

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

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In the  
Supreme Court of the United States

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VIRENTEM VENTURES, LLC,  
*Petitioner,*

v.

GOOGLE LLC,  
*Respondent.*

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

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PETITION FOR A WRIT OF CERTIORARI

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## QUESTIONS PRESENTED

1. Does the Federal Circuit's use of Rule 36 to affirm without opinion PTAB invalidity determinations that are challenged based on pure questions of law violate a patentee's due process rights through arbitrary or disparately applied results?

2. Did the Federal Circuit's use of Rule 36 to affirm without opinion PTAB invalidity determinations of Virentem's patents violate its due process rights?

3. Did the PTAB's adoption, and Federal Circuit's summary affirmance, of broad constructions of Time Scale Modification and other claim terms over Virentem's explicit narrowing definitions, violate the Federal Circuit's own law and precedents on claim construction in such circumstances?

4. Does the Federal Circuit's use of Rule 36 to affirm without opinion decisions from the PTAB violate the requirement of 35 U.S.C. § 144 that the Federal Circuit "shall issue to the Director its mandate and opinion"?

## **PARTIES TO THE PROCEEDINGS**

The caption of the case contains the names of all the parties to the proceedings.

### **RULE 29.6**

#### **CORPORATE DISCLOSURE STATEMENT**

Virentem Ventures, LLC has no parent corporations and no publicly held companies own 10% or more of stock in the party.

## LIST OF PROCEEDINGS

### DIRECT PROCEEDINGS BELOW

This petition is taken from three judgments of the Federal Circuit in seven related appeals, consolidated as follows:

- *Virentem Ventures, LLC v. Google LLC*, Nos. 21-1764, 21-1765, 21-1804, 21-1822 (Fed. Cir.), judgment entered November 21, 2022;
- *Virentem Ventures, LLC v. Google LLC*, Nos. 21-1805, 21-1806, (Fed. Cir.), judgment entered November 21, 2022; and
- *Virentem Ventures, LLC v. Google LLC*, No. 21-1934 (Fed. Cir.), judgment entered November 21, 2022.

Each of the seven Federal Circuit appeals arose from a final written decision of the Patent Trial and Appeal Board on *inter parties* review, as follows:

- *Google LLC v. Virentem Ventures, LLC*, IPR2019-01237 (P.T.A.B.)  
final written decision entered February 2, 2021;
- *Google LLC v. Virentem Ventures, LLC*, IPR2019-01239 (P.T.A.B.)  
final written decision entered January 13, 2021;
- *Google LLC v. Virentem Ventures, LLC*, IPR2019-01241 (P.T.A.B.)  
final written decision entered January 27, 2021;
- *Google LLC v. Virentem Ventures, LLC*, IPR2019-01243 (P.T.A.B.)  
final written decision entered January 12, 2021;

- *Google LLC v. Virentem Ventures, LLC*, IPR2019-01244 (P.T.A.B.) final written decision entered January 25, 2021;
- *Google LLC v. Virentem Ventures, LLC*, IPR2019-01245 (P.T.A.B.) final written decision entered January 26, 2021; and
- *Google LLC v. Virentem Ventures, LLC*, IPR2019-01247 (P.T.A.B.) final written decision entered March 5, 2021.

## **RELATED PROCEEDINGS**

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The patents found invalid by the Patent Trial and Appeal Board in the above written decisions (U.S. Patent Nos. 8,345,050; 8,068,108; 7,683,903; 9,785,400; 6,598,228; 7,100,188; and 7,043,433) were asserted against YouTube, LLC and Google LLC in a 2018 patent infringement action in the U.S. District Court for the District of Delaware, which was stayed pending the above-referenced PTAB proceedings; two other patents not subject to any *inter partes* review proceeding remain asserted in that stayed district court action:

- *Virentem Ventures, LLC D/B/A Enounce v. YouTube, LLC; Google LLC*, No. C.A. 18-917-MN (D. Del.).

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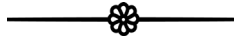
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## **PETITION FOR WRIT OF CERTIORARI**

Virentem Ventures, LLC respectfully petitions for a writ of certiorari to review the judgments of the United States Court of Appeals for the Federal Circuit in three related cases.



## **OPINIONS BELOW**

The Federal Circuit's order disposing of case 21-1805 without opinion (App.1-2) pursuant to Fed. Cir. R. 36 is unreported in the Federal Reporter and is not yet reported in the Federal Appendix, but is available at 2022 WL 17087139. The Federal Circuit's order disposing of case 21-1765 without opinion (App.3-4) pursuant to Fed. Cir. R. 36 is unreported in the Federal Reporter and not yet reported in the Federal Appendix, but is available at 2022 WL 17087138. The Federal Circuit's order disposing of case 21-1934 without opinion (App.5-6) pursuant to Fed. Cir. R. 36 is unreported in the Federal Reporter and is not yet reported in the Federal Appendix, but is available at 2022 WL 17887854. The opinions and orders of the Patent Office's Patent Trial and Appeal Board (App.7-473) are unreported.



## JURISDICTIONAL STATEMENT

The Federal Circuit entered judgment on November 21, 2022 in all three consolidated appeals. This petition is timely filed. The jurisdiction of this Court rests on 28 U.S.C. § 1254(1).



## CONSTITUTIONAL PROVISIONS, STATUTES, AND JUDICIAL RULES INVOLVED

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

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.

**U.S. Const. amend. V** provides:

No person shall be . . . deprived of life, liberty, or property, without due process of law; . . .

**35 U.S.C. § 144** provides:

The United States Court of Appeals for the Federal Circuit shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

**Federal Circuit Rule 36** provides:

## Entry of Judgment

## (a) Judgment of Affirmance Without Opinion.

The court may enter a judgment of affirmance without opinion, citing this rule, when it determines that any of the following conditions exist and an opinion would have no precedential value:

- (1) the judgment, decision, or order of the trial court appealed from is based on findings that are not clearly erroneous;
- (2) the evidence supporting the jury's verdict is sufficient;
- (3) the record supports summary judgment, directed verdict, or judgment on the pleadings;
- (4) the decision of an administrative agency warrants affirmance under the standard of review in the statute authorizing the petition for review; or
- (5) a judgment or decision has been entered without an error of law.



