No. 19-571

IN THE
Supreme Court of the United States

INTEL CORPORATION, IBIDEN U.S.A. CORPORATION, AND IBIDEN COMPANY LIMITED,

Petitioners,

v.

CONTINENTAL CIRCUITS LLC,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF THE HIGH TECH INVENTORS ALLIANCE AS AMICUS CURIAE IN SUPPORT OF PETITION FOR CERTIORARI

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INTEREST OF THE AMICUS CURIAE[1]

The High Tech Inventors Alliance ("HTIA") is a coalition of high technology companies that was created to advocate on patent law and policy issues.[2] HTIA members are some of the most innovative technology companies in the world, creating the computer, software, semiconductor, and communications products and services that support growth in every sector of the economy. HTIA members invest approximately $75 billion in research and development each year and collectively hold more than 175,000 patents.

HTIA is a strong supporter of the patent system and of effective patent protection. At the same time, its members—like many successful technology companies—have frequently been defendants in suits brought by increasingly sophisticated non-practicing entities seeking a return on litigation as a portfolio investment strategy.

HTIA supports this petition because its members and other technology companies are harmed by the

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[1] Counsel of record for all parties have consented to Amicus Curiae filing this brief pursuant to S. Ct. R. 37(2)(a). No counsel for any party had any role in authoring this brief, and no one other than the Amicus Curiae provided any monetary contribution to its preparation or submission.

[2] HTIA is described at https://www.hightechinventors.com/. HTIA members are Adobe, Amazon.com, Cisco, Dell, Google, Intel, Microsoft, Oracle, and Salesforce. Petitioner Intel did not participate in this brief.

decades-long divide at the Federal Circuit over how to construe a patent claim. This outcome-determinative divide discourages innovators from inventing around a patent's boundaries and businesses from reaching agreement on patent licenses. Importantly, it encourages patent holders to gamble by bringing speculative infringement allegations on patents that some Federal Circuit judges may read far more broadly than the invention described in the patent. Ending this divide will lessen one of the biggest problems plaguing our patent system today: creating a tax on innovators by unnecessary unpredictability that results in wasteful (and often meritless) litigation.

SUMMARY OF ARGUMENT

The Court recently tackled one cause of uncertainty in the scope of patent claims. For thirteen years, the Federal Circuit had applied too lax a standard for enforcing the Patent Act's clarity and precision demand against ambiguous, unclear or imprecise claims, 35 U.S.C. § 112(b). The Court rejected that standard in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014).

But a more fundamental cause of patent-scope uncertainty has existed even longer. "It is no secret among patent practitioners that panels on the [Federal Circuit] have at least two divergent approaches to claim construction, and that they use these approaches 'interchangeably.'" Amy Semet, *Specialized Trial Courts in Patent Litigation: A Review of the Patent Pilot Program's Impact on Appellate Reversal Rates at the Five-Year Mark*, 60 B.C. L. REV. 519, 561, 577 (2019).

For two decades, scores of Federal Circuit decisions have construed patents based on the *acontextual* meaning of their claim language, while scores of other Federal Circuit decisions have done the opposite, presumptively restricting claims to their *contextual* meaning. The particular interpretative school a given appeals panel favors, often determines who wins or loses a patent case. This divide exacerbates the widely acknowledged problems with our patent system today: uncertain patent scope, unnecessary unpredictability, and speculative lawsuits. More fundamentally, the resulting uncertainty in the scope of patented inventions makes them undecipherable to the engineers and scientists who are supposed to benefit from the patent system, and turns our patent system into a brake on innovation, instead of the engine of innovation it is designed to be.

This brief explains how this persistent divide harms the members of Amicus Curiae, other U.S. technology companies, and the proper and efficient operation of our patent system.

ARGUMENT

I. THE DIVIDE OVER CLAIM CONSTRUCTION IMPOSES WIDESPREAD COSTS EVEN APART FROM LITIGATION.

In the arena of patents, claim construction is all-important. It usually is dispositive of a patent dispute. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 989 (Fed. Cir. 1995) (*en banc*) (Mayer, J., concurring) ("[T]o decide what the claims mean is nearly always to decide the case."), *aff'd*, 517 U.S. 370 (1996); *see* Christopher A. Cotropia, *Patent Claim Interpretation Methodologies and Their Claim Scope*

Paradigms, 47 WM. & MARY L. REV. 49, 67 (2005) (claim construction is "often dispositive").

