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No. 14

IN THE

Supreme Court of the United States

Supreme Court, U.S.
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INTERVAL LICENSING LLC,

Petitioner,

v.

AOL, INC., APPLE, INC., GOOGLE, INC., AND YAHOO ! INC.

Respondents.

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

Whether a patent claim that includes terms that are either “subjective” or “terms of degree” is invalid as indefinite as a matter of law unless it also includes express definitional language or unambiguous limiting language.

RULE 29.6 DISCLOSURE STATEMENT

Petitioner Interval Licensing LLC has no parent company, and no publicly held corporation owns 10% or more of its stock.

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PETITION FOR A WRIT OF CERTIORARI

Petitioner Interval Licensing LLC (“Interval”) 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.

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 112 ¶ 2, provides, “The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.”

OPINIONS BELOW

The Federal Circuit’s opinion (Pet. App. 1a-28a) is published at 766 F.3d 1364. The district court’s opinion (Pet. App. 29a-69a) is unpublished. The court of appeals’ order denying rehearing en banc (Pet. App. 70a-71a) is also unpublished.

JURISDICTION

The Federal Circuit denied petitioner’s timely petition for rehearing en banc on December 18, 2014. Pet. App. 71a. On March 6, 2015, the Chief Justice granted petitioner’s timely application to extend the time to file this Petition to April 17, 2015. App. No. 14A925. On April 6, the Chief Justice granted petitioner’s application to further extend time to file this Petition to May 15, 2015. *Id.* This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

1. Interval is the owner of patents invented at Interval Research Corporation (Interval Research), a private think tank founded in 1992 by Paul Allen and

David Liddle to perform advanced research and development in the areas of information systems, communications, and computer science. Interval Research employed over 110 of the world's leading scientists, physicists, and engineers, and obtained hundreds of patents before ceasing operations in the year 2004.

In the years 1996 and 2000, as the Internet boom began, Interval Research filed applications for two patents—U.S. Patent Nos. 6,034,652 (filed Mar. 22, 1996) (the '652 patent) and 6,788,314 (filed Mar. 20, 2000) (the '314 patent)—for an “attention manager,” which is software that “presents information to a person in the vicinity of a display device that engages at least the peripheral attention of the person.” '652 patent, at [57]; '314 patent, at [57]. In layman's terms, the attention manager displays information to the user of a display—*e.g.*, a computer display, or a cellular phone display—that the user may find interesting, even if the user did not necessarily request that specific information at that specific time. As the patents explain, “[g]iven the extent to which computers now permeate society . . . there is increasing recognition of the capability of using computers, and, in particular, computers (and other devices) that are interconnected in a network, as an information dissemination tool that can satisfy the interests of both information providers and information consumers.” *E.g.*, '652 patent col. 1 ll. 19-27.

The '314 and '652 patents have a common specification, which explains that the attention

manager “makes use of the ‘unused capacity’ of the display device” to display pertinent additional information to users. *Id.* at col. 2 ll. 7-9.¹ The specification provides two examples of “unused capacity.” First, the attention manager can display information “while the apparatus (*e.g.*, computer) is operating, but during inactive periods (*i.e.*, when a user is not engaged in an intensive interaction with the apparatus).” *Id.* at col. 2 ll. 9-12. Second, the attention manager can display information “during active periods (*i.e.*, when a user is engaged in an intensive interaction with the apparatus), but in an unobtrusive manner that does not distract the user from the primary interaction with the apparatus (*e.g.*, the information is presented in areas of a display screen that are not used by displayed information associated with the primary interaction with the apparatus).” *Id.* at col. 2 ll. 12-19.

Of course, the patents also claim these features. Thus, they claim that the attention manager will, among other things, “selectively display, in an unobtrusive manner that does not distract a user of the apparatus from a primary interaction with the apparatus, an image or images generated from a set of content data.” *E.g., id.* at col. 29 ll. 41-55; *see also* ’314 patent col. 29 ll. 60-67.

¹ Because the specifications in both patents are substantively identical, this Petition cites the ’652 patent for the sake of brevity.

