

No. _____

In the
Supreme Court of the United States

LIGHTING BALLAST CONTROL LLC,

Petitioner,

v.

UNIVERSAL LIGHTING TECHNOLOGIES, INC.,

Respondent.

**On Petition for Writ of Certiorari to the
United States Court of Appeals for
the Federal Circuit**

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

In *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc), the Federal Circuit construed this Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), to hold that patent claim construction presents a purely legal question subject to *de novo* review. In this case, the Federal Circuit granted en banc review to reconsider the widely criticized *Cybor* rule. In a 6-4 decision, it decided to adhere to its precedent on *stare decisis* grounds, which hold no sway in this Court. Shortly after the decision, this Court granted the petition for certiorari in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, No. 13-854 (Mar. 31, 2014), to consider the validity of the *Cybor* rule.

This petition presents the same question presented in *Teva*. It also presents a second question that will be squarely implicated if the Court, in *Teva*, affirms the *Cybor* rule. That question arises from Respondent's failure to raise the claim construction arguments on which it ultimately prevailed below (which are purely legal issues per *Cybor*) in a motion for judgment as a matter of law after they were previously rejected on summary judgment. The courts of appeals are starkly divided as to whether there is an exception for "purely legal" issues to the general rule that issues raised in a failed summary judgment motion and not renewed in a motion for JMOL are forfeited, a question this Court expressly left open in *Ortiz v. Jordan*, 131 S. Ct. 884 (2011).

The questions presented are:

1. Whether a district court's factual finding in support of its construction of a patent claim term may

be reviewed *de novo*, as the Federal Circuit requires, or only for clear error, as Federal Rule of Civil Procedure 52(a) requires.

2. Whether there is an exception for “purely legal” issues to the general rule that an issue raised only in a failed summary judgment motion and not raised in a motion for judgment as a matter of law under Federal Rule of Civil Procedure 50 is forfeited on appeal.

PARTIES TO THE PROCEEDING

Petitioner Lighting Ballast Control LLC was the plaintiff in the district court and appellee in the court of appeals.

Respondent Universal Lighting Technologies, Inc. was the defendant in the district court and appellant in the court of appeals.

The following parties were also original defendants in the district court: General Electric Company, Philips Electronics North America Corp. (originally sued as Advanced Transformer Co.), and Fulham Co., Inc. All of these defendants were dismissed during district court proceedings; they were not parties to the Federal Circuit appeal and are not parties before this Court.

RULE 29.6 STATEMENT

Petitioner Lighting Ballast Control LLC is a wholly owned subsidiary of Acacia Research Group LLC, which is a wholly owned subsidiary of Acacia Research Corporation, a publicly traded corporation. Acacia Research Corporation has no parent company, and no publicly held company owns 10% or more of its stock.

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PETITION FOR WRIT OF CERTIORARI

In *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (en banc), the Federal Circuit construed this Court's decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), to hold that patent claim construction is "a purely legal issue" and that, accordingly, it would "review claim construction *de novo* on appeal including any allegedly fact-based questions relating to claim construction." 138 F.3d at 1451, 1456. From the outset, judges, patent practitioners, and legal scholars roundly criticized the so-called *Cybor* rule as improperly dismissive of the factual components of claim construction, inconsistent with this Court's precedents, and incompatible with the goals of transparency, accuracy, predictability, and efficiency in patent proceedings. Nonetheless, the Federal Circuit has repeatedly opted to adhere to its precedent.

In this case, the Federal Circuit finally granted rehearing en banc to consider whether to overrule *Cybor*. Twenty-one separate amicus briefs were filed; sixteen of them, including a brief by the United States, urged the court to overrule *Cybor*. But the Federal Circuit punted: despite hearing the case in an en banc posture, the Federal Circuit neither embraced its *de novo* standard as the proper rule nor abandoned it in the face of well-reasoned criticism. Instead, in a 6-4 decision, the en banc court upheld *Cybor* on *stare decisis* grounds. Shortly after the decision, however, this Court granted the petition for certiorari in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, No. 13-854

(Mar. 31, 2014), to consider the validity of the *Cybor* rule.

This petition presents the same question presented as the petition in *Teva*; indeed, it is the case that the *Teva* respondents urged the Court to await instead of granting certiorari in that case. Accordingly, the Court should hold this petition pending the outcome of *Teva*. If the Court correctly determines in *Teva* that patent claim construction may involve factual determinations subject to clear-error review under Federal Rule of Civil Procedure 52(a), it should grant this petition, vacate the en banc and panel judgments below, and remand for further consideration. In this case, Respondent obtained a reversal of the district court's claim construction only because the court of appeals employed *de novo* review to re-assess expert and inventor testimony and to draw different conclusions about that testimony from the district court, thereby allowing the court to conclude that Petitioner failed to rebut a critical presumption. Under clear-error review, the district court's eminently plausible findings concerning that testimony would have been entitled to deference, Petitioner would have rebutted the presumption, and the district court's claim construction would have been upheld by the panel.

If, however, the Court affirms the *Cybor* rule holding that claim construction is a "purely legal" issue, it should grant certiorari on a second important question presented here. In the district court, Respondent argued for its preferred claim construction on motion for summary judgment, which the court denied. During and after trial, however,

Respondent failed to raise this issue in a motion for judgment as a matter of law under Federal Rule of Civil Procedure 50. The Federal Circuit nevertheless proceeded to review it on appeal and reversed. There is a clear circuit split over whether a court of appeals may review a “purely legal” challenge rejected on summary judgment but not later raised in a Rule 50 motion: six courts permit review, and two do not. This question, moreover, was expressly left unresolved in *Ortiz v. Jordan*, 131 S. Ct. 884 (2011), although *Ortiz* supports a rule under which the legal basis for the decision below was, in fact, forfeited. And whatever the correct answer to this important and recurring issue of preservation, it should be uniform across the circuits. Thus, should this Court hold in *Teva* that claim construction continues to present only a “purely legal” issue, certiorari is warranted to resolve the entrenched divide on this question.

OPINIONS BELOW

The opinion of the en banc court of appeals (App. 1-91) is reported at 744 F.3d 1272. The order of the court of appeals granting rehearing en banc (App. 92-94) is reported at 500 F. App’x 951. The opinion of the court of appeals panel (App. 95-108) is reported at 498 F. App’x 986. The opinion of the district court denying Respondent’s motion for judgment as a matter of law (App. 109-172) is reported at 814 F. Supp. 2d 665. The opinion of the district court on motion for reconsideration (App. 173-215) is unreported but available at 2010 WL 4946343. The initial opinion of the district court construing the relevant claims and finding them invalid for indefiniteness (App. 216-238) is unreported but available at 2010 WL 3283037.

