No. 22-1220

In The
Supreme Court of the United States

Jeffrey A. Killian,

Petitioner

v.

Kathi Vidal, Director of the United States Patent and Trademark Office,

Respondent

On Petition for Writ of Certiorari from the United States Court of Appeals for the Federal Circuit

SUPPLEMENTAL BRIEF FOR PETITIONER

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NEW QUESTIONS PRESENTED

Does the Supreme Court's holding of *Amgen v. Sanofi*, 598 U.S. ____ (2023) demonstrate that Article III courts have erroneously conflated patent eligibility under Title 35 U.S.C. § 101 with the enablement requirement of Title 35 U.S.C. § 112(a) given that every exception to patent eligibility created by the courts relies on *O'Reilly v. Morse*, 15 How 62 (1853), which *Amgen* describes as relating to enablement?

Does the Supreme Court's holding of *Amgen v. Sanofi* demonstrate Petitioner Killian's assertion that the exceptions created by Article III courts of Title 35 U.S.C. § 101 exceed the constitutional authority of the courts?

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I. Introduction

This Court's decision of *Amgen v. Sanofi*, 598 U.S. ____, slip op. at p. 15 (2023) makes clear that Article III courts have no authority to add or subtract from the requirements of Title 35 of the United States Code. Yet, without question the exceptions to patent eligibility created by the Article III courts do exactly that starting with *Gottshalk v. Benson*, 409 U.S. 63 (1972).

This Court's *Amgen* decision also makes clear that the authority relied upon by Article III courts has been erroneously miscited and that cases such as *O'Reilly v. Morse*, 15 How 62 (1853) are directed to the enablement requirement of Title 35 U.S.C. § 112(a) rather than patent eligibility under Title 35 U.S.C. § 101.

Last, because of this conflation of § 112(a) and § 101, Article III courts have turned issues of fact into issues of law whereby judges routinely ignore evidence and any inconvenient scientific principle to come to conclusions having no basis in truth.

II. Argument

A. The Supreme Court's *Amgen v. Sanofi* Decision Confirms That the Exceptions to Patent Eligibility under Title 35 U.S.C. § 101 Cannot Be Maintained

1. There Are No Constitutional or Statutory Grounds for the Judicial Exceptions to § 101

This Court's decision of *Amgen v. Sanofi*, 598 U.S. slip op. at p. 15 (2023) stated "Judges may no more subtract from the requirements for obtaining a patent that Congress has prescribed than they may add to them. See *Bilski v. Kappos,* 561 U.S. 593, 602–603, 612 (2010)." Thus, *Amgen* acknowledges a lack of constitutional authority of the courts to rewrite Title 35 of the United States Code (hereinafter "the Patent Law") from the bench. Despite such authority, the exceptions to patent eligibility created by the courts, including that in *Bilski*, represent the courts subtracting from the breadth of patent eligibility stated in § 101 while adding the additional requirement of "inventive concept."

There is no language in § 101 that allows for judicial exceptions and no court has ever identified such language. Petitioner also reminds this Court that invention / inventive concept / flash of creative genius is a standard Congress removed from the Patent Law in the 1952 Patent Act in favor of the

objective non-obviousness standard of Title 35 U.S.C. § 103.[1]

2. Setting Aside the Judicial Exceptions to § 101 Involves No Statutory Stare Decisis

Because there is no language in § 101 to justify the various judicial exceptions to § 101 there can be no statutory *stare decisis*. While this Court's holding of *Kimble v. Marvel Entertainment, LLC*, 576 U.S. 446, 456-57 (2015) states that "stare decisis carries enhanced force when a decision . . . interprets a statute while (as with *Amgen*) citing *Bilski*, the *Bilski* decision (as with every other decision on patent eligibility by this Court) identifies no statutory language that supports creating exceptions to patent eligibility. Indeed, the only text of *Bilski* that speaks to *stare decisis* fails to recite a single word of § 101 while stating that "these exceptions have defined the reach of the statute as a matter of statutory *stare decisis* going back 150 years. See *Le Roy v. Tatham*, 14 How. 156, 174–175, 14 L.Ed. 367 (1853)." *Bilski*, 561 U.S. at 602.

Petitioner observes that the entire "abstract idea" concept originated in *Le Roy* v. *Tatham*, 14 How. 156,

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[1] See, Rich, Giles S., The Vague Concept of "Invention" as Replaced by Section 103 of the 1952 Patent Act (1964) (Reprinted with permission in *Nonobviousness – The Ultimate Condition of Patentability* (1978) at pp. 1:401-416) .