## INTRODUCTION

Without a word of explanation, the Federal Circuit affirmed the invalidation of seven patents stemming from inventor and Virentem principal Donald J. Hejna, Jr.'s master's thesis at the Massachusetts Institute of Technology concerning a form of audio processing called Time-Scale Modification. Time-Scale Modification ("TSM") is the term of art used to describe a set of audio processing techniques that speed up and slow down the audio content (usually involving speech) of an audio or audio-visual work in a manner that preserves the pitch and intelligibility of the content. The inventors incorporated their TSM techniques in products, one of which was selected by the Library of Congress for its "Talking Books" project in 1999. It was made available to visually impaired patrons so that they could speed up (or slow down) the rate of audio files while avoiding "chipmunking" and preserving the ability to understand the content. The Talking Books product was available at the Library of Congress until at least 2012. (Google, for its part, did not implement TSM on YouTube until 2015.)

The specifications, file histories, every prior art reference of record, and even Google's own admissions in the underlying litigation, confirm the above meaning of Time-Scale Modification. This is not surprising; it is what the term means to a person of ordinary skill in the art. And the patents at issue refer to Time-Scale Modification or TSM (a capitalized term in the patents) hundreds of times; as many as *485 times* in one specification. The law is clear that

the consistent and repeated description of an invention in the specification should be limiting as to the claims. This principle is regularly applied to narrow claims to avoid infringement. But here, the Patent Trial and Appeal Board (PTAB) found that none of the challenged claims across seven patents was limited to a TSM system. And even if they were, that was of no consequence to the PTAB; it also held that TSM had nothing to do with intelligibility or pitch, but instead only required speeding up or slowing down the playback rate. Every single challenged claim was cancelled by asserted prior art that was, at best, tangentially relevant. No primary reference used TSM; and remarkably, one reference only disclosed the visual display of text—with no audio whatsoever. Yet, the Federal Circuit affirmed the invalidity of every challenged claim without opinion—even though all turn on pure questions of law.

The lack of an opinion here, and in hundreds of other cases where a patentee requested but was denied a narrow construction based on the same claim construction principles that are regularly applied by defendants with success to avoid infringement, conceals a disparate application of claim construction law at the Federal Circuit. The disparity runs afoul of the very reason for the creation of that Court: to promote uniformity in the application of patent laws. In reality, the law of claim narrowing depends on the side advocating for its application. As shown through an empirical analysis described herein, an accused infringer is *five times* more likely to receive a narrowing construction that avoids infringement than is a patentee who seeks a narrowing construction that avoids an invalidity finding. This disparity in the

delineation of intellectual property rights is noxious and inexplicable—including because the Federal Circuit avoids writing opinions that could even attempt to explain it.

Congress created the Federal Circuit in 1982 to “substantially improve[] the administration of the law in the areas of patents . . . ; provide[] a tribunal capable of exercising intermediate appellate jurisdiction nationwide; and result[] in improved functioning of the federal appellate system.” House Report on the Federal Courts Improvement Act of 1982, H.R. Rep. No. 97–312, at 16 (1981). Congress’ objective “was to ‘reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist[ed] in the administration of patent law.’” *Id.* at 23.

Claim construction is central to any patent dispute. Questions of infringement and validity turn on how a patent’s claims are interpreted, impacting the patentee and the public. As explained by this Court in *Markman v. Westview Instruments, Inc.*:

The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. Otherwise, a zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field . . . and the public would be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. . . .

517 U.S. 370, 390 (1996) (quotation marks and citations omitted). To further ensure predictability, this Court held that claim construction is a question of law. *Id.* at 372. As such, it is vitally important that claim interpretation be fair and consistent, and not dependent on who requests a construction.

Since its formation, the Federal Circuit has developed claim construction rules. Pertinent here, the Federal Circuit has held that context can mandate that a claim term be given a narrower meaning than what might otherwise appear to the term’s “plain and ordinary meaning.” For example, where an inventor acted as her own lexicographer, the definition she provides prevails over the plain and ordinary meaning. Prosecution disclaimer, a fundamental precept in the Federal Circuit’s claim construction jurisprudence, likewise limits claim terms in accord with the amendments and statements that the inventor made to obtain her patent. Even short of disclaimer, the prosecution history can inform the meaning of a term. Likewise, when an inventor “repeatedly and consistently” characterizes her invention in the patent’s specification, it is proper to narrowly construe the claims in accordance with those characterizations. This makes sense; claims must be read in the context of the overall intrinsic record, and not in the abstract.

It follows, then, that when the Federal Circuit applies its own rules as a matter of law, the resultant claim construction should be predictable, and should not depend on who requests a construction.

But the outcomes in the instant appeals, and of many other Federal Circuit appeals, demonstrate that Federal Circuit claim construction precedent is



not applied in the same manner to patentees and accused infringers.

In precedential decisions from 2019 to the present, patentees requested a narrowing construction 35 times, but were only successful approximately 17% of the time.<sup>1</sup> In contrast, when accused infringers asked the Federal Circuit for a narrowing construction to avoid infringement, they were successful 21% of the time (3 of 14 cases).<sup>2</sup> This result would suggest that accused infringers are only slightly more successful in obtaining narrowing constructions than are patentees.

But when one also considers cases where the Federal Circuit invoked Rule 36 to affirm the lower tribunal's decision without providing a written opinion, it becomes clear that the outcomes are not so even-handed. Review of the briefing underlying Rule 36 affirmances in the same period (from 2019 to the present) reveals that the Federal Circuit refused to give patentees a narrow construction to avoid invalidity an additional 132 times. Combining these two results means that patent owners who requested a narrow construction to avoid invalidity lost over 96% of the time, and almost 82% of those losses were handed

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<sup>1</sup> These results are based on an analysis of the cases the Federal Circuit designated as precedential and listed at App.609-612. Time did not permit an analysis of all non-precedential cases published in the Federal Appendix. Electronic searching located one case where a patentee received a narrow construction: *VirnetX Inc. v. Mangrove Partners Master Fund, Ltd.*, 778 F. App'x 897 (Fed. Cir. 2019). It was the only case identified where a patentee won a narrowing construction based on prosecution history disclaimer, even though it is a "fundamental precept" in the Court's jurisprudence.

<sup>2</sup> See App.613-622.

down with no explanation at all. In the same period, there are only four Rule 36 affirmances denying an accused infringer a narrow construction. Combining accused infringer results, the accused infringer successfully changed an infringement result about 17% of the time (3 of 18) by obtaining a narrowing construction from the Federal Circuit. Thus, a defendant is about five times more likely to avoid an infringement result by asking the Federal Circuit to narrow a construction than is a patentee that would avoid invalidity with the same ask.

