

Pagination

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JAMES M. WICKS

**REPORT AND  
RECOMMENDATION**

**Majority Opinion** >

UNITED STATES DISTRICT COURT FOR THE  
EASTERN DISTRICT OF NEW YORK

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JOSEPH WIESEL, Plaintiff, -against- APPLE  
INC., Defendant.

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19-CV-7261 (JMA)(JMW)

April 21, 2025, Filed

April 21, 2025, Decided

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JAMES M. WICKS, United States Magistrate  
Judge.

**WICKS**, Magistrate Judge:

The Apple Watch<sup>1</sup> incorporates features that monitor and detect atrial fibrillation or "AFib"<sup>2</sup> and includes a notification feature indicating any irregular pulse detected.

<https://www.apple.com/newsroom/2018/12/ecg-app-and-irregular-heart-rhythm-notification-available-today-on-apple-watch/>.

According to Plaintiff, Apple has made this feature available on a series of Apple Watches since it was first released on Series 4 in 2018. (ECF No. 1, at ¶ 14.) Plaintiff, however, claims this feature is a willful violation of a patent he was issued in 2006, since "Apple has had indisputable actual knowledge of Dr. Weisel's '514 Patent." (ECF No. 1, at ¶ 20.)

In short, Plaintiff Joseph Wiesel ("Dr. Wiesel" or "Plaintiff") brings this action for Patent Infringement against Apple Inc. ("Apple" or "Defendant") pursuant to **35 U.S.C. § 271** for Defendant's alleged infringement of Dr. Wiesel's **U.S. Patent No. 7, 020,514** (the "514 Patent"). ( *See generally*, ECF No. 1.) Now before the Court, on referral from the Hon. Joan M. Azrack ( *see* Electronic Order dated December 4, 2024), is Defendant's motion to dismiss pursuant to Federal Rules of Civil Procedure ("FRCP") **12(b)(1)** and **12(b)(6)** ( *see* ECF Nos. 65, 67, 74)), which is opposed by Plaintiff. ( *See* ECF No. 66.) For the foregoing reasons, the undersigned

respectfully recommends that Defendant's Motion to Dismiss (ECF No. 65) be **GRANTED** in its entirety.

## **BACKGROUND**

### **I. Factual Background**

The following allegations are drawn from Plaintiff's complaint and documents integral to it; they are likewise assumed true for the purposes of the Motion to Dismiss. (See generally ECF Nos. 1, 68-7.) Dr. Wiesel ("Plaintiff") is a board-certified cardiologist and practitioner of over thirty years, having dedicated the past two decades to "inventing, researching, and experimenting with innovative approaches for monitoring and detecting atrial fibrillation ("AFib"). (ECF No.1, at ¶ 12.) In connection with these efforts, Dr. Wiesel was issued **U.S. Patent No. 7, 020,514** ("the '514 Patent") on March 28, 2006, entitled: "Method of and apparatus for detecting atrial fibrillation." ( *Id.* at ¶ 9.) This "innovative approach allowed patients to properly monitor atrial fibrillation in a non-hospital setting." ( *Id.* at ¶ 13.) As alleged, prior to Dr. Wiesel's patent, "patients could only use manual palpitation of the pulse" to detect AFib, which was both "rudimentary and prone to inaccuracy, especially as it was performed by patients at home or elsewhere and not by medical professionals." ( *Id.* ) Dr. Wiesel contends that his patent hinges upon the "long-term" and "at-home" [\*2] monitoring of the AFib condition which was, prior to his invention, "not an option for most people." (ECF No. 68-7, at 11.)

Specifically, Dr. Wiesel alleges that functions contained in Defendant's Apple Watch infringe on Plaintiff's '514 Patent. (ECF No. 1 at ¶¶ 34-

35.) Dr. Wiesel asserts that the Apple Watches provide "'irregular rhythm notifications' to help 'patients identify early warning signs.'" ( *Id.* at ¶ 34.) As alleged, Dr. Wiesel's "patented technology is a critical part of the Apple Watch and is used to drive customer demand." ( *Id.* at ¶ 35.) Defendant had knowledge of Plaintiff's patents because Dr. Wiesel sent initial notice letters on or around September 20, 2017. ( *Id.* at ¶ 20-21.) Despite, Dr. Wiesel's offering to negotiate in good faith, Apple refused and continued to sell its infringing products. ( *Id.* at ¶¶ 22-24.) Dr. Wiesel further notes that in 2018, Apple announced new features that now allowed the Apple Watch to monitor your heart rhythm and send notifications if there is an irregularity that seemed to be atrial fibrillation. ( *Id.* at ¶ 35.) Dr. Wiesel in essence is alleging that Apple is capitalizing off Plaintiff's patented technology by asserting that Defendant continues to highlight the atrial fibrillation detection feature on the watches. ( *Id.* at ¶¶ 43-44.) Thus, Dr. Wiesel claims that Defendant continues to infringe and disregard Plaintiff's patents. ( *Id.* at ¶¶ 24-25.)

### **A. The '514 Patent**

Each of the following claims, as alleged by Dr. Wiesel, are the basis of the infringement action against the Defendant Apple. As referenced in the complaint, the '514 Patent first describes "Independent claim 1," which "recites . . . a method of determining possible atrial fibrillation." (ECF No. 1, at ¶ 27); '514 patent col. 7 ll. 29-39. This method includes first the "step of detecting irregular pulse rhythms from a succession of time intervals," with "each succession of time intervals corresponding to a respective interval of time between successive pulse beats of a sequence of the pulse beats." ( *Id.* ) The method then "comprises" "analyzing the detected irregular

pulse rhythms" to determine a possible instance of Afib. ( *Id.* ) The final step of the method is to then "indicate" that possibility of Afib "from the determination." ( *Id.* ) What follows is a series of dependent claims.

The first dependent claim described, Dependent claim 7, further "recites the method" by "including detecting the irregular pulse rhythms by monitoring changes in light transmitted through a body appendage. . . ." (ECF No. 1, at ¶ 28.) Dependent claim 10 then involves an output of the detection of possible Afib "consisting of a printer, a display, an auditory signal generator and a vibration signal." ( *Id.* at ¶ 29.) Dependent claim 12 then describes the "apparatus for determining possible [Afib]": "a detector configured to detect irregular pulse rhythms" from a successive time interval, a "processor configured to analyze the detected irregular" which then "makes a determination of possible [Afib]," and finally "an indicator" which can alert the "possible [Afib] based on the detection." ( *Id.* at ¶ 30.)

The remaining three Dependent claims, 16, 17, and 18, further recite the "detector," the [\*3] "indicator" and the "processor," respectively. (ECF No. 1 at ¶¶ 31-33.) These claims, as described by the complaint, function in the same way as they are described above in the other Dependent claims.

### **B. The September Agreement**

Following successful patenting, in September of 2006 Dr. Wiesel entered into an exclusive license agreement with the Taiwanese medical device manufacturer, Microlife Corporation

("MLC"). (See Exhibit A, at ¶ 2.A) ("September Agreement"). This agreement granted to MLC "exclusive, worldwide, and perpetual use . . . to make, market, promote, use, distribute, [etc.]" the licensed AFib detection technology "made, developed, and reduced by Wiesel." ( *Id.* at ¶ 1.I.) Such licensed technology was agreed to be embodied in "Inventions, Know-How, Future Technology . . . and all reissues or extensions of any Patent and each and every Patent claim resulting from a reexamination certificate. . . ." (ECF No. 68-4, at ¶ 1.I.) The definition of patent, for the purposes of that section, was defined as the '514 Patent. (See Attachment to Exhibit A.) Per the September agreement, Wiesel was categorically prohibited from selling, transferring, or assigning "all or any portion of the Licensed Technology without the prior written consent of MLC." (ECF No. 68-4, at ¶ 2.D.) Additionally, the right to pursue patent infringement committed by third parties would first fall to MLC, and only upon MLC's not doing so, would Dr. Wiesel be able to prosecute claims of infringement. ( *Id.* at ¶ 6.D.) The agreement was silent as to which party, Dr. Wiesel or MLC, would be able to pursue an action for past damages resulting from infringement. (ECF No. 68-7, at 6; ECF No. 68-2, at 6.)

### **C. The December Agreement**

The September agreement remained alive until December 24, 2019, when both Dr. Wiesel and MLC mutually agreed to amend the exclusive license of the September Agreement. (See Exhibit B, Preamble) ("December Agreement"). In pertinent part, Dr. Wiesel retained "the sole right, without obligation, to enforce any rights arising from the Non-Exclusive Licensed Technology, including those related to third-party infringement..." and that "MLC shall not have the

right to enforce any rights arising from Non-Exclusive Licensed Technology." (ECF No. 68-5, at ¶ 23.) Dr. Wiesel would still be required to first seek the written consent of MLC before any sale, transfer, or assignment of "any portion" of the "Non-Exclusive Licensed Technology" could occur. ( *Id.* at ¶ 16.D.) "Non-Exclusive Licensed Technology" was now defined to mean the "atrial fibrillation and/or heart arrhythmia detection technology now owned or licensed . . . by Wiesel embodied in . . . Non-Exclusive Patents." ( *Id.* at ¶12. R.) As per the amended agreement, that "Non-Exclusive Licensed Technology" was the AFib detection technology contained in the '514 Patent. ( *Id.* at ¶ 6.)

