

No. 26-

IN THE
Supreme Court of the United States

US PATENT NO. 7,679,637 LLC,

Petitioner,

v.

GOOGLE LLC,

Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Under *Alice Corp. Pty. Ltd. v. CLS Bank International*, 573 U.S. 208 (2014) (“*Alice*”), a court asks first whether patent claims are “directed to” a patent-ineligible concept, such as an abstract idea, and second whether the claims’ additional elements supply an “inventive concept.” An issued patent “shall be presumed valid.” 35 U.S.C. § 282. In 35 U.S.C. § 112 Congress prescribed what a patent’s specification must disclose and how claims may be drafted.

In this case the Federal Circuit held the asserted claims ineligible at both steps of that framework, finding the claims do not “describe how” their goal is achieved, while declining to decide whether the district court’s formulation of the abstract idea was an overgeneralization. The specification describes how in prose, in figures containing pseudo-code and C++ source code, and in a program listing appendix; the opinion mentions none of them. The specification also records that, at the time of the invention, “current web conferencing systems are unable to enable participants to asynchronously observe a live meeting.” One asserted claim recites its storage element in means-plus-function form, importing the disclosed structure by construction; no court construed it. The courts below resolved the case on the pleadings, faulting the complaint for lacking factual allegations of unconventionality and denying leave to add them as futile.

The questions presented are:

1. Whether a court applying *Alice* may hold patent claims ineligible at both steps because they do not describe how their result is achieved, so that the identity of the abstract idea has no effect on the outcome, converting 35 U.S.C. § 101 into a disclosure inquiry that belongs to 35 U.S.C. § 112, conducted without evidence, claim construction, or the challenger’s burden of proof.

2. Whether a patent-infringement complaint may be dismissed because the patent owner did not plead facts negating ineligibility, an invalidity defense that 35 U.S.C. § 282(b) requires the accused infringer to plead, and where leave to add those facts was denied as futile.

PARTIES TO THE PROCEEDINGS

Petitioner US Patent No. 7,679,637 LLC was plaintiff in the district court and appellant in the court of appeals.

Respondent Google LLC was defendant in the district court and appellee in the court of appeals.

Petitioner has no stock ticker symbol. Respondent Google LLC has no stock ticker symbol; it is an indirect subsidiary of Alphabet Inc., whose shares trade under the ticker symbols “GOOGL” and “GOOG.”

CORPORATE DISCLOSURE STATEMENT

Pursuant to this Court's Rule 29.6, petitioner US Patent No. 7,679,637 LLC states that it has no parent corporation, that no publicly held company owns 10 percent or more of its membership interests, and that it has no stock ticker symbol. Jeffrey Kohler, the inventor of the patent at issue, is the real party in interest.

RELATED PROCEEDINGS

US Patent No. 7,679,637 LLC v. Google LLC, No. 2:23-cv-00592-JHC (W.D. Wash.), order granting motion to dismiss and judgment entered January 25, 2024.

US Patent No. 7,679,637 LLC v. Google LLC, No. 2024-1520 (Fed. Cir.), opinion and judgment entered January 22, 2026; combined petition for panel rehearing and rehearing en banc denied March 25, 2026.

US Patent No. 7,679,637 LLC v. Google LLC, No. 25A1262 (U.S.), application to extend the time to file this petition granted May 15, 2026.

There are no other proceedings in state or federal trial or appellate courts, or in this Court, directly related to this case within the meaning of Rule 14.1(b)(iii).

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PETITION FOR A WRIT OF CERTIORARI

US Patent No. 7,679,637 LLC respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-15a) is reported at 164 F.4th 1373. The order of the court of appeals denying panel rehearing and rehearing en banc (Pet. App. 55a-56a) is unreported. The opinion and order of the district court granting respondent's motion to dismiss (Pet. App. 18a-52a) is reported at 713 F. Supp. 3d 1024.

JURISDICTION

The court of appeals entered judgment on January 22, 2026, and denied a timely combined petition for panel rehearing and rehearing en banc on March 25, 2026. Pet. App. 55a-56a. On May 15, 2026, the Chief Justice extended the time within which to file this petition to and including August 22, 2026. No. 25A1262. This Court has jurisdiction under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Patent Clause, U.S. Const. art. I, § 8, cl. 8, and the pertinent text of 35 U.S.C. §§ 101, 112 (2006 ed.),¹ and 282 are reproduced at Pet. App. 85a-87a.

1. The application was filed before September 16, 2012, so the version of § 112 in force before the Leahy-Smith America Invents Act governs. Citations are to the 2006 edition of the United States Code.

INTRODUCTION

In 2006, Jeffrey Kohler built a web-conferencing system whose participants could rewind a meeting while the meeting was still happening, then catch back up at faster playback with the speech still intelligible. The specification he submitted contains the implementation itself. Figure 3 of U.S. Patent No. 7,679,637 is pseudo-code for the playback module; Figure 4 is the server’s frame-retrieval algorithm in C++; and a computer program listing appendix holds source code that “illustrate[s] an implementation of the invention.” The examiner allowed the claims only after amendments drew live-review and architecture distinctions. Kohler built time-shifted web conferencing in 2006, and he handed the public his source code.

Twenty years later, the Federal Circuit extinguished those claims under 35 U.S.C. § 101, in a precedential opinion, on the pleadings, without evidence or claim construction. At step one of the framework prescribed by *Alice*, it held the claims directed to an abstract idea “because they do not ‘describe how the alleged goal of [asynchronous review] is achieved.’” Pet. App. 7a-8a. At step two, it rejected Kohler’s inventive concepts because “the claims use result-oriented language with no specific implementation illustrating how to achieve the claimed results.” *Id.* 12a. One observation, the absence of “how,” was dispositive at both steps; the opinion’s namings of the abstract idea differ, and the outcome was expressly held constant across them. The opinion never mentions Figure 3, Figure 4, or the code.

The decision is the endpoint of a decade of drift. Specificity began as evidence, *Enfish, LLC v. Microsoft*

Corp., 822 F.3d 1327, 1336 (Fed. Cir. 2016), *Electric Power Group, LLC v. Alstom S.A.*, 830 F.3d 1350, 1356 (Fed. Cir. 2016); became a test, *Hawk Technology Systems, LLC v. Castle Retail, LLC*, 60 F.4th 1349, 1357 (Fed. Cir. 2023); became a presumption, *Beteiro, LLC v. DraftKings Inc.*, 104 F.4th 1350, 1356 (Fed. Cir. 2024); reached machine learning, *Recentive Analytics, Inc. v. Fox Corp.*, 134 F.4th 1205, 1213 (Fed. Cir. 2025); and in this case became self-sufficient: dispositive at both steps, whatever the abstract idea may be.

