

No. 14-448

---

---

IN THE  
**Supreme Court of the United States**

---

GOOGLE INC.,

*Petitioner,*

*v.*

VEDERI, LLC,

*Respondent.*

---

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

---

---

**BRIEF OF ACUSHNET COMPANY, DELL  
INC., KASPERSKY LAB, INC., LIMELIGHT  
NETWORKS, INC., NEWEGG INC., QVC,  
INC., SAS INSTITUTE INC., EBAY INC.,  
AND XILINX, INC. AS *AMICI CURIAE* IN  
SUPPORT OF PETITIONER**

---

---

PHILIP WARRICK

*Counsel of Record*

JOHN D. VANDENBERG

KLARQUIST SPARKMAN, LLP

One World Trade Center

121 S.W. Salmon Street

Portland, OR 97204

(503) 595-5300

philip.warrick@klarquist.com

*Counsel for Amici Curiae*

November 19, 2014

---

---

256641



COUNSEL PRESS

(800) 274-3321 • (800) 359-6859

**TABLE OF CONTENTS**

	<i>Page</i>
TABLE OF CONTENTS.....	i
TABLE OF CITED AUTHORITIES .....	iii
INTEREST OF <i>AMICI CURIAE</i> .....	1
INTRODUCTION AND SUMMARY OF ARGUMENT.....	1
ARGUMENT.....	4
I.    DISREGARDING ALL BUT THE CLEAREST DISCLAIMERS HARMS THE PUBLIC BY PRESUMPTIVELY RESOLVING AMBIGUITY IN FAVOR OF PATENTEES .....	4
A.  THIS COURT REQUIRES STRICT CONSTRUCTION WHERE PATENT APPLICANTS AMEND CLAIMS TO OVERCOME PRIOR ART.....	6
B.  THE FEDERAL CIRCUIT RESOLVES PROSECUTION AMBIGUITIES IN FAVOR OF PATENTEES TO THE DETRIMENT OF THE PUBLIC.....	9

**TABLE OF CONTENTS**

	<i>Page</i>
II. UNLIKE THE PROPER STANDARD— WHICH PROMOTES CLEAR PUBLIC NOTICE—THE FEDERAL CIRCUIT’S APPROACH INVITES AMBIGUITY . . . . .	16
III. THIS COURT SHOULD RE- AFFIRM THE IMPORTANCE OF CONSTRUING PATENT CLAIMS IN ACCORD WITH THE ACTUAL INVENTION AS EVIDENT FROM <i>ALL</i> OF THE INTRINSIC EVIDENCE, INCLUDING THE NEGOTIATION OF CLAIM SCOPE THAT OCCURS DURING PROSECUTION . . . . .	20
CONCLUSION . . . . .	23

## TABLE OF CITED AUTHORITIES

	<i>Page</i>
<b>CASES</b>	
<i>3M Innovative Proprs. Co. v. Tredegar Corp.</i> , 725 F.3d 1315 (Fed. Cir. 2013).....	3, 8, 13
<i>Ancora Techs., Inc. v. Apple, Inc.</i> , 744 F.3d 732 (Fed. Cir. 2014).....	21
<i>Athletic Alternatives, Inc. v. Prince Mfg., Inc.</i> , 73 F.3d 1573 (Fed. Cir. 1996) .....	10
<i>Creative Integrated Sys., Inc. v.</i> <i>Nintendo of Am., Inc.</i> , 526 F. App'x 927 (Fed. Cir. 2013) .....	21
<i>Exhibit Supply Co. v. Ace Patents Corp.</i> , 315 U.S. 126 (1942) .....	7
<i>Festo Corp. v.</i> <i>Shoketsu Kinzoku Kogyo Kabushiki Co.</i> , 535 U.S. 722 (2002).....	3, 8, 11, 22
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966).....	6, 22
<i>Hill-Rom Servs., Inc. v. Stryker Corp.</i> , 755 F.3d 1367 (Fed. Cir. 2014).....	21
<i>Hubbell v. United States</i> , 179 U.S. 77 (1900) .....	2, 15

*Cited Authorities*

	<i>Page</i>
<i>I.T.S. Rubber Co. v. Essex Rubber Co.</i> , 272 U.S. 429 (1926).....	7
<i>Inverness Med. Switzerland GmbH v.</i> <i>Warner Lambert Co.</i> , 309 F.3d 1373 (Fed. Cir. 2002) .....	12
<i>Invitrogen Corp. v. Biocrest Mfg., L.P.</i> , 327 F.3d 1364 (Fed. Cir. 2003) .....	3, 14
<i>Johnson Worldwide Assocs., Inc. v. Zebco Corp.</i> , 175 F.3d 985 (Fed. Cir. 1999).....	19
<i>Kumar v. Ovonic Battery Co.</i> , 351 F.3d 1364 (Fed. Cir. 2003) .....	12
<i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 134 S. Ct. 2120 (2014).....	4, 9, 15
<i>Netcraft Corp. v. eBay, Inc.</i> , 549 F.3d 1394 (Fed. Cir. 2008) .....	13, 14
<i>Omega Eng'g, Inc. v. Raytek Corp.</i> , 334 F.3d 1314 (Fed. Cir. 2003) .....	<i>passim</i>
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) .....	10, 20, 21, 22
<i>Retractable Techs., Inc. v.</i> <i>Becton, Dickinson &amp; Co.</i> , 653 F.3d 1296 (Fed. Cir. 2011) .....	21

