

No. 11-_____

IN THE
Supreme Court of the United States

R. J. REYNOLDS TOBACCO COMPANY (A NORTH CAROLINA CORPORATION) AND R. J. REYNOLDS TOBACCO COMPANY (A NEW JERSEY CORPORATION),

Petitioners,

v.

STAR SCIENTIFIC, 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

The Patent Act requires that a patent application include claims “particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112 ¶ 2. This Court has made clear that this definiteness requirement demands that a valid patent inform the public during the life of the patent of the limits of the monopoly asserted—that is, what may be safely used or manufactured without a license. Such practical notice of the patent’s claim limits is necessary, *inter alia*, to avoid chilling the inventive creativity of others.

In recent years, the Federal Circuit has adopted a definiteness standard demanding only that patent claims not be “insolubly ambiguous,” which test it has often found satisfied if the claims are “amenable to construction,” however difficult the task or debatable the result. The question presented is:

Whether the Federal Circuit’s insolubly ambiguous/amenable-to-construction test for patent definiteness, which upholds patents whose construed claims fail to inform a skilled artisan of the outer limits of the claimed monopoly, faithfully implements § 112 ¶ 2 as interpreted by the decisions of this Court.

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

The parties to the proceeding below were Petitioners R. J. Reynolds Tobacco Company (a North Carolina Corporation), R. J. Reynolds Tobacco Company (a New Jersey Corporation) (collectively, “Reynolds”), and Star Scientific, Inc. (“Star”). The Respondent, R. J. Reynolds Tobacco Company (a North Carolina Corporation), is successor by merger of R. J. Reynolds Tobacco Company (a New Jersey Corporation), which ceased to exist as of July 30, 2004.

Petitioner R. J. Reynolds Tobacco Company is directly and wholly owned by R. J. Reynolds Tobacco Holdings, Inc. (a Delaware Corporation). R. J. Reynolds Tobacco Holdings, Inc. is a wholly-owned subsidiary of Reynolds American Inc., a publicly traded corporation. Brown & Williamson Holdings, Inc. owns more than 10% of the common stock of Reynolds American Inc. and is an indirect, wholly-owned subsidiary of British American Tobacco, plc., a publicly traded corporation.

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PETITION FOR A WRIT OF CERTIORARI

The indefiniteness provision of the Patent Act requires that a patent application include 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 Court has long viewed these words as central to the bargain struck under the patent laws, by which a temporary monopoly is conferred in exchange for the inventor’s making certain disclosures.

Specifically, the inventor must “inform the public during the life of the patent” not only how to replicate the invention, but also “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). Thus, patent claims must be sufficiently clear to differentiate the claimed invention from the prior art. *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942). This notice to skilled artisans is necessary to avoid chilling “the inventive genius of others,” *id.*, because “[uncertainty] about a patent’s extent, may ... deter[] ... legitimate manufactures.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 732 (2002) (internal quotes omitted).

Notwithstanding the clarity and consistency of this Court’s decisions, in recent years, the Federal Circuit has developed its own standard of indefiniteness, which has proven to be much less demanding. That test requires only that patent claims not be “insolubly ambiguous,” and inquires whether the patent claims are “amenable to construction” by a court.

After invoking that test, the court below upheld as definite patents for a claimed method of curing tobacco, which requires a “controlled environment” to substantially eliminate the production of potentially carcinogenic chemicals called tobacco-specific nitrosamines (“TSNAs”). It so ruled, even though the claimed “controlled environment” was defined, following claim construction, simply as “controlling ... humidity, temperature and airflow in the curing barn, in a manner different from conventional curing,” while “conventional curing” is defined in the patents as “air-cur[ing] or flue-cur[ing], without the controlled conditions described herein, according to conventional methods commonly and commercially used in the U.S.” Pet.App.30a; JA167.¹

The obvious problem with this approach is that nowhere in the Star patents are the details of either the so-called “controlled environment” or “conventional methods” described. This complete circularity in defining both the “controlled environment” and the prior art “conventional curing” by reference to the absence of the other, with no affirmative disclosure of what either entails, makes it impossible to determine where one ends and the other begins. Indeed, at trial, no witness was able to explain what constitutes “conventional methods” or the claimed “controlled environment,” or how to distinguish between the two. JA46543-45; JA45681 (Star expert’s acknowledging that he “was not the guy to call on” to describe to a skilled artisan whether or not he was practicing the claimed invention).

¹ The JA cites refer to the Joint Appendix filed with the Federal Circuit in Appeal No. 2010-1183.

The seemingly fatal fact that the patents here do not “inform skilled artisans of the bounds of the claims,” Pet.App.32a (Dyk, J., dissenting), posed no obstacle to the decision below. That is because the Federal Circuit’s “insolubly ambiguous/amenable-to-construction” test led that court to focus not on whether the patent claims afford actual notice to the skilled artisan of their outer limits, as this Court has directed, but instead on whether a court can somehow give them some meaning, however tortuous and uncertain the path.

With this test as its guide, it is hardly surprising that the Federal Circuit has repeatedly upheld against indefiniteness challenge patents that do not provide skilled artisans with reasonable notice of claim scope, as this Court has many times ruled is essential. To make matters worse, as discussed below, *see infra*, notes 4 and 6, the Federal Circuit’s application of its standard has been inconsistent and unpredictable.

This Court should grant review and reaffirm that this Court’s earlier cases set forth the appropriate standard for determining the issue of patent indefiniteness.

OPINIONS BELOW

The opinion of the court of appeals from which this petition is taken (Pet.App.2a-32a) is reported at 655 F.3d 1364. The district court’s opinion addressing plaintiff’s post-trial motions (Pet.App.33a-39a) is unreported.

