

## **Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu**

The *Vederi* challenge to Federal Circuit post-argument claim construction now at the Supreme Court will be a featured topic at the Naples Conference; registration information is discussed at the end of this note.

On January 12, 2015, the Supreme Court issued a CVSG Order in *Google, Inc. v. Vederi*, Supreme Court No. 14-448, opinion below, *Vederi, LLC v. Google, Inc.*, 744 F.3d 1376 (Fed. Cir. 2014)(Rader, C.J.), where Petitioner questions whether “a court [should] presume that [an] amendment [responsive to a prior art rejection] narrowed the claim and strictly construe the amended claim language against the applicant[.]”

If *certiorari* is granted the case would be argued and decided in the coming Term that runs through June 2016.

**Top Guns for Petitioner:** Petitioner is represented by a former Principal Deputy Attorney General while *amici* in support of Petitioner (Acushnet Company, Dell Inc., Kaspersky Lab, Inc., Limelight Networks, Inc., Newegg Inc., QVC, Inc., SAS Institute Inc., Ebay Inc., and Xilinx, Inc.) are represented by the successful counsel in the recent *Nautilus* case.

**Naples Conference:** The 3rd Annual Naples Patent Law Experts Conference to be held February 9 – 10, will include the *Vederi* case. The beachfront Conference in Naples, Florida, focuses upon an interactive discussion by the more than thirty faculty members as well as Conference registrants. Information is available from the sponsoring organization, the University of Akron, Shannon Aupperle, [sfauppe@uakron.edu](mailto:sfauppe@uakron.edu)

Attached are the *Question Presented*; an excerpt from the opinion below; an excerpt from Petitioner’s opening brief; an excerpt from the brief of the *amici*; an excerpt from Respondent’s Brief in Opposition; and an excerpt from Petitioner’s Reply Brief.

Regards,

Hal

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

**Question Presented:** “When an applicant for patent amends a claim to overcome the Patent and Trademark Office’s earlier disallowance of the claim, should a court (i) presume that the amendment narrowed the claim and strictly construe the amended claim language against the applicant, as this Court has held, or (ii) presume that the claim scope remained the same and require that any narrowing be clear and unmistakable, as the Federal Circuit has held?”

***Vederi, LLC v. Google, Inc.*, 744 F.3d 1376, 1382, 1384 (Fed. Cir. 2014)(Rader, C.J.):**

In construing claims, this court relies primarily on the claim language, the specification, and the prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314-17 (Fed. Cir. 2005) (en banc). "Apart from the claim language itself, the specification is the single best guide to the meaning of a claim term." *AIA Eng'g Ltd. v. Magotteaux Int'l S/A*, 657 F.3d 1264, 1272 (Fed. Cir. 2011) (internal quotations and citation omitted). And while the prosecution history often lacks the clarity of the specification, it is another established source of intrinsic evidence. *Id.* After considering these three sources of intrinsic evidence, a court may also seek guidance from extrinsic evidence. *Phillips*, 415 F.3d at 1317-18. However, extrinsic evidence may be less reliable than the intrinsic evidence. *AIA Eng'g*, 657 F.3d at 1273.

\* \* \*

[Accused infringer] contends that the inventors of the Asserted Patents disclaimed the construction sought by [the patentee] in responding to a rejection over a prior art reference. Specifically, the application leading to the '760 patent initially contained claims reciting "images providing a non-aerial view of the objects." J.A. 404. The Patent Office rejected those claims in view of U.S. Patent No. 6,140,943 (Levine). The applicant responded by amending the claims to remove "non-aerial view" and add "substantially elevations." *Id.* at 494.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

The applicant also correctly noted that Levine was directed to "map images, which may include names of streets, roads, as well as places of interest" that a traveler could use to navigate through a geographic area. *Id.* at 503-04. Therefore, Levine did not disclose images "depict[ing] views that are 'substantially elevations of the objects in a geographic area'" or "acquired by an image recording device moving along a trajectory." *Id.* at 504. Despite [the patent challenger]'s protestations to the contrary, this court discerns no clear and unambiguous disavowal of spherical or curved images that would support the district court's construction. *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1369 (Fed. Cir. 2003).

