

Supreme Court, U.S.
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IN THE
Supreme Court of the United States

MEDTRONIC SOFAMOR DANEK, INC., F/K/A/ SOFAMOR DANEK
GROUP, INC., AND MEDTRONIC SOFAMOR DANEK USA, INC.,
Petitioners,

v.

DEPUY SPINE, INC. F/K/A DEPUY ACROMED, INC. AND
BIEDERMANN MOTECH GMBH
Respondent.

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

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

This case presents a question of broad and general importance regarding patent infringement under 35 U.S.C. § 271: Has the Federal Circuit properly and consistently balanced the public notice function of patent claims (the goal of this Court's "all-elements rule") with the desire to protect patentees from unscrupulous copyists (the goal of the doctrine of equivalents)? If not, how can the analysis of patent infringement under the doctrine of equivalents be better crafted to achieve more consistent and predictable outcome?

The answer to this question can affect virtually every issued U.S. patent and every U.S. patent infringement action, as well as any enterprise and member of the public affected by the grant of a U.S. patent.

**PARTIES TO THE PROCEEDINGS AND
RULE 29.6 STATEMENT**

Applicants Petitioners Medtronic Sofamor Danek, Inc. and Medtronic Sofamor Danek USA, Inc., were defendants in the district court proceedings and cross-appellants in the court of appeals proceedings.

Respondents DePuy Spine, Inc. and Biedermann Motech GmbH were the plaintiffs in the district court proceedings and the appellants in the court of appeals proceedings.

TABLE OF CONTENTS

	Page
QUESTION PRESENTED	i
PARTIES TO THE PROCEEDINGS AND RULE 29.6 STATEMENT	ii
OPINIONS BELOW	1
JURISDICTION.....	1
STATUTORY PROVISION INVOLVED	2
STATEMENT	3
STATEMENT OF THE CASE.....	8
REASONS FOR GRANTING THE PETITION	12
I. THIS CASE IS ONE OF MANY THAT ILLUSTRATE THE UNCERTAINTY GENERATED BY THE FEDERAL CIRCUIT'S APPLICATION OF THE ALL-ELEMENTS RULE AND THE DOCTRINE OF EQUIVALENTS, THUS ESTABLISHING THE NEED FOR FURTHER GUIDANCE AND REFINEMENT OF THE RULE BY THIS COURT.....	12

TABLE OF CONTENTS
(continued)

	Page
A. <i>DePuy Spine</i> Cannot be Distinguished From <i>Tronzo</i> , So The Decision in <i>DePuy Spine</i> , Which Directly Contradicts That in <i>Tronzo</i> , Demonstrates The Inconsistency In Federal Circuit Rulings	12
1. The Claims in Both <i>Tronzo</i> and <i>DePuy Spine</i> Unambiguously Call For a Specific Shape.....	12
2. The Patents In Both <i>Tronzo</i> and <i>DePuy Spine</i> Make It Clear That The Claimed Shape Was The Preferred Shape.....	13
3. Expert Testimony in Both <i>Tronzo</i> and <i>DePuy Spine</i> Indicated That Any Shape Would be Equivalent To The Claimed Shape, Thus Vitiating The Claim Element	14
B. In Many Cases The Federal Circuit Has Taken The “Hard,” Literal Approach to the All-Elements Rule That It Took in <i>Tronzo</i>	17

TABLE OF CONTENTS
(continued)

	Page
C. In Other Cases The Federal Circuit Has Taken The “Soft,” Non-Literal Approach to the All-Elements Rule That It Took In <i>DePuy Spine</i>	19
D. The “Hard” Approach Does Not Satisfy This Court’s Requirement for Equity for Patentees	21
E. The “Soft” Approach Does Not Satisfy This Court’s Requirement for Public Notice.....	21
II. THIS COURT MUST REJECT THE FEDERAL CIRCUIT’S INCONSISTENT APPLICATION OF THE ALL-ELEMENTS RULE AND ENDORSE A FRAMEWORK FOR CLEAR APPLICATION OF THAT RULE, SUCH AS A DETERMINATION OF WHETHER THE EQUIVALENT FEATURE IN QUESTION WAS FORESEEABLE AT THE TIME OF PATENTING.....	22
A. The All-Elements Rule Can Be An Efficient Threshold Rule When Evaluating Equivalence.....	22
B. To Preserve the Public Notice Function of Claims, Adherence To The All-Elements Rule Is Essential	23

TABLE OF CONTENTS
(continued)

	Page
C. To Preserve The Patentee's Rights, The All-Elements Rule Should Be Tempered By A Foreseeability Test	23
1. This Court's <i>Festo</i> Foreseeability Test Should Be Extended To All Determinations Under The Doctrine of Equivalents.....	24
2. A Foreseeability Test And The All-Elements Rule Can Work Cooperatively To Properly Constrain the Doctrine of Equivalents.....	25
3. A Foreseeability Test Balances Public Rights And A Patentee's Rights and Responsibilities	26
4. A Foreseeability Test Properly Allocates Costs For Improving Patent Quality	27
III. THIS IS AN APPROPRIATE TIME FOR THIS COURT TO CONSIDER THIS ISSUE.....	27

TABLE OF CONTENTS
(continued)

	Page
A. Consideration of This Issue Now would assure consistency in This Court's Current Examination of Federal Circuit Jurisprudence	27
B. Consideration of This Issue Is Timely Specifically For This Case.....	28
CONCLUSION.....	29

TABLE OF AUTHORITIES

	<u>Page</u>
<u>Cases</u>	
<i>Abbott Laboratories v. Dey, L.P.</i> , 287 F.3d 1097 (Fed. Cir. 2002).....	19, 20
<i>Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc.</i> , 291 F.3d 1317 (Fed. Cir. 2002).....	17
<i>DeMarini Sports, Inc. v. Worth, Inc.</i> , 239 F.3d 1314 (Fed. Cir. 2001).....	18
<i>DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.</i> , No. 01-10165-EFH (D. Mass. Feb. 24, 2004).. <i>passim</i>	
<i>Durel Corp. v. Osram Sylvania, Inc.</i> , 256 F.3d 1298 (Fed. Cir. 2001).....	17
<i>eBay v. MercExchange</i> , 126 S.Ct. 1837 (2006).....	27
<i>Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.</i> , 535 U.S. 722 (2002).....	6, 24
<i>Gillespie v. United States Steel Corp.</i> , 379 U.S. 148 (1964).....	28
<i>Graver Tank & Mfg. Co. v. Linde Air Products Co.</i> , 339 U.S. 605 (1950).....	6, 21, 23, 26
<i>Hughes Aircraft Co. v. United States</i> , 140 F.3d 1470 (Fed. Cir. 1998).....	4