The opinion of the court of appeals on the first appeal (Pet.App.40a-69a) is reported at 537 F.3d 1357. The district court’s January 19, 2007, opinion grant-

ing summary judgment for Reynolds based on indefiniteness (Pet.App.70a-82a) is unreported.

JURISDICTION

The district court had jurisdiction under 28 U.S.C. §§ 1331 and 1338(a). The United States Court of Appeals for the Federal Circuit had appellate jurisdiction under 28 U.S.C. § 1295(a)(1). The court of appeals entered its judgment and opinion on August 26, 2011, and denied Reynolds's petition for rehearing or rehearing en banc on November 29, 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. Statutory Background

The Constitution grants Congress 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.” U.S. Const. art. I, § 8, cl. 8. “[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). To that end, Congress has enacted laws that mandate complete, clear, and precise descriptions of inventions. *See generally* 35 U.S.C. §§ 111, 112.

In particular, each patent application must include a “specification,” 35 U.S.C. § 111(a)(2)(A), that “contain[s] 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. In addition to these “enablement” and “best mode” requirements, 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.

These requirements of Section 112 demand disclosure of each process or device “in sufficient detail to enable one skilled in the art to practice the invention ... and the same precision of disclosure is likewise essential to warn the industry concerned of the precise scope of the monopoly asserted.” *Universal Oil Prods. Co. v. Globe Oil & Ref. Co.*, 322 U.S. 471, 484 (1944).

While the specification describes the invention in detail, the claims define its legal scope. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373 (1996). Patent claims must therefore be drafted clearly and precisely so that the public can understand the boundaries of the invention and avoid infringement. *See, e.g., Gen. Elec.*, 304 U.S. at 369.

Once issued by the United States Patent and Trademark Office, a patent is presumed valid, 35

U.S.C. § 282, absent a showing that it does not comply with the Patent Act. As pertinent here, if a patent claim does not “particularly point[] out and distinctly claim[] the subject matter” of the invention, then it is invalid as indefinite. 35 U.S.C. § 112, ¶ 2.

B. Factual And Procedural Background

A. Tobacco may be cured in several different ways. In “air curing,” tobacco is exposed to unheated, ambient air in a curing barn, Pet.App.3a, and barn dampers are used to vary humidity and temperature. The tobacco is thus dried while being exposed to prevailing weather conditions. Pet.App.3a; JA45948. In “flue curing,” tobacco is dried in a curing barn using diesel or propane gas heaters that heat the air and the tobacco within the barn. Pet.App.3a.

Until the 1970s, most flue curing in the United States occurred using indirect-fired barns, in which the air and tobacco are heated by heat exchangers, preventing the combustion exhaust gases released by the burning fuel from contacting the tobacco being cured. Pet.App.3a; JA63151. During the 1970s, in an effort to save money, many tobacco farmers switched from indirect-fired barns to less expensive direct-fired barns, in which the residual heat of propane combustion exhaust gases heats the tobacco and the surrounding air. This results in the tobacco being exposed to the combustion exhaust gases during curing. Pet.App.3a; JA45671-72, JA45937-38, JA63151, JA45968-69.

In the 1980s, researchers recognized that TSNAs were being formed in tobacco during the tobacco-curing processes. Pet.App.3a; JA46254, JA47284-85, JA60616. During the late 1990s, while trying to find ways to prevent TSNA formation, Dr. David Peele, a

researcher employed by Reynolds, discovered that exhaust gases contacting the tobacco in direct-fired barns contribute to the formation of TSNAs. Reynolds applied for and was awarded patent protection for Peele's work. Pet.App.6a. Following Peele's invention, tobacco farmers in the United States began to retrofit their direct-fired barns with heat exchangers, returning to the pre-1970s indirect-fired tobacco-curing methods. Pet.App.6a-7a.

B. On May 23, 2001, in a complaint filed in the United States District Court for the District of Maryland, Star sued Reynolds, alleging infringement of two patents, United States Patent No. 6,202,649 and No. 6,425,401 (collectively, "the Star patents"). Pet.App.7a; JA197-220, JA44823-44850. The patents claim methods for substantially preventing formation of TSNAs, and recite a method for drying uncured tobacco in a "controlled environment" so as "to substantially prevent the formation of said at least one nitrosamine." JA174.

The district court adopted Star's proposed construction of the claim term "controlled environment" as "controlling one or more of humidity, temperature and airflow in the curing barn in a manner different from conventional curing, in order to substantially prevent the formation of TSNAs." Pet.App.16a. The district court further construed the phrase "substantially prevent the formation of at least one [TSNA]" to mean "the level of at least one of the nitrosamines falls within the following ranges: less than about 0.05 $\mu\text{g/g}$ [or parts per million] for NNN, less than about 0.10 $\mu\text{g/g}$ for NAT plus NAG, and less than about 0.05 $\mu\text{g/g}$ for NNK." Pet.App.49a.

There is no dispute that a skilled artisan would know how to test to determine the amount and presence of these specific TSNA's in the final cured tobacco product. But neither the specification nor claims of the Star patents indicate how to create a "controlled environment" to cure tobacco in accordance with the claimed method. The patents do not describe any particular equipment or technique to be used. Nor do they distinguish quantitatively the humidity, temperature, and airflow of the claimed "controlled environment" from those parameters as used in prior art, "conventional curing" processes. Pet.App.32a. Indeed, the patents define "conventional curing," from which the invention is to be distinguished, only in a wholly circular manner, as "air-cur[ing] or flue-cur[ing], without the controlled conditions described herein, according to conventional methods commonly and commercially used in the U.S." Pet.App.30a, Pet.App.32a; JA167.

