

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

**BUYERS PRODUCTS CO., INC,**  
Plaintiff.

v.

**WALLACE FORGE CO., INC,**  
Defendant.

**Jan. 16, 2002.**

Christopher B. Fagan, Richard M. Klein, Fay Sharpe, David B. Cupar, McDonald Hopkins, Mark E. Bandy, Rankin, Hill, Porter & Clark, Cleveland, OH, for Plaintiff.

Joseph A. Sebolt, Laura L. Beoglos, Sand & Sebolt, Canton, OH, James F. McCarthy, III, Katz, Teller, Brant & Hild, Cincinatti, OH, for Defendant.

## **ORDER**

**JAMES S. GWIN, District Judge.**

In this case, Plaintiff Buyers Products Company, Inc. ("Buyers Products") claims Defendant Wallace Forge Company, Inc. ("Wallace Forge") infringed its rights in U.S. Patent No. 6,139,043 (the "'043 Patent"). Having conducted a hearing under *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), the Court now construes the plaintiff's '043 Patent.

### **I. Legal Standard**

On December 17, 2001, the Court held a *Markman* hearing to receive the parties' arguments on claim construction of the '043 Patent. The Court grounds its construction of the claims in the relevant documents in the record and considers the arguments made by the parties at hearing.

A determination of infringement requires a two-step analysis. First, the Court must construe the meaning and the scope of the claims the patent protects, without regard to the accused product. *See* *Bai v. L & L Wings, Inc.*, 160 F.3d 1350, 1353 (Fed.Cir.1998); *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 149 F.3d 1309, 1315 (Fed.Cir.1998); *Multiform Desiccants, Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed.Cir.1998). Second, the claim as properly construed must be compared to the accused device or process. *See* *Ethicon*, 149 F.3d at 1315; *see also* *Bai*, 160 F.3d at 1353.

The first step, claim construction, is solely a question of law. The construction of a patent is exclusively the province of the court. *See* *Markman*, 517 U.S. at 383-91; *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1451 (Fed.Cir.1998). The second step poses a question of fact for the fact-finder to decide.

In construing a patent claim, the Court looks first to the three sources of intrinsic evidence of record: the patent itself, including the claims, the specification, and, if in evidence, the prosecution history. *See Genentech, Inc. v. Boehringer Mannheim GmbH*, 99 F.3d 1098, 1105 (Fed.Cir.1996).

The claim language defines the scope of the claim. A construing court does not afford the specification, prosecution history, and other relevant evidence the same weight as the claim itself, but consults these sources to give the necessary context to the claim language. *See Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1552 (Fed.Cir.1997).

In interpreting the claims and specification, the construing court interprets words "as one of skill in the art at the time of the invention would understand them." *Eastman Kodak*, 114 F.3d at 1555. In addition, "the court should also consider the patent's prosecution history ... in order to ascertain the true meaning of the language used in the patent claim." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed.Cir.1995); *see also Standard Oil Co. v. Am. Cyanamid Co.*, 774 F.2d 448, 452 (Fed.Cir.1985) ("[T]he prosecution history (or file wrapper) limits the interpretation of the claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance."). According to the court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed.Cir.2000) (en banc) *cert. granted*, 533 U.S. 915, 121 S.Ct. 2519, 150 L.Ed.2d 692 (2001), any amendment that narrows the scope of a claim for any reason related to the statutory requirements for a patent gives rise to prosecution history estoppel. *See id.* at 564. If prosecution history estoppel applies, then no range of equivalents is available for the amended claim. *See id.*

Terms used in the claim are to be given their ordinary and customary meaning "unless another meaning is specified or evident from the patent history." *Storer v. Hayes Microcomputer Prods.*, 960 F.Supp. 498, 501 (D.Mass.1997).

Reliance upon extrinsic evidence is improper when the public record-the claims, specification, and prosecution history-unambiguously defines the scope of the claims. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed.Cir.1996). Thus, the court looks to extrinsic evidence to assist in construing a patent claim only if the intrinsic evidence is ambiguous.

## **II. Construing the '043 Patent**

In this case, the Court is called upon to interpret the '043 Patent. That patent discloses a one-piece pintle hitch assembly and teaches that the hitch is integrally attached to a drawbar. Pintle hitches are used to attach tow trailers, wagons, and other equipment to a tow vehicle. Most typically, lighter duty vehicles and other applications in which a swivelling hitch is not necessary or desired would use the '043 Patent's rigid, nonswivelling structure.

The '043 Patent invention involves a pintle hitch claimed to improve over previously available hitches. Claiming the advantage of fewer parts and fewer connecting pieces, the application leading to the '043 patent described a one-piece pintle connection integrally joined to a drawbar that could be easily inserted into a receiving assembly along the underside of a vehicle. The invention describes an upper hinged jaw that pivots to connect with the lower jaw or hook.

