

In the
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, Case No. 09-CV-0029.
The Honorable **Reed O'Connor**, Judge Presiding.

REHEARING *EN BANC* RESPONSE BRIEF OF PLAINTIFF-APPELLEE

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CERTIFICATE OF INTEREST

Counsel for Appellee Lighting Ballast LLC, certifies the following:

1. The full name of every party or amicus represented by me is: Lighting Ballast Control LLC.
2. The name of the real party in interest I represent is: Lighting Ballast Control LLC.
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: Lighting Ballast Control LLC is a wholly owned subsidiary of Acacia Research Group LLC, which is a wholly owned subsidiary of Acacia Research Corporation.
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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I. SHORT ANSWERS TO *EN BANC* QUESTIONS

Lighting Ballast Control LLC (“Lighting Ballast”) respectfully submits this Rehearing *En Banc* Brief. Lighting Ballast answers each of the *en banc* questions in detail in the following sections. Lighting Ballast respectfully summarizes its answers as follows:

Should this Court overrule *Cybor*?

Yes. Not only was *Cybor*¹ incorrect to apply *de novo* review to all aspects of patent claim construction (*see* Part IV, below), that incorrect standard sometimes forces this Court to reach issues over which it has no appellate jurisdiction (*see* Parts II and III, below).

Should this Court afford deference to any aspect of a district court’s claim construction? If so, which aspects should be afforded deference?

Yes. All aspects of claim construction should receive deference (*see* Part IV, below). Only a district court’s statement of the legal canons should receive plenary review.

Part V below applies the proper standard, and explains that under any standard, the Court should affirm.

¹ *Cybor Corp. v. Fas Techs.*, 138 F.3d 1448 (Fed. Cir. 1998).

II. REJECTION OF *CYBOR* AND ADOPTION OF A DEFERENTIAL STANDARD WILL ALTER THE JURISDICTIONAL PARADIGM OF THIS APPEAL

Before this Court can review a trial court's claim construction, it must first determine whether it has appellate jurisdiction to review that construction at all. In its *amicus* brief, the United States observed that this is a threshold question:

[I]f this Court concludes that the district court rendered a factual finding in construing the claim term “voltage source means,” then this Court must accept the veracity of that finding for purposes of this appeal unless the Court concludes that the finding was clearly erroneous (***and that any such objection was properly preserved***).

(Br. for the United States 21-22 (emphasis added)).

In *Ortiz v. Jordan*, the Supreme Court clarified that a court of appeal generally has no power to review a district court's order denying summary judgment: “May a party, as the Sixth Circuit believed, appeal an order denying summary judgment after a full trial on the merits? Our answer is no.” *Ortiz v. Jordan*, 131 S. Ct. 884, 888-89 (2011) (internal footnote omitted). This clear, broad holding of *Ortiz* makes no distinction between bench or jury trials, nor does its reach depend on whether particular issues are decided at trial by a judge or jury.

Ortiz did not decide whether “purely legal” issues, *i.e.*, “neat abstract issues of law” presented and then denied on summary judgment, must be re-raised at trial to be preserved. *Id.* at 892-93. Under *Cybor*, all aspects of claim construction are pure questions of law. *Cybor*, 138 F.3d at 1456. On that basis, the panel rejected

Lighting Ballast’s contention that Universal Lighting Technologies, Inc. (ULT) failed to preserve for appellate review its first three issues. Panel Op. 6.

Cybor must be overruled because it causes this Court to exceed its judicial power. *Cybor*’s erroneous holding that claim construction is a pure issue of law forces the Court to review non-appealable interlocutory orders involving claim constructions that are later finalized and placed at issue in a full trial on the merits. But claim construction is *never* a pure issue of law. It always involves factual inquiries. *Markman v. Westview Instruments, Inc. (Markman II)*, 517 U.S. 370, 390 (1996) (“[T]here is sufficient reason to treat construction of terms of art like many other responsibilities that we cede to a judge in the normal course of trial, notwithstanding its evidentiary underpinnings.”). ULT has left the Court powerless to review the district court’s orders denying summary judgment on indefiniteness.

A. Claim Construction Is Never a Purely Legal, “Neat Abstract Issue of Law”

In *Ortiz*, the Supreme Court contrasted: (1) the abstract legal issue of “the substance and clarity of pre-existing law” in a qualified immunity analysis, with (2) the concrete issue of whether the defendants’ conduct comported with the Constitutional requirements of the pre-existing law. *Ortiz*, 131 S. Ct. at 892-93. The *Ortiz* Court declined to rule on the appealability of orders denying summary judgment to the extent they concern “neat abstract issues of law.” *Id.* at 893. However, the *Ortiz* Court definitively held that the concrete application of law to

the particular evidence of a given case, used to deny summary judgment, cannot be appealed after a full trial on the merits. *Id.*

Patent claim construction is never a purely legal, “neat abstract issue of law” under *Ortiz*. In *Markman II*, the Supreme Court inquired into whether claim construction is subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed claim term. This inquiry presupposed that claim construction is *not* a purely legal question. Litigants have never been entitled to have a jury decide purely legal issues. If claim construction were a pure question of law,

there would have been no need for [*Markman II*’s] extensive exegesis about the Seventh Amendment and whether juries must construe claims that have evidentiary underpinnings or whether the importance of uniformity is best served by giving these evidentiary questions of meaning to a judge. It would have been a simple matter for the [Supreme] Court to give short shrift to this argument by proclaiming construction purely, solely, and always a matter of law that would never have gone to the jury.

Cybor, 138 F.3d at 1464 (Mayer, J., concurring).

Examples of such abstract legal propositions that apply without regard to the facts of a particular case include: whether applicable law permits a condominium owner to use force to eject a trespasser from the building’s common areas (*Feld v. Feld*, 688 F.3d 779, 781-82 (D.C. Cir. 2012)); the legal implications of an ERISA plan participant’s unawareness of a Plan Summary (*Mauser v. Raytheon Co. Pension Plan for Salaried Employees*, 239 F.3d 51, 55 (1st Cir. 2001)); whether

donning and doffing required work attire meets statutory definitions under federal labor laws (*Lopez v. Tyson Foods Inc.*, 690 F.3d 869, 875 (8th Cir. 2012)); whether speech regarding a jail’s disciplinary process is a matter of public concern (*Houskins v. Sheahan*, 549 F.3d 480, 489 (7th Cir. 2008)); and whether a district court may consider evidence outside of an administrative record (*Banuelos v. Construction Laborers’ Trust Funds for So. Calif.*, 382 F.3d 897, 902 (9th Cir. 2004)).

By contrast, patent claim construction is never an abstract legal inquiry. Even if this Court were to hold that some claim constructions do not entail factual findings entitled to deference on appeal, an “intrinsic evidence” construction is still not a “neat abstract issue of law” under *Ortiz*. It is the end result of a “mongrel practice” involving the application of legal cannons of claim construction to a specific and technical evidentiary record. *Markman II*, 517 U.S. at 378.

B. *Cybor* Permits Appellants to Challenge Early-Stage Trial Court Orders on the Basis of Later-Acquired Evidence

An order denying summary judgment is generally unappealable after a “full trial on the merits.” *Ortiz*, 131 S. Ct. at 891. This is because the larger evidentiary record at the time of trial replaces the nascent record on which the trial court denied summary judgment:

Once the case proceeds to trial, the full record developed in court supersedes the record existing at the time of the summary judgment motion. . . . [The defense of qualified immunity] remains available to

the defending officials at trial; but at that stage, the defense must be evaluated in light of the character and quality of the evidence received in court.

Id. at 889.

The development of the evidentiary record in a patent case, after the denial of a dispositive motion, assists the trial court with its construction of disputed claim language. In this case, for example, ULT appeals from the construction of “voltage source means,” as set forth in the trial court’s December 2, 2010, Amended *Markman* Ruling. (ULT Panel Br. 2, “Issues Presented” no. 1). However, ULT assigns error based largely on expert deposition testimony from February 18, 2011. (ULT Panel Br. 2, citing A1619-30). The panel’s decision, which followed *Cybor*’s command to review the entire record *de novo*, relied heavily on this deposition testimony. Panel Op. 10 (citing to A1623).

Thus, *Cybor* flips the rationale of *Ortiz* on its head. Under *Ortiz*, the complete evidentiary record after a full trial on the merits supersedes the record at the summary judgment stage. Under *Cybor*, the trial court’s non-final *Markman* orders and the trial court’s claim construction rulings made in orders denying summary judgment may be second-guessed on appeal with evidence that was not even in the record at the time of the order from which the appeal is taken.

The root of this problem is *Cybor*’s refusal to acknowledge the factual underpinnings of claim construction: “The district court’s claim construction,

enlightened by such extrinsic evidence as may be helpful, is still based upon the patent and prosecution history.” *Cybor*, 138 F.3d at 1454. In this case, Judge O’Connor may rightly wonder how a deposition taken in February 2011 was supposed to enlighten his December 2010 *Markman* order.

C. To Resolve its Conflict with Other Courts of Appeal, this Court Should Overrule *Cybor* and Apply *Ortiz* to All Non-Final *Markman* Orders and to Orders Denying Summary Judgment

Four regional circuits prohibit *all* appeals from orders denying summary judgment after a full trial on the merits – even where the issue on appeal is purely legal. *Ji v. Bose Corp.*, 626 F.3d 116, 127-28 (1st Cir. 2010); *Chesapeake Paper Prods. Co. v. Stone & Webster Eng’g Corp.*, 51 F.3d 1229, 1235 (4th Cir. 1995); *Black v. J.I. Case Co.*, 22 F.3d 568, 571 n.5 (5th Cir. 1994²); *Lopez*, 690 F.3d at 875. If this Court permits ULT to appeal from the December 2010 *Markman* order (issue 1, ULT Panel Br. 2) or from the May 2011 order denying summary judgment (issues 2 and 3), the decision in this case will conflict with decisions in the First, Fourth, Fifth and Eighth Circuits.

