

18-1439 (Lead), -1440, -1441, -1444, -1445

In the
United States Court of Appeals
For the
Federal Circuit

TECHNOLOGY PROPERTIES LIMITED LLC, PHOENIX DIGITAL SOLUTIONS LLC,
and PATRIOT SCIENTIFIC CORPORATION,

Plaintiffs-Appellants,

v.

HUAWEI TECHNOLOGIES Co., LTD., FUTUREWEI TECHNOLOGIES, INC., HUAWEI DEVICE Co.,
LTD., HUAWEI DEVICE USA INC., HUAWEI TECHNOLOGIES USA INC., ZTE CORPORATION, ZTE
USA, INC., SAMSUNG ELECTRONICS Co., LTD., SAMSUNG ELECTRONICS AMERICA, INC., LG
ELECTRONICS, INC., LG ELECTRONICS U.S.A., INC., NINTENDO Co., LTD., and NINTENDO OF
AMERICA, INC.,

Defendants-Appellees.

*Appeal from the United States District Court for the Northern District of California,
Case Nos. 3:12-cv-03865-VC, 3:12-cv-03876-VC, 3:12-cv-03877-VC,
3:12-cv-03880-VC, and 3:12-cv-03881-VC • United States District Judge Vince Chhabria.*

**APPELLANTS’
PETITION FOR REHEARING EN BANC**

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March 8, 2019

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Technology Properties Limited, et al. v. Huawei Technologies Co., Ltd., et al.

Case No. 18-1439 (lead) with 18-1440, -1441, -1444, -1445
(consolidated)

CERTIFICATE OF INTEREST

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Technology Properties Limited LLC, Patriot Scientific Corporation, Phoenix Digital Solutions LLC,
certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
Technology Properties Limited LLC	Technology Properties Limited LLC	n/a
Patriot Scientific Corporation	Patriot Scientific Corporation	n/a
Phoenix Digital Solutions LLC	Phoenix Digital Solutions LLC	(1) Technology Properties Limited LLC; and
		(2) Patriot Scientific Corporation. Patriot Scientific Corporation is a publicly held company and owns 10 percent or more of the membership interest in Phoenix Digital Solutions LLC.

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

See Attachment A.

5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47. 4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

See Attachment B.

3/8/2019

Date

/s/ Denise De Mory

Signature of counsel

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Printed name of counsel

Please Note: All questions must be answered

cc: All Counsel of Record Via Court's CM-ECF

Reset Fields

ATTACHMENT A

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ATTACHMENT B

Appealed from the Northern District Court:

Tech. Properties Limited v. Huawei, Case No. 3:12-cv-03865

Tech. Properties Limited v. ZTE Corp, Case No. 3:12-cv-3876

Tech. Properties Limited v. Samsung, Case No. 3:12-cv-3877

Tech. Properties Limited v. LG Electronics, Case No. 3:12-cv-3880

Tech. Properties Limited v. Nintendo, Case No. 3:12-cv-3881

Consolidated with Court of Appeals, Federal District:

Tech. Properties Limited v. Huawei, Case No. 18-1438 (LEAD)

Tech. Properties Limited v. ZTE Corp, Case No. 18-1440

Tech. Properties Limited v. Samsung, Case No. 18-1441

Tech. Properties Limited v. LG Electronics, Case 18-1444

Tech. Properties Limited v. Nintendo, Case No. 18-1445

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**STATEMENT OF COUNSEL
UNDER FEDERAL RULE OF APPELLATE PROCEDURE 35(b)
AND FEDERAL CIRCUIT RULE 35(b)**

Based on my professional judgment, I believe the panel decision is contrary to the following decision(s) of the Supreme Court of the United States or the precedent(s) of this court: *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880), and *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996).

Dated: March 8, 2019

By: /s/ Denise M. De Mory
Denise M. De Mory

I. INTRODUCTION

This case is about the improper expansion of the judicially-created doctrine of prosecution disclaimer. Since the 1880's, the Supreme Court has consistently restricted prosecution disclaimer to the amendment, cancellation or surrender of patent claims during prosecution. When an applicant narrows claims during prosecution, the applicant disclaims the scope of the original claims; in this circumstance, the applicant's statements related to an amendment may shed light on the scope of the disclaimer.

