

In the  
Supreme Court of the United States

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AKEVA L.L.C.,

*Petitioner,*

v.

NIKE, INC., ADIDAS AMERICA, INC., NEW BALANCE  
ATHLETIC SHOE, INC., PUMA NORTH AMERICA, INC.,

*Respondents.*

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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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## QUESTION PRESENTED

A patent is a property right defined by its claims. The process of interpreting claims—claim construction—affects virtually *every* patent, patent law and litigation. And because patents define *property*, precedent has emphasized the need for consistency and predictability. Without those, patentees, licensees, and competitors cannot make informed judgments about what a claim covers, undermining efforts to enforce, invest, and innovate.

Over three decades, however, the Federal Circuit has perpetuated an intra-circuit split between two distinct sets of conflicting precedents. One set “heav[ily] presume[s]” the claim text bears its “ordinary meaning” in the relevant field wherein the patent’s specification affects claim construction “*only*” by meeting an “*exacting*” standard for (a) “clear” lexicography, i.e., a special definition; or (b) a “clear” disclaimer. The second set takes a “*holistic*” approach that permits the specification to affect claim construction in various ways *not* limited to “*exacting*” lexicography or disclaimer. Despite this exacerbating judicial divide, the Federal Circuit has refused to resolve it. This resulting unpredictability in claim-construction and the property rights so affected are anathema to the clarity required by this Court’s precedents and 35 U.S.C. § 112, ¶2, undermining the investment-and-innovation goals of the Patent Clause, Art. I., § 8, cl. 8. The question presented is:

Whether the Federal Circuit’s “heavy presumption” line of cases or its “holistic” line should govern claim construction.

**RULE 29.6 STATEMENT**

Akeva L.L.C. has no parent corporation, and no publicly held company owns 10% or more of its stock.

## LIST OF PROCEEDINGS

United States Court of Appeals for the Federal  
Circuit

2019-2249

Akeva L.L.C., *Counterclaimant-Appellant*, v.  
Nike, Inc., Adidas America, Inc., *Counter-*  
*Defendants-Appellees*

Date of Final Opinion: July 16, 2020

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United States District Court for the Middle District  
of North Carolina

1:09CV135

ASICS America Corporation, *Plaintiff* /  
*Counterclaim Defendant*, v. Akeva L.L.C., *Defendant*  
/ *Counterclaim Plaintiff*, v. Nike, Inc.; Adidas  
America, Inc.; New Balance Athletic Shoe, Inc.; and  
Puma North America, Inc., *Third Party Defendants*

Date of Final Order: July 8, 2019

Date of Judgment: July 8, 2019

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## **PETITION FOR A WRIT OF CERTIORARI**

Akeva L.L.C. petitions for a writ of certiorari to review the judgment of the Court of Appeals for the Federal Circuit.



## **OPINIONS BELOW**

The Federal Circuit issued a 15-page opinion in this case, designating it non-precedential, App.1a. The court entered final judgment on July 16, 2020, affirming the district court's adopted claim-construction and summary-judgment rulings, App.19a. The magistrate judge's report and recommendation (R&R) of summary judgment of non-infringement and invalidity appears at App.22a.



## **JURISDICTION**

The district court had jurisdiction under 28 U.S.C. §§ 1331, 1338(a). The Federal Circuit had jurisdiction under 28 U.S.C. § 1295(a)(1). This Court has jurisdiction under 28 U.S.C. § 1254(1).



## STATUTORY PROVISION INVOLVED

### 35 U.S.C. § 112, ¶2

The Patent Act requires the patent specification “conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as [the] invention.”



## INTRODUCTION

1. For all the legal issues that can affect the scope, value, and validity of a United States patent—a property right—none is more significant than claim construction. *Markman v. Westview Instruments*, 517 U.S. 370, 386-91 (1996). Claim construction is the process of interpreting a patent’s claims. *Id.* Having long recognized patents as property, this Court has “aptly likened” the claims—the numbered paragraphs that conclude the patent document—to a deed for real property that recites with “particularity” the “bounds” of the owner’s invention. *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 510 (1917); 35 U.S.C. § 112, ¶2. As this Court has explained, patent claims, like a deed, require clear-and-predictable precedents and interpretative rules.

First, this Court and Congress have long recognized that patents are indeed a “property right.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730-31 (2002); *Florida Prepaid Postsecondary*

*Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 644 (1999); 35 U.S.C. § 261. Further, they are property rights that have proven “essential to promote progress,” making the need for clarity and predictability all the more vital:

The patent laws “promote the Progress of Science and useful Arts” by rewarding innovation with a temporary monopoly. The monopoly is a *property right*; and like any property right, its boundaries should be clear. This clarity is essential to promote progress, because it enables efficient investment in innovation. A patent holder should know what he owns, and the public should know what he does not. For this reason, the patent laws require inventors to describe their work in “full, clear, concise, and exact terms,” 35 U.S.C. § 112, . . . .

*Festo*, 535 U.S. at 730-31 (citations omitted) (emphases added). The value of maintaining such clear rules and precedents—and of according them significant *stare decisis* value—are “at [their] acme in cases involving property . . . rights,” such as the patents rights-at-issue here. See *Payne v. Tennessee*, 501 U.S. 808, 828 (1991) (emphasis added).

Second, the U.S. patent system is one of “public notice,” *i.e.*, it charges the public with constructively knowing patent claims. *E.g.*, *Commil USA, LLC v. Cisco Sys., Inc.*, 135 S.Ct. 1920, 1926 (2015). Courts may thus hold parties strictly liable for directly infringing such claims, regardless of knowledge. *Id.*; 35 U.S.C. § 271(a). Accordingly, having clear-and-predictable rules to define claims—and what they do and do not cover—becomes paramount. To that end,

this Court held three decades ago that claim construction presents a legal question for courts, given the need for predictable principles and rulings. *Markman*, 517 U.S. at 387-90.

Similarly, in 1982, with regional circuits issuing conflicting and confusing patent-law decisions, Congress created the Federal Circuit, vesting it with exclusive jurisdiction over patent cases. *E.g.*, H.R. Rep. No. 312, 97th Cong., 1st Sess. 20-23 (1981). Congress did so to have a single court that would harmonize the patent laws and make them clear, consistent, and predictable. *E.g.*, *Phillips v. AWH Corp.*, 415 F.3d 1303, 1330 (Fed. Cir. 2005) (en banc) (“This court was created for the purpose of bringing consistency to the patent field” and “to reinvigorate the patent and introduce predictability to the field”) (Mayer, J., dissenting). Those consistent-and-predictable requirements are vital in patent litigation as well. After all, virtually *every* patent case—and *every* claim or defense therein—requires claim construction.

