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**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA**

BRIGHTEX BIO-PHOTONICS, LLC,

Plaintiff,

v.

L'OREAL USA, INC.,

Defendant.

Case No. 3:24-cv-07919-JCS

**DEFENDANT L'OREAL USA, INC.'S
NOTICE OF MOTION AND MOTION
TO DISMISS UNDER FED. R. CIV. P.
12(b)(6)**

Date: March 5, 2025
Time: 9:30 a.m.
Location: Zoom
Judge: Hon. Joseph C. Spero

TABLE OF CONTENTS

NOTICE OF MOTION AND MOTION	iv
RELIEF SOUGHT	iv
MEMORANDUM OF POINTS AND AUTHORITIES	1
I. INTRODUCTION	1
II. RELEVANT FACTS	2
A. Overview of the Asserted Claims of the '358 Patent	2
B. Prosecution History of the Asserted Claims Regarding § 101	5
III. LEGAL STANDARDS.....	10
A. Courts Often Dismiss Patent Infringement Claims Under Rule 12(b)(6) As Directed to Patent Ineligible Subject Matter	10
B. Claims Directed to Implementing Abstract Ideas on a Computer are Not Patent Eligible Under 35 U.S.C. § 101	11
IV. THE ASSERTED CLAIMS ARE NOT PATENT ELIGIBLE	12
A. Claim 16 is Directed to the Abstract Idea of Recommending Treatments Based on the Severity of a Person’s Skin Characteristics (<i>Alice</i> Step One)	12
B. Claim 16 Does Not Recite an “Inventive Concept” (<i>Alice</i> Step Two)	17
C. Dependent Claim 18 Does Not Add Any “Inventive Concept”	19
V. CONCLUSION	19

TABLE OF AUTHORITIES

CASES

<i>Alice Corp. Pty. Ltd. v. CLS Bank Int’l</i> , 573 U.S. 208 (2014)	1, 11, 12, 17, 18
<i>Ashcroft v. Iqbal</i> , 556 U.S. 662 (2009)	10
<i>Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC</i> , 827 F.3d 1341 (Fed. Cir. 2016)	12
<i>Bastidas v. Good Samaritan Hosp. LP</i> , 774 F. App’x 361 (9th Cir. 2019)	10
<i>Bell Atl. Corp. v. Twombly</i> , 550 U.S. 544 (2007)	10
<i>Bilski v. Kappos</i> , 561 U.S. 593 (2010)	12
<i>BSG Tech LLC v. Buyseasons, Inc.</i> , 899 F.3d 1281 (Fed. Cir. 2018)	12
<i>Chamberlain Grp., Inc. v. Techtronic Indus., Co.</i> , 935 F.3d 1341 (Fed. Cir. 2019)	13
<i>Credit Acceptance Corp. v. Westlake Servs.</i> , 859 F.3d 1044 (Fed. Cir. 2017)	13, 17
<i>Customea Techs., LLC v. Dish Network Corp.</i> , 951 F.3d 1359 (Fed. Cir. 2020)	11
<i>Cybergenetics Corp. v. Inst. of Env’t Sci. & Rsch.</i> , 490 F. Supp. 3d 1237 (N.D. Ohio 2020)	16
<i>DDR Holdings, LLC v. Hotels.com, L.P.</i> , 773 F.3d 1245 (Fed. Cir. 2014)	13
<i>Dental Monitoring SAS v. Align Tech., Inc.</i> , No. C-22-07335-WHA, 2024 WL 2261931 (N.D. Cal. May 16, 2024)	2, 14, 15, 18
<i>Diamond v. Diehr</i> , 450 U.S. 175 (1981)	11
<i>Elec. Commc’n Techs., LLC v. ShoppersChoice.com, LLC</i> , 958 F.3d 1178 (Fed. Cir. 2020)	10

1	<i>Elec. Power Grp., LLC v. Alstom S.A.</i> ,	
2	830 F.3d 1350 (Fed. Cir. 2016).....	passim
3	<i>FairWarning IP, LLC v. Iatric Sys., Inc.</i> ,	
4	839 F.3d 1089 (Fed. Cir. 2016).....	16
5	<i>Finjan, Inc. v. Blue Coat Sys., Inc.</i> ,	
6	879 F.3d 1299 (Fed. Cir. 2018).....	11
7	<i>Glasswall Sols. Ltd. v. Clearswift Ltd.</i> ,	
8	754 F. App'x 996 (Fed. Cir. 2018)	10
9	<i>In re Brown</i> ,	
10	645 Fed. App'x 1014 (Fed. Cir. 2016).....	17
11	<i>In re TLI Commc'ns LLC Patent Litig.</i> ,	
12	823 F.3d 607 (Fed. Cir. 2016).....	12
13	<i>Interval Licensing LLC v. AOL, Inc.</i> ,	
14	896 F.3d 1335 (Fed. Cir. 2018).....	10
15	<i>Procter & Gamble Co. v. QuantifiCare Inc.</i> ,	
16	288 F. Supp. 3d 1002 (N.D. Cal. 2017)	passim
17	<i>SAP Am. Inc. v. InvestPic, LLC</i> ,	
18	898 F.3d 1161 (Fed. Cir. 2018).....	10
19	<i>Secured Mail Sols. LLC v. Universal Wilde, Inc.</i> ,	
20	873 F.3d 905 (Fed. Cir. 2017).....	10
21	<i>Ultramercial, Inc. v. Hulu, LLC</i> ,	
22	772 F.3d 709 (Fed. Cir. 2014).....	12
23	STATUTES	
24	35 U.S.C. § 101	passim
25	RULES	
26	Federal Rule of Civil Procedure 12(b)(6)	10

NOTICE OF MOTION AND MOTION

PLEASE TAKE NOTICE that Defendant L’Oreal USA, Inc. (“L’Oreal”) hereby moves to dismiss Plaintiff Brightex Bio-Photonics, LLC’s (“BTBP”) claim of infringement of U.S. Patent No. 9,842,358 (“the ’358 Patent”) pursuant to Federal Rule of Civil Procedure 12(b)(6), and seeks a hearing on the Motion on March 5, 2025, at 9:30 a.m., or as soon thereafter as it may be heard by the Honorable Joseph C. Spero via Zoom. L’Oreal’s Motion is based on this Notice of Motion and Motion, the following Memorandum of Points and Authorities, the declaration of Jessica J. Delacenserie filed herewith, the pleadings and papers on file, and such other materials and oral arguments as the Court may permit. Specifically, Plaintiff fails to state a claim of infringement of the ’358 Patent upon which relief can be granted because all asserted claims of the ’358 Patent are invalid under 35 U.S.C. § 101. As explained below, the asserted claims are directed to a patent-ineligible abstract idea without an inventive concept.

