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**WEISNER V. GOOGLE LLC:
AN EFFORT TO PROVIDE CLARITY REGARDING PATENT
SUBJECT MATTER ELIGIBILITY**

Weisner v. Google LLC, 51 F.4th 1073 (Fed. Cir. 2022)*

The United States Court of Appeals for the Federal Circuit (“Federal Circuit”) recently issued a precedential two-to-one decision regarding patent subject matter eligibility under section 101 of the Patent Act.¹ In *Weisner v. Google LLC*, the Federal Circuit held that U.S. Patent Nos. 10,380,202 and 10,642,910 are directed to abstract ideas of creating digital travel logs which are patent ineligible.² Additionally, the Court held that U.S. Patent Nos. 10,394,905 and 10,642,911 are directed to both creating and using travel logs to improve computerized search results and are potentially patent-eligible.³ The majority’s decision is an attempt to clarify the historically gray area of patent eligibility under section 101, but it is unclear whether the result will aid future decisions or add to the complexity.

Judge Hughes’s dissent offers an interesting analysis arguing the focus of the patents’ claims does not warrant patent eligibility under section 101.⁴ He proposed that to be patent-eligible, the patents needed to solve a problem specific to the Internet.⁵ However, the majority’s decision seems to imply that courts should be more flexible and view patent eligibility as a simple threshold test, rather than halting the case in the early stages of litigation.

I. FACTUAL AND PROCEDURAL BACKGROUND

Sholem Weisner is a co-owner of U.S. Patent Nos. 10,380,202 (the “’202 patent”), 10,642,910 (the “’910 patent”), 10,394,905 (the “’905 patent”) and 10,642,911 (the “’911 patent”).⁶ All four of the patents are related and have a common specification, but differ in claims.⁷ The common specification describes ways for businesses and individuals to “exchange information, for instance ‘a URL or an electronic business card.’”⁸ The purpose is to create a time-stamped history of the businesses and people an individual interacts with,

* By Nicole Poirot, J.D. Candidate, Santa Clara University School of Law, 2024. I am grateful to Erik Perez for inspiring me to write this article and assisting me throughout the process.

¹ See *Weisner v. Google LLC*, 51 F.4th 1073, 1074 (Fed. Cir. 2022).

² *Id.* at 1081–84.

³ *Id.* at 1088.

⁴ *Id.*

⁵ *Id.* at 1088–89.

⁶ *Id.* at 1075.

⁷ See *Weisner*, 51 F.4th at 1075.

⁸ *Id.* (quoting ’202 patent col. 3 ll. 30–36).

recording identifier information in the user's "leg history" along the way.⁹

The claims of the '202 and '910 patents describe methods of *creating* a user's "leg history" either by having the user accept a prompt from a business or manually record entries, respectively.¹⁰ The '202 patent details a method of recording "physical location histories" of "individual member[s]" that visit "stationary vendor member[s]" in a "member network" if the user accepts an "automatic proposal" from the vendor.¹¹ The '910 patent differs in that "the location history is recorded based on the initiative of the individual choosing to record entries"¹² Both patents' claims refer to use of "generic features" like sorting software, Bluetooth, mobile communication devices, a telecommunications network, and GPS.¹³

The claims of the '905 and '911 patents differ in that they create and utilize the "leg history" to "improve computerized search results."¹⁴ The '905 patent details a "method of combining enhanced computerized searching for a target business with use of humans as physical encounter links."¹⁵ In other words, the method improves an individual's search results by comparing the user's "leg history" to a third-party with similar histories and promoting results that the third-party user visited.¹⁶ Similarly, the '911 patent describes a "method of enhancing digital search results for a business in a target geographic area using URLs of location histories."¹⁷ This method uses the user's geographic history to promote results in similar geographic locations.¹⁸

Sholem Weisner first filed a claim against Google, LLC, on April 06, 2020.¹⁹ While he originally only alleged infringement of the '202 patent, he quickly and voluntarily amended his complaint on June 16, 2020, to add the other three patents.²⁰ Google moved to dismiss the complaint for two reasons.²¹ First, Google argued Mr. Weisner's patent claims were ineligible under 35 U.S.C. § 101.²² Next, Google argued

⁹ *Id.* (quoting '202 patent col. 1 ll. 6–10).

