Appeal No. 2024-1202

United States Court of Appeals for the Federal Circuit

LONGITUDE LICENSING LTD.,

Plaintiff-Appellant,

v.

GOOGLE LLC,

Defendant-Appellee.

Appeal from the United States District Court for the Northern District of California, Case No. 3:23-cv-03046-VC

APPELLANT LONGITUDE LICENSING LTD.'S PETITION FOR REHEARING EN BANC

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May 30, 2025

CERTIFICATE OF INTEREST

No. 2024-1202
Longitude Licensing Ltd. v. Google LLC

Counsel for Longitude Licensing Ltd. certify under Federal Circuit Rule 47.4 that the following information is accurate and complete to the best of their knowledge:

1. **Represented Entities.** Provide the full names of all entities represented by undersigned counsel in this case.

Longitude Licensing Ltd.

2. **Real Parties in Interest.** 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.

None.

3. **Parent Corporations and Stockholders.** 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.

Meridian IP Ireland, Ltd.

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.

David Martinez and Navin Ramalingam of Robins Kaplan LLP.

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

No.

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).

N/A

Date: May 30, 2025 /s/ Aaron R. Fahrenkrog

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STATEMENT OF COUNSEL UNDER FEDERAL CIRCUIT RULE 40(c)(1)

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States or the precedents of this Court: *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014); *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016); *CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358 (Fed. Cir. 2020); *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016); *Ancora Techs., Inc. v. HTC Am., Inc.*, 908 F.3d 1343 (Fed. Cir. 2018); *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253 (Fed. Cir. 2017); *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299 (Fed. Cir. 2018); *CosmoKey Sol'ns GmbH & Co. KG v. Duo Security LLC*, 15 F.4th 1091 (Fed. Cir. 2021); *Cooperative Entm't, Inc. v. Kollective Tech., Inc.*, 50 F.4th 127 (Fed. Cir. 2022); and *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341 (Fed. Cir. 2016).

Dated: May 30, 2025

/s/ Aaron R. Fahrenkrog
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PRELIMINARY STATEMENT

Since the Supreme Court's *Alice* decision,[1] commentators have lamented a perceived uncertainty in § 101 law.[2] The Court's body of precedent, however, has followed a consistent principle throughout: in each case where the specification explains that the claimed arrangement provides a technological improvement over prior systems or processes, and nothing in the evidentiary record indicates that the claim recites only conventional technology, the Court has either upheld the claim's eligibility or vacated a Rule 12 dismissal for resolution of factual disputes. This precedent necessarily requires courts to consider and weigh the specification evidence and any other evidence of record to resolve patent eligibility.

The panel decision departs from this precedent and stands to introduce uncertainty for district courts and litigants. Here, the '365 patent's specification explains that the claimed arrangements differ from prior image processing systems and processes and thereby enhance the computer's ability to achieve improved visual image quality compared to prior computing systems.[3] The panel, however,

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[1] *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208 (2014).

[2] *See, e.g.*, R. Gruner, *Lost in Patent Wonderland with* Alice*: Finding the Way Out*, 72 Syracuse L. Rev. 1053 (2021-2022); J. Kesan & R. Wang, *Eligible Subject Matter at the Patent Office: An Empirical Study of the Influence of* Alice *on Patent Examiners and Patent Applicants*, 105 Minn. L. Rev. 527 (Dec. 2020); M. Sipe, *Patent Law 101: I Know It When I See It*, 37 Harvard J.L. & Tech. 448 (Spring 2024).

[3] Longitude limits its Petition to the '365 patent.

did not consider this evidence. Instead, the panel found the '365 claims ineligible without considering the specification's descriptions of the computing improvements provided by the recited claim limitations.

No issue in patent law under the Court's precedent depends solely on review of the claim language, divorced from the specification. The panel's determination of ineligibility without considering the specification departs not only from the Court's § 101 precedent, but also from the fundamental tenet of patent law: "[t]he claims, of course, do not stand alone. . . . For that reason, claims 'must be read in view of the specification, of which they are a part.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996)). The § 101 analysis is no exception—determining whether a claim is directed to an improvement to computer functionality versus an abstract idea, or whether the claim recites an inventive concept versus only conventional technology, necessarily depends on reading the claim in view of the specification evidence.