The panel understood which question this case presented. The Chief Judge of the Federal Circuit agreed at argument that claim 2 suffers from a functional claiming problem, then asked: “is that a step one issue or a step two issue? ... I’ll be honest with you, I don’t always know where that line is.” Arg. 11:03.² She laid out the candidate rubrics from the bench, asking whether the missing “how” “obviate[s] the need for identifying an abstract idea” or is instead “a separate vehicle for also evaluating ineligibility.” Arg. 13:09. Google’s counsel supplied an answer: the court need not decide what the abstract idea is before applying the test. Arg. 15:22. The opinion enacted that answer, and the en banc court declined review.

Panels before and after this one reaffirmed that step two cannot proceed without the abstract idea fixed for the decisionmaker. *Optis Cellular Technology, LLC v. Apple Inc.*, 139 F.4th 1363, 1380 n.11 (Fed. Cir. 2025); *Ollnova Technologies Ltd. v. ecobee Technologies ULC*, Nos. 2025-1045, -1046 (Fed. Cir. 2026).

2. “Arg. [minute:second]” citations refer to the October 6, 2025 oral argument, recording available at https://www.cafc.uscourts.gov/oral-arguments/24-1520_10062025.mp3.

The Chief Judge asked for “a rubric... for how these different concepts fit together under our 101 eligibility law.” Arg. 13:09. The Federal Circuit has not found one; only this Court can.

This petition accordingly does not ask the Court to define “abstract idea,” to overrule any decision, or to disturb specificity’s role at step one. Evidence may be shared across steps; the questions may not be. What a court may not do is let one observation substitute for both. When lower courts have merged the steps of this Court’s frameworks, this Court has corrected them. *Purkett v. Elem*, 514 U.S. 765, 768 (1995). And when the Federal Circuit has replaced one of this Court’s frameworks with an administrable proxy, this Court has retired the proxy, from *eBay* through *Halo*. The rule applied below is the newest member of that family.

The substitute inquiry also has a statutory home. Whether a patent teaches how to make and use an invention is the office of § 112, which answers it through the eyes of a skilled artisan, on evidence, after claim construction, with the burden on the challenger. Here it was answered by judges, on the pleadings, against the patentee, and wrongly, on a record containing the algorithms in the patent’s figures and the inventor’s working implementation. Sections 101 and 112 may overlap in application; *Mayo* said as much. *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 90-91 (2012). What one section may not do is stand in for the other, stripped of every safeguard Congress attached.

The second question is the procedural half of the same failure. Section 282 presumes issued patents valid and

puts the burden of establishing invalidity, by clear and convincing evidence, on the challenger. *Microsoft Corp. v. i4i Limited Partnership*, 564 U.S. 91, 95 (2011). Yet the asserted claims here were extinguished on a Rule 12(b)(6) motion, without evidence or construction, on inferences drawn against the patentee from misread sentences of the specification. The district court faulted the complaint for lacking “concrete allegations” of unconventionality, then denied leave to add them as futile.

It will be said the panel was generous: it assumed a narrower abstract idea *arguendo* and affirmed anyway. But the assumption changed nothing, because the missing “how” decided both steps. Step two is defined by step one’s output, and the formulations in play differ in exactly the elements that matter. Subtraction requires a subtrahend. A court whose result does not depend on which idea it names has not performed two inquiries; it has performed one inquiry twice.

It will also be said step two had a second ground: the specification’s statements of conventionality. Those statements reach individual components, never the claimed combination; the one true admission, an off-the-shelf audio library, touches a component absent from claims 2 and 3; the rest are misreadings. Part II.C, *infra*. That ground cannot carry the judgment.

The decision is already being applied at every procedural stage. The time to review a new rule is while it is new. The petition should be granted.

STATEMENT OF THE CASE

A. The invention

By 2006, web conferencing let dispersed participants meet through shared streams of screen video, camera video, audio, chat, and documents. '637 patent 2:38-43. Some systems could record a meeting for use afterward. *Id.* 2:44-50. The patent states the gap: “current web conferencing systems are unable to enable participants to asynchronously observe a live meeting, i.e., observe a previously recorded part of the meeting while the meeting is still in progress.” *Id.* 2:51-54.

Television had time-shifting, in what the specification calls “a separate field”: TiVo let a viewer rewind one linear broadcast stream on one device; while a conference transmits many concurrent streams through a server to observer applications. *Id.* 3:7-18.

Kohler’s system decomposes a conference into discrete streams and each stream into frames stamped in “presentation time,” relative to the session’s start. *Id.* 6:63-7:17. As frames arrive, the server writes an index entry for each: frame number, timestamp, key-frame or delta-frame status, and storage offset. *Id.* 6:18-28. The index is written while the session continues, so recording and retrieval are simultaneous: an observing client requests content by presentation time, and the server walks the index to return the last key frame at or before that time with the deltas that follow. *Id.* 7:26-44. Client playback logic computes the request from clock, rate, and offsets, so an observer can pause, seek, and change speed against a live recording. *Id.* 8:7-31.

The disclosure descends to code. Figure 3 is a pseudo-code listing of the playback module's logic: its state variables and its functions for pause, resume, seek, and rate change. Figure 4 is the server's frame-retrieval algorithm, RetrieveFrames, in C++. A computer program listing appendix, two compact discs whose forty-plus source files are inventoried in the specification, contains listings that "illustrate an implementation of the invention." '637 patent 1:16-2:27, 8:60-9:20; see MPEP § 608.05(a).

Claims 2 and 7 were treated as representative below and reproduced in full at Pet. App. PV12-PV13. Claim 2's storage element and whereby clause frame the dispute:

(c) storage means for recording said computer screen video and said data stream, and

whereby said web conferencing system is able to simultaneously record said computer screen video and said data stream and allow said observing participant to sense current and previously presented parts of said computer screen video and said data stream.

'637 patent 12:32-61. Independent claim 7 recites the architecture from the server's side in the claim's own text: a "server application" "arranged to" "receive said data streams from said first client application and record" them "in a storage device," and to "retrieve" and "send" them "to said second client application," with a time-scale modification component, all so that streams "can be simultaneously recorded by and retrieved from said storage device" while the presenter "is sharing a current part of said data streams." *Id.* 13:20-14:19. Every asserted

claim requires live operation; a system that merely plays back recorded content does not practice them. Claim 2 recites its storage element in statutory means-plus-function form, importing the disclosed structure by construction. 35 U.S.C. § 112 ¶ 6; *infra* Part II.A.

B. The examination of the patent

The file history is evidence, never weighed by any factfinder, of what was routine while the application was pending.

