United States District Court,
D. Puerto Rico.

INDUSTRIAS METALICAS MARVA,
INC. Plaintiff.
v.
Empresas LAUSELL Defendan,
Empresas LAUSELL Defendant.

No. 96-1697 (JP)

Aug. 28, 1997.

Marcos A. Ramirez Lavandero, San Juan, P.R., for Plaintiff.

Steven C. Lausell-Stewart, Jimenez, Graffam & Lausell, San Juan, P.R., for Defendant.

OPINION AND ORDER

PIERAS**, Senior District J.**

I. INTRODUCTION AND BACKGROUND

The Court has before it the Defendant's Motion for Summary Judgment (docket No. 26) and Second Motion for Summary Judgment (docket No. 43) and the Plaintiff's respective oppositions. The Plaintiff, Industrias Metalicas Marva, Inc. ("Marva"), brings this action for patent infringement alleging that the Super Guard 2000 ("SG 2000") jalousie window FN1 produced and sold since 1991 by the Defendant, Lausell Aluminum Jalousies, Inc. ("Lausell"), infringes on Plaintiff's patent. The patent at issue, United States Patent Number 4,481,734, also known as the Vaida patent, encompasses one independent and eight dependent claims, of which the following are the most relevant to the motions at bar:

FN1. The parties informed the Court that a jalousie window is one incorporating a system of louvers as a barrier between the exterior and interior of the edifice in which the window is placed.

1. A louver assembly comprising: a frame including vertical side jambs, a head, a sill and a central opening; a plurality of vertically-spaced, substantially-straight horizontal louver members extending longitudinally across said central opening between said side jambs, each of said louver members including a closing section and an actuating section, and each of said closing sections including upper and lower longitudinal edges; means for pivotally mounting each of said louver members on said side jamb about respective pivot axes; actuating means attached to the actuating section of each of said louver members for pivoting said louver members between open and closed position, the lower longitudinal edge of an upper louver member overlaps the pivot axis of the adjacent lower louver member so that the upper and lower longitudinal edges of the closing section of said louver members are completely supported along their longitudinal lengths by said pivot axis at the upper longitudinal edge thereof and by the pivot axis of the adjacent lower louver member at the lower longitudinal edge thereof; in said closed position, each of said actuated sections form a trough which receives any fluid which penetrates said louver assembly;
3. A louver assembly in accordance with claim 1 wherein each of said actuated sections are constructed to

form a trough when in said closed position which causes any fluid which penetrates said louver members to flow away from said louver assembly, said trough formed between the actuating section of one louver member and closing section of an adjacent louver member.

4. A louver assembly in accordance with claim 1 wherein each of said pivot axes includes reinforcing means.

5. A louver assembly in accordance with claim 4 wherein said reinforcing means of the pivot axis of each of said louver members includes a steel reinforcing member.

6. A louver assembly in accordance with claim 4 wherein said reinforcing means of the pivot axis of each of said louver members includes a reinforcing bead member.

7. A louver assembly in accordance with claim 6 wherein said reinforcing bead member is hollow for receiving supporting rivets at each end thereof for supporting said louver member on said vertical side jambs.

The Defendant now argues that no reasonable jury could find that the SG 2000 incorporates, either literally or under the Doctrine of Equivalents, Claims Three and/or Four of the Vaida patent. The Plaintiff disagrees, maintaining that the SG 2000 infringes both literally and under the Doctrine of Equivalents. Both parties have supported their contentions with documentary evidence including the Vaida patent documents, the prosecution history, mechanical drawings of the SG 2000, and sworn statements. The Court also requested and received from the Plaintiff the patent documents covering the relevant prior art and a physical exemplar of the Vaida patent FN2 and from the Defendant a physical exemplar of the SG 2000.
FN2. Of the evidence submitted by the parties, objections have been raised only as to the Plaintiff's physical specimen and the Defendant's expert evidence proffered retrospectively in its Third Motion for Summary Judgment. Comparing the physical specimen submitted by the Plaintiff as an exemplification of the Vaida patent with the Vaida patent drawings reveals that the physical specimen is not an exact embodiment of the Vaida patent. For example, the weatherstrips in the drawings are attached to the inside of lower edge of the closing sections, while on the physical specimen, the weather strip is attached to the upper edge of the closing sections, where the closing sections meet the actuating sections. Other differences abound, and the Court has utilized the Plaintiff's physical specimen in a very limited evidentiary manner. The Court has not considered the Defendant's proffered expert affidavits, so the Plaintiff's concerns about that matter have not been realized.

II. SUMMARY JUDGMENT

Rule 56(c) of the Federal Rules of Civil Procedure provides:

"[Summary judgment] shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law."

The purpose of summary judgment is "to pierce the pleadings and to assess the proof in order to see whether there is a genuine need for a trial." Garside v. Osco Drug, Inc., 895 F.2d 46, 50 (1st Cir.1990). To make this determination, the Court must cull the record for genuine disputes of material fact, drawing all reasonable inferences in favor of the party against whom summary judgment is sought. *See* Kennedy v. Josephthal & Co., 814 F.2d 798, 804 (1st Cir.1987). "Material means that a contested fact has the potential to change the outcome of the suit under the governing law if the dispute over it is resolved favorable to the nonmovant." McCarthy v. Northwest Airlines, Inc., 56 F.3d 313, 315 (1st Cir.1996). "A dispute is genuine if the parties' positions on the issue are supported by conflicting evidence." Int'l Ass'n of Machinists and Aerospace

Workers v. Winship Green Nursing Ctr., 103 F.3d 196, 200 (1st Cir.1996). If there are material factual disputes, summary judgment is inappropriate. If there are no disputed issues of material fact, the court proceeds to search the undisputed facts in an effort to discern whether the moving party has shown that it is entitled to judgment as a matter of law. Celotex Corp. v. Catrett, 477 U.S. 317, 324, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986).

The movant bears the initial burden of "informing the district court of the basis for its motion, and identifying those portions of the [record] which it believes demonstrate the absence of a genuine issue of material fact." *Id*. at 323. Where the issue on which the movant seeks summary judgment would be one for the jury at trial, the movant will be entitled to summary judgment if, given the undisputed facts, no reasonable jury could find that the party bearing the burden of persuasion at trial has either established or failed to establish all required elements, depending on whether the movant bears the burden at trial. *Id.,* at 331 (Brennan J., dissenting on other grounds). Here, the Defendant asserts bases for its motion for which it and the Plaintiff would bear the burden of persuasion at trial. Where the moving party does not bear the burden of proof at trial, it must show "that there is an absence of evidence to support the non-moving party's case." *Id.,* at 325. In other words, when the moving party does not bear the burden of persuasion, it must establish that no reasonable fact finder could find that the non-movant has established the requisite elements of its claim. On the other hand, "where the moving party will bear the burden of persuasion at trial, that party must support its motion with credible evidence ... that would entitle it to a directed verdict if not controverted at trial." Winnacunnet Coop. Sch. Dist. v. Nat'l Union Fire Ins. Co., 84 F.3d 32, 35 (1st Cir.1996) (quoting Celotex, 477 U.S. at 331 (Brennan, J., dissenting)).

Where the moving party has met its initial burden of production, the burden shifts to the non-moving party to show that some triable issue, whether factual or legal, remains unresolved. Celotex, 477 U.S. at 324. If it succeeds, the motion must be denied; if it does not, the motion will be granted.

When faced with a motion for summary judgment, the Court may consider "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any." Fed.R.Civ.P. 56(c). "In addition, a court may take into account any material that would be admissible or usable at trial ... [but] inadmissible evidence may not be considered." Horta v. Sullivan, 4 F.3d 2, 8 (1st Cir.1993). Moreover, "mere allegations, or conjecture unsupported in the record, are insufficient to raise a genuine issue of material fact." *Id*. (citing August v. Offices Unlimited, Inc., 981 F.2d 576, 580 (1st Cir.1992)); *accord* Medina-Munoz v. R.J. Reynolds Tobacco Co., 896 F.2d 5, 8 (1st Cir.1990) (a court need not credit "conclusory allegations, improbable inferences, and unsupported speculation"); Int'l Ass'n of Machinists and Aerospace Workers, 103 F.3d at 200 ("defeating a properly documented motion for summary judgment requires more than the jingoistic brandishing of a cardboard sword.")

III. ANALYSIS

For the purposes of the Defendant's summary judgment motions, no historical facts are in dispute. The ultimate issue before the Court is whether a reasonable jury could find from the evidence that the SG 2000 infringes, either literally or under the Doctrine of Equivalents, upon the Vaida patent.

The Defendant's first Motion for Summary Judgment focuses on the language in Claim One (upon which Claim Four depends) of the Vaida patent, describing the "lower longitudinal edge of an upper louver member [as] overlap[ping] the pivot axis of the adjacent lower louver member so that the ... lower longitudinal edges of the closing section of said louver members are completely supported along their longitudinal lengths by said pivot axis." Citing this language, the Defendant then points to its SG 2000, asserting that the lower edges of its louvers do not overlap the pivot axes of adjacent lower louvers, and that the SG 2000 therefore does not infringe on the Vaida patent. There is no doubt that the lower edges of louver members on the SG 2000 overlap the louver members below them, but under the definition of "pivot axis" that Lausell urges, the lower edges do not overlap the pivot axes as described in the Vaida patent.

