
In the Supreme Court of the United States

GOOGLE, INC., PETITIONER

v.

VEDERI, LLC

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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QUESTION PRESENTED

When an applicant for a patent amends a claim to overcome the United States Patent and Trademark Office's rejection of the claim on the basis of prior art, the amendment "operates as a disclaimer," and the amended claim language will not be construed to have the same scope as the original, rejected claim. *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942). The question presented is as follows:

Whether the court of appeals correctly applied those principles in concluding that the claim amendment in this case did not disclaim the subject matter that was the subject of the parties' interpretive dispute.

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BRIEF FOR THE UNITED STATES AS AMICUS CURIAE

INTEREST OF THE UNITED STATES

This brief is submitted in response to the order of this Court 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. A patent application must contain a specification with a written description of the invention. 35 U.S.C. 111(a)(2)(A), 112. The specification must describe the invention 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 invention. 35 U.S.C. 112(a). The specification must 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); see *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2125 (2014).

When an inventor applies for a patent, the United States Patent and Trademark Office (PTO) undertakes an examination process to determine whether a patent should issue. 35 U.S.C. 131. An examiner with expertise in the relevant technological fields analyzes the application and the invention it describes, as well as the prior art in the field, in order to determine whether the statutory requirements for patentability are satisfied. See *ibid.*; 37 C.F.R. 1.104(a)(1). If the examiner determines that a proposed claim is not patentable—for example, because it is anticipated by, or obvious in light of, the prior art, see 35 U.S.C. 102, 103—the examiner rejects the claim and notifies the applicant of “the reasons for such rejection.” 35 U.S.C. 132(a).

In order to overcome the examiner’s objections, the applicant may amend the proposed claims to narrow their scope, thereby disclaiming particular subject matter and distinguishing the claims from prior art. 35 U.S.C. 132(a); 37 C.F.R. 1.111(b) and (c). An applicant may also submit arguments that explain why and how the claimed invention differs from the prior art. See 35 U.S.C. 132(a); 37 C.F.R. 1.111(b). This iterative process generally occurs twice, culminating in the issuance of either a notice of allowance or a final rejection. 37 C.F.R. 1.113(a), 1.311(a). An applicant may appeal a final rejection to the Patent Trial and Appeal Board (Board), 35 U.S.C. 134(a), and then seek judicial review of the Board’s decision. 35 U.S.C. 141, 145.

2. a. Respondent brought this suit against petitioner, alleging that petitioner's "Street View" product infringes respondent's patents. Pet. App. 2.

The four patents at issue, which stem from the same original application and share a common specification, Pet. App. 2, disclose "a computer-implemented system and method for synthesizing images of a geographic location to generate composite images of the location," C.A. App. A346. In the patented system, an image-recording device, such as a set of cameras mounted on a vehicle, moves along a street and records images of the objects along the street. *Ibid.*; see Pet. App. 2. The computer then combines the images to create composite images stored in a database, allowing a user to visually navigate a geographic location from a user terminal. Pet. App. 2-4; C.A. App. A346. For example, a user could enter an address into a terminal and see a map and a composite image of that location on his screen. Pet. App. 4 (sample screen view). The claims recite that the images "depict[] views of objects in the geographic area, the views being *substantially elevations* of the objects in the geographic area." *Id.* at 5 (emphasis omitted).

The term "substantially elevations" was added to the claims during the prosecution of the patent application. Pet. App. 15. As originally drafted, the claims recited "images providing a *non-aerial view* of the objects." C.A. App. A404 (emphasis added; citation omitted). The examiner rejected the claims as anticipated by a prior-art patent known as Levine. Pet. App. 15. Levine disclosed a system for transmitting maps, including images of map data, such as the locations of gas stations. *Ibid.*; C.A. App. A3269-A3279. The images disclosed by Levine were map images, not

photographs. Pet. App. 15; C.A. App. A3274 (describing transmission of map images enabling navigation in a car). In response to the rejection, respondent replaced “non-aerial view[s]” with “substantially elevations.” Pet. App. 15.

