United States District Court,
S.D. California.

NESSCAP CO., LTD,
Plaintiff/Counter-Defendant.
v.
MAXWELL TECHNOLOGIES, INC,
Defendant/Counter-Claimant.
Maxwell Technologies, Inc,
Plaintiff.
v.
Nesscap, Inc. and Nesscap Co., Ltd,
Defendants.

April 21, 2008.

Brian M. Gaff, George W. Neuner, Barbara L. Moore, David Cotta, Edwards, Angell, Palmer & Dodge, LLP, Boston, MA, Andrea M. Kimball, Callie A. Bjurstrom, Michelle Ann Herrera, Luce, Forward, Hamilton and Scripps, San Diego, CA, for Plaintiff/Counter-Defendant.

David C. Doyle, Brian M. Kramer, Edwin Dale Buxton, Eric Martin Acker, Marc D. Sharp, Morrison and Foerster, San Diego, CA, for Defendant/Counter-Claimant.

CLAIM CONSTRUCTION ORDER FOR UNITED STATES PATENT NUMBERS 6,631,074, 6,525,924, 6,842,330, 7,180,726, and 6,743,544

JANIS L. SAMMARTINO**, District Judge.**

Pursuant to Markman v. Westview Instruments, Inc., 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), the Court conducted a hearing on December 11, 2007 regarding the construction of the disputed claims in Maxwell Technologies, Inc.'s United States Patent Numbers 6,631,074 ("074 patent"), 6,525,924 ("924 patent"), 6,842,330 ("330 patent"), and 7,180,726 ("726 patent), and in Nesscap Co., Ltd.'s United States Patent Number 6,743,544 ("544 patent").

LEGAL STANDARD

I. The Anatomy of a Patent

A patent includes two basic parts: (1) a written description of the invention, which may include drawings and is referred to as the "specification," and (2) the patent claims. The cover page of the patent provides identifying information: the date the patent issued and the patent number along the top, as well as the inventor's name, the filing date, and a list of the prior art publications considered by the U.S. Patent Office in issuing the patent. The specification of the patent begins with an Abstract, found on the cover page. The

Abstract is a brief statement about the subject matter of the invention. The drawings of the invention follow the Abstract. The drawings depict various aspects or features of the inventions and the embodiments of the claims. The written description of the invention appears next. In this portion of the patent, each page is divided into two columns, which are numbered at the top of the page. The written description of the patent begins at column 1, line 1. The written description includes, *inter alia,* a background section, a summary of the invention, and a detailed description of the invention.

By statute, each issued patent concludes with one or more "claims" that particularly point out and distinctly claim the patented invention. 35 U.S.C. s. 112, para.para. 1-2 ("Section 112.") The first paragraph of Section 112 states:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same[.]

Thus, the statutory requirement is that the specification describe the claimed invention in "full, clear, concise and exact terms." The second paragraph of section 112 provides:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Section 112 thus requires a "definiteness" in claims to "ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude." Datamize, LLC. v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed.Cir.2005).

II. The Importance of the Patent Claims

The specification is followed by one or more numbered paragraphs, *i.e.,* the patent claims. The claims may be divided into a number of parts or steps, which are referred to as "claim limitations." The claims of a patent are the main focus of a patent case because the claims define the patent owner's rights under the law. The claims define what the patent owner may exclude others from doing during the term of the patent. The claims of the patent serve two purposes. First, the claims state the boundaries of the invention. Second, they provide notice to the public of those boundaries. Thus, when a product is accused of infringing a patent, the patent claims must be compared to the accused product to determine whether there is infringement. The claims are also at issue in challenges to the patent's validity. Model Jury Instructions: Patent Litigation, 2005 A.B.A. Sec. Litigation 7-9.

There are two basic forms of claims-independent and dependent. Independent claims are free-standing claims. The scope of an independent claim can, therefore, be determined by referring to that claim only and not to any other claims in the patent. Dependent claims, in contrast, incorporate the contents of a preceding claim by reference. 35 U.S.C. s. 112 para. 4; 37 C.F.R. s. 1.75(c) ("One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application .") The scope of a dependent claim cannot be ascertained without referring to the claim on which it depends.

