United States District Court,
N.D. Oklahoma.

HEM, INC,
Plaintiff.
v.
BEHRINGER SAWS, INC,
Defendant.

No. 00-CV-0331-EA (X)

July 23, 2002.

John A. Kenney, Jeff L. Todd, McAfee & Taft, Oklahoma City, OK, for Plaintiff/counter-defendant.

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ORDER

EAGAN**, J.**

Now before the Court is the Motion for Reconsideration of Certain Claim Constructions Under Markman (Dkt.# 279) filed by the defendant, Behringer Saws, Inc. ("Behringer"), and the "objection" of the plaintiff, HEM, Inc. ("HEM"), to one claim construction (*see* Dkt. # 296, at 10 n. 4). For the reasons stated below, Behringer's motion for reconsideration is granted, and HEM's objection is overruled.

I.

On November 1, 2001, the Court entered an Order (Dkt. # 216, the " *Markman* Order") construing the claims of the patent in suit (the " '910 Patent") pursuant to Markman v. Westview Instruments Inc., 52 F.3d 967 (Fed.Cir.1995) (en banc), *aff'd* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996)). In its motion for reconsideration, Behringer requests that the Court review two aspects of its claim construction: (i) the alleged inconsistent construction of "first post adjacent," "second post adjacent," and "adjacent" (Claim Construction Nos. 7, 8, and 34), and (ii) the use of "not otherwise limited" phrases, or "trailers" in Claim Construction Nos. 2, 3, 4, 6, 10, 11, 19, 20, and 22.

A. "*Adjacent*"

As discussed at the hearing held April 9, 2002, *see* Dkt. # 329, Claim Construction Nos. 7 and 8 ("first post adjacent" and "second post adjacent") conflict with Claim Construction No. 34 ("adjacent"), and both parties agreed that the Court's November 1, 2001 *Markman* Order should be amended to strike Claim Construction No. 34 as unnecessary. Therefore, the Court will strike Claim Construction No. 34 in its entirety.

In addition, with regard to Claim Construction Nos. 7 and 8, the Court finds that "next to or not distant from" as the definition of the term "adjacent" is imprecise because the term "adjacent" may or may not imply contact but always implies the absence of anything of the same kind in between. For example, two houses may be adjacent because they are not distant from each other and are on adjacent lots with no houses in between. However, if a house is built between them, they are no longer adjacent houses, even though they are not distant from each other. The Court therefore finds that the term "adjacent" means "next to or not distant from with nothing of the same kind in between." Thus, the motion to reconsider should be granted as to the term "adjacent," and Claim Construction Nos. 7 and 8 should be amended as follows:

7. The term "first post adjacent" should be interpreted as follows: "A structure next to or not distant from the first longitudinal wall *with nothing of the same kind in between*."

8. The term "second post adjacent" should be interpreted as follows: "A structure next to or not distant from the second longitudinal wall *with nothing of the same kind in between*."

B. "*Trailers*"

With regard to certain "trailer" phrases in Claim Construction Nos. 2, 3, 4, 6, 10, 11, 19, 20, and 22, Behringer principally argues that these phrases are not supported by the claims, the specification, the prosecution history, or any other extrinsic evidence. The specific "trailer" phrases which Behringer requests that the Court delete from its *Markman* Order are as follows: in Claim Construction No. 2, the phrase "not limited in size, shape, configuration, or number of component parts"; in Claim Construction No. 3, the phrase "not limited in size, shape, form, orientation or number of pieces"; in Claim Construction No. 4, the phrase "not limited in size, shape, form, orientation or number of pieces"; in Claim Construction No. 6, the phrase "not limited to a structure with two posts"; in Claim Construction No. 10, the phrase "not otherwise limited in size, shape, form or orientation except"; in Claim Construction No. 11, the phrases "not otherwise limited in size, shape, form, or orientation" and "not limited in size, shape, form or orientation except"; and in Claim Constructions Nos. 19, 20 and 22, the phrase "not limited in size or shape".

In order to properly ascertain the meaning of patent claims under *Markman,* a court must "consider three sources: [t]he claims, the specification, and the prosecution history." Markman, 52 F.3d at 979 (citations and internal quotation marks omitted). "Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used." *Id*. (citations omitted). However, "[w]hile a court may look to the specification and prosecution history to interpret what a patentee meant by a word or phrase in a claim, extraneous limitations cannot be read into the claims from the specification or prosecution history." Bayer AG. v. Biovail Corporation, 279 F.3d 1340, 1348 (Fed.Cir.2002) (citations omitted). In other words, a court "cannot alter what the patentee has chosen to claim as his invention...." *Id*. (citations omitted). In construing the claims, "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." ' *Id*. (quoting E.I. du Pont de Nemours Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed.Cir.1988)).

