

United States District Court,  
C.D. California.

**Thomas & Betts International, a Delaware Corporation, and THOMAS & BETTS CORPORATION,  
a Tennessee Corporation,**  
Plaintiffs.

v.

**ORBIT INDUSTRIES, INC., a California Corporation, and United Manufacturing Industries, Inc., a  
California Corporation,**  
Defendants.

No. CV 06-03689 MMM (SSx)

**June 14, 2007.**

Delia Park, Gregory S. Cordrey, Jesse Damon Mulholland, William C. Rooklidge, Howrey LLP, Irvine, CA,  
for Plaintiffs.

Jonathan Hangartner, X-Patents, La Jolla, CA, for Defendants.

## **CLAIM CONSTRUCTION ORDER**

**MARGARET M. MORROW, District Judge.**

This case involves United States Patent No. 5,004, 199 ("the '199 Patent"), which protects a bracket for attaching a metal electrical box to a metal stud. Plaintiff Thomas & Betts International is the assignee of the patent. Plaintiff Thomas & Betts Corporation manufactures and sells products covered by the patent. The two companies (collectively "T & B") filed this action on June 13, 2006, alleging that the "MS series" of steel boxes sold by defendants Orbit Industries, Inc. and United Manufacturing Industries, Inc. (collectively "Orbit") infringe claims 21-22 and 26-27 of the '199 Patent. Pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), this order sets forth the court's construction of disputed terms in the patent claims.

### **I. THE PATENT**

United States Patent No. 5,004, 199 was issued on April 2, 1991. FN1 It protects a bracket for mounting electrical boxes to channel-shaped metal wall studs that have open and closed sides. The bracket has opposed stud gripping elements that enable the bracket to be mounted to studs of different sizes, and to either the open or closed side of the stud.FN2

FN1. United States Patent No. 5,004,199 ("the '199 Patent") at 1.

FN2. *Id.*

## **A. Background Of The Invention**<sup>FN3</sup>

FN3. *Id.*, col. 1, ll. 4-27.

The patent states that the invention is particularly applicable to brackets for mounting electrical boxes to channel-shaped metal wall studs, but can be used to mount electrical boxes to other types of studs as well. The dimensions of channel-shaped metal wall studs are not standardized. In particular, the width of the flanges and the flange lips on the studs vary from one manufacturer to another. Prior to the invention, individuals relied on box mounting brackets of different sizes to accommodate these different wall stud sizes. Additionally, many prior art brackets could be mounted only to the closed or open side of the channel-shaped wall stud.

The patented invention was designed to address the need for a box mounting bracket (1) that mounts to channel-shaped wall studs of different sizes and (2) that can be mounted to either the open or closed side of a wall stud. Rather than stocking brackets of many different sizes, individuals using the patented invention need only stock one bracket capable of attaching to various sized boxes.

## **B. Summary Of The Invention And The Preferred Embodiment**<sup>FN4</sup>

FN4. *Id.*, col. 1, l. 29-col. 2, l. 40.

The patented bracket includes a web with a pair of spaced-apart, opposed flanges extending from it. A metal wall stud may be inserted between the bracket flanges. Each flange includes components that permit it to grip the stud and hold it in place. These components, or "gripping means," comprise a number of sharp barbs that are spaced both longitudinally and transversely of the flanges.

In the preferred embodiment, a resilient arm attaches to the end of the first flange that is remote from the bracket web. This resilient arm extends inward into the space between the two flanges and ends in an "arm terminal end portion." The first flange's gripping means are located on the arm terminal end portion and face toward the second flange. The second flange has a "terminal end" from which "flange extensions" extend. Each flange extension has a number of spaced-apart barbs. The bracket web has a number of spaced-apart holes through which fasteners can be inserted. When extended into a wall stud, these fasteners further secure the mounting of the bracket to the wall stud.

## **C. Claims Of The Invention**

The patent has 28 claims, four of which are asserted against Orbit. These four claims are recited below with the disputed terms underlined.

21. A bracket for mounting electrical boxes to wall studs, said bracket including a web having a pair of spaced-apart opposed *first and second flanges* extending therefrom for receiving a wall stud therebetween, *stud gripping means* on said flanges and extending inwardly thereof for gripping a stud therebetween, said *stud gripping means* on each of said flanges including a plurality of barbs spaced-apart both longitudinally

and transversely thereof. FN5

FN5. *Id.*, col. 7, ll. 52-60.

22. The bracket of claim 21 wherein said first flange has an elongated *resilient arm* connected therewith remote from said web and extending generally along said first flange in inwardly inclined relationship thereto back toward said web, said, arm having an arm terminal end portion located adjacent said web, and said barbs on said first flange being on said arm terminal end portion.FN6

FN6. *Id.*, col. 7, l. 61-col. 8, l. 2.

26. A bracket for mounting electrical boxes to wall studs, said bracket including a web having a pair of *first and second* opposed *flanges* extending therefrom and between which a wall stud is receivable, said first flange having a free end portion remote from said web, a *resilient arm* extending from said free end portion of said first flange back toward said web in inwardly inclined spaced relationship to said first flange, said arm having an arm terminal end portion adjacent said web, and *stud gripping means* on said arm terminal end portion and on said second flange for gripping a stud therebetween, and said *stud gripping means* on said arm terminal end portion comprising a plurality of barbs spaced-apart both longitudinally and transversely of said arm.FN7

FN7. *Id.*, col. 8, ll. 14-28.

27. A bracket for mounting electrical boxes to wall studs, said bracket including a web having a pair of *first and second* opposed *flanges* extending therefrom and between which a wall stud is receivable, said first flange having a free end portion remote from said web, a *resilient arm* extending from said free end portion of said first flange back toward said web in inwardly inclined spaced relationship to said first flange, said arm having an arm terminal end portion adjacent said web, *stud gripping means* on said arm terminal end portion and on said second flange for gripping a stud therebetween, and said *stud gripping means* on said second flange comprising a plurality of barbs spaced-apart both longitudinally and transversely of said second flange.FN8

FN8. *Id.*, col. 8, ll. 28-41.

## II. DISCUSSION

### A. Legal Standard Governing Claim Construction

Patents grant inventors the exclusive right to make and sell their inventions in exchange for full disclosure of the invention. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). "It has long been understood that a patent must describe the exact scope of an invention and its manufacture to 'secure to [the patentee] all to which he is entitled, [and] to apprise the public of what is still open to them.'" *Id.* (quoting *McClain v. Ortmyer*, 141 U.S. 419, 424, 12 S.Ct. 76, 35 L.Ed. 800 (1891)). Two parts of the patent fulfill this function-the specification and the claims. *Id.* The specification must describe the invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same." 35 U.S.C. s. 112. The claims must "particularly point[ ] out and distinctly claim[ ] the subject matter which the applicant regards as his invention." *Id.*

"Victory in an infringement suit requires a finding that the patent claim 'covers the alleged infringer's product or process,' which in turn necessitates a determination of 'what the words in the claim mean.' " *Markman*, 517 U.S. at 374 (quoting H. Schwartz, *Patent Law and Practice* 1, 33 (2d ed.1995) and 3 E. Lipscomb, *WALKER ON PATENTS*, s. 11:2, pp. 288-90 (3d ed.1985)). The Supreme Court's decision in *Markman* clarified that it is the judge, not the jury, who must determine the meaning of the claim terms. *Id.* at 387.

While *Markman* established that judges are to construe the patent claims, it did not specifically address what types of evidence they should consider in doing so. The Federal Circuit first addressed this question in a series of opinions beginning with *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576 (Fed.Cir.1996). To ascertain the meaning of a claim term, the court [must] look [ ] to 'those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean.' " *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed.Cir.2005) (en banc) (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116(Fed.Cir.2004)), cert. denied, 546 U.S. 1170, 126 S.Ct. 1332, 164 L.Ed.2d 49(2006). These sources include "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." *Id.* at 1314; *Innova/Pure Water*, 381 F.3d at 1116. It is important to "read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Phillips*, 415 F.3d at 1313.

## 1. Intrinsic Evidence

Intrinsic evidence is the most important source in construing patent claims. *Vitronics* reiterated the "well-settled" rule "that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history." *Id.* at 1582. The *Vitronics* court described such "intrinsic evidence" as "the most significant source of the legally operative meaning of disputed claim language," *id.*, and recent Federal Circuit opinions confirm this. See *Phillips*, 415 F.3d at 1315 (quoting *Vitronics* ); see also *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 996 (Fed.Cir.2006) ("Our primary focus in determining the ordinary and customary meaning of a claim limitation is to consider the intrinsic evidence of record, viz., the patent itself, including the claims, the specification and, if in evidence, the prosecution history, from the perspective of one of ordinary skill in the art").

