

United States District Court,
N.D. Illinois, Eastern Division.

ASHLAND PRODUCTS, INC,
Plaintiff.

v.

MEC TECHNOLOGIES, INC,
Defendant.

March 24, 1999.

MEMORANDUM OPINION AND ORDER

COAR, District J.

Before this court is plaintiff Ashland Products, Inc.'s ("plaintiff" or "Ashland") claim of patent infringement under 35 U.S.C. s.s. 101 et seq., for infringement of U.S. Patent No. 5,139,291 (" '291") against defendant MEC Technologies, Inc. ("defendant" or "MEC"). As the first step in this litigation, Ashland and MEC submitted papers and presented oral arguments on the construction of Claim 1 of the '291 patent. After considering the arguments of both parties, the court interprets the construction of Claim 1 as follows.

The '291 Patent

Ashland, as assignee, holds patent '291 entitled "Flush Mount tilt-Latch For a Sash Window and Method." FN1 (Pl's Ex. A). This "tilt-latch" is used in windows in order to allow a user to unhook the bottom half of a standard window and tilt the window inward. The '291 tilt-latch patent is in response to the prior art Ro-Mai tilt-latch. While the '291 tilt-latch has "longitudinal edges" and "a pair of side walls" in order to create "a plurality of points along the length of the side wall of the tilt-latch," the Ro-Mai latch has only "a pair of flared tabs" at the front and the back of the housing to hold it in place. (Pl's Ex. A). Therefore, while the Ro-Mai tilt-latch has a tendency to disengage, or "pop out," of the top sash rail of the window, the '291 tilt-latch is stronger and more secure. (Pl's Ex. A).

FN1. The abstract for patent '291 describes the "tilt-latch" as follows: " A pivot latch adapted for releasably securing a pivotable sash window to a master frame. The master frame has opposed, vertically extending guide rails. The sash has a hollow top sash rail, a base and a pair of hollow stiles cooperatively connected together at adjacent extremities thereof to form a rectangular sash frame. The top sash rail includes a pair of opposing header slots. Each of the header slots forms a pair of opposing, longitudinal header rails. The pivot latch comprises a housing having an outward end opening. A latch bolt is disposed within the housing. The pivot latch further includes a spring for biasing the latch bolt outwardly through the outward end opening and is adapted for engaging one of the guide rails. The housing has a cover having longitudinal edges and a pair of side walls depending from the cover and disposed inward of the edges. Each of the side walls has a side wall rail which cooperates with a respective one of the housing cover edges to form a longitudinal groove adapted to cooperatively receive a respective pair of the header rails. A tab depending from the

housing is provided for engaging a respective one of the stiles to retain the tilt latch in position." (Pl's Ex. A).

Ashland alleges that MEC has sold tilt latches that embody the invention covered by patent '291 and thus infringes upon Ashland's patent. (Complaint para. 9, 10). MEC denies the infringement. (Answer para. 9, 10).

Since the claims of a patent define the scope of protection to an inventor or assignee, the claims of '291 determine what Ashland can and cannot prevent MEC from making. The '291 patent has 17 claims. (Pl's Ex. 1). The only claim presently in dispute is Claim 1. (Pl's Ex. 1). Ashland and MEC have stipulated to the definition of all but one of the terms in Claim 1 of patent '291. (Pl's Ex. B). The only term in dispute is the meaning of the term "groove." In particular, the dispute concerns the interpretation of the phrase, "a longitudinal groove adapted to cooperatively receive a respective pair of said header rails." (Pl's Ex. 1; Pl's Mem. in Support, pp. 2-3). Ashland argues that the phrase should be determined to mean the following:

A recess formed along the exterior side of each of the side walls which receives a respective one of the opposed header rails along the length of the housing, wherein each of the recesses is defined by two spaced recess walls which cooperate to receive one of the header rails, and each of the recess walls is defined by one or more projections along the length of the side wall. (Pl's Mem. in Support, p. 3).

In response, MEC argues that the phrase should be construed to apply only to latches which employ a groove or header rail with a slide-in type of installation. (Dft's Mem. in Support, p. 12). In other words, the issue in this claim construction dispute is whether or not a groove must be continuous to be a groove. The parties submitted briefs on the issue and the court ordered a hearing to be held on January 9, 1997.

Standard for Claim Construction

A patent infringement analysis requires two steps: the first is to determine the proper construction of the asserted claim; the second is to determine whether the accused method or product infringes the asserted claim as properly construed. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd* 517 U.S. 370 (1996). The interpretation and construction of patent claims is a matter of law and thus is properly determined by the court. *Id.* at 979.

