

United States District Court,
N.D. California.

UNITED STATES GYPSUM COMPANY,
Plaintiff.

v.

PACIFIC AWARD METALS INC,
Defendant.

No. C 04-04941 JSW

Nov. 8, 2005.

David Leon Bilsker, Howrey LLP, East Palo Alto, CA, Benjamin Kneeland Riley, Howrey LLP, San Francisco, CA, Michael M. Geoffrey, Chief Intellectual Property Counsel USG Corporation, Michael P. Padden, Thomas Wayne Jenkins, Jr., Howrey, Simon, Arnold & White, Chicago, IL, for Plaintiff.

M. Patricia Thayer, Heller Ehrman, LLP, San Francisco, CA, Colbern C. Stuart, III, Nicole Sara Cunningham, Heller Ehrman, LLP, San Diego, CA, James Roy Knox, Heller Ehrman, LLP, Menlo Park, CA, Warren J. Rheaume, Heller Ehrman White & McAuliffe, LLP, Seattle, WA, for Defendant.

CLAIM CONSTRUCTION ORDER

JEFFREY S. WHITE, District Judge.

The Court held a claim construction hearing to construe the disputed claim terms of U.S. Patent No. 5,131,198 (the "'198 Patent") pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), on November 2, 2005. Having carefully reviewed the parties' papers, heard the parties' arguments, and considered the relevant legal authority, the Court will now construe the disputed claim terms within the '198 Patent.

BACKGROUND

Plaintiff United States Gypsum Company ("USG") seeks to prevent Defendant Pacific Award Metals, Inc. ("Award") from infringing the '198 Patent. The '198 Patent relates to corner beads for drywall construction and particularly to corner beads having an outer paper layer. ('198 Patent, col. 1, ll. 9-11.)

The parties dispute two terms: "protective coating" FN1 and "said protective coating penetrating some of the fibers of said front paper layer and having a thickness on the front surface of said front paper layer of about 0.001 to 0.005 inches."

FN1. There is a typographical error in claim 1 of the '198 Patent referring to a "protected coating." ('198 Patent, col. 4, l. 58). The parties agree that this reference should be construed as "protective coating." (Joint

ANALYSIS

A. Legal Standard.

"It is a bedrock principle of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude." *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed.Cir.2004). The interpretation of the scope and meaning of disputed terms in patent claims is a question of law and exclusively within the province of a court to decide. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). The inquiry into the meaning of the claim terms is "an objective one." *Innova/Pure Water*, 381 F.3d at 1116. As a result, a court undertaking the construction of disputed terms "looks to those sources available to the public that show what a person of skill in the art would have understood the disputed claim language to mean." *Id.* In most cases, a court's analysis will focus on three sources: the claims, the specification, and the prosecution history. *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). However, on occasion, reliance on extrinsic evidence regarding the relevant scientific principles, the meaning of technical terms, and the state of the art at the time the patent issued is appropriate.

The starting point of the claim construction analysis is an examination of the specific claim language. A court's "claim construction analysis must begin and remain centered on the claim language itself, for that is the language that the patentee chose to particularly point out and distinctly claim the subject matter which the patentee regards as his invention." *Innova/Pure Water*, 381 F.3d at 1116 (internal quotations and citations omitted). Indeed, in the absence of an express intent to impart a novel meaning to a term, an inventor's chosen language is given its ordinary meaning. *York Prods., Inc. v. Cent. Tractor Farm & Family Center*, 99 F.3d 1568, 1572 (Fed.Cir.1996). Thus, "[c]laim language generally carries the ordinary meaning of the words in their normal usage in the field of the invention." *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1367 (Fed.Cir.2003) ("Claim language generally carries the ordinary meaning of the words in their normal usage in the field of invention."); *see also Renishaw v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed.Cir.1998) (recognizing that "the claims define the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim"). A court's final construction, therefore, must accord with the words chosen by the patentee to mete out the boundaries of the claimed invention.

