

Case No. 2021-1052

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

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MONUMENT PEAK VENTURES, LLC

*Plaintiff-Appellant,*

v.

TOSHIBA AMERICA BUSINESS SOLUTIONS, INC., TOSHIBA AMERICA  
ELECTRONIC COMPONENTS, INC., TOSHIBA CORPORATION,

*Defendants-Appellees*

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*On Appeal from the United States District Court for the Central District of  
California in Case No. 8:19-cv-02181-DOC-DFM, Judge David O. Carter*

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**BRIEF OF DEFENDANTS-APPELLEES  
TOSHIBA AMERICA BUSINESS SOLUTIONS, INC.,  
TOSHIBA AMERICA ELECTRONIC COMPONENTS, INC.,  
AND TOSHIBA CORPORATION**

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June 25, 2021

Corrected Brief Filed: June 25, 2021

**LANGUAGE OF THE PATENT CLAIMS**

Claim 8 of the '064 Patent is as follows:

8. A system comprising:

an image capture device including a memory, a user interface, and a processing system, wherein the processing system is configured to:

store captured images in the memory of the image capture device;

allow for the transfer of at least some of the stored images to a remote storage device;

store, in the image capture device, data indicating which of the stored images have been transferred to the remote storage device;

receive, from the user interface, an indication that all captured images that have been stored and previously transferred to the remote storage device are to be deleted;

delete, from the memory, all captured images that have been stored and previously transferred to the remote storage device in response to the receipt of the indication that all captured images that have been stored and previously transferred to the remote storage device are to be deleted.

Claim 9 of the '095 Patent is as follows:

9. A system comprising:

an image capture device including a memory, a user interface, and a processing system, wherein the processing system is configured to:

communicate at least one of a plurality of captured images in the memory of the image capture device to a remote storage device;

store, in the image capture device, data indicating which of the plurality of captured images have been communicated to the remote storage device; and

delete, from the memory, captured images that have been stored and previously transferred to the remote storage device in response to receiving an indication that captured images that have been stored and previously communicated to the remote storage device are to be deleted.

Claim 5 of the '294 Patent is as follows:

5. A method for determining the presence of a face from image data, said method comprising the steps of:

- (a) prescreening the image data with a first algorithm by using an algorithm interface adapter, the first algorithm determining a plurality of face candidates; and
- (b) operating on the face candidates with a second algorithm, the second algorithm processing the face candidates to determine the presence of the face;

wherein the first algorithm has a first rate of false positives, and the second algorithm has a second rate of false positives lower than the first rate of false positives.

Claim 1 of the '484 Patent is as follows:

1. A method of offering a customized promotional product to a user, the method comprising the steps of:

accessing a user-supplied digital image at a digital imaging device;

providing a digital image representative of a promotional product, the promotional product digital image having a predetermined image location adapted to receive at least a portion of the user-supplied digital image;

generating a modified user image by modifying the at least a portion of the user-supplied digital image to simulate an application of the at least a portion of the user-supplied image to the promotional product;

generating a customized digital image representative of the customized promotional product, the customized digital image comprising the promotional product digital image having the modified user image disposed within the predetermined image location; and

displaying the customized digital image to the user on a display of the digital imaging device.

Claim 19<sup>1</sup> of the '762 Patent is as follows:

19. A method for customizing a digital camera for at least two particular users by programming the programmable memory of the digital camera which controls the operation of the digital camera, the method comprising the steps of:

(a) displaying a list of selectable camera features that can be provided by the digital camera;

(b) a first user selecting a first desired camera feature from the displayed list of camera features;

(c) a second user selecting a second desired camera feature from the displayed list of camera features, wherein the second desired camera feature is different than the first desired camera feature;

(d) programming the programmable memory of the digital camera to enable the first desired camera feature and disable the second desired camera feature when the digital camera is used by the first user, and to enable the second desired camera feature and disable the first desired camera feature when the digital camera is used by the second user.

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<sup>1</sup> The district court's reference to claim 1 is a typographical error; the claim language reflected in the district court's decision is claim 19. Appx117.

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

**CERTIFICATE OF INTEREST**

**Case Number** 2021-1052

**Short Case Caption** Monument Peak Ventures, LLC v. Toshiba America Business

**Filing Party/Entity** Toshiba America Business Solutions, Inc.; Toshiba America Electronic Components, Inc.; and Toshiba Corporation

**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).

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

Date: 06/25/2021

Signature: /s/ Douglas F. Stewart

Name: Douglas F. Stewart

<p><b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).</p>	<p><b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).</p>	<p><b>3. Parent Corporations and Stockholders.</b> 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 type="checkbox"/> None/Not Applicable</p>
<p>Toshiba America Business Solutions, Inc.</p>		<p>Toshiba Tec Corporation and Toshiba America, Inc.</p>
<p>Toshiba America Electronic Components, Inc.</p>		<p>Toshiba America, Inc.</p>
<p>Toshiba Corporation</p>		<p>None</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).

None/Not Applicable  Additional pages attached

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**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).

None/Not Applicable  Additional pages attached


**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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### **STATEMENT OF RELATED CASES**

There are no prior appeals in or from the underlying action. There are no cases pending in other courts that will directly affect or be directly affected by this Court's decision in the instant appeal. U.S. Patent No. 7,583,294 was subject to a petition for *inter partes* review, captioned *Toshiba America Electronic Components, Inc. v. Monument Peak Ventures, LLC*, IPR2021-00330, which was denied — over a dissenting opinion — on June 25, 2021; the filing of a request for rehearing is anticipated. There are no other cases pending before any agency that will directly affect or be directly affected by this Court's decision in the instant appeal.

### **STATEMENT OF THE ISSUES**

1. Whether the district court correctly determined that the claims of the asserted patents are unpatentable under 35 U.S.C. § 101 after conducting the proper two-step *Alice/Mayo* analysis.

2. Whether the district court correctly dismissed Plaintiff-Appellant's amended claims for willful and induced infringement with prejudice after Plaintiff-Appellant elected to amend those claims in response to Defendants-Appellees' first motion to dismiss.

### **STATEMENT OF THE CASE**

Defendants-Appellees Toshiba America Business Solutions, Inc., Toshiba America Electronic Components, Inc., and Toshiba Corporation (collectively, "Toshiba") largely accept Plaintiff-Appellant Monument Peak Venture, LLC's

(“MPV”) statement of the case, but disagree that MPV pled “specific” or plausible allegations to support its claims, *see* Br. at 4, or that MPV’s synopsis of the patents bears on this appeal.

### **SUMMARY OF THE ARGUMENT**

On appeal, MPV identifies a number of highly duplicative issues, accusing the district court of rendering a decision that is “insufficient for this Court to meaningfully review,” but predicates its position on inapposite case law. MPV also seeks a procedurally improper and substantively meritless stay pending a decision by the Supreme Court on the *certiorari* petition in *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC* (No. 20-891).

Unlike some other § 101 decisions this Court has reviewed, this appeal is not a close case. The district court properly applied the two-step *Alice* framework, as that court has done in numerous other affirmed § 101 decisions. MPV’s arguments on appeal generally recycle its arguments to the district court and offer no legitimate reason for this Court to arrive at a different conclusion.

MPV once again incorrectly relies predominantly on *Berkheimer* and *Aatrix* to argue that it plausibly alleged facts that should have forestalled dismissal. MPV ignores that the district court correctly identified that MPV elected to file the Second Amended Complaint only after reviewing Toshiba’s initial motion to dismiss, which explained in detail why the asserted, representative claims fail to recite patent

eligible subject matter. Despite having a full opportunity to include additional factual allegations in the Second Amended Complaint addressing Toshiba's meticulously explained and supported arguments establishing the unpatentability of the asserted patents, MPV failed to do so. The Second Amended Complaint's allegations differ from those in the prior complaint only by couching legal conclusions as alleged facts, which the district court correctly disregarded. This Court should likewise disregard MPV's attempts to rely on legal conclusions to raise a factual dispute.

In addition, MPV's legal conclusions are contradicted by the claims and specifications of the patents themselves, which the district court correctly noted expressly identify the abstract, generic, and conventional aspects of the claimed inventions. This is confirmed by the fact that the patent claims fall squarely within consistent decisions of this Court invalidating similar claims. Toshiba's motion to dismiss exhaustively detailed these cases, which MPV failed to adequately address before the district court and continues to avoid on appeal, instead resorting to reliance on inapposite case law.

Rather than addressing these issues directly, MPV repeatedly argues that its self-labeled "well-pled facts" warrant a different outcome. MPV's unsupported proclamations do nothing to establish that the district court's conclusions were

erroneous. Nor do MPV's other arguments regarding the invalidity determination, which are repetitively echoed in conclusory fashion throughout MPV's brief.

First, MPV's assertion that the district court incorrectly identified representative claims is expressly contradicted by the language of the district court's decision. MPV was obligated to provide a cogent explanation as to why another claim is representative — a requirement that it completely ignored before the district court and on appeal. Even when MPV suggests that an alternative claim should be examined, it does not provide any “meaningful argument for the distinctive significance” of that claim, as required under *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365 (Fed. Cir. 2018), and merely states that a “narrower” claim should survive even though “a highly specific method for implementing an abstract idea is, at step 1 of the *Alice* test, still directed to that abstract idea.” *Bridge & Post, Inc. v. Verizon Commc'ns, Inc.*, 778 F. App'x 882, 889 (Fed. Cir. 2019).

Second, MPV asserts that the district court overgeneralized the focus of the patent claims at step one. MPV offers no specifics to support its contention and no alternative focus of the claims. Nor can it do so, as both the claims and specifications of the asserted patents confirm the district court's stated focus.

Third, MPV faults the district court for recognizing that the patent claims are abstract ideas long practiced by humans. MPV provides no facts to support its

contrary viewpoint and simply makes the statement without explanation or argument.

Fourth, MPV argues that the district court was required to distinguish MPV's cited authority, even though the district court cited applicable case law, Toshiba exhaustively identified applicable cases and distinguished MPV's cases, and MPV provides no authority indicating that the district court was obligated to address each one of MPV's inapposite cases.

Fifth, MPV contends that the district court should have addressed preemption, even though (1) preemption is not a separate test under *Alice/Mayo*, and (2) the absence of preemption does not establish patent eligibility.

Sixth, MPV's contention that the district court improperly dismissed the willful and induced infringement claims ignores that those allegations are nothing more than conclusory assertions. As such, the district court properly dismissed those claims.

