United States District Court,
N.D. California.

THE HEIL CO,
Plaintiff.
v.
CUROTTO CAN CO,
Defendants.

No. 04-1590 MMC

Nov. 16, 2004.

ORDER CONSTRUING CLAIMS

CHESNEY**, J.**

Before the Court is the parties' dispute regarding the proper construction of six terms in U.S. Patent 5,484,245 (" '245 Patent"). Plaintiff and defendant have submitted briefs and evidence supporting their respective positions on the disputed terms. FN1 The matter came on regularly for hearing on October 18, 2004. Alejandro Menchaca of McAndrews, Held & Malloy, Ltd., appeared on behalf of plaintiff. George G. Matava of Greenberg Traurig LLP appeared on behalf of defendant. Having considered the papers submitted, the claims and specification set forth in the '245 Patent, the prosecution history, and the arguments of counsel, the Court construes the disputed claims of the '245 Patent as follows.

FN1. Defendant's request to file a surreply is hereby DENIED. Contrary to defendant's argument, plaintiff's reply does not raise new legal arguments, but, rather, responds to legal arguments made in defendant's opposition. Nor did plaintiff raise new legal arguments at the hearing conducted October 18, 2004, although plaintiff, in response to the Court's questions, expanded on the basis for certain of its legal arguments.

LEGAL STANDARD

In construing disputed claims, a district court's primary source is the intrinsic evidence of the patent. *See* Vitronics Corp. v.. Conceptronic, Inc., 90 F.3d 1576, 1582-83 (Fed.Cir.1996). FN2 Intrinsic evidence includes "the claims, the specification, and the prosecution history," *see* Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1561 (Fed.Cir.1991), as well as the abstract, *see* Hill-Rom Co. v. Kinetic Concepts, Inc., 209 F.3d 1337, 1341 (Fed.Cir.2000). Language used in the patent is given its ordinary meaning, unless it is clear that the inventor intended the terms to have a different meaning. *See* Vitronics, 90 F.3d at 1582. The patent specification "may act as a sort of dictionary, which explains the invention and may define terms used in the claims ." *See* Markman v. Westview Instruments, Inc., 52 F.3d 967, 986 (Fed.Cir.1995), *aff'd,* 517 U.S. 370 (1996). Although a district court considers the specification in determining the meaning of a disputed claim, it is generally improper to limit the scope of the claim to the examples set forth in the specification. *See*

Electro Medical Systems v. Cooper Life Sciences, 34 F.3d 1048, 1054 (Fed.Cir.1994). The claims of the patent, not the specification, "measure the invention." *See* SRI Int'l v. Matsushita Elec. Corp. of America, 775 F.2d 1107, 1122 (Fed.Cir.1985). Finally, the district court reviews the prosecution history, which is "often of critical significance in determining the meaning of the claims." *See* Vitronics, 90 F.3d at 1582.

FN2. A district court considers extrinsic evidence, such as expert testimony, only if the claims are ambiguous and not sufficiently defined by the intrinsic evidence. *See* Bell & Howell Document Management Prods. Co. v. Altek Sys., 132 F.3d 701, 706 (Fed.Cir.1997) (holding that "[w]hen the intrinsic evidence is unambiguous, it is improper for the Court to rely on extrinsic evidence"). A district court may, however, consider "trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field." *See* Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1309 (Fed.Cir.1999). "This is especially the case with respect to technical terms, as opposed to non-technical terms in general usage or terms of art in the claim-drafting art, such as 'comprising." ' *Id*.

DISCUSSION

The patent at issue "relates to refuse vehicles utilizing motor powered systems for dumping containers." *See* U.S. Patent 5,484,245 (" '245 Patent"), col. 1, lines 11-13. Claim 1, in which all of the disputed terms may be found, reads as follows:

1. An motor powered intermediate container in combination with a refuse collection vehicle, wherein said refuse collection vehicle includes forwardly extending arms suitable for engaging, lifting and emptying directly into said vehicle a front loader refuse container filled with refuse, said motor powered intermediate container comprising:

an intermediate container carried by said forwardly extending arms; said intermediate container having support means for supporting said intermediate container on said forwardly extending arms;

an assembly extendable to the curb side of the vehicle and carried by said intermediate container;

said assembly having *motor powered means* including a *dumping assembly* and an extendable element carrying an *engagement assembly;*

said *dumping assembly* having *motor powered means to empty the contents of a curb side refuse container into said intermediate container;*

said *engagement assembly* having *motor powered means to hold the refuse container during the emptying operation;* and

said extendable element having *motor powered means to extend said extendable element and said engagement assembly into engagement with the refuse container,* whereby the use of said motor powered intermediate container converts said refuse collection vehicle from collection by lifting front loader refuse containers and emptying them directly into said vehicle to collection by collecting from curb side refuse containers to said intermediate container carried by said forwardly extending arms.

