United States Court of Appeals for the Federal Circuit

YANBIN YU, ZHONGXUAN ZHANG,
Plaintiffs-Appellants

v.

APPLE INC.,
Defendant-Appellee

2020-1760

Appeal from the United States District Court for the Northern District of California in No. 3:18-cv-06181-JD, Judge James Donato.

YANBIN YU, ZHONGXUAN ZHANG,
Plaintiffs-Appellants

v.

SAMSUNG ELECTRONICS CO., LTD., SAMSUNG ELECTRONICS AMERICA, INC.,
Defendants-Appellees

2020-1803

Appeal from the United States District Court for the Northern District of California in No. 3:18-cv-06339-JD, Judge James Donato.

Decided: June 11, 2021

ROBERT G. LITTS, Dan Johnson Law Group, LLP, Burlingame, CA, argued for plaintiffs-appellants. Also represented by DANIEL JOHNSON, JR.

HEIDI LYN KEEFE, Cooley LLP, Palo Alto, CA, argued for all defendants-appellees. Defendant-appellee Apple Inc. also represented by DEEPA KANNAPPAN, LOWELL D. MEAD, PRIYA B. VISWANATH; PHILLIP EDWARD MORTON, Washington, DC.

DOUGLAS HALLWARD-DRIEMEIER, Ropes & Gray LLP, Washington, DC, for defendants-appellees Samsung Electronics Co., Ltd., Samsung Electronics America, Inc. Also represented by JAMES RICHARD BATCHELDER, DAVID S. CHUN, East Palo Alto, CA; STEVEN PEPE, New York, NY; SCOTT S. TAYLOR, Boston, MA.

Before NEWMAN, PROST*, and TARANTO, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* PROST.

Dissenting opinion filed by *Circuit Judge* NEWMAN.

PROST, *Circuit Judge*.

Yanbin Yu and Zhongxuan Zhang (collectively, "Yu") sued Apple and Samsung (collectively, "Defendants"),

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* Circuit Judge Sharon Prost vacated the position of Chief Judge on May 21, 2021.

alleging that Defendants infringed claims 1, 2, and 4 of U.S. Patent No. 6,611,289 ("the '289 patent"). The district court granted Defendants' motion to dismiss on the basis that the asserted claims were invalid under 35 U.S.C. § 101. Yu appeals. Because the district court did not err, we affirm.

BACKGROUND

The '289 patent is titled "Digital Cameras Using Multiple Sensors with Multiple Lenses." Claim 1 is representative[1] and recites:

> 1. An improved digital camera comprising:
>
> a first and a second image sensor closely positioned with respect to a common plane, said second image sensor sensitive to a full region of visible color spectrum;
>
> two lenses, each being mounted in front of one of said two image sensors;
>
> said first image sensor producing a first image and said second image sensor producing a second image;
>
> an analog-to-digital converting circuitry coupled to said first and said second image sensor and digitizing said first and said second intensity images to produce correspondingly a first digital image and a second digital image;

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[1] The district court treated claim 1 as representative for purposes of its eligibility analysis. Neither party disputes that treatment on appeal, and Yu does not separately argue the eligibility of dependent claims 2 or 4. We therefore treat claim 1 as representative for purposes of our eligibility analysis. *See Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1352 (Fed. Cir. 2016).

> an image memory, coupled to said analog-to-digital converting circuitry, for storing said first digital image and said second digital image; and
>
> a digital image processor, coupled to said image memory and receiving said first digital image and said second digital image, producing a resultant digital image from said first digital image enhanced with said second digital image.

Defendants filed a Rule 12(b)(6) motion to dismiss, which the district court granted with prejudice after concluding that each asserted claim was patent ineligible under § 101. The district court held that the asserted claims were directed to "the abstract idea of taking two pictures and using those pictures to enhance each other in some way." *Yu v. Apple Inc.*, Nos. 18-cv-6181, 18-cv-6339, 2020 WL 1429773, at *3 (N.D. Cal. Mar. 24, 2020) ("*District Court Opinion*"). The court explained that "photographers ha[ve] been using multiple pictures to enhance each other for over a century." *Id.* at *4. The district court further concluded that the asserted claims lack an inventive concept, noting "the complete absence of any facts showing that the[] [claimed] elements were not well-known, routine, and conventional." *Id.* at *6.

The district court entered judgment. Yu timely appealed. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

DISCUSSION

We review a district court's grant of a Rule 12(b)(6) motion under the law of the regional circuit. *Simio, LLC v. FlexSim Software Prods., Inc.*, 983 F.3d 1353, 1358 (Fed. Cir. 2020). Under Ninth Circuit law, we review such dismissals de novo, construing all allegations of material fact in the light most favorable to the nonmoving party. *Yagman v. Garcetti*, 852 F.3d 859, 863 (9th Cir. 2017). And we review de novo a district court's determination of patent

ineligibility under § 101. *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1257 (Fed. Cir. 2017).

In analyzing whether claims are patent eligible under § 101, we employ the two-step *Mayo*/*Alice* framework. *Alice Corp. v. CLS Bank Int'l*, 573 U.S. 208, 217 (2014); *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 70–73 (2012). First, we determine whether a patent claim is directed to an unpatentable law of nature, natural phenomenon, or abstract idea. *Alice*, 573 U.S. at 217. If so, we then determine whether the claim nonetheless includes an "inventive concept" sufficient to "'transform the nature of the claim' into a patent-eligible application." *Id.* (quoting *Mayo*, 566 U.S. at 72, 78).

I

We begin our analysis with step one. We agree with the district court that claim 1 is directed to the abstract idea of taking two pictures (which may be at different exposures) and using one picture to enhance the other in some way. *See District Court Opinion*, 2020 WL 1429773, at *3, *6.

"We have approached the Step 1 directed to inquiry by asking what the patent asserts to be the focus of the claimed advance over the prior art. In conducting that inquiry, we must focus on the language of the [a]sserted [c]laims themselves, considered in light of the specification." *TecSec, Inc. v. Adobe Inc.*, 978 F.3d 1278, 1292 (Fed. Cir. 2020) (cleaned up). Given the claim language and the specification, we conclude that claim 1 is "directed to a result or effect that itself is the abstract idea and merely invoke[s] generic processes and machinery" rather than "a specific means or method that improves the relevant technology." *Smart Sys. Innovations, LLC v. Chi. Transit Authority*, 873 F.3d 1364, 1371 (Fed. Cir. 2017).

At the outset, we note that claim 1 results in "producing a resultant digital image from said first digital image

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