

No. 23-498

IN THE
Supreme Court of the United States

REALTIME DATA LLC, DBA IXO,

Petitioner,

v.

FORTINET, INC., *et al.*,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF *AMICI CURIAE* ALAN J. HEINRICH
AND CHRISTOPHER T. ABERNETHY IN SUPPORT
OF REALTIME DATA LLC'S PETITION
FOR A WRIT OF CERTIORARI**

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BRIEF OF *AMICI CURIAE*

INTEREST OF *AMICI*¹

Amici curiae Alan J. Heinrich and Christopher T. Abernethy are patent litigation practitioners with an interest in improving the state of the law and who have published on issues relevant to the petition. In addition to their litigation practices, Mr. Heinrich is currently a lecturer at the University of California, Los Angeles School of Law, and Mr. Abernethy has lectured at the Loyola Law School of Los Angeles. Beyond their interest in helping to improve the law, *amici* have no stake in the above-captioned litigation.

SUMMARY OF ARGUMENT

The present case is emblematic of how existing jurisprudence has led to confusion and improper conflation of the patent-eligible subject matter (§ 101) and enablement (§ 112) requirements in lower courts. As Judge Newman explained in her dissent below, this case “is properly an enablement case,” and “the enablement requirement of § 112 is better suited to determining validity of these claims than is the distortion of § 101.” *Realtime Data LLC v. Array*

¹ Pursuant to Sup. Ct. R. 37.6, *Amici* certify that no counsel for any party authored this brief, in whole or in part, and that no entity or other person other than *amici* and their counsel made any monetary contribution toward the preparation or submission of this brief. *Amici* further certify that, pursuant to Sup. Ct. R. 37.2, the counsel of record for all parties have received timely notice of this brief.

Networks Inc., 2023 WL 4924814, at *12 (Fed. Cir. Aug. 2, 2023) (Newman, J., dissenting).

Amici agree and write here to highlight that the time is ripe to address this issue given this Court’s decision in *Amgen, Inc. v. Sanofi*, 598 U.S. 594 (2023), which accurately described the holding in *O’Reilly v. Morse*, 56 U.S. (15 How.) 62 (1853), as being a ruling about the doctrine of enablement. Prior to this, *Morse* had unfortunately been incorrectly cited for over 140 years as a core foundation for the judicially created “exception[s]” to Section 101 that exclude “[l]aws of nature, physical phenomena, and abstract ideas” from patentability. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (citing *Morse*, 15 How. 62, 112-20).

In *Amgen* (2023), this Court described and applied *Morse* (1853) as a landmark case that “addressed the enablement requirement.” *Amgen*, 598 U.S. at 605. *Amici* made the same observation in Alan J. Heinrich & Christopher T. Abernethy, *The Myriad Reasons to Hit “Reset” on Patent-Eligibility Jurisprudence*, 47 Loy. L.A. L. Rev. 117 (2013) [hereinafter “Heinrich & Abernethy”]. *Amici* posited that the judicially created “exceptions” to Section 101 came into being largely due to an unfortunate misinterpretation of *Morse*, first misinterpreted in *dicta* in *Tilghman v. Proctor*, 102 U.S. 707 (1881), which was then cited repeatedly for more than 140 years as a purported foundational basis for the judicial “exceptions” to Section 101. See Heinrich & Abernethy, 47 Loy. L.A. L. Rev. at 133-70, 186-91.

The Court thus has sharply divergent lines of authority—Section 101 jurisprudence that incorrectly relies upon *Morse* as a patent eligibility case, and Section 112 jurisprudence that correctly relies upon

Morse as having applied the doctrine of enablement. Given this Court’s recent recognition in *Amgen* that *Morse* was in fact about the doctrine of enablement, *amici* encourage the Court to take the present case as an opportunity to reexamine the legal underpinnings of the judicially created “exceptions” to Section 101.

