

No. \_\_\_\_\_

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**In the Supreme Court of the United States**

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CJ CHEILJEDANG CORP., CJ AMERICA, INC., PT.  
CHEILJEDANG INDONESIA, PETITIONERS,

*v.*

INTERNATIONAL TRADE COMMISSION, AJINOMOTO CO.,  
INC., AJINOMOTO ANIMAL NUTRITION  
NORTH AMERICA, INC.

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

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**PETITION FOR A WRIT OF CERTIORARI**

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STEVEN PEPE  
RACHAEL BACHA  
HYUN-JOONG KIM  
ROPES & GRAY LLP  
1211 Avenue of the Americas  
New York, NY 10036

JAMES F. HALEY, JR.  
BRIAN M. GUMMOW  
HALEY GUILIANO LLP  
75 Broad Street  
Suite 1000  
New York, NY 10004

DOUGLAS HALLWARD-DRIEMEIER  
*Counsel of Record*  
MATTHEW J. RIZZOLO  
ROPES & GRAY LLP  
2099 Pennsylvania Ave, N.W.  
Washington, DC 20006  
(202) 508-4600  
*Douglas.Hallward-Driemeier@  
ropesgray.com*

PHILLIP Z. YAO  
ROPES & GRAY LLP  
800 Boylston Street  
Boston, MA 02199

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## QUESTION PRESENTED

The doctrine of equivalents in patent law prevents a would-be infringer from avoiding infringement by making insubstantial changes to a patented invention. But, when a patentee narrows its claims during prosecution to overcome a rejection, the patentee is presumed to be estopped from later invoking the doctrine of equivalents to recapture the territory between the original, broader claim and the narrower, amended one. Prosecution history estoppel ensures that the doctrine of equivalents does not defeat the patent's public notice function.

In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, this Court held that prosecution history estoppel can be rebutted if the patentee demonstrates “that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” 535 U.S. 722, 741 (2002). As relevant here, a patentee could do so by showing that “the rationale underlying the amendment \* \* \* bear[s] no more than a tangential relation to the equivalent in question.” *Id.* at 740. Until the decisions in this case and *Eli Lilly & Co. v. Hospira, Inc.*, 933 F.3d 1320 (Fed. Cir. 2019), the Federal Circuit had consistently held that a patentee's silence at the time of amendment could not satisfy this exception. Here, however, the Federal Circuit held that the rationale can be provided *post hoc*, in light of the product accused in litigation. The question presented is:

Whether, to avoid prosecution history estoppel under *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, “the rationale underlying the amendment” must be the rationale the patentee provided to the public at the time of the amendment.

(I)

**PARTIES TO THE PROCEEDING BELOW  
AND RULE 29.6 STATEMENT**

All parties are identified in the caption of this petition. Petitioner CJ CheilJedang Corp. is a parent corporation of petitioners CJ America, Inc. and PT. CheilJedang Indonesia with more than 10% ownership. CJ Corporation is a parent corporation of petitioner CJ CheilJedang Corp. with more than 10% ownership.

**RELATED PROCEEDINGS**

This petition is related to Investigation No. 337-TA-1005 in the United States International Trade Commission. Respondents Ajinomoto Co., Inc. and Ajinomoto Animal Nutrition North America, Inc. (formerly known as Ajinomoto Heartland Inc.) have also brought patent infringement claims against petitioners under the same two patents asserted in Inv. No. 337-TA-1005 (U.S. Patent Nos. 6,180,373 and 7,666,655) in the Southern District of New York: *Ajinomoto Co., Inc. v. CJ CheilJedang Corp.*, 1:16-cv-03498-JGK (SDNY). That case was stayed pending Inv. No. 337-TA-1005 and is currently closed administratively.

## TABLE OF CONTENTS

	Page
Opinions below .....	1
Jurisdiction .....	2
Statement of the case.....	2
A.    Applicable legal doctrines.....	5
1.    The doctrine of equivalents, counterbalanced by prosecution history estoppel.....	5
2.    The tangential exception, pre-2019.....	7
B.    Proceedings below .....	8
1.    Prosecution history of U.S. Patent No. 7,666,655 and the alleged equivalent .....	8
2.    The International Trade Commission.....	10
3.    The Federal Circuit appeal .....	11
Reasons for granting the petition .....	13
I.    The Federal Circuit’s decision undermines the public notice function of a patent’s prosecution history .....	15
A.    Prosecution history estoppel is a key component of patents’ public notice function .....	15
B.    The public notice function of the prosecution history is undermined by the Federal Circuit’s use of a <i>post-hoc</i> rationale in the face of a patentee’s silence.....	18
II.   The Federal Circuit’s new rule poses a grave threat to innovation .....	22

IV

Table of Contents—Continued	Page
III. Restoring the public notice function of prosecution history requires this Court’s immediate intervention, and this case is an ideal vehicle .....	24
A. This case (and <i>Hospira</i> ) sharply break from precedent.....	24
B. The patentee’s silence in the prosecution history makes this case the ideal vehicle for certiorari.....	26
Conclusion.....	28
Appendix A — Court of appeals majority opinion (Aug. 6, 2019).....	1a
Appendix B — Court of appeals Judge Timothy B. Dyk opinion (Aug. 6, 2019).....	36a
Appendix C — International Trade Commission opinion (Jan. 11, 2018) .....	44a
Appendix D — Court of appeals order denying rehearing (Nov. 25, 2019) .....	110a
Appendix E — Court of appeals judgment (Aug. 6, 2019).....	112a

