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Understanding the Role of Prosecution History through Linguistics

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UNDERSTANDING THE ROLE OF PROSECUTION HISTORY THROUGH LINGUISTICS

BY ZACHARY HERMAN

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I. INTRODUCTION

This note examines an alleged conflict within the Court of Appeals for the Federal Circuit over the proper role of prosecution history in claim construction and explains how a linguistic method of evaluating evidence can improve consistency and conviction within the Federal Circuit. This issue was the subject of the denied petition for certiorari¹ from the Federal Circuit case *Cioffi v. Google, Inc.*,² in which Google argues that the Federal Circuit has been “deeply conflicted” over the availability and proper role of prosecution history in construing disputed claim language,³ and that it has restricted its use to the doctrine of disclaimer.⁴ This approach has been called the “disclaimer only” standard and treats prosecution history as being a relevant source of context only if it clearly and unmistakably disavows claim scope.⁵

Modern Federal Circuit precedent recognizes the importance of prosecution history.⁶ Google argues⁷ the Federal Circuit’s clear and unmistakable approach applies to amendments made during prosecution, which results in the inventor receiving the benefit of the doubt rather than the public.⁸ This is controversial because the Supreme Court has long held that claim amendments contained within the prosecution history should be strictly construed against the applicant and in favor of the public.⁹

¹ Petition for Writ of Certiorari, *Google, Inc. v. Alfonso Cioffi, et al.*, (No. 16-200), 2016 WL 4363496.

² 632 F. App’x 1013, 1024 (Fed. Cir. 2015) *petition for cert. filed* (U.S. Aug. 10, 2016) (No. 16-200).

³ Google filed a petition for certiorari on August 10th, 2016, alleging that the Federal Circuit has been conflicted over the significance given to a patent’s prosecution history in claim construction for years, and that this uncertainty is resulting in confusion over claim construction standards, leading to confusion in litigation and among inventors attempting to determine the scope of an issued patent during product or licensing decisions. *See* Petition for Writ of Certiorari, *supra* note 1, at 3.

⁴ *Cioffi v. Google, Inc.* is an unpublished and non-precedential decision. However, it is important as the recently denied petition for certiorari in the case of *Vederi, LLC v. Google, Inc.* presented analogous arguments to the questions presented to the Supreme Court for review in *Cioffi*, chief among them that the Federal Circuit has limited prosecution history usage in claim construction to the doctrine of disclaimer. *Compare Cioffi*, 632 F. App’x at 1024; *Vederi*, 744 F.3d 1376, 1385 (Fed. Cir. 2014), *cert. denied* 135 S. Ct. 2856, 192 L. Ed. 2d 894 (2015). *with Fenner Investments, Ltd. v. Cellco P’ship*, 778 F.3d 1320, 1323 (Fed. Cir. 2015).

⁵ *See Poly-Am., L.P. v. API Indus., Inc.*, No. 2016-1200, 2016 U.S. App. LEXIS 18486 at *1 (Fed. Cir. Oct. 14, 2016) (holding the prosecution history of Poly-America’s patent was consulted specifically for the purpose of finding a clear and unequivocal statement by the inventor that disavowed claim scope).

⁶ *See Fenner*, 778 F.3d at 1323 (“[A]ny explanation, elaboration, or qualification presented by the inventor during patent examination is relevant” during the process of claim construction.).

⁷ *See* Petition for Writ of Certiorari, *supra* note 1, at 19.

⁸ *See Cioffi*, 632 F. App’x at 1013; *Vederi*, 744 F.3d at 1384.

⁹ Historically, the Supreme Court clearly intended to give the benefit of the doubt in claim amendment-scope disputes to the public rather than the inventor. This approach is called “strictly construing amendments against the patentee.” *See Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942); *Keystone Driller Co. v. Nw. Eng’g Corp.*, 294 U.S. 42, 48 (1935); *Smith v. Magic City Kennel Club, Inc.*, 282 U.S. 784, 789–90 (1931); *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443–44 (1926); and *Hubbell v. United States*, 179 U.S. 77, 84 (1900).

Google presented these issues to the Supreme Court for review in a petition for certiorari in *Google, Inc., v. Alfonso Cioffi, et al.*¹⁰ The question before the Federal Circuit in *Cioffi*¹¹ was whether the District Court had erroneously construed the terms “web browser process” and “critical file” in Cioffi’s issued patent.¹² The Federal Circuit rejected Google’s argument that the prosecution history provided crucial context that relinquished claim scope and sided with Cioffi.¹³ Google asserts the Federal Circuit’s decision applied a standard that is the subject of conflict within the Federal Circuit and contrary to the Supreme Court’s decision in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd.*¹⁴ *Festo*¹⁵ governs the relationship between prosecution history estoppel and the doctrine of equivalents¹⁶ and should not be consulted for the purpose of governing the role of the prosecution history in claim construction.¹⁷

Another problem is the alleged application of the disclaimer-only standard to claim amendments made during prosecution.¹⁸ This standard presumes amendments made during prosecution do not automatically disavow claim scope, allowing for the possibility of the scope in question to remain intact after an amendment.¹⁹ This standard would be inconsistent with Supreme Court precedent if applied in practice, because it may allow the inventor to recapture scope lost from a narrowing amendment during prosecution.²⁰

¹⁰ Petition for Writ of Certiorari, *supra* note 1, at i.

¹¹ See *Cioffi*, 632 F. App’x at 1014.

¹² Petition for Writ of Certiorari, *supra* note 1, at 9.

¹³ In siding with Cioffi, the Federal Circuit stated that “[t]here is be no ‘clear and unmistakable’ disclaimer if a prosecution argument is subject to more than one reasonable interpretation,” and concluded that Cioffi had given “a reasonable alternative interpretation” during prosecution. See *Cioffi*, 632 F. App’x at 1021 (citing *SanDisk Corp. v. Memorex Prods.*, 415 F.3d 1278, 1287 (Fed. Cir. 2005)).

¹⁴ Petition for Writ of Certiorari, *supra* note 1, at 18.

¹⁵ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.* 535 U.S. 722, 742 (2002).

¹⁶ URY FISCHER, *THE FLORIDA BAR, FUNDAMENTALS OF PATENT LITIGATION* § 21.14 (8th ed. 2014) (explaining *Festo* is the primary governing case law on the relationship between prosecution history estoppel and the doctrine of equivalents.)

¹⁷ *Festo* should not be consulted until after claim construction has taken place because it does not govern the role of prosecution history in claim construction. Cf. *Festo*, 535 U.S. at 723 (“[A] patent’s scope is not limited to its literal terms, but embraces all equivalents to the claims described.”).

¹⁸ Petition for Writ of Certiorari, *supra* note 1, at App. 18.

¹⁹ See *Poly-Am., L.P.*, No. 2016-1200 at *1 (Fed. Cir. Oct. 14, 2016) (explaining the prosecution history was examined for the presence of an unambiguous disclaimer of claim scope, and as one was found, the contested scope was therefore sacrificed as a condition of the patent grant).

²⁰ See *Festo*, 535 U.S. at 725 (holding amendments must be strictly construed against the inventor and in favor of the public, and that the inventor bears the burden of disproving scope disclaimer); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 30 (1997) (explaining the prosecution history may be used to estop a patentee from recapturing subject matter surrendered by an amendment as a required condition of obtaining the patent); *Hubbel*, 179 U.S. 77, 84 (1900). *But see Vederi*, 744 F.3d at 1384 (Fed. Cir. 2014) (holding amended claim language deserves no different treatment unless the applicant showed a “clear and unambiguous” or “clear and unmistakable” disclaimer of claim scope in the prosecution history); *3M Innovative Prods. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1325 (Fed. Cir. 2013) (holding there was a disclaimer which was not “clear and unmistakable” so the contested scope was not disavowed).

Clearly, this issue is important²¹ and the asserted claims deserve to be analyzed. A single, unified approach to the evidence used in claim construction would be helpful in avoiding these contentious situations in the future. A look at simple linguistics can provide an over-arching framework on which a potential solution can be based.

Discerning the difference between the semantic meaning and the pragmatic meaning of claim terms gives a better understanding of why context is so critical to determining the drafter's intent, which is the ultimate purpose of claim construction.²² The prosecution history is a pragmatic source that needs to be allowed to effect claim construction unrestricted in order to arrive at the most accurate determination of claim scope. Furthermore, evaluating evidence using linguistics will result in a more unified understanding of the significance of certain evidence used during claim construction.