### **From Petitioner's Main Brief:**

Because patents confer exclusive property rights, the integrity of the process by which the Patent and Trademark Office ("PTO") examines and grants patent applications is exceptionally important. During that process, a patent examiner may determine that a claim is not patentable because, for example, it was anticipated by prior inventions or obvious in light of the background knowledge of persons skilled in the art. In that common situation, a patent applicant may either appeal the denial or amend the claim to "overcome" the examiner's reasons for rejecting the claim. For example, an examiner might reject a broad claim to a camera because cameras were well known, but later allow a narrower, amended claim limited to a new, specific type of camera (such as the first infrared camera).

As this Court has repeatedly held, that process is not supposed to be a charade. When an applicant overcomes a rejection by amending a claim, something important has happened-the applicant has secured a government-granted property right by narrowing the claim. The amendment therefore "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). By striking a phrase and replacing it with another to overcome the rejection, the applicant "recognize[s] and emphasize[s] the difference between the two phrases and proclaim[s] his abandonment of all that is embraced in that difference." *Id.* at 136.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

The Federal Circuit has turned that holding on its head. Instead of presuming that such amendments are narrowing, the Federal Circuit presumes that they *do not* narrow the original claim scope. In that court's view, an amendment disclaims the earlier claim scope only if, and only to the extent that, it clearly and unmistakably does so. *See, e.g.*, App. 15. In other words, instead of strictly construing amended claim language against the drafter and in favor of the public the Federal Circuit construes it in favor of the drafter by seeking clear and unmistakable evidence of an intent to narrow the claim.

In addition to conflicting with this Court's claim-construction precedent, that standard vitiates this court's doctrine-of-equivalents jurisprudence. In limited circumstances, that doctrine expands a patent claim's effective scope to include "equivalents." When a patentee has amended a claim to secure allowance, however, "courts may presume ... that the territory surrendered is *not* an equivalent of the territory claimed." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 741 (2002) (emphasis added). That limitation on the doctrine of equivalents presupposes that the amendment has limited the claim scope and that the question is whether to reinstate some of the surrendered scope through equivalents. By adopting the opposite presumption, that amendments do not limit claim scope, the Federal Circuit reads claims more broadly than would be permitted even under the doctrine of equivalents—an untenable result, given that the doctrine of equivalents exists to broaden the effective claim scope.

The stark conflict between decisions of this Court and the Federal Circuit—with the Federal Circuit holding the exact opposite of what this Court has held—is reason enough to grant review. The question's importance is another reason. To preserve the integrity of the examination process, courts must enforce the conditions on which patents are granted and take care not to read claims more broadly than the examiner did when allowing them. "Were it otherwise, the inventor might 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." *Id.* at 734.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

That is what happened here. In response to an examiner's rejection, the patent applicants narrowed the proposed claims. In court, however, respondent argued that "there was no clear and unambiguous surrender" of claim scope (*e.g.*, C.A. App. 2183), and the Federal Circuit agreed. That is the opposite of strict construction.

A rule that permits patentees to say one thing before the PTO and another during litigation disserves the public and undermines the integrity of the PTO's examination process. This Court should grant certiorari or, at a minimum, call for the views of the Solicitor General on this important question.

### **Excerpt from the Brief of *amici curiae* Acushnet Company, Dell Inc., Kaspersky Lab, Inc., Limelight Networks, Inc., Newegg Inc., QVC, Inc., SAS Institute Inc., Ebay Inc., and Xilinx, Inc., in support of Petitioner.**