Even within the general category of "intrinsic evidence," there are preferences. Initially, a court should look to the words of the claims themselves to define the scope of the patented invention. *Vitronics*, 90 F.3d at 1582. See *Liquid Dynamics v. Vaughan Co.*, 355 F.3d 1361, 1367 (Fed.Cir.2004) ("We examine this intrinsic evidence seriatim. 'We look first to the claim language itself, to define the scope of the patented invention. As a starting point, we give claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art,' " quoting *Dow Chemical Co. v. Sumitomo Chemical Co.*, 257 F.3d 1364, 1372 (Fed.Cir.2001)); *Intellectual Property Development, Inc. v. UA-Columbia Cablevision of Westchester, Inc.*, 336 F.3d 1308, 1314 (Fed.Cir.2003) ("We begin our claim construction analysis with the words of the claim.... In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to particularly point[ ] out and distinctly claim[ ] the subject matter which the patentee regards as his invention" (internal quotations omitted)); *Advanced Cardiovascular v. Medtronic*, 265 F.3d 1294, 1304 (Fed.Cir.2001) ("As always, we begin our construction with the words of the Claim .... After looking to the claim language we consider the rest of the intrinsic evidence, that is, the written description and the prosecution history if in evidence");

Interactive Gift Express, Inc. v. CompuServe Inc., 256 F.3d 1323, 1331 (Fed.Cir.2001) ("First, we look to the claim language").

The words used in the claims are generally given the ordinary meaning they would have to a person skilled in the art.FN9 Phillips, 415 F.3d at 1313 ("We have made clear, moreover, that the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application"); Intellectual Property Development, 336 F.3d at 1314 ("In the absence of an express intent to impart a novel meaning to claim terms, the words are presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art"); see also Tegal Corp. v. Tokyo Electron Am., Inc., 257 F.3d 1331, 1342 (Fed.Cir.2001) ("Throughout the construction process, it is important to bear in mind that the viewing glass through which the claims are construed is that of a person skilled in the art").

FN9. Sometimes, this meaning is the "widely accepted meaning of commonly understood words." Phillips, 415 F.3d at 1314. See also Golden Blount, Inc. v. Robert H. Peterson Co., 365 F.3d 1054, 1059 (Fed.Cir.2004) (noting that "[t]he plain language of the claim [was] relatively straightforward," and that "there [was] nothing to indicate that persons skilled in the art would attribute any other or different meaning" to the term than "its ordinary and customary meaning").

The person of ordinary skill in the art is presumed "to read [a disputed] claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." Phillips, 415 F.3d at 1313; see also Medrad, Inc. v. MRI Devices Corp., 401 F.3d 1313, 1319 (Fed.Cir.2005) ("We cannot look at the ordinary meaning of the term ... in a vacuum. Rather, we must look at the ordinary meaning in the context of the written description and the prosecution history"); V-Formation, Inc. v. Benetton Group SpA, 401 F.3d 1307, 1310 (Fed.Cir.2005) (stating that the intrinsic record "usually provides the technological and temporal context to enable the court to ascertain the meaning of the claim to one of ordinary skill in the art at the time of the invention"); Unitherm Food Sys., Inc. v. Swift-Eckrich, Inc., 375 F.3d 1341, 1351 (Fed.Cir.2004) (the proper definition of a claim term is the "definition that one of ordinary skill in the art could ascertain from the intrinsic evidence in the record").

Frequently, a review of the specification "may reveal a definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." Phillips, 415 F.3d at 1316. See also Interactive Gift Express, 256 F.3d at 1331 (stating that deviation from ordinary meaning may be required where "a patentee [has chosen] to be his own lexicographer and use terms in a manner other than their ordinary meaning," quoting *Vitronics*, 90 F.3d at 1582); FN10 see also Forest Laboratories, Inc. v. Abbott Laboratories, 239 F.3d 1305, 1310 (Fed.Cir.2001) ("The words of a claim are generally given their ordinary and accustomed meaning, unless it appears from the specification or the file history that they were used differently by the inventor"); Biovail Corp. Int'l, v. Andrx Pharmaceuticals, Inc., 239 F.3d 1297, 1301 (Fed.Cir.2001) (quoting *Vitronics* and stating that the court "review[s] both the specification and the applicable prosecution history to determine whether the patentee defined claim terminology in a manner inconsistent with its ordinary meaning"); *Vitronics*, 90 F.3d at 1585 (where the specification clearly and unambiguously defines a claim term, that definition is controlling).

FN10. Where a patentee seeks to depart from the ordinary meaning of a claim term, he must "clearly set forth" or "clearly redefine" the term in the specification so as to put persons reasonably skilled in the art on notice of the intended meaning. *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*,

262 F.3d 1258, 1268 (Fed.Cir.2001) (quoting *Elekta Instrument S.A. v. O.U.R. Scientific International, Inc.*, 214 F.3d 1302, 1307 (Fed.Cir.2000)). See also *Schering Corp. v. Amgen, Inc.*, 222 F.3d 1347, 1353 (Fed.Cir.2000) (stating that the specification must demonstrate an "express intent to impart a novel meaning" to claim terms); *Optical Disc Corp. v. Del Mar Avionics*, 208 F.3d 1324, 1334 (Fed.Cir.2000) ("Without evidence in the patent specification of an express intent to impart a novel meaning to a claim term, the term takes on its ordinary meaning"). An explicit statement of redefinition is not required, however. *Bell Atlantic*, 262 F.3d at 1334; *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1344 (Fed.Cir.2001) (a patentee's description of the preferred embodiment "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"). See also *Astrazeneca AB v. Mutual Pharmaceutical Co.*, 384 F.3d 1333, 1339-40 (Fed.Cir.2004). Stated differently, the specification may define claim terms "by implication" such that the meaning to be given to the terms is "found in or ascertained by a reading of the patent documents." *Vitronics*, 90 F.3d at 1582, 1584 n. 6; see also *Schoenhaus v. Genesco, Inc.*, 440 F.3d 1354, 1358 (Fed.Cir.2006) ("The patentee is free to act as his own lexicographer, and may set forth any special definitions of the claim terms in the patent specification or file history, either expressly or impliedly").

A deviation from the ordinary meaning of a term may also be necessary if a patentee has "relinquished [a] potential claim construction in an amendment to the claim or in an argument to overcome or distinguish a reference." *Interactive Gift Express, Inc.*, 256 F.3d at 1331 (quoting *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 979 (Fed.Cir.1999)). See also *Phillips*, 415 F.3d at 1316 ("[T]he specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive"); *id.* at 1317 ("[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be").

In addition to the specification, the prosecution history is "often of critical significance in determining the meaning of the claims." *Vitronics*, 90 F.3d at 1582. See also *Phillips*, 415 F.3d at 1317 ("In addition to consulting the specification, we have held that a court 'should also consider the patent's prosecution history, if it is in evidence,' " quoting *Markman*, 52 F.3d at 980). "[B]ecause the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Phillips*, 415 F.3d at 1317. Despite this fact, it "can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.*

Thus, the court should look to the prosecution history "to exclude any interpretation that was disclaimed during prosecution." *CVI/Beta Ventures, Inc. v. Turn LP*, 112 F.3d 1146, 1155 (Fed.Cir.1997), cert. denied sub nom. *Marchon Eyewear v. Tura LP*, 522 U.S. 1109, 118 S.Ct. 1039, 140 L.Ed.2d 105 (1998); see also *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed.Cir.2005) ("The purpose of consulting the prosecution history in construing a claim is to 'exclude any interpretation that was disclaimed during prosecution,' " quoting *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1580 (Fed.Cir.1988)); *Intellectual Property Development*, 336 F.3d at 1316 ("We have noted that, like the specification, the prosecution history may demonstrate that the patentee intended to deviate from a term's ordinary and accustomed meaning, i.e., if it shows that the patentee characterized the invention using words or expressions of manifest exclusion or

restriction before the United States Patent and Trademark Office.... The prosecution history limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance"); *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed.Cir.), cert. denied, 516 U.S. 987, 116 S.Ct. 515, 133 L.Ed.2d 424 (1995) (same). The prosecution history of a patent "cannot be used to limit the scope of a claim[, however,] unless the applicant took a position before the PTO that would lead a competitor to believe that the applicant had disavowed coverage of the relevant subject matter." *Schwing GMBH v. Putzmeister Aktiengesellschaft*, 305 F.3d 1318, 1324 (Fed.Cir.2002).

