

**17-1704, 1706, 1707, 1708, 1709, 1710**

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

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COHO LICENSING LLC,

*Plaintiff-Appellant,*

v.

GLAM MEDIA INC., NING INC.,

*Defendants,*

AOL, INC., ROVI CORPORATION,

*Defendants-Appellees.*

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Appeals from the United States District Court for the Northern District of California  
in Nos. 4:14-cv-01576-JSW, 4:14-cv-01578-JSW, 4:14-cv-01579-JSW, 4:14-cv-  
02127-JSW, 4:14-cv-02128-JSW, and 4:14-cv-02130-JSW,  
Judge Jeffrey S. White

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**BRIEF OF *AMICI CURIAE*  
PATENT OWNERS AND PRACTITIONERS  
SUPPORTING PLAINTIFF-APPELLANT  
AND REVERSAL**

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## CERTIFICATE OF INTEREST

Counsel for Amici, hereby certifies the following:

1. The full name of every party represented by me is:

See Appendix.

2. The names of the real parties in interest (if the party named in the caption is not the real party in interest) represented by me are:

None.

3. All parent corporations and any publicly held companies that own 10% of more of the stock of the party or amici curiae represented by me are:

None.

4. The names of all law firms and partners or associates that appeared for the party or amicus now represented by us in the trial court or agency or are expected to appear in this Court (and who have not or will not enter an appearance in this case) are:

None.

Dated: June 20, 2017

Respectfully submitted,

/s/ Isaac Rabicoff  
Isaac Rabicoff

**FED. R. APP. P.29(a) and 29(c)(5) STATEMENTS**

Plaintiff-Appellant consented to the filing of this brief. Defendants-Appellees oppose the filing of this brief.

No party's counsel authored this brief in whole or in part; no party or party's counsel contributed money intended to fund preparing or submitting this brief; and no persons—other than amicus curiae—contributed money that was intended to fund preparation of or submission of this brief.

/s/ Isaac Rabicoff  
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## STATEMENT OF IDENTITY AND INTEREST

The *amici curiae* are patent owners and practitioners who closely follow and rely upon developments in patent law and policy. Although *amici* may differ amongst themselves on other aspects of modern patent law and policy, all agree that this Court should carefully examine the issues outlined in the brief relating to the application of the test for eligibility set forth in *Mayo/Alice*. They have no stake in the parties or in the outcome of the case.

The *amici curiae* are listed in the Appendix.

## I. INTRODUCTION AND SUMMARY OF ARGUMENT

More than three years since the Supreme Court’s decision in *Alice*,<sup>1</sup> determining patent-eligible subject matter remains a “difficult exercise” and the “requirements of the *Alice* analysis” are “still difficult-to-discern.”<sup>2</sup> District courts continue to struggle mightily.<sup>3</sup> In spite of the caselaw applying § 101 developed by this Court, one district court has recently noted that “even post-*Enfish*, the *Mayo/Alice* test provides limited practical guidance for distinguishing software and computer patents that are valid under § 101 from those that are not.”<sup>4</sup> This case presents the Court with an opportunity to clarify two areas of confusion among district courts forced to grapple with this “complex and developing area of law.”<sup>5</sup>

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<sup>1</sup> *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S.Ct. 2347 (2014).

<sup>2</sup> *Device Enhancement LLC v. Amazon.com, Inc.*, 189 F.Supp.3d 392, 400 (D. Del. May 17, 2016).

<sup>3</sup> See, e.g., *CG Technology Development, LLV v. Bwin.Party (USA), Inc.*, 2017 WL 58575, at \*2 (D. Nev. Jan. 4, 2017) (“Commentators have noted the lack of clarity in the test for abstractness challenges under § 101.”) (citing authorities); *TNS Media Research LLC v. TIVO Research and Analytics, Inc.*, 2016 WL 6993768, at \*1 (S.D. N.Y. Nov. 29, 2016) (referring to caselaw interpreting *Alice* to date as “somewhat confused” and vacating an earlier ruling on § 101); *Source Search Technologies, LLC v. Kayak Software Corp.*, 111 F.Supp.3d 603, 611 (D.N.J. Jul. 1, 2015) (observing that the § 101 “area remains somewhat muddled”).

<sup>4</sup> *Synchronoss Technologies, Inc. v. Dropbox Inc.*, 2016 WL 7406494, at \*5 (N.D. Cal. Dec. 22, 2016) (citing *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016)).

<sup>5</sup> *Papst Licensing GmbH & Co. KG v. Xilinx Inc.*, 2016 WL 4398376, at \*3 (N.D. Cal. Aug. 18, 2016) (noting that the caselaw on § 101 “developed even during the briefing” in that case).

