

United States District Court,
C.D. California, Southern Division.

JONATHAN MANUFACTURING CORPORATION, d/b/a Jonathan Engineered Solutions,
Plaintiff(s).

v.

CENTRAL INDUSTRIAL SUPPLY COMPANY,
Defendant(s).

No. SA CV04-1365 DOC (SHx)

Oct. 26, 2005.

James C. Brooks, Hope E. Melville, Orrick Herrington & Sutcliffe LLP, Los Angeles, CA, for Plaintiff
Jonathan Manufacturing Corp. d/b/a Jonathan Engineered Solutions.

Stetina, Brunda, Garred & Brucker LLP, Lowell Anderson, for Central Industrial Supply Company.

**ORDER RE: CLAIM CONSTRUCTION OF U.S. PATENT NO. 6,820,954; DENYING
DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF INVALIDITY; DENYING
DEFENDANT'S MOTION FOR SUMMARY JUDGMENT OF NON-INFRINGEMENT; DENYING
PLAINTIFF'S CROSS-MOTIONS FOR SUMMARY JUDGMENT OF INFRINGEMENT AND
CONTEMPT OF THE PRELIMINARY INJUNCTION**

DAVID O. CARTER, **District Judge.**

Before the Court are Defendant Central Industrial Supply Company's ("CIS") motions for summary judgment of invalidity of U.S. Patent No. 6,820,954 ("954 patent") and summary judgment of non-infringement, as well as Plaintiff Jonathan Manufacturing Corporation's ("Jonathan") cross-motions for summary judgment of infringement and for finding CIS in contempt of the Court's February 7, 2005 Order Granting Preliminary Injunction ("Preliminary Injunction Order"). Before addressing the motions, the Court engages in claim construction of the '954 patent. After considering the moving, opposing, and replying papers, and for the, reasons set forth below, the Court DENIES all motions.

I. BACKGROUND

Plaintiff Jonathan is a California-based engineering and manufacturing company, and the holder of the '954 patent. Defendant CIS is a Texas-based product development and manufacturing company that specializes in providing components and assemblies to original equipment manufacturers ("OEMs"). CIS formerly distributed Jonathan's "EZ RAIL" slide assembly. Now, Jonathan claims that CIS has copied the EZ RAIL and is selling a product called the QualSlide that infringes the '954 patent. These products are sliding rails, similar to those used for mounting household drawers. However, the slides at issue are used for mounting computer servers in vertical racks. The slides allow the computers to slide out from the rack like a drawer,

to allow access to all sides of the computer. The '954 patent covers a slide which has a feature that allows for the complete removal of the server from the rack by allowing part of the slide to separate.

The '954 patent is based upon a continuation application, filed November 7, 2003, of U.S. Patent No. 6,655,763 ("763 patent"), filed December 19, 2001 and issued December 2, 2003. The continuation application added thirteen new claims to the '763 patent application, and Jonathan asserted to the U.S. Patent and Trademark Office ("PTO") that the new claims were fully supported by the parent application and therefore added no new matter. The '954 patent issued on November 23, 2004. Jonathan has not alleged that CIS has infringed the '763 patent.

The '954 patent describes a system with two slides and a bearing retainer between the slides. The first slide contains a channel in which the second slide moves. This channel holds a bearing retainer, which holds ball bearings that allow the second slide to move smoothly within the channel. This bearing retainer slides toward the front of the first slide when the second slide is moved forward and withdrawn. At the front end of the first slide is a resilient latch. When the bearing retainer contacts the latch, a portion of the bearing retainer pushes the latch out of the way momentarily, into a second position. Then, as the latch moves back into its first position, it comes into contact with the retainer again. The effect of this contact is that the latch keeps the retainer from sliding back into the channel, thus making it easier to reinsert the second slide. Without some kind of latch, the retainer would be free to move about in the channel. The patent calls for the latch not to release in response to pressure pushing the retainer back into the first slide; it must be released through some other mechanism.

