

2021-2296, 2021-2297, 2022-1070

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

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**IRONBURG INVENTIONS LTD.,**

*Plaintiff-Cross-Appellant*

v.

**VALVE CORPORATION,**

*Defendant-Appellant*

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Appeal from the United States District Court for the Western District of Washington, Case No. 2:17-cv-01182-TSZ, Judge Thomas S. Zilly

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**APPELLANT VALVE CORPORATION'S COMBINED PETITION FOR  
PANEL REHEARING AND REHEARING EN BANC**

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May 3, 2023

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FORM 9. Certificate of Interest

Form 9 (p. 1)  
July 2020**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT****CERTIFICATE OF INTEREST**

**Case Number** 2021-2296; 2021-2297; 2022-1070

**Short Case Caption** Ironburg Inventions Ltd. v. Valve Corporation

**Filing Party/Entity** Valve Corporation

**Instructions:** Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 12/09/2021Signature: /s/Sharon A. IsraelName: Sharon A. Israel

FORM 9. Certificate of Interest

Form 9 (p. 2)  
July 2020

<p><b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).</p>	<p><b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).</p>	<p><b>3. Parent Corporations and Stockholders.</b> Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>Valve Corporation</p>		

Additional pages attached

FORM 9. Certificate of Interest

Form 9 (p. 3)  
July 2020

**4. Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable  Additional pages attached

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**5. Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

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**6. Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable  Additional pages attached


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None/Not Applicable  Additional pages attached

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**5. Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

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**6. Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

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**FEDERAL CIRCUIT RULE 35(b) STATEMENT OF COUNSEL**

Based on my professional judgment, I believe the panel decision is contrary to the following decisions of the Supreme Court of the United States or the precedents of this Court: *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014); *Pullman-Standard v. Swint*, 456 U.S. 273 (1982); *Dow Chemical Co. v. Nova Chemicals Corp. (Canada)*, 803 F.3d 620 (Fed. Cir. 2015); *Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335 (Fed. Cir. 2015); *Atl. Thermoplastics Co. v. Faytex Corp.*, 5 F.3d 1477 (Fed. Cir. 1993).

Based on my professional judgment, I believe this appeal requires an answer to one or more precedent-setting questions of exceptional importance:

Whether this Court may presume a district court considered and rejected issues and evidence presented, where the district court failed to address them and failed to provide sufficient detail by which it reached its ultimate determination.

Whether patent claims requiring measurement of a property are indefinite where the patent lacks reasonable certainty in sufficiently teaching an ordinary artisan how to make the measurement.

Whether a party can forfeit its ability to rely on a specific case on appeal, if not cited to the district court, where the underlying issue or principle had been raised.

Dated: May 3, 2023

By: /s/ Sharon A. Israel  
Sharon A. Israel  
Attorney of Record for  
Defendant-Appellant Valve Corporation

The majority opinion departs from this Court’s precedent. First, the majority improperly presumed the district court considered and rejected a particular ground of indefiniteness, although the district court’s judgment did not address that ground or the unrebutted evidence on which it was based. Second, the majority opinion is contrary to Supreme Court and Federal Circuit law on indefiniteness, for claims whose scope is defined in part by measuring some physical property, *i.e.*, “measurement claims.” Valve respectfully requests panel rehearing or rehearing *en banc* on these issues.

Furthermore, albeit in dictum in footnote 4, the majority implies that a party can forfeit its ability to rely on binding authority on appeal by not citing a specific case to the district court. Valve respectfully requests clarification through panel rehearing.

### **BACKGROUND**

Prior to a trial on infringement of Ironburg Inventions Ltd.’s U.S. Patent No. 8,641,525 (the “525 patent”), Valve sought a determination that the asserted claims were indefinite due to the limitation: “elongate member that extends substantially the full distance between the top edge and the bottom edge.” Valve argued, *inter alia*, that “a POSITA would not be able to determine or measure [the] distance [between the top and bottom edge] with reasonable certainty” because of the curved, irregular shape of the disclosed controller (*see* below) and the lack of “guidance

regarding where along those edges the ‘distance’ measurement should be made.” Appx3892, Appx3887. This was also supported by a detailed expert declaration, which reads in part: “[o]n a typical controller, a POSITA would [] be unable to ascertain with reasonable certainty what would be the boundaries of the ‘top edge’ and ‘bottom edge’, and where on the curved surface the measurement should be taken.” Appx3924; *see also* Appx3921–3924 (including supporting chart in which expert showed that depicted paddle could be 50% or 90% of full distance depending on measurement method). Ironburg offered no contrary evidence, relying instead on PTAB decisions to show the claims were allegedly amenable to construction. *See* Appx3817 (relying on PTAB decisions), Appx3997–4002 (similar), Appx4261–4262 (similar).

