

No.

IN THE
Supreme Court of the United States

TEVA PHARMACEUTICALS USA, INC., ET AL.,
Petitioners,

v.

SANDOZ, INC., ET AL.,
Respondents.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Rule 52(a) of the Federal Rules of Civil Procedure provides that in matters tried to a district court, the court's "[f]indings of fact . . . must not be set aside unless clearly erroneous."

The question presented is as follows:

Whether a district court's factual finding in support of its construction of a patent claim term may be reviewed *de novo*, as the Federal Circuit requires (and as the panel explicitly did in this case), or only for clear error, as Rule 52(a) requires.

PARTIES TO THE PROCEEDING

Petitioners are Teva Pharmaceuticals USA, Inc., Teva Pharmaceutical Industries Ltd., Teva Neuroscience, Inc., and Yeda Research and Development Co. Ltd. All were plaintiffs-appellees below.

Respondents are Sandoz Inc., Momenta Pharmaceuticals Inc., Mylan Pharmaceuticals Inc., Mylan Inc., and Natco Pharma Ltd. All were defendants-appellants below.

Sandoz International GmbH and Novartis AG were defendants in the district court, but were not parties in the court of appeals.

RULE 29.6 STATEMENT

The parent companies of Teva Pharmaceuticals USA, Inc. are: Orvet UK Unlimited, Teva Pharmaceutical Holdings Cooperative U.A., Ivax LLC (f/k/a IVAX Corporation), Teva Pharmaceuticals Europe, B.V., and Teva Pharmaceutical Industries Ltd.; Teva Pharmaceutical Industries Ltd. is the only publicly traded company that owns 10% or more of Teva Pharmaceuticals USA, Inc.

Teva Pharmaceutical Industries Ltd. has no parent company, and no publicly traded company owns 10% or more of Teva Pharmaceutical Industries Ltd.

The parent companies of Teva Neuroscience, Inc. are: IVAX Corporation, Teva Pharmaceuticals USA, Inc., Orvet UK Unlimited, Teva Pharmaceutical Holdings Cooperative U.A., Ivax LLC (f/k/a IVAX Corporation), Teva Pharmaceuticals Europe, B.V., and Teva Pharmaceutical Industries Ltd.; Teva Pharmaceutical Industries Ltd. is the only publicly

traded company that owns 10% or more of Teva Neuroscience, Inc.

Yeda Research and Development Co. Ltd. is wholly owned by Yeda Trust; no publicly traded company owns 10% or more of Yeda Research and Development Co. Ltd.

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PETITION FOR A WRIT OF CERTIORARI

Petitioners Teva Pharmaceuticals USA, Inc., Teva Pharmaceutical Industries Ltd., Teva Neuroscience, Inc., and Yeda Research and Development Co. Ltd. (collectively “Teva”), respectfully petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The decision of the court of appeals (Pet. App. 1a-25a) is reported at 723 F.3d 1363. The district court’s claim-construction decision (Pet. App. 26a-72a) is reported at 810 F. Supp. 2d 578. A previous decision of the district court denying Sandoz’s motion for summary judgment is reported at 749 F. Supp. 2d 130.¹ The district court’s post-trial findings of fact and conclusions of law are reported at 876 F. Supp. 2d 295.

JURISDICTION

The judgment of the court of appeals was entered on July 26, 2013. Pet. App. 2a. A petition for rehearing was denied on October 18, 2013. *Id.* at 84a-85a. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

¹ This petition uses “Sandoz” to denote respondents Sandoz Inc. and Momenta Pharmaceuticals Inc., and “Mylan” to denote respondents Mylan Pharmaceuticals Inc., Mylan Inc., and Natco Pharma Ltd.

STATUTORY PROVISION INVOLVED

Rule 52 of the Federal Rules of Civil Procedure provides in pertinent part:

Findings and conclusions by the court; judgment on partial findings

(a) FINDINGS AND CONCLUSIONS.

(1) *In General.* In an action tried on the facts without a jury or with an advisory jury, the court must find the facts specially and state its conclusions of law separately. The findings and conclusions may be stated on the record after the close of the evidence or may appear in an opinion or a memorandum of decision filed by the court. Judgment must be entered under Rule 58.

* * * *

(6) *Setting Aside the Findings.* Findings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous, and the reviewing court must give due regard to the trial court's opportunity to judge the witnesses' credibility.

INTRODUCTION

This case concerns the Federal Circuit's longstanding unwillingness to apply in patent cases the standard of review that this Court has prescribed in the Federal Rules of Civil Procedure. "Findings of fact" made by a district court after a bench trial "must not be set aside unless clearly erroneous." Fed. R. Civ. P. 52(a)(6). That standard applies whether those findings are "based on oral or other evidence," such as documentary or written evidence. *Id.* But the Federal Circuit will not apply that standard when

the findings are made in the course of patent interpretation. It reserves all such questions, no matter how fact-intensive, for itself to review *de novo*.

The Federal Circuit's disregard of the Federal Rules goes to a truly foundational question of patent litigation. District courts in patent litigation must construe the claims of a patent before trial—or even summary judgment proceedings—can take place. Both infringement and invalidity often depend on how the patent claims are construed. Yet no matter how much scientific evidence the district court hears, and no matter how fact-based its findings, the Federal Circuit will pay them no deference. That practice is contrary to Rule 52(a) and to this Court's decisions interpreting that Rule. It makes patent litigation longer, more expensive, and less predictable. And it asks appellate judges to make fact-intensive judgments that this Court has wisely left to trial judges. A growing number of Federal Circuit judges have concluded that the standard of review their court applies is flawed or simply wrong.² But thus far a majority of the Federal Circuit has insisted that this Court's decisions compel *de novo* review.

This case illustrates the danger of reviewing facts *de novo*. In this case the district court made express findings about certain historical and scientific facts, pertaining to the knowledge and understanding that

² See, e.g., *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d 1369, 1373 (Fed. Cir. 2011) (O'Malley, J., dissenting from denial of rehearing en banc); *id.* (Moore, J., dissenting from denial of rehearing en banc); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039, 1040 (Fed. Cir. 2006) (Michel, C.J., dissenting from denial of rehearing en banc); *id.* at 1044 (Rader, J., dissenting from denial of rehearing en banc); *id.* at 1046 (Moore, J., dissenting from denial of rehearing en banc).

an expert in the field of polypeptide chemistry would have had in 1994. Those findings, in turn, guided the district court's interpretation of the key term of Teva's patents. The Federal Circuit did not review those findings for clear error; it reviewed them *de novo*, disagreed with them, and as a result construed the patent in a way that invalidated it. The standard of review determined the outcome.