C. On January 19, 2007, the district court granted summary judgment that the patents-in-suit were invalid for indefiniteness. That decision was made final in June, 2007. In granting summary judgment, the district court found that the patents failed to define the boundaries of the patented method:

[T]he essential problem with the claims is that no one—certainly not one of ordinary skill in the art—reading the Patents-in-suit would be able to carry out the invention. That is, the skilled artisan would not be able to know, in advance, whether a particular curing operation would infringe.

The Patents-in-Suit do not teach how to control the environment to prevent an anaerobic condition that will substantially prevent the formation of a nitrosamine. The only way to ascertain whether a curing operation process would infringe is to examine the result and, if successful in reducing TSNA production, then the operation would have infringed.

Pet.App.73a-74a.

Star appealed the trial court's decision, and on August 25, 2008, the Federal Circuit reversed on multiple grounds, finding, as to indefiniteness, that the claim term "anaerobic condition" was not indefinite because a skilled artisan would be able to understand the meaning of those terms. Pet.App.65a-67a. The Federal Circuit further explained that it was reversing the lower court because "[t]he district court's contrary conclusion was based on its misunderstanding that claim definiteness requires that a potential infringer be able to determine if a process infringes *before* practicing the claimed process." Pet.App.67a. (emphasis in original). The Federal Circuit remanded the case for further proceedings on the infringement complaint consistent with its opinion. Pet.App.68a-69a.

Reynolds filed a petition seeking panel rehearing and rehearing en banc, which was denied on October 22, 2008, and a petition for a writ of certiorari in this Court, which was denied on March 9, 2009.²

² The petition for certiorari, *R. J. Reynolds Tobacco Co. v. Star Scientific, Inc.*, No. 08-918, dealt with the issue of inequitable conduct. The district court had also held a bench trial on the issue of inequitable conduct, and issued written findings that

D. On May 9, 2009, Star brought a second lawsuit, accusing Reynolds of infringing the same patents during other tobacco-growing seasons. *See Star Scientific, Inc. v. R. J. Reynolds Tobacco Co.*, No. 8:09-cv-01411-MJG (D. Md.). That suit is presently pending in district court.

E. On remand in the present action, the district court held a trial on the issues of infringement and validity. At trial, Reynolds's technical expert, Lambert Otten, testified that the Star patents do not provide any information, numerical or otherwise, to instruct a skilled artisan how to control humidity, temperature, and airflow to create the "controlled environment" claimed in the patents. JA46658. He testified that one of ordinary skill in the art could not distinguish between the "controlled environment" claimed in the patents and conventional curing processes. JA46545. He further testified that the patents do not provide any guidance about how to control humidity, temperature and airflow to substantially prevent the formation of TSNAs. JA46545.

The testimony from Star's trial witnesses, including named-inventor Jonnie Williams and expert James Sturgill, was consistent with the testimony from Reynolds's expert. Neither Williams nor Sturgill could distinguish the "somewhat" controlled environment of conventional processes not included in the patent from the claimed "controlled environment."

the patents-in-suit were unenforceable because the applicant engaged in inequitable conduct before the Patent Office. The Federal Circuit reversed this finding in the first appeal of this case.

Pet.App.32a; Pet.App.79a-80a; JA45442; JA45680-81; JA45434-36. Mr. Sturgill could not explain how a tobacco farmer could know whether or not he was practicing the claimed “controlled environment,” and acknowledged that he was “not the guy to call on” for this information. Pet.App.32a; Pet.App.79a-80a; JA45680-81.

The jury found (1) that Star had failed to prove infringement and (2) that Reynolds had proved by clear and convincing evidence that the patents-in-suit were invalid on four grounds, including indefiniteness. Star moved for judgment as a matter of law or a new trial. On December 21, 2009, The district court denied Star’s post-trial motions. Pet.App.39a.

F. Star again appealed the trial court’s decision, including the issue of indefiniteness. On August 26, 2011, the Federal Circuit affirmed the jury’s verdict that Reynolds did not infringe the patents-in-suit and affirmed the district court’s denial of Star’s motion for a new trial. However, the court reversed the jury verdict of patent invalidity, based on indefiniteness and three other grounds, and thus reinstated the patents that are the basis of a separate suit against Reynolds pending in district court.

As to indefiniteness of the claim term “controlled environment,” the majority ruled that it would only be indefinite if it was “‘not amenable to construction’ or ‘insolubly ambiguous,’” Pet.App.16a, and noted that the district court had in fact construed that term. *Id.* Thus, it stated, “[h]ere, indefiniteness requires a showing that a person of ordinary skill would find ‘controlled environment’ to be insolubly ambiguous.” *Id.* at 17a.

The court then found no insoluble ambiguity, stating that a person of reasonable skill would “recognize” a “controlled environment,” even though the patent did “not give exact numbers measuring humidity, temperature, and airflow in a conventional curing barn.” *Id.* at 17a. It supported this conclusion by quoting a statement in the Star ‘649 patent that “the practice of tobacco curing is more of an art than a science,” and misquoting the patent as saying that “the controlled conditions described herein [are] according to conventional methods commonly and commercially used in the U.S.” *Id.* at 17a-18a. The court further concluded that because “[t]he manner [in] which Virginia tobacco is grown, harvested, and processed is well known,” and “the record demonstrates that tobacco curing variables are well known in the tobacco industry,” “this term is not insolubly ambiguous and is not indefinite.” *Id.* at 18a.