JURISDICTION

The judgment of the en banc court of appeals was entered on February 21, 2014. On May 12, 2014, the Chief Justice extended the time within which to file a petition for certiorari to and including June 20, 2014. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

STATUTORY PROVISION AND FEDERAL RULES INVOLVED

35 U.S.C. § 112 (2006) and Federal Rules of Civil Procedure 50 and 52 are reproduced at App. 239-245.

STATEMENT OF THE CASE

A. Legal Background

Patent infringement is the unauthorized making, using, or selling of a patented invention. 35 U.S.C. § 271(a). Because a patent grants its owner the right to exclude others from those activities, “a patent must describe the exact scope of an invention and its manufacture to secure to the patentee all to which he is entitled.” *Markman*, 517 U.S. at 373 (brackets and quotation marks omitted). The claims of a patent define “the scope of the invention, and thus the scope of the patentee’s right to exclude others from making, using, or selling the patented invention.” App. 176. *See generally Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2125 (2014).

“Victory in an infringement suit requires a finding that the patent claim ‘covers the alleged infringer’s product or process,’ which in turn necessitates a determination of ‘what the words in the claim mean.’” *Markman*, 517 U.S. at 374. Thus in almost every patent infringement case, the district court’s first

principal task is claim construction, which is “the process of giving proper meanings to the claim language thereby defining the scope of the protection.” App. 176. District courts must give claim language “the meaning that [it] would have to a person of ordinary skill in the art in question at the time of the invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005). In undertaking this inquiry, district courts may look to a number of sources: the patent’s claims, its specification (a written description of the invention preceding the claims), its prosecution history (proceedings before the United States Patent and Trademark Office), and extrinsic evidence, meaning “all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979-81 (Fed. Cir. 1995).

In this case, the parties dispute whether a certain claim limitation in the asserted patent is a “means-plus-function” limitation. Under 35 U.S.C. § 112 ¶ 6 (2006), a patentee “may express a claim limitation by reciting a function to be performed by a generic means,” rather than “reciting in the claim the actual structure for performing the particular function.” App. 179.¹ A “means-plus-function” limitation

¹ Specifically, § 112 ¶ 6 provides: “An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” In 2011, Congress revised § 112 in ways not material here; for example, § 112 ¶ 6 is now

“operates to restrict claim limitations drafted in such functional language to those structures, materials, or acts disclosed in the specification ... that perform the claimed function.” *Id.* (quoting *Personalized Media Commc’ns, LLC v. ITC*, 161 F.3d 696, 703 (Fed. Cir. 1998)).

Whether a claim limitation invokes means-plus-function claiming under § 112 ¶ 6 “is an exercise in claim construction.” *Inventio AG v. ThyssenKrupp Elevator Ams. Corp.*, 649 F.3d 1350, 1356 (Fed. Cir. 2011). If a claim limitation includes the word “means,” then a presumption attaches that § 112 ¶ 6 governs construction of the claim term. *See Apex Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1371-72 (Fed. Cir. 2003). That presumption is rebutted and § 112 ¶ 6 does not apply, however, if the patent connotes, to one of ordinary skill in the art, sufficient structure for performing the described function. *See id.* at 1372; *Inventio*, 649 F.3d at 1357. If § 112 ¶ 6 does apply, construction of a claim then proceeds in two steps: “First, the court must determine the claimed function. Second, the court must identify the corresponding structure in the written description of the patent that performs that function.” App. 180-181 (quoting *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1332 (Fed. Cir. 2006)).

§ 112(f). Those revisions do not apply here because the patent predates their effective date. Citations in this petition are to the pre-2011 law.

B. Factual Background

This case involves Petitioner Lighting Ballast Control LLC's United States Patent No. 5,436,529 (the '529 patent), entitled "Control and Protection Circuit for Electronic Ballast." App. 173. An electronic ballast is a device for starting and regulating fluorescent lamps; it "helps maintain a current level high enough to start the lamp while simultaneously preventing current from reaching destructive levels" while the lamp is in operation. App. 96.

When a lamp is removed from a fixture or a lamp's filament breaks, current provided by the ballast may dissipate back into the ballast circuitry, which can destroy the ballast and create an electric shock hazard. *Id.* The '529 patent discloses an electronic ballast that improves upon prior art by shielding the ballast from destructive levels of current in those situations. App. 97. As relevant here, Claim 1 of the patent recites:

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.

Id. (emphasis added). The specification of the '529 patent repeatedly refers to the ballast's alternating current (AC) "power line source" or "power line voltage." See U.S. Patent No. 5,436,529 col.1 l.65 (filed Apr. 22, 1993) (describing a "power line voltage of 120 VAC [volts AC]"); *id.* col.1 ll.55-65; *id.* col.2 ll.6, 8-9, 44, 46; *id.* col.11 l.26.

C. District Court Proceedings

Petitioner brought suit against Respondent Universal Lighting Technologies, Inc., alleging that Respondent manufactured, used, and sold ballasts infringing the '529 patent. App. 175. Respondent denied infringement and brought a counterclaim alleging patent invalidity. *Id.* The parties disputed the construction and effect of three alleged means-plus-function limitations and four other terms in Claim 1, with Respondent seeking summary judgment that, based on its proposed constructions, all claims of the '529 patent are invalid for indefiniteness. App. 98, 183.

As relevant here, the parties disputed whether the limitation "voltage source means providing a constant or variable magnitude DC voltage between

the DC input terminals” (the “voltage source means” limitation) is a means-plus-function limitation. Petitioner contended that this limitation is not governed by § 112 ¶ 6 because the language connotes sufficient structure to one skilled in the art of lighting ballasts. In support, Petitioner pointed to the testimony of Andrew Bobel, the inventor of the ’529 patent, and Dr. Victor Roberts, its expert witness. App. 193. By contrast, Respondent argued that § 112 ¶ 6 applied, and because the ’529 specification does not disclose any structure corresponding to the claimed function, the claim is invalid as indefinite. App. 193-194. The district court initially held for Respondent, finding that the “voltage source means” limitation is a means-plus-function term governed by § 112 ¶ 6, the specification fails to identify a structure corresponding to the recited function, and, therefore, the asserted claims are indefinite and thus invalid. App. 98, 194, 216-238.