On February 7, 2005, this Court entered the Preliminary Injunction Order enjoining Defendant CIS from making, using, selling, offering for sale, importing, or otherwise distributing certain QualSlide quick-disconnect slide assemblies. After construing the terms of claim 17 of the '954 patent and reviewing two sample slide assemblies produced by the parties, this Court held that the preliminary injunction applied only to Qualslide slide assemblies where "the resilient latch **does not move** into a second position in response to a rearward force on the bearing retainer" when the second slide is reinserted ("QS1"). Order Granting Prelim. Inj. at 9:16-17. FN1 The Court found a high likelihood that Jonathan would succeed in showing that the QS1 literally infringed the '954 patent. The Preliminary Injunction Order did not apply to Qualslide slide assemblies where the resilient latch did move to the second position due to rearward force on the bearing retainer ("QS2").

FN1. At the preliminary injunction hearing, the Court labeled the slide assembly sample provided by Jonathan as "QS1," and the sample provided by CIS as "QS2." The Court noted that "Jonathan and CIS were unable to agree regarding which slide was the authentic device, so the Court accepted both items for inspection. CIS questions the origins of the QS1, stating that the QualSlide was sold only directly to Sun, and was not available to resellers." Order Granting Prelim. Inj. at 5:9-12.

In its cross-motion for contempt, Jonathan asserts that in July 2005 and September 2005, it purchased "'QS1'-type Qualslide slide assembly products from third-party independent distributors" that were made and sold after the Preliminary Injunction Order was issued. Opp'n to CIS's Mot. for Summ. J. of Non-Infringement, & Cross-Mot. for Summ. J. of Infringement of Claims 10-23 of U.S. Patent No. 6,820,954 & for Contempt of Prelim. Inj. Order at 1:9-10. CIS contends that the slide assemblies purchased by Jonathan do not violate the Preliminary Injunction Order.

II. CLAIM CONSTRUCTION

Claim interpretation is a matter of law. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). The only terms that the Court is required to construe are those that are in controversy, and only to the extent necessary to resolve the controversy. *Vivid Technologies, Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed.Cir.1999). Claim interpretation begins with the language of the claim. *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed.Cir.2002). "The words used in the claims are interpreted in light of the intrinsic evidence of record, including the written description, the drawings, and the prosecution history, if in evidence. *Id.* at 1324-35 (citing *Interactive Gift Express, Inc. v. CompuServe, Inc.*, 256 F.3d 1323, 1331 (Fed.Cir.2001)). The intrinsic evidence may provide context and clarification about the meaning of claim terms, and is the most significant source of the legally operative meaning of disputed claim language. *Id.* at 1325. Among the intrinsic evidence, the specification is always highly relevant to the claim construction analysis-it is the single best guide to the meaning of a disputed term, and is usually dispositive. *Id.* Nonetheless, although the claims must be read in view of the specification, limitations from the specification are not to be read into the claims. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed.Cir.2005) (en banc). "[T]he line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms ." *Id.*

"In the absence of an express intent to impart a novel meaning to claim terms, an inventor's claim terms take on their ordinary meaning." *Teleflex*, 299 F.3d at 1325. "Properly viewed, the 'ordinary meaning' of a claim term is its meaning to the ordinary artisan after reading the entire patent." *Phillips*, 415 F.3d at 1321.

A. The '954 Patent

The disputed claims of the '954 patent are independent claims 10, 17 and 23. The only disputed elements of the claims are denoted in the text below.

10. A slide assembly, comprising:

...

wherein, when said second slide segment is removed from said first slide segment, said bearing retainer contacts and passes over said rear face thereby biasing said resilient latch from a first position toward a second position until said portion of said bearing retainer moves into alignment with said recess, whereupon said resilient latch moves toward said first position such that said portion is within said recess and said locking surface contacts said engagement surface ***to inhibit rearward movement of said bearing assembly*** and wherein said locking surface and said engagement surface are configured such that said ***resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer.***

17. A slide assembly, comprising:

...

wherein, when said second slide segment is removed from said first slide segment, said bearing retainer biases said resilient latch from a first position toward a second position until said bearing retainer permits said latch to move back toward said first position whereupon said first engagement surface contacts said

second engagement surface *to inhibit rearward movement of said bearing assembly* and wherein said first engagement surface and said second engagement surface are configured such that said *resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer*.

