
In the Supreme Court of the United States

OLAF SÖÖT DESIGN, LLC, PETITIONER

v.

DAKTRONICS, INC., ET AL.

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

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

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QUESTION PRESENTED

In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), this Court held that the Seventh Amendment does not require questions regarding “the construction of a patent” to be submitted to a jury. *Id.* at 372. Instead, “the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” *Ibid.* The question presented is as follows:

Whether the court of appeals violated petitioner’s Seventh Amendment rights by construing non-technical terms within a patent and overturning a jury verdict of infringement.

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INTEREST OF THE UNITED STATES

This brief is submitted in response to the Court’s order inviting the Solicitor General to express the views of the United States. In the view of the United States, the petition for a writ of certiorari should be denied.

STATEMENT

1. a. A United States patent confers on the patentee “the right to exclude others,” for a limited term, from using the claimed invention “throughout the United States.” 35 U.S.C. 154(a)(1). To enforce that right, a “patentee shall have remedy by civil action for infringement of his patent.” 35 U.S.C. 281. Whether an accused product infringes a patent is determined in a two-step process. See *Cordis Corp. v. Boston Scientific Corp.*, 658 F.3d 1347, 1354 (Fed. Cir. 2011); see also *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384 (1996).

First, the patent claims—*i.e.*, “the portion of the patent document that defines the scope of the patentee’s rights,” *Markman*, 517 U.S. at 372—are “‘construed’” in a process known as “claim construction,” *Cordis Corp.*, 658 F.3d at 1354-1355 (citation omitted). As a general matter, patent claims, like deeds or contracts, are construed using evidence intrinsic to the patent itself, including: (i) the claim language; (ii) the patent’s specification—*i.e.*, the portion of the patent document that describes the invention in sufficient detail to enable others to make and use it; and (iii) the patent’s prosecution history—*i.e.*, the patentee’s representations to the United States Patent and Trademark Office concerning the scope and meaning of the claims. See *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 331 (2015). In some cases, the court in construing patent claims will also consider expert testimony and make subsidiary factual findings. See *id.* at 330. Claim terms generally are given “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc), cert. denied, 546 U.S. 1170 (2006).

Second, the accused product is compared to the construed claim to determine whether the product infringes. See *Cordis Corp.*, 658 F.3d at 1354. That comparison looks to “whether [the accused] device contains all the limitations * * * in the claimed invention.” *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1365 (Fed. Cir. 2002).

An accused product can infringe either literally or under the doctrine of equivalents. Literal infringement occurs when the accused product meets every limitation recited in the claim. See *E.I. du Pont de Nemours &*

Co. v. Unifrax I LLC, 921 F.3d 1060, 1073 (Fed. Cir. 2019). A product infringes under the doctrine of equivalents if “the difference between the claimed invention and the accused product or method [is] insubstantial or * * * the accused product or method performs the substantially same function in substantially the same way with substantially the same result as each claim limitation of the patented product or method.” *AquaTex Indus., Inc. v. Techniche Solutions*, 479 F.3d 1320, 1326 (Fed. Cir. 2007). The doctrine protects inventors from “copyists who make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 732-733 (2002) (citation and internal quotation marks omitted).

b. The Seventh Amendment to the United States Constitution provides that “the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States.” U.S. Const. Amend. VII. In *Markman*, this Court considered the Seventh Amendment’s application in the two-step process (see pp. 1-2, *supra*) used to determine whether a patent has been infringed. The Court recognized that juries generally are responsible for “answering the ultimate question of infringement.” *Markman*, 517 U.S. at 385. But the Court held that the first step—“the construction of a patent, including terms of art within its claim”—“is exclusively within the province of the court.” *Id.* at 372.

In support of that conclusion, the Court explained that “[t]he right of trial by jury” protected by the Seventh Amendment “is the right which existed under the

English common law when the Amendment was adopted.” *Markman*, 517 U.S. at 376 (citation omitted; brackets in original). The Court found no evidence that framing-era juries had commonly construed patent claims. See *id.* at 378-384. Instead, “judges, not juries, ordinarily construed written documents” during that period. *Id.* at 381-382. Having rejected “the contention that juries *generally* had interpretive responsibilities during the 18th century,” the Court separately rejected “the more modest contention that * * * the art of defining terms of art employed in a [patent] specification fell within the province of the jury” during that era. *Id.* at 383 (emphasis added).