The Supreme Court's denial of Google's petition for certiorari was proper because Google's argument that guidance is "urgently needed to settle a foundation issue in patent law"²³ fails as its facts are divorced from the argument presented²⁴ and no substantial precedent exists to show the Federal Circuit has disregarded the importance of consulting the prosecution history.²⁵ However, the case raises a legitimate debate over the inconsistent treatment between Federal Circuit panels over the proper weight to be given to different intrinsic evidentiary sources in claim construction. The Federal Circuit should resolve this issue by taking a linguistic approach that takes into consideration both semantic and pragmatic evidentiary sources simultaneously when examining evidence during claim construction.

²¹ "[C]laim construction is overwhelmingly the most critical issue in patent litigation" See Petition for Writ of Certiorari, *supra* note 1, at 1 (quoting Greg Reilly, *Judicial Capacities and Patent Claim Construction: A Ordinary Reader Standard*, 20 Mich. Telecomms. & Tech. L. Rev. 243, 246 (2014)). Furthermore, an Amicus brief was filed in support of Google as petitioner. See Brief of the Internet Association and Computer Communications Industry Association ("CCIA") as Amici Curiae in Support of Petitioner, Google, Inc., v. Alfonso Cioffi, et al., No. 16-200, 2016 WL 4761715 (asserting the Federal Circuit's approach improperly restricts the role of "patent prosecution history in ascertaining the proper scope of patent claims, incentivizes patent applicants to avoid clarity during prosecution" and "this rule of construction fosters ambiguity and gamesmanship").

²² See *Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1305 (Fed. Cir. 2011) (stating that the purpose of claim construction is to "capture the scope of the actual invention" that is disclosed, described, or patented.).

²³ Google's main position, as advanced in its petition, states that: "Although this Court has always deemed context to be important to claim construction, panels of the Federal Circuit are divided over its relevance. As a result, [The Supreme Court's] guidance is urgently needed to settle this important and foundational issue in patent law."). See Petition for Certiorari, *supra* note 1, at 3.

²⁴ See Dennis Crouch, *Strictly Construing Amended Claims Against the Patentee*, PATENTLYO, (Feb. 4, 2016), <http://patentlyo.com/patent/2016/02/strictly-construing-patentee.html> (asserting it is questionable, and potentially dispositive, whether the arguments and issues Google presents are actually related to the real-life facts of the case).

²⁵ See Kevin Penton, *Google IP Prosecution History Arguments Fail*, LAW360 (Nov. 18, 2016), <https://www.law360.com/articles/863730/> ("While precedent set by the full Federal Circuit is clear that courts may look at a patent's prosecution history when trying to figure out the meaning of ambiguous claims, Google, Inc. instead points to other decisions concerning unrelated legal matters.").

II. GENERAL TREATMENT OF PATENT PROSECUTION HISTORY AND CLAIM AMENDMENTS IN CLAIM CONSTRUCTION

This section summarizes the current use of prosecution history in claim construction and the problem a real division within the Federal Circuit, or between Federal Circuit and Supreme Court decisions, would present. Section A briefly explains the framework of claim interpretation. Section B gives a background of *Google, Inc., v. Cioffi, et al.* Section C discusses the allegedly conflicted decisions of the Federal Circuit regarding the proper significance of prosecution history in claim construction, and why its use is not actually in danger.

A. *The process of claim language interpretation during claim construction*

Before discussing the alleged divide, a basic framework of how a case gets to and moves through claim construction is important.²⁶ First, the actual meaning of a claim term must be the subject of a legitimate disagreement.²⁷ The Federal Circuit has viewed claim construction as being appropriate even when the term in question has a plain and ordinary meaning.²⁸ Next, if it is determined that the term needs to be construed, the court will apply existing substantive rules to the literal claim language in order to define the proper construction and corresponding scope.²⁹ The initial understanding of the language comes from a simple reading of the claims, which by definition establishes the boundaries of the property right to which the inventor is entitled,³⁰ and functions as the starting point of construction.³¹

²⁶ See Dennis Crouch, *Claim Construction: A Structured Framework*, PATENTLYO (Sep. 29, 2009), <http://patentlyo.com/patent/2009/09/claim-construction-a-structured-framework-1.html>, (asserting the role of claim construction plays a key part in nearly every patent case, making understanding the basic process critical before analyzing specific element of the process); Christopher A. Cotropia, *Patent Claim Interpretation Methodologies and Their Claim Scope Paradigms*, 47 WM. & MARY L. REV. 49, 67 (2005) (explaining infringement depends in large part on a claim's boundaries which define the scope of the right; accordingly, claim constructions are "often dispositive").

²⁷ See Crouch, *supra* note 26 (explaining the first step in determining whether construction is required is establishing a legitimate disagreement. The court will determine whether a legitimate disagreement exists and whether it is ripe for construction).

²⁸ The decision in the recent case of *Clare v. Chrysler Grp. LLC*, 819 F.3d 1323, 1329 (Fed. Cir. 2016) has set new precedent by construing a claim that had a well-established plain and ordinary meaning. See Robert Schaffer & Joseph Richardson, *CAFC: Claim Construction is Appropriate Even Where Term Has a Plain and Ordinary Meaning*, IP WATCHDOG (Apr. 4, 2016), <http://www.ipwatchdog.com/2016/04/10/claim-construction-even-if-ordinary-meaning/id=68149/>.

²⁹ See Crouch, *supra* note 26 (noting there are various substantive principles of construction that are "generally not in dispute," and which are used in nearly all claim constructions).

³⁰ See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372–74 (1996) ("[A] patent includes one or more 'claims,' which 'particularly point out and distinctly claim the subject matter which the applicant regards as his invention.' 35 U.S.C. § 112. '[Furthermore, a] claim covers and secures a process, a machine, a manufacture, a composition of matter, or a design, but never the function or result of either, nor the scientific explanation of their operation.' (citing 6 Lipscomb § 21:17, at 315–316.) The claim 'defines the scope of a patent grant,' and functions to forbid not only exact copies of an invention, but products that go to 'the heart of an invention but avoids the literal language of the claim by making a noncritical change.'").

³¹ See *Markman*, 517 U.S. at 389 (finding claim construction is a matter of law, and that judges must construe the claim language in question before submitting the question of infringement to a jury); Barry W. Graham, *Markman, Claim Construction, and Webster's New World Dictionary*, FULTON COUNTY DAILY REPORTER, September 1997 (noting trial judges are to consider three sources in "ascertaining the meaning of a patent claim: the claim language itself, the patent's specification, and the patent's administrative record in the U.S. Patent & Trademark Office, often referred to as the prosecution or file history," and furthermore, that "these documents form the public record of the patent and constitute what the Court has termed the "intrinsic" evidence of claim meaning.").

The next step is for the court to determine the “ordinary meaning,” which is considered to be the objective baseline for construction.³² Finding the ordinary meaning is highly context dependent, as it is the meaning “a person of ordinary skill in the art” would give to the words of the claim in question in consideration of any special meaning and usage in their field.³³ This sentiment requires the court to consider the same resources as would the person of ordinary skill in the art: the patent claims, the specification and the prosecution history.³⁴ Thus, these are the fundamental evidence sources of claim construction.³⁵

These fundamental source “usually provides the technological and temporal context to enable the court to ascertain the meaning of the claim to a person having ordinary skill in the art at the time of the invention.”³⁶ Accordingly, patent claims are interpreted in consideration of this “intrinsic” evidence and relevant “extrinsic” evidence, such as evidence showing the normal usage of a term in its field.³⁷ Claim construction ends at the “proper construction” as determined by the court in a Markman hearing.³⁸

B. *The Background of Google, Inc., v. Alfonso Cioffi*

The purpose of consulting the prosecution history is to provide relevant context in order to determine the intent of the inventor.³⁹ However, according to Google, the Federal Circuit does not appear to have treated the use of prosecution history to a consistent standard.⁴⁰ This controversial issue was the basis of the denied petition for certiorari in the case of *Google, Inc., v. Alfonso Cioffi*.⁴¹

³² The meaning a person ordinarily skilled in art would give to the claim language after considering intrinsic and extrinsic evidence is the baseline “ordinary meaning” of the claim terms. However, the ordinary meaning is not the start of claim construction. Crouch, *supra* note 24; (quoting Vitronics Corp., v. Conceptronic, Inc., 90 F.3d 1576 (Fed. Cir. 1996) (“There is a heavy presumption in favor of giving words in a claim the ordinary meaning that would be attributed to those words by one of ordinary skill in the relevant art.”)).