ARGUMENT

I. *Morse* (1853) Addressed The Enablement Doctrine, Not Patent Eligibility, Which This Court Recognized In *Amgen* (2023)

In *O’Reilly v. Morse*, 56 U.S. (15 How.) 62 (1853), the Court considered a patent directed to Samuel Morse’s famed electromagnetic telegraph. The Court found that Morse was the first and true inventor of the telegraph (*id.* at 109), and it discerned no flaws in the first seven claims of Morse’s patent, all of which claimed the telegraph device and its use. *Id.* at 112. However, the Court took exception to Claim Eight, which read as follows:

Eighth. I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being *the use of the motive power of the electric or galvanic current, which I call electromagnetism, however developed for making or printing intelligible characters, signs, or letters, at any distances*, being a new application of that power which I claim to be the first inventor or discoverer.

Id. (emphasis added).

The Court found that Claim Eight captured far more than Morse was entitled to claim. *Id.* at 112-20. The issue was not *what* Claim Eight sought to claim, but rather the claim's *scope* relative to the description in Morse's specification. As the Court explained:

It is impossible to misunderstand the *extent* of this claim. He claims the exclusive right to *every* improvement where the motive power is the electric or galvanic current, and the result is the making or printing intelligible characters, signs, or letters at a distance.

....

In fine he claims an exclusive right to use a manner and process *which he has not described* and indeed has not invented, and therefore *could not describe* when he obtained his patent. The court is of the opinion that the claim is *too broad*, and not warranted by law.

Id. at 112-13 (emphasis added).

This court has decided, that the *specification* required by this law is a part of the patent; and that the patent issues for the invention *described in the specification*.

....

The *specification* of this patentee *describes* his invention or discovery, and the manner and process of constructing and using it; and *his patent*, like inventions in the other arts above mentioned, *covers nothing more*.

Id. at 118-19 (emphasis added).

The act of Congress above recited, requires that the invention *shall be so described, that a person skilled in the science to which it appertains, or with which it is most nearly connected, shall be able to construct the improvement from the description given by the inventor.*

Now, in this case, *there is no description but one*, of a process by which signs or letters may be printed at a distance. And yet he claims the exclusive right to *any* other mode and *any* other process, *although not described by him*, by which the end can be accomplished, if electro-magnetism is used as the motive power. That is to say—he claims a patent, for an effect produced by the use of electro-magnetism distinct from the process or machinery necessary to produce it. The words of the acts of Congress above quoted show that no patent can lawfully issue upon such a claim. *For he claims what he has not described in the manner required by law.*

Id. at 120 (emphasis added).

The *Morse* Court’s reasoning was thus based on what has come to be called the full-scope enablement doctrine. As *amici* observed in their 2013 paper:

It thus appears that the Supreme Court rested its holding in *Morse* on enablement grounds, not on any finding regarding patent-eligible subject matter. We view *Morse* as an early application of the principle that, “[t]o be enabling, the specification of a patent must teach those skilled in the art

how to make and use the *full scope* of the claimed invention without ‘undue experimentation.’” *MagSil Corp. v. Hitachi Global Storage Techs., Inc.*, 687 F.3d 1377, 1380-81 (Fed. Cir. 2012) (emphasis added). The “full scope” enablement doctrine requires a patent’s disclosure to be “commensurate with the scope of the claims,” thereby preventing “overbroad claiming that might otherwise attempt to cover more than was actually invented.” *Id.* In *Morse*, although the patent specification enabled a species of invention (i.e., the telegraph), it failed to enable the full scope of a claim that recited a genus (i.e., the use of electromagnetism, by any means, to print characters at a distance).

Heinrich & Abernethy, 47 Loy. L.A. L. Rev. at 135-36 (additional citations omitted).

Consistent with *amici’s* foregoing understanding, this Court arrived at the same conclusion regarding *Morse* in the Court’s recent enablement decision in *Amgen, Inc. v. Sanofi*, 598 U.S. 594 (2023). In that case, the Court considered a patent which claimed “the entire genus” of antibodies that help reduce LDL cholesterol (aka, “bad cholesterol”). *Id.* at 598, 602. In addressing the full-scope enablement requirement, the Court examined *Morse* and described it as follows:

This Court has addressed the enablement requirement on many prior occasions. While the technologies in these older cases may seem a world away from the antibody

treatments of today, the decisions are no less instructive for it.