2. Despite the predominant role that claim construction plays in determining patent rights, the Federal Circuit’s claim-construction precedents have proven wholly inconsistent and its constructions unpredictable. As explained below, the intra-circuit conflict here is *not* the product of, say, one panel choosing to apply a particular claim-construction canon differently than another panel. Rather, the two conflicting lines of cases espouse distinguishing principles that are fundamental to and signify its particular line. Indeed, in an intra-circuit split dating since the late 1990s, the Federal Circuit has developed the following divergent sets of claim-construction principles:

### “Heavy Presumption” Principles

One set of principles, applied by some Federal Circuit judges in some cases, focuses on claim text and accords a “*heavy presumption*” that a term carries its ordinary meaning, as understood by “ordinary artisans” in the field—and that permits the *specification* to affect that meaning “*only*” if it meets an “*exacting*” standard and demonstrates (i) a “clear” disclaimer of claim scope, or (ii) “clear” lexicography<sup>1</sup>;

versus

### “Holistic” Principles

Another set of evolving principles, applied by other Federal Circuit judges in other patent cases (including this case), takes a “*holistic*” approach toward claim construction and allows the *specification* to affect claim meaning even when it does *not* demonstrate an “*exacting*” disclaimer or lexicography— as when, *e.g.*, the *specification* describes “*the present invention*”; “*disparages*” prior art; describes embodiments as “consistently,”

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<sup>1</sup> *E.g.*, *Continental Circuits LLC v. Intel Corp.*, 915 F.3d 788, 795-99 (Fed. Cir. 2019); *Hill-Rom Servs., Inc. v. Stryker Corp.*, 755 F.3d 1367, 1371 (Fed. Cir. 2014) (recognizing “heavy presumption” of term’s ordinary meaning; “[w]e depart from the plain and ordinary meaning of claim terms based on the *specification* in only two instances: lexicography and disavowal. The standards for finding lexicography and disavowal are *exacting*.”); *Thorner v. Sony Computer Enter. Am.*, 669 F.3d 1362, 1366 (Fed. Cir. 2012); *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002); *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 989 (Fed. Cir. 1999).

“uniformly,” or “repeatedly” using features; or provides an “implied definition.”<sup>2</sup>

The court’s ongoing claim-construction rulings, split for decades between these conflicting sets, have only deepened the confusion among the patent system’s stakeholders.

3. The Federal Circuit’s precedential divide has created confusion as to what the court’s claim-construction principles even *are*, let alone how they apply. Indeed, on any given oral-argument week at the Federal Circuit, one panel may be applying the “heavy-presumption” line in one courtroom while, across the hallway, another panel may be applying the “holistic” line. The court’s split jurisprudence thus violates not only this Court’s precedents emphasizing the need for clear, consistent and predictable principles for property rights and claim construction; but also Congress’s statutory command for clear, “particular[],” and “distinct” claim terms, 35 U.S.C. § 112, ¶2; *Festo*, 535 U.S. at 730-31 (stakeholders should be able to apply clear construction rules and “*should know what* [the

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<sup>2</sup> *E.g.*, *Markman Eight Years Later: Is Claim Construction More Predictable?* by Kimberly A. Moore, 9 LEWIS & CLARK L. REV. 231, 246-47 (2005) (recounting Professor [now-Judge] Moore’s description of Federal Circuit’s claim-construction split between “procedural” (or “heavy-presumption”) set of cases and “holistic” set); *Kinetic Concepts v. Blue Sky Med. Grp.*, 554 F.3d 1010, 1017-19 (Fed. Cir. 2009); *Abbott Labs v. Sandoz, Inc.*, 566 F.3d 1282, 1288-89 (Fed. Cir. 2009); *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1308 (Fed. Cir. 2007); *On Demand Machine Corp. v. Ingram Indus. Inc.*, 442 F.3d 1331, 1338-39 (Fed. Cir. 2006); *Nystrom v. TREX Co.*, 424 F.3d 1136, 1142-44 (Fed. Cir. 2005); *Bell Atlantic Network Serv. v. Covad Comm’ns*, 262 F.3d 1258, 1268-71 (Fed. Cir. 2001); *SciMed Life Sys., Inc. v. Adv. Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001).

patentee] owns, and the public should know what he does not”) (emphasis added); *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S.Ct. 2120, 2129 (2014). (§ 112, ¶2 “mandates clarity”).

The consequences of this confusion are real. For example, with two starkly different sets of interpretative law, determining the scope of a patent claim and its corresponding value becomes even more difficult. Moreover, since claim construction affects virtually every issue for every patent in every patent case, the uncertainty created by the Federal Circuit makes it all the more difficult for litigants to assess potential outcomes—and to decide whether and when to settle, or on what terms. Most of all, having two sets of conflicting laws on a matter of such importance—claim construction—upsets core notions of what law is and should be: clear, consistent, uniform, predictable.

4. This case highlights the need for this Court’s intervention and to decide whether “heavy-presumption” or “holistic” precedents are controlling. Indeed, the choice of one or the other is often case-dispositive, as it was here.

Akeva’s ’126 patent claims and four “Continuation Patents” relate to improvements in athletic shoes. App.2a. In applying a holistic claim-construction approach, however, the Federal Circuit construed the claim term “*rear sole secured*” without even addressing the claim text itself, as Akeva had urged, let alone ascribing the term a “heavy presumption” that its ordinary meaning applied. *Id.* The court’s 15-page opinion thus failed to address even once that the claim text—“*rear sole secured*”—denoted having a rear sole “*fixed*” to the shoe—regardless of duration—thus encompassing Defendants’ accused athletic shoes.

Indeed, the Federal Circuit disregarded the “heavy-presumption” rule and the “exacting” standard required for its two exceptions (for disclaimer and lexicography). And it never recognized (as other courts do) that the role of the patent claims is to “claim” or define the invention, while the written description and rest of the specification teach and illustrate how one may practice the invention. App.6a-10a. The panel instead focused on Akeva’s specification and found that its various “examples” of “the present invention” effectuated a “clear disclaimer” such that the claimed “rear sole *secured*” could *not* encompass shoes with a “conventional *fixed* rear sole.” *Id.* Even then, the panel failed to identify a single specification discussion that could meet the “*exacting*” standard to overcome the “heavy presumption” of ordinary meaning and restrict Akeva’s asserted claims. *Id.* After all, examples illustrate the invention, not limit it.

The most the Federal Circuit could do was identify the specification’s “multitude of *embodiments* and other non-limiting “*example[s]*” of what the Akeva patents “*contemplate[d]*.” *Id.* The panel thus failed to recognize that such embodiments and specification teachings cannot properly limit a claim’s scope or meaning. *E.g.*, *Continental Circuits*, 915 F.3d at 795-99 (specification’s description of embodiments did not limit claim).

Moreover, the panel purportedly found additional disclaimer support based on the specifications’ “disparagement” of prior-art conventional shoe designs and recognition that “*the present invention related generally to an improved rear sole.*” App.7a-8a (emphases added). But even then, it did not acknowledge the multiple precedents rejecting such “present invention” and

“disparagement” language as insufficient to meet the “exacting” disclaimer standard. *E.g.*, *Continental Circuits*, 915 F.3d at 795-98 (rejecting notion that “because the patentees repeatedly disparaged” a prior-art process, the patent had effectuated a disclaimer); *Absolute Software, Inc. v. Stealth Signal, Inc.*, 659 F.3d 1121, 1136-37 (Fed. Cir. 2011) (specification’s use of “the present invention” did not limit claim); *Voda v. Cordis Corp.*, 536 F.3d 1311, 1320-22 (Fed. Cir. 2008) (same). As seen above, application of the court’s “heavy-presumption” precedents would have surely led to a different plain-meaning construction for “rear sole secured”—and a different summary-judgment result. Notably, the panel’s analysis never identified specification statements restricting the “rear sole secured” to “permanent” or “temporary fixes” or the like. Yet its erroneous analysis, predicated on specification examples, produced that same claim construction and summary-judgment result.

