

No. 16-1241

---

IN THE  
**Supreme Court of the United States**

---

BROADBAND ITV, INC.,

*Petitioner,*

v.

HAWAIIAN TELCOM, INC., ET AL.,

*Respondents.*

---

**On Petition for Writ of Certiorari to the United  
States Court of Appeals for the Federal Circuit**

---

MOTION FOR LEAVE TO FILE A BRIEF AS *AMICUS CURIAE*  
AND BRIEF OF *AMICUS CURIAE* ALIPHCOM D/B/A JAWBONE  
IN SUPPORT OF PETITIONER

---

SCOTT S. KOKKA\*

*\*Counsel of Record*

KENNETH R. BACKUS, JR.

PATRICK O. BENITO

KRISTEN S. CHUI

KOKKA & BACKUS, PC

1 Embarcadero Center, Suite 4150

San Francisco, CA 94111

skokka@kokkalaw.com

Dir.: (650) 566-9912

Fax: (650) 566-9922

*Counsel for Amicus Curiae*

---

**MOTION FOR LEAVE TO FILE A BRIEF AS  
*AMICUS CURIAE***

AliphCom (d/b/a Jawbone) (“Jawbone”) respectfully moves for leave to file the attached brief as *amicus curiae*. Consent of counsel for Petitioner has been obtained and consent of counsel for Respondent Hawaiian Telcom is also believed to have been obtained and confirmed. Consent of counsel for Respondent Oceanic Time Warner Cable LLC and Spectrum Management Holding Company, LLC f/k/a Time Warner Cable, Inc. (collectively, “TWC”) was requested, but affirmatively withheld.

Jawbone has a substantial interest in this case because it is a party to consolidated cases presently pending in the Court of Appeals for the Federal Circuit in which one of the same issues is before the court, namely, whether lower courts and tribunals such as the International Trade Commission (“the Commission”) may overturn the presumption of validity under 35 U.S.C. §282 by using a standard of proof apart from the clear and convincing evidence standard held to be applicable to §282 by the Court in *Microsoft Corporation v. i4i Limited Partnership et al.*, 564 U.S. 91 (2011). *AliphCom d/b/a Jawbone v. Int’l Trade Comm’n*, No. 16-2175 (Fed. Cir. filed June 3, 2016); *AliphCom d/b/a Jawbone v. Int’l Trade Comm’n*, No. 16-2187 (Fed. Cir. filed June 7, 2016; consolidated with No. 16-2175).

Jawbone has made substantial investments to patent its intellectual property found in some of the world’s most well known health, medical, and wearable technology products. By admission of the Commission, there is a split and uncertainty among the courts as to the proper standard of proof for

determining patent eligibility relative to 35 U.S.C. §282. Despite the Court's holding in *i4i*, there is significant confusion amongst lower courts and tribunals and, now, Executive branch agencies such as the Commission ("ITC"), as to the proper standard of proof creating uncertainty and weakness in the U.S. patent system which, in turn reduces motivation for new business and job creation. By its own admission, the Commission "...recognizes that the law remains unsettled as to whether the presumption of patent validity under 35 U.S.C. § 282 applies to subject matter eligibility challenges under 35 U.S.C. § 101." *Certain Activity Tracking Devices, Systems, and Components Thereof*, Inv. No. 337-TA-963, EDIS No. 577805 (Apr. 4, 2016) (Notice of Commission Determination to Review). Without a clear evidentiary standard and a constant threat of litigation and intellectual property loss, U.S. businesses are becoming increasingly hesitant to participate in the U.S. patent system, which stifles innovation, threatens a \$5 trillion intellectual property ecosystem, and suppresses the mainstay of the American economy: startups and small businesses. It is believed that the brief which *amicus curiae* is requesting permission to file will contain a more complete argument on the proper standard of proof and its effect on innovation and the global economy.

Jawbone therefore respectfully requests that the Court to grant it leave to file the accompanying *amicus curiae* brief in support of Petitioner.

Respectfully submitted,

SCOTT S. KOKKA\*

*\*Counsel of Record*

KENNETH R. BACKUS, JR.