RELIEF SOUGHT

Pursuant to Fed. R. Civ. P. 12(b)(6), L’Oreal respectfully requests that the Court dismiss Plaintiff’s First Claim for Relief (Infringement of the ’358 Patent) because every asserted claim of the ’358 Patent is directed to nothing more than an abstract idea and, thus, invalid under 35 U.S.C. § 101.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Abstract ideas are categorically ineligible for patent protection, and any patent claiming an abstract idea without an “inventive concept” is invalid as a matter of law under 35 U.S.C. § 101. But this is exactly what the ’358 Patent claims. The asserted claims of the ’358 Patent are directed to nothing more than the abstract idea of recommending treatments based on the severity of a person’s skin “characteristics,” *e.g.*, wrinkles—something dermatologists and other skin care professionals have long been doing. The mere inclusion of generic computing components to implement this abstract idea does not overcome the unpatentability of the subject matter. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 223 (2014) (holding that the “mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.”). Further, the ’358 patent does not purport to invent any specially configured computer or device to perform these functions; it generically claims a “computer” to “identify ... skin characteristics” of a user based on an image, or to “calculate[] a severity rating” for such characteristics, or to “select[] ... skin treatment recommendations” based on such ratings. ’358 Patent at Claim 16. Nor is there anything plausibly inventive about using an “electronic device” to visually “indicat[e] how the user’s face should be positioned” when capturing the image for such analysis. *Id.*.

The asserted claims of the ’358 Patent therefore amount to nothing more than the abstract idea of recommending treatments based on the severity of a person’s skin characteristics in a captured image, which is not eligible for patent protection under 35 U.S.C. § 101. Indeed, courts have consistently found analogous patent claims to be invalid under § 101. *E.g.*, *Procter & Gamble Co. v. QuantifiCare Inc.*, 288 F. Supp. 3d 1002, 1017 (N.D. Cal. 2017) (finding a claim reciting steps of “(1) retrieving an image of a person, . . . (2) performing electronic analysis on the image to ‘locate an area containing a skin defect,’ . . . (3) assigning a ‘numerical severity’ to the defect area, . . . and (4) comparing the ‘numerical severity’ to a predefined value for a particular population” to be “directed to” nothing more than the abstract idea of “acquiring and analyzing a digital image of a person to locate and quantify skin defects” and, thus, invalid under § 101

(internal citations omitted)); *Dental Monitoring SAS v. Align Tech., Inc.*, No. C-22-07335-WHA, 2024 WL 2261931, at *1, 9 (N.D. Cal. May 16, 2024) (finding claims for “guiding a patient to capture images of their dental arches and aligner fit in order to facilitate remote treatment” invalid under § 101). For the same reasons, this Court should find the ’358 Patent claims invalid and dismiss Plaintiff’s claim of infringement.

II. RELEVANT FACTS

A. Overview of the Asserted Claims of the ’358 Patent

Plaintiff filed this lawsuit on November 12, 2024, accusing L’Oreal of infringing two patents. The application leading to the patent at issue in this motion, the ’358 Patent, was filed by a company called Own, Inc. on June 19, 2012, and the patent issued on December 12, 2017. Dkt. 1 (“Compl.”) ¶ 46. The ’358 Patent, entitled “Method for providing personalized recommendations,” discloses “a process by which recommendations may be selected for a user,” as illustrated in Figure 1 (reproduced below). ’358 Patent at 1:14–16; *see also id.* at Claim 16 (“A computerized method for providing prioritized skin treatment recommendations to a user...”).