Important to its application for a patent, the inventor FN1 of the '043 Patent described the hitch as easily attaching to the receiver assembly located along the underside of a vehicle. The application suggested that

the invention improved upon prior assemblies by allowing easy attachment to the receiver through use of a pin, in contrast to other hitches, which required assembly through the use of mounting plates and numerous bolts, fasteners, or other similar attaching materials that could loosen, break, or corrode. The '043 Patent application argued that its use of one solid piece was unique.

The '043 Patent's abstract summarizes its disclosure: "The one-piece hitch utilizes an integral drawbar that may be engaged with a conventional receiver assembly such as installed along the underside of a vehicle."

After earlier rejecting the application on obviousness grounds, the U.S. Patent and Trademark Office issue the '043 Patent on October 31, 2000. The '043 Patent describes twenty claims, three of which are independent claims. In this case, Plaintiff Buyers Products says Defendant Wallace Forge infringes claims 1, 2, 3, 5, and 6 of the '043 Patent. Claim 1 is an independent claim. Claims 2, 3, 5, and 6 are dependent claims, that is, they include the limitations described in Claim 1 together with additional elements.

Those claims, as described in the '043 Patent, are as follows:

In the claims:

1. A pintle hitch comprising

a bar having a non-cylindrical configuration and further having a distal end and a proximal end opposite from said distal end;

a lower jaw integrally formed with and nonseparable from said distal end of said bar, and extending therefrom by a neck having an upper and lower strengthening member and intermediate connecting portion;

an upper jaw hingedly attached to said distal end of said bar, said upper jaw being movable from a closed position in which a portion of said upper jaw contacts a portion of said lower jaw, to an open position in which said upper jaw is spaced from said lower jaw; wherein said proximal end of said bar has a rectangular cross section and is adapted to engage a receiver assembly.

2. The pintle hitch of claim 1, wherein said distal end of said bar defines a first aperture, said upper jaw defines a second aperture, and said upper jaw is hingedly attached with respect to said bar such that said first aperture defined in said bar is aligned, or substantially so, with said second aperture defined in said upper jaw, and said pintle hitch further comprises a pin extending into said first aperture and said second aperture thereby hingedly attaching said upper jaw to said bar.

3. The pintle hitch of claim 1 wherein said lower jaw is C-shaped.

....

5. The pintle hitch of claim 1 wherein said bar defines an aperture proximate said proximal end of said bar, said aperture adapted to receive a removable pin for securing said pintle hitch to a tow vehicle.

6. The pintle hitch of claim 1 wherein said lower jaw comprises a ball member extending from a distal end of said lower jaw.FN2

The parties dispute a limited number of the terms of the '043 Patent. The parties dispute certain terms in claims 1, 2, 3, and 6. They do not dispute other terms of the '043 Patent. As to independent claim 1 of the '043 Patent, the terms the parties dispute are: (1) "neck," (2) "upper strengthening member," (3) "lower strengthening member," (4) "a lower jaw integrally formed with and nonseparable from said distal end of said bar," (5) "contacts," (6) "an upper jaw hingedly attached to said distal end of said bar." As to claim 2 of the '043 Patent, the parties dispute: (7) the position of an aperture. Specifically the parties dispute whether the aperture is distal to the neck described in the '043 Patent. Finally, as to claim 6 of the '043 Patent, the parties dispute: (8) whether the ball member extending from a distal end of the lower jaw is a ball member integral to the lower jaw and nonremovable. Because certain of the disputed terms can be dealt with together, the Court groups the discussion of those terms. The Court now turns to the terms in dispute.

### **A. Construing "a neck having an upper and lower strengthening member and intermediate connecting portion"**

#### **1. Construing "neck"**

Plaintiff Buyers Products and Defendant Wallace Forge dispute the term "neck" as used in the '043 Patent. They also dispute the terms "having an upper strengthening member and a lower strengthening member." The construction of the term "neck" indirectly determines the position of other structures described in the '043 Patent.

