

United States District Court,
N.D. Oklahoma.

BED-CHECK CORPORATION,
Plaintiff.

v.

ULTIMATE SAFETY, INC,
Defendant.

No. 01-CV-0416-EA(M)

Nov. 24, 2003.

Alexander Floyd King, Crowe & Dunlevy, John M. Freese, Freese & March PA, Terry Lynn Watt, Fellers Snider Blankenship Bailey & Tippens, Tulsa, OK, Joseph J. Ferretti, Phillip L. Free, Jr., Crowe & Dunlevy, Oklahoma City, OK, for Plaintiff.

C. Matthew Bickell, Steven Massey Harris, Doyle Harris Davis & Haughey, Tulsa, OK, for Defendant.

MARKMAN ORDER

CLAIRE V. EAGAN, District Judge.

This matter comes before the Court for an interpretation of the claims contained in U.S. Patent Nos. 5,654,694 (the "'694 Patent") and 6,065,727 (the "'727 patent"). A hearing was held in this matter on November 3, 2003, pursuant to *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370 (1996). Based on a review of the record, the Court hereby interprets the '694 Patent and the '727 Patent as set forth below.

I.

1. Claims in a patent are part of the specification, and, as such, the words and phrases used in the claims must be clear, exact, and precise. Claims must also "particularly point[] out" and "distinctly" claim the invention. 35 U.S.C. s. 112. The claim requirements of 35 U.S.C. s. 112 must be adhered to strictly for purposes of enabling the public to determine what subject matter is, and what subject matter is not, within the scope of the monopoly granted by the United States government. That subject matter which has not been made the subject of the patent monopoly is free territory to be practiced by everyone in the general public. The public is thus entitled to rely on the public record. *Vitronics Corp. v. Conception Inc.*, 90 F.3d 1576 (Fed.Cir.1996).

2. "Claim construction" is the judicial statement of what is and is not covered by the technical terms and other words of the claims. *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347 (Fed.Cir.2001); *U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed.Cir.1997).

3. Under *Markman*, the first step of the patent infringement determination is a correct interpretation of words and phrases that are in dispute between the parties.

4. "[T]he construction of claims is simply a way of elaborating the normally terse claim language[] in order to understand and explain, but not to change, the scope of the claims." *Embrex, Inc. v. Service Eng'g Corp.*, 216 F.3d 1343, 1347 (Fed.Cir.2000), *quoting* *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 1580 (Fed.Cir.1991).

5. As in any other case, arguments of counsel are entitled to no deference in view of the written record and testimony. Arguments of counsel cannot take the place of evidence lacking in the record. *Estee Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588 (Fed.Cir.1997); *In re Jones*, 2001 WL 267053, at (Fed.Cir. Mar. 16, 2001) (unpublished disposition).

6. Interpreting the claims begins with a review of the intrinsic evidence, which consists of the claim language itself, the specification of the patent, and the prosecution history of the patent. *Embrex, Inc.*, 216 F.3d at 1347; *Vitronics Corp.*, 90 F.3d at 1582. If the intrinsic evidence resolves any ambiguity in a disputed claim, extrinsic evidence cannot be used to contradict the established meaning of the claim language. *Mantech Envtl. Corp. v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1373 (Fed.Cir.1998). Extrinsic evidence may, however, be accepted by the Court to enhance its understanding of the technology in general, but only for background purposes and may not be used in substitution of, or to contradict, intrinsic evidence, *See EMI Group N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed.Cir.1998).

7. In *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298 (Fed.Cir.1999), the Court of Appeals for the Federal Circuit emphasized that courts should: not rely on extrinsic evidence to contradict the meaning of claims "discernable from thoughtful examination of the claims, the written description, and the prosecution history-the intrinsic evidence." *Id.* at 1308. However, while the law prohibits reliance on expert testimony and other extrinsic evidence to alter the meaning of a claim, a court may still consider such evidence in reaching a particular interpretation.

[Indeed] it is entirely appropriate, perhaps even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with the clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field.

Id. at 1309.

8. Accordingly, while a patent file may often be sufficient to allow proper interpretation of the technical aspects of the patent, resort to extrinsic evidence may be appropriate to ensure that a court's understanding of the technical aspects of the patent is not at variance with the understanding of one skilled in the art. *Id.* at 1309. *See also* *Aqua-Aerobic Sys., Inc. v. Aerators Inc.*, 211 F.3d 1241, 1244-45 (Fed.Cir.2000) (expert testimony may be heard by the court to clarify the understanding of patented technology).

9. As to the review of the intrinsic evidence, the specification is reviewed to determine whether the patentee used terms in a manner inconsistent with their ordinary meaning. *See* *Vitronics Corp.*, 90 F.3d at 1582. The purpose of the specification is to present a description of the technologic subject matter of the invention, while the role of claims is to point out with particularity the subject matter that is patented. *See* 35 U.S.C. s. 112.

The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose. Thus[,] the claims are constructed to state the legal scope of each patented invention, on examination of the language of the claims, the description in the specification, and the prosecution history.

