No. 25-225

IN THE
Supreme Court of The United States

MSN PHARMACEUTICALS, INC., ET AL.,
Petitioners,

v.

NOVARTIS PHARMACEUTICALS CORPORATION,
Respondent.

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

BRIEF OF UNIFIED PATENTS, LLC AS AMICUS CURIAE IN SUPPORT OF PETITIONERS

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October 1, 2025

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INTEREST OF THE *AMICUS CURIAE*[1]

Unified Patents, LLC ("Unified") is a membership organization dedicated to deterring non-practicing entities ("NPEs") from extracting nuisance settlements from operating companies based on low-quality, likely invalid patents. Unified's more than 3,000 members are Fortune 500 companies, start-ups, automakers, industry groups, cable companies, banks, open-source developers, manufacturers, and others dedicated to reducing the drain on the U.S. economy resulting from defense and settlement costs attributable to now-routine baseless lawsuits asserting infringement of patents of dubious validity.

Unified seeks to improve patent quality and deter unsubstantiated or invalid patent assertions through its activities, including analytics, prior art, invalidity contests, patentability analysis, administrative patent review, amicus briefs, economic surveys, and essentiality studies. These activities focus on a number of defined technology sectors, with a concentration in the "high tech" industry.

While the patent right was intended to encourage innovation by rewarding inventors with a right to exclude others from incursion into the inventor's contribution to the art, patent prosecution and litigation are increasingly used by holding

[1] Counsel of record for all parties received notice at least 10 days prior to the due date of amicus curiae's intention to file this brief. Amicus curiae certifies that no counsel for a party authored this brief in whole or in part and no person or entity, other than amicus, its members, or its counsel, has made a monetary contribution to its preparation or submission.

companies who view the ability to assert broad claims and negotiate favorable settlements as an investment opportunity. The Federal Circuit's decision encourages this behavior by creating uncertainty as to how far a patentee may extend its claim scope beyond its contribution to the art to capture after-arising technology. Unified has an interest in clarifying this uncertainty to deter its opportunistic use and provide predictability to innovators and litigants.

INTRODUCTION AND SUMMARY OF ARGUMENT

This Court's guidance is needed to explain how and when after-arising technology may be used to assess compliance with Section 112 of the Patent Act. While some Federal Circuit precedent has required consistent treatment of after-arising technology with respect to infringement and Section 112 validity, a diverging line of cases conflicts with that precedent, allowing for inconsistency between the scope of the right to exclude and the obligation to disclose.

The purpose of the patent right is to incentivize American innovation, and investment thereof, by awarding inventors with limited monopolies that allow for monetization of their invention. Without such reward, the time and cost of the research and development required to advance technology may not be economical, and investment in innovation may fall away. To ensure that the patent right fulfills its purpose of making invention economical without inhibiting future progress, however, the scope of the patentee's monopoly must be proportional to his contribution to the art.

After-arising technology (i.e., technology that is first developed after the effective date of a patent) presents a unique challenge with respect to fulfilling the purpose of the patent right. By definition, the patentee cannot have disclosed and contributed this after-arising technology to the art (as required by 35 U.S.C. § 112). However, some courts have viewed it as unfair to invalidate a patentee's claims covering the technology that it *did* invent based on later-arising

developments the patentee did not foresee.

This has led to conflicting precedent within the Federal Circuit. According to a first line of cases (the *Idenix* Line), when after-arising technology is included within a claim's scope for infringement purposes, such technology is relevant to the question of validity of that claim under 35 U.S.C. § 112. According to a second, contradictory line of cases (the *Hogan-Entresto* Line), after-arising technology can be captured within a claim's scope for infringement, but the same technology cannot be considered in assessing Section 112 validity. In other words, the *Idenix* line of cases assumes a singular claim scope for both the patentee's right to exclude and his duty to disclose, while the *Hogan-Entresto* line allows for different claim constructions for different purposes.

The result of these diverging lines of cases is that future inventors, investors, patent drafters, and litigants faced with similar circumstances will not know what approach is likely to prevail. This uncertainty extends across technological areas, encourages predatorial patent litigation, and is the antithesis of the predictability that promotes investment in innovation.

This Court should thus take up the question presented in the Petition – i.e., "whether, in a patent-infringement suit, a court may consider after-arising technology to hold that the patent is invalid under § 112(a)." Petition, at i. The *Idenix* line answers this question in the affirmative. The *Hogan-Entresto* line says the opposite. This Court should reject the inconsistent treatment of claim scope for infringement

and validity purposes that has arisen from the *Hogan-Entresto* line of cases.