Judge Dyk dissented. He pointed out that the patents facially differentiate between the “controlled environment” claimed in the patents and conditions achieved by means of conventional curing methods: “[F]ar from equating the claimed ‘controlled environment’ to conventional curing, the patents make clear that conventional curing is conducted ‘*without* the controlled conditions described herein.” *Id.* at 30a (emphasis in original). But, he noted, the expert testimony showed that “a person of ordinary skill in art would be unable to draw the line between conventional curing methods and the ‘controlled environment’ required by the claims. ... [T]he patents do not provide sufficient guidance for one of skill in the art to determine the ranges of temperature, humidity, and airflow ‘covered by the [term] controlled envi-

ronment that are also not covered by the conventional curing processes.” *Id.* at 31a-32a. Judge Dyk concluded:

In sum, the patents describe the claimed “controlled environment” as something different from conventional curing methods, but fail to explain those differences in a way that would permit a skilled artisan to determine the bounds of the claims. To add to the confusion, the patents define conventional curing methods as air-curing or flue-curing “without the controlled conditions” required by the claims. Under this court’s established test for definiteness, such circularity is insufficient to inform skilled artisans of the bounds of the claims.

Id. at 32a.

On September 26, 2011, Reynolds filed a petition seeking panel rehearing or rehearing en banc. On November 29, 2011, the Federal Circuit denied Reynolds’s petition. *Id.*

REASONS FOR GRANTING THE WRIT

This Court has repeatedly held that the definiteness requirement ensures that skilled artisans are given clear notice of the content and outer limits of patent claims, so that infringement can be avoided without chilling new innovation. Notwithstanding this Court’s clear and repeated articulation of these requirements, the Federal Circuit has charted a different path. Starting in 2001, that court formulated, and has since applied repeatedly, vague and much less rigorous language which has come to be used as the court’s standard for determining patent definiteness. That language asks whether the patent claims

are “insolubly ambiguous” or “amenable to construction,” noting that “a claim term may be definite even when discerning the meaning is a ‘formidable [task] and the conclusion may be one over which reasonable persons will disagree.” *Id.* at 16a (citation omitted).

This standard does not by its terms address what is properly in issue—whether the patent provides actual notice to a skilled artisan of the invention’s outer limits. As a result, its use over the past decade has produced a significant number of decisions upholding unclear and ambiguous claims as sufficiently definite. The straightforward technology at issue here—involving circulating air to cure tobacco in a barn—and the circularity of the patent’s claims, make it obvious and indisputable that no one can tell where the patented “controlled environment” ends and conventional curing methods begin.

The issue posed by the Federal Circuit’s aberrant standard, as reflected in the decision below, is one of great and increasing importance. Beyond the inability of thousands of tobacco farmers and the companies that purchase their product to know whether they are infringing the Star patents at issue here, the Federal Circuit’s analysis is a source of general uncertainty for the patent system. That uncertainty inhibits innovation and impedes commercialization of useful technologies. Vague patent claims permit litigious patent holders to twist broad patent claims to read upon commercially successful products and processes and to extract license fees that may not be warranted. Moreover, the number of cases involving indefiniteness challenges is increasing.

I. THE FEDERAL CIRCUIT'S INSOLUBLY AMBIGUOUS / AMENABLE-TO-CONSTRUCTION TEST FOR DEFINITENESS CONFLICTS WITH DECISIONS OF THIS COURT AND, IN THIS AND OTHER CASES, HAS FAILED TO ENSURE THAT SKILLED ARTISANS ARE REASONABLY NOTIFIED OF THE BOUNDS OF PATENT CLAIMS

A. This Court's Decisions Have Made Public Notice Of Patent Scope The Touchstone Of Definiteness

1. 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. This ensures that the public can know "which features may be safely used or manufactured without a license and which may not," *Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931). It thus prevents creation of "[a] zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims[, and that] would discourage invention only a little less than unequivocal foreclosure of the field," *United Carbon*, 317 U.S. at 236.

For well over a century, this Court has emphasized that notice to the skilled artisan is the key requirement for definiteness. "[There is] 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.” *Merrill v. Yeomans*, 94 U.S. 568, 573 (1876); *see also Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 437 (1902) (noting that patents are addressed to those skilled in the relevant art); *Minerals Separation, Ltd. v. Hyde*, 242 U.S. 261, 271 (1916) (claims must provide “reasonable certainty” viewed in light of the applicable subject matter). The notice requirement prevents “unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights.” *Gen. Elec.*, 304 U.S. at 369.

Accordingly, this Court has focused on whether the scope—the outer limits—of the invention was fully and clearly disclosed, to allow inventors to innovate while avoiding infringement. Such clarity is indispensable, because “uncertainty” in patent claims deters “legitimate manufactures,” and foments “wasteful litigation” that diverts resources from more productive pursuits. *Festo*, 535 U.S. at 732.

2. Prior to the creation of the Federal Circuit in 1982, the federal courts of appeals faithfully followed this Court’s instructions and equated definiteness with the need to give the skilled artisan clear notice of the patent’s contents and limits. For example, as the Third Circuit stated in 1981:

The definiteness requirement is more than a linguistic quibble 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.

Rengo Co. v. Molins Mach. Co., 657 F.2d 535, 551 (3d Cir. 1981)(internal quotes omitted). *Accord Ellipse*

Corp. v. Ford Motor Co., 452 F.2d 163, 170 (7th Cir. 1971) (“Ambiguous, indefinite and vague patent claims are void. The precision requirements warn others skilled in the art against infringement, and to enable them to benefit from the teachings of the patent.”); *Norton Co. v. Bendix Corp.*, 449 F.2d 553, 557 (2d Cir. 1971) (invalidating patent because “[t]he claim descriptions, even 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.”); *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.”).

