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

HP INTELLECTUAL CORP. and HOUSEHOLD PRODUCTS, INC,
Plaintiffs.
v.
SUNBEAM PRODUCTS, INC,
Defendant.

May 13, 1999.

MEMORANDUM OPINION AND ORDER

NORDBERG**, District Court J.**

This is a patent infringement case involving competing food steamers, sometimes also referred to as rice cookers. Plaintiffs have filed a motion for summary judgment, arguing that defendant Sunbeam Products, Inc. ("Sunbeam") is liable for patent infringement under both literal infringement and the doctrine of equivalents. For the reasons set forth below, this court denies plaintiffs' motion for summary judgment.

BACKGROUND

This action originally was filed by plaintiff Black & Decker Inc. ("Black & Decker"). On October 5, 1998, after the parties filed their summary judgment briefs and after this court heard oral argument, Black & Decker filed a motion for leave to substitute HP Intellectual Corp. and Household Products, Inc. as plaintiffs. The substitution was requested because Black & Decker assigned and transferred its entire right, title, and interest in the patent at issue in this case to HP Intellectual Corp. FN1 Sunbeam did not oppose the motion, and it was granted by this court on October 9, 1998. Although there has been a change in the name of the plaintiff, for the sake of convenience and in keeping with the terminology used by the parties in their briefs, this court will continue in this opinion to refer to Black & Decker as the plaintiff.

FN1. Household Products, Inc. designs and manufacturers household products, including specifically the food steamers at issue in this case.

Black & Decker and Sunbeam were competitors in the consumer products industry. In 1992, Black & Decker designed a food steamer which it claimed would solve many of the problems with the food steamers then available in the industry. FN2 Most of the other steamers included a base, heater, water reservoir, cooking bowl, and lid-all stacked together vertically. According to Black & Decker, the cooking bowl typically had a perforated bottom surface and was located above the water so that when the water in the reservoir was heated, the steam rose into the cooking bowl to cook the food. One problem, however, was that such steamers allowed food juices to drip back down into the reservoir, causing the food juices to be boiled along with the water, which then emitted foul odors and caused problems in cleaning. Further, according to Black & Decker, those steamers that have been designed to solve this problem have suffered from other problems, the main one being uneven cooking that resulted from using one pathway for the steam to flow upward to heat the food and another pathway for the food juices to drain downward. Black & Decker's steamer was designed to solve these problems.

FN2. The Black & Decker steamer actually was designed by an employee of Black & Decker, Stuart Naft, who then assigned the invention to Black & Decker.

Black & Decker applied for a patent for its new steam cooking utensil, which was issued on March 24, 1992. U.S. Patent No. 5,097,753, entitled "Steam Cooking Utensil" ("the '753 patent"). A copy of the '753 patent is attached to the complaint as Exhibit A. The '753 patent includes eight claims. Claims 1 and 6 are independent claims, and the other claims are dependent on Claims 1 or 6. In addition to the specific language of the claims, the patent contains a written description of the invention, known as the specification, which includes a description of the preferred embodiment of the invention along with diagrams of the preferred embodiment.

Claims 1 and 6 both contain a number of discreet limitations. The limitations for Claim 1 are as follows:

1. A steam cooking utensil comprising:

a base;

a boiling liquid reservoir defined by the base;

a heater mounted in the base to heat liquid contained in the boiling liquid reservoir;

a drip ring supported in said base above said liquid reservoir and including an imperforate surface and an opening axially aligned with said heater;

a cooking bowl supported by said base and including a bottom tray having an imperforate surface axially aligned with the opening in the drip ring and the heater and a food support surface extending radially outwardly from said imperforate surface, said food support surface being defined by a plurality of alternating hill-like ridges and valley-like channels extending radially outwardly in concentrically spaced rings, said food support surface including a plurality of vent holes for enabling steam generated in said reservoir to flow into said cooking bowl, said [v]ent holes formed in the valley-like channels and the hill-like ridges maintain food supported by said bottom tray in spaced relation to said vent holes; and

a lid for closing the open end of said cooking bowl.

Cmplt., Ex. A at Col. 4.