The first is a procedural<sup>6</sup> issue dividing district courts: whether a court may decide the subject matter eligibility of multiple claims (and multiple patents) on the basis of one or more “representative claims,” and if so, under what circumstances. This issue has spawned several approaches among district courts, which “have interpreted” this Court’s decision in *Content Extraction*—which seems to permit the “representative claim” approach under some circumstances—in “numerous ways.”<sup>7</sup> According to one summary of the increasingly heterogeneous approaches to this issue, “[o]ne line of authority” (1) “allows courts to use representative claims only if the parties have agreed on them in advance,” while another (2) approach “place[s] the burden on the patentee to point out flaws in proposed representative claims.”<sup>8</sup> Still another (3) approach “place[s] the burden on the movant, declining to designate representative claims where the movant has not discussed any non-designated claims in detail,” while a contrasting reading of *Content Extraction* interprets it to (4) allow

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<sup>6</sup> Commentators have specifically called for procedural guidance from this Court relating to eligibility decisions. See Raymond A. Mercado, *Resolving Patent Eligibility and Indefiniteness in Proper Context: Applying Alice and Aristocrat*, 20 Va. J.L. & Tech. 240, 326-27 (2016) (“In light of *Mayo*’s procedural indeterminacy, we need guidance from the Federal Circuit that would specify the proper rules and procedures leading up to, and during, an eligibility determination, perhaps guidance that would establish a special hearing solely directed to eligibility at the appropriate time in a case, akin to the way *Markman* hearings became the established and standardized stage for addressing claim construction—a ‘*Mayo* hearing’ so to speak.”)

<sup>7</sup> *Front Row Technologies, LLC v. NBA Media Ventures, LLC*, 204 F.Supp.3d 1190, 1249-50 (D. N.M. Aug. 30, 2016).

<sup>8</sup> *Id.*

courts “to designate representative claims, even absent the parties’ agreement and in the face of the patentee’s specific objections.”<sup>9</sup>

This brief will argue that the statutory presumption of validity in 35 U.S.C. § 282, read together with 35 U.S.C. § 253 as well as *Alice* itself, forecloses the use of representative claims to decide eligibility, at least where the patentee objects and points to specific non-representative claims. Patent-eligible subject matter “must be analyzed on a claim-by-claim basis...like other grounds of invalidity.” *MeadWestVaco Corp. v. Rexam Beauty and Closures, Inc.*, 731 F.3d 1258, 1264 (Fed. Cir. 2013) (citing *Ortho Pharm. Corp. v. Smith*, 959 F.2d 936, 942 (Fed. Cir. 1992) (concluding that all grounds of invalidity must be evaluated against individual claims, as required by the plain language of 35 U.S.C. § 282)). To do otherwise—particularly here where, unlike *Content Extraction*, the patentee specifically *objected* to the use of a “representative claim” and pointed to specific, non-representative claims—not only “flies in the face of the presumption of validity” but risks invalidating otherwise patent-eligible claims through a cavalier, once-size-fits-all analysis. *Shelcore, Inc v. Durham Industries, Inc.*, 745 F.2d 621, 624 (Fed. Cir. 1984). Such a practice also raises serious due process concerns, as argued *infra*. Neither *Content Extraction* nor this Court’s recent decision in *The Cleveland Clinic Foundation v. True Health Diagnostics LLC*, 2017 WL 2603137, at \*5 (Fed. Cir.

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<sup>9</sup> *Id.*

Jun. 16, 2017) permit the use of representative claims to analyze eligibility where the patentee identifies specific non-representative claims. To the extent that *Content Extraction* and *Cleveland Clinic* can be read to permit such an approach, they may be in conflict with *Shelcore*, which is the earlier and controlling precedent—and with § 282, which is at the foundation of *Shelcore* and this Court’s repeated admonitions that validity is to be decided on a claim-by-claim basis.

Second, this case presents this Court with the opportunity to clarify the role of facts in determining whether claims recite an “inventive concept” or merely “conventional” activity at Step Two of *Alice*. While *Mayo* “recognize[d] that “the § 101 patent-eligibility inquiry and” the “§ 102 novelty inquiry might sometimes overlap,” there is significant confusion among district courts as to when evidence supporting novelty “might” be relevant to the eligibility analysis.<sup>10</sup> For example, district courts are divided on the relevance of post-grant fact-findings to eligibility. Compare *Sophos Inc. v. RPost Holdings, Inc.*, 2016 WL 3149649, at \*12 n. 6 (D. Mass. Jun. 3, 2016) (holding that the PTAB’s finding that patents were “technological inventions” and its denial of CBM review “tends to support [the] conclusion” that the patents were eligible under Step Two of *Alice*), with *Papst*, 2016 WL 3196657, at \*20 n. 11 (refusing to give weight to a PTAB decision declining to

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<sup>10</sup> *Mayo Collaborative Servs. v. Prometheus Laboratories, Inc.*, 132 S.Ct. 1289, 1304 (2012).

institute IPR because “[n]either a Section 101 challenge generally nor the more specific question articulated by the U.S. Supreme Court [at] the second step of the *Alice* framework was before the PTAB”); *Virginia Innovation Sciences Inc. v. Amazon.com, Inc.*, 2017 WL 64147, at \*11 (E.D. Va. Jan. 5, 2017) (“Although there is some caselaw to suggest that obviousness, novelty, and eligibility inquiries overlap, the most recent persuasive opinions conduct the eligibility inquiry in isolation.”). And here, contrary to *Mayo*’s recognition of “overlap,” the district court held that “the question of novelty . . . stands in direct contrast to . . . the question presented before this Court concerning patent eligibility.” Appx10. Moreover, it confused whether Appellant’s evidence was submitted in support of eligibility at Step One, when Appellant in fact submitted this evidence with reference to Step Two and raised sufficient factual questions precluding resolution at the Rule 12 stage. Compare Appx11 (rejecting relevance of evidence to the “question of abstractness” at Step One), with Appx1276-77 (argument by Appellant that evidence from the PTAB and prosecution history was relevant to “conventionality” at Step Two of *Mayo/Alice*, not Step One).

