

No. \_\_\_\_\_

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United States Court of Appeals  
for the Federal Circuit

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HEALTHEQUITY, INC.,  
*Defendant-Petitioner,*

v.

ALEXSAM, INC.,  
*Plaintiff-Respondent.*

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On Petition for Permission to Appeal an Order of  
The United States District Court for the District of Utah in  
Case No. 2:19-cv-00445, Judge Howard C. Nielson, Jr.

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**HEALTHEQUITY, INC.'S PETITION FOR  
ALLOWANCE OF AN INTERLOCUTORY APPEAL**

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August 17, 2020

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

**CERTIFICATE OF INTEREST**

**Case Number** \_\_\_\_\_

**Short Case Caption** HealthEquity, Inc. v Alexsam, Inc.

**Filing Party/Entity** Defendant-Petitioner HealthEquity, Inc.

**Instructions:** Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

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Date: 08/17/2020

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Name: Ricardo J. Bonilla

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| <p>HealthEquity, Inc.</p>  |   | <p>Blackrock Inc.</p>   |
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Additional pages attached

**4. Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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None/Not Applicable                       Additional pages attached

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## PRELIMINARY STATEMENT

Immediate appeal of the lower court's denial of HealthEquity's motion to dismiss is necessary because this Court's resolution of the issue certified for appeal will clarify controlling law and may materially advance the termination of litigations spanning four federal jurisdictions in different states and involving over half-a-dozen parties.

Using the existing banking network to access multiple databases, including those containing non-banking information, is an abstract idea ineligible for patenting, and the application of that idea with generic, conventional components does not constitute an inventive concept sufficient to confer eligibility. Federal courts, including this Court, have issued opinions applying eligibility principles to similar claims and finding or holding them to be ineligible. For example, in *Smart Systems Innovations, LLC v. Chicago Transit Authority*, this Court held that claims that used cards on the existing banking network to access information related to mass transit users were directed to abstract ideas and therefore ineligible. And, in *BSG Tech LLC v. Buyseasons, Inc.*, the Court explicitly reiterated what has been true since *Alice*: the use of an abstract idea cannot provide an inventive concept under step two of *Alice*.

The claims at issue in this case are directed to this abstract idea, and yet, the lower court denied HealthEquity's motion to dismiss. It reached this incorrect decision because it credited AlexSam's allegation that its claims' combination of conventional components was novel. Even if this allegation were true, as must be presumed at the Rule 12 stage, it is irrelevant to the § 101 analysis. The district court's opinion is thus contrary to Supreme Court and Federal Circuit precedent.

It would also foreclose an inexpensive avenue for disposing of plainly ineligible patents prior to commencement of costly discovery. Any patentee could avoid dismissal under Rule 12 with an artful, conclusory pleading of novelty. The district court itself recognized that its decision may be incorrect and that it may impact other pending cases, and it therefore *sua sponte* certified its opinion for interlocutory appeal. Absent immediate reversal of this erroneous decision, multiple parties and courts will waste resources litigating over invalid patent claims. Accordingly, HealthEquity's petition should be granted.

### **QUESTIONS PRESENTED AND RELIEF SOUGHT**

The district court *sua sponte* certified its order denying HealthEquity's motion to dismiss. HealthEquity respectfully requests permission to appeal

the district court's certified order because AlexSam's patent claims are directed to ineligible subject matter under 35 U.S.C. § 101. This decision rests on a controlling issue of law:

- (1) At the Rule 12 stage, is a patentee plaintiff's allegation that its claims' combination of conventional elements was novel at the time of the invention a factual allegation that precludes dismissal under 35 U.S.C. § 101, contrary to the Supreme Court's holding in *Diamond v. Diehr*?<sup>1</sup>

## **FACTUAL BACKGROUND**

Plaintiff-Respondent AlexSam, Inc. accuses Defendant-Petitioner HealthEquity, Inc. of infringing Claims 32 and 33 of the U.S. Patent No. 6,000,608. Appx34-91.

