

No. 13-369

IN THE
Supreme Court of the United States

NAUTILUS, INC.,
Petitioner,
v.

BIOSIG INSTRUMENTS, INC.,
Respondent.

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

**BRIEF OF INTERVAL LICENSING LLC
AS *AMICUS CURIAE* IN SUPPORT OF
RESPONDENT**

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INTEREST OF AMICUS CURIAE¹

Amicus curiae Interval Licensing LLC (Interval) is the owner of patents invented at Interval Research Corporation (Interval Research), a private think tank founded in 1992 by Paul Allen and David Liddle to perform advanced research and development in the areas of information systems, communications, and computer science.² Interval Research employed over 110 of the world's leading scientists, physicists, and engineers, and obtained hundreds of patents before ceasing operations in the year 2004. Interval has a strong interest in ensuring that the substantial resources that Interval Research, its employees, and other inventors expended in research and development receive appropriate protection from the patent system.

Interval is presently litigating in the Federal Circuit the validity of claims in two of its patents, which a district court erroneously held indefinite. Interval thus has a particularly acute interest in the precise issue before the Court, as well as substantial experience with the practical realities of applying the standard for indefiniteness in the real world—both as an inventor and as a party defending its patents in litigation.

¹ Petitioner and respondent have both filed blanket letters of consent with the Court. No party or person other than *amicus* and its counsel authored any part of this brief or made a monetary contribution intended to fund the preparation or submission of this brief.

² Interval is controlled by Vulcan, Inc., the investing arm for Paul Allen.

SUMMARY OF ARGUMENT

Petitioner Nautilus, Inc.’s proposed standard for indefiniteness—under which an invention is patent-ineligible whenever a claim term “is susceptible of multiple reasonable interpretations to one skilled in the relevant art,” Pet. Br. 22—finds no support in practice, precedent, or common sense. Its adoption would critically undermine the balance of the patent system by depriving inventors of the ability to protect their work.

First and foremost, the linguistic precision Nautilus demands is essentially impossible, which is why the patent system has never required it. Overwhelmingly, words are susceptible of multiple meanings, and patents routinely use language that might support more than one reasonable interpretation—or at least, language that an adversary may describe as susceptible of multiple interpretations. Nautilus’ proposed standard transforms this inherent imprecision of language into a perpetual risk that a court will deem a patent claim indefinite.

Adopting Nautilus’ proposed standard would thus call into question innumerable patents in every area of innovation, and would make patent prosecution exceedingly difficult. The risk is substantial because patents have lengthy lifespans. It is highly likely that during that time period, a motivated challenger will be able to conjure some new interpretation of a claim term that a court may regard as reasonable. This is especially the case in emerging technological fields, where the vocabulary that describes inventions grows more precise as the discipline matures. Nautilus’ standard would make

it far more difficult for an inventor to obtain a patent, maintain its validity, and enforce it against an infringer—therefore undermining the value of both existing and future patents.

Nautilus' standard also conflicts with important and settled features of patent practice. For example, it is incompatible with the claim construction process, the purpose of which is to permit a court to evaluate various reasonable interpretations of a claim term and choose the best one. Nautilus' standard would render claim construction superfluous by requiring courts to reject, as indefinite, any claim that is susceptible of more than one reasonable interpretation in the first instance.

The upshot is that patent prosecution would become extremely difficult, and substantially more expensive. Inventors would likely resort to drafting more and more complex claims—making patents harder to understand, and far more costly to file. This would not only impose costs upon the inventors themselves (in the form of increased fees to attorneys and the U.S. Patent and Trademark Office (PTO)), but would also substantially increase the burden on the PTO to review labyrinthine submissions designed to address every possible embodiment of the invention.

Confronted with these challenges, at least some inventors will decide that the benefits of patent protection are likely to be so short-lived or uncertain that the effort and expense of seeking a patent in the first instance are not justified. That would deprive the public of valuable knowledge and slow the pace of innovation.

