

**Nos. 2018-2103, -2228**

---

**In the United States Court of Appeals  
For the Federal Circuit**

---

THE CHAMBERLAIN GROUP, INC.,  
*Plaintiff-Appellee,*

v.

TECHTRONIC INDUSTRIES CO. LTD., TECHTRONIC  
INDUSTRIES NORTH AMERICA, INC., ONE WORLD  
TECHNOLOGIES, INC., OWT INDUSTRIES, INC., RYOBI  
TECHNOLOGIES, INC.,  
*Defendants-Appellants,*  
ET TECHNOLOGY (WUXI) CO. LTD.,  
*Defendant.*

---

Appeals from the United States District Court for the Northern District of Illinois  
in No. 1:16-cv-06097, Senior Judge Harry D. Leinenweber

---

**RESPONSE TO PETITION FOR REHEARING OR REHEARING EN BANC**

---

William R. Peterson  
MORGAN, LEWIS & BOCKIUS LLP  
1000 Louisiana St., Ste. 4000  
Houston, TX 77002  
(713) 890-5188

Sean C. Cunningham  
Erin P. Gibson  
Stanley J. Panikowski  
DLA PIPER LLP (US)  
401 B Street Suite 1700  
San Diego, CA 92101  
(619) 699-2700

Jason C. White  
Michael J. Abernathy  
Sanjay K. Murthy  
Nicholas A. Restauri  
MORGAN, LEWIS & BOCKIUS LLP  
77 W. Wacker Drive, Ste. 500  
Chicago, IL 60601  
(312) 324-1000

Julie S. Goldemberg  
MORGAN, LEWIS & BOCKIUS LLP  
1701 Market Street  
Philadelphia, PA 19103  
(215) 963-5095

*Counsel for Appellants*

---

### CERTIFICATE OF INTEREST

Counsel for Appellants Techtronic Industries, Co. Ltd., Techtronic Industries North America, Inc., One World Technologies Inc., OWT Industries, Inc., and Ryobi Technologies, Inc. certifies the following:

1. Full name of party represented by me	2. Name of real party in interest represented by me	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
Techtronic Industries, Co. Ltd.	Not applicable	None
Techtronic Industries North America, Inc.	Not applicable	None
One World Technologies Inc.	Not applicable	None
OWT Industries, Inc.	Not applicable	None
Ryobi Technologies, Inc.	Not applicable	None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (and who have not or will not enter an appearance in this case) are:

MORGAN, LEWIS & BOCKIUS LLP: Jesse T. Dyer, Caroline S. Lourgos, Margaret A. McGreal, James P. Looby, Thomas F. Hurka

DLA PIPER LLP (US): Steven J. Reynolds

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47. 4(a)(5) and 47.5(b).

None.

By: /s/ Jason C. White

Dated: November 12, 2019

William R. Peterson  
MORGAN, LEWIS & BOCKIUS LLP  
1000 Louisiana St., Ste. 4000  
Houston, TX 77002

Julie S. Goldemberg  
MORGAN, LEWIS & BOCKIUS LLP  
1701 Market Street  
Philadelphia, PA 19103

Sean C. Cunningham  
Erin P. Gibson  
Stanley J. Panikowski  
DLA PIPER LLP (US)  
401 B Street Suite 1700  
San Diego, CA 92101

Jason C. White  
Michael J. Abernathy  
Sanjay K. Murthy  
Nicholas A. Restauri  
MORGAN, LEWIS & BOCKIUS LLP  
77 W. Wacker Drive, Ste. 500  
Chicago, IL 60601

*Counsel for Appellants Techtronic Industries, Co. Ltd., Techtronic Industries  
North America, Inc., One World Technologies Inc., OWT Industries, Inc., and  
Ryobi Technologies, Inc.*

## TABLE OF CONTENTS

	<b>Page</b>
Certificate of Interest .....	i
Table of Authorities .....	iv
Introduction .....	1
Background .....	4
Reasons for Denying the Petition .....	8
I.    Chamberlain Waived Its Right to Seek a Remand on <i>Alice</i> 's Step Two.....	10
II.   The Panel Did Not Err in Resolving <i>Alice</i> 's Step Two.....	11
III.  The Panel Did Not Err in Failing to Analyze Alleged "Additional Features." .....	16
Conclusion & Prayer for Relief .....	19
Proof of Service .....	20
Certificate of Compliance .....	21