PATRICK O. BENITO

KRISTEN S. CHUI

KOKKA & BACKUS, PC

1 Embarcadero Center, Suite

4150

San Francisco, CA 94111

skokka@kokkalaw.com

Dir.: (650) 566-9912

Fax: (650) 566-9922

*Counsel for Amicus Curiae*

May 12, 2017

## TABLE OF CONTENTS

	<b>Page</b>
MOTION FOR LEAVE TO FILE AN AMICUS CURIAE BRIEF BEFORE THE COURT'S CONSIDERATION OF A PETITION FOR A WRIT OF CERTIORARI .....	i
TABLE OF AUTHORITIES .....	vi
INTERESTS OF THE <i>AMICUS CURIAE</i> .....	1
SUMMARY OF THE ARGUMENT .....	2
INTRODUCTION .....	4
ARGUMENT .....	5
<b>1. UNDER 35 U.S.C. §282, PATENT ELIGIBILITY IS SUBSUMED BY THE PRESUMPTION OF VALIDITY AND IS OVERTURNED ONLY BY CLEAR AND CONVINCING EVIDENCE .....</b>	<b>5</b>
A. Patent Validity Includes, as a Part, Patent Eligibility, Which is Entitled to the Statutory Presumption of Validity Under 35 U.S.C. §282 .....	5
B. The Holding in <i>i4i</i> Sets Forth a Clear and Convincing Standard of Proof that is Required to Overturn the Presumption of Validity on All Grounds of Validity Under 35 U.S.C. §282, Including Patent Eligibility Under 35 U.S.C. §101 .....	7

<b>2. LOWER COURTS AND TRIBUNALS ARE BEING DRAWN INTO QUICKSAND BY THE JUDICIARY'S SPLIT APPROACH TO ANALYZING PATENT VALIDITY UNDER 35 U.S.C. §101</b> .....	10
A. And Now the International Trade Commission Follows the District Courts and the Silence of the Federal Circuit, Disregarding the Holding of the Court in <i>i4i</i> .....	10
1. The Commission and the District Courts Must Abide by the Holding of the Court in <i>i4i</i> and the Presumption of Validity.....	11
2. The Commission Disregards the Holding of this Court in <i>i4i</i> .....	11
3. The Commission Haphazardly Applies <i>i4i</i> in its Patent Eligibility Analysis Post- <i>Alice</i> .....	14
B. The District Courts are Split on Whether to Adhere to the Holding of this Court in <i>i4i</i> and the Presumption of Validity .....	15
<b>3. ARBITRARY AND INCONSISTENT STANDARDS OF PROOF WEAKEN THE PATENT SYSTEM, INNOVATION, JOB GROWTH, COMPETITION AND THE U.S. ECONOMY</b> .....	17
CONCLUSION.....	19

## TABLE OF AUTHORITIES

<b>Cases</b>	<b>Page</b>
<i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i> , 134 S. Ct. 2347 (2014) .....	2, 11, 12, 14
<i>In re TLI Commc’ns LLC Patent Litig.</i> , 87 F. Supp. 3d 773 (E.D. Va. 2015) .....	13, 16
<i>Microsoft Corp. v. i4i Ltd. Partnership</i> , 564 U.S. 91 (2011) .....	<i>passim</i>
<i>Radio Corp. of America v. Radio Engineering Laboratories, Inc.</i> , 293 U.S. 1 (1934) .....	8
<i>Ultramercial, Inc. v. Hulu, LLC</i> , 772 F.3d 709 (Fed. Cir. 2014) .....	12
<b>Statutes and Regulations</b>	<b>Page</b>
19 U.S.C. §1337(a)(1)(B) .....	11
35 U.S.C. §101 .....	<i>passim</i>
35 U.S.C. §282 .....	<i>passim</i>
<b>Other Authorities</b>	<b>Page</b>
<i>Certain Activity Tracking Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-963, EDIS No. 575628 (Mar. 3, 2016) (Initial Determination) .....	12, 13

<i>Certain Activity Tracking Devices, Systems, and Components Thereof</i> , Inv. No. 337-TA-963, EDIS No. 577805 (Apr. 4, 2016) (Notice of Commission Determination to Review) .....	ii, 8, 13
<i>Certain Automated Teller Machines, ATM Products, Components Thereof, and Products Containing the Same</i> , Inv. No. 337-TA-972, EDIS No. 584722 (June 28, 2016) (Initial Determination) .....	14
<i>Certain Light Emitting Diode Products and Components Thereof</i> , Inv. No. 337-TA-947, EDIS No. 589794 (Sep. 2, 2016) (Notice of Final Determination).....	15
<i>Certain Network Devices, Related Software and Components Thereof</i> , Inv. No. 337-TA-944, EDIS No. 575521 (Mar. 2, 2016) (Initial Determination).....	15
<i>Certain Network Devices, Related Software and Components Thereof</i> , Inv. No. 337-TA-944, EDIS No. 586600 (July 26, 2016) (Commission Opinion).....	15
<i>Certain Portable Electronic Devices and Components Thereof</i> , Inv. No. 337-TA-994, EDIS No. 588603 (Aug. 19, 2016) (Final Initial Determination).....	14

