

Patent Drafting Reminders Gleaned from the July 16, 2018 Federal
Circuit Decision (Blackbird Tech. LLC v ELB Electronics Inc.).
by Adrian Lee

On July 16, 2018, the Federal Circuit published its precedential decision in Blackbird Tech LLC v. ELB Electronics.

Background: Blackbird brought an action for infringement against ELB electronics in the United States District Court for the District of Delaware. The patent claims at issue are directed towards an energy efficient lighting apparatus. The parties disputed the meaning of a claimed term “attachment surface.” Plaintiff Blackbird wanted a construction of this term as a “layer of the housing to which the illumination surface is secured.” However, the District Court construed the term as a “layer of the housing that is secured to the ballast cover.”

More specifically, though the plain language of the claim at issue recited a fastening mechanism for securing the attachment mechanism to the illumination surface, the District Court relied heavily on an embodiment described with respect to Figure 5 in the specification to infer that there was a second fastener for attaching the attachment surface to a ballast surface. This inference was the foundation for the District Court’s claim construction of the term “attachment surface.” Based on this construction, which was unfavorable to the Plaintiffs, the parties stipulated to non-infringement, and the District Court entered judgment in favor of the Defendants. The Plaintiffs appealed the unfavorable claim construction to the Federal Circuit.

In the July 16, 2018 decision, the Federal Circuit concluded that the District Court erred to interpret “attachment surface” as being secured to a ballast cover. The Federal Circuit looked to the plain meaning of the claim at issue, which recited “a fastening mechanism for securing the attachment surface to the illumination surface.” The Federal Circuit noted that there was no other fastening mechanism recited, nor is there any requirement that the attachment surface be secured to anything other than the illumination surface. The Federal Circuit noted that the District Court’s reliance on the embodiment of Figure 5 to read such a second fastening mechanism as being important was not founded.

Specifically, the Federal Circuit reasoned that the embodiment of Figure 5 describes that the “fastening may be achieved by ‘many different fastening mechanisms’ including ‘an adhesive strip’ (think tape) ‘a magnet, clips, screws, etc.’” Furthermore, the Federal Circuit reasoned

Patent Drafting Reminders Gleaned from the July 16, 2018 Federal
Circuit Decision (Blackbird Tech. LLC v ELB Electronics Inc.).

by Adrian Lee

that the fastener is never referred to “as the ‘present invention’ or ‘an essential element’ or uses any other language that would cause the ordinarily skilled artisan to believe that this fastening mechanism is an important component of the invention or that is critical to the invention for any reason.” Also, the Federal Circuit reasoned that the embodiment of Figure 5 is just described as “exemplary” and “non-limiting.” See Page 6. The Federal Circuit reasoned that “without any evidence that [such a second and unclaimed] fastener is important, essential, or critical to the invention, it should not be read in as a claim limitation.”

The Federal Circuit’s reasoning is very important to consider when drafting patent specifications. First, the reasoning underscores the importance of including alternative embodiments in the specification. Even the description of alternatives for seemingly unimportant components (like fasteners) can lead to broader claim construction. Second, when describing embodiments, it is important to couch the embodiments in non-limiting terms. Use of phrase such as “As an example only”, “example embodiment”, “for illustrative purposes only”, “it is not important which”, and so forth, help to broaden claim construction. In addition, it is important to avoid terms such as “the invention is”, or “it is essential that” or “needs to be” or any other language that an ordinary artisan would deem as describing that a particular element is required. Generally stated, when drafting a patent application, a practitioner should constantly question whether the words being selected could be deemed by an ordinary artisan to mean that a particular component is important or essential to the practice of the invention, especially where that is not the case.