

No. 18-1508

IN THE
Supreme Court of the United States

WISCONSIN ALUMNI RESEARCH FOUNDATION,
Petitioner,

v.

APPLE INC.,
Respondent.

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

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

The questions listed in the petition are not presented in this case because they depend on the incorrect premise that the Federal Circuit adopted a new claim construction on appeal. A more accurate statement of the questions would be:

1. Whether this Court should review a fact-specific ruling that Apple is entitled to judgment of non-infringement as a matter of law, where that ruling applied the plain and ordinary meaning of the “particular” limitation in WARF’s patent claims, just as the jury was instructed to do.

2. Whether this Court should consider a hypothetical question regarding whether the case should be remanded for consideration of a new claim construction where the Federal Circuit did not adopt a new claim construction, concluded the evidence could not support an infringement finding as a matter of law, and had no reason whatsoever to remand this case.

CORPORATE DISCLOSURE STATEMENT

Respondent Apple Inc. has no parent corporation. No publicly held corporation owns 10% or more of Apple's stock.

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INTRODUCTION

WARF's entire petition is based on an incorrect premise. The Federal Circuit did not adopt a new claim construction on appeal. It simply gave the "particular" limitation in WARF's patent claims its plain and ordinary meaning while reviewing the jury's verdict for substantial evidence. The court explained: "Applying the plain and ordinary meaning of the term 'particular,' and drawing all reasonable inferences from the evidence in favor of WARF, we hold that no reasonable juror could have found literal infringement in this case." Pet. App. 13a.

This run-of-the-mill decision granting judgment as a matter of law on the specific facts of this case was eminently justified and does not warrant review. WARF's representative patent claim refers to "a [load] instruction dependent for its data on a [store] instruction of earlier program order" and requires that a predictor "produce a prediction associated with *the particular* [load] instruction." Pet. App. 5a (emphases added). That is not how Apple's accused products operate. As the Federal Circuit recognized, in the accused products "only 4,096 load tags are possible," and "Apple's operating system alone contains millions of load instructions." Pet. App. 17a. "Each load tag can therefore be associated with a *group* of load instructions," Pet. App. 13a, "such that the prediction is associated with a group of instructions, rather than a *particular* instruction," Pet. App. 14a. The Federal Circuit concluded that, "drawing all reasonable inferences in favor of WARF, there is insufficient evidence to support the jury's finding that Apple's products literally satisfy the 'particular' limitation." Pet. App. 18a.

WARF does not challenge this straightforward analysis of the factual record or the deficiencies that the Federal Circuit identified in WARF's proof at trial. Instead, WARF attempts to manufacture a legal question by rewriting the facts of this case. That attempt is flawed from start to finish, and certainly does not merit review.

Apple consistently argued before trial that its accused products did not infringe the "particular" limitation for the exact reasons cited by the Federal Circuit. Apple did not need a special claim construction to support that argument: It was clear from the plain meaning of the claims that associating a prediction with a group of instructions was different from associating a prediction with "the particular instruction" as the claims require. WARF was the one that sought to stretch the meaning of the claims to capture products not covered by their plain language.

Indeed, WARF's petition notably fails to mention that the district court understood the plain meaning of the claims in the exact same way as Apple and the Federal Circuit when it construed the "particular" limitation on the second day of trial. The district court explained that the claim "as a whole ... contemplates a single load instruction." Pet. App. 131a. In fact, this was sufficiently clear that the court did not think any special construction beyond an instruction to apply the plain meaning of the claims was required:

From all of this, the court concludes that claim 1 discloses a prediction associated with a single load instruction, albeit one that is "dynamic." Because this language is consistent with the plain meaning of the claim terms "the" and "the particular," the court concludes that there is no

need for instructing the jury on the meaning of this term.

Pet. App. 132a.

Far from adopting a new claim construction for the first time on appeal, the Federal Circuit's JMOL analysis applied the same plain and ordinary meaning. This simple fact demolishes the foundation of WARF's petition. At a minimum, it strongly counsels against review, because this Court would be required to delve into the complex procedural history of this case and adopt the counterfactual premise of WARF's petition before it could even reach the questions presented.

WARF's questions would not warrant review even if they actually were presented on these facts. WARF's argument that juries should resolve questions of fact underlying the ultimate legal question of claim construction is waived because WARF never asked the panel to defer to any jury factfinding on claim construction. In any event, this case is an especially inapt vehicle to address that issue because WARF's argument relies on unsupported expert testimony that conflicts with, and cannot override, the plain language of the claims. WARF also fails to acknowledge that this Court has squarely assigned responsibility for claim construction to judges. Even in instances where—unlike here—factfinding beyond the intrinsic record of the claims, specification, and prosecution history is required, it falls on the court to find those facts. WARF does not even attempt to provide an exceptional justification for overruling that precedent.

WARF's second question presented fares no better. Even setting aside the fact that there was no new claim construction here, this Court's guidance is not needed to tell the Federal Circuit whether or not to

remand when it actually adopts a new claim construction on appeal. The appropriateness of remand in those circumstances—which are not presented here—is a case-specific question that depends on the specific facts before the court. The Federal Circuit frequently remands when more proceedings are needed under a new construction, but when there is only one legally permissible outcome under the correct construction, a remand may be unnecessary. It is unclear whether WARF is advocating a per se rule that a remand is always required or simply attempting to argue the facts of this individual case. Either way, there would be no cert-worthy question here—even if the Federal Circuit had adopted a new construction, which it did not.