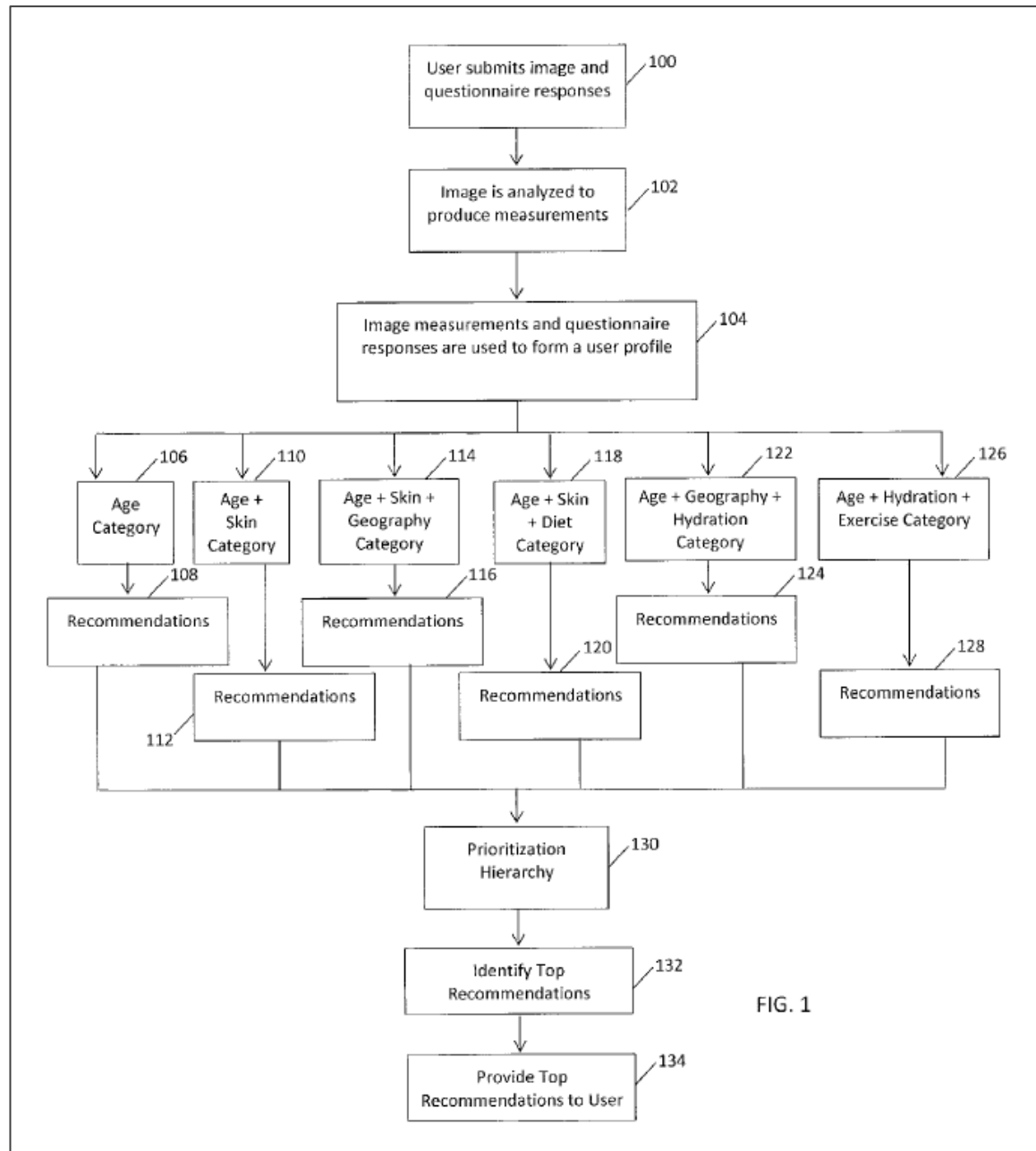


FIG. 1

The Complaint alleges that L’Oreal infringes independent claim 16 and dependent claim 18 (collectively, the “Asserted Claims”). Claim 16 states as follows:

A computerized method for providing prioritized skin treatment recommendations to a user, comprising:

receiving from an electronic device image data of a user’s face, wherein the electronic device comprises a camera and a display, wherein the image data is obtained via said camera, and wherein said electronic device presents on the display a photo guide

1 indicating how the user's face should be positioned with respect
2 to the camera when the image data is obtained;

3 transforming via a computer said image data via image
4 processing into measurements in order to identify at least two
5 skin characteristics of the user from the received image data;

6 calculating a severity rating for each of the at least two user skin
7 characteristics by:

8 accessing stored population information comprising
9 measurements for at least two skin characteristics of a
10 population of the same type as the at least two skin
11 characteristics of the user, wherein each of the
12 measurements for the at least two population skin
13 characteristics comprises a mean value and a standard
14 deviation value;

15 comparing each of the measurements of the at least two user
16 skin characteristics to the measurements of same type
17 population skin characteristic;

18 determining by how much each of the measurements of the
19 at least two user skin characteristics deviates from the mean
20 value and the standard deviation value of the same type
21 population skin characteristic;

22 assigning higher severity rating to the user skin
23 characteristic which deviates furthest than at least one
24 standard deviation of the same type population skin
25 characteristic; and

26 for a subset of the user skin characteristics with the highest
27 severity rating, selecting or more skin treatment
28 recommendations from stored skin treatment recommendations
based on the subset of the user skin characteristic with the
highest severity rating; and

providing to the electronic device the selected one or more skin
treatment recommendations.

'358 Patent, Claim 16. This method essentially involves four steps: (1) obtaining an image of a user's face, (2) identifying at least two skin characteristics of the user, (3) comparing the identified user skin characteristics to "normal" skin characteristics reference data¹ to calculate severity

¹In other words, data drawn from a population that has a normal distribution such that it can be described by two values: the mean and the standard deviation.

1 ratings, and (4) providing treatment recommendations for user skin characteristics with the highest
 2 severity rating. Claim 18 identifies specific types of skin characteristics used in this process:

3 The method of claim 16, wherein at least one of the at least two user
 4 skin characteristics and the at least two population skin
 5 characteristics comprise one or more of: number of wrinkles,
 6 number of age spots, quality of age spots, percentage of facial area
 7 covered by age spots, number of hyperpigmentation spots, quality
 8 of hyperpigmentation spots, percentage of facial area affected by
 9 hyperpigmentation spots, number of crow's feet, number of fine
 10 lines, number of deep lines, oiliness of skin, dryness of skin,
 11 pigment intensity, pigment darkness, pigment evenness, visibility of
 pores, number of large pores, lip color, lip line curvature, lip border
 strength, lip line smoothness, lip fullness, acne lesion visibility,
 color of acne scars, visibility of acne scars, presence of melasma,
 percentage of facial area covered by melasma, darkness of melasma,
 ultraviolet damage, and skin tone.

12 '358 Patent, Claim 18.

13 This is exactly what dermatologists and other skin care professionals have been doing for
 14 decades, if not centuries. They inspect a person's face to identify characteristics that vary from the
 15 norm and, where the variance is sufficiently great, they prescribe treatment. The claims simply
 16 recite a computer performing this process and using a mean and standard deviation to determine,
 17 respectively, what is normal and what is a significant variance.

18 **B. Prosecution History of the Asserted Claims Regarding § 101**

19 Throughout the prosecution of the '358 Patent application, the patent examiner maintained
 20 a rejection under § 101 with respect to the vast majority of the subject matter recited in the Asserted
 21 Claims. It was not until the applicant added the requirement that "said electronic device presents
 22 on the display a photo guide indicating how the user's face should be positioned with respect to
 23 the camera when the image is obtained" to the independent claims that the examiner allowed the
 24 claims. Indeed, this is the *only* limitation that the examiner believed to constitute anything more
 25 than the abstract idea of "instructing how to provide skin treatment recommendations utilizing
 26 measurements of skin characteristics." *E.g.*, Ex. A (prosecution history of the '358 Patent) at 22
 27 (Notice of Allowance, page 3), 62 (2017-03-21 Non-Final Office Action, page 3).²

28 ² The exhibits cited herein are attached to the Declaration of Jessica J. Delacenserie filed herewith.