This case therefore gives the Court an ideal opportunity to correct an important and fundamental error. The divisions within the Federal Circuit on this issue are deep and basic, stemming from disagreement over how to read this Court's decisions. While the Federal Circuit has tried to resolve it several times, and has another case before it presenting the question, a definitive answer—which the patent system urgently needs—can come only from this Court. If this Court does not address the issue in a case already pending on the merits this Term, it should not wait for another vehicle that may never arrive. The issue is squarely presented here, and the Court should take this opportunity to resolve it.

STATEMENT

A. The Federal Circuit Reviews Factual Findings *De Novo* When They Are Made During Claim Construction

The current system of reviewing factual issues *de novo* dates back to 1995. The en banc Federal Circuit acknowledged that it had previously been inconsistent: sometimes stating that claim construction may encompass factual issues, sometimes treating claim construction as a pure question of law. Henceforth, the court of appeals stated, it would treat eve-

ry aspect of claim construction, even the determination of historical facts, as a purely legal inquiry. *Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 976-77, 979 (Fed. Cir. 1995) (en banc). The Federal Circuit thought that its decision followed from various decisions of this Court, decided long before the adoption of the Federal Rules of Civil Procedure. The court of appeals read those cases as holding “that the construction of a patent claim is a matter of law exclusively for the court.” *Id.* at 977. And because it saw “claim construction [a]s a matter of law,” the court thought that factual findings underlying claim construction must be “reviewed *de novo* on appeal.” *Id.* at 979. Several judges wrote separately to disagree with that standard of review. *Id.* at 989-98 (Mayer, J., concurring in the judgment); *id.* at 998-99 (Rader, J., concurring in the judgment); *id.* at 999-1026 (Newman, J., dissenting).

This Court granted certiorari in *Markman*, but did not address the standard of review for factual findings *by a district judge*. Instead, the Court examined whether the Seventh Amendment requires that factual issues underlying claim construction be resolved *by a jury*. See Pet. for Cert. at i, *Markman v. Westview Instruments, Inc.* (No. 95-26). The Court held that the Seventh Amendment imposes no such jury-trial requirement in this context. *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370 (1996). But in answering the judge/jury question, it did *not* rule that claim construction is a question of law for all purposes. Rather, the Court noted that claim construction is “a mongrel practice,” and it acknowledged that practice’s “evidentiary underpinnings” even while holding that trial judges would do

a better job than juries of resolving those evidentiary issues in patent cases. *Id.* at 378, 390.

When it revisited the standard-of-review question, the en banc Federal Circuit concluded that it was doubly bound to review “any allegedly fact-based questions relating to claim construction” *de novo*. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc). First, the court of appeals thought that this Court’s decision in *Markman II* “conclusively and repeatedly” held that claim construction is purely legal. *Id.* at 1455-56. Second, although the court acknowledged that this Court “did not discuss the appellate standard of review,” the court thought its own decision in *Markman I* was equally binding on that subject. *Id.* at 1456. Several judges again dissented vigorously.

The Federal Circuit took up the standard of review en banc a third time in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). This time, however, after receiving briefing and argument on the question whether deference is ever due to “any aspect of trial court claim construction rulings,” the court of appeals “decided not to address that issue” and left its previous precedent, in *Markman I* and *Cybor*, “undisturbed.” *Id.* at 1328. Two judges dissented.

Thus, all three en banc decisions on this subject over the last nineteen years produced the same result: in the context of claim construction, the Federal Circuit continues to review *de novo* even quintessentially factual rulings, such as findings reached after “live hearings with argument and testimony, sometimes covering several days.” *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d

1369, 1374 (Fed. Cir. 2011) (O'Malley, J., dissenting from denial of rehearing en banc).

B. In This Case, The Federal Circuit Held Patent Claims “Insolubly Ambiguous” Despite A Trial-Court Finding That Skilled Artisans Would Understand Them

Teva is a pharmaceutical company that markets Copaxone[®], a drug widely prescribed for the treatment of multiple sclerosis. Respondents are generic drug companies that sought FDA approval to market generic formulations of Copaxone[®]. Teva brought patent-infringement actions, later consolidated, against respondents in the Southern District of New York, contending that respondents' generic products would infringe various patents held by Teva.

1. The Patents Claim An Active Ingredient With Specific Molecular-Weight Characteristics

The active drug ingredient in Copaxone[®], referred to as “copolymer-1,” is a mixture of many different polypeptide chains made by joining together four amino acids in essentially random fashion. The individual polypeptide molecules that make up copolymer-1 vary in length, amino-acid sequence, and molecular weight. The patents in this case all reflect the inventors' discovery that, contrary to the prevailing understanding at the time, copolymer-1 promised therapeutic effectiveness against multiple sclerosis with an improved side-effect profile when the mixture contained polypeptide molecules of relatively *low* molecular weight.

The patent claims therefore refer to copolymer-1 with particular molecular weight characteristics. The claims at issue here describe the invention with reference to the *average* molecular weight of the polypeptide chains constituting the particular sample of copolymer-1. *E.g.*, Pet. App. 5a (quoting a claim that refers to “a molecular weight of about 5 to 9 kilodaltons”).³ The key question in the courts below was the meaning of “average molecular weight.”

Several of the patents-in-suit contain the disputed claim term. The claim most relevant for this Court’s purposes is the single claim of U.S. Patent No. 5,800,808, the last of the patents-in-suit to expire. Contrary to the Federal Circuit’s incorrect statement (Pet. App. 24a n.5), the ’808 patent expires in September 2015. *See id.* at 80a-81a.

2. Relying On Expert Evidence, The District Court Finds That The Patent Claims Are Not “Insolubly Ambiguous”

Respondents asserted various invalidity defenses. As relevant here, they contended that the term “average molecular weight” was “insolubly ambiguous,” and that the patent claims containing that phrase were invalid for failure to satisfy the Patent Act’s requirement that a patent be “definite” enough to be understood by “one skilled in the art.” *E.g.*, *Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001); *see* 35 U.S.C. § 112 ¶ 2

³ Some of what the panel called the “Group I” claims refer to “average molecular weight” and others to copolymer-1 having “a molecular weight,” but it is undisputed that in the context of the Group I claims, “molecular weight” refers to *average* molecular weight. *See, e.g.*, Pet. App. 41a, 62a n.10.

(2006).⁴ At the time of the invention, there were several methods of characterizing the average molecular weight of a sample of polypeptide molecules known to persons of ordinary skill in the art. *See* Pet. App. 4a-5a, 41a. Because the patent did not expressly specify one of those methods, respondents contended that a person of ordinary skill in the art could not discern which method the inventors meant.

