United States District Court,
D. Minnesota.

THE TORO COMPANY,
Plaintiff.
v.
ARIENS COMPANY,
Defendant.

No. CIV.3-96-416/RHK/FLN

Sept. 2, 1998.

Earl D. Reiland, Daniel W. McDonald, and Joseph M. Kastelic, Merchant, Gould, Smith, Edell, Welter & Schmidt, Minneapolis, Minnesota, and Donald S. Trevarthen, The Toro Company, Bloomington, Minnesota, for Plaintiff.

Joseph A. Gemignani, Michael E. Husmann, Jonathon H. Margolies, and J. Christopher Carroway, Michael, Best & Friedrich, Milwaukee, Wisconsin, and Daniel J. Maertens, Fredrikson & Byron, Minneapolis, Minnesota, for Defendant.

MEMORANDUM OPINION AND ORDER

KYLE**, District J.**

Background

The Toro Company ("Toro") filed the instant lawsuit against Ariens Company ("Ariens"), alleging that Ariens' snowthrower infringed a patent belonging to Toro, U.S. Patent Re. 33,726 ("the '726 Patent"). The '726 Patent, entitled "Single Stage Snowthrower," was issued to Toro on October 29, 1991. (*See* Am. Compl. para. 4; Answer para. 4.) Ariens both denies that its product infringes the '726 Patent and contends that the '726 Patent is invalid. Ariens filed Counterclaims against Toro, seeking a declaratory judgment that the '726 Patent is invalid and unenforceable, and that Ariens has not infringed it.

The '726 Patent describes a single stage snowthrower. Single stage snowthrowers differ from "dual stage" or "two stage" snowthrowers in that they use only one implement to both pick up the snow and throw it, while dual stage snowthrowers use separate powered implements to do each task consecutively. ('726 Patent, Background of the Invention.) The '726 Patent describes a device with a single rotatable "impeller" with at least one paddle that rotates around an axis. The paddle, as it rotates, picks up and throws snow upwardly and outwardly along the rear wall of the housing of the snowthrower (or snow collecting chamber) and away from the snowthrower. (Id.) In a dual stage snowthrower, by contrast, a snow-gathering auger feeds the snow into the center of the housing, and a high-speed fan then blows it upwardly and away from the snowthrower. (Id.) Single stage snowthrowers are generally lighter and less expensive than dual stage

snowthrowers, and lack the power and other features found in dual stage snowthrowers. (Id.)

Currently before the Court are: (1) Ariens' Motion for Summary Judgment on the issue of Non-Infringement; (2) Ariens' Alternative Motion for Summary Judgment of Invalidity; (3) Toro's Motion for Summary Judgment that its Patent is Not Invalid Under 35 U.S.C. s.s. 102 or 112, para. 1; (4) Toro's Motion for Summary Judgment that Ariens Infringes Claim 37; and (5) Ariens' Motion for Summary Judgment of Non-Willfulness. For the reasons set forth below, the Court will: (1) grant Ariens' Motion for Summary Judgment of Non-Infringement in part and deny it in part; (2) deny Ariens' Alternative Motion for Summary Judgment of Invalidity; (3) grant Toro's Motion for Summary Judgment that its Patent is Not Invalid Under 35 U.S.C. s.s. 102 or 112, para. 1; (4) deny Toro's Motion for Summary Judgment that Ariens Infringes Claim 37; and (5) grant Ariens' Motion for Summary Judgment of Non-Willfulness.

Analysis

A. Standard of Review

"[S]ummary judgment is as appropriate in a patent case as in any other." Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc., 853 F.2d 1557, 1561 (Fed.Cir.1988) (quotation and citations omitted). Summary judgment is proper if there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c). The court views the evidence and the inferences which may reasonably be drawn from it in the light most favorable to the nonmoving party. Enterprise Bank v. Magna Bank, 92 F.3d 743, 747 (8th Cir.1996); *see also* Adkison v. G.D. Searle & Co., 971 F.2d 132, 134 (8th Cir.1992).

The moving party bears the burden of showing that there is no genuine issue of material fact and that it is entitled to judgment as a matter of law. Enterprise Bank, 92 F.3d at 747; *see also* Celotex Corp. v. Catrett, 477 U.S. 317, 322, 106 S.Ct. 2548, 2552 (1986). The nonmoving party must demonstrate the existence of specific facts which create a genuine issue for trial; mere allegations or denials are not enough. Celotex Corp., 477 U.S. at 256, 106 S.Ct. at 2514; Krenik v. County of Le Sueur, 47 F.3d 953, 957 (8th Cir.1995). Summary judgment is to be granted only where the evidence is such that no reasonable jury could return a verdict for the nonmoving party. *See* Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 250, 106 S.Ct. 2505, 2511 (1986).

Ordinarily, the court does not weigh facts or evaluate the credibility of affidavits and other evidence on a motion for summary judgment. The nonmovant cannot, however, avoid summary judgment in favor of the movant merely by pointing to some alleged factual dispute between the parties. Instead, any fact alleged to be in dispute must be "outcome determinative under prevailing law," that is, it must be material to an essential element of the specific theory of recovery at issue. *See* Get Away Club, Inc. v. Coleman, 969 F.2d 664, 666 (8th Cir.1992). Essentially, the court performs the threshold inquiry of determining whether there is a need for a trial. Liberty Lobby, 477 U.S. at 250; 106 S.Ct. at 2510.

B. Ariens' Motion for Summary Judgment on the Issue of Non-Infringement

1. Claim Construction

A claim of literal patent infringement FN1 requires a two-step analysis: claim construction, which is a question of law, and a determination of whether the accused product infringes the asserted claim, as properly construed, which is a question of fact for the jury. Vitrionics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1581-82 (Fed.Cir.1996); *see also* Markman v. Westview Instruments, Inc., 52 F.3d 967, 976

(Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384 (1996). In interpreting a claim, a court first looks to the intrinsic evidence, such as the claims themselves, the specification, and the prosecution history. Vitrionics, 90 F.3d at 1582 (citing Markman, 52 F.3d at 979). In construing the language in a claim, a court is guided by the principle that:

FN1. Toro's Amended Complaint does not specify whether it is alleging literal infringement of the '726 Patent or infringement under the doctrine of equivalents. In its Memorandum in Opposition to Ariens' Motion for Summary Judgment of Non-Infringement ("Pl.'s Opp'n Infringement Mem."), however, it argues that Ariens' accused product infringes both literally and under the doctrine of equivalents. (*See* Pl.'s Opp'n Infringement Mem. at 5-7, 15-16, 30-31.) The Court will address both arguments, therefore, in turn.

Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.
Id. (citing Hoechst Celanese Corp. v. BP Chems. Ltd., 78 F .3d 1575, 1578 (Fed.Cir.), *cert. denied,* 117 S.Ct. 275 (1996)). If the meaning of the claims to be construed is clear from an examination of the language of the claims at issue, the patent specification, and the prosecution history, it is inappropriate for a court to consider extrinsic evidence, such as expert testimony. Id. at 1584 ("In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a claim term. In such circumstances, it is improper to rely on extrinsic evidence."); *see also* Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1216 (Fed.Cir.1995), *cert. denied,* 117 S.Ct. 1243 (1997); Hormone Research Found., Inc. v. Genentech, Inc., 904 F.2d 1558, 1562 (Fed.Cir.1990).
While Toro does not specify, in its Amended Complaint, which claims it alleges that Ariens infringed, it does not dispute Ariens' characterization of the claims that Toro has put at issue: 8, 20, 24-27, 31-36, and 37-42. (*See* Def.'s Mem. in Supp. of Mot. for Summ. J. of Non-Infringement at 3) ("Def.'s Supp. Infringement Mem.") Of these 18 asserted claims, only claims 8, 20, 24, 36, and 37 are independent claims. Claims 25-27 and 31-35 are dependent on claim 24, and claims 38-42 are dependent on claim 37. (*See* '726 Patent.) Accordingly, if the Court finds that the accused product infringes either claim 24 or claim 37, it must also find infringement with regard to each of the claims that are dependent on the infringed independent claim. *See* Wolverine World Wide, Inc. v. Nike, Inc., 38 F.3d 1192, 1199 (Fed.Cir.1994) (if non-infringement is found with regard to independent claim, it must also be found with regard to all claims dependent thereon); *see also* Wahpeton Canvas Co. v. Frontier, Inc., 870 F.2d 1546, 1553 (Fed.Cir.1989) ("It is axiomatic that dependent claims cannot be found infringed unless the claims from which they depend have been found to have been infringed ....").

2. The "Curved" Central Snowthrowing Section

Ariens argues that it is entitled to summary judgment on Toro's contention that the accused product infringes on claims 8, 20, 24, 36, and all claims dependent thereon because the accused product does not have a "curved" central snowthrowing section of the impeller. (*See* Def.'s Supp. Infringement Mem. at 11-17.) Toro contends that neither claim 20 nor claim 36 requires a "curved" central snowthrowing section, and that the accused product does infringe-both literally and under the doctrine of equivalents-those claims which do require a curved section. (*See* Pl.'s Opp'n Infringement Mem. at 7-10, 25-32.)

Initially, the Court must determine which claims require a curved central snowthrowing section. Claim 8 describes an impeller that has "a wide central snow-throwing section which is curved forwardly from the

midpoint to each side thereof to be generally concave ...." ('726 Patent column 14, lines 14-17.) Claim 24 describes an impeller with a curved central snowthrowing section but does not specify that it be "curved forwardly from the midpoint to each side thereof to be generally concave," as does claim 8. (Id. column 17, lines 18-27.) Claim 20 contains a limitation that the impeller include a "means for throwing a snow stream which tapers inwardly as it rises away therefrom." (Id. column 16, lines 12-14.) Ariens argues that the patent specification makes clear that in order to throw such a stream, the central section of the impeller must be curved. (*See* Def.'s Supp. Infringement Mem. at 11-12.) Similarly, claim 36 includes a limitation that the impeller include "means for picking up and throwing snow upwardly along the rear wall of the housing." ('726 Patent column 28-30.) Ariens argues that, for the reasons relevant to claim 20, the limitation in claim 36 requires a curved central snowthrowing section. (*See* Def.'s Supp. Infringement Mem. at 12.) Toro argues that neither claim 20 nor claim 36 requires a curved central snowthrowing section. (*See* Pl.'s Opp'n Infringement Mem. at 7-10, 32.)

The Court finds that nothing in claims 20 or 36 requires that the central snowthrowing section be curved. Claim 36 merely describes the function of any impeller, namely to pick up and throw snow. In its entirety, claim 36 reads:

36. An improved single stage snowthrower, which comprises:

(a) a housing which includes a generally open front portion defined by spaced side walls connected together by a rear wall;

(b) a rotatable snowthrowing impeller extending between the side walls and located in front of the rear wall and having a predetermined length between the side walls, wherein the impeller includes means for picking up and throwing snow upwardly along the rear wall of the housing; and

(c) a snow collecting chamber located on the rear wall of the housing, wherein the chamber tapers inwardly from side-to-side as it rises, and wherein the chamber at its lower end is sufficiently wide to span at least approximately fifty percent, but less than one hundred percent, of the impeller's predetermined length.

('726 Patent column 18, lines 20-36.) The '726 Patent describes a means "for picking up and throwing snow" generally in the section entitled "Background of the Invention," and contrasts such a means in the single stage snowthrowers with those used in dual stage snowthrowers. (*See* id. column 1, lines 18-62.) In its description of single stage snowthrowers, including the Speiser '661 Patent, the '726 Patent nowhere specifies that such a means *necessarily* requires a curved impeller. Rather, the '726 Patent describes a generic single impeller, which performs the tasks of both picking up and throwing the snow. Moreover, in its Supplemental Declaration for Patent Application, submitted to the United States Patent and Trademark Office ("PTO") in support of the '726 Patent, Toro stated that "claim 36 is not specific to the shape or dimensional characteristics of the impeller." (Husmann Aff. Ex. 2V at 3 (11/19/90 amendment and supplemental declaration).)

Accordingly, the Court finds the plain language of claim 36, along with the prosecution history, reveals that claim 36 does not require a curved central snowthrowing section. Similarly, claim 20, which refers to a "means for throwing a snow stream which tapers inwardly as it rises away therefrom," cannot be read as a requirement that the impeller be curved. Ariens correctly notes that the '726 Patent, in the specification, clarifies that the result of the concave nature of the impeller is an inwardly tapering stream. ('726 Patent, column 5, lines 31-45.) Although Ariens argues that this necessarily means that claim 20 requires a concave

central snowthrowing section, the Court believes that such an interpretation would read a limitation into claim 20 that does not appear in the language of the claim, and is not a necessary result of the language in the claim. The Court finds, therefore, that only claims 8 and 24 describe a curved central snowthrowing section.

Having found that only claims 8 and 24 require a curved central snowthrowing section, the Court must determine whether a genuine issue of material fact exists with regard to whether Ariens' accused product infringes the '726 Patent. The impeller in the accused product has a flat central section, with curves at the ends of the impeller. Toro argues that this constitutes a curve, while Ariens argues that the flat central section renders its product non-infringing.

The most explicit claim with regard to the curved central snowthrowing section is claim 8, which explicitly requires that the section be "curved forwardly from the midpoint to each side thereof to be generally concave ...." ('726 Patent column 14, lines 15-17.) Toro does not dispute that the central section of the accused product's impeller (i.e., the midpoint and the areas immediately extending therefrom) is flat. Toro contends, however, that while the accused product's central section is flat when the snowthrower is not is use, it becomes concave when in use. (Pl.'s Opp'n Mem. at 28-29.) Ariens responds that Toro is estopped from making such an argument by its representations that the accused product's impeller is made of inflexible material, which resists bending under load. (Def.'s Supp. Mem. at 15-16.)