1 The claim that ultimately issued as asserted claim 16 was not included in the set of claims
2 originally submitted by the applicant. *See* Ex. A at 400–06. Rather, it was added as a new claim
3 37 in response to the first office action, dated August 21, 2014, in which the examiner rejected all
4 then-pending claims (20–34) under § 101 as being directed to nothing more than the abstract idea
5 of “providing recommendations.” *Id.* at 253, 267. Claim 37 (now claim 16) originally recited as
6 follows:

7 A computerized method for providing prioritized skin treatment
8 recommendations to a user, comprising:

9 receiving an image of a user’s face via a network;

10 identifying at least two skin characteristics of the user from the
11 received image;

12 calculating a severity rating for each of the at least two user skin
13 characteristics by:

14 accessing stored population information comprising at least
15 two skin characteristics of a population of the same type as
16 the at least two skin characteristics of the user, wherein each
17 of the at least two population skin characteristics comprises
18 a mean value and a standard deviation value;

19 comparing each of the at least two user skin characteristics
20 to the same type population skin characteristic;

21 determining by how much each of the at least two user skin
22 characteristics deviates from the mean value and the
23 standard deviation value of the same type population skin
24 characteristic;

25 assigning higher severity rating to the user skin
26 characteristic which deviates furthest than at least one
27 standard deviation of the same type population skin
28 characteristic; and

for a subset of the user skin characteristics with the highest
severity rating, selecting one or more skin treatment
recommendations from stored skin treatment recommendations
based on the subset of the user skin characteristic with the
highest severity rating; and

providing the selected one or more skin treatment
recommendations to the user.

1 Ex A at 253. The applicant argued that this claim represents a “sufficiently inventive concept”
2 because it recites “specifically how the recommendations are selected and prioritized based on a
3 specifically calculated severity rating.” *Id.* at 256. The examiner rejected this argument in an office
4 action dated December 31, 2014, explaining that all such limitations “relate to the abstract idea of
5 providing recommendations, and while they may be meaningful, do not represent significantly
6 more than the abstract idea itself.” *Id.* at 237–38.

7 In its response dated March 19, 2015, the applicant amended the claim to clarify that certain
8 steps are performed by “a computer,” while others are performed by “an electronic device”
9 comprising “a camera, a display, and a communication capability.” Ex. A at 220–21; Ex. B³ at
10 Col. 1. For example, the applicant added limitations stating that “the image data is obtained via
11 said camera” and that recommendations are selected “for display on the display of the electronic
12 device.” *Id.* The applicant also replaced “identifying at least two skin characteristics...” with
13 “transforming via the computer said image data via image processing into measurements in order
14 to identify at least two skin characteristics...” and added “measurements [for / of]” before each
15 recited “skin characteristic.” *Id.* The applicant also made several arguments regarding the
16 sufficiency of such amendments to overcome the § 101 rejection—all of which the examiner
17 subsequently rejected.

18 For example, the applicant argued that “the present invention is not an abstract idea at all,”
19 but rather “a novel computer implemented method that transforms image data obtained by an
20 electronic device into prioritized skin treatment recommendations based on a severity rating
21 calculation,” emphasizing the use of a computer to analyze a user’s skin, perform calculations, and
22 compare various user skin characteristics to the mean and standard deviation of stored population
23 data. Ex. A at 225–27. The applicant also argued that “the present invention provides an
24 improvement to the technical field of computerized skin analysis, adds specific limitations other
25 than well-understood, routine and conventional in the field of computerized skin analysis, and
26 adds unconventional steps that confine the claims to a particular useful application, which amount

27
28 ³ Exhibit B is a table showing the evolution of claim 37 (which issued as claim 16) as it was
amended throughout prosecution.

1 to ‘significantly more’ that [sic] the abstract idea itself” and that “the claimed solution is
2 necessarily rooted in computer technology.” *Id.* at 228–30. In rejecting these arguments, the
3 examiner noted that “skin analysis constitutes part of the abstract idea and cannot be a different
4 technical field.” *Id.* at 198 (2015-04-22 Non-Final Office Action, page 4). The examiner also
5 pointed out that the applicant failed to “explain why the analysis and recommendations could not
6 be performed without a computer.” *Id.* The applicant further argued that claim 37 (now claim 16)
7 is analogous to two examples provided in the “January 27, 2015 Abstract Idea Examples used in
8 conjunction with the 2014 Interim Eligibility Guidance”—one involving “both an improvement
9 to the functioning of the computer and an improvement to another technology” and the other
10 directed to “hardware that calculates specific values using specific formulae and specific
11 hardware, all of which are interconnected”—both of which the examiner explained were
12 irrelevant. *Id.* at 198, 230–31.

13 For the next two years, the applicant continued to make—and the examiner continued to
14 reject—substantively identical arguments. *E.g.*, Ex. A at 164–65 (2015-08-13 Final Office Action,
15 pages 3–4) (“[A]pplicant argues that providing skin treatment recommendations utilizing
16 measurements of skin characteristics is not a fundamental economic practice, citing *Bilski* and
17 *PNC Bank*, and arguing that the claims are not abstract because they involve physical steps.
18 Amendment, page 13. The examiner however believes that the claims are similar to the claims in
19 the *SmartGene v. Advanced Biological Labs* case in that new and stored information (*e.g.*, skin
20 characteristics of the user and stored population information) is compared to identify options
21 (treatments) using rules (*e.g.*, how much measurements deviate from mean values).”), 133–37
22 (2016-03-08 Non-Final Office Action, pages 3–7) (“The method can be performed with or without
23 the assistance of a computer, including by mental steps, and is similar to other methods that have
24 been found to be directed to abstract ideas. It is therefore ‘an idea itself.’” (collecting cases);
25 “Ultimately, the claimed machine(s) function solely as an obvious mechanism to achieve the
26 claimed result, failing to impart a meaningful limit on the claim scope ... the claims are only
27 specific in how the computer is used to facilitate the abstract idea itself using routine and
28 conventional operations of the generic machinery, and are silent as to any detail or property that