³³ See Crouch, *supra* note 26.

³⁴ *Id.*

³⁵ *Markman*, 517 U.S. 370 (1996) (“The fundamental sources for claim construction are well-established and include the patent claims, the specification and the prosecution history.”).

³⁶ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (citing *V-Formation, Inc. v. Benetton Group SpA*, 401 F.3d 1307, 1310 (Fed. Cir. 2005)).

³⁷ *Phillips*, 415 F.3d at 1317 (“Although we have emphasized the importance of intrinsic evidence in claim construction, we have also authorized district courts to rely on extrinsic evidence, which ‘consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries and learned treatises.’”).

³⁸ The ruling in a Markman hearing is the result of a Court deciding specifically how to interpret a claim and what that patent claim means; therefore, Markman hearings establish the legal right of the patent holder. See Rich Beem, *How We Approach Markman Hearings and Claim Construction*, BEEM LAW, <http://www.beemlaw.com/video-gallery/markman-hearing-and-claim-construction>.

³⁹ See *Bd. Of Regents of the Univ. of Tex. Sys. v. BENQ Am. Corp.*, 533 F.3d 1362, 1369 (Fed. Cir. 2008) (holding because the prosecution history was written by the applicant in an attempt to explain their invention to the examiner, the prosecution history is often the best and only reliable evidence of “how the inventor understood the invention . . .”) (quoting *Phillips*, 415 F. 3d at 1317 (Fed. Cir. 2005)).

⁴⁰ Petition for Writ of Certiorari, *supra* note 1, at 12 (“[T]he Federal Circuit has . . . divided internally and departed from [the Supreme] Court’s precedents. As a result, different panels apply different canons of construction.”).

⁴¹ Petition for Writ of Certiorari, *supra* note 1, at 1.

Alfonso Cioffi and the Estate of Allen Rozman (“Cioffi”), alleged Google’s famous Chrome web browser infringed four of their patents, and filed suit against Google on February 5, 2013.⁴² The District Court construed multiple terms contained within claims of the four patents in Google’s favor and gave a ruling of non-infringement.⁴³ Cioffi then appealed, challenging the construction of two specific claim terms: (1) “web browser process” and (2) “critical file.”⁴⁴ The Court of Appeals for the Federal Circuit, in an unpublished opinion, reversed the District Court’s claim construction on November 17, 2015.⁴⁵ Google filed a petition for certiorari to the Supreme Court asking two things:

1. When construing a patent claim, should courts generally consult the prosecution history as context for resolving ambiguities, or is prosecution history relevant only if it clearly and unmistakably disavows claim scope?
2. When a patent applicant has amended a claim to overcome the Patent and Trademark Office’s earlier disallowance of the claim, should a court strictly construe the amended claim language against the applicant, as the Supreme Court has held, or consider the amendment history to be relevant only to the extent that it clearly and unambiguously disavows claim scope, as this Court has held?⁴⁶

The two questions asked are similar in nature, as both questions concern the proper role of intrinsic evidence sources when construing claim terms that have no established or independently known meaning in the art.

⁴² See *Cioffi*, 632 F. App’x at 1014 (Fed. Cir. 2015).

⁴³ *Id.*

⁴⁴ *Id.*

⁴⁵ *Id.* at 1023–24.

⁴⁶ Petition for Writ of Certiorari, *supra* note 1, at i.

C. *The critical importance of prosecution history in the construction of claim language*

This section discusses the first question that Google poses in its petition.⁴⁷ Supreme Court precedent shows that the prosecution history, along with all other intrinsic evidence, is valuable to interpreting claim terms.⁴⁸ However, as Google points out, certain panels of the Federal Circuit have issued decisions that appear to treat the relevance of the prosecution history to differing standards.⁴⁹

In *Cioffi*,⁵⁰ the Federal Circuit applied the “clear and unmistakable standard,”⁵¹ which is “high and exacting.”⁵² This has the effect of giving the prosecution history very little weight in ascertaining the intended scope of the claim language.⁵³ As a result, any case that follows this standard only consults the prosecution history to determine if there was clear and unambiguous disavowal of claim scope.⁵⁴ The real question, then, does Federal Circuit precedent contradict itself and present an immediate problem for review by the Supreme Court? In its petition for certiorari, Google argues that the decision in *Cioffi*⁵⁵ applies this standard⁵⁶ and cites a number of cases that have applied this standard in the past, the most recent one being ten years old.⁵⁷ However, a very recent case, *Poly-America*,⁵⁸ shows that the Federal Circuit continues to apply this standard under certain circumstances today.⁵⁹

⁴⁷ *Id.*

⁴⁸ “[T]he specification ‘is always highly relevant to the claim construction analysis . . . it is the single best guide to the meaning of a disputed term.’” *Phillips*, 415 F. 3d at 1315 (quoting *Vitronics Corp.*, 90 F.3d at 1582). *See also Phillips*, 415 F. 3d at 1317 (holding that while extrinsic evidence is useful in some cases, it is “less significant than the intrinsic record in determine the legally operative meaning of claim language”); *Graham v. John Deere Co.*, 383 U.S. 39, 49 (1966) (explaining allowed claims must be interpreted in the context of rejected claims).

⁴⁹ *See* Petition for Writ of Certiorari, *supra* note 1, at 13.

⁵⁰ *Cioffi*, 632 F. App’x 1013. *See also Vederi*, 744 F.3d 1376).

⁵¹ *See* Petition for Writ of Certiorari, *supra* note 1, at App. 12.

⁵² *See Avid Tech, Inc. v. Harmonic Inc.*, 812 F.3d 1040, 1045 (Fed Cir. 2016) (noting because the “clear and unmistakable” standard is high and exacting, the court of appeals disregards the prosecution history entirely).

⁵³ *See* Petition for Writ of Certiorari, *supra* note 1, at 13 (noting because the court, in this line of cases, first identifies a term’s meaning without reference to the prosecution history, it “examines the prosecution history only to determine whether it contains a ‘clear and unmistakable disclaimer’ of [the term’s] meaning.”).

⁵⁴ *Id.*

⁵⁵ *See Cioffi*, 632 F. App’x 1013.

⁵⁶ *See* Petition for Writ of Certiorari, *supra* note 1, at 12 (explaining the “clear and unmistakable standard” limits “prosecution history [usage] to the doctrine of disclaimer—that is, to situations in which there is a clear and unmistakable disclaimer of claim scope.”).

⁵⁷ *See* *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1078 (Fed. Cir. 2005); *SanDisk Corp.*, 415 F.3d at 1286; *Rhodia Chimie v. PPG Indus.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1327 (Fed. Cir. 2003).

⁵⁸ The Court appeared to apply the disclaimer only standard by consulting the prosecution history to if it contained “clear and unequivocal” statements intending to limit the claim scope of the invention. It found that it did, which constituted disavowal of the contested scope. *See Poly-Am.*, No. 2016-1200.

⁵⁹ *See id.* at 1132 (noting court looks for a clear disclaimer because the question on appeal was whether the inventor had disclaimed the contented scope during prosecution).

In the overall hierarchy of claim construction, prosecution history disclaimer has been deemed to trump the argument of claim differentiation,⁶⁰ except when a clear disclaimer of claim scope is found.⁶¹ This means that the Federal Circuit, in considering Google's argument of prosecution history disclaimer, was able to rule in favor of claim differentiation⁶² without any conflict with precedent.

When considering the intent of the applicant, the plain language of the claim is the starting point for interpretation.⁶³ Google contends the Federal Circuit has appeared to contradict itself by limiting prosecution history estoppel to the doctrine of disclaimer.⁶⁴ However, the most recent Federal Circuit case on this issue recognizes the importance of the prosecution history in understanding even the plain meaning of the claim language.⁶⁵ After all, claim interpretation is strongly dependent upon context.⁶⁶ This makes it difficult to see Google's argument as wholly substantive—given the precedent indicating otherwise.

⁶⁰ See *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed. Cir. 1998) (explaining the doctrine of claim differentiation creates a presumption that each claim in a patent has a different scope and the differences in scope between independent and dependent claims is presumed to be significant to the extent that the absence of such difference would make the independent claim superfluous).