*Amici* respectfully ask the Court to grant the petition because the Federal Circuit has invited patent applicants to leverage ambiguity at the expense of the public and the integrity of the patent system. The appeals court's departure from this Court's precedent has resulted in the following common patent-litigation scenario: A patent owner asserts an issued patent against an accused infringer. Previously, during the prosecution of the underlying patent application, an examiner rejected the now-asserted claims as unpatentable in light of the prior art. In response, the patent applicant amended the original claims-typically *without* a clear explanation on the record-and the examiner allowed the amended claims. The patent owner now seeks a broad construction of that amended claim language to support its infringement arguments, which frequently turn on how courts interpret disputed claim language. Even if the examiner never would have allowed claims with the asserted scope, the record is ambiguous, so nothing stops the patent owner from making the assertion. This scenario arises frequently because patent practitioners are trained to draft broad initial claims, to narrow them only as required by the patent examiner, and to refrain from explaining the effect of such amendments in writing.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Under this Court's precedent, the limitations added by amendment "must be *strictly construed against the inventor* and in favor of the public" by presuming that she surrendered any scope between the original and amended claim language to overcome the cited art. *Hubbell v. United States*, 179 U.S. 77,84 (1900) (emphasis added) (affirming judgment of non-infringement based on interpretation of element added by amendment during prosecution). Thus, for the same reason the patentee is presumptively estopped from seeking infringement under the doctrine of equivalents, she has also presumptively disclaimed a broad interpretation of the amended claim language. *See generally Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

The Federal Circuit has adopted the opposite approach, presumptively reading language added to a claim by amendment in favor of the patentee based on her *own* failure to clarify (or often, intentional decision not to clarify) the scope of the disclaimer. According to the Federal Circuit, newly-amended claim language merits no different interpretation than if it had appeared in the original claims *unless* the patent applicant memorialized a "clear and unambiguous" or "clear and unmistakable" disclaimer of claim scope in the written prosecution history. *Vederi, LLC v. Google, Inc.*, 744 F.3d 1376, 1384 (Fed. Cir. 2014) (finding "no clear and unambiguous disavowal" (citing *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1369 (Fed. Cir. 2003))); *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1326 (Fed. Cir. 2013) (finding disclaimer was not "clear and unmistakable," and thus did not attach, because it was "amenable to multiple reasonable interpretations"). In essence, the Federal Circuit construes the new language *against the public* by affording it a presumptively broad scope, *see 3M*, 725 F.3d at 1326 ("Where . . . a disavowal does not exist, the ordinary and customary meaning of the claim term will be given its full effect."), which also leads to the paradoxical result of presumptively narrower claim scope for patent applicants who clearly explain their amendments in writing during prosecution. This practice improperly restricts the role of the prosecution history in ascertaining the proper scope of patent claims, incentivizes patent applicants to avoid clarity during prosecution, and cannot be squared with this Court's precedent.

Accordingly, this Court should grant the petition and clarify that claim language should not be construed in a vacuum, divorced from the remainder of the intrinsic evidence. Claim amendments made to overcome patentability rejections should trigger a rebuttable presumption *against the patentee*, who should no longer be rewarded for vague and unclear attempts to distinguish prior art. Patent applicants should not be incentivized to obfuscate the record of their interactions with the patent examiner.

***From Respondent's Opposition to the Petition:***

Questions Presented (per Respondent): 1. Whether Petitioner has shown that the Federal Circuit presumes that claim amendments to overcome a rejection by the Patent and Trademark Office do not narrow the claim's scope and that any disclaimer of the original claim scope must be clear and unmistakable.

2. Whether Petitioner has demonstrated any support for its proposition that, in the underlying case, the after-amended claims, as construed by the Federal Circuit, are of the same scope as the original before-amended claims.

\* \* \*

Petitioner asserts that, when confronted with a situation where an applicant for a patent has amended a claim to overcome a rejection of the claim by the Patent and Trademark Office, the Federal Circuit presumes that the claim scope remains the same and requires that any narrowing be clear and unmistakable. (Petition at page 16). None of the Federal Circuit decisions cited by Petitioner supports this assertion. Nor does the Federal Circuit's decision in the underlying case. In fact, the Federal Circuit recognizes that this would lead to a nonsensical result. *Bd. Of Regents of the Univ. of Tex. Sys. v. Ben Q Am. Corp.*, 533 F.3d 1362, 1370 (Fed. Cir. 2008)

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Petitioner conflates the effect of narrowing amendments on claim construction with the effect of statements by applicants made during prosecution of the claim. Petitioner further conflates disclaimer and disavowal in the context of claim construction, i.e., prosecution disclaimer, with disclaimer in the context of prosecution history estoppel and doctrine of equivalents analysis.

