

No. 11-1154

In the Supreme Court of the United States

RETRACTABLE TECHNOLOGIES, INC.,
ET AL., PETITIONERS

v.

BECTON, DICKINSON AND COMPANY

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

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

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QUESTIONS PRESENTED

1. Whether a court, in construing a disputed term in a patent claim, may draw inferences from the patentee's use of the same term elsewhere in the patent's specification.
2. Whether, in reviewing a district court's interpretation of a patent claim, the court of appeals should give deference to the district court's resolution of subsidiary factual questions.

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This brief is filed in response to the Court’s order inviting the Solicitor General to express the views of the United States. In the view of the United States, the petition for a writ of certiorari should be denied.

STATEMENT

1. Each written application for a United States patent must include, *inter alia*, a “specification as prescribed by section 112” of the Patent Act. 35 U.S.C. 111(a)(2)(A). The specification must “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 * * * to make and use the

same.” 35 U.S.C. 112(a) (formerly 35 U.S.C. 112, ¶ 1).¹ The “specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor * * * regards as the invention.” 35 U.S.C. 112(b). A copy of the specification, including the claims, “shall be annexed to the patent and be a part of such patent.” 35 U.S.C. 154(a)(4). The patent’s grant to the inventor of exclusive rights in the patented invention shall “refer[] to the specification for the particulars thereof.” 35 U.S.C. 154(a)(1).

2. Petitioners and respondent are competitors in the business of manufacturing and selling retractable syringes. Pet. App. 3a. Retractable syringes are “medical syringes that feature a needle that retracts into the syringe body after the syringe is used,” thereby reducing the risk of injuring a user or medical personnel though an accidental needle stick. *Ibid.* Retractable syringes have existed since the early 1990s. *Ibid.* Petitioners own three United States patents directed towards retractable syringes—United States Patent Nos. 5,632,733 (the ’733 patent), 6,090,077 (the ’077 patent), and 7,351,224 (the ’224 patent). *Id.* at 2a-8a. The patents at issue stem from the same underlying application and share a common specification in pertinent part. See *id.* at 4a, 43a-45a.

The court of appeals identified claim 43 of the ’224 patent as “generally representative of the asserted

¹ In September 2011, after the court of appeals’ decision in this case, Congress enacted the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112-29, 125 Stat. 284, which substantially revised and reorganized the patent laws. Although the AIA did not materially amend any statutory provision at issue in this case, several relevant provisions were reorganized, including Section 112 of Title 35. Citations in this brief are to the current version of the Patent Act.

claims.” Pet. App. 4a-5a. That claim recites a “syringe assembly” featuring a “hollow syringe body” containing a retractable needle, a retraction mechanism, a plunger, and other components. *Id.* at 5a-7a; see ’224 patent, col. 22 *l.* 35–col. 23 *l.* 19. As relevant here, the parties dispute whether the term “body” in the asserted claims is limited to one-piece structures or additionally encompasses retractable syringes that are assembled from multiple pieces. Pet. App. 50a-52a; see *id.* at 8a.

3. Petitioners brought this patent-infringement action against respondent, alleging that two types of respondent’s retractable syringes infringe various claims of the ’733, ’077, and ’224 patents. Pet. App. 8a. Respondent argued, *inter alia*, that its syringes that are composed of more than one piece do not infringe the relevant patents because the term “body,” as used in those patents, means only a one-piece structure. See *id.* at 14a-21a, 50a-51a. Respondent emphasized that the patents’ specifications describe “the invention” as featuring a one-piece body and criticize prior-art syringes for their two-piece structure. See *id.* at 15a-16a. Petitioners argued that the ordinary meaning of the word “body” encompasses both one- and multi-piece structures. See *id.* at 16a. They also emphasized that some of the claims in the asserted patents specifically recite a “one-piece body,” and they contended that the “one-piece” modifier would be superfluous if the term “body” standing alone were limited in that manner. See *ibid.*

After a hearing, the district court issued an order construing the contested terms in the patents. Pet. App. 37a-88a. In construing the term “body,” the court relied in large part on the construction adopted in a previous case by a different district judge, who had construed the term “body” in the same family of patents to include

multi-piece structures. *Id.* at 52a; see *id.* at 51a (citing *Retractable Techs. v. New Med. Techs.*, No. 02-cv-00034, 2004 WL 435054, at *4-*6 (E.D. Tex. Mar. 3, 2004)). The district court therefore construed the term “body” to include any “hollow outer structure that houses the syringe’s components.” *Id.* at 52a. The case was tried before a jury, using the district court’s construction of the patent claims. *Id.* at 10a. The jury concluded that petitioners’ patents were valid and that respondent had “infringed multiple claims of the asserted patents.” *Ibid.*