ARGUMENT

I. Federal Circuit Precedent Has Established Three Competing Regimes for Analysis of After-Arising Technology

Unlike many of our legal apparatuses, no investigation is required to divine the purpose of the patent right – it is written explicitly into the Constitution. Article I, Section 8, Clause 8 of the Constitution grants Congress the power to provide inventors with time-limited monopolies to their discoveries in order "[t]o promote the progress of science and the useful arts." Such monopolies are a double-edged sword: on the one hand, they encourage and support investment in innovation, but on the other, they provide barriers to those technologists who come after. In order to balance these effects, an inventor is awarded with a monopoly proportional to his contribution to the art.

> Right there in the text, one finds the outline of what this Court has called the patent 'bargain.' *Bonito Boats*, *Inc.* v. *Thunder Craft Boats*, *Inc.*, 489 U. S. 141, 150, 109 S. Ct. 971, 103 L. Ed. 2d 118 (1989). In exchange for bringing 'new designs and technologies into the public domain through disclosure,' so they may benefit all, an inventor receives a limited term of "protection from competitive

> exploitation." *Id.*, at 151, 109 S. Ct. 971, 103 L. Ed. 2d 118; *see also* The Federalist No. 43, p. 272 (C. Rossiter ed. 1961) (J. Madison) (explaining that in such cases "[t]he public good fully coincides . . . with the claims of individuals").

Amgen Inc. v. Sanofi, 598 U.S. 594, 604 (2023). In other words, it is well-established that the same claim scope is applied for the infringement analysis (i.e., the patentee's right to exclude) as for the validity analysis under the written description requirement of 35 U.S.C. § 112 (i.e., the patentee's requirement to disclose the invention).

After-arising technology (i.e., technology that is first developed after the effective date of a patent) presents a unique challenge to this principle of proportionality. A patentee cannot have had possession of such technology at the time of filing (as required by the written description requirement of Section 112). But, courts have been wary of invalidating a patentee's fairly-earned patent covering the technology that it *did* invent on the basis of later-arising developments that may happen to fall within the claim scope on its face. In grappling with this issue, disparate regimes have arisen within Federal Circuit jurisprudence.

According to a first line of cases (the *Idenix* Line), after-arising technology that is undisputedly included within a claim's scope for infringement purposes may be considered in determining the validity of that claim under the written description requirement of 35 U.S.C. § 112. According to a second,

contradictory line of cases (the *Hogan-Entresto* Line), it is possible for after-arising technology to be included within a claim's scope for infringement, while the same technology *cannot* be considered for Section 112 validity.

After-Arising Technology		
	Claim Scope for Infringement	Claim Scope for Validity
Idenix Line	✓	✓
Hogan-Entresto Line	✓	×

A. The *Idenix* Line: After-Arising Technology Is Relevant to Both Infringement and Section 112 Validity Analysis

In a first line of cases extending back approximately 20 years, the Federal Circuit has applied a consistent claim scope to both infringement and Section 112 validity analysis when dealing with after-arising technology. In the most recent of these cases, *Idenix Pharmaceuticals LLC v. Gilead Sciences Inc.*, 941 F.3d 1149 (Fed. Cir. 2019), the claim-at-issue recited a class of nucleosides. *Id.* at 1153-55. Gilead's accused product included a species of "methyl-up fluoro-down nucleoside." *Id.* at 1154. It was undisputed that no "methyl-up fluoro-down" nucleoside (like Gilead's) was disclosed anywhere in the asserted patent because "Idenix 'only came up with the[se]…embodiments a year or so after the

application was filed." *Id*. at 1164. In other words, Gilead's "methyl-up fluoro-down" nucleoside was after-arising technology.

Before the district court, Gilead requested a narrow construction of the claimed nucleoside that would have excluded the after-arising nucleosides included in Gilead's product. However, the district court rejected Gilead's request in favor of a broader construction that encompassed the "methyl-up fluoro-down" subclass." *Id.* Relying on this construction, Gilead stipulated to infringement because its nucleoside fell within the literal scope of the construed claim. *Id*. at 1153, 1164.