1 would transform the otherwise generic machinery into a specialized or special purpose machine.”),
2 109–10 (2016-08-30 Final Office Action, pages 7–8) (“Applicant argues that because the claims
3 include several items of computer hardware, namely a computer and a communication network,
4 the claims are tied to a particular machine or apparatus. ... The question is whether a computer
5 and a communication network are absolutely necessary to carry out the method. The examiner
6 determined that they are not. Severity calculations, for example, can be performed on paper.
7 Appellant argues that image processing cannot be performed without a computer. Amendment,
8 page 2. The examiner disagrees. Image processing simply means that the image is processed to
9 identify the features of the user’s face. Specification, page 4. This can be done without a computer.
10 Therefore, a computer is not integral to the claims.”), 63–66 (2017-03-21 Non-Final Office Action,
11 pages 4–7) (similar). Throughout this two-year back-and-forth with the examiner, the applicant
12 further amended claim 37 (now claim 16) to add a requirement that “one of the skin characteristics
13 is the percent area of the user’s face covered by age spots.” *Id.* at 181 (2015-07-22 Claim
14 Amendments, page 8); Ex. B at Col. 2. The applicant also attempted to support its arguments with
15 an expert declaration, to no avail. *Id.* at 92–93 (2017-01-30 Response, pages 2–3), 95–96
16 (Declaration of Raja Sivamani, MD MS).

17 In its final Response submitted July 21, 2017, the applicant amended the independent
18 claims (including what issued as claim 16) to add “wherein said electronic device presents on the
19 display a photo guide indicating how the user’s face should be positioned with respect to the
20 camera when the image data is obtained” (and also retracted certain earlier amendments). Ex. A
21 at 48–49; Ex. B at Col. 3. On August 4, 2017, the examiner allowed all pending claims on this
22 basis, explaining:

23 With respect to 35 U.S.C. § 101, it is concluded that while a photo
24 guide in and of itself is a generic and conventional element, when
25 used as claimed to assist in obtaining image data for processing
26 measurements to identify measurements to identify skin
characteristics, it constitutes a technological solution and
significantly more than the abstract idea.

27 *Id.* at 22.

28 As explained below, however, using an electronic device to present a photo guide is just

as “generic and conventional” when used as claimed as it is in any other context and is no more of an “inventive concept” than using such a device or other generic computer to perform any other step of the claimed method.

III. LEGAL STANDARDS

A. Courts Often Dismiss Patent Infringement Claims Under Rule 12(b)(6) As Directed to Patent Ineligible Subject Matter

Pursuant to Fed. R. Civ. P. 12(b)(6), a court may dismiss one or more claims of a complaint for failure to state a claim upon which relief can be granted. A claim cannot survive a motion to dismiss unless it contains “sufficient factual matter, accepted as true, to ‘state a claim to relief that is plausible on its face.’” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009). Although the Court must accept as true all factual allegations pleaded and construe them in the light most favorable to the nonmoving party, it must not accept allegations that are “merely conclusory, unwarranted deductions of fact, or unreasonable inferences.” *Bastidas v. Good Samaritan Hosp. LP*, 774 F. App’x 361, 363 (9th Cir. 2019); *see also Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 555 (2007). In particular, “a court need not ‘accept as true allegations that contradict matters properly subject to judicial notice or by exhibit,’ such as the claims and the patent specification.” *Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 913 (Fed. Cir. 2017) (quoting *Anderson v. Kimberly-Clark Corp.*, 570 F. App’x 927, 931 (Fed. Cir. 2014)).

“Patent eligibility under 35 U.S.C. § 101 is a question of law that may contain underlying issues of fact.” *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1342 (Fed. Cir. 2018). As such, it “may be, and frequently has been, resolved on a Rule 12(b)(6) or (c) motion.” *SAP Am. Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1166 (Fed. Cir. 2018); *Elec. Comm’n Techs., LLC v. ShoppersChoice.com, LLC*, 958 F.3d 1178, 1184 (Fed. Cir. 2020) (concluding “that the district court properly resolved patent eligibility at the pleadings stage of the proceedings” even before claim construction); *Glasswall Sols. Ltd. v. Clearswift Ltd.*, 754 F. App’x 996, 999 (Fed. Cir. 2018) (finding “no error in the district court’s resolution of the patent ineligibility of the claims on a Rule 12(b)(6) motion”).

B. Claims Directed to Implementing Abstract Ideas on a Computer are Not Patent Eligible Under 35 U.S.C. § 101

Pursuant to 35 U.S.C. § 101, patent protection is available for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” The Supreme Court has, however, “recognized limits to § 101” and identified certain subject matter that is ineligible for patent protection, including abstract ideas. *Diamond v. Diehr*, 450 U.S. 175, 185 (1981). In *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, the Supreme Court prescribed a two-step framework for evaluating patent eligibility under § 101. 573 U.S. 208, 217 (2014). First, the Court must “determine whether the claims at issue are directed to a patent-ineligible concept,” *e.g.*, an abstract idea. *Id.* at 217–18. If so, the Court must determine whether the claims contain 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 [abstract idea] itself.’” *Alice* at 217–18.

These two steps are “plainly related” and “involve overlapping scrutiny of the content of the claims.” *Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016). For example, “[i]n cases involving software innovations, [the first] inquiry often turns on whether the claims focus on ‘the specific asserted improvement in computer capabilities . . . or, instead, on a process that qualifies as an “abstract idea” for which computers are invoked merely as a tool.’” *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1303 (Fed. Cir. 2018) (quoting *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016)). And at step two, the “mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *Alice*, 573 U.S. at 223; *see also, e.g., id.* (“Thus, if a patent’s recitation of a computer amounts to a mere instruction to ‘implement’ an abstract idea ‘on . . . a computer,’ . . . that addition cannot impart patent eligibility.” (quoting *Mayo Collaborative Svcs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 84 (2012))); *Customedia Techs., LLC v. Dish Network Corp.*, 951 F.3d 1359, 1366 (Fed. Cir. 2020) (“Aside from the abstract idea of delivering targeted advertising, the claims recite only generic computer components, including a programmable receiver unit, a storage device, a remote server and a processor. . . . Such generic and functional hardware is insufficient to render

