

No. 11-_____

IN THE
Supreme Court of the United States

EASTMAN CHEMICAL COMPANY,

Petitioner,

v.

WELLMAN, INC.,

Respondent.

**On Petition For A Writ Of Certiorari
To The United States Court Of Appeals
For The Federal Circuit**

PETITION FOR A WRIT OF CERTIORARI

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QUESTION PRESENTED

Under 35 U.S.C. § 112, ¶ 2, a patent holder must definitively claim the subject matter covered by the patent. The district court below held that the patents in issue, covering a special plastic used for bottles containing hot liquid, were invalid for indefiniteness because a skilled artisan could not determine from the patent how to prepare samples for testing to assess whether those samples infringed any of the patent claims. The Federal Circuit reversed, joining one of two conflicting lines of its precedent, and held that the patent claims were not invalid for indefiniteness because the claims were “amenable to construction.”

The question presented is:

Whether the legal standard for patent indefiniteness is an artificial and blunt rule assessing whether patent claims are “amenable to construction,” or a more textually grounded and nuanced rule assessing whether the patent notifies a skilled artisan of the bounds of the patent claims and what would infringe those claims.

**PARTIES TO THE PROCEEDINGS
AND CORPORATE DISCLOSURE STATEMENT**

The parties to the proceedings below were Petitioner, Eastman Chemical Company and Wellman, Inc., the Respondent.

Petitioner Eastman Chemical Company is a publicly-owned, Delaware corporation. No publicly held corporation owns 10% or more of Eastman Chemical Company's stock.

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PETITION FOR A WRIT OF CERTIORARI

Eastman Chemical Company (“Eastman”) respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the court of appeals (Pet.App.1a-28a) is reported at 642 F.3d 1355 (Fed. Cir. 2011). The opinion of the district court (Pet.App.29a-60a) is reported at 689 F. Supp. 2d 705 (D. Del. 2010).

JURISDICTION

The district court had jurisdiction over respondent’s claims pursuant to 28 U.S.C. §§ 1331 and 1338(a). The Court of Appeals had jurisdiction to review the district court’s final judgment pursuant to 28 U.S.C. § 1295(a)(1). The United States Court of Appeals for the Federal Circuit entered its judgment and opinion on April 29, 2011, and denied Eastman’s petition for rehearing or rehearing en banc on August 11, 2011. This Court has jurisdiction under 28 U.S.C. § 1254(1).

STATUTORY PROVISIONS INVOLVED

Section 112, ¶ 2 of 35 U.S.C. provides:

The [patent] specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

STATEMENT OF THE CASE

A growing number of federal patent cases turn on “indefiniteness” challenges to patent validity based on the lack of public notice as to the scope of the claim terms. The Federal Circuit’s decision in this

case deepens a significant split within the Federal Circuit and with several other federal appellate courts. One line of the Federal Circuit’s cases interprets the definiteness requirement consistently with the language of the Patent Act and this Court’s precedents to ensure the public has clear warning of what constitutes infringement.

In the case below, however, the Federal Circuit applied a second line of its decisions, which have held that patent claims will survive indefiniteness challenges simply if they are “amenable to” a construction or if “reasonable efforts” at construction do not “prove futile.” Pet.App.20a-21a (quoting *Exxon Research & Eng’g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001)). The Federal Circuit then reached outside the intrinsic record to string together a series of suppositions and unwarranted inferences for the purpose of articulating a construction for the critical claim term. That definition is not supported by, and contradicts, the intrinsic record. The Federal Circuit’s reasoning in this case derogates the importance of notifying the public of the bounds of patent claims and dramatically illustrates the problems when the wrong standard is applied.

I. STATUTORY BACKGROUND

The Constitution grants Congress the power to create a patent system to promote the useful arts. U.S. Const. art. I, § 8, cl. 8 (“The Congress shall have the power ... [t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”). “[T]he patent system represents a carefully crafted bargain that encourages both the creation and the public disclosure of new

and useful advances in technology, in return for an exclusive monopoly for a limited period of time.” *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 63 (1998).

Ensuring that patented discoveries are fully disclosed by inventors, Congress enacted statutes that mandate complete, clear, and precise descriptions of the inventions for which an inventor seeks patent protection. *See generally* 35 U.S.C. § 112. Each patent application must include a “specification” that conforms with the requirements of Section 112. 35 U.S.C. § 111(a)(2)(A). A compliant specification will “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, and shall set forth the best mode contemplated by the inventor of carrying out his invention.” 35 U.S.C. § 112, ¶ 1. These provisions are often referred to as the “enablement” and “best mode” requirements. Further, Section 112 requires that a patent “shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112, ¶ 2. This provision is often referred to as the “definiteness” requirement.

The requirements of Section 112 work together to ensure that an inventor has satisfied his obligation to fully disclose the invention in exchange for the exclusive rights granted by the patent. *Universal Oil Prods. Co. v. Globe Oil & Ref. Co.*, 322 U.S. 471, 484 (1944) (“[T]he quid pro quo [for the patent right] is disclosure of a process or device in sufficient detail to enable one skilled in the art to practice the invention

once the period of the monopoly has expired, and the same precision of disclosure is likewise essential to warn the industry concerned of the precise scope of the monopoly asserted.”).

While the specification describes the invention in detail, the patent’s claims define the legal scope of the invention. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996). For this reason, it is critical that patent claims be drafted clearly and precisely so that the public can understand the boundaries of the claimed invention. This Court has often emphasized this important purpose behind the definiteness requirement:

The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must “inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.”

Gen. Elec. Co. v. Wabash Appliance Corp., 304 U.S. 364, 369 (1938).

A patent may, and often does, include multiple claims. Each claim may form the basis for a separate allegation of infringement. In this case, for example, the two Wellman patents-in-suit contain a total of 172 claims.

