15-1160

No. 15-___

IN THE

Supreme Court of the United States

THE DOW CHEMICAL COMPANY,

Petitioner,

v.

NOVA CHEMICALS CORPORATION (CANADA) and
NOVA CHEMICALS INC. (DELAWARE),

Respondents.

On Petition for a Writ of Certiorari to the United States Court Of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

HARRY J. ROPER
AARON A. BARLOW
PAUL D. MARGOLIS
JENNER & BLOCK LLP
353 North Clark Street
Chicago, IL 60654
(312) 222-9350

KATHLEEN M. SULLIVAN
Counsel of Record
RAYMOND N. NIMROD
WILLIAM B. ADAMS
CLELAND B. WELTON II
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue
22nd Floor
New York, NY 10010
(212) 849-7000
kathleensullivan@
quinnemanuel.com

Counsel for Petitioner

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WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20002

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QUESTION PRESENTED

Whether factual findings underlying a district court's determination on the definiteness of a patent claim under the Patent Act, 35 U.S.C. 112, like a district court's factual findings underlying construction of a patent claim, are subject to appellate review only for clear error or substantial evidence rather than *de novo* review.

RULE 29.6 STATEMENT

The Dow Chemical Company is a publicly traded company. It has no parent corporation, and no publicly held company owns 10 percent or more of its stock.

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INTRODUCTION

In *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014), this Court addressed the standard for patent claim definiteness under 35 U.S.C. 112, but expressly left open the question "whether factual findings subsidiary to the ultimate issue of definiteness trigger" deferential review on appeal. *Id.* at 2130 n.10. In *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831 (2015), this Court answered the very same question in the context of patent claim construction, holding that factual findings subsidiary to claim construction must be reviewed deferentially on appeal. *Id.* at 837-38, 841.

This case presents the perfect vehicle to answer the question left open in *Nautilus* and to consider whether *Teva*'s deference requirement extends from factual findings underlying claim construction to factual findings "subsidiary to the ultimate issue of definiteness." In an appeal from a patent-infringement judgment after jury trial where the jury expressly rejected an indefiniteness defense, the Federal Circuit at first affirmed, upholding the finding that the patent claims at issue here were definite under pre-*Nautilus* case law. But in a later (post-*Nautilus*) appeal from a $28 million supplemental-damages judgment in the same case, the Federal Circuit held the same patent claims indefinite.

The Federal Circuit's about-face on definiteness turned solely on its *de novo* review of a factual issue dependent on extrinsic evidence: namely, whether a person of ordinary skill in the art would know how to make a measurement related to a claim term. The jury implicitly found that a skilled artisan would have such knowledge, but the Federal Circuit declined to consider or give any deference to that finding in

holding the claims indefinite. Had the Federal Circuit applied the normal deference required by Rule 50(a), there is no doubt it would have had to affirm, for the record amply supported the jury's finding: Patents are presumed valid under the Patent Act, uncontested expert testimony showed that a person of ordinary skill in the art would understand the measurement required by the claims, and no evidence (much less clear and convincing evidence) overcame that showing. *See* FED. R. CIV. P. 50(a)(1) (providing for judgment as a matter of law ("JMOL") only if "a reasonable jury would not have a legally sufficient evidentiary basis" for its factual findings).

The need for this Court's review is underscored by the extraordinary fracture this case caused among the judges of the Federal Circuit. The court denied a petition for rehearing *en banc*. App. 165a-166a. Five members of the court concurred in the denial of rehearing but criticized the panel's decision in pointed terms. App. 168a-175a. Four of those judges noted that the panel had failed to give "deference to the jury's underlying fact findings" subsidiary to its definiteness finding. App. 175a. The concurrence recognized that such deference was required, but nonetheless declined to support *en banc* review. The three judges on the panel also concurred in the denial, asserting that their decision adhered to existing precedent. App. 167a. The panel judges did not explain how precedent justified their *de novo* review of the jury's definiteness findings. Two judges dissented on jurisdictional grounds. App. 177a-187a.

Because the Federal Circuit has declined to resolve this important issue despite five judges' acknowledgement that the panel decision applied the wrong standard of review, this Court should grant review

to provide much-needed clarity on the standard of review for subsidiary factual findings on patent definiteness. And, in light of *Teva*, the decision below presents the rare case in which summary reversal would be appropriate.

OPINIONS BELOW

The opinion of the U.S. Court of Appeals for the Federal Circuit is reported at 803 F.3d 620, and reproduced at App. 1a-25a. The order of the court of appeals denying rehearing and the accompanying opinions are reported at 809 F.3d 1223, and reproduced at App. 164a-185a.

A prior opinion of the Federal Circuit in this case is reported at 458 F. App'x 910, and reproduced at App. 54a-105a.

Relevant opinions and orders of the U.S. District Court for the District of Delaware are reported or available, respectively, at 629 F. Supp. 2d 397; 2010 WL 3070189; 2010 WL 3056617; and 2014 WL 1285508. They are reproduced at App. 26a-53a; 106a-118a; 119a-124a; and 125a-163a.

JURISDICTION

The court of appeals issued its decision on August 28, 2015 (App. 1a-25a), and denied Dow's timely petition for rehearing on December 17, 2015 (App. 164a-166a). This Court has jurisdiction under 28 U.S.C. 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

The Seventh Amendment to the Constitution provides:

> In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any court of the United States, than according to the rules of the common law.

Relevant provisions of the Patent Act, 35 U.S.C. 1 et seq., and Rule 50 of the Federal Rules of Civil Procedure, are reproduced at App. 186a-192a.

STATEMENT

A. Statutory Background

The Patent Act provides that a patent "specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter" of the invention. 35 U.S.C. 112; App. 186a-187a. This Court has interpreted that statutory language to mean that a patent is invalid as indefinite "if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention." *Nautilus*, 134 S. Ct. at 2124.