Unsurprisingly, therefore, the Federal Circuit's irreconcilable approaches to claim construction have contributed to a notorious lack of uniformity and predictability in patent disputes. *E.g.*, Greg Reilly, *Patent "Trolls" and Claim Construction*, 91 NOTRE DAME L. REV. 1045, 1047 (2016) ("An outcome-determinative split within the Federal Circuit as to the proper approach to claim construction creates significant uncertainty about claim scope that cannot be resolved without litigation."); Tun-Jen Chiang & Lawrence B. Solum, *The Interpretation-Construction Distinction in Patent Law*, 123 YALE L.J. 530, 534 (2013) ("The uncertainty in how courts will apply claims . . . most typically arises because judges have core policy disagreements about the underlying goals of claim construction.").

The uncertainty caused by this divide harms members of Amicus Curiae, other technology companies large and small, and our entire patent system.

First, patent-scope uncertainty creates inefficiencies and wastes resources generally, which is harmful to all business and innovation. It leads to a tax on innovators even in the absence of litigation. Every day patent-construction uncertainty confronts engineers, start-ups, in-house counsel, and investors dealing with technology investment decisions, product clearances, patent licensing, and patent infringement allegations.

Consider a technology company, such as a member of Amicus Curiae, who receives an infringement allegation letter with a demand for a large royalty

from a patent owner. Upon review, the target quickly determines that the allegations are misplaced because its products work nothing like the invention described in the patent, and the patent distinguishes the methods used by the target company in the patent disclosure. However, the English language of the patent claims is quite broad, unlike the disclosure in the patent's specification. What now? In an efficient regime, no further work would need to be done; the target might inform the patent owner that its allegations are unfounded and proceed with its business. Under current law, however, the inquiry often doesn't end there. The patent owner argues that under "plain meaning" of the claims, the target infringes despite the fact that the specification makes clear that the patentee didn't invent what the target does. Also, given uncertainty as to how the claims will be construed, the target may feel compelled to document its subjective good faith to avoid a later finding of willful infringement. *See Halo Elecs. v. Pulse Elecs.,* 579 U.S. __, 136 S. Ct. 1923, 1933 (2016) (holding that "[t]he subjective willfulness of a patent infringer … may warrant enhanced damages"). In some cases, that documentation takes the form of a formal opinion of counsel. That opinion may need to take into account alternative claim constructions, considering questions of infringement if the claims are construed one way and invalidity if the claims are construed differently. This process gets very expensive very quickly, even if no litigation is ever filed, and with no concomitant benefit to society at large. Uncertainty in claim construction thus imposes widespread costs on Amicus Curiae members, other companies, and the economy as a whole, which are wholly apart from litigation and are impossible to fully measure.

A very similar problem routinely confronts the member technology companies of Amicus Curiae in a different context: indemnification demands from customers, partners, and suppliers. In multi-component and multi-feature technology products—where the components or features may number in the hundreds or thousands—it is essential to know with reasonable certainty the scope of a patent's claims, in order to identify which technology suppliers or users are responsible under governing indemnification agreements. Enormous sums of money and time are wasted where the parties involved cannot be certain which of the two conflicting claim-construction methodologies will be applied.

Second, uncertainty in patent claim scope impedes the critical work of innovation performed by members of Amicus Curiae and others. Our patent system's first engine of innovation is the lure of monopoly profits incentivizing invention. But equally important is its second engine of innovation: clear patent boundaries incentivizing the next innovator to invent something new, outside the patent's boundary to avoid paying a royalty to the holder of the patent monopoly. But unclear claim boundaries turn this engine of innovation into a brake on innovation.

> The statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would

> discourage invention only a little less than unequivocal foreclosure of the field.

United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 236 (1942).

This harm to innovation no doubt is difficult to measure. Those discouraged by patent-scope uncertainty from embarking on innovation do not announce their decision to the world. They are not sued for patent infringement because they instead have settled for old technology, or paid the patent owner a royalty, rather than attempted to advance the technology. But this harm is real and undermines the foundational purpose of our patent system.

