

18-1049

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ALFONSO CIOFFI, MELANIE ROZMAN, MEGAN ROZMAN, MORGAN ROZMAN,
Plaintiffs-Appellees

v.

GOOGLE LLC,
Defendant-Appellant

On appeal from the United States District Court for the Eastern District of Texas
in No. 2:13-cv-00103-JRG, Chief Judge J. Rodney Gilstrap

GOOGLE'S RESPONSE TO THE PETITION FOR REHEARING

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June 12, 2023

CERTIFICATE OF INTEREST

I certify that the information below is complete to the best of my knowledge.

Date: June 12, 2023

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5. Related Cases

none

6. Organizational Victims and Bankruptcy Cases

none

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TABLE OF ABBREVIATIONS AND CONVENTIONS

Appx ____	appendix page ____
Google	defendant Google LLC (formerly Google Inc.)
JMOL	judgment as a matter of law
Pet.	Plaintiffs' combined petition for panel rehearing and rehearing en banc
Plaintiffs	plaintiffs Alfonso Cioffi and Melanie, Megan, and Morgan Rozman
RB ____	Plaintiffs' response brief, page ____
(xx:yy-zz)	column xx, lines yy-zz of a patent
'247 patent	U.S. Patent No. 7,484,247 (surrendered upon reissue)
RE'500 patent	U.S. Reissue Patent No. RE43,500
RE'528 patent	U.S. Reissue Patent No. RE43,528
RE'529 patent	U.S. Reissue Patent No. RE43,529

INTRODUCTION

Plaintiffs ask the panel and the en banc Court for rehearing on an issue that was resolved by a unanimous, non-precedential opinion that faithfully applied longstanding Federal Circuit and Supreme Court precedent. That opinion broke no new ground. It did not alter the landscape for invalidity under 35 U.S.C. § 251. And it did not overlook any point of law or fact. Instead, the panel applied an established legal standard to four related reissue claims and concluded that those claims failed to satisfy the statutory original-patent requirement.

Displeased with the outcome, Plaintiffs offer various theories of why they should have prevailed—some new, some recycled, all mistaken. Plaintiffs’ request to exempt “narrower” reissue claims from the original-patent requirement is new on rehearing. It also conflicts with the doctrine’s long history and has no basis in the statute. Controlling law likewise forecloses Plaintiffs’ effort to equate the original-patent requirement of § 251 with the substantively and statutorily distinct written-description standard of § 112. Plaintiffs’ misplaced policy appeals and citation-free arguments imputing nonexistent disclosures into the original specification also miss the mark.

In short, nothing in Plaintiffs’ petition comes close to warranting rehearing by the panel or the full Court. The petition should be denied.

BACKGROUND

A. The original-patent requirement of 35 U.S.C. § 251

This appeal involved 35 U.S.C. § 251(a), which permits “[r]eissue of defective patents” subject to certain restrictions. The restriction relevant here is the original-patent requirement, which requires a reissue patent to be “for the invention disclosed in the original patent.” The current statutory language carries forward § 64 of the previous Patent Act, which similarly required that reissue patents be issued only for the “same invention” as the original patent. The requirement has existed in U.S. patent law since 1836. *See Battin v. Taggert*, 58 U.S. 74, 82, 84-85 (1854).

As this Court has recognized, the Supreme Court has consistently enforced the original-patent requirement. Under that standard, it is *not* enough that the original specification “suggested or indicated” the later reissue claims; instead, the original patent must have “clearly and unequivocally disclose[d] the newly claimed invention as a separate invention.” *Antares Pharma., Inc. v. Medac Pharma Inc.*, 771 F.3d 1354, 1358-62 (Fed. Cir. 2014) (citing numerous Supreme Court cases, including *U.S. Indus. Chems., Inc. v. Carbide & Carbon Chems. Corp.*, 315 U.S. 668 (1942)).