- David Pridham, *Five Ways President Trump Can Revitalize Our Damaged Innovation Ecosystem* (Nov. 17, 2016), [www.forbes.com/sites/davidpridham/2016/11/17/five-ways-president-trump-can-revitalize-our-damaged-innovation-ecosystem/#7da7d0c43e0a](http://www.forbes.com/sites/davidpridham/2016/11/17/five-ways-president-trump-can-revitalize-our-damaged-innovation-ecosystem/#7da7d0c43e0a) ..... 17
- Janice Williams, *China Could Beat U.S. Innovation With ‘Extraordinary’ Patent Growth* (Mar. 15, 2017), [www.newsweek.com/china-patent-growth-us-japan-innovation-beat-568258](http://www.newsweek.com/china-patent-growth-us-japan-innovation-beat-568258) ..... 18
- J.D. Harrison, *The decline of American entrepreneurship – in five charts* (Feb. 12, 2015), [https://www.washingtonpost.com/news/on-small-business/wp/2015/02/12/the-decline-of-american-entrepreneurship-in-five-charts/?utm\\_term=.89873892b56f](https://www.washingtonpost.com/news/on-small-business/wp/2015/02/12/the-decline-of-american-entrepreneurship-in-five-charts/?utm_term=.89873892b56f) ..... 18
- Jeffrey Sparshott, *Startups Remain Stuck: Job Creation From New Establishments Lags* (Apr. 26, 2017), [blogs.wsj.com/economics/2017/04/26/startup-s-remain-stuck-job-creation-from-new-establishments-lags](http://blogs.wsj.com/economics/2017/04/26/startup-s-remain-stuck-job-creation-from-new-establishments-lags) ..... 18
- Petition for a Writ of Certiorari, *Broadband iTV, Inc. v. Hawaiian Telcom, Inc.*, No. 16-1241 (petition for cert. filed Apr. 13, 2017). 6

**INTERESTS OF THE *AMICUS CURIAE*<sup>1</sup>**

AliphCom (d/b/a Jawbone) of San Francisco, California (“Jawbone”) is a world leader in consumer technology and wearable devices, building hardware products and software platforms powered by data science. The products and technology of Jawbone improve the daily lives of users through fitness, sleep, and many other health and medical tracking functions. Since its founding, Jawbone has made substantial investments developing innovative technologies, ranging from audio to wearable products.

---

<sup>1</sup> The present *amicus curiae* brief was authored in whole by counsel for the *Amicus Curiae*, AliphCom d/b/a Jawbone (“Jawbone”). Neither counsel nor any other party made any monetary contribution intended to fund the preparation or submission of this brief. Counsel of record for the parties received timely notice of Jawbone’s intent to file this brief and Petitioner provided its written consent in accordance with Supreme Court Rule 37.2(a). See Email from Charles Macedo, Amster, Rothstein & Ebenstein LLP, to Scott S. Kokka, Kokka & Backus, PC (May 9, 2017, 0305 PDT) (on file with author and filed herewith). Respondent, Hawaiian Telcom, Inc. will not oppose filing of the present *amicus curiae* brief and written consent is believed to have been given and confirmed. See Email from Scott S. Kokka, Kokka & Backus, PC to Brandon Stroy and copying Sasha Rao, Maynard Cooper & Gale, LLP (May 9, 2017, 1214 PDT) (on file with author and filed herewith). Respondents Oceanic Time Warner Cable LLC and Spectrum Management Holding Company, LLC f/k/a Time Warner Cable, Inc. have affirmatively withheld consent. See Email from David Eiseman, Quinn Emanuel Urquhart & Sullivan, LLP to Scott S. Kokka, Kokka & Backus, PC (May 11, 2017, 1637 PDT) (on file with author and filed herewith). Accordingly, Jawbone has filed a motion for leave to file this *amicus curiae* brief.

## SUMMARY OF THE ARGUMENT

The presumption of validity codified at 35 U.S.C. §282 requires clear and convincing evidence to overturn validity on any ground specified in Part II of Title 35 of the United States Code, including §101. Patent validity includes, as a part, the determination of patent eligible subject matter under 35 U.S.C. §101. *Microsoft Corporation v. i4i Limited Partnership et al.* held that clear and convincing evidence is required to overturn the presumption of validity on all grounds of validity, including patent eligibility under 35 U.S.C. §101. *See* 564 U.S. 91 (2011). However, lower courts ranging from the U.S. Court of Appeals for the Federal Circuit to the various district courts to, now, executive agencies such as the International Trade Commission (“the Commission”) are using either different standards of proof or no standard altogether.

