United States District Court,
W.D. Texas, San Antonio Division.

JOHN MEZZALINGUA ASSOCIATES, INC., d/b/a/ PPC, Inc,
Plaintiff.
v.
PCT INTERNATIONAL, INC,
Defendant.

No. SA-05-CV-1002-RF

Dec. 20, 2006.

Harold L. Buddy Socks, Glast, Phillips & Murray, P.C., San Antonio, TX, Mark C. Enoch, Glast, Phillips & Murray, P.C., Dallas, TX, Roy C. Breedlove, Scott R. Zingerman, Todd A. Nelson, Fellers, Snider, Blankenship, Bailey & Tippens, P.C., Tulsa, OK, for Plaintiff.

John C. Cave, Miguel Villarreal, Jr., Ted D. Lee, Gunn & Lee, PC, San Antonio, TX, for Defendant.

ORDER CONSTRUING U.S. PATENT NO. 6,716,062 **CLAIM TERMS**

ROYAL FURGESON**, District Judge.**

BEFORE THE COURT is Plaintiff's Opening Claim Construction Brief (Docket No. 29), filed July 25, 2006; Defendant's Response (Docket No. 33), filed August 10, 2006; Defendant's Opening Claim Construction Brief (Docket No. 30), filed July 25, 2006; and Plaintiff's Response (Docket No. 32), filed August 10, 2006. The parties appeared before the Court in a *Markman* hearing on this matter on August 31, 2006. Upon thorough consideration of the proficient written briefing and oral arguments of both parties, the Court ORDERS the following claim constructions:

(1) The parties agreed on the unambiguous nature of the term "plurality of cable engagement members" in claim 27 of U.S. Patent No. 6,716,062 ("the ' 062 Patent"), and, therefore, the Court need not construe this term.

(2) The term "a metal shaft surrounding said port" in claim 27 of the '062 Patent shall be construed as "The externally threaded stub shaft of the port."

(3) The term "F-type connector" in claim 27 of the '062 Patent shall be construed as "a coaxial radio frequency (RF) cable connector commonly used in cable television applications."

(4) The term "a port on video equipment" in claim 27 of the '062 Patent shall be construed as "Any conventional video port including a center conductor (or contact(s)) for receiving the center wire of a coaxial radio frequency (RF) cable, the center conductor is surrounded by an externally threaded hollow stub

shaft."

(5) The term "a rest position" in claim 27 of the '062 Patent shall be construed as "The location of the nut with respect to the planar contact surface of the cable engagement member before the nut is screwed onto the shaft."

(6) The term "limited axial movement" in claim 27 of the '062 Patent shall be construed as "Movement between a first, or rest position, and a second position, wherein the nut is axially displaced by a maximum distance from the rest position."

(7) The term "spring means biasing said nut toward said rest position" in claim 27 of the '062 Patent shall be construed using a means-plus-function analysis as " *Structure:* a coil spring" and " *Function:* biases the nut toward the rest position."

(8) The term "coil spring" in claim 28 of the '062 Patent shall be construed as "An elastic body compressible between portions of the nut and one of the cable engagement members."

BACKGROUND

This case arises under federal patent law. Plaintiff John Mezzalingua Associates, Inc. d/b/a/ PPC, Inc. ("PPC") owns the '062 Patent and accuses Defendant PCT International, Inc. ("PCT") of patent infringement under 35 U.S.C s.s. 271 and 281-285. Specifically, Plaintiff asserts that certain F-type connectors sold by Defendant, including Defendant's model numbers TRS-59, TRS-HE, TRS-6 and TRS-6P, infringe independent claim 27 and dependant claim 28 of Plaintiff's '062 Patent. Defendant contends that it made proper use of its rights under its own patent, U.S. Patent No. 6,712,631 ("the '631 Patent").

In its most basic form, Plaintiff's '062 Patent, entitled "Coaxial Cable F Connector with Improved RFI Sealing," seeks to improve typical F-type connectors used for cable television boxes. FN1 An F-type connector is a type of coaxial cable connector used to link coaxial cable between various electronic devices, including television, cable television ("CATV") boxes, and computer modems. FN2 As a result of high labor costs incurred when installing cable connectors, manufacturers of coaxial connectors seek to design connectors that ensure a long-term, reliable, and easy connection. FN3 The purpose of the ' 062 Patent is to improve the engagement of the Radio Frequency Interface ("RFI") seal of F-type connectors against the connector face. FN4 This improved RFI seal lessens noise ingress that would otherwise degrade the coaxial cable signal. FN5 The ' 062 Patent achieves this lessened noise ingress by introducing an F-type connector with a coil spring that reduces the number of rotations needed to fully join the connector and the port, thereby ensuring a simpler and improved connection. FN6

Defendant's '631 Patent provides another solution to the same noise ingress problems that Plaintiff's '062 Patent attacks. Defendant's '631 Patent consists of an internally locking coaxial connector with a modified female connector providing continuous tension to prevent loosening during use. FN7 The coaxial cable connector provides consistent pressure by utilizing a lock washer in its female connector.FN8 This lock washer applies a constant tension against a mated male connector to reduce or prevent the connection from loosening due to excessive vibration and thermal cycling. FN9

The '062 Patent contains thirty-three separate claims. Two claims, 27 and 28, contain the terms that are at issue in this case. While the parties originally disagreed over eight terms, they have since stipulated to

agreed constructions for the terms "plurality of cable engagement members" and "metal shaft surrounding said port." The following six terms underlined in claims 27 and 28 of the '062 Patent remain in dispute:

[Claim 27:] An *F-type connector* for mounting upon a prepared terminal end of a coaxial cable to permit electrical connection of said cable to *a port on video equipment* by threaded engagement of said connector and a metal shaft surrounding said port, said connector comprising:

a) a plurality of cable engagement members secured to said terminal end, one of said engagement members having a planar surface in perpendicular, surrounding relation to said terminal end;

b) a nut having internal threads matable with external threads of said shaft, said nut being mounted to said engagement members for free rotation and *limited axial movement* from *a rest position* in a first direction with respect to said engagement members; and

c) *spring means biasing said nut toward said rest position*.

[Claim 28:] The connector of claim 27 wherein said spring means comprise a *coil spring* compressible between portions of said nut and said one of said engagement members.FN10

As fully discussed below, the parties propose differing constructions for these disputed claims.

A. F-TYPE CONNECTOR

First, regarding the term "F-type connector," Defendant urges the court to define the term as "a connector with an internally threaded nut, a flanged post, a deformable body and an internally tapered compression ring." FN11 Defendant asserts that the specification of the ' 062 Patent defines "F-type connector" in terms of conventional prior art F-type connectors. Specifically, the specification recites that F-type connectors are comprised of the elements of a body, a nut, and a compression ring, to which the '062 F-type connector added the coil spring.FN12 Accordingly, Defendant adopts the aforementioned construction regarding the F-type connector.

