

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

**ACCO BRANDS, INC,**

v.

**AMERICAN POWER CONVERSION CORP.**

Civil Action No. 2:02-CV-113

**July 16, 2003.**

Otis W. Carroll, Jr, Ireland Carroll & Kelley, Tyler, TX, Henry Charles Bunsow, Howrey Simon Arnold & White, Korula T Cherian, Howrey LLP, Sean P. Hodge, Bad Address, San Francisco, CA, Sidney Calvin Capshaw, III, Capshaw Derieux, LLP, Longview, TX, for Acco Brands, Inc.

George Richard Grainger, Law Offices of Richard Grainger, Tyler, TX, Steven K. Martin, Altman & Martin, Boston, MA, William R. Grimm, Hinckley Allen & Snyder, Providence, RI, for American Power Conversion Corp.

### ***MEMORANDUM OPINION AND ORDER***

**T. JOHN WARD, District Judge.**

After considering the submissions and the arguments of counsel, the court issues the following claim construction opinion:

#### **1. Introduction.**

This is a dispute involving portable electronic device security locks. The plaintiff, Acco Brands, Inc. d/b/a/ Kensington Technology Group, brought this patent infringement suit against the defendants American Power Conversion Corporation and Kryptonite Corporation, alleging infringement of certain claims of United States Patent Nos. 6,006,557 (the "557 patent"), 6,112,562 (the "562 patent") and 6,155,088 (the "088 patent"). Each of the patents is directed toward the security of portable electronic devices.

#### **2. Law Governing 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, 116 S.Ct. 1384, 134 L.Ed.2d 577 (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 laws, 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 specification, 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 specification 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).

To assess the ordinary meaning of claim terms, a court may properly rely on dictionary definitions. The Federal Circuit recently endorsed the use of such sources in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed.Cir.2002). In that case, the court noted that "[i]t has long been recognized in the precedent of our predecessor court, the Court of Customs and Patent Appeals, that dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meaning of claim terms." *Id.* The court reasoned that such sources are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art. *Id.* at 1202-03. According to the court, dictionaries, encyclopedias and treatises "constitute unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation." *Id.* at 1203.

Several of the claim terms at issue in this case are conceded by all parties to be drafted in means-plus-function format; therefore, a discussion of the rules pertaining to such terms is appropriate. Title 35, section 112, paragraph 6 of the United States Code provides:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. s. 112, para. 6 (2000).

Claim limitations drafted pursuant to s. 112 para. 6 are commonly referred to as "means-plus-function" or "step-plus-function" limitations. Through use of means-plus-function limitations, patent applicants are allowed to claim an element of a combination functionally, without reciting structures for performing those functions. *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1364 (Fed.Cir.2000). The trade-off, however, for the use of the statutory shorthand, is that the applicant is limited to the structure disclosed in the specification and equivalents. The statute specifically provides its own rule of claim construction when it states that "such claim shall be construed to cover the corresponding, structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. s. 112 para. 6.

The defendant contends that certain claim limitations at issue in this case are drafted in means-plus-function format, despite the fact that the language of the claim does not use the word "means." Recently, in *Apex, Inc. v. Raritas Computer, Inc.*, the Federal Circuit set forth the analytical framework for deciding this question. 325 F.3d 1364, 1371-72 (Fed.Cir.2003). According to the court:

It is well settled that "[a] claim limitation that actually uses the word 'means' invokes a rebuttable presumption that s. 112, para. 6 applies. By contrast, a claim term that does not use 'means' will trigger the rebuttable presumption that s. 112, para. 6 does not apply." ... "[T]he term 'means' is central to the analysis."  
...

From a procedural standpoint, this presumption "imposes on [Raritan] the burden of going forward with evidence to rebut ... the presumption, but does not shift to such party the burden of proof in the sense of the risk of nonpersuasion, which remains throughout the trial upon the party on whom it was originally cast." ... Raritan can rebut this presumption "if it demonstrates that the claim term fails to 'recite sufficiently definite structure' or else recites a 'function without reciting sufficient structure for performing that function.'" ... This burden must be met by a preponderance of the evidence ... If the party who must bring forth evidence fails to proffer sufficient evidence to meet its burden, the presumption, either for or against the application of s. 112, para. 6, prevails.

This presumption can collapse when a limitation lacking the term "means" nonetheless relies on functional terms rather than structure or material to describe performance of the claimed function....Conversely, when a claim uses the term "means," the focus is on whether the claim term recites no function corresponding to the means or recites sufficient structure or material for performing that function....

