


In the
Supreme Court of the United States



TECHNOLOGY PROPERTIES LIMITED LLC ET AL.,
Petitioners,

—v—

HUAWEI TECHNOLOGIES CO., LTD., ET AL.,
Respondents.

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

PETITION FOR A WRIT OF CERTIORARI

KENNETH W. STARR
THE LANIER LAW FIRM
10940 W. SAM HOUSTON PKWY. N.,
SUITE 100
HOUSTON, TX 77064
(713) 659-5200
KEN.STARR@LANIERLAWFIRM.COM

DENISE M. DE MORY
COUNSEL OF RECORD
AARON R. HAND
LAUREN N. ROBINSON
VERNON C. GRIGG III
WENDY J. THURM
BUNSOW DE MORY LLP
701 EL CAMINO REAL
REDWOOD CITY, CA 94063
(650) 351-7248
DDEMORY@BDIPLAW.COM

SEPTEMBER 6, 2019

COUNSEL FOR PETITIONERS

SUPREME COURT PRESS

◆ (888) 958-5705 ◆

BOSTON, MASSACHUSETTS

QUESTION PRESENTED

Whether the United States Court of Appeals for the Federal Circuit's development and application of the doctrine of "prosecution history disclaimer" is consistent with fundamental principles of separation of powers, the Patent Act, and long-established Supreme Court precedent.

PARTIES TO THE PROCEEDINGS

PETITIONERS

- Technology Properties Limited LLC
- Phoenix Digital Solutions LLC
- Patriot Scientific Corporation

RESPONDENTS

- Huawei Technologies Co., Ltd.
- Futurewei Technologies, Inc.
- Huawei Device Co., Ltd.
- Huawei Device USA Inc.
- Huawei Technologies USA Inc.
- ZTE Corporation
- ZTE USA, Inc.
- Samsung Electronics Co., Ltd.
- Samsung Electronics America, Inc.
- LG Electronics, Inc.
- LG Electronics U.S.A., Inc.
- Nintendo Co., Ltd.
- Nintendo of America, Inc.

RULE 29.6
CORPORATE DISCLOSURE STATEMENT

Technology Properties Limited LLC has no parent corporations and no publicly held companies own 10% or more of stock in the party.

Patriot Scientific Corporation is a publicly held company. No parent corporations or publicly held companies own 10% or more of stock in the party.

More than 10% of the membership interest in Phoenix Digital Solutions LLC is held by Patriot Scientific Corporation, a publicly traded company.

DIRECTLY RELATED PROCEEDINGS

Petitioners filed civil actions asserting patent infringement of U.S. Patent No. 5,809,336 in the U.S. District Court for the Northern District of California:

- Technology Properties Limited LLC, et al. v. Huawei Technologies Co., Ltd., et al. (No. 3:12-cv-03865);
- Technology Properties Limited LLC, et al. v. ZTE Corporation, et al. (No. 3:12-cv-03876);
- Technology Properties Limited LLC, et al. v. Samsung Electronics, Co., Ltd., et al. (No. 3:12-cv-03877);
- Technology Properties Limited LLC, et al. v. LG Electronics, Inc., et al. (No. 3:12-cv-03880);
and
- Technology Properties Limited LLC, et al. v. Nintendo Co., Ltd., et al. (No. 3:12-cv-03881).

Petitioners stipulated to entry of final judgment of non-infringement based on the claim construction order dated November 9, 2015; the court entered final judgment in each proceeding on November 13, 2015.

Notices of Appeal were filed in each case on December 13, 2015. The appeals were docketed by the Federal Circuit:

- Technology Properties Limited LLC, et al. v. Huawei Technologies Co., Ltd., et al. (No. 16-1306);
- Technology Properties Limited LLC, et al. v. ZTE Corporation, et al. (No. 16-1307);

- Technology Properties Limited LLC, et al. v. Samsung Electronics, Co., Ltd., et al. (No. 16-1309);
- Technology Properties Limited LLC, et al. v. LG Electronics, Inc., et al. (No. 16-1310); and
- Technology Properties Limited LLC, et al. v. Nintendo Co., Ltd., et al. (No. 16-1311).

These appeals were consolidated, and the Huawei case (No. 16-1306) designated as the lead appeal. In a decision dated March 13, 2017, the Federal Circuit held that the district court erred in a portion of its construction of the phrase “entire oscillator disposed upon said integrated circuit substrate,” drafted its own replacement language, vacated the judgment, and remanded for further proceedings.

On remand, the district court granted summary judgment of non-infringement, entering final judgment in each action on December 13, 2017.

Notices of Appeal were filed in each case on January 5, 2018. The appeals were docketed by the Federal Circuit:

- Technology Properties Limited v. Huawei Technologies Co., Ltd. (No. 18-1439);
- Technology Properties Limited v. ZTE Corporation (No. 18-1440);
- Technology Properties Limited v. Samsung Electronics Co., Ltd. (No. 18-1441);
- Technology Properties Limited v. LG Electronics, Inc. (No. 18-1444); and

- Technology Properties Limited v. Nintendo Co., Ltd. (No. 18-1445).

These appeal proceedings were consolidated, and the Huawei case (No. 18-1439) designated as the lead appeal. On February 6, 2019, the Federal Circuit entered judgment affirming the district court's decision without opinion under Federal Circuit Rule 36. Petitioners' request for rehearing en banc was denied on April 10, 2019.

On July 3, 2019, the Chief Justice granted petitioners' motion for an extension of time within which to file a petition for writ of certiorari to and including September 7, 2019.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
PARTIES TO THE PROCEEDINGS	ii
RULE 29.6 CORPORATE DISCLOSURE STATEMENT	iii
DIRECTLY RELATED PROCEEDINGS	iv
TABLE OF AUTHORITIES	x
PETITION FOR WRIT OF CERTIORARI	1
OPINIONS BELOW	1
JURISDICTIONAL STATEMENT	2
STATUTORY AND CONSTITUTIONAL PROVISIONS INVOLVED	2
STATEMENT OF THE CASE.....	4
REASONS FOR GRANTING THE PETITION.....	21
I. THE COURT OF APPEALS DECISION IS WRONG..	21
II. THE PROSECUTION HISTORY DISCLAIMER DOCTRINE CREATES INSTABILITY IN THE U.S. PATENT SYSTEM	32
III. THIS CASE PROVIDES AN APPROPRIATE VEHICLE	38
CONCLUSION.....	40

TABLE OF CONTENTS – Continued

Page

APPENDIX TABLE OF CONTENTS

OPINIONS AND ORDERS

Judgment of the Federal Circuit (February 6, 2019)	1a
Mandate of the Federal Circuit (April 17, 2019)	3a
Order of the Federal Circuit Denying Appellants Motion to Take Judicial Notice (June 1, 2018)	5a
Order Granting Motions for Summary Judgment (December 13, 2017)	8a
Judgment of the District Court (December 13, 2017)	17a
Opinion of the Federal Circuit (March 3, 2017)	20a
Final Judgment of the District Court (November 13, 2015)	38a
Order Adopting Magistrate Judge’s Report and Recommendation (November 9, 2015)	42a
Magistrate Report and Recommendation on Claim Construction (September 22, 2015)	45a
Order of the Federal Circuit Denying Petition for Rehearing En Banc (April 10, 2019)	62a

TABLE OF CONTENTS – Continued

Page

CONSTITUTIONAL AND STATUTORY PROVISIONS

Constitutional and Statutory Provisions 64a
Patent Act of 1836, 24 Cong. Ch. 357, 5 Stat. 117
(July 4, 1836) 76a

RECORD EXCERPTS

Brief of Plaintiff Appellant Tech Properties Ltd—
Relevant Excerpts (March 10, 2016) 95a
'336 Patent File History, Examiner Interview
Summary Record (May 13, 1998) 107a
'336 Patent File History, Supplemental Amendment
(April 24, 1998) 109a

