

Snap Judgment? Federal Circuit upholds motion to dismiss based on 35 U.S.C. § 101 Invalidity

YANBIN YU, ZHONGXUAN ZHANG v. APPLE INC., (CAFC, 06/11/2021)

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On June 11, 2021, The Court of Appeals for the Federal Circuit (the “CAFC”) [upheld](#) the Northern District of California’s grant of Apple’s and Samsung’s (collectively, the “Defendants”) Rule 12(b)(6) motion to dismiss Yanbin Yu and Zhongxuan Zhang’s (collectively, the “Patent Owners”) patent infringement action.

The patent in suit, [U.S. Patent No. 6,611,289](#) (the ‘289 patent), teaches a digital camera using multiple lenses to capture and combine several images for an enhanced final image. Despite the fact that it claimed a mechanical device, the Federal Circuit held that the ‘289 patent failed under Step 1 of the *Alice-Mayo* analysis because it merely covered the abstract idea of “using one picture to enhance another in some way[.]” a common practice of photographers for “over a century,” and included no specific improvement beyond the ineligible claimed concept. The CAFC considered the Patent Owners’ counterargument that the ‘289 taught a unique and specific improvement to camera technology functionality, but found a “mismatch” between a broadly claimed result and detailed technology taught only in the specification—the latter not being expressly claimed and the former failing to claim more than an idea with routine and conventional devices and components. This case seems to expand the CAFC’s commitment to the precedent that the “machine-or-transformation” test is not dispositive of eligibility under 35 U.S.C. § 101—adding cameras to a list that includes computers, garage door openers, and axles that do not pass *Alice/Mayo* Step 1 simply by virtue of being claimed.

The CAFC further found that the representative claim failed Step 2 of the *Alice-Mayo* test by generically claiming well-understood, routine, and conventional components and not transforming the abstract idea into a patent eligible invention. The Patent Owners argued that the invention cleared 35 U.S.C. §§ 102 and 103 novelty and non-obviousness requirements over multiple prior art references by virtue of a unique hardware configuration and architecture. But again, the CAFC found that recitation of novel subject matter does not necessarily confer eligibility—the representative claim still contemplated a generic configuration adding no substance to the abstract idea as claimed.

Finally, the CAFC found that the district court had not erred in making these determinations at the Rule 12(b)(6) motion to dismiss stage. The Court held that a determination of patent validity is appropriate, even absent expert testimony and disregarding allegations that contradict judicially noticed facts (such as a patent specification and claims) even in a technically complicated determination.

With the ongoing Supreme Court challenge to a similar CAFC outcome in *American Axle & Manufacturing Inc. v. Neapco Holdings LLC*, uncertainty shrouds this area of patent law. Likely, the vital connection between the subject matter taught in the specification and that which is specifically claimed is dispositive of whether the patent claims an ineligible concept or a new and useful technological advancement.