

No. 2012-1014

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

LIGHTING BALLAST CONTROL LLC,
Plaintiff-Appellee,

v.

PHILIPS ELECTRONICS NORTH AMERICA CORPORATION,
Defendant
and

UNIVERSAL LIGHTING TECHNOLOGIES, INC.,
Defendant-Appellant.

Appeal from the United States District Court
for the Northern District of Texas in
Case No. 09-CV-0029, Judge Reed O'Connor.

**BRIEF OF THE INTELLECTUAL PROPERTY LAW ASSOCIATION OF
CHICAGO AS *AMICUS CURIAE* SUPPORTING NEITHER PARTY**

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May 28, 2013

CERTIFICATE OF INTEREST

Counsel for The Intellectual Property Law Association of Chicago as *amicus curiae* (“IPLAC”) certifies the following:

1. The full name of every party or amicus represented by me is:

The Intellectual Property Law Association of Chicago

2. IPLAC submits this brief *amicus curiae* and has no interest in the outcome of the case.

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

Law firms	Banner & Witcoff, Ltd. and
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Partners or Associates of Banner & Witcoff, Ltd.	Charles W. Shifley
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May 28, 2013

/s/ Charles W. Shifley
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I. STATEMENT OF INTEREST

The Intellectual Property Law Association of Chicago (“IPLAC”) submits this brief in support of neither party.¹

Founded in 1884, IPLAC is the nation’s most senior intellectual property law association. It has approximately 1,000 members, who represent a spectrum of the intellectual property law profession ranging from law firm attorneys to sole practitioners, corporate attorneys, law school professors, and law students. IPLAC is in Chicago, a principal forum for U.S. patent litigation. IPLAC members prosecute thousands of patent applications and litigate many patent lawsuits in Chicago and across the country.^{2, 3}

IPLAC is not-for-profit. A principal aim is to aid in the development and administration of intellectual property laws and the manner in which they are

¹ Amicus Curiae, IPLAC, states that this brief has not been authored in whole or in part by counsel for a party and that no person or entity, other than Amicus, its members, or its counsel, has made a monetary contribution to the preparation or submission of this brief.

² In addition to the required statement of footnote 1, IPLAC adds that after reasonable investigation, IPLAC believes that (a) no member of its Board or Amicus Committee who voted to prepare this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (b) no representative of any party to this litigation participated in the authorship of this brief, and (c) no one other than IPLAC, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

³ While over 30 federal judges are honorary members of IPLAC, none was consulted on or participated in this brief.

applied by the courts and the United States Patent and Trademark Office. Purposes include making “more definite, uniform and convenient the rules of practice in the courts” in relation to the patent law.⁴

IPLAC is the source of Manzo, *Patent Claim Construction in the Federal Circuit*, published in annual editions including the current 2012 edition. This book of the IPLAC Litigation Committee reviews the law of precedential and non-precedential Federal Circuit claim interpretation cases each year.

II. ARGUMENT

A. **Question a.: Should This Court Overrule *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998)?**

Whether this Court should overrule *Cybor* depends on the meaning of the question. If the question is whether the Court should overrule *Cybor* to the extent of its holding that claim interpretation is purely legal in nature, the IPLAC answer is no. If the question asks whether the Court should overrule *Cybor* to the extent it holds that the Court will review the ultimate issue of claim construction in the district courts *de novo*, the IPLAC answer is no. If the issue is whether the Court should overrule *Cybor* to the extent it holds that the Court will review *de novo* all parts of each claim interpretation in the district courts where errors are asserted in

⁴ IPLAC is also dedicated to maintaining a high standard of professional ethics in the practice of law, and further dedicated to providing a medium for the exchange of views on intellectual property law among those practicing in the field and to educating the public at large.

appeals, the IPLAC answer is yes – the Court should overrule *Cybor* to the extent it holds that the Court will review *de novo* all aspects of claim interpretations in the district courts where errors are asserted in appeals.

Cybor is correct to the extent it holds that claim interpretation is a question of law. It is also correct to the extent it resolves that the Court is to review the ultimate issue of claim construction in decisions of the district courts *de novo*. Both of these holdings are dictated not by *Cybor* itself, but by “*Markman II*,” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). As *Cybor* concluded, *Markman II* answered the question whether the interpretation of a patent claim is a matter of law reserved entirely for the court, or subject to a Seventh Amendment guarantee, “by stating that ‘the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.’” 138 F.3d at 1455. As *Cybor* further concluded, “[n]othing in the Supreme Court’s opinion supports the view that the Court endorsed ... that claim construction may involve subsidiary or underlying questions of fact.” *Id.*