¹⁰ *Id.*

¹¹ *Id.* at 1077 (quoting '202 patent col. 21 ll. 13–67)).

¹² *Id.* at 1078 (citing '910 patent col. 21 ll. 12–61).

¹³ *See Weisner*, 51 F.4th at 1084.

¹⁴ *Id.* at 1078–79.

¹⁵ '905 patent col. 21 ll. 15–17.

¹⁶ *Id.*

¹⁷ '911 patent col. 21 ll. 14–16.

¹⁸ *Id.*

¹⁹ *See Weisner*, 51 F.4th at 1080.

²⁰ *Id.*

²¹ *Id.*

²² *Id.*

Mr. Weisner did not meet the minimum threshold for plausibly pleading his claim under *Bell Atlantic Corp. v. Twombly* and *Ashcroft v. Iqbal*.²³ Subsequently, the district court granted dismissal on the *Twombly / Iqbal* basis.²⁴ It held a hearing to determine whether Mr. Weisner's claims met the requirements for patent subject matter eligibility under section 101.²⁵ Following the hearing, the district court dismissed Mr. Weisner's complaint but allowed the opportunity for amendment.²⁶

Mr. Weisner's Second Amended Complaint was followed by Google's motion to dismiss for the identical reasons stated above.²⁷ This time, the district court granted dismissal for both failing to state a claim and patent ineligibility, without holding another hearing to discuss subject matter eligibility.²⁸ Mr. Weisner appealed to the Federal Circuit where, in a two-to-one split, the Court affirmed-in-part and reversed-in-part.²⁹

II. LEGAL ANALYSIS AND CONCLUSION

The Federal Circuit majority reviewed both the motion to dismiss for failure to state a claim under Federal Rules of Civil Procedure 12(b)(6) and the district court's decision on patent eligibility under section 101 *de novo*.³⁰ For the Rule 12(b)(6) issue, the Federal Circuit was to determine if the patents plausibly satisfied the Supreme Court's test for determining patent eligibility under section 101 of the Patent Act.³¹ The Court affirmed the district court's conclusion that the '202 and '910 patents were not patent-eligible.³² However, it reversed the district court's decision regarding the '905 and '911 patents, holding that the patents plausibly met the requirements for patent subject matter eligibility under section 101.³³

Section 101 protects "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."³⁴ In *Alice Corp. v. CLS Bank International*, the

²³ *Id.*

²⁴ *Id.*

²⁵ *See Weisner*, 51 F.4th at 1080.

²⁶ *Id.* at 1080–81.

²⁷ *Id.* at 1081.

²⁸ *Id.*

²⁹ *Id.*

³⁰ *Id.*

³¹ *See Weisner*, 51 F.4th at 1081.

³² *Id.* at 1088.

³³ *Id.*

³⁴ 35 U.S.C. § 101.

Supreme Court established the two-step test for determining whether a patent satisfies section 101.³⁵ Step one of the test is to “determine whether the claims at issue are directed to one of [the] patent-ineligible concepts[,]” like laws of nature, natural phenomena, or abstract ideas.³⁶ Step two looks for an “inventive concept” like “an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’”³⁷ The Federal Circuit analyzed each patent under the *Alice* two-step test.³⁸