Marva counters by entreating the Court to construct the phrase "pivot axis" as used in the Vaida patent to include the apparatus housing the pivot axis. Using this definition of "pivot axis," Marva argues that the SG 2000's louver members overlap part of the structure that contains and comprises the pivot axis of lower adjacent louver members. Therefore, under Marva's more expansive definition of "pivot axis," the SG 2000 incorporates the design spelled out by Claim Four of the Vaida patent.

With respect to equivalent infringement, the Defendant's first Motion for Summary Judgment asserts that the range of equivalents urged by Marva would incorporate the prior art. All jalousie window assemblies are designed so that the louvers overlap, because "otherwise horizontal openings would remain in the louver assembly in the closed position." To distinguish itself from the prior art, the Vaida patent averred that the prior art did "not disclose mounting means for pivotally mounting the louver members, such that wind-load conditions operate to close the louver members more tightly, rather than permitting them to open more easily, and [did] not disclose means for providing complete support against opening for each louver member at its upper and lower edges." Lausell argues that the structural "breakthrough" that, according to the Vaida patent itself, separates it from the prior art is not merely that the louvers overlap, but that they overlap the pivot axes or adjacent louvers. Lausell concludes that the holder of the Vaida patent cannot now argue that incorporation of a feature that was present in the prior art renders the SG 2000 equivalent to the Vaida patent. In addition, Lausell asserts that the SG 2000 does not meet the "way" prong of the "function-way-results" test for equivalency.

Marva counters that, because the lower longitudinal edge of the SG 2000 is supported by the "pivot axis structure" (as opposed to the pivot axis itself), "it provides substantially the same function, operates in the same way and delivers substantially the same result as the construction described and claimed by the patent." Therefore, Marva argues, the SG 2000 infringes under the Doctrine of Equivalents.

The Defendant's Second Motion for Summary Judgment focuses on the language of Claim One (upon which Claim Three depends) describing the formation of a "trough formed between the actuating section of one louver member and closing section of an adjacent louver member" that collects any fluid that enters the window structure and draws the collected fluid away from the louver assembly. The Defendant asserts that its SG 2000 does not even utilize actuating sections, and therefore cannot contain a trough formed between actuating and closing sections. Moreover, the Defendant argues that its SG 2000 contains no other element that functions as a trough.

The Plaintiff rejects the Defendant's assertions, arguing that the SG 2000's louvers do cooperate to form troughs that collect water penetrating the window. Specifically, the Plaintiff points to a space above the weather stripping that forms the seal between adjacent louver members in the closed position, and asserts that space literally constitutes a trough as described by the Vaida patent.

With respect to equivalent infringement, the Defendant's Second Motion for Summary Judgment points to the prosecution history of the Vaida patent and the prior art, and asserts that any coincidental creation of a trough by the overlapping of adjacent louver members should not constitute equivalence, because all louver window assemblies utilize overlapping louvers. The Plaintiff summarily denies the merits of this contention, apparently relying on the Court to determine the flaw in the Defendant's argument, and provides no analysis of that denial.

The Defendant's motions each focus on a single element of the Vaida patent. Each element is embodied in the only independent claim and refined in one or more dependent claims. We need only address the independent claim, for "it is axiomatic that dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed." Wolverine World Wide, Inc. v. Nike, Inc., 38 F.3d 1192, 1199 (Fed.Cir.1994) (quoting Wahpeton Canvas Co. v. Frontier, Inc., 870 F.2d 1546, 1553 (Fed.Cir.1989)). Moreover, in order for a product to infringe a patent claim, it must embody every

element of that claim. Cole v. Kimberly-Clark Corp., 102 F.3d 524, 532 (Fed.Cir.1997), *petition for cert. filed,* 65 U.S.L.W. 3799 (May 19, 1997) (No. 96-1858). Therefore, if the Court finds that no reasonable jury could conclude that the SG 2000 contains either of the two particular elements addressed in the motions at bar, then no reasonable jury could find infringement and judgment must be granted. The Court will analyze each of the Defendant's motions separately.FN3

FN3. When the Court is addressing the first motion, regarding the Vaida pivot axis, reference to exhibits is directed to exhibits appended to the Defendant's Motion for Summary Judgement or the Plaintiff's Opposition thereto, and when addressing the second motion, regarding the trough, reference to exhibits is directed to those appended to the Defendant's Second Motion for Summary Judgment or the Plaintiff's Opposition thereto.

A. DEFENDANT'S FIRST MOTION: THE PIVOT AXIS

1. Literal Infringement

A literal patent infringement analysis involves two steps: (1) the proper construction of the asserted claim and (2) a determination as to whether the accused method or product infringes the asserted claim as properly construed. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.) (citing Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd* 517 U.S.-, 134 L.Ed.2d 577 (1996)). At trial, the court bears responsibility for the first step-determining the patent scope. Markman v. Westview Instruments, Inc., 517 U.S. 370, ----, 116 S.Ct. 1384, 134 L.Ed.2d 577, 581 (1996). The jury is charged with carrying out the second step-determining infringement. Winans v.. Denmead, 56 U.S. (15 How.) 330, 338, 14 L.Ed. 717 (1853). This methodology was described precisely in *Winans:*

"[In a patent infringement trial,] two questions arise. The first is, what is the thing patented; the second, has that thing been constructed, used or sold by the defendants. The first is a question of law, to be determined by the court, construing the letters patent, and the description of the invention and specification of claim annexed to them. The second is a question of fact, to be submitted to a jury."

Id. If, after determining the patent's scope, the Court determines that no reasonable jury faced with the evidence before the Court could determine that the Defendant's SG 2000 infringes upon the Vaida patent, the Court must enter judgment for Lausell. Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., --- U.S. ----, ---- n. 8, 117 S.Ct. 1040, 1053 n. 8, 137 L.Ed.2d 146 (1997).

a. The Scope of the Vaida Patent

"In determining the proper construction of a claim, the court has numerous sources that it may properly utilize for guidance ... including both intrinsic and extrinsic evidence." Vitronics, 90 F.3d at 1582. In the first instance, however, the court must turn to "the patent itself,FN4 including the claims, the specification and, if in evidence, the prosecution history," which constitute "the most significant source of the legally operative meaning of disputed claim language." *Id*.

FN4. A patent document contains several components "describing the exact scope of an invention and its manufacture." *Markman,* 134 L.Ed. at 581. The first patent element is the specification, "describing the invention 'in such full clear concise and exact terms as to enable any person skilled in the art to make and use the same." ' *Id*. (quoting 35 U.S.C. s. 112). "Second, a patent includes one or more 'claims,' which 'particularly point out and distinctly claim the subject matter which the applicant regards as his invention." ' *Id*. (quoting 35 U.S.C. s. 112).

"First, we look to the words of the claims themselves, both asserted and nonasserted, to define the scope of

the patented invention." *Id*. Second, we must look at the specification "to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." FN5 *Id*. In other words, the specification serves "as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication." *Id*. (citing *Markman,* 52 F.2d at 979). The specification is "highly relevant to the claim construction analysis ... it is [usually] dispositive; it is the single best guide to the meaning of a disputed term." *Id*.

FN5. In looking at the patent language, the Court will assign each word its plain meaning, unless the patentee has chosen "to be his own lexicographer and [to] use terms in a manner other than their ordinary meaning, [provided that] the special definition of the term is clearly stated in the patent specification or file history." Vitronics, 90 F.3d at 1582.

Third, the court may consider the prosecution history, if it is in evidence. *Id*. The prosecution history may be significant where interpretations were disclaimed during prosecution, because interpretations that were disclaimed during prosecution may not be claimed during a later infringement action. *Id.; cf. also* Warner-Jenkinson, --- U.S. at ---- - ----, 117 S.Ct. at 1049-1051. In addition, the "prior art cited in the file wrapper gives clues as to what the claims do not cover." Autogiro Co. of America v. United States, 181 Ct.Cl. 55, 384 F.2d 391, 399 (Ct.Cl.1967). "Prosecution history is especially important when the invention involves a crowded art field, or when there is particular prior art that the applicant is trying to distinguish." Lemelson v. General Mills, Inc., 968 F.2d 1202, 1206 (Fed.Cir.1992). Where the intrinsic evidence found in the patent itself and in the prosecution history resolves any ambiguity in a disputed claim term, no other evidence should be consulted. Vitronics, 90 F.3d at 1583.

The Vaida patent consists of nine claims, only one of which is independent. The particular aspect of the Vaida patent at issue in the Defendant's first Motion for Summary Judgment is the reinforcement of the lower edge of each louver member by the "pivot axis" of the adjacent lower member. In large measure, the determination of infringement in this case turns on the scope afforded the phrase "pivot axis." The Plaintiff would have the Court endow the phrase with broad meaning to incorporate any structure that "houses" the pivot axis, while the Defendant urges a definition that limits the phrase to its technical definition.