In the face of these negative consequences, Nautilus' efforts to synthesize its standard with current practice fall short. Contrary to Nautilus' submission, the PTO has consistently applied a far more permissive standard than Nautilus proposes here. The PTO thus does not find a patent claim term indefinite whenever it is "susceptible" of multiple reasonable interpretations. Instead, the PTO—consistent with the Federal Circuit and with common sense—finds a claim indefinite only if those interpretations are conflicting, or if the claim terms are so amorphous that they fail to provide any meaningful guidance. Even skilled lawyers routinely create ambiguity that is susceptible of multiple reasonable interpretations. Recognizing that claim language often may be construed in different ways, the PTO and the Federal Circuit focus on intrinsic evidence such as the specification to determine whether a term is so ambiguous as to invalidate the invention. This standard balances the public notice function of patents against the critical need to protect the value of inventions as technologies evolve.

Interval's own ongoing litigation illustrates all of these principles. Interval filed suit against several technology companies relating to Interval's patents (obtained in the year 2000) for an "attention manager," which is technology that presents information on a display, *e.g.*, a computer screen, in several ways—including alongside a user's primary interactions in "an unobtrusive manner that does not distract the user." The patent specification explains what the relevant claim terms mean.

The defendants in Interval's case implement pop-up notifications to users, often on smartphones,

informing them of new e-mails, text messages, and similar, alleging that these technologies infringe its attention manager patents. The defendants argued that the claim terms “unobtrusive” and “does not distract the user” are indefinite, citing factors—such as the color and size of the information displayed, and the attention span of a particular user—that have nothing to do with the claim terms as described in the patent specification. Nonetheless, the district court agreed with the defendants and held the claims indefinite.

In an appeal pending before the Federal Circuit, Interval argues that the district court erred by looking past the patent specification and importing its own subjective understandings of what it might mean for information to be “unobtrusive” or not “distracting.” It argues that when a patent specification explains the meaning of claim terms, the public notice function of a patent has been achieved. In the face of that intrinsic evidence, a court cannot invalidate a patent because it can imagine multiple ways to interpret a claim term, or imagine a circumstance under which a term might be vague.

Interval’s case is meaningfully different from the case before the Court in one critical respect: in this case, it is arguable that the patent specification fails to explain the nature of the spaced relationship claimed in the patent. That explanation may not have emerged until the reexamination process, where Dr. Lekhtman attempted to distinguish his invention from Fujisaki. But if Nautilus’ standard is adopted, its effects will not be limited to cases like this one. Instead, it will invite further errors like the district

court's in Interval's case. This Court should therefore reject Nautilus' proposed standard and affirm. But even if it does not, it should decide this case narrowly to avoid prejudicing cases, like Interval's, in which the specification provides the information necessary to understand the allegedly indefinite claim terms. The Court should expressly clarify that when read in the light of the specification, a claim term that may be susceptible of more than one reasonable interpretation may nevertheless be definite for purposes of 35 U.S.C. § 112, ¶ 2.

ARGUMENT

I. Strictly Prohibiting "Multiple Reasonable Interpretations" Of Claims Under The Definiteness Requirement Of 35 U.S.C. § 112, ¶ 2 Would Severely Limit Inventors' Ability To Adequately Protect Inventions And Would Undermine The Balance Of The Patent System.

Nautilus argues that any time a claim term is susceptible of multiple reasonable interpretations, the claim is indefinite and therefore invalid. Respondent's brief ably explains why Nautilus' standard is contrary to the text of the Patent Act and this Court's precedents. That standard is also contrary to settled patent practice. Its adoption would make patent prosecution exceedingly difficult, and disrupt the balance of the patent system.

A. Nautilus' Proposed Standard Is Exceptionally Difficult To Satisfy And Inconsistent With Settled Practice.

If courts apply the standard as Nautilus has stated it, it will threaten the validity of innumerable existing patents, and make it nearly impossible for inventors and attorneys to have any confidence in future patents. Words, by their very nature, are subject to varying interpretations. A patent attorney drafting a claim cannot hope to foresee each and every potential interpretation that might be given to each claim term over the many years in which the patent is in force,³ and then to decide which potential interpretations are reasonable and which are not. It is untenable to suggest that simply because a hostile third party can eventually conjure a meaning that differs from the meaning intended by the patentee (as evidenced by the intrinsic record) and from the meaning attributed by the PTO (which provides the basis for the presumption of validity), a court should invalidate a patent claim.

