

United States District Court,
S.D. Iowa, Eastern Division.

McKAY ACQUISITION, INC. d/b/a Jancy Engineering, Inc,
Plaintiff/Counterclaim-Defendant.

v.

ROCKIES GLOBAL MARKETING, LLC and Steelmax Acquisitions, LLC,
Defendants/Counterclaim-Plaintiffs.

No. 06-CV-1030-LRR

Feb. 7, 2008.

Glenn L. Johnson, Kevin H. Collins, Shuttleworth & Ingersoll, Cedar Rapids, IA, for Plaintiff/Counter
Defendant.

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ORDER REGARDING CLAIM CONSTRUCTION

LINDA R. READE, **Chief Judge.**

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I. INTRODUCTION

This matter comes before the court for construction of the disputed claim of the patent-in-suit, the '503 Patent. FN1

FN1. Portable Drilling Machine with Internal Motor Control Cord, U.S. Patent No. 5,415,503 (filed May 2, 1994) (issued May 16, 1995).

II. BACKGROUND

A. Factual Background

Plaintiff/Counterclaim-Defendant McKay Acquisition, Inc. d/b/a Jancy Engineering, Inc. ("McKay Acquisition") is an Iowa corporation with its principal place of business in Davenport, Iowa. McKay Acquisition makes and sells the Jancy Engineering line of industrial power tools, which are well-known in the construction industry and other heavy industries. One of the power tools in McKay Acquisition's line are portable industrial drills that have a magnetic base. The focus of the instant litigation is McKay Acquisition's Slugger (TM) JM 201 drill.

Defendant/Counterclaim-Plaintiff Rockies Global Marketing, LLC ("RGM") and Defendant/Counterclaim-Plaintiff SteelMax Acquisitions, LLC ("SteelMax") are both Colorado corporations with their principal places of business at the same address in Centennial, Colorado. RGM and SteelMax have common ownership and share common employees.

On February 11, 2003, RGM was formed as a corporate entity.

On March 20, 2003, McKay Acquisition acquired substantially all of the assets of Jancy Engineering Company, including the ownership of the '503 Patent. Following the asset purchase, Jancy Engineering Company ceased operations. Immediately prior to March 20, 2003, William Kirkland Strange ("Kirk Strange") served as the President of Jancy Engineering Company and Gerry Zack served as the Marketing Director of Jancy Engineering Company.

In April of 2003, Kirk Strange and Gerry Zack began working for RGM. On February 24, 2006, SteelMax was formed as a corporate entity. As of December of 2006, Kirk Strange was working as RGM's Vice-President of Business Development and Gerry Zack was working as RGM's Vice President of Marketing and Product Development.

B. Procedural Background

On October 30, 2006, McKay Acquisition filed a Complaint against RGM and SteelMax. McKay Acquisition claims that, prior to the time their employment with McKay Acquisition terminated, Kirk Strange and Gerry Zack "individually or collectively, copied and otherwise misappropriated the product development information related to the Slugger (TM) JM 201...." Complaint (docket no. 1-1), para. 28.

McKay Acquisition further claims that, "within months after March 20, 2003, RGM began to commercially offer a line of portable industrial drills having a magnetic base which are identical or substantially identical to the Slugger (TM) JM 201" and that the RGM drills are called the SteelMax d1 and the SteelMax d2. *Id.* at para. 29. It argues that, since February 24, 2006, SteelMax has commercially offered the SteelMax d1 and SteelMax d2. *Id.* at para. 30.

The Complaint alleges patent infringement, copyright infringement, trademark infringement and unfair competition. McKay Acquisition seeks a preliminary and permanent injunction, an award of damages, prejudgment interest, treble damages, punitive damages, attorneys' fees and costs.

RGM and SteelMax deny that they engaged in unfair competition and that the SteelMax d1 and SteelMax d2 models infringe on the Slugger (TM) JM 201 in any way. Answer (docket no. 8). Further, RGM and SteelMax counterclaim for declaratory judgment of invalidity and non-infringement of the patent, the copyright and the trademark ("Counterclaims"). *Id.* at 16-18.

On September 6, 2007, RGM and SteelMax filed a Motion for Claim Construction ("Defendants' Motion") (docket no. 20); the parties filed a Joint Claims Construction Chart ("JCCC") (docket no. 21); and McKay Acquisition filed Plaintiff's Motion re Claims Construction ("McKay Acquisition's Motion") (docket no. 22). On September 20, 2007, RGM and SteelMax filed Defendants' Response to Plaintiff's Motion for Claim Construction ("Defendants' Response") (docket no. 25). On September 21, 2007, McKay Acquisition filed Plaintiff's Reply to Defendants' Claim Construction Brief ("McKay Acquisition's Reply") (docket no. 30).

