

2020-2333

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

THADDEUS GABARA,

Plaintiff-Appellant,

– v. –

FACEBOOK, INC.,

Defendant-Appellee.

*On Appeal from the United States District Court for the
Southern District of New York in No. 1:19-cv-09890-DLC*

**PETITION FOR REHEARING *EN BANC* FOR
PLAINTIFF-APPELLANT**

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AUGUST 9, 2021

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2020-2333
Short Case Caption Gabara v. Facebook, Inc.
Filing Party/Entity Appellant: Thaddeus Gabara

Instructions: Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

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Date: 08/09/2021

Signature: /s/ Timothy K. Gilman

Name: Timothy K. Gilman

<p>1. Represented Entities. Fed. Cir. R. 47.4(a)(1).</p>	<p>2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).</p>	<p>3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>Thaddeus Gabara</p>		

Additional pages attached

4. Legal Representatives. List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

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Stroock & Stroock & Lavan LLP	Greg Springsted	Ian DiBernardo

5. Related Cases. Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

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6. Organizational Victims and Bankruptcy Cases. Provide any information required under 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/Not Applicable Additional pages attached

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RULE 35(b) STATEMENT OF COUNSEL

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

1. Whether specific limitations recited in the claim language that describe the “claimed advance” over the prior art can be ignored in the court’s determination of patent eligibility.
2. Whether 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. § 101.¹

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States and/or precedents of this court: *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012); *Alice Corp. Pty. v. CLS Bank Int’l*, 573 U.S. 208 (2014); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016); *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019).

Dated: August 9, 2021

By: /s/ Timothy Gilman

Timothy Gilman

¹ This precedent-setting question is identical to one of the questions raised in a pending petition for rehearing en banc. *Yu v. Apple, Inc.*, Nos. 20-1760, -1803 (Fed. Cir. July 12, 2021). This Court has recently requested a response to this pending petition. No. 20-1760 (Fed. Cir. July 29, 2021), ECF. No. 62.

PRELIMINARY STATEMENT

The district court’s order invalidating 84 claims under § 101—cursorily affirmed and endorsed by the Panel under FED. CIR. R. 36—relied on an abstraction of the inventions that excluded the “claimed advance” touted in the specification, repeated throughout the claims, and relied upon in related PTAB proceedings to distinguish prior art and justify denial of IPR institution. The district court also explicitly failed to consider the lack of *any* risk of preemption, which the Supreme Court has instructed is vital to § 101 eligibility. Left unreviewed, this decision will obscure the proper application of *Alice* and further distance this Court’s evolving jurisprudence from the Supreme Court’s opinions interpreting and applying § 101.

If an invention can be recast without any regard the advance as claimed, or if preemption—the underlying concern in § 101—can be ignored, then the dispositive § 101 inquiry risks becoming an arbitrary weapon against patent validity. As this Court has recognized in requesting a response to the pending petition for rehearing in *Yu v. Apple*, the § 101 issues in this case raise important concerns ripe for clarification. No. 20-1760 (Fed. Cir. July 29, 2021), ECF. No. 62.

THE PATENTED INVENTION

Thaddeus Gabara, the owner and co-inventor of the four “Image Patents” at issue, is an accomplished engineer who pioneered semiconductor and networking technology at AT&T Bell Labs before creating his own incubator for early-stage technologies. The widespread licensing and commercialization of his inventions—

developed both during his time in the industry and later as an entrepreneur—evidence the value and innovation that he has contributed to the field.

The four Image Patents provide novel contributions to the field of portable devices. Portable devices such as smartphones are typically prized for smaller form factors, but as a result, are not well-suited to viewing or navigating images that extend beyond their relatively small screens. Traditionally, a user viewing a map or image on a touchscreen smartphone has to minimize, magnify, and scroll the map with finger gestures to locate a desired point. Appx237, 1:36-50. Repeatedly performing these actions may cause the user to lose bearing because the small screen inhibits the true sense of the distance between locations on the map, especially with changing magnification. Appx237, 1:50-56.