Included within the December Agreement was now a "Right of First Negotiation Clause" not previously existing in the September Agreement. This clause required that if Dr. Wiesel was ever to grant license to a "Non-Exclusive Patent" to anyone other than MLC, MLC must first be given "90 days" to make "such a Non-Exclusive Patent a Patent" (ECF No. 68-5, at ¶ 17.) If no agreement could be reached, [\*4] only then would Dr. Wiesel be free to grant license to the third party. ( *Id.* ) Per the December Agreement, that reference to a "Non-Exclusive Patent" was Patent '514. ( *Id.* at ¶ 9.) So too was the agreement silent as to which party, Dr. Wiesel or MLC, had the right to sue for past damages. (ECF No. 68-10, at 3-4.)

As alleged in the complaint, Patent '514 has been properly maintained and is thus "valid and enforceable." (ECF No. 1, at ¶ 11.) The instant lawsuit was filed on December 27, 2019 (three days after the December Agreement was executed). (Plaintiff Motion in Opposition at p. 1.)<sup>3</sup> The lawsuit was then stayed pending an examination by the Patent Trial and Appeal

Board. (ECF No. 34.)

### **D. Hearings ("PTAB") Before the Patent Trial and Appeal Board**

Apple first sought *inter partes* review<sup>4</sup> of the '514 patent before the PTAB, a request that was ultimately denied. *See Apple Inc. v. Wiesel*, No. IPR2020-01540, at\*2 (P.T.A.B. Aug. 12, 2021). Apple then sought a request for rehearing of the denial of the *inter partes* review, again denied by the PTAB. *See id.* at \*3. In relevant part, the PTAB concluded that Apple failed to demonstrate "a reasonable likelihood that it would prevail with respect to at least one of the claims challenging" the validity of the '514 Patent. *Id.* at \*13-14. Upon some later examination of the '514 Patent by the United States Patent and Trademark Office ("USPTO"), the Examiner concluded that Dr. Wiesel did have certain unpatentable claims under **35 U.S.C. § 103(a)**.<sup>5</sup> *See Ex Parte Wiesel*, Appeal 2024-002643, at\*5-7 (P.T.A.B. Aug. 29, 2024).<sup>6</sup> Dr. Wiesel then sought *ex parte* review of those findings of fact. *See id.* Upon review, the PTAB agreed with Dr. Wiesel that the findings of unpatentability under **35 U.S.C. 103(a)** were "insufficiently articulated," thus reversing the finding that Dr. Wiesel's technology could not be patented. *See id.* at \*8-9.

### **II. Procedural History**

In March of 2020, Apple sought leave of court to file a motion to dismiss. (ECF No. 14.) That motion to dismiss was referred to Magistrate Judge Anne Y. Shields, who recused herself. (ECF No. 21.) The matter was then referred to

Magistrate Judge Steven I. Locke, who granted the motion for leave to file the motion to dismiss. (ECF No. 22.) Apple then filed the motion to dismiss (ECF Nos. 32, 33.) Following that submission, Apple sought to stay the entirety of the proceedings pending the *inter partes* review of the '514 Patent by the PTAB. (ECF. No. 34.) That motion was granted by Judge Locke. (ECF No. 35.) All motions before Judge Locke were then dismissed without prejudice. ( *Id.* )

This case was then reassigned to the undersigned. (See Electronic Order dated 5/13/2021.) Dr. Wiesel moved to terminate the stay of proceedings, which this Court granted. (ECF Nos. 42, 45.) Apple then sought another stay of the proceedings pending the *ex parte* review sought by Dr. Wiesel, which the Court granted. (ECF. Nos. 49, 52.) The parties then advised the Court on the outcome of the PTAB's *ex parte* review, which included that all of the Examiner's conclusions regarding the unpatentability of the '514 Patent were reversed. (See Electronic Order dated 10/08/2024.) Accordingly, this Court terminated the stay of proceedings. ( *Id.* ). A discovery schedule was then entered on October 29, 2024. **[\*5]** (ECF No. 59.) Subsequently, Apple sought for leave pending the re-filing of a "fully briefed" motion to dismiss. (ECF No. 63.) Judge Azrack granted that application and referred the motion to dismiss to the undersigned for a Report and Recommendation. (See Electronic Order dated 11/22/2024.)

Apple's motion to dismiss, pursuant to both **12(b)(1)** and **12(b)(6)**, was then filed (ECF No. 65), with Dr. Wiesel filing opposition (ECF No. 66), and Apple filing its reply (ECF No. 67). A joint motion for leave to file documents under seal, entered on December 4th, was then granted after review by this Court. (ECF No. 68;

see Electronic Order dated 12/05/2024). In light of those filings, Apple motioned for leave in order to supplement its Motion to Dismiss "to address new case law presented by the Plaintiff in its opposition brief." (See Electronic Order dated 12/26/2024.) This Court granted the motion, and Apple then timely filed that supplemental brief. (ECF No. 74.) The parties appeared for oral argument on the motion to dismiss on April 17, 2025. (ECF No. 78.)<sup>7</sup>

### **III. The Parties' Contentions**

#### **A. Defendant's Motion to Dismiss**

Apple's motion is two-pronged: *first*, that Dr. Wiesel lacks "prudential" standing to maintain this action in light of the December Agreement with MLC, and *second*, that even if he does have standing, he does not have a valid patent to enforce. (ECF No. 65 at 1.)

As to the *first prong*, Apple asserts that Dr. Wiesel lacks prudential standing to bring an action for the alleged infringement of the '514 Patent. (ECF No. 65, at 1.) That is due, as Apple contends, to the transfer of rights that has occurred as a part of both the Exclusive and Non-Exclusive License agreements that Dr. Wiesel entered into with MLC. Those agreements, Apple avers, transferred "all substantial rights" of the '514 Patent from Dr. Wiesel (*i.e.*, the patentee) to MLC (*i.e.*, the licensee). (ECF No. 65, at 5.) Without those substantial rights then, Dr. Wiesel is not the holder of title such that he can enforce the patent without joining MLC.



Even though the December Agreement provided Dr. Wiesel with the "sole right" to enforce the '514 Patent, (ECF No. 68-5, at ¶ 23), this did not result in "a return conveyance of all substantial rights." (ECF No. 65, at 8.) Those "substantial rights" Apple contends, include the "the right to restrict the transfer or assignment of the '514 Patent, the right to consent and approve third party licenses of the '514 Patent, and the continues right to make, use, sell, and sublicense products under the '514 Patent." ( *Id.* at 8-9.)<sup>8</sup> That bundle of rights, having remained with MLC, means according to Apple, that MLC has become a necessary party for Dr. Wiesel to have standing. Without MLC's presence, therefore, Dr. Wiesel does not on his own have all the "substantial rights" to his patent such that he can bring a suit for infringement on his own. ( *Id.* )

Apple further argues that MLC is a necessary party under **Fed. R. Civ. P. 19(a)**, but that joinder is not feasible under **19(a)(2)** "because this Court does not have jurisdiction over Microlife and Apple will be unable to compel Microlife to respond to the discovery it propounds." (ECF No. 65, at 9.) As Apple argues, the fact that Taiwan is not a signatory to the Hague Service **[\*6]** Convention means "there is no other international treaty of agreement that allows for service of an order or summons in a Taiwanese company." (ECF No. 68-2, at 9 n.7.) The only way MLC can join the present action, Apple alleges, is voluntarily. ( *Id.* at 9-10.) Without them, Apple contends the present action and the issues of the '514 Patent cannot be fully resolved in a single proceeding, such that dismissal ought to occur until those defects are cured. (ECF No. 68-2, at 9-10.)

As to the *second prong*, Apple submits that even if Dr. Wiesel does satisfy prudential standing, the

'514 Patent attempts to "patent the unpatentable" under **35 U.S.C. § 101**.<sup>9</sup> Apple submits that this analysis is controlled by the two-step test articulated by the Supreme Court in *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, **573 U.S. 208** (2014). First, the court asks whether the claims sought to be patented are directed at an "abstract idea" or "fundamental law of nature." *Alice*, **573 U.S. at 217**. Then, even if the patent fails the first step, it must also be the case that there is no "inventive concept—*i.e.*, 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." *Id.* at **217-18** (internal quotations omitted).

Apple asserts that the '514 Patent captures a "basic, abstract idea that medical practitioners have employed for decades . . . ." (ECF No. 65, at 13.) Furthermore, Apple argues the '514 Patent "[does] not recite any technical improvement." ( *Id.* at 15.) Too generic is the apparatus, they say, because the '514 Patent only describes a "'detector, 'processor' and 'indicator' without any greater specification." (ECF No. 65., at 15.) "[W]ell-known components [combined] to carry out an abstract function" are, as Apple contends, patent ineligible. ( *Id.* at 16.) Not just is the '514 Patent aimed at an abstract idea, contends Apple, but so too does it attempt to patent a "fundamental law of nature." (ECF No. 65, at 16.) As alleged, the "Asserted Claims [for patentability] are not directed at any new or improved technique" for detecting AFib, and "do nothing more than observe natural phenomenon . . . ." ( *Id.* ) That further necessitates, as Apple alleges, a finding of unpatentability.