Once issued by the United States Patent and Trademark Office, a patent is presumed valid. 35 U.S.C. § 282. However, a patent may be declared invalid if the defendant in litigation proves that the patent does not comply with one or more provisions of

the Patent Act. For example, if a patent claims an innovation that was previously known in the art, it will be declared invalid for lack of novelty. 35 U.S.C. § 102. Similarly, if a patent claims only an obvious modification of a known innovation, it will be declared invalid as “obvious”. 35 U.S.C. § 103; *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 417-18 (2007). If a patent specification does not contain sufficient disclosure to enable one of ordinary skill in the art to practice the invention without undue experimentation, the patent is invalid. *ALZA Corp. v. Andrx Pharm., LLC*, 603 F.3d 935, 940 (Fed. Cir. 2010). And, as pertinent in this case, if a patent claim does not particularly point out and distinctly claim the invention, then it is invalid as indefinite. 35 U.S.C. §§ 112, ¶ 2 & 282(3).

II. FACTUAL BACKGROUND

This case concerns a plastic, polyethylene terephthalate, known as “PET” that is used in making food and beverage containers. One commercial application for PET is “hot-fill” bottles, which are exposed to high temperature, upwards of 205°F, during the bottle-filling process. Pet.App.2a. These high temperatures are needed when bottling, for example, certain juices that require heat pasteurization. *Id.*

According to the two patents-at-issue in this case, United States Patent Nos. 7,129,317 and 7,094,863 (collectively “the Wellman patents”), “[m]ost high-clarity polyester bottles do not possess the necessary dimensional stability to be hot-filled with product” and “exhibit unacceptable shrinkage and haze.” Pet.App.82a. This is because some types of PET crystallize at relatively low temperatures, causing the PET to look hazy and unattractive as a beverage bot-

tle. Accordingly, the patents posit that “there is a need for [PET] that is suitable for making high-clarity, hot-fill bottles that can be filled with product at temperatures between about 180°F. and 205°F.” *Id.*

The inventors’ solution to the hot-fill problem was a purported invention for “slow-crystallizing” PET, Pet.App.85a, which the patents define as PET that “possess[es] a significantly higher heating crystallization exotherm peak temperature (T_{CH}) as compared with those of conventional antimony-catalyzed [PET].” *Id.* T_{CH} is measured by heating a PET sample at a rate of 10°C per minute in a differential scanning calorimetry (or DSC) machine. Pet.App.97a. The temperature at which the sample crystallizes the fastest—which is recorded by the DSC as a “peak”—is the T_{CH} . *Id.*

The Wellman patents teach that having an elevated T_{CH} will delay the onset of crystallization when the PET is subjected to heat, Pet.App.85a, and that the claimed PET is particularly well suited for making hot-fill bottles. *Id.* Each of the asserted claims in the Wellman patents requires that the claimed PET has a T_{CH} value of more than about 140°C. *See, e.g.,* Pet.App.138a-139a (claim 1).

In order to determine whether a sample has a T_{CH} greater than 140°C, it is necessary to know the appropriate sample preparation methods. Differences in sample preparation methods will indisputably affect T_{CH} measurements. Pet.App.53a-58a. The Wellman patents do not provide any directions for preparing PET samples prior to testing. *Id.* Two of the many variables that can be controlled for testing and that will affect DSC measurements are thermal

history and moisture content. *Id.*

“Thermal history is the amount of heat and stress that a sample has been exposed to prior to the [DSC] test, such as during manufacturing and specimen preparation.” Pet.App.54a. Heat and stress can orient the long polymeric strands making up PET. *Id.* at 26a. The resulting orientation in the sample from its thermal history will change the measured T_{CH} . *Id.*

A sample’s T_{CH} can be measured with or without the influence of its thermal history. That is, a sample can simply be heated up and the T_{CH} determined. Pet.App.54a. This is called a “first scan” measurement. *Id.* Alternatively, immediately after this first heat up, the molten sample can be rapidly cooled, heated back up, and T_{CH} measured using this second heat up. *Id.* This is called a “second scan” measurement. *Id.*

Heating up and cooling PET erases the prior thermal history, and, thus, T_{CH} measurements made using a second scan are not affected by the PET’s previous thermal history and orientation. *Id.* DSC measurements using only a first scan, however, are directly affected by a sample’s thermal history. *Id.* Wellman’s own test data on the accused products showed that T_{CH} varied by over 50 degrees depending on whether a first or second scan was used:

T_{CH} from First Scan	T_{CH} from Second Scan
100.73° C	156.07° C
97.95° C	156.22° C
100.42° C	153.26° C
100.73° C	152.76° C

Pet.App.274a-289a.

Like thermal history, the moisture content of a sample affects its measured T_{CH} . Wellman's expert acknowledged this effect of moisture on T_{CH} :

The moisture content of polymers generally does effect [sic] T_{CH} . Specifically, significant moisture content can depress T_{CH} values because the presence of moisture tends to facilitate crystallization. Thus, higher moisture content will cause crystallization onset at a lower temperature than a similar sample with less moisture content.

Pet.App.251a.

A sample of PET can be conditioned, prior to DSC testing, to have a specific moisture content. For example, a test sample can be stored in a humidity-controlled environment for a set amount of time. However, the Wellman patents do not contain any instructions about how much, if any, moisture conditioning should be done before testing for T_{CH} . Pet.App.55a. Wellman's own data establishes that the T_{CH} of the accused products can vary by 20 degrees (from 151.07°C to 130.9°C) based solely on differences in moisture content. Pet.App.255a-256a.

III. PROCEEDINGS BELOW

A. In a complaint filed in the United States District Court for the District of Delaware on September 24, 2007, Wellman sued Eastman for allegedly infringing the Wellman patents. On February 2, 2010, the district court ruled on the related issues of claim construction and indefiniteness as well as Wellman's failure to satisfy the best mode requirement of 35 U.S.C. § 112. The district court entered summary judgment that the Wellman patents were invalid for

indefiniteness. Pet.App.59a. In addition, the district court held that many of the asserted claims were invalid because Wellman had intentionally withheld the best mode for practicing the invention. *Id.* at 48a-49a.

