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No. 16-__

AUG 10 2016

In the
Supreme Court of the United States

GOOGLE INC.,

PETITIONER,

v.

ALFONSO CIOFFI AND
THE ESTATE OF ALLEN FRANK ROZMAN,
RESPONDENTS.

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

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. When construing an ambiguous patent claim, should courts generally consider the record of the patent's prosecution as relevant context, or is prosecution history relevant only if it clearly and unmistakably disavows claim scope?

2. When a patent applicant has amended a claim to overcome the Patent and Trademark Office's earlier disallowance of the claim, should a court strictly construe the amended claim language against the applicant, as this Court has held, or consider the amendment history to be relevant only to the extent that it clearly and unambiguously disavows claim scope, as the Federal Circuit has held?

**PARTIES TO THE PROCEEDING
AND RULE 29.6 STATEMENT**

Petitioner in this Court, defendant-cross appellant below, is Google Inc. Respondents in this Court, plaintiffs-appellants below, are Alfonso Cioffi and the Estate of Allen Frank Rozman.

Alphabet Inc., a publicly traded company (NASDAQ: GOOG and GOOGL), has more than 10% ownership of Google Inc. No publicly held company owns 10 percent or more of Alphabet Inc.'s stock.

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PETITION FOR WRIT OF CERTIORARI

“[C]laim construction is overwhelmingly the most critical patent issue in litigation.” Greg Reilly, *Judicial Capacities and Patent Claim Construction: An Ordinary Reader Standard*, 20 Mich. Telecomms. & Tech. L. Rev. 243, 246 (2014). Whether a patent claim is valid, and whether a defendant infringed the patent, often depend in large part on the claim’s boundaries (*i.e.*, the scope of the exclusive right). As a result, claim construction is “often dispositive.” Christopher A. Cotropia, *Patent Claim Interpretation Methodologies and Their Claim Scope Paradigms*, 47 Wm. & Mary L. Rev. 49, 67 (2005).

In recent years, this Court has recognized the importance of claim construction by deciding a number of issues related to it, such as the appellate standard of review, *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 836 (2015), the authority of the Patent and Trademark Office (“PTO”) to apply different standards than those used in courts, *Cuozzo Speed Techs. v. Lee*, 136 S. Ct. 2131, 2146 (2016), and the requirement that a patent claim’s meaning be reasonably certain, *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2129 (2014).

The time has now come for this Court to resolve more fundamental questions concerning claim construction itself, *i.e.*, the legal standards, such as the canons of construction, that courts should follow in construing patent claims. To be sure, this Court opined on claim-construction principles in an earlier era. But the Federal Circuit has since divided internally and departed from this Court’s precedents. As a result, different panels now apply different

canons of construction, making it impossible for members of the public and litigants to know how a claim would eventually be construed by the Federal Circuit. Such uncertainty is inimical to the public-notice function of claims and the proper functioning of our patent system. It has also led to serious abuse.

This petition concerns the important role of prosecution history—*i.e.*, the public record of a patent’s examination—in construing otherwise ambiguous patent claims. In many cases, that record is extensive, and it sheds considerable light on the claims’ meaning. It includes, for example, the application for the patent, the applicant’s statements to the patent examiner concerning the patent’s intended scope, any rejections of originally proposed claims for lack of patentability, and the applicant’s response to such rejections, including arguments or amendments made to overcome disallowance.

This Court has long held that courts should construe claims in light of the entire intrinsic record, including the prosecution history, with a view toward “ascertaining the invention.” *United States v. Adams*, 383 U.S. 39, 49 (1966). Thus, for example, “[c]laims as allowed must be read and interpreted with reference to rejected ones.” *Graham v. John Deere Co.*, 383 U.S. 1, 33 (1966). Moreover, when an applicant amends a claim to overcome an examiner’s rejection, that amendment “operates as a disclaimer” and “must be strictly construed against [the applicant]” and in favor of the public. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942).

These clear rules preserve the integrity of the PTO’s examination process by preventing an

applicant from securing patent claims based on one understanding of their scope but later arguing for a broader scope in licensing discussions or litigation. These rules also ensure that the public may rely in good faith on arguments, amendments, and admissions made by an applicant to obtain a patent.

The Federal Circuit, however, is deeply divided over the relevance of a patent's prosecution history. Some panels correctly hold that the prosecution history always provides important context for construing ambiguous claim language. But many other panels, including the one below, hold that the prosecution history is irrelevant unless it clearly and unmistakably surrenders claim scope. Instead of considering all of the contextual evidence as a whole, those panels determine a presumed meaning without regard to the prosecution history, and then ask only whether the prosecution history clearly and unmistakably requires a different result.

This Court's review is urgently needed for at least two reasons. *First*, the uncertainty over which claim-construction rules will apply in any given case deprives the public of reasonable certainty regarding patents' scope. *Second*, the Federal Circuit's clear-and-unmistakable standard artificially restricts the courts' consideration of important contextual evidence by rendering prosecution history all but irrelevant in the mine run of cases, and thereby skews the analysis toward overbroad and acontextual constructions. The resulting uncertainty and overbreadth harm the very innovation the Patent Act is supposed to encourage and protect.

OPINIONS BELOW

The opinion of the court of appeals is reported at 632 F. App'x 1013 and reproduced at App. 1. The district court's unpublished disposition is available at 2014 WL 4293978 and is reproduced at App. 25.