Patents are "presumed valid," 35 U.S.C. 282; App. 188a-189a, and a lack of definiteness, like any "invalidity defense, [must] be proved by clear and convincing evidence," *Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238, 2242 (2011). Definiteness is an issue

of law but may involve subsidiary factual disputes that are properly resolved by a jury. *See, e.g.*, *BJ Servs. Co. v. Halliburton Energy Servs., Inc.*, 338 F.3d 1368, 1372 (Fed. Cir. 2003).

Rule 50 of the Federal Rules of Civil Procedure provides in relevant part that a court may "grant a motion for judgment as a matter of law" contrary to a jury verdict only if "a reasonable jury would not have a legally sufficient evidentiary basis to find for the [prevailing] party on that issue." FED. R. CIV. P. 50(a)(1); App. 190a-192a. Such a motion requires a court, upon review of "all of the evidence in the record," to "draw all reasonable inferences in favor of the nonmoving party" and to "disregard all evidence favorable to the moving party that the jury is not required to believe." *Reeves v. Sanderson Plumbing Prods., Inc.*, 530 U.S. 133, 150-51 (2000).

B. Dow's Patent Claims

The patents at issue, U.S. Patent Nos. 5,847,053 and 6,111,023, both now expired, were held by The Dow Chemical Company ("Dow"). In relevant part, they claimed new and useful kinds of plastic film, made by blending two polymer compounds with specified properties. *See* App. 126a. Dow commercialized its inventions through its "ELITE" plastic film, which is used in products including food packaging and heavy-duty shipping sacks. *See* App. 32a.

1. The dispute below relates to a particular property (called "strain hardening") of one of the polymers (referred to as "Component A") that is used to make the plastic film to which the patents are directed. "Strain hardening" describes the property whereby a substance becomes stronger (*i.e.*, more

resistant to stretching) as it is stretched. *See, e.g.*, App. 201a-204a.

The patents teach that strain hardening should be measured by running a sample of Component A through a device called an "Instron Tensile Tester," which stretches the sample until it breaks, generating data that is then depicted on a graph called a "stress/strain curve." App. 18a-19a. The stress/strain curve plots load (the force applied to the sample, measured in pounds) against displacement (how far the sample is stretched, measured in inches). A typical stress/strain curve, with displacement on the x-axis and load on the y-axis, looks like this:

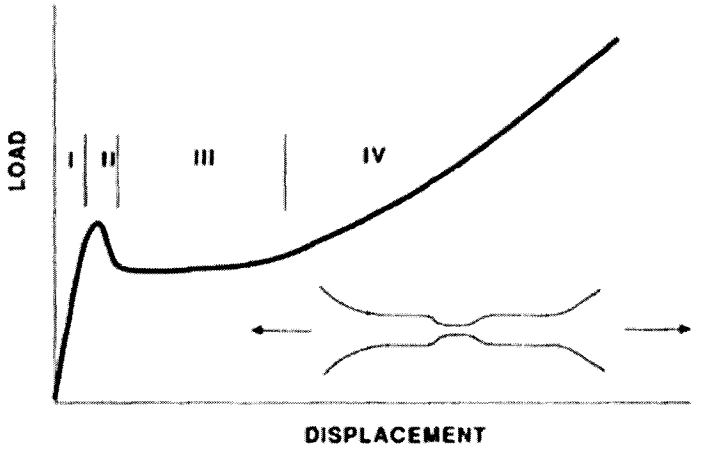

Figure 8. A typical load-displacement curve.

App. 19a. The strain-hardening effect is seen in region "IV" of the graph, which shows a sample becoming increasingly difficult to stretch (requiring a greater load) even as it is stretched further. *See* App. 20a.

The relevant patent claims instruct that, from the testing data, the reader should determine the stress/strain curve's "slope of strain hardening"—*i.e.*, the slope (calculated in pounds per inch) of the curve in its strain-hardening region. *See* App. 21a. This slope number is then used to determine a second parameter called the "slope of strain hardening coefficient" ("SHC"). *See* App. 3a-5a nn.2-3.[1] A sample meets the relevant claim limitations if it has a SHC greater than or equal to 1.3. *Id.*

2. In the courts below, defendants Nova Chemicals Corporation (Canada) and Nova Chemicals Inc. (Delaware) (collectively, "Nova") asserted that Dow's patent claims were indefinite because the claims fail to specify *where* the "slope of strain hardening" should be measured on the stress/strain curve. The typical curve, as shown above, has more than one slope, and the patent claims do not explicitly identify the location for measuring the slope. Resolution of the indefiniteness defense therefore turned on the factual question whether a person of ordinary skill in the art would know where to measure the slope of strain hardening on the stress/strain curve.

The trial evidence amply supported the conclusion that a skilled artisan would know to measure the slope at its maximum value. Specifically, Dow's expert Dr. Benjamin Hsiao, a chemistry professor and material science expert (*see* App. 198a-201a), testified that, for many applications, it is valuable if a material "can be [strain] hardened in a very short period of time"—reflected in a large slope number—because such a

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[1] Specifically, SHC=(*slope of strain hardening*)*$(I_2)^{0.25}$. App. 18a. "I_2" is the sample's "melt index" (App. 3a-5a nn.2-3), a property well known in the prior art.

material "immediately become[s] very strong" when force is suddenly applied to it. App. 201a-202a. For example, parachutes, seatbelts and plastic garbage bags all would hold more weight with less distortion if made with a material having a large slope of strain hardening. *See* App. 201a-205a. Dr. Hsiao thus testified that a skilled artisan "will always try to draw the line [for measuring slope of strain hardening] at [the] *maximum slope region* because that's the best performance of this material." App. 205a (emphasis added).[2] Further, the record shows that a person of ordinary skill in the art would agree with the common-sense mathematical propositions that "maximum means maximum" and that "[t]here's only one maximum" slope of strain hardening for a particular curve. App. 209a. Even Nova's expert witness agreed that any given curve has "only one true maximum slope." App. 245a.