A. *The Federal Circuit’s Analysis for ’202 and ’910*

The claims of the ’202 and ’910 patents describe methods of creating a user’s “leg history” either by having the user accept a prompt from a business or manually record entries, respectively.³⁹ Starting with the first one, the Federal Circuit’s majority agreed with the district court’s holding that both of the patents are abstract because they are creating a travel log.⁴⁰ The Federal Circuit referenced the patents’ claim language, and Mr. Weisner’s own legal briefs to support its holding.⁴¹ The ’202 patent claims refer to generic methods of “maintaining a processing system.”⁴² Similarly, the ’910 patent claims describe a “method for accumulation of physical location histories.”⁴³ In the Second Amended Complaint, Mr. Weisner reiterated the claims of the patents are directed to methods of accumulating data.⁴⁴ After finding that the “claims are directed to creating a digital travel log,” and thus are abstract ideas, the Court also analyzed whether the claims are aimed to improve computer function.⁴⁵

Under *Alice*, “claims purporting to improve ‘the functioning of the computer itself’ or ‘an existing technological process’ might not be directed to an abstract idea.”⁴⁶ The Federal Circuit once again agreed with the district court when it held that the creation of a digital travel

³⁵ 573 U.S. 208 (2014).

³⁶ *Id.* at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Lab’y, Inc.*, 566 U.S. 66, 77–79 (2012)).

³⁷ *Id.* at 217–18 (quoting *Mayo Collaborative Servs.*, 566 U.S. at 72–73).

³⁸ *See Weisner*, 51 F.4th at 1081.

³⁹ *Id.* at 1078–79.

⁴⁰ *Id.* at 1081.

⁴¹ *Id.* at 1082.

⁴² ’202 patent col. 21 ll. 15–18.

⁴³ ’910 patent col. 21 ll. 16–19.

⁴⁴ *See Weisner*, 51 F.4th at 1082.

⁴⁵ *Id.*

⁴⁶ *Id.* (quoting *Alice*, 573 U.S. at 225).

log is not an improvement to computer function.⁴⁷ The lower court stated “[h]umans have consistently kept records of a person’s location and travel in the form of travel logs, diaries, journals, and calendars, which compile information such as time and location.”⁴⁸ The Court held simply utilizing a computer to conduct a “conventional method of organizing human activity” is not enough to “bring the claims out of the realm of abstractness.”⁴⁹

Under *Alice*’s section two step, the Federal Circuit searched for an “inventive concept” which may save the claims from being patent ineligible.⁵⁰ However, the Court confirmed that the use of well-known technology to create a digital version of a travel log does not constitute an “inventive concept.”⁵¹ Furthermore, the claims did not “focus on a specific means or method that improves the relevant technology.”⁵² The Court pointed to various features that the claims list like sorting software, Bluetooth, mobile telephone, the Internet, and GPS.⁵³ The Federal Circuit affirmed the district court’s conclusion that the claims “do not recite significantly more than the abstract idea of digitizing a travel log using conventional components,” and therefore are ineligible under section 101.⁵⁴

B. *The Federal Circuit’s Analysis for ’905 and ’911*

The Federal Circuit then reviewed the ’905 and ’911 patents.⁵⁵ The claims of the ’905 and ’911 patents differ in that they create and utilize the “leg history” to “improve computerized search results.”⁵⁶ The Court began its analysis by holding the district court erred when they analyzed all four patents together at step one of the *Alice* two-step test.⁵⁷ The Court stated the ’905 and ’911 patents should have been analyzed separately from the other two patents because they have a different focus.⁵⁸ The ’905 and ’911 patents describe methods of

⁴⁷ *Id.* at 1082–83.

⁴⁸ *Id.* (quoting *Weisner*, 551 F. Supp. 3d at 339).

⁴⁹ *Id.* at 1083.

⁵⁰ *See Weisner*, 51 F.4th at 1083–84.

⁵¹ *Id.* at 1084.

⁵² *Id.* (quoting *Weisner*, 551 F. Supp. 3d at 340).

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ *Id.*

⁵⁶ *See Weisner*, 51 F.4th at 1078–79.

⁵⁷ *Id.* at 1084.

