

## **Intellectual Ventures I v. Symantec: Free Speech vs. Patent-Eligibility**

Today in *Intellectual Ventures I LLC v. Symantec Corp.*, \_\_\_ F.3d \_\_\_, \_\_\_(Fed. Cir. 2016)(Mayer, J., concurring), one member of the court took the unique view that grant of a patent to the innovation, here, would be a violation of the First Amendment:

“[T]he Constitution protects the right to receive information and ideas. . . . This right to receive information and ideas, regardless of their social worth, is fundamental to our free society.’ *Stanley v. Georgia*, 394 U.S. 557, 564 (1969) (citations omitted). Patents, which function as government-sanctioned monopolies, invade core First Amendment rights when they are allowed to obstruct the essential channels of scientific, economic, and political discourse. See *United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 812 (2000) (‘The distinction between laws burdening and laws banning speech is but a matter of degree.’); see also *In re Tam*, 808 F.3d 1321, 1340 (Fed.Cir. 2015) (en banc) (explaining that the government may impermissibly burden speech ‘even when it does so indirectly’).”

**Whither O’Reilly v. Morse**: Historically, there have been breakthrough methods to disseminate information, challenged on traditional grounds, but never on the basis of the First Amendment. See, e.g., the Telegraph Case, *O’Reilly v. Morse*, 56 U.S. (15 How.) 62 (1853).

The relevant portion of the concurring opinion is attached.

Regards,

Hal

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

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**INTELLECTUAL VENTURES I LLC,**  
*Plaintiff-Appellant*

v.

**SYMANTEC CORP.,**  
*Defendant-Cross-Appellant*

**TREND MICRO INCORPORATED, TREND MICRO,  
INC. (USA),**  
*Defendants-Appellees*

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2015-1769, 2015-1770, 2015-1771

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Appeals from the United States District Court for the District of Delaware in Nos. 1:10-cv-01067-LPS, 1:12-cv-01581-LPS, Chief Judge Leonard P. Stark.

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MAYER, *Circuit Judge*, concurring.

I agree that all claims on appeal fall outside of 35 U.S.C. § 101. I write separately, however, to make two points: (1) patents constricting the essential channels of online communication run afoul of the First Amendment; and (2) claims directed to software implemented on a generic computer are categorically not eligible for patent.

## I.

“[T]he Constitution protects the right to receive information and ideas. . . . This right to receive information and ideas, regardless of their social worth, is fundamental to our free society.” *Stanley v. Georgia*, 394 U.S. 557, 564 (1969) (citations omitted). Patents, which function as government-sanctioned monopolies, invade core First Amendment rights when they are allowed to obstruct the essential channels of scientific, economic, and political discourse. *See United States v. Playboy Entm’t Grp., Inc.*, 529 U.S. 803, 812 (2000) (“The distinction between laws burdening and laws banning speech is but a matter of degree.”); *see also In re Tam*, 808 F.3d 1321, 1340 (Fed. Cir. 2015) (en banc) (explaining that the government may impermissibly burden speech “even when it does so indirectly”).

Although the claims at issue here disclose no new technology, they have the potential to disrupt, or even derail, large swaths of online communication. U.S. Patent No. 6,460,050 (the “’050 patent”) purports to cover methods of “identifying characteristics of data files,” ’050 patent, col. 8 l. 13, whereas U.S. Patent No. 6,073,142 (the “’142 patent”) broadly claims systems and methods which allow an organization to control internal email distribution, ’142 patent, col. 1 ll. 15–34. U.S. Patent No. 5,987,610 (the “’610 patent”) describes, in sweeping terms, screening a communication for viruses or other harmful content at an intermediary location before delivering it to an addressee. *See* ’610 patent, col. 14 ll. 34–47. The asserted claims speak in vague, functional language, giving them the elasticity to reach a significant slice of all email traffic. *See Gottschalk v. Benson*, 409 U.S. 63, 69 (1972) (“*Benson*”) (explaining that claims are patent eligible only if they contain limitations “sufficiently definite to confine the patent monopoly within rather definite bounds”). Indeed, the claims of the ’610 patent could reasonably be read to cover most methods of screening for

harmful content while data is being transmitted over a network. See '610 patent, col. 1 ll. 59–61 (describing “screen[ing] computer data for viruses within a telephone network before communicating the computer data to an end user”).

Suppression of free speech is no less pernicious because it occurs in the digital, rather than the physical, realm. “[W]hatever the challenges of applying the Constitution to ever-advancing technology, the basic principles of freedom of speech and the press, like the First Amendment’s command, do not vary when a new and different medium for communication appears.” *Brown v. Entm’t Merchs. Ass’n*, 564 U.S. 786, 790 (2011) (citations and internal quotation marks omitted). Essential First Amendment freedoms are abridged when the Patent and Trademark Office (“PTO”) is permitted to balkanize the Internet, granting patent owners the right to exact heavy taxes on widely-used conduits for online expression.

