

Nos. 2025-1045 & 2025-1046

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

OLLNOVA TECHNOLOGIES LTD.,

Plaintiff-Appellant,

– v. –

ECOBEE TECHNOLOGIES ULC, dba ecobee,

Defendant-Cross-Appellant.

*Appeal from the United States District Court for the
Eastern District of Texas, Marshall Division
Case No. 2:22-cv-00072-JRG
Judge J. Rodney Gilstrap*

**BRIEF OF *AMICI CURIAE* SAP AMERICA, INC., HP INC., FORESCOUT
TECHNOLOGIES, INC., AND HIGH TECH INVENTORS ALLIANCE
(HTIA) IN SUPPORT OF DEFENDANT-CROSS-APPELLANT**

Katherine Vidal
WINSTON & STRAWN LLP
1901 L St. NW
Washington, D.C. 20036
(202) 282-5000
KVidal@winston.com

William Logan
WINSTON & STRAWN LLP
800 CAPITOL STREET, SUITE 2400
Houston, TX 77002
(202) 282-5000
WLogan@winston.com

Counsel for Amici Curiae

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

CERTIFICATE OF INTEREST

Case Number Nos. 2025-1045 & 2025-1046

Short Case Caption Ollnova Technologies Ltd. v. ecobee Technologies ULC

Filing Party/Entity Amici Curiae

Instructions:

1. Complete each section of the form and select none or N/A if appropriate.
2. Please enter only one item per box; attach additional pages as needed, and check the box to indicate such pages are attached.
3. In answering Sections 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance.
4. Please do not duplicate entries within Section 5.
5. Counsel must file an amended Certificate of Interest within seven days after any information on this form changes. Fed. Cir. R. 47.4(c).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 02/11/2025

Signature: /s/ Katherine Vidal

Name: Katherine Vidal

FORM 9. Certificate of Interest

Form 9 (p. 2)
March 2023

1. Represented Entities. Fed. Cir. R. 47.4(a)(1).	2. Real Party in Interest. Fed. Cir. R. 47.4(a)(2).	3. Parent Corporations and Stockholders. Fed. Cir. R. 47.4(a)(3).
Provide the full names of all entities represented by undersigned counsel in this case.	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. <input checked="" type="checkbox"/> None/Not Applicable	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. <input type="checkbox"/> None/Not Applicable
SAP America, Inc.		SAP SE is the parent corporation of SAP America, Inc.
Forescout Technologies, Inc.		Ferrari Intermediate, Inc. is the parent corporation of Forescout Technologies, Inc.
HP Inc.		The Vanguard Group and BlackRock, Inc. each own 10% or more stock in HP Inc.
High Tech Inventors Alliance (HTIA)		None

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).

None/Not Applicable Additional pages attached

5. Related Cases. Other than the originating case(s) for this case, are there related or prior cases that meet the criteria under Fed. Cir. R. 47.5(a)?

Yes (file separate notice; see below) No N/A (amicus/movant)

If yes, concurrently file a separate Notice of Related Case Information that complies with Fed. Cir. R. 47.5(b). **Please do not duplicate information.** This separate Notice must only be filed with the first Certificate of Interest or, subsequently, if information changes during the pendency of the appeal. Fed. Cir. R. 47.5(b).

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

TABLE OF CONTENTS

I.	Interest of <i>Amici Curiae</i>	1
II.	Summary of Argument	1
III.	Legal Background.....	2
IV.	Argument.....	4
V.	Conclusion.....	7

TABLE OF AUTHORITIES

Cases

<i>Alice Corp. v. CLS Bank Int’l</i> , 573 U.S. 208 (2014)	2, 3, 4, 7
<i>BSG, Tech LLC v. BuySeasons, Inc.</i> , 899 F.3d 1281 (Fed. Cir. 2018).....	3
<i>Int’l Bus. Mach. Corp. v. Zillow Grp., Inc.</i> , 50 F.4th 1371 (Fed. Cir. 2022).....	2
<i>Mayo Collab. Servs. v. Prometheus Lab’ys, Inc.</i> , 566 U.S. 66 (2012).....	2, 3, 4
<i>Ollnova Techs. Ltd. v. ecobee Techs. ULC</i> , No. 2:22-cv-00072-JRG, 2024 WL 4107482 (E.D. Tex. Sept. 6, 2024)	1
<i>SAP Am., Inc. v. InvestPic, LLC</i> , 898 F.3d 1161 (Fed. Cir. 2018).....	2, 3, 4