The Commission is an independent, quasi-judicial federal agency established by Congress to administrate and enforce U.S. trades laws. The Commission is authorized to levy exclusionary remedies upon reaching a determination that an article imported into the United States infringes a valid and enforceable United States patent. In accordance with this Court’s holding in *i4i* and the statutory language of 35 U.S.C. §282(b), the Commission must analyze facts with clear and convincing evidence to arrive at invalidity under §101. Since *Alice Corp. Pty. Ltd. v. CLS Bank, Int’l*, 134 S. Ct. 2347 (2014), the Commission has evaluated the validity of patent claims haphazardly, principally due to the schism between district courts, and the silence of the Federal Circuit regarding

adherence to the presumption of validity under §101. This Court must affirm its holding in *i4i* and instruct the Federal Circuit to require the courts and tribunals to presume validity of patents under §101, whereby invalidity requires clear and convincing evidence.

If patents can be invalidated under various and arbitrary standards of proof for patent eligibility relative to validity this contradicts Congress' intent, contravenes this Court, and jeopardizes the U.S. patent system and economy. Weakened incentives and protections for U.S. are stifling innovation and reducing the number of new businesses; the largest source of new jobs in the United States. The Court must grant certiorari in the present Petition in order to arrest these detrimental effects to ensure the U.S. patent system and economy remain strong.

## INTRODUCTION

The current state of law governing the proper standard of proof for determining patent eligibility is confused, dysfunctional, and inconsistently applied across different courts and tribunals relative to overcoming the presumption of validity set forth in 35 U.S.C. §282. Various lower courts and tribunals including district and circuit courts of appeals, specialized federal trial courts, and, now federal trade agencies, including the International Trade Commission, are creating widespread confusion by misapplying, misinterpreting, or failing to use the proper standard of proof of clear and convincing evidence, as experienced first-hand by this *Amicus Curiae* in International Trade Commission Investigation No. 337-TA-963. Despite the clear holding of the Court in *i4i*, there is a widespread split as to the standard of proof leading to unsettled expectations as to the enforcement of a U.S. patent.

There is a presumption of validity accorded to a U.S. patent as codified under 35 U.S.C. §282, which requires, pursuant to the holding of the Court in *i4i*, that clear and convincing evidence is required to overturn validity. In other words, a patent is presumptively valid unless invalidated on any grounds specified in Part II of Title 35, which includes §101. The Court is urged to grant the present Petition to create consistency and stability in patent eligibility law across all courts and tribunals its holding in *i4i* to ensure that U.S. intellectual property remains valuable.

**ARGUMENT****1. UNDER 35 U.S.C. §282, PATENT ELIGIBILITY IS SUBSUMED BY THE PRESUMPTION OF VALIDITY AND IS OVERTURNED ONLY BY CLEAR AND CONVINCING EVIDENCE****A. Patent Validity Includes, as a Part, Patent Eligibility, Which is Entitled to the Statutory Presumption of Validity Under 35 U.S.C. §282.**

Congress in 35 U.S.C. §282 set forth invalidity of a patent as a defense to infringement. 35 U.S.C. §282(b)(2) clearly states “Invalidity of the patent or any claim in suit *on any ground specified in Part II* as a condition for patentability.” (emphasis added). Part II of Title 35 of the United States Code includes Section 101 and, as such, is a ground for patentability or invalidity. As a ground for validity, patent eligibility under 35 U.S.C. §101 can be overturned only by presenting clear and convincing evidence as set forth in *i4i*. See *Microsoft Corporation v. i4i Limited Partnership et al.*, 564 U.S. 91 (2011). As Petitioner has pointed out, numerous courts and tribunals are invalidating patents for patent ineligibility by applying incorrect and inconsistent standards of proof that were neither codified by Congress nor consistent with the Court’s jurisprudence. The U.S. Court of Appeals for the Federal Circuit, has remained silent, possibly as a signal to the Court that it must review a case that

presents the issue in a salient manner as Petitioner has done.<sup>2</sup>

The Court should grant the present petition because Congress did not make an exception for excluding Section 101 as a ground for invalidity for purposes of the presumption of validity under §282. Nor did Congress or this Court create a standard of proof for invalidating a patent for ineligibility that is different than that required for anticipation or obviousness. Congress also did not create an exclusion to carve out patent eligibility from the statutory presumption of validity found in Section 282, which requires clear and convincing evidence, as set forth by this Court in *i4i*.<sup>3</sup> 35 U.S.C. §282 clearly states “any” ground specified in Part II (of 35 U.S.C.) as a basis for invalidity, all of which are individually subject to the same presumption of validity and evidentiary standard of proof to overturn: Clear and convincing.<sup>4</sup> As set forth by the Court in *i4i*:

Section 282 requires an invalidity defense to be proved by clear and convincing evidence.<sup>5</sup>

Regardless of when (*e.g.*, at summary judgment, pursuant to a *Markman* proceeding, before a jury) invalidity is determined, such a determination can only be made with clear and convincing evidence.

