

No. 14-448

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

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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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**SUPPLEMENTAL BRIEF FOR PETITIONER**

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**TABLE OF CONTENTS**

TABLE OF AUTHORITIES.....	ii
SUPPLEMENTAL BRIEF FOR PETITIONER.....	1
I. THE CONFLICT IS MANIFEST.....	2
A. This Court’s Standard .....	2
B. The Federal Circuit’s Standard .....	4
C. The Government’s Proposed Standard.....	7
II. THE ISSUE IS IMPORTANT AND CLEANLY PRESENTED.....	10
CONCLUSION .....	13

## TABLE OF AUTHORITIES

### Cases

<i>3M Innovative Props. Co. v. Tredegar Corp.</i> , 725 F.3d 1315 (Fed. Cir. 2013).....	1, 5, 6, 10
<i>Amgen Inc. v. Hoechst Marion Roussel, Inc.</i> , 314 F.3d 1313 (Fed. Cir. 2003).....	6
<i>Atofina v. Great Lakes Chem. Corp.</i> , 441 F.3d 991 (Fed. Cir. 2006).....	8
<i>Blair v. Chicago</i> , 201 U.S. 400 (1906) .....	3
<i>Broad River Power Co. v. South Carolina ex rel. Daniel</i> , 281 U.S. 537 (1930) .....	3
<i>Citizens' Bank of La. v. Parker</i> , 192 U.S. 73 (1904) .....	4
<i>Exhibit Supply Co. v. Ace Patents Corp.</i> , 315 U.S. 126 (1942) .....	2, 9
<i>Golight, Inc. v. Wal-Mart Stores, Inc.</i> , 355 F.3d 1327 (Fed. Cir. 2004).....	7
<i>Hubbell v. United States</i> , 179 U.S. 77 (1900) .....	1, 2
<i>I.T.S. Rubber Co. v. Essex Rubber Co.</i> , 272 U.S. 429 (1926) .....	10
<i>KSR Int'l Co. v. Teleflex Inc.</i> , 550 U.S. 398 (2007) .....	8
<i>Kumar v. Ovonic Battery Co.</i> , 351 F.3d 1364 (Fed. Cir. 2003).....	7, 10

<i>MarcTec, LLC v. Johnson &amp; Johnson</i> , 394 F. App'x 685 (Fed. Cir. 2010) .....	8
<i>Nautilus, Inc. v. Biosig Instruments, Inc.</i> , 134 S. Ct. 2120 (2014) .....	13
<i>Norian Corp. v. Stryker Corp.</i> , 432 F.3d 1356 (Fed. Cir. 2005).....	8
<i>Paragon Solutions, LLC v. Timex Corp.</i> , 566 F.3d 1075 (Fed. Cir. 2009).....	6
<i>Regents of Univ. of Cal. v.</i> <i>Dakocytomation Cal., Inc.</i> , 517 F.3d 1364 (Fed. Cir. 2008).....	8
<i>Schindler Elevator Corp. v.</i> <i>Otis Elevator Corp.</i> , 593 F.3d 1275 (Fed. Cir. 2010).....	6
<i>The Delaware R.R. Tax</i> , 85 (18 Wall.) U.S. 206 (1874) .....	3
<i>United States v. Baltimore &amp; Ohio Sw. Ry. Co.</i> , 222 U.S. 8 (1911) .....	4
<i>W.E. Hall Co. v. Atlanta Corrugating, LLC</i> , 370 F.3d 1343 (Fed. Cir. 2004).....	7
<i>Weber Electric Co. v. E.H. Freeman Electric Co.</i> , 256 U.S. 668 (1921) .....	10
<b>Other Authorities</b>	
Bassinger, Kenneth D., <i>Allocating Linguistic Uncertainty</i> <i>in Patent Claims</i> , 49 Loy. L. Rev. 339 (2003).....	1, 6

