

IN THE
Supreme Court of the United States

ALICE CORPORATION PTY. LTD.,

Petitioner,

v.

CLS BANK INTERNATIONAL AND CLS SERVICES LTD.,

Respondent.

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

**BRIEF OF PUBLIC KNOWLEDGE AS
AMICUS CURIAE IN SUPPORT OF RESPONDENT**

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TABLE OF CONTENTS

TABLE OF AUTHORITIES	(iii)
INTEREST OF <i>AMICUS CURIAE</i>	1
SUMMARY OF ARGUMENT	1
ARGUMENT	1
I. The Claims at Issue Are Ineligible Under Section 101 Because They Effectively Preempt Substantially All Uses of an Abstract Idea	1
A. A Seven-Line Computer Implementation of the Patented Technology Illustrates that the Claims Are Not Meaningfully Limited Beyond an Abstract Idea	1
B. Read with Proper Expansiveness, the Claims Cover Substantially All Computer Implementations of a Basic, Abstract Accounting Idea of Third-Party Escrow	3
C. The Court Should Disapprove the Preemption of Substantially All Computer Uses of an Abstract Idea, and Thus Hold the Claims at Issue Ineligible	5
II. The Court Should Proactively Clarify the Law of Subject Matter Eligibility in Order to Avoid Further Errors Relating to Abstract Ideas	7
A. The Court Should Enunciate the Inappropriateness of Using Specification Details to Evaluate Subject Matter Eligibility	8
B. The Court Should Reaffirm its Long-standing View that Mere Drafting Decisions, such as Choosing Between System and Method Claims, Do Not Affect Subject Matter Eligibility	9

(ii)

C. Recitation of Basic, Widely Available Platform Technologies, Regardless of De- tail, Cannot Render an Abstract Idea Patentable	10
CONCLUSION	11
APPENDIX A: Implementation of Claim 26 of the '375 Patent in Seven Lines of Computer Code	12
APPENDIX B: Claim 26 of the '375 Patent	18

TABLE OF AUTHORITIES

Cases

Bilski v. Kappos, 130 S. Ct. 3218 (2010) 1, 6, 10

Microsoft Corp. v. i4i Ltd. P’ship, 131 S. Ct. 2238
(2011) 1

Parker v. Flook, 437 U.S. 584 (1978) 5–6, 11

Quanta Computer, Inc. v. LG Elecs. Corp., 553 U.S.
617 (2008) 1

Statutes

35 U.S.C. § 101 (2013) 3, 5, 7–11

INTEREST OF *AMICUS CURIAE*

Public Knowledge is a non-profit organization that is dedicated to preserving the openness of the Internet and the public’s access to knowledge; promoting creativity through balanced intellectual property rights; and upholding and protecting the rights of consumers to use innovative technology lawfully. As part of this mission, Public Knowledge advocates on behalf of the public interest for a balanced patent system, particularly with respect to new and emerging technologies.

Public Knowledge has previously served as *amicus* in key patent cases. *E.g.*, *Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238 (2011); *Bilski v. Kappos*, 130 S. Ct. 3218 (2010); *Quanta Computer, Inc. v. LG Elecs. Corp.*, 553 U.S. 617 (2008).

SUMMARY OF ARGUMENT

*

ARGUMENT

- I. The Claims at Issue Are Ineligible Under Section 101 Because They Effectively Preempt Substantially All Uses of an Abstract Idea**
- A. A Seven-Line Computer Implementation of the Patented Technology Illustrates that the Claims Are Not Meaningfully Limited Beyond an Abstract Idea**

The claims use complex, technical-sounding language like “shadow accounts” that make the claim to appear

substantially limited beyond a mere abstract idea. However, a careful reading of the claims shows that this complex language does not in fact actually provide such substantial limitations.

To demonstrate this, we prepare a computer program that implements all the features of the claims. The computer program is very short, indicating that the verbose language of the claims does not in fact demand specific, particular implementations but rather can expansively cover all implementations.

```

10 LET account1 = 200.00
20 LET account3 = 300.00
30 INPUT "Value to exchange for transaction"; exchange
40 IF account1 < exchange THEN PRINT "Inadequate
    value" : STOP
50 account1 = account1 - exchange
60 account3 = account3 + exchange
70 PRINT "Instruction to 1st institution: adjust 2nd
    account by "; -exchange

```

Certain judges of the Federal Circuit were clearly misled by the claim language. They believed that the claim required particular, specific implementation details, due to the apparently technical language of the claims and the patent specification. However, our presented computer implementation shows these beliefs to be in error.

