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IN THE  
**Supreme Court of the United States**

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JOE A. SALAZAR,

*Petitioner,*

*v.*

AT&T MOBILITY LLC, SPRINT UNITED  
MANAGEMENT COMPANY, T-MOBILE USA, INC.,  
CELLCO PARTNERSHIP INC., DBA VERIZON  
WIRELESS, 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

The Constitution empowers Congress to incentivize innovation by granting inventors limited monopolies in exchange for the public disclosure of their inventions. U.S. Const. Art. I, § 8, Cl. 8. A patent—and the accompanying right to exclude others from making, using, offering for sale, or selling the disclosed invention—is a form of private property. 35 U.S.C. § 154(a)(1). The Takings Clause of the Fifth Amendment protects against uncompensated governmental takings of private property. U.S. Const. amend. V.

Where the Federal Circuit Panel’s construction of petitioner’s patent claim was unforeseeable and unjustifiable under the circuit’s prior decisions, disrupting petitioner’s legitimate investment-backed expectations and rendering his and similarly situated patent owners’ patents worthless, does the Panel’s precedential opinion constitute a judicial taking of property in violation of the Fifth Amendment’s Takings Clause?

## STATEMENT OF RELATED PROCEEDINGS

The following proceedings are directly related to this case within the meaning of Rule 14.1(b)(iii):

- *Salazar v. AT&T Mobility LLC, et al.*, No. 21-2320 (Fed. Cir.), judgment entered on April 5, 2023, and petition for rehearing *en banc* denied on June 8, 2023;
- *Salazar v. AT&T Mobility LLC, et al.*, No. 21-2376 (Fed. Cir.), judgment entered on April 5, 2023; and
- *Salazar v. AT&T Mobility LLC, et al.*, No. 2:20-cv-00004-JRG (E.D. Tex.), judgment entered on August 17, 2021.

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

Joe A. Salazar (“petitioner”) respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

### **OPINIONS BELOW**

The Federal Circuit’s opinion (Pet’r’s App. 1a–17a) is reported at 64 F.4th 1311. The district court’s claim construction memorandum opinion and order (Pet’r’s App. 18a–97a) is unreported.

### **JURISDICTION**

The Federal Circuit entered its judgment on April 5, 2023, (Pet’r’s App. 1a–17a), and denied rehearing on June 8, 2023, (Pet’r’s App. 97a–98a). This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

### **CONSTITUTIONAL AND STATUTORY PROVISIONS**

Article I, Section 8, Clause 8 of the United States Constitution (the “Intellectual Property Clause”) provides:

[The Congress shall have Power . . .] To promote the Progress of Science and useful Arts, by securing for limited

Times to . . . Inventors the exclusive  
Right to their respective . . . Discoveries.

U.S. Const. Art. I, § 8, Cl. 8.

The Due Process Clause and the Takings Clause of  
the Fifth Amendment of the United States  
Constitution provides:

No person shall . . . be deprived of life,  
liberty, or property without due process  
of law; nor shall private property be  
taken for public use, without just  
compensation.

U.S. Const. amend. V.

35 U.S.C. § 154(a)(1) provides:

Every patent shall contain a short title of  
the invention and a grant to the  
patentee, his heirs or assigns, of the right  
to exclude others from making, using,  
offering for sale, or selling the invention  
throughout the United States or  
importing the invention into the United  
States . . . .

35 U.S.C. §154(a)(1).

35 U.S.C. § 261 provides:

Subject to the provisions of this title,  
patents shall have the attributes of  
personal property.

35 U.S.C. § 261.

## STATEMENT OF THE CASE

This case presents the exceptionally important question whether a judicial decision that construes patent claims in a manner that unjustifiably excludes the disclosed “present invention” as described in the patent is an unconstitutional taking of the patent owner’s property rights. Here, the Federal Circuit Panel misapplied well-settled rules of claim construction, resulting in a drastic, unforeseeable narrowing of petitioner’s patent claims, such that petitioner’s “present invention” as described in the patent falls outside the scope of the patent’s protection. This unjustifiable deprivation of petitioner’s patent rights is a judicial taking, rendering petitioner’s and similarly situated inventors’ patents worthless. Absent this Court’s intervention, petitioner has no remedy.

