

No. 19-

IN THE
Supreme Court of the United States

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

Petitioners,

v.

CONTINENTAL CIRCUITS LLC,

Respondent.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether courts should construe a patent's claims in light of the written description of the invention disclosed in the patent's specification, or whether, as the Federal Circuit held, courts should first determine the ordinary meaning of claim terms in isolation, and consider the specification only to the extent that it contains a clear and unmistakable disclaimer of claim scope.

**PARTIES TO THE PROCEEDING AND
CORPORATE DISCLOSURE STATEMENT**

Petitioners are Intel Corporation; Ibiden U.S.A. Corporation, and Ibiden Company Limited. Respondent is Continental Circuits LLC.

Intel Corporation has no parent corporation and there are no publicly held companies that hold 10% or more of Intel's stock.

Ibiden Co. Limited is the parent of Ibiden U.S.A. Corp. and is publicly traded on the Nikkei Index. Ibiden Co. Limited has no parent corporation and there are no publicly held companies that hold 10% or more of Ibiden Co. Limited's stock.

RELATED PROCEEDINGS

The proceedings directly related to this petition are:

- *Continental Circuits LLC v. Intel Corporation*, No. 18-1076 (Fed. Cir. Feb. 8, 2019), *rehearing en banc denied* (Fed. Cir. June 14, 2019)
- *Continental Circuits LLC v. Intel Corporation*, No. 2:16-cv-2026 (D. Ariz. Sept. 13, 2017)

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PETITION FOR A WRIT OF CERTIORARI

Intel Corporation, Ividen U.S.A. Corporation, and Ividen Company Limited (collectively, “Intel”) 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 Federal Circuit’s opinion vacating the judgment of the district court and remanding (App. 1a-20a) is reported at 915 F.3d 788. The Federal Circuit’s opinion denying panel rehearing and rehearing en banc (App. 66a-67a) is unreported. The district court’s opinion on claim construction (App. 23a-65a) is unreported but is available at 2017 WL 3478659. The district court’s judgment (App. 21a-22a) is unreported.

JURISDICTION

The Federal Circuit entered judgment on February 8, 2019, and denied a timely rehearing petition on June 14, 2019. App. 1a-20a, 67a-68a. On August 30, 2019, the Chief Justice extended the time in which to file a petition for a writ of certiorari to and including October 28, 2019. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

35 U.S.C. § 112 (2006) provides in relevant part:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable

any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.¹

INTRODUCTION

This case presents a fundamental question of patent law on which the judges of the Federal Circuit are intractably divided. The question concerns claim construction—*i.e.*, the process of interpreting the language of a patent’s claims. Claim construction is a critical step in nearly every patent case because it determines the boundaries of the patent’s monopoly and sets the terms for disputes over whether the patent is infringed or invalid. This Court has long held that a patent’s claims must be construed in light of its “specification,” which contains “a written description of the invention” and an explanation of how the invention differs from the prior art. 35 U.S.C. § 112; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940). For decades, however, panels of the Federal Circuit have oscillated between two fundamentally incompatible approaches to the role that the patent specification plays in the claim construction process.

In a first line of cases, exemplified by the decision below, the Federal Circuit has instructed that claims be

¹ The pre-America Invents Act statute applies here, but the current version of Section 112 is substantively the same.

construed in isolation from the specification, with the words of the claim given their “ordinary and customary meaning,” without regard to the written description of the invention. On the view of this authority, the specification comes into play only in a second claim construction step, when the court asks whether statements in the specification are sufficiently clear to *override* the ordinary meaning of the claim language read in isolation.

In a second line of cases—one more faithful to the Patent Act and this Court’s precedents—the Federal Circuit has repudiated this two-step approach to claim construction, holding instead that claims must be read holistically in light of the specification. On this view, the specification is relevant to the claim construction analysis *ab initio*, and the process of determining the ordinary and customary meaning of the claims must be informed by the way the patentee described her invention in the specification.

This case vividly illustrates the consequences of the methodological split in the Federal Circuit’s claim construction cases. The only issue on appeal was whether the asserted claims in the patents at issue were limited to the invention as described in the written description—namely, a “repeated desmear” process used in manufacturing computer chip components. The patents’ specification makes clear that the crux of the invention is the allegedly unexpected roughening that results from use of a repeated, rather than single, desmear process: the specification defines the invention by reference to performing a desmear process more than once, and it distinguishes and criticizes prior-art roughening approaches that used only a single desmear process. App. 84a-85a, 88a, 92a. Applying the two-step methodological approach, the Federal Circuit first concluded

that the claim language, construed in isolation without reference to the specification, was not limited to a repeated desmear process. Only then did the court consider the specification, applying a heightened standard that asked only whether the written description's statements regarding the invention were sufficiently "clear and unmistakable" to limit the scope of the claims to a repeated desmear process. App. 14a. The Federal Circuit thus construed the asserted claims to be *broader* than the alleged invention described in the written description—with the perverse result that the asserted claims now cover the very same prior art characteristic (*i.e.*, a single-pass desmear) that the invention described in the specification criticizes and purports to improve upon.

As this case demonstrates, the Federal Circuit's two-step approach is irreconcilable with the fundamental principle that patent protection must be limited to the invention actually disclosed to the public. Moreover, the Federal Circuit's doctrinal inconsistency on a foundational issue in patent law makes claim construction a matter of panel-dependent chance rather than principle. This uncertainty impedes innovation by undermining the public's ability to discern the scope of a patent by reading the specification. The Court should accordingly take this opportunity to realign the Federal Circuit's approach to claim construction with the Patent Act and this Court's precedents.