In prosecuting the '043 Patent, Plaintiff Buyers Products argued that its most significant teaching was the use of a one piece structure, a structure without need for fasteners. As described in the '043 Patent abstract:

The one-piece pintle hitch avoids the use of prior art mounting plates that bolt to one another. Accordingly, the problems associated with threaded fasteners such as loosening, fracturing, and corrosion are eliminated. In addition, the one-piece pintle hitch utilizes a unique configuration along its bar portion that results in a significant reduction in weight and materials. FN3

The prosecution history of the '043 Patent aids in its interpretation. As originally submitted, the inventor argued that the one-piece structure distinguished the pintle hitch from earlier teachings. But the examiner rejected the entire application in a November 4, 1999 decision, on the grounds of anticipation and obviousness. To overcome the objection, the applicant amended independent claim 1 on January 31, 2000. With the amendment, the applicant emphasized that the application required a separate structure of a noncylindrical bar. As amended, claim 1 read in relevant part: "A bar having a non-cylindrical configuration and further having a distal end and a proximal end opposite from said distal end." FN4

In making this amendment, the applicants argued:

Amended independent claims 1 and 9 recite a pintle hitch comprising a non-cylindrical bar having a distal end and a proximal end. The non-cylindrical configuration, such as a rectangular or square cross section, precludes rotation of the bar about its longitudinal axis. *Ozheredova*, the reference cited by the Examiner, discloses a pintle hook having a cylindrical shaft, i.e. having a circular cross section, that can rotate or swivel about its longitudinal axis when connected to a receiving end. Claims 1 and 9, as amended, recite the feature of a bar having a non-cylindrical configuration, thereby clearly distinguishing the claimed subject matter from the limited disclosure of *Ozheredova*.FN5

The application's amendment to limit its disclosure to a noncylindrical configuration fared no better with the

Patent and Trademark Office. The examiner again rejected the application on the grounds of anticipation and obviousness. Despite a series of other amendments, the examiner continued to reject the application as anticipated and obvious. After receiving a final rejection notice, the applicant proposed a further amendment to change and limit the structure used to connect the distal end of the noncylindrical bar to the a lower jaw. An interview summary describes the change:

Applicants' attorneys appreciate the time and consideration extended by the Examiner during a telephonic interview held on May 3, 2000. Although no immediate agreement was reached during that interview, the Examiner indicated that consideration would be given to the following matters. In a second telephonic interview on May 8, 2000, the Examiner indicated that the present claims would be allowed if claims 1, 9, and 17 are amended to include the language "by a neck having an upper and lower strengthening member and intermediate connection portion" applicants have now amended claims, 1, 9, and 17 to include such changes.FN6

As further amended to overcome objections based upon anticipation and obviousness, the applicants amended claim 1 to describe the configuration as "a lower jaw integrally formed with and nonseparable from said distal end of said bar, *and extending therefrom by a neck having an upper and lower strengthening member and intermediate connecting portion.*"FN7

Here, Plaintiff Buyers Products argues that "the bar member of the '043 patent comprises not only the longitudinal bar, but also the neck and the optional upward or downward extensions. It is the longitudinal section of the bar (i.e. longitudinal bar 2, 102, 202, etc.), that the lower jaw is joined to by the neck and the optional extension members." But this argument runs counter to the position that Buyers Products took in prosecuting this patent. When prosecuting the patent, Buyers described the neck as a separate structure, not simply as a preferred embodiment.

In *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997), the Supreme Court described the general rule of the doctrine of equivalents: "Under this doctrine, a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." *Warner-Jenkinson*, 520 U.S. at 21. "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case." *Id.* at 24 (quoting *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609, 70 S.Ct. 854, 94 L.Ed. 1097 (1950)).

In *Warner-Jenkinson*, the Court stated concern that the doctrine of equivalents, as it had come to be applied before that decision, had "taken on a life of its own, unbounded by the patent claims." *Warner-Jenkinson*, 520 U.S. at 28-29. The Court observed that unbridled application of the doctrine conflicts with "the definitional and public-notice functions of the statutory claiming requirement." *Id.* at 29. No doubt because of that concern, the Court held that "[e]ach element contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole." *Id.* Furthermore, the Court emphasized that "[i]t is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety." *Id.*

In addition to emphasizing this "all-elements rule," the Court held that the doctrine of equivalents is constrained by "a well-established limit on nonliteral infringement, known variously as 'prosecution history

estoppel' and 'file wrapper estoppel.' " *Id.* at 30. This limit rests on the understanding that, if a patent applicant narrows the scope of patent protection by claim amendments or other actions during the proceedings before the Patent and Trademark Office to obtain a patent, the patent holder should not be allowed to argue, in a subsequent infringement action, that the disclaimed subject matter is equivalent to that which the applicant had actually claimed in its narrowing amendment.

Because prosecution estoppel typically arises after an applicant narrows a claim to avoid obviousness and anticipation rejections, *Warner-Jenkinson* cautioned that an applicant should not be able to reclaim ground relinquished in the patent prosecution. By narrowing the claim, the applicant effectively disavows a later claim that the subject matter excluded in the amendment is equivalent to that claim. *See id.* at 31 & n. 5 (citing *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 62 S.Ct. 513, 86 L.Ed. 736 (1942)).