The Court finds that it need not resolve the issue of whether or not Toro is estopped from asserting that the material out of which the accused product's impeller is made is flexible, because such a finding is irrelevant to the question of infringement, given the wording of the '726 Patent. Nothing in the '726 Patent would notify a reader of the patent that it describes anything other than a static condition. The '726 Patent does not describe a central snowthrowing section that is "bendable" or "flexible," but rather one that is "curved." Toro's proposed interpretation would impermissibly broaden the claims. Even assuming that the accused product has an impeller which would bend under certain conditions, Toro must show that it has a central snowthrowing section that is "curved," in order to defeat Ariens' Motion for Summary Judgment with regard to claim 8.

A plain reading of the language of claim 8 leaves no ambiguity, and the claim requires precisely what it says: a central snowthrowing section that is curved forwardly from the midpoint. Toro has directed this Court to no evidence that the central snowthrowing section of the accused product is anything but flat, and a visual examination of the product reveals that any such assertion would be untenable. Because this central section is flat, it is not possible to say that it is "curved forwardly from the midpoint." Accordingly, the Court will grant Ariens' Motion for Summary Judgment on the Issue of Non-Infringement with regard to claim 8.

Claim 24 does not include the phrase "curved forwardly from the midpoint," but merely describes a "curved central snowthrowing section." ('726 Patent column 17, lines 18-19.) Toro directs this Court to nothing in the claims, patent specification, or prosecution history indicating that the term "curved" should be interpreted differently from its dictionary definition. Therefore, the Court will apply the dictionary definition in construing claim 24. The American Heritage Dictionary defines "curve" as: "A surface that deviates from planarity in a smooth, continuous fashion." *American Heritage Dictionary* 357 (2d ed.1985). Toro argues that Ariens is attempting to change the limitation from "curved" to "continuously curved." (*See* Pl.'s Opp'n Infringement Mem. at 26.) There is no dispute, however, that the accused product has a 3-inch center section that is flat. (*See* Berner Dep. at 100-01.) Toro's expert witness, John Berner, testified that the

accused product's central section, when stationary, had "a flat section, approximately flat." (Id. at 100.) When posed with a hypothetical question about an impeller comprised of a flat central section with two curves on either side of it, Berner testified that he "wouldn't call that curved." (Id. at 102.) Based on these representations, and-more importantly-the plain meaning of the term "curved," along with the undisputed fact that the accused product has a central snowthrowing section that is flat, the Court finds that Toro has failed to create a genuine issue of material fact with regard to any infringement of claim 24.

Toro argues that, if literal infringement is not found, there is a genuine issue of material fact with regard to whether the accused product infringes under the doctrine of equivalents. The doctrine of equivalents, however, cannot be used to broaden claims or to eliminate claim limitations. *See* Sage Prods. v. Devon Indus., Inc., 126 F.3d 1420, 1424-25 (Fed.Cir.1997); *see also* Conopco, Inc. v. May Dep't Stores Co., 46 F.3d 1556, 1562 (Fed.Cir.1994) ("The doctrine of equivalents cannot be used to erase 'meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement." ') (citations omitted). To use the doctrine of equivalents in the manner proposed by Toro would impermissibly broaden the claims of the '726 Patent at issue, which specify that the central snowthrowing section must be curved, and would effectively erase that structural limitation. Because the doctrine of equivalents cannot be used to accomplish this end, the Court finds that Ariens is entitled to summary judgment on claims 8 and 24 under both a theory of literal infringement and equivalent infringement. Moreover, because claims 25-27 and 31-35 are dependent on claim 24, the Court finds that Ariens is entitled to summary judgment on those claims as well. *See* Wolverine World Wide, 38 F.3d at 1199. Accordingly, the Court will grant Ariens' Motion for Summary Judgment on the Issue of Non-Infringement with regard to claims 8, 24-27, and 31-35.

3. The Length of the Central Snowthrowing Section

Claim 20 describes a single stage snowthrower with an impeller "wherein the throwing means comprises a paddle portion which extends generally radially relative to the impeller means and extends over at least approximately one-half of the impeller means' total length ...." ('726 Patent column 16, lines 14-18.) Ariens argues that its accused product does not infringe claim 20 because its central snowthrowing section is not "at least approximately one-half the impeller's predetermined length." FN2 (Def.'s Supp. Infringement Mem. at 4-11.) Claim 8 describes a "central snowthrowing section" which "extends over at least approximately one-half of the entire impeller's predetermined length." Toro does not dispute Ariens' argument that the "throwing means" described in claim 20 is synonymous with the "central snowthrowing section" described elsewhere in the '726 Patent.

FN2. The Court notes that claims 8, 24, and 36 similarly require that the central snowthrowing section be at least approximately one-half the length of the impeller. ('726 Patent column 14, lines 19-21 and column 17, lines 18-24; Pl.'s Opp'n Mem. at 20-25.) The Court has determined, with regard to each of these claims, that Ariens is entitled to summary judgment on other grounds of non-infringement. (*See* sections B.2., *supra* and B.4., infra.) It notes, however, that Ariens' argument regarding the length of the central snowthrowing section provides an alternative independent ground on which this Court would grant summary judgment in Ariens' favor on claims 8, 24, and 36, even if it had rejected Ariens' other arguments regarding infringement of those claims.

The parties dispute what constitutes the "central snowthrowing section" of the accused product. Toro argues that the plain meaning of the term governs, and the term "central snowthrowing section" should be construed to mean the middle region of the impeller that throws snow off of the impeller. This is contrasted

to the ends of the impeller, the primary function of which is to feed snow into the central snowthrowing region. (*See* Pl.'s Opp'n Infringement Mem. at 20-21.) Ariens argues that the '726 Patent specification defines the term differently, and that any transition section between the end section and the central section is to be considered a part of the end section. (*See* Def.'s Supp. Infringement Mem. at 6-7.) Ariens further argues that the prosecution history of the '726 patent reveals that Toro narrowly defined the term "central snowthrowing section" to distinguish its patent application from the prior art, namely the '963 Heth Patent. (*See* id. at 7-8.)

The term "central snowthrowing section" is defined in the specification of the '726 Patent. The specification describes the impeller as follows:

Each paddle 32 includes a relatively long, central snowthrowing section 34 surrounded on either side by a relatively short, end section 36 that functions as an auger.

....

While each end section 36 has been described as being relatively distinct from central section 34, the axially inwardmost portion of each end section 36 might be considered a transition section in which the shape of the end section is blended to match the shape of the central section 34 at the side thereof. *However, if such a transition section does in fact exist, it will be considered as part of the end section for the purposes of definition herein.*

('726 Patent columns 5, line 28 to column 6, line 7) (emphasis added). Moreover, the Court finds that, in an attempt to distinguish its invention from the prior art, Toro further limited the interpretation of the term "central snowthrowing section."