The language of the claim is plainly understood. The claim describes the manner in which the device provides continuous longitudinal support for the upper and lower edges of each louver member:

actuating means attached to the actuating section of each of said louver members for pivoting said louver members between open and closed positions, so that in said closed position, the lower longitudinal edge of an upper louver member overlaps the pivot axis of the adjacent lower louver member so that the upper and lower longitudinal edges of the closing section of said louver members are completely supported along their longitudinal lengths *by said pivot axis at the upper longitudinal edge thereof and by the pivot axis of the adjacent lower louver member at the lower longitudinal edge thereof.*

Vaida Patent, p. 6. lines 29-40, Plaintiff's Exhibit 1 (emphasis added). The patent clearly contemplates the use of the "pivot axis" as the means for supporting the longitudinal edges of the louver members. *Cf*. Cole, 102 F.3d at 531 (refusing to invoke "means-plus" statute, 35 U.S.C. s. 112 para. 6 (1994), when the patent explicitly states the structure performing the function). The word "pivot" has meanings as a verb, a noun, and an adjective. As a noun, a pivot is a "shaft or pin whose pointed end forms the fulcrum and center on which something turns about, oscillates, or balances." Webster's Third New International Dictionary (Unabridged) 1726 (1981). As a verb, to pivot is "to turn about or oscillate or balance on or as if on a pivot." *Id*. at 1727. As an adjective, as in the Vaida patent language, the word "pivot" is used to describe something as "turning on or as if on a pivot." *Id*. An axis is "a straight line about which a body or a 3-dimensional figure rotates." *Id*. at 153. In this sense, the axis is an imaginary geometrical reference line, described by all points in three dimensional space dependent on a single independent variable. As such, it has an

infinitesimal width, and could not include any actual structure in the window. Technically, then, the pivot axis is the imaginary line about which each louver member rotates as it closes and opens. That definition, however, while technically correct, cannot suffice to describe the phrase as used in the Vaida patent, because the claim expressly states that the longitudinal edge of each louver is *supported* by the pivot axis.FN6 An imaginary geometric frame of reference cannot provide actual support.

FN6. Henceforth, when referring to the imaginary line that defines the axis of rotation of a louver member, the Court will use the phrase, "pivot axis line," and when referring to the element of the Vaida patent claim, the Court will use only the phrase "pivot axis."

The specifications in the Vaida patent help clarify the phrase. The "Detailed Discussion of Preferred Embodiment of the Invention" states that the "pivot axis is reinforced by having [a] bead member formed therein, and may be further reinforced by providing [a] steel rod extending completely through the hollow bead member." The bead member (a hollow tube holding the pivot pins and/or the steel reinforcing rod), and the reinforcing rod are both linear cylindrical forms whose center lines describe the imaginary pivot axis line of the louvers. *See* Figure # 2.FN7 Additionally, each of these elements form part of the pivot mechanism by which the louver rotates between the open and closed positions-the bead member and either the pivots or the steel reinforcing rod form a hinge. Moreover, dependent claims Five and Six expressly incorporate the hollow bead member and steel reinforcing member, respectively, into the Vaida "pivot axis." Nothing else in the Vaida patent both describes the technical pivot axis line and performs the task assigned to the pivot axis by the patent. Therefore, the Court must logically conclude that the bead member and the reinforcing steel rod comprise the "pivot axis" of the Vaida patent.FN8 As already noted, the patent claim expressly utilizes the pivot axis as a means for supporting the longitudinal edges of the louvers. Therefore, using the Court's definition of pivot axis, the claim is limited to louver systems that utilize the louvers' pivot axes-structural elements that describe the imaginary axis line about which the louvers turn and which serve as elements of the pivoting mechanism-as support for the longitudinal edges of the louvers. *See* Figure # 1.

FN7. In Figure # 2, the bead member is labeled 14a, the pivot pins 62, and the reinforcing rod 60.

FN8. Where the Court is deciding an issue at the summary judgment stage for which it would bear responsibility for determining at trial, and the Court has before it all of the evidence from which it would make that determination at trial (here, the patent itself and the prosecution history), the Court may determine the issue as if at trial. *Posadas,* 856 F.2d at 400.

The limited definition that the Court bestows on the phrase "pivot axis" is supported by reference to the prior art. It is common knowledge that in louver window assemblies, the louvers overlap.FN9 If they did not, gaps would form between the louvers even when in the closed position. That being the case, the upper edge of each louver member always acts to provide some support to adjacent upper louver member, because in the closed position, the upper louver will rest on the lower. The problem with most of these designs, however, as demonstrated by the Plaintiff's exhibit, *see* Declaration of Paul Beers, Defendant's Exhibit 2, p. 2, is that the inherent support furnished by overlapping louvers is not of sufficient rigidity to prevent flexion against heavy wind loads or other external forces. *See* Vaida Patent, p. 1, Plaintiff's Exhibit 1. The Vaida patent expressly addresses this shortcoming by placing the louvers in a position such that the lower edges of each louver member overlap the *pivot axes* of the adjacent lower louver members. *See* Vaida Patent, pp. 1-2, Plaintiff's Exhibit 1. The prior art in this case is important because it narrows the advancement claimed by the Vaida patent-the advancement lies in the particular use of the pivot axis. Whereas the typical louver assembly (i.e., the prior art) makes use of overlapping louvers, the Vaida patent achieved an advantage in reducing deflection by extending the lower edges of its louver members over the pivot axes of adjacent lower louver members in order to make use of the structural properties of the pivot axis.

FN9. The Court may consider on a motion for summary judgment that of which it could take judicial notice at trial. *See* Harris v. H & W Contracting Co., 102 F.3d 516, 522 (1996), *reh'g denied,* 109 F.3d 773 (11th Cir.1997). The Court may take judicial notice of facts commonly known. *See, e.g.,* In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 1567 (Fed.Cir.1984) (not error to take judicial notice of the fact "that deli counters may well display bread and rolls in close proximity to the cold cuts and cheeses purveyed there"). The Defendant's brief states that all louver windows utilize overlapping louvers. The Plaintiff's have not disputed that fact. Indeed, the Plaintiff's expert implies as much in his affidavit. *See also, e.g.,* United States Patent No. 3,381,601; United States Patent No. 4199898.

That fact is reiterated by the contents of the file wrapper. As first submitted, Claim One of the Vaida patent application described:

actuating means attached to the actuating section of each of said louver members for pivoting said louver members between open and closed positions, so that in said closed position, the lower longitudinal edge of an upper louver member overlaps the pivot axis of the adjacent lower louver member so that the upper and lower longitudinal edges of the closing section of said louver members are completely supported along their longitudinal lengths by said pivot axis at the upper longitudinal edge thereof and by the pivot axis of the adjacent lower louver member at the lower longitudinal edge thereof.

Plaintiff's Exhibit 3, p. 14. The patent examiner rejected Claim One of the original application "as being anticipated by Bishop." FN10 Plaintiff's Exhibit 3, p. 24. The Vaida patent applicant responded by attempting to "traverse this rejection:"

FN10. The patent examiner did not explain why he determined that the Bishop patent anticipated the Vaida application.

In the present invention, when the louvers are in their closed position, the lower longitudinal edges of each louver overlaps the pivot axis of an adjacent lower louver member. However, in the Bishop reference ... [the louvers] do not meet the claim limitations in lines 20 to 24 of claim 1. More particularly, these lines of claim 1 specifically recite that the upper and lower longitudinal edges of the closing section are completely supported along their longitudinal lengths: by the pivot axis at the upper longitudinal edge of that louver member and by the pivot axis of the adjacent lower louver member at the lower longitudinal edge thereof. Plaintiff's Exhibit 3, pp. 31-32. These remarks indicate the specificity of the Vaida improvement-the use of the pivot axis as a structural support.

b. The Super Guard 2000

Looking now at the accused product, the Court holds that no reasonable jury could find that the SG 2000 literally infringes on the Vaida patent. With respect to literal infringement, the parties' arguments imply an understanding that the outcome will rest solely on the claim definition. Even the Plaintiff concedes that the SG 2000 does not incorporate a design whereby the lower longitudinal edge of upper louver members overlaps the pivot axis of the adjacent lower louver members if the phrase "pivot axis" is given its strict, technical meaning. See Plaintiff's Exhibit 2, p. 3, para. 9. The Court has given the phrase "pivot axis" a meaning as close to its technical definition as the intrinsic evidence allows. By doing so, we define the Vaida claim such that no reasonable person could conclude that the SG 2000 literally infringes on the Vaida patent.

Literal infringement of a claim exists "when the properly construed claim reads on the accused device exactly." Cole, 102 F.3d at 532. The claim as the Court has just construed it does not read exactly on the SG 2000. The lower edges of the louvers on the SG 2000 do not overlap the pivot axes (as construed by the

Court) of adjacent lower louver members. Therefore, the limitation in the Vaida patent describing the lower longitudinal edges of louver members as overlapping the pivot axes of adjacent lower louver members cannot be found on the SG 2000. Therefore, no reasonable jury could find that the SG 2000 literally infringes the Vaida patent.

