

No. 2008-1248

**IN THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

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**ARIAD PHARMACEUTICALS, INC., MASSACHUSETTS INSTITUTE  
OF TECHNOLOGY, THE WHITEHEAD INSTITUTE FOR  
BIOMEDICAL RESEARCH, and THE PRESIDENT AND FELLOWS  
OF HARVARD COLLEGE**  
Plaintiffs-Appellees-Petitioners,

v.

**ELI LILLY AND COMPANY,**  
Defendant-Appellant-Respondent.

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Appeal From The United States District Court For The District Of  
Massachusetts in Case No. 02-CV-11280, Judge Rya W. Zobel.

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**BRIEF OF HYNIX SEMICONDUCTOR INC. AND SAMSUNG  
ELECTRONICS CO., LTD. AS *AMICI CURIAE* IN SUPPORT OF  
DEFENDANT-APPELLANT-RESPONDENT AND REVERSAL**

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**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

Ariad Pharmaceuticals, Inc., et al. v. Eli Lilly and Company

No. 2008-1248

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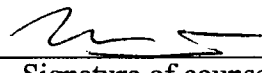
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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

*Ariad Pharmaceuticals, Inc., et al. v. Eli Lilly and Company*

No. 2009-1299

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**UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

Ariad Pharmaceuticals, Inc., et al. v. Eli Lilly and Co.

No. 2008-1248

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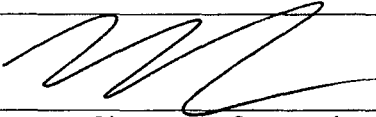
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Ariad Pharmaceuticals, Inc., et al. v. Eli Lilly and Co.  
No. 2008-1248

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## INTERESTS OF *AMICI CURIAE*<sup>1</sup>

*Amici Curiae* Hynix Semiconductor Inc. (“Hynix”) and Samsung Electronics Co., Ltd. (“Samsung”) rely heavily on a U.S. patent system that both appropriately rewards innovation and provides protection from opportunistic claims by patentees. Hynix and Samsung are global technology leaders that design, manufacture, and sell a wide variety of products; each holds thousands of United States patents. Hynix and Samsung are among the world’s largest manufacturers of advanced computer memory products. Hynix and Samsung regularly enter into licenses to patents from third parties and also regularly license others to use innovations developed by Hynix and Samsung. In doing so, Hynix and Samsung benefit from a patent system that “embodies a carefully crafted bargain for encouraging the creation and disclosure of new, useful, and nonobvious advances in technology and design in return for the exclusive right to practice the invention for a period of years.” *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1989).

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<sup>1</sup> The filing of this brief is authorized by this Court’s Order of August 21, 2009, which provides that “amicus briefs may be filed

Unfortunately, Hynix and Samsung also are often the target of law suits by patentees who in reality have contributed nothing to the products they make or the technology they use. For example, one patentee that filed a single patent application describing a specific memory product (licensed by Hynix, Samsung, and others) prosecuted a lengthy series of continuation and divisional applications in light of technical advances by the industry and, many years later, claimed that a far broader swath of products infringed the resulting newly minted patent claims. *See generally Rambus Inc. v. Infineon Techs. AG*, 318 F.3d 1081 (Fed. Cir. 2003).<sup>2</sup>

Although various doctrines are in place to prevent patentees from opportunistically expanding their patent claims to collect royalties far in excess of any technological contribution, the statutory “written description” requirement has long played a key role in preventing this type of pernicious abuse of the patent system. By requiring that a patentee’s claims not exceed the description of the invention, the

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without leave of court.” *Order, Ariad Pharms., Inc. v. Eli Lilly & Co.*, No. 2008-1248, at 2 (Aug. 21, 2009).

<sup>2</sup> *Hynix v. Rambus* is currently pending before the Court in Nos. 2009-1299 and 1347. Among other issues raised in that matter is

obligation to provide a written description of the invention assures that the claims do not exceed the patentee's contribution and notification to the public. The requirement also prevents patentees from later obtaining claims that are far different than their original contributions. Hynix and Samsung submit this brief as *amicus curiae* to emphasize the important role played by the separate written description requirement in assuring a patent system that promotes innovation.

### **QUESTIONS PRESENTED**

The Court has asked:

(1) Whether 35 U.S.C. § 112, paragraph 1, contains a written description requirement separate from an enablement requirement?

(2) If a separate written description requirement is set forth in the statute, what is the scope and purpose of the requirement?