Virtually all of the Federal Circuit cases cited by Petitioner address claim construction issues and specifically, whether statements made by the applicant during the prosecution of the patent claim represented an unambiguous disavowal of a particular meaning and narrow the ordinary meaning of the claim term. None of the cases involve a claim that has been amended and where the Federal Circuit presumed that the scope of the claim remained the same. None of these Federal Circuit cases are inconsistent with the Supreme Court cases cited by Petitioner, almost all of which address disclaimer in the context of prosecution history estoppel and the doctrine of equivalents.

The Federal Circuit decision in the underlying action dealt strictly with issues of claim construction. The claims were amended to replace "non-aerial views of objects" with "views being substantially elevations of objects." The issue on appeal was the meaning of "views being substantially elevations of objects." There were no issues relating to the doctrine of equivalents or prosecution history estoppel. There was no issue of prosecution disclaimer due to the amendment. That is, the amendment clearly narrowed the claim scope. Nor was the original claim scope recaptured by claim construction.

Hence, even if there is an issue regarding the Federal Circuit's application of prosecution disclaimer, this case is not an appropriate vehicle for review. Petitioner opines that the after-amendment scope of the claims, as construed by the Federal Circuit, is the same as the original claim scope. Petitioner identifies no support for its opinion. While Respondent adamantly disagrees with Petitioner's opinion, it recognizes that this issue is not ripe for review. There has been no finding by any court, and no evidence presented to any court on this issue. This issue was raised by Petitioner in its Petition for Rehearing En Banc which was denied by the Federal Circuit.



## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Also, contrary to Petitioner's assertions, The Federal Circuit did not apply a "clear and unambiguous" standard to determine the scope of a claim term that was amended during prosecution. (See Petition at App. 11-12). The Federal Circuit's reference to "no clear and unambiguous disavowal" (*Id.* at App. 15) relates to whether the claim term "images" (which was not amended during prosecution) should be construed to give "images" its ordinary meaning or narrowed to exclude curved and spherical images. The Federal Circuit correctly found that there was no disavowal of curved or spherical images and found no reason not to give "images" its ordinary meaning.

### ***Petitioner's Reply Brief (excerpts):***

At least two things should be clear by now. First, the question presented has great practical importance. Vederi does not dispute that crucial point, and the nine *amici* confirm it. Second, the Federal Circuit's legal standard squarely conflicts with this Court's holdings.

As Vederi acknowledges, this Court's decisions "clearly point out that a disclaimer attaches to narrowing amendments made to overcome prior art rejections." Opp. 19. To effectuate that disclaimer, the amendment "must be strictly construed against the inventor and in favor of the public." *Hubbell v. United States*, 179 U.S. 77, 83-84 (1900). The Federal Circuit has adopted precisely the opposite rule: an amendment disclaims the original claim scope only if-and only to the extent that the disclaimer is "both clear and unmistakable." *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1325 (Fed. Cir. 2013).

Vederi does not dispute either that this Court has adopted a strict construction standard or that the Federal Circuit does not apply such a standard. Instead, Vederi argues that this Court's cases concern only the doctrine of equivalents, whereas the Federal Circuit's cases concern claim construction. But this Court has held that a patentee may not recapture claim scope "by construction, or by resort to the doctrine of equivalents." *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 444 (1926) (emphasis added; internal quotation marks omitted).

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Vederi also asserts that, in the Federal Circuit cases, the patentees did not "recapture[ ] *all* that was given up" by amendment. Opp. 13 (emphasis added); *see also* Opp. 14, 15, 16, 18. But this Court's decisions do not require that amendments be read to narrow claim scope at least a little (*i.e.*, that they be given some modicum of effect); instead, this Court has required that amended claim language be strictly construed against the drafter and in favor of the public. Any other rule would allow patent applicants to amend their claims to secure allowance but later advance claim constructions that would largely (even if not entirely) undo the amendments required by the examiner as a condition for granting the patent.

