United States District Court,
N.D. Illinois, Eastern Division.

GILSON BROTHERS COMPANY,
Plaintiff.
v.
COTTER & COMPANY,
Defendant.

Jan. 13, 1987.

As Amended Nov. 25, 1987.

MEMORANDUM OPINION

GRADY, District Judge.

Plaintiff Gilson Brothers Company ("Gilson") alleges in this suit that defendant Cotter & Company ("Cotter") has infringed Gilson's patent on a cylindrical snowblower auger. Cotter asserts that Gilson is bound in its claims by "file wrapper estoppel" in that Gilson's patent was granted after it amended its claims to stress the "removable" or "releasable" nature of its auger. We asked the parties for memoranda on the relevant legal standards in applying file wrapper estoppel, and we file this opinion to indicate what standards we will apply and to guide the parties in further discovery.

FACTS

Gilson, the assignee of the patent, claims that the auger manufactured by Cotter literally infringes its patent. The device in question is a cylindrical auger, comprised of two stamped metal plates. Rubber flights clamped between these plates form auger flights and auger paddles, which are attached to impeller blades that throw the snow as the auger turns. U.S. Patent No. 4,203,237 (May 20, 1980), at 1. Gilson states that the "unique combination" of the stamped plates and rubber flights produce an auger of superior performance and efficiency which can be manufactured less expensively than "prior art" snowblower augers. Plaintiffs Memorandum at 2. Gilson argues that Cotter's auger construction is a literal infringement of the patent in suit. Id. at 4.

The only difference between the augers of Cotter and Gilson that has been brought to our attention is that the flights and blades of Cotter's auger are attached by "blind rivets," whereas Gilson's uses nuts and bolts. Defendants Memorandum at 2. Cotter maintains that this difference precludes a finding of literal infringement because the pop rivets are not releasable in the same way as nuts and bolts, and that Gilson must therefore rely on the "doctrine of equivalents" to establish an infringement by Cotter. Id. at 3. Under that doctrine, Cotter asserts, Gilson cannot make a successful infringement claim as "file wrapper" or "prosecution history" estoppel prevents Gilson from attempting to broaden the scope of the patent claims that it narrowed in making amendments to secure the patent. This argument is similar to the literal infringement defense in that Cotter relies on Gilson's amendments which point up the "releasable" and "removable" nature of the auger. Cotter states that "plaintiff is not now entitled to recoup what it gave up to

include other attachment means, i.e., 'blind rivets', that are not releasable or removable within the context of the patent specification ...." Id. at 11.

We will outline the procedural framework that governs this case and set forth the standards that apply at the various steps.

Literal Infringement

Literal infringement requires that the accused device embody each element of the patent claims as properly interpreted. Mannesmann Demag Corp. v. Engineered Metal Products Co., Inc., 793 F.2d 1279, 1282 (Fed. Cir. 1985). File wrapper estoppel is not a defense to literal infringement claims, Fromson v. Advance Offset Plate Inc., 720 F.2d 1565, 1571 (Fed. Cir. 1983), and we must therefore decide the issue of literal infringement before reaching the question of file wrapper estoppel. Hughes Aircraft Co. v. United States, 717 F.2d 1351, 1361 (Fed. Cir. 1983). However, the file wrapper or prosecution history "is properly considered in evaluating the scope of [Gilson's claims] for the purposes of determining literal infringement." Glaros v. A.H. Robertson Co., 615 F. Supp. 186, 192 (N.D. Ill. 1985); see also McGill, Inc. v. John Zink Co., 736 F.2d 666, 675 (Fed. Cir.), cert. denied, 469 U.S. 1037 (1984). As a result, we may consult the file wrapper to ascertain the true meaning of disputed language in the patent claims. Loctite Corp. v. Ultraseal, Inc., 781 F.2d 861, 867 (Fed. Cir. 1985).