Since the Court is sitting en banc to consider the written description requirement, Hynix and Samsung submit the Court should at the same time also resolve the following question:

(3) If a separate written description requirement is set forth in the statute, whether satisfaction of the requirement is ultimately a

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whether Rambus's claims are invalid for failure to provide a separate

question of fact for the jury to resolve or a question of law for the court? See Pet. Br., at 46 (stating that written description is a question of fact); and Resp. Br., at 51 (discussing same).

### ARGUMENT

The “ancient lineage” of the statutory terms at issue (*In re Barker*, 559 F.2d 588, 594 (C.C.P.A. 1977) (Rich, J., concurring)) necessarily calls upon the Court to apply its “special expertise.” *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997); *Dickinson v. Zurko*, 527 U.S. 150, 163 (1999) (noting “comparative expertise” due to “patent-related experience” because “Federal Circuit is a specialized court”). “As in all cases of statutory construction,” the Court’s “task is to interpret the words” of the Patent Act “in light of the purposes Congress sought to serve.” *Chapman v. Houston Welfare Rights Org.*, 441 U.S. 600, 608 (1979). The purpose of the patent laws, of course, is to “promote the Progress of Science and useful Arts.” U.S. Const., art. I, § 8.

For reasons first articulated by the Supreme Court more than two centuries ago, the patent laws require patent applicants to describe the

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written description.

invention in a way that does more than just enable one to make and use it. The separate description requirement informs the public what the inventor has invented and thereby protects the public against unwitting use of a patented invention. Today, these functions of the written description requirement remain vital to a patent system that promotes Progress. Indeed, *amici curiae* know first-hand the unfairness that results when a patentee is permitted to claim inventions ranging far beyond the inventions it originally described to the public. See *Interests of Amici Curiae* above.

**I. THE WRITTEN DESCRIPTION REQUIREMENT ASSURES THAT THE PUBLIC KNOWS BOTH WHAT THE INVENTION IS AND HOW TO MAKE AND USE IT**

**A. The First Patent Act Required The Patentee To Describe The Invention**

The first Patent Act, adopted in 1790, required the patentee to provide a “description” “of the thing or things, by him or them invented.” See *Pet. Br.*, at 8-9 (quoting Act of Apr. 10, 1790, 1 Stat. 109, 110-11, ch. 7, § 2). The description was to be “so particular” as “to distinguish the invention or discovery from other things before known and used.” *Ibid.*; see IV *Oxford English Dictionary* 860 (2d ed. 1991) (defining “distinguish” as “to perceive or note the difference between

(things)"). The description also was "to enable a workman . . . . to make, construct, or use the same." Pet. Br., at 8.

In *Evans v. Eaton*, 20 U.S. 356 (1822), the Supreme Court applied this "description" requirement to invalidate a patent that failed to put the public on notice of what the applicant had invented. The invention was an improvement to a milling machine. The patent included a description that taught the public how to make and use the improved machine, but did so by "mixing up the new and old." *Id.* at 434. The Court recognized that, for the purpose of enabling artisans to construct the machine, "it may be[] necessary for [the patentee] to state so much of the old machine as will make his specification of the structure intelligible." *Ibid.* But the description did "not in the slightest degree explain what is the nature or limit of the improvement which the party claim[ed] as his own[.]" *Id.* at 433. Because the inventor had not described (only enabled) what was invented, the patent was invalid.

In so holding, *Evans* explained the scope and purpose of the separate description of the invention requirement. The object is to

put the public in possession of what the party claims as his own invention, so as to ascertain if he claim anything that is in common use, or is already known, and to guard against

prejudice or injury from the use of an invention which the party may otherwise innocently suppose not to be patented.

*Id.* at 434.

**B. The Patent Act Of 1836 Retained The Requirement To Describe The Invention**

As petitioners note, the Patent Act of 1836 deleted the original statutory language stating that a purpose of the description requirement was to “distinguish” the invention from the prior art. Pet. Br., at 10-11 (quoting Act of July 4, 1836, 5 Stat. 117, 119, ch. 357, § 6). Congress, however, retained in the 1836 Act a requirement to provide a “written description of this invention,” and precedent from the Supreme Court confirms that the description requirement remained separate from the requirement of a description to enable one to make and use the invention.