Vederi does not and could not dispute the exceptional importance of this question. The Federal Circuit's rule undermines the integrity of the Patent and Trademark Office's ("PTO's") examination procedure, as well as the agency's recent efforts to promote clarity in prosecution, by encouraging gamesmanship by patent applicants and overbroad claim constructions by courts. The Court should grant the petition to resolve this important conflict or, at a minimum, call for the views of the Solicitor General in light of the impact of the Federal Circuit's rule on the patent prosecution process.

### **A. The Federal Circuit's Rule Squarely Conflicts With This Court's Precedents.**

1. This Court has consistently and repeatedly held that an amendment made to overcome a rejection based on prior art "operates as a disclaimer." *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942). The decision to amend a claim, rather than appeal the examiner's rejection, is a "concession that the invention as patented does not reach as far as the original claim." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002). To preserve the integrity of the examination process and prevent patentees from recapturing surrendered claim scope during litigation, the amendment "must be strictly construed against the inventor and in favor of the public." *Hubbell*, 179 U.S. at 83-84.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Vederi's understanding of this Court's precedents is more than a little puzzling. Vederi argues that this Court has never held "that the amended claims need not be construed as the initial step in an infringement analysis." Opp. 19. That is true but beside the point. Claims must be *strictly construed* against the applicant and in favor of the public. *Hubbell*, 179 U.S. at 83-84. Remarkably, Vederi never even mentions this Court's strict-construction requirement.

Vederi argues that this Court's decisions address only the doctrine of equivalents (specifically, principles of prosecution-history estoppel, which limit a patentee's right to invoke equivalents). *See* Opp. 12. Even a cursory review confirms that is wrong. As the Court has emphasized, "the question is one of construction of the claim." *Exhibit Supply*, 315 U.S. at 137; *see also Hubbell*, 179 U.S. at 84 (citing "principles of construction"). A patentee may not recapture claim scope *either* "by construction, or by resort to the doctrine of equivalents." *I.T.S. Rubber*, 272 U.S. at 444 (emphasis added).

As the petition explains, moreover, claim construction and prosecution-history estoppel are closely connected in this context. Pet. 23-24. The former prevents patentees from using the process of claim construction to recapture surrendered claim scope. The latter prevents patentees from using the doctrine of equivalents to do the same thing. *Festo*, 535 U.S. at 741. Because claim construction is antecedent to an equivalents analysis, allowing patentees to press for a claim construction broader than the scope of available equivalents would undermine this Court's prosecution-history estoppel jurisprudence. *See* Pet. 20-21. Yet that is exactly what the Federal Circuit has repeatedly done.

2. It would be an understatement to say that the Federal Circuit does not strictly construe claim amendments against the applicant. Pet. 16-18. That court takes the opposite approach by liberally construing amendments in favor of the applicant—presuming that an amendment disclaims the original claim scope only if, and only to the extent that, the difference between the original and amended claim language is "both clear and unmistakable." *3M Innovative Props.*, 725 F.3d at 1325.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Vederi does not appear to dispute those points. Far from arguing that the Federal Circuit strictly construes claim amendments, Vederi acknowledges that the court of appeals requires any disclaimer to be "clear," Opp. 15, 17, or "sufficiently explicit," Opp. 18. Whenever the prosecution history is not clear about the meaning of an amendment, the Federal Circuit construes it in favor of the applicant. Pet. 20-21. Indeed, if two interpretations of a claim amendment are at least "reasonable," the Federal Circuit chooses the one that favors the patentee instead of the public. *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1332 (Fed. Cir. 2004); *see also W.E. Hall Co. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1352 (Fed. Cir. 2004) (favoring patentee even when prosecution history is likely but "not necessarily inconsistent with" broader construction). As *amici* show, the Federal Circuit's heavy presumption has led it to reject even "ostensibly clear disclaimer[s]." *Amici* Br. 13-14.

