2012-1014

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

LIGHTING BALLAST CONTROL LLC,
Plaintiff-Appellee,

v.

PHILIPS ELECTRONICS NORTH AMERICA CORPORATION,
Defendant,

and

UNIVERSAL LIGHTING TECHNOLOGIES, INC.,
Defendant-Appellant.

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

BRIEF FOR THE UNITED STATES AS AMICUS CURIAE ON REHEARING EN BANC IN SUPPORT OF NEITHER PARTY

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I. STATEMENT OF INTEREST

Pursuant to Rule 29(a) of the Federal Rules of Appellate Procedure, the United States respectfully submits this amicus brief on behalf of the United States Patent and Trademark Office (USPTO), whose views the Court invited, and other affected agencies of the federal government. The USPTO, an agency of the United States Department of Commerce, is "responsible for the granting and issuing of patents," and "advise[s] Federal departments and agencies on matters of intellectual property policy in the United States." 35 U.S.C. § 2(a)(1), (b)(9). This Court's resolution of the questions presented in its March 15, 2013 Order may have a significant practical impact on the functioning of the patent system, specifically the conduct of district court patent infringement litigation and appellate review thereof. The government therefore appreciates the opportunity to provide its views on this topic.

II. QUESTIONS PRESENTED

This Court's March 15, 2013 Order presents the following questions:

1. Should this Court overrule *Cybor Corporation v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) (*en banc*)?

2. Should this Court afford deference to any aspect of a district court's claim construction?

3. If so, which aspects should be afforded deference?

III. SUMMARY OF THE ARGUMENT

A patent is an integrated written instrument that grants to the patentee, for a limited term, the right to exclude others in the United States from practicing the claimed invention. The proper scope of the exclusive rights conferred on the patentee is—like the construction of any other integrated written instrument—ultimately a question of law. In most cases, a district court may determine the proper construction of a disputed claim term without venturing beyond the four corners of the patent, informed as necessary by the patent's prosecution history. In such cases, no reason justifies modifying or departing from the *Cybor* rule that claim construction is subject to *de novo* review on appeal.

In a subset of cases, however, the ultimate legal issue of a patent claim's construction may depend in part on the resolution of subsidiary questions of fact. Factual controversies will typically focus on evidence, such as expert testimony or documentary materials, that bears on the meaning of claim terms to a skilled artisan at the time of the invention. Parties may dispute, for example, the prevailing meaning of a specialized term of art in a particular industry at a particular time. As the Supreme Court has recognized in the context of obviousness, resolving such a question is a "basic factual inquir[y]." *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). And the same question is no less factual

in nature when it relates to the meaning of a disputed claim term rather than the validity of the claim.

When a district court construing a patent claim makes a properly-identified finding of fact, that factual finding is entitled to deference on appeal. Under Rule 52(a) of the Federal Rules of Civil Procedure, "[f]indings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous, and the reviewing court must give due regard to the trial court's opportunity to judge the witnesses' credibility." Fed. R. Civ. P. 52(a)(6). Rule 52(a)'s requirement of deferential review reflects a wealth of accumulated wisdom and experience about judicial economy and relative institutional expertise, and the federal courts must abide by it.

But even in cases involving subsidiary factual findings, a district court's ultimate conclusion that a disputed claim term has one construction over another—that is, the court's conclusion regarding the meaning and proper scope of the patentee's exclusive legal rights—is *always* a legal conclusion subject to *de novo* appellate review. That is because factual findings, even when relevant, do not themselves resolve claim-construction disputes. After making a factual finding that a disputed claim term had a particular meaning in the relevant art at the time of the invention, for example, a district court would still need to draw a

legal conclusion about the proper construction of the claim term by applying the legal canons of claim construction.

Because *Cybor* fails to acknowledge that claim construction may involve factual findings entitled to deferential review under Rule 52(a), it should be overruled. But this Court should reaffirm that the ultimate construction of a patent claim is a legal conclusion subject to *de novo* review.