Plaintiff urges that the plain, ordinary meaning of the term "F-type connector" is defined by the dictionary as "a two conductor (signal wire and ground) coaxial radio frequency (RF) cable connector commonly used for cable television (CATV), satellite television, and cable modem applications." FN13 Moreover, Plaintiff believes that Defendant's construction of this claim improperly imports limitations from the specification and the preamble, resulting in redundancy in later claims. Rather than having limiting effect, the "F-type connector" language in the preamble merely uses a "convenient label" rather than a restricting term.FN14 With this assertion, Plaintiff defaults to the dictionary definition of F-type connector.

B. A PORT ON VIDEO EQUIPMENT

Noting that the construction of this term is essential to this case, Defendant requests that the Court construe "a port on video equipment" to mean "a conventional video port that has a male threaded stub shaft, and for which six or seven full revolutions of the nut of a conventional F-type connector are required to bring the leading surface of the conventional F-type connectors post into contact with the end of the stub shaft." FN15 Defendant explains the reasoning for this precise definition by raising a hypothetical situation wherein "Port X" requires only two turns for a stub shaft connection and "Port Y" requires seven turns for a stub shaft connection.FN16 Even using the exact same F-type connector, each port would require a different

number of turns. Thus, one could assert patent infringement on an F-type connector patented for two rotations despite the fact that the F-type connector may have nothing to do with the connection requiring only two rotations. FN17 Accordingly, Defendant fervently requests that the Court define the specific type of "port on video equipment" to require a six-or-seven-full-revolutions style of port.

In response, Plaintiff argues that the term is rightly construed as "any conventional video port including a center conductor (or contact(s)) for receiving the center wire of a coaxial radio frequency (RF) cable, the center conductor is surrounded by an externally threaded hollow stub shaft." FN18 According to Plaintiff, claim 27 simply recites a "port on video equipment" in the preamble but does not limit the term to a port requiring six or seven full revolutions of the nut. Rather than limiting the port to a number of rotations, the claim mentions the port in the preamble to provide a context for the arrangement of the elements of the F-type connector.FN19 Accordingly, Plaintiff applies the plain and ordinary meaning of the term.

C. A REST POSITION

Defendant cites to the specification for its construction of "a rest position." The Summary of the Invention, which is a part of the specification, states that in the rest position, the nut "is held by the spring prior to threading the nut onto the shaft." FN20 Defendant also contends that the Abstract limits the rest position to the "three turns" requirement and that the detailed description reinforces this definition. Using this reasoning, Defendant construes the term "rest position" to mean "the spring biased position of the nut, with respect to the post, before the spring has been compressed, wherein no more than three turns of the nut are required to establish contact of the post surface and shaft." FN21

Contesting Defendant's construction, Plaintiff notes that paragraph (b) of claim 27 includes neither the term "post" nor the term "spring." As such, Plaintiff contends that Defendant's proposed construction, which defines the rest position to be the spring biased position of the nut with respect to the post before the spring has been compressed, adds unsupported limitations to claim 27. Rather, the term "spring," as introduced in paragraph (c) of claim 27, simply recites a spring means biasing the nut toward a rest position. As such, Defendant's construction of "rest position" would make paragraph (c) effectively redundant. Furthermore, Defendant's "three turns" restriction improperly imports limitations from the preferred embodiment into the claim. Accordingly, Plaintiff defines "rest position" to mean "the position at which the nut comes to a rest or stops in its boundary in a first direction, with respect to the cable engagement members." FN22

D. LIMITED AXIAL MOVEMENT

In proposing a definition for "limited axial movement," Defendant refers to the specification, which explains the coil spring as bearing a nut that is "axially movable to a limited degree." FN23 The specification notes that the nut's movement is limited by the first (or rest) position and the second position, "wherein the nut is axially displaced by a maximum distance from the rest position." FN24 In light of these references, Defendant adopts the definition of "movement between a first, completely uncompressed spring position (or rest position), wherein no more than three turns of the nut are required to establish contact of the post surface and shaft, and a second, maximally compressed-spring position." FN25

Plaintiff adopts its construction of "limited axial movement" from Webster's dictionary. Plaintiff's disagreement over Defendant's construction centers around Defendant's allegedly improper construction of the term "rest position," discussed above. Plaintiff asserts that Defendant employs its construction of the term "rest position" in order to construe "limited axial movement ." Thus, the Court must consider Defendant's construction of "rest position" to effectively determine the correct construction of "limited axial

movement." In any case, however, Plaintiff asks the Court to adopt its dictionary definition of "limited axial movement," reading "the nut is capable of passing from one place or position to another with respect to the cable engagement members along an axis and within a boundary or bound." FN26

E. SPRING MEANS BIASING SAID NUT TOWARD SAID REST POSITION

Defendant contends that claim 27(c) recites a means-plus-function element, requiring the application of 35 U.S.C. section 112, paragraph 6 ("112/6") to construe the disputed term. Defendant proposes a means-plus-function definition consisting of " *Structure:* a multi-looped spring with upper and lower parallel surfaces spaced by a predetermined distance" and " *Function:* biases said nut toward said rest position." FN27 While Defendant acknowledges that the existence of a sufficiently recited structure within the claim may remove the claim from the means-plus-function analysis, Defendant does not believe that such structure exists in this case. Accordingly, Defendant contends that because the term "spring means biasing said nut toward said rest position" fails to provide adequate structure, 112/6 applies and covers the corresponding structures in the specification-here, a multi-looped spring with upper and lower parallel surfaces spaced by a predetermined distance.

Plaintiff contends that the means-plus-function analysis does not apply in this case because the United States Patent and Trademark Office ("U.S.P.T.O.") examined the '062 Patent under the 1999 Guidelines on applying 112/6 rather than the 1994 Guidelines upon which Defendant relies. Specifically, Plaintiff asserts that the 1999 Guidelines require "means for" language in order for 112/6 to apply. Because claim 27 simply does not have the requisite "means for" or "step for" language, the means-plus-function analysis does not apply. As such, Plaintiff proposes a construction of "an elastic body or contrivance that recovers its shape after being compressed, bent, or stretched that biases the nut toward the rest position." FN28

F. COIL SPRING

Defendant refers to its explanation of "multi-looped" in its construction of "spring means" to also support its construction of "coil spring." Defendant would have the Court define "coil spring" to mean "a multi-looped spring with upper and lower parallel surfaces spaced by a predetermined distance." Defendant argues that the correctness of its "coil spring" definition lies in its belief that claim 28 is more narrow than claim 27. More precisely, claim 28 is strictly limited to a coil spring and does not include structural components as does claim 27. Claim 28 is also limited to a coil spring that is "compressible between portion of said nut and one of said engagement members." FN29 This narrower construction of claim 28 renders itself to a definition of coil spring that includes the "multi-looped" components mentioned in the specification.

