

No. 26-236

IN THE
Supreme Court of the United States

U.S. PATENT NO. 7,679,637 LLC,
Petitioner,

v.

GOOGLE LLC,
Respondent.

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

BRIEF OF THE ASSOCIATION OF AMICUS
COUNSEL, MR. CHRISTOPHER PRATLEY,
DR. PROF. HEINZ GODDAR, U.S. FEMALE
INVENTORS, U.S. INVENTOR INC.,
THE SMALL BUSINESS TECHNOLOGY
COUNCIL, AND THE ASSOCIATION FOR
AMERICAN INNOVATION, AS *AMICI CURIAE*
IN SUPPORT OF PETITIONER

CHARLES E. MILLER
Counsel of Record
PAUL COLETTI
ASS'N OF AMICUS COUNSEL
445 Park Avenue
New York, NY 10022
(516) 641-3378
charles.miller@cmilleriplaw.com
Counsel for Amici Curiae

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INTEREST OF *AMICI CURIAE*

Amici curiae identified herein respectfully submit this brief in support of the petition for certiorari.¹

Amici are part of a cross-section of the broad community of stakeholders in the United States patent system. *Amici* have a significant interest in the instant case because they are affected by patent adjudications such as this one whose outcomes resulting from Federal Circuit rulings on appeals from subaltern tribunals are concerning.

Amici have neither a direct pecuniary stake in the case, nor any business dealings or other affiliations with the parties relevant to it. Rather, their interest stems from a shared need and desire for the proper functioning of the U.S. patent system which motivate them to provide their perspectives on the issues presented. This brief is intended to be useful to the Court in comprehending and avoiding the negative implications and ramifications if the Federal Circuit's judgment is allowed to stand.

Amicus Curiae The Association of Amicus Counsel ("AAC") is an independent group of professionally active lawyers having diverse affiliations and law practices and who are in good standing in the jurisdictions and fora in which they have been admitted to practice. By training, experience, scholarship, and discernment in their respective areas of the law, AAC members value the judiciary's

¹ Pursuant to S.Ct.R. Rule 37.6, *amici* state that no party or its counsel authored this brief in whole or in part, and no person or entity other than said *amici* or their counsel made or will make any monetary contribution intended to fund the preparation or submission of this brief. Pursuant to S.Ct.R. 37.2(a), the parties' counsel were given timely notice of amici's intent to file this brief.

confidence in their abilities and candor in appellate advocacy, and in their proficiency in preparing and submitting amicus briefs as may be useful to tribunals in cases involving issues of contention.

Briefs of the AAC advocate correct and balanced decision-making in adjudications that illuminate and affect the concerns of the public, and of other non-parties similarly situated. For these reasons the AAC was conceived and exists: to contribute to the advancement of the science of jurisprudence through friends-of-the-court briefs in appellate proceedings. Toward that end, the AAC has participated as an *amicus* in cases in other fora² as well as in this Court³ in advocating the preservation and enhancement of the nobler qualities of justice by arguing in support of common-sense, real-world outcomes in furtherance of the rule of law.

In the realm of intellectual property, the AAC advocates fidelity to identifying and adhering to the correct principles of interpreting and applying statutes, rules, and case law governing the eligibility of inventions to be considered for the granting of utility patents as expressed in the foundational precepts set forth below in Part I of the Argument. Toward that end, the AAC supports the proper deployment of the Patent Act⁴, and the Dictionary

² See, e.g., *NantKwest, Inc. v. Iancu*, 898 F.3d 1177 (Fed. Cir. 2018).

³ See, e.g., *Oil States Energy Servs. LLC v. Green's Energy Group, LLC*, 138 S. Ct. 1365 (2018); *Peter v. NantKwest, Inc.*, 589 U.S. 23 (2019); *USPTO et al. v. Booking.com B.V.*, 591 U.S. ____ (2020); *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC et al.*, No. 20-891.