23. A slide assembly, comprising:

...

wherein, when said second slide segment is removed from said first slide segment, said latch is moved from a first position toward a second position and then moves back towards said first position whereupon said first engagement surface contacts said second engagement surface *to inhibit rearward movement of said bearing assembly*;

wherein said latch includes a first surface, wherein force on said first surface when said second slide segment is removed from said first slide segment *to moves* said latch toward said second position; and

wherein said latch additional includes a second surface and said slide assembly further comprising a tab, said tab configured to contact said second surface and move said latch toward said second position when said second slide segment is inserted into said channel and moved towards said rearward end of said first slide segment, thereby releasing said bearing retainer from said latch and permitting rearward movement of said bearing assembly.

The disputed phrase "to inhibit rearward movement of said bearing assembly" appears in claims 10, 17 and 23. The disputed phrase "resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer" appears in independent claims 10 and 17. Since claim terms must be interpreted consistently, *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed.Cir.1995), the common disputed elements of independent claims 10, 17 and 23 are construed below, as well as the remaining disputed term in independent claim 23. The claims are construed below as a matter of law.

B. "to inhibit rearward movement of said bearing assembly"

Jonathan argues that the phrase "to inhibit rearward movement of said bearing assembly" means that the movement of the bearing assembly is "restrained, retarded or interfered with, or the bearing assembly is at least lightly held in place." *Markman Br.*, Ex. A at 6. CIS submits that the term "inhibit" should be read narrowly to mean that the rearward movement of the bearing assembly is "prevented" completely, and should not be read to mean "lightly hold." Opp'n to Jonathan Manufacturing Corporation's *Markman Br.* at 9:9-10. In its Preliminary Injunction Order, the Court found that the ordinary meaning of the phrase was broader than simply "prevent," and that "light holding" is sufficient to satisfy the inhibition requirement." Order Granting Prelim. Inj. at 6:4-5.

CIS argues that the Court's claim construction in the Preliminary Injunction Order should be reevaluated in light of the recent en banc decision by the Federal Circuit in *Phillips*. 415 F.3d 1303. In *Phillips*, the Federal Circuit held that a district court should construe a disputed claim term by focusing "at the outset on how the patentee used the claim term in the claims, specification, and prosecution history," rather than relying upon a "dictionary definition entirely divorced from the context of the written description." 415 F.3d at 1321. CIS suggests that the Court relied upon a dictionary definition in the Preliminary Injunction Order when construing the term "inhibit." Although the Court's ordinary meaning interpretation of the term "inhibit" is

consistent with the dictionary definition proffered by Jonathan, it is also consistent with the specification, claims and prosecution history. Moreover, after *Phillips*, judges remain free to consult dictionaries "so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." *Phillips*, 415 F.3d at 1322-23 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 n. 6 (Fed.Cir.1996)). Thus, the Court's claim construction of the disputed phrase is not inconsistent with the Federal Circuit's latest guidance on claim construction.

The Court's ordinary meaning interpretation of the phrase "to inhibit rearward movement" is consistent with the patent specification. The specification discloses that when the bearing assembly and the resilient latch come into contact with each other, "[r]earward movement of the bearing assembly 80 is limited by the rear locking surface 152. Forward movement of the bearing assembly 80 is limited by the front locking surface 150 and/or the hard stops 154." '954 Patent, Col. 8:27-30 (referring to Fig. 3). The specification teaches that movement of the bearing assembly is "limited" by the front and rear locking surfaces of the resilient latch. The specification does not state that the bearing assembly is completely prevented from moving while in contact with the resilient latch. Indeed, Figure 3 illustrates that there is space between the rear and front locking portions of the resilient latch within which the cross-member of the bearing assembly can move.

Therefore, in light of the intrinsic evidence before the court and the ordinary meaning of the disputed claim terms, the Court finds that Jonathan's interpretation is the correct construction of the phrase "inhibit rearward movement of said bearing assembly."