Rehearing en banc is necessary because the panel decision conflicts with the Court's body of § 101 precedent applying *Alice* and introduces uncertainty as to the role of the specification in the § 101 analysis. The Court should clarify that courts must accord weight to specification evidence favoring eligibility under both steps of the *Alice* analysis and may not determine ineligibility based on claim

language in a vacuum. The Court also should clarify that, under Rule 12, courts must interpret specification evidence in the light most favorable to the non-movant, and deny dismissal where that evidence, so interpreted, raises factual issues in favor of eligibility.

SUMMARY OF DISTRICT COURT PROCEEDINGS

Longitude filed suit against Google in the Northern District of California on June 21, 2023, asserting that Google's Pixel smartphones, Pixel tablets, and image editing software infringe seven Longitude image processing patents. Appx120. Google filed a motion to dismiss, under Rule 12(b)(6), Longitude's claims for four patents under § 101. The district court granted Google's motion in a brief order just over two pages long. Appx002-004. The district court's order did not cite or address any record evidence, including specification evidence regarding the computing benefits of the claimed inventions. *Id.* The parties agreed to dismiss the remaining three patents without prejudice, Appx005, and Longitude appealed the Rule 12(b)(6) dismissal. Appx311-312.

SUMMARY OF PANEL DECISION

The panel decision affirmed the district court's dismissal by evaluating only the claim language, without analysis of the specification evidence supporting eligibility. At *Alice* step one, the panel decision concluded that, for '365 claim 32, "the language of the claim does not explain how" it achieves a computing

improvement. Op. at 8. The panel further explained that claim 32 lacked "sufficient recitation of how the purported invention improves the functionality of image correction methods." *Id.* at 7 (underline original; quotation omitted). The panel treated the other '365 claims in the same manner as claim 32. *Id.* at 8-10.

The panel's step one analysis, like the district court's, did not address evidence from the '365 specification articulating how the steps recited in claim 32—specifically, the limitations "acquiring the properties of the determined main object image data" and "acquiring correction conditions corresponding to the properties that have been acquired"—enhance a computer's ability to improve image quality in automated image adjustment. Op. at 5-8. The panel did not identify any record evidence suggesting that claim 32 recites only conventional technology or techniques. *Id.* At *Alice* step two, the panel decision again assessed only the claims, without reference to the specification, and concluded that the claim language itself establishes a lack of inventive concept. *Id.* at 13-14.

ARGUMENT

I. The Panel Departed from Precedent at Step One by Not Addressing the Specification Evidence Explaining that the Claimed Limitations Provide a Computing Improvement.

The Court has consistently found that specification evidence describing how the claim limitations at issue improve a computing system weighs in favor of eligibility at *Alice* step one. The Court has never sanctioned refusing to accord

such evidence any weight (particularly in the Rule 12 context) or relying on the claim language in isolation. The panel opinion's determination of ineligibility without considering the specification evidence supporting eligibility sets a new path that requires en banc review to correct. Op. at 5-8.

The '365 specification explains how the specific limitations recited in claim 32 enable a computer to improve the picture quality of main objects in digital images compared to prior computer systems. Principal Br. 34, 36-38; Reply Br. 11-12. (collecting specification citations). The panel's step one analysis, however, does not cite or address any evidence from the '365 specification describing the benefits provided by the claimed steps "acquiring the properties of the determined main object image data," "acquiring correction conditions corresponding to the properties that have been acquired," and "adjusting the picture quality of the main object image data using the acquired correction conditions." Op. at 5-8.

The '365 specification explains that the claimed steps "acquiring properties" and "acquiring correction conditions corresponding to the properties" "permit[] more suitable adjusting of the picture quality according to the properties of the main object." Appx032 at 14:51-61. The specification explains that prior computing systems did not "tak[e] into consideration subtle differences in the main object characterizing the image," Appx026 at 1:30-40, and, unlike the claimed invention, those systems performed a "standardized picture quality adjusting

process . . . on the main object." *Id.* Thus, in prior systems, "[i]t is . . . inherently impossible to carry out a picture quality adjusting process that takes advantage of the subtle characteristics of the main object, and it is not always possible to output a more attractive main object." *Id.* The invention of claim 32 made it "possible to improve the picture quality of the main object characterizing the image." Appx027 at 3:42-61; Appx032 at 14:51-61.

