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17 UNITED STATES DISTRICT COURT  
18 SOUTHERN DISTRICT OF CALIFORNIA

19 TEMPUS AI, INC.,  
20 Plaintiff,  
21 v.  
22 GUARDANT HEALTH, INC.,  
23 Defendant.

24 ) Case No.: 3:25-CV-00621-JO-MMP  
25 )  
26 ) **MEMORANDUM OF POINTS**  
27 ) **AND AUTHORITIES IN**  
28 ) **SUPPORT OF DEFENDANT**  
 ) **GUARDANT HEALTH INC.'S**  
 ) **MOTION TO DISMISS**  
 ) **PURSUANT TO FED. R. CIV. P.**  
 ) **12(b)(6)**  
 )  
 ) Before: Hon. Jinsook Ohta  
 ) Hearing Date: July 31, 2025  
 ) Time: 9:30 A.M.  
 ) Courtroom 4C  
 )

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1 **I. INTRODUCTION**

2 This lawsuit was filed as a distraction from Guardant’s pending patent  
3 infringement case in the District of Delaware. That lawsuit describes how Tempus,  
4 founded years after Guardant, created copycat diagnostics products to unfairly  
5 compete with Guardant. *See Guardant Health, Inc. v. Tempus AI, Inc.*, C.A. No. 24-  
6 0687-GBW (D. Del. Jun. 11, 2024) (“Delaware Case”), Dkt. 1. Faced with its  
7 infringement, Tempus filed this lawsuit in retaliation. Tempus’s Complaint contains  
8 a counterfactual narrative, ignoring its own reliance on Guardant’s intellectual  
9 property and going so far as to accuse portions of Guardant products that predate the  
10 Asserted Patents.<sup>1</sup> Relevant here, all four of Tempus’s Asserted Patents, which  
11 relate either to using computers to analyze images of stained tissue slides or to  
12 storing cancer patients’ clinical records in databases, are textbook examples of  
13 patent-ineligible abstract ideas lacking any inventive concept. This Court should  
14 dismiss Tempus’s Complaint under Rule 12(b)(6) and 35 U.S.C. § 101.

15 The first two patents—U.S. Patent Nos. 10,957,041 (the “’041 Patent” (Dkt.  
16 1-5)) and 10,991,097 (the “’097 Patent” (Dkt. 1-6)) (collectively, the “Tissue  
17 Analysis Patents”)—try to claim a process that humans have performed for decades  
18 in the field of histopathology, simply adding the idea to do it on a computer.  
19 Representative Claim 1 of the ’097 Patent recites the abstract idea of analyzing  
20 different parts of a stained tissue slide to identify the tissues on each part. Yet  
21 according to a prior art paper cited on the face of the ’041 patent: “Microscopic  
22 imaging of tissue samples is a fundamental tool that is used for the diagnosis of  
23 various diseases and is the workhorse of pathology and biological sciences.” Jaffe  
24 Ex. 2 at 1.<sup>2</sup> These patents are thus “quintessential ‘do it on a computer’ patent[s]:

25 \_\_\_\_\_  
26 <sup>1</sup> Compare Dkt. 1-7 at 30 (citing 2018 paper describing Guardant 360) with Ex.  
27 1 to the Declaration of Jordan Jaffe, filed herewith (“Jaffe Ex.”).

28 <sup>2</sup> Rivenson, et al, “Virtual histological staining of unlabelled tissue-  
autofluorescence images via deep learning,” *Nature Biomedical Engineering* 3:466-  
77 (2019) is cited at 15:60-63 of ’041 Patent and thus properly considered on a  
(continued...)

1 [they] acknowledge[] that data from [tissue samples on slides] was previously  
2 collected, analyzed, manipulated, and displayed manually, and [they] simply  
3 propose[] doing so with a computer.” *Univ. of Fla. Rsch. Found, Inc. v. Gen. Elec.*  
4 *Co.*, 916 F.3d 1363, 1367 (Fed. Cir. 2019). The Federal Circuit has “held such  
5 claims are directed to abstract ideas.” *Id.* Tempus cannot patent this “fundamental  
6 tool” by simply “do[ing]” it on a computer.” *Id.*

7 That the claims of the related '041 Patent say do it on a computer with “deep  
8 learning” is of no help either. *See e.g.*, '041 Patent at cl. 1. As Tempus and the '041  
9 Patent admit, using AI and deep learning to analyze tissue slides is “conventional.”  
10 *See Compl.*, ¶ 65. As the Federal Circuit recently held, “patents that do no more  
11 than claim the application of generic machine learning to new data environments,  
12 without disclosing improvements to the machine learning models to be applied, are  
13 patent ineligible under § 101.” *Recentive Analytics, Inc. v. Fox Corp.* 134 F.4th  
14 1205, 1216 (Fed. Cir. 2025). Yet, that is precisely what the '041 Patent claims—  
15 *i.e.*, using generic machine learning technology as a tool to carry out longstanding  
16 mental methods of analyzing stained tissue slides.

17 The second two patents—U.S. Patent Nos. 11,640,859 (the “'859 Patent”  
18 (Dkt. 1-2)) and 12,112,839 (the “'839 Patent” (Dkt. 1-3, 1-4)) (collectively, the  
19 “Data Storage Patents”)—fare no better. Their alleged innovation is obtaining  
20 patients’ clinical records and genomic sequencing data, and then storing and  
21 “shaping” that data in “structured” or “semi-structured” databases. The Federal  
22 Circuit has repeatedly held that such claims, directed to the collection and storing of  
23 information, are “within the realm of abstract ideas.” *Elec. Power Grp., LLC v.*  
24 *Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016); *see also Longitude Licensing*

25 \_\_\_\_\_  
26 motion to dismiss as part of the intrinsic record. *See AI Visualize, Inc. v. Nuance*  
27 *Commc’ns, Inc.*, 97 F.4th 1371, 1380 (Fed. Cir. 2024) (patentees’ allegations of  
28 inventive concept fail “when the intrinsic record establishes the technology is  
conventional or well-known in the art.”); *E.I. du Pont De Nemours & Co. v. Unifrax*  
*I LLC*, 921 F.3d 1060, 1068 (Fed. Cir. 2019) (prior art cited during prosecution of  
the patent is considered part of intrinsic evidence).

1 *Ltd. v. Google LLC*, No. 24-1202, 2025 WL 1249136, at \*2 (Fed. Cir. Apr. 30, 2025);  
2 *Recentive*, 134 F.4th at 1214; *Geoscope Techs. Pte. Ltd. v. Google LLC*, No. 24-  
3 1003, 2025 WL 1276235, at \*2 (Fed. Cir. May 2, 2025). The Data Storage Patents’  
4 claims do not specify a new or inventive database “structure” or “semi-structure,” or  
5 any inventive method of “shaping” the data. Rather, they recite only generic and  
6 conventional “user application programs.” See ’859 Patent at 43:20-52 (describing  
7 user application programs as conventional computer programs to facilitate *e.g.*,  
8 oncological diagnosis and treatment). The claims also fail to recite any inventive  
9 concept; instead reciting the use of generic, conventional, and well-understood  
10 computer components and techniques such as “databases” and “user application  
11 programs” as a tool to achieve the desired results. Put simply, the claims require  
12 only storing patient information in databases using routine, well-known, and  
13 conventional computer technology.

