

**In The
Supreme Court of the United States**

GOOGLE, INC.,
Petitioner,

v.

VEDERI, LLC,
Respondent.

**ON PETITION FOR WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

**BRIEF IN OPPOSITION TO
PETITION FOR WRIT OF CERTIORARI**

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QUESTIONS PRESENTED

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.

PARTIES TO THE PROCEEDING
AND RULE 29.6 STATEMENT

Petitioner in this Court, Defendant-Appellee below, is Google, Inc. Respondent in this Court, Plaintiff-Appellant below, is Vederi, LLC.

Vederi, LLC is a privately held company.

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I. INTRODUCTION

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. BenQ Am. Corp.*, 533 F.3d 1362, 1370 (Fed. Cir. 2008)

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.

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.

The petition should be denied.

II. STATEMENT OF THE CASE

A. The Patented Inventions

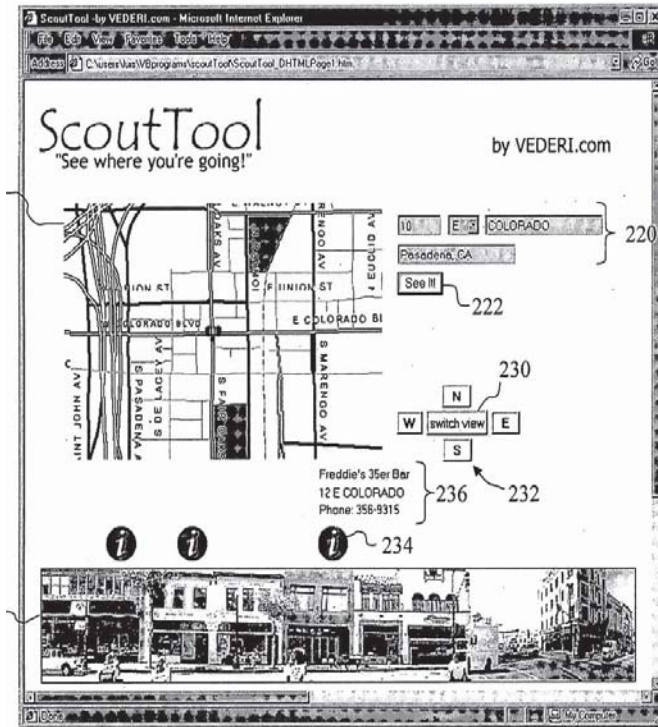
The patents-in-suit¹ disclose methods for enabling visual navigation of a geographic area from a user terminal. In Vederi’s patented methods, cameras are mounted on a moving vehicle that drives around a neighborhood’s streets recording image frames of the views of buildings, houses, etc. The recorded image frames are used to create

¹ U.S. Patent Nos. 7,239,760 (the “760 patent”), 7,577,316 (the “316 patent”), 7,805,025 (the “025 patent”) and 7,813,596 (the “596 patent”) entitled “System and Method for Creating, Storing and Utilizing Images of a Geographic Location.” (Collectively, the ‘760, ‘316, ‘025 and ‘596 patents are referred to herein as the “patents-in-suit” or the “asserted patents.”). C.A. App. A326, A573, A931, A1202. All claim priority to a provisional application filed October 6, 2000. *Id.*

composite images which are stored. When requested, the images associated with a particular location are retrieved by the server and caused to be displayed. The displayed images are what one would see if one were actually at the location. (App. 2-4).

In a preferred embodiment of the inventions, a host computer or server stores the composite images along with their associated geographic information. The server receives inquiries about a location within a geographic area. For example, the server may receive an address of a location or the geographic coordinates of the location from a user, or it may receive a selection of a location on a map. The server retrieves composite images associated with the selected location along with a map of the area and information on the businesses in the area. The server may cause these images and information to be displayed on a remote user terminal such as a personal computer. C.A. App. A351

Below is a reproduction of Figure 16 of the patents-in-suit showing a computer interface of the inventor's first working prototype called ScoutTool. (App. 3-4) At the bottom of the screen shot is an image depicting views of objects, i.e., storefronts.



B. The Accused Google Street View Processes

Google's Street View is a feature of Google Maps and Google Earth. C.A. App. A3340 at ¶ 1. In operation, Google receives a request from a user for a particular location. Google then provides a street-level image at or near the requested location. C.A. App. A3340-41 at ¶ 3; A2368 at ¶ 14; A2394. The image returned by Street View includes views of objects along the street. Many of these views are front or side views of objects, e.g. buildings, and many are identical in all pertinent aspects to what Google acknowledged are substantial elevational views of objects. C.A. App. A2367 at ¶¶ 3, 5; A2371;

A2373; A3341 at ¶¶ 4-5. For example, many Street View images contain front views of buildings that face the street:



C.A. App. A3286-88.