The holding in *Warner-Jenkinson* followed the more extended discussion of prosecution history estoppel given by the U.S. Supreme Court in *Exhibit Supply*. In *Exhibit Supply*, the Court held that by making a narrowing amendment to a claim element to avoid prior art, the patentee had affirmatively abandoned any subject matter between the claim element as originally claimed and as amended, precluding any range of equivalents for that claim element: "By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference." *Exhibit Supply*, 315 U.S. at 136 (internal citations omitted). The *Exhibit Supply* Court emphasized the effect of such an amendment:

The difference which he thus disclaimed must be regarded as material, and since the amendment operates as a disclaimer of that difference it must be strictly construed against him ... It follows that what the patentee, by a strict construction of the claim, has disclaimed-conductors which are carried by the table but not embedded in it-cannot now be regained by recourse to the doctrine of equivalents, which at most operates, by liberal construction, to secure to the inventor the full benefits, not disclaimed, of the claims allowed.

*Id.* at 137 (internal citations omitted).

Proceeding en banc, the U.S. Court of Appeals for the Federal Circuit further refined the *Warner-Jenkinson* holding in *Festo*. Dealing with the doctrine of equivalents and prosecution history estoppel, the *Festo* court held that an amendment of a patent claim that narrows the scope of a claim for any reason related to the statutory requirements for a patent will give rise to prosecution history estoppel with respect to the amended portion of the claim. *See Festo*, 234 F.3d at 566. The *Festo* court further held that a "voluntary" claim amendment has the same effect as an amendment made in response to a patent examiner's rejection. *See id.* at 568. The *Festo* court also held that a claim amendment giving rise to prosecution history estoppel is a "complete bar" and precludes any invocation of the doctrine of equivalents for the amended portion of the claim. *See id.* at 574. Finally, the Federal Circuit ruled that "unexplained" amendments likewise are not entitled to any range of equivalents. *See id.* at 576.

Here, the applicants amended claim 1 to add the neck element, a clearly distinct element, to their claims. Having amended this element to secure the patent, they are foreclosed under both *Festo* and *Exhibit Supply* from claiming infringement under the doctrine of equivalents.

In amending their application to secure a patent, the applicants added "by a neck having an upper and lower strengthening member and intermediate connection portion." FN8 The applicants described the neck:

The neck 30 generally provides a transition region that connects the bar 2 and the hook 50. The neck 30 comprises an upper and a lower strengthening member 34 and 36, respectively, and an intermediate connecting portion 32 extending between the members 34 and 36.FN9

Plaintiff Buyers Products argues that the term "neck" used in the '043 Patent refers simply to a transition region *of the bar* that connects the bar portion of the hitch with the lower jaw or hook portion of the hitch. Under Buyers Products's reading, any transition region would meet the description given in the '043 Patent, if it provided an integral and nonrotatable transition between the bar and the hook and was shaped in a way that strengthened the structure.

But the application belies this. The application shows that while the neck acts as a transition between the bar and the hook, it is a distinct structure. Claim 1 describes the lower jaw as "*extending therefrom* [from the bar] ... by a neck having an upper and lower strengthening member and intermediate connecting portion." FN10 The ' 043 Patent's specification supports this understanding: "The pintle assembly 1 comprises a longitudinal bar 2, a lower hook or jaw 50, and a neck 30 extending between the hook 50 and the bar 2." FN11

The specifications also describe the neck as "a transition region that connects the bar 2 and the hook 50." FN12 If the neck is a transition region connecting the bar and the hook, the neck is distinct from the bar.

Moreover, Buyers Products's description of the structure of the neck as encompassing any strengthening shape, including a configuration without distinct upper and lower strengthening members is wrong. The '043 Patent describes the neck structure as having three distinct members: an upper strengthening member, a lower strengthening member, and an intermediate connecting portion. By using the word "member," the applicants denoted distinct components, not simply areas of a single structure. And if this were in doubt, the drawings the applicants submitted with the application make clear that the strengthening members are distinct structures. *See, e.g., Karsten v. Mfg. Corp. v. Cleveland Golf Co. , 242 F.3d 1376, 1382 (Fed.Cir.2001)* (noting that the court may use drawings when construing patent claims); *Gen. Am. Transp. Corp. v. Cryo-Trans Inc., 93 F.3d 766, 770 (Fed.Cir.1996)* (using drawings in conjunction with the patent specification to determine the meaning of disputed claim language).