But an applicant's other statements in the examination process that are untethered to claim amendments should not be used to find disclaimer. That is what this Court held in its en banc decision in *Markman*: "Although the prosecution history can and should be used to understand the language used in the claims, it [] cannot '*enlarge, diminish, or vary*' the limitations in the claims."¹

In the years since *Markman*, however, district courts and panels of this Court have eroded *Markman*'s directive, relying on all manner of statements in the prosecution history to limit claim scope and rewrite claims.

This is the wrong approach. It introduces uncertainty into the scope of the

¹ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996) (quoting *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880)) (emphasis added).

patent grant and undermines the public-notice function of the patent claims. A patent is a public franchise.² The public and the patentee are entitled to clarity on the boundaries of a patentee’s rights; the claims, which define the metes and bounds of the inventor’s rights, provide that clarity. Gratuitous statements in the file history do not; they are inherently less predictable—illustrated by this case and other recent cases.³

Issued claims reflect the outcome of an applicant’s exchange with the Patent Office. As Judge Learned Hand noted, courts are not “to go through all that was said in the endless communications between applicant and Examiners to gather piecemeal the intent of the grant”⁴ When a court substitutes its judgment for the final determination of the Patent Office and re-writes claims under the doctrine of prosecution disclaimer, the entire process is undermined in a manner that Judge Hand cautioned against, and which *Markman* forbids.

Congress charged the Patent Office—not the judiciary—with the responsibility for ensuring that issued claims include all limitations made

² See *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1373-74 (2018).

³ Current disclaimer law resulted in multiple different constructions of the same term at issue here in different courts. Appx6718-6719.

⁴ *Campbell Metal Window Corp. v. S.H. Pomeroy & Co. Inc.*, 300 F. 872, 873-74 (S.D.N.Y. 1924) (citing *Goodyear Dental*).

necessary in view of its examination and analysis of the prior art.⁵ Congress also gave the Patent Office the power to review its decisions and correct mistakes. Statutorily authorized proceedings allow the patentee, an accused infringer, or a member of the public to ask the Patent Office to amend, correct or cancel an improperly granted claim. If review is instituted, the Patent Office owes itself no deference. In contrast, the judiciary is required to give deference to the Patent Office;⁶ patents are presumed valid absent clear and convincing evidence to the contrary.

In this case, the Patent Office has already been asked to reconsider its decision *six times*. The Patent Office even considered, for the second time, a reference used to find disclaimer here. The '336 Patent emerged from each reexamination without the limitations imposed below.⁷

The consequences of this judicial second-guessing are profound. A structure that falls squarely within the scope of the issued claims—the very structure disclosed in the claimed embodiment—was found noninfringing as a matter of law. This aberration was possible only because this Court re-wrote the issued claim in hindsight, based on statements unrelated to change in claim scope by amendment.

⁵ *E.g.*, *Microsoft Corp. v. i4i Ltd. P'ship*, 564 U.S. 91, 95-96 (2011).

⁶ *Id.*; *see also Dickinson v. Zurko*, 527 U.S. 150, 152-54 (1999).

⁷ *See* Appx101-113 & Appx114-115 (reexamination certificates from the *four instituted proceedings*).

By using its expanded disclaimer doctrine to significantly narrow issued claims, this Court upsets the balance between the role of the Patent Office and the role of the judiciary, as established by Congress, and injects great uncertainty into the public-notice function of patents.

Appellants respectfully submit that the disclaimer doctrine needs to be returned to the confines of Supreme Court and this Court's own precedent.

II. BACKGROUND

A. Applicants' Statements During Prosecution Of The '336 Patent Relate To An Unclaimed Embodiment

The '336 Patent, filed in 1989, is one of seven patents that issued from an application relating to the architectural improvements of the "Sh-boom" microprocessor, which was later inducted into the I.E.E.E. Chip Hall of Fame.