5. The extensive scholarly analysis on the Federal Circuit’s “feuding” claim-construction cases has duly confirmed the *harms* that this conflict has imposed—both on patent stakeholders and to the cause of innovation. In short, with all such stakeholders unable to reliably predict the scope of U.S. patent rights, investors and innovators alike have grown to distrust the U.S. patent system and the protections it does (or does not) offer. With that lack of legal predictability, investment in research-and-development—and efforts to invent generally—have diminished, including in the pharmaceutical and medical industries. Section V, A., n.12, *infra*.

The Federal Circuit’s en-banc *Phillips* decision has contributed to that harm. For all its promise of

resolving key conflicting cases, *Phillips* resolved only one short-lived “*Texas Digital*” issue, but otherwise offered the proverbial “something for everyone” recitation of law. Further, the Federal Circuit issued *Phillips* in 2005—more than 15 years ago, reflecting its ongoing stance against revisiting (and resolving) these fundamental construction issues.

In the end, allowing two separate-and-conflicting lines of cases control arguably the single most important issue in all of patent law—claim construction—has undermined the very purpose of having patent laws: “To promote the Progress of Science.” U.S. Const., Art. I, § 8.



## STATEMENT OF THE CASE

Many of the following patent-specific facts and practices warrant mention as case background only. Nevertheless, for completeness, Akeva offers the following.

\* \* \*

David Meschan, an avid runner, is the named inventor of Petitioner Akeva's portfolio of athletic footwear patents. These patents include (1) the '126 patent that, on summary judgment, the Federal Circuit found *not* infringed by Defendants' "conventional fixed" shoes, i.e., permanently-fixed and non-rotatable rear soles; and (2) Akeva's four "Continuation Patents" that the Federal Circuit held invalid as anticipated by Defendants' accused shoes.<sup>3</sup>

### **The Problems with Shoe Wear and Mid-Sole Compression—and the Akeva Patents' Solutions Thereto**

Starting around 1993, Mr. Meschan and Akeva's patent applications identified certain problems with the heel region of athletic footwear. These included: (1) rear soles becoming "extremely" worn at the outer "peripheral edges" of the shoe's rear sole after repeated use; and (2) the rear midsole losing its cushioning performance from repeated "midsole compression." App.2a.

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<sup>3</sup> U.S. Patent Nos. 5,560,126; 6,966,130; 7,114,269; 5,380,350; and 7,540,099.

For these different problems, Akeva's patents provided solutions. The '126 patent-in-suit, for example, disclosed a "*flexible-plate*"/graphite insert technology—e.g., having a "stiff but flexible" plate in the shoe's "heel region." App.29a. This "flexible plate" provided "trampoline"-like spring to alleviate "midsole compression" and add "spring to a user's gait." *Id.* As Akeva explained below, its '126 patent's scope broadly includes shoes with permanently attached and fixed rear soles, in addition to those that are detachable and/or rotatable. App.29a-31a.

The Defendants, to be sure, have long known of Akeva's patented technology. Mr. Meschan had contacted each Defendant in the mid-1990s and addressed it with them. A7688 (from record below). Each Defendant, however, declined to license Akeva's patents. Thereafter, each used, sold, and profited from them. Litigation followed.

### **Akeva's '300 ("CIP") Patent**

As noted above, Akeva asserted in this case four "Continuation Patents," each of which claimed priority (the "effective filing date") to Akeva's earliest-filed '126 patent (with an August 17, 1993, priority date). App.3a. Akeva sought this "through a chain of intervening continuations [or applications filed with the Patent and Trademark Office (PTO)]." *Id.* One of the patents in this "chain" included Akeva's earlier-litigated '300 patent.

The '300 patent is a continuation-in-part (CIP) of Akeva's '126 patent-in-suit. A CIP "is just what its name implies. It partly continues subject matter disclosed in a prior application, but it adds new subject matter not disclosed in the prior application."

*University of W. Va. v. VanVoorhies*, 278 F.3d 1288, 1297 (Fed. Cir. 2002). “Thus, some subject matter of a CIP application is necessarily different from the original subject matter.” *Id.*

### **The *Akeva I* Litigation**

In 2006, in a separate *Akeva* lawsuit, the Federal Circuit concluded the ’300 patent asserted in that earlier case had disclaimed coverage for shoes using conventional fixed rear soles—i.e., “permanently-fixed rear soles that do not rotate.” *Akeva L.L.C. v. Adidas-Salomon AG*, 208 F. App’x 861, 864-65 (Fed. Cir. 2006) (“*Akeva I*”). As a CIP, the ’300 patent necessarily included *different matter* than (among others) *Akeva’s* ’126 patent. *Id.* The *Akeva I* court thus purposely construed the ’300 patent’s own claim term—“*[rear sole] secured*”—without reference to *Akeva’s* ’126 patent. *Id.* And it affirmed summary judgment that the accused shoes did *not* infringe the ’300 claims if they had “permanently fixed” and non-rotatable rear soles. *Id.*

### **This Lawsuit, *Akeva’s* ’126 Patent-in-Suit, and Defendants’ Accused Athletic Shoes**

This litigation began in October 2009 when ASICS sued *Akeva* in the Middle District of North Carolina, seeking a declaratory judgment that, *inter alia*, the ASICS shoes were not infringing certain *Akeva* patents. *Akeva* counterclaimed for infringement, added Nike and other Defendants, and streamlined its case to assert five patents: The ’126 patent and Continuation Patents. Between stays and settlement discussions, the case’s claim-construction hearing did not occur until March 2016. *See, e.g.*, App.23a. Three years later, in March 2019, the magistrate judge issued an R&R on the ’126 patent’s own disputed

“*rear sole secured*” term and Defendants’ summary-judgment motions. It recommended the trial court grant the respective motions for non-infringement and invalidity. App.23a. The district court agreed and summarily adopted the R&R in July 2019. App.19a-21a.

### **The District Court’s Analysis of the ’126 Patent Claims**

Defendants urged that “*rear sole secured*,” as used in representative claim 25 of the ’126 patent, could *not* encompass shoes with (a) “conventional” permanently-fixed rear soles and (b) did not detach or rotate. *Id.* Claim 25 recites:

25.A shoe comprising:

an upper having a heel region;

a *rear sole secured* below the heel region of the upper; and

a *flexible plate* having upper and lower surfaces and supported between at least a portion of the *rear sole* and at least a portion of the heel region of the upper, peripheral edges of the plate being restrained from movement relative to an interior portion of the plate in a direction substantially perpendicular to a major axis of the shoe so that the interior portion of the plate is deflectable relative to the peripheral edges in a direction substantially perpendicular to the major axis of the shoe.

App.32a. (emphases added). In granting summary judgment of non-infringement, the district court addressed three main points.

First, citing the differences between the two patents' specifications, the court declined collateral estoppel or to construe the asserted '126 claims in view of the previously-litigated '300 (CIP) claims in *Akeva I*. App.5a.