II. THE DIVIDE OVER CLAIM CONSTRUCTION ENCOURAGES LITIGATION AND DRIVES UP THE COSTS OF LITIGATION.

Uncertainty begets litigation. The uncertainty in claim construction increases the number of disputes that result in litigation because it prevents diligent counsel from drawing firm conclusions about the scope of patents even in good faith licensing negotiations. With more predictable claim construction, parties can predict the outcome of a dispute, reach agreement, and avoid litigation altogether. We know this because patent owners and alleged infringers–even today–often agree that claim construction is dispositive.

In this very case, Intel and Continental Circuits stipulated to final judgment after the claim construction ruling, and the issue on appeal was just the claim construction. This is not an uncommon

circumstance. The following cases for just one of the Amicus Curiae member companies (Microsoft) followed this same pattern, where *both* parties stipulated to a trial court judgment upon issuance of the trial court's claim construction ruling: *Eleven Eng'g, Inc. v. Microsoft Corp.*, 693 F. App'x 909 (Fed. Cir. 2017) (affirming stipulated judgment of non-infringement); *Gradient Enterprises, Inc. v. Skype Techs. S.A.*, No. 10-CV-6712L, 2015 WL 5567926 (W.D.N.Y. Sept. 22, 2015) (granting stipulated judgment of noninfringement, not appealed); *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 909 (Fed. Cir. 2014) (affirming stipulated judgment of non-infringement); *Buyerleverage Email Sols. LLC v. Microsoft Corp.*, 577 F. App'x 997 (Fed. Cir. 2014) (dismissing appeal of stipulated judgment of non-infringement); *Mass. Inst. of Tech. v. Abacus Software*, 462 F.3d 1344, 1347 (Fed. Cir. 2006) (vacating stipulated judgment of non-infringement); *see also Improved Search LLC v. Microsoft Corp.*, 387 F. Supp. 3d 422, 428 (D. Del. 2019) (noting, in granting patentee's motion for summary judgment of non-infringement, that "[t]he parties ha[d] essentially stipulated and consented to a final judgment of noninfringement").

Patent scope uncertainty leads to more patent litigation for a second reason: speculative lawsuits by non-practicing entities, including against members of Amicus Curiae, often are filed in the hopes of winning a very broad claim scope. "The Federal Circuit is deeply divided as to the proper approach to claim construction. This split is a significant contributor to uncertain patent scope, which is widely recognized as a core reason for the rise and success of patent assertion entities." Greg Reilly, *Patent "Trolls" and*

Claim Construction, 91 NOTRE DAME L. REV. 1045 (2016).

The split at the Federal Circuit also increases the costs and length of patent litigations, especially those in the technology industry. If there were only one governing claim-construction methodology, then not only would fewer litigations be filed, but more patent infringement lawsuits would settle after the trial court's claim-construction ruling. That ruling typically is early enough to avoid nearly two-thirds of the expense of litigating a patent case through trial. *See Litigation Cost Analytics*, https://insight.rpxcorp.com/analytics/cost (subscription required). Claim construction rulings come early in part because the busiest patent-litigation district courts recognize the often outcome-determinative importance of claim construction, and have special Local Rules governing claim-construction procedures and timing. In an environment with only one governing claim-construction methodology, in-house counsel and other decision makers at the respective parties can make reasonable business judgments, after the early claim construction ruling, about the settlement value of the case, relieved of uncertainty about which competing claim construction methodology would be applied on appeal.

But, today, the split at the Federal Circuit prolongs the length of patent litigations, especially those in the technology industry. Today, the common practice of patent owners when a district court construes the claims in the defendant's favor establishing non-infringement is to appeal the resulting judgment of non-infringement. Because two of the three appeals panel judges might favor a different claim-construction methodology than the

one selected by the district court, there is a good chance for reversal. *See* Christian E. Mammen, *Patent Claim Construction as a Form of Legal Interpretation*, 12 J. Marshall Rev. Intell. Prop. L. 40, 49 (2012) ("Claim construction rulings are seen as relatively volatile, unpredictable, and subject to second-guessing on appeal.").