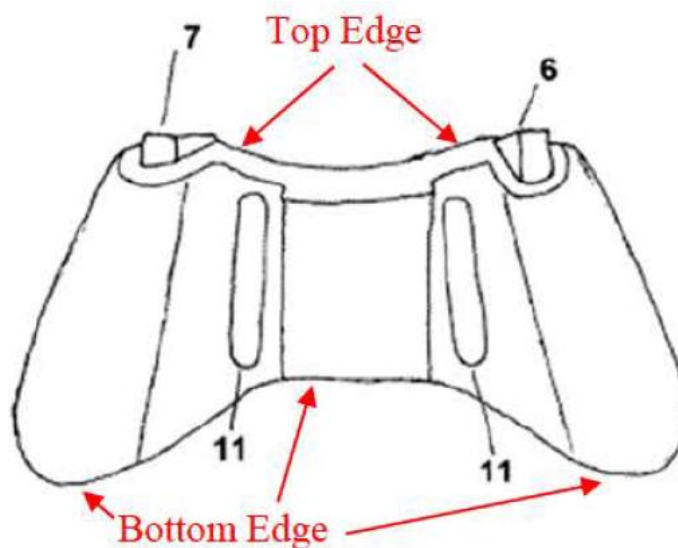


Figure 2

Appx3887 (annotating Fig. 2 from Appx89, Appx98)

The district court concluded the claims were not indefinite, without addressing Valve’s argument or the un rebutted evidence that the ’525 patent fails to provide reasonable certainty about measuring or determining the “distance” between the top and bottom edges. *See* Appx11–12. Instead, the district court focused on a different theory of indefiniteness (which Valve did not appeal) asserting that “substantially” is a term of degree lacking objective guidance. *Id.*; *see* Appx3890–3892 (Valve’s argument regarding “substantially”). The district court made no findings about whether an ordinary artisan would have known where and how to measure the “distance between the top edge and the bottom edge.” *See* Appx11–12.

On appeal, Valve argued, *inter alia*, that the district court erred in its determination of no indefiniteness based on the lack of reasonable certainty in measuring the “distance between the top edge and the bottom edge.” *See* Valve’s Corr. Principal Br. at 35–40. In addition to citing the un rebutted pre-trial evidence, *id.* at 36, Valve discussed how the use of different measurement methods at trial by the parties’ experts—which led to different results—illustrated the absence of reasonable certainty, *see id.* at 36–39.

Ironburg did not dispute that: (1) the experts used different measurement approaches, (2) these approaches produced different results, and (3) an ordinary artisan would have had no basis to choose between these competing approaches. *See* Ironburg’s Principal Br. at 31–37 (conceding the different approaches and results,

which it characterized as an infringement dispute). Ironburg also did not dispute that the district court determined only “that ‘substantially’ was ‘reasonably precise’” without addressing the measurement issue. *See id.* at 11 (citing Appx11–12).

In a split-panel decision, the Majority affirmed the district court’s determination of no indefiniteness. *Ironburg Inventions Ltd. v. Valve Corp.*, 64 F.4th 1274 (Fed. Cir. 2023) (hereinafter, “Op.”). Although Valve presented unrebutted evidence of indefiniteness on the measurement approach for determining “substantially the full distance between the top edge and the bottom edge,” the majority stated: “[i]n the absence of any clear indication that the district court misapprehended or overlooked the full scope of Valve’s indefiniteness argument, we must presume that the court considered, and here rejected, all of it.” Op. 13 n.2. The majority characterized the lack of reasonable certainty regarding measurement as “a dispute about *application* of an agreed-upon measurement technique,” *id.* at 17, though “the parties’ experts arrived at two different methods that could yield different answers,” as the dissent noted. *See* Dissent Op. 7–8. Further, notwithstanding the undisputed facts and the absence of specific findings by the district court, the majority concluded that “Valve has failed to prove, by the requisite clear and convincing evidence, that one of skill in the art would lack reasonable certainty as to claim scope.” Op. at 19.