This Court has long been familiar with the exceptional difficulty that already exists in drafting claims that accurately describe an invention. The Court famously recognized many years ago that:

[t]he specification and claims of a patent,
particularly if the invention be at all

³ Patents issued from applications filed after June 8, 1995, have a term of 20 years from the effective filing date. 35 U.S.C. § 154(a)(2); MPEP § 2701. Citations to the MPEP in this brief are to the 8th edition, revision 9 (August 2012).

complicated, *constitute one of the most difficult legal instruments to draw with accuracy*, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention.

Topliff v. Topliff, 145 U.S. 156, 171 (1892).

This difficulty has only grown with time. Patent claims “have become highly technical in many respects as the result of special doctrines relating to the proper form and scope of claims that have been developed by the courts and the Patent Office.” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 389 (1996) (citations omitted). Compounding this growing difficulty is the fact that, for many cutting edge technologies in this age of “subatomic particles and terabytes,” *In re Bilski*, 545 F.3d 943, 1011 (Fed. Cir. 2008) (Rader, J., dissenting), at the time of drafting there may be no established words in the art that a patent attorney can rely upon to draft claims that precisely capture the intended invention.

Nevertheless, Nautilus asks this Court to impose its strict indefiniteness standard on top of these already-demanding requirements by requiring patent attorneys—at the threat of post-issuance invalidation—to somehow predict each and every interpretation that may be ascribed to their claims

that might be deemed “reasonable” by a court (perhaps a decade or longer in the future).

Nautilus’ standard also clashes with patent practice in at least two uniquely damaging ways.

First, Nautilus’ standard is so strict that it would render the *Markman* claim construction process obsolete, and would encourage parties to frustrate and manipulate that process as well. The purpose of the *Markman* process is for a judge to decide which of the proposed reasonable constructions of a patent term is correct. *See* 517 U.S. at 388. *Markman* hearings have thus played an integral role in fairly and accurately determining claim constructions in patent cases since *Markman* was decided.

If patent attorneys are required to draft claim terms with such exacting perfection that there can be only one reasonable interpretation, however, then there is no need for courts to construe the claims at all (other than for the exceedingly narrow purpose of rejecting unreasonable constructions).

On the other hand, Nautilus’ standard also gives rise to the possibility that any time an adversary makes a good-faith argument in the *Markman* process that a claim means something other than that proposed by the patent holder, the claim is indefinite. Consequently, Nautilus’ standard would encourage parties to attempt to frustrate the claim construction process by proposing as many diverse meanings as possible, in the hope that a court would find more than one “reasonable,” and would therefore find the claim indefinite. *See Amicus Br. of Am. Bar Ass’n* 19-20 (arguing that Nautilus’ standard would create an incentive for infringers to set forth multiple

constructions instead of a single “best” construction). That would undermine the purpose of the *Markman* process, upending patent litigation across the board—even in cases that today litigants do not conceive of as indefiniteness cases. Such a change highlights the very difficult, if not impossible, standard that Nautilus would have inventors and patent attorneys satisfy.

Second, Nautilus’ standard risks undermining the validity of claims that describe multiple embodiments of a single invention. This is because when a single claim describes multiple *embodiments*, it is not clear that Nautilus’ standard—which rejects as indefinite any claim susceptible of multiple reasonable *interpretations*—would regard the claim as indefinite.

Such claims, however, are common. Patent prosecutors attempt to draft claims that broadly cover the underlying inventive principle over a variety of embodiments, while avoiding covering the prior art. This process necessarily involves claim language covering a range of meanings. The result does not make a claim ambiguous; it simply makes the claim broad. *See, e.g., Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 1106 (Fed. Cir. 2004) (“It is a familiar axiom of patent law, however, that the scope of the claims is not limited to the preferred embodiments described in the specification.”); MPEP § 2173.02 (I) (“A broad claim is not indefinite merely because it encompasses a wide scope of subject matter . . .”).