In granting summary judgment of invalidity, the district court first considered whether the claims were indefinite, noting that the primary purpose for the definiteness requirement of Section 112 “is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, *e.g.*, competitors of the patent owner, can determine whether or not they infringe.” Pet.App.50a, quoting *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774, 779-80 (Fed. Cir. 2002). The trial court explained:

Therefore, even if a claim term’s definition can be reduced to words, it is “still indefinite if a person of ordinary skill in the art cannot translate the definition into meaningfully precise claim scope.” In this regard, a claim term is indefinite if the patent does not provide an “objective anchor” or “yardstick against which potential infringers may measure their activities.”

Pet.App.51a, quoting *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1251 (Fed. Cir. 2008) and *Girafa.com. v. IAC Search & Media, Inc.*, No. 07-787-SLR, 2009 WL 3074712, at *2 (D. Del. Sept. 25, 2009).

Applying these standards, the district court noted that “one of ordinary skill in the art seeking to determine whether T_{CH} of a particular resin meets the T_{CH} limitation of (and thus infringes) the Wellman

patents is faced with a multitude of choices.” Pet.App.57a. Because the court found that each of the parameters was “crucial to providing the T_{CH} limitation with a fixed meaning,” the court was unable to construe the T_{CH} limitation in a sufficiently definite way to determine infringement. *Id.* at 58a. The court held that the patent claims were indefinite, and thus the Wellman patents were invalid. *Id.* at 59a.

B. The Federal Circuit first considered the district court’s best mode finding. Pet.App.8a-19a. The Federal Circuit affirmed the district court’s decision, noting that “[t]he record also shows that Wellman intentionally concealed the best mode.” *Id.* at 18a. However, because only some of the asserted claims were invalidated by the district court’s best mode ruling, the Federal Circuit also reviewed the district court’s judgment that all of the patent claims were invalid for indefiniteness. The Federal Circuit reversed that ruling and remanded the case for further proceedings. *Id.* at 28a.

In reaching its conclusion, the Federal Circuit applied the amenable-to-construction standard in this case: “Claims need not be plain on their face in order to avoid condemnation for indefiniteness; rather claims must only be amenable to construction.” Pet.App.20a-21a.

In applying that standard, the Federal Circuit adopted Wellman’s construction that equated “amorphous” PET with samples (i) having no thermal history or (ii) those “subjected to a first scan ... to remove the thermal history.” Pet.App.26a. This construction was necessary to overcome the variability in measuring T_{CH} caused by the thermal history in a PET sample, an ambiguity that was not addressed in

the Wellman patents.

To overcome the Wellman patent's failure to identify specific moisture conditions, the Federal Circuit looked outside the intrinsic record and relied upon a protocol, ISO 291, as "provid[ing] a person of skill in the art with an objective standard for moisture conditioning." Pet.App.24a. Even though ISO 291 was never presented to the district court, the Federal Circuit justified its reliance upon ISO 291 because it was referenced by number, without giving any details about the protocol, in an endnote of a different ISO protocol (the 1997 ISO 11357-1 protocol) that had been presented to the district court.¹ *Id.* at 25a.

C. Eastman filed a petition seeking panel rehearing or rehearing en banc on May 31, 2011. On August 11, 2011, the Federal Circuit denied Eastman's petition.

REASONS FOR GRANTING THE WRIT

This Court should grant the writ for at least three reasons:

First, the Federal Circuit's amenable-to-construction standard conflicts with the precedents of this Court, the Federal Circuit's prior decisions in *Honeywell Int'l, Inc. v. U.S.I.T.C.*, 341 F.3d 1332 (Fed. Cir. 2003) and *Halliburton*, the decisions of other Circuit Courts of Appeals, and the plain language of Section 112, ¶ 2. For example, *Honeywell* involved the same polymer as here, PET, and the patent failed to disclose sample preparation methods for DSC test-

¹ Neither ISO protocol was presented to the Patent Office during prosecution of the Wellman patents, and, therefore, neither is part of the intrinsic record.

ing of the PET, leading the Federal Circuit to hold the claims indefinite. Nevertheless, in this case, the Federal Circuit found the claims sufficiently definite to escape invalidity under nearly identical facts.

The purpose of the definiteness requirement is to ensure that the public has clear notice of the boundaries of the claims so that infringement can be avoided. The Federal Circuit's artificial amenable-to-construction standard, however, is too blunt a rule to be effective. While the definiteness standard is intended to ensure that a person of ordinary skill in the art can understand the scope of the claims, under the Federal Circuit's rule, overly broad or imprecise claims are deemed sufficiently definite as long as a court can concoct a plausible construction years later if the patent is asserted against would-be infringers. If the Federal Circuit's decision in this case is allowed to stand, the standard for indefiniteness will continue to move away from a textual and nuanced approach that ensures the public has clear notice of what constitutes infringement and toward an artificial and toothless standard that fails to ensure that the boundaries of the patent right are clearly defined.

Second, this issue is one of significant and increasing importance. Judge Plager of the Federal Circuit has written extensively about the flaws in the Federal Circuit's indefiniteness jurisprudence and has advocated strongly for change. Unfortunately, despite receiving at least four petitions for rehearing en banc on this issue, the Federal Circuit has declined to take it up. And, this case is not an isolated one. Questions of claim indefiniteness are arising with increasing frequency in the district courts and the Federal Circuit, particularly as a result of the large number

of patent infringement lawsuits being filed by non-practicing entities (“NPEs”)² seeking to twist broad patent claims to read upon new technologies in high technology sectors.

Third, this case presents an excellent vehicle for revisiting the standard for indefiniteness because the outcome directly depends upon which standard is applied. If the *Honeywell/Halliburton* rule is applied, the claims are invalid; however, when the court below applied the amenable-to-construction rule, it held that the ambiguous claims in the Wellman patents survived scrutiny because the court found it possible (albeit tortuously difficult) to articulate a construction for the claim terms. The dispositive contrast in the outcome makes this an ideal case for this Court to review the issue.

Moreover, the facts of this case illustrate the practical difficulties that arise when the amenable-to-construction standard is applied. When a court stretches to articulate a construction for ambiguous patent claims, the application of those construed claims may (and in this case does) conflict with the science, the intrinsic record, and fundamental principles of logic. Indeed, in this case, the Federal Circuit ignored the intrinsic record and specifically ignored the four-step testing method set forth in the

² “The term NPE generally refers to a patentee that does not make products or ‘practice’ its inventions. Over time, the definition has been narrowed to exclude actors in the innovation enterprise who engage in significant research and development activities and individual inventors who seek to commercialize their inventions.” Colleen V. Chien, *Of Trolls, Davids, Goliaths, And Kings: Narratives And Evidence In The Litigation Of High-Tech Patents*, 87 N.C. L. REV. 1571, 1577-78 (2009).