b. Like the invention described in respondent’s patents, petitioner’s Street View product combines multiple images taken by cameras mounted on a moving vehicle to produce a composite view of a street. Pet. App. 6. In Street View, the photographs are “stitched together” into a “spherical composite image” that is a “two-dimensional representation of a spherical shape.” *Ibid.* The effect of the spherical nature of the images is that the user perceives the objects depicted as though he were standing in the middle of a sphere. *Id.* at 7 (diagrams).

Petitioner contended that Street View does not infringe respondent’s patents because Street View utilizes “curved or spherical” images, while the images claimed in respondent’s patents are flat. Pet. App. 7. The parties’ dispute thus turned on the proper interpretation of the phrase “views of objects * * * being *substantially elevations*” in respondent’s claims. *Id.* at 8 (emphasis added). Petitioner asserted that “substantially elevations” refers to architectural views, which are flat depictions of a view of a building, and that the term excluded curved or spherical images, such as those used in Street View. *Ibid.* Respondent argued that “substantially elevations” means front and side views, and that the term encompasses both flat and curved images. *Ibid.*

c. The district court granted summary judgment for petitioner. Pet. App. 32-38. The court accepted petitioner’s argument that the term “elevations” re-

fers to architectural elevation drawings, which are flat images. The court construed the phrase “substantially elevations” to encompass only “vertical flat (as opposed to curved or spherical) depictions.” *Id.* at 33; see *id.* at 31. The court therefore held that petitioner’s Street View did not infringe, because it presents only curved or spherical images to the user. *Id.* at 34.

3. The court of appeals vacated and remanded. Pet. App. 1-16. The court concluded that “substantially elevations” refers to “front and side views of the objects” and may include curved or spherical images. *Id.* at 16.

Focusing first on the language of the claims and specification, the court of appeals explained that the district court, in concluding that “substantially elevations” is limited to flat images, had “give[n] no effect to the ‘substantially’ modifier contained in the claims.” Pet. App. 11. That qualifier, the court of appeals observed, “takes on important meaning in light of” the specification, which describes embodiments of the patented system (such as the use of a camera with a fish-eye lens) that would necessarily produce curved images. *Id.* at 11; see *id.* at 12-14.

Turning to the prosecution history, the court of appeals rejected petitioner’s argument that respondent, by amending its claims to disclose views that are “substantially elevations” rather than “non-aerial view[s],” had surrendered any claim to curved images. Pet. App. 15. The court explained that the application had been amended in response to Levine, which “was directed to ‘map images.’” *Ibid.* (citing C.A. App. A503-A504). The court accordingly concluded that the amendment did not amount to a “clear and unambiguous disavowal of spherical or curved images.” *Ibid.*

The court of appeals held that the term “substantially elevations” refers to “front and side views of the objects.” Pet. App. 16. It therefore concluded that “the claims do not exclude curved or spherical images depicting views that are substantially front or side views of the objects.” *Ibid.* The court vacated the district court’s judgment of non-infringement and remanded to permit the district court to address infringement “under a proper construction of the claims.” *Ibid.*

DISCUSSION

Petitioner contends (Pet. 13-26) that the court of appeals’ decision in this case, and the Federal Circuit’s general approach to construing amended patent claims, conflict with this Court’s decisions. In particular, petitioner argues that this Court’s precedents require that amended claim language be construed as narrowly as possible against the patentee. Petitioner is incorrect.

This Court has not adopted any categorical rule that all ambiguities in amended claim language must be resolved by giving the amended claim its narrowest plausible construction. Nor would such a rule be a sensible approach to the interpretation of amended claims. Rather, the Court has held only that an amended claim must be interpreted narrowly enough to exclude any subject matter that the amendment was intended to disclaim, see, *e.g.*, *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 137 (1942), and the Federal Circuit has followed that guidance.