⁵⁸ *Id.*

“improv[ing] computerized search results,” whereas the ’202 and ’910 patents refer to methods of simply creating travel logs.⁵⁹

The Federal Circuit decided, while the ’905 and ’911 patents are abstract, they have the “inventive concept” necessary to satisfy step two of the *Alice* test.⁶⁰ The Federal Circuit starts step two by referring to the claims themselves.⁶¹ Claim 1 of the ’905 patent recites an inventive method of utilizing a reference member to improve search results for the searching user.⁶² The Court stated this is an “inventive concept” because “it is a specific implementation of that concept.”⁶³

The Court also utilized Mr. Weisner’s Second Amended Complaint and the specification to affirm its decision.⁶⁴ The Second Amended Complaint elaborates on the inventive method stating that it “provides ‘specifically tailored result[s] to the searcher’s unique characteristics’ and ‘eliminates the inherent bias of pushing and referring places through conventional web searches.’”⁶⁵ The specification also describes the problem that the ’905 patent seeks to solve.⁶⁶ Rather than traditional web searches that are not personalized, the method described in the ’905 patent uses an individual’s leg history to improve and customize their search results.⁶⁷ The Federal Circuit concluded that the patentable subject matter is the use of another member’s leg history to improve the searchers user experience.⁶⁸

The Federal Circuit concluded similarly regarding the ’911 patent, stating that it “presents a different solution to the problem of generic web search results.”⁶⁹ As previously stated, the ’911 patent utilizes a user’s physical geographic history and the location of the search to improve their results.⁷⁰ The Court found the “inventive

⁵⁹ *Id.*

⁶⁰ *Id.* at 1087.

⁶¹ *Id.* “Although Mr. Weisner argue[d] on appeal that a number of claims are ‘exemplary,’ Appellant’s Br. 20, 28, 32, 37, he only describe[d] and analyze[d] claim 1 of each patent in any significant detail. Accordingly, [the Court] treat[ed] claim 1 of each patent as representative.” *Weisner*, 51 F.4th at 1082 n.2.

⁶² *See Weisner*, 51 F.4th at 1086 (citing ’905 patent col. 21 ll. 46–56).

⁶³ *Id.*

⁶⁴ *Id.*

⁶⁵ *Id.*

⁶⁶ *Id.* at 1087.

⁶⁷ *Id.*

⁶⁸ *See Weisner*, 51 F.4th at 1087.

⁶⁹ *Id.*

⁷⁰ *See Weisner*, 51 F.4th at 1087.

concept” in the ’911 patent where the patent “addresses the problem of non-personalized search results described in the specification.”⁷¹

Finally, the Federal Circuit held that the patents satisfied section 101 because they “provided a specific solution to an Internet-centric problem.”⁷² The patents recite methods of utilizing travel histories to produce personalized search results, a solution to the problem of generic search results.⁷³ Furthermore, the Court stated that the claims of the patents did not “broadly and generically claim[] ‘use of the Internet’ to perform an abstract business practice . . .” because they used specific methods to solve the problem.⁷⁴

For the reasons stated above, the Federal Circuit affirmed the district court’s conclusion that the claims in the ’202 and ’910 patents were ineligible under section 101.⁷⁵ However, it reversed the district court’s decision regarding the ’905 and ’911 patents, holding that both patents’ claims “plausibly include more than merely the concept of improving computerized search results using travel histories.”⁷⁶

III. JUDGE HUGHES’ DISSENT-IN-PART

Judge Hughes dissented-in-part.⁷⁷ He agreed that the claims of the ’202 and ’910 patents are ineligible but disagreed with the majority’s holding that the claims of the ’905 and ’911 patents involve inventive concepts.⁷⁸ Judge Hughes argued that the ’905 and ’911 patents utilize “routine and conventional” algorithms and “do not solve a problem specific to the internet.”⁷⁹

Judge Hughes first asserted that utilizing a user’s history of physical interactions with other users or their geographic history are well-known methods of sorting search results, and therefore are not transformative.⁸⁰ He looked to the Second Amended Complaint where Mr. Weisner admitted that his patents use “the same or similar algorithm used by existing search engines, only with physical

⁷¹ *Id.* (citing ’911 patent col. 2 l. 64–col. 3 l. 2).