In its response briefs, HEM cites numerous cases in which the Court of Appeals for the Federal Circuit found that district courts had erred by reading various limitations into the claims, and in which it instructed those courts, on remand, to delete such limitations from the construction of the claims. *See, e.g.,* Burke, Inc. v. Bruno Independent Living Aides, 183 F.3d 1334 (Fed.Cir.1999) and Advanced Cardiovascular Systems, Inc. v. Scimed Life Systems, Inc., 261 F.3d 1329 (Fed.Cir.1993). These cases are not on point, however, as

the *deletion* of unsupported claim limitations cannot fairly be equated with the *addition* of limitations which, in effect, render a claim term virtually unlimited in scope. After a thorough review of the briefs, the evidentiary submissions of the parties, as well as the transcript from the *Markman* hearing conducted on April 3-4, 2001, the Court finds that no support exists in the claims, specification, prosecution history, or extrinsic evidence for any of the "trailer" phrases. In addition, the Court finds that the inclusion of such "trailer" phrases in its construction of the claims might not only confuse a jury, but could also impermissibly broaden the scope of what HEM has chosen to claim as its invention. FN1 The Court therefore concludes the motion to reconsider should also be granted as to Behringer's request to delete the "trailer" phrases. Accordingly, Claim Construction Nos. 2, 3, 4, 6, 10, 11, 19, 20, and 22 should be amended as follows:

FN1. The Court further believes that inclusion of these "trailer" phrases in its instructions to a jury could amount to a directed verdict in favor of HEM under the doctrine of equivalents, should the Court rule in favor of HEM on Behringer's pending motion for partial summary judgment regarding this issue. *See* Dkt.# 81. In addition, because the Court will separately instruct the jury on means plus function limitations under 35 U.S.C. s. 112, para. 6, and on the doctrine of equivalents should it remain an issue at trial, the Court further finds that the phrase "or equivalents to such a mechanism" in Claim Construction No. 11 is also inherently confusing and should be deleted.

2. The term "roller framework" should be interpreted as follows: "The framework or roller framework is the *elongated* structural frame or framework having two oppositely facing sides between which the rollers are mounted. [It is elongated but, otherwise, the framework or roller framework is not limited in size, shape, configuration or number of component parts.]"

3. The term "roller framework first wall" should be interpreted as follows: "One side of a roller frame or roller framework. [It is not limited in size, shape, form, orientation or number of pieces.]"

4. The term "roller framework second wall" should be interpreted as follows: "One side of a roller frame or roller framework. [It is not limited in size, shape, form, orientation or number of pieces.]"

6. The term "vise assembly" should be interpreted as follows: "In all claims, the vise assembly includes a reaction frame having two posts and two opposing jaws mounted to the posts of the reaction frame for clamping the workpiece. [The reaction frame is not limited to a structure with two posts.]"

10. The term "coupling mechanism" should be interpreted as follows: "Coupling mechanism as used in Claim 19 and Claim 21: a mechanism for mounting the reaction frame to the roller framework. It [is not limited in size, shape, form or orientation except that it] must include guide rails extending longitudinally along each wall for movably coupling the posts of the reaction frame to the guide rails on either side of the roller framework for transfer of reaction forces cansed by clamping the workpiece from the reaction frame to the elongated roller framework. The mechanism in Claim 19 also includes guide rail bearings for engaging the guide rails."

11. The term "coupling means" should be interpreted as follows:

"Coupling means as used in Claim 1: a mechanism for mounting the reaction frame to the elongated roller framework for transfer of substantially the entire reaction forces along the direction of clamping of the workpiece from the reaction frame to the elongated roller framework and cross member [or equivalents to

such a mechanism]. [The mechanism is not otherwise limited in size, shape, form, or orientation.]"

"Coupling means as used in Claim 15: a mechanism for mounting the reaction frame to the roller framework. It [is not limited in size, shape, form or orientation except that it] must incorporate guide rails secured to each side framework member or wall and bearings mounted to the reaction frame and movably coupling the reaction frame to the guide rails. The mechanism transfers reaction forces caused by clamping the workpiece from the opposing jaws of the reaction frame to the roller framework."

"Coupling means as used in Claim 17: a mechanism for mounting the reaction frame to the roller framework. The mechanism [is not limited in size, shape, form or orientation except that it] must allow for longitudinal movement of the reaction frame along the roller framework and perform the function of transferring reaction forces caused by clamping of the workpiece from the opposing jaws to the roller framework."

19. The term "cross-support" should be interpreted as follows: "The terms 'cross-member,' 'cross-support' and 'cross-bracing member' have the same meaning, which is a structural member extending from one side to the other of the roller framework to transmit or resist, weight, force or pressure. [It is not limited in size or shape.]"

20. The term "cross-member" should be interpreted as follows: "The terms 'cross-member,' 'cross-support' and 'cross-bracing member' have the same meaning, which is a structural member extending from one side to the other of the roller framework to transmit or resist, weight, force or pressure. [It is not limited in size or shape.]"

22. The term "cross-bracing member" should be interpreted as follows: "The terms 'cross-member,' 'cross-support' and 'cross-bracing member' have the same meaning, which is a structural member extending from one side to the other of the roller framework to transmit or resist, weight, force or pressure. [It is not limited in size or shape.]"

II.

