United States District Court,
W.D. Texas, San Antonio Division.

Gene A. VOSS,
Plaintiff/Counterclaim Defendant.
v.
DUPACO, INC,
Defendant/Counterclaim Plaintiff.

Civil Action No. SA-01-CA-51-OG

Dec. 6, 2001.

David G. Henry, Naman, Howell, Smith & Lee, Waco, TX, for Plaintiff/Counterclaim Defendant.

W. Bradley Barnes, Cox & Smith Incorporated, San Antonio, TX, Susan B. Meyer, John L. Haller, Brown Martin Haller & McClain, L.L.P. , San Diego, CA, for Defendant/Counterclaim Plaintiff.

REPORT AND RECOMMENDATION

PAMELA A. MATHY**, Magistrate Judge.**

TO: ORLANDO L. GARCIA

United States District Judge

Pursuant to the Order of referral in the above-styled and numbered cause of action to the undersigned United States Magistrate Judge FN1 and consistent with the authority vested in United States Magistrate Judges under the provisions of 28 U.S.C. s. 636(b)(1)(B) and rule 1(d) of the Local Rules for the Assignment of Duties to United States Magistrates, effective January 1, 1994, in the Western District of Texas, this report concerns the evidentiary hearing on claim construction and addresses defendant's motion for partial summary judgment of non-infringement.

FN1. Docket no. 8.

I. *JURISDICTION*

The Court has jurisdiction over plaintiff's claims that defendant has infringed its patent, 28 U.S.C. s.s. 1331, 1338(a) and 2201(a), and over defendant's counterclaim for declaratory judgment that plaintiff's patent is invalid and not infringed by defendant, 28 U.S .C. s.s. 1338(a), 2201 and 2202. Venue is proper under 28 U.S.C. s. 1400(b).

II. *PROCEDURAL HISTORY*

This case concerns claims of alleged patent infringement. On January 17, 2001, plaintiff Gene A. Voss ("Voss") filed his complaint alleging that defendant Dupaco, Inc. ("defendant" or "Dupaco") is infringing one of his patents, United States Patent No. 4,752,064, entitled "Therapeutic Head Support" ("'064 patent"), through its manufacture, use, sale, offer for sale and/or importation of therapeutic head supports.FN2 Voss requests injunctive relief, treble damages, costs and attorneys fees. A jury trial is demanded.

FN2. Docket no. 1.

On April 16, 2001, defendant filed its combined answer and counterclaims. FN3 Dupaco admits subject matter and personal jurisdiction, admits that it makes, uses, offers for sale and sells in the United States a head support identified as the "Dupaco ProneView Protective Helmet System" ("ProneView") and denies the claim of infringement. Dupaco's answer alleges ten affirmative defenses and a counterclaim for declaratory judgment that Dupaco has not infringed any claims of the ' 064 patent, that every claim of the ' 064 patent is invalid, and that the ' 064 patent is unenforceable. With respect both to its defense of Voss' claim of infringement and its counterclaim, Dupaco requests attorneys fees and costs. Dupaco demands trial by jury on its counterclaim. On May 7, 2001, Voss filed his answer to the counterclaim. FN4

FN3. Docket no. 3.

FN4. Docket no. 4.

On June 25, 2001, this case was referred to the undersigned for pretrial management.FN5 On July 2, 2001, the Court entered an Order inviting the submission of proposed scheduling recommendations from the parties within sixty days of the first appearance of any defendant, as provided in the Local Rules. FN6 When no scheduling recommendations were submitted within the time provided, the Court entered a scheduling Order on July 24, 2001 which, among other deadlines, established January 14, 2002 as the discovery cut-off date and February 13, 2002 as the deadline for submission of dispositive motions. FN7 On August 14, 2001, the parties submitted an agreed protective Order. FN8

FN5. Docket no. 8.

FN6. Docket no. 9.

FN7. Docket no. 10.

FN8. Docket nos. 11 and 13.

On September 21, 2001, Dupaco tendered for filing its motion for partial summary judgment of non-infringement of the '064 patent.FN9 The motion, memorandum in support, appendix and notice of tendering a sample of the Dupaco ProneView product were filed September 24, 2001.FN10

FN9. Docket no. 19.

FN10. Docket nos. 19, 20, 21 and 22.

Because Dupaco's motion for partial summary judgment is premised on a construction of the claims in the '064 patent,FN11 on September 28, 2001, the Court entered an Order which, in sum, called upon plaintiff to file a response to the motion for summary judgment; given that defendant had addressed claim construction in connection with its motion, requested that plaintiff address matters relating to construction of the claims in the ' 064 patent in his response; required the submission of a joint claim construction statement; and scheduled a claims construction hearing for November 27, 2001. The Order recognized that defendant had not yet presented a claim construction statement with respect to its counterclaim that the ' 064 patent is invalid and unenforceable (issues not raised in the pending motion for partial summary judgment).FN12

FN11. Docket no. 20 at 5-10 and 12-19.

FN12. Docket no. 23.

On October 9, 2001, Voss filed his claim construction statement.FN13 On October 10, 2001, Voss filed his response to the motion for partial summary judgment.FN14 Voss asserts literal infringement of claim 1 of the ' 064 patent FN15 and that it is "entitled to doctrine of equivalents consideration, in the event that literal infringement is not found" under *Festo Corp*.FN16 Voss argues, in sum, that the motion for partial summary judgment on the non-infringement of the "clamping means" limitation and the "means for adjusting the orientation of the mirror" limitation must fail because there are genuine issues of material fact that Dupaco's ProneView satisfies the "clamping means" limitation and the "means for adjusting the orientation of the mirror" by literal infringement or under the doctrine of equivalents.FN17 On October 22, 2001, Dupaco filed its reply.FN18

FN13. Docket no. 24.

FN14. Docket no. 27.

FN15. Docket no. 24 at 2.

FN16. *Id*. *See* Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co. Ltd., 234 F.3d 558 (Fed.Cir.2000).

FN17. Docket no. 27 at 3.

FN18. Docket no. 32.

On November 27, 2001, the Court held a claims construction hearing. Prior to the hearing, the parties filed their joint claim construction statement. FN19 Only one witness testified in person at the claims construction hearing: plaintiff called the inventor of the ' 064 patent, Dr. Gene A Voss, M.D. Plaintiff also introduced nine exhibits, consisting of the patent in suit, its prosecution file, and seven dictionary definitions. Defendant called no live witnesses and introduced no exhibits but asked the Court, in connection with claims construction, to take notice of the exhibits attached to the declaration of Edward Callan, that is, copies of Mr. Callan's resume, the patent in suit, its file history, a copy of the references cited in the patent and/or its prosecution file, and photographs of the accused device.FN20 At the conclusion of the hearing, the Court took the matter under advisement, pending issuance of a report to the District Court.

FN19. Docket no. 34.

FN20. Docket no. 21, Attachment, Declaration of Edward Callan and its exhibits.

In this report, the undersigned proposes a claim construction of the ' 064 patent FN21 and makes a recommendation regarding the District Court's disposition of defendant's motion for partial summary judgment of non-infringement.

FN21. The parties do not contest claim construction apart from certain elements of claim 1 of the '064 patent. *See, generally,* docket nos. 20, 24, 27, 32 and 34.

With respect to infringement, although Dupaco moved for partial summary judgment of infringement of claims 1, 2 and 3 of the '064 patent, Voss' response states that, pending further discovery, "Voss now only advocates the position that claim 1 of the '064 patent is infringed" (docket no. 24 at 2) and Voss did not respond to partial summary judgment of non-infringement on claims 2 and 3. At the beginning of the claims construction hearing, Voss confirmed that he had waived his argument of infringement of claims 2 and 3. Therefore, this report recommends that Dupaco's motion for partial summary judgment of non-infringement of claims 2 and 3 should be *granted* or, in the alternative, that Voss' responses and representations should be construed as a motion to dismiss his claims of infringement of claims 2 and 3 and that said motion should be *granted* with prejudice.

III. *ISSUES*

1. What is the proper construction of claim 1 in the '064 patent?

2. Is there a genuine issue of material fact with respect to the issue of infringement of claim 1 of the '064 patent, or may judgment be entered on the issue of non-infringement?

IV. *STANDARDS*

A. *Claim Construction*

1. *Timing*

An infringement analysis consists of two steps. First, the court addresses, as a matter of law, the correct meaning and scope of the claims. Second, the court compares the properly construed claims to the accused device in order to determine, as a matter of fact, whether all claim limitations are present, either literally or by a substantial equivalent, in the accused device. FN22

FN22. Johnson v. Worldwide Associates, Inc. v. Zebco, Corp., 175 F.3d 985, 988 (Fed.Cir.1999).

Claim construction is a question of law for the court.FN23 The *Markman* decision established a court's obligation to instruct the jury on the meaning of words used in a claim.FN24 In this case, it is necessary to construe disputed claim terms in the ' 064 patent in connection with the recommended disposition of the partial summary judgment issues since the way in which a patent claim is construed often affects the determination of whether there is a genuine issue of material fact as to whether the patent has been infringed.FN25

FN23. Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995)(*en banc), aff'd* 517 U.S. 370, 116 S.Ct. 1384 (1996).

FN24. Elf Atochem v. Libbey Owens Ford Co., 894 F.Supp. 844, 850 (D.Del.1995)

FN25. *See e.g.,* Loral Fairchild Corp. v. Victor Co. of Japan, Ltd., 911 F.Supp. 76, 79 (E.D.N.Y.1996) ("The meaning of claim terms is the central issue of patent litigation. With most aspects of the trial hinging on this determination-now strictly a question of law for the court-a conscientious court will generally endeavor to make this ruling before trial.") (two-day evidentiary hearing); Neles Jamesbury, Inc. v. Fisher Controls International, Inc., 989 F.Supp. 393 (D.Mass.1998) (threeday hearing); Comark Communications, Inc. v. Harris Corp., 1997 WL 87260 at (E.D.Pa. Feb. 24, 1997)(two-day evidentiary hearing); Elf Atochem, 894 F.Supp. 844 (two-day evidentiary hearing).