Plaintiff's construction of "coil spring" focuses on what Plaintiff believes is the plain and ordinary meaning of the terms "coil" and "spring." Referring to its proposed construction of "spring" (an elastic body or device that recovers its shape after being compressed, bent, or stretched), Plaintiff simply adds the dictionary definition of "coil" to the front of the construction. Accordingly, Plaintiff defines "coil spring" as "an elastic body that recovers its shape after being compressed, bent, or stretched that is defined by an individual spiral or ring, or a series of connected spirals or concentric rings." FN30

LEGAL PRINCIPLES GOVERNING CLAIM CONSTRUCTION

A determination of patent infringement requires a two-step analysis. "First, the court determines the scope and meaning of the patent claims asserted ... [Second,] the properly construed claims are compared to the allegedly infringing device." FN31 Step one, claim construction, is an issue of law, wherein the trial judge

determines the scope and meaning of those claims in dispute.FN32 A patent consists of a specification, which includes a detailed description of the invention, and one or more claims that appear at the end of the patent.FN33 Disputes as to the meaning and scope of terms used in the claims are determined based on the claim language, the specification, and the prosecution history.FN34

In construing claims, courts follow a regimented process. Courts first consider the actual words of the claim.FN35 Generally claims should be given their ordinary meaning as understood by a person having ordinary skill in the art.FN36 At all times during the claim-construction analysis, the language of the patent claim controls.FN37 Even though the claim language controls, when claim language is unclear, courts should read claims in view of the patent specification, which includes the written descriptions and drawings, or preferred embodiments.FN38 After the claim language and the specification, a court may consider the prosecution history of the patent to determine proper claim constructions.FN39 Finally, during the claims construction process, courts may also receive guidance from dictionaries and other extrinsic evidence.FN40 Dictionaries may be used as an interpretive aid, but they may not vary or contradict the claim language or the specification.FN41

ANALYSIS

As aforementioned, the parties have stipulated to agreed constructions for the terms "plurality of cable engagement members" and "metal shaft surrounding said port." With these two terms defined, the Court must still construe the terms "F-type connector," "a port on video equipment," "a rest position," "limited axial movement," "spring means biasing said nut toward said rest position," and "coil spring." The Court provides its constructions in the headings below and explains the reasoning for its claim constructions in turn.

A. F-type Connector: "A COAXIAL RADIO FREQUENCY (RF) CABLE CONNECTOR COMMONLY USED IN CABLE TELEVISION APPLICATIONS."

The term "F-type connector" arises in the preamble of claim 27. The parties dispute the limiting effect of the preamble phrase "F-type connector." Defendant asserts that the preamble phrase should be given limiting effect, requiring a construction of claim 27's F-type connector that is limited to the preamble's breadth. Plaintiff contends that "F-type connector" is merely a convenient label and therefore does not demand limiting effect.

It should come as no surprise that determining the extent to which a claim's preamble substantively limits a patent's breadth is arguably "one of the most perplexing questions in patent law." FN42 The dominant decision for determining the limiting effects of a claim's preamble, *Kropa v. Robie,* FN43 provides neither a litmus test nor a clear analytic framework for evaluation preambles. After reviewing almost forty cases that turned on the limiting nature of preambles, the court in *Kropa* summarized its findings on preamble interpretation:

It appears that the preamble has been denied the effect of a limitation where the claim or count was drawn to a structure and the portion of the claim following the preamble was a self-contained description of the structure not depending for completeness upon the introductory clause.... In those cases, the claim or count apart from the introductory clause completely defined the subject matter, and the preamble merely stated a purpose or intended use of that subject matter. On the other hand, in those ... cases where the preamble to the claim ... was expressly or by necessary implication given the effect of a limitation, the introductory phrase was deemed essential to point out the invention defined by the claim or count. In the latter class of

cases, the preamble was considered necessary to give life, meaning, and vitality to the claims or counts.FN44

In making these findings, *Kropa,* at least implicitly, involved a two-step approach to preamble analysis.FN45 First, the court looked at how the preamble defined the invention and the invention's subject matter. Second, the court determined if the preamble was a limitation. Most courts following *Kropa,* however, have skipped the first step, resulting in unclear preamble-construction case law.FN46 In the interest of clarity and thoroughness, the Court will proceed through both prongs of the *Kropa* analysis.

1. Preamble's definition of invention and invention's subject matter.

The preamble of claim 27 defines the invention as "[a]n F-type connector for mounting upon a prepared terminal end of a coaxial cable to permit electrical connection of said cable to a port on video equipment by threaded engagement of said connector and a metal shaft surrounding said port, said connector comprising...." FN47 Accordingly, the invention's subject matter is essentially an F-type connector that connects to a video equipment port. FN48 The whole invention in claim 27 reveals a spring within the F-type connector that ensures an easier and more secure RFI seal.FN49 It is under this definition and with this purpose in mind that the Court must determine the limiting effects of the preamble terms.

2. Limiting effects of the preamble term "F-type connector."

The Court believes that the preamble term "F-type" recites essential elements of the invention and should thus be given limiting effect under the *Kropa* analysis, but that the phrase "F-type connector" as a whole is not limiting. A limiting effect applies when the preamble term is necessary to give life and meaning to the claims.FN50 Determining the limiting effect of "F-type" requires a brief grammatical interlude. In claim 27, the term "connector" is the claim noun. "F-type" is an introductory modifier to "connector." FN51 The Federal Circuit generally gives limiting effect to introductory modifiers in interpreting a claim because the grammatical purpose of an adjective is to describe the noun.FN52 The rest of the preamble following "connector" is the posterior modifier.FN53 Federal Circuit courts have found that certain phrases in the preamble modify other phrases within the posterior modifier rather than the claim noun.FN54 The Court must determine the extent to which the grammar used in claim 27 limits the type of connector covered by the invention.

Analyzing the grammatical components of the preamble, the Court finds that the introductory modifier "F-type" limits the type of connector covered by claim 27. Defendant asserts that the Court must limit the term "connector" or it would include every type of connector, including B-type connectors, etc. The Court agrees and has no intention of ignoring the introductory modifier of "F-type." In light of the claim, to read the preamble indiscriminately to cover all types of connectors would be divorced from reality. Both the preamble and the specification restrict the limitation to F-type connectors.