B. Read with Proper Expansiveness, the Claims Cover Substantially All Computer Implementations of a Basic, Abstract Accounting Idea of Third-Party Escrow

The example computer program shows that the asserted claims, though lengthy and technical in appearance, are actually directed only to a very simple, basic computer procedure. *Amicus* now turns to using this example computer program to show that the asserted claims are directed only to an abstract idea.

An abstract idea is [DEFINITION]. Claims directed merely to an abstract idea are not eligible under 35 U.S.C. § 101 (2013). Furthermore, inclusion of “insignificant” post-solution or pre-solution activity to an otherwise abstract idea does not render a claim eligible, as this Court has held, because otherwise any “competent draftsman” could circumvent the limitations of patent eligibility.

As Respondents have argued, the claim is directed to nothing more than a general-purpose computer tied to the abstract idea of accounting by a third-party escrow. The following exposition will consider Claim 26, line by line, to determine that every claim element is an inherent aspect of this abstract idea, a standard component of a general-purpose computer, or insignificant pre- or post-solution activity.

Elements 1–2¹ of the claim describe ordinary components of a general-purpose computer. *See infra* p. 13. The “communications controller” and “first party device” are broad, general terms that encompass basic computer components for interacting with users. Furthermore,

¹Elements will be referenced by numbers corresponding to the claim reprinted in the appendix. *See* Appendix B *infra* p. 18.

these two components are only recited in conjunction with a step of receiving data, which as explained below is insignificant pre-solution activity.

Elements 3–5 describe basic recordkeeping operations inherent in the idea of third-party escrow. Although the claim language verbosely describes a “data storage unit” with “information about a first account” and second account, the computer implementation demonstrates that these claim elements in fact require nothing more than storing account balances—that is, recording two numbers in a computer. *See id.* at appx:claim:elements 3–5. Certainly one would necessarily store such account information as part of an escrow service.

Element 6 recites “a computer,” and as such only further describes a general-purpose computer.

Element 7 states that the computer must “receive a transaction.” Steps of receiving data have been held by this Court and others to constitute insignificant pre-solution activity. *See, e.g., Mayo*. As such, this claim element does not contribute to the eligibility of the claim.

Element 8 describes two steps to be performed by the computer, both of which are inherent in the idea of third-party escrow. First, the computer is tasked with “ensuring that said first party and/or said second party have adequate value” in their accounts. The computer code shows that this amounts to nothing more than a comparison, checking whether an account balance is greater than an amount to be transferred out of that account. *See infra* p. 15. This is a necessary operation performed by a third-party escrow broker, who must ensure that the parties’ accounts can satisfy the desired transaction.

Second, element 8 requires the computer to “electronically adjust said first account and said third account.” This is performed in two lines of computer code, one of which subtracts from the first account and the other of which adds to the third account. *See id.* Again, this is inherent in a third-party escrow service, which must adjust account balance records to account for a transaction.

Element 9 instructs that the computer “generate an instruction to said first exchange institution and/or said second exchange institution to adjust said second account and/or said fourth account.” Despite the fifty-nine-word length of this element, it reduces to a single computer operation of printing out a message describing the transaction that was just completed. *See id.* at appx:claim:element 9. This elementary output step is post-solution activity that should not contribute to the eligibility of the claim. *See Parker v. Flook*, 437 U.S. 584 (1978).

Accordingly, this claim is directed to nothing more than an abstract idea of third-party escrow, in conjunction with insignificant pre-solution and post-solution activity, and ordinary, albeit verbosely described, components of a general purpose computer.

C. The Court Should Disapprove the Preemption of Substantially All Computer Uses of an Abstract Idea, and Thus Hold the Claims at Issue Ineligible

Under this Court’s precedent, a patent claim is ineligible under § 101 if that claim has the practical effect of removing all uses of an abstract idea from the public domain. In the present case, the claim would have the practical effect of removing all uses of an abstract idea *on a*

general purpose computer from the public domain. The Court should find such a claim ineligible as well, for the following reasons.

First, the addition of a general purpose computer is no more significant than the addition of post-solution or pre-solution activity that the Court has previously held not to render an otherwise abstract idea patentable. Cases such as **mayo** and *Flook* have disregarded post-solution and pre-solution activity on the rationale that [it does not significantly contribute to the subject matter of the claim, and that any competent draftsman could render a claim patentable by simple and insignificant addition of such limitations]. The same applies to the addition of a general-purpose computer. It does not contribute significantly to the inventive aspect of the claim, and any competent draftsman could easily insert a general purpose computer.