"To help determine whether a claim term recites sufficient structure, we examine whether it has an understood meaning in the art." As an aid in making this determination, this court inquires into whether the "term, as the name for the structure, has a reasonably well understood meaning in the art," keeping in mind that a claim term "need not call to mind a single well-defined structure" to fall within the ambit of s. 112, para. 6...."[T]he fact that a particular [claim term] is defined in functional terms is not sufficient to convert a claim [limitation] into a 'means for performing a specified function' within the meaning of 112(6)."

*Apex*, 325 F.3d at 1371-72 (internal citations omitted).

Once it is determined that a particular limitation is drafted in means-plus-function form, claim construction of the limitation is a two step process. First, the court must identify the claimed function. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1324 (Fed.Cir.2001). The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations. *Lockheed Martin Corp. v. Space Sys/Loral, Inc.*, 249 F.3d 1314, 1324 (Fed.Cir.2001). It is improper to narrow the scope of the function beyond the claim language. *Id.* It is also improper to broaden the scope of the claimed function by disregarding limitations in the claim language. *Id.* General principles of claim construction govern interpretation of the claim language used to describe the function. *Id.*

After the court identifies the claimed function, the court must then determine what structure, if any, disclosed in the specification corresponds to the claimed function. *Id.* To qualify as corresponding structure, the structure must not only perform the claimed function, but the specification must clearly associate the structure with performance of the function. *Medtronic, Inc. v. Advanced Cardiovascular Systems, Inc.*, 248

F.3d 1303, 1311 (Fed.Cir.2001). The court undertakes this task from the perspective of a person of ordinary skill in the art. *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1378-79 (Fed.Cir.1999).

The determination of what constitutes corresponding structure can be difficult. Corresponding structure need not include all things necessary to enable the claimed invention to work. Corresponding structure must, however, include all structure that actually performs the recited function. *See Asyst Techs., Inc. v. Empak, Inc.*, 268 F.3d 1364, 1371 (Fed.Cir.2001). In *Asyst*, the Federal Circuit emphasized that the determination of what structure corresponds to a claim function is contingent upon the language of the claims. *Id.* at 1372.

Additional rules apply when, as in this case, the specification discloses multiple embodiments of a claimed invention. "[P]roper application of s. 112 para. 6 generally reads the claim element to embrace distinct and alternative described structures for performing the claimed function. Specifically, '[d]isclosed structure includes that which is described in a patent specification, including any alternative structures identified.' " *Ishida Co., Ltd. v. Taylor*, 221 F.3d 1310, 1316 (Fed.Cir.2000) ( *quoting* *Serrano v. Telular Corp.*, 111 F.3d 1578, 1583 (Fed.Cir.1997)). Likewise, when construing a means-plus-function claim limitation, the preferred embodiment may not limit the claim when other embodiments have been disclosed. *Id.*

"Identification of corresponding structure may embrace more than the preferred embodiment. A means-plus-function claim encompasses all structure in the specification corresponding to that element and equivalent structures." *Micro Chem., Inc. v. Great Plains Chem. Co., Inc.*, 194 F.3d 1250, 1258 (Fed.Cir.1999). When multiple embodiments in the specification correspond to the claimed function, a proper application of s. 112, para. 6 generally construes the claim element to embrace each of those embodiments. *Id.*

Finally, the defendant urges that the court may not rely on certain structure disclosed in the specification because the patentee made an election in response to the patent examiner's restriction requirement. The examiner imposed the requirement in an early office action. In response, the applicant elected without traverse to prosecute what were then claims numbered 1-5, "an embodiment of which is shown in Figs. 1-7." The defendant contends that certain figures contained in the specification of the '557 patent are drawn to unelected species and, therefore, cannot constitute corresponding structure for purposes of claim construction. This argument is based on a misreading of the Federal Circuit's decision in *Signtech USA Ltd. v. Vutek, Inc.*, 174 F.3d 1352 (Fed.Cir.1999). FN1 The court rejects it.

FN1. The defendants conceded at the claim construction hearing that *Signtech* did not support the proposition for which it was cited in the defendants' claim construction brief.