2. Equivalent Infringement

Under the venerable Doctrine of Equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." Warner-Jenkinson, --- U.S. at ----, 117 S.Ct. at 1045 (citing Graver Tank & Mfg. Co. v. Line Air Products Co., 339 U.S. 605, 70 S.Ct. 854, 94 L.Ed. 1097 (1950)). "The doctrine of equivalents is ... designed to prevent an infringer who does not literally infringe an invention from nonetheless 'stealing the benefit of an invention." ' Nordberg, Inc. v. Telsmith, Inc., 881 F.Supp. 1252, 1299-1300 (E.D.Wis.1995), *aff'd,* 82 F.3d 394 (Fed.Cir.1996) (citations omitted). The idea behind the Doctrine is that "a patentee should not be deprived of the benefits of his patent by competitors who appropriate the essence of an invention while barely avoiding the literal language of the claims." London v. Carson Pirie Scott & Co., 946 F.2d 1534, 1538 (Fed.Cir.1991). In *Warner-Jenkinson,* the Supreme Court, after unanimously affirming the vitality of the Doctrine, expounded upon its limits and application. Citing *Winans,* 55 U.S. (15 How.) at 343, the Court held that "application of the doctrine of equivalents involves determining whether a particular accused product or process infringes upon the patent claim, where the claim takes the form-half express, half implied-of 'X and its equivalents." ' Warner-Jenkinson, --- U.S. at ----, 117 S.Ct. at 1052. As to what an "equivalent" is, the Court explained:

'[T]he substantial equivalent of a thing, in the sense of the patent law, is the same as the thing itself; so that if two devices do the same work in the substantially the same way, and accomplish substantially the same result, they are the same, even though they differ in name, form, or shape.'

Id. (quoting Union Paper-Bag Mach. Co. v. Murphy, 97 U.S. 120, 125, 24 L.Ed. 935 (1878)). In providing a framework for determining whether an element of an accused product or process constitutes the equivalent of a patented product or process, the Court refused to adopt any specific tests, leaving the refinement of the framework to the Federal Circuit. Whatever the test, however, the essential inquiry can be phrased thus: "does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" Warner-Jenkinson, --- U.S. at ----, 117 S.Ct. at 1054.

Courts often describe the overarching question as one of insubstantial differences, and where there is "proof of insubstantial differences between the claimed and the accused products or processes," infringement may be established under the Doctrine. Insituform Technologies, Inc. v. CAT Contracting, Inc., 99 F.3d 1098, 1107 (Fed.Cir.1996), *cert. denied,* 520 U.S. 1198, 117 S.Ct. 1555, 137 L.Ed.2d 703 (1997). In determining the substantiality of the differences, the analysis begins with the "triple identity" or "function-way-result" test, under which the Court applies the principle that "where the claimed and accused machines are substantially the same, and operate in the same manner, to produce the same result, they must in principle be the same." Gray v. James, 10 F. Cas. 1015, 1016 (C.C.D.Pa.1817) (No. 5,718); *see* Engel Indus. Inc. v. The Lockformer Co., 96 F.3d 1398, 1407 (Fed.Cir.1996) ("if the accused device performs a substantially different function *or* performs in a substantially different way *or* obtains a substantially different result, it does not infringe under the doctrine of equivalents"). "The function-way-result test often suffices to assess equivalency because similarity of function, way, and result leaves little room for doubt that only insubstantial differences distinguish the accused product or process from the claims." FN11 Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc., 62 F.3d 1512, 1645 (Fed.Cir.1995), *rev'd on other grounds,* 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). Moreover, the inquiry must be applied element by element, and not to the product or process as a whole. *Id.* Although the *Warner-Jenkinson* Court refused to determine whether analysis under the Doctrine of Equivalents is for the judge or the jury, the Federal Circuit

has allocated the task to the jury. Insituform, 99 F.3d at 1107. On the issue of equivalent infringement, the Court will grant a motion for summary judgment "where the evidence is such that no reasonable jury could determine two elements to be equivalent." Warner-Jenkinson, --- U.S. at ---- n. 8, 117 S.Ct. at 1053 n. 8.

FN11. The Federal Circuit has cleared up any misunderstanding as to whether the "insubstantial differences" analysis and the "function-way-result" analysis constitute separate tests-the test in all infringement by equivalency cases is one of insubstantial differences. In most instances, scrutiny of the function, manner, and result for insubstantial differences will suffice to determine whether the accused product or process is equivalent. That is, where technology is relatively simple, as in mechanical devices like jalousie windows, the function-way-result test ends the inquiry. But where the technology is more complex, "evaluation of function, way and result does not necessarily end the analysis." Hilton Davis, 62 F.3d at 1645. For a discussion of additional evidence that might bear on the analysis, *see* Hilton Davis, 62 F.3d at 1646-1647.

Before evaluating what a reasonable jury could or could not determine regarding the SG 2000's equivalency to the Vaida patent, the Court must examine some limitations that inhere to the Doctrine. First, as a general rule, the reach of the Doctrine must be tempered by a respect for competition-"designing or inventing around patents to make new inventions [as opposed to piracy] is encouraged." London, 946 F.2d at 1538. In order to encourage competition, courts must be careful to limit application of the Doctrine so that the public feels secure in relying on the claim language as the limit of the patent's protection. *See* Hilton-Davis, 62 F.3d at 1654-1660 (Newman, J., concurring) (excellent discussion of the policy implications of the Doctrine of Equivalents); Wilson Sporting goods Co. v. David Geoffrey & Ass., 904 F.2d 677, 684 (Fed.Cir.1990) ("to say that the doctrine of equivalents extends or enlarges the claims is a contradiction in terms"); *cf. also,* Keystone Bridge Co. v. Phoenix Iron Co., 95 U.S. (5 Otto.) 274, 278-279, 24 L.Ed. 344 (1877). As the Federal Circuit stated in *Hilton-Davis:*

The ability of the public successfully to design around-to use the patent disclosure to design a product or process that does not infringe, but like the claimed invention, is an improvement over the prior art-is one of the important public benefits that justify awarding the patent owner exclusive rights to his invention. Designing around "is the stuff of which competition is made and is supposed to benefit the consumer." State Indus., Inc. v. A.O. Smith Corp., 751 F.2d 1226, 1236 (Fed.Cir.1985).

62 F.3d at 1646. For this reason,

application of the doctrine is the exception... not the rule, for if the public comes to believe (or fear) that the language of patent claims can never be relied on, and that the doctrine of equivalents is simply the second prong of every infringement charge, regularly available to extend protection beyond the scope of the claims, then claims will cease to serve their intended purpose. Competitors will never know whether their actions infringe a granted patent.

London, 946 F.2d at 1538.

Aside from general rubric aimed at cabining the applicability of the Doctrine, courts have imposed two more concrete limitations-prosecution history estoppel and the rule that no infringement will lie if the asserted scope of equivalency would encompass prior art. "Prosecution history estoppel bars the patentee from recapturing subject matter that was surrendered by the patentee during prosecution in order to promote allowance of claims." *Insituform,* 99 F.3d at 109. Prosecution history estoppel is not implicated by either of the motions at bar.

The related rule that the asserted range of equivalents may not cover what is already in the public domain (i.e. prior art), removes from the application of the Doctrine of Equivalents any elements found in the accused product/process that could be found in the art when the patent was obtained. Wilson Sporting

Goods, 904 F.2d at 684. It is for the patent owner to show that "the range of equivalents which it seeks would not ensnare the prior art." *Id*. Whether these limitations should bar the application of the Doctrine of Equivalents is a question of law to be applied by the Court. Warner-Jenkinson, --- U.S. at ---- n. 8, 117 S.Ct. at 1053 n. 8.

In the case at bar, Marva invokes the Doctrine of Equivalents asserting that the SG 2000's incorporation of a structural element into the upper edge of each of its louver members to support the full longitudinal lower edge of adjacent upper louver members is equivalent to the Vaida patent claim calling for the use of the pivot axis to support the lower longitudinal edge of adjacent upper louver members. Essentially, Marva seeks to establish that the tubular box structure ("TBS") found at the upper edge of each louver on the SG 2000, *see* Figure # 3,FN12 is equivalent to the pivot axis claimed in the Vaida patent.

FN12. In Figure # 3, the Court has circled and labeled the TBS.

We now apply the triple identity test. A reasonable jury could conclude that the TBS found in the SG 2000 performs the relevant function FN13 of the pivot axis described in the Vaida patent. The Vaida patent claims the use of the pivot axis as a support for the lower edge of adjacent upper louver members. A jury could determine (and indeed almost certainly would determine) that the SG 2000's TBS also functions to support the lower edge of adjacent upper louver members. Both the TBS and the pivot axis constitute rigid structures upon which the lower edges of the adjacent upper louver members rest. The SG 2000's TBS and the Vaida patent's pivot axis resist louver bowing by providing an increased moment of inertia (stiffness) to the lower edge of the member directly above it. From this a jury could certainly conclude that the TBS performs substantially the same relevant function as the pivot axis.

FN13. As discussed below, the evidence demonstrates that the pivot axis performs multiple functions, only one of which coincides with the function assigned to the TBS.