On November 16, 2007, the court disseminated a draft claim construction order for the parties' review.

On February 4, 2008, the court held a hearing pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996) ("*Markman* Hearing") in this patent infringement action. *See generally id.* (holding that claim construction is a question of law for the court), *aff'g*, 52 F.3d 967 (Fed.Cir.1995) (en banc). Attorneys Glenn Johnson and Ryan Carter represented McKay Acquisition. Attorney Stephen Holtman represented RGM and SteelMax.

The court finds that the disputed claim of the patent-in-suit is fully submitted and ready for construction.

III. JURISDICTION

The court has original jurisdiction of civil actions "arising under any Act of Congress relating to patents, ... copyrights and trademarks." 28 U.S.C. s. 1338(a). It also has jurisdiction over related claims of unfair competition. *Id.* s. 1338(b). Plaintiff's Complaint and Defendants' Counterclaims raise various claims of patent infringement, in violation of 35 U.S.C. s. 271; copyright infringement, in violation of 17 U.S.C. s. 501; trademark infringement, in violation of 15 U.S.C. s. 1114; and common law unfair competition. Therefore, the court has subject-matter jurisdiction pursuant to s. 1338(a) and (b).

IV. PRINCIPLES OF CLAIM CONSTRUCTION

A patent is a legal document that describes the exact scope of an invention to "secure to [the patentee] all to which he is entitled [and] to apprise the public of what is still open to them." *Markman*, 517 U.S. at 373 (citations omitted). By statute, a patent consists of two different elements: one or more "claims," which "particularly poin[t] out and distinctl[y] clai[m] the subject matter which the applicant regards as his invention," and the "specification," which describes 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." *Id.* (citing 35 U.S.C. s. 112). "It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.'" *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed.Cir.2005) (en

banc) (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed.Cir.2004)). The goal of claim construction is to give proper meaning and scope to claim language. *Abtox, Inc. v. Exitron Corp.*, 122 F.3d 1019, 1023 (Fed.Cir.1997).

There is "no magic formula or catechism for conducting claim construction." Phillips, 415 F.3d at 1324. However, the Federal Circuit Court of Appeals has developed the following general principles:

A. Claims

Claim construction always starts with the language of the claim itself. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996); *see also* *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1344 (Fed.Cir.1998) ("The actual words of the claim are the controlling focus.") (citing *Thermalloy, Inc. v. Aavid Eng'g, Inc.*, 121 F.3d 691, 693 (Fed.Cir.1997)); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed.Cir.1998) (stating that claim construction "begins and ends in all cases with the actual words of the claim"); *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed.Cir.1985) ("[I]t is the *claims* that measure the invention.") (emphasis in original). "[T]he words of a claim 'are generally given their ordinary and customary meaning.' " Phillips, 415 F.3d at 1312 (quoting *Vitronics*, 90 F.3d at 1582). The ordinary rules of grammar and syntax also apply. *In re Hyatt*, 708 F.2d 712, 714 (Fed.Cir.1983).

"[T]he 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." Phillips, 415 F.3d at 1313 (citation omitted). The perspective of a person of ordinary skill in the art is "based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to be read by others of skill in the pertinent art." *Id.* (citing, in part, *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1119 (Fed.Cir.2002)). In certain cases, however, the patentee may unequivocally impart a novel meaning to claim terms. *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed.Cir.2003) (citations omitted). "It is a well-established axiom in patent law that a patentee is free to be his or her own lexicographer and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings." *Hormone Research Found., Inc. v. Genentech, Inc.*, 904 F.2d 1558, 1563 (Fed.Cir.1990). Therefore, "it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." *Vitronics*, 90 F.3d at 1582.

B. Specification

The claims "must be read in view of the specification, of which they are a part." *Markman*, 52 F.3d at 979. The specification is "the primary basis for construing the claims." Phillips, 415 F.3d at 1315 (quoting *Standard Oil Co. v. Am. Cynamid Co.*, 774 F.2d 448, 452 (Fed.Cir.1985)). "The close kinship between the [specification] and the claims is enforced by the statutory requirement that the specification describe the claimed invention in 'full, clear, concise, and exact terms.' " *Id.* at 1316 (quoting 35 U.S.C. s. 112). The Federal Circuit Court of Appeals recently summarized:

Ultimately, 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. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction.

