No. 02-289

IN THE

Supreme Court of the United States

R. BRENT JOHNSON, *et al.*,

Petitioners,

v.

I/O CONCEPTS, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF OF AMICI CURIAE SOLARC, INC., SAFETY TRAINING SYSTEMS, INC., AND GAZOO, LLC IN SUPPORT OF PETITIONERS

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INTEREST OF AMICI CURIAE[1]

SolArc, Inc. is a software development firm that provides trade management technology for the financial and physical marketing of energy commodities. SolArc's flagship product is currently used by the majority of the leading energy commodity market makers, and by oil and gas producers, refiner/marketers, and coal producers. Because it constantly seeks to develop or acquire innovations to improve its products, SolArc has a strong interest in issues of patent protection. And because it also has an abiding faith in the American public, SolArc has an interest in seeing that juries are allowed to serve their constitutional role in such patent protection.

[1] This brief is filed with the written consent of all parties. No counsel for a party authored this brief in whole or in part, nor did any person or entity, other than *amici* or their counsel, make a monetary contribution to the preparation or submission of this brief.

Safety Training Systems, Inc. (STS) is a privately held corporation specializing in the design and manufacture of custom training devices, such as flight simulators, for the airline and defense industries. STS is constantly looking at innovative means of design and production of its devices, either through development or acquisition of patentable processes and tools, or through use of innovations available in the public domain. The legal regime for defending patent rights, defending against potential infringement claims, and for being enabled to use inventions at the expiration of their patent terms are thus of substantial importance to STS.

Gazoo, LLC is a real estate holding company that leases to numerous high technology companies, including companies involved in the patent-intensive field of wireless communications services. Its interest in the operation of the patent system stems from its close involvement with, and dependence upon, its tenants, who in turn require the effective operation of patent law for their own business success. Gazoo thus has an interest in all of the legal and other factors that support the industries and companies with whom it does business.

SUMMARY OF ARGUMENT

The Federal Circuit's decision to treat enablement as an issue of law for the court, rather than as an issue of fact for the jury, conflicts with the position taken by at least three courts of appeals prior to the Federal Circuit's creation. The conflict between current Federal Circuit law and prior circuit court law serves as a useful indication that the issue merits this Court's attention.

The Federal Circuit's treatment of enablement as a legal issue squarely conflicts with this Court's holdings that enablement is a factual issue for the jury. Because the Federal Circuit lacks any basis for its departure from this Court's precedent, its position constitutes plain error that this Court can reach out to correct regardless of whether the issue was raised or resolved below.

ARGUMENT

The issue of enablement plays a significant role in the patent system. Requiring that a patent specification describe the invention in terms sufficient to, *inter alia*, "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," 35 U.S.C. § 112 ¶ 1, implements part of the central *quid pro quo* of the patent system – the ready availability of the invention to the public upon expiration of the patent. A patent specification that does not enable others to use the invention thus fails in its performance of the fundamental bargain and is invalid. The central role of enablement thus places it potentially at issue in every patent case and it often is the dispositive question in litigation.

Enablement also plays a further role in connection with continued or amended patents, where it serves as one of the measures for whether a subsequently filed application relates back to an earlier application. Relating back to an earlier filing date can mean the difference between a valid and an invalid patent, particularly where, as in this case, an invention has been sold or used close in time to the initial application but more than a year before the subsequent application. Pet. App. 3a-4a.

The recurring importance of the enablement issue in patent litigation provides ample reason why the proper constitutional treatment of the enablement issue is of great interest to potential patent litigants and should be of similarly great interest to this Court. In *amici*'s view, courts should jealously protect the Seventh Amendment right to a jury trial on such a central and fact-intensive issue as enablement. With no disrespect to the many able judges trying patent cases, the Constitution places greater faith in the common touch of the public when it comes to determining facts, and litigating members of the public may likewise repose more confidence in their peers than in a seemingly distant judge. *Amici* each repose great

confidence in juries and believe that overall confidence in the patent system depends in no small part on maintaining the connection between that system and the public. The Federal Circuit's approach undermines that connection and is in conflict with past circuit court decisions and decision from this Court. This Court thus should grant certiorari to review the erroneous exclusion of juries from the enablement issue.

I. THE FEDERAL CIRCUIT'S CATEGORIZATION OF ENABLEMENT AS A LEGAL ISSUE FOR THE COURT CONFLICTS WITH EARLIER PRECEDENT FROM OTHER COURTS OF APPEALS.

