

United States District Court,
N.D. California.

ACCO BRANDS, INC., dba Kensington Technology Group,
Plaintiff.

v.
MICRO SECURITY DEVICES, INC., dba PC Guardian,
Defendant.

No. C 00-2296 SI

June 12, 2001.

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CLAIM CONSTRUCTION ORDER

ILLSTON, J.

On June 6, 2001, the Court heard argument on claim construction for Claim 10 of U.S. Patent No. B1 5,502,989. Having considered the arguments of counsel and the papers submitted, the Court hereby construes Claim 10 as set out below.

BACKGROUND

Plaintiff, Acco Brands Inc., doing business as Kensington Technology Group ("Kensington"), filed an action alleging patent infringement in violation of 35 U.S.C. s. 271 against Micro Security Devices, Inc., doing business as PC Guardian ("PC Guardian"). Kensington claims that PC Guardian is directly infringing, contributorily infringing and inducing others to infringe Kensington's Patent No. 5,502,989 and Reexamination Certificate No. B1 5,502,989 ("the '989 patent") by making, using, offering to sell and selling computer security devices incorporating at least one of the '989 patent claims. The issue currently before the Court is the construction of disputed elements of Claim 10 of the '989 patent.

LEGAL STANDARD

Proper construction of patent claims is to be made by the trial court as a matter of law. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). In determining the proper construction of a claim, the Court begins with the intrinsic evidence of record, consisting of the claim language, the patent specification, and, if in evidence, the prosecution history. *Markman*, 52 F.3d at 979 (citing *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558,

1561 (Fed.Cir.1991)). "The appropriate starting point ... is always with the language of the asserted claim itself." *Comark Communications Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed.Cir.1998). Accordingly, although claims speak to those skilled in the art, in construing a claim, claim terms are given their ordinary and accustomed meaning unless examination of the specification, prosecution history, and other claims indicates that the inventor intended otherwise. *See Electro Medical Systems, S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1054 (Fed.Cir.1994). Although words in a claim are generally given their ordinary and customary meanings, a patentee is free to act as his own lexicographer provided that the patentee's special definition is clearly stated in the patent specification or prosecution history. *See Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563 (Fed.Cir.1990).

The claims must be read in view of the specification. *Markman*, 52 F.3d at 979. Yet while "claims are to be interpreted in light of the specification and with a view to ascertaining the invention, it does not follow that limitations from the specification may be read into the claims." *Sjolund v. Musland*, 847 F.2d 1573, 1581 (Fed.Cir.1988) ("This court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification."). Therefore, the specification can supply understanding of unclear terms, but should never trump the clear meaning of the claim terms. *See E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed.Cir.1988). Even "[r]eferences to a preferred embodiment, such as those often present in a specification, are not claim limitations." *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed.Cir.1988).

Finally, the Court may consider the prosecution history of the patent, if in evidence. The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution. *See Southwall Technologies, Inc. v. Cardinal JG Co.*, 54 F.3d 1570, 1576 (Fed.Cir.1995).

In most situations, analysis of this intrinsic evidence alone will resolve claim construction disputes. *See Vitronics Corp. v. Conceptronics, Inc.*, 90 F.3d 1576, 1583 (Fed.Cir.1996). Reliance on extrinsic evidence is unnecessary and improper when the disputed terms can be understood from how they are defined, even implicitly, in the specification or prosecution history. *See id.* at 1584. Judges may rely on extrinsic evidence, however, in the form of technical treatises and dictionaries at any time, "so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." *Id.* at 1585.

DISCUSSION

1. Claim 10 of the '989 Patent

Claim 10 of the '989 patent reads as follows:

10. A locking system, comprising:

[1] a portable electronic device including an exterior wall defining a security *slot*;

[2] cable means for attaching to a first object other than to the portable electronic device;

[3] a housing, proximate to said electronic device and including a slot engagement member having a slot engaging portion provided with a locking member having a *peripheral profile complementary* to preselected dimensions of said security slot to thereby permit said locking member to *extend* into said slot, said slot engagement member being *rotatable* between an unlocked position wherein said locking member is

removable from the slot, and a locked position wherein said locking member is retained within the slot;

[4] *a pin, coupled* through said housing for *extending* into said security slot proximate said slot engaging portion *when* said slot engagement member is in said locked position to thereby *inhibit* rotation of said slot engagement member to said unlocked position; and

[5] means, coupled to said housing, for attaching said cable to said housing.

See BI '989 Patent, Col. 2:14-38 (bracketed numbers and emphasis of disputed terms added).