The specification makes clear that claim 32 recites how a computer is improved: by introducing the steps "acquiring the properties of the determined main object image data," "acquiring correction conditions corresponding to the properties that have been acquired," and "adjusting the picture quality of the main object image data using the acquired correction conditions." Appx032-034 (describing the "Second Embodiment," which corresponds to claim 32). These steps make it "possible [to] carry out a picture quality adjusting process that makes the main objects in an image look more attractive." Appx034 at 17:54-63. Acquiring correction conditions corresponding to properties of the main object further allows the "identified main object [to] also be classified in further detail, allowing the optimal picture quality adjusting process to be carried out on the main object." *Id.* at 17:64-18:9. The specification provides examples of specific improvements achieved by utilizing a correspondence between properties and correction conditions associated with main object classifications—for example,

when "the sky is the main object," different correction conditions can be applied to provide a "more attractive, higher picture quality for bright sky, ordinary sky, dark sky, brilliant sky, overcast sky, clear sky, and red sky." *Id.*

The '365 specification thus explains how the exact limitations of claim 32 improve the performance of computers compared to prior systems. No one—Google, the district court, or the panel—identified any evidence suggesting that claim 32 recites only conventional technology. Op. at 5-8. This evidentiary record, properly weighed, should have resolved the step one inquiry in Longitude's favor.

The panel found otherwise by analyzing the claim language in a vacuum and not considering the specification evidence. Op. at 5-8. The panel repeatedly emphasized that the claim language itself did not recite "how" it improves computing functionality. *Id.* For example (bold emphasis added in each quote):

> Similarly, **claim 32** describes "determining" a main object, "acquiring" the main object image data and correction conditions, and "adjusting" the main object image data's parameters **without sufficient recitation of <u>how</u>** the purported invention improves the functionality of image correction methods.

Op. at 7 (underline original; quotation omitted; cleaned up).

> The specific improvement purportedly recited in **claim 32** does not make it non-abstract because **the language of the claim does not explain how** that improvement is achieved.

Id. at 8.

The panel decision thus found ineligibility without considering the specification evidence that explains how the recited steps (1) were not performed by prior computing systems and (2) enabled computers to produce better image quality compared to those prior systems. Appx026 at 1:30-40; Appx027 at 3:42-61; Appx032 at 14:51-61; Appx034 at 17:54-18:9; Principal Br. 34, 36-38; Reply Br. 11-12. However, "[c]laims need not articulate the advantages of the claimed combinations to be eligible." *Uniloc USA, Inc. v. LG Elecs. USA, Inc.*, 957 F.3d 1303, 1309 (Fed. Cir. 2020). Precedent requires consideration of other evidence to make that determination: the specification or other evidence of record. *See id.* at 1307-08 (citing specification as evidence of computing improvement).

Until the panel decision, to Longitude's knowledge, the Court has never affirmed a Rule 12 dismissal for ineligibility where the specification explains how the claimed arrangement improves computing performance or functionality and there is no evidence (in the specification or otherwise of record) that the claim recites only conventional technology. The Court frequently has found eligibility at step one based on such evidentiary records. *See, e.g.*, *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337-38 (Fed. Cir. 2016) (analyzing specification evidence of improvements to find eligibility under step one); *CardioNet, LLC v. InfoBionic, Inc.*, 955 F.3d 1358, 1368-71 (Fed. Cir. 2020) (relying on specification's benefits evidence and lack of conventionality evidence to find eligibility under step one);

McRO, Inc. v. Bandai Namco Games Am. Inc., 837 F.3d 1299, 1313-14 (Fed. Cir. 2016) (same); *Ancora Techs., Inc. v. HTC Am., Inc.*, 908 F.3d 1343, 1348-49 (Fed. Cir. 2018) (same); *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1259-60 (Fed. Cir. 2017) (relying on specification's benefits evidence and analogizing to *Enfish* on the basis that "the specification discusses the advantages offered by the technological improvement"); *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1304 (Fed. Cir. 2018) (referencing specification to determine virus scanning improvement).

