

United States District Court,
M.D. Pennsylvania.

DODGE-REGUPOL, INCORPORATED,
Plaintiff.

v.

RB RUBBER PRODUCTS, INC,
Defendant.

No. 3:06-cv-236

March 9, 2007.

Adam S. Barrist, Frey Petrakis Deeb Blum & Briggs, P.C., Philadelphia, PA, George C. Werner, Jr., Barley, Snyder, Senft & Cohen, LLC, Lancaster, PA, Jean-Paul Lavalleye, Robert C. Nissen, Willaim T. Enos, Oblon Spivak McClelland Maier & Neustadt, Alexandria, VA, Salvatore Anastasi, Barley Snyser, Berwyn, PA, for Plaintiff.

Adam S. Barrist, Frey Petrakis Deeb Blum & Briggs, P.C., Philadelphia, PA, Kara R. Yancey, Matthew L. Cutler, Rudolph A. Telscher, Jr., Harness, Dickey & Pierce, P.L.C., Clayton, MO, for Defendant.

MEMORANDUM AND ORDER

JOHN E. JONES III, District Judge.

THE BACKGROUND OF THIS ORDER IS AS FOLLOWS:

Pending before the Court are disputed claim terms from U.S. Patent No. 6,920,723 ("the '723 patent"). The main issue before the Court is the interpretation of the phrase "thickness of about 10 millimeters" as it applies to the rubber substrate that is the subject of the '723 patent.

PROCEDURAL HISTORY:

Plaintiff, Dodge-Regupol Incorporated ("Dodge") filed the instant patent infringement action against Defendant RB Rubber Products ("RB Rubber") on January 31, 2006. (Rec.Doc.1). On March 3, 2006, RB Rubber filed an answer with counterclaims. FN1 (Rec.Doc.4). On November 10, 2006, RB Rubber filed a Motion for Claim Consideration (doc. 25) and a corresponding *Markman* hearing was held on December 22, 2006. Following the hearing, the parties submitted additional briefs supporting their contrary positions. Presently, the matter has been fully briefed by the parties and is therefore ripe for our review.

FN1. Pending before the Court is RB Rubber's Motion to File Amended Answer and Counterclaims (doc. 44) filed on January 19, 2007. We shall grant the Motion and order the Clerk to file the Amended Answer and Counterclaims.

FACTUAL BACKGROUND:

The technology that is the subject of this patent infringement lawsuit relates to acoustical underlayment designed to reduce room-to-room and in-room ambient noise. Dodge is the owner of the '723 patent, which was issued on July 26, 2005, and entitled "Impact Sound Insulation." The '723 patent claims a substrate for use in a flooring system which is composed of a subfloor and a decorative top layer.

Prosecution History of the '723 Patent

Dodge filed the '723 patent application on August 16, 2001 ("Application"). As filed, the Application contained 24 claims. The premise of the invention is described in the '723 patent as:

The invention is directed to sound insulating material for use in flooring. In particular, a sound insulating material which exhibits the strength characteristics required to properly support the decorative top layer of the flooring.

(Rec. Doc. 26, Ex. A, the '723 patent, Column 1).

Claim 1 of the Application is representative:

1. A flooring system comprising

a subfloor;

a decorative top layer;

a substrate having a top surface and an oppositely facing bottom surface, the bottom surface positioned proximate the subfloor and the top surface is positioned proximate the decorative top layer, the substrate having voids which extend between the top surface and the bottom surface, the substrate is manufactured from rubber in sheets which are cut to the desired configuration;

whereby the substrate has the strength characteristics to support the decorative layer and prevent damage thereto and the sound dampening characteristics to provide decibel reduction through the substrate.

When the Application was initially filed, no limitation on thickness was included.

On December 9, 2002, the Patent Office rejected all 24 claims of the Application pursuant to 35 U.S.C. s. 102 (a finding that each and every limitation of each claim was found in a single prior art reference) or 35 U.S.C. s. 103 (a finding that the claims were obvious to one of the skill in the relevant field in view of certain prior art). Specifically, the Patent Office found that the Application claims were not patentable in view of U.S. Patent No. 5,714,219, issued to Mashunkashey. (Rec.Doc.25, Ex. C).

