. The *Alice / Mayo* analysis stops there. Step two is moot. Just as this Court presciently instructed.

Courts – including the Federal Circuit -- cannot modify or supplant this Court’s law regarding patent eligibility. See, e.g. *Rivers v. Roadway Express, Inc.*, 511 U.S. 298, 312 (1994):

"[O]nce the [Supreme] Court has spoken, it is the duty of other courts to respect that understanding of the governing rule of law."

Second: Though the DOA is painfully silent regarding this also important infirmity, it implicitly -- and incorrectly -- permits the startling and inapposite assertion of some unknown number of unknown alleged "similar" concepts: "*Similarly, while the dependent claims are each more specific, they are drawn to the same or a similar concept as well ...*" (PTAB Decision On Appeal at 7) (emphasis provided) (VI; RP at 10 / App. at 9)

As with multiple alleged abstract ideas / concepts, nowhere in *Alice* or *Mayo* does this Court say anything about "similar" (to an alleged one single) abstract concepts being applied against claims.

To insure that all of patent law would not be swallowed, in both decisions this Court wisely stated one idea / concept and stood by it. Start to finish. Beginning to end. Never wavering. Accordingly, the Board's "similar" allegations are inapposite. *Rivers*.

Moreover, how does one even begin to traverse such unidentified, *mystery* concepts? It's impossible. As explained in my briefs, this is a clear denial of due process. *See, e.g., Chester v. Miller*, 906 F.2d 1574, 1578 (Fed. Cir. 1990):

Section 132 "is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection."

“[t]he agency tribunal must make findings of relevant facts, and present its reasoning in sufficient detail that the court may conduct meaningful review of the agency action.” In re Lee, 277 F.3d 1338, 1346 (Fed. Cir. 2002). The Board must “set forth the findings and explanations needed for ‘reasoned decision making’” (emphasis supplied)

As the preceding *First & Second* make clear, neither the Federal Circuit nor the Patent Office are following the eligibility framework this Court established with its issue-controlling *Alice* decision:

No more than one *stated* abstract idea / concept to which all of the claims at issue are directed to.

Why is this Court’s simple (yet critically important) instruction so hard for some to accept and follow?

IV. The Patent Office Overrules *Alice* and *Mayo* and establishes *their own* Section § 101 Law

While the Patent Office is to be commended for doing their level best to stabilize claims eligibility analysis over the past several years, the agency nevertheless tumbles off the rails by materially enabling the swallowing of patent law by joining the Federal Circuit in improperly permitting allegations of *multiple* judicial exceptions in a single claim; including multiple abstract ideas.

Even going the Federal Circuit one worse by tossing their own, Supreme Court-unapproved, innovation-toxic ingredients into the eligibility witches brew. *See, e.g., the Patent Office’s October 2019 Update* (emphasis in original):

October 2019 Update: Subject Matter Eligibility

I. Evaluating Whether a Claim Recites a Judicial Exception at Step 2A Prong One

B. Multiple Judicial Exceptions Recited in a Claim

Clarification was requested on how claims reciting multiple judicial exceptions are treated. A claim can recite more than one judicial exception (i.e., abstract idea, law of nature, or natural phenomenon). MPEP 2106.05(II) when analyzing the claims for eligibility.⁶ 5 In some claims, the multiple exceptions are distinct from each other, e.g., a first limitation describes a law of nature, and a second limitation elsewhere in the claim recites an abstract idea. In these cases, examiners should continue to follow existing guidance in MPEP 2106.05(II) when analyzing the claims for eligibility.⁶

Other claims may recite multiple abstract ideas, which may fall in the same or different groupings, or multiple laws of nature. In these cases, examiners should not parse the claim. For example, in a claim that includes a series of steps that recite mental steps as well as a mathematical calculation, an examiner should identify the claim as reciting both a mental process and a mathematical concept for Step 2A Prong One to make the analysis clear on the record. However, if possible, the examiner should consider the limitations together to be an abstract idea for Step 2A Prong Two and Step 2B (if necessary) rather than a plurality of separate abstract ideas to be analyzed individually.⁷ This is illustrated in, e.g., Example 45 (Controller for Injection Mold), and Example 46 (Livestock Management).