A court also may look to intrinsic evidence, including the written description, the drawings, and the prosecution history, if included in the record, to provide context and clarification regarding the intended meaning of the claim terms because the claims do not stand alone. *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324-25 (Fed.Cir.2002). Rather, "they are part of 'a fully integrated written instrument.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed.Cir.2005) (en banc) (quoting *Markman*, 52 F.3d at 978). The specification "may act as a sort of dictionary, which explains the invention and may define the terms used in the claims." *Markman*, 52 F.3d at 979. The specification also can indicate whether the patentee intended to limit the scope of a claim, despite the use of seemingly broad claim language. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed.Cir.2001) (recognizing that when the specification "makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question").

Intent to limit the claims can be demonstrated in a number of ways. For example, if the patentee "acted as his own lexicographer," and clearly and precisely "set forth a definition of the disputed term in either the specification or the prosecution history," a court will defer to that definition. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed.Cir.2002). All that is required to so limit the claims is for the patentee to set out the alternative meaning in the specification "in a manner sufficient to give one of ordinary skill in the art notice of the change from ordinary meaning." *Innova/Pure Water*, 381 F.3d at 1117. In addition, a court will adopt an alternative meaning of a term "if the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention." *CCS Fitness*, 288 F.3d at 1367. Likewise, the specification may be used to resolve ambiguity "where the ordinary and accustomed meaning of the words used in the claims lack sufficient clarity to permit the scope of the claim to be ascertained from the words alone ." *Teleflex*, 299 F.3d at 1325.

However, limitations from the specification (such as from the preferred embodiment) may not be read into the claims, absent the inventor's express intention to the contrary. *Id.* at 1326; *see also CCS Fitness*, 288 F.3d at 1366 ("[A] patentee need not 'describe in the specification every conceivable and possible future embodiment of his invention.' "); *Virginia Panel Corp. v. MAC Panel Co.*, 133 F.3d 860, 866 (Fed.Cir.1997) ("[I]t is well-settled that device claims are not limited to devices which operate precisely as the embodiments described in detail in the patent."). To protect against this result, a court's focus should remain on understanding how a person of ordinary skill in the art would understand the claim terms. *Phillips*, 415 F.3d at 1323.

If the analysis of the intrinsic evidence fails to resolve any ambiguity in the claim language, a court then may turn to extrinsic evidence, such as expert declarations and testimony from the inventors. *Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1367 (Fed.Cir.2003) ("When an analysis of *intrinsic* evidence resolves any ambiguity in a disputed claim term, it is improper to rely on extrinsic evidence to contradict the meaning so ascertained.") (emphasis in original). When considering extrinsic evidence, a court should take care not to use it to vary or contradict the claim terms. Rather, extrinsic evidence is relied upon more appropriately to assist in determining the meaning or scope of technical terms in the claims. *Vitronics Corp. v. Conception, Inc.*, 90 F.3d 1576, 1583 (Fed.Cir.1996).

Dictionaries also may play a role in the determination of the ordinary and customary meaning of a claim term. The Federal Circuit recently reiterated that "[d]ictionaries or comparable sources are often useful to assist in understanding the commonly understood meanings of words" *Phillips*, 415 F.3d at 1322. The *Phillips* court, however, also admonished that district courts should be careful not to allow dictionary definitions to supplant the inventor's understanding of the claimed subject matter. "The main problem with elevating the dictionary to ... prominence is that it focuses the inquiry on the abstract meaning of the words rather than on the meaning of claim terms within in the context of the patent." *Id.* at 1321. Accordingly, dictionaries necessarily must play a role subordinate to the intrinsic evidence.

In addition, a court has the discretion to rely upon prior art, whether or not cited in the specification or the file history, but only when the meaning of the disputed terms cannot be ascertained from a careful reading of the public record. *Vitronics*, 90 F.3d at 1584. Referring to prior art may make it unnecessary to rely upon expert testimony, because prior art may be indicative of what those skilled in the art generally understood certain terms to mean. *Id.*

B. Claim Construction.

1. "Protective coating"

Claim 1 of the '198 Patent claims a corner bead for drywall construction comprising, *inter alia*, "a thin [protective] coating on said front paper layer." ('198 Patent, col. 4, l. 58.) FN2 USG proposes that the term "protective coating" be construed as: "The material applied to the front paper layer to reinforce the fibers and provide surface protection against abrasion ." Award proposes that the term be construed as: "Material that is applied to the outer surface of the front paper layer and that guards against abrasion." Each of the parties' proposed constructions of this term attempts to describe the purpose or function of the "protective coating."