STATEMENT

A. Factual Background

1. Technology Background

This case relates to the way processors execute instructions in a computer program. A computer program consists of a sequential list of instructions written in “program order.” Pet. App. 2a. Computer processors can execute instructions in the same order in which the program is written. *Id.* However, that requires the processor to wait for each instruction to complete before executing the next instruction, which can slow the processor’s performance. CAJA 1424-1425.

To avoid those delays, a processor can execute instructions in a different order from how the program is written—i.e., “out-of-order.” Pet. App. 2a. But when doing so, the processor must get the same result “as if it had executed the instructions in program order.” *Id.*

Many program instructions are “independent” of each other and can execute out-of-order without changing the result of the program. CAJA 1426. At times, however, an instruction may require the results of other instructions before it can execute correctly. For example, a “data dependence” exists when one instruction uses data that is changed by another instruction appearing earlier in the program order. Pet. App. 3a. If a data dependence exists between two instructions, they may not execute out-of-order without risking an incorrect result. CAJA 1713.

This case involves two types of program instructions that can be data dependent upon each other. A “store” instruction “writes” data to the computer’s memory so that it can be retrieved later. Pet. App. 3a. A “load” instruction “reads” data from the computer’s memory so that information can be used to “perform some function.” *Id.* If a store instruction and a load instruction that is later in the program order access the same memory location, then the load instruction is dependent upon the earlier store instruction and the two instructions must execute in the proper order to ensure that the program gets the correct result. *Id.* Otherwise, if the dependent load instruction executes before the earlier store instruction (i.e., out-of-order), the load instruction may not retrieve the correct data from memory that it needs to obtain the result intended by the program. *Id.*

If a load instruction is known to be dependent on an earlier store instruction, the processor will not perform the load instruction until after the earlier store instruction executes. However, it is not always possible to tell whether a load instruction depends upon an earlier store instruction—i.e., there may be an “ambiguous” dependence. CAJA 1715.

In the case of an ambiguous dependence, the processor can choose to execute the load and store instructions out-of-order. This is called “speculation” because the processor is effectively guessing that there is no dependence between them. Pet. App. 4a. If that speculation turns out to be correct and there was in fact no dependence between the instructions, the processor’s performance improves because the processor did not unnecessarily wait for a store instruction to complete before allowing an unrelated load instruction to execute. *Id.* However, if the speculation turns out to be incorrect, and the load instruction in fact executes before an earlier store instruction on which it depends, a “mis-speculation” occurs. When that happens, the processor must discard the incorrect results and re-execute the instructions in program order, which may decrease processor performance. *Id.*

To obtain the performance benefits of out-of-order execution while reducing the costs of mis-speculation, “prediction” techniques can be used to improve the accuracy of speculation. Prediction permits the processor to make an informed decision as to when speculation should be allowed. Pet. App. 5a.

2. WARF’s Patent

This case involves U.S. Patent No. 5,781,752 (“the ’752 patent”), which was assigned to WARF. The patent expired on December 26, 2016. Pet. App. 5a.

Before the ’752 patent, out-of-order execution and speculation were “well known in the art.” Pet. App. 53a. Companies, including IBM and Digital Equipment Corporation (“DEC”), had already patented prediction techniques for improving the accuracy of speculation involving load and store instructions. CAJA 1720-1744.

As one of the '752 patent's inventors acknowledged, "DEC and later IBM identified the same problem earlier than we did." CAJA 6007.

The '752 patent describes a specific prediction technique for a processor capable of executing program instructions out-of-order. Pet. App. 5a. The claimed processor contains a "data speculation circuit" that, among other things, detects mis-speculations. Pet. App. 68a (claim 1).¹ When it detects a mis-speculation, the data speculation circuit sends a signal called a "mis-speculation indication" to a "predictor." *Id.* The predictor then uses the "mis-speculation indication" to "produce a prediction associated with the particular [load] instruction" that mis-speculated. *Id.*² The prediction indicates the likelihood that the particular load instruction that mis-speculated previously will mis-speculate if allowed to execute out-of-order again. Pet. App. 7a. The processor prevents speculation when the prediction associated with that particular load instruction has a value falling within a predetermined range. Pet. App. 68a (claim 1).

Representative claim 1 recites in full:

In a processor capable of executing program instructions in an execution order differing from their program order, the processor further having a data speculation circuit for detecting data dependence between instructions and detecting a mis-speculation where a [load]

¹ WARF also asserted infringement of independent claim 9, but there are no relevant differences between the claims for purposes of this case. Pet. App. 7a n.2.

² The claim language referring to "data consuming" and "data producing" instructions refers to "load" and "store" instructions, respectively. Pet. App. 6a n.1.

instruction dependent for its data on a [store] instruction of earlier program order, is in fact executed before the [store] instruction, a data speculation decision circuit comprising:

- a) a predictor receiving a mis-speculation indication from the data speculation circuit to produce *a prediction associated with the particular [load] instruction* and based on the mis-speculation indication; and
- b) a prediction threshold detector preventing data speculation for instructions having a prediction within a predetermined range.

Id. (emphasis added).

3. Apple's Accused Processors

WARF accused the processors in Apple's iPhones and iPads of infringing the '752 patent. The specific feature in Apple's processors that WARF accused of infringement is known as the "Load-Store Dependency Predictor" or "LSD predictor." Pet. App. 7a.