In the decision below, the court of appeals gave the claim amendment a significant narrowing effect. The court correctly concluded, however, that the amendment did not disclaim the curved or spherical images

on which the parties' interpretive dispute centered. Further review is not warranted.

A. This Court's Decisions Hold That, Although An Amended Patent Claim May Not Be Construed To Recapture Disclaimed Subject Matter, The Proper Scope Of The Final Claim Language Is Subject To Ordinary Rules Of Claim Construction

1. a. When a patent examiner rejects a claim as anticipated or obvious in light of prior art, the patent applicant may amend the claim in order to distinguish it from that prior art. This Court has long held that, when a patent applicant "is compelled by the rejection of his application by the Patent Office to narrow his claim," the claim may not later be construed to capture the subject matter surrendered by the amendment. *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443 (1926) (explaining that the patentee "cannot after the issue of the patent broaden his claim by dropping the element which he was compelled to include in order to secure his patent"). The amendment thus acts as a disclaimer of the original scope of the invention, and "an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed." *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 218 (1940).

An example illustrates the principle. Suppose a patent applicant sought a patent on a baseball bat with an internal "reinforcing rod" designed to prevent the bat from breaking upon contact with the ball. Suppose further that the examiner rejected the claim on the ground that it was anticipated by a prior art baseball bat that contained a steel rod, and that the applicant then amended his claim to cover a baseball bat

with a “flexible reinforcing rod.” A court construing the amended claim language would err if it interpreted the term “flexible reinforcing rod” to encompass steel rods, because the evident purpose of the amendment was to surrender any claim to that invention.

b. Claim amendments are also relevant to the doctrine of equivalents. Under that doctrine, “a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is ‘equivalence’ between the elements of the accused product or process and the claimed elements of the patented invention.” *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21 (1997) (citation omitted). If the patentee has narrowed his claims during prosecution, however, “this prosecution history estops him from later arguing that the subject matter covered by the original, broader claim was nothing more than an equivalent.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 727 (2002). In other words, just as a patentee may not recapture disclaimed subject matter through a broad construction of his actual claims, he may not recapture the same subject matter through the doctrine of equivalents.

2. In *Hubbell v. United States*, 179 U.S. 77 (1900), the Court explained that, “[w]hile not allowed to revive a rejected claim, by a broad construction of the claim allowed,” the “patentee is entitled to a fair construction of the terms of his claim as actually granted.” *Id.* at 80. Thus, regardless of whether a patent claim has been amended during prosecution, a court in construing the claim must begin with the claim language, as it is the final language of the claims ap-

proved by the PTO that “measures the grant to the patentee.” *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 336 U.S. 271, 277 (1949); accord *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015). In addition, “it is fundamental that claims are to be construed in the light of the specifications” and the prosecution history. *United States v. Adams*, 383 U.S. 39, 49 (1966); see *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2128-2130 (2014).

In considering the prosecution history, the court must determine whether any claim amendment was intended to address an interpretive issue that is relevant to the parties’ dispute. If that is so, the court must not construe the claim to encompass the subject matter that the amendment was intended to disclaim. See *Hubbell*, 179 U.S. at 80. To return to the baseball-bat hypothetical, if the patentee alleges that his claim to a baseball bat with a “flexible reinforcing rod” is infringed by a baseball bat with a carbon-fiber reinforcing rod, the parties’ interpretive dispute would center on whether the final claim language encompasses carbon-fiber rods. In considering the effect of the claim amendment, the court might conclude that, because the patentee amended its claims to disclaim *steel* reinforcing rods, the amendment does not disclaim carbon-fiber rods and therefore does not resolve the parties’ interpretive dispute.

