

United States District Court,
W.D. Washington, at Seattle.

AMERICAN PILEDIVING EQUIPMENT, INC., a corporation,
Plaintiff.

v.

INTERNATIONAL CONSTRUCTION EQUIPMENT, INC., a corporation,
Defendant.

No. CV-02-1416P

Feb. 26, 2003.

Craig J. Madson, Madson & Austin PC, Robert S. Rapp, Madson & Metcalf, Salt Lake City, UT, John S. Riper, Stanislaw Ashbaugh LLP, Seattle, WA, for Plaintiff.

Clifford R. Jarrett, Kennedy Covington Lobdell & Hickman, Charlotte, NC, Jerry A. Riedinger, Kirstin Erika Larson, Perkins Coie, Jessica Lynn Rossman, Us Attorney's Office, Seattle, WA, for Defendant.

ORDER ON CLAIMS CONSTRUCTION OF REEXAMINED PATENT 5,609,380

MARSHA J. PECHMAN, District Judge.

This matter comes before the Court on cross motions for construction of certain claim language in American Pilediving Equipment, Inc.'s ("APE") patent, United States Patent No. 5,609,380. (Dkt. Nos. 11 and 12) Having considered the parties' Opening Briefs for Claims Construction and supporting papers, their Response Briefs and supporting papers, the Joint Statement for Claims Construction submitted by the parties, and having heard oral argument on the issues, the Court interprets the disputed language as explained below.

BACKGROUND

APE is suing International Construction Equipment, Inc. ("ICE") for patent infringement of United States Patent No. 5,609,380 (issued Mar. 11, 1997, reexamination certificate issued Sept. 12, 2000) entitled "Clamp Assemblies for Driving Piles into the Earth" (the "380 patent").

Specifically at issue before the Court is the construction of terms in independent claims 1, 8, 13, and 17 of the '380 patent. Each of these claims was amended during both the original examination of the patent application, and the reexamination. In total, there are five disputed terms. There are also claims that depend upon the construction of the four independent claims, but whose construction is not otherwise disputed.

The '380 patent relates to a clamp used in the heavy construction industry to insert or extract piles into or out of the ground. The disputed claims are reproduced below, with the disputed terms emphasized in bold

face type. The language added during reexamination is italicized, and the language removed is in heavy brackets [].

Claim 1

A clamp assembly for attaching a pile to a pile driving apparatus for inserting and/or extracting the pile, comprising:

a. a housing *comprising a front wall, a back wall, a left side wall, and a right side wall defining a household (sic, housing) passageway;*

b. a first gripping assembly rigidly attached to the *right side wall of the housing;*

c. a pivot member pivotably attached to the housing by a pivot pin, *where the pivot pin extends between the front and back walls outside of the housing passageway, part of the pivot member is located within the housing passageway, and the pivot member comprises at least one arm portion that extends through an opening in the right side wall;*

d. a second gripping assembly rotatably attached to the pivot member *such that at least a portion of the second gripping assembly is within the housing passageway;* and

e. actuating means for displacing the pivot member and the second gripping assembly such that the pile is gripped between the first and second gripping assemblies, the actuating means comprising a piston actuator having a first end rotatably connected to the housing and a second end rotatably attached to the pivot member by an actuator pin; wherein

f. as the second gripping assembly engages the pile, the second gripping assembly moves relative to the pivot member into a desired orientation relative to the pile; [and]

g. the pivot pin and the actuator pin are removed to allow removal and replacement of the second gripping assembly.