B. The original ’247 patent

U.S. Patent 7,484,247 issued in January 2009. Appx89-111. The specification asserted that extensive memory sharing among programs and communications between systems left computers vulnerable to malware attacks that could compromise

critical files despite existing computer-security techniques. Appx104 (5:26-50, 6:24-30). The disclosed and claimed solution was “isolating the network interface program from the main computer system, such that the network interface program does not share a common memory storage area with other trusted programs.” Appx105 (7:1-16). In essence, the ’247 patent called for a “sandboxing” approach that protected a safe portion of the computer’s memory from programs that were engaging with potentially hazardous outside content from network sources.

In particular, the ’247 patent described security architectures using two processors, P1 and P2, and corresponding first and second memory spaces M1 and M2. *See slip op. 5; Appx106 (9:30-39, 10:29-46), Appx91 (Fig. 1)*. The disclosed systems isolated the source of potential malware by allowing only the second processor to access the network and blocking the second processor from accessing the first memory. Appx106 (10:29-63). The second processor and memory thus “act[ed] as a separate computer system” for handling processes that required network communications, such as web browser or email processes, enabling the first processor and memory to remain safe from malware. Appx107 (11:1-14); slip op. 5-6.

The original ’247 patent thus described and claimed multi-processor systems running first and second logical processes, with the second, network-connected processor running in a protected mode that was isolated from, and thereby prevented corruption of, the first memory space. *See Appx110-111*. The ’247 patent nowhere

described running *two web browser* processes—one associated with each memory space. Rather, the '247 patent described systems that ran only a single web browser process. Appx106-107 (10:64-11:14); Appx109 (16:30-43).

C. The reissue patents-in-suit

After the inventors obtained the '247 patent, they became aware of Google's Chrome web browsing software, which used a multi-process architecture, and they filed broadening reissue applications with claims reciting the use of *multiple* web browser processes hoping those would cover Chrome. Appx4187-4188, Appx4136-4137, Appx4146, Appx4150. The reissue applications resulted in a family of reissue patents, including the RE'500, RE'528, and RE'529 patents at issue in this appeal.

The claims asserted here all require a “first web browser process” and a “second web browser process.” Appx136-137 (RE'500 claim 43); Appx160 (RE'528 claim 5), Appx163-164 (RE'528 claim 67); Appx189-190 (RE'529 claim 49).

D. This litigation

1. The district court credited testimony from Plaintiffs' technical expert in concluding that the reissue claims satisfied the original-patent requirement of § 251

At trial, the jury found that the asserted claims were infringed and had not been proven invalid. Slip op. 7. Google moved for JMOL arguing, among other things, that invalidity under the original-patent requirement was an issue for the court, not the jury, to resolve, and that the asserted claims failed to satisfy that

requirement as a matter of law. Appx5634-5642. The district court recognized that it had erred in submitting that issue to the jury and called for additional briefing, but it eventually rejected Google’s contention that the original ’247 patent’s specification did not clearly and unequivocally describe two web browser processes. Slip op. 7-8. In so holding, the district court relied on testimony from Plaintiffs’ technical expert, who asserted that a skilled artisan reading the ’247 patent’s specification would have inferred that the first and second processors could both be running web browser processes. *Id.* The district court thus held that the reissue claims satisfied the original-patent requirement. Google appealed.

2. The panel reversed because under settled precedent, inferences by a skilled artisan cannot substitute for the clear and unequivocal disclosure required by § 251

On appeal, Google renewed its arguments that the original ’247 patent did not clearly and unequivocally describe using two web browser processes as recited in the asserted reissue claims, and it maintained that the testimony from Plaintiffs’ expert could not bridge that gap under § 251. The panel unanimously agreed. In a non-precedential opinion, the panel explained that compliance with the original-patent requirement demands clear and unequivocal disclosure in the original patent itself. Slip op. 9-10. The invention claimed on reissue thus must have been more than “‘suggested or indicated’” by the original specification. *Id.* (quoting *Forum US, Inc. v. Flow Valve, LLC*, 926 F.3d 1346, 1351 (Fed. Cir. 2019) (cleaned up)).