The specification of the Image Patents “introduces a background map that remains stationary.” *E.g.*, Appx237, 2:7-8. As discussed throughout each specification and highlighted in the challenged claims, this “background image of a stationary map” is a novel data structure—a digital image stored in memory that is locked to a position in physical space. “The system behaves as if a stationary map exists behind the portable unit and the screen of the portable unit is a Sliding Window exposing the portion of the image of the stationary map behind the portable unit.” Appx243, 14:58-61. Instead of registering movement via touchscreen gestures, when the desired image or map is displayed, the portable device itself is moved and the image displayed appears to reveal new portions of the stationary map. Appx237,

2:7-11. The device is moved through physical space to a desired position, and in turn, that motion is translated into showing the portion of the “stationary” map or image that was not previously visible on the screen. Appx237, 2:17-21. This allows for a more natural viewing method that overcomes limitations in the prior art.

The specification of the Image Patents repeatedly indicates that the background image of a stationary map is an “innovative” and integral part of the claimed advance. *See, e.g.*, Appx227, Fig. 10b and Appx244, 16:10-11, 18 (“the innovative embodiment of the device movement technique,” in which “map 10-3 remains stationary”); Appx238, 3:33-36; Appx242, 11:58-67; Appx243, 13:4-11, 14:53-61; Appx244, 16:25-30 (“Lastly, the movement that the user experiences allows the user to ‘feel’ and grasp the various locations by various positions in physical space. This provides for this innovative distance and angle understanding of the map 10-3 which remains stationary and is being scanned by the moving portable unit.”). The patents tie “benefits” of the invention to this stationary map approach, reflected throughout the specification. *See, e.g.*, Appx196, Abstract (explaining that objects “outside of the range of the screen...can [] immediately be located and placed into view”), Appx244, 16:25-30.

This “background image of a stationary map” (or a related analog), is required by every claim of the Image Patents.² It is recited four times in claim 1 of U.S.

² Every independent claim of the four Image Patents recites one of: (1) “background image of a stationary map,” (2) “stationary background image,” or (3) “three

8,706,400 (the “ ’400 patent”), the exemplary claim that the district court used in its § 101 analysis. This background image forms the basis for the claimed advance—the image displayed on the screen changes according to movement of the portable device, while the background image remains stationary and fixed in real-space. This novel data structure is explicitly recited in four of the six method steps of claim 1 of the ’400 patent, and it serves a crucial role in the overall function of the invention.

The PTAB relied on this “background image of a stationary map” limitation to deny Facebook’s petitions for *inter partes* review challenging the ’400 patent. *See, e.g.*, Dkt. 29-4, at 12 (“[W]e find that Petitioner did not carry its burden of showing Kim discloses a stationary map as a background image and, thus, fails to demonstrate a reasonable likelihood that it would prevail in establishing that Kim anticipates claim 1.”). While Facebook’s prior art taught moving a portable device to view different portions of a displayed image, it did so in a different way. *Id.* 23-24 (emphasis in original) (footnotes omitted) (“Therefore, because the background image A1 moves, Petitioner has not shown sufficiently that Kim’s image A1 is a *stationary* map, as recited by claim 1.”). As the Board further wrote, “[a] stationary background image is a **critical aspect** of what the ’400 patent refers to as ‘innovative.’ *See, e.g.*, [’400 patent] at Fig. 10b[.]” *Id.* at 24, n.6 (emphasis added).

* * *

dimensional image of a stationary map.” Appx89, Appx142-43, Appx194-95, Appx247.

The district court erred, as discussed herein, by disregarding this “background image of a stationary map” limitation when it abstracted claim 1 to find it patent-ineligible. Appx12 (“The invention presented ... is to move the portable device itself to view different portions of images displayed on portable devices.”). This approach ignored the claimed advance touted in the specification, repeated throughout the claims, and used to distinguish prior art in the related IPR proceedings.