Furthermore, the Court has reasoned that abstract ideas must remain unpatentable to ensure that the basic tools of innovation remain free to all. *See Bilski v. Kappos*, 130 S. Ct. 3218 (2010); **mayo**; **benson**. Allowing patents on those basic tools of innovation would hinder, rather than promote, the progress of technology. Computers are also a basic tool of innovation, which enable software developers to test out new ideas, improve on existing ones, and create new innovations. They are essential to the progress of technology. Allowing patents on abstract ideas merely implemented on general purpose computers would thus equally hinder the progress of technology.

Finally, strong policy considerations indicate that mere inclusion of a general purpose computer should not render an otherwise abstract idea patentable. Computers are in widespread use today, and are effectively un-

avoidable. Thus, while as a truly formal matter a general purpose computer is only one possible way of implementing an abstract idea, in a practical sense a general purpose computer is the only way of implementing almost any of the abstract ideas used in society today. Condemning the public to resort to pencil and paper to avoid patent infringement is a simply untenable demand.

The Federal Circuit's holding in **alappat** should not affect this conclusion. There, the lower court held that a general-purpose computer, when instructed to perform a specific program, becomes a special-purpose computer. This is simply a statement of how a computer works internally, and says nothing about the degree to which a patent claim is limited by incorporation of a general purpose computer.

For similar reasons, the mere recitation in a patent claim of computer hardware, not specifically related to the inventive aspects of the claim, should not affect eligibility of the claim. This would enable a clever draftsman to evade § 101.

II. The Court Should Proactively Clarify the Law of Subject Matter Eligibility in Order to Avoid Further Errors Relating to Abstract Ideas

The Supreme Court has taken numerous subject matter eligibility cases recently. It does so because the Federal Circuit is in a confused state about the law of § 101, primarily because a small faction of that court repeatedly applies incorrect analytical techniques to improperly find patents eligible even when this Court's precedents demand otherwise.

To clearly enunciate the law for the Federal Circuit and to prevent the need for further appeals, this Court

should explicitly reject those improper analytical techniques, some of which have been catalogued below.

A. The Court Should Enunciate the Inappropriateness of Using Specification Details to Evaluate Subject Matter Eligibility

In assessing whether a claim is ineligible under § 101, courts must consider the entire breadth of the claim. Claims directed to an abstract idea will still cover specific, concrete implementations of that abstract idea, so the mere fact that a claim covers a concrete implementation is no indicator that a claim is directed to eligible subject matter.

Nevertheless, certain judges of the Federal Circuit persistently err by relying on specific examples to find patent claims eligible. In the present case, the plurality opinion justified its finding that the system claims of the patents at issue were eligible, by selecting a complex-looking flowchart from the specification to point to the supposed complexity and concreteness of the claim. By doing so, they failed to contemplate the possibility that other, simpler, abstract ideas were *also* covered by that same claim—ideas such as the 14-line computer program presented in this brief.

Ironically, those same judges of the Federal Circuit criticize their opposed colleagues for failing to read the “claims as a whole.” It is in fact those opposed colleagues who have actually read the claims as a whole, contemplating the vast scope of what they cover. It is that plurality of the Federal Circuit, instead, who fails to read the claims as a whole, focusing wrongly on specific examples and obfuscatory language that misleadingly make abstract ideas appear patentable.

B. The Court Should Reaffirm its Longstanding View that Mere Drafting Decisions, such as Choosing Between System and Method Claims, Do Not Affect Subject Matter Eligibility

The formalistic approach favored by some judges of the Federal Circuit lends to easy circumvention by clever patent drafting. For example, the suggestion that the method claims in the present case are ineligible, while system claims directed to the same technology are eligible, simply encourages patent applicants to use system claims in order to skirt the abstract ideas test.

Granting such weight to mere formal drafting practices ignores the basic rationale behind the Supreme Court's exceptions to § 101. In explaining the basis for the three exceptions to § 101, this Court has applied the fundamental principle that patents must ultimately incentivize innovation. While patents on many inventions do serve this principle, patents to abstract ideas, laws of nature and physical phenomena would in fact deter innovation by taking away those "basic tools of research available to all."

Several judges of the Federal Circuit ignore this basic rationale. Judge Rader, for example, has intimated that the three exceptions to § 101 are essentially tautological, because one "cannot invent an abstract idea, law of nature or physical phenomenon" since they have been around the whole time.

This unduly narrow, formalistic view of the exceptions to § 101 fails to adequately protect the concerns about incentives for innovation explicitly relied upon by this Court. Under Judge Rader's view, mere addition of even the most insignificant step to an otherwise abstract method would suddenly make that abstract

method patentable, because the combination would not have existed before. The Court has specifically denounced this possibility, in holding numerous times that insignificant post-solution activity and pre-solution activity cannot render an otherwise abstract idea patentable.