Endorsement of ULT’s petition-stage position regarding *Ortiz* would put this Court in conflict with two additional circuits. In opposing Lighting Ballast’s *en banc* request, ULT argued that *Ortiz* is inapplicable because “claim construction

² *Becker v. Tidewater, Inc.*, 586 F.3d 358, 365 n.4 (5th Cir. 2009) conflicts with *Black*, but *Black* controls as the earlier decision. *Wade v. Hewlett-Packard Dev. Co. LP Short Term Disability Plan*, 493 F.3d 533, 542 (5th Cir. 2007) (“When there are conflicting panel decisions, the earliest panel decision controls.”).

unquestionably is a matter for the court, not the jury, and so litigants are not required to re-argue claim construction at the trial stage.” (CAFC Dkt. No. 68 at 3 n.2). Of course, all purely legal issues are matters for the court, not the jury, and yet the First, Fourth, Fifth and Eighth Circuits *do* require legal issues to be re-asserted at the trial stage. Furthermore, even though the Tenth and Eleventh Circuits permit the appeal of a purely legal issue in an order denying summary judgment, such orders are generally non-appealable after full bench trials on the merits. *Boyles Galvanizing & Plating Co. v. Hartford Acci. & Indem. Co.*, 372 F.2d 310, 312 (10th Cir. 1967); *Lind v. United Parcel Serv., Inc.*, 254 F.3d 1281, 1286 (11th Cir. 2001).

ULT has thus charted for this Court a collision course with six other courts of appeal. Lighting Ballast’s jurisdictional position does not conflict with any circuit court decisions, except cases the Supreme Court rejected in *Ortiz*. This Court should reject ULT’s invitation to make this case the vehicle through which the Supreme Court resolves a circuit split over the appealability of non-final orders after a full trial on the merits.

D. ULT’s Jury Charge Waiver Gives the Court the Option of Reserving for Another Case the Post-*Cybor* Application of *Ortiz* to Claim Construction Orders

By overruling *Cybor*, this Court may avoid dealing with the implications of *Ortiz*. Under the doctrine of jury charge waiver, ULT waived its first three

appellate issues (the same issues that implicate appealability under *Ortiz*). (*See* Lighting Ballast Panel Br. 38, 43-44, 47, noting ULT’s “rectifier” proffer). The Court could assume, without deciding, that notwithstanding *Ortiz*, it has the power to review ULT’s first three appellate issues. Still, ULT waived those issues under Fifth Circuit law. *See Jimenez v. Wood County*, 660 F.3d 841, 846 n.7 (5th Cir. 2011) (*en banc*) (stating law of, and policy reasons for, charge waiver).

In rejecting Lighting Ballast’s jury charge waiver argument, the panel relied on *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008):

Once ULT’s position regarding the “voltage source means” was made clear to the district court, ULT was not required to renew its arguments during jury instructions. *See O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 521 F.3d 1351, 1359 (Fed. Cir. 2008) (“When the claim construction is resolved pre-trial, and the patentee presented the same position in the [pre-trial] proceeding as is now pressed, a further objection to the district court’s pretrial ruling may indeed have been not only futile but unnecessary.”).

Panel Op. 7. But respectfully, *Jimenez* expressly overruled Fifth Circuit case law that allowed a futility exception to jury charge waiver:

Although we have previously held that a party need not make a formal objection where it has already made its position clear to the district court, *see, e.g., Hartsell v. Dr. Pepper Bottling Co. of Texas*, 207 F.3d 269, 273 (5th Cir. 2000); *Russell v. Plano Bank & Trust*, 130 F.3d 715, 720 (5th Cir. 1997), this exception is no longer viable in light of the 2003 amendments to [Federal] Rule [of Civil Procedure] 51.

Jimenez, 660 F.3d at 846 n.7. Lighting Ballast submits that the panel did not fully appreciate how this Court’s decision in *O2 Micro* relied on a line of cases the Fifth Circuit overruled in *Jimenez*. More specifically, *O2 Micro* applied *Taita Chem. Co. v. Westlake Styrene, LP*, 351 F.3d 663, 667 (5th Cir. 2003), and *Taita Chem. Co.* followed *Russell. Taita*, 351 F.3d at 667 n.12. As shown above, *Russell* is no longer good law after *Jimenez* expressly overruled it.

ULT contends that the district court’s December 2010 *Markman* order – which issued more than six months before trial – was a rejection of ULT’s proposed jury instruction. (ULT Panel Reply Br. 11, arguing *Jimenez* inapplicable under Fed. R. Civ. P. 51(d)(1)(B)).

In fact, ULT did not propose jury instructions in any of its *Markman* briefs. (See A477-82; SA47-50). Rather, ULT was trying to avoid a jury trial altogether by urging the district court to grant judgment in its favor on its indefiniteness defense. (A482). Positions ULT took in its *Markman* briefs cannot possibly be deemed proposed jury instructions under any reasonable interpretation of Rule 51, nor can they meet the strict formality and timing requirements the Fifth Circuit demands under *Jimenez. Id.* at 845 (“All objections must be made at [the] time [dictated by Rule 51],” namely, after the court informs the parties of its intended instructions and gives them an opportunity to object outside the jury’s presence).

Judge O'Connor heard ULT's objections at the proper time. (A13406-10). The "voltage source" issue was not among them.

III. APPLICATION OF *ORTIZ* TO ULT'S APPEAL OF THE DISTRICT COURT'S ROLLING CONSTRUCTION OF "VOLTAGE SOURCE MEANS"

If *Cybor* is overruled, this Court must apply *Ortiz* to reject ULT's attempted appeal from non-final summary judgment orders.

A. ULT Appeals the Denial of Its *De Facto* Motion for Summary Judgment on Indefiniteness

ULT assigns error to, and appeals from, the district court's December 2010

Markman order:

Did the district court err in its December 2, 2010 Amended Claim Construction Order by reversing its initial *Markman* ruling that "voltage source means" is a means-plus-function limitation lacking corresponding structure in the specification, and thus is invalid as indefinite?

(ULT Panel Br. 2). The "initial" August 2010 *Markman* ruling to which ULT refers was a *de facto* summary judgment in ULT's favor, as the panel recognized. Panel Op. 4. The district court later reconsidered and vacated that earlier *Markman* order. (A1, A16-24). That reversal denied ULT summary adjudication of its indefiniteness defense. ULT contends this was error and that, based on undisputed evidence, the district court, in December 2010, should have found the asserted claims of the '529 Patent to be indefinite.

B. The December 2010 *Markman* Order Was Not Final with Regard to Claim Construction, the Factual Findings Underpinning Claim Construction, or ULT’s Indefiniteness Defense

Before the panel, ULT criticized the district court for its willingness to reconsider and modify its earlier claim construction orders:

Remarkably, the district court issued each of its four erroneous claim construction rulings *after* the initial *Markman* order ruled that the ‘529 patent’s “voltage source means” limitation is indefinite for failure to identify any structure corresponding to the claimed “means.” . . . The district court thus changed the rules of the game repeatedly, the first three times to allow LBC’s case to get to the jury, and the fourth to avoid JMOL in favor of ULT.

(ULT Panel Br. 1 (emphasis in original)). Now faced with the challenge of escaping the broad reach of *Ortiz*, ULT will likely reverse course and contend that the “rules of the game” were set in stone in December 2010 – at least with regard to the district court’s construction of “voltage source means” and ULT’s indefiniteness defense.

Nothing about “voltage source” or indefiniteness was finally adjudicated in the district court’s December 2010 *Markman* order. Judge O’Connor explained that he had reconsidered his initial ruling and was now engaging in “rolling claim construction.” (A19, quoting *Jack Guttman, Inc. v. Kopykake Enters., Inc.*, 302 F.3d 1352, 1361 (Fed. Cir. 2002) (encouraging trial judges to revisit and alter their claim interpretations as their understanding of the technology evolves)). To discourage unmeritorious motions for reconsideration, Judge O’Connor

preemptively clarified “that any further revisions to any of the Court’s claim constructions in this order [would not] be necessary or likely.” (A19). However, he stopped short of holding that his “voltage source” construction was final for trial purposes or constituted a final adjudication of ULT’s indefiniteness defense.

After the December 2010 *Markman* order, ULT did not act as though it considered the order final. In February 2011, ULT deposed Lighting Ballast’s expert, Dr. Victor Roberts, regarding the “voltage source” limitation and the corresponding structure in the specification. (A1618-30). ULT confronted Dr. Roberts with Judge O’Connor’s claim construction and attempted to elicit testimony that would undermine it. (*See, e.g.*, A1618: “Do you have an understanding of what the judge’s construction of ‘voltage source means’ is?”).

ULT moved for summary judgment on February 25, 2011 on, among other things, its indefiniteness defense, attaching excerpts from the February 18, 2011, deposition of Dr. Roberts. (A997-99, A1567-1631). Lighting Ballast opposed ULT’s indefiniteness arguments, not on the ground that the issue had been finally adjudicated against ULT, but on the ground that ULT had failed to produce evidence contradicting the unchallenged testimony of Lighting Ballast’s experts. (SA159).

In his May 4, 2011, order denying the indefiniteness portion of ULT’s motion for summary judgment, Judge O’Connor addressed ULT’s arguments on

the merits and found that ULT had presented “no additional basis for holding the asserted claims invalid.” Accordingly, he “decline[d] ULT’s invitation to address the same issue a third time.” (A62).

If Judge O’Connor had considered his December 2010 *Markman* order final as to claim construction and indefiniteness, then he would have had to address the threshold question of whether ULT had met its heavy burden under Rule 59(e) to show the need for reconsideration of a final order. ULT understood this burden well, having briefed the Fifth Circuit’s requirements for reconsideration in its opposition to Lighting Ballast’s motion for reconsideration. (SA84-85). ULT did not style its February 2011 motion for summary judgment as a motion for reconsideration under Rule 59(e). ULT was simply trying to roll back Judge O’Connor’s non-final December 2010 construction.