Without a “clear answer[.]” from history or precedent, the Court looked to whether, ““as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question.”” *Markman*, 517 U.S. at 388 (citation omitted). The Court observed that “[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis.” *Ibid.* With respect to “[p]atent construction in particular,” the Court found that “[t]he judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury.” *Id.* at 388-389 (citation omitted). The Court thus concluded that “judges, not juries, are the better suited to find the acquired meaning of patent terms.” *Id.* at 388.

2. This case concerns U.S. Patent No. 6,520,485 (the ’485 patent), issued to petitioner, for a winch system that raises and lowers theater scenery. Pet. App. 2a-3a. Petitioner sued respondents, alleging that they had infringed petitioner’s patent by producing and selling

winches called “VORTEK Classic Hoists” (the “Vortek product”). *Id.* at 19a.

Before trial, the district court addressed the terms in the patent claims. Pet. App. 68a. As relevant here, the parties disputed the meaning of claim 27’s element h, which describes how petitioner’s winch includes a “hollow drum” and, at the end of the drum, a “hollow hub.” *Id.* at 4a-5a. Element h states that “said hollow hub and hollow drum” will be “sized such that the screw can move into the hollow hub to allow the hollow drum to receive the screw as the cable unwinds from or winds up on the drum as the object moves to its respective down or up position.” *Id.* at 5a (emphasis omitted).

In its claim-construction briefing, petitioner argued that, for purposes of claim 27, “the hub is a part of the drum.” Pet. App. 7a (quoting C.A. App. 415). Under that view, the Vortek product met element h because it was undisputed that the Vortek hub was able to receive the screw. *Ibid.* Respondents argued that the hub and the drum are separate components, and that petitioner was attempting to “drop[] the [claim] requirement that the drum receives the screw.” *Ibid.* (brackets in original) (quoting C.A. App. 836). On that interpretation, respondents’ product did not meet element h because it was “undisputed that the Vortek screw is received by the hub” but does not go further into the drum. *Ibid.*

Before the trial began, the district court declined to adopt any clarifying jury instruction concerning the relationship between the hub and drum, instead adopting an instruction that simply tracked the language of element h. See Pet. App. 80a. As the litigation progressed, petitioner continued to argue that the hub is part of the drum and that element h is met whenever a product’s screw enters the hub. *Id.* at 29a-35a. Respondents

maintained that the hub and the drum are separate components of the patented invention, and that receipt of the screw by the hub is insufficient to meet element h. *Id.* at 29a-30a. At the close of petitioner’s case, respondents moved for judgment as a matter of law, arguing that the Vortek product did not infringe either literally or under the doctrine of equivalents. See D. Ct. Docs. 313, 314 (Dec. 14, 2018). The district court denied respondents’ motion. Pet. App. 26a n.2.

The jury returned a verdict of infringement. Pet. App. 18a. Through a special verdict, the jury found that the Vortek product did not “literally include” element h’s “‘screw into drum’ limitation,” but that the product had an “equivalent” to that limitation and thus infringed under the doctrine of equivalents. D. Ct. Doc. 341-1, at 17 (Jan. 30, 2019); see Pet. App. 2a.

After the verdict, respondents renewed their motion for judgment as a matter of law. Pet. App. 18a. Respondents argued that the jury’s finding of infringement under the doctrine of equivalents improperly vitiated—*i.e.*, rendered meaningless—element h’s requirement that the drum be able to receive the screw. See *id.* at 29a; D. Ct. Doc. 330, at 7, 12-19 (Jan. 7, 2019). The district court again denied respondents’ motion, this time adopting petitioner’s construction of element h and concluding that “all the descriptions of the hollow hub” in the claim language “unambiguously indicate that the hollow hub is *part of* not *separate from*, the drum.” Pet. App. 30a. The court further held that the jury had “ample evidence” to find infringement under the doctrine of equivalents. *Id.* at 35a.

