

No. 19-1062

In the Supreme Court of the United States

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

v.

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

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

REPLY BRIEF OF PETITIONERS

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Respondents largely ignore how the Federal Circuit's decisions here and in *Eli Lilly & Co. v. Hospira, Inc.*, 933 F.3d 1320 (2019), petitions for cert. pending, Nos. 19-1058, 19-1061 (filed Feb. 24, 2020) undermine the public notice function of a patent's prosecution history. This Court has recognized that expansive application of the doctrine of equivalents "conflicts with the definitional and public-notice functions of the statutory claiming requirement," and that prosecution history estoppel places "reasonable limits on the doctrine of equivalents." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 29, 34 (1997). Critically, to rebut the presumption of estoppel, the Court has stressed that the patentee must "establish the reason for an amendment required

during patent prosecution,” not a court at some later date. *Id.* at 33 (emphasis added).

In *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, the Court characterized the tangential exception as applying where “the rationale underlying the amendment * * * bear[s] no more than a tangential relation to the equivalent in question.” 535 U.S. 722, 740 (2002). *Festo* did not, however, depart from *Warner-Jenkinson*’s admonition that “the absence of a reason for an amendment” provided by the patentee “during patent prosecution” precludes a patentee from later rebutting the presumption of estoppel, 520 U.S. at 33.

Until its decisions here and in *Hospira*, the Federal Circuit adhered to that principle: a patentee’s “[s]ilence” during prosecution regarding its rationale for an amendment “does not overcome the presumption” of estoppel as to the whole scope of the amendment. *Honeywell Int’l, Inc. v. Hamilton Sundstrand Corp.*, 523 F.3d 1304, 1316, cert. denied, 555 U.S. 939 (2008). Any suggestion (Gov’t Br. in Opp. 20-21; Ajinomoto Br. in Opp. 19) that a court, years later, should determine “the objectively apparent reason” for an amendment, notwithstanding a patentee’s silence during prosecution, is irreconcilable with this Court’s precedent and vitiates the prosecution history’s public notice function. Respondents’ oppositions thus highlight the need for this Court to clarify the tangential exception.

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

A. Requiring Patentees To Provide Contemporaneous Rationales For Narrowing Amendments Comports With This Court’s Recognition Of The Public Notice Function Of The Prosecution History

Warner-Jenkinson and *Festo* recognized the prosecution history’s critical public notice function. See Pet. 15-17. Before its decisions here and in *Hospira*, the Federal Circuit consistently held “if the public notice function of a patent and its prosecution history is to have significance,” the tangential inquiry must focus on the “patentee’s objectively apparent reason for the narrowing amendment * * * discernible from the prosecution history record.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1369 (2003) (en banc), cert. denied, 541 U.S. 988 (2004) (emphasis added). These cases break from that precedent. See, e.g., Pet. 24-26; AAM Amicus Br. at 13-18, *Dr. Reddy’s Labs., Ltd. v. Eli Lilly & Co.*, No. 19-1061 (Mar. 27, 2020) (19-1061 AAM Amicus Br.).

The amicus here and the petitioners and amici in *Hospira* raise similar concerns regarding the harm these departures from precedent cause to the public notice function of the prosecution history. See R Street Institute (RSI) Amicus Br. 9-11; Pet. at 7-8, 24, *Dr. Reddy’s, supra* (Feb. 24, 2020) (19-1061 Pet.); Pet. at 4, 25, 28, *Hospira, Inc. v. Eli Lilly & Co.*, No. 19-1058 (Feb. 24, 2020) (19-1058 Pet.); 19-1061 AAM Amicus Br. at 5, 8-10, 14-15, 18; AHIP Amicus Br. at 19, 21, *Hospira, supra*

(Mar. 26, 2020) (19-1058 AHIP Amicus Br.). Respondents dismiss that damage as “the price of ensuring the appropriate incentives for innovation.” Gov’t Br. in Opp. 21 (citation omitted); Ajinomoto Br. in Opp. 21 (citation omitted). To the contrary, a lack of public notice of a patent’s scope stifles the progress of science.

Warner-Jenkinson identifies three parts of the prosecution history that, together, provide public notice of a claim’s scope: the rejection, the claim amendment, and the patentee’s explanation for the amendment, *i.e.*, why the particular amendment was chosen. 520 U.S. at 32-33. All three must be considered to evaluate the scope of estoppel. The rejection sets the minimum surrender (*i.e.*, the minimum required to overcome the rejection). The amendment provides the maximum (and presumed) surrender. *Festo*, 535 U.S. at 740. Under the tangential exception, only the patentee’s contemporaneous rationale for the amendment can rebut the presumption of maximum surrender. *Ibid.*; *Warner-Jenkinson*, 520 U.S. at 33-34.