Moreover, a reasonable jury could find that both structures achieve the same result. In fact, from the drawings, it certainly appears that both the TBS and the pivot axis provide substantial support to the louvers directly above them. This support would certainly lessen any inward bowing caused by force applied to the outside of the window, such as by wind or a would-be intruder. As both the TBS and the pivot axis perform the same function and achieve the same result, the Court does not grant summary judgment on either the "function" or "result" prongs of the triple identity test.

The Court holds, however, that the SG 2000 fails the triple identity test for summary judgment purposes because no reasonable jury could find that it passes the "manner" prong. Engel Indus. Inc., 96 F.3d at 1407. The Vaida patent utilizes an existing element in each louver member to serve an additional function. It exploits the cylindrical shape and resultant structural properties of the pivot axis-as defined by the Court-which presents a high moment of inertia about the horizontal axis relative to the flat louver member itself to prevent flexion in the horizontal direction. *See* Vaida Patent, p. 5, lines 3-10, Plaintiff's Exhibit 1. This property of the pivot axis structure, which allows it to perform the additional function of supporting the member directly above the louver in which it sits, derives from its primary functions, which are to provide support and serve as a hinge mechanism for the louver member that incorporates it. As the Vaida patent itself explains, each louver member is supported at the upper edge by its own pivot axis and at the lower edge by the pivot axis of the louver member below it. Therefore, the pivot axis of the Vaida patent serves a dual function-it must support two louver members (in addition to serving as a hinge mechanism).

The SG 2000, however, incorporates an additional element solely to serve the function of supporting the lower edge of each louver member. The TBS serves no function other than supporting the lower edge of the adjacent upper louver member-it does not support the louver member which incorporates it, and it does not

serve in the capacity of a hinge.FN14 By embodying a wholly new, additional element to serve the sole purpose of supporting the lower edge of each louver member, Lausell has "designed around" the Vaida patent. The use of an additional element creates a difference that cannot be considered insubstantial.FN15

FN14. This fact has not been addressed by the parties, but it cannot be debated that the TBS serves the function of supporting the lower edge of the adjacent upper louver members-that is the crux of the Plaintiff's argument. Moreover, the drawings of Plaintiff's expert, Paul Beers, Plaintiff's Exhibit 2, p. 2, demonstrate that the typical pivot axis structure does not contain or require a TBS like the one found in the SG 2000. Therefore, the TBS's inclusion into the SG 2000 design can be ascribed to no other purpose than to provide support for the adjacent upper louver. As for the rest of Paul Beer's statement, his entire argument with respect to literal infringement relies on a definition of the scope of the Vaida Patent, a legal issue, which the Court did not adopt. Therefore, his statement creates no genuine issue of material fact with respect to literal infringement. With respect to infringement under the Doctrine of Equivalents, Plaintiff's expert simply provides an unsupported regurgitation of the legal standard:
the [SG 2000] infringes because it provides substantially the same function, operates the same way, and delivers substantially the same result as the construction described and claimed by the patent. The SG 2000 is insubstantially different from the patented window, given that the lower longitudinal edge of each louver rests only a fraction of an inch off the rotational axis while still engaged and being supported by the pivot structure.

If the Court permitted such mere legal conclusions to create a genuine issue of material fact, summary judgment would never be appropriate in cases involving the Doctrine of Equivalents. Paul Beer's statement simply cannot be allowed to defeat Lausell's motion.
FN15. Analysis under the function and result prongs of the triple identity test involves overlapping considerations. Perhaps the Court's conclusion is better understood in terms of function. The TBS does not serve the same functions as the pivot axis. The TBS does not operate as a hinge and it does not provide any support to the louver of which it is part, two functions that can be ascribed to the pivot axis in the Vaida patent.

Nor does permitting the SG 2000 to avoid the protection provided by the Vaida patent through the use of the TBS exalt words over reality by allowing Lausell to breach the Vaida patent's scope of protection by merely "avoiding the letter" of the patent. Although not addressed by the parties, the Court takes notice from the evidence that at least three substantial differences inhere in the divergent designs. First, and most obvious, is the difference we have already noted-the design of the SG 2000 requires that each louver contain an additional element that serves no purpose aside from supporting the louver member above it. Second, by utilizing a structure that defines the pivot axis line about which the louver rotates, the Vaida patent avoids the problem of a moment, or torque, about that axis. In other words, when a force pushes on the lower edge of the adjacent upper louver, which the pivot axis is supporting, the louver containing the pivot axis will not tend to rotate. In the SG 2000, however, the same force applied to the lower edge of a louver member will create a torque about the adjacent lower louver member's pivot axis line, causing it to rotate. Third, when utilizing an additional structural feature like the TBS found in the SG 2000, the pivot axes may be placed without reference to the adjacent upper louver member, whereas the Vaida patent requires the lower edge of the adjacent upper louver member to overlap the pivot axis of the louver below it, placing a constraint on the design of the window not present in the SG 2000. Again, these specific facts have not been addressed by the parties, but they can be extrapolated from the undisputed evidence provided by the parties.

Keeping in mind the Federal Circuit's admonishment that application of the Doctrine of Equivalents should be the exception, and that the public must be able to rely on the language of patent claims in the interest of technological advancement, the Court holds as a matter of law that the Doctrine has no application to the SG 2000 with respect to the Vaida Patent's claims describing the use of pivot axes as support mechanisms.

B. DEFENDANT'S SECOND MOTION: THE TROUGH

1. Literal Infringement

a. Scope of the Vaida Patent

The Court looks first to the Vaida patent itself, including the claims, the specifications, and the prosecution history (if in evidence) to define the scope of the patented invention. Vitronics, 90 F.3d at 1582. Independent Claim One and dependent Claim Three of the Vaida patent describe the relevant element of the invention-i.e., the trough. Claim One relates: "in said closed position, each of said actuated members form a trough which receives any fluid which penetrates said louver assembly." Vaida Patent, p. 6, lines 41-43, Plaintiff's Exhibit 1. Claim Three FN16 describes:

FN16. Henceforth, reference to Claim Three incorporates reference to the relevant section of independent Claim One.

A louver assembly in accordance with claim One wherein each of said actuated sections are constructed to form a trough when in said closed position which causes any fluid which penetrates said louver members to flow away from said louver assembly, said trough formed between the actuating section of one louver member and closing section of an adjacent louver member.
Vaida Patent, p. 6, lines 56-60, Plaintiff's Exhibit 1. As used in the Vaida patent, the word "trough" means "a large, long, and usually comparatively shallow open vessel that is often V-shaped in cross-section and used especially to hold water or feed for domestic animals," or "a conduit for water," or "a long and narrow or shallow channel or depression (as between waves or hills)." Webster's Third New International Dictionary (Unabridged) 2453 (1981). Neither party contests the meaning of the word trough, and as with the claims at issue in the first Motion for Summary Judgment, Claims One and Three are plainly understood. The Vaida patent clearly contemplates the formation of a trough, defined on one side by the closing section of one louver and on the other side by the actuating section of the adjacent lower louver member. *See* Figure # 1. FN17 That conclusion is supported by the patent specifications. The Vaida patent's Detailed Discussion of Preferred Embodiment of the Invention contains:
FN17. In Figure # 1, the trough is labeled 50, the closing section 14, and the actuating section 32.

actuating sections ... constructed to form a trough when in their closed positions. That is, as shown in FIG. 3, each of the actuating sections 32 cooperates with the closing section 30 of an adjacent louver member 14 to form a substantially V-shaped trough 50 when the louver members 14 are in their closed position.
Vaida Patent, p. 4, lines 31-34, Plaintiff's Exhibit 1. Nothing contained in the intrinsic evidence could support a different definition of the scope of Claim Three of the Vaida patent.FN18
FN18. The Plaintiff contests what it considers the Defendant's assertion that the trough described by the Vaida patent is limited to the V-shape described in the preferred embodiment. Although the Court is not certain the Defendant actually makes that assertion, the shape of the trough is not relevant to the Court's holding, and it need not be addressed.

b. The Super Guard 2000

No reasonable jury could find that the SG 2000 literally infringes on the Vaida patent with respect to the trough described by Claim Three. A jury may find literal infringement "when the properly construed claim reads on the accused device exactly." Cole 102 F.3d at 532. The SG 2000 does not even contain actuating

sections.FN19 Clearly, without an actuating section, the device cannot contain a trough, one of the sides of which is defined by an actuating section. As Claim Three of the Vaida patent does not read exactly onto the SG 2000, no reasonable jury could find that the latter infringes the former literally.

FN19. The SG 2000's opening/closing mechanism consists of a series of linked metal plates located inside of the window's side jambs. The system of plates is delineated in Figure # 3 in dashed lines.

The Plaintiff's argument to the contrary is unpersuasive. The Plaintiff points to the space between closing sections of adjacent louver members in the SG 2000. The louvers do not come in direct contact; instead, a strip of material FN20 seals the space between the rigid louvers. The Plaintiff asserts that a small "trough" is formed between the overlapping louvers where the weatherstrip separates them. The "trough" is defined on one side by the closing section of the upper adjacent louver member that is above the weatherstrip, on the other side by that portion of the tubular box structure FN21 of the lower adjacent louver against which the upper adjacent member rests that is above the weatherstrip, and along the bottom by the weatherstrip itself. *See* Figure # 3A. The Plaintiff argues that a reasonable jury could read Claim Three exactly onto this "trough." The Plaintiff is mistaken. The Court has defined the object of Claim Three, based on the intrinsic evidence, not merely as a trough, but as a trough defined in part by the actuating section. Without an actuating section, the SG 2000 cannot literally infringe on the claim as the Court has defined it.