The district court additionally erred by expressly refusing to consider the issue of preemption—or lack thereof—simply because the accused infringer did not address it. Appx18, n.5. As demonstrated by the PTAB’s decision denying *inter partes* review challenges to the Image Patents, alternate approaches other than the instant claims existed in the field to “move a portable device itself to view different portions of images displayed on portable devices.” Accordingly, the claimed inventions posed no risk of preemption of the district court’s abstract idea, and it is therefore improper to invoke § 101 to invalidate the claims-at-issue.

The Panel’s endorsement of these errors through summary affirmance warrants rehearing and reversal. The district court’s approach risks further confusion as to the proper analysis in § 101 eligibility unless addressed by clarifying precedent.

ARGUMENT

In *Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208 (2014), and *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66 (2012), the Supreme Court set forth “a framework for distinguishing patents that claim laws of nature,

natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice*, 573 U.S. at 217. First, a court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” referred to as “Step One.” *Id.* This Court has further explained that Step One should “evaluate ‘the focus of the claimed advance over the prior art’ to determine if the character of the claim as a whole, considered in light of the specification, is directed to excluded subject matter.” *Trading Techs. Int’l, Inc. v. IBG LLC*, 921 F.3d 1378, 1384 (Fed. Cir. 2019). If the claim as a whole is directed to excluded subject matter, the court must “search for an ‘inventive concept,’” an element or combination of elements that “ensure[s] that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself,” commonly known as “Step Two.” *Alice*, 573 U.S. at 217-18. This approach is intimately tied to the policy basis for excluding “abstract ideas” from patent eligibility, *i.e.*, preventing the preemption of those abstract ideas. *Alice*, 573 U.S. at 216. (“We have described the concern that drives [the] exclusionary principle [for laws of nature, natural phenomena, and abstract ideas] as one of pre-emption.”).

The district court below made two key legal errors in finding the ’400 patent invalid as merely directed to an abstract idea. First, the district court omitted any analysis of the claimed advance of the ’400 patent over the prior art, a determination which must guide the Step One inquiry. Second, the district court relied on Federal Circuit precedent to ignore the lack of preemption in this case, despite the Supreme

Court's instruction to the contrary. The Court should grant Appellant's petition, clarify its implementation of the Supreme Court's § 101 analysis, reverse the district court's ruling, and remand this case for further proceedings.

I. THE PANEL'S AFFIRMANCE ENDORSES THE DISTRICT COURT'S FAILURE TO ANALYZE THE CLAIMED ADVANCE

At Step One, the district court erred in removing a key portion of the "claimed advance"—the "background image of a stationary map"—from its consideration of claim 1 of the '400 patent.

The legal error is showcased in the first sentence of the district court's analysis of the Image Patents. It wrote, "[t]he invention presented ... is to move the portable device itself to view different portions of images displayed on portable devices," and also that "[m]oving the device to change one's view of the image" instead of scrolling is an "abstract idea." Appx12. In so finding, the district court disregarded over 75% of the claimed invention and reduced claim 1 to two oversimplified steps:

1. A method of moving a portable unit to search for a new location comprising the steps of:

displaying an image on a screen of the portable unit
~~matched and superimposed to a corresponding portion of a background image of a stationary map;~~

~~mapping a first point of the display image located in a center of the screen of the portable unit to a corresponding reference point in the background image of the stationary map;~~

moving the portable unit to display a new portion of the background image of the stationary map on the screen;

~~identifying a new location in the new portion of the background image;~~

~~determining a first vector between the center of the screen of the portable unit and the new location; and~~

~~moving the center of the screen of the portable unit to the new location as determined by the first vector.~~

Appx247, 21:2-19 (strikethroughs and highlighting added). In doing so, the district court disregarded the “background image of a stationary map” limitation, a necessary portion of the claimed advance in claim 1.

