United States District Court,
D. Minnesota.

**WIMCO, LLC,**
Plaintiff.
v.
**LANGE INDUSTRIES, INC,**
Defendants.

No. 06-CV-3565 (PJS/RLE)

**Dec. 14, 2007.**

Matthew D. Spohn, David P. Pearson, and Brent A. Lorenz, Winthrop & Weinstine, PA, for plaintiff.

Mark R. Privratsky, David A. Allgeyer, and Christopher R. Smith, Lindquist & Vennum PLLP; Mark M. Nolan and Randy V. Thompson, Nolan, Macgregor, Thompson & Leighton, for defendant.

## *MARKMAN* ORDER

PATRICK J. SCHILTZ**, District Judge.**

This matter is before the Court for construction of certain terms found in the claims of U.S. Patent No. 7,052,207 (the '207 patent) in accordance with Markman v. Westview Instruments, Inc., 517 U.S. 370, 390-91 (1996). The parties prepared a joint claim-construction statement, and each side submitted two briefs (opening and response) on claim-construction issues. The Court held a *Markman* hearing on June 27, 2007.

## I. BACKGROUND

The '207 patent, titled "Sediment Control Drain and Method of Construction," covers a filter basin designed to be inserted into a street's storm-sewer drain in addition to or in lieu of the grate in order to keep debris from flowing into the storm sewer. FN1 The basin has two primary uses. First, the basin can be inserted when concrete work is being done in the area surrounding the storm drain; the basin catches and filters out wet concrete that might otherwise fall into the storm sewer. Second, the basin can be inserted while a subdivision is being developed to catch topsoil and other debris that tends to wash off into storm sewers when the ground is bare of vegetation.

FN1. Contrary to the implication of its title, the '207 patent does not include any method claims. A method claim in the initial patent application was dropped in the course of prosecution, but the title of the patent was not revised accordingly.

The patent drawings depict a sink-like basin with a circular hole in the middle of the basin's bottom and a

perforated standpipe around that hole. The standpipe is covered with filter material (a "filter sock"), and water that enters the basin passes through the filter material, into the standpipe, and out through the hole in the bottom of the basin. The top of the standpipe is left open so that overflowing water can exit the basin directly, without filtration, through the top of the standpipe. Finally, the basin includes a deflector wall on the side of the basin facing the curb; this wall ensures that debris is diverted into the basin and does not flow directly into the sewer through the opening in the curb.

Plaintiff WIMCO, LLC ("WIMCO") and defendant Lange Industries, Inc. ("Lange") compete to sell and service filter basins for storm drains. WIMCO owns the ' 207 patent, which was issued to Brian Wimberger, WIMCO's owner. Westman Decl. para. 2 [Docket No. 36]. WIMCO sued Lange in September 2006 for infringing the '207 patent, as well as for various state-law causes of action (false advertising, unfair competition, business torts, etc.). WIMCO alleges that Lange's filter basin-a basin that does not incorporate a standpipe-infringes claims 6 through 12 of the '207 patent. Pl. Claim Constr. Br. at 3 [Docket No. 26]. Claims 6 through 12 are not, on their face, limited to basins with standpipes. WIMCO is not asserting claims 1 through 5, which *are* expressly limited to basins featuring standpipes.

## II. APPLICABLE LAW

Courts, not juries, construe patent claims. Markman, 517 U.S. at 391. Language in a particular claim must be construed in the context of both that claim and the entire patent, including the specification. Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed.Cir.2005) (en banc). Indeed, the specification, read in light of the prosecution history, is the primary basis for construing patent claims. Id. at 1315. Courts may also rely on "extrinsic evidence"-everything other than the patent and its prosecution history-but that evidence is secondary to the intrinsic evidence. Id. at 1317.

In general, claim language means what it would have meant, ordinarily and customarily, to a person of ordinary skill in the art at the time the patent application was filed. Id. at 1312-13. In some cases, the ordinary and customary meaning of claim language to a person of ordinary skill in the art may be identical to the meaning of that language to a lay person who is not skilled in the art. Id. at 1314.

## III. CLAIM CONSTRUCTION

### *A. Overview*

The parties have asked the Court to construe a total of twelve terms in three different claims (five terms in each of claims 6 and 9 and two terms in claim 12). But the parties' list of terms is highly redundant. In some instances, the parties ask the Court to construe certain phrases and then to separately construe components of those same phrases; in other instances, the parties ask the Court to separately construe virtually identical terms in different claims. The Court finds that the number of distinct disputed terms can be reduced from twelve to nine, and the Court construes those nine terms below. In so doing, the Court construes all of the disputed claim language.

Although nine terms (by the Court's count) are at issue, the dispute between WIMCO and Lange boils down to two issues. First, Lange contends that claims 6 through 12 of the '207 patent should be interpreted to cover only basins that incorporate standpipes. WIMCO disagrees; it contends that claims 6 through 12 are broad enough to cover basins that do not feature standpipes. Second, Lange contends that only basins that fit "correctly" into storm-sewer drains are covered by claims 6 through 12. Again, WIMCO disagrees. According to WIMCO, the claimed basins must "fit" into storm-sewer drains, but do not necessarily have to

fit "correctly."

On the first and more important point, the Court agrees with WIMCO. As explained below, the Court will not read a standpipe limitation into claim language that, on its face, is not limited to covering basins with standpipes. On the second point-the required degree of fit between the patented basin and a storm-sewer drain-the Court adopts a position that is similar to Lange's.