Second, the court concluded that, as a matter of construction, the '126 specification *still* independently disclaimed subject matter so that the term "*rear sole secured*" required the following:

- a rear sole "*detachable*" from the shoe itself or "*attached [to the shoe] and rotatable*"; and
- a rear sole "*selectively or permanently fastened*" to the shoe, "*but not permanently fixed into position,*" *i.e.*, a rear sole that "can be rotated or replaced, but *not* permanently fixed in position."

App.39a-41a (emphases added).

Third, that the PTO examiner herself construed the term "*secured*" differently during prosecution also did not sway the district court. App.55a-56a. Unlike the courts, the PTO examiner applied the term's "ordinary meaning." *Id.* Notwithstanding this "direct conflict," the court declined to accord the agency's expert (the examiner) any "presumption of correctness" or deference to her "ordinary meaning" construction. *Id.* Further, the district court concluded that, as in *Akeva I*, the accused shoes here indisputably had permanently attached and non-rotatable rear soles. App.57a. It thus concluded those shoes could not infringe *Akeva's* '126 claims based on its "rear sole secured" construction. *Id.*

### The District Court's Analysis of the Continuation Patents

As for Akeva's Continuation Patents, the district court reasoned that *if* these Patents could *not* claim priority to the '126 patent's earlier 1993 filing date, then the Nike and other shoes Akeva accused of infringement would actually pre-date, and anticipate, those claims, rendering them invalid. 35 U.S.C. § 102; *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889) ("That [accused product] which infringes, if later, would anticipate [the same claim], if earlier.").

The district court so concluded. It summarized its patent-specific invalidity ruling as follows: "In light of this court's *Akeva I* ruling that the '300 patent specification" *and* the '126 specification had each *disclaimed* conventional fixed rear sole shoes, Akeva's amendments to the Continuation Patents' specification had the effect of impermissibly "add[ing]" new matter and broadening the scope" of those Patents. *Id.* at 52a-56a. Those Continuation Patent claims thus could *not* assert priority to August 1993 (again, the effective filing date for Akeva's '126 patent). *Id.* And since Defendants' accused shoes were on sale *before* the Continuation Patents' *later* filing date with the PTO, those claims were "invalid under 35 U.S.C. § 102 to the extent they purportedly included shoes with" conventional fixed rear soles. *Id.* at 58a.

**The Federal Circuit Affirms Summary  
Judgment, Applying *Holistic* Principles to  
Construe “*Rear Sole Secured*.”**

The Federal Circuit affirmed. Among other things, it agreed that the term “*rear sole secured*,” as used in the ’126 claims, meant a rear sole “selectively or permanently fastened but not permanently-fixed into position.” *E.g.*, App.3a, 5a. In so doing, the Federal Circuit panel here made plain its “holistic” choice. As law, for example, the panel omitted mention of claim-construction standards requiring a “heavy presumption” of ordinary meaning for claim terms, or “exacting” disclaimers or re-definitions. *E.g.*, App.6a-8a. Indeed, the panel did *not* address the claim text at all, much less ascribe an ordinary meaning to “rear sole secured.” *Id.* at 7a-10a. It never considered, for example, Akeva’s plain-meaning argument or that “*secured*” itself means “fixed”—regardless of whether that fix is “permanent” or temporary. *E.g.*, App.31a. Nor did it identify the different roles played by the claims versus the patent specification (written description).

The panel instead began (and ended) its construction by focusing on the ’126 *specification*, *i.e.*, the patent sections directed to teaching and disclosing the invention, *not* defining its claimed boundaries. *E.g.*, 35 U.S.C. § 112, ¶1; *Ariad Pharmaceuticals, Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1346-47 (Fed. Cir. 2010) (en banc). Specifically, the panel relied on specification statements that explicitly described “*example[s]*” and “*embodiments*” of “*the present invention*” and “*disparaged*” prior-art conventional fixed shoes, “generally,” for their uneven wear-and-tear and cushion-performance loss. *Id.* For another

specification section it relied on, the “Summary of Invention,” the panel omitted mention that the ’126 specification itself emphasized that the statements there and elsewhere provided a “*general description*” that was “*exemplary and explanatory only and are not restrictive of the invention as claimed.*” ’126 Patent, col. 3:43-46 (emphases added).

The balance of the Federal Circuit’s analysis followed this track. Pointing to the specification’s “Description of Preferred Embodiments,” for example, the court stressed that the “*multitude of embodiments*” illustrated “examples” of shoes with “detachable or rotatable” rear soles. App.9a. And it rejected multiple arguments on grounds that the “*purpose of the invention*” was to overcome “rear sole wear” with “detachable or rotatable” soles. *Id.* at 8-10. In its view, the ’126 specification did not “*contemplate[]*” having a “conventional fixed rear sole.” *Id.* at 9, 11. Thus, as the accused shoes had “permanently-fixed” and non-rotatable rear soles, they could not infringe the asserted ’126 claims, entitling Defendants to summary judgment.

As to Akeva’s Continuation Patents, the Federal Circuit affirmed summary judgment of anticipation by the accused shoes. Anticipation occurs if a single prior-art reference, such as a prior product, discloses each-and-every element of a claim. 35 U.S.C. § 102. As addressed by the district court (above), Akeva had to avoid anticipation by showing its Continuation Patents had sufficient disclosure in Akeva’s earlier-filed ’126 patent. But the Federal Circuit agreed the ’126 specification did *not* disclose such support for Akeva’s Continuation Patents. App.14a. As with the district court, the panel relied on the same analysis

of the specification described above—*i.e.*, specification statements that allegedly disclaimed “conventional fixed” rear soles. *Id.* It affirmed the trial court’s analysis and invalidity judgment accordingly. *Id.* This Petition follows.



## REASONS FOR GRANTING THE PETITION

### **I. THE FEDERAL CIRCUIT SHOULD *NOT* HAVE TWO *DIFFERENT*, OFT-CONFLICTING AND *UNPREDICTABLE* SETS OF CASES GOVERNING CLAIM CONSTRUCTION—AN ISSUE THAT AFFECTS VIRTUALLY *EVERY* PATENT.**

The claim-construction issues in this case highlight the fundamental and long-standing split within the Federal Circuit’s precedents—a split that undermines the consistency, predictability, and public notice emphasized by this Court’s precedents. *See, e.g., Nautilus*, 134 S.Ct. at 2124; *Markman*, 517 U.S. at 373. Given this intra-court split and its profound consequences for the U.S. patent system of innovation and “progress,” this Court should grant *certiorari* and resolve these core questions.

#### **A. A Patent Is a Property Right That Requires Uniform, Consistent and Predictable Rules of Interpretation to Provide Clear Boundaries.**

Authorized by the Constitution “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries,” Art. I, § 8, cl. 8, Congress has enacted patent laws to incentivize and reward inventors with a limited monopoly. “Th[at] monopoly is a property right” and, “like any property right, its boundaries should be clear.” *Festo*, 535 U.S. at 730; *Markman*, 517 U.S. at 373 (“It has long been under-

stood that a patent must describe the exact scope of an invention”).