The parties all recognized that the question turned on how a person of ordinary skill in the art would understand the term “average molecular weight” at the time of the invention. As the district court found and respondents’ own experts largely agreed, “[t]he level of ordinary skill in the art in this case is very high.” 876 F. Supp. 2d at 328-29. The parties submitted extensive evidence in the form of expert declarations, party documents, and deposition testimony.

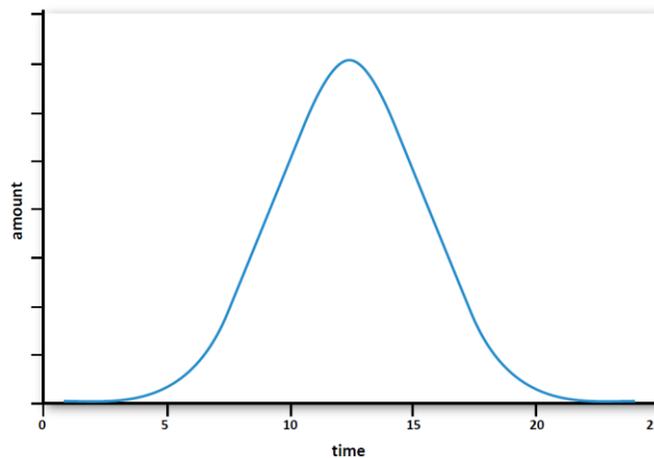
The district court construed the claims and rejected respondents’ contention that “average molecular weight” was insolubly ambiguous. Pet. App. 40a-62a. The court made extensive factual findings about what a person of ordinary skill in the art would have discerned from the patents and their prosecution histories. In making those findings, the district court found critically important the extensive testimony of Teva’s expert witness, Dr. Gregory A. Grant. *See id.* at 42a-45a, 48a-50a, 52a.

⁴ Congress amended Section 112 in 2011 in ways not material here. The amendments do not apply to this case because it involves patents issued before September 16, 2012. *See* 35 U.S.C. § 112 note (Supp. V 2011). References in this petition to Title 35 are to the pre-2011 version.

While the patents did not specify which particular method for calculating average molecular weight was to be used, they *did* indicate that average molecular weight was to be determined using size exclusion chromatography (“SEC”) technology to measure the proportions of a sample of copolymer-1 made up of polypeptide molecules of particular molecular weights. Pet. App. 42a-43a. The specified use of SEC technology was crucial to Dr. Grant’s analysis.

SEC technology separates molecules in a sample on the basis of their size by passing the sample through a column filled with gel particles. Larger (and therefore heavier) molecules bypass the gel particles and thus travel through the column more quickly. By measuring the amount of the sample passing through the column at particular times, the user can determine the distribution of molecules in the sample. *Id.* at 107a-111a. By plotting those amounts against time, the user derives a “chromatogram,” a graph that represents the amount of material that exits the column over time:

Chromatogram



C.A. App. 56292. The molecular weight associated with the highest point on a chromatogram reflects the “peak average molecular weight” or “M_p”—the molecular weight of the molecules present in the sample in greatest abundance.

M_p is the *only* expression of average molecular weight that can be derived directly from the chromatogram without the need for further calculations based on the underlying data. And none of the patents specifies any such further calculations. Therefore, Dr. Grant testified, a person of ordinary skill in the art would conclude that in the context of these patents, average molecular weight means M_p. To determine the average molecular weight with reference to other methods identified by respondents would require data manipulations that are nowhere suggested by the patents. *Id.* at 125a. Indeed, Dr. Grant pointed out, during the prosecution of one of the patents-in-suit Teva had stated unequivocally that average molecular weight was peak molecular weight. *Id.* at 129a. That was “the only statement that defined [average molecular weight] directly” in the prosecution history. *Id.* at 52a.

Respondents countered with testimony they had elicited when they cross-examined Dr. Grant at deposition. One set of respondents also submitted its own contrary expert testimony. They pointed to what they characterized as inconsistent statements made during the prosecution of other patents and anomalies in the figures set forth in the patents themselves. Pet. App. 48a-51a. But Dr. Grant addressed every one of these points. *See id.* at 48a-52a.

The District Court expressly “credited” Dr. Grant’s explanation of the inferences that a Ph.D. experi-

enced in characterizing synthetic peptides would and would not have drawn from the patents and their file histories at the time of the invention, based on his or her extensive scientific knowledge. Pet. App. 49a, 50a, 52a. Based on that testimony, the District Court found that “average molecular weight” meant “peak molecular weight,” and denied respondents’ motions for summary judgment that the patents were indefinite. *Id.* at 62a.

Respondents proffered no additional evidence on the meaning of “average molecular weight” at the trial. Finding that respondents had failed to prove their indefiniteness defense by clear and convincing evidence, the district court entered judgment that the patents were not invalid. Pet. App. 76a-78a. The district court also held that respondents’ generic products would infringe the patents, and it enjoined respondents from committing any such infringement during the remaining life of the patents. *Id.* at 76a-81a.

3. The Federal Circuit Reads The Patent Claims *De Novo* And Finds Them Insolubly Ambiguous

On appeal, respondents made no attempt to argue that the District Court clearly erred in finding that a person of ordinary skill in the art would read the patent claims to refer to “peak average molecular weight.” Rather, they asked the Federal Circuit to consider *de novo* whether the patent claims were insolubly ambiguous.

The court of appeals reversed the district court and held the claims containing the term “average molecu-

lar weight” invalid as indefinite. Pet. App. 1a-25a.⁵ The court expressly stated that it would not defer to the district court’s factual findings: “On *de novo* review of the district court’s indefiniteness holding, we conclude that Dr. Grant’s testimony does not save [the pertinent] claims from indefiniteness.” *Id.* at 10a; *accord id.* at 7a. Less persuaded by Dr. Grant’s testimony than the district court, the panel concluded that a person of ordinary skill would be unable to discern the meaning of “average molecular weight” as used in the patents-in-suit.

Although both Dr. Grant and the district court had dealt with every one of the grounds on which the panel disagreed with Dr. Grant’s reading of the patent, the panel gave no weight to the district court’s contrary findings.