STATEMENT

1. A patent is a legal instrument that grants to the patentee "the right to exclude others" from practicing the claimed invention. 35 U.S.C. § 154(a)(1). The patent document includes a specification and drawings. 35

U.S.C. §§ 111(a)(2), 113, 154(a)(4). The specification must “contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains * * * to make and use the same.”² 35 U.S.C. § 112 (2006). The written description gives the public the benefit of the invention by describing it in detail—and often places the invention in context, describing the technical problem it purports to address, the prior art, and why the prior art is insufficient to address that problem.

Because the line between the actual invention and the background descriptive material can sometimes be unclear, the Patent Act requires that “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” *Ibid.* Because the claims and the written description are part of one integrated document, “it is fundamental that claims are to be construed in the light of the specification[] and both are to be read with a view to ascertaining the invention.” *United States v. Adams*, 383 U.S. 39, 49 (1966).

2. The accused products at issue in this case are a computer component called a “substrate.” Substrates are multilayered structures consisting of both conductive material (*e.g.*, metal such as copper) and insulating “dielectric” material (*e.g.*, plastics such as epoxy). C.A.J.A. 2026-2027. In the process of manufacturing the

² Although the Patent Act provides that claims are part of a patent’s specification, courts typically use the term “specification” to refer specifically to the written description portion that precedes the claims.

alternating conductive and dielectric layers of a substrate, residual material called “smear” can accumulate on a dielectric layer and must be removed before the next conductive layer is added. To do so, a “desmear” process is performed in which various chemicals and rinses are applied to remove the smear. It has long been known that the desmear process, in addition to removing the smear, roughens the surface of the dielectric material, thereby improving adhesion between the conductive and dielectric layers of the substrate and reducing their tendency to delaminate, or peel away from each other. App. 84a-85a.

Continental Circuits, Inc. filed the original parent application to the patents-in-suit in 1997. App. 69a; C.A.J.A. 100, 368. The following year, that entity filed for bankruptcy. Respondent Continental Circuits LLC is a nonpracticing entity founded in 2016 by Peter Trzyna, the attorney who prosecuted the original patent application. After purchasing the parent application family in 2003 for \$1,000, between 2004 and 2013 Mr. Trzyna filed six “continuation” patent applications—*i.e.*, new applications based on the original parent patent’s specification. Four of those applications, which contained a total of 337 claims, became the patents-in-suit; each of those patents is currently owned by Continental Circuits LLC.³

3. The patents-in-suit are directed to a “multilayer electrical device * * * having a tooth structure” and methods for making the device. App. 69a. As relevant here, the claims include limitations regarding the “surface” or “etching” of a “dielectric material” or “epoxy.”

³ The patents are U.S. Patent Nos. 7,501,582; 8,278,560; 8,581,105; and 9,374,912. C.A.J.A. 100-151.

App. 26a-27a. The claim construction issue presented in this case concerns whether these terms should be construed to require a repeated desmear process (*i.e.*, performing the desmear process at least twice), as opposed to a single desmear process. *Ibid.*

The patents' common specification explains that roughening the surface of the dielectric material was a known way to improve adhesion between substrate layers. App. 74a-75a, 76a. It further explains that a single-pass desmear was a known way of achieving roughening. App. 84a-85a, 88a, 91a. The specification states, however, that single-pass desmear processes in the prior art did not result in enough roughening to ensure sufficient adhesion between layers, and as a result, prior art substrates suffered from delamination. App. 74a-75a; see also App. 88a, 92a (criticizing single-pass desmear as resulting in insufficient roughness and adhesion).

The patents-in-suit purport to improve upon the single-pass desmear process in one and only one way: by performing the desmear steps known in the prior art and then *repeating* those steps at least a second time. Accordingly, the specification characterizes "*the present invention*" as "differ[ing] from the common desmear process in that sub-steps in the desmear process are repeated." App. 91a (emphasis added). It emphasizes that distinction several times:

- "In *stark contrast* with the * * * process of the known prior art, * * * a second pass through the process * * * is used." App. 92a (emphasis added).
- "[T]he desmear process as disclosed herein is * * * a 'double desmear process,' *rather than the*

single desmear process of the known prior art.” App. 85a (emphasis added).

- “[C]ontrary to all known teachings in the prior art, in effect, a ‘double desmear process’ is utilized.” App. 84a (emphasis added).

The specification further states that the adhesion between layers “produced in accordance with *the present invention* is greater than” that “produced by the desmear process of the prior art, *i.e.*, a single pass desmear process.” App. 88a (emphasis added).⁴

4. In June 2016, respondent filed suit against petitioners in the U.S. District Court for the District of Arizona, alleging that *every* Intel processor made between 2010 and 2017 infringes the decades-old technology described in the four patents-in-suit.