14 Finally, Tempus’s lengthy allegations in its Complaint betray the inherent  
15 weakness of the patents under Section 101. They do not and cannot overcome the  
16 intrinsic record, which itself establishes that the patents are directed to ineligible  
17 subject matter. See *AI Visualize*, 97 F.4th at 1380. The remainder of the allegations  
18 are either irrelevant or conclusory, and thus pose no obstacle to this motion. At  
19 bottom, courts regularly dismiss these types of patents on a motion to dismiss under  
20 Section 101 and should likewise do so here. See *Cleveland Clinic Found. v. True*  
21 *Health Diagnostics LLC*, 859 F.3d 1352, 1360 (Fed. Cir. 2017) (collecting cases  
22 affirming Rule 12(b)(6) dismissals on patent eligibility grounds).

23 **II. BACKGROUND**

24 Guardant is a pioneering precision oncology company founded in 2012 to  
25 provide advanced cancer tests and monitoring. Jaffe Ex. 3 at 2. Guardant’s tests  
26 include “screening to find cancer early, monitoring for recurrence in early-stage  
27 cancer, and helping doctors select the best treatment for patients with advanced  
28 cancer.” *Id.*; see also Delaware Case (D. Del. Nov. 4, 2024), Dkt. 21, ¶¶ 2, 4-5.

1 These tests enable earlier detection of cancer without the invasiveness of a full  
2 surgical procedure. *Id.* Guardant has been recognized as a World Economic Forum  
3 Technology Pioneer, among other accolades. Jaffe Ex. 4.

4 In 2014, Guardant launched its Guardant360 liquid biopsy test, which samples  
5 a patient’s blood to detect and analyze free-floating DNA fragments in the  
6 bloodstream (“cell-free DNA” or “cfDNA”) for relevant biomarkers indicating the  
7 presence of cancer. Jaffe Ex. 5. The Guardant360 test was one of the first  
8 commercially available liquid biopsy tests for cancer diagnosis. In 2020, Guardant  
9 launched Guardant360 CDx, the first comprehensive liquid biopsy test approved by  
10 the U.S. Food and Drug Administration to provide tumor mutation profiling with  
11 solid tumors and to be used as a companion diagnostic in connection with non-small  
12 cell lung cancer, or NSCLC, and breast cancer. Jaffe Ex 6. In addition to its  
13 pioneering liquid biopsy tests, Guardant also offers Guardant360 Tissue Next, a  
14 solid tissue biopsy test, as well as various oncology related software and AI  
15 platforms including Guardant GALAXY, Guardant INFINITY, and Guardant  
16 INFORM. Jaffe Exs. 7-9. “To date, over 500,000 patient samples have been  
17 analyzed using Guardant’s tests.” Delaware Case, Dkt. 21, ¶ 2. To protect its  
18 innovative technology, Guardant holds 100+ patents, including U.S. Patent No.  
19 9,902,992, which was filed in 2016 and issued in 2018. *Id.*, ¶¶ 21-24.

20 Tempus was founded in 2015. Compl., ¶ 11. Since its inception, Tempus has  
21 capitalized on Guardant’s pioneering efforts by marketing copy-cat cell-free DNA  
22 liquid biopsy tests. For example, in 2018, Tempus launched its Tempus xF liquid  
23 biopsy tests to compete with Guardant360. Jaffe Ex. 10. In June 2024, Guardant  
24 filed a lawsuit against Tempus in federal court in Delaware, alleging that Tempus’s  
25 liquid biopsy sequencing methods infringe on Guardant’s patents. *See* Delaware  
26 Case, Dkt. 1. In what can only be described as retaliation, Tempus filed this lawsuit  
27 alleging Guardant infringes four patents in two categories: (1) the Tissue Analysis  
28

1 Patents ('097 and '041 Patents) and (2) the Data Storage Patents (the '859 and '839  
2 Patents) (collectively, the “Asserted Patents”).

3 The Tissue Analysis Patents both recite methods of using computer  
4 technology to analyze images of tissue slides. Claim 1 of the '097 Patent, which is  
5 representative, recites “[a] method for creating an overlay map on a digital image of  
6 a slide, the method comprising:

7 receiving the digital image;

8 separating the digital image into a plurality of tiles, each tile of the  
9 plurality of tiles containing a respective portion of the digital image of  
10 the slide; and

11 for each tile of the plurality of tiles:

12 identifying features of the tile;

13 identifying structural tissue features of a second portion of the digital  
14 image of the slide including at least part of one or more other tiles of  
15 the plurality of tiles, wherein the second portion is larger than the  
16 respective portion of the digital image contained in the tile; and

17 identifying the majority class of tissue visible within the tile based at  
18 least in part on the features of the tile and the structural tissue features  
19 of the second portion of the digital image of the slide.

20 '097 Patent at cl. 1. Claim 1 of the '041 Patent recites similar subject matter, adding  
21 conventional dyes for staining and “deep learning.” The dependent claims of the  
22 Tissue Analysis Patents recite additional limitations such as the resolution of the  
23 image, what kinds of tissues are being analyzed, or how those results are displayed.

24 The Data Storage Patents “generally disclose and claim methods for storing  
25 and structuring clinical and genomic sequencing patient data for specific application  
26 programs.” Compl., ¶ 23. Claim 1 of the '859 Patent, which is representative, recites  
27 “[a] method for conducting genomic sequencing” comprising, among other steps:

28 storing a set of user application programs wherein each of the programs  
requires an application specific subset of data to perform application  
processes and generate user output; ...

(a) obtaining clinical records data ... includ[ing] cancer state  
information, treatment types and treatment efficacy information;

- 1 (b) storing the clinical records data in a semi-structured first database;
- 2 (c) for each patient, using a next generation genomic sequencer to
- 3 generate genomic sequencing data ...;
- 4 (d) storing the sequencing data in the first database;
- 5 (e) shaping at least a subset of the first database data to generate system
- 6 structured data including clinical record data and sequencing data
- 7 wherein the system structured data is optimized for searching;
- 8 (f) storing the system structured data in a second database;
- 9 (g) for each user application program:
  - 10 (i) selecting the application specific subset of data from the
  - 11 second database; and
  - 12 (ii) storing the application specific subset of data in a structure
  - 13 optimized for application program interfacing in a third database.

14 '859 Patent at cl. 1. Claim 1 of the '839 Patent recites substantially the same  
15 elements. *See* '839 Patent at cl. 1. The dependent claims of the Data Storage Patents  
16 recite the claimed method as applied to specific purposes (*e.g.*, use by pathologists,  
17 radiologists) or specific types of data (*e.g.*, sequencing specific cells or genes).

### 18 **III. LEGAL STANDARD**

#### 19 **A. Rule 12(b)(6) Motion to Dismiss**

20 A motion to dismiss under Rule 12(b)(6) tests the legal sufficiency of the  
21 claims asserted. Fed. R. Civ. P. 12(b)(6). Dismissal is appropriate when the  
22 “complaint lacks a cognizable legal theory or sufficient facts to support a cognizable  
23 legal theory.” *Mendiondo v. Centinela Hosp. Med. Ctr.*, 521 F.3d 1097, 1104 (9th  
24 Cir. 2008). To survive a Rule 12(b)(6) motion, a plaintiff must state a facially  
25 plausible claim, which requires pleading sufficient “factual content that allows the  
26 court to draw the reasonable inference that the defendant is liable for the misconduct  
27 alleged.” *Ashcroft v. Iqbal*, 556 U.S. 662, 678 (2009).