The prosecution history of the '726 Patent discusses and distinguishes the '963 Heth Patent, which had a central snowthrowing section that was different from that described in the '726 Patent. The '963 Heth Patent described a product with a central snowthrowing section that was narrow and flat. (*See* Hussman Aff. Ex. 2E at 10 (6/18/86 amendment).) In describing the impeller of the '963 Heth Patent, Toro reiterated its restrictive meaning of the term "central snowthrowing chamber" by stating that the impeller "comprises paddles having only a very short and planar central snowthrowing section with relatively long helical auger flights on either side." (Id.) The exclusion of the helical augers from the "central snowthrowing section" is consistent with the usage of that term in the patent specification of the '726 Patent. Such augering sections are properly understood as "transition sections," as defined by the '726 Patent and, consistent with the specification, are considered part of the end sections rather than part of the central snowthrowing section. Because the prosecution history of the '726 Patent reveals special limitations on the manner in which the term "central snowthrowing section" should be interpreted, the Court finds that Ariens' proposed construction of the term is correct. Moreover, because the intrinsic evidence leads to a clear interpretation of the term "central snowthrowing section," it would be inappropriate for this Court to consider extrinsic evidence on the issue, such as expert testimony.FN3 *See* Vitrionics Corp., 90 F.3d at 1584.

FN3. The parties dispute the relevance of the testimony of one of Toro's experts, John Berner, who identified the portions of the impeller between the central section and the end sections as "transition sections." (Berner Dep. at 160-61; *see also* Hussman Aff. Ex. 16 (exhibits from Berner deposition).) While Ariens characterizes Berner's testimony as an admission by Toro, Toro contends that Berner's reference to a "transition section" is irrelevant to the legal issue currently before the Court. (*See* Def.'s Supp. Mem. at 9-

10; Pl.'s Opp'n Mem. at 24-25; Def.'s Reply Mem. at 2.) The Court finds that it need not resolve this dispute, however, because even assuming that Toro is correct in its contention that Berner's testimony is not relevant to the question of whether the accused product includes "transition sections," as referenced in the '726 Patent and its specification and prosecution history, that question is easily resolved in favor of Ariens.

The accused product, like the '963 Heth Patent, has an impeller with a short, flat central snowthrowing section, and two augering sections on either side which lead to the end sections. Interpreting the term "central snowthrowing section" in a manner consistent with the specification and prosecution history of the '726 Patent, the Court concludes that the curved sections on either side of the flat central section of the accused product's impeller must be considered transition sections and, therefore, part of the end sections rather than part of the central snowthrowing section.

Because the patent specification, the prosecution history, and the '726 Patent itself compel the above interpretation of the term "central snowthrowing section," the Court finds that there is no genuine issue of material fact with regard to the length of the "central snowthrowing section" on the accused product. Toro does not dispute-and this Court does not believe that it reasonably could dispute-that the short, flat central section of the accused product's impeller is approximately 3-4 inches long. Interpreting the claim as described above, the Court finds that those parts of the impeller immediately to either side of the central section must be considered end sections and, therefore, the accused product's central snowthrowing section is approximately 3-4 inches long. Toro does not dispute that the total length of the impeller is approximately 18 inches. (*See* Berner Dep. at 89-92.) Claim 20 requires a throwing means (which both parties interpret as being synonymous with the "central snowthrowing section") that "extends over at least approximately one-half of the impeller means' total length." ('726 Patent column 16, lines 17-18.) Because the 3-4 inch "central snowthrowing section" of the accused product is narrower than approximately one-half of the impeller means' total length, the Court finds that Ariens is entitled to summary judgment with regard to literal infringement of claim 20.

Toro argues that, even if the accused product does not literally infringe claim 20, it does so under the doctrine of equivalents. In its Memorandum in Opposition to Ariens' Motion for Summary Judgment of Non-Infringement, Toro does not separately address the issue of infringement of claim 20 under the doctrine of equivalents, but merely includes it in the broader discussion of equivalent infringement of claims 8, 20, and 24, and the claims dependent thereon. (*See* Pl.'s Opp'n Mem. at 30-31.) The Court previously found that the doctrine of equivalents cannot save Toro's claims of infringement of claims 8 and 24, and it reaches the same conclusion, for the same reasons, with regard to claim 20. As the Court stated above, the doctrine of equivalents cannot be used to broaden claims or to eliminate claim limitations. *See* Sage Prods., 126 F.3d at 1424-25; *see also* Conopco, 46 F.3d at 1562 ("The doctrine of equivalents cannot be used to erase 'meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement." ') (citations omitted).

Accordingly, the Court will grant Ariens' Motion for Summary Judgment on the Issue of Non-Infringement with regard to claim 20.

4. The Snow Collecting Chamber

Ariens argues that its accused product does not infringe claim 36 because its snow collection chamber is more than 100% the width of the impeller. (*See* Def.'s Supp. Infringement Mem. at 17-20.) Toro contends

that, while the "chamber" of the accused product is more than 100% the width of the impeller, the portion of the chamber in which snow is collected is less than 100% the width of the impeller and, therefore, the accused product infringes claim 36. (*See* Pl.'s Opp'n Infringement Mem. at 10-15.) Because Toro's construction of claim 36 would add language to the claim and alter its meaning, the Court will grant Ariens' Motion for Summary Judgment on the Issue of Non-Infringement with regard to claim 36.

Claim 36 of the '726 Patent describes:

a snow collecting chamber located on the rear wall of the housing, wherein the chamber tapers inwardly from side-to-side as it rises, and wherein the chamber at its lower end is sufficiently wide to span at least approximately fifty percent, but less than one hundred percent, of the impeller's predetermined length.

('726 Patent column 18, lines 31-36.) The only dispute with regard to this aspect of claim 36 is whether the accused product's snow-collecting chamber is, at its lower end, "less than one hundred percent ... of the impeller's predetermined length." Toro argues that the term "snow-collecting chamber" describes a function rather than simply a structure or an area, and that only that portion of the chamber that actually collects snow should be considered the "snow collecting chamber." (*See* Pl.'s Opp'n Infringement Mem. at 12-13.) Toro, however, points to no language anywhere in the intrinsic record evidence which supports this restrictive reading of the term "snow collecting chamber." Rather, it argues that such a reading is not foreclosed by the prosecution history of the '726 Patent. (*See* id. at 13-14.) This argument is unavailing, however, because it does not explain why the term "snow collecting chamber" should be read in a manner different from its plain meaning.

Importantly, the '726 Patent itself defines the term in question: "Collecting chamber 22 *is defined by* a rear wall 23, two triangular side walls 24 that progressively increase in width as chamber 22 rises vertically, and a generally circular upper collar or ring 25 into which the side and rear walls 23 and 24 are connected or blended." ('726 Patent column 5, lines 2-7) (emphasis added). As Ariens points out in its reply brief, Toro's proposed construction "is inconsistent with both grammar and the specification [of the '726 Patent]." (Def.'s Supp. Infringement Mem. at 9.) Focusing on the grammatical inconsistency of such a construction, Ariens notes that:

A diving board contains portions from which no one dives, a parking garage contains areas in which no one parks, and the bar, restrooms, and shoe rental pavilion are still part of any bowling alley. The structure of a snow collecting chamber may, grammatically, be wider than the actual stream of snow going into it.