On March 10, 2003 Dodge responded to the first Patent Office action, making amendments to the claims and arguing that the Mashunkashey patent did not, in fact, render the claims of the Application unpatentable. The Patent Office took its second action relating to the Application on May 20, 2003, again rejecting all claims contained therein pursuant to s.s. 102 and 103, again in view of both Mashunkashey alone and of Mashunkashey in combination with U .S. Patent No. 6,213,252 issued to Ducharme. (Rec.Doc.25, Ex. D).

On July 18, 2003, Dodge responded to the second Patent Office action. In this response, Dodge amended each of the pending claims to include the limitation that the substrate has "a thickness of about 10mm." Dodge argued in support of its amended claims, stating that "[t]he structure of the claimed invention differs from the structure of Mashunkashey et al., because the claimed invention requires the substrate to be porous and to have a thickness of about 10 mm." (Rec. Doc. 25, Ex. B, July 18, 2003 "Amendment" at 9, 10, and 11).

The Patent Office responded in its third Office action on September 4, 2003, again rejecting all the pending claims in view of U.S. Patent No. 6,602,586 issued to Kakimoto, or in view of Kakimoto in combination with Ducharme. (Rec.Doc.25, Ex. E). Dodge responded on December 4, 2003, making further amendments to certain claims and presenting new arguments.

On March 15, 2004, the Patent Office allowed claims 1-7 (each including the "thickness of about 10 mm" limitation) and rejected again the other pending claims in the application. After two additional Office actions and responses thereto, on March 16, 2005, the claims that are now present in the issued '723 patent were ultimately allowed by the Patent Office. As previously noted, the '723 patent was issued on July 26, 2005.

LEGAL FRAMEWORK:

Claim construction or claim interpretation is a question of law for the court to determine. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995)(en banc), aff'd 517 U.S. 370 (1996). The interpretation of a disputed claim term must first be determined based upon a review of the intrinsic evidence, namely the patent itself, including the claim language, the written description, and the file history. *See Bell Atlantic Network Services Inc. v. Covad Communications Group Inc.*, 262 F.3d 1258, 1267 (Fed.Cir.2001); *see also Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996).

The claim language itself is first examined to define the scope of the patented invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed.Cir.2005). As a starting point, claim terms are given their ordinary and accustomed meaning. *Id.* *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 955 (Fed.Cir.2000). "Without an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning." *York Prod., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1565, 1572 (Fed.Cir.1996). A technical term used in a patent is interpreted as having the meaning a person of ordinary skill in the art would understand it to mean. *Interactive Gift Express, Inc. v. CompuServe Inc.*, 256 F.3d 1323, 1332 (Fed.Cir.2001). Persons of ordinary skill in the art are deemed to read the claim terms not only in the context of the particular claim in which the term appears but in the context of the entire patent, including the specification and the prosecution history. *Phillips*, 415 F.3d at 1313.

The specification is always highly relevant to the claim interpretation analysis and acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication. *Vitronics*, 90 F.3d at 1582. The specification should be reviewed to ascertain the meaning of the claim term as it is used by the inventor in the context of the entirety of the invention. *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed.Cir.2001); *Interactive Gift Express*, 256 F.3d at 1332. The prosecution history may also be considered to determine whether or not any express representations were made in obtaining the patent regarding the scope and meaning of the claims. *Vitronics*, 90 F.3d at 1582.

Extrinsic evidence, including dictionaries, technical treatises, and expert testimony, "can shed useful light on

the relevant art," but it is recognized that such evidence is "less significant" than the specification and prosecution history for construing claims. Phillips, 415 F.3d at 1317 (quoting *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 338 F.3d 858, 862 (Fed.Cir.2004)). Accordingly, a patent's claims must be construed by referring primarily to the specification and the prosecution history and, only in limited circumstances, to extrinsic evidence. For instance, extrinsic evidence can be used to help educate one regarding the field of the invention and help determine what a person of ordinary skill in the art would understand claim terms to mean, but extrinsic evidence must be considered in the context of the intrinsic evidence. *Id.*

ANALYSIS:

A. Thickness of About 10 mm

The main issue of construction that pends before the Court is the meaning of the term "a thickness of *about* 10 mm." The parties maintain diverging interpretations of the meaning of the word "about" in this phrase. Dodge argues that "about 10 mm" encompasses a range of at least 10 mm to 2 mm. RB Rubber maintains that "about 10 mm" means slightly above or below 10 mm, but not greater than 12 mm and not less than 8 mm.