This brief will argue that eligibility is best characterized as a question of law based on underlying determinations of fact and, as such, cannot be resolved based on conclusory findings regarding what is or is not “conventional.” District courts may not substitute their opinion for the perspective of the skilled artisan or decide

“conventionality” without evidence of the state of the art at the time of filing.<sup>11</sup> To ignore that “the concern of hindsight bias has as much relevance to a § 101 challenge as it does a § 103 challenge...would provide a ‘blank check to all those who challenge patents without sufficient legal or evidentiary basis.’”<sup>12</sup> Evidence of novelty during prosecution or post-grant determinations by the PTAB may well support a finding of inventiveness or non-conventionality at *Mayo/Alice* Step Two, as this Court has recognized. *See Rapid Litigation Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016) (evidence of novelty over the prior art during prosecution supported eligibility at *Mayo/Alice* Step Two).

To a great extent, both these issues were settled by this Court’s opinion in *Ultramercial*, which was later vacated by the Supreme Court for further consideration in light of *Alice*. *See Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, (Fed. Cir. 2013), *vacated by WildTangent, Inc. v. Ultramercial, LLC*, 134 S. Ct. 2870 (2014). The opinion in *Ultramercial* made clear that eligibility “must be determined on a claim by claim basis,” that “the analysis under § 101, while ultimately a legal determination, is rife with underlying factual issues,” and that “[a]lmost by

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<sup>11</sup> *See generally* Mercado, *supra* note 6 (arguing that many district courts are deciding whether claims recite “conventional activity” at *Mayo/Alice* step two “in a vacuum—absent prior art evidence and without the understanding of the skilled artisan,” and arguing that *Mayo/Alice* step two requires a more contextual, fact-laden analysis).

<sup>12</sup> *Ameritox, Ltd. v. Millennium Health, LLC*, 88 F.Supp.3d 885, 914 (W.D. Wis. Feb. 19, 2015).

definition, analyzing whether something was ‘conventional’ or routine’ involves analyzing facts.” *Id.* at 1339. None of these things were contradicted by *Alice*. Thus, while this Court read the Supreme Court’s *vacatur* in *Ultramercial* to cast doubt on the *result* in that case, it should not be read to cast doubt on the requirement for claim-by-claim analysis or for the proposition that the “inventive concept” inquiry at Step Two has factual underpinnings. Indeed, this Court has relied on the “relevant and detailed analysis” of its prior opinions where they were vacated “without explanation,” and their reasoning “has been neither supplanted nor questioned.”<sup>13</sup> It should do so with *Ultramercial* here.

Thus, this Court can restore certainty on the issues raised in this case by reiterating the principles stated in *Ultramercial*, which are fully compatible with the test set forth in *Alice*.

## II. ARGUMENT

### A. Subject matter eligibility under Section 101 must be analyzed on a claim-by-claim basis.

#### 1. *The presumption of validity in 35 U.S.C. § 282, read together with 35 U.S.C. § 253, requires a claim-by-claim eligibility analysis.*

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<sup>13</sup> *Tegal Corp. v. Tokyo Electron America, Inc.*, 257 F.3d 1331, 1340 (Fed. Cir. 2001) (relying on reasoning of *In re Lockwood*, 50 F.3d 966 (Fed. Cir. 1995), *vacated*, 515 U.S. 1182 (1995)).



It is black letter law that “validity analyses must be performed on a claim-by-claim basis.” *Amazon.com, Inc. v. BarnesandNoble, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001); *see also Ortho Pharm. Corp. v. Smith*, 959 F.2d 935, 942 (Fed. Cir. 1992) (“validity of each claim must be evaluated individually as provided in 35 U.S.C. § 282”); *cf. Jones v. Hardy*, 727 F.2d 1524, 1528 (Fed. Cir. 1984) (“each claim must be considered as defining a separate invention”) (citing § 282). This principle is rooted not only in the statutory presumption of validity, but in long-standing Supreme Court precedent. *See, e.g., Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477, 487 (1935) (reversing court of appeals because it “made no examination of [the patent’s] separate claims” and noting that “each claim must stand or fall, as itself sufficiently defining invention, independently of the others”); *Honeywell Intern. Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131, 1149 (Fed. Cir. 2004) (“a dependent claim is independently valid”) (citing with approval *Altoona*, 294 U.S. at 487).

Here, the court below invalidated the claims of three patents based on a single “representative claim” objected to by the patentee. Rather than perform a claim-by-claim analysis of eligibility, the court made a “find[ing]” in a footnote that “the other claims of the patents-in-suit recite the same abstract idea” as the “representative claim.” Appx7 at n. 2. Like the one-paragraph claim construction found “inadequate” by this Court in *Nazomi*, the district court’s footnote here addressing

the eligibility of *three* patents based on scant analysis of a single purportedly representative claim, objected to by the patentee below, is woefully insufficient. *See Nazomi Communications, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364 (Fed. Cir. 2005) (vacating and remanding order containing one-paragraph of claim construction analysis “for a detailed analysis of the disputed claim construction”). Moreover, the district court never made separate findings about the non-representative claims at *Alice* Step Two, but referred later in its opinion to “the patents” and “the claims” generally. Appx9.