IV. ARGUMENT

A. This Court Should Overturn *Cybor* Because *Markman* Does Not Compel *De Novo* Review of Every Determination Related to Claim Construction

This Court, siting *en banc*, held in *Cybor* that it reviews a district court's construction of a patent claim *de novo* on appeal, "including any allegedly fact-based questions relating to claim construction." *Cybor*, 138 F.3d at 1456. That conclusion flowed from this Court's view that *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996), held "that the totality of claim construction is a legal question to be decided by the judge," and that "[n]othing in the Supreme Court's opinion supports the view . . . that claim construction may involve subsidiary or underlying questions of fact." *Cybor*, 138 F.3d at 1455.

The Supreme Court, however, had no occasion in *Markman* to address the proper allocation of authority between the trial courts and this Court, and its

analysis does not logically compel *de novo* review of all district court findings that bear on claim construction. The Supreme Court in *Markman* considered "whether the interpretation of a so-called patent claim . . . is a matter of law reserved entirely for the court, or subject to a Seventh Amendment guarantee that a jury will determine the meaning of any disputed term of art about which expert testimony is offered." 517 U.S. at 372. Finding no established common-law practice of juries acting as "definers of patent terms" at the time the Seventh Amendment was adopted, *id.* at 379-81, the Court concluded that the task of claim construction is not subject to the constitutional jury-trial guarantee, *id.* at 384.

The Court then turned to "functional considerations" to determine the judicial actor—judge or jury—best suited to interpret claims. *Id.* at 388-89. In assessing those considerations, the Court accepted that claim construction can involve factual inquiries, including the receipt of expert testimony and the accompanying credibility determinations. *See id.* at 389-90. But the Court concluded that "judges, not juries, are the better suited to find the acquired meaning of patent terms." *Id.* at 388. The Court explained that "[t]he construction of written instruments is one of those things that judges often do and are likely to do better than jurors," *id.*, and that a jury's skill at evaluating witness demeanor is "much less significant than a trained ability to evaluate the

testimony in relation to the overall structure of the patent," *id.* at 389-90. Accordingly, the Court concluded that "there 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." *Id.* at 390.

Markman amply supports *Cybor's* holding that the task of construing a claim belongs to the trial court, and that the ultimate question of claim construction is a legal issue. *Markman* does not, however, force *Cybor*'s further conclusion that claim construction never requires the trial court to render factual findings subject to deferential review. In the government's view, most disputes over the proper construction of claim terms can and should be resolved within the four corners of the patent, informed as necessary by the prosecution history. In such cases, no reason exists to depart from the usual understanding that a district court's legal rulings are reviewed *de novo* on appeal. As discussed below, however, questions of fact may arise during claim construction that require the trial court to receive evidence, hear testimony, make credibility determinations, or resolve inconsistent accounts of historical fact. Findings rendered in such cases are entitled to deference under the "clearly erroneous" standard of Rule 52(a). To the extent that *Cybor* is inconsistent with this view, it should be overruled.

1. *Markman* recognizes that some claim-construction inquiries require a district court to resolve evidentiary disputes

The *Cybor* Court erred in reading *Markman* as formally classifying claim construction as a pure issue of law lacking any distinct factual components entitled to deferential review. 138 F.3d at 1455. *Markman* simply allocated the task of construing claims to the court. The Supreme Court specifically avoided answering the question of whether claim construction is a matter of law, observing instead that claim construction "'falls somewhere between a pristine legal standard and a simple historical fact.'" *Markman*, 517 U.S. at 388 (quoting *Miller v. Fenton*, 474 U.S. 104, 114 (1985)); *see also Miller*, 474 U.S. at 113 ("[D]istinguishing questions of fact from questions of law has been, to say the least, elusive."). More colorfully, and perhaps more aptly, the Court called claim construction a "mongrel practice." *Markman*, 517 U.S. at 378. But ultimately, the Court did not make any fact/law distinction that would compel *Cybor's* holding. *See, e.g.*, *id.* at 384 n.10 ("Because we conclude that our precedent supports classifying the question as one for the court, we need not decide . . . the extent to which the Seventh Amendment can be said to have crystallized a law/fact distinction . . . .").