Finally, MPV's argument that none of its claims should have been dismissed with prejudice misapplies the law and the facts.

Accordingly, the district court's decision should be affirmed, and MPV's "motion" for a stay should be denied.

## **ARGUMENT**

### **A. Standard Of Review**

Toshiba agrees with MPV that patent eligibility under 35 U.S.C. § 101 is an issue of law and that the district court's grant of a motion to dismiss under Fed. R. Civ. P. 12(b)(6) pursuant to § 101 is reviewed *de novo*. See Br. at 10; *see also Palm v. Los Angeles Dep't of Water & Power*, 889 F.3d 1081, 1085 (9th Cir. 2018) (citations omitted). However, Toshiba is unable to reconcile MPV's suggestion that a "reversible error" standard (as MPV attempts to define that standard in footnote 3 of its brief) is somehow relevant to this Court's review. It is not.

### **B. The District Court Correctly Concluded That The Claims Of The Five Patents At Issue Were Invalid Under § 101**

#### **1. The District Court Correctly Determined That The '064 Patent Is Invalid Under § 101**

##### **a. The District Court Properly Determined That The Analyzed Claims Were Representative**

MPV alleges (with respect to the '064 patent and every other patent) that the district court's Order "summarily state[s]" that the claims referenced in the Order are representative "without any explanation." Br. at 21; *see also* Br. at 26, 35, 44, & 49. MPV misconstrues the district court's explicit ruling on the representative nature of the analyzed claims in relation to each patent.

The district court correctly recognized that it may treat a claim as representative where the "patentee does not present any meaningful argument for

the distinctive significance of any claim limitations not found in the representative claim.” Appx6 (citing *Berkheimer*, 881 F.3d at 1365). The district court specifically explained that MPV failed to present any such arguments. Instead, MPV offered “only conclusory arguments against the representative nature of the claims and [did] not identify or explain why other claim limitations may be distinctive.” *Id.* Accordingly, the district court confirmed that it could “properly treat the representative claims identified in Defendants’ Memorandum as representative.” *Id.*

The district court’s conclusion is both appropriate and amply supported by the law and the record. Toshiba’s motion to dismiss examined each of the independent and dependent claims of the asserted patents, identified a representative claim, and articulated the lack of distinctive significance of any claim limitations not found in the representative claim. Appx327-329; Appx336-337; Appx338; Appx345-346; Appx350-351. Toshiba’s reply brief in further support of the motion to dismiss also explained that MPV’s opposition failed to identify how any other claims or limitations were patentably distinct, and therefore failed to counter Toshiba’s asserted representativeness of the claims. Appx524-525; Appx532-534; Appx537-538; Appx540-541.

Accordingly, because MPV did not offer any argument beyond conclusory assertions, and failed to “present any meaningful argument for the distinctive significance of any claim limitations not found” in the claims identified by Toshiba,

the district court properly treated those claims as representative.<sup>2</sup> *Berkheimer*, 881 F.3d at 1365; *see, e.g., Whitserve LLC*, 2021 WL 1608941, 2021 WL 1608941, at \*1-2 n.1 (affirming district court’s rejection of challenge to representativeness for identical reason); *Berkheimer*, 881 F.3d at 1365; *Data Scape Ltd. v. Western Digital Corp.*, 816 F. App’x 461, 464 (Fed. Cir. 2020) (affirming representative nature of claim where plaintiff “presented no separate argument for the eligibility of any claim aside from” the representative claim).

**b. Step 1 – The ’064 Patent Claims An Abstract Idea**

The district court properly determined that representative claim 8 of the ’064 patent used “generic computer hardware” to “perform a routine task.” Appx7. More specifically, the district court stated that representative claim 8 was directed to “nothing more than an abstract method for file management,” which humans can practice “by remembering or manually noting which photographs they have saved to remote storage and then deleting those images from the camera to free up space.” *Id.*

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<sup>2</sup> Separately, MPV “forfeited its ability to argue that other claims are separately patent eligible” because it does not address any other patent claim in its appeal. *British Telecomms. PLC v. IAC/InterActiveCorp*, 813 F. App’x 584, 587-88 (Fed. Cir. 2020) (citation omitted); *see also Enco Sys., Inc. v. DaVincia, LLC*, 845 F. App’x 953, 957 n.1 (Fed. Cir. 2021) (noting appellant’s waiver for failure to present an alternative representative claim on appeal); *Whitserve LLC v. Dropbox, Inc.*, No. 2019-2334, 2021 WL 1608941, at \*1-2 n. 1 (Fed. Cir. Apr. 26, 2021) (same).

The district court's conclusion is aptly demonstrated by the claim itself, which uses nothing more than generic functional language to recite a system to “store” images, allow “transfer” of images, “store . . . data” about the images, “receive” an indication that images should be deleted, and “delete” those images. Appx6-7. The correctness of the district court's conclusion is further underscored by the specification, which illustrates that the '064 patent's claims do nothing more than track whether data stored on the camera's memory has been transferred to another memory device in order to allow the user to select only transferred data for deletion. See Appx8; Appx28 at 3:6-11; Appx31 at 9:6-9, 10:15-18, 10:56-58; see also Appx329.

The district court's conclusion is also reinforced by this Court's holdings in other cases where the patent claims were, like the '064 patent, directed to the abstract idea of “systems [] for requesting, transmitting, receiving, copying, deleting, and storing records” that recited “fundamental” business practices that “existed well before the advent of computers and the Internet.” *Whitserve*, 2021 WL 1608941, at \*4 (affirming ineligibility where claims were directed to “maintaining data records, in particular, backing up data records”; quotation omitted); see also *Data Scape*, 816 F. App'x at 463-64 (affirming that “selective data storage, transfer, and processing” is an abstract idea, as is the concept of delivering data to remote devices); *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343,

1347 (Fed. Cir. 2014) (explaining that “[t]he concept of data collection, recognition, and storage is undisputedly well-known” and that “humans have always performed these functions”).

In opposition to this conclusion, MPV repeats four conclusory arguments at its step one-analysis for each of the ineligible patents. Each of MPV’s arguments is unpersuasive.

**(i) The District Court Properly Considered The ’064 Patent’s Claim Limitations Without “Oversimplifying” The Focus Of The Claims**

MPV’s contention that the district court “oversimplified” and “over-generalized” the claims contravenes the plain language of both the claims and specification. *See* Br. at 22. MPV offers no specifics to support its contention beyond the mere conclusory assertion itself.<sup>3</sup> Instead, MPV argues that the district court failed to consider the “specific technical solutions to specific technical problems” that the ’064 claims purportedly provide. *Id.* at 19-22. That argument fails.

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<sup>3</sup> MPV contends that “the district court’s over-generalization does not even apply to the ’064 claims,” and attempts to point to a “relevant claim limitation” regarding generic data storage. Br. at 23-24. However, MPV proceeds to summarize the entirety of representative claim 8 and, in doing so, demonstrates that the district court’s description of the patent — “a system by which stored images . . . can be flagged . . . and . . . subsequently deleted” — is accurate and indeed abstract.

First, MPV's accusation that the district court "erroneously ignore[d] the claim limitations and claimed detail," *id.* at 22, evidences a fundamental misunderstanding of the *Alice/Mayo* step one analysis. As this Court has repeatedly explained, the "step one inquiry looks to the claim's 'character as a whole' rather than evaluating each claim limitation in a vacuum." *Ericsson Inc. v. TCL Commc'n Tech. Holdings Ltd.*, 955 F.3d 1317, 1326 (Fed. Cir. 2020). Thus, to determine whether claims are directed to an abstract idea, a court must "ask what the patent asserts to be the focus of the claimed advance over the prior art . . . to determine whether the claim's character as a whole is directed to ineligible subject matter." *Simio, LLC v. FlexSim Software Prods., Inc.*, 983 F.3d 1353, 1359 (Fed. Cir. 2020) (citations and internal quotations omitted).

The district court undertook the correct analysis, stating that the focus of the claims is "a system by which stored images (in a camera's internal memory) can be flagged after being transferred to remote storage (such as a computer or external drive), and by which images flagged as transferred can be subsequently deleted from the camera's internal memory." Appx7. This is confirmed by the specification, which states that the "present disclosure relates" to "delet[ing] captured images or data files that have already been transferred in order to make room" for others, which is accomplished by "keep[in]g track of which images have already been transferred." Appx16, Abstract. Accordingly, the district court correctly determined that the '064

patent's claims, as a whole, were directed to the abstract concept of "file management," which is evidenced by the claims' purely functional recitation of data storage, transfer, receipt, and deletion. *See Simio*, 983 F.3d at 1360 ("And where, as here, the abstract idea tracks the claim language and accurately captures what the patent asserts to be the focus of the claimed advance . . ., characterizing the claim as being directed to an abstract idea is appropriate.") (internal quotation omitted).

Regardless, even if MPV's distorted step one inquiry was the correct standard, MPV provides no argument or citation to any aspect of the '064 patent to support its contention that any "limitations" or "detail" alter the district court's conclusion. MPV's alleged (and unspecified) "claim[] detail" does not alter the district court's conclusion because "even a highly specific method for implementing an abstract idea is, at step 1 of the *Alice/Mayo* test, still directed to that abstract idea." *Bridge & Post*, 778 F. App'x at 890; *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1287 (Fed. Cir. 2018) ("[A] claim is not patent eligible merely because it applies an abstract idea in a narrow way."). Moreover, to the extent the claimed unconventionality and technological improvements that MPV describes are meant to be the alleged "detail," *see* Br. at 19-21, those only reinforce the abstract nature of the claims by illustrating that the '064 patent does nothing more than improve a user's experience. *See Simio*, 983 F.3d at 1361 (rejecting argument that patent was not abstract due to claimed "improvements" that did "not explain how the

*computer's* functionality is improved beyond the inherent improvement of the experience of a user"; emphasis in original).

**(ii) The District Court Appropriately Disregarded MPV's Alleged Facts**

MPV asserts that the district court did not consider "well-pled facts" from the Second Amended Complaint, which, according to MPV, led the district court to incorrectly determine that the '064 patent merely describes a long-standing human practice and an improvement in computers as tools. *See* Br. at 15-16, 23, 24. The district court did not ignore any facts because MPV failed to plead facts.