4. The court of appeals reversed in relevant part. Pet. App. 1a-36a.

a. The court of appeals stated that “proper construction of a patent’s claims is an issue of Federal Circuit law, and we review a district court’s claim construction *de novo.*” Pet. App. 12a (citing *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-1455 (Fed. Cir. 1998) (en banc)). The court explained that, “[t]o ascertain the scope and meaning of the asserted claims, we look to the words of the claims themselves, the specification, the prosecution history, and any relevant extrinsic evidence.” *Ibid.* (citing *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-1317 (Fed. Cir. 2005) (en banc), cert. denied, 546 U.S. 1170 (2006)).

Applying those principles, the court of appeals agreed with respondent that, “in light of the specifications,” the claimed syringe “body” is “limited to a one-piece structure.” Pet. App. 16a. The court recognized that the patents’ use of the phrase “one-piece body” in certain dependent claims “can be read to imply that a ‘body’ is not limited to a one-piece structure.” *Ibid.* The court concluded, however, that this implication “is not a strong one.” *Ibid.* The court explained that claim language cannot properly be construed “in isolation,” but

rather “must always be read in view of the written description.” *Ibid.* (citing *Phillips*, 415 F.3d at 1315).

Applying those principles to this case, the court of appeals concluded that “[t]he specifications indicate that the claimed ‘body’ refers to a one-piece body.” Pet. App. 17a. The court noted that the specifications in each of the patents distinguish prior-art syringes on the ground that they featured a body composed of multiple parts, rather than being “molded as [a] one piece outer body.” *Ibid.* (quoting ’733 patent, col. 2, *ll.* 26-31). The court further observed that each specification’s “Summary of the Invention” states that the claimed invention “features a one piece hollow body”; that every embodiment of the invention discussed in the patents is expressly described as having a one-piece body; and that each of the relevant drawings in the patents shows only a one-piece syringe body. *Ibid.* (quoting ’733 patent, col. 2, *ll.* 45-47).

The court recognized that “[t]here is a fine line between construing the claims in light of the specification and improperly importing a limitation from the specification into the claims.” Pet. App. 17a (citing *Phillips*, 415 F.3d at 1323). The court explained, however, that “while the claims [in this case] leave open the possibility that the recited ‘body’ may encompass a syringe body composed of more than one piece, the specifications tell us otherwise.” *Id.* at 18a.

b. Judge Plager filed a short concurring opinion, joining in the court’s reasoning and conclusion. Pet. App. 30a-31a. He wrote separately to emphasize the “fundamental point” that claims must be construed “in light of the specification of which they are a part because the specification describes what the inventors invented.” *Id.* at 30a (quoting *Arlington Indus., Inc. v.*

Bridgeport Fittings, Inc., 632 F.3d 1246, 1257 (Fed. Cir. 2011) (Lourie, J., concurring in part and dissenting in part)).

c. Chief Judge Rader dissented in pertinent part. Pet. App. 32a-36a. He argued that the “ordinary and customary meaning of ‘body’ does not inherently contain a one-piece structural limitation,” and that the majority had improperly “import[ed] limitations from the specification into the claims.” *Id.* at 32a. In his view, the specifications’ repeated references to the one-piece nature of the syringe body “do not rise to the level of an expression of manifest exclusion or an express disclaimer of claim scope.” *Id.* at 35a. Accordingly, he would have affirmed the district court’s claim construction and upheld the jury’s infringement verdict. See *id.* at 36a.

5. The court of appeals denied rehearing en banc. Pet. App. 89a-91a.

a. Judge Moore, joined by Chief Judge Rader, dissented. Pet. App. 92a-99a. Judge Moore recognized both that “claims are to be construed in the context of the entire patent, including the specification,” and that “[t]he specification may shed light on the plain and ordinary meaning” of a claim term. *Id.* at 94a. In her view, however, the panel had inappropriately relied on the specification to limit the meaning of a claim term that has a broader ordinary meaning. See *id.* at 94a-98a.