Notably, when Street View provides an image to the user, the default initial view is looking horizontally at objects, such as buildings, lining the street, resulting in a front view of those objects. C.A. App. A2368 at ¶ 15; A2396. From there, the user can pan up or down, or left or right, and can move up and down the street, or jump to a new location to receive a new image. C.A. App. A2368-69 at ¶¶ 15, 17; A2396; A2404-05; A2411.

C. Proceedings Below

1. Proceedings in the District Court

On October 15, 2010 Vederi sued Google for infringement of four of its patents (C.A. App. A1513). All of the Asserted Claims recite a method for enabling visual navigation of a geographic area.

On November 22, 2011, the district court conducted a claim construction hearing during which it construed a variety of terms including the phrase “the views being substantially elevations of objects” in the following claim limitation which appears in all of the asserted claims:

retrieving from the image source a first image associated with the first location, the image source providing a plurality of images depicting views of objects in the geographic area, *the views being substantially elevations of the objects* in the geographic area, wherein the images are associated with image frames acquired by an image recording device moving along a trajectory. (emphasis added)

See, e.g., C.A. App. A353. The district court did not issue a formal claim construction order but instead incorporated the transcript of the hearing by reference into a minute order. C.A. App. A73.

During claim construction, Vederi advocated that the “the views being substantially elevations of objects” phrase be construed as “front or side views” of objects whereas Google contended the proper construction was “vertical flat (as opposed to curved or spherical) depictions of front or side views” of objects. (App. 18-19).

The district court adopted Google’s proposed construction on the basis that the Vederi patents did not disclose spherical panoramas (App. 33-34)

(notwithstanding the fact that the specification affirmatively disclosed such panoramas (App. 22-23)).

The parties subsequently filed cross-motions for summary judgment on May 1, 2012. C.A. App. A1500-01. The district court granted summary judgment in Google's favor on the basis that the patents required "flat" views and that Google's Street View presented "curved views" even though the difference between Vederi's and Google's views would not be seen by the naked eye (C.A. App. A8-9) and because Street View allows the user to pan up and down or side to side to see views additional to the ones it displays that are identical to Vederi's views. C.A. App. A57-58 at 47:20-48:4.

2. Proceedings in the Court of Appeals

The Federal Circuit considered the district court's construction of "images depicting views of objects in the geographical area, the views being substantially elevations of the objects." The Federal Circuit, based on its analysis of the claims, specifications and file histories, concluded that the district court erred in its claim construction and determined "views being substantially elevations of the objects" refers to "front and side views of the objects." (App. 15-16)

The Federal Circuit also rejected Petitioner's arguments that statements made in the Background sections of the patents-in-suit and statements made in distinguishing the amended claims over the prior

art Levine reference disclaimed spherical image. (App. 13-15) The Federal Circuit rejected Petitioner's attempt to limit the meaning of "images," finding "no clear and unambiguous disavowal" of spherical or curved images. (App. 15) Specifically, the Federal Circuit found that "images" includes spherical and curved images. (App. 16)

Petitioner sought rehearing *en banc*. In its petition, Petitioner argued that the Federal Circuit had adopted a presumption "that amendments made to overcome disallowance presumptively do not disclaim the original claim scope, and instead narrow a claim only to the extent that they clearly and unambiguously do so." (Rehearing Petition at page 2). Petitioner also argued that the Federal Circuit applied a "clear and unambiguous" standard to determine the scope of a claim term that was amended during prosecution. (Rehearing Petition at pages 2-3) Petitioner further argued that "non-aerial views of objects" means the same thing as "views being substantially elevations of objects," as construed by the Federal Circuit. (Rehearing Petition at page 13) The Federal Circuit denied the Petition.

3. Concurrent Proceedings before the Patent and Trademark Office

On August 17, 2012, Petitioner filed requests for reexamination for each of the four patents in suit. At this stage of the proceedings, various claims of the patents have been confirmed or found patentable and others have been rejected. Both parties have

filed appeals to the Board of Patent Appeals and Interferences. Briefing for two of the patents has been completed. Briefing for the other two is ongoing. A hearing has yet to be scheduled.

4. **Status of the Action in the District Court.**

By agreement of the parties and the District Court, the action was stayed pending the outcome of the reexaminations.

