

No. 21-

IN THE
Supreme Court of the United States

THADDEUS GABARA,

Petitioner,

v.

FACEBOOK, INC.,

Respondent.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

The Sliding Windows patents cover a novel data structure—a “background image of a stationary map”—that allows users to navigate large images on a smartphone by moving the phone itself. This data structure is required by the patents’ claims, emphasized as the key to the invention throughout the patents’ specifications, and was the explicit basis on which the PTAB relied to distinguish the patents over prior art. In ruling that the patents were invalid under 35 U.S.C § 101 for claiming an abstract idea, however, the court below did not consider this claimed data structure, excluded this express requirement from the patent claims from the court’s characterization of what the claims were “directed to,” and refused to consider the fact that because this claim limitation distinguished prior art, the Sliding Windows patents did not risk preemption of any abstract idea.

The questions presented are:

What is the appropriate standard for determining whether a patent claim is “directed to” a patent-ineligible concept under step 1 of the Court’s two-step framework for determining whether an invention is eligible for patenting under 35 U.S.C § 101?

Whether, and to what extent, a court may ignore the “claimed advance” that distinguishes a patented invention over the prior art in its determination of what a claim is directed to under step 1 of the Court’s two step framework for determining patent eligibility under 35 U.S.C. § 101?

Whether, and to what extent, a court may consider whether a patent claim provides sufficient disclosure regarding how the claimed invention may be made or used to determine whether a patent claim is eligible for patenting under 35 U.S.C. § 101, or whether that improperly conflates § 101 and § 112?

Whether preemption is a consideration that the lower courts must consider in determining whether a claimed invention is directed to patent-eligible subject matter under Section 101, or whether it can be properly ignored if not raised by the patent-challenger?

PARTIES TO THE PROCEEDING

All parties to the proceeding are identified in the case caption.

CORPORATE DISCLOSURE STATEMENT

Petitioner is the individual named inventor and owner of the patents-in-suit.

RELATED PROCEEDINGS

The following proceedings are directly related to this case within the meaning of Rule 14.1(b)(iii):

- *Gabara v. Facebook*, No. 19-cv-9890 (DLC), U.S. District Court for the Southern District of New York. Judgment entered September 4, 2020; and
- *Facebook Inc. v. Thaddeus Gabara*, No. IPR2021-00116, USPTO Patent Trial and Appeal Board. Judgment entered May 11, 2021; and
- *Facebook Inc. v. Thaddeus Gabara*, No. IPR2021-00117, USPTO Patent Trial and Appeal Board. Judgment entered May 11, 2021; and
- *Facebook Inc. v. Thaddeus Gabara*, No. IPR2021-00118, USPTO Patent Trial and Appeal Board. Judgment entered May 11, 2021; and
- *Facebook Inc. v. Thaddeus Gabara*, No. IPR2021-00200, USPTO Patent Trial and Appeal Board. Judgment entered May 25, 2021; and
- *Facebook Inc. v. Thaddeus Gabara*, No. IPR2021-00201, USPTO Patent Trial and Appeal Board. Judgment entered May 25, 2021; and

- *Gabara v. Facebook*, No. 20-2333, U. S. Court of Appeals for the Federal Circuit. Judgment entered July 8, 2021.

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The Federal Circuit's judgment (App. 1a-2a) is reported at 852 F. App'x 541 (Fed. Cir. 2021). The opinion of the District Court dismissing the Second Amended Complaint (App. 3a-25a) is reported at 484 F. Supp. 3d 118 (S.D.N.Y. 2020). The Federal Circuit's order denying panel rehearing or rehearing *en banc* (App. 26a-27a) is unreported.

BASIS FOR JURISDICTION

The Federal Circuit entered judgement on July 8, 2021. Petitioner filed a timely petition for panel rehearing or rehearing *en banc*, which was denied on September 10, 2021. On November 18, 2021, this Court extended the time for filing a petition for writ of certiorari to February 7, 2022. This Court has jurisdiction pursuant to 28 USC § 1254(1).

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 101. Inventions Patentable: Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

INTRODUCTION

At issue in this case is the appropriate analysis of patent eligibility pursuant to Section 101. Section 101 provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.” 35 U.S.C. § 101. Judicially-created exceptions to patent-eligible subject matter are laws of nature, natural phenomena, and abstract ideas. *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972); *Mayo Collab. Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012); *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208 (2014).

This case presents important issues regarding (a) how a court should determine what a claim is “directed to” which is the first step of *Alice*, and relatedly whether a court may ignore the key aspect of the invention that is recited throughout the claims, emphasized throughout the specification, and that distinguishes the invention over the prior art, (b) whether, and to what extent, courts should consider enablement under Section 112 and factual issues raised thereby in the Section 101 analysis and (c) the role of preemption in the Section 101 analysis. The District Court’s opinion—affirmed summarily by the Federal Circuit—demonstrates a disregard of the patent claim limitations in order to arrive at an abstract idea. In doing so, the District Court conflates the Section 101 and Section 112 analyses as to how the patent claim achieves the functional result and ignores whether the patent claim preempts all methods of achieving the same result. These serious errors led to the invalidation of four patents-in-suit.

For the reasons set forth herein, Petitioner respectfully requests this Petition is granted.

Since the Supreme Court's decision in *Alice* and *Mayo*, Section 101 has not been applied uniformly or consistently by the lower courts. The Federal Circuit admits as much, stating they "are at a loss as to how to uniformly apply [Section] 101." *Am. Axle & Mfg. v. Neapco Holdings LLC*, 977 F.3d 1379, 1382 (Fed. Cir. 2020) (*en banc*). Indeed, the entirety of the Federal Circuit has urged the Supreme Court to provide it with guidance, noting that "[t]here is very little about which all twelve of us are unanimous, especially when it comes to [Section] 101." *Id.*

This case provides a unique vehicle for addressing and rectifying that confusion. As for clarifying how to assess what a claimed invention is "directed to" for Step 1 of the *Alice* framework, the claim language itself, the patent specifications, and the related PTAB proceedings all provide potential blaze marks for the analysis that were disregarded by the court below. This case would thus allow the Court to ensure that courts below are following the proper Step 1 analysis.

This case is also a unique vehicle for addressing the role of preemption. Because of the related PTAB proceedings, it is established that no risk of preemption exists. Prior art that performed the same "abstract idea" identified by the court below was nonetheless outside the scope of the Sliding Windows patents-in-suit, because it used the abstract idea in a way different from, and excluded by, the scope of the Sliding Windows patents' claims. Those claims did not cover all manners of using the abstract idea, and

therefore did not preempt the abstract idea. This case therefore would allow the Court to address whether it was proper to ignore the question of preemption in its entirety in conducting a Section 101 analysis, as done by the court below. As the Federal Circuit case law on the role of preemption is far from clear, this is an important aspect of Section 101 that the Court can clarify.

The Court has called for the views of the Solicitor General regarding the petition for writ of certiorari filed in *American Axle & Manufacturing, Inc. v. Neapco Holdings, LLC*, et al., case no. 20-891 (filed December 28, 2020), wherein a sharply divided Federal Circuit largely affirmed the district court's decision that claims directed to a process of reducing vibration in a vehicle drive shaft were not patent eligible because they were directed to a natural law.

This case presents issues that are similar to that of *American Axle* as discussed *infra*. Considering the present case in parallel with *American Axle* would allow the Court to address the “abstract idea” and “natural law” aspects of Section 101 in parallel, as well as to access a greater range of factual scenarios to provide greater clarity overall. In the event that this Court is not inclined to grant this Petition for full consideration, alternatively, Petitioner respectfully requests that this Petition be held pending the outcome of the petition in *American Axle* and any further proceedings in that case. If the Court grants the petition in *American Axle*, then the Court should grant this Petition, vacate the judgment of the Federal Circuit, and remand this case to the Federal Circuit

for further proceedings in view of any decision this Court may reach on the merits in *American Axle*.

STATEMENT OF THE CASE

A. The Court's Framework for Patent Eligibility

Section 101 provides that “[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor.” 35 U.S.C. § 101. Congress’s choice to define patentable subject matter using expansive language suggests that “Congress contemplated that the patent laws should be given wide scope, and the relevant legislative history also supports a broad construction.” *Diamond v. Chakrabarty*, 447 U.S. 303, 303, 100 S. Ct. 2204, 2205 (1980). However, the Supreme Court has recognized three judicially created exceptions as subject matter that are not patent-eligible, namely laws of nature, natural phenomena, and abstract ideas. *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014).