2. Agreed Terms

The parties agree upon the construction of the phrases, "[a] locking system, comprising," "cable means for attaching to a first object other than to the portable electronic device," and, "means, coupled to said housing, for attaching said cable to said housing." See Joint Claim Construction Chart ("Claim Chart") at 1, 2, 6. At the hearing, the parties also agreed upon the construction of the term "pin" to mean "a post or peg." The Court adopts the parties' agreed constructions.

At the hearing, defendant agreed to a definition of "slot" to mean a "groove or narrow groove." Kensington's proposed definition for slot is an "opening or groove." The Court adopts defendant's definition with a modification to encompass an "opening," which is found in both defendant's and plaintiff's dictionary definitions of slot provided to the Court. See Declaration of Michael E. Dergosits ("Dergosits Decl.") Exhs. P, Q; Kensington's Appendix of Definitions in Support of its Claim Construction ("Appendix"), Tab 1. Clause 1 is, therefore, construed as: "A portable electronic device including an exterior wall defining a security slot (slot-"an opening, groove, or narrow groove")."

3. The Housing Limitation

[3] a housing, proximate to said electronic device and including a slot engagement member having a slot engaging portion provided with a locking member having a *peripheral profile complementary* to preselected dimensions of said security slot to thereby permit said locking member to *extend* into said slot, said slot engagement member being *rotatable* between an unlocked position wherein said locking member is removable from the slot, and a locked position wherein said locking member is retained within the slot.

A. Peripheral profile

Kensington argues that the term "peripheral profile" should be given its ordinary and accustomed meaning. Kensington relies on Webster's Third New International Dictionary, 1993 ("Webster's Third"). According to Webster's Third, "peripheral" is defined as "of, relating to, or forming a periphery," and "periphery" is defined as "the external boundary or surface of any body." See Appendix, Tab 1. Therefore, Kensington argues that "peripheral profile" should be defined as "of, relating to, or forming the external boundary or surface of any body." See Kensington's Brief in Support of Claim Construction ("Pl.Brief") at 9.

Kensington's proposed claim construction would incorporate this definition as follows: "having an external boundary or surface profile." See Claim Chart at 3. PC Guardian does not provide a construction for "peripheral profile," and does not object to Kensington's proposed definition of "peripheral profile." The Court adopts Kensington's definition for this term and construes "peripheral profile" as:

having an external boundary or surface profile.

B. Complementary

PC Guardian contends that "complementary" should be defined as "fill up or complete." *See* Claim Chart at 3. To support its construction, PC Guardian relies on the specification of the '989 patent. *See* '989 Patent Col. 8:65-9:1 ("As previously described with reference to prior embodiments of the invention, the peripheral dimensions of the crossbar member conform closely to the internal dimensions of slot 252."). FN1 Defendant also cites to the prosecution history where, during reexamination, the Examiner rejected Claim 10 of the '989 patent as being unpatentable in part due to prior art. *See* Dergosits Decl., Exh. K para. . 5-6. In response to this rejection, Kensington argued that, "[t]he locking member [of the Jacobi invention] is not complementary to the round bore as it must be titled to be inserted into the slot." *Id.*, Exh. L p. 19. The Examiner rejected Kensington's argument that the Jacobi locking member was not complementary and found that, "'[c]omplementary' as defined in applicants' invention requires that the locking member be some measurable degree smaller than the slot to allow for some amount of clearance between the locking member and the slot...." *Id.*, Exh. M para. , 17-18.

Kensington argues that the Court should adopt the Examiner's definition of "complementary." *See id.* Kensington also argues that "complementary" is used in the claim in conjunction with the phrase "preselected dimensions of said security slot," and that preselected should be given its ordinary and customary meaning.

The Court agrees with the definition of "complementary" provided by the Examiner where the locking member must be some measurable degree smaller than the slot to allow for some amount of clearance between the locking member and the slot. *See* Dergosits Decl., Exh. M para. . 17-18. If the locking member "completed" or "filled up" the security slot, as PC Guardian proposes, the insertion and removal of the locking member might "be impracticable if not impossible because of friction." *Id.* p. 18.

The Court also agrees that the "preselected dimensions" of this element requires only that the "peripheral profile" of the locking member be complementary to certain dimensions of the slot to permit the locking member to extend into that slot. The Court rejects any reliance on the specification's description of the preferred embodiment whose locking member "conforms closely" to the internal dimensions of the slot, as an impermissible attempt to read limitations from the specification into the claims. *See, e.g.,* Laitram Corp. v. NEC Corp., 163 F.3d 1342, 1348 (Fed.Cir.1998). The language of the claim itself does not require that the locking member conform closely or fill up the internal dimensions of the slot.

