

No. \_\_\_\_ 071070 FEB 14 2008

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IN THE

**Supreme Court of the United States**

ORMCO CORPORATION,  
*Petitioner,*

v.

ALIGN TECHNOLOGY, INC.,  
*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**

DAVID L. DEBRUIN  
CHARLES J. CRUEGER  
RICHARD H. MARSCHALL  
MICHAEL, BEST &  
FRIEDRICH, LLP  
100 East Wisconsin Avenue,  
Suite 3300  
Milwaukee, WI 53202-4108  
(414) 271-6560

*Attorneys for Petitioner  
Ormco Corporation*

CARTER G. PHILLIPS  
*Counsel of Record*  
SIDLEY AUSTIN LLP  
1501 K Street, NW  
Washington, DC 20005  
(202) 736-8270

### **QUESTION PRESENTED**

Whether a court can properly determine an inventor's rights under a patent without regard to the text of the claims in the patent.

**PARTIES TO THE PROCEEDINGS**

Pursuant to Rule 14.1(b), the following list identifies all of the parties appearing here and before the Court of Appeals for the Federal Circuit.

The petitioner here and appellant and cross-appellee below isOrmco Corporation. Allesee Orthodontic Appliances, Inc. appeared below as a cross-appellee.

The respondent here and appellee and cross-appellant below is Align Technology, Inc.

**RULE 29.6 STATEMENT**

Ormco Corporation is the parent company of Allesee Orthodontic Appliances, Inc. Ormco Corporation is a wholly owned subsidiary of Sybron Dental Specialties, Inc. Sybron Dental Specialties Inc. is a wholly owned subsidiary of Danaher Corporation, a publicly traded corporation. No other publicly held company owns 10% or more of the stock of any of those companies.

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**PETITION FOR A WRIT OF CERTIORARI**

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Petitioner Ormco Corp. respectfully requests that this Court grant the petition for a writ of certiorari to review the decision and judgment of the United States Court of Appeals for the Federal Circuit.

**OPINIONS BELOW**

The decision of the court of appeals (Appendix ("App.") 1a-39a) is published at 498 F.3d 1307 (Fed. Cir. 2007). The order of that court denying the Petition for Panel Rehearing and Rehearing en Banc (App. 55a-56a) was entered on October 24, 2007 and is unreported. The opinion of the United States District Court for the Central District of California (App. 40a-54a) granting summary judgment of non-infringement is unreported.

## **JURISDICTION**

The court of appeals entered its judgment on August 24, 2007, and denied the petition for rehearing on October 24, 2007. On January 7, 2008, the Chief Justice granted an extension of time within which to file a petition for certiorari to and including February 14, 2008. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

## **STATUTORY PROVISIONS INVOLVED**

35 U.S.C. § 112 provides in relevant part: "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

## **STATEMENT OF THE CASE**

It is axiomatic that in all cases of statutory construction, the starting point is the text of the statute. That is because the text reflects Congress's intent. An equally fundamental and analogous rule exists in patent law: in construing the claims of a patent—that portion of the patent that defines the invention—the starting point must be the text of the claims. Both the Patent Act (35 U.S.C. § 112) and this Court's precedents expressly provide that the patented invention is defined by the patent's claims. *Altoona Publix Theatres v. Am. Tri-Ergon Corp.*, 294 U.S. 477, 487 (1935) ("Under the statute, it is the claims of the patent which define the invention."). Thus, the patent claims, similar to the text of a deed, serves an important public notice function: informing the public which products or processes would infringe the patent and which would not. See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535

U.S. 722, 730-31 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33-34 (1997) (claims serve definitional and notice function). “Victory in an infringement suit requires a finding that the patent claim ‘covers the alleged infringer’s product or process,’ which in turn necessitates a determination of ‘what the words in the claim mean.’” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 374 (1996).

The Federal Circuit here defined the patented invention without regard to the claims and without ever determining what any of the words in the 92 asserted claims mean. In fact, the court ignored most of the 92 claims.<sup>1</sup> Instead of looking to the text of the claims, the Federal Circuit, as the dissent pointed out, gleaned the purported “invention” from sources other than the claim language and then compared that finding—not the claims—to the product accused of infringement. Only by departing from this Court’s precedent and ignoring the text of the claims could the Federal Circuit hold that “the invention” involves an automatic determination of finish tooth positions *without operator involvement* when the claim expressly requires “*an operator* interacting with a computer . . . , altering the graphic representation [of the teeth] . . . to produce a digital model of a desired arrangement of the teeth. . . .” App. 63a (claim 1, Pat. No. 6,616,444 (the “’444 patent”)). The Federal Circuit’s holding that “the invention” can be defined from sources other than the claims eviscerates the public notice function of the patent laws and will foment further confusion and unpredictability on *the*

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<sup>1</sup> Each claim stands on its own as defining an invention independent of the other claims. *Altoona Publix Theatres*, 365 U.S. at 487.

fundamental issue presented by every patent—what is the patented invention? The direct conflict between the Federal Circuit and this Court on an issue as important as the role of text in patent claim construction clearly warrants certiorari.