"It is also appropriate to examine the prior art cited in the prosecution history in order to determine what the claims do not and cannot cover." *Vitronics*, 90 F.3d at 1583; see also *Amhil Enter., Ltd. v. Wawa, Inc.*, 81 F.3d 1544, 1560 (Fed.Cir.1996) (because a patent claim cannot be construed to encompass the prior art, "[a]n examination of the prosecution history is particularly important where ... the claimed invention is in a crowded art").

In considering a patent's prosecution history, the applicant's subjective intent is irrelevant; "[r]ather, the standard for determining what subject matter was surrendered is objective and depends on what a competitor, reading the prosecution history, would reasonably conclude was given up by the applicant." *Instituform Technologies, Inc. v. CAT Contracting, Inc.*, 99 F.3d 1098, 1107-08 (Fed.Cir.1996), cert. denied, 520 U.S. 1198, 117 S.Ct. 1555, 137 L.Ed.2d 703 (1997).

## **2. Extrinsic Evidence**

Although intrinsic evidence is most important, the court may also look to extrinsic evidence, such as expert and inventor testimony, dictionaries and treatises. *Phillips*, 415 F.3d at 1317. Extrinsic evidence "cannot be used to alter a claim construction dictated by a proper analysis of the intrinsic evidence." *On-Line Technologies, Inc. v. Bodenseewerk Perkin-Elmer GMBH*, 386 F.3d 1133, 1139 (Fed.Cir.2004). See also *Phillips*, 415 F.3d at 1317 ("[W]hile extrinsic evidence 'can shed useful light on the relevant art,' we have explained that it is 'less significant than the intrinsic record in determining 'the legally operative meaning of claim language,' " quoting *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 862 (Fed.Cir.2004), and *Vanderlande Indus. Nederland BV v. Int'l Trade Comm'n*, 366 F.3d 1311, 1318 (Fed.Cir.2004)); *id.* at 1318 ("We have viewed extrinsic evidence in general as less reliable than the patent and its prosecution history in determining how to read claim terms.... [U]ndue reliance on extrinsic evidence poses the risk that it will be used to change the meaning of claims in derogation of the 'indisputable public records consisting of the claims, the specification and the prosecution history,' thereby undermining the public notice function of patents").

While "extrinsic evidence ... is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence," the Federal Circuit has held that the district court may, in its discretion, admit such evidence to the extent it is "useful [in] ... provid[ing] background on the technology at issue, ... explain[ing] how an invention works, ... ensur[ing] that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or ... establish[ing] that a particular term in the patent or the prior art has a particular meaning in the pertinent field." *Phillips*, 415 F.3d at 1319. See also *Omega Engineering, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1332 (Fed.Cir.2003) (stating that "expert testimony and declarations are useful to confirm that the construed meaning is consistent with the denotation ascribed by those in the field of the art"); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1309 (Fed.Cir.1999) ("Thus, under *Vitronics*, it is entirely appropriate, perhaps

even preferable, for a court to consult trustworthy extrinsic evidence to ensure that the claim construction it is tending to from the patent file is not inconsistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field. This is especially the case with respect to technical terms, as opposed to non-technical terms in general usage or terms of art in the claim-drafting art, such as 'comprising' "); *Mantech Environmental Corp. v. Hudson Environmental Services, Inc.*, 152 F.3d 1368 (Fed.Cir.1998) (endorsing reference to extrinsic evidence as "background in the technical area at issue").

### **3. Means Plus Function Claims**

Under 35 U.S.C. s. 112, para. 6, an element in a patent claim may be drafted as a generic "means" for performing a function without including a description of the physical structure by which the element performs the function. A claim element is in means-plus-function format if it recites the performance of a function without reciting sufficient structure to perform the function. *Phillips*, 415 F.3d at 1311 ("Means-plus-function claiming applies only to purely functional limitations that do not provide the structure that performs the recited function"); *Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 324 F.3d 1308, 1318 (Fed.Cir.2003) ("A means-plus-function limitation recites a function to be performed rather than definite structure or materials for performing that function"); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed.Cir.2003) ("An element of 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").

Construction of such a limitation involves two steps. First, the court must identify and interpret the claimed function using ordinary principles of claim construction. Second, it must determine what structure disclosed in the specification corresponds to the claimed function. *Omega Engineering*, 334 F.3d at 1321 ("The construction of a means-plus-function limitation follows a two-step approach. First, we must identify the claimed function, ... staying true to the claim language and the limitations expressly recited by the claims.... Once the functions performed by the claimed means are identified, we must then ascertain the corresponding structures in the written description that perform those functions.... A disclosed structure is corresponding 'only if the specification or the prosecution history clearly links or associates that structure to the function recited in the claim.'... In other words, the structure must be necessary to perform the claimed function"); *Micro Chemical, Inc. v. Great Plains Chemical Co., Inc.*, 194 F.3d 1250, 1257-58 (Fed.Cir.1999) ("Application of s. 112, para. 6 requires identification of the structure in the specification which performs the recited function. Therefore, s. 112, para. 6 requires both identification of the claimed function and identification of the structure in the written description necessary to perform that function").

### **B. Patent Claim Terms In Dispute**

There are three claim terms whose meaning the parties dispute.FN11 These are: "first and second flanges" as used in claims 21, 26, and 27; "stud gripping means" as used in claims 21, 26, and 27; and "resilient arm" as used in claims 22, 26, and 27.

FN11. The parties agree that "web" means "the portion of the bracket that connects the first flange to the second flange." (Mot. at 7:22-23; Opp. at 6:19-21). In addition, both now agree that two other terms originally disputed-"arm terminal end portion" and "free end portion"-need no construction. (Opp. at 17:6-18:4; Reply at 1:10-11).

## 1. "First And Second Flanges"

The parties agree that the "first and second flanges" are "the pair of structural members that extend from the web for receiving a wall stud therebetween." They disagree, however, as to whether this definition is sufficient and requires no amplification. T & B contends that it is; Orbit asserts that it should be qualified by the phrase, "wherein the first flange has a length substantially greater than the second flange."

Claim 21 recites a bracket web "having a pair of spaced-apart opposed first and second flanges extending therefrom." Claims 26 and 27 refer to a bracket web that has "a pair of first and second opposed flanges extended therefrom and between which a wall stud is receivable." None of claims 21, 26, and 27 expressly limits the relative length of the flanges. This is significant, since courts look first to the language of the claims, and give that language the ordinary meaning it would have to a person skilled in the art. See, e.g., *Liquid Dynamics*, 355 F.3d at 1368 ("We look first to the claim language itself, to define the scope of the patented invention" and "give claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art"); *Intellectual Property Development*, 336 F.3d at 1314 ("We begin our claim construction analysis with the words of the claim ...").

The limitation that Orbit proposes appears clearly in claim 1 of the patent, which describes "a web having a pair of first and second opposed flanges extending therefrom and between which a wall stud is receivable, said first flange being substantially longer than said second flange...." FN12 Because the limitation appears in claim 1 but not in claims 21, 26 and 27, a presumption arises that these claims do not include the limitation. See *Seachange Intern., Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed.Cir.2005) (there is "a presumption that two independent claims have different scope when different words or phrases are used in those claims"); *Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72 (Fed.Cir.1999) (stating that the doctrine of claim differentiation is based on "the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope"); see also *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1329 (Fed.Cir.2006) ("The term 'rigid' appears in connection with 'insert' only once. The term appears that single time in uncontested claim 3, 'wherein the insert is rigid.' This single use of the term 'rigid' does not, however, import a 'rigid' limitation into all other claims. Rather it implies that the term 'insert,' when used elsewhere in the patent, does not inherently carry a 'rigid' limitation"); *Phillips*, 415 F.3d at 1314 ("The claim in this case refers to 'steel baffles,' which strongly implies that the term 'baffles' does not inherently mean objects made of steel").

FN12. *Id.*, col. 6, ll. 35-38.