#### 28 **B. Section 101 Patent Eligibility**

Section 101 of the Patent Act states that “[w]hoever invents or discovers any  
new and useful process, machine, manufacture, or composition of matter, or any new

1 and useful improvement thereof, may obtain a patent therefor[.]” 35 U.S.C. § 101.  
 2 “Laws of nature, natural phenomena, and abstract ideas are not patentable.” *See*  
 3 *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 216 (2014) (citation omitted).

4 The Supreme Court and Federal Circuit have set forth a two-part test for  
 5 determining patent-eligibility under Section 101. First, the Court “determine[s]  
 6 whether a claim is ‘directed to’ a patent-ineligible abstract idea” (“*Alice* step one”).  
 7 *Content Extraction & Transmission LLC v. Wells Fargo Bank, N.A.*, 776 F.3d 1343,  
 8 1346-47 (Fed. Cir. 2014) (citation omitted). If so, the Court then “consider[s] the  
 9 elements of the claim—both individually and as an ordered combination—to assess  
 10 whether the additional elements transform the nature of the claim into a patent-  
 11 eligible application of the abstract idea” (“*Alice* step two”). *Id.* at 1347. “This is the  
 12 search for an ‘inventive concept’—something sufficient to ensure that the claim  
 13 amounts to ‘significantly more’ than the abstract idea itself.” *Id.* (citation omitted).  
 14 That is, the claim must amount to something more than the “‘well-understood,  
 15 routine, conventional activit[ies]’ previously known to the industry.” *Alice*, 573 U.S.  
 16 at 225 (alteration in original, citation omitted). Patent eligibility under 35 U.S.C. §  
 17 101 is regularly determined at the motion to dismiss stage. *See Trinity Info Media,*  
 18 *LLC v. Covalent, Inc.*, 72 F.4th 1355, 1360-62 (Fed. Cir. 2023).

19 **IV. ARGUMENT**

20 **A. The Tissue Analysis Patents (’097 and ’041 Patents)**

21 **1. *Alice* Step 1: Representative Claim 1 of the ’097 Patent is**  
 22 **Directed to a Patent-Ineligible Abstract Idea.**

23 Claim 1 of the of the ’097 Patent is a classic example of claiming an abstract  
 24 idea and doing it on a computer. Here the abstract idea is looking at different parts  
 25 of an image and analyzing the visual information in each part. As the below chart  
 26 illustrates, each element of claim 1 is directed to this abstract idea.

'097 Patent Claim 1 Element	Abstract Focus
receiving the digital image;	Receiving visual information

1	separating the digital image into a plurality of tiles, each	<i>Dividing</i> visual information
2	tile of the plurality of tiles containing a respective portion of the digital image of the slide; and	
3	for each tile of the plurality of tiles:	<i>Analyzing</i> visual information
4	identifying features of the tile;	
5	identifying structural tissue features of a second portion of the digital image of the slide including at least part of one or more other tiles of the plurality of tiles, wherein the second portion is larger than the respective portion of the digital image contained in the tile; and	<i>Analyzing</i> visual information
6		
7		
8	identifying the majority class of tissue visible within the tile based at least in part on the features of the tile and the structural tissue features of the second portion of the digital image of the slide.	<i>Analyzing</i> visual information
9		
10		

11 At *Alice* step one, courts “look at the focus of the claimed advance over the  
 12 prior art to determine if the claim’s character as a whole is directed to excluded  
 13 subject matter.” *Recentive*, 134 F.4th at 1211-12 (internal quotations omitted,  
 14 citation omitted). This inquiry determines “whether the claims focus on ‘the specific  
 15 asserted improvement in computer capabilities or, instead, on a process that qualifies  
 16 as an abstract idea for which computers are invoked merely as a tool.” *Id.* at 1212  
 17 (cleaned up, citation omitted).

18 According to the ’097 Patent’s specification, manual analysis of stained tissue  
 19 slides in order to diagnose diseases is a long-standing practice in histopathology.  
 20 ’097 Patent at 1:29-46. Recent technological advances have made it possible to use  
 21 computer vision on high resolution images, rather than the trained human eye on  
 22 microscopes, to analyze tissue slides and classify the component tissues. *Id.* at 1:56-  
 23 62. Whole tissue slides often include more than one type of tissue, therefore  
 24 pathologists “need to classify different regions as different tissue classes, in part to  
 25 study the borders between neighboring tissue classes and the presence of immune  
 26 cells among tumor cells.” *Id.* at 1:67-2:3. This is something that human pathologists  
 27 have done for generations. *Id.* at 1:29-46. This includes looking at different portions  
 28 of a slide at a given time. Indeed, common microscopes going back to the 1970s

1 include grids—*i.e.* tiles—when looking at slides of tissue. Jaffe Ex. 12 at 2. The  
2 '097 Patent purports to claim a method that performs the same or similar analysis on  
3 a computer—including receiving a digital image of a tissue slide, separating that  
4 digital image into a “plurality of tiles,” and identifying the tissue classes in and  
5 around each tile. *See* '097 Patent at 2:30-35, cl. 1.

6 The claimed advance is directed to receiving visual information, dividing that  
7 visual information into separate “tiles,” and then analyzing that visual information  
8 by identifying features in different portions of the image and comparing them to  
9 identify the class of tissue in each tile. Courts regularly find claims reciting analysis  
10 of digital images to be directed to the abstract idea of collecting and analyzing  
11 information. Most recently, in *Longitude*, the Federal Circuit affirmed the patent-  
12 ineligible nature of patents claiming improved methods of identifying the “main  
13 object” in digital images and adjusting the picture quality of that “main object.”  
14 2025 WL 1249136 at \*1. The *Longitude* court found the claims abstract because they  
15 recite “organiz[ing], alter[ing], or manipul[at]ing] data, without more,” and  
16 “implement longstanding activities and mental processes using new data and generic  
17 computing components without explaining how these arrangements actually result  
18 in the claimed improvement.” *Id.* at \*2; *see also In re TLI Commc’ns LLC Pat.*  
19 *Litig.*, 823 F.3d 607, 610 (Fed. Cir. 2016).