The specification describes a number of embodiments. One embodiment, labeled the "Optimal CPU Clock Scheme,"⁸ describes a microprocessor system with one clock, a "familiar ring oscillator."⁹ When the '336 Patent was filed, the independent claims were directed only to this single-clock embodiment.

Applicants repeatedly attempted to obtain single-clock claims, making multiple arguments that the claimed clock (a ring oscillator on the same chip as the

⁸ Appx90-91 at Cols. 16:43-17:10.

⁹ *Id.* at Col. 16:54-58.

microprocessor) was different from cited single-clock prior art references.

Applicants were unsuccessful, and never obtained any single-clock claims.

Applicants then amended their claims to cover a different embodiment, the “Asynchronous/Synchronous CPU” dual-clock embodiment, by adding two additional limitations (including a second clock) to the original single-clock claims. The examiner allowed these narrowed dual-clock claims.

The dual-clock independent claims, including the claim at issue here, have four limitations, but the only limitation at issue concerns the ring oscillator of the dual-clock claims, called the “entire oscillator” in the claim.

B. The Court Added Limitations To “The Entire Oscillator” Term During Claim Construction, Thus Diminishing The Claims’ Scope

During claim construction, Appellees did not allege that “entire oscillator” was ambiguous. Instead, Appellees requested the imposition of negative limitations based on applicant’s statements made during their unsuccessful attempts to obtain the single-clock claims. In turn, the district court imposed, and a this court affirmed, the addition of two negative limitations, effectively re-writing the claim element to add the emphasized language as follows:

an entire oscillator (1) *that does not require a command input to change the clock frequency and (2) whose frequency is not fixed by any external crystal*, disposed upon said integrated circuit substrate and connected to said central processing unit, said oscillator clocking said central processing unit at a clock rate and being constructed of a second plurality of electronic devices,

thus varying the processing frequency of said first plurality of electronic devices and the clock rate of said second plurality of electronic devices in the same way as a function of parameter variation in one or more fabrication or operational parameters associated with said integrated circuit substrate, thereby enabling said processing frequency to track said clock rate in response to said parameter variation;¹⁰

C. Appellees Moved For And Were Granted Summary Judgment Based Solely On The Added Limitations

The district court granted summary judgment of non-infringement on the basis of the first disclaimer, finding that the accused products “require a command input to change frequency.”¹¹ The district court commented that it did not consider, but would likely reach the same outcome on, the second disclaimer.¹²

The noninfringement finding was not based on the characteristics or capabilities of the accused ring oscillator. The ring oscillators described in the patent and in the accused products are all comprised of an odd number of inversions connected in a loop:

¹⁰ See *Tech. Properties Ltd. v. Huawei Techs. Co.*, 849 F.3d 1349, 1359 (Fed. Cir. 2017) [hereinafter *TPL I*]. The panel affirmed the imposition of two negative limitations, as modified, based on the disclaimer doctrine.

¹¹ Because the words “command” and “input” do not appear in the specification or claims, Appellees submitted dictionary definitions of these terms during summary judgment. The district court based its ruling, in part, on the fact that Appellants did not provide a “a definition of ‘command input’ that would exclude” Defendants’ arguments. See Appx6.

¹² Appx8.

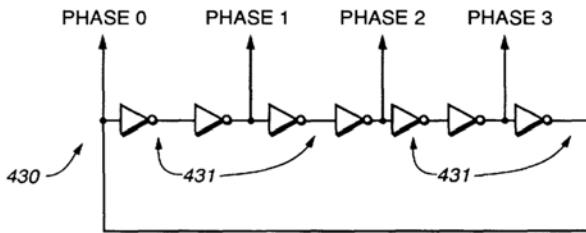
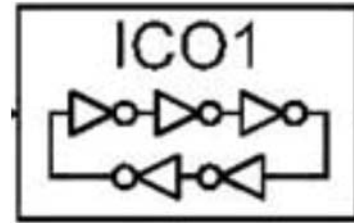