Claim 8

A clamp assembly for attaching a pile to a pile driving apparatus for inserting and/or extracting the pile, comprising:

a. a housing comprising a housing upper wall;

b. gripping means located within the housing for gripping the pile; [and]

c. **anvil means for engaging the pile should the gripping means fail to grip the pile**, the anvil means comprising an anvil plate spaced above the housing upper wall, *a lateral plate connected between the anvil plate and the housing upper wall, a plurality of front plates rigidly connected to the anvil plate, the housing upper wall, and the lateral plate, and a plurality of [vertical] back plates rigidly connected between the anvil plate [and], the housing upper wall, and the lateral plate; and a plurality of bolts for connecting the housing to the pile driving apparatus, where the bolts extend through the anvil plate at locations spaced on either side of the lateral plate and between the front and back plates; wherein the lateral plate, front plates,*

and back plates space the anvil plate from the housing upper wall to inhibit damage to the bolts if the housing upper wall is damaged.

Claim 13

A clamp assembly for attaching a pile to a pile driving apparatus for inserting and/or extracting the pile, comprising:

a. a generally rectangular housing having an upper wall, a front side wall, a back side wall, a first side wall, and a second side wall *defining a housing opening and a housing passageway into which the pile is inserted when the pile is attached to the pile driving apparatus;*

b. a fixed gripping assembly rigidly attached to an inner surface on the second side wall *at a first vertical location;*

c. a pivot member having a first end pivotably connected [to the housing] *between the front and back side walls by a pivot pin, wherein the pivot pin extends between the front and back side walls at a second vertical location that is spaced above the first vertical location, the pivot member further comprising a second end arranged outside of the housing passageway;*

d. a moveable gripping assembly rotatably connected to a second end of the pivot member by a grip member **pin *such that the movable gripping assembly is spaced on an opposite side of the housing passageway from the second side wall; and***

e. **a piston actuator *located outside of the housing passageway and having:***

i. a cylinder rotatably attached by a cylinder pin to an inner surface of the first side wall, and

ii. a rod rotatably attached to the second end of the pivot member by a rod pin; wherein

f. the pile is inserted from below into the housing between the fixed and movable gripping assemblies;

g. actuation of the piston actuator to extend the rod causes the movable gripping assembly to rotate downwards relative to the housing about an axis defined by the pivot pin towards the fixed gripping assembly to grip the pile there between; and

h. upon contacting the pile, the second gripping assembly rotates relative to the pivot member about an axis defined by the grip member pin into a desired orientation with respect to the pile.

Claim 17

A clamp assembly for attaching a pile to a pile driving apparatus for inserting and/or extracting the pile, comprising:

a. a housing comprising a housing upper wall;

b. a first gripping assembly rigidly attached to the housing *on a first side of the housing passageway;*

c. **a pivot member having a first end pivotably attached to the housing outside of the housing passageway on the first side of the housing passageway and a second end that extends outside of the housing passageway on a second side of the housing passageway, where the second side of the housing passageway is substantially opposite to the first side of the housing passageway;**

d. a second gripping assembly rotatably attached to the pivot member *within the housing passageway*,

e. **actuating means arranged outside of the housing passageway and connected to the second end of the pivot member for displacing the pivot member and the second gripping assembly such that the pile is gripped between the first and second gripping assemblies;**

f. an anvil plate; and

g. a plurality of vertical plates extending between the housing upper wall and the anvil plate; wherein

h. as the second gripping assembly engages the pile, the second gripping assembly moves *towards the first gripping assembly to grip the pile and also rotates relative to the pivot member into a desired orientation relative to the pile.*

'380 patent reexamination certificate. (APE Br., Ex. 2) (emphasis added in bold face type).

ANALYSIS

1. Sources to which the Court may look in the claims construction process

The first step in determining whether an accused device infringes a patent claim is to construe the claims to determine their scope. CAE Screenplates, Inc. v. Heinrich Fiedler GMBH & Co. KG, 224 F.3d 1308, 1316 (Fed.Cir.2000). Claim construction is an issue of law for the Court to decide. Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

In construing the claims, intrinsic evidence is considered before extrinsic evidence. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). Intrinsic evidence includes 1) the claim itself, 2) the patent specification, and 3) the prosecution history. *Id.* The specification includes the patentee's description of the best embodiment of the invention, not every possible embodiment. Claims are not limited to the embodiment disclosed in the specification. "It is well established that the preferred embodiment does not limit broader claims that are supported by the written description." Toro Co. v. White Consol. Indus, Inc., 199 F.3d 1295, 1301 (Fed.Cir.1999). The prosecution history includes the communications between the patentee and the United States Patent and Trademark Office ("PTO") during examination, including reasons for rejection by the PTO, and reasons for amendments to the claims by the patentee. Where the plain language of the claim resolves the claim construction, this Court does not need to turn to extrinsic evidence. Markman, 52 F.3d at 980.