The Supreme Court has recognized that “all inventions . . . [in some way] embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.” *Mayo*, 566 U.S. at 71. This Court has, thusly, cautioned that it must “tread carefully in construing this exclusionary principle lest it swallow all of patent law.” *Alice*, 573 U.S. at 217. It has described that the “concern that drives this exclusionary principle is one of pre-emption.” *Id.* at 216. *See also Bilski v. Kappos*, 561 U.S. 593, 611–612 (2010) (upholding the patent “would pre-empt use of

this approach in all fields, and would effectively grant a monopoly over an abstract idea”);

For these reasons, it is legal error for a court to hold patent claims ineligible simply because they may *relate to* some abstract concept. *See Diamond v. Diehr*, 450 U.S. 175, 187 (1981); *CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1371 (Fed. Cir. 2020) (finding that the district court erred by “[g]eneralizing the asserted claims” in a manner that is inconsistent with Federal Circuit instruction that courts “be careful to avoid oversimplifying the claims’ by looking at them generally and failing to account for the specific requirements of the claims”).

In *Alice*, the Supreme Court reaffirmed the two-step framework set forth in *Mayo* for determining Section 101 subject matter eligibility regarding abstract ideas. First, the Court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Alice* at 217. If yes, the Court is to “consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.*

This second step is “a search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.” *Id.* at 217-18. The “inventive concept” analysis is not analogous to a novelty determination; rather, it asks whether the claims cover a patent-eligible process, machine, manufacture, or composition of matter. *See, e.g.*,

Diehr, 450 U.S. at 190 (“The question therefore of whether a particular invention is novel is wholly apart from whether the invention falls into a category of statutory subject matter”) (internal citations omitted). In the context of software-based inventions, this analysis has been framed as whether “the specific improvements in the recited computer technology go beyond ‘well-understood, routine, conventional activit[ies]’ and render the invention patent-eligible.” *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016) (quoting *Alice*, 573 U.S. at 225).

B. Factual Background

Petitioner Thaddeus Gabara is the owner and co-inventor of the four “Sliding Windows Patents” at issue, namely U.S. Patent Nos. 8,930,131 (“the ’131 patent”); 8,620,545 (“the ’545 patent”); 8,706,400 (“the ’400 patent”); 8,836,698 (“the ’698 patent”) (collectively, the “Sliding Windows Patents”). He is an accomplished engineer who pioneered semiconductor and networking technology at AT&T Bell Labs before creating his own incubator for early-stage technologies. He has contributed value and innovation to this field, evidenced by the widespread licensing and commercialization of his inventions—developed both during his time in the industry and later as an entrepreneur.

The four Sliding Windows Patents at issue provide novel contributions to the field of portable devices. Portable devices such as smartphones are typically prized for smaller form factors, but, as a result, are not well-suited to viewing or navigating images that extend beyond their relatively small

screens. Traditionally, a user viewing a map or image on a touchscreen smartphone has to minimize, magnify, and scroll the map with finger gestures to locate a desired point. C.A.J.A.237, 1:36-50. Repeatedly performing these actions may cause the user to lose bearing because the small screen inhibits the true sense of the distance between locations on the map, especially with changing magnification. C.A.J.A.237, 1:50-56. The Sliding Window Patents instead provide for a particular implementation using kinesthetic navigation on portable devices to change the portion of a map being displayed.

The specification of the Sliding Windows Patents “introduces a background map that remains stationary.” *E.g.*, C.A.J.A.237, 2:7-8. As discussed throughout each specification and highlighted in the challenged claims, this “background image of a stationary map” is a novel data structure—a digital image stored in memory that is locked to a position in physical space. “The system behaves as if a stationary map exists behind the portable unit and the screen of the portable unit is a Sliding Window exposing the portion of the image of the stationary map behind the portable unit.” C.A.J.A.243, 14:58-61. Instead of registering movement via touchscreen gestures, when the desired image or map is displayed, the portable device itself is moved and the image displayed appears to reveal new portions of the stationary map. C.A.J.A.237, 2:7-11. The device is moved through physical space to a desired position, and in turn, that motion is translated into showing the portion of the “stationary” map or image that was not previously visible on the screen. C.A.J.A.237, 2:17-21. This allows

for a more natural viewing method that overcomes limitations in the prior art.

The specification of the Sliding Windows Patents repeatedly indicates that the background image of a stationary map is an “innovative” and integral part of the claimed advance. *See, e.g.*, C.A.J.A.227, Fig. 10b and C.A.J.A.244, 16:10-11, 16-17 (“the innovative embodiment of the device movement technique,” in which “map 10-3 remains stationary”); C.A.J.A.238, 3:33-36; C.A.J.A.242, 11:58-67; C.A.J.A.243, 13:4-11, 14:53-61; C.A.J.A.244, 16:25-30 (“Lastly, the movement that the user experiences allows the user to ‘feel’ and grasp the various locations by various positions in physical space. This provides for this innovative distance and angle understanding of the map 10-3 which remains stationary and is being scanned by the moving portable unit.”). The Sliding Windows Patents tie “benefits” of the invention to this stationary map approach, reflected throughout the specification. *See, e.g.*, C.A.J.A.196, Abstract (explaining that objects “outside of the range of the screen...can [] immediately be located and placed into view”); C.A.J.A.244, 16:25-30.

This “background image of a stationary map” (or a related analog), is required by every claim of the Sliding Windows Patents.¹ It is recited four times in claim 1 of U.S. 8,706,400 (“the ’400 patent”), the exemplary claim that the District Court used in its

¹ Every independent claim of the four Sliding Windows Patents recites one of: (1) “background image of a stationary map,” (2) “stationary background image,” or (3) “three dimensional image of a stationary map.” C.A.J.A.89, C.A.J.A.142-43, C.A.J.A.194-95, C.A.J.A.247.

Section 101 analysis. This background image forms the basis for the claimed advance—the image displayed on the screen changes according to movement of the portable device, while the background image remains stationary and fixed in real-space. This novel data structure is explicitly recited in four of the six method steps of claim 1 of the '400 patent, and it serves a crucial role in the overall function of the invention.

C. Procedural Background

Petitioner filed the original *pro se* complaint on October 25, 2019, asserting infringement of the U.S. Patent 8,930,131 (“the ’131 patent”), and on November 15, 2019, still proceeding *pro se*, Petitioner amended the complaint to additionally allege infringement of U.S. Patent Nos. 8,620,545 (“the ’545 patent”); 8,706,400 (“the ’400 patent”); 8,836,698 (“the ’698 patent”); and 9,299,348 (“the ’348 patent”). Faced with a first motion to dismiss arguing that the patents were invalid for claiming patent-ineligible subject matter under Section 101 and that certain claims were indefinite under Section 112, Petitioner filed a second amended complaint.

Respondent Facebook LLC renewed its motion to dismiss Petitioner’s second amended complaint arguing that all of the claims of all of the asserted patents were invalid for claiming patent-ineligible subject matter under 35 U.S.C. § 101, but did not renew its arguments regarding indefiniteness under Section 112. The District Court granted Facebook’s motion to dismiss on September 4, 2020.

The District Court analyzed representative claims of the Sliding Windows Patents under the two-step framework under *Alice*. At the first step, the District Court determined that the claims were directed towards “[m]oving the device to change one’s view of the image instead of scrolling on the device to change the view.” App. 13a. At a minimum, the District Court erred in its analysis by ignoring the advance touted in the specification and explicitly required by the claims, namely the “background image of a stationary map.”

At step two, the District Court determined that the Sliding Windows Patents “fail to contain an inventive concept” and that the Sliding Windows Patents “purport to employ conventional computer hardware and processes, in an ordinary manner, to achieve the idea at the heart of the invention.” *Id.* at 17a-18a.

The District Court further declined to address the issue of preemption, claiming in a footnote that it need not because “Facebook does not raise preemption as a ground for dismissal.” *Id.* at 19a. The District Court further stated that it need not reach the issue because “the absence of complete preemption does not render the Sliding Windows Patents any less abstract.” *Id.* at 19a, n. 5. The District Court erred by its express failure to consider the issue of preemption, and alternative approaches other than the representative claims of the Sliding Windows Patents existed in the field to “move a portable device itself to view different portions of images displayed on portable devices.” Accordingly, the claimed inventions posed no risk of preemption of the District Court’s abstract idea, and

it is therefore improper for the District Court to invoke Section 101 to invalidate the claims-at-issue.

Subsequent to the District Court's determination that the patents-in-suit were invalid for claiming patent-ineligible subject matter, Facebook filed a petition for *inter partes* review for each of the Sliding Windows Patents at the Patent and Trial Appeal Board ("PTAB"), arguing that the Sliding Windows Patents were anticipated by or rendered obvious in light of various prior art. The PTAB denied each of Facebook's petitions, and declined to institute *inter partes* review.