TABLE OF AUTHORITIES

	<u>Page</u>
<i>Insituform Technologies, Inc. v. Cat Contracting, Inc.</i> , 99 F.3d 1098 (Fed. Cir. 1996).....	20
<i>Land v. Dollar</i> , 330 U.S. 731, 734, n.2 (1947).....	28
<i>Larson v. Domestic & Foreign Commerce Corp.</i> , 337 U.S. 682 (1949).....	28
<i>Mazurek v. Armstrong</i> , 520 U.S. 968 (1997).....	28
<i>MedImmune, Inc. v. Centocor, Inc.</i> , 127 S. Ct. 1118 (2007).....	27
<i>Moore U.S.A., Inc. v. Standard Register Co.</i> , 229 F.3d 1091 (Fed Cir. 2000).....	18
<i>SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.</i> , 242 F.3d 1337 (Fed Cir. 2001).....	19
<i>Slimfold Mfg. Co. v. Kinkead Indus., Inc.</i> , 932 F.2d 1453 (Fed. Cir. 1991).....	3
<i>Tronzo v. Biomet, Inc.</i> , 156 F.3d 1154 (Fed. Cir. 1998).....	<i>passim</i>
<i>United States v. General Motors Corp.</i> , 323 U.S. 373 (1945).....	28
<i>Warner-Jenkinson Co. v. Hilton-Davis Chemical Co.</i> , 520 U.S. 17 (1997).....	<i>passim</i>

TABLE OF AUTHORITIES

Page

Statutes

28 U.S.C. § 1254(1)	1
28 U.S.C. § 1295(a)(1)	1
28 U.S.C. § 1331	1
28 U.S.C. § 1338(a)	1
35 U.S.C. § 112 ¶ 6	6
35 U.S.C. § 271	i
35 U.S.C. § 271(f)	28
35 U.S.C.A. § 271(a)	2

Other Authorities

National Research Council, <i>A Patent System for the 21st Century</i> (2004), Ch. 3 (available at http://books.nap.edu/catalog.php?record_id=10976)	27
---	----

APPENDIX

TABLE OF CONTENTS

	<u>Page</u>
Appendix A - Court of Appeals Opinion, <i>DePuy Spine, Inc., f/k/a DePuy AcroMed, Inc., v. Medtronic Sofamor Danek, Inc.</i> , 469 F.3d 1005 (2006).....	2a
Appendix B - Order denying Medtronic's Petition for Rehearing or Rehearing <i>en banc</i> of the United States Court of Appeals for the Federal Circuit, <i>DePuy Spine Inc., f/k/a DePuy AcroMed, Inc., v. Medtronic Sofamor Danek, Inc.</i> , No. 05-1311, 05-1335 (December 28, 2006).....	35a
Appendix C - Memorandum and Order, <i>DePuy AcroMed, Inc. v. Medtronic Sofamor Danek, Inc., f/k/a Sofamor Danek Group, Inc.</i> , No. 01-10165-EFH (D. Mass. April 14, 2003).....	37a
Appendix D - Memorandum and Order, <i>DePuy AcroMed, Inc. v. Medtronic Sofamor Danek, Inc., f/k/a Sofamor Danek Group, Inc.</i> , No. 01-10165-EFH (D. Mass. Feb. 24, 2004).....	40a
Appendix E - Memorandum and Order, <i>DePuy AcroMed, Inc. v. Medtronic Sofamor Danek, Inc.</i> , No. 01-10165-EFH (D. Mass. Oct. 27, 2003).....	47a

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Petitioners Medtronic Sofamor Danek, Inc. and Medtronic Sofamor Danek USA, Inc. (collectively, "Medtronic") respectfully submit this petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit entered in this action on November 20, 2006.

OPINIONS BELOW

The court of appeals' opinion is reported at 469 F.3d 1005 (2006) and is reproduced in Petitioner's Appendix ("App.") at 2a-34a.

The order denying Medtronic's petition for rehearing or rehearing *en banc* is unreported and is reproduced at App. 35a-36a. The Memorandum and Order of the United States District Court for the District of Massachusetts for Summary Judgment of Non-Infringement Concerning Medtronic's Vertex Screw is unreported and is reproduced at App. 40a-46a.

JURISDICTION

The district court had jurisdiction over respondent's claims pursuant to 28 U.S.C. § 1331 and 1338(a). The court of appeals had jurisdiction to review the district court's final judgment pursuant to 28 U.S.C. § 1295(a)(1). The court of appeals filed its opinion on November 20, 2006. That court denied Medtronic's timely petition for rehearing or rehearing *en banc* on December 28, 2006. On March 15, 2007, Chief Justice Roberts extended the time within which to file a petition for certiorari to April 30, 2007. No. 06A889. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

Title 35 U.S.C.A. § 271(a) provides:

§ 271. Infringement of patent

- (a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefor, infringes the patent.

STATEMENT

This case concerns a defendant Petitioner, Medtronic, who was aware of a patent for a medical device (a spinal implant) having claims that specifically defined certain features of the device by their geometric shape. Medtronic attempted to “design around” the patent by building a device that, *inter alia*, used a different geometry for the relevant features of the device. The Federal Circuit had already decreed in a very similar case (that also involved a medical implant defined by its shape in the patent claim) that such a substitution removed the accused device from the reach of the doctrine of equivalents, basing its ruling on the so-called “all-elements rule.” Nevertheless, in the present case the Federal Circuit declared that Medtronic’s new device *could* in fact lie within the territory of an equivalent for the geometrically-defined claim element at issue. Medtronic was, not unreasonably, surprised by this contradiction. This petition implicates, however, more than this pair of contradictory decisions by the Federal Circuit; this petition concerns a string of decisions over the last decade that touch upon the “all-elements rule” and that have left patent owners and the public at large in great confusion over the scope of rights granted by patents.