3. The court of appeals reversed the judgment of infringement. Pet. App. 1a-16a.

The court of appeals observed that “[t]he construction of claim terms based on the claim language, the specification, and the prosecution history are legal determinations.” Pet. App. 9a (citation omitted). The court explained that, “[w]hen the parties present a fundamental dispute regarding the scope of a claim term, it is the court’s duty to resolve it.” *Id.* at 6a-7a (quoting *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1362 (Fed. Cir. 2008)) (brackets in original). The court of appeals concluded that the district court had erred by “fail[ing] to resolve a fundamental dispute regarding the scope of claim element h—specifically, whether the hub is part of the drum”—before the trial took place. *Id.* at 7a.

The court of appeals noted that the district court had “belatedly resolved the claim construction dispute” when, post-verdict, it “concluded that the hub is part of the drum and, on that basis, rejected [respondents’] argument that the Vortek product does not infringe as a matter of law.” Pet. App. 8a. But the court of appeals disagreed with that construction. The court concluded that “[t]he claim language treats the hub and drum as two components, reciting that both ‘the hollow hub *and* hollow drum’ are sized to receive the screw.” *Id.* at 10a. The court found further support for that understanding in the ’485 patent’s specification, which, like the claim, speaks of “the screw enter[ing] the drum via passage through another component, the hollow hub.” *Ibid.* The court accordingly held that, “for purposes of claim 27, the hub is not part of the drum.” *Id.* at 11a.

The court of appeals then held “as a matter of law” that, “[u]nder the proper construction, the Vortek product does not infringe claim 27 either literally or under the doctrine of equivalents.” Pet. App. 11a; see *id.* at

6a. The court explained that “[t]he Vortek product does not literally meet element h of claim 27 because the hollow drum of the Vortek is not able to receive the screw.” *Id.* at 11a. The court determined as well “that the Vortek product does not meet element h under the doctrine of equivalents.” *Ibid.* The court explained that finding the Vortek product to have a function equivalent to element h “would impermissibly eliminate the requirement that the hollow drum be able to receive the screw as the cable winds or unwinds on the drum.” *Id.* at 12a. Accordingly, the court reversed the final judgment of infringement. *Id.* at 13a.

Judge Lourie concurred in the panel’s decision, “fully agree[ing] with its reasoning,” but writing separately to “express concern over the use of the doctrine of equivalents to find infringement when four claim limitations have not literally been met by the accused device.” Pet. App. 14a; see *id.* at 14a-16a.

The court of appeals subsequently denied panel rehearing and rehearing en banc without noted dissent. Pet. App. 93a-94a.

DISCUSSION

The court of appeals’ decision is consistent with this Court’s precedents addressing the allocation of power between judges and juries in patent-infringement suits, and with more general Seventh Amendment principles. In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), this Court made clear that the court rather than the jury should resolve *all* issues of claim construction. Contrary to petitioner’s suggestion, that holding is not limited to the interpretation of terms of art. Rather, the Court emphasized the importance of uniformity in the interpretation of particular patents and

explained that judges are experts in the necessarily sophisticated analysis of construing written documents as a whole.

Petitioner contends that this Court’s review is necessary to address purported lower-court confusion regarding *Markman*. But the procedural scheme that petitioner advocates, under which judges would construe an ill-defined category of specialized terms in patent claims while juries would construe “ordinary” patent terms, would introduce rather than alleviate uncertainty. In any event, this case would be an unsuitable vehicle for clarifying the scope of judicial power to overturn juries’ claim constructions, since here the court of appeals and the jury appear to have adopted the *same* construction of element h. The two decisionmakers reached different outcomes on the ultimate question of infringement because they applied the doctrine of equivalents differently; but petitioner does not seek this Court’s review of any question specifically pertaining to that doctrine. The petition for a writ of certiorari should be denied.

A. The Court Of Appeals Correctly Applied This Court’s Jurisprudence Regarding Patent-Claim Construction And The Seventh Amendment

The court of appeals held that the district court had erred in failing to resolve the parties’ claim-construction dispute before sending this case to the jury. Pet. App. 7a-8a. The court of appeals construed the disputed claim and concluded that respondents were entitled to judgment as a matter of law, both as to literal infringement and as to infringement under the doctrine of equivalents. That manner of proceeding was correct and consistent with the Seventh Amendment.