TABLE OF AUTHORITIES

	Page
CASES	
<i>Aro Mfg. Co. v. Convertible Top Replacement Co.</i> , 365 U.S. 336 (1961)	5, 25
<i>AWH Corp. v. Phillips</i> , 546 U.S. 1170 (2006)	25
<i>Biogen Idec, Inc. v. GlaxoSmithKline LLC</i> , 713 F.3d 1090 (Fed. Cir. 2013)	18, 35, 36
<i>Campbell Metal Window Corp. v. S.H. Pomeroy & Co.</i> , 300 F. 872 (S.D.N.Y. 1924).....	25
<i>Computer Docking Station Corp. v. Dell, Inc.</i> , 519 F.3d 1366 (Fed. Cir. 2008)	34, 35
<i>Crawford v. Heysinger</i> , 23 U.S. 589 (1887).....	28
<i>Cuozzo Speed Technologies, LLC v. Lee</i> , 136 S.Ct. 2131 (2016)	22
<i>Data Engine Techs. LLC. v. Google LLC</i> , 906 F.3d 999 (Fed. Cir. 2018)	14
<i>Elbex Video, Ltd. v. Sensormatic Elecs. Corp.</i> , 508 F.3d 1366 (Fed. Cir. 2007)	18
<i>Exhibit Supply Co. v. Ace Patents Corp.</i> , 315 U.S. 126 (1942)	30
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.</i> , 535 U.S. 722 (2002)	31
<i>Goodyear Dental Vulcanite Co. v. Davis</i> , 102 U.S. 222 (1880)	5, 25, 26, 28

TABLE OF AUTHORITIES—Continued

	Page
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966)	28
<i>Hubbell v. United States</i> , 179 U.S. 77 (1900)	29
<i>I.T.S. Rubber Co. v. Essex Rubber Co.</i> , 272 U.S. 429 (1926)	29
<i>Innova/Pure Water, Inc.</i> <i>v. Safari Water Filtration Sys., Inc.</i> , 381 F.3d 1111 (Fed. Cir. 2004)	25
<i>Keystone Bridge Co. v. Phoenix Iron Co.</i> , 95 U.S. 274 (1877)	23
<i>Krippelz v. Ford Motor Co.</i> , 667 F.3d 1261 (Fed. Cir. 2012)	36, 37
<i>Markman v. Westview Instruments, Inc.</i> , 52 F.3d 967 (Fed. Cir. 1995)	5, 25, 26, 27
<i>Massachusetts Inst. of Tech. v. Shire Pharm., Inc.</i> , 839 F.3d 1111 (Fed. Cir. 2016)	19
<i>McCarty v. Lehigh Val. R. Co.</i> , 160 U.S. 110 (1895)	25
<i>Merrill v. Yeomans</i> , 94 U.S. 568 (1876)	24
<i>Oil States Energy Serv., LLC</i> <i>v. Greene’s Energy Group, LLC</i> , 135 S.Ct. 1365 (2018)	22
<i>Omega Eng’g, Inc. v. Raytek Corp.</i> , 334 F.3d 1314 (Fed. Cir. 2003)	passim

TABLE OF AUTHORITIES—Continued

	Page
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	25
<i>Phoenix Caster Co. v. Spiegel</i> , 133 U.S. 360 (1890)	29
<i>Pregis Corp. v. Kappos</i> , 700 F.3d 1348 (Fed. Cir. 2012)	10
<i>Roemer v. Peddie</i> , 132 U.S. 313 (1889)	29
<i>Schriber–Schroth Co. v. Cleveland Trust Co.</i> , 311 U.S. 211 (1940)	28, 29, 30
<i>Shepard v. Carrigan</i> , 116 U.S. 593 (1886)	29
<i>Shire Dev., LLC v. Watson Pharm., Inc.</i> , 787 F.3d 1359 (Fed. Cir. 2015)	36
<i>Sutter v. Robinson</i> , 119 U.S. 530 (1886)	29
<i>Syntex (U.S.A.) Inc.</i> <i>v. U.S. Patent & Trademark Office</i> , 882 F.2d 1570 (Fed. Cir. 1989)	9
<i>Tech. Properties Ltd. v. Huawei Techs. Co.</i> , 849 F.3d 1349 (Fed. Cir. 2017)	19
<i>Uniloc USA, Inc. v. ADP, LLC</i> , 772 F. App'x 890 (Fed. Cir. 2019)	14
<i>Uship Intellectual Props., LLC v. United States</i> , 714 F.3d 1311 (Fed. Cir. 2013)	18
<i>Vehicle IP, LLC v. Gen. Motors Corp.</i> , 306 F. App'x 574 (Fed. Cir. 2009)	35

TABLE OF AUTHORITIES—Continued

	Page
<i>Weber Electric Co.</i>	
<i>v. E.H. Freeman Electric Co.</i> ,	
256 U.S. 668 (1921)	29
<i>White v. Dunbar</i> ,	
119 U.S. 47 (1886)	25

CONSTITUTIONAL PROVISIONS

U.S. Const. art. I, § 8, cl. 8.....	2, 6, 22
U.S. Const. art. I, § 8, cl. 18.....	2, 6, 22

STATUTES

28 U.S.C. § 1331.....	4, 10, 16
28 U.S.C. § 1338(a)	4, 10, 16
35 U.S.C. § 1(a)	3
35 U.S.C. § 2(a)(1).....	3, 8
35 U.S.C. § 101.....	4, 8, 23
35 U.S.C. § 102.....	8, 23
35 U.S.C. § 103.....	8, 23
35 U.S.C. § 112.....	4, 8, 23
35 U.S.C. § 131.....	4, 8, 23
35 U.S.C. § 132.....	4, 8, 23
35 U.S.C. § 134.....	4, 8, 9
35 U.S.C. § 141.....	4, 8, 23
35 U.S.C. § 145.....	4, 8, 24

TABLE OF AUTHORITIES—Continued

	Page
35 U.S.C. § 153.....	4
35 U.S.C. § 271.....	10
35 U.S.C. § 273.....	10
35 U.S.C. § 282.....	4, 10
35 U.S.C. § 301.....	4, 8, 24
35 U.S.C. § 302.....	4, 8, 24
35 U.S.C. § 303.....	4, 8
35 U.S.C. § 304.....	4, 8, 23
35 U.S.C. § 305.....	4, 8, 23
35 U.S.C. § 306.....	4, 9
 JUDICIAL RULES	
Fed. Cir. Rule 36.....	4
Sup. Ct. Rule 29.6.....	iii



PETITION FOR WRIT OF CERTIORARI

Technology Properties Limited LLC, Phoenix Digital Solutions, and Patriot Scientific Corporation respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.



OPINIONS BELOW

The Federal Circuit's affirmance pursuant to Fed. Cir. R. 36 is reported at 750 F. App'x 1003. App.1a-2a. That court's orders denying petitioners' request for judicial notice of additional portions of the asserted patent's file history (App.5a-7a) and denying petitioners' request for rehearing en banc (App.62a) are unreported. The district court's opinion and order granting summary judgment of non-infringement is not reported but is available at 2017 WL 9565341. App. 8a-16a.

The Federal Circuit's prior opinion concerning claim construction is reported at 849 F.3d 1349. App.38a. The district court's order on claim construction (App.42a), which adopted the magistrate judge's report and recommendation (App.45a), is not reported but is available at 2015 WL 13724461 (Order) and 2015 WL 12990208 (Report and Recommendation).



JURISDICTIONAL STATEMENT

The Federal Circuit entered judgment on February 6, 2019 and denied petitioners' timely petition for rehearing en banc on April 10, 2019. On July 3, 2019, the Chief Justice granted petitioners' motion and extended the time within which to file a petition for writ of certiorari to and including September 7, 2019, and the petition is being filed prior to that date. The jurisdiction of this Court rests on 28 U.S.C. § 1254(1).