Judge Moore also concluded that en banc review was appropriate “to consider whether deference should be given to the district court’s claim construction.” Pet. App. 98a. She would have held that claim construction “is clearly a mixed question of law and fact and deference should be given to the factual parts.” *Id.* at 99a. Judge Moore stated that “[i]t is time to rethink the def-

erence we give to district court claim constructions and the fallacy that the entire process is one of law.” *Ibid.*

b. Judge O’Malley also dissented. Pet. App. 100a-105a. She disagreed with the other dissenting judges’ criticism of the panel’s decision, explaining that the panel had “adhered to the broad principles of claim construction set forth” in prior Federal Circuit decisions and had merely “reached a different conclusion than the trial judge.” *Id.* at 103a. Judge O’Malley would have granted rehearing en banc, however, “to revisit and reverse” the court of appeals’ 1998 en banc decision in *Cybor Corp.*, *supra*, which held that claim construction is a pure question of law subject to de novo review on appeal. See Pet. App. 100a.

DISCUSSION

Neither of the questions set forth in the petition for a writ of certiorari warrants review in this case. Petitioners contend that, in interpreting the term “body” in the patent claims at issue here, the court of appeals improperly disregarded the “plain and ordinary meaning” (Pet. i) of that word. All members of the court below agreed, however, that the court was required to consider *both* the ordinary meaning of the disputed claim term *and* any contextual clues provided by other parts of the specification. The court’s application of those settled interpretive principles to particular patent claims raises no legal issue of broad importance.

Petitioners also contend that a court of appeals should apply a deferential standard in reviewing factual determinations made by a district court in the course of construing a disputed patent claim. The question whether deferential review is appropriate in those circumstances is of substantial and ongoing importance in patent law. That issue is not properly presented in this

case, however, because the district court did not make any factual findings or resolve any evidentiary disputes in interpreting the patent claims at issue here. The petition for a writ of certiorari therefore should be denied.

A. Petitioners Identify No Unsettled Question Of Claim-Construction Methodology Warranting This Court's Review

Petitioners urge the Court to decide whether, in construing a patent, a court may “depart from the plain and ordinary meaning of a term in a patent claim based on language in the patent specification” absent any “express[]” indication that the patentee intended the term to carry a different meaning. Pet. i. That question does not warrant this Court’s review. There is broad agreement among the judges on the Federal Circuit about the principles of law that govern that inquiry, and the Federal Circuit’s claim-construction jurisprudence is fully consistent with this Court’s precedents. Although different judges sometimes disagree about the proper interpretation of particular claim terms, that is simply the inevitable result of case-by-case adjudication, not a reason for this Court’s intervention.

1. A patent is an integrated legal instrument that grants the patentee, for a limited term, the right to exclude others in the United States from practicing the claimed invention, “referring to the specification for the particulars thereof.” 35 U.S.C. 154(a)(1). A patent’s specification must “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 * * * to make and use the same.” 35 U.S.C. 112(a). The “specification shall conclude with one or more claims particularly pointing out and distinctly claiming

the subject matter which the inventor * * * regards as the invention.” 35 U.S.C. 112(b). Those requirements are designed both to “secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.” *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996) (quoting *McClain v. Ortmyer*, 141 U.S. 419, 424 (1891)) (alterations in original).

Because a patent (like a contract or a will) is a written legal instrument, this Court has held that “the construction of a patent, including terms of art within its claim[s], is exclusively within the province of the court.” *Markman*, 517 U.S. at 372; see *id.* at 388-390 (“The construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis.”). The Court has announced various legal principles to guide judges in that task. In particular, the Court has repeatedly addressed the role of the specification in determining the scope of the invention described in a claim.

One clear principle is that “the claim,” not the specification as a whole, “measures the grant to the patentee.” *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 277 (1949); see, e.g., *Markman*, 517 U.S. at 372 (same); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961) (same); *Smith v. Snow*, 294 U.S. 1, 11 (1935) (same). Congress added to the Patent Act the requirement that a patent include particularized claims precisely to “reliev[e] the courts from the duty of ascertaining the exact invention of the patentee by inference and conjecture.” *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 (1877); see *Markman*, 517 U.S. at 378-379 (discussing the history of claim practice in the United States); *White v. Dunbar*,

119 U.S. 47, 52 (1886) (Congress required patent claims “for the very purpose of making the patentee define precisely what his invention is”).