JURISDICTION

The court of appeals rendered its decision on November 17, 2015. It denied rehearing on April 11, 2016. On June 28, 2016, the Chief Justice extended the time for filing a petition to and including August 10, 2014. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

A. The Patent-Examination Process

A patent application consists of a “specification” that describes, among other things, the claimed invention, how it works, and related inventions and learning that preceded the patent application's filing. See U.S. Pat. & Trademark Office, *Manual of Patent Examining Procedure* §§ 601, 608.01 (9th ed. Mar. 2014); see also 35 U.S.C. § 112. The specification must conclude with “one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor . . . regards as the invention.” 35 U.S.C. § 112(b). Those claims mark the boundaries of the inventor's asserted property right. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372–74 (1996).

A PTO examiner reviews the application to determine whether it meets the criteria for

patentability, including the requirements that the claimed invention be novel and non-obvious (*i.e.*, new and inventive). *See* 35 U.S.C. § 131; *see also, e.g., id.* §§ 101, 102, 103 & 112. If the examiner determines that claims fail to satisfy one or more patentability requirements, the examiner rejects the claims in an “Office action.” *See* 37 C.F.R. § 1.104. In response, the applicant has three options: “present arguments [to the examiner] pointing out the specific distinctions believed to render the claims . . . patentable over” the prior art, 37 C.F.R. § 1.111(b); appeal the rejection, *see* 35 U.S.C. § 134; or acquiesce in the examiner’s determination by amending the proposed claims, 37 C.F.R. § 1.111(b).

Applicants frequently draft initial claims as broadly as possible and then amend them as necessary to overcome the examiner’s rejections. Indeed, patent drafting manuals encourage that approach. *See, e.g.,* Robert C. Faber, *Faber on Mechanics of Patent Claim Drafting* § 10:1.1, at 10-2 (6th ed. 2013); Jeffrey G. Sheldon, *How to Write A Patent Application* § 7:5.3, at 7-68 (2d ed. 2012) (“At worst, the examiner will not allow the broadest claims. Thus, it is recommended that the practitioner be greedy when initially writing the application.”).

Thus, “the vast majority of . . . applicants who obtain patents . . . do so in part by amending their claims in response to examiner concerns.” Mark Lemley & Bhaven Sampat, *Examining Patent Examination*, 2010 Stan. Tech. L. Rev. 2, ¶ 12 (2010); *accord* Reilly, 20 Mich. Telecomms. & Tech. L. Rev. at 256. Applicants typically do not amend the

specification's description of the claimed invention, however, in part because the Patent Act prohibits changes to the specification that would introduce "new matter." 35 U.S.C. § 132(a). Thus, the specification generally describes the claims before, not after, any amendments.

The record of the examination, also known as the prosecution history, becomes part of the public record. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc). The PTO makes the prosecution history available on its public Patent Application Information Retrieval website, at <http://portal.uspto.gov/pair/PublicPair>.

B. The Asserted Patents

This case concerns three patents that seek to protect computers "from malicious software," or malware. C.A. App. 421. According to the patents' common specification, malware programs often succeeded in infecting computers because the computers' "resources" were "shared by programs simultaneously, giving a malware program a conduit to access and corrupt other programs." C.A. App. 423 (5:40–44). The proposed solution was to eliminate that conduit by separating the computer's memory into distinct areas, such that a malicious program could not access or infect other programs. See C.A. App. 424 (7:1–4).

Because that simple concept had long been known, respondents secured allowance of their claims only by limiting their scope. Among other things, the patent claims were limited to segregating components of a computer's hardware (as opposed to

software). The computer's key system files would operate on a processor with access to one memory region, while any network-interface software would operate on a second processor with access only to a second memory region. C.A. App. 408; *id.* at 425–26. Those claims issued as U.S. Patent No. 7,484,247. *See* C.A. App. 408.

After failing to license or sell that patented invention, *see* C.A. App. 383, respondents surrendered the original patent in 2010 and filed reissue applications with different claims. The Patent Act authorizes such applications if, among other things, “the patentee claim[ed] more or less than he had a right to claim” in the original patent. 35 U.S.C. § 251(a). The examination of a reissue application is similar to the initial examination, and such applications must meet all of the requirements for patentability. *See id.*

Armed with publicly available information about Google's Chrome web browser (the product accused of infringement in this case), the applicants drafted claims geared toward browsers. Instead of separating hardware components, the proposed claims used discrete software processes. *See* C.A. App. 424 (7:1–4). The computer would execute trusted processes in the main memory area, while “isolating” potentially dangerous processes “from the main computer system” in a second area. *Id.* The proposed claims referred to the trusted process and the potentially dangerous process as the first and second “browser process[es].” *See* C.A. App. 588.

The examiner rejected the claims because they were not new. In a prior patent application, known

as Narin, other inventors had described a virtually identical method of using software to divide computer memory. *See* C.A. App. 557. Narin described allowing a secure application to access untrusted Internet content by means of a second, non-secure application, while preventing the non-secure application from accessing secure memory space. *See* C.A. App. 588–89.

Respondents argued that Narin was distinguishable because their claims were limited to web browser processes, whereas Narin’s secure process was not a web browser process. *See* C.A. App. 587–92. Narin specified that a “browsing program, and not the secure rendering application, . . . performs the retrieval of web pages.” C.A. App. 591.

The examiner again rejected the claims because “the features upon which applicant relies [to distinguish Narin] . . . are not recited in the rejected claims.” C.A. App. 703–04. In other words, the claims, as then drafted, encompassed all “browser processes,” not only a narrower subset that could distinguish Narin. *Id.*

Respondents then amended the claims to require a first and second “web browser process.” *E.g.*, C.A. App. 798. That phrase appeared for the first time in the amended claims—it is not found in the specification, and it has no independently known meaning in the art. The examiner allowed the claims as amended, granting the three reissue patents at

issue here—Nos. RE43,500, RE43,528, and RE43,529. C.A. App. 70, 96, 123.¹

C. The District Court Proceedings

Respondents sued Google in the U.S. District Court for the Eastern District of Texas, alleging that the Chrome web browser infringed.