C. At Trial, ULT Was Free to Present Evidence on the Proper Construction of “Voltage Source Means” and Was Free to Seek Jury Resolution of Its Indefiniteness Defense

Attempting to distinguish *Ortiz*, ULT claims its indefiniteness defense “could not have been, ‘fully heard ... during a jury trial.’” (ULT Panel Reply Br. 5 (quoting *Owatonna Clinic v. Med. Prot. Co.*, 639 F.3d 806, 810 (8th Cir. 2011))). That is not so: “Like enablement, definiteness, too, is amenable to resolution by the jury where the issues are factual in nature.” *BJ Servs. Co. v. Halliburton Energy Servs.*, 338 F.3d 1368, 1372 (Fed. Cir. 2003). Likewise, nothing prevented ULT

from presenting to the district court, outside of the jury's presence, evidence the court might consider in finalizing its jury instructions and charge.³

The record at trial, for both the construction of the “voltage source” limitation and the issue of indefiniteness, begins and ends with ULT's proffered jury instruction that defined the voltage source limitation as a “rectifier.” (A5202, A165). ULT did not move under Rule 50 for judgment as a matter of law on its indefiniteness defense. Instead, ULT capitulated on the construction of “voltage source” and on its indefiniteness defense.⁴ Neither Judge O'Connor nor Lighting Ballast had any notice that ULT intended to raise these issues on appeal.⁵

D. ULT Led the Trial Court and Lighting Ballast to Believe It Had Capitulated on Its Indefiniteness Defense

Appellate courts have long recognized that litigants should not be allowed to use summary judgment as a “bomb planted within the litigation at its early stages

³ *Ortiz* does not distinguish between evidence presented to the jury and evidence presented to a judge outside the jury's presence. Either way, ULT was free to pursue its indefiniteness defense at trial.

⁴ Lighting Ballast objected at trial to ULT's willful infringement expert, who tried to opine on the “voltage source” limitation. Lighting Ballast objected not because the issue of indefiniteness had been previously adjudicated, but rather because the witness (a patent lawyer) did not have expertise to opine on how the limitation should be understood by one skilled in the lighting ballast art. (*See* A13144 (basis of objection), A4521 (applicable motion in limine)).

⁵ *Cf. Creo Products, Inc. v. Presstek, Inc.*, 305 F.3d 1337, 1346 (Fed. Cir. 2002) (allowing appeal because “district court on two separate occasions noted that Creo had preserved the arguments it made during the claim construction proceedings: once orally on the first day of trial, and a second time in a footnote in its written opinion”).

and exploded on appeal.” *Holley v. Northrop Worldwide Aircraft Servs., Inc.*, 835 F.2d 1375, 1377 (11th Cir. 1988); *see also Lind*, 254 F.3d at 1283; *Pahuta v. Massey-Ferguson, Inc.*, 170 F.3d 125, 131 (2d Cir. 1999); *Whalen v. Unit Rig, Inc.*, 974 F.2d 1248, 1251 (10th Cir. 1992); *Watson v. Amedco Steel, Inc.*, 29 F.3d 274, 277 (7th Cir. 1994). Even a purely legal issue should not be appealable from an order denying summary judgment where review of the denial unfairly surprises the opposing party, or the trial court had no opportunity to review its denial before that issue was appealed. *See Rekhi v. Wildwood Industries, Inc.*, 61 F.3d 1313, 1318 (7th Cir. 1995).

By emphasizing the general requirement that issues raised at the summary judgment stage must be renewed at trial, *Ortiz* ensures that the trial court and opposing party receive notice that an issue is being preserved for appeal. Had ULT done anything at trial to indicate it was not capitulating on its proposed construction of the “voltage source” limitation or its indefiniteness defense, Lighting Ballast could have bolstered its positions on these issues while the evidentiary record was still open.

Precisely what evidence Lighting Ballast would have put before the jury or district court regarding the disputed claim construction or ULT’s indefiniteness defense is a matter of speculation on appeal. That speculation flows from ULT’s decision to abandon, silently, its contentions regarding “voltage source” and

indefiniteness. ULT embraced the “rectifier” ruling at trial and relied on it to ease its invalidity proof. (A13187-88). Whatever its reasons, ULT’s surrender at trial does not convert a pretrial order denying summary judgment into an appealable order under *Ortiz*.

IV. *CYBOR* SHOULD BE OVERRULED BECAUSE CLAIM INTERPRETATION IS A QUESTION OF FACT, AND CLAIM CONSTRUCTION IS A MIXED QUESTION OF FACT AND LAW DESERVING DEFERENTIAL REVIEW

A. The Question is Not Whether to Overrule *Cybor*, but By How Much

Both parties and most *amici* agree that *Cybor* should be overruled, at least in part. Numerous active judges of this Court have questioned the blanket *de novo* standard of review expressed in *Cybor*.⁶ To an objective observer, the question now is not *whether* to overrule *Cybor*, but by how much.

The proper standard of review for all factual findings incident to claim construction is clear error. The district court’s claim interpretation, in its entirety and including the rejection of ULT’s indefiniteness defense, should be sustained unless clearly erroneous (and assuming ULT properly preserved its objection for

⁶ See, e.g., *Retractable Techs. v. Becton Dickinson & Co.*, 659 F.3d 1369, 1373 (Fed. Cir. 2011) (Moore, J. and O’Malley, J., dissenting from denial of rehearing *en banc*); *Amgen, Inc. v. Hoechst Mario Roussel, Inc.*, 469 F.3d 1039, 1043 (Fed. Cir. 2006) (Newman, J., dissenting from denial of rehearing *en banc*); *id.* at 1045 (Gajarsa, J., joined by Linn, J. and Dyk, J., concurring in denial of rehearing *en banc*) (willing to reconsider *Cybor* where claim construction depends on extrinsic evidence); *Cybor*, 138 F.3d at 1474 (Rader, J., dissenting).

appeal). While clear error review of the mixed question of claim construction “is deferential, it is not toothless.” *In re Agnew*, 144 F.3d 1013, 1014 (7th Cir. 1998).

B. Claim Definiteness and Claim Construction Involve Ultimate and Subsidiary Findings of Fact, Each Reviewable for Clear Error

To analyze claim definiteness, one must determine whether a person of ordinary skill in the art would find the patent claim “insolubly ambiguous,” *i.e.*, can ordinary artisans in the field ascertain a definite claim meaning? *Ultimax Cement Mfg. Corp. v. CTS Cement Mfg. Corp.*, 587 F.3d 1339, 1352 (Fed. Cir. 2009) (“Indefiniteness requires a determination whether those skilled in the art would understand what is claimed.”). In discussing a patent for an improved method of manufacturing steel, the Supreme Court explained:

[T]he specification of the patent is not addressed to lawyers, or even to the public generally, but to the manufacturers of steel, and any description which is sufficient to apprise them in the language of the art of the definite feature of the invention, and to serve as a warning to others of what the patent claims as a monopoly, is sufficiently definite to sustain the patent.

Carnegie Steel Co. v. Cambra Iron Co., 185 U.S. 403, 437 (1902).

Thus, indefiniteness is a question of ultimate fact.⁷ Ultimate facts receive clear error review. *Pullman-Standard v. Swint*, 456 U.S. 273, 293 (1982)

⁷ “An ultimate fact is one that is essential to the maintenance of the lawsuit,” including the statutory elements of a claim, whereas evidentiary facts are “[t]hose facts which are necessary for the determination of the ultimate facts, they are the premises upon which conclusions of ultimate facts are based.” Cynthia L. Randall, *Acquittals in Jeopardy: Criminal Collateral Estoppel and the Use of Acquittal Act*

(discriminatory intent a finding of ultimate fact reviewed for clear error); *see also* Fed. R. Civ. P. 52(a) (all factual findings, whether or not based on testimony, reviewed for clear error). Numerous panels of this Court have recognized the evidentiary underpinnings of the indefiniteness defense. *Spansion, Inc. v. Int’l Trade Comm’n*, 629 F.3d 1331, 1345 (Fed. Cir. 2010) (“The ALJ had a right to credit [expert] testimony [of claim meaning and no indefiniteness].”); *Ultimax Cement*, 587 F.3d at 1352 (reversing summary judgment of indefiniteness after considering patentee’s expert declaration); *BJ Svcs.*, 338 F.3d at 1372 (“Like enablement, definiteness, too, is amenable to resolution by the jury where the issues are factual in nature.”).

Since claim interpretation always informs the definiteness analysis, claim interpretation itself is a finding of ultimate fact. That is because the process of claim interpretation (as opposed to “construction”) is the determination of what meaning one of ordinary skill in the art would impute to the words of a claim in the context of the intrinsic record. *Inventio AG v. Thyssenkrupp Elevator Ams. Corp.*, 649 F.3d 1350, 1356-59 (Fed. Cir. 2011) (definiteness inquiry must consider meaning to artisan in context of intrinsic record); *accord Markman v. Westview Instruments, Inc. (Markman I)*, 52 F.3d 967, 1000-02 (Fed. Cir. 1995) (Newman,

Evidence, 141 U. Pa. L. Rev. 283, 292 n.46 (1992), citing *Black’s Law Dictionary*, 557 (6th ed. 1990) (citing *Womack v. Industrial Comm’n*, 168 Colo. 364, 451 P.2d 761 (1969)).

J., dissenting) (noting distinction between claim interpretation and claim construction, the former being ascertainment of meaning of terms to a person of ordinary skill, and the latter being the resulting legal scope after application of legal canons).

In *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966), one of the subsidiary “facts” underlying the obviousness inquiry was the “difference between the prior art and the claims at issue.” In *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 811 (1986), the Supreme Court underscored the factual nature of this *Graham* factor. It remanded to this Court “for further consideration in light of Rule 52(a)” because this Court “did not explicitly apply the clearly-erroneous standard to any of the District Court’s findings on obviousness, and did not explain why, if it was of that view, Rule 52(a) had no applicability to this issue.” *Dennison* quoted the *Graham* factors, reaffirming that the *Graham* decision “makes it clear that whether or not the ultimate question of obviousness is a question of fact subject to Rule 52(a), *the subsidiary determinations* of the District Court, at the least, ought to be subject to the Rule.” *Id.* (emphasis added). One such “determination” is the difference between the prior art and the claims, which necessarily requires ascertainment of claim meaning.⁸

⁸ *Graham* is not the only example in intellectual property where the “meaning” of something is deemed a question of fact. “Secondary meaning” in trademark and trade dress law is well established as a question of fact, reviewed under the clearly

The *Cybor* majority held otherwise, stating its belief that the Supreme Court endorsed, and did not overrule, the *de novo* review standard expressed in *Markman I. Cybor*, 138 F.3d at 1455. Distinguished *amici* (e.g., ABA, AIPLA) disagree and cite to Judge Mayer’s opinion in *Cybor*, 138 F.3d at 1464, which articulated the majority’s error. Again, if *Markman I* were correct that claim construction is a pristine issue of law reviewed entirely *de novo*, then *Markman II* would have had no need to perform the “extensive exegesis” that it did to decide whether a Seventh Amendment right to a jury trial attaches. *Markman II* addressed the historical and policy prongs of Seventh Amendment jurisprudence because the easy answer was not the correct answer.