To the contrary, *Markman* recognized that, at times, a district court must resolve factual disputes in construing a claim. *Id.* at 389-90. For example, the

trial court may need to resolve conflicts in the testimony of competing experts regarding the meaning of a particular term in the art at the time of the invention. *Id.* *Markman* did not deny that such questions are factual in nature, but rather concluded that the court (as opposed to the jury) is logically better suited to resolve them. *Id.* at 388-90. A court, trained in interpreting legal texts, is more attuned to prioritize the significance of facts in the overall legal construction of a patent claim. *Id.* at 388-89. For example, when credibility determinations are necessary, the court is in the best position "to ascertain whether an expert's proposed definition fully comports" with the patent document as a whole. *Id.* at 390. *Markman* did not purport to transform the trial court's subsidiary factual determinations into legal determinations reviewed without deference on appeal.

The *Cybor* Court's dismissal of the Supreme Court's "mongrel practice" observation as "only prefatory comments," *Cybor*, 138 F.3d at 1455, is difficult to square with *Markman*'s express allocation of claim construction to the judge "*notwithstanding* its evidentiary underpinnings," *Markman*, 517 U.S. at 390 (emphasis added). For the same reason, *Cybor*'s assertion that nothing in *Markman* could be read to support the view that "claim construction may involve subsidiary or underlying questions of fact," 138 F.3d at 1455, overlooks the Supreme Court's indications to the contrary. *See Markman*, 517 U.S. at 378 (stating that claim construction may follow the "receipt of evidence"). And the

Court's isolated characterization of claim construction as "purely legal," 517 U.S. at 391, more aptly reflects its conclusion that the ultimate construction of patent claims is legal in nature. The whole of *Markman* is clear that some claim-construction tasks will involve a district court's resolution of subsidiary questions of fact, and the Supreme Court's allocation of that task entirely to the court did not silently transform factual questions into legal ones.

2. Rule 52(a) requires that all findings of fact be reviewed for clear error

Accepting that some claim-construction disputes involve the resolution of subsidiary questions of fact, the question of whether deference should be afforded to any aspect of a district court's claim construction is easily answered. Appellate courts must defer to a trial court's factual findings under Rule 52(a) of the Federal Rules of Civil Procedure, which stipulates that "[f]indings of fact, whether based on oral or other evidence, must not be set aside unless clearly erroneous, and the reviewing court must give due regard to the trial court's opportunity to judge the witnesses' credibility." Fed. R. Civ. P. 52(a)(6). Federal Courts possess no inherent authority to deviate from or create exceptions to that rule. *See, e.g.*, *Bank of Nova Scotia v. United States*, 487 U.S. 250, 255 (1988) (explaining that Rule 52(a) "is, in every pertinent respect, as binding as any statute duly enacted by Congress, and federal courts have no more discretion to disregard the Rule's mandate than they do to disregard

constitutional or statutory provisions"). Moreover, 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).

Rule 52(a) reflects decades of accumulated wisdom and experience regarding judicial economy and institutional capacity. *Anderson v. City of Bessemer City, N.C.*, 470 U.S. 564, 573-76 (1985); *see also First Options of Chi., Inc v. Kaplan*, 514 U.S. 938, 948 (1995) (stating that the standard of appellate review "should depend upon the respective institutional advantages of trial and appellate courts." (quotation omitted)). The Supreme Court has noted that *de novo* review is appropriate where an issue turns on concepts that acquire meaning through case-by-case application, a description that applies with great force to the legal principles of claim construction. *See, e.g.*, *Cooper Indus., Inc. v. Leatherman Tool Grp., Inc.*, 532 U.S. 424, 435-36 (2001) (review of trial court's determination of the constitutionality of punitive damages award); *Ornelas v. United States*, 517 U.S. 690, 697 (1996) (review of trial court's reasonable suspicion and probable cause determinations); *cf. Graham*, 383 U.S. at 18 (agreeing that there will be "difficulties in applying the nonoboviousness test," but those "difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should

be amenable to a case-by-case development"). But even in those situations, the Court has been careful to preserve review of subsidiary factual findings under the deferential "clearly erroneous" standard. *Cooper*, 532 U.S. at 440; *Ornelas*, 517 U.S. at 699-700; *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 810-11 (1986) (holding that factual findings underlying the nonobviousness inquiry are entitled to deferential review under Rule 52(a)).