---

<sup>2</sup> Petition for a Writ of Certiorari at pp.39-42, *Broadband iTV, Inc. v. Hawaiian Telcom, Inc.*, No. 16-1241 (petition for cert. filed Apr. 13, 2017).

<sup>3</sup> See *Microsoft Corporation v. i4i Limited Partnership et al.*, 564 U.S. 91 (2011).

<sup>4</sup> See 35 U.S.C. §282(b)(2) (2011).

<sup>5</sup> See *id.* at 101.

Neither Congress nor this Court have held that there are different standards of proof for determining invalidity by way of patent eligibility that are either fact-based or litigation stage dependent. If 35 U.S.C. §282(b)(2) states that any ground specified in Part II of Title 35 can be used to invalidate a patent, then the presumption of validity and its accompany clear and convincing standard of proof must apply to each and every one of those grounds.

B. The Holding in *i4i* Sets Forth a Clear and Convincing Standard of Proof that is Required to Overturn the Presumption of Validity on All Grounds of Validity Under 35 U.S.C. §282, Including Patent Eligibility Under 35 U.S.C. §101.

As set forth in the holding of *i4i*, the Court did not carve out exceptions, establish conditions or qualifications, or create different standards for the standard of proof required to overturn the validity of a United States patent.<sup>6</sup> In fact, the Court specifically rejected arguments to qualify the standard and burden of proof for the presumption of validity.<sup>7</sup> The holding was clear, concise, and applicable to all sections of 35 U.S.C. §282.<sup>8</sup>

The Court clearly indicated that the burden of proof to prove invalidity is on a challenger.<sup>9</sup> The Court also clearly indicated that a challenger must

---

<sup>6</sup> See *id.* at 99-114.

<sup>7</sup> See *id.* at 104-105.

<sup>8</sup> See *id.* at 91.

<sup>9</sup> See *id.*

prove invalidity by clear and convincing evidence.<sup>10</sup> Rejecting arguments by Microsoft that the presumption of validity is conditional or qualified, the Court in *i4i* reasoned, citing in part Justice Cardozo, the standard of proof for overcoming the presumption of validity was and is intended to be more than a “dubious preponderance” and instead the presumption can only be overcome by an expression of force.<sup>11</sup> Yet, despite the Court’s clarity in *i4i*, there exists a significant absence of guidance as to the presumption of validity relative to patent eligibility not just among the district courts, but across other tribunals in both the Judicial and now Executive branches of the federal government, as this *Amicus Curiae* has recently experienced before the Commission.<sup>12</sup>

By its own admission, the ITC states, “[T]he Commission recognizes that the law remains unsettled as to whether the presumption of patent validity under 35 U.S.C. §282 applies to subject matter eligibility challenges under 35 U.S.C. §101.”<sup>13</sup> The Commission further stated “...nor is the Commission aware of any definitive case law holding that the presumption applies in §101 eligibility challenges.”<sup>14</sup> If the standard of proof is clear and convincing and the Court has held that said standard

---

<sup>10</sup> *See id.*

<sup>11</sup> *See Radio Corp. of America v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1 (1934).

<sup>12</sup> *See Certain Activity Tracking Devices, Systems, and Components Thereof*, Inv. No. 337-TA-963, EDIS No. 577805 (Apr. 4, 2016) (Notice of Commission Determination to Review; presently on appeal to the U.S. Court of Appeals to the Federal Circuit).

<sup>13</sup> *See id.* at 2.

<sup>14</sup> *See id.*

should apply wholesale to 35 U.S.C. §282, then what standard are the lower courts and tribunals such as the ITC using to determine patent eligibility and why, given this line of reasoning, would they do so? Dubious preponderance? Highly probable? At present, neither this *Amicus Curiae* nor any party that presents itself to the ITC for trade protection for enforcement of its patents has any settled expectation.

Additionally, arguments that tribunals and courts are somehow, at the time of summary disposition, entitled to use a standard of proof that is less than clear and convincing are without merit or support from the body of jurisprudence governing patent invalidity and eligibility law. These arguments are not supported by the present jurisprudence and permitting the continued chaos invites an impermissible and ugly division to grow and fester separate standards of proof for determining patent eligibility relative to the presumption of validity under 35 U.S.C. §282. This was not the intent of Congress nor the jurisprudence of this Court, as shown in the Court's own discussion in *i4i*.<sup>15</sup> While *Amicus Curiae* agrees that mechanisms for dealing with bad patents and abusive patent litigation are imperative, arbitrary standards of proof for rendering patents invalid for ineligibility is tantamount, metaphorically, to "flooding the ship to save it from fire."