**B. The Federal Circuit’s Insolubly Ambiguous/
Amenable-To-Construction Standard,
Formulated In 2001, Deviated From This
Court’s Notice Requirement**

1. For the first nineteen years of its existence, the Federal Circuit also applied a standard that adhered to the decisions of this Court, requiring patent claims to provide the skilled artisan with actual notice of the scope of the invention, when those claims are read in light of the specification. As the court stated in 2001:

The definiteness inquiry focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification.

Union Pac. Res. Co. v. Chesapeake Energy Corp., 236 F.3d 684, 692 (Fed. Cir. 2001). Applying this standard, the court invalidated method claims having a “comparing” step because “comparing’ could undoub-

tedly have [multiple] meanings” and the claim scope would vary depending upon which meaning was applied. *Id.*³

2. In September, 2001, in *Exxon Research & Engineering Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001), the Federal Circuit for the first time utilized language focusing on insoluble ambiguity and amenability to construction in addressing a definiteness challenge. After first discussing indefiniteness in terms of this Court’s oft-repeated requirement of notice of the patent’s scope to skilled artisans, the court proceeded:

³ *Union Pacific* substantially echoes language used by the Federal Circuit from 1982 until 2001, in decisions applying the definiteness requirement. *See, e.g., Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985) (“If the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.” (quoting *Georgia-Pacific Corp. v. U.S. Plywood Corp.*, 258 F.2d 124, 136 (2d Cir. 1958)); *N. Am. Vaccine, Inc. v. Am. Cyanamid Co.*, 7 F.3d 1571, 1579 (Fed. Cir. 1993) (“Whether a claim is invalid for indefiniteness depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification.”); *Process Control Corp. v. Hydrexclaim Corp.*, 190 F.3d 1350, 1358 n.2 (Fed. Cir. 1999). (“The test for whether a claim meets the definiteness requirement is whether one skilled in the art would understand the bounds of the claim when read in light of the specification.”) (internal quotes omitted); *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1378 (Fed. Cir. 1999) (“As a general matter, it is well-established that the determination whether a claim is invalid as indefinite ‘depends on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the specification.’”) (quoting *N. Am. Vaccine*, 7 F.3d at 1579.

We have not insisted that claims be plain on their face in order to avoid condemnation for indefiniteness; rather, *what we have asked is that the claims be amenable to construction, however difficult that task may be. If a claim is insolubly ambiguous*, and no narrowing construction can properly be adopted, *we have held the claim indefinite. 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. ... By finding *claims indefinite only if reasonable efforts at claim construction prove futile*, we accord respect to the statutory presumption of patent validity, and we protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.

Id. (internal citations omitted)(emphasis added).

Since the decision in *Exxon*, the Federal Circuit has consistently invoked the concepts of insoluble ambiguity and amenability to construction as its standard in resolving definiteness challenges. The court has also regularly emphasized *Exxon's* observations that claims should be found indefinite “only if reasonable efforts at claim construction prove futile,” and that such a construction will suffice even if the task is “formidable” and the resulting construction is one about which reasonable people will differ.

The Federal Circuit’s regular reliance on this new concept of definiteness has turned on its head the principle that patent claims are construed against the drafter, who is in the best position to make sure

that the claims are drafted carefully to avoid confusion. *See Merrill*, 94 U.S. at 569 (“No such question could have arisen if appellant had used language which clearly and distinctly points out what it is that he claims in his invention.”).

Claims that are unclear and obtuse have been upheld merely because a Federal Circuit panel is able, with great effort and uncertainty, to construe them.⁴ The court has so held even though construability is not at all synonymous with providing notice to skilled artisans of an invention’s outer boundaries. To the contrary, claims that on their face are inscrutable to skilled artisans, let alone the general public, may well be amenable to construction by a court’s arduous efforts. By construing a claim, the court need only provide a clear core *meaning* of the claim, and even that requirement is hedged by the Federal Circuit’s approval of constructions over which reasonable people will disagree. Nothing in patent law requires that, in order to be valid, a claim construction must itself provide a clear definition of the patent’s *scope*.

The proper test of indefiniteness—whether the claims provide effective notice of the patent’s boundaries or *scope*—is a separate question left unanswered by the fact that some construction of the claims is possible. And if the mere fact that claims can be con-

⁴ The Federal Circuit has not always been clear about the logical relationship between insoluble ambiguity and the requirement of amenability to construction, and has often, but not always, applied the categorical rule that a “claim that is amenable to construction is not invalid on the ground of indefiniteness.” *E.g.*, *Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 1371 (Fed. Cir. 2006). *See infra*, note 6.

strued renders them definite, then this critical question is one that the court need never reach.

3. That is just what has occurred in the decision below, and in numerous other Federal Circuit cases decided since 2001. Without any directive in the oft-recited phrases that make up the insolubly ambiguous/amenable-to-construction standard, the Federal Circuit has repeatedly rejected indefiniteness challenges without any serious consideration of whether the patent puts skilled artisans on reasonable notice of the limits of the claimed monopoly.

In 2002, in *All Dental Prodx, LLC v. Advantage Dental Prods., Inc.*, 309 F.3d 774 (Fed. Cir. 2002), the court reversed a summary judgment of indefiniteness, ruling that “[o]nly after a thorough attempt to understand the meaning of a claim has failed to resolve material ambiguities can one conclude that the claim is invalid for indefiniteness.” *Id.* at 780. The trial court had found no definition in the patent of the claim term, “original identified mass,” and had thus concluded that “a person skilled in the art would not be able to understand the bounds of the claims.” *Id.* at 777. The Federal Circuit, relying on the inventor’s statements during prosecution that “disclaim[ed] a specific shape,” found that “[t]he meaning of the phrase ‘original unidentified mass,’ arrived at after reviewing the specification and consulting the prosecution history, is indeed definite and clear.” *Id.* at 780. By focusing myopically on construability and by defining the claim limitation in terms of what the patentee had *excluded* during prosecution, the Federal Circuit’s construction determined only one attribute that the invention did not have—any “specific preformed size and shape.” *Id.* Its analysis failed entire-

ly to address whether the patent in other respects provided reasonable notice to a skilled artisan of the claims' outer limits or scope.