As neither party challenged the district court's claim construction on appeal, the Federal Circuit considered the broad construction—which included the after-arising "methyl-up fluoro-down" nucleosides—to be binding and found the claims to be invalid under Section 112 both for lack of enablement and lack of written description. *Id*. at 1165, 1156 n.3. With respect to the written description inquiry, the Federal Circuit explicitly considered the after-arising technology, stating that "[t]he question in this case is whether…the specification demonstrates possession of the 2'-methyl-up 2'-fluoro-down nucleosides that are the basis for Gilead's accused product." *Id.* at 1163-64. Because the claim construction encompassed the after-arising technology for infringement purposes, the Federal Circuit also considered the technology for Section 112 validity, ultimately finding the claims to lack both proper enablement and written description. *Id*. at 1165.

Similarly, in *Plant Genetic Systems v. DeKalb Genetics Corp.*, 315 F.3d 1335 (Fed. Cir. 2003), the Federal Circuit rejected the patentee's argument that it was "entitled to a broad scope of coverage and lower standard of [disclosure]." *Id*. at 1339. The asserted patent in *Plant Genetic Systems* recited certain types of plant cells. *Id*. at 1337. "A key issue…[was] the scope of both sets of the claims, i.e., what kind of plants or plant cells are covered by the claims" – monocots or dicots. *Id*. at 1338. The asserted patent did not disclose any working examples involving monocots, and "the scientific community was not able to transform monocots until after it first transformed dicots." *Id.* In this case, monocot cells were the after-arising technology.

The parties agreed that the asserted claims covered *all* plant cells – including both dicots and monocots. "Only by doing so [could] PGS sue DeKalb, which makes monocot products." *Id.* at 1341. Even in the context of after-arising technology, the Federal Circuit maintained that "the scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification" and found the claims invalid for lack of enablement for failure to disclose how to make and use monocot cells. *Id*. at 1340-41, 1346.

In a similar situation in *Chiron Corp. v. Genentech, Inc.*, 363 F.3d 1247, 1249 (Fed. Cir. 2004), the asserted patents recited certain antibodies. Genentech's accused product included a genetically engineered antibody. *Id*. at 1251. Genetically engineered antibodies were only successfully developed several months after the filing date of the

asserted patent. *Id*. at 1254. Thus, such antibodies were not disclosed. Accordingly, genetically engineered antibodies were after-arising technology.

Based on the plain meaning of the claims, the district court construed the asserted claims to include both natural and genetically engineered antibodies. *Id*. at 1252. Consistent with *Idenix* and *Plant Genetic Systems*, the Federal Circuit found a lack of written description because "the Chiron scientists, by definition, could not have possession of, and disclose, the subject matter…that did not even exist at the time of the 1984 application." *Id*. at 1255.

B. The *Hogan-Entresto* Line: After-Arising Technology Is Relevant to Infringement Analysis But Not for Section 112 Validity Analysis

At the same time, a contrasting line of cases has arisen in which the Federal Circuit has applied a disparate treatment of infringement and Section 112 validity analysis when dealing with after-arising technology. The most recent of these cases is the subject of the present Petition – *In re Entresto (Sacubitril/Valsartan)*, 125 F.4th 1090 (Fed. Cir. Jan 10, 2025). In *Entresto*, the asserted '659 Patent recited a composition including a "combination" of sacubitril and valsartan. *Id.* at 1094. Both Novartis's Entresto® and MSN's accused product included sacubitril and valsartan, present together in a chemical complex. *Id.* at 1154. It was undisputed that the '659 Patent did not describe a sacubitril/valsartan complex because such a complex was "not discovered until four years

after the priority date," making the complex the after-arising technology at issue. *Id*. at 1097.

As in *Idenix*, before the district court, MSN requested a narrow construction of "combination" to be limited to a combination in which sacubitril and valsartan were separate components (i.e., a physical mixture). *Id.* at 1095. This narrow construction would have excluded both Entresto and MSN's product. However, the district court found that the claim term was broad enough to encompass complexes as well as physical mixtures of sacubitril and valsartan. *Id.* Relying on this construction, MSN stipulated to infringement. *Id*. The Federal Circuit allowed this stipulation to stand.