The asserted reissue claims did not meet that standard. Applying Federal Circuit and Supreme Court precedent, the panel rejected the district court’s reliance on expert testimony to supplement the original patent’s disclosure. Slip op. 10-12. Such testimony about what a skilled artisan “would purportedly understand” from the original specification was insufficient under the original-patent requirement because compliance with that standard depends on “what is apparent *from the face of the instrument.*” *Id.* at 11-12. Because a skilled artisan would have had to make a series of inferences to get from the disclosures of the original ’247 patent to the asserted reissue claims reciting two web browser processes, the claims were invalid under § 251. *Id.* at 12-14.

ARGUMENT

A. This appeal turned on the original-patent requirement of § 251, not the ordinary § 112 written-description standard or a “word-for-word” test

Plaintiffs’ petition rests on a mistaken premise: it equates § 251’s original-patent requirement with the standard for adequate written description under § 112. The petition downplays § 251 as requiring only a “written-description-type” analysis. Pet. 12, 14. And Plaintiffs frame that analysis as being substantively identical to the written-description test. *See, e.g.*, Pet. 3 (contending that the panel’s invalidity ruling “conflicts with established *written-description* law”) (emphasis added), 9 (suggesting that the claims should “survive Defendant’s challenge” under § 251

because Google did not *also* assert invalidity for lack of written description at trial), 15 (citing precedent on written description and arguing that the panel “held the opposite” under § 251). Plaintiffs’ downgrading of the original-patent requirement directly contradicts established precedent and would effectively render that separate statutory provision a nullity.

Section 112 calls for “a written description of the invention,” a baseline disclosure requirement that applies to all patents. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1345 (Fed. Cir. 2010) (en banc). To meet that standard, the specification must convey to skilled artisans “that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at 1351. Under § 251, reissue claims must *also* satisfy the original-patent requirement—a separate, additional limitation that Congress applied specifically to reissues. *Antares*, 771 F.3d at 1358. Although the two standards are “analogous,” the original-patent requirement demands more. *Id.* at 1362. Specifically, to satisfy § 251, the original specification of a reissued patent “must clearly and unequivocally disclose the newly claimed invention as a separate invention.” *Id.* at 1362; *see also id.* at 1358-62 (recounting the original-patent requirement’s long history dating back to the 1800s).

In urging a more lenient, “written-description-type” standard, Plaintiffs rely on *In re Amos*, 953 F.2d 613, 618 (Fed. Cir. 1991), and *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc.*, 563 F.3d 1358, 1367 (Fed. Cir. 2009). Pet. 8-9. But Plaintiffs

never cited *Amos* or *Revolution Eyewear* in their briefing. For good reason: neither case helps them. *Amos* specifically declined to address whether the written-description and original-patent tests are “co-extensive,” 953 F.2d at 618, and held only that compliance with § 251 did not depend on an “intent to claim” standard never argued here, *id.* at 618-19; *see also Antares*, 771 F.3d at 1361-62. And this Court has explained that the terse discussion of § 251 in *Revolution Eyewear* “merely reflected the way the parties presented the issue” there and “cannot be taken to establish as precedent that the standards are the same.” *Antares*, 771 F.3d at 1362 n.8.¹

Plaintiffs nonetheless maintain that their faulty view of *Amos* and *Revolution Eyewear* should control because those decisions predated *Antares*. Pet. 10. But that only highlights a more fundamental problem: Plaintiffs’ proposed standard not only conflicts with Federal Circuit precedent, but also with longstanding Supreme Court precedent. Plaintiffs argue that compliance with the original-patent requirement requires only that the inventor “could fairly have claimed the newly submitted subject matter in the original application.” Pet. 9 (quoting *Amos*, 953 F.2d at 618). Yet the Supreme Court long ago made clear that “it is *not enough* that an invention might

¹ This Court has also noted that in *Amos*, the “exact embodiment claimed on reissue was expressly disclosed in the specification.” *Antares*, 771 F.3d at 1363; *see also Forum US*, 926 F.3d at 1353. The same was true in *Revolution Eyewear*. *See Forum US*, 926 F.3d at 1353 n.2. In contrast, it was undisputed that the original ’247 patent never expressly disclosed using two web browser processes.

have been claimed in the original patent because it was suggested or indicated in the specification.” *Industrial Chemicals*, 315 U.S. at 676 (emphasis added). Rather, the subject matter of any reissue claim must have been apparent “from the face of the instrument” in the original specification. *Id.* Accordingly, reissue claims are subject not only to § 112; they must also be scrutinized under the more demanding original-patent requirement, as confirmed both in *Industrial Chemicals* and *Antares*. See also *Forum US*, 926 F.3d at 1351-52.² The panel faithfully adhered to that precedent.