These two conclusions could arguably lead summarily to the opposite of the answer to question a. that IPLAC advocates. They could lead to the decision that no aspect of district court claim interpretation may ever be subject to anything

other than *de novo* review, absent Supreme Court modification of *Markman II*.⁵ The two conclusions, however, do not end the potential to overrule *Cybor in part* to the benefit of this Court, the judicial system, and the patent law.⁶

In some instances, there are appellate issues that are both issues of law and subject to deferential review. An example is provided by *Pierce v. Underwood*, 487 U.S. 552 (1988). *Pierce* involved the Equal Access to Justice Act, and whether a government position was not justified, such as to result in an award of fees. *Id.* The Supreme Court expressly stated that it had before it as the “present one,” a case that was to be decided “ultimately ... upon evaluation of the purely legal issue governing the litigation.” *Id.* at 560. It resolved, however, that the case was to be decided with a deferential standard of review. *Id.* at 563.

Lest *Pierce* be misunderstood, the Supreme Court clarified what *Pierce* decided, in *Cooter v. Hartmarx*, 496 U.S. 384 (1990). *Cooter* at 403 stated: “*Pierce* also concluded that the district court’s rulings on legal issues should be reviewed deferentially. See *id.*, at 560-561.” Thus, by express Supreme Court statement,

⁵ Consistent with *Markman II*, Federal Rule of Civil Procedure 52 is not pertinent. FRCP 52 “does not apply to conclusions of law.” *Pullman-Standard v. Swint*, 456 U.S. 273 (1982)(holding that Title VII discriminatory intent is an issue of fact).

⁶ Readers who are convinced *Markman II* does not restrict or inhibit this Court in establishing its standard of review for claim interpretation may jump to section B. Question b.

Pierce reflects an instance where an issue is both an issue of law and subject to deferential review.

Pierce is not alone. *Cooter* reflects another such issue. *Cooter* involved sanctions. *Id.* at 388. A disagreement of the circuits was under review: “The scope of disagreement over the appropriate standard of review can thus be confined to a narrow issue: whether the court of appeals must defer to the district court’s legal conclusions in a Rule 11 proceeding.” *Id.* at 401. Resolving this, *Cooter* concluded: “[A]n appellate court should apply an abuse-of-discretion standard in reviewing all aspects of a district court’s Rule 11 determination.” *Id.* at 405.

Thus, by a pattern of two Supreme Court examples, the understanding can be reached that it is possible both to categorize an issue as one of law, as in *Cybor*, and yet nevertheless have a deferential standard of review for some part or even all of it. Importantly, issues which have been characterized as issues of law *by the Supreme Court itself*, just as the issue of claim interpretation was characterized in *Markman II*, are issues that may nevertheless have a deferential standard of review.

In considering whether an issue was one of fact or law, *Miller v. Fenton*, 474 U.S. 104 (1985) cited as a source of wisdom H. Monaghan, Constitutional Fact Review, 85 Columbia L. Rev. 229 (1985). Professor Monaghan is the Harlan Fiske Stone Professor of Constitutional Law at Columbia Law School, and has “long [been] considered one of the nation’s leading constitutional law scholars and top

experts on federal jurisdiction.” *E.g.*, <http://www.law.columbia.edu/alumni/news/2010/02/henry-monaghan>.

Monaghan counsels that categorizing an issue as fact or law is not dispositive of who should decide it:

[C]onfusion exhibited in judicial opinions over law and fact stems from two sources. First, courts assume that the properly affixed characterization necessarily determines which legal actor is assigned the decisionmaking task. Second, the two categories have been used to describe at least three distinct functions: law declaration, fact identification and law application.

To be sure, the categories of law and fact have traditionally served an important regulatory function in distributing authority among various decisionmakers in the legal system. But there is no imperative that a properly affixed characterization necessarily controls allocation of function.

Id. at 234.

This is counsel for which the Supreme Court cited Monaghan. *Miller* at 113.⁷ The Supreme Court itself stated that in the discernment of the fact/law distinction, the matter has at times turned on a determination as to which judicial actor was better positioned to decide an issue. *Id.* Thus, as in the Supreme Court’s cited source of wisdom, just because this Court and the Supreme Court have

⁷ This Court’s panel decision in *Bard Peripheral Vascular, Inc. v. W.L. Gore & Associates, Inc.*, 682 F.3d 1003, 1006, 1008 (Fed. Cir. 2012), after en banc return to the panel, also found wisdom in Monaghan’s point, and cited *Miller* and *Ornelas v. United States*, 517 U.S. 690 (1996) for the point. *Ornelas* in turn relied on *Miller*, 517 U.S. at 701.

categorized claim interpretation as an issue of law does not mean that it is imperative that this characterization should necessarily control allocation of all parts of the decisionmaking to all levels of the courts without deference one to another. As Monaghan at 235, 237 explains, the “allocative uses” of categories of issues should be separated from the “analytical content” of the categories. That is:

“it seems misguided to assume, as many courts apparently do, that all law application judgments can be dissolved into either law declaration or fact identification. ... The real issue is not analytic, but allocative: what decisionmaker should decide the issue? Our system has not proceeded on the premise that judges, to say nothing of appellate judges, must render independent judgment on all law application.”