174–175 (1853) ("A principle, in the abstract, is a fundamental truth; an original cause; a motive; these cannot be patented, as no one can claim in either of them an exclusive right.") and not by any text in § 101. The failure of the courts to consider the Patent Law as expressly written by Congress while conflating pre-1952 case law with the text of § 101 has led to confusion and uncertainty. This Court cannot now wash its hands of a problem it created simply by calling a judicial doctrine "legislative". See, e.g., *Exxon Shipping Co. v. Baker,* 554 U. S. 471, 507 (2008).

B. *Amgen v. Sanofi* Confirms That Patent Eligibility under Title 35 U.S.C. § 101 Has Been Conflated with, *inter alia*, the Enablement Requirement of Title 35 U.S.C. § 112(a)

On pages 33 et seq. of Killian's Petition, Petitioner stated that Article III courts lacked constitutional authority to rewrite the Patent Law from the bench yet "the courts nonetheless created an ever-growing number of exceptions to patent eligibility including scientific principles, naturally occurring phenomena, mathematical algorithms, computer-based devices, and (most recently) computer networks that comprehend data and have opinions." Petitioner further explained that this Court ignored Title 35 U.S.C. §§ 102/103/112, which Congress expressly

designed to handle the issues Article III courts have tried to fit in under § 101.

As a specific example, on page 36 of the instant Petition, Killian stated the courts conflated patent eligibility under § 101 and § 112(a) stating "the eighth claim of *O'Reilly v. Morse*, 15 How 62 (1853) was not rejected because the claim involved a law of nature, but because the eighth claim failed to comply with what would be later codified as Title 35 U.S.C. § 112(a) of the Patent Law." Petitioner then quoted Morse stating:

> "In fine, [Morse's] claims an exclusive right to use a manner and process which he has not described and indeed had not invented, and therefore could not describe when he obtained his patent. The court is of opinion that the claim is too broad, and not warranted by law." *Id.* at p. 113.

Fast forwarding to the recent *Amgen* decision, *Amgen* is an in-depth recognition that the underlying policy issue of excessive preemption was long relegated to the eligibility requirement of § 112(a). *Amgen*, 598 U.S. at slip-op p. 10. Rather than relegate overly broad claiming of an "abstract idea" to patent eligibility, this Court tackled the issue in *Amgen* under § 112(a) enablement (as Congress intended) while recognizing that *Morse* stood for the proposition that "the Court held that one of the

claims in Morse's patent for a telegraphic system was 'too broad, and not warranted by law' and '[t]he problem was that the claim covered all means of achieving telegraphic communication, yet Morse's specification did not describe how to make or use them all.'" *Id.*

The Court's recent description of *Morse* is inconsistent with every single holding on patent eligibility under § 101 where patent eligibility was conflated with the enablement requirement § 112(a) starting with *Gottschalk v. Benson* and ending with *Mayo v. Prometheus*. where this Court stated:

> "Our conclusion rests upon an examination of the particular claims before us in light of the Court's precedents. Those cases warn us against interpreting patent statutes in ways that make patent eligibility 'depend simply on the draftsman's art' without reference to the 'principles underlying the prohibition against patents for [natural laws].' *Flook*, *supra*, at 593. ***They warn us against upholding patents that claim processes that too broadly preempt the use of a natural law***. *Morse*, *supra*, at 112-120; *Benson*, *supra*, at 71-72." (emphasis added) *Mayo*, 566 U.S. at p 72.

Benson and *Flook*[2] (cited by *Bilski*) were wrongly decided as: (1) the mathematical algorithms in those

[2] *Parker v. Flook*, 438 U.S. 584 (1978)

cases were not reflections of any natural law, and (2) excessive preemption is addressed in the enablement requirement of § 112(a). *Flook* is especially onerous in that the admittedly novel mathematical formula used in *Flook* is necessarily limited to producing alarm limits related to processes for "the catalytic chemical conversion of hydrocarbons." *Flook*, 438 U.S. at 585.

There is no better authority for recognizing that the various exceptions to patent eligibility created by the courts are improper than this Court's recent *Amgen* decision. This Court cannot stand by the *Amgen* decision and stand by its patent eligibility decisions of the past fifty-one years.

