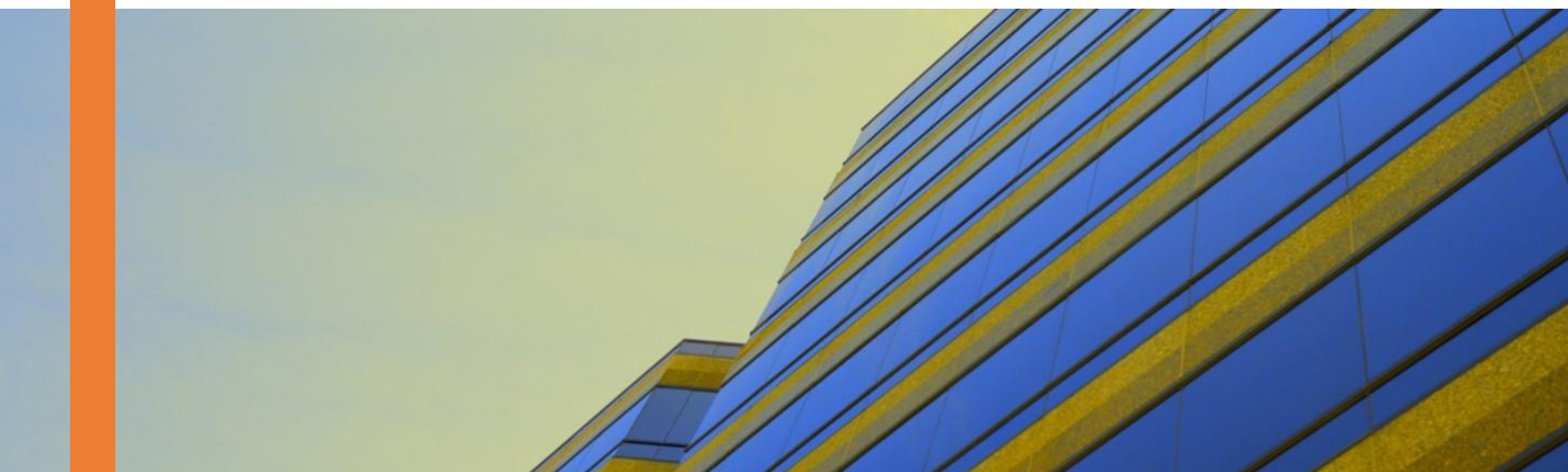


BLACKBIRD TECHNOLOGY LLC V.
ELB ELECTRONICS, INC.
2017-1703 (FED. CIR. JULY 16, 2018)



MATTHEW ALLEN
HARRITY & HARRITY LLP
11350 Random Hills Road
Suite 600
Fairfax, VA 22030

Practice Insights in the Wake of *Blackbird Tech LLC v. ELB Electronics, Inc.*

In *Blackbird Tech LLC v. ELB Electronics, Inc.* (Fed. Cir. July 16, 2018), the Federal Circuit found, with one judge dissenting, that the district court erred during claim construction by construing a claim limitation to include a requirement not included in the plain language of the claim, and not supported during the prosecution history.

The decision provides insight into how choices made during drafting and prosecution may affect claim construction, and provides insight into how issues of claim construction might be avoided.

The patent at issue (7,086,747) describes an energy efficient lighting apparatus designed to be retrofitted with an existing light fixture. At issue was claim construction regarding the meaning of “attachment surface,” and whether the attachment surface must be secured to a “ballast cover.” Specifically, claim 12 recites:

12. An energy-efficient lighting apparatus for retrofit with an existing light fixture having a ballast cover, comprising:
a housing having an attachment surface and an illumination surface;
a plurality of illumination surface holes in the illumination surface;
a circuit board comprising a plurality of light-emitting diodes, wherein the circuit board is positioned adjacent the housing so that the plurality of light-emitting diodes protrude through the plurality of illumination surface holes in the illumination surface; and
a fastening mechanism for securing the attachment surface of the lighting apparatus to the illumination surface, wherein the lighting apparatus is coupled to a wall switch and wherein the illumination of the light-emitting diodes is controllable based upon the position of the wall switch.

Blackbird argued that “attachment surface” should be construed as “layer of the housing to which the illumination surface is secured,” while ELB argued (and the district court agreed) that “attachment surface” should be construed as “layer of the housing that is secured to the ballast cover.”

In concluding that “claim 12 does not require the attachment surface to be secured to the ballast cover,” the Federal Circuit relied on the plain language of claim 12, stating that claim 12 “does not require the attachment surface be secured to anything other than the illumination surface.” The Court also pointed out that there was no suggestion (e.g., in the specification or during prosecution or litigation) indicating that the fastening mechanism securing the attachment surface to the ballast cover was an important feature of the claimed invention.

Interestingly, the Federal Circuit also noted that “possibly the most important reason why the fastener for connecting the attachment surface to the ballast cover disclosed in an embodiment ought not be imported into the claim is because that limitation was originally present in claim 12 and was expressly eliminated during prosecution.” During prosecution, an amendment made “to resolve 112 issues” deleted “ballast cover” and replaced it with “illumination surface.” The federal circuit concluded that “[n]o ordinary artisan could read the prosecution history as anything other than eliminating the requirement that a fastening mechanism secures the attachment surface to the ballast cover.”

In his dissent, Circuit Judge Reyna concluded “that the district court correctly construed ‘attachment surface’ to mean ‘layer of the housing that is secured to the ballast cover.’” In particular, Circuit Judge Reyna states:

The plain language of claim 12, read in the context of the specification, implicitly requires that the attachment surface be secured to the ballast cover to achieve the retrofit function. Apart from the preamble, which the parties agree is limiting, claim 12 contains no reference to the ballast cover, the existing light fixture, or where or how the apparatus is retrofit with the existing light fixture. Because the only feature of the existing light fixture described in claim 12 is the ballast cover, a person of ordinary skill would necessarily conclude that the attachment surface is secured to the ballast cover of the existing light fixture.

In addition to the plain language argument, Circuit Judge Reyna noted that “[e]very single embodiment of the retrofit lighting apparatus in the specification describes securing the attachment surface to the ballast cover of the existing light fixture.” He also cites a portion of the specification, which states that “[i]n typical operation, the attachment surface 530 is secured to the ballast cover,” to support his conclusion that the attachment surface should be read as being secured to the ballast cover.

Clearly, this case was not as clear cut as the plain language of claim 12 might have made it seem. However, the case does provide insight into how practitioners might draft and prosecute an application in a manner designed to avoid unfavorable claim construction.

For example, both the district court, and the dissenting Circuit Judge, felt that the specification did not make it clear that the attachment surface might not be secured to the ballast cover. In describing various components, a patent drafter might avoid similar issues by describing components as having multiple functions or capabilities, or avoiding describing a component as serving only one function.

In addition, the inclusion of “ballast cover” in the preamble of claim 12 was given weight in both the majority and dissenting opinions. During drafting, or prosecution, a practitioner might wish to avoid including (or amend to exclude), in the preamble of a claim, limitations, structure, or the like, which might be construed as being somehow tied into other claimed features.

Also, during prosecution, the elimination of claim features is clearly given weight in determining whether an eliminated feature might be required for patentability. Accordingly, rather than leaving in unnecessary claim features, it may be beneficial to remove claim features in a manner designed to pre-empt a claim construction that requires a claim feature that is actually not necessary for patentability.