Monaghan captures the point: even with claim interpretation categorized as an issue of law, this Court does not necessarily need to render independent judgment on all disputed aspects of claim interpretation. To the extent *Cybor* is understood to hold otherwise, this Court has within its power to retain the broader, correct principles of *Cybor*, but revisit and overrule *Cybor* on some aspects of retaining *de novo* review versus providing deference for some parts of claim interpretation.

B. Question b.: Should This Court Afford Deference To Any Aspect Of A District Court’s Claim Construction?

No deference is advisable on the ultimate issue of claim interpretation. It is difficult to imagine disagreement. This Court was created for the purpose of

promoting uniformity, and liberal deference in appellate review of claim construction would militate against that purpose. The trial court function under consideration is determining meanings of legal documents. Claim interpretation is often the single most significant issue in a patent case. See *e.g.*, *Markman v. Westview*, 52 F.3d 967 (Fed. Cir. 1995), *aff'd.*, 517 U.S. 370 (1996) (“[C]hoosing between contending interpretations of a claim can decide the matter of infringement for all intents and purposes.”) As in Manzo, *Patent Claim Construction in the Federal Circuit*, §1:3 (2012), where there is a dispute,

claim interpretation is required before determining issues such as infringement, anticipation, obviousness, invalidity over alleged on-sale activity, compliance with the written description requirement, ... inventorship, ... obviousness-type double patenting, ...whether a parent application supports the claims ... ‘almost always a prerequisite’ to granting a preliminary injunction ... when determining whether amendments made during a postissuance PTO proceeding enlarged the scope of a claim ... when determining the validity of a certificate of correction ... in inequitable conduct proceedings ... [and] incident to determining whether a claim is directed to statutory subject matter

As in D. Schwartz, *Practice Makes Perfect? An Empirical Study of Claim Construction Reversal Rates in Patent Cases*, 107 Mich.L.Rev. 223, 228 (1980), “claim construction is often the make-or-break determination.” Given all of *Markman II*, the purposes of the Court, the function under consideration, and the importance of the matter, even when testimony is received and evidence has to be

weighed, no deference is appropriate to the ultimate determination of claim interpretation.

But if “[t]he real issue is not analytic, but allocative: what decisionmaker should decide the issue?” see Monaghan, then considerations such as those that guided the Supreme Court in *Pierc, Cooter and Miller*, as articulated by Monaghan, can be brought to bear to provide a framework for analysis as to whether this Court should review *de novo* each and every aspect of the claim interpretations that come before it from the district courts.⁸

As Monaghan at 268 states as a starting principle, “the ‘importance’ of [the matter] does not yield a solid basis for ... fact review.” Thus, the importance of claim interpretation is not the place to start. Instead, two significant “institutional concerns” that “stand out” can “yield a solid basis for ... fact review,” and the concerns can be “the danger of systemic bias of other actors in the judicial system,” and “the perceived need for a case-by-case development of the law in a given area.” *Id.*

As with a Monaghan example at 272 of coerced confessions in criminal cases, a premise that district courts are to be suspected of distorted fact finding and law application in patent claim interpretation can be disquieting. But as with the

⁸ Of course, specific issues put aside by the parties by their exclusion of them from their appeals should also be put aside by the Court.

Monaghan example, reality intrudes. Something approaching half of all district court claim interpretations have been reversed in this Court. K. Moore, *Markman Eight Years Later: Is Claim Construction More Predictable?*, 9 Lewis & Clark L. Rev. 231, 246-247 (2005) (citing 34.5% reversal rate for 1996-2003). Reversals on even simple matters continue to this day. See e.g., *Douglas Dynamics, LLC v. Buyers Products Co.*, No. 2011-1291 (Fed. Cir. May 2, 2013)(reversal, as to the meaning of “connected” in a mechanical context). If reversals reflect a future danger of systemic bias in one or more aspects of interpretation, it is in that aspect or those aspects that the Court should retain *de novo* review. If reversals do not reflect danger in other aspects, then the other aspects can be left to discretion.

Monaghan at 273 considers a perceived need for case-by-case development of norms as likely the “single most important trigger” for fact review:

Where such norms are in a process of development, the Court must examine enough factually similar situations to formulate an acceptable norm.” [N]orm evaluation occurs best when the Court has power to consider fully a series of closely related situations.

If such a matter or matters exists in interpretation, the Court should retain *de novo* review as to that matter/those matters.