This procedure was expressly rejected by this Court in *Shelcore*, where a district court subjected dependent claims to the same validity analysis as an independent claim because they were not argued separately by the patentee. *See Shelcore, Inc v. Durham Industries, Inc.*, 745 F.2d 621, 624 (Fed. Cir. 1984). As this Court held, the “rule applied by the trial court flies in the face of the presumption of validity,” and “has no application in a district court proceeding to determine whether the claims of an issued patent are valid.” *Id.* Similarly, in *Ortho*, this Court rejected a “unitary treatment of the claims,” observing the statutory statement in 35 U.S.C. § 253 that “[w]henver, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid.” *Ortho*, 959 F.2d at 942 (quoting § 253). And in *MeadWestVaco*, in which this Court reiterated yet again that “[o]bviousness, like other grounds of invalidity must be analyzed on

a claim-by-claim basis,” the Court found the “central problem with the district court’s analysis is that it fails to treat claims 15 and 19, which are not limited to fragrance products, differently from the asserted fragrance-specific claims.” *Id.* at 1264.

Here, the district court likewise failed to analyze eligibility on a claim-by-claim basis. The court’s bare statement that it “finds that the other claims of the patents-in-suit recite the same abstract concept” as the “representative claim” is not sufficient to comport with the imperatives of §§ 282 and 253. Appx7 at n. 2. Merely stating a “finding” does not constitute analysis of why the specific limitations of the non-representative claims are directed to “the same abstract concept.” “Both this Circuit and the Ninth Circuit repeatedly have made clear that a trial court must at least provide its analysis and grounds for entering judgment somewhere in the record.” *OSRAM Sylvania, Inc. v. American Induction Technologies, Inc.*, 701 F.3d 698, 707 (Fed. Cir. 2012). To the extent that the district court’s perfunctory “find[ing]” constitutes an analysis at all, it is insufficient for review by this Court, which should at a minimum vacate and remand for a proper claim-by-claim eligibility analysis. *See Nazomi*, 403 F.3d at 1368-73 (Fed. Cir. 2005) (discussing the “shortcomings” of the district court’s one paragraph of claim construction “analysis,” and remanding “for a detailed analysis”).

While it is true that Fed. R. Civ. P. 52(a) does not itself require a court to “state findings or conclusions when ruling on a motion under Rule 12,” §§ 282 and 253, as interpreted by this Court in *Shelcore* and other cases, do require the district court to state its conclusions on validity through a claim-by-claim analysis. Since §§ 282 and 253 are specific statutes pertaining to the determination of patent validity, they control over Fed. R. Civ. P. 52(a). *See Vimar Seguros Y Reaseguros, S.A. v. M/V Sky Reefer*, 29 F.3d 727 (1<sup>st</sup> Cir. 1994) (“where two statutes conflict, regardless of the priority of enactment, the specific statute ordinarily controls the general”) (citations omitted). And, as both this Court and the Ninth Circuit have made clear, while recognizing Fed. R. Civ. P. 52(a), “a trial court must at least provide its analysis and grounds for entering judgment somewhere in the record,” *OSRAM*, 701 F.3d at 707.

**2. *At a minimum, Cleveland Clinic, Content Extraction and Shelcore do not permit district courts to use the “representative claim” approach over the patentee’s objection when the patentee identifies specific non-representative claims.***

- a. *Content Extraction permits the “representative claim” approach only where the patentee does not object or identify specific non-representative claims.*

Here the district court, like others attempting to justify the use of a “representative claim” approach to eligibility analysis, cited this Court’s decision in *Content Extraction*. Appx7 at n.2 (citing *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014)). While the

district court's opinion here did not explicitly reason through the propriety of deciding eligibility over the patentee's objection—another sign of its superficiality—the court in *Front Row* has attempted to do so. *See Front Row*, 204 F.Supp.3d at 1250 (“This Court concludes, however, that *Content Extraction* permits it to designate representative claims, even absent the parties' agreement and in the fact of the patentee's specific objections.”).

*Front Row's* interpretation, however, is incorrect. *Content Extraction* expressly distinguished itself from circumstances in which the patentee objected to the use of a representative claim. *See Content Extraction*, 776 F.3d at 1348 (“CET never asserted in its opposition to PNC's motion that the district court should have differentiated any claim from those identified as representative by PNC.”). *Front Row* nonetheless reads *Content Extraction* to suggest the fact that the Federal Circuit “independently reviewed all the claims” serves as a license for district courts to designate representative claims over the objection of the patentee. *Front Row*, 204 F.Supp.3d at 1250. But *Content Extraction* does not suggest that a district court's failure to perform a claim-by-claim analysis could be cured, in all circumstances, by appellate review. Rather, this Court merely emphasized its independent review in a context where the patentee failed to raise specific objections below but raised them on appeal. At most, *Content Extraction* stands for the proposition that a “representative claim” approach is permissible where the patentee does not object to

