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When is an *Alice* Challenge Ripe?

By Patrick T. Muffo

When defending against a software patent attack, litigants often address patent-eligibility by filing covered business method (CBM) reviews, moving to dismiss the lawsuit altogether, or waiting until summary judgment. Although not every court requires claim construction before invalidating a patent under §101, others tend to require clarity as to the meaning of the claims before deciding whether the claims are patent-eligible. The District of New Jersey went so far as to avoid deciding patent-eligibility because an unrelated case involving similar technology was on appeal to review issues of novelty and obviousness.

The case of *Synchronoss Technologies, Inc. v. Hyperlync Technologies, Inc.,* Civ. Act. No. 15-2845 (D. NJ March 7, 2016) involved a motion to dismiss under 12(b)(6) against a patent with claims covering synchronization and data backup technology. The parties disagreed as to the meaning of several claim terms and agreed that, like nearly all patent cases, claim construction would be necessary.

The court found the necessity of claim construction to preclude deciding the issue of patent-eligibility on the pleadings. Specifically, the court noted it "cannot address at this juncture whether every possible plausible construction of each of the claims asserted render the patent ineligible." (Internal quotations and citations omitted). Citing *Alice,* the court noted that the words of a claim determine patent-eligibility, so whether a claim passes muster under §101 necessarily requires an inquiry into what the claim means.

Turning to a recent *Inter Partes* Review (IPR) for a similar technology, the court pointed to the recent *Unified Patents v. Clouding IP* case that is now on appeal at the Federal Circuit. *Unified Patents* involves similar technology in the field of "synchronization of electronic data files through the insertion of a new segment of the current version of the file, wherein the new segment of the current version of the file is written into the update and the unchanged segment is excluded from the update." The court then cited the pendency of the IPR appeal in the unrelated *Unified Patents* case as a reason for avoiding the question of patent-eligibility in the instant case "This Court would be well-advised to follow the PTAB's expert lead by refraining from addressing this dispute without the benefit of further analysis."

Takeaway

The idea that a district court would avoid a §101 challenge without claim construction is nothing new. The dividing line here tends to be whether the parties' disputed constructions cross the line of patent-eligibility, i.e., would one construction render the claims patent-ineligible while the other construction saves the claims from such an attack? This court went a step farther without much explanation. The *Unified Patents* IPR has nothing to do with patent-eligibility (as IPRs do not involve such challenges) and the patents at issue are completely unrelated. At best, the general technology in the *Unified Patents* case is similar to the instant case such that a similar claim construction may apply for similar terms in both cases. But construing the terms of two unrelated patents the same is far from a given, and the reliance on the IPR is anything but conventional.

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