Given the clear command of Rule 52(a), no justification exists to treat claim construction any differently. *Cybor* failed to explain why a district court's resolution of conflicting documentary evidence or expert testimony in the claim construction context may properly be reviewed *de novo*, even though similar questions of fact implicated in other patent-law contexts are reviewed under the appropriate deferential standard. For example, the "ultimate question" of obviousness under 35 U.S.C. § 103 is a question of law for the trial court, but "the § 103 condition . . . lends itself to several basic factual inquiries." *Graham*, 383 U.S. at 17. These include "the scope and content of the prior art . . . ; differences between the prior art and the claims at issue . . . ; and the level of ordinary skill in the pertinent art." *Id.* This Court reviews the district court's fact findings resulting from those inquiries deferentially, reserving only the ultimate question of compliance with § 103 for *de novo* review. *Dennison*, 475 U.S. at 810-11.

The majority in *Cybor* correctly emphasized that this Court exists to provide national uniformity to the patent laws. 138 F.3d at 1455. But the *Cybor* Court erred in relying on this role as justification for reviewing "any allegedly fact-based questions relating to claim construction" *de novo*. *Id.* at 1456. As *Markman* acknowledges, principles of *res judicata* and non-mutual issue preclusion serve to achieve the goal of national uniformity. 517 U.S. at 391 (citing *Blonder-Tongue Labs., Inc. v. Univ. of Ill. Found.*, 402 U.S. 313 (1971)). And even if some marginal decrease occurred in this Court's ability to ensure perfect uniformity in the interpretation of patent claims, that decrease would not provide a reason to ignore the clear mandate of Rule 52(a). Congress gave no indication in the patent laws that it intended to displace the fundamental principle of appellate review that factual findings are reviewed for clear error.

Moreover, the objective of national uniformity must be balanced against the practical effect of the current standard of appellate review on patent infringement litigation, which in certain circumstances actually encourages uncertainty. *See Cybor*, 138 F.3d at 1477 (Rader, J., dissenting) (stating that plenary review has made the Federal Circuit the "real center stage" in claim-construction disputes); *cf. Anderson*, 470 U.S. at 574-75 (stating that the goal of avoiding duplication of trial court effort makes deferential review of factual findings "the rule, not the exception"). In the government's view, recalibrating

the standard of review to reflect the trial court's "institutional advantage" in considering certain types of evidence in the claim-construction process, while preserving this Court's ability to give *de novo* review to the trial court's ultimate construction, would promote "interjurisdictional uniformity." *Markman*, 517 U.S. at 391. It would also conform this Court's jurisprudence to the requirements of Rule 52(a), while minimizing any adverse impact on patent infringement litigation.

B. The Subsidiary Factual Findings in Claim Construction Generally Derive From the Resolution of Historical Facts and Other Issues Based on Extrinsic Evidence

The difficult question in any particular case is not whether claim construction may involve factual findings, nor whether factual findings must be deferentially reviewed under Rule 52(a). The hard part is knowing whether a particular claim-construction determination properly constitutes a factual finding subject to that deference. At a minimum, the government believes that when a district court makes findings about a disputed historical fact, those findings are entitled to deference. A trial court's resolution of other issues based on its consideration of extrinsic evidence provides another hallmark distinguishing questions of fact from those of law.

1. Claim construction does not necessarily involve subsidiary questions of fact, and in such cases, constructions based entirely on the patent document itself should be reviewed *de novo*

A patent is an integrated written instrument whose ultimate legal construction is a question of law. In most cases, a district court may determine the proper construction of disputed claim terms without venturing beyond the four corners of the patent itself, informed as appropriate by the prosecution history. *See generally Phillips v. AWH Corp.*, 415 F.3d 1303, 1314-17 (Fed. Cir. 2005) (*en banc*). And in such cases, no reason exists to modify or depart from the *Cybor* rule that claim construction is subject to *de novo* review on appeal, because the district court's claim construction rests entirely on conclusions of law.[1] *See* Br. for United States as Amicus Curiae, *Retractable Techs. Inc. v. Becton, Dickinson & Co.*, No. 11-1154, at 17-22 (S. Ct.).