The more intriguing question is, therefore, if the claim is limited to a specific kind of F-type connector. While no clear test exists concerning preambles and limiting effects, the Federal Circuit in *Catalina Marketing International, Inc. v. Coolsavings.com, Inc*.FN55 provided some guideposts for determining when a preamble limits a claim.FN56 The Federal Circuit has, for example, given limiting effect to preambles when a preamble phrase: (1) is repeated in the body of the claim, thus providing antecedent basis for the rest of the claim; FN57 (2) recites an additional structure that is emphasized as important by the specification; FN58 (3) was relied on during the patent's prosecution to distinguish the claim from prior art; FN59 (4) is part of Jepson claiming; FN60 or (5) is essential to understand limitations or terms in the claim

body.FN61 On the other hand, the Federal Circuit has denied limiting effect to a preamble when the preamble language: (1) merely provides features of the claimed invention without clear reliance on those features as significant to the patent; FN62 (2) describes the use or purpose of an invention; FN63 or (3) could be deleted without affecting the structure of the claimed invention because the claim body describes the structurally complete invention.FN64

In claim 27 of the '062 Patent, the Court finds that apart from a requirement that the connector be an F-type connector, no further limiting affect need be given to the preamble. The body of claim 27 describes the structurally complete invention and therefore does not require a limitation from the preamble. The body provides that the complete invention contains a plurality of cable engagement members, a nut, and a spring.FN65 If claim 27's preamble adds anything to this detailed description, it is only the intended use of the invention-"for mounting upon a prepared terminal end of a coaxial cable ..."-rather than significant structure. "If the preamble adds no limitations to those in the body of the claim, the preamble is not itself a claim limitation and is irrelevant to proper construction of the claim." FN66 The irrelevance of the term's construction lies in the fact that when the preamble is not limiting, the claim can only be infringed by an apparatus encompassing all of the limitations from the *body* of the claim. FN67

This irrelevance certainly applies here, where the phrase "F-type connector" in the preamble simply provides a descriptive name to the set of limitations listed in the body of the claim.FN68 When the preamble adds nothing, it cannot be considered to give "life, meaning, and vitality" to the claim.FN69 Accordingly, the Court finds that, apart from the requirement that claim 27 be a connector of the F variety, the phrase "F-type connector" has no limiting effect and is therefore insignificant in the claim construction process. To the extent that the parties insist on a construction, the Court will only provide the ordinary definition of "a coaxial radio frequency (RF) cable connector commonly used in cable television applications." FN70

B. A PORT ON VIDEO EQUIPMENT: "ANY CONVENTIONAL VIDEO PORT INCLUDING A CENTER CONDUCTOR (OR CONTACT(S)) FOR RECEIVING THE CENTER WIRE OF A COAXIAL RADIO FREQUENCY (RF) CABLE, THE CENTER CONDUCTOR IS SURROUNDED BY AN EXTERNALLY THREADED HOLLOW STUB SHAFT."

Also part of the preamble, the term "a port on video equipment" invites the same *Kropa* preamble analysis. The invention's subject matter and purpose remain an F-type connector with a spring that biases the nut toward a rest position.FN71 The Court must determine, however, the "life and meaning" provided by the preamble phrase "port on video equipment." FN72

Defendant argues that "port on video equipment" gives meaning to the claims because it serves as an antecedent basis for other claim language. Several Federal Circuit cases indicate that the presence of a cross-reference to the preamble is evidence that the subject matter of the claim cannot be defined without giving effect to the referenced preamble language.FN73 In this situation, courts have determined that the cross-referencing portions of the body derive their antecedent basis from the preamble.FN74 Defendant asserts that the limitations in claim 27(b) of "said shaft" and "said nut" derive antecedent basis from "port on video equipment." The language Defendant refers to, however, derives antecedent meaning from other terms-namely, "metal shaft" in the preamble and "a nut" in 27(b)-rather than from "port on video equipment." FN75

As with "F-type connector," the lack of a limiting effect in the preamble renders a construction irrelevant.

The Court is, however, aware that the parties desire that some definition be provided. Upon reviewing the specification and other claims, the Court finds that the only common requirement for a "port on video equipment" is that it function as the connecting point between the coaxial cable and the video equipment.FN76

Defendant additionally argues for the Court to limit the port to one which requires six or seven full rotations, but after carefully reviewing this argument, the Court remains unconvinced that the port must be limited to one requiring such rotations. The Court finds no support in the specification that clearly indicates that the port requires only six or seven rotations.FN77 While it is true that the usefulness of Plaintiff's invention may rely on a port that requires six or seven rotations, no legal requirement commands Plaintiff to draft such a restriction into its patent. Accordingly, Plaintiff's construction of "port on video equipment" appears to comply with the ordinary meaning of the term and requires no further limiting effect.

C. A REST POSITION: "THE LOCATION OF THE NUT WITH RESPECT TO THE PLANAR CONTACT SURFACE OF THE CABLE ENGAGEMENT MEMBER BEFORE THE NUT IS SCREWED ONTO THE SHAFT."

The specification distinctly defines "rest position" and therefore directly supports the Court's construction of the term. Because no language in the claim clearly addresses "a rest position," this question invites the Court to consider the '062 Patent's specification to define the term. Using the specification as a guide to defining claim terms requires application of a common pair of claim construction canons: "(a) one may not read a limitation into a claim from the [specification], but (b) one may look to the [specification] to define a term already in a claim limitation, for a claim must be read in view of the specification of which it is a part." FN78 These two rules provide the general relationship between the specification and the claims.FN79

When terms are not specifically defined in a claim, the specification is the "primary basis for construing the claims" because "the words of the claims must be based upon the description" in the specification.FN80 Noting the importance of the specification, the predecessor court to the Federal Circuit asserted that "[t]he use of the specification as a concordance for the claim is accepted by almost every court, and is a basic concept of patent law." FN81 In the predominant case on claim construction, the Federal Circuit added that "the [specification] may act as a sort of dictionary, which explains the invention and may define terms used in the claims." FN82

Claim 27 uses the term "rest position" twice. The term is first used in claim 27(b), describing the position from which the nut rotates, and again in 27(c) to distinguish the position to which the spring biases the nut:

b) a nut having internal threads matable with external threads of said shaft, said nut being mounted to said engagement members for free rotation and limited axial movement from a *rest position* in a first direction with respect to said engagement members; and

c) spring means biasing said nut toward said *rest position*.FN83

The specification in the '062 Patent acts as a sort of dictionary for the term "a rest position," defining rest position several times. First, in the Summary of the Invention, the rest position is mentioned:

The nut is axially movable to a limited degree with respect to the post (and other elements of the connector) between a first, or *rest position,* in which it is held by the spring prior to threading the nut onto the shaft,

and a second position, wherein the nut is axially displaced by a maximum distance from the rest position.FN84

The nut moves axially away from this rest position.FN85 Essentially, the rest position is where the nut sits naturally-with respect to the other elements-before it is screwed onto a CATV port.

From the specification, the Court knows that the rest position is the location of the nut with respect to the "other elements" before the nut is screwed onto the shaft. As such, the Court need only determine to which "other elements" the term applies. The specification provides that the "other element" is the post. FN86 The Court must be careful, however, to avoid adding a limitation to claim 27 from the specification.FN87 Instead of a post, claim 27 mentions only a plurality of cable engagement members, one of which has a planar surface.FN88 Accordingly, the Court finds that, based on both the claim language and the specification, a proper construction of "a rest position" requires consideration of the nut's location with respect to the planar contact surface of the cable engagement members.

Defendant requests that the Court incorporate a three-turns-or-less requirement into its construction of "a rest position." In support of this contention, Defendant highlights a sentence in the Abstract stating that "[a] coil spring biases the nut toward a rest position with respect to the other elements wherein not more than three revolutions of the nut into engagement with the shaft are necessary to bring the post of the connector into contact with the shaft...." FN89 The Court, however, feels that this limited revolutions requirement refers to the purpose of the coil spring rather than the definition of "a rest position." Accordingly, the Court will not include such a limitation in its construction of "a rest position."