*Cited Authorities*

	<i>Page</i>
<i>SanDisk Corp. v. Memorex Prods., Inc.</i> , 415 F.3d 1278 (Fed. Cir. 2005) .....	10
<i>Vedderi, LLC v. Google, Inc.</i> , 744 F.3d 1376 (Fed. Cir. 2014) .....	3, 15, 20
<i>Warner-Jenkinson Co. v.</i> <i>Hilton Davis Chem. Co.</i> , 9 520 U.S. 17 (1997) .....	9

**STATUTES**

35 U.S.C. § 112 .....	9
-----------------------	---

**ADMINISTRATIVE MATERIALS**

Federal Trade Commission, <i>The Evolving IP Marketplace: Aligning Patent Notice and Remedies with Competition</i> 85 (2011) .....	4
White House, <i>FACT SHEET— Executive Actions: Answering the President’s Call to Strengthen Our Patent System and Foster Innovation</i> (Feb. 20, 2014) .....	15

**OTHER AUTHORITIES**

Arthur H. Seidel <i>et al.</i> , <i>What the General Practitioner Should Know About Patent Law and Practice</i> 65 (5th ed. 1993) .....	16
---	----

*Cited Authorities*

	<i>Page</i>
George W. Jordan, III, <i>Prosecution Disclaimers</i> 7-8 (2004).....	17, 18
Gretchen Ann Bender, <i>Uncertainty and Unpredictability in Patent Litigation: The Time Is Ripe for A Consistent Claim Construction Methodology</i> , 8 J. Intell. Prop. L. 175 (2001) . . .	5, 16
Jeffrey G. Sheldon, <i>How to Write A Patent Application</i> § 7:5.3 (2d ed. 2012) .....	11
Mark A. Lemley & Kimberly A. Moore, <i>Ending Abuse of Patent Continuations</i> , 84 B.U. L. Rev. 63 (2004).....	17
Mark A. Lemley, <i>The Myth of the Sole Inventor</i> , 110 Mich. L. Rev. 709 (2012) .....	4
Mark Lemley & Bhaven Sampat, <i>Examining Patent Examination</i> , 2010 Stan. Tech. L. Rev. 2 (2010).....	12, 17
Michael P. Kahn et al., <i>Patent Drafting and Prosecution: The Intrinsic Record and Its Impact on Patent Litigation</i> , in <i>Fundamentals of Patent Prosecution 2013: A Boot Camp for Claim Drafting &amp; Amendment Writing</i> 565-66 (Practising Law Institute, Handbook No. G-1139, 2013).....	18

*Cited Authorities*

	<i>Page</i>
Michael Risch, <i>The Failure of Public Notice in Patent Prosecution</i> , 21 Harv. J.L. & Tech. 179 (2007) .....	6
R. Polk Wagner, <i>Understanding Patent-Quality Mechanisms</i> , 157 U. Pa. L. Rev. 2135 (2009) .....	.5, 6
Robert C. Faber, <i>Faber on Mechanics of Patent Claim Drafting</i> § 10:1.1 (6th ed. 2013).....	11
Thomas C. Fiala & Jon E. Wright, <i>Preparing and Prosecuting A Patent That Holds Up In Litigation</i> 28 (2006) .....	17, 18
Todd R. Miller, <i>The “Doctrine of Prosecution Disclaimer” in Construing Patent Claims</i> , 86 J. Pat. & Trademark Off. Soc’y 931 (2004) .....	16-17

**INTEREST OF *AMICI CURIAE*<sup>1</sup>**

*Amici* are leading technology and service companies employing thousands of innovators and providing valuable products and services throughout the United States and the world. A number of *Amici* engage in extensive research and development and manage significant patent portfolios related to numerous and diverse fields, including computer hardware and software, sporting equipment, web hosting, security, electronic commerce, and many others. *Amici* also frequently defend against allegations of infringement based on patents with unclear scope. This lack of clarity is often due to patent applicants' attempts to distinguish prior art with vague and ambiguous claim amendments on the public patent examination record. *Amici's* considerable experience with patent prosecution and litigation provide them with valuable insight regarding the question presented.