Miller at 114 applies Monaghan’s two “stand out” “institutional concerns.” In the articulation in *Miller*, *de novo* review is appropriate as a matter of one judicial actor – not the factfinder – being better positioned where “the relevant legal principle can be given meaning only through its application to the particular

circumstances of a case,” and “as a means of compensating for ‘perceived shortcomings of the trier of fact by way of bias or some other factor ...’” In contrast, *id.* at 115:

“other considerations often suggest the appropriateness of resolving close questions ... in favor of extending deference to the trial court. When, for example, the issue involves witness credibility and therefore turns largely on an evaluation of demeanor, there are compelling and familiar justifications for leaving the process of applying law to fact to the trial court and according its determinations presumptive weight.”

Pierce follows *Miller*. 487 U.S. at 559. *Cooter* follows *Pierce*. 496 U.S. at 403.

There is sense, therefore, in considering whether district courts experience shortcomings or bias in one or more aspects of claim interpretation. If so, it is in that aspect or those aspects that the Court should retain *de novo* review. If district courts do not experience shortcomings or bias in other aspects, then the other aspects can be left to discretion.

There is also sense in considering whether there is a perceived need for case-by-case development of norms such that the Court should be examining enough factually similar situations to formulate an acceptable norm.

In contrast, there is sense in leaving to the district courts aspects of claim interpretation that involve the credibility of witnesses and turn largely on an evaluation of demeanor.

C. Question c.: If So, Which Aspects Should Be Afforded Deference?

The ultimate issue, then, is this question c. In answer, IPLAC suggests that the Court should review underlying facts arising from intrinsic and extrinsic evidence as to whether they are clearly erroneous, and review the import of the facts *de novo*.

1. The Court Should Review Underlying Facts Arising from Intrinsic Evidence For Clear Error

As between district courts and this Court, this Court need not take the lead in the review of underlying facts arising from intrinsic evidence. It would seem the matter could be easily put aside. If the import of underlying facts is separated from the underlying facts themselves, the district courts are at least as well situated as this Court to decide the facts of intrinsic evidence – *e.g.*, what claim terms were used, how they related to other terms, what the specification stated by the use of such terms or equivalent terms, whether the terms were used to describe the invention or preferred embodiments, whether there were amendments or arguments affecting claim scope, etc. The intrinsic record is a written record. There would seem to be little chance that a district court could err as to the facts of the intrinsic record – the import of the facts set aside – without the error being clear. As well, there is not a perceived need for case-by-case development of norms such that the

Court should be examining enough factually similar situations to formulate an acceptable norm, as to the content of the intrinsic record.

2. The Court Should Review the Import of Underlying Facts *De Novo*

As between district courts and this Court, however, this Court should take the lead in the review of the *import* of underlying facts – in judging their significance, as the judicial actor *far* better positioned than the district courts to do so successfully. First, this Court is steeped in patent claim interpretation; it lives patent law every day. It is a court of patent experience. See *Dickinson v. Zurko*, 527 U.S. 150, 163 (1999) (“[A] Federal Circuit judge [judges] through the lens of patent-related experience ... expertise ...”) As in *Manzo* 2012 at §§7:3, 7:4 and 2011 at §6:2, the Federal Circuit heard 152 claim interpretation cases in 2010-11. As at *Manzo* 2012 §7:3 combined with *Manzo* 2011 §6:2, current Federal Circuit judges wrote majority opinions in 2010-11 in these numbers: Rader 17, Newman 6, Mayer 1, Plager 1, Lourie 22, Schall 4, Bryson 16, Linn 16, Dyk 13, Prost 9, Moore 17, O’Malley 3, per curiam 15. Rare is the federal district court judge who has anything approaching the Court’s high facility in the details of claim interpretation issues by dint of experience.

The more long-term experience levels of the Court’s judges are also impressive. The Chief Judge has been with the Court since 1990. His law school

patent law teaching has been extensive and worldwide. Other judges have been with the Court since as early as 1984. Several were patent examiners and/or patent attorneys, some with higher level positions in law firm intellectual property groups and at corporations invested in scientific research. Several hold science degrees, including some advanced degrees, and several were research scientists. One presided over more than one hundred patent and trademark cases as a district judge before appointment to the Court. One was a prominent law school professor in intellectual property. Numerous additional distinguished credentials, as well as the foregoing, attach to the present Court. (To the extent the judges are newer, they are able to stand on shoulders.)