The parties have not argued that someone of ordinary skill in the art would interpret any of the disputed language differently than would an educated lay person. Instead, the parties' arguments have focused on the '207 patent itself, its prosecution history, various pieces of prior art that are cited in the '207 patent, and definitions from general-purpose dictionaries. WIMCO also offers a declaration from the patent lawyer who prosecuted the patent (Nickolas Westman), but the Court has not considered this declaration in determining how to construe the claims. Westman's declaration contains evidence about Westman's state of mind and speculation by Westman about the state of mind of the patent examiner who reviewed the application that issued as the ' 207 patent. *See* Westman Decl. para.para. 11-12, 14. But even if the states of mind of Westman and the patent examiner were knowable, those states of mind would be of little use in determining, as the Court must, the *objective* meaning of the disputed claim language. Accordingly, the Court construes the disputed terms based on the intrinsic evidence and in light of the ordinary meaning that the claim language would have to an educated lay person.

### *B. Disputed Terms*

**1. The term "of size to fit into the grate frame" (claims 6 and 9).** FN2

FN2. In claim 6, the phrase "of size to fit into the grate frame" modifies one noun phrase ("open top receptacle"), whereas in claim 9 the phrase "being of size to fit into the grate frame" modifies a different noun phrase ("erosion control housing"). The parties treat "of size to fit into the grate frame" and "being of size to fit into the grate frame" as if they are different claim terms. Joint Claim Const. Stmt. ("JCCS") at 1, 3 [Docket No. 17]. In fact, both phrases include the same term ("of size to fit into the grate frame"). Claim 9 merely makes explicit (with the word "being") what is implicit in claim 6: The modified noun phrase ("open top receptacle" in claim 6; "erosion control housing" in claim 9) has the property of being "of size to fit into the grate frame." Accordingly, the Court treats the phrase "of size to fit into the grate frame," and not the phrase "being of size to fit into the grate frame," as the term to be construed, and gives the phrase the same meaning in both claim 6 and claim 9.

The Court construes this term to mean:

of a size to fit reasonably accurately into the grate frame.

WIMCO argues that this term does not need to be construed. Joint Claim Const. Stmt. ("JCCS") at 1, 3 [Docket No. 17]; Pl. Claim Constr. Br. at 8-10. Lange proposes construing it to mean "of a size to conform correctly to the shape or size of the grate frame." Def. Claim Const. Br. at 27-28 [Docket No. 28]. Based on the patent specification, the Court adopts a position close to Lange's.

The word "fit" is at once ordinary and imprecise; its meaning varies significantly depending on the context in which it is used. In some contexts, object A "fits" inside object B if A is smaller than B, regardless of how much smaller. For instance, if a store clerk asks a customer if her new television will "fit" into the

trunk of her car, the customer will answer "yes" as long as the trunk is larger than the television. It will make no difference whether the television will take up all of the room in the trunk or only a small portion of it; in either case, the customer will say that the television "fits" into the trunk. But if a mechanic is asked whether a nut "fits" onto a bolt, he will not say "yes" unless the threads on each are cut to match and the outer diameter of the bolt is nearly identical to the inner diameter of the nut, so that the threads on the nut will engage properly with the threads on the bolt. If the nut is so large that the bolt passes through without engaging, the mechanic will say that the nut does not "fit." In light of the protean nature of the word "fit," to leave the phrase "of size to fit into the grate frame" entirely undefined (as WIMCO suggests) would not give sufficient guidance to the jury that will have to decide infringement.

It is clear that, in the '207 patent, "fit" means something like the fit of a nut onto a bolt rather than the fit of a television into a car trunk. In several ways, the '207 patent specification indicates that the outer edges of the patented basin must fit fairly closely to the inside edges of storm-sewer grate frame. First, all of the patent drawings depict a basin that fits entirely within an existing storm-sewer grate frame, with neither significant gaps nor significant overlaps. In particular, Figure 2 shows a basin inside a grate frame and a grate inside that basin-that is, it depicts a basin sized to accommodate the *exact same grate* that is accommodated by the grate frame itself. Second, in describing the preferred embodiments, the patent provides: "Storm sewer frame castings are available in many shapes and sizes, and each erosion control basin then would be designed to fit into the frame with which it is used." '207 Patent col. 3:12-15. This language assumes a close fit between the basin and the grate frame, because it suggests that basins should be customized to particular grate-frame designs. Finally and most importantly, the sole purpose of the basin is to catch debris before it enters the storm sewer below the basin. The basin cannot fulfill its purpose if there are substantial gaps between the basin and the grate frame through which debris may flow.

In light of this evidence from the '207 patent, the Court finds that the claimed basin is "of size to fit into the grate frame" only if it fits reasonably accurately into the grate frame. This construction is admittedly not very precise, but it is as precise as the intrinsic evidence permits, and it serves to exclude from coverage those basins that fit so poorly within grate frames that they fail of their purpose.

**2. The term "filtered drain from the erosion control basin" (claim 6)** FN3

FN3. Lange asks the Court to construe separately the whole term "filtered drain from the erosion control basin" and the words "filtered drain" within that term. JCCS at 2. The Court sees no need to do so. In construing the entire term, the Court necessarily construes the term's components.

The Court agrees with WIMCO that this term does not need to be construed. *See* JCCS at 2. The words in this term are ordinary words, used in their ordinary sense, and any further definition or paraphrasing would serve no useful purpose.

Lange contends that "filtered drain" means "standpipe with filter sock." JCCS at 2; Def. Claim Constr. Br. at 30-31. Lange also contends that "from the erosion control basin" means "located in the interior of the erosion control basin." JCCS at 2; Def. Claim Constr. Br. at 32. Both of these contentions flow from the same premise: Lange contends that the intrinsic evidence compels the conclusion that the claims of the '207 patent cover only basins that incorporate a filtered drain made up of a perforated standpipe covered with a filter sock and located inside the basin, even if the claim language does not seem to be so limited. The Court disagrees.