---

<sup>15</sup> See *i4i*, 564 U.S. at 99-114.

**2. LOWER COURTS AND TRIBUNALS ARE BEING DRAWN INTO QUICKSAND BY THE JUDICIARY'S SPLIT APPROACH TO ANALYZING PATENT VALIDITY UNDER 35 U.S.C. §101**

A. And Now the International Trade Commission Follows the District Courts and the Silence of the Federal Circuit, Disregarding the Holding of the Court in *i4i*.

As discussed earlier, the present *Amicus Curiae* notes the apparent split and lack of consistent standards of proof now occurring, for example, in tribunals other than district courts such as its own experience in the U.S. International Trade Commission (“Commission”). The Commission is an independent, quasi-judicial federal agency established within the Executive branch of the federal government to administer and enforce U.S. trade laws and disputes. One of the responsibilities of the Commission is to investigate and adjudicate disputes arising from unfair trade practices. Congress vests the Commission, under section 337 of the Tariff Act of 1930, with the power to investigate unlawful activities, including the importation of goods that allegedly infringe intellectual property rights such as U.S. patents within the U.S. market. Further, the Commission is authorized to levy exclusionary remedies upon reaching a determination that an article imported into the United States “infringe[s] a *valid* and enforceable United States patent . . . or are made, produced, processed, or mined under, or by means of, a process

covered by the claims of a *valid* and enforceable United States patent.” See 19 U.S.C. §1337(a)(1)(B). (emphasis added).

1. The Commission and the District Courts Must Abide by the Holding of the Court in *i4i* and the Presumption of Validity.

When determining validity of a patent, the Commission must presume that a U.S. patent is valid and that [t]he burden of establishing invalidity . . . shall rest on the party asserting such invalidity.”<sup>16</sup> “Invalidity of a patent . . . [may be pleaded] *on any ground* specified in *part II* as a condition of patentability.” See 35 U.S.C. §282(b) (part II clearly sets forth grounds for patentability under §101, §102, and §103) (emphasis added).<sup>17</sup> Importantly, this Court unambiguously held in *i4i* that “§282 requires an invalidity defense to be proved by clear and convincing evidence.”<sup>18</sup> Therefore, the Commission must analyze facts in view of a heavy burden such that any conclusion of invalidity must be made with clear and convincing evidence in its §101 analysis.

2. The Commission Disregards the Holding of this Court in *i4i*.

After *Alice*, the Commission recalibrated its analytic framework to determine patentability, under §101, as demonstrated in the matter of *Certain*

---

<sup>16</sup> See 35 U.S.C. §282(b)(2).

<sup>17</sup> See *id.*

<sup>18</sup> See *i4i*, 564 U.S. at 91.

*Activity Tracking Devices, Systems, and Components Thereof*, Inv. No. 337-TA-963, EDIS No. 575628 (Mar. 3, 2016) (Initial Determination).<sup>19</sup> In an example experienced by the present *Amicus Curiae*, the Commission eschewed any consideration of analyzing a patent in accordance with any presumption or burden of proof under §101. Administrative law judge Lord (“ALJ”) addressed whether to apply a presumption, and concluded “no presumption of eligibility applies” when deciding whether a patent claim meets the demands of section 101.<sup>20</sup> In the example encountered by *Amicus Curiae*, ALJ Lord quoted *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 720-721 (Fed. Cir. 2014) (Mayer, J., concurring): “[T]he Supreme Court has taken up several section 101 cases in recent years, [but] it has never mentioned—much less applied—any presumption of eligibility.”

However, as discussed above, eligibility is a ground for patentability under Part II of Title 35, which brings it under the presumption of validity, and, therefore, under the clear and convincing standard. In the cited examples above, ALJ Lord failed to apply this reasoning and ultimately rendered U.S. patents ineligible without applying the proper standard of proof with regard to the burden of

---

<sup>19</sup> See *Certain Activity Tracking Devices, Systems, and Components Thereof*, Inv. No. 337-TA-963, EDIS No. 575628 at 4 n. 3 (Mar. 3, 2016) (Initial Determination) (“It appears that patent eligibility has not been addressed by the Commission since the Supreme Court’s decision in *Alice*.”).

