

Fed. Circ. Judge Rebukes Panel For Alice Ax Of Camera Patent

By [Dani Kass](#)

Law360 (June 14, 2021, 4:37 PM EDT) -- A split Federal Circuit panel on Friday upheld the invalidation of a digital camera patent asserted against [Apple](#) and Samsung as abstract, leading Judge Pauline Newman to accuse her colleagues of conflating patent eligibility and novelty.

In line with U.S. District Judge James Donato of the Northern District of California, the majority claimed Yanbin Yu and Zhongxuan Zhang's patent is directed to the abstract idea of taking two pictures and using one to enhance the other. The precedential ruling affirmed that Apple and Samsung can dodge infringement litigation at the [motion to dismiss stage](#).

But Judge Newman said the claims clearly show a mechanical invention with a defined structure, which may fail tests like novelty or obviousness, but clearly is patent eligible under Section 101.

"Although today's Section 101 uncertainties have arisen primarily in the biological and computer-implemented technologies, all fields are affected," she wrote in her dissent. "The case before us enlarges this instability in all fields, for the court holds that the question of whether the components of a new device are well-known and conventional affects Section 101 eligibility, without reaching the patentability criteria of novelty and nonobviousness."

The majority opinion, written by Judge Sharon Prost and joined by Judge Richard G. Taranto after March oral argument, said the idea of using multiple pictures to enhance each other has been known for more than a century and that the patented way of doing so under scrutiny Friday is "well known and conventional."

The opinion said that makes the patent abstract based on the [U.S. Supreme Court's](#) Alice test, which first looks at whether a claim is abstract and then whether there's an added inventive concept to make it patent eligible. Here, they said there was not an

added inventive concept to transform the patent.

"Because claim 1 is recited at a high level of generality and merely invokes well-understood, routine, conventional components to apply the abstract idea identified above," the opinion said.

Judge Newman shot back that the majority's focus on whether the invention was well-known is irrelevant to whether the invention in U.S. Patent No. [6,611,289](#) is abstract.

"Claim 1 is for a digital camera having a designated structure and mechanism that perform specified functions; claim 1 is not for the general idea of enhancing camera images," the dissent said. "The camera of the '289 patent may or may not ultimately satisfy all the substantive requirements of patentability, for this is an active field of technology. However, that does not convert a mechanical/electronic device into an abstract idea."

Apple and Samsung had also challenged this patent at the Patent Trial and Appeal Board, where some asserted claims were [invalidated as obvious](#) in January.

Counsel for the parties didn't immediately respond to requests for comment Friday.

U.S. Circuit Judges Pauline Newman, Sharon Prost and Richard G. Taranto sat on the panel for the Federal Circuit.

The patent-in-suit is U.S. Patent No. 6,611,289.

Yu is represented by Robert G. Litts and Daniel Johnson Jr. of Dan Johnson Law Group LLP.

Apple is represented by Heidi Lyn Keefe, Deepa Kannappan, Lowell D. Mead, Priya B. Viswanath and Phillip Edward Morton of [Cooley LLP](#).

Samsung is represented by Douglas Hallward-Driemeier, James Richard Batchelder, David S. Chun, Steven Pepe and Scott S. Taylor of [Ropes & Gray LLP](#).

The case is Yu v. Apple Inc., case number [20-1760](#), in the [U.S. Court of Appeals for the Federal Circuit](#).

--Editing by Gemma Horowitz.