United States District Court,
C.D. California.

RODIME PLC, A SCOTTISH COMPANY,
Plaintiff.
v.
SEAGATE TECHNOLOGY, INC., A Delaware Corporation,
Defendant.

No. CV92-6855JSL

July 3, 1997.

ORDER AND JUDGMENT RE MARKMAN CLAIM INTERPRETATION HEARING

LETTS**, District J.**

On February 25 and 26, 1997, this Court conducted a *Markman* hearing to resolve the claim construction issues in this action. Having reviewed the papers submitted regarding this matter, having heard the evidence and oral argument presented at the *Markman* hearing, and being fully apprised of the relevant facts and law, IT IS HEREBY ORDERED AND ADJUDGED that

1. The positioning means elements of claims 3, 5, 8, and 17 of Rodime's '383 patent require thermal compensation.

2. The positioning means of claims 3, 5, 8, and 17 of Rodime's '383 patent provides thermal compensation solely by arrangement, geometry, and selection of materials.

3. The Seagate ST157 positioning mechanism does not literally infringe claims 3, 5, 8, and 17 because it uses a separate member for thermal compensation.

4. The Seagate ST157 positioning mechanism does not infringe claims 3, 5, 8, and 17 under the doctrine of equivalents or under s. 112, para. 6 because it uses a separate member for thermal compensation.

IT IS FURTHER HEREBY ORDERED AND ADJUDGED that summary judgement be entered in favor of Seagate, provided that, however, the Court will proceed with an advisory jury trial if either party so requests.

Discussion

The primary claim construction issue before the Court at the *Markman* hearing was whether the positioning means element of claims 3, 5, 8, and 17 of Rodime's '383 patent required thermal compensation. Although this question had been previously been answered by Special Master Wardlaw and Judge Gadbois, the Court

decided it was necessary to readdress it independently because that question might be dispositive of a second issue that had not been addressed: whether the equivalence issue in this case should actually go to a jury.

The Court concurs with and adopts the conclusions reached by Judge Gadbois, Special Master, and court-appointed expert Professor Bogy, that thermal compensation has to be included in the positioning means element of the disputed claims. *Markman Hearing Exhibits,* Exhibit 7, p. 3-6 (Bogy); Exhibit 39, p. 9 (Wardlaw); Exhibit 40, p. 3-4 (Gadbois).

The Court's independent analysis focused primarily on the previously undiscussed issue of whether the "positioning means" element could be sub-divided into two separate and distinct functions: the function of "moving" the head from track to track, and the function of thermal compensation. This simplistic statement of the issue suggested a simple answer: movement from track to track takes place in a period of time so brief that thermal compensation is not required for accurate movement. Consequently, thermal compensation could be defined as a distinct function from the function of moving from track to track. *Markman Hearing Transcript,* 2/25/97, at 63, 77 (Bogy), and 126 (Kline).

However, this narrow definition of moving is not a complete definition of the "moving" that is required of a computer disk drive system. In defining the function of a means plus function claim, the Court must define the function in terms that are relevant to the invention described in the specification. *See* Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995). In the disputed claims, the positioning means must not only function to move the head from track to track, it must be able to record data onto a disk and retrieve that data at a later time. Accordingly, the positioning means of a disk drive system must be able to accurately locate a track upon which information was recorded at an earlier time.

The Court agrees with Professor Bogy that in order to accomplish this "moving" function thermal compensation is required. *Transcript of Proceedings,* 3/6/97, at 9-10. Without thermal compensation, the disk drive system would not be able to read data recorded previously at a different temperature. Since "moving" in the context of the disputed claims necessarily includes returning to tracks of previously recorded information, the fact that each required movement takes place in only a short period of time does not make the function of movement separable from that of thermal compensation.

Rodime argues that the functions are nonetheless separable because the claimed invention can accomplish the relevant moving function without thermal compensation, so long as there are no significant changes in temperature between the time data is recorded and retrieved. FN1 This would require that the invention only be operated 1) in a temperature-controlled environment and 2) after a "warm up" period. FN2 This contention is not supported by the patent.

FN1. Alternatively, Rodime argues that thermal compensation, even if necessary for the invention, is a trivial aspect of a disk drive system and need not be included in the disputed claims. However, on re-examination, Rodime distinguished the claimed invention over prior art based on the means for providing thermal compensation of its invention. *Markman Hearing Exhibits,* Exhibit 4(D) at L004253-L004255. The argument that the means for providing thermal compensation made its claimed combination novel over the prior art, estops Rodime from arguing before this Court that thermal compensation, although necessary, is a trivial aspect of a disk drive system that is not, and need not, be included in the disputed claims.