Kohler filed the application in October 2007, claiming the benefit of an October 2006 provisional, and prosecuted it himself. The examiner tested the claims against both fields the district court would later conflate: web-conferencing references and TiVo's own recorder patents. The claims were allowed over all of them.

The prosecution history records how. In interviews memorialized in the applicant's contemporaneous remarks, never questioned by the Office, the examiner "expressed a desire for the claims to more explicitly call out" the invention's aspects: "it should be made more clear that an observer can interact with the system while a conference is in progress (someone is presenting)," because otherwise "the Examiner felt that playback was a well known technique similar to that exemplified by a DVD player." July 2009 Remarks 6-7 (Pet. App. 58a). Kohler amended the claims to draw the distinction.

After a further rejection came a third interview. The remarks record the examiner's agreement that in the principal reference, Culver, "you have to wait until

the end of the recording to listen to the conference,” while in the applicant’s system “you are able to listen to the conference while it’s being recorded.” October 2009 Remarks 7 (Pet. App. 61a). Kohler filed the amendment, distinguishing the TiVo references (Barton, Vallone) by architecture. His remarks observed that, three years after his provisional filing, “no web conferencing systems are available that include time-shifting capabilities.” Pet. App. 80a. The claims were allowed in January 2010. The rejections were prior-art rejections, and the allowance predates *Bilski* and *Alice*.

C. The district court proceedings

Petitioner, the LLC that holds Kohler’s patent, sued Google in the Western District of Washington in April 2023, alleging that Google’s YouTube service infringes claims 2 through 5 and 7 through 9, every web-conferencing system claim in the patent. The amended complaint attached a twenty-six-page chart mapping each claim element to Google’s products. C.A. App. 290-315.

Google moved to dismiss under Rule 12(b)(6), asserting ineligibility and an alternative pleading ground, and supported the motion with materials beyond the pleadings, including a prior-art patent. Petitioner opposed, invoking *Berkheimer v. HP Inc.*, 881 F.3d 1360 (Fed. Cir. 2018), and *Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121 (Fed. Cir. 2018); arguing that Google offered no evidence that the claimed combination was conventional in 2006; identifying “storage means” and “time-scale modification component” as § 112 ¶ 6 terms; submitting a Rule 56(d) declaration itemizing the discovery needed to answer Google’s conventionality assertions, C.A. App.

249-252; and requesting leave to amend if any defect were found, C.A. App. 184.

The district court granted the motion without oral argument and dismissed with prejudice. Pet. App. 18a-52a. It held “the ’637 Patent is directed to the abstract idea of playing back recorded content,” reasoning that the web-conferencing problem the patent identified “is not an issue unique to the internet.” *Id.* 42a-43a. At step two it held the claims recite “generic computer functions.” *Id.* 48a. It distinguished *Aatrix* on the ground that petitioner “does not point to concrete allegations” that the elements and their combination are not well understood, routine, and conventional, *id.* 47a n.8, and in the same order denied leave to amend as futile. *Id.* 50a-51a. It conducted no claim construction, did not address the Rule 56(d) declaration, and, disclaiming reliance on Google’s extra-pleading materials, declined to convert the motion. *Id.* 46a-47a n.7. Google’s alternative ground was not reached. *Id.* 19a-20a n.1.

D. The court of appeals proceedings

The Federal Circuit heard argument on October 6, 2025, before Chief Judge Moore and Judges Hughes and Stoll. Chief Judge Moore said the district court’s characterization “ignored the important claim language about being able to asynchronously observe a web-conference session while the session’s still going on,” and, when Google’s counsel adhered to it: “I kind of don’t agree, and I think this is an over generalization.” Arg. 09:33, 10:19.

The Chief Judge agreed that claim 2 suffers from a “functional claiming problem” (“How is it arranged to allow?”), and pressed counsel on where that problem belongs in the framework. Arg. 11:03, 13:09.

The panel affirmed in a precedential opinion by the Chief Judge, without adopting or rejecting the district court’s characterization. Pet. App. 1a-15a. It held: “Even if we were to narrow the district court’s characterization of the claims, however, we would still conclude the claims are directed to the patent-ineligible abstract idea of allowing asynchronous review of presentations, rather than any specific technological improvement, because they do not ‘describe how the alleged goal of [asynchronous review] is achieved.’” *Id.* 7a-8a (quoting *Hawk*, 60 F.4th at 1357). It read the written description as “suggest[ing] the invention is nothing more than the abstract idea of applying known time-shifting functions to web-conferencing systems,” citing three passages of the specification, each about an individual component. Pet. App. 10a.

At step two, the opinion rejected both asserted inventive concepts, the two-application multi-stream architecture and the time-scale modification component, as resting on result-oriented language and as shown conventional by the specification. Pet. App. 12a-13a. Its final section announced that “[t]he abstract idea involves allowing asynchronous review of web conferencing presentations” and held amendment futile because “[n]o amendment to the complaint can alter what the ’637 patent itself states.” Pet. App. 14a.

The opinion does not mention Figure 3, Figure 4, or the source code appendix.

E. Rehearing and subsequent developments

Petitioner sought panel and en banc rehearing; the petition presented, module by module, the specification’s capture, server, observer, and playback logic, and observed that “[t]he panel nowhere mentions the code nor explains why it can conclude that a patent that includes such code can nonetheless fail to explain how the invention operates.” C.A. Reh’g Pet. 2. It asked the full court to reconcile the panel’s approach with *Contour IP Holding LLC v. GoPro, Inc.*, 113 F.4th 1373 (Fed. Cir. 2024). The court denied the petition on March 25, 2026, without opinion. Pet. App. 55a-56a.

Ten weeks later, a different panel vacated a judgment in a similar case because the factfinder had been asked to decide *Alice* step two without being told the abstract idea. *Ollnova*, slip op. 17-23. *Ollnova* also held functionally drafted claims not abstract at step one, explained that “[c]laims need not articulate the advantages of the claimed combinations to be eligible,” and held conventionality of the claimed architecture a jury question. *Id.*, slip op. 23-30 (quoting *Uniloc USA, Inc. v. LG Electronics USA, Inc.*, 957 F.3d 1303, 1309 (Fed. Cir. 2020)).

REASONS FOR GRANTING THE PETITION

Both questions presented arise from the same event: the substitution of this Court’s two-step framework with a single question, whether the claims recite “how,” answered by judges on the pleadings against a presumptively valid patent. Part I traces the substitution; Part II identifies the substitute as § 112’s inquiry stripped of § 112’s safeguards; Part III addresses the pleading stage; Part IV explains why review is warranted now, in a clean vehicle.