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>CASES</b>	
<i>Aatrix Software, Inc. v. Green Shades Software, Inc.</i> , 882 F.3d 1121 (Fed. Cir. 2018) .....	2, 12
<i>Affinity Labs of Tex., LLC v. DIRECTV, LLC</i> , 838 F.3d 1253 (Fed. Cir. 2016) .....	6, 16
<i>Affinity Labs of Texas, LLC v. Amazon.com Inc.</i> , 838 F.3d 1266 (Fed. Cir. 2016) .....	6
<i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i> , 573 U.S. 208 (2014).....	<i>passim</i>
<i>Amdocs (Israel) Ltd. v. Openet Telecom, Inc.</i> , 841 F.3d 1288 (Fed. Cir. 2016) .....	16
<i>Atl. Thermoplastics Co. v. Faytex Corp.</i> , 5 F.3d 1477 (Fed. Cir. 1993) .....	13
<i>Berkheimer v. HP Inc.</i> , 881 F.3d 1360 (Fed. Cir. 2018) .....	2, 12, 17
<i>Black &amp; Decker, Inc. v. Hoover Serv. Ctr.</i> , 886 F.2d 1285 (Fed. Cir. 1989) .....	12
<i>BSG Tech LLC v. Buyseasons, Inc.</i> , 899 F.3d 1281 (Fed. Cir. 2018) .....	9, 11, 13, 16
<i>Cellspin Soft, Inc. v. Fitbit, Inc.</i> , 927 F.3d 1306 (Fed. Cir. 2019) .....	17
<i>Content Extraction &amp; Transmission LLC v. Wells Fargo Bank, National Ass’n</i> , 776 F.3d 1343 (Fed. Cir. 2014) .....	17
<i>Dow Chem. Co. v. Nova Chems. Corp. (Canada)</i> , 809 F.3d 1223 (Fed. Cir. 2015) .....	8

**TABLE OF AUTHORITIES**  
(continued)

	<b>Page(s)</b>
<i>DSU Med. Corp. v. JMS Co.</i> , 471 F.3d 1293 (Fed. Cir. 2006) .....	9
<i>Easley v. Reuss</i> , 532 F.3d 592 (7th Cir. 2008) .....	8
<i>Elec. Power Grp. v. Alstom S.A.</i> , 830 F.3d 1350 (Fed. Cir. 2016) .....	15
<i>Haas v. Peake</i> , 544 F.3d 1306 (Fed. Cir. 2008) .....	10
<i>In re Dillon</i> , 919 F.2d 688 (Fed. Cir. 1990) .....	9, 18
<i>Int’l Rectifier Corp. v. Samsung Elecs. Co.</i> , 424 F.3d 1235 (Fed. Cir. 2005) .....	13
<i>JANA, Inc. v. United States</i> , 936 F.2d 1265 (Fed. Cir. 1991) .....	12
<i>Mayo Collaborative Servs. v. Prometheus Labs., Inc.</i> , 566 U.S. 66 (2012).....	16
<i>MyMail, Ltd. v. ooVoo, LLC</i> , 934 F.3d 1373 (Fed. Cir. 2019) .....	13
<i>Parker v. Flook</i> , 437 U.S. 584 (1978).....	16
<i>Pentax v. Robison</i> , 135 F.3d 760 (Fed. Cir. 1998) .....	8, 10
<i>Sec. &amp; Exch. Comm’n v. Chenery Corp.</i> , 332 U.S. 194 (1947).....	14
<i>Smithkline Diagnostics, Inc. v. Helena Labs. Corp.</i> , 859 F.2d 878 (Fed. Cir. 1988) .....	12