C. "resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer."

Jonathan argues that the phrase "resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer" means that the resilient latch does not move "in response to the frictional force exerted on the bearing retainer" by the second slide segment as the segment is reinserted into the first slide segment. *Markman Br.*, Ex. A at 6. Jonathan contends that the resilient latch need only remain immobile long enough to ensure that the second slide segment is properly seated within the first slide segment upon reinsertion. It cites to the specification, which states that "[w]ith the bearing assembly 80 retained near the front of the channel 56, it is easier to guide the forward end of the inner slide segment 16 past the forward end of the bearing assembly 80 as the inner slide segment is inserted into the channel 56." '954 Patent, Col. 8:30-35 (referring to Fig. 3). CIS argues that "does not move" should be understood in an absolute sense such that the bearing retainer would move only in response to a destructive force. Opp'n to Jonathan Manufacturing Corporation's *Markman Br.* at 12:19-20. In the Preliminary Injunction Order, the Court interpreted the disputed phrase in terms of its ordinary meaning: The resilient latch "does not move" from the first position to the second position in response to a rearward force exerted on the bearing retainer. Order Granting Prelim. Inj. at 6:9-13.

The ordinary meaning of the disputed phrase is clear, and the claim should not be construed to mean anything other than that the resilient latch does not move from the first locking position to the second releasing position in response to a rearward force exerted on the bearing retainer. As Jonathan itself points out, "inhibit" and "does not move" are two different terms with distinct meanings, the former allowing for a level of resistance short of "prevention" of movement. *Markman Reply Br.* at 4:12-17. If Jonathan wished to claim a resilient latch that would move to the second position in response to a frictional force exerted on the bearing retainer, it could have used terminology similar to "inhibit." Instead, by using the term "does not move," Jonathan's claim communicates to the person of ordinary skill in the art that the resilient latch will

not move in response to a force greater than mere frictional force. This interpretation is not altered by the specification language stating that the purpose of retaining the bearing assembly near the front of the channel is to facilitate reinsertion of the inner slide segment. Moreover, the specification supports this ordinary meaning of the phrase, stating that "[w]hen the inner slide segment 16 is removed from the channel 56, the bearing assembly 80 is drawn forwardly towards the latch 126. The cross-member 98 of the bearing retainer 84 contacts the locking portion 140 of the latch 126 and the bearing assembly 80 is *automatically locked in place.*" '954 Patent, Col. 8:66-9:4 (referring to Fig. 9) (emphasis added). The specification teaches that the resilient latch is locked in place and will not move from the first to second position, even in response to a force greater than frictional force exerted on the bearing retainer.

Therefore, the disputed phrase is given its ordinary meaning: The "resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer," where the amount of force refers to a force greater than mere frictional force.

D. "to moves"

CIS points out this typographical error in claim 23 of the '954 patent and argues that the claim is invalid for indefiniteness under 35 U.S.C. s. 112. CIS argues that the meaning of this claim is unresolvably ambiguous as a result of this two-word phrase, and presents a number of possible prepositional phrases that might have been left out between the two words to make sense of the claim ("to _____ moves"). Br. on Claim Construction for the '954 Patent & Mem. For Invalidity Under s. 112 at 21:22-25 (suggesting that the phrase could be read as "wherein force on said first surface when said second slide segment is removed from said first slide segment to *engage said engagement surfaces* moves said latch toward said second position"). Jonathan argues that the word "to" is a superfluous typographical error and that the claim is grammatically correct when the word is removed from the claim. While recognizing the typographical error, Jonathan has not sought a certificate of correction from the PTO to correct this error.

When no certificate of correction has been issued by the PTO to correct an error in a patent claim, a district court may act to correct the error only if "(1) the correction is not subject to reasonable debate based on consideration of the claim language and specification, and (2) the prosecution history does not suggest a different interpretation of the claims." *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1354 (Fed.Cir.2003). Jonathan's suggested correction of deleting the word "to" makes the limitation consistent with claim 23 read in its entirety and the specification. The prosecution history before the Court similarly does not suggest a different interpretation of the claim. The last paragraph of claim 23 refers to a tab configured to contact the second surface of the resilient latch "and move said latch toward said second position...." '954 Patent, Col. 18:11-12. When the word "to" is deleted from the disputed paragraph of claim 23, the claim similarly reads that a force exerted on the first surface of the resilient latch "moves said latch towards said second position." Based on consideration of the claim language and specification, the missing phrases suggested by CIS are not reasonable. Therefore, claim 23 is corrected to read "wherein said latch includes a first surface, wherein force on said first surface when said second slide segment is removed from said first slide segment moves said latch toward said second position." This claim is given its ordinary meaning.