Begin with *Morse*. . . .

....

Morse's patent included eight claims, and this Court had no trouble upholding seven of them—those limited to the telegraphic structures and systems he had designed. But the Court paused on the eighth. . . .

The Court held the eighth claim “too broad, and not warranted by law.” The problem was that it covered *all* means of achieving telegraphic communication, yet Morse had not described how to make and use them all.

Id. at 605-07 (citations omitted).

Our decisions in *Morse* [and similar cases] reinforce the simple statutory command. If a patent claims an entire class of processes, machines, manufactures, or compositions of matter, the patent's specification must enable a person skilled in the art to make and use the entire class. In other words, the specification must enable the full scope of the invention as defined by its claims.

Id. at 610 (citations omitted).

The Court then went on to expressly apply *Morse* in assessing Amgen's antibody genus claim. “Much as Morse sought to claim all telegraphic forms of communication,” the Court explained, “Amgen seeks to claim ‘sovereignty over [an] entire kingdom’ of antibodies.” *Id.* at 613 (citation omitted). And like in

Morse, Amgen’s genus claim did “not include just the 26 [antibodies] that Amgen has described by their amino acid sequences, but a ‘vast’ number of additional antibodies that it has not.” *Id.* The Court thus found Amgen’s claim invalid, as the specification did not enable the full scope of the claim. *Id.* at 614.

Accordingly, and as this Court now clearly agrees, *Morse* was a case about the doctrine of enablement.

II. The Judicial “Exceptions” To Section 101 Arose Largely From *Dicta* Misinterpreting *Morse* (1853), Cited Repeatedly Since 1881

Despite that the landmark *Morse* (1853) decision concerned the enablement doctrine (*see* Part I, *supra*), it somehow grew to become synonymous with patent eligibility jurisprudence for more than a century. As *amici* explained in their 2013 paper, this largely stemmed from an early misinterpretation of *Morse*, made in *dicta* in the case of *Tilghman v. Proctor*, 102 U.S. 707 (1881), which was then cited repeatedly for over 140 years as a basis for the judicial “exceptions” to Section 101. *See* Heinrich & Abernethy, 47 Loy. L.A. L. Rev. at 186-91; *see also id.* at 133-70.

In *Tilghman v. Proctor*, Tilghman had discovered that fat can be separated into its component parts (fat acids and glycerine) through the “process of subjecting the neutral fat, whilst in intimate mixture with water, to a high degree of heat under sufficient pressure to prevent the water from being converted into steam.” *Id.* at 712. Tilghman’s patent claimed the foregoing process, irrespective of the machinery used to carry it out. *Id.* at 709-10, 715. The Court found the

claim was *valid* as directed to *patent-eligible* subject matter, stating

That a patent can be granted for a process, there can be no doubt. The patent law is not confined to new machines and new compositions of matter, but extends to any new and useful art or manufacture. A manufacturing process is clearly an art, within the meaning of the law.

Id. at 722.

Had the Court stopped there, *Tilghman* would have been an unremarkable case. However, the Court went on to provide *dicta* distinguishing *Morse*—the enablement case 28 years prior—by interpreting the holding of *Morse* in a broad and incorrect manner:

The eighth claim of Morse’s patent was held to be invalid, *because it was regarded by the court as being not for a process, but for a mere principle*. It amounted to this, namely, a claim to the exclusive right to the use of electromagnetism as a motive power for making intelligible marks at a distance; *that is, a claim to the exclusive use of one of the powers of nature for a particular purpose*.

Id. at 726 (emphasis added). In contrast, the Court explained distinguishing the case at hand, *Tilghman* claimed a “*process* of ‘manufacturing fat acids and glycerine from fatty bodies by the action of water at a high temperature and pressure.’” *Id.* at 721. This was a claim for a patent-eligible “process” and “not for a mere principle,” the Court reasoned, because it “does

not claim every mode of accomplishing [the] result” of separating fat into its component parts. *Id.* at 729.