**TABLE OF AUTHORITIES**  
(continued)

	<b>Page(s)</b>
<i>Sony Elecs., Inc. v. U.S.</i> , 382 F.3d 1337 (Fed. Cir. 2004) .....	8
<i>Texas Instruments Inc. v. United States</i> , 922 F.2d 810 (Fed. Cir. 1990) .....	12
<i>Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC</i> , 874 F.3d 1329 (Fed. Cir. 2017) .....	16
<i>United States v. Bongiorno</i> , 110 F.3d 132 (1st Cir. 1997).....	10
<b>STATUTES</b>	
35 U.S.C. § 101 .....	1, 14, 15
<b>RULES</b>	
Fed. Cir. R. 40.....	8
Fed. R. App. P. 35 .....	8
<b>OTHER AUTHORITIES</b>	
Fed. Cir. IOP 13 .....	8

## INTRODUCTION

This Court should deny The Chamberlain Group, Inc.’s petition for rehearing and rehearing en banc. The panel correctly applied the *Alice* framework and this Court’s precedent to hold the asserted claims ineligible under Section 101. En banc review would neither resolve a disagreement among the Court’s decisions nor answer any exceptionally important question.

Chamberlain does not challenge the panel’s *Alice* step one determination that the asserted claims are directed to an abstract idea. Rather, Chamberlain requests, for the first time in its petition, a remand on step two. Thus, the only question presented on rehearing is whether the panel correctly determined—on an undisputed record—that the asserted claims do not recite significantly more than the abstract idea of “wirelessly communicating status information about a system.”

But Chamberlain waived its right to seek a remand on step two by failing to request such relief before the panel. It should not be permitted to raise such arguments in the first instance on rehearing.

Further, Chamberlain’s complaints rely on (i) incorrectly characterizing the nature of the claims, (ii) disregarding its own admissions regarding undisputed facts, and (iii) misapprehending the panel’s analysis. The undisputed record demonstrates that the asserted claims recite generic, “off the shelf” components. Indeed, in



response to a direct question from the panel, Chamberlain’s counsel admitted that all of the claimed components are generic:

Judge O’Malley: But are any of those improvements other than generic? A combination of generic components?

Ms. Brooks: There are no non-generic components in the movable barrier operator. The transmitter is generic. **The controller is generic. . . .**

Oral Argument Recording 23:52-24:08 (emphasis added).<sup>1</sup>

Given this concession, Chamberlain’s arguments—and the cases on which Chamberlain relies, including *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), and *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121 (Fed. Cir. 2018)—are immaterial.

The panel correctly resolved *Alice*’s step two. As Chamberlain admits, the claimed components are generic. The only purported “inventive concept” is the use to which the components are put: “wirelessly communicating status information about a system.” But using a transmitter to transmit is the antithesis of an “inventive concept.” The panel’s decision merely reaffirms this Court’s long-standing precedent that implementing an abstract idea (wirelessly transmitting information), using routine and conventional components (such as transmitters used to transmit),

---

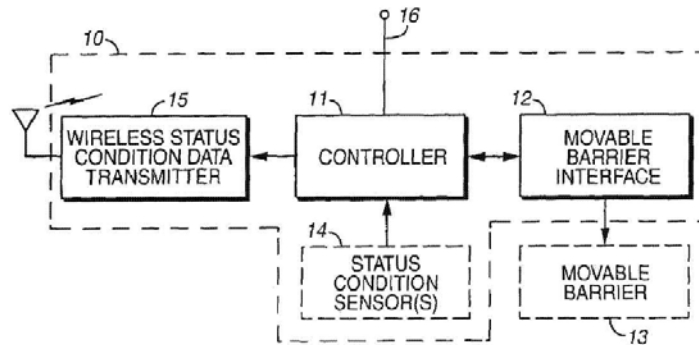
<sup>1</sup> Available at <http://oralarguments.cafc.uscourts.gov/default.aspx?fl=2018-2103.mp3>.

and applying a field-of-use restriction (garage door openers) do not constitute an inventive concept under *Alice*'s step two.

## BACKGROUND

Chamberlain’s U.S. Patent No. 7,224,275 (“the ’275 patent”) discloses detecting information about a movable barrier operator (*i.e.*, a garage door opener) and transmitting it wirelessly. Appx213 (Abstract: “A movable barrier operator (10) has a wireless status condition transmitter (15) that wirelessly transmits status condition messages to one or more remote peripherals (20).”).