Even if these claims are ineligible, Apple argues further that the claims of the '514 Patent lack "an inventive concept," even though a combined

reading of the abstract claims could make an otherwise unpatentable idea patentable. As Apple alleges, "all of the claims of the '514 Patent fail to recite any particularized, new way of carrying out the abstract idea." (ECF No. 65, at 18.) The lack of novelty controls the analysis, as the claims provide no "specific algorithm . . ." for "detecting, analyzing, or indicating," nor "teach any advancement in an abstract idea." ( *Id.* at 17-18.) Rather, Apple views the claims of the '514 Patent as merely reciting photoplethysmography (i.e., monitoring changes in light transmitted through a body appendage of an individual), as prior art "known at the time of the patent." ( *Id.* at 18.) As characterized in Apple's motion to dismiss, this "mere recitation" of prior art lacks an inventive concept, therefore failing the second step of the *Alice/Mayo* [\*7] test described below.

Apple cautions that a finding of patentability would "preempt future innovation" and lead to infringement of Dr. Wiesel's patent every time "every known medical device used by medical practitioners to detect [AFib]." (ECF No. 65, at 19.) Apple characterizes Dr. Wiesel's complaint as "admit[ting] as much, [as the complaint] states that practitioners previously used 'manual palpitation of the pulse to detect [AFib].'" (ECF No. 68-2, at 19.) This, as Apple sees it, is fatal to the claims asserted by Dr. Wiesel as being patent eligible under § 101.

## **B. Plaintiff's Response in Opposition**

Dr. Wiesel urges this Court first to conclude that he has "prudential" standing, and separately that the '514 Patent is a valid one, sufficient to withstand the Motion to Dismiss. Dr. Wiesel first

asserts that he has prudential standing as the patentee of the '514 Patent. As Plaintiff sees it, "there [appears] to be no cases" requiring the joinder of a licensee (i.e., MLC) "when a patentee brings suit." (ECF No. 68-7, at 5.) That is key, as Wiesel asserts, because neither the "right of first negation clause" nor the "silence as to past damages" render MLC an exclusive licensee even after having been named a non-exclusive one, per the December agreement. ( *Id.* at 5-6.) Instead, Dr. Wiesel asks this Court to consider the "totality of the agreement," which leaves him without any encumbrance to enforce the '514 Patent, as him satisfying prudential standing. ( *Id.* at 7-8.) Dr. Wiesel contends too that joinder, if deemed necessary by this Court, remains feasible by judicial compulsion under [Fed. R. Civ. P. 19\(a\)\(2\)](#) and [4\(h\)\(2\)](#).

As a threshold matter, Plaintiff asserts that recent case law from the Federal Circuit (dubbed "the trio" of *Berkheimer*, *Aatrix*, and *Cellspin*) read in light of *Alice*, command that "motions to dismiss on the affirmative defense of patent ineligibility should be extremely rare." (ECF No. 68-7, at 15.) While eligibility ultimately remains a question of law, whether something is "well understood, routine, and conventional to a skilled artisan at the time of the patent is a factual determination" to be left to a jury. ( *Id.* at 14.)

This brings the Plaintiff's argument to the disagreement about the alleged factual characterization by Apple of the '514 Patent. Rather than simply stating an abstract idea, the very innovation is the detection and analyzing of "pulse time intervals"—as opposed to traditional pulse palpitation—as a means to detect and monitor episodes of AFib. (ECF No. 68-7, at 18.) Moreover, Wiesel contends that his innovation was not "practiced prior to his invention by

anyone" nor that it is simply a "basic diagnostic technique," therefore satisfying the second prong of *Alice*. (ECF No. 68-7, at 24.) The "commercially available devices measure the number of pulse beats over a preset period . . . but these devices neither analyze nor determine the presence of AFib." ( *Id.* at 25-26.) Therefore, given these "plausible and specific factual allegations," as Plaintiff argues, that should be enough to satisfy the threshold of overcoming the motion to dismiss. ( *Id.* at 26.)

### **C. Defendant's Reply and Sur Reply**

Apple maintains in its Reply that Dr. Wiesel fails [\*8] to satisfy prudential standing to bring an infringement action of the '514 Patent. MLC, according to Apple's interpretation of the December agreement, "has at least two . . . substantial rights—the right to consent to assignment . . . and the right to approve settlements—making it a necessary party" to the action. (ECF No. 68-10, at 3.) Apple urges in its reply that the silence in the agreement as to the right to sue for past damages is a concession on the part of Dr. Wiesel that such right remained with MLC even after the December agreement was enacted.<sup>11</sup> ( *Id.* ) Moreover, Apple further alleges that the December agreement requires that Dr. Wiesel first seek the consent of MLC before he "transfers or assigns the '514 Patent . . ." ( *Id.* at 4.) The obligation to join MLC as a necessary party, so contends Apple, thus lies with the Plaintiff. ( *Id.* at 5.) And, as Dr. Wiesel has asked for leave to amend the complaint should the motion to dismiss be granted, this further suggests according to Apple that "Microlife should have been joined from the start" as a necessary party." ( *Id.* ) *Au fond*, Apple reiterates that given the rights which have either

expressly been granted, or that the agreement is silent to, MLC is a necessary party so as to satisfy prudential standing. ( *Id.* )

Apple maintains that patent-eligibility is a matter of law that can be, and often is, decided at the motion to dismiss stage under [§ 101](#). ( *Id.* at 6.) Apple maintains that subsequent "extrinsic technical explanation" is "nowhere to be found in the claims or specifications of the '514 Patent;" rather that they only appear in Dr. Wiesel's reply brief. ( *Id.* at 5.) Moreover, as a matter of law, Apple reaffirms its argument that "when there are no factual allegations, that taken as true, prevent resolving the eligibility question," it remains proper for the district court to, as a matter of law, resolve the [§ 101](#) question in a motion to dismiss. ( *Id.* at 7.)

Apple relies upon the Federal Circuit's decision in *CardioNet, LLC v. InfoBionic, Inc.*, in which that court held "that claims—directed at a nearly identical abstract idea of collection, analyzing, and displaying cardiac data for determining atrial fibrillation—were ineligible for patent protection under [Section 101](#)." (ECF No. 68-10 at 8) (citing [816 F App'x 471, 475-77](#) (Fed. Cir. 2020)). Moreover, these "generic claims" coupled with "conventional components" and "conventional computing devices" could not therefore contain an inventive concept. ( *Id.* ) "The same conclusion," Apple avers, "applies to the claims of the '514 Patent here." ( *Id.* ) Thus, Apple argues, the Federal Circuit's decision "serves to confirm" that "the claims of the '514 Patent are directed at patent illegible subject matter." ( *Id.* at 10.)

Plaintiff's case law surrounding motions to dismiss resolving [Section 101](#) claims actually cut in favor of Apple, not Dr. Wiesel, according to



Apple: "[Indeed], in three of the cases [cited by Plaintiff]—*Mobile*, *Hawk*, and *Simio*—the Federal Circuit affirmed the district court's grant of a [Rule 12](#) motion to dismiss under [Section 101](#)." ( *Id.* ) More to the point, those decisions (now cited by both parties affirmatively) were based on the determination that the "claims recite a fundamentally [\*9] abstract idea at Step 1 of the *Alice* inquiry." ( *Id.* ) In short, Apple once more urges this Court to reject Plaintiff's characterization of Federal Circuit precedent and hold the '514 Patent ineligible as a matter of law under [35 U.S.C. § 101](#).

## **MOTION TO DISMISS: THE LEGAL FRAMEWORK**

When presented with both a motion under [12\(b\)\(1\)](#) to dismiss for lack of subject matter jurisdiction and a motion under [Rule 12\(b\)\(6\)](#) to dismiss for failure to state a claim upon which relief can be granted, the first issue is whether the Court has the subject matter jurisdiction necessary to consider the merits of the action." *Zapotocky v. CIT Bank, N.A.*, [587 B.R. 589, 592](#) (S.D.N.Y. 2018). To prevail against a motion to dismiss for lack of subject matter jurisdiction under [12\(b\)\(1\)](#), the "plaintiff bears the burden of proving the Court's jurisdiction by a preponderance of the evidence." *Makarova v. United States*, [201 F.3d 110, 113](#) (2d Cir. 2000) (citing [Fed. R. Civ. P. 12\(b\)\(1\)](#) ) ("A case is properly dismissed for lack of subject matter jurisdiction under [Rule 12\(b\)\(1\)](#) when the district court lacks the statutory or constitutional power to adjudicate it."). Relevant here, "[a] motion to dismiss for lack of Article III standing challenges the subject-matter jurisdiction of a federal court and, accordingly, is properly brought under [Fed. R. Civ. P. 12\(b\)\(1\)](#)." *SM Kids, LLC v. Google LLC*, [963 F.3d 206, 210](#) (2d Cir. 2020). In

considering such a motion, the Court generally "must accept the material factual allegations in the complaint as true[.]" however, it is *not* required to "draw all reasonable inferences in the plaintiff's favor." *Zapotocky*, [587 B.R. at 592](#).