In stating the governing standards for its review of a motion to dismiss, the district court correctly acknowledged its obligation to "accept[] as true a plaintiff's well-pleaded factual allegations and construe[] all factual inferences in the light most favorable to the plaintiff." Appx4-5. Crucially, the district court also observed that it was "not required to accept as true legal conclusions couched as factual allegations." Appx5 (citing *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009)); *see also* Appx4 (noting that the "plaintiff must provide 'more than labels and conclusions'") (quoting *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007)). The district court faithfully applied these standards, and MPV's criticisms are faulty for a variety of reasons.

First, the alleged "facts" referenced by MPV are not facts. They are legal conclusions and therefore entitled to no weight. *Iqbal*, 556 U.S. at 678. For

example, MPV points to unsupported allegations in its Second Amended Complaint that the claimed inventions purportedly solve technical problems and provide technical solutions to the mass transfer of images. *See* Br. at 19-21, 23. But a district court is not required to accept as true plaintiff's "characterization of its inventions as 'technical innovations,'" which is a "legal conclusion[] . . . even if couched as [a] factual allegation[]." *Bridge & Post*, 778 F. App'x at 894 (citation omitted); *see also Simio*, 983 F.3d at 1365 ("We disregard conclusory statements when evaluating a complaint," including statements "that a feature 'improves the functioning and operations' of a computer"); *Ubisoft Entm't, S.A. v. Yousician Oy*, 814 F. App'x 588, 592 (Fed. Cir. 2020) (affirming district court's refusal to accept as true plaintiff's allegation "that the claimed invention is 'an improvement over the prior art'"); Appx526-527 (collecting cases).

Second, MPV's allegations regarding the '064 patent's alleged technical innovations are contradicted by both the claims and specification. As explained above, representative claim 8 confirms that the recited processes are performed on a general "image capture device" with a generic "memory," "user interface," and "processing system." Appx32 (claim 8). The specification further establishes that the recited processor uses generic "firmware programs"; the recited memory can be a generic "removable Flash memory card, internal Flash memory chips, magnetic memory, or optical memory"; and the "user interface" is a generic "graphical user

interface.” Appx28 at 3:37-40, 3:45-47, 4:47-49. Additionally, the specification confirms that “numerous” generic techniques were available to mark transferred images, it was well known to transfer images to an external storage device, and it was also well known to store a profile in a digital camera indicating whether images “should be deleted after being transferred.” Appx27 at 1:43-44, 63-65; Appx32 at 11:14-16. As a result, the district court was not obliged to accept MPV’s conclusory allegations since they “contradict matters properly subject to judicial notice or by exhibit, such as the claims and the patent specification.” *Secured Mail Sols., LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 913 (Fed. Cir. 2017) (internal quotations omitted).

Lastly, even if any merit to MPV’s complaint regarding the district court’s discussion of the so-called “well-pled facts” could be found, it is, “at worst, harmless error.” *Bridge & Post*, 778 F. App’x. at 894.

**(iii) The District Court Correctly Ruled That The ’064 Patent Describes The Automation Of A Human Practice**

MPV faults the district court for concluding that the ’064 patent is abstract because the claimed invention sought to patent a human practice and used “generic computer hardware ‘as tools’ to perform a routine task.” Appx7 (quoting *Elec. Power Grp., LLC v. Allstom S.A.*, 830 F.3d 1350, 1354 (Fed. Cir. 2016)). MPV insists that the claimed invention “significantly improved ease of use and accuracy”

in transferring and identifying files for deletion, Br. at 21, and in a manner that “could not be accomplished with Defendants’ human cross-check solution,” Br. at 23. Yet, MPV’s own arguments establish that the district court correctly concluded that the purported benefits of the ’064 patent simply automate a human practice to improve a user’s experience.<sup>4</sup> See *id.* at 23 (alleging that the improvements “obviate” the need for human comparison, which is “cumbersome”); Appx291, ¶ 106 (alleging that the claimed invention prevents users from being “forced to cross-check against offloaded storage,” thus confirming that users can perform the claimed processes manually); Appx293, ¶ 111 (acknowledging that “*humans could compare* what is in a remote storage device with what is in a camera,” but that the claimed inventions “obviate the need for such a comparison”; emphasis added). This Court has repeatedly explained that “improving a user’s experience . . . is not, without more, sufficient to render the claims directed to an improvement in computer functionality.” *Customedia Techs., LLC v. Dish Network Corp.*, 951 F.3d 1359, 1365 (Fed. Cir. 2020); see also *Simio*, 983 F.3d at 1361 (affirming claims are

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<sup>4</sup> While MPV declares that the claimed inventions provide “specific technical solutions” in “a way that is necessarily rooted in technology,” Br. at 22, MPV does not explain this conclusory assertion. MPV also ignores the two examples of this long-known practice that the district court had before it from Toshiba’s motion to dismiss, Appx330, which MPV did not mention, much less rebut, in its opposition to the motion, Appx525.

abstract where they do not improve a computer's functionality "beyond the inherent improvement of the experience of a user").

**(iv) The District Court Is Not Required To Discuss Or Distinguish The Case Law MPV Cited In Opposition**

MPV asserts that the district court should be reversed for not explicitly raising and distinguishing "the key cases that MPV cited" in its opposition to the motion to dismiss. Br. at 24. MPV's argument lacks merit because the district court "has broad discretion to determine what the opinion should contain and in what detail," and mere lack of mention of a case, argument, or issue does not support the assumption that the district court failed to consider them. *Lowder v. Dep't of Homeland Sec.*, 504 F.3d 1378, 1383 (Fed. Cir. 2007) (collecting cases).

MPV ignores that it failed to explain to the district court its rationale behind the authority it cited in its opposition to the motion to dismiss, Appx525-526, and that Toshiba readily distinguished that authority, which was far off the mark, Appx529-530. Toshiba also defended its own abundant, on-point authority. Appx529. Thus, it is hardly surprising that the district court did not expressly address each case.

Moreover, MPV's continued reliance on *Visual Memory LLC v. NVIDIA Corp.* remains inapplicable to the step one analysis of the '064 patent for the same reasons Toshiba explained to the district court. See Appx529-530. Similarly, MPV's attempted reliance on *DDR Holdings LLC v. Hotels.com, L.P.*, offers MPV

no basis to seek reversal. MPV fails to explain to this Court how *DDR* supports its appeal, just as MPV failed to do anything more than summarily declare to the district court that, “like the claims in *DDR*,” the ’064 patent’s claims “overcome a problem specifically arising in the realm of computer networks.” Appx382. In fact, the ’064 patent claims bear no resemblance to the claims in *DDR*.

Consequently, for all the reasons stated above, the district court correctly determined that the claims of the ’064 patent are abstract under *Alice* step one.

**c. Step 2 – The ’064 Patent Lacks An Inventive Concept**

Despite the clear difference between the step one and step two analysis, MPV simply repeats, verbatim, its conclusory contention that the district court “erroneously ignore[d] the claim limitations and claimed detail” and “well-pled facts.”<sup>5</sup> Compare Br. at 22, with *id.* at 25; also compare *id.* at 15, with *id.* at 25. In addition to the reasons explained above, *see supra* Section B.1.a, the district court correctly determined that representative claim 8 of the ’064 patent recites selectively deleting image files “on generic computer hardware” without any “additional feature or inventive concept.” Appx7.

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<sup>5</sup> MPV also argues that the district court “does not even reference a correct legal standard,” which MPV says is “noted above,” although MPV provides no indication of where that complaint is explained. Br. at 25 (emphasis added). The district court in fact recited and followed *the* correct legal standard. *See* Appx6-7.

This conclusion is evident from the claim language, which recites a generic “memory,” “user interface,” and “processing system.” Appx6-7; *see also* Appx32 (claim 8). It is also confirmed by the specification, which describes only conventional, routine, generic computer functions for storing, transferring, recognizing, and deleting data. *See* Appx27 at 1:26-27, 1:63–2:3; Appx28 at 3:17-20, 3:26-28, 3:37-47; Appx31 at 9:6-7, 10:17-18, 10:58; Appx32 at 11:12-16. Moreover, the district court’s conclusion is confirmed by this Court’s precedent, which establishes that claims directed to non-descript components for “requesting, transmitting, receiving, copying, deleting, and storing” data simply describe routine and generic computer functions. *See, e.g., Whitserve*, 2021 WL 1608941, at \*5 (collecting cases); *Data Scape*, 816 F. App’x at 464 (confirming that claims, which generically recite editing information, comparing data, and selectively transmitting data, are not inventive); *Clarilogic, Inc. v. FormFree Holdings Corp.*, 681 F. App’x 950, 955 (Fed. Cir. 2017) (claims requiring “only off-the-shelf, conventional computer technology for gathering, analyzing, and displaying the desired information” fail step two).

Consequently, the district court properly applied *Alice*’s mandate that “‘generic computer implementation’ fails to transform a claimed method or process from an abstract idea into a patent-eligible invention” in determining that “the ’064 Patent merely describes an abstract idea.” Appx7 (quoting *Alice Corp. v. CLS Bank*

*Int'l*, 573 U.S. 208, 223-24 (2014)). The district court's conclusion is also consistent with *Alice*'s command that "transformation into a patent-eligible application requires more than simply stating the abstract idea while adding the words 'apply it.'" *Alice*, 573 U.S. at 221; *BSG Tech.*, 899 F.3d at 1290 ("It has been clear since *Alice* that a claimed invention's use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention 'significantly more' than that ineligible concept.").

On appeal, MPV offers only rote recitation of paragraph 109 from the Second Amended Complaint in an attempt to establish an inventive concept at *Alice* step two. Compare Br. at 25, with Appx292-293. This is one paragraph fewer than MPV offered the district court, see Appx373, Appx383 (citing ¶¶ 109, 110), and remains devoid of any identification of an inventive concept.

MPV's reliance on the allegations in paragraph 109 does nothing to identify an inventive concept. Those allegations focus on "improved ease of use and accuracy" for the user without identifying any "inventive technological improvements," or any order or timing of the claim elements that are different than the normal transfer and deletion of data. Br. at 25. As such, those allegations fail under *Alice* step 2, as this Court's "precedent is clear that merely adding computer functionality to increase the speed or efficiency of the process does not confer patent

eligibility on an otherwise abstract idea.” *Ericsson*, 955 F.3d at 1330 (citations omitted).

Likewise, this Court has established that a complaint’s repeated assertions that patent “claims are not routine or conventional,” without providing any “plausible factual allegations to support those assertions,” are insufficient to supply inventiveness at step two. *Boom! Payments, Inc. v. Stripe, Inc.*, 839 F. App’x 528, 533 (Fed. Cir. 2021). Thus, MPV’s conclusory allegations regarding *Alice* step 2 cannot support reversal, particularly as they are contradicted by the specification of the ’064 patent. *See Whitserve*, 2021 WL 1608941, at \*5 (“Patent eligibility may be determined on the intrinsic record alone where, as here, the specification provides that the relevant claim elements are well-understood, routine and conventional.”).