In interpreting an asserted claim, the court should first look at the intrinsic evidence: the claim itself, the specification, and the prosecution history. *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). When examining the claim, the court should first look at the "ordinary and customary" meanings of the words. *Id.* at 1582. However, the patent holder may alter the meaning of the words "as long as the special definition is clearly stated in the patent specification or file history." *Id.* at 1582.

The next piece of intrinsic evidence for the court to review is the specification. The purpose of this review is "to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." *Vitronics*, 90 F.3d at 1582. The specification is a written description of the product or process which is clear and complete enough so that a person of "ordinary skill in the art" can understand the parameters of the patent. *Smithkline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 882 (Fed.Cir.1988). "The specification 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 final piece of intrinsic evidence to review is the prosecution history of the patent. The prosecution history contains the entire record of the prosecution of the patent claim before the patent office, including any representations made by the patent holder about the scope of the claim. However, sometimes the entire prosecution history is not offered into evidence.

If after an analysis of the intrinsic evidence, the language of the asserted claim is still ambiguous, then the court has the discretion to examine extrinsic evidence. *Vitronics*, 90 F.3d at 1584. However, the court should turn to extrinsic evidence only if there is a genuine ambiguity in the claims. *Markman*, 52 F.3d at 978-79; *Vitronics*, 90 F.3d at 1584.

Most patents contain several claims and thus many times parties argue that one claim broadens or narrows the scope of another claim. However, the court must be careful in how it analyzes such arguments, for the court "cannot broaden claims beyond their correct scope, determined in light of the specification and the prosecution history and any relevant extrinsic evidence." *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1479 (Fed.Cir.1998). On the other hand, "...narrow claim limitations cannot be read into [] broad [claims] whether to avoid invalidity or to escape infringement." *United States v. Teletronics, Inc.*, 857 F.2d 778, 783 (Fed.Cir.1988); see also *SRI International v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1122 (Fed.Cir.1985).

Analysis

A. The Claim

Ashland argues that there is no language in Claim 1 that would require a continuous groove or a groove with continuous side walls. Ashland states that the important aspect of the patented product is not that the walls be continuous, but that the groove is adapted to receive the header rail. (Pl's Mem. in Support, p. 11). Granted, the words of the preferred embodiment imply continuous side walls, but Ashland argues that claims should not be limited to the preferred embodiment. (Pl's Mem. in Support, pp. 11-12). To support this argument, Ashland points to the other claims, such as Claim 7, which use the same language as Claim 1 and do not include a continuous requirement. (Pl's Mem. in Support, p. 12; Pl's Ex. 1). In response, MEC argues that if the court read the claim as broadly as Ashland argues it should be read, then the wording of Claim 1 would apply to the flare tabs of the prior art Ro-Mai latch and thus make the '291 patent invalid. (Dft's Mem. in Support, p. 11). Therefore, if the court reads the ordinary and plain meaning of the words of Claim 1, then the longitudinal groove would be read to mean "continuous." (Dft's Mem. in Support, p. 12).

The language of Claim 1 that is in question states:

"... [the] said housing has a cover and a pair of side walls depending from said cover, each of said side walls forming a *longitudinal groove adapted to cooperatively receive a respective pair of said header rails*... (Pl's Ex. 1, emphasis added).

No where in Claim 1 is there language of "continuous groove" or "continuous sidewalls." Granted, the diagrams included within the preferred embodiment show a continuous edge on the body of the tilt-latch, implying that the sidewall, or groove, must be continuous. However, Ashland is correct that patent claims should not be limited to the preferred embodiment. See *Transmatic, Inc. v. Gulston Industries, Inc.*, 53 F.3d 1270, 1277 (Fed.Cir.1995) ("a patent claim is not necessarily limited to a preferred embodiment disclosed in the patent."); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed.Cir.1988) ("References to

a preferred embodiment, such as those often present in a specification, are not claim limitations."), *cert. denied*, 490 U.S. 1068 (1989); *Texas Instruments, Inc. v. United States International Trade Commission*, 805 F.2d 1558, 1563 (Fed.Cir.1986) ("This court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification.").FN2

FN2. MEC filed a separate brief discussing preferred embodiments. MEC argued that controlling case law states that when only one preferred embodiment is presented in the patent, then that preferred embodiment can be read as a limitation on the claims of the patent. *General American Transportation Corp. v. Cryo-Trans, Inc.*, 93 F.3d 766, 770 (Fed.Cir.1996); *Modine Mfg. Co. v. U.S. International Trade Commission*, 75 F.3d 1545, 1551 (Fed.Cir.1996); *Vitronics*, 90 F.3d at 1583 (Fed.Cir.1996); *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1578 (Fed. Cir.1996). However, in the cases MEC cites, the courts point out that one specific requirement was described in the preferred embodiment, the specification, and the prosecution history of each of the patents in question. That is not the case here, where there is no unambiguous requirement that the longitudinal groove be continuous. Therefore, the general rule that an inventor may claim an invention more broadly than the preferred embodiment still applies. *Transmatic*, 53 F.3d at 1277 (Fed.Cir.1995).