FN2. Uncontradicted evidence presented at the *Markman* hearing established that, at least during a "warm up period," there are temperature changes created by the operation of the disk drive system itself that would require thermal compensation. *Markman Hearing Transcript,* 2/25/97, at 121 (Kline) and 129 (Bogy).

Nowhere in the patent, or any of the evidence examined by the Court, does it indicate that the disk drive system should only be used after delay or in a climate controlled environment. *See, Markman Hearing Transcript,* 2/25/97 at 57. FN3 On the contrary, the patent indicates that the disk drive system would not have such limitations. The patent repeatedly states that the invention is "particularly suited to meet the demands of a portable computer system" and other uses "where compact, rugged light-weight hard-disk storage is required." *See, e.g., Markman Hearing Exhibits,* Exhibit 1, '383 patent at Abstract; 1:38-49; 2:37-43 (object of the invention); 3:9-28; 5:11-15; 5:9-15; 5:34-39. These uses are not achievable with a disk drive system that must only be operated in a temperature-controlled room after a delay period. The value of portability is the ability to transport and use computers in multiple locations, which will inevitably have varying temperatures.

FN3. 35 U.S.C. s. 112, para. 1 mandates: " 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 certains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention."

Further, if the disputed claims were construed to have these limitations they would not represent an advancement of the prior art, and may deprive the patented invention of any commercial use. The practical significance, in 1987, of a computer that could only be used in a temperature-controlled environment is doubtful. As indicated by the patent itself, such an invention would have been a step backwards in the development of computers, rather than a step forward toward compactness and portability. FN4

FN4. *See also, Markman Hearing Transcript,* p. 130 (Kline) ("...clearly in the early conditions of manufacturing of disk drives, we imposed that they had to be in a controlled environment and they have to be operated exactly in that fashion.")

Having construed the positioning means element of the disputed claims as including thermal compensation, the Court concludes that the patent discloses and protects only positioning means that provide thermal compensation solely by arrangement, geometry, and section of materials. The Seagate ST157 positioning mechanism does not infringe these claims because it uses a "separate member" to accomplish thermal compensation.

Although the issue of infringement under the doctrine of equivalence or under s. 122 para. 6 presents a jury question, the Court can determine the issue under the general summary judgment standard when there is no genuine issue of material fact. Warner-Jenkinson Co. v. Hilton Davis Chem. Co., ---U.S. ----, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). FN5 In this action, there is not a genuine issue of material fact as to infringement.

FN5. "Where the evidence is such that no reasonable jury could determine two elements to be equivalent,

district courts are obliged to grant partial or complete summary judgment. [citations omitted]. If there has been a reluctance to do so by some courts due to unfamiliarity with the subject matter, we are confident that the Federal Circuit can remedy the problem. Of course, the various legal limitations on the application of the doctrine of equivalents are to be determined by the court, either on a pre-trial motion for partial summary judgment or a motion for judgment as a matter of law at the close of the evidence and after the jury verdict. [[citations omitted]. *Thus, under the particular facts of a case, if prosecution history estoppel would apply or if a theory of equivalence would entirely vitiate a particular claim element, partial or complete judgment should be rendered by the court, as there would be no further material issues for the jury to resolve*." *Id.,* at n. 8.

The Court agrees with Professor Bogy that, based on two distinct lines of analysis, Seagate's ST 157 does not infringe the Rodime '383 patent under the doctrine of equivalence or under s. 112, para. 6. *Markman Hearing Exhibits,* Exhibit 7, Report of Professor Bogy at 2, 15-27. First, Rodime is estopped from claiming equivalence by its arguments distinguishing prior art during re-examination. Second, limiting the equivalents to exclude systems that have a separate member for thermal compensation is the only construction consistent with the patent's validity.