I. THE FEDERAL CIRCUIT ANSWERED BOTH STEPS OF THE ALICE FRAMEWORK WITH THE SAME OBSERVATION, AND NO FORMULATION OF THE ABSTRACT IDEA AFFECTED THE OUTCOME

A. Alice prescribes two distinct, sequential inquiries

This Court’s framework is sequential by design. A court “must first determine whether the claims at issue are directed to a patent-ineligible concept.” *Alice*, 573 U.S. at 218. Only then may it “consider the elements of each claim both individually and ‘as an ordered combination’” in search of an “inventive concept” sufficient to make the patent “significantly more than a patent upon the [ineligible concept] itself.” *Id.* at 217-218 (quoting *Mayo*, 566 U.S. at 72-73, 78-79). Step one characterizes what the claim is about; step two takes that characterization as fixed and asks what the claim adds. The Federal Circuit agrees: the inventive concept must lie in limitations “other than the invention’s use of the ineligible concept,” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018), and a factfinder deciding step two “should be instructed what the abstract idea is.” *Optis*, 139 F.4th at 1380 n.11. This Court has itself fixed the concept first in every case: *Bilski* (risk hedging), *Mayo* (metabolite correlations), *Alice* (intermediated settlement). Step two cannot condemn until step one has produced its object.

B. One observation answered both steps

The opinion below resolved step one with step two’s question. The claims were held directed to an abstract idea

not because of what they are about, but “because they do not ‘describe how the alleged goal of [asynchronous review] is achieved.’” Pet. App. 7a-8a. Whether a claim describes a specific implementation rather than a bare result is, in the Federal Circuit’s own architecture, the heart of the step two search. The opinion then answered step two with the same observation: “the claims use result-oriented language with no specific implementation illustrating how to achieve the claimed results.” *Id.* 12a. One criterion, applied twice, decided both steps. A framework in which a single observation is dispositive at each step is a one-step test, not the test this Court prescribed.

The shortcut was deliberate: its author laid out the candidate rubrics in open court, *supra* Introduction, and the opinion made the missing “how” suffice at step one, reused it at step two, and let the abstract idea formulation matter at neither. Elevating one criterion into the sole test of eligibility is what *Bilski* forbade. *Bilski v. Kappos*, 561 U.S. 593, 602-604 (2010).

The treatment of the abstract idea confirms that the framework stopped doing work. The district court held “the ’637 Patent,” not the claims, directed to “playing back recorded content.” Pet. App. 42a. At argument, Google’s counsel repeated that formulation, then offered two more variants. Arg. 10:09-16:39. The opinion declined to endorse or reject that formulation and let variants accumulate. Pet. App. 7a-8a, 10a, 14a. The formulation it floated in a subjunctive clause was petitioner’s own asserted improvement with the word “improvement” deleted; the entire distance between improvement and abstraction was “how.” Multiple formulations, none reconciled, and the outcome never changed: whatever the idea was, the claims lacked “how.”

The ready answer is that the opinion names an abstract idea twice. Each naming concedes the problem. The first is conditional: “[e]ven if we were to narrow the district court’s characterization of the claims, however, we would still conclude” the claims ineligible, “because they do not ‘describe how.’” Pet. App. 7a-8a. It holds the outcome constant across formulations. The second arrives in the leave-to-amend section and differs from the formulation step one hypothesized: “[t]he abstract idea involves allowing asynchronous review of web conferencing presentations.” *Id.* 14a. Nothing in the opinion subtracts it, or any other candidate, from the claims. An identification that cannot change the result is not what the framework requires. Step two requires a subtraction, *BSG Tech*, 899 F.3d at 1290, and the opinion performed none against any formulation it named.

The step two discussion does contain a second sentence: “as the specification makes clear,” the client applications were “conventional, well-known components,” and the time-scale component “was a conventional component implemented using off-the-shelf algorithms.” Pet. App. 12a-13a. The statements concern individual components, never the ordered combination the claims recite, though an inventive concept can reside in precisely “the non-conventional and non-generic arrangement of known, conventional pieces.” *BASCOM Global Internet Services, Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1350 (Fed. Cir. 2016). They rest on the misread passages addressed in Part II.C, *infra*; the one true admission reaches only the time-scale component of claims 4, 5, 7, 8, 9; claims 2 and 3 recite no such component. And they perform no subtraction, because the opinion never asks what the claims add beyond any identified idea. Built from

the same misreadings, and measured against no identified idea, the second ground cannot stand on its own.

C. What began as evidence became a substitute

This petition does not ask the Court to disturb the role specificity has played at step one. Since *Enfish*, the Federal Circuit has asked whether claims focus on a “specific asserted improvement in computer capabilities” or instead on an abstract idea for which computers are “invoked merely as a tool,” and the way claims are drafted has informed that inquiry as evidence. 822 F.3d at 1335-1336. *Electric Power Group* did what the decision below would not: it fixed the abstract idea first, used the claims’ result-oriented character as evidence, and separately asked what the claims added to that idea. 830 F.3d at 1353-1356. Each step kept its own question. Specificity was evidence within the framework, not the framework itself.

The cases that followed changed its role by increments, each citing the last. *Hawk* made the evidence a test: claims fail at step one where they do not “describe how the alleged goal... is achieved.” 60 F.4th at 1357. *Beteiro* made the test a presumption: functionally drafted claims “are almost always found to be ineligible.” 104 F.4th at 1356. *Recentive* carried the presumption into machine learning. 134 F.4th at 1213. And the decision below completed the progression, precedentially: the observation now suffices at both steps, and the outcome no longer depends on what the abstract idea is. The framework was replaced in increments too small for any single panel to arrest.

D. This Court does not permit lower courts to merge the steps of its frameworks

Outside patent law, the rule is enforced. When the Eighth Circuit “erred by combining *Batson*’s second and third steps into one,” this Court summarily reversed. *Purkett*, 514 U.S. at 768. It reversed again when California resolved *Batson*’s first step with the third step’s standard. *Johnson v. California*, 545 U.S. 162, 168-173 (2005). It rebuffed a litigant who pressed the extraterritoriality framework’s step two “focus” inquiry at the threshold. *RJR Nabisco, Inc. v. European Community*, 579 U.S. 325, 337-338 (2016). It enforced the rule again, unanimously, in *Barnes v. Felix*, 605 U.S. 73 (2025), where a totality inquiry had been reduced to a single question. This Court should enforce the same discipline on *Alice*’s two steps.

This Court has relaxed the sequencing of its own frameworks only openly. *Pearson v. Callahan*, 555 U.S. 223 (2009); *Strickland v. Washington*, 466 U.S. 668, 697 (1984). It has never licensed silent departures below.

What happened below is not benign skipping of a dispositive prong: resolving step one with step two’s criterion, then reusing it, decides everything while performing neither inquiry. *Purkett* and *Johnson* condemn precisely that.

