

United States District Court,
E.D. Texas, Marshall Division.

IMONEX SERVICES, INC,

v.

W H MUNZPRUFER DIETMAR TRENNER GMBH.

Civil Action No. 2:01-CV-174

Oct. 25, 2002.

Michael T. McLemore, Amy E. Hawk, Sankey & Luck, Randy J. McClanahan, McClanahan & Clearman, Gregory M. Luck, Thompson & Knight, Houston, TX, Mike C. Miller, Attorney at Law, Franklin Jones, Jr., Jones & Jones, Marshall, TX, for Imonex Services, Inc.

Maria Wyckoff Boyce, Baker Botts LLP, Houston, TX, for W H Munzprufer Dietmar Trenner GMBH, Alliance Laundry Systems LLC, American Dryer Inc., Maytag Corporation, The Dexter Company.

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Bruce W. Slayden, II, R. William Beard, Jr., Baker Botts LLP, Austin, TX, for American Dryer Inc., The Dexter Company.

ORDER ON CLAIM CONSTRUCTION

T. JOHN WARD, District Judge.

The court issues this order to resolve the claim construction issues remaining in this case.

1. Introduction.

The plaintiff, Imonex Services, Inc. ("Imonex") sued the defendants for infringement of two United States Patents, Nos. 4,911,280 ("the '280 patent") and 5,988,349 ("the '349 patent"). The patents-in-suit are directed toward coin separator/rejector systems that include a plurality of coin races that are disposed in a coin separator or rejector body. '280 patent, Abstract; '349 patent, Abstract.

The parties have filed claim construction briefs. The briefing narrowed the issues for resolution, and the parties later filed a joint claim construction and pre-hearing statement (# 108). The joint claim construction

and pre-hearing statement also narrowed the disputed terms the court must construe. FN1 The parties waived the right to an oral hearing; therefore, the court rules on the matter based on the parties' submissions.

FN1. The court commends the parties on their efforts.

2. Legal principles relevant to claim construction.

"A claim in a patent provides the metes and bounds of the right which the patent confers on the patentee to exclude others from making, using or selling the protected invention." *Burke, Inc. v. Bruno Indep. Living Aids, Inc.*, 183 F.3d 1334, 1340 (Fed.Cir.1999). Claim construction is an issue of law for the court to decide. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed.Cir.1995)(en banc), *aff'd*, 517 U.S. 370 (1996).

To ascertain the meaning of claims, the court looks to three primary sources: the claims, the specification, and the prosecution history. *Markman*, 52 F.3d at 979. Under the patent law, the specification must contain a written description of the invention that enables one of ordinary skill in the art to make and use the invention. A patent's claims must be read in view of the specification, of which they are a part. *Markman*, 52 F.3d at 979. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. *Id.* "One purpose for examining the specification is to determine if the patentee has limited the scope of the claims." *Watts v. XL Sys., Inc.*, 232 F.3d 877, 882 (Fed .Cir.2000).

Nonetheless, it is the function of the claims, not the specifications, to set forth the limits of the patentee's claims. Otherwise, there would be no need for claims. *SRI Int'l, v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed.Cir.1985)(en banc). The patentee is free to be his own lexicographer, but any special definition given to a word must be clearly set forth in the specification. *Intellicall, Inc. v. Phonometrics*, 952 F.2d 1384, 1388 (Fed.Cir.1992). And, although the specifications may indicate that certain embodiments are *preferred*, particular embodiments appearing in the specification will not be read into the claims when the claim language is broader than the embodiments. *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1054 (Fed.Cir.1994).

3. Discussion.

After a review of the claims, specifications, and file history, together with the parties' briefs on these issues, the court issues the following constructions to the terms contained in the joint claim construction and pre-hearing statement that remain for interpretation.

A. Primary coin race.

The parties first dispute the meaning of the term "primary coin race." The court construes the term "primary coin race" to mean the first in a series of coin tracks along which coins roll or slide. The plaintiff suggests that the court should construe "primary coin race" to mean the first in a series of coin tracks along which coins *introduced through the inlet coin portal* roll or slide. The court rejects that construction because it adds limitations not found in the disputed terms. To the extent other language of any claim requires that limitation, then such other language would mandate that the coins be introduced through the inlet coin portal. *E.g.*, '280 Patent, claim 1 (requiring both inlet portal and downwardly inclined primary coin race adapted to receive coins from the portal).

B. Secondary coin race.

For substantially the reasons expressed above, the court construes "secondary coin race" to mean the second in a series of coin tracks along which coins roll or slide.

C. Vertically disposed attitude.

The court construes "vertically disposed attitude" to mean the substantially upright posture of a coin which is mainly supported by rolling on its outer circumference or rim. The defendants assert that the court should adopt that definition, with the additional limitation "where the coin does not topple, drop (fall), or tumble." The court has reviewed carefully the prosecution history and is not persuaded that the defendants' proposed limitation is appropriate as relates to the term in issue. Therefore, the court adopts the plaintiff's proposed construction.

D. Coin deflecting protrusion.

The court construes "coin deflecting protrusion" to mean a surface which extends or juts into the primary coin race so as to engage each coin as the coin proceeds downwardly in the primary coin race. The court rejects the defendants' argument that the surface must additionally be a "bulging surface" as redundant of a surface which extends or juts into the primary coin race.

E. Curvilinear protrusion

For substantially the reasons expressed above, the court construes "curvilinear protrusion" as a surface which extends or juts into the primary coin race and is curved on its upstream surface to contact each coin as it moves down said primary coin race.