Subsequent to the invention, such unobtrusive information displays have become widespread. For example, smartphone owners might receive alerts describing text messages or breaking news along one edge of their screen, even as they use their phones to do something else, *e.g.*, play a game or listen to music. Computer users frequently receive similar notifications. Moreover, software developers and others skilled in the art are very familiar with these displays. For example, respondent Apple, Inc. provides guidance to third-party developers who write software for Apple devices. The guidance explains that the Apple operating system, called OS X, includes a “Notification Center,” which “provides a way for users to receive and view app notifications in an attractive, *unobtrusive way*.” See Apple, What’s New in OS X, at 35 (last updated April 30, 2015), <https://developer.apple.com/library/mac/releasenotes/MacOSX/WhatsNewInOSX/WhatsNewInOSX.pdf> (emphasis added).

2. Interval sued respondents in the Western District of Washington, alleging infringement of four patents including the ’652 and ’314 patents. Respondents make software that includes pop-up notifications, which display information alongside a user’s primary interaction with his electronic device. Interval’s complaint alleges that this software infringes its patents. The court stayed the litigation pending proceedings at the Patent and Trademark Office (PTO). After the PTO confirmed the patentability of the asserted claims in both the ’314 patent and the ’652 patent—the former in an adversarial *inter partes* proceeding brought by one of

respondents—the district court lifted the stay with respect to the '652 and '314 patents, proceeding to claim construction.

The key claim language is that the attention manager displays information “in an unobtrusive manner that does not distract a user of the display device from a primary interaction with the display device or apparatus.” Pet. App. 42a. Interval’s proposed construction was that a system displays information in an “unobtrusive manner that does not distract a user of the display device” by displaying information “in an area of the display screen not substantially used by displayed information associated with the primary action of the user.” *Id.* 43a. This proposed construction quoted an example in the specification almost verbatim. *See* '652 Patent, at col. 2, ll. 17-19 (explaining that information is displayed “in an unobtrusive manner that does not distract the user from the primary interaction with the apparatus (e.g., the information is presented in areas of a display screen that are not used by displayed information associated with the primary interaction with the apparatus)”). Interval also argued that in the context of the patent as a whole as read by a skilled artisan actually trying to understand it, this was a natural construction of the plain-English words.

Respondents argued, by contrast, that this claim term must be indefinite because it is “subjective” in the sense that different users would find different displays “obtrusive” or “distracting.” For example, a distractible user might find a very small, non-overlapping notification obtrusive, while another user

of especially robust attention could proceed with her primary interaction in the face of a large notification occupying much of the screen with blinking red lights. The district court agreed, holding that “whether something distracts a user from his primary interaction depends on the preferences of the particular user and the circumstances under which any single user interacts with the display.” Pet. App. 37a. Having deemed this language indefinite, the district court held that every claim incorporating it (the majority of the claims in the patents) was therefore invalid under 35 U.S.C. § 112 ¶ 2. Pet. App. 40a-41a.

3. On appeal, Interval argued that the district court’s decision embodied a mistaken approach to indefiniteness. The best-chosen claim terms often must refer to “subjective” human experiences that are matters of degree. Accordingly, Interval noted that the Federal Circuit had recently approved several similar claim terms over indefiniteness challenges, pointing in particular to *Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1360 (Fed. Cir. 2012) (claiming a rotary cutting deck that was “easily” washed off), and *Hearing Components, Inc. v. Shure Inc.*, 600 F.3d 1357 (Fed. Cir. 2010) (claiming a hearing aid in which components could “readily” be replaced).

The Federal Circuit had approved these terms because, based on the examples in the specifications, skilled artisans could determine the general, objective criteria that corresponded to the allegedly “subjective” description of the user’s experience. Interval also emphasized that the Federal Circuit had routinely

approved terms of degree as sufficiently definite because a skilled artisan can understand the relevant parameters based on her understanding of the purpose of the invention and how it works. *See, e.g., Exxon Res. & Eng'g, Co. v. United States*, 265 F.3d 1371, 1381 (Fed. Cir. 2001).