- The panel emphasized that other measures of average molecular weight— M_n and M_w —“can also be obtained from the data generated by the SEC method after some calculations.” Pet. App. 10a. The panel did not acknowledge the key basis for the district court’s finding—that the patent disclosed no such calculations, and M_p was the only measure that could be read directly from a chromatogram “*without* any further calculation.” *Id.* at 43a, 48a (emphasis added).
- The panel found significant that the value the patent assigned to average molecular

⁵ The court of appeals rejected respondents’ challenges to the infringement finding and their arguments that the remaining claims were invalid (except that the court miscategorized four claims as Group I claims rather than valid Group II claims). See Pet. App. 3a nn.1-2, 12a-24a; Pet. for Reh’g 13-15.

weight, in Example 1, was not at the peak of the graph in the patent, Figure 1. *Id.* at 10a-11a. The panel did not acknowledge or refute the District Court’s finding, based on Dr. Grant’s testimony, that the seeming discrepancy was merely a technical artifact: “the process of transferring the data from the chromatogram would likely cause the peak on each curve to shift slightly.” *Id.* at 45a (quoting *id.* at 127a).

- The panel considered a statement in the prosecution history to be inconsistent with Teva’s position. *Id.* at 9a-10a. But the panel did not acknowledge the District Court’s finding, based on Dr. Grant’s testimony, that no skilled artisan would have credited that statement as a possible expression of the meaning of “average molecular weight,” because any skilled artisan would have known as a scientific matter that the statement was simply erroneous. *Id.* at 52a (citing *id.* at 128a-29a).

4. The Federal Circuit Declines To Hold Its Mandate.

While the appeal was under submission, the Federal Circuit ordered rehearing en banc in *Lighting Ballast Control LLC v. Philips Electronics North America Corp.*, 500 F. App’x 951 (2013) (No. 2012-1014). The question presented in *Lighting Ballast* is whether the Federal Circuit should overrule its precedent requiring *de novo* review of findings of historical fact when they are made in connection with claim construction.

Teva sought rehearing, noting that this case presented the same question already being considered en banc. Teva suggested deferring action or holding the mandate until *Lighting Ballast* is decided. Pet. for Reh'g 12-13. The court of appeals denied rehearing, Pet. App. 84a, denied a stay of the mandate, *id.* at 84a-85a, and issued its mandate the same day. The Circuit Justice declined to recall the mandate. No. 13A458.

REASONS FOR GRANTING THE WRIT

Claim construction takes place in virtually every patent litigation, and is “the single most important event” during each such case, because it “is often the difference between infringement and non-infringement, or validity and invalidity.” *Retractable*, 659 F.3d at 1370 (Moore, J., joined by Rader, C.J., dissenting from denial of rehearing en banc). The standard by which the national court for patent appeals reviews the factual findings made by district courts in the course of those critical claim-construction decisions is plainly a question that should be settled. And Rule 52(a)(6) should settle it: “Findings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous”

But the proper standard of review is anything but settled. For more than 15 years, a majority of the Federal Circuit has declined to apply Rule 52(a)(6) and instead has applied the fundamentally flawed view that it must review all aspects of district-court claim constructions *de novo*, even the underlying factual findings. Three times since 1995, the Federal Circuit has ruled that it reviews facts found in claim

construction *de novo*. Each time, a determined minority has continued to object. And all the while, the Federal Circuit's wrongheaded rule has imposed billions of dollars in litigation costs on patentees and infringement defendants alike, who must litigate to final judgment in district court, only to be sent back for new proceedings once the Federal Circuit reverses the claim construction based on its own reading of the underlying factual record. It is time for this Court to bring the debate to a close and hold that factual findings in patent cases are entitled to the same measure of deference on appeal as factual findings in all other cases.

This case presents an excellent vehicle to decide that eminently cert-worthy question now. The flaws of *de novo* review are on prominent display in this case: the district court took evidence from all sides and devoted considerable time to understanding the science and the invention. The court of appeals undid that effort based purely on its own oversimplified reading of the record *de novo*. This case well illustrates why the detailed work of deciding the facts belongs to the district court.

I. The Federal Circuit's *De Novo* Approach Ignores The Applicable Federal Rule And Misapplies This Court's Precedent

The standard of review of findings of historical fact, like the ones the district court made here, is not up to the Federal Circuit. This Court and Congress have already prescribed it: since the merger of law and equity, every federal appellate court has been barred from setting aside “[f]indings of fact” unless they are “clearly erroneous.” Fed. R. Civ. P. 52(a)(6).

The Federal Circuit has never attempted to square its precedent with the Rule, which is sufficient to dispose of the standard-of-review question here. That is just the sort of incorrect holding by the Federal Circuit—asserting that a generally applicable principle of law does not apply in patent cases—that this Court has often granted certiorari to correct.⁶

Indeed, the question presented here is, if anything, *more* fundamental and *more* important than many of those the Court has reviewed from the Federal Circuit in recent Terms. Almost *every* patent-infringement case involves claim construction, and the standard of review potentially affects almost every patent appeal from a district court to the Federal Circuit—more than 400 cases per year, many of them with multimillion- or billion-dollar sums potentially at stake.⁷

A. Rule 52(a) Applies To All Bench Trials

Rule 52(a) was drafted to apply to “*all* actions tried upon the facts without a jury.” *United States v. U.S. Gypsum Co.*, 333 U.S. 364, 394-95 (1948) (emphasis added). The bench trial and claim-construction proceedings in this case were no exception. Indeed, as this Court has said, “Rule 52(a) . . . *does not make exceptions* or purport to exclude certain categories of factual findings from the obligation of a court of appeals to accept a district court’s findings unless clear-

⁶ See, e.g., *eBay v. MercExchange, LLC*, 547 U.S. 388, 394 (2006) (general principles governing injunctive relief in federal courts apply in patent cases); *Dickinson v. Zurko*, 527 U.S. 150, 165 (1999) (general principles governing review of agency actions apply to review of Patent Office decisions).

⁷ See <http://www.cafc.uscourts.gov/images/stories/Statistics/patent%20filings%20historical.pdf>.

ly erroneous.” *Pullman-Standard Co. v. Swint*, 456 U.S. 273, 287 (1982) (emphasis added). This Court has the power to make such exceptions for patent cases if it chooses; so does Congress. Neither has done so.

In its two leading decisions, *Markman I* and *Cybor*, the court did not even cite Rule 52(a), even though separate opinions cogently pointed out the conflict between that Rule and the court’s standard of review. *Markman I*, 52 F.3d at 991 (Mayer, J., concurring in the judgment); *see also Cybor*, 138 F.3d at 1464 (Mayer, J., concurring in the judgment). Rather, the Federal Circuit has brushed off the restrictions on appellate review of factfinding by asserting that there *is* no factfinding in claim construction. *See, e.g., Cybor*, 138 F.3d at 1456 (“[A]s a purely legal question, we review claim construction *de novo* on appeal including any allegedly fact-based questions relating to claim construction.”). The Federal Circuit insists that factfinding has no place in “document construction.” *Id.* (quoting *Markman II*, 517 U.S. at 389). Respondents have echoed that position as well. *See Resps.’ Opp. to Stay Appl.*, No. 13A458, at 10-11. That view is plainly mistaken.

