

BU Loses Bid To Reinstate \$14M LED Patent Win

By [Mike LaSusa](#)

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Law360 (July 18, 2019, 10:40 PM EDT) -- A Massachusetts federal judge on Thursday shut down Boston University's bid to reinstate a \$14 million patent infringement verdict against three LED manufacturers that was overturned by the Federal Circuit last year.

U.S. District Judge Patti B. Saris cited "several" reasons for rejecting the university's request to undo the Federal Circuit ruling in the case over U.S. Patent No. [5,686,738](#), which covers a certain way of growing layers on a semiconductor, in this case an LED.

Judge Saris said the university had asked for the court to overturn the decision based on a federal court rule meant to correct "a clerical mistake" or other "mistake arising from oversight or omission."

"But this is not a simple clerical mistake in the judgment," the judge said. "Plaintiff is asking the court to re-interpret the trial record in a way that would have significant ramifications for the substantive rights of the parties."

Moreover, she said, Boston University's bid is "foreclosed by the 'mandate rule' which governs the court's authority to take further actions following an appellate disposition."

Judge Saris mostly granted a request to rescind an earlier award of attorney fees against the companies, Taiwan-based Epistar Corp. and its customers Everlight Electronics Co. Ltd. and Lite-On Inc. After the Federal Circuit's ruling, the LED makers are the "prevailing parties," the judge said, though she did award some attorney fees to the university that were related to alleged misrepresentations by Everlight.

Jeffrey T. Lindgren of [Vasquez Benisek & Lindgren LLP](#), who represents the companies, told Law360 on Thursday that his clients are "happy" with the ruling.

"We're pleased that the judge recognized that there is no basis to overturn the Federal Circuit's determination that the patent claim that was taken to trial was invalid as a matter of law," he said.

Counsel for the university declined to comment on Thursday.

BU first sued in December 2012, accusing Epistar, Everlight and Light-On in Massachusetts federal court of infringing the '738 patent. The three faced a joint trial in 2015, which ended with a jury returning a [\\$13.7 million verdict](#) in favor of the university alongside its willful infringement finding.

But the Federal Circuit reversed the jury's finding, saying that the claim in Boston University's patent that the companies allegedly infringed describes something physically impossible, making it ineligible for patent protection.

Specifically, the claim in the '738 patent describes growing a monocrystalline layer directly on an amorphous layer, or in layman's terms, growing a single-crystalline structure onto a noncrystal region, using a process called epitaxy, the opinion said. That process involves depositing molecules of the semiconductor material onto the noncrystal surface, which then try to copy the underlying crystal lattice structure as they grow, the court wrote.

But experts for Taiwan-based Epistar Corp. and its customers Everlight Electronics Co. Ltd. and Lite-On Inc. testified that growing a monocrystalline film directly on an amorphous structure epitaxially is impossible, and BU's expert agreed, the Federal Circuit said.

"We can now safely conclude that the specification does not enable what the experts agree is physically impossible," Circuit Judge Sharon Prost wrote for the panel.

BU argued that the patent also covers doing this in ways to create a direct layer other than epitaxy, but the panel disagreed, finding the university was unable to back up its argument.

The patent-in-suit is U.S. Patent Number 5,686,738.

The university was represented as recently as April by Erik Paul Belt of [McCarter & English LLP](#), and Michael W. Shore, Alfonso Garcia Chan and Christopher L. Evans of [Shore Chan DePumpo LLP](#).

The companies were represented as recently as January by Richard C. Vasquez, Jeffrey T. Lindgren and Eric W. Benisek of Vasquez Benisek & Lindgren LLP, and Susan G.L. Glovsky of [Hamilton Brook Smith Reynolds](#).

The consolidated case is Trustees of Boston University v. Everlight Electronics Co. Ltd. et al, case number [1:12-cv-11935](#), in the [U.S. District Court for the District of Massachusetts](#).

--Additional reporting by Dani Kass. Editing by Emily Kokoll.

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Case Information

Case Title

[Trustees of Boston University v. Everlight Electronics Co., Ltd. et al](#)

Case Number

[1:12-cv-11935](#)

Court

[Massachusetts](#)

Nature of Suit

[Patent](#)

Judge

[Patti B. Saris](#)

Date Filed

[October 17, 2012](#)

Law Firms

[Hamilton Brook](#)

[McCarter & English](#)

[Shore Chan](#)

[Vasquez Benisek](#)

Government Agencies

[U.S. District Court for the District of Massachusetts](#)

Patents

[5,686,738 - Highly insulating monocrystalline gallium nitride thin films](#)

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