Wellman patents. The patents clearly laid out that process, but in an effort to construe the claims, the Federal Circuit ignored the four-step method disclosed and stated that one skilled in the art would use a different process that is not even referred to in the patents. In addition, the Federal Circuit reached outside the intrinsic record to find a moisture conditioning method in an obscure reference to protocol (ISO 291) found in another protocol, even though ISO 291 was never raised before the trial court and was introduced by Wellman for the first time on appeal. When one can salvage patent claims only by such extreme machinations, the public notice function of Section 112 has been eliminated.

I. THE DECISION BELOW CONFLICTS WITH THIS COURT'S PRECEDENTS, FEDERAL CIRCUIT PRECEDENTS, OTHER CIRCUIT COURT PRECEDENTS, AND THE PATENT ACT

A. This Court's Precedent Emphasizes The Public Notice Function Of Section 112, ¶ 2

For more than a century, this Court has emphasized that patent claims must clearly disclose the boundaries of the invention claimed. *White v. Dunbar*, 119 U.S. 47, 52 (1886) (“The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is...”); *Merrill v. Yeomans*, 94 U.S. 568, 573 (1876) (“The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, leave no excuse for ambiguous language or vague descriptions. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these

rights.”); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730-31 (2002) (“The monopoly is a property right; and like any property right, its boundaries should be clear.... A patent holder should know what he owns, and the public should know what he does not. For this reason, the patent laws require inventors to describe their work in ‘full, clear, concise, and exact terms,’”).

Congress codified the definiteness requirement in Section 112, ¶ 2. This Court has often explained that the primary purpose for the definiteness requirement is to provide clear warning as to what constitutes infringement of the patent. *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942) (requiring definite claim language avoids creating a “zone of uncertainty” around patent rights that can discourage innovation); *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931) (A patent claim must “inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.”); *see also Gen. Elec.*, 304 U.S. at 369 (same).

To comport with this authority, any standard for definiteness must ensure that the public is informed of the scope of the patent right with reasonable certainty. Such a standard will not tolerate vague or ambiguous patent claims, nor will it leave the public wondering whether its conduct infringes others’ patent rights. But the Federal Circuit has created a contrary line of authority that diverges from this Court’s core principles. Instead of a standard that takes into account all of the relevant facts and circumstances—including the practical ability to apply

the construed claims to potentially infringing products with reasonable certainty—the Federal Circuit has turned its back on giving the public meaningful notice and created an “anti-notice,” amenable-to-construction standard. Under this standard, the Federal Circuit imposes an blunt and artificial test that holds claims sufficiently definite as long as one can articulate a construction for the claim terms, even if that construction as applied to the accused products is inconsistent with the science, the intrinsic record, or simply makes no sense. Accordingly, under the amenable-to-construction standard, patent claims will almost never be found indefinite, even though many (as in this case) fail to give the public adequate notice of what constitutes infringement.

The amenable-to-construction standard is in direct conflict with this Court’s historical precedents on indefiniteness, and it also runs contrary to this Court’s more recent patent decisions. This Court has repeatedly rejected artificial or blunt tests of the sort at issue here when the patent system would be better served with a more textual and nuanced approach. *See, e.g., eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 390 (2006) (rejecting mandatory injunction rule in favor of traditional four-part balancing test for granting injunctive relief); *KSR*, 550 U.S. at 415 (“We begin by rejecting the rigid approach of the Court of Appeals. Throughout this Court’s engagement with the question of obviousness, our cases have set forth an expansive and flexible approach inconsistent with the way the Court of Appeals applied its TSM test here.”); *Bilski v. Kappos*, 130 S. Ct. 3218, 3227-28 (2010) (reversing machine-or-transformation test as the sole test for determining the patent eligibility of a

process, and replacing it with a more flexible analysis to determine patent-eligible subject matter). This case presents another situation where this Court's intervention is necessary to return balance to the patent system by eliminating the Federal Circuit's meaningless and vague amenable-to-construction standard for indefiniteness.

B. The Federal Circuit Has Created Two Conflicting Lines Of Authority—One That Adheres To The Public Notice Requirement Of The Statute And The Other That Focuses On Whether The Claim Is Amenable-To-Construction

1. Consistent with this Court's precedents and the language of the statute, the Federal Circuit has acknowledged the importance of clearly defining the bounds of the claimed invention:

The primary purpose of the definitiveness requirement is to ensure that the claims are written in such a way that they give notice to the public of the extent of the legal protection afforded by the patent, so that interested members of the public, *e.g.*, competitors of the patent owner, can determine whether or not they infringe.

All Dental Prodx, 309 F.3d at 779-80; *see also Halliburton*, 514 F.3d at 1249 (“[T]he patent statute requires that the scope of the claims be sufficiently definite to inform the public of the bounds of the protected invention, i.e., what subject matter is covered by the exclusive rights of the patent. Otherwise, competitors cannot avoid infringement, defeating the public notice function of patent claims.”); *Honeywell*, 341 F.3d at 1340 (“[T]he claims, the written description, and the prosecution history fail to give us, as the

interpreter of the claim term, any guidance as to what one of ordinary skill in the art would interpret the claim to require. Moreover, because the sample preparation method is critical to discerning whether a PET yarn has been produced by the claimed process, knowing the proper sample preparation method is necessary to practice the invention.”).

Applying these principles, the Federal Circuit has sometimes invalidated unclear and ambiguous patent claims. *See, e.g., Geneva Pharm., Inc. v. GlaxoSmithKline PLC*, 349 F.3d 1373, 1384 (Fed. Cir. 2003) (“A claim is indefinite if its legal scope is not clear enough that a person of ordinary skill in the art could determine whether a particular composition infringes or not.”); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1342 (Fed. Cir. 2003) (affirming invalidity when it was impossible to determine whether the accused product fell within the scope of the claims).