As a result, the district court correctly determined that the claims of the ’064 patent lack an inventive concept under step two.

**d. The District Court Did Not Need To Address Preemption**

MPV concludes its inaccurate critique of the district court’s ruling on the ’064 patent claims, and the other representative patent claims, by stating that “[t]he district court erred in failing to address, much less consider, the issue of preemption.” Br. at 26, 39, 46, 51-52. MPV errs “because preemption ‘is not a separate and independent test under *Alice*.’” *Whitserve*, 2021 WL 1608941, at \*2 (quoting *Whitserve LLC v. Dropbox, Inc.*, No. 18-655-CFC, 2019 WL 3342949, at \*4-5 (D.

Del. July 25, 2019)). In fact, “where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Alice* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Two-Way Media v. Comcast Cable Commc’ns, LLC*, 874 F.3d 1329, 1339 (Fed. Cir. 2017); *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015) (“[Q]uestions on preemption are inherent in and resolved by the § 101 analysis.”).

MPV’s argument also misapprehends the preemption analysis. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics*, 788 F.3d at 1379; *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362-63 (Fed. Cir. 2015) (“[T]hat the claims do not preempt all price optimization . . . do[es] not make them any less abstract.”). Thus, MPV’s allegation that the claims are not “unduly preemptive” does not render them non-abstract.<sup>6</sup>

**e. The District Court Properly Dismissed The Claims, Not The Patents**

MPV’s recurring argument that the district court committed error by holding the “patents” invalid rather than the claims is wrong, and seeks to place semantics

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<sup>6</sup> Even assuming preemption were relevant, Toshiba explicitly addressed preemption before the district court, and MPV’s attempts to refute those points on appeal are ineffective. *See* Appx335-336; Appx337; Appx354-355; Appx532; Appx543. Although the district court was not required to address preemption, it was entitled to rely on Toshiba’s preemption analysis without including an explicit discussion of preemption. *Lowder*, 504 F.3d at 1383.

over substance. *See, e.g.*, Br. at 8-9, 23-24. The district court plainly explained that, pursuant to *Alice*'s two-step framework, it must first determine if “the *claims* at issue” are abstract and, if so, whether the “elements of each *claim*” provide an inventive concept. Appx6 (emphasis added). The district court went on to identify representative claims for each of the patents, which it analyzed under *Alice*'s framework, and determined that those claims were invalid. *See, e.g.*, Appx7; Appx9. That the district court may have, in some instances, used shorthand to refer to a “patent” rather than the “claims of the patent” provides no basis for MPV's charge of error.

## **2. The District Court Correctly Determined That The '095 Patent Is Invalid Under § 101**

The '064 patent and the '095 patent are continuations of a common parent application and contain identical specifications and figures. *See* Appx27; Appx45; Appx299, ¶ 129. The district court accordingly agreed with Toshiba “that claim 8 of the '064 Patent is representative” of the independent claims of the '095 patent and, as a result, the '095 patent claims are invalid “[f]or the same reasons described with respect to the '064 Patent.” Appx7-8 (examining the independent claims and determining that the claims “are substantially similar . . . and recite similar methods for flagging images for deletion after transfer” as representative claim 8 of the '064 patent). On appeal, MPV faults the district court for its conclusion, but offers

nothing more than a cursory list of accusations that provide no legitimate basis for reversal.

First, MPV states that the district court erred by finding claim 8 of the '064 patent representative of the '095 patent claims. Br. at 26. However, MPV did not provide the district court with any “meaningful argument for the distinctive significance of any claim limitations” in the '095 patent. *Berkheimer*, 881 F.3d at 1365; *see also Data Scape*, 816 F. App'x at 464 (affirming that a claim in one patent was representative of claims in other patents from the same family); Appx388. Nor does MPV do so on appeal, thus waiving its right to contest representativeness. *See British Telecomm.*, 813 F. App'x at 587-88; *Enco Sys., Inc. v. DaVincia, LLC*, 845 F. App'x 953, 957 n.1 (Fed. Cir. 2021). Further, MPV is estopped from contesting representativeness because it treated the two patents as functionally equivalent by including identical allegations regarding the so-called “technical problems,” “specific technological solutions,” and “inventive” and “unconventional” aspects of both patent's claims. *Compare* Appx291-293, ¶¶ 105-110, *with* Appx300-301, ¶¶ 127-131.

Second, MPV regurgitates, verbatim, portions of the Second Amended Complaint as its entire argument that “specific inventive technological improvements” in the '095 patent make the claims “inventive” and “unconventional” and “do not automate any human processes.” Br. at 27-29. MPV does not even

identify which step of the *Alice/Mayo* test these conclusory assertions are intended to address, let alone provide any cognizable argument sufficient to save the '095 patent claims from ineligibility. Regardless, none of MPV's unsupported assertions withstand scrutiny for all of the same reasons articulated in detail above. *See supra* Section B.1.b.(ii).

Third, MPV alludes to the prosecution of the parent patent as supposed proof that the '095 patent claims “provide specific technical solutions” to “address technical problems.” Br. at 26-27. But as this Court has repeatedly cautioned, “satisfying the requirements of novelty and non-obviousness does not imply eligibility under § 101, including under the second step of the *Alice* inquiry.” *Adaptive Streaming, Inc. v. Netflix, Inc.*, 836 F. App'x 900, 904 (Fed. Cir. 2020); *see also Two-Way Media*, 874 F.3d at 1340 (“Eligibility and novelty are separate inquiries.”) (citation omitted).

Finally, while cross-referencing to a previous analysis of an identical patent specification and functionally identical claim language is appropriate and reasonable, *see Lowder*, 504 F.3d at 1383, *Data Scape*, 816 F. App'x at 464, MPV complains that the district court's referral to its analysis of the '064 patent claims to support its determination that the '095 patent claims are directed to unpatentable subject matter renders the district court's decision “insufficient for affirmance.” Br. at 29. MPV's position is groundless.

For these reasons and those provided in Section B.1, *supra*, the district court correctly invalidated the '095 patent claims.

**3. The '294 Patent Is Invalid Under § 101**

**a. The District Court Properly Treated Claim 5 As Representative**

MPV asserts that the district court “summarily” identified claim 5 of the '294 patent as representative “without any explanation.” Br. at 35. MPV also contends the district court “erred in ignoring '294 claim 1, which differs meaningfully and substantially from claim 5.” Br. at 36. MPV is incorrect on both counts.

First, the district court addressed the issue of representativeness “[a]s an initial matter” before addressing each asserted patent under the two-step *Alice/Mayo* framework. Appx6. As noted above, the district court pointed out that “Plaintiff’s Opposition makes only conclusory arguments against the representative nature of the claims and does not identify or explain why other claim limitations may be distinctive.” Appx6; *see supra* Section B.1.a. Accordingly, because MPV did not “present any meaningful argument for the distinctive significance of any claim limitations not found in the representative claim[s]” identified by Toshiba, the district court “properly treat[ed] [those] representative claims . . . as representative.” Appx6. That opinion applied to each of the claims that Toshiba identified. *See* Appx327-329; Appx336-337; Appx338; Appx345-346; Appx350-351. Based on this threshold analysis, the district court correctly found that claim 5 was

“representative of the ’294 patent.” Appx8. Thus, MPV’s complaint is factually incorrect.

Second, MPV presented the district court with the exact same arguments regarding “narrower” claim 1 that it now repeats, without alteration, on appeal. Br. at 36; Appx389; Appx390-391. At both the district court and on appeal, MPV’s argument regarding the alleged non-representative nature of claim 1 consists of (1) the allegation that claim 1 is “narrower” and (2) a quotation of claim 1. The district court’s ruling that MPV “makes only conclusory arguments against the representative nature of the claims and does not identify or explain why other claim limitations may be distinctive” confirms that the district court considered, and correctly rejected, MPV’s arguments regarding claim 1. MPV’s unsupported assertions to the contrary do not present any “meaningful argument for the distinctive significance” of claim 1 compared with claim 5, and therefore are insufficient to challenge the representativeness of claim 5. *Berkheimer*, 881 F.3d at 1365; *see also Data Scope*, 816 F. App’x at 464.

Third, even if claim 1 were considered, it does nothing to salvage the ’294 patent claims from abstraction. While the limitations in claim 1 may be more specific, “even a highly specific method for implementing an abstract idea is, at step 1 of the *Alice* test, still directed to that abstract idea.” *Bridge & Post*, 778 F. App’x

at 889; *BSG Tech*, 899 F.3d at 1287 (“[A] claim is not patent eligible merely because it applies an abstract idea in a narrow way.”).

**b. Step 1 – The ’294 Patent Claims An Abstract Idea**

The district court properly determined that representative claim 5 of the ’294 patent is directed to the abstract idea of “facial recognition in image data.” Appx8. The district court further correctly determined that the ’294 patent claims employ “wholly abstract terms” and “unspecified,” “black box,” and “generic” algorithms to perform “abstract mathematical computation” aimed at “a vague process of facial recognition.” *Id.*

MPV’s disjointed and unsupported complaints about the district court’s conclusion are contradicted by numerous decisions of this Court finding similar claims abstract. *See, e.g., In re Bd. Of Tr. of the Leland Stanford Junior Univ.*, 991 F.3d 1245, 1250 (Fed. Cir. 2021) (“Courts have long held that mathematical algorithms for performing calculations, without more, are patent ineligible under § 101.”); *In re Gopalan*, 809 F. App’x 942, 945 (Fed. Cir. 2020) (“[T]his court has held that claims focused on analyzing information using mathematical algorithms are directed to an abstract idea.”); *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167 (Fed. Cir. 2018) (“[S]electing certain information, analyzing it using mathematical techniques, and reporting or displaying the results of the analysis” is abstract).