Extrinsic evidence may include expert and inventor testimony, and learned treatises. *Id.* at 980. "Extrinsic evidence is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims." *Id.* at 981. However, "dictionaries are always available to the court to aid in the task of determining meanings that would have been attributed by those of skill in the relevant art to any disputed terms used by the inventor in the claims." Tex. Digital Sys., Inc. v. Telegenix, Inc., 308

Claim construction starts with the language of the claim itself. CAE, 224 F.3d at 1316; Vitronics, 90 F.3d at 1582. In construing claims, all words of a claim must be given meaning. Exxon Chem. Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1556 (Fed.Cir.1995). This prevents patent holders from reading language out of a claim that was intended to function to limit the scope of the claim. Further, in construing a patent claim, the plain and ordinary meaning of claim language controls unless a different meaning is expressly stated in the specification or prosecution history. Vitronics, 90 F.3d at 1582. A patentee may choose to be his or her own lexicographer to alter the ordinary meaning of a term. *Id.*

2. The Court's construction of the disputed claim language

As a point of clarification, the wall described as 52 in the specification is referred to as both the left side wall and the first side wall throughout the patent. Also, the wall described as 54 in the specification is referred to as both the right side wall and the second side wall throughout the patent. The both terms for each wall are used throughout the construction discussion.

A. Claim 1: "housing passageway"

The parties dispute the definition of the "housing passageway." APE contends that "the housing passageway is not co-extensive with the vacant space bounded by the walls, but rather is an area, smaller than that vacant space, within the housing that a pile can be clamped for driving or pulling." APE Br., Ex. 3 at 4. According to APE, the specification makes it clear that the housing passageway is an area smaller than the vacant space within the walls of the housing. '380 patent 4 :44-45 states "a passageway 56 allows the pile 22 to be inserted into the interior of the housing 30."

ICE contends that the housing passageway is "an open area having definite boundaries specifically defined by the five walls of the housing." ICE Br. at 7. ICE's interpretation requires that "the pivot pin must be physically separated from the housing passageway by at least one of the housing walls." ICE Br. at 9.

Specifically, ICE makes three contentions. First, ICE contends that the claim defines a housing as the walls defining a housing passageway. Second, ICE contends that the dictionary definition of "define" is "to mark the limits of; to determine with precision or exhibit clearly the boundaries of;" and "to make distinct in outline or features." *Webster's Third New International Dictionary* 592 (unabr., 3d ed.1986). Therefore, according to ICE, the walls of the housing are the boundaries of the housing passageway. Third, ICE contends that APE did not attempt to qualify or limit the extent of the housing passageway in the specification or in the prosecution history during both the examination and reexamination. ICE notes that this proceeding is the first time APE has asserted that the housing passageway is an area less than that bounded by the housing.

The Court adopts ICE's construction: a "housing passageway" is defined as the open space defined by the housing walls. In making this interpretation, the Court looks to the claim language read in light of the specification and the prosecution history. First, the plain language of claim 1 compels this result. The claim specifically provides the walls that define the housing passageway. That there exists some smaller area called the "housing passageway" inside is not supported by the plain language definition of "housing" and "housing passageway" in claim 1. Second, the specification does not otherwise clearly define the housing passageway. Even if there were a clear reference in the specification, claim construction cannot properly add a limitation from the specification that does not appear in the unambiguous language of the claim. Gart

v. Logitech, Inc., 254 F.3d 1334, 1342-43 (Fed.Cir.2001). This Court gives effect to the terms of the claim chosen by APE as the patentee. *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1364 (Fed.Cir.1999). It cannot rewrite patent claims. *Id.* Third, the prosecution history supports this interpretation because APE modified the claim during reexamination, adding the specific walls that define the housing and the housing passageway. The housing defines the boundaries; the housing passageway is all of the space inside.