⁴ 35 U.S.C. § 100 (“Definitions”), § 101 (“Inventions Patentable”), and § 282 (“Presumption of Validity; Defenses”)

Act⁵, in determining, as a gatekeeping matter at the threshold of the patenting process, the utility-patent-eligibility under 35 U.S.C. § 101 of “any new and useful invention or discovery” made by “whoever” may desire to “obtain a patent therefor.” These principles and precepts are manifestations of Congress’s “Power to . . . make all laws which shall be necessary and proper for carrying into Execution the . . . Power [of Congress] to promote the Progress of . . . useful Arts.” U. S. Const. Art. I, sec. 8, cls. 18 and 8. Together they act as a coarse filter that allows eligible inventions to pass through en route to the test for patentability while blocking and excluding ineligible subjects matter from further consideration in the patenting process.

Amicus Curiae Mr. Christopher Pratley is a named inventor on forty-eight U.S. patents. He appears herein in his capacity as a businessman and member of the intellectual-property community. He is a former Vice President of Microsoft Corporation where he spent thirty years of his professional career. During his tenure at Microsoft, he created multiple Microsoft Office products, including OneNote and Sway. He founded Microsoft Garage, the company’s internal network for employee innovators, and led Office Labs, an incubation team that built new products and prototypes. After leaving Microsoft, Mr. Pratley founded his own company called Coach Ex Machina Inc. to develop and market inventions in artificial intelligence (“AI”).

During and after his years at Microsoft, Mr. Pratley witnessed the United States patent system become undermined in three distinct phases. When he

⁵ 1 U.S.C. §§ 1-8.

joined Microsoft, the patent system had been serving as a reliable way of protecting the legitimate interests of innovators, entrepreneurs, and investors in making inventions, obtaining patents, and bringing them to fruition in the marketplace. Over the ensuing years, he saw the system shift from protecting those interests in favor of entities confronted by claims of patent infringement. By the time he left Microsoft, Mr. Pratley saw that the system had become unreliable and unpredictable to the point where it no longer serves its purpose with any degree of certainty. The first two phases had its defenders. In its present phase, the system has none.

Mr. Pratley's particular interest as an *amicus* stems from conversations he had with patent counsel shortly after starting his AI company. The conversations were about whether AI inventions could be patented in a way that would actually protect them, both from infringers and as monetizable assets. The answer, described below, should worry this Court. It explains the widespread legal problem that the petitioner is asking this Court to solve.

Amicus Curiae, Dr. Prof. Heinz Goddar is a European patent attorney. Dr. Goddar's interest as an *amicus* in this case stems from the fact that for decades as a partner in a major law firm in Germany, a significant part of his practice has been spent advising and representing clients in various countries on matters of international intellectual property law, including European patent law. Ongoing developments in disciplines affecting his clients have often been impacted by corresponding developments in the United States patent system as typified by the issue in the present petition.

Amicus Curiae, U.S. Inventor Inc. (“USI”) is a nonprofit advocacy organization dedicated to promoting strong and effective U. S. patent rights of inventors and technology-based startups. USI’s nationwide membership relies on a dependable patent system to protect innovation, to compete with dominant market incumbents, to support domestic manufacturing, and to help maintain American technological leadership.

Amicus Curiae, The Association for American Innovation (“AAI”) is a diverse organization representing numerous technology sectors and is dedicated to supporting and promoting American technological innovation. The AAI recognizes that continuous technological innovations are necessary for America to prosper and are essential for the country’s economic national security. The AAI’s core mission is to maximize innovation by promoting the strengthening and maintenance of a robust system of patent rights in the United States. The AAI believes that a correct outcome of the present case is essential to achieving that goal.

Amicus Curiae, U.S. Female Inventors (“USFI”) is a national organization providing a platform for over 500 women inventors and entrepreneurs to advocate for a strong, reliable, and accessible U.S. patent system. USFI’s members include independent inventors, entrepreneurs, and small-business innovators who rely on patent protection to justify investment in inventions, attract capital and commercial partners, disclose new technologies, and protect those technologies from unauthorized use. USFI members have a particular interest in the predictable application of 35 U.S.C. § 101 because uncertainty concerning whether an issued patent will

remain enforceable directly affects inventors' and innovators' decisions whether to invest in patent protection for the purpose of commercializing, licensing, or raising the capital needed for the enforcement of patent rights.