Like *Graham* and *Dennison*, *Markman II* explained that claim construction is a “mongrel practice” with “evidentiary underpinnings.” *Markman II*, 517 U.S. at 378, 390. In “*treating* interpretive issues *as* purely legal,” with regard to the allocation of the task to judges instead of juries, *Markman II* avoided saying such issues “are” purely legal. *See id.* at 391 (emphasis added). The Supreme Court noted that a trial court may be “aided by expert testimony” and by the “light furnished by [them] relevant to the significance of such words or phrases” that might be “terms of art or science used in letters patent.” *Id.* at 387. In this way,

erroneous standard. *GH Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 1294 (Fed. Cir. 1990); *see also St. Luke’s Cataract & Laser Inst. v. Sanderson*, 573 F.3d 1186, 1209 (11th Cir. 2009).

Markman II permits more than simply using experts to find the established meaning of terms, or to determine whether there are known synonyms. Experts may be used to plumb “the significance” of technical terms and phrases. *Markman II* never suggests that findings about claim meaning are not factual findings, reviewable for clear error. *Markman II* also relied on 19th Century decisions that, while confirming an historical practice of allocating the task to courts rather than juries, recognize a trial court’s role in finding facts about claim meaning. For example, in *Bischoff v. Wethered*, 9 Wall. 812, 815 (1870) (cited in *Markman II*), the Supreme Court explained that:

the specifications of patents for inventions are documents of a peculiar kind. They profess to describe mechanisms and complicated machinery, chemical compositions and other manufactured products, which have their existence in pais, outside of the documents themselves; and which are commonly described by terms of the art or mystery to which they respectively belong; and these descriptions and terms of art often require peculiar knowledge and education to understand them aright; and slight verbal variations, scarcely noticeable to a common reader, would be detected by an expert in the art, as indicating an important variation in the invention.

Even ULT acknowledges that trial courts make findings of disputed historical fact on the way to ruling on patent claim construction. (ULT Br. 24-26). ULT also acknowledges that such findings must be reviewed for clear error because of the statutory mandate of Rule 52(a). (ULT Br. 24). In this way, the parties agree that at least part of *Cybor* should be overruled. But, ULT incorrectly

advocates for *de novo* review for all other types of factual findings, such as those based on undisputed facts, or those based on documentary evidence alone.

The law forbids ULT's arbitrary boundaries. In 1985, the Supreme Court amended Rule 52 to confirm that all factual findings receive clear error review, regardless of whether they are based on testimony or documents. Upon ratification under 28 U.S.C. §§ 2071, *et seq.*, amended Rule 52 acquired the force of a federal statute. *See In re Grand Jury Proceedings*, 616 F.3d 1186, 1196 (10th Cir. 2010). The law does not permit deviations from clear error review or favor certain kinds of factual findings over others:

Rule 52(a) broadly requires that findings of fact not be set aside unless clearly erroneous. It does not make exceptions or purport to exclude certain categories of factual findings from the obligation of a court of appeals to accept a district court's findings unless clearly erroneous. It does not divide facts into categories; in particular, it does not divide findings of fact into those that deal with "ultimate" and those that deal with "subsidiary" facts.

Pullman-Standard, 456 U.S. at 287. ULT tries to slice the divisions even finer than the offending party in *Pullman-Standard* by proposing subcategories for "subsidiary" facts (*i.e.*, "disputed" versus "nondisputed," and "historical" versus "nonhistorical"). If the division between "ultimate" and "subsidiary" factual findings did not justify a split standard of review, then the further division of "subsidiary" findings into finer slices and subcategories surely cannot.⁹

⁹ This Court has long recognized that it must review factual findings inferred from

ULT's proposed framework makes no sense, would be unworkable, and would lead to bizarre results. Under ULT's framework, a finding would be subject to *de novo* review if undisputed, but subject to clear error review if disputed. The very findings most likely to be accurate (since undisputed) would become the most vulnerable to reversal on appeal. In an ironic twist, ULT relies heavily on its own failure to present contrary expert testimony in support of its call for *de novo* review. (ULT Br. 14-15, 26). This argument is particularly specious. It would vary the standard of review for given findings according to the tactical litigation choice of whether a party objected in a court filing or proffered contrary evidence.

C. A “Mixed Question” Characterization Also Yields Clear Error Review

As shown, claim interpretation is an issue of ultimate fact and therefore receives clear error review, without exception. *Pullman-Standard*, 456 U.S. at 287. Claim “construction” requires a more nuanced analysis. If claim “construction” is a mixed question of law and fact (as *Markman II* holds by calling it a “mongrel practice”), then choosing the standard of review becomes more complex. Here,

undisputed evidence under the clearly erroneous standard of review. *See, e.g., W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 1125 (Fed. Cir. 1994); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1126-27 (Fed. Cir. 1993); *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1570-71 (Fed. Cir. 1987); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1580-82 (Fed. Cir. 1987); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384-85 (Fed. Cir. 1986).

even if this Court characterizes claim construction as a mixed question of law and fact, clear error review should still apply.

In *Pierce v. Underwood*, 487 U.S. 552 (1988), the Court observed that some appellate standards of review are “answered by relatively explicit statutory command.” *Id.* at 558. That fairly describes Rule 52(a). But when a trial court determination is one for which neither a clear statutory prescription nor a historical tradition exists, it is “uncommonly difficult” to derive an analytical framework from the pattern of appellate review of other questions. *Id.* *Pierce* looked to *Miller v. Fenton*, 474 U.S. 104 (1985), for guidance on mixed questions of fact and law (*i.e.*, those not covered by Rule 52(a)). *Id.* at 559-60; *see also Ornelas v. U.S.*, 517 U.S. 690, 701 (Scalia, J., dissenting) (“[T]here is no rigid rule with respect to mixed questions.”). In *Miller*, the Supreme Court noted:

in those instances in which Congress has not spoken and in which the issue falls somewhere between a pristine legal standard and a simple historical fact, the fact/law distinction at times has turned on a determination that, as a matter of the sound administration of justice, one judicial actor is better positioned than another to decide the issue in question.

Id. at 114. This means that “deferential review of mixed questions of law and fact is warranted when it appears that [1] the district court is ‘better positioned’ than the appellate court to decide the issue in question or that [2] probing appellate scrutiny will not contribute to the clarity of legal doctrine.” *Salve Regina College v. Russell*, 499 U.S. 225, 233 (1991) (citing *Miller.*). While the presence of either factor

justifies deferential review, history under *Cybor* has proven that both factors apply to patent claim construction.

1. District Courts are Better Positioned to Decide Claim Construction than This Court

Trial courts approach claim construction with more tools than this Court will ever have. Where the resolution of a mixed question is essentially factual and involves inquiry into beliefs or understandings, trial courts are better positioned to address that question. *See U.S. v. Brown*, 631 F.3d 638, 643-45 (3d Cir. 2011), (citing *U.S. v. McConney*, 728 F.2d 1195, 1202-05 (9th Cir. 1984) (*en banc*)). Special capacities of trial courts include record development, receipt and analysis of oral and non-oral evidence, and the luxury of time and unfettered access to the adversaries' counsel and witnesses.

For example, the Ninth Circuit in *McConney* chose *de novo* review for the question of whether “exigent circumstances” justify a warrantless search, because such review of police conduct “requires us to consider abstract legal doctrines, to weigh underlying policy considerations, and to balance competing legal interests,” a process that “necessarily involves us in an inquiry that goes beyond the historical facts.” *McConney*, 728 F.2d at 1205. In contrast, the Third Circuit in *Brown* (citing *McConney* and *Miller*) chose clear error review for the question of whether a warrant affidavit for a search was “recklessly false,” since the underlying inquiry

was essentially factual: state of mind and community standards. *Brown*, 631 F.3d at 645.

Here, claim construction inquiries depend on analysis of historical facts (such as understanding to a skilled artisan at a particular time), and undisputed facts (such as the content of the intrinsic record). These are “essentially factual” inquiries that hinge on state of mind (the significance of terms to artisans), and on records that vary by case. An individual patent’s claim construction never requires the court to weigh policy considerations or to balance competing interests of sectors of society (as in *McConney*).

The Supreme Court distinguishes between society-centered issues (reviewed *de novo*) and fact-centered issues (reviewed deferentially). See *Ornelas*, 517 U.S. at 696 (“reasonable suspicion and probable cause” evoke *de novo* review because they are “fluid concepts that take their substantive content from the particular contexts in which the standards are being assessed” and “acquire content only through application”); *Miller*, 474 U.S. at 115-16 (“voluntariness” of a confession reviewed *de novo* because it has “always had a uniquely legal dimension” and because question turns on “compatib[ility] with a system that presumes innocence and assures that a conviction will not be secured by inquisitorial means as on whether the defendant’s will was overborne”); contrast with *Pierce*, 487 U.S. at 561-62 (whether litigation position was “substantially justified” evokes deferential

review because underlying issues involve “multifarious, fleeting, special, narrow facts that utterly resist generalization”); *Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384, 403 (1990) (whether litigant’s position comports with Rule 11 evokes deferential review because it is as “fact specific” as the inquiry in *Pierce*).

The American Intellectual Property Law Association advocates clear error review for claim meaning and explains why district courts are better positioned to decide claim construction: this Court’s strict time and page limits, versus the district court’s luxury of time to study and receive technology tutorials, and the capacity to call for and hear expert testimony. (AIPLA Br. 6). The American Bar Association notes that “not only is it more efficient for the trial court to construct the record, the trial court is *better*, that is, more accurate, by way of both position and practice, at finding facts than appellate judges.” (ABA Br. 13, *quoting Phillips v. AWH Corp.*, 415 F.3d 1303, 1334 (Fed. Cir. 2005) (Mayer, J., dissenting)).