B. Patent Claim Construction Entails Finding Historical Facts

Judges construing patents often must establish a baseline of scientific, historical, or technical facts before beginning to interpret the document, precisely because patents are not written primarily for judges or lawyers. The principal function of a patent’s *claims* is to provide public notice as to what technology may not be practiced without a license from the

patentee. *See, e.g., Markman II*, 517 U.S. at 373; *Universal Oil Prods. Co. v. Globe Oil & Ref. Co.*, 322 U.S. 471, 484 (1944). These public disclosures are specifically directed to practitioners of the relevant scientific art. Accordingly, understanding and construing the patent requires understanding the perspective of a person of ordinary skill in the relevant art, at the time the patent was submitted.

A generalist judge seeking to understand and apply the skilled artisan's perspective must find *as a matter of fact* what the artisan knows. In this case, for example, the judge needed to consider: What was the level of ordinary skill in the art at the relevant time? *See, e.g., Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (describing “the level of ordinary skill in the pertinent art” as “basic factual inquir[y]”). (In this case, it required a Ph.D. and significant experience in the characterization of synthetic peptides. 876 F. Supp. 2d at 328-29.) What did a skilled artisan know about the different ways to characterize the average molecular weight of polypeptide mixtures? Which of those measures may be read directly from a chromatogram, and which require further mathematical analysis?

These are manifestly questions of fact, not law. Similar questions of fact arise in most patent cases. Frequently the parties will contest these facts and require the trial judge to weigh conflicting evidence and assess the credibility of witnesses, often scientists, who disagree with each other.

This Court has long recognized that the answers to questions like these are factual findings, even when they are made in order to help interpret a legal document. In a contract case, for example, “extrinsic ev-

idence may be necessary to determine the meaning of words appearing in the document. This is true where technical words or phrases not commonly understood are employed” *Great N. Ry. Co. v. Merchants’ Elevator Co.*, 259 U.S. 285, 291-92 (1922). The construction of a contract is undoubtedly a question of law. But “the function of construction is necessarily preceded by the determination of the matter of fact.” *Id.* at 292.

The same is true in patent cases. This Court in *Markman II* recognized that claim construction is often a “mongrel practice (like construing a term of art following receipt of evidence).” 517 U.S. at 378. The decision in *Markman II* held that the various aspects of that “mongrel practice” were best performed by the district court, not the jury. But that holding says nothing about the role of the *appellate* court. The Federal Rule “easily” answers the latter question: when the court makes findings about the “evidentiary underpinnings” of claim construction, *id.* at 390, Rule 52(a)(6) requires deferential review. U.S. Amicus Br. at 9, *Lighting Ballast*, No. 2012-1014 (Fed. Cir. June 7, 2013).

Allowing district courts to play that role capitalizes on the “institutional advantages” that district courts have over appellate courts in this context. *Cybor*, 138 F.3d at 1478 (separate opinion of Rader, J.). “Trial judges can spend hundreds of hours reading and rereading all kinds of source material, receiving tutorials on technology from leading scientists, formally questioning technical experts and testing their understanding against that of various experts, [and] examining on site the operation of the principles of the claimed invention” *Id.* at 1477. By contrast,

“[a]n appellate court has none of these advantages”: it holds parties to “strict time and page limits in oral and written presentations,” and it receives only “a sterile written record [that] can never convey all the nuances and intangibles of the decisional process.” *Id.* at 1477-78. Where district courts can spend “several days,” an appellate court has only “mere minutes . . . to devote to live exchanges with counsel.” *Retractable*, 659 F.3d at 1374 (O’Malley, J., dissenting from denial of rehearing en banc).

C. A Growing Consensus Is Calling For Factual Findings In Claim Construction To Receive Due Deference

Numerous members of the Federal Circuit have repeatedly called for the court to overrule its practice of reviewing factual findings *de novo*. See pp. 4-7 & n.2, *supra*. The federal government has recently done the same. So have numerous other amici in *Lighting Ballast*. That broad agreement that the Federal Circuit is wrong underscores the need for review by this Court.

Now-Chief Judge Rader of the Federal Circuit has previously explained how the Federal Circuit’s *de novo* treatment of factual findings aggravates the already-high cost of patent litigation. “The meaning of a claim is not certain (and the parties are not prepared to settle) until nearly the last step in the process—decision by the . . . Federal Circuit.” *Cybor*, 138 F.3d at 1476 (separate opinion of Rader, J.). In turn, “the focus shifts from litigating for the correct claim construction to preserving ways to compel reversal on appeal,” and “the uncertainty, cost, and duration of patent litigation only increase.” *Id.* Be-

cause patent litigation already “costs upwards of \$15 billion per year to patentees and accused infringers,” J. Jonas Anderson, *Secret Inventions*, 26 Berkeley Tech. L.J. 917, 952 (2011), the unnecessary relitigation that the Federal Circuit’s rule requires potentially costs billions.

De novo review is all the more pernicious because it generally occurs late in the process, after discovery and trial. The Federal Circuit has the authority to entertain interlocutory appeals where (*inter alia*) reversal may “materially advance the ultimate termination of the litigation”—for example, where reversing the claim construction would leave no need for a trial. 28 U.S.C. § 1292(b) (2006); *see id.* § 1292(c)(1). But in its first 27 years, the Federal Circuit apparently granted interlocutory review of claim construction only *once*. *See Portney v. CIBA Vision Corp.*, 401 F. App’x 526, 529 (Fed. Cir. 2010) (identifying a “peculiar” 2007 case as “the only occasion in which” the Federal Circuit entertained an interlocutory claim-construction appeal).

As a result, of the large number of reversals the Federal Circuit hands down, many come after a full trial on the merits. And many of those cases require a *new* trial under a new claim construction. Not only must the litigants try the case before appealing, the *de novo* standard of review means a higher likelihood that they will have to try it a second time. *Cf., e.g., AFG Indus., Inc. v. Cardinal IG Co., Inc.*, 375 F.3d 1367, 1374 (Fed. Cir. 2004) (Newman, J., dissenting) (noting that the court was remanding “for the third time on the issue of claim construction”).