### **A. THE PATENT-IN-SUIT**

The '608 Patent, entitled "Multifunction Card System," was filed on July 10, 1997, and issued on December 14, 1999. Appx19. It "relates generally to debit card systems, both bank-issued and non-bank-issued, and more particularly to a multifunction card system that can be accessed by a variety of standard point-of-sale devices, by phone by fax, or over the Internet."

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<sup>1</sup> "The 'novelty' of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter." *Diamond v. Diehr*, 450 U.S. 175, 188-89 (1981).

Appx22 at 1:3-8. According to the patent, prior art debit card systems were “extremely useful and provide[d] convenience for bank depositors, [but] they generally [did] not serve a plurality of functions.” *Id.* at 1:24-26. Accordingly, there was “a need in the art for a debit/credit card capable of performing a plurality of functions, such as an electronic gift certificate card, a prepaid phone card, and a loyalty card, all in a real-time secure environment.” *Id.* at 1:26-30.

The patentee purported to fill this need by describing “a card system which can serve a number of functions, thus allowing the consumer to have one card which may act as their card for financial transactions, long-distance telephone calls, loyalty information, and medical information.” Appx23 at 3:2-6. The claims at issue here, claims 32 and 33, are specifically directed to a card system that would allow a user to use one card and access one database when the card is used as a debit card or to access another database when used as a medical card. *See* Appx29 at cl. 32, 33. The system includes the card, a transaction processor, and a processing hub, all used to allow an “unmodified existing standard point-of-sale device” to process the card according to its intended function at the point of processing, as recited in Claim 32:

32. A multifunction card system comprising:

- a. at least one debit/medical services card having a unique identification number encoded on it comprising a bank identification number approved by the American Banking Association for use in a banking network;
- b. a transaction processor receiving card data from an unmodified existing standard point-of-sale device, said card data including a unique identification number;
- c. a processing hub receiving directly or indirectly said card data from said transaction processor; and
- d. said processing hub accessing a first database when the card functions as a debit card and said processing hub accessing a second database when the card functions as a medical card.

*Id.* at cl. 32. Claim 33 adds that “the unique identification number further comprises a medical identification number.” *Id.* at cl. 33.

The claimed components—debit/credit card, transaction processor, point-of-sale device, processing hub, databases—are all generic and claimed for their conventional purposes. The debit/credit card is used conventionally: to access a debit/credit account over the existing banking network. *See id.* at cl. 32 (tying the debit/credit card to the existing banking network via BIN); *see also* Appx22 at 1:11-21 (explaining the conventional use of debit/credit cards). The transaction processor is used conventionally: to process data. *See id.* at cl. 32 (the processor receives card data and sends it to

the processing hub, directly or indirectly). The processing hub is used conventionally: to receive and access data. *See id.* (processing hub receives data, directly or indirectly, and accesses databases).

These components are described generically and with little detail because they are required to do no more than what one would expect them to do: contain, receive, send, and access data. The databases, too, are not described with any detail because they are generic databases, used to store data. And the point-of-sale device is explicitly described as “unmodified,” “existing,” and “standard” in the claim language—it could not be more generic or used in a more conventional manner.

## **B. THE PROCEEDINGS IN THE LOWER COURT**

AlexSam has asserted the '608 Patent in litigation nearly three dozen times since 2007, and it has been the subject of multiple appeals to this Court.<sup>2</sup> Currently, including the *HealthEquity* case, AlexSam and the '608 Patent are involved in seven cases pending in five different federal jurisdictions in Utah, California, Texas, New York, and Connecticut.<sup>3</sup> Six of the seven

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<sup>2</sup> *See AlexSam, Inc. v. IDT Corp.*, 715 F.3d 1336 (Fed. Cir. 2013); *AlexSam, Inc. v. Gap, Inc.*, 621 F. App'x 983 (Fed. Cir. 2015). Several claims of the '608 Patent were invalidated as a result of this Court's decision in *AlexSam, Inc. v. Gap, Inc.*

<sup>3</sup> *See AlexSam, Inc. v. HealthEquity, Inc.*, No. 2:19-cv-00445 (D. Utah); *AlexSam, Inc. v. WageWorks, Inc.*, No. 3:19-cv-04538 (N.D. Cal.); *AlexSam, Inc. v. Aetna Inc.*, No. 3:19-cv-01025 (D. Conn.); *AlexSam, Inc. v. Simon Property Group (Texas), L.P.*, No. 2:19-cv-00331 (E.D. Tex.); *AlexSam, Inc. v. Cigna Corp. et al.*, No. 2:20-cv-00081 (E.D. Tex.);

cases—all but the case against Mastercard that is currently pending in New York—involve allegations that the defendants infringe claims of the '608 Patent.