FN20. According to the mechanical drawings of the SG 2000 and the physical specimen, the material used as weatherstripping is wool pile.

FN21. See the Court's analysis of the Defendant's first Motion for Summary Judgment, above, for explanation of "tubular box structure." *See* Figure # 3.

2. Equivalent Infringement

The Court's analysis under the Doctrine of Equivalents begins with the triple identity test-if the "trough" found on the SG 2000 "performs a substantially different function *or* performs in a substantially different way *or* obtains a substantially different result, it does not infringe under the doctrine of equivalents." Engel Indus., 96 F.3d at 1407 (emphasis in original). The Court holds as a matter of law that the "trough" that the Plaintiff has pointed out in the SG 2000 does not perform the same function as the trough defined in Claim Three of the Vaida patent. The patent describes the function of the trough as "[collecting] any fluid which penetrates the seal between adjacent louver members," Vaida Patent, p. 4, lines 39-41, Plaintiff's Exhibit 1, and "caus[ing] any fluid that penetrates the louver members to flow away from said louver assembly." Vaida Patent, p. 4, lines 30-35, p. 6, lines 56-60, Plaintiff's Exhibit 1. The Vaida Patent relates a substantial trough capable of containing a relatively large quantity of water.FN22 By utilizing the sloping actuating section as one side of the trough, the Vaida patent captures a significant volume of space to function as a trough-to catch and transport water that infiltrates the window's barrier. The result is a design for effectively preventing water that penetrates the window's barrier from entering the dwelling.

FN22. The patent drawings are not scaled, so it is impossible for the Court to determine the exact size of the trough contemplated by the Vaida Patent. According to the patent drawings (and the specifications found in the preferred embodiment), the actual cross-sectional area of the trough would depend on the length and the slope of the actuating section. As the actuating section serves as the lever arm that rotates the entire louver about the pivot axis, it must be of sufficient length to generate sufficient torque about the pivot axis. Also, if the goal of the Vaida design is to be achieved, and a trough created, the actuating section must be sloped. In other words, if the actuating section is not sloped when in the closed position, no trough is created. Based on these facts, the Court can determine that the cross-sectional area of the trough described by Claim Three of

the Vaida patent is of sufficient magnitude to perform its designated function-collecting and transporting water.

Moreover, the physical example of the Vaida Patent supplied to the Court by Marva contains a trough with a significant cross-sectional area.
The mechanical drawings and the physical exemplar of the accused device demonstrate that the SG 2000 does not contain a trough of significant dimensions to perform the function ascribed to the trough defined by Claim Three of the Vaida patent. Such a trough simply does not exist on the SG 2000. The volume of space to which the Plaintiff points on the SG 2000 as embodying the trough described in the Vaida Patent is so minuscule that no reasonable jury could find that it is able to contain and/or transport water. Looking at both the mechanical drawings and the physical model of the SG 2000, the cross-sectional area of the SG 2000's trough can be no greater than one one-hundredth of a square inch. No reasonable jury could determine that "trough" could perform the function of collecting and transporting water that penetrates the window.

The Plaintiff has attempted to dispute that fact through the Declaration of Max Moskowitz, but the evidence provided by the Plaintiff on that point has no probative value. Max Moskowitz is a lawyer specializing in intellectual property law. *See* Expert Report of Max Moskowitz, docket No. 23; Plaintiff's Initial Scheduling Conference Report, docket No. 16. The Plaintiff has proffered him as a patent law expert, nothing more. Generally, expert testimony on the law is not permitted, "because the trial judge does not need the judgment of witnesses." United States v. Zipkin, 729 F.2d 384, 387 (6th Cir.1984). "The special legal knowledge of the judge makes the witness' testimony superfluous." *Id*. (citing VII Wigmore on Evidence s. 1952 (Chadbourn rev.1978)). Nonetheless, in the context of patents, courts have occasionally utilized patent experts to assist them on legal determinations. Markman v. Westview Instruments, Inc., 52 F.3d 967, 991 n. 4 (Fed.Cir.1995) (Mayer, J. concurring). But "a fact dispute cannot arise solely from testimony of a patent law expert." *Id*. ("While this sort of testimony is acceptable, even if often overdone, as an interpretive aid to the court, it is not evidence and cannot create a genuine fact question for the jury"); *accord* Nutrition 21 v. United states, 930 F.2d 862, 871 n. 2 (Fed.Cir.1991) ("patent law expert's 'opinion on the ultimate legal conclusion is neither required nor indeed evidence at all" '); Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc., 853 F.2d 1557, 1564 (Fed.Cir.1988)("conflicting opinions of legal experts create no material issue of fact"). In his statement, Max Moskowitz testifies as to the operation of the window. The Plaintiff has not proffered Max Moskowitz as a technical expert, and the Court holds that he, as a patent expert, has in no way been qualified to testify as to the windows' operation.FN23 In so holding, the Court is not scrutinizing Moskowitz's qualifications; the Court is merely limiting his testimony to issues for which he has been proffered as an expert.FN24 In sum, Max Moskowitz's declaration is legally insufficient to create a genuine issue of material fact as to the existence of a trough in the SG 2000. Having determined that no reasonable jury could find that the SG 2000 contains a trough sufficient to perform the function of the trough described by Claim Three of the Vaida Patent, the Court need not consider either the "way" or the "result" prongs of the function-way-result test.

FN23. Moskowitz also presents two hand-drawn depictions of the Vaida window and the SG 2000, respectively. Those drawings are likewise not admissible for the purpose of summary judgment-the actual patent drawings and mechanical drawings of the SG 2000, the accuracy of which has been testified to by sworn statement, are available, and Max Moskowitz's sketches are not valid replacements.

FN24. This is not a case like *Cortes-* Irizarry v. Corporacion Insular de Seguros, 111 F.3d 184 (1st Cir.1997), in which the trial judge excluded the testimony of an expert at the summary judgment stage based on the application of *Daubert*. The Court is cognizant of the United States Court of Appeals for the First Circuit's admonishment that a trial court should normally apply *Daubert* at trial, with the benefit of *voir dire*. Our determination of the value of Max Moskowitz's testimony does not rely on his qualifications. The Plaintiff specifically proffered him as a patent expert, and the Court has accepted that he is such. The Court's holding stems from established rules of evidence regarding the value of testimony by "legal

experts."

Even if the Plaintiff had succeeded in pointing out a genuine issue of material fact with respect to the function-way-result test for equivalency, the Court would still hold as a matter of law that the SG 2000 does not infringe on the Vaida Patent under the Doctrine of Equivalents. That is so because "the range of equivalents which [the Plaintiff] seeks would [] ensnare the prior art." Wilson Sporting Goods, 904 F.2d at 684. As the Court stated above, the asserted range of equivalents may not cover what was in the public domain when the patent was obtained. *Id*. The determination of whether this limitation prevents application of the Doctrine is one of law. Warner-Jenkinson, ---U.S. at ---- n. 8, 117 S.Ct. at 1053 n. 8. The "trough" to which the plaintiff points in the SG 2000 results incidentally from the overlap of adjacent louvers separated by weatherstripping. Louver assemblies in which the lower edges of adjacent upper louver members overlap the upper edges of adjacent lower louver members and which utilize seals at the point of contact between the overlapping louvers existed at the time the Vaida patent was issued. For example, United States Patent Number 3,381,601, covering an Air Damper Assembly ("McCabe Patent") and issued in 1968, clearly shows the use of a seal at the connection created by the overlapping of adjacent louver members. If the Court were to permit the Plaintiff's asserted range of equivalents, it would encompass the McCabe Patent at least. Therefore, the Court holds as a matter of law that the SG 2000 does not incorporate the trough described in Claim Three of the Vaida Patent under the Doctrine of Equivalents.

The Court's holding conforms to the goals of the Doctrine. As noted above, the Doctrine was formulated with the idea that "a patentee should not be deprived of the benefits of his patent by competitors who appropriate the essence of an invention while barely avoiding the literal language of the claims." London, 946 F.2d at 1538. The SG 2000 does not utilize the "essence" of the Vaida Patent's trough for collecting and dispersing water. The essence of the Vaida design, with respect to the trough, is the use of the actuating section for dual purposes-as the lever arm for rotating the louvers about their pivot axes and as one side of the trough channels. As the SG 2000 does not even make use of an actuating section, and as the formation of any trough in its design is incidental to the overlapping of louvers and the use of weather stripping, neither of which is the essence of the Vaida Patent, the goal of the Doctrine would not be served by a finding of equivalence.