Lange relies primarily on two sources for its contention that a "filtered drain" must be a "standpipe with filter sock." First, Lange points out that this is the only type of drain described in the patent. Def. Claim Constr. Br. at 30-31. Second, Lange argues that the prosecution history mandates Lange's claim construction because Wimberger, during the course of prosecution, distinguished the claimed invention from the prior art on the basis that the claimed invention had a standpipe with filter sock. Id. at 31. Although both the patent specification and the prosecution history provide some support for Lange's proposed construction, these two sources do not provide enough support to overcome the straightforward claim language.

Claim 6 is directed to an "erosion control basin comprising [1] an open top receptacle ... [2] a filtered drain from the erosion control basin to filter water draining from the open top receptacle including a filter supported in the basin below a top opening of the open top receptacle, and [3] a substan[t]ially imperforate deflector wall along one side of the erosion control basin...." ' 207 Patent col. 4:37-43. This claim language does not limit the basin's "filtered drain" in any way. In this respect, claim 6 contrasts sharply with claim 1, which covers an erosion-control basin having "a drain from the basin comprising *an upright pipe* ... said upright pipe having a wall with a plurality of openings there through, and a sock filter surrounding said upright pipe...." '207 Patent col. 3:45-51 (emphasis added). Under Lange's construction, the generic claim term "filtered drain" in claim 6 should be limited to the very specific type of drain claimed in claim 1. Both the doctrine of claim differentiation and simple common sense render it unlikely that the term "filtered drain" in claim 6 has such a narrow meaning. FN4 Claim 1 leaves no doubt that Wimberger knew how to claim a standpipe with a sock filter and easily could have done so in claim 6 had he wanted.

FN4. *See* Andersen Corp. v. Fiber Composites, LLC, 474 F.3d 1361, 1369 (Fed.Cir.2007) ("Th[e] doctrine [of claim differentiation] is based on 'the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope.' Karlin Tech. Inc. v. Surgical Dynamics, Inc., 177 F.3d 968, 971-72 (Fed.Cir.1999). 'To the extent that the absence of such difference in meaning and scope would make a claim superfluous, the doctrine of claim differentiation states the presumption that the difference between claims is significant.' Tandon Corp. v. U.S. Int'l Trade Comm'n, 831 F.2d 1017, 1023 (Fed.Cir.1987).").

Lange also notes that every one of the embodiments described or depicted in the '207 patent features a filter sock around a standpipe. Def. Claim Constr. Br. at 30-33. But it is black-letter law that patent claims are not, as a rule, limited to preferred embodiments. Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1122 (Fed.Cir.2004) ("[T]he law does not require the court, where an applicant describes only a single embodiment, to construe the claims as limited to that one embodiment. Indeed, such a construction is not encouraged or presumed.") (citations omitted). Further, the section of the '207 patent in which the preferred embodiments are described concludes with an express reminder that the preferred embodiments do not limit the claims: "Although the present invention has been described with reference to preferred embodiments, workers skilled in the art will recognize that changes may be made in form and detail without departing from the spirit and scope of the invention." '207 Patent col. 3:30-34.

Lange's strongest argument with respect to the patent specification is that, in describing the invention as a whole, Wimberger characterizes it as featuring a standpipe with a filter sock. For example, the patent's "Abstract" section describes the "erosion control basin" and says that "[a] filter is formed around an upright perforated drain pipe that is on the interior of the basin and which opens to an outlet." '207 Patent Abstract. Moreover, the "Summary of the Invention" section provides: "The *present invention* relates to a drain catch

basin.... The catch basin has a center perforated tube forming a drain tube, that is covered with a filtration sock, or fine mesh, to filter out large debris but yet let water pass through for draining as necessary. The upper opening of the tube, which forms a standpipe type structure, is left open...." '207 Patent col. 1:41-48 (emphasis added).

Lange correctly notes that when a patent specification describes "the invention" as a whole in narrow terms, claim language is sometimes construed narrowly to cover only the specific thing that is identified as "the invention" in the specification. Def. Resp. Claim Constr. Br. at 9-12 [Docket No. 38]; *see* C.R. Bard, Inc. v. U.S. Surgical Corp., 388 F.3d 858, 864 (Fed.Cir.2004); Microsoft Corp. v. Multi-Tech Sys., Inc., 357 F.3d 1340, 1348 (Fed.Cir.2004); Alloc, Inc. v. Int'l Trade Comm'n, 342 F.3d 1361, 1370 (Fed.Cir.2003) ("[W]here the specification makes clear at various points that the claimed invention is narrower than the claim language might imply, it is entirely permissible and proper to limit the claims."). The Court finds, however, that the '207 patent specification does not expressly limit the claimed invention to a basin that features a standpipe. The broad language of claim 6 plainly covers structures that are not standpipes with filter socks, while the narrow language of claim 1 just as plainly covers only structures that are standpipes with filter socks. Further, as noted above, the specification asserts that "changes may be made in form and detail without departing from the spirit and scope of the invention." '207 Patent col. 3:32-34. Claim 6 of the '207 patent therefore differs significantly from the claims of patents that the Federal Circuit has held to be limited to particular embodiments by virtue of narrowing language in patent specifications. *Cf.* C.R. Bard, 388 F.3d at 864; Multi-Tech Sys., 357 F.3d at 1348; Alloc, Inc., 342 F.3d at 1369-70.