Amicus Curiae The Small Business Technology Counsel (SBTC) is the nation's largest association of small, technology-based companies in diverse fields. SBTC is a council of the National Small Business Association (NSBA), the nation's first small-business advocacy organization. NSBA is a nonpartisan organization with 65,000 members in every state and every industry in the US. SBTC's interest in this case and its outcome manifests SBTC's policy of advocating on behalf of the 6000 firms who participate in the Small Business Innovation Research (SBIR) and Small Business Technology Transfer (STTR) programs. In most years, SBIR/STTR companies have obtained more U.S. patents than all American universities combined.

SUMMARY OF ARGUMENT

Within the framework of the federal common law of patents, 35 U.S.C. § 101 governs the eligibility of an “invention or discovery” to be tested for patentability against the downstream “conditions and requirements” in other sections of the Patent Act. As a corollary, a tribunal that deploys those conditions and requirements in determining the patentability of an invention is presumed to have already deemed the invention eligible for such a determination. In other words, to be judged patentable, the invention must be eligible as a condition precedent, whereas an invention that is patent-eligible is not necessarily patentable.

The present petition for certiorari asks this Court to provide that which experience has demonstrated in numerous Federal Circuit § 101 decisions over the past 12 years to be critically lacking in deploying the general two-step test for § 101 patent-eligibility enunciated in *Alice Corp. Pty v. CLS Bank Int'l*, 573 U.S. 208 (2014). What is lacking is reasonable predictability of eligibility determinations that the public and particularly the patent community can rely on. *Amici* submit this brief to demonstrate what that lack of predictability looks like at an operational level, viz., in patent strategy deliberations among inventors, innovators, entrepreneurs, corporate executives, investors, and their counsel.

When *amicus* Mr. Pratley left Microsoft and founded Coach Ex Machina, his patent counsel could not say with any degree of certainty whether AI patents could survive scrutiny under the present state of the law of § 101. Instead, counsel could only posit two paths going forward, both of which would more likely than not result in unpredictable outcomes. One path would involve writing patent specifications whose claims define AI inventions as “improvements to how a computer functions.” Although the Federal Circuit recognized this as affording a zone of relatively predictable patent-eligibility for software inventions, it was too narrow to provide a meaningful definitional framework that could reliably protect inventions and innovations in the emerging modern AI technology space. The other path would entail writing specifications whose claims define AI inventions precisely but which face a heightened risk of unpredictability under *Alice* Step One. Neither path offers the kind of necessary protection that can be relied on by AI inventors and their proponents.

This is the operational state of affairs in AI invention and innovation prevalent in the United States today. Mr. Pratley knows this from his own experience in founding start-up companies. Other founders have had similar experiences. Investors nowadays want to know not only whether a startup company's patent assets are strong, but also whether they are worth the cost and effort of obtaining and maintaining them. Faced with this dilemma, inventors and their assigns are increasingly choosing to protect their technologies via the law of trade secrets rather than publicly disclosing them in patents – a Hobson's choice that the U.S. patent system was meant to avoid.

It isn't hard to understand why large AI incumbents can tolerate such unpredictability and consequent unreliability while start-up companies cannot. In the real world, the operation of the two-step *Alice* test has become an entry barrier against those inventive entities the patent system was designed to benefit, encourage, and protect in order “to promote the Progress of . . . useful Arts.”

Predictability is what the patent system requires in order to function as intended, and reliability through inherent predictability is what the petitioner is asking this Court to restore. The petition should be granted.