This principle, commonly known as the doctrine of claim differentiation, creates no more than a presumption, however; "it is not a hard and fast rule of construction." *Seachange*, 413 F.3d at 1369 (quoting *Kraft Foods, Inc. v. Int'l Trading Co.*, 203 F.3d 1362, 1365-69 (Fed.Cir.2000)). "[T]he doctrine of claim differentiation can not broaden claims beyond their correct scope, determined in light of the specification and the prosecution history and any relevant extrinsic evidence.... [C]laims that are written in different words may ultimately cover substantially the same subject matter." *Seachange*, 413 F.3d at 1369 (quoting *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1480 (Fed.Cir.1988)). "That the patentee chose several words in drafting a particular limitation of one claim, but fewer (though similar) words in drafting the corresponding limitation in another, does not mandate different interpretations of the two limitations, since 'defining a state of affairs with multiple terms should help, rather than hinder, understanding.'" *Kraft*

Foods, 203 F.3d at 1368 (quoting *Bell & Howell Doc. Management Prods. Co. v. Altek Sys.*, 132 F.3d 701, 707 (Fed.Cir.1997)). For that reason, the court turns to the written description and prosecution history to determine if they contain language or disclaimers that negate the presumption created by the claim differentiation doctrine.

The specification has been termed the "single best guide to the meaning of a disputed term." Phillip, 415 F.3d at 1321. Using this "guide" properly, however, is often challenging. See *id.* at 1323 ("the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice"); *Comark Communications, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186-87 (Fed.Cir.1998) ("[t]here is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification"). The Federal Circuit has "expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment," noting that "persons of ordinary skill in the art rarely would confine their definitions of terms to the exact representations depicted in the embodiments." Phillips, 415 F.3d at 1323. Rather, a court should interpret claims "in light of the specification and with a view to ascertaining the invention." *Comark*, 156 F.3d at 1186.

The specification describes the first flange as "extend[ing] a substantially greater distance from bracket web 30 th[a]n second flange 34." FN13 This description is consistent with the bracket shown in all of the patent figures. To read this limitation into the claim language merely because it is the preferred embodiment, however, runs contrary to the Federal Circuit's repeated admonitions against importing limitations from the specification into a claim. See *Comark*, 156 F.3d at 1186-87 (Fed.Cir.1998) (noting the Federal Circuit's "repeated statements that limitations from the specification are not to be read into the claims"); *Texas Instruments, Inc. v. United States Int'l Trade Comm'n*, 805 F.2d 1558, 1563 (Fed.Cir.1986) ("This court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification").

FN13. *Id.*, col. 3, ll. 33-35.

In *Comark*, defendant argued that the term "video delay circuit" should be read "in light of the specification" to mean that the "video delay circuit" functioned so as to compensate for delay introduced to the video signal by an IF vision modulator. *Comark*, 156 F.3d at 1186. The Federal Circuit disagreed, concluding that this interpretation did not construe claim language "in light of the specification," but instead read a limitation into the claim from the specification. *Id.* at 1186-87. The court observed that the term "'video delay circuit' ha[d] a clear and well-defined meaning," and was "not so amorphous that one of skill in the art [could] only reconcile the claim language with the inventor's disclosure by recourse to the specification." *Id.* at 1187 (citing *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed.Cir.1988) (the specification can supply understanding of unclear terms, but should never trump the clear meaning of the claim terms)).

Like the term "video delay circuit" in *Comark*, the term "first and second flanges" is not "so amorphous that one of skill in the art" can determine its meaning only by looking to the specification. See *Comark*, 156 F.3d at 1187. Rather, the specification simply provides an example of how the two flanges are arranged in one embodiment of the invention. As in *Comark*, the specification "in no way sheds light on either the meaning of the term to the inventor, or the common meaning of the term to one of skill in the art." *Id.*

Turning next to the prosecution history, Orbit contends that the inventor expressly defined the term "first and second flanges" as two flanges, one of which is substantially longer than the other, in an amendment submitted to the examiner. In an office action letter issued on September 18, 1990, the examiner rejected claim 1 as anticipated by Schuplin, i.e., United States Patent No. 3,780, 209 ("the '209 Patent").FN14 In response, the inventor amended claim 1 to add the phrase, "said first flange being substantially longer than said second flange." FN15 He argued that th claim should be permitted in light of this amendment, stating: "In rejecting claim 1 on Schuplin, the Examiner was reading flange 12 of Schuplin as the claimed first flange. However, claim 1 now recites the first flange as having a length substantially greater than the second flange. Therefore, the flange 12 of Schuplin can no longer be read as the first flange." FN16

FN14. Declaration of Michael V. Cangolosi in Support of Thomas and Betts Corporation's Reply Brief ("Cangolosi Decl. II"), Exh. B (USPTO action letter, September 18, 1990).

FN15. *Id.*, Exh. C at 35 (response to action letter dated September 18, 1990).

FN16. *Id.* at 39.

The amendment offered by the inventor concerned claim 1 only. T & B correctly notes that the claims at issue—claims 21-22 and 26-27—were not rejected by the examiner.FN17 Because the inventor did not interpret or offer a definition of "first and second flanges" in his response to the office action letter, but instead added a limitation to claim 1 to overcome the rejection based on Schulpin, the limitation is not properly read into the definition of "first and second flanges" as used in other claims.FN18 See *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1332 (Fed.Cir.2004) ("Here, we find no clear or express statement by the patentees giving 'rotating' a special meaning. The statements in the prosecution history relied on by Wal-Mart, while arguably subject to the interpretation Wal-Mart gives them, can also be reasonably understood as applying only to those claims (such as issued claim 5) that explicitly recite that rotation must be 'through greater than 360 (deg.)'. Claim 11 is not one of those claims. Because the statements in the prosecution history are subject to multiple reasonable interpretations, they do not constitute a clear and unmistakable departure from the ordinary meaning of the term 'rotating' "); *id.* at 1333 ("Wal-Mart focuses in particular on the patentees' statements in response to the Examiner's third rejection. The patentees stated in their response that the prior art Lipman reference clearly 'would not be rotatable so as to be able to sweep through 360 (deg.) or greater as achieved by applicants' invention' and that 'the claims in issue have been amended to recite rotation through at least 360 (deg.) and avoid an incidental disclosure of rotation which could be imputed to Lipman.' ... [T]he patentees' statements about Lipman's inability to rotate through 360 (deg.) were made to distinguish only those claims that explicitly recited a 360 (deg.) limitation. Claim 16, which issued as claim 11 now in dispute, has no such limitation. These statements therefore do not rise to the level of a clear disavowal of scope with respect to pending claim 16"); see also *SanDisk Corp. v. Memorex Products, Inc.*, 415 F.3d 1278, 1287 (Fed.Cir.2005) ("When the patentee makes clear and unmistakable prosecution arguments limiting the meaning of a claim term in order to overcome a rejection, the courts limit the relevant claim term to exclude the disclaimed matter.... An ambiguous disclaimer, however, does not advance the patent's notice function or justify public reliance, and the court will not use it to limit a claim term's ordinary meaning.... There is no 'clear and unmistakable' disclaimer if a prosecution argument is subject to more than one reasonable interpretation, one of which is consistent with a proffered meaning of the disputed term"); *Cordis Corp. v. Medtronic AVE, Inc.*, 339 F.3d 1352,1359 (Fed.Cir.2003)

(concluding that a statement made during prosecution was "amenable to multiple reasonable interpretations and it therefore [did] not constitute a clear and unmistakable surrender"); compare *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (1995) ("arguments made during prosecution regarding the meaning of a claim term are relevant to the interpretation of that term in every claim of the patent absent a clear indication to the contrary"); *Digital Biometrics, Inc. v. Indentix, Inc.*, 149 F.3d 1335, 1347 (Fed.Cir.1998) ("Appellants ask us to parse through the prosecution history and limit these remarks to those claims in which 'active area' explicitly appears. The remarks are not as limited in scope as DBI suggests. *The remarks ... were made without reference to a particular claim.* Instead, the remarks were made with respect to 'all of the pending claims [that] stand rejected under 35 USC 102(b) or 35 USC 103 over the Ruell German Patent 3,432,886.' While it is true that the applicants went on to specifically distinguish each claim, or group of claims, including claim 19, from Ruell on more narrow grounds, that does not eliminate global comments made to distinguish the applicants' 'claimed invention' from the prior art").

FN17. As originally filed, claims 21-22 were numbered claims 24-25. The other claims at issue, claims 26-27, were added as claims 29-30 in an amendment dated October 17, 1990. (Reply at 2 n. 1; Cangolosi Decl. II, Exh. A at 20; id., Exh. B; id., Exh. C at 3).