After oral argument, but before the Federal Circuit decided this case, this Court decided *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120 (2014). In *Nautilus*, this Court held that “a patent is invalid for indefiniteness if its claims, read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Id.* at 2124. The Court thus rejected the wording of the Federal Circuit’s prior standard, under which a parent was indefinite only if its terms were “insolubly ambiguous,” or not “amenable to construction.” *Id.*

While the Court found fault with the Federal Circuit’s phrasing of its test, the flaw with that test is that it was ambiguous. *See id.* at 2130 (“Those formulations can breed lower court confusion, for they lack the precision § 112, ¶ 2 demands.”); *id.* (“[S]uch terminology can leave courts and the patent bar at sea without a reliable compass.”). But the Court “recognize[d]” that “[t]he Federal Circuit’s fuller explications . . . may come closer to tracking the statutory prescription.” *Id.* at 2130. Thus, the Court did not overrule any particular Federal Circuit case, or even suggest that the result in any past case should have come out differently. The Court did not even

adopt petitioner *Nautilus*' proposed test: that "a patent is invalid when a claim is 'ambiguous, such that readers could reasonably interpret the claim's scope differently.'" *Id.* at 2128 (quoting *Nautilus*' brief at 37). Instead, the Court recognized that "absolute precision is unattainable," and required only the amount of certainty that is "reasonable, having regard to [the patent's] subject-matter." *Id.* at 2129 (quotation marks omitted).

Nevertheless, the court of appeals applied *Nautilus* in this case to find Interval's patents indefinite. Pet. App. 10a. The court of appeals determined that Interval's claims involve a "term of degree ('unobtrusive manner')." *Id.* 11a. The court of appeals recognized that *Nautilus* had not deemed such terms "inherently indefinite." *Id.* But it rejected Interval's argument that the example provided in the patent specification was sufficient to give a person of ordinary skill in the art notice of the scope of the invention.

Interval had argued first that the term "unobtrusive manner" was clearly tied to one embodiment of the invention—referred to below as the "wallpaper embodiment"—whereby the attention manager displayed information in the unused space of a display. That was in contrast with a second embodiment—the "screen saver embodiment"—whereby the attention manager displayed information while the device was not otherwise being used. The court of appeals acknowledged that "Interval identifies portions of the specification that appear to use the 'unobtrusive manner' phrase in conjunction with the

wallpaper embodiment,” but it found that “other portions of the specification *suggest* that the phrase *may* also be tied to the screen saver embodiment.” Pet. App. 14a. It therefore concluded that Interval’s resort to the “wallpaper embodiment” was unavailing. *Id.*

Interval argued next that because the specification includes a clear example providing that the display of information in an “unobtrusive manner” involves displaying the information in a part of the screen that is not substantially used by the user’s primary interaction with the device (the same example Interval had relied upon during claim construction), the term “unobtrusive manner” is not indefinite. The court of appeals reached a contrary conclusion. It acknowledged that “[h]ad the phrase been cast as a definition instead of as an example—if the phrase had been preceded by ‘i.e.’ instead of ‘e.g.’—then it would help provide the clarity that the specification lacks.” Pet. App. 19a. But because the example had not, in the court’s view, been set forth as the “exclusive definition” of the term “unobtrusive manner,” it was insufficient. *Id.* The court gave an example to elucidate its reasoning: “What if a displayed image takes up 20% of the screen space occupied by the primary application with which the user is interacting?” *Id.* 20a. Because, in the Federal Circuit’s view, a skilled artisan would not necessarily know the answer to that question, the language of the patent was indefinite.

Interval sought rehearing en banc, arguing that the majority had effectively created a per se rule that any time a patent uses a term that is “subjective” or a “term of degree,” and does not include either an

express definition or express limiting language, the term is invalid. The court of appeals denied rehearing. Pet. App. 71a-72a.

This Petition followed.