D. LIMITED AXIAL MOVEMENT: "MOVEMENT BETWEEN A FIRST, OR REST POSITION, AND A SECOND POSITION, WHEREIN THE NUT IS AXIALLY DISPLACED BY A MAXIMUM DISTANCE FROM THE REST POSITION."

Similar to "rest position," the Court looks to the specification to determine the definition of the term "limited axial movement," and again, the specification provides such a definition. The specification explains that the coil spring bears a nut that is "axially movable to a limited degree." FN90 Moreover, the specification notes that the nut's movement is limited by the first, or rest, position and the second position, "wherein the nut is axially displaced by a maximum distance from the rest position." FN91 The maximum distance from the rest position equates to the distance that occurs when adequate rotations maximally compress the spring.FN92

As with "port on video equipment," the Court finds no limitation requiring it to restrict the axial movement to a boundary of three turns as Defendant suggests. Additionally, the Court does not see a need to refer to a dictionary definition, as Plaintiff suggests, when the specification provides an adequate definition. Although the Court may use dictionaries in determining claim constructions issues, "a common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty." FN93 In explaining the use of dictionaries in claim construction, one of the Federal Circuit's predecessor courts stated:

Indiscriminate reliance on definitions found in dictionaries can often produce absurd results.... One need not arbitrarily pick and choose from the various accepted definitions of a word to decide which meaning was intended as the word is used in a given claim. The subject matter, the context, etc., will more often than not lead to the correct conclusion.FN94

The Court will not "arbitrarily pick" a definition when one is already provided by the patent. In light of the specification and the context of the term, the Court adopts the aforementioned claim construction for limited axial movement.

E. SPRING MEANS BIASING SAID NUT TOWARD SAID REST POSITION: " *STRUCTURE:* A COIL SPRING; *FUNCTION:* BIASES THE NUT TOWARD THE REST POSITION"

Determining the correct construction for this claim requires a two-step process. First, the Court must determine if 35 U.S.C. s. 112, para. 6 (112/6) applies and thereby requires the means-plus-function analysis. If 112/6 *does* apply, then the Court follows the guidelines to claim construction specified in the statute: "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." FN95 In following these guidelines, the Court must define both the structure and the function of the disputed claim. If 112/6 *does not* apply, then the Court applies precedent for the construction of limitations in the customary way.

1. The application of 112/6.

In determining the application of 112/6, it seems evident that the means-plus-function analysis does apply and that Plaintiff cannot rebut this presumption. The use of the word "means" in a claim creates a presumption that 112/6 applies.FN96 The presumption is rebuttable, however, in two situations: (1) if the limitation does not recite a function that corresponds to the means; and (2) even when a limitation recites a function, if it also recites a sufficiently definite structure for performing that function.FN97

Primarily, the use of the word "means" in claim 27(c) creates the presumption that 112/6 applies, and other language in the patent supports this presumption. The drafters of the '062 Patent seem to have purposely used the word "means" when they could have just as easily (and perhaps should have) omitted the word. Indeed, the drafters used similar language in other parts of the patent but did not utilize the word "means" in those parts. For example, claim 1 of the ' 062 Patent states "a spring biasing said nut toward said first position...." FN98 The language in claim 1 is almost identical to that of claim 27(c), but notably omits the term "means" from the claim. Although Plaintiff contends that the use of the word "means" is simply a "construct of old terminology," the Court believes that from both a legal and grammatical standpoint, the use of "means" is intentional.

Plaintiff's additional argument-that per the applicable U.S.P.T.O. Guidelines, a claim must recite the words "means for" in order to apply 112/6-also fails.FN99 Applicable law suggests otherwise, indicating that the Federal Circuit is not bound by the U .S.P.T.O. policy determinations and only uses them as a guide to its interpretation of the law.FN100 As such, section 112/6 presumably applies.

While 112/6 applies, Plaintiff can attempt to rebut the presumption, but is defeated on this attempt as well. One can rebut the presumption that 112/6 applies when "a claim recites a function, but then goes on to elaborate sufficient structure, material, or acts within the claim itself to perform entirely the recited function, the claim is not in means-plus-function format." FN101 Plaintiff cites the case of *Watts v. XL Systems, Inc.* FN102 in support of its ability to rebut the 112/6 presumption. The court in *Watts,* however, ruled on the opposite issue to the case at hand. In *Watts,* the disputed claim did *not* have the term "means" and, therefore, no 112/6 existed.FN103 In the present case, we deal with the presumption that 112/6 does apply.

Further, even if Plaintiff had cited a case more closely on point, the rebuttal would still fail. The patent's language suggests that the drafters designed the limitation at issue as a performable function ("biasing said nut toward said rest position") rather than a definite structure. As such, Plaintiff's attempt to rebut the presumption fails and 112/6 applies.

2. Defining Structure and Function.

Because 112/6 applies, the Court must proceed with a 112/6 analysis. The first step in this analysis is to identify the function and the second step is identification of the corresponding structure in the specification. FN104 The parties agree that the function is to bias the nut toward the rest position, so the Court need only concern itself with the structure. FN105

While a patent applicant may choose "means-plus-function" claim language rather than precisely describing the structures of the invention, "that application of the broad literal language of such claims must be limited to only those means that are "equivalen[t]" to the actual means shown in the patent specification." FN106 In defining the structure, a court should construe the limitation "to cover the corresponding structure material, or acts described in the specification and equivalents thereof." FN107 The specification must "clearly link or associate" a definite structure with the claimed function in order to constitute a "corresponding structure." FN108

Defendant refers to the specification to define the corresponding structure as a "multi-looped spring." Plaintiff contends that this definition violates the doctrine of claim differentiation because a coiled spring is the subject of dependent claim 28. To decide the construction for the corresponding structure, the Court must determine the extent to which claim differentiation applies in this context. In its most basic form, the doctrine of claim differentiation reminds us of the old rule of statutory construction, " *Lex rejicit superflua, pugnantia, incongma*." FN109 Claim differentiation instructs that courts must avoid construction of a claim which would render another claim in the patent redundant.FN110 Courts should not import into a claim additional structural limitations present in another claim.FN111

Defendant, however, reminds the Court that the Federal Circuit, in *Laitram Corp. v. Rexnord, Inc.*,FN112 explained that "the judicially developed guide to claim interpretation known as 'claim differentiation' cannot override" the 112/6 rule that means-plus-function claims are limited to structure or steps equivalent to what the patent specification discloses.FN113 As such, Defendant argues that the specification controls over claim differentiation, inviting use of the "multi-looped spring" structure. The Federal Circuit did distinguish *Laitram* in *Wenger Manufacturing, Inc. v. Coating Machinery Systems, Inc*.FN114 In that case, the court commented that while "Laitram held that the stringencies of a means-plus-function limitation are not to be avoided by the mere addition of a dependent claim," it "does not stand for the broader proposition ... that a means-plus-function limitation must be interpreted without regard to other claims." FN115

The intersection of *Laitram* and *Wenger* requires the Court to determine to what extent claim differentiation applies in this context. Only one other claim in the '062 Patent indicates that the patent writers meant to distinguish between a regular spring and a coil spring. Independent claim 1 mentions a spring, and dependent claim 4 adds the concept of a coil.FN116 The Court finds, however, that all of the other uses of the term "spring" in the ' 062 Patent require the addition of a coil. In fact, the ' 062 Patent' s spring is defined as a "coil spring" in the Abstract, both of the preferred embodiments, the Summary of the Invention, the Detailed Description, and claim 12, claim 18, and claim 21. In light of the descriptions of "spring" that the ' 062 Patent provides, the Court believes that this case is the very situation in which *Laitram* instructs the

courts to ignore claim differentiation.