Plaintiffs’ other complaints fare no better. Plaintiffs repeatedly argue that the panel applied an erroneous “word-for-word” test. Pet. 3, 8, 9, 12, 14. But the petition never explains how or where the panel’s opinion demanded “word-for-word” identity between the asserted reissue claims and the original specification. In reality, the opinion did no such thing. The question was whether the original ’247 specification clearly and unequivocally described the use of two web browser processes. And on that score, the panel recognized that Plaintiffs’ arguments impermissibly relied on expert testimony to assert “what a person of ordinary skill in the art would

² Plaintiffs’ insistence that “there was no question” the asserted claims “undisputedly” satisfied § 112 is beside the point under § 251. Pet. 2, 12. It is also inaccurate. Google did assert invalidity under § 112 in the district court right up to trial. Appx1025. Its ultimate decision not to expend its limited trial time on that defense—especially with an analogous but more rigorous ground for invalidity at hand under § 251—hardly constituted agreement that the claims would have passed muster under § 112.

purportedly understand’ from the specification rather than what is apparent ‘*from the face of the instrument.*’” Slip op. 11-12 (quoting *Forum US*, 926 F.3d at 1351-52).

That analysis applied settled law, not a new standard. Courts applying the original-patent requirement have long rejected efforts to reach beyond an original specification’s clear disclosures by invoking extrinsic suggestions about what else a skilled artisan might infer or extrapolate from the document. *E.g.*, *Industrial Chemicals*, 315 U.S. at 678; *Forum US*, 926 F.3d at 1352. Plaintiffs’ petition does not dispute those limits on expert testimony, and it cannot legitimately contest the panel’s straightforward application of that standard in this case. *See* slip op. 11-14.

Finally, Plaintiffs assert that the panel’s analysis conflicted with “established written-description law that disclosing a small genus discloses each species within that genus.” Pet. 3; *see also id.* at 13, 15. That argument goes nowhere.

For starters, Plaintiffs’ expert testified that “a logical process could be just about anything,” Appx5047, so “logical processes” were hardly a “small” genus. Moreover, the original specification presented the purported sub-genus (“interactive network processes”) as another unbounded set. Appx104 (6:14-18) (noting “the interactive nature of *many applications*, such a[s] gaming, messaging, and browsing”) (emphasis added), Appx108 (14:3-54) (“Interactive network processes such as interactive gaming”).

More fundamentally, the panel was not applying “written-description law”; it was applying the more rigorous standard of § 251. And a genus does not necessarily describe every constituent species even under § 112. *E.g.*, *Gen Hosp. Corp. v. Sienna Biopharmaceuticals., Inc.*, 888 F.3d 1368, 1372 (Fed. Cir. 2018) (“The disclosure of a broad range of values does not by itself provide written description support for a particular value within that range.”); *Knowles Elecs. LLC v. Cirrus Logic, Inc.*, 883 F.3d 1358, 1365-66 (Fed. Cir. 2018) (affirming that a disclosed genus of connection techniques failed to provide adequate written-description support for the claimed species). So too for genus/species anticipation under § 102. *See* Pet. 15; *Ineos USA LLC v. Berry Plastics Corp.*, 783 F.3d 865, 872 (Fed. Cir. 2015) (“disclosure of a small genus *can* be a disclosure of each species within the genus”) (emphasis added). The panel certainly was not compelled to reach a contrary conclusion here under the *more demanding* original-patent requirement.