**INTRODUCTION AND  
SUMMARY OF ARGUMENT**

*Amici* respectfully ask the Court to grant the petition because the Federal Circuit has invited patent

---

<sup>1</sup> Pursuant to Supreme Court Rule 37.6, counsel for *amici* represent that they authored this brief in its entirety and that none of the parties or their counsel, nor any other person or entity other than Symmetry LLC, *amici*, or their counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Pursuant to Rule 37.2(a), counsel for *amici* represent that all parties have consented to the filing of this brief, and counsel of record for all parties received notice at least 10 days prior to the due date for the brief. Written consent of petitioner and respondent are being submitted contemporaneously with this brief.

applicants to leverage ambiguity at the expense of the public and the integrity of the patent system. The appeals court's departure from this Court's precedent has resulted in the following common patent-litigation scenario: A patent owner asserts an issued patent against an accused infringer. Previously, during the prosecution of the underlying patent application, an examiner rejected the now-asserted claims as unpatentable in light of the prior art. In response, the patent applicant amended the original claims—typically *without* a clear explanation on the record—and the examiner allowed the amended claims. The patent owner now seeks a broad construction of that amended claim language to support its infringement arguments, which frequently turn on how courts interpret disputed claim language. Even if the examiner never would have allowed claims with the asserted scope, the record is ambiguous, so nothing stops the patent owner from making the assertion. This scenario arises frequently because patent practitioners are trained to draft broad initial claims, to narrow them only as required by the patent examiner, and to refrain from explaining the effect of such amendments in writing.

Under this Court's precedent, the limitations added by amendment “must be *strictly construed against the inventor* and in favor of the public” by presuming that she surrendered any scope between the original and amended claim language to overcome the cited art. *Hubbell v. United States*, 179 U.S. 77, 84 (1900) (emphasis added) (affirming judgment of non-infringement based on interpretation of element added by amendment during prosecution). Thus, for the same reason the patentee is presumptively estopped from seeking infringement under the doctrine of equivalents, she has also presumptively

disclaimed a broad interpretation of the amended claim language. *See generally Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

The Federal Circuit has adopted the opposite approach, presumptively reading language added to a claim by amendment in favor of the patentee based on her *own* failure to clarify (or often, intentional decision not to clarify) the scope of the disclaimer. According to the Federal Circuit, newly-amended claim language merits no different interpretation than if it had appeared in the original claims *unless* the patent applicant memorialized a “clear and unambiguous” or “clear and unmistakable” disclaimer of claim scope in the written prosecution history. *Vederi, LLC v. Google, Inc.*, 744 F.3d 1376, 1384 (Fed. Cir. 2014) (finding “no clear and unambiguous disavowal” (citing *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1369 (Fed. Cir. 2003))); *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326 (Fed. Cir. 2013) (finding disclaimer was not “clear and unmistakable,” and thus did not attach, because it was “amenable to multiple reasonable interpretations”). In essence, the Federal Circuit construes the new language *against the public* by affording it a presumptively broad scope, *see 3M*, 725 F.3d at 1326 (“Where . . . a disavowal does not exist, the ordinary and customary meaning of the claim term will be given its full effect.”), which also leads to the paradoxical result of presumptively narrower claim scope for patent applicants who clearly explain their amendments in writing during prosecution. This practice improperly restricts the role of the prosecution history in ascertaining the proper scope of patent claims, incentivizes patent applicants to avoid clarity during prosecution, and cannot be squared with this Court’s precedent.

Accordingly, this Court should grant the petition and clarify that claim language should not be construed in a vacuum, divorced from the remainder of the intrinsic evidence. Claim amendments made to overcome patentability rejections should trigger a rebuttable presumption *against the patentee*, who should no longer be rewarded for vague and unclear attempts to distinguish prior art. Patent applicants should not be incentivized to obfuscate the record of their interactions with the patent examiner.

## ARGUMENT

### I. DISREGARDING ALL BUT THE CLEAREST DISCLAIMERS HARMS THE PUBLIC BY PRESUMPTIVELY RESOLVING AMBIGUITY IN FAVOR OF PATENTEES.

This Court has recognized the powerful economic incentives for patent applicants to employ ambiguity that can later be leveraged in litigation. *See Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014) (citing evidence that “patent applicants face powerful incentives to inject ambiguity into their claims”).<sup>2</sup> Just

---

<sup>2</sup> *See also id.* (“Eliminating that temptation is in order, and the patent drafter is in the best position to resolve the ambiguity . . .” (internal quotation marks omitted)); Federal Trade Commission, *The Evolving IP Marketplace: Aligning Patent Notice and Remedies with Competition* 85 (2011), available at <http://www.ftc.gov/os/2011/03/110307patentreport.pdf> (quoting testimony regarding “an incentive to be as vague and ambiguous as you can with your claims” and “defer clarity at all costs”); Mark A. Lemley, *The Myth of the Sole Inventor*, 110 Mich. L. Rev. 709, 745 (2012) (“[T]he Federal Circuit has permitted a number of

as the Court sought to eliminate that temptation by rejecting a standard that tolerated ambiguous patent claims, the Court should also reject the Federal Circuit's treatment of claims amended during prosecution, which likewise resolves prosecution history ambiguity in favor of the patentee at the expense of the public. *See, e.g., Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003) (summarizing Federal Circuit opinions declining "to apply the doctrine of prosecution disclaimer where the alleged disavowal of claim scope is ambiguous" and refusing to limit the claims unless the patentee "has *unequivocally* disavowed a certain meaning" (emphasis added)).