Indeed, the '294 patent claims fall into abstraction under the long-standing principle announced by the Supreme Court in *Parker v. Flook*. See 437 U.S. 584, 595 (1978) (“[I]f a claim is directed essentially to a method of calculating, using a mathematical formula, even if the solution is for a specific purpose, the claimed method is nonstatutory” under § 101 (citation omitted)); see also *In-Depth Test, LLC v. Maxim Integrated Prods., Inc.*, No. 14-887-CFC, 2018 WL 6617142, at \*5 (D. Del. Dec. 18, 2018), *aff’d*, 787 F. App’x 749 (Fed. Cir. 2019) (“Making that determination is essentially ‘doing math.’ It is akin to calculating standard deviations, and it is the type of mathematical computation that the Supreme Court has deemed an abstract idea.” (citing *Flook*, 437 U.S. at 594-95)). This precedent firmly establishes that the '294 patent’s invocation of generic algorithms to detect a face in an image is similarly abstract.

MPV continues to invoke, with little explanation, *McRO v. Bandai Namco Games* as “an analogous case.” Br. at 35. *McRO* is in no way analogous. “The claims in *McRO* were directed to the creation of something physical — namely, the display of ‘lip synchronization and facial expressions’ of animated characters.” *SAP Am.*, 898 F.3d at 1167. Moreover, the claims “set out meaningful requirements” for the recited animation rules. *McRO v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299, 1313 (Fed. Cir. 2016). As such, the claims were “limited to rules with certain

common characteristics” and rules that “define morph weight sets as a function of the timing of the phenome sub-sequences.” *Id.*

Unlike the claims in *McRO*, the ’294 patent claims are not directed “to the creation of something physical,” nor do the claims contain any meaningful limits rendering them non-abstract. Indeed, the ’294 patent’s claims do not even specify the use of any specific algorithms, let alone recite a “more robust algorithm,” as MPV proclaims. *See Br. at 37-38.*

MPV also asserts that *Enfish, LLC v. Microsoft Corp.* is “analogous” because the ’294 patent claims allegedly improve the operation of a computer by using two, successive algorithms. *Br. at 36-37.* MPV’s reliance on *Enfish* fares no better than its reliance on *McRO*. In *Enfish*, this Court found that the claims recited a new type of “self-referential table” that functioned differently from conventional database structures. *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). The claims were thus directed to an improvement in the functioning of the computer itself. *Id.* at 1338. But as Toshiba explained to the district court, the ’294 patent claims do not improve the functioning of a digital camera. Appx340-341 (starting at ln. 18 to ln. 6). Instead, they simply describe generic digital camera technology for analyzing and categorizing images, which numerous courts have found to be abstract. *See Secure Cam, LLC v. Tend Insights, Inc.*, 351 F. Supp. 3d 1249, 1254-55 (N.D. Cal. 2018) (claims directed to processing digital image data by applying

algorithms to determine an appropriate category tag “do not describe a specific improvement to digital camera functionality”); *see also RecogniCorp, LLC v. Nintendo Co., Ltd.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017) (confirming that encoding and decoding images through “[a] process that started with data, added an algorithm, and ended with a new form of data [is] directed to an abstract idea”).

MPV seeks to escape this conclusion by haphazardly pointing to the patent’s use of two algorithms, Br. at 32, 35, 36, 37-38, even though MPV admits that the patent itself deems them “conventional.” Br. at 34 (quoting Appx70 at 3:29-32). In doing so, MPV largely confuses the step two analysis for step one. *See* Br. at 34. MPV also fails to appreciate the district court’s determination that “[t]he fact that two algorithms are involved matters not at all, and offers the ’294 Patent nothing more than organizational convenience — *i.e.*, the processes in these black box algorithms could just as well be concatenated into a single algorithm, or their subroutines could be divided into numerous algorithms, etc.” Appx8. MPV offers no specific rebuttal of the district court’s conclusion, *see* Br. at 37, nor could it. While the second algorithm may have a rate of false positives lower than the first algorithm, that is simply a mathematical law inherent in the algorithms themselves — it is not a technical innovation. *In re Gopalan*, 809 F. App’x at 945-46 (confirming that claims directed to the “idea of using algorithms or mathematical

relationships” to perform measurements that optimized “true positives and false positives” are abstract).

**(i) The District Court Properly Considered The ’294 Patent Claim Limitations Without “Oversimplifying” The Focus Of The Patent**

MPV again accuses the district court of “over-generalizations,” “over-simplifications,” and not “meaningfully referenc[ing] all the elements in claim 5, including as an ordered combination.” Br. at 36. MPV offers no actual explanation for these assertions, and again confuses step one for step two. Indeed, contrary to MPV’s suggestion, “[t]he first stage of the Alice inquiry looks at the “focus” of the claims,” whereas “the second stage of the inquiry . . . looks more precisely at what the claim elements add.” *SAP Am.*, 898 F.3d at 1167; *Ericsson*, 955 F.3d at 1326.

The district court determined that the ’294 patent claims were directed to “some set of mathematical computations . . . performed on image data, first to identify ‘face candidates,’ and then to determine which ‘face candidates’ are in fact faces” by using “a generic ‘first algorithm’ and ‘second algorithm.’” Appx8. Stated differently, the claims “describe[] an abstract method for running unspecified algorithms on generic computer hardware.” *Id.* This is confirmed by the plain language of both the claims and the specification. *See* Appx78-79, Claim 5; Appx69 at 2:11-24 (“Summary of the Invention” describing the method as “prescreening the image data with a first algorithm” to determine face candidates, and “operating on

the face candidates with a second algorithm”). MPV offers no cogent explanation for why this conclusion purportedly “over-generalizes” or “over-simplifies” the claims.

MPV also fails to indicate how a “reference” to any other unidentified claim 5 elements would impact the district court’s analysis. In fact, none would.

**(ii) The District Court Appropriately Disregarded MPV’s Alleged Facts**

MPV’s allegation that the district court ignored so-called “facts” is wrong for all the reasons stated above. In actuality, MPV merely pled legal conclusions masquerading as “facts,” which are not entitled to any weight. *See supra* Section B.1.b.(ii).

**(iii) The ’294 Patent Describes The Automation Of A Human Practice**

The ’294 patent claims are abstract because humans have long observed their environment and visual images (*e.g.*, photographs, paintings) and identified and categorized aspects of what they see, including faces, which is the focus of the ’294 patent claims. *See Appx52*. MPV challenges this rationale because it presumes, incorrectly, that a human would complete his or her observation with a single look, whereas the ’294 patent claims first require a “pre-screen,” which a human would therefore not “manually implement.” Br. at 35. MPV offers no support for this theory. MPV also fails to appreciate the law, which treats “analyzing information

. . . by mathematical algorithms, without more, as essentially mental processes within the abstract-idea category.” *Elec. Power Grp.*, 830 F.3d at 1354.

**(iv) The District Court Is Not Required To Discuss Or Distinguish The Case Law MPV Cited In Opposition**

MPV also complains that the district court did not expressly address MPV’s cited case authority. Br. at 38. For the same reasons articulated above, this argument offers no basis to alter the district court’s conclusion. *See supra* Section B.1.b.(iv).

Consequently, for all the reasons stated above, the district court correctly determined that the claims of the ’294 patent are abstract under step one.

**c. Step 2 - The ’294 Patent Lacks An Inventive Concept**

The ’294 patent explicitly acknowledges that its claimed invention is conducted entirely via conventional techniques and hardware. For example, the specification states that all of the referenced hardware components are “components of a standard camera.” Appx70 at 3:43-45; 3:43-4:18 (describing conventional components of a standard camera such a generic memory, optical section, flash unit, CPU, RAM, etc.); Appx70 at 3:32-35 (noting that the computer readable medium is “conventional”). Likewise, the specification confirms that all “software implementation needed for practice of the invention is conventional,” Appx70 at 3:29-32, a fact that MPV readily concedes, *see* Br. at 34; *see also* Appx396 (acknowledging that the specification described standard and conventional digital camera components, but contending that disclosure is “irrelevant”). Accordingly,

the district court correctly concluded that “the ’294 Patent simply describes an abstract method to be run on generic computer hardware.” Appx9.

MPV’s attempt to analogize the ’294 patent algorithmic screening process to the claims in *Cellspin Soft, Inc. v. Fitbit, Inc.*, Br. at 38-39, is unavailing. In *Cellspin*, this Court held that “specific, plausible factual allegations” regarding the alleged unconventionality of a “two-step, two-device structure requiring a connection *before* data is transmitted” were sufficient to overcome a motion to dismiss. 927 F.3d 1306, 1317-18 (Fed. Cir. 2019). MPV makes no attempt to link the ’294 patent claims with those at issue in *Cellspin*. Nor could it. The ’294 patent claims bear no resemblance to the “two-step, two-device structure” at issue in *Cellspin*. Instead, the mathematical steps claimed in the ’294 patent are the natural steps taken in applying math to data sets and do not provide an inventive concept. *See In re Bd. Of Tr. of the Leland Stanford Junior Univ.*, 991 F.3d at 1252 (“The application of those elements results in the mathematical analysis itself, and therefore the claimed method subsists in ‘the basic tools of scientific and technological work.’” (quoting *Alice*, 573 U.S. at 216)).

Moreover, MPV’s allegations regarding unconventionality not only lack any factual basis, but are directly contradicted by both the claims and specification of the ’294 patent as indicated above. As such, they are not entitled to be taken as true. *See Secured Mail*, 873 F.3d at 913; *Boom!*, 839 F. App’x at 533.

Finally, MPV's vague assertion that the "juxtaposition of the prior art with the claimed inventions contradicts the district court's erroneous opinions of conventionality," Br. at 39, is lacking in both context and support. But to the extent this argument suggests that the '294 patent claims are inventive or non-conventional at step two because they allegedly satisfy the requirements for novelty and obviousness, MPV is mistaken as a matter of law. *See Adaptive Streaming*, 836 F. App'x at 904 ("We have explained that satisfying the requirements of novelty and non-obviousness does not imply eligibility under § 101, including under the second step of the *Alice* inquiry."); *see also In re Bd. Of Tr. of the Leland Stanford Junior Univ.*, 991 F.3d at 1252 ("Nor is novelty the touchstone of patent eligibility. That a specific or different combination of mathematical steps yields more accurate [] predictions than previously achievable under the prior art is not enough to transform [an] abstract idea . . . into a patent eligible application.").

Accordingly, the district court correctly found that the claims of the '294 patent lack an inventive concept under step two.

**d. The District Court Did Not Need To Address Preemption**

MPV concludes its critique of the district court's ruling by stating that "[t]he district court erred in failing to address, much less consider, the issue of preemption." Br. at 39. MPV provides nothing but circular reasoning to claim the lack of preemption, rather than presenting an actual argument about why preemption does

not apply or how that would impact the two-step *Alice/Mayo* analysis. Regardless, “preemption ‘is not a separate and independent test under *Alice*.’” *Whitserve*, 2021 WL 1608941, at \*2. In fact, “where a patent’s claims are deemed only to disclose patent ineligible subject matter under the *Alice* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Two-Way Media*, 874 F.3d at 1339; *Ariosa Diagnostics*, 788 F.3d at 1379 (“[Q]uestions on preemption are inherent in and resolved by the § 101 analysis.”).