STATUTORY AND CONSTITUTIONAL PROVISIONS INVOLVED

U.S. Const. art. I, § 8, cls. 8 & 18 provide:

The Congress shall have power . . .

[* * *]

To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries;

[* * *]

To make all laws which shall be necessary and proper for carrying into execution the foregoing powers, and all other powers vested by this Constitution in the government of the United States, or in any department or officer thereof.

35 U.S.C. § 1(a) provides:

§ 1. Establishment

(a) Establishment. The United States Patent and Trademark Office is established as an agency of the United States, within the Department of Commerce. In carrying out its functions, the United States Patent and Trademark Office shall be subject to the policy direction of the Secretary of Commerce, but otherwise shall retain responsibility for decisions regarding the management and administration of its operations and shall exercise independent control of its budget allocations and expenditures, personnel decisions and processes, procurements, and other administrative and management functions in accordance with this title and applicable provisions of law. Those operations designed to grant and issue patents and those operations which are designed to facilitate the registration of trademarks shall be treated as separate operating units within the Office.

35 U.S.C. § 2(a)(1) provides:

§ 2. Powers and duties

- (a) In General. The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce-
- (1) shall be responsible for the granting and issuing of patents and the registration of trademarks

[* * *]

Pertinent text from additional statutes and court rules is set out in the Appendix:

28 U.S.C. §§ 1331, 1338

35 U.S.C. §§ 101, 112, 131, 132, 134, 141, 145, 153, 282, 301, 302, 303, 304, 305, 306

Federal Circuit Rule 36



STATEMENT OF THE CASE

Article I of the Constitution gives Congress the power to make laws necessary to promote the progress of science, by securing for inventors an exclusive right to their inventions for a limited time. Nearly 200 years ago, Congress established a comprehensive statutory scheme governing patent applications and issued patents. That scheme has evolved over time, but an essential feature has been constant from the Patent Act of 1836 to today: only the United States Patent & Trademark Office (“USPTO”) is authorized to review patent applications and issue patents. This legislative authorization includes the power to allow patent claims, reject patent claims, and to require an applicant to amend claims to add limitations that narrow the scope of the claims to gain allowance.

The Patent Act grants the federal judiciary limited powers to review USPTO decisions and to preside over patent infringement actions. But the judiciary is not empowered to rewrite patent claims to add limitations based on its *post hoc* examination of the patent prosecution file. Rewriting claims to add limitations amends the claims and changes claim

scope. No statute or constitutional provision permits the judiciary to substitute its own judgment on amendments for that of the USPTO.

Once issued, patent claims define the metes and bounds of the patentee's invention and provide public notice of the patentee's right to exclude others from practicing it. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961). The patent prosecution history cannot be used to "enlarge, diminish, or vary" the claim limitations. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (quoting *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880)), *aff'd*, 517 U.S. 370 (1996).

Yet the Federal Circuit has disregarded this clear rule, creating a doctrine out of whole cloth that allows it—and district courts—to do just that: diminish and vary claim scope. The doctrine allows courts to rewrite claims to include additional limitations during claim construction based on statements made by the patentee to the USPTO, even when those statements are not relied on by the USPTO in issuing the patent. The Federal Circuit dubbed the doctrine "prosecution history disclaimer," and has used it to go down a wild and slippery slope, substituting judicial views for those of the USPTO, and freely changing claim scope based on anything and everything in the file history.

In this case, the Federal Circuit applied prosecution history disclaimer to add two limitations to a patent claim even though the claim had been examined and confirmed by the USPTO seven different times in accordance with the rules and procedures in the Patent Act. The Federal Circuit requires disclaimer

to be “clear and unequivocal,” but in practice this standard is anything but “clear and unequivocal.” Different tribunals have interpreted the claim at issue no fewer than five different ways. Under our system of separation of powers, the Federal Circuit is not at liberty to second guess the USPTO and rewrite claims to add limitations. When it does so, the court undermines the public notice function of patent claims and treads on powers expressly delegated to the USPTO.

American innovation depends on a stable and rational patent system. *Post hoc* theorizing by the federal courts about what a patent applicant and a patent examiner meant to agree on (or should have agreed on) creates uncertainty and arbitrariness and deprives inventors of the full scope of their patent grant. This approach hinders our country’s technological competitiveness and shows disregard for separation of powers principles.

1. Article I of the United States Constitution gives Congress the power to make laws necessary to promote the progress of science, by securing for inventors an exclusive right to their inventions for a limited time. U.S. Const. art. I, § 8, cls. 8 & 18. In 1836, Congress established the United States Patent Office as part of the Department of State. 24 Cong. Ch. 357, § 1, 5 Stat. 117 (1836) (App.76a).

2. Congress vested in the Commissioner of Patents the power to grant United States Patents. 24 Cong. Ch. 357, §§ 1-5, 5 Stat. 117 (App.76a-79a). Pursuant to the 1836 Patent Act, any person who discovered or invented any new and useful art, machine, manufacture, or composition of matter, or any new and

useful improvement thereto, could apply in writing to the Commissioner of Patents for a patent. *Id.* § 6. The application was required to include a detailed description of the invention that would enable a person skilled in the art to make the invention and “particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.” *Id.* This provision marks the origin of patent claims, which define the metes and bounds of the exclusive rights granted to an inventor by the United States.

The 1836 Patent Act gave the Commissioner of Patents, and those in his charge, the power to examine patent applications, and to grant an application, reject it, or to propose amendments to the claims which, if accepted by the applicant, defined the scope of the patent grant. *Id.* § 7. The Commissioner’s decisions were reviewable only by a board of examiners. *Id.*

The Commissioner was also given the power to reissue patents that “shall be inoperative, or invalid, by reason of defective or insufficient description of specification, or by reason of the patentee claiming more than he had or shall have a right to claim as new. . . .” *Id.* § 13. Upon surrender and payment of a fee, the Commissioner could reissue a patent with a “corrected description and specification,” with the reissued patent having the same effect for all actions commenced after reissue as if the patent had been originally issued in its correct form. *Id.*

Congress has periodically amended the Patent Act to clarify and modify the rules governing the process for obtaining a patent. Today, under the Patent Act, the USPTO remains responsible “for the granting and

issuing of patents.” 35 U.S.C. § 2(a)(1). When an inventor applies for a patent, an examiner reviews the proposed claims and the prior art and determines whether the claims satisfy the statutory requirements for utility, novelty, and nonobviousness, 35 U.S.C. §§ 101, 102, and 103, and whether the claims sufficiently describe the invention. 35 U.S.C. § 112. During the patent examination process, the assigned examiner reviews the application and decides if it should be granted, or more often at the early stages of the process, rejected. If the patent application is rejected, the applicant can try to convince the examiner she is wrong, amend the claims, or if it is a final rejection, seek limited enumerated forms of judicial review. 35 U.S.C. §§ 131-32, 134, 141, 145.

In 1980, Congress enacted the *ex parte* reexamination statute. Any party can ask the USPTO to reexamine a patent, either through the submission of prior art or a formal reexamination request. 35 U.S.C. §§ 301-305. A request for reexamination is granted if the USPTO Director decides it presents a “substantial new question of patentability affecting any claim of the patent. . . .” 35 U.S.C. § 303. During reexamination, the USPTO follows the same procedures used during an initial examination—that is, if the patent examiner finds that a claim does not meet the statutory requirements, she can reject the claim, demand amendment(s) to the claim as an alternative to a rejection, or defer such a decision pending further dialogue with the patent owner. 35 U.S.C. § 305. Similarly, the patent owner may accept the examiner’s proposed amendment(s) and obtain issuance of the amended claim, reject the proposed amendment(s) and attempt to persuade the examiner that no amend-

ment is required, or reject the proposed amendment(s) and appeal to the Patent Trial and Appeal Board (“PTAB”). 35 U.S.C. §§ 134(b), 306.