Because the Federal Circuit ignores disclaimers made during prosecution unless they rise to the level of "clear and unambiguous" or "clear and unmistakable," claims are often interpreted in one way to secure allowance and in a different, broader way against accused infringers, particularly where the claims were amended to overcome prior-art rejections by the Patent Office. *See, e.g., R. Polk Wagner, Understanding Patent-Quality Mechanisms*, 157 U. Pa. L. Rev. 2135, 2149 (2009) (explaining how "patentees [may] exploit the dual-stage-analysis process . . . to obtain a patent under one understanding of the language (e.g., a narrow understanding) and later assert that same patent

---

vague general disclosures that don't actually communicate very much to anyone, and patent lawyers often have incentives to write such vague disclosures."); Gretchen Ann Bender, *Uncertainty and Unpredictability in Patent Litigation: The Time Is Ripe for A Consistent Claim Construction Methodology*, 8 J. Intell. Prop. L. 175, 211 (2001) ("[T]he patentee and the patent drafter have practical reasons to keep the scope and subject matter of the patent fluid and malleable.").

in a way that broadens the scope of coverage”). Patentees understand and exploit this disincentive for clarity by injecting ambiguity into the public prosecution record. *See id.* at 2151 (“[I]t should be no surprise that many rational patentees would seek to defer clarity, and that such an action plays an important role in diminishing the quality of patents.”); Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 Harv. J.L. & Tech. 179, 188 (2007) (“Patent applicants have an incentive to allow claims to remain vague so that they can mold the claims to fit the future product of a currently unknown, potential infringer or to avoid invalidation if previously undiscovered prior art comes to light,” a problem exacerbated by the fact that “[p]atent examiners cannot devote much time to each patent.”). And, unsurprisingly, “[a] patent system without certainty in claim scope encourages gaming, increases uncertainty, retards free competition, fails to encourage invention properly, and discourages the use of unprotected ideas.” Risch, *supra*, at 188 (internal footnotes omitted).

**A. THIS COURT REQUIRES STRICT CONSTRUCTION WHERE PATENT APPLICANTS AMEND CLAIMS TO OVERCOME PRIOR ART.**

This Court has long recognized the importance of prosecution history in the claim construction analysis, particularly where the original claims are amended by the applicant to secure allowance. *See, e.g., Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) (“[C]laims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent.”). In particular, according to this Court’s

precedent, patent applicants' claim language amendments in the face of patentability rejections during prosecution presumptively narrow the scope of the issued claims, which should be strictly construed against the patentee and in favor of the public. For example,

where an applicant whose claim is rejected on reference to a prior patent, without objection or appeal, voluntarily restricts himself by an amendment of his claim to a specific structure, having thus narrowed his claim in order to obtain a patent, he may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments, which amount to a disclaimer.

*I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 444 (1926) (internal quotation marks omitted) (affirming judgment of non-infringement based on narrowing claim interpretation premised on prosecution proceedings).

By the amendment [the applicant] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference. The difference which he thus disclaimed must be regarded as material, *and since the amendment operates as a disclaimer of that difference* it must be strictly construed against him.

*Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-37 (1942) (emphasis added) (internal citations omitted) (reversing judgment of infringement based on interpretation of amended claim language).

This presumptively narrow scope reflects that patent applicants are uniquely situated to provide clarity.<sup>3</sup>

A rejection indicates that the patent examiner does not believe the original claim could be patented. While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim.

*Festo*, 535 U.S. at 734. “Were it otherwise, the inventor might avoid the PTO’s gatekeeping role and seek to recapture in an infringement action the very subject matter surrendered as a condition of receiving the patent.” *Id.* Courts should therefore “hold the inventor to the representations made during the application process and to the inferences that may reasonably be drawn from the amendment. By amending the application, the inventor is deemed to concede that the patent does not extend as far as the original claim.” *Id.* at 737-38.

Importantly, however, strictly construing amended claim language against the patentee creates only a rebuttable presumption of disclaimer, which—like that applied in the context of prosecution history estoppel—may be overcome by the patentee.

---

<sup>3</sup> See *3M*, 725 F.3d at 1334-36 (Plager, J., concurring) (suggesting that cases involving “conflicting or indeterminate written description and prosecution history . . . may well deserve application of a principle analogous to the contract doctrine of *contra proferentem*,” whereby claims should be construed against the patentee “in favor of a competitor who should not have the risk of guessing wrong about what a claim term could possibly mean”).

The presumption we have described, one subject to rebuttal if an appropriate reason for a required amendment is established, gives proper deference to the role of claims in defining an invention and providing public notice, and to the primacy of the PTO in ensuring that the claims allowed cover only subject matter that is properly patentable in a proffered patent application.

*Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33-34 (1997) (placing “the burden on the patent holder to establish the reason for an amendment required during patent prosecution,” whereby “[t]he court then would decide whether that reason is sufficient”).