Nautilus’ test, however, risks turning these axioms of patent law on their head, and effectively inserting a new narrowness requirement for patent claims. To the extent that Nautilus’s proposed

standard can be read as prohibiting claims that describe multiple embodiments of an invention, it should be rejected outright.

In sum, patent prosecutors already face a daunting task under the current indefiniteness standard. Imposing Nautilus' proposed standard on inventors and their attorneys would make the task of drafting claims exceptionally difficult, if not impossible.

B. Nautilus' Proposed Standard Would Significantly Increase Patent Prosecution Costs.

By adding complexity to the process and creating incentives for applicants to claim every possible embodiment of their inventions, Nautilus' proposed standard would also dramatically increase attorney fees and costs. The billable time involved in drafting and prosecuting dozens or even hundreds of claims per patent application, in addition to ensuring that each claim term has one and only one reasonable interpretation, would become prohibitively expensive for many inventors, particularly small entities.

In addition, a significant expansion in the number of claims filed per application would overload the already-backlogged PTO. *See* Paul R. Lawrence & Mark A. Abramson, *Paths to Making a Difference: Leading in Government* 111-14 (rev'd ed. 2011) (detailing the PTO's backlog woes). Examiners would now be required to examine dozens or hundreds of claims per patent application, ensuring that none of them has a single claim term with more than one reasonable interpretation. If an examiner were to discover more than one reasonable interpretation in

any claim, significant PTO and attorney time would be spent debating whether the examiner's multiple interpretations are truly reasonable—costs that would be multiplied many times over if the examiner finds multiple reasonable interpretations in multiple claims. Also, filing numerous claims inevitably results in restrictions, which requires filing divisional applications and further costs. This result also prolongs prosecution and runs counter to the PTO's goal of more efficient and compact prosecution. Adopting Nautilus' standard would clog the PTO with scores of claims and continuing applications, and would delay protection for inventions.

C. Nautilus' Proposed Standard Would Have A Chilling Effect On The Patent System.

The patent system is premised on encouraging inventors to willingly disclose details of inventions in exchange for a limited-time monopoly that prevents others from making, using, selling, and importing that which infringes the claims of the patent. *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1989) (“The federal patent system thus embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years.”).

A stricter interpretation of § 112, ¶ 2 would undermine that tradeoff and cause a chilling effect on the patent system, because—unless the inventor's attorney succeeds in the tremendously difficult task of drafting claims having one and only one reasonable

interpretation—the inventor will have disclosed the details of his invention to the world but will receive in exchange only a patent that is more likely to be invalidated when scrutinized post-issuance (with an adversary incentivized to scour the intrinsic record and a stack of dictionaries in search of any alternative meaning that might pass a “reasonableness” test) under Nautilus’ proposed standard.

This is no idle threat. Patent attorneys and PTO examiners will have difficulty identifying any and all reasonable interpretations of a claim and amending the claims to exclude all such interpretations. And new potential interpretations may arise after the patent issues in response to further developments in related technology areas. During post-issuance litigation, a hostile third party with large numbers of attorneys spending many hours on the case will have little trouble conjuring some reasonable interpretation that the time-pressured attorney and examiner did not. Indeed, there will be few cases in which a hostile third party cannot identify at least one alternative, reasonable construction for a claim term. If that suffices to render the claim indefinite, inventors will no longer be incentivized to disclose their inventions to the world. *See Bonito Boats*, 489 U.S. at 150-51.

And once a patent issues, the already-high cost of patent litigation will increase further. Lawyers trying to invalidate a patent concoct arguments showing that a term may be susceptible of multiple reasonable meanings, and lawyers for the patent holder attempt to fend off such requests. Instead of focusing on the proper inquiry of what a term

actually means, both sides and the court instead will turn to the collateral question of whether a term could have multiple reasonable interpretations—even if only one is correct.

