

No. _____

IN THE
Supreme Court of the United States

INTERACTIVE WEARABLES, LLC,
Petitioner,

v.

POLAR ELECTRO OY AND POLAR ELECTRO INC.,
Respondents.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The patents-in-suit are directed to an electronic hardware device comprising a content player/remote-control combination having numerous concretely-recited components that undisputedly qualifies as a “machine” or “manufacture” under the statutory language of 35 U.S.C. § 101. Nevertheless, the court below found the claims of the patents-in-suit invalid under Section 101, on a motion to dismiss, for claiming nothing more than the abstract idea of “providing information in conjunction with media content.” As a justification for disregarding each recited structural component from its characterization of what the claims are “directed to,” the court resorted to a factual, enablement-style analysis of the level of detail in the specification and declared it insufficient to support patentability.

The questions presented are:

1. What is the appropriate standard for determining whether a patent claim is “directed to” a patent-ineligible concept under step one of the Court’s two-step framework for determining whether an invention is eligible for patenting under 35 U.S.C. § 101?
2. Is patent eligibility (at each step of the Court’s two-step framework) a question of law for the court based on the scope of the claims or a question of fact for the jury based on the state of art at the time of the patent?
3. Is it proper to apply 35 U.S.C. § 112 considerations to determine whether a patent claims eligible subject matter under 35 U.S.C. § 101?

CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, petitioner Interactive Wearables, LLC states that it is a wholly owned subsidiary of Poltorak Technologies LLC and no publicly held company owns 10% or more of Interactive Wearables, LLC's stock.

RELATED PROCEEDINGS

The following proceedings are directly related to this case within the meaning of this Court's Rule 14.1(b)(iii):

Interactive Wearables, LLC v. Polar Electro Oy and Polar Electro Inc., Case No. 2:19-cv-03084 (E.D.N.Y.), judgment entered on November 30, 2020.

Interactive Wearables, LLC v. Polar Electro Oy and Polar Electro Inc., Case No. 21-1491 (Fed. Cir.), judgment entered on October 14, 2021.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Interactive Wearables, LLC (“Interactive Wearables” or “Petitioner”) respectfully submits this petition for a writ of certiorari to review the judgment of the U.S. Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The court of appeals’ opinion in *Interactive Wearables, LLC v. Polar Electro Oy and Polar Electro Inc.*, Case No. 21-1491 (App. 1–2) is not published in the Federal Reporter but is reprinted at 2021 WL 4783803 (Fed. Cir. Oct. 14, 2021). The court of appeals’ order denying panel rehearing and rehearing *en banc* is unreported but is reproduced at App. 48-49. The opinion of the district court granting Polar Electro Oy and Polar Electro Inc.’s (collectively, “Polar” or “Respondents”) motion to dismiss Interactive Wearables’ complaint is reported at 501 F.Supp.3d 162 (App. 3–45).

JURISDICTION

The Federal Circuit entered judgment on October 14, 2021. Interactive Wearables filed a petition for panel rehearing and rehearing *en banc*, which the court denied on December 20, 2021. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 101 of Title 35 of the U.S. Code 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 112(a) of Title 35 of the U.S. Code provides: “The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.”

PRELIMINARY STATEMENT

Since the Court’s 2014 decision in *Alice Corporation Pty. Ltd. v. CLS Bank International*, 573 U.S. 208 (2014), the lower courts have not applied the test for determining patent eligibility under 35 U.S.C. § 101 in a uniform or consistent manner. *See, e.g., Am. Axle & Mfg. v. Neapco Holdings LLC*, 977 F.3d 1379, 1382 (Fed. Cir. 2020) (Moore, J., concurring) (noting that the Federal Circuit is “at a loss as to how to uniformly apply § 101”). Indeed, the entirety of the Federal Circuit has unanimously urged the Court to provide guidance in this area. *Id.*

This petition presents essential questions regarding the proper analysis for determining whether a patent claims eligible subject matter under Section 101. Interactive Wearables’ patent claims are directed to a concretely-recited electronic hardware device comprising the combination of a content player and a remote control, having numerous concretely-recited components. It was undisputed below that the claimed device qualifies as a “machine” or “manufacture” per the statutory language of Section 101. Nevertheless, the Federal Circuit summarily affirmed the district court’s invalidation of the claims under Section 101—on a motion to dismiss—as directed to nothing more than an abstract idea.