Respondents ignore (Ajinomoto Br. in Opp. 14-15, 22; Gov’t Br. in Opp. 14, 20) this three-part analysis and look only to the rejection and amendment, arguing that it was the court’s function to independently discern from them the “objectively apparent reason” for the amendment. *Warner-Jenkinson*, however, emphasizes the necessary third element of the prosecution history, mandating “the *patent holder* to *establish the reason* for an amendment required *during patent prosecution*,” not the court during later litigation. 520 U.S. at 33-34 (emphases added). Respondents’ flawed approach largely moots *Festo*’s presumptive surrender due to a narrow-

ing amendment. It would permit, as occurred here, patentees to articulate, and courts *sua sponte* to divine, a *post-hoc* rationale for the amendment. This Court rejected precisely that expansion of the doctrine of equivalents in *Warner-Jenkinson*. *Id.* at 33-34.

By contrast, requiring patentees to provide contemporaneous explanations for their narrowing amendments is faithful to *Warner-Jenkinson* and *Festo*. It preserves the public notice of the prosecution history and grounds the scope of the intended surrender in the entire prosecution record, not just the rejection and amendment. Given patentees' control over that prosecution record, it is not unreasonable to require patentees to provide contemporaneous explanations for their amendments if they intend to surrender less than the maximum scope of those amendments. *Cf.* Gov't Br. in Opp. 18. This approach balances flexibility for the patentee with notice to the public. Allowing patentees to articulate *post-hoc* rationales for their amendments during subsequent litigation, by contrast, destroys that balance.

As Hospira notes (19-1058 Pet. at 18), when considering a rejection over oranges and an amendment from "fruit" to "Red Delicious apples," the public cannot know if the patentee intended to surrender all citrus fruit, all non-apples, or all fruit except Red Delicious apples. Similarly, here, the public cannot know if Ajinomoto intended to surrender all YfiK proteins, all "non-YddG" proteins, or all proteins whose DNAs fall outside the hybridization definition. *Cf.* Ajinomoto Br. in Opp. 12-13, 19. In both cases, without a contemporaneous explanation, the public can only objectively determine, as petitioners did, that the patentee intended to surrender the

entire territory between the original and amended claims. Ajinomoto’s years-later assertion, when trying to capture the accused product, that it intended to surrender less than the amendment’s full scope vitiates the public notice provided by the prosecution history.

Accordingly, as *Festo* mandates, support for any intermediate scope of surrender must be found in the patentee’s contemporaneous “reason” for the amendment. 535 U.S. at 740; see also Pet. 20. Only that contemporaneous explanation provides public notice that the intended scope of surrender is between the minimum (the rejection) and maximum (the amendment’s full scope). Without such notice, only *subjective*, after-the-fact analysis is possible. Indeed, here, three neutral adjudicators identified three different rationales for Ajinomoto’s amendment, and Ajinomoto belatedly proffered a fourth. See Pet. 21.

The Government belittles (Br. 20) the difference between the Majority’s and Ajinomoto’s proffered rationales. This ignores that two other neutral adjudicators identified two additional, very different rationales. Ajinomoto likewise implies (Br. 16) that, although the three adjudicators “did not use the *exact* same words to describe the *exact* same rationale,” they identified essentially the same rationale. Not so. The three adjudicators’ rationales and Ajinomoto’s are very different—*e.g.*, the ITC and the dissent relied on DNA (the ITC excluding native *genes*; the dissent excluding DNA that did not hybridize) while the Majority and Ajinomoto relied on protein (the Majority limiting the permissible *amino acid* alterations; Ajinomoto excluding non-YddG proteins). Notably, each is subjective, developed years after the amendment, and devoid of objective support

from the patentee in the prosecution record. See, *e.g.*, Pet. 9-10. That is not public notice.

B. The Decision Below Frustrates The Public Notice Function Of The Prosecution History

Without a patentee’s contemporaneous rationale for its amendment, the Federal Circuit’s subjective, *post-hoc* analysis here and in *Hospira* turns the tangential exception into an I-know-it-when-I-see-it test, improperly relieving the patentee of its “burden [to] show[] [contemporaneously] that the amendment does not surrender the particular equivalent in question,” and providing no public notice of the scope of estoppel until a court “sees” it years later. *Cf. Festo*, 535 U.S. at 740; see also RSI Amicus Br. 9-11; 19-1058 Pet. at 7; 19-1061 Pet. at 20-21; 19-1061 AAM Amicus Br. at 17-18; 19-1061 AHIP Amicus Br. at 9. This approach leaves the public in the dark.

Respondents allege that Ajinomoto’s “argument” during prosecution supports the Majority’s rationale. Ajinomoto Br. in Opp. 23; Gov’t Br. in Opp. 26.¹ They are mistaken. The “argument” parroted the rejection, restated the amendment, and concluded that the prior art no longer anticipated. Pet. 9-10. It provided no more public notice than simply the rejection and amendment (the minimum and maximum surrenders, respectively).