The patent Medtronic had been accused of infringing claimed, among other things, a receiver chamber having “an inner hollow spherically-shaped portion,” and a compression member for exerting a force such that a screw head “is pressed against the hollow spherically-shaped portion.” U.S. Patent No. 5,207,678 (“678 patent”), col. 4, ll. 18-24. Medtronic wanted to “design around” this patent, a recognized action for those who wish to avoid infringement. *See, e.g., Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991). As a result, Medtronic’s device had a *conically* shaped portion, not a *spherically*

shaped portion, against which the head of the bone screw pressed. In producing this device, Medtronic relied upon the public notice function of the clearly written patent claims, and this Court's holding in *Warner-Jenkinson Co. v. Hilton-Davis Chemical Co.*, 520 U.S. 17, 29 (1997), which cautioned that "[i]t is important to ensure that the application of the doctrine [of equivalents], even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety." That proscription for application of the doctrine of equivalents is known as the "all-elements rule." See, e.g., *Hughes Aircraft Co. v. United States*, 140 F.3d 1470, 1474 (Fed. Cir. 1998). Medtronic also relied on the Federal Circuit's decision in *Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998), a case very similar to this case, in which the Federal Circuit found that a hemispherical shape could not infringe, under the doctrine of equivalents, a claim that called for an "essentially conical" shape because such infringement would violate the all-elements rule. However, the Federal Circuit's application of that rule has, as exemplified by this case, been woefully inconsistent.

The trial court in *DePuy AcroMed, Inc. v. Medtronic Sofamor Danek, Inc.*, No. 01-10165-EFH (D. Mass. Feb. 24, 2004) ruled on summary judgment that the conically-shaped portion in Medtronic's device did not literally meet the "spherically-shaped portion" limitation recited in the '678 patent claims. (App. at 41a). The trial court also ruled that the conically-shaped portion of the accused device could not comprise an equivalent to the "spherically-shaped" limitation of the asserted claims without vitiating that claim limitation. (App. at 43a). The Federal Circuit reversed, finding that while there could be no literal infringement, there may be infringement by equivalents, and remanded for a trial on equivalence. *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1019-1020 (2006) (App. at 33a).

In so doing, the Federal Circuit deprived Medtronic of its reasonable reliance on the words chosen by the patentee to define its patent rights and thereby created unnecessary uncertainty regarding how the public can determine the scope of a patentee's claimed invention.

The '678 patentees claimed only the specific "spherical" shape. Yet nothing in the record below suggests that the patentees could not reasonably have foreseen, when they applied for the patent, that by claiming their invention with a specific shape, devices that had a different shape would fall outside the boundaries of the claim. The Federal Circuit's decision in *DePuy Spine* allows the patentee to resort to the doctrine of equivalents to effectively rewrite the patent claim, which it could have drafted more broadly but did not.

Petitioner's experience demonstrates how the doctrine of equivalents, combined with erratic application of the all-elements rule, has made the scope of the patent right attaching to a specifically written claim unpredictable. The resulting failure of confidence in the public-notice function of claims, if not arrested, will inhibit competition and further innovation unless this Court provides guidance on the use of the all-elements rule as a limit on the doctrine of equivalents.

This case gives this Court a timely opportunity to address this ambiguity and confusion. The question this Court must resolve is one of paramount importance in today's patent law: how should the all-elements rule be used to control the application of the doctrine of equivalents? This Court stated in *Warner-Jenkinson* that the all-elements rule *should* be used to limit the application of the doctrine of equivalents, but in the past decade the Federal Circuit has not settled on *how* it should be used, and has produced a body of irreconcilable decisions through its inconsistent application

of the rule. As a result, neither the public, who must know the definite limits of a patent, nor patentees, who must be protected from copyists making insignificant changes, are served.

The doctrine of equivalents for claims not expressed in means-plus-function form¹ is court-made law that evolved to prevent “the unscrupulous copyist” from making “unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law.” *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950). Equivalence may be determined using either a test for similarity of function, way, and result, or a test for “insubstantial differences.” *Warner-Jenkinson*, 520 U.S. at 39-40. No matter what formulation is used, however, it is perilous to anyone other than the patentee to apply the doctrine of equivalents. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727 (2002) (“by extending protection beyond the literal terms in a patent the doctrine of equivalents can create substantial uncertainty about where the patent monopoly ends.”). The subjectivity of the “insubstantial differences” or “function-way-result” tests can be relieved, in some cases, by the use of certain rules which have been developed by the courts to limit the doctrine. These rules, when consistently followed, help facilitate the public-notice function of patent claims. The all-elements rule is one such potentially useful rule.

The *first* task in any analysis of infringement under the doctrine of equivalents—preceding any assessment of facts by the fact finder—should be a determination of

¹ Elements described in “means plus function” claims as “a means for . . .” are the only claim elements statutorily granted the possibility of equivalents. See 35 U.S.C. § 112 ¶ 6.

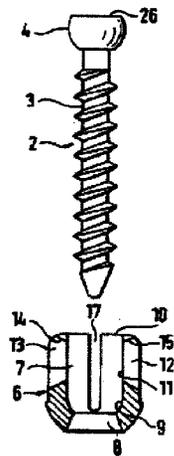
whether an element is vitiated. If so, the inquiry can stop there and no further test is needed because “if a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further *material* issue for the jury to resolve.” *id.* at 39 (emphasis in original). The Federal Circuit has not, unfortunately, always honored the primacy of the all-elements rule as laid down in *Warner-Jenkinson*.

To overcome inconsistency in the application of the all-elements rule, Petitioner respectfully submits that the application of the doctrine of equivalents should be guided by a foreseeability test. That test would ask whether, at the time the applicant obtained its patent, it could have foreseen that a specifically recited claim limitation could be met by a different structure (or step or component) that does not literally meet the recited claim element. If so, then the applicant could have, and should have, crafted the patent claims more broadly. The applicant’s failure to do so should preclude application of the doctrine of equivalents to that specifically recited claim element. If the alleged equivalent of the claim element was not foreseeable, e.g., it comprised later-developed technology not reasonably known prior to the presentation of the claim, then the patentee should be allowed recourse to the doctrine of equivalents as to that claim element, assuming no other limitation on the doctrine, such as prosecution history estoppel, applies.