2. However, at other times—as it did in this case—the Federal Circuit has upheld vague and ambiguous patent claims as long as they are amenable to some construction, even if the proper meaning of the claims cannot clearly be determined from the text:

[W]hat we have asked is that the claims be amenable to construction, however difficult that task may be If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds.

Exxon Research, 265 F.3d at 1375; see also *Star Scientific, Inc. v. R. J. Reynolds Tobacco Co.*, 655 F.3d 1364, 1373-74, 1380 (Fed. Cir. 2011) (finding claims sufficiently definite because a skilled artisan would know how to control the environment in a tobacco curing barn, even though RJR’s expert testified that a skilled artisan would be unable to draw the line between conventional curing methods and the “controlled environment” required by the claims); *Trading Techs. Int’l, Inc. v. eSpeed, Inc.*, 595 F.3d 1340, 1358 (Fed. Cir. 2010) (“Only claims ‘not amenable to construction’ or ‘insolubly ambiguous’ are indefinite.”); *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1321 (Fed. Cir. 2008) (reversing district court’s determination of indefiniteness because the Federal Circuit was able to construe the claim term at issue); *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372-74 (Fed. Cir. 2004) (same).

3. Finding a patent claim sufficiently definite solely because it is possible to articulate some construction for the claim is far different from requiring precise and distinct disclosure of the boundaries of the claimed invention. In fact, Judge Plager recently challenged the Federal Circuit’s amenable-to-construction standard when he dissented from the Federal Circuit’s decision to deny rehearing en banc in *Enzo Biochem, Inc. v. Applera Corp.*:

Despite the varying formulations that the court has used over the years in describing its “indefiniteness” jurisprudence ..., the general conclusion from our law seems to be this: if a person of ordinary skill in the art can come up with a plausible meaning for a disputed claim term in a

patent, that term, and therefore the claim, is not indefinite.

605 F.3d 1347, 1348 (Fed. Cir. 2010), *cert. denied*, 131 S. Ct. 3020 (2011).

There, Judge Plager recognized that the Federal Circuit’s amenable-to-construction test eviscerates the public notice function of patent claims and focuses instead upon the trial court’s attempt to pick the “right” interpretation, an interpretation that will not be confirmed until appellate review is complete:

[I]t is not until three court of appeals judges randomly selected for that purpose pick the “right” interpretation that the public, not to mention the patentee and its competitors, know what the patent actually claims. The inefficiencies of this system, and its potential inequities, are well known in the trade.

*Id.*³

Judge Plager concluded that if the public notice function of the patent law is to be honored, the rule that claims must particularly point out and distinctly claim the invention must be enforced:

It is time for us to move beyond sticking our fingers in the neverending leaks in the dike that

³ Judge Plager’s concerns are well justified. The data shows that the Federal Circuit reverses challenged claim constructions on appeal nearly 40% of the time. Kimberly A. Moore, *Markman Eight Years Later: Is Claim Construction More Predictable?*, 9 LEWIS & CLARK L. REV. 231, 239 (2005). Given this high reversal rate and the Federal Circuit’s rule that patent claims are sufficiently definite if they are amenable to construction, the public notice function of the Section 112, ¶ 2 is practically non-existent under the amenable-to-construction standard.

supposedly defines and figuratively surrounds a claimed invention. Instead, we might spend some time figuring out how to support the PTO in requiring that the walls surrounding the claimed invention be made of something other than quicksand.

Id. at 1349.

C. The Federal Circuit's Decision In This Case Is In Direct Conflict With Its Prior Decisions In *Honeywell* And *Halliburton*

In this case, the Federal Circuit applied the amenable-to-construction standard, derogated the public notice function, further deepened the split within the Federal Circuit, and further departed from this Court's principles and the statutory language in the Patent Act. The Federal Circuit should have applied *Honeywell* and *Halliburton* and affirmed the trial court's judgment that the Wellman patents are invalid.

Honeywell is virtually identical to this case. There, the Federal Circuit invalidated a patent because the claimed process for making PET yarn was defined in terms of a particular measured value. 341 F.3d at 1339-40. Just as in this case, it was undisputed that the test results in *Honeywell* varied if different sample preparation methods were used. *Id.* at 1341. Because, like in this case, the intrinsic record gave no guidance as to which sample preparation method should be used, the claim was indefinite:

[T]he claims, the written description, and the prosecution history fail to give us, as the interpreter of the claim term, any guidance as to what one of ordinary skill in the art would interpret

the claim to require. Moreover, because the sample preparation method is critical to discerning whether a PET yarn has been produced by the claimed process, knowing the proper sample preparation method is necessary to practice the invention.

Id. at 1340.

In this case, however, the Federal Circuit rejected application of its earlier decision in *Honeywell*, calling it “inapposite.” Pet.App.25a. Instead, the court found that because “the well-known practice in this field” was supposedly to look to ISO 291 (notwithstanding that protocol’s complete absence from the record before the trial court), one of skill in the art would know what conditioning protocol to use. *Id.* at 26a. Moreover, the court ignored that there are many possible protocols known in the art that a skilled artisan might chose when preparing a PET sample to test for T_{CH} , *Id.* at 57a, and the Wellman patents fail to disclose which method to use.

These decisions cannot be reconciled. In *Honeywell*, the case involved PET polymers; the patents failed to disclose sample preparation methods for DSC testing of the PET; and the Federal Circuit held that the claims were *indefinite*. In this case, the polymer at issue is the same, PET; the Wellman patents failed to disclose sample preparation methods for DSC testing of the PET; and the Federal Circuit held that the claims were sufficiently *definite*.