B. Plaintiffs’ argument that narrowed claims always satisfy the original-patent requirement is new, legally erroneous, and factually mistaken

Plaintiffs also contend that at least two asserted claims should have survived because (1) those claims were purportedly narrowed relative to those in the original ’247 patent, and (2) the original-patent requirement applies only to *broadening* reissues. Pet. 10-12. That argument is mistaken on multiple levels.

First, that argument could not have been overlooked because Plaintiffs never raised it in briefing before the panel. Fed. R. App. P. 40(a)(2); *Pentax Corp. v. Robinson*, 135 F.3d 760, 762 (Fed. Cir. 1998).³ The Court should disregard Plaintiffs’ new argument for that reason alone.

Second, Plaintiffs’ novel framework has no legal basis. In support, Plaintiffs present a handful of cherry-picked quotations from decisions that happened to address broadening reissues, along with vague assertions that *Antares* rested on a foundation that was somehow abrogated by the 1952 Patent Act. Pet. 10-12, 14. But § 251 by its terms governs narrowing *and* broadening reissues—i.e., when a patentee claimed “more or less” than it should have in the original patent—with no indication that the statutory mandate to reissue claims only “for the invention disclosed in the original patent” applies to just one of those categories. Furthermore, as this Court has noted, enforcement of the original-patent requirement *pre-dates* broadening reissue practice. *See Antares*, 771 F.3d at 1359 (noting that the original-patent requirement “became *even more* important when the Supreme Court first held that broadening reissue applications were permissible”) (emphasis added). There is no indication that the 1952 Act was intended to disturb the standards developed over

³ It is likewise difficult to understand how an entire substantive argument directed to the primary disputed issue on appeal could pose a true “question of exceptional importance” and yet somehow escape mention in Plaintiffs’ underlying merits brief. *See* Fed. R. App. P. 35(a).

the preceding century of consistent enforcement. *See* P.J. Federico, *Commentary on the New Patent Act*, 75 J. Pat. & Trademark Off. Soc’y 161, 205 (1993); *Antares*, 771 F.3d at 1360 (citing same). And the purpose of the original-patent requirement—ensuring that reissue claims cover the same invention disclosed in the original patent—applies regardless of whether the reissue claims are broader or narrower.

Third, Plaintiffs are wrong in suggesting that any of the reissue claims asserted here are narrower than the original ’247 claims. A reissue claim is considered broadening if it is broader than the original claims in *any* respect. *In re Bennett*, 766 F.2d 524, 526 (Fed. Cir. 1985) (en banc). Plaintiffs concede that RE’500 claim 43 and RE’528 claim 67 were broader. Pet. 10. And RE’528 claim 5 and RE’529 claim 49 were broader too. Plaintiffs argue that the only “meaningful” change to those claims was narrowing because both retained the two-processor limitation of the original claims. Pet. 10-11. But as Plaintiffs have described, the reissue claims reciting two web browser processes covered, for the first time, two “un-isolated” processes capable of accessing website data. *See* RB11-12, RB52. The resulting claims were thus broadened, extending to new subject matter beyond the reach of the original ’247 patent. *See* Appx4187-4188.

C. The panel correctly rejected Plaintiffs’ argument that the original ’247 patent disclosed two web browser processes

Plaintiffs contend that the panel “overlooked” that the original ’247 patent “expressly discloses two web-browser processes” and thus “satisfied the original-

patent test.” Pet. 12. But that was the dispositive question on appeal. The panel did not “overlook” the disclosures that Plaintiffs cited; it considered and correctly rejected them as insufficient under § 251.

The petition does not even try to identify any clear and unequivocal disclosure of two web browser processes in the ’247 patent. It simply re-hashes Plaintiffs’ theory that generically disclosing “interactive network processes” should be considered “sufficient disclosure of each member species.” Pet. 12-13. The petition acknowledges the panel’s conclusion that the original specification, at best, required a series of inferences to arrive at the reissued claims. Pet. 13; slip op. 12-14. But it suggests, without explanation, that those inferences “are disclosures in the Patent.” Pet. 13. That is simply a non-sequitur. The panel detailed that series of inferences not as disclosures made in the original ’247 patent, but rather as inferences needed to get *from* what was in the ’247 patent *to* the asserted reissue claims. Slip op. 12-14. If those inferences had been “disclosures in the patent,” no inferences would have been required to bridge the gap. Plaintiffs do not challenge, much less refute, the panel’s reasoning as to any of the three necessary inferences identified in the opinion.