Petitioner moved for reconsideration, which the court granted after concluding that it had “unduly discounted” the expert testimony offered by Bobel and Roberts “regarding the knowledge of one of ordinary skill in the electronic ballast field.” App. 195. Applying settled Federal Circuit law, the district court began with “the presumption that this is a means-plus-function limitation ... because it uses the term ‘means.’” App. 196 It noted that this presumption would “collapse if the claim describes sufficient structure for performing the recited function, despite its use of the term ‘means.’” App. 197. It further observed that the “voltage source means” limitation “need not denote a specific structure,” so long as the term “is used in common parlance or by persons of skill

in the pertinent art to designate structure.” *Id.* (quotation marks omitted).

The court then reviewed Petitioner’s expert testimony. It noted that Dr. Roberts had testified that because “nearly all common applications for residential and commercial uses” of lighting ballasts draw power “from an AC power source”—a power line source that the ’529 patent itself repeatedly references—the “voltage source means” limitation “would connote to anyone skilled in the art, the structure of a rectifier.” App. 199-200. In Dr. Roberts’ opinion, “the only way for a lighting ballast to convert AC ... into DC ... is through a rectifier.” App. 199. Dr. Roberts stated that in “very few applications,” a battery could supply the necessary DC voltage, but “[i]n either case, one skilled in the art would immediately ascertain and implement the structure necessary to supply the DC supply voltage, based on the particular application of the ballast in question.” App. 200. Thus, in Dr. Roberts’ expert view, the “voltage source means” limitation connotes “a sufficient structure, or class of structures.” *Id.*

The district court also noted the testimony of Bobel, the inventor. Bobel testified that he intentionally drafted the claim language to connote “physical structure to those skilled in the art.” *Id.* Bobel further testified that “one skilled in the art of designing lighting ballasts” would view the “voltage source means” limitation as necessarily connoting “a structure that will ‘rectify the line.’” *Id.*

Based on this testimony, the district court expressly found that in the context of the ’529 patent, the “voltage source means” limitation is “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.” App. 201. The court further found, consistent with the patent’s repeated references to a power line source and Dr. Roberts’ testimony that the “vast majority” of ballast applications use an AC power line source, that “one familiar with the use and function of a lighting ballast” would conclude that a rectifier is the “only structure that would provide ‘a constant or variable magnitude DC voltage’” as described in the “voltage source means” limitation. *Id.* The court additionally found that it “is clear to one skilled in the art that to provide a DC voltage when the source is a power line, which provides an AC voltage”—as described in the patent—“a structure to rectify the line is required and is clear from the language” of the limitation. App. 202. Accordingly, the court found that Petitioner had rebutted the means-plus-function presumption. App. 203.

Following the court’s decision, Respondent “again moved for summary judgment,” rearguing that the “voltage source means” limitation constitutes means-plus-function claiming and is indefinite. The district court again denied summary judgment, declining “to address the same issue a third time.” App. 99 (quotation marks omitted).

The case proceeded to trial. At the close of evidence, Respondent moved for judgment as a matter of law on a number of grounds but did not challenge the “voltage source means” claim construction rejected on summary judgment. *Id.* The district court denied

the motion. At the charge conference, Respondent did not object to a jury instruction incorporating the district court's finding that the "voltage source means" limitation constitutes a rectifier. *Id.* The jury returned a verdict finding infringement of the '529 patent, no invalidity, and damages of \$3 million to Petitioner. App. 111. Following the verdict, Respondent again moved for judgment as a matter of law but again did not challenge the "voltage source means" construction. App. 99. The district court denied the motion and entered a final judgment of approximately \$4.5 million, reflecting pre-judgment interest and costs. App. 171-172.

D. Panel Proceedings in the Federal Circuit

A panel of the Federal Circuit reversed. App. 95-108. The panel first held that Respondent had not waived its argument challenging the rejection, on summary judgment, of the district court's construction of the "voltage source means" limitation, despite its failure to raise that issue in its motions for judgment as a matter of law. App. 99-101. The panel acknowledged that Respondent had "twice moved for summary judgment and argued its proposed construction of 'voltage source means'" yet failed to raise that issue in its later Rule 50 motions. App. 99-100. Nevertheless, applying Fifth Circuit law, *see Summit Tech., Inc. v. Nidek Co.*, 363 F.3d 1219, 1223 (Fed. Cir. 2004) (holding that regional circuit law applies to procedural issues not unique to patent law), the panel held that because the claim construction ruling "concerned only questions of law," Respondent

was not later required to challenge it in order to preserve the issue. App. 100-101.

The panel then held, contrary to the district court, that the “voltage source means” limitation in the ’529 patent is a means-plus-function limitation. At the outset, citing *Cybor*, the panel observed that “[w]hether a claim limitation invokes means-plus-function claiming ... is a matter of claim construction and therefore a question of law that we review without deference.” App. 102. The panel then concluded *de novo* that Petitioner had “failed to present sufficient evidence to overcome” the presumption triggered by use of the word “means” in the disputed claim. App. 102-106.²

In so holding, the panel set aside the district court’s findings based on Petitioner’s expert and inventor testimony regarding how a person skilled in the lighting ballast art would understand the claim language. While the district court had expressly found, based on Dr. Roberts’ and Bobel’s testimony, that in the context of the ’529 patent, a person of skill in the art would understand the “voltage source means” limitation to connote a rectifier, the panel reviewed the evidentiary record, including Dr. Roberts’ own testimony, anew to conclude otherwise:

[Petitioner’s] record testimony suggests a lack of a defined class of structures. While a rectifier and a battery may be examples of structures that commonly perform the recited

² In an apparent scrivener’s error, the decision misstates that Respondent (rather than Petitioner) failed to rebut the presumption. *See* App. 106.

function, there are many other ways to provide DC voltage, including “generators” and “solar voltaic cells,” as [Petitioner’s] expert admitted.

App. 104-105.

Having found that “voltage source means” invoked means-plus-function claiming, the panel then held that the patent failed to disclose corresponding structure to support the claimed function, as required under § 112 ¶ 6. App. 106-108. Consequently, it held the asserted claims invalid for indefiniteness. App. 108.