The '207 patent's prosecution history does not change the Court's analysis. Lange argues that, in the course of prosecution, Wimberger disclaimed coverage of anything other than a basin with a standpipe, and that claim 6 must be construed accordingly. Although the general principle of prosecution disclaimer is relevant to claim construction, application of that principle does not mandate the construction advocated by Lange. FN5

FN5. Prosecution disclaimer is related to, but distinct from, prosecution-history estoppel. *See* Ventana Med. Sys., Inc. v. Biogenex Labs., Inc., 473 F.3d 1173, 1182 (Fed.Cir.2006) (explaining and applying "the doctrine of prosecution disclaimer"); *see also* 5B Donald S. Chisum, *Chisum on Patents* s. 18.05[4][b] (2007). The doctrine of prosecution disclaimer provides that if a patentee clearly disclaims certain claim scope in the course of securing a patent, the patent's claims cannot be construed to literally cover the disclaimed material. Prosecution disclaimer is therefore a doctrine that limits *claim construction*. The doctrine of prosecution-history estoppel (also known as *Festo* estoppel), however, provides that when a patentee clearly disclaims certain claim scope in the course of securing a patent, the patentee cannot, when attempting to prove infringement, use the doctrine of equivalents to effectively reacquire the claim scope that the patentee disclaimed. Prosecution-history estoppel is therefore a doctrine that limits *infringement analysis*. *See* 5B Donald S. Chisum, *Chisum on Patents* s. 18.05 [4][b] at 18-1159 (2007) ("Interpreting claims in view of the prosecution history applies as a preliminary step in determining literal infringement. Prosecution history estoppel applies as a limitation to the doctrine of equivalents after the claims have been properly interpreted and no literal infringement is found.").

Claim 6 was not added until quite late in the prosecution of the '207 patent. The patent application as it was first considered by the U.S. Patent and Trademark Office ("PTO") included five claims: four apparatus claims directed to a basin with a standpipe and one method claim directed to a "method of constructing a storm drain" that was not limited to using a basin with a standpipe. Westman Decl. Ex. A (Patent

Application) at 7-9, Ex. B (Preliminary Amend.) at 2-3.

The patent examiner understood that the apparatus claims in the '207 patent application, as first considered by the PTO, were limited to basins with standpipes. Indeed, the examiner required Wimberger to restrict his application to *either* the apparatus claims *or* the method claim, because the method claim "can be practiced by another materially different apparatus [i.e., one other than the device claimed in the apparatus claims], such as a filtering basket in the basin *without the upright drain pipe* wrapped around with filtering material." Westman Decl. Ex. C (PTO Office Action Mar. 17, 2004) at 2 (emphasis added).

In response, Wimberger elected to pursue only the apparatus claims. Wimberger also responded to arguments that the examiner had made in rejecting a related patent application (which issued as U.S. Patent No. 6,609,852), although the examiner had not yet raised those arguments in connection with the application that issued as the '207 patent. Wimberger argued that his apparatus claims were patentable over two prior-art references, Williamson (U.S. Patent No. 6,287,459) and Singleton (U.S. Patent No. 5,843,306). Wimberger asserted that there was no suggestion in the prior art that would lead to his invention, i.e., "a basin that has a peripheral wall that encircles the basin, and surrounds an *upright drain pipe*." Westman Decl. Ex. D (Amend.Apr.19, 2004) at 5 (emphasis added). Wimberger repeatedly emphasized the importance of the standpipe to his claimed invention, and distinguished it from the prior art on the basis that "the present device ... has a bottom wall with an upright pipe in the bottom wall, and with a filter around the upright pipe to accomplish filtering of silt and debris before being transferred out through an opening in the bottom wall." Id. at 7. FN6

FN6. In addition, Wimberger argued:
[T]here is no suggestion in the Williamson patent that a filter that filters round a pipe that is spaced from the peripheral walls would be possible, or desirable.... In fact, there is no suggestion that the basin of Williamson would support an upright pipe connected on a bottom wall.... The open bottom of the filter frame shown in Figure 3 of Williamson will not support an upright pipe that has openings and a filter around the pipe.... Since there is no bottom wall in the Williamson device that can support an upright pipe with a filter around it, if the unit shown in the Singleton patent was placed into that frame [i.e., the frame disclosed in the Williamson patent], water would flow out around the corners, and [the unit] would not work for its intended purpose."

Westman Decl. Ex. D (Amend.Apr.19, 2004) at 6.
These remarks make clear that, as initially conceived, the invention claimed in the '207 patent covered only a basin with a standpipe. But at the time that Wimberger made these remarks, the only claims before the PTO were apparatus claims that expressly included a standpipe-claims that eventually issued as claims 1 through 5 of the '207 patent. There is no dispute that claims 1 through 5 cover only basins with standpipes, and those claims have not been asserted in this case.

The examiner disagreed with Wimberger's arguments about the prior art and, on June 23, 2004, rejected what are now claims 1 and 5 as obvious in light of the prior art. Westman Decl. Ex. F (PTO Office Action June 23, 2004) at 3-4. The examiner also rejected all of the claims as obvious in light of Wimberger's related patent, U.S. Patent No. 6,609,852 (the '852 patent), but advised Wimberger that this ground of rejection (obviousness-type double patenting) could be overcome if Wimberger filed a terminal disclaimer to limit the term of what became the '207 patent to the term of the' 852 patent. Id. at 4-7.