During claim construction proceedings, the parties identified elements from each asserted claim related to the “surface,” “removal,” or “etching” of the dielectric material, and agreed they should be construed as a

⁴ Substantial additional evidence confirms what the specification makes plain—namely, that the only alleged invention disclosed in respondent’s patents stemmed from use of a repeated desmear process. For example, during prosecution of one patent-in-suit, the examiner rejected claims as indefinite “for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” C.A.J.A. 2123. The applicant responded with an expert declaration asserting that the claims were definite because they disclosed a roughened surface created by “two separate” desmear passes, and the examiner then withdrew the rejection. C.A.J.A. 2074. The district court found that this and other extrinsic evidence corroborated its claim construction requiring a repeated desmear process. App. 36a.

group. C.A.J.A. 4; C.A.J.A. 1874-1875; C.A.J.A. 1880-1889. Petitioners argued that, although the asserted claims at issue did not explicitly recite a *repeated* desmear process, the claims must necessarily be limited to a repeated desmear process in light of the statements in the specification describing “the present invention” as a repeated desmear process, and contrasting that alleged invention with the single-pass desmear process of the prior art. C.A.J.A. 1880. Respondent, however, argued that the claim terms should be construed independently from the specification, and that because the claims themselves do not contain express reference to a repeated desmear process, they encompass the single-pass desmear process that the patents criticize and distinguish. *Ibid.*; see also C.A.J.A. 2443-2444.

The district court agreed with petitioners, construing the terms to require that the surface, removal, or etching of the dielectric material be “produced by a repeated desmear process.” App. 26a; see App. 26a-39a. The court identified five passages from the specification that distinguish the invention from a single-pass desmear. App. 30a-33a; see pp. 7-8, *supra*. Those passages, the court explained, “make clear that the invention *does not* include the prior art’s single[-pass] desmear process.” App. 33a (emphasis added). The district court also relied on the specification’s description of “the present invention” as utilizing a repeated desmear. App. 33a-35a.

Because it was undisputed that petitioners do not use a repeated desmear process, the parties stipulated to a judgment of non-infringement based on the district court’s construction of the disputed claim terms. App. 21a-22a.

5. The Federal Circuit reversed the district court's claim construction and remanded for further proceedings. App. 1a-20a. At the outset, the court of appeals recited the well-established rule that claims are to be given their "ordinary and customary meaning" from the perspective of a skilled artisan, "look[ing] to sources including the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence." App. 11a (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-1313 (Fed. Cir. 2005) (en banc)) (internal quotation marks omitted).

In applying that approach to construe the claims at issue here, however, the Federal Circuit followed a two-step procedure. First, the court explained that it would "[b]egin[] with the claim language," and it observed that "none of the asserted claims actually recite a 'repeated desmear process.'" App. 12a-13a. For that reason, the court concluded that "at least based on the plain language, the claims are not limited to a repeated desmear process." *Ibid.*

Next, the Federal Circuit "continue[d] [its] analysis by reading the claims in view of the specification * * * ." App. 13a (quoting *Phillips*, 415 F.3d at 1315). The court explained that the specification may "reveal a special definition" of a claim term "other than its plain and ordinary meaning," or it may disclaim claim scope that would otherwise be contained within the ordinary meaning of the claim terms. *Ibid.* (citations omitted). In either case, the court stated, it may depart from the plain and ordinary meaning of the claim terms only if the specification contains "expressions of manifest exclusion or restriction" that rise to the level of a "clear and unmistakable disclaimer" of claim scope. *Id.* at 13a-14a (citation omitted).

Applying that heightened standard, the Federal Circuit concluded that “none of the statements” in the specification—not even its repeated assertions that “the present invention” involves a double desmear process, and its disparagement of the single desmear process—“rises to the level of ‘a clear and unmistakable disclaimer.’” App. 14a (citation omitted). For example, the court ruled that the specification’s statements “distinguishing the double desmear process as ‘contrary to’ or ‘in stark contrast’ with the single desmear process * * * are not clear and unmistakable limiting statements.” App. 15a (citation omitted). The court found that certain isolated phrases in the specification—in particular, the specification’s statement that “one technique for forming the teeth” is the double desmear process—kept the specification from “clearly limiting the claimed ‘electrical device’ to require a repeated desmear process.” *Id.* at 14a-15a (citations and alterations omitted). The court further reasoned that the specification’s “descriptions of ‘the present invention’ * * * are not limiting” because they “do not characterize the present invention ‘as a whole’” but rather “disclose one way to carry [it] out.” App. 16a (citations omitted).

Accordingly, the Federal Circuit reversed the district court’s claim construction and vacated the non-infringement judgment. App. 20a. Petitioners sought rehearing en banc. After calling for a response, the Federal Circuit denied the petition. App. 67a.

REASONS FOR GRANTING THE PETITION

Claim construction is fundamental to the patent system: in virtually every patent case, the court must construe the claims, and the resulting construction often determines both whether the patent has been infringed

and whether it is invalid. Yet the Federal Circuit is intractably divided on the basic method of claim construction, and the outcome of a case can turn on which of two conflicting approaches a particular Federal Circuit panel chooses to follow. While some Federal Circuit decisions properly adhere to the Patent Act's structure and this Court's instruction that the meaning of patent claims must be determined in light of the specification, *Schriber-Schroth*, 311 U.S. at 217, other decisions—like the decision below—erroneously employ a two-step approach that first determines the ordinary meaning of claim terms in isolation, and only then examines the specification, using a heightened standard requiring a “clear and unmistakable” disclaimer to overcome the court's presumptive construction. That method of construing claims improperly minimizes the specification and accords claims an unduly broad scope that is divorced from what the patentee has actually invented and described in the specification. This divergence in approach has persisted for more than a decade, and there is no reason to think it will be resolved without definitive guidance from this Court.