III. SUMMARY JUDGMENT STANDARD

Summary judgment is proper if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c).

The Court must view the facts and draw inferences in the manner most favorable to the non-moving party. *United States v. Diebold, Inc.*, 369 U.S. 654, 655, 82 S.Ct. 993, 994, 8 L.Ed.2d 176 (1962). However, the existence of some alleged factual dispute between the parties will not defeat an otherwise properly supported motion for summary judgment; to defeat the motion, the non-moving party must affirmatively set forth facts showing there is a genuine issue for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248-49, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986). The moving party bears the initial burden of demonstrating the absence of a genuine issue of material fact for trial. *Id.* at 256, 106 S.Ct. at 2514. When the non-moving party bears the burden of proving the claim or defense, the moving party can meet its burden by pointing out the absence of evidence of a genuine issue of material fact from the non-moving party. *Musick v. Burke*, 913 F.2d 1390, 1394 (9th Cir.1990). The moving party need not disprove the other party's case. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323-25, 106 S.Ct. 2548, 2553-54, 91 L.Ed.2d 265 (1986).

When the moving party meets its burden, the "adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party." Fed.R.Civ.P. 56(e). "The mere existence of a scintilla of evidence ... will be insufficient; there must be evidence on which the jury could reasonably find for [the opposing party]." *Anderson*, 477 U.S. at 252, 106 S.Ct. at 2512.

IV. INVALIDITY

A patent is presumed valid. 35 U.S.C. s. 282. "Because a patent issued by the U.S. Patent and Trademark Office is presumed to be valid ... the evidentiary burden to show facts supporting a conclusion of invalidity is clear and convincing evidence. *Transclean Corp. v. Bridgewood Serv.'s, Inc.*, 290 F.3d 1364, 1370 (Fed.Cir.2002) (citing *WMS Gaming, Inc. v. Int'l Game Tech.'s*, 184 F.3d 1339, 1355 (Fed.Cir.1999)). Since CIS has moved for summary judgment of invalidity, it must satisfy this evidentiary burden at the summary judgment stage. *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 880-81 (Fed.Cir.1998) (stating that "in rendering a decision on a motion for summary judgment, a court must 'view the evidence presented through the prism of the substantive evidentiary burden' that would inhere at trial").

A valid patent must contain in its specification "a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. s. 112 para. 1.

A. Written Description

The "written description" requirement of 35 U.S.C. s. 112 is satisfied if the patent applicant "convey[s] with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed.Cir.1991). CIS alleges that the '954 patent is invalid for lacking an adequate written description that conveys the meaning of the disputed phrases "to inhibit rearward movement of said bearing assembly" and "resilient latch does not move." FN2 However, CIS has produced no evidence that a person of ordinary skill in the art would fail to understand the meaning and scope of these phrases from the specification of the '954 patent. Therefore, CIS has not demonstrated by clear and convincing evidence that the '954 patent is invalid for lack of an adequate

written description.

FN2. CIS states that the '954 patent lacks an adequate written description in the "originally filed '954 patent specification." Br. on Claim Construction for the '954 Patent & Mem. for Invalidity under s. 112 at 17:25-27. It is unclear from the quoted language whether CIS is referring to the specifications of the '954 patent or the specifications of the parent '763 patent. To the extent CIS bases its argument on the disclosure of the '763 patent specification, the argument is misplaced. "For purposes of s. 112 para. 1 ... earlier specifications are relevant only when the benefit of an earlier filing date is sought under 35 U.S.C. s. 120." *Reiffin v. Microsoft Corp.*, 314 F.3d 1342, 1345 (Fed.Cir.2000). Jonathan has not sought the benefit of the earlier filing date of the '763 patent.