2. ***Priority of Evidence***

Claims are construed from the vantage point of a person of ordinary skill in the art at the time of the invention.FN26 In construing a claim, a court looks first to the intrinsic evidence of record, namely, the patent itself, including the language of the claims, the specification, and, if in evidence, the prosecution history.FN27 The first step in claim construction is an examination of the claim language itself. "A construing court does not accord the specification, prosecution history, and other relevant evidence the same weight as the claims themselves, but consults these sources to give the necessary context to the claim language." FN28 Terms used in the claim are to be given their ordinary and customary meaning "unless another meaning is specified or is evident from the patent history." FN29 The specification "acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication" FN30 and is the "single best guide to the meaning of a disputed term." FN31 The patentee may act as his or her own lexicographer and may use terms in a manner other than their ordinary meaning, so long as the special definition of such terms are stated in the patent specification or file history." FN32 The Court recognizes that there is presumed to be "a difference in meaning and scope when different words or phrases are used in

separate claims." FN33 There is a presumption against construing claims as being so similar as to "make a claim superfluous." FN34

FN26. Markman, 52 F.3d at 986.

FN27. Insituform Tech., Inc. v. Cat Contracting, Inc., 99 F.3d 1098, 1105 (Fed.Cir.1996); Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996).

FN28. Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1555 (Fed.Cir.1997).

FN29. Storer v. Hayes Microcomputer Prod., Inc., 960 F.Supp. 498, 501 (D.Mass.1997); Vitronics, 90 F.3d at 1584.

FN30. Vitronics, 90 F.3d at 1582.

FN31. *Id*.

FN32. *Id*.

FN33. United States v. Telectronics, Inc., 857 F.2d 778, 783 (Fed.Cir.1988).

FN34. *Id*.

In interpreting the claim and specification, the construing court interprets words "as one of skill in the art at the time of the invention would understand them." FN35 Although the Federal Circuit has held that claims should be read in view of the specification,FN36 the Court repeatedly has cautioned against limiting the scope of a claim to the preferred embodiment or specific examples disclosed in the specification.FN37 The "court should also consider the patent's prosecution history ... in order to ascertain the true meaning of the language used in the patent claim." FN38

FN35. Eastman Kodak, 114 F.3d at 1555.

FN36. Hoechst Celanese Corp. v. BP Chemicals, Ltd., 78 F.3d 1575, 1582 (Fed.Cir.), *cert. denied,* 117 S.Ct. 275 (1996).

FN37. *See e.g.,* Ekchian v. Home Depot, Inc., 104 F.3d 1299, 1303 (Fed.Cir.1997); Interveet America, Inc.

v. Kee-vet Laboratories, Inc., 887 F.2d 1050, 1053 (Fed.Cir.1989) ("[L]imitations appearing in the specification will not be read into claims, and ... interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper' " (citation omitted)).

FN38. Markman, 52 F.3d at 979-80; *see also* Hoechst Celanese Corp., 78 F.3d at 1579 and Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 452 (Fed.Cir.1985) ("The prosecution history (or file wrapper) limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance").

Claims and interpretation of the prosecution history is undertaken to sustain the validity of the claims, if possible, short of actually redrafting the claims.FN39 "The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." FN40 The figures in a patent may be considered "in the same manner and with the same limitations as the specification." FN41

FN39. Eastman Kodak Co., 114 F.3d at 1547.

FN40. Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed.Cir.1998).

FN41. Autogiro Co. v. U.S., 384 F.2d 391, 398 (Ct.Cl.1967).

In its discretion and if the intrinsic evidence is ambiguous, the court may also look at extrinsic evidence to assist in construing a patent claim-testimony from inventors and expert witnesses, dictionary definitions and treatises.FN42 Reliance on any extrinsic evidence to construe the meaning and scope of a patent claim is improper where the public record, that is, the claims, specification, and file history unambiguously defines the scope of the claims.FN43 Competitors have the right to look at the public record and attempt to "invent or design around" a claimed invention.FN44 That right would be hollow if expert testimony or other extrinsic evidence could alter that record. To understand the patent, however, the court may consult extrinsic evidence, such as technical treatises and dictionaries in conjunction with the public record so long as these secondary sources do not vary or contradict anything in the patent documents.FN45 Extrinsic evidence may be used only to aid the court in understanding the claim, not to broaden the scope of the patent or to contradict the claim language, the specification or the prosecution history.FN46

FN42. Markman, 52 F.3d at 980 and 116 S.Ct. at 1396.

FN43. Pitney Bowes, Inc. v. Hewlett Packard Co., 182 F.3d 1298, 1308 (Fed.Cir.1999) (" *Vitronics* does not prohibit courts from examining extrinsic evidence even when the patent document is itself clear ... Certainly, there are no prohibitions in *Vitronics* on courts hearing evidence from experts. Rather, *Vitronics* merely warned courts not to *rely* on extrinsic evidence in claim construction to contradict the meaning of claims discernible from thoughtful examination of the claims, he written description, and the prosecution

history-the extrinsic evidence.") (citations omitted; emphasis in original); Trilogy Communications v. Times Fiber Communications, 109 F.3d 739, 742, 744 (Fed.Cir.1997) (in construing claims the court should look to the claims language, the specification, the prosecution history, and extrinsic evidence only if necessary); Vitronics, 90 F.3d at 1583.

FN44. *Id*.

FN45. Hoechst Celanese Corp., 78 F.3d at 1579. *See also* EndressHauser, Inc. v. Hawke Measurement System Pty., Ltd., 122 F .3d 1040, 1042 (Fed.Cir.1997) (district court's interpretation of means-plus-function claim upheld: "[A]s we made abundantly clear in *Markman,* the trial court has wide latitude in the kinds of aids, including testimony of witnesses, employed to assist in the job of claim interpretation as a matter of law."); Fromson v. Antitec Printing Plates, Inc., 132 F.3d 1437, 1442-45 (Fed.Cir.1997) (Federal Circuit upheld district court's claim interpretation based on intrinsic evidence and expert testimony: "Although *Markman* presents a useful general rule, it is adaptable to the needs of a particular case. In this case technical experts not only aided the court's understanding of technology, but also provided evidence material to the interpretation of the claims.")

FN46. Vitronics, 90 F.3d at 1584-85; Bell and Howell Document Management Prods. Co. v. Altek Systems, 132 F.3d 701, 707 (Fed.Cir.1997).

It is well established that "claims must be interpreted and given the same meaning for purposes of both validity and infringement analyses." FN47 *Markman* has led some courts to decline to consider prior art in interpreting claim language, reserving all such issues for the separate inquiry into validity.FN48 This report fully considers the prosecution history of the ' 064 patent to the extent that references to prior art are cited as to reasons why claims originally submitted may have been rejected.FN49 Otherwise, because Dupaco has moved for partial summary judgment only on the issue of infringement and not on validity and because Dupaco filed its motion prior to the expiration of the discovery deadline, the Court does not further consider prior art. All arguments on validity are reserved to the proper time.

FN47. Kegel Co., Inc. v. AMF Bowling, Inc., 127 F.3d 1420, 1429 (Fed.Cir.1997).

FN48. *See* Elf Atochem, 894 F.Supp.at 859-60 (court declined to review prior art during claim construction, in order to avoid interpreting the prior art as a matter of law); Haney v. Timesavers, Inc., 900 F.Supp. 1375, 1376-77 (D.Or.1995) (if prior art diminishes or varies claim language the certainty that patent statutes provide to the public would be destroyed; prior art is relevant to validity, a jury question, and not claim construction); Stairmaster Sports/Med. Prods. Inc v. Groupe Procycle, Inc., 1998 WL 290296 at (D.Del. May 20, 1998) (court refuses to entertain issues of invalidity, noting that the Federal Circuit "has consistently rejected this approach to claim construction and continues to draw a line between claim construction issues and issues of infringement and validity"); *c.f.* Stairmaster Sports/Med. Prods. Inc v. Groupe Procycle, Inc., 25 F.Supp.2d 270 (D.Del.1998), *aff'd* in unpublished opinion, 232 F.3d 909 (Fed.Cir.2000).

FN49. Interactive Gift Express, Inc. v. Compuserve, Inc., 256 F.3d 1323, 1331 (Fed.Cir., 2001) ("First, we look to the claim language.... Then we look to the rest of the intrinsic evidence, beginning with the specification and concluding with the prosecution history, if in evidence.) (citations and quotations omitted).

In this report, the Court looks to intrinsic evidence-the patent itself, including the claims, the specification and prosecution history-in defining the disputed claims.FN50 The Court has accorded the disputed terms their plain and customary meaning to one of ordinary skill in the relevant art at the time of the invention,FN51 unless it is found to be clear from the specification and the prosecution history that the inventor accords the term an alternate meaning.FN52 Thus, the Court has reviewed claim 1 which is at issue, the surrounding claims 2 and 3, the written description, drawings and specification. The portions of the prosecution history in evidence also been reviewed and considered. The Court gives only limited consideration of "extrinsic" evidence, as noted expressly in this report, such as the noted references to dictionary definitions of words, or to address the parties' contentions about the claims, but not to "vary or contradict the claim language" or to "contradict the import of other parts of the specification." FN53 An inventor's testimony is considered to be extrinsic evidence; a patent is to be interpreted by what it states an not an inventor's after-the-fact testimony as to his subjective intent.FN54

FN50. Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 28-30, 117 S.Ct. 1040, 1048-50 (1997) (claims define the invention); Renishaw PLC, 158 F.3d at 1248 (claim analysis "begins and ends in all cases with the actual words of the claim").

FN51. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.,* 175 F.2d 985, 988 (Fed.Cir.1999).

FN52. Hoechst Celanese Corp., 78 F.3d at 1578.

FN53. Vitronics, 90 F.3d at 1584.

FN54. *E.g.,* Engel Indus., Inc. v. Lockformer, Co., 96 F.3d 1398 (Fed.Cir.1996) (subjective intent of little or no probative weight, except as documented in prosecution history); Roton Barrier, Inc. v. Stanley Works, 79 F.3d 1112 (Fed.Cir.1996) (reliance on inventor's earlier published work to interpret scope of patent claims harmless error).

B. ***Summary Judgment Standard***

The standard to be applied in deciding a motion for summary judgment is set forth in Federal Rule of Civil Procedure 56, which provides in pertinent part as follows:

The judgment sought 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 judgment as a matter of law. FN55

FN55. FED. R. CIV. P. 56(c); Celotex Corp. v. Catrett, 477 U . S. 317, 322, 106 S.Ct. 2548, 2552 (1986).

The summary judgment movant bears the initial burden of providing the court with a legal basis for its motion and identifying those portions of the record which it alleges demonstrate the absence of a genuine issue of material fact. FN56 The movant must establish that if the evidence of record "were reduced to admissible evidence in court," the evidence would be insufficient to allow the opposing party to carry its burden.FN57

FN56. Celotex Corp., 477 U.S. at 323, 106 S.Ct. at 2553.

FN57. Id. at 327, 106 S.Ct. at 2555; Beck v. Texas State Bd. of Dental Examiners, 204 F.3d 629, 633 (5th Cir.), *cert denied,* 531 U.S. 871 (2000).

