

2012-1014, 1015

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

LIGHTING BALLAST CONTROL LLC,

Plaintiff-Appellant,

v.

PHILIPS ELECTRONICS NORTH AMERICA CORPORATION,

Defendant.

UNIVERSAL LIGHTING TECHNOLOGIES, INC.,

Defendant-Appellant.

APPEALS FROM THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF TEXAS IN CASE NO. 09-CV-0029
DISTRICT JUDGE REED C. O'CONNOR

RESPONSE TO PETITION FOR REHEARING EN BANC

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CERTIFICATE OF INTEREST

Pursuant to Federal Circuit Rule 47.4, counsel of record for the Defendant-Appellant Universal Lighting Technologies, Inc. ("ULT" or "Universal") certifies the following:

1) The full name of the party represented by counsel of record for Appellant is Universal Lighting Technologies, Inc.

2) The name of the real party in interest is Universal Lighting Technologies, Inc.

3) Universal Lighting Technologies, Inc. is a wholly owned subsidiary of ULT Holdings, Inc. ULT Holdings, Inc. is a wholly owned subsidiary of Panasonic Electric Works Co., Ltd. Panasonic Electric Works Co., Ltd. is a wholly owned subsidiary of Panasonic Corporation. There is no parent corporation or publicly held corporation that owns 10% or more of the interest of Panasonic Corporation.


4) The names of all law firms and the partners and associates that have appeared for Universal Lighting Technologies, Inc. ("ULT") in the proceeding before the United States district court for the Northern District of Texas or who are expected to appear for the party in this Court are:

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INTRODUCTION

“A petition for rehearing en banc is rarely appropriate if the appeal was the subject of a nonprecedential opinion by the panel of judges that heard it.” Fed. Cir. R. 35, Practice Note. The Petition now before the Court presents no exception to that rule. The panel’s nonprecedential opinion, authored by Judge Reyna and joined by Chief Judge Rader and Judge O’Malley, unanimously held that the “voltage source means” term in the asserted claims is a means-plus-function limitation governed by 35 U.S.C. Section 112 ¶ 6. *See* Panel Op. at 7-11. As the panel correctly pointed out, the contrary argument advanced by Petitioner Lighting Ballast Control LLC (“LBC”) relied on case law that was inapposite “because the claim limitations at issue did not include the word ‘means.’” *Id.* at 10. There is nothing remarkable about the panel’s holding or legal reasoning, nor does any aspect of the panel decision require the Court’s further consideration.

LBC further is wrong in suggesting that this appeal is an appropriate vehicle for the Court to reconsider its holding in *Cybor Corp. v. FAS Technologies, Inc.* 138 F. 3d 1448 (Fed. Cir. 1998) (en banc).

First, the panel did *not* reject or override any district court findings of fact. Indeed, like the district court, the panel *accepted* “LBC’s uncontroverted evidence” (quoting Appellee Br. at 39) that one skilled in the art would understand that the claimed “voltage source means” could be satisfied by *either* a rectifier *or* another

class of DC source (e.g., “a battery or the like”). *See* Panel Op. at 5, 10. The panel reversed the judgment below because the district court misapplied this Court’s well-settled precedents on how to construe means-plus-function limitations, not because the panel adopted a different view of any disputed evidence or facts.

Second, this case does not present the type of scenario that has led some to question *Cybor*. The only extrinsic evidence before the district court during claim construction was a declaration from LBC’s litigation expert, Dr. Roberts, and a deposition excerpt of the inventor, Mr. Bobel. Appellant Universal Lighting Technologies, Inc. (“ULT”) relied on intrinsic evidence for its claim construction/indefiniteness position, and explained that the extrinsic statements of Dr. Roberts and Mr. Bobel, if considered, actually supported that position. Based solely on a paper record – *no Markman hearing of any kind was ever held below* – the district judge initially ruled on August 19, 2010 that Section 112 ¶ 6 governed and that the “voltage source means” limitation was indefinite under 112 ¶ 2. A806-815. On December 2, 2010, without receiving any new evidence, the district court reversed itself and ruled that Section 112 ¶ 6 did not apply. A17-24. On appeal, the panel had the same opportunity as the district court to review the full record, and it reached the same conclusion the district court reached in its initial August 2010 ruling. On this record, there is no meaningful basis for deferring to district court fact-finding or to either of the court below’s shifting constructions.

