

## **Federal Circuit Affirms District Court Decision Invalidating Whitserve Patents Asserted Against Rothwell Figg Clients Donuts and Enom**

The Federal Circuit Court of Appeals affirmed the district court's dismissal of Whitserve LLC's infringement claims against Rothwell Figg clients Donuts Inc. and Enom, LLC. The Federal Circuit agreed with the district court that all of the asserted patent claims are invalid under 35 U.S.C. § 101 because they recite ineligible subject matter, resulting in a complete victory.

The Federal Circuit agreed with the district court that the claims of U.S. Patent Nos. 5,895,468 and 6,182,078 ("the Whitserve patents") were directed towards the abstract idea of "keeping track of deadlines for clients and carrying out two-way communications with clients relevant to meeting those deadlines, using computers and networks to do so." The court concluded that the claims merely used computers and a familiar network as a tool to perform a fundamental economic practice involving simple information exchange. The Federal Circuit rejected Whitserve's assertion that the claims recite an inventive concept and instead agreed with Defendants that the claims lack any improvement in off-the-shelf computers and only recite generic components. For that reason, the Federal Circuit found that nothing in the claims transforms the abstract idea into a patentable invention. The Federal Circuit also rejected Whitserve's argument that the district court's dismissal of its infringement claims was premature, holding that "patent eligibility can be determined at the Rule 12(b)(6) stage if there are no plausible factual allegations to impede such a resolution." The Federal Circuit agreed with Defendants that when the specification alone suffices to resolve the patent-eligibility inquiry, like in this case, resolution is appropriate at the pleading stage.

The ruling that the Whitserve patents are not patent eligible is particularly significant because Whitserve had successfully asserted these patents in earlier litigations against Computer Packages Inc. (resulting in a multi-million dollar damages award) and GoDaddy.com (resulting in a settlement for an undisclosed amount after GoDaddy's motion for summary judgment was denied).

### **Key Contacts**

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### **Related Areas of Practice**

Appellate Litigation

### **Technologies**

Software & Information Technology

All Defendants in this case were represented by Rothwell Figg attorneys Sharon Davis and Nicole DeAbrantes.

The cases are WhitServe LLC v. Donuts Inc., case number 19-2240, and WhitServe LLC v. Enom, LLC, case number 19-2241, in the U.S. Court of Appeals for the Federal Circuit.

The victory was covered by IP Law360. The article can be found [here](#).