Given this question’s fundamental impact on patent litigation, the Solicitor General previously ad-

vised this Court that “[i]n an appropriate case, this Court’s intervention might be warranted to determine the proper standard of appellate review” where claim construction rests on the resolution of factual disputes. U.S. Amicus Br. at 17, *Retractable*, No. 11-1154 (Nov. 28, 2012); *see id.* at 21. The Solicitor General explained that the Federal Circuit’s rule is based on a misreading of this Court’s decision in *Markman II*. As he noted, “[t]he Federal Circuit’s decision in *Cybor* does not identify any reason that [factual findings underlying claim construction] should not be given the deference ordinarily required by [Rule] 52(a).” *Id.* at 20-21. In a subsequent brief in *Lighting Ballast*, the government expressly called for the Federal Circuit to overrule its precedent holding that factual findings must be reviewed *de novo*.⁸

The government, the dissenting Federal Circuit judges, and their fellow critics of current Federal Circuit precedent have a common theme: a “*clear example*”—perhaps the clearest—“of a factual finding is the historical meaning of a claim term to one of ordinary skill in the art at the time of the invention.” U.S. Amicus Br. at 15, *Lighting Ballast*, *supra* (emphasis added); *accord, e.g., Cybor*, 138 F.3d at 1464 (Mayer, J., concurring in the judgment). That is precisely the sort of finding that the district court made—and the Federal Circuit upset—in this case.

For that reason, this is the “appropriate case” that the Solicitor General urged this Court to await. The standard-of-review question is squarely presented,

⁸ The government is joined in that position by numerous other amici, including the American Bar Association, the American Intellectual Property Law Association, and the Federal Circuit Bar Association.

and as the Solicitor General recognized, that question meets the standards for certiorari.

II. This Case Is An Ideal Vehicle Allowing This Court To Address This Critical Issue Without Further Delay

A. The District Court’s Findings Were Amply Supported And Would Have Been Outcome-Determinative

The last high-profile case raising the standard-of-review question, *Retractable*, unfortunately turned out not to be a proper vehicle, because the district court made no findings and took no expert or documentary evidence. U.S. Amicus Br. at 21-22, *Retractable*, *supra*. In fact, there was nothing on which to base findings except “the legal arguments of counsel.” *Id.* at 18. The standard of review for factual findings therefore did not matter.

In this case, by contrast, that issue is presented cleanly—indeed, quite starkly. The district court found as a factual matter that a person of skill in the art would know what “average molecular weight” meant as used in the patents. Crediting that finding would mean the patents were not hopelessly indefinite—and would reverse the outcome of this case. But three generalist appellate judges refused to credit it, simply because they disagreed with it—for reasons that the district court’s findings anticipated, addressed, and refuted. On clear-error review, such disagreement plainly would not have been enough to justify reversal. Respondents prevailed purely because, as the Federal Circuit stated twice, it reviewed the finding “*de novo*.” Pet. App. 7a, 10a. That standard of review—and nothing else—allowed

the Federal Circuit to decide for itself that highly trained chemists familiar with peptide synthesis would not have been able to decipher the meaning of this patent.

The district court was quite clear about the difference between factual findings based on expert evidence, which are entitled to deference under Rule 52(a)(6), and legal arguments by lawyers. The court observed that Sandoz relied heavily “on unsubstantiated attorney-argument,” which could not outweigh the expert evidence Teva submitted. Pet. App. 49a-50a. For its part, Mylan submitted expert evidence, which was simply less persuasive than Teva’s.

Teva’s expert, Dr. Grant, repeatedly explained in detail what a “person of skill in the art would [or would not] have understood” by particular terms used in the patents. *Id.* at 92a-93a, 125a-130a. He also explained how a person of skill in the art would have understood the statement in the prosecution history on which the panel relied. *Id.* at 128a-129a.

The district court made findings crediting Dr. Grant’s testimony—including, where necessary, over the testimony of Mylan’s expert. *See* pp. 11-12, *supra*; Pet. App. 48a-50a, 52a, 55a-57a. In fact, when the court of appeals relied on the fact that the peaks of the curves in Figure 1 did not precisely correspond to the average-molecular-weight figures in Example 1, it was making precisely the same point that Mylan introduced *through its expert*. *See id.* at 10a-11a, 49a. The district court credited Dr. Grant’s explanation of that minor discrepancy as a technical artifact. *Id.* at 49a. In reversing, the court of appeals was simply rejecting the district court’s factfinding—

without offering *any* reason why Dr. Grant or the district court was clearly wrong.

Respondents have contended that this case presents an unsuitable context in which to consider applying Rule 52(a)(6), because Dr. Grant did not testify in person. For that reason, respondents have argued, the district court’s findings based on his testimony are not entitled to deference. Resps.’ Opp. to Stay Appl. 12-13 (“The court of appeal was in as good a position as the district court to review [the expert declarations].”). But this Court has squarely rejected that exact argument in the context of Rule 52(a)(6), through both case law and rulemaking. The plain text of the Rule states that the clear-error standard of review applies with full force to all “findings of fact, whether based on oral *or other* evidence.” Fed. R. Civ. P. 52(a)(6) (emphasis added). That amendment came about precisely because some courts of appeals concluded that—just as respondents have argued—they were in “as good a position as the trial court to review a purely documentary record,” Fed. R. Civ. P. 52 advisory committee’s note (1985). This Court amended the Federal Rules to disapprove those decisions and make clear that the clear-error standard of review is *not* limited to findings based on oral testimony. *Id.*; accord *Anderson v. City of Bessemer City*, 470 U.S. 564, 574 (1985) (“The rationale for deference to the original finder of fact is not limited to the superiority of the trial judge’s position to make determinations of credibility.”). In-person credibility determinations are to be paid “special deference,” but that “does not alter” the Rule’s basic command: when a district court makes a factual finding, it is reviewed for clear error, no matter the

kind of case. *Id.* (citing *Pullman-Standard*, 456 U.S. at 287.

Thus, there is no need for this Court to wait and decide the question presented in the context of some future case involving oral testimony. Indeed, the case the Federal Circuit is now considering en banc, *Lighting Ballast*, also involves an expert declaration—a much less detailed submission than Dr. Grant’s.⁹ Rule 52(a)(6) does not permit a rule that defers to oral testimony but allows *de novo* review of documentary evidence. There is therefore no reason to wait for a case involving oral testimony to decide the basic question of *de novo* versus clear-error review.

B. This Court Should Not Delay Review Any Longer

This Court might well have taken up this question two Terms ago if the *Retractable* case had proved to be a suitable vehicle. *See* U.S. Amicus Br. at 21, *Retractable*, *supra*. Respondents cannot dispute that the question continues to be crucially important to numerous facets of patent litigation. And the holding of *Cybor* is no more correct today than it was in 2012.