REASONS FOR GRANTING THE WRIT

In *Nautilus*, this Court subtly modified the Federal Circuit's test for determining indefiniteness. In this case, the Federal Circuit erroneously treated that modification as a sea change. Contrary to the Federal Circuit's analysis in this case, this Court never held—or even suggested—that “terms of degree” are disfavored, or that they can only be definite if accompanied by express definitions or limiting language. Instead, this Court set forth a general standard, which easily can be met when a patent specification includes examples that establish the scope of an invention. Because terms that are arguably “subjective” or “terms of degree” are commonplace in patents—indeed, they are often essential to writing comprehensible patents—this Court should grant certiorari and reject the Federal Circuit's crabbed rule for those terms.

I. Certiorari Is Warranted Because The Federal Circuit's Decision Is Contrary To This Court's Recent Decision In *Nautilus* And To Established Federal Circuit Precedent, Which *Nautilus* Did Not Purport To Overrule.

The Federal Circuit overread *Nautilus* and essentially overruled—*sub silentio*—a number of important indefiniteness precedents to find Interval's

patents invalid. Certiorari is warranted because only this Court can clarify authoritatively the scope of *Nautilus*' holding.

Nautilus replaced the "amorphous" language of the Federal Circuit's indefiniteness test with language that hews more closely to the statutory text. 134 S. Ct. at 2131. But the intended effect on the *substance* of the indefiniteness standard was very subtle. This Court did not set out to upend the law, or to overturn the settled expectations upon which the entire industry had come to rely. Indeed, the Court never disparaged the result of *any* prior Federal Circuit case. Instead, it merely sought to "ensure that the Federal Circuit's test is at least 'probative of the essential inquiry.'" *Id.* at 2130 (quoting *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997)).

Evidence abounds that *Nautilus* did not intend to work a major change in the law. The case was decided unanimously, and with little controversy. Indeed, even the respondent in *Nautilus* agreed that the language the Federal Circuit had been using was not "felicitous," and was willing to accept a new formulation. 134 S. Ct. at 2130. Moreover, this Court expressly recognized that the "Federal Circuit's fuller explications of the" standard "may come closer to tracking the statutory prescription," thus recognizing the correctness of many prior Federal Circuit cases. *Id.* And it rejected the demanding standard set forth by the petitioner, under which a patent would be invalid if it could be interpreted in more than one way—and instead required only that "a patent must be precise enough to afford clear notice of what is claimed" to a

person skilled in the art, and elaborating that the appropriate level of clarity is only that which is “reasonable.” *Id.* at 2129.

Especially important, the patent in *Nautilus* itself included a term of degree, providing that the signals detected by the electrodes were to be of “substantially equal magnitude and phase” so that the difference amplifier would “produce a substantially zero [EMG] signal” upon subtracting them from each other. *Id.* at 2126. But the Court never suggested that the use of the word “substantially”—unadorned by any definitional language—rendered the term indefinite.

Notwithstanding the subtlety of this Court’s approach in *Nautilus*, the Federal Circuit in this case implemented a far more sweeping change. Because the court of appeals determined that the phrase “unobtrusive manner” could be read to encompass more than one embodiment of Interval’s invention, it refused to resort to clear language in the patent specification limiting the term. Pet. App. 14a. Moreover, the court of appeals refused to heed a clear example in the specification—an example that is indistinguishable from respondents’ infringing products—because the example was preceded by an “e.g.,” instead of an “i.e.,” and therefore did not furnish an “exclusive definition” of the term. *Id.* 18a-19a. Indeed, the court below demanded exactly the sort of “absolute precision” that *Nautilus* held unnecessary—hanging its decision on whether an alert that covered 20% of the screen, as opposed to, say, 19%, would be deemed “obtrusive.” *Id.* 19a. Patents have never been required to exhibit that sort of arbitrary granularity.

In fact, prior to this case, the Federal Circuit's consistent practice was to allow the specification and prosecution history to supply a limiting construction of an allegedly "subjective" or expansive claim term, without requiring that the specification expressly say that this is the *only* possible construction. *See, e.g., Deere & Co. v. Bush Hog, LLC*, 703 F.3d 1349, 1360 (Fed. Cir. 2012); *Hearing Components, Inc. v. Shure*, 600 F.3d 1357 (Fed. Cir. 2010); *Exxon Res. & Eng'g, Co. v. United States*, 265 F.3d 1371, 1381 (Fed. Cir. 2001). Those cases, which permit such constructions to be drawn from "examples" in the specification and the practical knowledge of skilled artisans about the purposes and function of the invention, have never been overruled—including by *Nautilus*.