B. Claim 8: "anvil means for engaging the pile should the gripping means fail to grip the pile"

The parties dispute when the anvil means engages the pile. APE contends that the "anvil means" may engage the pile if the gripping means fails, but does not require such contact. APE Resp. at 7. APE contends that direct contact is not necessary because the plain language doesn't call for it, and because there are situations where the pile may slip downward (such as when extracting a pile), and it may not move up toward the anvil means. The anvil means is still capable of contacting the pile, but only if it is close enough to the anvil means to start with.

ICE asserts that the anvil must directly contact the pile should the gripping means fail. APE equates "anvil means" to the term "anvil portion" of the specification of the '380 patent. ICE Br. at 11-13.

Properly construed, the Court finds that the "anvil means" should not have to necessarily contact the pile should the gripping means fail *in general*. The anvil means should contact the pile when the gripping means fail and the pile slips "up." This is the only logical construction when the claim language is read in light of the specification.

The specification supports this construction. The purpose of the anvil means is to minimize damage to the housing upper wall, and to remain unharmed if the housing upper wall is damaged. '380 patent 4 :25-31; 6 :44-47. The specification language reads "should the pile slip and contact the housing upper wall." The difficulty comes in that the claim language seems to claim that the purpose of the anvil means is to engage the pile in the event that the gripping means fail. Read in light of the specification, however, the claim means that if the gripping means fail, *and* if the pile slips up and contacts the anvil means, *then* the rest follows. The anvil means does not have to necessarily contact the pile every time the gripping means fail, only when they fail and the pile slips "up" toward the housing upper wall. Obviously, if the pile slips "down," out of the clamp, there is no danger of harm to the anvil means, so there is no requirement that the anvil means engage the pile.

In addition, the specification gives the option of placing shock absorbing material on the anvil upper wall for extra protection. The specification reads "should the pile slip, the pile will contact the shock absorbing material and will not directly contact the anvil upper wall." '380 patent 6 :63-66. The purpose of the anvil means is to protect the housing upper wall, and there is no worry of damage if the pile slips "down" instead of "up." Therefore, the "if, then" situation is the same as if there is no shock absorbing material, except that if the pile slips, *and* then if it is in a position to contact the housing upper wall, *then* the pile will contact the material instead of the wall. This supports a construction that the pile may contact the anvil means if the gripping means fail, but is not required to do so.

Finally, it is important to recognize that the "housing upper wall," in addition to being part of the housing, is part of the anvil means. '380 patent, reexamination certificate 2:5-9. The pile doesn't actually have to break through the upper housing wall in order to reach the anvil means. Therefore, the anvil means only has to engage the pile when the gripping means fail and the pile slips "up."

C. Claim 13: "a piston actuator located outside of the housing passageway and having a cylinder rotatably attached by a cylinder pin to an inner surface of the first side wall"

The parties dispute the location of the inner surface of the first side wall. APE asserts that "all surfaces of the first side wall (i.e., left side wall 52 and/or flange 94) are confined within the perimeter defined by the front wall 48 and the back wall 50 ..., all surfaces of the first side are inner." APE Br., Ex. 3 at 22-23.

ICE contends that "the surface in question is the inside surface of the first side wall that is situated within the housing passageway and is directed toward the interior of the housing." ICE Br. at 16.

The Court adopts ICE's construction that the "inner surface of the first side wall" is the surface of the first side wall interior to the housing passageway.