The limitations for Claim 6 are as follows:

6. A steam cooking utensil comprising:

a base;

a boiling liquid reservoir defined by the base;

a heater mounted in the radial center of the base to heat liquid in the boiling liquid reservoir;

a drip ring supported in said base axially above said liquid reservoir and including a centrally located opening aligned with said heater and an imperforate surface extending radially outwardly from said opening;

a cooking bowl including a bottom tray having an imperforate surface axially aligned with the opening in

the drip ring and the heater and a perforated surface extending radially outwardly from said imperforate surface for supporting food to be steamed, the diameter of the openings in said perforated surface increasing as the openings are positioned radially outwardly relative to the imperforate surface;

means for maintaining food supported on said openings therethrough; and

a lid for closing the open end of said cooking bowl.

Id. at Col. 4-5.

The Sunbeam steamers at issue in this case are Model Nos. 4710 and 5710. For purposes of this litigation, the parties agree that these two models are essentially the same. The Sunbeam steamers were designed in Hong Kong by Sunbeam's supplier, Pentalpha Enterprises Ltd. ("Pentalpha"). Sunbeam purchases the steamers from Pentalpha and packages and sells them under the Sunbeam brand name. Pentalpha owns a United States patent for its food steamer, Patent No. 5,400,701, which was issued to Pentalpha on March 28, 1995 ("the '701 patent").

On December 22, 1995, Black & Decker filed the complaint in this action, alleging that the Sunbeam steamers infringed the '753 patent. Sunbeam denied Black & Decker's claims and counterclaimed, alleging that Black & Decker's '753 patent is invalid, not infringed, and unenforceable. Sunbeam also claimed that the United States Patent and Trademark Office ("PTO") improperly issued the '753 patent because it failed to consider "highly relevant" prior art. Sunbeam sought reexamination of the '753 patent by the PTO, and this court stayed this action pending reexamination. The PTO reviewed several new prior art references that it previously had not considered when initially examining the application for the '753 patent. Upon reexamination of the '753 patent the PTO found Black & Decker's patent to be valid and "unique." FN3

FN3. Specifically, the PTO stated that the "prior art [cited by Sunbeam] fails to teach, alone or in combination the unique combination of elements claimed by the [Black & Decker patent] that achieve the advantages of dripping separation, steam control, and even food cooking obtained by the [Black & Decker] invention...." Reexamination Certificate Bl 5,097,753, issued March 18, 1997.

Black & Decker then moved for summary judgment of patent infringement on Claims 1 and 6. This court held a hearing to consider the motion for summary judgment and to construe the claims.

DISCUSSION

A patent infringement analysis involves a unique, two-step process. The first part of the analysis is construction or interpretation of the meaning and scope of the claims of the patent in suit. *See* Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed.Cir.1995), *aff'd,* 517 U.S. 370 (1996). The second part of the analysis requires a comparison of the claims of the patent-in-suit to the accused device.

In the first step, involving what is referred to as a Markman hearing, this court must construe the particular words of the claims as a matter of law. Markman, 517 U.S. at 372; *Vitronics,* 90 F.3d at 1583. "Proper claim construction requires an examination of the claim language, the written description, and, if relevant, the prosecution history. The appropriate starting point, however, is always with the language of the asserted claim itself." Comark Communications, Inc. v. Harris Corp., 156 F.3d 1182, 1186 (Fed.Cir.1998) (citations omitted). The words of a claim should be given their ordinary and customary meaning. *Vitronics,* 90 F.3d at 1582. A court may use the written description of the invention-also known as the specification-as an aid in construing ambiguous or disputed terms in the claim. *Id.* (the specification is "always highly relevant" and is "[u]sually" the "single best guide to the meaning of a disputed term").FN4 Although the specification is important, "limitations from the specification are not to be read into the claims." Comark, 156 F.3d at 1186.

FN4. "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 pertains, 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 ." 35 U.S.C. s. 112.

In the second step of the infringement analysis, there must be a comparison of the properly construed claims to the accused device. This is a question of fact. *See* Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp., 93 F.3d 1572, 1583 (Fed.Cir.1996). When analyzed in the context of a summary judgment motion, as is the case here, this second step thus implicates the well-known standards under Rule 56.FN5 Thus, summary judgment in a patent case, like any case, is appropriate when there are no genuine issues of material facts and the movant is entitled to judgment as a matter of law. Fed.R.Civ.P. 56(c); *see also* Monarch Knitting Mach. Corp. v. Sultzer Morat GMBH, 139 F.3d 877, 880 (Fed.Cir.1998). The court determines whether genuine issues of material fact exist by looking at the pleadings, depositions, answers to discovery requests, admissions, and affidavits. The evidence presented by the parties and all inferences taken must be viewed in a light most favorable to the nonmoving party. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986). The movant bears the burden of establishing the absence of a genuine issue of a material fact. Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986).