While the Federal Circuit's treatment of enablement is well established, Pet. 7, it nonetheless conflicts with the treatment of enablement by at least three different courts of appeals prior to the Federal Circuit's creation. For example, the Ninth Circuit had squarely held that the "ability of 'any person skilled in the art' to reproduce the product was a question for the trier of fact." *Locklin* v. *Switzer Bros., Inc*., 299 F.2d 160, 166 (CA9), *cert. denied*, 369 U.S. 861 (1962); *see also*, *Research Products Co.* v. *Tretolite Co.*, 106 F.2d 530, 533 (CA9 1939) (question of "whether or not these descriptions of the chemical agent to be used in the process are sufficiently clear and definite to be understood and applied by those engaged in the art * * * is one of fact to be ascertained by the evidence of experts"); *Schumacher* v. *Buttonlath Mfg. Co.*, 292 F. 522, 532 (CA9 1920) ("With respect to the remaining objection, that there was an insufficient disclosure of the use of paper or other like material for retarding the absorption of moisture, the question was one of fact.").

Similarly in the Seventh Circuit, in a case tried before a judge, the Court of Appeals recognized long-established precedent that "whether or not a patent claim is sufficiently specific to comply with the statute is a question of fact, except as to the construction of the written words used, to be decided by the trial court, or jury." *Bank* v. *Rauland Corp*., 146 F.2d

19, 22 (CA7 1945) (citing cases). The court proceeded to affirm the finding below that the patent's "description is not in such full, clear, concise and exact terms as to enable one skilled in the art to make and use the same," and that "one skilled in the art could not, without extensive experimentation, construct [the patented] system, nor make it function in the manner described in the patent." *Id*. at 21-22; *see also*, *Refrigeration Patents Corp.* v. *Stewart-Warner Corp.*, 159 F.2d 972, 975 (CA7) ("the sufficiency of description of a claim, under the foregoing statute [predecessor to § 112 ¶ 1], is a question of fact for the jury or trial court"), *cert. denied*, 331 U.S. 834 (1947).

Finally, the Fourth Circuit held, in *Tights, Inc.* v. *Stanley*, 441 F.2d 336, 338 (CA4), *cert. denied*, 404 U.S. 852 (1971), that the appellant was "entitled to determination by a jury of any factual questions related to the validity and infringement issues." In the course of that opinion the Fourth Circuit specifically relied upon this Court's decision in *Battin* v. *Taggert*, 58 U.S. (17 How.) 74 (1854), which it considered "typical" of numerous cases wherein "issues of validity and infringement have been held * * * to present questions of fact for resolution by the jury." 441 F.2d at 342-43. Indeed, the court proceeded to quote *Battin* for the proposition that it "'was the right of the jury to determine from the facts in the case, whether the specifications, including the claim, were so precise as to enable any person skilled in the structure of machines, to make the one described.'" *Id*. at 343 (citation omitted).

Other federal courts also have held enablement to present issues of fact for the jury. *See, e.g.*, *Davis* v. *Palmer*, 7 F. Cas. 154, 158 (C.C.D. Va. 1827) (Marshall, C.J.) ("it is within the province of the jury to decide, whether a skilful workman can carry into execution the plan of the inventor"); *Lowell* v. *Lewis*, 15 F. Cas. 1018, 1021 (C.C.D. Mass. 1817) (Story, J.) (charging a jury: "the question here is, and it is a question of fact, whether the specification be so clear and full,

that a pump maker of ordinary skill could, from the terms of the specification, be able to construct one upon the plan of Mr. Perkins.").

While the Federal Circuit claims support for its contrary position in cases from the Court of Customs and Patent Appeals, and from the Tenth Circuit and D.C. District Court, *Raytheon Co.* v. *Roper Corp.*, 724 F.2d 951, 960 n. 6 (CA Fed. 1983), *cert. denied*, 469 U.S. 835 (1984) (discussed *infra* at 9-10), those cases at best only deepen the conflict and, in any event, generally do not support the Federal Circuit's current position. For example, the Federal Circuit's citation to *Plastic Containers Corp.* v. *Continental Plastics of Oklahoma, Inc.*, refers to a patent *regulation* requiring certain definitions to be included in the specification, and describes the regulation as a conclusion of law, not the enablement question in general. 607 F.2d 885, 891-92 n. 9 (CA10 1979), *cert. denied*, 444 U.S. 1018 (1980). And *Hirschfeld* v. *Banner* drew only a distinction between the "ultimate legal question of enablement" and "factual evidence directed to the amount of time and effort and level of knowledge required for practice of the invention from the disclosure alone," concluding that "witnesses here testified to facts establishing enablement." 462 F. Supp. 135, 142 (D.D.C. 1978), *aff'd*, 615 F.2d 1368 (CADC 1980), *cert. denied*, 450 U.S. 994 (1981)). That discussion in *Hirschfeld* thus better supports petitioners' view that enablement presents fact questions for the jury than it does the Federal Circuit's contrary approach.

