

No. 20-1545

In the Supreme Court of the United States

TCL COMMUNICATION TECHNOLOGY HOLDINGS,
LIMITED, TCT MOBILE LIMITED, TCT MOBILE (US)
INC., PETITIONERS

v.

GODO KAISHA IP BRIDGE 1

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

BRIEF FOR GODO KAISHA IP BRIDGE 1 IN OPPOSITION

STEVEN PEPE
KEVIN J. POST
ROPES & GRAY LLP
1211 Avenue of the
Americas
New York, NY 10036

SAMUEL L. BRENNER
ROPES & GRAY LLP
Prudential Tower
800 Boylston Street
Boston, MA 02199

DOUGLAS HALLWARD-DRIEMEIER
Counsel of Record

QUINN WALKER
ROPES & GRAY LLP
2099 Pennsylvania Avenue, NW
Washington, DC 20006
(202) 508-4600

*Douglas.Hallward-Driemeier
@ropesgray.com*

JAMES R. BATCHELDER
SHONG YIN
ROPES & GRAY LLP
1900 University Avenue
6th Floor
East Palo Alto, CA 94303

QUESTION PRESENTED

In *Markman v. Westview Instruments, Inc.*, this Court held that patent infringement cases “must be tried to a jury,” whose role is to “answer[] the ultimate question of infringement.” 517 U.S. 370, 377, 385 (1996) (citing *Bischoff v. Whethered*, 76 U.S. (9 Wall.) 812, 814 (1869)). After the trial court construes the patent’s terms, which is a question of law, the jury determines whether the accused product infringes, which is a question of fact, by comparing that product to the patent claim’s limitations. In the case of so-called “standard essential patents,” the Federal Circuit has long recognized that the factfinder may undertake that comparison in two steps: first, comparing the claim limitations to an industry standard to determine whether practicing the standard *necessarily* meets the claim’s terms; and second, if so, comparing the accused product to the industry standard to determine if it practices the standard, and therefore necessarily practices the claims. In this case, after the district court construed disputed claim terms in *Markman* proceedings, the jury heard extensive expert evidence that mandatory portions of the industry standard require practicing each limitation of the asserted claims, and that the accused products comply with the standard. Petitioner offered no contrary evidence, and the jury found the claims infringed. The question presented is therefore:

Whether the court of appeals correctly held, consistent with this Court’s instruction in *Markman v. Westview Instruments, Inc.*, that it is the province of the jury to determine whether an accused product infringes the claims of an asserted patent.

CORPORATE DISCLOSURE STATEMENT

Respondent Godo Kaisha IP Bridge 1 respectfully states its parent corporation is IP Bridge, Inc. and no publicly held corporation owns 10% or more of its stock.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 60a-69a) is reported at 967 F.3d 1380. The district court's opinions on respondent's post-trial motion (Pet. App. 31a-49a) and petitioners' post-trial motion (Pet. App. 50a-59a) are unreported, but are available at 2019 WL 1877189 and 2019 WL 1879984, respectively.

JURISDICTION

The court of appeals issued its opinion (Pet. App. 60a-69a) on August 4, 2020. The court denied a timely petition for rehearing on December 4, 2020 (Pet. App. 70a). The petition for a writ of certiorari was filed on May 3, 2021. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

(1)

INTRODUCTION

Petitioners TCL Communication Technology Holdings Limited, TCT Mobile Ltd., and TCT Mobile (US) Inc. (collectively, TCL) do not present any issue that warrants review, or even that is genuinely presented by this case, because the Petition rests on mischaracterizations of what happened at trial, what role the district court played, and what the Federal Circuit held.

To prove patent infringement, a patent owner must prove that every element of the asserted claim is present in the accused device. The court is charged with construing those claim elements as a legal matter pursuant to this Court's directive in *Markman*, but once that is done, infringement is a factual determination that the jury makes, based on a comparison of the claim terms to the accused product.

The patent claims at issue here are essential to a technical standard for cell phones known as "LTE." A claim is "standard-essential" if it is necessary to practice every element of the claim in order to comply with (*i.e.*, practice) the standard. In the context of such standard-essential patents (SEPs), the Federal Circuit has long "endorsed standard compliance as a way of proving infringement." Pet. App. 64a.