Apple's LSD predictor makes predictions as to whether load and store instructions should be allowed to execute out-of-order. Pet. App. 7a-8a. Unlike the '752 patent, however, those predictions are not associated with the particular load instruction that mis-speculated. Instead, Apple's LSD predictor associates predictions with a "Load Tag." Pet. App. 8a; CAJA 2057-2058, 2155-2156. Because Apple uses a "hashing" function to generate Load Tags, multiple load instructions can have the same Load Tag. Pet. App. 8a. Indeed, there are only 4,096 Load Tags, but millions of load instructions in Apple's operating system software alone. Pet. App. 8a; CAJA 2056-2061, 2168-2169, 2296-2298. Apple's LSD predictor thus always associates

predictions with a *group* of load instructions having the same Load Tag, not with a *particular* load instruction. CAJA 2060-2062, 2165-2166, 2296-2298.

As a practical matter, this means that Apple's LSD predictor behaves differently from the '752 patent's predictor. For example, Apple's LSD predictor will prevent speculation for *all* load instructions having the same Load Tag if it detects a data dependence for *any* load instruction with the same Load Tag. CAJA 2166, 2168. By contrast, the '752 patent's predictor prevents speculation only for the *particular* load instruction associated with a prediction and not any others. Pet. App. 58a.

Apple's LSD predictor updates its predictions over time to account for new information as a program runs. Because multiple instructions share the same Load Tag, different load instructions having the same Load Tag may update the same prediction in Apple's LSD predictor. Pet. App. 16a; CAJA 2293-2294, 2296. That situation is called "aliasing." Pet. App. 8a. Regardless of whether aliasing occurs, Apple's LSD predictor always associates its predictions with a group of load instructions through the use of Load Tags, instead of with a particular load instruction. CAJA 2062, 2180.

Apple received its own patent (U.S. Patent No. 9,128,725) relating to Apple's work developing the LSD predictor. CAJA 3517-3518, 5966-5987. The Patent Office considered WARF's '752 patent during the prosecution of Apple's patent application and allowed Apple's patent to issue over WARF's '752 patent. CAJA 5967.

B. District Court Proceedings

WARF sued Apple for infringement of the '752 patent in 2014. Long before trial, Apple argued that its processors do not infringe the '752 patent because, among other reasons, Apple's LSD predictor associates predictions with a group of load instructions using a Load Tag, instead of with the "particular" load instruction that mis-speculated as the '752 patent requires. *See, e.g.*, Dist. Ct. Dkt. 103 (¶252). Apple's defense was based on the plain and ordinary meaning of the term "particular," and neither party requested a different claim construction prior to trial. Pet. App. 10a-11a.

The district court held a bifurcated, two-week jury trial in Madison, Wisconsin in October 2015. Just before trial, WARF abandoned its theory of infringement under the doctrine of equivalents to prevent Apple from introducing its own patent into evidence during the trial's liability phase. CAJA 18758, 18603, 18641.

At trial, WARF's expert did not dispute how Apple's LSD predictor uses Load Tags. CAJA 1603-1606. Instead, he testified that he understood "particular" in the '752 patent claims to require only "an association," and not to include any requirement that a prediction be associated with the specific individual load instruction that mis-speculated. CAJA 1503 ("[I]n my opinion the claim doesn't require one and only, the claim and the patent contemplate there being more than one load that can map into a particular entry."); CAJA 1492 ("I think [the word] particular just is identifying in this case an association.").

WARF then filed a mid-trial motion to preclude Apple's expert from presenting a non-infringement defense that Apple's LSD predictor did not satisfy the "particular" limitation on the basis that such a defense

was purportedly inconsistent with the plain and ordinary meaning of “particular.” Dist. Ct. Dkt. 550 at 2. Apple opposed that motion, explaining that its non-infringement defense rested on the plain and ordinary meaning of “particular”—which refers to a single load instruction that is distinct from others. Dist. Ct. Dkt. 552 at 5-6. However, given WARF’s apparent disagreement with Apple over the plain and ordinary meaning of “particular,” Apple further requested that the court construe the term and instruct the jury as to its meaning. *Id.* at 9-10.

The district court noted that “WARF knew—or at least should have known—that its own interpretation of the term ‘the particular’ differed from Apple’s” since at least 2015. Pet. App. 129a. But “[r]egardless of who [wa]s to blame,” the court examined the claims and agreed with Apple that Apple’s non-infringement defense was consistent with the plain and ordinary meaning of “particular,” which “contemplates a single load instruction.” Pet. App. 131a. In fact, the court considered the language sufficiently clear that it saw no need to instruct the jury to do anything other than to apply the plain and ordinary meaning:

From all of this, the court concludes that claim 1 discloses a prediction associated with a single load instruction, albeit one that is “dynamic.” Because this language is consistent with the plain meaning of the claim terms “the” and “the particular,” the court concludes that there is no need for instructing the jury on the meaning of this term.

Pet. App. 132a.