E. En Banc Proceedings in the Federal Circuit

Petitioner sought rehearing en banc, asserting that “on deferential appellate review the district court would not or should not have been reversed.” App. 3. The Federal Circuit granted rehearing and requested briefing on the following issues: (1) whether the Federal Circuit should overrule *Cybor*; (2) whether the Federal Circuit should afford deference to any aspect of a district court’s claim construction; and (3) if so, which aspects should be afforded deference. App. 92-94. Twenty-one *amici curiae* briefs were filed; sixteen of them, including a brief by the United States, urged the court to overrule *Cybor*.

In a 6-4 decision, the en banc Federal Circuit reaffirmed *Cybor* and reinstated the panel decision. App. 1-91.³ The court “appl[ied] the principles of *stare decisis*” and concluded that “the criteria for departure

³ Two recently appointed judges did not participate. App. 1.

from *stare decisis* are not met.” App. 3. In the majority’s view, no “post-*Cybor* developments ... have undermined the reasoning of *Cybor*.” App. 18. No party had “shown that *de novo* review of claim construction is unworkable” or that such review “increased the burdens on the courts or litigants conducting claim construction.” *Id.* And “[n]o consensus has emerged as to how to adjust *Cybor* to resolve its perceived flaws.” *Id.* “The principles of *stare decisis*,” the majority observed, “counsel against overturning precedent when there is no evidence of unworkability and no clearly better resolution.” App. 19. In short, the majority stated, it had “been offered no argument or public policy, or changed circumstances, or unworkability or intolerability, or any other justification for changing the *Cybor* methodology and abandoning *de novo* review of claim construction.” App. 24.

Judge Lourie concurred to provide “additional reasons why retaining *Cybor* is wise.” App. 37 (Lourie, J., concurring). In his view, *de novo* review was not inconsistent with this Court’s *Markman* decision, and deferential review of claim construction would hamper the Federal Circuit’s “ability to interpret claims with full authority and hence to ensure uniformity.” App. 38.

Judge O’Malley, joined by Judges Rader, Reyna, and Wallach, dissented. App. 45-91.⁴ Judge O’Malley gave a number of reasons why the majority was wrong to adhere to *Cybor* as a matter of *stare decisis*. First,

⁴ Judges Rader, O’Malley, and Reyna comprised the panel in this case.

it “misapprehends the Supreme Court’s decision in *Markman*, ignoring numerous instances where the Court acknowledged that claim construction can present factual questions.” App. 59.

Second, *Cybor* “ignores the realities of the claim construction process,” in which “claims are to be interpreted from the perspective of one of skill in the art at the time of the invention.” App. 64. Judge O’Malley used this case as an example, explaining that it involves “disputed factual questions” and turns on a “fact-intensive dispute[]” over “whether ‘voltage source means’ denoted a particular structure to those of skill in the art (i.e., whether the term had a specific meaning used by those of skill in the art to describe a defined structure or specific class of structures).” App. 66-67. If “skilled artisans understood ‘voltage source means’ to refer to a defined structure, it would not be considered a means-plus-function limitation.” App. 67. Because the intrinsic evidence “did not resolve the question,” it was necessary to consider “the testimony of [Petitioner’s] expert,” Dr. Roberts. *Id.* “When situations like this arise,” Judge O’Malley explained, “it is appropriate—and sometimes necessary—to make findings based on extrinsic evidence that relate to the meaning of a disputed term.” *Id.* A district court’s “[r]esolution of these fact-intensive disputes,” she stated, merits deference. *Id.*

Third, Judge O’Malley continued, “by refusing to acknowledge the factual component of claim construction, *Cybor* contravenes the clear directives” of Federal Rule of Civil Procedure 52(a)(6), which requires factual findings to be upheld unless clearly erroneous. App. 69.

Fourth, *Cybor* “has made the claim construction process less transparent, accurate, predictable, and efficient, thereby imposing high ‘social costs.’” App. 75.

Fifth, the *Cybor* rule ignores the comparative expertise and tools “that district courts have available to resolve factual disputes fairly and accurately,” App. 79, including “analyzing patents, their written descriptions, and prosecution histories, [and] receiving testimony from inventors and experts,” App. 82. *Cybor* permits the court of appeals to “ignore” the fact-intensive inquiries before a district court, thereby “undermin[ing] the authority of district judges” and “compromis[ing] the decision-making process on appeal.” App. 82-83.

REASONS FOR GRANTING THE PETITION

This petition presents the same question presented in the petition for certiorari in *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, No. 13-854 (Mar. 31, 2014), which the Court granted shortly after the en banc Federal Circuit’s decision in this case. Both petitions challenge the Federal Circuit’s widely criticized *Cybor* rule holding that patent claim construction presents a purely legal question subject to *de novo* review. This case squarely and cleanly presents that issue. Indeed, the dissenting en banc Judges sat on the panel and presumably viewed this case as an ideal vehicle for the potential en banc reconsideration of *Cybor*. Accordingly, the petition in this case should be held pending the Court’s disposition of *Teva*, and then disposed of accordingly.

Should the Court correctly determine in *Teva* that claim construction may involve fact-finding subject to

clear-error review, it should grant this petition, vacate the en banc and panel judgments below, and remand for further consideration. As confirmed by the Federal Circuit’s decision to employ this case as the vehicle for en banc review of the *Cybor* rule, the standard of review for factual findings underlying patent claim construction is outcome-determinative here given the competing views of Petitioner’s expert testimony by the district court and court of appeals.

Should the Court affirm the Federal Circuit’s view that claim construction presents only purely legal questions, however, it should grant this petition to consider an important question expressly left open in *Ortiz v. Jordan*, 131 S. Ct. 884 (2011)—*viz.*, whether a court of appeals may review a “purely legal” challenge rejected on summary judgment and not later raised in a motion for judgment as a matter of law under Federal Rule of Civil Procedure 50. This issue has divided the courts of appeals: six have held that a “purely legal” issue represents an exception to the general rule and need not be raised in a Rule 50 motion, while two have correctly held that a purely legal issue, like any other argument raised in a summary judgment motion, must be raised in a Rule 50 motion to be preserved for appellate review. This petition is an ideal vehicle to resolve the split if the Court upholds the *Cybor* rule, because the forfeiture issue is outcome-determinative here. The district court denied Respondent’s motion for summary judgment challenging the “voltage source means” claim construction—a “purely legal” issue if *Cybor* is affirmed—and Respondent failed to raise the issue in a Rule 50 motion. The Federal Circuit was only able to reach the issue on which it reversed by ignoring what would be a clear forfeiture in at least two circuits.