FN5. Although a Markman hearing may be conducted at almost any time in the legal proceeding, in this case, it has been conducted as part of the analysis of the pending summary judgment motion. *See generally,* Mediacom Corp. v. Rates Technology, Inc., 4 F.Supp.2d 17, 22 at n. 2 (D.Mass.1998) ("Since *Markman,* claim construction has most frequently been handled in conjunction with a hearing on a motion for summary judgment.").

Black & Decker has moved for summary judgment on the grounds that Sunbeam's steamers infringe Black & Decker's patent in two different ways: (1) literal infringement; and (2) infringement under the doctrine of equivalents. For the accused device to infringe the claims of the patent-in-suit, it must exactly embody each claim limitation or its equivalent. *See* Miles Labs., Inc. v. Shandon, Inc., 997 F.2d 870, 876 (Fed.Cir.1993). Should even one limitation in a properly construed claim be absent from the accused device, there will be no infringement. *See* London v. Carson Pirie Scott & Co., 946 F.2d 1534, 1538 (Fed.Cir.1991).

I. Claim Construction

Consistent with the above methodology, this court first must determine the scope and meaning of the claims in the '753 patent. In this case, both parties focus their arguments almost exclusively on claim construction. As noted previously, there are two claims at issue in this motion-Claims 1 and 6-each of which contains a number of specific limitations. Although the parties dispute the meaning of all but one of the limitations in each of the two claims, this court believes that it is only necessary to construe the second and third limitations of the two claims in order to resolve this summary judgment motion.

For purposes of this analysis, the second and third limitations in each claim are the same. Specifically, the language of the second limitation is identical in each claim and requires "a boiling liquid reservoir defined by the base." The language of the third limitation of each claim is almost identical. In Claim 1, the third limitation requires "a heater mounted in the base to heat liquid contained in the boiling liquid reserve." In Claim 6, the third limitation requires "a heater mounted in the radial center of the base to heat liquid in the boiling liquid reservoir." In sum, this court will construe these two limitations, which can be stated as follows: "a boiling liquid reservoir defined by the base" and "a heater mounted in the [radial center of the] base to heat liquid in the boiling liquid reservoir."

The parties offer different interpretations of the language in these two claim limitations. Reduced to its simplest form, the parties' arguments turn on whether this claim language requires that the liquid (which is usually water) must actually come to a boil while inside the reservoir. If it does, the parties basically agree that Sunbeam's heating system does not fall within this language because it does not bring water to a boil inside the reservoir.

Before analyzing the specific language of the claim limitations, as this court is required to do, it will be helpful to first describe the different heating systems used in the Sunbeam steamers and in Black & Decker's "preferred embodiment" of its patented steamer. The parties are in agreement that in the preferred embodiment of the Black & Decker steamer, the water actually comes to a boil while inside the reservoir which holds the water. As set forth in the specification, which contains a description and diagram of the preferred embodiment, the Black & Decker heater is an immersion type heating system in which the system's heater is located in the middle of the reservoir. The heater thus heats the adjacent water to boil while the water sits inside the reservoir. The steam then rises upward from the surface of the water.

In contrast, the Sunbeam steamers use a different heating system, referred to either as a flash-steam system or a remote flow-through system. Instead of heating the water as it sits in the reservoir, the Sunbeam steamer heats the water in a C-shaped heating element located underneath the reservoir rather than inside the reservoir. In operation, water in the Sunbeam steamer intermittently drains, by the force of gravity, out of a tube attached to the bottom of the reservoir and flows into the C-shaped heating element located underneath the reservoir. While in the C-shaped element, the water is vaporized or "flashed" into steam. The steam then flows upward through a steam nozzle. Thus, the Sunbeam steamer heats the water "from" the reservoir rather than "in" it. At no time does the water in the reservoir of the Sunbeam steamers rise to a boiling point while *in* the reservoir. The Sunbeam steamer converts the water into steam in approximately 15 seconds whereas the Black & Decker steamer takes approximately a minute to bring the water to boil. Moreover, the Sunbeam steamer heats the water intermittently whereas the Black & Decker steamer heats the water continuously.