Drawing on the patents' prosecution history, the district court construed "web browser process" to mean a "process that can access data on websites." App. 43–44, 101–02. The court explained that "the patentees relied on claiming a 'web' browser process" to secure the patents and clarified that, "to be meaningful and consistent with the prosecution history," the "capability of accessing websites must not *require* using another web browser process." App. 41–42. That is, each "web browser process" must itself be capable of accessing websites directly, without dependence upon a second process. *See id.* If a "web browser process" could not access the web itself, but instead could do so only through a separate web browser, it would be indistinguishable from what Narin disclosed and the applicants amended the claims to exclude: a process, not itself a "web browser," that could access the web only through a separate "browsing program." C.A. App. 591.

The parties stipulated that, under the district court's construction, Chrome did not infringe. App. 102–03. Based on that concession, the district court

¹ The opinion below discusses a fourth reissue patent, RE43,103, and an additional term used in that patent; however, respondents elected to proceed only on claims from the three patents discussed above. *See* App. 25; *see also id.* at 8–9.

entered a final judgment of noninfringement against respondents. *Id.*²

D. The Court Of Appeals' Decision

The Federal Circuit reversed. It agreed with the district court that a “web browser process” is a “process that can access data on websites.” App. 10–11. But it held that a “web browser process” does not have to be capable of independently accessing website data. Instead, in the court of appeals’ view, a process could be considered a web browser process even if it always required the use of a second process to access website data. App. 18–19.

Although the district court derived its construction largely from the prosecution history, the Federal Circuit determined the claim term’s meaning without reference to the prosecution history. The court noted that some claims required the “second browser process” to be “capable of directly exchanging data with the network interface and with the first web browser process.” App. 12–13. That language, it reasoned, would be “superfluous” if a web browser process must be capable of accessing a website without using another web browser process. App. 12–13.

² Chrome contains a browser kernel that can access the network and a rendering engine that executes webpage code to display web pages. Respondents alleged that Chrome’s browser kernel is the “first web browser process” and its rendering engine is the “second web browser process.” App. 102–03. These two processes access separate areas of the system’s memory, and the rendering engine has no network access without the browser kernel. *Id.* Thus, it is not a “web browser process” under the district court’s construction of that term.

The court of appeals noted that this “claim differentiation” point would not overcome any “limitations imposed by the prosecution history.” App. 14. That court has repeatedly cautioned that claim-differentiation is a weak doctrine because “patentees often use different language to capture the same invention.” *Atlas IP, LLC v. Medtronic, Inc.*, 809 F.3d 599, 607 (Fed. Cir. 2015). Indeed, “claim drafting often involves finding different expressions to define the same invention.” *World Class Tech. Corp. v. Ormco Corp.*, 769 F.3d 1120, 1126 (Fed. Cir. 2014). Thus, differences in word choice by patent applicants lack the significance sometimes attributed to similar differences in legislation. *Cf., e.g., Mohamad v. Palestinian Auth.*, 132 S. Ct. 1702, 1708 (2012).

Here, however, the Federal Circuit relied solely on claim differentiation because it determined that the other interpretive evidence—the prosecution history—did not “unequivocally disavow[]” claim scope. App. 14 (citation and quotation marks omitted). According to the Federal Circuit, “nothing from the prosecution history constitutes a clear and unmistakable disavowal of ‘indirect’ access” of websites. App. 18. The court ruled that there can be “no ‘clear and unmistakable’ disclaimer if a prosecution argument is subject to more than one reasonable interpretation” and that respondents had “offered a reasonable alternative interpretation” of their admission during prosecution. *Id.* at 18–19 (quoting *SanDisk Corp. v. Memorex Prods.*, 415 F.3d 1278, 1287 (Fed. Cir. 2005)).

Google petitioned for rehearing en banc, which the Federal Circuit denied. App. 105.

REASONS FOR GRANTING THE PETITION

I. A Patent’s Prosecution History Provides Vital Context For Construing Otherwise Ambiguous Claim Language.

A patent’s prosecution history “consists of the complete record of the proceedings before the PTO.” *Phillips*, 415 F.3d at 1317. It provides essential context for ascertaining the scope of a patented invention, including: claims originally proposed by the applicant; rejections by the examiner, amendments made to those claims to secure allowance; arguments and admissions made by the applicant; statements by the examiner; and evidence of the state of the art at the time of the invention. Although this Court has always deemed that context to be important to claim construction, panels of the Federal Circuit have divided over its relevance. As a result, this Court’s guidance is urgently needed to settle this important, indeed foundational, issue in patent law.

A. The Federal Circuit Is Deeply Divided Regarding The Use Of Prosecution History To Construe Patent Claims.

1. Many Federal Circuit decisions, including the decision in this case, have restricted the use of prosecution history to the doctrine of disclaimer—that is, to situations in which there is a clear and unmistakable disavowal of claim scope. *E.g.*, App. 18–19; *Invitrogen Corp. v. Clontech Labs., Inc.*, 429

F.3d 1052, 1078 (Fed. Cir. 2005); *SanDisk Corp.*, 415 F.3d at 1286; *Rhodia Chimie v. PPG Indus. Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1327 (Fed. Cir. 2003); *SunRace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1306 (Fed. Cir. 2003); *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1575 (Fed. Cir. 1996).