The district court reached its determination only by conducting a misplaced analysis of the level of detail recited in the *specification* regarding the components of the device recited in the *claims*, rather than the claim limitations themselves. That approach is more akin to the analysis courts employ to resolve questions of enablement under 35 U.S.C. § 112, not subject matter

eligibility under Section 101. Based on its misplaced quasi-enablement analysis, the district court improperly disregarded every recited claim component from its determination of what the claimed content-player/remote-control combination is “directed to” at step one of the *Alice* patent eligibility test, and declared that the claims were instead directed to the abstract idea of “providing information in conjunction with media content”—words not even appearing in the claim. That is a clear mischaracterization of the claims, and the district court should not have performed a cursory analysis of enablement to change the fundamental nature of what the claims are “directed to” for purposes of analyzing eligibility under Section 101.

Both this Court and the Federal Circuit have made clear that the proper analysis of what a claim is directed to at step one must remain focused on the claim language itself, and ultimately consider whether the claim as a whole, not statements in the specification, poses a risk of pre-empting an abstract idea. Here, the district court wrongly determined that the claim is directed to an abstract idea despite its own tacit recognition that the claim does not even pre-empt its stated abstract idea.

Allowing the panel’s affirmance to stand would send a clear signal to the lower courts, effectively endorsing an approach to the step one analysis that allows for disregarding claim elements of an unconventional arrangement of physical components by mining the specification for an abstract idea and declaring that the specification insufficiently describes all physically claimed components. This Court has never endorsed such an approach to step one of the eligibility analysis. Indeed, a tersely described physical

component remains as concrete as the same component described with much verbiage. Widespread application of such an approach to determining what a claim is directed to—an approach that is largely untethered to the claim language itself—would make the current confusion regarding the proper application of the test for eligibility under Section 101 look tame by comparison.

As discussed *infra*, this petition raises issues similar to those presented in the petition in *American Axle & Manufacturing, Inc. v. Neapco Holdings, LLC*, et al., Case No. 20-891 (filed December 28, 2020), a pending case in which the Court has called for the views of the Solicitor General. In *American Axle*, a sharply divided Federal Circuit affirmed the district court’s decision that certain claims directed to a process of reducing vibration in a vehicle driveshaft were not patent eligible because they were directed to a natural law. Judge Moore criticized the majority in *American Axle* for “imbu[ing] § 101 with a new superpower—enablement on steroids.” *See Am. Axle & Mfg. v. Neapco Holdings LLC*, 967 F.3d 1285, 1305 (Fed. Cir. 2020) (Moore, J., dissenting). The district court here performed just such a quasi-enablement analysis to find that Interactive Wearables’ claims were ineligible under Section 101.

Accordingly, Interactive Wearables respectfully requests that the petition be held pending the outcome of the petition in *American Axle* and any further proceedings in that case. If the Court grants the petition in *American Axle*, then the Court should grant this petition, vacate the judgment of the Federal Circuit, and remand this case to the Federal Circuit for further proceedings in view of any decision this Court may reach on the merits in *American Axle*. Alternatively,

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Interactive Wearables respectfully submits that this petition should be granted for the reasons detailed *infra*.

STATEMENT OF THE CASE

A. Statutory Background

Section 101 of the Patent Act broadly defines patent-eligible subject matter as including “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. Through this broad definition, “Congress intended statutory subject matter to ‘include anything under the sun that is made by man.’” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980) (quoting S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952)).

There are, however, three narrowly crafted judicial exceptions to Section 101, “laws of nature, natural phenomena, and abstract ideas,” which are not eligible for patent protection. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). This Court has cautioned that these exceptions should not be too broadly applied “lest [the exceptions] swallow all of patent law.” *Alice*, 573 U.S. at 217 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 71 (2012)). To determine whether a patent falls within one of the exceptions to Section 101, a court undertakes a two-step test. *Id.* at 217–18.