The Court also has a tradition of distinction in patent matters, ranging from its first judges including its first Chief Judge and their many advanced and important decisions starting with *South Corp. v. United States*, 690 F.2d 1368 (Fed. Cir. 1982), through the Court's many more recent advanced and outstanding decisions on subjects including claim interpretation itself, patent ownership, infringement, willfulness, validity, inequitable conduct, patent exhaustion and the like, such as "*Markman I*," i.e., *Markman v. Westview*, 52 F.3d 967 (Fed. Cir. 1995), aff'd.; *Bd. of Trust. of Leland Stanford v. Roche*, 583 F. 3d 832 (Fed. Cir. 2009)(patent ownership), aff'd., 131 S.Ct. 2188 (2011); the opinion of Judge Nies in *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F. 3d 1512 (Fed.

Cir. 1995)(limitation-by-limitation equivalents), adopted in part in *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 520 U.S. 17 (1997); *SEB S.A. v. Montgomery Ward & Co.*, 594 F.3d 1360 (Fed. Cir. 2010) (induced infringement), *aff'd.*, *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060 (2011); *Akamai Technologies Inc. v. Limelight Networks Inc.*, 692 F.3d 1301 (Fed. Cir. Aug. 31, 2012)(*en banc*)(divided infringement); *In re Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007)(*en banc*)(willfulness); *i4i Ltd. Partnership v. Microsoft Corp.*, 598 F. 3d 831 (Fed. Cir. 2010)(invalidity), *aff'd.*, 131 S.Ct. 2238 (2011); *Therasense, Inc. v. Becton, Dickinson and Co.*, 649 F. 3d 1276 (Fed. Cir. 2011)(*en banc*)(inequitable conduct); and *Monsanto Co. v. Bowman*, 657 F.3d 1341 (Fed.Cir. 2011)(patent exhaustion), *aff'd.*, *Bowman v. Monsanto*, No. 11-796 (May 13, 2013).

It is true that fourteen districts are in the first of ten years of Patent Pilot Programs. See, *e.g.*, http://www.uscourts.gov/News/NewsView/11-06-07/District_Courts_Selected_for_Patent_Pilot_Program.aspx and [http://www.wilmerhale.com/uploadedFiles/WilmerHale_Shared_Content/Editorial/Publications/Publication/REPRINT_%20Patent%20Pilot%20Program,%20One%20Year%20Later%20\(Khan,%20Gunther\)_FINAL_\(104981290\)_1.PDF](http://www.wilmerhale.com/uploadedFiles/WilmerHale_Shared_Content/Editorial/Publications/Publication/REPRINT_%20Patent%20Pilot%20Program,%20One%20Year%20Later%20(Khan,%20Gunther)_FINAL_(104981290)_1.PDF). These programs offer to concentrate patent cases among limited numbers of judges. *Id.* Such judges could increase rapidly in patent facility. *Id.* Some litigants who have choices of venue may also

direct their patent cases to such districts and judges, potentially further increasing district judicial patent facility. See, e.g., N. Olson, *Does Practice Make Perfect? An Examination of Congress's Proposed District Court Patent Pilot Program*, 55 *UCLA Law Review* 745 (2008). The record of one judge of this Court (presiding over more than one hundred patent and trademark cases as a district court judge before appointment to the Court) reflects well on the potential for some district judges to gain excellent patent experience.

The Court could take advantage of the expertise these judges develop, as it does the judges who have other expertise. As in *SMS Data Products Group, Inc. v. U.S.*, 900 F.2d 1553 (Fed.Cir. 1990) and *Erickson Air Crane Co. v. U.S.*, 731 F.2d 810, 814 (Fed.Cir. 1984), “legal interpretations by tribunals having expertise are helpful to us, even if not compelling.” But the evidence of the Schwartz empirical study is that district court judges are not improving with experience on claim construction. See Schwartz at 258-9. Explanations may include that current judges cannot learn how to construe claims properly, that this Court has not taught the needed skills, or that claim interpretation is inherently indeterminate. *Id.* Because Schwartz determined that district judges do not learn through experience, whether Patent Pilot judges will develop expertise is an open question. But as Schwartz also concludes, at the least the judges will develop reputations with this Court, all hopefully good.

Patent Pilot Programs aside, there are 94 districts including those in territories, see Schwartz at 245, and 678 authorized district court judgeships, *id.*, such that the vast majority of the districts and judges do not have Patent Pilot Programs to access. Meanwhile, there are cases that cannot be brought in Patent Pilot districts.

Typical available statistics reflect that the Patent Pilot districts received 5,514 patent case filings of the 9,958 total for all districts in the two years 2011-12. See Lexis Nexis[®] Court Link[®] Nature of Suit Strategic Profile, Property Rights – Patent (830), 1/1/2011 – 12/31/2012, All Courts, as to the filing numbers, see http://www.uscourts.gov/News/NewsView/11-06-07/District_Courts_Selected_for_Patent_Pilot_Program.aspx for the identity of the Patent Pilot districts. That left 4,444 patent case filings elsewhere.