Under the Federal Circuit's settled precedents, allegedly "subjective" claim terms can be given sound limiting constructions based on the general teachings and examples provided in the specification, even if the specification could also be read to permit broader constructions as well. In *Shure*, for example, the court reversed a holding that the phrase "readily installed and replaced by a user" was indefinite because different users would have different impressions and abilities regarding the replacement of the relevant hearing-aid part. 600 F.3d at 1368. The written description said little—only that the part was "simple to install, easy to remove, and convenient to replace," and was "inexpensive and require[d] no tools for installation or removal." *Id.* at 1367. It also disparaged some prior art where "removal and replacement ha[d] been difficult," especially for older people. *Id.* The court noted that these were "the *only* examples or

discussion provided by the specification” regarding the disputed terms. *Id.* (emphasis added). But this discussion was sufficient to allow the Federal Circuit to adopt a sound, limiting construction equating the term “readily installed and replaced by a user” with the absence of any need for specialized training or tools. *Id.* at 1368.

Likewise, in *Deere*, this Federal Circuit rejected the contention that a claim limiting the invention to rotary decks that were “easily washed off” was indefinitely subjective. 703 F.3d at 1360. The court found all the guidance it needed in the following six lines from the specification:

An object of the invention is to provide a deck which is easy to clean but yet has an underside free of obstructions to the smooth flow of cut material.

A more specific object of the invention is to provide a rotary cutter deck which has an upper, generally convex smooth surface from which debris tends to slide off and water will run off.

U.S. Patent No. 6,052,980, at col. 1, ll. 40-46 (filed July 17, 1998). From this statement, the court of appeals found sufficient “physical characteristics [to] guide the determination of whether a deck” was easy to clean (*i.e.*, whether it had a smooth, convex surface). *Deere*, 703 F.3d at 1360.

Similarly, in *Exxon*, the Federal Circuit found that the term “substantial absence of slug flow” was definite precisely because “[o]ne of skill in the art

would understand . . . that the *reason* slug flow should be avoided is that it may interfere with reactor efficiency.” 265 F.3d at 1381. The court of appeals thus acknowledged that terms that may be broad or subjective in the colloquial sense may have a more limited meaning in the context of a patent, which, after all, is “addressed . . . to those skilled in the relevant art.” *Nautilus*, 134 S. Ct. at 2128.

None of the patent specifications that adequately limited the allegedly subjective claim language in these cases contained express definitional language. None said that the examples they provided were the *only* way to satisfy the disputed claim limitation. It would thus have been equally possible for skilled artisans to “wonder what other forms of [rotary decks] are [“easily” washed off],” in *Deere*, and certainly there would be some that did not involve a “generally convex smooth surface.” The same is equally true of *Shure*, where there were surely other possible parameters beyond the need for specialized tools by which to judge whether a hearing-aid part was “readily” replaced.

Here, however, the Federal Circuit applied a rule that bears no resemblance to these decisions, and reached a result at odds with their holdings, without so much as citing them. Instead, it applied this Court’s decision in *Nautilus* as if it had wiped the slate of prior authority clean. That was a grave error that warrants this Court’s attention. Otherwise, parties and district courts will be left in the dark as to the validity of the Federal Circuit’s prior holdings regarding terms of degree.