To find infringement in this fashion, the jury first "compar[es] the claims to that standard," which "is the same as comparing the claims to the accused product." Pet. App. 66a. If the asserted claims "cover[] every possible implementation of [that] standard," *and* the jury further finds that the "accused product operates in accordance with a standard," then the jury has made the necessary predicate factual findings to support an

ultimate finding of infringement. *Ibid.* (quoting *Fujitsu Ltd. v. Netgear Inc.*, 620 F.3d 1321, 1327-1328 (Fed. Cir. 2010)). As the Federal Circuit has explained, “[b]ecause the standard *requires* that devices utilize specific technology, compliant devices *necessarily* infringe certain claims in patents that cover technology incorporated into the standard.” *Ericsson, Inc. v. D-Link Sys., Inc.*, 773 F.3d 1201, 1209 (2014).

Here, after a seven-day trial, the jury applied precisely this methodology to find that TCL infringes two of respondent’s patents. IP Bridge proved at trial, through extensive evidence and expert testimony, both “that: (1) the patent claims are essential to mandatory aspects of the Long-Term Evolution (‘LTE’) standard; and (2) the accused products practice that standard.” Pet. App. 61a. Indeed, “TCL did not present evidence to counter that showing.” *Id.* at 55a, 62a, 69a n.2. The district court instructed the jury that it was required to “compare the Accused Products with each and every one of the requirements of a claim to determine whether the requirements of that claim are met.” *Id.* at 54a. Having heard all the evidence and this charge, the jury found infringement.

Proving infringement in the standard-essential context through this two-step approach is thus not a “shortcut,” as TCL asserts (Pet. 16), but a logically rigorous method that ensures that a patentee proves, and the jury finds, that the accused device practices each and every limitation of the asserted claims.

Neither of the two questions on which the Petition seeks review accurately reflects what happened below or what the court of appeals held. For example, TCL’s

first Question frames the issue as whether “a patentee may prove literal infringement by relying *solely* on the essentiality of its patent to an industry standard.” Pet. i. But IP Bridge did no such thing—and the court of appeals never held that would suffice. Rather, IP Bridge presented substantial evidence not only that the claims were essential to mandatory portions of the LTE standard, but *also* that each accused product complied with (and practiced) that standard. IP Bridge thus presented substantial evidence that each accused product also practiced the limitations of the asserted claims.

TCL’s second Question is premised on the mischaracterization that the jury, rather than the court, engaged in claim construction in violation of this Court’s holding in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Not so. Instead, *after* the district court construed the claims in a standard *Markman* proceeding, the court submitted to the jury the quintessential factual question whether IP Bridge had proven infringement, employing the long-endorsed two-step process for SEPs. The Federal Circuit appropriately found “no error in the submission of these questions to the jury in the context of an infringement trial.” Pet. App. 61a. That holding is entirely in line with *Markman*’s clear directive that the *jury*, and not the court, answer “the ultimate question of infringement.” 517 U.S. at 377, 385.

The Petition should be denied.

STATEMENT

I. BACKGROUND

A. The Standards-Setting Context

Industry and technical standards, such as WiFi, Bluetooth, or (as in this case) 4G/LTE, ensure that products manufactured by different companies will work together, regardless of who manufactured them. In other words, any cellular phone that complies with the LTE standard will be able to talk to any cellular base station that also complies with that standard. Standards lower costs by increasing product manufacturing volume, and increase price competition by eliminating switching costs for consumers. Standards can have both “mandatory” and “optional” portions. When a product “complies” with a standard, that product necessarily practices all mandatory portions of the standard.

To create standards, interested parties come together in voluntary, non-governmental “standard-setting organizations,” or “SSOs,” such as the European Telecommunications Standards Institute (ETSI). Those interested parties include industry participants that want to have their technology incorporated into the standard. When that happens, such industry participants can enjoy significant potential benefits, including enhanced reputation and greater familiarity with how to design products to comply with the ultimate standards.

