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By [Dani Kass](#) · [Listen to article](#)

Law360 (October 14, 2022, 9:03 PM EDT) -- A New York federal judge rightly found two location-tracking patents asserted against [Google](#) invalid under the [U.S. Supreme Court's](#) Alice decision but then improperly extrapolated that holding to invalidate two other patents, the Federal Circuit said in a split ruling Thursday.

The majority faulted U.S. District Judge Alvin K. Hellerstein for analyzing whether all four of inventor Sholem Weisner's patents — which share a specification — were invalid under [Alice](#) without differentiating the claims. They reversed half of Judge Hellerstein's [order dismissing the case](#), leaving Google to again defend its Maps platform in the infringement suit.

Under Alice, a patent claiming an abstract idea can only meet eligibility requirements if it has an added inventive step. While the full panel said all four patents were abstract, the majority held that U.S. Patent Nos. 10,394,905 and 10,642,911 had an inventive step, which the judge missed by only analyzing the other pair.

"Whether these claims are directed to an abstract idea presents a much closer question than the claims in the [other two] patents," the precedential [opinion](#) said. "We ultimately conclude that the representative claims of the '905 and '911 patents are directed to an abstract idea, but that, on the pleadings, they satisfy step two of the Alice test."

Circuit Judge Kara Farnandez Stoll, joined by Circuit Judge Jimmie V. Reyna, said U.S. Patent Nos. 10,380,202 and 10,642,910 are about creating location histories that mirror a digital travel log. The '905 and '911 patents, however, cite a specific method used to enhance search results based on location data, the majority said.

"This is more than just the concept of improving a web search using location history — it is a specific implementation of that concept," the opinion said.

Circuit Judge Todd M. Hughes followed up with a dissent rejecting the majority's finding that the '905 and '911 patents feature an added inventive step. He said those patents use "routine and conventional" algorithms and shouldn't have passed step two.

Weisner had sued in April 2020, claiming Google infringes by using physical location histories in its Maps program. Despite multiple amendment attempts, Judge Hellerstein dismissed the suit at the pleadings stage in July 2021, finding the patents fail under Alice.

The Federal Circuit wasn't persuaded by any of Weisner's arguments that the '202 and '910 patents should be revived. In one argument, he said they are eligible because they "only [capture] the travel history of 'members,'" which the judges said has no basis in the second amended complaint or patent.

"According to Mr. Weisner, this improves the 'integrity' of the data and avoids an 'inundation of information making it useless,'" the opinion said. "But these purported technological advantages are nothing more than attorney argument, unlinked to the complaint or the patent claims or specification. Indeed, neither the specification nor the [second amended complaint] addresses this purported technological improvement."

Judge Hughes had expressed frustration during June arguments that Weisner's counsel [relied too heavily on buzzwords](#) to prove their case without adding specifics.

"We appreciate the opinion of the court and are pleased with the outcome," Weisner's attorney, Chip De Preter of [Aronberg Goldgehn Davis & Garmisa](#), said in an email.

Counsel for Google didn't immediately respond to a request for comment Thursday.

Circuit Judges Jimmie V. Reyna, Todd M. Hughes and Kara Farnandez Stoll sat on the panel for the Federal Circuit.

The patents-in-suit are U.S. Patent Nos. 10,380,202; 10,642,910; 10,394,905; and 10,642,911.

Weisner is represented by Matthew "Chip" De Preter of Aronberg Goldgehn Davis & Garmisa and solo practitioner Jacob Ginsburg.

Google is represented by Todd R. Gregorian, Daniel Ledesma, Kevin McGann and Olivia L. Wheeling of [Fenwick & West LLP](#).

The case is Weisner v. Google LLC, case number [21-2228](#), in the [U.S. Court of Appeals for the Federal Circuit](#).

--Additional reporting by Britain Eakin. Editing by Gemma Horowitz.