While the conflict among the lower courts is somewhat vestigial given the exclusive jurisdiction of the Federal Circuit, this Court nonetheless will review Federal Circuit decisions when "other courts have held or assumed" the contrary. *Pfaff* v. *Wells Electronics, Inc.*, 525 U.S. 55, 60 (1998). As Justice Stevens has observed, conflicts between the Federal Circuit's decisions and those of other circuits on "patent issues" are "useful in identifying questions that merit this Court's attention." *Holmes Gp.* v. *Vornado Air Circulation*

Sys., 122 S. Ct. 1889, 1897-98 (2002) (Stevens, J., concurring in part and concurring in the judgment)); *see also* CHISUM ON PATENTS § 6.02 ("[P]re-1983 decisions of the regional circuits will continue to carry weight with the Supreme Court when it considers issues of patent law."). The conflict between the Federal Circuit and other circuits on the treatment of the enablement issue thus demonstrates that the petition presents an important question that merits the attention of this Court.

II. THE FEDERAL CIRCUIT'S TREATMENT OF ENABLEMENT AS A LEGAL QUESTION IS PLAIN ERROR.

As petitioners properly note, Pet. 7-8, enablement is a jury question under the two-part test described in *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370 (1996). There is no question that patent infringement was a cause of action tried to a jury and falls generally within the Seventh Amendment's guarantee. Likewise, there is ample historical evidence that the issue of whether a patent disclosure enabled production of the patented invention was routinely tried to a jury both in the United States and England. Pet. 8-10.

But what move the Federal Circuit's approach from mere error to plain error are this Court's discussions of enablement going back over 150 years, which confirm beyond all doubt that enablement is a question of fact to be determined by a jury. In *Wood v. Underhill*, for example, this Court noted the requirement that the "specification must be in such full, clear, and exact terms as to enable any one skilled in the art to which it appertains to compound and use the invention," and stated that in "patents for machines the sufficiency of the description must, in general, be a question of fact to be determined by the jury." 46 U.S. (5 How.) 1, 4 (1847). As to the specific patent at issue in that case, the Court held that because there was no obvious impossibility of enablement evident from the face of the specification, "whether the fact is so or not is a question to be decided by a jury, upon the evidence

of persons skilled in the art to which the patent appertains." *Id*. at 5-6.

Similarly in *Battin* v. *Taggert*, this Court held that

> [i]t was the right of the jury to determine, from the facts in the case, whether the specifications, including the claim, were so precise as to enable any person skilled in the structure of machines, to make the one described. This the statute requires, and of this the jury are to judge.

58 U.S. (17 How.) 74, 85 (1854). Both *Wood* and *Battin* remain good law, and are not in the least bit ambiguous on the issue of enablement being a factual determination for the jury.

More recently in *Markman*, this Court confirmed that the determination of enablement was a factual issue for the jury. Expressly distinguishing enablement from the claim construction performed by the judge, this Court observed that at "the time relevant for Seventh Amendment analogies," typical patent litigation consisted, *inter alia*, of "'enablement' cases, in which juries were asked to determine whether the specification described the invention well enough to allow members of the appropriate trade to reproduce it." 517 U.S. at 379.

Overall, this Court's discussions of enablement as a fact question for the jury, as well as the English cases cited by petitioners, Pet. 8-10, provide "clear historical evidence that the very subsidiary question was so regarded under the English practice of leaving the issue for a jury." *Markman*, 517 U.S. at 377. The allocation of the specific issue of enablement to the jury is thus "easy," *id*., and the Federal Circuit's contrary allocation is plain error.

Given what appears to be a perfectly uncomplicated application of Seventh Amendment jurisprudence, this Court might reasonably wonder how the Federal Circuit has gotten it wrong for so many years.

The Federal Circuit issued no opinion in this case, and the district court had no occasion to discuss the issue given that

petitioners understandably felt bound by long-established – but erroneous – Federal Circuit precedent that the sufficiency of a disclosure for enablement purposes is a question of law. *See* Pet. App. 6a (district court discussion of legal standard). The Federal Circuit precedent cited by the district court, however, either does not support the proposition at all or states only the bald conclusion that enablement is a legal issue for the court, without discussing this Court's contrary precedent. *See Reiffen* v. *Microsoft*, 214 F.3d 1342, 1346 (CA Fed. 2000) (seemingly inapposite); *Utter* v. *Hiraga*, 845 F.2d 993, 998 (CA Fed. 1988) ("We review the enablement aspect of 35 U.S.C. § 112 ¶ 1 as a question of law.").

