



## District Court Denied Rule 12(b)(6) Motion Based on Section 101 Because Additional Facts and Claim Construction Would Provide Informative Value to Patent-Eligibility Question

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Plaintiff Fortinet sued Forescout Technologies for infringing U.S. Patent Nos. 8,458,314, 9,369,299, and 9,948,662, which are directed to network access control security technology. Forescout challenged the patents as claiming ineligible subject matter—specifically, arguing that the patents were directed to the “abstract idea of controlling access to a network.”

The court analyzed each patent using the U.S. Supreme Court’s two-step *Alice* framework. At step one, a court determines whether the claims are “directed to” a patent-ineligible concept, such as an abstract idea. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 573 U.S. 208, 217 (2014). If it is, the court moves to step two, considering “the elements of each claim both individually and ‘as an ordered combination’ to determine whether [any] additional elements ‘transform the nature of the claim’ into a patent-eligible application” of the ineligible subject matter. *Id.* The crux, at this step, is whether “the elements of [a] claim both individually and ‘as an ordered combination’” go beyond “‘well-understood, routine, conventional activit[ies]’ previously known to the industry.” *Id.* at 225.

### The ’314 Patent

The ’314 Patent is directed to “a method of delegating control of computer network access from network administrators to sponsors’ through the creation of digital ‘templates and profiles that associate network users with a sponsor.’” Addressing *Alice* step one, the court stated that eligibility turned on “whether the focus of the claims is 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.” Applying an abstract idea on a generic computer, for example, does not satisfy step one, nor does limiting the invention to a technological environment such as the Internet. The court found the claims here involved the abstract idea of “controlling [network] access by delegating authority” and were not directed to improving the functionality of a computer or network platform itself. While Fortinet argued that the claims provided a technological solution by enhancing system security, minimizing the risk of errors and abuse, and benefitting from department-specific knowledge, the court disagreed. These benefits were inherent to the abstract idea of controlling access and delegating authority—features which do not even require a computer.

Proceeding to *Alice* step two, the parties disputed whether the claims’ key components—the “templates” and “profiles”—entail more than well-understood, routine, conventional activities previously known to the industry. Fortinet argued they were not, and that this was a fact question precluding dismissal under Rule 12(b)(6). Forescout argued these components were merely generic or functional abstractions. It analogized these abstractions to “a set of software and hardware components” in a computer system that analyzed a user’s security level to determine whether to allow network access—a functional abstraction that the Federal Circuit found to be a “black box” that failed “to describe **how** to solve the problem” it purportedly addressed. *Dropbox, Inc. v. Synchronoss Techs., Inc.*, 855 Fed. Appx. 529, 533 (Fed. Cir. 2020). The court found Forescout’s argument plausible and noted that the patent and Fortinet failed to explain how the templates and profiles actually worked—i.e., **how** these components solved the problem they purportedly addressed. Yet, the court declined to hold the claims patent ineligible under § 101. The court stated it could not conclude, at this juncture, the factual determination that these components, and their ordered combination, were well-understood, routine, conventional activities. The court also decided against early adjudication because of the potential informative value of claim construction.

## The ’299 Patent

The ’299 Patent is directed to “a system for out-of-band control of network access,’ featuring such technological components as ‘a server device,’ a ‘terminal device,’ a ‘remote access device,’ and a ‘network access filter.’” The court declined to determine at *Alice* step one whether the claims recite a technological solution to a technological problem. Significantly, the court found that the technical jargon of the claims was difficult to parse, and both the meaning and structure of the patent’s key components (e.g., “remote access device” and “network access filter”) remained vague. Given these uncertainties, the court found that the

patent-eligibility question could be “answered more confidently with additional facts and claim construction.”

## The '662 Patent

The '662 Patent is directed to “a method of providing security in a communication network” whereby “a network security device selectively disables application of security features based on a trust level associated with [an] external network.” At *Alice* step one, Fortinet asserted that the claims solve a “technical problem that occurs when security features are deployed indiscriminately to out-of-network traffic streams.” The patent, according to Fortinet, solves this problem “by selectively disabling and enabling security features on traffic streams based on the trust level of the destination”—and, in turn, providing “higher system performance” through “optimize[d] utilization of the system resources.” Forescout, on the other hand, asserted that relaxing security measures for trusted users is “an abstract and longstanding human activity” and the purported benefits to performance were merely incidental. Here, the court agreed with Forescout. The claims were directed to “the abstract idea of disabling security for trusted communication”—i.e., “a method of organizing human activity.”

Turning to *Alice* step two, the court concluded that the issues disputed by the parties represent “exactly the type of fact question” that cannot be resolved at this early stage of litigation. Fortinet argued that certain dependent claims further explain the content and structure of claimed steps and the specification “describes how the specific claimed methods address shortcomings in ‘conventional methods and systems.’” Forescout argued that the specification failed to describe anything more than the claimed components performing basic computer functions or functions known in the art. It also noted that the patent does not require special hardware nor disclose novel hardware. The court, however, found the parties’ dispute underscores “the potential value of claim construction and development of facts that may inform the § 101 analysis.”

Accordingly, the court denied without prejudice Forescout’s Rule 12(b)(6) motion to dismiss computer-implemented claims as patent-ineligible abstract ideas under § 101.

## Practice Tip:

When challenging computer-implemented claims under § 101 at the Rule 12(b)(6) stage, defendants should avoid being drawn into questions of fact and claim construction. On the other hand, when facing such challenges, patent owners should avoid oversimplification of

the claims, showing how they recite a technological improvement or inventive concept and the potential value of claim construction.

*Fortinet, Inc. v. Forescout Technologies, Inc.*, No. 20-cv-03343-EMC (N.D. Cal. Nov. 2, 2020)

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