I. The Court Should Hold The Petition For *Teva* And Grant, Vacate, And Remand Should It Correctly Conclude That Patent Claim Construction Does Not Present A Purely Legal Question Subject To *De Novo* Review.

A. The Petition Presents the Same Question Presented in *Teva*.

This petition presents the exact same question presented in *Teva*: whether the Federal Circuit’s longstanding refusal to review factual findings underlying claim construction for clear error—the so-called “*Cybor* rule,” which the en banc court reaffirmed in the decision below—is erroneous. Indeed, the identity of the issue here and in *Teva* was made clear in the certiorari-stage briefing in *Teva*. The respondents in *Teva* argued that the Court should deny certiorari in that case because “[t]he question *Teva* poses in its petition ... is pending before the en banc Federal Circuit in *Lighting Ballast Control LLC v. Philips Electronics North America Corp.*,” and the Court should not “grant review to consider a question currently being considered by the en banc Federal Circuit.” Br. for Resps. in Opp. 1-2, *Teva Pharm.*, No. 13-854 (Feb. 5, 2014), 2014 WL 507332; *see also id.* at 15 (“In *Lighting Ballast*, the en banc Federal Circuit already is reconsidering whether and to what extent a district court’s claim-construction ruling is entitled to deference on appeal.”); *id.* (“The en banc Circuit is expressly considering whether to ‘overrule *Cybor*’ in whole or in part.” (quoting App. 93)); *id.* at 18 (“If this Court wishes to consider the standard of appellate

review for claim-construction rulings, *Lighting Ballast* ... would be the appropriate vehicle to do so.”).

In their reply—filed after the en banc decision in this case—the *Teva* petitioners did not dispute respondents’ contention that their petition presented the same question as this case. To the contrary, in urging review, they noted that “the Federal Circuit decided in *Lighting Ballast* to continue to follow *Cybor* irrespective of its merits and notwithstanding its flaws.” Reply Br. for Petrs. 6, *Teva Pharm.*, No. 13-854 (Feb. 26, 2014), 2014 WL 768707.

Given that this case presents the same question that is presented in *Teva*, the Court, consistent with its ordinary practice, should hold the petition in this case pending its disposition of *Teva*.

B. Factual Findings Underlying a District Court’s Claim Construction Should Be Reviewed for Clear Error, a Standard of Review That Is Outcome-Determinative Here.

Should the Court correctly conclude in *Teva* that factual findings underlying a district court’s claim construction should be reviewed for clear error, it should grant this petition, vacate the judgments below, and remand the case for further consideration. Had the court of appeals properly accorded clear-error deference to the district court’s factual findings supporting its construction of the “voltage source means” limitation, Petitioner would have rebutted the means-plus-function presumption, and the district court’s claim construction would have been affirmed. Indeed, three of the dissenting en banc Judges constituted the panel in this case and presumably

viewed it as an ideal vehicle for the en banc Federal Circuit to revisit the *Cybor* rule.

1. As explained at length in the recently-filed brief for petitioners in *Teva* and in Judge O'Malley's thorough dissent, the *Cybor* rule is mistaken. In *Cybor*, the en banc Federal Circuit concluded that “[n]othing” in this Court's *Markman* decision supports the view “that claim construction may involve subsidiary or underlying questions of fact.” 138 F.3d at 1455. Accordingly, the court held, “we review claim construction *de novo* on appeal including any allegedly fact-based questions relating to claim construction.” *Id.* at 1456. But contrary to the Federal Circuit's view that claim construction *only* and *always* presents purely legal questions, claim construction “at times requires district courts to resolve questions of fact.” App. 45 (O'Malley, J., dissenting). Indeed, this Court in *Markman* repeatedly “acknowledged that claim construction can present factual questions.” App. 59; *see, e.g., Markman*, 517 U.S. at 378, 390 (acknowledging the “evidentiary underpinnings” of claim construction and describing it as a “mongrel practice” that involves “construing a term of art following receipt of evidence”); *see also Cybor*, 138 F.3d at 1478 (Rader, J., dissenting) (listing the many “factual components” of claim interpretation); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1332 (Fed. Cir. 2005) (Mayer, J., dissenting) (remarking that “the nature of the questions underlying claim construction illustrate that they are factual”).

Once it is recognized that claim construction can involve factual findings by the district court, Federal Rule of Civil Procedure 52(a) *requires* that those

determinations be upheld unless clearly erroneous. Rule 52(a) “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.” *Pullman-Standard v. Swint*, 456 U.S. 273, 287 (1982); *see also Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485, 498 (1984) (“We have repeatedly held that ... Rule [52(a)] means what it says.”).

Affording “zero deference to any aspect of a district court’s claim construction,” App. 79 (O’Malley, J., dissenting), also disregards the “respective institutional advantages of trial and appellate courts.” *First Options of Chi., Inc. v. Kaplan*, 514 U.S. 938, 948 (1995) (quoting *Salve Regina Coll. v. Russell*, 499 U.S. 225, 233 (1991)). When construing claims, the trial judge “has tools to acquire and evaluate evidence concerning claim construction that [the Federal Circuit] lacks.” *Cybor*, 138 F.3d at 1477 (Rader, J., dissenting). Trial judges “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, ... and deliberating over the meaning of the claim language.” *Id.* An appellate court, by contrast, considers only limited briefing and oral argument and a “sterile written record” that “can never convey all the nuances and intangibles of the decisional process.” *Id.* at 1478; *cf. United States v. Taylor*, 487 U.S. 326, 342-43 (1988). Finally, as Judge O’Malley explained, the *Cybor* rule “has made the claim construction process less transparent, accurate,

predictable, and efficient, thereby imposing high ‘social costs.’” App. 75 (O’Malley, J., dissenting).

The many legal flaws and adverse consequences of the *Cybor* rule have been thoroughly documented by those calling for its rejection. In the en banc proceedings below, sixteen separate *amicus* briefs urged the court to overrule *Cybor*. Among those parties was the United States, which argued that “[b]ecause *Cybor* fails to acknowledge that claim construction may involve factual findings entitled to deferential review under Rule 52(a), it should be overruled.” Br. for the United States as Amicus Curiae on Reh’g En Banc in Supp. of Neither Party 4, *Lighting Ballast Control LLC v. Philips Elecs. North Am. Corp.*, No. 2012-1014 (Fed. Cir. June 11, 2013), 2013 WL 3193440.