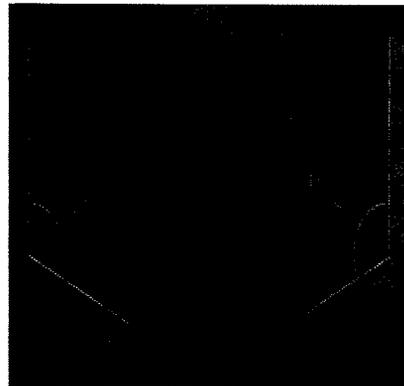
STATEMENT OF THE CASE

DePuy Spine and Biedermann Motech accused Medtronic Sofamor Danek of infringing the '678 patent with its Vertex pedicle screw product. The '678 patent describes and claims an orthopedic implant, a pedicle screw that is free to pivot inside a receiver member prior to being locked at a chosen angle by the surgeon. To permit such pivoting (or polyaxial) movement, Claim 1 of the '678 patent calls for the screw to have a "spherically-shaped" head which fits within a "spherically-shaped" portion of a receiver member. These specific shapes are identified with reference numerals 4 and 9 in the patent drawings and in claim 1.

The relevant portion of Figure 1 of the '678 patent, and the Medtronic device, are shown below:



From '678 Patent – Figure 1



Medtronic's Vertex device

Claim 1 of the '678 patent recites:

1. Device for stabilizing spinal column segments, comprising a pedicle screw (1) having a threaded shaft portion (3) and a spherically-shaped head (4) at the end of said threaded shaft portion, a receiver member (5) flexibly connected to said head (4), said receiver member being provided with two holes for receiving a rod 916) [sic:(16)], a receiver chamber (7) being provided within said receiver member (5), the receiver chamber (7) having at one end thereof a bore (8) for passing the threaded shaft portion (3) there through and *an inner hollow spherically-shaped portion* (9) for receiving the head (4) of said screw (1), an opening (10) being provided opposite said bore (8) for inserting said screw (1), said device further comprising a compression member (18) for exerting a force onto said head (4) such that said head is pressed against *the hollow spherically-shaped portion* (9).

'678 patent, col. 4, ll. 9-24 (emphasis added). The emphasized phrases in claim 1 give rise to this dispute. In Medtronic's Vertex product, the interior portion of the receiver member adjacent to the screw head is conical, not spherically-shaped. *DePuy Spine*, 469 F.3d at 1011. Thus, the screw head in Medtronic's Vertex product cannot be pressed against "a hollow spherically-shaped portion."

After holding a hearing on claim construction the trial court construed the "spherically-shaped" limitation to mean "approximately spherical, such as a globe or basketball," *DePuy AcroMed, Inc. v. Medtronic Sofamor Danek, Inc.*, No. 01-10165-EFH (D. Mass. Oct. 27, 2003) (App. at 51a). The court then concluded that the Vertex product did not literally infringe the '678 patent, because it

contained no spherically-shaped portion in the receiver; rather, it had conical lower chamber walls. *DePuy AcroMed, Inc. v. Medtronic Sofamor Danek, Inc.*, No. 01-10165-EFH (D. Mass. Feb. 24, 2004) (App. at 41a). The district court then invoked the all-elements rule to conclude that the Vertex screw did not infringe the '678 patent under the doctrine of equivalents because "the cylindrical-conical shape of the Vertex screw receiver member cannot infringe the '678 patent without reading out of the claim the express requirement that the screw head be 'pressed against the hollow, spherically-shaped portion'" of the receiver chamber. (App. at 43a-44a). The court also found that the Vertex screw did not infringe under the function/way/result test for equivalence because it "does not do 'substantially the same thing' as the screw disclosed in the '678 patent," in that the Vertex screw head contacts only an edge or lip of the receiver member rather than the larger area of the hollow spherically-shaped portion of the receiver chamber. (App. at 44a).

On appeal, DePuy challenged the district court's finding that no issue of material fact exists as to whether the Vertex product infringes the '678 patent, both literally and under the doctrine of equivalents. The Federal Circuit affirmed the grant of summary judgment of no literal infringement, finding that no evidence had been presented that the Vertex receiver member contained "a portion that meets the literal terms 'approximately spherical, such as a globe or basketball.'" *DePuy Spine*, 469 F.3d at 1016. However, the Federal Circuit reversed the grant of summary judgment under the doctrine of equivalents. Even though the patent claim unambiguously calls for a *spherically shaped* receiver member and Medtronic's accused product has a *conically* shaped receiver member, the Federal Circuit held that there *could* be infringement under the doctrine of equivalents, finding "no support . . . for the district court's

conclusion that applying the doctrine of equivalents would vitiate or read out the ‘spherically-shaped’ limitation.” *Id.* at 1019. On remand, the Federal Circuit required the fact finder to determine “whether the difference in the [argued] equivalent is “substantial,” *Id.* at 1021, and if those differences were *not* found to be “substantial,” then infringement under the doctrine of equivalents *could* exist notwithstanding the “all-elements rule.” *Id.*

In so subordinating application of this Court’s all-elements rule to a test for substantial differences, the Federal Circuit’s decision in *DePuy Spine* effectively negated the basis for that rule—to insure that every limitation in a patent claim be accounted for to thereby provide appropriate certainty to a patentee’s scope of rights. Moreover, the Federal Circuit provided no guidance or test to determine when differences between a claim element and an accused equivalent structure rise to the level of “substantial” differences.

REASONS FOR GRANTING THE PETITION**I. This Case is One of Many That Illustrate the Uncertainty Generated By the Federal Circuit's Application of the All-Elements Rule and the Doctrine of Equivalents, Thus Establishing the Need for Further Guidance And Refinement of the Rule By This Court.**

A. *DePuy Spine* Cannot be Distinguished From *Tronzo*, So The Decision in *DePuy Spine*, Which Directly Contradicts That in *Tronzo*, Demonstrates The Inconsistency In Federal Circuit Rulings

1. The Claims in Both *Tronzo* and *DePuy Spine* Unambiguously Call For a Specific Shape

The claim in question in *Tronzo's* patent recited a "body" of a prosthetic hip implant that had a "generally conical outer surface." U. S. Patent No. 4,743,262, col. 12, l. 9. The claim in question in *DePuy Spine* recites, *inter alia*, a receiver chamber *having an inner hollow spherically-shaped portion for receiving the head of the screw*, and a compression member for exerting a force onto the screw head "such that said [spherically-shaped screw] head *is pressed against the hollow spherically-shaped portion.*" '678 patent, col. 4, ll. 9-24 (emphasis added). The claimed inventions in *Tronzo* and *DePuy Spine* both relate to a medical implant and unambiguously call for specific shapes: "generally conical" in *Tronzo*, and "spherically-shaped" in *DePuy Spine*. The accused devices in *Tronzo* had a hemispherical shape instead of the claimed conical shape, while the accused devices in *DePuy Spine* had a conical shape instead of the claimed spherical shape.