⁷² *Id.* The Court applied the rule from *DDR Holdings, LLC v. Hotels.com, L.P.* where it held that “an inventive concept for resolving [a] particular Internet-centric problem, render[ed] the claims patent-eligible.” 773 F.3d 1245, 1258 (Fed. Cir. 2014).

⁷³ *Id.* at 1087–88.

⁷⁴ *Id.* at 1088 (quoting *DDR Holdings*, 773 F.3d at 1258–59).

⁷⁵ *Id.*

⁷⁶ *See Weisner*, 51 F.4th at 1088.

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Id.* at 1088–89.

⁸⁰ *Id.* at 1089.

encounters that are now searchable online just as cyber encounters were until now.”⁸¹ Judge Hughes highlighted that the claims attempt to use conventional methods of sorting data, just with a “new type of data—location history.”⁸² He further argued that the only new concept in the claims of the ’905 and ’911 patents was the use of location history, which the majority agreed was an abstract idea, not an “inventive concept.”⁸³ Therefore, Judge Hughes concludes the patents should have failed step two of the *Alice* test.⁸⁴

Judge Hughes also disagreed with the majority’s use of the rule in *DDR Holdings*.⁸⁵ He argued that the ’905 and ’911 patents do not solve problems specific to the Internet, which he seemed to propose is the distinguishing element for a patentable abstract idea involving the Internet.⁸⁶ He provided two examples where the problems the ’911 and ’905 patents seek to solve exist outside of the Internet.⁸⁷ First, he used an example of using a travel agent to get travel recommendations as an analogy to the ’911 patent.⁸⁸ Like the claims of the ’911 patent, “[t]o get more personalized recommendations from a travel agent, people could ask about specific destinations and list locations they have visited before”⁸⁹ Next, he compared the ’905 patent to receiving restaurant recommendations from a friend who has similar taste and has been to similar restaurants.⁹⁰ To Judge Hughes, Mr. Weisner’s patents “merely recite the performance of some business practice known from the pre-Internet world along with the requirement to perform it on the Internet,” unlike the system in *DDR Holdings* which solved a problem specific to the Internet.⁹¹

IV. DISCUSSION

This decision may offer much needed resolution regarding patent eligibility for abstract ideas involving the utilization of collected data. Courts and scholars have long struggled with interpreting the meaning of “abstract ideas” under the landmark Supreme Court

⁸¹ See *Weisner*, 51 F.4th at 1089.

⁸² *Id.*

⁸³ *Id.* at 1090.

⁸⁴ *Id.*

⁸⁵ *Id.*

⁸⁶ *Id.*

⁸⁷ See *Weisner*, 51 F.4th at 1090.

⁸⁸ *Id.*

⁸⁹ *Id.*

⁹⁰ *Id.*

⁹¹ *Id.* at 1091.

decision, *Diamond v. Chakrabarty*.⁹² For example, the Supreme Court, Federal Circuit, and Court of Appeals have all noted concerns about the lack of clarity regarding the word, especially given its importance as one of the three strictly patent-ineligible concepts under *Diamond*.⁹³ Once inventors started using technology to recreate abstract ideas in a digital form, the Supreme Court went through a difficult period attempting to resolve questions involving patent subject matter eligibility.⁹⁴ The Supreme Court sought to harmonize its earlier decisions a number of times before it finally established a more definitive test for patentable subject matter in *Alice Corp. v. CLS Bank International*.⁹⁵ Since the *Alice* decision, however, lower courts have found it difficult to apply the Supreme Court's test, resulting in a steep increase in the number of patents being invalidated on section 101 grounds.⁹⁶ To combat this, commentators have called for more standardized tests regarding patent eligibility.⁹⁷