FN18. In the context of prosecution history estoppel, the Federal Circuit has rejected the notion that an amendment or argument made to distinguish one claim does not limit the range of equivalents for other claims that were not the subject of the amendment or argument. See *Southwall*, 54 F.3d at 1583-84 ("In South wall's view, since the arguments concerning [prior art] were never made to obtain allowance of the claims now being asserted ... but instead were directed to now canceled claims in the application, there is no estoppel.... Southwall's analysis contains several flaws.... [T]he actual basis for patentability is not the only factor that determines whether an argument in the prosecution history creates an estoppel. We look also to the context and character of the argument. And once an argument is made regarding a claim term so as to create an estoppel, the estoppel will apply to that term in other claims"). "There is a clear line of distinction," however, "between using the contents of the prosecution history to reach an understanding about disputed claim language ... and the doctrine of prosecution history estoppel which 'estops' or limits later expansion of the protection accorded by the claim to the patent owner under the doctrine of equivalents when the claims have been purposefully amended or distinguished over relevant prior art to give up scope." *Biodex Corp. v. Loredan Biomedical, Inc.*, 946 F.2d 850, 862 (Fed.Cir.1991); see *Southwall*, 54 F.3d at 1578) (citing *Biodex* and stating that "[c]laim interpretation in view of the prosecution history is a preliminary step in determining literal infringement, while prosecution history estoppel applies as a limitation on the range of equivalents if, after the claims have been properly interpreted, no literal infringement has been found.... The limit on the range of equivalents that may be accorded a claim due to prosecution history estoppel is simply irrelevant to the interpretation of those claims"); see also *AccuScan, Inc. v. Xerox Corp.*, 76 Fed. Appx. 290, 291 (Fed.Cir. Sept.17, 2003) (Unpub.Disp.) ("Prosecution history estoppel stands 'as a legal limitation on the doctrine of equivalents.' ... Since this restriction on the doctrine of equivalents applies 'only where claims have been amended for a limited set of reasons,' ... prosecution history estoppel does not apply to claim construction ...," quoting *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 30, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997)). In the claim construction context, arguments made regarding a term used in a claim are relevant to the extent they assist the court in understanding the meaning of a disputed claim term. See *Southwall*, 54 F.3d at 1579 ("arguments made during prosecution regarding the meaning of a claim term are relevant to the interpretation of that term in every claim of the patent absent a clear indication to the contrary"). Here, the inventor did not attempt to define the term "first and second flanges," but merely inserted a limitation in claim 1 to overcome the

examiner's rejection of that claim. Because the same limitation was not inserted in any of claims 21, 26 or 27, it cannot be imported into those claims.

At the *Markman* hearing, Orbit argued that the purpose of the '199 Patent would be negated if the first flange were not substantially longer than the second flange. It contends, and the court agrees, that the primary novel feature of the '199 Patent is its "universal mountability," i.e., the bracket's ability to attach to studs of different sizes, and to the closed or open side of a stud. The centrality of this feature to the invention is evidenced by the specification, which explains that "[i]t is a principal objection of the present invention to provide an improved box mounting bracket that is capable of being mounted to channel-shaped wall studs having different dimensions," and that "[i]t is also an object of the invention to provide such a box mounting bracket that is selectively mountable to either the open or closed side of a channel-shaped metal wall stud." FN19 This central purpose is also reflected in the inventor's remarks to the examiner during patent prosecution. The inventor stated that two important features of the bracket were its "universal mountability to wall studs of many different sizes" and its "mountability ... to either the open or closed side of metal channel-shaped wall studs." FN20

FN19. '199 Patent, col. 2, ll. 21-28; see also *id.*, col. 1, ll. 24-27 (noting that the invention fills an unmet need for "a box mounting bracket that could be mounted to channel-shaped wall studs of different sizes, while also being selectively mountable to either the open or closed side of the stud").

FN20. Declaration of Michael V. Cangolosi in Support of Thomas and Betts Corporation's Reply Brief ("Cangolosi Decl. II"), Exh. C at 38 (response to action letter dated September 18, 1990).

Orbit contends that this key feature of universal mountability would be lost if the first flange were not substantially longer than the second flange. It notes that because the resilient arm extends in an inward and backward direction from the portion of the first flange that is remote from the web, the length of the first flange determines the length of the resilient arm. Because, in Orbit's view, the resilient arm must be substantially longer than the second flange, the first flange must be substantially longer as well. This, in fact, is how the bracket is depicted in figures 9 and 10 of the '199 Patent.

Figure 10 depicts a bracket mounted on the open side of a channel-shaped wall stud. As noted, the resilient arm extends from the free end portion of the first flange, and grips and bites into stud lip 18. When channel flanges 12 and 14 are relatively long, a shorter resilient arm—e.g., one extending from the free end portion of a first flange that is no longer than the relatively short second flange depicted in figure 10—would be able to grip and bite into stud lip 18. When channel flanges 12 and 14 are relatively short, however, the resilient arm (and concomitantly, the first flange) must be substantially longer than the comparative short second flange that is shown in figure 10, or the arm would be too short to grip and bite into stud lip 18.

Determining that the first flange and resilient arm must be substantially longer than the relatively short second flange depicted in figure 10 if the bracket is to have the capability of mounting on the open side of a range of stud sizes, however, does not address whether the second flange must *necessarily* be substantially shorter than the first flange and the resilient arm. For the bracket to mount on the closed side of the stud, as depicted in figure 9, the second flange of the bracket must be long enough that flange extension 74 can hook behind stud lip 16. Contrary to Orbit's contention, however, the court can discern no reason why the second

flange cannot be longer, or even substantially longer, than the length of stud lip 16. It appears that the second flange could be as long, or nearly as long, as the first flange, and yet have stud gripping means with barbs that grip wall studs of varying sizes. Consequently, the court cannot find, as Orbit urges, that the invention will be unable to achieve its central purpose if the first flange and the resilient arm are not substantially longer than the second flange.

As neither the written description nor the prosecution history negates the presumption arising from the difference in language between claim 1 and the asserted claims, the court construes "first and second flanges" as "the pair of structural members that extend from the web for receiving a wall stud between."

## 2. "Resilient Arm"

"Resilient arm" appears in claims 22, 26, and 27. Claim 22 recites a bracket "wherein said first flange has an elongated resilient arm connected therewith remote from said web and extending generally along said first flange in inwardly inclined relationship thereto back toward said web, said arm having an arm terminal end portion located adjacent said web...." FN21 Claims 26 and 27 describe "a resilient arm extending from said free end portion of said first flange back toward said web in inwardly inclined spaced relationship to said first flange, said arm having an arm terminal end portion adjacent said web...." FN22

FN21. '199 Patent, col. 7, l. 61-col. 8, l. 1.

FN22. *Id.*, col. 8, ll. 17-23; *id.*, col. 8, ll. 31-36.

T & B proposes that the term "resilient arm" be interpreted to mean "the portion of the bracket that extends from the first flange inward to the space between the two flanges." Orbit counters that the term should be construed as "a resilient member centrally located between opposite ends of a first flange, having a length substantially greater than the length of the second flange, which extends inwardly from the remote end of the first flange."

The court starts its analysis with the ordinary meaning of the term. See *Liquid Dynamic*, 355 F.3d at 1368 ("We look first to the claim language itself, to define the scope of the patented invention" and "give claim terms their ordinary and accustomed meaning as understood by one of ordinary skill in the art"). T & B contends that the ordinary meaning of "resilient arm" can be discerned by looking to a general dictionary. The Merriam Webster Collegiate Dictionary, for example, defines "resilience" as "the capability of a strained body to recover its size and shape after deformation caused especially by compressive stress" FN23 and "arm" as "a narrow extension of a larger area, mass, or group." FN24

FN23. Declaration of Michael V. Cangolosi in Support of Thomas and Betts Corporation's Opening Claim Construction Brief ("Cangolosi Decl. I"), Exh. H (excerpts from MERRIAM WEBSTER'S COLLEGIATE DICTIONARY (9th ed.1989)).

FN24. *Id.*

Notwithstanding T & B's reliance on these dictionary definitions, it is apparent that neither party finds them fully adequate, as each proposes a construction that incorporates the direction and location of the arm relative to the flanges. The primary differences in the parties' proposed constructions are found in the fact that Orbit asserts the arm (1) must be "centrally located" between opposite ends of the first flange, (2) have "a length substantially greater than the length of the second flange," and (3) extend inwardly from the "remote end" of the first flange.

Recognizing that claims 22, 26 and 27 do not explicitly include any of the limitations it proposes-i.e., "centrally located," "having a length substantially greater than the length of the second flange," and "remote end"-Orbit relies on the specification and prosecution history to show that these limitations are properly read into the claims. The specification states in relevant part:

"In a preferred arrangement, resilient arm 42 is integral with first flange 32, and is formed by smoothly reversely bending an extension of first flange 32 as generally indicated at 46. Resilient arm 42 is centrally located between opposite ends 48, 50 of first flange 32, and has a transverse arm width that is greater than one-half the distance between first flange opposite ends 48, 50.