Although the case is not directly on point, *Signtech* suggests that the court should consider *all* of the structure disclosed in the patent specification to determine what constitutes corresponding structure. As explained below, this approach is not inconsistent with any purpose underlying either the examiner's restriction requirement or the doctrine of prosecution history estoppel. *See generally* *R2 Medical Systems, Inc. v. Katecho, Inc.*, 931 F.Supp. 1397, 1436 (N.D.Ill.1996). Moreover, the statute governing construction of mean-plus-function limitations directs the court to consider structure disclosed anywhere in the specification. Given the purposes of the relevant rules and the statutory directive, the court will consider the entire specification in this case.

The restriction requirement is an administrative one. Under 35 U.S.C. s. 121, and various regulations, the patent examiner has the discretion to restrict a patent application to one invention if "two or more independent inventions are claimed in one application." This requirement prevents the applicant from,

among other things, paying less fees than he would pay had he submitted separate applications for examination. R2 Medical, 931 F.Supp. at 1438; Application of Weber, 580 F.2d 455, 458 (C.C.P.A.1978). It is important to remember that the examiner in this case imposed the restriction before he made any decision on patentability.

The defendants' argument equates the election decision with prosecution history estoppel. The argument, however, overstates the effect of both the examiner's discretionary restriction decision and the applicant's decision to elect. As noted, the restriction requirement is an administrative one, and it has nothing to do with the patentability *vel non* of the invention. The doctrine of prosecution history estoppel serves a different function. During prosecution, an examiner might determine that an invention does not meet the statutory requirements for patentability and reject the claims. An applicant's arguments to the contrary, should they ultimately persuade the examiner, may inform the scope of the issued claims, depending on the context of the statements. *See, e.g.,* Advance Transformer Co. v. Levinson, 837 F.2d 1081, 1083 (Fed.Cir.1988) ("Positions taken in order to obtain allowance of an applicant's claims are pertinent to an understanding and interpretation of the claims that are granted by the PTO, and may work an estoppel as against a subsequent different or broader interpretation."). Prosecution history estoppel may prohibit the patentee from recovering claim scope surrendered during the prosecution of the patent.

Finally, the patent law mandates that when a claim limitation is drafted according to s. 112 para. 6, the "claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. s. 112 para. 6. The specification of a patent includes the written description of the invention and the drawings which accompany it. *See, e.g.,* General Foods Corp., v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1274 (Fed.Cir.1992). In exchange for drafting pursuant to s. 112 para. 6, the patent law limits the patentee to the structure disclosed in the specification. So long as the structure is otherwise "corresponding" structure, s. 112 para. 6 directs the court to include it for claim construction purposes.

In the absence of any controlling authority to the contrary, the court holds that an election of the sort present in this case does not *necessarily* serve to surrender otherwise corresponding structure. Depending on the record in a given case, an election during patent prosecution might give rise to an estoppel. *See* R2 Medical, 931 F.Supp. at 1439 ("[i]f the record demonstrates that the Examiner restricted the species elected by Heath to a simultaneous system, then Heath's subsequent election of those claims *may* constitute an avowed understanding that those claims were directed to that subject matter.") (emphasis added). There is no indication in this record, however, that the applicant's election in response to the examiner's restriction requirement served the purpose of surrendering corresponding structure disclosed in any portion of the specification. The court therefore holds that the usual rules of claim construction applicable to means-plus-function limitations apply. The court will review the entire specification of each patent in its search for corresponding structure. The court now turns to the disputed terms of the patents-in-suit.

### **3. Discussion.**

#### **A. '557 Patent.**

##### **1. Claim 1, Element [b]: "locking means for attaching to a first object other than to the portable electronic device.**

The parties agree that this element is drafted in means-plus-function language according to 35 U.S.C. s. 112 para. 6. The parties also agree that the function is "attaching to a first object other than to the portable electronic device." The parties disagree, however, on the corresponding structure. The plaintiff argues that the corresponding structure is limited to the cable and equivalents. The defendants argue that the locking means is the combination of cable and lock (and equivalents).

The claim language all but mandates the defendants' proposed construction. To that end, the plain language of the claim indicates that the function is performed by a *locking* means. Moreover, the claimed function is "*attaching* to a first object other than to the portable electronic device." (emphasis added). Under the general rules of claim construction, the corresponding structure must include sufficient structure to perform the function of "attaching." The cable, standing alone, is insufficient to perform the function.