If the movant satisfies this burden, then the nonmovant "must set forth specific facts showing a genuine issue for trial and may not rest upon mere allegations or denials of its pleadings." FN58 Rule 56 requires that there be no genuine issue of material fact.FN59 A fact is material if it might affect the outcome of the lawsuit under the governing law.FN60 More than a "metaphysical doubt as to the material facts" is required.FN61 A dispute about a material fact is genuine if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.FN62 Therefore, summary judgment is proper if, under governing laws, there is only one reasonable conclusion as to the verdict; if reasonable finders of fact could resolve a factual issue in favor of either party, summary judgment should not be granted.FN63

FN58. Beck, 204 F.3d at 633 (citing Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249, 106 S.Ct. 2505, 2511 (1986)).

FN59. Anderson, 477 U.S. at 247, 106 S.Ct. at 2510.

FN60. Anderson, 477 U.S. at 248, 106 S.Ct. at 2510; Thomas v. LTV Corp., 39 F.3d 611, 616 (5th Cir.1994).

FN61. Beck, 204 F.3d at 633 (citing Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586, 106 S.Ct. 1348, 1355 (1986)).

FN62. Anderson, 477 U.S. at 248, 106 S.Ct. at 2510; Wise v. E.I. DuPont De Nemours & Co., 58 F.3d 193, 195 (5th Cir.1995).

FN63. Anderson, 477 U.S. at 249, 106 S.Ct. at 2509.

All evidence and inferences drawn from that evidence must be viewed in the light favorable to the party resisting the motion for summary judgment. FN64 Thus, summary judgment motions permit a court to resolve lawsuits without the necessity of trials if there is no genuine dispute as to any material facts and the moving party is entitled to judgment as a matter of law. FN65

FN64. Hibernia Nat'l Bank v. Carner, 997 F.2d 94, 97 (5th Cir.1993).

FN65. *See* Fields v. City of South Houston, Tex., 922 F.2d 1183, 1187 (5th Cir.1991).

When affidavits are used to support or oppose a motion for summary judgment they "shall be made on personal knowledge, shall set forth facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein." FN66 Affidavits that are not based on personal knowledge or that are based merely on information and belief do not satisfy the requirements of Rule 56(e), and those portions of an affidavit that do not comply with Rule 56(e) are not entitled to any weight and cannot be considered in deciding a motion for summary judgment. FN67 Neither shall conclusory affidavits suffice to create or negate a genuine issue of fact.FN68

FN66. Fed.R.Civ.P. 56(e); Beijing Metals & Minerals Import/Export Corp., v. American Bus. Center, Inc., 993 F.2d 1178, 1182 (5th Cir .1993).

FN67. Richardson v. Oldham, 12 F.3d 1373, 1378-79 (5th Cir.1994).

FN68. *See* Travelers Ins. Co., v. Liljeberg Enterprises, Inc., 7 F.3d 1203, 1207 (5th Cir.1993); Salas v. Carpenter, 980 F.2d 299, 305 (5th Cir.1992).

V. *ANALYSIS*

With the foregoing principles on claim construction in mind, the Court makes the following background findings regarding the '064 patent and Dupaco's accused device and, thereafter, the disputed claim elements in claim 1 of the ' 064 patent.FN69

FN69. As noted, the parties' joint claim construction statement states that, other than the words or phrases in claim 1 addressed in the claim construction statement, the "[r]emaining words or phrases in the claims are not believed to be subject to any reasonable differences in interpretation" and are not separately addressed (docket no. 34 at 1). Nevertheless, Voss has argued that "the narrower scope of claim 2 'clamp member' and 'knob means' elements require a broader interpretation of the "clamping means" and "means for adjusting" limitations in claim 1 (docket no. 34 at 9). And, Dupaco has proposed a construction of some of the terms in claim 2 (docket no. 34 at 15-17), to which Voss has not objected or proposed counter definitions.

A. *Claims Construction and a Means Plus Function Patent*

A claim element written as a "means" for performing a function is subject to special claim construction

rules set forth in 35 U.S.C. s. 112, para. 6. This provision states:

An element in a claim for a combination may be expressed as a means or step **for performing a specified function without the recital of structure,** material or acts **in support thereof, and such claim shall be construed to cover the corresponding structure,** material, or acts **described in the specification and equivalents thereof.**FN70

FN70. 35 U.S.C. s. 112, para. 6 (emphasis added).

A means plus function claim recites a specified function to be performed rather than the structure, material or acts for performing that function. FN71 For example, a means plus function claim may recite a "means for adjusting" rather than a "knob." A means plus function claim also may first describe the element in terms of the function, followed by the word "means," such as "clamping means." FN72 The use of the word "means" creates a presumption that the sixth paragraph of section 112 applies.FN73

FN71. IMS Technology, Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1429-30 (Fed.Cir.), *cert. denied,* 530 U.S. 1299 (2000). Dupaco argues that " 'section 112 paragraph 6 operates to *cut back* on the types of *means* which could literally satisfy the claim language' " (docket no. 20 at 10 (*quoting* Johnston v. IVAC Corp., 885 F.2d 1574, 1580 (Fed.Cir.1989) (emphasis in original)). But, Voss argues that claim elements that recite actual structure are narrower than means plus function elements and, therefore, it must be true that a means plus function element is broader than a structural element (docket no. 27 at 9 (citing Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 234 F.3d 558 (Fed.Cir.2000)). Even if, as Dupaco argues, the types of means are limited in a means-plus-function claim, "[a] claim element recited in a means-plus-function language literally encompasses the corresponding structure and its equivalents." Festo Corp., 234 F.3d at 589 (citing Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 1536 (Fed.Cir.1991)).

FN72. Signtech U.S.A., Ltd. v. Vutek, Inc., 174 F.3d 1352, 1356 (Fed.Cir.1999).

FN73. *Cf.,* Wenger Manuf. Inc. v. Coating Machinery Systems, Inc., 239 F.3d 1225 (Fed.Cir.2001) ("means defining a plurality of separate product coating zones" is not properly construed as means plus function limitation since it is unclear whether there is any function that correspond to word "means," and since, even if function of "defining" corresponds to word "means," claim recites sufficiently defined structure for performing function for "defining"); Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 1361, 1313 (Fed.Cir.2000) ("plastic envelope closing means" is a means plus function format).

B. *The Claimed Invention: The* '064 Patent

Gene A. Voss is the holder of U.S. Patent No. 4,752,064 entitled, "Therapeutic Head Support." The '064 patent issued on June 21, 1988 based upon an application filed on March 23, 1987 and is generally directed to a therapeutic device for supporting the head face down during a medical procedure such as back surgery, to support the face comfortably, to allow monitoring of the patient's face, to allow the placement of tubes and the like into the patient's mouth, to allow conversation with the patient.FN74

FN74. '064 patent, column 1 through column 2, line 16.

The '064 patent consists of three claims, two independent and the third dependent on the second claim. The following is a summary of the key elements of the claimed invention described in those claims. The commercial embodiment of the claimed invention is a product called "Therapeutic Head Support."

Claim 1

Claim 1 is an independent claim that describes "[a] therapeutic head support comprising":

a pillow made of soft resilient foam being between two and four inches thick;

said pillow having a T-shaped void therein conforming to the contours of a human face;

said pillow having a channel therein extending from said void to an outer surface of said pillow;

a plate member having a cutout therein for supporting said pillow;

said cutout corresponding to said void;

rod members attached to said plate member;

clamping means connected to said rod members for attaching said plate member to a table;

a mirror attached to said plate member opposite said pillow; and

means for adjusting the orientation of the mirror.FN75

FN75. '064 patent, col. 4; *see* figure 4. The emphasis has been added to the claim language to highlight the elements of claim 1 which Dupaco, in its motion for partial summary judgment, argues are not present in the ProneView. At the claims construction hearing, Dupaco also appeared to emphasize that its product did not satisfy the element of the '064 patent which calls for "said pillow having a T-shaped void therein conforming to the contours of a human face." Again, this was not a ground raised in its motion for partial summary judgment (*see* docket nos. 20 and 32).

The "clamping means" and "means for adjusting the orientation of the mirror" limitations are most properly construed as means-plus-function limitations. FN76

FN76. Dupaco argues that these two elements are stated in a means plus function form (docket no. 20 at 9-10 and 12); Voss does not dispute that the two elements in question are governed by paragraph 6 of section 112 (docket no. 27 at 8-9, 10-12 and 13-17). At the beginning of the claims construction hearing, the parties confirmed that they agree that the two elements in question are written in a means plus function form.

Claim 2

Claim 2 is an independent claim. Claim 2 describes "[a] therapeutic head support comprising:"

a pillow member having upper and lower surfaces and having a T-shaped void therein for receiving a human face at said upper surface;

a plate member whose dimensions correspond to the cross-sectional dimensions of said pillow member, said plate member having a cutout there-through corresponding to said void in said pillow member, and having a flanged edge for securing said pillow member thereto;

one or more clamp members, sais first end of sais one or more rod members being attached to said plate member and said second end of said one or more rod members being attached to said one or more clamp members;

or more bar members having first and second ends, said first end being attached to said plate member;

a mirror attached to said second end of said one or more bar members;

and knob means for adjusting the orientation of said mirror.FN77

FN77. '064 patent, col. 4.

Claim 3

Claim 3 is a dependent claim, depending on claim 2, and, therefore, incorporates the limitations of claim 2 and adds some additional elements. Claim 3 reads:

The therapeutic head support of claim 2 wherein said pillow member has one or more channels therein extending from said void to an outer surface of said pillow member.FN78

FN78. '064 patent, col. 4.

C. *The Accused Device: Dupaco's ProneView Protective Helmet System*

The ProneView is a helmet designed to cradle and cushion the fact of a patient during medical procedures when the patient is in a face-down position. The ProneView consists of three main parts: a foam cushion with a T-shaped void; a helmet; and a mirrored base.FN79 The cushion is made of foam and is shaped to fit within the interior of the helmet and is removable.FN80 The cushion has passages for the patient's eyes, nose and mouth and are large enough to allow an attendant to view the eyes of the patient.FN81 The helmet fits over the patient's face and has four hollow legs that extend from the bottom the helmet.FN82 Two or four of the legs (depending on the model) attach to the mounts of the mirrored base.FN83 The mirrored base is rectangular and has a flat bottom surface. The directions for use of the ProneView are printed on the bottom of the mirrored base. The ProneView sits on top of an operating table when it is in use and does not sit on any base attached to the operating table.

FN79. Docket no. 21, Declaration of Jordan at 1-2; docket no. 27 at 7.

FN80. *Id*.