Meanwhile, before he received word of the PTO's June 23 rejection, Wimberger again amended his claims, adding for the first time apparatus claims that were *not* expressly directed to a basin with a standpipe. Those new claims, which were directed to an erosion-control basin with "a filtered drain," eventually issued as claim 6 (an independent claim) and claims 7 to 8 (dependent claims based on claim 6). *See* Westman Decl. Ex. E (Suppl. Amend. June 21, 2004) at 4. In submitting the new claims, Wimberger did not mention that they covered basins without standpipes. Instead, he asserted that the new claims "relate specifically to an erosion control basin of the type present in [what was then] claim 8"-i.e., in *current* claim 1, which includes a standpipe. Id . at 5. Wimberger pointed out only one difference between the new, non-standpipespecific claims and the earlier standpipe-specific claims, asserting that "[t]he feature of the new claims is the *deflector wall* that aids in controlling overflow water and diverts or deflects water from a[n] overflow opening forming part of the storm sewer inlet on a lateral side of the grated [ *sic* ] frame." Id. (emphasis added).

In August 2004, in response to the amendment including these new claims, the patent examiner reiterated his earlier rejection of the standpipe-specific claims as obvious in light of the prior art, as well as his earlier rejection of those claims based on obviousness-type double patenting (a rejection that could be overcome by a terminal disclaimer). Westman Decl. Ex. G (PTO Office Action Aug. 27, 2004) at 3-8. But as to the new, non-standpipe-specific claims, the examiner did *not* reject them as obvious (apparently because of the inclusion of the deflector wall); rather, he found that they would be allowable if Wimberger filed a terminal disclaimer. Id. at 8. The examiner did not mention anything about the fact that the new claims were not drawn to basins with standpipes.

If the prosecution history had ended at that point, the Court would likely agree with Lange that, based on the prosecution history, Wimberger disclaimed coverage of basins without standpipes. Wimberger first distinguished his invention from the prior art on the basis that the prior art did not disclose a standpipe. Westman Decl. Ex. D (Amend.Apr.19, 2004) at 5-7. He then described his non-standpipe-specific claims as being "of the type present" in claims that featured standpipes, and pointed out a single difference-a deflector wall-in the new claims without pointing out an arguably more-significant difference-the lack of a standpipe. Westman Decl. Ex. E (Suppl. Amend. June 21, 2004) at 5.

WIMCO argues that Wimberger described the new claims as "of the type present" in the earlier-submitted, standpipe-specific claims only to point out that they were apparatus claims, in contrast to the abandoned method claim. Pl. Reply Br. Supp. Claim Constr. at 7-8 [Docket No. 35]. Perhaps this was Wimberger's subjective intent, but that subjective intent is irrelevant. The doctrine of prosecution disclaimer is grounded in the notion that the public should be able to rely on statements made by a patentee in the course of obtaining a patent. The public does not have access to the subjective intentions of a patentee or his lawyer; accordingly, only the *objective* import of the patentee's statements is relevant. *See* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed.Cir.1996) ("The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention.").

By the time Wimberger added the non-standpipe-specific claims, he had already abandoned the method claim. *See* Westman Decl. Ex. D (Amend.Apr.19, 2004) (electing to prosecute apparatus claims). Thus it is highly unlikely that an objective reader of the prosecution history would construe Wimberger's statement that the non-standpipe-specific claims were drawn to a basin "of the type present" in current claim 1 to

mean merely that they were apparatus claims (something that was readily apparent from the face of the claims and that did not need to be pointed out to the PTO). Rather, an objective reader would take that statement to mean that the new claims were drawn to an apparatus like the apparatus that had already been claimed, with one difference (the only difference noted by Wimberger): The new claims featured a deflector wall.

The prosecution history did not, however, end at this point. Wimberger responded to the examiner's August 2004 rejection of the standpipe-specific claims by again emphasizing the standpipe, but he emphasized it only in connection with the standpipe-specific claims, and *not* in connection with the new, non-standpipe-specific claims. Westman Decl. Ex. H (Amend.Nov. 19, 2004) at 6-9. At the same time, Wimberger filed a terminal disclaimer to overcome the rejection of the non-standpipe-specific claims. The PTO then allowed, without comment, all of the previously rejected claims, both standpipe-specific and non-standpipe-specific. Westman Decl. Ex. J (Notice of Allowability Mar. 23, 2005).

A few months after the PTO's allowance of the claims, Wimberger filed a "Request for Continued Examination" to reopen prosecution of the patent and to amend it by adding additional claims. Westman Decl. Ex. K (Request for Cont. Exam. June 16, 2005). Specifically, the main purpose of the amendment was to add four new non-standpipe-specific claims, which eventually issued as claims 9 through 12. In response, the examiner not only rejected the new claims, but he also rejected the non-standpipe-specific claims that he had previously allowed. Westman Decl. Ex. L (PTO Office Action Summary July 26, 2005). In doing so, the examiner clearly demonstrated his understanding that the non-standpipe-specific claims were drawn to a basin that did *not* necessarily include a standpipe. The examiner rejected the claims that eventually issued as claims 6 through 12 as either anticipated or obvious in light of U.S. Patent No. 5,405,539 to Schneider, which discloses an L-shaped, mesh-covered structure for filtering water at storm-sewer inlets. *See* Westman Decl. Ex. L (PTO Office Action Summary July 26, 2005) at 3-5; U.S. Patent No. 5,405,539. The structure disclosed in Schneider filters water through two flat, mesh-covered surfaces, the first of which is parallel to the ground and the second of which is perpendicular to the first. Schneider includes nothing even vaguely resembling a standpipe.

Wimberger responded to this rejection by making minor amendments to his claims and by distinguishing the rejected claims from Schneider. In distinguishing Schneider, Wimberger emphasized that his claimed basin had a different frame from the Schneider invention and featured a deflector wall and an overflow opening that were not found in Schneider. Westman Decl. Ex. N (Amend.Oct.25, 1995) at 7-9. The examiner was apparently persuaded, because he allowed the challenged, non-standpipe-specific claims, which issued as claims 6 through 12.