One recent study found relatively higher reversal rates for patent appeals involving claim construction. Mark A. Lemley & Shawn P. Miller, *If You Can't Beat 'Em, Join 'Em? How Sitting by Designation Affects Judicial Behavior*, 94 TEX. L. REV. 451, 466 (2016). Another recent study of the patent pilot program found that 39% of the "primary mistakes" (identified by the Federal Circuit) for non-pilot trial judges, and 31% for pilot judges, is a claim construction reversed or modified on appeal. Amy Semet, *Specialized Trial Courts in Patent Litigation: A Review of the Patent Pilot Program's Impact on Appellate Reversal Rates at the Five-Year Mark*, 60 B.C. L. REV. 519, 561, 577 (2019). Many of these "mistakes" were guessing wrong about which of the two irreconcilable schools would be followed by the majority of the appellate panel.

It has been our experience that issues arising from ambiguous claim construction standards are particularly acute in the technology field. The following cases for Amicus Curiae members are representative of cases where the correct claim construction dictates non-infringement but the patent owner appeals: *Improved Search LLC v. Microsoft Corp.*, 387 F. Supp. 3d 422, 429 (D. Del. 2019) (granting summary judgment of non-infringement; appeal currently pending); *Baker v. Microsoft Corp.*, 726 F. App'x 800, 804 (Fed. Cir. 2018) (affirming summary judgment of non-infringement); *Eleven*

Eng'g, Inc. v. Microsoft Corp., 693 F. App'x 909 (Fed. Cir. 2017) (affirming stipulated judgment of non-infringement); *Impulse Tech. Ltd. v. Microsoft Corp.*, 665 F. App'x 872, 880 (Fed. Cir. 2016) (affirming summary judgment of non-infringement); *Nazomi Commc'ns, Inc. v. Microsoft Mobile OY*, 597 F. App'x 1075, 1078 (Fed. Cir. 2014) (affirming stipulated judgment of no literal infringement and summary judgment of non-infringement); *Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 909 (Fed. Cir. 2014) (affirming stipulated judgment of non-infringement); *Optimum Power Sol'ns LLC v. Hewlett Packard Co.*, 547 F. App'x 997 (Fed. Cir. 2013) (affirming stipulated judgment of non-infringement); *Fenner Investments, Ltd. v. Microsoft Corp.*, 369 F. App'x 132, 133 (Fed. Cir. 2010) (affirming summary judgment of non-infringement); *E-Pass Techs., Inc. v. Microsoft Corp.*, 231 F. App'x 950, 954 (Fed. Cir. 2007) (affirming summary judgment of non-infringement) *Prism Techs. v. Verisign, Inc.*, 263 F. App'x 878 (Fed. Cir. 2008) (affirming stipulated judgment of non-infringement).

Ending this divide will reduce the amount of patent litigation, and its cost.

III. THE ACONTEXTUAL PRESUMPTION MAKES PATENTS UNDECIPHERABLE BY ACTUAL INNOVATORS.

The acontextual-presumption school is wrong as a matter of statutory interpretation, this Court's precedents, how engineers read patents, how patents are drafted, and public policy.

First, the Patent Act defines the protected "invention" with relation to both the patent's claims and its specification. 35 U.S.C. § 154(a) provides that

each issued patent shall grant rights to exclude others from using, etc., "the invention," "referring to the specification for the particulars thereof." Section 112 requires both "a written description of the invention" (in the specification) and "claims particularly pointing out and distinctly claiming" the invention. To ignore the specification—as the acontextual-presumption school condones—cannot be reconciled with this statutory text.

Second, just five years ago this Court unanimously used contextual analysis for claim interpretation, holding "we read §112, ¶2 to require that a patent's claims, viewed in light of the specification and prosecution history, inform those skilled in the art about the scope of the invention with reasonable certainty." *Nautilus*, 572 U.S. at 910. While *Nautilus*, involved validity, the Court relied on several contextual-infringement precedents to support its contextual interpretation approach and has long rejected attempts to interpret claims differently for purposes of infringement and validity. The Court earlier explained the specification's role when construing a patent claim in context: "While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." *United States v. Adams*, 383 U.S. 39, 48–49 (1966). *See also* Pet. 21–24.