The intrinsic evidence also supports the defendants' argument. First, in the written description, the locking *mechanism* of the '557 patent is described as locking mechanism 30, which "includes a cable 35 and a lock 40." '557 Patent, Col. 3, ll. 63-64. The specification also states that "[l]ocking mechanism 30 may include other objects, such as a shackle of a padlock coupling a cable to the stationary object." '557 Patent, Col. 4, ll.1-2. Finally, the specification states that "[i]nserting a locking mechanism 30 through aperture 110 and aperture 150 maintains the engagement of anchor spindle 100 with locking spindle 140, and can be used to lock the computer 5 to a stationary object." '557 Patent, Col. 4, ll. 41-45. Again, the description provides that what is inserted through the apertures is the locking *mechanism* which can be *used to lock* the computer to a stationary object. In each relevant statement in the written description, the patentee explicitly refers to the "locking mechanism" (as opposed simply to cable). The patent describes the locking mechanism as including *both* cable 35 and lock 40.

Notwithstanding the plaintiff's arguments to the contrary, the drawings are not inconsistent with this conclusion. The plaintiff argues that the locking means is limited to the cable because the drawings show only the cable passing through the apertures. According to the plaintiff, if the court construes the locking means to include the combination of the cable and the lock, then it would be impossible for the locking means to pass through the apertures due to the size of the lock. The court disagrees. While the figures show a cable passing through the apertures, nothing in the written description requires that the entire locking means (from one end to the other) pass through both apertures. Therefore, a construction of this limitation to include the combination of the cable and the lock is consistent with the drawings and the written description because the cable portion of the means is able to pass through the apertures.

Moreover, the drawings actually support the defendants' argument. For example, in Figs. 5, 6, 14 and 17 the patentee consistently uses the number 30 to refer to the item passing through the aperture. The written description repeatedly associates the number 30 with the locking mechanism, which, in turn, includes the *combination* of the cable and the lock. None of the drawings refers to the locking mechanism with the number 35, which is the number associated with only the cable.

The doctrine of claim differentiation does not alter this result. Claim 6, which depends from claim 1, explicitly requires that the locking means "is a cable and a lock." The law is well-settled, however, that independent claims containing means-plus-function limitations do not have the same literal scope as dependent claims reciting specifically the structure that performs the stated function. *Medtronic, Inc. v. Advanced Cardiovascular Systems, Inc.*, 248 F.3d 1303, 1313 (Fed.Cir.2001); *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed.Cir.1991). As to the locking means limitation, claim 1 literally covers the combination of the cable and the lock and equivalents. Claim 6 literally covers only the combination of the

cable and the lock.

The court construes the locking means limitation in claim 1 of the '557 patent to include the combination of the cable and the lock and equivalents.

**2. Claim 1, Element [e]: "means, coupled to said pin, for attaching to said locking means and for inhibiting removal of said pin from said slot."**

The parties agree that this element is drafted in means plus function format and that the recited function is "for attaching to said locking means and for inhibiting removal of said pin from said slot." Again, the parties disagree on the corresponding structure.

The claim language recites: "means, coupled to said pin, for attaching to said locking means and for inhibiting removal of said pin from said slot." This claim limitation is ambiguous because it is subject to two different interpretations. The limitation may claim a *single* means which performs two different functions or, the limitation may claim *two separate* means which perform different functions. *Cf. Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1115 (Fed.Cir.2002) ("[m]oreover, the language of the "third monitoring means" does not merely recite dual functions; it also requires the same means to perform them both. The language of the limitation at issue does not refer to 'a means for doing x and y.' In such a case, the claim could potentially be ambiguous about whether the limitation required one means for performing both functions x and y, or simply one means for performing function x and one (potentially different) means for performing function y.").

Despite the court's reservations about the clarity of the claim language, both parties insist that a single means performs both functions. Therefore, the court will identify sufficient structure to perform both of the required functions. The plaintiff urges the court to limit the corresponding structure to the combination of the body portions and apertures. The defendant argues that the corresponding structure is the combination of the body portions, apertures and the locking means. The court cannot accept either argument.

The plaintiffs proposed structure is incomplete. Although the combination of the body portions and apertures is sufficient to perform the function of "attaching to said locking means," that combination is insufficient to perform the second recited function of "inhibiting the removal of said pin from said slot." The law is clear that the court may not expand the scope of claims by ignoring clear limitations present in the claim language.