1. In the well-known case of *O’Reilly v. Morse*, 56 U.S. 62, 121 (1854), the Supreme Court applied the 1836 Act’s description requirement to invalidate a claim. There, the Supreme Court found that Samuel “Morse was the first and original inventor of the telegraph described in his specification.” *Id.* at 108. Nevertheless, the Court

invalidated one of Morse's claims because the specification failed to describe what Morse had invented. The claim stated:

I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances, being a new application of that power of which I claim to be the first inventor or discoverer.

*Ibid.* In invalidating the claim as “too broad,” the Supreme Court emphasized that “some future inventor, in the onward march of science, may discover a mode of writing or printing at a distance by means of the electric or galvanic current, without using any part of the process or combination set forth in the plaintiff’s specification.” *Id.* at 113. In statutory terms, the claim was invalid because Morse “ha[d] not described and indeed had not invented” such future uses of electric or galvanic current. *Ibid.*; *see id.* at 120 (“The words of the acts of Congress above quoted show that no patent can lawfully issue upon such a claim. For he claims what he has not described in the manner

required by law.”).<sup>3</sup>

Years later, in *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 57 (1938), the Supreme Court again applied the description requirement to bar claims that would have extended beyond what the inventor described. At issue in that case was the “Maynard” patent that sought to claim a piston gas engine device with “flexible webs,” even though “one element” of that device—the webbing—was “not described at all.” *Id.* at 50. Although flexible webs “[we]re neither described in Maynard’s specifications nor mentioned in his claims,” Maynard argued that they were covered by the patent because “it was but the skill of the art, and not invention, to substitute a flexible for a rigid means.” *Id.* at 58, 60. The Court rejected that assertion: “If invention depends on emphasis of one quality over the other,” “the statute requires that emphasis to be revealed to the members of the

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<sup>3</sup> In contrast, where the inventor “did describe accurately, and with admirable clearness, his process,—that is to say, the exact electrical condition that must be created to accomplish the purpose,” the Supreme Court has found the statutory description requirement met. *Telephone Cases*, 126 U.S. 1, 535 (1888).

public, who are entitled to know what invention is claimed.” *Ibid.*<sup>4</sup>

*O'Reilly* and *Schriber-Schroth* both illustrate that the description of the invention is separate from the description that enables making and using the invention. In *O'Reilly*, the description did not include some as-yet unimagined mode of writing at a distance. The Court could have chosen to invalidate the claim on the basis that the description did not enable one to make and use the as yet uninvented mode of writing. But the Court emphasized the failure to even “describe[]” the invention in the first instance. 56 U.S. at 113. In *Schriber-Schroth*, others could make and use the invention based on the description (by supplementing the description with known art), and the invention, therefore, was arguably enabled. Nevertheless, the Court invalidated the claim on the antecedent and distinct ground that the invention was not described in the patent application. As the Court summarized in *Schriber-Schroth*, the objects of the description requirement are to enable the public to

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<sup>4</sup> *Accord, e.g., Permutit Co. v. Graver Corp.*, 284 U.S. 52, 60 (1931) (“The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be

make and use the invention after the patent expires “and to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.” 305 U.S. at 57.

2. Contrary to petitioners’ suggestion (at 14), the 1836 Act’s claiming requirement did not eliminate the separate description requirement. To be sure, under the 1836 Act, the patent application had to “particularly specify and point out the part, improvement, or combination, which he claims as his invention or discovery.” *See* Pet. Br., at 10 (quoting Act of July 4, 1836, 5 Stat. 117, 119, ch. 357, § 6). Although claims help to distinguish what is invented from what came before, claims alone are too specific (i.e., particular) to inform the public of what the invention is without an accompanying description. *See Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 975 (Fed. Cir. 2002) (Newman, J., concurring) (“[T]he description of the invention has always been the foundation of the patent specification. It sets forth what has been invented, and sets boundaries of what can be claimed.”);

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known which features may be safely used or manufactured without a license and which may not.”).

