

VoIP-Pal Decries '101 Patent Eligibility 'Chaos' To Supreme Court

By [Dani Kass](#)

Law360 (July 1, 2021, 4:38 PM EDT) -- VoIP-Pal is asking the U.S. Supreme Court to step in after the Federal Circuit let its call-routing patents be invalidated, warning that patent eligibility under Section 101 is being mixed up with other patenting requirements and causing "legal chaos."

In a petition docketed Tuesday, VoIP-Pal.com Inc. said the Federal Circuit allowed its patents to be invalidated for not describing how to achieve the claimed invention, but using the part of the Patent Act that describes what type of inventions are patent eligible. This conflation of Sections 101 and 112 is part of a broader pattern of expanding patent eligibility under Section 101, the petition states.

"This disregard for Congress's carefully crafted framework has created legal chaos, destabilized the U.S. patent system, and disincentivized U.S. innovation," the petition states. "The district court opinion in this case invalidating the claims of four patents represents an egregious example of the failure to heed this court's warning."

Section 112 requires a patent to have an adequate written description and be enabled, to make sure that the invention works and that someone with the proper qualifications can recreate it, whereas Section 101 deals with whether an inventive concept can be eligible for a patent, regardless of whether it works. The Supreme Court has set a two-step test for Section 101, looking first at whether a patent is abstract or directed to natural phenomena and, if so, whether there's an added inventive concept.

VoIP-Pal asked the justices to either grant its June 25 petition outright or hold it until the court reaches a decision in [American Axle v. Neapco](#), a similar patent eligibility case that raises Section 112 issues. The high court in May asked the [solicitor general to weigh in](#) on that case — which [split the Federal Circuit 6-6](#) — and the government's response is pending.

In VoIP-Pal's case, it had accused [Amazon](#) and [Apple](#) of infringement, and a California federal court subsequently invalidated the claims under Section 101. VoIP-Pal appealed to the Federal Circuit, and a three-judge panel [affirmed the invalidation](#) in November without issuing an opinion.

VoIP-Pal told the justices that its case "presents an egregious misapplication of the Patent Act's statutory framework." While there may be some overlap between 101 and 112, the company said the court has taken it too far.

"The district court repeatedly injected [Section] 112 issues into its [Section] 101 inquiry despite the fact that [Section] 112 was not at issue in the case," the petition states. "In particular, the district court raised how issues at both steps of this court's two-step framework for determining patent eligibility under [Section] 101 even though this court has never held that either step includes a how requirement."

Pointing to the divisiveness in *American Axle*, VoIP-Pal said "the Federal Circuit is hopelessly deadlocked on these critical issues of patent law," so the justices' input is needed.

Amazon and Apple have until July 29 to respond to VoIP-Pal's petition.

Counsel for VoIP-Pal declined to comment. Representatives for Apple and Amazon didn't immediately respond to requests for comment Wednesday.

The patents-in-suit are U.S. Patent Nos. [9,537,762](#); [9,813,330](#); [9,826,002](#); and [9,948,549](#).

VoIP-Pal is represented by Lewis Emery Hudnell III of [Hudnell Law Group PC](#).

Apple was represented at the Federal Circuit by Mark A. Perry, Brian Buroker and Ryan Iwahashi of [Gibson Dunn & Crutcher LLP](#).

Amazon was represented at the Federal Circuit by Daniel T. Shvodian and Nathan K. Kelley of [Perkins Coie LLP](#).

The case is *VoIP-Pal.com Inc. v. Apple Inc. et al.*, case number [20-1809](#), in the [Supreme Court of the United States](#).

--Editing by Andrew Cohen.