To make it easier for all companies to practice these standards, and ensure that standards are adopted as widely as possible, SSOs generally seek commit-

ments from owners of patents that are essential to the standard and who participated in setting the standard to license those patents to *everyone* on “Fair, Reasonable, and Non-Discriminatory” (FRAND) terms. Patents that are essential to a standard (in that they must be practiced to accomplish that standard) are called “standard essential patents,” or “SEPs.” Such patents can be essential either to mandatory or optional portions of a standard.

The original owner of the two Asserted Patents at issue here participated in the LTE standard-setting process, and made FRAND commitments for both patents.

B. The Federal Circuit’s Long-Standing Rule Allowing Use of Standard Compliance as a Way for the Jury to Find Infringement

For nearly two decades, in cases involving standard essential patents, the Federal Circuit has “endorsed standard compliance as a way of proving infringement.” Pet. App. 64a (citing *Ericsson, Inc. v. D-Link Sys., Inc.*, 773 F.3d 1201, 1209 (Fed. Cir. 2014); *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263 (Fed. Cir. 2004)). In *Ericsson*, the Federal Circuit explained that, “[b]ecause the standard *requires* that devices utilize specific technology, compliant devices *necessarily* infringe certain claims in patents that cover technology incorporated into the standard.” 773 F.3d at 1209. In *Fujitsu*, and again in this case, the Federal Circuit made clear that “if an accused product operates in accordance with a[n] [industry] standard,” and if the asserted claims “cover[] every possible implementation of [that] standard,” “then comparing the

[asserted] claims to that standard *is the same as* comparing the claims to the accused product.” *Fujitsu Ltd. v. Netgear Inc.*, 620 F.3d 1321, 1327-1328 (2010) (emphasis added); see also Pet. App. 65a-67a. And, since at least its *Dynacore* decision in 2004, the Federal Circuit has made clear that, just as comparing the claims to the accused product is a question of fact, the “standard-essentiality of patent claims is a fact issue” properly addressed by the factfinder. See Pet. App. 68a.

II. THE CASE

A. The Case in the District of Delaware

After a seven-day trial, the jury found that the accused TCL LTE products infringe claims 9 and 12 of U.S. Patent No. 8,385,239 and claims 15 and 16 of U.S. Patent No. 8,351,538 (the “Asserted Claims” of the “Asserted Patents”). These patents are directed to important technical aspects of how mobile devices, such as smartphones, connect to and communicate with base stations, such as cell towers, in LTE cellular networks. These patents are, in fact, essential to mandatory portions of the 4G/LTE standard as promulgated by ETSI, as IP Bridge established at trial. TCL sells dozens of mobile phone models that it advertises as complying with that standard.

Over a year before trial, the district court conducted a standard *Markman* proceeding: the parties exchanged proposed terms for construction and provided the court with extensive briefs, and the court held oral argument. See Pet. App. 4a-28a. Ultimately, the court construed multiple terms from the Asserted Claims. At trial, the parties’ experts then testified about whether every element of these claims, *as they were*

construed by the court, was present in the Accused Devices.

At trial, as the district court observed, IP Bridge’s expert, Dr. Min “testified that: (1) the asserted claims are essential to mandatory (not optional) functionality of the LTE standard (i.e., functionality that must be performed by any device that complies with the LTE standard); and (2) the accused products comply with the LTE standard.” Pet. App. 55a.

With respect to the first prong of this framework, as the district court explained, “Dr. Min identified mandatory requirements of the LTE standard and explained how the mandatory portions relate to and practice the elements of the asserted claims.” Pet. App. 55a. “In essence,” the district court added, “he testified that if functionality is mandatory, a device that is capable of connecting to an LTE network must have that functionality and explained that there is no way to implement the LTE standard without practicing each of the asserted claims.” *Ibid.*

With respect to the second prong of this framework, Dr. Min explained that the Accused Products comply with the LTE standard, and, given his finding in prong 1, thus necessarily infringe the Asserted Claims. In making this compliance determination, the district court noted, Dr. Min testified “that he analyzed extensive TCL documents, including user manuals, compliance matrices, certificates of compliance, and source code, to determine that the accused products practice the LTE standard.” Pet. App. 55a. As the district court noted, “TCL did not present any evidence to

counter [Dr. Min's] showing" that both prongs of the test were satisfied. *Ibid.*