Resilient arm 42 is located in the space between first and second bracket flanges 32, 34, and extends inwardly from first flange 32 less than one-half the distance toward second flange 34. Resilient arm 42 has an arm terminal end portion 52 located closely adjacent bracket web 30....

Elongated arm 42 has a length substantially greater than the length of second flange 34 and provides automatic adjustment over a wide range for resilient gripping across a stud flange of many different widths." FN25

FN25. '199 Patent, col. 3, l. 61-1. 4; id., col. 5, ll. 47-51.

The court agrees with Orbit that the "resilient arm" must extend from a portion of the first flange that is "remote" from the web. This restriction is clear not only in the cited passages of the specification, but more importantly, in the claim language itself. Claim 22, for example, recites a bracket "wherein said first flange has an elongated resilient arm connected therewith *remote from said web*."FN26 Claims 26 and 27 use different language, but recite "a resilient arm extending from said *free end portion* of said first flange ... said arm having an arm terminal end portion adjacent said web." FN27 The "free end portion" of the flange is the portion not attached to the web bracket, i.e., the portion that is remote from the web. Thus, consistent with the specification, the claim language makes clear that the resilient arm extends from the portion of the first flange that is remote from the web in an inward and backward direction, so that the "arm terminal end portion" is "adjacent" to the web. See *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, 1301 (Fed.Cir.2006) (stating that the court "turn[ed] first to the language of the claims" to determine if it "offer[ed] any guidance as to the meaning" of the disputed claim term); *Liquid Dynamics*, 355 F.3d at 1367 ("We look first to the claim language itself, to define the scope of the patented invention.... We look to the written description for guidance 'when the claim language itself lacks sufficient clarity to ascertain the scope of the claims' "); *Chimie*, 402 F.3d at 1377 ("Claim construction begins with the intrinsic evidence of record, looking first to the claim language itself to define the scope of the patented invention"); see also *Phillips*, 415 F.3d at 1313 (claim terms must be "read ... not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification").

FN26. *Id.*, col. 7, ll. 61-63.

FN27. *Id.*, col. 8, ll. 17-22; *id.*, ll. 32-36.

T & B argues that including in the definition of "resilient arm" a requirement that it extend from a portion of the first flange that is "remote" from the web is redundant, as each of claims 22, 26 and 27 already includes such a limitation.FN28 The court agrees. See, e.g., *Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1381 (Fed.Cir.2006) ("Even if "adjustable" were synonymous with the presence of an adjustment mechanism, this court perceives no redundancy because the claims that recite the presence of such a mechanism do not include the 'adjustable' limitation"); *Old Town Canoe Co. v. Glenwa, Inc.*, 55 Fed. Appx. 918, 921 (Fed.Cir. Jan.14, 2003) (Unpub.Disp.) ("To ascribe a hull shape to 'sit-on-top kayak' would be redundant in view of the first element of the independent claims that refers specifically to the siton-top kayak as comprising 'a hull defining a hull outer surface.' If 'sit-on-top kayak' meant a craft with a particular hull, then it would be unnecessary to also claim a hull"); see also *Merck & Co. v. TevaPharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed.Cir.2005) ("A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so"); *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed.Cir.2006) ("Allowing a patentee to argue that physical structures and characteristics specifically described in a claim are merely superfluous would render the scope of the patent ambiguous, leaving examiners and the public to guess about which claim language the drafter deems necessary to his claimed invention and which language is merely superfluous, nonlimiting elaboration. For that reason, claims are interpreted with an eye toward giving effect to all terms in the claim"). Because each of claims 22, 26 and 27 claims a resilient arm that extend from the free arm portion of the first flange remote from the web, such a limitation need not be imported into the definition of resilient arm. The same is true of a portion of T & B's proposed construction of the term. T & B urges the court to construe "resilient arm" to mean "the portion of the bracket that extends from the first flange inward to the space between the two flanges." Each of claims 22, 26 and 27 specifically includes a limitation that the resilient arm extend "in inwardly inclined relationship" to the first flange.FN29 Just as Orbit's proposal that the court construe resilient arm to require that the arm extend from the free arm portion of the first flange remote from the web is redundant, so too is T & B's proposal that the court construe the term to require that the resilient arm extend inwardly to the space between the two flanges.

FN28. *Id.*, col. 7, ll. 61-63 ("an elongated resilient arm connected [with the first flange] remote from said web"); col. 8, ll. 18-20 ("a resilient arm extending from said free end portion of said first flange"); col. 8, ll. 32-34 ("a resilient arm extending from said free end portion of said first flange").

FN29. *Id.*, col. 7, ll. 63-64; col. 8, ll. 20-21; col. 8, ll. 34-35.

The additional limitations proposed by Orbit run afoul of the rule that claims are not limited to the preferred embodiment. See *Comark*, 156 F.3d at 1186-87 (noting the Federal Circuit's "repeated statements that limitations from the specification are not to be read into the claims"); *Texas Instruments*, 805 F.2d at 1563 ("This court has cautioned against limiting the claimed invention to preferred embodiments or specific examples in the specification").

Orbit first attempts to restrict the resilient arm to an arm that is "centrally located between opposite ends of a first flange." While this restriction is clearly a component of the preferred embodiment, nothing in the claim language or specification suggests that it is a necessary component of the invention. See *Conoco, Inc. v. Energy & Environmental Intern., L.C.*, 460 F.3d 1349, 1357-58 (Fed.Cir.2006) (stating that an inventor's intention to use the specification to disclaim or disavow the broad scope of a claim must be clear and that courts "cannot draw limitations into the claim from a preferred embodiment"); *Phillips*, 415 F.3d at 1323 ("[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments"); *Nazomi Communications, Inc. v. ARM Holdings, PLC*, 403 F.3d 1364, 1369 (Fed.Cir.2005) (claims may embrace "different subject matter than is illustrated in the specific embodiments in the specification"). The specification does not indicate that its reference to "centrally located" is in any way intended to define the term "resilient arm" or that the inventor intended to disavow some other placement of the arm.

Nor is the patented invention's purpose or novelty negated if the resilient arm is not "centrally located between opposite ends of a first flange." See *Renishaw*, 158 F.3d at 1250 ("the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim"); see also *Phillips*, 415 F.3d at 1323 ("To avoid importing limitations from the specification into the claims, it is important to keep in mind that the purposes of the specification are to teach and enable those of skill in the art to make and use the invention and to provide a best mode for doing so"). The purpose of the resilient arm is to permit the bracket to attach securely to different sizes of wall studs. This purpose can be served whether or not the arm is centrally located between opposite ends of the first flange. Consequently, rather than "shed[ding] light on either the meaning of the term to the inventor, or the common meaning of the term to one of skill in the art," the specification merely details where the resilient arm is placed in one embodiment of the invention. *Comark*, 156 F.3d at 1187.

Orbit also argues that the resilient arm must "hav[e] a length substantially greater than the length of the second flange." This restriction is explicitly stated in claim 1, which recites an arm that is "substantially longer than said second flange and [that has] an arm terminal end portion adjacent to said web." FN30 Claims 22, 26, and 27, by contrast, describe an arm "having an arm terminal end portion located adjacent said web." FN31 As noted, this difference in language gives rise to a presumption that claims 22, 26, and 27 do not contain the limitation that is clearly recited in claim 1. See *Seachange*, 413 F.3d at 1369 (there is "a presumption that two independent claims have different scope when different words or phrases are used in those claims"); *Karlin Tech.*, 177 F.3d at 971-72.

FN30. '199 Patent, col. 5, ll.43-45.

FN31. *Id.*, col. 7, l. 65-col. 8, l. 1; *id.*, col. 8, ll. 21-22, 35-36.

This presumption can be overcome by evidence contained in the written description and file wrapper. See *Seachange*, 413 F.3d at 1369 (noting that the claim differentiation presumption can be overcome). In response to a USPTO office action letter rejecting claim 1 as anticipated by the '209 Patent, the inventor amended the claim to add the limitation that Orbit seeks to import into claims 22, 26 and 27. He stated:

"The elongated resilient arm 42, shown best in Figures 3, 9 and 10, is one feature that enhances the universal mountability of the bracket. As indicated at the bottom of page 13 of the specification, the elongated arm 42

has a length substantially greater than the length of second flange 34 to provide automatic adjustability over a wide range of different stud sizes. This novel and advantageous feature is now recited in claim 1." FN32

FN32. Congolosi Decl. II, Exh. C (response to office action letter of September 18, 1990).