ARGUMENT

America's utility-patent-eligibility jurisprudence is predicated on 35 U.S.C. § 100 and § 101 of the Patent Law Revision and Recodification Act of July 9, 1952 (ch.950, 66 Stat. 792, 797 eff. January 1, 1953 [“the Patent Act” or “title 35”] and 1 U.S.C. §§ 1-8 (the “Dictionary Act”). In a single, broad sentence of 36

words comprising two orthogonal clauses, the first clause being anaphoric and the second cataphoric, *see*, A. Scalia and B. A. Garner, *Reading Law – The Interpretation of Legal Texts*, 144 (Thomson/West 2012), the legislative Stradivarius known as § 101 states that:

“Whoever invents or discovers any new and useful process, machine, manufacture, composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.”

The substance of § 101 has endured over the centuries following its original expressions in the initial federal patent acts of 1790 and 1793. Section 101 is the statutory instrument on which decision-makers must perform when deciding patent-eligibility in a way that separates the signal from background noise. Justice requires that § 101 be deployed according to the principles, precepts, doctrines, and canonical rules for analyzing and interpreting legal texts – both in the statute itself and in patent specifications – in harmony with underlying relevant factual evidence.

American patent eligibility jurisprudence under § 101 and in statutory precursors has been manifested in a series of almost two dozen apex holdings by justices of this Court across decades spanning the development of the federal common law of patents. In the context of the present case, the Court’s evolving patent-eligibility jurisprudence culminated in the two-step test for patent-eligibility enunciated in *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208 (2014). In it, the Court held that a patent claim directed to an “abstract idea” (specifically in that case a financial

transaction qua “process”) is not patent-eligible [Step One] unless it incorporates an “inventive concept” [Step Two]. Unfortunately, the *Alice* decision did not define the operative terms “abstract idea” and “inventive concept.” Instead, it was left to Federal Circuit panels, federal district court judges, and others to figure it out for themselves with no further guidance from the Court. Not surprisingly, this resulted in a cavalcade of astoundingly inconsistent decisions by lower courts and other tribunals, resulting in lack of clarity, predictability, and reliability. This chaotic state of affairs has been recently analyzed and discussed by a prominent legal scholar at the University of Washington School of Law in the particular context of the present case. See, Prof. Toshiko Takenaka, *The Forgotten Constitutional Actor: Inventors and the Patent Bargain* (September 11, 2026). Available at SSRN: <https://ssrn.com/abstract=7448065> or <http://dx.doi.org/10.2139/ssrn.7448065>.

Granting the present petition will enable this Court to review and correct the Federal Circuit’s decision, thereby avoiding the creation of a dangerous template for decision-making in future cases involving patent-eligibility of AI inventions.

I.

The Federal Circuit's Affirmance Of The District Court's Dismissal Of The Complaint Epitomizes The Injustice Of Misapplying The *Alice* Test

In order for the U.S. patent system to function the way Congress intended, § 101 has required the decision-maker, at the threshold of every case involving the granting of a patent application or the

validity of an issued patent, to address a two-fold question, namely, (i) what is the “invention” that the claims in the application or patent, taken as a whole and properly construed, directed to? and (ii) is the invention defined in the claims, as so construed, *eligible* to be tested against the conditions and requirements for *patentability* under the other sections of the Patent Act? There are, by and large, five distinct groups of decision-makers tasked with making those determinations:

The first group are patent practitioners versed in technology and trained in patent law, and who advise and represent (a) inventors and assigns, or (b) other entities, on matters of § 101 subject matter patent-eligibility.

The second group is the corps of technically trained ‘patent examiners’ within in the U. S. Patent and Trademark Office (“USPTO”) whose job includes determining whether that agency, acting on behalf of the federal government, should grant to a patent applicant the exclusive right to a given invention by issuing a patent therefor.

The third group are the Article II administrative patent judges (“APJs”) who, like patent examiners, are educated in technology, and also in the law, and who serve on the agency’s Patent Trial and Appeal Board (“PTAB”) (a) to receive appeals by disappointed patent applicants and decide whether to affirm or overrule examiners’ adverse determinations, and (b) upon requests of third-parties, conduct, on a selective basis, post-grant reviews and assessments of patents whose validities have been challenged.