III. **ARGUMENT**

A. **Petitioner Conflates Claim Construction Analyses and Analysis under the Doctrine of Equivalents**

An infringement determination involves a two-step process. First, the claims are construed so that their meaning is understood. Second, the construed claims are compared to the accused device or method. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384-85 (1996); *Winans v. Denmead*, 56 U.S. 330, 338; (1854). If all of the claimed elements are present in the accused device or method, there is literal infringement. If literal infringement is not found, the accused device may still infringe under the doctrine of equivalents, if the differences are insubstantial. *Warner-Jenkinson Co., v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39-40 (1997). Of importance here is the sequence of analysis. The amended claims must be construed before

considering the issues of literal infringement and infringement under the doctrine of equivalents.

In an infringement analysis involving a claim that has been amended during prosecution, the issue of disclaimer may arise in different contexts. In connection with the construction of the amended claim, a disclaimer may result from an amendment narrowing the scope of the claim. This Court's precedence holds that "it is a rule of patent construction consistently observed that a claim in a patent that is allowed must be read and interpreted with reference to claims that have been canceled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent." *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940). *See also, Keystone Driller Co. v. Northwest Eng'g Corp.*, 294 U.S. 42, 48 (1935) ("We do not attribute the force of an estoppel to what was said by the claimant in seeking to avoid the prior art cited against his broad claims, but we do apply the principle that where such broad claims are denied and a narrower substituted, the patentee is estopped to read the granted claim as the equivalent of those which were rejected.") The Federal Circuit has adopted this precept. *See, Omega Eng'g, Inc v. Raytek, Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) ("In light of the Court's guidance, we have adopted that [prosecution disclaimer] doctrine as a fundamental precept in our claim construction jurisprudence.")

In the context of claim construction, a disclaimer or disavowal may also result from statements made by the applicant during the

prosecution of the claim. Here, the Federal Circuit finds that if the applicant made an unambiguous disavowal of a certain meaning of a claim term to obtain a patent, the doctrine of prosecution disclaimer applies and narrows the ordinary meaning of the claim. *Id.* at 1324. However, if the purported disavowal is ambiguous, the doctrine of prosecution disclaimer does not attach and the claim will be given its ordinary meaning.

The issue of disclaimer may also arise in the application of the doctrine of equivalents. If a claim is narrowed by amendment during prosecution to overcome a rejection by the Patent and Trademark Office, there is a rebuttable presumption that prosecution history estoppel applies. Prosecution history estoppel precludes a patentee from asserting as an equivalent under the doctrine of equivalents subject matter surrendered by an amendment to the claims, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*, 535 U.S. 722, 734 (2002).

Petitioner asserts there is a conflict between the cited Federal Circuit issues which address claim construction issues and the cited Supreme Court precedents. An analysis of the Federal Circuit cases and the Supreme Court opinions demonstrates that Petitioner is mistaken in this regard.

B. None of the Federal Circuit Cases cited by Petitioner Support Its Purported Presumption

Petitioner cites a variety of Federal Circuit cases as purported support for its assertion that

when an applicant for 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. Many of the cases cited by Petitioner actually address the construction of the amended claim and particularly the new claim language. Many of these cases also address the issue of whether statements made by the applicant (as opposed to claim amendments) result in a narrowing of the meaning of the newly added claim language. None, however, treat the amended claim scope as the same as the original claim scope.

In *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1325 (Fed. Cir. 2013), the claim language was amended from “substantially continuous contact” to “continuous contact.” The Federal Circuit determined that “continuous contact” should be given its ordinary meaning and is not limited to the full contact mode of Fig. 22. There was no issue that the construed language recaptured all that was given up when the applicant amended his claims.

In *Schindler Elevator Corp. v. Otis Elevator Corp.*, 593 F.3d 1275, 1284-1285 (Fed. Cir. 2010) the claim was amended to further recite “an information transmitter” and “the recognition device ... *actuating the information transmitter*” (amendment emphasized)” *Id.* The patentee argued that the prior art required a user to manually actuate a transmitter by pressing buttons. The claim construction issue was whether the claim disavowed all “personal action” by the elevator user. The

Federal Circuit found that the statements by the patentee in the specification and prosecution history were directed to elevator operations *after* the information transmitter is in range of the recognition device and therefore there was no disavowal of the initial act of bringing the information transmitter within range of the recognition device. Again, there was no issue that the construed language recaptured all that was given up when the applicant amended his claims.

