2012-1014, -1015

United States Court of Appeals for the Federal Circuit

LIGHTING BALLAST CONTROL LLC,

Plaintiff-Appellee,

v.

PHILIPS ELECTRONICS NORTH AMERICA CORPORATION,

Defendant,

and

UNIVERSAL LIGHTING TECHNOLOGIES, INC.,

Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Texas in case no. 09-CV-0029, Judge Reed O'Connor.

BRIEF *FOR AMICUS CURIAE* SAN DIEGO INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PLAINTIFF-APPELLEE LIGHTING BALLAST CONTROL LLC

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JULY 1, 2013

CERTIFICATE OF INTEREST

Counsel for the *amicus curiae*, San Diego Intellectual Property Law Association, certifies the following:

1. The full name of every party or amicus represented by me is:

   San Diego Intellectual Property Law Association

2. The name of the real party in interest (if the party name in the caption is not the real party in interest) represented by me is:

   San Diego Intellectual Property Law Association

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

   None

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court are:

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Date: July 1, 2013

/s/ William L. Respess
William L. Respess

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I. STATEMENT OF INTEREST OF *AMICUS CURIAE*

The San Diego Intellectual Property Law Association (SDIPLA) is an association of members in the San Diego in all aspects of intellectual property law. SDIPLA members include attorneys employed by corporations, universities, and the government, and attorneys in private practice. SDIPLA members represent both owners and users of intellectual property.

The SDIPLA has no stake in any of the parties to this litigation or the result of this case, other than its interest in seeking correct and consistent interpretation of the law affecting intellectual property. This case involves the standard for review of patent claim construction by a District Court during an infringement proceeding, perhaps the most important issue determined prior to a trial in a patent case. It guides future discovery, often permits cases to be resolved by summary judgment, and frames the deliberations of the jury in in its role as fact finder with respect to issues such as infringement, enablement and obviousness.

This brief was authored by counsel for *amicus curiae* and its filing authorized by the Board of Directors of SDIPLA. No party or its counsel has authored this brief in whole or in part nor contributed money to support drafting or submission of this brief nor has any party other than SDIPLA, its members, or its counsel contributed money used to fund preparation or submission of this brief.

II. BRIEF RESPONSE TO QUESTIONS PRESENTED.

Should the Court overrule *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998)?

Cybor should be overruled because it is inconsistent with the standard of review the Supreme Court has made applicable to *de novo* appellate review of decisions of a District Court that can be properly characterized as presenting mixed questions of law and fact.

Should the court afford deference to any aspect of a district court's claim construction? If the court overrules *Cybor*, which aspects of the district court's claim construction should be afforded deference?

The Court should defer to "historical facts" determined by the District Court in resolution of a mixed question of fact and law undergoing *de novo* review unless clearly erroneous. When applying facts determined by the district Court that are not clearly erroneous to mixed questions of fact and law, inferences drawn from those facts also require deference.

The foregoing answers to the questions posed by the court follow from the manner in which the Supreme Court has instructed the Federal Courts of Appeal in cases involving *de novo* appellate review in cases such as *Thompson v. Keohane*, 516 U.S. 99 (1995); *Ornelas v. United States*, 517 U.S. 690 (1996); and *Cooper Industries, Inc. v. Leatherman Tool Group, Inc.*, 532 U.S. 424 (2001).

III. SUMMARY OF ARGUMENT

This case presents the Court with a timely opportunity to revisit and overrule its decision in *Cybor Corp. v. FAS Technologies*, 138 F.3d 1448 (Fed. Cir. 1998) holding that claim construction is purely a question of law to be reviewed *de novo* and without any deference to the factual findings of the District Court which informed its claim construction. In our view, the Court erred in its determination that the Supreme Court's decision in *Markman II,* if it did not require the *Cybor* standard of review, at least supported adoption of that standard. Rather, while *Markman II* was a review and affirmance of this Court's judgment in *Markman I*, considered with contemporaneous decisions of the Supreme Court, the proper reading of *Markman II* does not support the holding in *Cybor*.

Contemporaneous with its decision in *Markman II*, the Supreme Court has handed down a number of important cases in order to provide guidance to Courts of Appeal concerning the manner in which they are to review the decisions of the district courts when the appellate court is engaged in a de novo review of those decisions. Those decisions make it clear that in situations such as claim construction where the District Court is assigned a fact finding role as an adjunct to its authority to resolve issues of law and the appellate court is permitted to engage in *de novo* review, the appellate court must always defer to the District Court's findings of "historical" facts unless clearly erroneous and to the inferences drawn from those facts by that court.

IV. THE PANEL'S DECISION PROVIDES AN OPPORTUNITY FOR REVIEW AND OVERRULING OF *CYBOR*

The invention involved in this appeal, as the panel observed, is directed to an electrical device for providing fluorescent lighting. One element of the claims on appeal is a "voltage source means providing a constant or variable magnitude DC voltage between the DC input terminals." The District Court's rejection of the alleged infringer's contention that the claim was indefinite under 35 U.S.C. § 112 turned on whether or not the "voltage source means" limitation was construed as means-plus-function claiming under 35 U.S.C. § 112, ¶ 6. The alleged infringer urged that it was and, as a result, the claim should be held indefinite because no structure capable of providing DC voltage was disclosed.

