

**United States Court of Appeals  
for the Federal Circuit**

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YANBIN YU, ZHONGXUAN ZHANG,  
*Plaintiffs-Appellants,*

– v. –

APPLE INC.,  
*Defendant-Appellee.*

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YANBIN YU, ZHONGXUAN ZHANG,  
*Plaintiffs-Appellants,*

– v. –

SAMSUNG ELECTRONICS CO. LTD.,  
SAMSUNG ELECTRONICS AMERICA, INC.,  
*Defendants-Appellees.*

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*On Appeal from the United States District Court, Northern District  
of California, in Case Nos. 3:18-cv-06181-JD, 3:18-cv-06339-JD,  
Judge James Donato*

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**DEFENDANTS-APPELLEES RESPONSE TO  
PETITION FOR REHEARING *EN BANC***

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## CLAIM LANGUAGE

Claim 1 recites:

1. An improved digital camera comprising:

a first and a 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 a 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.

Claim 2 recites:

2. The improved digital camera as recited in claim 1, wherein said first image sensor sensitive to said full region of visible color spectrum.

Claim 4 recites:

4. The improved digital camera as recited in claim 1, wherein said analog-to-digital converting circuitry comprises two individual analog-to-digital converters, each integrated with one of said first and second image sensors so that said first and second digital images are digitized independently and in parallel to increase signal throughput rate.

**CERTIFICATE OF INTEREST**

Counsel for Appellee, Apple Inc. certifies the following:

1. The full name of every party or amicus represented by me is:

Apple Inc.

2. The name of the real party in interest (Please only include any real party in interest NOT identified in Question 3. below) represented by me:

None.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

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 are:

COOLEY LLP: Heidi L. Keefe, Phillip E. Morton, Lowell D. Mead,  
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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).

*Apple Inc. v. Yu, et al.*, IPR2019-02158 (USPTO PTAB);  
*Samsung Electronics Co., Ltd. et al. v. Yu, et al.*, IPR2020-00492  
(USPTO PTAB); *Apple Inc. v. Yu, et al.*, No. 21-1723 (Fed. Cir.).

6. All information required by Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6):

None.

Dated: August 12, 2021

/s/ Heidi L. Keefe

Heidi L. Keefe

COOLEY LLP

**CERTIFICATE OF INTEREST**

Counsel for Appellees Samsung Electronics Co., Ltd. and Samsung Electronics America, Inc. certify the following:

1. The full name of every party or amicus represented by me is:

Samsung Electronics Co., Ltd.  
Samsung Electronics America, Inc.

2. The name of the real party in interest (Please only include any real party in interest NOT identified in Question 3. below) represented by me:

None.  
None.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None.  
Samsung Electronics Co., Ltd.

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 are:

ROPES & GRAY LLP: Douglas H. Hallward-Driemeier; James Batchelder, Steven Pepe, David Chun, Scott Taylor

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).

*Apple Inc. v. Yu, et al.*, IPR2019-02158 (USPTO PTAB);

*Samsung Electronics Co., Ltd. et al. v. Yu, et al.*, IPR2020-00492 (USPTO PTAB); *Apple Inc. v. Yu, et al.*, No. 21-1723 (Fed. Cir.)

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None.

Dated: August 12, 2021

/s/ Douglas Hallward-Driemeier  
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## INTRODUCTION

There is no basis here for rehearing *en banc*. The majority opinion properly applied the *Alice* test and the Court’s longstanding precedent in holding representative claim 1 ineligible. The opinion does not change the law, raise “fresh uncertainties,” or increase “instability” in § 101 jurisprudence. *See* Dissent at 7. It is, rather, Appellants that seek to revert § 101 law to a pre-*Alice* world where every claim reciting a “mechanical and electronic device of defined structure and mechanism” would be patent-eligible. Pet. at 3-4 (quoting Dissent at 2). But the Supreme Court in *Alice* rejected that proposition. Op. at 7 n.2 (quoting *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 224 (2014)).