C. Recitation of Basic, Widely Available Platform Technologies, Regardless of Detail, Cannot Render an Abstract Idea Patentable

The Federal Circuit repeatedly cites recitations of basic general purpose computing hardware as evidence that a claim is directed to eligible subject matter under § 101. This is often done by overstating this court’s dicta in *Bilski*, that the “machine or transformation” test is an “important clue” in assessing subject matter eligibility.

The Court should clarify that mere recitation of general purpose platform technologies, such as general purpose computers, cannot render an otherwise ineligible claim eligible. Such a holding would be consistent with this Court’s precedent, and more importantly would strongly advance the principles of incentivizing innovation, by protecting those “basic tools of innovation” meant to be “available to all.”

As an analogy, consider a claim directed to the basic idea of addition, performed with paper and pencil. The paper and pencil could be described in great detail:

Drawing one or more numerical figures, with a pencil comprising a wooden shaft substantially in the shape of a hexagonal prism, the wooden shaft surrounding a cylindrical graphite barrel, the wooden shaft having a distal end including a rubber eraser, the

wooden shaft further having a proximal end sharpened to thereby expose a portion of the cylindrical graphite barrel.

Such a claim would certainly satisfy the machine-or-transformation test (a pencil is a machine of sorts, and the adherence of graphite to paper would constitute transformation of matter, among other things), but certainly such a claim would not be eligible subject matter, regardless of the level of detail. This is because paper and pencil are the basic tools of invention. To permit the patenting of abstract ideas merely tied to such basic tools would be tantamount to permitting the patenting of those abstract ideas alone.

Certain judges of the Federal Circuit criticize this approach, believing that it improperly imports questions of novelty and obviousness into § 101. However, as this Court's precedent makes clear, this is not the case. *See Flook*.

CONCLUSION

For the foregoing reasons, *amicus* respectfully submits that the Court should affirm the district court.

Respectfully submitted,

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APPENDIX A

Implementation of Claim 26 of the '375 Patent in Seven Lines of Computer Code

The following seven-line computer program, written in the BASIC programming language, implements Claim 26 of the '375 Patent.

```

10 LET account1 = 200.00
20 LET account3 = 300.00
30 INPUT "Value to exchange for transaction"; exchange
40 IF account1 < exchange THEN PRINT "Inadequate
    value" : STOP
50 account1 = account1 - exchange
60 account3 = account3 + exchange
70 PRINT "Instruction to 1st institution: adjust 2nd
    account by "; -exchange

```

The subsequent text reviews the elements of the claim in detail and explains how a general-purpose computer, running the above computer program, would satisfy all the elements of the claim. For convenience, the entirety of the claim is reprinted in the next appendix.

CLAIM 26, PREAMBLE:

A data processing system to enable the exchange of an obligation between parties, the system comprising:

The preamble recites that the claim covers a general purpose computing system, called a "data processing system" by the claim language. The recitation that the system is "to enable the exchange of an obligation" is a statement of intended use, which should not contribute to the scope of the claim.

CLAIM 26, ELEMENTS 1–2:

a communications controller,
a first party device, coupled to said communications controller,

These elements recite general hardware inherent in a general purpose computer. A “communications controller” broadly refers to a component of a computer that receives and processes communications, and a “first party device” could refer to any computer hardware. A standard keyboard could potentially satisfy this limitation.

CLAIM 26, ELEMENTS 3–5:

a data storage unit having stored therein
(a) information about a first account for a first party, independent from a second account maintained by a first exchange institution, and
(b) information about a third account for a second party, independent from a fourth account maintained by a second exchange institution; and

COMPUTER CODE, LINES 10–20:

10 LET *account1* = 200.00
 20 LET *account3* = 300.00

These elements of the claim simply require that a computer store two numbers representing account balances. The “data storage unit” might be any computer storage component, such as a hard disk or memory. The “information about” the first and third accounts broadly encompass any account information, such as an account balance.

The recitations that the information be stored “independent from” various accounts maintained by exchange

institutions are simply statements of intended use, which should not contribute to the patentability of the claim. Petitioners have never suggested that the external exchange institutions are necessary parties to infringement of their claims.

The computer code implements these elements of the claim by instructing a computer to store two account balances, into variables named *account1* and *account3*.

CLAIM 26, ELEMENT 6:

a computer, coupled to said data storage unit and said communications controller, that is configured to

This element is simply further recitation of details about a general purpose computer. Any computer would necessarily be coupled to a data storage unit, so that it might access data for processing, and further be coupled to a communications controller, so that it may receive and output information.