2. The Federal Circuit’s decision to grant en banc review of the *Cybor* rule in this case, after years of refusing to reconsider the issue, *see, e.g., Retractable Techs., Inc. v. Becton, Dickinson & Co.*, 659 F.3d 1369 (Fed. Cir. 2011) (denying rehearing en banc); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039 (Fed. Cir. 2006) (same), reflects the outcome-determinative nature of the question presented here. *See Retractable Techs.*, 659 F.3d at 1373 (Moore, J., dissenting from denial of rehearing en banc) (pining for “that ever-elusive perfect vehicle to review the issue of deference to the district court’s claim construction”). Accordingly, should the Court properly hold that the *Cybor* rule cannot be sustained, it should grant this petition, vacate the judgments of the court of appeals, and remand the case for further consideration.

This case involves “disputed factual questions” and turns on a “fact-intensive dispute[]” over whether the “voltage source means” limitation in Claim 1 “denote[s] a particular structure to those of skill in the art.” App. 66-67 (O’Malley, J., dissenting). As the panel noted, the district court expressly “found that ... the claimed ‘voltage source means’ corresponds to a class of structures.” App. 99. Specifically, the district court found that the “voltage source means” limitation is “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.” App. 201. Indeed, it found that for lighting ballast applications using an AC power line source—*i.e.*, the applications contemplated by the patent, as reflected by its repeated references to that power line source—*only* a rectifier could provide “a constant or variable magnitude DC voltage” as described in the limitation. *Id.*

The district court made these factual determinations based on its view of the expert testimony. In particular, it credited Dr. Roberts’ testimony that because “nearly all common applications” of lighting ballasts draw power “from an AC power source,” as the patent itself describes, the “voltage source means” limitation in the ’529 patent “would connote to anyone skilled in the art, the structure of a rectifier.” App. 199-200. It also credited Dr. Roberts’ view that “the only way for a lighting ballast to convert AC ... into DC ... is through a rectifier,” and that one skilled in the art “would immediately ascertain and implement the structure necessary to supply the DC supply voltage.” *Id.*

Finally, the district court credited the testimony of Bobel, the inventor, who testified that he drafted the language to connote “physical structure to those skilled in the art” and that “one skilled in the art of designing lighting ballasts” would, in the context of the ’529 patent, view the “voltage source means” limitation as connoting “a structure that will ‘rectify the line.’” App. 200. Based on its view of this testimony, the court held that Petitioner had rebutted the means-plus-function presumption. App. 203.⁵

The Federal Circuit, however, accorded no deference to any of the district court’s critical observations and determinations regarding the expert testimony. To the contrary, applying *Cybor*, it reviewed the factual record *de novo* and drew its own independent conclusion that Dr. Roberts’ testimony “suggests a lack of a defined class of structures.” App. 105. Furthermore, it completely disregarded Bobel’s testimony attesting to defined physical structure. Applying the *de novo* review commanded by *Cybor*, the panel concluded that Petitioner had *not* rebutted the means-plus-function presumption, thereby triggering the means-plus-function test of § 112 ¶ 6. And it proceeded to hold that the ’529 patent failed that test, rendering the patent invalid.

Had the panel applied the highly deferential clear-error standard of review to the district court’s entirely plausible findings regarding the expert

⁵ The centrality of the expert testimony is illustrated by the district court’s initial ruling in Respondent’s favor. Only after acknowledging that it had “unduly discounted” the expert testimony did the court hold for Petitioner on reconsideration. App. 195.

testimony—rather than reviewing the expert testimony *de novo* and drawing its own independent conclusions—there is little doubt that it would have affirmed the district court’s claim construction. Indeed, *all* of the panel members were en banc dissenters. *See* n.4, *supra*. It is thus a fair inference that the panel supported en banc review and viewed this case as an ideal candidate for en banc consideration of the long-simmering dispute over the validity of *Cybor* precisely because the standard of review was outcome-determinative here. As Judge O’Malley observed, “[w]hen *situations like this* arise, it is appropriate—and sometimes necessary—to make findings based on extrinsic evidence,” and those findings “deserve[] the deference that Rule 52(a)(6) requires.” App. 67 (O’Malley, J., dissenting) (emphasis added).

In sum, the circumstances here are precisely those where clear-error review of factual determinations underlying claim construction matters. Accordingly, should this Court properly hold that the *Cybor* rule cannot stand and factual findings in support of claim construction must be upheld absent clear error, it should grant the petition, vacate the judgments below, and remand the case to the court of appeals for further consideration.

II. Should The Court Conclude in *Teva* That Patent Claim Construction Presents A Purely Legal Question, It Should Grant Certiorari To Resolve Whether A Rule 50 Motion Is Necessary To Preserve A Purely Legal Challenge Rejected On Summary Judgment.

If, despite the glaring flaws of the *Cybor* rule, the Court in *Teva* affirms the Federal Circuit's view that patent claim construction is "a purely legal issue ... subject to *de novo* review," *Cybor*, 138 F.3d at 1451, the Court should grant certiorari to address a second question that this case would then squarely present: whether there is an exception for "purely legal" issues to the general rule that raising an issue in a rejected summary judgment motion but not renewing it in a motion for judgment as a matter of law under Federal Rule of Civil Procedure 50 is insufficient to preserve the issue for appellate review. This issue has starkly divided the circuits, was expressly left unresolved by the Court in *Ortiz v. Jordan*, 131 S. Ct. 884 (2011), and is outcome-determinative here should the Court affirm the *Cybor* rule in *Teva*.

In *Ortiz*, respondents had sought summary judgment on qualified-immunity grounds in petitioner's 42 U.S.C. § 1983 action, which the district court denied because of material facts genuinely in dispute. *Id.* at 888. At trial, respondents moved for judgment as a matter of law under Fed. R. Civ. P. 50(a) at the close of petitioner's evidence and their own case, but they did not move for judgment as a matter of law under Fed. R. Civ. P. 50(b) after the jury returned verdicts against them. *Id.* at 890-91. They appealed the denial of their pretrial

motion for summary judgment to the court of appeals, which reversed based on qualified immunity grounds. *Id.* at 888.