The foregoing holding was a key turning point in the history of patent eligibility jurisprudence. The core error of *Tilghman* was the Court’s interpretation of *Morse* as having invalidated a claim due to the *type* of subject matter claimed, rather than because the claim’s *scope* was not supported by a sufficiently enabling disclosure. This led the Court to draw a vague distinction between claiming an unpatentable “principle” and claiming a patent-eligible “process.”

To be sure, the *Tilghman* Court could have instead distinguished *Morse* on enablement grounds. The Court analyzed the specification of Tilghman’s patent and concluded it had a sufficiently enabling disclosure to support Tilghman’s process claim. *Id.* at 718-22. Although the process claim was not limited to the use of specific machinery, the Court found that the particular apparatus used “was not material” to the invention, as the specification disclosed that the process could be implemented using means of heating water under pressure that were already well known. *Id.* at 718, 722. This is in contrast to *Morse*, where the patent disclosed a new apparatus (the telegraph), yet claimed any means of using electromagnetism to print characters at a distance. *Morse*, 56 U.S. at 112. Morse had “not discovered, that the electric or galvanic current will *always* print [characters] at a distance.” *Id.* at 117 (emphasis added).

Tilghman, on the other hand, *had* discovered—and disclosed in his patent—that fat *always* separates into its component parts when “subjecting the neutral fat, whilst in intimate mixture with water, to a high

degree of heat under sufficient pressure to prevent the water from being converted into steam.” *Tilghman*, 102 U.S. at 712. Thus, unlike the claim at issue in *Morse*, the “full scope” of *Tilghman*’s process claim was enabled by the patent’s specification. Nonetheless, rather than focusing on these core differences in disclosure and claim scope, the *Tilghman* Court chose to distinguish *Morse* by attributing to that case a sweeping, vaguely defined, *per se* patent-eligibility exclusion of any claim directed to a “mere principle.” *Id.* at 726-27.

Fast forward nearly a century, and *Tilghman*’s *dicta* misinterpreting *Morse* began to gain legs, being repeatedly cited in nearly every one of the Court’s patent eligibility decisions as a foundational basis for the judicially created “exceptions” to Section 101. A brief overview of a number of relevant cases follows:

In *Gottschalk v. Benson*, 409 U.S. 63 (1972), the Court discussed the 1881 holding in *Tilghman*, and it described *Morse* in the same incorrect manner. *Id.* at 68-70 (“The effect of that decision was, therefore, that the use of magnetism as a motive power, without regard to the particular process with which it was connected in the patent, could not be claimed, but that its use in that connection could.”) (citation omitted). From that description, the Court then concluded:

It is conceded that *one may not patent an idea*. But in practical effect that would be the result if the [claimed] formula for converting BCD numerals to pure binary numerals were patented in this case. The mathematical formula involved here has no substantial practical application except in connection

with a digital computer, which means that if the judgment below is affirmed, *the patent would wholly preempt the mathematical formula and in practical effect would be a patent on the algorithm itself.*

Id. at 71-72 (emphasis added).

In *Parker v. Flook*, 437 U.S. 584 (1978), the Court then built upon *Benson* and *Morse* to articulate the judicially created exceptions to Section 101, stating: “It is a commonplace that *laws of nature, physical phenomena, and abstract ideas* are not patentable subject matter.” *Id.* at 598 (emphasis added). The Court explained those prior cases as follows:

The process itself, not merely the mathematical algorithm, must be new and useful. Indeed, the novelty of the mathematical algorithm is not a determining factor at all. Whether the algorithm was in fact known or unknown at the time of the claimed invention, as one of “the basic tools of scientific and technological work,” see *Gottschalk v. Benson*, 409 U.S., at 67, 93 S. Ct., at 255, *it is treated as though it were a familiar part of the art.*

This is also the teaching of our landmark decision in *O’Reilly v. Morse*, 15. How 62. In that case the Court rejected Samuel Morse’s broad claim covering any use of electromagnetism for printing intelligible signs, characters, or letters at a distance. *Id.*, at 112-121. . . .