And as the district court further observed, prior to submitting the case to the jury, the court explicitly instructed the jury to "compare the Accused Products with each and every one of the requirements of a claim [and] determine whether the requirements are met." Pet. App. 54a. The jury, having considered all of this evidence and the court's instructions, ultimately found all Asserted Claims valid and infringed, and awarded IP Bridge damages. *Id.* at 31a-32a. The parties then filed post-trial motions. Among other things, TCL's post-trial motion sought to overturn the jury's infringement finding. Relevant to this Petition, the district court denied TCL's JMOL motion, declining to "supplant the jury's determinations of credibility," and finding that substantial evidence supported the jury's verdict. *Id.* at 56a.

B. TCL's Appeal to the Federal Circuit

TCL appealed the district court's JMOL finding regarding infringement. The Federal Circuit found "no error in the submission of" questions about essentiality and compliance "to the jury in the context of an infringement trial." Pet. App. 61a. Like the district court, the Federal Circuit also held that the jury's verdict was supported by substantial evidence. See *id.* at 69a.

The Federal Circuit rejected TCL's contention that comparing the standard to the claim language, to determine the factual question of whether practicing the standard would necessarily meet each of the claim's limitations, must be done by a court during claim con-

struction. The Federal Circuit held that it is appropriate for the jury to make this determination as part of assessing whether the accused products practice every element of the construed claims. Pet. App. 68a-69a. As the Federal Circuit explained, “[w]e agree with IP Bridge that standard-essentiality is a question for the factfinder.” *Id.* at 65a.

In discussing the substantial evidence underlying the jury verdict, the Federal Circuit observed, as the district had before it, that at trial, to prove infringement, “IP Bridge put forth evidence to demonstrate that (1) the asserted claims are essential to mandatory sections of the LTE standard; and (2) the accused products comply with the LTE standard.” Pet. App. 62a. In doing so, the Federal Circuit added, “IP Bridge’s expert [Dr. Min] testified at length about how each claim limitation is present in mandatory portions of the LTE standard and how TCL’s LTE standard-compliant devices practice mandatory portions of the standard.” *Id.* at 68a n.1. The court of appeals then concluded that “TCL’s own documents and marketing materials make clear that its products are standard-compliant—a conclusion TCL does not refute on appeal. And the jury was free to credit IP Bridge’s substantial expert evidence that IP Bridge’s patent claims are essential to mandatory portions of the standard.” *Id.* in 69a n.2.

REASONS FOR DENYING THE PETITION**I. THE QUESTIONS PRESENTED DO NOT WARRANT THIS COURT'S CONSIDERATION****A. TCL's First "Question Presented" Does Not Warrant Review Because It Does Not Reflect the Federal Circuit's Holding**

TCL's first Question Presented does not warrant this Court's consideration because it does not reflect what the Federal Circuit (or any court) has ever held.

The underlying premise of TCL's first Question is that the Federal Circuit supposedly "condoned a decision permitting the jury to rely *entirely* on the existence of the LTE standard to prove infringement." Pet. 5 (emphasis added). Indeed, TCL suggests that IP Bridge proved infringement by (as the Question says) "relying *solely* on the essentiality of its patent to an industry standard." *Id.* at i.

But IP Bridge did no such thing—and thus the Federal Circuit's holding does not reflect what TCL challenges through this Question. Instead, the Federal Circuit found (as had the district court) that there was substantial evidence supporting the jury verdict where "IP Bridge's expert testified at length about how each claim limitation is present in mandatory portions of the LTE standard *and* how TCL's LTE standard-compliant devices practice mandatory portions of the standard." Pet. App. 68a & n.1 (emphasis added); *id.* at 69a. As the Federal Circuit further noted, "TCL did not present evidence to counter that showing." *Id.* at 62a. In finding that the jury's infringement verdict was "fully support[ed]" by substantial evidence, moreover,

the court of appeals noted that, with respect to the critical second prong of this analysis—which TCL’s Question ignores entirely—“TCL’s own documents and marketing materials make clear that its products are standard-compliant—a conclusion TCL does not refute on appeal.” *Id.* at 69a & n.2.