### A. Background

U.S. Patent No. 5,802,467 (“the ’467 Patent”) was filed on September 28, 1995, and issued on September

1, 1998. The '467 Patent discloses and claims a communications, command, control and sensing system integrated with a unique set of high-tech features and functionalities of high-end smart phones of the 2013 time period. These features include: a display device, replaceable icons associated with desired functionalities, efficient space management of parameter sets and command codes, bi-directional IR (infrared frequency) and RF (radio frequency) communications capabilities, touch sensitive device creating signals, sound/voice activation and commands (sending and receiving voice commands), sensors for measuring physical phenomena, and sound and data coupling to receive sound as data signals, among others. The Salazar invention incorporates remote-controlled technology into a device such as a telephone, and the two-way IR transceiver allows the device to communicate and control other devices such as a television or thermostat.

A key aspect of the Salazar invention is the integration and operation of these high-tech features through the use of a plurality of microprocessors. The '467 Patent's teaching that the system be implemented through multiple microprocessors is consistent and prolific. Notably, the '467 Patent's specification describes the "present invention" as "a wireless and wired communications, command, control and sensing system" where "both the handset and the base station contain a touch screen or similar

touch sensitive device that when touched in at least one specific outlined area, provide the **means for externally interacting with their respective microprocessors.**’467 Patent col. 2 l. 66–col. 3 l. 14 (emphasis added). The ’467 Patent further describes the handset and base station of the present invention as both having “microprocessors to control all their internal operations.” ’467 Patent col. 3 l. 15–19.

## **B. Procedural History**

1. On June 18, 2019, Salazar sued AT&T Mobility LLC; Sprint United Management Company; T-Mobile USA, Inc.; and Cellco Partnership d/b/a Verizon Wireless, Inc. (collectively, “respondents”) in the United States District Court for the Eastern District of Texas, alleging, pursuant to 35 U.S.C. § 271, that they directly infringed, contributorily infringed, and induced others to infringe at least claim 1 of the ’467 Patent by offering for sale and selling their smartphone products, including the HTC One M7, HTC One M8, and HTC One M9 (collectively, the “Accused Smartphones”).

During the pendency of the case, the parties briefed various claim construction issues, and the district court held a *Markman* hearing on July 24, 2020. One of the disputed claim terms was “a microprocessor for generating . . ., said microprocessor creating . . ., a plurality of parameter sets retrieved by said microprocessor . . ., said microprocessor

generating . . . .” This claim term, which is applicable to each of the asserted claims of the ’467 Patent, was the subject of Salazar’s appeal to the Federal Circuit Court of Appeals.

The crux of the dispute was whether the claims require a single microprocessor that is capable of performing all the recited “generating,” “creating,” “retrieving,” and “generating” functions. Citing Federal Circuit and district court precedent, Salazar argued that they do not. Because the claim-at-issue is an open-ended “comprising” claim involving the indefinite “a microprocessor,” the well-established general rule of claim construction found in *Baldwin Graphic Systems, Inc. v. Siebert, Inc.*, 512 F.3d 1338 (Fed. Cir. 2008), and its progeny dictates that: (1) the general construction rule of “a” meaning “one or more” applies, such that the recited “a microprocessor” means “one or more microprocessors,” and (2) the subsequent use of the definite article “said” to refer back to the same claim term reinvokes that non-singular meaning. Further, none of the extremely limited exceptions to this general rule applies, as there is nothing in the prosecution history, specification, or claim language that evinces a clear intent to limit “a microprocessor” to “one microprocessor” or necessitates a departure from the rule. Thus, any one of the one or more microprocessors can be capable of performing any one of the recited functions in the claim term, and any individual one of the microprocessors (or all the

microprocessors) need not be capable of performing all of the recited functions.

Respondents argued that although the phrase “a microprocessor” could mean “one or more” microprocessors, the same microprocessor must be configured to perform the microprocessor functions attributed to every subsequent recitation of “said microprocessor”—i.e., “generating,” “creating,” “retrieving,” and “generating.” Respondents did not argue that their construction was grounded in the ’467 Patent’s prosecution history or limitations in the specification. Following the hearing and supplemental briefing by the parties, the district court agreed with respondents, construing the term as “one or more microprocessors, at least one of which is configured to perform the generating, creating, retrieving and generating functions.”

A six-day jury trial was held on August 2, 2021. At trial, respondents consistently and emphatically argued that the Accused Smartphones did not infringe the asserted claims of the ’467 Patent because they did not contain a single microprocessor capable of performing all the recited functions. This argument was a centerpiece of respondents’ case and was raised in their opening statement, during cross-examination of petitioner’s technical expert, in the testimony of respondents’ technical expert, and in respondent’s closing argument—where counsel for respondents explicitly acknowledged that the “microprocessor”



claim language was key to the question of infringement.

At the close of trial, the jury returned a verdict of noninfringement as to all of the asserted claims, while also affirming the validity of the '467 Patent. The district court entered final judgment on August 17, 2021.