Compounding this error, the district court improperly twisted certain advantages of the claimed inventions discussed in the ’400 patent into evidence of abstractness. *See Yu v. Apple Inc.*, 1 F.4th 1040, 1047 (Fed. Cir. 2021) (Newman, J., dissenting) (“A statement of purpose or advantage does not convert a device into an abstract idea.”). This approach perverts the intrinsic record, supplanting the claimed invention with a description of the invention’s *benefits* from the specification.

The district court wrote that the loss-of-bearing problem discussed in the patent does not only arise in portable devices. Appx15. However, the ’400 patent instructs that a user may “lose bearing” as a “*shortcoming in current portable systems* for providing map directions.” Appx237, 1:53-58 (emphasis added). The solution to this problem in the ’400 patent arises from improving the *source* of the problem, *i.e.* improving portable device technology itself through the introduction of a “background image of a stationary map.” Claim 1 itself does not recite regaining

one's bearings. In the same vein, the district court wrote that claim 1 lacks a "particularized method" because "one asserted benefit of the claimed invention" is compatibility with various portable devices. *See* Appx15. But again, this "compatibility" is recited as a potential advantage of the claimed invention, not the claimed invention itself. The claimed invention is not reduced to its potential benefits, even if found in the specification—the actual claim language still defines the scope of the invention.

The "background image of a stationary map" is the heart of the claimed advance over the prior art. It is explicitly described as an innovation and a key feature to the invention as described in the written description. It is recited multiple times throughout each independent claim. It is part of almost every step of the recited methods. And it was the PTAB's express basis to foreclose Facebook's IPR challenges against the Image Patents.

A proper § 101 analysis must consider such a claimed advance at Step 1, and the district court's failure to do so is reversible error. If the district court's error remains affirmed, it risks encouraging future courts to convert the threshold validity issue of § 101 into an arbitrary analysis driven by cherry-picked snippets from the specification and ignore the specific features of the claimed invention.

II. THE PANEL OVERLOOKED THE DISTRICT COURT'S FAILURE TO CONSIDER THE LACK OF PREEMPTION

The Supreme Court has instructed that the § 101 analysis must distinguish between claims that ““would risk disproportionately tying up the use of the underlying’ ideas, and are therefore ineligible” and claims that “pose no comparable risk of pre-emption, and therefore remain eligible.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 73) (citation omitted). Accordingly, courts must examine the extent of preemption when conducting a § 101 analysis.

After the Supreme Court decided *Alice*, this Court in *Ariosa Diagnostics, Inc. v. Sequenom, Inc.* stated that “questions on preemption” are necessarily “resolved” in the § 101 analysis, seemingly allowing preemption. 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“The Supreme Court has made clear that the principle of preemption is the basis for the judicial exceptions to patentability. For this reason, questions on preemption are inherent in and resolved by the § 101 analysis.”) (citation omitted). *Ariosa* also described the legal effect of so-called “complete preemption,” a term not found in *Mayo* or *Alice*. (“While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility....Where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.”). *Id.*

Facially, the phrase “complete preemption” tracks the Supreme Court’s concern about “disproportionate” levels of preemption. “Complete preemption” also implies some legally-significant, lesser degree of preemption of using a natural phenomenon that would shift a claim into being found patent-eligible. However, this “complete preemption” language from *Ariosa* has been morphed into a tool used by courts to *ignore* preemption entirely, divorcing the § 101 inquiry from its very foundation.

This language from *Ariosa* (or similar language) has been used repeatedly as the sole basis to reject a patentee’s attempt to raise lack of preemption. *See, e.g., Return Mail, Inc. v. United States Postal Serv.*, 868 F.3d 1350, 1370 (Fed. Cir. 2017), *rev’d on other grounds*, 587 U.S. --- (2019); *Intell. Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1321 (Fed. Cir. 2016), *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1150 (Fed. Cir. 2016). A common rationale this Court has stated to justify ignoring preemption risk is that “the lack of preemption risk cannot save claims that are deemed to only be directed to patent-ineligible subject matter.” *E.g., Return Mail*, 868 F.3d at 1370. But this reasoning nonsensically presumes the *conclusion* of ineligibility without addressing the *basis* of ineligibility. Preemption risk is the sine qua non of the patent-eligibility determination, as repeatedly confirmed by the Supreme Court, and therefore arguments and evidence showing a lack of preemption risk should not be summarily cast aside.