The Federal Circuit’s decision in *Halliburton* also compels a different result in this case. There, the invention involved “fragile gel” drilling fluids. The trial court held the claims indefinite because a skilled artisan could not understand whether a process would

infringe the “fragile gel” limitation. 514 F.3d at 1251. The Federal Circuit found that while the patentee had articulated a definition, a skilled artisan could not translate that definition into a meaningfully precise claim scope. *Id.* Although the patent disclosed test methods to evaluate the accused gels, the Federal Circuit held that patents did not sufficiently disclose what was needed to determine infringement:

Halliburton argues that a person of ordinary skill would know how to measure the quantity of drill cuttings suspended in a fluid (either through laboratory measurements or in the field for example by measuring weight (or density) of the fluid when entering the borehole and when exiting the borehole), and would also know how to determine when the fluid no longer exhibited the L-shaped curve behavior when tested with a Brookfield viscometer. The fact that an artisan would know how to perform these measurements and tests, however, says nothing about whether the artisan would also know which fluids were “fragile gels” as that term is used in the claims of the ‘832 patent.

Id. at 1254.

The Federal Circuit’s decision in this case is squarely at odds with *Halliburton*. In *Halliburton*, there was no question that a skilled artisan could perform a test using a Brookfield viscometer as described in the patent. In this case, there is no question that a skilled artisan would know how to run a test for T_{CH} by DSC scan. The point in both cases, however, is that neither the *Halliburton* patent nor the Wellman patents give the skilled artisan enough information to run the appropriate test so that he

will obtain meaningful results. As in *Halliburton*, one might be able to identify possible testing protocols, but that knowledge, without specific guidance from the patents, is insufficient to determine infringement.

And as in *Honeywell*, it is critical to know which sample preparation method to use because T_{CH} will vary depending upon the method employed. By applying the amenable-to-construction rule, the Federal Circuit's decision directly splits with *Honeywell* and *Halliburton* and further exacerbates the conflict in the law within the Federal Circuit.

D. The Federal Circuit's Amenable-To-Construction Rule Conflicts With Other Circuit Court Decisions And The Plain Language Of The Statute.

The Federal Circuit's amenable-to-construction standard also conflicts with decisions of the regional Circuit Courts of Appeals.⁴ Consistent with this Court's precedents, the Third Circuit emphasized the

⁴ The Federal Circuit's nationwide patent jurisdiction does not render this circuit split inert or irrelevant, because the regional circuits continue to decide issues of patent law in some cases, such as where patent issues are raised in counterclaims under *Holmes Grp., Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826, 834 (2002). Justice Stevens's separate opinion in *Holmes Group* specifically noted that because "other circuits will have some role to play in the development of" patent law, "[a]n occasional conflict in decisions [could] be useful in identifying questions that merit this Court's attention." *Id.* at 839 (Stevens, J., concurring in part and concurring in the judgment). *See also Christianson v. Colt Indus. Operating Corp.*, 486 U.S. 800, 809-10 (1988) (holding that regional circuits may be called upon to rule on issues of patent law when they are part of one of multiple theories supporting a claim for relief).

public notice function of the definiteness requirement:

The definiteness requirement is more than a linguistic quibble, however. Its purpose is to demarcate the boundaries of the purported invention, in order to provide notice to others of the limits “beyond which experimentation and invention are undertaken at the risk of infringement.... The definiteness requirement shapes the future conduct of persons other than the inventor, by insisting that they receive notice of the scope of the patented device.

Rengo Co. v. Molins Mach. Co., 657 F.2d 535, 551 (3d Cir. 1981); *see also Ellipse Corp. v. Ford Motor Co.*, 452 F.2d 163, 170 (7th Cir. 1971) (“Ambiguous, indefinite and vague patent claims are void. The purposes for the precision requirements are to warn others skilled in the art against infringement, and to enable them to benefit from the teachings of the patent.”).

The Third Circuit is exactly right. Definiteness is much more than “a linguistic quibble.” But, the Federal Circuit’s amenable-to-construction standard reduces the inquiry to just such a linguistic exercise that completely undermines real purpose of ensuring that the public has notice of the scope of the patent right.

Applying a standard that supports the public notice function, the Circuit Courts of Appeal have not hesitated to strike down patent claims that failed to apprise the public of the scope of the claimed invention. In *Antonious v. ProGroup, Inc.*, the Sixth Circuit found that the patentee’s failure to recite in the claims the location of the flexible Velcro fastener on the claimed athletic glove was fatal to the patent’s

validity. 699 F.2d 337, 340 (6th Cir. 1983). Because the inventor failed to “clearly set forth the area over which he seeks exclusive rights,” the patent was invalid. *Id.* Similarly, the Second Circuit invalidated a patent because “[t]he claim descriptions, even when considered in the light of the diagrams and the full testimony below, fail[ed] to inform the public as to what may or may not be manufactured.” *Norton Co. v. Bendix Corp.*, 449 F.2d 553, 557 (2d Cir. 1971). And the Seventh Circuit invalidated patent claims when the patent failed to give the public sufficient information to avoid infringement. *Deep Welding, Inc. v. Sciaky Bros., Inc.*, 417 F.2d 1227, 1241 (7th Cir. 1969) (“The precision required [by the definiteness requirement] must also be such as would put on notice all those working in the crowded art so that they do not infringe on the patented process.”).

The Federal Circuit’s amenable-to-construction standard also conflicts with the plain language of the statute. Section 112, ¶ 2 requires that a patent’s claims “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” This “statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise.” *United Carbon*, 317 U.S. at 236. In this case, as in others, the Federal Circuit replaced this clear, statutory mandate with an ineffective standard that fails to ensure that patent claims are clear and unambiguous and leaves the public with no guidance whatsoever as to the boundaries of the claims. This Court’s intervention is necessary to clarify the standard for indefiniteness

and effectuate the statutory mandate.

II. THIS CASE PRESENTS AN IMPORTANT AND RECURRING ISSUE

A. This Case Presents An Important Issue

Allowing uncertain claim language undermines the patent system's fundamental goal of encouraging innovation. *United Carbon*, 317 U.S. at 236 (requiring definite claim language avoids creating a "zone of uncertainty" around patent rights that can discourage innovation). The Federal Circuit's amenable-to-construction standard does not require precise and distinct claims. Under this line of cases, claim terms are "insolubly ambiguous," and thus indefinite, "only if they provide no guidance to those skilled in the art as to the scope of" invention. *Power-One, Inc. v. Artesyn Techs., Inc.*, 599 F.3d 1343, 1348 (Fed. Cir. 2010). As Judge Plager explained, regardless of what notice is provided to the public, a claim will be held definite "if a person of ordinary skill in the art can come up with a plausible meaning for a disputed claim term." *Enzo*, 605 F.3d at 1348.