In summary, the construction of the term "neck" is readily apparent from a review of the specification and prosecution history of the '043 patent. The "neck" of the claimed pintle hitch is the separate transition region that extends between the lower jaw or hook and the distal end of the bar. The neck has three necessary components. It must have an upper strengthening member; a lower strengthening member; and an intermediate connecting portion, that is, a connecting portion, between the upper strengthening member and the lower strengthening member. As described, there are no equivalents available because of prosecution history estoppel. Even were *Festo* not controlling, the Court finds that Plaintiff Buyers Products is estopped from claiming that structures lacking a distinct transition structure joining a non-cylindrical bar to a lower jaw.

## **2. Construing "having an upper and lower strengthening member and intermediate connecting portion"**

As described above, claim 1 of the '043 Patent teaches a pintle hitch having a neck that includes an upper strengthening member and a lower strengthening member.FN13 The patent application described strengthening members similarly in other embodiments disclosed in the ' 043 patent.

Plaintiff Buyers Products argues that any intermediate structure that strengthens the connection between the bar and the lower hook is the strengthening member described in claim 1. But the syntax of claim 1 disputes this. As described above, claim 1 describes three elements to the neck. If the neck itself constituted the strengthening member, there would have been no reason to describe a separate strengthening member structure. As argued by Defendant Wallace Forge, the word member connotes a distinct constituent part.

The '043 Patent specification drawings support this interpretation. In Figures 1, 2, 3, 5, 6, 7, 8, 9, and 10, the strengthening members, both upper and lower, are identified as separate components of the neck. Figure 2, a drawing of a preferred embodiment, shows the strengthening members as in an "I-beam" structure. The neck of the '043 Patent is more than a transition region. Instead, this transition region must have identifiable strengthening members located at both the upper and lower portions of that region to strengthen adjacent areas of the neck.

Left with the clear teaching that the strengthening member must be a separate component of the neck area, the Court need construe these claim elements. The '043 Patent specifications shows only one embodiment of this neck area, the embodiment shown in Figures 1, 2, 3, 5, 6, 7, 8, 9, and 10. As to each, the specifications show the neck as a flange structure, 34, that is enlarged relative to the adjacent structural components, 32. Therefore, the strengthening members are not subsumed within the transition region between the bar and the hook, as Buyers Products would have that term construed. Instead, the strengthening members must be in the upper region and lower region of the neck to add strength to the adjacent members.FN14

As the phrase "strengthening member" needs further description, the Court looks to the '043 Patent specification. In those specifications, including the drawings, the strengthening members are consistently taught to be a flange structure, larger than the adjacent connecting portion of the neck and providing structural strength in excess of the adjacent connecting portion of the neck. Having amended the application to overcome rejection as obvious and anticipated, there are no equivalents.

**B. Interpreting "lower jaw integrally formed with and nonseparable from said distal end of said bar" and "hitch of claim 1 wherein said lower jaw comprises a ball member extending from a distal end of said lower jaw"**

As one of its elements, the '043 Patent describes a one-piece assembled pintle hitch comprising of a bar, a neck, and a lower jaw. As earlier described, the applicants argued to the Patent and Trademark Office that the application taught a new structure because it avoided the use of fasteners with their attendant risk of loosening, fracturing, and corrosion found in the prior art. The parties also dispute the interpretation of the structure described in claim 6, a dependent claim that describes as an element a lower jaw member that includes a ball member.

Regarding the interpretation of these claims, the parties dispute whether the lower jaw member, including its embodiment in claim 6 with a ball member, needs to be one piece, without fasteners or bolts. Defendant Wallace Forge argues that the lower jaw must be integral and nonseparable from the bar. Wallace Forge also argues that the lower jaw and the bar must form a one-piece assembly, which does not include any bolts, threaded fasteners, or threaded members.FN15

Plaintiff Buyers Products generally agrees, except it argues that while the '043 Patent forbids the use of



"bolts, threaded fasteners or threaded members" to connect the hitch with the vehicle, it does not exclude the use of such fasteners to attach the ball to the jaw.FN16

As earlier described, claim 1 of the '043 Patent describes the lower jaw element in broad terms: "a lower jaw integrally formed with and nonseparable from said distal end of said bar." FN17 The specifications describing the '043 Patent emphasize its rejection of the need for fasteners at its point of attachment of the pintle hitch to a tow vehicle through mounting plates.FN18 Thus, Buyers Products argues that it abjured bolts and nuts and other fasteners with regard the mounting plate but not with regard to other structures.

