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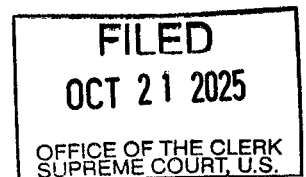
IN THE  
**Supreme Court of the United States**

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CHIAN CHIU LI,  
*Petitioner,*

v.

APPLE INC.,  
*Respondent.*



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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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*Pro Se Petitioner*

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October 21, 2025

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## **QUESTIONS PRESENTED**

Section 112(a) of Title 35 requires that a patent include a specification containing “a written description of the invention ... in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same.”

The Federal Circuit held that a patent need not expressly state the absence of a feature in order to support a negative limitation in the specification, and did not identify what, if anything, must be present in the written description to support such a limitation.

The question presented is:

Whether, under 35 U.S.C. § 112(a), a patent specification must include a written description supporting a claimed negative limitation.

## **PARTIES TO THE PROCEEDINGS**

Petitioner is Chian Chiu Li, an individual.

Respondent is Apple, Inc.

## **RULE 29.6 DISCLOSURE STATEMENT**

The Petitioner is an individual. No interest of the Petitioner in this case is assigned to any corporation or any publicly held company.

## **LIST OF PROCEEDINGS**

- *Chian Chiu Li v. Apple Inc.*, No. 2024-2148, United States Court of Appeals for the Federal Circuit. Judgment was issued on June 9, 2025. Rehearing was denied on July 24, 2025.
- *Apple Inc. v. Chian Chiu Li*, No. IPR2023-00560, Patent Trial and Appeal Board. Final written decision was entered on May 29, 2024.
- *Apple, Inc. v. Chian Chiu Li*, No. 3:22-cv-02956-TLT (N.D. Cal.)

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

Petitioner respectfully requests a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

### **OPINIONS BELOW**

The decision of the U.S. Court of Appeals for the Federal Circuit (App.1a-6a) was entered on June 9, 2025, and is not reported. The final decision of the Patent Trial and Appeal Board (App.7a-23a) was entered on May 29, 2024, and is reported.

### **JURISDICTION**

The judgment of the United States Court of Appeals for the Federal Circuit was entered on June 9, 2025. App.1a. A timely filed petition for rehearing was denied on July 24, 2025. App.24a. The jurisdiction of the Court is invoked under 28 U.S.C. § 1254(1).

### **STATUTORY PROVISIONS INVOLVED**

#### **35 U.S.C. § 112(a)**

(a) In General.—

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor or joint inventor of carrying out the invention.

## STATEMENT OF THE CASE

### A. Introduction

This case concerns the proper application of 35 U.S.C. § 112(a)'s written description requirement to a negative limitation.

The patent at issue is U.S. Patent No. 11,016,564 B2 (“the ’564 Patent”).

App.2a. Apple, Inc. (“Apple”) filed IPR2023-00560 challenging the ’564 Patent.

App.2a. On May 29, 2024, the Patent Trial and Appeal Board (the “Board”) issued its Final Written Decision (“Final Decision”), determining claims 1-6, 8-12, 14-16, and 18-20 of the ’564 Patent were unpatentable. App.21a. A timely appeal was filed with the U.S. Court of Appeals for the Federal Circuit. On June 9, 2025, the Federal Circuit affirmed the Final Decision with its judgment (“Judgment”) and opinion (“the Opinion”). App.6a. A petition for panel rehearing and rehearing en banc was filed timely, and the Federal Circuit denied the petition on July 24, 2025. App.25a.

### B. The ’564 Patent

The ’564 Patent discloses methods for presenting information to a user at an electronic device, such as a smartphone. App. 8b(2:29-41). The electronic device includes a sensor 10 to detect the user’s gaze direction, a sensor 20 to detect the user’ approach, and a sensor 24 to detect movement, such as shaking of the device. App.9b(3:65-4:28). The user’s gaze direction is detected and used to provide an



easy, convenient, and secure method for unlocking the device and displaying information. App.10b-11b(6:61-7:2). Gaze detection is performed after the user either approaches the device (a proximity event) or moves it (e.g., by shaking it). App.10b(6:32-37; 6:58-66). When gaze detection is performed only after detecting a given act involving physical contact with or movement of the device (“Given Act”) – that is, when the proximity event is excluded – it saves energy and prevents privacy leaks. App.11b(7:9-12).

Independent claims 1, 8, and 14 of the ’564 Patent each recite a limitation requiring that gaze detection be performed only after detecting the Given Act. This limitation is referred to as the “only after” limitation.

The ’564 Patent complies with 35 U.S.C. § 112(a) by fully and clearly describing the “only after” limitation, enabling a person skilled in the art to make and use the invention. The Federal Circuit’s Opinion, however, held that a prior art reference need not state the “only after” limitation in its description in order to disclose it, because it constitutes a negative limitation. App.4a-5a.