**A. The district court determined non-infringement and invalidity without construing the claims.**

Ormco sued respondent Align for infringing 92 claims in four patents. Most of the asserted claims are found in the '444 patent. The claims relate to the use of computers to assist orthodontists in the design and manufacture of custom orthodontic appliances, *i.e.*, appliances based upon the individual patient's anatomy. App. 63a-77a. Respondent Align designs and manufactures custom orthodontic appliances using a computer to alter images of the patient's teeth to arrange them in various desired positions. App. 49a-50a. The district court had jurisdiction under 28 U.S.C. § 1338(a).

Respondent moved the district court for summary judgment of non-infringement, arguing that all 92 of the asserted claims were limited to "automatic computer determination of the finish positions of teeth." App. 44a. According to respondent, it did not infringe because its process uses "skilled operators rather than a fully automated computerized process to determine finish positions of the teeth." App. 17a. Respondent identified nothing in the text of '444 patent claim 1, however, or in the text of any of the other 92 asserted claims, that required Ormco's invention to be limited in this way. Instead, respondent pressed the district court categorically not to review the claims at all, arguing that "the

claims need not be individually discussed”; that “there is no need . . . to review each and every asserted claim”; and that the “issue is not the meaning of a particular word, but rather that Ormco made it perfectly clear that *the very nature of its invention* was for automatic computer determination of the finish positions of teeth. . . .” App. 80a; App. 82a-83a.

The district court accepted this curious methodology, stating that it was “not interpreting the specific language of the claims to favor one side or the other.” App. 42a n.1. It granted summary judgment of no infringement by holding that Ormco’s invention required automatic determination of finish tooth positions and denied as moot Ormco’s motion for briefing and a hearing on the meaning of particular claim terms. App. 42a n.1 and App. 49a-52a. Having thus determined the content of Ormco’s patented invention without regard to the claims, the district court subsequently granted respondent summary judgment that all the claims were invalid as not enabled.

**B. The Federal Circuit affirmed without construing a single word in any claim.**

A divided panel of the Federal Circuit affirmed the district court’s judgment with respect to almost all of the 92 asserted claims.<sup>2</sup> Some Federal Circuit cases hold that when a district court refused to construe the language of a claim, the proper course for the

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<sup>2</sup> The court excepted claims 37-40, 45, and 69 of the ’444 patent. In its appeal brief, respondent stated that these six claims “on their face stop short of any aspect of the essence of the invention,” and thus were “the only claims that could survive this appeal.” App. 78a-79a.

court of appeals is to remand to require the district court to perform its claim construction function in accordance with *Markman*, 517 U.S. at 389-91. App. 25a-26a. Indeed, the dissent here concluded that since there was no claim construction record developed below, “the district court’s failure to construe the claim language in this case, standing alone, warrants remand.” App. 27a.

The majority did not follow this precedent. It held instead that because it reviews “decisions, not opinions,” it “need not exalt form over substance and vacate what is essentially a correct decision.” App. 18a. The majority held that Ormco’s invention was “automatic computer determination of the finish positions of the teeth without human adjustment of the final results.” App. 17a. Based on that holding, the court then found that these claims were not infringed. *Id.* It also found these claims were invalid because “Ormco had never attempted to create a computerized system that automatically determined tooth positions without human decision making.” App. 19a.

In reaching its conclusion, the majority did not cite or begin with the text of any of the claims it purported to construe. App. 28a. Instead, the court began its analysis with the patents’ lengthy and complex common specification, concluding: “[t]he specification thus provides clear indication that *the invention* is in the automatic determination of tooth position.” App. 10a (emphasis added).

Having divined the “patented invention” from the specification alone, without recourse to the text of the claims, the court then equivocated, conceding that the specification “standing alone, may not be conclusive in showing that the claims require completely



automatic determination of final tooth positions.” App. 10a. To quote the dissent: “[R]ecognizing the danger of counseling a district court to rely on language from the specification *to the exclusion of* language in the claims themselves, and recognizing that the statements in the specifications are less definitive than Align claims, the majority concedes that . . . the specification may not be conclusive to show that the claims require completely ‘automatic determination of finish tooth positions.’” App. 33a (emphasis added). That should have been reason enough to remand to the district court to construe the claims.