Specifically, the PTAB relied on the "background image of a stationary map" limitation to deny Facebook's petitions for *inter partes* review challenging the '400 patent. *See, e.g., Gabara v. Facebook*, No. 20-2333, Dkt. 29-4, at 12 ("[W]e find that Petitioner did not carry its burden of showing Kim discloses a stationary map as a background image and, thus, fails to demonstrate a reasonable likelihood that it would prevail in establishing that Kim anticipates claim 1."). While Facebook's prior art taught moving a portable device to view different portions of a displayed image, it did so in a different way. *Id.* 23-24 ("Therefore, because the background image A1 moves, Petitioner has not shown sufficiently that Kim's image A1 is a *stationary* map, as recited by claim 1.") (emphasis in original) (footnotes omitted). As the Board further wrote, "[a] stationary background image is a **critical aspect** of what the '400 patent refers to as 'innovative.' *See, e.g.,* [400 patent] at Fig. 10b[.]" *Id.* at 24, n.6 (emphasis added).

Petitioner timely appealed the District Court's judgment to the Federal Circuit. The Federal Circuit endorsed the errors made by the District Court in its affirmance of the district and denied Petitioner's request for panel rehearing or rehearing *en banc*, on September 10, 2021.

Prior to the Federal Circuit's denial of rehearing *en banc*, American Axle filed a petition for writ of certiorari presenting substantially similar issues as raised by the instant case. See *Am. Axle & Mfg., Inc. v. Neapco Holdings, LLC* (No. 20-891). Specifically, American Axle asked the Court to review two following questions:

1. What is the appropriate standard for determining whether a patent claim is "directed to" a patent-ineligible concept under step 1 of the Court's two-step framework for determining whether an invention is eligible for patenting under 35 U.S.C. § 101?
2. Is patent eligibility (at each step of the Court's two-step framework) a question of law for the court based on the scope of the claims or a question of fact for the jury based on the state of art at the time of the patent?

See No. 20-891 Pet. at i.

On May 3, 2021, this Court invited the Acting Solicitor General to file a brief in *American Axle* to express the views of the United States. As of the date of this Petition, the Solicitor General has not filed its brief.

REASONS FOR GRANTING THE PETITION

A. The Lower Courts erred in their determination as to what the patent claim is “directed to.”

This Court should grant certiorari in this case in order to resolve the appropriate standard the Federal Circuit and the district courts should apply in determining what a claim is “directed to.” As is evidenced by this case, the lack of clear guidance from the Supreme Court has led to an outcome driven analysis resulting in unpredictable results.

Here, the very first sentences of the District Court’s analysis showcase the errors in its analysis of the Sliding Windows Patents:

The invention presented in the [Sliding Windows] Patents is to move the portable device itself to view different portions of images displayed on portable devices. Moving the device to change one’s view of the image instead of scrolling on the device to change the view is an abstract idea.

C.A.J.A.12; App. 13a. In order to arrive at this conclusion, the District Court disregarded over 75% of the claimed invention and reduced claim 1 to two oversimplified steps, exemplified below.

1. A method of moving a portable unit to search for a new location comprising the steps of:

displaying an image on a screen of the portable unit ~~matched~~ and superimposed to a corresponding portion of a background image of a stationary map;

~~mapping a first point of the display image located in a center of the screen of the portable unit to a corresponding reference point in the background image of the stationary map;~~

moving the portable unit to display a new portion of the background image of the stationary map on the screen;

~~identifying a new location in the new portion of the background image;~~

~~determining a first vector between the center of the screen of the portable unit and the new location; and~~

~~moving the center of the screen of the portable unit to the new location as determined by the first vector.~~

C.A.J.A.247, 21:2-19 (strikethroughs added).

By improperly ignoring the claimed features, the District Court disregarded the “background image of a stationary map” limitation, a necessary portion of the claimed advance in claim 1. Indeed, the “background image of a stationary map” is the heart of the claimed advance over the prior art. It is explicitly described as an innovation and a key feature to the invention in the written description. It is recited multiple times throughout each independent claim. It is part of almost every step of the recited methods. And it was the PTAB’s express basis to foreclose Facebook’s IPR challenges against the Sliding Windows Patents.

Compounding this error, the District Court improperly twisted certain advantages of the claimed inventions discussed in the ’400 patent into evidence of abstractness. *See Yu v. Apple Inc.*, 1 F.4th 1040, 1047 (Fed. Cir. 2021) (Newman, J., dissenting) (“A statement of purpose or advantage does not convert a device into an abstract idea.”). This approach perverts the intrinsic record, supplanting the claimed invention with a description of the invention’s *benefits* from the specification.

The District Court wrote that the loss-of-bearing problem discussed in the patent does not only arise in portable devices. C.A.J.A.15; App. 15a.

However, the '400 patent instructs that a user may “lose bearing” as a “**shortcoming in current portable systems** for providing map directions.” C.A.J.A.237, 1:53-58 (emphasis added). The solution to this problem in the '400 patent arises from addressing the **source** of the problem, *i.e.* improving portable device technology itself through the introduction of a “background image of a stationary map.” Although it may be a benefit of the claimed invention, Claim 1 itself does not recite or purport to cover regaining one’s bearings. In the same vein, the District Court wrote that claim 1 lacks a “particularized method” because “one asserted benefit of the claimed invention” is compatibility with various portable devices. *See* C.A.J.A.15; App. 16a. But again, this “compatibility” is recited as a potential advantage of the claimed invention, not the claimed invention itself. The claimed invention is not reduced to its potential benefits, even if found in the specification—the actual claim language still defines the scope of the invention.

It is incumbent upon the Supreme Court to clarify the appropriate standard to be applied to determine what a claim is directed to. A proper Section 101 analysis should consider a claimed advance at Step 1. The District Court’s approach and the Federal Circuit’s affirmance encourages future courts to convert the threshold validity issue of Section 101 into an arbitrary analysis driven by cherry-picked snippets from the specification and ignore the specific features of the claimed invention.

B. The Lower Courts improperly conflated the Section 101 analysis with Section 112.

This Court has stated that Section 101 patent eligibility inquiry “might sometimes overlap” with the inquiry under the other requirements of patentability. *See Mayo*, 566 U.S. at 90. According to the Federal Circuit, to avoid ineligibility, “a claim must “ha[ve] the specificity required to transform [the] claim from one claiming only a result to one claiming a way of achieving it.” *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1296 (Fed. Cir. 2020). This principle is reiterated by the District Court in this case. *See App. 16a* (“[P]atentable material must not only disclose a desirable outcome; it must also explain how to realize that outcome.”). Thus, there is necessarily some overlap between Section 101 – patent eligibility concerns and Section 112 – addressing “enablement.”

The concern of conflating Section 101 and 112 is particularly evident in light of the Federal Circuit’s opinion and associated dissents in *American Axle*. Indeed, there is a clear division amongst the judges on the Federal Circuit as to where the line between Section 101 and Section 112 should be drawn. The *American Axle* panel majority agreed that “[this Court] in *Mayo* made clear that Section 101 serves a different function than enablement [under Section 112]” *Am. Axle*, 967 F.3d at 1302-03. But, Judge Stoll, also joined by Judge Moore and Judge Reyna, suggested that the majority view is a step too far whereby it “incorporat[ed] a heightened enablement requirement into [Section] 101.” *See Am.*

Axle, 966 F.3d at 1363 (Stoll, J., joined by Newman, Moore, O’Malley, and Reyna, JJ.). Judge Stoll further opined that in her view, “a claim can be specific enough to be directed to an application of a law of nature—which is patent eligible—without reciting how to perform all the claim steps.” *Id.* Judge Stoll also opined that “en banc review would provide an opportunity for . . . the full court to consider, where [Section 101] eligibility analysis stops and [Section 112] enablement analysis begins.” This review was denied.

Nevertheless, whatever permissible overlap there may be, the District Court’s Section 112-infused eligibility analysis here exceeds any such permissible overlap, particularly at the motion to dismiss stage, where the complaint must be viewed in the light most favorable to the plaintiff, and all factual allegations must be accepted as true. The language and reasoning of the District Court’s opinion demonstrates that it conflated the requirement that the invention be enabled and whether the subject matter is patentable.

The District Court points out that Claim 1 of the ’400 patent “does not set forth any technical details.” App. 14a. After reciting the steps of the claim, including “displaying an image, mapping a first point, moving the portable unit, identifying a new location, determining a first vector between the center of the screen of the portable unit and the new location and moving the center of the screen,” “nothing in that claim discloses *how* those steps are accomplished.” App. 14a. The “how to” accomplish these steps relates to enablement of the specification, rather than to whether the claims “identify ‘how’ [the] functional

result is achieved by limiting the claim scope to structures specified at some level of concreteness” as appears to be required by Section 101. *Am. Axle*, 967 F.3d 1285, 1302. As Judge Reyna recognized in dissent in *Amdocs*, the level of *how* required to satisfy the eligibility inquiry is not especially exacting: “the recited way of accomplishing the goal need not be extensively detailed or even complete. Rather, it must meaningfully limit the claim to a manner of achieving the desired result without unduly foreclosing future innovation.” See *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1315 (Fed. Cir. 2016) (Reyna, J., dissenting).