Figure 1 of the ’275 patent illustrates a preferred embodiment:



**FIG. 1**

Appx214; Appx217 at 3:27-53. According to the patent, “the wireless status condition data transmitter 15 serves to transmit a status condition signal that represents a present operational status condition of the controller 11.” Appx217 at 4:64-67.

Claim 1 recites:

A movable barrier operator comprising:

a controller having a plurality of potential operational status conditions defined, at least in part, by a plurality of operating states;

a movable barrier interface that is operably coupled to the controller;

a wireless status condition data transmitter that is operably coupled to the controller, wherein the wireless status condition data transmitter transmits a status condition signal that:

corresponds to a present operational status condition defined, at least in part, by at least two operating states from the plurality of operating states; and

comprises an identifier that is at least relatively unique to the movable barrier operator, such that the status condition signal substantially uniquely identifies the movable barrier operator.

Appx219 at 8:5-21. The specification explains that the claimed controller, movable barrier interface, and wireless status condition data transmitter are all “well understood in the art.” Appx217 at 3:49-53 and 4:2-4.

Chamberlain accused Respondents Techtronic Industries Co. Ltd., Techtronic Industries North America, Inc., One World Technologies Inc., OWT Industries, Inc., and Ryobi Technologies, Inc. (collectively, “TTI”) of infringing the ’275 patent, and a jury found the patent valid in view of the prior art and infringed. Appx86. In denying TTI’s motions for judgment as a matter of law, the district court concluded under *Alice*’s step one that the claims were patent-eligible. Appx104-105.

TTI appealed, noting numerous errors in the district court's final judgment, including that the infringement and anticipation verdicts were unsupported by substantial evidence. In particular, TTI identified two errors in the district court's opinion denying TTI's motion for judgment as a matter of law regarding anticipation: (i) the prior art Menard reference does disclose a movable barrier operator (*i.e.*, garage door opener) system with a controller and transmitter, and (ii) Chamberlain's expert's testimony that a skilled artisan could, hypothetically, practice Menard without practicing the asserted claims is irrelevant: the correct inquiry is whether Menard discloses every limitation of the claimed invention, not whether Menard may also teach a separate non-anticipatory embodiment. Appellants' Br. 29-37.

The panel never reached infringement or invalidity because it held the claims patent-ineligible. The panel explained that the asserted claims are directed to the wireless transmission of data, which this Court has repeatedly held to be an abstract idea under *Alice*'s step one. Op. 6. (citing *Affinity Labs of Tex., LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016) and *Affinity Labs of Texas, LLC v. Amazon.com Inc.*, 838 F.3d 1266, 1269 (Fed. Cir. 2016)).

The panel rejected Chamberlain's principal argument that the mere fact that the claims recite a physical device means that they cannot be directed to an abstract idea. See Op. 8 ("Without more, the mere physical nature of C[hamberlain]'s claim

elements (*e.g.*, controller, interface, and wireless data transmitter) is not enough to save the claims from abstractness, where the claimed advance is directed to the wireless communication of status information using off-the-shelf technology for its intended purpose.”). As the Supreme Court explained, “mere recitation of a generic computer”—a physical device—“cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 223 (2014); *see also id.* at 224 (expressly rejecting the “any physical device” argument). Chamberlain’s petition does not challenge the panel’s step one analysis. *See* Pet. 12-17.

At *Alice*’s step two, the panel noted the specification’s concession that each individual element of the asserted claims is “well understood in the art.” Op. 9 (citing Appx217 at 3:27-4:4). The panel then explained that the only alleged “inventive concept” in the ordered combination of elements is its use for wireless communication, the very abstract idea that the claims are directed to. Op. 10. Chamberlain requests rehearing on the panel’s step two analysis.