## SUMMARY OF THE ARGUMENT

Despite un rebutted evidence, the district court did not address whether the lack of reasonable certainty regarding measurement approaches renders the claims invalid, nor did it make any findings on the underlying facts. Nevertheless, in affirming the definiteness determination, the majority presumed that the district court considered and rejected Valve’s entire indefiniteness argument. Op. 13, n.2. The majority’s presumption contradicts the fundamental requirement that district courts must make the reasons for their judgments clear enough to facilitate appellate review. The majority’s approach contradicts precedent and shields unsupported judgments from meaningful review.

In this case, the majority “presumed” a determination the district court never made. This led the majority to ignore the undisputed facts that there were multiple methods for measuring the “full distance between the top edge and the bottom edge,” leading to disparate results, and that the ’525 patent does not provide any basis to choose which measurement method to use. Given the undisputed facts, the Court’s judgment in this case is contrary to its precedent applying § 112’s definiteness requirement and the “reasonable certainty” standard of *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014).

## ARGUMENT

### **I. USING PRESUMPTIONS TO FILL GAPS IN DISTRICT-COURT FINDINGS, AS THE MAJORITY DID, UNDERMINES APPELLATE REVIEW AND RISKS IMPERMISSIBLE FACTFINDING ON APPEAL**

Presuming that the district court considered and rejected un rebutted evidence and arguments of indefiniteness, where the district court record is silent, undermines the appellate review process. Valve presented un rebutted expert testimony that the '525 patent claims are indefinite because an ordinary artisan would have lacked reasonable certainty about how and where to measure the “full distance” between the top and bottom edges of the claimed game controller. Nevertheless, the district court concluded these claims were not indefinite. However, the district court made no findings about the measurement issue and did not otherwise address the specifics of Valve’s indefiniteness argument or supporting evidence.

Relying on *Novartis AG v. Torrent Pharms., Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017), the majority presumed the district court considered and rejected Valve’s argument and evidence. Op. 13, n.2. Such a presumption departs from the well-established role of an appellate court: “This court must review factual findings made by the district court; *it may not guess at findings left unmade.*” *Atl. Thermoplastics Co. v. Faytex Corp.*, 5 F.3d 1477, 1479 (Fed. Cir. 1993) (italics added).

The parties did not dispute that the district court’s determination of definiteness focused only on *part* of Valve’s indefiniteness argument, *i.e.*, whether

the word “substantially” is sufficiently “precise” in prescribing the required length of an “elongate member.” Ironburg’s Principal Br. at 11 (citing Appx11–12). The district court concluded it was, reasoning based on the specification that the length of the elongate members can be assessed relative to “the average span of a human hand.” Appx12. *Accord* Ironburg’s Principal Br. at 30 (citing the district court’s discussion as relating to “exactly *how long* the elongate members must be”) (italics added). But Valve argued before the district court and on appeal that the claims also recite a comparison between the length of the recited elongate member and the “full distance between the top edge and the bottom edge.” As the dissent correctly observed, “the district court could not know that the elongate members extend that full distance unless it knows what that full distance is, which in turn requires knowing the points for measurement.” Dissent Op. 4. And it is undisputed that an ordinary artisan would *not* know the points for measurement.

The unrebutted evidence demonstrates that an ordinary artisan would have “be[en] unable to ascertain with reasonable certainty what would be the boundaries of the ‘top edge’ and ‘bottom edge’, and where on the curved surface the measurement [of the claimed ‘distance’] should be taken.” Appx3924. *See generally* Appx3921–3924 (expert declaration explaining why the patent does not enable an ordinary artisan to determine the claimed “distance” with reasonable certainty). The district court did not address any of this evidence, or the argument it supports; as



such, it made no findings about a subsidiary factual component of Valve's indefiniteness challenge. *See* Appx11–12. By presuming that the district court *did* consider and reject this contention, the majority improperly “guessed” at findings the district court did not make. *Atl. Thermoplastics*, 5 F.3d at 1479; *see Pullman-Standard v. Swint*, 456 U.S. 273, 291 (1982) (“[Factfinding] is the basic responsibility of district courts, rather than appellate courts.”) (quoting *DeMarco v. United States*, 415 U.S. 449, 450 (1974)) (alteration in original).