Undaunted and in further disregard of the claim text, the court of appeals sought to bolster its conclusion by turning to the prosecution history of a patent other than one in litigation, *viz.* the history of the ’562 patent.<sup>3</sup> The ’562 patent is a distant ancestor to the ’444 patent. The claims of the ’562 patent are not at issue in this case and, as the dissent correctly observed, “do not share claim language with the majority of the claims at issue in this suit.” App. 34a. Simply stated, the court ignored the prosecution history of the claims of the ’444 patent. App. 37a. n.5.

As summarized by the dissent: “[A]fter examining the specification of one of the patents in suit (but not its prosecution history), and the prosecution history of a patent which is not in suit, [the majority] back[ed] into a form of claim construction by asserting that all of the claims address themselves to

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<sup>3</sup> A prosecution history is the Patent Office record of the patent application and the proceedings that lead to an issued patent. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370 (1996).

the practice of determining finish tooth positions.” App. 28a. The majority never identified any “word or words in the claims in suit it purport[ed] to construe,” and never identified “*what* language is used in *which* claims to describe that practice, or why such language is in need of interpretation.” App. 28a. (emphasis in original). Of the 92 claims asserted, the court failed even to mention any language from 55 of the claims asserted from the ’444 patent—independent claims 10, 23, 30, 46, 54, and 70 and claims that depend from them—and ignored their prosecution history.

The dissent, by Judge O’Malley, was highly critical of the majority. She pointed out that the majority “concede[d], as it must, that none of the claims in suit ‘expressly recite automatic control of the finish tooth positioning.’” App. 28a (quoting majority). Nevertheless, “[d]espite the absence of this language in the claims . . . the [majority] concludes that this unstated (and seemingly important) limitation is ‘what [the claims] mean.’” App. 28a (quoting majority).

[T]he majority has: imported the terms “automatically” and “automated” from the specification to the claims; found that the terms “automatically” and “automated,” when used in the specification, are the same terms (without a record of how one skilled in the art would construe those terms); concluded that, in every instance, the words “automatically” and “automated” mean “completely automatically” or “completely automated;” found that, where a claim is silent on the issue, use of an operator is wholly precluded; and found that, where involvement of an operator is claimed, that operator cannot be skilled.

App. 32a. Accordingly, the dissent would have reversed and remanded “with direction that the claim language at issue *be construed* and that a record supporting that construction be developed.” App. 39a (emphasis added).

### **REASONS FOR GRANTING THE PETITION**

The Federal Circuit’s holding renders meaningless 35 U.S.C. § 112’s express direction that the claims define the patented invention. It also conflicts directly with this Court’s controlling precedent that “[u]nder the statute, it is the claims of the patent which define the invention.” *Altoona Publix Theatres*, 294 U.S. at 487. “[T]he claims of the patent, not its specifications, measure the invention.” *Smith v. Snow*, 294 U.S. 1, 11 (1935); *see also Warner-Jenkinson*, 520 U.S. at 29 (“[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention” (discussing doctrine of equivalents)).

Claim construction is the foundation for judging patent infringement and patentability. Infringement “necessitates a determination of ‘what the words in the claim mean.’” *Markman*, 517 U.S. at 374. Clearly delineating the boundaries of the patented property rights by adhering to the claim text is vital to providing the public with notice of what is patented. Failure to define the patentee’s rights by reference to the patent claims destroys the ability of the public, and the patent owner, to know what is owned. In this case, the Federal Circuit held that the essence of “the invention” could be determined from sources other than the patents’ claims; indeed, the court of appeals ignored over half of the claims at issue in this case and, as the dissent pointed out,

never identified “*what* language is used in *which* claims to describe that practice, or why such language is in need of interpretation.” App. 28a.

This case also poses sharply the conflict within the Federal Circuit, which has become increasingly polarized, concerning the primacy to be accorded to the actual language of the claims. Since this Court in *Markman* assigned the task of claim construction to judges in the hope of increased uniformity, 517 U.S. at 390, the binding law from the Federal Circuit on claim construction has become increasingly confused and varies by panel with unpredictable results. Some Federal Circuit panels look first to the text of the claim and anchor the claim construction analysis to specific language in the claim to define the patented invention; other Federal Circuit panels are decidedly more free-form, determining claim scope by picking and choosing from among various types of statements in the specification and prosecution history with little or no regard for the actual language of the claims. The majority opinion here presents a stark example of this latter, atextual, approach.