it and does not identify specific non-representative claims. *Front Row's* expansive reading of that opinion (and the approach used by the district court here, without analysis) must be curtailed. This Court's recent decision in *Cleveland Clinic*, while seeming to echo a similarly broad reading of *Content Extraction*, was not dealing with the factual situation here. In *Cleveland*, the patentee had made only a blanket objection to the use of representative claims in general, without identifying specific non-representative claims for the district court or any basis for a claim-by-claim eligibility analysis. See *Cleveland Clinic*, 2017 WL 2603137, at \*4 ("Cleveland Clinic objected to treating any claims as representative of others"). As the Appellee pointed out in *Cleveland Clinic*, the patentee had "made only a passing objection to treating those claims as representative claims" and did not identify specific non-representative claims.<sup>14</sup> Therefore, any language from *Cleveland Clinic* implying (with *Front Row*) that courts may use a representative claim approach despite the patentee's identification of specific non-representative claims is mere dicta, since the *Cleveland Clinic* Court was not faced with those facts.

In support of its misreading of *Content Extraction*, *Front Row* raises the policy concern that "a ban on selecting representative claims [for eligibility analysis] absent the patentee's agreement would effectively grant the patentee a veto over § 101 determinations," and "effectively guarantee[] a claim construction hearing and its

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<sup>14</sup> Brief for Appellee, No. 2016-1766 (Fed. Cir. Oct. 24, 2016), at 47.

associated costs to put it in a better settlement position.” *Id.* at 1251. But such a rule will not vest “veto” power in the patentee, or defer the issue of eligibility until a later stage of litigation. If the patentee’s objections to representative claims are properly considered, the result will simply be fewer “blanket” § 101 decisions. Eligibility determinations would not necessarily be deferred, but they may be more narrowly crafted (and more carefully reasoned), limited to the claims the movant contends are “representative” in the first place. Moreover, nothing prevents district courts from denying motions without prejudice as to non-representative claims, so that litigants may renew their challenges against non-representative claims with the guidance of the district court’s views on an initial § 101 determination. All this is in accord with basic notions of due process and fairness to the patentee, as discussed below.

Even if *Front Row* were correct that this rule would give patentees some measure of “veto” power over blanket § 101 determinations, that is merely consistent with the rule that, in ruling on a motion to dismiss or motion for judgment on the pleadings, a court must draw “all inferences in the light most favorable to the non-moving party.” *Baker v. Riverside County Office of Educ.*, 584 F.3d 821, 824 (9<sup>th</sup> Cir. 2009). In contexts outside § 101, is not unusual that a non-movant is able to raise factual or other disputes sufficient to preclude resolution at the Rule 12 stage—which is partly why the trend of deciding eligibility in so many cases in the Rule 12

posture has been so unexpected, and troubling. *Cf. Ultramercial*, 722 F.3d at 1338-39 (“it will be rare that a patent infringement suit can be dismissed at the pleading stage for lack of patentable subject matter...Rule 12[] dismissal for lack of eligible subject matter will be the exception, not the rule.”), *vacated by WildTangent*, 134 S. Ct. 2870; *Verint Systems Inc. v. Red Box Recorders Ltd.*, 2016 WL 7156768, at \*1 (S.D.N.Y. Dec. 7, 2016) (“the current fad of ineligibility motions has...gotten ahead of itself,” and “courts should make such determinations on a proper record”). Given the effect of §§ 282 and 253, courts ruling on motions at the Rule 12 stage should generally infer that claims are not so duplicative that a claim-by-claim analysis may be avoided.

*b. Shelcore requires a claim-by-claim analysis and, to the extent it may be read to conflict with Cleveland Clinic and Content Extraction, is controlling authority.*

As indicated *supra*, *Shelcore* requires a claim-by-claim analysis under § 282, rejecting the notion that “dependent claims stand or fall with the independent claim” because it “flies in the face of the presumption of validity.” *Shelcore*, 745 F.2d at 624. Thus, the district court’s decision here to invalidate the dependent claims (as well as the other independent claims) of three patents based on analysis of a single “representative” claim objected to the patentee contravenes *Shelcore* and must be reversed.



*Front Row* attempted to distinguish *Shelcore* on the ground that its “requirement” for a claim-by-claim analysis is only “applicable ‘at trial,’” and any departure from the claim-by-claim approach “requires either a ‘pretrial agreement or stipulation.’” *Front Row*, 204 F.Supp.3d at 1251 (citing *Shelcore*, 745 F.2d at 625). But *Shelcore* rests on the statutory presumption of validity, § 282, not any rule of procedure specific to trial. Moreover, it makes no distinction between a validity determination at the early posture of this case or at trial; *Shelcore* refers to a “district court proceeding,” not to a particular stage of that proceeding. *Id.* at 624-25 (noting that the district court’s departure from claim-by-claim analysis “has no application in a district court **proceeding** to determine whether the claims of an issued patent are valid,” citing § 282) (emphasis added). Indeed, *Shelcore*’s claim-by-claim approach is even more applicable here, on a Rule 12(c) motion on validity, since the district court was required to “draw all inferences in the light most favorable to the non-moving party.” *Baker*, 584 F.3d at 824.