(Id. at 10.) The Court agrees. To construe claim 36 as Toro urges would alter the claim, where there is no apparent ambiguity as to its meaning. FN4

FN4. The Court further believes that Toro's proposed construction of the term "snow collecting chamber" is foreclosed not only by the patent specification but also by the prosecution history, in which the collecting chambers of the Rubin '767 Patent and the Curtis '680 Patent were distinguished based on their structural limitations. (*See* Husmann Aff. Ex. 2M at 18 (3/20/87 amendment) ("Because the inverted funnel-shaped discharge chutes in Rubin and Curtis comprise the entire housing, they inherently do not define a chamber which is included on a rear wall of a housing having the specific dimensional limitations of [the claim].").)

Furthermore, application of the doctrine of equivalents would be inappropriate for the reasons discussed in

section B.2., above. As is the case with claims 8, 20, and 24, application of the doctrine of equivalents to claim 36 in the manner Toro urges would simply read out of existence the limitation in claim 36 that the snow collecting chamber be "less than one hundred percent ... of the impeller's predetermined length." ('726 Patent column 18, lines 35-36.) In the prosecution history, Toro distinguished the Rubin '767 Patent and the Curtis '680 Patent by arguing that they "do not define a chamber which is included on a rear wall of a housing having the specific dimensional limitations of [the claim.]" (Husmann Aff. Ex. 2M (3/20/87 amendment).) An applicant for a patent may not, however, file narrow claims to avoid prosecution scrutiny by the PTO and later "obtain in court, either literally or under the doctrine of equivalents, a scope of protection which encompasses [the foregone] subject matter." Genentech, Inc. v. Wellcome Found. Ltd., 29 F.3d 1555, 1564 (Fed.Cir.1994). Because the doctrine of equivalents cannot be used to broaden claims or to eliminate claim limitations, *see* Sage Prods., 126 F.3d at 1424-25; Conopco, 46 F.3d at 1562, the Court finds that Toro has failed to show that there is a genuine issue of material fact with regard to infringement of claim 36 under the doctrine of equivalents.

Accordingly, the Court will grant Ariens' Motion for Summary Judgment with regard to claim 36.

5. The Ledges

Finally, Ariens contends that it is entitled to summary judgment on claim 37 and all claims dependent thereon because there is no genuine issue of material fact with regard to whether the accused product infringes that claim either literally or under the doctrine of equivalents. (Def.'s Supp. Infringement Mem. at 20-21.) Toro argues that the accused product infringes claim 37 both literally and equivalently because it has ledges, as described in claim 37. (Pl.'s Opp'n Infringement Mem. at 1-7.) The parties' sole dispute over claim 37 is the proper construction of the term "ledges." Ariens argues that because its accused product has surfaces that extend outward but without any discontinuity in the surface of the rear wall, they are part of a continuous curve and cannot be characterized as "ledges." (*See* Def.'s Supp. Infringement Mem. at 20-21; Def.'s Reply Infringement Mem. at 11-13.) Toro responds that Ariens is not entitled to summary judgment with regard to claim 37 because: (1) Ariens' proposed construction of the term "ledges" is improper because it would add limitations to claim 37; (2) the accused product literally infringes claim 37 even under the proposed construction of the term "ledges" advanced by Ariens; and (3) the accused product infringes claim 37 under the doctrine of equivalents. (*See* Pl.'s Opp'n Infringement Mem. at 1-7.)

Element (d) of claim 37 describes: "two downwardly facing ledges located on the rear wall of the housing beneath the upper edge of the housing, wherein the ledges are positioned on each side of the snow collecting chamber to lie above the end sections of the impeller." ('726 Patent column 18, lines 54-58.)

To interpret the term "ledges," the Court must first look to the plain meaning of the term in question, and apply that construction of the term unless intrinsic evidence indicates that it is to be construed differently. *See* In re Paulsen, 30 F.3d 1475, 1480 (Fed.Cir.1994). The definition of the term "ledge" is: "A horizontal projection forming a narrow shelf on a wall." *American Heritage Dictionary* 721 (2d ed.1985). Ariens argues that a "ledge" connotes a discontinuity in a surface, and because the protrusions in the accused product are part of the same unbroken surface, they cannot be considered "ledges." (Def.'s Supp. Infringement Mem. at 21.) Toro argues that the accused product literally infringes claim 37 because, even under Ariens' proposed construction of the term "ledges," the protrusions in the accused product constitute discontinuities in the surface of the rear wall. (*See* Pl.'s Opp'n Infringement Mem. at 3-4; *see also* Pl.'s Mem. in Supp. of its Mot. for Summ. J. that its Patent is Not Invalid Under 35 U.S.C. s.s. 102 or 112, para. 1 and that Ariens Infringes Claim 37.)

The Court concludes that, after consideration of the evidence presented to it, substantial ambiguity remains over the manner in which the term "ledges," as it is used in claim 37, should be construed. Because claim interpretation is a matter of law, to be determined by the Court, this Court will deny both Ariens' and Toro's Cross-Motions for Summary Judgment on the Issue of Infringement with regard to claim 37, and will schedule a *Markman* hearing to be held before trial of this matter. *See* Markman v. Westview Instruments, Inc., 517 U.S. 370, 384-90, 116 S.Ct. 1384, 1393-96 (1996); Vitrionics, 90 F.3d at 1581-83. This hearing will be limited to the issue of the proper construction of claim 37 and, particularly, to the disputed term "ledges." In the hearing, both parties will be allowed to present both intrinsic and extrinsic evidence, such as testimony from expert witnesses in the relevant fields, and will present the Court with proposed definitions of the disputed term, "ledges," as it is used in the '726 Patent. If the Court determines, after the hearing, that the intrinsic evidence presented by the parties leads to an unambiguous construction of the term "ledges," it will rely on the extrinsic evidence only for purposes of background information and will not consider that evidence in construing the claims at issue. *See* Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc., 152 F.3d 1368, ___, 1998 WL 469887, *4-*6 (Fed.Cir. Aug. 13, 1998); *see also The* Rival Co. v. Sunbeam Corp., 987 F.Supp. 1167, 1170-71 (W.D.Mo.1997) (discussing procedural and evidentiary aspects of a *Markman* hearing and the appropriate use of extrinsic evidence therein).

C. Ariens' Motion for Summary Judgment on the Issue of Invalidity and Toro's Motion for Summary Judgment on the Issue of Validity

Ariens argues, in addition to its arguments about non-infringement, that claims 36-42 of the '726 Patent are invalid. Specifically, Ariens contends that: (1) claims 37-41 are anticipated by the prior art; (2) claims 36-41, which were part of the reissue patent, are broader than allowed by the original specification; and (3) claims 36-42 are invalid under 35 U.S.C. s. 251 because the requirements pertaining to reissue patent applications were not met.FN5

FN5. Because the Court has determined that Ariens is entitled to summary judgment on the issue of infringement with regard to claim 36, it need not address the issue of the validity of that claim.