The majority’s well-reasoned opinion faithfully applies this Court’s precedent. Appellants admitted that every component recited in representative claim 1 is a “generic and conventional” part of a digital camera. Op. at 6 (quoting Reply Br. at 12). Appellants also did not dispute that the idea of using multiple pictures to enhance each other has been well-known and practiced for over a century. Op. at 6. In the wake of *Alice*, this Court has consistently invalidated claims, like those here, in which the recited structure/mechanism is merely a “generic environment in which to carry out the abstract idea.” *Id.*

Appellants do not demonstrate any error by the Court, let alone any error requiring *en banc* rehearing. In fact, Appellants’ petition does not cite any argument in their merits briefing, nor any well-pleaded allegation in their complaints, that was allegedly misapprehended or overlooked. Instead, the petition raises new arguments that seek to conflate the two-sensor configuration recited in the claims at issue with a “four sensor” camera embodiment disclosed in the specification but *not* in those claims. These new arguments are waived as untimely and, even if considered, would not change the result. The majority correctly appreciated the fundamental “mismatch” between the specification’s four-sensor embodiment, which uses three color-specific sensors (*e.g.*, red, green, and blue) and a full-spectrum black-and-white sensor, versus claim 1, which “requires only a two-lens, two-image-sensor configuration in which none of the image sensors must be color.” *Op.* at 8. The claims at issue are much broader, and this “breadth” dooms their eligibility. *Id.*

## **ARGUMENT**

### **I. THE MAJORITY’S OPINION DOES NOT RAISE ISSUES OF EXCEPTIONAL IMPORTANCE**

Appellants’ purported “precedent-setting questions of exceptional importance” (*Pet.* at 1) do not identify any area of uncertainty in the law and distort the record in an improper attempt to reargue the merits.

First, as discussed below, the majority properly considered all “specific requirements” recited in claim 1 when it determined that the claim’s “focus” and “character as a whole” was directed to an abstract idea (*see* Section II.A, *infra*). Pet. at 1.

Next, the question of “[w]hether a court can make adverse findings of fact against the non-moving party at the pleadings stage that are inconsistent with the patent specification, the file history, and/or plausible allegations in the complaint” is not in dispute (the answer is no). No such impropriety happened here, and Appellants do not meaningfully attempt to demonstrate otherwise. *See* Section II.C, *infra*.

Similarly, Appellants’ question “[w]hether a claim that presents no danger of preempting an ‘abstract idea,’ either generally or in a particular field of use or technological environment, can be found ineligible for patent protection under 35 U.S.C. § 101” ignores established law holding that complete preemption is not required, and erroneously presupposes that claim 1 presents no danger of preemption, which is incorrect. *See* Section II.D, *infra*. Indeed, Appellants proclaimed in their original complaints that their claim “*is not limited to performing any particular type of image enhancement*” and

preempts “*virtually all dual-lens cameras on the market today.*” Appx50 (¶¶ 11-12), Appx74 (¶¶ 13-14) (emphasis added).

Appellants’ final enumerated question—“[w]hether a claimed combination of non-abstract (e.g., structural) limitations that has not been shown to exist in the prior art can be found to be ‘generic’ and ‘conventional’”—relies on the flawed premise that a claim requiring “a mechanical and electronic device of defined structure and mechanism” cannot be directed to an abstract idea. Pet. at 3-4 (citing Dissent at 2). Following from this premise, Appellants erroneously contend that every claim to a novel “combination of structural limitations (*i.e.*, a machine)” should be “patent-eligible in its own right under the express language of Section 101.” Pet. at 15; *cf.* Dissent at 4-7 (canvassing pre-*Alice* law to suggest that claim 1 should be patent-eligible because it recites a “mechanical/electronic device”). But the Supreme Court has instructed that “[g]roundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry,” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S.Ct. 2107, 2117 (2013), and reaffirmed in *Alice* that not every claim requiring a “tangible system (in § 101 terms, a ‘machine’)” is patent-eligible, Op. at 7 n.2 (quoting *Alice*, 573 U.S. at 224). *See also e.g., Simio, LLC v. Flexsim Software Prods., Inc.*, 983

F.3d 1353, 1364 (Fed. Cir. 2020) (even assuming limitations are novel, that “does not avoid the problem of abstractness” because alleged novelty “is not enough—standing alone—to confer patent eligibility”); *In re TLI Commc’ns Patent Litig.*, 823 F.3d 607, 611 (Fed. Cir. 2016) (“[N]ot every claim that recites concrete, tangible components escapes the reach of the abstract-idea inquiry.”).