In *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1085-86 (Fed. Cir. 2009) the Federal Circuit construed the amended language “data acquisition unit” and concluded that

By amending the claims to require a separate data acquisition unit and display unit, and by remarking that this distinguished the “unitary structure” of Root, the applicants clearly and unmistakably disavowed a single structure that encompassed an electronic positioning device, a physiological monitor, and a display unit. The claimed exercise monitoring system must be at least two structures. However, there is nothing in the amendment or the applicants’ comments that clearly and unmistakably disavows a monitoring system with *more than* two structures. Thus, there was no clear and unmistakable disavowal of a “data

acquisition unit” made up of physically separate structures.

There was no issue that the construed language recaptured all that was given up when the applicant amended his claims.

In *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364, 1371 (Fed. Cir. 2003) the claim language was amended in view of prior art, deleting reference to “a rare earth-transition metal material in a metastable crystalline state” to “an amorphous rare earth-transition metal alloy...”. In determining the subject matter surrendered by the amendment, the Federal Circuit noted that “Kumar surrendered a broad claim covering all partially crystalline material, but did not thereby surrender the subset of such material within the scope of the definition of amorphous.” There was no issue that the construed language recaptured all that was given up when the applicant amended his claims.

In *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1332 (Fed. Cir. 2004) the claim at issue included the limitation “vertical drive means for tilting said lamp unit in a vertical direction and horizontal drive means for rotating said lamp unit in a horizontal direction”. *Id.* at 1330 (emphasis omitted). Wal-Mart argued that “rotating” must be construed as meaning that the lamp unit rotates through “at least 360°.” The Federal Circuit determined that there was no clear definition or disavowal of claim scope in the written description that would limit the claim to horizontal motion through “at least 360°” and that the claim at issue

was distinguished based on the prior art's failure to disclose both tilting and rotating. Once again, there was no issue that the construed language recaptured all that was given up when the applicant amended his claims.

In *Omega Eng'g*, 334 F.3d at 1323-25 some of the claims at issue relating to an infrared thermometer having a laser sighting component included the limitation “means for causing said at least one laser beam to strike the periphery of the energy zone for visibly outlining said energy zone” or similar limitations. *Id.* at 1321-1322 The claim construction issue was whether this limitation would encompass devices that also emitted a laser beam that struck a portion within the energy zone. The Federal Circuit determined that, *Omega Eng'g* distinguished claims that included the “outlining” limitation, over the prior art by arguing that laser beams that struck the energy zone would add heat to the energy zone, thereby adversely affecting the temperature measurements. Therefore, *Omega Eng'g* explicitly disclaimed lasers having beams aimed inside the energy zone. However, there was no similar argument made with respect to other claims that did not include the “outlining” limitation and therefore there was no disclaimer in those claims. There was no issue that the construed language recaptured all that was given up when the applicant amended his claims.

In *Bd. Of Regents of the Univ. of Tex. Sys.* 533 F.3d at 1369, the claim language was amended to replace “an alphabetic string” with “one or more syllabic elements”. The Federal Circuit determined

that, in accordance with the prosecution history, the claim amendment to recite “syllabic element” narrowed the scope of the claim to distinguish over the art of record and that a single syllabic element could encompass either a single word or a part of a multi-syllable word. “Moreover, if ‘syllabic elements’ included words, then Rabiner’s disclosure of matching with words would teach the portion of claim 10 that was amended to distinguish Rabiner. *We decline to adopt a construction that would effect this nonsensical result.*” *Id.* at 1370 (emphasis added)

In *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1327 (Fed. Cir. 2003) the claims recited “non-naturally occurring,” “vertebrate cells,” and “mammalian cells”. The claim construction issue was whether these included human cells. The Federal Circuit determined that the specification described humans as being a subset of mammals and mammals, in turn, a subset of invertebrates and that the claim limitations therefore include human cells. The Federal Circuit also found that an error in the specification was not a clear disavowal sufficient to undercut the express disclosure of the claims’ encompassing human cells.

In *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333 (Fed. Cir. 2003) the claim language was amended to add the limitations “treating or preventing macrocytic-megaloblastic anemia” and “to a human in need thereof”. The claim construction issue was whether these limitations required the infringer to “intend” to treat or prevent macrocytic-megaloblastic anemia. The Federal Circuit

determined that the claim amendments should be given weight and that this amendment changed the scope of the claims.

In *W.E. Hall Co. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1352 (Fed. Cir. 2004) the claim language was amended to further recite a pipe of a “single piece construction” in order to overcome the prior art. The claim construction issue was whether the “single piece construction” meant a construction that has only a single element contributing to the structural integrity of the pipe. The Federal Circuit determined that there was not sufficiently explicit disclaimer in the prosecution history to depart from the ordinary and customary meaning of the term “single piece construction.” There was no issue that the construed language recaptured all that was given up when the applicant amended his claims.