Figure 18 ('336 Patent)



Accused Products

This structure creates inherent instability such that changes in processing, voltage or temperature (“PVT”) parameter will cause the frequency to vary. To combat this variance, Appellees add a component, known as phase-locked loop (“PLL”), which operates like a cruise control, slowing down the oscillator when it speeds up, and vice versa.¹³ Appellees’ expert opined that the PLL’s influence on the ring oscillator meant that the ring oscillator’s frequency could only be changed via the PLL’s command input, similar to changing a car’s cruise control setting.¹⁴ Hence, Appellees argued that the *addition of the PLL* imposed a “command input,” avoiding infringement based on disclaimer. The district court agreed, and the second panel of this Court issued a Rule 36 affirmance.¹⁵

¹³ Appx5326.

¹⁴ Appx5332.

¹⁵ In this appeal, which followed a remand of an earlier appeal, Appellants asked the panel to revisit the earlier panel’s decision on claim construction and to review the propriety of current disclaimer law. Although the panel was bound by stare decisis and law of the case on these issues, an en banc court does not face the same limitations. *E.g., E-Pass Techs., Inc. v. 3COM Corp.*, 473 F.3d 1213, 1219 (Fed. Cir. 2007).

III. REHEARING SHOULD BE GRANTED TO RECONSIDER THE PROPER LIMITS OF PROSECUTION DISCLAIMER

Rehearing should be granted in this case because the law of prosecution disclaimer has morphed in a manner that conflicts with Supreme Court precedent and this Court's en banc decision in *Markman*. By ignoring this authority, this Court upsets the balance between the role of the Patent Office and the role of the judiciary, as established by Congress, and injects great uncertainty into the public-notice function of patents.

Congress delegated the examination and issuance of patents to the Patent Office and requires deference of the agency's decision-making.¹⁶ The expanded disclaimer doctrine calls into question the Patent Office's authority to examine and issue patents, and the limited role of the judiciary in reviewing the Patent Office's determinations.¹⁷ The expanded doctrine also leads to widely divergent results in the district courts and between panels of this Court. The unpredictability of the doctrine creates, rather than resolves, uncertainty regarding the boundaries of what should be well-settled property rights.

A. Amendment Alone Is The Hallmark Of Disclaimer

Prosecution disclaimer traces its origins to at least 1880 in *Goodyear Dental*

¹⁶ *i4i*, 564 U.S. at 95-96; *Dickinson*, 527 U.S. at 152-54.

¹⁷ *E.g.*, *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 (1877).

Vulcanite Co. v. Davis.¹⁸ *Goodyear Dental* held that disclaimer can arise when a claim is amended to overcome a prior art rejection.

Faced with a prior art rejection, the applicant in *Goodyear Dental* amended his specification to recite: “I do not claim the use of gutta-percha, or of any material which is merely rendered plastic by heat and hardened by cooling, ... ; but what I do claim as my invention ... consists in combining [artificial teeth] with a rubber plate and gums, which ... are vulcanized by Goodyear’s process, or any other process.” The applicant also amended the asserted claim to read: “forming the plate and gums in which the teeth are inserted in one piece of hard rubber, or vulcanite, i.e. an elastic material.” In view of the amended claims, the Court determined that “celluloid,” a “substance of recent discovery,” did not fall within the scope (or equivalents) of the claims because celluloid was “not vulcanite, and neither it nor its ingredients are capable of being vulcanized.” In reaching this conclusion, the Supreme Court stated that that while it was permissible to consider whether the prosecution history confirmed an apparent disavowal: “We do not mean to be understood as asserting that any correspondence between the applicant for a patent and the Commissioner of Patents can be allowed to enlarge, diminish,

¹⁸ 102 U.S. 222 (1880).

or vary the language of a patent afterwards issued.”¹⁹ The Supreme Court has thereafter consistently limited disclaimer to the surrender of claim scope through narrowing amendments.²⁰

Consistent with *Goodyear Dental*, this Court held en banc that while the prosecution history can be used to provide insight into claim meaning, it cannot be used to “*enlarge, diminish, or vary*” claim limitations.²¹