On the other hand, the defendants' proposed structure includes too much. The defendants suggest that the court should include the locking means within the proposed structure, as the locking means, when inserted through the apertures, is sufficient to inhibit the removal of the pin from the slot. But the court must limit corresponding structure to that structure necessary to perform the claimed function. The court need not include all structure necessary to make the invention work. It is therefore significant that the claim language requires "inhibiting" as opposed to "locking." As construed by the court, the locking means includes both the cable and the lock; however, in the embodiments shown in Figs. 2, 5, 6 and 7, the only structure necessary to perform the function of inhibiting removal of the pin from the slot is the cable passing through the apertures. Therefore, with respect to the embodiment shown in Figs. 2, 5, 6, and 7, the court defines the corresponding structure to include the combination of the body portions, apertures and cable.

The plaintiff also urges the court to look beyond Figs. 2, 5, 6 and 7 to Fig. 17 for additional corresponding

structure. The plaintiff is, for the reasons expressed previously, entitled to claim corresponding structure disclosed in the entire specification. The plaintiff contends that Figure 17's disclosure of structure corresponding to the claimed function is the body portion and aperture shown in the drawing. The court agrees that Figure 17 discloses alternative structure, but, again, the plaintiff's proposal is incomplete because it does not take into account the inhibiting function mandated by the claim language.

Figure 17 discloses an embodiment of a locking system that works differently from the system disclosed in Figs. 2, 5, 6 and 7. Figure 17 discloses a system that uses a body portion and aperture to perform the function of "attaching to said locking means" but, in Figure 17, the cable does not perform the function of inhibiting removal of any locking pin from the slot. Rather, the device is equipped with a removable knob 850 that the user rotates to turn a shaft 840 from a first position to a second position. The shaft 840 is connected to a head portion 845. The user's rotation of the shaft and, in turn, the head portion, causes the head portion to engage first and second legs attached to flanges. The flanges, in turn, expand to exceed the dimensions of the slot in the electronic device, thereby preventing removal of the lock from the device. Once in the second position, the user removes the removable knob, thereby inhibiting the return of the shaft, head portion and flanges to the unlocked first position. Figure 17's disclosure of alternative structure corresponding to the functions recited in claim 1, element [5], must include not only the combination of the body portion 835 and the aperture 855 but also the removable knob 850 and equivalents.

**3. Claim 3, element [d]: "pin retaining means coupled to said pin for inhibiting removal of said pin from said slot."**

Again, the parties agree that the limitation is written in means-plus-function language and also agree that the recited function is "inhibiting removal of said pin from said slot." The plaintiff contends that the pin retaining means consists of the engagement members 115, 120, 155 and 160 shown in Figure 2. But the engagement members do not perform the function of "inhibiting removal of said pin from said slot." In Figure 2, there is nothing inhibiting the removal of the pin from the slot until the cable is inserted through the apertures. Therefore, for essentially the reasons expressed in the preceding discussion, the court construes the corresponding structure of Claim 3, element [d] to include the combination of the body portions, apertures and cable and equivalents. This combination is sufficient structure disclosed in the specification to perform the recited function of "inhibiting the removal of said pin from said slot."

**4. Claim 1, Element [c] and Claim 3, Element [b]: "said locking member adapted for insertion into and withdrawal from said slot when in a first position."**

The defendants suggest that the court construe this limitation to mean "said locking member adapted for insertion completely through and withdrawal completely from said slot when in a first orientation relative to said slot." The plaintiff argues that the defendants' proposed construction unnecessarily imports limitations from the specifications into the claim. The court agrees with the plaintiff and further holds that the claim language is readily understandable. Use of the term "orientation" instead of "position" adds little to the claim language and, in fact, operates to restrict the element to the embodiments disclosed in the specification.

**5. Claim 1, Element [d] and Claim 3, Element [c]: "a pin adapted for insertion into and withdrawal from said slot when said locking member is in said second position."**

In this element, the issue is whether the court should define the term "when." The court is persuaded to adopt the defendant's proposed definition and notes that the plaintiff has, in a prior case, agreed that the

construction is correct. The court defines this claim term to mean: "a pin adapted for insertion into and withdrawal from said slot at or during the time that said locking member is in said second position."