By analogy to statutory interpretation, it is as if some Federal Circuit decisions accord primary importance to the text of the statute that is at issue, while other Federal Circuit decisions focus primarily on the statute’s legislative history and overall purpose. This Court long ago resolved the proper methodology for deciding this question in the context of statutory interpretation—the process begins and often ends with the text and only when there is ambiguity does the Court look to other sources. The function of those other sources, moreover, is simply to shed light on the correct meaning of the statutory text—not to rewrite the statute so that it effectively

says something else. The Court should follow the same course here and make clear that claim construction can never be divorced from the language of the claims. The claim language always should be the starting point and often the end point of the inquiry, but it should never be an afterthought.

The difference in approach within the Federal Circuit, as exemplified by this case, can often depend on a single judge on the panel. In *Ventana Medical Sys. v. Biogenex Labs.*, 473 F.3d 1173 (Fed. Cir. 2006), the majority adhered to the claim text, while the dissent expressly advocated an atextual “essence of the invention” approach; the Federal Circuit’s decision in this case is actually the *dissent* in *Ventana*, creating directly conflicting standards that can only bewilder both litigants and district courts. *Id.* at 1185-87.

The Court should intervene now because the Federal Circuit has made it clear that it either is unwilling or unable to halt the growing disparity in its precedent. This confusion on an issue central to every patent, and to every patent case, has allowed district courts to “streamline” the claim construction process in a way that does violence to the text of the claims and in turn renders the public notice function a nullity. The patent laws reflect a policy decision that intellectual property protection through patent rights has a strong positive effect on technological change and therefore on economic growth. Achieving these benefits, however, requires that the boundaries of the patent right be clear. “A patent owner should know what he owns, and the public should know what he does not,” and “[t]his clarity is essential to promote progress, because it enables efficient investment in innovation.” *Festo*, 535 U.S. at 730-31.

The Federal Circuit's failure to provide a uniform rule of law on the role of the claim text in defining the scope of the patented invention yields unpredictable results that subvert that national policy decision. That is reason enough for the Court to grant certiorari.

**I. THE FEDERAL CIRCUIT'S DISREGARD OF THE TEXT OF THE CLAIMS IS IN DIRECT CONFLICT WITH THIS COURT'S PRECEDENTS AND EVISCERATES THE PUBLIC NOTICE FUNCTION OF THE PATENT'S CLAIM LANGUAGE.**

The Federal Circuit here determined "the invention" in the four patents in suit by attempting to discern "the invention" from the very lengthy specification and the prosecution history of a patent not even in suit, rather than from the text of the claims. Its decision directly conflicts with *the* fundamental tenet of patent law that a patented invention's scope is determined by the text of the claims. 35 U.S.C. § 112; *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961) ("the claims made in the patent are the sole measure of the grant"); *Altoona Publix Theatres*, 294 U.S. at 487 ("Under the statute, it is the claims of the patent which define the invention."). Section 112 of the patent statute requires that every patent contain one or more claims "particularly point out and distinctly claiming" the subject matter of the invention. 35 U.S.C. 112, ¶ 2. The patent claim thus defines the invention for the purpose of applying the conditions of patentability under the patent statutes. See generally 35 U.S.C. §§ 102-103 & 112. The patent claim is the measure by which patent infringement and patent invalidity is judged. *Markman*, 517 U.S.

at 374; *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 276-78 (1949). The patent claim gives the public notice of what is, and what is not, the “patented invention” that persons cannot make, use or sell without incurring liability to the patent owner. 35 U.S.C. § 271(a).

This public notice function of patent claims is critical to achieving the policy aims of Congress. The patent system embodies “a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years.” *Bonito Boats Inc. v. Thunder Craft Boats Inc.*, 489 U.S. 141, 150-51 (1989). In *Festo* this Court observed:

The patent laws “promote the Progress of Science and the useful Arts” by rewarding innovation with a temporary monopoly. U.S. Const. Art. I, § 8, cl. 8. The monopoly is a property right; and like any property right, its boundaries should be clear. This clarity is essential to promote progress, because it enables efficient investment in innovation. A patent holder should know what he owns, and the public should know what he does not.

535 U.S. at 730-31.

In furtherance of the public notice function, the infringement inquiry requires attention to each claim element rather than the invention as a whole. See e.g. *Warner-Jenkinson Co.*, 520 U.S. at 29; *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 607 (1950) (“In determining whether an accused device or composition infringes a valid patent, resort must be had in the first instance to the words of the

claim. If accused matter falls clearly within the claim, infringement is made out and that is the end of it.”). The issue is whether the accused product or process falls within the description of the claim, not whether it is the same or similar to an embodiment described in the patent specification. *Smith*, 294 U.S. at 11 (“the claims of the patent, not its specifications, measure the invention.”); *Merrill v. Yeomans*, 94 U.S. 568, 570 (1876) (“[the statutorily required] distinct and formal claim is, therefore, of primary importance, in the effort to ascertain precisely what it is that is patented to the appellant in this case.”).