See '245 Patent, col. 7, line 53-col. 8, line 21 (emphasis added; two of the six disputed terms are set forth twice in Claim 1) . FN3

FN3. Some of the disputed terms are found in other claims, all of which depend on Claim 1. The parties do not argue that the meaning of any disputed term varies depending on the claim.

A. "Motor Powered Means"

The parties dispute the proper construction of "motor powered means" as used in the phrase "said assembly FN4 having *motor powered means* including a dumping assembly and an extendable element carrying an engagement assembly." *See* '245 Patent, col. 8, lines 3-5 (emphasis added). The parties agree "motor powered means," as used in the above phrase, is not a "means plus function" term.

FN4. "Said assembly" is a reference to "an assembly extendable to the curb side of the vehicle and carried by said intermediate container." *See* '245 Patent, col. 8, lines 1-2.

Plaintiff argues the subject term should be construed as "one or more motor powered structures, including a dumping assembly and an extendable element carrying an engagement assembly." (*See* Pl.'s Proposed Order at 2:2-4.) The phrase "including a dumping assembly and an extendable element carrying an engagement assembly," however, is already included in the claim. *See* '245 Patent, col. 8, lines 3-5. Consequently, plaintiff's proposed construction is, more precisely, "one or more motor powered structures." Defendant argues the term should be construed as "a tool or device that has a power source for use in obtaining a particular end." FN5 (*See* Def.'s Proposed Order at 2:7-8.)

FN5. Defendant alternatively argues that the Court should find the term indefinite and thus find Claim 1 invalid. "If the court determines that a claim is not amenable to construction, then the claim is invalid as indefinite." Honeywell Int'l, Inc. v. International Trade, 341 F.3d 1332, 1338 (Fed.Cir.2003). Defendant, however, has failed to show that the term "motor powered means" is not amenable to construction and, indeed, has proposed a construction.

Because plaintiff's proposed construction includes the word "motor," and defendant's proposed construction does not purport to construe "motor," FN6 the word "motor" does not require construction. *See* United States Surgical Corp. v. Ethicon, Inc ., 103 F.3d 1554, 1568 (Fed.Cir.1997) (holding "[c]laim construction is a matter of resolution of disputed meanings and technical scope, to clarify and when necessary to explain what the patentee covered by the claims" and is "not an obligatory exercise in redundancy"). Similarly, the word "powered" does not require construction because both parties' proposed construction includes the word "power." *See id*. Finally, the ordinary definition of "means," the remaining word in the disputed term, is "structure." *See* Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc., 145 F.3d 1303, 1308 (Fed.Cir.1998) (holding "means" is "generic reference for corresponding structure").

FN6. In its brief, defendant cites a dictionary definition of "motor" as "one that imparts motion: a source of mechanical power ." (*See* Def.'s Response to Pl.'s Opening Claim Constr. Brief at 11:22-12:1.) In its proposed construction, however, defendant does not include such, or similar, language.

Accordingly, "motor powered means" is construed as "one or more motor powered structures."

B. "Dumping Assembly"

As noted, "dumping assembly" is included in the "assembly extendable to the curb side of the vehicle." *See* '245 Patent, col. 8, lines 1-5. Plaintiff argues that "dumping assembly" should be construed as "the structure that inverts and dumps the contents of the curb side container, including a hydraulic cylinder or other motor." (*See* Pl.'s Proposed Order at 2:5-7.) Defendant argues that "dumping assembly" should be construed as "an assembled collection of parts used for letting the contents of a curbside refuse container fall in a heap or mass into the intermediate container, which collection of parts include the motor powered means to empty as interpreted below." (*See* Def.'s Proposed Order at 2:9-11.)

Both parties' proposed constructions focus on the function of the claimed "dumping assembly." Although the parties offer differing language, each has proposed a construction that is, essentially, in accord with the specification's teaching as to the function of the "dumping assembly," specifically, that it causes the contents of a curb side refuse container to be emptied, *i.e.,* "dumped," into the intermediate container. *See* '245 Patent, col. 7, lines 32-34; Figs. 4, 7.

Accordingly, "dumping assembly" is construed as "the structure that dumps the contents of a curb side refuse container."

