United States District Court,
W.D. Texas.

HARBISON-FISCHER, INC., et. al,
Plaintiffs.
v.
JWD INTERNATIONAL, et. al,
Defendants.

No. MO-07-CA-58-H

Dec. 19, 2008.

Daniel L. Bates, Geoffrey A. Mantooth, Decker, Jones, McMackin, McClane, Hall & Bates, Fort Worth, TX, for Plaintiffs.

B. Calvin Hendrick, VII, Shafer, Davis, O'Leary and Stoker, Odessa, TX, Cason P. Carter, Frank J. Catalano, Gablegotwals, John Henry Rule, Attorney at Law, Tulsa, OK, for Defendants.

ORDER REGARDING CLAIM CONSTRUCTION

HARRY LEE HUDSPETH**, Senior District Judge.**

This is a civil action alleging patent infringement under 35 U.S.C. s. 100 et seq., 35 U.S.C. s.s. 271 and 281. Plaintiff Harbison-Fischer, Inc. FN1 asserts that the Defendants infringe United States Patent No. 4,963,078 (the "'078 Patent"). The Court is responsible for construing the claim at the center of the dispute.

I. The Technology

The patent-in-suit concerns a down-hole oil field tool. A down-hole pump is used to pump liquids to the surface in an oil and gas well. The patent-in-suit is directed to a stress and torque reducing tool (STR Tool) that uses a fluid cushion between the sucker rods and the traveling valve of the pump to unseat the valve and permit gas to escape. This has the advantage of avoiding gas lock, a condition where gas enters below the plunger of a conventional pump and the plunger cannot compress the gas sufficiently to force the traveling valve open. The invention also intends to reduce the jarring force on the sucker rods caused by another condition called gas pound, where the plunger compresses the gas on the downstroke in a conventional pump with insufficient force to open the traveling valve but with more pressure than the rod weight.

II. Applicable Law

Claim construction is a matter of law. Markman v. Westview Instruments, Inc., 517 U.S. 370, 391, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). "It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the rights to exclude.' " Phillips v. AWH Corp., 415 F.3d 1303,

1312 (Fed.Cir.2005) (en banc) (quoting Innova/Pure Water Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1115 (Fed.Cir.2004)).

The words of a claim are given their ordinary and customary meaning, which 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," as measured by the effective filing date of the application. Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed.Cir.2005) (en banc) (citations omitted). The person of ordinary skill in the art is deemed to read the claim term in the context of the claim in which it appears and in the context of the entire patent, including the specification. ***Id.*** But it is improper to read limitations from the written description into a claim. *See* Tate Access Floors, Inc. v. Maxcess Techs., Inc., 222 F.3d 958, 966 (citing Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 1362 (Fed.Cir.2000)). Elements of a preferred embodiment should not ordinarily be read into claim language that is broader than such embodiments. Id. at 966-67.

In claim construction, courts first examine the intrinsic evidence, which includes the claims, the specification, and the prosecution history, if in evidence. *See* Tate Access Floors, 222 F.3d at 965 (citing Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996)). The specification "is always relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." Phillips, 415 F.3d at 1315 (quoting Innova/Pure Water, 90 F.3d at 1582).

The prosecution history is less useful than the specification and claims because it represents the ongoing negotiation between the PTO and the patentee. Phillips, 415 F.3d at 1317. The prosecution history, however, is helpful when it demonstrates how the inventor understood the invention or shows that the inventor limited the invention in the course of prosecution. ***Id.***

Although the use of extrinsic evidence is not forbidden, it is generally less significant than the intrinsic record. Nazomi Communs., Inc. v. Arm Holdings, PLC, 266 Fed. Appx. 935, 939 (Fed.Cir.2008) (citation omitted).

III. Construction of Claim Term

The parties have stipulated to the construction of many terms. Since there is no controversy regarding those terms, the Court will not address them here. What follows is the Court's construction of the sole term that remains in dispute.

