

Claims Not Limited to Unrecited Aspect Unless the Intrinsic Record Shows Criticality

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Addressing the construction of a claim directed to an energy-efficient lighting device, the US Court of Appeals for the Federal Circuit overturned a narrow district court construction that limited the claims to an unrecited feature described in the specification in favor of a broader construction. *Blackbird Tech LLC v. ELB Electronics, Inc.*, Case No. 2017-1703 (Fed. Cir. July 16, 2018) (Moore, J) (Reyna, J, dissenting). The Federal Circuit found that the district court improperly limited the claims to a feature not characterized as being the invention itself or an essential element of it.

Blackbird sued ELB Electronics for infringement of a patent directed to a device used to retrofit an existing lighting fixture. In the patent specification, the device is described as having an attachment surface so that it can be installed onto a ballast cover of an existing lighting fixture. The preamble of the claim at issue calls for a lighting apparatus for retrofitting an existing light fixture, and the body of the claim recites a housing with an attachment surface and an illumination surface. The district court interpreted the claimed attachment surface to be a layer of the housing that is secured to the ballast cover. In response, Blackbird stipulated to non-infringement in order to appeal the district court's claim construction.

On appeal, the Federal Circuit reversed. The Court first noted that the claim language did not expressly require the attachment surface to be secured to the ballast cover. The Court pointed to a separate claim limitation requiring the attachment and illumination surfaces to be fastened to each other and contrasted that explicit recitation with the lack of any such recitation regarding fastening to a ballast cover. The Court next looked to the intrinsic record for anything that would merit reading such a requirement into the claims. While the specification described fastening the attachment surface to the ballast cover, it did not refer to the particular fastening approach as being the invention or an essential element, or use any other language that treated this aspect as critical to the invention. Finally, the Federal Circuit found it notable that the claim had previously recited a fastening mechanism for securing the attachment surface to the ballast cover but that recitation was later removed by amendment. The Court thus construed attachment surface to be a layer of the housing to which the illumination surface is secured, which mirrors the separate claim limitation calling for a fastening mechanism that secured those two surfaces together.

Judge Reyna dissented based on the preamble language reciting the purpose of the device being to retrofit an existing light fixture having a ballast cover. According to Judge Reyna, the claim implicitly

required the attachment surface to be secured to the ballast cover so that the claim scope would be appropriately confined to the disclosed invention.

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