Turning to the *HealthEquity* case, AlexSam filed its complaint on June 26, 2019, alleging that HealthEquity infringed claims 32 and 33 of the '608 Patent because “HealthEquity sells, advertises, offers for sale, uses, or otherwise provides” various Visa-branded debit cards that are tied to health savings, flexible spending, and health reimbursement accounts. Appx45. The complaint contains more than thirty paragraphs over eight pages directed, in various forms, to the inventiveness of the asserted claims, Appx37-45, along with a 28-page expert declaration purporting the same, Appx71-99.

Of particular relevance here, AlexSam alleged, “Based on the state of the technology in 1997, there was a need in the art for a debit/credit card capable of performing a plurality of functions, which could be accepted by any Point-Of-Sale (‘POS’) device, and a processing center that could manage this multifunction card system.” Appx37-38 at ¶ 19. The applicant, Robert Dorf, “set out to solve this problem by inventing a new multifunction card system that utilized his special-purpose computer, referred to as the ‘processing hub’, that worked with the existing banking network and that utilized

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*AlexSam, Inc. v. Umb Fin. Corp. et al.*, 2:20-cv-00082 (E.D. Tex.); *AlexSam, Inc. v. Mastercard It'l Inc.*, No. 15-cv-02799 (E.D.N.Y.)

a bank identification number (BIN) to allow for the use of a multifunction card.” Appx38 at ¶ 22. AlexSam alleged that the invention combined claimed elements in a way that was novel in 1997: “[T]he combination of the POS device, transaction processor, and Processing Hub into a system that allows for the multifunction card system to access debit card databases and medical databases was not available or in general use in 1997.” Appx43 at ¶ 38.

HealthEquity filed a motion to dismiss under Rule 12(b)(6) because “[e]ach of the claims is directed to the abstract idea of using a card to access information” and neither contains an inventive concept sufficient to confer eligibility. Appx203. AlexSam opposed the motion, arguing that its claims were “actually directed to the creation of a new card system with newly created components, not to any abstract idea.” Appx255. The district court held a hearing on the motion via videoconference on June 19, 2020. *See generally* Appx397-511.

During the hearing, which lasted nearly three hours, the lower court made clear that it was struggling with its decision at step two of the *Alice* analysis. *See* Appx494-495 at 98:14-99:14. Specifically, the court was not sure whether the asserted claims were more like those in *BASCOM*, and therefore plausibly eligible, or like those in *Alice*, and therefore ineligible:

**MR. BONILLA:**

[W]hat I understand Your Honor to be struggling with is, is the idea

of using the banking network to access something other than just my bank account, is that enough to be an eligible invention? Is that just an abstract idea or is it, as *Alice* says, something that is significantly more than an abstract idea? Is this more like *BASCOM* or is this more like *Alice* or *Bilski*?

**THE COURT:**

. . . That is really what I’m trying to get at, . . . including the way you phrased that.

Appx504 at 108:1-11. The lower court accordingly “requested supplemental briefing regarding cases applying *Alice* step two in circumstances similar to those presented here and otherwise addressing the application of *Alice* step two to the facts of this case.” Appx512. The parties submitted that briefing on July 2, 2020. See Appx514-616.

**C. THE DISTRICT COURT’S § 101 ORDER**

The district court issued its opinion denying HealthEquity’s motion on August 7, 2020. See generally Appx1-13 (the “§ 101 Order”). At step one, the court remarked “that the claims at issue here present a ‘close call’ at the first step of the *Alice* inquiry.” Appx5. The court explained that the claims could be interpreted in two different ways to reach two different conclusions at this first step in the analysis:

On the one hand, the court believes that the claims at issue here are probably best characterized as being directed to “accessing databases to facilitate various kinds of transactions”—or, more

specifically, accessing financial and medical databases to facilitate making payments, engaging in other financial transactions, and medical records. . . . If this is the correct level of generality, the claims at issue here are indeed directed toward an abstract idea. . . .