To survive a motion to dismiss under [Rule 12\(b\)\(6\)](#), a complaint must plead "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, [550 U.S. 544, 570](#) (2007). A claim is facially plausible "when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Ashcroft v. Iqbal*, [556 U.S. 662, 678](#) (2009). A complaint is properly dismissed where, as a matter of law, "the allegations in a complaint, however true, could not raise a claim of entitlement to relief." *Twombly*, [550 U.S. at 558](#). When considering a motion to dismiss under [12\(b\)\(6\)](#), the Court must assume all well-pleaded facts to be true, "drawing all reasonable inferences in favor of the plaintiff." *Koch v. Christie's Int'l PLC*, [699 F.3d 141, 145](#) (2d Cir. 2012). However, this tenet does not apply to legal conclusions or "threadbare recitals of a cause of action's elements." *Ashcroft v. Iqbal*, [556 U.S. at 663](#). Pleadings that offer only "labels and conclusions" or "a formulaic recitation of the elements of a cause of action will not do." *Twombly*, [550 U.S. at 555](#). More is required.

Having viewed the pleadings and filings in the most favorable light of Plaintiff, the undersigned concludes that: (i) Plaintiff lacks "prudential" standing, and (ii) even if the Court disagrees with the undersigned and concludes that Dr. Wiesel indeed has "prudential" standing, his claim nonetheless fails on the merits because the '514 Patent classifies as patent ineligible subject matter under [35 U.S.C. § 101](#). Therefore, based

upon these findings, it is respectfully recommended that Defendant's Motion to Dismiss pursuant to [12\(b\)\(1\)](#) and [12\(b\)\(6\)](#) be granted in its entirety.

## DISCUSSION

### I. Does Plaintiff Standing? [\*10] have Prudential

Article III of the Constitution "confines the federal judicial power to the resolution of 'Cases' and 'Controversies.'" *TransUnion LLC v. Ramirez*, [141 S. Ct. 2190, 2203](#) (2021) (" *TransUnion* ") (quoting *Raines v. Byrd*, [521 U.S. 811, 819-20](#) (1997)). The essence or "core component of standing is an essential and unchanging part of the case-or-controversy requirement of Article III." *Lujan v. Defenders of Wildlife*, [504 U.S. 555, 560](#) (1992). That is, standing is precisely "what it takes to make a justiciable case." *Steel Co. v. Citizens for a Better Env't*, [523 U.S. 83, 102](#) (1998). Standing is derived from that limitation and rooted in the "idea of separation of powers." *Allen v. Wright*, [468 U.S. 737, 752](#) (1984).

The judicial power derived from Article III "exists only to redress or otherwise to protect against injury to the complaining party." *Warth v. Seldin*, [422 U.S. 490, 499](#) (1975). The "irreducible constitutional minimum of standing" has three elements. *Spokeo, Inc. v. Robins*, [578 U.S. 330, 338](#) (2016). Intervenor bears the burden of proving each element of standing: (i) "that [the plaintiff] suffered an injury in fact that is concrete, particularized, and actual or imminent; (ii) that the injury was likely caused by the defendant; and (iii) that the injury would likely be redressed by judicial relief." *TransUnion*, [141 S. Ct. at 2203](#) (citing *Lujan*, [504 U.S. at 560-561](#) ); *Tummino*,

[260 F.R.D. at 30-31](#). "To establish injury in fact, a plaintiff must show that he or she suffered 'an invasion of a legally protected interest' that is 'concrete and particularized' and 'actual or imminent, not conjectural or hypothetical.'" *Spokeo*, [578 U. S. at 339](#) (quoting *Lujan*, [504 U.S. at 560](#) ). A "particularized" injury "must affect the plaintiff in a personal and individual way." *Lujan*, [504 U.S. at 560 n.1](#).

"Although past injuries may provide a basis for standing to seek money damages, they do not confer standing to seek injunctive relief unless the plaintiff can demonstrate that [she] is likely to be harmed again in the future in a similar way." *Nicosia v. Amazon.com, Inc.*, [834 F.3d 220, 239](#) (2d Cir. 2016). "Plaintiffs lack standing to pursue injunctive relief where they are unable to establish a 'real or immediate threat' of injury." *Id.* (quoting *City of Los Angeles v. Lyons*, [461 U.S. 95, 111-12](#) (1983)).

In every federal action, the threshold requirement of standing must first be satisfied. See *Sicom Systems, Ltd. V. Agilent Technologies, Inc.*, [427 F.3d 971, 975](#) (Fed. Cir. 2005) (citing *Pfizer, Inc. v. Elan Pharm. Research Corp.*, [812 F. Supp. 1352, 1356](#) (D. Del. Feb. 4, 1993)). The burden of establishing standing lies with the party bringing the action for infringement.<sup>12</sup> See *Id.* at [976](#).

Civil actions for patent infringement can be brought by the "patentee." [35 U.S.C. § 281](#). The "patentee" is defined by statute as the party to whom the initial patent was issued and also the successors in title to that same patent. [35 U.S.C. § 100\(d\)](#); *Abbott Labs. v. Diamedix Corp.*, [47 F.3d 1128, 1130](#) (Fed. Cir. 1995). In certain circumstances, a transfer of "all substantial rights" by the patent owner "is tantamount to an

assignment of those patents to the exclusive licensee, conferring standing to sue solely on the licensee." *Alfred E. Mann Found. For Sci. Rsch. v. Cochlear Corp.*, **604 F.3d 1354, 1358-59** (Fed. Cir. 2010) [hereinafter "*Mann Foundation*"] (citing *Vaupel Textilmaschinen KG v. Meccanica Euro Italia Spa*, **944 F.2d 870, 873-74** (Fed. Cir. 1991)); *Diamond Coating Technologies, LLC v. Hyundai Motor America*, **823 F.3d 615, 618** (Fed. Cir. 2016) ("An assignment of patent rights operates to transfer title to [\*11] the patent, while a license leaves title in the patent owner and transfers something less than full title and rights.") (internal quotation omitted).

Parties that do not hold title have been accorded "prudential" standing in only a limited set of circumstances. *AssymetRx, Inc. v. Biocare Medical, LLC*, **582 F.3d 1314, 1318** (Fed. Cir. 2009). To satisfy "prudential" standing when one is not the patentee, the typical pathway is for the exclusive licensee to "join the patent owner in an action brought against an accused infringer." *Propat Int'l Corp. v. Rpost, Inc.*, **473 F.3d 1187, 1193** (Fed. Cir. 2007). A nonexclusive license, by contrast "confers no constitutional standing on the licensee to bring suit or even to join a suit with the patentee because a nonexclusive licensee suffers no legal injury from infringement." *Morrow v. Microsoft Corp.*, **499 F.3d 1332, 1341** (Fed. Cir. 2007) (quoting *Sicom*, **427 F.3d at 976**). A non-exclusive licensee is consequently faced with insufficient Article III standing that "cannot be cured by adding the patent title owner to the suit." *Id.* (citing *Propat*, **437 F.3d at 1189**); *Intellectual Prop. Dev., Inc. v. TCI Cablevision of Cal., Inc.*, **248 F.3d 1333, 1345** (Fed. Cir. 2001).

"[I]n determining whether a party holds the exclusionary rights, we determine the substance

of the rights conferred on that party, not to the characterization of those rights as exclusive licenses or otherwise. . . . For instance, an exclusive licensee who actually holds all substantial rights may sue in its own name alone for patent infringement." *Morrow*, **499 F.3d at 1340 n.7** (Fed. Cir. 2007) (internal citation omitted); *Textile Productions, Inc. v. Mead Corp.*, **134 F.3d 1481, 1484** (Fed. Cir. 1998) ("[W]hat matters [then] . . . is the substance of the arrangement.") The Federal Circuit has explained that two rights in particular, the right of enforcement and the right of alienation, come to the forefront of the analysis to determine whether that has been a virtual assignment of the patent by the original patentee.

The first "substantial" right to consider when assessing whether de facto assignment of title has occurred—as opposed to a grant of exclusive or non-exclusive license—is "the nature and scope of the licensor's retained right to sue accused infringers." *Mann Foundation*, **604 F.3d at 1361**. When the licensor retains such a right, this "often preclude[s]. . . [a] finding that all substantial rights were transferred to the licensee." *Id.* But the right to enforce the patent could nevertheless be rendered "illusory . . . by the licensee's ability to settle licensor-initiated litigation by granting royalty-free sublicenses to the accused infringers." *Id.*; *Speedplay, Inc. v. Bebob, Inc.*, **211 F.3d 1245, 1251** (Fed. Cir. 2000).