Since Claim 1 does not contain any limiting words, such as "continuous," it is broader than the preferred embodiment and the other claims. The narrower limitations of other claims cannot be read into Claim 1. *Teletronics*, 857 F.2d at 783 (Fed.Cir.1988); *SRI Int'l*, 775 F.2d at 1122 (Fed.Cir.1985); *Deere & Co. v. International Harvester, Co.*, 658 F.2d 1137, 1141 (7th Cir.1981), *cert. denied*, 454 U.S. 969 (1981). Therefore, the plain language of the claim does not require a continuous groove.

B. The Specification

While the specification describes the design with the continuous sidewalls diagramed in the preferred embodiment, Ashland argues that the specification does not require such a continuous wall. (Pl's Mem. in Support, p. 13). Claim 1 is broader than both the preferred embodiment and the specification; however, that does not mean that Claim 1 must be limited, for it is improper to read limitations from specifications into the claims. The law does not require every conceivable embodiment to be included in the specification. (Pl's Mem. in Support, p. 15).

Ashland's argument is correct. The courts have found that "[w]here a specification does not require a limitation, that limitation should not be read from the specification into the claims ." *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 987 (Fed.Cir.1988). If everything in a specification were required to be read into the claims, or the patent was limited only to the design in the specification, then there would be no need for claims. *SRI Int'l*, 775 F.2d at 1121 (Fed.Cir.1985). While the specification for '291 describes a model with a continuous groove, the benefits of the patented design can be gained from a non-continuous wall, as long as the walls are significantly longer than the flare tabs of the prior art Ro-Mai design. MEC even admitted at oral argument that the specification could be read to include this noncontinuous design. (Hearing Transcript, pp. 45-46).

Finally, the specification does not have to include every possible design under the patent: "The law does not require the impossible. Hence, it does not require that an applicant describe in [her] specification every conceivable and possible future embodiment of [her] invention. The law recognizes that patent specifications are written for those skilled in the art, and requires only that the inventor describe the 'best

mode' known at the time to [her] of making and using the invention." SRI Int'l, 775 F.2d at 1121 (Fed.Cir.1985) (citing 35 U.S.C. s. 112). In the present case, the "best mode" seems to be continuous grooves or sidewalls in order to provide the maximum strength against bending and disengagement. However, the "best mode" does not preclude a slightly weaker design of noncontinuous grooves that are longer than the flare tabs of the prior art Ro-Mai tilt-latch.

C. Prosecution History

The prosecution history does not shed light on this issue of the continuous groove. Ashland states that the United States Patent and Trademark Office allowed Claim 1 to be filed as is, and MEC points out that there is nothing in the history that contradicts the claim or the specification. In other words, the prosecution history is silent on this issue.

D. Extrinsic Evidence

Both parties conceded that it is not necessary for the court to review extrinsic evidence, for any ambiguity in the terms of Claim 1 is eliminated by reviewing the intrinsic evidence. (Pl's Mem. in Support, pp. 17-18; Dft's Mem. in Support, p. 8). However, both sides still offered several pieces of extrinsic evidence to the court.

Ashland presented window end pieces from other manufacturers with window tracks that had noncontinuous grooves in order to demonstrate that within the window hardware industry, grooves can have either continuous or noncontinuous sidewalls. (Pl's Mem. in Support, p. 18). MEC presented definitions from Webster's dictionary of "groove," "longitudinal," "cooperate," and "receive," as well as pieces of Ashland's sales literature. (Dft's Mem. in Support, p. 8-10).

Since the court finds that a review of the claim, the specification, and the prosecution history clarify any ambiguity in Claim 1, it is not necessary to examine the extrinsic evidence of either side.FN3

FN3. At the hearing, both parties became involved in a discussion of the definition of "groove." After an examination of the definition presented by MEC, "...a long narrow hollow or channel made artificially in a surface," the court finds that the definition does not require the groove to be continuous for any specified length.

Conclusion

After an examination of the claim, the specification, and the prosecution history of the '291 patent, it seems clear to the court that the '291 patent does not require that a groove be continuous for the patent to apply. Therefore, the court construes the meaning of "a longitudinal groove adapted to cooperatively receive a respective pair of said header rails" in Claim 1 to be defined as:

"a recess formed along the exterior side of each of the side walls which receives a respective one of the opposed header rails along the length of the housing, wherein each of the recesses is defined by two spaced recess walls which cooperate to receive one of the header rails, and each of the recess walls is defined by one or more projections which extend substantially along the length of the side wall." (Pl's Mem. in Support, p. 3).

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