In this line of cases, the court first identifies a term’s meaning without reference to the prosecution history. *E.g.*, App. 13–14. It then examines the prosecution history only to determine whether it contains a “clear and unmistakable disclaimer” of that meaning. App. 18–19 (quotation mark omitted). Under this line of cases, “[t]he purpose of consulting the prosecution history in construing a claim is to exclude any interpretation that was disclaimed during prosecution.” *Rhodia Chimie*, 402 F.3d at 1384 (citation and quotation marks omitted). When the prosecution history is subject to more than one reasonable interpretation, the court disregards it entirely. *E.g.*, App. 18–19; *SanDisk*, 415 F.3d at 1287. Because the clear-and-unmistakable standard is “high” and “exacting,” *Avid Tech, Inc. v. Harmonic, Inc.*, 812 F.3d 1040, 1045 (Fed. Cir. 2016); *Hill-Rom Servs., Inc. v. Stryker*, 755 F.3d 1367, 1371 (Fed. Cir. 2014), it generally deprives prosecution history of any weight at all.

Consider, for example, *Schindler Elevator Corp. v. Otis Elevator Co.*, 593 F.3d 1275 (Fed. Cir. 2010), which involved the use of an “information transmitter” to call an elevator automatically. To overcome rejection based on prior art references, the

applicant had amended the claims and assured the examiner that it was “not necessary that the information transmitter be in the elevator user’s hands to select the desired floor” and that the “call commands [we]re pre-programmed to occur automatically, contactlessly, and independently of the orientation of the information transmitter.” *Id.* at 1285.

Accordingly, the district court construed “information transmitter” to be “a device that communicates . . . *without requiring any sort of personal action by the passenger.*” *Id.* at 1280 (emphasis added). The Federal Circuit, however, determined that the prosecution history was not unequivocal, refused to give it any weight, and held that the claimed “information transmitter” *could* require action by the passenger. *Id.* at 1283–86.

A separate line of cases takes a more contextual approach to prosecution history, recognizing that prosecution history provides relevant and important context for resolving ambiguity in claim language even when there is “no clear disavowal of claim scope.” *Nystrom v. TREX Co.*, 424 F.3d 1136, 1145 (Fed. Cir. 2005); *see also Fenner Invs., Ltd. v. Cellco P’ship*, 778 F.3d 1320, 1323 (Fed. Cir. 2015); *Sunovion Pharms., Inc. v. Teva Pharms. USA, Inc.*, 731 F.3d 1271, 1276 (Fed. Cir. 2013); *Bd. of Regents of the Univ. of Tex. Sys. v. BENQ Am. Corp.*, 533 F.3d 1362, 1369 (Fed. Cir. 2008); *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333–34 (Fed. Cir. 2003); *Amhil Ents. Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1559–60 (Fed. Cir. 1996).

These cases recognize that, when a claim term is unclear, prosecution history is the best and often the only reliable evidence of “how the inventor understood the invention.” *BENQ*, 533 F.3d at 1369 (quoting *Phillips*, 415 F.3d at 1317). That is so because it was “created by the patentee in attempting to explain and obtain the patent.” *Fenner*, 778 F.3d at 1325 (quoting *Phillips*, 415 F.3d at 1317). Under this line of cases, “[a]ny explanation, elaboration, or qualification presented by the inventor during patent examination is relevant” to claim construction. *Fenner*, 778 F.3d at 1323 (citation and quotation marks omitted).

2. The Federal Circuit’s internal conflict on this issue has been well known for more than a decade. As one commentator explained, “[s]ome Federal Circuit decisions provide that claim terms shall be given their ordinary meaning and that the prosecution history can only change that meaning through a clear and unmistakable disavowal of the plain meaning. Other cases do not apply such a stark rule, instead using the prosecution history as a source of evidence to find the right meaning in the context of the invention.” Federal Circuit Bar Association, *Guidelines for Patent Claim Construction: The Basics of a Markman Hearing*, 14 Fed. Cir. B.J. 771, 782 (2005); see also Michael Dergosits & John Imperato, *Patent Drafting in View of Recent Case Law on Claim Construction*, 5 Intell. Prop. L. Bull. 1, 2–3 (2000).

More than ten years ago, the Federal Circuit had an opportunity to resolve this disagreement when it convened *en banc* to opine on proper claim

construction principles. *See Phillips*, 415 F.3d 1303. Although the *en banc* court recognized the importance of prosecution history, *see id.* at 1317, it was evidently unable to agree on the question presented here, and its division has persisted. *See* Stephanie Ann Yonker, *Post-Phillips Claim Construction: Questions Unresolved*, 47 IDEA 301, 324, 330 (2007); Reilly, 20 Mich. Telecomm & Tech. L. Rev. at 259–60.

Many decisions, like the one in this case, continue to hold that the “purpose of consulting the prosecution history in construing a claim is to exclude any interpretation that was disclaimed during prosecution.” *E.g.*, *AIA Eng’g Ltd. v. Magotteaux Int’l S/A*, 657 F.3d 1264, 1277 (Fed. Cir. 2011) (citation and quotation marks omitted); *Schindler Elevator Corp.*, 593 F.3d at 1285; *Verizon Servs. Corp. v. Vonage Holdings Corp.*, 503 F.3d 1295, 1306 n.6 (Fed. Cir. 2007); *Research Plastics, Inc. v. Fed. Packaging Corp.*, 421 F.3d 1290, 1296 (Fed. Cir. 2005).

