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Federal Circuit In *Lighting Ballast* Confirms *De Novo* Claim Construction Standard of Review

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For the first time in over 8 years since the court's decision in *Phillips v. AWH Corp*., 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*), the full United States Court of Appeals for the Federal Circuit has issued an en banc decision on claim construction.

In *Lighting Ballast Control LLC v. Philips Elecs. N. Am. Corp.,* No. 2012-1014 (Fed. Cir. 2014) (*en banc*), a split Court, applying the principles of *stare decisis*, reconfirmed its prior standard from *Cybor Corp. v. FAS Technologies Inc.,* 138 F.3d 1448 (Fed. Cir. 1998) (*en banc*), holding that claim construction is a matter of law and shall be reviewed *de novo* by the appellate courts with no deference given to the district courts.

Judge Newman, writing for the six member majority, discusses the various positions taken by the extensive, thirty-eight amici curiae in twenty-one briefs.

1. The first position, shared by Lighting Ballast, is that claim construction is a matter of fact and the *Cybor* standard should be discarded. The majority finds this first view to be incorrect.
2. The second position, and one shared by the United States in their amicus brief, is that claim construction is matter of law but that factual aspects of claim construction are entitled to deferential review while the final construction receives *de novo* review. The majority finds this second view to also be incorrect.
3. The third position is that claim construction is a matter of law and that *Cybor* should be upheld. The majority finds this third view to be correct. According to the majority, "[t]he principles of *stare decisis* counsel against overturning precedent when there is no evidence of unworkability and no clearly better resolution." The majority writes, "we are not persuaded that discarding *de novo* review would produce a better or more reliable or more accurate or more just determination of patent claim scope." *Cybor* has been applied for over fifteen years and "[d]eferential review [of claim construction] does not promise either improved consistency or increased clarity."

Judge Lourie issued a concurring opinion in which he argued in favor of the *Cybor* standard on its merits.

Judge O'Malley, writing for the four dissenting Judges, argued for more deference: "District judges . . . and the majority of intellectual property lawyers and academics

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around the country will no doubt be surprised by today's majority opinion—and for good reason." The dissent argues that the majority "puts itself at odds with binding congressional and Supreme Court authority" by refusing to acknowledge that claim construction "at times requires district courts to resolve questions of fact." According to the dissent, the principles of *stare decisis* would not be an obstacle for the court to overturn *Cybor*.

We will continue to follow this development.

In the meantime, please feel free to contact our attorneys regarding issues raised by this case.

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