B. Enablement

A patent specification must enable a person skilled in the art to make and use the claimed invention without "undue experimentation." *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1334 (Fed.Cir.2003) (citations omitted). "Whether the subject matter of a patent claim satisfies the enablement requirement of 35 U.S.C. s. 112 para. 1 is a question of law based on underlying facts, and, because a patent is presumed to be valid, the evidentiary burden to show facts supporting a conclusion of invalidity is one of clear and convincing evidence." *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1238-39 (Fed.Cir.2003) (citations omitted). CIS argues that the claims of the '954 patent are not enabled because they disclose neither how to "inhibit rearward movement of said bearing assembly" nor the amount of force against which the "resilient latch does not move." However, CIS has presented no evidence that a person of ordinary skill in the art would not be able to make and use the claimed invention based on the disclosure of the '954 patent. Therefore, CIS has not demonstrated by clear and convincing evidence that the '954 patent is invalid for lacking an enabling disclosure.

C. Indefiniteness

A valid patent must contain "one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. s. 112 para. 2. "The statute is satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in the context of the specification." *Marley Mouldings Ltd. v. Mikron Indus., Inc.*, 417 F.3d 1356 (Fed.Cir.2005). CIS argues that the '954 patent is invalid for indefiniteness because the specification does not disclose a manner in which to test the claim that the resilient latch "does not move to said second position in response to a rearward force exerted on said bearing retainer." It notes that the '954 patent does not disclose by what mechanism a rearward force is applied to the bearing retainer. However, CIS has presented no evidence that a person of ordinary skill in the art would not reasonably understand the claim when read in the context of the specification.

CIS also contends that the '954 patent is indefinite because of the "to moves" typographical error in claim 23. As discussed in Part II above, the Court has corrected this phrase by deleting the word "to," so that the corrected phrase reads "wherein said latch includes a first surface, wherein force on said first surface when said second slide segment is removed from said first slide segment moves said latch toward said second position." This correction makes the phrase comprehensible and is not subject to reasonable debate based upon a consideration of the entire claim and the specification. *See Novo Indus., L.P.*, 350 F.3d at 1354. CIS has presented no evidence that the phrase as corrected would not be reasonably understandable to a person of ordinary skill in the art.

Therefore, CIS has not demonstrated by clear and convincing evidence that the '954 patent is invalid for indefiniteness.

D. New Matter

CIS argues that the '954 patent is invalid because it claims new matter not initially disclosed in the parent '763 patent and exceeds "what the inventors regarded as their invention." It bases its argument on the sentence immediately preceding the claims in both the '954 patent and the '763 patent: "Thus, it is intended that the scope of the present invention herein disclosed should not be limited by the particular disclosed embodiments described above, but should be determined only by a fair reading of the claims that follow." '954 Patent, Col. 13:36-40. CIS contends that this sentence is an express limitation on the scope of all claims, and that the inventors intended to limit their invention solely to the claims in the '763 patent. CIS reads too much into this boilerplate language. This language merely sets forth a tenet of claim construction: namely, that although the claims must be read in view of the specification, limitations from the specification are not to be read into the claims. *See, e.g.*, Phillips, 415 F.3d at 1323. Moreover, CIS has failed to prove by clear and convincing evidence that the claims of the '954 patent claim new matter beyond the scope of the '763 patent specification.

Therefore, since CIS has failed to overcome the presumption of the '954 patent's validity by clear and convincing evidence, CIS's motion for summary judgment of invalidity is DENIED.

V. INFRINGEMENT

In response to Jonathan's allegation that CIS has literally infringed the '954 patent, CIS has moved for summary judgment of non-infringement. Jonathan has cross-moved for summary judgment of infringement. "An infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly construed claims to the device accused of infringing." Markman, 52 F.3d at 976. In literal infringement analysis, the court first interprets the asserted claims to determine their meaning and scope and then determines whether the claims read on the accused product. Southwall Tech., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1575 (Fed.Cir.1995). "To establish literal infringement, every limitation set forth in a claim must be found in an accused product, exactly." *Id.* "Although claim construction is a question of law, infringement, either literal or under the doctrine of equivalents, is a question of fact." RF Del., Inc. v. Pac. Keystone Techs., Inc., 326 F.3d 1255, 1266 (Fed.Cir.2003). Thus, summary judgment in this case is appropriate only if no genuine issues of material fact about literal infringement remain. Based on the claim construction of the disputed claims in Part II above, the Court addresses below the parties' cross-motions for summary judgment.FN3