The Court granted certiorari to determine “whether a party may appeal a denial of summary judgment after a district court has conducted a full trial on the merits.” *Id.* at 891. The Court was unequivocal: “Our answer is no.” *Id.* at 888-89. In so holding, the Court faulted respondents for failing to seek judgment as a matter of law under Federal Rule of Civil Procedure 50(b), without which “an appellate court is ‘powerless’ to review the sufficiency of the evidence after trial.” *Id.* at 891-92 (quoting *Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc.*, 546 U.S. 394, 405 (2006)). Respondents contended that a Rule 50 motion was unnecessary because their summary judgment motion raised only “a purely legal issue.” *Id.* at 892 (citing *Rekhi v. Wildwood Indus., Inc.*, 61 F.3d 1313 (7th Cir. 1995)). The Court held that it “need not address this argument” because respondents’ motion for summary judgment had been denied not on “purely legal” grounds but because of genuine issues of material fact. *Id.* at 892-93. Because the summary judgment motion did not “present ‘neat abstract issues of law,’” respondents were “obliged” to raise their challenge in a Rule 50(b) motion. *Id.* at 893 (quoting *Johnson v. Jones*, 515 U.S. 304, 317 (1995)).

If the Court correctly holds in *Teva* that, contrary to the *Cybor* rule, claim construction does not present a “purely legal” issue, *Ortiz* would then be squarely applicable and provide an additional basis for granting the petition, vacating the judgments below, and remanding for further consideration. As the panel below observed, Respondent “twice moved for summary

judgment and argued its proposed construction of ‘voltage source means,’” and twice the district court denied summary judgment. App. 100. At trial, Respondent “did not continue to dispute the court’s construction of ‘voltage source means”” in its Rule 50(a) motion, and after the verdict, Respondent “did not press its argument regarding the court’s construction of ‘voltage source means”” in its Rule 50(b) motion. App. 99. Thus, under *Ortiz*, Respondent has squarely forfeited the argument on which it prevailed by not including it in its JMOL motion, unless the issue is purely legal. If this Court concludes in *Teva* that claim construction does not present “purely legal” questions, then Respondent cannot avoid the prohibitive effect of *Ortiz*.⁶

If, however, the Court affirms the Federal Circuit’s view that patent claim construction is “a purely legal issue,” *Cybor*, 138 F.3d at 1451, then the question left open in *Ortiz* is squarely before the Court. The federal courts of appeals are squarely divided on the issue. Six circuits—the Second, Sixth, Seventh, Ninth, Tenth, and District of Columbia Circuits—have firmly held that an

⁶ Respondent also did not object to a jury instruction “that the term ‘voltage source means’ refers to ‘a rectifier,” *i.e.*, the precise construction that the district court adopted. App. 99. The panel below relied on the so-called futility exception to hold that Respondent’s failure to object to the charge did not prevent Respondent from raising the issue on appeal. App. 101. Almost every court of appeals, however, has rejected a futility exception in the context of jury instructions. *See, e.g., Jiminez v. Wood Cnty., Tex.*, 660 F.3d 841, 845-46 & n.7 (5th Cir. 2011); *Ji v. Bose Corp.*, 626 F.3d 116, 125-26 (1st Cir. 2010). *But see Medtronic, Inc. v. White*, 526 F.3d 487, 495 (9th Cir. 2008). While the Court may wish to resolve this conflict, it need not do so here given the Rule 50 waiver.

appellate court *may* review a “purely legal” issue rejected on summary judgment but not raised in a Rule 50 motion. *See In re AmTrust Fin. Corp.*, 694 F.3d 741, 750-51 (6th Cir. 2012); *Feld v. Feld*, 688 F.3d 779, 781-83 (D.C. Cir. 2012); *F.B.T. Prods., LLC v. Aftermath Records*, 621 F.3d 958, 962-63 (9th Cir. 2010); *Houskins v. Sheahan*, 549 F.3d 480, 488-89 (7th Cir. 2008); *Rothstein v. Carriere*, 373 F.3d 275, 283-84 (2d Cir. 2004); *Wilson v. Union Pac. Ry. Co.*, 56 F.3d 1226, 1229 (10th Cir. 1995).

By contrast, two circuits—the First and Fourth Circuits—have firmly held that an appellate court *may not* review a “purely legal” issue rejected on summary judgment but not raised in a Rule 50 motion. *See Ji v. Bose Corp.*, 626 F.3d 116, 127-28 (1st Cir. 2010) (“We have not recognized an exception ... as some circuits have done, when a party’s challenge [to denial of a motion for summary judgment] is based on a circumscribed legal error Instead, our rule is that even legal errors cannot be reviewed unless the challenging party restates its objection in a [Rule 50] motion for JMOL.”); *Varghese v. Honeywell Int’l, Inc.*, 424 F.3d 411, 423 (4th Cir. 2005) (“We recognize that several other circuits have taken a different approach on this issue, allowing appeals from a denial of summary judgment after a trial where the summary judgment motion raised a legal issue [T]heir approach simply conflicts with our own.”).

The Eighth Circuit has concededly issued conflicting decisions on the question. *See Owatonna Clinic–Mayo Health Sys. v. Med. Protective Co. of Fort Wayne, Ind.*, 639 F.3d 806, 809-10 (8th Cir. 2011) (acknowledging that its “cases related to this general

question may not be in harmony” (citing *Metro. Life Ins. Co. v. Golden Triangle*, 121 F.3d 351 (8th Cir. 1997), and *White Consol. Indus., Inc. v. McGill Mfg. Co.*, 165 F.3d 1185 (8th Cir. 1999))). The Fifth Circuit also has not “settled on a position.” *Feld*, 688 F.3d at 782 n.3 (citing *Becker v. Tidewater, Inc.*, 586 F.3d 358, 365 n.4 (5th Cir. 2009), and *Black v. J.I. Case Co.*, 22 F.3d 568, 571 n.5 (5th Cir. 1994)).⁷

This Court should grant review on this question not only because the circuits are badly split, but also because the majority rule, which was applied here, is incorrect, as *Ortiz* strongly suggests. There, the Court squarely addressed the question, “May a party ... appeal an order denying summary judgment after a full trial on the merits?” And it just as squarely responded: “Our answer is no.” 131 S. Ct. at 888-89. That colloquy disposes of this case, for Respondent sought appellate review of the denial of its motion(s) for summary judgment addressing the “voltage source means”