To the extent there was any dispute at trial regarding the separate question of *how* a person of ordinary skill in the art would determine the maximum slope, there was ample evidence that such a person would know how to do so. The evidence showed that the most basic method is to identify visually the location on the graph at which the slope is steepest (*i.e.*, has its highest value), and then to

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[2] He continued: "[O]nly at the maximum slope [will] most all the [polymer] chains ... be hardened" (App. 206a), meaning that only at that point "will [you] have a true, complete strain hardening effect" (App. 225a; *see* App. 207a). And because the point of the test is to identify polymers that have a high slope of strain hardening (permitting a SHC greater than 1.3), "the person of ordinary skill would draw the line [and measure] at the maximum slope." App. 207a; *see* App. 208a (a person of ordinary skill "will try to determine the slope of strain hardening at a maximum slope of the tensile curve").

calculate the slope at that location using a pencil and a ruler. *See* App. 212a-213a, 233a-234a. There was also evidence of alternative methods for calculating or approximating maximum slope (*see, e.g.*, App. 21a-22a, 216a-217a, 230a, 231a-232a, 239a-240a), and Dr. Hsiao explained that he developed an additional method to aid in his analysis (*see* App. 212a-216a). As Dr. Hsiao testified, a skilled artisan would know to visually inspect the curve in order to choose the method that would result in the correct measurement (*see, e.g.*, App. 214a, 224a, 228a, 230a, 237a), and would further know to disregard methods that produced obviously incorrect results.[3] And Nova's own expert agreed that "persons in the art know how to determine maximum slopes." App. 244a.

C. The Proceedings Below

1. In 2002, Nova introduced a product ("SURPASS") that it billed as a substitute or "drop-in" for Dow's ELITE film. *See* App. 28a, 33a-34a; C.A.J.A. A10755; A10786; A10788. SURPASS quickly gained market share, becoming the primary competitor to Dow's ELITE film. *See* App. 28a, 33-34a, 43a-44a.

Dow filed this patent-infringement suit in the District Court for the District of Delaware in 2005. *See* App. 3a. In pre-trial proceedings, the district court

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[3] For instance, the "final slope" technique involves determining the curve's last slope before the sample snaps. *See* App. 22a. In most cases the result is the maximum slope, but in some experimental conditions, sample slippage causes the curve to slope downward just before breaking, yielding a *negative* "final slope." *See* App. 217a-219a; App. 194a-196a. A skilled artisan would know not to use the "final slope" method in that circumstance, because a *negative* slope cannot be the *maximum* slope. *See* App. 216a-222a; App. 194a-196a.

construed the patent claims (*see* App. 125a-163a), and ruled that Nova could present to the jury its affirmative defense that the claims were indefinite (App. 143a).

At the conclusion of a 12-day jury trial at which definiteness was specifically contested, the district court instructed that definiteness "is determined from the point of view of the hypothetical person of ordinary skill in the art," that "[a] patent does not need to expressly recite all the information necessary to determine whether an accused product meets a claim," and that a claim is definite if omitted information "would have been understood by a person of ordinary skill in the art reading the patent at the time the patent was filed." App. 247a. The jury was also instructed that Nova "has the burden of proving the claim of indefinite[ness] by clear and convincing evidence." *Id.*

The jury found that Nova had infringed Dow's patents and that Nova had failed to prove the relevant claims indefinite. App. 249a-250a. While the verdict form did not propound particularized interrogatories (*see id.*), the jury's finding that the claims were not indefinite necessarily entailed implied findings of subsidiary fact based on the evidence at trial—namely, that a person of ordinary skill in the art would know where and how to measure the "slope of strain hardening." The jury awarded $61.77 million in damages, covering the period up to December 31, 2009 (the last date for which sales data were available). App. 28a, 251a.

The district court denied Nova's post-trial JMOL motion, ruling that Dr. Hsiao's testimony provided "more than ample evidentiary support for the jury's verdict" of no indefiniteness. App. 112a. The court

entered judgment for Dow, but reserved decision on Dow's request for supplemental damages to account for infringement occurring after December 31, 2009. *See* App. 2a.

2. Nova appealed, and the Federal Circuit affirmed. App. 54a-105a ("*Dow I*"). Rejecting Nova's argument that the claims were invalid as indefinite, the court held that the record established that "one of ordinary skill in the art would ... be able to determine the slope of the strain hardening for the SHC coefficient" (App. 70a); that "one of ordinary skill in the art would know at which particular part along the curve the slope of the stress/strain curve should be measured" (*id.*); and that "one of ordinary skill in the art would know that the maximum slope of the stress/strain curve was the appropriate value for calculating the SHC coefficient" (App. 72a). The court thus held that, "because one of skill in the art would understand the bounds of the claims, the district court correctly rejected Nova's indefiniteness challenge." App. 74a.

This Court denied Nova's petition for a writ of certiorari. 133 S. Ct. 544 (2012).[4]

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[4] Nova made further unsuccessful attempts to escape infringement liability. It first filed *ex parte* requests for reexamination of Dow's patents, but the Patent and Trademark Office upheld Dow's claims. *See* Reexamination Certificate 6,111,023 C1 (U.S.P.T.O. July 14, 2014); Reexamination Certificate 5,847,053 C1 (U.S.P.T.O. Aug. 18, 2014).