The Court agrees with APE's statement that the location of the inner surface of the first side wall is "manifestly clear," but disagrees with APE's construction. The Court turns to the claim language in light of the specification and the prosecution history.

The specification language provides that "the cylinder is attached by a cylinder pin to a flange rigidly extending from the left side wall." '380 patent 5 :43-45. This language does not indicate which surface of the left side wall is intended. However, the use of "inner" in the claim language indicates an interior surface rather than an exterior surface. The inner surface is that surface of the first side wall interior to the housing passageway.

The Court notes that Figure 2 appears to contradict the claim language. In looking at Figure 2, the cylinder is attached by the cylinder pin to a flange, which is rigidly attached to what appears to be the outer surface of the first side wall. The Court construes this claim based on the weight of the plain language of the claim, the specification language, and the prosecution history. In this construction, the Court affords little weight to this Figure.

Furthermore, the prosecution history supports the Court's construction. The claim language amended during prosecution is significant. "A left inner surface" was changed to "an inner surface," and "left side wall" was then later changed to "first side wall." As originally claimed, the language seems to support APE's construction of the "inner surface" being outside of the left wall but still within the front and back walls. Deleting "left" from "left inner surface" works against that construction. In the patent as issued, "inner" is directly modifying "surface ." Also, the term "inner" implies that there is an "outer" as well. Under APE's construction, all surfaces of the first side wall would be inner. That construction does not make sense.

"Left side wall" was changed to "first side wall" to clarify the position of the wall relative to the entire housing structure, not to indicate a wall different from the left side wall. Therefore, the inner surface of the first side wall is that surface interior to the housing passageway.

D. Claim 13: "a pivot member having a first end pivotably connected [to the housing] between the front and back side walls by a pivot pin, wherein the pivot pin extends between the front and back side walls at a second vertical location that is spaced above the first vertical location, the pivot member further comprising a second end arranged outside of the housing passageway"

The parties disagree as to the location of the pivot pin. APE contends that the pivot pin need only be spaced

above the fixed gripping assembly and between the front and back wall. APE Br., Ex. 3 at 21-22.

ICE again asserts that the pivot pin "must be located outside of the second side wall of the housing." ICE Br. at 7.

Properly construed, the pivot pin is located above the fixed gripping assembly, outside of the second side wall. The claim language is ambiguous because it is unclear where the "second vertical location" is located. The Court turns to the specification and prosecution history to resolve the ambiguity of the claim language.

The specification calls for the pivot arms to extend through the slots straddling the second side wall. The figures support this description as well, where the pivot arms extend through the slots and the pivot pin is located on the upper portion of those arms, outside of the second side wall. Therefore, read in light of the specification, the pivot pin is located outside of the second side wall.

The prosecution history further supports this construction. The claim originally read "connected to the housing by a pivot pin," and now reads "connected between the front and back side walls." While this claim does not state that the pin is located "outside" of the housing passageway, it does state that the "second end [is] arranged outside of the housing passageway." Also, claim 1 states that the pin is located "outside of the housing passageway." APE contends that it acted purposefully in not specifically stating "outside the housing passageway" in this claim. Although this contention, as first blush, seems to cut against locating the pin outside of the second side wall, the prosecution history reveals the strength of the Court's construction.

The attempt to read this difference as having meaning, even giving the drafter the benefit of the doubt that he knew and intended the difference, fails in light of the prosecution history. *See Laitram Corp. v. Morehouse Indus., Inc.*, 143 F.3d 1456, 1463 (Fed.Cir.1998). APE responded to the patent examiner during reexamination to overcome rejection based on obviousness in light of prior art references. APE wrote that none of the prior art references disclosed a clamp assembly where "the pile is spaced from the actuator means and/or the pivot pin by walls of the housing that define the housing passageway." ICE Br., Ex. B at 5. Further, APE wrote that "the cited references fails (sic) to disclose, teach, or suggest any type of interior wall between the pile and/or the actuator and the pivot pin." *Id.* APE asserted that the wall serves to protect the actuator means or the pivot pin during pulling or driving of the pile, substantially reducing damage. *Id.* The patent examiner then provided the reasons why claims 1, 13, and 17 were found patentable:

Claims 1, 13, and 17 recite specifics of the relative positioning of the actuator means and the pivot pin for mounting the pivot member of the claimed clamp assembly on the housing thereof. In particular, the claims recite that one or both of the actuator means and the pivot pin are located outside of the housing passageway. Such structure is not shown or suggested in the prior art.