Vederi suggests that all of the relevant Federal Circuit cases concern disclaimers based on "statements made by the applicant," rather than amendments to the claims. Opp. 13. Again, that ignores what the decisions (including the decision in this case, *see* Pet. App. 15) actually say and do. In *3M*, for example, the Federal Circuit relied on its "clear and unmistakable" standard in reversing a district court's holding that claim "amendments constituted a disclaimer." 725 F.3d at 1325-26, 1327. In another case, the court held that disclaimer occurs only when an applicant "unequivocally disavowed" claim scope "whether by amendment or by argument." *Schindler Elevator Corp. v. Otis Elevator Corp.*, 593 F.3d 1275, 1285 (Fed. Cir. 2010) (internal quotation marks omitted). In the Federal Circuit's view, "an amendment that clearly narrows the scope of a claim . . . constitutes a disclaimer," but ambiguous amendments do not. *Id.* (emphasis added).

Vederi also argues that the Federal Circuit has not allowed a patentee to "recapture[] *all* that was given up when the applicant amended his claims." Opp. 13 (emphasis added); *see also* Opp. 14, 15, 16, 18 (citing *e.g.*, *Bd. Of Regents of the Univ. of Tex. Sys. v. BenQ Am. Corp.*, 533 F.3d 1362, 1370 (Fed. Cir. 2008)). This case demonstrates otherwise. *See* Pet. 18.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Even if Vederi were correct, the conflict would remain. Vederi's argument appears to be that, so long as amended claim language is construed to be at least a little narrower than the original claim language, all is well. But patentees are not entitled to recapture *any* of the claim scope they abandoned by amending a claim to overcome the prior art. By striking a phrase and replacing it with another to overcome a rejection, the applicant "recognize[s] and emphasize[s] the difference between the two phrases and proclaim[s] his abandonment of *all* that is embraced in that difference." *Exhibit Supply*, 315 U.S. at 136 (emphasis added). This Court has not required that amendments made to overcome disallowance be construed to have at least a little effect; it has required that such amendments be strictly construed against the patentee.

3. This case illustrates the conflict. The court of appeals did not strictly construe Vederi's amended claim language. Instead, that court applied its "clear and unmistakable" standard and held that the claim amendment was not a clear and unmistakable disclaimer. Pet. App. 14-15.

That error is especially stark in this case because, as construed by the Federal Circuit, there is no difference between the original and amended claim scope. To overcome the examiner's rejection, the applicants replaced "non-aerial views" with "substantially elevations," and the Federal Circuit construed the latter term broadly to cover all "front and side views." *See* Pet. 7-8. Because all non-aerial views are front or side views in the patented invention (everyone agrees there are no back views, *see* Pet. App. 31), the court's application of the wrong legal standard produced the wrong result.

As the petition explains, the court of appeals never identified any difference in the scope of the original and amended claims. Nor has Vederi. Pet. 12. After acknowledging that all default views in StreetView are front views, *see* Opp. 6, Vederi asserts that "there are innumerable non-aerial views of objects that are not front views or side views of the objects." Opp. 21. But Vederi offers no explanation for that conclusory assertion.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Vederi falsely asserts that Google previously acknowledged such views, but Vederi points only to an exhibit containing several screen shots from Street View. Vederi contends without explanation that only one of those screen shots "depicts a *front* view of an object." Opp. 22 (emphasis added). But the Federal Circuit's construction includes front or *side* views. *See* Pet. App. 16. All of the pictures in Vederi's exhibit contain a front or side view of one or more objects, such as streets, cars, or buildings. *See* Opp. 22.

Even if there were some slight difference between the original claim language and the Federal Circuit's construction of the amended language, the point would remain the same - the amendment should be strictly construed against the applicants, not presumptively read in their favor so as to minimize its effect. A rule that permits patentees to recapture most, even if not all, of the scope given up by amendment fails for all the reasons discussed above.

4. Vederi's other arguments concerning the record of this case are at best diversions. Vederi argues that the Federal Circuit relied on its "clear and unmistakable" standard only for a different issue concerning a purported difference between "images" and "views." *See* Opp. 20-21. The court did no such thing. The court of appeals rejected Google's reliance on the amendment that replaced "non-aerial views" with "views being substantially elevations," and did not even discuss any purported difference between images and views. Pet. App. 15-16. In the court of appeals, Vederi had made a confusing and specious argument about a purported difference between images and views, Vederi C.A. Br. 25-27, but the court did not even address that argument in its opinion, much less adopt it. n1 Instead, the court relied on its "clear and unmistakable" standard to reject Google's reliance on the amendment that replaced "non-aerial views" with "substantially elevations." *See* Pet. App. 15-16.