B. Application Of The Expanded Prosecution Disclaimer Doctrine Has Been Inconsistent And Unpredictable

While there were some cases finding disclaimer without amendment in the 1990’s, the floodgates appear to have fully opened in 2003 in *Omega Eng’g, Inc, v. Raytek Corp.*²² That panel generalized the prosecution disclaimer doctrine as follows, omitting any reference to amendment or arguments accompanying an amendment: “The doctrine of prosecution disclaimer is well established in

¹⁹ *Goodyear Dental*, 102 U.S. at 227 (emphasis added).

²⁰ *Shepard v. Carrigan*, 116 U.S. 593, 597 (1886) (“Where an applicant for a patent to cover a new combination is compelled by the rejection of his application by the patent-office to narrow his claim by the introduction of a new element, he cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent.”); *Weber Elec. Co. v. E. H. Freeman Elec. Co.*, 256 U.S. 668, 677-78 (1921) (“[T]he patentee may not by construction, . . . give to the claim the larger scope which it might have had without the amendments, which amount to a disclaimer [of] an operative feature of his devise.”); *Schriber-Schroth Co. v. Cleveland Tr. Co.*, 311 U.S. 211, 218 (1940).

²¹ *Markman*, 52 F.3d at 980 (quoting *Goodyear Dental*).

²² 334 F.3d 1314, 1326-27 (Fed. Cir. 2003).

Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.”²³ But this generalization is an overstatement of the authority on which the *Omega* panel relied; the cited Supreme Court cases involved amendments. The other cited cases also either addressed amendments, arguments that accompanied amendments or the scope of narrowed reissued claims.

Since this pronouncement, the prosecution disclaimer opinions of this Court have expressed divergent views and applications of the disclaimer doctrine, notwithstanding the repeated refrain that disclaimer occurs only when disavowal of claim scope is clear and unambiguous. One panel held that disclaimer may be inferred from a single statement concerning the prior art.²⁴ But in *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, this Court reversed the district court’s finding that “the inventor limited the ‘receiving means’ that receives the first code signal to a ‘monitor’ that receives the first code signal.”²⁵ The Court found that the

²³ *Omega*, 334 F.3d at 1323.

²⁴ *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366 (Fed. Cir. 2008) (“[A]pplicants distinguished their invention from the prior art in multiple ways. Nonetheless a disavowal, if clear and unambiguous, can lie in a single distinction among many.”).

²⁵ 508 F.3d 1366, 1372-73.

following statement could be read to be a disclaimer but was not clearly and unambiguously a disclaimer in view of the totality of the file history:

To ensure a no-error operation the camera generates a code signal, which is received by *the monitor*, based upon which, *a code is sent back to the camera along with the control signal...* ***The principle of the present invention is, therefore a transmission of a code from the camera to the monitor of the receiving means and back to the camera.***²⁶

In some cases, this Court carefully analyzed whether the applicant's discussion of the prior art raised a point of distinction rather than one of claim scope, while in others, statements about the contents of the prior art alone were sufficient to constitute disclaimer. For example, in *Shire Dev., LLC v. Watson Pharm., Inc.*, a panel found no disclaimer where "Shire carefully characterized the prior art as not having separate matrices but never actually stated that the claimed invention does have separate matrices."²⁷ In *Krippelz v. Ford Motor Co.*, the panel found disclaimer where the applicant argued that a prior art reference lacked a "light bulb at or near the focal point of a reflector" and therefore "disclaimed lamps lacking these limitations, and the limitations therefore became part of the properly construed claims."²⁸

²⁶ *Id.* (emphasis added).

²⁷ 787 F.3d 1359, 1366 (Fed. Cir. 2015).

²⁸ 667 F.3d 1261, 1266-67 (Fed. Cir. 2012).