Members of this Court have hailed the superior institutional advantages of trial courts over the appellate court. *Cybor*, 138 F.3d at 1477 (Rader, J., dissenting) (trial courts have “tools to acquire and evaluate evidence that this court lacks”); *Markman I*, 52 F.3d at 1005 (Newman, J., dissenting) (“I doubt that an appellate court’s *de novo* finding of technologic facts is more likely to attain accuracy, than the decision of a jury or judge before whom a full trial was had.”) *quoting Anderson v. Bessemer City*, 470 U.S. 564, 574-75 (1985) (“Duplication of the trial

judge's efforts in the court of appeals would very likely contribute only negligibly to the accuracy of fact determination at a huge cost in diversion of judicial resources.”).

ULT emphasizes this Court's greater familiarity with patent *law*. (ULT Br. 23-24). However, the construction of a patent claim hinges on unique and idiosyncratic patent *facts*. Greater familiarity with legal doctrine does not necessarily translate to greater accuracy in evaluating claim meaning to a person of ordinary skill in the art. Indeed, for appellate correction itself to be accurate, a standard of review should be chosen that will encourage district judges to build the most complete record feasible. As discussed in the Federal Circuit Bar Association brief, clear error review provides such incentives for district courts to reveal their true bases for a decision (FCBA Br. 12-14). When district courts choose to rely more on extrinsic evidence when they need it the most, such choices enhance this Court's record on appeal, and thereby improve the accuracy of judicial decision-making at all levels.

ULT also argues that when there is no extrinsic evidence, the trial court holds no advantages over the appellate court in making claim construction rulings. (ULT Br. 21-23, noting that a patent is a fully integrated legal instrument). From this, ULT argues that patent standards of review should be identical to contract and statute interpretation standards of review. But, *Markman I* rejected the analogy to

contracts to minimize their sometimes-factual interpretations. *Markman I*, 52 F.3d at 984-87. Further, “patents are not baby statutes.” *Markman I*, 52 F.3d at 998 n.8 (Mayer, J., concurring).

2. Probing *De Novo* Appellate Scrutiny of Individual Claim Construction Decisions Will Not Contribute to the Clarity of Legal Doctrine

Every patent is different. The term now under review is “voltage source means for providing a constant or variable magnitude DC voltage between the DC input terminals.” It is safe to say that this precise limitation will never be under review again in any other litigated patent. The “*stare decisis*” of the construction of such a claim, if considered purely legal, extends only to the parties.¹⁰ This contrasts with questions that receive *de novo* review: “reasonable suspicion and probable cause” (*Ornelas*), “voluntariness” of a confession (*Miller*), or “exigent circumstances” (*McConney*). These “mixed” questions come up every day in state and federal courts. Appellate treatment yields a pattern of decisions that will predictably guide future conduct.

On the other hand, the limited or nonexistent precedential value of each individual claim construction counsels deferential review. In addition to the superior position of the trial court to observe demeanor, to collect evidence, and to

¹⁰ The ‘529 Patent has now expired.

deliberately review that evidence over time, the *Brown* court noted why this second rationale for picking deferential review applied:

Recklessness determinations are also likely to be highly fact-dependent, and thus to carry little precedential value: decisions will typically turn on what a particular officer did and either knew or should have known. Review of such determinations does not warrant substantial expenditure of appellate resources, because the answers to the questions presented will not be of much use in future cases with different fact patterns. The overarching goals of judicial administration thus favor affording deference to the trial court's findings.

Brown, 631 F.3d at 645. The same is true about claim construction. A given holding will not be of much use in future cases with different patents. Statements of claim construction law educate the patent law community. But individual claim construction decisions rarely, if ever, carry over.

D. ULT's Arguments for *De Novo* Review Do Not Apply or Are Wrong

ULT urges *de novo* review by misstating that *Markman II* held claim interpretation to be a pure question of law. (ULT Br. 10, 20). But as discussed above, *Markman II* did *not* so hold. Rather, *Markman II* held that claim construction is a “mongrel practice.” *Markman II*, 517 U.S. at 378. ULT relies on the part of *Markman II* stating it would be “treating interpretive issues as purely legal.” This language merely affirmed *Markman I*'s decisional allocation to the judge and not the jury. *Id.* at 391.

ULT's arguments also misapply authorities on the "application of law to fact." ULT cites only *Ornelas* and *Miller* (two decisions that conclude *de novo* review should apply to particular mixed questions) without discussing any decisions that find deferential review for mixed questions (e.g., *Pierce*, *Cooter*, *Brown*). (ULT Br. 27-29).¹¹ ULT ignores many other examples. E.g., *Thornburg v. Gingles*, 478 U.S. 30, 77-79 (1986) (clear error review for "vote dilution" finding because result "peculiarly dependent upon the facts of each case"); *U.S. v. Wright*, 873 F.2d 437, 443-44 (1st Cir. 1989) (clear error review for findings that accused was a "minor" or "minimal" participant in an offense). Nor does ULT's brief indicate awareness of the proper analytical framework. (ULT Br. 27-29). ULT argues that *de novo* review unifies precedent over time and provides guidance on the law. (ULT Br. 29). But ULT grudgingly admits that in claim construction, whatever guidance this Court can provide by construing a given fact-specific patent claim is guidance "only by analogy." (ULT Br. 29).

¹¹ ULT labels "particularly instructive" this Court's treatment of obviousness determinations as a "legal conclusion reviewed *de novo* based on fact findings reviewed for clear error under Rule 52(a)." (ULT Br. 28). This reliance is misplaced. The proper review standard is unsettled. *Dennison*, 475 U.S. at 811 ("whether or not the ultimate question of obviousness is a question of fact subject to Rule 52(a), the subsidiary determinations of the District Court, at the least, ought to be subject to the Rule.") (emphasis added). The majority opinion in *Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757 (Fed. Cir. 1988), does support *de novo* review of an obviousness conclusion (see ULT Br. 28), but Judge Newman's dissent persuasively applied the Supreme Court's *Pierce v. Underwood* decision to urge clear error review. *Id.* at 781.

ULT also argues that *de novo* review serves the ideal of “uniformity” as a policy objective, calling it the “chief” purpose. (ULT Br. 12). But finality is a more important policy goal of the judicial system. Among “reasons . . . given for deferring to decisions of lower tribunals,” the “first reason asserted is finality. The more deference given to the decision of the lower tribunal, the less likely the losing party is to appeal that decision.” Kelly Kunsch, *Standard of Review (State and Federal): A Primer*, 18 Seattle U. L. Rev. 11, 19 (1994). Deferential review will reduce court congestion (since it will reduce appellate backlog) and will serve to “maintain the morale of trial court . . . judges.” *Id.* at 20. Deferential review avoids “a high proportion of reversals on review [that] erodes public confidence in trial courts.” *Id.*

ULT also cites the policy goal of uniformity in the treatment of a given patent to argue that appellate courts are in the best position to review claim construction as a mixed question of fact and law. (ULT Br. 20, quoting *Markman II*). ULT posits that two district courts might each issue plausible yet contrary claim construction findings. (ULT Br. 36). ULT failed to show any danger that such a thing might happen. If it did, it would be the rarest of situations ever to face this Court. This Court would then fashion specific legal rules to accommodate such

situations – possibly including choosing the earlier ruling over the later one, or interposing plenary appellate review solely in that one “tiebreaker” scenario.¹²

ULT’s final policy arguments (ULT Br. 37-41) are easily dismissed. For example, this Court’s venue jurisprudence, including numerous mandamus decisions under 28 U.S.C. § 1404, has curtailed forum shopping. Provisions in the newly enacted America Invents Act help as well. *See, e.g.*, 35 U.S.C. § 299.

Deferential review would not generate “uncertainty” in the process of determining claim meaning so as to “stifle innovation.” Encouraging proper trial court record development would lead to more accurate determinations of claim meaning, which would only encourage innovation.

ULT predicts “messy, distracting disputes in every appeal” over the correct standard of review when there is a “hybrid” standard. However, Lighting Ballast does not propose any such “hybrid” standard; rather, Lighting Ballast proposes that all findings, including the mixed conclusion, receive clear error review.

ULT argues that *Phillips* has mitigated problems with *Cybor*’s requirement of a *de novo* standard of review, but this is hardly a full-throated endorsement of the status quo. ULT argues that “a broad scope of deferential review will

¹² In *Saffran v. Johnson & Johnson*, 712 F.3d 549 (Fed. Cir. 2013), no single circuit judge agreed on the right “uniform” claim construction. One commentator observed that deferential review, not *de novo* review, might have provided the uniformity ULT champions. Dennis Crouch, Patently-O Blog (Apr. 12, 2013), <http://www.patentlyo.com/patent/2013/04/stent-patent-cannot-heal-divided-claim-construction.html> (last visited June 3, 2013).

encourage litigants to attempt to posture issues disputes [sic] of fact.” (ULT Br. 40). However, Lighting Ballast’s proposal will not encourage such posturing, since *all* mixed questions would receive deferential review.

Finally, ULT warns that the public notice function will be undermined “if parties are left to wonder whether they can rely on the patent documents alone to understand the claim scope.” (ULT Br. 41). This is not an argument against a comparatively deferential review standard but against perceived flaws in the use of extrinsic evidence. Even on that level, ULT bucks experience and common sense to suggest that giving a trial court *more* tools to find the true meaning of a patent claim will lead to less certainty in the patent system.

E. “Informal Deference” Is No Substitute for a Correct Standard of Review

ULT, like several *amici*, cites a recent study by two law professors to show that a form of “informal deference” has already entered this Court’s decisions since *Phillips*.¹³ (ULT Br. 39, n.4). In so doing, ULT coins a novel standard: “due weight” under *de novo* review. (ULT Br. 11-12). The study by the law professors (hereafter, “Anderson & Menell”) does not support ULT.

