United States District Court,
S.D. Iowa, Central Division.

Steven W. SABASTA and Sioux Falls Insulation Supply, Inc., a South Dakota corporation, d/b/a Sioux City Insulation & Supply, Inc,
Plaintiffs.
v.
BUCKAROOS, INC,
Defendant.

No. 4:06-cv-180

Feb. 13, 2009.

Debra Lynne Hulett, Nyemaster Goode West Hansell & O'Brien PC, Des Moines, IA, Sander J. Morehead, Tim R. Shattuck, Woods Fuller Shultz & Smith PC, Sioux Falls, SD, for Plaintiffs.

Charles Johnson Meyer, Woodard Emhardt Moriarty McNett & Henry LLP, Indianapolis, IN, James S. Zmuda, Califf & Harper, Moline, IL, for Defendant.

ORDER

ROBERT W. PRATT**, Chief Judge.**

I. BACKGROUND

Plaintiffs, Steven W. Sabasta and Sioux Falls Insulation Supply, Inc. ("Plaintiffs" or "Sabasta"), filed the present action for patent infringement on April 17, 2006. Clerk's No. 1. Plaintiffs' Complaint alleges that Sabasta is the original inventor of a roll-bending die used to make saddles for pipe insulation. Compl. para. 2. Sabasta was granted United States Patent No. 6,751,995 ("the '995 Patent") on June 22, 2004. According to the Complaint, Defendant, Buckaroos, Inc. ("Buckaroos"), has commercially exploited Sabasta's invention since March 2005 by using roll-bending dies that infringe upon the ' 995 Patent in manufacturing certain pipe insulation saddles. FN1

FN1. Pipe saddles are essentially bent or curved pieces of metal designed to support hanging pipes, with or without insulation. The metal saddle shape is commonly produced using a "roll-bending" process, whereby a blank piece of metal is run through a machine that forms the metal into an arcuate shape. Pipe saddles often have flared ends, and some pipe saddles have radial "ribs" in them, intended to strengthen the saddle and inhibit the hanger from sliding.

On July 18, 2008, this Court denied both parties' motions for summary judgment with respect to Buckaroos' claim that the '995 Patent is invalid, but granted Plaintiffs' request for summary judgment on the question of

whether Buckaroos could assert the First Inventor defense, pursuant to 35 U.S.C. s. 273. Clerk's No. 97. Since that time, the parties have engaged in continuing discovery. Additionally, both parties have filed briefs and reply briefs regarding claim construction in the case. It is the issue of claim construction that is now before the Court. FN2

FN2. While a *Markman* hearing was set on the issue of claim construction, the parties jointly moved on September 3, 2008 to cancel the hearing and to submit the issue on the briefs. Clerk's No. 102. The motion to cancel the hearing was granted on September 9, 2008. Clerk's No. 103.

II. LAW

Patent infringement analysis consists of a two-step process. *See* Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448, 1454 (Fed.Cir.1998). "The first step is claim construction, which involves ascertaining the scope and meaning of the claims at issue, while the second step involves determining whether the claims as construed read on the accused device." Streamfeeder, LLC v. Sure-Feed Sys. Inc., 175 F.3d 974, 981 (Fed.Cir.1999). The first step, interpreting and constructing the patent law claims, is a question of law to be resolved by the Court. Markman v. Westview Instruments, Inc., 52 F.3d, 967, 970-71 (Fed.Cir.1995), *aff'd,* 517 U.S. 370 (1996). "In 'claim construction' the words of the claims are construed independent of the accused product ... [and] it is efficient to focus on the construction of only the disputed elements or limitations of the claims ... [as] a way of elaborating the normally terse claim language: in order to understand and explain, but not to change, the scope of the claims." Scripps Clinic & Research Found. v. Genentech, Inc., 927 F.2d 1565, 1580 (Fed.Cir.1991).

In attempting to construe the claims of a patent, the Court must first examine the language of the claim itself, the patent specification, and the prosecution history. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996); Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1216 (Fed.Cir.1995). The words of a claim "are generally given their ordinary and customary meaning," specifically, "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." Phillips v. AWH Corp., 415 F.3d 1303, 1313 (Fed.Cir.2005) (citing Vitronics, 90 F.3d at 1582; Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc., 381 F.3d 1111, 1116 (Fed.Cir.2004)).