The fourth group are the Article I administrative law judges (“ALJ’s” or commissioners) of the International Trade Commission (“ITC”) who decide the validity vel non of a patent whose validity has been challenged in a Tariff Act proceeding.

The fifth group are the Article III judges and justices who, except for those sitting on the Federal Circuit, typically are not technically trained, who decide whether to (a) affirm or reverse PTAB affirmances of examiners’ adverse determinations in patent applications, or (b) sustain or revoke claims in issued patents whose validity has been challenged in court litigation or in a request for USPTO post-grant review.

Requirements for Patent-Eligibility. With the exception of the tacit exclusions from eligibility discussed below in II, and in statutory furtherance of Congress’s aforesaid “Power[s],” only those claimed “inventions” that fall within the subject-matter categories recited in § 101⁶ are eligible by law (reviewable de novo) to be vetted for patentability, but only if two factual requirements of the statute (reviewable for clear error) are met. The first requirement is that the inventions must be “new” in

⁶ The subjects matter categories of inventions recited in § 101 have been characterized in antecedent statutes as the “great and distinct classes of invention.” *See, Ex parte Blythe*, 1885 Comm’n Dec. 82, 86 (Comm’r Pat. 1885). It may be noted that according to 35 U.S.C. § 100(b), the categorical scope of § 101 implicitly includes “materials” because, § 100(b) defines the recited category of “process[es]” in the context of § 101 to include “a new use of a known process, machine, manufacture, composition of matter, or *material*.” [Emphasis added.] Also, the noun “material” is ubiquitous in § 101 case law. *See, e.g., In re Bergstrom*, 427 F.2d 1394, *passim* (C.C.P.A. 1970).

the sense of not having already existed as such. The second requirement is that they must be “useful” in the sense of having specific, substantial, beneficial, immediate, and practicable utility. Such inventions – and only they – are *eligible to be considered* for follow-on determinations of **(A)** whether they are patentable under 35 U.S.C. § 102 and § 103, and **(B)** whether (i) specifications, (ii) drawings (when required), and (iii) models, specimens and ingredients (when required) describing, claiming, depicting, and embodying the inventions in written patent applications under § 111, satisfy the standards of adequacy of disclosure under § 112, § 113, and § 114 for the issuance of patents pursuant to § 131 and § 151.

Exclusions from Eligibility. Consistent with its legislative intendment, § 101, by judicial exegesis, implicitly and logically excludes from patent-eligibility things that:

- (A) are either not “invented” or not “new,” because they already exist ‘out there in the wild’ independent of human effort. Such things cannot be legally appropriated in patents even if the claims are broad enough to encompass them as such, viz., **(i)** tangible ‘products of Nature’, **(ii)** ‘laws of Nature,’ **(iii)** phenomenological manifestations of the laws of Nature and **(iv)** aggregations of things already known that function separately, e.g., a pencil with an eraser on the end of it; or
- (B) not “useful,” viz., **(i)** inventions that don’t work, e.g., systems like perpetual motion machines whose energy outputs are alleged to exceed their energy inputs, and **(ii)** compositions of matter or materials, as well as

processes for producing them, whose utilities are unknown or speculative; or

- (C) so-called “abstract ideas,” viz., (i) mathematical formulas and equations as such, (ii) the use of computers and computer software merely as tools for the sole purpose of implementing known ideas that could otherwise be carried out manually, or of acquiring, collecting, analyzing, and displaying data, and (iii) imaginary things expressed in and encompassed/pre-empted by claims that are written “at such a high level of generality” as to be merely aspirational, results-oriented statements or figments amounting to mere wishes for *what* those things *do*, without specifying any concrete, particularized algorithms for *how* they are done, or without defining what those ideas actually are. Claims directed to such things fail because they recite them in terms so vague or broad as to encompass (i.e., pre-empt) inventions yet to be made, or that, when put to the test, cannot be reduced to practice. (For example, things conceived that are defined and prophetically exemplified in the specifications of so-called “paper patents,” that, notwithstanding their prima facie legal status as constructive reductions-to-practice, are not enabled, or cannot be reduced to actual practice, or that are not adequately described in, taught by, or discernible from, the patent document.)