eligible claims directed to an abstract idea.”); *Bascom Global Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016) (“An abstract idea on ‘an Internet computer network’ or on a generic computer is still an abstract idea.” (citing *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1368, n.2 (Fed. Cir. 2015) (collecting cases))); *Elec. Power Grp.*, 830 F.3d at 1355 (“But in this case the claims’ invocation of computers, networks, and displays does not transform the claimed subject matter into patent-eligible applications. The claims at issue do not require any nonconventional computer, network, or display components, or even a ‘non-conventional and non-generic arrangement of known, conventional pieces,’ but merely call for performance of the claimed information collection, analysis, and display functions ‘on a set of generic computer components’ and display devices.” (quoting *Bascom*, 827 F.3d at 1349–52)); *In re TLI Commc’ns LLC Patent Litig.*, 823 F.3d 607, 612–13 (Fed. Cir. 2016) (“The specification does not describe a new telephone, a new server, or a new physical combination of the two. The specification fails to provide any technical details for the tangible components, but instead predominately describes the system and methods in purely functional terms. ... In other words, the focus of the patentee and of the claims was not on an improved telephone unit or an improved server.”). “[L]imiting the use of an abstract idea ‘to a particular technological environment’” is similarly insufficient to transform the abstract idea into a patentable invention. *Alice*, 573 U.S. at 223 (quoting *Bilski v. Kappos*, 561 U.S. 593, 610–11 (2010)).

IV. THE ASSERTED CLAIMS ARE NOT PATENT ELIGIBLE

The Asserted Claims of the ’358 Patent are directed to the abstract idea of recommending treatments based on the severity of a person’s skin characteristics, and rely solely on generic computer components to carry out that idea. They are thus invalid under § 101 and *Alice*.

A. Claim 16 is Directed to the Abstract Idea of Recommending Treatments Based on the Severity of a Person’s Skin Characteristics (*Alice* Step One)

Claim 16 is directed to a prototypical abstract idea. The Federal Circuit has explained that a claim is “directed to” an abstract idea if the abstract idea is the “focus of the claims.” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1286 (Fed. Cir. 2018); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014) (finding claims directed to an abstract idea despite the existence

1 of “certain additional limitations [that] add a degree of particularity” because “the concept
 2 embodied by the majority of the limitations describes only the abstract idea”). As explained above,
 3 claim 16 recites nothing more than a method of: (1) obtaining an image of a user’s face, (2)
 4 identifying at least two skin characteristics of the user, (3) comparing the identified user skin
 5 characteristics to “normal” skin characteristics reference data to calculate severity ratings, and (4)
 6 providing treatment recommendations for user skin characteristics with the highest severity rating.
 7 These steps are all logical and conventional aspects of recommending treatments based on the
 8 severity of a person’s skin characteristics in both the real and electronic world. Thus, the “focus”
 9 of the method recited in claim 16 is recommending treatments based on the severity of a person’s
 10 skin characteristics. Further, this is not a method “necessarily rooted in computer technology in
 11 order to overcome a problem specifically arising in the realm of” computerized skin analysis—an
 12 argument the U.S. Patent Office consistently rejected during the prosecution of the ’358 Patent,
 13 *see supra* Section II.B—because each step is performed by generic computer components. *DDR*
 14 *Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014); *Credit Acceptance*
 15 *Corp. v. Westlake Servs.*, 859 F.3d 1044, 1055 (Fed. Cir. 2017) (“Our prior cases have made clear
 16 that mere automation of manual processes using generic computers does not constitute a patentable
 17 improvement in computer technology.”) (collecting cases).

18 ***First***, for a computer to determine the severity of skin characteristics, it logically follows
 19 that an image (or “image data”) must be obtained. ’358 Patent, Claim 16. It also logically follows
 20 that the subject of the image—here, “the user’s face”—“should be positioned” in a particular way
 21 “when the image data is obtained.” *Id.* Although claim 16 recites the use of a “photo guide”
 22 presented on the display of an electronic device to “indicat[e] how the user’s face should be
 23 positioned,” this can be achieved without a computer and is incidental to the abstract idea of
 24 recommending treatments based on the severity of a person’s skin characteristics. *Id.* Indeed, the
 25 specification makes clear the purpose of this limitation is to ensure that “the user is able to take an
 26 image of her face with preferred dimensions *for use in the recommendation process.*”⁴ ’358
 27 Patent at 2:35–37; *see Chamberlain Grp., Inc. v. Techtronic Indus., Co.*, 935 F.3d 1341, 1346

28 ⁴ All emphases are added unless otherwise indicated.

(Fed. Cir. 2019) (explaining that “the specification [is] helpful in illuminating what a claim is ‘directed to’”). “Common sense dictates that the request for a [] photo” containing information related to the requisite “quality or composition of the [] image, and guidance as to the acquisition” thereof is a process “as old as photography itself.” *Dental Monitoring*, 2024 WL 2261931, at *6. Accordingly, the use of a generic “electronic device”—such as a “mobile telephone, smart phone, tablet computer, personal digital assistant (PDA), laptop or other devices[] with at least a camera, display,” ’358 Patent at 2:27–40—to position and capture an image of a user’s face does not make these processes any less abstract. *E.g.*, *Elec. Power Grp. v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (“[W]e have treated collecting information, including when limited to a particular content (which does not change its character as information), as within the realm of abstract ideas.”); *Dental Monitoring*, 2024 WL 2261931, at *4–5 (finding a “purported advance” in “gathering ... information of a specified content”—there, “dental aligner shape and fitment”—and “not any particular assuredly inventive technology for performing [that] function” to be ineligible under § 101, explaining that although “implicit in the command to ‘do it on the computer’ is a great deal of field-of-use specific configuration,” the “work necessary to turn a generic computer to the field of use at issue does not *improve* the computer, just as the limitation of an abstract idea to the same field of use does not render the idea non-abstract” (emphasis in original)); *Procter & Gamble Co. v. QuantifiCare Inc.*, 288 F. Supp. 3d 1002, 1019 (N.D. Cal. 2017) (finding a method “directed to acquiring ... a digital image of a person *to locate and quantify skin defects*” to be directed to an abstract idea because “[a]cquiring a digital image of a person is mere data collection,” regardless of what the image is used for).