The use of the term "means" in a claim triggers a rebuttable presumption that the language intended to invoke the means-plus-function claiming practice permitted under Section 112(6)[1].[2]

In this case, the District Court found that the limitation was not intended to invoke 112(6), relying in part on expert testimony that to a person of ordinary skill in the art, this term "voltage source means" means a rectifier. The jury was so

[1] Section 112(6) was recently recodified as 35 U.S.C. 112(f).

[2] "We do not mean to suggest that section 112(6) is triggered only if the claim uses the word 'means.'…. Nonetheless, the use of the term 'means' has come to be so closely associated with 'means-plus-function' claiming that it is fair to say that the use of the term "means" (particularly as used in the phrase 'means for') generally invokes section 112(6) and that the use of a different formulation generally does not." *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584 (Fed. Cir. 1996).

charged and found the asserted claims to be valid and infringed. On appeal, however, the panel began its consideration of the issue of indefiniteness with a citation to *Cybor*, stating "Whether a claim limitation invokes means plus function claiming under §112 ¶6 is a matter of claim construction and therefore a question of law that we review without deference." *See Lighting Ballast Control, LLC v. Phillips Elec. N. Am. Corp. and Universal Lighting Tech., Inc.,* Appeal No. 2012-1014 (Fed. Cir 2013). The panel construed the disputed language as an invocation of § 112(6) and found the claim invalid for indefiniteness.

While a procedural question concerning whether the appellant waived its right to appeal this issue was also decided by the panel, the correctness of the District Court's claim construction is the only substantive issue on appeal. Accordingly, this case is clearly a suitable vehicle for (i) reconsideration and reversal of *Cybor*[3] and (ii) institution of the practice of treating claim construction as a mixed question of fact and law requiring deference to underlying fact finding by the district court fact unless the findings of fact are clearly erroneous.

V. THE SUPREME COURT'S JURISPRUDENCE RELATED TO *DE NOVO* REVIEW OF DISTRICT COURT DECISIONS PRESENTING MIXED QUESTIONS OF FACT AND LAW REQUIRES OVERRULING *CYBOR.*

Both the holding in *Cybor* requiring *de novo* review of claim construction without deference to the District Court's findings of fact, and the alternative

[3] It is certainly a better vehicle than *Philips v. AWH Corp.,* 415 F.3d 1303 (Fed. Cir. 2005) in which, the Court invited briefing on *Cybor* but ultimately declined to reconsider its holding.

approach that treats "*de novo*" claim construction as a mixed question of fact and law have their genesis in the Supreme Court's opinion in *Markman II*. As the Court is well aware, it held in *Markman I*, and the Supreme Court affirmed in *Markman II*, that claim construction, including ancillary fact finding that informs that construction, is exclusively the province of the trial judge.

The Supreme Court's agreement with this Court that the jury could be divested of any fact finding role necessarily raised the question of whether this practice would violate the Seventh Amendment's prescription that "the right of trial by jury shall be preserved." 517 U.S. at 376-377. Although The Court concluded that the Seventh Amendment did not bar empowering the trial court to make factual as well as legal determinations regarding claim construction, nowhere in *Markman II* did the Supreme Court expressly deal with the question of how this Court should review claim constructions by the District Courts conducted as mandated by the *Markman* decisions. Notwithstanding this Court's determination that claim construction is not a mixed fact law question and that its *de novo* review of claim construction should be without deference, there is at least a hint, a guidepost if you will, that the Supreme Court considered claim construction to be a mixed question of fact and law in light of its characterization of claim construction as a "mongrel practice (like construing a term of art following receipt of evidence) …." 517 U.S. at 378.[4]

[4] That claim construction presents a mixed question of fact and law is almost certainly beyond question in view of the other legal scenarios which the Supreme

A further indication that the Supreme Court would consider claim construction under *Markman II* to be a mixed question of fact and law -- a characterization with clear implications for appellate review -- is found in others of its opinions in which it has authorized *de novo* (or independent) review by the Courts of Appeals. For example, in *Thompson,* where the Court was reviewing an "in custody" determination under 28 U.S.C. 2254 as presenting a mixed question of law and fact, it determined that two inquiries were necessary. The first was to determine the circumstances surrounding the interrogation of a suspect and the second, given those circumstances, would a reasonable person have believed he or she was in custody or could terminate the interrogation and leave. The first inquiry was determined to be completely factual and was attended by a presumption of correctness while the second was deemed a mixed question of law and fact that qualified for independent review. 516 U.S. 116-117.