## TABLE OF AUTHORITIES

	Page(s)
Cases:	
<i>Duncan Parking Techs., Inc. v. IPS Grp., Inc.</i> , 914 F.3d 1347 (Fed. Cir. 2019) .....	22
<i>Eli Lilly &amp; Co. v. Hospira, Inc.</i> , 933 F.3d 1320 (Fed. Cir. 2019) .....	<i>passim</i>
<i>Evans v. Eaton</i> , 20 U.S. 356 (1822).....	16
<i>Exhibit Supply Co. v. Ace Patents Corp.</i> , 315 U.S. 126 (1942).....	19, 20
<i>Felix v. Am. Honda Motor Co.</i> , 562 F.3d 1167 (Fed. Cir. 2009) .....	7, 25
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.</i> , 344 F.3d 1359 (Fed. Cir. 2003), cert. denied, 541 U.S. 988 (2004) .....	3, 7
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.</i> , 535 U.S. 722 (2002).....	<i>passim</i>
<i>General Elec. Co. v. Wabash Appliance Corp.</i> , 304 U.S. 364 (1938).....	15, 17
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966) .....	5
<i>Honeywell Int'l, Inc. v. Hamilton Sundstrand Corp.</i> , 523 F.3d 1304 (Fed. Cir.), cert. denied, 555 U.S. 939 (2008).....	3, 7, 22, 25
<i>I.T.S. Rubber Co. v. Essex Rubber Co.</i> , 272 U.S. 429 (1926).....	19, 20
<i>Insituform Techs., Inc. v. CAT Contracting, Inc.</i> , 385 F.3d 1360 (Fed. Cir. 2004) .....	7, 25

VI

Cases—Continued:	Page(s)
<i>Intervet Inc. v. Merial Ltd.</i> , 617 F.3d 1282 (Fed. Cir. 2010) .....	8, 26
<i>Kewanee Oil Co. v. Bicron Corp.</i> , 416 U.S. 470 (1974) .....	5, 24
<i>Keystone Driller Co. v. Nw. Eng’g Corp.</i> , 294 U.S. 42 (1935).....	6
<i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 572 U.S. 898 (2014).....	4, 15, 16
<i>Pioneer Magnetics, Inc. v. Micro Linear Corp.</i> , 330 F.3d 1352 (Fed. Cir. 2003) .....	7
<i>Regents of Univ. of Cal. v. Dakocytomation Cal., Inc.</i> , 517 F.3d 1364 (Fed. Cir. 2008).....	8, 25
<i>Shepard v. Carrigan</i> , 116 U.S. 593 (1886).....	19
<i>Warner-Jenkinson Co. v. Hilton Davis Chem. Co.</i> , 520 U.S. 17 (1997).....	<i>passim</i>
Statute:	
28 U.S.C. 1295 .....	26

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Petitioners CJ CheilJedang Corp., CJ America, Inc., and PT. CheilJedang Indonesia respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

**OPINIONS BELOW**

The opinion of the court of appeals (App., *infra*, 1a-43a) is reported at 932 F.3d 1342. The public version<sup>1</sup> of the relevant International Trade Commission decision (App., *infra*, 44a-109a) is reported at 82 Fed. Reg. 60,763-60,764.

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<sup>1</sup> While the full International Trade Commission decision included certain material redacted for confidentiality reasons, none of the redacted material is relevant to the issues raised in this petition.



## JURISDICTION

The court of appeals entered judgment on August 6, 2019 (App., *infra*, 112a-113a). A timely petition for rehearing was denied on November 25, 2019 (App., *infra*, 110a-111a). The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

## STATEMENT OF THE CASE

This case presents an important issue at the heart of the patent system: the public’s ability to rely on a patentee’s representations to the Patent Office during prosecution (called the “prosecution history”) to determine the metes and bounds of a claim. During prosecution, when the Patent Office rejects a claim as unpatentable in view of the prior art, the patentee often chooses to narrow its claims to avoid that art and secure allowance of the amended claim. This results in a presumption of prosecution history estoppel, preventing the patentee from later relying on the doctrine of equivalents<sup>2</sup> to recapture the surrendered territory between the original, broader claim and the narrower, amended claim. Such estoppel places “reasonable limits on the doctrine of equivalents” to ensure that it does not conflict with the underlying public notice and disclosure functions of the Patent Act. *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 34 (1997).

In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, the Court held that to rebut the presumption of prosecution history estoppel, a “patentee must show that at the time of the amendment one skilled in

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<sup>2</sup> The doctrine of equivalents prevents a would-be infringer from avoiding infringement by making insubstantial changes to a patented invention.

the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” 535 U.S. 722, 741 (2002). As relevant here, the Court stated that a patentee could avoid estoppel by demonstrating that “the rationale underlying the amendment \* \* \* bear[s] no more than a tangential relation to the equivalent in question.” *Id.* at 740.

Since *Festo*, this Court has not had occasion to clarify that, consistent with the principle of public notice, a patentee must have stated the “rationale” in question on the record at the time of the amendment. Until recently, there was no need to do so. The Federal Circuit itself had applied such a limit, holding that the rationale “should be discernible from the prosecution history record, if the public notice function of a patent and its prosecution history is to have significance.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1369 (2003) (en banc), cert. denied, 541 U.S. 988 (2004). “Silence,” the Federal Circuit has recognized, “does not overcome the presumption.” *Honeywell Int’l, Inc. v. Hamilton Sundstrand Corp.*, 523 F.3d 1304, 1316, cert. denied, 555 U.S. 939 (2008).

In the present case and *Eli Lilly & Co. v. Hospira, Inc.*, 933 F.3d 1320 (2019), issued within days of each other, the Federal Circuit adopted a new rule that applies the “tangential exception” to prosecution history estoppel even where the patentee gave no contemporaneous explanation in the prosecution history for why it chose the particular amended claim language or how the amendment overcame the rejection. The Federal Circuit’s departure from its own and this Court’s precedent disrupts the delicate balance between the doctrine of

equivalents and prosecution history estoppel that this Court has established.