**B. THE FEDERAL CIRCUIT RESOLVES PROSECUTION AMBIGUITIES IN FAVOR OF PATENTEES TO THE DETRIMENT OF THE PUBLIC.**

As with the Federal Circuit’s failure to enforce the clarity and precision demanded of patent applicants by Section 112(b) of the Patent Act, *see Nautilus*, 134 S. Ct. at 2124, the Federal Circuit’s treatment of prosecution amendments improperly resolves ambiguity created by the patent applicant against the public. Nothing could be more antithetical to a regime promoting clarity and public notice than to reward patent applicants with broad claim constructions where they have been unclear about how their own amended claim language distinguishes the prior art. The prosecution process provides applicants with every opportunity to clarify the scope of the claimed invention. Yet the Federal Circuit has chosen to simply

excuse failures of clarity rather than incentivize greater clarity.

The Federal Circuit has acknowledged that vague and ambiguous disclaimers in the prosecution history present public notice problems,<sup>4</sup> but rather than invite greater clarity by enforcing the burden on patentees to explain amendments and clearly distinguish the prior art, it has concluded that patentees should benefit from their own obfuscation of the public record. Ironically, the Federal Circuit has cited the importance of clear public notice to justify this outcome: “An ambiguous disclaimer . . . does not advance the patent’s notice function or justify public reliance, and the court will not use it to limit a claim term’s ordinary meaning.” *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1287 (Fed. Cir. 2005).

To balance the importance of public notice and the right of patentees to seek broad patent coverage, we have thus consistently rejected prosecution statements too vague or ambiguous to qualify as a disavowal of claim scope. Rather, we have required the alleged disavowing statements to be both so clear as to show reasonable clarity and deliberateness, and so unmistakable as to be unambiguous evidence of disclaimer.

---

<sup>4</sup> See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc) (“[T]he prosecution history . . . often lacks the clarity of the specification and thus is less useful for claim construction purposes.”); *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1580 (Fed. Cir. 1996) (finding contradictory prosecution history “unhelpful as an interpretive resource”).

*Omega Eng'g*, 334 F.3d at 1325 (internal citations omitted). This justification is counterproductive, and the appeals court's solution contravenes not only this Court's precedent but also the notice policies underlying our patent system.

Holding patentees *only* to the clearest of narrowing amendments does not promote certainty or public notice. Rather, ambiguous amendments in the face of prior-art rejections leave would-be competitors in the dark regarding what scope—if any—was surrendered and what aspects of the prior art may safely be practiced. *See Festo*, 535 U.S. at 731 (recognizing the “delicate balance . . . between inventors . . . and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights”). Moreover, treating ambiguously amended claim language on equal footing with original claim language often risks improper recapture of subject matter previously surrendered by applicants during prosecution to secure allowance.

The effects of this misguided approach are far reaching. Amended claim language is frequently encountered in litigation because many patent applicants intentionally draft initial claims as broadly as possible, placing the burden on the examiner to require narrowing amendments. *See, e.g.*, Robert C. Faber, *Faber on Mechanics of Patent Claim Drafting* § 10:1.1, at 10–2 (6th ed. 2013) (describing “as broad as possible” claim coverage as one of the “goals of claim writing”); Jeffrey G. Sheldon, *How to Write A Patent Application* § 7:5.3, at 7–68 (2d ed. 2012) (“At worst, the examiner will not allow the broadest claims. Thus, it is recommended that the practitioner be greedy when initially writing the application.”). Thus, it should be no surprise that “the vast

majority of . . . applicants who obtain patents . . . do so in part by amending their claims in response to examiner concerns.” Mark Lemley & Bhaven Sampat, *Examining Patent Examination*, 2010 Stan. Tech. L. Rev. 2, ¶ 12 (2010).

A few examples illustrate how far the Federal Circuit has gone astray. It has held, for example, that despite “surrendering . . . broad claims” reciting particular types of materials, an applicant did not disclaim a subset of such materials because “[a]t most the prosecution history is *confusing* in this respect, and the surrender is not clear and convincing as required by our cases.” *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364, 1371 (Fed. Cir. 2003) (emphasis added); *see also Inverness Med. Switzerland GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1382 (Fed. Cir. 2002) (vacating summary judgment of non-infringement based on a narrow claim construction because “[i]t is inappropriate to limit a broad definition of a claim term based on prosecution history that is itself ambiguous,” even though the Court was “not convinced that the [patentee’s] reading of the history is the only plausible reading”).

In other words, even where an applicant indisputably amended claims to overcome prior art, the Federal Circuit will *not* recognize a prosecution disclaimer if “there is more than one reasonable basis for the amendment, rendering the intent underlying the amendment ambiguous and thus negating the possibility of the disclaimer being unmistakable.” *Omega Eng’g*, 334 F.3d at 1330 (holding that prosecution disclaimer did not attach because “the basis for that amendment is reasonably amenable to more than one explanation”). Thus, patent owners need only

contrive “any number of other unstated but reasonable rationales unrelated to the [alleged disclaimer]” to preserve a broad construction inconsistent with *any* narrowing interpretation. *Id.* Similarly, in a more recent case, the patent applicant narrowed claims from “substantially continuous contact” to “continuous contact,” but “did not provide statements illuminating why ‘substantially’ was removed.” *3M*, 725 F.3d at 1324-25. The Federal Circuit refused to effectuate a disclaimer limiting “continuous contact” to “full skin-to-core contact” as advocated by the defendant because the patent owner “present[ed] a competing interpretation that the applicant eliminated the word ‘substantially’ to more clearly recite that ‘continuous contact’ was different from . . . intermittent contact.” *Id.* at 1325-26 (“Where an applicant’s statements are amenable to multiple reasonable interpretations, they cannot be deemed clear and unmistakable.”).