Tellingly, in other cases, this Court has used preemption—or the lack thereof—as a key factor to explain why certain claims *are* patent-eligible. In *McRO, Inc. v. Bandai Namco Games Am. Inc.*, this Court highlighted that specificity *and* lack of preemption are relevant at Step One. 837 F.3d 1299, 1316 (Fed. Cir. 2016) (emphasis added) (“By incorporating the specific features of the rules as claim limitations, claim 1 is limited to a specific process for automatically animating characters using particular information and techniques *and* does not preempt approaches that use rules of a different structure or different techniques.”). (Emphasis added). Further, in *Bascom Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, this Court relied on preemption as the *sole basis* to distinguish four prior decisions of this Court that found ineligibility. 827 F.3d 1341, 1352 (Fed. Cir. 2016) (discussing *Intell. Ventures I LLC v. Cap. One Bank (USA)*, 792 F.3d 1363, 1371 (Fed. Cir. 2015); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715-16 (Fed. Cir. 2014), and *Accenture Glob. Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344-45 (Fed. Cir. 2013)). The claims in these four cases “claim an abstract idea implemented on generic computer components, without providing a specific technical solution beyond simply using generic computer concepts in a conventional way.” 827 F.3d at 1352. The sole basis for that conclusion relied on finding that those invalidated claims “**preempted all**

use of the claimed abstract idea,” and were therefore patent-ineligible. *Bascom* at 1352 (emphasis added).

These and other Federal Circuit precedent have equated preemption with a lack of specificity in the claims. *See, e.g., Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 967 F.3d 1285, 1298 (Fed. Cir. 2020) (discussing *Diamond v. Diehr*, 450 U.S. 175 (1981)) (emphasis added) (“The [*Diehr*] invention involved a new rubber-curing process with a **specific and detailed series of steps** (one of which included the use of a natural law) that **limited the possibility of preempting** the natural law itself.”), *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1259 (Fed. Cir. 2014) (distinguishing the instant claims from *Ultramercial*) (emphasis added) (“It is also clear that the claims at issue **do not attempt to preempt every application** of the idea of increasing sales by making two web pages look the same...Rather, they recite a **specific way** to automate the creation of a composite web page....”). Accordingly, the absence of preemption—especially to a technically relevant extent, *e.g.*, the existence of alternative uses of the abstract idea outside of the claimed invention—may be a guidepost to explain why claims are “specific” enough.

Taken together, this body of case law indicates specificity and preemption are *two sides of the same coin, not two different coins*. This Court has never articulated why preemption may inform or even control “specificity” (and therefore, eligibility) in some cases and not others.

The § 101 analysis should return to the Supreme Court’s original concern: whether claims “risk *disproportionately* tying up the use” of abstract ideas, laws of nature, or natural phenomena. *Alice*, 573 U.S. at 217 (emphasis added). At present, many district court cases simply echo the arbitrary and dismissive approach to preemption fomented by *Ariosa* and related caselaw. *E.g.*, *Coqui Techs., LLC v. Gyft, Inc.*, No. CV 17-777-CFC-SRF, 2018 WL 6033479, at *7 (D. Del. Nov. 16, 2018) (emphasis added) (“[T]he ’864 patent is **no closer to achieving patent-eligibility** under § 101 **due to any lack of preemption concern.**”); *Voip-Pal.Com, Inc. v. Apple Inc.*, 411 F. Supp. 3d 926, 972-73 (N.D. Cal. 2019) (writing “courts have sometimes discussed the Step Two analysis in terms of preemption” in relation to *DDR Holdings*, but quoting *Ariosa* to dismiss a lack of preemption argument in a separate section *after* Step One and Step Two), *aff’d*, 828 F. App’x 717 (Fed. Cir. 2020), *cert. pending*, Nos. 2020-1241, 2020-1244 (June 29, 2020); *Cave Consulting Grp., Inc. v. Truven Health Analytics Inc.*, No. 15-CV-02177-SI, 2017 WL 6405621, at *11 (N.D. Cal. Dec. 15, 2017) (granting summary judgment of invalidity under § 101, even where patentee submitted evidence creating a factual dispute regarding preemption) (“Thus, while the parties dispute as a factual matter whether the asserted claims preempt the field of ways of measuring physician efficiency, the Court finds that this factual dispute does not preclude summary judgment.”), *aff’d*, 756 F. App’x 997 (Fed. Cir. 2019).