## **C. The Cited Prior Art**

### **1. U.S. Patent No. 10,540,013 (“Ryu”)**

Ryu discloses a device 100 that includes a sensor 101. App.51b(4:63-65). The sensor 101 detects a movement, such as a rotational movement of the device 100. App.52b(6:61-64). Aside from the sensor 101, Ryu is silent on whether the

device 100 includes any other sensors. When a user rotates the device 100 by a certain number of degrees, functions of a front camera 821 are activated.

App.59b(19:51-59). When it is determined that the user looks at the device 100 (i.e., gaze detection is performed), the device 100 executes a task. App.59b(19:30-34).

Thus, Ryu discloses performing gaze detection after detecting a rotational movement – referred to as the “after” limitation. The rotational movement serves as a movement trigger for performing gaze detection. Ryu, however, is silent on any other trigger for gaze detection and on the “only after” limitation.

Furthermore, because Ryu does not disclose any other triggers (besides the movement trigger) or any other sensors (besides the sensor 101) that could support other triggers, it has no need, motivation, and intent to exclude other triggers. The “only after” limitation expressly excludes other triggers. Therefore, Ryu has no use, need, motivation, or intent to configure or implement the “only after” limitation to exclude non-existent other triggers. As noted, the other triggers could raise privacy and power consumption concerns. Accordingly, Ryu does not disclose the “only after” limitation explicitly or inherently, nor does it expect or imply such limitation – let alone enable a person skilled in the art to make and use it.

Therefore, under 35 U.S.C. § 112(a), Ryu does not disclose the “only after” limitation.

**2. U.S. Patent Publication No. 2010/0079508 (“Hodge”) and U.S. Patent No. 8,331,992 (“Stallings”)**

Both Hodge and Stallings are silent regarding performing gaze detection only after detecting the Given Act. The Board did not find that either Hodge or Stallings discloses the “only after” limitation.

**D. The Final Decision of the Board**

Regarding Ryu’s disclosure, the Board found the device 100 includes the sensor 101 for detecting movement and does not include a proximity sensor. App.14a-15a, 17a. The Board did not address the subject of a negative limitation. Nevertheless, without providing any supporting evidence or rationale, the Board accepted Apple’s assertion that Ryu discloses the “only after” limitation – an assertion that itself lacked evidentiary and analytical support. App.18a.

**E. The Opinion of the Federal Circuit**

The Federal Circuit’s Opinion affirmed the Board’s Final Decision. However, like the Board, the Opinion did not identify any evidence in Ryu’s disclosure supporting the “only after” limitation. Instead, the Opinion cited precedent and reasoned Ryu need not show the “only after” limitation explicitly:

To the extent that Mr. Li contends that “only after” is akin to a negative limitation, prior art references “need not state a feature’s absence in order

to disclose a negative limitation.” AC Techs. S.A. v. Amazon.com, Inc., 912 F.3d 1358, 1367 (Fed. Cir. 2019) (citing Süd-Chemie, Inc. v. Multisorb Techs., Inc., 554 F.3d 1001, 1004–05 (Fed. Cir. 2009) (affirming finding that reference disclosed “uncoated” film where it did not describe the film as coated and did not suggest necessity of coatings)). App.4a-5a (emphasis added).

Before making this “need not state a feature’s absence” statement, the Opinion mischaracterized Petitioner’s argument by asserting that Petitioner contended “the Board’s unpatentability holding must have relied on inherency”, and then stating that the Board “never relied on an inherency theory.” App.4a. Thus, immediately preceding its reliance on precedent, the Opinion merely offered commentary, without any context or analysis indicating that Ryu explicitly or inherently disclosed the “only after” limitation, or that Ryu expected or implied such a limit. Accordingly, the Opinion’s holding effectively concludes that a negative limitation need not have any written description support, nor any qualifying condition.

Thereafter, the Opinion added – from another angle – that Ryu discloses the “only after” limitation “when read as a whole”. App.5a. However, “when read as a whole” is a method of interpretation, not evidence or rationale. The Opinion further relied on a non sequitur in an effort to demonstrate disclosure, stating:

Given that the primary embodiment’s device triggers gaze detection after motion is detected and features no other triggers, a fact finder could reasonably conclude that a skilled artisan would read Ryu’s preferred embodiment as performing gaze detection only after motion is detected. App.5a.

## REASONS FOR GRANTING THE PETITION

### I. The Conflict between the Federal Circuit's Opinion and Its Precedent

The Federal Circuit has held that:

While a negative limitation need not be recited in the specification in haec verba, there generally must be something in the specification that conveys to a skilled artisan that the inventor intended the exclusion, such as a discussion of disadvantages or alternatives. *Novartis*, 38 F.4th 1013, 1017 (Fed. Cir. 2022).