Moreover, MPV again misapprehends the preemption analysis. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics*, 788 F.3d at 1379; *see also OIP*, 788 F.3d at 1362-63 (“[T]hat the claims do not preempt all price optimization . . . do[es] not make them any less abstract.”).

#### **4. The District Court Correctly Found That The ’484 Patent Is Invalid Under § 101**

##### **a. Step 1 – The ’484 Patent Claims An Abstract Idea**

The district court correctly determined that representative claim 1 of the ’484 patent is abstract after concluding that the patent is directed to “creating preview images of a product,” which the district court understood as an attempt to patent the “sorts of mock-ups [that] can be created with pencil and paper — or entirely in one’s imagination.” Appx9. The focus of this patent is confirmed by the specification, which explains that the claimed invention relates to “offering a customized

promotional product to a user.” Appx81, Abstract; *see also* Appx85-86, (figures illustrating the placement of an image on a promotional item such as a t-shirt or coffee mug). The abstract nature of the claims is further evidenced by the specification’s acknowledgement that “[t]he present invention personalizes the upsell to interest the user in the imaging service and/or product.” Appx90 at 3:65-66. Upselling is not only an abstract “fundamental concept,” but “a marketing technique as old as the field itself.” *Tuxis Techs., LLC v. Amazon.com, Inc.*, No. 13–1771–RGA, 2014 WL 4382446, at \*3 (D. Del. Sept. 3, 2014).

As this Court recently held, “the idea and practice of using multiple pictures to enhance each other has been known by photographers for over a century.” *Yu v. Apple Inc.*, No. 2020-1760, 2021 WL 2385520, at \*2 (Fed. Cir. June 11, 2021) (noting that “taking two pictures . . . and using one picture to enhance the other in some way” is abstract). Other courts addressing similar claims have also consistently found them abstract at *Alice* step one. For example, in *American Needle, Inc. v. Zazzle Inc.*, the purpose of the asserted claims — as with the claims of the ’484 patent — was to display digital previews of customizable merchandise to potential customers. No. 15-cv-3971, 2016 WL 232440, at \*2 (N.D. Ill. Jan. 19, 2016), *aff’d*, 670 F. App’x 717 (Fed. Cir. 2016). The court found the claims invalid under Section 101, reasoning that:

promoting sales by providing a visual aide to purchasing over the internet cannot be said to be rooted in computer

technology. Presenting various iterations of products with different design elements in order to entice business is not computer or network specific. Furthermore, adding design elements to merchandise and displaying the merchandise is a method that can be performed by human thought alone, and previewing merchandise to potential customers is a longstanding economic practice.

*Id.* at \*3; *In re Morsa*, 809 F. App'x 913, 917 (Fed. Cir. 2020) (“We have explained that claims related to customizing information based on (1) information known about the user and (2) [specific] data are directed to abstract ideas.”) (internal quotations omitted; alteration in original).

MPV’s conclusory contention that the claims “provide specific technical solutions to specific technical problems” and are “necessarily rooted in technology,” Br. at 44, is refuted by the claims themselves. As representative claim 1 demonstrates, the claimed method uses generic functional language to recite “**accessing** . . . a digital image,” “**providing** a digital image representative of a promotional product,” “**generating** a modified user image . . . to simulate an application of the . . . user-supplied image to the promotional product,” “**generating** a customized digital image representative of the customized promotional product,” and “**displaying** the image.” This is “purely functional” claim language that “confirms that it is directed to an abstract idea, not to a concrete embodiment of that idea.” *Affinity Labs of Tex., LLC v. Amazon.com, Inc.*, 838 F.3d 1266, 1269 (Fed. Cir. 2016). This conclusion is further supported by the fact that representative claim

1 does not recite any specific, tangible mechanism for performing the claimed method. Finally, MPV fails to provide any explanation surrounding its assertion that the predetermined image location or simulation aspect of the claims alters the patent's abstract nature or any of the case law invalidating similar claims at step one.

MPV's remaining arguments are conclusory assertions of error regarding the district court's (i) determination that claim 1 is representative, (ii) lack of appreciation of the "claim detail," (iii) disregard of so-called "facts," (iv) identification of the claims as a long-standing human practice, and (v) failure to expressly analyze MPV's cited case authority. Each of MPV's arguments are unpersuasive for the same reasons stated twice above. *See supra* Sections B.1 & B.1.b.(ii).

In addition, MPV's continued reliance on *Electronic Scripting Prods. v. HTC America*, Br. at 45, remains unavailing. As Toshiba explained to the district court, the claims at issue in that case related to an "optical navigation apparatus and methods for optically inferring or measuring the absolute pose of objects," which was implemented through a unique physical arrangement of photodetectors and motion sensors on a manipulated object. No. 17-cv-05806-RS, 2018 WL 1367324, at \*1, 5 (N.D. Cal. Mar. 16, 2018); Appx539 (lns. 9-18). MPV made no attempt then — and does not attempt now — to explain how the claims in *Electronic Scripting* are even remotely similar to the claims of the '484 patent.

MPV also attempts, for the first time, to analogize its claims to those in *McRO*. Unlike the claims in *McRO*, the '484 patent claims are not directed “to the creation of something physical” and do contain any meaningful limits rendering them non-abstract. The only limitation that MPV even references is the “limitation of having a modified user image constrained to be disposed within the bounds of pre-determined image location of a promotional product.” Br. at 45. But this limitation, which simply attempts to narrow the abstract idea, cannot save the '484 patent claims as “a claim is not patent eligible merely because it applies an abstract idea in a narrow way.” *BSG Tech*, 899 F.3d at 1287; *Bridge & Post*, 778 F. App'x at 889-90.

**b. Step 2 – The '484 Patent Lacks An Inventive Concept**

MPV accuses the district court of error because it relied on the '484 patent's own description of conventional input devices, and other conventional aspects of the purported invention, which MPV concedes would cause the patent to fail at step two. *See* Appx89-90 at 2:66-3:3; Appx90 at 3:4-40; Appx91 at 5:17-22. Nonetheless, MPV contends that an inventive concept exists solely in the “modified user image constrained to be disposed within the bounds of a pre-determined image location.” Br. at 46. MPV does not elucidate what or how this element adds “significantly more,” nor can it do so. To the contrary, claims directed to an abstract idea that are implemented on generic computer components, like the '484 patent claims, “do[ ] not move into [§] 101 eligibility territory[.]”” *In re Morsa*, 809 F. App'x at 918

(citing *buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1354 (Fed. Cir. 2014)). Moreover, “[a]s a matter of law, narrowing or reformulating an abstract idea does not add ‘significantly more’ to it.” *BSG Tech*, 899 F.3d at 1291; *Bridge & Post*, 778 F. App’x at 892. MPV’s extensive recitation of the prosecution history, Br. at 41-42, does not add anything to the analysis. *See Adaptive Streaming*, 836 F. App’x at 904; *see also Two-Way Media*, 874 F.3d at 1340.

Thus, the district court correctly found no inventive concept within representative method claim 1, Appx10, and correctly concluded that the ’484 patent claims are invalid.

**5. The District Court Correctly Found That The ’762 Patent Is Invalid Under § 101**

**a. Step 1 – The ’762 Patent Claims An Abstract Idea**

The district court correctly found that the ’762 patent is directed to “a method for customizing settings for different users, which is an abstract idea.” Appx10. The district court arrived at this conclusion with the benefit of Toshiba’s in-depth analysis of representative claim 19, the patent specification, and applicable case authority.<sup>7</sup> *See* Appx350-353; Appx541-543. The district court’s recognition that claim 19 of the ’762 patent is abstract aligns with precedent establishing that claims

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<sup>7</sup> The district court’s reference to claim 1 is a typographical error; the claim language reflected in the district court’s decision is claim 19. Appx117.

directed to customizing settings and preferences for different users is fundamentally abstract.

For example, in *Zkey Investments, LLC v. Facebook Inc.*, the district court held that claims directed toward “means by which information is collected, analyzed, and displayed based on the user’s granting or denial of access to other [users],” and a user’s ability “to selectively choose who is granted and denied access to their user profile information and illustrate the results of collecting and analyzing information,” recite abstract subject matter. 225 F. Supp. 3d 1147, 1154-55 (C.D. Cal. 2016), *aff’d*, 708 F. App’x 681 (Fed. Cir. 2018). As the district court in that case explained, claims focused on customizing which information is displayed to multiple users “are not focused on improvements to computer functionality but are more focused and tailored to the use of computers as tools in aid of processes focused on an abstract concept.” *Id.* at 1155 (internal quotations omitted); *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1367-68 (Fed. Cir. 2015) (affirming that claims reciting “a profile keyed to user identity and containing one or more user-selected categories” were abstract).

MPV asserts three main errors with this result. First, MPV summarily states that the claims “provide specific technical solutions . . . including in a way that is necessarily rooted in technology and that improves technology.” Br. at 49. Not only is this contention unsupported, but the district court expressly rejected MPV’s

argument as nothing more than improving the user experience. Appx10. That conclusion is consistent with this Court’s precedent: “improving a user’s experience . . . is not, without more, sufficient to render the claims directed to an improvement in computer functionality.” *Customedia*, 951 F.3d at 1365; *see also Simio*, 983 F.3d at 1361 (rejecting alleged improved functionality where the “argument does not explain how the *computer’s* functionality is improved beyond the inherent improvement of the experience of a user” (emphasis added)). It is also consistent with the ’762 patent’s specification, which confirms that the claims are directed to generic customization ability to improve user experience by “includ[ing] only those features that are of interest to the user.” Appx108 at 2:45-48; Appx108 at 2:42-44.

Second, MPV argues that claim 1 is “markedly different” from representative claim 19 and, presumably, should have led to a finding of eligibility.<sup>8</sup> Yet, all MPV offers by way of argument is one sentence, a redline comparison, and an incorrect recitation of claim 1.<sup>9</sup> These items are insufficient to form a legitimate argument on appeal.

Regardless, MPV overlooks that *both* claim 1 and claim 19 recite “programming the programmable memory of the digital camera,” thus confirming

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<sup>8</sup> MPV’s conclusory refrain that claim 19 is also not representative, Br. at 49, has been previously rebutted. *See supra* Section B.1.