Id. (quoting *Renishaw*, 158 F.3d at 1250).

If there is a dispute about the meaning of a claim term, the specification presents "the single best guide to the meaning of the disputed term." *Vitronics*, 90 F.3d at 1582. "[T]he 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." *Phillips*, 415 F.3d at 1323. It is well-settled, however, that courts should not ordinarily read a limitation into a claim from the specification. As the Federal Circuit Court of Appeals makes clear:

[The Federal Circuit Court of Appeals] has consistently adhered to the proposition that courts cannot alter what the patentee has chosen to claim as his invention, that limitations appearing in the specification will not be read into claims, and that interpreting what is *meant* by a word *in* a claim is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.

Laitram Corp. v. NEC Corp., 163 F.3d 1342, 1348 (Fed.Cir.1998) (citations omitted, emphasis in original); *accord KJC Corp. v. Kinetic Concepts, Inc.*, 223 F.3d 1351, 1356 (Fed.Cir.2000) ("[A]lthough the specifications may well indicate that certain embodiments are preferred, particular embodiments appearing in a specification will not be read into the claims when the claim language is broader than such embodiments.") (quoting *Electro Med. Sys., S.A. v. Cooper Life Scis., Inc.*, 34 F.3d 1048, 1054 (Fed.Cir.1994)). To avoid pitfalls, the court must remain focused "on understanding how a person of ordinary skill in the art would understand the claim terms." *Phillips*, 415 F.3d at 1323.

C. Prosecution History

The court should also consider the patent's prosecution history, if it is in evidence. *Phillips*, 415 F.3d at 1317. The prosecution history consists of the record of the patent before the United States Patent and Trademark Office ("PTO"). *Id.* The prosecution history includes the prior art cited during the examination of the patent. *Id.*

Although the prosecution history may assist in claim interpretation, as a general rule it may not "enlarge, diminish or vary the limitations in the claims." *Markman*, 52 F.3d at 980 (internal quotations omitted). Moreover, the prosecution history "often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Phillips*, 415 F.3d at 1317.

Nonetheless, the 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. *Vitronics*, 90 F.3d at 1582-83; *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); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed.Cir.1995).

Id.

The prosecution history here is uncomplicated. *See Plaintiff's Motion* (docket no. 22-2), at 7-8. There were no rejections issued by the PTO, and Claim 1 of the originally filed patent application is identical to Claim 1 of the '503 Patent. *Id.*

D. Extrinsic Evidence

The claims, the specification and the patent's prosecution history comprise the so-called "intrinsic" evidence of the meaning of the claim terms. *Vitronics*, 90 F.3d at 1582. The intrinsic evidence is considered the most important evidence for construing a patent. *Id.* Other evidence that may be considered in construing a patent is so-called "extrinsic evidence," which is "evidence [that] is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles." *Id.* at 1584. For example, the court may

consult dictionaries and technical treatises "at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents."

Phillips, 415 F.3d at 1322-23 (quoting *Vitronics*, 90 F.3d at 1584 n. 6).

The Federal Circuit Court of Appeals has repeatedly cautioned district courts that, "while extrinsic evidence 'can shed useful light on the relevant art,' ... it is 'less significant than the intrinsic record in determining the legally operative meaning of claim language.'" Phillips, 415 F.3d at 1317 (quoting *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 862 (Fed.Cir.2004)). Extrinsic evidence "is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence." *Id.* at 1319. As the Federal Circuit Court of Appeals articulated in *Vitronics*:

[I]n most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence.... The claims, specification and [prosecution] history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely. In other words, competitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention. Allowing the public record to be altered or changed by extrinsic evidence introduced at trial, such as expert testimony, would make this right meaningless.

90 F.3d at 1583 (citations omitted); *see also* *Ga. -Pac. Corp. v. U.S. Gypsum Co.*, 195 F.3d 1322, 1332 (Fed.Cir.1999) ("[W]hen intrinsic evidence is unambiguous, it is improper for the court to rely on extrinsic evidence to contradict the meaning of the claims.") (citation omitted).