IV. LAUSELL'S COUNTERCLAIM

The Defendant has filed a counterclaim challenging the validity of the Vaida Patent and seeking a declaratory judgment that the patent is invalid. The Defendant invokes this Court's jurisdiction under the Declaratory Judgment Act, 28 U.S.C. s. 2201(a) ("DJA"). The DJA does not expand the jurisdiction of the federal courts, it only expands the range of redress available therein. Glaxo, Inc. v.. Novopharm, Ltd., 110 F.3d 1562, 1570 (Fed.Cir.1997). Moreover, the exercise of jurisdiction under the DJA is discretionary. Ernst & Young v. Depositors Economic Protection Corp., 45 F.3d 530, 534 (1st Cir.1995); 28 U.S.C. s. 2201(a)("court ... *may* declare the rights and other legal relations of any interested party"). Before the Court will render a declaratory judgment, then, jurisdiction must be established *and* the Court must exercise its discretion and determine that it wishes to hear the controversy.

In order for jurisdiction to exist, an actual case or controversy must be presented. Glaxo, 110 F.3d at 1570. "In the trial court ... a party seeking a declaratory judgment has the burden of establishing the existence of an actual case or controversy." Cardinal Chem. Co. v. Morton Int'l, Inc., 508 U.S. 83, 95, 113 S.Ct. 1967, 124 L.Ed.2d 1 (1993). In the realm of patent litigation, "if a party has actually been charged with infringement of the patent, there is, necessarily, a case or controversy adequate to support jurisdiction of a complaint, or a counterclaim, under the [Declaratory Judgment] Act." *Id*. at 96. But "a party may satisfy that burden, and seek a declaratory judgment, even if the patentee has not filed an infringement action." *Id*. at 95. That is important here because the Court has dismissed the infringement action prior to even addressing the counterclaim regarding validity, and hereafter, no infringement action exists. In order to satisfy the

burden of showing a controversy where no infringement action looms, the complainant must, as is the case whenever a declaratory judgment is sought, demonstrate that there is a clear controversy. Arrowhead Indus., Water, Inc. v. Ecolochem, Inc., 846 F.2d 731, 735 n. 6 (Fed.Cir.1988); 28 U.S.C. s. 2201. In determining whether that burden has been satisfied, "the question in each case is whether the facts alleged, under all the circumstances, show that there is a substantial controversy, between parties having adverse interests, of sufficient immediacy and reality to warrant the issuance of a declaratory judgment." Maryland Casualty Co. v. Pacific Coal & Oil Co., 312 U.S. 270, 273, 61 S.Ct. 510, 85 L.Ed. 826 (1941).

Where the infringement action is dismissed in a case in which a counterclaim has been filed seeking a declaration of invalidity, the question of whether there is an actual case or controversy regarding validity is complicated. Prior to reaching the merits of the validity issue, the Court has not affirmatively reached the question of jurisdiction under the DJA. Logically, if the Court dismisses the infringement action at the Summary Judgment stage prior to addressing the counterclaim, the issue of validity must be in immediate and real controversy, independently of the infringement action, in order for the Court to retain jurisdiction under the DJA. As noted above, the purpose of summary judgment is "to pierce the pleadings and to assess the proof to determine if there is a genuine need for a trial." Garside, 895 F.2d at 50. In other words, given the undisputed facts, is there even a controversy? Upon a determination that no controversy regarding infringement has been presented, a controversy regarding validity should not be permitted to ride the coattails of the non-existent infringement action. Therefore, the Court must consider the validity claim independently in order to determine whether it has jurisdiction.

Lausell's counterclaim bases its assertion of this Court's jurisdiction under the DJA on the infringement action:

Marva has asserted and now asserts such patent against Lausell and Lausell denies the validity of an the alleged infringement of said patent, wherefore an actual controversy exist[s] between Lausell and [] Marva regarding such patent which is recognizable by this Court under the Federal Declaratory Judgment Act.

No grounds for the exercise of jurisdiction that are independent of the infringement action have been proffered. In the patent context, the DJA's purpose is served by preventing patent owners from using the threat of patent infringement litigation to render competitors "helpless and immobile." Arrowhead, 846 F.2d at 734. After passage of the Act,

competitors were no longer restricted to an *in terrorem* choice between the incurrence of a growing potential liability for patent infringement and abandonment of their enterprises; they could clear the air by suing for a judgment that would settle the conflict of interests.

Id. at 734-735. "The sole requirement for jurisdiction under the [[[Declaratory Judgment] Act is that the conflict be real and immediate." *Id*. at 735. The Defendant has not alleged that Marva has "engaged in a *danse macabre,* brandishing a Damoclean threat with a sheathed sword" (i.e., the threat of patent infringement claims). *Id*. The only threat that the Defendant has mentioned was real-the infringement suit at bar-but is now no longer vital. The demise of that threat destroyed any immediacy and reality of the conflict regarding validity. Therefore, the Court finds that it has no jurisdiction over the Defendant's counterclaim for declaratory judgment now that the infringement action has been dismissed.

Aside from the question of jurisdiction, the DJA provides the district court with discretion to accept jurisdiction. Prior to reaching the merits of the validity claim, the Court has not exercised its discretion under the DJA and accepted jurisdiction.FN25 In the instant case, the issue of validity may never be important again. The patent was issued in 1984 and will expire in approximately three years. 33 U.S.C. s. 154 (patent provides right to exclude making, use, or sale of an invention for seventeen years). The Court has not been informed that other actions for infringement of the Vaida Patent have been brought or threatened by Marva, or that the Defendant faces a burden due to the Vaida Patent's continued existence.

Moreover, substantial time and effort is generally involved in determining patent validity. Cardinal, 508 U.S. at 99. Therefore, even if the Court had jurisdiction over the Defendant's counterclaim, the Court would, in its discretion, refuse to accept that jurisdiction in the interest of judicial economy.

FN25. Much of the Supreme Court's reasoning in *Cardinal*-regarding the appellate court's jurisdiction under the Declaratory Judgment Act to hear an appeal from a valid declaratory judgment rendered by the trial court-was based on the notion that the district court had already exercised its discretion to accept jurisdiction. *See* Cardinal, 508 U.S. at 97-99.

IV. CONCLUSION

In conclusion, no reasonable jury could come to the conclusion that the SG 2000 infringes the Vaida patent, either literally or under the Doctrine of Equivalents. The Plaintiff's claims are hereby DISMISSED WITH PREJUDICE. The Court has no jurisdiction over the Defendant's counterclaim challenging the validity of the Vaida patent, and even if the Court had jurisdiction under the Declaratory Judgment Act, the Court would exercise its discretion and refuse to accept jurisdiction over the Defendant's counterclaim. The Defendant's counterclaim is hereby DISMISSED WITHOUT PREJUDICE.

IT IS SO ORDERED, ADJUDGED, AND DECREED.

In San Juan, Puerto Rico, this 27 day of August, 1997.