III. Claim Construction

A patent is a written instrument, and, therefore, the court bears the responsibility for all patent interpretation issues. Markman, 517 U.S. at 390. A key issue in interpretation of a patent language is the interpretation of

the words in the claims, *i.e.,* a process called "claim construction." *Id.* Claim construction is a matter of law to be decided exclusively by judges. Analysis of a patent infringement claim contains two steps: "The first step is determining the meaning and scope of the patent claims asserted to be infringed ... The second step is comparing the properly constructed claims to the device accused of infringing." Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

The first step, claim construction, is presently before this Court. As discussed below, there are four principal sources of evidence that the trial court may use in construing claims: (1) the claim language; (2) the patent specification; (3) the prosecution history; and (4) limited extrinsic evidence to assist with understanding the background technology and the state of the art. Claim construction begins with an examination of the intrinsic evidence, i.e., items (1)-(3) above. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996); *see, e.g.,* Graham v. John Deere Co., 383 U.S. 1, 33, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966) ("It is, of course, well settled that an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office ... Claims as allowed must be read and interpreted with reference to rejected ones and to the state of the prior art; and claims that have been narrowed in order to obtain the issuance of a patent by distinguishing the prior art cannot be sustained to cover that which was previously by limitation eliminated from the patent.").

IV. Claim Construction Begins with the Words of the Claims

It is a "bedrock principle" of patent law that "the claims of a patent define the invention to which the patentee is entitled the right to exclude." Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed.Cir.2005). Claim construction centers on the words actually used in the claims. Inno/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1116 (Fed.Cir.2004); *see* Scanner Techs Corp. v. ICOS Vision Sys. Corp. N.V., 365 F.3d 1299, 1303 (Fed.Cir.2004) (claim construction "begins and ends" with the actual words of the claims).

Words in a claim can acquire meaning from various sources, including (1) the ordinary use of the English language, (2) the customary use by a group (*e.g.,* a trade, professional, scientific, or technological group), or (3) the particular use within the patent or its prosecution history. *See* Vitronics Corp., 90 F.3d at 1582 ("[R]egardless of how those skilled in the art would interpret a term in other situations, where those of ordinary skill, on a reading of the patent documents, would conclude that the documents preclude the term being given the meaning propounded by the expert witnesses, we must give it the meaning indicated by the patentee in the patent claim, specification and file history.").

In *Phillips,* the court stated that claim interpretation begins with determining how a person of ordinary skill in the art understands a claim term as of the filing date of the patent application. 415 F.3d at 1313. "Such a person is deemed to read the words used in the patent documents with an understanding of their meaning in the field, and to have knowledge of any special meaning and usage in the field." *Id.* Second, the person "is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Id.*

Words of a claim "are generally given their ordinary and customary meaning." Phillips, 415 F.3d at 1312. "[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Id.;* Home Diagnostics, Inc. v. LifeScan, Inc., 381 F.3d 1352, 1358 (Fed.Cir.2004)

("customary meaning" refers to the "customary meaning in [the] art field"). A judge cannot add or subtract words from the claims. Callicrate v. Wadsworth Mfg., Inc., 427 F.3d 1361, 1369 (Fed.Cir.2005). The objective is to determine the "acquired meaning" of the claim language actually used. Markman, 517 U.S. at 388; Riles v. Shell Exploration, 298 F.3d 1302, 1310 (Fed.Cir.2002).