C. "Engagement Assembly"

The "engagement assembly," which is "carried" on the "extendable element," is, along with the "dumping assembly," included in the "assembly extendable to the curb side of the vehicle and carried by said intermediate container." *See* '245 Patent, col. 8, lines 1-5. The "engagement assembly" is described as "having motor powered means to hold the refuse container during the emptying operation." *See* '245 Patent, col. 8, lines 9-11.

Plaintiff argues "engagement assembly" should be construed as "the structure that engages the curb side container, including a hydraulic cylinder or other motor." (*See* Pl.'s Proposed Order at 2:8-9.) Defendant argues "engagement assembly" should be construed as "an assembled collection of parts coming into contact or interlocking, which collection of parts must include motor powered means to hold the refuse container during the emptying operation as interpreted below." (*See* Def.'s Proposed Order at 2:16-18.)

As with "dumping assembly," the parties' respective constructions focus on the function of the claimed "engagement assembly." The specification teaches that the function of the "engagement assembly" is to "securely attach[ ]" a curb side refuse container before its contents are emptied into the intermediate container. *See* '245 Patent, col. 7, lines 10-15, Figs. 7b-7d.

Accordingly, "engagement assembly" is construed as "the structure that securely attaches to a curb side container."

D. "Motor Powered Means to Empty the Contents of a Curb Side Refuse Container into said Intermediate Container"

The "dumping assembly," *i.e.,* the structure that dumps the contents of a curb side refuse container, is

described as "having motor powered means to empty the contents of a curb side refuse container into [the] intermediate container." *See* '245 Patent, col. 8, lines 6-8. The parties agree that the term "motor powered means to empty the contents of a curb side refuse container into [the] intermediate container" is written in means-plus-function language.

Claims written in means-plus-function language are "construed to cover the corresponding structure set forth in the specification and its equivalents." *See* 35 U.S.C. s. 112, para. 6. In construing a means-plus-function term, the district court's task is to "look[ ] to the written description to identify the structure corresponding to [the] function." *See* Micro Chemical, Inc. v. Great Plains Chemical Co., 194 F.3d 1250, 1258 (Fed.Cir.1999).

The function recited in the claim is "to empty the contents of the curb side refuse container into [the] intermediate container." *See* '245 Patent, col. 8, lines 6-8. Plaintiff argues that the structure "provid[ing] the motive force to empty the contents of the curb side container into the intermediate container" is the only structure the Court should identify, and contends that the specification indicates that the only such "motive force" is a "cylinder." (*See* Pl.'s Opening Claim Constr. Brief at 12:13-14, 13:1-3.) Although defendant agrees that a "cylinder," which both parties also refer to as a "hydraulic cylinder," is necessary structure, defendant argues that additional structure is necessary to perform the claimed emptying function.

The Court agrees with defendant that structure other than that supplying power is necessary because the recited function is "to empty" the contents of the curb side refuse container, not "to provide the power causing other structure to empty" the contents. The Court next turns to the specification to determine the corresponding structure. The specification, after discussing how the claimed device engages and then lifts a curb side refuse container, teaches how the device next carries out the function of emptying the curb side refuse container:

[E]xtendable arm 45 is retracted until cams 92 and 93 contact cam followers 150. As extendable arm 45 continues to retract, cam followers 150 force cams 92 and 93 downward, swinging tilt plate 90 with attached refuse container 24 upward. When tilt plate 90 reaches the proper elevation, cover 160 of refuse container 24 swings open allowing refuse to empty from body 154. When tilt plate 90 swings upward, a torsional force is build [sic] up in torsional spring 94.

See '245 Patent, col. 7, lines 27-35. The specification also teaches that the cam followers are placed in position to force the cams downward by "activating cylinder 145," which activation causes "rod 146 to extend," *see* '245 Patent, col. 7, lines 22-26; "cylinder 45" and "rod 146" are collectively referred to as "cylinder assembly 144," *see* '245 Patent, col. 6, lines 7-10.