1. Anticipation

It is the burden of Ariens to demonstrate, by clear and convincing evidence, that the claims at issue are invalid. *See* Laitram Corp. v. Morehouse Indus., Inc., 143 F.3d 1456, 1464-65 (Fed.Cir.1998). A claim that has been anticipated by the prior art is invalid. *See* 35 U.S.C. s. 102. 35 U.S.C. s. 282 provides: "A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim." Even if this Court were to find claim 37 to be anticipated and invalid, it could still find the dependent claims 38-42 to be valid. If, however, claim 37 is found to be valid, then claims 38-42 are also necessarily valid because they are dependent claims.

A claim is anticipated and, therefore, invalid only if a reference in the prior art discloses every feature of the claimed invention, either explicitly or inherently. Hazani v. United States Int'l Trade Comm'n, 126 F.3d 1473, 1477 (Fed.Cir.1997). "Whether a claim feature is inherent in a prior art reference is a factual issue on which extrinsic evidence may be submitted." *Id.*

In arguing that claim 37 (and, therefore, dependent claims 38-42) is not anticipated, Toro focuses on element (d) of claim 37, which describes "two downwardly facing ledges located on the rear wall of the housing beneath the upper edge of the housing, wherein the ledges are positioned on each of the snow collecting chamber to lie above the end sections of the impeller." ('726 Patent column 18, lines 54-58.) Toro argues that each of the previously existing patents cited by Ariens to show anticipation of claim 37 had one continuous ledge rather than "two downwardly facing ledges ... positioned on each of the snow collecting chamber to lie above the end sections of the impeller," as claim 37 requires.

Ariens argues that claims 37-41 are invalid because they are anticipated by prior patents, notably the Davies '092 Patent, and the Vachon '989 Patent. (*See* Def.'s Supp. Invalidity Mem. at 3.) Because claim 37 is the independent claim on which claims 38-42 depend (and because those dependent claims are necessarily valid if claim 37 is valid), the Court will focus its attention on claim 37. Claim 37 describes:

An improved single stage snowthrower, which comprises:

(a) a housing which includes a generally open front portion defined by spaced side walls connected together by a rear wall, wherein the open front portion includes an upper edge;

(b) a rotatable snowthrowing impeller extending between the side walls and located in front of the rear wall, wherein the impeller comprises a central snowthrowing section and two end sections located on each side of the central section, wherein each end section comprises auger means for feeding snow inwardly onto the central section;

(c) an upwardly extending snow collecting chamber located on the rear wall of the housing and having a lower end disposed beneath the upper edge of the housing; and

(d) two downwardly facing ledges located on the rear wall of the housing beneath the upper edge of the housing, wherein the ledges are positioned on each side of the snow collecting chamber to lie above the end sections of the impeller.

('726 Patent, column 18, lines 37-58.) Toro focuses on element (d) of claim 37, arguing that there is nothing in the prior art describing such a claim. The Court agrees that Ariens has cited no prior art that includes each and every element of claim 37 and, accordingly, finds that claim 37, as well as claims 38-42, which are dependent on it, are not anticipated by the prior art.

The Davies '092 Patent does not describe "two downwardly facing ledges located on the rear wall of the housing beneath the upper edge of the housing," because the "ledges" (if they can be considered ledges) in the '092 Patent are themselves a part of the housing and constitute the upper edge of the housing. (*See* Husmann Aff. Ex. 4 ('092 Patent).) Ariens argues that the '726 Patent defines the term "upper edge" in a particular manner and, therefore, the "ledges" in the '092 Patent are "beneath the upper edge of the housing". (*See* Def.'s Opp'n Invalidity Mem. at 12-14.) The Court disagrees with this contention. No evidence suggests that the '726 Patent defines "upper edge" in any manner inconsistent with its ordinary meaning, and the Court finds that the "ledges" in the '092 Patent were a part of the housing. (*See* Husmann Aff. Ex. 4.) To argue that, even though the ledges constitute part of the upper edge of the housing, they are also "beneath the upper edge of the housing," defies logic. Claim 37 does not refer to the highest point on the housing, as Ariens would like the Court to read it, but instead to the upper edge of the housing.

The Vachon '989 Patent describes a device with only one ledge, and does not require "two downwardly facing ledges ... positioned on each side of the snow collecting chamber," as claim 37 does. (*See* Husmann Aff. Ex. 6 ('989 Patent).) Ariens argues that the single ledge described in the '989 Patent should be considered to be two ledges on either side of the chamber with a connector between them. (*See* Def.'s Opp'n Invalidity Mem. at 15.) Toro characterizes this argument and the argument about the '092 Patent as "semantic gymnastics" and the Court agrees. Ariens has presented no evidence suggesting that the '989 Patent describes anything other than-or has ever been read to describe anything other than-what it appears to describe: a single ledge extending from one side of the device to the other. Because the '726 Patent describes "two downwardly facing ledges ... positioned on each side of the snow collecting chamber," it is not anticipated by the '989 Patent. Similarly, none of the other prior patents cited by Ariens describes "two downwardly facing ledges ... positioned on each side of the snow collecting chamber."

Because Ariens has failed to identify any prior art that contained each element of claim 37, that claim cannot be said to have been anticipated by the prior art. Because claims 38-42 are dependent on claim 37, none of them are anticipated by the prior art either.

2. The "Written Description" Requirement of s. 112, para. 1

Ariens argues that claims 36-41, which are reissue claims, are invalid because they are broader than allowed by the original patent specification, in violation of 35 U.S.C. s. 112, para. 1. (Def.'s Supp. Invalidity Mem. at 8-15.) In Gentry Gallery, Inc. v. Berkline Corp ., 134 F.3d 1473 (Fed.Cir.1998), the Federal Circuit interpreted s. 112, para. 1, and reversed the district court's determination that the claims at issue were valid. Paragraph 1 of s. 112 provides that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. 112, para. 1. In *Gentry Gallery,* the Federal Circuit held that, while a claim is not limited to the preferred embodiment included in the specification, "in a given case, the scope of the right to exclude may be limited by a narrow disclosure." Gentry Gallery, 134 F.3d at 1479.

Ariens alleges that, when Toro obtained the reissue patent that included claims 36-42, it exceeded the limits of the original specification and, therefore, this Court should hold that those claims are invalid. Toro responds that the inventor of the '726 Patent "had possession of" the later claimed matter, and the specification reveals this. If the specification describes an invention in sufficient detail that one skilled in the art could clearly conclude that the inventor had possession of the claimed invention as of the filing date, then the written description requirement of s. 112, para. 1 is satisfied. Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572 (Fed.Cir.1997).