Like all congressional powers, the power to issue patents and copyrights is circumscribed by the First Amendment. See *Golan v. Holder*, 132 S. Ct. 873, 889–93 (2012); *Eldred v. Ashcroft*, 537 U.S. 186, 219–21 (2003). In the copyright context, the law has developed “built-in First Amendment accommodations.” *Eldred*, 537 U.S. at 219; see also *Park ’N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 201 (1985) (noting that the Lanham Act contains safeguards to prevent trademark protection from “tak[ing] from the public domain language that is merely descriptive”). Specifically, copyright law “distinguishes between ideas and expression and makes only the latter eligible for copyright protection.” *Eldred*, 537 U.S. at 219; see also *Harper & Row Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 556 (1985) (explaining that “copyright’s idea/expression dichotomy” supplies “a definitional balance between the First Amendment and the Copyright Act by permitting free communication of facts while still protecting an author’s expression” (citations and internal

quotation marks omitted)). It also applies a “fair use” defense, permitting members of “the public to use not only facts and ideas contained in a copyrighted work, but also expression itself in certain circumstances.” *Eldred*, 537 U.S. at 219; *see* 17 U.S.C. § 107 (“[T]he fair use of a copyrighted work, including such use by reproduction in copies . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.”).

Just as the idea/expression dichotomy and the fair use defense serve to keep copyright protection from abridging free speech rights, restrictions on subject matter eligibility can be used to keep patent protection within constitutional bounds. Section 101 creates a “patent-free zone” and places within it the indispensable instruments of social, economic, and scientific endeavor. *See Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (emphasizing that the “building blocks of human ingenuity” are patent ineligible); *Benson*, 409 U.S. at 67 (stating that “mental processes . . . and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work”). Online communication has become a “basic tool[],” *Benson*, 409 U.S. at 67, of modern life, driving innovation and supplying a widely-used platform for political dialogue. *See Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014) (noting that the Internet “is a ubiquitous information-transmitting medium”); *see also U.S. Telecom Ass’n v. Fed. Comm’n Comm’n*, 825 F.3d 674, 698 (D.C. Cir. 2016) (explaining that online communication “has transformed nearly every aspect of our lives, from profound actions like choosing a leader, building a career, and falling in love to more quotidian ones like hailing a cab and watching a movie”). Section 101, if properly applied, can preserve the Internet’s open architecture and weed out those

patents that chill political expression and impermissibly obstruct the marketplace of ideas.

As both the Supreme Court and this court have recognized, section 101 imposes “a threshold test,” *Bilski v. Kappos*, 561 U.S. 593, 602 (2010), one that must be satisfied before a court can proceed to consider subordinate validity issues such as non-obviousness under 35 U.S.C. § 103 or adequate written description under 35 U.S.C. § 112. *See Parker v. Flook*, 437 U.S. 584, 593 (1978) (“*Flook*”) (“The obligation to determine what type of discovery is sought to be patented” so as to determine whether it falls within the ambit of section 101 “must precede the determination of whether that discovery is, in fact, new or obvious.”); *In re Comiskey*, 554 F.3d 967, 973 (Fed. Cir. 2009) (“Only if the requirements of § 101 are satisfied is the inventor allowed to pass through to the other requirements for patentability, such as novelty under § 102 and . . . non-obviousness under § 103.” (citations and internal quotation marks omitted)); *State St. Bank & Trust Co. v. Signature Fin. Grp., Inc.*, 149 F.3d 1368, 1372 n.2 (Fed. Cir. 1998) (explaining that section 101 is “[t]he first door which must be opened on the difficult path to patentability” (citations and internal quotation marks omitted)). Indeed, if claimed subject matter is not even *eligible* for patent protection, any pronouncement on whether it is novel or adequately supported by the written description constitutes an impermissible advisory opinion. *See, e.g., Golden v. Zwicker*, 394 U.S. 103, 108 (1969) (emphasizing that Article III courts “do not render advisory opinions” (citations and internal quotation marks omitted)).

The public has a “paramount interest in seeing that patent monopolies . . . are kept within their legitimate scope.” *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016) (citations and internal quotation marks omitted); *see also Medtronic, Inc. v. Mirowski Family Ventures, LLC*, 134 S. Ct. 843, 851 (2014). Nowhere is

that interest more compelling than in the context of claims that threaten fundamental First Amendment freedoms. *See Palko v. Connecticut*, 302 U.S. 319, 326–27 (1937) (“[F]reedom of thought and speech . . . is the matrix, the indispensable condition, of nearly every other form of freedom.”). “As the most participatory form of mass speech yet developed, the Internet deserves the highest protection from governmental intrusion.” *ACLU v. Reno*, 929 F. Supp. 824, 883 (E.D. Pa. 1996), *aff’d*, 521 U.S. 844 (1997). A robust application of section 101 at the outset of litigation will ensure that the essential channels of online communication remain “free to all men and reserved exclusively to none,” *Funk Brothers Seed Co. v. Kalo Inoculant Co.*, 333 U.S. 127, 130 (1948).

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## II.

Most of the First Amendment concerns associated with patent protection could be avoided if this court were willing to acknowledge that *Alice* sounded the death knell for software patents. The claims at issue in *Alice* were directed to a computer-implemented system for mitigating settlement risk. 134 S. Ct. at 2352–53. Although the petitioners argued that their claims were patent eligible because they were tied to a computer and a computer is a tangible object, the Supreme Court unanimously and emphatically rejected this argument. *Id.* at 2358–60. The Court explained that the “mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Id.* at 2358. Accordingly, “[t]he fact that a computer necessarily exist[s] in the physical, rather than purely conceptual, realm is beside the point” in the section 101 calculus. *Id.* (citations and internal quotation marks omitted).

Software is a form of language—in essence, a set of instructions. *See Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 447 (2007) (explaining that “software” is “the set of instructions, known as code, that directs a computer to