[1] While Supreme Court precedent predating *Markman* does not directly address the standard of review for claim construction, the Court seemingly conducted *de novo* review of the lower courts' constructions even if the Court did not clearly enunciate such a rule. *See, e.g.*, *Coupe v. Royer*, 155 U.S. 565, 574-77 (1895); *Merrill v. Yeomans*, 94 U.S. 568, 568-72 (1876); *Winans v. Denmead*, 56 U.S. 330, 338-43 (1853); *Hogg v. Emerson*, 47 U.S. 437, 484-86 (1848). But there is no indication in the Court's decisions that the lower courts considered anything beyond the patent document in construing the claims. *See, e.g.*, *Winans*, 56 U.S. at 338 (stating that the issue of claim construction "renders it necessary to examine the letters-patent, and the schedule annexed to them, to see whether their construction by the Circuit Court was correct"); *Merrill*, 94 U.S. at 571 ("But the language in the specifications aids us in construing the claim.").

2. Findings of historical fact are entitled to deference

As discussed above, however, some claim construction disputes have "evidentiary underpinnings." *Markman*, 517 U.S. at 390. One clear example of a factual finding is the historical meaning of a claim term to one of ordinary skill in the art at the time of the invention. *See Phillips*, 415 F.3d at 1313 ("We have made clear . . . that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application."). In appropriate cases, evidence can be offered to assist the court in resolving a dispute over the historical meaning of a claim term. *Id.* at 1314, 1317-18. Evidence may typically take the form of expert testimony, *see Markman*, 517 U.S. at 389-90, or the form of written documents such as patents or other technical writings, *see Phillips*, 415 F.3d at 1317-18. When the trial court receives such evidence and makes a finding of fact based on that evidence, that finding must be accepted as true on appeal absent clear error.

But a district court's factual determination about the historical meaning of a claim term (or any similar matter) will not resolve the legal question of claim construction. That determination must be considered along with the patent document itself to arrive at the correct legal construction, including any appropriate inferences arising from the prosecution history. *See Markman*, 517

U.S. at 389 ("[W]e expect[] any credibility determinations will be subsumed within the necessarily sophisticated analysis of the whole document, required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole."); *see also Winans v. New York & Erie R.R. Co.*, 62 U.S. 88, 101 (1858) ("[P]rofessors or mechanics cannot be received to prove to the court or jury what is the proper or legal construction of any instrument of writing."); *Corning v. Burden*, 56 U.S. 252, 270 (1853) ("The refusal of the court to hear the opinion of experts, as to the construction of the patent, was proper. Experts may be examined as to the meaning of terms of art . . . but not as to the construction of written instruments."). Moreover, a historical fact finding by itself is necessarily incomplete on the question of claim construction because the court must apply the law—*i.e.*, the legal canons of claim construction, *see, e.g.*, *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582-83 (Fed. Cir. 1996)—to determine the import of that fact.

An analogy to contract law is helpful. It is well settled that "the interpretation and construction of written contracts are matters of law and are freely reviewable as such." *See generally* 9C Wright & Miller, FED. PRAC. & PROC. § 2588, at 459-60 & n.11 (3d ed. 2008) (collecting cases) ("Wright & Miller"). But it sometimes happens that the ultimate legal construction of a contract depends in part on the resolution of contested questions of historical

fact on the basis of extrinsic evidence. Courts generally recognize that, in such cases, the consideration of extrinsic evidence involves "inferences of fact." *West v. Smith*, 101 U.S. 263, 270 (1879); *see also Great N. Ry. Co. v. Merchants' Elevator Co.*, 259 U.S. 285, 292 (1922) ("Where such a situation arises, and the peculiar meaning of words, or the existence of a usage, is proved by evidence, the function of construction is necessarily preceded by the determination of the matter of fact."). Appellate courts apply the clearly erroneous standard of review in those scenarios. *See generally* Wright & Miller at 463-64 n.13 (collecting cases). But the ultimate legal meaning and effect of the words of the contract in light of the factual findings remains a question of law.