Limits to Patent-Eligibility of Multi-Element Inventions. A patent that claims an invention as an integral, “ordered combination” of elements is one that

comprehends, appropriates, and *is limited to*, the combination of those elements *as recited in the claim(s)* without creating a proprietary right in any one or more but less than all of said elements.

Effect of Non-Eligibility of Recited Claim Elements. That one or more but less than all of the elements recited in a claim to an integral combination of elements lacks patent-eligibility does not in and of itself necessarily foreclose the eligibility of the combination.

Determining the patent-eligibility of an invention requires the deployment of the foregoing precepts and doctrines with consistency in accordance with the canons of interpreting legal texts in statutes and in patent specifications. These canons act as guardrails that guide the determinations within boundaries in a manner consistent with the plain and ordinary language of § 101 and the plain wording and ordinary meaning of patent specifications. Unfortunately, the prevalence of flawed legal precedents has frustrated the goal of consistent, case-by-case decision-making. This state-of-affairs calls for re-visiting the controversial patterns of judicial decision-making that have imposed certain illogical and flawed requirements for eligibility. In the present case and others like it, the problem resides in the requirement there be so-called, undefined “inventive concepts” embedded in otherwise excluded subjects matter – most notably but not exclusively in reported cases involving abstract ideas – that are supposed to amount to “something more” than “conventional steps or features,” so as to transform otherwise ineligible subjects matter into patent-eligible inventions by providing undefined “technological solutions to technical problems.”

II.

The Misapplication Of The *Alice* Test In This Case Typifies The Lack Of Predictable Protection That Has Caused The Present Widespread Uncertainty In The Reliability Of U.S. Patent Protection For AI Inventions

When *amicus* Christopher Pratley left Microsoft and started his own AI company, the first substantive conversation he had with patent counsel was in regard to § 101. Mr. Pratley expected the usual guidance, e.g., which features of AI inventions were most likely to be patentable, how to structure patent claims to cover those inventions most effectively, and where to apply for patents. But what he took away from that conversation was something quite different. He learned that whether his AI inventions would be patent-eligible and whether patents on them would be respected or enforceable could not be said with any degree of assurance.

Counsel walked through what Mr. Pratley has since come to understand as the standard conversation between AI company founders/executives and their patent lawyers. There are, counsel said, two paths to seeking patent protection of AI inventions, neither of which is satisfactory. The first path offers a measure of predictability in obtaining patents that, albeit not invalid, did not predictably protect the actual inventions. The second path offers potential protection but without the degree of predictability that AI inventors and innovators need to rely on in order to survive. AI inventors and innovators should be able to rely on both predictability and protection, but in the real world they rarely achieve it.

The first path was to draft patent applications so that AI inventions sounded like “improvements to how a computer functions.” Counsel explained that the Federal Circuit had carved out a narrow zone of patent eligibility for software inventions that could be described as making the computer itself work better at the architectural level, rather than applying an idea on a computer. Inventions that landed inside that zone had a meaningful chance of surviving § 101 challenges at the pleading stage. Inventions outside it did not.

The problem is that this zone had been drawn for inventions that predated modern AI: database structures, memory architectures, network protocols, the low-level plumbing of how computers store and retrieve data. AI inventions, on the other hand, are different in kind. They endow machines with new capabilities by training them on examples. It is not, generally speaking, about making the computer itself faster or more efficient at the architectural level that the *Alice* test recognizes. To frame AI inventions as “improvements to how a computer functions” would mean writing claims that described not the inventions themselves but a contorted framing of them focused on the architectural details. A potential infringer reading the patent claims would be free to build the same capability using a different architecture that would avoid the claims. This would leave the AI patentee worse off than not patenting at all.