In that event, the court would determine, in light of the claim language, specification, and any other evidence in the prosecution history, whether the claims should be construed to encompass carbon-fiber rods. If the court held that the final claim term “flexible reinforcing rod” encompassed carbon-fiber rods, that conclusion would not suggest that the court had failed

to give meaningful effect to the patentee's narrowing amendment. Rather, it would reflect the court's determination that the amendment did not disclaim the particular subject matter that was actually at issue in the case. See, e.g., *Exhibit Supply*, 315 U.S. at 134-135 (recognizing that amendment disclaimed any mechanism that was not "embedded," but concluding that amendment did not disclaim the partially embedded mechanism that was the subject of the parties' dispute).

3. Petitioner contends (Pet. 15) that, under this Court's precedents, a court must not only give effect to narrowing amendments, but must also construe amended claims as narrowly as possible against the patentee. Petitioner did not raise that argument before the court of appeals panel, asserting it for the first time in its unsuccessful petition for rehearing en banc. Compare Pet. C.A. Br. 30-31, with Pet. for Reh'g En Banc 8-12. This case is therefore an unsuitable vehicle for considering the question. See *Cutter v. Wilkinson*, 544 U.S. 709, 718 n.7 (2005) (This Court is "a court of review, not of first view.").

In any event, petitioner's contention lacks merit. The logical implication of petitioner's view is that, if the baseball-bat patent could plausibly be construed as either including or excluding carbon-fiber rods, the court would be required to hold that the patent excluded carbon-fiber rods—even though the amendment to the claim was intended to avoid prior art that did not utilize carbon-fiber rods. Nothing in the Patent Act or this Court's decisions requires that counterintuitive result.

a. Petitioner relies primarily on statements in this Court's decisions to the effect that amendments made

to narrow a claim “must be strictly construed against the inventor and in favor of the public.” *Hubbell*, 179 U.S. at 84; see *Exhibit Supply*, 315 U.S. at 137. Taken in context, however, those statements do not suggest that an amended claim must be construed more narrowly than is necessary to give effect to the amendment. Rather, the Court was explaining that, when a court has determined that an amendment disclaims particular subject matter, it may not allow the patentee to recapture that subject matter either by broadly construing the claims or by applying the doctrine of equivalents. In *Exhibit Supply*, the Court observed that, although the doctrine of equivalents ordinarily “operates * * * by liberal construction” to accord to the patentee subject matter that is outside the literal scope of his claims, the “strict construction” accorded to amended claims ensures that the patentee may not “regain[]” subject matter that he has disclaimed “by recourse to the doctrine of equivalents.” 315 U.S. at 137. Similarly in *Hubbell*, the Court explained that amended claims must be “strictly construed” with respect to the doctrine of equivalents, but it also stated that amended claims must be given a “fair construction.” 179 U.S. at 80, 82.

Exhibit Supply demonstrates that the Court has used the phrase “strict construction” to describe an interpretive method that prevents the patentee from regaining disclaimed subject matter, not one that gives amended claims their narrowest possible scope. The patent at issue in *Exhibit Supply* was directed to an electrical switch for a pinball table, and it originally claimed an electrical conductor “carried by the table.” 315 U.S. at 134. To overcome the examiner’s objections, the patentee limited the claim to encompass

only a conductor “embedded in the table.” *Ibid.* The Court explained that the amendment “restricted [the patentee’s] claim to those combinations in which the conductor means, though carried on the table, is also embedded in it.” *Id.* at 136. The Court also stated that the “strict construction” accorded the claims precluded resort to the doctrine of equivalents to regain disclaimed subject matter. *Id.* at 137. In construing the amended claim, however, the Court did not interpret the term “embedded” in the narrowest possible sense, instead construing it “as used in a permissible sense which would conform to the drawings.” *Id.* at 135. The Court accordingly interpreted the term “embedded” to encompass not only conductors set below the surface of the table, but also those fixed in the table and protruding above its surface—thereby rendering several of the accused devices infringing. *Ibid.*