FN3. Before addressing the cross-motions for summary judgment of non-infringement and infringement, the Court deals with CIS's contention that Jonathan's cross-motions should be dismissed on procedural grounds. Specifically, CIS notes that Jonathan's cross-motions were filed after the September 20, 2005 deadline for summary judgment motions set in the Scheduling Order of June 27, 2005, and that Jonathan failed to file a Notice of Motion and proposed Findings of Fact and Conclusions of Law, as required by Local Rules 7-3 and 56-1. CIS also asserts that Jonathan has violated Local Rule 26-4 by using duplicative exhibit numbers. The Court will not dismiss Jonathan's cross-motions on procedural grounds because Jonathan did not raise new motions, but rather filed these cross-motions in its opposition to CIS's motion for summary judgment of non-infringement. The Court similarly refuses to dismiss Jonathan's cross-motions because some exhibit numbers are duplicative. Therefore, Jonathan's submission is not violative of the Scheduling Order or Local

1. "to inhibit rearward movement of said bearing assembly"

A reasonable jury could find that the limitation "to inhibit rearward movement of said bearing assembly" reads on CIS's slide assemblies. CIS admitted with respect to the QS1 that "the resilient member thus will lightly hold the bearing retainer in place, so that it will not roll back if the server rack [is] jostled ." Yost Decl. para. 9. Additionally, Jonathan alleges that the slide assemblies it purchased in July 2005 and September 2005 are made and sold by CIS and are similar to the QS1. Opp'n to CIS's Mot. for Summ. J. of Non-Infringement, & Cross-Mot. for Summ. J. of Infringement of Claims 10-23 of U.S. Patent No. 6,820,954 & for Contempt of Prelim. Inj. Order at 1:9-12. Upon physical examination by the Court, this new slide assembly has a resilient latch that inhibits the bearing assembly from rolling back in the channel. Therefore, a reasonable jury could find that CIS slide assemblies have a resilient latch that "inhibits rearward movement of said bearing assembly."

Although CIS is not entitled to summary judgment of non-infringement, Jonathan is not, as a consequence, entitled to a finding that this claim limitation reads on CIS's slide assemblies. The recently acquired slide assemblies that Jonathan asserts are similar to the QS1 appear, upon physical examination, to have a resilient latch that inhibits rearward movement of the bearing assembly. However, CIS asserts that it stopped making and selling the QS1 slide assembly well before the '954 patent issued in November 2004. Decl. of Alfred E. Barry Jr. Re Def. Central Industrial Supply Company's Mot. to Dismiss Claims on the QS1 para. 17, 20. CIS further contends that sales of the QS1 occurred prior to the effective date of the '954 patent and that those sales were made by a foreign affiliate of CIS. Id. at para. 20. CIS maintains that both the QS1 and QS2 are no longer in production, and that a new slide assembly model (different from the slide assemblies recently acquired by Jonathan), which Jonathan has not accused of infringing the '954 patent, has replaced the QS2. Id. at para. 23. Therefore, a genuine issue of material fact exists as to whether CIS has made, used, sold, offered to sell, or imported slide assemblies after the effective date of the '954 patent.

2. "resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer."

A reasonable jury could find that the limitation "resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer" reads on CIS's slide assemblies. Jonathan claims that the recently purchased slide assemblies are similar to the QS1 because they have a latch mechanism that "holds the bearing retainer in place without releasing in response to rearward force on the bearing retainer." Decl. of James C. Brooks in Supp. of Jonathan's Mot. for Contempt, in Opp'n to Def.'s Mot. to Dismiss Claims on the QS1 & in Opp'n to Def.'s Mot. for Summ. J. of Invalidity para. 3. After physically examining these recently purchased slide assemblies, the Court agrees with Jonathan's assessment that the resilient latch in these assemblies, like the resilient latch in the QS1, holds the bearing retainer in place when rearward force is manually applied to the bearing retainer.