Indefiniteness is question of law, but that “does not render [a] subsidiary [factual] question a legal one,” even if that factual question is “nearly dispositive” of the legal issue. *Teva Pharms. USA, Inc. v. Sandoz, Inc.* (“*Teva I*”), 574 U.S. 318, 333 (2015) (discussing claim construction); *see Teva Pharms. USA, Inc. v. Sandoz, Inc.* (“*Teva II*”), 789 F.3d 1335, 1342 (Fed. Cir. 2015) (applying *Teva I* to indefiniteness). District courts are required to make any factual findings express, even subsidiary factual findings, in order to facilitate review. *See, e.g., Gechter v. Davidson*, 116 F.3d 1454, 1458 (Fed. Cir. 1997) (“[A]s to the facts it must also find subsidiary facts ‘specially,’ and not just the ultimate fact.”).

This Court has explained that “trial court[s] must provide sufficient factual findings such that we may meaningfully review the merits of [their] order[s].” *Pretty Punch Shoppettes, Inc. v. Hauk*, 844 F.2d 782, 784 (Fed. Cir. 1988) (citing *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 872, 873 (Fed. Cir. 1985)). “Findings of fact

are said to be adequate when ‘they are sufficiently comprehensive and pertinent to the issue to form a basis for the decision.’” *Atl. Thermoplastics*, 5 F.3d at 1479 (quoting *Medtronic, Inc. v. Daig Corp.*, 789 F.2d 903, 906 (Fed. Cir. 1986)).

Within this framework, this Court has not required that district courts “recite every piece of evidence” they consider in their opinions. *Plant Genetic Sys. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1343 (Fed. Cir. 2003). Hence, without abrogating the requirement for express findings that are “sufficiently comprehensive and pertinent to the issue,” the Court may “presume that a fact finder *reviews all the evidence* presented unless he explicitly expresses otherwise.” *Medtronic*, 789 F.2d at 906 (italics added). And in *Novartis AG v. Torrent Pharmaceuticals Ltd.*, 853 F.3d 1316 (Fed. Cir. 2017), which the majority cited as support for its presumption (Op. 13, n.2), this Court extended similar leeway to the Patent Trial and Appeal Board. *See Novartis*, 853 F.3d at 1328 (“[T]here is no requirement that the Board expressly discuss each and every negative and positive piece of evidence lurking in the record to evaluate a cursory argument.”).

But this line of cases, including *Novartis*, does not support extending a similar presumption to independent legal arguments and the subsidiary findings required to resolve them, as the majority did here. Op. 13, n.2. Presuming factual findings that a district court did not make is tantamount to “guess[ing] at findings left unmade” or even to appellate factfinding, both of which are prohibited. *Atl. Thermoplastics*,

5 F.3d at 1479; *see Pullman-Standard*, 456 U.S. at 291. Even if this were not the case, the presumption adopted by the majority effectively eliminates any requirement for express findings, thereby undermining this Court’s ability to perceive the reasoning by which a district court reached a judgment under review. *See, e.g., Pretty Punch Shoppettes*, 844 F.2d at 784 (meaningful review requires adequate, express findings). The panel or the *en banc* Court should grant rehearing to address this improper presumption on appeal.

## **II. THE MAJORITY OPINION CONTRADICTS AND THREATENS TO UNSETTLE THIS COURT’S ESTABLISHED PRECEDENT SINCE *NAUTILUS***

Since *Nautilus*, this Court has established a consistent body of law governing indefiniteness of measurement claims. The majority opinion contradicts *Nautilus* and this Court’s established precedent, and threatens to trigger a cascade of follow-on cases raising similar problems.

### **A. The Law on Indefiniteness of Measurement Claims Has Been Well-Established by This Court**

As the dissent observed, “[t]his court has a stable body of law that tests the indefiniteness of claims that require measurements: if a claim demands a measurement but the patent lacks reasonable certainty in sufficiently teaching how to make the measurement, the claim is indefinite.” Dissent Op. 5 (citing *Dow*, 803 F.3d 620 (Fed. Cir. 2015) and *Teva II*, 789 F.3d 1335 (Fed. Cir. 2015)).