E. This Court has repeatedly corrected the Federal Circuit for substituting homegrown proxies for its frameworks

This case also fits a pattern specific to the court below. Time and again, the Federal Circuit has compressed

a flexible framework into a rigid, administrable proxy, and this Court has reversed: the injunction rule in *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 393-394 (2006) (rejecting a “general rule,” “unique to patent disputes”); the teaching-suggestion-motivation test in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007) (“rejecting the rigid approach”); machine-or-transformation in *Bilski*, 561 U.S. at 602-604 (not “the sole test”); the *Brooks Furniture* fee standard in *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 572 U.S. 545, 553 (2014) (“unduly rigid”); and the *Seagate* willfulness test in *Halo Electronics, Inc. v. Pulse Electronics, Inc.*, 579 U.S. 93, 103-104 (2016) (same).

The functional-language rule is the newest proxy. Under circuit law as the decision below states and applies it, claims “drafted using largely (if not entirely) result-focused functional language, containing no specificity about how the purported invention achieves those results... are almost always found to be ineligible.” Pet. App. 9a (quoting *Beteiro*, 104 F.4th at 1356). The rule is administrable as those proxies were, and it displaces the framework the same way: it makes the statutory question irrelevant whenever a judge can characterize the claim language as functional. The correction this petition seeks is the one this Court has issued five times: retire the proxy and apply the framework.

F. The merger decided this case

The panel’s assumed abstract idea did not cure the merger, because step two is defined by step one’s output. Nor was assuming a narrower idea a favor. At step two, favorability inverts: the narrower the idea,

the more of the claims' substance it subsumes, so the assumption ran against the patentee. Under the district court's formulation, "playing back recorded content," simultaneous recording and live review lie outside the idea: additional elements whose conventionality in 2006 is a question of fact on which Google offered no evidence. Under the opinion's subjunctive formulation, live review is subsumed but the web-conferencing architecture is not; under the amendment section's formulation, the architecture arguably is; and under the written-description formulation, "applying *known* time-shifting functions to web-conferencing systems," nothing remains, because the word "known" decides the *Berkheimer* question by definition. Same claims, four formulations, four different step two inquiries. A court that never chooses among them has not performed the analysis this Court prescribed. And the remand is concrete: step two would ask whether simultaneous live review, through two client applications and a server that records while serving, recited in claim 7 and imported into claim 2 by its storage element, was conventional in 2006. Against the specification sentences Google cited, each about an individual component, stand the examiner's refusal to allow the claims until the live-review distinction was drawn, allowance over TiVo's own recorder patents, and the applicant's uncontradicted statement that no web-conferencing system offered time-shifting. A factfinder has never seen that dispute. *Supra*, Statement B.

The opinion's own background states, "undisputed by Google on appeal," that the claims allow a participant "to go back and review one aspect of a multimedia presentation while another aspect is proceeding live." Pet. App. 2a. The elements that move in and out of these

formulations are the very distinctions the Patent Office required as the price of allowance, without which, the remarks record, the claims would describe a technique “exemplified by a DVD player.” *Supra*, Statement B. The characterizations the courts below employed erased the elements the agency demanded, and the substitute “how” rule ensured the erasure never mattered.

The Federal Circuit’s own cases mark when an assumed idea is harmless, and this case is on the wrong side of that line. *Ollnova* acknowledged in a footnote that an abstract idea may be identified “by stipulation, assumption, or otherwise,” and that district courts may deny motions on step two factual disputes “without definitively ruling as to step one.” Slip op. 21 n.7. But every decision cited for that practice resolved the assumption in the patentee’s favor: the claims survive under every candidate. *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014) (claims “satisfy *Mayo/Alice* step two” under “any of these characterizations”); *Aatrix*, 882 F.3d at 1126-1128; *Cooperative Entertainment, Inc. v. Kollektive Technology, Inc.*, 50 F.4th 127, 131 (Fed. Cir. 2022). Running the assumption against the patentee inverts that logic: because the formulation defines the additional elements, extinguishment on an assumed idea requires failure under every candidate tested, and no court here tested any. The footnote addresses when motions may be denied without fixing the idea; it says nothing about extinguishing a patent that way. Even *Ollnova*’s caution, that an idea left unfixed invites a new trial, concedes that formulation controls outcome.

G. The Federal Circuit cannot hold its own line

The court of appeals is divided against itself, and the en banc court declined to intervene. On characterization: *Contour IP* reverses a district court for overgeneralizing claims, 113 F.4th at 1379; the decision below affirms without deciding whether “playing back recorded content” was such a description. On step discipline: *Optis* and *Ollnova* hold that step two cannot proceed without the abstract idea fixed for the decisionmaker, 139 F.4th at 1380 n.11; slip op. 17-23; the decision below held its outcome constant across every formulation in play, condemning on the pleadings what *Ollnova* sent to a jury. Slip op. 26-30. The author of the decision below saw this coming: dissenting in *American Axle*, she wrote that § 101 is “monstrous enough,” and objected that her court was converting § 101 into a disclosure inquiry belonging to § 112. 967 F.3d 1285, 1307 (Fed. Cir. 2020) (Moore, J., dissenting), reh’g en banc denied, 966 F.3d 1347 (Fed. Cir. 2020) (6-6). When the judge who diagnosed the conflation authors the decision that completes it, and the en banc court declines to engage, Pet. App. 55a-56a, the problem is institutional and past self-correction. The silence is exhaustion, not agreement: *Athena* produced eight separate opinions pleading for intervention, *American Axle* five; the denial here produced none. *Athena Diagnostics, Inc. v. Mayo Collaborative Services*, 927 F.3d 1333 (Fed. Cir. 2019) (en banc denial). The Federal Circuit’s jurisdiction is exclusive, 28 U.S.C. § 1295(a)(1), so no circuit split will ever ripen; intra-circuit conflict is the only conflict patent law can produce, and it exists here.

II. THE SUBSTITUTE INQUIRY IS SECTION 112'S, STRIPPED OF SECTION 112'S SAFEGUARDS

A. Disclosure is Section 112's office

Patent law already assigns the “how” question a statute: § 112. The statute requires the specification to describe the invention in terms exact enough “to enable any person skilled in the art... to make and use the same.” 35 U.S.C. § 112 ¶ 1. Section 112 is enforced as an invalidity defense, proved by clear and convincing evidence, after claim construction, through the eyes of the skilled artisan. *Id.*, 564 U.S. at 95.

That division of labor is the patent bargain's oldest term: claims delimit the invention; the specification teaches it. This Court sustained a claim specifying only a “high” or “substantial” pitch for a papermaking wire because the specification taught the artisan the rest, *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 65-66 (1923), and describing the invention “is the role of the disclosure portion of the specification, not the role of the claims.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). The contrary demand is new. *Supra* Part I.C.