### REASONS FOR DENYING THE PETITION

This Court disfavors panel rehearing and en banc review. “Panel rehearings are designed as a mechanism for the panel to correct its own errors in the reading of the factual record or the law.” *Easley v. Reuss*, 532 F.3d 592, 594 (7th Cir. 2008); *see also* Fed. Cir. R. 40(a)(4). En banc reconsideration should be granted only if it is necessary to maintain uniformity of this Court’s decisions or if the proceeding involves a question of exceptional importance. Fed. R. App. Proc. 35(a); *see* Fed. Cir. IOP 13(2); *Sony Elecs., Inc. v. U.S.*, 382 F.3d 1337, 1339 (Fed. Cir. 2004). When a panel opinion “is not viewed as having changed the law,” disagreement with the panel’s decision “is not a sufficient reason for en banc review.” *Dow Chem. Co. v. Nova Chems. Corp. (Canada)*, 809 F.3d 1223, 1227-28 (Fed. Cir. 2015) (Moore, J., joined by Newman, O’Malley, and Taranto, JJ., concurring in denial of rehearing en banc).

Chamberlain has failed to identify an error in the reading of the factual record or the law to support panel rehearing. Nor has it identified any departure from this Court’s decisions.

Rehearing and en banc review are inappropriate when a “new theory [is] raised for the first time in [a] petition for rehearing.” *Pentax v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998). Chamberlain waived the remand relief it now seeks because it never requested a remand on step two or argued that such a remand was

necessary to resolve the parties' dispute. Its belated request should be rejected for this reason alone.

Even so, the panel did not err or depart from this Court's prior decisions regarding step two when all of the claim elements used to implement the abstract idea are indisputably conventional and well understood. Appx217 at 3:49-53 and 4:2-4. And the panel's step two analysis tracks that of *BSG Tech LLC v. Buyseasons, Inc.*, where this Court held "[i]f a claim's only 'inventive concept' is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea." 899 F.3d 1281, 1290-91 (Fed. Cir. 2018).

The purpose of rehearing is not "to second-guess the panel on the facts of a particular case." *In re Dillon*, 919 F.2d 688, 700 n.3 (Fed. Cir. 1990) (Newman, J., joined by Cowen and Mayer, JJ., dissenting). The "rare intervention" of en banc rehearing "should be reserved for real conflicts as well as cases of exceptional importance." *DSU Med. Corp. v. JMS Co.*, 471 F.3d 1293, 1311 (Fed. Cir. 2006) (Michel, C.J., and Mayer, J., concurring). Because Chamberlain waived its step two challenges, and the panel's analysis of step two comports with established precedent, such "rare intervention" is unwarranted here.



**I. Chamberlain Waived Its Right to Seek a Remand on *Alice*'s Step Two.**

Chamberlain requests rehearing because the district court did not reach *Alice*'s step two in its decision below, so Chamberlain argues this Court erred in resolving step two in the first instance. Pet. 1, 4, 12-16. But Chamberlain failed to raise this argument to the panel. Petitions for rehearing cannot raise new issues. *See Pentax*, 135 F.3d at 762 (declining to address “the government’s new theory raised for the first time in its petition for rehearing” (citing *United States v. Bongiorno*, 110 F.3d 132, 133 (1st Cir. 1997) (“a party may not raise new and additional matters for the first time in a petition for rehearing”)); *see also Haas v. Peake*, 544 F.3d 1306, 1308 (Fed. Cir. 2008) (same).

In response to TTI’s appeal, Chamberlain never requested a remand on step two. *See, e.g.*, Appellee’s Br. 18-31. To the contrary, Chamberlain addressed step two by arguing that the claimed movable barrier operator was novel and asserting (incorrectly) that the district court made factual findings regarding step two. *See id.* at 28.<sup>2</sup> Although Chamberlain could have alternatively argued that the panel should remand for analysis of step two, it failed to do so. Chamberlain waived this issue, and this Court should reject its attempt to raise it for the first instance on rehearing.

---

<sup>2</sup> Judge O’Malley raised the remand issue raised during oral argument when she asked TTI’s counsel whether a remand would be required. TTI’s counsel explained why it was not necessary, and Chamberlain’s counsel never argued to the contrary. *See Oral Argument Recording* 4:43-5:20; 30:55-31:12.

## II. The Panel Did Not Err in Resolving *Alice*'s Step Two.

Even if this Court considers Chamberlain's arguments on the merits, it should decline Chamberlain's invitation to review the case because the panel's step two analysis was unremarkable. At step two, a court "must 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." *Alice*, 573 U.S. at 221. When claims merely state an abstract idea and add the words "apply it with generic components," they are not eligible for patent projection. *Id.*

This Court correctly applied this principle in *BSG*, holding that "[i]f a claim's only 'inventive concept' is the application of an abstract idea using conventional and well-understood techniques, the claim has not been transformed into a patent-eligible application of an abstract idea." 899 F. 3d at 1290-91.