Anderson & Menell explain the history of patent claims, claim construction, appellate review, trends in claim construction reversal rates from 2000 to 2011,

¹³ Jonas Anderson and Peter S.Menell, *Informal Deference: An Historical, Empirical, and Normative Analysis of Patent Claim Construction*, Nw. U. L. Rev., Vol. 108 (October 4, 2012), available at SSRN: <http://ssrn.com/abstract-2150360>.

and a “functional analysis” of appellate review that follows Supreme Court directives. They conclude that the proper standard (much like Lighting Ballast’s proposal) is to uphold claim construction rulings “if not clearly erroneous or clearly contradicted by the specification or prosecution history” (pp. 69-70).

Even though Anderson and Menell observe a trend of lowering reversal rates (40.7% of cases with at least one reversed claim term pre-*Phillips* compared to 30.8% post-*Phillips*, see p.38), they conclude that the rise of “informal deference” (“some standard that is less rigorous than *de novo*”) is explained by this Court “collectively recogniz[ing] that the decision to review every opinion *de novo* has led to confusion and discontent.” (p.57). That modest decrease in reversal rates has occurred absent “a doctrinal basis for increased deference” (p.60) and “is likely a case of the realities of judging outpacing the law.” (p.70). Anderson & Menell provide many key observations that corroborate Lighting Ballast’s analysis:

- *Cybor* misconstrued *Markman II* (pp. 23, 62),
- “the inherently factual aspects of patent claim construction” are a proper “jurisprudential basis for ‘deferring’” (p.60),
- high reversal rates have “demoralized federal district judges” (p.26),
- maintaining *de novo* review means that “[s]ome district judges have decided that it is better to provide little or no reasoning for their claim constructions” resulting in “the appellate court lack[ing] the fully developed record and reasoned opinion that would enable . . . a transparent view of what occurred . . . to evaluate its correctness” (p.64),

- private and social costs of *de novo* review include lower quality decision making at trial and appellate levels, higher costs of litigation because of more appeals and retrials, greater uncertainty, longer case pendency, and increased costs because of fewer and delayed settlements, among others (p.66),
- the “uniformity” goal has “limited benefits . . . outweighed by the drawbacks of refusing deference,” and “achieving that goal through *de novo* review misapprehends comparative institutional analysis at a heavy cost,” leading to an “artificial sense of clarity and uniformity” (p.67),
- the “sheer number of patents” means that this Court’s impact on uniformity is limited, even under a *de novo* standard of review, *i.e.*, the *de novo* standard is a “a thimble-sized solution to an ocean-sized challenge” (p.68), and
- even where “intrinsic evidence . . . inclines toward *de novo* or independent review,” the “mongrel” character of the exercise and “the standpoint of a skilled artisan” is still something “which the trial court is better placed to perceive” (p.69).

V. ASSUMING ULT PROPERLY PRESERVED ITS APPEAL, THIS COURT SHOULD AFFIRM THE DISTRICT COURT’S NONFINAL REJECTION OF INDEFINITNESS UNDER ANY STANDARD OF REVIEW

Even if this Court considers the merits, it should affirm the district court, which rejected ULT’s indefiniteness defense because “voltage source means providing a constant or variable magnitude DC voltage between the DC input terminals” connotes sufficient structure – a rectifier – to skilled artisans and is therefore not subject to §112 ¶6 treatment. Even if this Court rejects that finding and performs a further §112 ¶6 analysis, it must credit the undisputed testimony of experts, who fleshed out the patent’s explicit structural references to an AC power

line and DC input terminals to confirm the patent’s implicit disclosure of a rectifier – a corresponding structure that the prosecution history clearly links to the claimed function.

This section clarifies the state of the claim construction record below, summarizes the law of indefiniteness as applied to §112 ¶6 (now §112(f)), and demonstrates how the district court properly applied this Court’s precedent to make correct factual findings and to conclude that ULT failed to prove indefiniteness.

A. Summary of Claim Construction Record: ULT Relies on 2011 Evidence to Appeal 2010 Order

The claim construction process preceding the district court’s December 2, 2010, order spanned over eight months (SA2, A34) and created a record in excess of 500 pages. (A296-858; A141-43, Dkt. Nos. 78-107). Lighting Ballast’s opening brief included a sworn declaration from an independent technical expert, Dr. Victor Roberts, whose qualifications were never challenged. (A21). His opinions on U.S. Patent No. 5,436,529 were based on his understanding as “a person of ordinary skill in the art as of the effective filing date of the patent application,” having considered each term “in the context of the particular claim in which the disputed term appears, [and] in the context of the entire patent, including the specification.” (SA27).

Dr. Roberts stated:

The “voltage source” limitation connotes, or suggests, to me, and would connote to anyone skilled in the art, the structure of a rectifier – with its input terminals connected to an AC power line and with its output terminals connected to the DC input terminals. In other words, the only way for a lighting ballast to convert AC (from a “power line source” such as a wall outlet or other similar AC power source in a home or office) into DC (for use as the “DC supply voltage”) is through a rectifier. . . . AC power is converted into DC power through the use of a rectifier. . . . The only structure in a lighting ballast that can perform [this] function is a rectifier.

(SA29-30). This evidence was consistent with the specification, which repeatedly discloses an AC “power line source” and “power line voltage,” previously specified in Column 1 to be “120VAC.” (A194). The patent never discloses a DC power source.¹⁴

The district court received other materials, including the prosecution history, inventor testimony, ULT’s technical tutorial, and dictionary definitions. *See* Part V.C below. ULT did not submit expert testimony from any of its 19 technical experts (SA147; SA153; SA163-70) to challenge Dr. Roberts. (SA97-98). Further, ULT did not seek to depose Dr. Roberts at that time and “agree[d] that expert witnesses are not needed at the claim construction hearing.” (SA3).

¹⁴ The Panel Opinion (p. 12) cited Col.3 1.6-7 to suggest the patent “mentions drawing power from . . . DC supply voltages” In fact, that excerpt describes “DC input terminals . . . *for receiving thereacross a DC supply voltage of approximately 250 Volts.*” (A195) (emphasis added). Column 3’s text comports with a rectified AC power line (not a DC power source) feeding those terminals.

On December 2, 2010, the district court issued its amended claim construction order, ruling that, on the record presented, the voltage source limitation was not subject to §112 ¶6. (A18). Judge O’Connor did not revisit his prior analysis of corresponding structure, because he determined §112 ¶6 did not apply. Relying on “unchallenged expert testimony [and] Federal Circuit precedent” (A18), he made the following express factual finding:

[T]he Court finds that while the “voltage source means” term does not denote a specific structure, it is nevertheless understood by persons of skill in the lighting ballast design art to connote a class of structures, namely *a rectifier, or structure to rectify the AC power line* into a DC voltage for the DC input terminals.

(A22 (emphasis added), A23 (“[A] structure to rectify the line is required and is clear from the language [T]he term describes a rectifier.”)). The district court thus declared that the claimed voltage source is a rectifier, and *only* a rectifier.

The above-quoted finding is conspicuously absent from ULT’s briefing. ULT appears to deny its existence by claiming (twice) that the “district court made no such finding.” (ULT Br. 4 n.1, 51). ULT chooses instead to quote the panel’s characterization of the district court’s factual finding:

The [district] court found that, according to the limitation’s ordinary meaning, the claimed “voltage source means” corresponds to a class of structures: *a rectifier* for common applications in which the claimed device is used with an AC power line; *and a battery or the like* for less commonly used applications in which a DC power line is used.

(ULT Brief at 4, 43-44, quoting Panel Op. at 5) (emphasis added). Respectfully, the panel misstated the actual finding. The district court did *not* find that a “battery or the like” would have been understood as a type of “voltage source” in the AC “power line” context of the intrinsic record. (A22-23).

Months after the December 2010 order, on February 18, 2011, ULT deposed Dr. Roberts. On February 25, 2011, ULT filed a motion for summary judgment (A943) and supporting appendix (SA118), including excerpts from that deposition. (A1567). Despite many opportunities, and a 3,500-page summary judgment record (A936-4416, A145-49, Dkt. Nos. 126-87), ULT failed to present any expert testimony challenging Dr. Roberts’ opinions or the district court’s analysis on this issue. (SA159). On May 4, 2011 – just weeks before trial – the district court again rejected ULT’s argument on the voltage source limitation, because “ULT present[ed] no additional basis for holding the asserted claims invalid.” (A62).

A month later, ULT agreed to a jury instruction stating that the voltage source limitation “refers to a rectifier.” (A165; A5202). ULT presented no indefiniteness defense at trial and filed no motions for judgment as a matter of law on this issue. ULT’s surrender meant that Lighting Ballast saw no need to develop the record further at trial.

B. The Law of Indefiniteness Under §112 ¶6

To declare a claim indefinite under §112 ¶6, the court must perform a two-step analysis. In step one, the court seeks to determine whether §112 ¶6 applies to the limitation. If so, the court proceeds to step two, which requires the court to analyze the limitation in accordance with §112 ¶6 by identifying structure corresponding to the recited function.

1. Step One: Does §112 ¶6 apply?

A claim limitation that uses the word “means” invokes a rebuttable presumption that §112 ¶6 applies. *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1358 (Fed. Cir. 2004). However, the presumption will “collapse” if the claim connotes or describes sufficient structure for performing the recited function, despite its use of the term “means.” *See Apex, Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1372 (Fed. Cir. 2003). Thus, the presumption may be rebutted – and means-plus-function treatment averted – by evidence that the language used connotes sufficient structure to one skilled in the art.

ULT argues (without citation) that a means term must evoke “a specialized meaning in the art” to avoid §112 ¶6, and “much [sic] ‘recite’ or be ‘self-descriptive’ of structure” to rebut the presumption. (ULT Br. 44-45, 48). This is one way, but not the only way. Rather, this Court simply requires that the term, as a whole, has a “reasonably well understood meaning in the art, keeping in mind

that a claim term need not call to mind a single well-defined structure” *Id.* (internal quotations omitted). The term need not “denote a specific structure”:

“[I]t is sufficient if the claim term is used in common parlance or by persons of skill in the pertinent art to designate structure, even if the term covers a broad class of structures and even if the terms identify the structures by their function.”