Congress also spoke to the functional drafting style condemned below. After *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946), invalidated functional claiming at the point of novelty, Congress rejected that rule in the 1952 Act: means-plus-function elements are permitted, on the condition that they be “construed to cover the corresponding structure... described in the specification.” 35 U.S.C. § 112 ¶ 6; *In re Donaldson Co.*,

16 F.3d 1189, 1192-1195 (Fed. Cir. 1994) (en banc) (the construction is mandatory). The statute builds the “how” into a functional claim by construction: the disclosed structure becomes a limitation as a matter of law. Even the *American Axle* majority recognized that a claim may supply “how” “by statutory incorporation of specification details under section 112(f).” 967 F.3d at 1302. Claim 2 recites its storage element in that statutory form, and its corresponding structure sits on the record’s face: the indexed frame store and retrieval logic of Figures 1, 3, and 4, illustrated further in the program listing appendix. ’637 patent 6:18-28, 7:26-44. Petitioner identified “storage means” and “time-scale modification component” as § 112 ¶ 6 terms below, C.A. App. 175-178; neither court construed them, each citing the absence of a proposed construction. Pet. App. 15a, 34a-35a. Construed as the statute directs, claim 2 recites structure, not a bare result; unconstrued, it was condemned for the very drafting form Congress authorized. That sequence is itself the inversion this petition describes. And claim 7 needs none of this: its storage element is a “storage device,” not a means clause, and its architecture, a server connected to two client applications, recording streams while simultaneously retrieving and sending them, is recited in the claim’s own text.

None of this treats the sections as sealed compartments. *Mayo* said the inquiries “might sometimes overlap,” while refusing to shift § 101’s work onto §§ 102, 103, and 112. 566 U.S. at 90-91. The boundary runs both ways: the sections may share evidence; neither may absorb the other’s inquiry. Here the substitution stripped every safeguard. The skilled artisan is replaced by a judge’s reading of the cold document; the clear and convincing burden by

no evidence at all; construction by a demand that the patentee volunteer constructions at the pleading stage; a defense the challenger must prove becomes a hurdle the complaint must clear to reach discovery. And it performs a dissection this Court forbids: claims “must be considered as a whole,” not condemned component by component. *Diamond v. Diehr*, 450 U.S. 175, 188 (1981). The choice between § 112 and § 101 chooses the procedure, and the procedure decides the case. The result is *Halliburton’s* condemnation revived under § 101, where the construction Congress prescribed as its cure never operates.

B. The record refutes the premise: the patent describes how, down to source code

By the opinion’s own account, step one permits “analyzing whether the claims and written description ‘describe how [the] improvement was accomplished.’” Pet. App. 8a (quoting *Recentive*, 134 F.4th at 1213). If the test measured whether the patent explains how the invention works, this patent passes three ways at once: in prose (the capture, indexing, retrieval, and playback logic, ’637 patent 6:18-28, 6:63-7:17, 7:26-44, 8:7-31); in the figures (Figure 3, the playback algorithm in pseudo-code; Figure 4, the server’s retrieval routine in C++); and in the appendix (forty-plus source files that “illustrate an implementation,” inventoried in the specification, *id.* 1:16-2:27). The opinion states that no technological improvement is “discernible to a skilled artisan from the patent or the prosecution history,” Pet. App. 9a, yet it mentions none of this. If source code does not describe “how,” nothing could.

The anticipated rejoinder, that unclaimed disclosure is irrelevant, indicts the opinion it defends, which consults

“the claims and written description” and says the claim “need not explicitly recite the improvement.” Pet. App. 8a. *Contour IP* likewise found the improvement in the specification and reversed. 113 F.4th at 1379-1380.

Nor does *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 112-113 (1854), answer this record: Morse’s eighth claim covered printing at a distance by electromagnetism “however developed,” untethered from the machinery he disclosed. Kohler’s claims run the opposite way. They are confined to web conferencing, to multiple concurrent streams, to two client applications joined by a recording server, and to live operation; record-then-replay systems, broadcast time-shifting, and single-stream tools all remain open to the world. That is a claim on a particular architecture, not a result. Claim 7 recites the architecture expressly, and claim 2 imports it through its storage element. *Two-Way Media*’s rule that the inventive concept must appear in the claims is met, not evaded. 874 F.3d 1329, 1338 (Fed. Cir. 2017); *Trustees of Columbia University v. Gen Digital Inc.*, No. 2024-1243 (Fed. Cir. Mar. 11, 2026) (same rule).

“[T]o the extent the claims do not claim a specific manner of achieving that goal, the patent specification does.” C.A. Reh’g Pet. 5.

C. The specification was read against the patentee

The opinion’s contrary account, that the specification shows nothing more than known time-shifting functions, rests principally on three citations, each of which misdescribes its passage. It cites column 5 as “acknowledging data streams were ‘commonly used in the audio visual field.’” The sentence describes the key-

frame and delta-frame scheme, not data streams, and the passage teaches extending that scheme to stream types where it had not been used. '637 patent 5:35-44. It cites column 8 as stating that the display components “resemble those of similar components in existing web conferencing... applications.” The sentence begins “For the most part,” and the next sentence states exactly where the resemblance ends: playback rate. *Id.* 8:33-39. It cites column 10 as “disclosing known client applications.” That passage is an alternative-embodiments discussion of how the inventor’s own applications might be packaged. *Id.* 10:20-29. Candid descriptions of embodiments were misread into admissions of conventionality, on a motion where every reasonable inference belonged to the patentee.

The same inversion produced a rule that punishes drafting candor twice over. Because the specification honestly discloses that one component of the first embodiment used an existing audio library, the component was held incapable of contributing to an inventive concept “as a matter of law.” Pet. App. 13a. And because the specification does not append the label “this is a specific technical improvement,” the architecture was held to embody none, drawing Judge Stoll’s question at argument: “Does it have to say it’s a specific technical improvement?” Arg. 20:03. *Ollnova*, quoting *Uniloc*, answers no: “Claims need not articulate the advantages of the claimed combinations to be eligible.” Slip op. 26. Eligibility should not turn on magic words; within the same circuit, today, it does and it does not.

D. The United States has said this conflation warrants review

In *American Axle*, a claim fell at step one for failure to specify how a natural law was applied; the en banc court split six to six; and the Solicitor General recommended certiorari, identifying confusion in the “directed to” inquiry and the entanglement of § 101 with § 112. Brief for the United States as Amicus Curiae, *American Axle*, No. 20-891 (2022). The Solicitor General then recommended granting both *Interactive Wearables* and *Tropp*, which asked whether § 112 considerations may drive § 101. Nos. 21-1281, 22-22 (Apr. 2023). What began as a driveshaft problem in 2022 is now the general law of software.