Furthermore, viewing the prosecution history and particularly claim amendments through this forgiving lens has led the Federal Circuit to disregard even seemingly unambiguous disclaimers. For example, in *Netcraft Corp. v. eBay, Inc.*, 549 F.3d 1394 (Fed. Cir. 2008), the patentee and the accused infringer disagreed regarding whether or not the claim term “providing a communications link through equipment of the third party” required providing access to the Internet. *Id.* at 1395. The original claims recited “providing a communications link over the Internet,” but to overcome a prior-art rejection, Netcraft amended the claims and explained to the examiner that the cited prior art reference “neither discloses nor suggests providing a system for allowing access to the Internet,” but rather “assumes that the users . . . are already connected to the Internet.” *Id.* at 1401. Despite

this ostensibly clear disclaimer, the Federal Circuit concluded “that the portions of the prosecution history cited by the parties are not particularly helpful to either party’s claim construction position.” *Id.* at 1402.

The *Invitrogen* opinion cited by the appeals court in this case similarly illustrates the severity of the problem. There, the asserted patent claimed a process including the step of “growing *E. coli* cells in a growth-conducive medium at a temperature of 18° C. to 32° C.” *Invitrogen*, 327 F.3d at 1366. The district court granted summary judgment of non-infringement based on its conclusion that “the applicants had disclaimed all growth outside the range of 18° C to 32° C” because they “amended the claims to replace ‘less than 37° C’ [as originally claimed] with ‘18° C to 32° C’” in response to an examiner rejection and furthermore “stated that their amendment ensures that the claimed invention is different from prior art showing growth at 37° C.” *Id.* at 1368. The Federal Circuit disagreed, vacating the district court’s judgment and characterizing this prosecution history evidence as a “rather sketchy record,” which “does not show any clear and unambiguous disavowal” of any growth at 37° C. *Id.* at 1368-69. Rather than strictly construing the amended language against the patentee, the appeals court held that the claimed invention did *not* preclude “preparatory steps,” including growing *E. coli* cells at 37° C. *Id.* at 1369-70.

Finally, the present case presents a good vehicle to address this problem. Here, to overcome a prior-art reference, the patent applicant—with minimal explanation—amended the original claim term “non-aerial view” to recite “substantially elevations.” *See*

*Vederi*, 744 F.3d at 1384. Because the Federal Circuit did not find an *express* disclaimer of “spherical or curved images,” it declined to construe the new language narrowly against the patentee or to express any opinion regarding the difference in scope between “non-aerial view” and “substantially elevation,” despite the applicant having made this amendment to secure allowance over the prior art. *See id.* The Federal Circuit thus violated this Court’s directive that such amendments should be “strictly construed against the inventor and in favor of the public,” *Hubbell*, 179 U.S. at 84.

These cases and many others unduly diminish the role of the important public examination record. Subjecting prosecution disclaimers to a “clear and unambiguous” or “clear and unmistakable” standard divorces the issued claim language from the patent applicant’s own actions reflecting the scope of the invention as negotiated with the examiner.<sup>5</sup>

---

<sup>5</sup> The Federal Circuit’s tolerance of ambiguity stands in stark contrast not only to this Court’s recent *Nautilus* decision, 134 S. Ct. at 2129 (holding that “a patent’s claims, viewed in light of the specification *and prosecution history*, [must] inform those skilled in the art about the scope of the invention with reasonable certainty” (emphasis added)), but also to recent Patent Office initiatives designed to promote clarity in prosecution, *see, e.g.*, White House, *FACT SHEET– Executive Actions: Answering the President’s Call to Strengthen Our Patent System and Foster Innovation* (Feb. 20, 2014), available at <http://www.whitehouse.gov/the-press-office/2014/02/20/fact-sheet-executive-actions-answering-president-s-call-strengthen-our-p> (noting that, *inter alia*, “the USPTO has developed an extensive, multi-phased training program for all examiners and judges focused on . . . improving examination consistency and the clarity of the examination record” and “a pilot

## II. UNLIKE THE PROPER STANDARD—WHICH PROMOTES CLEAR PUBLIC NOTICE—THE FEDERAL CIRCUIT’S APPROACH INVITES AMBIGUITY.

Patent applicants—well aware of the drawbacks associated with clearly narrowing claim amendments—are advised to avoid clarity during prosecution. *See, e.g., Bender, supra* n.2, at 210-11 (“The greatest possible effort should be exerted to avoid adopting a position in which the applicant may later be placed in a corner. It is much better technique, when possible, not to pinpoint the essence of patentability to a particular feature and, instead, to attempt to leave a certain amount of ambiguity or room to maneuver should very pertinent prior art be subsequently unearthed.” (quoting Arthur H. Seidel et al., *What the General Practitioner Should Know About Patent Law and Practice* 65 (5th ed. 1993))). Given the Federal Circuit’s approach and the powerful incentives to preserve broad constructions in subsequent litigation, applicants are trained to distinguish the prior art while stopping short of unequivocally disavowing anything on the written record. The resultant ambiguity serves the patentee’s interests to the detriment of the public, the courts, and anyone else seeking to understand the scope of the amended claims.