PTO Stmt. for Reasons of Patentability, June 26, 2000. Therefore, based upon APE's representations to the PTO, the pivot pin is located outside of the second side wall.

In sum, the Court finds the claim language to be ambiguous. However, in light of the specification and the prosecution history, the Court interprets the location of the pivot pin to be outside of the second side wall.

E. Claim 17: *"a pivot member having a first end pivotably attached to the housing outside of the housing passageway on the first side of the housing passageway and a second end that extends outside of the housing passageway on a second side of the housing passageway"*

The parties dispute the location where the first end of the pivot member must be attached. Resolving this dispute requires the earlier construction of "housing passageway." APE again contends that the housing passageway is not coextensive with the vacant space bounded by the walls. Rather, APE asserts that the housing passageway is an area, smaller than that vacant space, outside of which the pivot member is attached pivotably to the housing. APE Resp. at 11.

ICE proffers the same interpretation applied to claim 1, and asserts that the same claim language used in different claims of the '380 patent must be interpreted consistently. ICE Br. at 23. Namely, ICE contends that the housing passageway is an open area having definite boundaries specifically defined by the housing structure. Therefore, the "pivot pin must be physically separated from the housing passageway by at least one of the housing walls." ICE Br. at 7 and 9.

The Court finds that the "pivot member being pivotably attached to the housing outside the housing passageway" must be attached on the outside of the first side wall, not on the inside within the housing passageway.

A housing passageway is defined in claim 1. Courts are to give a term the same construction throughout all of the claims, because claims should be read consistently, if possible. *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed.Cir.2001). In claim 17, the housing is defined as comprising a housing upper wall. In patent drafting, "comprising" is defined as "including without limitation." *See Water Techs Corp. v. Calco, Ltd.*, 850 F.2d 660, 666 (Fed.Cir.1988). A housing is a structure that defines an inside area. With just one wall, there is no inside area. Therefore, it is consistent to read the definition of housing from claim 1 as the same definition in claim 17.

Here, the claim language provides that a pivot member has its first end "... pivotably attached to the housing outside of the housing passageway on the first side of the housing passageway ..." While the claim language doesn't mention a pivot pin, that is not relevant.

In sum, the housing is defined as in claim 1. Accordingly, the housing passageway is the area defined by the housing walls, i.e., all of the space bounded by the walls. The pivot member is attached to the housing outside of the housing passageway on the first side of the housing passageway. Thus, read together for consistency, the pivot member must be attached on the outside of the first side wall of the housing structure.

CONCLUSION

Claim 1: The Court adopts ICE's construction: a "housing passageway" is defined as the open space defined by the housing walls.

Claim 8: The Court finds that the "anvil means" should not have to necessarily contact the pile should the gripping means fail *in general*. The anvil means should contact the pile when the gripping means fail and the pile slips "up."

Claim 13: The Court adopts ICE's construction that the "inner surface of the first side wall" is the surface of the first side wall interior to the housing passageway. Also for claim 13, the pivot pin is located above the fixed gripping assembly, outside of the second side wall.

Claim 17: The Court finds that the "pivot member being pivotably attached to the housing outside the

housing passageway" must be attached on the outside of the first side wall, not on the inside within the housing passageway.

The Clerk is directed to provide copies of this order to all counsel of record.

W.D.Wash.,2003.

American Piledriving Equipment, Inc. v. International Const. Equipment, Inc.

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