DISPUTED TERM: means for limiting relative rotational movement between the plunger means and the hollow body means ('078 Patent, **claim 1)**

The parties agree that this term is a means-plus-function term governed by 35 U.S.C. s. 112, para. 6. Under Federal Circuit precedent, a claim limitation that uses the language "means ... for" invokes a rebuttable presumption that 35 U.S.C. s. 112, 16 applies. *See* Gemstar-TV Guide Int'l, Inc. v. ITC, 383 F.3d 1352, 1361 (Fed.Cir.2004). Means-plus-function terms are those "purely functional limitations that do not provide the structure that performs the recited function." Phillips, 415 F.3d at 1311. The disputed term does not provide sufficient structure to perform the recited function, so it is a means-plus-function term. To construe a means-plus-function term, the Court should first identify the recited function within the claim limitation and then examine the written description to determine the corresponding structure that performs that function. Gemstar, 383 F.3d at 1361.

The Plaintiff proposes the following construction: functionally, the plunger is limited in rotation within the

cylinder. This is accomplished by structure of a non-round plunger shank and a shank opening that conforms to the geometrical shape of the shank. The Defendants propose the following construction: Functionally, the plunger is always prevented from rotating within the cylinder. This is accomplished by a shank portion, which may be any shape other than round, and a shank opening in the lower end of the body, which conforms to the geometrical shape of the shank portion, thereby preventing rotation of the plunger.

The first dispute is over the recited function. The Federal Circuit directs a Court to look to the claim language to determine the function of the claim limitation. *See* Gemstar, 383 F.3d at 1361. In fact, the Federal Circuit has said that it is improper to adopt any function different from that explicitly recited in the claims. Creo Prods., Inc. v. Presstek, Inc., 305 F.3d 1337, 1344-45 (Fed.Cir.2002). The recited function is "limiting relative rotational movement between the plunger means and the hollow body means."

The proposed definitions add limitations beyond the claim language by defining the function as limiting or preventing rotation of the plunger within the cylinder rather than between the plunger and the cylinder. The recited function in the claim language limits only relative rotational movement between the plunger and the hollow body means (the cylinder, as agreed by the parties).

The recited function proposed by the Defendants compounds the error of adding additional claim limitations by requiring the complete prevention of rotation by the plunger in the cylinder. In effect, the Defendants ask the Court to redraft the recited function to require a prevention of rotation that is not found in the claim. The Defendants argue that the Court should not construe the recited function as limiting because that would render the recited function unsupported by the corresponding structure in the claims. Instead of arguing that the lack of a structure that limits, rather than prevents, rotation makes the claim invalid, the Defendants ask the Court to change the recited function to require prevention of rotation. The Federal Circuit "has repeatedly held that courts may not redraft claims to cure a drafting error made by the patentee, whether to make them operable or to sustain their validity." *See* Lucent Techs., Inc. v. Gateway, Inc., 525 F.3d 1200, 1215 (Fed.Cir.2008) (citing Chef Am., Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1373 (Fed.Cir.2004) (additional citations omitted)). It is improper then, for this Court to ignore the explicit claim language that requires "limiting" the rotation and replace it with "preventing" rotation because of the Defendants' arguments about validity.

Further, the specification does not support the Defendants' argument that the rotation is always prevented. The Defendants point only to the following phrase in Col. 4: 29-34 to support their argument that the shank portion must prevent all rotation: "The plunger includes shank point 27 which may be in any shape or form preferable other than round and is illustrated as square which thereby prevents the plunger from rotating and facilitating manual back-off of the sucker rods whenever necessary." The use of "which thereby prevents the plunger" indicates that the clause "thereby prevents the plunger from rotating ..." is referring to the square, just as "which may be in any shape ..." is referring to "shank point 27." The square shape of the preferred embodiment prevents the plunger from rotating, but the very same sentence points out that any shape except round can be used.