In cases where the intrinsic evidence alone resolves any ambiguities in the claim language, a court should not rely on extrinsic evidence to alter or change the meaning of that language. *Id*. at 1583. Indeed, while a court may rely on expert testimony and other extrinsic evidence to help it understand the underlying technology, extrinsic evidence about the proper construction of a claim term "may only be relied upon if the patent documents, taken as a whole, are insufficient to enable the court to construe disputed claim terms. Such instances will rarely, if ever, occur." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1308-09 (Fed.Cir.1999) (reiterating that courts should not "rely on extrinsic evidence in claim construction to contradict the meaning of claims discernible from thoughtful examination of the claims, the written descriptions, and the prosecution history-the intrinsic evidence," but noting that courts may consider extrinsic evidence to ensure that any interpretation of claim language is not in contravention to "clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field") (citing Vitronics, 90 F.3d at 1585).

III. ANALYSIS

The parties have resolved all matters of claim construction, save for one. Claim 23 of the '995 Patent

specifies in pertinent part:

A roll bending die for being used with a roll bending machine for producing rib reinforced rolled material, the roll bending die comprising ... a pair of clamp members selectively engaging an end face of each of said opposing ends of said body member, each of said clamp members being adapted for engaging the roll tube of the roll bending machine such that said clamp members are for securing said body member to the roll tube of the roll bending machine.

'995 Patent.

Plaintiffs request that the Court construe this portion of Claim 23 as follows:

Claim Term	Plaintiffs' Proposed Construction
"[a] pair of clamp members"	"two clamps"
"selectively engaging an end face of each of the opposing ends of said body member"	"able to engage an end face of each of the opposing ends of said body member"
"each of said clamp members being adapted for engaging the roll tube of the roll bending machine"	"the clamps are designed to be able to engage the roll tube of the roll bending machine"
"such that said clamp members are for securing said body member to the roll tube of the roll bending machine"	"the clamps are for securing the body member to the roll tube of the roll bending machine"

Defendant, on the other hand, requests that the Court construe Claim 23 in the following manner:

Claim Term	Defendant's Proposed Construction
"[a] pair of clamp members"	"two clamps"
"selectively engaging an end face of each of the opposing ends of said body member"	"the clamps can be secured and removed to interlock with the end faces of the body member"
"each of said clamp members being adapted for engaging the roll tube of the roll bending machine"	"each clamp can be interlocked to the roll tube of the roll bending machine"
"such that said clamp members are for securing said body member to the roll tube of the roll bending machine"	"each clamp member functions to rigidly hold the body member both radially and laterally with respect to the roll tube"

1. ***Claim language.***

In any claim construction analysis, "[t]he appropriate starting point ... is always with the language of the asserted claim itself." Phonometrics, Inc. v. Northern Telecom Inc., 133 F.3d 1459, 1464 (Fed.Cir.1998) (citation omitted).

As the Supreme Court stated in White v. Dunbar, 199 U.S. 47, 52, 30 L.Ed. 303, 7 S.Ct. 72 (1886): "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an invasion of the law to construe it in a manner different from the plain import of its terms."

Kimberly-Clark Corp. v. Johnson & Johnson, 745 F.2d 1437, 1458 (Fed.Cir.1984). The words used in a patent claim are examined from the perspective of a person of ordinary skill in the art. Tegal Corp. v. Tokyo

Electron America, Inc., 257 F.3d 1331, 1342 (Fed.Cir.2001).

The parties are in agreement that the first clause of the claim, "[a] pair of clamp members," references "two clamps." As to the second clause of the claim, "selectively engaging an end face of each of the opposing ends of said body member," the parties' interpretations diverge significantly.

In determining the ordinary and customary meaning of the phrase "selectively engaging," the parties have both referenced dictionary definitions for the individual terms. Dictionaries, while technically extrinsic evidence, are permissible sources of information for use during claim construction. *See* Vanguard Prods. Corp. v. Parker Hannifin Corp., 234 F.3d 1370, 1372 (Fed.Cir.2000) ("A dictionary is not prohibited extrinsic evidence, and is an available resource of claim construction"). Indeed, the Federal Circuit has stressed that dictionaries "are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms." Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed.Cir.2002); *see also* Vitronics Corp., 90 F.3d at 1584 n. 6 ("Judges are free to consult [dictionaries] at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.").