The district court reiterated this view when Apple later requested that the court provide the jury with a

curative instruction as to the meaning of “particular.” Pet. App. 133a-134a. Although Apple’s defense was based on the plain meaning of the term, it worried that the jury might be confused because WARF’s expert had testified based on a contrary meaning. The district court rejected this concern, holding that Apple had “waived any request to now insert a construction of the term into the closing jury instructions.” Pet. App. 137a. The court noted that it had “sided with Apple in its request that the term simply be given its plain and ordinary meaning,” and that “for the reasons already explained in its prior opinion, plain meaning is sufficient.” *Id.*

At the close of evidence, Apple moved for judgment of non-infringement as a matter of law because, among other reasons, no reasonable jury could have found that Apple’s processors associate predictions with a “particular” load instruction. The district court denied Apple’s motion, noting without further explanation its belief that “a reasonable jury could conclude that a prediction was associated with a particular load instruction (even if that same prediction may be associated with other load instructions).” Pet. App. 146a.

The jury returned a verdict of infringement and awarded \$234 million in damages. The district court denied Apple’s renewed motion for judgment as a matter of law of non-infringement based upon the “particular” limitation for the same reasons that it denied Apple’s Rule 50(a) motion at the close of evidence. Pet. App. 157a-158a. The district court also denied Apple’s motion, in the alternative, for a new trial based upon the court’s failure to instruct the jury as to the meaning of the claim term “particular.” Pet. App. 158a. The court explained that it “agreed with Apple’s interpretation” that the plain and ordinary meaning of the “par-

particular” limitation requires “a prediction associated with a single load instruction,” but “given that this interpretation was consistent with the plain meaning of the claim terms ‘the’ and ‘the particular’ declined to insert a specific, untimely construction in the closing instructions.” *Id.*

After awarding supplemental damages, ongoing royalties, and interest, the district court entered a final judgment against Apple in the amount of \$506 million. Pet. App. 200a.

C. The Federal Circuit’s Decision

On appeal, Apple led with the argument that under the plain and ordinary meaning “instruction given, no reasonable jury could find literal infringement.” Apple C.A. Br. 21. WARF did not dispute that, in reviewing this argument, the Federal Circuit should apply the plain meaning of the claims. WARF C.A. Br. 11 (“plain and ordinary meaning was sufficient and correct for this limitation”). WARF also conceded that interpreting “particular” as requiring “a prediction associated with a *single* load instruction’ ... in effect restated the words of the claim.” *Id.* at 26.

The Federal Circuit carefully reviewed the record and, in an opinion written by Chief Judge Prost and joined by Judges Bryson and O’Malley, agreed with Apple that under the plain and ordinary meaning of the “particular” limitation, the jury’s infringement verdict was not supported by substantial evidence. The Federal Circuit made clear that it was not adopting a new claim construction in this analysis but rather applying the plain meaning of the claims as previously understood by the district court. The Federal Circuit explained:

Consistent with Apple’s understanding of the plain and ordinary meaning, the district court reasoned that “[f]rom the court’s reading of claim 1 as a whole, it contemplates a *single* load instruction.” In the district court’s view, this was “consistent with the plain meaning of the claim terms ‘the’ and ‘the particular.’” The court thus “conclude[d] that claim 1 discloses a prediction associated with a *single* load instruction.”

Pet. App. 12a (citations omitted). The Federal Circuit noted that it was WARF who was attempting to deviate from the plain meaning of the “particular” limitation. However, the Federal Circuit rejected that effort to “leave the term devoid of any meaning whatsoever” and concluded, as the district court had before, that “the plain meaning of ‘particular’ ... requires the prediction to be associated with a *single* load instruction.” *Id.*

The Federal Circuit then reviewed the evidence and concluded: “Applying the plain and ordinary meaning of the term ‘particular,’ and drawing all reasonable inferences from the evidence in favor of WARF, we hold that no reasonable juror could have found literal infringement in this case.” Pet. App. 13a. The court explained that “because of the way Apple’s hashing algorithm is designed, multiple load instructions may hash to the same load tag. Each load tag can therefore be associated with a *group* of load instructions,” meaning that “a given load instruction’s history will impact the prediction associated with *all* load instructions that hash to that same load tag.” *Id.* The court also found “insufficient evidence to support WARF’s theory that Apple’s load tags are *sometimes* associated with a single load instruction.” Pet. App. 15a. Among other

things, it noted that “only 4,096 load tags are possible” while “Apple’s operating system alone contains millions of load instructions.” Pet. App. 17a. Thus, “drawing all reasonable inferences in favor of WARF, there is insufficient evidence to support the jury’s finding that Apple’s products literally satisfy the ‘particular’ limitation.” Pet. App. 18a.

WARF petitioned for panel rehearing and rehearing en banc. The Federal Circuit denied the petition without dissent and without calling for a response. Pet. App. 26a-27a.

REASONS FOR DENYING THE PETITION

I. WARF’S FIRST QUESTION PRESENTED DOES NOT WARRANT REVIEW

A. WARF’s First Question Is Based On The Incorrect Premise That The Federal Circuit Adopted A New Claim Construction

WARF’s petition is based on an incorrect premise. The Federal Circuit did not construe the “particular” limitation in WARF’s patent claims “for the first time” on appeal. Pet. i. The court simply reviewed the verdict for substantial evidence using the same construction that the district court instructed the jury to apply, and concluded under the plain and ordinary meaning of the term that there was “insufficient evidence to support the jury’s finding that Apple’s products literally satisfy the ‘particular’ limitation.” Pet. App. 18a. WARF’s effort to transform this case-specific review of the sufficiency of the evidence into a broad legal question does not merit review.