The term "complementary," therefore, is defined as follows:

that is some measurable degree smaller than preselected dimensions of said security slot

C. Rotatable FN2

Kensington argues that the word "rotatable" is used in its ordinary and accustomed meaning and, therefore, the Court should adopt the Webster's Third definition of "rotatable" which is "capable of being rotated about an axis or a center." *See* Kensington's Brief at 9; Appendix, Tab 2. PC Guardian contends that "rotatable" should be limited to mean "only rotation about the longitudinal axis of the slot engagement member, and cannot mean rotation about a transverse axis of the slot engagement member." *Def. Resp.* at 20. This narrowed definition, PC Guardian argues, is compelled by the written description requirement of 35 U.S.C. s. 112 para. 1 and the '989 patent's prosecution history.

35 U.S.C. s. 112 para. 1 requires that a specification contain "a written description of the invention." "To fulfill the written description requirement, the patent specification 'must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.' In re Gosteli, 872 F.2d 1008, 1012 (Fed.Cir.1989). An applicant complies with the written description requirement 'by describing the invention, with all its claimed limitations.' Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997)." Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473, 1479 (Fed.Cir.1998).

As PC Guardian points out, claims should be construed, where possible, to uphold their validity. *See, e.g.,* Wang Labs. v. America On-Line, Inc., 197 F.3d 1377, 1383 (Fed.Cir.1999) ("the claims are not properly construed to have a meaning or scope that would lead to their invalidity for failure to satisfy the requirements of patentability"). PC Guardian argues that "rotatable" must be limited to encompass only rotation about the longitudinal axis as demonstrated in Figures 14 and 15 of the '989 patent, because if the term is construed to encompass other types of rotation, including rotation about a transverse axis, the claim would be invalid under s. 112 para. 1. The s. 112 para. 1 issue arises because nowhere in the '989 patent did Kensington describe a way to lock or unlock the slot engagement member in the security slot by rotation about any axis other than the longitudinal axis. *See* Def. Resp. at 20. *See* Gentry Gallery, 134 F.3d 1473; Wang Labs., 197 F.3d 1377; Lockwood v. American Airlines, Inc., 107 F.3d 1565 (Fed.Cir.1997).

The Court, at the claim construction stage, rejects PC Guardian's s. 112 para. 1 argument and finds the case law cited by defendant distinguishable. In *Gentry Gallery*, the Federal Circuit found that certain claims were invalid under s. 112 para. 1 because they did not limit the location of the adjustment controls of a sectional sofa to the sofa's console as disclosed in the specification. While the plaintiff argued that it should not be limited to the preferred embodiment disclosed in the specification, the Court found that such limitation was required where "the original disclosure clearly identifie[d] the console as the only possible location for the controls," no variation was suggested in the disclosure, and the "only discernable purpose for the console [wa]s to house the controls." *Id.* at 1479. Thus, location of the controls in the console was an "essential element" of the invention and "locating the controls anywhere but on the console is outside the stated purpose of the invention." *Id.* Viewing the disclosure in its entirety, the Court found that the disclosure limited the breadth of the claims. *Id.*

This case, however, does not present the same facts. The '989 disclosure does not specifically identify rotation along the longitudinal axis the only possible form of rotation and construing the term "rotation" to encompass rotation beyond the longitudinal axis would not exceed the defined purpose of the invention. Because the disclosure does not "unambiguously" limit the type of rotation, this case is distinguishable from *Gentry Gallery*.

In *Wang Labs*, the plaintiff claimed that the term "frame" encompassed both a character-based protocol and a bit-mapped protocol. The district court found that the claim encompassed only the character-based protocol because the specification was limited to character-based protocols, and because the prosecution history supported that limitation. The Federal Circuit affirmed, finding that the only system "described and enabled" in the specification used a "character-based" protocol. Wang Labs., 197 F.3d at 1382. Not only did the specification fail to enable the use of a bit-mapped protocol, it was not disputed that the patentee had not been able to implement a bit-mapped protocol in the system. In light of the fact that the only subject matter described and enabled in the specification was "the invention itself," and not simply a preferred example, and the prosecution history specifically supported the finding that the invention was directed to a character-based protocol, the court limited the claims to the character-based protocol disclosed in the specification. *Id.* at 1383-84. In this case, however, there is no indication in the specification that the type of rotation

disclosed in the preferred embodiment is necessary for the invention, or *is* the invention itself as opposed to simply a preferred type of rotation. Moreover, PC Guardian does not make an enablement argument, as presented in *Wang Labs*, but limits its challenge to the written description requirement of s. 112 para. 1.

