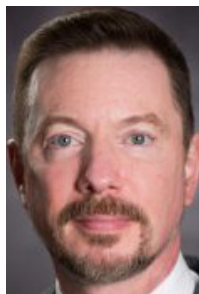


IP Frontiers: Yu v. Apple Inc.: Yet Another Alice Disaster



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In *Yangin Yu, Zhongxuan Zhang v. Apple Inc.* (Fed. Cir. June 11, 2021), hereinafter “*Yu v. Apple*,” the Federal Circuit majority proves there is a serious problem with its § 101 jurisprudence, which has expanded to the point of swallowing at least § 112 and, to an extent, § 102 and § 103. In this article, we explore the decision and the biting dissent. Subsequently, Yu filed a request for rehearing en banc, but that was denied.

Yu v. Apple is an appeal from the Northern District of California, in which the Court ruled in the defendant’s favor on a motion to dismiss. At issue is U.S. Patent No. 6,611,289 (hereinafter “the ‘289 patent”) concerning digital cameras. Claim 1 was treated as representative (bolding added):

An improved digital camera comprising:

a first and second image sensor closely positioned with respect to a common plane, said second image sensor sensitive to a full region of visible color spectrum;

two lenses, each being mounted in front of one of said two image sensors; said first image sensor producing a first image and said second image sensor producing a second image;

an analog-to-digital converting circuitry coupled to said first and said second image sensor and digitizing said first and said second intensity images to produce correspondingly a first digital image and second digital image;

an image memory, coupled to said analog-to-digital converting circuitry, for storing said first digital image and said second digital image; and

a digital image processor, coupled to said image memory and receiving said first digital image and said second digital image, producing a resultant digital image from said first digital image enhanced with said second digital image.

The bolded terms represent physical

camera components, one in each claim element. The District Court, despite all claim limitations including physical components, held the claim to be directed to the abstract idea of taking two pictures and using the pictures to enhance each other in some way. In so holding, the District Court also held the use of two pictures to enhance one has been done for over a century and that all recited components were well-known, routine and conventional.

To refresh, the Alice two-part test includes, in step one of the test, the Court determining “whether the claims at issue are directed to a patent-ineligible concept,” i.e., whether the claims are directed to a judicial exception to the expansive language of 35 U.S.C. § 101. *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014) (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 77 (2012)). The judicial exceptions handed down by the U.S. Supreme Court include abstract ideas, laws of nature and natural phenomena (including products of nature). If it is found that the claims are directed to a patent-ineligible concept, we then “examine the elements of the claim to determine whether it contains an ‘inventive concept’ sufficient to ‘transform’ the claimed abstract idea into a patent-eligible application.” *Id.* at 221 (quoting *Mayo*, 566 U.S. at 72–73, 78). In so doing, the elements of the claim are to be considered individually and as an ordered combination. See *Alice* at 217.

The Federal Circuit generally agreed with the District Court regarding the claims being directed to the abstract idea of taking two pictures, possibly at different exposures, and using one to enhance the other in some manner. The Federal Circuit noted that there was no dispute that the use of two pictures to enhance each other was long-practiced in photography. The Federal Circuit also agreed with the District Court that each camera component recited was well-known and conventional. One wonders whether “well-known and conventional” could be better addressed as prior art under § 102 and/or § 103, rather than § 101 patentable subject matter. Further, the Federal Circuit agreed with the District Court that the components were used to perform only their basic functions and the lim-

itations were set forth at a high degree of generality. The Court further found that the claims describe a generic environment in which to carry out the abstract idea. If a digital camera with specifically identified parts is a generic environment, then one has to wonder what is not considered a generic environment. The Federal Circuit gave short shrift to Yu’s argument that the claims recite an improved camera, actually quoting from *Alice* that not every claim that recites concrete, tangible components escapes the reach of the abstract-idea inquiry. That sounds to me like it is supposed to be more of a rare event, but it is treated as anything but rare by the Federal Circuit.

The Court also makes much of the embodiments in the specification of the ‘289 patent using an unclaimed four-camera array, one for each of red, blue and green, and a black and white camera, the addition of the black and white image being seen as the difference with or advance over the prior art. However, the Court never entertained the fact that a single camera imaging sensor can, and the vast majority do, include red, blue and green pixels, resulting in two image sensors, rather than separate ones, RGB and black and white. That would certainly be within the knowledge of one of ordinary skill in the art. Yet, at *Alice* step two, the Court derides Yu’s argument that claim 1 was found by the Examiner to be novel over several prior art references, simply indicating that novelty and subject matter eligibility are two separate things and novelty does not automatically mean eligibility. While that may be true, it should be an indication of an advance over prior solutions. Simply put, the Court found claim 1 to be lacking an inventive concept sufficient to transform the claim into one achieving subject matter eligibility.

A biting dissent penned by Judge Newman is more than worthy of discussion here. While Judge Newman’s dissent does not go beyond the § 101 issue, it is submitted that the ‘289 patent should be, if anything, concerned with indefiniteness. The reasoning would be that, in keeping with the Federal Circuit’s § 101 jurisprudence, claim 1 never actually describes *how* the second image is used to enhance the first image.

Judge Newman argued that claim 1 was direct-

ed to a camera, a mechanical and electronic device of defined structure and mechanism rather than some abstract idea. Here, here! Judge Newman further argued that, while claim 1 may or may not satisfy other patentability requirements, that does not convert a mechanical/electronic device into an abstract idea. This observation seems so obvious, yet it completely eludes the majority.

Judge Newman goes on to point out that in *Diamond v. Diehr* (Sup. Ct. 1981), the Supreme Court clarified that § 101 is a general statement of patentable subject matter, subject to other statutory requirements, i.e., § 102, § 103 and § 112. In other words, § 101 should be treated as a surface filter, not a road block.

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