2. On September 17, 2021, Salazar filed a notice of appeal to the Federal Circuit, which had jurisdiction over Salazar's appeal under 28 U.S.C. § 1295(a)(1). Salazar filed his opening brief on November 15, 2021, and argued that the district court's erroneous claim construction prejudiced Salazar, likely affecting the outcome of the trial and therefore constituting reversible error. Respondents filed a response brief on February 24, 2022, which included arguments that the district court erred in holding that the asserted claims were not anticipated. Oral argument was held on November 7, 2022.

On April 5, 2023, the Federal Circuit Panel issued an opinion affirming the district court's claim construction. In its opinion, the panel held that "the claim language 'a microprocessor,' read in the context of the full claim . . . should be construed to require at least one microprocessor capable of performing the recited functions." Pet'r's App. 13a–14a. The panel explained that "it does not suffice to have multiple microprocessors, each able to perform just one of the

recited functions; the claim language requires at least one microprocessor capable of performing each of the recited functions.” Pet’r’s App. 14a.

Under this construction the district court and the panel required that a single microprocessor be capable of performing all the recited functions. Doing so, the panel rejected Salazar’s position (and analogous precedent) that any one of the group of “one or more microprocessors” could carry out each of the recited functions so long as that group of “one or more microprocessors” collectively was capable of carrying out all of the recited functions, i.e., a single microprocessor did not need to be capable of performing all the recited functions. Under this construction, Salazar was deprived of the scope of his invention as set out consistently throughout his patent and particularly as described as the “present invention.”

With respect to respondents’ anticipation argument, the Panel affirmed the jury decision in favor of Salazar, holding that “AT&T clearly disavowed any intention to move for judgment as a matter of law regarding anticipation” and “accordingly, even under the most liberal construction of the requirements of Rule 50(a), AT&T has nevertheless waived its anticipation argument.” Pet’r’s App. 17a.

On May 5, 2023, Salazar timely filed a Petition for rehearing *en banc*. The Federal Circuit denied Salazar’s petition on June 8, 2023.

## **REASONS FOR GRANTING THE PETITION**

The Panel’s unduly narrow construction of petitioner’s claimed invention, which requires a single microprocessor to perform each of the recited functions, dramatically departs from well-settled precedent of the Federal Circuit which consistently construes the language used in petitioner’s claim to allow for any one of the “one or more” microprocessors to perform each of the claimed functions. The Panel’s ruling was unforeseeable and unjustifiable by reference to the circuit’s prior decisions, disrupting petitioner’s legitimate investment-backed expectations. The unfair, unexpected claim construction—at odds with settled law—constitutes a judicial taking in violation of the Fifth Amendment.

The Constitution empowers Congress “[t]o promote the Progress of Science and useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their respective . . . Discoveries.” U.S. Const. Art. I, § 8, Cl. 8. To effect this purpose, Congress has enacted patent laws granting inventors limited monopolies in exchange for disclosure of their inventions. These disclosures spur innovation by collectively forming a vast body of public knowledge that allows others to make and use the disclosed

inventions. This Court stated more than a century ago that “[t]he object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated . . . by the application of artificial rules of interpretation.” *Topliff v. Topliff*, 145 U.S. 156, 171 (1892). Yet the Panel, through the arbitrary misapplication of the circuit’s rules of interpretation, has construed patent claims in a manner that excludes the disclosed invention as described in the patent, thus stripping petitioner of his patent rights and reneging on the government’s bargain.

The Panel’s precedential decision undermines the critical public purposes of patent law, and, if left unchecked, will have devastating impacts on innovation and the economy. Innovation-driven industries account for more than forty percent of all U.S. domestic economic activity, and those industries rely on robust, reliable intellectual property protection. Kathi Vidal, Under Sec’y of Commerce for Intellectual Prop. & Director, U.S. Patent & Trademark Office, Remarks at AIPLA Spring Meeting (May 10, 2023), <https://www.uspto.gov/about-us/news-updates/remarks-uspto-director-kathi-vidal-aipla-spring-meeting>. At a minimum, inventors and investors must have confidence that a patent will “confer[] upon the patentee an exclusive property in the patented invention.” *Horne v. Dep’t of Agric.*, 576 U.S. 351, 359 (2015) (quoting *James v. Campbell*, 104 U.S. 356, 358 (1882)). But the Panel’s decision

inexplicably deprives petitioner and those similarly situated of their property by misinterpreting patent claims such that the invention described in the patent itself is not protected by the patent.