20 Several California District Courts have found analogous claims to be abstract.  
21 For instance, in *Procter & Gamble Co. v. QuantifiCare Inc.*, the court considered  
22 several claims directed to methods of “locating one or more visual skin defects” by  
23 acquiring a digital image of the face, electronically analyzing the image to locate an  
24 area containing a skin defect, and determining the severity of said defect. 288 F.  
25 Supp. 3d 1002, 1009 (N.D. Cal. 2017) (“*P&G*”). The *P&G* court found that these  
26 claims were abstract because “[a]cquiring a digital image of a person is mere data  
27 collection” and “[a]nalyzing that digital image to locate and quantify the skin defects  
28 is simple analysis of that information.” *Id.* at 1019. The Court also found that the

1 claims’ steps “do no more than “analyz[e] information by steps people go through  
2 in their minds, or by mathematical algorithms.” *Id.* at 1020 (quoting *Elec. Power*  
3 *Grp.*, 830 F.3d at 1354); *see also Brightex Bio-Photonics, LLC v. L’Oreal USA, Inc.*,  
4 No. 24-cv-7919, 2025 WL 722445, at \*15-16 (N.D. Cal. Mar. 6, 2025) (analogizing  
5 *P&G* and finding claims directed to computerized methods of analyzing facial  
6 images to determine the severity of a patient’s “skin characteristics” are directed to  
7 the abstract idea of collecting and analyzing information.); *Dental Monitoring SAS,*  
8 *v. Align Tech., Inc.*, No. 22-07335, 2024 WL 2261931, at \*3-7 (N.D. Cal. May 16,  
9 2024) (finding patent-ineligible claims reciting using machine learning to analyze  
10 images of patients’ dental arches); *Monument Peak Ventures, LLC v. SZ DJI Tech.*  
11 *Co.*, No. 18-cv-2210, 2018 WL 5174034, at \*1, 7 (C.D. Cal. July 31, 2018) (finding  
12 patent-ineligible claims directed to identifying objects in an image, and determining  
13 “at least one structural saliency feature and at least one semantic saliency feature”).

14 Like in these cases, claim 1 of the ’097 Patent has nothing to do with any  
15 purported improvements in technology, but is instead directed to long-standing  
16 mental processes.<sup>3</sup> As the ’097 Patent acknowledges, analyzing images of stained  
17 tissue slides to diagnose diseases is a “common” practice in histopathology. *See*  
18 ’097 Patent at 1:29-46. As part of this process, pathologists would “visually  
19 analyze” a tissue slide to “classify each region of the tissue.” *Id.* at 1:34-39; *see*  
20 *also* Compl., ¶¶ 48, 63 (describing “conventional” methods of analyzing tissue  
21 slides). This is an age-old practice going back over a hundred years. *See generally*  
22 *Jaffe Exs. 11, 12.* Claim 1 of the ’097 Patent merely recites this longstanding mental  
23

24 <sup>3</sup> The one claim found patent eligible in *P&G* is distinguishable. The court there  
25 relied upon the specificity of the relevant claimed method of identifying facial  
26 landmarks (*e.g.*, a corner of an eye, nose or mouth), in finding that the claim recited  
27 a “combined order of specific rules that renders information into a specific format  
28 that is then used and applied to create desired results[.]” 288 F. Supp. 3d at 1034  
(citation omitted). Here, no such “specific rules” exist; claim 1 of the ’097 Patent  
merely recites the single, generic step of “separating the digital image into a plurality  
of tiles,” (’097 Patent at cl. 1), completely “untethered to any specific or concrete  
way of implementing” the function. *P&G*, 288 F. Supp. 3d at 1033 (citation  
omitted).

1 practice of analyzing the visual information on a stained tissue slide, and directs it  
2 to be done with a “digital image.” This claim’s steps do no more than “analyz[e]  
3 information by steps people go through in their minds, or by mathematical  
4 algorithms.” *P&G*, 288 F. Supp. 3d at 1020 (citation omitted). This is “a  
5 quintessential ‘do it on a computer’ patent: it acknowledges that data from [tissue  
6 slides] was previously collected, analyzed, manipulated, and displayed manually,  
7 and it simply proposes doing so with a computer.” *Univ. of Fla.*, 916 F.3d at 1367.

8 Like the claims in *Longitude*, claim 1 of the ’097 Patent is also “framed  
9 entirely in functional, results-oriented terms” “without actually explaining how [the]  
10 process was achieved.” 2025 WL 1249136 at \*3-4.; *see also Free Stream Media*  
11 *Corp. v. Alphonso Inc.*, 996 F.3d 1355, 1363 (Fed. Cir. 2021) (a relevant inquiry is  
12 whether patents “focus on a specific means or method that improves the relevant  
13 technology or are instead directed to a result or effect that itself is the abstract idea.”  
14 (citation omitted)). Claim 1 of the ’097 Patent recites only such functional language,  
15 such as “**receiving** the digital image” “**separating** [it] into a plurality of tiles ...” and  
16 “**identifying** structural tissue features...and ... the majority class... *Id.* (emphasis  
17 added). Each of these elements merely recites the desired result, with no specificity  
18 as to *how* the claimed result is accomplished. The claims similarly do not recite *who*  
19 is performing which steps—a computer versus a human. Claim 1 thus “fails to recite  
20 a practical way of applying an underlying idea and instead is drafted in such a result-  
21 oriented way that it amounts to encompassing the principle in the abstract....” *Free*  
22 *Stream*, 996 F.3d at 1363 (cleaned up, citation omitted).

23 Tempus alleges that the ’097 Patent discloses an improvement over  
24 “conventional AI techniques to [analyze tissue slides]” by “receiving and separating  
25 a digital image into a plurality of tiles, each containing a portion of the digital image  
26 of the slide, and, for each tile, identifying features of the tile....” Compl., ¶¶65-66.  
27 As an initial matter, nothing in claim 1 of the ’097 Patent even recites “AI  
28 techniques.” Regardless, this element recites nothing more than the idea of dividing

1 the digital image into multiple parts, and then analyzing the visual data. “[M]erely  
2 splitting up a job into smaller pieces” is an abstract idea. *Coho Licensing LLC v.*  
3 *Glam Media, Inc.*, No. 14-1576, 2017 WL 6210882, at \*5 (N.D. Cal. Jan. 23, 2017).  
4 This concept is not inventive. Humans have been doing that since the beginning of  
5 time—and doing it in the context of tissue slide analysis for decades. *See* Section  
6 IV(A)(2), *infra*. “Simply applying the already-widespread practice of [dividing  
7 tasks to subparts] to the environment of [computerized analysis of tissue slides] is  
8 no more than an abstract idea.” *Simio, LLC v. FlexSim Software Prods., Inc.*, 983  
9 F.3d 1353, 1360 (Fed. Cir. 2020); *see also Elec. Power Grp.*, 830 F.3d at 1354  
10 (combination of abstract idea processes is still abstract and patent-ineligible).

11 **2. Alice Step 2: Representative Claim 1 of the '097 Patent Fails**  
12 **to Recite an Inventive Concept.**

13 At *Alice* step two, claim 1 of the '097 Patent also fails to recite any inventive  
14 concept sufficient to elevate it beyond the abstract idea, individually or as an ordered  
15 combination. At this step, Courts “consider the elements of [the] claim both  
16 individually and ‘as an ordered combination’ to determine whether the additional  
17 elements ‘transform the nature of the claim’ into a patent-eligible application.”  
18 *Alice*, 573 U.S. at 217 (quoting *Mayo Collaborative Servs. v. Prometheus Lab’ys,*  
19 *Inc.*, 566 U.S. 66, 78-79 (2012)). “An inventive concept reflects something more  
20 than the application of an abstract idea using ‘well-understood, routine, and  
21 conventional activities previously known to the industry.’” *Cellspin Soft, Inc. v.*  
22 *Fitbit, Inc.*, 927 F.3d 1306, 1316 (Fed. Cir. 2019) (citation omitted). This “must be  
23 significantly more than the abstract idea itself, and cannot simply be an instruction  
24 to implement or apply the abstract idea on a computer.” *Bascom Glob. Internet*  
25 *Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1349 (Fed. Cir. 2016).