A patentee's efforts to show no disproportionate preemption should not automatically be swept aside by merely reciting these talismanic rationales from cases like *Ariosa* and *Return Mail*. Instead, courts must engage in meaningfully analyzing the scope of preemption as part of an eligibility determination.

Here, the district court's approach—excising preemption from § 101—should not be sanctioned by summary affirmance. The district court relegated preemption to a footnote that reveals its analytical shortcomings: it found preemption *irrelevant* unless raised by the accused infringer. Appx18, n.5 (citing *Return Mail*, 868 F.3d at 1370) (emphasis added) (“**Facebook does not raise preemption as a ground for dismissal.** In any event, the absence of complete preemption does not render the Image Patents any less abstract.”). The district court not only acknowledged that Facebook *did not raise preemption*, but also failed to consider preemption in its own analysis. Moreover, the district court *separated* preemption from the *Alice* test, as a “ground for dismissal” untethered from § 101. Regardless, the legal inquiry cannot be controlled by whether the accused infringer phrases its arguments to include the term preemption, as the district court found here.

In any case, the record indicates that the Image Patents do not disproportionately preempt the field of moving a portable unit to view an image, nor attempt to monopolize the use of motion in a particular technological environment. Appellant's briefing identified specific implementations not covered by claim 1 of the '400 patent—including actual approaches implemented by competitors within

the field—and rebutted Facebook’s single paragraph attempting to argue otherwise. *See* OB32, n.2, OB40; Reply at 16-17. Further, the PTAB’s decisions denying institution of IPR indicate that “background image of a stationary map” meaningfully distinguishes the Image Patents from prior art involving the same abstract idea of “moving a portable unit to view more of an image.” In short, there is no record evidence in this case that the Image Patents pose a risk of any significant or disproportionate preemption, much less complete preemption.

CONCLUSION

For the foregoing reasons, Appellant requests that the Court reconsider *en banc* the panel’s decision and reverse the judgment below. The panel’s summary affirmance furthers a misguided version of the § 101 analysis, instead of one that focuses on the claimed advance and considers the lack of preemption.

Dated: August 9, 2021

Respectfully submitted,

STROOCK & STROOCK & LAVAN LLP

/s/ Timothy Gilman

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ADDENDUM

NOTE: This disposition is nonprecedential.

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

THADDEUS GABARA,
Plaintiff-Appellant

v.

FACEBOOK, INC.,
Defendant-Appellee

2020-2333

Appeal from the United States District Court for the Southern District of New York in No. 1:19-cv-09890-DLC, Senior Judge Denise Cote.

JUDGMENT

TIMOTHY GILMAN, Stroock & Stroock & Lavan LLP, New York, NY, argued for plaintiff-appellant. Also represented by BINNI N. SHAH.

ERIC SHUMSKY, Orrick, Herrington & Sutcliffe LLP, Washington, DC, argued for defendant-appellee. Also represented by ABIGAIL COLELLA, New York, NY; ERIN MARIE BOYD LEACH, Irvine, CA.

THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (MOORE, *Chief Judge*, REYNA and HUGHES, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

July 8, 2021
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2020-2333

Short Case Caption: Gabara v. Facebook, Inc.

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Date: 08/09/2021

Signature: /s/ Timothy K. Gilman

Name: Timothy K. Gilman