Nova then filed an extraordinary "independent action" seeking relief from the judgment under Fed. R. Civ. P. 60(d), baselessly accusing Dow and its attorneys of procuring the *Dow I* judgment through fraud and fraud on the court. The district court dismissed Nova's action from the bench in July 2014, and the Federal Circuit summarily affirmed. *Nova Chems. Corp. (Canada) v. Dow Chem. Co.*, 607 F. App'x 993 (Fed. Cir. 2015). The district

3. The district court later held a bench trial to determine the amount of supplemental damages owed to Dow, and awarded Dow some $28 million for the period from January 1, 2010 through the patents' expiration in October 2011. *See* App. 26a-53a. Nova did not raise the issue of definiteness at any point during the pendency of the supplemental-damages proceedings in the district court.

a. Nova appealed the supplemental-damages judgment, arguing (*inter alia*) that Dow's patents were indefinite based on this Court's intervening decision in *Nautilus* because the claims did not specify with reasonable certainty *where* on the stress/strain curve to measure the slope of strain hardening. Nova C.A. Br. 46-48. Nova did not argue that the claims were indefinite for failing to specify *how* to measure the maximum slope of the curve. To the contrary, Nova conceded that "one skilled in the art could physically locate and calculate the 'maximum slope' on a stress/strain curve if the artisan knew that such a 'maximum slope' approach was called for by the patents-in-suit." Nova C.A. Reply Br. 13-14; *see* Nova C.A. Br. 49 (similar).

This time, the Federal Circuit reversed, holding Dow's patent claims indefinite under *Nautilus*. App. 1a-25a (*"Dow II"*). Citing this Court's decision in *Teva* only in passing (App. 24a n.9), the Federal Circuit expressly applied *de novo* review (App. 7a), and accorded no deference to the implicit factual findings

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court viewed Nova's conduct as so exceptional that it awarded Dow nearly $2.5 million in attorneys' fees and expenses under 35 U.S.C. 285. *See Nova Chems. Corp. (Canada) v. Dow Chem. Co.*, 2015 WL 5766257, *6 (D. Del. Sept. 30, 2015), *appeals pending*, Nos. 16-1576, -1680 (Fed. Cir.).

necessarily made by the jury in rejecting the indefiniteness defense.

The Federal Circuit assumed *arguendo* that a person of ordinary skill in the art would know where to measure the "slope of strain hardening"—namely, "that the maximum slope should be measured." App. 21a. But the court nevertheless held *sua sponte* that the patent claims were indefinite for failure to specify *how* to measure the maximum slope of a stress/strain curve. The court reasoned that there are "multiple methods" for measuring maximum slope "leading to different results without guidance in the patent or the prosecution history as to which method should be used." App. 23a. The court identified no record evidence (nor was there any) showing that a person of ordinary skill in the art would not know how to measure the maximum slope of a stress/strain curve.

b. Dow petitioned for panel rehearing or rehearing *en banc*. The court denied the petition (App. 164a-166a), but *five* of the eleven participating judges suggested that the panel decision conflicts with this Court's holding in *Teva* (App. 168a-176a).

Specifically, a concurrence authored by Judge Moore (joined by Judges Newman, O'Malley, and Taranto) observed that the panel had based its reversal on something that is "unquestionably a factual issue based upon extrinsic evidence"—namely, "whether one of skill in the art would know how to select from among multiple measurement techniques to determine maximum slope." App. 175a. The concurrence criticized the panel's decision to hold Dow's patent claims indefinite even "after a jury verdict of no indefiniteness and without giving deference to the jury's underlying fact findings." *Id.* The four concurring judges further questioned the panel's

decision to resolve the case "on a basis not only not raised by Nova ... but in fact expressly disavowed by Nova." *Id.* (citing Nova C.A. Br. 49; Nova C.A. Reply Br. 13-14).

The four concurring judges, plus Judge Chen, recognized that the panel decision conflicts with this Court's "recent holding ... that fact findings which rely upon extrinsic evidence must be given deference on appeal." App. 171a (citing *Teva*, 135 S. Ct. at 835). And the five concurring judges observed that the panel decision conflicts with the statutory "burden of proving indefiniteness ... by clear and convincing evidence," which rests "on the party challenging validity." App. 173a. As the concurrence noted, the panel had reversed without identifying evidence establishing "that one of skill in the art would not know how to choose among [multiple measurement techniques]." App. 174a. The concurrence did not attempt to reconcile the conflict between the panel decision and the standards set forth in *Teva* and Rule 50. But the concurring judges nevertheless voted to deny *en banc* review on the supposed ground that the panel decision did not change governing law. App. 175a.

The judges on the panel separately concurred in the denial of rehearing *en banc*. App. 167a. The panel judges asserted, without explanation, that the panel decision was consistent with the standards articulated in the five-judge concurrence (*id.*), notwithstanding that the panel had explicitly applied *de novo* review (App. 7a) and had never acknowledged either the requirement of deference to jury factual findings or Nova's burden of proving the patent claims invalid by clear and convincing evidence. Like the five-judge

concurrence, the panel concurrence did not attempt to reconcile the decision with *Teva* or Rule 50.[5]

REASONS FOR GRANTING THE WRIT

This Court in *Nautilus* expressly "le[ft] ... for another day" the question "whether factual findings subsidiary to the ultimate issue of definiteness trigger" deferential appellate review. 134 S. Ct. at 2130 n.10. This case presents the ideal vehicle to decide that question. In the decision below, the Federal Circuit invalidated Dow's patent claims based on *de novo* review of factual findings subsidiary to the ultimate issue of definiteness. The jury had implicitly found, in rejecting Nova's indefiniteness defense, that one of ordinary skill in the art would know how to select a measurement method for determining maximum slope—"unquestionably a factual issue based upon extrinsic evidence," in the words of the concurrence below (App. 175a). The Federal Circuit rejected that jury finding on its own initiative without citing any record evidence or showing why "a reasonable jury would not have a legally sufficient evidentiary basis" to make that finding, as Rule 50(a) would normally require. Only by according *no* deference to the jury's factual findings on definiteness could the Federal Circuit reverse the district court's judgment.

