2012-1014

United States Court of Appeals for the Federal Circuit

LIGHTING BALLAST CONTROL LLC,

Plaintiff-Appellee,

v.

PHILIPS ELECTRONICS NORTH AMERIC 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-00295, Senior Judge Reed O'Connor.

MOTION FOR LEAVE TO FILE BRIEF OF AMICUS CURIAE SAN DIEGO INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PLAINTIFF-APPELLEE FOR REHEARING *EN BANC*

WILLIAM L RESPESS
SAN DIEGO INTELLECTUAL PROPERTY LAW ASSOCIATION
P.O. Box 8983
Rancho Santa Fe, CA 92067
(858) 756-3978

Counsel for Amicus Curiae

FEBRUARY 15, 2013

COUNSEL PRESS, LLC (202) 783-7288 * (888) 277-3259

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:

   William L. Respess
   P.O. Box 8983
   Rancho Santa Fe, CA 92067
   (858) 756-3978

Date: February 15, 2013

William L. Respess

San Diego Intellectual Property Law Association (SDIPLA) respectfully moves the Court, pursuant to Federal Rules of Appellate Procedure 29 and 35, for leave to file the brief submitted herewith, as *amicus curiae* in support of the Plaintiff-Appellee Lighting Ballast Control, LLC's ("LBC)") Petition for Rehearing *En Banc* (the "Petition"). Pursuant to Federal Circuit Rule 27(a)(5), SDIPLA contacted counsel for LBC and Universal Lighting Technologies, Inc. ("ULT") to ascertain whether the parties would oppose SDIPLA's motion for leave to file its *amicus* brief. Both LBC and ULT consent to SDIPLA's motion for leave. ULT wishes SDIPLA to inform the Court that its consent is not an agreement that the issue concerning the standard of review of claim construction is properly presented by the petition for rehearing. The parties to this appeal have not contributed to its preparation or filing.

The San Diego Intellectual Property Law Association (SDIPLA) is an association of members in the San Diego area interested in patents, copyrights, trademarks, trade secrets, and other areas of intellectual property law. SDIPLA members include attorneys employed by corporations, universities, and the government and in private practice. SDIPLA members represent both owners and users of intellectual property.

This case involves application of the jurisprudence of this Court with respect to reviewing patent claim construction by the District Court during the proceedings

in the District Court relating to a patent infringement. Claim construction is perhaps the most important issue determined prior to a trial on the merits of an assertion of infringement. It guides future discovery, often permits cases to be resolved by summary judgment, and frames the deliberations of the jury in the exercise of its responsibility to act as fact finder with respect to issues, for example, of infringement, enablement, novelty and obviousness.

Amicus briefs are appropriate, pursuant to Federal Rule of Appellate Procedure 29, when the party submitting the brief is "interested" in the case, and the brief is both "desirable" and "relevant to the disposition of the case." Fed. R. App. P. 29; *Neonatology Assocs., P.A. v. Comm'r of Internal Revenue*, 293 F.3d 128, 130-31 (3d Cir. 2002) (Alito, J.). As summarized below and further explained in SDIPLA's *amicus* brief, SDIPLA appears as *amicus* out of concern that the Panel's *de novo* review of the construction of elements of the claims on appeal without deference to the findings of fact by the District Court, as indeed it is required to do in view of *Cybor Corp. v. FAS Technologies*, 138 F.3d 1448 (Fed. Cir. 1998), continues an appellate practice by this Court which is inconsistent with Supreme Court authority.

As our brief submitted herewith explains in more detail, the standard for review of claim construction commanded by *Cybor* does not comport with the decisions of the Supreme Court in *Markman v. Westview Instruments, Inc.,* 517

U.S. 370 (1996); *Gasperini v. Center for Humanities, Inc*., 518 U.S. 415 (1996); and *Cooper Industries, Inc, v. Leatherman Tool Group, Inc.,* 532 U.S. 424 (2001). These precedents require review of claim constructions with, rather than without, deference to fact finding by the District Court.