Here, the steps recited in the claim language itself provide the necessary level of detail to identify how the functional result is achieved (*i.e.* using vectored movements to superimpose a portion of a larger map over a virtual background image). The added requirement that the claims themselves must further explain “how” the steps are accomplished is not at issue for patent eligibility.

Other language in the District Court’s opinion is emblematic of the improper blending of Section 101 and Section 112 issues, including:

The technical details set forth in the [Sliding Windows] Patents are few. Those that are mentioned, however, lack the specificity to nudge the patents into the realm of patentable subject matter. App. 14a.

Even the more granular descriptions found in the *specifications* of the [Sliding Windows Patents] are vague. *Id.* (emphasis added). What additional information it does provide is not specific enough to identify a patent-eligible innovation. *Id.* at 15a.

Even assuming the idea embodied by the invention would improve computer functionality, the Sliding Windows Patents must still *disclose a particularized method* to accomplish it. *Id.* at 16a (emphasis added).

As is explained by Judge Moore, the “new blended [Section] 101/112 defense is confusing, converts fact questions into legal ones and eliminates the knowledge of a skilled artisan.” *Am. Axle*, 967 F.3d at 1316 (Moore, J., dissenting). The District Court’s decision suggests that even a claim for which a person of ordinary skill in the art would agree there is legally sufficient description in the specification could fall under Section 101, not because it claims an allegedly abstract idea, but because a court determines *on its own* that the claims failed to provide sufficient enabling detail for how the claimed invention is achieved. Unless this Court reconsiders whether, and to what extent, the District Court’s Section 112 considerations are improper in a Section 101

eligibility analysis this problematic practice will continue and further cause confusion and uncertainty as to patent eligibility.

C. The Lower Courts’ Refusal to Address the Issue of Preemption is Contrary to This Court’s Decision in *Alice*, and Undermines the Purpose of Section 101.

This Court should also grant certiorari to address the role of preemption in the Section 101 analysis. The Federal Circuit has strayed from this Court’s precedent, as have district courts following the Federal Circuit’s lead. This Court has instructed that the Section 101 analysis must distinguish between claims that “would risk disproportionately tying up the use of the underlying’ ideas, and are therefore ineligible” and claims that “pose no comparable risk of pre-emption, and therefore remain eligible.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 73) (citation omitted). Accordingly, this Court has directed lower courts to examine the extent of preemption when conducting a Section 101 analysis. However, the Federal Circuit, and thus, the district courts, have not followed the Supreme Court’s guidance.

After the Supreme Court decided *Alice*, the Federal Circuit in *Ariosa Diagnostics, Inc. v. Sequenom, Inc.* stated that “questions on preemption” are somehow necessarily “resolved” in the Section 101 analysis, seemingly allowing courts to ignore preemption as a consideration. 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. For this reason,

questions on preemption are inherent in and resolved by the [Section] 101 analysis.”) (citation omitted). *Ariosa* also muddied the waters by coining so-called “complete preemption,” a term not found in *Mayo* or *Alice*. (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility....Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.”). *Id.*

Facially, the phrase “complete preemption” may tie to the Supreme Court’s concern about “disproportionate” levels of preemption. “Complete preemption” also implies some legally-significant, lesser degree of preemption of using a natural phenomenon that would shift a claim into being found patent-eligible. However, this “complete preemption” language from *Ariosa* has been morphed into a tool used by courts to *ignore* preemption entirely, divorcing the Section 101 inquiry from its very foundation. As illustrated in the present case, some lower courts have concluded that if “complete preemption” is not required, then preemption itself—the primary underlying concern for Section 101 as expressed in this Court’s precedent—is no longer relevant to any extent to the Section 101 analysis.

This language from *Ariosa* (or similar language) has been used repeatedly as the sole basis to reject a patentee’s attempt to raise lack of preemption. See, e.g., *Return Mail, Inc. v. United States Postal Serv.*, 868 F.3d 1350, 1370 (Fed. Cir. 2017), *rev’d on other grounds*, 587 U.S. ---, 139 S. Ct.

1853 (2019); *Intell. Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1321 (Fed. Cir. 2016); *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1150 (Fed. Cir. 2016). A common rationale the Federal Circuit has stated to justify ignoring preemption risk is that “the lack of preemption risk cannot save claims that are deemed to only be directed to patent-ineligible subject matter.” *E.g.*, *Return Mail*, 868 F.3d at 1370. But this reasoning nonsensically presumes the *conclusion* of ineligibility without addressing the *basis* of ineligibility. Preemption risk is the *sine qua non* of the patent-eligibility determination, as repeatedly confirmed by this Court, and therefore arguments and evidence showing a lack of preemption risk should not be summarily cast aside.

Notably, in other cases, some Federal Circuit panels have used the lack of preemption as a key factor to explain why certain claims *are* patent-eligible. In *McRO, Inc. v. Bandai Namco Games Am. Inc.*, this Court highlighted that specificity *and* lack of preemption are relevant at Step One. 837 F.3d 1299, 1316 (Fed. Cir. 2016) (emphasis added) (“By incorporating the specific features of the rules as claim limitations, claim 1 is limited to a specific process for automatically animating characters using particular information and techniques *and* does not preempt approaches that use rules of a different structure or different techniques.”) (emphasis added). Further, in *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, the Federal Circuit relied on preemption as the *sole basis* to distinguish four prior decisions of this Court that found ineligibility. 827 F.3d 1341, 1352 (Fed. Cir. 2016) (discussing *Intell. Ventures I LLC v. Cap. One Bank (USA)*, 792 F.3d

1363, 1371 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014), *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715-16 (Fed. Cir. 2014); and *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344-45 (Fed. Cir. 2013)). The claims in these four cases “claim an abstract idea implemented on generic computer components, without providing a specific technical solution beyond simply using generic computer concepts in a conventional way.” 827 F.3d at 1352. The sole basis for that conclusion relied on finding that those invalidated claims “**preempted all use** of the claimed abstract idea,” and were therefore patent-ineligible. *Id.* (emphasis added). The decisions and rationale of different Federal Circuit panels regarding preemption are thus confusing and inconsistent with each other.

Relatedly, some Federal Circuit precedents have equated preemption with a lack of specificity in the claims. *See, e.g., Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1298 (Fed. Cir. 2020) (discussing *Diamond v. Diehr*, 450 U.S. 175 (1981)) (emphasis added) (“The [Diehr] invention involved a new rubber-curing process with a **specific and detailed series of steps** (one of which included the use of a natural law) that **limited the possibility of preempting** the natural law itself.”); *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014) (distinguishing the instant claims from *Ultramercial*) (emphasis added) (“It is also clear that the claims at issue **do not attempt to preempt every application** of the idea of increasing sales by making two web pages look the same...Rather, they

recite a **specific way** to automate the creation of a composite web page....”). Accordingly, the absence of preemption—especially to a technically relevant extent, *e.g.*, the existence of alternative uses of the abstract idea outside of the claimed invention—may be a guidepost to explain why claims are “specific” enough.

Taken together, the Federal Circuit’s body of case law indicates specificity and preemption are *two sides of the same coin, not two different coins*. The Federal Circuit, however, has never articulated why preemption may inform or even control “specificity” (and therefore, eligibility) in some cases but not in others. Nor has this Court ever endorsed such an approach.

Due to the unpredictable application of the preemption doctrine, this Court should take the opportunity to return the Section 101 analysis to its original concern: whether claims “risk *disproportionately* tying up the use” of abstract ideas, laws of nature, or natural phenomena. *Alice*, 573 U.S. at 217 (emphasis added).

The District Court’s approach in this case—excising preemption from Section 101—and the Federal Circuit’s summary affirmance of the same is the very reason that this Court should grant certiorari. The District Court relegated preemption to a footnote that reveals its analytical shortcomings: it found preemption *irrelevant* unless raised by the accused infringer. App. 18a-19a, n.5 (citing *Return Mail*, 868 F.3d at 1370) (emphasis added) (“**Facebook does not raise preemption as a ground for dismissal**. In any event, the absence of complete

preemption does not render the [Sliding Windows] Patents any less abstract.”). The District Court not only acknowledged that Facebook ***did not raise preemption***, but also failed to consider preemption in its own analysis. Moreover, the District Court ***separated*** preemption from the *Alice* test, as a “ground for dismissal” untethered from Section 101. Regardless, the legal inquiry cannot be controlled by whether the accused infringer phrases its arguments to include the term preemption, as the District Court found here.