Second, in order to determine the severity of skin characteristics, it logically follows that at least two skin characteristics must be identified from the image. Although claim 16 specifically requires “transforming via a computer said image data via image processing into measurements in order to identify” such characteristics, ’358 Patent at Claim 16, the specification makes clear that the purported invention is not directed to a specific or improved type of image processing, nor does the claimed “image processing” require the use of a non-generic computer, *e.g.*, *id.* at 2:58–63 (“In step 102, the user’s image is analyzed to produce measurements. ... Any sufficient method

1 or means of image processing may be used to analyze the user’s image to identify the facial
 2 characteristics and features of the user’s face.”); *see generally id.* (failing to disclose any
 3 limitations to, or requirements of, the claimed “computer”). Indeed, the claimed measurements are
 4 merely the “number of” a given characteristic, such as “crow’s feet” or “age spots,” or some other
 5 quantification of a given characteristic, such as the “percentage of the user’s face that is covered
 6 by age spots” or “pigment intensity.” *Id.* at 2:63–3:28. All such “measurements” can be (and have
 7 long been) determined visually, *e.g.*, by a skin care professional, without the use of a computer.
 8 *See* Compl. ¶¶ 13 (“In 2005, ... the skincare industry was far behind in using technology to
 9 improve its products and services. For example, at the time of BTBP’s founding, the industry was
 10 still visually comparing images before and after product application... . Visual grading was used,
 11 and books were published to train staff and dermatologists to align their grading scores.”), 14
 12 (“inspecting a face for characteristics and conditions required one to closely examine the skin for
 13 very small imperfections, which was the best way to conduct a useful diagnosis”), 20 (“Prior to
 14 the 2007-time-frame, most skin analysis cosmetologists used visual grading techniques.”).
 15 Accordingly, the use of a computer to identify skin characteristics and/or measurements thereof—
 16 *i.e.*, to collect information—does not make these processes any less abstract. *E.g.*, *Procter &*
 17 *Gamble*, 288 F. Supp. 3d at 1017–18 (finding that steps of “performing electronic analysis on the
 18 image to ‘locate an area containing a skin defect’” and “assigning a ‘numerical severity’ to the
 19 defect area” fall “within the realm of ideas that the Federal Circuit has consistently found to be
 20 abstract”), 1019 (explaining that “‘electronically analyzing’ the digital image to locate skin
 21 defects” is “purely functional language . . . indicative of abstractness”); *see also Elec. Power Grp.*,
 22 830 F.3d at 1353; *Dental Monitoring*, 2024 WL 2261931, at *4–5.

23 **Third**, in order to determine the severity of a person’s skin characteristics, the variance of
 24 such characteristics from the norm must be determined. Comparing each characteristic (or a
 25 “measurement[] of” each characteristic) to “the mean value and the standard deviation value of
 26 the same type population skin characteristic” is the logical way to determine variance of such
 27 characteristic from the norm (and thus the severity of the characteristic). ’358 Patent at Claim 16.
 28 These too are merely ideas “that the Federal Circuit has consistently found to be abstract.” *Procter*

1 & *Gamble*, 288 F. Supp. 3d at 1017–18 (regarding method steps that include “comparing the
 2 ‘numerical severity’ to a predefined value for a particular population”). That this comparison is
 3 “computerized” in claim 16 does not make the idea any less abstract. *Elec. Power Grp.*, 830 F.3d
 4 at 1354 (“[W]e have treated analyzing information by steps people go through in their minds, or
 5 by mathematical algorithms, without more, as essentially mental processes within the abstract-
 6 idea category.”); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1094–95 (Fed. Cir.
 7 2016) (“While the claims here recite using one of a few possible rules to analyze the audit log
 8 data, this does not make them eligible... . While the claimed system and method certainly purport
 9 to accelerate the process of analyzing audit log data, the speed increase comes from the capabilities
 10 of a general-purpose computer, rather than the patented method itself.”); *Cybergenetics Corp. v.*
 11 *Inst. of Env’t Sci. & Rsch.*, 490 F. Supp. 3d 1237, 1247 (N.D. Ohio 2020) (finding that “the use of
 12 and accounting for variance by mathematical algorithms is ‘[t]he only difference between the
 13 conventional methods ... and that described’ in the claims and is, therefore, abstract,” explaining
 14 that “claims are abstract if they are directed to ‘selecting certain information, analyzing it using
 15 mathematical techniques, and reporting or displaying the results of the analysis’” (quoting *Parker*
 16 *v. Flook*, 437 U.S. 584, 585–86 (1978); *SAP Am., Inc. v. InvestPic, LLC*, 898 F.3d 1161, 1167
 17 (Fed. Cir. 2018))), *aff’d* 856 F. App’x 312 (Fed. Cir. 2021).

18 Indeed, the limitations of claim 16 “broadly cover manual determination and comparison
 19 of defect severity” using “purely functional language.” *Procter & Gamble*, 288 F. Supp. 3d at
 20 1019–20 (citing *Elec. Power Grp.*, 830 F.3d at 1356 (noting susceptibility of “claims so result-
 21 focused, so functional, as to effectively cover any solution to an identified problem”)). And
 22 Plaintiff readily acknowledges that the purpose of such limitations is to improve upon existing
 23 ways to “identify skin characteristics and conditions that could be treated”—*e.g.*, by “visually”
 24 “inspecting a face for characteristics and conditions”—as opposed to improving the functioning
 25 of a computer. Compl. ¶¶ 13–14 (describing “[v]isual grading” as a “deficient process” due to lack
 26 of accuracy and consistency), 55 (“the claimed invention ... provides for a particular, improved
 27 way to acquire an image of a person’s face, and then analyze that image data to identify at least
 28 two user skin characteristics, and then calculate the extent to which the user’s data for at least these

two skin characteristics deviate from stored data regarding the same type of skin characteristics (*i.e.* ‘severity rating’) for a specific group of people.”), 59 (“The specific steps set forth in the asserted claims state how the claims improve the method for identifying the severity of a skin condition and then recommending a treatment for improving the condition...”); *Credit Acceptance*, 859 F.3d at 1055 (“[Federal Circuit] cases have made clear that mere automation of manual processes using generic computers does not constitute a patentable improvement in computer technology.”) (collecting cases); *In re Brown*, 645 Fed. App’x 1014, 1016–17 (Fed. Cir. 2016) (finding the claims directed to an abstract idea where “Brown themselves state the object of the invention, providing a ‘consistent and repeatable hair cut,’ is ‘achieved though the recited steps of defining a head shape, designating zones, and assigning patterns to zones,’” which are capable of “being performed entirely in one’s mind”); *see also Flook*, 437 U.S. at 591 (“The process itself, not merely the mathematical algorithm, must be new and useful. Indeed, the novelty of the mathematical algorithm is not a determining factor at all.”).