D. Nautilus’ Proposed Standard Conflicts With The PTO’s Practice.

In an effort to minimize the negative consequences of applying its standard, Nautilus cites the PTO’s purported application of its proposed indefiniteness standard to argue that applying the same standard in court would impact inventors only minimally. Pet. Br. 45. Specifically, Nautilus cites *Ex Parte Miyazaki*, Appeal No. 2007-3300, at 11-12 (B.P.A.I. Nov. 19, 2008) and MPEP § 2173.02 (I) as requiring examiners at the PTO to use Nautilus’ proposed indefiniteness standard when examining patent applications. In so doing, however, Nautilus overstates the impact that *Miyazaki* and MPEP § 2173.02 (I) have had on the PTO’s handling of indefiniteness rejections, and it provides no evidence showing how the PTO enforces the standard as a practical matter.

Contrary to Nautilus’ characterizations, both *Miyazaki* and MPEP § 2173.02 (I) contain permissive language that suggests a judicious and reasonable application of the standard. *See Miyazaki*, Appeal No. 2007-3300, at 11-12 (stating that the PTO “is justified” in deeming a patent indefinite if it is amenable to two or more plausible constructions); MPEP § 2173.02 (I) (stating that a rejection for indefiniteness is only appropriate if a person of ordinary skill in the art necessarily “would read it with more than one reasonable interpretation”).

These word choices are important—*Miyazaki* never requires the PTO to reject a claim merely because multiple reasonable interpretations are possible, and the MPEP does not give the examiner license to reject claims as indefinite merely because a person of ordinary skill in the art *could* come up multiple interpretations if given an incentive to do so (*e.g.*, invalidating a patent asserted against him or her).

Consistent with the permissive language of *Miyazaki* and MPEP § 2173.02 (I), the PTO in practice applies *Miyazaki* strictly to find patent terms indefinite only where a claim limitation evokes two entirely inconsistent or irreconcilable things or where a claim limitation is so amorphous or undefined that lacks any apparent meaning. *See, e.g., Ex Parte Mann*, Appeal No. 2009-011798, at 7 (P.T.A.B. Jan. 29, 2012) (“Because claim 29 is amenable to two reasonable *and inconsistent* meanings, it is indefinite.”) (emphasis added). The PTO does not routinely reject claims as indefinite simply because the claim—without reference to the specification—allows for a range of possible meanings that broadly cover a variety of embodiments relating to a common inventive principle. Only where the possible meanings are contradictory or incompatible with each other or simply indeterminable does the PTO impose this requirement.⁴

⁴ The American Intellectual Property Law Association agrees: “To show that the claim does not have an established meaning, the constructions proposed by each party must be equally valid under the claim’s phrasing and in conflict.” *Amicus Br. of Am. Intellectual Prop. Law Ass’n* 12.

A review of recent Patent Trial and Appeal Board (PTAB)⁵ decisions citing *Miyazaki* from 2013 and 2014 confirms that the PTO applies the indefiniteness requirement in a manner substantially different from that suggested by *Nautilus*. In many of these cases, the PTAB applied the stricter *Miyazaki* standard because the claim language contained syntax errors that could not be resolved and thus gave rise to multiple conflicting interpretations. In the remaining cases, the claim language contained terms that were so open-ended that—even in light of the specification—their metes and bounds could not reasonably be determined. For instance, in a recent decision citing *Miyazaki*, the PTAB rejected a claim as indefinite under the stricter standard because the claim contained a modifying phrase whose object could not be determined. *See Ex Parte Loo*, Appeal No. 2011-011015, at 10-11 (P.T.A.B. Mar. 4, 2014). In another recent case, the PTAB issued an indefiniteness rejection because the claims contained the phrase “expanded rear end” but did not identify what the rear end was “expanded” relative to, nor did the specification provide helpful guidance. *Ex Parte Grant*, Appeal No. 2011-006841, at 3-5 (P.T.A.B. June 27, 2013). And the PTAB has found claims indefinite when they use terms of degree without any helpful guidance from the specification to determine the bounds of those terms. *See Ex Parte Baker*, Appeal No. 2010-001513, at 6-8

⁵ Effective September 2012, the PTAB replaced the Board of Patent Appeals and Interferences in accordance with the America Invents Act. 35 U.S.C. § 6(a).

(P.T.A.B. June 28, 2012). No recent PTAB case citing *Miyazaki*, however, has applied the standard in the sweeping manner that Nautilus proposes.