Statutes

35 U.S.C. § 101.....	2
----------------------	---

Other Authorities

Fed. Cir. R. 29(c).....	1
-------------------------	---

I. INTEREST OF *AMICI CURIAE*

The *amici curiae* are companies that are on occasion involved in patent litigation in the district courts of the United States of America and an organization whose members are similarly involved. They have an interest in avoiding juries upholding patents on ineligible subject matter, and in establishing appellate guidance allowing district courts to properly instruct juries on subject matter eligibility. They have no stake in the parties or in the outcome of the case. The names of the members of the *amici* are SAP America, Inc., HP Inc., Forescout Technologies, Inc., and High Tech Inventors Alliance (HTIA).¹

II. SUMMARY OF ARGUMENT

The district court's jury instruction and verdict form question on patent eligibility in *Ollnova*—which has become the model for patent eligibility in the Eastern District of Texas and has been imported into other districts—are legally incorrect. *See Ollnova Techs. Ltd. v. ecobee Techs. ULC*, No. 2:22-cv-00072-JRG, 2024 WL 4107482 (E.D. Tex. Sept. 6, 2024). The instructions lower the standard for patent eligibility and permit a jury to uphold claims where their only inventiveness lies in the patent ineligible subject matter, contrary to the Supreme Court's *Alice-*

¹ No party's counsel authored this brief in whole or in part. No party, party's counsel, or other person contributed money intended to fund preparing or submitting this brief. Consent was sought from each party. Plaintiff-Appellant Ollnova Technologies Ltd. expressly withheld its consent to the filing of this brief. Fed. Cir. R. 29(c). A motion for leave is being filed with this brief.

Mayo framework, and the clear edict from this Court that, even if “the techniques claimed are groundbreaking, innovative, or even brilliant, . . . that is not enough for eligibility” when “the advance lies entirely in the realm of abstract ideas.” *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018) (quotations omitted); *see also Int’l Bus. Mach. Corp. v. Zillow Grp., Inc.*, 50 F.4th 1371, 1379 (Fed. Cir. 2022) (explaining that at Step Two “we evaluate whether the claims disclose ‘additional features . . . that constitute an inventive concept’”).

This Court has not yet addressed this issue.

III. LEGAL BACKGROUND

The law concerning Section 101 is well established. Through *Alice* and *Mayo*, the Supreme Court set forth a two-step test for determining whether a claim is directed to ineligible subject matter under 35 U.S.C. § 101. At Step One, the court must “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” *e.g.*, an abstract idea. *See Alice Corp. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014). (“Laws of nature, natural phenomena, and abstract ideas are not patentable.”).

If a claim is directed to ineligible subject matter, Step Two requires a determination of “whether [any] additional elements transform the nature of the claim into a patent-eligible application” by reciting “an inventive concept—*i.e.*, an element or combination of elements that is sufficient to ensure that the patent in

practice amounts to significantly more than a patent upon the ineligible concept itself.” *Alice*, 573 U.S. at 217–18 (quotations omitted; emphasis added). Such elements must be more than a “well-understood, routine, conventional activity” previously known in the art. *Mayo Collab. Servs. v. Prometheus Lab’ys, Inc.*, 566 U.S. 66, 79 (2012).

Relevant to this appeal, even if “the techniques claimed are groundbreaking, innovative, or even brilliant, . . . that is not enough for eligibility” when “the advance lies entirely in the realm of abstract ideas.” *SAP Am.*, 898 F.3d at 1163 (quotations omitted). “What is needed is an inventive concept in the non-abstract application realm.” *Id.* at 1168. “[A] claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept.” *BSG, Tech LLC v. BuySeasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018). The “relevant inquiry is not whether the claimed invention *as a whole* is unconventional or non-routine.” *Id.* (emphasis added). Rather, to properly evaluate the claims under Step Two of the *Alice-Mayo* standard, the abstract idea must be identified, set aside, and then “we ask . . . *what else* is there in the claims before us?” *See id.* (quoting *Mayo*, 566 U.S. at 78) (emphasis added). If that “what else” 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.” *Id.* at 1290–91.

IV. ARGUMENT

The district court’s jury instructions and verdict form misstate the relevant inquiry, and their use in this case—and in others that use them as a model—constitutes reversible error. They erroneously permit a jury to find that a claim satisfies the “inventive concept” requirement of *Alice* Step Two based on the features of an abstract idea itself instead of disregarding the abstract idea and considering only the non-abstract claim elements that describe something other than the ineligible abstract idea.