CLAIM 26, ELEMENT 7:

(a) receive a transaction from said first party device via said communications controller;

COMPUTER CODE, LINE 30:

30 INPUT "Value to exchange for transaction"; *exchange*

According to this element, the computer receives a "transaction." An exchange of money between two accounts is one type of transaction. Thus, this element requires nothing more than receipt of an instruction to transfer money between two accounts.

The computer code implements this by requesting input of an amount of money to transfer between the first

and third account. Upon running this line of code, a computer would print out a prompt message, and then await an outside user to enter a number indicating the amount of money to transfer. The amount to exchange is stored in a variable named *exchange*.

CLAIM 26, ELEMENT 8:

(b) electronically adjust said first account and said third account in order to effect an exchange obligation arising from said transaction between said first party and said second party after ensuring that said first party and/or said second party have adequate value in said first account and/or said third account, respectively; and

COMPUTER CODE, LINES 40–60:

```
40 IF account1 < exchange THEN PRINT "Inadequate
    value" : STOP
50 account1 = account1 - exchange
60 account3 = account3 + exchange
```

This element describes two operations. First, a computer must check that at least one of the accounts has a large enough balance to permit the desired transfer of money (“ensuring that said first party...ha[s] adequate value in said first account”). Second, the computer must record the transfer by adjusting the balances of the accounts (“electronically adjust said first account and said third account”).

Note the substantial presence of inoperative language in this claim element. The recitation “in order to effect an exchange obligation arising from said transaction between said first party and said second party” does nothing more than reiterate that the computer is transferring money between accounts. Furthermore, the claim recites that the computer must ensure “adequate

value in said first account and/or said third account,” and the disjunctive “and/or” means that the claim element is satisfied if only one of those accounts is checked.

The computer code implements the step of checking the account balances at line 40, which halts execution (with STOP) if the balance of *account1* is less than the amount to be exchanged. The code implements the step of effecting the transfer at lines 50–60, which deducts the amount to be exchanged from *account1* and adds that amount to *account3*.

CLAIM 26, ELEMENT 9:

(c) generate an instruction to said first exchange institution and/or said second exchange institution to adjust said second account and/or said fourth account in accordance with the adjustment of said first account and/or said third account, wherein said instruction being an irrevocable, time invariant obligation placed on said first exchange institution and/or said second exchange institution.

COMPUTER CODE, LINE 70:

70 PRINT “Instruction to 1st institution: adjust 2nd
account by ”; *–exchange*

This claim element requires only that a computer output an instruction to perform the desired transfer of money. The claim element recites “an instruction to said first exchange institution and/or said second exchange institution,” but the disjunctive “and/or” means that a single instruction suffices. Similarly, the recitation of an instruction “to adjust said second account and/or said fourth account” only requires an instruction with regard to a single account.

The requirement that the instruction be “an irrevocable, time invariant obligation” is merely a statement of intended use that should not contribute to the patentability of the claim. An instruction is simply a text, and the recipient of the instruction chooses whether to treat that text as irrevocable or time-invariant. Although this claim language could plausibly have been defined in the specification to require some sort of special format for the instruction, Petitioners have never identified any such special definition in any of their briefs to this Court or the Federal Circuit, and the text of the specification contains neither term outside of the claims. Furthermore, even if these terms did have some special meaning, it would only dictate the content of the instruction text, and content of text does not contribute to patentability.

The computer code implements this element by causing a computer to print an instruction to adjust the second account. The instruction directs the first institution to deduct the amount *exchange* from the account.

APPENDIX B

Claim 26 of the '375 Patent

Numbers, in square brackets, have been inserted before each element of the claim, to assist in referring to claim elements within the brief.

A data processing system to enable the exchange of an obligation between parties, the system comprising:

- [1] a communications controller,
- [2] a first party device, coupled to said communications controller,
- [3] a data storage unit having stored therein
- [4] (a) information about a first account for a first party, independent from a second account maintained by a first exchange institution, and
- [5] (b) information about a third account for a second party, independent from a fourth account maintained by a second exchange institution; and
- [6] a computer, coupled to said data storage unit and said communications controller, that is configured to
- [7] (a) receive a transaction from said first party device via said communications controller;
- [8] (b) electronically adjust said first account and said third account in order to effect an exchange obligation arising from said transaction between said first party and said second party after ensuring that said first party and/or said second party have adequate value in said first account and/or said third account, respectively; and
- [9] (c) generate an instruction to said first exchange institution and/or said second exchange

institution to adjust said second account and/or said fourth account in accordance with the adjustment of said first account and/or said third account, wherein said instruction being an irrevocable, time invariant obligation placed on said first exchange institution and/or said second exchange institution.