The Defendants also argue that the only embodiment shown is a square shank portion, so the recited function must be limited to preventing rotation because a square shape prevents rotation. It is true that the preferred embodiment appears to be a square shank as shown in Figs. 2 and 3 and in Col. 4:29-34. However the cited passage also makes clear that the invention contemplates other non-round shapes, which are not explicitly said to limit the rotation like a square shape. It is improper to read limitations from the written description into a claim. *See* Tate Access, 222 F.3d at 966 (citing Kemco Sales, 208 F.3d at 1362). Elements

of a preferred embodiment should not ordinarily be read into claim language that is broader than such embodiments. Id. at 966-67. In the present patent, the disclosure is explicitly broader than the preferred embodiment, so it would be improper to read in a narrower limitation that is not even found in the specification. It would be especially wrong to change the recited function to limit it to a preferred embodiment.

The Defendants also cite to the prosecution history in support of their argument that the shank must prevent all rotation. The portion cited, however, is nearly the same as the language from the specification that the Court has already discussed. The patentee was responding to the Examiner's citation of a prior art reference that the Examiner said showed a shank with a non-circular aperture that rendered the invention obvious. The patentee responded that the reference cited had a different function-to attach the piston assembly in the main pump cylinder to the piston. The patentee distinguished that the reference

in no way serves the purpose as described by Applicant in the second paragraph on page 8 of the specification that the plunger includes a shank portion which may be in any shape or form preferably other than round and is illustrated as square which thereby *prevents* the plunger from *rotating* and facilitating manual back-off of the sucker rods whenever necessary. The purpose of preventing relative rotation between the plunger and the hollow body can be achieved by use of other means including dogs if desired. Dobbs 00061 (emphasis in original).

In this passage the inventor was distinguishing attaching components from preventing rotation of components. He was not distinguishing whether the rotation was completely prevented or merely limited as the Defendants intend with this passage. The language cited supports only that the inventor intended to prevent rotation, not all rotation, as opposed to attaching components together. Taken together, the Defendant has not overcome the function explicitly recited in the claim.

Turning to the corresponding structure, the parties largely agree that the corresponding structure is the shank portion and shank opening. The disputes are merely repetitive of those decided above concerning whether the rotation must be completely prevented or merely limited and whether that dispute must be repeated in the corresponding structure. Both parties point to the language in col. 4:29-38 as sufficiently pointing out the structure corresponding to the recited function. To the definition proposed by the Plaintiff, the Defendants add that the shank opening is located in the lower end of the body and that the structure prevents rotation of the plunger. It is valid to specify that the shank opening must be in the lower portion of the body, since this is part of the corresponding structure in col. 4:29-38 that is necessary to perform the recited function. This language should be included in the structure. It is not valid, however, to include functional language regarding rotation and to repeat the debate settled above regarding whether the function requires limitation or complete prevention of rotation. That language is excluded from the structure.

CONSTRUCTION: **The recited function is limiting relative rotational movement between the plunger means and the hollow body means. The corresponding structure is a shank portion 27 of the plunger that is any shape except round and a shank opening (bushing 29), in the lower end of body 23, that conforms to the geometrical shape of the shank portion.**

IV. CONCLUSION

The Court having now discharged its responsibility with respect to claim construction, a separate Order will be entered governing further proceedings in this case. In keeping with a previous Order, the parties will

have sixty (60) days within which to conduct any additional discovery.

SIGNED AND ENTERED this *17th* day of December 2008.

FN1. Harbison-Fischer, Inc. appears to be the licensee of the patent-in-suit. Although the apparent licensor, STR Tool, Inc., was added as a Plaintiff in the lawsuit, Harbison-Fischer, Inc. is the only Plaintiff that has taken a position on the claim construction. Likewise, briefing from the Defendants has largely come from Jerry W. Dobbs, with some filings representing Jerry W. Dobbs Int'l Marketing, but no claim construction briefing claiming to come from JWD International.

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