A. The decision below presents a longstanding intracircuit conflict regarding the role of patent specifications in claim construction.

The Federal Circuit has long been divided over the proper approach to claim construction. See, e.g., *University of Fla. Research Found., Inc. v. General Electric Co.*, No. 17-171, 2017 WL 5502940, at *2 (N.D. Fla. Nov. 16, 2017) (describing conflict); see also Greg Reilly, *Judicial Capacities and Patent Claim Construction*, 20 Mich. Telecom. & Tech. L. Rev. 243, 260-261 (2014) (describing

a “methodological split in the Federal Circuit’s claim construction jurisprudence”) (citation omitted). While many Federal Circuit decisions recite the high-level principle that a patent’s claims should be construed in light of the specification, App. 11a-12a, only one of the Federal Circuit’s two conflicting claim construction methods actually keeps faith with that principle by examining claim terms in light of the specification in the first instance. The other line of Federal Circuit authority, as exemplified in this case, improperly minimizes the specification’s role by determining the “ordinary” meaning of the claims in isolation and altering that meaning only when the specification contains statements that are sufficiently clear and unmistakable to overcome that meaning.

1. The decision below represents one of the Federal Circuit’s two competing approaches to claim construction. Under that approach, claim construction proceeds in two distinct steps.

The court first construes the claim terms without reference to the specification, determining their “ordinary and customary meaning” in isolation. App. 11a; see also, e.g., *Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012). These cases treat the description of the invention contained in the specification as irrelevant to the first step of claim construction. App. 13a (concluding that “based on the plain language, the claims are not limited to a repeated desmear process,” without considering the specification); see also, e.g., *Unwired Planet, LLC v. Apple Inc.*, 829 F.3d 1353, 1358 (2016).

The specification becomes relevant only at a second claim construction step, and only insofar as the specification might *overcome* the already-determined plain meaning of the claims. At the second step, the court decides whether either of two exceptions to the “ordinary and customary meaning” rule applies: namely, whether the patentee either (1) acted as its own lexicographer by “clearly set[ting] forth” in the specification an express definition of a term used in the claims, or (2) used “expressions of manifest exclusion or restriction” that “rise[]to the level of ‘a clear and unmistakable disclaimer’” of the full scope of a claim term. App. 13a-14a (quoting *Thorner*, 669 F.3d at 1367). These exceptions are narrow and exacting: the written description of the invention will be found to limit broader claim language only when “the specification [includes] ‘expressions of *manifest* exclusion or restriction, representing a *clear* disavowal of claim scope.’” App. 13a (citation omitted and emphases added); accord *Thorner*, 669 F.3d at 1365.

Federal Circuit decisions employing this approach effectively apply a presumption that the claim terms will be given their “ordinary” meaning, determined without reference to the specification, and they permit the written description to influence the construction of the claim terms only in rare cases. As a result, these decisions may accord claims a broad scope untethered to the actual invention.

This case provides a concrete example. Although the literal language of the patent claims is broad enough to cover both a single desmear and a repeated desmear process, the specification repeatedly disparaged the prior art’s single-pass desmear process and characterized “the present invention” as “differ[ing] from” that process in that the desmear steps “are repeated.” App.

91a. But the Federal Circuit did not even consider the specification until after it had already concluded that the claims, considered in isolation, were broad enough to include a single desmear process. In applying its second step, the court held that the specification's definition of "the present invention" and extensive disparagement of the single desmear process were irrelevant because they did not rise to the level of a "clear and unmistakable disclaimer" of claim scope. App. 14a.

Numerous other decisions take the same approach. See, e.g., *Unwired Planet*, 829 F.3d at 1358-1359 (construing "voice input" based on its ordinary meaning as not limited to an input via a communication "channel," even though specification described the invention as involving a channel, because the specification did not clearly disclaim the broader claim coverage); *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1372 (Fed. Cir. 2014) (construing "datalink" based on its plain meaning to include both wired and wireless links, even though specification described only a wired link and failed to enable a wireless link, because the specification contained no "words of manifest exclusion or restriction"); *Skedco, Inc. v. Strategic Operations, Inc.*, 685 F. App'x 956, 959 (Fed. Cir. 2017) (construing claims to have their plain meaning even though doing so rendered certain drawings in the specification nonsensical).

2. In a second line of cases, the Federal Circuit has adopted a single-step approach to claim construction, holding that claims must, from the beginning of the claim construction process, "be read in view of the specification, of which they are a part." *Forest Labs, LLC v. Sigmapharm Labs, LLC*, 918 F.3d 928, 933 (Fed. Cir. 2019). Under this approach, "the specification is *always* highly relevant to the claim construction analysis."

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). Indeed, the specification is typically “dispositive,” because “it is the single best guide to the meaning of a disputed term” in the claim. *Ibid.* Decisions applying this approach do precisely what the Federal Circuit refused to do in this case: analyze the specification to determine the meaning of claim terms without requiring the specification to contain a “clear and unmistakable” definition or disclaimer.

