United States District Court,
N.D. Illinois.

Philip F. FINNEY,
Plaintiff.
v.
NAUTICAL SPECIALTIES, INC. and Mr. Carl Lemke,
Defendant.

Dec. 3, 1997.

MEMORANDUM OPINION AND ORDER

LEINENWEBER**, J.**

The plaintiff, Philip F. Finney, was issued U.S. Patent No. 4,936,593 (the " '593 patent") on June 26, 1990. The patent describes a type of assembly for providing a seal between the hull of a powered water craft and a drive shaft that passes through the hull. Such a seal is needed because the drive shaft rotates while the tubular hull fitting is stationary. Without a seal water would flow along the rotating shaft into the hull of the boat since the rotating shaft cannot be water tight in the hull fitting and still rotate. The water seal in the '591 patent consists of two annular, *i.e.,* ringlike, face seals, one of which is attached to the tubular hull fitting, which is stationary, and the other is attached along the rotating shaft and rotates. The two seals are kept in constant, mutual compression by a stationary sleeve bearing to which the hull seal is attached and a coil spring which is positioned along the shaft distal to the shaft face seal providing the pressure to keep the two face seals in constant contact. The shaft rotates in either of two directions which causes a certain amount of "wobble or eccentric motion," which the sleeve bearing is intended to eliminate. There is an open area between the sleeve bearing and the tubular hull fitting that is covered by a boot or casing which is water resistant. Because the shaft moves axially back and forth, as the engine is engaged in a forward direction or reverse, this flexible casing, or boot, ensures that, depending on the movement of the coil spring, the expanding or constricting area is covered and watertight.

The patent in Claims 1 and 5, describes two variations of the invention, the difference being the location of the coil spring. In Claim 5 the coil spring is located as described above, while in Claim 1 the coil spring is located along the shaft between the stationary face seal and the sleeve bearing. In Claim 1 the boot is located surrounding the coil spring which expands or restricts as described above. The specifications state that the latter assembly (Claim 1) is intended for boats that have a greater amount of shaft axial movement. The specifications state that the purpose of the former assembly (Claim 5) is intended for boats where wobble is more of a problem than axial movement. This case involves Claim 5, and a dependent Claim 9. Claim 9 describes a hole in the bearing sleeve extending from the stationary seal to the opposite end which, according to the preferred embodiment, is intended for drainage purposes.

The defendant, Nautical Specialities, Inc., is in the business of manufacture and sale of marine supplies, including shaft seals. One of its products is the Lasdrop Shaft Seal which it has been manufacturing and

selling since December, 1994 when it purchased the assets of the Lasdrop Shaft Seal Company. Plaintiff does not claim that this seal infringes on the '593 patent.

In mid-1995, the defendant launched its Lasdrop Gen. II shaft seal which, plaintiff contends, infringes Claims 5 and 9 of the '593 patent. This seal has some obvious differences from the '593 patent although the principle is the same, *i.e.,* use of a coil spring to engage two seals, one stationary and the other rotating on the shaft and held in place by a sleeve bearing.

The original Lasdrop seal was constructed differently. In stead of a coil spring it had a neoprene bellows that, similar to the coil spring, caused the seals to remain in contact during axial movement. It also had sufficient space along the shaft to enable sea water to flow to the seals to cool and lubricate the friction surfaces. There was a separate model that had a water injection line to cool high speed boats. This line fed water directly trough a hole in the stationary bearing.

After this suit was filed, Robert Edgecombe, the owner of a 1964 Pearson Vanguard sail and power boat, brought to defendant's attention the fact that his boat, which he acquired in 1984, was equipped with a Sealol Shaft seal. Defendant contends that this shaft seal has each and every feature cited in Claim 5 of the '593 patent. Consequently defendant contends that the '593 patent is anticipated by this prior existing Sealol Shaft Seal and is invalid pursuant to the provisions of 35 U.S.C. s. 102(b). Defendant also contends that the dependent Claim 9 is obvious in view of the teachings of the prior Lasdrop Shaft Seal combined with the Sealol Shaft seal under the provisions of 35 U.S.C. s. 103. FN1

FN1. Defendant's argument is more correctly described as non-infringement. The hole required by Claim 9 is stated in the patent as being for drainage purposes only. The hole or holes of the alleged infringing Gen. II seal are clearly for supplying water for use as a lubricant under the bearing seal. Defendant says however that if the hole is considered to be infringing then it was obvious since the original Lasdrop seal also had a whole for supplying water.