Appellants’ positions are thus predicated on frustrations with what the law *is* relative to what they *wish it were*. But as this Court has explained and the majority correctly followed, *Alice* requires invalidation where “[w]hat is claimed is simply a generic environment in which to carry out the abstract idea.” Op. at 6. The claims in *In re TLI*, for example—a case ignored by Appellants and the dissent—recited a “telephone unit” and “digital pick up unit” for capturing images as part of a “mobile telephone system,” but were nevertheless ineligible. *In re TLI*, 823 F.3d at 611-15. *See also, e.g., ChargePoint, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 770 (Fed. Cir. 2019), *cert. denied*, 140 S. Ct. 983 (2020) (ineligible claims recited an apparatus containing “transceiver,” “controller,” and “control device”); *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1345 (Fed. Cir. 2019) (ineligible claims recited a “movable barrier operator” containing “controller,”

“interface,” and “wireless data transmitter” structures); *iLife Techs., Inc. v. Nintendo of Am., Inc.*, 839 F. Appx. 534, 535-36 (Fed. Cir. 2021) (invalidating claim reciting “a physical system that incorporates sensors”). “What matters, according to the [Supreme] Court, is the reality behind the machine or system language, whether or not it simply clothes abstract concepts.” *Sensormatic Elecs., LLC v. Wyze Labs, Inc.*, \_\_ F. Appx. \_\_, No. 2020-2320, 2021 WL 2944838, at \*1-3 (Fed. Cir. July 14, 2021) (invalidating claims reciting a system with “wireless input capture devices”).

## **II. APPELLANTS IDENTIFY NO ERROR IN THE MAJORITY’S OPINION**

To the extent that Appellants identify purported “instability” in § 101 jurisprudence (Dissent at 7), it is not exacerbated by the majority’s opinion and would not be resolved by rehearing *en banc* in this particular case. There is no error in the majority’s analysis under the facts or the law, which was a faithful and straightforward application of *Alice*.

### **A. The Majority Properly Determined the Claims’ “Focus” at *Alice* Step 1**

Appellants assert that the majority did not discuss every claim limitation in evaluating the “focus” of claim 1 as an abstract idea at *Alice* step one (Pet. at 11-12), but a proper step one inquiry looks to the claim’s “character as a



whole.” *Ericsson Inc. v. TCL Commc’n Tech. Holdings Ltd.*, 955 F.3d 1317, 1326-27 (Fed. Cir. 2020) (citation omitted); *PersonalWeb Techs. LLC v. Google LLC, et al.*, No. 2020-1543, slip op. at 13-14 (Fed. Cir. Aug. 12, 2021). There is no requirement that a discussion of that analysis mention each and every claim limitation. Here, the Court properly evaluated the “focus” of the claim, accounting for all of the “structural” elements. Op. at 5-6 (discussing claim elements). Considered as a whole, the claims are directed to achieving a desired functional result of capturing two images and producing a digital image from one image “enhanced” with the other—*i.e.*, the abstract idea of taking two pictures and using one to enhance the other. The focus of the claimed invention is not any improvement to any underlying digital camera technology.

This is thus a classic instance of claims “directed to a result or effect that itself is the abstract idea and merely invoke[s] generic processes and machinery” rather than “a specific means or method that improves the relevant technology.” Op. at 5 (quoting *Smart Sys. Innovations, LLC v. Chi. Transit Auth.*, 873 F.3d 1364, 1371 (Fed. Cir. 2017)). The claims fail to specify *how* to achieve the desired result of an “enhanced” image with any underlying algorithm, circuitry, or code. This Court’s precedent therefore dictated the outcome, where Appellants admitted that every component recited in the claims

is “generic and conventional” and did not dispute that the components “perform only their basic functions.” Op. at 6.<sup>1</sup> “What is claimed is simply a generic environment in which to carry out the abstract idea.” *Id.* (citing *In re TLI*, 823 F.3d at 611).