b. A rule that amended claims must be given their narrowest plausible construction would have perverse consequences. If a claim had been amended during prosecution, courts would be required to give the amended language its narrowest plausible interpretation; but if a claim had not been amended, courts would be free to adopt the best construction based on the ordinary meaning of the claim language, the specification, and the prosecution history. Where (as here) the parties’ interpretive dispute is unrelated to the purpose that the amendment was intended to achieve, there is no good reason to treat the amendment as superseding usual claim-construction principles. To avoid being subject to the narrow-construction rule, moreover, applicants faced with an examiner’s rejection would have an artificial incentive to appeal the

rejection rather than amending their claims, even if they were otherwise willing to disclaim the particular subject matter that had prompted the examiner's rejection. That would disrupt the iterative nature of the examination process, increasing its burdensomeness and diminishing the agency's ability to work with applicants to produce claims with appropriate scope.

**B. The Federal Circuit Follows This Court's Precedents
In Construing Amended Patent Claims**

Properly understood, this Court's decisions establish that a court generally must apply ordinary principles of claim construction to an amended claim. Although the court may not construe an amended claim to encompass disclaimed subject matter, it need not adopt the narrowest plausible construction of the amended language. The Federal Circuit's decisions are consistent with those principles.

1. a. The Federal Circuit has repeatedly recognized that "an amendment that clearly narrows the scope of a claim, such as by the addition of a new claim limitation, constitutes a disclaimer of any claim interpretation that would effectively eliminate the limitation or that would otherwise recapture the claim's original scope." *Schindler Elevator Corp. v. Otis Elevator Co.*, 593 F.3d 1275, 1285 (2010); see *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (2003) (explaining that the Federal Circuit has "adopted" this "Court's guidance" as "a fundamental precept in [its] claim construction jurisprudence"). The Federal Circuit has regularly concluded that a patentee has disclaimed subject matter by amending an original claim in a manner that was "significant in distinguishing the claim from the prior art." *Board of Regents of the Univ. of Tex. Sys. v. BENQ Am. Corp.*, 533 F.3d

1362, 1372 (2008) (*BENQ*). The court also will not permit a patentee to recover, by way of claim construction in infringement litigation, subject matter that the patentee disclaimed before the PTO. See, e.g., *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-1334 (Fed. Cir. 2003); *Rheox, Inc. v. Entact, Inc.*, 276 F.3d 1319, 1326-1327 (Fed. Cir. 2002); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575-1577 (Fed. Cir.), cert. denied, 516 U.S. 987 (1995).

b. Petitioner characterizes (Pet. 13, 16-20) the Federal Circuit as presuming that a claim amendment made during the patent's prosecution "does *not* narrow a claim's scope" unless there is "clear and unmistakable" evidence to that effect. Petitioner is incorrect.

Consistent with this Court's precedents, the Federal Circuit construes claim language in light of the specification to "determine the ordinary and customary meaning of undefined claim terms as understood by a person of ordinary skill in the art at the time of the invention." *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1083 (2009). The court uses the "clear and unmistakable" formulation to express a presumption that the claim language should be given its ordinary meaning, consistent with the specification. The court applies that interpretive approach whether or not the claim has been amended during prosecution. See *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1327 (Fed. Cir. 2003) (court applies a "heavy presumption that a claim term carries its ordinary and customary meaning").

Accordingly, the Federal Circuit will treat the prosecution history as a ground for adopting a narrower interpretation of the claims than the ordinary

meaning of claim terms would suggest only if the prosecution history contains “clear and unmistakable” evidence to that effect. See *Amgen*, 314 F.3d at 1327. In applying that presumption, the Federal Circuit respects the principle that a claim may not be construed to recapture subject matter that was previously disclaimed through an amendment. The court has held that a claim amendment designed to exclude a particular prior-art technology necessarily constitutes clear and unmistakable evidence that the patentee intended to disclaim that technology, even if the ordinary meaning of the amended claim language would seem to encompass that prior art. See, e.g., *ibid.* (“[T]he prosecution history may not be used to infer the intentional narrowing of a claim absent the applicant’s clear disavowal of claim coverage, such as an amendment to overcome a rejection.”); see also *Paragon*, 566 F.3d at 1085-1086 (amendment made to distinguish single-structure prior art provided clear evidence that amended claim could not be construed to include single-structure technology); *BENQ*, 533 F.3d at 1372-1373 (amendment made to distinguish prior art referring to “word” matching established that claim term “syllabic elements” did not include all words).