Similarly, in *Bancorp Services, L.L.C. v. Hartford Life Insurance Co.*, 359 F.3d 1367, 1372 (Fed. Cir.2004), the Federal Circuit invoked the language of *Exxon* to justify reversing the district court's indefiniteness ruling because it was able to "discern" a "meaning" for the claim terms at issue. The court acknowledged that the claim term "surrender value protected investment credits" was not defined in the patent nor in any industry publication. *Id.* at 1371. The court nonetheless reversed the trial court's indefiniteness holding because it was able to piece together a construction on a word-by-word basis, saying that "the components of the term have well-recognized meanings, [and] allow the reader to infer the meaning of the entire phrase with reasonable confidence." *Id.* at 1372. This type of judicial cherry-picking, which parses out the words of the claims and cobbles together definitions for each word to "infer" some *meaning* for individual claim terms, ignores the key requirement of definiteness demanding not just a core meaning of claim terms but reasonable definition of the boundaries or scope of the claimed invention.

In *Energizer Holdings, Inc. v. International Trade Commission*, 435 F.3d 1366 (Fed. Cir. 2006), the International Trade Commission had held patent claims indefinite for failing to recite the required antecedent basis for the term "said zinc anode,"⁵ and

⁵ The antecedent-basis requirement is a rule of patent drafting that avoids ambiguity by requiring that a draftsman identify

because even if construed, the claim remained unclear and ambiguous. The Federal Circuit reversed, stating flatly that “[a] claim that is amenable to construction is not invalid on the ground of indefiniteness.” *Id.* at 1371. On that basis, while acknowledging that the patent provided no “antecedent basis for ‘said zinc anode,’” the court ignored the Commission’s stated concerns that the claims as construed remained unclear and ambiguous and found the claims sufficiently definite simply because they could be construed. *Id.* (“Here, it is apparent that the claim can be construed. ... The Commission’s holding of invalidity on the ground of indefiniteness is reversed.”)

In 2008, in *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306 (Fed. Cir. 2008), the district court had ruled the patent indefinite, where the disputed claim term was “not described, labeled, or coherently discussed in the patent,” and its meaning was not “discernable from the patent.” *Id.* at 1320. The Federal Circuit made brief reference to the “public notice function” of the definiteness requirement, *id.* at 1319, but rejected the finding of indefiniteness without any discussion of the notice of claim limits actually afforded by the patent. To the contrary, noting that “[i]ndefiniteness is a matter of claim construction,” *id.*, the court upheld the patent as definite enough because it was able to construe, and thus determine a meaning for, the disputed claim term, *id.*, at 1321. It did this even as it

each claim element clearly by using “a” or “an” when an element is first introduced and with “said” or “the” in subsequent references to that same element. *See* Manual of Patent Examining Procedure § 2173.05(e).

conceded that the patent was “not [] a model of clarity,” and dismissed expert testimony that the claims were indefinite. *Id.*

Most recently, in *Wellman, Inc. v. Eastman Chemical Co.*, 642 F.3d 1355, 1366 (Fed. Cir. 2011), the Federal Circuit reversed the lower court’s summary judgment of indefiniteness, applying the rule that “[c]laims need not be plain on their face in order to avoid condemnation for indefiniteness; rather, claims must only be amenable to construction.” There, the patents claimed a certain polymer having a particular measured value for “ T_{CH} .” While the claims plainly defined the boundary of T_{CH} as being $>140^{\circ}\text{C}$, “the district court found that the ... patents do not disclose sample conditions and testing parameters essential for obtaining consistent DSC measurements [of T_{CH}].” *Id.* at 1359. But the Federal Circuit nonetheless ruled that the claims, once construed, were sufficiently definite, even though the construed claims did not convey sufficient information to enable a skilled artisan to measure T_{CH} reliably in order to determine the bounds of the claims.⁶

⁶ In a few cases during this same period, the Federal Circuit, while first reciting these now-familiar phrases, has sidestepped the misleading character of the insolubly ambiguous/amenable-to-construction language by moving past it to focus on the necessity of providing notice of the patent’s outer boundaries, and on that basis has invalidated patents as indefinite. These cases are at odds with the insoluble ambiguity/amenable-to-construction approach that reflects the dominant strain in the Federal Circuit’s jurisprudence and only underscore the need for this Court to clarify the proper standard. See *Honeywell Int’l, Inc. v. Int’l Trade Comm’n*, 341 F.3d 1332, 1340 (Fed. Cir. 2003) (finding claims indefinite because the patent failed to disclose information “critical to discerning whether [a compound] ha[d]

As discussed below, the present case is both the latest and the most egregious in this line of misguided decisions.

C. The Decision Below Is An Egregious Example Of The Federal Circuit’s Definiteness Standard Being Applied To Uphold A Patent That Affords No Notice At All Of The Invention’s Outer Boundaries

For generations, tobacco farmers have dried yellowed tobacco leaves in curing barns in which humidity, temperature and airflow have been modified in a number of ways, including using heat exchangers to inject exhaust-free heated air. The patents in this case purport to use a “controlled environment” to substantially prevent an anaerobic condition around the plants—and thus stop the formation of nitrosamines—by using air free of combustion gases to vary at least one of humidity, temperature and airflow.