This Court should determine whether *Shelcore* stands for a **per se** rule requiring claim-by-claim validity analysis. Whereas a careful reading of *Content Extraction* and *Cleveland Clinic* seems to permit a representative claim approach where the patentee fails to object or identify specific non-representative claims, *Shelcore* specifically held that “[i]t was not [the patentee’s] burden to argue patentability” and required a claim-by-claim analysis even where the patentee “has

not argued the patentability of the dependent claims separately from the independent claim.” *Id.* at 624. Therefore, *Content Extraction* and *Cleveland Clinic* may well be in conflict with *Shelcore* on this point.<sup>15</sup> To extent that they are in conflict, *Shelcore* is the earlier precedent and controls here, unless and until this Court resolves the conflict *en banc*. See *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988) (“Where there is direct conflict, the precedential decision is the first.”). This panel may therefore opt for a broader reading of *Shelcore* as standing for a per se rule requiring claim-by-claim analysis, or may reconcile *Shelcore* with *Content Extraction* and *Cleveland Clinic* by requiring that patentees objecting to representative claim approach to eligibility analysis identify specific non-representative claims.

In any event, this panel should reverse the district court and reaffirm the vitality of *Shelcore*, or vacate and remand for a claim-by-claim analysis under *Shelcore* and § 282.

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<sup>15</sup> Notably, the opinion in *Content Extraction* made no attempt to distinguish *Shelcore*, even though that case was specifically argued in the briefing. See Brief for Appellant, Nos. 2013-1588, 2013-1589, 2014-1112, 2014-1687 (Fed. Cir. Jan. 22, 2014), 2014 WL 407719, at \*20 (citing *Shelcore*, *inter alia*). The *Cleveland Clinic* briefing was completely devoid of any discussion of *Shelcore* or § 282, as was the opinion.

**3. The district court’s “representative claim” approach raises serious due process concerns.**

In prior cases, this Court has recognized that a serious due process problem could arise if a patentee were limited to “representative” claims. *See Nuance Commc’n, Inc. v. ABBYY USA Software House, Inc.*, 813 F.3d 1368, 1376 (Fed. Cir. 2016); *In re Katz Interactive Call Processing Patent Litigation*, 639 F.3d 1303, 1311-13, 1313 n.9 (Fed. Cir. 2011). However, unlike *Nuance* and *Katz*, where patentees were merely limited in the number of claims they were allowed to present in an infringement suit, this case involves an erroneous deprivation of Appellant’s property rights in three patents on the basis of a single “representative” claim, in the face of Appellant’s objections below.

In *Mathews v. Eldridge*, 424 U.S. 319, 335 (1976), the Supreme Court set forth three factors involved in due process analysis:

First, the private interest that will be affected by the official action; second, the risk of an erroneous deprivation of such interest through the procedures used, and the probable value, if any, of additional or substitute procedural safeguards; and finally, the Government’s interest . . . and the fiscal and administrative burdens that the additional or substitute procedural requirement would entail.

Here, as the first *Mathews* factor, the private interest affected by the district court’s failure to conduct a claim-by-claim eligibility analysis is clear: the separate property rights inhering in each of Appellant’s claims. *See, e.g., Cedars-Sinai Medical Center v. Watkins*, 11 F.3d 1573, 1582 (Fed. Cir. 1993) (patents are

“property rights of which the patentee cannot be deprived without due process of law”) (quotation omitted); *Jones*, 727 F.2d at 1528 (“each claim must be considered as defining a separate invention”) (citing § 282).

As to the second *Mathews* factor, the risk of an erroneous deprivation of these property rights through failure to conduct a claim-by-claim analysis is very significant. The “representative claim” approach endorsed by *Front Row* and used by the court in this case permits district courts to abdicate their responsibility to “consider the elements of **each claim**” as the Supreme Court mandated in *Alice*, 134 S. Ct. at 2347 (emphasis added), and as § 282 requires. Because such a procedure focuses the court’s attention on purportedly “representative” claims to the exclusion of other claims, it risks reviving the “‘heart of the invention’ analysis for patentability,” which was abrogated long ago. *See CLS Bank Int’l v. Alice Corp.*, 717 F.3d 1269, 1315 (Moore, Rader, Linn & O’Malley, JJ., dissenting-in-part); *see also Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 345 (1961) (“there is no legally recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention in a combination patent.”). Indeed, the district court here felt free to refer to “the patents” and “the claims” at an extremely general level, on the basis of a single representative claim. Appx9. *See McRo, Inc. v. Bandai Namco Games America Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016) (“We have previously cautioned that courts must be careful to avoid oversimplifying the claims by looking at them

generally and failing to account for the specific requirements of the claims.”) (quotations omitted).

Finally, the third factor weighs in favor of reversing the district court’s approach as well, since the burden of conducting a claim-by-claim analysis is minimal, especially in this case which involves far fewer patents and claims than *Nuance* and *Katz*. Indeed, if conducting an eligibility analysis of the excluded claims on this record proves to be a complex task, that is one reason why deciding the issue at this stage of litigation, on a Rule 12(c) motion, was premature, and should be reversed or vacated and remanded for a proper claim-by-claim analysis, in light of a fuller factual record.

For these reasons, the district court’s designation of a single “representative” claim over the patentee’s objection was improper. This Court should reverse, or vacate and remand for a claim-by-claim analysis of the non-representative claims.