According to the legal framework set forth in detail in this Memorandum, the initial exercise for this Court to engage in when interpreting the disputed claim term-"about 10 mm"-is to apply the ordinary meaning to a term used in a claim, unless it is clear from the specification or file history that the questioned term is intended to mean something else. *See Bell Communications Research Inc. v. Vitalink Comm. Corp.*, 55 F.3d 615, 620 (Fed.Cir.1995). RB Rubber argues that "about" necessarily maintains its ordinary meaning as it relates to the patent, because nothing in the specification or the file history of the '723 patent indicates that the term "about" means anything *other* than its ordinary meaning. Dodge counters that the net effect of a reading of the '723 patent would lead one reasonably skilled in the art to understand the term "a thickness of about 10 mm" to incorporate a range of thicknesses from 2 mm to at least 10 mm.

As aptly noted by RB Rubber, both at the *Markman* hearing and within its submissions, there is nothing technical about the word "about." An example submitted by RB Rubber is instructive on this point:

If my daughter were 9 years and 6 months old, I would describe her age as "nearly 10" or "about 10." If she were 9 years and 2 months old, I would describe her as "about 9." If she were 5 years old, it would be absurd to describe her as "about 10."

(Rec. Doc. 41 at 2-3). It seems entirely logical to the Court that we should follow the teaching of this admittedly elementary example, and as a result the ordinary meaning of the term "about" must attach in the context of the '723 Patent.

Dodge argues that the net reading of the '723 patent and file history emphasizes Dodge's focus on thinness of the rubber substrate. Dodge essentially submits that because the aim of the '723 patent focused on thinness as its goal, we must then construe the term "about" to include a range of thinness, dipping as low as 2 mm. While we do not disagree with Dodge that its goal was to patent a thinner rubber substrate, we simply cannot find that the term "a thickness of about 10 mm" lends itself to include a substrate measuring 2 mm in thickness. To find as Dodge argues would defy simple common sense.

Accordingly, we find that the term "thickness of about 10 mm" means a thickness very close to 10 mm, including a range from 9 mm to 11mm. We find that a one millimeter range in each direction would not

defeat the purposes of the '723 patent, nor would it grant Dodge an overly broad interpretation of the '723 patent.

B. Subfloor

Within the submissions, the parties note that they agree with the definition of subfloor, namely "an integral part of the building or structure and can be in the form of a concrete slab, plywood floor, or other known material commonly used in the building industry," and therefore this definition is adopted by the Court.

C. Decorative Top Layer

Within the submissions, it appeared that the parties disagreed with the definition of the term decorative top layer, inasmuch as RB Rubber felt that Dodge's interpretation of decorative top layer required the top layer to have individual components, thereby excluding carpet as an example. However, at the hearing, Dodge clarified for the Court that carpet was not excluded from its definition of the term decorative top layer. Accordingly, we shall adopt the following definition of decorative top layer: wood, linoleum, ceramic, tile, carpet, or any other known flooring

D. Substrate

The parties disagree whether the term substrate should be limited to just recycled rubber. Dodge submits that the term substrate should be interpreted to mean a structure having a bottom surface, a top surface, side surfaces and end surfaces which are manufactured from recycled rubber. RB Rubber argues that the specification allows for the substrate to be made of "SBR rubber, other rubbers, or any combination thereof." (Rec.Doc.26, Ex. A, 3:25).

It appears that the '723 patent language itself recognizes that the substrate can be made from a rubber *other* than recycled rubber, therefore we find it would be too limiting to confine the scope of the claims to just recycled rubber. Therefore, the term substrate is defined by this Court to include SBR rubber, other rubbers or a combination thereof, in conformity with the '723 patent language.

E. Voids

The parties do not dispute the following interpretation of the term voids, which the Court shall adopt: random spaces between the particles of rubber from which the substrate is formed.

F. Adhesive

The parties do not dispute the following interpretation of the term voids, which the Court shall adopt: any glue or adhesive which is commonly used to apply flooring materials of the type specified as decorative top layers to subfloors. **NOW, THEREFORE, IT IS HEREBY ORDERED THAT:**

1. The terms of the '723 patent shall be interpreted in conformity with this Memorandum.
2. RB Rubber's Motion to File Amended Answer and Counterclaims (doc. 44) is GRANTED. The Clerk shall file the Amended Answer and Counterclaims.
3. The Clerk shall terminate Document 25 as a pending Motion, as it was improperly docketed as such.

M.D.Pa.,2007.

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