⁶¹ See *Biogen Idec, Inc. v. GlaxoSmithKline LLC*, 713 F.3d 1090, 1097 (Fed. Cir. 2013) (“[W]here found, prosecution history disclaimer can overcome the presumption of claim differentiation.”).

⁶² See *Cioffi*, 632 F. App'x at 1019 (“We do not find, moreover, that anything in the prosecution history overcomes the presumption created by these claim differentiation principles.”).

⁶³ *Fenner*, 778 F.3d at 1323 (“The foundation of judicial claim construction is the ‘written description’ in the specification. The patent statute requires that the claims ‘particularly point[] out and distinctly claim[] the subject matter’ that the applicant regards as the invention. 35 U.S.C. § 112(b).”).

⁶⁴ See *Poly-Am.*, No. 2016-1200 at 2.

⁶⁵ See *Biogen Idec, Inc.*, 713 F.3d at 1094 (holding that a claim term's “ordinary meaning must be considered in the context of all the intrinsic evidence, including the claims, specification, and prosecution history”).

⁶⁶ See *Crouch*, *supra* note 26 (asserting the ordinary meaning on which interpretation is based is viewed through the lens of a person of ordinary skill in the pertinent art that is “deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field;” therefore, “claim interpretation is highly context dependent”).

The Federal Circuit's decision in *Cioffi*⁶⁷ and *Poly-America*⁶⁸ do not consider all of the contextual intrinsic evidence on the whole. Instead, the Court establishes a presumed meaning before consulting contextual evidence such as the prosecution history. This results in a narrower use of the prosecution history, and as Google argues, limits it to situations where circumstances indicate searching for a clear disclaimer.⁶⁹ Despite what Google argues, controlling case law shows the general availability of consulting the prosecution history during claim construction is not in danger.⁷⁰

III. SUPREME COURT V. FEDERAL CIRCUIT TREATMENT OF AMENDMENT CLAIM SCOPE DISCLAIMER

Section A explains how the Supreme Court has traditionally construed claim amendments against the patentee. Section B summarizes how the Supreme Court has departed from this traditional approach and analyzes Google's argument that the Federal Circuit's current approach is the opposite of strict construction. Section C summarizes Google's alternative argument that the Federal Circuit's approach may violate the public notice function of patent claims. Section D explains how *Festo*⁷¹ does not control the question of literal interpretation of ambiguous patent claims during claim construction. Finally, section E evaluates the reasoning behind Google's petitions for certiorari.

⁶⁷ See *Cioffi*, 632 F. App'x at 1019 (finding because no clear disclaimer was found in the prosecution history "that anything in the prosecution history overcomes the presumption created by these claim differentiation principles").

⁶⁸ See *Poly-Am.*, No. 2016-1200, 2016 U.S. App. LEXIS 18486 at 2 (Fed. Cir. Oct. 14, 2016) (finding the prosecution history was consulted for the purpose of finding a disclaimer because the question on appeal was whether scope had been disclaimed during prosecution).

⁶⁹ See Petition for Writ of Certiorari, *supra* note 1, at 3.

⁷⁰ See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (Those sources include "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.") (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1116); see also *Gemstar-TV Guide Int'l, Inc. v. ITC*, 383 F.3d 1352, 1364 (Fed. Cir. 2004); *Vitronics*, 90 F.3d at 1582-83; *Markman*, 52 F.3d at 979-80.

⁷¹ *Festo*, 535 U.S. at 734.

A. *The Supreme Court has traditionally construed amendments strictly against the applicant*

The Supreme Court recently denied a petition for certiorari in the case of *Google, Inc. v. Vederi*.⁷² The issues and arguments in this case are very similar to the second question raised in Google's petition for certiorari from *Cioffi*.⁷³ The petition compared Federal Circuit and Supreme Court cases to advance its position that although the Supreme Court's stance was to strictly construe claims amendments against the inventor and in favor of the public, the Federal Circuit repeatedly espoused an opposing view. This accusation must be investigated.

Google insisted that by requiring a "clear and unmistakable" disclaimer of the original claim scope, the Federal Circuit enabled patent applicants to have it both ways—i.e., applicants may obtain a patent with narrowed claims while retaining the right to assert a broad claim scope in litigation.⁷⁴ Google correctly gauged that the Supreme Court has a long history of construing amendments in favor of the public and against the applicant,⁷⁵ stating this as a major question in both the petitions of *Vederi*⁷⁶ and *Cioffi*.⁷⁷ That intent continues into modern law in *Festo*.⁷⁸ The decision to amend a claim, rather than appeal the examiner's rejection, is a "concession that the invention as patented does not reach as far as the original claim."⁷⁹

⁷² *Vederi*, 744 F.3d 1376 (contesting that the Court's decision not to strictly construe an amendment against the patentee violated precedent).

⁷³ See Crouch, *supra* note 23 (noting Google had asked the Supreme Court in *Vederi* to answer the question: "Whether, when an applicant for a patent amends a claim to overcome the U.S. Patent and Trademark Office's earlier disallowance of the claim, should a court (i) presume that the amendment narrowed the claim and strictly construe the amended claim language against the applicant, as this Court has held; or (ii) presume that the claim scope remained the same and require that any narrowing be clear and unmistakable, as the Federal Circuit has held?" This question is "parallel" to the questions raised in *Cioffi*).

⁷⁴ See Petition for Writ of Certiorari, *supra* note 1, at 31.

⁷⁵ See *Exhibit Supply*, 315 U.S. at 137 (holding when an applicant amends their claim to overcome a rejection, the amendment effectively "operates as a disclaimer and must be strictly construed against the applicant and in favor of the public."); *Keystone Driller*, 294 U.S. at 48.

⁷⁶ See Petition for Writ of Certiorari, *supra* note 67, at i.

⁷⁷ See Petition for Writ of Certiorari, *supra* note 1, at i (citing *Magic City Kennel Club*, 282 U.S. at 789–90; *Hubbell*, 179 U.S. at 84).

⁷⁸ See *Festo*, 535 U.S. at 734 (asserting amendments should always be construed in favor of the public and not the patentee and "[t]he decision to amend a claim, rather than appeal the examiner's rejection, is a concession that the invention as patented does not reach as far as the original claim.").

⁷⁹ *Id.*

B. *The Federal Circuit's current approach is not the opposite of strict construction.*

As explained in the previous section, the Supreme Court's traditional position is amendments made to overcome disallowance must be strictly construed against the applicant.⁸⁰ Google's second question in its petition for certiorari in both *Vederi*⁸¹ and *Cioffi*⁸² asks whether the Federal Circuit had applied a disclaimer-only standard to claim amendments. In order to be true, evidence would have to be presented that the Federal Circuit has viewed the amended claim language as non-deserving of a different interpretation than the original claim language unless a "clear and unmistakable disclaimer" of claim scope was found in the prosecution history.⁸³ Additionally, Google contends the Federal Circuit construes the new language against the public by assuming a generously broad scope.⁸⁴ Such a construction leads to the undesirable result of a narrower claim scope for applicants who clearly articulated reasons for their amendments during the prosecution process,⁸⁵ "unduly restricting the proper role of prosecution history in construing the scope of patent claim language."⁸⁶

However, these claims are unsubstantiated.⁸⁷ While legal commentary has stated that the "Federal Circuit has strayed significantly from pre-1952 Supreme Court precedent on disclaimer law,"⁸⁸ as explicitly pointed out by Google in its petition,⁸⁹ they are not giving the complete picture. In the same article,⁹⁰ the author describes Google's position as "quite misguided."⁹¹ In light of this evidence, Google's argument that the Federal Circuit's current approach is the opposite of strict construction fails.

⁸⁰ See *Exhibit Supply Co.*, 315 U.S. at 137; *Keystone Driller Co.*, 294 U.S. at 48; *Smith*, 282 U.S. at 789–790; *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443–44 (1926).

⁸¹ See Petition for Writ of Certiorari, *supra* note 67, at i.

⁸² See Petition for Writ of Certiorari, *supra* note 1, at i.

⁸³ See *Vederi*, 744 F.3d at 1384.

⁸⁴ See *3M Innovative Properties*, 725 F.3d at 1326 (finding when "disavowal does not exist, the ordinary and customary meaning of the claim term will be given its full effect").

⁸⁵ See Petition for Writ of Certiorari, *supra* note 1, at 26.