Netword, LLC, 242 F.3d at 1352.

10. The prosecution history is also considered to determine whether or not there were any express representations made in obtaining the patent regarding the scope and meaning of words and phrases used in the claims. *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed.Cir.1995) ("The prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.").

11. Words used in a claim cannot be given an interpretation in a vacuum. The ordinary meaning of a word or phrase must be determined in the context of the written description and the prosecution history to determine the proper construction of the particular word or phrase as it has been used in the claims of the patent. *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1324 (Fed.Cir.2001). The language of the claims as allowed is to be construed, and it is that language that determines the limitations of the claim, *Intervet Am., Inc. v. Kee-Vet Labs., Inc.*, 887 F.2d 1050, 1054 (Fed.Cir.1989); *DeMarini Sports, Inc.*, 239 F.3d 1314. The Federal Circuit has cautioned:

"That claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims." If everything in the specification were required to be read into the claims, or if structural claims were to be limited to devices operated precisely as a specification-described embodiment is operated, there would be no need for claims, Nor could an applicant, regardless of the prior art, claim more broadly than that embodiment. Nor would a basis remain for the statutory necessity that an applicant conclude his specification with "claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107 (Fed.Cir.1985) (citations omitted).

12. The Federal Circuit Has clarified that there is only one correct claim interpretation (reviewed *de novo* by the Federal Circuit), which must be determined as a matter of law by the trial judge. The Court's task is not to decide whether one of the parties is correct, but rather, to assess independently the claims at issue:

We have recently concluded in *Boch* that claim interpretation is a matter of law, and that the trial judge alone has the duty and responsibility to interpret the claims at issue. *Markman*, 52 F.3d at 970 ... [I]t may well be that in some cases one side or the other will offer the correct claim interpretation to the judge. More often, however, it is likely that the adversaries will offer claim interpretations arguably consistent with the claims, the specification and the prosecution history that produces victory for their side. In any event, the judge's task is not to decide which of the adversaries is correct.

Exxon Chem. Patents, Inc. v. Lubrizol Corp., 64 F.3d 1553, 1556 (Fed.Cir.1995).

13. In interpreting the claim language, the Court should first look to the actual words of the claims themselves, which is the starting point for any claim construction. *Pitney Bowes, Inc.*, 182 F.3d at 1305. The

Court should then examine the patent as a whole. Finally, the Court should examine the prosecution history. When the meaning of the claim language is clear upon the examination of intrinsic evidence, the Court should not rely on extrinsic evidence to interpret the claims. *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1344 (Fed.Cir.1998). As noted above, however, to ensure proper claim interpretation, the Court may consider extrinsic evidence, such as, for example, expert testimony. *Id.*

14. One must ignore the structure and operation of the accused device or devices of the defendant when seeking the correct interpretation of a word or phrase used in the claims. In other words, the accused device or product of the defendant is not a "tool" that is available in the claim interpretation exercise. *Young Dental Mfg. Co., Inc. v. Q3 Special Prods., Inc.*, 112 F.3d 1137 (Fed.Cir.1997). Only after the claims have been properly interpreted without any consideration of the products accused of infringement, may the interpreted claims be applied to the accused products of the defendant in the second step of the infringement analysis. *SRI Int'l*, 775 F.2d at 1118.

15. The role of the Court "is neither to limit nor to broaden the claims, but to define, as a matter of law, the invention that has been patented. The claims are always construed in light of the specification, of which they are a part." *Network, LLC*, 242 F.3d at 1352, *citing* *Slimfold Mfg. Co., Inc. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1118 (Fed.Cir.1987).

16. "Each claim in a patent must be interpreted by comparing or contrasting it to other claims of the same patent. The scope of any one claim of a patent therefore, is influenced by the language employed in other claims of the same patent." *Bendix Corp. v. United States*, 199 U.S.P.Q. 203, 212 (Ct. Cl. Trial Div.1978), *aff'd*, 600 F.2d 1364 (Ct.Cl.1979).

17. "The patent stands or falls on what is said, not what the holder of the patent hoped he said, nor what an expert speculates in hindsight about what the patent holder might have meant.... Claims may not be broadened by the specifications, nor by hindsight ." *Refac Int'l, Ltd. v. IBM*, 689 F.Supp. 422, 430 (D.N.J.1988), *aff'd*, 891 F.2d 299 (Fed.Cir.1989) (unpublished disposition).

18. "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 claims 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. Interpretation of a "means plus function" limitation is a three-step process. *See* *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258 (Fed.Cir.1999). First, the Court must identify the recited function. *See id.* Second, the Court must identify the structure disclosed in the patent that performs the recited function. *Id.* Third, the claim element covers the structure disclosed and equivalent structures. *See* 35 U.S.C. s. 112, para. 6.

19. A principle of claim construction is that "a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed." 35 U.S.C. s. 112.