B. TCL’s Second “Question Presented” Similarly Does Not Warrant Review Because There Is No Conflict With Supreme Court Precedent or Any Policy Concern

1. *Contrary to TCL’s Suggestion, There Is No Conflict With Supreme Court Precedent*

TCL’s second Question Presented similarly does not warrant this Court’s consideration, because it too does not reflect what the Federal Circuit held. And, contrary to TCL’s suggestion (*e.g.*, Pet. 2), nothing in either *Markman* or *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318 (2015), or any other decision of this Court, conflicts with the Federal Circuit’s opinion here. As such, there is no conflict that requires this Court’s review.

As the Federal Circuit noted, its decision in this case was in accord with its long-standing precedent holding that a patent owner may demonstrate infringement through the appropriate use of standard compliance. Pet. App. 64a. As the court explained, the Federal Circuit has repeatedly “endorsed standard compliance as a way of proving infringement.” *Ibid* (citing *Ericsson, Inc. v. D-Link Sys., Inc.*, 773 F.3d 1201, 1209 (Fed. Cir. 2014); *Dynacore Holdings Corp. v. U.S. Philips Corp.*, 363 F.3d 1263 (Fed. Cir. 2004)). That is because, in order to find infringement through

standard compliance, the jury must necessarily find that every element of the claim is present in the accused device. Again, as the Federal Circuit observed in *Ericsson*, “[b]ecause the standard *requires* that devices utilize specific technology, compliant devices *necessarily* infringe certain claims in patents that cover technology incorporated into the standard.” 773 F.3d at 1209; see also *Dynacore*, 363 F.3d at 1266-1267. To summarize: “if an accused product operates in accordance with a[n] [industry] standard, then comparing the [asserted] claims to that standard *is the same as* comparing the claims to the accused product” if the asserted claims “cover[] every possible implementation of [that] standard.” *Fujitsu Ltd. v. Netgear Inc.*, 620 F.3d 1321, 1327-1328 (Fed. Cir. 2010) (emphasis added); Pet. 9.

In this case, the Federal Circuit appropriately found that the district court did not err in submitting to the jury the factual questions of whether practicing the standard would necessarily meet each of the claims’ limitations and whether the accused products practice the standard. Pet. App. 61a, 68a. In arguing otherwise, TCL mischaracterizes both *Markman*’s holding and (as the Federal Circuit correctly recognized) what actually happened at trial.

For example, TCL’s argument (Pet. 14) that, under *Markman*, only a court, rather than a jury, can engage in a “comparison of written instruments” (such as the patent claims and the standard) is incorrect. TCL’s argument would mean that only courts, and not juries, could ever analyze written documentation. But *Markman* did not hold that factfinders cannot consider written documents. Indeed, saying so would be nonsensical—this is precisely what patent juries do when con-

sidering whether a prior art reference anticipates a patent claim or whether a product infringes by determining that the construed claims read on a product manual and that the products work as the manual describes. *E.g.*, *Core Wireless Licensing S.A.R.L. v. LG Elecs., Inc.*, 880 F.3d 1356, 1369 (Fed. Cir. 2018) (finding substantial evidence to support jury finding of infringement based on evidence in a user manual). Instead, *Markman* holds simply that “the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” 517 U.S. 370, 372 (1996).¹ And *Teva*, 574 U.S. at 321, which TCL also cites (Pet. 15-16), merely confirms that claim construction is for the court, “even where the construction of a term of art has ‘evidentiary underpinnings.’” Nothing in the Federal Circuit’s decision here in any way contradicts those holdings.