On the other hand, . . . the claims at issue here appear to describe a specific, though partial, implementation of the solution to the problem described: encoding cards with banking identification information and placing a processing hub within the banking network so that a user can access financial and medical information with a single card using a single point-of-sale device. . . . If the claims here are properly characterized in the latter manner, they could be understood to be “directed to improvements to the functionality of a computer or network platform itself,” rather than simply to “a process or system that qualifies an abstract idea for which computers are merely invoked as a tool.”

Appx5-7. (citations omitted). The court concluded this step by stating that it did not need to determine this question because it found the claims survived § 101 scrutiny at the Rule 12 stage under *Alice* step two. *See* Appx7.

At step two, contrary to AlexSam’s repeated assertions, the court found “that each of the five elements of Claim 32—a processing hub, a transaction processor, two databases, a point-of-sale device, and a card encoded with a banking identification number—is simply conventional and does not amount to an inventive concept.” Appx8. Nonetheless, “[w]hen considering the elements as ‘an ordered combination,’ the court [could not] find as a matter of law that the claims reflect ‘conventional, routine, and well understood applications in the art.’” Appx10. Specifically, the court was persuaded by the specification’s description of the existing need in the art for a multifunction

card system and AlexSam’s “alleg[ation] that ‘the combination of the POS device, transaction processor, and Processing Hub into a system that allows for the multifunction card system to access debit card databases and medical databases was not available or in general use in 1997.’” Appx10-11. Accepting this allegation of novelty as true, the court could not find the claims ineligible as a matter of law on the pleadings. *See id.* It therefore denied HealthEquity’s motion. *See* Appx12.

#### **D. THE DISTRICT COURT’S *SUA SPONTE* CERTIFICATION**

The district court was forthcoming about its struggles applying *Alice* and its progeny to AlexSam’s claims. *See* Appx12. It considered the questions to be close calls and noted the parties “cited authoritative cases addressing at least somewhat analogous patent claims that appear to support their conflicting positions and, in all candor, this court finds some of these cases difficult to reconcile with one another.” *Id.* Although the court did not elaborate on these cases, it did explain why an interlocutory appeal is appropriate:

If this court’s ruling is erroneous, it would welcome reversal by the Federal Circuit. It is likely that such a ruling would promptly and efficiently resolve litigation not only in this case, but also in two other district courts where similar lawsuits and “nearly identical” motions to dismiss are pending. The court accordingly finds that this “order involves a controlling question of law as to which there is a substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the litigation.”

*Id.* The district court thus *sua sponte* certified the § 101 Order for interlocutory appeal. *Id.*

## **ARGUMENT**

Section 1292(b) establishes three criteria for certification. The district court must be of the opinion that: (1) the order involves a controlling question of law; (2) there is substantial ground for difference of opinion; and (3) certification will materially advance the ultimate termination of the litigation. 28 U.S.C. § 1292(b). Once certified, this Court has complete discretion regarding whether to permit the appeal. *See In re Convertible Rowing Exerciser Patent Litigation*, 903 F.2d 822 (Fed. Cir. 1990). The Court should exercise that discretion here and permit the appeal.

### **A. THE § 101 ORDER RAISES CONTROLLING QUESTIONS OF LAW**

Whether a plaintiff's allegation regarding an inventive concept is a factual allegation that must be presumed true or a legal conclusion irrelevant to the eligibility analysis is a controlling question of law. Under § 1292(b), a question of law is "controlling" if the Federal Circuit's "resolution of that issue could have an immediate impact on the course of the litigation." *Fujitsu Ltd. v. Tellabs, Inc.*, 539 Fed. Appx. 1005 (Fed. Cir. 2013).