Finally, LBC devotes much of its Petition to the district court's summary judgment ruling and purported failure to "credit Universal's litigation techniques" in deposing LBC's litigation expert. Pet. at 7-11. All of that, however, occurred months *after* the district court issued its final *Markman* ruling. LBC apparently seeks to imply – *inaccurately* – that the district court had some unique insight into the parties' positions or evidence. In ruling on summary judgment, however, the district court expressly "decline[d] ULT's invitation to address the ["voltage source means"] issue a third time;" it neither credited nor discredited anything relating to the "voltage source means" issue. A62.

THE '529 PATENT

This appeal involves a single asserted independent claim (claim 1) of U.S. Patent No. 5,436,529 (the '529 patent), which includes three "means" limitations:

1. An energy conversion device employing an oscillating resonant converter producing oscillations, having DC input terminals producing a control signal and adapted to power at least one gas discharge lamp having heatable filaments, the device comprising:

voltage source means providing a constant or variable magnitude DC voltage between the DC input terminals;

output terminals connected to the filaments of the gas discharge lamp;

control means capable of receiving control signals from the DC input terminals and from the resonant converter, and operable to effectively initiate the oscillations, and to effectively stop the oscillations of the converter; and

direct current blocking means coupled to the output terminals and operable to stop flow of the control signal from the DC input

terminals, whenever at least one gas discharge lamp is removed from the output terminals or is defective.

It is undisputed that the “control means” and “direct current blocking means” limitations are governed by 35 U.S.C. § 112 ¶ 6. LBC nonetheless insists that the “voltage source means” limitation is *not* a means-plus-function term.

THE PRIOR PROCEEDINGS

Because the Petition mischaracterizes the record, we briefly summarize the procedural history relevant to the issues before the Court.

A. The District Court Initially Ruled that “Voltage Source Means” is a Means-Plus-Function Limitation Based on Uncontested Evidence

The district court’s initial August 2010 claim construction ruling addressed only one claim term, the “voltage source means” limitation. The only extrinsic evidence before the court was: (a) a declaration from LBC’s litigation expert, Dr. Roberts, and (b) excerpts from a deposition of the ‘529 inventor, Mr. Bobel. A807-808, 812-813. The district court did not hold a hearing or tutorial, did not receive live testimony, and did not even entertain oral argument from counsel, despite requests from both parties for a *Markman* hearing. Indeed, the first time the district court had any live interaction with counsel, parties, or witnesses in this action was in May 2011, at a pretrial conference held shortly before trial.

The district court initially ruled in August 2010 that “voltage source means” is a means-plus-function term and that the specification of the ‘529 patent fails to

disclose corresponding structure, as required by Section 112 ¶¶ 2 & 6. A814. The district court acknowledged the uncontested extrinsic evidence proffered by LBC that a rectifier can and often does perform the recited function of the limitation, when an AC power source is used. A807-808, 812-813. But the court agreed with ULT that such extrinsic evidence was insufficient to overcome the presumption of means-plus-function claiming that arises from use of the word “means”:

First, Lighting Ballast does not point the Court to any evidence, intrinsic or extrinsic, that the term “voltage source” is commonly used in the electronic ballast industry to mean a rectifier. Rather, Plaintiff relies on the description of the function, stating that persons of skill in the electronic ballast industry, including Bobel and Dr. Roberts, understand that this function, insofar as it includes supplying a DC voltage, can be and often is performed by a rectifier. Secondly, Lighting Ballast admits that a rectifier is not the only structure capable of providing a DC voltage, pointing out that a battery would also suffice. There is no indication that “voltage source” is often used synonymously with the term “rectifier” by those of ordinary skill in the electronic ballast industry, and Lighting Ballast does not appear to argue as much. In fact, the opposite would seem to be the case, since a rectifier is merely one voltage source. [A807-808.]