The rule and disclaimer found in this case is also inconsistent with other panel decisions. In this case, the Court said “the scope of surrender is not limited to what is absolutely necessary to avoid a prior art reference; patentees may surrender more than necessary.”²⁹ But in *3M Innovative Properties Co. v. Avery Dennison Corp.*, this Court held that where “the patentee has expressly defined a term in the specification and remarks made to distinguish claims from the prior art are broader than necessary to distinguish the prior art, the full breadth of the remark is not a clear and unambiguous disavowal of claim scope.”³⁰

In another example, in *Avid Tech., Inc. v. Harmonic, Inc.*, a panel reversed a district court’s application of prosecution disclaimer finding that the statements on which the district court relied did not meet the high bar for disclaimer.³¹ One of those statements recited:

[T]he claimed system, by virtue of the “independent” storage units, avoids using a central controller to access data. In particular, storage units “receiv[e] ... request[s] from one of the client systems for a segment of a file.” *Clients **do not** issue requests to a central controller that in turn identifies storage units that store the data and issues requests to storage units.*³²

²⁹ *TPL I*, 849 F.3d at 1359

³⁰ 350 F.3d 1365, 1373 (Fed. Cir. 2003).

³¹ 812 F.3d 1040, 1045-47 (Fed. Cir. 2016).

³² *Id.* at 1046 (alterations in original; italics added by court; boldface added).

Compare that language to the language on which the disclaimer and summary judgment were based in this case:

The patentee argued during prosecution that Sheets was distinguishable from the '336 patent claims because Sheets requires “a command input ... to change the clock speed.” J.A. 2127. It described Sheets’ system “for providing clock control signals to an external clock” as “unrelated” to the claimed invention. J.A. 2117. Conversely, it stated that in the '336 patent, “[n]o command input is necessary to change the clock frequency.” J.A. 2127.³³

In *Avid*, the panel found no disclaimer because the quoted passages are “readily susceptible to a narrower reading than the one needed to support the district court’s disclaimer conclusion.”³⁴ To reach this conclusion, the court looked to the underlying reference to interpret the statements in context.³⁵ When Appellants did the same thing, the panel said “Technology Properties presented clear and concise arguments about the distinctions between Magar and the '336 patent in its briefing to our court. Had those same arguments been made to the Patent Office, our construction may have been different because the patentee likely disclaimed more than was necessary to overcome the examiner’s rejection.”³⁶

³³ *TPL I*, 849 F.3d at 1359.

³⁴ *Avid*, 812 F.3d at 1046.

³⁵ *Id.* at 1047.

³⁶ *TPL I*, 849 F.3d at 1359.

C. Applicants Did Not Disclaim A “Ring Oscillator”

This Court effectively re-wrote the “entire oscillator” limitation, adding two negative limitations based only on statements related to claims that were never obtained. Relying on the negative limitations, Appellees successfully argued that a ring oscillator did not meet the “entire oscillator” limitation of the asserted apparatus claim even though Appellees *never argued* that the accused ring oscillator did not meet the “entire oscillator” limitation as written.

There is no doubt that the examiner would have understood that a ring oscillator—the very structure in the specification—falls within the scope of the “entire oscillator” limitation. The examiner rejected the applicants attempts to obtain a single-clock claim, where the single clock was a ring oscillator. Though the applicants argued to obtain single-clock claims, those arguments were mooted when the applicant and the examiner agreed that none of the prior art disclosed the dual-clock embodiment, where one clock was *a ring oscillator* (“the entire oscillator”) and the other was a crystal clock. The claims were amended to require both clocks.³⁷ The prosecution history confirms that a ring oscillator falls within the scope of the claims.

³⁷ Applicants disclaimer of a claim that covered only a single clock is the only disclaimer that occurred in this case.

Appellees nonetheless successfully argued that *the addition of the PLL* brought the accused devices within the added negative limitations, and therefore outside the scope of infringement. In the normal case, adding structure to an otherwise infringing apparatus, even if it limits the apparatus' operation, may at best impact the value of the invention to the accused infringer, but does not make the apparatus non-infringing. The result here is contrary to this Court's precedent in *A.B. Dick Co. v. Burroughs Corp.*, could not have been reached without the added negative limitations, and should be vacated.³⁸

IV. CONCLUSION

The doctrine of prosecution disclaimer expanded under the rationale that the public should be able to rely on all of an applicant's statements in the prosecution history, regardless of whether they relate to amendments, whether they were successful, or whether they were relied on by the examiner. The result in this case, however, evidences the extent to which the doctrine has led to highly unpredictable and manifestly unjust results.