Petitioner's use of the indefinite article "a" preceding the word "microprocessor" in his claim language of independent claim 1 of the '467 Patent carries with it by weight of settled precedent in the Federal Circuit the meaning of "one or more" microprocessors capable of performing each of the recited functions. *Baldwin Graphic Sys., Inc.*, 512 F.3d at 1342; *see also* Joseph E. Root, 1 Rules of Patent Drafting § 3.03 (2023) ("In the quest for achieving maximum breadth with minimal words, the traditional method of achieving coverage of both the singular and plural elements in a patent claim consists of simply using the singular indefinite article, 'a' or 'an.'"); Edward D. Manzo, Patent Claim Construction in the Federal Circuit § 7:2 (2023) ("The general rule applicable where "comprising" is the transition term is that [the] indefinite article ['a' or 'an'] means . . . one item or more."). Moreover, his subsequent use of the term "said" in his claim language referring back to the "a microprocessor" similarly carries with it by settled precedent in the circuit the meaning of "one or more" microprocessors capable of performing the recited functions; it simply reinvoles the plural, non-singular meaning and does not change the import of the indefinite article "a" previously used to describe the "one or more"

microprocessor(s) at issue. *Baldwin Graphic Sys., Inc.*, 512 F.3d at 1343; *see also Lite-Netics, LLC v. Nu Tsai Cap. LLC*, 60 F.4th 1335, 1346 (Fed. Cir. 2023).

*Baldwin's* “one or more” construction of the indefinite article “a” when used in a patent claim is a “bedrock rule of patent law,” *Creative Internet Advert. Corp. v. Yahoo!, Inc.*, 476 F. App'x 724, 735 (Fed. Cir. 2011) (Clevenger, J., dissenting in part), with very limited and well-known exceptions, i.e., only where the language of the claims themselves, the specification, or the prosecution history necessitate a departure from this bedrock rule, *Baldwin*, 512 F.3d at 1342–43; *accord Convolve, Inc. v. Compaq Computer Corp.*, 812 F.3d 1313, 1321 (Fed. Cir. 2016) (“Absent a clear intent in the claims themselves, the specification, or the prosecution history, we interpret ‘a processor’ to mean ‘one or more processors.’”). The claim language exception to *Baldwin's* bedrock general rule (that “a” means “one or more”) *must* be derived from language other than a claim's subsequent use of the words “said” or “the” to describe an element of the invention. *Lite-Netics, LLC*, 60 F.4th at 1346; *Baldwin Graphic Sys., Inc.*, 512 F.3d at 1343.

In a patent, the use of the term “present invention” is strong evidence that the elements contained therein apply to the invention as a whole. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343 (Fed. Cir. 2001); *IP Innovation, L.L.C. v.*

*Ecollege.com*, 156 F. App'x 317, 322 (Fed. Cir. 2005). The Federal Circuit has consistently construed claims in a way that they align with the specific features of the embodiment labeled as the “present invention.” See *nCube Corp. v. Seachange Int'l*, 436 F.3d 1317, 1329 (Fed. Cir. 2006) (Dyk, J., dissenting) (stating that the use of the term “present invention” is strong evidence that the use applies to the invention as a whole); *Gaus v. Conair Corp.*, 363 F.3d 1284, 1289–90 (Fed. Cir. 2004) (identifying the phrase, “according to the invention,” and the phrase, “the object of the invention,” and limiting the claims to the features disclosed by these phrases). Moreover, “the characterization of [a limitation] as part of the ‘present invention’ is strong evidence that the claims should not be read to encompass the opposite structure.” *nCube Corp.*, 436 F.3d at 1329 (Dyk, J., dissenting); see also *Pacing Techs., LLC v. Garmin Int'l, Inc.*, 778 F.3d 1021, 1025 (Fed. Cir. 2015) (stating that when a patentee “describes the features of the ‘present invention’ as a whole,” he alerts the reader that “this description limits the scope of the invention”).

Similarly, embodiments representing the character of the invention should not be excluded from a claim construction. See *Alloc, Inc. v. Int'l Trade Comm'n*, 342 F.3d 1361, 1369–70 (Fed. Cir. 2003) (construing claim to include limitation because “**very character of the invention**” required that the limitation be part of every embodiment) (emphasis

added); *GE Lighting Sols., LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1311 (Fed. Cir. 2014) (reversing the district court’s grant of summary judgment of noninfringement based on a claim construction that excluded an embodiment because “there [were] no statements during prosecution or in the specification that indicate[d] the patentee’s intent to limit his claim”).