In *Dow*, the Court was confronted by the question “whether the existence of multiple methods leading to different results without guidance in the patent or the prosecution history as to which method should be used renders the claims indefinite,” to which it answered in the affirmative. *Dow*, 803 F.3d at 634. The Court in *Dow* also recognized the similarity to *Teva II*, in which the claim term “molecular weight” was found to be indefinite because “there were three relevant measures for molecular weight . . .[,] where each was calculated in a different manner and each typically had a different value”; the patent lacked any guidance to choose between them, and “the prosecution history contained inconsistent statements.” *Id.* at 634–35 (citing *Teva II*, 789 F.3d at 1338, 1341–45).

The test for measurement claims derives from the Supreme Court’s adoption of the “reasonable certainty” standard of *Nautilus*. As this Court noted in *Dow*, “[b]efore *Nautilus*, a claim was not indefinite if someone skilled in the art could arrive at a method [of measurement] and practice that method.” *Id.* at 634. Under pre-*Nautilus* caselaw, it was enough that “Dow’s expert . . . had developed a method for measuring maximum slope [of strain hardening],” but “[u]nder *Nautilus* this is no longer sufficient” without objective guidance from the claims, specification, or prosecution history. *Id.*

Reasonable certainty must be evaluated in light of the knowledge of one skilled in the art, which may include known, standard measurement methods. *See*

*Presidio Components, Inc. v. Am. Technical Ceramics Corp.*, 875 F.3d 1369, 1376 (Fed. Cir. 2017) (“Under our post-*Nautilus* cases, a claim is not indefinite if a person of skill in the art would know how to utilize a standard measurement method, such as insertion loss, to make the necessary measurement.”); *Ethicon Endo-Surgery, Inc. v. Covidien, Inc.*, 796 F.3d 1312, 1319 (Fed. Cir. 2015) (“[T]he definiteness requirement of 35 U.S.C. § 112 mandates only that one skilled in the art must be able to understand *which* pressures are relevant to the claims and *how* those pressures can be measured, so to discern the scope of the claimed average pressure range with reasonable certainty.” (citing *Nautilus*, 134 S. Ct. at 2124)).

**B. The Majority Opinion in This Case Contradicts and Unsettles Established Precedent**

This Court has (until now) consistently held that definiteness requires that an ordinary artisan be able to make any recited measurements with reasonable certainty. The majority in this case contradicts this established precedent by permitting a lack of reasonable certainty regarding particular details about the way claimed measurements are made, *i.e.*, location but not methodology, “where” but not “how.” The way measurement details may be characterized should not control the indefiniteness analysis; that approach to indefiniteness is irreconcilable with the inquiry called for by *Nautilus* and this Court’s post-*Nautilus* jurisprudence.

The inquiry under *Nautilus* focuses on whether “a patent’s claims, viewed in light of the specification and prosecution history, inform those skilled in the art

*about the scope of the invention* with reasonable certainty.” 572 U.S. at 910 (emphasis added). An ordinary artisan must therefore have reasonable certainty about any measurement detail that is material to claim scope. *Cf. Ethicon*, 796 F.3d at 1320 (distinguishing differences “due to natural variances in real-world testing conditions” from indefiniteness).

Consistent with *Nautilus*, this Court has not treated the question of “where” to measure as distinct from the question of “how” to measure; rather, it has looked at the record for evidence of reasonable certainty. *See Ethicon*, 796 F.3d at 1320; *Dow*, 803 F.3d at 633. In *Ethicon*, this Court reviewed a judgment that a claimed average “clamping pressure” was indefinite for failing to specify where along a clamping arm the measurements were taken. 796 F.3d at 1320. In *Dow*, the appellant asserted indefiniteness based on “*where* and *how* the ‘slope of strain hardening’ should be measured.” 803 F.3d at 633 (emphasis added). In each case, this Court was guided by record evidence that one skilled in the art would have known where to measure the recited physical property. *See Ethicon*, 796 F.3d at 1320 (reversing judgment where record evidence established that an ordinary artisan would have known to determine the average pressure by measuring at the midpoint of the arm); *Dow*, 803 F.3d at 633 (citing expert testimony that “one of ordinary skill in the art would know that the slope of the hardening curve would have to be measured at its maximum value”). Characterizing the issue as a question of “where” to measure did

not cause this Court to give the arguments less weight than it gave to other indefiniteness arguments. *See generally Ethicon*, 796 F.3d at 1319–22; *Dow*, 803 F.3d at 631–34. Instead, the Court relied on record evidence that one skilled in the art would have known “where” to measure, evidence which is absent in this case (as discussed further below).