The court of appeals' new rule improperly allows a patentee to rely on a *post-hoc* rationale, in light of the accused product, for the narrowing amendment to recapture voluntarily surrendered claim scope. The new rule thus creates perverse incentives at odds with the Patent Act's and this Court's focus on public notice. Rather than encouraging transparency during patent prosecution, these decisions encourage patentees to withhold any explanation during prosecution for why they chose particular amended claim language or what they did not intend to surrender by that amendment. The patentee is then free, in subsequent litigation, to craft with hindsight a rationale designed to be "tangential" to the alleged equivalent.

The effect of the court of appeals' decision will be devastating. The public will be denied notice of the actual scope of the surrender or what is subject to subsequent recapture as an "equivalent" until the end of infringement litigation, with the prospect of millions of dollars in damages and potential injunctions. Like a patent claim employing indefinite terms, the "zone of uncertainty" that this pair of Federal Circuit precedential decisions has created raises a "risk of infringement claims" that will inevitably deter "enterprise and experimentation." *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 909 (2014) (quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942)).

Certiorari is warranted to restore the public notice function of a patent's prosecution history and prevent further harm to innovation in the United States.

## A. Applicable Legal Doctrines

### 1. The Doctrine Of Equivalents, Counterbalanced By Prosecution History Estoppel

This Court has long held that under the doctrine of equivalents, a product that does not literally infringe the express terms of a patent claim may nonetheless be found to infringe if there is “equivalence” between elements of the accused product and elements of the patent claim. See *Warner-Jenkinson*, 520 U.S. at 321. This equitable doctrine protects a patentee “against efforts of copyists to evade liability for infringement by making only insubstantial changes to a patented invention.” *Festo*, 535 U.S. at 727. At the same time, the Court has acknowledged that if the doctrine of equivalents is applied broadly, it “can create substantial uncertainty about where the patent monopoly ends.” *Ibid.* This “conflicts with the definitional and public-notice functions of the statutory claiming requirement,” *Warner-Jenkinson*, 520 U.S. at 29, which are the Constitutional *quid pro quo* for a patentee’s right to exclude, see *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 484 (1974). The prosecution history is an important part of that public disclosure *quid pro quo*. See *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966).

The Court has recognized that invoking the doctrine of equivalents to reclaim territory surrendered during patent prosecution presents particular risk to the patent’s public notice function. Thus, the Court has held that “[w]hen the patentee responds to [a Patent Office] rejection by narrowing [the] claims, this prosecution history estops [the patentee] from later arguing that the subject matter covered by the original, broader claim” but not covered by the narrower, amended claim, “was

nothing more than an equivalent” of the amended claim. *Festo*, 535 U.S. at 727. “Competitors may rely on the estoppel to ensure that their own devices will not be found to infringe by equivalence.” *Ibid.* Over the past century, the Court has repeatedly emphasized prosecution history estoppel as a counterbalance to the doctrine of equivalents, to “ensure[] that the doctrine of equivalents remains tied to its underlying purpose.” *Festo*, 535 U.S. at 734; *Warner-Jenkinson*, 520 U.S. at 34; *Keystone Driller Co. v. Nw. Eng’g Corp.*, 294 U.S. 42, 48 (1935).

“Mindful that claims do indeed serve both a definitional and a notice function,” the Court has placed “the burden on the patent holder to establish the reason for an amendment required during patent prosecution.” *Warner-Jenkinson*, 520 U.S. at 33. To rebut the presumption, the patentee “bear[s] the burden of showing that the amendment does not surrender the particular equivalent in question.” *Festo*, 535 U.S. at 740.

The Court cabined the showing necessary to rebut the presumption of prosecution history estoppel to three limited circumstances: (1) where the equivalent was “unforeseeable at the time of the application”; (2) where “the rationale underlying the amendment \* \* \* bear[s] no more than a tangential relation to the equivalent in question”; or (3) where, for some other reason, “the patentee could not reasonably be expected to have described the insubstantial substitute in question.” *Festo*, 535 U.S. at 740-741. In these ways, the patentee can “show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.” *Id.* at 741.

## 2. The Tangential Exception, Pre-2019

Until the present case and *Hospira*, in the nearly 20 years since this Court's decision in *Festo*, the Federal Circuit's tangential exception analysis has "focuse[d] on the patentee's objectively apparent reason for the narrowing amendment" and required that such "reason should be discernible from the prosecution record" in order for "the public notice function of a patent and its prosecution history \* \* \* to have significance." *Festo*, 344 F.3d at 1369-1370.

Consistent with that jurisprudence, the Federal Circuit has explained that "[s]ilence [at the time of amendment] does not overcome the presumption" of prosecution history estoppel. *Honeywell Int'l*, 523 F.3d at 1316. The Federal Circuit has, thus, applied prosecution history estoppel where the patentee provided "no explanation in the prosecution history for the addition of the [narrowing] limitation." *Felix v. Am. Honda Motor Co.*, 562 F.3d 1167, 1184 (2009). Likewise, the Federal Circuit has also rejected a patentee's *post-hoc* rationales, such as inventor declarations submitted during litigation purporting to describe the reason an amendment was made. *Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 330 F.3d 1352, 1356 (2003).

Prior to this case and *Hospira*, when the Federal Circuit applied the tangential exception to rebut the presumption of prosecution history estoppel, it specifically looked to the patentee's explicit explanation in the prosecution history of how its amendment overcame the rejection. See *Insituform Techs., Inc. v. CAT Contracting, Inc.*, 385 F.3d 1360, 1370 (2004) (patentee's argument in the prosecution history based on location of the vacuum source was tangential to the number of vacuum sources);

*Regents of Univ. of Cal. v. Dakocytomation Cal., Inc.*, 517 F.3d 1364, 1378 (2008) (patentee’s argument in the prosecution history that prior art did not teach its blocking method generally was tangential to the specific reagents used in the method); *Intervet Inc. v. Merial Ltd.*, 617 F.3d 1282, 1291 (2010) (patentee’s argument in the prosecution history distinguishing prior art based on the organism from which the genes were derived was tangential to the specific gene sequences that may be derived from the claimed organism).