¹ Ajinomoto’s argument that the presumption of estoppel does not even apply is misplaced. The Government acknowledges (Br. 12) that the presumption applies. Pet. App. 91a, 94a-95a. Precedent establishes that a narrowing amendment is “presumed to be a general disclaimer of *the territory between the original claim and the amended claim.*” *Festo*, 535 U.S. at 740 (emphasis added); see also *Warner-Jenkinson*, 520 U.S. at 33. Ajinomoto concedes (Br. 11-12) the pertinent facts demonstrating that scope of surrender.

It certainly provided no objective rationale why Ajinomoto chose its amended language or that Ajinomoto intended to surrender less than the full scope of its amendment—let alone any particular lesser scope.

This contravenes long-standing Federal Circuit precedent applying the tangential exception only when a patentee explained during prosecution why it chose its amendment and how the amendment overcame the rejection. See Pet. 7-8, 25-26 (citing *Insituform Techs., Inc. v. CAT Contracting, Inc.*, 385 F.3d 1360, 1370 (Fed. Cir. 2004); *Regents of Univ. of Cal. v. Dakocytomation Cal., Inc.*, 517 F.3d 1364, 1378 (Fed. Cir. 2008); *Intervet Inc. v. Merial Ltd.*, 617 F.3d 1282, 1291 (Fed. Cir. 2010); *Felix v. Am. Honda Motor Co.*, 562 F.3d 1167, 1184 (Fed. Cir. 2009)).

The Government tries (Br. 22) to dismiss the patentee’s contemporaneous statements in those cases as merely “probative.” Yet, it fails to identify a *single* case applying the tangential exception without a patentee’s contemporaneous rationale for the amendment.

This is understandable. The presumption of estoppel results from a patentee’s choice to amend its claim. *Festo*, 535 U.S. at 734. A patentee choosing to amend can (1) remain silent, or (2) explain *how* its amendment overcame the rejection, *why* it chose the particular language, or *whether* it intended to surrender less than the territory between its original and amended claims. *Festo*, therefore, provides the patentee the opportunity to narrow its scope of surrender. If the patentee elects to remain silent, it conveys its intention to surrender the full territory between the original and amended claims.

As the Federal Circuit has recognized, “[s]ilence does not overcome the presumption.” *Honeywell*, 523

F.3d at 1316. *Honeywell* is especially pertinent. Without a contemporaneously stated rationale, the *Honeywell* court could look only to the rejection and amendment and conclude that the patentee had surrendered the entire territory between the original and amended claims (*i.e.*, the maximum scope of surrender). *Ibid*; *cf.* Gov't Br. in Opp. 23-24; Ajinomoto Br. in Opp. 23-24.

Without this Court's correction, the precedential decisions here and in *Hospira* will frustrate the prosecution history's public notice function. The outcome of the Federal Circuit's flawed decisions is clear: innovators like petitioners² who rely on that public record to make incremental innovations will be deterred, and the progress of science will suffer.

C. Requiring Contemporaneous Explanations Places No Undue Burden On Patentees

Ajinomoto's concerns (Br. 17-18) about placing burdens on patentees are misplaced. *Festo* does not require that patentees explain "which hypothetical equivalents could be covered and which could not," *id.* at 18, and petitioners do not advocate such a standard. Rather, if a patentee intends to surrender less than the full scope of its amendment, it need only provide a contemporaneous explanation that informs the public of its intended surrender. This then serves as the touchstone against which future potential equivalents are judged.

² Petitioners are no copyists. *Cf.* Ajinomoto Br. in Opp. 20. Ajinomoto admits that Petitioners' post-litigation strains were designed "in an attempt to avoid infringement," just as patent law encourages. *Id.* at 8.

The rationale need not utilize particular words describing what was and was not surrendered. *Ajinomoto Br. in Opp.* 18. A patentee is not charged with overcoming limitations of language.³ Nor is there need when amending to contemporaneously identify all potential equivalents. *Cf. ibid.*; *Gov't Br. in Opp.* 19-20. A patentee can later assert any equivalent as tangential to its contemporaneously stated reason. But what the patentee cannot do is wait until it knows the accused product to formulate a *post-hoc* rationale for its long-ago amendment.

Respondents misunderstand this Court's description of the test as "flexible." *Ajinomoto Br. in Opp.* 18-19; *Gov't Br. in Opp.* 18-19. The test is flexible because, fully recognizing the limitations of language, it allows patentees to narrow their presumed scope of surrender by contemporaneously explaining their amendments. The Court did not endorse "flexibility" to allow patentees a bait-and-switch by remaining silent during prosecution, and then, years later, inventing a rationale to rebut the presumption of estoppel. That is not flexibility—it is uncertainty. It diminishes the prosecution history's public notice function and fosters the innovation-discouraging "zone of uncertainty" this Court has warned against. See *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 909-911 (2014) (citation omitted).