Rather than dispute the importance of the question presented, respondents have contended that the final

⁹ *See* En Banc Br. of Deft.-Appellant at 55-56, *Lighting Ballast*, No. 2012-1014 (Fed. Cir. May 20, 2013) (“[T]he district court did not hold a claim construction hearing . . . or evaluate the live testimony of any witnesses. The record consisted of the patent, the prosecution history, [an expert]’s nine page-long declaration, and a few excerpts from [an inventor]’s deposition transcript.”) (citations omitted).

answer should come from the Federal Circuit, in *Lighting Ballast*, rather than this Court. See, e.g., Resps.’ Opp. to Stay Appl. 10-11. Respondents have characterized the question as implicating only an “internal division” or “internal difficulties” within the Federal Circuit. *Id.* (quoting *Wisniewski v. United States*, 353 U.S. 901, 902 (1957)). So, they contend, the Federal Circuit’s decision to rehear *Lighting Ballast* en banc signals that a definitive resolution to the matter is at hand, and this Court should not step in. That argument carries no weight.¹⁰ Quite simply, a decision by today’s Federal Circuit judges, no matter what it may be, cannot provide a sure and certain answer to this question. Only this Court can do that, not only because the question is so important, but because the answer depends on resolving what *this Court* has said.

That is why none of the Federal Circuit’s previous decisions has settled this issue. To the contrary, the continued discord within the Federal Circuit has *increased* the uncertainty that surrounds this foundational issue of patent litigation. The Federal Circuit has considered the issue en banc three different times since 1995, and a fourth is now underway. See *Markman I*, 52 F.3d at 976-77, 979; *Cybor*, 138 F.3d at 1454-56; *Phillips*, 415 F.3d at 1328; *Lighting Ballast*, *supra*. Each time thus far, it has attracted great attention and a flood of briefing from interested *amici* on all sides. Each time thus far, it has ul-

¹⁰ Under analogous circumstances, this Court has granted review of an important question when a suitable vehicle presented itself, even though the sole outlier court of appeals had already granted rehearing en banc whether to overrule its precedent and eliminate the circuit split. See, e.g., *Dillon v. United States*, 130 S. Ct. 2683, 2693 n.6 (2010).

timately left the law where it stands today. *See generally* pp. 4-7, *supra*.

Yet each time, the dissenters have vowed to keep up the fight. *See, e.g., Phillips*, 415 F.3d at 1330, 1334 (Mayer, J., dissenting) (“Now more than ever I am convinced of the futility, indeed the absurdity, of this court’s persistence in adhering to the falsehood that claim construction is a matter of law devoid of any factual component. . . . We should abandon this unsound course.”). New judges have joined them. *See, e.g., Retractable*, 659 F.3d at 1373 (O’Malley, J., dissenting from denial of rehearing en banc); *id.* (Moore, J., dissenting from denial of rehearing en banc). And other judges have expressed uncertainty about the merits but agreed that the question should be reconsidered. *See, e.g., Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039, 1040 (Fed. Cir. 2006) (Michel, C.J., dissenting from denial of rehearing en banc) (“[I]n light of our eight years of experience with [the] application” of the *Cybor* rule of *de novo* review, “I have come to believe that reconsideration is appropriate and revision may be advisable.”); *id.* at 1045 (Gajarsa, Linn, and Dyk, JJ., concurring in denial of rehearing en banc) (“In an appropriate case we would be willing to reconsider limited aspects of the *Cybor* decision.”).

In short, this debate has occupied the Federal Circuit for nearly two decades. The holding of *Lighting Ballast*—whichever way the case comes out—will not suddenly provide the certainty that patent litigants and lawyers have been seeking. Compounding the problem, the Federal Circuit voted to grant rehearing in *Lighting Ballast* at a time when three of its twelve judgeships were vacant. All three seats have

now been filled, but only one of them in time for the new judge to hear argument in *Lighting Ballast*. A majority of the en banc court thus might not represent a majority of the sitting judges—which would only encourage further attempts to relitigate the issue.

Continued litigation is a certainty because those favoring *de novo* review of factual findings insist, and will continue to insist, that this Court has already settled the matter. The Federal Circuit majority has pointed to this Court’s holdings that claim construction *in general* is a matter of law;¹¹ to the Court’s decision that factual issues underlying claim construction are resolved by the judge;¹² to the Court’s endorsement of the general proposition that uniform interpretation of patents is a good thing;¹³ and even to the Court’s failure to mention the standard of appellate review in *Markman II*.¹⁴

As explained above, and as many litigants, *amici* (including the Government), and commentators have discussed, those views are incorrect. But more significantly, they also demonstrate the enduring na-

¹¹ *Markman I*, 52 F.3d at 981 (citing numerous hoary patent cases).

¹² *Cybor*, 52 F.3d at 1456-57 (“[T]he Supreme Court’s opinion [in *Markman II*] conclusively and repeatedly states that claim construction is purely legal.”).

¹³ *Id.* at 1455 (in *Markman II*, “the Supreme Court endorsed [the Federal Circuit’s] role in providing national uniformity to the construction of a patent claim, a role that would be impeded if we were bound to give difference to a trial judge’s asserted factual determinations incident to claim construction.”).

¹⁴ *Id.* (“Nothing in the Supreme Court’s opinion supports the view that the Court endorsed a silent, third option—that claim construction may involve subsidiary or underlying questions of fact.”).

ture of the problem. Until this Court takes up this question and answers it, the controversy within the Federal Circuit is likely to continue, and patent litigation will continue to be plagued with uncertainty.

Because *Lighting Ballast* will not settle the issue, this Court need not and should not wait for a future petition in *Lighting Ballast*. Recent experience has shown that the Court cannot count on the litigants in a patent case, even a high-profile, precedent-setting patent case, to seek review.¹⁵ And if this Court were to wait, the Federal Circuit would continue to apply its misguided rule of *de novo* review in case after case while *Lighting Ballast* is pending, dozens of them each month. In many of those cases, including this one, the standard of review results in a new claim construction that either changes the winner or requires a new trial.

Rather than defer taking up an issue that it *will* need to review in an appropriate case, this Court should ask at the certiorari stage whether this case properly presents the eminently cert-worthy issue. The answer is yes. The Court should not pass up this opportunity to take a case in which the issue is so plainly outcome-determinative and in which the court of appeals' disregard of the factual findings about the state of knowledge in the art was so complete.

¹⁵ In several recent Federal Circuit en banc cases, the losing party has not petitioned for certiorari. See, e.g., *Marine Polymer Techs., Inc. v. HemCon, Inc.*, 672 F.3d 1350 (Fed. Cir. 2012); *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011); *TiVo, Inc. v. EchoStar Corp.*, 646 F.3d 869 (Fed. Cir. 2011); *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010).