**B. Step two of *Mayo/Alice* has factual underpinnings and evidence of novelty from the prosecution history and post-grant fact-finding by the PTAB may support eligibility.**

1. *Here the district court, like other district courts, improperly substituted its own perspective for that of the skilled artisan, and rendered a conclusory determination of “conventionality” at Mayo/Alice step two, unsupported by any evidence.*

As this Court’s prior opinion in *Ultramercial* made clear, “[a]lmost by definition, analyzing whether something was ‘conventional’ or routine” under *Mayo* “involves analyzing facts.” *Id.* at 1339, *vacated by WildTangent, Inc. v.*

*Ultramercial, LLC*, 134 S. Ct. 2870 (2014). Some district courts properly recognize the need to support their Step Two determinations with facts. For example, one court, urged by movants to find a patent directed to “conventional” activity on a scant record and on the basis of “unsupported assertions,” sensibly asked: “how, on this record, would the Court be in a position to conclusively determine” whether the claim involved merely “conventional activities?”<sup>16</sup> And another court, warning of the potential for “hindsight bias” regarding the conventionality of an invention analyzed at *Mayo/Alice* Step Two, noted that if a party wishes a court “to infer that the combination of elements is conventional, [that party] must supply some evidence to convince the trier of fact to accept its version of events.”<sup>17</sup> “To ignore this concern,” the court went on, “would provide a ‘blank check’ to all those who challenge patents without sufficient legal or evidentiary basis.”<sup>18</sup> In the absence of sufficient facts, therefore, some district courts are properly denying § 101 motions as premature.<sup>19</sup>

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<sup>16</sup> *Kaavo Inc. v. Amazon.com Inc.*, 2016 WL 6562038, at \*11 (D. Del. Nov. 3, 2016).

<sup>17</sup> *Ameritox*, 88 F.Supp.3d at 914.

<sup>18</sup> *Id.*

<sup>19</sup> See, e.g., *Kaavo*, 2016 WL 6562038, at \*13-14; *Cave Consulting Grp., Inc. v. Truven Health Analytics Inc.*, 2016 WL 283478, at \*3 (N.D. Cal. Jan. 25, 2016) (denying motion for judgment on the pleadings under § 101 until there is a “fuller factual record”).

Unfortunately, as commentators have noted, many district courts are “kick[ing] the hypothetical person of ordinary skill in the art to the curb in favor of a discretionary analysis that need not be constrained by the need to establish qualifying prior art evidence” of conventionality, and rendering decisions on *Alice* Step Two with “virtually nothing to guide and focus the judicial imagination.”<sup>20</sup> As a result, many district courts are “improperly resolving these cases in a vacuum, substituting their own perspective for that of the skilled artisan and ignoring critical fact issues.”<sup>21</sup>

Here, the district court made the conclusory finding that all the claims of Appellant’s patents involved “rely on generic hardware components to perform conventional activities commonly understood.” Appx9. In support of that statement, it cited no evidence—even from the specification—and specifically disregarded evidence from the prosecution history and a post-grant determination by the PTAB. Appx10-11. This was improper.

To begin with, “[j]udges are not constitutionally empowered to legislate their individual subjective views respecting degrees of inventiveness, a distinct approach from that of determining validity on the basis of the evidence and procedural rules.” *Jones*, at 1530. This applies as much to the “inventive concept” inquiry of

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<sup>20</sup> Timothy R. Holbrook & Mark D. Janis, *Patent-Eligible Processes: An Audience Perspective*, 17 Vand. J. Ent. & Tech. L. 349, 362-363, 382 (2015)

<sup>21</sup> Mercado, *supra* note 6, at 250.

*Mayo/Alice* Step Two as to the obviousness context, because both eligibility and obviousness are questions of law that rest on subsidiary fact determinations. *See Ultramercial*, 722 F.3d at 1339 (“the analysis under § 101, while ultimately a legal determination, is rife with underlying factual issues.”), *vacated by WildTangent, Inc.*, 134 S. Ct. 2870; *Ameritox*, 88 F.Supp.3d at 914 (comparing eligibility to obviousness and noting the need for sufficient evidence, because “the concern of hindsight bias has as much relevance to a § 101 challenge as it does to a § 103 challenge”).<sup>22</sup> One district court has rightly emphasized that since “it is the state of the art that provides the objective baseline for the analysis” elsewhere in patent law, “Section 101 should be no exception.”<sup>23</sup> *Ameritox*, 88 F.Supp.3d at 915.

2. *The district court confused whether appellant’s evidence was relevant to step one of Mayo/Alice, when appellant specifically argued this evidence was relevant to step two (not step one).*

Here, given that *Mayo* has emphasized the potential for “overlap” of Step Two with issues of novelty, the district court erred in disregarding evidence of novelty as somehow irrelevant to the eligibility analysis. In part, this may be due to the district court’s confusion over whether the evidence relating to novelty is relevant to Step One or Step Two of the § 101 analysis. The district court mistakenly held that

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<sup>22</sup> *See Mercado, supra* note 6, at 331 (“[e]ligibility, as currently formulated under *Mayo*, more closely resembles an obviousness determination—though ultimately a question of law, it is ‘based on underlying determinations of fact,’ most notably relating to the ‘conventionality’ of the claims at *Mayo/Alice* Step Two.”).

<sup>23</sup> *See id.* at 331-32 (discussing *Ameritox*).