We think that this case must also be considered as if the principle or mathematical formula were well known.

....

Even though a phenomenon of nature or mathematical formula may be well known, an inventive application of the principle may be patented. Conversely, *the discovery of such a phenomenon cannot support a patent unless there is some other inventive concept in its application.*

Id. at 591-94 (emphasis added).

In *Diamond v. Chakrabarty*, 447 U.S. 303 (1980), the Court relied upon *Morse*, *Flook*, and *Benson*, among other cases, for what was now considered settled law: “*The laws of nature, physical phenomena, and abstract ideas have been held not patentable.*” *Id.* at 309 (citing *Morse*, 15 How. 62, 112-21; *Flook*, 437 U.S. 584; *Benson*, 409 U.S. 63, 67) (emphasis added) (additional citations omitted).

In *Diamond v. Diehr*, 450 U.S. 175 (1981), the Court again did the same, stating: “It is now commonplace that an *application* of a law of nature or mathematical formula to a known structure or process may well be deserving of patent protection.” *Id.* at 187-88 (citing *Morse*, 15 How. 62) (emphasis added) (additional citations omitted). The Court further discussed *Flook*, *Benson*, and *Morse*, stating: “In *Flook*, this Court clarified *Benson* Under this procedure, the algorithm is treated for § 101 purposes as though it were a familiar part of the prior art; the claim is then examined to determine whether it discloses ‘some other inventive concept.’” “This form

of claim analysis did not originate with *Flook*. Rather, the Court derived it from the landmark decision *O'Reilly v. Morse*, 15 How. 62, 115.” *Id.* at 204 & n.22.

In *Bilski v. Kappos*, 561 U.S. 593 (2010), the Court similarly cited *Morse*, *Benson*, and *Diehr*, stating: “The Court has kept [the] ‘*constitutional standard*’ in mind when deciding what is patentable subject matter under § 101. For example, we have held that no one can patent ‘*laws of nature, natural phenomena, and abstract ideas.*’” *Id.* at 649 (citing *Morse*, 15 How. at 113; *Diehr*, 450 U.S. at 185; *Benson*, 409 U.S. at 67) (emphasis added). The Court further explained that, “[w]hile these exceptions *are not required by the statutory text*, . . . these exceptions have defined the reach of the statute as a matter of statutory *stare decisis* going back 150 years.” *Id.* at 601-02 (emphasis added). “The Court, therefore, need not define further what constitutes a patentable ‘process,’ beyond pointing to the definition of that term provided in § 100(b) and looking to the guideposts in *Benson*, *Flook*, and *Diehr*.” *Id.* at 612.

In *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012), the Court relied upon *Morse*, *Benson*, *Bilski*, and *Flook* as broadly defining the current state patent-eligible subject matter jurisprudence, stating:

The Court has repeatedly emphasized this last mentioned concern, *a concern that patent law not inhibit further discovery by improperly tying up the future use of laws of nature*. Thus, in *Morse* the Court set aside as unpatentable Samuel Morse’s general claim for “the use of the motive power of the electric

or galvanic current . . . however developed, for making or printing intelligible characters, letters, or signs, at any distances.” . . .

Similarly, in *Benson* the Court said that the claims before it were “so abstract and sweeping as to cover both known and unknown uses of the [mathematical formula]. In *Bilski* the Court pointed out that to allow “petitioners to patent risk hedging would pre-empt use of this approach in all fields.” And in *Flook* the Court expressed concern that the claimed process was simply “a formula for computing an updated alarm limit,” which might “cover a broad range of potential uses.”

These statements reflect the fact that, *even though rewarding with patents those who discover new laws of nature and the like might well encourage their discovery, those laws and principles, considered generally, are “the basic tools of scientific and technological work.”* *Benson, supra*, at 67. And so there is a danger that the grant of patents that *tie up their use will inhibit the future innovation* premised upon them, a danger that becomes acute when a patented process amounts to no more than an instruction to “apply the natural law,” or otherwise *forecloses more future invention than the underlying discovery could reasonably justify*.