Patent madness indeed. Eligibility analyses are frustrating and confounding enough for everyone – including for our busy Courts – without the Fed. Cir. and Patent Office improperly piling on multiple and mystery abstract concepts to the *Alice / Mayo* analysis.

Only this Court can put an end to it.

Given the preceding and with no time to waste, this case is the ideal vehicle to end the madness.

Companies and investors are withholding R&D and other investments they would have made before the CAFC and Patent Office went ineligibility amok. Waiting to intervene could inflict irreparable U.S. industry harm – especially in the economy-ravaged age of Covid-19.

Conclusion

With Section § 101 Law now firmly and unconstitutionally in the malleable, unchecked hands of the Federal Circuit and Patent Office, the petition for a writ of certiorari should be granted.(1)(2)

Respectfully requested July 8th, 2020.

/s/ Steve Morsa

1 In its woeful, jaw-dropping unwillingness to rebalance and restore the broken scales of justice, the Federal Circuit also contravened settled law by: 1. Improperly permitting the Solicitor to raise new arguments and rationales for the first time on appeal (I; RP at 3 / App. at 3); 2. Improperly permitting the Patent Office to break their own *Rules & Regulations* (II; RP at 4 / App. at 3); 3. Ignoring the lack of a required Patent Office *prima facie* case (V; RP at 7 / App. at 6); 4. Incorrectly affirming that a representative claim exists (VIII; RP at 14 / App. at 11); 5. Ignoring the integral technological elements which confirm eligibility of the claims (IX; RP at 15 / App. at 13); 6. Ignoring the computer function improvements which confirm eligibility of the claims (X; RP at 17 / App. at 14).

The Patent Office also contravened settled law by: 1. Breaking their own *Rules & Regulations* (II; RP at 4 / App. at 3); 2. Failing to make the required *prima facie* case (V; RP at 7 / App. at 6); 3. Improperly designating a representative claim (VIII; RP at 14 / App. at 11); 4. Ignoring the integral technological elements which confirm eligibility of the claims (IX; RP at 15 / App. at 13); 5. Ignoring the computer function improvements which confirm eligibility of the claims (X; RP at 17 / App. at 14).

In defending two *facts and law indefensible* PTAB decisions, the Solicitor also contravened settled law by raising new arguments and rationales for the first time on appeal (I; RP at 3 / App. at 3).

2 As NPR and others have reported and historical Patent Office and government edicts and records reflect; our nation has a long and sordid history of denying and restricting African Americans from obtaining patents. *See, e.g.,* Dr. Lisa Cook, *Patent Racism* (NPR 2020); Brian L. Frye, *Invention of a Slave*, 68 Syracuse L. Rev. 181, 194 (2018) (historical analysis); Kara W. Swanson, *Race and Selective Legal Memory: Reflections on Invention of a Slave*, 120 Columbia Law Review 1077 (2020) (reflection on historical and ongoing impact); Professor Dennis Crouch, *Invention of a Slave and the Ongoing Movement for Equal Justice* (PatentlyO 2020).

Most recently, the Federal Circuit, Patent Office, and Solicitor's above-detailed misapplication of the *Alice / Mayo* eligibility framework is causing especially severe damage to these and other beleaguered minority and female inventors. To those least able to obtain critical patent protection and financing for their inventions and the new companies to be created therefrom.

Shockingly and abhorrently, fewer than 1% of start-up founders who receive venture funding are Black. Less than 1% are Women of Color. Less than 3% are Women. The difficulty in or impossibility of obtaining – or holding onto -- patent protection for their innovations is one of the reasons why.

No patents. No funding. No new companies. No new jobs. No American opportunity for them or their families.

This Court – Your Honors – can and should use this case to help put an end to this long-entrenched innovation inequity.

“A new and useful machine invented by a slave cannot be patented.”

Attorney General's Office, June 10, 1858