In its supplemental response brief, HEM informally objects to the Court's interpretation, in Claim Construction No. 11 of the *Markman* Order, of the phrase "coupling means" as such phrase is used in element (2)(c) of Claim 1 of the '910 Patent. *See* Supplement Brief of Hem, Inc. in Response to Behringer's Motion for Reconsideration of Certain Claim Construction Issues Under Markman, Dkt. # 296, at 10 n. 4. Claim 1 of the patent recites:

A feed table apparatus for clamping a workpiece for cutting by a machine tool comprising:

(1) a roller assembly including;

(a) an elongated roller framework having a longitudinally extending first wall and an oppositely facing longitudinally extending second wall,

(b) at least one cross-member rigidly mounted to and transversely extending between said first wall and said second wall, and

(c) roller means rotatably mounted between said first wall and said second wall for rolling support of said workpiece along said framework assembly; and

(2) a vise assembly including

(a) a reaction frame having a first post adjacent said first wall and a second post adjacent said second wall,

(b) two opposed jaws mounted to said reaction frame assembly between said first post and said second post, said jaws defining a workpiece gripping channel therebetween proximate and above said roller means, and at least one of said jaws being mounted to said reaction frame assembly for movement toward the other of said jaws to clamp workpiece therebetween, and

(c) coupling means mounting said reaction frame to said elongated roller framework for transfer of substantially the entire reaction forces along the direction of clamping said workpiece from said reaction frame to said elongated roller framework and said cross-support.

'910 Patent, at col. 7. A review of the record, however, reveals that the construction of the phrase "coupling means" adopted by the Court is virtually identical FN2 to the interpretation which HEM urged upon the Court in both its post- *Markman* hearing proposed findings of fact and conclusions of law, *see* Dkt. # 144, p. 12, at para. 53.A., and its portion of the chart of words and phrases jointly submitted by the parties, *see* Dkt. # 156, p. 4, at para. 11 col. 3.

FN2. Because of the deletion of a "trailer" phrase by the Court, the construction adopted by the Court is not completely identical to the interpretation urged by HEM. *See* s. I.B., *supra*.

Nevertheless, the Court perceives HEM to be contesting the Court's interpretation, in Claim Construction No. 16, of the phrase "substantially the entire reaction forces" as such phrase is recited in element (2)(c) of Claim 1. In Claim Construction No. 16, the Court found that "[t]he term 'substantially the entire reaction forces' should be interpreted as follows: 'Nearly all of the reaction forces." ' *See Markman* Order, p. 12, at para. 16. In particular, HEM suggests that the term "reaction forces" as recited in Claim 1 would be interpreted by one of ordinary skill in the art to refer specifically to those reaction forces that are "manifested at the coupling means." The Court does not find HEM's argument persuasive. The Court acknowledges, as HEM argues, that the reaction forces manifested at the coupling means are the only reaction forces that are, in the preferred embodiment of HEM's invention, transferred from the reaction frame to the roller framework, as the coupling means is the principal, if not the only, "point of contact" between such structures. However, the reaction forces manifested at the coupling means clearly are not the only reaction forces which could exist "along the direction of clamping." In fact, HEM's own specification discloses a reaction frame structure which "includes an upper cross beam 67c rigidly mounted to and transversely spanning upper portions of first post 40c to second post 40c'." '910 Patent, col. 7, at ll. 4-6; *see also* Fig. 6 of '910 Patent. With such an alternative reaction frame structure in place, "tension forces are resisted and counteracted by cross-beam 67c *and* by roller framework cross-members 50." '910 Patent, col. 7, at 6-8 (emphasis added). In this case, "part of the reaction force from the jaws will be reacted by the cross-beam itself, and part will be reacted by the coupling means to the cross-members of the roller framework." Testimony of Dr. Appl, *Markman* Hrg. Transcript, p. 95, at ll. 10-12.

Thus, it appears that with the substitution of the alternative reaction frame structure actually disclosed by

HEM in its specification, substantially the entire reaction forces along the direction of clamping might *not* actually he transferred from the reaction frame to the roller framework through the coupling means. By requesting that the Court interpret the term "reaction forces" as recited in Claim 1 as limited only to such forces "manifested at the coupling means," HEM asks the Court, in effect, to the ignore the limitation "substantially" and read another limitation into the claim.FN3 The Court, however, refrains from altering what HEM has chosen to claim as its invention. Therefore, the Court concludes that HEM's objection should be overruled.

FN3. Interestingly, none of HEM's other independent claims includes the limitation that "substantially the entire reaction forces along the direction of clamping" be transferred through the coupling means to the roller framework. *See* '910 Patent, Claim No. 15 ("transferring reaction forces") and Claim Nos. 17, 18, 20, 21 ("transfer of reaction forces").

III.

The Court, *sua sponte,* is amending Conclusion of Law No. 20 and deleting Conclusion of Law No. 21 in the original *Markman* Order.

IV.

IT IS, THEREFORE, ORDERED that the defendant's Motion for Reconsideration of Certain Claim Constructions Under Markman (Dkt.# 279) should be and hereby is GRANTED; the Court will enter an Amended Order pursuant to *Markman* herewith.

IT IS FURTHER ORDERED that the plaintiff's "objection" to one claim construction under *Markman* (Dkt. # 296, at 10 n. 4) should be and hereby is OVERRULED.

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