C. Because The Court May Have The Opportunity To Address This Question In A Case Already Pending, The Court May Wish To Hold The Petition

The role of factual findings in claim construction is so fundamental that it has surfaced in a case that this Court will hear on the merits this Term. In *Nautilus, Inc. v. Biosig Instruments, Inc.*, No. 13-369, the Court will consider the standard governing the indefiniteness defense in patent-infringement litigation. Both questions presented in *Nautilus* bear on the Federal Circuit’s decision in this case, and the second question directly implicates the issue raised in this petition. The possibility that the Court will address that issue this Term would justify holding this petition pending *Nautilus*. But if the Court decides not to answer that question in *Nautilus*, it should grant review in this case without delay.

As noted above, under Federal Circuit precedent, to establish that a patent is indefinite under 35 U.S.C. § 112 ¶ 2, challengers must prove that the claim is not amenable to construction or is “insolubly ambiguous.” Pet. App. 6a (quoting the panel opinion in *Nautilus*). The Court has now agreed to review whether the “insolubly ambiguous” standard is correct, and whether the statutory presumption of patent validity (35 U.S.C. § 282 (2006)) “dilutes” the definiteness requirement. Pet. for Cert. at i, *Nautilus*, No. 13-369 (Sept. 21, 2013).

The parties appear likely to argue the presumption-of-validity question in a way highly relevant to this case. Under this Court’s decisions, the presumption of validity means that a patent-invalidity defense must be proven by clear and convincing evi-

dence. See generally *Microsoft Corp. v. i4i Ltd. P'ship*, 131 S. Ct. 2238 (2011). The patentee in *Nautilus* contended at the certiorari stage that, because indefiniteness involves consideration of *factual issues as part of claim construction*, the presumption requires those facts to be supported by clear and convincing evidence. Br. in Opp. at 31, *Nautilus, supra*. And the patentee emphasized that it submitted expert evidence that a person of ordinary skill in the art could understand what is claimed by the patent. *Id.* at 32. The petitioner responded that the presumption of validity was inapplicable because “[t]here are no factual determinations in claim construction.” Cert. Reply Br. at 6, *Nautilus, supra*. And both briefs relied on this Court’s decision in *Markman II* for those competing propositions—just as the judges of the Federal Circuit have done in expressing their divergent views on the proper standard of appellate review, see pp. 4-7, 21-23, *supra*.

As Justice Breyer noted in *i4i*, understanding the proper role of the presumption of validity calls for the Court to “separat[e] factual and legal aspects of an invalidity claim.” 131 S. Ct. at 2253 (Breyer, J., joined by Scalia and Alito, JJ., concurring). Accordingly, deciding whether the presumption of validity “dilutes” the statutory requirement of clear claim drafting is likely to turn on the question presented by this petition: whether claim construction turns on underlying questions of fact, subject to review under Rule 52(a)’s “clear error” standard, or is a pure question of law.

The Federal Circuit itself has been inconsistent in its approach to that issue. Decisions like the one below treat the indefiniteness inquiry as a purely legal

question reviewed *de novo*. See, e.g., Pet. App. 7a (“Indefiniteness is a question of law we review *de novo*.”).¹⁶ But other decisions correctly recognize that the ultimate legal conclusion whether a claim is indefinite often depends on underlying factual questions entitled to deferential review. See, e.g., *BJ Servs. Co. v. Halliburton Energy Servs., Inc.*, 338 F.3d 1368, 1370-71, 1372-73 (Fed. Cir. 2003) (treating as a matter of fact, reviewed deferentially, whether a person of ordinary skill in the art would know what “about 0.06” includes).¹⁷

In light of the questions presented in *Nautilus*, the parties’ contentions, and the split within the Federal Circuit, the Court may well address the proper role of factual findings in claim construction in the course of deciding *Nautilus*. The Court therefore may wish to hold the petition in this case pending a decision in *Nautilus*.¹⁸ But if this Court does not resolve the

¹⁶ Accord, e.g., *Funai Elec. Co., Ltd. v. Daewoo Elecs. Corp.*, 616 F.3d 1357, 1371 (Fed. Cir. 2010) (“The issue of claim definiteness receives plenary review, as a question of law.”); *Atmel Corp. v. Info. Storage Sys.*, 198 F.3d 1374, 1378 (Fed. Cir. 1999) (reviewing *de novo*).

¹⁷ Accord *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1288, 1297-98 (Fed. Cir. 2000) (treating indefiniteness as a question of fact rather than law).

¹⁸ This case may also be informed by the Court’s disposition of *Highmark Inc. v. Allcare Health Mgmt. Sys.*, No. 12-1163, and *Octane Fitness, LLC v. Icon Health & Fitness, Inc.*, No. 12-1184 (both to be argued Feb. 26, 2014). The Court is considering whether the Federal Circuit has erroneously asserted authority to review *de novo* a district court’s finding that a patent case is an exceptional one warranting an award of attorney’s fees. The parties, and dissenting judges in the Federal Circuit, have emphasized that the Federal Circuit’s position in *Highmark* bears considerable similarity to its position on claim construction in *Cybor*: it has assumed the power to review *de novo* by labeling

standard-of-review issue in the course of deciding *Nautilus*, this case represents the Court’s best opportunity to settle the question definitively, without further delay.

* * * * *

For too long, the Federal Circuit has seized for itself the primary role in claim construction, even on complex, technical factual points. The district court is in a far better position to invest the time and attention necessary to understand the patent from the right perspective—that of a person skilled in the art. That is exactly what the district court did in this case. Teva’s expert gave, and the district court credited, several reasons why “average molecular weight” was not fatally ambiguous to a skilled artisan. The Federal Circuit panel disagreed—without even acknowledging that the question is supposed to be examined from a skilled artisan’s perspective. The panel’s decision to second-guess the district court’s well-informed findings and hold the patent hopelessly ambiguous well illustrates the problem with the *Cybor* rule. This Court should take this clear, concrete, and ready opportunity to examine that rule—and to reject it.

an entire issue a “legal” one, even when it turns on fact questions. *E.g.*, Pet’r Br. at 17, *Highmark*, No. 12-1163); *Highmark, Inc. v. Allcare Health Mgmt. Sys., Inc.*, 701 F.3d 1351, 1362 (Fed. Cir. 2012) (Moore, J., dissenting from denial of rehearing en banc); *Highmark, Inc. v. Allcare Health Mgmt. Sys., Inc.*, 687 F.3d 1300, 1320 (Fed. Cir. 2012) (Mayer, J., dissenting in part). To the extent not subsumed in a hold for *Nautilus*, a hold for *Highmark* and *Octane* would also be appropriate.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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