First, the court considers whether the claims are directed to a law of nature, natural phenomena, or an abstract idea. *Alice*, 573 U.S. at 217. If the claims are not “directed to” an abstract idea, the inquiry ends in favor of patent eligibility. *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1363 (Fed. Cir. 2018). If the court determines the claims are directed to an abstract idea, then it “consider[s] the elements of each claim both individually and as an

ordered combination” to identify whether the claims include an “inventive concept” that “amounts to significantly more” than a patent on the abstract idea itself. *Alice*, 573 U.S. at 217–18 (internal quotation marks and citation omitted). If so, the claims at issue are patent eligible.

Ultimately, the eligibility test is not merely a philosophical inquiry into what is or is not “abstract,” but rather serves a practical need to identify when there is a risk that a claim will pre-empt others from using an abstract idea regardless of how it is implemented. *Mayo*, 566 U.S. at 85; *see also Bilski v. Kappos*, 561 U.S. 593, 611–12 (2010) (“Allowing petitioners to patent risk hedging would pre-empt use of this approach in all fields, and would effectively grant a monopoly over an abstract idea.”); *Alice*, 573 U.S. at 216 (“We have described the concern that drives this exclusionary principle as one of pre-emption.”). In other words, the inquiry is meant to address a practical “concern that patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity.” *Id.* (internal quotation marks and citation omitted).

This case serves as yet another example of how the lower courts have misconstrued the Court’s two-step patent eligibility framework.

B. Interactive Wearables’ Patented Invention

The patents-in-suit are directed to improved devices for playing audio and visual media content, such as cellphones, radios, and wearable devices. ’016 Patent

at 1:44–2:42.¹ As the specification explains, prior art devices that played media content did not contain components permitting a user to view information about media content being played, such as the title of a song being listened to or a show being viewed, while the content was being played. The inventor created devices containing a display screen integrated into a wirelessly-coupled remote control, which permitted a user to view information regarding media content on a separate display while continuing to experience the media content on the media content player.

The inventor filed the utility applications for the claimed new and improved content players in 2002. As explained in the specification of the patents-in-suit, by that time, “individuals [were] use[d] to, and ha[d] come to expect, if not demand, to have information available to them instantaneously.” ’016 Patent at 2:37–39. Despite this customer demand, “no system or apparatus [wa]s [then] available which c[ould] provide radio broadcasts or television broadcasts along with information regarding the content of the respective broadcast.” *Id.* at 2:39–42. Due to the limitations of existing media content players in 2002, when a device user desired to learn information regarding media content, such as the name of a song, or an actor in a digital video, such information was typically only provided either before or after the media content, such as a radio deejay introducing a song or credits shown after a video

¹ The patents-in-suit are U.S. Patent Nos. 9,668,016 (“’016 Patent”) and 10,264,311 (“’311 Patent”), which share a common specification. Citations to the specification herein refer to the ’016 Patent’s specification unless otherwise indicated.

production. *Id.* at 1:64–2:2 (explaining the conventional manner of acquiring “information regarding” media content was that such information was “introduced prior to, or announced subsequent to, the broadcast of the respective . . . program[] . . . [but] the information [wa]s typically not provided during the course of the broadcast”). “[A]s a result,” prior to the claimed invention, “an individual who misse[d] the respective introduction or announcement may never receive the desired information.” *Id.* at 2:2–4. The desire to overcome the problem with existing devices spurred the inventor to create new media players remedying “the shortfalls of the prior art.” *Id.* at 2:48.

The patents-in-suit describe and claim a novel, improved content player. The claimed devices comprise “a wearable content player,” which, among other things, has a display and playing device equipment, as well as a receiver that receives content together with information about that content. ’016 Patent at 26:7–9, 26:15–20. The wearable content player further wirelessly couples with a remote control having a second display, through which a user can remotely control the wearable content player, and which remote control can receive and display information from the content player about the content being played to a user. *Id.* at 26:20–27. Thus, the claimed remote is not merely a one-way remote control device used to control a content-player; it is a two-way communication device that both controls a content-player and that also receives information for display from the content-player. These components of the new and improved content player were not conventional at the time of the claimed inventions.