This case presents the ideal vehicle for resolving questions regarding the role of preemption for patent eligibility. The record here indicates that the Sliding Windows Patents do not disproportionately preempt the field of moving a portable unit to view an image, nor attempt to monopolize the use of motion in a particular technological environment. Petitioner’s briefing below identified specific implementations not covered by claim 1 of the ’400 patent—including actual approaches implemented by competitors within the field—and rebutted Facebook’s single paragraph attempting to argue otherwise. *See Gabara v. Facebook*, No. 20-2333, Dkt. 8 at 32, n.2, 40; Dkt. 14 at 16-17. Further, the PTAB’s decisions denying institution of an IPR indicate that “background image of a stationary map” meaningfully distinguishes the Sliding Windows Patents from prior art involving the same abstract idea of “moving a portable unit to view more of an image.” In short, there is no record evidence that the Sliding Windows Patents pose a risk of any significant or disproportionate preemption, much less complete preemption.

D. Unfairness, Uncertainty and Confusion Abound at the Federal Circuit and Lower Courts as to the Appropriate Application of Section 101

Contrary to the purpose of the Federal Circuit, Section 101 jurisprudence is simply not a clear, uniform body of law, as recognized by Judge Moore in her dissent in *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1319 (Fed. Cir. 2020) (dissenting). Indeed, as discussed herein, the Federal Circuit is divided in its approach to the appropriate Section 101 analysis. *Id.*

The Federal Circuit's "rulings on patent eligibility have become so diverse and unpredictable." *Id.* at 1357. Indeed, the former director of the USPTO, David Kappos, recognized that "current patent eligibility law truly is a mess" and "[this Court], [the] Federal Circuit, district courts and the USPTO are all spinning their wheels on decisions that are irreconcilable [and] incoherent." *U.S. Senate Subcommittee on Intellectual Property*, 116th Congress (2019) (Statement of David J. Kappos, Partner, Cravath Swain & Moore LLP), at 1 ([https://www.judiciary.senate.gov/imo/media/doc/Kappos %20Testimony.pdf](https://www.judiciary.senate.gov/imo/media/doc/Kappos%20Testimony.pdf)).

Simply put, every patent case involving Section 101 is now an arbitrary, "litigation gamble." 967 F.3d at 1361 (Newman, J., dissenting). This comes with terrible consequences. It is "destroying the ability of American businesses to invest with predictability." 977 F.3d at 1382 (Moore, J., concurring); *see also* 967

F.3d at 1357 (Newman, J., dissenting); 967 F.3d at 1361 (Stoll, J., dissenting).

Indeed, individual inventors such as Petitioner and inventor-started companies are the entities most likely to lose their patents due to patent ineligibility—not so-called patent trolls. See Mark A. Lemley and Samantha Zyontz, *Does Alice Target Patent Trolls?*, J. Empirical Legal Stud. (forthcoming, draft available at SSRN <https://ssrn.com/abstract=3561252>) (Mar. 26, 2020), p. 2 (“Lemley”). For example, a study conducted by Stanford law school professors of every District Court and Federal Circuit decision on the issue of patent eligibility from mid-2014 to mid-2019 has shown that Section 101 disproportionately affects solo-inventors and inventor-led businesses, stating that “patents were invalidated in ... a striking 73.4% of individual inventor and inventor-started company decisions,” and further finding that “[o]nly 13.8% of individual inventor decisions found the patents eligible outright.” Lemley at 24-25. This was less than half the rate for both other NPE’s and practicing entities. *Id.* Whether the significantly low rate of patent-eligibility is due to the quality of the patents asserted or some inequity in the application of Section 101 is unknown. Nevertheless, at a minimum, these statistics require a consideration of whether Section 101, as applied by the Federal Circuit and the district courts, is appropriately serving its gatekeeping function.

Moreover, the Federal Circuit affirmed district courts’ findings of patent ineligibility without opinion in more than half of the final decisions between mid-2014 and mid-2019. Lemley at 28. This represents a

failure of the Federal Circuit to provide guidance to the district courts regarding how to best analyze Section 101, and has sown even greater uncertainty as district court opinions stray ever further from the limited consistent guidance that has been offered by the Federal Circuit.

Under any circumstance, there is an overwhelming necessity for the Supreme Court to weigh in and recalibrate Section 101 patent eligibility. Without such guidance, the outcome of the analysis of Section 101 by the Federal Circuit and, by extension, the district courts will remain a roll of the dice.

E. A Decision on the Merits in *American Axle* Will Impact the Proper Disposition of this Case

The issues raised by *American Axle* in its petition for writ of certiorari include (a) the appropriate standard for determining whether a patent claim is “directed to” a patent-ineligible concept and (b) whether patent eligibility is a question of law for the court based on the scope of the claims or a question of fact for the jury based on the state of the art at the time of the patent. These same issues are raised in the instant Petition. A decision on the merits as to either of these issues will affect the ultimate outcome as to whether the Sliding Windows Patents are patent eligible.

In particular, as to the first issue, previously discussed in Section C.A., the District Court’s analysis of Step One of *Alice* is akin to the so-called “*Nothing More*” test identified by Judge Moore in her dissent in *American Axle*. See *Am. Axle & Mfg., Inc.* 967 F.3d at

1307–08 (Moore, J., dissenting). In particular, the District Court stated:

“In any event, although the [Sliding Windows] Patents offer a solution to this problem [i.e. losing bearings by repeatedly minimizing or magnifying the background image to view different areas] – moving the portable device itself rather than moving the image by scrolling on the screen of the device – they do *little more* than recite that idea and suggest how elements in a generic computer might be harnessed to accomplish the solution.”

App. 16a (emphasis added). To the extent that the Supreme Court grants the petition in *American Axle*, and ultimately rejects, modifies or clarifies this test, then the Court’s ruling would require reconsideration of the findings in the present action.

As to the second issue, previously discussed in Section C.B., the District Court improperly infused its Section 101 analysis with the “enablement” requirements set forth in Section 112, requiring every patent specification to sufficiently teach those skilled in the art how to make and use the claimed invention. Enablement raises distinct questions of fact for a factfinder to determine, and patent-eligibility is a matter of law. To the extent that this Court determines that questions of fact impact any aspect of the patent-eligibility inquiry, then that ruling also would require the Federal Circuit to reconsider the rulings in the present action.

Accordingly, Petitioner respectfully requests that, at a minimum, the Court hold this Petition

pending the outcome in *American Axle*. If the Court grants the petition in *American Axle*, then the Court should grant this Petition, vacate the judgment below, and remand this case to the Federal Circuit for further proceedings in view of any decision this Court may reach on the merits in *American Axle*.

CONCLUSION

The Court should grant certiorari in this case to address the patent eligibility irrespective of whether it grants the petition in *American Axle*. Notwithstanding, this case should be considered as a companion case to *American Axle*, as the Court may be able to provide guidance as to two judicially-created exceptions to Section 101—law of nature and abstract ideas.

Alternatively, if the Court grants the petition in *American Axle*, then the Court should grant this Petition, vacate the judgment of the Federal Circuit, and remand this case to the Federal Circuit for further proceedings in view of any decision this Court may reach on the merits in *American Axle*.

Respectfully submitted,

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FEBRUARY 7, 2022

APPENDIX

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**APPENDIX A — JUDGMENT OF THE UNITED
STATES COURT OF APPEALS FOR THE
FEDERAL CIRCUIT, FILED JULY 8, 2021**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2020-2333

THADDEUS GABARA,

Plaintiff-Appellant

v.

FACEBOOK, INC.,

Defendant-Appellee

Appeal from the United States District Court for the
Southern District of New York in No. 1:19-cv-09890-DLC,
Senior Judge Denise Cote.

JUDGMENT

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (MOORE, *Chief Judge*, REYNA and HUGHES,
Circuit Judges).

AFFIRMED. See Fed. Cir. R. 36.

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Appendix A

ENTERED BY ORDER OF THE COURT

July 8, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

**APPENDIX B — OPINION AND ORDER OF THE
UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF NEW YORK,
FILED SEPTEMBER 4, 2020**

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

19cv9890(DLC)

THADDEUS GABARA,

Plaintiff,

-v-

FACEBOOK, INC.,

Defendant.

September 4, 2020, Decided

September 4, 2020, Filed

OPINION AND ORDER

DENISE COTE, District Judge:

Defendant Facebook, Inc. (“Facebook”) has moved to dismiss this patent infringement action on the ground that the patents at issue claim patent-ineligible subject matter. *See* 35 U.S.C. § 101 (“Section 101”). For the reasons that follow, the defendant’s motion to dismiss is granted.

*Appendix B***BACKGROUND**

The following facts are drawn from the Second Amended Complaint (“SAC”) and documents integral to that pleading. Thaddeus Gabara (“Gabara”) alleges that Facebook is committing direct, induced, and contributory infringement of five U.S. patents: Nos. 8,930,131 (the “131 Patent”); 8,620,545 (the “545 Patent”); 8,836,698 (the “698 Patent”); 8,706,400 (the “400 Patent”); and 9,299,348 (the “348 Patent”). The SAC alleges infringement by three Facebook products: Facebook 360, 3D Photos, and Workplace by Facebook.