Again putting Patent Pilot Programs aside, typical available statistics also reflect that after the top five districts for filings (Eastern Texas, Delaware, Central California, Northern California, and Northern Illinois), the remaining 89 districts had fewer patent cases filed in total than the top five (4,468 versus the top five 5,472). See Lexis Nexis[®] as above. Twenty-six districts had patent cases, but also had 10 or fewer in 2011-12. Many district judges will get only the occasional patent case. The Federal Circuit heard appeals from decisions of 485 district and magistrate judges from 1996-2007. Schwartz at 246-7.

Second, if there are shortcomings to be perceived in district court decisions, they are concentrated in what to *make of* the facts, both those arising from intrinsic evidence, and from extrinsic evidence. As to the import of the *intrinsic* evidence, the following shortcomings are visible: (1) reading limitations from preferred embodiments into the claims, (2) resolving claims to be indefinite that cannot have limitations read in from preferred embodiments, (3) and finding disavowals of claim scope as a result of unclear expressions that are or are not arguably disavowals, with the same as to expressions of preference. As to *extrinsic* evidence, the principal mistake as to the import of the evidence is to use it to contradict the intrinsic evidence.

a. District courts have a sustained tendency to read limitations from preferred embodiments into claims.

A first visible shortcoming of district courts decisions is a sustained tendency to read limitations from preferred embodiments into claims. Examples abound, back to the beginnings of review by this Court, through the present.⁹ This

⁹ These include the cases cited in *Phillips*, and *Transmatic, Inc. v. Gulton Indus.*, 53 F.3d 1270, 1277 (Fed. Cir. 1995)(term “light housing” limited to preferred embodiment); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855 (Fed.Cir.1988) (“References to a preferred embodiment, such as those often present in a specification, are not claim limitations.”), cert. denied, 490 U.S. 1068 (1989); *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed.Cir.1985)(means limitation limited to preferred embodiment); *SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107 (Fed. Cir. 1985); and *Lemelson v. United States*, 752 F.2d 1538, 1552 (Fed.Cir.1984).

Court itself recognized the problem, in *Phillips* at 1323, stating that it recognized that the distinction between using the specification for interpretation and importing limitations is difficult to apply in practice:

[W]e recognize that the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice.

While *Phillips, id.*, provided guidance,¹⁰ it also noted that it has had to warn of the problem repeatedly:

For instance, although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. ... In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.

(citations omitted.) The Court quite reasonably expressed, *id.*, that there would be some hard cases even after applying the Court's guidance:

In the end, there will still remain some cases in which it will be hard to determine whether a person of skill in the art would

¹⁰ “[T]he line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms. ... To avoid importing limitations from the specification into the claims, it is important to keep in mind that the purposes of the specification are to teach and enable those of skill in the art to make and use the invention and to provide a best mode for doing so. ... One of the best ways to teach a person of ordinary skill in the art how to make and use the invention is to provide an example of how to practice the invention in a particular case.” (citations omitted).

understand the embodiments to define the outer limits of the claim term or merely to be exemplary in nature.

The Court at 1324 also noted that *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed.Cir. 1996) grappled with the problem, toward creating greater likelihood a district court will comprehend the matter:

In *Vitronics*, this court grappled with the same problem

The court also repeated its warning in *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed.Cir. 2008), stating it would not countenance incorrect practices:

Occasionally specification explanations may lead one of ordinary skill to interpret a claim term more narrowly than its plain meaning suggests. Nonetheless, this court will not countenance the importation of claim limitations from a few specification statements or figures into the claims,

As stated in *Manzo*, §1:1, the problem is that “[announcing the substantive precepts of patent claim interpretation is one thing, but applying them to the facts of a case can be much more perplexing, particularly where precepts can be in opposition to one another, and district judges cannot always tell which one(s) apply to a particular case.” Put another way, as in *Schwartz* at 230-1 and 233, the two canons involved are particularly contradictory – “the line between these canons is often murky ... It is an open question whether district court judges with proper training can correctly determine which canon of construction to use.”

b. District courts have a sustained tendency to read claims as indefinite when they cannot read structural limitations such as dimensions into claims.