The claims of the patents-in-suit are directed to, and narrowly claim, tangible, physical inventions

comprising components arranged in a specific way to achieve the specific objects of the invention. For example, claim 32 of the '016 Patent recites:

A content player comprising:

a receiver configured to receive content and together with the content information associated with the content,

a processor coupled to the receiver and configured to process the content and the information associated with the content,

memory coupled to the processor,

a first display coupled to the processor, and

playing device equipment coupled to the processor and configured to provide the content to a user of the content player, the playing device equipment comprising an audio player;

wherein the content player is a wearable content player configured to be controlled by a wireless remote control device comprising a second display,

the wireless remote control device being configured to receive commands directing operations of the wearable content player, and wherein the wireless remote control device is configured to provide to the user at least a portion of the information associated with the content.

Id. at 26:7–27.

C. Proceedings Below

On May 23, 2019, Interactive Wearables filed a complaint against Polar alleging infringement of the patents-in-suit. App. 3–4. In response, Polar moved to dismiss the complaint for failure to state a claim under

Rule 12(b)(6) of the Federal Rules of Civil Procedure, alleging that the patents-in-suit are directed to patent-ineligible subject matter. *Id.* at 6. Polar argued that the claims of the patents-in-suit are directed to the abstract idea of “providing information related to certain media . . . using a content player that includes generic components used for their common purpose.” *Id.* at 16–17.

In opposition, Interactive Wearables explained that the claims are each directed to “a physical device having a specific combination of non-generic hardware components with specific features.” App. 17. Interactive Wearables further argued that Polar’s proposed abstract idea improperly ignored the vast majority of claim limitations. *Id.* at 17–18. Additionally, Interactive Wearables urged that the claims included inventive concepts and that, at the very least, questions of fact on whether such limitations were not well-understood, routine, and conventional at the time of the invention precluded a finding against Interactive Wearables at the motion to dismiss stage. *Id.* at 31.

On November 19, 2020, the district court granted Polar’s motion and found claims 1–32 of the ’016 Patent and claims 1–32 of the ’311 Patent invalid as directed to patent-ineligible subject matter. App. 14–16. The district court determined that claim 32 of the ’016 Patent was representative of all claims in the patents-in-suit and analyzed that claim in making its ineligibility determination. *Id.* at 16.

The district court held that the claims are directed to the abstract idea of “providing information in conjunction with media content, ‘applied to the context’ of content players.” App. 22. The district court found that the claims “merely apply the abstract idea behind

consulting a TV Guide—i.e., ‘to obtain more information’ about a program while viewing it—to a content player, rather than ‘provide[] a technological improvement’ to the content player itself.” *Id.* at 23–24. In determining what the claims are “directed to” the district court disregarded every concretely-recited component of the claimed device by finding that the specification failed to describe their operation in sufficient detail or failed to expressly characterize such components as inventive. *See, e.g., id.* at 19 (n.6) (“[T]he specification goes to great lengths to avoid any specifics in describing the components.”); *see also id.* at 18–20 (disregarding physical components of the content-player/remote-control combination because other than the purported abstract idea “[n]othing else is described in the specification as the invention” and the “specification fails to provide any technical details for the tangible components”).

The district court further found that the claims failed to add any inventive concept beyond that purported abstract idea because they “merely invoke conventional and generic components arranged in a conventional manner.” App. 33. In reaching its conclusion, the district court acknowledged that the specification and claims “‘purport to describe’ an improved content player which allows for the ability to provide information in conjunction with media content . . .” *Id.* However, the district court disregarded that evidence, finding the patents-in-suit are “wholly devoid of details which describe how this is accomplished.” *Id.* (internal quotation marks and citation omitted). The district court also did not credit the complaint’s factually supported allegations that the claims include inventive concepts that were not well-

understood, routine, and conventional at the time of the invention. *Id.* at 33–34, 39–41. The district court reasoned that such allegations were “mere conclusory statements,” and that the specification conceded the conventionality of certain claimed components. *Id.* at 34. The district court further relied on evidence outside of the record that it found on an Internet website to support its factual determination that the claimed remote control was conventional. *Id.* at 32–33 (n.9); *Id.* at 41 (n.14).

Interactive Wearables timely appealed from the district court’s dismissal order and judgment. The Federal Circuit held oral argument on October 7, 2021. On October 14, 2021, the Federal Circuit affirmed the district court’s ineligibility ruling, without explanation, in a judgment pursuant to Federal Circuit Rule 36. App. 1–2. Interactive Wearables timely filed a combined petition for rehearing *en banc* and panel rehearing, which the Federal Circuit denied on December 20, 2021. *Id.* at 48–49.