⁷ The Third and Eleventh Circuits have not squarely addressed whether failure to make a Rule 50 motion following denial of a motion for summary judgment on “purely legal” grounds constitutes forfeiture. They have, however, addressed whether an appellate court can review the denial of a summary judgment motion raising “purely legal” issues after a full trial on the merits—wholly apart from whether it is renewed in a Rule 50 motion. The Third Circuit will review the denial of a summary judgment motion presenting a “purely legal” question. See *Mincy v. McConnell*, 523 F. App’x 898, 900 (3d Cir. 2013). The Eleventh Circuit, by contrast, will “not review the pretrial denial of a motion for summary judgment after a full trial and judgment on the merits,” even if the motion raised only legal issues. *In re Carlson*, 464 F. App’x 845, 849 (11th Cir. 2012). While these decisions arose after bench trials, which do not implicate Rule 50, they nevertheless underscore the unsettled legal landscape in the circuits subsequent to *Ortiz*.

construction after a full trial on the merits, a practice *Ortiz* forbids. *See also id.* at 894 (Thomas, J., concurring in the judgment) (“It is clear ... that the appeals court reviewed the order denying summary judgment, and that was error.”). As *Ortiz* observes, although orders denying summary judgment are ordinarily not final decisions subject to appeal, litigants have a variety of options to obtain review of the issues in such orders: immediate appeal under the collateral order doctrine, certification under 28 U.S.C. § 1292(b), or, most straightforwardly, subsequent motions under Rule 50. 131 S. Ct. at 891-92. What is not an option is what Respondent did here: nothing.

To be sure, *Ortiz* reserved the question of whether there could be an exception to the general rule for “purely legal” issues. But such an exception has little to recommend it as either a theoretical or practical matter. Manufacturing a dichotomy between “purely legal” and “not purely legal” would require courts “to engage in the dubious undertaking of determining the bases on which summary judgment is denied and whether those bases are ‘legal’ or ‘factual,’” an inquiry complicated by the fact that “all summary judgment decisions are legal decisions in that they do not rest on disputed facts.” *Chesapeake Paper Prods. Co. v. Stone & Webster Eng’g Corp.*, 51 F.3d 1229, 1235 (4th Cir. 1995). Moreover, nothing in the Federal Rules of Civil Procedure supports, let alone requires, such a dichotomy, and the prospect of creating “a new jurisprudence in which district courts would be obliged to anticipate parties’ arguments on appeal by bifurcating the legal standards and factual conclusions supporting their decisions denying summary judgment” is not an attractive prospect. *Id.*; *see also Black*, 22 F.3d at 571 n.5. And

“[e]ven when the pretrial record and the trial testimony are identical,” as would presumably be the case in “purely legal” situations, judgment following a Rule 50 motion “is superior to a pretrial decision because the factfinder’s verdict depends on credibility assessments that a pretrial paper record simply cannot allow.” *Varghese*, 424 F.3d at 421 (quoting *Chesapeake*, 51 F.3d at 1226) (quotation marks omitted).

There is no reason to go down this path when the rejection of purely legal issues on summary judgment “can be adequately vindicated by other means,” namely, a Rule 50 motion. *Mohawk Indus., Inc. v. Carpenter*, 558 U.S. 100, 107 (2009); see *Black*, 22 F.3d at 571 n.5 (noting that exception for purely legal issues “would benefit only those summary judgment movants who failed to properly move for judgment as a matter of law at the trial on the merits”). Indeed, all of this effort to discern and maintain a tenuous distinction between “purely legal” issues and other bases for summary judgment would make little practical difference, as prudent counsel would always have an incentive to renew their purely legal arguments in Rule 50(b) motions. Even courts adopting the “purely legal” exception recognize that because “the basis for the court’s denial of summary judgment may be difficult to discern,” “prudent counsel would do well to preserve the issue in a Rule 50 motion.” *Chemetall GMBH v. ZR Energy, Inc.*, 320 F.3d 714, 719 (7th Cir. 2003); *Wolfgang v. Mid-America Motorsports, Inc.*, 111 F.3d 1515, 1521-22 (10th Cir. 1997). But the concededly tenuous line between “purely legal” and “not purely legal” issues is a reason to require, not simply recommend, that the former category be included in Rule 50 motions, lest both district courts and courts of

appeals be put in the difficult position of discerning the nebulous distinctions between the two.

In all events, whatever this Court's ultimate resolution of the question, it is clearly not a question whose answer should vary among the circuits. Such a basic question of appellate preservation clearly demands a uniform rule. It makes no sense for the exact same argument to be deemed fully preserved in one circuit and fatally forfeited in another. Both attorneys and their clients need to know whether renewing a legal objection in a Rule 50 motion is simply a best practice or is absolutely required.

In short, the circuit split is stark; it is acknowledged, *see Feld*, 688 F.3d at 781-82; it was expressly left unresolved by *Ortiz*, *see Owatonna*, 639 F.3d at 810 (noting that “[t]his very issue was recently raised in *Ortiz*, but the Court decided that it need not address it” (citation omitted)); it is consequential; and, critically, it is outcome-determinative here. Had this case proceeded in a district court within the First or Fourth Circuits (and arguably the Eleventh, *see* n.7, *supra*), Respondent would have been prohibited from raising on appeal the arguments on which it prevailed, because they were raised only in summary judgment motions and not included in its Rule 50 motion for judgment as a matter of law.⁸ But because the case proceeded in a district court within a circuit that has not required an appellant to raise purely legal objections

⁸ When addressing “a procedural issue not unique to patent law,” the Federal Circuit applies “the law of the regional circuit in which the appeal from the district court would usually lie.” *Summit Tech., Inc. v. Nidek Co.*, 363 F.3d 1219, 1223 (Fed. Cir. 2004).

denied on summary judgment in a Rule 50 motion, Respondent's challenge to the "voltage source means" construction was permitted to proceed, ultimately resulting in reversal of Petitioner's \$4.5 million judgment.

Therefore, if this Court holds in *Teva* that claim-construction is a purely legal issue to be reviewed *de novo*, it should grant certiorari to resolve this deep, entrenched, and consequential split.

CONCLUSION

The petition should be held pending this Court's disposition of *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, No. 13-854. Should the Court overrule or modify the *Cybor* rule in *Teva*, the petition should be granted, the judgments below vacated, and the case remanded. Should the Court affirm the *Cybor* rule, the petition should be granted to consider the second question presented.

Respectfully submitted,

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