All that being said the Federal Circuit has disapproved of the sole transfer of the right to sue in the form of a "hunting license." *Lone Star Silicon Innovations LLC v. Nanya Technology Corporation*, **925 F.3d 1225, 1233** (Fed. Cir. 2019) (citing *Crown Die & Tool Co. v. Nye Tool & Mach. Works*, **261 U.S. 24, 40** (1923)). In the

context of patent suits, the "hunting license" conferred to a mere licensee "in the form of a *pro forma* exclusive license" a grant of only the right to sue, nothing more. *Id.* Without joining the proper owner of the patent, the suit for infringement cannot proceed for lack of prudential standing. *Id.*

Second, the Federal Circuit [\*12] has explained that in addition to the right to bring suit, the right to alienate the patent is critical in determining whether a virtual assignment has occurred. See *Enhanced Sec. Rsch., LLC v. Juniper Networks, Inc.*, C.A. No. 09-871-JJF, [2010 BL 163855], 2010 WL 2898298, at \*4 (D. Del. July 20, 2010) ("[T]he Federal Circuit has looked to whether the grantor retains the right to make and use the patented product, . . . as well as the ability to freely grant sublicenses to other parties...." (citing *Abbott Labs.*, 47 F.3d at 1132)). "Whether a party may . . . assign its interests in the patents, and enter into contracts without reservation are also relevant considerations." *Id.* (citing *Sicom*, 427 F.3d at 979-80).<sup>13</sup> The general rule, then, is that "one seeking to recover money damages for infringement . . . must have had *legal title* to the patent *during the time of the infringement*." *Arachnid Inc. v. Merit Industries, Inc.*, 939 F.2d 1574, 1579 & n.7 (Fed. Cir. 1991) (emphasis in original) (internal citation omitted). The present agreement is governed by New York Law (Exhibit 8, ¶ 11), and thus: "[I]t is a well-established principle of New York contract law that a contract should not be interpreted to produce a result that is absurd, commercially unreasonable, or contrary to the reasonable expectations of the parties." *Coscarelli v. ESquared Hosp. LLC*, 364 F. Supp. 3d 207, 225 (S.D.N.Y. 2019) (alterations and internal quotation marks omitted).

Here, the Court looks to the totality of the agreement to determine the rights retained both by MLC and by Dr. Wiesel. *Lone Star*, 925 F.3d at 1231 (assessing the "totality" of the agreement); *AsymmetRx*, 582 F.3d at 1321 ("[W]hile any [individual]. . . restriction[ ] alone might not have been destructive of the transfer of all substantial rights, their totality is sufficient to do so."). The most recent agreement, the December Agreement, granted to Dr. Wiesel "the sole right, without obligation, to enforce any rights arising from the Non-Exclusive Licensed Technology, including those related to third-party infringement . . ." and that "MLC shall not have the right to enforce any rights arising from Non-Exclusive Licensed Technology." (ECF No. 68-5, at ¶ 23.) The right to sue appears on its face to be fully vested in Dr. Wiesel alone.

On the one hand, this could be enough to confer "prudential" standing. See *Sicom*, 427 F.3d at 979 ("[A]n important substantial right is the exclusive right to sue for patent infringement."); *Mann Foundation*, 604 F.3d at 1361 ("[I]f the licensor retains the right to enforce, this often preclude[s]. . . [a] finding that all substantial rights were transferred to the licensee."). However, the *Lone Star* court emphasized that this analysis must also focus on who retains the right of alienation. *Lone Star*, 925 F.3d at 1230 ("In considering this question, we have often focused on two salient rights: enforcement and alienation.") (citing *Intellectual Prop. Dev.*, 248 F.3d at 1336 (concluding that a transferee that possessed the exclusive right to file suit still did not possess all substantial rights)).

Per the December Agreement, Dr. Wiesel would be required to first seek the written consent of MLC before any sale, transfer, or assignment of "any portion" of the "Non-Exclusive Licensed



Technology" could occur. (ECF No. 68-5, at ¶ 16.D.) Additionally, Dr. Wiesel agreed to be bound by a "Right of First Negotiation Clause," not previously present [\*13] in the September Agreement. This clause required that before any non-exclusive license could be granted by Dr. Wiesel to a third party, MLC must first be given "90 days" to make "such a Non-Exclusive Patent a Patent" ( *Id.* at ¶ 17.) Only upon no agreement being reached could Dr. Wiesel then be free to grant such non-exclusive license. ( *Id.* )

Under the December Agreement then, despite the grant of a "non-exclusive license," Dr. Wiesel's right of alienation to the '514 Patent is materially limited by MLC's retained control over that alienation. Regarding the substance of the agreement, Dr. Wiesel cannot sell, transfer, assign, or license any portion of the '514 Patent to any third party without the written consent of MLC. (ECF No. 68-5 at, ¶¶ 14, 17); *Lone Star*, **925 F.3d at 1233** (explaining that a requirement of consent prior to alienation "will always control how the patents are asserted"); *Propat*, **473 F.3d at 1191** ("The right to dispose of an asset is an important incident of ownership, and such a restriction on that right is a strong indicator that the agreement does not grant [the transferee] all substantial rights under the patent."); *Sicom*, **427 F.3d at 979** (noting that the lower court's finding of the restriction on alienation was a "fatal" reservation of rights by the transferor).

The December Agreement grants to Dr. Wiesel, in effect, only the right to pursue litigation against alleged third-party infringers. *Cf. Diamond Coating*, **823 F.3d at 619** ("[A] 'licensor's retention of a limited right to develop and market the patented invention indicates that the licensee failed to acquire all substantial rights.'" (quoting *Fieldturf, Inc. v. Sw. Recreational Indus., Inc.*,

**357 F.3d 1266, 1269** (Fed. Cir. 2004)). That substantively amounts to the so-called "hunting license" in which the only right he has truly retained is the ability to pursue, absent any consent requirement of MLC, litigation against third-party infringers. This being a particularly disfavored practice, the Federal Circuit has already cautioned that "prudential" standing should not be conferred on that basis alone so as to not unduly produce "multiple litigations against the same defendant by multiple plaintiffs." *Lone Star*, **925 F.3d at 1233** (citing *Prima Tek II*, **222 F.3d at 1381** (Fed. Cir. 2000) ("[A] 'right to sue' clause cannot confer standing on a bare licensee. . . . To hold otherwise would allow a patent owner to effectively grant a 'hunting license,' solely for the purpose of litigation, in the form of a *pro forma* exclusive license. . . . The Supreme Court long ago disapproved of such arrangements.")).

Given the deficit in "substantial rights" held by Dr. Wiesel, he asks that MLC be joined under **Fed. R. Civ. P. 19(a)**, and that service be effectuated upon MLC by invoking **Rule 4(h)**. Based upon the factual allegations in the complaint, at this juncture there appears no reason, contrary to the assertions of Apple, that such joinder cannot be effectuated. *In toto*, considering the rights retained and those transferred under the December Agreement, the undersigned respectfully submits that Dr. Wiesel lacks prudential standing, and that his suit be dismissed without prejudice.

**II. Plaintiff's  
Patent  
Infringement  
Claim Otherwise**

**Fails on the  
Merits**

Even if the court disagrees with the [\*14]



undersigned and instead concludes that Dr. Wiesel has prudential standing, that does not resolve the issue whether, under **35 U.S.C. § 101**, Plaintiff as a matter of law has a patent eligible "method for determining possible atrial fibrillation."

In the context of a motion to dismiss regarding the affirmative defense of patent ineligible subject material under **§ 101**, "patent eligibility can be determined at the **Rule 12(b)(6)** stage . . . only when there are no [plausible] factual allegations that ... preclude dismiss[al]." *Aatrix Software, Inc. v. Green Shades Software, Inc.*, **882 F.3d 1121, 1125** (Fed. Cir. 2018). "If there are claim construction disputes, . . . the court [may] proceed by adopting the non-moving party's construction," and construing the patent claims in a manner most favorable to the non-moving party. *Aatrix Software*, **882 F.3d at 1125**; *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, **776 F.3d 1343, 1349** (Fed. Cir. 2014) (court applies the non-moving party's construction of the terms of the patent for purposes of the motion); *Berkheimer v. HP, Inc.*, **881 F.3d 1360, 1368** (Fed. Cir. 2018) ("Patent eligibility has in many cases been resolved on motions to dismiss . . .").

**Section 101 of the Patent Act** defines the subject matter for eligibility as: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." **35 U.S.C. § 101**. The Supreme Court "has long held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable." *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, **573 U.S. 208**

, **216** (2014).

To discern then whether the subject matter at issue is ineligible under **§ 101** turns on a two-step analysis developed by the Supreme Court known as the *Alice/Mayo* framework.<sup>14</sup> See *Alice*, **573 U.S. at 217** and *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, **566 U.S. 66, 70-73** (2012).