2. The Patents In Both *Tronzo* and *DePuy Spine* Make It Clear That The Claimed Shape Was The Preferred Shape

The Federal Circuit attempted to differentiate *DePuy Spine* from *Tronzo* on the basis that “unlike the patent at issue in *Tronzo*, the written description in the ‘678 patent does not label other shapes as ‘prior art’ and ‘inferior.’” *DePuy Spine*, 469 F.3d at 1020. But the spherical shapes of the screw head and interior of the receiver chamber of the ‘678 patent—specific features of the invention—were not new. The inventors of the ‘678 patent combined these old elements with newer ones to form their invention. As such, the spherical shapes themselves did not have to be distinguished from the prior art. In fact, the ‘678 inventors freely acknowledged that “a very well-operating pedicle screw” was known from their own prior art reference EP 0 242 708, which describes and illustrates a pedicle screw with a spherically-shaped head connected to a spherically-shaped receiver, thereby “allowing a pivoting movement around the center of the hollow sphere” ‘678 patent, col. 1 ll. 44-45. The ‘678 invention was driven by the fact that, although the prior art screw was “well-operating,” it had a drawback: “[w]hen using this known screw, it is necessary to have the entire screws [i.e., with receiver] in the desired sizes in stock. However, the stocking costs for such complete screws are very high. . . .” ‘678 patent, col. 1, ll. 47-50. The inventors of the ‘678 patent wanted to overcome this drawback, “to provide a possibility for reducing the stocking costs of such screws.” ‘678 patent, col. 1 ll. 54-55. “Such screws” were the prior art spherically-headed screws with spherically-shaped receivers. Because the ‘678 patent inventors acknowledged and incorporated into their new design the prior art spherical shape, they did not have to show that the *shape* of their receiver was superior to shapes in the prior art. It was the *combination* of the remaining

elements of claim 1 with the known spherically-shaped receiver that produced a superior product.

The Federal Circuit's attempt to distinguish *Tronzo* from *DePuy Spine* on the basis of comments about the claimed shape in *Tronzo*'s patent specification thus fails, because the *DePuy Spine* inventors specifically claimed the *same* shape for the receiver chamber as existed in the prior art and relied on different features to distinguish their invention. Moreover, nothing in the record suggests that it was not foreseeable to the '678 patentees that a different shape for the receiver chamber would also allow the screw to pivot within the receiver member. Thus, a specific shape for the receiver chamber was not necessary to distinguish the '678 claimed invention from the prior art, but the patentees nevertheless claimed their invention with that shape and should not now be permitted to effectively re-write the claim to cover different shapes.

3. Expert Testimony in Both *Tronzo* and *DePuy Spine* Indicated That Any Shape Would be Equivalent To the Claimed Shape, Thus Vitiating the Claim Element

The expert testimony in *Tronzo* was that "when either a hemispherical cup or trapezoidal cup or any other shape cup is successfully implanted into the body, it functions almost exactly the same way." *Tronzo*, 156 F.3d at 1160. In its *Tronzo* opinion, the Federal Circuit took this testimony to indicate that "any shape would be equivalent to the conical limitation of claims 2 and 10," and recognized that "[s]uch a result is impermissible under the all-elements rule. . . ." *Id.* at 1160.

As in *Tronzo*, the relevant expert testimony in *DePuy Spine* concerned the "function, way, and result" test of

equivalence. As in *Tronzo*, the patentee's expert in *DePuy Spine* testified that the specifically claimed shape was irrelevant. In response to the question of whether there is "any shape that the bottom portion of the receiver member can take that would not be an equivalent to the spherically-shaped portion as recited in claim one of the patents," this expert stated that:

The issue as I have cited under the Doctrine of Equivalents, *the issue is not the shape of the bottom of the receiver. The issue is whether a bore in the bottom of the receiver contains the head of the screw.*

It's too small to permit the head of the screw to pass; that the receiver has room for the head, and that the hole be such that it permits angulation, and it's a bore, it's rounds [sic], and therefore, that's the only requirement for angulation.

Deposition of Robert Mann, Sc.D., Dec. 20, 2002, p. 49. (emphasis added). In other words, the shape is irrelevant because (according to DePuy's theory of equivalence) the only requirements for the bottom portion of the receiver chamber were that it contain a bore through which the screw could pass; that this bore not be so large as to allow the head of the screw to pass through; and that the bore be round, to permit the screw to be fixed in any direction. The patentee's equivalence theory in *DePuy Spine* was, therefore, the same as that in *Tronzo*: *any* shape would be equivalent to the shape specifically called for in the claim, so long as the alleged function was achieved. Under this theory, the claimed "hollow spherically-shaped portion" of the '678 patent is eviscerated because only a "hollow portion" is necessary. A specific feature of that claim, the spherical shape of the hollow portion, has been discarded and that

claim element has been vitiated.²

The Federal Circuit attempted to differentiate its decision in *DePuy Spine* from *Tronzo*, and thus justify its diametrically opposite result, by pointing out factual differences between the cases, noting that “Tronzo is limited to the facts and theories of equivalence presented in that case,” *DePuy Spine*, 469 F.3d at 1019, n.1. But the Federal Circuit has never criticized the *method of analysis* it used in *Tronzo*. Simply noting that a particular decision is limited to the facts presented in that case only emphasizes the lack of certainty and predictability in the Federal Circuit’s application of the all-elements rule and the doctrine of equivalents. The opposite result reached in *Tronzo* and *DePuy Spine* on strikingly similar issues highlights the need for this Court’s guidance on those issues.

