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No. 14-448

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

GOOGLE INC.,

PETITIONER,

v.

VEDERI, LLC,

RESPONDENT.

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

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**REPLY BRIEF FOR PETITIONER**

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**REPLY BRIEF**

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).

Vedri 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.

Vedri 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, 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'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 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.

Vedri 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).

Vedri 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.

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 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.<sup>1</sup> 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.

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<sup>1</sup> The claims refer to images depicting views, the views being substantially elevations. Pet. 7. Because views are substantially elevations, and images depict those very (elevational) views, any distinction between images and views sheds no light on the meaning of substantially elevations. See Google C.A. Br. 32. It certainly does not provide a basis for negating the amendment that replaced non-aerial views with substantially elevations. That amendment must be given effect.

Vederi suggests that Google did not preserve the 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 substantial elevations. Google C.A. Br. 30; *see also id.* (“Vederi’s proposed construction would essentially 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. 364–43 (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, ¶ 12 (2010). Indeed, a study shows that 85% of sampled issued patents were amended at least once. *Id.* ¶ 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*.

\* \* \*

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.

**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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