The Patent Office, the agency to which Congress has delegated authority to examine and issue patents, confirmed the claims at issue here as written when it first decided to issue the claims—and again six additional times. Notwithstanding this, the district court and prior panel re-wrote the claims to impose additional

³⁸ 798 F.2d 1392 (Fed. Cir. 1986).

limitations. The limitations include language that does not appear in the claims or specification, and ignore how previous tribunals interpreted the “entire oscillator” limitation. Without ever arguing that the accused products did not meet the claims as written, Appellees were able to successfully argue a ring oscillator— one of the clocks of the dual-clock claim ultimately granted—did not infringe the claim as a matter of law, solely based on the judicially-imposed negative limitations.

This result in this case wrong, unjust, and undermines the very rationale underlying the disclaimer doctrine. The expanded doctrine leads to uncertainty, not clarity, which the claims themselves provide. Congress delegated the process of examining and granting claims that delineate an inventor’s rights to the Patent Office. Encouraging litigants and courts to wade through the back-and-forth between the Patent Office and an applicant to rewrite the claims by imposing additional limitations runs afoul Congress’s delegation.

For all of the foregoing reasons, Appellants respectfully request that Court should once again follow the Supreme Court’s bright line precedent that only amendment (i.e., an affirmative change in claim scope) gives rise to disclaimer. At minimum, disclaimer should not be rooted in unsuccessful arguments that did not impact the Patent Office’s decision to issue the patent.

Respectfully Submitted,

Dated: March 8, 2019

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ADDENDUM

Panel Decision Dated February 6, 2019

NOTE: This disposition is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

**TECHNOLOGY PROPERTIES LIMITED LLC,
PHOENIX DIGITAL SOLUTIONS LLC, PATRIOT
SCIENTIFIC CORPORATION,**
Plaintiffs-Appellants

v.

**HUAWEI TECHNOLOGIES CO., LTD., FUTUREWEI
TECHNOLOGIES, INC., HUAWEI DEVICE CO.,
LTD., HUAWEI DEVICE USA INC., HUAWEI
TECHNOLOGIES USA INC., ZTE CORPORATION,
ZTE USA, INC., SAMSUNG ELECTRONICS CO.,
LTD., SAMSUNG ELECTRONICS AMERICA, INC.,
LG ELECTRONICS, INC., LG ELECTRONICS
U.S.A., INC., NINTENDO CO., LTD., NINTENDO OF
AMERICA, INC.,**
Defendants-Appellees

2018-1439, 2018-1440, 2018-1441, 2018-1444, 2018-1445

Appeals from the United States District Court for the
Northern District of California in Nos. 3:12-cv-03865-VC,
3:12-cv-03876-VC, 3:12-cv-03877-VC, 3:12-cv-03880-VC,
3:12-cv-03881-VC, Judge Vince Chhabria.

JUDGMENT

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THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (MOORE, TARANTO, and CHEN, *Circuit Judges*).

AFFIRMED. See Fed. Cir. R. 36.

ENTERED BY ORDER OF THE COURT

February 6, 2019
Date

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limitation of Federal Rule of Federal Circuit Rule 32(a). This brief contains 3,889 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f), Federal Circuit Rule 32(b) and 35(c)(2).

This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft Word 2016 in 14-point Times New Roman.

Dated: March 8, 2019

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PROOF OF SERVICE

I hereby certify that on March 8, 2019, I electronically filed the foregoing Appellant's Petition for Panel Rehearing and Rehearing En Banc with the Court's CM/ECF filing system, which constitutes service, pursuant to Fed. R. App. P. 25(c) and Fed. Cir. R. 25(a).

Dated: March 8, 2019

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