The *BSG* analysis controls. Chamberlain has never identified any inventive concept that transforms the abstract idea. The record demonstrates that all of the claim elements used to implement the abstract idea are indisputably conventional and well-understood. The claims do not concern a new transmitter or new garage door opener. According to Chamberlain, they claim use of a generic transmitter to wirelessly transmit status information about a garage door opener.

The '275 patent's specification and Chamberlain's expert confirmed that all of the claim elements are generic and well-known in the art. *See* Appellants' Br. 22,

26 (citing Appx216 at 1:12, Appx216 at 3:49-50 and 3:55-4:4, Appx494, Appx343-344). And Chamberlain’s own counsel admitted “[t]here are no non-generic components in the movable barrier operator.” Oral Argument Recording 23:52-24:08.

On this undisputed record, the panel did not err in resolving step two in the first instance on appeal because the genuine issues of fact found to be present in *Berkheimer*, 881 F.3d at 1370, and *Aatrix*, 882 F.3d at 1126, are absent here.

The panel’s decision comports with this Court’s precedent. *See Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 891 (Fed. Cir. 1988) (“When the pertinent facts are undisputed, as here, an appellate court need not remand for the trial court to make findings and conclusions but may resolve the issue.”); *Black & Decker, Inc. v. Hoover Serv. Ctr.*, 886 F.2d 1285, 1290 (Fed. Cir. 1989) (same), *abrogated on other grounds by Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000); *see also JANA, Inc. v. United States*, 936 F.2d 1265, 1270 (Fed. Cir. 1991) (“Our holding, however, is based entirely on straightforward application of law to undisputed facts and facts properly found, and thus remand for further findings by the Claims Court is not necessary.”); *Texas Instruments Inc. v. United States*, 922 F.2d 810, 815 (Fed. Cir. 1990), *opinion modified on reh’g* (Mar. 19, 1991) (“[W]here the evidence is undisputed . . . it would seem that this court can make that finding without sending the matter back . . . for

determination of the factual issues; otherwise, litigation would be protracted and unnecessary delay and expense would result simply in order to have the [lower court] formally decide a fact which legally can be decided in only one way.”) (citation omitted).

The cases cited by Chamberlain are inapposite. *See* Pet. 13 (citing *MyMail, Ltd. v. ooVoo, LLC*, 934 F.3d 1373, 1380 (Fed. Cir. 2019); *Atl. Thermoplastics Co. v. Faytex Corp.*, 5 F.3d 1477, 1479 (Fed. Cir. 1993), *Int’l Rectifier Corp. v. Samsung Elecs. Co.*, 424 F.3d 1235, 1241 (Fed. Cir. 2005)). *MyMail* recognized that *Alice*’s step two “**may** involve subsidiary fact questions.” 934 F.3d at 1380 (emphasis added). But here, all relevant questions of fact are undisputed. The other cases stand for the unremarkable proposition that appellate courts do not engage in fact-finding. None of these cases holds that remand is inherently required where, as here, no factual issues need to be resolved. Under *BSG*, as a matter of law, the claims have not been transformed into a patent-eligible application because the only “‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques.” 899 F.3d at 1290.

Chamberlain also points to arguments from the parties’ appeals of an unrelated International Trade Commission determination, *Chamberlain v. ITC*, No. 18-2002 (Fed. Cir.), where in the Initial Determination the Administrative Law Judge not only found that TTI’s accused products cannot infringe the asserted claims

but also held the claims to be ineligible under 35 U.S.C. § 101. *See* Pet. 4-5. The circumstances surrounding appellate review of a Commission Final Determination are not analogous. After affirming the Administrative Law Judge’s noninfringement finding, the Commission expressly vacated and took no position on the Initial Determination’s Section 101 analysis. That is, the Commission never made a decision regarding patent eligibility, so deciding the issue in the first instance on appeal (and making factual findings in favor of Chamberlain) would have been improper. *Cf. Sec. & Exch. Comm’n v. Chenery Corp.*, 332 U.S. 194, 196 (1947) (“[A] reviewing court, in dealing with a determination or judgment which an administrative agency alone is authorized to make, must judge the propriety of such action solely by the grounds invoked by the agency.”).<sup>3</sup>