In other cases, the Court has upheld eligibility at step two or identified a fact issue that precludes Rule 12 dismissal based on evidence akin to the specification evidence presented here. *See, e.g.*, *CosmoKey Sol'ns GmbH & Co. KG v. Duo Security LLC*, 15 F.4th 1091, 1097-98 (Fed. Cir. 2021) (relying on specification's description of improvements and lack of conventionality evidence to find eligibility under step two); *Cooperative Entm't, Inc. v. Kollective Tech., Inc.*, 50 F.4th 127, 131-32 (Fed. Cir. 2022) (relying on the specification's explanation of "how [the claimed invention] is different from and improves upon the prior art" to find a fact question under step two precluding Rule 12 dismissal); *BASCOM Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349-50 (Fed. Cir. 2016) (relying on specification evidence to find a fact question under step two precluding Rule 12 dismissal).

This consistent precedent necessarily requires consideration and weighing of specification evidence supporting eligibility at both step one and step two. For example, in *Ancora*, the Court found that the claim "addresses a technological problem" based on aspects of the claimed arrangement "that the patent asserts, and we lack any basis for disputing, were not previously used in the way now claimed, and the result is a beneficial reduction of the risk of hacking." *Ancora*, 908 F.3d at 1348-49 (finding eligibility under step one).

CardioNet, too, weighed the specification's description of benefits against its lack of description of conventionality. *CardioNet*, 955 F.3d at 1368-71 (finding eligibility under step one). The Court found that the "written description identifies a number of advantages gained by the elements recited" in the claim, and, conversely, the specification contained "no suggestion . . . that doctors were previously employing the techniques performed on the claimed device." *Id.* at 1369-70. *CardioNet* analogized the evidentiary record to *McRO* and *Visual Memory*: where the specification evidence describes the claimed arrangement as a technological improvement and not as conventional technology, the Court has consistently upheld the corresponding claims. *Id.*

The panel decision distinguished *McRO* on the basis that "in *McRo* [*sic*], we stressed that the language of the claims themselves was 'limited to rules with specific characteristics.'" Op. at 7-8 (citing *McRO*, 837 F.3d at 1313). This

statement is correct, but lacking the material context that *McRO* did not assess the claims in a vacuum.[4]

Indeed, *McRO* weighed the specification evidence supporting eligibility against the absence of evidence of conventionality in the same way as in *CardioNet*, and reached the same conclusion of eligibility. *McRO*, 837 F.3d at 1313-14. The Court relied on the fact that "the specification confirms" the computing improvement provided by the claim and, on the other side of the scale, "Defendants provided no evidence that the process previously used by animators is the same as the process required by the claims." *Id. McRO* continued to emphasize the absence of evidence demonstrating conventionality, explaining that "[t]here has been no showing that any rules-based lip-synchronization process must use rules with the specifically claimed characteristics," and, again, "no record evidence supports this conclusion." *Id.* at 1315.

The cases discussed by the panel—*Recentive* and *Hawk*—follow the Court's precedent finding claims ineligible where the balance of record evidence demonstrates that the claimed arrangements recite only conventional technology

[4] The panel decision also asserted that "Longitude effectively asks to import disclosures from the specification into the claim," but the decision does not identify what disclosures it refers to or explain why those disclosures do not describe claim 32. Op. at 8.

and techniques. Op. at 6-7. These cases do not support the panel's decision to disregard intrinsic evidence supporting eligibility. Op. at 5-8.

In *Recentive*, the specification and the patent owner conceded that the claims did not improve any machine learning technology, and instead merely applied conventional machine learning techniques to a new data environment. *Recentive Analytics, Inc. v. Fox Corp.*, 134 F.4th 1205, 1212-13 (Fed. Cir. 2025). *Recentive* found claims ineligible based on affirmative evidence not present here—intrinsic evidence and concessions—that the claims recited conventional techniques. *Id.*

Hawk, too, explained that the specification described the claimed arrangement as using only conventional technology: "'existing broadband infrastructures' and a 'generic PC-based server.'" *Hawk Tech. Sys., LLC v. Castle Retail, LLC*, 60 F.4th 1349, 1353 (Fed. Cir. 2023) (citing the patent's specification). The Court agreed with the district court's finding that the "specification and claims do not explain or show how the monitoring and storage is improved, except by using already existing computer and camera technology." *Id.* at 1358. The Court further noted that "[t]he '091 patent itself confirms that the invention is meant to 'utiliz[e] existing broadband media and other conventional technologies.'" *Id.* at 1358-59 (citing the patent's specification).

In contrast, *CardioNet* aligns with the record in this case. The *CardioNet* majority found that—as here—"the district court erred by disregarding the written