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Vederi suggests that Google did not preserve this issue and that it is therefore unripe. *See* Opp. 2. In fact, Google argued that the amendment "makes clear that 'substantially elevations' is different from and narrower than 'non-aerial views,'" but Vederi's construction "would defeat the amendment" because there is no evident difference between non-aerial views and Vederi's construction of substantially elevations. Google C.A. Br. 30; *see also id.* ("Vederi's proposed construction would essentially [\*\*14] restore the original claim scope."); *id.* at 30-31 ("If there is a relevant difference between non-aerial views and Vederi's overbroad proposal of front or side views, it is a subtle one.").

Moreover, the court of appeals squarely addressed the issue by relying on its "clear and unmistakable" standard, rejecting Google's interpretation of "substantially elevations," and reversing the district court's final judgment for that reason. Having been pressed *and* passed on below, the issue was amply preserved even before Google's petition for rehearing en banc asked the full Federal Circuit to overrule its "clear and unmistakable" standard. *See United States v. Williams*, 504 U.S. 36, 41-43 (1992).

### **B. This Issue Is Exceptionally Important.**

As the petition and *amici* brief explain, the question presented is exceptionally important. *See* Pet. 22-25. Significantly, Vederi does not dispute the issue's importance. Ignoring that basis for *certiorari* does not make it disappear.

The nine *amici*, which include Dell, eBay, Limelight, NewEgg, and SAS, have extensive experience with innovation, the patent examination process, and patent litigation. Their brief demonstrates that the question presented recurs frequently because it is commonplace for patent applicants to file broad claims and then amend them in response to initial rejections. *See Amici* Br. 11-12; Robert C. Faber, *Faber on Mechanics of Patent Claim Drafting* § 10:1.1, at 10-2 (6th ed. 2013); Mark Lemley & Bhaven Sampat, *Examining Patent Examination*, 2010 Stan. Tech. L. Rev. 2, P 12 (2010).

## [Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu](#)

Indeed, a study shows that 85% of sampled issued patents were amended at least once. *Id.* P 11. But there is typically not a clear record concerning the meaning of an amendment, in part because of the *ex parte* nature of the examination process, in which telephone conversations or other conferences are not recorded. *See Amici Br.* 18-19.

Under the Federal Circuit's "clear and unmistakable" test, patent applicants have every reason to seek broad claims, amend them as necessary to secure allowance, avoid putting anything clear in the record concerning an amendment's meaning, and then seek a broad construction in court. *See id.* And they often do just that. *See, e.g.,* Greg Reilly, *Judicial Capacities and Patent Claim Construction: An Ordinary Reader Standard*, 20 Mich. Telecomms. Tech. L. Rev. 243, 246 (2014).

In addition to enabling those tactics, and undermining the integrity of the PTO examination process, the Federal Circuit's approach deprives the public and courts of valuable interpretive evidence. As this Court recently held, claims must be reasonably clear. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014). Just as the meaning and clarity of statutory language depends on context, so too does the meaning and clarity of a claim term. *Cf. General Dynamics Land Sys., Inc. v. Cline*, 540 U.S. 581, 596 (2004). Especially for language amended or added during examination, the prosecution history often provides the relevant context. *See Pet.* 23. By presumptively disregarding the amendment history, the Federal Circuit's precedents make it more difficult to determine a term's meaning in context - undermining the public-notice function of claims, producing over-broad claim constructions, and unnecessarily calling the validity of some claims into question under *Nautilus*.

\* \* \*



## **Vederi at the Naples Conference: Festo at the Supreme Court Déjà vu**

The case for *certiorari* is simple. There is a clear conflict between this Court's precedents and the Federal Circuit's, the issue is crisp and straightforward in light of this Court's prior rulings, and the issue is a frequently recurring one with considerable practical importance. The Court has reviewed a number of patent-law issues in recent years. The question presented here is no less deserving of the Court's review.