The court has the discretion to admit extrinsic evidence. Phillips, 415 F.3d at 1319. District courts are not "barred from considering any particular sources or required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence." *Id.* at 1324 (citations omitted). In exercising its discretion, however, the court should "keep in mind the flaws inherent in each type of evidence and assess that evidence accordingly." *Id.* at 1319.

E. Means-Plus-Function Construction

Title 35, United States Code, Section 112, Paragraph 6 provides as follows:

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.

35 U.S.C. s. 112, para. 6. This statute "allows patent applicants to claim an element of a combination functionally, without reciting structures for performing those functions." *Enviro Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1364 (Fed.Cir.2000). "Limitations contemplated by s. 112, para. 6, often referred to as means-plus-function or step-plus-function limitations, recite a specified function to be performed rather than the structure, material, or acts for performing that function." *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1429-30 (Fed.Cir.2000). In other words, "a patentee may define the structure for performing a particular function generically through the use of a means expression, provided that it discloses specific structure corresponding to that means in the patent specification." *Kemco Sales, Inc.*

v. Control Papers Co., 208 F.3d 1352, 1360 (Fed.Cir.2000) (citations omitted). Where a patent claim includes a means-plus-function element, the construction of the element is "limited to the structure corresponding to the claimed function as 'described in the specification and equivalents thereof.'" *Envirco Corp.*, 209 F.3d at 1365 (quoting 35 U.S.C. s. 112, para. 6); *see also* *Atmel Corp. v. Info. Storage Devices, Inc.*, 198 F.3d 1374, 1380-82 (Fed.Cir.1999) (holding the structure supporting a means-plus-function limitation must be disclosed in the specification).

The use of the word "means" in a claim gives rise to a presumption that s. 112, para. 6 applies. *Personalized Media Commc'ns, LLC v. ITC*, 161 F.3d 696, 703-04 (Fed.Cir.1998) (citing *York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1574 (Fed.Cir.1996)). Conversely, failure to use the term "means" creates a presumption that s. 112, para. 6 does not apply. *Id.* (citing *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1213 (Fed.Cir.1998)). "These presumptions can be rebutted if the evidence intrinsic to the patent and any relevant extrinsic evidence so warrant." *Id.* at 704 (citing *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed.Cir.1996)). "In deciding whether either presumption has been rebutted, the focus remains on whether the claim as properly construed recites sufficiently definite structure to avoid the ambit of s. 112, para. 6." *Id.* (citing *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1427-28 (Fed.Cir.1997)).

Once a court has determined that a claim limitation is written in means-plus-function format, construction of the means-plus-function limitation proceeds as follows:

[First,] the court must identify the function of the limitation." *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed.Cir.2003) (citing *Micro Chem., Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250, 1258 (Fed.Cir.1999)). Next, the court "ascertains the corresponding structure in the written description that is necessary to perform that function." *Id.* (citing *Micro Chem.*, 194 F.3d at 1258) (emphasis added); accord *Omega Eng'g*, 334 F.3d at 1321] ("[T]he structure must be necessary to perform the claimed function."). Lastly, "[s]tructure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim." *Altiris*, 318 F.3d at 1375 (quoting *B. Braun Med. v. Abbott Labs.*, 124 F.3d 1419 (Fed.Cir.1997)).

Kinzenbaw v. Case LLC, 179 F.A'ppx 20, 24 (Fed.Cir.2006) (emphasis in original); accord *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1333-34 (Fed.Cir.2004).

V. CONSTRUCTION OF THE '503 PATENT

The '503 Patent only contains one claim, and the parties have provided stipulated definitions for certain clauses of Claim 1. *See* JCCC, at 1-4 (stipulating to definitions for the following terms and phrases: "electrical control panel," "housing," "electric motor power control cord," "electric motor power control cord intermediate portion," "electric motor power control cord having an upper end fixedly supported on the electric drive motor" and "electric drive motor"). The parties ask the court to construe six terms from Claim 1 of the '503 Patent.