Further, Chamberlain’s arguments at 14-15 that fact-finding is necessary—which it improperly raises for the first instance on rehearing, *see* Section I, *supra*—are misplaced. Chamberlain asserts that wireless transmission was not the only inventive concept it identified. Pet. 14. Rather, it alleges it also identified the claims’ “on-board controller.” *Id.* (citing Appellee’s Br. 10). But the words “on-

---

<sup>3</sup> Chamberlain conversely argued in that case “[t]here is no need for remand to determine that such a claim, even if directed to an abstract idea, has a sufficient inventive concept to confer patentability.” *Chamberlain v. ITC*, No. 18-2002, Dkt. 85 at 74. Therefore, Chamberlain implicitly acknowledged that there may be cases where this Court can decide *Alice*’s step two as a matter of law. Chamberlain’s Petition never explains its own contradictory positions.

board controller” are found nowhere in the ’275 patent. The only controller described by the ’275 patent is the same controller the specification describes as “well understood in the art.” *See* Appx217 at 3:49-53 (“Such controllers 11 and movable barrier interfaces 12 are well understood in the art . . . .”). Chamberlain never disputed this characterization. Indeed, its counsel, expert, and the named inventor all agreed with it. *See* Oral Argument Recording 23:52-24:08 (“The controller is generic.”); Appx491 (Chamberlain’s expert Dr. Rhyne testifying that “controllers disclosed in the ’275 patent are used in a conventional well-known manner to control operations within the movable barrier operator”); Appx343-344 (James Fitzgibbon, inventor of the ’275 patent, admitting the same). Thus, nothing in the claims “requires anything other than off-the-shelf, conventional” hardware. *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1355 (Fed. Cir. 2016).

Finally, both the district court’s statements when analyzing **step one** and the jury’s **contested** findings on validity are irrelevant. *See* Pet. 15. Chamberlain does not seek rehearing based on the panel’s application of step one, and the jury made no specific findings of fact regarding Section 101 in reaching its verdict.<sup>4</sup>

---

<sup>4</sup> On appeal, TTI challenged the jury’s finding that the ’275 patent was not anticipated. The panel did not reach the issue of whether the jury’s validity findings were supported by substantial evidence because it decided this case on Section 101 grounds. Op. 2.

Regardless, “the relevant inquiry is not whether the claimed invention as a whole is unconventional or non-routine.” *BSG*, 899 F.3d at 1290. Rather, the issue is whether the “only ‘inventive concept’ is the application of an abstract idea using conventional and well-understood techniques.” *Id.* The panel correctly determined it was.

### **III. The Panel Did Not Err in Failing to Analyze Alleged “Additional Features.”**

Chamberlain argues that the panel failed to assess the novelty of the claimed invention or credit “additional features” beyond wireless transmission, thereby conflating *Alice*’s step one and step two. Pet. 5, 11-12. But novelty and nonobviousness are separate patentability requirements from eligibility. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 89 (2012); *Two-Way Media Ltd. v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1340 (Fed. Cir. 2017) (“Eligibility and novelty are separate inquiries.”); *DIRECTV*, 838 F.3d at 1263 (“Even assuming [the claimed invention is novel], it does not avoid the problem of abstractness.”); *Parker v. Flook*, 437 U.S. 584, 591 (1978) (“[T]he novelty of the mathematical algorithm is not a determining factor at all [in analyzing eligibility.]”). Further, this Court has noted “that there is considerable overlap between step one and step two.” *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288, 1294 (Fed. Cir. 2016).