Finally, *Lockwood* dealt with whether each application in a chain of applications disclosed the features claimed in a later application, to entitle the later application to the filing date of an earlier application. *Lockwood*, 107 F.3d at 1571-72. The Court found that where two of the three intervening applications failed to maintain continuity and contain all the necessary disclosures, the later patent was not entitled to the earlier filing date. *Id.* The issues presented in this case, however, do not implicate the continuity of disclosures from related patents. *Lockwood*, therefore, is inapposite. FN3

In addition to its s. 112 argument, PC Guardian also asserts that a narrow construction of "rotatable" is compelled by arguments Kensington made during the reexamination prosecution. In response to a rejection of Claim 10 based in part on the Jacobi patent, Kensington argued that the Jacobi locking member "is not complementary to the [security slot] as it must be tilted to be inserted into the slot." *See Dergosits Decl.*, Exh. L p. 19. Because the Jacobi locking member is tilted by transverse rotation in order to be inserted into the security slot, PC Guardian asserts that Kensington's statement to the Examiner disclaims coverage of a locking member that rotates transversely.

However, the response submitted by Kensington was directed to the "complementary" element of Claim 10 and not the "rotatable" element. Because this discussion was not directed to the element at issue, Kensington cannot be said to have disclaimed a definition of a locking member that rotates on a transverse axis.

As such, the Court concludes that the term "rotatable" should be construed as:

capable of being turned about an axis or a center.

Therefore, the Court defines the housing limitation in full as follows:

a housing, proximate to said electronic device and including a slot engagement member having a slot engaging portion provided with a locking member having an external boundary or surface profile that is some measurable degree smaller than preselected dimensions of said security slot to thereby permit said locking member to extend into said slot, said slot engagement member being capable of being turned about an axis or a center between an unlocked position wherein said locking member is removable from the slot, and a locked position wherein said locking member is retained within the slot. ("Extend" being an active verb).

4. The "Pin" Limitation

[4] a pin, coupled through said housing, for extending into said security slot proximate said slot engaging portion when said slot engagement member is in said locked position to thereby inhibit rotation of said slot engagement member to said unlocked position.

A. Coupled through the housing

PC Guardian contends that to be "coupled through the housing" the pin must be a structure separate and

apart from the housing and removably attached thereto. According to PC Guardian, the "separate and apart" construction is supported by Figures 14 and 15 in the specification. Figure 14 shows the pin as a screw, element 230, that is separate from the housing and removable therefrom. *See* '989 Patent. Similarly, Figure 15 shows pin member 270, which is a structure separate and apart from the housing and removably attached thereto. *Id.* PC Guardian also relies on the prosecution history where the Examiner rejected Claims 1, 3, 4, 6, 8, and 9 under s. 102(b) as being anticipated by the Schou patent, noting that in Schou the slot engagement member is turned into the locking position "prior to insertion" of the pin. *See* Dergosits Decl., Exh. K. p.2. In response, Kensington argued that the key in Schou, which is separate and apart and removably attached to the housing, corresponds more precisely to the pin in the '989 patent as it extends through the housing. *Id.*, Exh. L. p.6. Additionally, the Examiner rejected Claims 1-5 under the French Patent '740 which used a pin separate and apart from the housing. *Id.*, Exh. K. p.3. Kensington responded to the rejection under the French patent by arguing that the '989 patent required the pin to be coupled through the housing, but the French Patent figures all showed the pin "exterior" to the housing. Therefore the French patent with the exterior pin could not be prior art to Kensington's patent. *Id.*, Exh. L. p. 10.

PC Guardian argues that this prosecution history demonstrates that Kensington expressly disavowed an interpretation of pin "coupled through the housing" that would include a structure that is exterior to the housing, and has accepted an interpretation that the pin is separate and apart from the housing. Kensington responds that the portions of the prosecution history relied on by PC Guardian address Claims 1, 3, 4, 6, 8, and 9. As Claim 10 defines a different invention, Kensington argues that defendant's citations are irrelevant to Claim 10's "pin" limitation.

In addition, Kensington argues that it could not have "expressly disavowed" an interpretation of a pin that would include a structure exterior to the housing for two reasons. First, Kensington's comments in response to the French patent were not directed to the pin, but to the housing. Second, even if Kensington's comments could be attributed to the pin limitation of Claim 10, because the Examiner rejected Kensington's comments and did not rely on them Kensington is not precluded from asserting that a structure exterior the housing infringes Claim 10. *See* Dergosits Decl., Exh. M para. . 12-13 (PTO rejected Kensington's position as "untenable"); *Zenith Labs., Inc. v. Bristol-Meyers Squibb Co.*, 19 F.3d 1418, 1425 n. 8 (Fed.Cir.1994) (noting that in applying prosecution history estoppel at infringement determination stage "although actual reliance by the examiner need not be shown, if an estoppel is to rest upon argument made during the examination process, the circumstances must be such as to permit the inference that such reliance in fact occurred.").