Respondents argue "bright-line rules" are inappropriate. *Gov't Br. in Opp.* 18-19; *Ajinomoto Br. in Opp.* 16-17. But, even if requiring contemporaneous explanations for amendments were a "bright-line rule" (it is not),

³ Undisputedly, *Ajinomoto's* original claim literally covered petitioners' strains. *Ajinomoto Br. in Opp.* 11-12.

that would not reduce the need for the requested clarification to the tangential exception. When appropriate, this Court embraces “bright-line rules,” even in patent-related cases. See, *e.g.*, *Helsinn Healthcare S.A. v. Teva Pharm. USA, Inc.*, 139 S. Ct. 628, 633 (2019) (commercial sale satisfies 35 U.S.C. 102(a), regardless of whether the sale made the invention publicly available); *Impression Products v. Lexmark Int’l*, 137 S. Ct. 1523, 1527 (2017) (sale of a product exhausts patent rights in that item, regardless of restrictions patentee purports to impose).

Given a patentee’s control of the prosecution record, requiring it to provide the public with a contemporaneous rationale if it intends to narrow the full scope of surrender imposes no unreasonable burden—especially in an *ex parte* proceeding that results in exclusive rights enforceable against the public. See generally Pet.; *Festo*, 535 U.S. at 741; see also, *e.g.*, RSI Amicus Br. 1-2, 4-7, 9. Indeed, it is consistent with this Court’s pronouncement that the “patentee should bear the burden of showing that” it did not surrender the alleged equivalent. *Festo*, 535 U.S. at 740; see also *Warner-Jenkinson*, 520 U.S. at 33. This requirement does not upset settled expectations of patentees, and respondents have not identified a single conflicting case.

II. THIS CASE IS THE IDEAL VEHICLE

A. This Case Presents A Simple Legal Question

The issue here is a simple legal one: to rebut the presumption of estoppel under the tangential exception, must the patentee provide a contemporaneous explanation for its amendment? Respondents here and in *Hospira* assert that subtle differences between the questions presented in the three petitions (Nos. 19-1058, 19-1061, and this one) doom them. *Ajinomoto Br. in Opp.*

22-23; Eli Lilly Br. in Opp. at 20, 24-25, *Hospira, supra* (Apr. 27, 2020). Not so.

While using different phrasing (*e.g.*, “contemporaneous explanation,” “buyers’ remorse” and “post-hoc”), the three petitions present the same issue: the tangential analysis must be grounded on the objective rationale the patentee proffered during prosecution and not after-the-fact, litigation-inspired constructions. Notably, three amici recognize the important, common, precedent-shattering issue that the Federal Circuit’s decisions present. See, *e.g.*, 19-1061 AAM Amicus Br. at 5. And Judge Dyk’s dissent identified the same divergence from precedent. See Pet. App. 42a-43a; see also, *e.g.*, *Insituform*, 385 F.3d at 1370; *Regents*, 517 F.3d at 1378; *Intervet*, 617 F.3d at 1292; *Integrated Tech. Corp. v. Rudolph Techs., Inc.*, 734 F.3d 1352, 1358-1359 (Fed. Cir. 2013), cert. denied, 573 U.S. 946 (2014); *Schwarz Pharma, Inc. v. Paddock Labs., Inc.*, 504 F.3d 1371, 1377 (Fed. Cir. 2007); and *Lucent Techs., Inc. v. Gateway, Inc.*, 525 F.3d 1200, 1218 (Fed. Cir. 2008).

B. The Facts Underlying The Issue Are Straightforward

Contrary to respondents’ assertions, no in-depth technical review is required to decide this case.⁴ *Cf.* Ajinomoto Br. in Opp. 14, 26; Gov’t Br. in Opp. 15, 17. This Court need only look at Ajinomoto’s short and simple “argument” during prosecution. Pet. 9-10. Nothing there suggests that Ajinomoto intended to surrender an-

⁴ The legal question here requires far less technical knowledge than cases this Court has ably resolved. See, *e.g.*, *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 580-581 (2013).

anything less than the entire territory between the original and amended claims or provides support for the four diverse rationales that Ajinomoto and the adjudicators have proffered. In *Hospira*, by contrast, the presence of a rationale is hotly disputed.

There could be no cleaner background against which this Court could—and should—clarify where the support for a patentee’s rationale underlying a narrowing amendment must be found. The prosecution history’s public notice function hangs in the balance.

If the Court were to grant one of the *Hospira* petitions and not this one, however, it should hold this petition and dispose of it in light of the Court’s ruling in that case.

CONCLUSION

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

Respectfully submitted,

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