If the PTO had been applying the *Miyazaki* standard as strictly as Nautilus suggests, its long-standing practice of determining the “broadest reasonable construction” of a claim during examination, MPEP § 2111, would effectively have been eviscerated. After all, any claim term that has a “broadest reasonable construction” must, by definition, have more than one reasonable interpretation. Given that the PTO evaluates patentability by applying the “broadest reasonable construction” standard to literally scores of patent applications every day, one would expect that a strict application of the *Miyazaki* standard as Nautilus proposes would result in vast numbers of patent applications being rejected on indefiniteness grounds. But Nautilus has not provided any evidence that this is the case.

Thus, Nautilus proposes a stricter standard than the *Miyazaki* standard applied at the PTO—one that would have substantially greater consequences for the ability to draft claim terms than Nautilus suggests. What Nautilus has in mind with a sweeping prohibition of “multiple reasonable interpretations” is inconsistent with and is much more restrictive than the present reality at the PTO. Adopting Nautilus’ proposed standard would thus mark a significant and ill-advised departure from patent prosecution practice as it exists today.

II. In Resolving This Case, The Court Should Make Clear That The Patent Specification Will Frequently Clarify Claim Terms In A Manner That Renders Them Definite.

The foregoing establishes some of the risks inherent in adopting sweeping changes to the well-established standard for indefiniteness. As a further illustration, the application of that standard is currently at issue in a Federal Circuit appeal between Interval and several technology companies. *See Interval Licensing LLC v. AOL, Inc., et al.*, Nos. 2013-1282, -1283, -1284, -1285 (Fed. Cir.). That litigation is an important illustration of the legal question presented by this case because the specification in Interval's patents contains the information necessary to establish the scope of Interval's invention. Here, by contrast, Nautilus argues that information was missing until Dr. Lekhtman attempted to distinguish his invention from the Fujisaki patent during the reexamination process.⁶ However this Court decides the case before it, it should refrain from announcing a rule that

⁶ Interval is not alone in recognizing the importance of the specification. Nautilus itself concedes, as it must, that "[c]laims . . . must be 'construed in light of the specifications.'" Pet. Br. 35 (quoting *United States v. Adams*, 383 U.S. 39, 48-49 (1966)). It also argues that the Lekhtman patent's claims are indefinite because of "the absence in the specification of any concrete description or illustration of the necessary spacing." *Id.* 52. Dr. Chakrabarty likewise emphasizes "the complementary roles of the specification and the claims." *Amicus* Br. of Dr. Ananda M. Chakrabarty 4; *see also id.* 34 (arguing that Lekhtman's invention was not "disclosed in the specification").

would undermine the many patents—like Interval’s—that contain specifications providing substantial guidance on the meaning of claim terms.

A. Description Of Interval’s Patents.

In the years 1996 and 2000, as the Internet boom began, Interval’s predecessor in interest, Interval Research, filed applications for two patents—U.S. Patent Nos. 6,034,652 (filed Mar. 22, 1996) (the ‘652 patent) and 6,788,314 (filed Mar. 20, 2000) (the ‘314 patent)—for an “attention manager,” which “presents information to a person in the vicinity of a display device that engages at least the peripheral attention of the person.” ‘652 patent, at [57]; ‘314 patent, at [57]. In layman’s terms, the attention manager displays information to the user of a display—*e.g.*, a computer display, or a cellular phone display—that the user may find interesting, even if the user did not necessarily request that specific information at that specific time. As the patents explain, “[g]iven the extent to which computers now permeate society . . . there is increasing recognition of the capability of using computers, and, in particular, computers (and other devices) that are interconnected in a network, as an information dissemination tool that can satisfy the interests of both information providers and information consumers.” *E.g.*, ‘652 patent col. 1 ll. 19-27.