The second path was to describe the inventions accurately and deal with Step One of the *Alice* test directly. That was the path of full unpredictability. Counsel could not reliably predict whether any Federal Circuit panel would judge the client’s inventions to be patent-eligible. Counsel could only

predict that the answer would depend on which panel happened to draw the case, what characterization of the invention the panel adopted, and how willing the panel would be to wrongly convert a fact-intensive question into a pure legal one to be disposed of on the pleadings.

AI inventors are given a choice they cannot really make: the first path provides predictability without protection; the second path provides neither predictability nor protection. That's the kind of advice that informs AI investment strategy. It is choosing how to lose.

What counsel did not have to say, and what Mr. Pratley understood without being told, was that the practical effect of that conversation would shape every future patent strategy decision he would have to make for his AI company going forward. Economics make this choice different from what inventors and investors were told in the past. A patent application can cost five figures to prepare and prosecute to allowance and issuance. Litigation and/or licensing can cost up to seven figures. At the end of all that, an inventor would be hard pressed to predict ultimate outcomes if courts could invalidate the patent with minimal procedural protections, or if competitors and would-be licensees could avoid liability and royalty obligations by designing around patent claims that were unnaturally contorted away from the actual invention. Investors no longer ask whether a startup's patents are strong. They ask whether the startup should bother patenting at all.

Business leaders confronted with this reality are reacting by eschewing public disclosure/patent coverage of their technologies in favor of relying on

trade secrets law for protection. While that choice may appear to be a rational response to what counsel are saying, it is also a choice that contradicts the patent system's purpose under U.S. Const. Art. I, Sec. 8, cl.8 of the Constitution.

Example 1: Mr. Pratley developed a personalized video coaching system for showing the user how to swing at a tennis ball, and fragments of a video of a professional tennis player performing the same swing. The invention would edit these video components together in order to highlight where the user would need to adjust the motion and timing of the swing. The video would further feature a customized instructional voiceover. The system would do all of this 'on-demand' in seconds as soon as the user performed a swing. Mr. Pratley was told by patent counsel that this AI invention would not likely survive the *Alice* test because a human could perform these same operations, and therefore there was no invention because it would be seen as merely an "abstract idea" for using a computer to do a human task faster instead of improving the operation of the computer.

Example 2: Mr. Pratley developed a system for coordinating the use of multiple AI systems to deliver cost-effective tennis coaching using existing AI services of several vendors to perform various aspects of the process. The system is able to provide users with helpful insights regarding their technique. Mr. Pratley's invention achieved integral use of these AI systems to augment them while at the same time reducing costs. Mr. Pratley was informed by patent counsel that this invention would not likely survive the *Alice* test because it would be seen as simply an abstract idea for using computers to automate a human task and because the invention did not

“improve the operation” of the underlying computer architecture.

In both examples, Mr. Pratley was advised to conceal the inner workings of these innovations as trade secrets rather than reveal them in patents that would educate potential infringers and at the risk of having no reliable recourse against them under the Patent Act.

Mr. Pratley is not the only AI start-up founder having this conversation. From discussions with other founders and investors, the same two paths are described by different lawyers, the same diligence questions are asked by different investors, and the same disclosure-versus-secrecy calculations are frequently being made.

The predictability problem is concentrated where this Court is least likely to see it: in corporate decisions about which inventions to develop and which inventions to forgo, made by AI start-up founders and investors who never reach a court room because some of the patent system’s biggest failures in patent-eligibility decision-making never show up in litigation. They manifest themselves in meritorious inventions that no one sought to patent, in worthwhile investments that were never made, and in ground-breaking inventions hidden from the public through concealment in the form of trade secrets. These adversities rarely reach the courts. But they are happening, right now, in the most consequential technology sector in a generation.