The Federal Circuit decision here disregards this binding law and utterly lacks any analysis that is based on the text of the claims. The court did not “resort . . . in the first instance to the words of the claim,” *Graver Tank & Mfg. Co.*, 339 U.S. at 607; to the contrary, the court ignored and never discussed over half of the claims that are being asserted. A claim never discussed is a “patented invention” ignored. See *Graver Tank & Mfg. Co.*, 336 U.S. at 277 (“It would accomplish little to require that claims be separately written if they are not to be separately read.”); *Altoona Publix Theatres*, 294 U.S. at 487 (“The Court of Appeals, in upholding the patent, made no examination of its separate claims. . . . And each claim must stand or fall, as itself sufficiently defining invention, independently of the others.”). That the court ignored so many of the asserted claims while at the same time purporting to construe all 92 asserted claims for the first time on appeal without the benefit of any construction by the trial court reveals clearly the flawed methodology that the majority employed. App. 26a-27a.



The Federal Circuit made it quite clear that it defined “the invention” by the patents’ common specification, not their varied claims, disregarding 35 U.S.C. § 112 and this Court’s admonition that “the claims of the patent, not its specifications, measure the invention.” *Smith*, 294 U.S. at 11. If it is “unjust to the public” and an “evasion of the law” to construe a claim “in a manner different from the plain import of its terms,” *White v. Dunbar*, 119 U.S. 47, 52 (1886), then surely it is equally “unjust” and an “evasion of the law” to ignore the claim terms altogether and define a patented invention by its specification. Yet that is exactly what the Federal Circuit did here.

The Federal Circuit’s use of “prosecution disclaimer” to prop up its conclusion further highlights its disregard for the claim text and the conflict with this Court’s precedent, which ties the relevance of a prosecution history to the language of the claims. *Smith* held that a prosecution history (also called the file wrapper) can be relevant to prevent a patentee from “broaden[ing] his claim by dropping from it an element which he was compelled to add in order to secure his patent.” 294 U.S. at 14-15. Thus, in *Smith v. Snow* the Court looked first to the language of the claims and then to the prosecution history of the claim in suit to determine if the patentee had restricted the claims to obtain allowance (and found that he had not). *Id.* at 15-16. Use of the prosecution history to limit claims without regard to the claim language conflicts with *Smith* and finds no support in this Court’s precedents.

Searching for the essence or heart of “the invention” is a form of claim construction that, as the dissent observed, this Court soundly rejected in *Aro Mfg. Co.*, 365 U.S. at 345 (“there is no legally

recognizable or protected ‘essential’ element, ‘gist’ or ‘heart’ of the invention in a combination patent”). The invention is defined by the claims, and it is only by looking to the words in the claim, not some purported “essence” or “nature” of the invention, that courts can adhere to Congress’s goal of giving interested persons notice of what is and is not patented.

The approach adopted by the majority below is akin to a method of statutory interpretation this Court abandoned more than two decades ago. In the middle part of the last century, it was common for courts to interpret statutes primarily by reference to legislative history and the overall policy of the law. See William N. Eskridge, Jr., *The New Textualism*, 37 UCLA Law Rev. 621, 626-628 & nn.16, 25 (1990) (collecting examples from this Court’s case law from the 1920s through the 1980s); see also, e.g., *United Steelworkers v. Weber*, 443 U.S. 193, 201 (1979) (refusing to adopt “a literal interpretation” of Title VII’s text and turning instead to its legislative history and “the historical context from which the Act arose”). Beginning in the 1980s this Court adopted a more rigorous approach to statutory interpretation that “always” focuses in the first instance on the language of the law. See, e.g., *Knight v. C.I.R.*, 128 S.Ct. 782, 787 (2008); *Barnhart v. Sigmon Coal Co.*, 534 U.S. 438, 450 (2002); *United States v. Gonzales*, 520 U.S. 1, 4 (1997). If the language is unambiguous, the inquiry ends there as well. *Desert Palace, Inc. v. Costa*, 539 U.S. 90, 98 (2004). If there is a lack of clarity in the language, then the Court turns to additional sources—the structure and history of the statute, rules of construction and on occasion legislative history. See, e.g., *Dolan v. U.S. Postal Serv.*, 546 U.S. 481, 486 (2006); *Koons Buick Pontiac GMC, Inc. v. Nigh*, 543 U.S. 50, 60-64 (2004); *Florida*

*Power & Light Co. v. Lorion*, 470 U.S. 729, 737 (1985). But even in this process, the Court does not ignore the text of the statute.