The Court will not read the limitations present in the preferred embodiment, of a pin which is separate and apart from the housing and removably attachable thereto, into the claim language. The prosecution history cited by PC Guardian does not indicate either that the Examiner required the pin to be separate, apart and exterior to the housing for patentability or that Kensington disclaimed an interpretation that would include a pin that is not separate, apart and exterior to the housing.

B. For extending into ... when

PC Guardian and Kensington agree that the term "when" should be defined as "at or during the time that." *See* Claim Chart at 4. PC Guardian asserts that the ramification of this definition-"when" read in conjunction with "for extending" where "extending" is used as an active verb-means that the pin can only be inserted after the slot engagement mechanism is rotated to the locked position. *See* Def. Resp. at 27. PC Guardian also argues that because the pin in the '989 patent does not actually "spread or stretch forth," in

accordance with the definition of extend, the term insert should be used instead of extend. Insert, according to PC Guardian, is a more precise term which describes what actually happens to the pin in the '989 patent. Kensington responds that PC Guardian has confused the grammatical structure of the claim language, and that "extend" is not used as an active verb but refers only to a state of being of "extending."

Reading the term "extending" in conjunction with the surrounding language, including the use of the words "for" and "when," the Court finds that extending should be construed not as referring to a state of being but as an active verb. PC Guardian's suggestion that the word "insert" is more precise given the context and function of the invention and should be used instead of "extend" is rejected, as the meaning of "extend" is adequately clear when defined as an active verb and read in the context of the limitation. The Court, therefore, adopts the parties' definition of when as "at or during the time that" and finds that extend is used as an active verb.

C. Inhibit

PC Guardian contends that inhibit should be construed as "prohibiting" rotation. FN4 Kensington argues, and the Court agrees, that term "inhibit" is clear and does not need further definition. *See* Claim Chart at 4.

Therefore, the Court construes clause 4 as:

a post or peg, coupled through said housing, for extending into said security slot proximate said slot engaging portion at or during the time that said slot engagement member is in said locked position to thereby inhibit rotation of said slot engagement member to said unlocked position. ("Extending" being an active verb).

IT IS SO ORDERED.

FN1. PC Guardian refers to Webster's Seventh New Collegiate Dictionary and Webster's II New College Dictionary to support its proposed claim construction. *See* Dergosits Decl. Exhs. P.Q. These dictionary definitions are not, however, included in the exhibits for the Court's review.

FN2. In the Joint Claim Chart, PC Guardian argues that the term "extend" in the housing element should be construed as "be inserted." *See* Claim Chart at 3. Kensington asserts that "extend" refers not to an action but only to a state of being. *Id.* Neither party, however, addresses "extend" in the sections of their claim construction briefs on the housing element. Rather, the parties address the related term, "extending," in conjunction with the pin element. As discussed below, the Court construes "extending" as an active verb. Finding no reason why "extend" in the housing limitation should be defined differently than "extending" in the pin limitation, extend in the housing limitation is construed as an active verb rather than as a state of being.

FN3. On May 17, 2001, PC Guardian submitted extrinsic evidence in support of its s. 112 para. 1 written description requirement argument. The P.T.O. evidence submitted does not come from the prosecution history of the '989 patent, but from the prosecution of a PC Guardian patent covering one of the devices that Kensington claims infringes the '989 patent. The Court does not find the extrinsic evidence probative to the construction of Claim 10 of the '989 patent and will not rely on this extrinsic evidence during claim

construction.

The Court also notes that whether a patent is invalid under s. 112 para. 1 is a question of fact. The Court's discussion of PC Guardian's s. 112 challenge at this claim construction stage does not prevent PC Guardian from challenging the adequacy of the written description under s. 112 on a subsequent motion with evidence to show whether one skilled in the art would have recognized that the patentee of the '989 patent possessed the claimed invention. *See* Union Oil of California v. Atlantic Richfield Co., 208 F.3d 989, 996 (Fed.Cir.2000).

FN4. PC Guardian also contends that "rotation" as used in this element should be construed consistent with its proposed definition of "rotation" in the housing element as "being limited to rotation about the longitudinal axis." *See* Claim Chart at 4. The Court, as discussed above, rejects PC Guardian's limitation on rotation.

N.D.Cal.,2001.

ACCO Brands Inc. v. Micro Sec. Devices, Inc.

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