B. The District Court Later Reversed its Claim Construction, Reaching the Opposite Legal Conclusion on the Same Uncontested Evidence

LBC presented no new evidence in support of its motion for reconsideration.

A824. And the district court again held no hearing and no oral argument. A16-18.

Yet in December 2010, the district court granted LBC’s motion and reversed its indefiniteness ruling based on the same record relied on in reaching its opposite

ruling four months earlier. A20-24. While acknowledging that the “voltage source

means term does not denote a specific structure,” the court nonetheless concluded that one skilled in the art “would understand a rectifier is, at least in common uses, the only structure” to perform the recited function. A23.¹

Although the factual record did not change between August and December 2010, the district court’s legal reasoning did. While the August 2010 ruling relied squarely on *Biomedino, LLC v. Waters Tech Corp.*, 490 F.3d 946 (Fed. Cir. 2007) and other precedents of this Court, A809-815, the December 2010 ruling relied heavily on a “rationale” from a special master’s report in another district court action that was emphasized in LBC’s reconsideration motion. A20-22 (citing *Comtech EF Data Corp. v. Radyne Corp.*, 2007 U.S. Dist. LEXIS 97038 (D. Ariz.), *aff’d in relevant part*, 2008 U.S. Dist. LEXIS 26966 (D. Ariz. Mar. 31, 2008). That new legal rationale led the district court to reverse its August 2010 claim construction and to exempt the “voltage source means” term from 112 ¶ 6.

C. The District Court Declined to “Address the Same Issue a Third Time” In Denying Summary Judgment

ULT later renewed its indefiniteness argument in a motion for summary judgment. ULT relied on the same record that was before the district court in

¹ In ruling that a rectifier may be a “voltage source means” in “common applications,” the district court relied on the same statements from Dr. Roberts cited in its contrary August 2010 ruling. A21-22. But, as the Roberts declaration itself made clear, a rectifier is *not* the only structure that could perform the recited function of the limitation. *Id.* (“[a] battery could likewise provide the necessary DC supply voltage described in the patent”) (quoting Roberts decl. at 7-8).

August and December 2010 plus a deposition of LBC's expert, Dr. Roberts taken after the court's *Markman* rulings. At deposition, Dr. Roberts elaborated on his earlier declaration that the "voltage source means" of claim 1 could be either a rectifier or one of a number of other classes of DC sources. A1618-1624. The district court, however, refused to consider the issue "a third time." Panel Op. at 5. In denying summary judgment, the district court did not address the substance of ULT's arguments and made no new findings. A62.

D. The Panel Accepted the Same Uncontested Evidence Relied on by the District Court but Reversed on Legal Grounds

ULT appealed the district court's construction of "voltage source means" as well as four other claim construction errors. In responding on the "voltage source means" issue, LBC told the panel that:

LBC's uncontroverted evidence showed that only two subtypes of devices can be a "voltage source" in that precise functional context: either a rectifier in the case of the vast majority of application, which rely on an AC power source; or a battery or the like (such as a DC generator or solar cell) in the unusual case of a direct supply of DC power (A820, A2906).

Appellee Brief at 39. LBC thereby confirmed that the "uncontroverted evidence" establishes that a rectifier is not the only class of structures that may correspond to the "voltage source means" of the '529 patent. *Id.*

While accepting LBC's "uncontroverted evidence," *see* Panel Op. at 9-10, the panel concluded that LBC had not overcome the presumption of means-plus-

function claiming under this Court's precedents. *Id.* at 10-11. The panel held that, under this Court's precedents, "the claim does not contain structural language that is sufficient to remove 'voltage source means' from the reach of §112, ¶ 6." Panel Op. at 9. Furthermore, because the specification did not link any corresponding structure to the "voltage source means," the panel ruled that the asserted claims are invalid as indefinite under §112, ¶ 2. Panel Op. at 11-13.