Indeed, as this Court explained more than a century ago, a patent and the claims recited at the end of that document’s specification are “aptly likened” to a deed that defines real property. *Motion Picture Patents*, 243 U.S. at 510. Both the deed and claim must recite with clarity and “particularity” the “boundaries” of the owner’s property rights. *Id.*; 35 U.S.C. § 112, ¶2. In that way, both the deed and claims provide public notice to potential purchasers and trespassers about the scope of their property rights. *Id.* That public notice becomes all the more important when, as with the law generally, ignorance of a patent is no defense; infringers are strictly liable for directly infringing a patent claim—regardless of any knowledge of the patent. *Commil*, 135 S.Ct. at 1926.

Accordingly, having consistent and predictable rules on claim construction is critical to ensuring that patents and the patent system are meeting the public-notice function of the patent law. *See, e.g., Markman*, 517 U.S. at 373 (patent must be precise enough to afford clear notice of what is claimed, thereby “appris[ing] the public of what is still open to them”) (citation omitted). “Otherwise there would be [a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infring[ing] claims.” *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236-37 (1942) (citation omitted).

Each of these purposes of the patent laws—clarity, consistency, predictability, and public notice—are vital to promoting innovation and investment,

the very reasons for having a patent system. U.S. Const., Art. I, § 8, cl. 8. Indeed, *without* stable, clear, and predictable principles to apply and define this property right, the incentives to invest in innovation—and to invent generally—become less “efficient,” as this Court has explained:

The patent laws “promote the Progress of Science and useful Arts” by rewarding innovation with a temporary monopoly . . . . The monopoly is a property right; and like any property right, its boundaries should be clear. This *clarity is essential to promote progress, because it enables efficient investment in innovation. A patent holder should know what he owns, and the public should know what he does not.*

*Festo*, 535 U.S. at 730-31 (emphasis added). Conversely, a patent system that lacks clear standards, consistency, and predictability will *not* attract the investment needed to fuel innovation.

### **1. Congress Created the Federal Circuit to Make Patents and Patent Law Clear, Consistent and Predictable.**

Congress understood this. Prior to 1982, patentees and other stakeholders were subject to conflicting decisions from the regional circuit courts.<sup>4</sup> Thus, in

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<sup>4</sup> *E.g.*, Elizabeth I. Rogers, *The Phoenix Precedents: The Unexpected Rebirth of Regional Circuit Jurisdiction Over Patent Appeals and the Need for a Considered Congressional Response*, 16 HARV. J.L. & TECH. 411, 421 (2003) (“[S]tudies exposed particularly egregious problems of a lack of uniformity in patent cases”).

an effort to harmonize and revive the U.S. patent system, Congress passed the Federal Courts Improvement Act—the legislation that created the Federal Circuit. 96 Stat. 25 (enacted April 2, 1982). Congress did this for a specific purpose: To place exclusive jurisdiction over the patent laws in a single court that would reconcile these conflicting decisions and provide greater uniformity and predictability.<sup>5</sup> With improved consistency and predictability, the patent laws—including the Federal Circuit’s rulings—could better define the scope of those patent rights; better serve the public-notice function; and better protect patent owners and the public alike. And it would promote greater confidence in the patent system and spur greater investment and innovation. *See, e.g., id.*

## **2. Claim Construction Affects Virtually Every Issue in Every Patent Litigation.**

Having uniform rules of interpretation remains crucial for another reason: Claim construction affects virtually *every* merits issue in patent litigation.<sup>6</sup> Indeed, interpreting a claim is a prerequisite for determining, *inter alia*, infringement, invalidity, equitable issues, and remedies.<sup>7</sup> Thus, when the underlying claim-construction principles themselves are uncertain, the analysis of those merits issues is uncertain. Courts

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<sup>5</sup> H.R. Rep. No. 312, 97th Cong., 1st Sess. 20-23; *Phillips*, 415 F.3d at 1330.

<sup>6</sup> *E.g.*, Mark A. Lemley, *The Changing Meaning of Patent Claim Terms*, 104 MICH. L. REV. 101, 105 (2005) (“The claims of a patent are central to virtually every aspect of patent law.”).

<sup>7</sup> *E.g., id.*

and litigants thus cannot reach consensus on merit issues that would help facilitate resolution or settlement. Accordingly, because the claim-construction rules are themselves unpredictable and split into two distinct sets or lines (“heavy-presumption” vs. “holistic”), parties have every incentive to continue litigating those patent issues affected by claim construction through appeal. *See Teva Pharm. USA v. Sandoz, Inc.*, 135 S.Ct. 831, 837-38 (2015).

## II. AFTER 20-PLUS YEARS, THE FEDERAL CIRCUIT REMAINS DIVIDED ON CLAIM CONSTRUCTION—UNDERMINING PREDICTABILITY, PUBLIC NOTICE, AND INCENTIVES TO INVENT.

Despite the overarching need for consistency and predictability, the law on claim construction—arguably the most important issue of all—is riven with Federal Circuit precedents that are starkly inconsistent and unpredictable. Since the late 1990s, the Federal Circuit’s precedents have reached claim constructions that have accorded “heavy-presumption” primacy to the claim text and its “ordinary meaning” on the one hand—but on the other, have ignored that text and restricted claims based on the specification.<sup>8</sup> In short, the court is split and its claim-construction rulings often turn on the composition of the panel randomly assigned to the appeal. These rulings break into two divergent camps.

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<sup>8</sup> *E.g., Markman Eight Years Later*,” Moore, 9 LEWIS & CLARK L. REV. at 246-47 (Federal Circuit’s claim-construction rulings fall into “procedural” (“heavy-presumption”) set or “holistic” set).

**A. The Federal Circuit’s “Heavy Presumption” Cases Focus on Claim Text’s Ordinary Meaning and Consider the Specification “Only” for Two “Exacting” Exceptions.**

In one line, the court “indulge[s] a heavy presumption that a claim term carries its customary and ordinary meaning.” *Starhome*, 743 F.3d at 857 (citation omitted). And it will “depart from the plain and ordinary meaning of claim terms based on the specification in *only two instances: lexicography and disavowal.*” *Hill-Rom*, 755 F.3d at 1371 (emphasis added). These precedents underscore the rigor of these two “exceptions,” saying they are “exacting” and not readily met. *Id.* On that point, they often contrast the roles played by the “terse” claim text in defining the claims’ inventive boundaries, versus the specification (or “written description”) role in disclosing and enabling the invention. *E.g.*, *Continental Circuits*, 915 F.3d at 797; 35 U.S.C. § 112, ¶1.

Unlike many holistic precedents, this line focuses on the claim term’s meaning, often using dictionaries to define it. *E.g.*, *id.*; *CCS Fitness*, 288 F.3d at 1366-67. Unlike holistic precedents, the heavy-presumption cases often invoke the precedential rule that disclosing only a “single embodiment” in the specification cannot alone restrict a claim term’s scope. *E.g.*, *Hill-Rom*, 755 F.3d at 1371.

\* \* \*

The emphasis on claim text often proves dispositive. In *Continental Circuits*, for example, the Federal Circuit reversed summary judgment of non-infringement based on the district court’s erroneous

construction that patents claiming “dielectric,” “surface,” and “epoxy” “tooth” requirements for microchips also required the “double-desmear process” described in the specification. 915 F.3d at 796-97. Applying heavy-presumption precedents, the court explained that these claims do *not* “actually recite a ‘repeated desmear process.’” *Id.* (citing *Thorner, supra*).