26 Claim 1 of the '097 Patent does not recite anything that could arguably be  
27 “significantly more” than the abstract idea, individually or as an ordered  
28 combination. Claim 1 does not even recite any computer hardware, components, or

1 software at all. Instead, the claim recites *only* the method of separating a “digital  
2 image” of the tissue slide into tiles and analyzing each tile—by comparing it to other  
3 portions of the image—to classify tissues. This is conventional both for humans and  
4 computers. As the ’097 Patent acknowledges, human pathologists have long used  
5 conventional microscopes to “visually analyze” tumor tissue, and specifically “to  
6 classify *each region* of the tissue as one of many *tissue classes*.” See ’097 Patent at  
7 1:29-46 (emphasis added). Indeed, dividing slides into sections for analysis has been  
8 taught to pathologists for decades. See Jaffe Ex. 13 at 649 (teaching pathologists to  
9 divide images into grids or tiles). And, adding grid markings on microscope eye  
10 pieces (a “reticle” or “reticule”) is a well-understood and routine technology,  
11 allowing scientists to separate out microscope slides into “tiles.” *Id.*; see also Ex.  
12 14 at 6-9; Ex. 15 at 8-11. As these examples demonstrate, the claimed method is  
13 something human pathologists can *and have* performed manually for decades.

14 Separating digital images into separate “tiles” for individual analysis on a  
15 computer is also a routine and well-understood activity—U.S. Patent Pub. No.  
16 2006/0064248A1, cited on the face of the ’097 Patent, discloses “partitioning” a  
17 tissue image into “non-overlapping blocks” for grading and diagnosis. See Jaffe Ex.  
18 16 at [0013], FIG. 6. Similarly, Coudray, et al., “Classification and mutation  
19 prediction from non-small cell lung cancer histopathology images using deep  
20 learning,” bioRxiv 23 (Oct. 2017), cited by the Tissue Analysis Patents, also  
21 discusses taking whole image slides of stained tissues and dividing them into tens to  
22 thousands of tiles per slide. Jaffe Ex. 17 at 5.

23 Tempus alleges that the ’097 Patent is inventive because its claimed  
24 inventions result in “reduce[d] computational redundancy” and “greater processing  
25 efficiency.” Compl., ¶ 67 (citing ’097 Patent at 6:54-56). But the Federal Circuit  
26 has made clear that the “improved speed or efficiency inherent with applying the  
27 abstract idea on a computer” cannot supply the inventive concept at *Alice* step two.  
28 *Intell. Ventures I LLC v. Cap. One Bank (USA)*, 792 F.3d 1363, 1367 (Fed. Cir.

1 2015). Similarly, Tempus’s allegations that the specification of the ’097 Patent  
2 recites an unconventional and innovative “multi-tile algorithm” are irrelevant. Even  
3 if the Court were to take that allegation as true, nothing in the claim language  
4 actually recites any such “multi-tile algorithm,” and *Alice* step two requires the Court  
5 to “avoid importing concepts from the specification into the claims.” *Longitude*,  
6 2025 WL 1249136 at \*4 (citation omitted). At best, ’097 Patent claim 1 merely  
7 claims the generic concept of “analyzing many tiles and their surroundings  
8 concurrently instead of separately analyzing each tile” (Compl., ¶ 70), but this is no  
9 more than the abstract idea of analyzing visual information—in this case in and  
10 around a part of an image. Tempus’s remaining allegations that the ’097 Patent is  
11 innovative are all conclusory or irrelevant and do not raise any valid factual dispute.  
12 *See* Section IV(C), *infra*.

13 **3. Claim 1 of the ’097 Patent is Representative of the ’097**  
14 **Patent.**

15 Claim 1 of the ’097 Patent is representative of all claims of the ’097 Patent.  
16 Courts may treat certain claims as representative where the other claims are  
17 “substantially similar and linked to the same abstract idea.” *Longitude*, 2025 WL  
18 1249136 at \*4 (citation omitted). Thus, where each claim “is directed to the same  
19 abstract idea,” the Court is “not required to separately address ... ‘trivial variations  
20 of the abstract idea’ claimed by [the other claims].” *Id.* at \*5 (quotation omitted).

21 Independent claim 6 of the ’097 Patent recites the same elements as claim 1,  
22 but with the additional limitations of “determining a predicted class for each tile  
23 based at least in part on the features of the tile and the structural tissue features of  
24 the second portion of the digital image of the slide” and “assigning the tile [a]  
25 predicted class ....” ’097 Patent at cl. 6. These limitations are simply “trivial  
26 variations” of the same abstract idea of analyzing visual information. *Longitude*,  
27 2025 WL 1249136 at \*5 (citation omitted). “Determining a predicted class” is not  
28 meaningfully different from “identifying the majority class of tissue” recited in

1 claim 1, and “assigning a predicted class” merely recites displaying the results of  
2 that analysis. Similarly, the dependent claims recite additional limitations such as  
3 the resolution of the image, what kinds of tissues are being analyzed, or how those  
4 results are displayed. None of these limitations change the underlying “inventive  
5 focus” of the claims—dividing and analyzing visual information—and do not recite  
6 any “inventive concept” beyond routine and conventional activities.

7 **4. Claim 1 of the '097 Patent is Representative of the '041**  
8 **Patent.**

9 The Court should also treat claim 1 of the '097 Patent as representative of the  
10 claims of the related '041 patent. Independent claim 1 of the '041 Patent recites  
11 substantially the same elements as claim 1 of the '097 Patent, with two differences.

12 First, instead of reciting digital images of stained tissue slides generally, '041  
13 Patent claim 1 recites a “digital image of a hematoxylin and eosin (H&E) stained  
14 slide.” '041 Patent at cl. 1. Because “limiting the use of an abstract idea to a  
15 particular technological environment” is insufficient for patent eligibility, this  
16 limitation does not change the underlying abstract idea. *Alice*, 573 U.S. at 223  
17 (cleaned up, citation omitted). And the '041 Patent’s specification confirms that  
18 using H&E dyes to stain tissue slides and then analyzing those stained tissue slides  
19 is well-understood, conventional, and routine mental activity that pathologists have  
20 done for decades. *See* '041 Patent at 2:47-52, 15:14-30; Compl., ¶¶ 48-49; Jaffe Ex.  
21 11 at 201-02. Accordingly, this limitation is nothing more than a “trivial variation[]  
22 of the abstract idea.” *Longitude*, 2025 WL 1249136, at \*5 (citation omitted).

23 Second, claim 1 of the '041 Patent recites analyzing the recited tissue slide  
24 using “a deep learning framework comprising one or more trained biomarker  
25 classification models” and “one or more trained deep learning multiscale classifier  
26 models.” '041 Patent at cl. 1. But as the Federal Circuit recently held in *Recentive*,  
27 a patentee cannot “rely on the use of generic machine learning technology in carrying  
28 out the claimed methods” to avoid patent-ineligibility. 134 F.4th at 1212. Like in

1 *Recentive*, claim 1 of the '041 Patent “is not claiming machine learning itself” or any  
2 specific improvement to machine learning. *See e.g.*, '041 Patent at 12:21-25 (the  
3 claimed deep learning models may be implemented using any number of artificial  
4 intelligence engines including “gradient boosting models, random forest models,  
5 neural networks (NN), regression models, Naive Bayes models, or machine learning  
6 algorithms (MLA).”). Instead, claim 1 only recites the use of generic machine  
7 learning technology to carry out the claimed method of identifying biomarkers in  
8 tissue slides—a longstanding mental process previously performed by human  
9 pathologists. *See also Dental Monitoring*, 2024 WL 2261931 at \*4 (finding claims  
10 recited method “conventionally performed by an orthodontist, via in-person visual  
11 inspection,” and recitation of a deep learning device did not change the fact that the  
12 “focus of the claim itself remains the abstract idea[.]”).