The Federal Circuit's refusal to defer to jury factual findings underlying a definiteness determination warrants this Court's review. That ruling conflicts with *Teva*'s holding that, in the closely analogous context of

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[5] Judge O'Malley, joined by Judge Reyna, dissented from the denial of rehearing *en banc* on the ground that the court lacked jurisdiction over the issue of definiteness as it was not at issue in the supplemental-damages proceedings. App. 177a-185a.

claim construction, subsidiary factual findings must be reviewed deferentially for clear error. The rationale for that decision applies at least equally to factual findings underlying a jury's determination that a patent claim is not indefinite. Moreover, the decision below conflicts with Rule 50(a), which requires giving at least as much deference to a jury's factual findings on definiteness as is owed to a district court's factual findings on claim construction.

Certiorari is warranted also because certainty as to the standard of review for definiteness findings is an issue of great importance to patent litigants and the district courts. *Teva* has failed to ensure the Federal Circuit's deference to district-court findings underlying claim construction. As the decision below illustrates, the same is true as to findings underlying definiteness determinations. The Court should grant certiorari here to reinforce the need for such deference, and to reaffirm that there is no patent-law exception to normal rules of appellate review of factual findings.

I. THE FEDERAL CIRCUIT'S *DE NOVO* REVIEW OF FACTUAL FINDINGS UNDERLYING A PATENT DEFINITENESS DETERMINATION WARRANTS CERTIORARI

Unlike *Nautilus*, which did not involve "any contested factual matter," 134 S. Ct. at 2130 n.10, the judgment below turned on a single dispositive factual question underlying the issue of patent claim definiteness. The jury resolved that factual question in Dow's favor, but the Federal Circuit reversed on *de novo* review, giving no deference to the jury's factual findings. This case thus squarely presents the question reserved in *Nautilus*: what standard of review governs "factual findings subsidiary to the

ultimate issue of definiteness." That question warrants certiorari.

A. The Judgment Below Conflicts With *Teva* And Rule 50(a)

As *Teva* explained, there is no patent-law "exception" to ordinary rules providing for deferential review of factual findings made by a district court. *Teva*, 135 S. Ct. at 837; *cf. eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006) (generally applicable rules "apply with equal force to disputes arising under the Patent Act"). As this Court observed, recognizing such exceptions "'would tend to undermine the legitimacy of the district courts ..., multiply appeals ..., and needlessly reallocate judicial authority.'" *Teva*, 135 S. Ct. at 837 (quoting FED. R. CIV. P. 52 advisory committee's note (1985)). Moreover, such exceptions "'would very likely contribute only negligibly' to accuracy 'at a huge cost in diversion of judicial resources.'" *Id.* (quoting *Anderson v. Bessemer City*, 470 U.S. 564, 574-75 (1985)).

As *Teva* further explained, factual findings warrant deference even where the fact-finding in question relates to an ultimate legal conclusion like patent claim construction. *Teva* held that factual findings underlying patent claim construction must, "like all other factual determinations" made by a district judge, "be reviewed for clear error." *Id.* at 838 (citations omitted). As the Court noted, such factual determinations may require "'credibility judgments' about witnesses," *id.* (quoting *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996)), or consideration of extrinsic evidence as to how "'technical words or phrases not commonly understood'" are used in a particular trade, *id.* at 837 (quoting *Great Northern Ry. Co. v. Merchants' Elevator*

Co., 259 U.S. 285, 292 (1922)). The same holds true for factual findings subsidiary to the legal determination of invalidity for obviousness. *See Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986) (per curiam), *cited in Teva*, 135 S. Ct. at 838.

The Federal Circuit's decision here warrants review because it departs from *Teva*'s clear holding. There is no basis to treat claim construction and definiteness determinations differently when reviewing their underlying factual findings. To the contrary, determining the meaning of a patent claim closely resembles determining whether a patent claim informs a skilled artisan of its scope with reasonable certainty. Both are legal questions regarding the meaning of patent claims, predicated on underlying issues of fact. (*Teva* itself came to this Court as a dispute over definiteness. *See* 135 S. Ct. at 836.) Moreover, like claim construction and obviousness, the ultimate legal question of definiteness often turns on factual issues such as the knowledge of a skilled artisan. *See Nautilus*, 134 S. Ct. at 2129 (definiteness "require[s] that a patent's claims ... inform those skilled in the art about the scope of the invention with reasonable certainty"). Thus, just as with a district court's factual findings underlying claim construction, *see Teva*, 135 S. Ct. at 836-37, deference to a jury's definiteness findings promotes judicial economy and uniform application of the Federal Rules of Civil Procedure. *See* Jonas Anderson & Peter S. Menell, *Restoring the Fact/Law Distinction in Patent Claim Construction*, 109 NW. U.L. REV. ONLINE 187, 199 (2015) (explaining that, while *Teva* addressed the standard of review for claim construction, the same standard should apply in definiteness cases by analogy).

Indeed, deferential review is if anything *more* appropriate with respect to factual findings underlying definiteness than to factual findings underlying claim construction. *First*, the Patent Act requires that an affirmative defense like indefiniteness be proved by clear and convincing evidence. *See* 35 U.S.C. 282; *Microsoft*, 131 S. Ct. at 2242. Second-guessing a factfinder's conclusion under such a demanding burden of proof is especially intrusive upon the factfinder's role.