Brief for the United States, <i>Sebelius v. Cloer</i> , 133 S. Ct. 1886 (2013) (No. 12-236), 2006 WL 75285.....	4
Brief for the Unites States, <i>Applera Corp. v. Enzo Biochem, Inc.</i> , No. 10-426 (Jan. 1, 2010), 2011 WL 1881824.....	13
Crouch, Dennis, Patently-O (Jan. 13, 2015) .....	5
Miller, Todd R., <i>The “Doctrine of Prosecution Disclaimer”</i> <i>in Construing Patent Claims</i> , 86 J. Pat. & Trademark Off. Soc’y 931 (2004).....	9
Risch, Michael, <i>The Failure of Public Notice in Patent</i> <i>Prosecution</i> , 21 Harv. J. L. & Tech. 179 (2007).....	11
United States Patent & Trademark Office, <i>Discussion Regarding Strategies for</i> <i>Improving Claim Clarity: Glossary Use</i> <i>in Defining Claim Terms</i> (Oct. 17, 2013).....	11

## SUPPLEMENTAL BRIEF FOR PETITIONER

The conflict is manifest. This Court strictly construes claim language that was amended during prosecution to overcome disallowance. *Hubbell v. United States*, 179 U.S. 77, 84 (1900). The Federal Circuit applies the opposite standard, holding that such amendments do not disclaim the original claim scope unless a disclaimer is “clear and unmistakable.” *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1325 (Fed. Cir. 2013). While this Court’s standard ensures that ambiguities are resolved “against the inventor and in favor of the public,” *Hubbell*, 179 U.S. at 83–84, the Federal Circuit’s standard “shifts the risk of” ambiguities “from the patentee to the public.” Kenneth D. Bassinger, *Allocating Linguistic Uncertainty in Patent Claims*, 49 Loy. L. Rev. 339, 397 (2003).

The government attempts to reconcile these diametrically opposed standards by asserting that both courts follow a third legal standard, under which a court applies ordinary principles of construction and then carves out only what it determines to have been within the scope of the prior art. *Neither* court has ever articulated that test, and the Federal Circuit has expressly *rejected* it. The government’s advocacy of a third standard only underscores the need for this Court’s review.

The government does not dispute that, if the conflict exists, it is exceptionally important. As Google and its *amici* have explained, it is common practice to seek broad claims from the Patent and Trademark Office (“PTO”), amend the claims as necessary to overcome an examiner’s initial rejection,

and be as ambiguous as possible about the intended effect of the amendments—so that the applicant can later exploit the ambiguity in litigation or licensing negotiations.

In calling for the government’s views, this Court may have hoped that the government would address the practical consequences. By remaining largely silent on that question, the government (like *Vederi*) has at least implicitly acknowledged the issue’s importance. This Court can consider the government’s merits position at the merits stage, but that is no reason to deny review at this stage.

## I. THE CONFLICT IS MANIFEST

### A. This Court’s Standard

When a patent applicant amends a claim to overcome rejection, the amendment “operates as a disclaimer.” *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942). To prevent patentees from attempting to reclaim what they had surrendered, such amendments “must be strictly construed against the inventor and in favor of the public.” *Hubbell*, 179 U.S. at 83–84.

The government argues that by *strict* construction, this Court really meant that “a court generally must apply *ordinary* principles of claim construction to an amended claim.” U.S. Br. 13 (emphasis added). The government relies on this Court’s statement in *Hubbell* that patentees deserve a “fair construction.” U.S. Br. 8 (quoting *Hubbell*, 179 U.S. at 80). But *Hubbell* expressly called for strict construction, 179 U.S. at 83–84, and there is no

conflict between those two statements because strict construction is fair.

There is no reason to believe that, in calling for strict construction, the Court intended something different from the many other contexts in which strict construction applies. Strictly construing claims that were amended to overcome disallowance is a species of the general rule that “public grants are strictly construed, such that rights not “expressly granted are reserved” to the public. *The Delaware R.R. Tax*, 85 (18 Wall.) U.S. 206, 225 (1874).

For example, “any ambiguity or doubts as to” the meaning of statutes authorizing corporate franchises “must be resolved in favor of the public interest,” in part because “legislative acts of this character are commonly prepared by those interested in the benefits to be derived from them.” *Broad River Power Co. v. South Carolina ex rel. Daniel*, 281 U.S. 537, 548 (1930); accord *Blair v. Chicago*, 201 U.S. 400, 471 (1906). So too here: applicants draft their own claims, and ambiguities should be resolved against them. *See* Pet. 4–6.

The government argues that it would be unreasonable to “require that amended claim language be construed as narrowly as possible.” U.S. Br. 6. That is a straw man. First, this Court has required strict construction only for amendments made to overcome rejection, not all amendments. In this context, ambiguities should be construed against the drafter because there is no question that the narrowing amendment was important, and indeed necessary, for the patent’s issuance.