Accordingly, the structure corresponding to the recited function of emptying the contents of a curb side refuse container are the above-referenced cams, cam followers, tilt plate, torsional spring, and cylinder assembly, as well as equivalents thereof.FN7

FN7. Plaintiff argues that if structure such as cams and cam followers is identified as corresponding structure for the purposes of Claim 1, the resulting construction will run afoul of the doctrine of claim differentiation. Specifically, plaintiff refers to Claim 6, which is dependent on Claim 1 and which, rather than including means-plus-function language, claims a "tilt mechanism [that] includes a cam and cam follower." *See* '245 Patent, col. 8, lines 42-45. The Federal Circuit, however, has rejected the argument advanced by plaintiff, stating: "it is settled ... that independent claims containing means-plus-function

limitations do not have the same literal scope as dependent claims reciting specifically the structure that performs the stated function." *See* Medtronic, Inc. v. Advanced Cardiovascular Systems, Inc., 248 F.3d 1303, 1313 (Fed.Cir.2001) (holding independent claim that included means-plus-function language broader than dependent claim without means-plus-function language because independent claim covered "structure described in [ ] specification and equivalents thereof," while dependent claim "[did] not literally cover equivalents").

E. "Motor Powered Means to Hold the Refuse Container During the Emptying Operation"

The "engagement assembly," which is carried on the "extendable element," is described as "having motor powered means to hold the refuse container during the emptying operation." *See* '245 Patent, col. 8, lines 3-5, 9-11. The parties agree the term "motor powered means to hold the refuse container during the emptying operation" is written in means-plus-function language.

The recited function of the subject means is to hold the curb side refuse container while the contents of the refuse container are emptied into the intermediate container by the "means to empty." *See* '245 Patent, col. 8, lines 9-11. Similar to the parties' dispute over the term "means to empty," discussed above, the parties dispute whether the structure necessary to perform the recited function is, as plaintiff argues, only a hydraulic cylinder that actuates the engagement assembly to hold a curb side container while said container is being emptied or, as defendant argues, the structure that performs the actual holding.FN8 For the reasons set forth above with respect to "means to empty," the Court finds structure other than a hydraulic cylinder is necessary to perform the recited function, and that such result does not run afoul of the doctrine of claim differentiation.

FN8. Defendant, in the alternative, argues that the term "means to hold" is indefinite because the specification does not "specifically use the claim language 'to hold." ' (*See* Def.'s Response to Pl.'s Opening Claim Constr. Brief at 18:7-9.) If a "specification discloses no structure that corresponds to the claimed function," the claim is "invalid for indefiniteness." *See* Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc., 296 F.3d 1106, 1113 (Fed.Cir.2002). As discussed, *infra,* the specification discloses a "grabber assembly" that "securely attaches" a curb side refuse container to the claimed device. The Court finds the patentee's use, in the specification, of "securely attaches" rather than "holds" does not render Claim 1 invalid for indefiniteness.

In describing the holding function performed by the claimed device, the specification states:

Extendable arm 45 is extended until *grabber assembly* 48 is positioned between upper grab bar 162 and lower grab bar 163.FN9 Lift arms 23 are then raised a distance sufficient to engage upper grabber 122 with upper grab bar 162. Referring now to Fig. 7c, cylinder assembly 120 is activated, extending operating rod 126. This engages lower grabber 123 to lower grab bar 163. The *spreading of upper grabber* 122 *and lower grabber* 123 *securely attaches refuse container* 24 to sidearm assembly 44.

FN9. "Upper grab bar 162" and "lower grab bar 163" are located on the curb side refuse container. *See* '245 Patent, Fig. 3.

See '245 Patent, col. 7, lines 5-15 (emphasis added). The specification describes the "grabber assembly" as including, in addition to the "upper grabber" and "lower grabber," a "double acting cylinder." *See* '245 Patent, col. 5, lines 40-42.

Accordingly, the structure corresponding to the recited function of holding a curb side refuse container while the container is being emptied is the above-referenced grabber assembly, consisting of "double acting cylinder," "upper grabber," and "lower grabber," as well as equivalents thereof.

With respect to the "equivalents thereof," defendant argues that such equivalents cannot include a "wrap-around mechanism utilizing two arms to close around a curb side refuse container." (*See* Def.'s Proposed Order at 2:23-25.) In support of this assertion, defendant contends plaintiff has disclaimed such construction. In other words, defendant argues that plaintiff has disclaimed a construction whereby a "means to hold" consisting of a "wrap-around mechanism utilizing two arms to close around a curb side refuse container" could be the equivalent of the particular "means to hold" structure disclosed in the specification.

Statements in the prosecution history may establish that the applicant has "disclaimed or disavowed subject matter, narrowing the scope of the claim terms." *See* Nystrom v. Trex Co., 374 F.3d 1105, 1112-13 (Fed.Cir.2004). "[F]or prosecution disclaimer to attach, [Federal Circuit] precedent requires that the alleged disavowing actions or statements made during prosecution be both clear and unmistakable." Omega Engineering, Inc. v. Raytek Corp., 334 F.3d 1314, 1325-26 (Fed.Cir.2003); *see, e.g.,* Microsoft Corp. v. Multi-Tech Systems, Inc., 357 F.3d 1340, 1347 (Fed.Cir.2004) (holding where applicant's statement in prosecution history "unambiguously reflect[ed]" applicant's understanding of its patents as being limited to transmission of data over "telephone line," claim could not be construed as covering transmission of data over "packet-switched network such as the Internet").