FN81. Docket no. 21, Declaration of Jordan at 2; docket no. 27 at 7.

FN82. *Id*.

FN83. *Id*.

D. ***Claim Construction of Disputed Terms in the*** '064 Patent

In connection with claims construction, the parties submitted a joint claims construction statement which set forth the parties' construction of claim 1.FN84 The Court finds that each term in claims 1, 2 and 3 is used consistently throughout the claims and the specification of the ' 064 patent; the parties do not argue otherwise. In their joint claims construction statement and, as confirmed at the claims construction hearing, the parties do not dispute the meaning of any words or phrases used in the ' 064 patent except for those words or phrases in which each side proposes a different interpretation in the joint claims construction statement.FN85 When the parties have agreed or conceded that a word or phrase is not defined in the ' 064 patent, the Court has made reference to dictionary definitions, as noted below.FN86

FN84. Docket no. 34.

FN85. Docket no. 34 at 1. As noted elsewhere herein, Dupaco has also proposed definitions of other words used in claim 2, but the parties agree that, unless the parties have proposed competing interpretations of words, the words are or phrases "are not believed to be subject to any reasonable differences in interpretation ..." (docket no. 34 at 1).

FN86. *Vitronics,* 90 F.2d at 1584 n. 6; *see also, e*. g., MSM Investments Co. v. Carolwood Corp., 259 F.3d 1335, 1339 (Fed.Cir.2001); Elecktra Instrument S.A. v. O.U.R. Scientific Int'l, Inc., 214 F.3d 1302, 1307 (Fed.Cir.2000); Eastman Kodak Co., 114 F.3d 1547. When the parties have used a dictionary definition, they have cited to general purpose dictionaries. No party has argued that any of the words or phrases sought to be defined are "technical" words. *See* Anderson v. Int'l Eng'g & Mfg ., Inc., 160 F.3d 1345, 1348-49 (Fed.Cir.1998). No definition contradicts other trustworthy extrinsic evidence. AFG Industries, Inc. v. Cardinal IG Co., 239 F.3d 1239, 1247 (Fed.Cir.2001).

The Court makes the following findings with respect to the material disputed terms which are to be construed in all claims as indicated herein. These terms, as construed, are the basis for the Court's conclusions with respect to the pending motion for partial summary judgment of non-infringement.

"***T-shaped***"

The term "T-shaped" is not defined in the patent, but its meaning can be derived from its context in the specification and the drawings. Figure 1 shows a void in the general shape of a capital letter "T." The specification discloses:

Pillow 12 has a generally T-shaped void 14 therein. The shape of void 14 provides total support for the head but does not interfere with the critical facial areas of the mouth, nose and eyes. The upper portion 16 of void 14 has a length of between four and seven inches depending on the age of the intended user ... Lobes 22 protrude slightly inward toward the center of the void, providing extra support at the cheekbones. Alternatively phrased, the lower portion 18 of void 14 is slightly widened, allowing some freedom of movement of the mouth so that the patent may converse with the attending physician. The inner edge 15 of void 14 is preferably curved at the extended portion of the T shape, rather than being square cut, providing the maximum surface contact with the face, and thus maximum support.FN87

FN87. '064 patent, col. 3, lines 9-26.

Voss argues that the description of the particulars of the length and shape of the opening for the void are merely a description of the "then-anticipated best mode and preferred embodiment," the further specifications do describe what is depicted in figures 1, 2 and 4 and describe the length, shape and dimensions for the void so that the void may allow an unobstructed passageway and that the pillow may still provide support for the head. It also should be noted that the prosecution history discloses that earlier claims describing the dimensions of the void were rejected as unpatentable.FN88

FN88. Plaintiff's Exhibit 2, Nov. 27, 2001 Claims Construction Hearing, at 2153-55 and 2172-73.

Therefore, the term "T-shape" means the general shape of the letter "T."

"***void***"

The term "void" is not defined in the specification. The parties agree that "void" ordinarily means "opening or gap." FN89 This definition is consistent with the patentee's use of the term:

FN89. Docket no. 34 at 2; and docket no. 34 at 10 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

The upper portion 16 of void 14 has a length of between four and seven inches depending on the age of the intended user. Thus the patient may see through pillow 12 at the upper portion 16 of void 14, avoiding any claustrophobic effect. Void 14 also provides an unobstructed passageway for air.FN90
FN90. '064 patent, col. 3, lines 12-18.

Therefore, the term "void" means "opening" or "gap."
"***T-shaped void***"

The phrase "T-shaped void" means a void or gap or opening in the general shape of the letter "T" and of a configuration for providing support for the head but not interfering with the critical facial areas of the

mouth, nose and eyes and for providing an unobstructed passageway for air. This definition is consistent with the use of the word in the patent.

"***channel***"

The term "channel" is not defined in the patent, therefore resort to the ordinary meaning is made. Voss proposes that channel be defined as "groove"; FN91 Dupaco proposes that channel ve defined as a "tubular enclosed passage: conduit." FN92

FN91. Docket no. 34 at 3 (citing WEBSTER'S 21ST CENTURY DICTIONARY (Thomas Nelson Publishers, 1992)).

FN92. Docket no. 34 at 11 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

The patent uses the term "channel" consistent with the meaning of a "groove" or "gutter" or "furrow" FN93: "Figs. 1 and 2 depict pillow 12 as having two channels 26 therein running from void 14 to the outside of the pillow." FN94 The purpose of the channels is to act as airways, for the placement of a microphone, and for the placement of an endotracheal tube.FN95 Channels could be closed tubes or conduits, but the depicted channels are not and instead are open grooves or gutters or furrows or recesses. Further, the parties agree that the channels in question can be on either the upper or lower surface of the pillow.FN96 If the channel is on the upper surface of the pillow, then the channel is not "closed" as it might be considered to be when the pillow is placed "groove" side down on the table.FN97

FN93. MERRIAM WEBSTER'S COLLEGIATE DICTIONARY (defines "channel" as including "a long gutter, groove, or furrow"), *available at http:// www.m-w.com/cgi-bin/dictionary* (last visited Dec. 6, 2001).

FN94. '064 patent, col. 3, lines 28-30.

FN95. '064 patent, col. 3, lines 35-39.

FN96. Docket no. 34 at 3 and 11.

FN97. *Compare* figures 1, 2 and 4 *with* figure 3, '064 patent.

Therefore, "channel" is a "groove" that runs from the void cut in the pillow to the outside of the pillow and can be either on the upper or the lower surface of the pillow.

"***plate member***"

The phrase "plate member" is not defined in the patent. "Plate" is subject to a number of definitions. Voss

proposes that "plate" be defined as "a horizontal structure member that provides bearing and anchorage." FN98 Dupaco proposes that "plate" be defined to mean "a smooth flat thin piece of material." FN99 A "member" is "a constituent part of a whole." FN100

FN98. Docket no. 34 at 3 (citing MERRIAM WEBSTER'S COLLEGIATE DICTIONARY, *available at http://www.m-w.com/cgi-bin/dictionary* (last visited Dec. 6, 2001)).

FN99. Docket no. 34 at 11 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

FN100. Dupaco proposes this definition. Docket no. 34 at 11 ((citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

These meanings are generally consistent with the patent's use of the words. The specification states: "In this embodiment, pillow 12 is immediately supported by a plate 32, preferably metal, which has a cutout 34." FN101 Figure 4, point 32 illustrates the plate member and shows a tray-like structure which supports and cradles the pillow.FN102 The specification further provides that "Plate 32 has flanged edges 36 which keep pillow 12 properly aligned therein." FN103 Thus, "plate member" is not limited to a "flat thin piece of material," as proposed by Dupaco.FN104

FN101. '064 patent, col. 3, lines 49-51.

FN102. *See* figure 4, '064 patent.

FN103. '064 patent, col. 3, lines 53-55.

FN104. Dow Chemical Co. v. Sumitomo Chem. Co., Ltd., 257 F.3d 1364, ---- (Fed.Cir. July 27, 2001):
... it is also well established that a claim construction that excludes a preferred embodiment is 'rarely, if ever, correct.' Vitronics, 90 F.3d at 1583, 39 USPQ2d at 1578 (emphasis added); *see also Interactive Gift,* 256 F.3d at ----. This is because 'it is unlikely that an inventor would define the invention in a way that excluded the preferred embodiment, or that persons of skill in this field would read the specification in such a way.' Hoechst Celanese Corp. v. BP Chem. Ltd., 78 F.3d 1575, 1581, 38 USPQ2d 1126, 1130 (Fed.Cir.1996).

Therefore, a "plate member" is a horizontal structure that provides bearing and anchorage for the pillow that is a constituent part of the whole head support.

"cut out"

The term "cut out" is not defined in the patent. The parties agree that the ordinary meaning of the term "cut

out" is "the space or hole left after cutting." FN105 This meaning is consistent with the use of the term in the specification. The specification states: "In this embodiment, pillow 12 is immediately supported by a plate 32, preferably metal, which has therein a cutout 34 similar in shape to, but slightly larger than void 14 in pillow 12." FN106

FN105. Docket no. 34 at 4 and 12 (each citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

FN106. '064 patent, col. 3, lines 49-54.

Therefore, "cut out" means "the space or hole left after cutting."

"***corresponding***"

The term "corresponding" is not defined in the patent. The parties agree that the ordinary meaning of "corresponding" is "having or participating in the same relationship (as kind, degree, position or function)." FN107 This definition is consistent with the patent's use of the term in claim 1 when it describes the relationship between the cut out and the void: "[A] plate member having a cutout therein for supporting said pillow, said cutout corresponding to said void." FN108 The specification states: "[C]utout 34[is] similar in shape to, but slightly larger than, void 14 in pillow 12." FN109 In the context of the relation between the cut out in the plate and the void in the pillow, "corresponding" means that the size and shape of the cut out and the void are such that they can be lined up so that there is a substantially uninterrupted view of the mirror through the pillow (through the void) and through the plate (through the cut out).

FN107. Docket no. 34 at 4 and 12 (each citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

FN108. "064 patent, claim 1.

FN109. '064 patent, col. 3, lines 51-52.

Therefore, "corresponding" means "having or participating in the same relationship (as kind, degree, position or function)."

"***rod members***"

The phrase "rod members" is not defined in the patent. Dupaco proposes that the ordinary meaning of "rod" is a "slender bar (as of wood or metal)." FN110 As noted above, a "member" is ordinarily "a constituent part of a whole."

FN110. Docket no. 34 at 12 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)). Voss proposes no other ordinary meaning for "rod."