A previous empirical study of the impact of Rule 36 affirmances in patent eligibility cases demonstrated that “the Federal Circuit’s precedential opinions provide an inaccurate picture of how disputes over patentable subject matter are actually resolved.” Paul Gugliuzza & Mark A. Lemley, *Can a Court Change the Law by Saying Nothing?*, 71 VAND. L. REV. 765 (2018). The authors observed that “precedential opinions suggest that any given patent has a decent chance of surviving an eligibility challenge at the Federal Circuit. But, in reality, very few patents do.” *Id.* at 765-66.

In this case, the claim constructions cannot be squared with Federal Circuit precedent, which compels a different outcome. Had Petitioner’s proposed constructions (the same constructions it advanced in the district court, where infringement was also at issue) been adopted by either the Patent Trial and Appeal Board (“PTAB”) or the Federal Circuit, most or all the claims would stand valid because neither Google nor the PTAB advanced any alternative invalidity arguments under Virentem’s proposed claim constructions, which were consistent with the construction it advanced in the district court for purposes of

infringement. This Court should vacate the underlying decisions, or at least remand with instructions to the Federal Circuit to issue an opinion that will at least explain, if not change, this result.



## STATEMENT OF THE CASE

### **A. Determining the Boundaries of an Inventor’s Right to Exclude is a Question of Law.**

The Constitution empowers Congress “[t]o 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.” Art. I, § 8, cl. 8. Congress granted inventors “the right to exclude others from making, using, offering for sale, selling, or importing the patented invention” in exchange for full disclosure of their inventions. 35 U.S.C. § 154.

A patent must describe “the exact scope of an invention and its manufacture to ‘secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.’” *Markman*, 517 U.S. at 373 (quoting *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891)). A patent includes one or more claims, which “particularly point[] out and distinctly claim[] the subject matter which the inventor . . . regards as the invention.” 35 U.S.C. § 112. The claim “define[s] the scope of a patent grant.” *Markman*, 517 U.S. at 373 (citations omitted). It is a “bedrock principle” of patent law that “the claims of a patent define the invention to which the patentee is entitled the right

to exclude.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (citations omitted).

Claim construction is a question of law. *Markman*, 517 U.S. at 372.

The words of a claim “are generally given their ordinary and customary meaning” to a person of ordinary skill in the art as of the effective filing date of the application for the invention. *Phillips*, 415 F.3d at 1312-13; *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996); *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004) (“A court construing a patent claim seeks to accord a claim the meaning it would have to a person of ordinary skill in the art at the time of the invention.”); *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004) (“customary meaning” refers to the “customary meaning in [the] art field”).

The claim construction standard from *Phillips* applies to the appeals at issue here.<sup>3</sup> Under *Phillips*, the person of ordinary skill in the art “is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Phillips*, 415 F.3d at 1313. Usually, the specification is dispositive, and it is the single

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<sup>3</sup> For IPRs filed before November 13, 2018, the PTAB applied what is known as the broadest reasonable interpretation or “BRI” standard. See Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board, 83 Fed. Reg. 51,340 (Oct. 11, 2018). A BRI construction can be the same as or broader than a *Phillips* construction, but it cannot be narrower. *In re CSB–System Int’l, Inc.*, 832 F.3d 1335, 1341 (Fed. Cir. 2016).

best guide to the meaning of a disputed term, *id.* at 1315, and it is regularly used to adopt a narrow construction of a claim term where the specification repeatedly and exclusively describes the invention in a manner that is consistent with the proposed narrow construction. *See, e.g., GPNE Corp. v. Apple Inc.*, 830 F.3d 1365, 1370 (Fed. Cir. 2016).

In some cases, the specification may include a special definition for a term that differs from its usual meaning. *Phillips*, 415 F.3d at 1316. In these instances, the inventor's lexicography controls. *Id.* The specification might also contain a disclaimer or disavowal of claim scope. *Id.* Again, in these instances, the inventor's expressed intention is regarded as dispositive. *Id.*

Courts may also consider the patent's prosecution history, as it may provide evidence of how the inventor and the Patent Office understood the patent. *Id.* In some cases, the Federal Circuit uses statements in the prosecution history describing an invention to confirm a narrow construction that is consistent with the meaning of a term to a person of ordinary skill in the art. *See, e.g., Nystrom v. TREX Co.*, 424 F.3d 1136, 1145 (Fed. Cir. 2005); *Fenner Investments, Ltd. v. Cellco P'ship*, 778 F.3d 1320, 1323 (Fed. Cir. 2015). Or prosecution disclaimer, where the inventor has limited the invention by amendment or in public statements made to the examiner during prosecution, can limit the meaning of a claim term. *See Sound View Innovations, LLC v. Hulu, LLC*, 33 F.4th 1326, 1334-35 (Fed. Cir. 2022).

Finally, extrinsic evidence such as expert and inventor testimony, dictionaries, and learned treatises may be used, although such evidence is less significant

than the intrinsic record. *Phillips*, 415 F.3d. at 1317-18. The ordinary and customary meaning of a term may be evidenced by a variety of sources, including the prior art, if it is consistent with the intrinsic record. *Alloc, Inc. v. Int'l Trade Comm'n*, 342 F.3d 1361, 1368 (Fed. Cir. 2003) (“[T]o determine claim meaning, a court immerses itself in the specification, the prior art, and other evidence, such as the understanding of skilled artisans at the time of the invention, to discern the context and normal usage of the words in the patent claim.”).

When a patent “repeatedly and consistently” characterizes a claim term in a particular way, a claim term should be construed in accordance with that characterization. *See, e.g., GPNE*, 830 F.3d at 1370; *VirnetX, Inc. v. Cisco Sys., Inc.*, 767 F.3d 1308, 1318 (Fed. Cir. 2014); *ICU Med., Inc. v. Alaris Med. Sys., Inc.*, 558 F.3d 1368, 1374-75 (Fed. Cir. 2009); *In re Abbott Diabetes Care Inc.*, 696 F.3d 1142, 1149-50 (Fed. Cir. 2012) (construing the term “electrochemical sensor” as “devoid of external connection cables or wires to connect to a sensor control unit” to be consistent with “the language of the claims and the specification”); *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260-61 (Fed. Cir. 2010) (construing the term “material for finishing the top surface of the floor” to mean “a clear, uniform layer on the top surface of a floor that is the final treatment or coating of a surface” to be consistent with “the express language of the claim and the specification”); *Vitronics Corp.*, 90 F.3d at 1583 (construing the term “solder reflow temperature” to mean “peak reflow temperature” of solder rather than the “liquidus temperature” of solder in order to remain consistent with the specification).