Ariens contends that, because claims 36-41 do not refer to a *curved* central snowthrowing section, those claims constitute an impermissible broadening of the original specification. For support, it relies almost exclusively on *Gentry Gallery*. In that case, however, the original disclosure was much narrower than in the instant case. The patentee in *Gentry Gallery* had obtained a patent for a sectional sofa with side-by-side recliners that were separated by a control console. Id., 134 F.3d at 1474-75. The original disclosure

clearly identifie[d] the console as the only possible location for the controls. It provide[d] for only the most minor variation in the location of the controls, noting that the control "may be mounted on top or side surfaces of the console rather than on the front wall ... without departing from this invention."

Id. at 1479. In the instant case, there is no comparably narrow limitation, and claim 37 does not describe something that was expressly excluded from the original specification. Accordingly, the Court finds *Gentry Gallery* inapposite to the instant case, and finds that the original specification described the invention in sufficient detail as to convey that Toro was in possession of the invention claimed in its reissue application. Accordingly, the Court holds that claim 37, and all claims dependent thereon, comply with the "written description" requirement of s. 112, para. 1.

3. Requirements for Reissue Patents

The final issues raised by Ariens on the issue of invalidity of the claims are Toro's alleged failure to comply with the requirements of the reissue statute, 35 U.S.C. s. 251, and Toro's alleged inability to show the necessary "error" that is a prerequisite to obtaining a reissue patent. To obtain a reissue patent, an applicant must show that an error was committed in the application process without deceptive intent and that, as a result, the patent issued is defective because the patentee received either more or less than it had a right to claim. *See* 35 U.S.C. s. 251; In re Wilder, 736 F.2d 1516, 1518 (Fed.Cir.1984).

Ariens argues that Toro cannot show "error" with regard to claims 36-41 because the overly narrow nature of the claims came to its attention only after competitors began to manufacture snowthrowers that fell outside of the scope of Toro's original claim. This, argues Ariens, cannot constitute the "error" required by s. 251. (Def.'s Supp. Invalidity Mem. at 17-21.) Toro does not dispute that it made this discovery after seeing its competitors' products, but argues that this is irrelevant to a determination of "error" under s. 251. (Pl.'s Opp'n Invalidity Mem. at 3-8.) Section 251 provides, in relevant part, that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a deceptive specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall ... reissue the patent for the new invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

35 U.S.C. s. 251. Where the patentee or the patentee's attorney fails, in the original application, to appreciate the scope of the claimed invention until after the patent is granted, such a mistake can constitute the required error. *See* In re Wilder, 736 F.2d 1516, 1519 (Fed.Cir.1984); *see also* Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1575 (Fed.Cir.1991) (holding that s. 251 contains no requirement that the error have been unavoidable, and recognizing that attorney error can suffice). In *Wilder,* the Federal Circuit reversed the decision by the United States Patent and Trademark Office Board of Appeals that the failure of the patentee's attorney to appreciate the scope of the invention could not constitute error, as required by s. 251. Wilder, 736 F.2d at 1519. The *Wilder* Court stated:

The error provision of 35 U.S.C. s. 251 is to be liberally construed to permit correction of defects. An attorney's failure to appreciate the full scope of the invention is one of the most common sources of defects in patents. The fact that the error could have been discovered at the time of prosecution with a more thorough patentability search or with improved communication between the inventors and the attorney does

not, by itself, preclude a patent owner from correcting defects through reissue. In this case, the attorney's error was discovered after commercialization of the invention and issuance of the patent. An application for broader claims was filed within two years after the original patent issued. Under these circumstances, the attorney's explanation of his error in misunderstanding the scope of the invention is sufficient to satisfy the error requirement of 35 U.S.C. s. 251.

Id. Ariens has failed to distinguish *Wilder* in any meaningful way, but insists that the reasons given by Toro for its failure to claim the original patent more broadly cannot constitute error. Because the Court finds that *Wilder* controls the instant case, it holds that Toro made the requisite showing of error under s. 251.

Finally, Ariens argues that Toro failed to comply with the requirements of s. 251 and of 37 C.F.R. s. 1.175, that reissue applicants "[p]articularly specify[ ] the errors relied upon, and how they arose or occurred" and that they, "[w]hen it is claimed that [the] patent is inoperative or invalid 'by reason of the patentee claiming more or less than he had a right to claim in the patent,' distinctly specify[ ] the excess or insufficiency in the claims." *See* 37 C.F.R. s. 1.175(a)(3) & (5) (since amended to eliminate both requirements, *see* 37 C.F.R. s. 1.175 (1998)). In support of this argument, Ariens relies exclusively on the recent Federal Circuit case, Nupla Corp. v. IXL Mfg. Co., Inc., 114 F.3d 191 (Fed.Cir.1997). In *Nupla,* the Federal Circuit stated that a reissue applicant must " 'specify every difference between the original and reissue claims." ' Id., 114 F.3d at 193 (quoting In re Constant, 827 F.2d 728, 729 (Fed.Cir.1987)). The court went on, however, to state that the reissue declaration was insufficient in that case because, while it explained only one difference in scope between the original and the reissue claims, "there were actually three *material differences* in scope." *Id*. at 194 (emphasis added). The Court finds that the language in *Nupla* stating that a reissue applicant must specify *every* difference must be considered dicta, because the basis for the *Nupla* court's decision was the applicant's failure in that case to explain *material* differences. In the instant case, Ariens has presented the Court with no evidence of any material difference between the original and the reissue claims and, therefore, it has not shown that Toro failed to comply with either 35 U.S.C. s. 251 or 37 C.F.R. s. 1.175 when it applied for the '726 reissue patent. Accordingly, the Court rejects Ariens' argument with regard to Toro's alleged failure to satisfy the legal requirements for reissue patents.

Because Ariens has failed to create a genuine issue of material fact with regard to any of its asserted grounds for the invalidity of claims 37-42, the Court will deny its Motion for Summary Judgment on the Issue of Invalidity with regard to those claims. Similarly, because no genuine issue of material fact exists on this question, the Court will grant Toro's Cross-Motion for Summary Judgment that its Patent is Not Invalid Under 35 U.S.C. s.s. 102 or 112, para. 1. Because Ariens has failed to respond to Toro's arguments regarding the validity of claims 8, 20, 24-27, and 31-35, the Court will grant Toro's Motion for Summary Judgment that its Patent is Not Invalid Under 35 U.S.C. s.s. 102 or 112, para. 1 with regard to those claims as well. Finally, because the Court holds that Ariens is entitled to summary judgment on the issue of infringement with regard to claim 36, the Court will not reach the issue of the validity *vel non* of that claim.

D. Ariens' Motion for Summary Judgment on the Issue of Non-Willfulness

Ariens contends that any infringement on its part was not willful, and that it is entitled to summary judgment on that issue, because Toro has presented no clear and convincing proof of willful infringement and, therefore, no reasonable jury could find willfulness. Toro first takes issue with Ariens' characterization of the applicable standard at the summary judgment stage, arguing that Toro is required only to show that there is a genuine issue of material fact, rather than to present clear and convincing evidence in its favor. (*See* Pl.'s Opp'n Willfulness Mem. at 5-6.) More substantively, Toro contends that it has presented evidence that

Ariens copied Toro's design and that Ariens disregarded the legal opinion it obtained from its patent counsel, both of which constitute evidence of bad faith and willful infringement. (*See* id . at 7-8.)