Likewise here, a district court may find as a matter of fact that a disputed claim term had a certain meaning to a person of ordinary skill in the art at the time of the invention. But the court may ultimately conclude that the claim term has a different construction based on other contextual indications arising from such legal doctrines as claim differentiation and inventor lexicography, and as guided by the presumption of validity under 35 U.S.C. § 282. While this Court must accept the district court's fact findings unless they are clearly erroneous, it reviews without deference the legal question of whether, for example, other language in the patent indicates something other than the ordinary meaning.

Thus, only rarely will a finding of fact necessitate a particular conclusion of law. *Markman*, 517 U.S. at 389.

3. Other factual findings based on extrinsic evidence may bear on claim construction as well

Extrinsic evidence may be relevant to a claim-construction dispute apart from demonstrating a historical question of fact. For example, certain characteristics of matter, physical constants or properties, or the ability of various elements to perform claimed functions may be the subject of legitimate factual disputes ancillary to claim construction. When those disputes are resolved by a trial court weighing extrinsic evidence, the court's factual findings "must not be set aside unless clearly erroneous." Fed. R. Civ. P. 52(a)(6).

But as with the use of parol evidence in contract law, the trial court must guard against relying upon unnecessary extrinsic evidence when the patent document itself provides the correct claim construction. *Cf. Grun v. Pneumo Abex Corp.*, 163 F.3d 411, 420 (7th Cir. 1998) ("The rule against admitting unnecessary extrinsic evidence supports the law's general policy of upholding the integrity of written contracts and favoring written terms over extrinsic evidence." (quotation omitted)). As this Court emphasized in *Phillips*, while extrinsic evidence has a place in the claim construction process, it cannot be used "to contradict claim meaning that is unambiguous in light of the intrinsic evidence." 415 F.3d at 1324.

4. Not every reference to extrinsic evidence constitutes a factual finding subject to deferential review

It bears emphasizing that not every passing characterization of evidence by a district court constitutes a factual finding subject to deferential review under Rule 52(a). Even in cases where the district court has considered evidence outside the patent document, clear-error review is appropriate only to the extent that the district court has actually rendered discernible factual findings. In some cases, a district court might hear and subjectively be influenced by, for example, the testimony of competing expert witnesses, yet might fail to explain its own reasoning process in a way that clearly distinguishes between that process's factual and legal components. In that circumstance, the district court's ultimate agreement with one party's proposed construction of the disputed claim language does not necessarily mean that the court adopted that party's view of the relevant facts. Unless specific factual findings are either explicit or clearly implicit in the district court's explanation for its decision, this Court has no choice but to apply *de novo* review, even if the district court has heard the kinds of evidence that could have given rise to factual findings.

Moreover, the mere existence of a disagreement between parties about the construction of a claim term does not necessarily create a genuine issue of material fact precluding summary judgment. Rather, a true conflict of evidence

must exist. For example, in *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989), this Court explained that a "disputed issue of fact may, of course, arise in connection with interpretation of a term in a claim if there is a genuine evidentiary conflict created by the underlying probative evidence pertinent to the claim's interpretation." But in the absence of "such evidentiary conflict, claim interpretation may be resolved as an issue of law by the court on summary judgment." *Id.* at 1580; *see also Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1196-97 & n.3 (Fed. Cir. 1994) (stating that summary judgment is appropriate when the court has no need to go outside the four corners of the patent to construe the disputed claim term).