Representative claim 1 of WARF’s patent requires, among other things, “a [load] instruction dependent for its data on a [store] instruction of earlier program or-

der” and a predictor that “produce[s] a prediction associated with *the particular* [load] instruction” when it receives a mis-speculation indication. Pet. App. 68a (emphasis added). Under the plain and ordinary meaning of this language, a prediction must be associated with “the particular [load] instruction,” not a group of load instructions. *Id.*; see Pet. App. 12a, 132a.

Well before trial, Apple argued that its products do not infringe because Apple’s LSD predictor uses a hashed Load Tag and therefore associates predictions with a group of load instructions, rather than with a “particular” load instruction. See, e.g., Dist. Ct. Dkt. 103 (¶¶241-261, 265-268). As the district court later found, “WARF knew—or at least should have known—that its own interpretation of the term ‘the particular’ differed from Apple’s” since at least 2015. Pet. App. 129a.

Apple remained consistent in its interpretation of the “particular” limitation through trial. In briefing summarizing the testimony Apple planned to offer at trial, Apple explained that its expert would testify that the LSD predictor does not infringe because it associates a prediction with a Load Tag, rather than with a “particular” load instruction. Dist. Ct. Dkt. 552 at 3 (“As a result of this grouping of load instructions by Load Tag, the LSD Predictor treats load instructions collectively and does not associate a prediction with ‘the particular’ load instruction.”).

When WARF moved to exclude this testimony, the district court made clear that it agreed with Apple’s understanding that the patent claim at issue “contemplates a single load instruction.” Pet. App. 131a. The court determined, however, that no special construction

beyond an instruction to apply the plain meaning of the claims was required:

From all of this, the court concludes that claim 1 discloses a prediction associated with a single load instruction, albeit one that is “dynamic.” Because this language is consistent with the plain meaning of the claim terms “the” and “the particular,” the court concludes there is no need for instructing the jury on the meaning of this term.

Pet. App. 132a. The district court reiterated this point when deciding that it did not need to provide further clarification in the closing instructions to counter WARF’s effort to deviate from the plain meaning of the term. Pet. App. 137a (“[F]or the reasons already explained in its prior opinion, plain meaning is sufficient.”).

The Federal Circuit did not adopt a new claim construction on appeal as WARF asserts. *See* Pet. i. Rather, it simply applied the plain and ordinary meaning construction adopted by the district court, understood in the same way that the district court had when it decided to give that instruction. The Federal Circuit summarized the district court’s conclusion that “consistent with the plain meaning of the claim terms ‘the’ and ‘the particular,’” “claim 1 discloses a prediction associated with a *single* load instruction.” Pet. App. 12a (quoting Pet. App. 132a). The Federal Circuit then agreed that “the plain meaning of ‘particular,’ as understood by a person of ordinary skill in the art after reading the ’752 patent, requires the prediction to be associated with a *single* load instruction.” Pet. App. 12a. The purportedly “new” construction the Federal Circuit adopted on appeal was thus exactly the same as the

construction applied below. This fact alone is fatal to WARF's petition, which wisely does not challenge the Federal Circuit's case-specific application of that construction to determine that the jury's infringement verdict was not supported by substantial evidence.

B. WARF's Argument Regarding The Jury's Role In Claim Construction Is Waived And, In Any Event, Does Not Warrant Review

Unable to show that the Federal Circuit adopted a new claim construction, WARF attempts to muddy the waters by arguing that the Federal Circuit's opinion should have deferred to the jury's "implicit fact findings" on the meaning of the "particular" limitation. Pet. i. This argument appears to rely on the premise that the jury interpreted the "particular" limitation and gave it a special meaning contrary to the plain and ordinary meaning discussed above. But WARF's attempt to secure this Court's review by injecting the jury into the claim construction process fails for multiple reasons.

First, WARF never argued to the Federal Circuit panel that it needed to defer to the jury on the proper construction of the "particular" limitation. WARF's brief in the Federal Circuit argued that the infringement verdict was supported by substantial evidence, and it briefly but incorrectly accused Apple of requesting a new claim construction. WARF C.A. Br. 13-18. But WARF's brief did not argue, as it does now, that the Federal Circuit needed to defer to any implicit fact-finding by the jury on claim construction. And despite WARF's attempt to pitch this case as an opportunity to clarify the application of this Court's decision in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831 (2015), WARF's panel brief never even cited *Teva*.

Indeed, far from telling the Federal Circuit that the “particular” limitation should be given a special meaning based on expert testimony or jury factfinding, WARF argued that “plain and ordinary meaning was sufficient and correct for this limitation.” WARF C.A. Br. 11. WARF also told the Federal Circuit that no further guidance needed to be given to the jury because an instruction that “a prediction associated with *the particular* ... instruction” meant “associated with *a single* load instruction” would have “in effect restated the words of the claim.” *Id.* at 26. The Federal Circuit cited both of these concessions when it recited the district court’s understanding of the plain meaning and then immediately observed that “WARF does not dispute the district court’s decision to give the term ‘particular’ its plain and ordinary meaning.” Pet. App. 12a.

WARF has thus waived the argument at the heart of its first question presented. And regardless of how it may attempt to recharacterize the record on reply, the very existence of a debate regarding WARF’s preservation of the issue stands as a serious vehicle problem, since the issue of waiver would have to be addressed before the question could be reached.