Star urged, and the trial court adopted, a construction of “controlled environment” as “controlling one or more of humidity, temperature and airflow in the curing barn, in a manner different from conventional curing, in order to substantially prevent the forma-

been produced by the claimed process”); *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005) (invalidating ambiguous claims because the claim term, as construed, was “purely subjective,” and claim limitations “must be objective” in order to “notify the public”); *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1250 (Fed Cir. 2008) (holding claims indefinite because the proposed construction failed to resolve “the ambiguity in the scope of the [claim] term”).

tion of TSNAs.” Pet.App.16a-17a. But neither this construction nor the patent on its face provides any guidance as to how the patented “controlled environment” differs from prior art, conventional curing processes that have been used by farmers for decades. Both parties’ experts testified that one skilled in the art could not distinguish the methods used to create the patented “controlled environment” from long-used techniques of conventional tobacco curing. Pet.App.32a; Pet.App.79a-80a; JA45681. Thus the patents are indefinite.

The majority below avoided this conclusion by first invoking the rule that claims are indefinite only if they are “not amenable to construction” or “insolubly ambiguous,” which it said does not demand “[a]bsolute clarity” and is satisfied even “when discerning the meaning is a ‘formidable [task] and ... reasonable persons will disagree [about the conclusion].” Pet.App.16a. Noting that the claim had been construed, the Federal Circuit said further that one skilled in the art “would ... recognize” and “know how to establish” a “controlled environment,” because “tobacco curing variables are well known in the tobacco industry.” *Id.* at 17a-18a.

Indeed, the court ruled that the claimed “controlled environment” is not indefinite because tobacco farmers will know how to achieve it by varying humidity, temperature and airflow using “conventional methods commonly ... used in the U.S.” *Id.* at 18a. But, as Judge Dyk explained in dissent, this is precisely the problem. According to the court, the patents rely on prior industry experience to tell tobacco farmers how to achieve the claimed “controlled environment.” But nothing is said about when the farmers’ use of

familiar techniques ceases to be the practice of “conventional methods” and begins to infringe the patents. *Id.* at 31a-32a. In a wholly circular manner, the world is told only that the patented “controlled environment” is “different from conventional curing” techniques, and that conventional curing is air-curing or flue-curing “without the controlled conditions” required by the claims. *Id.* at 32a. The patents give no guidance at all about where one ends and the other begins.

Further, the claims define the method in part by reference to the resulting product in which formation of TSNA is substantially prevented. Thus, even if skilled artisans could determine how to create the “controlled environment” referenced in the claims—and they cannot—they could not determine whether the method claims had been infringed until *after* committing a potentially infringing act, based on whether formation of TSNA was substantially prevented.⁷

The patents, even as construed, thus utterly fail to advise what methods or conditions to avoid in order to steer clear of the boundary of the patent claims.

⁷ If a farmer uses techniques capable of infringing the claimed method, whatever they may be, infringement could theoretically rest on “as little as one instance” in which the required prevention of TSNA formation is achieved. *See Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1317 (Fed. Cir. 2009). Thus, the Federal Circuit has opened the door to the chilling prospect that, if Star’s patents are not invalid for indefiniteness, Star could file an infringement claim whenever a farmer produces a single batch of TSNA-free tobacco, putting such farmer to the task of proving that the batch had been produced by “conventional methods,” whatever those may be.

The public is simply forced to guess what methods or techniques will and will not invade the patent monopoly.

Accordingly, this Court should grant review and reaffirm that the touchstone of patent definiteness is the requirement that a patent provide notice of a patent's outer limits to those of ordinary skill in the art.

II. THIS CASE PRESENTS AN IMPORTANT AND RECURRING ISSUE

A. Uncertainty About A Patent's Outer Boundaries Discourages Innovation And Gives Rise To Unnecessary And Wasteful Litigation

Upholding the validity of patents with uncertain claim language undermines the patent system's fundamental goal of encouraging innovation. Strong and consistently interpreted patent rights are essential to promoting innovation and technological advancement, and requiring definite claim language avoids creating a "zone of uncertainty" around patent rights that can discourage innovation. *United Carbon*, 317 U.S. at 236. *See Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176, 221 (1980) (recognizing "the policy of stimulating invention that underlies the entire patent system").

The Federal Circuit's insolubly ambiguous/amenable-to-construction standard directs attention away from this Court's clear mandate that skilled artisans receive reasonable notice of the boundaries of the patent. Indeed, in its simplest articulation, equating definiteness with construability, the Federal Circuit's holding that "[a] claim that is amenable to construction is not invalid on the ground of indefiniteness,"

Energizer Holdings, 435 F.3d at 1371, is an obvious perversion of the law as articulated by this Court.⁸

⁸ In addressing the Court's request for his views by recommending denial of *certiorari* in *Applera Corp. v. Enzo Biomchem, Inc.*, 131 S. Ct. 3020 (2011) (cert. denied), the Solicitor General himself raised questions about the suitability of the Federal Circuit's insolubly ambiguous/amenable-to-construction standard and that court's elaboration of it. The Solicitor noted that, "[r]ead in isolation, those phrases . . . might suggest an insufficiently demanding definiteness standard to a district court looking for guidance," Br. at 13, and even that the "Federal Circuit may on occasion have used [its test] while conducting a definiteness inquiry that in substance was insufficiently rigorous." *Id.* at 15.

