Yu v. Apple Settles It: The CAFC is Suffering from a Prolonged Version of Alice in Wonderland Syndrome (ipwatchdog.com)

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Print Article

"The syndrome has recently reached an acute stage, which if applied consistently to all similarly situated patents with similarly drafted claims, would result in many hundreds of thousands of clearly tangible inventions that one can actually hold in one's hand being mysteriously declared to be 'abstract.'"

Alice in Wonderland syndrome is a medical condition for which there is no known treatment. It causes a disturbance of perception and has a serious impact on the life of those afflicted, and I suspect on those who surround those afflicted. Of course, those in the patent community who work on software implemented innovations know all of this too well.

Think this is a joke? Sadly, no. *Alice in Wonderland* syndrome is a real thing.

A Disturbance of Perception

According to Wikipedia, *Alice in Wonderland* syndrome is named after the Lewis Carroll character because the distortions of perception and size experienced by Alice are reminiscent of those experienced by individuals afflicted with the syndrome. For those unfamiliar with the connection to patent law, *Alice Corp. v. CLS Bank* is the case of seminal importance where the Supreme Court most recently announced the patent eligibility test for computer implemented innovations, better known as software.

"*Alice in Wonderland* syndrome is a disturbance of perception rather than a specific physiological condition," Wikipedia explains. "[T]hough the symptoms may acutely impact the patient's life while they are present, *Alice in Wonderland* syndrome typically resolves itself within weeks or months." If only that were similarly true in the legal sphere!

Unfortunately, the Federal Circuit seems to be dealing with an exceptionally prolonged and worsening version of *Alice in Wonderland* syndrome. The syndrome has recently reached an acute stage, which if applied consistently to all similarly situated patents with similarly drafted claims, would result in many hundreds of thousands of clearly tangible inventions that one can actually hold in one's hand being mysteriously declared to be "abstract" by the Federal Circuit.

And, as previously mentioned, according to Wikipedia, "[a]t present, *Alice in Wonderland* syndrome has no standardized treatment plan."

'Six Impossible Things Before Breakfast'

In addition to a litany of inventions that have fallen as patent ineligible under the Supreme Court's *Alice-Mayo* framework, the Federal Circuit recently ruled — over a strong dissent by Judge Newman — that a digital camera was both abstract and patent ineligible. Remarkably, the claim in *Yu v. Apple* 2020-1760 (Fed. Cir. June 11, 2021) recited image sensors, lenses that are mounted to the image sensors, a digital image processor and even analog-to-digital converting circuits. How could the claim be abstract? How can a claim that recites circuitry be abstract? Moreover, this claim went the final mile to recite the delivery of a tangible application, namely, the delivery of a resultant digital image.

Yu did not argue that it is well known to use multiple pictures to enhance each other, but rather argued that claim 1 was directed to a patent eligible application, which by its express, literal terms, it is. Nevertheless, Judge Prost (who was joined by Judge Taranto) found that the components used were conventional and there was nothing unique about the claimed configuration of the lenses and sensors.

The only conclusion is that the Federal Circuit judges are experiencing the world as Alice, who was known to have sometimes "believed six impossible things before breakfast."

'Curioser and Curioser'

What is interesting is that, in reaching the patent eligibility determination under 35 U.S.C. 101, Judge Prost reviewed the specification to find that the configuration for which the inventor described uniqueness compared with the prior art was a version of the invention containing 4 lenses and 4 sensors, which she wrote made claim 1 overbroad because it only required 2 lenses and 2 sensors. Such a determination, however, is really a matter properly decided under 35 U.S.C. 112. Indeed, the only way one can truly appreciate the scope of a claim vis-à-vis the specification is to undertake a proper and thorough claim interpretation, which did not happen here, and is, for reasons the Federal Circuit has not explained, not required for a 101 inquiry. A complete and thorough claim interpretation is, however, required for analysis of claims under 35 U.S.C. 102, 103 and 112, because those sections relate to invalidity.

In *Yu*, the district court granted the defendants' motion to dismiss—a motion that is supposed to have all inferences drawn in favor of the non-moving party (i.e., the patent owner). And still, the Federal Circuit stretched to find that while the specification does explain the invention is unique compared to the prior art, the scope of claim 1 is too broad and therefore patent ineligible? Simply stated, this is not a proper 101 analysis, period.

If we must live under the fiction foisted upon us by the Supreme Court that their patent eligibility jurisprudence is perfectly consistent, and specifically, that *Diamond v. Diehr* has not been overruled, then that has to mean the Federal Circuit does not have the authority to ignore the explicit teachings from *Diehr*. And *Diehr* is extremely clear — you cannot collapse the patentability inquiry into a single question under 101, period. In *Diehr*, then Associate Justice Rehnquist wrote that the other sections of the statute must be allowed to do their work, which makes perfect sense, otherwise those sections become superfluous, which violates basic canons of statutory construction.

'We're All Mad Here'

Can’t we all at least agree that when a claimed invention is concrete and tangible enough to, when thrown at your head leave a scar upon impact, it cannot possibly be abstract? Apparently not, because we are told by the Federal Circuit that no amount of tangibility allows a claimed invention to escape the clutches of an abstract idea designation! And they say that with a straight face as if we are supposed to believe it simply because it has been spoken by those wearing black robes. Madness.

Whatever the Supreme Court’s patent eligibility jurisprudence is or means at this point, determining breadth of a claim pursuant to 101 without a proper claim construction is wrong. Making such a determination based on a specification the court itself recognizes as explaining that the invention is unique (i.e., not conventional, not routine, not well established) compared to the prior art shows the very reason for requiring a proper claim construction in the first place. Claims are to be interpreted in light of the specification, not in spite of the specification.

It is a basic tenet of patent law that one cannot understand what a claim covers unless and until the claims, the specification and the prosecution history are all reviewed. A complete claim interpretation can even include expert testimony to explain what someone of skill in the field would understand since the relevant question isn’t whether a judge on the Federal Circuit understands or thinks the scope is too broad, but whether the specification explains the claimed invention to the relevant technical audience.

Perhaps at the end of the day these claims should be found invalid, having been improvidently granted by the U.S. Patent and Trademark Office. But there is no way Judges Prost and Taranto can know that now, based on the obvious cursory review they have given this case, the lack of any claim construction, and the confusion of 101 and 112. It is long past time to stop with the shortcuts and start treating examined and issued patents with the presumption of validity they deserve.