The Court has also repeatedly emphasized, however, that a disputed patent claim must be interpreted in light of the patent’s written specification rather than in isolation. See, e.g., *United States v. Adams*, 383 U.S. 39, 49 (1966) (“[I]t is fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention.”); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940) (same); *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1854) (same). That approach makes sense because, under the Patent Act, the claims are themselves a part of the specification. See 35 U.S.C. 112(b) (“The specification shall conclude with one or more claims.”). In defining the metes and bounds of the invention, the summing-up language of the claims therefore necessarily draws upon—and is intended to be understood in light of—the written description setting forth the invention in “full, clear, concise, and exact terms” that makes up the remainder of the specification. See 35 U.S.C. 112(a).

The balance between reading a patent’s claims as expressing the extent of its scope and interpreting those claims in light of the specification is a delicate one. Although the specification is an important tool in construing the meaning of a claim, it may not be used to alter that meaning. This Court has therefore cautioned that courts should avoid importing additional limitations from a specification into claims. Although it is “proper in all cases” to refer to the specification for “the true intent and meaning of the language employed in the claims,” *Bates v. Coe*, 98 U.S. 31, 38 (1878), there is “no

principle of law which would authorize [a court] to read into a claim an element which is not present,” *McCarty v. Lehigh Valley R.R.*, 160 U.S. 110, 116 (1895); see *White*, 119 U.S. at 51-52. At bottom, then, the task of claim construction is to ascertain the meaning of the actual claim language approved by the U.S. Patent and Trademark Office, as “explained by and read in connection with the specification.” *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 432 (1902).

2. The Federal Circuit has faithfully implemented those principles in considering questions of claim construction. The leading case on the question at issue here is the en banc court’s 2005 decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, in which the court considered “the extent to which we should resort to and rely on a patent’s specification in seeking to ascertain the proper scope of its claims.” *Id.* at 1312. Recognizing that “[t]his is hardly a new question,” the court in *Phillips* summarized the claim-construction principles announced by this Court and developed by the courts of appeals over “nearly two centuries.” *Ibid.*; see *id.* at 1312-1324.

As relevant here, the *Phillips* court reaffirmed the “bedrock principle” that “the claims of a patent define the invention to which the patentee is entitled the right to exclude.” 415 F.3d at 1312 (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). The court stressed that the words of a patent claim define the invention, and that “it is ‘unjust to the public, as well as an evasion of the law, to construe [the claim] in a manner different from the plain import of its terms.’” *Ibid.* (quoting *White*, 119 U.S. at 52). The court also recognized, however, that the claims of a patent “do not stand alone,” but rather “are

part of a fully integrated written instrument consisting principally of a specification that concludes with the claims.” *Id.* at 1315 (internal quotation marks and citation omitted). Noting that a patent specification “is always highly relevant to the claim construction analysis,” the court emphasized that “claims must be read in view of the specification, of which they are a part.” *Ibid.* (internal quotation marks and citation omitted). That approach, the court observed, “has a long pedigree in Supreme Court decisions.” *Ibid.* (citing cases).

The Federal Circuit in *Phillips*—like this Court before it—highlighted “the danger of reading limitations from the specification into the claim.” 415 F.3d at 1323. The court acknowledged that “the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice.” *Ibid.* The court nevertheless concluded that “attempting to resolve that problem in the context of the particular patent [in question] is likely to capture the scope of the actual invention more accurately” than any rigid interpretative rule would permit. *Id.* at 1323-1324; see *id.* at 1324 (“[T]here is no magic formula or catechism for conducting claim construction.”).

Petitioners argue (Pet. 12) that the court in *Phillips* was “unsuccessful” in resolving a preexisting “split” among members of the Federal Circuit (one that petitioners contend continues today) about the proper approach to claim construction. But the *Phillips* court’s recitation of claim-construction principles not only hewed closely to this Court’s decisions, it was also essentially unanimous. The only judge who dissented from that discussion did so principally on the ground that, in his view, no formulation of claim-construction principles

could bring consistency to patent law unless the court of appeals also afforded deference to district courts' factual findings in the claim-construction process. See 415 F.3d at 1330-1335 (Mayer, J., dissenting).² No member of the court of appeals expressed disagreement with the conclusion that it is “entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims.” *Id.* at 1317. That conclusion follows directly from this Court’s decisions. See, e.g., *Markman*, 517 U.S. at 389 (claim construction requires a “necessarily sophisticated analysis of the whole document”); *Bates*, 98 U.S. at 38 (explaining that it is “proper in all cases” for a court to refer to the specification for “the true intent and meaning of the language employed in the claims”).