F. Means to maintain the coins passing through the aperture in a generally vertically disposed, on-edge attitude.

In this means-plus-function element, the parties agree on the function, but disagree on the corresponding structure. The function is "to maintain coins passing through the aperture in a generally vertically disposed, on-edge orientation." The plaintiff contends that the structure is the combination of the "protrusion" (27, 274) and the tolerance of the primary coin race, and equivalents. The defendant contends that the corresponding structure is the deflecting shoulder (26).

The court rejects both proposed constructions. Contrary to the plaintiff's argument, the "protrusion" serves to *direct* the coin through the aperture, but the specification makes plain that it is the combination of the lower flange (38) and the deflecting structure (26) extending from the wall of the second coin race that maintains the coin (once directed) in a generally vertically disposed, on-edge orientation. See '280 patent, Col. 10, ll. 3-12. ("[t]he lower flange 38 is preferably drawn only partially across the aperture 30 in order to properly align the smaller coin 6A in a plane substantially parallel to the secondary coin race 20. *In such a fashion, the coin 6A maintains an on-edge orientation as it negotiates the transition from the primary coin race 10 to the secondary coin race 20.* Maintenance of such an on-edge orientation greatly reduces the width necessary in the rejector body 1 while greatly enhancing overall operational efficiency.") (emphasis added). After the protrusion directs the coin into the aperture, the coin encounters the deflecting shoulder. The deflecting shoulder 26 "is designed to impart a smooth change of direction in the coin 6A *and to assure its*

vertical disposition as it now travels down the secondary race 20." '280 patent, ll. 15-17. While the tolerances or dimensions of the primary and secondary coin races serve to maintain the coins in an on-edge orientation, these tolerances do so while the coin is traveling through the races. The claim element at issue, however, is not concerned with the maintenance of the coin in an on-edge orientation while the coin is traveling through either of the coin races. Instead, the claim element deals with the means for maintaining the on-edge orientation, while the coin is moving *through the aperture* from the primary coin race into the secondary coin race. The structure which provides the means to maintain coins passing through the aperture in a generally vertically disposed, on-edge orientation is the combination of the partial lower flange (38) and the deflecting shoulder (26) and equivalents. 35 U.S.C. s. 112 para. 6.

The defendants urge in their brief that a definition of the corresponding structure to include both the partial lower flange (38) and the deflecting structure (26) and equivalents would render dependent claim 26 partially redundant. Claim 26 depends from claim 24. The defendants rely on the doctrine of claim differentiation and assert that dependent claim 26 adds the additional limitation of a flange located at the bottommost portion of the primary coin race. The argument goes that the portion of claim 26 that includes the additional limitation of a second flange at the bottom of the primary coin race would have been unnecessary if the structure which corresponds to the function set forth in independent claim 24 already included a lower flange.

Although it is a close question, the court is not persuaded by this argument, given the clarity with which the specification speaks. The doctrine of claim differentiation is not a hard and fast rule. If the claim language, read in conjunction with the specification and prosecution history admit only one construction, the court must adopt it. *O.I. Corp. v. Tekmar Co., Inc.*, 115 F.3d 1576, 1581 (Fed.Cir.1997)("[a]lthough the doctrine of claim differentiation may at times be controlling, construction of claims is not based solely upon the language of other claims; the doctrine cannot alter a definition that is otherwise clear from the claim language, description, and prosecution history"); *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1567 n. 15 n. 15 (Fed.Cir.1990) (the doctrine of claim differentiation "cannot overshadow the express and contrary intentions of the patent draftsman"). In this case, the specification is very plain that the relevant structure is the combination of a partial lower flange and the deflecting shoulder which together perform the function of maintaining an on-edge orientation while the coin passes through the aperture. For these reasons, the court is persuaded that the structure corresponding to the recited function is the partial lower flange (38) and the deflecting shoulder (26) and equivalents. 35 U.S.C. s. 112 para. 6.

G. Means for maintaining said smaller coins in a generally one-edge orientation as they move through the aperture into the secondary coin race.

The court construes the function to mean "for maintaining said smaller coins in a generally one-edge orientation as they move through the aperture into the secondary coin race." For substantially the reasons expressed above, the corresponding structure is the partial lower flange (38) and the deflecting shoulder (26) and equivalents.

As to this means-plus-function limitation, the defendants suggest that the structure should be limited to the partial lower flange (38). They point to claim language which recites "said *aperture including* means for maintaining said smaller coins in a generally one-edged orientation as they move through the aperture into the secondary coin race." (emphasis added). According to the defendants, the aperture must "include" the means, and, in this case, the partial lower flange is the only structure included in the aperture that maintains the smaller coins in an on-edged orientation. Literally speaking, though, an aperture is a form of an

opening. In the context of these patents, it is the configuration of the physical structure surrounding the entrance to the opening (or aperture) and the structure found at the exit of the aperture that maintains the on-edge orientation of the coins. These physical structures are the partial lower flange (38) and the deflecting shoulder (26) and equivalents.

H. Means for redirecting the coins of at least a selected minimum diameter that are aligned with the aperture and for retaining said coins in the primary race while maintaining said coins in a substantially vertical on-edge orientation.

The court construes the function to be "redirecting the coins of at least a selected minimum diameter that are aligned with the aperture and for retaining said coins in the primary race while maintaining said coins in a substantially vertical on-edge orientation." The corresponding structure is the upper flange 140, 40 and equivalents.

So **ORDERED** and **SIGNED** this *24th* day of October, 2002.

E.D.Tex.,2002.

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