But the patent history of the '043 Patent, as cited by Defendant Wallace Forge, suggests that the lower jaw needs to be one piece and without fasteners or bolts. In the Final Action, the examiner rejected claim 6. Claim 6, a dependent claim, modifies claim 1 to specify that the "lower jaw comprises a ball member extending from a distal end of said lower jaw." FN19 The examiner rejected claim 6 as unpatentable because

It would have been obvious to one of ordinary skill in the art to have further modified the modified pintle hitch of Ozheredova '743 as modified by McCoy '594 and '142 with a duplex pintle hitch as taught by Theilen '266 to accommodate various types of trailer connections as taught by Theilen '266 (col. 1, line 29-37) and capable of towing larger more heavier trailers as taught by McCoy '142 in order to eliminate the need for multiple hitch members depending upon the trailers being towed by the user.FN20

In their "After Final Amendment and Response," the applicants argued that the pintle hitch was different from the prior art because the prior art taught a separable bar component. In this response, the applicants described the lower arm:

The collection of patents to McCoy et al. were relied upon for their teaching of using a bar having a rectangular cross section in a hitch assembly.

Applicants acknowledge that McCoy et al. teach a bar having a rectangular cross section. However, Applicants submit that in following the teachings of McCoy et al., one would also be instructed to provide a hitch assembly that was *non-integral such that the ball (or end fixture) is readily separable from the bar.*

....

Accordingly, all pending claims are readily distinguishable from, and thus patentable over, the combination of the '743 patent to Ozheredova and the '594 patent to McCoy et al. *All claims* now expressly recite that the pintle hook or lower jaw component *is integral with and inseparable from the bar component.* This configuration is entirely opposite the approach taught by McCoy et al. It is impermissible to selectively draw on only some of the teaching of McCoy et al., such as the use of a noncylindrical bar, *while ignoring other more significant teaching such as nonintegral and separable bar and ball assemblies.*FN21

As suggested by this response to the examiner's rejection, Buyers Products distinguished its application because, unlike the McCoy patents, it did not have a separable bar and ball assembly.

As described by the Federal Circuit *Festo*, "[a]rguments made voluntarily during prosecution may give rise to prosecution history estoppel if they evidence a surrender of subject matter." *Festo*, 234 F.3d at 568 (citing *KCJ Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1359-60 (Fed.Cir.2000) (concluding that "KCJ's

statements [during prosecution] reflect a clear and unmistakable surrender" of subject matter that cannot be reclaimed through the doctrine of equivalents); *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1252-53 (Fed.Cir.2000) (finding that "through [Bayer's] statements to the [Patent and Trademark Office] and the declarations it filed, Bayer made statements of clear and unmistakable surrender of subject matter," which it could not recapture through the doctrine of equivalents); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1583 (Fed.Cir.1995) ("Clear assertions made during prosecution in support of patentability, whether or not actually required to secure allowance of the claim, may ... create an estoppel."); *Tex. Instruments Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 1174 (Fed.Cir.1993) (holding that arguments made during prosecution that emphasized one feature of the invention estopped the patent holder from asserting that a device lacking that feature infringed the patent under the doctrine of equivalents).

Here, the applicant made specific statements indicating that, distinct from *McCoy* and *Thelin*, the ball and other components of the lower arm were not separable.

In sum, the Court finds that *Wallace Forge* makes the more persuasive argument with regard to the interpretation of the lower jaw and the structure described in claim 6. The Court interprets "a lower jaw integrally formed with and nonseparable from said distal end of said bar" to require that the jaw, and its components be one piece, without bolts, nuts, or other fasteners. The Court interprets claim 6 of the '043 Patent as including the structure claimed in claim 1 and additionally configured to include an integrally formed and nonremovable ball extending from the extreme end of the lower jaw projecting upward. As described in claim 6 of the '043 Patent, the ball is part of the lower jaw, and as such, the ball must be permanently attached and not removable from the lower jaw.

### **C. Construing "contacts"**

Claim 1 of the '043 Patent describes a structure with "an upper jaw hingedly attached to said distal end of said bar, said upper jaw being movable from a closed position in which a portion of said upper jaw *contacts* a portion of said lower jaw ...." FN22 The parties agree that "contacts" refers to the physical touching of the upper jaw and lower jaw. They, however, dispute what portions of the structure of the lower arm must touch the hingedly attached upper arm.

Plaintiff *Buyers Products* argues that the lower jaw may, in some configurations, include a ball member. Consistent with its argument that any ball member must be inseparable from the lower arm, Defendant *Wallace Forge* says the lower jaw must "contact" the upper jaw in a closed position. *Wallace Forge* argues that if this Court had interpreted "lower jaw" to allow the lower jaw to include items attached by bolts, threaded fasteners, or threaded members, then the lower jaw would not contact the upper jaw upon closure.

But as interpreted by the Court, any ball member must be integral to and inseparable to the lower arm. Because the ball must be of one piece with the jaw, and without bolts, nuts, or other fasteners, contact would be made by the physical touching of the upper jaw and the one-piece lower jaw, including embodiments in which the lower arm contains a ball shape.