Having read the dictionary definitions proffered by the parties, the Court finds little, if any, support for Buckaroos' proposed reading of the term "selectively" within the context of the phrase "selectively engagable." Buckaroos cites Webster's Ninth New Collegiate Dictionary ("Webster's") for its assertion that "the term 'selectively' means that the clamp members are removable at the choice of the operator, as opposed to permanently attached." Pl.'s Br. at 23. While Webster's does not directly define the term "selectively," it does define related terms:

select ... to take by preference from a number or group: pick out: CHOOSE ... to make a choice ...

selection ... 1: the act or process of selecting: the state of being selected 2: one that is selected: CHOICE; ...

selective ... 1: of, relating to, or characterized by selection: selecting or tending to select ... **selectively**

Buckaroos' App. at 11-3. The word "removable" neither appears in nor can be fairly inferred from the Webster's definitions. Indeed, the Webster's definition more fairly accords with Plaintiffs' contention that the term "selectively," merely implies "that the user of the invention may, or may not, choose to 'engage' the clamps with the dies, as demonstrated by the definition of 'selection' " in Merriam-Webster's Collegiate Dictionary, which defines "selection" as meaning "one that is selected: choice." FN3 Pls.' Reply at 7 (quoting Merriam-Webster's Collegiate Dictionary (10th ed.2002). Likewise, Oxford English Dictionary defines the term "selectively" as "[i]n a selective manner; by selection," and further defines the term "selection" as "[a] particular choice; choice of a particular individual or individuals." Oxford English Dictionary (2d ed.1989).

FN3. Buckaroos counters that "the proposition that a user 'may or may not' engage the clamps at the user's choice logically means that the clamps are removable at the user's choice." The Court disagrees and fails to see how imposing a requirement that the clamps be removable "logically" follows from the use of the term "selectively."

Buckaroos argues that reading the term "selectively" as Plaintiffs propose ignores the context of the term and the fact that it is used in conjunction with the term "engaging." Buckaroos argues that the term "engaging" should be interpreted with reference to Webster's definition of the root term "engage": "to come together and interlock (as of machinery parts)." *Id*. Webster's also, however, defines "engage" as "to cause (mechanical parts) to mesh," and "to bring together or interlock (weapons)." In the context of "engaging and disengaging machinery," Oxford English Dictionary defines "engaging" as: "that in which one part is alternately united to, or separated from another part, as occasion may require." Oxford English Dictionary (2d ed.2002).

Even reading "selectively" and "engaging" together, as recited in Claim 23, Buckaroos' request for a construction that employs a requirement that the clamps be removable reads a limitation into the claim that is unsupported by any intrinsic evidence in the case. This is not to say, however, that Plaintiff's proposed construction, "able to engage an end face," is wholly adequate. In fact, after careful consideration of the parties' arguments and the language of the Claim itself, the Court finds that adopting Plaintiff's construction would fail to adequately give meaning to the word "selectively." Accordingly, after careful consideration of all the evidence in the case, the Court concludes that the term "selectively" requires that the clamps be able to engage the end face, "at the operator's discretion." This construction gives due weight to the "choice" aspect of the term, rather than rendering it superfluous. As to whether the claim should be read to require a construction that "engaging" be synonymous with "interlock," the question is a closer one. The "engaging" requirement of the second disputed clause is also relevant to the third disputed clause of Claim 23, that "each of said clamp members being adapted for engaging the roll tube of the roll bending machine." Accordingly, the Court looks to other intrinsic evidence in the case, namely the patent specification, to aid in determining the construction of the second and third clauses, as well as to evaluate the fourth clause of Claim 23, for which Buckaroos requests that the Court impose additional limitations on the Claim language.FN4

FN4. While the prosecution history is often a useful source of intrinsic evidence, it provides no guidance in the present case. In regards to Claim 23, the Examiner merely stated that "New claim [23] has been added to vary the scope of the claims and clarify the present invention. All limitations are supported by the original disclosure including the specification, drawings and original claims.... Therefore, no new matter has been added. The new claim is believed to be allowable." Clerk's No. 99-4 at 34.