Mass. Inst. of Tech. (“MIT”) v. Abacus Software, 462 F.3d 1344, 1356 (Fed. Cir. 2006), quoting *Lighting World*, 382 F.3d at 1359-60; see also *Pers. Media Comm’s, LLC v. ITC*, 161 F.3d 696, 704-05 (Fed. Cir. 1998) (“‘detector’ had a well-known meaning to those of skill in the electrical arts connotative of structure, including a rectifier or demodulator” even though claim need not “specifically evoke a particular structure”).

Concerning the intrinsic record, district courts must consider *all* of the words in the limitation, not just a portion of the limitation. *Apex*, 325 F.3d at 1372-73 (“The primary source of [the district court’s] error lies in [its] reliance on single words of the limitations . . . as opposed to the limitations as a whole”). Claim language that further defines a generic term, such as nouns or adjectives that appear *before* or *after* the word “means,” can add or suggest sufficient structure to avoid means-treatment. See *MIT*, 462 F.3d at 1354; *Apex*, 325 F.3d at 1373-74. The limitation’s functional language may also suggest sufficient structure to avoid means-plus-function treatment. See, e.g., *MIT*, 462 F.3d at 1355-56; *Linear Tech. Corp. v. Impala Linear Corp.*, 379 F.3d 1311, 1320 (Fed. Cir. 2004). Finally,

where the claims recite the term “means,” this Court has “considered the written description to inform the analysis of whether the claim recites sufficiently definite structure to overcome the presumption” *Inventio*, 649 F.3d at 1356-58.

District courts may also consider extrinsic sources, including technical tutorials, dictionary definitions, and expert testimony. *Depuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1023 (Fed. Cir. 2006) (“dictionary definitions and experts” helped avoid means-treatment); *Cybor*, 138 F.3d at 1477 (Rader, J., dissenting) (technical tutorials). This Court has repeatedly endorsed reliance on expert testimony because it is the best way to determine what the claim language conveys to one skilled in the art. *Linear Tech.*, 379 F.3d at 1319-21; *MIT*, 462 F.3d at 1355-56 (majority op.), 1363-64 (Michel, C.J., dissenting); *see also Rembrandt Data Techs., KP v. AOL, LLC*, 641 F.3d 1331, 1341-43 (Fed. Cir. 2011).

In this case, the panel suggested that the substantive law (*i.e.*, the role and weight of expert evidence on whether a means-term “connotes” or “suggests” structure to a skilled artisan) turns on which way the presumption starts. Panel Op. 10-11. No court has previously held that the “connote” or “suggest” line of cases applies only when the word “means” is absent. The same test should apply, regardless of whether the presumption is for or against means-plus-function treatment. *See, e.g., Inventio*, 649 F.3d at 1357; *cf. Power Integrations, Inc. v.*

Fairchild Semiconductor Int'l, Inc., 711 F.3d 1348, 1366 (Fed. Cir. 2013) (term without “means” avoided means-treatment because it “suggest[ed] sufficient structure,” *not* because of presumption against means-treatment); *see also Apex*, 325 F.3d at 1372 (“presumption that §112, ¶6 applies . . . ‘imposes on [the party seeking to overcome the presumption] the burden of going forward with evidence to rebut . . . the presumption, but does not shift to such party the burden of proof in the sense of the risk of nonpersuasion, which remains throughout the trial upon the party on whom it was originally cast’”) (*quoting* Fed. R. Evid. 301).

2. Step Two: Does the Specification Describe Corresponding Structure?

If a limitation is subject to means-treatment, then the court proceeds to step two, which requires analysis of the specification to identify the structure corresponding to the claimed function. *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1303 (Fed. Cir. 1999). The “structure disclosed in the specification is ‘corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.” *MIDCO v. Elekta AB*, 344 F.3d 1205, 1210 (Fed. Cir. 2003) (citations omitted). However,

“[d]isclosure of structure corresponding to a means-plus-function limitation may be implicit in the written description *if it would have been clear to those skilled in the art* what structure must perform the function recited” [I]t makes no sense to encumber the specification of a patent with all the knowledge of the past concerning how to make and use the claimed invention.

Atmel Corp. v. Info Storage Devices, Inc., 198 F.3d 1374, 1380-83 (Fed. Cir. 1999) (quoting Manual of Patent Examining Procedure and finding “high voltage generating means” not indefinite) (emphasis in original).

Under *Atmel*, expert testimony cannot make up for “a total omission of structure.” *Id.* at 1382. However, if the specification discloses at least *some* structure, a party may rely on expert testimony to “flesh out” the sufficiency of that disclosure. *Creo Prods.*, 305 F.3d at 1347 (expert “can be called upon to flesh out a particular structural reference in the specification [to] satisfy[] the statutory requirement of definiteness.”).

3. Claims Are Indefinite Only If Insolubly Ambiguous, Which Challenger Must Prove by Clear and Convincing Evidence

A court should hold a claim indefinite only after “reasonable efforts at construction prove futile.” *Exxon Research & Eng’g Co. v. U.S.*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). A claim is not indefinite merely because it poses a difficult issue of claim construction. *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372 (Fed. Cir. 2004). Only claims not amenable to construction or “insolubly ambiguous” are indefinite. *Id.*; *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347-48 (Fed. Cir. 2005). To rule on a claim of indefiniteness, “a court must determine whether those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Bancorp Servs.*, 359 F.3d at 1372.

Naturally, the indefiniteness analysis frequently involves fact-finding. *See, e.g., Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1366 (Fed. Cir. 2003). Any facts tending to show that those skilled in the art would not understand what is claimed or facts otherwise supporting a holding of invalidity must be proved by clear and convincing evidence. *Id.*; *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376-77 (Fed. Cir. 2001). Because of the presumption of validity, “close questions of indefiniteness . . . are properly resolved in favor of the patentee.” *Exxon Research & Eng’g Co.*, 265 F.3d at 1380.

C. The District Court Properly Concluded that ULT Failed to Meet Its Burden to Prove Indefiniteness

1. Under Step 1, §112 ¶6 Does Not Apply Because of the Factual Finding That the “Voltage Source” Limitation Connotes a Rectifier

LBC presented testimony from Dr. Roberts and the inventor, Andrew Bobel, to show the voltage source limitation connotes structure – a rectifier – to anyone skilled in the lighting ballast art. Both the expert and inventor stated unequivocally that a rectifier is *the only thing* a lighting ballast would ever use to convert AC from a power line source into DC for use as a DC supply voltage.

In his deposition, Bobel testified that “[w]hen [he] wrote this ‘voltage source means’ language,” he fully “intend[ed] to suggest physical structure to those skilled in the art,” namely, “a rectifier” or “structure [to] rectify the line.” (SA104-06). In his declaration, Dr. Roberts explained that in the AC power line context of

the invention, a rectifier is the only structure a skilled artisan would perceive as the claimed voltage source. (SA29-30¹⁵). For completeness, Dr. Roberts volunteered that batteries could be foreseen in other contexts, but *not* in contexts where the power comes from an AC power line.

ULT never tried to rebut Dr. Roberts' testimony that the claim limitation connotes sufficient structure, or a class of structures, to one skilled in the art. It would have been a simple exercise (if it were possible) for ULT to put forth an expert to declare that the voltage source limitation does *not* connote sufficient structure, or a class of structures, to one skilled in the art. ULT's failure to do so is fatal in this case. *See Apex*, 325 F.3d at 1374 (noting lack of compelling expert testimony and criticizing party that "relies solely on its [counsel's] arguments"); *Creo Prods.*, 305 F.3d at 1348 (crediting "expert [who] offered unrebutted testimony").

ULT cites Roberts' declaration and Bobel's deposition to argue a battery could serve as a direct DC source. The district court acknowledged this evidence but nevertheless determined that the claims, when read in context, require a rectifier. (A22-23). Nevertheless, even if a battery could serve as the claimed

¹⁵ In its panel briefing, ULT pointed to post-*Markman* testimony where Dr. Roberts correctly stated that an AC "power line" is not an explicit limitation within claim 1. (ULT Br. 54, citing A1629). That unremarkable fact does not disturb his earlier testimony, or the district court's findings, that the "voltage source" term is properly understood in an AC power line context.

“voltage source,” ULT has not addressed why a rectifier (AC to DC) and a battery (DC) would not themselves constitute a perceptible “class of structures,” such that §112 ¶6 would not apply. *Linear Tech. Corp.*, 379 F.3d at 1322 (“That the disputed term is not limited to a single structure does not disqualify it as a corresponding structure, as long as the class of structures is identifiable by a person of ordinary skill in the art.”); *Power Integrations, Inc.*, 711 F.3d at 1365 (“[A]s the district court pointed out, a variety of structures can be used to provide the claimed function. Nevertheless, viewed in the context of the claimed invention, the function recited is sufficiently clear, and definitely described, to suggest to the ordinarily skilled artisan a defined class of structures.”).

The remainder of the claim construction record likewise supports affirmance. Looking first at the intrinsic evidence, the claim itself does not use the classic “means for” template most “closely associated with means-plus-function claiming.” See *Lighting World*, 382 F.3d at 1358. Accordingly, Judge O’Connor noted: “The drafter’s use of the term ‘means’ seems unnecessary” and “perfunctory.” (A20-24 and n.4, 5). Also, the limitation’s functional language (“providing a constant or variable magnitude DC voltage between the DC input terminals”) informs the understanding of skilled artisans. (A23). The specification likewise supports the “rectifier” finding. (A194 (“power line voltage of 120 VAC” and multiple references to “power line”); A195 (“DC input terminals . . . for

receiving thereacross a DC supply voltage of approximately 250 Volts”); A199 (“power line”)).

During patent prosecution, the examiner equated “voltage source means” with a rectifier. The examiner initially rejected the claims in view of U.S. Patent No. 4,710,682 to Zuchriegel (A8132), identifying Zuchriegel’s “POWER RECTIFIER 2” (A10939) to satisfy the voltage source limitation. Bobel never disagreed. (A8145-48). Thus, the prosecution history supports the “rectifier” finding.