Second, even if WARF had preserved the argument, this case would remain a bad vehicle to consider the role of factfinding in claim construction because the alleged factfinding involved a snippet of unsupported expert testimony that would have been insufficient to override the plain language of the claims. WARF’s expert asserted across two quick questions and answers that, to a person of ordinary skill, “particular just is identifying in this case an association” and “was the association with the load instruction.” Pet. App. 126a-127a. That testimony did not allege that “particular” had an established meaning in the art or show based on

contemporaneous references that it would have been understood in a specific way. It was just a bare assertion.³

WARF relies on *Teva* for the proposition that, because “the ordinary rule governing appellate review of factual matters” applies to review of factual findings underlying claim construction, the Federal Circuit was required to give “deference to the jury’s implicit fact findings” on claim construction. Pet. 3 (quoting *Teva*, 135 S. Ct. at 838). But *Teva* also made clear that “[c]onstruction of written instruments often presents a ‘question solely of law,’ at least when the words in those instruments ‘are used in their ordinary meaning.’” 135 S. Ct. at 837. The district court instructed the jury to apply the plain and ordinary meaning of the claims to a person skilled in the art because it believed that the language of the claims themselves was clear. The court noted that in light of “the plain meaning of the claim terms ‘the’ and ‘the particular,’ the court concludes there is no need for instructing the jury on the meaning of this term.” Pet App. 132a. Unsupported expert testimony referring to nothing more than the claim language does not change that plain meaning. Accordingly, WARF cannot benefit from the rule it seeks, and this is not a good case in which to address the role of factfinding in claim construction.

Third, WARF proposes an approach to claim construction that contradicts this Court’s applicable precedent, including in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996). WARF argues that in jury trials, courts should defer to juries on questions of

³ In fact, WARF’s expert testified before trial that, in his view, the word “particular” “doesn’t add anything” in the patent claims. CAJA 17818.

fact underlying the ultimately legal question of a patent claim's scope. *See* Pet. 3, 19-20. However, WARF fails to acknowledge or even cite *Markman*, which held in a jury case that “the construction of a patent, including terms of art within its claim, is exclusively within the province of the court,” 517 U.S. at 372, even where that construction has “evidentiary underpinnings,” *id.* at 390.

A plain and ordinary meaning construction does not mean that a term has no meaning or that the jury is entitled to adopt a different construction. Rather, juries are told to use plain and ordinary meaning when, as the district court concluded here, there is no need for the court to provide an alternative formulation because the plain language of the claims adequately conveys the correct meaning.

Nothing in the *Teva* decision undermines *Markman*'s holding that claim construction is “exclusively” an issue for “the court.” *See Markman*, 517 U.S. at 372. To the contrary, *Teva* confirms that “when [this Court] held in *Markman* that the ultimate question of claim construction is for the judge and not the jury,” it “recognized that courts may have to resolve subsidiary factual disputes.” *Teva*, 135 S. Ct. at 838. WARF's argument (Pet. 19) that this Court has not decided what deference is owed to the jury on claim construction is incorrect; this Court squarely assigned responsibility for claim construction and its factual underpinnings to judges. *Markman*, 517 U.S. at 376. WARF provides no exceptional justification for overruling *Markman* on this point.

Fourth, the district court's occasionally confusing statements do not save WARF's petition. The district court's explanation for denying JMOL was admittedly

hard to follow to the extent it implied that the jury might have interpreted the claims differently from the court. Pet. App. 157a. But in the very same opinion, the district court reiterated that it “agreed with Apple’s interpretation, concluding that claim 1 ‘disclosed a prediction associated with a single load instruction,’” which was “consistent with the plain meaning of the claim terms.” Pet. App. 158a. Likewise, although the district court did at one point remark that “it is the jury who will decide what the ordinary or plain meaning is,” Pet. App. 126a, it subsequently precluded Apple from cross-examining WARF’s expert on the testimony that followed on the ground that “if you’re trying to engage in an argument over construction, that’s not appropriate,” CAJA 1602. The court then gave a curative instruction to the jury: “Just so we’re clear, the Court provides the construction of the claims.” *Id.* If WARF wanted to argue on appeal that the jury should have a formal role in claim construction—as opposed to its appropriate role comparing the claims as construed to an accused product to determine infringement—it should have made that argument to the Federal Circuit panel so the issue could be addressed below.

Fifth, WARF’s reliance (Pet. 4, 22, 24) on Judge O’Malley’s dissent from the denial of rehearing en banc in *NobelBiz, Inc. v. Global Connect, L.L.C.*, 876 F.3d 1326 (Fed. Cir. 2017), is misplaced. Judge O’Malley’s dissent expressed concern that district courts may feel “compelled” to resolve late-arising claim construction disputes rather than instructing the jury to apply a term’s plain and ordinary meaning. *Id.* at 1329. That is the opposite of what happened here, where the case went to the jury under a plain and ordinary meaning construction and was reviewed on the same basis on appeal. Indeed, Judge O’Malley presumably does not

believe that her *NobelBiz* dissent applies, since she joined the majority opinion in this case and did not dissent from the denial of en banc review.

In sum, WARF's first question presented is waived, and even if it were not, the question would not merit review, especially in the context of this case.

II. WARF'S SECOND QUESTION PRESENTED DOES NOT WARRANT REVIEW

A. WARF's Second Question Is Also Based On The Incorrect Premise That The Federal Circuit Adopted A New Claim Construction

WARF's second question presented asks whether the Federal Circuit may apply a new claim construction on appeal without remanding for further proceedings. Once again, this question is not actually presented because it is based on a false premise. As discussed, the Federal Circuit did not adopt a new claim construction on appeal. It simply applied the plain and ordinary meaning of the "particular" limitation, just as the jury had been instructed to do. WARF is seeking review of a hypothetical question.