On December 28, 2020, shortly after the district court granted Polar’s motion to dismiss Interactive Wearables’ complaint, the plaintiff in *American Axle & Manufacturing v. Neapco Holdings LLC* filed a petition for writ of certiorari presenting substantially similar questions as those at issue in this case. *See Am. Axle & Mfg., Inc. v. Neapco Holdings, LLC* (No. 20-891). In particular, American Axle identified the following two questions:

1. What is the appropriate standard for determining whether a patent claim is “directed to” a patent-ineligible concept under step 1 of the Court’s two-step framework for determining

whether an invention is eligible for patenting under 35 U.S.C. § 101?

2. Is patent eligibility (at each step of the Court’s two-step framework) a question of law for the court based on the scope of the claims or a question of fact for the jury based on the state of art at the time of the patent?

No. 20-891 Pet. i. On May 3, 2021, the Court invited the Acting Solicitor General to file a brief in *American Axle* stating the views of the United States. The petition in *American Axle* is still pending.

REASONS FOR GRANTING THE PETITION

I. A MERITS DECISION IN *AMERICAN AXLE* WILL INFORM THE PROPER OUTCOME OF THIS CASE

This petition presents the same questions as the petition for a writ of certiorari filed in *American Axle*, No. 20-891, and if the Court grants the petition in *American Axle*, then a merits decision in that case will directly impact the proper disposition of this case. Accordingly, this Court should hold this petition pending final disposition of *American Axle* and dispose of it as appropriate in light of that decision or grant this petition.

First, if the Court in *American Axle* decides the question of “the appropriate standard for determining whether a patent claim is ‘directed to’ a patent-ineligible concept,” then the Federal Circuit’s judgment in this case will have to be vacated and remanded to apply the standard articulated by the Court. For example, in *American Axle*, the Federal Circuit held that the patent

claims were ineligible “because they don’t teach *how* to tune a liner.” *Am. Axle*, 967 F.3d at 1316 (Moore, J., dissenting). As Judge Moore aptly noted, in doing so, the majority improperly “imbued § 101 with a new superpower—enablement on steroids.” *Id.* Here too, as detailed more fully *infra*, the district court improperly conducted a quasi-enablement analysis to determine what the claims were directed to at step one of the subject matter eligibility test. Indeed, the district court determined it could disregard claimed components from the “directed to” inquiry because the *specification* allegedly failed to describe such components in enough detail. *See, e.g.*, App. 19 (n.6) (“[T]he specification goes to great lengths to avoid any specifics in describing the components.”); *see also id.* at 20 (disregarding physical components of the content-player/remote-control combination because the “specification fails to provide any technical details for the tangible components”).

Second, if the Court in *American Axle* determines that “patent eligibility (at each step of the Court’s two-step framework)” involves a “question of fact for the jury based on the state of art at the time of the patent,” that would also impact the proper outcome here. In this case, no factual issues concerning the patent eligibility analysis were presented to a jury. Instead, on a motion to dismiss, the district court made factual determinations about the adequacy of the specification’s disclosure to discount the claimed receiver and remote control components from the “directed to” inquiry at step one, and from the inventive concept inquiry at step two. *See, e.g.*, App. 21 (discounting from step one’s “directed to” inquiry the entirety of the claimed remote control component based on its factual determination that specification only described the component in

“vague terms”); *Id.* at 33 (making a factual determination that none of the claimed components could comprise inventive concept at step two because they were “conventional and generic components arranged in a conventional manner”).

Indeed, the district court searched for evidence outside of the record and factually interpreted it against Interactive Wearables’ interest on a motion to dismiss to support its factual finding that the claimed remote control was conventional, rather than present such a factual issue to a jury after full development of the factual record. App. 32–33 (n.9) (conducting its own Internet search for prior art to contradict the complaint’s factual allegations of unconventionality); *Id.* at 41 (n.14) (citing results of its Internet search as factual support for its conventionality finding). If the Court determines that questions of fact impact any aspect of the patent eligibility inquiry, then that ruling also would require the Federal Circuit to reconsider this case.