Although a patentee may seek limited judicial review of the USPTO’s reexamination decisions, regardless of the result, a third-party requestor has no such rights. *See Syntex (U.S.A.) Inc. v. U.S. Patent & Trademark Office*, 882 F.2d 1570, 1573-75 (Fed. Cir. 1989) (“Congress may provide for judicial review of some issues at the behest of particular parties but not others. . . . Congress intended to limit appeals from final reexamination decisions to those initiated by patent owners seeking to reverse an unfavorable decision.”).

Patent claims are generally written in a single sentence that lists all the elements of the claimed invention. For example, a typical patent claim is written as: I claim, as my invention, a device including elements a, b, c, and d. The various requirements of the elements of the claim are referred to as “limitations.”

Claim limitations play a vital role in infringement analysis. In order to prove infringement, a patent owner must prove that an accused infringing product meets every limitation of a claim; hence, the more limitations there are in a claim, the more cumbersome it is to prove infringement. If a patent owner fails to prove that an accused infringing product meets a single limitation of a patent claim, the claim is not infringed. Thus, the decision to amend a claim to add limitations is an important one because additional limitations narrow the inventor’s right to exclude, and limit the range of products

that can be accused of infringement; each additional limitation provides another route for an accused infringer to dispute infringement.

3. In the Patent Act, Congress also delineated the elements of a claim for infringement of a patent and the defenses to an infringement claim, and vested the federal courts with exclusive jurisdiction over such claims and defenses. 35 U.S.C. §§ 271, 273, 282; 28 U.S.C. §§ 1331, 1338(a). Under § 282, a defendant in an infringement action may assert a defense of noninfringement and challenge the validity of the asserted patent(s) for failure to comply with the statutory requirements of utility, novelty, and nonobviousness (*see* 35 U.S.C. § 282(b)(2)); failure to comply with the statutory requirements of enablement (*see* 35 U.S.C. § 282(b)(3)(A)); and failure to comply with provisions governing reissued patents, to the extent those are relevant (*see* 35 U.S.C. § 282(b)(3)(B)). Nowhere in § 282, or elsewhere in the Patent Act, is an accused infringer granted the right to request that a court add limitations to claims that the examiner purportedly missed during prosecution. *See Pregis Corp. v. Kappos*, 700 F.3d 1348, 1360 (Fed. Cir. 2012) (“[T]he specific list of defenses available under § 282 reflects the deliberate judgment of Congress that not every error during prosecution should provide a defense to a claim of patent infringement.”).

4. The patent-in-suit, U.S. Patent No. 5,809,336 (“the ’336 Patent”), claims fundamental advances in microprocessor architecture. In 1989, the personal computer market was nascent. IBM compatible personal computers with 80386 processors (CPUs) operating at a speed of about 25 megahertz were state-of-the-art. There was an active race amongst chip manufacturers to release faster and faster CPUs. Engineers Charles H. Moore and Russell Fish, the inventors of the ’336 Patent, were developing next-generation microprocessors and were active participants in this race.

Moore, already well-known for inventing the Forth programming language, turned his attention to designing high performance CPUs. He and Fish ultimately developed the

“Sh-boom” microprocessor, which was later inducted into the I.E.E.E. Chip Hall of Fame because of its advanced architecture. As shown in Figure 1 of the ’336 Patent, the invention at issue here was born out of the “Sh-boom” microprocessor development. On August 3, 1989, Moore and Fish filed a comprehensive patent application describing the many improvements to microprocessor architecture in the Sh-boom microprocessor, two of which are significant here.

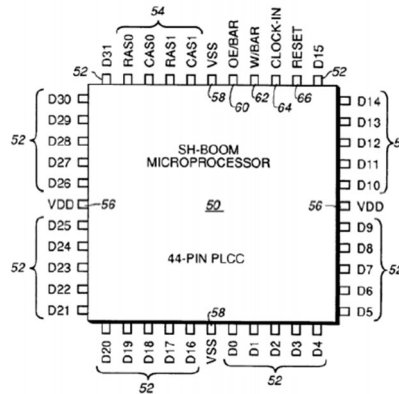


FIG. 1

The first embodiment of significance is labeled “Optimal CPU Clock Scheme” in the ’336 specification. Here, the inventors described a microprocessor architecture, whereby the clock used to control the speed of the central processing unit (“CPU”) is constructed on the same chip with the CPU using the same materials and manufacturing process. Moore and Fish originally attempted to obtain a claim for a microprocessor system with only two claim limitations (corresponding to the circled portion of Figure 17 from the ’336 Patent), a CPU (70) and a ring oscillator variable speed clock (430), that were constructed on the same chip (hereinafter the “single-clock claim”).

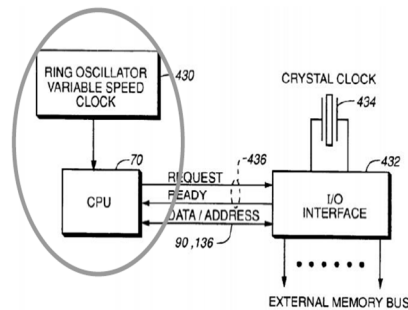


FIG. 17

The inventors tried mightily, but after a series of exchanges with the patent examiner, they were unable to convince the examiner to issue any form of this single-clock claim, even after providing significantly greater detail about the integrated ring oscillator clock in the claim language itself. The examiner repeatedly cited two references against the single-clock claim, a prior art patent issued to Sheets and a prior art patent issued to Magar. Ultimately, every argument or amendment the inventors made to try to obtain the single-clock claim over Sheets and Magar was unsuccessful; Moore and Fish never obtained any version of the single-clock claim. The final but unsuccessful version of the single-clock claim reads as follows:

A microprocessor system comprising:

a central processing unit disposed upon an integrated circuit substrate, said central processing unit operating at a processing frequency and being constructed of a first plurality of electronic devices;

an entire oscillator disposed upon said integrated circuit substrate and connected to said central processing unit, said oscillator clocking said central processing unit at a clock rate and being constructed of a second plurality of electronic devices, thus varying the processing frequency of said first plurality of electronic devices and the clock rate of said second plurality of electronic devices in the same way as a function of parameter variation in one or more fabrication or operational parameters associated with said integrated circuit substrate, thereby enabling said processing frequency to track said clock rate in response to said parameter variation.

The examiner, however, offered the inventors a path forward. During a telephonic interview, the examiner suggested that he would allow the claims as written above if the inventors agreed to narrow them by adding two additional limitations, which are described in the “Asynchronous/Synchronous CPU” embodiment of the '336 Patent. App.107a-113a.¹ In

¹ In their appeal, petitioners requested that the Federal Circuit take judicial notice of excerpts of the file history that were not in the lower court record, including this interview summary. Petitioners' request was denied. App.5a-7a. *Cf. Uniloc USA, Inc.*

this embodiment, the inventors described that it would be beneficial to have a second off-chip clock in addition to the ring oscillator clock on the same chip as the CPU. This second off-chip clock was a fixed-speed crystal clock that could control communications with slower portions of the system, such as output to a peripheral device, like a printer.