The ultimate determination of the existence of literal infringement is one of fact, although the interpretation of the claims is a legal issue. Martin v. Barber, 755 F.2d 1564, 1566-67 (Fed. Cir. 1985). It is Gilson's burden to prove that Cotter's auger embodies every element of the patent claims. Mannesmann, 793 F.2d at 1282. Gilson argues that there is no limitation in its patent claims stating that nuts and bolts must be used to secure the auger, only that there be a "means for releasably clamping" the auger flights to the cylinder. Plaintiffs Memorandum Appendix A at column 6 (Patent Claim 5).

Obviously, if the pop rivets used in Cotter's auger do not "releasably clamp" the auger to the flights, there can be no finding of literal infringement.

The determination will depend on the interpretation of the language "releasable" and "removable" in Gilson's patent claims. As we may consult the prosecution history to arrive at that interpretation, we note that in Gilson's "Remarks" at the end of the first set of amended claims, it states, "Another of the advantages of auger construction is that it permits convenient disassembly of the auger halves and replacement of the blades. By merely removing the bolts holding the auger halves together, the auger flights and impeller blades can be removed and replaced." Defendants Memorandum, Appendix C at 6-7.

If the facts show that Cotter's "pop rivets" do not permit "convenient disassembly" of the mechanism, the Cotter device will not embody Gilson's claim for a "releasably clamped" auger as defined by the prosecution history. In that case, summary judgment for Cotter on the issue of literal infringement would be appropriate.

Doctrine of Equivalents-File Wrapper Estoppel

If there is no literal infringement, the inquiry will then shift to whether Cotter's auger infringes the patent under the doctrine of equivalents.

Designed to protect a patentee from an infringer who appropriates the invention but avoids the literal

language of the claims, the doctrine of equivalents allows a finding of infringement when the accused device and the claimed invention perform substantially the same function in substantially the same way to yield substantially the same result. Graver Tank & Mfg. Co. v. Linde Air Products, Co., 339 U.S. 605, 608 (1950).

Martin, 755 F.2d at 1567.

File wrapper estoppel prevents a patentee from seeking a broad interpretation of his claim in an attempt to recapture through equivalence certain coverage given up during the prosecution. In the instant case, Gilson's original claims made no mention of the "removable" feature of the auger. The examiner denied those claims, citing prior art. Defendants Memorandum, Appendices A-B. The first set of amended claims added the removable feature, and although the patent was again rejected on prior art, four of the amended claims pertaining to the "removable" aspects of the auger were deemed allowable. Plaintiffs Memorandum, Appendices D-E (Claims, 18, 19, 32, 33). The patent was eventually granted after Gilson submitted a second amended set of claims which emphasized the "stamped plate" construction of the auger. Id., Appendix F at 8.

File wrapper estoppel may certainly apply in this case to limit Gilson's potential to argue that "removability" is not an essential feature of the patented device. However, the ultimate question of fact under the doctrine of equivalents, whether Cotter's auger substantially matches Gilson's under the "function, way, result" test of Graver Tank, again comes down to a comparison of the characteristics of pop rivets as opposed to nuts and bolts. It will have to be determined whether pop rivets serve "substantially" the same purpose-providing removable auger flights-as do nuts and bolts.

Cotter states that it "intends to prove that a pop rivet indeed is not equivalent to a nut and bolt, because it is not removable in the sense of the patent and constitutes a semi-permanent fixture." Defendants Reply at 11. A motion for summary judgment might provide an appropriate mechanism for the determination of this pivotal question, as we think removability of the auger is the dispositive factual question in both the literal infringement and doctrine of equivalents analyses. Prosecution history plays a role in both inquiries-it aids interpretation of the claims on the literal infringement issue and may create estoppel against Gilson on the scope of his claims under the doctrine of equivalents.

CONCLUSION

The parties should continue discovery on the issue of the removability of pop rivets in comparison with nuts and bolts, and we invite either party to move for summary judgment pursuant to this opinion at such time that it feels it has adequate proof in support of such a motion under Federal Rule of Civil Procedure 56.

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