FIGURE # 1

CROSS-SECTIONAL VIEW OF THE MARVA PATENTED WINDOW

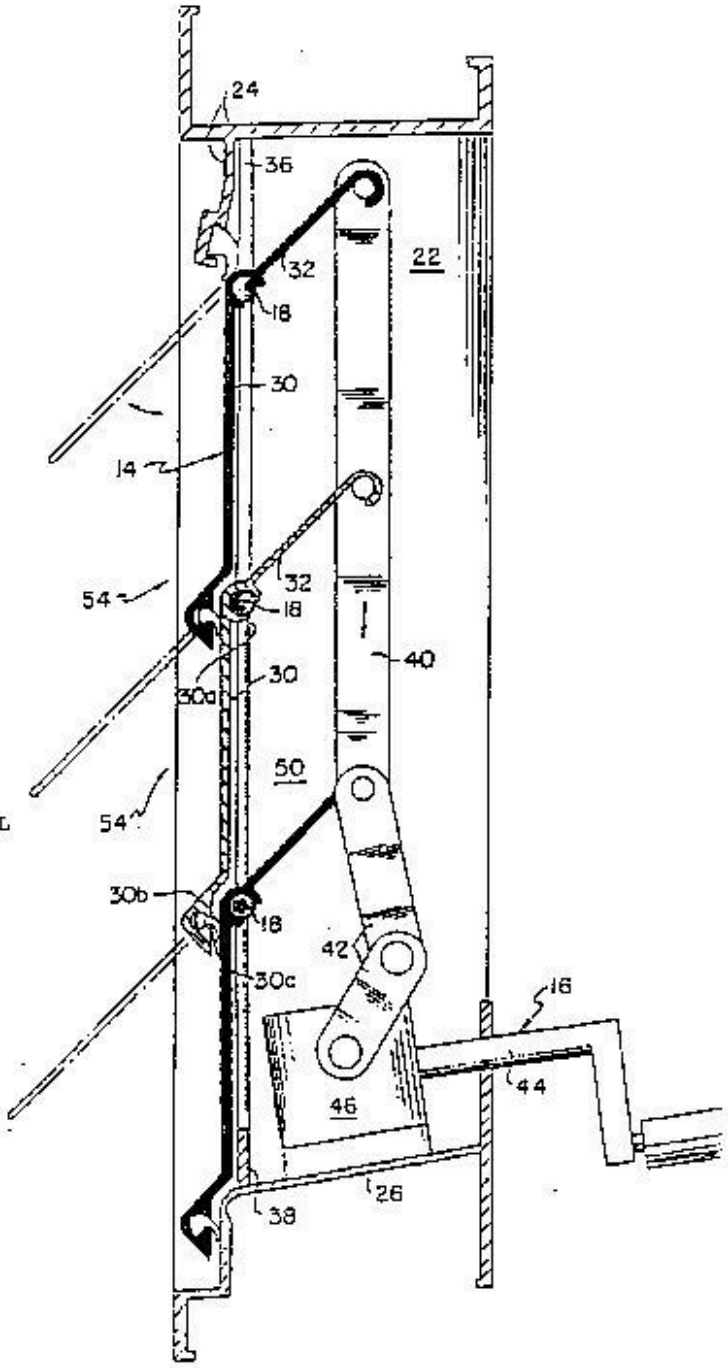


FIGURE #1

CROSS-SECTIONAL VIEW OF THE MARVA PATENTED WINDOW

MARVA PATENTED WINDOW

FIGURE # 2

OBLIQUE VIEW OF THE MARVA PATENTED WINDOW

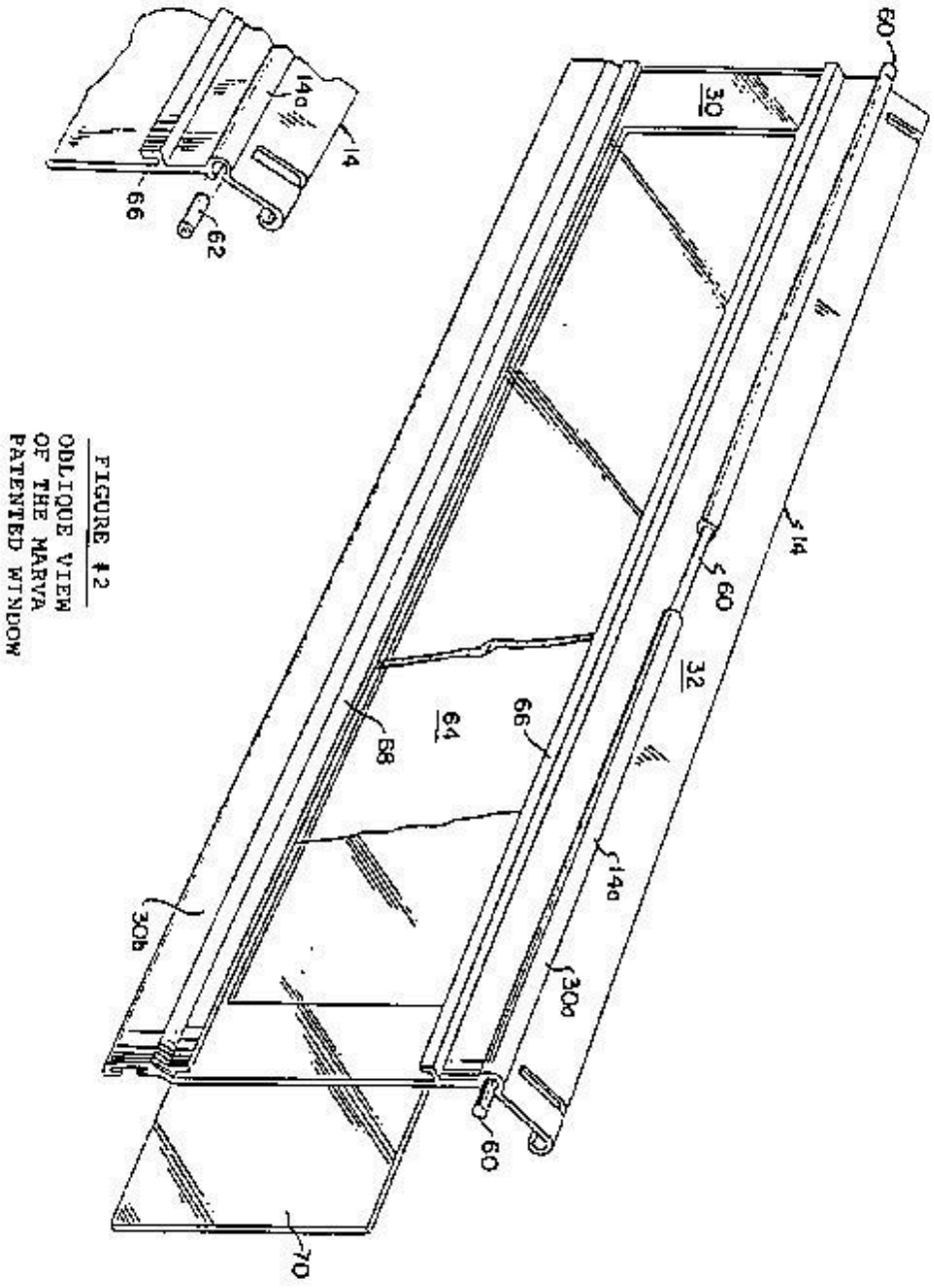


FIGURE #2
OBLIQUE VIEW
OF THE MARVA
PATENTED WINDOW

FIGURE # 3

CROSS-SECTIONAL VIEW OF THE SG 2000 WINDOW

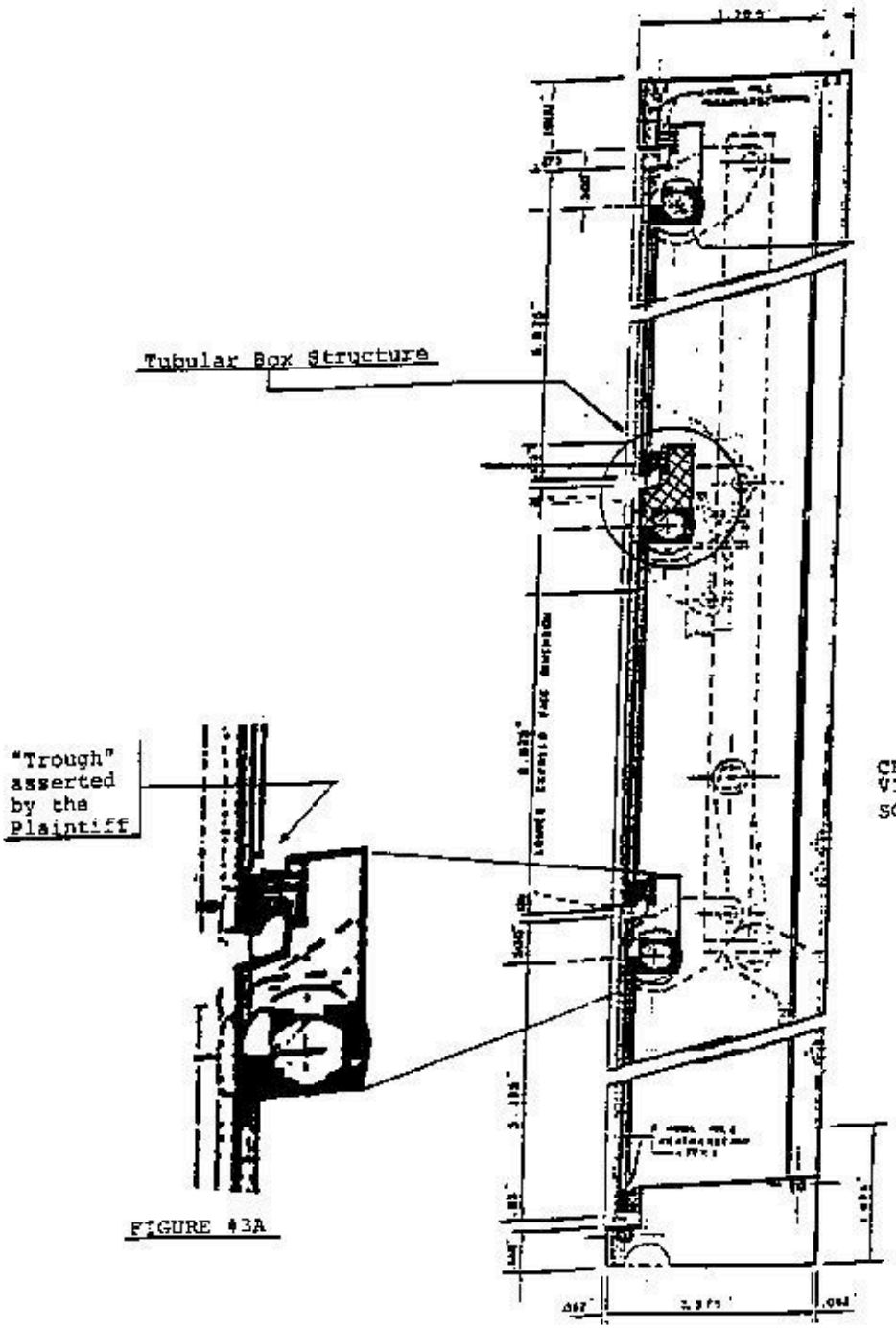


FIGURE #3A

FIGURE #3

CROSS-SECTIONAL VIEW OF THE SG 2000 WINDOW

D.Puerto Rico,1997.
Industrias Metalicas Marva, Inc. v. Empresas Lausell

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