The Image Patents

Four of Gabara’s five patents concern the same subject matter and contain substantially similar specifications. The ’698 Patent was filed on December 26, 2011. The ’698 Patent is related to Patent No. 8,532,919 (the “919 Patent”), also filed on December 26, 2011. The ’545, ’400, and ’131 Patents -- filed on August 14, 2013; December 5, 2013; and April 21, 2014, respectively -- all claim priority to the ’919 Patent. The ’545, ’400, ’131, and ’698 Patents will be referred to as the Image Patents.

The Image Patents work with a “portable unit,” such as a smart phone, that can display portions of a background image that is larger than the unit’s viewing screen. The user of the unit moves the device to bring other portions of the background image into view. With this invention, the unit acts like a “Sliding Window” to provide views of the off-screen background image by moving the unit itself. The prior art technology, by contrast, requires the user to

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scroll on the portable unit in order to view an off-screen portion of the background image.

For example, consider a background image of a map displaying two cities: City A on the screen of the unit and City B out of view. If the user wished to move the view displayed on the device to City B, the prior art technology required the user to move the stationary background image by scrolling with her fingers. The Image Patents allow a user to view City B on the map by moving the portable unit itself. As alleged in the SAC, a significant benefit of the Image Patents is that they “take advantage of existing hardware that is commonplace in mobile devices, such as accelerometers and gyroscopes,” allowing the Image Patents to be deployed across a wide range of devices.

The '400 Patent is entitled “Method and apparatus of physically moving a portable unit to view an image of a stationary map.” It issued on April 22, 2014, and is representative of each of the four Image Patents.

The Abstract of the '400 Patent explains the invention as follows:

A background map remains stationary while a portable unit moves within a plane parallel to the screen of the portable unit. As the user moves the unit, images of the background map appear on the screen of the portable device. The user scans the stationary map presented on the screen of the portable unit. This has several benefits since now relative

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distances and angular displacements within the plane between objects that are outside of the range of the screen of the handheld unit can be immediately be [sic] located and placed into view on the screen of a portable unit. The handheld unit is like a Sliding Window which provides a view of this image of a stationary map lying in the background of the portable unit.

Figure 10a in the specification of the '400 Patent shows the prior art, in which the user had to move the background image itself. Figure 10b illustrates how the Image Patents operate by permitting the user to navigate across the background image by moving the device. Those illustrations are reproduced below:

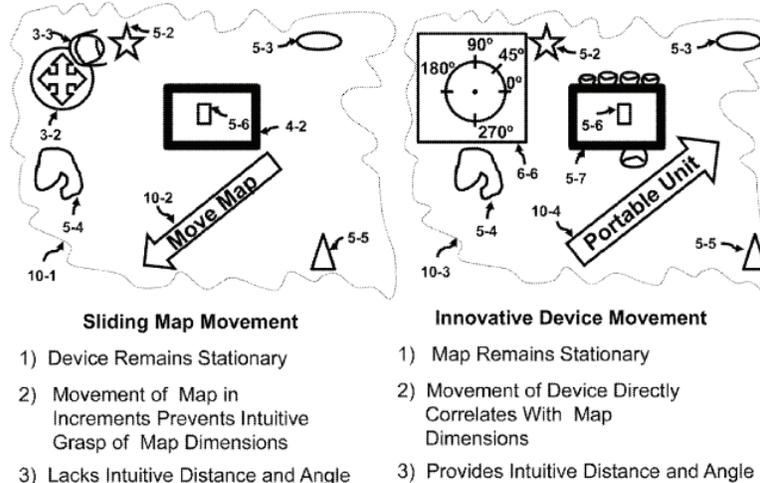


FIG. 10a

FIG. 10b

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The '400 Patent contains twenty-one claims: three independent claims and eighteen dependent claims. Claim 1 of the '400 Patent recites:¹

1. A method of moving a portable unit to search for a new location comprising the steps of:

displaying an image on a screen of the portable unit matched and superimposed to a corresponding portion of a background image of a stationary map;

mapping a first point of the display image located in a center of the screen of the portable unit to a corresponding reference point in the background image of the stationary map;

moving the portable unit to display a new portion of the background image of the stationary map on the screen;

identifying a new location in the new portion of the background image;

determining a first vector between the center of the screen of the portable unit and the new location; and

1. For the purposes of the § 101 analysis, Claim 1 of the '400 Patent is representative of all the claims in the Image Patents.

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moving the center of the screen of the portable unit to the new location as determined by the first vector.

The fifth patent on which Gabara brings suit is the '348 Patent. The '348 Patent, issued on March 29, 2016, is entitled, "Method and apparatus for obtaining information from the web." It is a continuation of an application filed on January 26, 2011. The invention operates on a "portable wireless system" to "improve the operations of a group" communicating electronically. As Gabara asserts in the SAC, the invention embodied in Claim 7 of the '348 Patent "extract[s] key information from the ongoing conversation and generat[es] additional topics to continue" the conversation. The invention "utilizes voice recognition, speech to text, and other blocks emulating various Finite State Machines (FSM)" to interact with the participants' conversation and provide new topics for discussion.

The '348 Patent contains three independent claims and sixteen dependent claims. The SAC identifies Claim 7 of the '348 Patent as "exemplary" and describes only that claim. In full, Claim 7 recites:

7. An intelligent conversation system augmenting, a conversation between two or more individuals comprising:

a determination circuit configured to segregate the conversation into topics and to extract search parameters from the topics, wherein the search parameters are sent to a search

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engine and search results corresponding to the search parameters are received from the search engine;

a memory configured to store the search results; and

a finite state machine configured to sequence through the search results to generate recall topics.

The '348 Patent does not describe how it improves upon the prior art. The SAC asserts that the invention in the '348 Patent “actively and dynamically contribute[s] to a conversation,” and that this is an improvement over existing technology that will only search for new topics when called upon to do so.

Procedural History

Gabara filed this action on October 25, 2019, claiming infringement of the '131 Patent. In November, Gabara filed a first amended complaint asserting infringement of four additional patents. Gabara is listed as an inventor of each of the five patents.²

In response to Facebook's motion to dismiss the amended complaint, Gabara filed the SAC on February 14, 2020. The SAC describes one claim from each of the

2. Gabara is a licensed patent agent and is named on over 125 patents.

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patents. Facebook filed the instant motion to dismiss the SAC on March 6, 2020. It became fully submitted on April 10.

Discussion

Facebook asserts that the five patents on which the plaintiff brings suit claim inventions ineligible for protection under § 101. “Whether a claim is drawn to patent-eligible subject matter under § 101 is a threshold inquiry, and any claim of an application failing the requirements of § 101 must be rejected even if it meets all of the other legal requirements of patentability.” *In re Bilski*, 545 F.3d 943, 950 (Fed. Cir. 2008) (citation omitted).

A patent is presumed to be valid. 35 U.S.C. § 282. The party challenging the validity of a patent bears the burden of proving invalidity by clear and convincing evidence. *See, e.g., Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1359 (Fed. Cir. 2007). Patent eligibility under § 101, however, is “an issue of law.” *Packet Intelligence LLC v. NetScout Sys., Inc.*, 965 F.3d 1299, 1307 (Fed. Cir. 2020) (citation omitted).

Pursuant to § 101, an inventor can patent “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. Abstract ideas as well as the laws of nature and natural phenomena, however, are not patentable under § 101. *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208, 216, 134 S. Ct. 2347, 189 L. Ed. 2d 296 (2014) (“*Alice*”).

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In *Alice*, the Supreme Court set forth a two-step framework for distinguishing patents that claim abstract concepts “from those that claim patent-eligible applications of those concepts.” *Id.* at 217. First, a court must “determine whether the claims at issue are directed to a patent-ineligible concept.” *Id.* at 218. If the claims are directed to an ineligible concept, a court proceeds to the second step and must look for an “inventive concept,” -- “i.e., an element or combination of elements that is sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the ineligible concept itself.” *Id.* at 217-18 (citation omitted).

“At *Alice* Step one,” the inquiry is trained on “the claimed advance over the prior art” and whether that claimed advance embodies a patent-ineligible concept. *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019) (citation omitted). Where the patent involves computer software, *Alice* step one requires a court to “articulate with specificity what the claims are directed to, and ask whether the claims are directed to an improvement to computer functionality versus being directed to an abstract idea.” *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1258 (Fed. Cir. 2017) (citation omitted).

The “mere automation of manual processes using generic computers . . . does not constitute a patentable improvement in computer technology.” *Trading Techs. Int’l*, 921 F.3d at 1384 (citation omitted). And, “claims are not saved from abstraction merely because they recite components more specific than a generic computer.”