Further, *Continental* held that none of the cited specification statements about this process constituted “a clear and unmistakable disclaimer.” *Id.* *Continental* thus stressed that the purposes of the specification are to teach and enable the invention, not define it. *Id.* Given this, the multiple specification statements in *Continental* about how “*the present invention can*” use this double-desmear process, how it differed “starkly” from “all known teachings in the prior art,” and that it “is greater than” those prior-art processes, did *not* effectuate a clear disclaimer. *Id.* Rather, those specification statements occurred “overall” in the context of describing merely an “*example*,” “*one technique*,” or even “a ‘new’ way” for making the claimed “electrical device” and “teeth,” rather than a “clear disavowal of claim scope.” *Id.*

*Continental* also brushed aside arguments that the specification had “disparaged” other prior art, for example, and limited the claims. *Id.* at 798. “We have held that [m]ere criticism of a particular embodiment . . . is not sufficient to rise to the level of clear disavowal.’ Thus, comparing and contrasting the present technique to that of the prior art does not ‘rise to the level of [a] clear disavowal’ of claim scope.” *Id.* (citation omitted).

“Similarly,” held *Continental*, the specification’s repeated references to “*the present invention*” did not

restrict the claims either, much less meet the “exacting” disclaimer standard. *Id.* at 799-80. As *Continental* and other “heavy-presumption” precedents have explained, that “present invention” phrase is *not* limiting when, for example, the “references . . . are not uniform,” “do not characterize the present invention ‘as a whole,’” or “do not support applying the limitation to the entire patent.” *Id.* And “the present invention” references in the *Continental* patents occurred in the “context” of describing examples—*not* the claimed invention. *Id.*

Reversing the district court, *Continental* concluded as follows: That the claim’s “plain and ordinary meaning” applied, per the “heavy-presumption” rule, and thus did *not* require the desmear process described only in the patent’s specification, *not* its claim text. *Id.* Federal Circuit panels have on-and-off applied these “heavy-presumption” rules since the late 1990s.<sup>9</sup>

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<sup>9</sup> *E.g.*, *Hill-Rom*, 755 F.3d at 1372-74 (reversing judgment for accused infringer based on erroneous “*datalink*” construction as limited to the physical cable disclosed in specification; claim’s plain meaning did not preclude wireless connections and arguments about the term lacking sufficient § 112 support could not change construction when meaning was clear); *Thorner*, 669 F.3d at 1365-68 (construing “*attached*” to cover external and internal attachments, given term’s plain meaning and specification evinced no disclaimer); *Teleflex, Inc. v. Fiscosa N. Am. Corp.*, 299 F.3d 1313, 1325-28 (Fed. Cir. 2002) (applying “heavy presumption” and rejecting “single embodiment” argument); *CCS Fitness*, 288 F.3d at 1366-67 (construing “reciprocating member” as *not* restricted by specification’s lone embodiment of exercise bar); *Johnson Worldwide*, 175 F.3d at 989-90 (same methodology).

**B. *Other* Federal Circuit Precedents Restrict a Claim Term’s Meaning Based on the Specification—*Regardless* of “Heavy Presumption” or “Exacting” Exceptions.**

In the “holistic” line, Federal Circuit panels have defined a claim term based on the specification—without any “heavy presumption” of ordinary meaning for the claim text or an “exacting” disclaimer-or-definition standard.

In *Nystrom*, for example, the court limited the term “board” to wood boards, even though the claim and specification said nothing about requiring wood. 424 F.3d at 1142-44. Rather, reasoned the court, the specification “consistently used the term ‘board’ to describe” flooring for boards on a deck. *Id.* The *Nystrom* court thus effectively applied an opposite test than the “heavy-presumption” cases, saying it could *not* construe a claim term as broad enough to cover a definition otherwise found in a dictionary or other “ordinary meaning” source—*not* unless “*something* in the [specification] and/or prosecution history” illustrated that construction. *Id.* at 1145. As with other “holistic” cases, *Nystrom* necessarily relied on the oft-stated principle that patentees cannot claim more broadly than what the specification “has described as the invention.” *Id.*; accord *Abbott v. Sandoz*, 566 F.3d at 1288.

The Federal Circuit has taken this holistic approach in numerous cases over decades.<sup>10</sup> The

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<sup>10</sup> *E.g.*, *Kinetic Concepts*, 554 F.3d at 1017-19 (construing “wound” to exclude “pus pockets” when specification repeatedly illustrated single embodiment of “skin” wounds only, even though it did not demonstrate clear disclaimer); *Sandoz*, 566 F.3d at 1288-89

problem is that, for some 20-plus years, patentees, the public, courts and other stakeholders do not know when one line of authorities or the other will apply, and often not until *after* the Federal Circuit panel itself finally decides after years of costly litigation and spent judicial resources.

### 1. The Holistic Precedent’s Factors Affecting Claim Construction.

The holistic cases are themselves often unpredictable as to what aspect of the specification or analysis thereof they might newly rely on to affect the scope of the claim-at-issue. Nevertheless, claim-construction precedents across three decades have pointed up the following as sign-posts indicative of the holistic line and when the cases therein may restrict the claim term-at-issue:

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(restricting term “crystalline” to specification’s “Crystal A” example); *Verizon*, 503 F.3d at 1308 (restricting term based on specification statements describing “*the present invention*”); *On Demand*, 442 F.3d at 1338-39 (confining “sales information” to “promotional sales text and color graphics” described in specification even though it did not show disclaimer); *AquaTex*, 419 F.3d at 1380 (construing “fiberfill” as excluding “natural materials” when specification “consistently used th[at] term . . . to refer to synthetic materials”); *Bell Atlantic*, 262 F.3d at 1268-71 (restricting term based on “implied definition”); *SciMed*, 242 F.3d at 1343-44 (limiting “lumen” to “coaxial lumen” only, given specification statements indicating “all embodiments” and “the present invention” used particular structure); *Watts*, 232 F.3d at 882-83 (limiting “sealingly connected” to specification’s “misaligned taper angles” when term was “not clear on its face”); *Toro*, 199 F.3d at 1301 (limiting term based partly on specification statements describing ring and “cover” as “important to the invention”); *Wang*, 197 F.3d at 1382-83.

- The holistic decision makes little or no reference to the disputed claim text;
- It does not apply the “heavy presumption” of an “ordinary meaning” for the disputed term;
- It does not emphasize the “exacting” disclaimer/lexicography standard;
- The holistic approach limits claim scope based on specification statements describing “*the present invention.*” *e.g.*, *Verizon*; *SciMed*, n.11; or
  - Specification statements that *disparage* the prior art—as the panel here did, App.8a; or
  - the specification’s embodiments have “consistently,” “uniformly” or “repeatedly” used features a particular way, *e.g.*, *Nystrom*; *AquaTex*, at n.11; or
  - the specification defined a term “*by implication,*” *Bell Atlantic*, 262 F.3d at 1268-71.
- The claim-at-issue purportedly lacks sufficient specification support, *e.g.*, *Abbott v. Sandoz*, n.11.

As these points alone illustrate, the differences between the holistic and heavy-presumption lines are long-standing, easy-to-spot—and often outcome-determinative.