Second, strict construction means only that a court faced with two reasonable constructions of an ambiguous provision should choose the narrower one. The “proper office” of strict construction is “to help to solve ambiguities,” not create them. *Citizens’ Bank of La. v. Parker*, 192 U.S. 73, 86 (1904). When the text is clear, it controls. See *United States v. Baltimore & Ohio Sw. Ry. Co.*, 222 U.S. 8, 13 (1911). Similarly, if an interpretive dispute does not implicate an amendment made to overcome rejection, strict construction should not alter the outcome. The amended language should be strictly construed, but that should have no bearing on unrelated interpretive disputes.

Strict construction therefore poses none of the issues the government attributes to it. The government is especially ill-suited to suggest that strict construction is not fair construction, as the government routinely invokes it in other contexts. See, e.g., U.S. Br. 29–30, *Sebelius v. Cloer*, 133 S. Ct. 1886 (2013), 2006 WL 75285.

## **B. The Federal Circuit’s Standard**

The conflict would persist even under the government’s view of this Court’s decisions. The government argues that the Federal Circuit “respects the principle that a claim may not be construed to recapture subject matter that was previously disclaimed through an amendment.” U.S. Br. 15. But that elides the Federal Circuit’s strong presumption against finding disclaimer: faced with two reasonable constructions of an ambiguous amendment, the court of appeals chooses the broader

one unless the interpretive evidence favoring the narrower is “both clear and unmistakable.” *3M Innovative Props.*, 725 F.3d at 1325; Pet. 16–17. Whatever this Court meant by *strict* construction, it surely did not mean *liberal* construction. As the leading intellectual-property blog observed, therefore, “the Federal Circuit has strayed significantly” from this Court’s precedents. Dennis Crouch, Patently-O (Jan. 13, 2015), at <http://patentlyo.com/patent/2015/01/copyrights-through-supreme.html>.

The government tries to take the “clear and unmistakable” out of the Federal Circuit’s “clear and unmistakable” standard by downplaying the standard as a “formulation to express a presumption that the claim language should be given its ordinary meaning, consistent with the specification.” U.S. Br. 14. Under that view, the Federal Circuit applies the same “interpretive approach whether or not the claim has been amended during prosecution.” *Id.* That should be the end of the discussion of whether there is a conflict. The whole point of this Court’s cases is that amendments made to overcome disallowance should receive *greater* scrutiny. Yet the government defends the Federal Circuit’s standard by arguing that it applies *ordinary* scrutiny.

The government then shifts position by arguing that the Federal Circuit does apply heightened scrutiny, after all. According to the government, the Federal Circuit holds that an amendment “necessarily constitutes clear and unmistakable evidence” of disclaimer. U.S. Br. 15. If only it were so. The first case the government cites for that proposition found there was no clear disavowal, *see*

*Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1327 (Fed. Cir. 2003), and none of the others held that amendments are *per se* clear and unambiguous disclaimers.

The Federal Circuit has held the opposite: only “an amendment that *clearly* narrows the scope of a claim” constitutes a disclaimer in the Federal Circuit’s view. *Schindler Elevator Corp. v. Otis Elevator Corp.*, 593 F.3d 1275, 1285 (Fed. Cir. 2010) (emphasis added). “[U]nexplained amendments do not evince a clear and unmistakable surrender of subject matter.” Bassinger, 49 Loy. L. Rev. at 397. Indeed, the Federal Circuit has reversed when “[t]he district court found that [claim] amendments constituted a disclaimer” precisely because its “precedent requires that, in order for prosecution disclaimer to attach, the disavowal must be both clear and unmistakable.” *3M Innovative Props.*, 725 F.3d at 1325. Under that standard, the Federal Circuit routinely resolves ambiguities regarding the scope of an amendment in favor of the patentee. *See* Pet. 16–17; *Amici* Br. 13–14.

The government dismisses some of the Federal Circuit’s cases as relating to argument-based disclaimer (*i.e.*, disclaimer from statements made to examiners, as opposed to from claim amendments). But the Federal Circuit has applied its clear-and-unmistakable standard to amendments in numerous cases, including this one. *See 3M Innovative Props.*, 725 F.3d at 1325; *Schindler Elevator*, 593 F.3d at 1284–85; *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1085–86 (Fed. Cir. 2009); *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1332 (Fed. Cir.