1. a. In *Markman*, this Court considered “whether the interpretation of a * * * patent claim * * * is a

matter of law reserved entirely for the court, or subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed term of art about which expert testimony is offered.” 517 U.S. at 372. The dispute there concerned the meaning of the term “‘inventory,’” as used in a patent for a system for “monitor[ing] and report[ing] the status, location, and movement of clothing in a dry-cleaning establishment.” *Id.* at 374-375. A witness for the patentee testified at trial that the term as used in the claim encompassed inventories of invoices and transactions, rather than of the clothes themselves. See *id.* at 375. The jury appeared to accept that interpretation, finding that the defendant had infringed the relevant claim. See *ibid.* The district court nonetheless entered judgment as a matter of law for the defendant because it construed “inventory” to require that “the product was capable of tracking articles of clothing,” which the defendant’s product could not do. *Ibid.*

The patentee in *Markman* argued that the district court had erred in “substitut[ing] its construction of the disputed claim term * * * for the construction the jury had presumably given it.” *Markman*, 517 U.S. at 376. The Court rejected that argument. The Court recognized that the ultimate question of infringement was appropriate for resolution by a jury. See *id.* at 377. The Court held, however, that “the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” *Id.* at 372; see *id.* at 391 (“[W]e hold that the interpretation of the word ‘inventory’ in this case is an issue for the judge, not the jury.”).

Based on its examination of common-law practice at the time of the founding, the Court disagreed both with

the patentee's broad argument that "juries generally had interpretive responsibilities during the 18th century," and with the patentee's "more modest contention that even if judges were charged with construing most terms in the patent, the art of defining terms of art employed in a specification fell within the province of the jury." *Markman*, 517 U.S. at 383; see *id.* at 378-384. The Court explained that "in other kinds of cases during this period judges, not juries, ordinarily construed written documents." *Id.* at 381-382. The Court found it likely that "judges were doing the same thing in the patent litigation of the time" because "as soon as the English reports [began] to describe the construction of patent documents, they show[ed] the judges construing the terms of the specifications." *Id.* at 382.

The Court then considered other factors to determine how claim-construction duties should be "allocate[d] * * * as between court or jury." *Markman*, 517 U.S. at 384. The Court cited 19th Century decisions holding that "construing the letters-patent" is "a question of law, to be determined by the court." *Ibid.* (quoting *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338 (1854)). The Court also observed that "[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors." *Id.* at 388. With respect to "[p]atent construction in particular," the Court found that "[t]he judge, from his training and discipline, is more likely to give a proper interpretation to such instruments than a jury.'" *Id.* at 388-389 (citation omitted). Accordingly, the Court concluded that "judges, not juries, are the better suited to find the acquired meaning of patent terms." *Id.* at 388. Finally, the Court noted "the importance of uniformity in the treatment of a given patent as an independent

reason to allocate all issues of construction to the court,” *id.* at 390, and it observed that such uniformity would “be ill served by submitting issues of document construction to juries,” *id.* at 391.

b. Petitioner would confine (Pet. 7) *Markman*’s holding to terms of art or “claim construction issues anchored in the legal and technical patent record.” Nothing in *Markman* supports that limitation. To the contrary, the Court repeatedly framed its conclusions in more categorical terms. The Court discussed 19th Century precedents that described “construing the patent” as “a question of law,” *Markman*, 517 U.S. at 384 (citation omitted), and the Court further observed that judges are “better positioned” to construe “written instruments” generally, *id.* at 388 (citation omitted). And in emphasizing “the importance of uniformity in the treatment of a given patent as an independent reason to allocate *all* issues of construction to the court,” *id.* at 390 (emphasis added), the Court stated that “[u]niformity would * * * be ill served by submitting issues of document construction to juries,” *id.* at 391.

The *Markman* Court noted a possible distinction between terms of art and other patent language only in the course of considering the patentee’s fallback argument that juries should construe terms of art in patents *even if* judges are otherwise responsible for claim construction. See 517 U.S. at 383, 389. The patentee in *Markman* argued that “a jury should decide a question of meaning peculiar to a trade or profession * * * because the question is a subject of testimony requiring credibility determinations, which are the jury’s forte.” *Id.* at 389. The Court rejected that argument. While acknowledging that “credibility judgments have to be made about the experts who testify in patent cases,” the

Court concluded that even in those circumstances, “any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document,” and that the jury’s ability “to evaluate demeanor” or “to reflect community standards” will be “much less significant than a trained ability to evaluate the testimony in relation to the overall structure of the patent.” *Id.* at 389-390. That discussion took as its starting point the understanding that, when a disputed patent claim can be construed *without* expert testimony, its construction is the province of the court rather than the jury. The Court did not even entertain as a possibility the allocation of responsibilities that petitioner advocates, under which juries would have *greater* authority to construe “ordinary” claim terms than to construe terms of art.