### III. THE FEDERAL CIRCUIT’S UNPREDICTABLE AND CONFLICTING PRECEDENTS DISREGARD THE “CLARITY” MANDATED BY SECTION 112, ¶2.

The court’s lines of authorities are not only oft-conflicting, but also unpredictable and inconsistent: A patentee or other stakeholder can never know which line of cases will apply to which patent, or when. The patent laws should *not* have such conflict and confusion on any issue of note, but especially not claim construction. In that respect, the Federal Circuit’s split jurisprudence—and the confusion it induces—violate the clarity that Congress mandates for patent claims under 35 U.S.C. § 112, ¶2.

This Court has long read that provision’s “definiteness” standard, 35 U.S.C. § 112, ¶2, to require that claims, viewed in light of the specification and prosecution history, must inform those of ordinary skill in the art about the scope of the claimed invention with “*reasonable certainty*.” *Nautilus*, 134 S.Ct. at 2124 (emphasis added). Indeed, the Act’s “definiteness requirement [for claims] . . . *mandates clarity*.” *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261, 270 (1916) (emphasis added); *Markman*, 517 U.S. at 373; *id.* at 373 (patent must afford clear notice of what claim covers, “appris[ing] the public of what is still open to them”); *United Carbon*, 317 U.S. at 236 (“claims must be reasonably clear-cut”). “Otherwise there would be ‘[a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infring[ing] claims.’” *Id.* at 236-37.

Here and beyond, the Federal Circuit’s perpetuation of these oft-conflicting lines of claim-construction canons disregards the “clarity,” “clear notice,” and “reasonable-certainty” standards required by the

Patent Act and this Court. After all, parties cannot know if the law that applies to claim construction today will focus on the claim and even accord it a “heavy presumption of ordinary meaning,” section II.A., *supra*, or—as the Federal Circuit’s decision here illustrates—it will accord *no* such importance to the claim text and focus on the specification and embodiments illustrated therein, section II.B., *supra*.

Here and beyond, the parties cannot know if the law *today* will impose an “exacting” standard and require “clear” evidence of disclaimer to overcome a term’s presumptive ordinary meaning, *see, e.g.*, section II.A., *supra*—or if no such standards will apply, leaving claim construction to the “holistic” feel about what the disputed “present invention” should cover, section II.B., *supra*.

Here and beyond, the parties cannot know if the law today will indeed continue to confine the “exceptions” to a claim’s presumed ordinary meaning, section II.A., *supra*—or if it will permit broader (and even unforeseen) uses of the specification to affect claim scope—*e.g.*, determinations that the specification “consistently” or “repeatedly” uses a feature a certain way; describes “the present invention” in ways that restrict claim scope; or “disparages” in a claim-limiting way, section II.B.

### **A. The Federal Circuit Developed This Precedential Split, *Not* Harmonized It.**

As noted above, Congress created the Federal Circuit in 1982 to harmonize the conflicting patent-law decisions of the regional circuits. But over the course of some 15-to-20 years, the Federal Circuit has done the opposite for claim-construction law: It

created and has perpetuated this “heavy-presumption” versus “holistic” divide. That is all the more reason why this Court should now resolve these claim-construction deficiencies, consistent with Congress’s mandate for claim clarity. *See* 35 U.S.C. § 112, ¶2; *Nautilus*; *Markman*; *Minerals Separation*; *United Carbon*, *supra*.

#### IV. THIS IS AN IDEAL CASE FOR RESOLVING THE FEDERAL CIRCUIT’S *HEAVY PRESUMPTION* VERSUS *HOLISTIC* DIVISION.

This is the right case to decide these issues. As noted, the panel here assuredly applied holistic rules to construe “*rear sole secured*,” restrict that term based on specification “examples,” and uphold summary judgment of non-infringement and invalidity.

##### A. The Panel Used “Holistic” Principles.

Here, the panel plainly did *not* use the Federal Circuit’s “heavy-presumption” precedents. Its 15-page opinion did not attempt to parse the claim text-at-issue (“*rear sole secured*”), nor accord it a “heavy presumption” that its “ordinary meaning” applied. App.6a-8a. Nor did it mention the “exacting” standard required for “clear” disclaimers. *Id.* Rather, the panel relied on several telltale holistic factors, applying some to limit the claimed “*rear sole secured*.” Section II.B., *supra*. For example, citing holistic cases such as *SciMed*, *supra*, the opinion relied on ’126 *specification* statements that:

- described “*the present invention*” as “*relating generally* to an improved rear sole for footwear . . . in terms of cushioning and spring,” App.7a;

- “*disparage[d]* [prior-art] conventional design[s]” for shoes, App.8a, 10a;
- disclosed in the “*Preferred Embodiments*” section a “multitude of embodiments” as uniformly or “consistently” having “detachable or rotatable rear soles,” App.9a, 11a; and
- did not “contemplate[] as part of the invention” coverage for “conventional fixed” rear soles, App.13a.

All told, however, the panel could not identify a single discussion in Akeva’s asserted patents that alone met the “*exacting*” standard and demonstrated a “clear” disclaimer—one that would impose the “rear sole” constructions that the Federal Circuit described as merely “*contemplate[d]*” by the patents’ specification, *id.*

### **B. Application of “Heavy-Presumption” Rules Would Have Led to Different Results.**

Beyond that, the application of “heavy-presumption” rules here would have produced different results. The plain meaning of “rear sole *secured*” does *not* exclude “conventional *fixed*” soles. *E.g.*, “secured” definition-Bing (defining “*secured*” as “fix or attach (something) firmly so that it cannot be moved or lost. ‘[P]ins secure the handle to the main body.’”); *CCS Fitness*, 288 F.3d at 1366 (“[O]ur precedents show that dictionary definitions may establish a claim term’s ordinary meaning”) (collecting cases).

Rather, the ordinary meaning of “secured” indicates the term is sufficiently broad as to cover *both* permanently *and* temporarily “*fixed*” (or “secured”)

rear soles. *See, e.g., Thorner*, 669 F.3d at 1365-68 (construing term “*attached*” as broad enough to cover both external and internal attachments, given term’s plain meaning and specification’s lack of disclaimer); *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) (“[I]f an apparatus claim recites a general structure without limiting that structure to a specific subset of structures, we will generally construe the term to cover all known types of that structure”).

The PTO examiner here—an expert or “artisan” in the field—indicated she too was applying the ordinary meaning of “secured,” without restricting it based on the specification. App.55a. Given that agency expertise and the “heavy presumption” applicable to the term’s ordinary meaning, the panel here erred at minimum by *not* even considering the meaning of the claim text itself.