⁸⁶ See *id.*

⁸⁷ See Dennis Crouch, *Google Looks to Narrow both Copyrights and Patents through Supreme Court Action*, PATENLYO, (Jan. 13, 2015), <http://patentlyo.com/patent/2015/01/copyrights-through-supreme.html> (asserting, despite Google's contention, "the Federal Circuit does not presume that amended claims maintain the identical scope following an amendment to overcome a rejection by the U.S. Patent and Trademark Office").

⁸⁸ See Crouch, *supra* note 24.

⁸⁹ See Petition for Writ of Certiorari, *supra* note 1, at 24.

⁹⁰ See Crouch, *supra* note 83.

⁹¹ *Id.*

Next, one must consider Google's secondary position that panels of the Federal Circuit have reached very different results on the issue of strict construction.⁹² This alternative approach benefits the patentee more than a strict construction, as it views amendments to the claims as the applicants own failure to clarify (or intention not to clarify) and does not immediately understand the amendment to operate as a disclaimer. However, this argument is made nonsensical by a simple overview of the prosecution process.

The examination process begins with the filing of an application.⁹³ After the United States Patent and Trademark Office receives the application, it is subjected to a substantive examination.⁹⁴ During examination, the examiner may reject an application through an office action, which explains the reasoning behind the decision not to allow.⁹⁵ Some of the most common rejections are based in the reasoning that the invention was either anticipated by the prior art⁹⁶ or that it was obvious when considered in context of the knowledge of a person of ordinary skill in the pertinent art.⁹⁷

After reviewing the office action, the applicant may respond to the examiner's rejection by requesting reevaluation of the application or by amending the claims, description, or drawings to overcome the examiner's rejection.⁹⁸ If the applicant is successful in overcoming the rejection set forth in the Office action by narrowing the claim, they will have secured a patent grant, but at the cost of waiving the previous claim scope in the form of a disclaimer.⁹⁹ Accordingly, the Supreme Court's decisions are not contradicted by Federal Circuit rulings¹⁰⁰ and the Federal Circuit's decisions have not created an internal divide sufficient for the Supreme Court to have granted Google's petition for certiorari.

⁹² See Crouch, *supra* note 23 (noting a recent example of this was the case of *Columbia University v. Symantec*, which was decided by Chief Judge Prost along with Judges Dyk and Huges, while the *Cioffi* panel of Judges O'Malley, Plager, and Bryson "reached a different result in a similar situation applying the same principle").

⁹³ 3 R. CARL MOY, *MOY'S WALKER ON PATENTS* § 3:15 (4TH ED. 2016).

⁹⁴ *Id.*

⁹⁵ *Id.*

⁹⁶ A specific claim of an invention may be rejected by the examiner when the invention is anticipated (otherwise known as "not novel") by a disclosure that is considered prior art. In order to be anticipated, the disclosure in question must teach all elements of the claim. See 35 U.S.C. § 102 (2012).

⁹⁷ A patent claim may be rejected if the differences between the claimed subject matter of the invention and the prior art are similar to the degree that the claimed invention would have been obvious before to a person having ordinary skill in the relevant art. See 35 U.S.C. § 103 (2012).

⁹⁸ 3 R. CARL MOY, *MOY'S WALKER ON PATENTS* § 3:18 (4TH ED. 2016).

⁹⁹ See *BENQ Am. Corp.*, 533 F.3d at 1369 (explaining an amendment made to overcome rejection may constitute a "clear disavowal" of claim scope).

¹⁰⁰ See *Poly-Am.*, No. 2016-1200; *Fenner*, 778 F.3d 1320 ("In this articulation of the process, both the specification and the prosecution history play an important role.").

C. The Court of Appeals for the Federal Circuit's approach does not violate the Nautilus standard by obscuring the public notice function of claims.

If Google's argument that the contextual value of amendments made during prosecution is being disregarded by the Federal Circuit, then determining a specific claim term's meaning in context would become very difficult.¹⁰¹ This situation would likely question the validity of some claims under *Nautilus*¹⁰² because of the presumption that using vague terminology during prosecution will benefit the patentee during claim construction.¹⁰³

The Supreme Court has long recognized that a patent must define the scope of the subject matter to which the right extends.¹⁰⁴ Google uses this as a final argument, specifically that the Federal Circuit has undermined the Supreme Court's prudential requirement that claims must be "reasonably certain."¹⁰⁵ If the Federal Circuit's "clear and unmistakable" standard compromises the public-notice function of claims, it opens the door to the supposition that it may also violate the recent Supreme Court precedent in *Nautilus*,¹⁰⁶ which dictates that written claims need to be "provide reasonable certainty"¹⁰⁷ to be held valid. The final meaning and interpretation of statutory language depends on its context, so it follows that the meaning and clarity of a claim term are also context dependent.¹⁰⁸ Especially for language amended or added during examination, the prosecution history often provides relevant context.¹⁰⁹ It is likely that a true conflict in precedent within the Federal Circuit would violate the *Nautilus* standard, but here this is not the case because the Federal Circuit does not currently presume that claims amended during prosecution retain their original scope.¹¹⁰

¹⁰¹ See Petition for Writ of Certiorari, *supra* note 1, at 17–23.

¹⁰² *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014).

¹⁰³ See Petition for Writ of Certiorari, *supra* note 1, at 27–28 ("Allowing patentees to exploit such ambiguities in court undermines the integrity of the [U.S. Patent and Trademark Office's] examination process by making examiners' efforts to confine patent claims to actual innovation much more difficult, if not futile.").

¹⁰⁴ *Markman*, 517 U.S. at 373 (quoting *McClain v. Ortmyer*, 141 U.S. 419, 424, 12 S.Ct. 76, 77, 35 L.Ed. 800 (1891)) (holding "a patent must describe the scope of an invention and its manufacture to 'secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.'").

¹⁰⁵ See Dennis Crouch, *Supreme Court: To Be Valid, Patent Claims Must Provide Reasonable Certainty Regarding the Claim Scope*, PATENTLYO (Jun. 2, 2014),

<http://patentlyo.com/patent/2014/06/reasonable-certainty-regarding.html> (explaining that to achieve the notice function of claims, the *Nautilus* standard requires that claims must provide reasonable certainty regarding the claim scope).

¹⁰⁶ See *Nautilus*, *supra* note 102.

¹⁰⁷ See *Nautilus*, 134 S. Ct. at 2128 (finding, according to 35 U.S.C. § 112, a "patent's specification 'shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same'").

¹⁰⁸ See *Gen. Dynamics Land Sys., Inc. v. Cline*, 540 U.S. 581, 596 (2004).

¹⁰⁹ See Petition for Writ of Certiorari, *supra* note 67, at 23.

¹¹⁰ See Crouch, *supra* note 83.

D. Festo does not control the question of literal interpretation of ambiguous patent claim amendments.

A final topic to note from the petitions of *Cioffi*¹¹¹ and *Vederi*¹¹² is the misapplication of *Festo*, a case that Google cites frequently in the petitions to support its contention that Federal Circuit decisions have conflicted sharply with Supreme Court precedent.¹¹³ The decision in *Festo* does not contribute to the body of governing law used in the interpretation of claim language during construction; rather, it is focused on the availability of the doctrine of equivalents in light of the content of the prosecution history.¹¹⁴ This is an important distinction.

The doctrine of equivalents stands for the principle that a patent can be infringed by something that is outside the claim scope of the patent, but does not substantially differ in function because a certain feature or element has been substituted.¹¹⁵ The Court explained the relationship between the doctrines, by stating:

Prosecution history estoppel ensures that the doctrine of equivalents remains tied to its underlying purpose. Where the original application once embraced the purported equivalent but the patentee narrowed his claims to obtain the patent or to protect its validity, the patentee cannot assert that he lacked the words to describe the subject matter in question.¹¹⁶

This establishes that the amendments narrow the subject matter of the claims because that is precisely what the patentee chose to do. It is this idea Google is using in its argument when it quotes “claim amendments must be examined in context of the prosecution history.” However, as previously established, Federal Circuit law does not conflict with this idea.

¹¹¹ See Petition for Writ of Certiorari, *supra* note 1, at 26 (citing *Festo*, 535 U.S. at 734).

¹¹² See Petition for Writ of Certiorari, *supra* note 67, at 14.