Orbit argues that this limitation must be applied to all claims that recite a resilient arm, not just claim 1. In support, it cites *Digital Biometrics, Inc. v. Indetix, Inc.*, 149 F.3d 1335, 1347 (Fed.Cir.1998) for the proposition that, absent qualifying language, "arguments made to obtain the allowance of one claim are relevant to interpreting other claims in the same patent." *Id.* at 1347. As previously noted, however, claims 22, 26, and 27 were never rejected by the examiner, and neither contains the limitation found in claim 1 that the first flange must be substantially longer than the second flange. The inventor's remarks to the patent examiner, moreover, made clear that the added limitation applied only to claim 1. FN33 Contrary to Orbit's contention, therefore, nothing in the prosecution history rebuts the presumption that arises from the fact that the "substantially greater" length limitation appears in claim 1 but not in the asserted claims.

FN33. The proposition for which Orbit cites *Digital Biometrics* has been questioned, as it significantly broadens the rule it purports to apply, i.e. that arguments regarding the *meaning* of a claim term made during patent prosecution must guide the court's interpretation of all other claims employing the same term. See *Southwall*, 54 F.3d at 1569 ("[a]rguments made during prosecution regarding the meaning of a claim term are relevant to the interpretation of that term in every claim of the patent absent a clear indication to the contrary," cited by *Digital Biometrics*, 149 F.3d at 1347). See also *Pliant Corp. v. MSC Marketing & Technology, Inc.*, 416 F.Supp.2d 632, 643 (N.D.Ill.2006) (questioning *Digital Biometrics* ).

The Federal Circuit has cited this aspect of *Digital Biometrics* only once since the case was decided, in *Hockerson-Halbertstadt, Inc. v. Avia Group Intern., Inc.*, 222 F.3d 951 (Fed.Cir.2000). *Hockerson* followed *Southwall* and not *Digital Biometrics*, however, in that an inventor's arguments regarding the *meaning* of the term "groove" during patent prosecution were held to apply to all claims in which the word "groove" appeared. See *id.* at 956-57 ("Review of the prosecution history, however, reveals that the inventor disclaimed a particular interpretation of groove, thereby modifying the term's ordinary meaning.... The term 'central longitudinal groove' is present in all three claims of the '792 patent. Thus the inventor's statements and submitted drawings concerning groove width apply with uniform force to all the claims"). The court need not decide whether *Ditigal Biometrics* controls, however, because the inventor clearly included "qualifying language" indicating that the amendment at issue-i.e., an elongated arm with a length substantially greater than the length of second flange-applied only to claim 1. See *Digital Biometrics*, 149 F.3d at 1347 ("Absent qualifying language, arguments made to obtain the allowance of one claim are relevant to interpreting other claims in the same patent").

Moreover, as already explained, the court does not agree with Orbit's contention that the resilient arm must be substantially longer than the second flange in order for the bracket to be mountable on either the open or closed side of a variety of different-sized wall studs. While it is true that the first flange and the resilient arm must be substantially longer than the comparatively short second flange depicted in figures 9 and 10, there is no reason why the second flange *cannot* be longer than that shown in figures 9 and 10, nor is there any reason why the second flange *cannot* be as long, or almost as long, as the first flange. Accordingly, the court rejects Orbit's suggestion that it construe the resilient arm as having a length substantially greater than the length of the second flange.

Although it cannot accept the limitations that Orbit proposes, the court agrees with Orbit that T & B's

proposed construction of resilient arm is defective because it eliminates entirely the concept of "resiliency." The Federal Circuit has repeatedly emphasized that claim construction centers on the words of the claim. See *Vitronics*, 90 F.3d at 1582 ("we look to the words of the claims themselves ... to define the scope of the patented invention"); see also *Renishaw*, 158 F.3d at 1248 ("claim construction inquiry, therefore, begins and ends in all cases with the actual words of the claim"). Absent a clear indication in the specification or prosecution history, the court cannot assume that the inventor's use of the word "resilient" was superfluous. See *Merck & Co.*, 395 F.3d at 1372 ("A claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so"); *Power Mosfet Techs., L.L.C. v. Siemens AG*, 378 F.3d 1396, 1410 (Fed.Cir.2005) (interpretations of claims that render claim terms superfluous are generally disfavored). The court therefore modifies T & B's proposed construction to incorporate the concept of "resilience," which the parties agree means "capable of recovering its size and shape after deformation caused especially by compressive stress." FN34

FN34. Cangolosi Decl. I, Exh. H (excerpts from MERRIAM WEBSTER'S COLLEGIATE DICTIONARY (9th ed.1989)); Reporter's Transcript, Mar. 9, 2007 ("RT"), at 26:10-21; 28:15-29:12.

As a result, the court construes "resilient arm" to mean "the portion of the bracket that is connected to the first flange, and that is capable of recovering its size and shape after deformation caused especially by compressive stress."

### **3. "Stud Gripping Means"**

The parties propose different constructions of "stud gripping means." T & B believes the term should be interpreted to mean "that which allows the bracket to attach firmly to the wall stud, without being limited to only the use of barbs." Orbit proffers a construction that limits "stud gripping means" to "barbs or teeth deformed outwardly from a surface." The parties also dispute whether "stud gripping means" is a means-plus-function claim term governed by section 112, para. 6. The court first resolves this threshold issue.

A claim element is in means-plus-function format if it recites the performance of a function without reciting sufficient structure to perform the function. *Phillips*, 415 F.3d at 1311 ("Means-plus-function claiming applies only to purely functional limitations that do not provide the structure that performs the recited function"); *Lockheed Martin Corp.*, 324 F.3d at 1318 ("A means-plus-function limitation recites a function to be performed rather than definite structure or materials for performing that function"); *Altiris, Inc.*, 318 F.3d at 1375 ("An element of 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").

Because the term "stud gripping means" uses the word "means," it is presumptively a means-plus-function term governed by 35 U.S. s. 112, para. 6. See *Al- Site Corp. v. VSI Intern., Inc.*, 174 F.3d 1308, 1318 (Fed.Cir.1999) ("if the word 'means' appears in a claim element in combination with a function, it is presumed to be a means-plus-function element to which s. 112, para. 6 applies"); *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1428 (Fed.Cir.1997) ("In the present case, the 'closure means' of claim 1 and the 'movable closure means' of claim 10 use the word 'means' and, thereby, presumptively implicate section 112, paragraph 6").

The presumption is not conclusive, however. It is rebutted if a claim recites function "but then goes on to elaborate sufficient structure, material, or acts within the claim itself to perform entirely the recited function." Sage Products, 126 F.3d at 1427; see also *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1365 (Fed.Cir.2000) ("The district court should have determined whether the claims recite sufficient structure for performing the claimed function, thereby overcoming the presumption s. 112, para. 6"). Because the recited structure must be sufficient to "perform entirely the recited function," a claim may recite some structure and yet not recite *enough* structure to take it outside s. 112, para. 6. See *Personalized Media Communications, LLC v. International Trade Comm'n*, 161 F.3d 696, 704 (Fed.Cir.1998) ("[T]e focus remains on whether the claim as properly construed recites sufficiently definite structure to avoid the ambit of s. 112, para. 6"). To hold otherwise would permit claims to be "construed so broadly [as] to cover every conceivable way or means to perform the function" recited. *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1214 (Fed.Cir.1998).

As used in claims 21, 26, and 27, "stud gripping means" describes an aspect of the flanges and the resilient arm. The relevant language is as follows:

-> Claim 21: "stud gripping means on said flanges and extending inwardly thereof for gripping a stud therebetween, said stud gripping means on each of said flanges including a plurality of barbs spaced-apart both longitudinally and transversely thereof." FN35

FN35. '199 Patent, col. 7, ll. 55-60.

-> Claim 26: "stud gripping means on said arm terminal end portion and on said second flange for gripping a stud therebetween, and said stud gripping means on said arm terminal end portion comprising a plurality of barbs spaced-apart both longitudinally and transversely of said second flange." FN36  
FN36. *Id.*, col. 8, ll. 22-27.

-> Claim 27: "stud gripping means on said arm terminal end portion and on said second flange for gripping a stud therebetween, and said stud gripping means on said second flange comprising a plurality of barbs spaced-apart both longitudinally and transversely of said second flange." FN37  
FN37. *Id.*, col. 8, ll. 36-41.