For instance, in *UltimatePointer, LLC v. Nintendo Co.*, 816 F.3d 816 (Fed. Cir. 2016), the court acknowledged that a claim to a “handheld pointing device” was broad enough to include both direct and indirect pointing devices. *Id.* at 818-819. But the specification described the invention as a direct-pointing system and emphasized that direct pointing is superior to indirect pointing. *Id.* at 823. Without applying the heightened “clear and unmistakable” disclaimer standard set forth in other cases, the Federal Circuit held that the specification’s discussion supported “the conclusion that the [claims are] limited to a direct-pointing device.” *Ibid.* The court further explained that limiting the claim terms to their “ordinary meaning,” uninformed by the specification, “would incorrectly require us to divorce the claim language from the repeated direct-pointing description and indirect-pointing criticism in the specification.” *Id.* at 824.

Many other decisions are to the same effect. See, e.g., *Forest Laboratories*, 918 F.3d at 932-933 (holding that claims directed to a pharmaceutical composition that did not “expressly refer to buccal or sublingual administration” nevertheless should be construed as limited to those features because the specification stated that

“[t]he invention relates to a sublingual or buccal pharmaceutical composition” and extolled “the benefits of sublingual and buccal treatment over the prior art”) (alteration in original); *Honeywell Int’l, Inc. v. ITT Indus. Inc.*, 452 F.3d 1312, 1317-1319 (Fed. Cir. 2006) (narrowing ordinary and customary meaning based on specification’s description of “the present invention”); *David Netzer Consulting Eng’r LLC v. Shell Oil Co.*, 824 F.3d 989, 993-997 (Fed. Cir. 2016) (limiting the claim term “fractionating” as narrower than its ordinary meaning of separating a mixture into fractions, to mean “separating compounds based on differences in boiling points” where the specification distinguished the “present invention” from other methods of extraction); *Kinetic Concepts, Inc. v. Blue Sky Med. Grp., Inc.*, 554 F.3d 1010, 1018-1019 (Fed. Cir. 2009) (construing the claim term “wound” not to include fistulae and “pus pockets” because “[a]ll of the examples described in the specification involve skin wounds,” and construing the term more expansively “would thus expand the scope of the claims far beyond anything described in the specification”).

3. These two approaches stand in stark contrast to each other, and which one a particular Federal Circuit panel adopts often dictates the result.

This case well illustrates how the construction of a claim term can turn entirely on which line of conflicting Federal Circuit precedent a particular panel decides to follow. Here, the Federal Circuit held that the specification’s description of “the present invention” as involving a repeated desmear process did not “clear[ly] and unmistakabl[y]” limit the claims because, in the court’s view, the specification simply expressed a *preference* for the repeated desmear process. App. 14a-15a (explaining

that the specification’s use of “phrases such as * * * ‘can be carried out’” suggested that methods other than the repeated desmear process can be used). Thus, the “clear and unmistakable” standard led the court to require unequivocal language in the specification.

By contrast, in cases that do not apply the “clear and unmistakable” standard, similar language in the specification can and does result in a different claim construction—despite the specification’s use of non-definitive phrases. In *Medicines Company v. Mylan, Inc.*, 853 F.3d 1296 (2017), for instance, the claims covered drug “batches” with a certain impurity level. The court construed the claims as limited to batches made by a particular “compounding process that achieves batch consistency.” *Id.* at 1303. The court relied in part on the specification’s statement that use of a compounding process that achieves consistent results “is desirable”—language that surely would not have constituted a “clear and unmistakable” disclaimer under the approach followed by the court below. *Id.* at 1304. And in *Aptalis Pharmatech, Inc. v. Apotex Inc.*, 718 F. App’x 965 (2018), in construing the claim term “coating,” the court acknowledged that the specification did not contain any lexicological definition of the term, and that the prosecution history did not contain a “clear and unmistakable disavowal of claim scope.” *Id.* at 968. Nonetheless, the court construed the term in light of the specification as limited to a “continuous outer film”—despite the existence of some countervailing language in the specification that “give[s] us pause.” *Id.* at 969 & n.4.

4. For more than a decade, the Federal Circuit has been unable to resolve this split in its jurisprudence. In 2005, the court granted rehearing en banc in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005), in an attempt

to resolve the conflicting approaches discussed above. There, the court held that claim language should be given its “ordinary meaning * * * as understood by a person of skill in the art” in light of the specification and prosecution history. *Id.* at 1314. The court also stated that certain of its decisions had placed too much reliance on dictionaries as a source of a claim’s ordinary meaning. *Id.* at 1320. In the course of that discussion, the court stated that first determining the plain meaning of the claims using a dictionary would place “too little” reliance on the specification, improperly “limit[ing] the role of the specification in claim construction to serving as a check on the dictionary meaning of a claim term.” *Ibid.* But at the same time, the court made other statements that seemed to point the other way. See, e.g., *id.* at 1312 (emphasizing that claim terms should be given their “ordinary and customary” meaning); *id.* at 1314 (“In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words”). As a result, *Phillips*’ discussion has had little practical effect on subsequent panel decisions. See, e.g., *Thorner*, 669 F.3d at 1367. As the Federal Circuit’s decision in this case and the many post-*Phillips* decisions cited above show, some Federal Circuit panels have not understood *Phillips* to disavow the two-step approach, and they continue to adhere to the “clear and unmistakable” standard.