Defendants regularly rely on this precedent to avoid infringement. In *GPNE*, for example, defendant Apple asserted that “node” in the phrase “a first node in a data network” should be limited to “[a] pager in a network operating independently of a telephone network,” whereas patentee GPNE asserted that “node” should be construed as “[a] device in a network that can transmit and receive information.” *GPNE*, 830 F.3d at 1368. The district court rejected GPNE’s “device” construction and limited “node” to a “pager.” *Id.* The jury found that Apple did not infringe under the district court’s narrow construction.

The Federal Circuit affirmed in an often-cited precedential opinion. The word “node” appears in the Abstract and the claims; among other things “GPNE argue[d] that the district court erred in classifying a ‘node’ as a ‘pager’ because nothing in the claims requires that a ‘node’ must be a ‘pager’ . . . and the specification contains evidence that ‘node’ should be construed more broadly.” *Id.* at 1371. For example, “GPNE point[ed] to how the specification describes ‘nodes’ as devices that operate on a sophisticated data network and contain complex features like image displays and a writing pad.” *Id.* But the Federal Circuit rejected GPNE’s argument, and affirmed the narrow construction of “nodes” as “pagers” because:

The words “pager” and “pager units” appear in the specification over 200 times, and, apart from the Abstract, the specification repeatedly and exclusively uses these words to refer to the devices in the patented system . . . . The prosecution history also supports construing “node” as a type of “pager” because the inventor’s Rule 131 declaration consistently

and exclusively describes the invention as a system of pagers. J.A. 657–83. In light of this consistent disclosure, the district court did not err in characterizing a “node” as a “pager.”

*Id.* at 1370-71.

In *VirnetX*, 767 F.3d at 1318, after an adverse jury verdict, accused infringer Apple argued that “secure communication link” required not just data security but also required “anonymity.” *Id.* at 1317. The Federal Circuit agreed with Apple that “when read in light of the entire specification,” the details of which the Federal Circuit systematically recounted in its opinion, “security” in the context of the asserted claims required “anonymity.” *Id.* at 1318. The Federal Circuit vacated the district court’s claim construction in favor of Apple’s proposed narrow construction, and remanded.

Respondent Google likewise successfully and repeatedly makes this “consistently and repeatedly” argument to secure narrowing constructions when accused of infringement. *See, e.g., Uniloc 2017 LLC v. Google LLC*, No. 2:18-CV-00491-JRGRSP, 2020 WL 569857, at \*4-6 (E.D. Tex. Feb. 5, 2020) (specification consistently described “replacing” as using “a gradual transition”); *Arendi S.A.R.L. v. LG Elecs., Inc.*, No. CV 12-1595-LPS, 2019 WL 3891150, at \*4 (D. Del. Aug. 19, 2019) (per patent’s consistent and repeated description, a “document” must be editable); *SourceProse Corp. v. AT&T Mobility, LLC*, No. A-11-CV-117-LY, 2014 WL 2879694, at \*8-9 (W.D. Tex. June 24, 2014) (“second map” was distinct from first because this went to the “very heart of the claimed invention”).



Prosecution disclaimer is “well established in Supreme Court precedent” and “a fundamental precept in [the Federal Circuit’s] claim construction jurisprudence”—and is regularly found to mandate a narrow claim construction as a matter of law. *See, e.g., 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 Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323-24 (Fed. Cir. 2003); *Traxcell Techs., LLC v. Nokia Solutions & Networks Oy*, 15 F.4th 1136, 1141-42 (Fed. Cir. 2021); *Data Engine Techs. LLC v. Google LLC*, 10 F.4th 1375, 1382-83 (Fed. Cir. 2021); *SpeedTrack, Inc. v. Amazon.com*, 998 F.3d 1373, 1379-81 (Fed. Cir. 2021).

In *Data Engine Technologies*, for example, Google successfully argued to the Federal Circuit that the preamble term “three-dimensional spreadsheet” was limiting to avoid an infringement finding. 10 F.4th at 1380.

During prosecution of the application that led to the asserted patent, the applicants distinguished the prior art from the claimed invention, arguing that the prior art “falls far short of a true 3D spreadsheet.” *Id.* Giving effect to this disclaimer made in the prosecution history, the Federal Circuit determined that the “three-dimensional spreadsheet” preamble was limiting. *Id.* at 1382-83.

As the *Data Engine Technologies* case shows, and similar to the “consistently and repeatedly” argument, Google has successfully and repeatedly made this

“prosecution disclaimer” argument in federal courts. *See also SEVEN Networks, LLC v. Google LLC*, No. 2:17-CV-441-JRG, 2018 WL 5263271, at \*31-35 (E.D. Tex. Oct. 23, 2018) (agreeing with Defendants, including Google, that the prosecution history contains a disclaimer that limits the “common channel” and “non-common channel” to being “push” channels).

Even where the prosecution history does not rise to the level of disclaimer, the inventor’s public statements about the metes and bounds of her invention are often used as instructive of the meaning of claim terms. *See MasterMine Software, Inc. v. Microsoft Corp.*, 874 F.3d 1307, 1312 (Fed. Cir. 2017) (finding that a statement “presented by the inventor during patent examination is relevant to claim construction, for the role of claim construction is to capture the scope of the actual invention that is disclosed, described, and patented,” even if the statement does not amount to a disclaimer); *Bd. of Regents of the Univ. of Tex. Sys. v. BENQ Am. Corp.*, 533 F.3d 1362, 1369 (Fed. Cir. 2008); *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34 (Fed. Cir. 2003).

## **B. The Federal Circuit Affirmed Claim Constructions That Run Directly Afoul of Its Own Settled Precedent Without Opinion.**

Arguing at the PTAB, Virentem requested narrow claim constructions that are dispositive of the IPR proceedings. The facts were undisputed and compelled the requested constructions in accord with the precedent set forth above. Exemplary terms are set forth below.

1. Virentem requested that the PTAB construe “media-work” in the ’433 Patent to require at least

audio based on the consistent and repeated use in the specification.