Second, factual findings underlying a definiteness determination are often (as here) made by a jury rather than by a district court. But Rule 50 permits a court to set aside a jury's factual findings only if "a reasonable jury would not have a legally sufficient evidentiary basis to find for the party on that issue," FED. R. CIV. P. 50(a)(1)—that is, only if *no reasonable jury* could have reached the actual jury's conclusion. The Rule 50 standard, unlike the Rule 52 clear-error standard applied in *Teva*, has constitutional dimension, for it secures the Seventh Amendment's jury-trial right. *See Galloway v. United States*, 319 U.S. 372, 396 (1943) (Seventh Amendment "requires that the jury be allowed to make *reasonable* inferences from facts proven in evidence having a reasonable tendency to sustain them") (emphasis added). Rule 50 thus requires a reviewing court to "draw all reasonable inferences in favor of" a jury verdict and to "disregard all evidence favorable to the moving party that the jury is not required to believe," while prohibiting "credibility determinations" and attempts to "weigh the evidence." *Reeves*, 530 U.S. at 150-51.

The Federal Circuit disregarded the panel decision's plain conflicts with *Teva* and Rule 50. Upon denial of rehearing *en banc*, five judges highlighted those conflicts (*see* App. 168a-175a), but concurred in the

denial. And the panel made no attempt to harmonize its decision with *Teva* or Rule 50. To the contrary, the panel judges asserted in a separate concurrence in the denial of rehearing (App. 167a) that the panel decision had "directly applie[d]" the legal standards discussed in the five-judge concurrence—without explaining how it could have done so when it never acknowledged those standards and expressly applied *de novo* rather than deferential review. The panel cited *Nautilus* (App. 18a, 24a-25a), but *Nautilus* did not speak to the question presented here—namely, whether deference is required to factual findings based on *extrinsic* evidence of the knowledge possessed by a person of ordinary skill in the art.[6]

Thus, this Court should grant certiorari to resolve the conflict between the decision below and *Teva* and Rule 50 and to answer the question left open by *Nautilus*—whether factual findings subsidiary to the issue of patent definiteness must be reviewed with deference.

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[6] The Federal Circuit also sought (App. 24a-25a) to analogize to its decision on remand in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc. ("Teva II")*, 789 F.3d 1335 (Fed. Cir. 2015). But that decision is inapposite: *Teva II* held a patent claim indefinite under *Nautilus* because of ambiguity in the term "molecular weight," which could mean either of two *entirely different* facts about a given molecule—either its "peak average molecular weight" or its "weight average molecular weight." *See id.* at 1338, 1340, 1344-45; *Teva*, 135 S. Ct. at 836. Here, by contrast, a person of ordinary skill in the art would know that every measurement method is directed to the *same* objective fact—the *single* maximum slope of a sample's stress/strain curve. And the evidence likewise permitted a reasonable jury to find that a skilled artisan would know how to measure that slope in a given case. *See supra*, at 7-9.

B. This Case Presents An Excellent Vehicle For Certiorari

Without question, the Federal Circuit here reversed on indefiniteness by coming to the opposite conclusion than the jury on a determinative factual question: whether a skilled artisan would know how to measure the maximum slope of a stress/strain curve. *See* App. 21a-24a.[7] The patent does not expressly identify a slope-measurement method, so whether the claims are definite depends on whether a person of ordinary skill in the art could identify such a method. In the words of the four-judge concurrence below, "[t]he question of whether one of skill in the art would know which measurement method to use to determine the maximum slope of a curve *is unquestionably a factual issue based upon extrinsic evidence*." App. 175a (emphasis added).

As this Court explained in *Teva*, a determination about "how a skilled artisan would understand" an undefined term is a "factual finding." 135 S. Ct. at 843; *see, e.g., KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 427 (2007) (treating level of ordinary skill in the art as factual issue); *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966) (the "level of ordinary skill in the pertinent art" is a "basic factual inquir[y]"); *Harries v. Air King Prods. Co.*, 183 F.2d 158, 164 (2d

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[7] That the jury's factual determination was implied rather than explicit does not affect the Rule 50 standard. *See* App. 175a (opinion of Moore, J.); *Circuit Check Inc. v. QXQ Inc.*, 795 F.3d 1331, 1334 (Fed. Cir. 2015); *Kroshnyi v. U.S. Pack Courier Servs., Inc.*, 771 F.3d 93, 106 (2d Cir. 2014); *Sanofi-Aventis Deutschland GmbH v. Glenmark Pharm. Inc., USA*, 748 F.3d 1354, 1358 (Fed. Cir. 2014); *Acosta v. City & Cty. of San Francisco*, 83 F.3d 1143, 1147 (9th Cir. 1996); *Starceski v. Westinghouse Elec. Corp.*, 54 F.3d 1089, 1100 (3d Cir. 1995).

Cir. 1950) (L. Hand, C.J.) ("how the art understood the [claim] term ... was plainly a question of fact"), *quoted in Teva*, 135 S. Ct. at 838. The Federal Circuit nonetheless rejected the jury's implicit finding that a skilled artisan would know how to measure the maximum slope of a curve, holding the patent claims indefinite absent express guidance "as to which method should be used" to determine the maximum slope. App. 23a-24a. In overturning the jury's resolution of the dispositive factual question, the Federal Circuit cited *Teva* only in a passing footnote (App. 24a n.9), expressly applied *de novo* review (App. 7a), and never purported to adopt the deferential Rule 50 standard.

Under ordinary Rule 50(a) review, the Federal Circuit would have had to affirm the judgment of no indefiniteness in deference to the jury's factual findings underlying that judgment. *First*, Dow was entitled under Section 282 to a presumption that its patent claims are valid. The jury was thus required to presume (absent clear and convincing contrary evidence) that the PTO had correctly concluded in issuing the patent that a skilled artisan would know how to measure the maximum slope of a curve. *See* 35 U.S.C. 282; *Microsoft*, 131 S. Ct. at 2242.