Black & Decker does not dispute that such differences exist between the Sunbeam steamers and the preferred embodiment of the Black & Decker steamer. Instead, Black & Decker argues that such differences are not important because this court must construe the literal words of the "claim limitations" and may not use certain limitations contained in the "preferred embodiment" to limit the language in the claims. *See generally* Texas Instruments, Inc. v. United States Int'l Trade Comm'n, 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."). In other words, Black & Decker argues that the language of the claim limitations is broader than the language describing the preferred embodiment. Therefore, if Black & Decker's interpretation is correct, the limitations can cover both the preferred embodiment and the Sunbeam steamers even though they have different heating systems. Under this analysis, each heating system is simply one specific way to embody the broader patent claim.

This court agrees with Black & Decker's general statement of the law and therefore begins with an examination of the specific language of the claims. With regard to the second limitation, Black & Decker argues that the phrase "a boiling liquid reservoir" merely requires a reservoir or receptacle that holds liquid that-at some point in time and at some place-will be boiled. In other words, according to Black & Decker, the language does not require that the liquid actually be boiled *in* the reservoir.

This court disagrees with Black & Decker's proposed interpretation and instead finds that the limitation of "a boiling liquid reservoir defined by the base" must be construed to mean a reservoir inside which the liquid is brought to boil. This interpretation makes sense of the specific language. The limitation refers to a "boiling" liquid reservoir. Under Black & Decker's interpretation, the word "boiling" would be superfluous if the limitation did not require that the liquid actually be brought to a boil while it sits inside the reservoir. Black & Decker chose to add the phrase "boiling liquid" to modify the word "reservoir." To interpret the

phrase only to mean that the water in the reservoir will be boiled at some later point in time and in a different place is an awkward and unnatural interpretation of the language. This court believes that its construction of the second limitation makes more sense of the ordinary meaning of the words used by Black & Decker.

To the extent that there is any ambiguity, this court finds that the specification provides further support for this interpretation. Specifically, the patent specification states as follows:

The present invention is embodied in a steam cooking utensil generally referenced by the numeral 10. Utensil 10 includes a base member 12 having a wall 17 defining a *boiling liquid reservoir* 16. A heating element 18 *is mounted in reservoir* 16 to provide heat to the liquid, such as water *to transform the water into steam*.

* * *

In operation, fluid such as water is placed into reservoir 16 and food is placed into bowl 26 onto surface. The various components of utensil 10 are assembled and electrical power is delivered to the heating element 18 *to boil the water in the reservoir*. The steam formed as a consequence of boiling the water passes upwardly through opening 24 in member 20 and thence through flow holes 42A-42E in food support tray 28.

Ex. A at Col 2., lines 8-13, and Col. 3, lines 53-60 (emphasis added). This language emphasizes that the water is brought to a boil "in" the reservoir and thus reinforces the court's construction of the language above.FN6

FN6. In referring to the specification, this court is aware of the rule that the language of the specification cannot be used to limit the broader language of the claims but only can be used to interpret that language. However, as the Federal Circuit has recently acknowledged, "there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification." Comark, 156 F.3d at 1186-87.

This court finds that a similar analysis applies in construing the third limitation-"a heater mounted in the [radial center of the] base to heat liquid contained in the reservoir." Black & Decker focuses on the first half of the limitation and argues that this limitation merely requires that the accused device have a heater mounted in the base. Under such a proposed interpretation, it is irrelevant whether the heater is actually "in" the reservoir or underneath it-either way, the heater is in the base. This court does not disagree with Black & Decker's proposed interpretation of the first half of the limitation, standing alone. However, this court believes that Black & Decker ignores the second half of this third limitation; namely, the requirement that the heater mounted in the base must "heat liquid contained in the boiling liquid reservoir." For the same reasons stated above, this court finds that the third limitation should be construed to require a heater that heats the liquid while it sits in the reservoir. Once again, Black & Decker chose to insert the phrase "boiling liquid" when referring to the reservoir. In sum, when taken together, the two limitations reinforce the same basic point. The Black & Decker patent is limited to a heating system that heats the liquid while in the reservoir.FN7

FN7. After the parties filed their summary judgment briefs in this case, the Federal Circuit issued a ruling in a similar case- The Rival Co. v. Sunbeam Corp., 1998 WL 96416, *6-7 (Fed.Cir. Feb. 23, 1999)-in which it affirmed the district court's finding of no infringement based on, among other things, a finding that Sunbeam's food steamers lacked a "boiling water reservoir." The parties here filed supplemental briefs concerning the effect of this opinion. Because *Rival* involved a different (albeit similar) patent and because

the Federal Circuit's opinion is not citable as precedent, this court did not consider the *Rival* opinion in this ruling.