At the same time, the Solicitor asserted that "[a]t least in the main run of its decisions," the Federal Circuit has used those phrases "to express principles that are well grounded in this Court's" cases. Br. at 13. That conclusion, which was unsupported by any comprehensive review of the circuit's decisions, and pre-dated *Eastman* and the present case, cannot be squared with the showing above that in most cases where claims are construable but still fail to provide reasonable notice of claim boundaries, the court has wrongly found them definite enough.

The government's brief in *Applera* is otherwise unexceptional. The brief argues at substantial length, Br. at 18-22, that the circuit there correctly decided a highly fact-bound question whether one of skill in the art of designing and labeling nucleic acid probes would understand the meaning of the claim term "substantial interference," *id.* at 15.

The brief also points out that the *Applera* decision "did not use either the phrase 'insolubly ambiguous' or the phrase 'capable of construction.'" *Id.* For all of these reasons, the Solicitor General concluded that the petition "provide[d] an unsuitable vehicle for determining whether the Federal Circuit in *other* decisions has used phrases like 'insolubly ambiguous' to announce a separate, legally deficient definiteness standard," *Id.* at 16 (emphasis in original).

As Judge Plager has commented concerning the Federal Circuit’s present approach to the issue of patent indefiniteness:

Despite the varying formulations that this 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.

Enzo Biochem, Inc. v. Applera Corp., 605 F.3d 1347, 1348 (Fed. Cir. 2010)(Plager, J. dissenting from denial of rehearing en banc), *cert. denied*, 131 S. Ct. 3020 (2011). He emphasized that it 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.” *Id.*⁹

The Solicitor’s brief in *Applera* thus gives no basis for denying review here, where the patent makes no distinction at all between the patented controlled environment and conventional curing methods, and the analysis is driven by the “insufficiently demanding” language that the Federal Circuit now utilizes as its standard of patent indefiniteness.

⁹ 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 application of the “insolubly ambiguous” standard that upholds patent claims if they are amenable to construction, the public notice function of the Section 112, ¶ 2 is nearly eviscerated.

Further, as Judge Plager has observed elsewhere:

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 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" of indefinite and ambiguous claims is further exacerbated when patentees seek to enforce broad and ambiguous patent claims by twisting their meaning to try to read them on profitable, commercialized products and processes. See 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, 1580 (2009); John R. Allison, Mark A. Lemley, & 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 parties targeting an entire industry). Indeed, when the boundaries are not clearly defined, productive companies may be deterred from legitimate pursuits and drawn into wasteful litigation that disrupts and diverts resources that could be otherwise spent to grow the business. *Festo*, 535 U.S. at 732. As a result, innovation, productivity, and commercialization of useful technology suffers.

B. The Federal Circuit’s Recurring Failure To Enforce The Definiteness Requirement Will Likely Persist Unless This Court Intervenes

The Federal Circuit’s multiple reversals of patent indefiniteness holdings leave little doubt that the insolubly ambiguous/amenable-to-construction standard is well-entrenched and is having a dramatic effect to water down the definiteness requirement as it has been articulated by this Court for well over a century. While the technical nature of many patents can make challenging any assessment of the character of the notice they provide, the decisions discussed above are cases where the absence of notice seems quite clear. And the decision below, involving air flow to cure tobacco in a barn, and circular definitions of the patented “controlled environment” and the prior art conventional curing in terms of the absence of the other, is the starkest case to date of a patent being upheld that provides no notice at all of the invention’s outer boundaries.

Nor is the Federal Circuit itself likely to correct the situation. During the past two years, in this case and two others, that court has denied petitions for rehearing en banc asking the court to reconsider the proper standard for indefiniteness. *See Eastman Chemical*

Co. v. Wellman Inc., No. 2010-1249 (petition denied Aug. 11, 2011); *Enzo*, 605 F.3d at 1347 (petition denied). The unanimous denial of such en banc review in the present case, even in the face of Judge Dyk’s powerful opinion demonstrating the majority’s error, suggests that a sense of futility may have settled in among those on the court who have previously spoken out against the court’s approach.

The flaws in the Federal Circuit’s erroneous standard are further compounded because the court does not apply its standard consistently. At least, if the court’s erroneous rule were applied uniformly, competitors would know that patent claims, if construable, would be enforced, and they could make business decisions based upon that predictable outcome. *See* S. Rep. No. 97-275 at 6 (1981) (reasoning that uniform patent laws resulting from Federal Circuit’s creation would yield a benefit that “[b]usiness planning will become easier as more stable and predictable law is introduced”). But, when it is unclear whether ambiguous patent claims will be upheld or struck down as indefinite, competitors struggle not only to determine the boundaries of the claimed invention, but also to evaluate the patent’s validity, which is a fundamental inquiry in any patent valuation analysis. As a result, it is much more difficult for patentees and competitors to reach a business solution that will permit innovation and enterprise.

Further magnifying the deleterious effects of the Federal Circuit’s crazy quilt approach, 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 J. INTELL. PROP. 25 (2010) (showing increase in the number of cases from 1998-2008 in which patent validity was challenged on indefiniteness grounds). 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.¹⁰ Even before this recent uptick in cases involving indefiniteness issues, the Federal Circuit had 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. *Id.* at 30.

But, in the end, the problem is not just the number of cases in which indefiniteness is raised, but the disconnect between the Federal Circuit's standard and this Court's precedent. This Court should grant review to reaffirm that the standard is clear notice and not insoluble ambiguity or mere amenability to construction.

CONCLUSION

The petition for a writ of certiorari should be granted.

¹⁰ *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 Mar. 24, 2012); Judge Schneider's standard Joint Discovery/Case Management Plan for Patent Infringement Cases, http://www.txed.uscourts.gov/cgi-bin/view_document.cgi?document=2192 (last visited Mar. 24, 2012).

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