The ‘314 and ‘652 patents have substantively identical specifications, which explain that the attention manager “makes use of the ‘unused capacity’ of the display device” to display pertinent

additional information to users. *Id.* at col. 2 ll. 7-9.⁷ The specification provides two examples of “unused capacity.” First, the attention manager can display information “while the apparatus (*e.g.*, computer) is operating, but during inactive periods (*i.e.*, when a user is not engaged in an intensive interaction with the apparatus).” *Id.* at col. 2 ll. 9-12. Second, the attention manager can display information “during active periods (*i.e.*, when a user is engaged in an intensive interaction with the apparatus), but in an unobtrusive manner that does not distract the user from the primary interaction with the apparatus (*e.g.*, the information is presented in areas of a display screen that are not used by displayed information associated with the primary interaction with the apparatus).” *Id.* at col. 2 ll. 12-19.

Of course, the patents also claim these features. Thus, they claim that the attention manager will, among other things, “selectively display, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from a set of content data.” *E.g.*, *id.* at col. 29 ll. 41-55; *see also* ’314 patent col. 29 ll. 60-67.

B. Procedural History Of Interval’s Lawsuit To Enforce Its Patents.

In August 2010, Interval filed suit against various technology companies, alleging, among other things, that their technologies for displaying pop-up

⁷ Because the specifications are substantively identical, this brief will cite to the ’652 patent for the sake of brevity.

notifications to users infringe on its patents. While such notifications were quite novel when Interval patented the technology, they became ubiquitous in the smartphone era as a means to display new e-mails, text messages, social media updates, breaking news, and similar snippets of useful information in a non-distracting manner. Because these technologies display information alongside the user’s primary activity, Interval alleged that they infringed the version of its invention that displays information “during active periods . . . but in an unobtrusive manner that does not distract the user from the primary interaction with the apparatus (e.g., the information is presented in areas of a display screen that are not used by . . . the primary interaction.)” ’652 patent col. 2 ll. 12-19. The litigation was stayed after the defendants filed reexamination requests at the PTO. The PTO subsequently confirmed the patentability of the asserted claims in both the ’314 patent and the ’652 patent—the former in an adversarial *inter partes* proceeding brought by one of the defendants.

The district court then lifted the stay, and the case proceeded to claim construction. The defendants argued that the phrase “in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus” was indefinite. *See Interval Licensing, LLC v. AOL, Inc.*, No. C10-1385MJP, 2013 WL 792791, at *6 (W.D. Wash. Feb. 28, 2013). Interval argued, by contrast, that “in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus” means “[d]uring a user’s primary interaction with the apparatus and the information is

presented in an area of the display screen not substantially used by displayed information associated with the primary interaction of the user.” *Id.*

The district court agreed with the defendants, holding that the claim term “in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus” was indefinite, and that a means-plus-function limitation containing that same term was likewise indefinite due to the lack of a sufficient description of the corresponding structure in the specification. *See id.* at *3-*5. The court reasoned that the phrase “in an unobtrusive manner” is indefinite because “the same image may or may not be considered unobtrusive depending on a variety of factors, such as color, size, and information displayed.” *Id.* at *3. It also concluded that the phrase “does not distract” is indefinite “because whether something distracts a user from his primary interaction depends on the preferences of the particular user and the circumstances under which any single user interacts with the display.” *Id.* at *4.

Interval had addressed this contention by pointing to the specification of its patents. The patents explained that displaying information in an unobtrusive, non-distracting manner meant presenting the information “in areas of a display screen that are not used by displayed information associated with the primary interaction with the apparatus.” *E.g.*, ’652 patent col. 2 ll. 17-19; *see also id.* at col. 6 ll. 38-45. The patents further explain that the invention thus utilizes the “unused capacity” of the computer in order to display information to the

user, and “unused capacity” is “defined broadly to include, for example, . . . spatial . . . dimensions,” *i.e.*, unused space on a display screen. *Id.* at col. 6 ll. 45-51. The district court, however, disagreed, and ruled the claim terms indefinite.

On appeal, Interval argues that its claims cannot be deemed indefinite in light of the specification. Specifically, it argues that “[a] display in an ‘unobtrusive manner that does not distract a user’ is one positioned in an area of the display screen not substantially used by the user’s primary activity.” Br. for Interval 22, *Interval Licensing LLC v. AOL, Inc. et al.*, No. 2013-1282 (Fed. Cir.). It further argues that the district court erred by focusing on a multitude of factors that the specification never discusses—*e.g.*, the color, shape, and size of the information displayed, or whether the user of the device has a particularly high or low ability to focus. *See id.* 28-30. These factors—which may relate to whether an image is “unobtrusive” or “distracting” in a colloquial sense—were never relevant to Interval’s invention and do not appear in the specification. The district court erred by reading those terms without reference to the specification.