Another visible shortcoming of district court decisions is a sustained tendency to read claims as indefinite. This occurs when structural limitations such as dimensions cannot be determined. An example is given by this Court's recent decision in *Biosig Instruments, Inc. v. Nautilus, Inc.*, No. 12-1289 (Fed. Cir. April 26, 2013). This Court reversed a decision to hold a patent invalid, in relevant portion. The source of the reversed holding was the seemingly simple expression "spaced relationship." The patent stated that in a heart rate monitor, two sets of electrodes were mounted "in spaced relationship with each other." Slip op. at 4-5. The court construed the term but expressed that "a spaced relationship did not tell me or anyone what precisely the space should be ...". Slip op. at 12. This Court had no difficulty finding the term definite. The claims and specification both clearly defined the relationship by the function to be accomplished. *Id.* at 14. Many cases fit the same pattern, a pattern of shortcomings as to indefiniteness.¹¹

¹¹ The following are some of them. *HTC Corp. v. IPCOM GMBH & Co.*, 667 F.3d 1270(Fed.Cir. 2012)(reversal); *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 655 F.3d 1364 (Fed. Cir. 2011)(reversal, where the term was "controlled environment," because a person of ordinary skill would understand how to achieve variables to create a controlled environment); *S3 Inc. v. Nvidia Corp.* 259 F.3d 1364 (Fed.Cir. 2001)(reversal, matter of video information data stream); *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372 (Fed.Cir. 2000)(reversal, matter of adverse deposition testimony of inventor); *Atmel Corp. v. Information Storage*

- c. **District courts have a sustained tendency to find disavowals of claim scope as a result of unclear expressions that are or are not arguably disavowals, and to find the same as a result of expressions of preference, in the intrinsic evidence.**

A third visible shortcoming of district court decisions is a sustained tendency to find disavowals of claim scope in the intrinsic evidence as a result of unclear expressions and expressions of preference.¹²

In *Computer Docking Station*, where it stated it would not countenance wrong practices, the Court considered it appropriate to state this synopsis:

Prosecution disclaimer does not apply to an ambiguous disavowal. ...
Prosecution disclaimer does not apply, for example, if the applicant

Devices, Inc., 198 F.3d 1374 (Fed.Cir. 1999)(reversal, un rebutted expert testimony proved that a specification citation to a journal was sufficient in the citation alone to specify a means); *North Am. Vaccine, Inc. v. American Cyanimid Co.*, 7 F.3d 1571 (Fed. Cir. 1993)(reversal, matter of polysaccharides); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565 (Fed. Cir. 1986)(reversal, matter of a chair); *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed.Cir. 1983)(reversal, matter of “stretch rate”); *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124 (2nd Cir. 1958)(reversal, matter of striated plywood); *Lever Bros. v. Procter & Gamble Mfg. Co.*, 139 F.2d 633 (4th Cir. 1943)(reversal, matter of soap) .

¹² The cases include the following. *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 Fed.Cir. 2004)(silence apparently considered disavowal); *LiebelFlarsheim Co. v. Medrad, Inc.*, 358 F.3d 898 (Fed.Cir. 2004); *Omega Eng’rg., Inc. v. Raytek Corp.*, 334 F.3d 1314 (Fed.Cir. 2003); *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823 (Fed.Cir. 2003); *Invitrogen Corp. v. Biocrest Mfg., L.P.* 327 F.3d 1364 (Fed.Cir. 2003); *Schwing GMBH v. Putzmeister Aktiengesellschaft*, 305 F.3d 1318 (Fed.Cir. 2002); *Rexnord Corp. v. Laitrim Corp.*, 274 F.3d 1336 (Fed.Cir. 2001); *Pall Corp. v. PTI Tech., Inc.*, 259 F.3d 1383 (Fed.Cir. 2001) vacated on other grounds, 535 U.S. 1109, 122 S.Ct. 2324, 153 L.Ed.2d 152 (2002).

simply describes features of the prior art and does not distinguish the claimed invention based on those features. ... And if the specification expressly defines a claim term and "remarks made to distinguish claims from the prior art are broader than necessary to distinguish the prior art, the full breadth of the remark is not `a clear and unambiguous disavowal of claim scope as required to depart from the meaning of the term provided in the written description."

519 F.3d at 1375 (citations omitted).

Plainly, the Court was noting a tendency to find disclaimers.

d. District courts have a sustained tendency to let extrinsic evidence convince them to contradict intrinsic evidence.

A fourth visible shortcoming of district court decisions is a sustained tendency to let extrinsic evidence, especially expert testimony, contradict intrinsic evidence. As the Supreme Court has stated, "[e]xpert evidence can be both powerful and quite misleading because of the difficulty of evaluating it." *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 595 (1993). Undue reliance on it can risk that it will change the meaning of claims in derogation of the public record. *Phillips*, 415 at 1319. That is, experts are certainly capable of "semantic antics." *Senmed, Inc. v. Richard-Allan Medical Industries*, 888 F.2d 815, 819 (Fed. Cir. 1989)(inventor as expert). It was experts who led the district court astray, giving rise to the decision in *Vitronics*. Experts contradicted the intrinsic evidence. *Id.*, 90 F.3d at 1582-5. It was experts who led the jury astray giving rise to *Markman*. They also contradicted the intrinsic evidence. *Markman v. Westview Instruments*,

Inc., 52 F.3d 967, 981 (Fed.Cir. 1995). As in the power and potential for misleading that is expert testimony, the factfinders of district courts have been prominently misled.