Id. at 85-86 (emphasis added) (citations omitted).

Finally, with the Court’s latest patent eligibility decision in *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014), the Court again reaffirmed the state of patent-eligibility jurisprudence based upon *Morse*, stating: “Section 101 of the Patent Act defines the subject matter eligible for patent protection. . . . ‘We have long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable.’ We have interpreted § 101 and its predecessors in light of this exception for more than 150 years.” *Id.* at 216 (citing *Morse*, 15 How. 62, 112-20; *Bilski*, 561 U.S. at 601-02) (additional citations omitted). “We have ‘repeatedly emphasized this . . . concern that patent law not inhibit further discovery by improperly tying up the future use of these building blocks of human ingenuity.’” *Id.* (quoting *Mayo*, 566 U.S. at 85 (citing *Morse*, 15 How. at 113)).

The foregoing decisions all stand in stark contrast to this Court’s 2023 decision in *Amgen*, in which this Court correctly described and then applied *Morse* as a landmark decision that “addressed the enablement requirement.” *Amgen*, 598 U.S. at 605. The Court thus has sharply divergent lines of authority—Section 101 jurisprudence that incorrectly relies upon *Morse* as a patent eligibility case, and Section 112 jurisprudence that correctly relies upon *Morse* as having applied the doctrine of enablement. Given this Court’s recent recognition in *Amgen* that *Morse* was in fact about the doctrine of enablement, *amici* encourage the Court to take the present case as an opportunity to reexamine the legal underpinnings of the judicially created “exceptions” to Section 101.

III. The Judicial “Exceptions” To Section 101 Contradict the Text and Original Intent of the U.S. Constitution and the Patent Act, Which Envision Patents on “Discoveries”

Amici submit that the judicial exceptions to Section 101 are contrary to the text and original intent of the U.S. Constitution and the Patent Act. The Intellectual Property Clause of U.S. Constitution provides for patent protection not just for “*Inventors*,” but more broadly for their “*Discoveries*.”² Section 101 of the Patent Act also states that “[w]hoever *invents or discovers* any new and useful process, machine, manufacture, or composition of matter” may obtain a patent, provided all the other requirements (including Section 112 enablement) are met. 35 U.S.C. § 101; *see also, e.g.*, Megan Thobe, *A Call to Action: Fixing the Judicially-Murkied Waters of 35 U.S.C. § 101*, 50 Ind. L. Rev. 1023, 1029 (2017) (“The term ‘invention’ in § 100(a) now ‘means invention or discovery.’”); *id.* at 1044-48 (examining Heinrich & Abernethy).

The express Constitutional and statutory offering of patent protection for *discoveries* conflicts with the vague judicial exclusion of anything that might subjectively be described as the *discovery* of a law of nature, physical phenomenon, or abstract idea. *See, e.g., Funk Bros. Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948) (“He who *discovers* a hitherto unknown *phenomenon of nature* has no claim to a

² U.S. CONST. art. I, § 8, cl. 8 (“To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and *Inventors* the exclusive Right to their respective Writings and *Discoveries*.”) (emphasis added).

monopoly of it which the law recognizes. If there is to be *invention* from such a *discovery*, it must come from the application of the law of nature to a new and useful end.”) (emphasis added). The Constitution and Patent Act are not limited to “inventions,” but rather more broadly offer patent protection for “discoveries.”

Amici have discussed this matter at length in their 2013 paper. *See* Heinrich & Abernethy, 47 Loy. L.A. L. Rev. at 212-17 (“Patent-Eligible Subject Matter Includes ‘Discoveries’”); *see also id.* at 121-31 (“Patent Eligibility: Constitutional and Statutory Bases,” addressing the “Intellectual Property Clause” and the “Legislative History of Section 101”). Should the Court grant certiorari to review the present case, *amici* expect to file another brief expanding upon the Constitutional and statutory interpretation issues.

CONCLUSION

Amici respectfully request that the Court grant Realtime Data LLC’s petition for a writ of certiorari.

Respectfully submitted,

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