These meanings are consistent with the patentee's use of the phrased in the figures and the specification: "Plate 32 is attached to the operating table 24 in any expedient manner; in fig. 3, plate 32 is in turn supported by support rods 38 which are welded to claims 40. Clamps 40 are easily secured to the end of the table 24." FN111 Figure 3 at number 38 illustrates an "L" -shaped bar connecting the plate to the operating table. In the context of the patent, the rods are structural members in which the rods are slender bars which, in cooperation with other member(s), support and immobilize the plate member relative to the operating table.

FN111. '064 patent, col. 3, lines 54-57.

Therefore, a "rod member" is a slender bar that is a constituent part of the whole head support.

"***attached***"

The term "attached" is not defined in the patent. The parties agree that "attached" ordinarily means "to make fast (as by tying or gluing)." FN112 This meaning is consistent with the patent's use of the word.

FN112. Docket no. 34 at 5 (citing MERRIAM WEBSTER'S COLLEGIATE DICTIONARY, *available at http://www.m-w.com/cgi-bin/dictionary* (last visited Dec. 6, 2001)) and docket no. 34 at 14 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)). MERRIAM WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (Merriam Webster, 1986) includes the following definition for "attach": "make fast or join (as by glue or string): bind, fasten, tie.")

Claim 1 recites that rod members are "attached" to the plate member. Figure 4 of the patent shows rods 38 extending from plate 32. The patent specification states: "Plate 32 is attached to operating table 24 in any expedient manner; in FIG. 3, plate 32 is in turn supported by support rods 39 which are welded to clamps 40."

Therefore, "attached" means "made fast as by tying or gluing."

"***table***"

The term "table" is not defined in the patent. The parties essentially agree that the ordinary meaning of "table" is a piece of furniture or equipment consisting of a smooth flat slab fixed on legs.FN113 The patentee uses the term in a consistent manner in the description of the invention and the figures. As described by Voss, Figure 3 of the patent shows a patient resting "on what is clearly an operating table." FN114 Although it is true, as noted by Voss, that the subject matter of the ' 064 patent concerns medical treatment and surgery, in particular; the ordinary meaning of "table" does not include " ***any*** structure or apparatus upon which a medical patient rests for receiving surgery or medical treatment," since not all structures or apparatuses are tables.

FN113. Voss suggests the "table" means "any structure or apparatus upon which a medical patient rests for receiving surgery or medical treatment" (docket no. 34 at 6). Dupaco suggests that the ordinary meaning of "table" is "a piece of furniture consisting of a smooth flat slab fixed on legs" (docket no. 34 at 14).

FN114. Docket no. 34 at 6.

Therefore, "table" means a piece of furniture or equipment consisting of a smooth flat slab fixed on legs.

"***opposite***"

The term "opposite" is not defined in the patent. Voss suggests that the ordinary meaning of "opposite" is "being the other of a pair that are corresponding or complementary in position, function, or nature." FN115 Dupaco suggests that the ordinary meaning of "opposite" is "across from and usually facing or on the same level with." FN116 Although the parties do not propose precisely the same definition, each proposed meaning is consistent with the patentee's use of the term. Claim 1 states: "[A] mirror attached to said plate member opposite said pillow." The specification describes the mirror being placed below the plate, which would be facing the pillow, so that the mirror could be adjusted to allow, for example, the attending physician's view of the patient's eyes and face.FN117 Figure 4 shows the pillow resting on one side of the plate and the mirror suspended from the second side of the plate so that it is opposite the plate.

FN115. Docket no. 34 at 6.

FN116. Docket no. 34 at 14.

FN117. '064 patent, col. 3, lines 61-63.

Therefore, "opposite" means "being the other of a pair that are corresponding or complementary in position, function or nature."

"***clamping means connected to said rod members for attaching said plate member to a table***"

The phrase "clamping means" is not defined in the patent or prosecution history. A "means" is a term of art allowing a patentee to claim a structure by what it does.FN118 Voss proposes a definition of "clamp" as "any of various instruments or appliances having parts brought together for holding or compressing something." FN119 Dupaco proposes that "clamp" ordinarily means "a device designed to bind or constrict or to press two or mor parts together so as to hold them firmly." FN120 Although the parties do not propose precisely the same definition,FN121 each proposed meaning is consistent with the patentee's use of the term.

FN118. Dupaco proposes this meaning (docket no. 34 at 14); Voss proposes no express definition of this patent term or art in the joint claims construction statement (docket no. 24 at 6-8).

FN119. Docket no. 34 at 7 (citing MERRIAM WEBSTER'S COLLEGIATE DICTIONARY, *available at http://www.m-w.com/cgi-bin/dictionary* (last visited Dec. 6, 2001)).

FN120. Docket no. 34 at 13 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random

House, 1995)).

FN121. To be precise, both parties initially proposed the same definition of "clamp." *See* docket no. 20 at 13 and docket no. 27 at 14 ("Voss does *not disagree* with Dupaco's proposal for one definition of a clamp-'a device designed to bind or constrict or to press two or more parts together so as to hold them firmly.' ") (emphasis added). In the joint claims construction statement, Dupaco again proposed that definition (docket no. 34 at 13), but Voss proposed the similar definition recited in the text above (docket no. 34 at 7). MERRIAM WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (Merriam-Webster, 1986) includes the following definition for "clamp": "a device (as a band or brace) designed to bind or constrict or to press two or more parts together so as to hold them firmly in their relative position."

The '064 patent does not include the term "clamping means" in the specification, but it does describe "clamps" that are welded to the support rods: "Clamps 40 are easily secured to the end of the table 24." FN122 Figure 4, number 40 illustrates clamps attaching directly to the operating table and further attaching the support rods to the operating table.FN123

FN122. '064 patent, column 3, lines 55-57.

FN123. '064 patent, figure 4.

Voss argues that "[t]he self-evident purpose of clamps 40 in the Voss patent is to support and immobilize the 'plate' vis-a-vis the operating table" and, because the inventor specified that the attachment of the plate to the table can be in any expedient manner, "clamps" should not be interpreted only as the structure shown under reference 40 and "clamping means" "need not be an instrumentality that attaches *directly* to an operating table." FN124 Voss would rely on the testimony of the inventor of the ' 064 patent, Dr. Voss, and Dr. Voss' affidavit attached to Voss' response to the motion for partial summary judgment in support of his argument that "persons reasonably skilled in the pertinent art would consider [other structures] interchageable with the examples depicted in a patent's specification." FN125 But, even if the Court were to consider the testimony of the inventor for this purpose, a means clause should not be construed to cover all possible structures that are capable of performing the stated function, but only those structures described in the specification, and their equivalents, that perform the stated function. FN126

FN124. Docket no. 34 at 6-8; *see* docket no. 27 at 14.

FN125. Docket no. 34 at 7.

FN126. Valmont Industries, Inc. v. Reinke Manuf. Co., 983 F.2d 1039, 1042 (Fed.Cir.1993).

The only structure described in the specification of the '064 patent are "clamps" that are secured to the end of the table so that the plate member is attached to a table. Although the Court is aware that drawings alone

wills not support inclusion of a limitation not otherwise present in claims,FN127 and that claims should not ordinarily be limited to a preferred embodiment, FN128 the requirement of "clamps" (a structure that is secured to the end of the table by binding or constricting or pressing two or more parts together so as to hold them firmly in their relative position) is consistent with the wording of claim 1 that requires "clamping means connected to said rod members for attaching said plate member to a table." FN129 The words used in the "clamping means" element in claim 1 limit the scope of the "clamping means" element to structures that are secured to the end of the table by binding or constricting or pressing two or more parts together so as to hold them (the plate member which is connected to the rod members and the table) firmly in their relative position.

FN127. *Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc.,* 261F.3d 1329, ----, 59 U.S.P.Q.2d 1801, 1808 (Fed.Cir.2001) ("Scimed correctly notes that all of the drawings in the asserted patents depict the connecting elements in parallel alignment both with each other and the stent's longitudinal axis. However, this fact, by itself, does not support adding such a limitation to the claims....Without a "generally parallel" limitation in the claim or a discussion in the specification about the claimed connecting elements being generally parallel both to each other and to the stent's longitudinal axis, the drawings' depiction of the connecting elements in parallel relationship both with each other and the stent's longitudinal axis can not support the conclusion that such a limitation exists. Since nothing in the specification assigns significance to the fact that the drawings align the connecting elements parallel both to each other and to the stent's longitudinal axis, we will not allow this aspect of the drawings to be imported into the claims as a limitation.") (citations omitted).

FN128. Cultor Corp. v. A.E. Staley Mfg. Co, 224 F.3d 1328, 1330-31 (Fed.Cir.2000).

FN129. Oak Technology, Inc. v. U.S. I.T.C., 248 F.3d 1316, ----, 58 U.S.P.Q.2d 1748, 1754-57 (Fed.Cir.2001) (reliance on written description in claim construction did not amount to an impermissible importation of a limitation when the claim itself imposes the limitation and the written description merely confirms that understanding).

Therefore, "clamping means connected to said rod members for attaching said plate member to a table" is construed as a structure that is secured to the end of the table by binding or constricting or pressing two or more parts together so as to hold them firmly in their relative position.

"means for adjusting the orientation of the mirror"

The term "adjusting" is not defined in the patent. Voss proposes that "adjust" ordinarily means "to bring the parts of to a true or more effective relative position." FN130 Dupaco proposes that "adjust" ordinarily means "to bring to a more satisfactory state." FN131 Although the parties do not propose precisely the same definition,FN132 each proposed meaning is generally consistent with the patentee's use of the term.FN133

FN130. Dupaco originally proposed the definition for "adjust" as "to bring to a more satisfactory state" (docket no. 20 at 14-15) and Voss did not appear to object when filing his responsive claim construction statement (docket no. 24). But, in the joint claims construction statement, Voss proposed a slightly different definition (docket no. 34 at 8), as recited above, citing MERRIAM WEBSTER'S COLLEGIATE

DICTIONARY, *available at http://www.m-w.com/cgi-bin/dictionary* (last visited Dec. 6, 2001).

FN131. Docket no. 34 at 15 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

FN132. To be precise, both parties initially proposed the same definition of "clamp." *See* docket no. 20 at 13 and docket no. 27 at 14. In the joint claims construction statement, Dupaco again proposed that definition (docket no. 34 at 13), but Voss proposed the similar definition recited in the text above (docket no. 34 at 7). MERRIAM WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (Merriam Webster, 1986) includes the following definition for "clamp": "a device (as a band or brace) designed to bind or constrict or to press two or more parts together so as to hold them firmly in their relative position."