20. A "preferred embodiment" or "best mode of carrying out the invention" disclosed in the written description is just that, and the scope of a patentee's claims is not limited to that preferred embodiment or best mode. *Amhil Enters., Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1559 (Fed. Cir.1996). The Court must review the patent specification in analyzing the meaning of disputed claim terms. *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572 (Fed.Cir.1996). However, it is settled law that the written description (which includes the best mode of practicing the invention) and the drawings do not define the

scope of the claims. Markman, 52 F.3d at 980.

21. The Federal Circuit permits the court to consult dictionaries and learned treatises. In *Vitronics Corp.*, the court stated:

Although technical treatises and dictionaries fall within the category of extrinsic evidence, as they do not form a part of an integrated patent document, they are worthy of special note. Judges are free to consult such resources at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.

Id. at 1584 n. 6.

22. Claims are to be construed as they would be construed by one of ordinary skill in the art. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 1388 (Fed.Cir.1992); *see also* *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1578 (Fed.Cir.1996).

II.

Applying the legal principles set forth above to the words and phrases identified by the parties for interpretation, the Court hereby interprets the ' 694 Patent as follows:

1. The term "**A system for monitoring a long term care device having a sensor thereon for detecting the presence of a patient on the device comprising ...**" should be interpreted as follows: "**A system for monitoring a long term care device having a sensor for detecting the presence of a patient on the device. The System has at least the following features....**"

2. The term "**A microprocessor responsive to a program resident therein**" should be interpreted as follows: "**An integrated circuit that contains a central processing unit (CPU) on a single chip, that responds to a software program resident in memory.**"

3. The term "**first circuit means connected to said microprocessor and to the sensor (1) for automatically activating operation of said microprocessor to a "monitor" mode upon detection by the sensor of the patient's presence on the device, (2) for maintaining operation of said microprocessor for a predetermined time period at least equal to a running time of said program (3) for terminating operation of said microprocessor at the expiration of said predetermined time period if detection by said sensor of termination of the patient's presence on the device occurs prior to expiration of said predetermined time period.**" should be interpreted as follows: "**1. The recited functions are "automatically activating operation of the microprocessor to a "monitor" mode ... maintaining operation of the microprocessor ... and terminating operation of the microprocessor....**" 2. The corresponding structure disclosed in the patent for performing these functions is the power operating circuitry shown at Fig. 6 (and as described in the specification) together with the associated program. 3. The first circuit means is connected to the microprocessor and to the sensor.

4. The term "**activating**" should be interpreted as follows: "**setting in motion.**"

5. The term "**operation of a microprocessor**" should be interpreted as follows: "**execution of**

software/program code."

6. The term "**to a monitor mode**" should be interpreted as follows: "**to the point the microprocessor is executing a line of code as part of the program.**"

7. The term "**maintaining**" should be interpreted as follows: "**preserving or keeping in a given existing condition.**"

8. The term "**running time**" should be interpreted as follows: "**the period of time during which a program is being executed.**"

9. The term "**terminating**" should be interpreted as follows: "**ending.**"

III.

Applying the legal principles set forth above to the words and phrases identified by the parties for interpretation, the Court hereby interprets the ' 727 Patent as follows:

1. The term "**a holster for a module comprising**" should be interpreted as follows: "**a holster for a module that includes at least the following features.**"

2. The term "**first and second substantially rigid continuous wire loops bent into identical inverted-Ls of a height adapted to be less than a height of the module and arranged in back-to-back spaced apart relationship;**" should be interpreted as follows: "**two wire loops bent into inverted L-shapes. The two wire loops are arranged in back-to-back, spaced apart relationship.**"

3. The term "**upper and lower substantially rigid parallel wire cross members fixed to rearward vertical portions of said inverted-Ls, said cross members being of length and upper horizontal portions of inverted-Ls being of contour adapted to constrain horizontal movement of the module when the module is inserted downwardly there between and is seated on lower horizontal portions of said inverted-Ls;**" should be interpreted as follows: "**Two wire cross members are fixed to the rearward vertical portions of the wire loops. The length of the cross members and the contour of the wire loops is such that they will restrict horizontal movement of a module seated on the lower horizontal portions of the wire loops.**"

4. The term "**means connectable to said holster for hanging said holster from another structure.**" should be interpreted as follows: "**1. The recited function is hanging the holster from another structure. 2. The corresponding structure described in the specification includes: (a) the hangar 50,(b) the loop clamps 33 and 35 or (c) structural equivalents thereof. 3. The structure disclosed for performing the recited hanging function is connected to the holster.**"

5. The term "**connectable**" should be interpreted as follows: "**capable of being connected together; it does not require that the hanging means be removable.**"

IV.

It is unclear from the post- *Markman* briefs whether the parties want the Court to enter a ruling on the dependent claims of the patents, A joint submission of the parties delineating which, if any, additional terms

are to be construed should be submitted by December 5, 2003.

IT IS SO ORDERED.

N.D.Okla.,2003.

Bed-Check Corp. v. Ultimate Safety, Inc.

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