Generally speaking, patentability under § 101 is a threshold legal issue. *Bilski v. Kappos*, 561 U.S. 593, 602 (2010). If this Court permits the appeal

and holds the claims are ineligible as a matter of law, the litigation would end, absent a petition for certiorari to the Supreme Court by AlexSam. And not only would this litigation end, but so would several others, as AlexSam is asserting the same claims in four other cases in California, Texas, and Connecticut. Additionally, a holding of ineligibility of the claims asserted against HealthEquity would be just as applicable to the other surviving claims<sup>4</sup> of the '608 Patent, and AlexSam would be left with no patent claims to pursue in any litigation. No decision could have a more immediate impact on the course of litigation than whether asserted patent claims survive the threshold issue of § 101 eligibility. Accordingly, the § 101 Order presents a controlling question of law.

The specific § 101 question raised by the district court's § 101 Order is also a controlling question of law. The district court found that it could not determine the asserted claims are ineligible as a matter of law because it had to accept as true AlexSam's allegation "that 'the combination of the POS device, transaction processor, and Processing Hub into a system that allows for the multifunction card system to access debit card databases and medical

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<sup>4</sup> Claims 1, 34, 36, 37, 57, 58, 60, 62, and 65 of the '608 Patent were invalidated as a result of this Court's decision in *AlexSam, Inc. v. Gap, Inc.*, 621 Fed. Appx. 983, 994 (Fed. Cir. 2015) (holding asserted claims of two patents, including '608 Patent, were invalid as anticipated).

databases **was not available or in general use in 1997.**” Appx11 (emphasis added). Even if this allegation were true, however, it is irrelevant to the § 101 analysis, as the Supreme Court made clear nearly four decades ago: “The question . . . of whether a particular invention is novel is wholly apart from whether the invention falls into a category of statutory subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 190 (1981).

Further, this Court has also clarified that whether the abstract idea itself was unconventional is also not relevant to the § 101 analysis. In *BSG Tech LLC v. Buyseasons, Inc.*, this Court held, “If a claim’s only ‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea.” 899 F.3d 1281, 1290-91 (Fed. Cir. 2018). Here, then, the critical question is not whether the asserted claims’ arrangement of claimed components was novel in 1997, or whether the abstract idea to which they are directed was unconventional in 1997, but instead whether the claims include some unconventional component or some unconventional arrangement of known components. The district court already found the claims lacked the former, as it found the claimed components to be generic and used for their conventional purposes. *See* Appx8-9.

With respect to the latter, however, the district court errantly credited AlexSam's allegations of a purportedly novel combination of known elements to find that it could not, as a matter of law, rule that the claims contained no inventive concept. *See* Appx10-11. Can a plaintiff survive § 101 scrutiny at the Rule 12 stage merely by artfully pleading that its claimed combination of generic components was new as of the date of the invention? That is the controlling issue of law that this Court can decide now, and precedent from both the Supreme Court and this Court instructs the answer is "no." *See Diamond*, 450 U.S. at 190; *Two-Way Media Ltd. v. Comcast Cable Comm'ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) ("Eligibility and novelty are separate inquiries."). This Court should grant permission to appeal to apply that answer to AlexSam's claims in this case.

**B. THERE ARE SUBSTANTIAL GROUNDS FOR DIFFERENCE OF OPINION REGARDING THE DISTRICT COURT'S DECISION TO DENY HEALTHEQUITY'S MOTION TO DISMISS**

There exist substantial grounds for difference of opinion regarding whether the asserted claims are directed to patent-ineligible subject matter. In fact, one jurist on this Court already came to a conclusion different from the district court's below. In *AlexSam, Inc. v. IDT Corp.*, this Court addressed jury findings on invalidity and infringement regarding claims 57 and 58 of the '608 Patent. 715 F.3d 1336 (2013). Judge Mayer dissented from that

opinion, opining, “There can be no infringement of [the ’608 Patent] because it is invalid. Asserted claims 57 and 58 disclose<sup>5</sup> nothing more than an abstract idea for making a business run more efficiently, thereby failing to meet the subject matter eligibility requirements set forth in 35 U.S.C. § 101.” *Id.* at 1348.