First, it must be determined "whether the claims at issue are directed to one of those patent-ineligible concepts," i.e., laws of nature, natural phenomena, and abstract ideas. See *Alice*, **573 U.S. at 217**; *Mobile Acuity Ltd. v. Blippar Ltd.*, **110 F.4th 1280, 1289** (Fed. Cir. 2024) (same). "Among other things, [the court] examine[s] what the patent asserts to be the focus of the claimed advance over the prior art." *Solutran, Inc. v. Elavon, Inc.*, **931 F.3d 1161, 1168** (Fed. Cir. 2019). Put another way, the claims are considered "in their entirety to ascertain whether their character as a whole is directed to excluded subject matter." *McRO, Inc. v. Bandai Namco Games Am. Inc.*, **837 F.3d 1299, 1312** (Fed. Cir. 2016). Step one of *Alice/Mayo* also considers "the language of the asserted claims, considered in light of the specification." *Yu v. Apple*, **1 F.4th 1040, 1043** (Fed. Cir. 2021). "The specification [can be] helpful in illuminating what, [in fact], a claim is directed to." *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, **935 F.3d 1341, 1346** (Fed. Cir. 2019).

If the *Alice/Mayo* step one is not satisfied because a patent ineligible abstract concept has been identified, the court then turns to step two. This has been described "as a search for an 'inventive concept'—i.e., 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 [\*15] concept] itself." *Alice*, **573 U.S. at 217-18** (internal quotations omitted); *Hawk Tech. Sys. v. Castle Retail*, **60 F.4th 1349, 1358** (Fed. Cir. 2023) (same). Two important cautions on this analysis have been highlighted by both the Supreme Court and the Federal Circuit.

First, "[p]henomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work." *Gottschalk v. Benson*, **409 U.S. 63, 67** (1972). "[M]onopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it." *Mayo*, **566 U.S. at 71**.

Second, the Supreme Court has simultaneously recognized that too broad an interpretation of this exclusionary principle could eviscerate patent law. "[A]ll inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas." Thus, in particular, the *Diehr* court highlighted that "a process is not unpatentable simply because it contains a law of nature or a mathematical algorithm." *Diamond v. Dieher*, **450 U.S. 175, 187** (1981) (quoting *Parker v. Flook*, **437 U.S. 584, 590** (1978)). It added that "an application of a law of nature . . . to a known structure or process may well be deserving of patent protection." *Mayo*, **566 U.S. at 71** (citing *Diehr*, **450 U.S. at 187**) (emphasis in original); *Endo Pharms. Inc. v. Teva Pharms. USA, Inc.*, **919 F.3d 1347, 1352-53** (Fed. Cir. 2019) ("[A]ll inventions at some level embody, use, reflect, rest upon, or apply laws of nature, natural phenomena, or abstract ideas.").

If the claims are directed to a patent-eligible

concept, the claims satisfy **§ 101** then the inquiry ends; no need to proceed to step two of *Alice/Mayo* (i.e., the "search for an inventive concept"). See *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, **880 F.3d 1356, 1361** (Fed. Cir. 2018) (citing *Visual Memory LLC v. NVIDIA Corp.*, **867 F.3d 1253, 1262** (Fed. Cir. 2017)). It is the burden of the party asserting the affirmative defense of ineligibility to establish the patents invalidity under **§ 101**, as duly issued patents are presumed valid by statute. See **35 U.S.C. § 282**.

15

### A. *Alice/Mayo* Step One

The finds the *CardioNet* duo of decisions particularly instructive here, which guides the analysis that follows. See *CardioNet, LLC v. InfoBionic*, **955 F.3d 1358** (Fed. Cir. 2020) ("*CardioNet I*") and *Cardio Net, LLC v. InfoBionic*, **816 Fed. App'x 471** (Fed. Cir. 2020) ("*CardioNet II*"). Both decisions warrant close examination.

#### 1. *CardioNet I*

In *CardioNet I*, the Federal Circuit held that a patent directed to an "improved cardiac monitoring device," was subject matter eligible under **§ 101**. See *CardioNet I*, **955 F.3d at 1368**. The Court there found that the device was one that claimed to detect "beat-to-beat timing of cardiac activity, detect[] premature ventricular beats, and determine[] the relevance of the beat-to-beat timing to atrial fibrillation or atrial flutter, taking into account the variability in the beat-to-beat timing caused by premature ventricular beats identified by the device's ventricular beat detector." *Id.* This was recognized by the Federal Circuit as a means that "improves cardiac monitoring technology" because the device could effectively avoid detecting both false positives

and false negatives with respect to atrial fibrillation or atrial flutter, as well as "sustained episodes" of either condition. *Id.* at 1368-69. [\*16] Moreover, each of the dependent claims in dispute were held to be "directed to patent-eligible subject matter" because they narrowed "the device's specific technical features or operations." *Id.* at 1369. Since the Federal Circuit concluded that the patent survived *Alice/ Mayo* step one, the claims were therefore eligible under § 101, and no further analysis was required. See *id.* at 1371.

2. CardioNet II

In *CardioNet II*, a challenge was brought as to the validity of two patents which purported to "describe systems and methods 'for presenting information relating to heart data.'" *CardioNet*, 816 Fed. App'x at 472. Specifically, the patents at issue described the method as "a monitoring system" that "collects heart rate data and analyzes the data to identify arrhythmia events." *Id.* With both data collected by the "processor" and by a human technician, "[i]f the data [were] determined to be valid, the processing system [would then] display[] a graph that includes heart rate data as well as "atrial fibrillation burden, which refer[ed] to the overall amount of time that a patient is in atrial fibrillation (or arrhythmia) over a specified time period." *Id.*

The Federal Circuit concluded these patents survived neither step of *Alice/ Mayo* . At the first step, the claims of "collecting, analyzing, and displaying data" were held to be "abstract concepts." *CardioNet II*, 816 F. App'x at 475. Even though "some of the claims" were "couched as systems . . . they essentially recite[d] . . . collecting, analyzing, and displaying data by conventional means." *Id.* The claims at issue

were not directed to any "specific methods for identifying cardiac events" nor "[specific methods for] determining correlation between machine and human identified events;" simply that these processes are done. *Id.* The Federal Circuit found this to be nothing more than "generic data analysis." *Id.* And, even though displaying that data might have been "very useful to physicians . . . usefulness alone does not necessarily negate abstractness." *Id.* at 476.

Toward this end, Apple did a side-by-side analysis of the claims here with those asserted in *CardioNet II*.<sup>16</sup> (ECF No. 78.)

<i>CardioNet II</i> 's Patent Claim	Dr. Wiesel's '514 Patent Claim
12. An article comprising a machine-readable medium embodying information indicative of instructions that when performed by one or more machines result in operations comprising:	12. An apparatus for determining possible atrial fibrillation, compromising:
Identifying atrial fibrillation events in physiological data obtained for a living being, wherein identifying atrial fibrillation events comprises examining the	A detector configured to detect irregular pulse rhythms from a succession of time pulse rhythms from a succession of time

physiological data in multiple time intervals, and identifying intervals in	intervals each corresponding to a respective interval of time between	using a common time scale,	
which at least one atrial fibrillation event has occurred;	respective interval of time between	information regarding the heart rate data for the multiple time intervals during	An indicator configured to indicate the
	successive pulse beats of a sequence of	a defined time period in alignment with indications of atrial fibrillation	possible atrial fibrillation based on the
Obtaining heart rate data for the living being;	the pulse beats;	activity for the identified intervals, according to the identified atrial	determination.
Receiving a human assessment of a subset [*17] of the identified atrial fibrillation	A processor configured to analyze the	fibrillation events, during the defined time period such that heart rate trend is	
events; and	detected irregular pulse rhythms for	presented with atrial fibrillation burden, wherein pictographically presenting	
	making a determination of possible atrial	information regarding the heart rate data comprises displaying for each of the	
Based on the human assessment of the subset of the identified atrial fibrillation events, pictographically presenting, using a common time scale,	fibrillation; and	multiple time intervals a range of heart rates and a heart rate average.	
fibrillation events, pictographically presenting,			

3. The '514 Patent at Issue

In the present case, the '514 Patent appears closer in principle to the ineligible patents at issue in *CardioNet II*, rather than the patent

eligible subject matter in *CardioNet I*. Dr. Wiesel maintains that the '514 Patent recites a method that goes beyond the abstract and represents an actual improvement over the prior art of Afib detection. On the other hand, Apple asserts first that the '514 Patent goes to ineligible subject matter, i.e. abstract ideas, which as a matter of law removes patentability under [§ 101](#).

The '514 Patent recites in Independent claim 1:

A method of determining possible atrial fibrillation . . . comprising the steps of:

- (a) detecting irregular pulse rhythms from a succession of time intervals each corresponding to a respective interval of time between successive pulse beats of a sequence of pulse beats;
- (b) analyzing the detected irregular pulse rhythms to make a determination of possible atrial fibrillation; and
- (c) indicating the possible atrial fibrillation from the determination.

'514 patent col. 7 ll. 29-39.

Dependent claim 7 then recites the method by "including detecting the irregular pulse rhythms by monitoring changes in light transmitted through a body appendage. . . ." '514 patent col. 7 ll. 58-61. Dependent claim 10 includes the limitation that an output of the detection of possible Afib consists of "a printer, a display, an auditory signal generator and a vibration signal."