Third, patents primarily are written for engineers and scientists. As in-house counsel for the Amicus members know, engineers and scientists naturally start with the technical descriptions and drawings to understand the invention encompassed by the patent

claims. They do not start with the claims, dictionary in hand, to come up with a presumed definition of the patent's invention. Construing patent claims acontextually risks punishing companies with damages, injunctions and possibly willful infringement sanctions for their engineers and scientists doing exactly what our patent system encourages: reading patents and innovating new inventions outside the apparent boundaries of the patent's invention as *described* and claimed in the patent.

Fourth, the technical disclosures in a patent are drafted when the patent application is filed, close in time to the invention, and typically reviewed by the actual inventors. The patent's claims, on the other hand, often are drafted or amended years later by patent attorneys seeking broader patents, and often not reviewed by the actual inventors. This is another reason why it makes sense that the patent specification provides meaningful context for what was really invented.

Fifth, the contextual school promotes Constitutionally-based principles and public policies of the Patent Act: proportionality and particularity. To avoid patent applicants reaping monopoly profits where they did not sow innovation, the principle of proportionality limits patent claims to being no broader than the disclosed invention. To avoid patent claims from covering all possible ways of performing a function or achieving a result, the principle of particularity limits patent claims to the particular way (how) a claim-recited function or result is performed or achieved in the specification, and equivalents thereof. Each of these principles is

essential if our patent system is to be an engine of innovation, not a brake on innovation.

IV. THE DIVIDE IS REAL AND HAS LASTED FOR AT LEAST TWO DECADES.

Trial judges, Patent Office judges, attorneys, engineers, etc. all need to know how to construe a patent claim. But today they labor under two irreconcilably conflicting schools of patent claim interpretation embraced by the Federal Circuit.

The contextual school always looks to the patent's claims and specification *together* as part of a unitary legal document and seeks to capture the scope of the actual invention by reading the claims in light of the context of the entire specification. In the Federal Circuit, this contextual school dates back at least to 1999. *See Wang Labs., Inc. v. Am. Online, Inc.*, 197 F.3d 1377, 1383 (Fed. Cir. 1999) (affirming narrow claim construction: "[I]n order to be covered by the claims that subject matter must be sufficiently described as the applicant's invention to meet the requirements of section 112."). It was embraced by this Court long before the Federal Circuit was formed. *E.g.*, *United States v. Adams*, 383 U.S. 39, 48–49 (1966) ("While the claims of a patent limit the invention, and specifications cannot be utilized to expand the patent monopoly, it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.").

But this contextual school competes with a very different "acontextual-presumption school" endorsed by other Federal Circuit judges. This acontextual-presumption school applies at least a "heavy presumption" that the acontextual meaning of the

claim language—without regard to the scope of the disclosed invention—governs. Absent a clear and unequivocal disavowal of that scope in the specification or prosecution history, this school gives the claim that acontextual claim scope. In the Federal Circuit, this second school dates back also to at least 1999. *See Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989–90 (Fed. Cir. 1999) (affirming broad construction, applying a "heavy presumption in favor of the ordinary meaning of claim language"). It has no support in this Court's precedents.

This acontextual-presumption school naturally results in patent claims divorced from the "invention" described in the specification. But the acontextual-presumption school leaves this resulting gulf between a patent's invention and its scope to invalidity challenges under 35 U.S.C. § 112. Such invalidity challenges, however, are no substitute for limiting the claimed invention to the disclosed invention. In part, this is because such invalidity challenges are subject to a "clear and convincing evidence" burden of proof and often are submitted to a jury, forcing the patent challenger to incur the expense, uncertainty, and burden of a full trial.

Below we identify exemplary Federal Circuit decisions from each school.

A. The Contextual School

The contextual school considers the claims and specification together as a unitary document before even tentatively settling on the correct legal interpretation of a patent claim or claim term.

> In reviewing the intrinsic record to construe the claims, we strive to

> capture the scope of the actual invention, rather than strictly limit the scope of claims to disclosed embodiments or allow the claim language to become divorced from what the specification conveys is the invention.

Retractable Techs., Inc. v. Becton, Dickinson & Co., 653 F.3d 1296, 1305 (Fed. Cir. 2011).