Rodime is estopped from claiming equivalence by its arguments distinguishing prior art during re-examination. The prosecution history "is of primary significance in understanding the claims." Markman v. Westview Instruments, Inc., 52 F.3d 967, 980 (Fed.Cir.1995), *aff'd* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996); Alpex Computer Corp. v. Nintnedo Co., 102 F.3d 1214, 1220 (Fed.Cir.1996). If an applicant specifically distinguishes a structure from what is claimed during prosecution, the applicant will be estopped from asserting a scope for the same claim that covers the structure. Alpex Computer Corp. v. Nintendo Co. Ltd., 102 F.3d 1214, 1221-22 (Fed.Cir.1996). Just as prosecution history may act to estop an equivalence argument under the doctrine of equivalents, positions taken before the PTO may bar an inconsistent position on claim construction under s. 112, para. 6. *Id.*

In reexamination of the '383 patent, Rodime's attorneys distinguished the thermal compensation of the '383 patent from that of the Kaseta '996 patent. *Markman Hearing Exhibits,* Exhibit 4(D) at L0004254. FN6 Rodime's attorneys admitted that the use of metallurgy to compensate for thermal effects was known in the art, but distinguished the Kaseta patent based on the fact that it used a "separate member," as opposed to relying solely on arrangement, geometry, and section of materials, to accomplish thermal compensation. FN7

FN6. Although this discussion was related to claim 11, this discussion is relevant to the disputed claims because the "positioning means" of those claims requires thermal compensation, and only one kind of thermal compensation is revealed in the specification: one that accomplishes thermal compensation solely by arrangement, geometry, and selection of materials. *See supra.*

FN7. The court-appointed and party experts have considered at length the issue of how the Kaseta spring actually works to accomplish thermal compensation. *See Markman Hearing Exhibits,* Exhibit 7, Report of Professor Bogy at 22-25. The Court agrees with Professor Bogy that regardless of how the spring in Kaseta works, Rodime considered it a "separate member" from materials and geometry, and distinguished its claimed combination on that basis before the PTO. *See Markman Hearing Exhibits,* Exhibit 7, Report of Professor Bogy at 24.

In so doing, Rodime is estopped from asserting that the scope of its claims cover a structure that accomplishes thermal compensation through a separate member. The "thermal pin" of Seagate's ST157 design is a "separate member" similar to the thermal biasing spring element of the Kaseta patent. *Markman Hearing Exhibits,* Exhibit 7, Report of Professor Bogy at 15-25. Therefore, the Court agrees with Professor Bogy that Rodime is estopped from claiming that such a structure is an equivalent. *Id*. at 26-27.

Even if, arguendo, Rodime is not deemed to be estopped by its arguments, limiting the scope of equivalents to exclude systems with thermal compensation relying on a "separate member" is the only construction consistent with the patent's validity. The Court, the court-appointed experts, and the Special Master in this action have repeatedly raised concerns that, in light of the inherent commonality of methods for making computers smaller, call into question the validity of the '383 patent. *See, e.g., Transcript of Proceedings,* 3/6/97, p. 6; *Markman Hearing Transcript,* 2/25/97, p. 66-67. The Court agrees with Professor Bogy that the Rodime '383 patent would have been obvious in light of the prior art *but for* its unique method for achieving thermal compensation, and its distinction and disavowal of combinations that achieved thermal compensation through a separate member. *See Markman Hearing Exhibits,* Exhibit 6 at 1.

Therefore, the scope of the '383 patent under the doctrine of equivalents and s. 112, para. 6 is quite narrow. "The broadest protection under the doctrine of equivalents is reserved for pioneer or generic patents... as distinguished from a mere improvement or mere perfection of what had gone before." 3 Peter D. Rosenberg, *Patent Law Fundamentals* s. 1707[1] at 17-95. Even if the test for equivalence is met, "there can be no infringement if the asserted scope of equivalency of what is literally claimed would encompass prior art." *Id*. at 17-90.1.

When questioned by the Court at the *Markman* hearing, Professor Bogy stated if Seagate has attempted to patent its ST157 design prior to Rodime, it would have been obvious in light of the teaching of Kaseta. If the scope of the Rodime '393 disputed claims covered thermal compensation structures that included a separate member, they would have been obvious in light of the teaching of Kaseta as well. *See Markman Hearing Transcript,* 2/25/97, at 105-107. Even without Kaseta, the use of a separate member for thermal compensation would have been obvious to those skilled in the art when the patent was prosecuted. *Id*. at 107.

Rodime obtained the patent by construing its claims narrowly, as not covering structures that used a separate member to accomplish thermal compensation. It was necessary for Rodime to make this narrow construction to obtain the '383 patent. The Court will not adopt a construction of the scope of the disputed claims pursuant to the doctrine of equivalents or s. 112, para. 6 that would render them obvious and invalid.

IT IS SO ORDERED.

C.D.Cal.,1997.
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