Soon after its decision in *Thompson*, the Court decided *Ornelas* involving the reasonableness of a warrantless search and seizure and, without specifically branding the review as one presenting a mixed question of law and fact, held that determinations of reasonable suspicion and probable cause for a search should be

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Court considers to present mixed questions of law and fact. Reviewing a *habeas corpus* petition under 28 U.S.C. 2254, in *Thompson v. Keohane,* at 516 U.S.at 110, the Court cited *Townsend v. Sain*, 372 U.S. 293 which characterized cases "that require application of a legal standard to the historical-fact determinations" as "Socalled mixed questions of fact and law." 372 U.S. 309, n. 6. Claim construction by its very nature requires fact findings to be made to which legal standards are applied in construction.

reviewed *de novo* on appeal. It cautioned, however, "(h)aving said this, we hasten to add that a reviewing court should take care both to review findings of historical fact only for clear error and to give due weight, i.e. deference, to inferences drawn from those facts by resident judges…." According to the Court, "The background facts provide a context for the historical facts, and when seen together, yield inferences that deserve deference" 517 U.S. at 699.[5]

In *Cooper* the Court addressed the nature of the review by a Court of Appeals of the application of the three part test articulated in *BMW of North America, Inc. v. Gore*, 517 U.S. 559 (1996) for assessing whether an award of punitive damage is constitutionally excessive. It concluded that such review should be *de novo* but with the caveat that "while we have determined that the Court of Appeals must review the District Court's application of the Gore test *de*

[5] *Thompson and Ornelas* were decided in the same term as *Markman II*. In that same term, in *Gasperini v. Center for Humanities, Inc*. 518 U.S. 415 (1996), Justice Stevens, in a dissenting opinion in which he agreed "with most of the reasoning in the Court's opinion" but not the disposition of the case expressed the view that the Court's holding in *Markman II* assigned the same type of appellate review to claim construction as was assigned in Thompson and Ornelas. He noted: "Three times this Term we have assigned appellate courts the task of independently reviewing similarly mixed questions of law and fact. See *Ornelas v. United States*, 517 U.S. 690, 696-697 (1996); *Markman v. Westview Instruments, Inc*. 517 U. S. 370, 388-390 (1996); *Thompson v. Keohane*, 516 U.S. 90, 112-116 (1995). Such appellate review is proper because mixed questions require courts to construe all record inferences in favor of the factfinder's decision and then to determine whether, on the facts as found below, the legal standard has been met." The majority did not take exception to this characterization of the cases. 518 U.S. 442-443 (emphasis added).

novo, it of course remains true that the Court of Appeals should defer to the District Court's findings of fact unless they are clearly erroneous." 517 U.S. 440.

We submit that *Thompson*, *Ornelas* and *Cooper* provide a context in which to determine how the Supreme Court views the role of the Courts of Appeal when reviewing a District Court's fact findings and inferences drawn from them made in conjunction with its analysis of a question of law. That view is that such reviews, even when considered to be *de novo,* should be considered to raise mixed questions of fact and law and that the Court of Appeals should defer to the findings of fact by the District Court unless clearly erroneous and to inferences drawn from those facts.

VI. CONCLUSION

The SDIPLA, therefore, urges the Court to overrule *Cybor* and henceforth engage in review of claim construction as a mixed question of fact and law giving deference to facts found by the District Court unless clearly erroneous and to inferences drawn from those facts. This is consistent with the Supreme Court's holding in *Markman II* concerning the role of judge and jury in patent trials and aligns this Court's practice with that so clearly directed in *Thompson, Ornelas* and *Cooper*. Adopting a standard of reviewing claim construction with deference will reduce the reversal rate on appeal, and result in fewer appeals because of litigants' greater confidence that a favorable decision by a District Court is less likely to be reversed and remanded for a new trial.

By: /s/ William L. Respess

William L. Respess

Attorney for *amicus curiae*

United States Court of Appeals
for the Federal Circuit
Lighting Ballast v Philips Electron, 2012-1014

CERTIFICATE OF SERVICE

I, Robyn Cocho, being duly sworn according to law and being over the age of 18, upon my oath depose and say that:

Counsel press was retained by SAN DIEGO INTELLECTUAL PROPERTY LAW ASSOCIATION, Attorneys for *Amicus Curiae* to print this document. I am an employee of Counsel Press.

On **July1, 2013**, counsel for *Amicus Curiae* has authorized me to electronically file the foregoing **Brief for *Amicus Curiae*** with the clerk of court using the CM/ECF system, which will serve via e-mail notice of such filing to any of the following counsel registered as CM/ECF users:

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Upon acceptance by the Court of the original e-filed document, thirty paper copies will filed with the Court, via Federal Express, within the time provided in the Court's rules.

July 1, 2013

/s/ Robyn Cocho
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CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App. P. 32(a)(7)(C), the undersigned hereby certifies that this brief complies with the type-volume limitation of Fed. R. App. P. 28.1(e)(2)(A)

1. Exclusive of the exempted portions of the brief, as provided in Fed. R. App. P. 32(a)(7)(B) and Fed. Cir. R. 32(b), the brief contains 2,416 words.

2. The brief has been prepared in proportionally spaced typeface using Microsoft Word 2007 in 14 point Times New Roman font. As permitted by Fed. R. App. P. 32(a)(7)(C), the undersigned has relied upon the word count feature of this word processing system in preparing this certificate.

Date: July 1, 2013

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