The Court should adopt the same approach to patent claim construction that it has applied in the construction of statutes. The Federal Circuit's willingness to deviate from the language of the patent claim and to find its meaning from atextual sources does the same kind of damage to the Congressional policies underlying the Patent Act that judicial departures from the language in a statute do to the separation of powers. The appropriate solution in both instances is the same. Fundamentally, the process of claim interpretation must remain just that: it must be a matter of supplying the correct meaning to the words of the text that is under scrutiny, and not a vehicle for rewriting the text according to the judicial decision maker's sense of what it should have said.

The Federal Circuit's erroneous approach of defining patented rights by abandoning the text of the claims is binding law that is applicable in every patent case. The court's decision here impacts every single patent. Its impact is not limited to infringement and validity issues in patent litigation. It impacts how intellectual property rights are valued, and thus materially affects the business interests of many corporations, both large and small. The uncertainty it has created over what patents protect adversely affects decisions made by the Patent Office, patentees, competitors, investors and, of course, lawyers who must render advice. Only this court can clarify the proper rule of construction for patents and restore the primacy of claim language that is critical to the public notice function of the patent system.

**II. THE CONFLICT IS ONGOING AS  
FEDERAL CIRCUIT PANELS ARE SPLIT  
ON THIS ISSUE AND THE FEDERAL  
CIRCUIT HAS PROVED UNABLE OR  
UNWILLING TO RESOLVE THIS FUNDA-  
MENTAL AND RECURRING PROBLEM.**

The majority's decision reflects a methodological conflict within the Federal Circuit that is recurring and will persist until this Court finally resolves it. This case is only the most recent example, but one that renders the conflict readily apparent.

As the dissent here pointed out, the Federal Circuit would have come to a different result had it decided this case under its law as set forth in *Ventana Medical Sys., Inc. v. Biogenex Labs., Inc.*, 473 F.3d 1173 (Fed. Cir. 2006). App. 36a. In *Ventana*, the majority started with the words at issue in the claim and the rule that claim terms are given their "ordinary and customary meaning" unless something in the specification or prosecution history reflected the inventor's intent that one of ordinary skill should interpret the claim term differently. *Id.* at 1180. Since it anchored its analysis to the words in the claim, the *Ventana* court found the prosecution history of an ancestor patent irrelevant because the claim terms at issue in the prosecution were different than the claims term being interpreted. *Id.* at 1182. It was the *dissent* in *Ventana* that argued that the "essence of the invention" could be gleaned from the specification and prosecution history, and that the claims should be limited to that invention. *Id.* at 1186 ("Direct dispensing is the essence of the invention, and the specification supports that conclusion.") (Lourie, J., dissenting). The dissent in *Ventana*

became the Federal Circuit's contrary but still binding precedent in this case.

Congress established the Federal Circuit with exclusive jurisdiction over patent cases hoping to bring greater uniformity to the patent law. *Florida Prepaid Postsecondary Education Expense Board v. College Savings Bank*, 527 U.S. 627, 651 (1999); *United States v. Hohri*, 482 U.S. 64, 71 (1987). Yet at least since *Markman*, the Federal Circuit has employed inconsistent claim construction methodologies and the “law” as applied has varied by panel, with a welter of published cases on both sides of the issue. Some Federal Circuit cases start with the text of the claims, and then presume that the text will be given its ordinary meaning, absent clear indications that persons skilled in the art would understand some other meaning. See e.g., *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004) (“a claim construction analysis must begin and remain centered on the claim language itself”); *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (“[T]he resulting claim interpretation must . . . accord with the words chosen by the patentee . . . .”); *Virginia Panel Corp. v. MAC Panel Co.*, 133 F.3d 860, 865-66 (Fed. Cir. 1997) (concluding that intrinsic evidence does not require modification of the ordinary meaning of “reciprocating”); *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572 (Fed. Cir. 1996) (“Without an express intent to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning.”). Other Federal Circuit cases, by contrast, take a decidedly atextual approach. They determine coverage by looking mainly to the specification and prosecution history, not the claims, to divine “the invention” from

context and limit the patent rights to that “invention.” See e.g., *Alloc, Inc. v. Int’l Trade Comm’n*, 342 F.3d 1361, 1375-82 (Fed. Cir. 2003) (Schall, J., dissenting) (dissent explaining how majority departed from precedent and “arrived at its conclusion that the asserted claims require play by relying on [statements in the specification]” and the prosecution history of a parent patent, not the claims); see also *Cultor Corp. v. A.E. Staley Mfg.*, 224 F.3d 1328, 1331 (Fed. Cir. 2000) (“Whether a claim must, in any particular case, be limited to the specific embodiment presented in the specification, depends in each case on the specificity of the description of the invention . . . .”); *Toro Co. v. White Consol. Indus.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999) (“The specification does not describe an invention broader than [the] description of the cover and the restriction ring ‘automatically’ inserted and removed together.”). These two groups of cases are inconsistent with each other. In fact, one Federal Circuit panel characterized the court’s claim construction rules as “ambivalent” and observed that their “careless application . . . can be a recipe for error.” *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003).