In contrast, other decisions have recognized the importance of prosecution history, as relevant context, even when it does not rise to the level of a clear and unmistakable disclaimer. *See, e.g.*, *GPNE Corp. v. Apple, Inc.*, No. 2015-1825, 2016 WL 4073323, at *3–4 (Fed. Cir. Aug. 1, 2016) (treating prosecution history as relevant and not requiring clear disclaimer of claim scope); *Wi-LAN USA, Inc. v. Apple, Inc.*, — F.3d —, No. 2015-1256, 2016 WL 4073324, at *9 (Fed. Cir. Aug. 1, 2016) (“We turn next to viewing the patent as a whole as well as the

prosecution history to glean clues as to the claim term's meaning.”).

For example, another panel held, shortly after the decision in this case, that proper interpretive principles do “not require explicit redefinition or disavowal.” *Trustees of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1363 (Fed. Cir. 2016). The contrast between the two decisions led the leading intellectual-property blog to highlight the conflict: “*Symantec* appears roughly [to] follow the suggestions outlined by Google” in its rehearing petition in this case, and the two panels “reached a different result.” Dennis Crouch, *Strictly Construing Amended Claims Against the Patentee*, Patently-O, available at <http://patentlyo.com/patent/2016/02/strictly-construing-patentee.html> (Feb. 4, 2016).

The Federal Circuit’s longstanding divide on claim construction methodology is, by itself, sufficient reason to grant the petition. As this Court has held, the public needs to know the scope of exclusive patent rights with “reasonable certainty.” *Nautilus*, 134 S. Ct. at 2124. Yet parties are left to “guess as to the weight” the Federal Circuit might give the prosecution history in any given case. *Yonker*, 47 IDEA at 324, 330; *see also* *Reilly*, 20 Mich. Telecomm & Tech. L. Rev. at 259–60. Without even knowing what interpretive principles the Federal Circuit will apply, there can be nothing resembling reasonable certainty.

That is an enormous problem not just for litigants, but for the public at large. Inventors and manufacturers need to be able to determine the scope of a patent right when they design new products or

decide whether to pay for a license to a patent, and most disputes over patent rights never reach litigation. Of those that do, the vast majority settle in the district courts, in part because of the high cost of patent litigation. *See, e.g.,* John R. Allison, Mark A. Lemley, & Joshua Walker, *Patent Quality and Settlement Among Repeat Patent Litigants*, 99 Georgetown L.J. 677, 689 (2011). Only a minority of the cases litigated to final judgment in district court ultimately result in an appellate opinion. Price Waterhouse Cooper, *2015 Patent Litigation Study: A Change in Patentee Fortunes* 19 (2015), available at <https://www.pwc.com/us/en/forensic-services/publications/assets/2015-pwc-patent-litigation-study.pdf>.

As a result, cases that actually go to litigation, reach the appellate stage, and result in published opinions are the tip of the iceberg. It is a large tip, as shown by the many conflicting Federal Circuit opinions on point. And the size of that tip should leave no doubt that the overall scope of uncertainty engendered by the Federal Circuit's internal division—*i.e.*, its inability to articulate and apply consistent claim construction principles across cases—warrants this Court's review.

B. The Federal Circuit's Disclaimer-Only Standard Is Contrary to This Court's Decisions.

Another reason to grant review is that the Federal Circuit's prevailing view, exemplified in the decision below, is contrary to this Court's claim-construction jurisprudence. This Court has

recognized that claim terms must be construed in light of all the intrinsic evidence, specifically including the prosecution history. See, e.g., *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 733 (2002) (requiring that “the claims of a patent be interpreted in light of the proceedings in the PTO during the application process”). Indeed, this Court has long stressed that “[c]laims as allowed *must* be read and interpreted with reference to rejected ones.” *Graham*, 383 U.S. at 33 (emphasis added); accord *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220–21 (1940). In keeping with those precedents, commentators have long understood that when a claim is ambiguous, the “entire field of inquiry is open.” W. Robinson, *The Law of Patents for Useful Inventions*, § 845 at 501 (1890).

The same interpretive approach applies in all other areas of law. When construing ambiguous terms in statutes and contracts, for example, courts routinely consult all of the intrinsic evidence, without imposing a heightened barrier to consideration of some such evidence. See e.g., *M & G Polymers USA, LLC v. Tackett*, 135 S. Ct. 926, 936 (2015). Of course, there are limits on the consideration of *extrinsic* evidence in contract cases. See, e.g., *id.* at 938 (Ginsburg, J., concurring); *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 837 (2015). But treating some of the *intrinsic* record as disfavored, even when construing ambiguous language, appears to be reserved to a subset of Federal Circuit judges in patent cases.

**C. The Disclaimer-Only Standard
Undermines The Public Notice
Function Of Claims And Produces
Overbroad Constructions.**

Nothing about prosecution history warrants disfavored status. To the contrary, the context provided by the prosecution history bolsters the public-notice function of claims by clarifying the meaning of otherwise ambiguous claim language. *See, e.g., Universal Oil Prods. Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484–85 (1944). That is true whether or not the prosecution history rises to the level of a clear and unmistakable disclaimer or—like other interpretive evidence—provides important context short of that “high” and “exacting” (p. 14, *supra*) barrier.

After all, the patent applicant and the PTO create the prosecution history in the course of, and for the very purpose of, explaining the claimed invention and its scope. (In that regard, prosecution history differs from legislative history. A court using legislative history seeks to divine the thoughts of an entire body of people based on statements made by individual members of that body or their staffers. In contrast, the prosecution history directly reflects the contemporaneous understanding and intent of the applicant who drafted and sought the patent claim as well as the PTO examiner who approved the claim.)

Admissions are treated as especially reliable evidence in other areas of the law. *E.g.*, Fed. R. Evid. 801(d)(2) (party admissions excluded from hearsay rules). Similarly, contemporaneous impressions are favored over those arrived at in hindsight. *See, e.g.*,

Fed. R. Evid. 803(1)–(3). Admissions in prosecution history represent “contemporaneous intention of the inventor,” Albert H. Walker, *Text-book of the Patent Laws of the United States of America*, § 187 at 146 (1887), not a later position taken in full hindsight and with a view toward covering an accused product.