As a policy matter, construing claim 27 in this manner will emphasize the importance of careful patent drafting. To avoid having this claim and future claims narrowed or broadened outside of the drafter's intent, the claim drafter must simply chose language that avoids the application of 112/6. FN117 This cautious drafting will not only further the policy of public notification of patents, but will also aid the courts in reaching just decisions in patent cases.

F. COIL SPRING: "AN ELASTIC BODY COMPRESSIBLE BETWEEN PORTIONS OF THE NUT AND ONE OF THE CABLE ENGAGEMENT MEMBERS."

The Court should construct "coil spring" as a compressible elastic body. As noted, a court should look first to a claim's language in defining a term. Claim 28 notes that the coil spring of the invention is "compressible between portions of said nut and said one of said engagement members." FN118 As such, the claim provides the Court with a definition of the coil spring of the invention. Further, the specification supports this definition. The Summary of the Invention states that "the coil spring ... has opposite ends bearing against the underside of the post flange and a portion of the nut." FN119 As with the phrase "limited axial movement," claim 28's dependence on claim 27 requires that the Court omit the term "post" from a construction of "coil spring." Once replaced with claim 27's "cable engagement members," however, claim 28 and the specification refer to essentially the same structure.

Defendant contends that such a construction violates the definition provided in the specification, specifically by the preferred embodiments. Under claim construction precedent, the specification can define claims 'by implication' such that the meaning may be ascertained by reading the patent documents, such as the preferred embodiments.FN120 Because the ' 062 Patent's preferred embodiments depict only multi-looped coil springs, Defendant maintains that multiple coils are necessary to properly construe the term. Defendant forgets, however, that the Court is not bound by the preferred embodiments. While a court may use patent drawings in construing claims, courts must also remember that patent drawings may illustrate *only* a preferred embodiment and therefore may not limit the claim's scope.FN121 In fact, the Federal Circuit has noted that " 'the number of embodiments disclosed in the specification is not determinative of the meaning of disputed claim terms' and consequently should not be construed as a limitation on those terms." FN122 As a general rule, therefore, the preferred embodiments do not limit claims.FN123 If, however, the specification expressly limits the claims to a specific, preferred version of the invention, this preferred vision will have limiting effect. FN124

The specification in the '062 Patent suggests that the drawings depicted are *only* the preferred embodiments rather than a limiting, preferred vision of the claims.FN125 Although the preferred embodiments depict only multi-looped springs, they do not limit claim 28's "coil spring" to one with multiple loops. In the absence of a specification's clear expression of a specific, preferred vision, the Court will not give limiting effect to the preferred embodiments. Accordingly, the Court finds that claim 28's coil spring may have a single coil or multiple coils, as long as the spring is compressible between portions of the nut and one of the cable engagement members.FN126

CONCLUSION

For the foregoing reasons, the Court ORDERS that the remaining disputed terms be construed in accordance with the discussion above.

The Court ORDERS that:

(1) The term "a metal shaft surrounding said port" in claim 27 of the '062 Patent shall be construed as "The externally threaded stub shaft of the port."

(2) The term "F-type connector" in claim 27 of the '062 Patent shall be construed as "a coaxial cable connector commonly used in cable television applications."

(3) The term "a port on video equipment" in claim 27 of the '062 Patent shall be construed as "Any conventional video port including a center conductor (or contact(s)) for receiving the center wire of a coaxial radio frequency (RF) cable, the center conductor is surrounded by an externally threaded hollow stub shaft."

(4) The term "a rest position" in claim 27 of the '062 Patent shall be construed as "The location of the nut with respect to the planar contact surface of the cable engagement member before the nut is screwed onto the shaft."

(5) The term "limited axial movement" in claim 27 of the '062 Patent shall be construed as "Movement between a first, or rest position, and a second position, wherein the nut is axially displaced by a maximum distance from the rest position."

(6) The term "spring means biasing said nut toward said rest position." in claim 27 of the '062 Patent shall be construed as a means-plus-function as " *Structure:* a coil spring" and " *Function:* biases the nut toward the rest position."

(7) The term "coil spring" in claim 28 of the '062 Patent shall be construed as "An elastic body compressible between portions of the nut and one of the cable engagement members."

It is so ORDERED.

FN1. Coaxial Cable F Connector with Improved RFI Sealing, U.S. Patent No. 6,716,062 col. 1 1.5-50 (filed Oct. 21, 2002) (issued Apr. 6, 2004) [hereinafter '062 Patent].

FN2. Pl.'s Opening Claim Construction Br. (Docket No. 29).

FN3. *Id*.

FN4. '062 Patent col.1 1.5-50.

FN5. Id.

FN6. Id.

FN7. Internally Locking Coaxial Connector, U.S. Patent No. 6,712,631 Abstract (filed Dec. 4, 2002) (issued Mar. 30, 2004).

FN8. Id. at col. 1 l.15-20.

FN9. Id.

FN10. '062 Patent col.10 l.28-45.

FN11. Def.'s Opening Claim Construction Br. (Docket No. 30).

FN12. '062 Patent col.3 l.57-63 (filed Oct. 21, 2002) (issued Apr. 6, 2004) ("It will be immediately recognized by those skilled in the art that the elements of the connector of the present invention generally duplicate those of prior art F connectors, with the addition of the coil spring. That is, prior art connectors of this type include an internally threaded nut, a flanged post, a deformable body and an internally tapered compression ring.").

FN13. Pl.'s Opening Claim Construction Br. (Docket No. 29).

FN14. Pl.'s Resp. (Docket No. 32).

FN15. Def.'s Opening Claim Construction Br. (Docket No. 30).

FN16. *Id*.

FN17. *Id*.

FN18. Pl.'s Resp. (Docket No. 32).

FN19. *Id*.

FN20. '062 Patent col.2 l.17-19.

FN21. Def.'s Opening Claim Construction Br. (Docket No. 30).

FN22. Pl.'s Opening Claim Construction Br. (Docket No. 29).

FN23. '062 Patent col.2 l.15-20.

FN24. Id.

FN25. Def.'s Opening Claim Construction Br. (Docket No. 30).