Even if the issue were more debatable than it is, this dispute over the predicate for WARF's second question makes this case an especially poor vehicle to address the circumstances in which the Federal Circuit should remand after adopting a new claim construction. The Court could not even reach that question until it had resolved what is, at a minimum, a substantial—and, in reality, lopsided in Apple's favor—dispute regarding whether the Federal Circuit changed claim constructions on appeal.

Relying on statistics that are more than a decade old, WARF argues that the Federal Circuit regularly

issues new claim constructions on appeal. Pet. 25. If there were actually a need for guidance, it should be easy to address the second question presented in a case in which the Federal Circuit actually changed constructions on appeal but made a mistake in deciding whether to remand. The last thing this Court should do is take up the question in a case in which it is not even presented or, at least, there is a substantial dispute over that issue.

B. Even Setting Aside WARF's Incorrect Premise, The Second Question Does Not Warrant Review

Even setting aside the fact that the Federal Circuit did not adopt a new claim construction, WARF's second question presented does not warrant review, and additional vehicle problems make this case an especially inapt one for addressing it.

First, because the Federal Circuit did not think it was adopting a new claim construction, it never reached the question of what factors should guide an appellate court's decision to remand. Nor did WARF brief the issue before the panel. "The Court does not ordinarily decide questions that were not passed on below." *City & Cty. of S.F. v. Sheehan*, 135 S. Ct. 1765, 1773 (2015); *see also Cutter v. Wilkinson*, 544 U.S. 709, 718 n.7 (2005) ("[W]e are a court of review, not of first view[.]").

Second, the alleged "lines of divergent authority" in the Federal Circuit (Pet. 27) do not reflect a legal disagreement but simply normal variation from case to case based on differences in the specific facts and posture of the cases. WARF has not even attempted to demonstrate that any of the individual cases it cites was

wrongly decided on its facts, let alone come close to demonstrating any sort of systematic problem or general rule that deprives parties of the opportunity to receive a remand in appropriate circumstances.

To the contrary, WARF's own cases (Pet. 25-27) show that the Federal Circuit often remands for further consideration where—unlike here—it adopts a new claim construction on appeal.⁴ In the cited cases where the Federal Circuit did not remand, it was based on an analysis of the case-specific circumstances, leading to the conclusion that no reasonable jury applying the correct construction could reach a contrary result.⁵ For example, WARF cites *CVI/Beta Ventures* for the proposition that “‘failure of proof under the correct claim construction’ based on the existing record

⁴ *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1319 (Fed. Cir. 2014); *August Tech. Corp. v. Camtek, Ltd.*, 655 F.3d 1278, 1286 (Fed. Cir. 2011); *Lazare Kaplan Int'l, Inc. v. Photoscribe Techs., Inc.*, 628 F.3d 1359, 1370 (Fed. Cir. 2010); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1324 (Fed. Cir. 2008); *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1253-1255 (Fed. Cir. 2005); *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 381 F.3d 1371, 1382-1383 (Fed. Cir. 2004); *Abbott Labs. v. Synttron Bioresearch, Inc.*, 334 F.3d 1343, 1351, 1358 (Fed. Cir. 2003).

⁵ See, e.g., *Bowers v. Baystate Techs., Inc.*, 320 F.3d 1317, 1334 (Fed. Cir. 2003) (reversing district court's claim construction and denial of motion for JMOL of non-infringement because no reasonable jury could find infringement based on the new claim construction); *SimpleAir v. Sony Ericsson Mobile Commc'ns*, 820 F.3d 419, 431-432 (Fed. Cir. 2016) (reversing claim construction and directing judgment of no infringement because it was uncontested that no reasonable jury could have found infringement under the proper construction); *Eon Corp. IP Holdings v. Silver Spring Networks, Inc.*, 815 F.3d 1314, 1320 & n.3 (Fed. Cir. 2016) (holding that district court erred by failing to construe disputed claim terms, and that under the proper claim construction no reasonable jury could have found infringement).

purportedly suffices for the panel to enter ‘judgment of noninfringement as a matter of law.’” Pet. 27 (quoting *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1161 (Fed. Cir. 1997)). But in *CVI/Beta Ventures*, the Federal Circuit determined that the patentee was “on notice that adoption of [the defendant’s] claim construction was a distinct possibility,” but “[n]evertheless ... confined its proof at trial to evidence purporting to establish infringement under its construction of the claims.” 112 F.3d at 1162. Under those circumstances, the Federal Circuit unremarkably determined that the defendant was entitled to judgment of noninfringement. *Id.*

Third, despite requesting “clear guidance for when remand is appropriate,” WARF never specifies what rule it would have this Court adopt. WARF is presumably not arguing that remand is always required. For example, it appears to concede that remand would be unnecessary “where attempting to establish infringement under the new construction would be futile.” Pet. 28. WARF’s petition thus quickly devolves (at 29-32) into a fact-bound argument regarding whether allegedly new evidence might save its claims on the specific facts of this case.⁶ This Court should not spend its limited time addressing a fact-intensive, technologically-complex fight over a hypothetical remand, even apart from the fact that the request for a remand rests on the incorrect premise that the Federal Circuit adopted a new claim construction on appeal.