The relevance of the holding in *Gasperini* to the standard for review of a District Court's claim construction is found in the Supreme Court's citation to *Markman* in its analysis of how findings of fact were to be treated on review:

> "New York's limitation requires a legal inquiry that cannot be wholly divorced from the facts but that quality does not necessarily make the question one for the fact finder rather than the reviewing court. Three times this Term we have assigned appellate courts the task of independently reviewing similarly mixed questions of law and fact. See *Omelas 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." 518 U.S. 442-443 (emphasis added).

It will not be lost on this Court that the factfinder in *Markman* to which the Supreme Court refers in *Gasperini* is the trial court engaged in claim construction. *Cooper* similarly holds that when the Courts of Appeal conduct *de novo* review of questions of law the review must be with deference to findings of fact made by the District Court. In that regard the Court said:

> "While we have determined that the Court of Appeals must review the District Court's application of the *Gore* test *de 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." (Citation Omitted) 532 U.S. 440, n. 14.

Accordingly, *Amicus Curiae* SDIPLA respectfully requests that the Court grant SDIPLA leave to file its Brief in Support of Plaintiff-Appellee's Petition for Rehearing *En Banc*, submitted herewith.

Respectfully submitted,

Dated: February 15, 2013

By: William L. Respess

William L. Respess
P.O. Box 8983
Rancho Santa Fe, CA 92067

Attorney for Amicus Curiae
San Diego Intellectual Property Law Association

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2012-1014

LIGHTING BALLAST CONTROL, LLC
Plaintiff-Appellee,

v.

PHILLIPS ELECTRONICS NORTH AMERICA CORPORATION,
Defendant

and

UNIVERSAL LIGHTING TECHNOLOGIES, INC.
Defendant-Appellant

ON MOTION FOR LEAVE TO FILE BRIEF OF AMICUS CURIAE SAN DIEGO INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF PLAINTIFF-APPELLEE'S PETITION FOR REHEARING *EN BANC*

[PROPOSED] ORDER

Upon consideration of the motion of SAN DIEGO INTELLECTUAL PROPERTY LAW ASSOCIATION for leave to file an *amicus curiae* brief in support of plaintiff-Appellee's Petition for Rehearing *En Banc*, the Court finds that the proposed brief will assist in the determination of Plaintiff-Appellee's's Petition. Accordingly, IT IS ORDERED that leave to file an *amicus curiae* brief is GRANTED.

FOR THE COURT

Date: _____

_____

United States Court of Appeals
For the Federal Circuit

United States Court of Appeals
for the Federal Circuit

Lighting Ballast v Philips Electron, 2012-1014

CERTIFICATE OF SERVICE

I, John C. Kruesi, Jr., 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 Appellant Complus Data Innovations, Inc. to print this document. I am an employee of Counsel Press.

On the **15th Day of February, 2013**, I served the within **Motion** upon:

Jonathan T. Suder
jts@fsclaw.com
Friedman, Suder & Cooke
604 E. 4th Street, Suite 200
Fort Worth, TX 76102
(817) 334-0400
Counsel for Defendant-Appellee

Steven J. Routh
srouth@orrick.com
Orrick, Herrington & Sutcliffe LLP
1152 15th Street, NW
Washington, DC 20005
(202) 339-8400
Counsel for Defendant-Appellant

Robert P. Greenspoon
Flachsbart & Greenspoon
333 N. Michigan Avenue, 27th Fl.
Chicago, IL 60601
(312) 551-9500
Counsel for Universal Lighting
Technologies, Inc.

via Federal Express, by causing 2 true copies of each to be deposited, enclosed in a properly addressed wrapper, in an official depository of Fed Ex..

Unless otherwise noted, the required copies have been hand-delivered to the Court on the same date as above.

February 15, 2013