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BSG Tech LLC v. Buyseasons, Inc., 899 F.3d 1281, 1286 (Fed. Cir. 2018). Instead, an asserted improvement in computer functionality must have “the specificity required to transform a claim from one claiming only a result to one claiming a way of achieving it.” *Ancora Techs., Inc. v. HTC Am., Inc.*, 908 F.3d 1343, 1349 (Fed. Cir. 2018), *as amended* (Nov. 20, 2018) (citation omitted).

The collection and analysis of information may also amount to no more than the statement of an abstract idea. The Federal Circuit has “treated analyzing information by steps people go through in their minds, or by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016) (collecting cases). On the other hand, “claims [that] are directed to a particular manner of summarizing and presenting information in electronic devices” may be eligible for patent protection. *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1362 (Fed. Cir. 2018).

At *Alice* step two, a court must determine whether the claimed invention, even if directed towards an abstract idea, embodies an inventive concept. In looking for an inventive concept, a court must consider the elements of the claims “both individually and as an ordered combination” to determine whether the additional elements have transformed the claim into a patent-eligible application. *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1347 (Fed. Cir. 2016) (citation omitted) (“*Bascom*”). “A claim contains an inventive

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concept if it includes additional features that are more than well-understood, routine, conventional activities.” *Smart Systems Innovations, LLC v. Chicago Transit Auth.*, 873 F.3d 1364, 1374 (Fed. Cir. 2017) (citation omitted). “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.” *BSG Tech LLC*, 899 F.3d at 1290-91. Again, the realization of an abstract idea on a generic computer does not itself constitute an inventive concept. *See Mortgage Grader, Inc. v. First Choice Loan Servs. Inc.*, 811 F.3d 1314, 1322 (Fed. Cir. 2016).

I. The Image Patents

The invention presented in the Image Patents is to move the portable device itself to view different portions of images displayed on portable devices. Moving the device to change one’s view of the image instead of scrolling on the device to change the view is an abstract idea. As each of the Image Patents explain, the invention is akin to moving a sliding window across an image. Other pertinent analogies are the physical acts of moving a telescope across the night sky or a magnifying glass across a map. Indeed, simply swiveling one’s head to look at a different portion of the landscape or of a room or of a newspaper page are comparable commonplace activities. In each instance, the object remains still and the observer moves her eyes or her device to focus on a different portion of the object.

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Nor is the abstract nature of the invention saved by a description of an improvement the invention makes to the functionality of the mobile device. The technical details set forth in the Image Patents are few. Those that are mentioned, however, lack the specificity to nudge the patents into the realm of patentable subject matter.

For example, insofar as the '400 Patent explains how the invention is realized, it recites a combination of conventional components of mobile devices and well-known algorithmic steps. Claim 1 of the '400 Patent does not set forth any technical details. The process of moving the viewing window is described in terms of the results displayed: “displaying an image,” “mapping a first point,” “moving the portable unit,” “identifying a new location,” “determining a first vector between the center of the screen of the portable unit and the new location,” and “moving the center of the screen.” Nothing in that claim discloses how those steps are accomplished.

Even the more granular descriptions found in the specifications of the Image Patents are vague. Take the section of the specification entitled “Detailed Description of the Invention” in the '400 Patent. In describing the process at the heart of the Image Patents -- translating portable device movement to a new view of the background image -- the specification states that an “inertial guidance system” gathers “information from the accelerometer and gyroscope sensors,” and sends that information to a “microprocessor.” Then, “[t]he microprocessor calculates (based on the acceleration, orientation scale of the map, and origin position) the new position of the map that should be displayed in the center of the screen.” That description

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offers little more detail than what is set forth in Claim 1. What additional information it does provide is not specific enough to identify a patent-eligible innovation. Inertial guidance systems, such as accelerometers, gyroscope sensors and microprocessors, are conventional computer components that the '400 Patent uses in their ordinary manner -- tracking the movement of the portable device. Similarly, the formulas used to calculate a vector are commonplace.

Nor does the discussion of prior art in the specifications of the Image Patents suggest that the invention is not an abstract idea. The Image Patents purport to solve a problem that arises whenever the screen on a portable device cannot display the entirety of an image. The '400 Patent explains that, when using the prior art method of moving the background image, a user must scroll on “the screen to get a bearing of where this particular item of interest is with respect to the initial requested destination” and then magnify the image to view the second point. Minimizing and magnifying the background image in this way causes the user to “lose bearing” and obscures the distance between the two points of interest in the background image. This description of the limitation in the prior art does not mean that the Image Patents themselves contain patentable subject matter.

First, the purported problem with the prior art is not a problem that arises only in the portable devices for which the inventions are intended. The Image Patents do not “meet a challenge unique to computer networks” or present “a technological solution to a technological problem”. *Packet Intelligence LLC*, 965 F.3d at 1309.

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A surveyor reading a map with a magnifying glass, for instance, might also lose her bearings by repeatedly minimizing or magnifying the background image to view different areas.

In any event, although the Image Patents offer a solution to this problem -- moving the portable device itself rather than moving the image by scrolling on the screen of the device -- they do little more than recite that idea and suggest how elements in a generic computer might be harnessed to accomplish the solution. Even assuming the idea embodied by the invention would improve computer functionality, the Image Patents must still disclose a particularized method to accomplish it. They provide no such particularity.³

In opposing this motion, Gabara principally argues that Facebook oversimplifies the Image Patents. He asserts that when considered with the specification, which is lengthy, Claim 1 of the '400 Patent is patent-eligible. Relying on *Core Wireless*, he maintains that the purported invention “recite[s] a specific improvement over prior systems, resulting in an improved user interface for electronic devices.” 880 F.3d at 1363. But, Claim 1 does not recite a specific improvement. As explained above, patentable material must not only disclose a desirable outcome; it must also explain how to realize that outcome. Claim 1 of the '400 Patent is directed towards the result -- moving a portable device to view portions of a background

3. Indeed, one asserted benefit of the claimed invention is its compatibility with virtually any portable electronic device, “such as cell phones, smart phones, iPads, Kindles, Blackberries, Navigation devices (Magellan or Garmin) and Android systems.”

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image. It does not set forth with any specificity a process to achieve it beyond applying generic computer processes in some vaguely defined way.

Gabara also disputes that Claim 1 of the '400 Patent is representative of all the claims in the Image Patents. "Courts may treat a claim as representative in certain situations, such as if the patentee does not present any meaningful argument for the distinctive significance of any claim limitations not found in the representative claim." *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (2d Cir. 2018). Gabara offers no meaningful argument in opposition to Facebook's assertion that Claim 1 of the '400 Patent is representative. Insofar as he disputes this at all, he does so in a lengthy appendix to his memorandum in opposition to this motion. That appendix far exceeds the page limits for his memorandum and could properly be ignored.⁴ In any event, the Court has examined the entirety of the four Image Patents. The other claims in the Image Patents are substantially similar to Claim 1 of the '400 Patent, with only semantic differences. None of those differences are material to the § 101 analysis undertaken in either the first or second step.

Turning to step two of the *Alice* framework, for many of the reasons that the inventions lack the specificity required to convert their idea into patentable subject matter, they also fail to contain an inventive concept. Simply put, the Image Patents are insufficiently inventive.

4. Gabara explains that he engaged an attorney "for a limited time period" to help prepare his opposition to the defendant's motion, but that he is appearing *pro se*.

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They purport to employ conventional computer hardware and processes, in an ordinary manner, to achieve the idea at the heart of the invention.

The SAC bluntly admits as much. It states, “the Image Patents take advantage of existing hardware that is commonplace in mobile devices . . . without the need for specialized equipment . . . user training, or . . . restrict[ions] to certain settings.” Nor do the other descriptions in the SAC or the Image Patents add in any material way to this description of the patents. The SAC asserts that the inventive concept is to “allow a wide variety of portable devices to reveal parts of images stored on the device by movement along a vector in one or more dimensions.” Or as expressed in another portion of the SAC, the Image Patents’ “improvements include the ability to dynamically adjust the viewing angle and depth of the image shown when the portable device is moved,” resulting in “an inventive way to view and experience visual content that was not available in the prior art.”

Gabara is correct that conventional components, arranged in a novel or unconventional fashion, can be inventive. The Image Patents, however, contain no such non-generic arrangement. The '400 Patent, for example, essentially reports that a generic computer would gather data and perform the necessary calculations. In order to qualify as an inventive concept, the Image Patents must do more than recite an abstract idea and its conventional application on a computer. Because they do not do so, they do not address patentable subject matter under § 101.⁵

5. Gabara argues that the Image Patents would not preempt

*Appendix B***II. The '348 Patent**

The core features of the '348 Patent are identifying topics in a conversation, searching the internet for those topics, and generating “recall topics” from the search results. Those features embody the abstract ideas of collecting, analyzing, storing, and retrieving data. These tasks predated computers. It is the same process, as Facebook points out, as a student recording a professor’s lecture in her notes, researching topics contained in those notes, and using the results of that research to inform questions for and interactions with the professor at the next lecture.