¹¹³ *Id.*

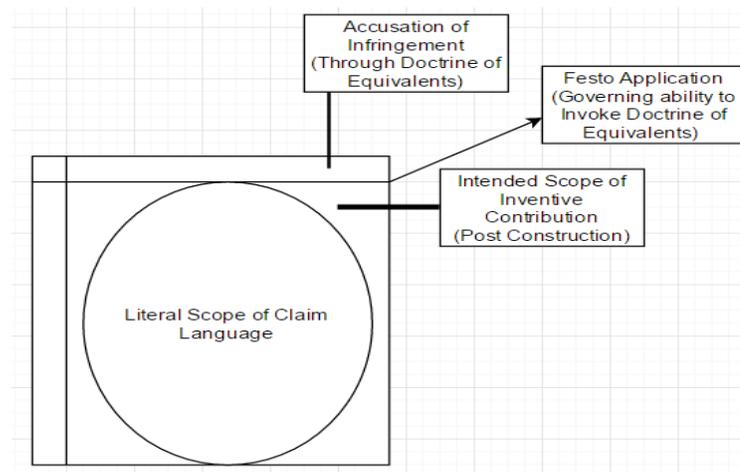
¹¹⁴ See FISCHER, *supra* note 16.

¹¹⁵ See MPEP § 2186 (8th ed. Rev. 11, Nov. 2013).

¹¹⁶ *Festo*, 535 U.S. at 734.

Furthermore, it was not the main focus of the Court, and is not a ground for Google to assert that that the Federal Circuit is in violation of Supreme Court precedent, as intention of the case was to hold that claim amendments do not necessarily bar assertions under the Doctrine of Equivalents due to prosecution history estoppel. Essentially, the holding of this case actually damages Google’s argument of strict construction against the patentee because it allows for the possibility that equivalents may be asserted even after estoppel, which arises when an amendment narrows a patent’s scope. The Court summarized this point as follows: “[b]y amending the application, the inventor is deemed to concede that the patent does not extend as far as the original claim, that the amended claim becomes so perfect in its description that no one could devise an equivalent.”¹¹⁷

The diagram below illustrates the difference between where Google cites to *Festo*¹¹⁸ as controlling (finding the intended scope of inventive contribution) and where *Festo* actually governs (the ability to invoke the doctrine of equivalents to claim indirect infringement in light of a narrowing amendment constituting an estoppel, or other limiting content of the prosecution history).



¹¹⁷ *Id.* at 738.

¹¹⁸ *Id.* at 724.

The United States Court of Appeals for the Federal Circuit has definitively recognized that all intrinsic evidence is relevant to claim construction¹¹⁹ in issues over literal claim interpretation. In order to avoid future confusion over the correct application of *Festo*, its reference should be limited to issues of amendment based prosecution history estoppel¹²⁰ and post construction availability of the doctrine of equivalents, neither of which was at issue in *Cioffi*.¹²¹ *Festo* was not intended to govern the relevance of prosecution history to claim construction as a whole, as other cases focus in on this issue much more closely.¹²² As such, the Supreme Court's decision in *Festo* does not clash with Federal Circuit decisions determining the significance of prosecution history in claim language disputes.

E. An evaluation of the reasoning behind the petitions for certiorari damages Google's position.

The debate over standards used during claim construction is important because businesses, independent inventors, and the general public need to be able to understand the scope of a patent's right to exclude. If the claims, which define the boundaries of that right,¹²³ are ambiguous, the likelihood of accidental infringement of that patent increases tremendously. Google's petition for certiorari went so far as to suggest that in addition to allowing vague or ambiguous claims, the alleged division compromises the character of the United States Patent and Trademark Office's prosecution process.¹²⁴

In *Cioffi*, the dispute over the term "web browser process" started when the U.S. Patent and Trademark Office asserted that the claim containing that term was preempted by the prior art, and accordingly rejected Cioffi's malware patent claim.¹²⁵ This naturally resulted in Cioffi's patent attorney narrowing the claim to describe a more specific process. The trial judge concluded Cioffi's claim could only refer to something else after reviewing this narrowing amendment in the prosecution history, and concluded Google did not infringe.¹²⁶ However, on appeal, the Court sided with Cioffi because it determined it would look at the prosecution history of the patent at issue only if it contained a "clear and unmistakable" statement to support Google's case.¹²⁷

¹¹⁹ See *Biogen Idec*, 713 F.3d at 1094 ("[A] term's ordinary meaning must be considered in the context of all the intrinsic evidence, including the claims, specification, and prosecution history.").

¹²⁰ See *Intrinsic and Extrinsic Evidence for Claim Construction*, THE PATENT ANALYST (Feb. 10, 2014), <https://thepatentanalyst.com/2014/02/10/intrinsic-and-extrinsic-evidence-for-claim-construction/> (explaining *Festo* applies in situations where "[A]MENDMENT-based prosecution history estoppel is found, where a narrowing amendment is 'made for a "substantial reason related to patentability," when the record does not reveal the reason for the amendment.'").

¹²¹ See *Cioffi*, 632 F. App'x at 1014.

¹²² See *Phillips*, 415 F.3d at 1310 (quoting *Multiform Desiccants, Inc. v. Medzam, Ltd.* 133 F.3d 1473, 1478 (Fed. Cir. 1998) ("The best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history.")).

¹²³ See *Markman*, 517 U.S. at 373 (quoting *McClain v. Ortmyer*, 141 U.S. 419, 424, (1891)) ("[A] patent must describe the exact scope of an invention and its manufacture to 'secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.'").

¹²⁴ See Petition for Writ of Certiorari, *supra* note 1, at 27.

¹²⁵ *Id.* at 9.

¹²⁶ *Id.*

¹²⁷ *Id.* at 11.

Accordingly, Google states that the “clear and unmistakable” standard is too high of a bar, and that the Supreme Court should hear the case to remove inconsistencies between Federal Circuit decisions. Google also alleged that the uncertainty created by the divided Federal Circuit favors companies that abuse the patent system; specifically, Google argued “[o]verbroad patent claims are a plague, especially in the vital and growing high-tech sector. . . . All of this plays into the hands of entities that buy patents and then use litigation or the threat of litigation to extract settlements from alleged infringers.”¹²⁸ Whether or not these additional claims about the clear and unmistakable standard are true, the most significant question to note behind the validity of the petition is whether the facts of the case actually support Google’s extensive arguments.

If the Supreme Court were to accept certiorari for this case, it is unclear whether the ruling would actually affect the outcome of the case.¹²⁹ It is certainly a controversial area of law, as evidenced by the amicus brief¹³⁰ filed in the case of *Google, Inc. v. Vederi*.¹³¹ Nine amici, including several major corporations such as Dell and eBay, support Google’s assertion that the Federal Circuit’s “clear and unmistakable” standard clearly departs from the Supreme Court’s precedent and results in overbroad construction.¹³²

Google’s arguments have attracted significant attention over the past several years, but they are simply not appropriate for the Supreme Court to review, because they are misguided and irrelevant to the actual facts of the case.¹³³ It is likely that Google keeps disputing the proper use of prosecution history because it is unhappy with the Federal Circuit’s determination that nothing contained within the prosecution history was particularly valuable in aiding the interpretive dispute.

IV. USING THE PROSECUTION AND AMENDMENT HISTORY AS PRAGMATIC SOURCES WHEN INTERPRETING THE LITERAL LANGUAGE OF A PATENT CLAIM

In light of the recent Supreme Court decision in *Teva Pharmaceuticals*,¹³⁴ the Federal Circuit reviewed the use of intrinsic evidence during claim construction *de novo*.¹³⁵ It also reviews the trial court’s factual findings based on extrinsic evidence sources for clear error.¹³⁶

¹²⁸ *Id.* at 31.

¹²⁹ Crouch, *supra* note 24 (asserting a critical question that may invalidate Google’s argument is “whether Google’s legal argument is actually relevant to the facts-on-the-ground.”); Penton, *supra* note 25 (“Google . . . points to other decisions concerning unrelated legal matters in an attempt to convince the Supreme Court” of a division in the Federal Circuit.).

¹³⁰ Brief Of Acushnet Company, Dell Inc., Kaspersky Lab, Inc., Limelight Networks, Inc., Newegg Inc., Qvc, Inc., Sas Institute Inc., Ebay Inc., And Xilinx, Inc. as Amici Curiae In Support Of Petitioner, *Google, Inc. v. Vederi, LLC.*, 135 S. Ct. 2856 (No. 14-448), 2015 WL 2473390.

¹³¹ *Vederi*, 744 F.3d at 1376.

¹³² See Amicus Brief in Support of Petitioner, *supra* note 130 at 1.