Retractable Technologies illustrates how the contextual school uses the specification when interpreting the scope of a patent claim, and how doing so often is determinative of the case's outcome. The patent concerned medical syringes in which the needle retracts into the syringe body after the syringe is used. *Id.* at 1298. Some earlier retractable syringes had syringe bodies made of multiple pieces. The patent distinguished this prior art, asserting that "the prior art had failed to recognize a retractable syringe that 'can be molded as one piece outer body.'" *Id.* at 1305. Similarly, the patent's "Summary of the Invention" stated: "'[t]he invention is a retractable tamperproof syringe,' and that this syringe 'features a one piece hollow body.'" *Ibid.* Each embodiment of the invention in the patent had a one-piece body, and nothing in the patent "indicate[d] that the body is anything other than a one-piece body." *Ibid.* Based on this consistent description of the "invention" in the patent's specification, the panel majority construed the claim term "a hollow syringe body" as being limited to a one-piece body. It therefore reversed the trial court's broader construction encompassing a syringe body with multiple pieces, and a jury verdict of infringement based on that broader construction. *Id.* at 1299, 1305. Judge Rader, in dissent, disagreed,

noting that the plain meaning of "body" is not limited to a one-piece body. *Id.* at 1311–12.

This contextual-school approach is well defined at the Federal Circuit:

> [I]n construing a claim there are two limiting factors—what was invented, and what exactly was claimed. To determine the former—what was invented—we look at the entire patent, with particular attention to the specification (the written description of the invention and the several claims made). To determine the latter—what exactly was claimed—the focus is on the precise words of the particular claim or claims at issue; the written description and preferred embodiments are aids in understanding those words. In the case before us, proper claim construction requires that we understand what the invention encompasses as well as how the claims are stated.

MySpace, Inc. v. Graphon Corp., 672 F.3d 1250, 1256 (Fed. Cir. 2012).

Scores of Federal Circuit claim construction rulings have applied this contextual-school approach. In many, if not most, applying the claims' *contextual* meaning was outcome determinative. *See*, *e.g.*, *Sipco, LLC v. Emerson Elec. Co.*, 939 F.3d 1301, 1308–09 (Fed. Cir. 2019) (reversing a broad acontextual "plain meaning" construction of claim term "low-power," because the specification more narrowly tied that term to a limited transmission range); *Eon Corp. IP*

Holdings LLC v. Silver Springs Networks, Inc., 815 F.3d 1314, 1319–20 (Fed. Cir. 2016) (reversing jury verdict of $18,800,000; construing claim terms narrowly to be consistent with the patent's description of the invention, and reversing the trial judge's instruction to the jury to give these terms their plain and ordinary meaning); *In re Papst Licensing Digital Camera Patent Litig.*, 778 F.3d 1255, 1261 (Fed. Cir. 2015) (reversing five trial court claim constructions and reversing summary judgment of non-infringement: "We apply, in particular, the principle that '[t]he construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.'"); *SimpleAir, Inc. v. Sony Ericsson Mobile Commc'ns AB*, 820 F.3d 419 (Fed. Cir. 2016) (reversing trial court's construction and construing claim to conform to the specification's description of the "invention"); *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1318 (Fed. Cir. 2014) (reversing trial court's claim construction: "The fact that the Summary of the Invention gives primacy to these attributes strongly indicates that the invention requires more than just data security."); *Sealant Sys. Int'l Inc. v. TEK Global, S.R.L.*, 616 F. App'x 987, 993 (Fed. Cir. 2015) (non-precedential) (reversing trial judge's claim construction and summary judgment of obviousness; with trial court's broader construction, "the patent would claim more than the patentee actually invented"); *Lexington Luminance LLC v. Amazon.com, Inc.*, 601 F. App'x 963 (Fed. Cir. 2015) (non-precedential) (reversing construction that had been based on general dictionaries).

B. The Acontextual-Presumption School

Then Chief Judge Rader quoting former Chief Judge Rich described the acontextual-presumption school's approach, and contrasted it from the contextual school favored by some of his colleagues:

> The concurrence-in-part and dissent-in-part characterizes the specification as the "heart of the patent" and, using "colloquial terms," states that "you should get what you disclose." This devalues the importance of claim language in delimiting the scope of legal protection. "Claims define and circumscribe, the written description discloses and teaches." To use a colloquial term coined by Judge Rich, "*the name of the game is the claim*."

Arlington Indus., Inc. v. Bridgeport Fittings, Inc., 632 F.3d 1246, 1255, n.2 (Fed. Cir. 2011) (citations omitted).