ARGUMENT

A. The Panel Opinion Does Not Implicate *Cybor* Because It Does Not Resolve Disputed Evidence or Facts Differently than the District Court

The Petition does not identify any disputed evidence or facts that the panel resolved contrary to a district court finding. Indeed, as LBC acknowledges, the panel, in construing "voltage source means," recited the district court's "express factual finding" without disagreement:

The 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.*

Pet. at 8 (quoting Panel Op. 5 (emphasis added)). No one – not LBC, ULT, the district court, or the panel – disputed that the "voltage source means" of the '529 patent could be *either* a rectifier *or* one of a number of structures that supplies DC, such as a battery. *See* Appellee Br. at 39. The Petition is wrong in suggesting that the district court resolved a disputed factual question on this point. Pet. at 7.

The dispositive issue in this case was whether the “uncontroverted evidence”—credited equally by the panel and district court—was sufficient to overcome the presumption that “voltage source means” is a means-plus-function term governed by 35 U.S.C. § 112 ¶ 6. That dispositive issue is a legal question governed by principles this Court has reiterated many times, including in the past year.² The panel applied this Court’s means-plus-function precedents to the uncontested facts of the case to reach a unanimous decision.

Petitioner’s own briefing shows that the panel reversed the district court because it failed to properly apply this Court’s precedents in at least two respects:

First, LBC argued to the panel that the district court had correctly applied “key authorities” of this Court, including *MIT v. Abacus Software*, 462 F.3d 1344 (Fed. Cir. 2006), to avoid Section 112 ¶ 6. Appellee Br. at 39. But, as the panel explained, LBC and the district court *misapplied* those cases. Panel Op. at 10-11 (“In those cases, however, we started from the presumption that means-plus-function claiming did not apply because the claim limitations at issue did not include the word ‘means’”). Thus, the panel and the district court reached different conclusions because the district court failed to adhere to this Court’s requirement that “[t]he use of the term ‘means’” is “central to the analysis, as the terms ‘means’

² See, e.g., *EPLUS, Inc. v. Lawson Software, Inc.*, No. 2011-1396, -1456, -1554, (Nov. 21, 2012); *Noah Systems, Inc. v. Intuit, Inc.*, 675 F.3d 1302 (2012); *Ergo Licensing, LLC v. Carefusion, Inc.*, 673 F.3d 1361 (2012) (and cases cited).

and ‘means for’ have become closely associated with means-plus-function claiming.” *Inventio AG v. ThyssenKrupp Elevator Americas Corp.*, 649 F.3d 1350, 1356 (Fed. Cir. 2011) (cited in the Panel Opinion at 8).

Second, LBC advances the same erroneous legal argument relied on by the district court that, because the circuit of claim 1 could in *some* applications use a rectifier as a voltage source, “voltage source means” was sufficiently structural to avoid means-plus-function treatment. Pet. at 6-7 (citing *Rembrandt Data Techs., LP v. AOL*, 641 F.3d 1331, 1340–41 (Fed. Cir. 2001)); *see also* A22-23. That argument misapplies *Rembrandt* because, as the panel opinion explained, the expert testimony in *Rembrandt* showed that the terms in question “were commonly used in publications to identify *defined* algorithms (i.e., structure) known in the art.” Panel Op. at 9 (emphasis in original). In contrast, Petitioner presented no evidence that the phrase “voltage source” has ever been used in publications, or anywhere else, to identify a rectifier or any other “defined structure.” *Id.* As the district court found in its August 2010 claim construction ruling:

Lighting Ballast does not point the Court to any evidence, intrinsic or extrinsic, that the term ‘voltage source’ is commonly used in the electronic ballast industry to mean a rectifier ... There is no indication that ‘voltage source’ is often used synonymously with the term ‘rectifier’ by those of ordinary skill in the electronic ballast industry, and Lighting Ballast does not appear to argue as much. [A807-808.]