*see also Phillips v AWH Corp.*, 415 F.3d 1303, 1319 (Fed. Cir. 2005) (en banc).<sup>5</sup>

Petitioners concede that the claims required by the 1836 Act do not completely displace the long-standing requirement to provide a written description of the invention. Attempting to distinguish cases relied on by this Court to support a separate written description requirement, petitioners write (at 23): “these three cases [*Jepson v. Coleman*, 314 F.2d 533 (C.C.P.A. 1963), *In re Moore*, 155 F.2d 379 (C.C.P.A. 1946), and *In re Sus*, 306 F.2d 494 (C.C.P.A. 1962)] merely stand for the undisputed proposition that the claims must be directed to an invention that is identified in the specification.” Exactly. In addition to particularly and distinctly claiming the invention, the specification must also “identif[y]”—in other words, describe—the invention. *See* Pet. Br., at 43 (“describe (identify)”); VII *Oxford English Dictionary* 619 (2d ed. 1991) (defining “identification” to mean “realistic description”). Although petitioners would limit the purpose of that identification to enable others to make and use the invention, the conceded need for a description that provides context for the specific

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<sup>5</sup> The Act of 1952 moved the claiming requirement into a separate

claims confirms that, even in petitioners' view, the description has a role beyond enablement.

In any event, the view that the 1836 Act claiming requirement somehow displaced the description requirement is foreclosed by Supreme Court precedent. Both *Morse* and *Schriber-Schroth* were decided after the 1836 Act, and focused not on any failure to satisfy the claiming requirement but on the failure to describe the invention that was claimed. *See* above at IB.

**C. The Description Of The Invention Requirement Is Critical To Assuring That The Patent Laws Promote Innovation**

The separate description of the invention requirement especially promotes Progress by preventing inventors from amending claims to capture the innovations of others. The precise type of description required in particular contexts should be developed by this Court on a case-by-case basis.

1. *Schriber-Schroth* is instructive as to a particularly critical role played by the description of the invention requirement. There, a second patent at issue was the "Gulick" patent. The Court noted that the

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paragraph where it remains today. *See* 35 U.S.C. § 112.

patentee's original application and claims did not mention flexible webbing; only "after the Long piston, whose webs concededly were laterally flexible, was in commercial use" did Gulick amend his specification and claims. 305 U.S. at 55. This is precisely the type of strategic claim amending that the separate written description requirement precludes. *Id.* at 47 ("The application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed.").

In more modern terminology, the written description requirement "operates as a timing mechanism t[hat] ensure[s] fair play in the presentation of claims after the original filing date and to guard against manipulation of that process by the patent applicant." *PowerOasis Inc. v. T-Mobile*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) (citation omitted). For example, under 35 U.S.C. § 120, "an application for patent for an invention disclosed in the manner provided by" Section 112 "in an application previously filed" "shall have the same effect, as to such invention, as though filed on the date of the prior application." Although this and similar procedures may properly allow inventors to clarify pending or issued claims, the procedures also provide an

opportunity for mischief. Just as the inventor in *Schriber-Schroth* sought to have his claims reach a commercially successful product, patentees may improperly invoke various patent law procedures to alter pending or issued claims in an effort to capture the value of innovation by others. The written description requirement bars this pernicious practice. See Mark Lemley and Kimberly Moore, *Ending Abuse of Patent Continuations*, 84 B.U.L. Rev. 63, 92 (Feb. 2004) (focus “on claims changed during prosecution is consistent with a desire to eliminate one of the core harms of continuation practice, the drafting of new claims designed to capture inventions first made by competitors”). See also, e.g., *Univ. of Rochester v. G.D. Searle & Co.*, 375 F.3d 1303, 1311-12 (Fed. Cir. 2004) (Rader, J., dissenting from denial of en banc review) (noting “necessity of tying disclosure to the time of invention”).<sup>6</sup>

To be sure, the prohibition on adding “new matter” (35 U.S.C. § 132(a)) can prevent some forms of strategic claiming. See, e.g., *TurboCare Div. of Demag Delaval Turbomachinery Corp. v. GE*, 264

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<sup>6</sup> Accord *Brief of Amicus Curiae Novozymes A/S*, at 5 (“traditional written description standard” “requires disclosure of later-claimed subject matter in the originally-filed specification”); *Brief of Amici Curiae The Regents of the University of California, et al.*, at 24 (“the

F.3d 1111, 1118 (Fed. Cir. 2001) (referring to “written description requirement and its corollary, the new matter prohibition”). But in permitting a later application to receive an earlier filing date, Section 120, for example, expressly refers to Section 112. Accordingly, Section 112 itself must limit amendments to those supported by the original written description.<sup>7</sup> In contrast, the statutory prohibition on amendments that add “new matter” is included in a section (35 U.S.C. § 132) that governs the process of the U.S. Patent and Trademark Office’s examination of applications. In any event, that Congress saw fit to provide various routes to prohibit strategic claim amendments merely confirms its desire to bar the harmful practice.<sup>8</sup>

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written description requirement is best returned to its role in the context of determining entitlement to priority”).