In August 2019, the Federal Circuit made a dramatic departure from this historical precedent. In the present case and *Hospira*, the Federal Circuit applied the tangential exception, notwithstanding that the patentees had provided no explanation in the prosecution history as to how their claim amendments overcame the rejections in question or that they intended to surrender less than the entire territory between the original and amended claims. See App., *infra*, 20a, 23a-24a; *Eli Lilly & Co. v. Hospira, Inc.*, 933 F.3d 1320, 1331 (Fed. Cir. 2019).

## **B. Proceedings Below**

### **1. Prosecution History Of U.S. Patent No. 7,666,655 And The Alleged Equivalent**

U.S. Patent No. 7,666,655 (the ‘655 patent), the only patent at issue in this petition, relates to *E. coli* strains used to produce tryptophan.

Claim 1 of the ‘655 patent originally claimed proteins that characterized those strains in terms of their structure: “a protein which *comprises an amino acid sequence* including deletion, substitution, insertion or ad-

dition of one or several amino acids in the amino acid sequence shown in SEQ ID NO:2.” App., *infra*, 18a-19a (emphasis added) (quoting C.A. App. 5047). There is no dispute that the original claim captured the alleged equivalent. *Id.* at 39a (Dyk, J. dissenting).

The Examiner rejected the claim as anticipated in view of prior art (Livshits) that disclosed a protein having the structure recited in original claim 1. App., *infra*, 19a.

In response, the patentee amended the claim so that it no longer defined the proteins by their structure but, instead, redefined them as: proteins “*encoded by a nucleotide sequence that hybridizes with the nucleotide sequence of SEQ ID NO:1 under stringent conditions.*” App., *infra*, 19a (emphasis added) (quoting C.A. App. 5609). There is no dispute that the alleged equivalent is outside the literal scope of the amended claim. It is not “encoded by” the recited nucleotide sequence. *Id.* at 17a, 40a (Dyk, J. dissenting).

It is also not disputed that, when narrowing and redefining the claim to overcome the art, the patentee did not provide the Examiner or public with any explanation regarding the amendment. Rather, the patentee provided only a factual summary of the rejection and a conclusory statement that, in view of the amendment, the cited art no longer anticipated the claim:

The Examiner cites Livshits et al as disclosing a bacterium within the scope of Claim 1. This amendment [*sic*, rejection] was based on the broad interpretation of Claim 1 (B) as encompassing any protein that would result in an increase in L-amino acid production due to the



use of the phrase “an amino acid sequence including deletion, substitution, insertion or addition of one *or several amino acids* in the amino acid sequence shown in SEQ ID NO:2.” Applicants have amended part (B) of Claim 1 to **define** the protein as one that is “encoded by a nucleotide sequence that hybridizes with the nucleotide sequence of SEQ ID NO: 1 under stringent conditions comprising 60°C, 1 x SSC, 0.1% SDS.” In view of this amendment, Livshits et al no longer anticipates the claimed invention.

C.A. App. 5617 (underlining and italics in original, bolding added); see also App., *infra*, 39a (Dyk, J. dissenting). The patentee never explained how its amendment and redefinition of the protein distinguished the cited art. The patentee just said it did. The patentee likewise never said that it intended to surrender less than the entire territory between the original and amended claim.

Finally, it is undisputed that the patentee at the time it narrowed the claim knew how to claim the alleged equivalent, inasmuch as the original claim did just that. App., *infra*, 39a (Dyk, J. dissenting).

## 2. The International Trade Commission

In its decision, the Commission held that the patentee’s narrowing amendment created a presumption of prosecution history estoppel with respect to the protein redefinition. App., *infra*, 93a-94a. The Commission held, however, that the tangential exception applied. *Id.* at 95a. The Commission did not identify a rationale for the narrowing amendment. *Id.* at 96a. Rather than identify the *rationale* for the amendment, the Commission

concluded that the narrowing amendment *itself* was tangential to the alleged equivalent, *id.* at 96a-97a, and found that the alleged equivalent infringed the amended claim under the doctrine of equivalents.

### 3. The Federal Circuit Appeal

The parties cross-appealed the Commission's decision to the Federal Circuit. Because the prosecution history was silent about the patentee's rationale for the narrowing amendment, each party—petitioners, respondents, and the Commission—hypothesized a different purported rationale. Petitioners argued that the patentee's silence necessarily meant that it had surrendered the full scope of subject matter between the original claim and the amended claim. CJ Opening C.A. Br. 44-45. Respondents, by contrast, argued that the patentee intended to surrender only the protein cited in the Examiner's rejection and "possibly" other proteins that were not functionally equivalent to the protein characterizing the claimed strains. Ajinomoto Response/Reply C.A. Br. 41-42. The Commission, for its part, asserted that the amendment limited the claim to certain types of genes. ITC C.A. Br. 66.

A divided panel of the court of appeals affirmed the Commission's determination that the tangential exception applied and rebutted the presumption of prosecution history estoppel. App., *infra*, 20a. The court of appeals did not, however, accept *any* of the parties' hypothesized rationales. Instead, it found, *sua sponte*, that the reason the patentee chose the language of its amendment was "to limit the set of proteins within the claim's scope so that it no longer included the prior art *E. coli* YfiK protein and, more generally, no longer allowed as wide a range of *amino acid* alterations" (hence deletions,

substitutions, insertions, or additions to the structure of the protein) as the original claim. *Id.* at 23a. In support of its *post-hoc* rationale, the Federal Circuit cited only the original claim language, *not* any statement the patentee made at the time of the amendment. *Ibid.* (citing C.A. App. 5047).