FN133. MERRIAM WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY (Merriam Webster, 1986) includes the following definition for "adjust": "to bring to a true or effective relative position (as the parts of a device)." With respect to the definition "to bring to a more satisfactory state," this dictionary includes additional text: "to bring to a more satisfactory state ...: settle, resolve ... rectify."

The term "orientation" is not defined in the patent. The parties agree that "orientation" ordinarily means "the act or process of orienting." FN134 The parties agree that "orient" means "to set or arrange in any determinate position." FN135

FN134. Docket no. 34 at 8 (citing MERRIAM WEBSTER'S COLLEGIATE DICTIONARY, *available at http://www.m-w.com/cgi-bin/dictionary* (last visited Dec. 6, 2001)) and docket no. 34 at 15 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

FN135. Docket no. 34 at 8 (citing MERRIAM WEBSTER'S COLLEGIATE DICTIONARY, *available at http://www.m-w.com/cgi-bin/dictionary* (last visited Dec. 6, 2001)) docket no. 34 at 15 (citing MIRRIAM WEBSTER'S COLLEGIATE DICTIONARY (Random House, 1995)).

Thus, a "means for adjusting the orientation of the mirror" is a structure that brings the mirror into a determinate, relative position. In the context of the patent, the "means for adjusting the orientation of the mirror" is a structure that is involved in bringing the mirror into a determinate position relative to the plate and pillow.

Dupaco argues that because a means clause should not be construed as covering all possible structures that perform the stated function but only those structures described in the specification and their equivalents that perform the stated function, the "means for adjusting the orientation of the mirror" should be limited to a knob, the only structure disclosed in the specification to adjust the mirror.FN136 Although it is true that figure 4 to the patent does disclose a knob, it also depicts the mirror being suspended from the plate through the use of support bars such that a knob or other device may be sued to adjust the orientation of the mirror about an horizontal axis. In other words, it is the structure used to suspend the mirror from the plate through

the use of support bars that allows the orientation of the mirror to be adjusted about an horizontal axis, not merely the knob, a device to facilitate the orientation of the mirror. Therefore, to require a knob, to the exclusion of other devices that would work like a knob, would be impermissibly importing a limitation from the specification to a claim, or, stated differently, limiting the claim to its preferred embodiment.FN137

FN136. Docket no. 34 at 15.

FN137. SIBIA Neurosciences, Inc. v. Codus Pharm. Corp., 225 F.3d 1349, 1355 (Fed.Cir.2000).

Therefore, a "means for adjusting the orientation of the mirror" is a knob or device that is used to bring the mirror into a determinate, relative position.

E. ***Infringement***

1. ***Summary of the Arguments and Introduction***

Dupaco has moved for partial summary judgment on plaintiff's claim of infringement of the '064 patent, arguing that there is "complete lack of evidence" that Dupaco makes, uses, sells or offers to sell head supports with (a) a "clamping means," that is, a clamping mechanism to clamp the head support to an operating table, or (b) a "means for adjusting the orientation of the mirror," that is, a knob mechanism to adjust the orientation of the suspended mirror.FN138 Therefore, Dupaco argues, there are no disputed issues of material fact with respect to infringement, literally or under the doctrine of equivalents. Because there are no genuine issues of material fact regarding direct infringement, there is no genuine issue of material fact regarding contributory infringement or inducement.FN139

FN138. Docket no. 20 at 2.

FN139. Docket no. 20 at 19-20.

In response, Voss argues that there is a factual issue as to whether Dupaco's ProneView satisfies the "clamping means" and the "means for adjusting the orientation of the mirror" by literal infringement or by the doctrine of equivalents. Because there are factual issues regarding direct infringement, Dupaco's argument that there can be no contributory infringement must fail. Alternatively, Voss argues that there are factual disputes with respect to Dupaco's inducing infringement of the '064 patent.

Title 35, United States Code, section 271 makes liable anyone who (a) without authority makes, uses, offers to sell or sells any patented invention;" (b) "actively induces infringement of a patent"; or (c) "offers to sell or sells ... a component of a patented [invention] ... knowing the same to be especially made or especially adapted for use in an infringement of such patent...." "An infringement analysis entails two steps: (1) the claims must be construed; and (2) the properly construed claims must be compared to the allegedly infringing device." FN140 At the summary judgment stage, Dupaco has the initial burden of demonstrating that there is no genuine issue of material fact regarding infringement. At trial, as a patentee, Voss bears the burden of proving infringement by a preponderance of the evidence.FN141

FN140. *Loral Fairchild Corp. v. Sony Corp.,* 181 F.3d at 1321 (citing Markman, 52 F.3d at 976), *cert. denied,* 528 U.S. 1075, 120 S.Ct. 789 (2000).

FN141. CVI/Beta Ventures, Inc. v. Tura LP, 112 F.3d 1146, 1161 (Fed.Cir.1997), *cert. denied,* 118 S.Ct. 1039 (1998). The presumption of validity acts as a procedural device to place the burden of going forward with evidence and the ultimate burden of persuasion of invalidity on the alleged infringer. Dupaco has not raised invalidity as an issue in its motion for partial summary judgment.

1. ***Literal Infringement***

In order to establish literal infringement, a plaintiff must demonstrate by a preponderance of the evidence that every limitation in the properly construed claim "reads on" the accused device, that is, whether the accused device falls within the scope of the claimed invention.FN142 "To establish literal infringement, every limitation set forth in a claim must be found in an accused product, exactly." FN143 The absence of even a single claimed feature from the accused product precludes a finding of infringement as a matter of law.FN144 Because "[a] patent is infringed if a single claim is infringed," FN145 the Court has individually examined each of the asserted claims to determine whether they have been infringed by the accused device.

FN142. Laitram Corp. v. Rexnord, Inc., 939 F.2d at 1535 ("a means clause does not claim every means for performing the specified function" but, rather, " 'the court must compare the accused structure with the disclosed structure, and must find equivalent structure as well as identity of claim function for that structure.' ") (citation omitted).

FN143. Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1575 (Fed.Cir.), *cert. denied,* 516 U.S. 987 (1995).

FN144. Kahn v. General Motors Corp., 135 F.3d 1472, 1476 (Fed.Cir.1998).

FN145. Intervet America, Inc., 887 F.2d at 1055.

When a claim element is stated in a means plus function format, a three-part test is used to determine literal infringement. First, the court must identify the claimed function and determine the corresponding structure or structures described in the specification that perform the stated function. The first step involves questions of law for the court.FN146 Second, it must be determined if the accused product performs the identical function to one recited in the claim. The second step involves a question of fact.FN147 Third, if the accused product performs the identical function, then it must be determined if it uses the same structure disclosed or an equivalent structure. FN148 The third step also is a question of fact.FN149 Thus, the function described in the claim is a question of law, but the analysis of the accused product is a question of fact.FN150

FN146. Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., 145 F.3d 1303, 1307 (Fed.Cir.1998); Multiform Dessicants, Inc., 133 F.3d 1473, 1480 (Fed.Cir.1998) (in determining literal infringement under s.

112, para. 6, "the first step in interpretation of the claim is determination of the meaning of the words used to describe the claimed function.").

FN147. Odetics, Inc. v. Storage Technology Corp., 185 F.3d 1259, 1266 (Fed.Cir.1999); IMS Technology, Inc., 206 F.3d at 1430.

FN148. Chiuminatta Concrete Concepts, Inc., 145 F.3d at 1306. *See also* Medtronic Inc. v. Advanced Cardiovascular Systems, Inc., 248 F.3d 1303 (Fed.Cir.2001).

FN149. Odetics, Inc., 185 F.3d at 1266; IMS Technology, Inc., 206 F.3d at 1430. *C.f.* Chiuminatta Concrete Concepts, 145 F.3d at 1309 (notes that this question was not decided in *Markman* and remained unresolved).

FN150. Motorola, Inc. v. Interdigital Technology Corp., 930 F.Supp. 952 (D.Del.1996), *aff'd in part and rev'd in part,* 121 F.3d 1461 (Fed.Cir.1997).

Equivalence under section 112, paragraph six is "an application of the doctrine of equivalents in a restrictive role, narrowing the application of broad literal claim elements." FN151 The test for statutory equivalence under section 112, paragraph six requires identical function and determines whether the accused product contains a structure "equivalent" to the means disclosed in each individual limitation in the patent claim.FN152 Or, stated differently,

FN151. Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. at 28, 117 S.Ct. at 1048 ("Section 112, para. 6, now expressly allows so-called 'means' claims, with the proviso that application of the broad literal language of such claims must be limited to only those means that are 'equivalen[t]' to the actual means shown in the patent specification. This is an application of the doctrine of equivalents in a restrictive role, narrowing the application of broad literal claim elements. We recognized this type of role for the doctrine of equivalents in Graver Tank itself. 339 U.S. at 608-609, 70 S.Ct., at 856-857.").

FN152. Chiuminatta Concrete Concepts, Inc., 145 F.3d at 1309; EndressHauser, 122 F.3d at 1043; Valmont, 983 F.2d at 1043 ("In the context of section 112 ... an equivalent results from an insubstantial change which adds nothing of significance to the structure, material, or acts disclosed in the patent specification.").

[t]he content of the test for insubstantial differences under s. 112, para. 6 thus reduces to "way" and "result." That is, the statutory equivalence analysis requires a determination of whether the "way" the assertedly substitute structure performs the claimed function, and the "result" of that performance, is substantially different from the "way" the claimed function is performed by the "corresponding structure, acts, or materials described in the specification," or its "result." Substantial equivalence under s. 112, para. 6 is met only if the differences are insubstantial.FN153

FN153. Odetics, 185 F.3d at 1266 (citations omitted).

A change is substantial if the "way" defendant's product performs the claimed function and the "result" of that function is substantially different from the "way" the claimed function is performed by the corresponding structure, acts or materials described in the '064 patent specification or the "result" of that function.FN154

FN154. Odetics, 185 F.3d at 1267.

a. "*Clamping Means*"

Claim 1 of the '064 patent requires "a clamping means connected to said rod members for attaching said plate member to a table." As described in the specification to the '064 patent, there is a separate plate that is attached to the operating table on which the head support rests so that the head support does not itself sit on top of the operating table but, rather, rests on a pillow which in turn rests on a plate that is attached to the operating table. FN155 On the other hand, the ProneView does not have a means or structure to attach the plate member or any part of the helmet to the operating table. Rather, the ProneView simply rests on top of the operating table.

FN155. The specification states "Clamps 40 are easily secured to the end of the table." '064 patent, col. 3, lines 57-58.

