SG Urges Justices To Tackle Patent Eligibility In 2 Cases

By Ryan Davis · Listen to article

Law360 (April 5, 2023, 10:28 PM EDT) -- The solicitor general recommended Wednesday that the U.S. Supreme Court should hear two cases dealing with patent eligibility, saying that hearing both in tandem will bring "much-needed clarification" to the contentious issue.

After being asked by the high court to weigh in on the cases in October, U.S. Solicitor General Elizabeth Prelogar said in a joint brief in both cases that "recent Federal Circuit precedent reflects significant confusion" over when patents are invalid for claiming nothing more than abstract ideas.

"These cases would be suitable vehicles for providing much-needed clarification in this area," which has proven challenging to judges and litigants since the Supreme Court's 2014 Alice v. CLS Bank decision, she wrote.

Notably, the brief maintained that one of the Federal Circuit decisions on appeal wrongly found that the media player patents at issue cover patent-ineligible abstract ideas, but that the appeals court was correct that the luggage lock patents in the second case are invalid as abstract.

While agreeing with the outcome in the lock case, the government said that "by reviewing both cases, the court can illustrate the types of claimed inventions that fall both within and without the scope of the abstract-idea exception." It added that the cases should be briefed and argued separately because they involve "very different inventions."

The brief marks the third time in just over three years that solicitors general in two different administrations have urged the Supreme Court to take on the issue of patent eligibility. Both last year and in 2020, the justices rejected the cases that Prelogar and her predecessor Noel Francisco recommended hearing.

In one of the cases that the government on Wednesday said the high court should take up, the Federal Circuit summarily affirmed a lower court decision siding with accused infringer Polar Electro Oy, and invalidating Interactive Wearables' patents on a media player that provides details like the name of a song while the content is playing.

The court found the patents cover only the abstract idea of "providing information in conjunction with media content" and do not add elements that transform the idea into a patent-eligible application.

The government said that decision was wrong, because a wearable media player is "the kind of 'machine,' that has always been patent-eligible," and that the purported abstract idea identified by the court is simply the function of the device "described at a high level of generality."

"The district court's characterization is akin to saying that a patent for a television is directed to the 'abstract idea' of displaying images and sounds," the brief said. "It is difficult to imagine any technological invention that could not be recharacterized as directed to an abstract idea under that approach."

The government also said that the decision "placed undue emphasis on considerations of novelty, obviousness, and enablement," which the brief emphasized are distinct issues from patent eligibility.

"Applying modified versions of other doctrines in the guise of [an eligibility] analysis unmoors those doctrines from the statutory text and diminishes their analytical rigor," the brief said.

In the second case, in contrast, the solicitor general said the Federal Circuit correctly invalidated inventor David Tropp's patents on a method of letting the Transportation Security Administration unlock and screen luggage.

The appeals court found that the patents, which were asserted against Travel Sentry and other lockmakers, claim only the abstract idea of coordinating luggage inspection by providing locks that the TSA can open with a master key.

The patents do not cover a physical device like the actual lock, but rather a method of

marketing to consumers that the TSA can open the lock without cutting it off, which is a "fundamental economic practice" that cannot be patented, the government said.

"Because Tropp involves an abstract idea but Interactive does not, the two cases taken together provide the court with an opportunity to clarify what kind of inventions fall on each side of the line," the brief said.

The government recommended reformulating the questions presented in the petitions to remove other issues, allowing the justices "to ask simply whether the claimed inventions are ineligible for patent protection."

Anthony Fuga of Holland & Knight LLP, an attorney for Polar Electro, said Wednesday that the government's brief "raises issues related to purported misapplication of the law, which aren't exactly suitable for Supreme Court review."

While the brief expressed concern that the judge's eligibility analysis of the media player patents included other issues like obviousness and enablement, Fuga said the judge's decision acknowledged the distinction between those issues.

He noted that even if the judge had erred, the Supreme Court's rules state that it rarely hears cases over misapplication of a properly stated rule, instead focusing on circuit splits and federal law questions. Fuga pointed out that the Federal Circuit affirmed the lower court with a one-line order, and denied Interactive Wearables' request for en banc review with no dissents.

Counsel for the other parties in both cases could not immediately be reached for comment Wednesday.

The patents at issue in the Interactive Wearables case are U.S. Patent Nos. 9,668,016 and 10,264,311. The patents at issue in the Tropp case are U.S. Patent Nos. 7,021,537 and 7,036,728.

The government is represented by Elizabeth B. Prelogar, Brian M. Boynton, Malcolm L. Stewart, Austin Raynor, Joshua Salzman, Steven Hazel and Ben Lewis of the U.S. Department of Justice and Thomas W. Krause, Farheena Y. Rasheed, Amy J. Nelson, Robert McManus and Robert E. McBride of the U.S. Patent and Trademark Office.

Interactive Wearables is represented by Andrea Pacelli, Michael DeVincenzo and Charles Wizenfeld of King & Wood Mallesons LLP.

Polar Electro is represented by Anthony J. Fuga and John P. Moran of Holland & Knight LLP.

Tropp is represented by Eric A. White and Jamie B. Beaber of Mayer Brown LLP.

Travel Sentry is represented by William L. Prickett, Brian L. Michaelis and Matthew Brekus of Seyfarth Shaw LLP, Peter I. Bernstein of Scully Scott Murphy & Presser PC and Michael E. Schollaert of Baker Donelson Bearman Caldwell & Berkowitz PC.

The cases are Interactive Wearables LLC v. Polar Electro Oy et al., case number 21-1281, and Tropp v. Travel Sentry Inc., case number 22-22, before the U.S. Supreme Court.

--Editing by Emily Kokoll.