Second, ample extrinsic evidence supported the jury's conclusion, including the trial testimony of both Dow's and Nova's experts. That evidence showed that a skilled artisan would know *where* to measure the slope in order to observe a sample's "true strain hardening effect" (App. 207a; *see* App. 205a-207a, 225a)—namely, at the *maximum* slope. As Nova's expert agreed, a given curve has "only one true maximum slope." App. 245a; *see* App. 209a. And ample evidence also supported the conclusion that, as

Nova's expert admitted, "persons in the art know how to determine maximum slopes." App. 244a (emphasis added). While there may be different methods for approximating the "true maximum slope," there was no dispute that a skilled artisan armed with a pencil, a ruler, and a calculator could determine it for a given curve. *See* App. 212a-213a; App. 233a-234a. There was also substantial evidence from which a reasonable jury could conclude that a skilled artisan would know how to disregard incorrect results and choose the correct method. *See, e.g.*, App. 216a-222a, 194a-196a.

Third, Nova supplied *no* evidence to contradict these showings and override the presumption of validity, even though it bore the burden of proving indefiniteness by clear and convincing evidence. To the contrary, Nova's expert *agreed* that a person of ordinary skill in the art would know how to measure maximum slope. *See* App. 244a. Thus, Nova conceded on appeal that "one skilled in the art could physically locate and calculate the 'maximum slope' on a stress/strain curve if the artisan knew that such a 'maximum slope' approach was called for by the patents-in-suit." Nova C.A. Reply Br. 13-14; *see* Nova C.A. Br. 49 (similar).

Accordingly, there can be no doubt that a reasonable jury could find, based on the presumption of validity and the evidence and burdens at trial, that a skilled artisan would have the knowledge required to understand the meaning of Dow's claims with reasonable certainty. The Federal Circuit reached the opposite conclusion *only* by refusing any deference to the jury's findings and disregarding Nova's burden of proof.

This case thus presents an excellent vehicle for reconciling review of factual findings in the definiteness context with both *Teva* and Rule 50. The record

here contains *zero* evidence that a skilled artisan would lack the knowledge necessary to understand the claims, much less the clear and convincing evidence needed to overcome the presumption of claim validity. Nova did not even raise such an argument as to the method-of-measurement issue on which the Federal Circuit reversed. The Court thus should grant review to answer the question left open in *Nautilus* and to correct the Federal Circuit's error in disregarding *Teva* and Rule 50.

Indeed, in light of this Court's recent decision in *Teva*, from which it may readily be inferred that deference is required to factual findings underlying definiteness determinations, Dow respectfully submits that summary reversal would be appropriate. *See, e.g., Amgen Inc. v. Harris*, 136 S. Ct. 758, 759-60 (2016) (per curiam) (summarily reversing where court of appeals failed properly to apply newly announced precedent); *CSX Transp., Inc. v. Hensley*, 556 U.S. 838, 839 (2009) (per curiam) (summarily reversing where court below "misread and misapplied" controlling decision); *Dennison*, 475 U.S. at 811 (summarily vacating where Federal Circuit reversed obviousness ruling without applying Rule 52(a)), *cited with approval in Teva*, 135 S. Ct. at 838, 840; STEPHEN M. SHAPIRO ET AL., SUPREME COURT PRACTICE 345 & n.96 (10th ed. 2013) (collecting decisions summarily reversing "failures ... to heed Court precedents respecting ... appellate review of FELA jury verdicts").

II. REVIEW OF PATENT DEFINITENESS FINDINGS IS AN IMPORTANT AND RECURRING ISSUE ON WHICH THE FEDERAL CIRCUIT IS DEEPLY FRACTURED

The question presented is one of great importance to patent litigants and the district courts, and will arise in every definiteness appeal in which a jury or district court has made a material finding of fact. Because the Federal Circuit has nationwide jurisdiction over patent cases, its inability to resolve the question presented here makes this Court's review all the more important. And the Federal Circuit's failure to adhere consistently to *Teva* in the claim-construction context increases the likelihood that the confusion created by the decision below will persist in the definiteness context absent this Court's review.

In the claim-construction context, *Teva* has failed to bring about deferential review of fact findings underlying claim construction except "in very limited circumstances."[8] Commentators correctly predicted that the Federal Circuit would avoid *Teva*'s holding by reverting to "de facto *de novo* review."[9] As commentators have observed, the Federal Circuit has continued to do "exactly what it did pre-*Teva*": applying "a *de novo* standard of review, brushing aside extrinsic evidence where it contradicts, relying on it where it

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[8] Stacey Cohen & William Casey, *1 Year Later,* Teva *Providing Less Certainty Than Expected*, LAW360 (Jan. 19, 2016), http://www.law360.com/appellate/articles/651341.

[9] Dennis Crouch, *Giving Deference to the Supreme Court in* Teva v. Sandoz, PATENTLY-O (Jan. 21, 2015), http://patentlyo.com/patent/2015/01/deference-supreme-sandoz.html.

supports and not giving so much as a whiff of formal deference."[10]

For example, even after this Court vacated *CardSoft v. Verifone, Inc.*, 769 F.3d 1114, 1118 (Fed. Cir. 2014), *vacated*, 135 S. Ct. 2891 (2015), for improper *de novo* review of extrinsic evidence, the Federal Circuit again undertook *de novo* review of the district court's claim construction on the supposed basis that the "intrinsic record fully determines the proper scope of the disputed claim terms," *CardSoft, LLC v. VeriFone, Inc.*, 807 F.3d 1346, 1350 (Fed. Cir. 2015); *see also Enzo Biochem Inc. v. Applera Corp.*, 780 F.3d 1149, 1156 (Fed. Cir. 2015) (overruling district court finding, based on extrinsic evidence, as to the meaning of a claim term); *id.* at 1159 (Newman, J., dissenting) (criticizing majority's failure to give district court's "factual findings" deference due "in accordance with the Court's instruction in *Teva*").