The '433 Patent claims improvements in presenting audio or audio-visual works in a Time-Scale Modification system:

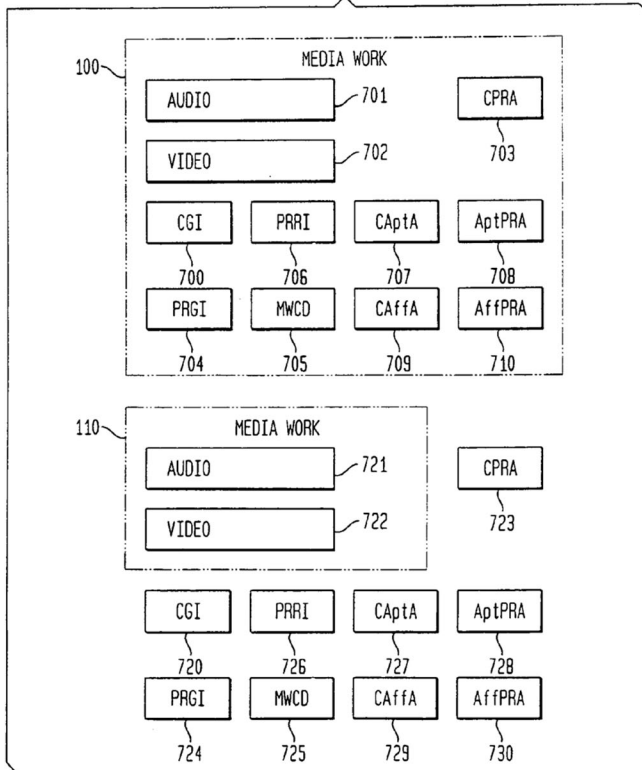
Presently known methods for Time-Scale Modification ("TSM") enable digitally recorded audio to be modified so that a perceived articulation rate of spoken passages, *i.e.*, a speaking rate, can be modified dynamically during playback. Typical applications of such TSM methods include, but are not limited to, speed reading for the blind, talking books, digitally recording lectures, slide shows, multimedia presentations and foreign language learning. In a typical such application, referred to herein as a Listener-Directed Time-Scale Modification application ("LD-TSM"), a listener can control the speaking rate during playback of a previously recorded speaker. This enables the listener to "speed-up" or "slow-down" the articulation rate and, thereby, the information delivery rate provided by the previously recorded speaker. As is well known to those of ordinary skill in the art, the use of the TSM method in the above-described LD-TSM application enables the sped-up or slowed-down speech or audio to be presented intelligibly at the increased or decreased playback rates. Thus, for example, a listener can readily comprehend material through which he/she is fast-forwarding.

PV.27, 1:22-42.

The '433 patent is directed to an improved *listener*-directed TSM system for determining audience interest in a work that includes audio as the term “listener” implies.

“Media work” or “MW” is parenthetically specified to be an “audio and/or audio-visual work” **126 times** in the specification, and is specified to be an “audio and/or audio-visual work” **6 additional times**. Figure 19A, which includes the only two representations of a “media work” in the specification, depicts audio in both. PV.30, 8:48-50.

FIG. 19A



In the first embodiment, the specification states that “media work” may also “be referred to herein as speech, audio, and/or audio-visual work. PV.34, 16:10-11. That designation is carried through the rest of the specification. *See, e.g., id.*, 16:60-67 (“(a) select a file to play, which file corresponds to a particular MW (audio or audio-visual work)”); PV.37, 21:49-51 (“Upon completion of presentation (playback) of an MW (audio or audio-visual work)”); PV.45, 37:63-64 (“TSM sampling frequencies, to be used for any MW (audio or audio-visual work)”); PV.45, 38:63-66 (“The output from TSM apparatus 4300 is a stream of digital samples which comprise a digitized audio or audio-visual stream that is a Time-Scaled Modified version of the input MW (audio or audio-visual work)”); PV.39, 25:28-43; *see also id.*, 25:26-28; 25:56-67; PV.7-8, figs. 6 & 7. There is not a single embodiment in the specification that does not include audio.

Nonetheless, the PTAB determined that media work could be text alone based solely on the use of the words “one or” in following paragraph within the 72-column and 32-figure specification:

Media Work: A Media Work (“MW”) may comprise, without limitation, one or more of text, pictures, audio, ***for example, a speech, an audio-visual work, for example, a movie or instructional video tape.***

App.433 (emphasis added).

Based on its conclusion that “media-work” in claims 1, 2 and 7 could be text alone, the PTAB invalidated the claims as obvious in a combination where the primary reference was text-only—adding a

TSM patent that taught only audio to the text-only reference.

Before the Federal Circuit, Virentem argued that the specification's consistent, repeated, and exclusive use of media-work as an "audio or audio-visual work" in every embodiment compels a construction that required audio. In contravention of its own precedent, the Federal Circuit affirmed this result without an opinion.

2. Virentem requested that the PTAB construe the '433, '228, and '188 Claims as limited to TSM systems based on the consistent and repeated use in the specification.

As noted above, the '433 Patent is directed to a "LD-TSM" application. PV.27, 1:22-42. TSM appears 463 times in the specification and figures; and Time-Scale Modification or Time-Scale Modified appears another 22 times. There is no non-TSM embodiment in the specification.

The '228 Patent and the '188 Patent share a common specification and are *entitled* "Method and apparatus for controlling *time-scale modification* during multi-media broadcasts." The '228 Patent specification begins:

The present invention pertains to multi-media broadcast and presentation of broadcast multi-media. In particular, the present invention pertains to method and apparatus for controlling *Time-Scale Modification* of broadcast multi-media (such as, for example, audio and audio-visual works).

PV.83, 1:15-19. TSM appears **134 times** in the specification, and variations of time-scale modification, time-scale modified, time-scale compressed, etc., appear another **130 times**.

Virentem argued that the limitation “in a TSM system” should be added as a limitation to the claims of the ’433, ’228, and ’188 Patents. The PTAB rejected these constructions. The Federal Circuit affirmed without opinion.

3. Virentem requested that the PTAB find the preambles in the ’229 and ’188 Patents limiting because they were added during prosecution to overcome prior art.

The ’228 Patent relates to audio-visual works sent from a broadcaster to a client device. The specification describes multiple embodiments; in one case the client device is “dumb” and simply plays the content exactly as it is received. It was disclaimed during prosecution. *See* App.538-539. The claimed embodiment, in contrast, has the ability to speed up or slow down the content received from the broadcaster.

The underlined language was added during prosecution to overcome the prior art: “A method for presentation of information received from a broadcaster by a client device, which device utilizes presentation rates to present information at various presentation rates.”