¹³³ See Penton, *supra* note 25.

¹³⁴ See *Teva Pharm. USA, Inc., v. Sandoz, Inc.*, 135 U.S. 831, 841 (2015).

¹³⁵ *Id.* at 841.

¹³⁶ *Id.*

A. The difference between pragmatic and semantic meaning.

The ultimate purpose of language is, of course, to communicate meaning. The goal of using written language is to effectively and precisely convey the message intended to be communicated.¹³⁷ This process, by which an understanding of a particular text is formed,¹³⁸ depends not only upon the actual words, but also encompasses relevant context and extends to information and knowledge shared with the speaker.¹³⁹ By definition then, all meaning, both semantic and pragmatic, involve the use of context to a certain extent.¹⁴⁰ The distinction between the two comes primarily in that the field of semantics concentrates solely on the meaning that the vocabulary and grammar impart, and does not take into account any implied or underlying meaning.¹⁴¹ Pragmatic meaning, in contrast, looks to the same vocabulary and grammar, but derives meaning based on context that gives important subtext, which in turn, allows the derivation of a different understood meaning.¹⁴² Accordingly, using a pragmatic approach often results in a different understood meaning from that of a semantic approach, making it very important to consult both semantic and pragmatic evidentiary sources to arrive at the most accurate interpretation of the language in question, as the prosecution history is a pragmatic source that needs to be allowed to effect the pragmatic meaning of the claim language unrestricted.

B. Evidentiary sources are currently classified only as either extrinsic or intrinsic.

Now that pragmatics and semantics have been defined, the next step is to look at acceptable evidentiary sources used during claims construction and classify them as semantic or pragmatic. Currently, these evidentiary sources are classified and referred to as being extrinsic or intrinsic.¹⁴³ Intrinsic evidence encompasses the literal claim words, the specification, and the prosecution history.¹⁴⁴ Extrinsic sources are sources which are not a part of the written application.¹⁴⁵ The proper role, and view, of these sources by courts undertaking claim construction has shifted notably over the years from strongly disfavored to favored, and recently regressing back to being disfavored,¹⁴⁶ though still allowed.¹⁴⁷ In *Phillips*,¹⁴⁸ the Court stated that going forward, extrinsic evidence must be considered in the context of the intrinsic evidence, as it is “less reliable than the patent and its prosecution history in determining how to read claim terms.”¹⁴⁹

¹³⁷ William Ladusaw, *Meaning (Semantics and Pragmatics)*, LINGUISTIC SOCIETY OF AMERICA, <http://www.linguisticsociety.org/resource/meaning-semantics-and-pragmatics> (last visited Mar. 24, 2017).

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *Id.* (explaining the importance of context, as people “mean more than they say by considering the same thing said in two different contexts”).

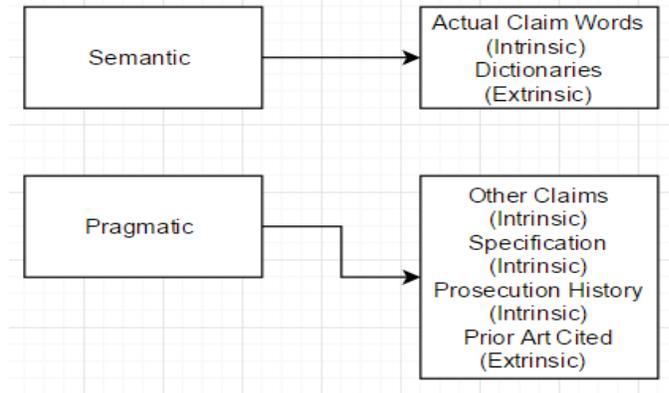
¹⁴¹ See Courtney Crass, *What is Semantics?*, BRIGHTHUB EDUCATION (Jun. 6, 2014), <http://www.brighthubeducation.com/english-homework-help/105856-understanding-pragmatic-vs-semantic-meaning/>.

¹⁴² *Id.*

¹⁴³ See *Phillips*, 415 F.3d at 1317 (“Although we have emphasized the importance of intrinsic evidence in claim construction, we have also authorized district courts to rely on extrinsic evidence, which ‘consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries and learned treatises.’”).

¹⁴⁴ *What is Intrinsic Evidence?*, THE LAW DICTIONARY,

The diagram below classifies these evidentiary sources linguistically. The only semantic source that is considered to be intrinsic evidence are the actual claim words.¹⁵⁰



Taking a purely semantic approach would result in claim language being the only intrinsic evidence allowed. Once pragmatic sources are introduced, the rest of the intrinsic evidence can then be consulted appropriately.

<http://thelawdictionary.org/intrinsic-evidence/> (last viewed Mar. 24, 2017).

¹⁴⁵ *Extrinsic Evidence Law*, U.S. LEGAL.COM, <https://definitions.uslegal.com/e/extrinsic-evidence/> (last viewed Mar. 24, 2017).

¹⁴⁶ See Crouch, *supra* note 26 (From an early time period until 2002, extrinsic evidence was strongly disfavored by the court. From 2002 until the decision in *Phillips*, 415 F.3d 1303, the court appeared to regularly consult dictionaries, which are an extrinsic evidence source. The *Phillips* decision brought the focus primarily to intrinsic evidence once again, but allows for the possibility if necessary to educate the court on the art or what a person of ordinary skill in the art would take a given term to mean.).

¹⁴⁷ After considering intrinsic evidentiary sources, a court may then seek guidance from extrinsic evidence. *Phillips*, 415 F.3d at 1317–18.

¹⁴⁸ *Id.*

¹⁴⁹ *Id.* at 1318–19.

¹⁵⁰ See *Intrinsic and Extrinsic Evidence for Claim Construction*, THE PAT. ANALYST (Feb. 10, 2014), <https://thepatentanalyst.com/2014/02/10/intrinsic-and-extrinsic-evidence-for-claim-construction/>.

C. *Applying pragmatic and semantic principles to the process of claim language construction.*

This section suggests a simple approach that would help unify future Federal Circuit decisions. When these basic linguistic categories are applied to claim construction, it becomes clear that consulting the prosecution history and all intrinsic evidence sources are critical context. This is not in dispute¹⁵¹ as it contains essential sources created by the actual drafter.¹⁵² However, panels of the Federal Circuit are essentially able to choose what intrinsic and, when the situations allows, extrinsic evidentiary sources they deem most important during claim construction. This results in opinions that stay within precedent, but lack in consistency. Comparing the Federal Circuit's recent decision in *Columbia University v. Symantec*¹⁵³ to *Cioffi*¹⁵⁴ exemplifies this assertion.¹⁵⁵

As previously explained, the Federal Circuit panel in *Cioffi*¹⁵⁶ found the principle of claim differentiation more persuasive than Google's prosecution history disclaimer argument, because the Court did not find a clear disclaimer of claim scope.¹⁵⁷ In *Columbia University*,¹⁵⁸ the relevant provisional application included a statement that the contested byte sequence feature did not extend to non-machine code "resource information."¹⁵⁹ That statement was removed before the non-provisional application, but the Federal Circuit determined that the original definition still applied,¹⁶⁰ as provisional applications are considered to be part of the specification.¹⁶¹ This implies that the withdrawal of a statement is insufficient.¹⁶² Rather, after a significant change, the patent applicant must take steps to affirmatively identify the change to the examiner for their consideration or risk unintentionally disclaiming the scope.¹⁶³

¹⁵¹ See *Biogen Idec*, 713 F.3d at 1095 ("[A] term's ordinary meaning must be considered in the context of all the intrinsic evidence, including the claims, specification, and prosecution history.").

¹⁵² The prosecution history contains the application, statements to the inventor specifically concerning the intended claim scope, rejections of claims, responses by the applicant to rejections, and any arguments made to overcome disallowance. See *Phillips*, 415 F.3d at 1317 ("[L]ike the specification, the prosecution history was created by the patentee in attempting to explain and obtain the patent.").

¹⁵³ *Trustees of Columbia University in City of New York v. Symantec Corp.*, 811 F.3d 1359 (Fed. Cir. 2016).

¹⁵⁴ *Cioffi*, 632 F. App'x 1013.

¹⁵⁵ See *Crouch*, *supra* note 24.

¹⁵⁶ *Cioffi*, 632 F. App'x 1013.

¹⁵⁷ See *Biogen Idec*, No. 12-1120 (stating that "where found, prosecution history disclaimer can overcome the presumption of claim differentiation.").