As an initial matter, the Court finds that both parties are correct on the standard applicable to the instant Motion, and that there is no actual disagreement between them on this issue. Ariens, the movant, must show that there is no genuine issue of material fact in dispute. Fed.R.Civ.P. 56. Ariens is entitled to summary judgment if it can show that no reasonable jury could make a finding of willfulness. Because willfulness must be proved by clear and convincing evidence, Ariens is entitled to summary judgment if it can show that no reasonable jury could find willfulness *by that standard*. *See* Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1057 (Fed.Cir.1994); American Med. Sys., Inc. v. Medical Eng'g Corp., 6 F.3d 1523, 1530 (Fed.Cir.1993).FN6

FN6. Even if the applicable standard on this Motion were "by a preponderance of the evidence," the Court would grant the Motion because Toro has failed to show that any genuine issue of material fact exists with regard to willfulness, even under that more liberal standard.

Wilfulness is "a factual determination to be made after consideration of the totality of the circumstances." American Med. Sys., 6 F.3d at 1530. "A finding of willfulness requires the fact-finder to find that clear and convincing evidence shows 'that the infringer acted in disregard of the patent ... [and] had no reasonable basis for believing it had a right to do the acts." ' *Id*. (quoting Stickle v. Heublein, Inc., 716 F.2d 1550, 1565 (Fed.Cir.1983)) (alterations in original).

In support of its position that Ariens willfully infringed the '726 Patent, Toro makes two allegations: (1) that Ariens copied Toro's patented product; and (2) that Ariens disregarded one of the opinions that it had received from its patent counsel on the issue of infringement and concealed information from its patent counsel. (*See* Pl.'s Opp'n Willfulness Mem. at 7-8.) Toro has presented evidence that Ariens examined Toro's products and patents and attempted to design its product around them in order to avoid infringement. (*See* Bullis Dep. at 39, 129-31.) After it completed a proposed design, Ariens obtained a written opinion from its patent counsel that the proposal would not infringe the '726 Patent. (Husmann Aff. Ex. 20 (9/30/94 Gemignani opinion letter).) Ariens then modified its proposed design, and obtained a second opinion from its patent counsel, which again stated that the proposed design would not infringe the '726 Patent. (Id. Ex. 21 (10/17/95 Gemigmiani opinion letter).) Toro argues that this second opinion was flawed because Ariens concealed information about design changes from its patent counsel. (*See* Pl.'s Opp'n Willfulness Mem. at 4-5.)

The Court finds that Toro has presented no evidence, however, to support its claim that "Ariens *lied* to [its counsel] and *concealed* the fact that the impeller had been modified." (*See* id. at 8) (emphasis added.) At best, it has presented evidence that Ariens modified its impeller after Gemignani rendered his *first* opinion of non-infringement. In response to Toro's request for documentation received by Gemignani "in connection with either the 1994 or the 1995 written opinions," however, Ariens produced a drawing dated 12/21/94 that unambiguously reflects the change about which Toro now complains. (Margolies Aff. Ex. 2 at MBF 0011 (Response to Plaintiff's First Request for Production of Documents and Things).) Moreover, even if the Court were to find that Toro has presented evidence that Gemignani was unaware of this change at the time he rendered his second opinion, Toro has failed to show how the change was material, whether it affected the reasonableness of Gemignani's opinion of non-infringement, and how it has any bearing on the issue of willfulness. FN7

FN7. Significantly, the modification about which Gemignani was allegedly unaware dealt with the length of the flat central section of the impeller. The Court has already granted summary judgment in favor of Ariens, however, on each issue that has to do with the impeller. The only claims that remain as a part of this action are claims 37-42, and the only issues that remain in dispute are the construction of the term "ledges" in claim 37 and whether the accused product infringes those claims that describe the "ledges."

Even viewing all evidence in the light most favorable to Toro, the Court finds that Ariens is entitled to summary judgment on the issue of willfulness. Toro's evidence of "copying" is more properly characterized as an attempt by Ariens to design around existing patents, a practice that the Federal Circuit encourages. *See* Westvaco Corp. v. International Paper Co., 991 F.2d 735, 745 (Fed.Cir.1993) (collecting cases); *see also* London v. Carson Pirie Scott & Co., 946 F.2d 1534, 1538 (Fed.Cir.1991) ("[D]esigning or inventing around patents to make new inventions is encouraged.") On the issue of the opinions obtained from Ariens' patent counsel, as explained above, Toro's allegations of "concealment" are not supported by evidence in the record, and the Court finds that Toro has created no genuine issue of material fact with regard to the competence of Gemignani's opinions of non-infringement or the reasonableness of Ariens' reliance thereon.

Based on the evidence presented by Toro, the Court finds that no reasonable jury could determine by clear and convincing evidence that Ariens willfully infringed the '726 Patent. Accordingly, the Court will grant Ariens' Motion for Summary Judgment of Non-Willfulness.

Conclusion

For the foregoing reasons, and based upon all of the files, records and proceedings herein, IT IS ORDERED that:

(1) Ariens' Motion for Summary Judgment of Non-Infringement (Doc. No. 62) is GRANTED IN PART, with respect to claims 8, 20, 24-27, and 31-36; and is DENIED IN PART, with respect to claims 37-42;

(2) Ariens' Alternative Motion for Summary Judgment of Invalidity (Doc. No. 62) is DENIED;

(3) Toro's Motion for Summary Judgment that its Patent is Not Invalid Under 35 U.S.C. s.s. 102 or 112, para. 1 (Doc. No. 44) is GRANTED;

(4) Toro's Motion for Summary Judgment that Ariens Infringes Claim 37 (Doc. No. 44) is DENIED; and

(5) Ariens' Motion for Summary Judgment of Non-Willfulness (Doc. No. 62) is GRANTED.

IT IS FURTHER ORDERED that each party shall submit to the Court by September 30, 1998 materials in anticipation of a *Markman* hearing to be held prior to trial FN8 for the purposes of construing claims 37-41 of the '726 Patent: a memorandum of law not to exceed ten pages, a detailed narrative summary of the evidence to be presented, a witness list, an exhibit list, a proposed definition of the disputed term, and proposed constructions of claims 37-42 that are suitable for presentation to a jury. The parties' Cross-Motions for Summary Judgment on the Issue of Infringement of claims 37-42 are DENIED WITHOUT PREJUDICE.

FN8. A trial date, and a date for submission of trial materials, will be established following the *Markman* hearing; paragraph 2 of the Court's May 22, 1998 Order (Doc. No. 55) may be disregarded.

D.Minn.,1998.
Toro Co. v. Ariens Co.

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