It is at this point that the Federal Circuit diverged from the *Idenix* line. Despite the patentee's insistence during claim construction that the recited genus of "combinations" included both physical mixtures and complexes (*In re Entresto Sacubitril/Valsartan Patent Litig.*, 2023 U.S. Dist. LEXIS 117240 at *67 (D. Del. Jul. 7, 2023)), the Federal Circuit *refused* to consider such complexes as part of its Section 112 validity analysis. The Federal Circuit held that "[t]he fact that the '659 patent does not describe a complexed form of valsartan and sacubitril does not affect the validity of the patent." *Id*. at 1098. It was the Federal Circuit's view that the "complex—not discovered until four years after the priority date of the '659 patent—is not what is claimed." *Id*. Accordingly, the court determined that "[t]he later-discovered valsartan-sacubitril complexes…cannot be used to 'reach back' and invalidate the asserted claims." *Id*. at 1100.

Similarly, in *In re Hogan*, 559 F.2d 595 (Fed. Cir. 1977), the claims recited a polymer. *Id*. at 597. In this instance, amorphous forms of the claimed polymer were the after-arising technology, not having been in existence at the time of filing of the application (as opposed to the crystalline forms, which were known at the time of filing). *Id*. at 605. However, the Federal Circuit rejected the notion that the inclusion of the amorphous polymer could render the claims invalid under Section 112, criticizing "[t]he use of a subsequently existing improvement to show lack of enablement in an earlier-filed application." *Id*. at 606.

At the same time, the Federal Circuit left open the possibility that the claims could capture the after-arising amorphous polymers for infringement. While the Federal Circuit acknowledged a concern that the breadth of the claim "might lead to enforcement efforts against later developments," the court found this consideration to be irrelevant when considering whether the claims should issue. *Id*. at 607. While the court speculated that the requirement to construe claims in light of the specification might help "preclude improper enforcement against later developers," it simultaneously acknowledged a patentee's "right to broad claims," noting that "[t]o restrict appellants to the crystalline form disclosed…would be a poor way to stimulate invention….To demand such restriction is merely to state a policy against broad protection for pioneer inventions, a policy both shortsighted and unsound from the standpoint of promoting progress in the useful arts…." *Id*.

C. The Precedents Are Contradictory

Each of these cases treats the analysis of after-arising art differently, leading patentees, accused infringers, innovators, and counsel to a different conclusion depending on which line is followed.

Strikingly, the approach taken by the majority in *Entresto* corresponds closely to the approach taken by the dissent in *Idenix*. In *Idenix*, the dissenting opinion conceded that the asserted patent contained "a large number of unclaimed chemical variants…[that] are not described, not synthesized, and not tested for antiviral activity." *Idenix*, 941 F.3d at 1165. However, the dissent argued that "[i]t is incorrect to include these variants in the claims and then to invalidate the claims because these variants are not described and not enabled." *Id.*

The *Idenix* majority criticized the dissent's position for ignoring the "binding" claim construction made by the district court that allowed the claims to encompass the undisclosed, after-arising variants and the accused product. *Id*. at 1156 n.3. The majority clarified that "[t]he question before us is whether the '597 patent enables the full scope of its claims under the district court's broad construction. The dissent declines to answer that question, and instead applies its own 'narrow' claim construction…." *Id.*

Entresto took the same approach as the dissent in *Idenix*. As in *Idenix*, the *Entresto* case involved a broad claim construction urged by the patentee, adopted by the district court, and not challenged on appeal. But like the dissent in *Idenix*, the majority in *Entresto* diverged from this broad construction to *sua*

sponte adopt a narrower claim scope for the validity analysis, holding that "[b]ecause the '649 patent does not claim valsartan-sacubitril complexes, those complexes need not have been described." *Id*. at 1098. The problem with this approach is that it is outcome-oriented; by construing the claims narrowly to avoid invalidity, a contradictory construction is now left intact for purposes of infringement.

The result is that future litigants faced with similar circumstances will not know which approach is likely to prevail. The uncertainty is problematic not only for patent holders but also for those developing new technologies. Without knowing which standard the Federal Circuit is likely to apply, it is impossible to know whether any given patent will be held to read on after-arising technology that someone else invents independently and, if so, whether that patent is valid or not. This uncertainty is not only contrary to the constitutional patent bargain recognized by the courts, but it disincentivizes innovation, harms competition, and encourages predatorial patent litigation. Such uncertainty merits resolution via grant of the present Petition.

II. Resolution Is Required to Provide Predictability to Innovators Across Technology Areas

While this issue is currently brought to light via a pharmaceutical case in *Entresto*, the existing uncertainty extends across industries and technology areas because any use of broad, categorical, generic, or functional claim terms runs the risk of inadvertently or intentionally capturing after-arising

technology. That the claims cover technology that is independently invented by another at a later time is certainly a relevant fact in determining compliance with Section 112.