In particular, the jury instructions and verdict form allow a finding of patent-eligibility if the practical application of an abstract idea is wholly conventional and the *only* unconventional aspect of the claim lies in the abstract idea itself. But the law requires that claims directed to abstract ideas are *not* patent eligible unless they provide an inventive concept in “the non-abstract application realm.” *SAP, Am.*, 898 F.3d at 1168. The Supreme Court has defined the term “inventive concept” as “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice*, 573 U.S. at 217-18, (quoting *Mayo*, 566 U.S. at 72-73). An abstract idea cannot supply an “inventive concept” because it cannot “amount to significantly more” than itself. Therefore, once a claim is found to be directed to an abstract idea, the idea itself is irrelevant to the Step Two analysis, and the required inventive

concept can only be supplied by the non-abstract claim elements (if any) that are added to the abstract idea.

The instructions and verdict form invited the jury, in its conventionality analysis, to consider, rather than ignore, the abstract idea. In this case, and as stated in substantially the same terms in similar cases, the court instructed the jury as follows:

To succeed on its claims for patent ineligibility, ecobee must establish two things. The first is whether the claims are directed to an abstract idea. That issue is one for the Court to decide and not the jury. It is not something you will have to decide in this case.

However, you, the jury, will decide the second question related to patent eligibility. Specifically, and in that regard, ecobee must show that the claims involve nothing more than the performance of activities which a person of ordinary skill in the art would have considered well-understood, routine, and conventional at the time the patent application was filed. You, the jury, will determine this issue.

To meet its burden on this issue, ecobee must show by clear and convincing evidence that the asserted claims of the '495 patent involve only technology which a person of ordinary skill in the art would have considered to be well-understood, routine, and conventional as of April the 9th, 2004. The mere fact that something was known in the art at the time does not necessarily mean that it was well-understood, routine, and conventional. Rather, the test is whether, in view of all the evidence, a person of ordinary skill in the art would have considered the claim to involve only technology that was well-understood, routine, and conventional as of April the 9th, 2004.

You should consider all the evidence presented during this trial, including the testimony of the witnesses as well as the exhibits introduced, including the specifications within the patents-in-suit. If the evidence shows by clear and convincing evidence that the elements of the asserted claims, when taken individually or when taken as an

ordered combination, involve only technology which a person of ordinary skill in the art would have considered to be well-understood, routine, and conventional, then this element of patent ineligibility has been established.

Trial Tr. at 1240:4-1241:12 (emphases added). The verdict form asked the jury, in relevant part:

Did ecobee prove by clear and convincing evidence that the limitations of the asserted claims of the '495 Patent, when taken individually or when taken as an ordered combination, involve only technology which a person of ordinary skill in the art would have considered to be well-understood, routine, and conventional as of April 9, 2004?

Yes: _____ OR No: _____

Dkt. 225 at 5 (emphasis added). Plaintiff-Appellant should not have been required to prove that the abstract idea was unconventional. But the court, by instructing the jury that “ecobee must show that the claims involve nothing more than the performance of activities which . . . would have [been] considered well-understood, routine, and conventional at the time the patent application was filed,” improperly imposed exactly this requirement on ecobee. Trial Tr. at 1240:4–1241:12 (emphasis added).

By using a jury instruction and verdict form that allowed the jury to find claims patent eligible if the abstract idea itself incorrectly served as the basis for the inventive concept, the court committed reversible error. The importance of this error is compounded by the reuse across other cases of the same or substantially similar language in instructions and verdict forms. This Court should correct the error in this

case and prevent its perpetuation by clarifying that a jury must exclude the abstract idea from consideration under *Alice* Step Two. The Court should further clarify that, in the conventionality analysis, juries may consider only the “additional elements” that describe something other than, and in addition to, the abstract idea.

V. CONCLUSION

The *amici* ask this Court to find the instruction and verdict form erroneous and to provide clear guidance to the district courts as to how similar instructions and verdict forms should be structured.

Dated: February 11, 2025

Respectfully submitted,

By: /s/ Katherine Vidal

Katherine Vidal
WINSTON & STRAWN LLP
1901 L St. NW
Washington, D.C. 20036
(202) 282-5000
KVidal@winston.com

William Logan
WINSTON & STRAWN LLP
800 CAPITOL STREET
SUITE 2400
Houston, TX 77002
(202) 282-5000
WLogan@winston.com

Counsel for Amici Curiae

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

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: Nos. 2025-1045 & 2025-1046

Short Case Caption: Ollnova Technologies Ltd. v. ecobee Technologies ULC

Instructions: When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

The foregoing filing complies with the relevant type-volume limitation of the Federal Rules of Appellate Procedure and Federal Circuit Rules because it meets one of the following:

- the filing has been prepared using a proportionally-spaced typeface and includes 1653 words.
- the filing has been prepared using a monospaced typeface and includes _____ lines of text.
- the filing contains _____ pages / _____ words / _____ lines of text, which does not exceed the maximum authorized by this court's order (ECF No. _____).

Date: 02/11/2025

Signature: Katherine Vidal

Name: Katherine Vidal