2. *The specification.*

"The importance of the specification in claim construction derives from its statutory role." Phillips, 415 F.3d at 1316. The patent statutes requires that a 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...." 35 U.S.C. s. 112; *see* Lizardtech, Inc. v. Earth Resource Mapping, Inc., 433 F.3d 1373, 1374 (Fed.Cir.2006) (per curiam) (stating that the specification statute contains two separate requirements, a written description and an enablement requirement); Capon v. Eshhar, 418 F.3d 1349, 1360 (Fed.Cir.2005) ([A]lthough the legal criteria of enablement and written description are related and are often met by the same disclosure, they serve discrete legal requirements."). "In light of the statutory directive ... the specification necessarily informs the proper construction of the claims." Phillips, 415 F.3d at 1316 (citing Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1250 (Fed.Cir.1998) ("Ultimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually

invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.")). Accordingly, where a patentee reveals in the specification a "special definition given to a claim term ... that differs from the meaning it would otherwise possess ... the inventor's lexicography governs." *Id*. (citing CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed.Cir.2002)). Likewise, if the specification reveals "an intentional disclaimer, or disavowal, of claim scope by the inventor ... the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive." *Id*. (citing SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337, 1343-44 (Fed.Cir.2001)). If neither a unique lexicography nor a disavowal of claim scope appear in the specification, the "ordinary meaning, to one skilled in the art, of the claim language controls." Digital Biometrics, Inc. v. Identix, Inc., 149 F.3d 1335, 1344 (Fed.Cir.1998).

Buckaroos contends that its interpretation that Claim 23 requires "interlocking" is supported by the specification in this case. Specifically, Buckaroos points to the "Description of the Preferred Embodiment," which provides:

A pair of clamp members 22 FN5 selectively engage an end face 23 of each of the opposing ends 15 of the body member 11. Each of the clamp members 22 is designed for engaging the roll tube 56 of the roll bending machine 50 whereby the clamp members 22 are for securing the body member 11 to the roll tube 56 of the roll bending machine 50.

FN5. The numbers interspersed throughout the Description of the Preferred Embodiment reference the drawings including in the '995 Patent.

Each of the clamp members 22 comprises a pair of clamp portions 24. One of the clamp portions 24 is selectively coupled to the other of the clamp portions 24 whereby each of the clamp portions 24 is designed for being positioned around the roll tube 56 of the roll bending machine 50 when the clamp portions 24 are coupled to together [sic]. Each of the clamp portions 24 comprises an arcuate interior face 25 20 whereby the arcuate interior face 25 20 of each of the clamp portions 24 is designed for frictionally engaging the roll tube 56 for inhibiting rotation of the clamp portions 24 with respect to the roll tube 56 when the clamp portions 24 are coupled together around the roll tube 56....
Each of the clamp members 22 comprises a lip portion 29. The lip portion 29 outwardly extends from an engagement face 30 the associated one the clamp members 22. The lip portion 29 of each of the clamp members 22 selectively extends into one of the alignment grooves 28 of the body member 11 when the engagement face 30 of each of the clamp member 22 abuts against the end face 23 of the association one of the opposing ends 15 of the body member 11 for maintaining alignment of the body member 11 with respect to the roll tube 56.

'995 Patent, col. 4, lines 10-53.FN6 A plain reading of the specification as articulated in the preferred embodiment indicates that the clamp members are designed to have a protuberance that will extend into prefabricated alignment grooves on the body member, that is, the lip of the clamp member is designed to engage the body member in order to keep the body member in proper alignment with the roll tube. The engagement between the lip and the body member, as described in the embodiment, clearly implies something more than "some contact between the clamps and the dies," as suggested in Plaintiffs' Reply. Pls.' Reply at 6.
FN6. The language from the preferred embodiment is essentially duplicated in Claims 11-13 of the '995

Patent. Claims 11-13, however, are dependent claims of Claim 1. The doctrine of claim differentiation "create[s] a presumption that each claim in a patent has a different scope." Comark Comm., Inc. v. Harris Corp ., 156 F.3d 1182, 1187 (Fed.Cir.1998). The doctrine would not support reading a limitation from Claims 11-13 into Claim 23, because "when a patent claim 'does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim....' " Amgen Inc. v. Hoechst Marion Roussel, Inc ., 314 F.3d 1313, 1326 (Fed.Cir.2003) (quoting SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1122 (Fed.Cir.1985)). Furthermore, the Court notes that Buckaroos has referenced only the description in the "Preferred Embodiment," and has not referenced Claims 11-13 in support of its proposed claim construction.