Claim 1 of the '503 Patent reads as follows, with the disputed terms underlined:

1. A portable electromagnetic drilling machine **(10)** having an electromagnetic base **(12)**, a housing **(14)** with an inner wall **(56)** mounted on said base, a cutting tool spindle **(28)** mounted on said base **(12)**, and an electric spindle drive motor **(36)** slidably mounted on said housing **(14)** for upward and downward movement with the cutting tool spindle **(28)**, wherein:

(a) said machine **(10)** has an electrical control panel **(20)** mounted in said housing **(14)**;

(b) said housing (**14**) has a *chamber* (**18**) formed therein above said electrical control panel (**20**);

(c) said machine (**10**) has an electric motor power control cord (**50**) having a lower end positioned in said *chamber* (**18**) above said electrical control panel (**20**) and being operatively connected to said electrical control panel (**20**);

(d) said electric motor power control cord (**50**) having an intermediate portion extended through an *opening* (**54**) in the inner wall (**56**) of said housing (**14**) and into a space (**74**) between said housing inner wall (**56**) and said electric drive motor (**36**);

(e) said electric motor power control cord (**50**) having an upper end fixedly supported on the electric drive motor (**36**) in an *enclosure means* (**60, 66, 68**) mounted on said drive motor (**36**), and said cord (**50**) being operatively connected to the drive motor (**36**); and,

(f) *cover means* (**72**) for enclosing the space (**74**) between said cord *enclosure means* (**60, 66, 68**) on the electric drive motor (**36**) and the housing inner wall (**56**).

'503 Patent, col.4, ll.6-36 (underlining added, bold emphasis in original). The parties urge the court to adopt different constructions of the above-underlined terms in Claim 1.

For each of the disputed terms, the court has examined the perspective of a person of ordinary skill in the art, and it has reviewed the specification, as it must. *See Phillips*, 415 F.3d at 1313; *Vitronics*, 90 F.3d at 1582; *see also Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed.Cir.2004) (explaining that "customary meaning" refers to the "customary meaning in [the] art field"). The disputed terms used in the '503 Patent are not terms of art in the engineering community. *See Affidavit of Edward L. Briggs* ("Briggs Affidavit") (docket no. 22-4, pps. 22-25), at para. 7; *see also Affidavit of Carl S. Larson* ("Larson Affidavit") (docket no. 22-4, pps. 8-12), at para. 8 ("The terms set forth in Claim 1 of the '503 [P]atent are not specialized 'terms-of-art.' "). As stated previously, the prosecution history in this case is irrelevant to the claim construction issues at hand. *See supra*, at Part IV. C.

Additionally, many of these disputed claim terms do "not require elaborate interpretation." *Brown v. 3M*, 265 F.3d 1349, 1352 (Fed.Cir.2001). This is a case in which "the ordinary meaning of claim language as understood by a person of skill in the art [is] readily apparent even to lay judges," and, therefore, this claim construction "involves little more than the application of the widely accepted meaning of commonly understood words." *Phillips*, 415 F.3d at 1314. The court shall 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." *Id.* (quoting *Innova*, 381 F.3d at 1116).

The court addresses each of the disputed terms, in turn:

A. "*Chamber* "

McKay Acquisition suggests that the term "chamber" means "an internal space or cavity." JCCC, at 2; Larson Affidavit, at para. 8; Briggs Affidavit, at para. 8; McKay Acquisition's Motion, at 15-16. Defendants argue that the term "chamber (**18**)" FN2 is "defined by the housing (**14**) and the inner wall (**56**)." JCCC, at 2.

FN2. The court notes that Defendants use parenthesis and bolding sporadically in their citations to claim terms. In Claim 1, each numeral associated with a claim term appears consistently in bold print and within parenthesis. For the sake of consistency, the court will modify Defendants' citation format to follow the style used in Claim 1.

The entirety of McKay Acquisition's argument is the following:

[McKay Acquisition] relies on the '503 Patent specification as well as the ordinary meaning of the word "chamber" to support this interpretation. The scope of the invention disclosed and claimed in the '503 Patent is to provide a drill which has an internal cord to prolong the life of the drill by protecting the cord. The power cord begins at the control panel. Obviously, the power cord must travel between the "electrical control panel" and the "drive motor." In order to do this, the drill must have one or more "chambers" or "an internal spaces [sic] or cavities [sic]" for the cord to travel through. The "chamber" of Claim 1 provides one "internal space or cavity" through which a portion of the cord travels.

McKay Acquisition's Motion, at 15-16. Defendants' argument is the following:

An "inner wall (56)" is first required apart from the remainder of the housing (14), and then, the *chamber (18)* is defined within the housing (14) ... and defined relative thereto and the "inner wall (56)" ... as existent between housing (14) and wall (56)... Moreover, chamber (18) is definitively apart from space (74), as a separate area through which the power control cord is disposed.... Thus, space (74) and chamber (18) are definitely discrete areas as delimited by wall (56), which has a cord communicating [sic] opening (54) defined therein.