This acontextual-presumption school leaves to later invalidity challenges any resulting gaps between the acontextual claim scope and the specification:

> If the metes and bounds of what the inventor claims extend beyond what he has invented or disclosed in the specification, that is a problem of validity, not claim construction. It is not for the court to tailor the claim language to the invention disclosed.

Retractable Techs., Inc. v. Becton, Dickinson and Co., 659 F.3d 1369, 1371 (Fed. Cir. 2011) (Moore, J. (joined

by Rader, J.) dissenting from denial of rehearing en banc).

This approach has led, for instance, to the Federal Circuit reversing a district court judgment of non-infringement per a construction limiting the claims to the disclosed invention, followed by a remand in which the district court ruled the claims (as acontextually construed by the Federal Circuit) invalid for being broader than the enabled disclosed invention, and then affirmance at the Federal Circuit on that ground some nine years (and no doubt millions of dollars in legal fees) after the litigation began—which process "can only be viewed as a public policy disaster." *See* John F. Duffy, *Counterproductive Notice in Literalistic Versus Peripheral Claiming*, 96 B.U. L. REV. 1197, 1199 (2016).

Rather than look at the claims and specification together as part of a unitary document, before settling on the meaning of a term used in the claim, this school applies a "heavy presumption" that the ordinary acontextual meaning of the claim term controls. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989–90 (Fed. Cir. 1999). This acontextual-presumption school recognizes only two narrow exceptions to this heavy presumption: "We depart from the plain and ordinary meaning of claim terms based on the specification in only two instances: lexicography and disavowal. The standards for finding lexicography and disavowal are exacting." *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367 (Fed. Cir. 2014) (reversing narrow construction, citing several acontextual-school precedents); *accord Aventis Pharma S.A. v. Hospira, Inc.*, 675 F.3d 1324, 1330 (Fed. Cir. 2012) (describing the "stringent standard

for narrowing a claim term beyond its plain and ordinary meaning").

Scores of Federal Circuit claim construction rulings have applied this acontextual-presumption approach, including the panel decision here. Again, in many if not most, applying the claims' *acontextual* meaning was outcome determinative. *See*, *e.g.*, *Unwired Planet, LLC v. Apple Inc.*, 829 F.3d 1353 (Fed. Cir. 2016) (reversing narrow construction of "voice input" and instead adopting its "plain meaning;" reference to "present invention" in the summary of invention does not constitute clear, unmistakable disavowal for everything in that paragraph); *Info-Hold, Inc. v. Applied Media Tech.*, 783 F.3d 1262 (Fed. Cir. 2015) (reversing narrow construction: "Nothing in the word 'transmit' suggests a limitation on initiation: there is no linguistic ambiguity to resolve."); *Vehicle IP, LLC v. AT&T Mobility, LLC*, 594 F. App'x 636, 641 (Fed. Cir. 2014) (non-precedential) (reversing narrow construction: "In order to disavow claim scope, the specification must make clear that the invention does not include a particular feature otherwise within the scope of the claim term."); *Thorner v. Sony Comput. Entm't Am. LLC*, 669 F.3d 1362, 1366–67, 1368 (Fed. Cir. 2012) (reversing narrow construction: "To constitute disclaimer, there must be a clear and unmistakable disclaimer." An "'implied' redefinition must be so clear that it equates to an explicit one."); *Toshiba Corp. v. Imation Corp.*, 681 F.3d 1358, 1369 (Fed. Cir. 2012) (reversing narrow construction: "Absent disclaimer or lexicography, the plain meaning of the claim controls."); *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1325, 1355 (Fed. Cir. 2004) (reversing narrow construction: There is "a 'heavy presumption'

that claim terms carry their accustomed meaning in the relevant community at the relevant time.").

Some acontextual-presumption panels go even further and treat the "heavy presumption" as irrebuttable. Specifically, some Federal Circuit panels declare that there is no need to consult the patent's specification at all when construing a claim term having a plain meaning outside the patent. This, of course, is the antithesis of contextual interpretation.

> In construing a claim term, we look to the words of the claim itself. If the claim term has a plain and ordinary meaning, our inquiry ends. If, however, the claim term does not have an ordinary meaning, and its meaning is not clear from a plain reading of the claim, "we turn to the remaining intrinsic evidence, including the written description, to aid in our construction of that term."

Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc., 711 F.3d 1348, 1361 (Fed. Cir. 2013) (citation omitted). *Accord Ancora Techs., Inc. v. Apple Inc.*, 744 F.3d 732, 738 (Fed. Cir. 2014) (rejecting indefiniteness defense: "[T]he terms at issue have so clear an ordinary meaning that a skilled artisan would not be looking for clarification in the specification."); *Creative Integrated Sys., Inc. v. Nintendo of Am., Inc.*, 526 F. App'x 927, 933 (Fed. Cir. 2013) (non-precedential) ("The district court could have ended its analysis with the plain language.").

In sum, the contextual school always consults the patent specification and construes patent claims to conform to the scope of the disclosed invention, while

the acontextual-presumption school sometimes ignores the specification entirely and otherwise applies a "heavy presumption" that the claim's acontextual meaning is its correct interpretation, even if that does not reflect the patent's disclosed invention. Unsurprisingly, which school two of three judges on a particular panel prefer often dictates who wins or loses the case. It is no wonder, therefore, that parties who need to agree on the scope of a patent claim in order to reach a business agreement, often cannot agree.

C. The Two Schools Harbor Conflicting Conceptions Of "Plain And Ordinary Meaning"

Some deny or downplay this stark divide by noting, correctly, that both schools cite to the Federal Circuit's 2005 *en banc* decision on how to construe a patent claim, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), and that both express allegiance to the "plain meaning" and "ordinary meaning" of claim language per that *en banc* decision. But *Phillips* has something for everyone and "plain meaning" is anything but in current patent law. The two competing interpretive schools harbor conflicting conceptions of "plain and ordinary meaning" of language in a patent claim.

By "plain meaning," the contextual school means contextual plain meaning, quoting the following sentence from *Phillips*: "Properly viewed, the 'ordinary meaning' of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Id.* at 1321. Without rejecting the "plain and ordinary meaning" banner *per se*, this school begins with the skilled artisan's contextual understanding of the claim, refusing to give the acontextual meaning the

badge of "plain meaning" or a presumption of correctness. "The only meaning that matters in claim construction is the meaning in the context of the patent." *Trustees of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1363 (Fed. Cir. 2016). *Accord Innovation Sciences, LLC v. Amazon.com, Inc.*, 778 F. App'x 859, 866 (Fed. Cir. 2019) (non-precedential) ("[T]o determine the ordinary meaning, we look to the claim language, the specification, the prosecution history, and, where necessary, extrinsic evidence."); *Eon Corp. IP Holdings LLC v. Silver Spring Networks, Inc.*, 815 F.3d 1314, 1321 (Fed. Cir. 2016) ("only meaning that matters in claim construction is the meaning in the context of the patent").

But the acontextual-presumption school has a very different conception of "plain and ordinary meaning," and quotes a different passage in *Phillips*: "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips*, 415 F.3d at 1313.

> In construing a claim term, we look to the words of the claim itself. If the claim term has a plain and ordinary meaning, our inquiry ends. If, however, the claim term does not have an ordinary meaning, and its meaning is not clear from a plain reading of the claim, "we turn to the remaining intrinsic evidence, including the written description, to aid in our construction of that term."

Power Integrations, Inc. v. Fairchild Semiconductor Int'l., Inc., 711 F.3d 1348, 1361 (Fed. Cir. 2013)

(citations omitted) (finding the claims alone did not provide a plain and ordinary meaning).

Thus, it is not uncommon for each side of a divided Federal Circuit panel to cite *Phillips* in support of its competing contextual or acontextual claim construction. *See Indivior Inc. v. Dr. Reddy's Labs, SA*, 752 F. App'x 1024, 1029, 1037, 1038 (Fed. Cir. 2018).

CONCLUSION

For twenty years, our exclusive patent appellate court has been hopelessly and equally divided on probably the most consequential question in patent law: how to construe a patent claim. This divide harms innovation and the patent system as a whole. This Court should continue the work it started in *Nautilus* by granting *certiorari*, ending this persistent and fundamental conflict at the Federal Circuit, and approving the contextual school of patent claim construction.

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