This Court has since reaffirmed that “the ultimate question of claim construction is for the judge and not the jury,” regardless of whether the disputed claim language is a common term or a term of art. *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 326 (2015). In *Teva Pharmaceuticals*, the Court reiterated that “a judge, in construing a patent claim, is engaged in much the same task as the judge would be in construing other written instruments, such as deeds, contracts, or tariffs.” *Id.* at 325. That description is incompatible with petitioner’s argument that the judge has primacy only in construing terms of art. And the Court again indicated that, to the extent different types of claim language raise distinct interpretive issues, construing common terms is *even more clearly* within the judge’s purview than construing terms of art. The Court explained that the interpretation of contested claim lan-

guage “may give rise to a factual dispute” when, for example, the patent “uses ‘technical words or phrases not commonly understood.’” *Id.* at 326 (citation omitted). The Court reaffirmed, however, that claim construction remains the province of the court even when such fact-finding is necessary. See *id.* at 326-327. And when, as here, “the words in [the written] instruments are ‘used in their ordinary meaning,’” such factual disputes do not arise and “[c]onstruction of written instruments often presents ‘a question solely of law.’” *Id.* at 326 (citation omitted).

2. The court of appeals’ decision in this case is consistent with *Markman* and with generally applicable Seventh Amendment principles.

a. The court of appeals recognized, as *Markman* requires, that “[t]he construction of claim terms based on the claim language, the specification, and the prosecution history are legal determinations.” Pet. App. 9a (citation omitted). Accordingly, the court construed element h of claim 27 and concluded that “the hollow hub is not part of the hollow drum.” *Id.* at 10a.¹

The court of appeals then considered the proper disposition of respondents’ sufficiency-of-the-evidence challenge to the judgment of infringement. Respondents had filed a pre-verdict motion for judgment as a matter of law and had renewed that motion after the jury rendered its verdict, and the district court had denied both motions. See p. 6, *supra*. Federal Rule of Civil Procedure 50(e) provides that, after reversing the

¹ Because the district court in this case based its construction of element h solely on the language of the patent itself, rather than on any subsidiary factfinding, see Pet. App. 30a-35a, the court of appeals correctly applied de novo review to the district court’s interpretation, see *Teva Pharm.*, 574 U.S. at 332-333.

denial of a motion for judgment as a matter of law, the appellate court “may order a new trial, direct the trial court to determine whether a new trial should be granted, or direct the entry of judgment.” In patent cases in particular, “[i]f no reasonable jury could have found infringement under the proper claim construction,” the court of appeals may “reverse [the] district court’s denial of [judgment as a matter of law] without remand.” *Comcast IP Holdings I LLC v. Sprint Commc’ns Co.*, 850 F.3d 1302, 1309 (Fed. Cir. 2017) (citation omitted).

The court of appeals appropriately chose that course of action here. While the court of appeals did not recite the familiar “no reasonable jury” standard, it had before it the district court’s denial of respondents’ renewed, post-verdict motion for “judgment as a matter of law * * * of noninfringement.” Pet. App. 2a; see *id.* at 18a. Respondents were entitled to judgment as a matter of law if “a reasonable jury would not have a legally sufficient evidentiary basis to find for” petitioner. Fed. R. Civ. P. 50(a)(1); see Fed. R. Civ. P. 50(b) and (e). In holding “as a matter of law” that “[u]nder the proper construction, the Vortek product does not infringe claim 27,” Pet. App. 6a, 11a, the court of appeals implicitly determined that a reasonable jury could not have found infringement under the proper claim construction.