Nevertheless, petitioners contend (Pet. 10-13) that, even after *Phillips*, two interpretive camps remain among Federal Circuit judges—one that believes that “an inventor is entitled to the plain and ordinary meaning of a claim term unless: (i) the inventor ‘acts as his own lexicographer’ by redefining the claim term in the specification, or (ii) the specification expressly disavows a broad meaning,” and one (reflected in the decision here) that believes that “judges may limit clear language in a patent claim even though there is no explicit redefinition or disclaimer in the specification.” Pet. 10-11

² Although Judge Newman joined Judge Mayer’s dissenting opinion in *Phillips*, she also joined the partial dissent of Judge Lourie, who “fully join[ed] the portion of the court’s opinion resolving the relative weights of specification and dictionaries in interpreting patent claims.” 415 F.3d at 1328 (Lourie, J., dissenting). Judge Lourie’s partial dissent concerned the interpretation of the particular patent at issue in *Phillips*. See *id.* at 1328-1330.

(quoting *Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)). Petitioners emphasize (Pet. 13-15) that Federal Circuit judges regularly disagree about the proper interpretation of disputed patent claim terms. But petitioners are mistaken in attributing the disagreements they observe among Federal Circuit judges about the meaning of claim terms to a disagreement about the role of the specification in the interpretation of such terms.

All of those judges agree that a court should determine the ordinary meaning of a claim term in light of the specification (as the court held in *Phillips*). Indeed, even in *Thorner*—the case petitioners cite (Pet. 10) as the primary example of a post-*Phillips* decision adhering to a stricter view of the role of a specification in construing claim terms—the panel acknowledged that “[t]he words of a claim are generally given their ordinary and customary meaning as understood by a person of ordinary skill in the art when read in the context of the specification and prosecution history.” 669 F.3d at 1365 (citing *Phillips*, 415 F.3d at 1313). As with the construction of statutes, however, the construction of particular patent claims can spawn disagreement even among judges who are applying the same interpretive principles. See, e.g., *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 904 (Fed. Cir.) (“Although parties frequently cite one or the other of these [claim-construction] axioms to us as if the axiom were sufficient, standing alone, to resolve the claim construction issues we are called upon to decide, the axioms themselves seldom provide an answer, but instead merely frame the question to be resolved.”), cert. denied, 543 U.S. 925 (2004). The fact that established rules of claim

construction often fail to produce unanimous outcomes does not signal a defect in the rules themselves.

3. Although the question was close, the court of appeals correctly concluded that petitioners' claims are limited to retractable syringes having one-piece bodies. See Pet. App. 15a-18a. Considered in isolation, the word "body" (unlike, for example, "assembly" or "composition") does not necessarily imply anything about whether the object in question consists of one piece or many. The court of appeals therefore appropriately drew inferences from other provisions within the patents to determine whether the disputed claims encompassed syringes with multi-piece bodies.

The court of appeals acknowledged petitioners' argument that "body" should be interpreted to encompass both one-piece structures and multi-piece structures because some of the patents' "claims recite a 'body' and other claims recite a 'one piece body.'" Pet. App. 16a. Under the interpretive doctrine of claim differentiation, courts generally construe different claims in the same patent to have different scope. See, e.g., *Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1233 (Fed. Cir. 2001). The court therefore recognized that the patents' use of the phrase "one-piece body" in certain dependent claims implies that the claim term "body," standing alone, "is not limited to a one-piece structure." Pet. App. 16a.

The court of appeals also recognized, however, that claim differentiation is "not a hard and fast rule of construction." *Wenger Mfg., Inc.*, 239 F.3d at 1233 (internal quotation marks and citations omitted). That is in part because claim drafters should not be permitted to broaden claims beyond their correct scope under 35 U.S.C. 112 merely by using different (but essentially

synonymous) terms in different claims. See Dan L. Burk & Mark A. Lemley, *Fence Posts or Sign Posts? Rethinking Patent Claim Construction*, 157 U. Pa. L. Rev. 1743, 1753-1754 (2009). Moreover, the doctrine of claim differentiation itself reflects a recognition that the meaning of a disputed term in a patent claim may be clarified by language in other provisions of the patent. In drawing inferences about the disputed claims from language in other parts of the specification, the court of appeals engaged in a mode of analysis no different in kind from the one that petitioners advocated.