Plaintiffs’ reliance on *In re Muller*, 417 F.2d 1387, 1390 (CCPA 1969), is similarly unavailing. To begin with, Plaintiffs never cited *Muller* to the panel. And at any rate, the problem in *Muller* was that the Board had placed “undue reliance on the drawings” while ignoring written description that expressly described

manufacturing the later-claimed filter using the claimed forms of filtering material. *Id.* The applicant was not required to “*illustrate* the cylindrical folding with each and every disclosed material”; it was required to *disclose* each of those materials. *Id.* Because the written description clearly described each of the claimed forms, the claims survived regardless of what the figures illustrated. *Id.* at 1390-91. As the panel here recognized, the original ’247 patent contained no express disclosure of using two web browser processes—neither in text nor in figures.

D. Plaintiffs’ additional arguments come nowhere close to justifying en banc review

The petition concludes with additional arguments directed specifically toward en banc rehearing. But Plaintiffs cannot mask the obvious—this case makes an exceptionally poor candidate for that extraordinary procedure.

At bottom, the panel rendered a case-specific, non-precedential decision that applied settled law to particular claims. The analysis turned on several gaps in the original ’247 patent’s specification relative to the four reissue claims asserted here. *See slip op.* 12-14. And the opinion followed a path charted by existing precedent. As such, this case fit the bill as one “not adding significantly to the body of law,” which warranted the panel’s non-precedential designation, Fed. Cir. R. 32.1(b), and illustrates why en banc petitions like this one are “rarely appropriate” following a non-precedential opinion, *see* Fed. Cir. R. 35 Practice Note.

Plaintiffs nonetheless contend that their petition is “particularly important” because the panel’s non-precedential opinion “calls into question the validity of countless reissue patents.” Pet. 16. A look back at the Court’s docket belies that assertion. *Industrial Chemicals*, on which the panel substantially relied, has been on the books since 1942, and patentees have continued to seek reissues in the years since. We have found only seven decisions from this Court applying the original-patent requirement since 1982. *See Antares*, 771 F.3d at 1361 (identifying only four pre-*Antares* cases). And despite Plaintiffs’ criticism that *Antares* somehow opened the floodgates with a “new ‘clear and unequivocal disclosure’ test,” Pet. 14, this Court has decided only two of those seven original-patent cases (this one and *Forum*) since *Antares* issued in 2014. There has been no sea change, and the specific issues that were presented here are highly unlikely to recur.

Nor is this the appropriate forum for Plaintiffs’ ill-defined policy arguments suggesting that the panel’s ruling somehow fails to “protect a legitimate interest of the interested public” or will “devalue the patent system.” Pet. 14, 16. The original-patent requirement has been continuously and consistently applied since the mid-1800s, and any complaints about perceived harms to the patent system or the public are properly directed to Congress, not the courts.

Plaintiffs also suggest that “because reissue requires surrender of the original patent,” the panel’s opinion “leaves inventors with no patent rights.” Pet. 4. But

inventors seeking reissue can maintain their originally issued claims in addition to any new or amended claims that comply with § 251. Indeed, Plaintiffs themselves did so in their unasserted U.S. Reissue Patent No. RE43,987.

Finally, there is no “conflict” between the panel’s decision and precedent governing written description and anticipation under §§ 112 and 102. Pet. 15. This appeal did not involve either of those statutes. And as noted earlier, there is no bright-line rule even under those statutes that describing a genus necessarily suffices to describe every constituent species.

CONCLUSION

The petition should be denied.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

1. This response complies with the type–volume limitation of Federal Circuit Rules 35(e)(2) and 40(c) because the body of response contains 3,837 words, as calculated by the word-processing system used to prepare the document.

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type-style requirements of Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface using Microsoft® Word and 14-point Times New Roman type.

Dated: June 12, 2023

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