The Court interprets "contacts" to require the actual structure of the lower jaw to contact directly the actual structural of the upper jaw in a closed position.

### **D. Construing "an upper jaw hingedly attached to said distal end of said bar" and the position of aperture in claim 2**

Claim 1 of the '043 Patent describes the invention as including "an upper jaw hingedly attached to said distal end of said bar, said upper jaw being movable from a closed position in which a portion of said upper jaw contacts a portion of said lower jaw." FN23 Regarding this element, Defendant Wallace Forge argues that it makes no sense because the claim language purportedly contradicts the drawings and specifications. The defendant says the contradiction cannot be reconciled because the specifications and drawing describe the aperture used to hinge the upper jaw in the neck area. Stated otherwise, independent claim 1 requires the upper jaw to be hingedly attached to the bar. But the drawings and some, but not all, of the specifications attach the upper jaw to the neck, which neck itself is distal to the bar.

The defendant argues that the neck and distal end of the bar are distinct components of the pintle hitch. As a result, the upper jaw cannot be described as attaching to the bar if it attaches to the neck or beyond the neck.

In response, Plaintiff Buyers Products says that this element should be interpreted to allow the upper jaw to attach to a portion of the neck or the hook. The plaintiff says the '043 Patent specification suggests this element should be interpreted to affix the upper jaw to either the lower jaw or the neck.

Interpreting this term is difficult because the '043 Patent and its specifications are inconsistent in describing the invention. Claim 1 of the '043 Patent describes the bar as "a non-cylindrical configuration and further having a distal end and a proximal end opposite from said distal end." FN24 Claim 1 further describes the lower jaw as "extending [from the bar] by a neck ...." FN25 And as described above, in the specifications, "[t]he pintle assembly comprises a longitudinal bar 2, a lower hook or jaw 50, and a neck 30 extending *between* the hook 50 and the bar 2." FN26 The specifications also describe the neck as "a transition region that *connects the bar 2 and the hook 50.*" FN27 The specifications also describe one preferred embodiment wherein welding is used. In describing this, the applicants state: "If welding is employed, a pintle hook and latch sub-assembly *may be welded to a bar* along a ridge 170 as shown in FIG. 5." FN28 By use of the phrase "to a bar," the applicants distinguished between the bar and the hook assembly. The claim and the specifications differentiate the neck from the bar. Therefore, the neck cannot be the distal end of the bar.

In contrast to these descriptions, the specifications to the '043 Patent also give conflicting descriptions of the hook attaching to the neck region:

An aperture 62 is also preferably provided *in a region of the hook 50 or neck 30* for receiving the pivot member 60. That member 60 preferably extends through or at least into both the aperture 62 in the hook 50 or the neck 30, and the aperture defined in the latch 40. The latch 40 further defines an aperture 46 along its mid-section. The aperture 46 is used in conjunction with a pin (not shown) that is used to provide a jaw locking arrangement.FN29

This specification shows, in contrast the earlier description, that the upper hook attaches to the neck. But the problem with this description is it conflicts *with the language of the claim itself*: "an upper jaw hingedly attached to said distal end of said bar." FN30

"In short, a court must presume that the terms in the claim mean what they say, and, unless otherwise compelled, give full effect to the ordinary and accustomed meaning of claim terms." Johnson Worldwide Assocs. v. Zebco Corp., 175 F.3d 985, 989 (Fed.Cir.1999); *see also* Gart v. Logitech, Inc., 254 F.3d 1334, 1343 (Fed.Cir.2001) ("[The court cannot] improperly add a limitation appearing in the specification and the drawings, but not appearing in the unambiguous language of the claim."); Intervet Am., Inc. v. Kee-Vet

Labs., Inc., 887 F.2d 1050, 1053 (Fed.Cir.1989) (noting that "courts cannot alter what the patentee has chosen to claim as his invention, that limitations appearing in the specification will not be read into claims, and that interpreting what is meant by a word in a claim is not to be confused with adding an extraneous limitation appearing in the specification").

Plaintiff Buyers Products argues the bar member of the '043 patent comprises not only the longitudinal bar, but also the neck and the optional upward or downward extensions. Claiming that specifications contrary to this interpretation are only discussions of preferred embodiments, Buyers Products says that contrary statements in the specifications should simply be ignored. In interpreting such unclear drafting of claims, the specifications are properly used to interpret the claims. *See* Hoechst Celanese Corp. v. BP Chemicals Ltd., 78 F.3d 1575, 1581 (Fed.Cir.1996) ("We share the district court's view that it is unlikely that an inventor would define the invention in a way that excluded the preferred embodiment, or that persons of skill in this field would read the specification in such a way.")