Petitioner relies (Pet. 16-17) on several prior decisions in which the Federal Circuit found no “clear and unmistakable” evidence that amended claim language should be given a construction narrower than its ordinary meaning. Contrary to petitioner’s contention, the court did not hold in those cases that the amendments did not narrow the claims at all, or that the amendments would be construed to have narrowing effect only upon a showing of clear and unmistakable

evidence. Rather, the court concluded that the amendments had disclaimed subject matter that was not relevant to the parties' interpretive dispute. The court thus held that amendments designed to disclaim particular subject matter did not constitute "clear and unmistakable" evidence that the patentees intended to disclaim *other* subject matter not addressed by the amendments.

In *Paragon, supra*, for instance, the claim-construction dispute concerned whether the patent covered a device made up of three separate components, or was instead limited to a device made up of two components. 566 F.3d at 1085-1086. Although the claim language and specification indicated that the device could consist of three components, the accused infringer argued that a claim amendment had disavowed the three-component device. The Federal Circuit rejected that contention. It explained that the amendment was intended to distinguish prior art consisting of a "unitary structure," and that "[b]y amending the claims" to require multiple separate units and "remark[ing] that this distinguished the 'unitary structure' of" the prior art, "the applicants clearly and unmistakably disavowed a *single* structure." *Ibid.* (emphasis added).

The Federal Circuit in *Paragon* thus recognized that the patentee could not recapture through claim construction the subject matter disclaimed by the amendment—namely, a device containing only a single component. But since there was no evidence that the amendment was intended to disclaim a three-component device, and since the ordinary meaning of the amended claim language encompassed such a device, the court declined to treat the amendment as a

ground for rejecting the most textually natural interpretation of the claim. 566 F.3d at 1084-1086. The other decisions on which petitioner relies are to the same effect. See *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1325-1326 (Fed. Cir. 2013) (holding that amendment that disclaimed “intermittent contact” found in the prior art by requiring “continuous contact” did not establish whether patentee intended to exclude a technology not found in the prior art from the definition of “continuous contact”); *Kumar v. Ovonic Battery Co.*, 351 F.3d 1364, 1370-1371 (Fed. Cir. 2003) (amendment surrendered broad claim to all partially crystalline alloys, but “did not thereby surrender the subset of such material within the scope of the definition of ‘amorphous,’” so the prosecution history did not clearly disavow the ordinary meaning of “amorphous” alloys).¹

¹ Petitioner relies (Pet. 16-17) on several other decisions that it characterizes as having found “no disclaimer” at all when the prosecution history was unclear. Those decisions did not involve *amendments* to actual claim language, but instead concerned *statements* made during the prosecution of a patent application. Unlike claim amendments, such statements do not implicate the rule that a court must give effect to narrowing amendments. In addition, statements made to the examiner may be vague or incomplete, necessitating caution in relying on them to narrow the apparent scope of claim language. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005), cert. denied, 546 U.S. 1170 (2006). The Federal Circuit has accordingly declined to conclude that prosecution statements evince any intent to narrow the claims, absent an unequivocal expression to that effect. See *W.E. Hall Co. v. Atlanta Corrugating, LLC*, 370 F.3d 1343, 1351-1352 (2004) (applicant’s statements about scope of amended claim did not support construing final claim language to be narrower than its ordinary meaning); *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1333 (2004) (rejecting argument that patentee’s state-