Extrinsic materials also support affirmance. ULT’s technical tutorial explains that “the ballast circuit of U.S. Patent No. 5,436,529” is powered by an “ordinary domestic power supply.” (SA124-25). The sequence of rectifying that power supply to provide a DC supply voltage at the DC input terminals is so basic that ULT simply refers to a point in time “when the power is turned on.” (SA127). ULT also cited the IEEE definition of “terminal” (SA138) to argue the DC input terminals must be “conductive element[s] for connection to an external conductor” and must be “able to receive the applied DC input voltage that is used to power the [ballast.]” (A474-75).

Finally, Judge O’Connor relied on applicable case law (A20-21), including *Comtech EF Data Corp., v. Radyne Corp.*, in which the court appointed the late

Robert Harmon, author of *Patents and the Federal Circuit* (BNA 9th ed. 2009), as

Special Master. His report and recommendations stated:

[I]t would be illogical to assume that the drafter of the '646 patent intended "power supply means" to be construed as a [means-plus-function] element. . . . The only rational conclusion is that the drafter was relying on the highly likely proposition that, in the context of the claimed invention, a person of ordinary skill in the art would recognize that "power supply" connotes a well understood class of structures

[T]he "power supply means" element . . . is understood by persons of skill in the . . . art to designate a broad class of structures that supply power appropriate to the claimed system.

Any active electronic circuit will have a power supply appropriate to its needs. Unless it is the power supply itself that is the distinguishing feature (or among the distinguishing features) of the claimed invention, the point is moot. [I] would be astonished if either side were to proffer expert testimony to the effect that . . . the accused systems did not have a power supply.

2007 U.S. Dist. LEXIS 97038, *33-38 (D. Ariz. Oct. 12, 2007); *see also Nilssen v. Motorola, Inc.*, 80 F. Supp. 2d 921, 924 (N.D. Ill. 2000) ("Conventional . . . alternating current ('AC') powers an electronic ballast Current flows to the rectifier, which converts the AC voltage into direct current ('DC') voltage."). Bobel's '529 patent cites various Nilssen patents. (A186).

Judge O'Connor's factual findings and ruling of no indefiniteness were supported by the record and consistent with the parties' views, each of whom

understood and read the claims in an AC power line context. At a minimum, his finding was “plausible,” which is sufficient to survive clear error review under *Anderson*, 470 U.S. at 573-74. See *Parts & Elec. Motors, Inc. v. Sterling Elec., Inc.*, 866 F.2d 228, 233 (7th Cir. 1988) (“To be clearly erroneous, a decision must . . . strike us as wrong with the force of a five-week old, unrefrigerated dead fish.”).

De novo review yields the same result. This Court should not consider any part of the record that post-dates the December 2, 2010, order from which ULT appeals. Nevertheless, even if this Court considers the entire record below, that record supports affirmance. For example, the inventor’s engineering notebook (Exhibit 1 at trial (SA172-73)), includes schematic drawings of Bobel’s novel circuit design, each of which shows a full-wave bridge rectifier. (A11602-07). The power line rectifier was so obvious Bobel did not bother to include it in the final version of the patent’s figures. Compare Notebook (A11602-07) with Patent Figures (A187-90). Bobel even testified at trial that a “rectifier [has been] part of every ballast since the beginning of time.” (A12324-25). Similarly, the prior art of record or discussed by experts discloses a rectifier as the voltage source. (A10939 (Zuchriegel); A1442-43; A13201-03 (JP ‘997); A13186-88 (JP ‘799); SA151-152, A13010-11, SA178-82 (Kroning)).

ULT relies heavily on Dr. Roberts’ 2011 deposition. (ULT Br. 43, 53-56) (characterizing 2011 testimony as part of “[t]he record . . . of the district court’s

[2010] ruling”). ULT conducted an improper cross-examination and avoided asking whether the claim language, when read in context, connotes non-rectifier structures to persons skilled in the art. Instead, ULT had Dr. Roberts assume the conclusion that the “voltage source” limitation reads on batteries, solar cells, etc. The questions assumed as fact ULT’s intended and desired answers, *e.g.*, “Q. And if ballast [sic] of figure 1 were used with a solar cell, what would you understand the voltage source means to be? A. The solar cell. . . .” (A1622). ULT’s questions were so absurd they prompted Dr. Roberts to acknowledge that a ballast could hypothetically be powered by “a potato [because] it generates DC.” (A1623). Lighting Ballast objected (SA156-58). ULT elected not to offer that testimony at trial.¹⁶

Dr. Roberts answered ULT’s improper and out-of-context hypotheticals. But he *never* testified that one skilled in the art, reading the claims in the context of the patent, would understand the voltage source limitation to connote all sorts of non-rectifiers (such as potatoes). In any event, Dr. Roberts explained that DC power sources are not mutually exclusive of rectifiers: “the full wave bridge [rectifier] . . .

¹⁶ In similar fashion, ULT mischaracterizes Lighting Ballast’s position on appeal. (*See* ULT Br. 54-55, citing to Lighting Ballast’s Red Brief at 39 and suggesting the text “a battery or the like” undercuts the district court’s “rectifier” finding). But page 40 of the same brief explains that Judge O’Connor properly excluded non-rectifier structures as being outside the AC power line context taught by the patent.

can be there [*i.e.*, included within the ballast circuitry] and it [*i.e.*, the ballast] can be used for either AC or DC.” (A1621-22).

2. The Trial Court’s Factual Findings Support a Finding of No Indefiniteness Under Step Two of §112 ¶6¹⁷

Even if this Court determines the voltage source limitation is subject to §112 ¶6, the claims are not indefinite because a rectifier is implicit in the patent specification (A186-200), which includes a specific reference to “a power line voltage of 120 VAC” (A194, Col.1, 1.65), numerous subsequent references to that power line (A194, Col.2, 1.44; A199, Col.11, 1.26), and multiple references to DC input terminals (A195, Col.3, 1.4-7; A197, Col.7, 1.48-49). Thus, as Dr. Roberts described (SA30), the specification implicitly, but clearly, discloses corresponding structure – a rectifier – to perform the function of converting AC “from a power line source” (A194, Col.1, 1.64 - Col.2, 1.6) to DC for use as “a DC supply voltage.” (A195, Col.3, 1.4-7; A197, Col.7, 1.48-49).

In this case, Lighting Ballast identified the structure of an AC power line and DC input terminals. Mr. Bobel (SA104-11) and Dr. Roberts (SA29-30) were called upon to flesh out those explicit structural references. They stated unequivocally that a rectifier is the *only* structure used in an electronic lighting

¹⁷ In his amended *Markman* order, Judge O’Connor never reached step two because his proper step one analysis concluded that §112 ¶6 did not apply. Lighting Ballast previously briefed both steps of the analysis in its motion for reconsideration. (SA73-82, SA95-99).

ballast to provide a DC supply voltage from an AC power source. ULT failed to present *any* expert testimony (let alone clear and convincing evidence) to the contrary. (SA159). Thus, the invention's requirement of a rectifier is implicit but clear from the specification's multiple references to "a power line source" and "a DC supply voltage." *Creo Prods.*, 305 F.3d at 1347 (relying on un rebutted expert testimony to find "structure to be implicit").

Neither the law nor skilled artisans require the explicit disclosure of something so basic and well understood. *See S3 Inc. v. nVidia Corp.*, 259 F.3d 1364, 1371 (Fed. Cir. 2001) ("an accommodation to the 'common experience' of lay persons . . . is an unnecessary burden for inventors and has long been rejected as a requirement of patent disclosures"). ULT itself acknowledged that power flowing from an AC power line must be "rectified" (*i.e.* by a rectifier) to convert it to DC. (A480). (*See also* SA81 (defining "rectification" as "The term used to designate the process by which electric energy is transferred from an alternating-current circuit to a direct-current circuit.")).

Finally, the rectifier is clearly linked to the claimed function. During patent prosecution, the examiner equated "voltage source means" with a "rectifier" (A8132) by pointing to Zuchtriegel's "POWER RECTIFIER 2." (A10939). Dr. Roberts' unchallenged testimony also explained how the specification "clearly links" the rectifier to the claimed function. (SA30).

ULT conflates these two analytical steps, citing indiscriminately to *Biomedino, LLC v. Waters Techs. Corp.*, 490 F.3d 946 (Fed. Cir. 2007). (ULT Br. 42, 49) (citing *Biomedino*'s step two analysis to support ULT's step one arguments). At step one, this Court rejected *Biomedino*'s bare "assertion that use of the term 'control'" was sufficient to avoid means-treatment. *Id.* at 949-50. At step two, *Biomedino* pointed to a "box labeled 'Control'" and to vague expert testimony that did not identify a specific structure or class of structures. This Court held: "[A] bare statement [from an expert] that known techniques or methods can be used does not disclose structure." *Id.* at 950-53. Here, a rectifier is not simply one of "many known" structures for providing a DC supply voltage from an AC power line – it is the *only* structure capable of doing so in a lighting ballast. (SA81). The patent's teachings create no ambiguity, and the claims are certainly not "insolubly ambiguous" so as to be indefinite.

VI. CONCLUSION

Cybor should be overruled. Its erroneous review standard has caused this Court to find appellate jurisdiction (and no waiver) in a manner that conflicts with *Ortiz v. Jordan* and numerous circuit courts. Regardless of waivers or review standards, the district court's findings were correct, and the judgment should be affirmed.

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CERTIFICATE OF SERVICE

I hereby certify that on June 24, 2013, I caused the foregoing Rehearing En Banc Response Brief of Plaintiff-Appellee, to be electronically filed through the CM/ECF system, which will send a notice of electronic filing to counsel for all parties to the action who are registered in the CM/ECF system. On June 24, 2013 two copies of the Response Brief have also been served via personal delivery to the following party:

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CERTIFICATE OF COMPLIANCE WITH FRAP 32(A)(7)(B)

The undersigned hereby certifies that this brief complies with the type-volume limitation of Federal Rules of Appellate Procedure 32(a)(7)(B).

1. The brief contains 13,997 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

2. The brief has been prepared in a proportionally spaced typeface using Microsoft Word in 14 point Times New Roman font.

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General Information

Court	U.S. Court of Appeals for the Federal Circuit; U.S. Court of Appeals for the Federal Circuit
Federal Nature of Suit	Property Rights - Patent[830]
Docket Number	12-01014
Status	CLOSED