#### **6. Claim 4: "a cable attachment mechanism for associating a cable with the engagement member"**

The parties dispute whether this limitation is drafted in means-plus-function format. The language of the claim limitation does not use the word "means." Therefore, the presumption is invoked that the claim is not drafted pursuant to s. 112 para. 6. The burden thus shifts to the defendants to come forward with evidence sufficient to rebut such presumption. The defendants have failed to do so. In particular, the defendants have brought forth no evidence one way or another to allow the court to determine whether one of skill in the art would understand the term "cable attachment mechanism" to connote sufficient structure for performing the function of "associating a cable with the engagement member." Although the question is a close one, the court concludes that the patentee's use of the terms "cable attachment mechanism" describes sufficient structure for performing the function of "associating a cable with the engagement member." *See Al- Site Corp. v. VSI International, Inc.*, 174 F.3d 1308, 1318-19 (Fed.Cir.1999).

#### **7. Claim 9, Element [b]: "said head portion adapted for insertion into and withdrawal from said slot when in a first position."**

The court has concluded that none of the terms in this limitation requires construction. In particular, the court rejects the argument that "position" means "orientation." The terms of this limitation are, in the court's view, sufficiently understandable.

#### **8. Claim 9, Element [c]: "an anchor spindle."**

Preliminarily, the defendants correctly note that the claims use the terms "anchor spindle" and "locking spindle" in a manner different from the specification. The specification describes the anchor spindle 200 as the spindle that includes a head portion 230. Misaligning head portion 230 with slot 15 engages head portion 230 with inner surface of wall 10, thereby inhibiting removal of lock interface 55 from computer 5. '557 Patent, Col. 5 ll.1-26. The specification further describes the "locking spindle" as the spindle that includes a locking pin 265. Subsequent insertion of locking pin 265 into slot 15 inhibits realignment of head portion 230 with slot 15.

The claim language describes the two spindles in precisely the opposite manner. Claim 9 recites a "*locking spindle* having a body portion and a head portion, said head portion having a peripheral profile complementary to said security slot, said head portion adapted for insertion into and withdrawal from said slot when in a first position and for engagement with an interior surface of said wall when in a second position such that said head portion is associated with said portable device while in said second position." '557 Patent, Claim 9, Element [b] (emphasis added). Likewise, claim 9 includes "an *anchor spindle* having a body portion and an anchor portion, said anchor portion adapted for insertion into and withdrawal from said slot when said head portion of the locking spindle is in said second position, said anchor portion inhibiting transition of said head portion from said second position to said first position, and said anchor spindle body portion adapted for association with said locking spindle body portion." '557 Patent, Claim 9, Element [c] (emphasis added).

Notwithstanding the transposition of the terms "anchor" and "locking," the court defines "spindle" according to its ordinary meaning. The term "spindle" is defined as "any shaft, rod or pin that turns around or on which something turns, as an axle, arbor, or mandrel." The balance of the language of the claim limitation

sufficiently defines the anchor spindle such that the claim terms need no further definition.

**9. Claim 9, Element [c]: "said anchor portion adapted for insertion into and withdrawal from said slot when said head portion of the locking spindle is in said second position."**

The court adopts the defendants' proposed construction of the term "when." The claim limitation is defined to mean "said anchor portion adapted for insertion into and withdrawal from said slot at or during the time that said head portion of the locking spindle is in said second position."

**10. Claim 9, Element [d]: "a locking mechanism, adapted for engaging said anchor spindle body portion and said locking spindle body portion, inhibiting disassociation of said locking spindle and said anchor spindle."**

The parties dispute whether this claim limitation is drafted in means-plus-function form. For essentially the same reasons discussed with respect to the term "cable attachment mechanism," the court holds that the defendants have failed to overcome the presumption that the limitation is not drafted according to s. 112 para. 6. As the parties do not suggest any alternative construction of any of the terms of this limitation, the court determines that further construction of the terms is unnecessary.

**B. '562 Patent**

**1. Claim 1, Element [b][ii] and Claim 6, Element [c][ii]: "spindle."**

The court adopts the dictionary definition of the term "spindle" as proposed by the plaintiff. The term "spindle" is defined as "any shaft, rod or pin that turns around or on which something turns, as an axle, arbor, or mandrel."

**2. Claim 1, Element [b][iii]: a locking mechanism for maintaining rotation of said shaft of said spindle fixed in said cavity relative to said housing.**

The dispute concerning this claim term is whether the claim language is drafted in meansplus-function form. The court has considered the claim language and notes that the failure to use the word "means" results in a presumption that the claim element is not drafted according to s. 112 para. 6. The court has also determined, given the claim language, that the element recites sufficient structure and that the defendant has failed to overcome the presumption that results from the failure to use the word "means." Therefore, the patentee is entitled to the full breadth of the definition of the term "locking mechanism."