For instance, in the chemical and biological art areas, claims reciting a genus including multiple species of chemical compounds, cells, or macromolecules, such as nucleic acids (e.g., DNA and/or RNA), are ubiquitous. In *Idenix*, for example, the asserted claims recited a genus of nucleosides that captured the after-arising "methyl-up fluoro-down" species. *Idenix*, 941 F.3d at 1164.

A similar scenario may arise in mechanical patents that recite materials by a categorical term (e.g., "a metal," "a plastic," etc.). An early example is found in *The Incandescent Lamp Patent,* 159 U.S. 465 (1895), in which the patent-at-issue claimed a lightbulb having a filament made out of "carbonized fibrous or textile material." *Id.* at 468. The claims in that case broadly recited the category of "carbonized fibrous…material," which no one disputed captured the specific bamboo filament later developed for use in Thomas Edison's highly successful electric lightbulb. *Id.* at 473-76. In construing the claims according to their plain meaning and finding them invalid for lack of enablement, this Court considered, among other factors, that the embodiments disclosed by the patentee were "inferior to those afterwards discovered by Edison." *Id*. at 476.

Functional claims also have a significant likelihood of ensnaring after-arising technology. Functional claiming is highly prevalent in the

electrical and computer art areas, where software is commonly claimed by what it *does*, rather than by the corresponding algorithmic structure (i.e., what it *is*). *See Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1327-28 (Fed. Cir. 2016) (Mayer, J., concurring) (noting "the vast number of software patents—most of which are replete with broad, functional claims"). In the mechanical art areas, functional claiming often takes the form of recitation of components "configured to" or "adapted to" perform certain functions. Functional claiming may also appear in the chemical and biological spaces. For example, macromolecules with variable or uncharacterized structures, such as polymers, may be claimed by their properties (e.g., average molecular weight, viscosity at certain temperatures, absorbance, etc.). Broad functional claims leave open the possibility of capturing after-arising methods and structures that accomplish the claimed function. *See id.* at 1327 ("Engineers can describe what they want software to do—in terms that have been sufficient for the PTO—well before they have made it work.").

Accordingly, innovators and investors across technology areas would benefit from clarification of the doctrinal uncertainty surrounding after-arising technology.

III. A Double Standard for Infringement and Validity Cannot Be the Answer

Federal Circuit precedent currently offers two options for dealing with after-arising technology: (1) treating it the same for purposes of infringement and invalidity (*Idenix*); or (2) considering it irrelevant

to the question of Section 112 validity (*Hogan-Entresto*) but allowing it to be captured for infringement.

After-Arising Technology		
	Claim Scope for Infringement	Claim Scope for Validity
Idenix Line	✓	✓
Hogan-Entresto Line	✓	✗

Hogan-Entresto's disparate treatment of after-arising technology with respect to infringement and validity is simply not viable. This approach creates an imbalance between the scope of what the patentee actually invented and disclosed to the public and the patentee's right to exclude. This imbalance strikes at the heart of the basic patent bargain, allowing the patentee to enjoy an unearned windfall by capturing technology that it did not invent and forcing later inventors to gamble on whether their independently developed technology will be ensnared. Rather than incentivizing true innovative efforts by rewarding the patentee for an invention disclosed to the public, this regime stifles progress by allowing a patentee to occupy and exclude others from a technological space that it did not contribute to.

More specifically, such a rule creates ripe opportunities for non-practicing entities ("NPEs") and other predatory patent holders. Removing the teeth from the Section 112 disclosure requirement opens the door for strategic prosecution, by which a patentee may use an older patent family (with early priority

dates) to pursue broad claims[2] that intentionally capture successful after-arising technologies. Such claims would be well-insulated from prior art challenges due to early priority dates and would also be insulated from Section 112 invalidity under *Hogan-Entresto*, allowing an NPE, patent monetization firm, or opportunistic patent holder to extract favorable royalties or settlement fees from successful technology that it did not create, upending the constitutionally-stated purpose of the patent right. Accordingly, this Court would do well to dispense with the *Hogan-Entresto* approach.