Consistent with the precedent on interpreting claims and the importance of the disclosure of the “present invention” in the patent, petitioner had a reasonable expectation that his patent claims would be interpreted to include one or more microprocessors, any one of which could perform any of the recited functionality. The “present invention” of the ’467 Patent describes multiple microprocessors working in concert to implement the disclosed functionalities of petitioner’s invention. Indeed, the present invention is described as including components that both “have microprocessors to control all their internal operations.” ’467 Patent col. 3 l. 15–16. For example, the ’467 Patent states: “**In accordance with the present invention**, a wireless and wired communications, command, control and sensing system, in the form of a remote handset or base station, or both, is provided. . . . Both the handset and the base station contain a touch screen or similar touch sensitive device that when touched in at least one specific outlined area, provide the **means for externally interacting with their respective**



**microprocessors.**” ’467 Patent col. 2 l. 66–col. 3 l. 14 (emphasis added); “The handset and the base station **microprocessors** are configured to actuate internal circuits, make calculations, process data, generate and verify privacy codes for telephone communications, generate sound and/or data signals, control signal processing, control the reception and transmission of radio and/or infra-red frequency signals and activate access to public or private telephone networks.” ’467 Patent col. 3 l. 15–19.

Moreover, the embodiments of the ’467 Patent repeatedly describe the invention as including multiple microprocessors. The specification explains that “**The microprocessors** further provide . . . **The microprocessors** and associated software logically inter-relate data to generate information and general purpose command and control signals . . . **The microprocessors** further generate signals . . .” ’467 Patent col. 3 l. 9–31. In another embodiment, the specification describes data signals being coupled to microprocessors for processing and output: “Sensors embodied in the communications, command, control and sensing system detect physical phenomena differentials and convert these differentials into data signals. These data signals are coupled to **microprocessors** for further processing..” ’467 Patent col. 4 l. 18–22. These descriptions are consistent and without exception. *See, e.g.*, ’467 Patent col. 3 l. 15–31, col. 3 l. 44, col. 4 l. 57–60 (“received data is processed by the **respective**

**microprocessor** for display and/or automatic updates to command and control signals sent back to the external ...”), col. 5 l. 46–51 (“A ninth implementation comprises a sensor... which senses temperature, pressure or some other externally measurable human body condition which is then converted and processed by the **respective microprocessor...**”).

The concept of multiple microprocessors working collectively to carry out the functions of petitioner’s invention is the essence of his entire invention disclosed in his patent. The district court and Federal Circuit’s construction requiring that a single microprocessor be capable of performing all the recited functions renders the ’467 Patent virtually devoid of value; anyone may appropriate Salazar’s invention by simply adding additional microprocessors to achieve the recited functions.

Despite this admitted bedrock rule of patent law for claim construction and the invention disclosed in petitioner’s patent, the Panel read petitioner’s claim language describing “a” (non-singular) microprocessor performing certain functions as being changed by the claim language’s subsequent use of the word “said” to describe the microprocessors at issue, and concluded from the subsequent use of the word “said”—when read in context of the full claim—that the claim now required that *at least one* microprocessor be capable of performing *each of* the claimed functions, i.e., the

“generating,” “creating,” “retrieving,” and “generating” functions. In doing so, the Panel dramatically departed from the circuit’s well-settled precedent that the subsequent use of the word “said” by the claim language *does not* change the “one or more” meaning of the claim’s antecedent use of the indefinite article “a” to define an element of the invention, here “microprocessor.”

This unduly constricted reading of petitioner’s claim by the Panel not only runs counter to settled law but also rewrites petitioner’s claim language encompassing “one or more” microprocessors which would perform each of the claimed functions to now require that *a single microprocessor* perform each and every function of the claim, rendering the “or more” of the “one or more” language meaningless. It excludes the embodiments of the ’467 Patent which consistently describe petitioner’s invention as including *multiple* microprocessors to carry on its functions, the very heart of the invention itself, as disclosed in the patent.

Finally, the Panel’s unjustified narrowing of *Baldwin’s* “one or more” rule erodes the rights of patent owners like petitioner, constricting their patent claims without justification for doing so in the prosecution history, specification, or claim language. It will also remove embodiments of claimed inventions—sometimes years after the patent has issued—rendering many of these patents worthless

and leaving inventors like petitioner with no remedy for the loss of their inventions.

The Panel's onerous claim construction was unforeseeable and unjustifiable by reference to the Federal Circuit's prior decisions, including *Baldwin* and its progeny, disrupting petitioner's legitimate investment-backed expectations. Its unfair, unexpected reading of petitioner's patent claim—dramatically at odds with prior well-settled law of the Federal Circuit—constitutes a judicial taking of petitioner's property in violation of the Fifth Amendment.