2. For the same reasons, petitioner is wrong in contending (Pet. 20-21) that the Federal Circuit’s “clear and unmistakable” evidence standard conflicts with this Court’s decisions applying the doctrine of equivalents. Petitioner argues (Pet. 21) that the Federal Circuit disregards narrowing amendments in construing claims, thereby permitting “applicants [to] receive through claim construction what they could not under the doctrine of equivalents.” Petitioner’s premise is incorrect. In resolving claim-construction disputes, the Federal Circuit takes care to prevent patentees from recapturing subject matter that they disclaimed through amendments. See pp. 14-15, *supra*. The court’s claim-construction precedents are thus fully consistent with decisions of this Court that recognize the limiting effect that claim amendments may have on the patentee’s ability to invoke the doctrine of equivalents.

C. The Court Of Appeals’ Decision In This Case Is Consistent With This Court’s Precedents

The Federal Circuit correctly applied the foregoing principles in this case. The dispute between the parties concerned the claim language describing “views of objects * * * [that are] *substantially elevations*.” Pet. App. 5 (emphasis omitted). Petitioner contended below that the term “substantially elevations” was limited to flat images (*i.e.*, images that lack any per-

ments about scope of amended claims established intent to narrow a different claim); see also *Schindler Elevator*, 593 F.3d at 1285-1286 (construing amendment to disavow reliance on user’s manual action to call an elevator, but concluding that separate prosecution-history statements did not clearly disavow reliance on other user actions).

spective), while respondent argued that the term also encompasses spherical or curved images. *Id.* at 8.

The Federal Circuit first determined that the ordinary meaning of the claim term “substantially elevations” encompassed all “front or side views” of objects, including front or side views showing depth and perspective (as views depicted in curved or spherical images would). Pet. App. 10-13. The court explained that the district court’s interpretation of “substantially elevations” as covering only elevations in the strict architectural sense—*i.e.*, exclusively flat views that show no perspective or curvature—effectively read the term “substantially” out of the claim. *Id.* at 11. The court of appeals also relied on the specification’s discussion of embodiments of the invention that would necessarily create curved or spherical images, including using a fish-eye lens (which creates curved images), and using a duodecahedron of cameras (which creates images that can be combined to create spherical composite images). *Id.* at 12, 14.

The court of appeals recognized that the phrase “substantially elevations” was added to respondent’s claims in response to a rejection based on prior art. Pet. App. 15. Based on the prosecution history, however, the court found that the amendment was not relevant to the parties’ interpretive dispute because the amendment was intended to disclaim subject matter *other than* curved or spherical images. Respondent’s claims initially recited “images providing a non-aerial view of the objects.” *Ibid.* (citation omitted). That claim broadly encompassed any images that showed views other than views of objects taken from directly above (for instance, front or side views of an object, or views taken from a low angle looking up-

ward). The examiner rejected that claim in light of a prior-art patent, Levine, which was “directed to ‘map images’” (*i.e.*, images of map data) that showed the location of streets, gas stations, and other places of interest. *Ibid.* By narrowing its claim to views that are “substantially elevations,” respondent sought to distinguish its claims from Levine’s map views.

That history indicates that the amendment was designed to narrow the range of views covered by respondent’s claim, out of concern that the broad claim to all “non-aerial view[s]” encompassed the map views shown by Levine. The disputed issue in the courts below, however, was whether respondent’s claim encompasses curved or spherical images—in other words, images that display a view of an object (such as a front or side view) that is curved at the edges or projected onto a sphere. See Pet. App. 6-7 (examples). Petitioner does not suggest that Levine claimed curved or spherical images. Nor does petitioner identify any evidence in the prosecution history suggesting that the examiner was concerned that respondent had claimed too broad a range of image types (*e.g.*, flat, curved, spherical). Indeed, if respondent had intended to disclaim curved or spherical images, its alteration of “non-aerial view[s]” to “views of objects * * * [that are] substantially elevations” would have been a particularly oblique and counterintuitive way of expressing that intent.