Accordingly, in view of the highly similar issues presented both here and in *American Axle*, Interactive Wearables respectfully requests that the Court hold this petition pending the outcome in *American Axle*. If the Court grants the petition in *American Axle*, then the Court should grant this petition, vacate the judgment below, and remand this case to the Federal Circuit for further proceedings in view of any decision this Court may reach on the merits in *American Axle*.

II. THE DECISION BELOW IMPROPERLY CONFLATED ENABLEMENT WITH PATENT ELIGIBILITY

The district court’s step one analysis was infected by its legally erroneous use of the specification to erase

every claimed physical component individually, as well as the unconventional arrangement of physical components collectively, from the “directed to” inquiry. Specifically, with respect to the claimed two-way remote control with a display, the district court determined that the *specification* failed to describe such component in enough detail and, therefore, it could be disregarded from the “directed to” inquiry. *See, e.g.*, App. 19 (n.6) (“[T]he specification goes to great lengths to avoid any specifics in describing the components.”); *see also id.* at 18–20 (disregarding physical components of the content-player/remote-control combination because other than the purported abstract idea “[n]othing else is described in the specification as the invention” and the “specification fails to provide any technical details for the tangible components”). Such a quasi-enablement analysis as to the level of description in the *specification* of a component recited in the *claims* may be relevant to questions of compliance with Section 112, but it has no place in the Section 101 inquiry.

Indeed, this Court has explained that patent eligibility under Section 101 is separate from the other requirements for patentability under the Patent Act, including the enablement inquiry of Section 112. *See Bilski*, 561 U.S. at 602 (“The § 101 patent-eligibility inquiry is only a threshold test. Even if an invention qualifies as a process . . . in order to receive the Patent Act’s protection the claimed invention must also satisfy ‘the conditions and requirements of this title[,]’ [which] requirements include that the invention be novel, see § 102, nonobvious, see § 103, and fully and particularly described, see § 112.”); *see also Mayo*, 566 U.S. at 91 (“These considerations lead us to decline the Government’s invitation to substitute §§ 102, 103, and

112 inquiries for the better established inquiry under § 101.”).

The Federal Circuit has similarly recognized that Claims “that are not enabled raise questions of patentability [under Section 112], not eligibility.” *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1354 (Fed. Cir. 2016) (Newman, J., concurring). The Federal Circuit has further indicated that the question of a specification’s level of detail should not play a role in the Section 101 inquiry. *See Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1261 (Fed. Cir. 2017) (recognizing enablement plays no role in whether a claim satisfies Section 101). In particular, the Federal Circuit has held that there are “two different ‘how’ requirements in patent law.” *Am. Axle*, 967 F.3d at 1302. According to the Federal Circuit, Section 101 has a “how” requirement “that the claim itself . . . must go beyond stating a functional result; it must identify ‘how’ that functional result is achieved by limiting the claim scope to structures specified at some level of concreteness.” *Id.* But the other “distinct ‘how’ requirement” relates to the separate question of enablement under Section 112 and analyzes whether the specification “set[s] forth enough information for a relevant skilled artisan to be able to make and use the claimed structures or perform the claimed actions.” *Id.*

Here, the district court did not find that the claims fail to specify the relevant components “at some level of concreteness.” There was no dispute that the claims on their face recite such components in a sufficiently concrete manner. Instead, the district court focused on the separate enablement inquiry concerning the *specification’s* level of detail of such components’ operation. That was a clear legal error. *Am. Axle*, 967

F.3d at 1302 (Section 101 is not concerned with “whether the specification has adequately described how to make and use the concretely claimed structures.”). Precedent offers no support for the proposition that a claim, which on its face is directed to a combination of concrete components, can be transformed into an abstract idea merely by looking to the specification’s level of detail regarding such components. In fact, if the specification were *silent* about each of the claimed components, that might mean that the claim lacks adequate support under Section 112, but that should have no bearing on whether the claim satisfies Section 101. It certainly could not transform the claimed unconventional arrangement of concrete components into an abstract idea.