Fourth, WARF’s argument (Pet. 28) that “the trial record would have been very different” if “the new con-

⁶ It would not. Indeed, all but one piece of “new” evidence that WARF says it would offer was already presented at trial. Compare Pet. 31-32, with Pet. App. 235a.

struction governed below” ignores WARF’s own awareness of the substance of Apple’s defense. As the district court found, “Apple’s expert articulated its reading of claim 1a in his March 2015 report and reiterated the theory in his August 2015 report. WARF knew—or at least should have known—that its own interpretation of the term ‘the particular’ differed from Apple’s.” Pet. App. 128a-129a (citations omitted). If WARF wanted the claims to be construed contrary to their plain and ordinary meaning, it should have made such a request before relying on the high-risk and ultimately unsuccessful strategy of trying to deviate from that plain meaning at trial. Likewise, if it had additional evidence to counter Apple’s non-infringement argument under the plain and ordinary meaning construction that went to the jury, WARF should have presented that evidence at trial.

Fifth, it is clear that what WARF really wants is an opportunity to *switch* theories on remand by pursuing an infringement case under the doctrine of equivalents. See Pet. 32. WARF affirmatively waived any reliance on the doctrine of equivalents in the district court. In making that decision, WARF did not say anything about the claim construction of the “particular” limitation. Rather, the issue arose after WARF filed a motion in limine to exclude evidence or argument concerning Apple’s own patent on the accused LSD predictor. Dist. Ct. Dkt. 290. Apple opposed because, among other reasons, the patentability of Apple’s accused technology over WARF’s ’752 patent was relevant to rebutting WARF’s theory of infringement under the doctrine of equivalents. Dist. Ct. Dkt. 398 at 2-3, 6-8. WARF responded by offering to abandon its doctrine of equivalents theory to keep Apple’s patent out of the record at the liability phase. WARF stated:

[S]hould the Court conclude that Apple has laid a proper foundation for the question of the impact of the allowance of [Apple's] '647 application on doctrine of equivalents to be presented to the jury, then WARF will drop doctrine of equivalents and make no doctrine of equivalents arguments whatsoever at trial, making the application irrelevant for any purpose.

Dist. Ct. Dkt. 512-1 at 1 (emphasis omitted). Apple agreed to this proposal, and the district court's ruling said:

WARF has agreed to "drop doctrine of equivalent[ts] and make no doctrine of equivalents arguments whatsoever at trial" if [Apple's] '647 application is allowed into evidence. In kind, Apple has agreed it will not offer the "647 application or the issued '725 patent" for any reason during the liability phase of trial "if the doctrine of equivalents is not in issue."

Dist. Ct. Dkt. 517 at 2 (citations omitted). The Federal Circuit confirmed this waiver on appeal: "WARF abandoned its theory of infringement under the doctrine of equivalents before trial and has proceeded only on a theory of literal infringement." Pet. App. 10a n.5. Even if the Federal Circuit had adopted a new claim construction (which it did not), WARF's request (Pet. 32) for a remand to address the doctrine of equivalents would fail because WARF made a deliberate decision to waive that argument for strategic reasons.

Finally, WARF's invocation of the Seventh Amendment and the Due Process Clause adds nothing. As with WARF's entire remand argument, the Federal Circuit did not rule on either provision because it did not think it was changing its claim construction and

WARF never argued to the panel that granting JMOL would violate the constitution. Regardless, the right to a jury trial is not abridged when a party receives JMOL on the ground that the evidence is legally insufficient for any reasonable jury to find against it. *See, e.g., Neely v. Martin K. Eby Constr. Co.*, 386 U.S. 317, 322 (1967) (“[T]here is no constitutional bar to an appellate court granting judgment n.o.v.”); *Weisgram v. Marley Co.*, 528 U.S. 440, 449-457 (2000). There is also no plausible due process violation here given that, among other things, WARF had ample notice of Apple’s defense and the basis of its JMOL motion.⁷ More importantly, WARF has not established any split in the lower courts or other compelling need for guidance on the meaning of the Seventh Amendment or the Due Process Clause.

⁷ The cases that WARF cites (Pet. 33) are inapposite. *Hamling v. United States*, 418 U.S. 87 (1974), was a criminal case, and the passage that WARF quotes is from the *dissent*. *Id.* at 149-150. In *Saunders v. Shaw*, 244 U.S. 317, 319 (1917), the relevant argument was foreclosed before an intervening Supreme Court decision, and the district court had ruled that evidence relating to that argument was inadmissible. In *Carpet World, Inc. v. Riddles*, 737 P.2d 939 (Okla. 1987), the trial court had disposed of the case as a matter of law at the close of the plaintiffs’ case before the defendant put on any evidence, but the intermediate court of appeal had reversed that ruling and ordered entry of judgment against the defendant. *Id.* at 941-942. The Oklahoma Supreme Court’s decision simply held that it was improper to enter judgment against the defendant without *any* opportunity for it to put on evidence, including evidence relating to defenses that were never considered. The court distinguished this unusual situation from the “general rule,” saying “the general rule that the appellate court will render the judgment the trial court should have rendered is not operative inasmuch as the defendant has yet to put his evidence before the [c]ourt.” *Id.* at 942.

CONCLUSION

For the foregoing reasons, the petition should be denied.

Respectfully submitted.

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