13 Nor does Tempus have any credible argument that the addition of generic  
14 “deep learning” supplies an inventive concept at *Alice* step two. As a preliminary  
15 matter, Tempus’s own complaint admits that using AI (*i.e.*, deep learning) to  
16 “analyze [tissue] slides and classify the tissue components by tissue class” is  
17 “conventional.” *See Compl.*, ¶ 65. Similarly, the '041 Patent cites to U.S. Patent  
18 No. 6,463,438 (“Veltri”) on its face, which described and claimed methods of using  
19 neural networks (*i.e.* machine learning) to analyze images of tissue slides to identify  
20 abnormalities. *Jaffe Ex. 18*. Veltri issued in 2002, and claims priority to an  
21 application filed in 1994—decades before the Asserted Patents were filed.

22 Courts have also found that generic recitations of machine learning models  
23 (such as claim 1’s recitation of “biomarker classification models”) are conventional  
24 and well-known in the art. *See e.g., Recentive*, 134 F.4th at 1214-15 (affirming  
25 district court finding that generic recitation of machine learning is insufficient to  
26 state an inventive concept at *Alice* step two); *Hyper Search, LLC v. Facebook, Inc.*,  
27 No. 17-1387, 2018 WL 6617143, at \*10 (D. Del. Dec. 17, 2018) (finding that generic  
28 recitation of a “neural network module” was not inventive, because neural networks

1 are well-known in the art and conventional); *Dental Monitoring*, 2024 WL 2261931  
 2 at \*7 (neural networks are generic and conventional computer technology).

3 Finally, the other claims of the '041 Patent are also not meaningfully distinct,  
 4 and also recite only trivial variations of the abstract idea. Independent claims 23,  
 5 26, and 27 of the '041 Patent recite the same method steps as claim 1, with additional  
 6 steps of determining the tissue class of certain tiles, and discarding certain tiles based  
 7 on that classification. These limitations do not change the underlying focus of the  
 8 claims as directed to collecting and analyzing visual information. Dependent claims  
 9 2-4, 6-8, 11, 29-30 recite limitations such as labelling the slides or tiling the image  
 10 in specific shapes, claims 13, 18-22, 25 recite applying the claimed method to  
 11 specific biomarkers, and dependent claims 5, 9-10, 12, 17 recite different machine  
 12 learning models or computer hardware. None of these limitations are meaningfully  
 13 distinct, as they do not change the claimed focus of the patent.

14 **B. The Data Storage Patents ('859 and '839 Patents)**

15 **1. *Alice* Step 1: Representative Claim 1 of the '859 Patent is**  
 16 **Directed to a Patent-Ineligible Abstract Idea.**

17 Claim 1 of the '859 Patent is also directed to a classic abstract idea the Federal  
 18 Circuit has repeatedly held ineligible. Specifically, collecting, storing, and  
 19 organizing information (here, patient data). As shown below, each element of claim  
 20 1 is focused on this abstract idea:

'859 Patent Claim 1 Element	Abstract Focus
<i>storing</i> a set of user application programs wherein each of the programs requires an application specific subset of data to perform application processes and generate user output;	<i>Storing</i> information (programs)
for each of a plurality of patients that have cancerous cells and that receive cancer treatment: (a) <i>obtaining clinical records data</i> in original forms where the clinical records data includes cancer state information, treatment types and treatment efficacy information;	<i>Collecting</i> information (patient data)

1	(b) <i>storing the clinical records data</i> in a semi-structured first database;	Storing information
2	(c) for each patient, using a next generation genomic sequencer to <i>generate genomic sequencing data</i> for the patient's cancerous cells and normal cells;	Collecting information (sequencing data)
3	(d) <i>storing the sequencing data</i> in the first database;	Storing information
4	(e) <i>shaping</i> at least a subset of the <i>first database data</i> to generate system structured data including clinical record data and sequencing data wherein the system structured data is optimized for searching;	Organizing information
5	(f) <i>storing the system structured data</i> in a second database;	Storing information
6	(g) for each user application program:	Selecting and storing information
7	(i) <i>selecting the application specific subset of data</i> from the second database; and (ii) <i>storing the application specific subset of data</i> in a structure optimized for application program interfacing in a third database.	

14 The '859 Patent's "claimed advance" over the prior art is a system for  
15 collecting and organizing various aspects of a patients' health data. *Id.* at 1:30-37;  
16 *see also* Compl., ¶¶ 29-33 (Data Storage Patents directed to "a new way of better  
17 *capturing* and *organizing* ... health data." (emphasis added)). The '859 Patent  
18 describes how, in cancer treatments, genetic factors may result in different patient  
19 reactions to the same treatments. *Id.* at 3:50-4:29. Thus, there is a need for large  
20 scale cause and effect analysis between treatment outcomes and genetic data. *Id.*  
21 Several purported challenges impeded efforts to develop large scale cause and effect  
22 analysis between genetics and treatment efficacy, including for example, a lack of  
23 standardized guidelines for capturing and storing patient data (including genomic  
24 sequencing data from next generation sequencers (NGS)). *See e.g. id.* at 5:4-6:42.  
25 Additionally, existing prior art databases were "incapable of optimally supporting  
26 different types of system users" such that databases designed for one type of user  
27 (*e.g.*, physicians) could not easily be adapted for use by other users. *Id.* at 9:4-21.  
28 To purportedly solve these alleged problems, the '859 Patent states that "what is

1 needed is a system that is capable of efficiently *capturing all treatment relevant*  
2 *data*” such as a patient’s health information, treatment information, and sequencing  
3 information, “and *structuring that data* to optimally drive different system activities  
4 ....” *Id.* at 9:43-55 (emphasis added). Accordingly, the ’859 Patent discloses and  
5 claims the general idea of “obtaining” patients’ clinical records and genomic  
6 sequence data and forming “semi-structured” and “structured” databases of this data.  
7 *See id.* at 11:1-25; 12:30-45; cl. 1.

8 As the above chart demonstrates, each recited step of the claimed method, and  
9 the overall “inventive focus” of the claim, is on *collecting, storing, and/or*  
10 *organizing* information (*i.e.*, “shaping,” “structuring,” or “selecting”). It is well-  
11 established that such claims, directed to the collection, analysis, and organization of  
12 information are “within the realm of abstract ideas.” *Elec. Power Grp.*, 830 F.3d at  
13 1353 (collecting cases); *see also Geoscope*, 2025 WL 1276235 at \*2 (claims directed  
14 to determining the location of a mobile device by collecting information about  
15 known locations and organizing that information in a database are abstract); *BSG*  
16 *Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1286 (Fed. Cir. 2018) (finding  
17 “asserted claims are directed to the abstract idea of considering historical usage  
18 information while inputting data.”); *In re Salwan*, 681 F. App’x 938, 941 (Fed. Cir.  
19 2017) (invalidating claims “directed to the abstract idea of ... organizing patient  
20 health information.”). Claim 1 of the ’859 Patent is directly analogous to those  
21 invalid claims—it recites the collection, storage, and organization of patient  
22 information on conventional computers, in ways that does not “change its character  
23 as information.” *Elec. Power Grp.*, 830 F.3d at 1353.