The same is proving true for factual findings underlying definiteness determinations. For instance, in *Eidos Display, LLC v. AU Optronics Corp.*, 779 F.3d 1360 (Fed. Cir.), *cert. denied*, 136 S. Ct. 502 (2015), the Federal Circuit reversed a judgment of invalidity based on indefiniteness. The district court had found, based on extrinsic evidence, that a person of ordinary skill in the art would not understand certain claim terms. *See id.* at 1364. The Federal Circuit disagreed, determining *de novo* what "a person of ordinary skill in the art would understand." *Id.* at 1367.[11]

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[10] Jason Rantanen, Teva, Nautilus, *and Change Without Change*, 18 STAN. TECH. L. REV. 430, 448 (2015).

[11] The petition for certiorari that was denied in *Eidos* did not present the question at issue here, but rather a question concerning an exception to *Teva* in the claim-construction con-

And on remand in *Teva* itself, the Federal Circuit held the asserted patent claim indefinite by rejecting the district court's finding—based in part on inferences drawn from evaluation of extrinsic evidence—as to how a skilled artisan would understand the term "molecular weight." *Teva II*, 789 F.3d at 1342. The court characterized the issue as one of law, *see id.*, but the dissent protested the majority's "failure to afford sufficient deference to the trial court's findings of fact," *id.* at 1346 (Mayer, J., dissenting); *see id.* at 1348 (criticizing majority for "first embarking on an independent review of the record and then considering, as an afterthought, the important and carefully considered factual findings made by the trial court").

While the Federal Circuit has deferred to district-court factual findings concerning definiteness in some cases, *see, e.g.*, *Akzo Nobel Coatings, Inc. v. Dow Chem. Co.*, 811 F.3d 1334, 1343-44 (Fed. Cir. 2016), its decisions remain inconsistent. *Akzo Nobel* affirmed a finding of no indefiniteness based on deference to district-court findings regarding a skilled artisan's understanding, but *Teva II*, as noted, declined such deference and found patent claims indefinite over a forceful dissent. And the issue is likely to recur with increasing frequency: In the 13 months since this Court decided *Teva*, the Federal Circuit has reviewed lower-court factual findings subsidiary to definiteness determinations in at least five cases. *See Akzo Nobel*, 811 F.3d at 1343-44; *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1317 (Fed. Cir. 2015); *Teva II*, 789 F.3d at 1341; *EON Corp. IP Holdings LLC v. AT&T Mobility LLC*, 785 F.3d 616, 620 (Fed. Cir.

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text. *See* Pet. for Writ of Cert., *Chunghwa Picture Tubes, Ltd. v. Eidos Display, LLC*, No. 15-288 (Sept. 8, 2015).

2015); *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374, 1377 (Fed. Cir. 2015).

Moreover, the standard of review at issue here has broader implications for patent law. For example, the affirmative defenses of obviousness and double patenting, like the affirmative defense of indefiniteness, involve legal conclusions based on underlying factual determinations. *E.g., Abbvie Inc. v. Mathilda & Terence Kennedy Inst. of Rheumatology Trust*, 764 F.3d 1366, 1372 (Fed. Cir. 2014) (double-patenting); *Power Integrations, Inc. v. Fairchild Semiconductor Int'l, Inc.*, 711 F.3d 1348, 1356 (Fed. Cir. 2013) (obviousness).

By declining *en banc* review in this case, the Federal Circuit deepened the uncertainty and inconsistency surrounding application of *Teva* to factual findings based on extrinsic evidence. The decision below, and the concurrence's acquiescence in its departure from *Teva*, thus undermine the "'uniformity in patent law'" that the Federal Circuit was established to promote. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 162 (1989) (quoting H.R. Rep. No. 97-312, p. 20 (1981)). While the Federal Circuit's exclusive jurisdiction in patent cases means that there will be no circuit split on the important question presented here, the ongoing but unpredictable splintering of the Federal Circuit provides additional reason for this Court to grant review.

Finally, the question presented here is particularly important because it implicates the Seventh-Amendment jury-trial right. This Court granted certiorari in *Teva* to resolve the question whether the Rule 52(a) clear-error standard applies to district-court claim-construction findings—an issue implicating prudential goals concerning judicial economy, *see*

135 S. Ct. at 837-38. Here, resolving whether Rule 50(a)'s substantial-evidence standard applies to definiteness findings implicates those goals *and* the constitutional right to a jury trial, *see Galloway*, 319 U.S. at 396.

Certiorari is thus warranted to resolve the important and recurring question presented.

CONCLUSION

The petition should be granted and the judgment below summarily reversed. Alternatively, the petition should be granted and the case set for briefing and argument.

Respectfully submitted,

HARRY J. ROPER
AARON A. BARLOW
PAUL D. MARGOLIS
JENNER & BLOCK LLP
353 North Clark Street
Chicago, IL 60654
(312) 222-9350

KATHLEEN M. SULLIVAN
Counsel of Record
RAYMOND N. NIMROD
WILLIAM B. ADAMS
CLELAND B. WELTON II
QUINN EMANUEL URQUHART
& SULLIVAN, LLP
51 Madison Avenue
22nd Floor
New York, NY 10010
(212) 849-7000
kathleensullivan@
quinnemanuel.com

Counsel for Petitioner

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