AI is also the sector in which the unpredictability of § 101 patent-eligibility is most severe. The narrow zone the Federal Circuit has carved out for predictable software patent eligibility does not extend to AI. AI

lives in a broad, unpredictable region of the “useful Arts” where outcomes depend on which characterization of the invention a court adopts on the pleadings, with no procedural discipline to constrain that characterization.

The mismatch between AI technology and § 101 eligibility is not a problem the Federal Circuit alone can fix. The Federal Circuit’s decision below typifies the concern over unpredictability that this Court can correct. The present petition is asking for the procedural protections that would make the *Alice* test reliable and predictable in substantive content and operation. That is what AI companies urgently need and what stakeholders in the U.S. patent system are seeking.

III.

AI Inventors And Innovators Have No Recourse From *Alice* Uncertainty, Which Is Why This Case Matters

The *Alice* test provides owners of software technologies with two alternative paths to patent protection: (1) by claiming those technologies within the framework of “improvements to how a computer functions,” as in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016), or (2) by claiming them within the unpredictable *Alice* Step One framework. For software inventions, the first path is usually viable. Inventors who can credibly describe their work as making the computer itself function better have a meaningful zone of patent eligibility to work in. They can trade some accuracy of description for some procedural predictability.

Owners of AI inventions, on the other hand, don't have that option. The narrow zone of predictability was for a different generation of software: database structures, memory architectures, network protocols, etc. Modern AI technology does not fit through it. An AI invention described as an "improvement to how a computer functions" protects the framing rather than the underlying capability, leaving the inventor worse off than not patenting at all. The first path is effectively closed to owners of AI. They are locked into *Alice* Step One.

And *Alice* Step One is what the present petition is asking this Court to address. The petitioner's infringement complaint was dismissed at the pleading stage. There was no claim construction. There was no development of the facts a § 101 inquiry is supposed to rest on. There was no characterization of the abstract idea. That procedural letdown is the most egregious form of *Alice* unpredictability that AI inventors and innovators face when trying to enforce their patents that cover what they actually invented.

Granting the present petition would enable the Court to decide the merits of this case and in so doing help the patent community by preventing the wrongful invalidation of patents in Fed.R.Civ.P. 12(b)(6) motions to dismiss at the pleading stage. And it would help AI startup companies most of all because they have nowhere else to go. They cannot frame their patents to fit within the narrow zone of predictability with any reasonable expectation of achieving reliable protection of their inventions. Instead, they must live where *Alice* uncertainty lives. Restoring procedural justice and discipline at the pleading stage is the only path back to a viable patent system that AI inventors

and innovators as well as all stakeholders in the system can rely on.

Toward that end, since respondent Google LLC waived its right to respond to the instant petition, *amici* respectfully invite the Court to consider requesting a response prior to deciding the present petition for the benefit of full adversarial briefing at this critical juncture of this important case. It should be noted that there is another petition for certiorari pending before this Court in *Innovaport LLC v. Target Corporation*, No. 26-322 involving Section 101. The text at pages 26-30 of that petition under the heading in Part IV (“This Court Should Clarify That A Court’s Invalidation Of A Patent On Summary Judgment Must Be Supported By Record Evidence”) directly invokes the relevance and acknowledges the impact of the present petition’s identification of the problem, i.e., collapsing Step Two into Step One of the *Alice* test raises a question that requires this Court’s resolution. *Amici* submit that this can be done by calling for a response from Google LLC before deciding the present petition.

CONCLUSION

The U.S. patent system can fulfill its constitutional purpose only when stakeholders are willing – and able – to rely on it with reasonable predictability as a means for protecting their legitimate rights and interests respecting inventions and discoveries including those involving AI. *Amici* support and urge the granting of the present petition for certiorari so that the Court can act to restore that predictability and reliability.

Respectfully submitted,

CHARLES E. MILLER

Counsel of Record

PAUL COLETTI

ASS'N OF AMICUS COUNSEL

445 Park Avenue

New York, NY 10022

(516) 641-3378

charles.miller@cmilleriplaw.com

Counsel for Amici Curiae

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