The court of appeals explained in that regard that “[t]he Vortek product does not literally meet element h of claim 27 because the hollow drum of the Vortek is not able to receive the screw.” Pet. App. 11a. The court separately concluded “as a matter of law that the Vortek product does not meet element h under the doctrine of equivalents.” *Ibid.* In reaching that conclusion, the court of appeals applied this Court’s admonition in

Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17 (1997), that the doctrine of equivalents should not be “allowed such broad play as to effectively eliminate [an] element in its entirety.” Pet. App. 11a-12a (quoting *Warner-Jenkinson Co.*, 520 U.S. at 29). The court explained that “a finding of infringement under the doctrine of equivalents would be inappropriate under these specific circumstances because such a finding would impermissibly eliminate the requirement that the hollow drum be able to receive the screw as the cable winds or unwinds on the drum.” *Id.* at 12a. The court also cited prior Federal Circuit decisions holding the doctrine of equivalents to be inapplicable where a finding of equivalence would “vitiating” an entire claim limitation. See *ibid.*

b. Petitioner contends (Pet. 15-16) that the court of appeals “undermined the fact-finding role of the jury” by construing the ’485 patent, holding as a matter of law that the accused product does not infringe the properly construed claim, and reversing the jury’s verdict. Contrary to petitioner’s argument, the court of appeals’ decision is consistent with well-settled and generally applicable Seventh Amendment principles.

This Court has long recognized “that a trial court, pursuant to [Federal Rule of Civil Procedure] 50(b), [can] enter judgment for the verdict loser without offense to the Seventh Amendment” when “the facts are sufficiently clear that the law requires a particular result.” *Weisgram v. Marley Co.*, 528 U.S. 440, 448-450 (2000) (quoting 9A Charles Alan Wright & Arthur R. Miller, *Federal Practice and Procedure* § 2521, at 240 (2d ed. 1995), and citing *Neely v. Martin K. Eby Constr. Co.*, 386 U.S. 317 (1967), and *Montgomery Ward & Co. v. Duncan*, 311 U.S. 243 (1940)). An appellate court can

in turn review the denial of a motion for judgment as a matter of law and, without offending the Seventh Amendment, “reverse[] the judgment,” as the court of appeals did here. Fed. R. Civ. P. 50(e); see Pet. App. 11a-13a. “As far as the Seventh Amendment’s right to jury trial is concerned * * * there is no greater restriction on the province of the jury when an appellate court enters judgment [as a matter of law] than when a trial court does.” *Weisgram*, 528 U.S. at 450 (quoting *Neely*, 386 U.S. at 322). Thus, “there is no constitutional bar to an appellate court granting judgment [as a matter of law].” *Neely*, 386 U.S. at 322.

Petitioner asserts (Pet. 17) that respondents did not object to or challenge on appeal “the district court constructions given to the jury at trial.” Even if that were true, it would not affect the Seventh Amendment analysis. “If the evidence presented in the * * * trial would not suffice, as a matter of law, to support a jury verdict under the” correct view of the law, “judgment [can] properly be entered * * * at once, without a new trial.” *Boyle v. United Techs. Corp.*, 487 U.S. 500, 513 (1988). “[T]hat is so even” if the party seeking judgment as a matter of law “failed to object to jury instructions that expressed the [law] differently, and in a fashion that would support a verdict.” *Id.* at 513-514.

In any event, the record makes clear that respondents vigorously objected throughout the district court proceedings to petitioner’s proposed construction of claim 27. Before trial, petitioner argued that the hub is part of the drum and thus that element h is met so long as the screw enters the hollow hub. Pet. App. 7a, 80a. Respondents disputed that construction, arguing that the hub is separate from the drum and that entry of the screw into the hub is not sufficient to satisfy element h.

Id. at 7a (citing C.A. App. 836). At the close of petitioner’s evidence, respondents unsuccessfully moved for judgment as a matter of law, arguing that the Vortek product could not infringe claim 27 because the screw on that product did not enter the drum. See *id.* at 26a n.2; D. Ct. Doc. 314, at 7-10. After the jury verdict, respondents renewed their motion on that same basis. Pet. App. 27a. And when their motions were denied, respondents appealed, arguing, among other things, that the “hollow drum in claim 27 is different than the hollow hub.” Resps. C.A. Br. 24.²

B. This Court’s Review Is Not Warranted

1. Petitioner asserts (Pet. 8) that lower courts have “struggle[d] to discern where a claim construction issue ends and the infringement question begins,” thus “depriving litigants of their rights to trial by jury and creating great inefficiencies in patent trials,” Pet. Reply Br. 1-2. But courts “have long found it possible to separate factual from legal matters.” *Teva Pharm.*, 574 U.S. at 328. Although the “line drawn” between claim construction and infringement can sometimes be “a fine