The amendment was accompanied by arguments that the prior art does not teach “that the receiver of the broadcast information analyzes guidance information to determine a presentation rate,” and the prior art “cannot modify a work to be displayed (the playback system cannot modify the work)” —to change

presentation rate “a new modified work must be created and sent to the playback system for each new presentation rate.” App.514-517; App.524-526. The case was appealed to the Board of Patent Appeals and Interferences (“BPAI”). In the appeal, the applicant emphasized to the BPAI that the “present invention” of the challenged claims is limited to “smart devices” that are capable of changing presentation rates:

[T]he present invention relates to method and apparatus for broadcasting media works such as audio or audio-visual works to “smart” client devices, i.e., client devices . . . that can present the received broadcast media works at presentation rates that are obtained by the client devices. Thus, for example, such “smart” client devices can receive a broadcast media work encoded at one presentation rate, and present the broadcast media work at another presentation rate, for example, a presentation rate that is broadcast to the client device.

App.538-539. The claims were then allowed, and the preamble language was called out in the notice of allowance.

Consistent with the applicant’s statements during prosecution, when describing the embodiments of the challenged claims, the PTAB says:

“User system 21300 is a *client device capable of altering presentation rate of streamed media based on the PRGI information [rate guidance information] sent in connection with the broadcast media.*”

App.13 (emphasis added).



But the PTAB’s claim construction was directly contrary to its own description: “[f]or these reasons, we determine that the preambles do not limit the scope of challenged, independent claims 3, 31, and 34 to ‘smart devices’—devices or apparatus that are capable of performing time-scale modification (‘speeding up or slowing down the playback rate’), wherein the modification is performed by the device or apparatus itself.” App.44. The PTAB then invalidated the claims with references that disclosed client devices that were not capable of modifying rates.

The Federal Circuit affirmed without opinion.

4. Virentem requested that the PTAB construe TSM consistent with its plain and ordinary meaning to a person of ordinary skill in the art, the definitions in the specification, and the statements in the file history.

As set forth above, the ’433 Patent expressly defines Time-Scale Modification:

Presently known methods for Time-Scale Modification (“TSM”) enable digitally recorded audio to be modified so that a perceived articulation rate of spoken passages, *i.e.*, a speaking rate, can be modified dynamically during playback. . . . As is well known to those of ordinary skill in the art, the use of the TSM method . . . enables the sped-up or slowed-down speech or audio to be presented intelligibly at the increased or decreased playback rates.

PV.27, 1:22-40. This alone is clear.

The '228 Patent contains similar language:

*Time-Scale Modification (“TSM”) enable digitally recorded audio to be modified so that a **perceived articulation rate of spoken passages, i.e., a speaking rate, can be modified dynamically during playback.***

PV.85, 5:7-12 (emphasis added).

Statements in the prosecution history leave no doubt as to the meaning of “time-scale modification”:

In accordance with one aspect of the present invention, the presentation or playback rate of the broadcast media work is altered by time-scale modification (“TSM”). . . . **However, TSM is completely different from merely speeding up a playback rate of a signal** by, for example, sub-sampling.

As is well known, merely speeding up a playback rate of a signal causes local pitch periods to be shortened. As is further well known, this shortening of local pitch periods increases frequency, and when the resulting signal is displayed for listening, the resulting signal “sounds like chipmunks.” . . .

In contrast to a simple speed-up/sub-sampling approach, a time-scale modified signal maintains properties of the original signal such as a local pitch period, speaker identity, and intelligibility. TSM does this by preserving prominent features of the signal that are associated with these properties, for example, the local pitch period. Thus, whenever TSM is performed on a voice signal, the resulting

signal sounds as though the same person is talking faster or slower in the same voice.

App.539-542 (emphasis added).

The prior art articles relied on by Respondent, as well as the articles submitted by Petitioner, confirm Virentem's construction. For example, a 1985 article published by IEEE entitled "High Quality Time-Scale Modification of Speech," explains that "[i]n time-scale modification, we wish to modify the perceived rate of speech while preserving the formant structure (for intelligibility) and the perceived pitch (for naturalness)." App.581-584. In another IEEE article, *Time-Scale Modification in Medium to Low Rate Speech Coding*, published in 1986, John Makhoul and Armo El-Jaroudi state: "[c]hanging the speed of the speech signal without changing the voice quality is known as time-scale modification, or TSM." App.585-587. Another, co-authored by inventor Hejna explains that "[t]he key issues in designing time-scale modification (TSM) systems are that the local pitch period remains unchanged (no Donald Duck or Minnie Mouse effects), and that no audible splicing, reverberation, or other artifacts are introduced." App.592-593.

Google itself also admitted that it understands TSM the same way. In its invalidity contentions in the underlying district court litigation, Google wrote:

Certain claims in the '903 family require "Time-Scale Modification" ("TSM") that modifies the playback rate of audio, while also modifying the audio to avoid changing the pitch (for example, reducing the "chipmunk" effect typical from speeding up audio).

[ . . . ]

TSM allowed for, among other things, greater intelligibility of audio when it is sped up for quick listening, as described in Virentem’s patents.

App.573-576.

There is no contrary evidence, except Google’s IPR expert’s say-so that Google’s definition was right.

The PTAB accepted Google’s definition of TSM as “speeding up or slowing down the playback rate,” and then invalidated all challenged claims, including those that specifically recite TSM, based on references that do not disclose TSM.<sup>4</sup>

Before the Federal Circuit, Virentem argued that the claims, specification, prior art, prosecution history, and Google’s admissions, all compelled adoption of Virentem’s claim construction.

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<sup>4</sup> The construction is not grounded in binding precedent but instead resulted largely from a bad game of telephone. The PTAB deferred to the district court in Delaware (most times just copying it verbatim in the FWDs). The district court based its construction on an interlocutory claim construction position taken by a predecessor-in-interest to Virentem in another case years earlier regarding a patent not at issue here—but incorporated by reference in some of the specifications. App.31-34, 125-128, 227-228, 292-293. Aside from the fact that this extrinsic evidence—about a litigation position taken by an entity that is not party here, on an unrelated patent with algorithm claims that inherently preserved pitch and intelligibility (making such a construction superfluous)—falls nowhere in the *Phillips* hierarchy of claim construction evidence; a motion for reconsideration of the Delaware Court’s interlocutory claim construction order was pending when the case was stayed pending the outcome of the IPRs.

In contravention of its own precedent, the Federal Circuit affirmed this result without an opinion.