C. Interval’s Lawsuit Demonstrates The Importance Of Referring To Intrinsic Evidence, Such As A Patent’s Specification, To Evaluate The Definiteness Of Claim Terms.

Interval’s appeal highlights the dangers posed by Nautilus’ standard for indefiniteness. Adopting Nautilus’ standard—which requires courts to invalidate a patent any time multiple reasonable

interpretations of a claim term are possible—would invite errors like the district court’s error in Interval’s case. It would encourage courts to inject their own uncertainty about the meaning of claim terms into a patent dispute, focusing on irrelevant contingencies in order to find vagueness where none exists. Indeed, under Nautilus’ standard, if any expert testifies that a term has multiple reasonable meanings, a question of indefiniteness may exist.

As the American Intellectual Property Law Association explains, “[a] patent claim is part of a larger specification of the invention Understanding the scope of a patent claim thus requires . . . a jurist asked to rule on invalidity [] to read the claim language in light of the entire specification.” *Amicus Br. of Am. Intellectual Prop. Law Ass’n* 5-6. Nautilus’ standard, however, demands such a high degree of certitude that a court could always find indefiniteness—regardless of what a patent’s specification says. A court could do so by doing what the district court did in Interval’s case: either hold that the specification does not address some extraneous source of ambiguity concocted by an infringer, or hold that the specification itself is susceptible to multiple reasonable interpretations, so that it does not establish that the claim terms can only be construed one way.

Thus, under Nautilus’ standard, the mere fact that terms like “unobtrusive” and “does not distract” are susceptible of multiple reasonable meanings—even if those meanings do not contradict each other, and even if the patent specification sheds substantial light on the meaning of those terms in the context of the relevant invention—could be sufficient to render

the claims indefinite. As a result, Interval's important patent, and countless others like it, could be invalidated. As the American Bar Association explains, Nautilus' "inflexible standard" would undermine a "patent system that protects innovation." *Amicus Br. of Am. Bar. Ass'n* 10.

The problem would be especially acute in cases, like Interval's, in which the inventor obtained a patent while the entire genre of technology was still nascent and experiencing substantial breakthrough and upheaval, so that the relevant vocabulary was underdeveloped. In such cases, it would be relatively easy, in hindsight, for competitors to recharacterize a patent as being vague because it appears to be so in light of new, more sophisticated terminology. *See, e.g., Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1362 (Fed. Cir. 1983) (explaining that a patentee is not required to "predict all future developments which enable the practice of his invention in substantially the same way.").

But the difficulties would by no means be limited to cases involving nascent technologies. Indeed, almost any patent that uses an adjective in one of its claims would face the threat of subsequent invalidation under Nautilus' standard, because reasonable minds frequently can apply multiple interpretations to almost any adjective. Innumerable patents include terms like "easily," "readily," "substantially," and "near," all of which could be interpreted in multiple ways, and all of which have been found valid when read in light of the relevant specifications. *See, e.g., Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1360 (Fed. Cir. 2012); *Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357, 1366

(Fed. Cir. 2010); *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1336 (Fed. Cir. 2010); *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1346-47 (Fed. Cir. 2007). The public does not gain by effectively banning such words from patents. Indeed, in many inventions, the amount of precision is irrelevant. And, as explained in Part I, such a rule would deter patent applications and disserve innovation.

Consequently, this Court should tread lightly before accepting any change to the standard for indefiniteness. Indeed, the best change in this case is no change, as the claims construction process and a focus on the patent specification already solve the public notice concerns raised by *Nautilus* and its *amici*. At a minimum, however, this Court should continue to allow litigants to define patent terms by reference to the intrinsic evidence of a patent such as the specification. If it is possible to glean a meaning of the term from the intrinsic evidence, a patent claim term is not indefinite.

CONCLUSION

For the foregoing reasons, the court of appeals' decision should be affirmed.

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