Chief among the patent applicant’s tools for avoiding disclaimer is silence—at least in the written record. *See Todd R. Miller, The “Doctrine of Prosecution Disclaimer” in Construing Patent Claims*, 86 J. Pat. & Trademark

---

program that uses glossaries in patent specifications to promote patent clarity”).

Off. Soc’y 931, 953 (2004) (“As a general rule, the less said, the better. Silence may be the wisest course of action.”); Thomas C. Fiala & Jon E. Wright, *Preparing and Prosecuting A Patent That Holds Up In Litigation* 28 (2006), available at [http://www.skgf.com/uploads/24/doc/Preparing\\_and\\_Prosecuting\\_a\\_Patent\\_that\\_Holds\\_Up\\_in\\_Litigation\\_pdf.pdf](http://www.skgf.com/uploads/24/doc/Preparing_and_Prosecuting_a_Patent_that_Holds_Up_in_Litigation_pdf.pdf) (“One of the hallmarks of a ‘bullet-proof’ patent is a silent prosecution history.”). Silence regarding the scope of the amended claims and the exact contours of any disclaimer leaves the door open for subsequent interpretation. Accordingly, patent applicants frequently omit any significant written explanation for submitted claim amendments, which are often negotiated during in-person or telephonic examiner interviews. “Because interviews are not recorded, and because examiner records of interviews almost never include any useful information, interviews are often thought by practitioners as a way to explain the invention (and perhaps make concessions) without creating prosecution history that binds the applicant in later litigation.” Lemley & Sampat, *supra*, ¶ 15.<sup>6</sup> Applicants are further advised to

---

<sup>6</sup> See also Mark A. Lemley & Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U. L. Rev. 63, 67-68 (2004) (“Unlike the rest of the prosecution history, which involves written correspondence and is therefore carefully documented, the interview is not transcribed and the interview summary that is completed by the examiner is often cryptic and uninformative. It is quite common for an examiner to withdraw a final rejection and allow the claims after such an interview.” (internal footnote omitted)); George W. Jordan, III, *Prosecution Disclaimers* 7-8 (2004), available at <http://www.merchantgould.com/Resources/images/3411.pdf> (advising prosecutors that “one viable option for limiting the risk of prosecution disclaimer is to conduct examiner interviews in place of written arguments whenever feasible,” and that “[a]nother option for limiting the

avoid “clear statements concerning why the prior art is different from the claimed invention.”<sup>7</sup> Indeed, applicants are even advised to “review the text the examiner intends to include in the Interview Summary Form and provide suggested changes,” particularly “when such text characterizes the invention, the prior art, or any alleged similarities or differences between the invention and the prior art.” Fiala & Wright, *supra*, at 9.

Patent applicants should not be rewarded for deliberately obscuring the public record of their dealings with the Patent Office, but the Federal Circuit has repeatedly done exactly that. By ignoring patent applicants’ own indications of narrowed scope unless they rise to the level of “clear and unmistakable” or “clear and unambiguous” disclaimers, the Federal Circuit permits patent owners to assert broad claim constructions in litigation that recapture claim scope surrendered during prosecution to secure the issuance of their patents.

The *Omega Engineering* case illustrates the effectiveness of these tactics. In that case, the patent applicant had four telephonic examiner interviews within the span of a week, culminating in an amendment adding

---

risk of prosecution disclaimer is to present amendments without arguments”); *id.* at 8 (“[E]xaminer interviews can be a significant impediment to finding a ‘clear and unmistakable’ disclaimer.”).

<sup>7</sup> Michael P. Kahn et al., *Patent Drafting and Prosecution: The Intrinsic Record and Its Impact on Patent Litigation*, in *Fundamentals of Patent Prosecution 2013: A Boot Camp for Claim Drafting & Amendment Writing* 565-66 (Practising Law Institute, Handbook No. G-1139, 2013) (noting that “[t]hose should be arguments of last resort”).

the word “only” to certain claims. *Omega Eng’g*, 334 F.3d at 1331. The “Examiner Interview Summary Record” merely indicated that claims “were amended to clearly define the invention over the prior art of the record.” *Id.* And,

[b]ecause the examiner deemed it unnecessary for the applicant to provide a separate record of the substance of the interview, [the applicant’s] Supplemental Amendment only contained this cryptic statement: “Responsive to numerous telephone conversations with the Examiner, please amend the above identified application as follows.” Except for the changes to the claims’ text, [the applicant] did not provide any reason for the amendments.

*Id.* The Federal Circuit found that no disclaimer could attach based on these limited statements and that to conclude otherwise would require an “ungrounded leap of logic.” *Id.* Absent a judicial check on these practices, many applicants will continue to undermine the public-notice function of the prosecution record.