Judge Dyk dissented, emphasizing that the patentee's hindsight assertion of a rationale for the narrowing amendment was inconsistent with how the claim was, in fact, amended. App., *infra*, 40a-41a. Judge Dyk further noted that “[t]he fact that the inventors may have thought after the fact that they could have relied on other distinctions in order to defend their claims is irrelevant and speculative.” *Id.* at 41a (quoting *Schwarz Pharma, Inc. v. Paddock Labs., Inc.*, 504 F.3d 1371, 1377 (Fed. Cir. 2007)).

Judge Dyk finally observed that “[t]he problem with the majority’s analysis is that it ignores how the patentee deliberately elected to narrow the claims” during prosecution, specifically that “the patentee deliberately chose to redefine” the protein element of the claim specifically to distinguish the prior art, as the prior art protein (Livshits) was made by a nucleotide sequence that did not meet the newly added “hybridization” requirement. App., *infra*, 40a-41a. In sum, Judge Dyk found that the tangential exception could not apply, because “the rationale for the narrowing amendment (avoiding a prior art protein based on its encoding nucleotide sequence that does not meet the newly claimed hybridization requirement) directly relates to the accused equivalent (a protein made by an encoding nucleotide sequence, that does not meet the newly claimed hybridization requirement).” *Id.* at 42a.

Three days after its decision here, in *Hospira*, the Federal Circuit again applied the tangential exception despite the lack of any contemporaneous explanation from the patentee for its narrowing amendment. 933 F.3d at 1331-1332.

Petitioners and the *Hospira* defendants sought rehearing, each cross-referencing the other's petition, explaining that the Federal Circuit's decisions represented a dramatic shift in the Federal Circuit's approach to prosecution history estoppel and undermined the public notice function—particularly as it pertains to the tangential exception that this Court announced in *Festo*. The Federal Circuit declined to rehear either appeal. App., *infra*, 110a-111a.

#### REASONS FOR GRANTING THE PETITION

The issue here goes to the very heart of the patent system: the public's right (and indeed necessity) to rely on a patent's prosecution history to determine the metes and bounds of a claim. The Federal Circuit's decisions here and in *Hospira* significantly frustrate the public notice function of the prosecution history. They allow a patentee to recapture claim scope it voluntarily surrendered during prosecution in order to secure allowance of its patent, despite the patentee's having provided no notice to the public that it intended to surrender any less than the entire territory between the original and amended claims. These decisions force the public to face "a zone of uncertainty" about the scope of countless patents, disrupting the longstanding, delicate counterbalance between the doctrine of equivalents and prosecution history estoppel that this Court has established. And, critically, the decisions mean that accused infringers and the public-at-large will not know the scope of

such recapture until the end of an infringement suit, where after years of uncertainty, millions of dollars in damages and a potential injunction may be at stake.

Just as importantly, if these precedential decisions were to stand, the uncertainty they create will stifle the progress of science and the useful arts. Potential innovators, who would otherwise be able to design around a patent, may instead decline to do so, unwilling to run the risk of being found to infringe under a doctrine of equivalents theory that recaptures what a patentee appears on the face of the patent and the prosecution history to have surrendered.

This concern is particularly applicable in the pharmaceutical industry. Absent this Court's intervention, a pharmaceutical company may be less incentivized, for example, to develop a new product that increases the efficacy or safety of a patented product because, under these decisions, a patentee may, years after the fact, be permitted to recapture subject matter that it had surrendered during prosecution to secure issuance of a patent. To avoid the potential waste of billions of dollars, pharmaceutical companies will forgo development, and, as a consequence, consumers may never receive the benefit of some innovative new product or technology.

This Court should grant certiorari and return the Federal Circuit to this Court's precedents, restoring the public notice function of the prosecution history.

**I. THE FEDERAL CIRCUIT’S DECISION UNDERMINES THE PUBLIC NOTICE FUNCTION OF A PATENT’S PROSECUTION HISTORY**

**A. Prosecution History Estoppel Is A Key Component Of Patents’ Public Notice Function**

The very foundation of patent law is that the public must have notice of the metes and bounds of a patent. As this Court has explained, to promote the progress of science and the useful arts, the Constitution mandates that a skilled artisan and the public must be able to reasonably ascertain what is covered by a patent (and what is not) by reading the claims in light of the patent and the prosecution history. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730-731 (2002). A patent protects only that which is claimed and not what the patentee has surrendered and dedicated to the public. *Festo*, 535 U.S. at 740.

The patent system strikes a balance. It “seeks to guard against [both] unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights.” *General Elec. Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 369 (1938). The principle of patent law that the metes and bounds of a patent are coextensive with public notice serves two important functions necessary to maintain that balance. It affords patentees certainty as to the scope of their rights, while also encouraging innovators to develop alternative ways to achieve the goal of what the patent claims. *Festo*, 535 U.S. at 731. Indeed, the Court has stressed that the public “should be encouraged to pursue innovations, creations, and new ideas beyond the inventor’s exclusive

rights.” *Ibid.* (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U. S. 141, 150-151 (1989)).

Nearly two centuries ago, this Court explained the paramount importance of public notice: to prevent a patentee from “practising upon the credulity or the fears of other persons, by pretending that his invention is more than what it really is.” *Evans v. Eaton*, 20 U.S. 356, 434 (1822). Without “clear notice,” *Nautilus*, 572 U.S. at 909, innovators will not be willing to invest the time, money, and resources needed to innovate around a patent, especially in highly competitive, cutting-edge technical fields.