II. Infringement

Having construed these two limitations in the above manner, this court now turns to the question of infringement and Black & Decker's summary judgment motion. In their briefs, the parties devote the bulk of their argument to the dispute over claim construction, presumably because they believe that resolution of that issue will be dispositive. *See* Markman, 52 F.3d at 989 (claim construction is a crucial step in the process because determining the scope and meaning of the claims often will decide the case).

A. Literal Infringement

Based on the above claim construction and applying the undisputed material facts, this court finds the Sunbeam steamers do not literally infringe Claims 1 or 6 for the basic reason that the Sunbeam steamers do not contain the second limitation of "a boiling liquid reservoir defined by the base." Although the Sunbeam steamers do have a "reservoir," they do not heat the liquid *in* the reservoir but instead heat the liquid in a flow-through heating unit located in the base of the product and underneath the reservoir.

Similarly, the Sunbeam steamers do not literally infringe Claims 1 or 6 because the heater does not heat the liquid while it is in the boiling liquid reservoir as is required by the third limitation as construed by this court. As already explained above, although it is true that the Sunbeam steamers have a heater mounted in the base, they do not heat the liquid while it is in the liquid reservoir.

Having found that the second and third limitations of both Claim 1 and 6 are absent from the Sunbeam steamers and therefore that there is no literal infringement of either claim, this court will not analyze the remaining limitations of Claims 1 and 6. The parties agree that if there is no literal infringement on the independent claims (Claims 1 and 6), then there can be no literal infringement on the dependent claims (Claims 2, 3, 5, 7, and 8). In sum, this court finds that there is no literal infringement.

B. Infringement Under The Doctrine Of Equivalents

The above analysis also mandates a similar result under the doctrine of equivalents. Under the doctrine of equivalents, patent infringement is determined by inquiring as to whether the accused device contains "elements identical or equivalent to each claimed element of the patented invention." Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, 19 (1997). To make an equivalence determination, a court applies the "insubstantial differences" test and the "function-way-result" test. *Id*. Applying either test, the determination of equivalence is a question of fact. *See* Laitram Corp. v. Morehouse Indus., Inc., 143 F.3d 1456, 1464 (Fed.Cir.1998). In a doctrine of equivalents analysis, each element or limitation of a claim must be analyzed for infringement, rather than the accused device as a whole. *See Warner-Jenkinson,* 520 U.S. 18.

In its briefs and at oral argument, Black & Decker presented only an abbreviated argument for infringement under the doctrine of equivalents. Black & Decker's primary contention is that the Sunbeam steamers infringe the limitations of Claim 1 and 6 because they perform the same function as the patented invention, in the same way, accomplishing the same result.

While it is true that the function of the Sunbeam steamers is to steam food, the way in which that function is accomplished is substantially different from the claims in the '753 patent. As noted previously, the Sunbeam steamers heat liquid by intermittently draining water from the reservoir into a flow-through heating device located underneath the bottom surface of the reservoir. This is a substantially different way to accomplish the same result-steaming food-as the '753 patent. Therefore, the Sunbeam steamers do not infringe the

"boiling liquid reservoir" limitation of Claims 1 or 6 under the doctrine of equivalents. Because this court finds no infringement of the second limitation of Claims 1 and 6 under the doctrine of equivalents, it need not analyze the remaining claim limitations.

CONCLUSION

For the foregoing reasons, this court denies plaintiffs' motion for summary judgment, finding that the Sunbeam steamers (Model Nos. 4710 and 5710) do not infringe Claims 1 or 6 of the '753 patent. The parties are directed to appear at a status hearing at 4 p.m. on June 2, 1999, to discuss any remaining issues in this case.

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