III. PRESUMPTIVELY VALID CLAIMS MAY NOT BE EXTINGUISHED ON THE PLEADINGS BY RESOLVING FACTUAL QUESTIONS AGAINST THE PATENTEE

A. The statute, this Court’s cases, and the Federal Rules all point the same way

Section 282(a) commands that “[a] patent shall be presumed valid” and places “[t]he burden of establishing invalidity” on the challenger. This Court held in *i4i* that the burden is clear and convincing evidence, 564 U.S. at 95, and the Federal Circuit applies the presumption in eligibility cases, *Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1319 (Fed. Cir. 2019). Section 282 allocates as well as presumes: invalidity is a defense that “shall be pleaded” by the party asserting it. 35 U.S.C. § 282(b). A complaint need not anticipate and negate an affirmative defense. *Jones v. Bock*, 549 U.S. 199, 216 (2007); cf. *Astellas Pharma, Inc. v.*

Sandoz Inc., 117 F.4th 1371 (Fed. Cir. 2024) (§ 282 governs § 101). An affirmative defense can support dismissal only where “the allegations in the complaint suffice to establish that ground,” *Jones*, 549 U.S. at 215. The complaint’s allegations did not, because every specification passage in play concerns individual components, never the claimed combination. The decision below inverted the statute’s allocation: the complaint was dismissed for failing to plead facts negating a defense assigned to the infringer. On a Rule 12(b)(6) motion, allegations are taken as true, *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 555-556 (2007), and every reasonable inference runs to the plaintiff, a standard the order below recited. Pet. App. 20a.

The Federal Circuit holds that “[w]hether something is well-understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination,” *Berkheimer*, 881 F.3d at 1369, resolvable on the pleadings “only when there are no factual allegations that, taken as true, prevent resolving the eligibility question as a matter of law,” *Aatrix*, 882 F.3d at 1125.

None of that law operated here. Google introduced no evidence that the claimed combination was conventional in 2006; when pressed at argument for record support, its counsel offered two sentences of the specification about individual components. Arg. 17:49, 20:34. The courts below made a finding about what a “skilled artisan” would discern with no artisan in the record, treated misread specification sentences as binding concessions, *supra* Part II.C, and never analyzed the ordered combination beyond a conclusory sentence, contrary to *Diehr*, 450 U.S. at 188, and *BASCOM*, 827 F.3d at 1350. Nor is it an answer that eligibility is ultimately legal: the sub-question that decided

this case, conventionality, is one the Federal Circuit itself classifies as factual, and here it was resolved against the patentee without evidence. *Tolan v. Cotton* summarily vacated a court that weighed disputed evidence against the non-movant. 572 U.S. 650, 656-660 (2014) (per curiam). The courts below did at the pleadings what *Tolan* forbade even at summary judgment.

B. The amendment ruling was a trap with no exit

The district court distinguished *Aatrix* on the ground that petitioner “does not point to concrete allegations” that the claim elements and their combination were not well understood, routine, and conventional. Pet. App. 47a n.8. In the same order, it denied leave to add those very allegations as futile. *Id.* 50a-51a. The court of appeals affirmed both rulings together: “[n]o amendment to the complaint can alter what the ’637 patent itself states regarding the conventionality of the client applications, data streams, and time-scale modification components.” Pet. App. 14a (citing *Sanderling Management Ltd. v. Snap Inc.*, 65 F.4th 698, 706 (Fed. Cir. 2023)). That is a list of components, in a holding about allegations addressed to the combination. Each half assumes the other: the complaint fails for want of allegations and the allegations are futile because of what the patent “states.” Yet the patent states no such thing about the claimed combination.

What would petitioner have pled? The record answers. An amended complaint would have alleged, with support already in the intrinsic record, that the two-application multi-stream architecture indexed by presentation time was not well understood, routine, or conventional (’637 patent 6:18-28, 6:63-7:17); that no web-conferencing

system permitted review while the session continued, as the specification stated in 2006 and the prosecution remarks repeated three years later ('637 patent 2:51-54; October 2009 Remarks 21); that the examiner allowed the claims over conferencing and TiVo patents only after the live-review and architecture distinctions were drawn (July 2009 Remarks 6-7; October 2009 Remarks 7). Those are among the “concrete allegations” the district court said were missing, and they speak to *Berkheimer* conventionality of the claimed combination, not to novelty. They were refused not as implausible but as futile. Petitioner will be candid about the sequence: the amended complaint did not plead unconventionality, the request for leave was a sentence, and no draft amendment was tendered. None of it mattered, because futility was declared from what the patent “states,” a ground indifferent to any pleading’s content and reviewed de novo, *Mobile Acuity Ltd. v. Blippar Ltd.*, 110 F.4th 1280, 1288 (Fed. Cir. 2024), and Part II.C shows the reading behind that ruling mistaken.

Rule 15(a)(2) requires leave to amend be freely given. *Foman v. Davis*, 371 U.S. 178, 182 (1962). *Aatrix* reversed a futility-based denial of leave to amend in an eligibility case. 882 F.3d at 1126-1130. *Sanderling* is not to the contrary: the amendments proposed there were “conclusory statements,” offered, evaluated, and found wanting, 65 F.4th at 706; here no proposed amendment was evaluated at all. A regime in which allegations are fatal to omit and futile to offer is simply a rule that patentees lose, whatever they plead. And the decision below is spreading: within months, district courts were invoking its futility holding against other patentees. *Elreich v. Waymo, LLC*, No. 1:25-cv-00814 (E.D. Cal. June 22, 2026) (findings

and recommendations) (citing 713 F. Supp. 3d at 1041); *Empower Tribe Commercial FZE v. Roland Corp.*, No. 2:25-cv-09658 (C.D. Cal. July 7, 2026) (quoting 164 F.4th at 1380).

C. The same court gives other patentees the process it denied here

Within thirteen months, the Federal Circuit gave the same factual question, conventionality of a claimed feature or combination, four different procedural fates: a dispute that “precludes judgment on the pleadings” in *Columbia*, seven weeks after the decision below; a jury in *Ollnova*, slip op. 23-26; a remand for step two in *Optis*, 139 F.4th at 1380 & n.11; and judgment on the complaint here, the Rule 56(d) declaration never addressed, the motion never converted. Fed. R. Civ. P. 12(d). Postures differ, and different records permit different inferences. But the variable across these cases was not the record; it was the question. Where a court asked whether the claimed combination, not merely its parts, was conventional, the dispute survived, past the pleadings in *Columbia* and to factfinders in *Ollnova* and *Optis*. Here statements about parts were treated as answering the question about the whole, and the claims died on the allegations in the complaint alone.