Consistent with the much greater expertise in this Court in assessing the *import* of the facts of claim interpretation, and the struggles of the district courts in these matters, see *especially* Schwartz for empirical analysis, this Court should review the import of the facts underlying claim interpretation *de novo*, at least in the stated areas and preferably in all areas. A hypothetical could be helpful. If this Court had not had full *de novo* review of the line between using the specification for interpretation and importing limitations, then there is little doubt the case law of the Court would not be rich with precedents for the district courts to draw from in accomplishing the known difficult task of drawing the line in specific cases. The same is true as to disclaimers, in that if this Court had not had full *de novo* review and developed the law as to disclaimers, the district courts would not have a synopsis as in *Computer Docking Station*, and would be more prone to mistakes at this time. The perception of need for case-by-case development of norms, the “single most important trigger,” as in Monoghan, is alive and present. Until this Court is completely satisfied that it has generated a body of case law on claim interpretation sufficient to guide the district courts in the many different situations

that patent cases present them (observable by an acceptable low claim interpretation reversal rate), the Court should continue *de novo* review, as counseled by Monaghan.¹³

3. The Court Should Review Underlying Facts Arising from Extrinsic Evidence for Clear Error

Extrinsic evidence in patent cases takes the form, at least principally, of expert testimony, dictionaries and technical publications.

Perhaps the most controversial extrinsic evidence is expert testimony. The testimony of an expert on claim interpretation generated at the time of litigation and for its purposes has been characterized as subject to bias that is not present in intrinsic evidence, which is exacerbated if the expert's opinion is offered in a form that is not subject to cross-examination. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005). As a result, “a court should discount any expert testimony ‘that is clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent.’” *Id.* (citations omitted).

Moreover, as in *Markman II* at 390, “ a [patent] term can be defined only a way that comports with [its] instrument as a whole.” That being the case, an expert's testimony is to be judged and rejected unless it “fully comports with the

¹³ The goal surely is not mere reduction of reversal rate. Deference would make the reversal rate fall, Schwartz at 264, but that would not fix the jurisprudence, *id.*

specification and claims and so will preserve the patent's internal coherence.” *Id.* This is consistent with all review of credibility determinations in the district courts. As this Court stated in *Hybritech Inc. v. Monocolnal Antibodies, Inc.*, 802 F.2d 1367 (Fed.Cir. 1986), quoting the Supreme Court in *dictum*, “a trial judge may not ‘insulate his findings from review by denominating them credibility determinations’; if documents or objective evidence contradict the witness’s story, clear error may be found even in a finding purportedly based on a credibility determination. *Anderson [v. City of Bessemer City, N.C.]*, 470 U.S. 564] at 1512-13 [(1985)].”

With *de novo* review over the import of underlying facts, including intrinsic evidence, as suggested above, and with the foregoing rules of law from *Phillips* and *Markman II* to guide district courts, this Court has an appropriate ambit of review over expert testimony, and appropriate rules in place, such as to give deference to district court considerations of the credit or lack of credit to be given expert testimony for reasons such as credibility. If district courts judge expert testimony to be lacking in credibility, there is no reason to doubt them. If they judge expert testimony to be credible, the Court may also not doubt them, but may review the import of the testimony *de novo* – for what it means, what effect it has on claim interpretation, does it fully comport with the specification and claims? If

it contradicts the specification and claims, it cannot be insulated from review on the basis of credibility. Again there is no reason for *de novo* review.

Dictionaries and treatises, like intrinsic evidence, should take little attention. An error as to them is most likely to be clear error.

III. CONCLUSION

“[W]hat matters is for [courts] to attach the appropriate weight to be assigned [the various claim interpretation] sources in light of the statutes and policies that inform patent law.” *Phillips*, 415 F.3d at 1324. It is in this matter, given the presence of Monaghan’s single most important trigger, that factfinding should not receive deference.

For the foregoing reasons, IPLAC urges this Court to overrule *Cybor* to a limited extent, to hold that factual findings made by a district court in the course of interpreting patent claims should be reviewed under the clearly erroneous standard of review, but that the *import* of the facts and the ultimate interpretation should be reviewed *de novo*.

Respectfully submitted,

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This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B). The brief contains 6,756 words, excluding parts exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii). This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in proportionally spaced typeface using Microsoft Word 2010 with 14 point Times New Roman type style.

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/s/Charles W. Shifley
Charles W. Shifley

CERTIFICATE OF FILING AND SERVICE

I hereby certify that on May 28, 2013, this Brief of The Intellectual Property Law Association of Chicago as *Amicus Curiae* Supporting Neither Party was filed electronically with the Clerk of the Court using the CM/ECF System, which will send notice of such filing to counsel of record.

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