Moreover, this Court has taught that the very concern that drives the abstract idea exception is “one of pre-emption” and that the exception is meant to ensure that “patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity.” *Alice*, 573 U.S. at 216 (internal quotation marks and citation omitted). Here, the district court recognized the two-way remote control content player combination claims would not pre-empt the alleged abstract idea of “providing information in conjunction with media content.” *See* App. 28 (recognizing that Interactive Wearables’ claims “would not cover *any* content player capable of providing information alongside content” because the claimed combination requires a content-player that can be “controlled by another device with a display”).

The district court’s reliance on the specification’s level of detail, rather than the lack of pre-emption concerns, implicates the very issue with which Judge Moore disagreed in *American Axle*: “[t]he majority’s

concern is not preemption... (which should be the focus), but rather that the claims do not teach a skilled artisan how to tune a liner without trial and error.” *Am. Axle*, 967 F.3d at 1316 (Moore, J., dissenting). By affirming the district court’s decision without opinion, the panel below has effectively endorsed the improper quasi-enablement ineligibility analysis that is causing division at the Federal Circuit. *Am. Axle*, 977 F.3d at 1382 (Moore, J., concurring) (“What we have here is worse than a circuit split—it is a court bitterly divided.”).

This Court should grant certiorari to clarify that step one of the patent eligibility test cannot be determined by a quasi-enablement inquiry into the level of description in the *specification* of components that are concretely recited in the *claims*. This Court’s precedent includes no such analysis at step one. *See Alice*, 573 U.S. at 218-21. Moreover, the Federal Circuit has expressly held that analyzing whether a specification details “how” a claimed limitation is achieved is not part of the patent eligibility inquiry. *See Am. Axle*, 967 F.3d at 1302.

III. THE QUESTION OF RELIANCE ON THE SPECIFICATION’S LEVEL OF DETAIL IN THE ABSTRACT IDEA INQUIRY IS AN IMPORTANT AND RECURRING ISSUE

The issue of whether courts can conduct a quasi-enablement inquiry to determine what a claim is “directed to” as part of the abstract idea analysis is critically important to the patent system. As referenced above, for example, Judge Moore recognized in *American Axle* that the majority’s decision “has imbued § 101 with a new superpower—enablement on steroids... [which] is certain to cause confusion for

future cases.” *Am. Axle*, 967 F.3d at 1305 (Moore, J., dissenting).

More broadly, as Judge Moore also noted, the Federal Circuit’s inability to consistently apply this Court’s Section 101 jurisprudence has caused it to become “bitterly divided” on Section 101. *Am. Axle*, 977 F.3d at 1382 (Moore, J., concurring). This observation is consistent with the recent numerous calls from many different areas of the patent landscape to bring clarity and consistency to the state of the law of patent eligibility. American Axle’s petition accurately details the uncertainty and turmoil caused by the recent patent eligibility jurisprudence. *See Am. Axle* petition, case no. 20-891, pp. 27–33 (Dec. 28, 2020) (“The entire patent system is calling for guidance from the Court.”).

The issue of whether courts can substitute the Section 101 inquiry with a quasi-enablement inquiry, as the district did here, is also a recurring issue. Indeed, several recently filed petitions to this Court, in addition to *American Axle*, have effectively raised the same issue. *See* Pet. for Writ of Cert. in *iLife Techs., Inc. v. Nintendo of Am., Inc.*, No. 20-1760 (June 14, 2021) at p. 13; Pet. for Writ of Cert. in *VoIP-Pal.com, Inc. v. Apple, Inc., et al.*, No. 20-1809 (June 25, 2021) at pp. 17–32; Pet. for Writ of Cert. in *WhitServe LLC v. Dropbox, Inc.*, No. 21-812 (November 24, 2021) at pp. 25–29; Pet. for Writ of Cert. in *Gabara v. Facebook, Inc.*, No. 21-1106 (February 7, 2022) at pp. 18–22.

This issue will likely keep recurring until this Court grants certiorari and provides guidance that will discourage the Federal Circuit and district courts from importing enablement concerns into the abstract idea inquiry of Section 101.