**B. The Court Properly Accounted for the “Combination” of Claim Elements at *Alice* Step 2.**

Similar reasoning disposes of Appellants’ argument that the Court “discounted” the “claimed combination of limitations.” Pet. at 12-15. The majority explained that claim 1 does not pass muster under *Alice* step two because “the *claimed* hardware configuration itself is not an advance and does not itself produce the asserted advance of enhancement of one image by another, which, as explained, is an abstract idea.” Op. at 10 (emphasis in original). As the majority appreciated, claim 1 fails to recite an inventive concept that bridges the gaping chasm from the recited components to the

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<sup>1</sup> Appellants also briefly mention that the two image sensors in claim 1 are “closely positioned with respect to a common plane” (Pet. at 8, 12) but do not demonstrate how this feature might provide a patent-eligible advance—and it does not. Close positioning of image sensors on a common plane too was generic and conventional, as exemplified by the prior art cited during prosecution of the ’289 patent. *See* Appellees’ Br. at 40-42 (citing Appx117, Appx123-135 at Appx124, Appx128, Appx132 (1:11-2:34), Appx133 (4:40-51)).

desired result of producing an “enhanced” image. As Appellants concede, both sensors in claim 1 can be identical black-and-white sensors. Pet. at 8; Op. at 8. Appellants criticize the majority for observing that the images produced by the sensors “may be at different exposures,” Pet. at 11, but this point only reinforces the majority’s opinion. The claim does not impose any requirements on exposure duration, image resolution, quantity of pixels, physical material quality, or anything else that would be necessary to achieve “enhanced” image quality. The majority was thus correct to conclude that “[t]he claimed configuration does not add sufficient substance to the underlying abstract idea of enhancement—the generic hardware limitations of claim 1 merely serve as ‘a conduit for the abstract idea.’” Op. at 10. Stated differently, just as saying “do it on a computer” (*Alice*), “do it in a mobile phone” (*In re TLI*), or “do it in a charging station” (*ChargePoint*) does not confer patent eligibility on a claim directed to an abstract idea, neither does “do it in a two-lens digital camera.”

**C. Appellants Did Not Raise Any Plausible Factual Allegations Sufficient to Confer Eligibility.**

The majority properly reviewed *de novo* the question of eligibility under § 101, and correctly concluded that there is a fundamental “mismatch” between the “breadth” of claim 1 and the narrow four-sensor embodiment cited by Appellants. Op. at 4-5, 7-8. This is not a new or erroneous “finding of fact”

against Appellants. Pet. at 16-18. The majority further concluded that the district court did not err in rejecting certain allegations in Appellants' complaints. Op. at 11 (recognizing that "a court need not accept as true allegations that contradict" the claims and the specification). Appellants' petition does not cite any factual allegations in their district court complaints that were allegedly overlooked by the Court—let alone any well-pleaded allegations grounded in the claim language that plausibly demonstrate an inventive concept—because none exist. If the majority materially disregarded an allegation that justified rehearing, Appellants' petition should have demonstrated that basis. *Olaplex, Inc. v. L'Oréal USA, Inc.*, \_\_\_ F. Appx. \_\_\_, No. 2020-1382, 2021 WL 1811722, at \*10 (Fed. Cir. May 6, 2021) ("Judges are not like pigs, hunting for truffles buried in the record.") (citation omitted).

Appellants' petition ignores the claims, instead resting a host of new arguments on the specification's four-sensor embodiment. Pet. at 4-9, 17-18. These arguments fail both on the merits and procedurally. Procedurally, Appellants did not argue in their merits briefing that claim 1 is eligible because it allegedly implements and is limited to the four-sensor embodiment and thereby obtains all of that embodiment's purported benefits; nor did Appellants raise their arguments purportedly distinguishing "image combination" from

“image enhancement.” Appellants therefore waived these arguments. *Omega Patents, LLC v. CalAmp Corp.*, 920 F.3d 1337, 1343 (Fed. Cir. 2019) (where appellant’s “opening brief . . . failed to present a developed argument” the argument is waived).

On the merits, Appellants’ new arguments regarding the four-sensor embodiment miss the mark because—like the arguments Appellants raised at the district court—they rely on the *specification*, not the language of the asserted *claims*. The “§ 101 inquiry must focus on the language of the Asserted Claims themselves, and the specification cannot be used to import details from the specification if those details are not claimed.” *ChargePoint*, 920 F.3d at 769. Appellants devote several pages to new discussion of specification embodiments, but nothing in that discussion demonstrates that *claim 1* contains any patent-eligible invention. *PersonalWeb*, slip op. at 16 (affirming that alleged “improvements in the specification” did not preclude judgment on the pleadings). The Court properly recognized the “mismatch” between the disclosure of the specification and the breadth of claim 1 to conclude that “the *claim*—as opposed to something purportedly described in the specification—is missing an inventive concept.” Op. at 8, 10 (emphasis in original) (quoting

*Two-Way Media Ltd. v. Comcast Cable Commc'ns, LLC*, 874 F.3d 1329, 1338 (Fed. Cir. 2017)).