In sum, none of the cited Federal Circuit support the assertion that the Federal Circuit presumes that amendments made to overcome a prior art rejection do not narrow the scope of the claims.

C. There is No Conflict Between Supreme Court Precedents and the Federal Circuit’s Approach Regarding the Effect of a Claim Amendment on Claim Construction

The Supreme Court cases cited by Petitioner make clear that an applicant whose claim is narrowed by amendment to overcome a rejection based on prior art, “may not by construction, or by

resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to a disclaimer.” *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429 (1926) (quoting *Weber Elec. Co. v. Freeman Elec. Co.*, 256 U.S. 668). See also, *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126 (1942); *Keystone Driller Co. v. Nw. Eng’g Corp.*, 294 U.S. 42, 48 (1935); *Smith v. Magic City Kennel Club, Inc.*, 282 U.S. 748 (1931); *Hubbell v. United States*, 179 U.S. 77, 83 (1900); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

While these cases clearly point out that a disclaimer attaches to narrowing amendments made to overcome prior art rejections, none of these cases suggest that the amended claims need not be construed as the initial step in an infringement analysis.

The Federal Circuit decisions cited by Petitioner, discussed above address this initial step of construing the amended claims. None of the Federal Circuit cases construe the amended claim limitation to have the same scope as the original claim limitation. Hence, the cited Federal Circuit decisions are consistent with the guidance provided in the above Supreme Court cases.

D. The Amendment to the Vederi Claims Was to the Type of Views Depicted in the Images, Not to the Type of Images

During prosecution, Vederi amended its claims to distinguish over U.S. Patent No. 6,140,943 (“Levine”). As the Federal Circuit noted,

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”.

(App. 15)

Vederi’s amendment changed the claim language from “the images providing a non-aerial view of the objects” to “images depicting views of objects . . . the views being substantially elevations of the objects.” (App. 15) This amendment is directed to the *views* of objects that are depicted in the *images*, not to the type of images (e.g., flat, spherical or curved).

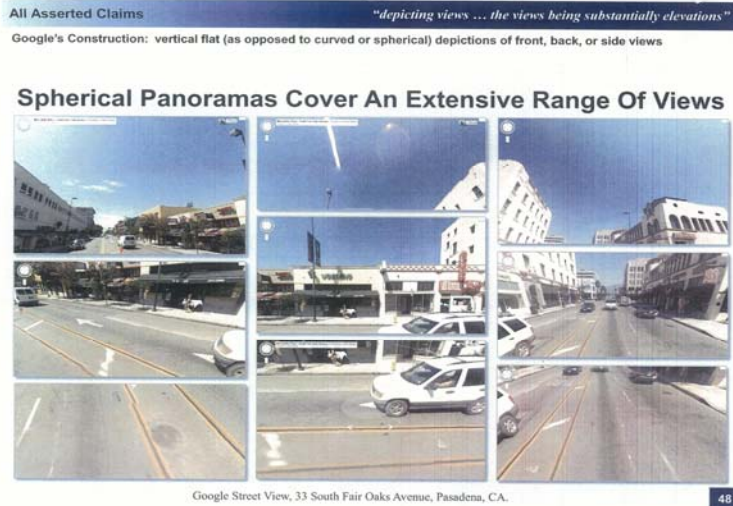
The Federal Circuit found that “[d]espite Google’s protestations to the contrary, this court discerns no clear and unambiguous disavowal of spherical or curved *images* that would support the district court’s construction.” (App. 15) (emphasis

added) Hence, the Federal Circuit reference to “clear and unambiguous” is not a reference to the amended claim term.

As to the type of views of objects depicted in the images, the claims were narrowed from “non-aerial views of objects” to “views being substantially elevations of objects.” (App. 15) Because there are innumerable non-aerial views of objects that are not front views or side views of the objects, the claims were narrowed in scope.

E. There is a Difference Between Non-Aerial Views of Objects and Views Being Substantially Elevations (Front and Side Views) of Objects

Petitioner makes the unsupported and conclusory statement that “non-aerial views of objects” and “views being substantially elevations” [front and side views] of objects mean the same thing. (Petition at page 18) This is not only contrary to the words themselves, but contradicts prior arguments by Petitioner. During the claim construction hearing, Petitioner submitted a presentation slide, reproduced below, stating that Street View includes a range of views. C.A. App. A2343 at ¶ 2; A2349.



All of the above images depict non-aerial views of objects. As can be seen, only the center image depicts a front view of an object, i.e., a storefront.

Because the amendment narrowed the scope of the claims, there can be no conflict with *Smith* or *Exhibit Supply* as claimed by Google.

IV. CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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