2004); *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364, 1371 (Fed. Cir. 2003); *W.E. Hall Co. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1352 (Fed. Cir. 2004); Pet. App. 11–12. Some of those cases *also* involved statements to examiners, but that has no bearing on the standard applied to amendments.

The government’s discussion of argument-based disclaimer only confirms the error. As the cases cited by the government (at 17 n.1) confirm, the Federal Circuit applies the same “clear and unmistakable” standard to statements that it applies to amendments. *See, e.g., Golight*, 355 F.3d at 1332; *W.E. Hall*, 370 F.3d at 1352. As the government recognizes, however, statements to examiners “do not implicate the rule that a court must give effect to narrowing amendments,” in part because such statements “may be vague or incomplete, necessitating caution in relying on them.” U.S. Br. 17 n.1. The Federal Circuit’s application of the same standard to amendments and to presumptively unreliable statements confirms that it is not applying this Court’s heightened scrutiny to amendments.

### **C. The Government’s Proposed Standard**

The government argues for a third approach: construing claims as if they had not been amended, determining what an applicant had to surrender in order to distinguish a prior art reference, and then carving out that subject matter but no more from the claim. *See* U.S. Br. 6, 9. The government’s position does nothing to ameliorate the conflict because the Federal Circuit has squarely rejected it. That court does not allow patentees “to assert that claims should

be interpreted as if they had surrendered only what they had to.” *Norian Corp. v. Stryker Corp.*, 432 F.3d 1356, 1361–62 (Fed. Cir. 2005); *see also MarcTec, LLC v. Johnson & Johnson*, 394 F. App’x 685, 687 (Fed. Cir. 2010); *Regents of Univ. of Cal. v. Dakocytomation Cal., Inc.*, 517 F.3d 1364, 1381 (Fed. Cir. 2008); *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 998 (Fed. Cir. 2006).

And for good reasons. The government’s assumption that amendments are intended to disclaim only the metes and bounds of specific prior art references (as later understood by a court) is question-begging, and often wrong. “It frequently happens that patentees surrender more through amendment than may have been absolutely necessary to avoid particular prior art.” *Norian*, 432 F.3d at 1361–62. One reason is the non-obviousness requirement: even if a patent claim excludes the precise metes and bounds of a prior art reference, it may be obvious, and thus unpatentable, in light of that reference and the background knowledge and skill of those in the art. *See, e.g., KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

In the government’s hypothetical example, an amendment to change “reinforcing rod” to “flexible reinforcing rod,” in light of prior art involving steel rods, would exclude only steel rods. *See* U.S. Br. 7–8. But if other known metals similar to steel could be used in the same way as steel, the government’s construction would likely make for a textbook case of obviousness. *See, e.g., KSR*, 550 U.S. at 417. It is at best unclear why an examiner would require an

amendment to satisfy the anticipation but not the non-obviousness requirement for patentability.

In any event, the interpretive question is what the amendment actually surrendered, not what a court later concludes had to be surrendered. That is why “it is immaterial whether the examiner was right or wrong in rejecting the [original] claim as filed.” *Exhibit Supply*, 315 U.S. at 137.

Perhaps most importantly, the government assumes away the fundamental underlying problem—ambiguity. The government’s approach would be workable only if the interplay of the prior art, the examiner’s reasoning, and the resulting claim amendment were clear. In reality, as the petition and *amici* brief explain, that is usually *not* the case. Applicants typically dispute the scope of the prior art, see Todd R. Miller, *The “Doctrine of Prosecution Disclaimer” in Construing Patent Claims*, 86 J. Pat. & Trademark Off. Soc’y 931, 948–49 (2004), and deliberately inject ambiguity into the amendment process, in order to secure allowance while retaining flexibility to assert an interpretation with which the examiner may well have disagreed. That is easy to do because communications with examiners often occur (as they did for this patent) in unrecorded conferences. Pet. 22–23, 24; *Amici* Br. 17–19.

The government never comes to terms with the fundamental problem of ambiguity—or even addresses how a court should handle ambiguity. This Court has addressed that issue by resolving ambiguities against the applicant. See, e.g., *Weber Electric Co. v. E.H. Freeman Electric Co.*, 256 U.S.