Thus, as leading commentators have recognized, “claim construction remains ‘as divided today as before *Phillips*.’” Oskar Liivak, *The Unresolved Interpretive Ambiguity of Patent Claims*, 49 U.C. Davis L. Rev. 1851,

1859 (2016); see also 5A *Chisum on Patents* § 18.03 (2019) (noting that *Phillips* failed to “quell the divergent approaches of Federal Circuit judges toward the relative importance of the ‘ordinary’ meaning of claim language and of the specification disclosure of an invention”); Andrew B. Dzeguze, *Did Markman and Phillips Answer the Right Question? A Review of the Fractured State of Claim Construction Law and the Potential Use of Equity to Unify It*, 15 *Tex. Intell. Prop. L.J.* 457, 482 (2007) (“The cases applying *Phillips* have proven every bit as fractured as the prior jurisprudence.”). In fact, one empirical analysis suggests that “the rate of disagreement” among Federal Circuit judges concerning claim construction analysis has *risen* since *Phillips*. R. Polk Wagner & Lee Petherbridge, *Did Phillips Change Anything? Empirical Analysis of the Federal Circuit’s Claim Construction Jurisprudence*, in *Intellectual Property & the Common Law* 123, 146 (Shyamkrishna Balganesh ed., 2013). This Court’s intervention is therefore necessary to resolve the enduring conflict in the Federal Circuit’s claim construction jurisprudence.

B. The decision below is incorrect.

The Federal Circuit’s two-step claim construction methodology is inconsistent with this Court’s precedent and the text and history of the Patent Act. The Court should reject it and reaffirm the “fundamental” rule that claims are always “to be construed in the light of the specification[.]” *Adams*, 383 U.S. at 49.

1. Claim construction should entail a single step: ascertaining the scope of claims in light of the specification.

a. The Federal Circuit’s two-step approach accords insufficient weight to the specification, and in many cases has the practical effect of disregarding the specification entirely. The initial step of construing claims according to their “plain and ordinary meaning” *without* considering the specification often produces an interpretation that is entirely divorced from the invention described in the specification. Then, at the second step, the court considers the specification only through the lens of a “heavy presumption” that the claim terms should be given the plain meaning that the court has accorded to them in isolation. *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003). The upshot is that claims may often be given a scope that is broader than what a skilled artisan would understand to be the invention described in the written description.

That approach cannot be reconciled with this Court’s instruction that “[t]he claims of a patent are *always* to be read or interpreted in the light of its specifications.” *Schriber-Schroth*, 311 U.S. at 217 (emphasis added); see also *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996) (claim construction entails an “analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole”). That principle dates back to the Patent Act’s addition of claims to the patent document in 1836. See *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1853) (“The claim * * * is not to be taken alone, but in connection with the specification and drawings; the whole instrument is to be

construed together.”); see also *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917); *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 432 (1902); cf. *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 482 (1848). Taken together, these cases establish a fundamental canon in claim construction: the specification provides critical context for understanding the claim language and determining its scope.

United States v. Adams, 383 U.S. at 39, offers a clear application of this interpretive principle. There, the Court considered a patent related to a wet battery, which the specification explained “may be * * * rendered serviceable by merely filling the [battery] container with water.” *Id.* at 42. The Court explained that “it is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.” *Id.* at 49. Accordingly, the Court held that although the claims did “not mention a water electrolyte,” they nevertheless should be construed as so limited because the “stated object of the invention,” as articulated by the specification, “was to provide a battery rendered serviceable by the mere addition of water.” *Id.* at 48. Federal Circuit decisions that disregard the specification in determining the “ordinary and customary meaning” of the claims are thus inconsistent with this Court’s approach in *Adams*.

b. The Federal Circuit’s two-step approach is also at odds with the text of the Patent Act, which requires construing a patent’s claims in the context of—and as limited by—the written description. The Act accords patent protection to a disclosed “invention.” 35 U.S.C. § 154(a). Section 112 requires that the “specification * * * contain a written description of the invention, and of the manner and process of making and using it, in such full,

clear, concise, and exact terms as to enable any person skilled in the art to which it pertains * * * to make and use the same.” 35 U.S.C. § 112 (2006). It also provides that “[t]he specification shall conclude with one or more claims particularly *pointing out* and distinctly claiming the subject matter which the applicant regards as his invention.” *Ibid.* (emphasis added).

The statutory text confirms that the claims are referential rather than independent. The claims establish the boundaries of the monopoly protection granted by the patent by “pointing out” precisely what in the written description constitutes the invention that the patentee has disclosed to the public. Because the Patent Act requires that the claims refer to the written description, construction of those claims necessarily requires reading them in light of the written description and the invention itself. That is why this Court has concluded that “[t]he claim of a patent must always be explained by and read in connection with the specification.” *Carnegie Steel*, 185 U.S. at 432.

The history of the Patent Act confirms the central importance of the specification in construing claims. The earliest versions of the Act did not require that a patent contain discrete claims at all; the equivalent of the current written description both disclosed the invention and distinguished it from the prior art. Patent Act of 1793, ch. 11, sec. 3, 1 Stat. 318, 321. In those early days, “it was the *specification* * * * that represented the key to the patent.” *Markman*, 517 U.S. at 379 (emphasis added). Eventually, patent drafters began breaking out a distinct statement of the novel features of the claimed invention in order to better distinguish between the invention claimed by the patentee and the description of the prior art. Karl B. Lutz, *Evolution of the Claims of*

U.S. Patents, 20 J. Pat. Off. Soc’y 134, 139-141 (1938); Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction?*, 157 U. Pa. L. Rev. 1743, 1767 (2009). The Patent Act of 1836 codified this practice, requiring that an applicant “particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.” Ch. 357, sec. 6, 5 Stat. 117, 119. Congress has retained the requirement of “claiming” ever since. But the requirement of distinct claims was created as a complement to, not a substitute for, the detailed specification. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 902 (2014); see also 35 U.S.C. § 112.