It was therefore appropriate for the court of appeals to consult the patents' specifications—in addition to consulting the patents' other claims, as urged by petitioners—to understand “the true intent and meaning of the language employed in the claims.” *Bates*, 98 U.S. at 38. As the court explained, the specifications “expressly recite that ‘the invention’ has a body constructed as a single structure, expressly distinguish the invention from the prior art based on this feature, and only disclose embodiments that are expressly limited to having a body that is a single piece.” Pet. App. 18a. The inventors' own disclosure of what they invented thus strongly suggested that petitioners' syringe “body” was a single-piece body. As the court acknowledged, “[t]here is a fine line between construing the claims in light of the specification and improperly importing a limitation from the specification into the claims.” *Id.* at 17a (citing *Phillips*, 415 F.3d at 1323). In this case, however, the specifications clarified the nature of the syringe “body” that petitioners had claimed as their invention.

Petitioners insist that the court of appeals “departed from the plain and ordinary meaning” of the word “body,” as used in the claims, “based on language in the

patent specification.” Pet. 2. But while petitioners emphasize “the primacy of the claim language,” Pet. 18, they do not dispute that a court engaged in claim construction may consult a patent’s specification to determine the meaning of a disputed claim term. Nor did any judge on the Federal Circuit contest that proposition. See Pet. App. 33a (Rader, C.J., dissenting in part) (“[T]he claims do not stand alone and must be read in light of the specifications.”); *id.* at 94a (Moore, J., dissenting from the denial of rehearing en banc) (“[C]laims are to be construed in the context of the entire patent, including the specification.”); *id.* at 103a (O’Malley, J., dissenting from the denial of rehearing en banc) (concluding that the panel’s decision “adhered to the broad principles of claim construction set forth” under *Phillips* and merely “reached a different conclusion than the trial judge”).

At bottom, petitioners’ argument is simply that the court of appeals misapplied settled interpretive principles to the patent claims at issue here. That case-specific dispute does not warrant this Court’s review.

B. This Case Is Not An Appropriate Vehicle For Determining What Standard Of Appellate Review Should Apply To A District Court’s Subsidiary Factual Findings In Claim Construction

Petitioners also urge the Court to decide the question whether “claim construction, including underlying factual issues that are integral to claim construction, is a purely legal question subject to de novo review on appeal.” Pet. i. In an appropriate case, this Court’s intervention might be warranted to determine the proper standard of appellate review of district court factual determinations that bear on the interpretation of disputed patent claims. In construing the patent claims at issue

here, however, the district court did not make any findings of fact or rely on anything other than the legal arguments of counsel. See Pet. App. 50a-52a. This case is therefore an unsuitable vehicle for determining the appropriate standard of review for cases in which a district court's claim construction turns on subsidiary factual findings.

1. In *Markman v. Westview Instruments, supra*, this Court considered whether the interpretation of patent claims “is a matter of law reserved entirely for the court, or subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed term of art about which expert testimony is offered.” 517 U.S. at 372. The Court recognized that the interpretation of patent claims sometimes has “evidentiary underpinnings,” and it described claim construction as a “mongrel practice” that may involve “construing a term of art following receipt of evidence.” *Id.* at 378, 390. But because the Court could find no “established practice” of submitting such questions to a jury at the time the Seventh Amendment was adopted, it held that claim-construction questions are not constitutionally committed to the jury. *Id.* at 379-381. Turning to a consideration of “the relative interpretive skills of judges and juries and the statutory policies that ought to be furthered by the allocation” of interpretive tasks, the Court ultimately concluded that “judges, not juries, are the better suited to find the acquired meaning of patent terms.” *Id.* at 384, 388. Accordingly, the Court held that “the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” *Id.* at 372.

The en banc Federal Circuit subsequently held that a district court's construction of disputed patent claims,

“including any allegedly fact-based questions relating to claim construction,” is subject to de novo review by the court of appeals. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1456 (1998). The court interpreted the decision in *Markman* as holding “that the totality of claim construction is a legal question to be decided by the judge,” and it found “[n]othing” in that decision to “support[] the view * * * that claim construction may involve subsidiary or underlying questions of fact.” *Id.* at 1455. The Federal Circuit acknowledged this Court’s description of claim construction as a “mongrel practice” with “evidentiary underpinnings,” *Markman*, 571 U.S. at 378, 390, but dismissed those observations as “only prefatory comments.” *Cybor*, 138 F.3d at 1455. The Federal Circuit thus reviews de novo not only a district court’s ultimate claim construction, but also any subsidiary determinations of fact, including the court’s resolution of conflicting documentary evidence or expert testimony.