'514 patent col. 8 ll. 1-5. Dependent claim 12 then describes the "apparatus for determining possible [Afib]": "a detector configured to detect irregular pulse rhythms" from a successive time interval, a "processor configured to analyze the detected irregular" which then "makes a determination of possible [Afib]," and finally "an indicator" which can alert the "possible [Afib] based on the detection." '514 patent col. 8 ll. 15-23.

The final dependent claims in contention, claims 16-18, recite the following, respectively: the detector that is configured to **[\*18]** "detect irregular pulse rhythms . . . by monitoring changes in the light transmitted through a body appendage," the "indicator" with its output display, a printer, and an "auditory signal generator and a vibrational signal," and the "processor including at least one of a microprocessor, an ASIC circuit, a programmable logic array (PLA) and a reduced instruction set chip (RISC)." '514 patent col. 8 ll. 36-49.

These recited claims in the '514 Patent are strikingly similar to those asserted in *CardioNet II*. The claims of the '514 Patent merely "recite and are directed to collection, analyzing, and displaying data by conventional means." *CardioNet II*, **816 F. App'x at 475**. Looking to "the language of the asserted claims, considered in light of the specification," *Yu*, **1 F.4th at 1043**, the claims of the '514 Patent go to "quintessential abstract concepts—not any particular technology for performing those functions." *Id.* The method of Independent claim 1, after "detecting irregular pulse rhythms," is to then analyze, without greater specificity, the pulse rhythms to "make a determination of possible atrial fibrillation" and subsequently



indicates that determination. '514 patent col. 7 ll. 29-39. That indication is then displayed via printer, and includes both auditory and vibrational signal generators. '514 patent col. 8 ll. 1-5. Again, all that is described is that these processes happen, not necessarily by any particular means with specificity that could then "narrow" the device to patent eligible subject matter. *Cf. CardioNet I*, [955 F.3d at 1369, 1371](#) ("[The written description of the [patent] confirms that the asserted claims are directed to a specific technological improvement—an improved medical device that achieves speedier, more accurate, and clinically significant detection of two specific medical conditions out of a host of possible heart conditions.").

The abstractness of the '514 Patent is just like the patent at issue in *CardioNet II*, which similarly described the method of its independent claim as collecting, analyzing, and displaying physiological data. *See CardioNet II*, [816 F. App'x at 473-74](#). There, because of that recitation in the patent, the Federal Circuit reiterated that "[d]isplaying data by conventional methods as a part of a series of abstract steps is itself an abstract concept." *Id.* Consequently, such abstractness is patent-illegible under [§ 101](#). *See Elec. Power Grp., LLC v. Alstom S.A.*, [830 F.3d 1350, 1354](#) (Fed. Cir. 2016) ("[W]e have recognized that merely presenting the results of abstract processes of collecting and analyzing information, without more (such as identifying a particular tool for presentation), is abstract as an ancillary part of such collection and analysis."). Moreover, "[Federal Circuit] precedent is clear. . . . [M]erely adding computer functionality to increase the speed or efficiency of the process does not confer patent eligibility on an otherwise abstract idea." *CardioNet I*, [955 F.3d 1358, 1375](#) (Dyk, Circuit Judge, concurring in part and

concurring in the result) (quoting *Intellectual Ventures, LLC v. Capital One Bank (USA)*, [792 F.3d 1363, 1370](#) (Fed. Cir. 2015)). The same is true of the '514 Patent, which only provides for a method of "detecting . . . analyzing . . . [and] displaying data." '514 [\*19] patent col. 7 ll. 29-39.

Accordingly, the undersigned respectfully submits that the '514 Patent fails the first step of *Alice/Mayo*, for its claims are directed at the abstract processes of detecting, analyzing, determining, and indicating data. Thus, the Court proceeds to step two.

## B. *Alice/Mayo* Step Two

The second part of the analysis under *Alice/Mayo* is whether the abstract ideas amount to, in their totality, to an inventive concept. *See Alice*, [573 U.S. at 217-18](#) (describing step two as the search for an "inventive" concept) (internal quotations omitted); *Hawk Tech. Sys.* [60 F.4th at 1358](#) ("At *Alice* step two, we consider the claim elements—individually and as an ordered combination—to assess whether [they] transform the nature of the claim into a patent-eligible application of the abstract idea."). For the reasons that follow, the undersigned concludes that the abstract ideas set forth in the claims advanced do not.

Dr. Wiesel principally argues that the '514 Patent, because it involves both the detection of irregular pulse rhythms between "successive pulse beats," taken in conjunction with the dependent claims of 7, 10, and 16-18 (the displaying of the detected data on a printer that has both auditory and visual alerts) amount to an inventive concept, therefore patent eligible under [§ 101](#). (ECF No. 1 at 8-11.) On the other hand,

Apple maintains that the claims "provide no specific algorithm or other alleged novel way of 'detecting, analyzing, or indicating' the data collected.<sup>17</sup> (ECF No. 68-2, at 17.) Again, much like the patent at issue in *CardioNet II*, the '514 Patent fails the *Alice/ Mayo* step two for similar reasons.

The '514 Patent describes that means by which the pulse is measured (i.e., the "detecting" phase) involve "monitoring the changes in light transmitted through a body appendage of the individual." '514 patent col. 7 ll. 58-60. This effectively describes the art of photoplethysmography<sup>18</sup>, which according to the background of the '514 Patent, was known at the time the patent's issuance.<sup>19</sup> See ECF No. 65-6 at 4.

Moreover, Dependent claims 17 and 18 respectively recite the technology used to display the physiological data, as "a printer, a display, an auditory signal generator, a vibrational signal generator . . . and a processor." ' 514 Patent col. 8 ll. 39-49. That is the extent to which these dependent claims are described. When the abstract dependent claims are "so result-focused, so functional, as to effectively cover any solution to an identified problem," the Federal Circuit has frequently held these to be invalid inventive concepts under the *Alice/Mayo* step two. See *Affinity Labs*, **838 F.3d at 1264-65** ("[R]ecitation of generic computer components [and] . . . limitations does not make an otherwise ineligible claim patent-eligible." (quoting *Mortgage Grader, Inc. v. First Choice Loan Services, Inc.*, **811 F.3d 1314, 1324-25** (Fed. Cir. 2016))).

Compare this to the language of the patent in *CardioNet I*, in which the dependent claims in

that case recited a device that: used "*variability determination logic* . . . to identify the relevance of the variability using a non-linear function" and that the beat detector contained a "QRS detector"<sup>20</sup> and that the data collected is then weighted as **[\*20]** being "negatively indicative of one of the atrial fibrillation and atrial flutter." *CardioNet I*, **955 F.3d at 1355-56** (emphasis added). It is not simply the plain text of the patent was technically written, but that the dependent claims went to processes which "would have been difficult to fathom" that doctors could presently perform manually. See *id. at 1371*. Cf. *Accenture Global Services, GmbH v. Guidewire Software, Inc.*, **728 F.3d 1336, 1345** (Fed. Cir. 2013) ("[T]he complexity of the implementing software or the level of detail in the specification does not transform a claim reciting only an abstract concept into a patent-eligible system or method. . . . The system claims themselves only contain generalized . . . components arranged to implement an abstract concept on a computer."); *ChargePoint, Inc. v. SemaConnect, Inc.*, **920 F.3d 759, 769** (Fed. Cir. 2019) (holding the same). Rather, those dependent claims in *CardioNet I* were conclusively "directed to a specific technological improvement . . . [which] achieves speedier, more accurate, and clinically significant detection of two specific medical conditions out of a host of possible heart conditions." *Id. at 1370*. In other words, an inventive concept.

In stark contrast, the dependent claims recited in the '514 Patent translate more to the patent at issue in *CardioNet II*, which the Federal Circuit invalidated as failing to recite an inventive concept. "While some claims [were] cast as systems . . . they are implemented on generic 'monitoring systems,' 'monitoring stations,' and 'processing systems.... Ultimately, the claims

[depended] on methods that [could] be performed on any general-purpose computer device without reciting or requiring any nonconventional components or characteristics." *CardioNet II*, **816 F. App'x at 476**. That proved fatal to the *CardioNet II* patent, and so too proves fatal for the '514 Patent at issue herein. This is true even in light of the new metric, measuring "irregular pulse rhythms from a succession of time intervals corresponding to a respective interval of time between a successive pulse beat of a sequence of the pulse beats." (ECF. No 68-8, at 24); ' 514 Patent col. 7 ll. 30-35. Even if this is true, much like the Federal Circuit held in *CardioNet II*, "it is at most a mathematical computation performed on a general-purpose computing device, which could otherwise be 'performed by a human, mentally or with pen and paper.'" *Id.* at 477 (quoting *Intellectual Ventures*, **838 F.3d at 1318** ). The '514 Patent recites only a series of claims that involve "detecting", "processing," "indicating," and "analyzing" the physiological data collected by the apparatus described therein. '514 Patent col.s 7 ll. 29-39; 8 ll. 15-24.

*In toto*, based upon application of the *CardioNet* precedents, the undersigned respectfully recommends dismissal since the claims underlying the '514 Patent fail to articulate an inventive concept thus rendered patent illegible under **§ 101**.