The '348 Patent’s purported invention is to apply the functionality of a computer to these tasks. As described in the patent, a computer uses conventional components such as memory, electronic circuits, and a generic search engine to execute the purported invention. Put differently, the '348 Patent “[s]tat[es] an abstract idea while adding the words ‘apply it with a computer.’”⁶ *Alice*, 573 U.S. at

future inventions that achieve the same result in different ways. Facebook does not raise preemption as a ground for dismissal. In any event, the absence of complete preemption does not render the Image Patents any less abstract. *See Return Mail, Inc. v. United States Postal Serv.*, 868 F.3d 1350, 1370 (Fed. Cir. 2017), *rev’d on other grounds*, 587 U.S. ___, 139 S. Ct. 1853, 204 L. Ed. 2d 179 (2019).

6. Gabara relies in part on the statement of the patent examiner who reviewed the '348 Patent. That examiner stated that all claims of the '348 Patent “are directed to processing a conversation, which is not an abstract idea.” Although the prosecution history of the patent is relevant to determining whether its subject matter is abstract,

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223. As *Alice* explained, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.*

Notably, the ’348 Patent does not describe any improvement in computer technology or functionality achieved through the patent. Nor does the ’348 Patent identify any deficiency in the prior art to which it is directed.

In the SAC, Gabara does claim a purported improvement in computer functionality. The SAC alleges that the ’348 Patent “improves on the existing functions of computers by allowing for a dynamic, responsive system that actively contributes new information and topics of interest to users during an ongoing conversation.” Even if it were appropriate to consider this explanation, which is not found in the ’348 Patent, the patent does not specify how this improvement will be achieved. And, of course, in determining whether a patent describes an improvement, a court “must analyze the asserted claims and determine whether they capture the[] improvements.” *Berkheimer*, 881 F.3d at 1369.

The claims in the ’348 Patent resemble those deemed abstract in *Intellectual Ventures I LLC v. Capital One*

the § 101 determination must be based on an analysis of the patent claims. *Berkheimer*, 881 F.3d at 1369. Insofar as the patent examiner characterized the ’348 Patent as directed towards extracting and processing information, that is an abstract idea. *See, e.g., Content Extraction & Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1349 (Fed. Cir. 2014).

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Fin. Corp., 850 F.3d 1332 (Fed. Cir. 2017). That claimed invention was directed towards “organizing, displaying, and manipulating data of particular documents” and then presenting the underlying data. *Id.* at 1341 (citation omitted). That patent, which was limited to a specialized computer language (XML documents), also recited generic computer components and was too abstract to achieve patent protection. *Id.* at 1341-42. For the same reasons, the ’348 Patent fails the step one analysis under § 101.

Gabara asserts that the ’348 Patent is analogous to the patent at issue in *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999 (Fed. Cir. 2018). There, the Federal Circuit held patent eligible claims reciting “a specific method for navigating through three-dimensional electronic spreadsheets.” *Id.* at 1008. The claimed invention “improv[ed] computers’ functionality as a tool able to instantly access all parts of complex three-dimensional electronic spreadsheets.” *Id.* Unlike the claims in the ’348 Patent, however, the claims at issue in *Data Engine* “require[d] a specific interface and implementation for navigating complex three-dimensional spreadsheets using techniques unique to computers.” *Id.* at 1009. The ’348 Patent teaches no such specific interface or implementation.

It bears emphasis that the ’348 Patent is vague. The specification describes a mobile device as one potential embodiment. But the invention is also compatible with “a portable system consisting of components that are magnetically and electronically coupled together,” and “an apparatus that allows the user to interact with an electronic system.” Such breadth of application further

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signals an abstract idea.

Proceeding to *Alice* step two, the '348 Patent lacks an inventive concept that could render it patent eligible. As explained above, the '348 Patent recites the abstract idea of extracting and processing information from a conversation and raising apposite prompts. Plainly, the abstract idea itself is not inventive; retrieving relevant information on the basis of prior topics is an ancient practice of human communication.

Accordingly, were there a novel concept in the '348 Patent, it would have to arise in the automation of that process. But the '348 Patent fails at *Alice* step two for many of the reasons it was deemed abstract at step one. The computer components recited in the '348 Patent are generic, not innovative: a “finite state machine,” “memory,” and a “circuit.” Those existed long before the invention claimed here. Furthermore, as the '348 Patent specification acknowledges, the process of enlisting a search engine to search the internet existed prior to the patent’s filing. *See* '348 Patent at 16:46-50 (“These topics are sent wirelessly to the network by RF Link and the network routes the topic list to WWW which is the World Wide Web, also known as the Internet, to search engines that perform searches on the recalled topics.”). Similarly, the specification recites that common computer components such as an “Audio Signal Analyzer Block,” “Determination Circuit Block,” or “Voice Recognition Block” could be involved in extracting search terms from the conversation. But, the patent does not describe a way to arrange the components it lists in any novel or

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non-conventional fashion. In essence, the '348 Patent lists components from a generic computer that would be useful to carry out the desired task. It does not actually describe how the purported invention works.

Nor does the '348 Patent solve a problem unique to computer-based conversation. See *Uniloc USA, Inc. v. LG Elecs. USA, Inc.*, 957 F.3d 1303, 1308 (Fed. Cir. 2020). In the SAC, Gabara asserts that the '348 Patent is an advance over the prior art because it “proactively” aids in continuing or improving a conversation. The problems that Gabara identifies as the target of the invention -- interruptions, disruptive speakers, or silences in conversations -- are commonplace, whether the conversation occurs on a computer or not.

Similarly, the solution presented in the '348 Patent -- generating new topics by linking them to what has been discussed -- is conventional. And the '348 Patent does not identify any particular aspect of digital communication that exacerbates those issues. For example, any conversation may falter and run out of topics. The '348 Patent describes one way of remedying that lapse -- searching the internet for new subjects. But, it does not recite a novel method to perform that function. Instead, it enlists generic computer components to assist in the generation of a new topic.⁷

7. Gabara's opposition to this motion asserts that the '348 Patent improves computer function by recalling the most recent topics as prompts for the interlocutors. This improvement does not appear in the '348 Patent itself or even in the SAC. Accordingly, it cannot provide the basis for determining that the patent embodies an inventive concept. See *Berkheimer*, 881 F.3d at 1369.

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Gabara principally argues that Facebook has misrepresented the '348 Patent to strip it of its inventive features. Relying on *Bascom*, Gabara maintains that “an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.” 827 F.3d at 1341. But neither the '348 Patent nor the SAC identifies how the purported invention is non-conventional or non-generic. In *Bascom*, the Federal Circuit upheld patent claims directed towards filtering content from the internet because they did not “merely recite the abstract idea of filtering content along with the requirement to perform it on the Internet, or to perform it on a set of generic computer components.” *Id.* at 1350. Instead, the *Bascom* patent described the prior-art filtering technology and recited a discrete improvement to that technology. *Id.* There, the patent leveraged the ability to associate the request for online content with a specific user to create bespoke filtering of internet content. *Id.* The claims therefore “recite[d] a specific, discrete implementation of the abstract idea of filtering content.” *Id.*

The '348 Patent, by contrast, is silent about the prior art or how it improves upon it. And as already explained, it lacks specificity in application that could render it more than the recitation of an abstract idea. The expansive and generic terms of the patent here are insufficient to spell out a concrete advance in technology and are not patentable under § 101.

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Conclusion

Facebook's March 6 motion to dismiss the SAC is granted. The Clerk of Court shall enter judgment for the defendant and close the case.

Dated: New York, New York
September 4, 2020

/s/ Denise Cote
DENISE COTE
United States District Judge

**APPENDIX C — DENIAL OF REHEARING OF
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT, FILED
SEPTEMBER 10, 2021**

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2020-2333

THADDEUS GABARA,

Plaintiff-Appellant,

v.

FACEBOOK, INC.,

Defendant-Appellee.

Appeal from the United States District Court for the Southern District of New York in No. 1:19-cv-09890-DLC, Senior Judge Denise Cote.

ON PETITION FOR REHEARING EN BANC

Before MOORE, *Chief Judge*, NEWMAN, LOURIE, CLEVINGER*, DYK, PROST, O'MALLEY, REYNA, TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*.**

* Circuit Judge Clevenger participated only in the decision on the petition for panel rehearing.

** Circuit Judge Cunningham did not participate.

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PER CURIAM.

ORDER

Thaddeus Gabara filed a petition for rehearing en banc. The petition was first referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue on September 17, 2021.

FOR THE COURT

September 10, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court