**A. Petitioner's Patent Rights are Private Property Within the Intendment of the Fifth Amendment's Takings Clause.**

The Takings Clause of the Fifth Amendment provides that “private property [shall not] be taken for public use, without just compensation.” U.S. Const. amend. V. Property rights are created by law. As a general matter, state law creates property rights, but in the case of patents, federal law defines the nature of the right. 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,” U.S. Const. Art. I, § 8, cl. 8, Congress enacted patent laws rewarding inventors with a limited monopoly, *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S.

898, 901 (2014). In this regard, 35 U.S.C. § 261 provides in pertinent part that “patents shall have the attributes of personal property . . . .”

In addition, the Court’s decisional law has consistently acknowledged that a patent for an invention “is as much property as a patent for land.” *Consolidated Fruit-Jar Co. v. Wright*, 94 U.S. 92, 96 (1876). In *James v. Campbell*, 104 U.S. 356, 358 (1882), it recognized that a patent confers upon a patentee like petitioner an *exclusive* property in the patented invention which cannot be used—even by the government—without the patentee’s consent or without just compensation being paid. *Id.*; *see also* 35 U.S.C. § 154(a)(1); *Carl Schenck, A.G. v. Norton Corp.*, 713 F.2d 782, 786 n.3 (Fed. Cir. 1983) (the patentee’s right to exclude others is “the very definition of ‘property’”); Adam Mossoff, *Patents as Constitutional Private Property: The Historical Protection of Patents Under the Takings Clause*, 87 B.U. L. Rev. 689, 700–11 (2007) (discussing that the “nineteenth-century jurisprudence was quite clear: patents are private property rights secured under the Constitution” and their taking or use without compensation even by the government was unconstitutionally unjust).

Subsequent decisions of the Court have reaffirmed the proposition that patents are property for purposes of the Takings Clause. *See Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1373–75, 1379 (2018) (patents convey “a public

franchise” to the patentee which is property subject to the Takings Clause); *Horne*, 576 U.S. at 359–60 (2015) (patents are private property which cannot be taken by the government without just compensation); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730 (2002) (patentee’s monopoly under the patent laws “is a property right” whose dimensions should be clear); *Florida Prepaid Postsecondary Educ. Expense Bd. v. Coll. Sav. Bank*, 527 U.S. 627, 641–43 (1999) (patents are a species of property included within the concept of “property” of which no person may be deprived without due process of law); *Ruckelshaus v. Monsanto*, 467 U.S. 986, 1003–04 (1984) (trade secrets are secured as “private property” under the Takings Clause, citing Blackstone and Locke for the proposition that “property” subsumes all things that arise from “labour and invention” ).

**B. The Panel’s Unfair, Unexpected Claim Construction Renders Petitioner’s Patent Worthless and Constitutes a Judicial Taking in Violation of the Fifth Amendment.**

In order to constitute a taking forbidden by the Fifth Amendment, this Court has identified three factors which have “particular significance” in the analysis: (1) the economic impact of the regulation on the claimant; (2) the extent to which the regulation has interfered with distinct investment-backed expectations; and (3) the character of the

governmental action. *Connolly v. Pension Benefit Guar. Corp.*, 475 U.S. 211, 224–25 (1986) (quoting *Penn Cent. Transp. Co. v. New York City*, 438 U.S. 104, 124 (1978)); see also *Horne*, 576 U.S. at 360.

Petitioner’s showing below satisfied all three factors. In pursuing his patent claims, he justifiably relied upon a coherent body of law developed by the Federal Circuit both before *Baldwin*, see *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed. Cir. 2000) (citing cases), and after *Baldwin*, see, e.g., *01 Communique Lab., Inc. v. LogMeIn*, 687 F.3d 1292, 1297 (Fed. Cir. 2012), that the use of the indefinite article “a” preceding the word “microprocessor” carries with it the meaning of “one or more” microprocessors; and the subsequent use of the definite articles “the” or “said” simply reinvokes that non-singular meaning.

The Federal Circuit charges inventors like petitioner with knowledge of the law. *Novo Nordisk Pharm., Inc. v. Bio-Tech. Gen. Corp.*, 424 F.3d 1347, 1361 (Fed. Cir. 2005) (citing *Brasseler, U.S.A. I., L.P. v. Stryker Sales Corp.*, 267 F.3d 1370, 1385 (Fed. Cir. 2001) (“[I]nventors represented by counsel are presumed to know the law.”)). When petitioner filed the ’467 Patent in **1995**, the “one or more” construction of the indefinite article “a” when used in a patent claim was already well established. See *N. Am. Vaccine, Inc. v. Am. Cyanamid Co.*, 7 F.3d 1571, 1575–76 (Fed. Cir. **1993**) (citing Robert C. Faber, Landis on Mechanics of Patent Claim Drafting 531 (3d ed. **1990**)).