FN26. Pl.'s Opening Claim Construction Br. (Docket No. 29).

FN27. Def.'s Opening Claim Construction Br. (Docket No. 30).

FN28. Pl.'s Opening Claim Construction Br. (Docket No. 29). Plaintiff also provides the Court with a sealed Exhibit containing a letter from Defendant's internal patent counsel, opining that the "spring means" language did not support the application of section 112. *See id*. at Sealed Ex. H.

FN29. '062 Patent col. 10 l.44-45.

FN30. Pl.'s Opening Claim Construction Br. (Docket No. 29).

FN31. Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454 (Fed.Cir.1998) (en banc) (citations omitted).

FN32. Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1324 (Fed.Cir.2003)(citing Markman v. Westview Instr., 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)).

FN33. Gen. Foods Corp. v. Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1274 (Fed.Cir.1992).

FN34. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996); Markman, 52 F.3d at 979-80. Prosecution history, also referred to as "file history" or "file wrapper," consists of the correspondence

exchanged between the applicant and the U.S.P.T.O. Markman, 52 F.3d at 980. Prosecution history is not, however, helpful in defining the terms presented in this dispute.

FN35. *See* Teleflex, Inc. v. Ficosa N. Am. Corp., 29-9 F.3d 1313, 1324 (Fed.Cir.2002) ("[T]he 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.").

FN36. Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc., 222 F.3d 951, 955 (Fed.Cir.2000).

FN37. York Prods., Inc. v. Cent. Tractor Farm & Family Ctr., 99 F.3d 1568, 1572 (Fed.Cir.1996).

FN38. Markman, 52 F.3d at 979.

FN39. Id. at 980.

FN40. SuperGuide Corp. v. DirecTV Enters., Inc., 358 F.3d 870, 875 (Fed.Cir.2004) ("[D]ictionaries are often helpful in ascertaining the plain and ordinary meaning of claim language.")

FN41. Phillips v. AWH Corp., 415 F.3d 1303, 1321 (Fed.Cir.2005) ("[H]eavy reliance on the dictionary divorced from the intrinsic evidence risks transforming meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification.").

FN42. Stephen P. Koch, Interpreting Claim Preambles: An Analytic Framework, 11 TEX. INTELL. PROP. L.J.. 117, 118 (2002) (citing Willis E. Higgins, *The Significance of Preambles in Chemical Composition Claims,* 49 J. PAT. OFF. SOC'YY 337 (1967)).

FN43. Kropa v. Robie, 38 C.C.P.A. 858, 187 F.2d 150 (C.C.P.A.1951).

FN44. Id. at 152; *see also* Bell Commc'n Research v. Vitalink Commc'n Corp., 55 F.3d 615, 621 (Fed.Cir.1995).

FN45. Koch, *supra* note 42, at 122.

FN46. *Id*.

FN47. '062 Patent col.10 l.28-32.

FN48. Id.

FN49. Id.

FN50. *Kropa,* 184 F.2d at 152.

FN51. "The introductory modifier is an adjective word or phrase that precedes the claim noun." Koch, *supra* note 42, at 124.

FN52. *Id*.

FN53. *Id*. at 123-24 (explaining the grammatical aspects of a claim preamble).

FN54. *See, e.g.,* In re Roshong, 48 C.C.P.A. 787, 285 F.2d 819, 822 (C.C.P.A.1961); Vaupel Textilmaschine n KG v. Euro Italia s.p.a., 944 F.2d 870, 880 (Fed.Cir.1991).

FN55. Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801 (Fed.Cir.2002).

FN56. Id. at 808-11.

FN57. *See* Bell Commc'n Research, 55 F.3d at 620.

FN58. *See* Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257 (Fed.Cir.1989).

FN59. *See* Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1375 (Fed.Cir.2001).

FN60. *See* Epcon Gas Sys., Inc. v. Bauer Compressors, Inc., 279 F.3d 1022, 1029 (Fed.Cir.2002). Although not used in the claims at issue, "[a] Jepson claim [has] two parts. First, the preamble recites the subject matter of the invention and the technical features necessary to define the claimed subject matter but that lie within the prior art. The second, or characterizing, portion of the claim describes the technical features that the invention adds to the prior art." John R. Thomas, *The* Responsibility of the Rulemaker: Comparative

Approaches to Patent Administration Reform, 17 BERKELEY TECH. L.J. 727, 755 (2002).

FN61. Pitney Bowes v. Hewlett-Packard Co., 182 F.3d 1298, 1306 (Fed.Cir.1999).

FN62. *See* STX, LLC v. Brine, Inc., 211 F.3d 588, 591 (Fed.Cir.2000).

FN63. In re Gardiner, 36 C.C.P.A. 748, 171 F.2d 313, 315-16 (1948). The court in *Catalina,* however, noted that in rare instances, statements of intended use in the preamble may limit claims. Catalina Mktg., 289 F.3d at 810.

FN64. IMS Tech., Inc. v. Haas Automation, Inc., 206 F.3d 1422, 1434 (Fed.Cir.2000).

FN65. '062 Patent col. 10 l.33-41.

FN66. Pitney Bowes, 182 F.3d at 1305.

FN67. *See* IMS Tech., 206 F.3d at 1434.

FN68. *Id.*

FN69. *See* Intertool, Ltd. v. Texas Corp., 369 F.3d 1289, 1296 (Fed.Cir.2004).

FN70. The Court may also receive guidance from dictionaries and other extrinsic evidence. SuperGuide Corp. v. DirecTV Enters., Inc., 358 F.3d 870, 875 (Fed.Cir.2004)("[D]ictionaries are often helpful in ascertaining the plain and ordinary meaning of claim language."). Dictionaries may be used as an interpretive aid, but they may not be used to vary or contradict the claim language or the specification. Phillips, 415 F.3d at 1321 ("[H]eavy reliance on the dictionary divorced from the intrinsic evidence risks transforming meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification."). The Court does not believe that referring to the dictionary definition of F-type connector contradicts the claim language or the specification, but provides the plain and ordinary meaning of F-type connector as it is known in the electronics field.

FN71. *See supra* notes 47-49 and accompanying text.

FN72. *See Kropa,* 184 F.2d at 152.

FN73. *See, e.g.,* In re Szajna, 57 C.C.P.A. 899, 422 F.2d 443, 447 (C.C.P.A.1970); Pitney Bowes, 182 F.3d at 1306. For a comparative chart on preamble constructions, see Koch, *supra* note 42, at 144-56.

FN74. *See* Bicon, Inc. v. Straumann Co., 441 F.3d 945, 953 (Fed.Cir.2006) (explaining the use of the antecedent basis for a preamble construction issue).

FN75. '062 Patent col. 10 l.28-39.

FN76. '062 Patent abstract; col.1 l.16-18; col.2 l.6-9; col.6 l.47-51; col.10 l.19-23. For a more detailed discussion of using the specification to define terms, see *infra* notes 78-82 and accompanying text.