Appellant’s evidence did “not address or resolve the question of abstractness” at Step One, when in fact Appellant specifically submitted that evidence in support of the analysis at **Step Two**. Appx11; see also Appx1276-77 (appellant argued evidence from the PTAB and prosecution history with reference to “conventionality” at Step Two of *Mayo/Alice*, **not** Step One).

Because the district court misunderstood the relevance of Appellant’s factual evidence, this Court should reverse, or at a minimum should vacate and remand for consideration of this evidence at Step Two of *Mayo/Alice*.

3. *Evidence from the prosecution history and PTAB is relevant to Step Two of Mayo/Alice.*

While it is certainly true that evidence of novelty over specific prior art references does not per se establish “inventiveness” or non-conventionality at *Mayo/Alice* step two, in many cases it can. And this Court has specifically relied upon an examiner’s finding of novelty during prosecution in holding a patent eligible, noting that “repeating a step that the art taught should be performed only once can hardly be considered routine or conventional.” *Rapid Litigation Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1047 (Fed. Cir. 2016). Clearly, evidence of novelty can sometimes demonstrate inventiveness at Step Two. But here, the district court failed to distinguish *Rapid* and simply asserted that “repeat[ing]” steps does not render the patents inventive, giving a “*but see*” citation to *Rapid*. Appx10. This was error.

To determine whether “repeat[ing]” steps is inventive and non-conventional when compared to the prior art would require the district court to be “well versed in the state of the art at the time of the invention.”<sup>24</sup> (Moreover, Appellant disputes the characterization of the claims as merely “repeating” steps from the prior art, and points out that the claims rely on an “unconventional architecture allowing independent localized control over subtask portion allocation,” Opening Br. 11-12). Read in the broader context of the prior art, evidence from the prosecution history and the PTAB submitted by Appellant below could very well support eligibility. However, this would likely require a more developed factual record than was present before the district court at the Rule 12 stage. Appellant has raised a sufficient factual dispute to preclude resolution of *Mayo/Alice* Step Two in this posture.

Indeed, demonstrating conventionality at step two of *Mayo/Alice* should be more difficult to establish than anticipation or obviousness. Whereas only one reference is required to demonstrate anticipation (or a combination of references to show obviousness), for a patent is ineligible at *Mayo/Alice* Step Two, the claimed invention must be shown to have been not only known but **well-known** throughout the art. That is what “well-understood, routine, conventional activity” is. *Mayo*, 132 S.Ct. at 1298. This is a **higher** threshold to meet than a mere showing of anticipation or obviousness. As Judge Dyk recently suggested at oral argument,

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<sup>24</sup> *Ameritox*, 88 F.Supp.3d at 915.

whereas when “you’re dealing with anticipation and obviousness, you may be dealing with a single reference or two references, [by contrast] the theory of *Alice* is that something is well-known, a well-known concept, which isn’t shown by finding a single reference.”<sup>25</sup> Indeed, one scholar has suggested that a finding of “conventionality” at Step Two may require additional evidence showing not only that an invention is well-known in the art but that it is widely **practiced**.<sup>26</sup> Hence, testimonial evidence may often be required to show “well-understood, routine, conventional activity.” *Mayo*, 132 S.Ct. at 1298.

This Court should clarify the higher thresholding for *Mayo/Alice* Step Two and the requirement for supporting factual evidence. Accordingly, it should reverse, or at a minimum vacate and remand for further consideration of *Mayo/Alice* of the factual evidence submitted by Appellant.

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<sup>25</sup> See *TLI Communications LLC v. AV Automotive, L.L.C.*, No. 15-1372, Oral Arg. Recording at 21:23-22:24 (Fed. Cir. Apr. 7, 2016) (Dyk, J.).

<sup>26</sup> See Jacob S. Sherkow, *And How: Mayo v. Prometheus and the Method of Invention*, 122 Yale L.J. Online 351, 356-57 (2013) (pointing out the ‘[r]outine and ‘convention’ are issues of practice, not necessarily publication,” and suggesting that “prior art seems ill-equipped to prove ‘routine’ or ‘convention’” and that these issues may “often be better left to witnesses than documentary testimony.”).

### III. CONCLUSION

In light of the foregoing, *amici* urge this Court reverse the judgment of the district court or, alternatively, to vacate and remand for a claim-by-claim analysis of eligibility and full consideration of the factual evidence submitted by Appellant.

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Respectfully submitted,

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# **APPENDIX**

**APPENDIX*****Amici Curiae Patent Owners and Practitioners***

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## CERTIFICATE OF SERVICE

I hereby certify that on June 20, 2017, I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system.

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I further certify that, upon acceptance and request from the Court, the required paper copies of the foregoing will be shipped via overnight delivery to the Clerk, United States Court of Appeals for the Federal Circuit, 717 Madison Place, N.W., Washington, D.C. 20439.

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## CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rules of Appellate Procedure 28.1(e)(3), 29(a)(5) and 32(a)(7)(C), the undersigned hereby certifies that this brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 28.1(e)(2)(B)(i) and 29(a)(5).

1. This brief complies with the type-volume limitation of Fed. R. App. P. 29(a)(5) and 32(a)(7)(B) and Federal Circuit Rule 32(b) because this brief contains 6,423 words, excluding the parts of the brief exempted by Federal Circuit Rule 32(b)(1)-(3).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in 14-point Times New Roman Font.

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