Prosecution history is especially “critical in interpreting disputed claim terms” where, as here, the term in question has no well-known meaning or definition in the specification. *Sunovion Pharms.*, 731 F.3d at 1276; *see also* Peter S. Menell et al., *Patent Claim Construction: A Modern Synthesis and Structured Framework*, 25 Berkeley Tech. L.J. 711, 723 (2010). As discussed above, a patent’s specification generally reflects the scope of the claims before—not after—amendment. *See* p. 6, *supra*. Especially when claim terms are added by amendment to overcome rejection, the prosecution history provides the *most* relevant context for interpreting newly added terms.

By discounting this important context, the Federal Circuit’s clear-and-unmistakable-disclaimer approach undermines the public-notice function of claims, casts doubt on the reasons the applicant gave the examiner for issuing the patent in the first place, and thereby skews the interpretive analysis in favor of overbroad constructions. The resulting harm to public notice is particularly acute in software-patent cases. Software inventions are often “more malleable than many other types of inventions.” Julie E. Cohen & Mark A. Lemley, *Patent Scope and Innovation in the Software Industry*, 89 Cal. L. Rev. 1, 48 (2001). As a result patentees are prone to use terms without

a well-known meaning in the art—or even, as here, a basis in the specification. The disclaimer approach thus robs courts of the evidence most likely to explain the meaning of the terms in context.

This Court has reversed Federal Circuit rules that impose similarly artificial limitations on the consideration of relevant evidence. *E.g.*, *Octane Fitness, LLC v. ICON Health & Fitness, Inc.*, 134 S. Ct. 1749 (2014); *KSR Int’l Co v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). It should do so again here.

II. Amendments Made To Overcome Rejection Should Be Strictly Construed Against Applicants.

For the reasons discussed above, courts should always consider the prosecution history when construing otherwise ambiguous claims. That is true whether the prosecution history takes the form of either an argument to the examiner or an amendment of the claim language. Where, as here, the relevant prosecution history involves an amendment made to overcome disallowance, the Federal Circuit’s disclaimer standard conflicts with this Court’s decisions for an additional reason: it does not construe the claim’s ambiguity against the applicant.

1. This Court has long held that amendments made to overcome disallowance “must be strictly construed against the inventor and in favor of the public.” *Hubbell v. United States*, 179 U.S. 77, 84 (1900); accord *Exhibit Supply Co.*, 315 U.S. at 137; *Smith v. Magic City Kennel Club, Inc.*, 282 U.S. 784, 790 (1931). This is a species of the broader rule that

“any ambiguity or doubts” are generally construed against the drafter, especially in the case of a public grant of property rights, as “acts of this character are commonly prepared by those interested in the benefits to be derived from them.” *Broad River Power Co. v. S. Carolina ex rel. Daniel*, 281 U.S. 537, 548 (1930).

Any other rule, the Court has explained, would allow the inventor to “avoid the PTO’s gatekeeping role and seek to recapture in an infringement action the very subject matter surrendered as a condition of receiving the patent.” *Festo*, 535 U.S. at 734; *see also Smith*, 282 U.S. at 789. Specifically, after a patent examiner allows a claim based on one understanding of a narrowing amendment, a patentee might—as respondents did here—espouse a broader interpretation in litigation.

In stark contrast to this Court’s strict-construction standard, the Federal Circuit has adopted the opposite rule by presuming there was no disclaimer unless (and only to the extent that) the applicant clearly and unmistakably manifested an intent to limit claim scope. *E.g.*, App. 18; *see also 3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1325 (Fed. Cir. 2013); *Schindler*, 593 F.3d at 1285; *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1085–86 (Fed. Cir. 2009).

Thus, for example, if an amendment made to overcome disallowance could be construed in one of two ways, each “equally consistent” with the interpretive evidence, the Federal Circuit presumes *no* disclaimer and chooses the broader interpretation. *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364, 1371

(Fed. Cir. 2003); *see also* App. 19 (electing broader interpretation of “web browser process” because respondents “offered a reasonable alternative interpretation”); *Vederi, LLC v. Google, Inc.*, 744 F.3d 1376, 1384 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 2856 (2015); *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1332 (Fed. Cir. 2004) (choosing broader of two “reasonable interpretations” of amended claim language). In *Kumar*, for example, the court of appeals described the record before the PTO as “confusing” and held that “the surrender is not clear and convincing as required by our cases.” 351 F.3d at 1371. A strict construction would hold such an ambiguity against the applicant responsible for the “confusing” claim amendment, not against the public.

The Federal Circuit has occasionally suggested that an amendment made to overcome rejection is entitled to “weight” and might suffice to demonstrate a clear disavowal. *BENQ*, 533 F.3d at 1369; *see also Amgen*, 314 F.3d at 1327; *Jansen*, 342 F.3d at 1333. As explained above, however, it has given weight to such amendments only to the extent that they clearly and unmistakably narrow a claim’s meaning. Indeed, the Federal Circuit has gone so far as to reject a narrower construction simply because the prosecution history was “not necessarily inconsistent with” a broader construction. *W.E. Hall Co. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1352 (Fed. Cir. 2004) (emphasis added).