<sup>7</sup> See *Brief of Amicus Curiae New York Intellectual Property Law Association*, at 18 (“[B]ecause Sections 119 [benefit of earlier filing date for foreign applications] and 120 refer to Section 112 for determining entitlement to priority, it is not sufficient to rely on Section 132(a) for this purpose and abandon the written description requirement of Section 112.”).

<sup>8</sup> In the patent reissue context, the Supreme Court has relied on the “same invention” requirement to preclude broadening claims beyond what was originally disclosed to the public. *U.S. Indus. Chems. v. Carbide & Carbon Chems. Corp.*, 315 U.S. 668, 678 (1942) (Court has “uniformly held that the omission from a reissue patent of one of the steps or elements prescribed in the original, thus broadening the claims

2. Dicta from this Court's panel opinion in *Bilstad v. Wakalopulos*, 386 F.3d 1116 (Fed. Cir. 2004), stands in tension with the innovation-promoting purpose of the description of the invention requirement, and the Court should take this occasion to disavow it. In *Bilstad*, the Court stated a "general rule that disclosure of a species provides sufficient written description support for a later filed claim directed to the genus." *Id.* at 1125. To the extent *Bilstad* suggests that disclosure of one exemplar (*e.g.*, a combustion engine with rigid webbing) always suffices to support a claim to a genus (*e.g.*, combustion engines), it is inconsistent with the need for the public to know what has been invented. *Cf. Harries v. Air King Products Co.*, 183 F.2d 158, 160 (2d Cir. 1950) (Hand, J.) ("A patent must be a certain guide; not a congeries of pregnant suggestions."). The Court should address and eliminate the confusion caused by the *Bilstad* dicta. *See, e.g., Rambus*,

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to cover a new and different combination, renders the reissue void"). *See also Ry. Co. v. Sayles*, 97 U.S. 554, 563-64 (1878) ("The law does not permit such enlargements of an original specification, which would interfere with other inventors who have entered the field in the mean time, any more than it does in the case of reissues of patents previously granted. Courts should regard with jealousy and disfavor any attempts to enlarge the scope of an application once filed, or of a patent once granted, the effect of which would be to enable the patentee to

*Inc. v. Hynix Semiconductor, Inc.*, 569 F. Supp. 2d 946, 996 (N.D. Cal. 2008) (discussing *Bilstad* and finding a “divergent and confusing [written description] doctrine”).

Similarly, those that argue that the entire purpose of the description of the invention requirement is to enable others to make and use the invention do so in part on the basis that the enablement doctrine can assure that claims do not reach beyond the original disclosure.<sup>9</sup> But, paralleling *Bilstad*, some litigants argue that precedent from this Court suggests, at least in the context of the “predictable” arts, that description of only a single embodiment may be sufficient to enable others to make and use a more generic invention. *See, e.g., Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524 (Fed. Cir. 1987). Description of a single embodiment may not be sufficient “to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be

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appropriate other inventions made prior to such alteration, or to appropriate that which has, in the mean time, gone into public use.”).

<sup>9</sup> *See, e.g., Brief of Amici Curiae Mark D. Janis and Timothy R. Holbrook*, at 5 (“On its own, the enablement doctrine provides the tools for regulating claim scope and ensuring against the claiming of afterthoughts.”); *Brief of Amicus Curiae Law Professor Christopher M.*

safely used or manufactured without a license and which may not.” *Schriber-Schroth*, 305 U.S. at 57. Absent a separate written description requirement, the current enablement doctrine would have to be significantly altered, particularly where the claims are broader than the described embodiment(s). *Cf. Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371 (Fed. Cir. 2007) (invalidating broad claims as not enabled); Bernard Chao, *Rethinking Enablement in the Predictable Arts: Fully Scoping the New Rule*, 2009 Stan. Tech. L. Rev. 3 (2009) (“the enablement doctrine is not well suited to addressing the problem of generic or overbroad claims”).

3. Although Congress requires the patentee to describe the invention, Congress has not further specified the content of that requirement. There are many possible ways to describe an invention. *See, e.g., Regents of Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1569 (Fed. Cir. 1997). As the panel here stated, “[o]f course, what is adequate depends upon the context of the claimed invention.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 560 F.3d 1366, 1372 (Fed. Cir. 2009), *vacated by Order of August 21, 2009*. This Court should “refine the

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*Holman*, at 29 (“enablement doctrine has often been used to police

formulation of the test” for written description “in the orderly course of case-by-case determination.” *Warner-Jenkinson*, 520 U.S. at 40 (“we leave such refinement to that court’s sound judgment in this area of its special expertise”).