(“In a claim, the indefinite article A or AN connotes ‘one or more.’”); *see also* Root, *supra*, at § 3.03 (2023) (citing John H. Landis, *Mechanics of Patent Claim Drafting* (1970)). Prior to petitioner bringing this litigation, the Federal Circuit in *Baldwin* “strongly restated” this traditional rule. Root, *supra*, at § 3.03 (“The fact that [the *Baldwin*] court referred to this principle as ‘best described as a rule, rather than merely a presumption or even a convention,’ underlines the fact that *the Federal Circuit expects this principle to be applied as a matter of course.*” (emphasis added)).

Petitioner’s ’467 Patent describes “a” (i.e., a non-singular) microprocessor performing certain functions, a key aspect of which is the integration and use of *a plurality* of microprocessors. Petitioner thus had the legitimate expectation that his claim would be construed by the Panel consistent with *Baldwin*’s well-settled, bedrock precedent so that it would encompass the use of multiple microprocessors in performing the claimed functions. Its construction to require instead that a single microprocessor perform each and every function of the claim—founded as it was on the Panel’s overt and unexpected abnegation of *Baldwin* and its progeny—rendered his patent worthless, directly interfering with his distinct investment-backed expectations. The negative economic impact on petitioner is self-evident and the character of the government action in the form of the Panel’s erroneous claim construction at odds with its



well-settled precedent is direct and immediate. A judicial taking of petitioner's property in violation of the Fifth Amendment has therefore been made out, warranting reversal of the Panel's ruling and a remand of the matter to the district court for the resolution of petitioner's infringement claims.

That the Panel's unfair, unexpected claim construction at odds with its well-settled precedent constitutes a judicial taking of petitioner's property has been anticipated by several decisions of this Court. In *Hughes v. Washington*, 389 U.S. 290 (1967), the Washington Supreme Court, ignoring a 1946 state decision to the contrary, held that the state—not the landowner—owns certain accretions of land deposited on uplands. *Id.* at 291–92. A majority of the Court determined that ownership was a federal issue and reversed. *Id.* In a concurring opinion, Justice Stewart made the point that while a state's highest court will have the final word on state law, “to the extent that [its] judicial decision “constitutes *a sudden change* in state law, unpredictable in terms of the relevant precedents, no such deference would be appropriate.” *Id.* at 296 (Stewart, J., concurring) (emphasis added).

Justice Stewart concluded that state court judges could not defeat the constitutional prohibition against the taking of property by the simple expedient of asserting retroactively that the property it has taken “never existed at all.” *Id.* at 297 (Stewart, J., concurring). The Due Process Clause forbids such

confiscation “no less through its courts than through its legislature, and no less when a taking is unintended than when it is deliberate.” *Id.* at 298 (Stewart, J., concurring) (emphasis added).

In *Pruneyard Shopping Center v. Robins*, 447 U.S. 74 (1980), the Court responded to a shopping center owner’s claim of a taking after the California Supreme Court, overturning its own well-settled precedent, ruled that it could not regulate citizens’ expressive activity there. *Id.* at 78–80. Justice Rehnquist agreed that “there has literally been a ‘taking’ of that right [to exclude others] to the extent that the California Supreme Court has interpreted the State Constitution to entitle its citizens to exercise free expression and petition rights on shopping center property.” *Id.* at 82.

Similarly, in *Stop the Beach Renourishment, Inc. v. Florida Department of Environmental Protection*, 560 U.S. 702 (2010), Justice Scalia, writing for a plurality of the Court, acknowledged that a judicial taking occurs when “governmental actors,” i.e., the Florida Supreme Court, “recharacterize as public property what was previously private property.” *Id.* at 713. He concluded that a judicial taking is committed when a court “declares that what once was an established right of private property no longer exists.” *Id.* at 715.

Thus, the sum and substance of this Court’s jurisprudence on judicial takings is that where a court, contradicting well-settled precedent, unfairly

and unexpectedly decides that a person's property is no longer his but instead belongs to the public, it constitutes a judicial taking which can only be remedied by a reversal of that unconstitutional judgment. *Id.* at 723; *Hughes*, 389 U.S. at 298; *See also Zoltek Corp. v. United States*, 442 F.3d 1345, 1376–77 (Fed. Cir. 2006) (Plager, J., dissenting) (acknowledging the “constitutional remedy” under the Fifth Amendment for inverse condemnation arising from the taking of patent rights by government action).