Moore and Fish accepted the examiner's suggestion and amended the claim at issue here to add limitations corresponding to each of the components in Figure 17 of the '336 Patent. Independent Claim 6 was then allowed, and the '336 Patent issued on September 15, 1998 with the two new limitations indicated in brackets below:

A microprocessor system comprising:

a central processing unit disposed upon an integrated circuit substrate, said central processing unit operating at a processing frequency and being constructed of a first plurality of electronic devices;

an entire oscillator disposed upon said integrated circuit substrate and connected

v. ADP, LLC, 772 F. App'x 890, 898 n.3 (Fed. Cir. 2019) (unpublished) ("The prosecution history is part of the intrinsic record of the patent and is a 'matter[] of public record.' *Data Engine Techs. LLC v. Google LLC*, 906 F.3d 999, 1008 n.2 (Fed. Cir. 2018). It is thus subject to judicial notice and may be considered in our de novo review of the district court's eligibility analysis."). But regardless of who suggested the amendment, a comparison of the rejected single-clock claim to the final issued claim reveals that the claim was allowed when narrowed by amendment to include the second clock and input/output interface limitations.

to said central processing unit, said oscillator clocking said central processing unit at a clock rate and being constructed of a second plurality of electronic devices, thus varying the processing frequency of said first plurality of electronic devices and the clock rate of said second plurality of electronic devices in the same way as a function of parameter variation in one or more fabrication or operational parameters associated with said integrated circuit substrate, thereby enabling said processing frequency to track said clock rate in response to said parameter variation;

[an on-chip input/output interface, connected between said central processing unit and an external memory bus, for facilitating exchanging coupling control signals, addresses and data with said central processing unit; and]

[an external clock, independent of said oscillator, connected to said input/output interface wherein said external clock is operative at a frequency independent of a clock frequency of said oscillator.]

Six *ex parte* reexamination requests challenging Claim 6 were submitted to the USPTO between 2006 and 2010.

The first three reexamination requests, which involved several hundred prior art references, were considered together by the USPTO. Ultimately, the examiner confirmed the patentability of Claim 6 with minor amendments that are not relevant to this case (they relate to the second clock limitation only). The

USPTO issued a reexamination certificate on December 15, 2009 (Certificate No. 7235). In these reexaminations, the Sheets reference was considered again.

The USPTO also considered the fourth reexamination request. The patentability of Claim 6 was confirmed without amendment on November 23, 2010 (Certificate No. 7887). The USPTO denied the fifth and sixth requests for reexamination of the '336 Patent.

Petitioners filed this action for patent infringement in the Northern District of California on July 24, 2012. Original and exclusive jurisdiction rested with the federal courts pursuant to 28 U.S.C. §§ 1331, 1338.

The case was stayed for approximately three years pending International Trade Commission proceedings. When the case emerged from stay, claim construction proceedings were scheduled. The parties asked the court to construe one limitation of the claim—the phrase “entire oscillator disposed upon said integrated circuit substrate.”

Respondents urged the court to apply a doctrine that the Federal Circuit has dubbed “prosecution history disclaimer” to add two negative limitations to the phrase “entire oscillator disposed upon said integrated circuit substrate.” Petitioners urged the district court not to apply prosecution history disclaimer.

The magistrate judge issued a report and recommendation concerning claim construction on September 22, 2015. App.45a. The report acknowledged that the prosecution history lacks the clarity of the specification and often is less useful for claim construction

purposes. App.57a. Nevertheless, the magistrate judge re-wrote the phrase “entire oscillator disposed upon said integrated circuit substrate” to include two additional negative limitations.

The magistrate judge added limitations based on the unsuccessful arguments the inventors made to the examiner regarding the Sheets and Magar references. App.49a-50a. The magistrate judge acknowledged that the claims already included limitations that addressed distinctions over Sheets and Magar: “It is true that the ‘on-chip/off-chip’ distinction and the invention’s variability depending on PVT are reflected in other limitations,” but concluded that these limitations “do not get at the full range of distinctions drawn” in the inventors’ arguments to the patent examiner about Sheets and Magar. App.60a.

The magistrate judge’s recommendation, which did not even adopt respondents’ proposed negative limitations, concludes as follows:

The undersigned appreciates that the construction recommended differs from the constructions adopted in the Eastern District of Texas, the International Trade Commission and by the undersigned as presiding judge in HTC. It also must be noted that neither party urged this particular language. . . . After multiple rounds of briefing by the parties and a lengthy hearing, the undersigned is convinced that the particular language urged recommended here best captures what actually happened at the patent office. In the universe of claim construction, that directive is ultimate prime.

App.61a. (emphasis added).

Petitioners sought relief from the magistrate judge's recommendation—arguing that there could be no “clear and unambiguous” disclaimer given the numerous prior claim construction proceedings that did not arrive at the same result. The magistrate judge himself admitted that he had previously construed the term differently in a different matter involving the same patent. Although the district court granted the request for de novo review, it adopted the report and recommendation without modification. App.42a-44a. In so doing, the district court cast aside the USPTO's six decisions affirming Claim 6 in response to the earlier reexamination requests.

The parties stipulated to entry of judgment so that the district court's claim construction order could be immediately appealed. In its opinion, the Federal Circuit explained the applicable law as follows:

An applicant's statements to the PTO characterizing its invention may give rise to prosecution history disclaimer. *Uship Intellectual Properties, LLC v. United States*, 714 F.3d 1311, 1315 (Fed. Cir. 2013). Prosecution disclaimer can arise from both claim amendments and arguments made to the PTO. *Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013). The doctrine does not apply unless the disclaimer is “both clear and unmistakable to one of ordinary skill in the art.” *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1371 (Fed. Cir. 2007) (quotations omitted). When determining whether dis-

claimer applies, we consider the statements in the context of the entire prosecution. *Massachusetts Inst. of Tech. v. Shire Pharm., Inc.*, 839 F.3d 1111, 1119 (Fed. Cir. 2016). If the challenged statements are ambiguous or amenable to multiple reasonable interpretations, prosecution disclaimer is not established. *Id.*

Tech. Properties Ltd. LLC v. Huawei Techs. Co., 849 F.3d 1349, 1357-58 (Fed. Cir. 2017) (emphasis added) (App.31a).

The Federal Circuit affirmed the district court's decision to add the two limitations by applying the doctrine of prosecution history disclaimer, but determined that the district court erred as to the scope of the Sheets disclaimer and therefore altered it. *Id.* at 1359-60. With the judicially-added limitations inserted in underline, the entire oscillator limitation now read as follows on remand:

an entire oscillator, disposed upon said integrated circuit substrate (1) that does not require a command input to change the clock frequency and (2) whose frequency is not fixed by any external crystal, and connected to said central processing unit, said oscillator clocking said central processing unit at a clock rate and being constructed of a second plurality of electronic devices, thus varying the processing frequency of said first plurality of electronic devices and the clock rate of said second plurality of electronic devices in the same way as a function of parameter variation in one or more fabrication or

operational parameters associated with said integrated circuit substrate, thereby enabling said processing frequency to track said clock rate in response to said parameter variation;

On remand, the district court granted summary judgment of non-infringement based solely on one of the judicially-added limitations—the limitation added based on the inventors’ ultimately futile arguments regarding Sheets. App.8a-16a. The district court commented that it would likely reach the same outcome on the second judicially-added limitation relating to the inventors’ unsuccessful Magar arguments. App.15a.

Petitioners appealed, arguing that the district court wrongly rejected binding authority from this Court when it effectively amended Claim 6 by adding two limitations based on the inventors’ unsuccessful efforts to obtain a one-clock claim.² Petitioner also appealed the merits of the summary judgment order.

5. The district court’s summary judgment order was affirmed without opinion. App.1a-2a.

Petitioner filed a petition for rehearing en banc raising procedural and substantive challenges to the Federal Circuit’s use of the prosecution history disclaimer doctrine to add limitations and change the scope of patent claims.

² On the second appeal to the Federal Circuit, respondents argued that petitioners waived arguments challenging prosecution history disclaimer even though petitioners have always maintained that the courts inappropriately reached beyond the amendments to Claim 6 to write additional limitations into that claim. The Federal Circuit entertained extensive oral argument on the propriety of the prosecution history disclaimer doctrine.

The petition for rehearing en banc was denied; mandate issued on April 17, 2019. App.3a-4a.



REASONS FOR GRANTING THE PETITION

I. THE COURT OF APPEALS DECISION IS WRONG

The USPTO issued the '336 Patent in 1998. To obtain allowance of their patent over the Sheets and Magar prior art references, the inventors were forced to narrow Claim 6 from a one-clock claim to a two-clock claim. The USPTO reexamined the '336 Patent no fewer than six times between 2006 and 2010. Each time, Claim 6 emerged unscathed, save for a minor amendment to a portion not at issue here. Six times a third party challenged the patent, and six times the USPTO satisfied itself that Claim 6 was valid and properly reflected the scope of Moore's and Fish's invention. That should have settled the matter. The Patent Act does not authorize a third party to seek judicial review of a USPTO decision affirming a patent after reexamination.