Reversing this damaging presumption will yield multiple benefits. Patent claims will be construed to comport with the narrowing scope adopted during prosecution, and rational applicants will strive to be clear about precisely what is—and is not—being disclaimed in the written record. *See Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 992 (Fed. Cir. 1999) (explaining that “carefully-crafted arguments in support of patentability can avoid creating ambiguous or adverse prosecution history”).

**III. THIS COURT SHOULD RE-AFFIRM THE IMPORTANCE OF CONSTRUING PATENT CLAIMS IN ACCORD WITH THE ACTUAL INVENTION AS EVIDENT FROM ALL OF THE INTRINSIC EVIDENCE, INCLUDING THE NEGOTIATION OF CLAIM SCOPE THAT OCCURS DURING PROSECUTION.**

The Federal Circuit's consistent refusal to recognize prosecution disclaimers unless they are found to be "unambiguous" reflects a deeper problem underlying the Federal Circuit's claim-construction jurisprudence. Specifically, an intra-circuit split has persisted in the wake of an *en banc* decision, which cautioned against "focus[ing] the inquiry on the abstract meaning of words rather than on the meaning of claim terms within the context of the patent." *Phillips*, 415 F.3d at 1321. Despite this opinion, the Federal Circuit has developed competing lines of authority regarding the proper interpretive role for descriptions of the invention and prior art found in the patent specification and prosecution history. In particular, several panels have construed claim language very broadly under the guise of "plain meaning" with minimal reference to the prosecution history or even the specification unless they perceive a clear and unmistakable disavowal of scope. This results in construing claim language in a vacuum, divorced from the alleged invention described and distinguished from prior art in the specification and during prosecution.

Indeed, this very case illustrates the deeper and more fundamental problem. The appeals court not only broadly construed the amended claim language, but also gave limited effect to statements in the specification. *See Vederi*, 744 F.3d at 1383-84 (holding that statements in the

patent specification distinguishing prior art requiring “the dense sampling of images of an object/scene to provide different views of the object/scene” demonstrated no disavowal of claim scope because they did not rise to the level of “a clear and unmistakable disavowal”).

Admittedly, some panels have adhered to the guidance of *Phillips*, at least with respect to the specification, and many of the resulting decisions evidence efforts to ascertain the proper scope of the invention as dictated by all of the intrinsic evidence. *E.g.*, *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305 (Fed. Cir. 2011) (“In reviewing the intrinsic record to construe the claims, we strive to capture the scope of the actual invention, rather than . . . allow the claim language to become divorced from what the specification conveys is the invention.”). Other panels, however, have refused to look past the claim language itself if it appears clear on its face. *E.g.*, *Ancora Techs., Inc. v. Apple, Inc.*, 744 F.3d 732, 738 (Fed. Cir. 2014) (holding that “the terms at issue have so clear an ordinary meaning that a skilled artisan would not be looking for clarification in the specification” because “[t]here is no facial ambiguity or obscurity in the claim term”).<sup>8</sup>

---

<sup>8</sup> *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014) (“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.” (internal citation omitted)); *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.”).

While patent claims define the boundaries of the exclusionary right, they should not be analyzed in a vacuum. The specification and the public record of the negotiation between the applicant and the patent examiner inform and limit the scope of the claims to the actual invention for which the patent was issued by the Patent Office. That issued patent claims or the specification may appear clear on their face does not obviate the need to consult the prosecution history. After all, the patent specification is drafted prior to prosecution, and does not reflect the applicant's views of her invention in light of new prior art identified by the examiner. Nor does the issued patent reflect the differences between the original and issued claims. The Federal Circuit decisions interpreting claim language in isolation from the remainder of the intrinsic evidence run afoul of *Phillips*, but more importantly cannot be reconciled with this Court's longstanding and repeated directives that, for example, "an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office." *Graham*, 383 U.S. at 33 ("Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art . . ."); *see also Festo*, 535 U.S. at 741 ("[T]he prosecution history is relevant to construing [the] claims. When the patentee has chosen to narrow a claim, courts may presume the amended text was composed with awareness . . . that the territory surrendered is not an equivalent of the territory claimed."). This Court should take advantage of this opportunity to clarify once again the importance of consulting *all* of the intrinsic evidence when construing claims.

**CONCLUSION**

Patentees should be held to the amendments made and bargains struck during prosecution. Where patentees have obfuscated the rationale for amending their claims, they should not benefit from presumptively-broad interpretations during subsequent litigation. Courts should presume that applicants have disclaimed any scope between the original and amended language, and thus construe the amended claim language strictly against the patentee unless she can overcome the presumption by reference to the public record. The Court should take this opportunity to reaffirm the proper interpretative role of such amendments and thus support the Patent Office in promoting much-needed clarity during patent prosecution.

Respectfully submitted,

PHILIP WARRICK

*Counsel of Record*

JOHN D. VANDENBERG

KLARQUIST SPARKMAN, LLP

One World Trade Center

121 S.W. Salmon Street

Portland, OR 97204

(503) 595-5300

philip.warrick@klarquist.com

*Counsel for Amici Curiae*

November 19, 2014