The examiner's rejection of Wimberger's non-standpipe-specific claims in light of Schneider put the world on notice that Wimberger's patent was *not* limited to basins with standpipes. That rejection (which Wimberger eventually overcame) also establishes that Wimberger did not secure allowance of his claims by misleading the PTO as to their nature. Even if Wimberger, early in the prosecution history, tried to distract the patent examiner from the fact that some of his claims did not require a standpipe, the examiner was well aware of this fact by the time he allowed the claims that issued as the '207 patent. The doctrine of prosecution disclaimer does not, therefore, mandate construing the broad term "filtered drain from the erosion control basin" in claim 6 to cover only the narrow embodiment of a "standpipe with filter sock located in the interior of the erosion control basin," as Lange contends.

**3. The term "a filter supported in the basin below a top opening of the open top receptacle" (claim 6)**

FN7

FN7. Lange asks the Court to construe the entire phrase "a filter supported in the basin below a top opening of the open top receptacle" and then to separately construe the words "top opening" within the phrase. The Court sees no need to do so. In construing the phrase as a unit, the Court necessarily construes the components of the phrase.

The Court construes this term to mean:

a filter supported in the basin below the open top of the receptacle.

Lange argues that this means "a filter sock supported on a standpipe, having a top opening, extending from the bottom of an open top erosion control basin." JCCS at 2; Def. Claim Constr. Br. at 33. WIMCO proposes a construction that repeats the claim language, but provides an additional gloss on the term "open top receptacle," defining it as "the erosion control basin." JCCS at 2 (proposing this construction: "A filter supported in the basin below a top opening of the open top receptacle, the open top receptacle also being known as the erosion control basin."). The Court adopts neither proposed construction.

Lange's proposed construction rests largely on the fact that the patent discloses only basins with standpipes. Def. Claim Constr. Br. at 33-34. For the reasons already given in connection with the term "filtered drain from the erosion control basin," the Court declines to limit otherwise broad claim language (in this term, the words "filter supported in the basin") to the preferred embodiments disclosed in the '207 patent.

The Court also disagrees with Lange's contention that the words "top opening" must be construed as the top of a standpipe because the specification refers to "the top of the drainpipe" and provides that the "upper opening of the tube, which forms a standpipe type structure, is left open...." *See* Def. Claim Constr. Br. at 33-34; '207 Patent Abstract; '207 Patent col. 1:47-48. The "top opening" of the standpipe is not the only "top opening" disclosed in the patent; the basin itself obviously has a top opening. Just as obviously, it is the basin's top opening to which the disputed language in claim 6 refers; after all, as described at length above, claim 6 does not even require a standpipe.

The Court rejects WIMCO's proposed construction because it is inconsistent with the language of claim 6. As noted above, claim 6 is directed to an "erosion control basin *comprising* " three things: an "open top receptacle," a "filtered drain," and a "deflector wall." '207 Patent col. 4:37-43 (emphasis added). Because the "open top receptacle" is but one component of the "erosion control basin," the Court cannot construe the "open top receptacle" to be identical to the "erosion control basin," as WIMCO proposes.

Nonetheless, the Court agrees in substance with WIMCO that the "top opening of the open top receptacle" is the top opening of the receptacle portion of the basin, not the top opening of a standpipe within the basin. Claim 6 (which, again, does not *require* a standpipe) provides that the "top opening" at issue is the top opening " *of* the open top receptacle." The Court's claim construction is dictated by this language.

The Court's claim construction does, however, appear to conflict slightly with one aspect of the claim language and with an amendment made during the prosecution history. Wimberger originally proposed claim language almost identical to the Court's claim construction. The now-disputed language, which reads "a filter supported in the basin below *a top opening* of the open top receptacle," originally read "a filter

supported in the basin below *the open top*." Westman Decl. Ex. N (Amend.Oct.25, 1995) at 4 (emphasis added). It was the patent examiner, in a telephone conversation with the patent prosecutor, who required that "below the open top" be replaced with "below a top opening of the open top receptacle." Smith Decl. Ex. G (Examiner's Amend./Cmt.) at 2 [Docket No. 29]. Admittedly, the Court's construction effectively reverses this amendment. But a full review of the prosecution history-along with an understanding of the sometimes-strange dialect and customs of claim drafters-establish that the Court's construction is nonetheless correct.

The patent examiner, in his summary of his telephone interview with Wimberger's patent lawyer about this amendment, said that Wimberger's lawyer authorized the amendment to overcome an indefiniteness problem under 35 U.S.C. s. 112, paragraph 2. Examiner Int. Summary Nov. 18, 2005, *available at* http://portal.uspto.gov/external/portal/pair (search for U.S. Patent No. 7,052,207, then select tab labeled "Image File Wrapper"). How was the phrase "below the open top" in the claim as originally submitted indefinite under s. 112, paragraph 2? Most likely, a "layperson" would not have found "below the open top" to be indefinite at all. The claim, before the examiner's amendment, referred to "the *open top receptacle* including a filter supported in the basin below *the open top* ...." Westman Decl. Ex. N (Amend.Oct.25, 2005) at 4 (emphasis added). The typical lay reader would undoubtedly conclude that "the open top" below which the "filter is supported" must be the same "open top" found in the phrase "open top receptacle."