Here, defendant relies on a statement plaintiff made to the examiner during the prosecution of the patent. When the examiner considered plaintiff's claim, which, at that time, claimed a "sidearm assembly of engaging and emptying refuse containers, comprising [*inter alia*] a grabber assembly coupled to [a] tilt assembly," (*see* Def.'s Response to Pl.'s Opening Claim Constr. Brief Ex. H at CC000032), the examiner rejected such claim as being "anticipated by Bell et al.," (*see id*. Ex. H. at CC000067) .FN10 In response to the rejection, plaintiff amended its claim to clarify that the grabber assembly consisted of two grabbers and a spreader actuator, *e.g.,* a hydraulic cylinder, whereby each grabber would attach to a grab bar located on the refuse container. (*See id*. Ex. H at CC000076.) In an attempt to overcome the argument that its claim was anticipated by Bell et al., plaintiff stated:

FN10. The examiner was of the view that "Bell et al. show an extendable arm for dumping refuse containers into a refuse truck including a rocker frame 32 (tilt assembly) coupled to the end of the arm and clamping arms 34-36 (grabber assembly) coupled to the tilt assembly." (*See id*.)

Bell et al. does not disclose suggest or teach a first and second grabber which are moveable to engage an upper and lower grab bar on a refuse container. Bell et al. discloses a devices [sic] having clamping arms which are opened and closed around a trash container. Therefore, since each and every element of [plaintiff's claims] is not present in Bell et al., it is not believed to be anticipated thereby.
(*See id*. Ex. H at CC000080.) In using such language, plaintiff set forth, in a clear and unmistakable manner, its understanding that a grabbing assembly consisting of two grabbers, each of which attach to a

separate grab bar on a trash container, is not the equivalent of a grabbing assembly consisting of "clamping arms which are opened and closed around a trash container."
Accordingly, a "means to hold" consisting of clamping arms that open and close around a trash container is not an equivalent, for the purposes of 35 U.S.C. s. 112, para. 6, of grabber assembly, consisting of "double acting cylinder," "upper grabber," and "lower grabber."

F. "Motor Powered Means to Extend Said Extendable Element and Said Engagement Assembly into Engagement with the Refuse Container"

The "extendable element," which carries the "engagement assembly," is described as "having motor powered means to extend [the] extendable element and [the] engagement assembly into engagement with the refuse container." *See* '245 Patent, col. 8, lines 3-5, 12-14. The parties agree the term "motor powered means to extend said extendable element and said engagement assembly into engagement with the refuse container" is written in means-plus-function language.

The recited function of the subject means is to extend the extendable element and the engagement assembly carried thereon so as to allow the engagement assembly to engage with a curb side refuse container. *See* '245 Patent, col. 8, lines 12-14. Similar to their dispute over the two means-plus-function terms discussed above, the parties' dispute here concerns whether the structure necessary to perform the recited function is, as plaintiff argues, only a hydraulic cylinder that actuates the extendable element to extend itself and the engagement assembly carried thereon or, as defendant argues, the structure that performs the actual extending. For the reasons set forth above with respect to the other means-plus-function terms, the Court finds structure other than a hydraulic cylinder is necessary to perform the recited function, and that such result does not run afoul of the doctrine of claim differentiation.

According to the specification, "the extension of extendable arm 45 [occurs] by activating cylinder assembly 50 which extends operating rod 53." *See* '245 Patent, col. 3, lines 5-7. The specification teaches that "[c]ylinder assembly 50 includes a double acting cylinder 52 ... and reciprocally removable operating rod 53," *see* '245 Patent, col. 4, lines 35-37, and that "[g]uide members 56 and 58 are mounted for reciprocal movement corresponding to operating rod 53," *see* '245 Patent, col. 4, lines 42-44.

Accordingly, the structure corresponding to the recited function of extending the extendable element are the above-referenced cylinder assembly, consisting of "double acting cylinder" and "reciprocally removable operating rod," and guide members, as well as equivalents thereof.

CONCLUSION

For the reasons expressed, U.S. Patent No. 5,484,245 is construed in the manner set forth above.

IT IS SO ORDERED.

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