<sup>9</sup> MPV incorrectly recounts the third element.

that this alleged difference is in fact no difference at all. MPV also ignores that the '762 patent characterizes the recited "customization software" in purely generic and functional terms that predictably "customizes" firmware. Appx109 at 3:32-48 (generically stating that the software "accesses software code which permits firmware . . . to be customized," "can modify or combine firmware" to customize the camera, and can include applications with information "about available camera features"). Accordingly, this customization software cannot render claim 1 non-abstract. *See In re TLI Commc'ns LLC Patent Litig.*, 823 F.3d 607, 612, 615 (Fed. Cir. 2016) (invalidating claims where the specification "describes the system and methods in purely functional terms," including describing a "control unit" as something that "predictably 'controls' various aspects of the claimed functionality").

The specification also confirms that this "customization software" is nothing more than standard "camera customization software provided with the digital camera," Appx109-110 at 4:67-5:3, which is "typically executed on the host computer," Appx109 at 3:32-34. Accordingly, MPV's conclusory allegation that "software operating on allegedly standard hardware" can provide inventive solutions to technical problems, Br. at 50, lacks merit because the '762 patent specification itself firmly establishes that the generic software recited in the claims plainly does not provide an inventive solution.

Third, MPV once again complains that the district court did not distinguish MPV's cited case authority. As noted above, the fact that the district court elected not to include such a discussion in its decision is not grounds for error, particularly when Toshiba's briefing on the motion exhaustively distinguished MPV's cases, including the cases MPV once again cites on appeal.<sup>10</sup> *See supra* Sections B.1.b.(iv) & B.3.b.(ii); Appx542-543.

Regardless, MPV's reliance on *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, is misplaced. In *Core Wireless*, the Federal Circuit found that claims were patent eligible where they recited specific limitations for a user interface, including (1) "specifying a particular manner by which the summary window must be accessed," (2) "restrain[ing] the type of data that can be displayed in the summary window," and (3) "requir[ing] that the device applications exist in a particular state." 880 F.3d 1356, 1362-63 (Fed. Cir. 2018). As the Court explained, "[t]hese limitations disclose[d] a specific manner of displaying a limited set of information to the user, rather than using conventional user interface methods." *Id.* at 1363. In contrast, MPV cannot dispute that the '762 patent relies upon conventional firmware and hardware components, including a conventional user interface. *See* Appx109-110 at 3:32-5:32 (describing conventional hardware, user

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<sup>10</sup> MPV's incantation regarding preemption, Br. at 51-52, also fails for the same reasons stated above. *See supra* Section B.1.d.

interface, and customization software to provide a selective display of data and functions).

Likewise, in *DDR Holdings LLC v. Hotels.com, L.P.*, this Court found that the claims at issue encompassed a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” 773 F.3d 1245, 1257 (Fed. Cir. 2014). Specifically, the claims in *DDR* directed the user to an automatically generated hybrid webpage that combined product information from a third-party website with the “look and feel” of the host website, thereby preventing the host website from losing visitors. *Id.* at 1257-58. Not only do the ’762 patent claims bear no resemblance to the claims in *DDR*, but MPV offers nothing to support its conclusory argument that the claims are similarly “necessarily rooted in computer technology” or “improve[] the relevant technology.” Br. at 49. To the contrary, as explained above, the claims are directed to the application of generic and conventional customization ability to improve a user’s experience, which is quintessentially abstract.

**b. Step 2 – The ’762 Patent Lacks An Inventive Concept**

Representative claim 19 of the ’762 patent relies entirely upon conventional digital camera and PC firmware and hardware components, including hardware necessary to provide a selective display of data and functions on a graphical user interface. *See* Appx109-110 at 3:49–5:32; Appx111 at 8:45-47. The specification

also confirms that the “customization software” is conventional software provided *with* the digital camera. Appx109 at 3:32-48. Accordingly, the district court appropriately determined that “[t]here is no sort of specialization or improvement necessary to execute the method described, and thus no inventive concept or additional feature is supplied” that could “transform [the] abstract subject matter into something patentable.” Appx111; *see also Intellectual Ventures*, 792 F.3d at 1368 (confirming that a “user profile” is a “generic computer element[ ]”).

On appeal, MPV does little more than cut and paste the allegations from its Second Amended Complaint. Br. at 51. MPV does not dispute that the claimed inventions utilize conventional digital camera and PC firmware and hardware components. Nor does it point to any specific “inventive technological improvement” aside from the abstract concept of allowing users to customize features. *Id.* (referencing the fact that the ’762 patent claims allow “first and second users” to “select” and “program” features). But “[i]t has been clear since *Alice* that a claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.” *BSG Tech.*, 899 F.3d at 1290.

Consequently, nothing can save the ’762 patent from abstraction, and the district court correctly invalidated its claims.

**C. The District Court Properly Dismissed The Second Amended Complaint's Claims Of Infringement With Prejudice**

MPV argues the district court's "with prejudice" dismissal of its infringement claims is erroneous and that MPV should have been given yet another opportunity to amend. Br. at 52-53. MPV also alleges that the district court should have issued "'written findings' sufficient to show that leave to amend would be futile," but instead somehow engaged in "improper bootstrapping" by relying on its conclusion of ineligibility as the basis for its "with prejudice" dismissal. *Id.* MPV's argument misconstrues the facts and the law.

MPV's recitation of the facts attempts to portray a situation in which the district court prematurely denied leave to amend. *See* Br. at 3-4, 53, 57, 61. The district court did no such thing. MPV had already twice amended its complaint and, importantly, elected to amend its complaint the second time in response to Toshiba's first motion to dismiss, which raised the same patent ineligibility arguments under 35 U.S.C. § 101 as its motion to dismiss the Second Amended Complaint. *See* Appx211-243. Thus, MPV was afforded a full opportunity to address Toshiba's § 101 arguments by including plausible, factual allegations sufficient to establish compliance with § 101's requirements before the district court ruled on Toshiba's motion.<sup>11</sup> Despite this opportunity, MPV did nothing more than

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<sup>11</sup> For at least this reason, MPV's reliance on *Quad City Patent* and *TrackTime*, Br. at 53, are inapposite since the plaintiffs in those cases did not have

improperly interpose legal conclusions couched as factual allegations. *See supra* Sections B.1.b.(ii) & B.3.b.(ii). Moreover, while MPV repeatedly decries the district court's failure to accept MPV's "well-pled facts" throughout its brief, MPV never offers this Court any explanation of what new or additional facts it could possibly plead to convert its invalid claims into valid, "non-abstract" claims.<sup>12</sup>

The district court properly recited the law governing futility of amendment, Appx5, and correctly applied it to the alleged facts, Appx7-11.<sup>13</sup> The district court's conclusion is amply supported by this Court's precedent, which confirms that leave to amend is not required where the claims are found invalid under 35 U.S.C. § 101. *Data Scape*, 816 F. App'x at 464-65 (affirming dismissal of complaint without leave to amend); *Simio*, 983 F.3d at 1364-65 (same).

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the opportunity to replead following a motion to dismiss, unlike here. *Quad City Patent, LLC v. Zoosk, Inc.*, 498 F. Supp. 3d 1178, 1189 (N.D. Cal. 2020); *TrackTime, LLC v. Amazon.com, Inc.*, No 18-1518 (MN), 2019 WL 2524779, at \*6 (D. Del. Jun. 19, 2019).

<sup>12</sup> For at least this reason, MPV's reliance on *Aatrix* is misplaced. *See Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1126, 1128 (Fed. Cir. 2018) (reversing district court's decision denying amendment "without explanation," despite plaintiff proposing "concrete" amendments that "would directly affect the district court's patent eligibility analysis").

<sup>13</sup> Unlike the situation in *Mayes v. Leipziger*, 729 F.2d 605 (9th Cir. 1984), cited by MPV, the district court here expressly denied leave to amend and stated the reason for its denial. Relying on a determination of patent ineligibility as the basis for futility is not "boot-strapping," it is the application of sound legal reasoning.

**D. The District Court Properly Dismissed The Second Amended Complaint At the Pleading Stage**

Despite admitting that the district court acted well within sound precedent, MPV argues that this Court should reverse years of established law because dismissal of patent infringement claims under 35 U.S.C. § 101 on a Rule 12(b) motion to dismiss should not be permitted. Br. at 54. MPV’s own recitation of the law of this Court, as well as the precedent cited by Toshiba, establishes that MPV’s argument has zero basis and warrants no further attention.

To the extent MPV is attempting to present an *Aatrix/Berkheimer* argument (despite not citing either of those cases in its argument) based on purported factual issues, MPV’s argument still fails for all the reasons explained above in relation to MPV’s meritless contentions that the district court ignored facts. *See supra* Sections B.1.b.(ii) & B.3.b.(ii).

**E. The District Court Correctly Dismissed The Allegations Of Willful Infringement**

As the district court noted, willful infringement is “generally reserved for egregious cases of culpable behavior.” Appx11 (citing *Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1932 (2016)). Here, the district court explained that, “[w]hile Plaintiff alleges that Defendants were made aware of their alleged infringement, this is insufficient to plead the necessary *egregious* conduct for willful

infringement.” *Id.* MPV’s attempt to assign error to the district court’s analysis fails.

First, MPV’s attempt to distinguish *Halo* as “not a pleading case,” Br. at 55, is irrelevant in light of the wealth of additional authority dismissing similar allegations for the same reasons. *See, e.g., Smith v. Extreme Performance 1, LLC*, No. 5:20-cv-00328, 2020 WL 5092913, at \*5 (C.D. Cal. June 23, 2020); *Apple Inc. v. Princeps Interface Techs. LLC*, No. 19-cv-06352, 2020 WL 1478350, at \*2 (N.D. Cal. Mar. 26, 2020).

Second, MPV’s claim of “boot-strapping” misunderstands the district court’s reasoning; MPV’s allegations of Toshiba’s knowledge are insufficient to plead willful infringement because Toshiba was entitled to a reasonable belief that the patents were not infringed. *See Appx11; see also Finjan, Inc. v. Cisco Sys. Inc.*, No. 17-cv-00072, 2017 WL 2462423, at \*5 (N.D. Cal. Jun. 07, 2017) (contention that defendant had knowledge of the patents and its infringement “failed to allege facts that [] support a plausible inference that [defendant] engaged in ‘egregious’ conduct”); *XpertUniverse, Inc. v. Cisco Sys., Inc.*, No. 17-cv-03848-RS, 2017 WL 4551519, at \*6 (N.D. Cal. Oct. 11, 2017) (“Disagreement about the existence of continued infringement does not necessarily indicate willful or deliberate misconduct.”).