Tracking the history of Federal Circuit precedent on this issue provides no more enlightenment as to the justification for that court's error. For example, in *Amgen, Inc.* v. *Chugai Pharmaceuticals Co.*, the Federal Circuit offered only the bare conclusion that "[w]hether a claimed invention is enabled under 35 U.S.C. § 112 is a question of law, which we review *de novo*." 927 F.2d 1200, 1212 (CA Fed.), *cert. denie*d, 502 U.S. 856 (1991). Earlier Federal Circuit cases are no more compelling, with one-sentence conclusions citing back to still further one sentence conclusions. *See Moleculon Research Corp.* v. *CBS, Inc.*, 793 F.2d 1261, 1268 (CA Fed. 1986) ("We review * * * enablement as a question of law.") (merely citing similarly cryptic cases), *cert. denied*, 479 U.S. 1030 (1987); *Cross v. Iizuka*, 753 F.2d 1040, 1044 n. 7 (CA Fed. 1985) ("Enablement under § 112, paragraph 1, *i.e.*, the how-to-use requirement, is a question of law"); *Lindemann Maschinenfabrik GMBH* v. *American Hoist & Derrick Co.*, 730 F.2d 1452, 1463 (CA Fed. 1984) ("Enablement is a legal issue."); *Raytheon*, 724 F.2d at 960 n. 6 ("Enablement under 35 U.S.C. § 112, paragraph 1, is a question of law.").

The earlier Federal Circuit cases primarily rely on language in opinions from the Court of Customs and Patent Appeals, and therein may be the original source of the Federal Circuit's error. *Raytheon*, for example, bases its conclusion

on bare citations to several such cases. 724 F.2d at 960 n. 6 (including citations to *In re Hogan*, 559 F.2d 595, 604 (C.C.P.A. 1977); *In re Brandstadter*, 484 F.2d 1395, 1405 (C.C.P.A. 1973); *In re Naquin*, 398 F.2d 863, 866 (C.C.P.A. 1968); and *In re Chilowsky*, 306 F.2d 908, 909 (C.C.P.A. 1962). But *Hogan* was addressing the rather different question of the *time period* framing the enablement determination – *i.e.*, whether an invention must be enabled as of the filing date or as of some later date – and in that context stated that "Courts should not treat the same legal question, enablement under § 112, in one manner with respect to the applicant and in a different manner with respect to the examiner." 559 F.2d at 604.

Brandstadter similarly arose in an unrelated context and merely described and rejected conclusory expert opinions "on the ultimate legal question whether the specification is enabling." 484 F.2d at 1405. But the distinction between an "ultimate" legal question and its subsidiary factual components is quite different than the fact/law dichotomy often used to determine jury issues and does not even remotely support the Federal Circuit's current position. Indeed, the remainder of the *Brandstadter* opinion thoroughly contradicts the Federal Circuit's misuse of that case by treating enablement as a factual issue. *Id*. (observing that "the evidence * * * was not sufficient to prove to the satisfaction of the examiner or the board that one of ordinary skill in the art could practice the invention without undue experimentation"; board and examiner viewed "affidavit evidence as being generally conclusory statements, rather than showing facts which would" establish enablement); *id*. at 1407 (finding that "the board reasonably determined that the examiner was correct in holding that appellants have not proved" enablement).

In *Naquin*, the court again drew distinctions only between "ultimate" legal issues and subsidiary facts, but overall treated enablement as a factual issue, not a legal issue. 398 F.2d at 866 ("We agree with the board that the affiant's opin-

ions on the ultimate legal issue are not evidence in the case. * * * However, we think that statements of fact, however commingled with inadmissible assertions, ought to be considered."; holding that given such evidence, and in "the absence of a challenge to the affiant's qualifications or, at the very least, a contrary inference by the board or examiner from the other evidence, we are unable to hold that this record supports the board's affirmance"); *see also, id.* (noting that the board reviewed the examiners determination on enablement for whether it "was clearly erroneous" – the standard applied to issues of fact, not law); *id.* at 865 ("We find no substantial basis in this record to support the board's decision" regarding enablement).

Finally, while *Chilowsky* describes the enablement question as "primarily one of law," 306 F.2d at 909, it goes on to echo the "ultimate legal conclusion" language discussed above, *id*. at 912. *Chilowsky* then draws the same distinction discussed above regarding opinions stating a legal conclusion of enablement as opposed to subsidiary facts, and concludes that "[w]e have been unable to find in the facts which the affidavits support a basis for deciding that Chilowsky has complied with the requirement of section 112." *Id*. at 912, 916. *Chilowsky*'s general description of enablement as a legal issue but treatment of it as a factual question thus provides only dubious support for the Federal Circuit's subsequent treatment of enablement as a question of law for the court.