As the leading patent-law blog has recognized, the Federal Circuit “has strayed significantly” from this Court’s precedent on this point. Dennis Crouch,

Google Looks to Narrow both Copyrights and Patents through Supreme Court Action, Patently-O (Jan. 13, 2015), at <http://patentlyo.com/patent/2015/01/copyrights-through-supreme.html>; see also John D. Vandenberg, We Need Another *Phillips* To Explain ‘Plain Meaning,’ Law360, available at <http://www.law360.com/appellate/articles/824008> (noting that this Court and the Federal Circuit are in clear disagreement on whether “claim amendments [are] strictly construed against the patent owner”). By resolving ambiguities in favor of the patentee and against the public, the Federal Circuit’s clear-and-unambiguous standard for disclaimer is “unmistakably in conflict with the Supreme Court’s earlier guidance.” Joshua D. Sarnoff, *The Doctrine of Equivalents and Claiming the Future after Festo*, 14 Fed. Cir. B.J. 403, 445 (2004).

Some judges and scholars have mused that the Federal Circuit should impose a rule of strict construction for claim language generally. See, e.g., *3M Innovative Props.*, 725 F.3d at 1336 (Plager, J., concurring) (“ambiguity should be construed against the draftsman”); Dan L. Burk & Mark A. Lemley, *Quantum Patent Mechanics*, 9 Lewis & Clark L. Rev. 29, 54 (2005) (proposing “narrowly construing claims against the drafter”). That discussion of whether to start applying a strict-construction rule shows how far the Federal Circuit has drifted from this Court’s precedents. A good place to start would be the strict-construction rule this Court already adopted.

2. This issue is exceptionally important because the clear-and-unmistakable standard leads to gamesmanship during the patent examination

process. As discussed above, patent examination manuals encourage applicants to file claims that are as broad as possible and then amend them as necessary to secure allowance. See p. 5, *supra*. As a matter of standard practice, applicants also avoid making a written record on the intended effect of, and reasons for, claim amendments. See, e.g., Todd R. Miller, *The “Doctrine of Prosecution Disclaimer” in Construing Patent Claims*, 86 J. Pat. & Trademark Off. Soc’y 931, 953 (2004) (“the less said, the better”); Thomas C. Fiola & Jon E. Wright, *Preparing and Prosecuting a Patent That Holds Up in Litigation* 28 (2006) (“One of the hallmarks of a ‘bullet-proof’ patent is a silent prosecution history.”).

That is a viable strategy because claim amendments are negotiated between applicants and examiners during telephonic or in-person “interviews.” Mark A. Lemley & Kimberly A. Moore, *Ending Abuse of Patent Continuations*, 84 B.U. L. Rev. 63, 67-68 (2004); George W. Jordan, III, *Prosecution Disclaimers* 7-8 (2004). Because such “interviews are not recorded, and because examiner records of interviews almost never include any useful information, interviews are often thought by practitioners as a way to explain the invention (and perhaps make concessions) without creating prosecution history that binds the applicant in later litigation.” Lemley & Sampat, 2010 Stan. Tech. L. Rev. 2 ¶ 15.

In other words, the less said in the prosecution history, the easier it is to secure a claim based on a narrower understanding of the claim scope, but later advocate a broader construction in court. This Court

adopted strict construction for the very purpose of preventing such gamesmanship by construing ambiguities against the applicant. *See* p. 23, *supra*. But the Federal Circuit's clear-and-unmistakable standard has the opposite effect, as patent applicants have every reason to seek broad claims, amend them as necessary to secure allowance, and avoid putting anything clear in the record concerning an amendment's meaning. The patentee can then seek a broader construction in court, making a mockery of the PTO's examination process.

The Federal Circuit's decision in *Omega Engineering v. Raytek Corp.*, 334 F.3d 1314 (Fed. Cir. 2003), exemplifies this common practice. There, the patent applicant had several telephone interviews with the examiner over the course of a week, resulting in an amendment adding the word "only" to certain claims. *Id.* at 1331. In the record, the applicant made only a "cryptic statement" that the amendment was "[r]esponsive to numerous telephone conversations with the Examiner." *Id.* The applicant offered no other reason for the amendment. *See id.* Because the record was "at best ambiguous" on the amendment's "effects and reasons," the Federal Circuit held that the amendment did not clearly disavow claim scope. *Id.*

That case is by no means an outlier. Scholars have noted "the relative ease in which one may find an ambiguity in the prosecution history so as to avoid prosecution disclaimer." Todd R. Miller, 86 J. Pat. & Trademark Off. Soc'y at 945. Allowing patentees to exploit such ambiguities in court undermines the integrity of the PTO's examination process by

making examiners' efforts to confine patent claims to actual innovation much more difficult, if not futile.

3. This Court invited the Government's views on this question in *Google Inc. v. Vederi, LLC*, 135 S. Ct. 1021 (2015). Without disputing the exceptional importance of the question, the Government recommended denial based on an unusual position on the merits. Faced with this Court's and the Federal Circuit's diametrically opposed standards, the government opined that both courts actually follow a third standard, under which a court applies ordinary construction principles (construing claims as if they had not been amended), determines what it thinks an applicant *had to* surrender in order to distinguish a prior art reference, and then carves out that subject matter—but no more—from the claim. See Br. for United States as Amicus Curiae, *Google, Inc. v. Vederi, LLC*, No. 14-448, 2015 WL 2395404, at *6, 9 (May 19, 2015). Because neither this Court nor the Federal Circuit has ever articulated that third test, the government's advocacy of it only underscores the need for this Court to consider and resolve the question.