The parties in *IDT* did not address § 101 before the trial court, during trial, or on appeal, but Judge Mayer nonetheless wrote that the ’608 Patent claimed ineligible subject matter. He remarked that “the ‘great benefit’ of the ’608 Patent is that it discloses no new hardware or software, but instead relies on the use of unmodified existing terminals for activating gift and prepaid telephone cards.” *Id.* at 1349. He specifically noted the broad nature of the ’608 Patent’s claims and its implication of the preemption concerns undergirding § 101: “Alexsam’s broad claims—which cover not only gift cards and prepaid telephone cards, but also customer ‘loyalty’ cards and ‘medical information cards—threaten to preempt some of the ‘basic tools’ of modern commerce.” *Id.* Accordingly, he concluded, unlike the lower court, that the claims “fall outside the ambit of section 101.” *Id.* Consequently, the only two

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<sup>5</sup> Claims 57 and 58 are not materially different from claims 32 and 33 with respect to § 101. The former claims are directed to using a banking card to activate an electronic gift certificate, a phone account, a loyalty account, or a medical information account, while the latter claims are directed only to a debit and medical services card. These differences do not alter the eligibility analysis: all four claims are directed to using a banking card to access non-banking information.

federal jurists who have commented on the eligibility of the '608 Patent's claims reached differing conclusions, establishing that substantial grounds for difference of opinion exist.

Additionally, this Court has more recently addressed strikingly similar claims and held them to be ineligible because the idea of using banking cards from an existing network to access additional databases or information is an abstract idea that is ineligible for patenting. In *Smart Systems Innovations, LLC v. Chicago Transit Authority*, this Court addressed claims that covered purported solutions to “problems that had proven intractable to the [mass] transit sector.” 873 F.3d 1364, 1368 (Fed. Cir. 2017). The patents-at-issue addressed these problems “with inventions designed to implement open-payment fare systems in mass transit networks in the United States.” *Id.* Specifically, the patents' claims were directed to “[a]n open-payment fare system [that] allows users to conveniently and quickly access mass transit by using existing bankcards,’ such as debit and credit cards, thereby ‘eliminat[ing] the need for, and added operational cost of, dedicated fare-cards,’ paper tickets, and tokens.” *Id.* The patentee argued that the claims were eligible because they “satisf[ied] a public demand for more convenient travel **that did not exist in the prior art.**” *Id.* at 1371 (emphasis added).

This Court disagreed. It explained that the claims were directed to collecting, storing, and recognizing data in the context of forming financial transactions:<sup>6</sup>

The Asserted Claims of the '003 and '617 patents involve acquiring identification data from a bankcard, using the data to verify the validity of the bankcard, and denying access to a transit system if the bankcard is invalid. The Asserted Claims of the '816 patent involve acquiring identification data from a bankcard and funding a transit ride from one of multiple balances associated with that bankcard. Moreover, the Asserted Claims of the '390 patent involve identifying whether a presented bankcard is associated with a timepass (e.g., a monthly subway card) and, if the timepass is found, charging a different fare. Taken together, the Asserted Claims are directed to the formation of financial transactions in a particular field (i.e., mass transit) and data collection related to such transactions. The Asserted Claims are not directed to a new type of bankcard, turnstile, or database, nor do the claims provide a method for processing data that improves existing technological processes. Rather, the claims are directed to the collection, storage, and recognition of data. We have determined that claims directed to the collection, storage, and recognition of data are directed to an abstract idea.

*Id.* at 1371-72 (citations omitted). This Court found unavailing the patentee's argument that the claims were "patent eligible because they improve prior systems of fare collection by speeding up the process at the turnstile." *Id.* at 1372. The Court therefore held the claims were directed to an abstract idea at step one of the *Alice* test.

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<sup>6</sup> This description is very similar to Judge Nielson's initial formulation for what the asserted claims are directed to: "accessing databases to facilitate various kinds of transactions." Appx5.