C. Federal Circuit Opinions Confirm That *Morse* Was Miscited by the Courts

The Federal Circuit majority in *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC, et al.*, Appeal No.2018-1763, slip-op at p. 15 (2021) cited *Morse* for the following prospect:

> "Claiming a result that involves application of a natural law without limiting the claim to particular methods of achieving the result runs headlong into the very problem repeatedly identified by the Supreme Court in its cases shaping eligibility analysis. See . . . O'R*eilly v. Morse*, 56 U.S. (15 How.) 62, 112–17, 14 L.Ed. 601 (1853)."

The "natural law" that the majority cited however, is Hooke's Law, which relates to the force needed to extend or compress a spring by some distance based on the stiffness of the spring. The claims of *American Axle*, however, have nothing to do with Hooke's law. Even if Hooke's Law were remotely involved in *American Axle*, the majority's holding that the claims at issue preempt Hooke's Law is ludicrous as there exists an infinite number of applications that the claims in *American Axle* do not embrace from retractable ball point pens to guitar strings to the bow and arrow to the reclining chair found in nearly every government office in the United States. *American Axle* is unquestionably wrong to anyone with a rudimentary knowledge of physics.

Judge Moore's dissent is telling. Her discussion of the constitutional violations and total lack of technical knowledge by the majority is well stated as follows:

> "The majority instead holds that we appellate judges, based on our background and experience, will resolve questions of science *de novo* on appeal. . . . ***The majority reaches this conclusion despite all of the briefing and record evidence contradicting it***. Second, the majority refuses to consider the unconventional claim elements. Third, ***the majority has imbued § 101 with a new superpower—enablement on steroids***. ***The***

> ***majority's blended 101/112 analysis expands § 101, converts factual issues into legal ones and is certain to cause confusion for future cases***.
>
> Although some degree of trial and error in modifying the mass, stiffness, and location of the liner to optimize the reduction in vibration of a given shaft could (if undue) create an enablement concern, that is not a § 101 problem. American Axle (AAM) and the many *amici* believe each of these errors of law are likely to create confusion for the district courts and to expand § 101 profoundly" (emphasis added). *American Axle*, dissent slip-op at p. 2.

In sum, Judge Moore acknowledged that judges are more than willing to act on their oblivious misconceptions of technology while going to great lengths to ignore evidence to the contrary. This problem is common to *In re Killian* where the Federal Circuit expanded patent eligibility to a conclusion based on science fantasy about generic computer networks comprehending data – all while refusing to consider fifty-five documents contradicting the holding of the Patent Trial and Appeal Board ("PTAB") which the PTAB refused to consider in violation of constitutional due process and the Administrative Procedure Act.

Judge Moore is correct. The Federal Circuit has morphed *Alice/Mayo* into a capricious test in defiance

of evidence in a manner that conflates § 101 and § 112(a) and that converts factual issues into legal ones.

It is long held that the enablement issue of § 112(a) has factual underpinnings. This Court has expressly held that enablement is "a question of fact to be determined by the jury." *Wood v. Underhill*, 46 U.S. (5 How.) 1, 4 (1846) ; *Battin v. Taggert*, 58 U.S. (17 How.) 74, 85 (1854); *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 428 (1822). The Federal Circuit has similarly held that the enablement issue of § 112(a) has factual underpinnings. See, *In re Wands*, 858 F.2d. 731, 737 (Fed. Cir. 1988) ("Whether undue experimentation is needed . . . is a conclusion reached by weighing many factual considerations").

Turning to the most recent *Alice/Mayo* decision by the Federal Circuit of *Realtime Data LLC v. Array Networks Inc.*, Appeal No. 2021-2251 (Fed.Cir. Aug. 2, 2023), Judge Newman's dissent is telling in the very first sentence where she states, "This is properly an enablement case." *Id.* dissent slip-op at p. 1.

Judge Newman continues, "This case is an example, for the enablement requirement of § 112 is better suited to determining validity of these claims than is the distortion of § 101." *Id.* "More than a decade after the Supreme Court waded into patent eligibility law, uncertainty remains about what areas of innovation are eligible for patent protection. Critical technologies like medical diagnostics and

artificial intelligence can be protected with patents in Europe and China, but not in the United States." *Id.* "Unfortunately, our current Supreme Court's patent eligibility jurisprudence is undermining American innovation and allowing foreign adversaries like China to overtake us in key technology innovations" *Id.*

D. The *Amgen* Decision Further Weakens the Case for *Stare Decisis* for All Past Holdings for Exceptions to Patent Eligibility

This Court held in *Dobbs v. Jackson Women's Health Organization*, 142 S. Ct. 2228, 2265 (2022) that "[u]nder our precedents, the quality of the reasoning in a prior case has an important bearing on whether it should be reconsidered." The holding of *Amgen* further proves that the quality of reasoning used to justify the exceptions to patent eligibility is poor.