This Court has long safeguarded the public notice function of the patent’s prosecution history. Indeed, while the Court has allowed patentees to rely on the doctrine of equivalents to expand a patent’s protection beyond the literal scope of claims narrowed during prosecution, the Court has done so only in limited circumstances and in recognition of “language’s inability to capture the essence of innovation” perfectly. *Festo*, 535 U.S. at 734. But, the Court has always recognized that because the doctrine of equivalents “conflicts with the definitional and public-notice functions of the statutory claiming requirement,” *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29 (1997), it must be applied with restraint, so as not to stifle innovation.

The potential for uncertainty to chill innovation is precisely why this Court has, for over a century, repeatedly stressed that prosecution history estoppel imposes “limits on the doctrine of equivalents.” *Warner-Jenkinson*, 520 U.S. at 34. Competitors must be able to “rely on the prosecution history, the public record of the patent proceedings” for purposes of “estoppel to ensure

that their own devices will not be found to infringe by equivalence.” *Festo*, 535 U.S. at 727. In other words, “[t]he limits of a patent must be known,” not just “for the protection of the patentee, [but for] the encouragement of the inventive genius of others.” *General Elec. Co.*, 304 U.S. at 369.

In carefully calibrating this balance, the Court has placed the burden of ensuring proper notice of the claims’ scope squarely on the patentee—including the burden to show an exception to prosecution history estoppel. As this Court explained in *Warner-Jenkinson*, because patent claims “serve both a definitional and a notice function \* \* \* the better rule is to place the burden on the patent holder to establish the reason for an amendment required during patent prosecution.” 520 U.S. at 33. In *Festo*, this Court was even more explicit: “the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question.” 535 U.S. at 740. Indeed, “[w]hen the patentee is unable to explain the reason for amendment, estoppel not only applies but also ‘bar[s] the application of the doctrine of equivalents as to that element.’” *Id.* at 740 (quoting *Warner-Jenkinson*, 520 U.S. at 33).

The public notice function requires faithful adherence to this burden of proof. The public must be able to rely on the prosecution history. Patentees cannot be permitted to use after-the-fact arguments, developed with an eye on the accused product, to recapture in litigation subject matter that they wish they had not disclaimed during prosecution. The Federal Circuit’s decisions here and in *Hospira* dramatically undermine that public notice function by allowing patentees to rely on just such *post-hoc* reasoning.



This Court’s review and clarification is urgently needed. The Court should confirm, consistent with the underlying purpose of public notice and the Patent Act’s emphasis on disclosure, that the patentee is bound by its actions in prosecution and is therefore required to point to *an explanation in the prosecution history* as to why prosecution history estoppel should not apply. If, by contrast, a *post-hoc* rationale, developed so as to be “tangential” to an accused product’s purported “equivalence,” is permitted, then competitors cannot know if their innovation around the existing patent will nonetheless be deemed to infringe.

**B. The Public Notice Function Of The Prosecution History Is Undermined By The Federal Circuit’s Use Of A *Post-Hoc* Rationale In The Face Of A Patentee’s Silence**

If a patentee intends to invoke the doctrine of equivalents during litigation to recapture subject matter disclaimed during prosecution, the patentee must point to a contemporaneous explanation in the prosecution history that provides notice to the public that the patentee intended to surrender less than the full scope of the disclaimer. Only such a rule strikes the appropriate balance between the patentee’s interests and public notice, is consistent with the purpose of the Patent Act, and is the logical implication of this Court’s precedent. Indeed, this Court has long evaluated prosecution history estoppel by looking at the patentee’s *actions and statements in the prosecution*, not rationales that the patentee offers years after the fact.

Well over a century ago, the Court noted that “[i]f an applicant, in order to get his patent, accepts one with

a narrower claim than that contained in his original application, he is bound by it. If dissatisfied with the decision rejecting his application, he should pursue his remedy by appeal”—not by resorting to the doctrine of equivalents to “enlarge [the] patent by argument, so as to cover elements not falling within its terms.” *Shepard v. Carrigan*, 116 U.S. 593, 598 (1886). To that end, the Court has explained that “*limitations imposed by the inventor*, especially such as were introduced into an application after it had been [] rejected, must be strictly construed against the inventor and looked upon as disclaimers.” *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443-444 (1926) (emphasis added). In *Exhibit Supply Co. v. Ace Patents Corp.*, for example, the Court expressly looked to the patentee’s actions in narrowing the claims, recognizing that “[b]y the amendment, he recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference.” 315 U.S. 126, 136 (1942). And, this Court explained in *Festo* that the patentee’s “decision to forgo an appeal [from the Patent Office’s rejection] and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim.” 535 U.S. at 734.

There is no dispute that here, the patentee provided no reason in the prosecution history of the ’655 patent why it chose its amended claim language and provided no indication that it meant to surrender less than the full scope of territory between the original and amended claim language. Instead, the prosecution history shows only that (1) the Examiner rejected the original claim as anticipated by the prior art, App., *infra*, 19a, (2) the patentee redefined the claim through a narrowing amendment, App., *infra*, 19a, 40a (Dyk, J. dissenting), and (3)

the patentee said only that in view of its amendment, the prior art “no longer anticipates.” App., *infra*, 39a (Dyk, J. dissenting). Under controlling precedent, a patentee’s “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. Here, if the patentee intended to surrender less than the full scope between the original claim and the amended and redefined claim, the patentee was required to say so at the time. Absent that explicit notice, the public is entitled to reasonably understand that the patentee had dedicated the full scope between the original and amended claim to the public. *Exhibit Supply Co.*, 315 U.S. at 137. If the patentee wants to limit that disclaimer, the law requires far more than silence. *Festo*, 535 U.S. at 740-741. Indeed, this Court’s precedent that “limitations imposed by the inventor \* \* \* must be strictly construed against the inventor and looked upon as disclaimers,” *I.T.S. Rubber Co.*, 272 U.S. at 443-444, is particularly important here where the patentee has offered no contemporaneous explanation for its narrowing amendment or statement that it intended to surrender less than the territory between the original and amended claims. Otherwise, a patentee (like here) remains free to invent, *post hoc*, any one of many plausible rationales for its apparent disclaimer. The wide variety of possible explanations inherent in every narrowing amendment creates precisely the “zone of uncertainty” around the claim that this Court said is impermissible.