\* \* \*

In sum, Section 112 embodies Congress’s desire for inventors to describe their invention in a way that both enables others to make it *and* informs the public of the invention. That congressional purpose remained fully in place after the laws were amended to require inventors to distinctly claim the invention. In particular, the separate description of the invention requirement is critical to assuring that patentees not abuse the system by obtaining claims that reach the innovation of others.

## **II. THIS COURT SHOULD ADOPT THE INTERPRETATION OF SECTION 112 THAT BEST PROMOTES INNOVATION**

In arguing against a separate description of the invention requirement, petitioners devote their primary effort to linguistic discussion of the current text of Section 112. Pet. Br., at 2-8. “Under [the Supreme Court’s] precedent, if the intent of Congress is clear and

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against overly broad claims”).

unambiguously expressed by the statutory language at issue, that would be the end of our analysis.” *Zuni Pub. Sch. Dist. No. 89 v. Dep’t of Educ.*, 550 U.S. 81, 93 (2007). Here, however, requiring a description of the invention separate from one that enables others to make and use the invention is an eminently reasonable interpretation of the statute’s plain language. And because that view best promotes Progress, it best reflects congressional intent and warrants adoption by the full Court.

**A. There Are Two Proposed Readings Of Section 112**

Section 112 provides:

The specification shall contain a written **description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same**, and shall set forth the best mode contemplated by the inventor of carrying out his invention. (bolding, underlining, and italics all added).

35 U.S.C. § 112.

Petitioners begin their textual argument with a noncontroversial premise: “Under a plain reading of the statute, a patent specification must be in writing and must contain a description (i) of the invention,

and (ii) of the manner and process of making and using it.” Pet. Br., at 2. No one dispute this.

Petitioners then state: “The legal adequacy of that written description is then judged by the standard set forth in the final prepositional phrase, which demands that the description be ‘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.’” Pet. Br., at 2-3. In other words, petitioners argue that the italicized phrase (the “final prepositional phrase”) modifies *both* the bolded description “of the invention” requirement and the underlined “of the manner and process of making and using it” requirement. *See In re Barker*, 559 F.2d 588, 594 (C.C.P.A. 1977) (Markey, J., dissenting) (“Congress saved words by specifying, in a single prepositional phrase, that the description of the invention, and the description of the manner of making and using it, shall both be in ‘such full, clear, concise, and exact terms as to enable’”). In this fashion, petitioners read the text of the statute to limit the description of the invention to a description that enables one to make and use the invention.

The other way to read the text of the statute is that the requirement to describe the manner and process of using the invention is addressed to the enablement requirement. On this view, the bolded commas setting off the italicized phrase act as an interjection. That is, a patentee must provide a written description “of the invention” and a description “of the manner and process of making and using it” (such description being “*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*”). Read this way, the italicized phrase modifies the requirement to describe the “manner and process of making and using it” rather than the separate requirement to describe “the invention” itself. *See Enzo Biochem*, 323 F.3d at 971 (Lourie, J., concurring in denial of rehearing en banc) (the separate written description requirement “read[s] the statute so as to give effect to its language,” which “states that the invention must be described”). Thus, Section 112 would include three requirements: “the patent application must describe, enable, and set forth the best mode of carrying out the invention.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002).

None of the linguistic arguments advanced by petitioners establish that one reading forecloses the other. In both readings, the final prepositional phrase modifies an object—either the description of how to make and use the invention or the description of both the invention itself and how to make and use the invention. *See* Pet. Br., at 3. In both readings, the first bolded comma serves a function, either to make the “manner and process of making and using it” run “in parallel” to the description requirement (Pet. Br., at 7) or to interject the italicized phrase to modify the “manner and process of making and using it.” Thus, both readings have “the important benefit of following ordinary rules of English grammar.” Pet. Br., at 3. And, of course, both readings require courts to supply necessary refinement of broad statutory terms.

Notably, if the purpose of the description is solely to enable one to make and use the invention, the underlined language requiring a description “of the manner and process of making and using it” is superfluous. The statute could eliminate that language and would still require a description that taught how “to make and use” the invention. *Accord, e.g., In re Barker*, 559 F.2d at 591-92. Similarly, if the purpose

of the description is solely to enable one to make and use the invention, there is no need for the statute to require a description “of the invention” as well as a description of how to make and use the invention.