Buyers Products seeks to enforce a patent claim and then seeks an interpretation of that claim inconsistent with the language chosen for the claim. In *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 63 S.Ct. 165, 87 L.Ed. 232 (1942), the Court discussed the need for definiteness in the patent law:

The statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field.

*United Carbon Co.*, 317 U.S. at 236.

Plaintiff Buyers Products shows no construction of this term that does not do violence to the specifications of the '043 Patent describing the bar as separate structure from the neck. More important, Buyers Products's construction does violence to the claim language. Stating again, claim 1 says:

a lower jaw integrally formed with and nonseparable from said distal end of said bar, *and extending therefrom by a neck* having an upper and lower strengthening member and intermediate connecting portion.FN31

This claim requires that the lower jaw extend from the distal end of the bar by a neck. The neck is, therefore, not a part of the bar. Instead, the neck is the intermediate connecting portion of the pintle hitch between the distal end of the bar and the lower jaw. To like effect, the upper jaw cannot be attached to the neck because the neck is a distinct structure and claim 1 requires that the aperture used to affix the upper jaw be located in the distal end of the bar, that is, to the right of the neck.

For these reasons, the Court interprets "an upper jaw hingedly attached to said distal end of said bar" to require that the upper jaw be attached to the distal end of the bar, and the bar does not include the neck. For like reasons, the Court interprets claim 2 of the '043 Patent to require the aperture described in that claim is at the distal end of the bar.

The Court so construes the '043 Patent.

FN1. Thomas A. Gries and Mark J. Saltzman invented the '043 Patent and then assigned it to Buyers Products.

FN2. U.S. Patent No. 6,139,043 (issued Oct. 31, 2000) at cols. 8-9 [hereinafter '043 Patent].

FN3. *Id.* at Abstract.

FN4. *Id.* at col. 8, ll. 32-34.

FN5. Doc. 40, Exh. B at BPC 5315.

FN6. *Id.* at BPC 5342.

FN7. '043 Patent, *supra* note 2, at col. 8, lines 35-38 (emphasis added).

FN8. *Id.* at col. 8, ll. 36-37.

FN9. *Id.* at col. 3, ll. 53-57. January 16, 2002

FN10. *Id.* at col. 8, ll. 36-38.

FN11. *Id.* at col. 3, ll. 32-34; *see also id.* at col. 5, ll. 14-17; col. 5, ll. 55-57; col. 6, ll. 18-21.

FN12. *Id.* at col. 3, ll. 52-53.

FN13. *See id.* at col. 3, ll. 54-57; col. 5, ll. 20-23.

FN14. Defendant Wallace Forge shows evidence that transition structures were taught and used before the application leading to the ' 043 Patent. This prior art shows pintle hitches with intermediate regions between the area of attachment and the area of the hook. From this Wallace Forge argues that the flanged strengthening members was the new teaching that let to the issuance of the '043 Patent.

FN15. '043 Patent, *supra* note 2, at col. 2, ll. 53-63.

FN16. Doc. 47 at 4.

FN17. Id. at col. 8, ll. 35-39.

FN18. The '043 Patent described the principal concern:

Moreover, there are significant safety concerns relating to the use of currently available pintle hitch assemblies that utilize mounting plates which bolt to one another. There are hazards associated with the use of bolts or threaded fasteners. Bolts are susceptible to being under torqued during installation which may lead to the bolt(s) becoming loose, and eventually separating from the assembly. Also, bolts may fracture or otherwise fail. And, it is well known that the threads and/or the corresponding threaded fastener, i.e., the nut, may become corroded and rust, thereby further increasing the difficulty of removing and re-attaching a pintle hitch to the tow vehicle. As a result, there is a need for a pintle hitch assembly that is not susceptible to these types of safety concerns.

Id. at col. 1, ll. 40-5

FN19. Id. at col. 9, ll. 1-3.

FN20. Doc. 40, Exh. B at BPC 5332.

FN21. Doc. 40, Exh. B at 5342-44 (emphasis added).

FN22. '043 Patent, *supra* note 2, at col. 8, ll. 39-42.

FN23. Id. at col. 8, ll. 38-40.

FN24. Id. at col. 8, ll. 32-34.

FN25. Id. at col. 8, ll. 36-37.

FN26. Id. at col. 3, ll. 33-34 (emphasis added).

FN27. Id. at col. 3, ll. 53-54 (emphasis added).

FN28. Id. at col. 5, ll. 43-46 (emphasis added).

FN29. Id. at col. 4, ll. 3-11 (emphasis added).

FN30. Id. at col. 8, ll. 39-40.

FN31. Id. at col. 8, ll. 35-38.

N.D. Ohio, 2002.

Buyers Products Co., Inc. v. Wallace Forge Co., Inc.

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