² The Federal Circuit stated that DePuy Spine’s “expert expressly identified certain shapes that were different from the accused device but would not be capable of supporting the screw head, allowing flexible movement, and creating a rigid lock when the compression member is engaged.” *DePuy Spine*, 469 F.3d at 1020. This testimony is said to appear in a “particularized declaration” by DePuy’s expert Dr. Mann. *Id.* at 1019. Medtronic is unable to find specific testimony by Dr. Mann to this effect. The record shows that Dr. Mann identified “[a] square, a cube, a hexagon, a polygon” as shapes that were “not spherically shaped as required by claim one of this patent,” deposition of Robert Mann, Sc. D., Dec. 20, 2002, p.97, but did not state that any such shape would be incapable of supporting the screw head, allowing flexible movement, and creating a rigid lock when the compression member is engaged--the “function, way, and result” that DePuy Spine defined for the “spherically-shaped” claim limitation.

B. In Many Cases the Federal Circuit Has Taken the “Hard,” Literal Approach to the All-Elements Rule That It Took in *Tronzo*

Tronzo is only one of several decisions in which the Federal Circuit elected to adhere to the specific wording of a claim—a “hard” approach to the doctrine of equivalents. In *Cooper Cameron Corp. v. Kvaerner Oilfield Products, Inc.*, 291 F.3d 1317 (Fed. Cir. 2002), the claim element in question called for “[a] wellhead comprising . . . a workover port extending laterally through the wall of the spool tree from between the two plugs.” *Id.* at 1319. (emphasis added). The accused device had a workover port above, not between, the two plugs. The Federal Circuit upheld a summary judgment of non-infringement because “the workover port in Kvaerner’s accused device enters the wellhead assembly ‘above’ the two plugs, which cannot be equivalent to a connection ‘between the two plugs.’” *Id.* at 1322. The Federal Circuit acknowledged the all-elements rule, recognizing that if it were to ignore the use of the word “between” in the claim, “we would vitiate that limitation and thereby run afoul of the all-limitations rule.” *Id.* The Federal Circuit did not ask whether the difference in location of the workover port was “substantial.”

This hard approach was similarly evident in *Durel Corp. v. Osram Sylvania, Inc.*, 256 F.3d 1298 (Fed. Cir. 2001). The claim element in question called for “encapsulated electroluminescent phosphor particles, each comprising a particle of . . . phosphor which is essentially completely encapsulated within a . . . continuous *metal oxide coating* . . .” *Id.* at 1301. (emphasis in original). The Federal Circuit construed “oxide coatings” as primarily comprising a binary compound or compounds “containing only metal cations and oxygen.” *Id.* at 1305. The court found that the accused products “contain an additional

element, hydrogen, and therefore do not meet the claim limitation that only metal cations and oxygen be present in the primary component of the oxide coating. A finding of equivalence would vitiate the limitation of 'oxide coating'” *Id.* (citing *Tronzo*). On this basis, the Federal Circuit refused to remand the case for a determination of infringement under the doctrine of equivalents “because we conclude that no reasonable fact-finder could find such infringement.” *Id.* The Federal Circuit did not ask whether this difference between the accused product and the claim was “substantial.”

In *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314 (Fed. Cir. 2001) the claim in question called for “a hollow tubular bat frame having a circular cross-section; and an insert positioned within the frame.” *Id.* at 1319. In the accused device the positions of the insert and frame were reversed: the insert was external to, not within, the frame. The Federal Circuit affirmed the trial court’s summary judgment of non-infringement under the doctrine of equivalents because “the functional relationships of these structural limitations is not maintained.” *Id.* at 1333. Acknowledging that the accused device simply reversed the position of the insert and the frame, the Federal Circuit did not then ask whether that difference in arrangement was “substantial.” Rather, the Federal Circuit stated that “[i]t is one thing to effect a mere reciprocal change, but it is quite another thing when a limitation in a claim is simply missing.” *Id.* at 1334.

Other examples of cases in which the Federal Circuit took a “hard” approach to claim interpretation include *Moore U.S.A., Inc. v. Standard Register Co.*, 229 F.3d 1091, 1106 (Fed Cir. 2000) (A device’s extension of only 47.8% of a length could not be equivalent to a claim element that called for the device to extend “the majority of the length,” because

holding a minority to be equivalent to a majority would vitiate the majority requirement), and *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1345 (Fed Cir. 2001) (A side-by-side arrangement of tubes could not infringe a claim that specified a coaxial arrangement of tubes because “[a] particular structure can be deemed outside the reach of the doctrine of equivalents because that structure is clearly excluded from the claims whether the exclusion is express or implied.”). *Id.* at 1345.

C. In Other Cases The Federal Circuit Has Taken The “Soft,” Non-Literal Approach to the All-Elements Rule That It Took In *DePuy Spine*

DePuy Spine is one decision in which the Federal Circuit elected to ignore the specific wording of a claim. The Federal Circuit’s thinking when it is in this “soft” mode, allowing broadening of a clearly specified claim element, is illustrated by a number of other recent cases. In *Abbott Laboratories v. Dey, L.P.*, 287 F.3d 1097 (Fed. Cir. 2002), Abbott’s patent claimed a surface active material comprising a phospholipid and other ingredients, “characterized in that the overall phospholipid content is 68.6-90.7%. . . .” *Id.* at 1099. The accused product contained phospholipid up to 94.5% concentration, and Abbott presented expert testimony that the phospholipid content of the accused product was insubstantially different from the claimed phospholipid content because “95 percent [phospholipid] would work exactly the same” as the claimed 90.7%, and that “it really doesn’t matter whether it is 80 or 85 or 90 or 95 or probably even 99.” *Id.* at 1101. On the other hand, the expert testified that there was an upper limit to the effective content of phospholipid, probably somewhere between 99% and 100%. *Id.* Although the trial court felt that this testimony tended to establish equivalence, it ruled that Abbott was “effectively and improperly reading out the phospholipid range limitation

altogether.” *Id.* at 1102. The Federal Circuit reversed, seizing upon the fact that there was *some* upper limit—although not the 90.7% stated in the claim—to allow Abbott to invoke the doctrine of equivalents. *Id.* at 1107.³