668, 677–78 (1921) (holding that “disclaimer of rotation as an operative feature” resulted from claim amendment “implying” such a disclaimer). In contrast, it is not clear that the Federal Circuit would agree with the government that the hypothetical amendment disclaims steel. That would depend on whether the term “flexible” clearly and unambiguously excludes steel. *See, e.g., 3M Innovative Props.*, 725 F.3d at 1325; *Kumar*, 351 F.3d at 1371.

## **II. THE ISSUE IS IMPORTANT AND CLEANLY PRESENTED**

Like *Vederi*, the government does not dispute that this is a frequently recurring question, that the conflict (if it exists) is exceptionally important, and that the common prosecution tactics described above make a mockery of the examination process.

Most of the government’s policy arguments rest on its incorrect assertions about the Federal Circuit’s legal standard and Google’s position. *See* U.S. Br. 22–23. Beyond that, the government suggests that this Court’s legal standard would cause it administrative inconvenience because strict construction would purportedly give applicants a greater incentive to appeal rejections instead of amending claims. *See* U.S. Br. 12–13. This Court has stated that applicants “should” appeal rejections they believe to be erroneous. *E.g., I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443 (1926). In any event, the important incentive would be for applicants to stop injecting ambiguity into the record and instead use clear claim language or explain—in a

sentence or two in the prosecution record—the effect and meaning of an otherwise ambiguous amendment. The PTO has stated elsewhere, as part of its patent-quality initiative, that it *wants* applicants to make a clear administrative record of claims’ meaning. See, e.g., USPTO, *Discussion Regarding Strategies for Improving Claim Clarity: Glossary Use in Defining Claim Terms* (Oct. 17, 2013), available at [http://www.uspto.gov/sites/default/files/patents/init\\_events/glossary\\_pilot.pdf](http://www.uspto.gov/sites/default/files/patents/init_events/glossary_pilot.pdf).<sup>1</sup>

Finally, the government’s vehicle concerns are makeweight. See Reply 8–9. The government notes that Google did not challenge the Federal Circuit’s entrenched precedent before the panel. U.S. Br. 10, 22. But the government appears, correctly, to stop short of claiming that Google forfeited or waived this point. As the reply explains, litigants must preserve issues, not supporting arguments, and Google raised this issue—the correct interpretation of the claim language in light of the amendment—before the panel. Moreover, the panel passed upon the legal question, and Google asked the *en banc* court to overrule its precedents. See Reply 9. Why this case would be a more “suitable” vehicle had Google asked the panel as well as the *en banc* court to overrule settled circuit precedent is at best unclear.

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<sup>1</sup> The PTO’s longstanding application of a broadest-reasonable-construction standard is beside the point because the problems discussed above have flourished notwithstanding that standard. Indeed, “courts often interpret claims more broadly than the USPTO.” Michael Risch, *The Failure of Public Notice in Patent Prosecution*, 21 Harv. J. L. & Tech. 179, 181 (2007).



The government also asserts that the amendment at issue here has nothing to do with the parties' interpretive dispute. As explained above, such analysis is at best question-begging. The parties dispute the meaning of "substantially elevations." Because that term was added by amendment, the change from "non-aerial views" to "views being substantially elevations" provides important context. And the government's assertion that the amendment served only to exclude maps is clearly wrong. The replaced language (non-aerial views) already excluded maps because maps are by definition non-aerial views. *See* Pet. 18–19; Reply 6–8. Under correct legal principles, therefore, the amendment necessarily has greater effect and relevance than the government and Federal Circuit attribute to it.

In any event, the question for present purposes is not whether Google would necessarily win under correct legal principles (though Google should). The point is simply that this Court's review of the legal question might change the result in this case, making it an appropriate vehicle for addressing the important legal question.

\* \* \*

It is no secret that the government's standard for a conflict, and for certworthiness in general, differs from this Court's. With respect to the standard for determining whether a patent claim is definite, for example, the government advised this Court that there was no conflict between its precedents and the Federal Circuit's. *See* U.S. Br. at 11–12, *Applera Corp. v. Enzo Biochem, Inc.*, No. 10-426 (Jan. 1,

2010), 2011 WL 1881824. When this Court later granted review of the issue, it determined that the Federal Circuit's standard was not even "probative of the essential inquiry" as construed by this Court. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2130 (2014) (quotation marks and citation omitted). On this issue as well, the conflict is clear, and review is warranted.

### CONCLUSION

The petition for a writ of certiorari should be granted.

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