<sup>20</sup> See *id.* at 17 (citing *Wireless Media Innovations, LLC v. Maher Terminals*, 100 F.Supp.3d 405, 411 (2015)).

proof being on the Commission and Intervenors as challengers, pursuant to 35 U.S.C. §282.<sup>21</sup>

The Commission moderated and modified the approach set forth by ALJ Lord in its review of the Initial Determination, but equally disturbing, again stated its position that there appeared to be no case law addressing the appropriate standard of proof.<sup>22</sup> Specifically, the Commission stated:

The Commission recognizes that the law remains *unsettled* as to whether the presumption of patent validity under 35 U.S.C. §282 applies to subject matter eligibility challenges under 35 U.S.C. §101. See *In re TLI Commins, LLC Patent Litig.*, 87 F. Supp. 3d 773, 797 (E.D. Va. Feb. 6, 2015) (observing that neither the Supreme Court nor the Federal Circuit has addressed the issue and that “[a]s a result of this deafening silence, district courts, not surprisingly, are split over the standard of proof applicable to §101 challenges”). (emphasis added)<sup>23</sup>

Without providing rationale, the Commission concluded that regardless of whether a presumption is applied, the outcome would be the same either

---

<sup>21</sup> *Certain Activity Tracking Devices, Systems, and Components Thereof*, Inv. No. 337-TA-963, EDIS No. 575628 at 32.

<sup>22</sup> *Certain Activity Tracking Devices, Systems, and Components Thereof*, Inv. No. 337-TA-963, EDIS No. 577805 at 2.

<sup>23</sup> See *id.*

way.<sup>24</sup> Thus, the Commission saw failed to apply the presumption of validity under 35 U.S.C. §282 to patent eligibility (as a ground of invalidity) as mandated by the Court in *i4i*.

### 3. The Commission Haphazardly Applies *i4i* in its Patent Eligibility Analysis Post-*Alice*.

In one subset of determinations, the Commission asserts that the corresponding patent claims are not directed to patentable subject matter under §101. These determinations omit any reference to, or implementation of, a clear and convincing evidentiary standard. Other examples of Commission determinations also conclude that corresponding patent claims are directed to ineligible subject matter without regard as to whether a presumption of validity applies.<sup>25</sup>

In another subset of determinations, the Commission found that corresponding patent claims were not invalid under 35 U.S.C. §101, and, therefore, valid and directed to patentable subject matter. However, inexplicably, these example determinations of the Commission hypocritically applied the clear and convincing standard of proof of

---

<sup>24</sup> See *id.*

<sup>25</sup> See, e.g., *Certain Portable Electronic Devices and Components Thereof*, Inv. No. 337-TA-994, EDIS No. 588603 at 24-25 (Aug. 19, 2016) (Final Initial Determination); *Certain Automated Teller Machines, ATM Products, Components Thereof, and Products Containing the Same*, Inv. No. 337-TA-972, EDIS No. 584722 at 8 (June 28, 2016) (Initial Determination)(§101 Investigation terminated).

*i4i*.<sup>26</sup> Under what circumstances, conditions, facts, or reasoning can the Commission, or any lower court or tribunal, apply the clear and convincing standard of proof when finding claims are patent eligible and no standard of proof (or a lesser one) when finding claims are patent ineligible? The marked inequity and utter disregard of the holding in *i4i* demands the attention of the Court.

The arbitrariness in which the Commission (and other lower courts and tribunals) adjudicates patents under 35 U.S.C. §101 creates significant uncertainty and weakness to all issued U.S. patents despite their presumed validity. This uncertainty and weakness, in turn, reduces the effectiveness of the U.S. patent system as a vehicle by which U.S. patent owners may enforce intellectual property rights and protect U.S. businesses.

B. The District Courts are Split on Whether to Adhere to the Holding of this Court in *i4i* and the Presumption of Validity.

The Commission looks to the judiciary for guidance, but incongruities in the district courts and silence at the Federal Circuit provide no sustainable guidance to light the way for the administrative law

---

<sup>26</sup> See *Certain Network Devices, Related Software and Components Thereof*, Inv. No. 337-TA-944, EDIS No. 575521 at 43 and 292, (Mar. 2, 2016) (Initial Determination); see also, *Certain Network Devices, Related Software and Components Thereof*, Inv. No. 337-TA-944, EDIS No. 586600 at 49-50 (July 26, 2016) (Commission Opinion); *Certain Light Emitting Diode Products and Components Thereof*, Inv. No. 337-TA-947, EDIS No. 589794 at 280-281 (Sep. 2, 2016) (Notice of Final Determination).

judges and the Commission generally. A subset of district courts follow this Court's lead and require clear and convincing evidence with which to invalidate a patent. Other district courts ignore this Court's holding in *i4i* when determining patent eligibility, and hence validity, under 35 U.S.C. §101 without regard to the presumption under 35 U.S.C. §282. Examples of a split in approaches to §101 are set forth in footnote 48 of *In re TLI Commc'ns LLC Patent Litig*, 87 F. Supp. 3d 773, 797 n. 48 (E.D. Va. 2015).