Indeed, claim 1 is vastly broader than the four-sensor embodiment in the specification. In the four-sensor embodiment, three sensors are color-specific (red, green, blue) and the fourth is black-and-white, and the specification asserts that the mixing of color-specific sensors together with a black-and-white sensor purportedly provides certain “benefits and advantages.” *See Op.* at 7-8 (quoting ’289, 9:23-27, 10:17-25, 2:52-57). Whatever benefits and advantages might be conferred by such an embodiment, they do not flow from claim 1, which “requires only a two-lens, two-image-sensor configuration in which none of the image sensors must be color.” *Op.* at 8; *Pet.* at 7-8 (discussing two-sensor embodiment and admitting that neither sensor in claim 1 needs to be color-specific).<sup>2</sup>

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<sup>2</sup> The four-sensor embodiment does correspond with other, unasserted claims of the ’289 patent. Claims 6-25 recite four sensors including red, green, blue, and full-spectrum sensors. But those claims were never at issue because nobody allegedly infringed them. Ineligibility, of course, is determined on a claim-by-claim basis. *E.g., Berkheimer v. HP, Inc.*, 881 F.3d 1360, 1370-71 (Fed. Cir. 2018) (ineligible claims 1-3 and 9 reflected only the abstract idea with “conventional” components while claims 4-7 claimed different subject matter that allegedly “improves system operating efficiency and reduces storage costs”).

Contrary to Appellants' argument, a broad abstract claim does not become patent-eligible merely by "covering" some device that also has additional unclaimed features (such as additional color-specific sensors). *See* Pet. at 17-18. Appellants' contention that claim 1 "covers" various configurations of two, four, or more sensors only buttresses the Court's observation that the "breadth of claim 1" shows that "the focus of the claimed advance is the abstract idea and not the particular configuration discussed in the specification." Op. at 8.

**D. The Claimed Invention Raises Serious Preemption Concerns**

Finally, Appellants' contention that the Court did not explicitly address the issue of preemption is also not grounds for rehearing. Pet. at 18-19. Where "claims are deemed only to disclose patent ineligible subject matter under the [*Alice/*]*Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). As explained above, the majority faithfully and properly applied that two-step *Alice/**Mayo* framework. Appellants' attempt to characterize claim 1 as "narrowly circumscribed" by comparing it to an unclaimed, single-sensor camera system (Pet. at 18), ignores the tenet that "the absence of complete preemption does not demonstrate patent eligibility" and

“does not change the conclusion that the claims are directed to patent ineligible subject matter.” *Ariosa*, 788 F.3d 1379.

In fact, this case presented precisely the type of preemption concerns that underlie § 101 jurisprudence. Appellants criticize the Court for observing that the claims broadly aspire to enhance images “in some way” that is not limited to any specific enhancement technique. Pet. at 11, 12. However, Appellants themselves trumpeted in their original complaints that the claimed invention “*is not limited to performing any particular type of image enhancement*” and that “*virtually all dual-lens cameras on the market today use the techniques claimed in the '289 Patent.*” Appx50 (¶¶ 11-12), Appx74 (¶¶ 13-14) (emphasis added). Although they later amended their complaints to remove those admissions, they still attempted to preempt a wide variety of different accused technologies not recited in claim 1, such as digital zoom and “bokeh” effects. Appx251-256 (¶¶ 25-31), Appx258, Appx279-286 (¶¶ 22-30), Appx287-288.

### **III. CONCLUSION**

For the foregoing reasons, Appellees respectfully request that the Court deny Appellants’ petition.



Dated: August 12, 2021

COOLEY LLP

By: /s/ Heidi L. Keefe

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*Attorneys for Appellee*  
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Dated: August 12, 2021

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**CERTIFICATE OF SERVICE**

I hereby certify that on August 12, 2021, I filed or caused to be filed the foregoing with the Clerk of the United States Court of Appeals for the Federal Circuit via the CM/ECF system and served or caused to be served a copy on all counsel of record by the CM/ECF system.

Dated: August 12, 2021

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**CERTIFICATE OF COMPLIANCE**  
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**Short Case Caption:** Yu v. Apple Inc.; Yu v. Samsung Electronics Co., Ltd.

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Dated: August 12, 2021

/s/ Heidi L. Keefe  
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