But it didn't settle the matter. The district court and the Federal Circuit allowed respondents to make an end run around the Patent Act using the doctrine of prosecution history disclaimer. Through the guise of claim construction, the district court rifled through the file history to form its own conclusions about "what actually happened at the patent office" leading up to the inventors' decision to amend Claim 6 to add a second clock. The district court then significantly narrowed the amended Claim 6 based on the inventors'

statements trying to convince the USPTO to issue the original one-clock Claim 6 over the Magar and Sheets prior art. The Federal Circuit affirmed.

1. The Federal Circuit decision runs afoul of the separation of powers among Congress, the USPTO, and the federal courts embodied in the Patent Act. Article I, section 8, clauses 8 and 18 of the United States Constitution give Congress the power to enact all laws necessary to secure for inventors the exclusive rights to use their discoveries. Congress fulfilled those constitutional duties by enacting, and amending from time to time, the Patent Act.

By statute, Congress delineated the powers and responsibilities of the USPTO, and it defined in detail the limited authority of the federal courts to review certain USPTO decisions and adjudicate certain patent disputes. This Court has ruled that the Patent Act's division of responsibility among Congress, the USPTO, and the federal courts is constitutional. *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S.Ct. 1365 (2018); *Cuozzo Speed Techs., LLC v. Lee*, 136 S.Ct. 2131 (2016).

The power to issue patents with claims that particularly specify the invention to which an inventor is entitled rests exclusively with the USPTO. As this Court explained in 1877:

Since the act of 1836, the patent laws require that an applicant for a patent shall not only, by a specification in writing, fully explain his invention, but that he 'shall particularly specify and point out the part, improvement, or combination which he claims as his own invention or discovery.' This

provision was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture, derived from a laborious examination of previous inventions, and a comparison thereof with that claimed by him. This duty is now cast upon the Patent Office. There his claim is, or is supposed to be, examined, scrutinized, limited, and made to conform to what he is entitled to.

Keystone Bridge Co. v. Phoenix Iron Co., 95 U.S. 274, 278 (1877) (emphasis added).

The USPTO has the exclusive power to examine, issue, reexamine, and reissue patent claims. 35 U.S.C. § 2(a)(1). The USPTO is empowered to decide whether the claim limitations proposed by an applicant appropriately capture and particularly point out the applicant's invention, and to require amendments until the statutory requirements for patentability are met. 35 U.S.C. §§ 101, 102, 103, 112, 131-132. The USPTO can also revisit its decisions regarding issuance in reexamination proceedings, where it likewise has the power to determine if amendments are appropriate. 35 U.S.C. §§ 304-305.

Congress limited the judiciary's power to review decisions made by the USPTO to issue, reexamine, and reissue patent claims. The patentee has certain limited rights to seek judicial review of USPTO decisions in the original patent prosecution and in reexamination proceedings. 35 U.S.C. § 141. The power of the judiciary in those situations is limited to affirming or reversing

the USPTO’s decisions; the judiciary cannot rewrite the claims. 35 U.S.C. § 145.

Any third party may request reexamination of an issued patent. 35 U.S.C. §§ 301-302. But that third party can never request that the claims be amended, and cannot seek review of USPTO decisions not to reexamine the patent, or to reaffirm and reissue patent claims, with or without amendment, in a reexamination proceeding.³

Congress authorized federal courts to preside over infringement actions and to make legal decisions bearing on infringement and invalidity. But the legislature never granted federal courts the power to rewrite claims by adding limitations.

2. The claims of the patent define the metes and bounds of a patentee’s right to exclude others from making, using, and selling her invention. This principle has been recognized since at least 1836, when Congress first required that the specification include a portion in which the inventor “shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.” 24 Cong. Ch. 357, § 6, 5 Stat. 119 (App.79a).

This Court has repeatedly affirmed the bright line rule that the claims are “of primary importance, in the effort to ascertain precisely what it is that is patented. . . .” *Merrill v. Yeomans*, 94 U.S. 568, 570 (1876). Because the patentee is required to “define precisely what his invention is,” the Court explained,

³ In the Leahy-Smith America Invents Act (“AIA”) of 2011, Congress recently expanded the USPTO’s power to review its own decisions, and again provided for limited judicial review.

it is “unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms.” *White v. Dunbar*, 119 U.S. 47, 52 (1886); *see also McCarty v. Lehigh Val. R. Co.*, 160 U.S. 110, 116 (1895) (“[I]f we once begin to include elements not mentioned in the claim, in order to limit such claim, . . . we should never know where to stop.”). In *Aro*, 365 U.S. at 339, this Court reiterated that “the claims made in the patent are the sole measure of the grant. . . .”

Federal Circuit precedent is in accord with this foundational premise of patent law. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (citing *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)), *cert denied*, 546 U.S. 1170 (2006). In its seminal en banc opinion on claim construction in *Markman*, 52 F.3d at 980 the Federal Circuit wrote: “The written description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims.”

While the prosecution history can play some role in claim construction, it should not be used to diminish or enlarge the scope of the claims. Recognizing that the issued patent is intended to reflect the final memorial of the applicants’ exchange with the USPTO, no lesser light than Judge Learned Hand noted that under settled precedent, courts were not “to go through all that was said in the endless communications between applicant and examiners to gather piecemeal the intent of the grant. . . .” *Campbell Metal Window Corp. v. S.H. Pomeroy & Co.*, 300 F. 872, 873-74 (S.D.N.Y. 1924) (citing *Goodyear Dental*, 102 U.S.

222). Consistent with this authority, the Federal Circuit reiterated in *Markman* that the prosecution history may provide insight into the meaning of language used in the claims, but cannot be used to “enlarge, diminish, or vary” their scope. *Markman*, 52 F.3d at 980 (quoting *Goodyear Dental*, 102 U.S. at 227). But that is exactly what happened here.

3. The doctrine of “prosecution history disclaimer” improperly claims for the judiciary powers that are delegated exclusively to the USPTO. In this case, the Federal Circuit used prosecution history disclaimer to do precisely what it warned courts they must not do during claim construction: diminish the scope of petitioners’ claims. And this case is just the tip of the iceberg. The Federal Circuit, and district courts abiding by its directives, have used a patent’s prosecution history to enlarge, diminish, or vary claim scope in hundreds of cases.

This case starkly illustrates this jurisprudential anomaly. Here, the district court applied the doctrine of prosecution history disclaimer to add two limitations to the claim based on arguments made by the inventors during the initial patent prosecution that were not material to the examiner’s decision to allow the patent to issue. Worse yet, the district court acknowledged that the claims already included limitations corresponding to the alleged disclaimer statements—but in its view, the claims did not accurately reflect the “full scope” of what happened at the USPTO. The district court did not acknowledge that the USPTO had already reconsidered and reaffirmed its approval of Claim 6 as written six different times. The Federal Circuit affirmed this decision, but

engaged in second-guessing of its own, re-writing one of the added limitations before remanding.

The consequences of this decision are very real. The addition of these limitations was dispositive; summary judgment was granted based on one of the added limitations, and the Federal Circuit affirmed.

But the judiciary does not have the power to rewrite claims to add limitations based on its interpretation of “what actually happened at the patent office.” This doctrine of “prosecution history disclaimer,” a term coined by the Federal Circuit, opened an entirely new frontier, authorizing courts to search through a file history for any statement that could be viewed as bearing on the scope of a claim. The Federal Circuit authorized judges to supplant their own judgment for that of the USPTO, so that they could decide for themselves, as the magistrate judge did here, “what actually happened at the patent office.” But in accordance with the Patent Act and almost 200 years of precedent, we already know the answer to that question—it is found in the issued patent claims.