## REASONS FOR GRANTING THE PETITION

### I. **The Federal Circuit’s Failure to Issue an Opinion in This Case Violated 35 U.S.C. § 144, Fifth Amendment Due Process Guarantees, and Is Wrong.**

Section 144 of the Patent Act requires that, in appeals from decisions of the Patent Trial and Appeal Board, the Federal Circuit “shall issue to the Director [of the Patent Office] its mandate *and opinion*.” 35 U.S.C. § 144 (emphasis added). Notwithstanding this statutory mandate, the Federal Circuit routinely affirms PTAB decisions without opinion in violation of the statute. In fact, the Federal Circuit has been regularly criticized for its practice of affirming PTAB decisions without opinion. *See, e.g.*, Dennis Crouch, *Wrongly Affirmed Without Opinion*, 52 WAKE FOREST L. REV. 561 (2017); Gregory Dolin & Irina D. Manta, *Taking Patents*, 73 WASH. & LEE L. REV. 719 (2016); R. Lindhorst, *Because I Said So: The Federal Circuit, The PTAB, and the Problem With Rule 36 Affirmances*, 69 CASE W. RES. L. REV. 247 (2018). The problem continues to have a significant impact on patent rights. In some years, the Federal Circuit affirmed over 50% of PTAB results using Rule 36; in 2022 it was about 43%. Daniel F. Klodowski & Audrey J. Parker, *Federal Circuit PTAB Appeal Statistics for December 2022*, At the PTAB Blog (Feb. 1, 2023), <https://www.finnegan>.

[com/en/insights/blogs/at-the-ptab-blog/federal-circuit-ptab-appeal-statistics-for-december-2022.html](https://www.federal-circuit.com/en/insights/blogs/at-the-ptab-blog/federal-circuit-ptab-appeal-statistics-for-december-2022.html).

The language in Section 144 is clear, it requires an opinion—a statement of reasons on which the outcome rests. But the Federal Circuit has conceded that Federal Circuit Rule 36 judgments are not opinions, *see Rates Tech., Inc. v. Mediatrix Telecom, Inc.*, 688 F.3d 742, 750 (Fed. Cir. 2012), and a court does not issue an “opinion” merely by rendering a judgment on the outcome of a case, *see, e.g., Rogers v. Hill*, 289 U.S. 582, 587 (1933) (“The court’s decision of a case is its judgment thereon. Its opinion is a statement of the reasons on which the judgment rests.”).

As a general matter of sound judicial administration, Congress had good reason to require the Federal Circuit to issue opinions in appeals from PTAB decisions. Appellate court opinions not only provide important guidance to the immediate parties to the case, they also serve a critical role in advising the public of the legal principles governing their rights. Written opinions also ensure consistent administration and application of the law. Indeed, in a 2004 letter expressing the unanimous view of the then-sitting Federal Circuit judges on proposed amendments to the Federal Rules of Appellate Procedure, former Chief Judge Haldane Robert Mayer confirmed that use of Rule 36 can interfere with the administration of justice. Chief Judge Mayer indicated that proposed changes could delay precedential opinions and “it is likely that there will be an increase in Federal Circuit Rule 36 judgments without opinion. In our view, both of these developments would be detrimental to the administration of justice.” App.623-629.

These functions are particularly important in patent disputes as they impact the rights of patentees as well as the public. “[P]atents are ‘public franchises’ that allow their inventors to ‘exclude others from making, using, offering for sale, or selling the invention throughout the United States.’” *Oil States Energy Services, LLC v. Greene’s Energy Group, LLC*, 138 S. Ct. 1365, 1373-74 (2018) (quoting *Seymour v. Osbourne*, 78 U.S. (11 Wall.) 516, 533 (1871); 35 U.S.C. § 154(a) (1)). Patentees and the public are entitled to know the precise boundaries of those franchises.

The Constitution provides for the issuance of patents to “promote the progress of Science and useful Arts.” U.S. Const. art. 1, § 8, cl. 8. But there is a competing interest that the proper adjudication of patent boundaries informs: “the full and free use of ideas in the public domain.” *Lear, Inc. v. Adkins*, 395 U.S. 653, 674 (1969). In the context of patents, the Federal Circuit is the sole appellate court charged with determining the metes and bounds of inventions, enhancing the risk if it fails to do so consistently. Where individual outcomes are largely immune from challenge because of the lack of an opinion, and inconsistency is hidden from sight by affirmance without opinion, there is great risk and harm to the patentee and public alike.

The Federal Circuit was expressly created to “reduce the widespread lack of uniformity and uncertainty of legal doctrine that exist[ed] in the administration of patent law.” *Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 813 (1988) (quoting H.R. Rep. No. 97-312, at 23 (1981)). Two decades after the Federal Circuit was created to promote uniformity, this Court took a further step to

ensure that uniformity: it made claim construction a question of law. As the Court stated in *Markman v. Westview Instruments, Inc.*:

. . . It was just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases . . . observing that increased uniformity would strengthen the United States patent system in such a way as to foster technological growth and industrial innovation.

517 U.S. at 390 (quotation marks and citations omitted). But where the limits change based on who is requesting a claim construction, and do so without any explanation of why whatsoever, the patent system is undermined.

Thus, it is critically important that the Federal Circuit be held to the consistent administration and application of the law, particularly where the question presented is a pure question of law as to the boundaries of a patent grant. If only one Court was charged with deciding whether other forms of property, like a farm or a house, could be taken from its owner as a matter of law, there would be significant public outcry if the law was applied in a disparate fashion, or simply out of public view. But the Federal Circuit's practice of issuing Rule 36 affirmances similarly violates the Fundamental-Fairness doctrine and undermines the uniform application of the law, or at least significant questions, in cases that present pure questions of law (such as in any case in which a patentee requests a narrowing construction).



It has been posited that appellate court silence in the form of Rule 36 affirmances directly impacts substantive patent law. An empirical study of the impact of Rule 36 affirmances in patent eligibility cases demonstrated that “the Federal Circuit’s precedential opinions [relating to patent eligibility] provide an inaccurate picture of how disputes over patentable subject matter are actually resolved.” Gugliuzza, *supra*, at 765. The authors concluded: “Our findings suggest that, by saying nothing, a court can indeed affect substantive law, or at least the perception of it.” *Id.* at 765-66. This was the case even though, as the authors aptly commented:

As a strictly doctrinal matter, the Federal Circuit should not be deferring to lower tribunals because patent eligibility is a question of law reviewed de novo.

*Id.* at 794 (citing *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362 (Fed. Cir. 2015), with a *contra* cite to *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1368 (Fed. Cir. 2018) as “arguably creating a split within the Federal Circuit on this issue by stating that eligibility involves underlying questions of fact subject to deferential review”); *see also* Jonathan S. Masur & Lisa Larrimore Ouellette, *Deference Mistakes*, 82 U. CHI. L. REV. 643 (2015).