FN2. *See* note 1, *supra*.

Although the claim language is silent on this point, the specification is not. In the Detailed Description of the Invention section, the patentee states that "a center band **16** of a protective coating is applied to the outer face of the cover strip **12**, and a pair of bands **17** of a protective coating is applied to the portions of the outer face of the cover strip **13**" (*Id.*, col. 3, ll. 22-26.) In the Summary of the Invention section, the patentee states that "[t]he portion of the paper layer covering and adjoining each shoulder is provided with a protective coating making it far more resistant to scuffing during the sanding operation in preparation for painting." (*Id.*, col. 2, ll. 18-23.)

As further set forth in the specification, "[t]he bands **16, 17** of protective coating preferably result from treatment of the outer paper layers **12, 13** (**12'**, **13'**) with a material which penetrates the fibers of the paper to reinforce the paper and provide surface protection against abrasion." (*Id.*, col. 3, ll. 43-47.) The patentee also states that when the corner bead is sanded, "the protective bands **16, 17** prevent adverse scuffing of the paper **12** covering the corner rib **10 a** and the paper **13** covering the rounded nose **11 a** adjacent the shoulders **11 b**." (*Id.*, col. 4, ll. 24-28 (describing nail-on corner beads); *see also id.* at col. 4, ll. 41-43 ("the protective bands **16', 17'** prevent adverse scuffing of the outer paper layers **12', 13'**) (describing tape-on corner beads).) FN3

FN3. The terms "protective coatings" and "protective bands" are used interchangeably. (*See, e.g.*, '198 Patent, col. 4, ll. 42-49.)

In light of the fact that the claim language is silent on the purpose of the "protective coating," the Court reads the claims "in view of the specification of which they are a part." Phillips, 415 F.3d at 1315 (quoting Markman, 52 F.3d at 979). It is evident from the specification that the protective coating is designed to reduce scuffing of the paper layer. Award argues that the Court should not construe this term to include the reference to reinforcing the fibers because that language refers only to a preferred embodiment. USG argues that this language is not merely a preferred embodiment but is, in fact, a requirement of the invention.

Award is correct that, in general, the Court should not limit a claim term to the preferred embodiment. *See* Teleflex, 299 F.3d at 1326; *accord* Astrazeneca A.B. v. Mutual Pharmaceutical Co., 384 F.3d 1333, 1340 (Fed.Cir.2004). However, "the patentee's choice of preferred embodiments can shed light on the intended scope of the claims." Astrazeneca, 384 F.3d at 1340. If the specification stated that the material penetrated the fibers of the paper *preferably* to reinforce the paper and provide surface protection against abrasion,

Award's argument on this point would be more persuasive. However, the term "preferably" modifies the entire phrase that it precedes. (*See* '198 Patent, col. 3, ll. 43-47 ("[t]he bands of protective coating *preferably* result from treatment of the outer paper layers with a material that penetrates the fibers of the paper and provide surface protection against abrasion.") (emphasis added).) Award concedes that in *all* embodiments the protective coating must penetrate the paper layer.

In the Court's view, and considering the context of the overall purpose of the protective coating, *i.e.* to make the paper layer more resistant to scuffing during sanding, this language explains the import of the penetration limitation and the scope of the claims. By penetrating the paper layer, the protective coating both reinforces the paper and provides surface protection against abrasion. The Court is mindful that it should not read a limitation from the specification into the claims. However, the Court does not concur with Award's view that the language discussed in the preceding paragraph refers only to a preferred embodiment but rather views this language as evidence that the patentee viewed that particular embodiment as important to the invention. *See* CCS Fitness, 288 F.3d at 1367. Therefore, reading the claims "in view of the specification of which they are a part," the Court construes the term "protective coating" to mean: **"The material applied to the front paper layer to reinforce said front paper layer and to provide surface protection against abrasion."**

2. "[S]aid protective coating penetrating some of the fibers of said front paper layer and having a thickness on the front surface of said front paper layer of about 0.001 to 0.005 inches."

