

The patent claim under consideration recited an “improved digital camera” that has two lenses, two image sensors, an analog-to-digital converter, a memory and a digital image processor for “producing a resultant digital image from said first digital image enhanced with said second digital image.” Yu conceded that “the idea and practice of using multiple pictures to enhance each other has been known by photographers for over a century” and that the components recited in the claim “are themselves generic and conventional.”

Applying the Supreme Court’s two-step *Alice v. CLS Bank* test for determining patent eligible subject matter, the Federal Circuit determined at step one that the claim was “directed to the abstract idea of taking two pictures . . . and using one picture to enhance the other in some way.” At step two, the Court held that the claim failed to otherwise define a patent eligible invention because the digital camera “is
recited at a high level of generality and merely invokes well-understood, routine, conventional components to apply the abstract idea of [using one picture to enhance the other in some way].” The Court rejected Yu’s attempts to use portions of the patent’s specification to support eligibility, explaining that the eligibility analysis is limited to the literal recitations of the asserted claims.

Then, along came Judge Pauline Newman. With a chainsaw.

In dissent, Judge Newman argued that the majority was improperly enlarging the § 101 analysis to include other “substantive requirements of patentability.” Judge Newman emphasized (twice) that the claim literally recited an electromechanical camera, not an abstract idea. In her view, the camera recited in the claim met the requirements of § 101 as a new and useful machine, without regard to whether the claimed camera also met the novelty requirements of §§ 102 and 103. Referring to the Supreme Court’s 1981 holding in Diamond v. Diehr, Judge Newman wrote that “[i]n contravention of [Diehr’s] explicit distinction between Section 101 and Section 102, the majority now holds that the [claimed] camera is an abstract idea because the camera’s components were well-known and conventional and perform only their basic functions.” Judge Newman further proclaimed that “the principle that the majority today invokes was long ago discarded.”

Judge Newman also admonished the majority for the destabilizing effects that similar holdings have already had on US patent policy. She noted that “[i]n the current state of Section 101 jurisprudence, inconsistency and unpredictability of adjudication have destabilized technologic development in important fields of commerce,” and that “[t]he fresh uncertainties engendered by the majority’s revision of Section 101 are contrary to the statute and the weight of precedent, and contrary to the public’s interest in a stable and effective patent incentive.”

**Practice Note:** Some of the uncertainty among the members of the Federal Circuit bench may trace back to the Supreme Court’s opinion in Mayo v. Prometheus. In Mayo, the Supreme Court determined that the asserted claims were patent ineligible, in part because the recited claim elements “involve well-understood, routine, conventional activity previously engaged in by researchers in the field.” Indeed, the Supreme Court specifically recognized that “the §101 patent-eligibility inquiry and, say, the §102 novelty inquiry might sometimes overlap [but] to shift the patenteligibility inquiry entirely to these later sections risks creating significantly greater legal uncertainty.”

© 2021 McDermott Will & Emery

National Law Review, Volume XI, Number 175