As noted, "[l]iteral infringement of a s. 112, para. 6 limitation requires that the relevant structure in the accused device perform the identical function recited in the claim and be identical or equivalent to the corresponding structure in the specification." FN156 Under the first step of the three-part test to determine infringement of a means plus function patent element, the Court finds that the claimed function of the "clamping means" is stated in the claim-"for attaching said plate member to a table." The court must next identify the structure that corresponds to the function of attaching said plate member to a table. A structure is only "corresponding" to a function if "the structure is linked by the specification or the prosecution history" to the function.FN157 The only corresponding structure disclosed in the specification is a "clamp." FN158 No other structure for attaching the plate is disclosed. The Court recognizes, as argued by Voss, that the "clamping means" is not limited to the description in the preferred embodiment. FN159 But, no other structure for attaching the plate is disclosed in the ' 064 patent except through the use of a "clamp" and the meaning of "clamping means" requires that the structure is secured to the end of the table by binding or constricting or to press to or more parts together so as to hold the rod members connected to the plate member firmly to the table.FN160

FN156. Odetics, 185 F.3d at 1267.

FN157. Unidynamics Corp. v. Automatic Products Int'l, 157 F.3d 1311, 1319 (Fed.Cir.1998).

FN158. '064 patent, col. 3, line 54.

FN159. *MicroChemical,* Inc. v. Great Plains, 194 F.3d 1250, 1258 (Fed.Cir.1999).

FN160. *See* Medtronic, Inc., 248 F.3d 1303 (court held that the specification linked or associated "straight wire and hooks" to a different function of preventing overstretch of the formed coil and not with the function of "connecting adjacent elements together); Kemco Sales, Inc. v. Control Papers Co., Inc., 208 F.3d 1352, 1360 (Fed.Cir.2000) (court explained that while it is "fully cognizant of the need to avoid reading limitations into a claim from the specification," the specification described the "closing means" only as a fold-over flap and did not support plaintiff's "expansive interpretation of what structures correspond to the closing means" and the court rejected plaintiff's argument that the limitation should be construed to include other "methods.").

Voss argues that under the doctrine of claim differentiation, this claim element should not be limited to the clamps disclosed. Rather, Voss argues that because "clamp members" are specifically claimed in claim 2, the "clamping means" of claim 1 must be broader to encompass other structures or there would be no difference in meaning between "clamp members" and "clamping means ." FN161

FN161. Docket no. 24 at 4-5 and docket no. 27 at 18-19.

Under the doctrine of claim differentiation, the language of a claim ordinarily should not be interpreted to make another claim identical in scope to the claim in question.FN162 "A means plus function limitation is not made open-ended by the presence of another claim specifically claiming the disclosed structure which underlies the means clause or an equivalent of that structure." FN163 If a dependent claim explicitly claiming the corresponding structure did support a broader construction of the more generally worded independent means plus function claim, "it would provide a convenient way of avoiding the express mandate of section 112(6)." FN164 "[I]t is permissible for claim 1 and claim 2 to have similar scope after each is correctly construed in light of the structures disclosed in the written description, because the judicially-created doctrine of claim differentiation cannot override the statutory mandate of s. 112, para. 6." FN165 Claim 1 of the ' 064 patent can only be construed as broadly as the corresponding structures disclosed in the specification-clamps, that is, devices to bind, constrict or press-and their equivalents, despite a differently worded claim having similar meaning and scope. Therefore, claim differentiation does not alter the result of the analysis at the first step of the three-part test for infringement.

FN162. *E.g.* Stevenson v. International Trade Comm'n, 612 F.2d 546, 554 (C.C.P.A.1979). Claim differentiation "only creates a presumption that each claim in a patent has a different scope; it is 'not a hard and fast rule of claim construction.' " Kraft Foods, Inc. v. International Trading Co., 203 F.3d 1362, 1368 (Fed.Cir.2000) ("... we first note that claim differentiation only creates a presumption that each claim in a patent has a different scope; it is 'not a hard and fast rule of construction.' ") (citation omitted).

FN163. Laitram Corp., 939 F.2d at 1538.

FN164. *Id.*

FN165. IMS Technology, Inc., 206 F.3d at 1432 (citation omitted). *See also* Mutiform Dessicants, Inc., 133 F.3d at 1480.

At the second step of the three-part test for infringement of a means plus function patent, it must be determined, as a question of fact, whether the ProneView performs the identical function to the one recited in the claim. As noted, the function recited in the claim is "for attaching said plate member to a table." The ProneView product contains no structure for attaching any part of it, including the helmet or mirror, to a table and no reasonable jury could find otherwise. The ProneView rests on the table but is not attached (made fast) to the table. Voss argues that the specification states the plate could be attached to an operating table "in any expedient manner" FN166 such as by gravity or friction, so that the ProneView, therefore, may be considered to be attached to the operating table by gravity once the weight of the patient's head is placed in the helmet.FN167 But, the claim requires a "clamping means" to attach the plate to the table. There is no genuine issue of material fact that the ProneView, by resting on the top of the operating table, does not perform the identical function as the claimed "clamping means."

FN166. '064 patent, col. 3, lines 54-55.

FN167. Docket no. 27 at 15-16.

At the third step-which is addressed on the assumption that step two had been resolved favorably to Voss-it must be determined, as a question of fact, if the ProneView uses the same structure disclosed in the '064 patent or an equivalent structure, under the test of statutory equivalence. It is undisputed that the ProneView does not contain any clamps or structure or device for attaching the helmet to a table.

Voss argues that the ProneView's mounting pegs on the mirror that slide into the hollow legs of the ProneView helmet together equate to a clamping mechanism.FN168 The Court does not agree that a peg and a leg may be considered to be a "clamp," because there is no other structure that presses or constricts those two parts together so as to hold them firmly. Even if the insertion of a peg into a leg may be considered a functional "clamp," that is, a device designed to bind or constrict or to press two or more parts together so as to hold them firmly in their relative position,FN169 the issue is not whether the helmet and mirror are attached by a "clamping means" but whether the helmet and table are attached by a "clamping means." The ProneView does not contain a structure identical to a "clamping means." No reasonable jury could conclude that the ProneView uses identical structure, materials or acts described in the ' 064 patent.

FN168. Docket no. 27 at 15.

FN169. *See* Voss' response, docket no. 27 at 14: "Voss does not disagree with Dupaco's proposal for one definition of a clamp-'a device designed to bind or constrict or to press two or more parts together so as to hold them firmly.' "

To determine whether the ProneView uses an equivalent structure as the '064 patent, it must be determined

"whether the differences between the structure in the accused device and any disclosed in the specification are insubstantial." FN170 Even if Voss' characterization of the ProneView is accepted such that the pegs and hollow legs in the ProneView are considered to equate to a clamping means and/or even if it is accepted, as argued by Voss, that the ProneView is held in place on top of an operating table by gravity or friction or even through the addition of a glue by the customer, such constructions are not equivalent to the "clamping means" described in the ' 064 patent. The difference between the ProneView, which rests on top of the operating table without any structures or devices to clamp it to the table, and the clamping means disclosed in the ' 064 patent is so great as to be totally different. No reasonable jury could conclude that the ProneView uses a structure that is only insubstantially different from the structure disclosed in ' 064 patent. No reasonable jury could find that the ProneView performs the identical function with the same or an equivalent structure described in the specification.

FN170. Chiuminatta Concrete Concepts, Inc., 145 F.3d at 1309.

Voss is correct in stating that broader equivalents are allowed when the disclosed physical structure is of little or no importance to the claimed invention.FN171 Here, the "clamping means" is of great importance to the ' 064 patent" because the means for attaching the plate to the table "is central to the operation of the claimed invention." FN172 The claimed invention allows a head support plate to be attached to an operating table. In the ' 064 patent, if the head support does not rest on a plate that is clamped to the operating table, the mirror which is suspended to the plate would be ineffective in gaining a view of the patient's face and eyes. Stated differently, if the head support in the ' 064 patent were simply to rest on top of the operating table as it does in the ProneView, the '064's described structure of suspending a mirror to the plate attached to the operating table in order to allow a view of the patient's eyes becomes inoperable.

FN171. *See* IMS Technology, Inc., 206 F.3d at 1436.

FN172. B & W Custom Truck Beds, Inc. v. Metalcraft, Inc., 156 F.Supp.2d 1238 (D.Kan.2001).

Finally, even if Dr. Voss's testimony about the interchangeability of the ProneView and the Therapeutic Head Support is accepted,FN173 the interchangeability of the two *products* does not necessarily mean that each product uses interchangeable *structures*. The ' 064 patent describes a "clamping means connected to said rod members for attaching said plate member to a table." There is no structure in the ProneView that is for attaching either the helmet or the mirror to a table. The ProneView does not contain a structure that could be interchanged with the required "clamping means" for attaching a plate to a table.

FN173. Docket no. 27, exhibit Q at 4 ("Therefore, this attachment scheme is interchangeable with that shown in my patent for anyone skilled in this field").

b. "***Means for Adjusting the Orientation of the Mirror***"

Claim 1 of the '064 patent requires a "means for adjusting the orientation of the mirror." The mirror is attached to the plate which, in turn, is attached to the operating table and there is specified a means for adjusting the orientation of the mirror so that, for example, health care professionals may adjust the mirror

to be able to look down at the mirror to see the reflection of the patient's face and eyes. Dupaco argues that there is no genuine issue of material fact that the ProneView does not contain such a means for adjusting the orientation of the mirror.

At the first step of the three-part test to determine direct infringement of a means plus function patent, the court must identify the claimed function and determine the corresponding structure(s) described in the specification that perform the stated function. The Court finds that the claimed function of the "means for adjusting" is stated in the claim-"for adjusting the orientation of the mirror." The court must next identify the structure that corresponds to the function of adjusting the orientation of the mirror. The only structure disclosed in the '064 patent is a knob used to adjust the orientation of the mirror by rotating the mirror about an horizontal axis.

Voss argues that the doctrine of claim differentiation allows for a broader interpretation of claim 1 because "knob means" was specifically described in claim 2 and "means for adjusting the orientation of the mirror" must be construed as broader than the "knob means." FN174 But, the doctrine of claim differentiation does not override the statutory requirements of section 112, paragraph 6. The "means for orienting" in claim 1 can only be construed as broadly as the corresponding structure disclosed in the specification, a knob or device to orient the mirror on its horizontal axis. The claimed function for the knob is "for adjusting the orientation of said mirror." While the height of the ProneView helmet may be changed and the mirror may be assembled in a 90 degree angle to the helmet about a vertical axis, neither of these are identical to the function of a knob or device that is turned to adjust the mirror on a horizontal axis.

FN174. Docket no. 27 at 20-21.