The Federal Circuit similarly took the “soft” approach in *Insituform Technologies, Inc. v. Cat Contracting, Inc.*, 99 F.3d 1098 (Fed. Cir. 1996). The Federal Circuit interpreted a patent claim “as limited to ‘a process using only one vacuum cup.’” *Id.* at 1106 (Internal citation omitted). Nevertheless, the Federal Circuit found that a process that used multiple cups infringed the claim under the doctrine of equivalents. *Insituform Technologies, Inc. v. Cat Contracting, Inc.*, 161 F.3d 688, 693 (Fed. Cir. 1998). In finding infringement, the Federal Circuit found no substantial differences between the claimed single-cup process and the accused multi-cup process because “the multiple cups used in the accused process each perform precisely the same steps and functions as the single cup of the claimed method. Every limitation in claim 1, therefore, is met by at least one cup in Defendants’ multiple cup process.” *Id.*

The “soft” approach, which eschews a literal reading of patent claims, may be fairer to some patentees in some circumstances than the unforgiving “hard” test. Yet, this approach inevitably leads to uncertainty on the part of a patentee’s competitors, who will not know how “soft” any given court might be. Thus, a clear rule for allowing equivalents beyond the literal interpretation of the claims, in appropriate circumstances, must be established.

³ “Because Abbott’s application of the doctrine of equivalents to a phospholipid upper limit of 94.5% does not eliminate the upper limit of phospholipid from the claim, Abbott should not be precluded on this basis from relying on the doctrine of equivalents in this case.” *Abbott Laboratories*, 287 F.3d at 1107.

D. The "Hard" Approach Does Not Satisfy This Court's Requirement for Equity for Patentees

This Court has resoundingly expressed its desire to assure that patentees are equitably treated and given the protection they deserve. This Court has, as a result, consistently expressed its faith in the doctrine of equivalents, stating that claims must not be read so literally as to "leave room for - indeed encourage - the unscrupulous copyist to make unimportant and insubstantial changes and substitutions in the patent which, though adding nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law." *Graver Tank*, 339 U.S. at 607. An unqualified "hard" approach to claim interpretation, as practiced by the Federal Circuit in the cases described in § I.B. *supra*, is unsatisfactory because it has the potential to "convert the protection of the patent grant into a hollow and useless thing," *id.*, resulting in inequitable treatment of patentees.

E. The "Soft" Approach Does Not Satisfy This Court's Requirement for Public Notice

This Court has also expressed its alarm at the effect of the doctrine of equivalents on the public notice function of patent claims. Indeed, the "soft" approach is nothing more than a broad application of the doctrine of equivalents, and "[t]here can be no denying that the doctrine of equivalents, when applied broadly, conflicts with the definitional and public-notice functions of the statutory claiming requirement." *Warner-Jenkinson*, 520 U.S. at 29. An unqualified "soft" approach to claim interpretation, as practiced by the Federal Circuit in the cases described in § I.C. *supra*, is therefore as unsatisfactory as an unqualified "hard" approach.

II. This Court Must Reject the Federal Circuit's Inconsistent Application of the All-Elements Rule And Endorse A Framework For Clear Application of That Rule, Such As A Determination Of Whether the Equivalent Feature in Question Was Foreseeable at the Time of Patenting

A. The All-Elements Rule Can Be An Efficient Threshold Rule When Evaluating Equivalence

DePuy Spine and *Tronzo* are examples of cases in which, had a clear method been consistently applied by the appeals court, the all-elements rule could have been (and was, in *Tronzo*) used to dispose of a theory of equivalence. In these cases the disputed claims were written with simple and unambiguously stated structural limitations. In *Tronzo*, the claim called for a conical shape, and the Federal Circuit found that there could be no equivalence because the accused product had a hemispherical shape. In *DePuy Spine*, the claim called for a spherical shape and the Federal Circuit should have ruled there could be no equivalence because the accused product had a conical shape, in analogy to *Tronzo*. In *DePuy Spine* the patentee could have attempted to obtain a patent in which the invention described in the specification and recited in the claims either specifically encompassed other shapes, or was not limited to a specific shape. The PTO would then have decided whether inventions comprising other shapes, or reciting no particular shape, were patentable.⁴

⁴ The PTO granted the patentee in *Tronzo* a claim comprising a generic shape. However, the Federal Circuit declared that claim invalid as anticipated by the prior art. *Tronzo*, 156 F.3d at 1160.

B. To Preserve the Public Notice Function of Claims, Adherence To The All-Elements Rule Is Essential

Straightforward application of the all-elements rule to the literal wording of the claim in *DePuy Spine* would have definitively solved the question of infringement by equivalents, just as it did in *Tronzo*. The public expects patent claims to define the boundaries of the invention, and in these cases, which involved no nuance or subtlety of language, the public should have been able to rely on the boundaries the patentees themselves chose. But even if a court declined to apply the all-elements rule in *DePuy Spine*, it could have asked whether there was a reason that the '678 patentees could not, and should not, have claimed their invention more broadly. In the absence of such a reason, the patentee should not have access to the doctrine of equivalents to effectively re-write its claims.

C. To Preserve The Patentee's Rights, The All-Elements Rule Should Be Tempered By A Foreseeability Test

Although there are cases, such as *DePuy Spine* and *Tronzo*, in which application of the all-elements rule may be straightforward, more complex cases are not uncommon. In such cases pure literalism will not preserve all of the rights a patentee should have in his invention, as this Court has pointed out in *Graver Tank* and *Warner-Jenkinson*. To preserve those rights, pure literalism should be tempered by a rule which, in return for protection of patentee rights, is both simple to apply and properly assesses burdens between the patentee and his competitors. The foreseeability test already endorsed by this Court in *Festo* would accomplish these goals.