These claims clearly recite a structure ("a plurality of barbs spaced-apart both longitudinally and transversely of said second flange") that performs the contemplated function (stud gripping). T & B contends this structure is sufficient to take "stud gripping means" outside of s. 112, para. 6. The court agrees.

Citing *SanDisk Corp.*, 415 F.3d 1278, T & B contends that "stud gripping means" includes barbs, but does not exclude other means that would allow a user to attach the bracket firmly to the wall stud. *SanDisk* involved a non-means-plus-function claim that described "[a] method of operating a computer system including a processor and a memory system, wherein the memory system includes an array of ... memory cells partitioned into a plurality of sectors." *Id.* at 1284. Noting that the word "includes" is a patent law term of art that has the same meaning as "comprising," the court held that "[n]either includes, nor comprising, forecloses additional elements that need not satisfy the stated claim limitations." *Id.* Thus, the language did

not prevent the use of cells that were not grouped into partitioned sectors. *Id.* at 1285.

*SanDisk* cited *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313 (Fed.Cir.2003) for its definition of "includes" and "comprising." *Amgen* defines the words as "term[s] of art ... which mean[ ] that the named elements are essential but other elements may be added and still form a construct within the scope of the claim." *Id.* at 1344-45; *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed.Cir.1997) (same); see also *Amgen*, 314 F.3d at 1345 ("Thus, a claim reciting 'a widget comprising A and B,' for example, would be infringed by any widget containing A and B, no matter that C, D, or E might be present").

Applying this definition, the reference in claims 22, 26 and 27 to "comprising a plurality of barbs" and "including a plurality of barbs" means that the gripping means cannot exclude barbs altogether. Barbs "are essential but other elements may be added." *Id.* at 1345. The claim language thus recites some structure for the means. It also recites the location of the stud gripping means (on "the second flange" and on the "arm terminal end portion" of the resilient arm) and how it operates ("gripping a stud therebetween").

Taken together, these limitations negate the concern that the claim could be "construed so broadly [as] to cover every conceivable way or means to perform the [stud gripping] function," ( *Mas-Hamilton*, 156 F.3d at 1214), and renders the recited structure sufficiently definite to overcome the presumption that it falls within s. 112, para. 6. See *Personalized Media*, 161 F.3d at 704 ("the focus remains on whether the claim as properly construed recites sufficiently definite structure to avoid the ambit of s. 112, para. 6"); see also, e.g., *TI Group Automotive Systems (North America) v. VDO North America, L.L.C.*, 375 F.3d 1126, 1135 (Fed.Cir.2004) (holding that "pumping means" was not a means-plus-function term because the claim recited "its structure ('including a nozzle and a venturi tube in alignment with the nozzle'), location ('being located within the reservoir in the region of the opening'), and operation ('the passage of fuel out of the nozzle and through the venturi tube causing fuel to be entrained through the opening into the interior of the reservoir')"); *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1365 (Fed.Cir.2000) (holding that "second baffle means" was not a means-plus-function element because the term "baffle" itself imparted structure and further, the "claims describe[d] the particular structure of this particular baffle ('having inner surfaces for directing airflow ... radially outward ... and thereafter ... between said first baffle means and said air filter means')" and described "details about the location and formational details").

Accordingly, the court concludes that the claims contain sufficient structure to overcome the presumption that "stud gripping means" is a means-plus-function claim term within the meaning of s. 112, para. 6.FN38 It therefore applies standard rules of construction to the term. As always, the court starts with the claim language itself. Here, the claims indicate that the "stud gripping means" include or comprise "a plurality of barbs spaced-apart both longitudinally and transversely of said second flange." As noted, the words "comprising" and "including" demonstrate that barbs are a necessary element of the gripping means, although there may be other elements.

FN38. Orbit argues that the recited structure corresponds only to the first and second flanges described in claim 21, the arm terminal end portion described in claim 26, and the second flange described in claim 27. It contends that the structure is not linked to the second flange recited in claim 26 and the arm terminal end portion claimed in claim 27. As the "stud gripping means" on these elements are not limited by any structure, Orbit contends, the court must construe "stud gripping means" in two different ways: first as a means-plus-function term and then as an "ordinary," non-means-plus-function term. Orbit cites no authority for the proposition that a single term should be construed differently within the same claim. Absent such authority, the court declines to do so, as it would run contrary to the Federal Circuit's oft-repeated

admonition that "a claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent." *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed.Cir.2001); see also *Phonometrics, Inc. v. Northern Telecom Inc.*, 133 F.3d 1459, 1465 (Fed.Cir.1998) ("A word or phrase used consistently throughout a claim should be interpreted consistently"); *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1159 (Fed.Cir.1997) ("we are obliged to construe the term 'elasticity' consistently throughout the claims"); *Southwall*, 54 F.3d at 1579 (holding that claim terms found in different claims should be interpreted consistently).

Because claim language must be read in context of the patent as whole ( *Phillips*, 415 F.3d at 1313), the court next examines this language in view of the specification to determine if the inventor gave "stud gripping means" a definition different than it would otherwise possess, or if he intentionally disclaimed or disavowed the meaning of the term now advocated ( *id.* at 1316).

The "summary of the invention" and specification make a number of references to the "stud gripping means," including:

-> "The gripping means on the flanges may be in the form of a plurality of sharp barbs spaced both longitudinally and transversely of the flanges." FN39

FN39. '199 Patent, col. 1, ll. 41-43.

-> "It is another object of the invention to provide such a bracket having a bracket flange with stud gripping barbs in optimum locations and spacings." FN40

FN40. *Id.*, col. 2, ll. 38-40.

-> "The gripping means may comprise a plurality of spaced-apart primary and secondary barbs or teeth 56, 58 deformed outwardly from resilient arm 42. In the relaxed and unstressed condition of resilient arm 42, barbs or teeth 56, 58 extend generally parallel to bracket web 30 toward second flange 34. Primary and secondary barbs 56, 58 on arm end portion 52 provide arm 42 and first flange 32 with a plurality of barbs that are spaced-apart from one another in directions extending both longitudinally and transversely of arm 42." FN41

FN41. *Id.*, col. 4, ll. 6-18.

-> "Second flange 34 has central stud gripping means in the form of a central resilient finger 90 deformed inwardly thereof and terminating in transversely spaced-apart barbs 92." FN42

FN42. *Id.*, col. 4, ll. 64-57.

As can be seen, the specification is consistent with the claim language, and confirms that the stud gripping means comprise spaced-apart barbs. Contrary to Orbit's contention, nothing in the specification limits the gripping means to "barbs or teeth deformed outwardly from a surface." To the contrary, it appears that the specification contemplates that other gripping means may be used in addition to barbs, referencing "resilient stress" in the arm extending from the first flange that pulls the second flange of the bracket toward the stud.

FN43 Thus, the specification reflects the claims' explicit requirement that the gripping means must include barbs that are "spaced-apart both longitudinally and transversely of said second flange," but that it need not be limited to barbs.FN44 Accordingly, the court construes "stud gripping means" to mean "that which allows the bracket to attach firmly to the wall stud and which includes, but is not limited to, a plurality of barbs." FN45

FN43. Id., col. 5, ll. 19-20.

FN44. This interpretation is not contradicted by the prosecution history. In response to a September 18, 1990 action letter issued by the USPTO, the inventor explained that extensions from the second flange "have a pair of stud gripping means spaced longitudinally thereof for better gripping against a stud wall"; in doing so, he did not limit the stud gripping means to any particular form. (Congolosi Decl. II, Exh. C at 6 (response to office action letter of September 18, 1990)).

FN45. As noted, Orbit proposes that the word "barb" be qualified by the phrase "deformed outwardly from a surface." This addition is unnecessary, as "barbs" inherently project outward from the surface on which they are attached. See WEBSTER'S THIRD INTERNATIONAL DICTIONARY (1976) (defining "barb" as "a sharp projection extending backwards (as from the point of an arrow, spear, or fishhook) preventing easy extraction from a wound" or "any sharp projection with its point similarly oblique or crosswise to something else").

### III. CONCLUSION

For the foregoing reasons, the court adopts the following constructions:

-> "First and second flanges": "The pair of structural members that extend from the web for receiving a wall stud between."

-> "Resilient arm": "the portion of the bracket that is connected to the first flange, and that is capable of recovering its size and shape after deformation caused especially by compressive stress."

-> "Stud gripping means": "That which allows the bracket to attach firmly to the wall stud and which includes, but is not limited, a plurality of barbs."

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Thomas & Betts Corp. v. Orbit Industries, Inc.

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