Indeed, this case exemplifies the “zone of uncertainty” that exists if *post-hoc* rationales are allowed, and why this Court should clarify that a patentee’s silence concerning a narrowing amendment to overcome a rejec-

tion related to patentability bars any rebuttal to the presumption of prosecution history estoppel. Otherwise, as here, public notice falls by the wayside as the patentee's silence in the prosecution history led each of petitioners, respondents, the ITC, the Federal Circuit majority, and Judge Dyk in dissent to hypothesize a different "objectively apparent reason" for the amendment. See pp. 11-12, *supra*. That is a game of chance, not public notice. Indeed, respondents themselves could not identify a single rationale for the amendment, saying it could "possibly" be two different reasons. Ajinomoto Responsive/Reply C.A. Br. 41-42. If the patentee could not determine the reason for its own amendment, how could the public have been expected to do so?

This case and *Hospira* reflect a dangerous departure by the Federal Circuit from this Court's (and the Federal Circuit's own) prior precedent. In *Hospira*, the Federal Circuit ignored the particular amended claim language that the patentee chose in a narrowing amendment to distinguish the cited art and applied the tangential exception. 933 F.3d at 1331-1332. The *Hospira* court focused on the Examiner's rejection (*i.e.*, *why* the patentee needed to amend at all), rather than *how* the patentee actually narrowed the claim and the arguments it made when doing so. *Id.* at 1332 (examining the basis of the Examiner's rejection and stating that while the patentee's amendment may have been "inartful," it was "prudential in nature" and did not *need* to surrender certain scope in order to avoid the prior art). Applying this *post-hoc*, "prosecution remorse" approach, both here and in *Hospira*, the Federal Circuit has made an about-face in its prosecution history estoppel jurisprudence—effectively abrogating the public notice function of the prosecution history and allowing patentees years after the

fact to posit new rationales for the amendment, in an attempt to rely on the doctrine of equivalents to recapture subject matter the public had every reason to believe the patentee had voluntarily surrendered during prosecution to obtain the patent.

## II. THE FEDERAL CIRCUIT'S NEW RULE POSES A GRAVE THREAT TO INNOVATION

By abandoning the previous rule that a patentee's silence at the time of amendment precludes invoking the doctrine of equivalents, see *Honeywell Int'l, Inc. v. Hamilton Sundstrand Corp.*, 523 F.3d 1304, 1316, cert. denied, 555 U.S. 939 (2008), the Federal Circuit has created a significant disincentive to innovation. Now, a court can simply ignore a patentee's silence during prosecution and instead fill in the silence with its view "why" the patentee needed to amend (*e.g.*, to overcome the rejection) and what the patentee may have intended by the amendment. Such an approach creates an untenable uncertainty for members of the public when considering whether a future innovation would infringe a patent claim. As a consequence, the Federal Circuit's new rule will discourage innovation.

In the aftermath of these precedential Federal Circuit decisions, when the prosecution history is silent as to a patentee's reason for making a narrowing amendment to distinguish the prior art, the public—including potential innovators—will have to assume that the patentee will try to formulate, in hindsight, a rationale for the amendment that is "tangential" to the way the new innovation differs from the narrower claim. Given the uncertainty this creates, "the language of patent claims can never be relied on." *Duncan Parking Techs., Inc. v.*

*IPS Grp., Inc.*, 914 F.3d 1347, 1362 (Fed. Cir. 2019) (quoting *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991)). The consequence is that the doctrine of equivalents will loom over every good faith attempt to innovate around a patent.

To allow the Federal Circuit’s decision to stand will, therefore, dangerously undermine the public notice function of patents and their prosecution histories that forms the basis for the constitutional *quid pro quo* of a patentee’s right to exclude. Innovators would be forced to live under the unfettered and unclear shadow of the doctrine of equivalents, left with only guesses and assumptions about what a patentee *might have intended* when narrowing the scope of the claims. Potential innovators would be left to innovate at their peril, running the risk of a court divining years after the fact that a patentee did not really have to or intend to surrender what it appeared at the time to have disclaimed, resulting in catastrophic damages or injunctive relief. The result of this “zone of uncertainty” is clear: innovation would be stifled. Understandably, to play it safe, many would-be innovators would stay on the sidelines, avoiding the risk, and depriving the public of countless innovations.

The perverse, but natural, consequence of the court of appeals’ new rule is that patentees hoping to preserve their flexibility to rely on the doctrine of equivalents in subsequent litigation are incentivized *not* to disclose any rationale for narrowing amendments made during prosecution. By remaining silent during prosecution, patentees would remain free to devise later theories to recapture the very subject matter disclaimed to obtain their patents. This perverse incentive undermines the core

purpose of the patent system—the “*quid pro quo*” of disclosure in exchange for the right to exclude. *Kewanee Oil Co. v. Bicron Corp.*, 416 U.S. 470, 484 (1974).

### III. RESTORING THE PUBLIC NOTICE FUNCTION OF PROSECUTION HISTORY REQUIRES THIS COURT’S IMMEDIATE INTERVENTION, AND THIS CASE IS AN IDEAL VEHICLE

This Court last addressed the interplay between the doctrine of equivalents and prosecution history estoppel nearly two decades ago, in *Festo*. Although the Federal Circuit initially adhered to those principles, in this case (and in *Hospira*), it has now sharply deviated from them—undercutting the public notice function of the prosecution history and destroying the balance between the doctrine of equivalents and prosecution history estoppel, with devastating future consequences. This case is an ideal vehicle for the Court to restore that balance and prevent a further degradation of prosecution history estoppel and its public notice function by the Federal Circuit.