The authors contemplated that the fact that most Federal Circuit decisions invalidating patents under *Alice Corp. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014)—but none of the decisions upholding patents—are hidden from view by Rule 36 may affect the long-term development of the law. Gugliuzza, *supra*, at 796.

Gugliuzza’s and Lemley’s empirical results bear striking similarity to the results obtained in Virentem’s analysis here. At the time of their study, the Federal Circuit had issued 33 written eligibility decisions, and found the challenged patent eligible 7 times, or about 21.2% of the time. *Id.* at 783. This would have suggested that a patentee had a reasonable chance at surviving an eligibility challenge at the Federal Circuit. However, adding Rule 36 affirmances into the total significantly altered that result; “since *Alice*, the Federal Circuit has decided 54 patentable subject matter cases under Rule 36. By definition, all 54 affirmed the tribunal below. Remarkably, every one of the Rule 36 affirmances affirmed a finding of invalidity.” *Id.* at 787. With Rule 36 affirmances added, the actual likelihood of surviving an eligibility challenge at the Federal Circuit was, in reality, less than ten percent.

In the last four years, a review of precedential decisions would suggest that patentees who request narrow constructions to avoid invalidity, and accused infringers who request narrow constructions to avoid infringement have a roughly equal chance at obtaining a narrow claim construction at the Federal Circuit. But when Rule 36 affirmances are added to the totals, the reality is that an accused infringer is many times more likely to get a narrow construction than a patentee.<sup>5</sup> This impacts not only perceptions and

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<sup>5</sup> This study necessarily captures only PTAB results where the patentee had the wherewithal to appeal an adverse PTAB result despite the overwhelming odds against succeeding at the Federal Circuit. Thus, it should be noted that this study fails to capture the significant impact of the equally troubling and underlying issue made clear in this appeal: the PTAB’s failure to follow Federal Circuit precedent when a patentee asks for a narrowing

substantive patent law, but it deprives patentees of their valuable property without due process of law—in addition to violating Section 144 of the Patent Act.

The Due Process guarantees of the United States Constitution require that all persons “shall be treated alike, under like circumstances and conditions.” *Hayes v. Missouri*, 120 U.S. 68, 71-72 (1887) (“an equal right in like cases, and under like circumstances”); *see also Bolling v. Sharpe*, 347 U.S. 497, 499 (1954). Legal questions that come out differently based on which side of the “v” one occupies are an affront to the rule of law and to equal protection under that law. At a minimum, being “treated differently from others similarly situated” requires a rational explanation—one that cannot be found in a collection of summary affirmances without opinion. *See, e.g., Village of Willowbrook v. Olech*, 528 U.S. 562, 564 (2000) (per curiam); *Marshall v. United States*, 414 U.S. 417, 422 (1974) (there must be some “rational basis” for distinctions made). The Constitution’s Due Process guarantees apply to patentees with vested rights in presumptively valid patents. *See, e.g., Oil States*, 138 S. Ct. at 1379 (patents are “property for purposes of the Due Process Clause”).

No reason is evident to explain why accused infringers seeking to narrow patent claims to avoid infringement would be many times more successful than patentees seeking to narrow patent claims to preserve their validity. If anything, Congress seems to have required that the disparity should be the other way round. *See* 35 U.S.C. § 282(a) (“A patent shall be presumed valid.”). Claim construction is a legal

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construction.

question that depends on the content and context of the patent and which must have one answer—without regard to the status of the party doing the asking.

Deprived of any explanation from an Article III court, Virentem cannot possibly conclude that it has been afforded due process in the loss of its property rights. Looking solely at the studied results of the Federal Circuit’s cases since 2019, Virentem might reasonably believe that had it been accused of infringing its own patents, then its very same claim construction arguments might well have been accepted. No rational basis can be discerned from the Federal Circuit’s lack of opinion in this case, nor from its differential treatment of accused infringers and patent owners across the cases studied. Virentem’s procedural and substantive Due Process rights under the Fifth Amendment were violated.

Moreover, the underlying District Court proceeding was stayed while the PTAB proceedings were underway; two other patents that relate to TSM technology (which were not subject to any *inter partes* review proceeding) remain asserted in that stayed proceeding. Thus, the absence of written opinions and attendant Due Process violations are ongoing, with uncertain impact on Virentem’s property rights.

## **II. These Appeals Present the Court with an Appropriate Opportunity to Weigh in on Important Issues That Impact Our Innovation and Our Economy.**

As explained in the House Report, creation of the Federal Circuit was motivated by a need to create

uniformity in the patent law, and thereby serve as a stimulus to innovation and the economy:

the uniformity in the law that will result from the centralization of patent appeals in a single court will be a significant improvement from the standpoint of the industries and businesses that rely on the patent system. Business planning becomes easier as more stable and predictable patent law is introduced. Patents have served as a stimulus to the innovative process. This can have important positive ramifications for the nation's economy.

H.R. Rep. No. 97–312, at 20–21 (1981) (footnotes omitted).

Independently of the impact of the Federal Circuit's practices here, *inter partes* reviews have had a significant negative economic impact on the patent system. It has been estimated that “the value of patents has dropped by two-thirds since and because of the AIA.” Gregory Dolin & Irina D. Manta, *Taking Patents*, 73 WASH. & LEE L. REV. 719, 791 (2016); *The Trouble with Patent-Troll-Hunting*, THE ECONOMIST, Dec. 14, 2019, at 60 (average value of an American patent dropped by 58 percent from 2013 to 2018). The Federal Circuit's practice of affirming these results without explanation, even where the challenge to the result is a question of law and not subject to the substantial deference standard that governs review of other aspects of IPR decisions, further erodes the value of the patent system.

The facts and results in this case cannot reasonably or readily be reconciled with the facts and results

in cases where defendants requested and were given a narrow construction to avoid infringement. As a result, it does not neatly fall within the construct of any portion of Federal Circuit Rule 36 that permits summary affirmance. Thus, this case presents a meritorious vehicle to address the statutory and due process issues implicated by the Federal Circuit's practice of using Rule 36.

Virentem has established it does not stand alone. The Federal Circuit's Rule 36 practice has brought unexplained disparity of legal outcome to basic questions of administration of justice in the patent system, which are impacting patent owners and the public alike, and certainly each of the more than one hundred other patent owners who were denied vested property rights without opinion in just the last four years.



**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.

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