This history affirms the critical role of the specification in claim construction. As originally codified, claims “served merely to call attention to * * * the salient features of [an] invention. The drawings and description were the main thing, the claims a mere adjunct thereto.” Ridsdale Ellis, *Patent Claims* § 3 (1949). Because the claims simply identify what in the written description constitutes the invention subject to patent protection, claims must be “construed in the light of the specifications * * * with a view to ascertaining the invention.” *Adams*, 383 U.S. at 49. The Federal Circuit’s decisions holding that courts should ascertain the invention’s subject matter in the first instance without consulting the specification is inconsistent with the claims’ historical role.

2. Because the Federal Circuit used an incorrect method of claim construction, it erroneously construed the claims.

The Federal Circuit’s use of the two-step claim construction method led it to erroneously construe the

claims at issue here far more broadly than the actual alleged invention described in the specification.

The specification leaves no doubt that the scope of the claimed invention is a repeated desmear process. The specification states that “the present invention” uses a repeated desmear process. It goes on to explain that the repeated desmear process is “contrary to” and “in stark contrast” with the prior art, which involved a single-pass desmear process. See, *e.g.*, App. 91a (“[T]he present invention differs from the common desmear process in that sub-steps in the desmear process are repeated[.]”); App. 88a (“Accordingly the peel strength produced in accordance with the present invention is greater than the peel strength produced by the desmear process of the prior art, *i.e.*, a single pass desmear process.”). Indeed, the specification states that “the desmear process * * * disclosed herein is * * * a ‘*double desmear process*,’ rather than the single desmear process” that characterized the prior art. App. 85a (emphasis added). A skilled artisan, reading the claims’ references to “etching” and similar terms in light of the specification, would have understood the etching to be produced by a repeated desmear process. As the specification made clear, a substrate created using that process is the *invention*—*i.e.*, the innovation of the claims over the single desmear process in the prior art.

The Federal Circuit, however, viewed the specification’s repeated statements as insufficiently clear to overcome the claims’ failure to mention a single desmear process. Because the court required the written description to contain a “clear and unmistakable” disclaimer of a single desmear process, the court did not evaluate the written description as a whole to determine how a skilled artisan would understand the scope of the claims

in light of the written description. Instead, the court focused on isolated phrases in the specification that, in its view, undermined the clarity of the specification's repeated statements that the "present invention" involves a double desmear process. For instance, the court relied on the specification's statement that "one technique" for forming the teeth is the double desmear process, inferring that using a repeated desmear process may be only one way to take the invention. App. 15a. But as the district court explained, that statement simply introduces the double desmear process, and the detailed description that follows "explain[s] at length the difference between the current invention and the prior art single desmear process." App. 37a-38a.

The court of appeals then held that the specification's statements "distinguishing the double desmear process as 'contrary to' or 'in stark contrast' with the single desmear process" of the prior art were "not clear and unmistakable limiting statements." App. 15a. But a primary purpose of the specification is to distinguish the invention from the prior art. There is no doubt that a skilled artisan would read the claims in light of the express distinctions explained in the specification. The Federal Circuit's requirement of a "clear and unmistakable" disclaimer thus resulted in an incorrect, overly broad construction of the claims that permitted the patentee to capture much broader subject matter than a skilled artisan would understand it to have invented.

C. The question presented is exceptionally important and warrants review in this case.

1. The question presented is of paramount importance to the patent system. The interpretive paradigm of the Federal Circuit authority that this case exemplifies systematically skews claim construction by interpreting claims broadly and in the abstract, even if the fairest reading of the claim “in connection with the specification and drawings” indicates that a narrower construction is needed to capture the actual bounds of the disclosed invention. *Brooks*, 56 U.S. (15 How.) at 215; see *Phillips*, 415 F.3d at 1321 (“[S]tart[ing] with the broad dictionary definition in every case and fail[ing] to fully appreciate how the specification implicitly limits that definition * * * will systematically cause the construction of the claim to be unduly expansive.”); Greg Reilly, *Patent “Trolls” And Claim Construction*, 91 Notre Dame L. Rev. 1045, 1061 (2016) (“[M]ov[ing] the claim term’s meaning from the context of the patent to the abstract, * * * will naturally expand the potential claim scope.”).

That approach is contrary to the fundamental principle that inventors should receive protection only for what they have actually invented. *United States v. Masonite Corp.*, 316 U.S. 265, 277 (1942) (“[T]he public policy which includes inventions within the granted monopoly excludes from it all that is not embraced in the invention.”); see also *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 12 (1946). As this Court has recognized, “patent applicants face powerful incentives to inject ambiguity into their claims” by drafting them to cover far more than what the inventor actually invented. *Nautilus*, 572 U.S. at 910; see also FTC, *The*

Evolving IP Marketplace: Aligning Patent Notice And Remedies With Competition 85 (2011)⁵ (“FTC Report”) (describing evidence that the patent system fosters “an incentive to be as vague and ambiguous as you can with your claims” and “defer clarity at all costs” (citations omitted)). The two-step approach followed by the Federal Circuit in this case makes that problem worse. By prioritizing the “plain” meaning of the claims in isolation, this approach allows inventors to claim monopoly protection that is much broader than the *actual* inventions they create and disclose to the public.⁶

Giving claims broad coverage detached from limits in the specification impedes innovation. When claims are read independently from the rest of the specification, patentees can argue that infringement exists with respect to products or methods that go far beyond the invention disclosed in the patent. Burk, *supra*, 157 U. Pa. L. Rev. at 1753 (applicants may not “specify what they mean by

⁵ Available at <https://www.ftc.gov/sites/default/files/documents/reports/evolving-ip-marketplace-aligning-patent-notice-and-remedies-competition-report-federal-trade/110307patentreport.pdf>.