1. This Court's *Festo* Foreseeability Test Should Be Extended To All Determinations Under The Doctrine of Equivalents

This Court has already invoked a foreseeability test to regulate the application of the doctrine of equivalents in the context of prosecution history estoppel. In *Festo*, this Court set the price that a patentee must pay for having surrendered subject matter for purposes of patentability during prosecution. This price was the surrender of all equivalents to which the amendment was relevant, except for “equivalents *unforeseeable* at the time of the amendment *and* beyond a fair interpretation of what was surrendered.” *Festo*, 535 U.S. at 738. (emphasis added)⁵ Thus, having voiced its disinclination for pure literalism, or the “hard” approach in applying the doctrine of equivalents, this Court adopted a moderated, softened literalism, providing for a “flexible” application of the doctrine. *See id.*

However, there is no reason to limit the approach of *Festo* to the issue of prosecution history estoppel. The rationale for this Court’s imposition of a foreseeability requirement to constrain the doctrine of equivalents in *Festo* applies as well when prosecution history estoppel is not implicated. Even if a patentee gave up some equivalent, or range of equivalents, by amendment, other equivalents may be conceivable—and may not have been foreseeable by the patentee. The *particular* equivalent in question might well

⁵ The *Festo* decision, in detail, holds it a rebuttable presumption that prosecution history estoppel bars a finding of equivalence. A patentee can overcome the presumption if he can show the equivalent was unforeseeable, the rationale underlying his surrender was only tangentially related to the equivalent in question; or there was some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. *Festo*, 535 U.S. at 740-741.

lie in this universe of equivalents. Because the terrain of possible equivalents may outstrip the terrain surrendered by amendment, and because “[t]he patentee, as the author of the claim language, may be expected to draft claims encompassing readily known equivalents,” *id.* at 740, the presumption that a patentee foresaw, or should have foreseen, a particular embodiment of his invention and did not claim it—thus surrendering it—should apply in all cases. The patentee who has not amended his claim should be held to the same standards of claim-writing as the patentee who has, and any patentee who seeks to invoke the doctrine of equivalents should be subject to the foreseeability test of *Festo*.

2. A Foreseeability Test And the All-Elements Rule Can Work Cooperatively To Properly Constrain the Doctrine of Equivalents

The method for achieving reasonable limits on the doctrine of equivalents by applying the all-elements rule in association with a foreseeability test would be straightforward. In analyzing any case of possible infringement by equivalence, the all-elements rule and foreseeability test may be applied in order. First, an accused equivalent would be examined to determine whether it satisfies the “all-elements rule.” Such an examination might be relatively simple, as, for example, in cases such as *Tronzo*, where the element in question was a well-understood structural shape. If the accused equivalent could not be dismissed using the all-elements rule, the next level of analysis would be an examination in light of the foreseeability rule, in which the accused equivalent would be examined to determine whether it was, or could have been, foreseeable to the patentee. This question of fact might be answered on the basis of intrinsic evidence, including the

patent specification, and, possibly, extrinsic evidence, in the form of what was known in the prior art. If the accused equivalent was foreseeable but not claimed, then the patentee should not be permitted access to the doctrine of equivalents to effectively re-write the claim. If the accused equivalent was not foreseeable, a function/way/result or "insubstantial differences" test could be applied.

3. A Foreseeability Test Balances Public Rights And A Patentee's Rights and Responsibilities

A foreseeability test balances the public's right to know the boundaries of a patentee's claim with the patentee's right for protection against the "imitation of a patented invention which does not copy every literal detail," a right emphasized in *Graver Tank*. 339 U.S. at 608. This balance results because the test, in conjunction with the all-elements rule, reduces the subjectivity of the ultimate decision by providing a defined method for analyzing equivalence. The importance of the literal wording of a patent claim is enhanced, improving public notice, while the possibilities for going beyond this wording are clearly spelled out, both improving public notice of the possibility of equivalents and protecting the patentee from possibly excessive constraint by the literal wording of a claim.

4. A Foreseeability Test Properly Allocates Costs For Improving Patent Quality

The quality of issued patents⁶ will improve if a foreseeability test is adopted. Making the costs of considering foreseeable equivalents the responsibility of the patentee puts the burden of clear claim drafting on the person holding the pen, a fair result that will require patentees to ask whether each specifically recited claim element is necessary to practice their invention.

III. This Is An Appropriate Time for This Court To Consider This Issue

A. Consideration of This Issue Now would assure consistency in This Court's Current Examination of Federal Circuit Jurisprudence

This Court is currently engaged in a critical examination of the Federal Circuit's interpretation of the patent laws since its inception a quarter-century ago. This Court has already examined Federal Circuit jurisprudence on the subjects of preliminary injunctions, *eBay v. MercExchange*, 126 S.Ct. 1837 (2006), and licensee estoppel, *MedImmune, Inc. v. Centocor, Inc.*, 127 S. Ct. 1118 (2007), and has heard argument on the Federal Circuit's criterion for determining whether an invention is "obvious," *KSR v. Teleflex*, 04-1350. (Oral argument heard on November 28, 2006). The court also recently heard argument on patent

⁶ "Patent quality" has been defined in terms of how well a patent's validity can be defended in re-examination or litigation. See *Generally*, National Research Council, *A Patent System for the 21st Century* (2004), Ch. 3 (available at http://books.nap.edu/catalog.php?record_id=10976). However, the quality of a patent may also be measured by its clarity. A general measure of this quality would be the amount of infringement litigation based on the doctrine of equivalents arising in patent suits.

protection in the U.S. for software copied abroad, under 35 U.S.C. § 271(f). *A.T. & T Corp. v. Microsoft*, 05-1056. (Oral argument heard on February 21, 2007). Because the determination of infringement by equivalence is of equally critical importance to patentees and the public, clarification of this issue is necessary now, and will have significant ramifications not only in the area of patent litigation, but also in industrial development.

B. Consideration of This Issue Is Timely Specifically For This Case

This case has not had a final judgment, having been remanded to the district court for a determination of equivalence. Therefore, this case is in the same posture as *KSR International v. Teleflex, Inc.*, 04-1350, which was argued before this Court on November 28, 2006. In *KSR*, as in *DePuy Spine*, a summary judgment was vacated by the Federal Circuit, which remanded the case to the lower court.

This Court has “no absolute bar to review of non-final judgments of the lower federal courts.” *Mazurek v. Armstrong*, 520 U.S. 968, 975 (1997). A ruling by this Court now would also be permissible because it would be “fundamental to the further conduct of the case”—indeed, could be dispositive. See *Gillespie v. United States Steel Corp.*, 379 U.S. 148, 152-154 (1964); *Larson v. Domestic & Foreign Commerce Corp.*, 337 U.S. 682, 685, n. 3 (1949); *Land v. Dollar*, 330 U.S. 731, 734, n. 2 (1947); *United States v. General Motors Corp.*, 323 U.S. 373, 377 (1945). For these reasons, consideration of this case now by this Court is appropriate.

CONCLUSION

For the reasons stated, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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