24 Claim 1 of the ’859 Patent is also drafted in functional, results-oriented  
25 language, confirming its abstract nature. It merely recites using generic computer  
26 components (*e.g.*, “user application programs,” “databases”) to perform  
27 conventional computer processes (“obtaining” “storing,” “shaping,” and  
28 “selecting”) patient data, without supplying any practical detail (*e.g.*, how the data

1 is “shaped” or “selected,” or what the databases “structure[s]” are). The Federal  
2 Circuit has repeatedly rejected claims reciting similar language as being patent in-  
3 eligible. *See, e.g., Geoscope*, 2025 1276235 at\* 4 (finding abstract claims reciting  
4 “generating” grid points using “calibration data” but “do not explain how the  
5 claimed grid points are generated from calibration data, much less suggest that any  
6 new technology is used during this generation process.”); *Hawk Tech. Sys., LLC v.*  
7 *Castle Retail, LLC*, 60 F.4th 1349, 1357 (Fed. Cir. 2023) (“receiving, displaying,  
8 converting, storing, and transmitting digital video ‘using result-based functional  
9 language’” is abstract. (citation omitted)).

10 This functional claim language also distinguishes ’859 Patent claim 1 from  
11 patent-eligible improvements to computer technology, such as the claims in *Enfish*,  
12 *LLC v. Microsoft Corp.*, 822 F.3d 1327, 1337 (Fed. Cir. 2016). The Federal Circuit’s  
13 decision in *BSG Tech.*, which usefully distinguished *Enfish*, illustrates the  
14 difference. In *BSG Tech.*, the court found patent-ineligible analogous patents  
15 directed to methods of “indexing and retrieving data” using specific database  
16 structures. *See generally* 899 F.3d 1281. The court noted that while the self-  
17 referential tables claimed in *Enfish* functioned differently from conventional  
18 databases, “the focus of BSG Tech’s claims is unrelated to how databases function”  
19 and “[u]nder the claimed methods, information inputted by users into a database is  
20 stored and organized in the same manner as information inputted into conventional  
21 databases[.]” *Id.* at 1288. Here too, claim 1 of the ’859 Patent does not relate to  
22 how databases function, and the patient data is inputted and stored in the databases  
23 in the same manner as conventional databases.<sup>4</sup> And while claim 1 recites “shaping”  
24 the database into “structure[s],” it recites no detail as to how such “shaping” is  
25 accomplished or what those structures are, or how those unspecified structures  
26

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27 <sup>4</sup> This fact is confirmed by Tempus’s accusation of, for example,  
28 GuardantINFORM, merely by virtue of it being a database containing patient data.  
*See* Dkt. 1-7 at 14.

1 improve the functionality of the *database*. Rather, as described by the patent, the  
2 focus of the claimed advance here is the abstract result of collecting health  
3 information, storing that information in databases, and “shaping” that information  
4 into unspecified “structures.” *E.g.*, ’859 Patent at cl. 1.

5 Finally, this conclusion is reinforced by another “telltale sign of  
6 abstraction”—each step of the claimed method is a “mental process that can be  
7 performed in the human mind or using a pencil and paper.” *Trinity*, 72 F.4th at 1361-  
8 62 (cleaned up) (citation omitted). A human with a pencil and paper, could “obtain  
9 clinical records” and “store [those] clinical records” in a database (*i.e.*, spreadsheet).  
10 Likewise, a human could “us[e] a next generation sequencer to generate genomic  
11 sequencing data” and store that sequencing data in a database. And finally, a human  
12 could “shape” the data in the database to generate “structured” data, and selectively  
13 “store” that structured data in databases. ’859 Patent claim 1 recites nothing more  
14 than implementing these abstract mental processes on generic computer hardware.

15 **2. *Alice* Step 2: Claim 1 of the ’859 Patent Fails to Recite Any**  
16 **“Inventive Concept.”**

17 At *Alice* step two, claim 1 of the ’859 Patent fails to recite an “inventive  
18 concept” sufficient to transform it from a patent-ineligible abstract idea.

19 Individually, the elements of ’859 Patent claim 1 are all well-understood and  
20 routine computer technologies. Elements such as “user application programs” or  
21 “databases” are nothing more than generic computer components that are well-  
22 understood in the art. *See* ’859 Patent at 43:20-52 (describing user application  
23 programs as conventional computer programs to facilitate *e.g.*, oncological diagnosis  
24 and treatment). Similarly, using next generation sequencing (NGS) to obtain patient  
25 sequencing data is a conventional, well-understood, and routine activity. *Jaffe Ex.*  
26 *19*;<sup>5</sup> *see also CareDx, Inc. v. Natera, Inc.*, 563 F. Supp. 3d 329, 345 (D. Del. 2021)

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27 <sup>5</sup> Dienstmann, et al., “Standardized decision support in next generation  
28 sequencing reports of somatic cancer variants,” *Mol. Oncol.*, 8:859-873 (2014) is  
also cited on the face of the ’859 Patent and thus part of the intrinsic record.

1 (rejecting argument that “NGS” was unconventional, and finding that it was well  
2 known in the art) *aff’d*, 40 F.4th 1371 (Fed. Cir. 2022).

3 Claim 1 of the ’859 Patent also fails to recite an inventive concept as an  
4 ordered combination, as the only arguable inventive concept here is nothing more  
5 than the abstract idea itself. Tempus alleges that ’859 Patent claim 1 is inventive  
6 because it is directed to “nonconventional, non-routine methods ... that impose  
7 specific requirements for arrangement and relationship on the stored data[,]”  
8 enabling “smaller sub-databases including application and research specific data sets  
9 ... which ultimately speeds up the data access and manipulation processes.” Compl.,  
10 ¶¶ 32-35. This simply restates the fundamental abstract idea of collecting and  
11 organizing patient data; a claim cannot be patentable under *Alice* step two if “[i]f a  
12 claim’s only ‘inventive concept’ is the application of an abstract idea using  
13 conventional and well-understood techniques.” *Angel Techs. Grp., LLC v. Meta*  
14 *Platforms, Inc.*, No. 22-2100, 2024 WL 4212196, at \*5 (Fed. Cir. Sept. 17, 2024)  
15 (quoting *BSG Tech*, 899 F.3d at 1290-91). Tempus “has identified nothing  
16 ‘significantly more’ than the application of abstract ideas using generic computer  
17 components, which is not sufficient to transform the nature of the claim into a patent-  
18 eligible application of the abstract idea.” *Id.*

19 **3. Claim 1 of the ’859 Patent is Representative of the Data**  
20 **Storage Patents.**

21 Claim 1 of the ’859 Patent is representative of all claims of the Data Storage  
22 Patents. There is no distinctive significance between claim 1 of the ’859 Patent and  
23 any other claim of the ’859 Patent. Independent claim 81 recites substantially the  
24 same method steps as claim 1 and relates to the same underlying abstract idea of  
25 collecting and organizing patient information. Dependent claims 2-10 recite the  
26 additional step of using “micro-service” programs to “shape” or “structure” the data,  
27 but such programs are nothing more than existing and well-understood computer  
28 programs that run independently on software. *See* ’859 Patent at 9:59-10:6.