The court of appeals therefore correctly held that the amendment’s use of the term “substantially elevations” did not constitute a “clear and unambiguous disavowal of spherical or curved images.” Pet. App. 15. Petitioner does not seek review of the court’s antecedent determination that, under the most natural

reading of the claim language and the specification, the term “substantially elevations” encompasses curved or spherical images. See *id.* at 12-14. Because that term was added in order to disclaim an altogether different type of image (the map views disclosed in Levine), the court found no persuasive reason to depart from the construction of “substantially elevations” that best reflected the ordinary meaning of the amended claims.²

Contrary to petitioner’s contention (Pet. 13), the court of appeals’ construction does not deprive the amendment of any narrowing effect. By amending the claim to encompass only images that are “substantially elevations,” respondent unquestionably excluded the map-style views disclosed in Levine. As respondent has explained, moreover, the phrase “substantially elevations” also excludes other non-aerial views, such as views looking down a street or views from a low angle looking upward. Br. in Opp. 21-22.

² Petitioner argues (Pet. 23-24) that the Federal Circuit should not have relied on the specification in construing the claim, because narrowing amendments often are not reflected in the specification, rendering it of “limited value in construing a claim term added by amendment.” The Federal Circuit has recognized that when an amendment is intended to disclaim an embodiment described in the specification, the court must construe the claim to exclude that embodiment. See, e.g., *North Am. Container, Inc. v. Plastipak Packaging, Inc.*, 415 F.3d 1335, 1346 (2005); *Rheox, Inc.*, 276 F.3d at 1327. The court simply concluded in this case that the amendment did not compel such a result. Because the court concluded that the amendment was directed to the map views in Levine, rather than to curved or spherical images, the court correctly held that the curved-image embodiments described in the specification (e.g., using a fish-eye lens or a duodecahedron of cameras) were relevant to construing the claims.

D. This Court's Review Is Not Warranted

The Federal Circuit does not presume that amended claim language has the same meaning as the pre-amendment language. Rather, the court presumes that an amended claim (like claim language generally) carries its ordinary and usual meaning. When a litigant contends that the prosecution history supports an interpretation of amended claim language that departs from the ordinary meaning of the disputed terms, the Federal Circuit requires the litigant to identify clear and unmistakable evidence that the patentee intended such a departure. For the reasons discussed above, that approach is consistent with this Court's decisions.

Even if petitioner's argument were an apt criticism of *other* Federal Circuit decisions, further review would not be warranted in this case. The court below did not conclude that the amended claim language bore the same meaning as the claim in its pre-amendment form. Rather, by construing the term "substantially elevations" to mean "substantially front or side views of the objects in the geographic area," Pet. App. 16, the court read that term to exclude some of the "non-aerial view[s] of the objects," *id.* at 15 (citation omitted), that the pre-amendment language had encompassed. And because petitioner failed to argue before the panel that this Court's decisions require the narrowest plausible construction of amended claims, this case is an unsuitable vehicle to consider that question. See p. 10, *supra*.

Petitioner asserts (Pet. 13) that "the Federal Circuit's approach allows applicants to secure claims by narrowing them before the PTO, but then to turn around and assert the broader, original claim scope in

court.” That concern is amply addressed by the settled rule—applied both by this Court and by the Federal Circuit—that a patentee in infringement litigation cannot advance an interpretation of its patent claims that would negate an amendment made to secure issuance of the patent. Established PTO procedures provide additional protection against patent holders in post-issuance litigation claiming broader claim scope than the PTO contemplated in granting the claims. During the examination, the examiner must give the claims their broadest reasonable interpretation. *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004). When an examiner allows an amended claim, he therefore has concluded that the claim is patentable even if it is given its broadest reasonable construction. That rule “reduc[es] the possibility” that the court in an infringement suit will construe a claim more broadly than the PTO intended in allowing the claim. *Ibid.*

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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