The district court did not reverse or alter these factual findings. Instead, on reconsideration, it reached an opposite *legal* conclusion on the same record.

This case presents a textbook example of why this Court's precedents do not allow a patent holder to rebut the presumption that a "means" term is governed by 35 U.S.C. § 112 ¶ 6 simply by arguing that persons of ordinary skill in the art could ascertain some structure to perform the recited function. LBC's proffered evidence – that the "voltage source means" could be a rectifier in many applications but also could be other types of structure in other applications – fails to identify specific corresponding structure as required to avoid § 112 ¶ 6. The position advocated by LBC would allow it to assert that any structure capable of performing the recited function of the "voltage source means" limitation qualifies as the claimed "means," thereby amounting to prohibited functional claiming. *See Biomedino*, 490 F.3d at 952 (quoting *Med. Instrumentation*, 344 F.3d at 1211). The panel rightly rejected a construction that would have allowed LBC to have its cake and eat it too as inconsistent with this Court's precedents.³

B. This Case is Not an Appropriate Vehicle for Reconsidering *Cybor* for Additional Reasons

The Petition asserts that this Court has relied on *Cybor* over 750 times without ever taking a case en banc to reconsider its holding. Pet. at 13. Parties have specifically asked to reconsider *Cybor* en banc multiple times, and the Court

³ The panel honed in on this point at oral argument, observing that claim 1 could be read on ballasts connected to a DC power source, such as a DC generator as used in many hospitals, without a rectifier, if LBC decided to accuse such ballasts of infringement in a future case. Tellingly, LBC's counsel did not dispute that observation or disclaim that the '529 patent could be asserted in that context.

has rejected each such petition. *See, e.g., Amgen Inc. v. Hoechst Marion Rousell, Inc.*, 469 F. 3d 1039 (Fed. Cir. 2006); *Retractable Techs. Inc. v. Becton, Dickinson and Co.*, 659 F.3d 1369 (Fed. Cir. 2011); *St. Clair Intellectual Property Consultants, Inc. v. Canon Inc., et al.*, No. 2009-1052, 2010-1137, -1140 (Fed. Cir. Jan. 10, 2011). Each of those cases would have been a far more appropriate vehicle for revisiting *Cybor*, if the Court were inclined to do so since none were unanimous, nonprecedential decisions with uncontested record facts.

Further, the reasons that have been proffered in the past for reconsidering *Cybor* do not apply in this case. As Chief Judge Rader noted in his dissent in *Cybor*, enhanced deference to district court findings may be appropriate in some contexts:

Trial judges can spend hundreds of hours reading and rereading all kinds of source material, receiving tutorials on technology from leading scientists, formally questioning technical experts and testing their understanding against that of various experts, examining on site the operation of the principles of the claimed invention, and deliberating over the meaning of the claim language. If district judges are not satisfied with the proofs proffered by the parties, they are not bound to a prepared record but may compel additional presentations or even employ their own court-appointed expert.

Cybor, 138 F. 3d at 1477.

In this case, by contrast, the district court did not hold a hearing, receive a technology tutorial, or even entertain oral argument before issuing its claim construction rulings. Based solely on the limited paper record, the district court

reached two different *legal* conclusions on claim construction and indefiniteness. The panel considered the same paper record and issued a decision consistent with the district court's initial (and correct) legal conclusion.⁴ The procedural history underscores that this case is not an appropriate vehicle for revisiting *Cybor*; this is not a case where the district court weighed competing evidence and made factual findings that underlie its legal conclusion on claim construction.⁵

Even if the full Court were to revisit this appeal, the construction of the “voltage source means” was only one of five erroneous district court rulings that ULT appealed. The panel understandably did not address ULT's other four

⁴ The Petition attempts to suggest some relevant district court fact-finding centered on the deposition testimony of LBC's litigation expert, Dr. Roberts. See Petition at 9-11. There is no substance to that suggestion. *First*, as explained above, Dr. Robert's deposition was not taken until 2011, *after* the district court issued its final construction of “voltage source means” in December 2010. The district court declined to consider Dr. Robert's deposition in ruling on ULT's summary judgment motion. *Second*, what Dr. Roberts said at deposition merely confirmed his earlier declaration: the “voltage source means” of claim 1 could be any number of different types of structure:

[C]laim 1 simply talks about DC input terminals. It doesn't care where the DC comes from, and in reality it doesn't matter. That was the part of my claim construction argument. It's totally irrelevant where the DC comes from for the operation of the ballast. [A1629.]