2. *Markman* amply supports the Federal Circuit’s holding in *Cybor* that the ultimate question of the scope of a patent claim is a question of law. In many patent cases (including this one), a district court can determine the proper scope of disputed claims without venturing beyond the four corners of the patent instrument itself. In such cases, there is no reason to depart from the usual understanding that a district court’s legal rulings are reviewed de novo on appeal. Cf. *Salve Regina Coll. v. Russell*, 499 U.S. 225, 233 (1991) (standards of appellate review “reflect an accommodation of the respective institutional advantages of trial and appellate courts”). De novo Federal Circuit review in that circumstance also furthers Congress’s effort to promote consistent application of patent laws by centralizing appellate juris-

diction in a specialized tribunal. See 28 U.S.C. 1295(a)(1) and (4).

As this Court recognized in *Markman*, however, some claim-construction questions require a district court to resolve disputes with “evidentiary underpinnings.” 517 U.S. at 389-390. Because the meaning of a patent is judged from the perspective of “a person of ordinary skill in the art in question at the time of the invention,” *Phillips*, 415 F.3d at 1313; see *Carnegie Steel Co.*, 185 U.S. at 437, a district court will sometimes be called upon to “decide a question of meaning peculiar to a trade or profession,” *Markman*, 517 U.S. at 389. In those cases, the court’s ultimate claim construction may depend on its resolution of contested questions of historical fact, such as the content of the prior art on a particular date, the accepted meaning of specialized terms in a particular industry, or the level of “ordinary skill” in the relevant field at the time of the invention. See *Graham v. John Deere Co.*, 383 U.S. 1, 17, 33 (1966) (describing these inquiries as “basic factual inquiries” in the context of obviousness). The Court in *Markman* acknowledged that such determinations may require a court to, *e.g.*, choose among testifying experts. 517 U.S. at 389. The Court nevertheless held that such determinations are the province of the court rather than the jury—not because they are not factual determinations, but because they must be resolved “in a way that comports with the [patent] instrument as a whole,” which courts are better suited to do than juries. *Id.* at 389-390.

It is clear, then, that *some* claim-construction decisions will depend on a district court’s resolution of subsidiary factual questions. The Federal Circuit’s decision in *Cybor* does not identify any reason that such factual findings should not be given the deference ordinarily

required by Federal Rule of Civil Procedure 52(a), and appellate courts routinely defer to factual findings made by district courts and juries. See Fed. R. Civ. P. 52(a)(6) (“Findings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous, and the reviewing court must give due regard to the trial court’s opportunity to judge the witnesses’ credibility.”). Rule 52(a) “does not make exceptions or purport to exclude certain categories of factual findings from the obligation of a court of appeals to accept a district court’s findings unless clearly erroneous.” *Pullman-Standard v. Swint*, 456 U.S. 273, 287 (1982). The *Cybor* court relied on *Markman*’s holding that subsidiary evidentiary questions relating to claim construction should be resolved by the district court rather than by the jury. See 138 F.3d at 1455-1456. It does not necessarily follow, however, that such questions should be viewed for other purposes as legal rather than factual issues. The Court in *Markman* had no occasion to address the proper allocation of authority between trial and appellate courts, and its analysis does not logically compel de novo appellate review of all district court findings that bear on patent claim construction.

3. In an appropriate case, this Court’s intervention might be warranted to determine the appropriate standard of review when a district court makes subsidiary factual findings in the course of construing a disputed patent claim. The district court in this case, however, did not make any factual findings about the meaning of the term “body,” the state of the relevant art, or any other matter. See Pet. App. 50a-52a. Nor did the court consider any expert testimony, make any credibility determinations, or receive any documentary evidence. Rather, the district court’s hearing consisted entirely of

the oral argument of counsel regarding the claim language, the specification, and pertinent legal authorities. See generally 12/04/08 *Markman* Hrg. Tr. Because the district court's claim-construction ruling did not depend on the resolution of *any* questions of fact, this case does not present the question whether a claim-construction ruling that *is* predicated on factual determinations should nevertheless be subject entirely to de novo appellate review.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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