Given its own clear pronouncement in *Markman*, how did the Federal Circuit get here?

In 2003, the Federal Circuit declared: “The doctrine of prosecution disclaimer is well established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.” *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (emphasis added).

The *Omega* panel made this pronouncement as if it were black letter Supreme Court jurisprudence on claim construction. It is not.

Omega supports its assertion with four cases that are often relied on by Federal Circuit panels to support the existence of its prosecution history disclaimer doctrine:

See Schriber–Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 220-21 (1940) (“It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent.”); *Crawford v. Heysinger*, 123 U.S. 589, 602-04 (1887); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880); *cf. Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966) (ruling, in addressing the invalidity of the patents in suit, that “claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent.”).

Omega, 334 F.3d at 1323.

Critically, in all four of the cited cases, the claims were amended during prosecution or reexamination in accord with the provisions and procedures for patent prosecution in the USPTO in the Patent Act. In each of these cases, the patentee affirmatively surrendered claim scope by agreeing to an amend-

ment adding limitations to the claims in the USPTO. When a patentee amends its claims, it can no longer claim the broader scope of the original claims. But there is no suggestion in these cases that scope can be surrendered by anything other than claim amendments. Thus, they simply do not support the Federal Circuit's expansion of the concept of any "disclaimer" beyond the amendments entered during the original prosecution, a reissue, or reexamination proceeding in the USPTO.

The cases cited in support of the Federal Circuit's parenthetical quote from *Scriber-Schroth* prove this fact beyond question. For the proposition, "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent," *Scriber-Schroth*, 311 U.S. at 220-21, cites:

Shepard v. Carrigan, 116 U.S. 593 (1886);
Sutter v. Robinson, 119 U.S. 530 (1886);
Roemer v. Peddie, 132 U.S. 313 (1889);
Phoenix Caster Co. v. Spiegel, 133 U.S. 360
 (1890); *Hubbell v. United States*, 179 U.S. 77
 (1900); *Weber Electric Co. v. E.H. Freeman
 Electric Co.*, 256 U.S. 668 (1921); *I.T.S.
 Rubber Co. v. Essex Rubber Co.*, 272 U.S.
 429, 443 (1926).

Every one of these cases deal with the amendment of claims during prosecution or reissue. They provide no justification for the Federal Circuit's expansive prosecution history disclaimer doctrine.

But there is an even more significant issue with the Federal Circuit's reliance on *Schriber-Schroth*. That case concerned a distinct equitable doctrine called "prosecution history estoppel." It is decidedly not about claim construction or "prosecution history disclaimer." This equitable doctrine offers no support for the Federal Circuit's use and regular expansion of its "prosecution history disclaimer" case law. In fact, the two doctrines cannot rationally co-exist.

Omega quotes only part of a paragraph from *Schriber-Schroth*. Immediately after the quoted sentence, the *Schriber-Schroth* Court continued: "The patentee may not, by resort to the doctrine of equivalents, give to an allowed claim a scope which it might have had without the amendments, the cancellation of which amounts to a disclaimer." Prosecution history estoppel is a well-established equitable doctrine that applies only when the patentee asserts infringement under the doctrine of equivalents instead of claiming literal infringement.

This Court has long held that where a patentee has amended claims to overcome prior art, "[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," such that those differences "cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed." *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-37 (1942) (emphasis added).

“Prosecution history estoppel ensures that the doctrine of equivalents remains tied to its underlying purpose. Where the original application once embraced the purported equivalent but the patentee narrowed his claims to obtain the patent or to protect its validity, the patentee cannot assert that he lacked the words to describe the subject matter in question.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 734 (2002) (emphasis added). Put simply, when a patentee asserts that an accused product infringes because it is “equivalent” to what is actually claimed, the doctrine of prosecution history estoppel authorizes a court to consult the file history to determine whether the alleged “equivalent” was surrendered by amendment or by cancellation of claims during prosecution.

Unlike prosecution history estoppel, which addresses situations where a patentee seeks to extend her claims in equity to a structure that is not explicitly claimed, the Federal Circuit’s prosecution history disclaimer doctrine seeks to narrow the scope of a claim such that it no longer covers that which it explicitly claims, in the context of literal infringement. Nor does the Federal Circuit’s prosecution history disclaimer doctrine limit itself to assessing claim interpretation “by reference to those [claims] ‘that have been cancelled or rejected’” as contemplated by this Court in *Festo*. Instead, as expanded and applied by the Federal Circuit, any statement made by a patentee, even with respect to unsuccessful arguments, can be used to change the claim scope for purposes of direct infringement.

Neither the Patent Act nor this Court's patent jurisprudence supports a doctrine that uses a broad array of statements in the file history to add limitations to a claim during claim construction (a determination made as a matter of law). Contrast such a rule with this Court's insistence that only amendment, cancellation, or surrender will bar a plaintiff from relying on the doctrine of equivalents to prove infringement. Such a disparity in approach defies logic. There is no support in this Court's precedent for the Federal Circuit's prosecution history disclaimer doctrine.⁴

II. THE PROSECUTION HISTORY DISCLAIMER DOCTRINE CREATES INSTABILITY IN THE U.S. PATENT SYSTEM

1. The prosecution history disclaimer doctrine has undermined the public notice function of patent claims. Because of this doctrine, it is common for claim construction proceedings to focus on the prosecution history first, and almost exclusively, instead of the plain and ordinary meaning of the terms, which is where the canons of claim construction mandate that the inquiry begin. When a court makes the prosecution history the primary focus of claim construction, it both undermines the public notice of the claims and diminishes the significance of the patent grant.

This *post hoc* process, by its very nature, is inherently subjective. Under the prosecution history disclaimer doctrine, the Federal Circuit gives courts free rein to decide, as a matter of law, what the court

⁴ In *Omega*, the Federal Circuit also cite a series of its cases applying "prosecution history disclaimer" in further support of application of the doctrine. 334 F.3d at 1323-24. All these cases stand on the same faulty logic.

believes “actually happened” at the USPTO. Aside from being prohibited from adding limitations to patent claims by revisiting “what actually happened at the patent office,” the task is a fool’s errand. The prosecution history often does not even reflect all the communications between the examiner and the patent applicant, many of which occur on the telephone or even in lengthy in-person meetings. At most, there is a one-or two-line summary of those communications contained in the file history. The written communications also are not required to reflect the complete thought process of the examiner, or what argument convinced an examiner to change her mind on a given issue. Not only is the disclaimer process subjective, because the files are incomplete, it has a very low chance of even yielding the answer to “what actually happened at the patent office”—if that was an appropriate inquiry, which it is not.

As the panel did during oral argument in this case, the Federal Circuit often asserts that as a matter of public notice, would-be infringers should be entitled to rely on the statements an applicant makes to the USPTO when seeking issuance of its claims. But there is no evidence in this case (or any of the others in which the prosecution history disclaimer has been applied) that the respondents relied on statements made by the inventors to the USPTO other than when it was convenient for them to assert statements as defenses in the infringement action. In any event, the haphazard way the doctrine has been applied makes it of limited value to a would-be infringer.

On the one hand, the Federal Circuit has decreed that disclaimer of claim scope must be “clear and

unmistakable.” *See Omega*, 334 F.3d at 1325-26 (“[F]or prosecution disclaimer to attach, our precedent requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable.”). However, this case powerfully demonstrates the unpredictability of the “clear and unmistakable” standard. Claim 6 of the ’336 Patent has been the subject of no fewer than five different claim construction orders—four finding disclaimers based on a clear and unequivocal disavowal of claim scope, and one finding no disclaimer. To make matters worse, in the cases where disclaimer was found, none of the articulations of the scope of the purported disclaimer match. Indeed, in this case, the respondents proposed one formulation, the district court adopted another, and the Federal Circuit adopted yet a third.