## CONCLUSION

For the foregoing reasons, the undersigned respectfully recommends that Defendant's Motion to Dismiss pursuant to **12(b)(1)** and **12(b)(6)** (ECF No. 65) be **GRANTED**.

## OBJECTIONS

A copy of this Report and Recommendation is being electronically served on Counsel. Any written **[\*21]** objections to this Report and Recommendation must be filed with the Clerk of the Court within fourteen (14) days of service of this Report. **28 U.S.C. § 636(b)(1)** (2006 & Supp. V 2011); **Fed. R. Civ. P. 6(a), 72(b)**. Any requests for an extension of time for filing objections must be directed to the district judge assigned to this action prior to the expiration of the fourteen (14) day period for filing objections. Failure to file objections within fourteen (14) days will preclude further review of this Report and Recommendation either by the District Court or the Court of Appeals. *Thomas v. Arn*, **474 U.S. 140, 145** (1985) ("a party shall file objections with the district court or else waive right to appeal"); *Caidor v. Onondaga Cnty.*, **517 F.3d 601, 604** (2d Cir. 2008) ("failure to object timely to a magistrate's report operates as a waiver of any further judicial review of the magistrate's decision"); see *Monroe v. Hyundai of Manhattan & Westchester*, **372 F. App'x 147, 147-48** (2d Cir. 2010) (summary order) (same).

Dated: Central Islip, New York

April 21, 2025

**RESPECTFULLY RECOMMENDED,**

/s/ James M. Wicks

JAMES M. WICKS

United States Magistrate Judge

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Manufactured and sold by Defendant Apple, Inc. See <https://support.apple.com/en-us/108375>.

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AFib is the "most common" type of irregular heart rhythm, where if not regulated can lead to complications such as heart failure or stroke. See <https://www.heart.org/en/health-topics/atrial-fibrillation/what-is-atrial-fibrillation-afib-or-af>. During AFib, the upper chambers of the heart (called the atria) beat out of sync and irregularly with the lower heart chambers or ventricles. See <https://www.mayoclinic.org/diseases-conditions/atrial-fibrillation/symptoms-causes/syc-20350624>.

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Initial notice of potential patent infringement was served on Apple "on or about September 20, 2017," two years prior to the December Agreement and the commencing of the instant lawsuit. (ECF No. 1 at ¶ 20.)

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*Inter partes* review is a trial held before the PTAB, where the patentability of one or more claims is reviewed.

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In pertinent part, **§ 103(a) of the Patent Act** states: "A patent for a claimed invention may not be obtained, notwithstanding that the

claimed invention is not identically disclosed as set forth in **section 102**, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains." **35 U.S.C. § 103(a)**.

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As will be shown in the procedural history, this *ex parte* review came three years after the case was reopened. (ECF. No. 52.)

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The Court expresses its appreciation to counsel for the quality and professionalism of the briefs and arguments.

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However, **Fed. R. Civ. P. 4(f)(2) and (3)** provide: "[I]f there is no internationally agreed means, or if an international agreement allows but does not specify other means, by a method that is reasonably calculated to give notice: (A) as prescribed by the foreign country's law for service in that country in an action in its courts of general jurisdiction; (B) as the foreign authority directs in response to a letter rogatory *or letter of request*; or (C) unless prohibited by the foreign country's law, by: (i) delivering a copy of the summons and of the complaint to the individual personally; or (ii) using any form of mail that the clerk

addresses and sends to the individual and that requires a signed receipt; or (3) by other means not prohibited by international agreement, as the court orders." **Fed. R. Civ. P. 4(f)(2), (3)**. And, **Fed. R. Civ. P. 4(h)(2)** applies that text to a foreign corporation. See **Fed. R. Civ. P. 4(h)(2)** (permitting service upon a foreign corporation "[. . .] in any manner prescribed by **Rule 4(f)** for serving an individual, except personal delivery under **(f)(2)(C)(i)**").

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**§ 101** states: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title." **35 U.S.C. § 101**.

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"Prior Art" loosely meaning "all that was publicly available" prior to the claim of a novel invention. [https://www.law.cornell.edu/wex/prior\\_art](https://www.law.cornell.edu/wex/prior_art).

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Assuming arguendo that such a right remained with MLC, the parties conceded at oral argument that the statute of limitations for past damages would expire at the end of this year. The undersigned noted on the record that even if MLC were to bring a claim for past damages, the parties could in effect address

this in a settlement agreement, which the parties acknowledged. (ECF No. 78.)

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Plaintiff at oral argument contends that both constitutional and statutory standing has been satisfied. (ECF No. 78.) As Counsel stated, Plaintiff clearly has an injury to meet Article III standing and the Patent Act provides Plaintiff with standing. Plaintiff cites *Lexmark Intern., Inc. v. Static Control Components, Inc.*, for the proposition that if you have constitutional standing and a statute provides you with standing, then the inquiry ends there. **572 U.S. 118** (2014). *Lexmark* discusses that in order to have statutory standing you must: 1) be within the zone of interests that the statute intends to protect, and 2) the defendant's conduct must have proximately caused your injury. *Id.* at **129-133**. For the reasons discussed below, even if Plaintiff meets these general propositions of standing, the Federal Circuit's case law after *Lexmark* clarifies who may sue for patent infringement, and outlines de-facto assignments and hunting license exceptions, which ultimately hinders Plaintiff's standing argument.

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In addition, the Federal Circuit has taken care to explain that there is no "complete list of the rights. . .to determine whether the licensor has transferred away sufficient rights to render an exclusive licensee the owner of a patent." *Mann Foundation*, **604 F.3d at 1360**. A non-exhaustive list of rights, which in their totality may amount to a "substantial" transfer



include:

(1) transfer of the exclusive right to make, use, and sell products or services under the patent..., (2) the scope of the licensee's right to sublicense, (3) the nature of license provisions regarding the reversion of rights to the licensor following breaches of the license agreement, (4) the right of the licensor to receive a portion of the recovery in infringement suits brought by the licensee, (5) the duration of the license rights granted to the licensee, (6) the ability of the licensor to supervise and control the licensee's activities, (7) the obligation of the licensor to continue paying patent maintenance fees, and (8) the nature of any limits on the licensee's right to assign its interests in the patent.

*Id.* at 1360-61 (collecting cases).

even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity." [35 USC § 282](#)

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Apple contends that this case is not only similar to *CardioNet II*, but in fact should be considered "CardioNet III" as the Patent here is so abstract and conventional so as to render it patent ineligible. (ECF No. 78.)

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In response to this particular argument Plaintiff at oral argument noted that Dependent Claim 2 has specific algorithm that detects irregularities making '514 Patent an inventive concept. (ECF No. 78.) As Apple correctly points out, Plaintiff has not pled or included claim 2 in its Complaint (ECF No. 1), and this is the first time that claim 2 is addressed. ( *Id.* ) In response, Plaintiff asserted that claim 2 may and would be added following additional discovery. ( *Id.* ) However, nowhere in the Complaint is there a claim 2 asserted.

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John Allen, Photoplethysmography and Its Application in Clinical Physiological Measurement, *Physiol Meas.*, Feb. 2007, at 28.

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During oral argument, both parties conceded that the undersigned must view the issue of ineligibility under the *Alice/Mayo* framework. (ECF No. 78.) Specifically, the parties agree that step one of the analysis is a matter of law, where step two is a mixed question of law and fact. ( *Id.* )

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"A patent shall be presumed valid. Each claim of a patent—whether in independent, dependent, or multiple dependent form—shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid

And, both parties cite to the Braunwald Textbook on Cardiovascular Medicine, which, if nothing else, describes the examination technique of how to characterize an ECG that is displaying pulse waves potentially indicative of Afib. See ECF No. 65-6.






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"The QRS complex is a combination of three



of the graphic deflection seen on a typical ECG (electrocardiogram)." *A QRS Detection and R Point Recognition Method for Wearable Single-Lead ECG Devices*, Nat'L Institute Of Health <https://pmc.ncbi.nlm.nih.gov/articles/PMC5621148/>  
#:~:text=For%20a%20remote%20electrocardiogram%20(ECG, of%20the%20ECG%20analysis%20algorithm (last visited Mar. 13, 2025 ).

Case Analysis ( 0 case )

Case Analysis Summary		
	Positive	0
	Distinguished	0
	Caution	0
	Superseded	0
	Negative	0
Total		0

No Treatments Found

Direct History

Direct History Summary		
	Caution	0
	Negative	0
Total		0

1. 

Wiesel v. Apple Inc, No. 19-CV-7261 (JMA)(JMW), 2025 BL 136018 (E.D.N.Y. Apr. 21, 2025)

report submitted

## General Information

<b>Case Name</b>	Wiesel v. Apple Inc
<b>Court</b>	U.S. District Court for the Eastern District of New York
<b>Date Filed</b>	Mon Apr 21 00:00:00 EDT 2025
<b>Judge(s)</b>	JAMES M. WICKS
<b>Parties</b>	JOSEPH WIESEL, Plaintiff, -against- APPLE INC., Defendant.
<b>Topic(s)</b>	Civil Procedure; Patent Law; Technology Law