Finally, when confronted with an alleged factual dispute over the meaning of claim terms, the trial court must exercise care to distinguish relevant and probative expert testimony (*e.g.*, testimony about the accepted meaning of a claim term in the relevant art at the time of the invention) from irrelevant opinion (*e.g.*, an expert's present, subjective understanding of a patent claim). *See General Protecht Group, Inc. v. Int'l Trade Comm'n*, 619 F.3d 1303, 1310 (Fed. Cir. 2010) ("[A]n expert's subjective understanding of a patent term is irrelevant."); *Phillips*, 415 F.3d at 1318 ("[C]onclusory, unsupported assertions by experts as to the definition of a claim term are not useful to a court.").

5. The application of 35 U.S.C. § 112(f) may implicate factual findings

The dispute between the parties in this case concerns the application of 35 U.S.C. § 112(f) to the claims. This Court has explained that whether a claim limitation invokes means-plus-function treatment under § 112(f) is a question of law, reviewed under the *de novo* standard. *Cybor*, 138 F.3d 1454-55. In construing a potential means-plus-function claim, a court begins with a legal presumption that a claim limitation using the words "means" or "means for" invokes § 112(f) whereas a claim limitation not using those words does not. *E.g.*, *Greenberg v. Ethicon Endo-Surgery, Inc.*, 91 F.3d 1580, 1584 (Fed. Cir. 1996). In determining whether the legal presumption is rebutted, a court may consider, *inter alia*, evidence regarding the historical understanding of the disputed claim term among persons skilled in the art at the time of the invention. *Lighting World, Inc. v. Birchwood Lighting, Inc.*, 382 F.3d 1354, 1359-60 (Fed. Cir. 2004).

The United States takes no position on the outcome of the particular claim-construction dispute between the parties in this case. But if 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). But the Court owes no deference to the district court's legal conclusion regarding the relevance of that factual finding to the ultimate claim construction inquiry or to the application of § 112(f).

C. The Questions Presented Do Not Implicate This Court's Review of the USPTO's Interpretation of Claims

Unlike a district court, the USPTO applies the "broadest reasonable interpretation" ("BRI") to a claim term under examination. *Phillips*, 415 F.3d at 1316. This Court reviews that interpretation under the deferential "reasonableness" standard. *In re Morris*, 127 F.3d 1048, 1055 (Fed. Cir. 1997). The *en banc* Order in this case poses no question concerning BRI, and therefore does not concern the agency's distinct approach to claim interpretation or the standard under which this Court reviews those interpretations.

V. CONCLUSION

Contrary to this Court's holding in *Cybor*, a district court's claim construction may involve findings of fact that must be reviewed with deference on appeal. When the meaning of a disputed claim term lies within the four corners of the patent document (informed as necessary by the prosecution history), the current regime of *de novo* appellate review should normally apply. But some claim construction issues may require the district court to resolve factual disputes, and in those cases, this Court should review the trial court's findings and interpretation of the evidence in those cases under the clearly

erroneous standard of Federal Rule of Civil Procedure 52(a). Because *Cybor* fails to acknowledge that claim construction may involve factual findings entitled to deferential review, it should be overruled.

Respectfully submitted,

June 7, 2013

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CERTIFICATE OF SERVICE

I hereby certify that on June 7, 2013, I electronically filed the foregoing BRIEF FOR THE UNITED STATES AS AMICUS CURIAE ON REHEARING EN BANC IN SUPPORT OF NEITHER PARTY using the Court's CM/ECF filing system. Counsel were electronically served by and through the Court's CM/ECF filing system per Fed. R. App. P. 25 and Fed. Cir. R. 25(a) and 25(b).

/s/ Kristi L. R. Sawert

Kristi L. R. Sawert
Associate Solicitor

RULE 32(a)(7)(C) CERTIFICATE OF COMPLIANCE

I certify pursuant to Fed. R. App. Proc. 32(a)(7) that the foregoing BRIEF FOR THE UNITED STATES AS AMICUS CURIAE ON REHEARING EN BANC IN SUPPORT OF NEITHER PARTY complies with the type-volume limitation required by the Court's rule. The total number of words in the foregoing brief, excluding the table of contents and the table of authorities, is 5205 words as calculated using the Word® software program.

/s/ Kristi L. R. Sawert

Kristi L. R. Sawert
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