TCL here claims, incorrectly, that the “jury construed the patent claims” because it “was left to map the industry standard to the claims.” Pet. 4. But the jury in this case did not decide claim construction—*i.e.*,

¹ As the Federal Circuit has frequently reiterated, claim construction should focus on the claim language and intrinsic record, not extrinsic material, such as a standard. See *Ruckus Wireless, Inc. v. Innovative Wireless Sols., LLC*, 824 F.3d 999, 1003 (2016); see also *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317-1319 (2005) (en banc), cert. denied, 126 S. Ct. 1332 (2006). If anything, TCL’s suggestion that courts must determine during claim construction whether the claimed invention is essential to an industry standard would complicate the *Markman* process. Unlike typical claim construction, a determination regarding essentiality would require resolution of complicated issues of fact and extensive expert testimony regarding particular industry standards, turning a straightforward *Markman* hearing into a mini-trial on infringement.

the “interpretation” or “meaning” of a claim. Instead, after an extensive *Markman* process, which included an exchange of proposed terms for construction, full briefing, and oral argument, the district court construed the Asserted Claims. Pet. App. 4a-28a. (On appeal, moreover, TCL never identified any claim terms it felt that the district court had failed to construe.) At trial, the jury appropriately applied the district court’s constructions in comparing the claim limitations to the LTE standard and determining that practicing the mandatory portions of that standard necessarily meets the claims’ terms. *Id.* at 32a. As the Federal Circuit explained, this question of “essentiality” is, “after all, a fact question about whether the claim elements read onto mandatory portions of a standard that standard-compliant devices must incorporate.” *Id.* at 68a. And, as the Federal Circuit agreed, whether a properly construed claim reads on a product, or reads on mandatory portions of a standard, is a quintessential fact question that is properly the province of a factfinder. See *ibid.* Indeed, for “more than two centuries,” it has been established “that infringement cases * * * must be tried to a jury,” *Markman*, 517 U.S. at 377, whose function it is to “answer[] the ultimate question of infringement,” *id.* at 385 (citing *Bischoff v. Whethered*, 76 U.S. (9 Wall.) 812, 814 (1869)); see also U.S. Const. Amend. VII (guaranteeing right to a jury trial).

Here, analyzing the standard was simply part of the first step of determining whether practicing the mandatory portions of the standard would meet every limitation of the Asserted Claims. This “is the same as comparing the claims to the accused product,” Pet. App. 66a, and the same as what juries are asked to do

as factfinders in any infringement case. Leaving that quintessentially factual infringement question to the factfinder certainly does not violate this Court’s precedent, nor warrant review.

2. *TCL’s Professed Concern About the Ease With Which Patent Owners Make “Declarations” Of Essentiality Is a Strawman Because It Does Not Reflect The Federal Circuit’s Holding*

Furthermore, TCL’s professed policy concern, (Pet. 16-21) over “the ease at [*sic*] which patents can be declared essential, and the vast number of essential patents that exist,” is a strawman that similarly does not support review because it too does not reflect the Federal Circuit’s holding.

TCL argues (Pet. 16-19) that many patents are declared essential when they are not actually essential (the concept of “over-declaration”). Notwithstanding TCL’s repeated misrepresentations, however, IP Bridge never argued—and the Federal Circuit never held—that a patentee can prove essentiality merely by relying on a declaration to that effect by the patent owner to an SSO. To the contrary, as the Federal Circuit expressly held, “where, but *only where*, a patent covers mandatory aspects of a standard, is it enough to prove infringement by showing standard compliance.” Pet. App. 66a-67a (emphasis added). In other words, whatever a patent owner may have *declared* about its patents being essential to a particular standard, to show infringement the patent owner needs to *prove* that as fact to the jury. As discussed above, that is what IP Bridge did in this case. See, *e.g.*, *id.* at 32a,

55a. In any event, the requirement that patentees offer such proof obviates any speculative concerns TCL may have that patentees could prove infringement with patents declared, but not in fact, essential. That many patents are *declared* essential to standards has no effect on what must be shown in order to prove infringement.

TCL tries (Pet. 16-17) to leverage what it characterizes as an “over-declaration” problem further by arguing that the fact that a product complies with a standard may not mean that the product “satisfies every mandatory requirement of an industry standard.” Not so. As Dr. Min testified in this case—and TCL *never contested at trial*—to “comply” with the standard here, a product *must* practice all mandatory portions of that standard. Pet. App. 55a, 62a. If, in another case, an implementer maintains that it is holding out its products to consumers as standard-compliant even though they do not, in fact, practice all mandatory portions of the standard, that issue should be addressed through expert testimony and cross-examination in front of the factfinder. See, e.g., *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 596 (1993) (explaining that cross-examination and contrary evidence are the traditional and appropriate means of attacking expert testimony). Here, as both the district court and the Federal Circuit noted, TCL presented *no evidence* to the jury countering Dr. Min’s and IP Bridge’s showing—and TCL’s expert never even ventured an opinion either way.