The Federal Circuit's amenable-to-construction standard subverts the statutory notice function of Section 112, ¶ 2. In a recent law review article, Judge Plager urged that this standard should be rejected:

One consequence of this particular reading of the statute is that it removes a significant impetus for clearer claim drafting, thus reinforcing the system's tolerance for uncertainty in the claims. In addition, and importantly for the court, it opens the way for claim interpretation cases to come to the court in which the claims at issue are

so ambiguous that there are a variety of possible understandings; yet, because some conclusion about meaning is possible, the claim falls short of being “not amenable to construction.”

S. Jay Plager, *The Federal Circuit As An Institution: On Uncertainty And Policy Levers*, 43 LOY. L.A. L. REV. 749, 759 (2010). *See also Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 653 F.3d 1296, 1311 (Fed. Cir. 2011) (Plager, J., concurring) (“I have written elsewhere about the curse of indefinite and ambiguous claims, divorced from the written description, that we regularly are asked to construe, and the need for more stringent rules to control the curse.”).

The “curse” Judge Plager writes about is further exacerbated when NPEs, whose business model involves the assertion of patents against typically high-technology companies, seek to enforce broad and ambiguous patent claims by twisting their meaning to try to read them on profitable commercialized technology. Chien, 87 N.C. L. REV. at 1580; John R. Allison, Mark A. Lemley, and Joshua Walker, *Patent Quality And Settlement Among Repeat Patent Litigants*, 99 GEO. L.J. 677, 692-94 (2011) (citing recent empirical evidence that the vast majority of the most litigated patents—the ones that involve the most suits against the most defendants—are filed by NPE’s targeting an entire industry).

The mischief caused by such lawsuits is real and concrete. Recently, Yahoo!, Inc. submitted an amicus brief supporting Applera’s bid for certiorari on this same issue. In that brief, Yahoo! discussed its experience as a target of NPEs bringing patent infringement suits, and explained that it has raised the defense of indefiniteness against those who would as-

sert patents that, on their face, seem to have no applicability to the products and services against which they are asserted. Brief for Yahoo!, Inc. as *Amicus Curiae* Supporting Petitioners at 13, *Applera Corp. v. Enzo Biochem, Inc.*, No. 10-426 (Oct. 28, 2010).

Without a strong and predictable definiteness standard, NPEs will be able to continue to assert broad and vague claims against commercially-valuable innovations. And, in all events, the public will not have reliable notice of the scope of patent rights in order to avoid infringement that is contemplated by the definiteness requirement.

B. The Issue Will Continue To Recur Unless This Court Intervenes

The Federal Circuit had the opportunity to correct the inconsistency in the law, but notwithstanding the direct conflict with its prior precedents, it declined to rehear this case. In fact, in the last two years, the Federal Circuit has received at least four petitions for rehearing en banc asking the court to reconsider the proper standard for indefiniteness. *See Enzo*, 605 F.3d at 1347 (petition denied May 26, 2010); *Telcordia Techs. Inc. v. Cisco Sys. Inc.*, No. 2009-1175 (petition denied Oct. 6, 2010); *Wellman, Inc. v. Eastman Chem. Co.*, No. 2010-1249 (petition denied Aug. 11, 2011); *Star Scientific, Inc. v. R. J. Reynolds Tobacco Co.*, No. 2010-1183 (petition filed Sept. 26, 2011, pending). The Federal Circuit's continued rejection of these petitions shows that it will not likely resolve this conflict without this Court's intervention.

Moreover, this case is not an isolated incident. Indefiniteness challenges are mounted in patent infringement cases with increasing frequency. Christa J. Laser, *A Definite Claim On Claim Indefiniteness:*

An Empirical Study Of Definiteness Cases Of The Past Decade With A Focus On The Federal Circuit And The Insolubly Ambiguous Standard, 10 CHI.-KENT J. INTELL. PROP. 25 (2010) (showing increase in the number of cases from 1998-2008 in which patent validity was challenged on indefiniteness grounds). A recent search of the Docket Navigator database showed that the district courts collectively issued 27 summary judgment rulings involving indefiniteness in 2010, and another 14 rulings thus far in 2011. Indeed, because indefiniteness is an issue in so many patent infringement cases, some of the district court judges in the Eastern District of Texas have incorporated a deadline for bringing indefiniteness challenges into their standard scheduling orders as part of the claim construction process.⁵ Even before this recent uptick in cases involving indefiniteness issues, the Federal Circuit issued 17 decisions involving indefiniteness in the period from 2006 to 2008, and it issued nearly 50 such decisions in the decade from 1998 to 2008. *Laser*, 10 CHI.-KENT J. INTELL. PROP. at 30.

⁵ See, e.g., Judge Davis' standard Docket Control Order for patent cases, http://www.txed.uscourts.gov/cgi-bin/view_document.cgi?document=2192, last visited Nov. 3, 2011; Judge Schneider's standard Joint Discovery/Case Management Plan for Patent Infringement Cases, http://www.txed.uscourts.gov/cgi-bin/view_document.cgi?document=19900 (last visited Oct. 25, 2011).

III. THIS CASE PRESENTS AN EXCELLENT VEHICLE FOR ADDRESSING THE STANDARD FOR INDEFINITENESS AND THE FEDERAL CIRCUIT'S ERRONEOUS RULING IN THIS CASE ILLUSTRATES THE PRACTICAL DIFFICULTIES CREATED BY THE AMENABLE-TO-CONSTRUCTION STANDARD

The factual context of this case presents an excellent vehicle for this Court to clarify the law of indefiniteness. Here, there is no real dispute that the Wellman patents fail to disclose the sample preparation methods that one should use to determine if a PET sample falls within the scope of the claims. If, as the district court did, the *Honeywell/Halliburton* rule is applied, the claims are invalid for failing to satisfy the definiteness requirement. However, when the amenable-to-construction rule was applied by the Federal Circuit below, the court held that the ambiguous claims in the Wellman patents survive scrutiny because the court found that it was possible to articulate a construction for the claim terms in the Wellman patents, even though that construction is not meaningful to one of skill in the art. The dispositive contrast in the outcome depending upon which rule is applied makes this case an ideal context for this Court to review the issue.