#### A. This Case (And *Hospira*) Sharply Break From Precedent

Through *Festo*, *Warner-Jenkinson*, and more than a century’s worth of precedent, this Court has stressed the public notice function of prosecution history estoppel and its role in limiting the doctrine of equivalents. The Court has, moreover, emphasized that “the doctrine of equivalents and the rule of prosecution history estoppel are settled law. The responsibility for changing them rests with Congress,” not the Federal Circuit. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739 (2002). But that is precisely what the Federal Circuit has done here.

The Federal Circuit’s *post-hoc* divining of a rationale for a narrowing amendment in the absence of *any* contemporaneous explanation from the patentee directly conflicts with *Festo*’s holdings that “the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question,” and that “[w]hen the patentee is unable to explain the reason for amendment, estoppel \* \* \* not only applies but also ‘bar[s] the application of the doctrine of equivalents as to that element.’” *Festo*, 535 U.S. at 740. As Judge Dyk explained in dissent, the Federal Circuit previously (and correctly) held that *post-hoc* arguments for overcoming the rejection not raised in the prosecution history itself are “irrelevant and speculative.” App., *infra*, 40a-41a (citing *Schwarz Pharma*, 405 F.3d at 1377).

The Federal Circuit also ignored its own previous recognition that “[s]ilence does not overcome the presumption” of prosecution history estoppel. *Honeywell Int’l, Inc. v. Hamilton Sundstrand Corp.*, 523 F.3d 1304, 1316, cert. denied, 555 U.S. 939 (2008); see also *Felix v. Am. Honda Motor Co.*, 562 F.3d 1167, 1184 (Fed. Cir. 2009) (tangential exception does not apply when there is “no explanation in the prosecution history for the addition of the [narrowing] limitation”).

As explained above, prior to this case and *Hospira*, the Federal Circuit applied the tangential exception looking to a patentee’s explicit and contemporaneous explanations in the prosecution history as to what the patentee was surrendering and what it was not. See, *e.g.*, *Insituform Techs., Inc. v. CAT Contracting, Inc.*, 385 F.3d 1360, 1370 (2004) (relying on patentee’s explicit argument and distinguishing the case where “no explanation is given for a claim amendment”); *Regents of Univ.*



of *Cal. v. Dakocytomation Cal., Inc.*, 517 F.3d 1364, 1378 (2008) (citing specific arguments in the prosecution history); *Intervet Inc. v. Merial Ltd.*, 617 F.3d 1282, 1291 (2010) (quoting from the prosecution history and citing patentee’s specific arguments). Yet, now apparently favoring the patentee to the detriment of the public, the Federal Circuit has dramatically changed course, finding it appropriate to rely on *its own post-hoc*, hypothetical “rationale” for the narrowing amendment—why the amendment was needed and what had to be surrendered to distinguish the art—and ignoring the patentee’s silence at the relevant time to invoke the tangential exception to prosecution history estoppel.

Because the Federal Circuit has exclusive jurisdiction of patent appeals, 28 U.S.C. 1295, there cannot be a circuit split with regard to the issues presented here, and as the denials of the en banc petitions here and in *Hospira* show, the issue is unlikely to percolate any further.

### **B. The Patentee’s Silence In The Prosecution History Makes This Case The Ideal Vehicle For Certiorari**

This case provides an ideal vehicle for refocusing the Federal Circuit on the public notice function of patent prosecution and clarifying the proper analysis of the tangential exception to prosecution history estoppel.

In this case, the patentee made *no argument whatsoever* during prosecution as to *how* its narrowing amendment overcame the prior art rejection, *why* it chose the amended claim language that it did, or *whether* it intended to surrender any less than the full territory between its original and amended claims. C.A. App. 5617; see also App., *infra*, 39a (Dyk, J. dissenting). All

the patentee did was to provide a factual summary of the Examiner's rejection and state that its amendment overcame the prior art. *Ibid.*

Accordingly, this petition does not ask whether the Federal Circuit correctly analyzed the prosecution history, but whether it should have conducted a *post-hoc* analysis at all. The Court does not need to weigh the evidence or the parties' arguments. It simply needs to reemphasize the overriding public notice function of the prosecution history and the logical implication of precedent: a patentee's silence in the prosecution, in the context of the rationale for a narrowing amendment, bars its reliance on the doctrine of equivalents to recapture during litigation subject matter surrendered to get the patent allowed. *Festo*, 535 U.S. at 740-741.

This case presents an issue of compelling importance: is the public entitled to rely on a patentee's statements—or lack thereof—in the context of a narrowing amendment to overcome the prior art, or may a patentee recapture disavowed claim scope years after the fact by offering a hindsight, *post-hoc*, unsupported rationale for narrowing its claims? The Federal Circuit has broken with precedent and chosen the latter, frustrating the important public notice function of the prosecution history and threatening the very innovation that results from the *quid pro quo* of the patent system.

**CONCLUSION**

For the foregoing reasons, petitioners respectfully ask the Court to grant the petition for a writ of certiorari and reverse the judgment of the court of appeals.

Respectfully submitted,

DOUGLAS HALLWARD-DRIEMEIER

STEVEN PEPE

MATTHEW J. RIZZOLO

RACHAEL BACHA

HYUN-JOONG KIM

PHILLIP Z. YAO

ROPES & GRAY LLP

JAMES F. HALEY, JR.

BRIAN M. GUMMOW

HALEY GUILIANO LLP

*Counsel for Petitioners*

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