Patent drafters and examiners, however, speak their own peculiar dialect. In that dialect, the noun phrase "the open top" (following the preposition "below") must have some "antecedent basis"-that is, it must refer back to an earlier use of that noun phrase. *See* Robert C. Faber, *Landis on Mechanics of Patent Claim Drafting* s. 3:11 at 3-49 (2007) ("To avoid such a problem [i .e., rejection for indefiniteness], be sure that every reference-back word-whether "said," "the," or others that might be used, like "this," "each," and "every"-has the actual antecedent which the reference-back word implies."). A linguist would recognize that the words "open top" in the phrase "the open top receptacle" is, in fact, a noun phrase being used as an attributive modifier, and not an adjective (as it might appear to most nonlinguists), and that "the open top" in the phrase "below the open top" therefore *does* have a clear antecedent. FN8

FN8. *See* Rodney Huddleston & Geoffrey K. Pullum, *The Cambridge Grammar of the English Language* Ch. 6 s. 2.4.1(a) at 537 (discussing attributive modifiers), Ch. 19 s. 3.3(b) at 1643 ("School grammars tend to say that in expressions like *the Clinton policy* the word *Clinton* is (or 'is used as') an adjective but ... this is to confuse the word-category adjective with the function modifier of a noun. Any noun (other than a pronoun) can occur in this function, given a suitable head noun, so the appropriate way to handle such data is in terms of syntax (the distribution of nouns), not in terms of word-formation (the creation of new words).").

But patent drafters and examiners are not linguists, and they expect noun phrases like " *the* duck" to refer back to " *a* duck" that has already been defined. The word "duck" used as an attributive modifier (as in "duck blind") does not identify " *a* duck" in a way that satisfies the expectations of patent drafters and examiners. The leading treatise on drafting patent claims instructs as follows:

The first time an element or part is mentioned, it should not be preceded by a definite article ("the") or by "said." Instead the indefinite article ("a" or "an") should be used ...: " *a* container," " *a* base," etc.... When each previously identified element or part is referred to again, the definite article should be used, as " *the* container," " *the* base"....

*Id*. at s. 3:11 at 3-48 (footnote omitted); *see also id*. at s. 10:7.4 at 10-44 ("A new element or step is introduced with an indefinite article 'a' or 'an.' ... On the other hand, when a previously identified element or step is repeated, it is introduced by a definite article 'the' or 'said.' ").

Recall that the patent examiner changed "below *the* open top" to "below *a* top opening of the open top receptacle." Smith Decl. Ex. G (Examiner's Amend./Cmt.) at 2 (emphasis added). This change follows naturally from the practice, in drafting patent claims, of always using the indefinite article the first time a claim element is introduced, and of considering the claim element " *the* duck" to be indefinite if it has not already been introduced as " *a* duck." Claim 6, as originally drafted, referred to " *the* open top" without ever having recited " *an* open top." Westman Decl. Ex. N (Amend.Oct.25, 2005) at 4. The examiner's amendment corrected this fancied defect in the original claim language. FN9 The examiner's interview notes make clear, however, that this was a technical change, not a substantive one. The Court's construction simply rephrases the claim language in a way that a layperson can understand, without changing that language's meaning.

FN9. A different examiner's amendment introduced an error into claim language that had previously been correct. Claim 11, as originally submitted, was drawn to a basin designed to "support a slatted grate that overlies the grate frame." Westman Decl. Ex. K (Amend. Jun 16, 2005) at 5. The examiner required Wimberger to changed "slatted grate"-i.e., a grate with slats-to "slated grate," which demonstrates that the examiner overlooked principles of English orthography. *See* Westman Decl. Ex. L (PTO Office Action Summary July 26, 2005) at 3.

**4. The term "drain opening" (claim 9, claim 12)** FN10

FN10. Although the parties identify the term "drain opening" in claim 9 as a term that needs to be construed, they do not separately identify the term "drain opening" in claim 12 as needing construction. Instead, Lange implicitly tries to secure a construction of the term "drain opening" in claim 12 by asking the Court to construe the larger phrase "below the open top and above the drain opening to form a drain." *See* JCCS at 4. The term "drain opening" in claim 12 has the same meaning as "drain opening" in claim 9. Accordingly, the Court construes the term only once.

The Court agrees with WIMCO that this term does not need to be construed. The words "drain opening" are ordinary words, used in their ordinary sense, and any further definition or paraphrasing would serve no useful purpose.

Lange argues that "drain opening" means "bottom of standpipe." JCCS at 3; Def. Claim Constr. Br. at 36-37. Lange's argument relies primarily on the fact that the '207 patent specification discloses only one type of drain, a hole at the bottom of the standpipe. This is true, but it is not a sufficient reason to limit the broad term "drain opening" to cover only a single embodiment. In so limiting the term, the Court would be wrongly importing a limitation from the specification into the claims.

**5. The term "drain opening defined by the erosion control housing" (claim 9)**

The Court construes this term as follows:

A drain opening is "defined by the erosion control housing" if it is an opening whose boundaries are formed by, and found within, the erosion-control housing.

As noted above, "drain opening" does not need to be construed. This larger phrase containing the term "drain opening" also may not need to be construed, but the Court construes it because a jury of laypersons may not be familiar with how the word "define" is used. The most common meaning of the word "define" is "to state the precise meaning" of something or "[t]o describe the nature or basic qualities" of something. *American Heritage Dictionary of the English Language* at 476 (4th ed.2000). To "define" an opening, however, is to establish its boundaries. *See* id. (providing additional definitions of "define": "2a. To delineate the outline or form of: *gentle hills that were defined against the sky*. b. To specify distinctly: *define the weapons to be used in limited warfare*. 3. To give form or meaning to....").