To date, numerous district courts have reasoned that *Nautilus* did not significantly change the law vis-à-vis certain terms of degree, such as “relatively small,” “short,” “substantially,” “generally,” and “approximately.” *iLife Techs. Inc. v. Body Media, Inc.*, No. CIV.A. 14-990, 2015 WL 868103, at *23 (W.D. Pa. Feb. 27, 2015); *WhatsApp Inc. v. Intercarrier Commc’ns, LLC*, No. 13-CV-04272-JST, 2014 WL 5306078, at *7 (N.D. Cal. Oct. 16, 2014); *R-Boc Representatives, Inc. v. Minemyer*, No. 11 C 8433, 2014 WL 4412311, at *3 (N.D. Ill. Sept. 5, 2014) *reconsideration denied*, No. 11 C 8433, 2014 WL 4656389 (N.D. Ill. Sept. 18, 2014); *Perfectvision Mfg., Inc. v. PPC Broadband, Inc.*, 2014 WL 4285786, *18 (E.D. Ark. 2014) (“The Supreme Court’s decision in *Nautilus* did not overturn or address the Federal Circuit’s decisions regarding the use of ‘substantially.’”); *Thomas Swan & Co. v. Finisar Corp.*, 2014 WL 2885296, *25 (E.D. Tex. 2014) (“*Nautilus* does not overturn, or even address, the above-cited cases.”); *In re Maxim Integrated Prods., Inc. MDL 2354*, No. MDL 2354, 2014 WL 3696137, at *11 (W.D. Pa. July 23, 2014) (noting that *Nautilus* did not address a term-of-degree issue in the case before it, and declining to disturb prior finding of definiteness). Many of these cases were decided prior to the Federal Circuit’s decision in this case, and it is not at all clear that they will be affirmed. Other district court decisions have relied either on *Nautilus* or on this case to find terms indefinite absent a definition. See *ACQIS LLC v. Alcatel-Lucent USA Inc.*, No. 6:13-CV-638, 2015 WL 1737853, at *10 (E.D. Tex. Apr. 13, 2015) (relying on this case to find the phrase “similar in design” to be

indefinite); *Cioffi v. Google Inc.*, No. 2:13-CV-103-JRG-RSP, 2014 WL 4293978, at *22 (E.D. Tex. Aug. 28, 2014) (relying on *Nautilus* to find the phrase “critical file” indefinite); *Innovative Display Techs. LLC v. Acer Inc.*, No. 2:13-CV-522-JRG, 2014 WL 4230037, at *26 (E.D. Tex. Aug. 26, 2014) (citing *Nautilus* to find the phrase “quite small” indefinite).

This confusion over the scope of *Nautilus*’ holding—exemplified by this very case—calls out for this Court’s prompt review.

II. This Case Is An Ideal Vehicle To Decide An Important Question Of Patent Law.

Certiorari is also warranted because this case presents an ideal occasion to address an important question of patent law. The Federal Circuit’s new rule disparaging terms of degree will substantially alter the adjudication of any number of existing patents, and will surely influence future patent prosecution. If, as Interval submits, the Federal Circuit’s rule is invalid, then this Court should clarify the law as soon as possible so that its holding in *Nautilus* is not further misinterpreted. If, on the other hand, the Federal Circuit’s rule is legitimate, it would aid the industry, the bar, and district courts to know that as soon as possible.

Countless patent claims, written in reliance on the Federal Circuit’s previous approach, incorporate words of degree without expressly limiting them to one particular embodiment or providing a lexicographic definition in the specification. The number of words that can be obstinately read by potential infringers as

being “subjective” or “terms of degree” is limitless, and even if the challenges can be overcome, the court of appeals’ new approach creates a powerful incentive for every patent challenger to comb through each claim looking for such terms, potentially derailing every single case. For example, one can be sure that in the wake of this case, infringers will hunt for patents that introduce examples with “*e.g.*” instead of “*i.e.*” That incentive arises even if the allegedly subjective term has *nothing to do* with the actual dispute, as the consequence of an indefiniteness finding for any claim term is invalidation of the claim as a whole.

That incentive can easily be seen in this very case. At this stage, the basic dispute between the parties (at least, as to this claim limitation) boils down to whether the pop-up notifications seen on devices like Apple’s iPhone satisfy the claim language. There can hardly be much question that they do; these displays were *designed* to be “unobtrusive,” and any skilled artisan would understand the basic design parameters for such an unobtrusive display. *See, e.g.,* Apple, What’s New in OS X, at 35 (last updated April 30, 2015), <https://developer.apple.com/library/mac/releasenotes/MacOSX/WhatsNewInOSX/WhatsNewInOSX.pdf> (explaining that notifications appear in an “unobtrusive way”); Jeff Benjamin, iOS 7: The Ultimate Notification Center Guide, <http://www.idownloadblog.com/2014/03/15/ios-7-the-ultimate-notification-center-guide/> (“[N]otifications are unobtrusive and quickly disappear automatically after a few seconds.”).