This phrase also appears in claim one of the '198 Patent and further describes the protective coating limitation. USG asks the Court to construe it as one phrase that means: "The protective coating penetrates some of the fibers at the surface of the front paper layer and has a total thickness of about 0.001 to 0.005 inches, including the penetration depth." Award asks the Court to construe the phrase in two parts as follows: "(1) The protective coating enters some of the spaces between the fibers of the front paper layer;" and (2) "The protective coating has a layer or film of about 0.001 to 0.005 inches adjoining, and measured from, the outer surface of the front paper layer."

The parties agree that the protective coating penetrates the surface of the front paper layer. The Court concludes that no further construction of the term "penetrate" is required and declines Award's request to parse the phrase to construe it. The true dispute between the parties rests on the construction of the thickness limitation.

As set forth above, USG contends that the "thickness" of the protective coating includes any material that has penetrated into the surface of the paper layer. USG argues that the thickness must be measured to include material that has penetrated the paper because the patent contemplates a unitary protective coating. USG acknowledged, however, that at least some of the protective coating acts as a barrier, *i.e.* there is some portion of the protective coating that rests on the surface of the front paper layer. Award contends that the "thickness" limitation refers only to protective coating that rests above or on top of the surface of the paper layer.

Award's proposed construction is supported by the plain language of the claim. The claim language reads: "said protective coating ... having a thickness on the front surface of said front paper layer of about 0.001 to 0.005 inches." ('198 Patent, col. 4, ll. 61-64 (emphasis added).) USG argues that the term "on" refers to a location, *i.e.* the protective coating is located "on" the front surface of said front paper layer. However, the limitation in question refers to the *thickness* of the protective coating and from where that thickness is to be

measured. The claim language suggests that the thickness limitation is to be measured by excluding any of the material that has penetrated into surface of the front paper layer.

The Court also reads the claims in light of the specification. Phillips, 415 F.3d at 1315 (quoting Markman, 52 F.3d at 979). The portion of the specification that describes the thickness limitation reads as follows: "When the coating has dried, the surface of the paper area to which the coating material has been applied will normally have an acrylic *film or layer about 0.001 inches in thickness.*" ('198 Patent, col. 3, ll. 54-57 (emphasis added).) The patentee also stated that "[t]his *surface film or layer* can be increased in *thickness* to about 0.005 inches by using a suitable primer sealer for the protective coating." (*Id.*, col. 3, ll. 58-60 (emphasis added).) Thus the specification supports a conclusion that once the protective coating penetrates the surface of the paper layer and dries, it leaves a film or layer that forms a barrier on that surface, which can vary in thickness depending upon the type of material used.

Similarly, the drawings depict the bands of protective coating as lying on top of the paper layers, creating a barrier, and do not contradict the concept of a unitary protective coating because the drawings also show the penetration of the protective coating into the paper layers. (*See, e.g.*, ' 198 Patent, figs. 2, 4, 5, 6.)

Accordingly, the Court construes the term "said protective coating penetrating some of the fibers of said front paper layer and having a thickness on the front surface of said front paper layer of about 0.001 to 0.005 inches," to mean: "**The protective coating penetrates some of the fibers at the surface of the front paper layer and measures about 0.001 to 0.005 inches in thickness on the front surface of said front paper layer, said thickness excluding penetration depth of said protective coating.**"

CONCLUSION

Based on the analysis set forth above, the Court adopts the foregoing constructions of the disputed terms. The parties are ordered to submit a further joint case management report pursuant to Patent Standing Order para. 13 within 21 days of the filing of this Order.

IT IS SO ORDERED.

N.D.Cal.,2005.

U.S. Gypsum Co. v. Pacific Award Metals Inc.

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