Finally, providing treatment recommendations for sufficiently severe skin characteristics—here, the ones determined to have “the highest severity rating”—is merely incidental to the above-described abstract processes and similarly abstract. ’358 Patent at Claim 16. “[S]electing” such recommendations “from stored skin treatment recommendations,” *id.*, is nothing more than the abstract idea of collecting information. *E.g., Elec. Power Grp.*, 830 F.3d at 1353. And “providing to the electronic device the selected one or more skin treatment recommendations,” ’358 Patent at Claim 16, is “abstract as an ancillary part of” the abstract process by which such recommendations are selected. *Elec. Power Grp.*, 830 F.3d at 1354 (“[W]e have recognized that merely presenting the results of abstract processes of collecting and analyzing information ... is abstract as an ancillary part of such collection and analysis.”).

Accordingly, claim 16 is directed to the abstract idea of recommending treatments based on the severity of a person’s skin characteristics.

B. Claim 16 Does Not Recite an “Inventive Concept” (*Alice* Step Two)

At step two of *Alice*, the claim elements are considered “both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the

claim’ into a patent-eligible application.” *Alice*, 573 U.S. at 217 (quoting *Mayo*, 566 U.S. at 78–79). As explained above, claim 16 “simply recites the conventional use of existing electronic components” to perform each step of the claimed method, and thus none of the claim elements, assessed individually, supply the requisite “inventive concept.” *Procter & Gamble*, 288 F. Supp. 3d at 1026. In *Procter & Gamble*, for example, the court was presented with claims reciting substantively identical steps of “(1) retrieving an image of a person, . . . (2) performing electronic analysis on the image to ‘locate an area containing a skin defect,’ . . . (3) assigning a ‘numerical severity’ to the defect area, . . . and (4) comparing the ‘numerical severity’ to a predefined value for a particular population” and found that “[a]ll of these functions, when performed electronically, are routine computer functions.” *Id.* at 1017, 1026–27. As in that case, the specification here “confirms the generic nature of [the claim] elements.” *Id.* Regarding the claimed “electronic device,” the specification confirms that this can be any “typical electronic device,” such as a “mobile telephone, smart phone, tablet computer, personal digital assistant (PDA), laptop or other device.” ’358 Patent at 2:27–33. The specification does not once mention the claimed “computer,” much less suggest that the relevant functions cannot be performed on any general-purpose computer. *See generally id.* In particular, and as explained above, the specification notes that the claimed “image processing” performed by a computer can be “[a]ny sufficient method or means of image processing” and simply “identif[ies] the facial characteristics and features of the user’s face.” *Id.* at Claim 16, 2:60–63; *see supra* Section IV.A. Even if such image processing had never before been used in the field of skin analysis (it had), that is not enough to transform the abstract idea into patentable subject matter. *Dental Monitoring*, 2024 WL 2261931, at *9 (“It is not enough that a deep learning device had not previously been turned to the field of dental aligners.”).

The elements of claim 16 are also arranged in a conventional and generic way. As explained above, the claimed method “does not require a new technique for analyzing information, but rather follows the familiar progression of acquiring and analyzing information of a desired type to extract certain results from that information.” *Procter & Gamble*, 288 F. Supp. 3d at 1027; *see supra* Section IV.A. Nothing in the specification supports Plaintiff’s allegation that the claims “recite a technical solution to a problem *arising in the realm of computing networks*.” Compl.

¶ 59. Rather, the specification consistently describes the purported invention as “provid[ing] personalized recommendations that are intended to improve a person’s cosmetic appearance,” with only sparse references to generic computer components that can be used to achieve this. *E.g.*, ’358 Patent at 1:14–18; *see generally id.* The specification is also void of any suggestion that the claimed method would in any way improve the functioning of such generic computer components. *Id.* Moreover, “[r]egardless of whether the steps in claim [16] have previously been combined” (they have), “they do not amount to significantly more than acquiring and analyzing information” and, thus, the combination thereof does not “encompass an inventive concept.” *Procter & Gamble*, 288 F. Supp. 3d at 1028–29; *see supra* Section IV.A.

Accordingly, neither the individual elements of claim 16 nor their ordered combination recite an inventive concept sufficient to transform the abstract idea of recommending treatments based on the severity of a person’s skin characteristics.

C. Dependent Claim 18 Does Not Add Any “Inventive Concept”

Claim 18 merely specifies what “at least one of the at least two user skin characteristics and the at least two population skin characteristics” recited in claim 16 must be. It does not add any steps to the method of claim 16, nor does it require the use of any new or specialized computer components, nor does it provide any elements that would improve the functioning of the generic computer components recited in claim 16. ’358 Patent at Claim 18. Accordingly, claim 18 does not add any inventive concept to the abstract idea of recommending treatments based on the severity of a person’s skin characteristics.

V. CONCLUSION

The Asserted Claims of the ’358 Patent are directed to nothing more than the abstract idea of recommending treatments based on the severity of a person’s skin characteristics. As such, they are invalid under 35 U.S.C. § 101 and Plaintiff’s claim of infringement of the ’358 Patent should be dismissed.

1 Dated: January 24, 2025

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CERTIFICATE OF SERVICE

I hereby certify that on January 24, 2025, I caused the foregoing document to be filed with the Clerk of the Court using the CM/ECF system, which will send a notification of such filing to the email addresses indicated on the Court's Electronic Mail Notice List.

/s/ Ramsey M. Al-Salam
Ramsey M. Al-Salam