Under the doctrine of claim differentiation, Voss argues that the "means for adjusting" may be interpreted more broadly because "knob means" was specifically claimed in claim 2. The "means for adjusting" element can only be construed as broadly as the corresponding structure disclosed in the specification, a knob or device that allows the orientation of the mirror to be adjusted about an horizontal axis, despite a differently worded claim having the same meaning and scope.FN175

FN175. As noted by Dupaco, a strong argument can be made that the ' 064 patent would be invalid for obviousness were it not for the provision for a knob (or device) to be used to adjust the orientation of the mirror (docket no. 32 at 11-12).

At the second step of the three-part test for literal infringement of a means plus function patent, it must be determined, as a question of fact, whether the ProneView performs the identical function recited in the claim. The claimed function for the knob is "for adjusting the orientation of said mirror." There is no structure in the ProneView that would allow the mirror to be adjusted from any position other than laying flat on the operating table and sitting in a 90 degree angle to the helmet.

Although the ProneView is not marketed with a knob to use to accomplish adjustments in the orientation of the mirror, it is marketed with pegs of varying heights. Voss argues that the use of the pegs changes the distance between the pillow and the mirror and, therefore, is a means to adjust the orientation of the mirror to the face. But, the pegs do not perform the identical function of allowing the mirror to be adjusted around an horizontal axis and no reasonable jury could find otherwise.

At the third step-which is addressed on the assumption that step two had been resolved favorably to Voss-it must be determined as a question of fact whether the Prone View uses the same structure disclosed in the '064 patent or an equivalent structure under the test of statutory equivalence. The ProneView has no structure to adjust the orientation of its mirror along a horizontal axis. As noted, the pegs in the ProneView adjust the distance from the helmet to the mirror but do not change the orientation of the mirror from a 90 degree plane. The pegs are not turned or manipulated like a knob so that the mirror may be orientated around a horizontal axis. Even if, as Voss argues, the mirror can be turned "a quarter of a turn" FN176 before all the pegs are inserted, the mirror always remains parallel to the top of the table and at a 90 degree angle to the helmet and no structure in the ProneView performs the turning. Even if there may be a broader range of equivalents for a physical structure that is of little or no importance to the claimed invention, the "means for adjusting" element is of great importance in the claimed operation of the ' 064 patent and to its patentability.FN177 No reasonable jury could conclude that the ProneView uses the equivalent "means for adjusting," or that the differences between the two structures is insubstantial.FN178

FN176. Docket no. 27 at 21.

FN177. *See* Plaintiff's Exhibit 3, Nov. 27, 2001 Claims Construction Hearing.

FN178. In light of this recommended disposition, it is not necessary to address Dupaco's alternative argument that if the "means for orienting" in claim 1 is interpreted more broadly than the disclosed knob structure, the claim would be invalid because two patents were issued before the filing date of the '064 patent for head supports that are rotatably adjustable (docket no. 32 at 11-12). As noted above, all questions as to validity have been reserved.

c. ***Summary***

Therefore, Dupaco is entitled to entry of partial summary judgment on the issue of literal infringement.

3. ***Doctrine of Equivalents***

Plaintiff also argues that ProneView infringes the '064 patent under the doctrine of equivalents. At the claims construction hearing, the parties agreed that claim 1 of the '064 patent had not been narrowed during prosecution; therefore, prosecution history estoppel (an issue for the court), the applicability of *Festo* and its effect on the application of the doctrine of equivalents are not at issue.

The doctrine of equivalents exists in order to prevent infringers from stealing the heart of an invention but escaping liability by making minor or insubstantial changes to the literal language of the claims. Infringement under the doctrine of equivalents occurs if every limitation of the asserted claim or its equivalent is found in the accused product or process and the equivalent differs from the claimed invention only insubstantially.FN179 Or, stated differently, "if the 'function, way or result' of the assertedly substitute structure is substantially different from that described by the claim limitation, equivalence is not established." FN180 Equivalence is a question of fact.FN181

FN179. Warner-Jenkison Co., 520 U.S. at 39-40; Ethicon Endo-Surgery, Inc. v. United States Surgical

Corp., 149 F.3d 1309, 1315 (Fed.Cir.1998); B & W Custom Truck Beds, Inc., 156 F.Supp.2d at 1244.

FN180. Odetics, 185 F.3d at 1267 (citation omitted). *See also* Warner Jenkinson Co., 520 U.S. at 39-40; Hughes Aircraft Co. v. U.S., 140 F.3d 1470, 1474 (Fed.Cir.1998).

FN181. Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608, 70 S.Ct. 854, 856 (1950) quoted in Southwall Technologies, Inc., 54 F.3d at 1579. *See also* Warner-Jenkinson Co., 520 U.S. at 38-39.

Analysis under the doctrine of equivalents is similar to the analysis of statutory equivalence under section 112, paragraph 6. As noted, the statutory equivalence test requires functional identity,FN182 but, the doctrine of equivalence requires either identical or equivalent function, as well as, identical or equivalent "way" and "result." FN183 Because of the similarity in the analyses of insubstantiality of differences, "a finding of lack of literal infringement for lack of equivalent structure may preclude a finding of equivalence under the doctrine of equivalents." FN184

FN182. *Id*.

FN183. Chiuminatta, 145 F.3d at 1310.

FN184. *Id*.

The Federal Circuit has identified "an important difference between the doctrine of equivalents and s. 112, para. 6" in that "after-developed technology, could not have been disclosed in the patent" but may constitute "so insubstantial a change from what is claimed in the patent" that it may be considered to be an infringement under the doctrine of equivalents even though, under the section 112, paragraph six test, "it is not equivalent to the structure disclosed in the patent." FN185 Unless there is a later-developed technology, "a finding of non-equivalence for s. 112, para. 6 purposes should preclude a contrary finding under the doctrine of equivalents. This is because, as we have already determined, the structure of the accused device differs substantially from the disclosed structure, and given the prior knowledge of the technology asserted to be equivalent, it could readily have been disclosed in the patent." FN186

FN185. Chiuminatta, 145 F.3d at 1310.

FN186. Chiuminatta, 145 F.3d at 1311. *See also* B & W Custom Truck Beds, Inc., 156 F.Supp.2d at 1244.

There are two major limitations on using the doctrine of equivalents to allow a patent owner a broader right to exclude than is given by the literal language of the claims: inventions in a crowded field are often restricted to a narrow range of equivalents, if any; FN187 and a patent owner can be estopped from benefitting from the doctrine of equivalents as a result of prosecution history estoppel.FN188

FN187. Hughes Aircraft Co. v. U.S., 717 F.2d 1351 (Fed.Cir.1983).

FN188. *See* Festo Corp., 234 F.3d 558. Voss contends and Dupaco does not contest that "claim one (filed as claim 20 in the original patent application) was never amended during prosecution (only re-numbered when indicated as allowable and when preceding claims were canceled)" (docket no. 24 at 2). Therefore, under even the most stringent reading of *Festo,* Voss is entitled to doctrine of equivalents consideration even if literal infringement is not found.

This case does not involve later-developed technology. Because the requirement that each claim limitation be met by an equivalent element in the ProneView has not been met for section 112, paragraph six purposes with respect to either of the two means plus function limitations, the requirement is not met for the purposes of the doctrine of equivalents. "An element of a device cannot be 'not equivalent' and equivalent to the same structure." FN189 As discussed above, the structure in the Prone View operates in a substantially different way when compared with the structure of the ' 064 patent. With respect to the "clamping means" element, there is no structure on the ProneView that is for attaching the helmet ("plate") to a table; there is no structure ("clamps") that is manipulated to attach or secure the helmet ("plate") to a table; and the ProneView is not attached or secured to the table. With respect to the "means for adjusting" element, the ProneView does not have any structure that rotates the mirror around an horizontal axis; there is no structure or device or knob to rotate the orientation of the mirror; and the result of changing the pegs or turning the mirror 90 degrees about a vertical axis does not change the mirror relative to the plate since the mirror always remains on the same horizontal plane.

FN189. Chiuminatta, 145 F.3d at 1311 (citing Dawn Equip. Co. v.. Kentucky Farms, Inc., 140 F.3d 1009, 1017-22 (Fed.Cir.1998).

Therefore, Dupaco's ProneView does not infringe under the doctrine of equivalents.

F. ***Contributory Infringement and Inducement of Infringement***

Dupaco also moves for summary judgment on Voss' claims of contributory patent infringement and active inducement of patent infringement. Because no genuine issues of material fact exist regarding non-infringement of claim 1 exist, it is recommended that summary judgment on contributory infringement and inducement of infringement be granted.

VI. ***RECOMMENDATION***

In sum, Dupaco's motion for partial summary judgment on infringement FN190 should be **GRANTED.**FN191

FN190. Docket no. 19.

FN191. Dupaco's motion for partial summary judgment of non-infringement of claims 2 and 3 should be *granted* or, in the alternative, Voss's abandonment of his arguments of infringement of claims 2 and 3

should be construed as a motion to voluntarily dismiss claims of infringement of claims 2 and 3 which motion should be *granted*. *See* note 21, above and docket no. 24 at 2.

VII. *INSTRUCTIONS FOR SERVICE AND NOTICE OF RIGHT TO OBJECT/APPEAL*

The United States District Clerk shall serve a copy of this Memorandum and Recommendation on each and every party either (1) by certified mail, return receipt requested, or (2) by facsimile if authorization to do so is on file with the Clerk. According to Title 28 U.S.C. s. 636(b)(1) and FED.R.CIV.P. 72(b), any party who desires to object to this report must serve and file written objections to the Report and Recommendation within 10 days after being served with a copy unless this time period is modified by the District Court. A party filing objections must specifically identify those findings, conclusions or recommendations to which objections are being made and the basis for such objections; the District Court need not consider frivolous, conclusive or general objections. **Such party shall file the objections with the Clerk of the Court, and serve the objections on all other parties and the Magistrate Judge.** A party's failure to file written objections to the proposed findings, conclusions and recommendations contained in this report shall bar the party from a de novo determination by the District Court.FN192 Additionally, any failure to file written objections to the proposed findings, conclusions and recommendations contained in this Report and Recommendation within 10 days after being served with a copy shall bar the aggrieved party, except upon grounds of plain error, from attacking on appeal the unobjected-to proposed factual findings and legal conclusions accepted by the District Court. FN193

FN192. *See* Thomas v. Arn, 474 U.S. 140, 150, 106 S.Ct. 466, 472, 88 L.Ed.2d 435 (1985).

FN193. Douglass v. United Serv. Auto. Ass'n., 79 F.3d 1415, 1428 (5th Cir.1996).

Produced by Sans Paper, LLC.