With respect to the QS2, which the Court found in the Preliminary Injunction Order had a resilient latch that "did move to the second position due to rearward force on the bearing retainer," there is also a genuine issue of material fact that precludes a finding of summary judgment of non-infringement. Order Granting Prelim. Inj. at 6:19-20. From the evidence presently before the Court, it is unclear whether the movement of the resilient latch in the QS2 is due to a design modification of the latch that allows for movement, or an erosion of the plastic latch from the repeated removal and reinsertion of the inner slide segment by the

parties and the Court in the course of this litigation. Upon visual inspection, the newly purchased slide segments appear to have a bearing retainer and resilient latch that are similar to the bearing retainer and resilient latch of the QS2, yet the resilient latch "does not move" in response to manually applied rearward force on the bearing retainer. CIS claims that it "did not design our resilient release to lock and hold against all force or a large force when inserting the drawer slide members." Decl. of Al Barry in Opp'n to Pl.'s Mot. For a Prelim. Inj. at 7:22-24. However, CIS also states that "[m]ost of the time a server is never removed from a rack other than to replace it, 2-4 years later." Id. at 7:24-25. Therefore, a reasonable jury could find that the claim limitation that the resilient latch "does not move" does read on the QS2, when the QS2 has not been subjected to atypical, repeated removal and reinsertion of the inner slide segment. CIS is not entitled to a finding of non-infringement of this claim limitation.

While CIS is not entitled to a finding of non-infringement on this claim limitation, Jonathan is similarly not entitled to summary judgment of infringement of this claim limitation. First, for the reasons stated above in subsection 1, a genuine issue of material fact remains as to whether CIS has made, used, sold, offered to sell, or imported slide assemblies after the effective date of the '954 patent. Second, as mentioned in the preceding paragraph, a genuine issue remains as to whether the movement of the resilient latch in the QS2 is due to design modification or the atypical, repeated removal and reinsertion of the inner slide segment during the course of this litigation. Therefore, summary judgment of infringement on this claim limitation is inappropriate.

Since genuine issues of material fact remain concerning whether the claim limitations stating "to inhibit rearward movement of said bearing assembly" and "resilient latch does not move to said second position in response to a rearward force exerted on said bearing retainer" read on CIS's slide assemblies, CIS's motion for summary judgment of non-infringement and Jonathan's cross-motion for summary judgment of infringement are DENIED.

For the reasons stated above, CIS's motion to vacate the Preliminary Injunction Order is similarly DENIED.

VI. CONTEMPT

On cross-motion, Jonathan has alleged that CIS has violated the terms of the Preliminary Injunction Order by manufacturing and selling QS1-type Qualslides after the injunction's effective date of February, 7, 2005. As discussed above, there remain unresolved issues of material fact and a reasonable jury could find that the '954 patent does not read on CIS's slide assemblies. Therefore, Jonathan's cross-motion for contempt is DENIED.

VII. DISPOSITION

For the reasons stated above, the disputed claims of the '954 patent are construed as a matter of law as above, all motions by Plaintiff and Defendant for summary judgment are DENIED, and Plaintiff's cross-motion for contempt is DENIED.

IT IS SO ORDERED.

**STIPULATED DISMISSAL WITH PREJUDICE OF ALL CLAIMS BETWEEN JONATHAN
MANUFACTURING CORPORATION AND CENTRAL INDUSTRIAL SUPPLY COMPANY;
[PROPOSED] ORDER**

WHEREAS Jonathan Manufacturing Corporation d/b/a Jonathan Engineered Solutions ("Jonathan") and Central Industrial Supply Company ("CIS") have entered into a Settlement Agreement resolving their differences, and wish to terminate the legal proceedings between them;

NOW THEREFORE, pursuant to and subject to the terms of their Settlement Agreement, Jonathan and CIS each dismiss with prejudice all of their claims, counter claims, allegations and counter-allegations against each other in the above-identified action.

IT IS SO STIPULATED.

IT IS SO ORDERED.

C.D.Cal.,2005.

Jonathan Mfg. Corp. v. Central Indus. Supply Co.

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