Other examples of the uncertainty and chaos arising from prosecution history disclaimer abound. In *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1377-78 (Fed. Cir. 2008), the Federal Circuit limited claims drawn to a “portable computer” or “portable computer microprocessing system” to exclude laptops based on applicants’ distinctions over a prior art reference, even though the examiner’s Reasons for Allowance indicated that the claims were allowable because of a different limitation. *Id.* at 1376-77.

Considering the applicant-examiner exchanges some 18 years later, the panel determined that it could disregard the examiner’s express statement because, from its view, it saw “little doubt that the distinctions between the invention and [the prior art reference] are more extensive than only the [limitation relied upon by the examiner].” *Id.* at 1377. The

court held that disavowal “can lie in a single distinction among many.” *Id.* The Federal Circuit reached this conclusion despite noting: “Of course, a multitude of distinctions may serve to make any single distinction in the group less clear and unmistakable as the point of distinction over prior art and as a critical defining point for the invention as a whole.” *Id.* at 1378.

A year later, in *Vehicle IP, LLC v. Gen. Motors Corp.*, 306 F. App’x 574, 578 (Fed. Cir. 2009) (unpublished), the Federal Circuit held that disclaimer may be inferred from a single statement: “If the location of the mobile unit must be determined independently of the notification coordinate, then the notification coordinate necessarily must provide an absolute location.” Two members of the panel decided that disclaimer was “clear,” even though the dissent explained why the court’s inference was not only inappropriate from a technical standpoint, but contrary to the explicit claim language of the issued claim. *Id.* at 579 (Mayer, J., dissenting). A request for rehearing was denied.

The Federal Circuit has even demonstrated a willingness to disregard an examiner’s contemporaneous findings. In *Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1095 (Fed. Cir. 2013), for example, the court upheld a disclaimer that was “teas[ed] out” from portions of the file history addressing an enablement rejection. *Id.* at 1098 (Plager, J., dissenting). The examiner explicitly stated that he “broadly interpreted” the claims, and allowed them to issue as written; yet, in the face of this explicit determination, the court endeavored to “analyze how the PTO and the inventors understood the disputed term.” The court then concluded that the examiner must have

been wrong and ruled that the issued claims must be further limited. *Id.* at 1095 (majority decision).

The dissent sharply criticized the majority's effort to "tease out" disclaimer from the prosecution history, particularly where the disclaimer relied more on statements by the examiner, not the applicant. *Id.* at 1098 (Plager, J., dissenting). Nonetheless, consistent with the Federal Circuit's typical practice, the patentee's request for rehearing en banc was denied.

The line is now so unpredictable that a disclaimer finding can turn on the Federal Circuit's assessment that an applicant is "characterizing the prior art" as opposed to "distinguishing" it. For example, one panel in *Shire Dev., LLC v. Watson Pharm., Inc.*, 787 F.3d 1359, 1366 (Fed. Cir. 2015), decided that there was no disclaimer because the applicant "carefully characterized the prior art as not having separate matrices but never actually stated that the claimed invention does have separate matrices." But in *Krippelz v. Ford Motor Co.*, 667 F.3d 1261, 1266-67 (Fed. Cir. 2012), a different panel imposed disclaimer, reversing the district court's summary judgment order on infringement and the jury's on validity. The panel focused on a reexamination proceeding in which the Board of Patent Appeals and Interferences ultimately confirmed the patentability of the claims as written. In defending the patent, the patentee characterized the "Kim" prior art reference as lacking a "light bulb at or near the focal point of a reflector." *Id.* at 1267. The Federal Circuit understood this, as it noted: "Endeavoring to traverse the rejection, Mr. Krippelz attacked Kim." *Id.* at 1266. Nonetheless, the Federal Circuit decided that those

characterizations of the prior art (not the claimed invention) “disclaimed lamps lacking these limitations, and the limitations therefore became part of the properly construed claims.” *Id.* at 1267.

Mr. Krippelz, an individual inventor, secured his patent claims, and they survived reexamination. He secured a jury verdict of validity and an award of \$21 million in damages. He also proved willful infringement, warranting treatment as an exceptional case. Mr. Krippelz died during the pendency of lengthy proceedings to enforce his patent rights and ended up with nothing by virtue of the panel’s decision.

This is no way to run the U.S. patent system.

2. In this high-visibility case, involving the cutting edge of technological advancement, the Federal Circuit indulged in its ever-increasing practice of summary dismissal. Not only is the underlying doctrine deeply suspect under both existing judicial precedent and foundational principles of separation of powers, the Federal Circuit has eluded basic norms of accountability by its employment of the procedural shortcut of summary affirmance. It failed to give a public accounting that displays reasoned and deliberative judicial decision-making in a highly controversial—and vitally important—arena of patent law.

The underlying record here is clear. It is undisputed that the courts below engaged in an aggressive application of the “prosecution history disclaimer” doctrine. The Federal Circuit’s silence only adds to the need for this Court’s review.

At a minimum, the importance of this frequently invoked doctrine, coupled with the Federal Circuit’s

increasingly aggressive employment of summary disposition, suggests the wisdom of calling for the views of the Solicitor General.

III. THIS CASE PROVIDES AN APPROPRIATE VEHICLE

This case presents a perfect example of how the prosecution history disclaimer doctrine disrupts the constitutional balance among Congress, the USPTO, and the federal courts in effectuating the patent system. The USPTO was asked six times to reexamine the two-clock invention in Claim 6. It agreed four times to conduct that review. In every instance, it affirmed that the two claim as issued was proper (with one minor change not relevant here). That should have been the end of the line on the scope of Claim 6.

The '336 Patent has been the subject of litigation in several federal district courts, the Federal Circuit, and the International Trade Commission. Those tribunals issued five different claim construction orders—four that rely on prosecution history disclaimer to limit the scope of the two-clock claim and one that does not. And despite the Federal Circuit's directive to find disclaimer only when the inventors' statements are "clear and unequivocal," the four courts formed four different opinions about what the file history showed and imposed different limitations on the two-clock claim. It is difficult to imagine a better record for understanding how a court's *post hoc* assessment of "what really happened at the patent office" is judicial overreach run amok.

Petitioners respectfully submit that the doctrine of prosecution history disclaimer is contrary to binding precedent and violates separation of powers

principles. Claim scope can only be changed in the USPTO by amendment. Courts should not be permitted to second-guess work of the USPTO done in accord with the powers and responsibilities granted to it by Congress. The Patent Act grants federal courts limited and specified jurisdiction regarding their review of USPTO actions and regarding infringement cases. Courts should not be permitted to expand their power by rewriting claims to add limitations as a matter of law during claim construction when the power to examine, amend, reject, and grant patents rests exclusively with the USPTO.



CONCLUSION

For the reasons set forth above, the petition for certiorari should be granted. Alternatively, the Court may wish to consider calling for the views of the Solicitor General.

Respectfully submitted,

KENNETH W. STARR
THE LANIER LAW FIRM
10940 W. SAM HOUSTON PKWY. N., SUITE 100
HOUSTON, TX 77064
(713) 659-5200
KEN.STARR@LANIERLAWFIRM.COM

DENISE M. DE MORY
COUNSEL OF RECORD
AARON R. HAND
LAUREN N. ROBINSON
VERNON C. GRIGG III
WENDY J. THURM
BUNSOW DE MORY LLP
701 EL CAMINO REAL
REDWOOD CITY, CA 94063
(650) 351-7248
DDEMORY@BDIPLAW.COM
AHAND@BDIPLAW.COM
LROBINSON@BDIPLAW.COM
VGRIGG@BDIPLAW.COM
WTHURM@BDIPLAW.COM

*COUNSEL FOR APPLICANTS,
TECHNOLOGY PROPERTIES LIMITED LLC,
PHOENIX DIGITAL SOLUTIONS LLC, AND
PATRIOT SCIENTIFIC CORPORATION*

SEPTEMBER 6, 2019