Moreover, the factual context of this case and the Federal Circuit's erroneous analysis of the Wellman patents illustrates the problems that arise when the amenable-to-construction standard is applied. In this case, the Federal Circuit focused its attention solely on trying to construe the claims, to the exclusion of giving any attention the practical ramifications of

that construction. The court upheld the claims, even though the Wellman patents fail to give the skilled artisan sufficient guidance to determine what infringes the claims. This is contrary to the public notice function of the definiteness requirement.

A. In Applying The Amenable-To-Construction Rule, The Federal Circuit Adopted A Claim Construction Divorced From The Intrinsic Record And That Misconstrued The Technology At Issue

Although the patents set out a four-step procedure for testing T_{CH} in the PET samples, that four-step procedure is devoid of guidance for addressing the thermal history or orientation of the sample. To overcome this deficiency, the Federal Circuit was forced to engage in a cascading series of unsupported departures from the intrinsic record in its attempt to provide meaning to the otherwise indefinite patent claims.

First, the Federal Circuit read a requirement into the claims from the specification that the claimed PET be “amorphous.” Then, the Federal Circuit assumed, without any support from the intrinsic record, that amorphous PET is in the same physical state as PET with its thermal history removed. Pet.App.26a-27a. Based on that definition, the court of appeals reasoned that “an amorphous PET material will produce equivalent DSC results regardless of whether one uses a four-step ‘first scan’ protocol or six-step ‘second scan’ protocol.” *Id.*

But this is directly contradicted by the science. “Amorphous” PET is *not* the same as PET having no thermal history, as the prior art of record plainly demonstrated. Pet.App.247a-248a. Wellman tested

the accused products, which Wellman argued fit its definition of “amorphous,” and found that T_{CH} varied by over 50 degrees, depending on whether a first or second scan was performed:

T_{CH} from First Scan	T_{CH} from Second Scan
100.73° C	156.07° C
97.95° C	156.22° C
100.42° C	153.26° C
100.73° C	152.76° C

Pet.App.274a-289a. These differences in T_{CH} occurred because even though the samples were “amorphous,” they nonetheless had thermal history that was removed by the first scan.

The Federal Circuit dismissed this issue, concluding that “if an amorphous PET material had some orientation due to its thermal history, a person of skill in the art would know to use second scan results to resolve the concern in accordance with industry practice.” Pet.App.27a-28a. This conclusion directly contradicts the teachings in the patents, however, which instruct the skilled artisan to use the four-step, single-scan method. Thus, instead of relying on the intrinsic record, the Federal Circuit resorted to methods that are not only *not* disclosed in the patents, but are, in fact, methods from which the patents teach away.

Second, by reading the amorphous limitation into the claims, the Federal Circuit’s construction is directly contradicted by the patents. The Federal Circuit construed “amorphous” to mean that a sample of PET has “less than about 4% crystallinity,” where crystallinity describes the extent that the strands of

polymer that make up PET are arranged into a crystalline lattice. The patents describe several samples of PET as being “amorphous,” and provide DSC scans for each of those samples. Pet.App.95a-96a. Using Wellman’s own formula for calculating the amount of crystallinity in these samples, however, the data shows that each of the samples has a crystallinity of greater than 4% and, therefore, *none* of the examples in the patents actually satisfies the definition adopted by the Federal Circuit:

Figure	Calculated Crystallinity
1	6.3%
3	8.8%
5	4.4%
7	7.8%

Pet.App.292a.

The Federal Circuit’s construction thus cannot be reconciled with the intrinsic record, and the intellectual gymnastics required to reach a construction illustrate the problem with the amenable-to-construction standard. By resorting to analytical contortions to sustain the validity of the claims, the Federal Circuit eviscerated the public notice function of the definiteness requirement.

B. The Federal Circuit Also Erred By Reaching Outside The Record To Adopt A Method For Moisture Conditioning That Is Not Disclosed In The Patents

The lengths the Federal Circuit went to find an applicable moisture conditioning protocol further illustrate the problems with the amenable-to-construction standard. The Wellman patents do not

disclose moisture conditions to prepare the sample for testing. The Federal Circuit bridged this omission in the patents' disclosure by reaching outside the trial court record and adopting ISO 291 as purportedly the sole protocol that one of ordinary skill in the art would consult to determine the proper sample preparation. Pet.App.24a.⁶

The Federal Circuit's analysis was fundamentally flawed, however, because ISO 291 was not in the trial court record, and in all events, there was no evidence in the record before either the district court or the Federal Circuit suggesting that ISO 291 would be the sole protocol that one of ordinary skill would consult to determine an appropriate method for moisture conditioning. The reference to ISO 291 in ISO 11357-1 (which the court of appeals also relied upon) states just the opposite: ISO 11357-1 provides that one *may* use ISO 291 conditions. Pet.App.24a. *Cf. Halliburton*, 514 F.3d at 1254. There is nothing in the Wellman patents that tells the public to use ISO 291 conditions to the exclusion of any others. Indeed, Wellman litigated this case for nearly three years before ever raising ISO 291, which it did for the first time before the Federal Circuit. Only now, after the Wellman patents have been litigated before a trial court and through appeal has the public been in-

⁶ Significantly, Wellman had every opportunity to submit evidence of "typical" moisture conditions. Wellman offered a late expert declaration describing allegedly typical moisture conditions, but the trial court struck it as untimely. Pet.App.55a. On appeal, Wellman tried to introduce different evidence of "typical" moisture conditions, arguing for the first time that ISO 291 defines such conditions. This argument was plainly waived below and should not have been considered by the Federal Circuit.

formed that ISO 291 contains a protocol to moisture condition the PET samples. This public-notice-by-court-decision approach is completely contrary to the public notice function and statutory language of Section 112, ¶ 2, and if allowed to stand, upsets the ordinary workings of patent law.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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