### 3. ARBITRARY AND INCONSISTENT STANDARDS OF PROOF WEAKEN THE PATENT SYSTEM, INNOVATION, JOB GROWTH, COMPETITION, AND THE U.S. ECONOMY

Without guidance from the Federal Circuit or guidance from the Court, a growing split will continue to create chaos amongst various jurisdictions, creating unsettled and unpredictable expectations amongst those parties having substantial legal and financial interests in patenting such as present *Amicus Curiae*. To date, the present *Amicus Curiae* has invested the better part of a billion dollars to develop patented products protected by a global patent portfolio of thousands of properties that was built through the investment of hundreds of millions of dollars. It has enforced these matters around the world, including in numerous and various jurisdictions and tribunals across the United States. However, the present *Amicus Curiae* also has unsettled expectations and faces unpredictable conditions raising the difficulty to acquire and enforce its intellectual property while competing in the marketplace. If patents can be invalidated under various and arbitrary standards of proof for patent eligibility and validity, in contravention of Congress and the Court, a weakened patent system would threaten the innovation infrastructure of our nation and lessen a more than \$5 trillion a year ecosystem that employs more than a third of all U.S. employees in IP-intensive industries.<sup>27</sup> This lessens incentives

---

<sup>27</sup> See David Pridham, *Five Ways President Trump Can Revitalize Our Damaged Innovation Ecosystem* (Nov. 17, 2016), [www.forbes.com/sites/davidpridham/2016/11/17/five-ways-](http://www.forbes.com/sites/davidpridham/2016/11/17/five-ways-)

for businesses, startups and stalwarts alike, to rely upon patents as an effective tool for economic competition and protection in the marketplace on national and global trade fronts.<sup>28</sup> This weakening of U.S. patents because of erosion due to incorrect or inconsistent standards of proof for patent eligibility relative to patent validity is already having negative effects upon our nation's businesses' ability to compete and the number of new businesses starting up, the latter of which represent the largest source of job growth for the U.S.<sup>29</sup> If not arrested, trade imbalances will grow, U.S. innovation and global competitiveness will decrease, and the value of U.S. intellectual property and the number of jobs affected by weakened patents will fall.<sup>30</sup> In the views of the present Amicus Curiae, it is imperative the Court intervene and steer the lower courts and tribunals onto the clear and convincing standard for the standard of proof for patent eligibility as it relates to the presumption of validity.

---

president-trump-can-revitalize-our-damaged-innovation-ecosystem/#7da7d0c43e0a.

<sup>28</sup> See Janice Williams, *China Could Beat U.S. Innovation With 'Extraordinary' Patent Growth* (Mar. 15, 2017), [www.newsweek.com/china-patent-growth-us-japan-innovation-beat-568258](http://www.newsweek.com/china-patent-growth-us-japan-innovation-beat-568258).

<sup>29</sup> See Jeffrey Sparshott, *Startups Remain Stuck: Job Creation From New Establishments Lags* (Apr. 26, 2017), [blogs.wsj.com/economics/2017/04/26/startups-remain-stuck-job-creation-from-new-establishments-lags](http://blogs.wsj.com/economics/2017/04/26/startups-remain-stuck-job-creation-from-new-establishments-lags).

<sup>30</sup> See J.D. Harrison, *The decline of American entrepreneurship – in five charts* (Feb. 12, 2015), [https://www.washingtonpost.com/news/on-small-business/wp/2015/02/12/the-decline-of-american-entrepreneurship-in-five-charts/?utm\\_term=.89873892b56f](https://www.washingtonpost.com/news/on-small-business/wp/2015/02/12/the-decline-of-american-entrepreneurship-in-five-charts/?utm_term=.89873892b56f).

**CONCLUSION**

Based on the foregoing reasons, Jawbone respectfully requests that the Court grant the Petitioner's petition for writ of certiorari to affirm Congress and the Court's jurisprudence that the standard of proof for determining patent eligibility under 35 U.S.C. §101 as a ground of patent validity under 35 U.S.C. §282 requires clear and convincing evidence.

Very respectfully,

SCOTT S. KOKKA\*

*\*Counsel of Record*

KENNETH R. BACKUS, JR.

PATRICK O. BENITO

KRISTEN S. CHUI

KOKKA & BACKUS, PC

1 Embarcadero Center, Suite

4150

San Francisco, CA 94111

skokka@kokkalaw.com

Dir.: (650) 566-9912

Fax: (650) 566-9922

*Counsel for Amicus Curiae*

May 12, 2017