IV. THE QUESTIONS ARE IMPORTANT AND RECURRING, AND THIS CASE PRESENTS THEM CLEANLY

A. The decision below is already reshaping eligibility litigation

In seven months, the decision became a fixture of eligibility law. The Federal Circuit has applied it twice: in a precedential decision setting aside a jury verdict, *GoTV Streaming, LLC v. Netflix, Inc.*, 166 F.4th 1053 (Fed. Cir. 2026), and in affirming a Rule 12(b)(6) dismissal, *Etison LLC v. HighLevel, Inc.*, No. 2025-1711, slip op. 15 (Fed. Cir. July 2, 2026) (nonprecedential) (quoting Pet. App. 12a). District courts have invoked it to hold amendment futile, *Elreich, supra*; to grant summary judgment on the eve of trial, *B.E. Technology, L.L.C. v. Google LLC*, No. 20-622-GBW (D. Del. 2026); to reopen a settled eligibility ruling, *Vineyard Investigations v. E. & J. Gallo Winery*, No. 1:19-cv-01482 (E.D. Cal. 2026).

Courts applying the decision are already pulling in opposite directions. One district court quoted its statement that “the claim itself need not explicitly recite the improvement” and, looking to the specification, denied a § 101 motion without prejudice. *Lime Green Lighting, LLC v. Brilliant NextGen Inc.*, No. 5:25-cv-00950 (N.D. Cal. Mar. 25, 2026). The Federal Circuit has twice applied its demand for a specific implementation to condemn claims that recite functions. *GoTV*, 166 F.4th at 1067; *Etison*, slip op. 15.³ Both readings are faithful to the opinion, which

3. *GoTV* recites that the inquiries remain “distinct, at least in focus,” yet lets the same missing “how” observation carry both.

is the problem: it supplies no administrable rule for when an improvement “embodied” in the specification saves a claim and when its absence from the claims condemns it. A new precedential rule is disposing of verdicts, complaints, and settled rulings based on contradictory meanings in the decision.

B. The candid ledger, and why this petition is different

Petitioner will not pretend recent history away. This Court denied every § 101 petition since *Alice*, including *American Axle*, *Interactive Wearables*, and *Tropp* over the Solicitor General’s recommendations to grant. Four more petitions were denied in the last year alone. Those petitions asked what an abstract idea is or whether particular claims were eligible, questions requiring re-entry into the definitional thicket. This petition asks something structural and small: whether the two-step framework this Court prescribed must be applied as two steps, and whether a statutory presumption of validity survives contact with a motion to dismiss. Both can be answered without defining “abstract idea” or overruling anything. The nearest denial came in *Berkheimer* itself: HP’s petition, No. 18-415, asked whether step two’s conventionality inquiry is factual, and the United States recommended denial while the substantive standard remained unsettled.

This petition does not re-ask that question. Petitioner invoked *Berkheimer* below, and the claims were extinguished on the complaint anyway, showing the law was denied its intended effect. No prior petition has presented the first question through this Court’s

framework-integrity decisions. The fix resembles *Purkett* more than *Bilski*: a correction of method.

Nor is there anywhere else for the questions to go. The en banc court denied review here without opinion, even as its members pleaded for intervention. *Berkheimer v. HP Inc.*, 890 F.3d 1369, 1374 (Fed. Cir. 2018) (Lourie, J., concurring in denial of rehearing en banc) (“the law needs clarification by higher authority”). Congress has considered eligibility legislation for years without enacting any. Congressional Research Service, IF12563 (updated Jan. 16, 2026). The Patent Office examines under guidance that does not ask whether claims narrate “how,” 84 Fed. Reg. 50 (Jan. 7, 2019); the agency grants what the courts extinguish on the pleadings. The disclosure bargain at the heart of the system, *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 484 (1974), fails if the most complete disclosure an inventor can make, source code, cannot keep his case alive to discovery.

C. The record presents the questions cleanly

The questions were pressed and passed upon: petitioner argued below that the district court had overgeneralized the claims and that *Berkheimer*, *Aatrix*, and *i4i* barred resolution on the pleadings, C.A. Br. 5, 23; C.A. App. 170-172; the panel decided both points in a precedential opinion. See *United States v. Williams*, 504 U.S. 36, 41 (1992) (cert is precluded only when the question was “not pressed or passed upon below”). The case ended on the pleadings, so the record is the complaint and the patent: legal questions, no findings to unwind. The § 101 holding is the judgment’s only basis; Google’s alternative pleading argument, a claim-specific

dispute neither question presented touches, remains open on remand without obstructing review. Pet. App. 19a-20a n.1. The claim-construction ruling below was an alternative holding that obstructs review of neither question presented. The methodology challenged in the first question could not have been objected to before it appeared in the opinion; its components were preserved, overgeneralization at step one and an unsupported step two, and on rehearing petitioner challenged the opinion's use of the missing "how" as irreconcilable with *Contour IP*, presenting the specification's logic modules and code; the court declined without comment. C.A. Reh'g Pet. 1-2, 4-9, 11-13. And a claim properly presented is not limited to "the precise arguments... made below." *Yee v. City of Escondido*, 503 U.S. 519, 534 (1992). Nor is the record on the specification's disclosures an obstacle: the "discernible to a skilled artisan" holding is a determination about the intrinsic record; the figures were in the record; the patent before both courts describes and inventories the program listing appendix that is part of its specification, MPEP § 608.05(a); the figures were pressed on appeal, C.A. Br. 6-9, and the appendix was walked module by module on rehearing; and the prosecution history is the patent's public file, about which the opinion itself made a holding. Pet. App. 9a.

No cleaner record is coming. *B.E. Technology* arrives on summary judgment and cannot present the pleading stage; a dismissal on the complaint alone is as clean as records get.

D. At a minimum, the Court should call for the views of the Solicitor General

Since 2019, this Court has called for the views of the Solicitor General in five § 101 cases, and the United States recommended granting *American Axle*, *Interactive Wearables*, and *Tropp*. Its most recent submissions identified the two defects this petition presents: a “directed to” inquiry unmoored from any governing standard, and the migration of § 112’s disclosure concerns into § 101. If the Court is not prepared to grant outright, it should invite the Solicitor General’s views on whether the framework-integrity question supplies the narrow vehicle the United States has been asking for.

CONCLUSION

The petition for a writ of certiorari should be granted. If the Court prefers a narrower course, it may vacate and remand with instructions to apply the two steps of *Alice* as this Court has defined them. At a minimum, it should call for the views of the Solicitor General.

Respectfully submitted,

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