Under *Novartis*, Ryu does not disclose the “only after” limitation, because Ryu contains nothing in its specification that “conveys to a skilled artisan that the inventor intended the exclusion.”

Yet, by stating that prior art references “need not state a feature’s absence in order to disclose a negative limitation,” and by attaching no qualifying conditions, the Opinion directly conflicts with the Federal Circuit’s holding in *Novartis*. With such nearly opposite views, the split and inconsistency within the Federal Circuit on negative limitations are clear and significant. The denial of the petition for panel rehearing and rehearing en banc only deepened this conflict.

Ironically, as discussed below, the Opinion even contradicts the very precedents it cited.

The Opinion quoted *AC Techs S.A. v. Amazon.com, Inc.* as follows: “Prior art references “need not state a feature’s absence in order to disclose a negative

limitation.”” App.4a-5a. However, the preceding paragraph in *AC Technologies* explained that the negative limitation at issue was already disclosed, though not expressly: “The Board found that Rabinovich discloses this limitation because neither cnt(s, xs) nor cnt(E, xs) requires access of Rabinovich’s host ... Substantial evidence supports the Board’s finding.” *AC Technologies S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1366-1367 (Fed. Cir. 2019).

The Opinion also cited *Süd-Chemie, Inc. v. Multisorb Techs., Inc.* to support its view on disclosure of a negative limitation. App.5a. But *Süd-Chemie* similarly explained that the limitation is already affirmatively disclosed: “*Komatsu* plainly teaches that containers can be made of films that are heat sealed without the use of adhesives, and thus without coatings.” *Süd-Chemie, Inc. v. Multisorb Techs., Inc.*, 554 F.3d 1001, 1004 (Fed. Cir. 2009).

The Opinion’s misinterpretation of its own cited precedents further demonstrates that confusion regarding the treatment of negative limitations is deep and pervasive within the Federal Circuit, warranting this Court’s view to provide clarity and uniformity in applying 35 U.S.C. § 112(a).

## **II. The Federal Circuit’s Opinion Departs from the Plain Language and Purpose of 35 U.S.C. § 112(a)**

This Court has stated that: “Section 112 requires only a ‘written description of the invention ... in such full, clear, concise, and exact terms as to enable any

person skilled in the art ... to make and use the same.” Mayo Collaborative Servs. v. Prometheus Labs., Inc., 566 U.S. 66, 90 (2012) (ellipses in original; quoting § 112).

The Federal Circuit’s Opinion, however, held that prior art references need not state a feature’s absence in order to disclose a negative limitation – in effect, that a written description need not be full and clear when disclosing a negative limitation. This holding contradicts the plain language of § 112(a). Under the statute, every element of the invention, including a negative limitation, must be disclosed fully and clearly so that a person skilled in the art is enabled “to make and use the same”. By contrast, silence on a claimed negative limitation cannot enable one of ordinary skill in the art to make and use the limitation.

Accordingly, the Opinion’s approach departs from both the text and purpose of § 112(a), which ensure that patent disclosures are complete, clear, and enabling.

### **III. The Federal Circuit’s Opinion Conflicts with the MPEP**

The Manual of Patent Examining Procedure (MPEP) provides that: “Any negative limitation or exclusionary proviso must have basis in the original disclosure” and “The mere absence of a positive recitation is not basis for an exclusion.” MPEP § 2173.05(i).

The Federal Circuit’s Opinion stands in direct conflict with this well-established guidance. By holding that a reference need not state a feature’s

absence in order to disclose a negative limitation, the Opinion contradicts the MPEP's requirement that a negative limitation must have an explicit basis in the original disclosure, and that mere silence is insufficient.

#### **IV. Whether Disclosing a Negative Limitation Requires a Written**

##### **Description is An Exceptionally Important Question**

Whether disclosing a negative limitation requires a written description has serious consequences for the inventing public. If the Opinion is allowed to stand, many individual inventors and small businesses may be unable to obtain reliable and meaningful patent protection.

If a negative limitation need not be supported by a written description, numerous issued patents containing such limitations could be invalidated by the Board, district courts, and the Federal Circuit – because the claims could be deemed anticipated by mere silence in the prior art.

Such a rule would benefit only well-funded litigants who could exploit the inconsistency between the Opinion and the Federal Circuit's own precedents.

Moreover, it would invite infringers to invalidate otherwise valid patents by relying on the Opinion, thus undermining the stability and integrity of the patent system.

#### **V. This Case is an Ideal Vehicle to Resolve Issues Concerning Negative Limitations**



Respectfully submitted,

Date: October 21, 2025



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