Plaintiffs contend that because the specification only teaches a preferred embodiment, it does not act to limit the claims. Pls.' Reply at 100. Plaintiffs cite Rexnord Corp. v. Laitram Corp., 274 F.3d 1336 (Fed.Cir.2001) in support of this proposition. In *Rexnord,* the Federal Circuit stated: "Our case law is clear that an applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention." 274 F.3d at 1344. The Court agrees that as a general rule, the Federal Circuit has found it improper to import limitations from an embodiment, even a preferred embodiment, into a claim. 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.... In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment.") *Id*. (citations omitted); Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1327 (Fed.Cir.2002) ("We hold that claim terms take on their ordinary and accustomed meanings unless the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.").
In the present case, the Court can find no words of manifest exclusion or restriction in the language Buckaroos quotes from the Preferred Embodiment portion of the patent. The applicability of the Federal Circuit's general rule on importing limitations from the specification, however, is made somewhat more difficult by the fact that the only descriptions sufficient to satisfy the enablement requirement of the specification statute appears in the "Description of the Preferred Embodiment." FN7 *See* 35 U.S.C. s. 112 (stating that a patent "shall" contain a description of the invention and how to make it sufficient "to enable any person skilled in the art ... to make and use the same"). The Court's concern in this regard is highlighted by a statement the Federal Circuit made in *Lizardtech:* "Claims are not necessarily limited to preferred embodiments, but, if there are no other embodiments, and no other disclosure, then they may be so limited. One does not receive entitlement to a period of exclusivity for what one has not disclosed to the public ... merely calling an embodiment 'preferred,' when there are no others, does not entitle one to claims broader than the disclosure." Lizardtech, 433 F.3d at 1375. The quoted *Lizardtech* decision was a per curiam denial of a petition for rehearing en banc. In the underlying case, however, the three judge panel actually construed the disputed claim as *not* being limited by the specification. While on the one hand, this may give rise to a conclusion that the *Lizardtech* quotation is dicta; on the other, it may be consistent with the Federal Circuit's statement that when a preferred embodiment is the *only* written description sufficient to enable the patent, that a court " *may,*" but is not required to, limit the claims of the patent to the written description in the preferred embodiment, despite the general rule to the contrary.

FN7. The '995 Patent specification contains a brief "Background of the Invention," a broad and nonspecific "Summary of the Invention," and a "Brief Description of the Drawings." '995 Patent, cols. 1-2. Other than

these items, the '995 Patent comprises nothing more than the drawings, the "Description of the Preferred Embodiment," and the Claims themselves.

In this case, the Court finds it appropriate to abide by the typical rule of the Federal Circuit that claims should not be limited by embodiments. While certainly Plaintiffs' stated embodiment foresees a lip portion of the clamps that "interlock" with precut grooves in the body member, this is not the only reasonably conceivable method of "engaging" the body member. Indeed, the Court finds that the term "engaging" has a readily apparent meaning that requires more than mere touching, though not necessarily interlocking. *See* Oxford English Dictionary (2d ed.2002) (defining "engaging" as encompassing mechanical situations where "one part is alternately united to, or separated from another part, as occasion may require"). Where, as here, Plaintiffs have not disclaimed or intentionally disavowed the use of clamps that do not interlock, per se, the Court declines to read such a limitation into the patent claim. Given the Court's determination that the term "engaging" does not necessarily require interlocking and that the term "selectively" cannot be read to require that the clamps be removable, the Court adopts Plaintiffs' proposed construction, with one modification, of the second and third phrases of the disputed portion of Claim 23.

With regard to the fourth phrase of the disputed portion of Claim 23, "such that said clamp members are for securing said body member to the roll tube of the roll bending machine," the Court also declines to import Buckaroos' requested limitations into the Claim language. Specifically, Buckaroos' request to read the Claim as requiring that "each clamp member functions to rigidly hold the body member both radially and laterally with respect to the roll tube" is simply not supported by the ordinary meaning of the claim terms or by any other limitation apparent from the intrinsic evidence in the case. Indeed, the Claim language itself is clear and the Court does not believe it requires further construction.

IV. CONCLUSION

For the reasons stated herein, the final paragraph of Claim 23 shall be read as follows: "two clamps, which are able, at the operator's discretion, to engage an end face of each of the opposing ends of said body member, each of the clamps is designed to engage the roll tube of the roll bending machine, such that the clamp members function to secure the body member to the roll tube of the roll bending machine."

IT IS SO ORDERED.

S.D.Iowa,2009.
Sabasta v. Buckaroos, Inc.

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