In the last paragraph of its Petition, TCL argues (Pet. 19) that “[t]here must be *some step* * * * that allows a defendant to ensure that the patent asserted against it will be held to the scope of its claims, and that

plaintiffs will not use the standard-setting process to improperly broaden patent claim scope during litigation.” Here, there were at least *two* such steps: first, the claim construction process, in which the court considered the proper scope of the Asserted Claims; and, second, the infringement case presented to the jury, which determined that the construed claims read on mandatory portions of the standard, and that the products practice those mandatory portions of the standard. At the first of those steps, TCL never asked the district court to construe the claims in the manner it now insists is required. At the second of those steps, TCL chose, for whatever reason, not to attempt to present any evidence (including expert testimony) to counter Dr. Min’s and IP Bridge’s showing. TCL should not now be heard to complain about the consequences of its own choices.

II. THIS CASE IS A POOR VEHICLE, BECAUSE THE PETITION IS PREMISED ON A FALSE RECOUNTING OF THE DISTRICT COURT PROCEEDINGS

Even if the issues the Petition attempts to raise might warrant review, this case is a particularly poor vehicle for such review, because all of TCL’s arguments are based on mischaracterizations of what took place in the trial court.

For example, as discussed previously, TCL’s first Question is based on the false premise that IP Bridge “prove[d] literal infringement by relying *solely* on the essentiality of its patent to an industry standard.” Pet. i. No court has ever upheld proving infringement on that basis alone, nor is that what the district court did,

what IP Bridge presented, or what the jury found. The jury found infringement on the basis of IP Bridge's presentation of extensive evidence (including hours of expert testimony, based on extensive documentation from TCL itself) not only that the claims were essential to mandatory portions of the LTE standard, but *also* that the accused products each complied with that standard, and so practiced the mandatory portions of the standard. See, *e.g.*, Pet. App. 55a. TCL never presented evidence to counter that showing. *Ibid.* Assuming the first question otherwise warrants the Court's review, the Court should consider it in a case in which the jury did, in fact, base its finding of infringement solely on a finding of essentiality.

TCL's Petition is also based on a related mischaracterization, that to prove essentiality IP Bridge relied solely on IP Bridge's required declaration to ETSI. TCL repeats this incorrect claim numerous times in its Petition. See, *e.g.*, Pet. 4 (claiming IP Bridge "merely relied on a declaration of standard essentiality at trial from a standard-settings organization known as 3GPP"); *id.* at 5 (alleging that the jury used this "declaration of standard-essentiality * * * to conclude infringement"); *id.* at 11 ("At trial, the district court permitted IP Bridge to rely solely on a self-interested declaration of standard essentiality * * * ."); *id.* at 12 (stating that the Federal Circuit's error "is especially egregious here, because the declaration of standard-essentiality that the jury used to conclude infringement was made by IP Bridge in a self-interested agreement."). But as TCL well knows, while the original patent owner certainly declared these patents essential to the LTE standard as part of the standard-setting pro-

cess (presumably the “declaration” to which TCL refers), IP Bridge *did not rely on that declaration to prove essentiality*, nor did the district court or the Federal Circuit approve of doing so. Instead, as discussed above, IP Bridge relied on the detailed, extensive testimony of its expert, Dr. Min, to demonstrate that each limitation of each asserted claim was present in mandatory portions of the LTE standard. Pet. App. 55a. The actual facts of this case, thus, would frustrate the Court’s ability to address and resolve the issues that TCL contends warrant review. The Court should await a case in which those concerns are actually present.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be denied.

Respectfully submitted,

DOUGLAS HALLWARD-DRIEMEIER
JAMES R. BATCHELDER
STEVEN PEPE
KEVIN J. POST
SAMUEL L. BRENNER
SHONG YIN
QUINN WALKER
ROPES & GRAY LLP

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