V. Claims Must Be Read In Light Of The Specification

The specification may resolve ambiguous claim terms "where the ordinary and accustomed meaning of the words used in the claims lack sufficient clarity to permit the scope of the claim to be ascertained from the words alone." Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1325 (Fed.Cir.2002). But, "[a]lthough the specification may aid the court in interpreting the meaning of disputed claim language, particular embodiments and examples appearing in the specification will not generally be read into the claims." Comark Commc'ns, Inc. v. Harris Corp., 156 F.3d 1182, 1187 (Fed.Cir.1998). Patent claims are not limited to the embodiments set forth in the specification. Phillips, 415 F.3d at 1323 ("[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments."). Only the disputed claim language needs to be construed. Vanderlande Industries Nederland BV v. I.T.C., 366 F.3d 1311, 1323 (Fed.Cir.2004) (claim limitation was not in dispute when the ALJ construed the claims, and thus there was no reason for the ALJ to set out a formal construction.)

VI. Patent Prosecution History

The U.S. Patent and Trademark Office ("patent office") is the agency which examines patent applications and issues patents. Patent applications are assigned to a Patent Examiner who determines whether an invention meets the requirements for patentable inventions. If the Patent Examiner rejects the patent, the applicant may respond with arguments to support the claims, by making changes to the claims, or submitting new claims. This process from the filing of the patent application to the issuance of the patent is called "patent prosecution." Model Jury Instructions: Patent Litigation, 2005 A.B.A. Sec. Litigation 10. The record of papers relating to patent prosecution is the "prosecution history." The prosecution history of the patent also provides evidence of how the patent office and the inventor understood the use of certain terms of the patent. Phillips, 415 F.3d at 1317.

VII. Use of Extrinsic Evidence

Extrinsic evidence is any evidence that is not part of the claims, specification or prosecution history of the patent at issue. Extrinsic evidence, such as expert testimony and dictionaries, can be used if needed to assist in determining the meaning or scope of technical terms in the claims. Vitronics Corp., 90 F.3d at 1583. Extrinsic evidence may be considered in claim construction, as long as it is not used to vary or contradict the intrinsic evidence. Pitney Bowes, Inc. V. Hewlett-Packard Co., 182 F.3d 1298, 1308 (Fed.Cir.1999).

VIII. Other Legal Principles Specific to the Patents-in-Suit

Several of the disputed claims (*e.g.,* "saturating" and "pressure adjusting means") are means-plus-function limitations. Construing such a limitation "follows a two-step approach. First, we identify the claimed function, staying true to the claim language and the limitations expressly recited by the claims. Once the functions performed by the claimed means are identified, we must then ascertain the corresponding structures in the written description that perform those functions." Omega Eng'g, Inc. v. Raytek Corp., 334 F.3d 1314, 1321 (Fed.Cir.2003) (internal citations omitted).

The parties dispute whether the Court must construe "device for accumulating electrical energy," which appears in the preamble of claims 1 and 8 of the '924 patent. The preamble must be construed " 'if it recites essential structure or steps, or if it is necessary to give life meaning, and vitality' to the claim.' " Eaton Corp. v. Rockwell Int'l Corp., 323 F.3d 1332, 1339 (Fed.Cir.2003) (quoting Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed.Cir.1999) (other internal quotations omitted). The Federal Circuit has elaborated: "When limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention. On the other hand, '[i]f the body of the claim sets out the complete invention,' then the language of the preamble may be superfluous." *Id*. at 1339 (quoting Schumer v. Lab. Computer Sys., Inc., 308 F.3d 1304, 1310 (Fed.Cir.2002)) (other internal citations omitted).

The inventor of the '330 patent provided a specific definition of the term "hermetically sealed". The Federal Circuit "recognize[s] that the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." Phillips, 415 F.3d at 1316.

The same term must "be interpreted consistently in all claims." Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579 (Fed.Cir.1995).

In describing the connection of a cell balancing circuit across capacitor terminals, the 726 patent incorporated by reference "a detailed description of connection, operation, and use of cell balancing circuits" found in patent application serial number 10/423,708, which issued as Patent Number 6,806,686 ("686 patent"). (*See* 726 patent, at 4:45-49.) The Federal Circuit finds "highly relevant" the incorporation by reference of what other patents teach. AquaTex Indus., Inc. v. Techniche Solutions, 419 F.3d 1374, 1381 (Fed.Cir.2005).