Finney in response says that one skilled in the art, *i.e,* one experienced in the field of the invention, would be a "machinist, seal designer, or one having a good understanding of/and experience with marine propulsion systems." He argues that the detailed description of the preferred embodiments of the invention shows that the shaft is to be "journalized" in the sleeve bearing. He contends, in effect, that the verb "journal" is a term of art in the machinist trade. He quotes from two machinist handbooks to show that a journal fit for a shaft .875 inches in diameter, the size of the Sealol shaft, would provide a clearance of between .00157 and .00274 inches or between .0015 and .0035, depending on the source book. Finney claims that he measured the clearance of the corresponding parts of the Sealol shaft and found it slightly oval from wear and varying from .010 and .013, which he claims is a considerable difference from the handbook description of a journal fit. On the other hand Mr. Finney testified that he measured clearance on the Gen. II and found it to be .002 which was within the sleeve bearing journal relationship according to the handbooks.

It appears that it is Finney's position that the distinguishing feature, on one hand that establishes infringement on the part of the Gen. II seal, and, on the other hand that renders the Sealol shaft not relevant to defendant's anticipation argument, is the clearance measurements between the rotating shaft and the sleeve bearing. The Gen. II and the '593 call for a journaled sleeve bearing while the Sealol did not have such a close fitting, journalized sleeve bearing. However conspicuous by its absence is any such requirement

in the language of Claim 5 and the dependent Claim 9 of the '593 patent. The journaled relationship described in Finney's brief is located in the description of the preferred embodiment of the invention and not in the claim language.

It is well known that a court "cannot alter what the patentee has chosen to claim as his invention." SSIH Equipment S.A. v. U.S. Int'l Trade Comm., 718 F.2d 365, 378 (Fed.Cir.1983) cited in E.I. Du Pont de Nemours & Co. v. Phillips Petroleum, 849 F.2d 1430 (Fed.Cir.1988). It is proper to use the specifications and the preferred embodiment to explain, for example, what is mean by a word or phrase in the claim. But this is not to be confused with adding an extraneous limitation. *Id*. The fact of the matter is that Finney is asking the court to interpret his claim as limited by the description in the preferred embodiment. This the court cannot do. Ekchian v. Home Depot. Inc., 104 F.3d 1299, 1302-03 (Fed.Cir.1997). Suppose the shoe was on the other foot and Finney was suing Sealol for infringement. The court could not limit the claim to the precise measurement described in the preferred embodiment. The claim language only specifies that the sleeve be a bearing sleeve, meaning that clearances in measurement be sufficiently small so that the sleeve can act as a bearing sleeve. This is certainly not as precise as the one called for in the description of the preferred embodiment. If Finney wanted to limit his claim in that manner he could easily have specified a journaled relationship in Claim 1 and Claim 5, but he did not do so. The court therefore interprets the patent in suit as not requiring a journalized relationship between the sleeve bearing and the shaft. *See,* Markman v. Westview Instruments, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

Since Finney does not otherwise attempt to distinguish the Sealol seal from the claim language of the '593 patent, it is apparent that the Sealol seal anticipated the '593 patent, which renders it void under 35 U.S.C. s. 102.

With regard to Claim 9 it frankly appears to the court that there is no infringement. It is clear that the limitation in Claim 9 describes a seal assembly according to Claim 5 which is a hole through the sleeve bearing extending from a point adjacent to the stationary annular seal to its opposite end. The hole is described in the preferred embodiments as a "drain hole" for allowing "any entrapped water to drain from the seal cavity during cold weather out-of-water storage to prevent seal damage." On the other hand the alleged infringing Gen. II seal assembly has what appears to be curved channels in the outside of the bearing sleeve, called a "Cutlass bearing," that provides water to the seal rings for lubrication purposes. Finney argues that these channels, or grooves, are holes. The preferred definition of "hole," taken from *Webster's Third New International Dictionary,* Merriam-Webster, Inc, 1981, "an opening into or through anything: aperture, Perforation <a hole in the roof> < shot a hole through a board> <entered the shed through a hoe in the side> < fishing through a hole in the ice>." Finney does not appear to take great issue on this point. He merely argues that his alternative definition of "hole" is "a cavity in a solid" and states that his conclusion that grooves are holes amounts to a factual disagreement. The court does not agree that grooves are holes, and under the authority of *Markman,* interprets Claim 9 to require a hole through the sleeve bearing for drainage purposes. Since the Gen. II does not have such a hole, the court finds as a matter of law that the Gen. II does not infringe Claim 9.

Accordingly, the court grants the motion of summary judgment of the defendants and enters judgment in their favor and against the plaintiff.

IT IS SO ORDERED.

JUDGMENT IN A CIVIL CASE

[ ] Jury Verdict. This action came before the Court for a trial by jury. The issues have been tried and the jury rendered its verdict.
-> Decision by Court. This action came before the Court. The issues have heard and a decision has been rendered.

IT IS ORDERED AND ADJUDGED that the motion for summary judgment of defendants, Nautical Specialties, Inc. And Mr. Carl Lemke is granted. Judgment is entered in favor of the defendants' and against the plaintiff, Philip F. Finney.

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