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Chamberlain Petitions SCOTUS to Review CAFC's 'Refusal to Assess Claims as a Whole' in Garage Door Opener Case

By **Rebecca Tapscott**
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Print Article

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 On May 15, the Chamberlain Group Inc. filed a petition for a writ of certiorari asking the U.S. Supreme Court to review the U.S. Court of Appeals for the Federal Circuit**'s** (CAFC) decision reversing a district court's holding that Chamberlain's claims covering a "moveable barrier operator" were patent-eligible under Section 101. If the Supreme Court grants review**,** it will consider whether the Federal Circuit "improperly expanded § 101's narrow implicit exceptions by failing to properly assess Chamberlain's claims 'as a whole,' where the claims recite an improvement to a machine and leave ample room for other inventors to apply any underlying abstract principles in different ways."

Federal Circuit Reasoning

On appeal, the CAFC found the disputed claims of U.S. Patent No. 7,224,275 (the '275 patent) to be ineligible because "wireless transmission" was the only element of the claims that was inventive over the prior art. The CAFC noted that "transmitting information wirelessly was conventional at the time the patent was filed and could be performed with off-the-shelf technology." Thus, since "wireless communication cannot be an inventive concept here, because it is the abstract idea that the claims are directed to," the Court held that "no inventive concept exists in the asserted claims sufficient to transform the abstract idea of communicating status information about a system into a patent-eligible application of that idea."

Chamberlain's Argument for Granting the Petition

Chamberlain noted that there are three reasons why the Supreme Court should grant its petition. First, the CAFC persistently refuses to analyze claims "as a whole" under Section 101, which defies Supreme Court precedent and "divorces the statute's implicit exceptions from the statutory language and preemption concerns." Second, Chamberlain argued that the CAFC's approach to Section 101 threatens innovation and investment across many technological areas. Third, Chamberlain outlined several reasons why this case is an "ideal vehicle" to address and correct the CAFC's Section 101 jurisprudence.

CAFC's Application of Section 101

The bulk of Chamberlain's arguments surrounded its assertion that the CAFC has strayed from the text of Section 101 and drastically expanded the exceptions to patent eligibility, in particular by not analyzing claims "as a whole." Chamberlain noted that *Alice's* two-step framework enforces a balance between the monopolization of natural laws and abstract ideas and claims that apply those basic tools in a new, useful and particularized way. Chamberlain further noted that the CAFC's refusal to examine claims "as a whole" caused a failure to properly assess the preemption concerns addressed by both steps of *Alice*.

Chamberlain noted that step one of *Alice* asks whether the claims at issue are directed to a patent-ineligible concept. Explaining that Supreme Court precedent dictates a holistic approach that examines what the claims at issue are directed to "as a whole", Chamberlain argued that the CAFC's approach of separating the claims into old and new elements basically equates to the invention of a "fundamentally different step-one test." Chamberlain also argued that the CAFC's approach of focusing on "the claimed advance over the prior art" improperly imports novelty and obviousness determinations into the question of whether the subject matter of a claim is eligible under Section 101.

Chamberlain also noted that the CAFC improperly proceeded to step-two of the two step framework, which subjects claims to a "closer scrutiny, deeming eligible those that incorporate natural laws or abstract ideas more prominently (and so were not filtered into 'eligibility' territory at step one), but that nonetheless pair those concepts with a specific, inventive component (and so pose no risk of undue preemption)." Noting that the Supreme Court has held that inventors cannot preempt an entire field and must rather narrow claims to a particularized application within a field, Chamberlain asserted that the CAFC misapplied the "technological environment" standard. Chamberlain noted that the critical question should have been whether the claims "preempt *every imaginable* implementation of the abstract idea within that technological field, and so improperly monopolize the idea itself." Chamberlain asserted that the answer was "no".

Effects on Innovation and Investment

Chamberlain argued that the CAFC's approach to Section 101 is widespread and threatens innovation and investment in many areas of technology, such as manufacturing, home appliances, automotive and computing. Citing many cases where industries have asked the Supreme Court to step in, Chamberlain noted that this is "an innovation emergency" that is undermining innovation and investment.

Chamberlain also argued that this case is an "ideal vehicle" for the Supreme Court to "reaffirm that courts must evaluate the claims 'as a whole' and tether the § 101 inquiry to the preemption concerns embodied in the statute and the Constitution." Instead, the clarification Chamberlain is seeking "targets the analytical misstep that has led the Federal Circuit down the wrong path in so many recent cases and will greatly reduce the confusion surrounding § 101 without a complete overhaul of established jurisprudence," said the petition.

In conclusion, Chamberlain further noted that the case is an "ideal vehicle" because: 1) of the "current uncertainty" surrounding § 101; 2) this is a case

where the lower courts' confusion and the Supreme Court's precedent makes a practical difference; 3) there is no dispute that would significantly impede efforts to clarify § 101; and 4) garage door technology is familiar and easy to understand.