1 Dependent claims 13-80 are just “trivial variations” of independent claim 1 as  
2 applied to specific purposes (*e.g.*, use by pathologist, radiologist) or specific types  
3 of data (*e.g.*, sequencing on specific types of cells or genes) and do not meaningfully  
4 change the underlying focus: collecting and organizing patient data.

5 Tempus’s Complaint alleges that dependent claims 11 and 12 “further  
6 highlight the claimed invention’s novelty” (Compl., ¶ 40), but these claims are also  
7 not meaningfully distinct for patent eligibility purposes. Claim 11 merely recites an  
8 application of claim 1 wherein the “application programs” include a subset of  
9 “physician suite of programs useable to consider cancer state treatment options,”  
10 while claim 12 requires the programs also to include programs “usable...to shape  
11 data stored in the first database.” These claims do not change the purported  
12 invention’s claimed focus—methods of collecting, storing, and organizing patient  
13 data. Nor do they recite an inventive concept; the recited physician and operation  
14 programs are no more than conventional and generic computer programs, designed  
15 for specific purposes (cancer treatment and data shaping).

16 Claim 1 of the ’859 Patent is also representative of the ’839 Patent. Tempus’s  
17 own Complaint describes both patents as directed to the same subject matter. *See*  
18 Compl., ¶ 23 (“The ’839 and ’859 Patents generally disclose and claim methods for  
19 storing and structuring clinical and genomic sequencing patient data for specific  
20 application programs.”), ¶ 38 (admitting that claim 1 of the ’839 Patent recites  
21 similar elements as the ’859 Patent). Independent claims 1, 19, and 20 of the ’839  
22 Patent recite the same method steps as ’859 Patent claim 1, with only an added  
23 limitation that the stored “user application programs” “generates a *respective*  
24 *genomic variant characterization*” as opposed to generic user output. *Compare* ’859  
25 Patent cl. 1 *with* ’839 Patent cl. 1 (emphasis added). This change is not meaningful;  
26 it merely requires that the method store a “user application program” that generates  
27 a more specific type of output, but does not change the claimed focus of the  
28 invention—collecting, storing, and organizing patient data. Likewise, and contrary

1 to Tempus’s allegations, dependent claim 2’s recitation that this program comprises  
2 “a machine learning algorithm or neural network” does not render the claim non-  
3 abstract. Again, this limitation requires *only* that the claimed method store a specific  
4 type of “user application program,” here a trained machine learning or neural  
5 network model. This has nothing to do with the actual claimed focus of the  
6 invention—collecting, storing, or organizing patient data.

7 The patents’ prosecution history reinforces this conclusion. The ’839 Patent  
8 is a continuation of U.S. Application No. 16/657,804 (the ’804 App.”), which issued  
9 as U.S. Patent No. 11,705,226. Compl., ¶ 21. On January 6, 2023, the applicant of  
10 the ’804 App. filed a terminal disclaimer over U.S. Application No. 16/771,451,  
11 which issued as the ’859 Patent. *See id.*, ¶ 22. A terminal disclaimer “offers support  
12 for the ... conclusion” that the ’859 Patent is representative, “because it ‘is a strong  
13 clue that a patent examiner and, by concession, the applicant, thought the claims in  
14 the continuation lacked a patentable distinction over the parent.’” *PPS Data, LLC*  
15 *v. Jack Henry & Assocs., Inc.*, 404 F. Supp. 3d 1021, 1034 (E.D. Tex. 2019) (quoting  
16 *SimpleAir, Inc. v. Google LLC*, 884 F.3d 1160, 1168 (Fed. Cir. 2018)).

17 **C. Tempus’s Allegations in the Complaint Do Not Raise Any Factual**  
18 **Issues Preventing Dismissal.**

19 Guardant expects Tempus to argue that its allegations in the Complaint raise  
20 factual issues that preclude dismissal under Rule 12(b)(6). Not so. The Federal  
21 Circuit has repeatedly affirmed that patent eligibility may be resolved at the motion  
22 to dismiss stage. *See Cleveland Clinic*, 859 F.3d at 1360 (collecting cases). Here,  
23 the Complaint’s allegations should not preclude dismissal, as they are all either  
24 conclusory, irrelevant, or contradicted by the intrinsic record. For instance, Tempus  
25 asserts that the Asserted Patents are directed to “specific, nonconventional, [and]  
26 non-routine methods” but then simply repeats the claim language. *See Compl.*,  
27 ¶¶ 33, 54-55, 66, 71. Such allegations are no more than legal conclusions that the  
28 Court should properly disregard on Rule 12(b)(6). *See Simio*, 983 F.3d at 1365

1 (disregarding conclusory allegations of patent eligibility under Rule 12(b)(6)).  
2 Similarly, Tempus alleges that the Asserted Patents’ specifications disclose specific  
3 inventive solutions to problems in the prior art, but even “groundbreaking,  
4 innovative, or ... brilliant” abstract ideas are patent-ineligible. *SAP Am., Inc. v.*  
5 *InvestPic, LLC*, 898 F.3d 1161, 1163 (Fed. Cir. 2018) (citation omitted); *see also*  
6 *Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1151 (Fed. Cir. 2016)  
7 (“[A] claim for a *new* abstract idea is still an abstract idea.”). As the above  
8 discussions demonstrate, any such “improvements” are essentially patent-ineligible  
9 abstract ideas, and the intrinsic record of the Asserted Patents confirm that the recited  
10 elements are conventional, routine, and well-understood in the art. Allegations that  
11 contradict that intrinsic record cannot raise a factual issue on a motion to dismiss.  
12 *See Secured Mail Sols. LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 913 (Fed. Cir.  
13 2017). And allegations highlighting specific examples from the patents’  
14 specification (*see e.g.*, Compl., ¶¶ 31, 70) are irrelevant as the §101 inquiry must  
15 focus on the *claim* language, and Court should “avoid importing concepts from the  
16 specification into the claims.” *Longitude*, 2025 WL 1249136 at \*4 (citation omitted).

17 Finally, Tempus’s allegations that the PTO allowed the Asserted Patents are  
18 irrelevant. “[A] patent examiner’s consideration of Section 101 issues does not ‘in  
19 any way shield the patent’s claims from Article III review for patent eligibility.’”  
20 *Beteiro, LLC v. DraftKings Inc.*, 104 F.4th 1350, 1359 (Fed. Cir. 2024) (citation  
21 omitted). District Courts regularly decline to consider PTO findings on subject  
22 matter eligibility. *See e.g., Recentive Analytics, Inc. v. Fox Corp.*, 692 F. Supp. 3d  
23 438, 449 (D. Del. 2023), *aff’d*, 134 F.4th 1205 (Fed. Cir. 2025); *Luxer Corp. v.*  
24 *ButterflyMX, Inc.*, No. 24-cv-602, 2025 WL 417008, at \*7 (D. Del. Feb. 6, 2025).

25 **V. CONCLUSION**

26 For the foregoing reasons, Guardant respectfully requests that the Court  
27 dismiss Tempus’s Complaint under Rule 12(b)(6), on the ground that the claims of  
28 the Asserted Patents are directed to patent-ineligible subject matter.

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