What is more, the panel’s cited specification statements do nothing to overcome the heavy presumption that the claimed “rear sole *secured*” can cover conventional fixed shoes. For starters, the Federal Circuit has repeatedly rejected such “*present invention*” language as insufficient to meet the “exacting” disclaimer/lexicography standard. *See, e.g., Continental Circuits*, 915 F.3d at 795-98 (rejecting notion that “because the patentees [had] repeatedly disparaged” a prior-art process, the patent had effectuated disclaimer); *Absolute Software*, 659 F.3d at 1136-37 (specification’s use of “the present invention” did not limit claims); *Voda*, 536 F.3d at 1320-22 (same); *Praxair*, 543 F.3d at 1326 (same). Further, the “present invention” aspect cited by the panel merely, related “*generally*” the Akeva patents’ goals of having shoes

with a “versatile life” and “better performance.” App.7a-8a—generalities and goals that do not rebut any heavy presumptions, much less meet any “exacting” disclaimer standards. *See Continental Circuits; Absolute Software; Voda; Praxair, supra.*

So too with the panel’s cited portions of the Akeva patent specifications that purportedly “disparage” shoes having “conventional fixed’ soles. App.8a. As noted, the Federal Circuit has “held that ‘[m]ere criticism of a particular embodiment [or prior-art reference] . . . is not sufficient to rise to the level of clear disavowal.’ Thus, comparing and contrasting the present technique to that of the prior art does not ‘rise to the level of [a] clear disavowal’ of claim scope.” *E.g., Continental Circuits*, 915 F.3d at 795-98. Further, the court’s cited disparagement here merely describes, in general terms, the problems of “outsole wear” and “midsole compression.” App.8a. Those general statements again do nothing to rebut the “heavy presumption” of ordinary meaning; indeed, the specifications say *nothing* to address having a “rear sole secured” or “fixed” to the shoe. *See id.*

The same goes for the panel’s cited references to the Akeva patents’ “Description of the Preferred Embodiments”—and specifically, its description of a “*multitude*” of examples where the shoe had a “*detachable*” sole, *not* a “*permanently* fastened” or fixed one. App.9a. (emphases added). As the law has long held, the purpose of the specification is to “disclose[] and teach[],” *not* claim, “define and circumscribe.” *E.g., Ariad*, 598 F.3d at 1346-47. Moreover, as the heavy-presumption line repeatedly holds, “embodiments” and examples in the specification are merely that—*non-limiting examples* that illustrate

one way of practicing the claimed invention. *E.g.*, *Continental Circuits*, 915 F.3d at 795-80. But whether a specification describes a “single embodiment” or many, its examples cannot constrict a claim. *Id.*

## V. THE HARM CAUSED BY THE FEDERAL CIRCUIT’S DIVIDED PRECEDENTS IS SUBSTANTIAL.

Given this precedential split, patent stakeholders cannot know the scope of the patent claims that the law charges them with knowing. Consistency and predictability, two of the driving purposes underlying the patent system, are sacrificed. And with the lack of such consistency and predictability, investors, innovators, and other stakeholders have dwindling reason to invest and innovate. *See, e.g., Festo*, 535 U.S. at 730-31.

Specifically, patentees and the public cannot know the boundaries of a patent’s claims and thus cannot make reasoned judgments about patent value. Patent litigants and lawyers cannot reliably assess and advise on the merits of patent litigation. Naturally, then, parties cannot reasonably determine whether they should settle, at what price, or when. In sum, the harm caused by the court’s divided case law has genuine consequences for stakeholders across the system—and to innovation itself. After all, who will invest in innovation if the patents and laws that protect them are unclear, inconsistent, and unpredictable?

### A. The Scholarly Commentary Confirms the Harm Caused by this “Feuding” Precedent.

For decades, the scholarly analyses on this claim-construction divide has highlighted the need for this Court’s intervention. Rather than address every such analysis, we refer briefly to an example that well-encapsulates the problems resulting from the Federal Circuit’s confused jurisprudence.

In their influential 2009 book, *PATENT FAILURE: HOW JUDGES, BUREAUCRATS, AND LAWYERS PUT INNOVATORS AT RISK*, Professors Bessen and Meurer conclude that the lack of public notice—and what a patent’s claims do and do not cover—have been the main culprit in undermining the U.S. patent system. *Id.* at 9. As they have explained, unclear interpretive rules and poor public notice “subject[] technology investors to an unavoidable risk of disputes and litigation” and undercut patent value and incentives to invest and invent. *E.g., id.* As one of their chapter titles puts it, “*If you can’t tell the [claim’s] boundaries, it ain’t property.*” *Id.* at 8. And that lack of clarity and predictability with a patent’s claims—with its *boundaries*—is the result of the “*Federal Circuit feuding over appropriate methods of claim construction,*” *id.* at 58.

Since the early 2000s, other commentators and judges have similarly lamented the Federal Circuit’s failure to provide predictable principles of interpretation—and that this unpredictability has undermined innovation itself.<sup>11</sup>

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<sup>11</sup> *E.g., Of Fences and Definite Patent Boundaries*, by Deepa Varadarán, 18 *Vand. J. Ent. & Tech. L.* 564, 573 (2015-2016);

## B. The Federal Circuit has Refused to Fix *Phillips* or the 15-Year-Plus Split It Created.

Despite this long-existing divide over claim construction, the Federal Circuit has declined to resolve it. That the court created this split and allowed the resulting confusion to spread—on an issue of such importance—are reasons enough to grant *certiorari*. That it has perpetuated this split for 15-20 years is all the reason more.

The Federal Circuit’s en-banc *Phillips* decision only exacerbated this intra-court split. *See* 415 F.3d at 1312-16. Foremost, even while framing it as the “principle question” for en-banc review, *Phillips* did not resolve the specification’s role in claim construction. *Id.* Instead, the court emphasized the “primary importance” of the claim text, *id.* at 1312; emphasized the specification as the “primary basis for construing the claims,” *id.* at 1315; and then recited the refrain

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*Unpredictability in Patent Law and Its Effect on Pharmaceutical Innovation*, by Christopher Holman, 76 MO. L. REV. 645, 663-64 (2011) (“In recent years, major innovative pharmaceutical companies have experienced two pronounced and significant trends: a decreasing output of innovative new drugs and cutbacks in research and development (R&D) investment”; the “high level of unpredictability in today’s patent law [including claim construction] is a significant impediment to the development of new medicines” and the “R&D crisis”); *Markman Eight Years Later*,” Moore, note 2, *supra* (examining “morass of confused and contradictory claim construction canons” and concluding the Federal Circuit “undoubtedly” is “at fault” because it is “not providing sufficient guidance on claim construction” or “any clear canons of claim construction”); *Uncertainty and Unpredictability in Patent Litigation: The Time is Ripe for a Consistent Claim Construction Methodology*, Gretchen Ann Bender, 8 J. INTELLECTUAL PROPERTY LAW 175, 176 (2001).

that “claims are to be read in light of the specification, of which they are a part”—all without resolving what it means to construe claims “*in light of the specification.*” 415 F.3d at 1323. *Phillips*, to be sure, overruled a *Texas Digital* holding that applied a dictionary “presumption.” *Id.* at 1320-21. But it otherwise merely armed each side of the interpretation debate, ascribing “primary” importance to both claim and specification.

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To this day, patentees and the public must still guess whether they will have a Federal Circuit panel applying the “heavy presumption” law or “holistic” law. That guessing is no way to run any legal system, let alone one responsible for promoting “science,” “progress,” and innovation. Indeed, as *Festo* cautioned, the absence of such claim-construction clarity has hampered the cause of technology investment and invention itself.



## CONCLUSION

The Federal Circuit has refused for decades to resolve this assault on the Constitution's Patent Clause and laws. It is time for this Court to do so. Petitioner Akeva L.L.C. respectfully requests the Court grant the requested writ of certiorari.

Respectfully submitted,

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