⁶ This case well illustrates the problem. After the parent application had been filed (and the written description drafted), the prosecuting attorney bought the patent rights and drafted continuation patents with additional claims—including those at issue in this case—that were broader than the invention described in the specification. The claims do not expressly reference the use of a repeated desmear process, but the patent examiner would have read those claims in light of the invention described in the specification, see 37 C.F.R. § 1.75(d)(1). The patentee then selectively asserted these broad claims, arguing that they covered even the use of the single-pass desmear process that the specification expressly criticized, distinguished, and purported to improve upon.

ambiguous technical [claim] language * * * because they intend to exploit the ambiguity in obtaining or enforcing the patent”).

That problem is particularly acute in numerous areas of technology in which successive product generations improve incrementally, as a single new product may potentially implicate hundreds or even thousands of patents. The possibility that a court will construe claims more broadly than the specification would indicate chills competition by creating “a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims.” *Nautilus*, 572 U.S. at 909-910 (citation, internal quotation marks, and alterations omitted); *Markman*, 517 U.S. at 390. And it increases uncertainty about the scope that claims will be accorded in any infringement litigation. When claim construction rests on divining the “ordinary” meaning of claim terms in the abstract, parties can cite a variety of sources external to the patent that are not specifically aimed at the particular alleged invention, such as dictionaries or common usage unrelated to the field of the invention. Reilly, *supra*, 91 Notre Dame L. Rev. at 1061. The result is variability and unpredictability: a third party cannot know how a particular judge or appellate panel will characterize the “ordinary” meaning of the claims, or what extrinsic sources will be used. FTC Report 102.

By contrast, a rule requiring claims to be construed as limited by the written description promotes predictability because, as the FTC has explained, “[a] third party seeking to understand a claim’s meaning can view the intrinsic evidence,”—*i.e.*, the specification and prosecution history. *Ibid.* But because of the conflict within the

Federal Circuit’s claim construction jurisprudence, litigants cannot know in advance which approach the court will employ. District courts cannot be certain which line of cases to follow, and the rights and liabilities of litigants unfairly turn on the particular Federal Circuit panel hearing their cases. This Court’s review is therefore warranted to promote uniformity in the Federal Circuit’s claim construction methodology and to ensure that claims are construed only to cover what the patentee actually invented.

2. This case presents a suitable vehicle for the Court to address the proper method of claim construction. The only issue on appeal was whether the claims were limited to the invention disclosed in the specification. The parties’ proposed constructions cleanly embody the two competing strands in the Federal Circuit’s cases, and the Federal Circuit expressly based its decision in this case on its application of the two-step process in which the specification is consulted only after the meaning of the claim is determined in isolation. App. 17a (after concluding that the claims literally encompassed a single-desmear process, concluding that the statements in the specification “do not meet the ‘exacting’ standard required to limit the scope of the claims to a repeated desmear process”).⁷ As demonstrated above, if the panel

⁷ The Federal Circuit’s claim construction in this case is final, and thus this Court’s review is appropriate at this time. While the Federal Circuit remanded for further proceedings in light of its altered claim construction, that is no reason not to decide this important issue now. The procedural posture here is analogous to a court of appeals’ reversal of a grant of summary judgment or a motion to dismiss, a posture in which this Court regularly reviews cases. See, e.g., *Intel Corp. Inv. Policy Comm. v. Sulyma*,

had taken the approach consistent with the statutory requirements and this Court's precedent (and employed by the Federal Circuit in numerous other cases)—construing the claims in light of the specification and with a view to ascertaining the invention—it would have held that the claims require use of a repeated desmear process. See pp. 24-26, *supra*.

* * *

The proper standard for claim construction is an issue of critical importance to the patent system. As both Congress and this Court have recognized, it is fundamental to the patent bargain that the monopoly protected by a patent's claims be commensurate with what its inventors disclose to the public as their invention in the specification. The two-step process that the Federal Circuit applied in this and other cases is a clear departure from the Patent Act and this Court's precedent, thereby undermining the patent bargain and harming the public interest. This harm is magnified by the Federal Circuit's internal inconsistencies, which only exacerbate the public's uncertainty as to the meaning of patents. This Court should grant certiorari to remedy that uncertainty by restoring patent specifications to their proper, coequal role in claim construction.

No. 18-1116 (cert. granted June 10, 2019); *Manhattan Cmty. Access Corp. v. Halleck*, 139 S. Ct. 1921, 1927 (2019); *Nieves v. Bartlett*, 139 S. Ct. 1715, 1721 (2019); *Beard v. Banks*, 548 U.S. 521, 528 (2006); *Air Line Pilots Ass'n, Int'l v. O'Neill*, 499 U.S. 65, 73 (1991). Claim construction arises at a threshold stage in every patent case, and the dispute over the proper legal standard for claim construction will not change while this case is on remand.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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