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Fed. Circ. Nixes Boston University's \$14M LED Patent Win

By **Dani Kass**

Law360 (July 25, 2018, 8:21 PM EDT) -- The Federal Circuit overturned a nearly \$14 million infringement verdict against three LED manufacturers on Wednesday, finding that the claim in Boston University's patent that they allegedly infringed describes something physically impossible, making it ineligible for patent protection.

The claim-at-issue in U.S. Patent Number 5,686,738, which covers a certain way of growing layers on a semiconductor — in this case an LED — doesn't meet enablement requirements, the three-judge panel said. Someone reading the patent would have to rely on "undue experimentation" to create the described layer, and the companies successfully proved that actually reaching the desired effect would be "impossible," the court wrote.

More 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.

"[BU] cites conclusory or unresponsive expert testimony and evidence that some persons were able to grow a monocrystalline layer directly on an amorphous layer — years after the patent's effective filing date, via methods BU does not suggest were taught by the specification or otherwise within an ordinary artisan's skill as of that filing date," the panel said.

The panel finished its opinion by saying that, "to some extent, BU created its own enablement problem," by not adequately describing the process it was patenting, which is "part of the quid pro quo of the patent bargain."

BU first sued in December 2012, accusing Epistar, Everlight and Light-On in Massachusetts federal court of infringing the 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.

"Epistar, Everlight and Lite-On have been resolute that they would be vindicated by the U.S. courts in the end," said Richard C. Vasquez of Vasquez Benisek & Lindgren LLP, who argued for the defendants. "Today's decision that the asserted patent is invalid has justified their faith."

Counsel for BU didn't immediately respond to a request for comment Wednesday.

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

Circuit Judges Sharon Prost, Kimberly Ann Moore and Jimmie V. Reyna sat on the panel for the Federal Circuit.

BU is represented by Edward R. Reines of Weil Gotshal & Manges LLP; Erik Paul Belt of McCarter & English LLP; and Alfonso Chan, Russell J. DePalma, Christopher Liimatainen Evans and Michael W. Shore of Shore Chan DePumpo LLP.

Everlight and Lite-On are represented by Kevin Russell, Charles Hardy Davis and Thomas Goldstein of Goldstein & Russell PC. Epistar is represented by Richard C. Vasquez, Eric W. Benisek, Jeffrey T. Lindgren and Robert McArthur of Vasquez Benisek & Lindgren LLP.

The case is Trustees of Boston University v. Everlight Electronics Co., case numbers 16-2576, 16-2577, 16-2578, 16-2579, 16-2580, 16-2581, 16-2582, 16-2591, 16-2592, 16-2593, 16-2594 and 16-2595, all in the U.S. Court of Appeals for the Federal Circuit.

--Editing by Alyssa Miller.

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