

## Eligibility and the U.S. Solicitor General

April 12, 2023 Dennis Crouch

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A decade ago, the US Supreme Court issued a pair of decisions that upended substantial aspects of patent practice. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012); and *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 573 U.S. 208 (2014). These cases appeared to broaden scope of the “abstract idea” and “law of nature” exclusions in ways that largely overlap with other patent law doctrines, such as obviousness and indefiniteness. But, unlike those doctrines, the subject-matter eligibility jurisprudence is more of free-wheeling approach based that typically does not require evidence. Many thousands of patents have been denied or invalidated under the expanded doctrine. Opponents of the change argue that it has created unpredictability, lack of respect for the law, and overreach that inhibits our culture of innovation historically fostered by the fuel of potential exclusive rights. One difficulty with the law here is that it is entirely judge made. The statute is clear that patents should be awarded to “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof” so long as the other requirements of patentability are met. 35 U.S.C. 101. The Supreme Court added the admittedly atextual gloss of excluding “laws of nature, natural phenomena, and abstract ideas.” And, although those limits have been longstanding, the court expanded their scope and simplified the procedures for invalidating patents in its *Mayo* and *Alice* decisions. A substantial number of prior petitions have asked the Supreme Court to clarify and revise its stance on Section 101 eligibility, but the Supreme Court has repeatedly denied certiorari.

**Most recently, the court asked for the views of the Solicitor General (CVSG) in two pending cases.** And, for the third time,

the SG has recommended that the court grant certiorari and revise its doctrine. In its briefing, the SG ties itself to the idea of “technological inventions” — arguing that “quintessentially technological inventions” should be patent eligible. “These cases would be suitable vehicles for providing much-needed clarification in this area.” *SG Brief*. A positive SG amicus brief usually indicates a high likelihood that the Supreme Court will hear the case.

The two parallel pending cases are:

- *Interactive Wearables, LLC, v. Polar Electro Oy*, 21-1281. Interactive Wearables asserts two patents covering a wearable content player connected to a screen-based remote control that permits users to view information about the song being played from the remote. U.S. Patent Nos. 9,668,016 and 10,264,311. The district court dismissed the case with prejudice on the pleadings for lack of eligibility. On appeal, the Federal Circuit affirmed without opinion.
- *Tropp v. Travel Sentry, Inc.*, 22-22. Tropp’s asserted patents claim a method of improving airline luggage inspection by selling TSA-labelled locks having a master key held by TSA authorities. If TSA needs to open the luggage for inspection, they use their key rather than cutting the lock. U.S. Patent Nos. 7,021,537 and 7,036,728. The district court found the claims ineligible on summary judgment. On appeal, the Federal Circuit affirmed with a non-precedential *per curiam* opinion. Importantly, Tropp does not claim to have created any new technology here, but rather a new process. Of course, Section 100 of the Patent Laws defines process to “include[] a new use of a known process, machine, manufacture, composition of matter, or material.”

In its brief filed jointly in both cases, the Solicitor General distinguishes between the inventions in *Interactive* and in *Tropp*; arguing that only the first represents a patent eligible invention because it is directed to the “scientific, technological, [or] industrial arts” rather than “non-technological methods of organizing human activity.”

*Properly construed, [the abstract idea] exception helps cabin Section 101's reach to patent law's traditional bailiwick of the scientific, technological, and industrial arts. The category of patent-ineligible abstract ideas thus does not encompass quintessentially technological inventions, like the improved content player that the patentee claimed in Interactive. By contrast, as the court of appeals correctly recognized, Section 101 excludes non-technological methods of organizing human activity like the luggage-inspection method claimed in Tropp.*

**SG Brief.** In looking at the court decisions, the SG also argued that the lower courts had unduly considered other doctrines such as novelty, obviousness, and enablement and overlaid them into the obviousness analysis.

*A court at step two therefore should ask whether a claimed invention sufficiently transforms an abstract idea into the kind of innovation eligible for patent protection. Rather than undertake that inquiry, however, the Interactive court placed undue emphasis on considerations of novelty, obviousness, and enablement. Although those considerations may sometimes overlap with the abstract-idea inquiry, they are the purview of different statutory provisions and perform different functions. See 35 U.S.C. 102, 103, 112. By contrast, the Tropp court correctly held that nothing in the claimed method transforms it into a technological invention.*

Id. Although not clear, the Supreme Court may consider whether to grant or deny certiorari in these cases as early as its May 18, 2023 conference. Meanwhile, a third eligibility case of *Avery Dennison v. ADASA* is also pending and could be taken-up on the same date.

It is of some importance here that the USPTO also signed the brief – indicating that it is on board with creating a *technological invention* dividing line.