Although *Hogan-Entresto*'s application of a double standard to infringement and validity cannot be correct, these cases did raise valid concerns regarding the fairness of applying after-arising technology to Section 112 validity analyses. For instance, the court in *Hogan* articulated the concern that it would be unfair to invalidate a patentee's claims to technology that it *did* invent based on future developments. *Hogan*, 559 F.2d at 606. Regarding the "solid polymer" claimed in *Hogan*, the Federal Circuit reasoned that "[a]ppellants disclosed, as the only then existing way to make such a polymer, a method of making the crystalline form. To now say that appellants should have disclosed in 1953 the amorphous form which on this record did not exist until 1962, would be to impose an impossible burden

[2] A patent's likelihood of acquisition by an NPE increases with its claim scope, suggesting that NPEs strategically use earlier-filed patents with broad claims to capture infringers. Fischer, T., et. al., *Patent trolls on markets for technology – An empirical analysis of NPEs' patent acquisitions*, 41 Research Policy 9, 1519-1533 (2012).

on inventors and thus on the patent system." *Id*. Amicus appreciates this concern; in dealing with these concerns, a distinction should be made between *inadvertent* capture of after-arising technology and *intentional* capture of after-arising technology.

It might be appropriate to construe claims narrowly where patentees have *inadvertently* captured after-arising technology, i.e., to encompass only what the inventor possessed and disclosed at the time of filing. *See, e.g.*, *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1581 (Fed. Cir. 1996) ("Where there is an equal choice between a broader and a narrower meaning of a claim, and there is an enabling disclosure that indicates that the applicant is at least entitled to a claim having the narrower meaning, we consider the notice function of the claim to be best served by adopting the narrower meaning."). But then, in the infringement analysis, the patentee will have the same narrow claim construction.

The Federal Circuit has taken this approach before. For example, in *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347 (Fed. Cir. 2000), the asserted patent recited "IFN-alpha" – a polypeptide that may be derived naturally from cells (e.g., leukocytes) or may be produced synthetically. *Id.* at 1349-53. However, synthetically produced IFN-alpha subtypes were not available at the time of filing of the application, making them after-arising technology. *Id*. at 1352.

At the time of filing, the asserted patent did not use the term "IFN-alpha" but instead recited "leukocyte interferon" in reference to natural, leukocyte-derived polypeptides. *Id.* at 1352. After

filing, the application was amended to claim "IFN-alpha" in view of a change in terminology within the scientific community. *Id*. at 1352. Unlike the original term, "IFN-alpha" identified a particular polypeptide by its physical and chemical characteristics, rather than by its origin – i.e., leukocytes. *Id.*

Accordingly, the Federal Circuit inquired into whether this new (and facially broader) term would encompass synthetic IFN-alpha subtypes. It concluded that "this court interprets the claim at issue to cover no more than what the specification supported at the time of filing." *Id.* at 1353. Accordingly, the Federal Circuit found that the after-arising technology was outside of the claim scope for purposes of both infringement and validity. "To grant broader coverage would reward [the inventor] for inventions he did not make." *Id*. at 1354.

This approach avoids unfairly rewarding the patentee for inventions it did not make, as well as unfairly punishing the patentee for lack of clairvoyance in predicting and claiming around future developments. Further, this approach comports with the requirement that claims be interpreted as they would have been viewed by a person of ordinary skill in the art at the time of filing[3] as well as with the well-established axiom that claims should be construed to preserve their validity. *See Rhine v. Casio, Inc.*, 183 F.3d 1342, 1345 (Fed. Cir. 1999).

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[3] *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1315 (Fed. Cir. 2003) ("The best indicator of claim meaning is its usage in context as understood by one of skill in the art at the time of invention.").

But what's good for the goose must be good for the gander. Where a patentee uses claim construction to *intentionally* ensnare after-arising technology to obtain a stipulation of infringement, they must be held to that same construction for purposes of invalidity. As the majority explained in *Idenix*, "[t]he question before us is whether the [specification] enables the full scope of its claims under the district court's broad construction." *Idenix*, 941 F.3d at 1156 n.3. It is not proper for the appellate court to apply a "newly invented claim construction to find a hypothetical narrower claim valid….Respectfully, that is no way to conduct an appeal." *Id.*

In sum, consistency must be the answer. When a patent claim inadvertently captures after-arising technology, a narrow construction is proper to preserve validity and proportionally reward the patentee's contribution to the art. However, when the patentee intentionally insists on a broad construction to establish infringement as part of its litigation strategy, this construction must also be applied for validity analysis.

CONCLUSION

The petition should be granted to clarify which line of Federal Circuit precedent applies and to provide clear direction as to the appropriate treatment of after-arising technology.

Respectfully submitted,

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October 2025