Scholarly studies have recognized and documented the deep and irreconcilable conflict in the Federal Circuit’s claim construction methodologies. A recent study identified two conflicting methodologies employed by the Federal Circuit: one favoring the ordinary meaning of the text; the second “distinctly more free-form” and based more heavily on non-textual sources. R. Polk Wagner & Lee Patherbridge, *Is the Federal Circuit Succeeding? An Empirical Assessment of Judicial Performance*, 152 U. Pa. L. Rev. 1105, 1111-12 (2004). Professor Wagner con-

cluded that a “sharp division” exists within the court as to the proper approach, that the Federal Circuit’s cases were becoming “increasingly polarized,” and that the outcome of cases are panel dependent and judge dependent. *Id.* at 1111. Another study published by now Judge Kimberly Moore in 2005 concluded that the Federal Circuit’s reversal rate of 35% on claim construction issues was getting “worse over time, not better” and that “criticism over the lack of guidance and unpredictability caused by the current claim construction process is warranted.” Kimberly Moore, *Markman Eight Years Later: Is Claim Construction More Predictable?*, 9 Lewis & Clark L. Rev. 231, 233, 237 (2005).

In 2005 the Federal Circuit granted *en banc* review to address claim construction in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*). The decision, although met with great fanfare and a plethora of amicus briefs, produced little more than a restatement of the Federal Circuit’s earlier opinions. *Id.* at 1312 (“what we said in those cases bears restating”); *see also id.* at 1330 (“[A]fter proposing no fewer than seven questions, receiving more than thirty *amici curiae* briefs, and whipping the bar into a frenzy of expectation, we say nothing new, but merely restate what has become the practice over the last ten years – that we will decide cases according to whatever mode or method results in the outcome we desire, or at least allows us a seemingly plausible way out of the case.”) (Mayer, J., dissenting). Thus, while the *Phillips*’ majority stated that “[i]t is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude,’” *id.* at 1312, it also equivocated and left unresolved whether a claim

construction must start with the words of the claim and remain anchored to the disputed claim terms.

*Phillips* used language favoring an atextual approach to claim construction rather than an approach focused on the text of the claims: “the court *starts* the decision-making process by reviewing the same resources as would [a person of ordinary skill in the field of the invention], *viz.*, the patent specification and the prosecution history.” *Id.* at 1313 (quoting *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998)) (emphasis added). The court also stated that “[t]he sequence of steps used by the judge in consulting various sources [such as the specification, prosecution history, or dictionaries] is not important.” *Id.* at 1324. Indeed, Judge Lourie, joined by Judge Newman, concurred in the court’s explication of its claim construction methodology, expressly interpreting *Phillips*’ holding to be that claims “are limited to what is contained in the overall disclosure of the specification.” *Id.* at 1328-29 (Lourie, J., concurring in part and dissenting in part). This is but another way of saying that the specification defines the patented inventions. That interpretation has resulted in the instant decision, where the patent claims are entirely disregarded.

Thus, the methodological conflict continues post-*Phillips*, and whether the Federal Circuit gives primacy to the claim language continues to be panel dependent and unpredictable. As one author who examined Federal Circuit law post-*Phillips* concluded: “The name of the game is no longer just the claim. It’s the whole patent.” Gerson Panitch, *Is the Name of the Game Still the Claim? The Post-Phillips Revolution in Patent Law*, Intellectual Property Today (June 2007). Even though the Federal Cir-



cuit's decision here conflicts both with *Ventana* and this Court's precedents, the Federal Circuit denied rehearing *en banc* and let the conflict stand. The Federal Circuit's decision here sanctions continued use of sources other than the claim language to define the "patented invention." The Federal Circuit remains polarized, and it is plain that a workable, predictable methodology for determining the scope of a patent will require renewed guidance from this Court.