In making a distinction between questions of “where” and “how” to measure a claimed property, the majority relied on *Presidio Components, Inc. v. American Technical Ceramics Corp.*, but *Presidio* does not support making that distinction. *See Op. 17*. In the cited excerpt, the Court in *Presidio* described *Dow* and *Teva II* as cases where “the challenger had shown competing methodologies that reached different results, and the patent failed to describe which of the multiple methods to use.” *Id.* (quoting *Presidio*, 875 F.3d at 1377) (cleaned up). Nothing in *Presidio* suggests, however, that “competing methodologies” excludes unresolved questions of “where” to measure something. Rather, the judgment of no indefiniteness in *Presidio* was affirmed because record evidence showed that a well-established test method, referenced in the patent, could be used with minor modifications within the skill of an ordinary artisan. *See* 875 F.3d at 1376–77 (“Under our post-*Nautilus* cases, a claim is not indefinite if a person of skill in the art would know how to utilize a standard measurement method, such as insertion loss, to make the necessary measurement.”). In support of that holding, *Presidio* analogized its facts to those in

*Ethicon* and distinguished *Dow* and *Teva II* as cases where “the challenger **had shown**” what it needed to show. *Id.* at 1377 (emphasis added). The use of “competing methodologies” did not limit the kinds of uncertainty that could give rise to indefiniteness.

Furthermore, as the dissent warned, the majority opinion destabilizes the body of law applying the *Nautilus* standard to measurement claims. *See* Dissent Op. 6. The majority’s holding creates a class of patent claims whose scope need not be reasonably certain, as required under *Nautilus*, so long as the uncertainty can be classified as a question of “where” to measure and not “how” to measure. Despite an avowed intention not to create *per se* rules, the majority treated the *where-how* dichotomy as a *per se* “weakness in Valve’s showing.” Op. 19. This will incentivize unnecessary litigation, including appeals, over the way measurement problems are characterized with respect to this *where-how* dichotomy. Similar disputes could arise for any question faced in construing measurement claims, *e.g.*, “when” in a process measurement occurs or “who” is measuring. *Cf. Olaplex, Inc. v. L'Oréal USA, Inc.*, 845 F. App’x. 943, 949 (Fed. Cir. 2021) (“The possible constructions for this limitation concern **whether the measurement is made when** the active agent is added into the mixture **or after** it has been added to the mixture.”) (emphasis added) (non-precedential). District courts, in turn, will need to police which measurement details require reasonable certainty. The panel or the *en banc* Court should grant



rehearing to address the correct standard for the indefiniteness inquiry required by this Circuit and the Supreme Court.

**III. THE PANEL SHOULD CLARIFY THAT PARTIES CAN CITE AUTHORITY ON APPEAL REGARDLESS OF WHETHER CITED TO THE DISTRICT COURT**

In dictum in footnote 4, the majority implied that a party can forfeit its ability to rely on binding authority on appeal, if the party did not cite a specific case to the district court. Valve respectfully requests that the Court clarify its statement regarding possible forfeiture of citing binding precedent. While parties may waive or forfeit the ability to raise issues on appeal, they are still bound by precedent and may cite relevant cases on appeal. Failing to clarify the statement in footnote 4 could result in parties being obligated to cite string cites of cases to a district court in an effort to avoid potential forfeiture on appeal.

**CONCLUSION**

For the foregoing reasons, the panel or the *en banc* Court should grant rehearing as to the issues addressed herein.

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**CERTIFICATE OF COMPLIANCE**

This combined petition complies with the type-volume limitation of Federal Rule of Appellate Procedure 35(b)(2)(A) and Federal Circuit Rule 32. This petition contains 3613 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(f) and Federal Circuit Rule 32(b). This petition 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). This petition has been prepared in a proportionally spaced typeface using Microsoft Word in 14-point Times New Roman.

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