¹⁵⁸ *Trustees of Columbia University in City of New York v. Symantec Corp.*, 811 F.3d 1359 (Fed. Cir. 2016).

¹⁵⁹ See *Dennis Crouch*, *Claim Construction Leads to Nonsensical Result and thus Indefiniteness*, PATENLYO, (Feb. 3, 2016), <https://patentlyo.com/patent/2016/02/construction-nonsensical-indefiniteness.html>.

¹⁵⁹ *Symantec Corp.*, 811 F.3d 1359.

¹⁶⁰ *Id.* at 1366.

¹⁶¹ See *ADVANCED DISPLAY SYS., INC. V. KENT STATE UNIV.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000) (explaining referenced provisional applications are "effectively part of the" specification as though it was "explicitly contained therein."). Additionally, "Apart from the claim language itself, the specification is the single best guide to the meaning of a claim term." *AIA Eng'g Ltd. v. Magotteaux Int'l S/A*, 657 F.3d 1264, 1272 (Fed. Cir. 2011).

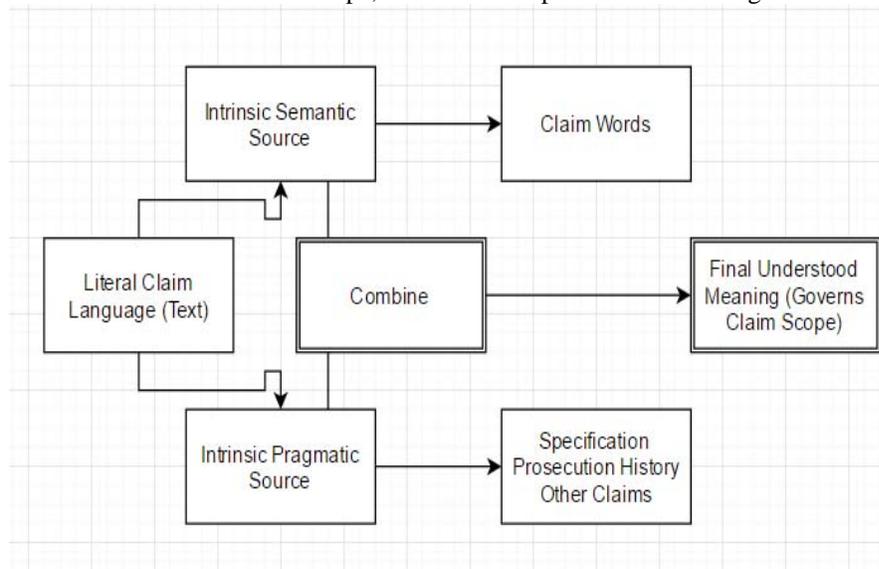
¹⁶² *Crouch*, *supra* note 24.

¹⁶³ *Id.*

This treatment of the specification is exacting and places disclaimers made during prosecution in very high regard, and is consistent with Google’s view of how the prosecution history should be treated.¹⁶⁴ In *Cioffi*,¹⁶⁵ however, the Federal Circuit considered claim differentiation to be more significant than potential disclaimers made in the prosecution history.¹⁶⁶ In essence, panels of the Federal Circuit choose whether prosecution history, the claims, or the specification should be given more weight in claim construction.

This is important because the “construction of patent claim plays a critical role in nearly every patent case.”¹⁶⁷ In the words of Judge Newman in *Fenner*:¹⁶⁸ “Words are symbols, linguistic embodiments of information sought to be communicated, and, as such, can be imperfect at representing their subject.” This sentiment is especially relevant in the field of technology, as many terms used in claim language do not have an established meaning; these are the situations that are likely to necessitate construction.¹⁶⁹

This difference in opinion over the proper importance of different intrinsic evidentiary sources could be reduced by considering the evidence from a linguistic point of view. Through the lens of linguistics, it is clear that both semantic and pragmatic sources should be used to arrive at an accurate construction of an invention’s claim scope, which is depicted in the diagram below.



¹⁶⁴ Crouch, *supra* note 24.

¹⁶⁵ *Cioffi*, 632 F. App’x 1013.

¹⁶⁶ *Id.* at 1019 (“We do not find, moreover, that anything in the prosecution history overcomes the presumption created by these claim differentiation principles.”).

¹⁶⁷ Crouch, *supra* note 26.

¹⁶⁸ *Fenner*, 778 F.3d at 1323.

¹⁶⁹ *Id.* (“When the disputed words describe technology, the terse usage of patent claims often requires ‘construction’ in order to define and establish the legal right.”).

As is apparent in the diagram, linguistics dictates that the only way to arrive at an accurate meaning is to utilize both the semantic and pragmatic sources simultaneously. If courts used this simple thought process when weighing evidentiary sources during claim construction, a greater degree of consistency between opinions could likely be achieved through greater understanding of how these important contextual resources confer meaning. Essentially, using a linguistic view of intrinsic evidentiary sources, including the prosecution and amendment history, could reduce preferential treatment of certain sources and resolve the debate over what intrinsic sources are the most valuable.

V. CONCLUSION

The arguments Google presents in their petition¹⁷⁰ for certiorari in *Cioffi*¹⁷¹ raise important concerns about the restriction of intrinsic evidence in claim construction. However, upon further analysis, it seems that the Supreme Court rightly denied their petition for certiorari just as they did one year earlier in *Vederi, LLC v. Google, Inc.*¹⁷² This is because the arguments in each case seems to be analogous.¹⁷³ Therefore, among other reasons,¹⁷⁴ it is highly questionable whether a court ruling on the case would actually affect the outcome. Furthermore, the Federal Circuit's treatment of prosecution and amendment history is not nearly as restrictive¹⁷⁵ as Google claims,¹⁷⁶ as the availability of all intrinsic evidence to provide crucial context for establishing the meaning of a claim term that is the subject of dispute is not in danger.¹⁷⁷ Next, Google's second argument also fails, as the Federal Circuit presumes claim amendments narrow the claim's scope despite Google's misguided allegation, and judges have the discretion to interpret the effect of an amendment.¹⁷⁸ Because the arguments presented were insufficient to warrant review, the Supreme Court correctly denied Google's petition for certiorari.

¹⁷⁰ Petition for Writ of Certiorari, *supra* note 1, at i.

¹⁷¹ *Cioffi*, 632 F. App'x 1013.

¹⁷² See *Vederi*, 744 F.3d 1376.

¹⁷³ Crouch, *supra* note 24.

¹⁷⁴ Crouch, *supra* note 26.

¹⁷⁵ See *Phillips*, 415 F.3d at 1315 (quoting *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473 (Fed. Cir. 1998) (“[T]he best source for understanding a technical term is the specification from which it arose, informed, as needed, by the prosecution history.”)); *Markman*, 517 U.S. at 373 (“The fundamental sources for claim construction are well-established and include the patent claims, the specification and the prosecution history.”).

¹⁷⁶ See *Vederi*, 744 F.3d 1376.

¹⁷⁷ See *Biogen Idec*, 713 F.3d at 1095 (“[A] term's ordinary meaning must be considered in the context of all the intrinsic evidence, including the claims, specification, and prosecution history.”); *BENQ Am. Corp.*, 533 F.3d at 1369 (citing *Phillips*, 415 F. 3d at 1317 (Fed. Cir. 2005) (finding because the prosecution history was written by the applicant in an attempt to explain their invention to the examiner, the prosecution history often informs how the inventor understood the invention)).

¹⁷⁸ See Crouch, *supra* note 24 (asserting it is unsurprising that different three-judge panels reach a different verdict than other three judge panels given the opinion of the judges, but noting that that deviation in decisions does not cause a split in precedent).

Finally, even though these intrinsic evidence sources are not endangered¹⁷⁹ by a conflict within the Federal Circuit the way Google asserts, courts could benefit from bolstering their understanding of how evidentiary sources acquire meaning through linguistics, as the minor variation in holdings¹⁸⁰ between Federal Circuit panels indicate a selective approach in considering available evidence. Viewing evidentiary sources using a linguistic classification could increase the contextual understanding of a claim's intended meaning by contemplating both semantic and pragmatic meaning, and as a result, improve consistency between Federal Circuit panels during claim construction.

¹⁷⁹ See *Biogen Idec*, 713 F.3d at 1095; *Phillips*, 415 F.3d at 1305.

¹⁸⁰ See *Crouch*, *supra* note 24.

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