**III. THE COURT SHOULD FINALLY RESOLVE THIS RECURRING CONFLICT THAT UNDERMINES CONGRESS'S POLICY DECISION TO PROTECT INTELLECTUAL PROPERTY RIGHTS THROUGH PATENT LAW.**

This Court has often observed that the patent laws reflect a policy decision that intellectual property protection through patent rights can have a strong positive effect on technological change and therefore on economic growth. *Bonito Boats Inc.*, 489 U.S. at 150-51; *Festo Corp.*, 535 U.S. at 730-31. The statutory requirement that the claims define the patentee's rights distinctly and with particularity is important both to providing the patentee with an appropriate incentive for invention and disclosure and for providing notice to the public. "[C]larity is essential to promote progress, because it enables efficient investment in innovation. A patent holder should know what he owns, and the public should know what he does not." *Festo Corp.*, 535 U.S. at 730-31. For example, if the public cannot determine what the patent protects by looking at the claims, third parties may avoid activities that are not claimed as the invention (and thus are free for the

public to use) for fear of being sued nonetheless for infringement. In addition, an inventor who cannot be reasonably certain that his claims define his patent protection may choose to avoid the patent system altogether and maintain his invention as a trade secret.

Clear and predictable boundaries can be delineated only by faithful adherence to the text of the claims. See *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 (1877) (statutory requirement that a patent include one or more claims “was inserted in the law for the purpose of relieving the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture”). There is no clarity or predictability when the scope of a patented invention remains highly uncertain until appeal and even then is panel and judge dependent. The Federal Circuit’s failure to heed the mandate of the statute and this Court’s precedent, combined with its continued internal dispute over whether to adhere to the text of the claims, affects every patent, goes to the very heart of infringement and patentability—defining what is the patented invention—and subverts the very policies the patent laws are intended to promote.

Even the Federal Circuit recognizes the problem of a jurisprudence where it finds that district courts get claim construction wrong as a matter of law over 35% of the time. *Harris Corp. v. Ericsson Inc.*, 417 F.3d 1241, 1266 (Fed. Cir. 2005) (“For various reasons this court already has a high reversal rate on claim construction issues, which tends to encourage appeals and, perhaps, discourage trial courts from heavily investing in claim constructions below.”). Similarly, district courts have openly expressed bewilderment over how to apply the applicable law

and seemingly approach the undertaking with a sense of fatalism.<sup>4</sup> The Federal Circuit has chosen to do nothing, however, to resolve this ongoing and pervasive problem in its law. Because the Federal Circuit is either unable or unwilling to resolve the conflict and is unlikely to attempt to do so again in the foreseeable future, the time has come for this Court to make clear that it meant what it said in its prior decisions—claim construction begins and never deviates from the text of the claims.

This Court has not addressed claim construction rules since long before the creation of the Federal Circuit. The issue presented requires no subtle or detailed analysis of a specification or file history to determine the “correct” claim construction for any of the 92 asserted claims in this case. Rather, the question presented is whether a court can conduct, to quote the dissent, “a form of claim construction,” without ever identifying what claim terms are in need of construction or why. Absent review by this Court, patent rights will be undermined and the public notice function of the patent claims will

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<sup>4</sup> *Merck & Co., Inc. v. Teva Pharma. USA, Inc.*, 395 F.3d 1364, 1381 (Fed. Cir. 2005) (noting that the Federal Circuit “often hears criticism from district court judges that its reversal rate on claim construction far exceeds that of other circuit courts”); *Ultratech, Inc. v. Tamarak Scientific Co.*, 2005 WL 2562623 at \*7 (N.D. Cal. Oct. 11, 2005) (“Nor can the Court say that *Ultratech*’s claim construction position is so frivolous as to warrant sanctions; to be candid, this Court is reluctant to hold that any claim construction is frivolous, given the well-known reversal rate in the Federal Circuit.”), *Cargill, Inc. v. Sears Petroleum & Transport Corp.*, 2004 WL 3507329 at \*12 (N.D.N.Y. Aug. 27, 2004) (staying permanent injunction pending appeal and noting that “I am also cognizant of the Federal Circuit’s unusually high rate of reversal, particularly when engaged in de novo review of claim construction”).

continue to be frustrated because patent holders and the public alike will be left uncertain as what is the patented invention.

### CONCLUSION

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

Respectfully submitted,

DAVID L. DEBRUIN  
CHARLES J. CRUEGER  
RICHARD H. MARSCHALL  
MICHAEL, BEST &  
FRIEDRICH, LLP  
100 East Wisconsin Avenue,  
Suite 3300  
Milwaukee, WI 53202-4108  
(414) 271-6560

CARTER G. PHILLIPS  
*Counsel of Record*  
SIDLEY AUSTIN LLP  
1501 K Street, NW  
Washington, DC 20005  
(202) 736-8270

*Attorneys for Petitioner*  
*Ormco Corporation*