This issue of predictability and reasonable reliance on well-settled precedent to justify relief in the takings context aligns with the Court's decisional law addressing due process generally. This Court has held that where a federal appellate court interprets a state statute or practice in a way that was “unforeseen” or “indefensible by reference to the law which had been expressed prior to the conduct in issue” in order to deny a litigant a hearing on the substantive right affected, it violates due process. *See Bush v. Gore*, 531 U.S. 98, 115 (2000) (Rehnquist, J., concurring); *see also United States v. Lanier*, 520 U.S. 259, 266 (1997) (due process bars courts from applying a novel construction of a criminal statute to conduct that neither the statute nor any prior judicial decision had fairly disclosed to be within its scope); *NAACP v. Ala. ex rel. Patterson*, 357 U.S. 449, 457–58 (1958) (state court's unexpected resort to new procedural rules to

deny relief to alleged contemnors violates due process).

By recharacterizing petitioner’s patent claims to exclude his disclosed invention, the Panel’s ruling constitutes a judicial taking of his property in violation of the Fifth Amendment. This Court should reverse the judgment below and remand the matter to the district court for the resolution of petitioner’s infringement claims.

**C. This Case Presents an Ideal Opportunity for the Court to Rectify the Unconstitutional Judicial Taking of Patent Rights.**

The related issues of reasonable reliance, inadequate forewarning, and unfair surprise in judicial decisions—all of which can converge to cause a judicial taking of property without due process—are particularly important in the context of patent law. As Justice Kennedy wrote in *Festo Corp.*, patent laws strike a “delicate” balance “between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor’s exclusive rights.” 535 U.S. at 731; see also *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 146 (1989).

However, this delicate balance is put at risk when the Federal Circuit—which has jurisdiction over nearly all patent appeals in the United States—makes changes without warning, adopting new rules for claim construction and blindsiding inventors like petitioner who have justifiably relied on *Baldwin’s* “one or more” rule when drafting the patent claims for his disclosed invention. As Justice Kennedy cautioned:

[f]undamental alterations in [patent rules] risk destroying the legitimate expectations of inventors in their property. . . . “To change so substantially the rules of the game now could very well subvert the various balances the [Patent and Trademark Office] sought to strike when issuing the numerous patents . . . .

*Festo Corp.*, 535 U.S. at 739 (quoting *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 32 n.6 (1997)).

Such is the case here. Petitioner justifiably relied on the “one or more” bedrock rule in describing his invention. The Panel’s unfair, unjustifiable, and unforeseeable abnegation of that rule has now rendered petitioner’s patent worthless. The Panel’s claim construction so substantially changed the rules of the game as to subvert not only the legitimate investment-backed expectations of petitioner but also

the delicate balance between inventors who rely on the law and the public domain. And this erroneous claim construction constitutes grounds for granting a partial new trial on infringement. *Network-1 Techs., Inc. v. Hewlett-Packard Co.*, 981 F.3d 1015, 1022 (Fed. Cir. 2020) (“It is well established that when an incorrect jury instruction—such as an incorrect claim construction—removes from the jury a basis on which the jury could reasonably have reached a different verdict, the verdict should not stand.”).

This case provides a valuable opportunity for the Court to remedy the Panel’s unconstitutional judicial taking and protect the constitutional objective of patent law. Petitioner appropriately argued in his petition for rehearing *en banc* that, should the Federal Circuit’s decision stand, it would constitute an unconstitutional taking. Further, because of the exclusive federal jurisdiction over patent law issues, this case does not raise any of the federalism issues often inherent in takings claims. *See, e.g., Stop the Beach Renourishment, Inc.*, 560 U.S. at 742 (Breyer, J., concurring) (expressing concerns regarding federalism issues).

It is exceptionally important for the Court to protect patent owners who are otherwise left without recourse when a Federal Circuit panel dramatically and unjustifiably departs from well-settled precedent. Patent owners must have confidence that the patent claims covering their invention will be construed in

accordance with well-settled principles of claim interpretation and in a manner that includes the disclosure of the “present invention” and embodiments of the patent, barring any specific limiting language in the specification or prosecution history. This fundamental patent law principle is crucial to a robust and efficient patent system.

## CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted, the judgment of the Federal Circuit should be vacated, and the matter should be remanded to the district court for the Eastern District of Texas, Marshall Division, instructing the district court to conduct a partial new trial on infringement with a constitutionally sound construction of petitioner’s patent claims.

Respectfully submitted,

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September 6, 2023

# **APPENDIX**