Moreover, nothing as a matter of linguistics requires Congress to state expressly the purpose of the common-sense requirement that one must describe the invention one is seeking to patent. *Cf.* Pet. Br., at 6. So too, nothing in the statute would prohibit this Court from ascribing other purposes (*e.g.*, public notice) to the description requirement in order to advance Congressional intent.<sup>10</sup> The requirement of a “written description of the invention” is operative, and certainly nothing in the statute dictates that enablement is the “only reason” Congress mandated a description of the invention. *See Rochester*, 375 F.3d at 1305 (Lourie, J., concurring) (“The statute does not contain a limitation that it pertains only to priority issues.”).

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<sup>10</sup> Along these lines, the Supreme Court recently explained that even a constitutionally stated purpose (“A well regulated Militia, being necessary to the security of a free State”) does not cabin a constitutional requirement (“the right of the people to keep and bear Arms”). *District of Columbia v. Heller*, 128 S. Ct. 2783, 2801 (2008) (“The prefatory clause does not suggest that preserving the militia was the only reason

## **B. The Court Should Read Section 112 To Require A Separate Written Description**

As detailed in Section I above, the purposes of the patent laws are best served by requiring a separate written description of the invention. Because such a requirement “falls within the scope of the statute’s plain language,” *Zuni*, 550 U.S. at 90, the Court should hold that patentees have an obligation to provide a description of their invention that is separate and apart from the obligation to describe how to make and use the invention.

Two traditional tools of statutory construction confirm that Congress intended for patentees to comply with a separate written description requirement. First, “courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community.” *Festo*, 535 U.S. at 739; see *Warner-Jenkinson*, 520 U.S. at 28. The written description requirement currently applied by this Court falls within this “settled” category. This Court, like its predecessor court, has long required a written description of the invention apart from the enablement requirement. See, e.g., *In re*

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Americans valued the ancient right; most undoubtedly thought it even more important for self-defense and hunting.”).

*Ruschig*, 379 F.2d 990, 995-96 (C.C.P.A. 1967) (“traditional” written description requirement achieves “vital purpose” of “tying disclosure to the time of invention”); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555 (Fed. Cir. 1991).

Second, and in light of this long and consistent history of judicial interpretation, the doctrine of congressional acquiescence enhances the force of the current interpretation of Section 112. In *Watson v. United States*, 552 U.S. 74 (2007), for example, the Supreme Court observed that “in 14 years Congress has taken no step to modify [the Court’s prior statutory] holding, and this long congressional acquiescence has enhanced even the usual precedential force [the Court] accord[s] to [its] interpretations of statutes.” *Id.* at 82-83 (citations omitted). Here, this Court and the Supreme Court have applied a statutory interpretation for far longer than 14 years, and Congress has taken no step to modify that holding. Accordingly, this judicial precedent has “enhanced” precedential force.

Here, consistent with *Evans*, *Morse*, and *Schriber-Schroth*, the original panel opinion properly held that the patentee’s broad claims are invalid in light of the description of the invention requirement. As

the panel opinion noted, “Ariad chose to assert claims that are broad far beyond the scope of the disclosure provided in the specification.” *Ariad*, 560 F.3d at 1377. The original panel opinion properly reversed the district court’s conclusion that the expansive claims were permissible despite the narrow description of the invention.

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In light of the statutory purpose and text, as well as traditional tools of statutory interpretation, the Court should hold that under Section 112 the patentee must provide a written description of the invention that is separate from the requirement to provide a description that enables the public to make and use the invention once the patent expires.<sup>11</sup>

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<sup>11</sup> If, contrary to the position urged here, the Court elects to eliminate the separate written description of the invention requirement, pending appeals raising written description issues should be remanded for trial proceedings under the new understanding of the law. See Eugene Gressman, *et al.*, Supreme Court Practice 251 n.31, 348 (9th ed. 2007) (noting Court’s “not infrequent” practice of issuing an order granting a petition for certiorari, vacating decision below, and remanding for further proceedings in light of recent Supreme Court decisions); Order, *Aviall Servs., Inc. v. Cooper Indus., Inc.*, No. 00-10197, at 1-2 (5th Cir. Feb. 15, 2005) (en banc) (remanding case with instructions to permit [plaintiff] . . . to amend its complaint, if necessary, to assert, free of any challenge of waiver or forfeiture, whatever statutory claims it urges in light of the Supreme Court’s

