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By **Burman York (Bud) Mathis III**
June 23, 2021

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Print Article

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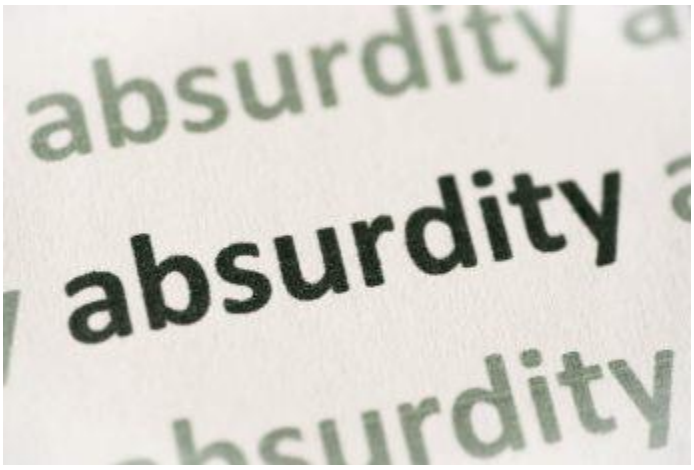

Reading the recent opinion of Judges Prost and Taranto in *Yu and Zhang v. Apple and Samsung*, Appeal Nos. 2020-1760, 1803 (Fed.Cir. June 11, 2021), I'm reminded of something Mark Twain never said: "There's a lie, there's a damned lie, and then there's an *Alice-Mayo* decision." Granted, it is hard to tell one *Alice-Mayo* decision from another. At face value, the *Yu* decision appears to be merely the latest absurdist fiction in a collection of short stories based on the abandonment of conventional law. Yet, the *Yu* decision is more than the typical *Alice-Mayo* scenario where logical construction and argument give way to irrationality in a senseless judiciary.

No Claim Could Survive

This story starts with a motion to dismiss on the basis that the asserted claims were patent ineligible under 35 U.S.C. § 101 by the honorable Judge James Donato in the Northern District of California. Granted, it is not certain that any claim at issue in the *Yu* case would survive Title 35 U.S.C. §§ 102/103 in a vigorous litigation where the patent holders would face an army of well-paid attorneys having comparatively infinite resources. ***What is certain is that no claim ever written could survive the treatment of Judges Donato, Prost, and Taranto***. Over 70 years ago, Justice Robert Jackson lamented in a dissenting Supreme Court opinion (*Jungersen v. Ostby & Barton Co.*, 335 U.S. 560, 572 (1949)) that "the only patent that is valid is one which this Court has not been able to get its hands on" while pondering inadequacies for determining the standard of "invention" necessary to

confer patentability. A few days ago, the Federal Circuit proclaimed, “Those guys were amateurs.”

To Judge Donato’s credit, there does appear to be evidence dating back to the mid-1800s of a photographer in France who used multiple photographic exposures to create an improved photograph. Where Judge Donato fails miserably is using this single instance of evidence to conclude that this practice was “well-understood, routine, and conventional.”

Where the Federal Circuit fails miserably is an inability to read its own case law.

Dear Judge Taranto, remember when you were a panelist in the *Berkheimer* decision and signed onto the following undeniable truth: “The mere fact that something is disclosed in a piece of prior art, for example, does not mean it was well-understood, routine, and conventional”? *Berkheimer*, slip op. at p. 14. Remember when you signed onto the statement, “summary judgment is improper because whether the claimed invention is well-understood, routine, and conventional is an underlying fact question *for which HP offered no evidence*”? Id. slip op. at p. 13. The *Berkheimer* decision recognized that the burden of proof to invalidate a patent under FRCP 56 is properly put on a party challenging a patent.

An Unknown Standard

Fast-forwarding to last week, the new standard is summarized as “the complete absence of any facts [provided by the patent-holder] showing that the[] [claimed] elements were not well-known, routine, and conventional.” *Yu*, slip op. at p. 4. “[E]ven if claim 1 recites novel subject matter, that fact is insufficient by itself to confer eligibility.” *Yu*, slip op. at p. 9. “The main problem that [Yu] cannot overcome is that the claim . . . is missing an inventive concept.” *Yu*, slip op. at p. 10.

Forget the logical impossibility of proving a negative when no opportunity was ever provided to the patent holder to present evidence. How does one prove something isn’t “well-known, routine, and conventional?” Forget that novelty mandates that a claim is not well-known, not routine, and not conventional. Forget that the term

"inventive concept" has never been defined in the last 170 years of thousands of jurists pondering the mysteries of "invention." All old stuff. The *Yu* case is distinguished in that the new burden of proof for patent eligibility under *Alice-Mayo* is now shifted from the party challenging a patent to the patent-owner under an unknown standard of evidence.

Now that is novel.

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Burman York (Bud) Mathis III is a sole-practitioner in the Washington D.C. area with experience in patent drafting and prosecution, opinion writing, due diligence, litigation and appellate work. Mr. Mathis technical expertise and experience is far-ranging. For example, Mr. Mathis' experience covers a wide variety of highly-technical subject matter that includes wired and wireless communications (including MIMO, 3G, 3GPP/LTE, D2D and 4G technology), analog and digital electronics, image processing, semiconductor devices and processes, solid-state physics, material science, printers and copiers, projectors, cameras, speech recognition and synthesis, xerography, cryptography, control systems, magnetic and optical disc technologies, fiber optics, MEMS technologies, nanosensors, GPS navigation systems, software, computer networking and business methods.