Moreover, the panel did consider the “additional features,” including the operator, and explained why the record demonstrated they lacked in inventiveness. *See* Op. 9 (“These conventional components, all recited in a generic way, are no better equipped to save the claim from abstractness than were, for example, the conventional computer used in *Alice* or the scanner used in *Content Extraction & Transmission LLC v. Wells Fargo Bank, National Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014).”); *id.* at 10 (“As we explained above, the specification makes clear that transmitting information wirelessly was conventional at the time the patent was filed and could be performed with **off-the-shelf technology**.” (emphasis added)). And Chamberlain’s own counsel admitted that “[t]here are no non-generic components in the movable barrier operator.” Oral Argument Recording 23:52-24:08.<sup>5</sup>

---

<sup>5</sup> Amicus Jeremy C. Doerre seizes on language from the panel’s opinion that “CGI does not point to any inventive concept present in the ordered combination of elements beyond the act of wireless communication,” Op. 10, to suggest the opinion may be interpreted as shifting the burden to Chamberlain to prove patent eligibility. Chamberlain has not requested reconsideration on such a strained reading of the panel opinion. Further, this Court has already clarified that issued patents are presumed to be valid and eligible. *See, e.g., Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1319 (Fed. Cir. 2019) (citing, *inter alia*, *Berkheimer*, 881 F.3d at 1368). Mr. Doerre also requests guidance from the Court on how to establish that a claim does not contain an inventive concept sufficient to transform the claimed abstract idea into a patent-eligible application. However, he fails to explain why this case—in which the specification and Chamberlain’s counsel have conceded the claims only require generic, “off the shelf” components to implement the abstract idea—is an appropriate vehicle to resolve this question.



Every component that Chamberlain identifies as “inventive”—the transmitter, the controller, the moveable barrier operator—is inherent in implementing the abstract idea of “wirelessly communicating status information about a system” in the technological environment of movable barrier operators. One cannot transmit status information about a moveable barrier operator without a moveable barrier operator and a transmitter. As *Alice* explained, neither “stating an abstract idea while adding the words ‘apply it’” nor “limiting the use of an abstract idea to a particular technological environment” is sufficient for patent eligibility. 573 U.S. at 223. Nor can one claim an abstract idea by reciting a “system configured to implement the relevant concept.” *Id.*

After losing the appeal, Chamberlain may disagree with the panel’s analysis of the alleged “additional features,” but the purpose of rehearing is not “to second-guess the panel on the facts of a particular case.” *In re Dillon*, 919 F.2d at 700 n.3. And in any event, the undisputed record belies Chamberlain’s arguments.

## CONCLUSION & PRAYER FOR RELIEF

Chamberlain waived its ability to request remand on the issues presented, and its Petition improperly raises new arguments regarding *Alice*'s step two for the first instance on rehearing. The panel's decision comports with precedent and is unremarkable given Chamberlain's and the claims' admitted use of conventional components. Chamberlain's petition should be denied.

Dated: November 12, 2019

By: /s/ Jason C. White

Jason C. White

*Counsel for Appellants Techtronic  
Industries, Co. Ltd., Techtronic  
Industries North America, Inc., One  
World Technologies Inc., OWT  
Industries, Inc., and Ryobi  
Technologies, Inc.*

**PROOF OF SERVICE**

I certify that I electronically filed the foregoing Response to Petition for Rehearing and Rehearing En Banc using the Court's CM/ECF filing system on November 12, 2019. All counsel of record were served via CM/ECF on November 12, 2019.

Dated: November 12, 2019

By: /s/ Jason C. White

Jason C. White

*Counsel for Appellants Techtronic  
Industries, Co. Ltd., Techtronic  
Industries North America, Inc., One  
World Technologies Inc., OWT  
Industries, Inc., and Ryobi  
Technologies, Inc.*

## CERTIFICATE OF COMPLIANCE

1. This response complies with the type-volume limitation of Federal Rule of Federal Circuit Rule 35(e)(4). This response contains 3,819 words, excluding the parts of the response exempted by Federal Rule of Appellate Procedure 35(c)(2).

2. This response complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). This response has been prepared in a proportionally spaced typeface using Times New Roman, 14-point font in Microsoft Office Professional Plus 2016.

Dated: November 12, 2019

By: /s/ Jason C. White

Jason C. White

*Counsel for Appellants Techtronic  
Industries, Co. Ltd., Techtronic  
Industries North America, Inc., One  
World Technologies Inc., OWT  
Industries, Inc., and Ryobi  
Technologies, Inc.*