CLAIM CONSTRUCTION

After careful consideration of the parties' arguments and the applicable statutes and case law, the Court **HEREBY ADOPTS** the parties' stipulated claim constructions, wherever such constructions exist, and **CONSTRUES** the disputed claims for the patents-in-suit as follows.

074 patent

"Current collector foil": A thin metal sheet, film, layer or plate for collecting the flow of electric charge.

"Primary coating": A continuous sheet, film, or layer of particles collected on the surface of the current collector foil.

"Portion": A fraction or part of the whole.

"Secondary coating": A continuous sheet, film, or layer of particles collected on the surface of the first coating.

"Saturating": *Function:* Submersing or surrounding the porous separator and first and second electrode structures with a prescribed electrolyte solution; *Structure:* A hole.

924 patent

"Device for accumulating electrical energy" FN2: A capacitor.

FN2. The Court finds that this preamble language must be construed because "it is necessary to give life, meaning, and vitality to the claim." Eaton Corp. v. Rockwell Int'l Corp., 323 F.3d 1332, 1339 (Fed. Cir.2003 (internal quotations omitted).

"Substantially cylindrical": A cylindrical shape including flattened or rounded lateral side faces.

"Substantially cylindrical lateral face" and **"Cylindrical face":** Circumference of any cross-section parallel to the device's end faces that is flattened or rounded in shape.

"Winding of strips" and **"Winding strips":** Pieces of material wrapped around a single object.

"Winding": The process of wrapping pieces of material around a single object.

330 patent

"Terminal": A component that passes current from the electrode to a device in need of energy.

"Hermetic seal": A seal minimizing the influx of impuriteis entering the capacitor case to less than 0.00005 g/m ^{2}/day at 73 (deg.) F, and less than 0.00009 g/m ^{2}/day at 110 (deg.) F.

"Current collector foil": A thin metal sheet, film, layer or plate for collecting the flow of electric charge.

"Juxtaposed against": Placed side by side and in contact with.

"Saturating": Submersing or surrounding.

"Substantially contained": Largely but not necessarily entirely held within.

"Substantially inhibited": Largely but not necessarily entirely restrained.

"Selected solvent": Any solvent suitable for use in a double layer capacitor.

"Selected salt": Any salt suitable for use in a double layer capacitor.

"Against": In contact with.

In light of the parties' agreed proposed constructions and the Court's constructions *supra,* the Court declines to construe separately the terms "hermetically sealed case" or "substantially inhibited by the hermetically sealed case".

726 patent

"Terminal": A component that passes current from the electrode to a device in need of energy.

"Through which a high current may flow safely" and **"That passes the high current":** Capable of passing currents at the high end of the amount of amperage the electrode is able to deliver.

"Bus bar": A metal conductor used to make an electrical connection between electrical components.

"Integral structure": One or more bus bars electrically connected to one or more capacitors forming an interconnected whole.

"Self-supporting structure": A configuration where the bus bars and capacitors provide the necessary support to hold the system together.

"Capacitor balancing circuits": Circuits used to bring the voltage of each capacitor in a system to the same equilibrium voltage.

"Welds" and **"Welded":** the fusion of metal in the capacitor terminals to the bus bars.

"Laser welds": Welds formed by a laser.

"Integrally interconnected self-supporting structure": A configuration of bus bars and capacitors that are electrically connected and form an interconnected whole that provides the necessary support to hold the system together.

544 patent

"Terminal": A component that passes current from the electrode to a device in need of energy.

"Pressure adjusting means": *Function:* Absorbing pressure changes in order to maintain a predetermined constant pressure between the electrode body and the anode and cathode terminals; *Structure:* An elastic rubber packing and equivalents thereof.

"Predetermined constant pressure": A stable pressure between the terminals and electrode body, which is the pressure when the terminals and electrode body are in their original condition.

"Metal layer": A thickness of metal that is not derived from the surface material of the electrode protrusions or terminals.

IT IS SO ORDERED.

S.D.Cal.,2008.
Nesscap Co., Ltd. v. Maxwell Technologies, Inc.

Produced by Sans Paper, LLC.