The court is also not persuaded that the patentee's statements to the examiner regarding the Kerry prior art reference create an estoppel. The defendants argue that the patentee disclaimed the use of a squared off side as a locking mechanism for maintaining the rotation of the shaft fixed in the cavity relative to the housing. In response to a rejection, the patentee stated that Kerry provides a squared passage that prevents the rotational movement of the stem when a squared portion of the stem is received by the squared passage, and, as a consequence Kerry did not disclose or suggest "a locking mechanism for maintaining rotation of said shaft of said spindle fixed in said cavity relative to said housing." The patentee's principal argument against Kerry, however, was that Kerry did not include an electronic device. The prior art was distinguishable on this ground; therefore, the court cannot say that the patentee disclaimed the use of a squared off side in exchange for patentability, as the defendants contend. The parties have not urged the court to construe this term other as relates to the issues whether it is drafted in means plus function format

and whether the statements regarding Kerry create an estoppel.

**3. Claim 1, Element [b][iv]: "a pin, displaced laterally from said shaft."**

The defendants have urged the court to construe this limitation to mean "a pin, displaced from the side of said shaft." The plaintiff argues that construction of this term is unnecessary, as the terms are readily understandable. The court agrees with the plaintiff that the terms used in this element are readily understandable and that no construction is necessary.

**4. Claim 6, Element [c][iii]: "a pin ... laterally displaced from said shaft."**

The court concludes that no construction of this limitation is necessary.

**5. Claim 6, Element [d] "a locking mechanism for maintaining rotation of said shaft fixed relative to said pin."**

The court is persuaded that this claim language recites sufficient structure and that the defendants have not overcome the presumption that the claim is drafted according to s. 112 para. 6.

C. '088 Patent.

**1. Claim 1, Element [b]: "a pin for extending into said security slot ... when said slot engagement member is in locked position."**

For the reasons expressed above, the term "when" is defined as "at or during the time that." The balance of the claim language needs no construction.

**2. Claim 1, Element [b]: "proximate said slot engagement member."**

The plaintiff argues that this limitation needs no construction. The defendants maintain that the court should define the term "proximate" and proposes a dictionary definition of the term to mean "next to or very close to." The court agrees with the defendants that the term "proximate" should be defined and adopts the definition of the term proposed by the defendants. The court notes that the plaintiff does not suggest that the defendants' proposed definition is inadequate or otherwise unnecessarily imposes limitations into the claim language. The limitation is defined as "next to or very close in space to said slot engagement member."

**3. Claim 3, Element [b]: "a pin, coupled through said housing, for extending proximate said security slot and proximate to said slot engagement member."**

For the reasons stated in the preceding paragraph, the court construes the term "proximate" to be "next to or very close in space to."

**4. Claim 3, Element [b]: "a pin ... for extending proximate said security and proximate said slot engagement member when said slot engagement member is in said locked position."**

The court adopts the same definitions of "proximate" and "when" as previously adopted in the context of other limitations.

**5. Claim 1, Element [c] and Claim 3, Element [c]: "a cable attachment mechanism, coupled to said**

**housing, for attaching a cable ."**

The court concludes, for essentially the reasons expressed in the defendants' brief, that the patentee's representation to the examiner that this claim limitation was drafted according to s. 112 para. 6 is binding. The defendants' brief attaches pertinent portions of the prosecution history in which the applicant stated, in response to a patentability rejection, that this claim limitation is specifically subject to 35 U.S.C. s. 112 para. 6. (See Bush Decl. Exh. G, pp. 5-7 & n.l). The plaintiff's reply brief does not rebut this prosecution history or attempt to explain it in any way, although the plaintiff suggested at the claim construction hearing that the representation might have been a mistake. The court has carefully reviewed the cited portions of the prosecution history and is of the opinion that both the applicant and the examiner used the terms "cable attachment mechanism" and "cable attachment means" interchangeably. The applicant further stated "[n]ote that the cable attachment means is subject to the requirements of 112(6)." The defendants have carried their burden to show that this limitation is a means-plus-function limitation. The plaintiff has not specifically contested the structure proposed by the defendants to correspond with this limitation. As such, the court adopts the defendants' proposed construction that the claimed function is "attaching a cable" and the corresponding structure is a pair of aligned apertures, a permanent ring, and equivalents.

So **ORDERED**.

E.D.Tex.,2003.

Acco Brands, Inc. v. American Power Conversion Corp.

Produced by Sans Paper, LLC.