In the case at hand, the Federal Circuit majority's decision seems to provide some guidance for cases where the patented technology *uses* collected data. The primary difference between the patents is that two of the patents only collect data, while the other two utilize data to create a personalized experience for users. The Federal Circuit decided a similar case right after *Weisner*, concluding that the "inventive concept" it is looking for must involve using data in a way

⁹² 447 U.S. 303, 309 (1980); see Scott T. Luan, *All That is Solid Melts Into Air: The Subject-Matter Eligibility Inquiry in the Age of Cloud Computing*, 31 SANTA CLARA HIGH TECH. L.J. 313, 316–17 (2014).

⁹³ Luan, *supra* note 92, at 317.

⁹⁴ *Compare Gottschalk v. Benson*, 409 U.S. 63 (1972) (an algorithm for converting binary-coded decimal numerals into pure binary numerals – patent ineligible) with *Parker v. Flook*, 437 U.S. 584 (1978) (procedure for updating an alarm limit – patent eligible) and *Diamond v. Diehr*, 450 U.S. 175 (1981) (a physical and chemical process for molding precision synthetic rubber products – patent eligible).

⁹⁵ See 573 U.S. 208 (2014); see also *Bilski v. Kappos*, 561 U.S. 593 (2010) (attempting to harmonize decisions in *Gottschalk v. Benson*, *Parker v. Flook*, and *Diamond v. Diehr*).

⁹⁶ See Jonathan Stroud, *Patent Post-Grant Review after Alice* 69 BAYLOR L. REV. 56, 103 (2017) (after *Alice* until 2017, "[o]f 155 § 101 challenges in district courts, 109 or 70.3% resulted in the invalidity rulings").

⁹⁷ See Ping-Hsun Chen, *Patent Eligibility Standard For Network Architecture Patents Under The Federal Circuit's Jurisprudence*, 36 SANTA CLARA HIGH TECH. L.J. 1, 37 (2020). The call for standardization can be found in other areas of patent law as well. See e.g., Erik I. Perez, *A Proposed Analytical Framework For Resolving An Intra-Court Split On Claim Construction Ambiguity*, 39 SANTA CLARA HIGH TECH. L.J. 92 (2022).

that solves a problem for users. In *IBM v. Zillow Group, Inc.*, the Federal Circuit held in a two-to-one decision that methods of collection, sorting, and *displaying* data do not meet the “inventive concept” requirement of the *Alice* test.⁹⁸ These rulings confirm that to avoid dismissal under Rule 12(b)(6), a patent’s claims must plausibly show the method or system does more than just sort and display data—it must also use the data in a specific way.

Through the *Weisner* decision, the Federal Circuit may also offer a different way to avoid an invalidity ruling under section 101. Patents that solve an Internet-specific problem may escape the realm of abstractness simply by utilizing the Internet in the solution. Judge Hughes offered compelling arguments against this, concluding that Mr. Weisner’s patents should not satisfy *Alice*’s second step because they recited methods that have been known long before the Internet.⁹⁹ The majority’s disregard of Judge Hughes’ arguments could be an effort to reduce the number of patents being invalidated under section 101. Claiming that solutions to Internet-specific problems should satisfy step two of the *Alice* test will surely open the doors for patents reciting similar claims. However, the Federal Circuit’s goal may be to return section 101 to the threshold test it was designed to be,¹⁰⁰ rather than the complex jungle of litigation it has become in the years after *Alice*.

⁹⁸ 50 F.4th 1371, 1383 (Fed. Cir. 2022).

⁹⁹ See *Weisner*, 51 F.4th at 1090.

¹⁰⁰ See *Bilski*, 561 U.S. at 593.