Here, the asserted claims are not meaningfully distinguishable from those held ineligible in *Smart Systems*. Like in *Smart Systems*, the '608 Patent noted that prior art systems were limited in functionality and did not allow customers to “access certain types of information in a very fast and convenient manner.” Appx22 at 2:52-53. To address the perceived need, the patentee claimed a multifunction card that can act as both a debit/credit card and a medical services card, simply because the existing banking network accesses multiple databases. See Appx29 at cl. 32. Compare that to *Smart Systems*, where the claimed cards used the existing banking network to access information about mass transit riders, such as their identification information or whether they had a “timepass” account, which would result in discounted mass transit fare. See *Smart Systems*, 873 F.3d at 1372. Both sets of claims cover using extant banking cards and networks to access non-banking information.

And, like in *Smart Systems*, AlexSam’s claims “are not directed to a new type of bankcard, . . . nor do the claims provide a method for processing data that improves existing technological processes.” *Id.* at 1372. There is no real daylight between the claims held to be abstract and ineligible in *Smart*

*Systems*, and the claims of the '608 Patent. Accordingly, it is difficult to reconcile the lower court's decision in this case with this Court's decision in *Smart Systems*.

Consequently, there exists substantial ground for difference of opinion regarding the § 101 Order. Strikingly similar claims were held ineligible in *Smart Systems*, and Judge Mayer opined that the claims of the '608 Patent were ineligible, yet the lower court found it could not declare the claims ineligible. This Court should grant permission to appeal and address the discrepancies between prior opinions from this Court and the district court's opinion below.

**C. IMMEDIATE APPEAL FROM THE § 101 ORDER MAY MATERIALLY ADVANCE THE ULTIMATE TERMINATION OF MULTIPLE CASES PENDING IN MULTIPLE JURISDICTIONS**

Permitting this appeal may materially advance the ultimate termination of this litigation and others. This Court has, on several occasions, granted petitions for interlocutory appeal where resolution of the interlocutory issue would affect the resolution of other pending cases. *See, e.g., Ad Global Fund, LLC v. U.S.*, 167 Fed. Appx. 171, at \*1 (Fed. Cir. 2006) (“We note in particular that resolution of this issue will affect the resolution of other pending cases.”); *Symbol Techs., Inc. v. Lemelson Med., Educ. & Research Foundation, L.P.*, 243 F.3d 558 (Fed. Cir. 2000) (“We determine in

our discretion to grant Symbol’s petition, in part because the issue affects not only this case, but many other cases as well.”); *Ins. Co. of West v. U.S.*, 230 F.3d 1378 (Fed. Cir. 2000); (“[T]he United States challenges jurisdiction on the basis of *Blue Fox* not only in the instant case, but also in three other cases pending in the Court of Federal Claims.”). In the *Ad Global* and *Insurance Company of West* cases, this Court found at least partially determinative that its decisions in those cases would impact five and three other pending cases, respectively. *See Ad Global*, 167 F. Appx. at \*1; *Ins. Co. of West*, 230 F.3d at \*1.

The Court’s decision in this case may affect five other cases pending in three different jurisdictions. AlexSam’s case against HealthEquity is pending in the District of Utah, but it is asserting the identical claims 32 and 33 against WageWorks in the Northern District of California, Appx617-748, Aetna in the District of Connecticut, Appx749-922, and both Cigna and UMB entities in the Eastern District of Texas, Appx923-1298. It is also asserting other claims of the ’608 Patent against Simon Property Group in the Eastern District of Texas. Appx1299-1485. HealthEquity’s motion was ruled upon in this case, but WageWorks and Cigna have similar pending motions to dismiss under § 101 in their respective cases, and those have yet to be ruled upon. There thus exists the possibility of inconsistent rulings from different

jurisdictions on identical issues. This Court can avoid that situation and the potential waste of significant resources by multiple parties and courts by permitting HealthEquity to appeal this threshold issue now.

### **CONCLUSION**

For these reasons, respectfully, HealthEquity's petition should be granted.

Dated: August 17, 2020

Respectfully submitted,

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## CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 28.1(e)(2)(A), because it contains 4961 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii) and Federal Circuit Rule 32(b).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This brief has been prepared in a proportionally spaced typeface using Microsoft Word, in 14 Point Georgia.

Dated: August 17, 2020

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