The boundaries of an opening in an object are "defined" by that object because they are formed by, and found within, that object. This construction of the word "defined" in claim 9 is consistent with how the word is used in claim 6 and claim 12, the only other places in the '207 patent where the word is used.FN11

FN11. Claim 6 describes a "storm sewer inlet having an opening on a lateral side of the grate frame above the grate opening and *defined in* the street curb...." '207 Patent col. 4:35-37 (emphasis added). The "opening" of the storm sewer inlet is "defined" in the street curb because its boundaries are formed by, and found within, the street curb. Claim 12 describes "an opening for overflow *defined by* portions of the erosion control housing...." '207 Patent col.6:4-5 (emphasis added). The boundaries of this "opening for overflow" are formed by, and found within, portions of the erosion-control housing.

**6. The term "filter support" (claim 9)**

The Court agrees with WIMCO that this term does not need to be construed. Both "filter" and "support" are ordinary words used in their ordinary senses.

WIMCO proposes to define "filter support" to mean "[t]he portion of the erosion control housing that holds up, serves as a foundation for, serves as a prop for, or braces the filter." JCCS at 3; Pl. Claim Constr. Br. at 18. The Court rejects this proposed construction because it does little more than provide a series of synonyms for the word "support." The synonyms are accurate enough, but they add nothing useful to already-straightforward claim language. FN12

FN12. Indeed, WIMCO says as much, and offers its proposed construction of this term while noting that the term's meaning "should be sufficiently clear from its plain language...." Pl. Claim Constr. Br. at 18.

Lange argues that a "filter support" is a "standpipe." JCCS at 3; Def. Claim Constr. Br. at 37-38. For reasons already given, the Court rejects this argument.

**7. The term "filter support to support a filter to filter water entering the open top and exiting the drain opening" (claim 9)**

The Court agrees with WIMCO that this term does not need to be construed. The Court has already held that it need not construe the individual terms "filter support" and "drain opening" within this longer term. The remainder of this longer term simply uses ordinary language to describe the functions of the filter support: It "support[s] a filter"; that filter, in turn "filter[s] water"; the water first "enter[s] the open top"; and, after that, the water "exit[s] the drain opening."

The only word in this term that could conceivably benefit from additional construction is the word "filter." Indeed, it appears that Lange would like the Court to construe "filter" in this phrase to mean "filter sock," although Lange has buried this proposed construction within a proposed construction of the term as a whole that is somewhat inconsistent with Lange's proposed construction of "filter support" standing alone. Lange contends that a "filter support" is a "standpipe." JCCS at 3; Def. Claim Constr. Br. at 37-38. If that were true, a "filter support to support a filter to filter water" would be a "standpipe to support a filter to filter water." But Lange asks the Court to define a "filter support to support a filter to filter water" as a "filter sock around a standpipe to filter water." JCCS at 4; Def. Claim Constr. Br. at 39. It seems that Lange intends to argue that a "filter support to support a filter to filter water" should be construed to be a "standpipe [i.e., a filter support] to support a filter sock [i.e., a filter] to filter water."

The Court will not construe "filter" in this term to mean "filter sock." The claim language is not so limited, and there is no more reason to limit a "filter" to a preferred embodiment (a "filter sock") than there is to read a "standpipe" limitation into the claims. Given that a standpipe would necessarily be fitted with a filter around its circumference, i.e., a filter sock, Lange's argument that "filter" means "filter sock" is really just a different way of arguing that "filter support" means "standpipe." That argument has already been rejected.

**8. The term "opening for overflow" (claim 12)**

The Court agrees with WIMCO that this term does not need to be construed. The words "opening for overflow" are ordinary words, and nothing in the intrinsic evidence requires those words to be given some unusual meaning.

The Court therefore rejects Lange's argument that an "opening for overflow" is necessarily the "top opening of [a] standpipe." JCCS at 4; Def. Claim Constr. Br. at 39-40. As the Court has already explained, claim 9 (from which claim 12 depends), like claim 6, is not limited to basins with standpipes. Accordingly, although an "opening for overflow" *could* be the top of a standpipe (as it is in the preferred embodiments disclosed in the '207 patent), it does not *have* to be the top of a standpipe.

**9. The term "below the open top and above the drain opening to form a drain" (claim 12)**

The Court construes this term to mean:

below the open top of the erosion-control housing and above the drain opening to form a drain.

The Court's construction simply clarifies what is already implicit in the claim language-that the "open top" in the term "below the open top and above the drain opening to form a drain" is the "open top of the erosion control housing." This is clear from claim 9, upon which claim 12 depends. Claim 9 defines the claimed "erosion control housing" as "having an open top...." ' 207 Patent col. 4:60-61. The "open top" in claim 12 is necessarily the "open top" of the erosion-control housing referred to in claim 9.

Lange asks the Court to construe this term to mean "below the open top erosion control housing and above the standpipe hole in the bottom of the erosion control housing." JCCS at 4; Def. Claim Constr. Br. at 40-41. The first portion of Lange's proposed construction is not substantially different from the construction adopted by the Court. (Lange proposes "the open top erosion control housing," whereas the Court uses the words "the open top of the erosion control housing.")

As noted above in connection with the term "drain opening," Lange is really asking the Court to construe the term "drain opening" within this longer term. According to Lange's proposed construction of this longer term, a "drain opening" is a "standpipe hole in the bottom of the erosion control housing." JCCS at 4; Def. Claim Constr. Br. at 40-41. The Court has already rejected Lange's attempt to define a "drain opening" as being a hole for the bottom of a standpipe. The term "drain opening" in this term has the meaning that the Court has already given it above.

## IV. CONCLUSION

In light of the patent's specification (including the claims), the prosecution history, the purpose of the '207 patent as disclosed in the intrinsic evidence, and the ordinary meaning of the claim language, the Court construes the disputed claim language as stated above.

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