Third, MPV's remaining contention that it properly pled willfulness through legal conclusions (disguised as facts), which the district court allegedly failed to appreciate, lacks merit for the reasons discussed above. To the contrary, the district court correctly concluded that "[t]he rest of Plaintiff's allegations about willful infringement are conclusory and are properly disregarded under *Iqbal*." Appx11.

Finally, MPV's disagreement over the "with prejudice" dismissal of the willfulness allegations ignores the fact that MPV was already provided a full opportunity to include plausible, non-conclusory allegations in response to Toshiba's first motion to dismiss, but was unable to do so. *See supra* Section C; *see also Addiction and Detoxification Inst. LLC v. Carpenter*, 620 F. App'x 934, 938 (Fed. Cir. 2015) (finding the district court did not abuse its discretion in denying a second motion to amend the complaint).

Accordingly, the district court correctly dismissed MPV's willful infringement allegations with prejudice.

**F. The District Court Correctly Dismissed The Allegations Of Induced Infringement**

As the district court explained, MPV's allegations regarding induced infringement "are predicated on providing instructions for use of [the] allegedly infringing products, with the intent that end users would directly infringe the Asserted Patents." Appx11. "However, beyond conclusory allegations, [MPV] does not allege that any end users infringed the Asserted Patents, that following

Defendants' instructions would cause an end user to infringe the Asserted Patents, or that Defendants specifically intended to induce infringement." *Id.* For this reason, the district court properly concluded that MPV "does not state a plausible claim for specific intent or induced infringement." *Id.*

MPV repeatedly accuses the district court of "disregard[ing] the factual allegations" in the Second Amended Complaint. Br. at 58, 60-61. The district court did not disregard any facts. MPV's assertions were not factual allegations; they were legal conclusions masquerading as facts. Appx11; *see supra* Sections B.1.b.(ii) & B.3.b.(ii).

MPV's conflicting arguments that "[t]here is nothing conclusory or formulaic" about its allegations and meeting the Rule 8(a) standard are contrary to controlling pleading standards. Br. at 60. The allegations that MPV identifies are "bald conclusions that an end user following . . . instructions results in infringement," which are insufficient to allege induced infringement. *Hypermedia Navigation LLC v. Google LLC*, No. 18-cv-06137-HSG, 2019 WL 1455336, at \*3 (N.D. Cal. Apr. 2, 2019); *Uniloc USA, Inc. v. Logitech, Inc.*, No. 18-CV-01304, 2018 WL 6025597, at \*2 (N.D. Cal. Nov. 17, 2018) (simply "provid[ing] instructions to infringe" does not demonstrate "knowledge of customers' infringing conduct"); *Apple*, 2020 WL 1478350, at \*4 ("[G]eneral and imprecise references to 'instructional materials and/or services'" and "insufficiently specific 'passing

references to ‘user manual guides, and support articles’” fail to demonstrate specific intent to induce infringement) (citations omitted).

Likewise, MPV’s summary pronouncement that “Defendants have . . . specifically intended to induce direct infringement by customers and/or end users,” or had “intent that such direct infringement occur,” Br. at 59, “simply recite[] the legal conclusion that Defendants acted with specific intent,” which fails to state a plausible claim for inducement. *Addiction*, 620 F. App’x at 938; *Uniloc*, 2018 WL 6025597, at \*2 (“Here, Uniloc pleads no facts, only conclusory statements, in relation to Logitech’s intent for its customers to infringe.”). Similarly, MPV’s assertions that “Defendants were made aware of infringement . . . via an infringement chart,” Br. at 60, provides nothing suggesting specific intent to induce infringement.

MPV’s disagreement over the “with prejudice” dismissal of the inducement allegations ignores the fact that MPV squandered its chance to make plausible, non-conclusory allegations in response to Toshiba’s first motion to dismiss, which outlined MPV’s inducement pleading failures.<sup>14</sup> *See supra* Section D; *see also Addiction*, 620 F. App’x at 938.

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<sup>14</sup> MPV again refers incorrectly to willfulness in an apparent typographical error.

Accordingly, the district court correctly dismissed MPV's induced infringement allegations with prejudice.

**G. As Demonstrated Above, The District Court More Than Adequately Explained The Reasoning For Its Decision**

Early in its brief, MPV asserts that the district court did not issue a "reviewable opinion" because the district court determined that MPV's so-called "well-pled facts" were merely legal conclusions and because it invalidated the patent claims without explicitly distinguishing MPV's cited authority. Br. at 14-16. As detailed above in response to these same complaints, the district court's order provided ample analysis and explanation to facilitate meaningful appellate review. *See supra* Section B.1.b.(iv). Specifically, the district court's order summarized the background facts and procedural history of the case, Appx3-4; described in detail the legal standards for both a motion to dismiss and an analysis of patentable subject matter under *Alice*, Appx4-6; explained its analysis for determining representative claims for each of the patents-in-suit, Appx6; individually analyzed each of the representative claims under both steps of *Alice* and explained why they were abstract and non-inventive, Appx6-11; described why MPV failed to state a claim for willful infringement and induced infringement under relevant pleading standards, Appx11-12; and used the correct legal standard in determining further amendment would be futile, Appx5, Appx7, Appx11-12. MPV's contention that this detailed

analysis fails to provide this Court with a reviewable opinion is therefore without legitimate basis.

MPV's attempted comparison of the district court's decision with the decisions in *Realtime Data LLC v. Reduxio Systems Inc.*, 831 F. App'x 492 (Fed. Cir. 2020), and *Nazomi Communications, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364 (Fed. Cir. 2005), only establish the legitimacy of the district court's analysis.

In *Nazomi*, the district court's entire claim construction analysis was limited to a single paragraph that differed from either of the parties' proposed constructions, failed to consider the intrinsic evidence, and made no mention of the appropriate level of ordinary skill in the art. *See* 403 F.3d at 1371. Its infringement analysis "was, if anything, more curt," in addition to being "circular" and devoid of "findings of fact on the nature of the accused device." *Id.* These errors and omissions set *Nazomi* apart from the district court's decision in this instance, which conducted the correct two-step analysis of the patent claims, rendered a decision fully in line with numerous precedents analyzing similar patent claims, applied the correct law to the willfulness and inducement claims, and noted that MPV's allegations were merely legal conclusions.

The opinion in *Realtime* is even further afield. The district court's decision here bears no resemblance to the on-the-record oral decision (amounting to just five transcript pages) where the court: incorrectly focused on whether the claims were

novel under § 102; did not identify any representative claims — a “critical shortcoming” resulting in a lack of any cogent “directed to” assessment; and, despite specifically asking each party to identify the single case that most closely supported its position on patent eligibility, did not even address that “one case.” 831 F. App’x at 497. Those failures left this Court with no explanation as to why the *Realtime* district court diverged from three other district courts, which previously found the same claims patent eligible. *Id.* at 497-98. Even then, this Court cautioned that the *Realtime* district court ruling was “unique” in both the “paucity of analysis and the closeness of the underlying issue.” *Id.* at 498.

As a result, *Realtime* is completely inapposite given that the district court here issued a written decision that included the proper two-step eligibility analysis, identified the representative claims, and cited authority supporting its decision.

#### **H. MPV’s Request To Stay This Appeal Is Procedurally Improper And Substantively Incorrect**

MPV seeks a stay of this appeal pending the outcome of a petition for certiorari in *American Axle & Manufacturing, Inc. v. Neapco Holdings LLC*, 967 F.3d 1285 (Fed. Cir. 2020). As an initial matter, MPV’s request should have been made via a motion pursuant to Federal Circuit Rule 27. MPV’s request is therefore procedurally improper and should be rejected on that basis alone. MPV does not explain why it waited until its brief — the very end of it, at that — to request this relief. The writ in *American Axle* was filed on December 28, 2020, yet MPV sought

multiple extensions of time to file its brief before tacking on its stay request, thereby forcing Toshiba to expend the time and money responding to MPV's myriad arguments on appeal. For those reasons, MPV's request should be denied.

Additionally, this Court has decided numerous appeals of § 101 motions to dismiss since the *American Axle* writ was filed. *See, e.g., Whitserve*, 2021 WL 1608941, at \*2 (decided April 26, 2021); *Enco*, 2021 WL 855856, at \*4 (decided Mar. 8, 2021); *Veripath, Inc. v. Didomi*, 842 F. App'x 640 (Fed. Cir. Feb. 8, 2021); *Boom!*, 839 F. App'x at 534 (decided January 13, 2021); *Yu*, 2021 WL 2385520, at \*2, (decided June 11, 2021). MPV makes no mention of this fact nor offers any rationale, let alone a compelling one, as to why its appeal should be treated differently from the numerous other § 101 cases decided over the last six months that also "implicate" the same issues.

Moreover, MPV fails to address the fact that this Court denied *American Axle's own request* to stay issuance of the mandate pending its request for certiorari. *Am. Axle & Mfg., Inc. v. Neapco Holdings LLC*, 977 F.3d 1379 (Fed. Cir. 2020). As this Court explained, American Axle is not irreparably injured by continuing litigation pending the outcome of the Supreme Court's decision on the petition for certiorari. *Id.* at 1381-82. Here, MPV does even attempt to argue any unique prejudice or injury absent a stay.

For all these reasons, MPV's request should be denied and fees should be awarded to Toshiba in connection with addressing this portion of MPV's appeal.

**CONCLUSION**

The district court's determination that the claims of the asserted patents are unpatentable under 35 U.S.C. § 101 should be affirmed. Further, the district court's dismissal of MPV's claims of willful and induced infringement, with prejudice, should be affirmed.

Dated: June 25, 2021

Respectfully submitted,

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## CERTIFICATE OF SERVICE

I, Douglas F. Stewart, hereby certify that on June 25, 2021, I caused the foregoing document to be electronically filed with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit via the Court's CM/ECF system. Counsel of record were served via the Court's CM/ECF on June 25, 2021.

Dated: June 25, 2021

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## CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Federal Circuit Rule 32(a). This brief contains 13,754 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type of style requirements of Federal Rule of Appellate Procedure 32(a)(6). This brief has been prepared in proportionally spaced typeface using Microsoft Word 2013 in Times New Roman, 14-point.

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