After backtracking through Federal Circuit precedent, therefore, the only underpinning for the Federal Circuit's position seems to be an anomalous misinterpretation of loose language in earlier enablement cases. But through time and the ossification of precedent, that misunderstanding has become the established rule, so settled that it is not even questioned.

But while settled, the rule has never been cogently justified, and in fact is incoherent when compared to other Federal Circuit law regarding classification of factual and legal issues.

The first paragraph of § 112, for example, also contains a requirement that an inventor disclose the "best mode" of practicing his invention in addition to disclosing instructions sufficient to "enable" a person skilled in the arts to make the invention. In *Amgen* the Federal Circuit applied its longstanding precedent that the "determination whether the best mode requirement is satisfied is a *question of fact*." 927 F.2d at 1209 (emphasis added). The best mode requirement, however, itself contains an embedded enablement element such that the fact-finder must inquire whether the "disclosure is adequate to enable one skilled in the art to practice the best mode." *Id*. Yet when turning to the enablement requirement in general, the *Amgen* opinion categorizes that as "a question of law." 927 F.2d at 1212. That two functionally identical inquiries – enablement of the invention in general and enablement of the best mode of that invention – can be treated divergently as questions of law and fact, respectively, suggests a breakdown in reasoning and further confirms the Federal Circuit's plain error.[2]

[2] The incoherence of the Federal Circuit's rule is also highlighted by the overlap in issues between the statutory requirement of enablement in § 112 and the requirement of non-obviousness in § 103. In determining the "ultimate" legal issue of validity, the requirement of non-obviousness "lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Graham* v. *John Deere Co*., 383 U.S. 1, 17 (1966); *see Tights*, 441 F.2d at 339 n. 3 ("The circuits have specifically held that under *Graham* v. *John Deere* the questions of what the prior art was, what improvement the patents have effected, and the level of ordinary skill in the pertinent art are factual in nature; only the ultimate question of obviousness is one of law.") (citing cases).

III. THIS COURT CAN REACH PLAIN ERROR IN A CASE FROM FEDERAL COURT EVEN IF NOT RAISED OR RESOLVED BELOW.

While this Court ordinarily requires that questions in a petition first be raised and resolved in the lower courts, it has occasionally made exceptions to that rule. The Court has observed, for example, that "the rule is not inflexible" and has reached issues neither "rested upon" in, nor "addressed" by, the lower courts, "at least to the extent of vacating the judgment below and remanding the case for consideration of the" previously neglected issue. *Youakim* v. *Miller*, 425 U.S. 231, 233-34 (1976). In cases coming to this Court from the federal courts, the failure to specifically raise an issue is not a jurisdictional defect, this Court thus has the authority to review issues raised first in the petition for certiorari, and it will do so in "exceptional cases." *Duignan* v. *United States*, 274 U.S. 195, 200 (1927).

Plain error by the courts below can, in certain cases, constitute such an "exceptional" basis for this Court's discretionary review. In *United Brotherhood of Carpenters & Joiners of America* v. *United States*, for example, this Court noted that while the defendant had not taken exception to the charge in the court below,

> we would not be precluded from entertaining the objection. The erroneous charge was on a vital phase of the case and affected the substantial rights of the defendants. We have the power to notice a 'plain error' though it is not assigned or specified."

330 U.S. 395, 411-12 (1947) (footnote omitted).

Likewise in *United States* v. *Mendenhall*, this Court found "exceptional circumstances to "consider the Government's contention that there was no seizure of the respondent in this case, because the contrary assumption, embraced by the trial court and the Court of Appeals, rests on a serious misapprehension of federal constitutional law." 446 U.S. 544, 551-52

n. 5 (1980); *see also Vance* v. *Terrazas*, 444 U.S. 252, 258-59 n. 5 (1980) ("consideration of issues not present in the jurisdictional statement or petition for certiorari and not presented in the Court of Appeals is not beyond our power, and in appropriate circumstances we have addressed them."); *cf.* S. CT. RULE 24.1(a) (noting, in connection with petitioner's brief on the merits, that "[a]t its option, however, the Court may consider a plain error not among the questions presented but evident from the record and otherwise within its jurisdiction to decide").

In this case, the plain error of the Federal Circuit rule denying the substantial constitutional right of trial by jury provides this Court with grounds for finding exceptional circumstances for review.

CONCLUSION

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

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Dated: October 25, 2002.