Justices Told Nearly All Tech Faces Alice Ax Without Changes

By Ryan Davis ·

Law360 (December 3, 2021, 7:33 PM EST) -- The owners of a digital camera patent that was invalidated as an abstract idea in a dispute with Apple and Samsung told the U.S. Supreme Court that unless it steps in, "virtually every machine" using processors faces the same fate under the current state of patent eligibility law.

In a cert petition filed Nov. 29 and docketed Wednesday, inventors Yanbin Yu and Zhongxuan Zhang said the Federal Circuit's June ruling, which found their patent invalid under the high court's Alice v. CLS Bank decision for claiming only the abstract idea of enhancing camera images, threatens patent protection for countless other inventions.

"The issues presented by this case are of exceptional importance. As many have observed, the panel majority decision could be applied to call into question the patent-eligibility of virtually every machine that uses a processor to perform any part of its functionality, regardless of the specificity with which the structural components are defined in the claim," they said.

The Federal Circuit's approach "leaves the ultimate determination on patent-eligibility up to gut instincts" and leads to "unpredictable and absurd results," meaning that patents for everything from toasters to washing machines to cars to robots to Thomas Edison's lightbulb "would be at risk" without intervention from the justices, Yu and Zhang said.

The inventors, engineers in the field of image processing, obtained a patent on a method of employing multiple lenses and sensors to take separate images of the same scene and using them to enhance each other. They said the patent, which they accused Apple and Samsung of infringing, helped early digital cameras rival film cameras in image quality.

A Northern District of California judge and the majority of a split Federal Circuit panel concluded that the patent covers nothing more than the abstract idea of taking two photos

and using one to enhance the other using routine and conventional components, making it ineligible for patenting under Section 101 of the Patent Act.

Yu and Zhang argue that since the Alice ruling in 2014, the Federal Circuit has handed down a "series of increasingly expansive, concerning, and inconsistent" eligibility decisions that threaten patents and led to their own being lost to the "patent shredder on the wrong side of today's unpredictable patent eligibility jurisprudence."

They maintain that the appeals court is divided about which of two decades-old Supreme Court patent eligibility decisions, which have starkly different approaches, remain good law after more recent rulings like Alice.

Yu and Zhang argue that some Federal Circuit panels apply a "far reaching and more patent-antagonistic approach" found in a 1978 Supreme Court patent eligibility decision, rather than guidance from a 1981 high court ruling that they maintain is correct.

The 1981 ruling, known as Diamond v. Diehr, held that the patent eligibility analysis must be based on the claim as a whole, and that "it is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements." Under that approach, "there is no plausible analysis" under which their patent is invalid, Yu and Zhang said, because it is an improved camera with specific lenses arranged in a specific manner, which was not routine and conventional.

The 1978 ruling, known as Parker v. Flook, held that abstract ideas or natural phenomena cannot be patented "unless there is some other inventive concept in its application." Yu and Zhang said that was rejected by Diehr, and involves an inappropriately subjective analysis that attempts to divine what the patent is "really about" by ignoring elements a judge can dismiss as conventional — like camera lenses — even when they are used in a new way.

"Stripped of structure, most descriptions of the improvement or point of novelty of a patent sound abstract," they said.

The Federal Circuit judges themselves have said that they are "bitterly divided" over the correct approach to patent eligibility, with some suggesting that Diehr was overruled in favor of Flook by the more recent Supreme Court eligibility rulings, so the justices must step in, the inventors said.

"Disagreement and uncertainty over [patent eligibility] at the Federal Circuit engenders disruptive uncertainty among scientists, engineers, and their patent lawyers about the extent to which inventions can be protected, and how any individual claim will be assessed if put to a Section 101 challenge," they said. "This court should grant the petition."

Counsel for the parties could not immediately be reached for comment Thursday.

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

Yu is represented by Denise De Mory and Corey Johanningmeier of Bunsow De Mory LLP and Daniel Johnson Jr. and Robert Litts of Dan Johnson Law Group LLP.

Counsel for Apple and Samsung at the Supreme Court was not immediately available. At the Federal Circuit, Apple was represented by Cooley LLP and Samsung was represented by Ropes & Gray LLP.

The case is Yu v. Apple Inc., case number 21-811, in the U.S. Supreme Court.

--Editing by Alanna Weissman.