Respondents' strategy—blessed by the Federal Circuit's approach in this case—has been to hypothesize bizarre devices that can theoretically be considered “unobtrusive” in their (frankly, rather obtrusive) displays, such as one that occupies a fifth of the screen with flashing lights. And while such hypotheticals have no actual relevance to the parties' dispute, they are very easy to concoct. This approach to indefiniteness only rewards parties for the obtuse misreading of language that is easily understood, and encourages patent litigation to descend even further into ticky-tack technicalities with no bearing on the actual invention or accused products at issue.

As these challenges progress, almost any patent that uses an adjective in one of its claims would face the threat of subsequent invalidation under the Federal Circuit's new rule, because reasonable minds frequently can apply multiple interpretations to almost any adjective, and patents often do not set forth “exclusive definitions” of every claim term. Innumerable claims include terms like “easily,” “readily,” “substantially,” and “near,” all of which have been found valid when read in light of the relevant specifications. *See, e.g., Deere*, 70F.3d at 1360; *Shure*, 600 F.3d at 1366; *Enzo Biochem, Inc. v. Applera Corp.*, 599 F.3d 1325, 1336 (Fed. Cir. 2010); *Young v. Lumenis, Inc.*, 492 F.3d 1336, 1346-47 (Fed. Cir. 2007). The public does not gain by effectively banning such words from patents. Indeed, in many inventions, the amount of precision is irrelevant.

For related reasons, the Federal Circuit's new rule will complicate future patent prosecution. To the

extent possible, inventors will avoid terms that might ultimately be construed as subjective or as terms of degree. Of course, they will often not be able to do so, because it frequently is impossible to avoid such terms in describing an invention. Thus, some inventors may refrain altogether from seeking patent protection for certain inventions. That would undermine a central goal of the patent system, which is to encourage inventors to disclose the details of their inventions. *See Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1989).

Inventors who nevertheless file patent applications will have an incentive to avoid claiming multiple embodiments of an invention in a single claim, for fear that what happened to Interval will happen to them. Such claims, however, are common. Patent prosecutors attempt to draft claims that broadly cover the underlying inventive principle over a variety of embodiments, while avoiding covering the prior art. This process necessarily involves claim language covering a range of meanings. The result does not make a claim ambiguous; it simply makes the claim broad. *See, e.g., Fuji Photo Film Co. v. ITC*, 386 F.3d 1095, 1106 (Fed. Cir. 2004) (“It is a familiar axiom of patent law, however, that the scope of the claims is not limited to the preferred embodiments described in the specification.”); Manual of Patent Examining Procedure § 2173.02 (I) (“A broad claim is not indefinite merely because it encompasses a wide scope of subject matter . . .”).

The Federal Circuit’s decision in this case threatens to upend this settled practice by requiring

applicants—on pain of potential indefiniteness—to separately claim every possible embodiment of their inventions. The decision will therefore dramatically increase attorney fees and costs. The billable time involved in drafting and prosecuting dozens or even hundreds of claims per patent application, in addition to ensuring that each claim term has only one objectively reasonable interpretation, would become prohibitively expensive for many inventors, particularly small entities.

In addition, a significant expansion in the number of claims filed per application would overload the already-backlogged PTO. *See* Paul R. Lawrence & Mark A. Abramson, *Paths to Making a Difference: Leading in Government* 111-14 (rev'd ed. 2011) (detailing the PTO's backlog woes). Examiners would now be required to examine dozens or hundreds of claims per patent application to ensure that each one has a single objective definition. If an examiner discovers a controversial claim, significant PTO and attorney time would be spent debating the issue. This result would also prolong prosecution and run counter to the PTO's goal of more efficient and compact prosecution.

This Court can spare the industry, the bar, and the district courts from substantial confusion and unnecessary expense by reviewing the Federal Circuit's decision in this case.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

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