In pages 33 *et seq.* of Killian's Petition, Killian correctly asserted that there is a complete lack of constitutional authority for creating exceptions to patent eligibility, which the Federal Circuit and Respondent do not contest, and which *Amgen* confirms. Killian also correctly argued that the requirement of "inventive concept" contravenes congressional intent, which the Federal Circuit and Respondent do not contest.

Now the intellectual underpinnings of patent exceptions based on *O'Reilly v. Morse* are shown to be flawed given that the holding of *Amgen* recognizes that *Morse* relates to enablement and not patent eligibility. Thus, the quality of every judicial decision creating an exception to patent eligibility to date is extraordinarily poor both from a constitutional perspective and from the idea that every single issue addressed under patent eligibility could have and should have been addressed under the statutory framework Congress created.

III. *Killian v. Vidal* Represents an Ideal Opportunity

Despite the claims of many petitioners, there is no ideal patent case with perfect claims ready for review by this Court. The difference in the instant Petition is that the absurdities and confusion of the lower courts are made readily apparent at a time when this Court reveals that the intellectual underpinnings of *Alice/Mayo* are flawed and after the Solicitors of the Department of Justice (DOJ) and United States Patent Office (USPTO) have twice admitted that *Alice/Mayo* needs clarification.

This Court should take note of the Solicitors' suggestions in their *American Axle* amicus where the Solicitors sought to discourage deciding issues of evidence before clarification is provided despite the

fact that it is the absence of evidence in the lower courts' *Alice/Mayo* opinions that have defied clarification. This Court should also recognize that the Solicitors' amicus commonly filed for both the *Interactive Wearables* (21-1281 (2021)) and *Tropp* (21-1908, 21-1909 (2021)) is an example of capricious advocacy that depends on specious statements. For example, on page 19 of the *Interactive Wearables* / *Tropp* amicus, the Solicitors state:

> "The court further held that *Tropp* had failed to preserve any argument that the lock referenced in his method claim represents 'a concrete technical advance over earlier dual-access locks.' *Ibid*. Unlike the district court in *Interactive*, however, the court of appeals in *Tropp* did not thereby confuse novelty with patent-eligible subject matter."

As an initial issue, based on the language above, the Solicitors believe that the Federal Circuit conflated patent eligibility under § 101 with the evidence-intensive issue of novelty under § 102 in *Interactive wearables*. The same is true with *Killian* although the Solicitors have declined comment.

As a second initial issue, the *Tropp* claims aren't directed to an improved lock, and the USPTO necessarily found Tropp's method claims novel when issuing Tropp's patent. Why then the demand for novelty for a single component of Tropp's patent

claims? The *Diamond v, Diehr* holding did not rely on a novel computer or a novel rubber mold. To the contrary, the *Diehr* decision was based on the use of an admittedly well-known law of nature (see *Diehr*, 450 U.S. at 177, fn 2) directed to the curing of rubber that has been known since 1889 incorporated into a generic computer that controlled a generic rubber mold. In contrast, the majority in *Flook* stated that the claims in *Flook* relied on an algorithm that this Court believed to be novel (see *Flook*, 438 U.S. at 585) in a decision that relied on the erroneous *Morse* interpretation that *Amgen* recently corrected.

Without question the judicial exceptions to patent eligibility are based on contradictions, fundamental misunderstandings of the laws of nature, a refusal to consider evidence, erroneous readings of past case law, and a refusal to address the whole statutory framework of the Patent Law as Congress intended. The claims of *American Axle* were held patent ineligible because the claims somehow preempt a law of physics totally unrelated to the claims. Petitioner Killian's claims were held patent ineligible under three separate incompatible theories by the Examiner, the PTAB, and the Federal Circuit with the Federal Circuit convinced that Killian's claims somehow preempt science fantasy. Whether or not Killian's claims are ideal for review, the present circumstances are ideal as it is abundantly clear that any fact-based decision contrived in an evidentiary

vacuum is not only a violation of due process of law, but an exercise in capriciousness that is rarely, if ever, correct.

IV. Conclusion

Because the exceptions to patent eligibility involve constitutional issues as opposed to issues of statutory interpretation, the case for *stare decisis* is at its weakest. *Dobbs*, 142 U.S. at 2262. Because this Court places a high value on having constitutional issues "settled right," this Court should now reconsider and set aside the destructive and unconstitutional exceptions to patent eligibility created by the courts.

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