### III. THE COURT SHOULD HOLD THAT COMPLIANCE WITH THE WRITTEN DESCRIPTION REQUIREMENT IS A QUESTION OF LAW

Because the Court is already sitting en banc to consider the scope and purpose of the written description requirement, the Court can and should revisit the question of whether compliance with the written description requirement is ultimately a question of fact or a question of law.<sup>12</sup>

*Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), involved the same type of interpretative questions that are at issue here. There, the Court held that the process of claim construction is a question of law for the court, not a question of fact for the jury. *Id.* at 384-90. Quoting Justice Benjamin Robbins Curtis, a former patent practitioner, the Court observed that “construing the letters-patent,

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decision); *Sanko S.S. Co., Ltd. v. United States*, 272 F.3d 1231, 1232 (9th Cir. 2001) (“Since the time that the district court issued its decision, however, the United States Supreme Court reversed [a previous decision] and established a more restrictive test for determining sovereign immunity. . . . Because this new test involves determination of facts that have not been fully developed, we reverse and remand for further proceedings in light of the Supreme Court’s . . . decision.”).

<sup>12</sup> See, e.g., *Ralston Purina Co. v. Far-Mar-Co.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985); *In re Ruschig*, 379 F.2d 990 (C.C.P.A. 1967); see

and the *description* of the invention” was “a question of law.” *Id.* at 384 (quoting *Winans v. Denmead*, 56 U.S. 330, 338 (1853)) (emphasis added). In addition to this established practice, the *Markman* Court also relied on “the relative interpretive skills of judges and juries,” noting that “[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis.” *Id.* at 389. Furthermore, the Court recognized that “the importance of uniformity in the treatment of a given patent [i]s an independent reason to allocate *all* issues of construction to the court.” *Id.* at 390 (emphasis added).

Also instructive is *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). There, the Supreme Court reversed this Court’s conclusion that an existence of a dispute over a material fact precluded summary judgment. The Supreme Court stated: “The ultimate judgment of obviousness is a legal determination. Where, as here, the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute, and the obviousness of the claim is

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also Robert Green Sterne, *et al.*, *The Written Description Requirement*, 37 Akron L. Rev. 231, 234 (2004).

apparent in light of these factors, summary judgment is appropriate.”

*Id.* at 426-427 (citations omitted).

The Court’s decisions in *Markman* and *KSR* provide strong reason for this en banc Court to hold that satisfaction of the written description requirement is a question of law. Like claim construction, the inquiries mandated by the written description requirement turn on an interpretation of the “description,” a task, as Justice Curtis noted and the Court explained, best performed by judges. Like obviousness, the failure of a claim to meet the written description requirement may be apparent where the content of the prior art, the scope of the patent claim, and the level of ordinary skill in the art are not in material dispute.

Indeed, the panel here essentially held that the failure to meet the description requirement is a question of law. The panel in this case stated, without qualification, that, where “asserted claims are far broader” than the accompanying disclosure, a “jury lack[s] substantial evidence for [a] verdict that the asserted claims were supported by adequate written description.” *Ariad*, 560 F.3d at 1376. Although there may be underlying questions of fact upon which the evaluation of a

written description is based, *see In re Ruschig*, 379 F.2d at 996, the “ultimate judgment” of that description’s adequacy of the description must, like the questions of claim construction and obviousness, be “a legal determination.” *KSR*, 550 U.S. at 427. The Court should make explicit that compliance with the written description requirement is ultimately a question of law.

### CONCLUSION

The Court should hold that the 35 U.S.C. § 112, paragraph 1, contains a written description requirement separate from an enablement requirement. The Court should also hold that satisfaction of the written description requirement is a question of law.

\* \* \*

Respectfully submitted,

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November 19, 2009

## CERTIFICATE OF FILING AND SERVICE

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## CERTIFICATE OF COMPLIANCE

(No. 2008-1248)

Counsel for *amicus curiae* certifies that the brief contained herein has a proportionally spaced 14-point typeface, and contains 6,562 words, based on the “Word Count” feature of Microsoft Word, including footnotes and endnotes. Pursuant to Federal Rule of Appellate Procedure 32(a)(7)(B)(iii) and Federal Circuit Rule 32(b), this word count does not include the words contained in the Certificate of Interest, Certificate of Filing and Service, Table of Contents, and Table of Authorities.

Dated: November 19, 2009

Respectfully submitted,



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