² It is irrelevant that respondents characterized the disputed question on appeal as one of vitiation, see Resps. C.A. Br. 19-32, rather than as “a claim construction issue,” Pet. 4 (quoting C.A. Oral Arg. at 4:38-4:45 (Nov. 6, 2020), <https://cafc.uscourts.gov/home/oral-argument/listen-to-oral-arguments/>). To decide whether a finding of infringement would vitiate a claim limitation, the court must first construe that limitation to determine its scope. See *Decision-ing.com, Inc. v. Federated Dep’t Stores, Inc.*, 527 F.3d 1300, 1315 (Fed. Cir. 2008) (per curiam) (collecting cases concluding that limitations would be vitiated “as construed”). In any event, any contention that principles of waiver or forfeiture should lead to a different result in this particular case would provide no basis for this Court’s review.

one, it is one that the Court has drawn repeatedly in explaining the respective roles of the jury and judge in patent cases.” *Markman*, 517 U.S. at 387. Rather than producing greater clarity, petitioner’s approach would render the division of labor between judges and juries *less* certain, by replacing *Markman*’s clear allocation of “all issues of [claim] construction to the court,” *id.* at 390, with a new rule that judges can construe only those claim terms that have “acquired a specialized meaning” because they were “used in a special way” during patent prosecution or have “special meaning in the art,” Pet. Reply Br. 3-4.

2. In any event, this case does not present any close question concerning the line between claim construction and infringement. The determination whether the hub and the drum are separate components in claim 27 of the ’485 patent plainly falls in the former category. If the district court had adopted petitioner’s construction of element h before rather than after submitting the case to the jury, the court of appeals could have reviewed that construction *de novo* in any appeal from the final judgment. The district court’s failure to construe the relevant claim language until after the jury had rendered its verdict cannot reduce respondents’ appeal rights.

3. Finally, this case would be an unsuitable vehicle for clarifying the respective roles of judges and juries in construing disputed claim terms because there is no apparent inconsistency between the claim construction the jury applied and the one the court of appeals adopted. The court concluded that, “for purposes of claim 27, the hub is not part of the drum,” and that element h required that the drum—not just the hub—must be able to receive the invention’s screw. Pet. App. 11a.

That construction prompted the court to hold that respondents' product "does not literally meet element h of claim 27." *Ibid.* But the jury had previously reached the same conclusion, issuing a special verdict finding that respondents' accused product did not "literally include" element h's "'screw into drum' limitation." D. Ct. Doc. 341-1, at 17.

The inconsistency between the jury's verdict and the court of appeals' decision appears to have arisen not from any disagreement about the proper construction of element h, but from the two decisionmakers' application of the doctrine of equivalents. The jury concluded that, although the Vortek product did not literally meet element h's "'screw into drum' limitation," that accused product had "an equivalent" to it. D. Ct. Doc. 341-1, at 17. The court of appeals took a different view, applying this Court's instruction that the "application of the doctrine [of equivalents], even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety." Pet. App. 12a (quoting *Warner-Jenkinson Co.*, 520 U.S. at 29, and collecting cases holding that the doctrine of equivalents should not be applied in such a way as to "vitate" entire claim limitations) (brackets in original). The court of appeals concluded that deeming the Vortek product's feature equivalent to element h "would impermissibly eliminate the requirement that the hollow drum be able to receive the screw as the cable winds or unwinds." *Ibid.* The court determined on that basis that the accused product did not infringe under the doctrine of equivalents as a "matter of law." *Id.* at 11a.

This Court has recognized that a court may enter judgment as a matter of law where "a theory of equivalence would entirely vitiate a particular claim element"

and there is “no further material issue for the jury to resolve.” *Warner-Jenkinson Co.*, 520 U.S. at 39 n.8 (emphasis omitted). Petitioner does not challenge the court of appeals’ doctrine-of-equivalents analysis, instead focusing on the court’s antecedent claim-construction holding. And in any event, the court’s case-specific application of established doctrine-of-equivalents principles raises no issue of general importance warranting this Court’s review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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