⁵ Similarly, in *Retractable Technologies*, cited by Petitioner, Pet. at 3, the Solicitor General supported *denying* a petition for writ of certiorari “because the district court's claim-construction ruling did not depend on the resolution of any questions of fact, [and] the case [did] not present the question whether a claim-construction ruling that is predicated on factual determinations should nevertheless be subject entirely to de novo appellate review.” Brief for the United States as Amicus Curiae at 22, 659 F.3d 1369 (Fed. Cir. 2011).

arguments, each of which presented solid grounds to reverse the judgment below. Those additional district court errors, which are fully explained in ULT's Appellant Brief, further complicate this appeal and provide additional reasons why this case is not a good vehicle for reconsidering the holding of *Cybor*.⁶

C. The Panel Conclusively Found ULT Preserved Its Claim Construction and Indefiniteness Arguments

The waiver issues discussed in the Petition also do not warrant this Court's further consideration. As an initial matter, LBC's waiver argument is conditioned on the Court accepting LBC's argument that *Cybor* should be reconsidered and reversed. For the reasons discussed above, the necessary condition precedent to LBC's waiver argument does not exist.

Moreover, the panel correctly found that "ULT preserved its claim construction and indefiniteness argument with respect to the 'voltage source means' and that the issue is properly raised on appeal." Panel Op. at 7. LBC's scattershot waiver theories miss the point. For example, LBC does not even try to refute (because it cannot) the panel's reliance on longstanding Fifth Circuit law holding that "once a final judgment is entered, all earlier non-final orders affecting

⁶ Among the multiple rulings ULT challenged on appeal was a claim construction first announced by the district court *after* trial and verdict in denying ULT's JMOL motion. See ULT Brief at 14-22, 37-51 (appealing post-verdict construction of "connected to" as not requiring any connection to the output terminals of the ballast, even though the claim language, specification, and prosecution history specifically contradicted the district court's construction).

that judgment may properly be appealed.” Panel Op. at 6 (quoting *Exxon Corp. v. St. Paul Fire & Marine Ins. Co.*, 129 F.3d 781, 784 (5th Cir. 1997)). Even if the Court overruled its holding in *Cybor*, claim construction (and indefiniteness) would remain exclusively the province of the court, *not* the jury. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372, 116 S.Ct. 1384, 1387 (1996). Accordingly, regardless of the standard of review, ULT’s challenge to the district court’s “voltage source means” construction merged into the final judgment and was appealable; no JMOL motion was required.

CONCLUSION

For the foregoing reasons, the Petition presents no basis for revisiting the standard of review set forth in *Cybor* or any other issue, and should be denied.

Respectfully submitted,



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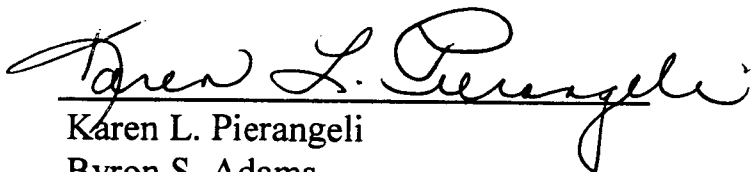
CERTIFICATE OF SERVICE

I hereby certify that on this 19th day of February, 2013, two (2) copies of the foregoing RESPONSE TO PETITION FOR REHEARING EN BANC were served by sending same via Federal Express, Priority Overnight Service on the following counsel:

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General Information

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