What is more, the Federal Circuit has squarely rejected the Government's test: under its law, patentees may not "assert that claims should be interpreted as if they had surrendered only what they had to." *Norian Corp. v. Stryker Corp.*, 432 F.3d 1356, 1361–62 (Fed. Cir. 2005); see also *MarcTec, LLC v. Johnson & Johnson*, 394 F. App'x 685, 687 (Fed. Cir. 2010); *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 998 (Fed. Cir. 2006). Instead, as discussed above, the Federal Circuit has adopted a

strong presumption against disclaimer: faced with two reasonable constructions of an ambiguous amendment, the court chooses the *broad* one. *3M Innovative Props.*, 7254 F.3d at 1325. There is no sense in which such liberal construction is the “strict construction” called for by this Court.

Merits positions aside, the question is exceptionally important, the conflict is manifest, and this Court’s review is warranted.

III. This Case Provides A Good Vehicle For Considering These Important Issues.

This case illustrates the importance of both questions presented. Respondents overcame the examiner’s rejection by amending the claims to require a first and second “web browser process.” The applicants coined that term—it has no ordinary meaning in the computer field. And the patents’ specification does not use the term. Thus, as the *source* of the disputed term, the prosecution history provides by far the best evidence of the term’s meaning.

As discussed above, the applicants limited the claims to the use of a “web browser process” for the express purpose of distinguishing Narin’s secure process, which could access the web only through another process. *See* p. 8, *supra*. Indeed, the applicants emphasized that their claimed invention differed from Narin’s precisely because Narin’s secure process “may call upon a general-purpose browsing program to perform the web browsing,” instead of independently accessing the web itself. C.A. App. 590.

Thus, the district court correctly held that, to be “consistent with the prosecution history,” a web browser process must be capable of independently accessing website data. App. 42. Otherwise, it would be indistinguishable from the browsers that Narin disclosed and the applicants distinguished in order to secure the claims.

The Federal Circuit’s opposite conclusion rests on its rejection of the prosecution history under the clear-and-unmistakable standard. Without looking to the prosecution history, the court adopted a presumed construction based on the slenderest of reeds—its claim-differentiation doctrine, which, as that court has repeatedly acknowledged, is weak because patent applicants typically include numerous claims that use different words to say the same thing. See p. 11, *supra*. The court then declined to give *any* weight to the prosecution history based on its determination that the record was not clear and unambiguous. App. 18–19. In doing so, the court construed the term “web browser process” to include Narin’s browsers—exactly what the applicants distinguished to secure allowance in the first place.

That result illustrates a key problem with limiting prosecution history to a rigid, clear-and-unmistakable-disclaimer analysis. Under that approach, courts give no weight at all to an important source of contextual evidence in most cases. Commentators have noted a “decrease in the use of prosecution history” over time. J. Jonas Anderson, Peter S. Menell, *Informal Deference: A Historical, Empirical, and Normative Analysis of Patent Claim Construction*, 108 Nw. U. L. Rev. 1, 44–

45 (2013); *accord* Reilly, 20 Mich. Telecomm. & Tech. L. Rev. at 259–60. No need to wonder why: for courts following the Federal Circuit’s disclaimer analysis, there is often no reason to cite prosecution history, because the prosecution history typically contains some ambiguity. There is no reason to allow patent applicants to benefit from their own ambiguity, especially considering that they are the ones who failed to make a clear record of the intended meaning and effect of their own amendments.

Overbroad patent claims are a plague, especially in the vital and growing high-tech sector. *See, e.g., Enzo Biochem., Inc. v. Applera Corp.*, 605 F.3d 1347, 1349 (Fed. Cir. 2010) (Plager, J., dissenting from denial of reh’g). Such claims block others from innovating. *See* U.S. Dep’t of Commerce, *Patent Reform: Unleashing Innovation, Promoting Economic Growth & Producing High-Paying Jobs* 1, 5 (2010); Christopher R. Leslie, *The Anticompetitive Effects of Unenforced Invalid Patents*, 91 Minn. L. Rev. 101, 113–29 (2006). And the increased threat of damages or an injunction can drive up prices and decrease the availability of innovative products and services to the public.

All of this plays into the hands of entities that buy patents and then use litigation or the threat of litigation to extract settlements from alleged infringers. *See Halo Elecs., Inc. v. Pulse Elecs., Inc.*, 136 S. Ct. 1923, 1935 (2016). As the Federal Trade Commission has observed, patent assertion entities obtain “overbroad, vague claims” they may assert against a broad range of products or activities. They

wait for others to do the hard work of developing applications, and then sue the real innovators. See Fed. Trade Comm’n, *The Evolving IP Marketplace* 8–9, 50–51, 60–61 (Mar. 2011), available at <http://www.ftc.gov/os/2011/03/110307patentreport.pdf>. One study estimated that the direct cost of such suits totaled \$29 billion in a single year. James Besson & Michael J. Meurer, *The Direct Costs from NPE Disputes*, 99 Cornell L. Rev. 387, 387 (2014). Another study demonstrated that entities sued by patent-assertion entities “substantively reduce their innovative activity.” Lauren Cohen, Umit G. Gurun, & Scott Duke Kominers, *Patent Trolls: Evidence from Targeted Firms*, National Bureau of Economic Research Working Paper No. 20322, at 33 (Apr. 24, 2016), available at http://www.hbs.edu/faculty/Publication%20Files/15-002_1d86bb91-630b-43b9-949d-16cfa36a5f58.pdf. The result is that patent-assertion entities’ “nuisance suits stand to crowd out socially valuable innovation . . . without any measurable social gains.” *Id.* at 34.

The Federal Circuit’s jurisprudence exacerbates these problems through the uncertainty caused by its internal divisions and by placing the risk of ambiguity on the public instead of the patent applicant. For these reasons, and because of the overriding importance of claim scope, this Court’s review is warranted.

CONCLUSION

Google's petition for a writ of certiorari should be granted.

Respectfully submitted,

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