FN77. Defendant points to language in the Summary of the Invention which notes that "six or seven full revolutions of the nut are required to bring the annular post surface into contact with the end of the stub shaft...." '062 Patent col.2 l.6-11. Defendant, however, fails to notice that "in the typical case" precedes "six or seven full rotations." Id. The Court believes that the addition of these words provides for a broader definition of "port on video equipment."

FN78. Renishaw PLC v. Marposs Societa'Per Azioni, 158 F.3d 1243, 1248 (Fed.Cir.1998).

FN79. *Id.*

FN80. Standard Oil Co. v. Am. Cyanamid Co., 774 F.2d 448, 452 (Fed.Cir.1985).

FN81. Autogiro Co. of Am. v. United States, 181 Ct.Cl. 55, 384 F.2d 391, 397-98 (Ct.Cl.1966).

FN82. Markman, 52 F.3d at 979.

FN83. '062 Patent col. 10 l.37-42 (emphasis added).

FN84. Id. at col.2 l.17-19 (emphasis added).

FN85. '062 Patent Abstract.

FN86. '062 Patent col. 10 l.17-19.

FN87. *See* Renishaw, 158 F.3d at 1248.

FN88. '062 Patent col. 10 l.33-36.

FN89. Id. at Abstract.

FN90. '062 Patent col.2 l.15-20.

FN91. Id.

FN92. Id.

FN93. Renishaw, 158 F.3d at 1250.

FN94. Liebscher v. Boothroyd, 46 C.C.P.A. 701, 258 F.2d 948, 951 (C.C.P.A.1958).

FN95. 35 U.S.C. s. 112, para. 6(2006).

FN96. *See, e.g.,* Personalized Media Commc'n, LLC v. Int'l Trade Comm'n, 161 F.3d 696, 703-04 (Fed.Cir.1998) ("[C]ases have clarified that use of the word "means" creates a presumption that s. 112, para. 6 applies and that the failure to use the word "means" creates a presumption that s. 112, para. 6 does not apply.").

FN97. *See* id. at 703. Defendant notes, however, that not every recitation of structure automatically removes the claim element from the means-plus-function analysis. For example, the Federal Circuit in *Unidynamics Corp v. Automatic Prod. Int'l Ltd.* held that the claim phrase "spring means tending to keep the door closed" insufficiently provided structural language to remove the element from section 112. Unidynamics Corp. v. Automatic Prod. Int'l, Ltd., 157 F.3d 1311, 1319 (Fed.Cir.1998).

FN98. '062 Patent col.6 l.56-63.

FN99. Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, para. 6, 65 Fed.Reg. 120 (noticed on June 21, 2000) ("If a claim limitation does not include the phrase "means for" or "step for," the examiner will not treat the claim limitation as invoking [112/6]."). The Guidelines note that courts should interpret a claim limitation so as to invoke section 112 if it meets the following three requirements: (1) the claim limitation must use the phrase "means for" or "step for"; (2) the "means for" or "step for" must be modified by functional language, that is, a specified function must be recited; and (3) the phrase "means for" or "step for" must not be modified by structure, material, or acts for achieving the specified function. Interim Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. section 112, paragraph 6 (issued by the USPTO effective July 30, 1999), 64 Fed.Reg. 41, 392 (1999), 58 PAT. TRADEMARK & COPYRIGHT J. . (BNA) 443-45 (Aug. 5, 1999).

FN100. *Enzo Biochem, Inc. v. Gen-Probe, Inc.,* 296 F.3d 1316, 1324 (Fed.Cir.2002) ("The Guidelines, like the Manual of Patent Examining Procedure ... are not binding on th[e] court, but may be given judicial notice to the extent they do not conflict with the statute.").

FN101. Sage Prod., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427-28 (Fed.Cir.1997).

FN102. Watts v. XL Sys., Inc., 232 F.3d 877 (Fed.Cir.2000).

FN103. *Id.*

FN104. *See* 5A DONALD S. CHISUM, CHISUM ON PATENTS s. 18.03[5][d][i].

FN105. The actual infringement will require factfinders to determine if the spring in the accused device is the equivalent of the corresponding spring structure described in Plaintiff's specification as performing that function. *See id.* This question, however, is reserved for later decision.

FN106. Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co., 520 U.S. 17, 28, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997).

FN107. 35 U.S.C. s. 112, para. 6 (2006); *See* Snellman v. Ricoh Co., 862 F.2d 283, 288 (Fed.Cir.1988) (noting that a court must look at the specification to determine the structure claimed to perform the function).

FN108. CHISUM, *supra* note 104, at s. 18.03[5][d][i].

FN109. "The law rejects superfluous, contradictory, and incongruous things." *See* FRANCIS BENNION,

STATUTORY INTERPRETATION s. 316, at 776 (3d ed.1997).

FN110. CHISUM, *supra* note 104, at s. 18.03[6] ("The 'claim differentiation' doctrine is a specific application of the general principle that in construing the language in one claim of a patent, due consideration must be given to the language in other claims in the patent").

FN111. *Id*.

FN112. Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533 (Fed.Cir.1991).

FN113. Id. at 1538 ("We hold that one cannot escape th[e] mandate [of 112/6] by merely adding a claim or claims specifically reciting such structure or structures.").

FN114. Wenger Mfg., Inc. v. Coating Mach. Sys., Inc., 239 F.3d 1225 (Fed.Cir.2001).

FN115. Id. at 1234.

FN116. *Compare* '062 Patent col.6 l.56-63("[A] spring biasing said nut toward said first position ....") *with* '062 Patent col.7 1.6-8 ("The connector of claim 1 wherein said spring is a coil spring....").

FN117. *See* CHISUM, supra note 104, at s. 18.03[5][d][i].

FN118. '062 Patent col.10 l.43-45.

FN119. '062 Patent col.2 l.12-15.

FN120. *See* SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F.3d 1337, 1344 (Fed.Cir.2001) (noting that the preferred embodiments "can provide guidance as to the meaning of the claims, thereby dictating the manner in which the claims are to be construed, even if the guidance is not provided in explicit definitional format").

FN121. Beckson Marine, Inc. v. NFM, Inc., 292 F.3d 718 (Fed.Cir.2002).

FN122. *U.S. Philips Corp. v. Atmel Corp.,* 2004 U.S. Dist. LEXIS 5832, (D.N.Y.2004) (citing *Teleflex, Inc.,*

299 F.3d at 1327).

FN123. CHISUM, *supra* note 104, at s. 18.03[4][c].

FN124. *Id*.

FN125. *See* '062 Patent col.2 l.34-67 (addressing the drawings as only preferred embodiments rather than the limit of the invention).

FN126. Defendant also argues that this construction results in claim 28 having broader effect than claim 27, thus violating the rule that dependent claims must be more limited in scope. The Court's construction, however, complies with these claim construction rules. Whereas the coil spring in claim 27 does not require compression between nut and a cable engagement member, the coil spring in claim 28 does require such compression.

W.D.Tex.,2006.
John Mezzalingua Associates, Inc. v. PCT Intern., Inc.