IV. THIS CASE WOULD BE A GOOD VEHICLE FOR REVIEW

The Federal Circuit summarily affirmed the district court's determination that the claims' concretely-recited content-player/remote-control combination is an unpatentable abstract idea. In particular, the district court held that the claims are directed to the abstract idea of "providing information in conjunction with media content, 'applied to the context' of content players." App. 22. Until the recent chaos in Section 101 jurisprudence, it would have been unthinkable to consider such a "mechanical and electronic device of defined structure and mechanism," *Yu v. Apple Inc.*, 1 F.4th 1040, 1046 (Fed. Cir. 2021) (Newman, J., dissenting), to be nothing more than an abstract idea, and certiorari is necessary to clarify that the Federal Circuit has overreached.

The Federal Circuit in *American Axle* similarly held that subject matter that not long ago would not reasonably have even been challenged as ineligible—a process directed to reducing vibration in a motor vehicle driveshaft—was nevertheless ineligible. Yet the Federal Circuit did so in that case under the "law of nature" exception to Section 101—different from the "abstract idea" exception at issue here. By considering the eligibility of the patents-in-suit in this case and *American Axle* at the same time—two cases that involve different Section 101 exceptions and different technologies—the Court can fashion a test that can be consistently applied in cases involving the different exceptions to Section 101 across a wide range of technologies.

Moreover, in certain respects, this case presents an even better vehicle for review than *American Axle*.

The patents-in-suit here involve relatively straightforward and understandable technology—a content player for audio or video content with a series of concretely-recited components for implementing various recited features. Unlike in *American Axle*, there is no question surrounding whether the claims are directed to a complex mathematical formula. Further, the claimed content player here is a consumer hardware electronics device. Section 101 challenges to such types of inventions—unthinkable until recently—have become more prevalent in today’s confusing subject matter eligibility jurisprudence. *See, e.g., Yu*, 1 F.4th 1040 (Section 101 challenge to claims directed to a digital camera.). Accordingly, the Court’s analysis in resolving this petition would likely be applicable to numerous subject matter eligibility challenges concerning such inventions.

And, as referenced above, unlike *American Axle*, this case involves the “abstract ideas” exception to Section 101. The “abstract ideas” exception is more commonly invoked in eligibility challenges than the “laws of nature” exception at issue in *American Axle*.

Finally, the Federal Circuit’s decision not to issue an opinion explaining its reasons for affirmance here should not discourage the Court from granting certiorari. “[T]he Court grants certiorari to review unpublished and summary decisions with some frequency.” Stephen M. Shapiro et al., *Supreme Court Practice* 264 (10th ed. 2013). For example, this Court recently granted certiorari in a case involving a patent dispute where, like here, the Federal Circuit did not issue a written opinion. *See Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC* No. 16-712, 137 S.Ct. 2239 (U.S. June 12, 2017). At least one former

justice “tend[ed] to vote to grant more on unpublished opinions, on the theory that occasionally judges will use the unpublished opinion as a device to reach a decision that might be a little hard to justify.” J. Cole & E. Bucklo, *A Life Well Lived: An Interview with Justice John Paul Stevens*, 32 *Litigation* 8, 67 (Spring 2006). Here, the oral argument before the Federal Circuit indicates that the panel may have experienced such difficulty justifying its decision. Indeed, when questioning Interactive Wearables’ counsel about the specification’s level of detail regarding the claimed remote control component, one panel member acknowledged: “I know I sound like I’m talking about enablement, I know, I understand the problem.” Fed. Cir. Oral Argument at 15:30–46 (Oct. 7, 2021) available at https://oralarguments.cafc.uscourts.gov/default.aspx?fl=21-1491_10072021.mp3. Still, the Federal Circuit chose to affirm but not to explain its reasons for affirmance.

Even without a written opinion from the Federal Circuit, however, the district court’s opinion raises strikingly similar issues to those in *American Axle*. Accordingly, Interactive Wearables respectfully requests the Court grant certiorari to address the important issues raised in this petition.

CONCLUSION

In conclusion, Interactive Wearables respectfully requests that this petition be held pending the disposition of the petition in *American Axle* and any further proceedings in that case. If the Court grants the *American Axle* petition, then it should grant this petition, vacate the judgment of the Federal Circuit, and

remand this case to the Federal Circuit for further proceedings in light of any decision this Court may reach on the merits in *American Axle*.

Alternatively, Interactive Wearables respectfully requests that the Court grant this petition irrespective of whether it grants the petition in *American Axle*.

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