Defendants' Motion, at 8 (underlined emphasis in Defendants' Motion).

The inventor has used the term "chamber" in a manner that is consistent with its ordinary meaning. Vitronics, 90 F.3d at 1582; *see also* Abtox, Inc. v. Exitron Corp., 131 F.3d 1009, 1010 (Fed.Cir.1997) (discussing the phrase "gas-confining chamber" and stating that the term "chamber" has its ordinary meaning"). The dictionary definition of "chamber" is "a compartment or enclosed space; cavity." Larson Affidavit, at para. 8 (quoting Random House Unabridged Dictionary (2d ed.1993)); Briggs Affidavit, at para. 8 ("Chamber" as used in the '503 [P]atent means an internal space or cavity within the housing of the portable drill."); *see also* Oxford English Dictionary [hereinafter "OED"], *available online at* <http://www.oed.com> (last visited Oct. 24, 2007) (providing varying definitions of the term "chamber," including "[a]n enclosed space, cavity, etc." and "an enclosed space or compartment in a piece of mechanism, etc."); Random House Unabridged Dictionary (2006) [hereinafter "Random House Dictionary"], *available at* *Dictionary.com*, at "chamber" (last visited Oct. 24, 2007) (defining the term "chamber" in part as "a compartment or enclosed space; cavity"); New Lexicon Webster's Dictionary of the English Language [hereinafter "New Lexicon"] 162 (encyclopedic ed.1989) (defining the term "chamber" in part as "a compartment or cavity"); The American Heritage Dictionary of the English Language [hereinafter "American Heritage Dictionary"] 222 (New College ed. 1976) ("Any enclosed space or compartment; cavity."). Here, the dictionary definition does not conflict with or contradict the patent documents. Phillips, 415 F.3d at 1322-23. The court concludes that the term "chamber," as used in the '503 Patent, means an "enclosed internal space or cavity."

B. "Opening "

McKay Acquisition "proposes to interpret the element 'opening' as 'a breach, gap, or hole.' " McKay Acquisition's Motion, at 17; JCCC, at 3; Larson Affidavit, at para. 8; Briggs Affidavit, at para. 8. It, again, relies on the specification and the ordinary meaning of the word "opening." McKay Acquisition's Motion, at 17. Defendants propose that the term "opening" be construed as "an opening in an upper extension wall (56) that is integrally formed on the upper inner side of the housing (14)." Defendants' Motion, at 8; *see also* JCCC, at 3 ("This claim term is limited to being defined in the housing inner wall (56) as described in the text of the specification.").

The inventor has used the term "opening" in a manner that is consistent with its ordinary meaning. Vitronics, 90 F.3d at 1582; *see also* Lawman Armor Corp. v. Winner Int'l, Inc., No. CIV .A. 01-1605, 2002 WL 123342, (E.D.Pa. Jan.28, 2002) (construing claims to require that a "device contain a narrow opening, groove, passage, enclosure or space" and stating that, "[b]ecause the meaning of this language is plain, and no ambiguity remains, the [c]ourt will not rely on any extrinsic evidence to further define these terms"). The meaning of the term "opening" is plain and unambiguous. The dictionary definition of "opening" is "a gap, an aperture." New Lexicon, at 702; *see also* American Heritage Dictionary, at 920 ("A hole or aperture."); Random House Dictionary, at <http://dictionary.reference.com/browse/opening> (defining "opening" as a noun that means "a void in solid matter, a gap, hole, or aperture").FN3 The court cannot find that "the presumption that the ordinary meaning was intended has been overcome ." Sunrace Roots Enter. v. SRAM Corp., 336 F.3d 1298, 1302 (Fed.Cir.2003). The term "opening" in Claim 1 of the ' 503 Patent means "a gap, hole or aperture."

FN3. The fact that other courts have construed other claim terms to mean "opening" shows that the term is plain and unambiguous. *See* State of Cal. Dep't of Transp. v. Tycor Walls, Inc., 106 F.App'x 709, 712 (Fed.Cir.2004) (affirming the district court's claim construction of the word "slot" to mean "a long and narrow opening"); Volovik v. Bayer Corp., No. Civ. 01-1426 (JNE/JG), 2003 WL 21088047, (D.Minn. May 12, 2003) (construing the term "port" to be an "opening" and stating that "[t]he ordinary meaning of 'port' is an opening").

C. "Inner wall "

McKay Acquisition proposes that the phrase "inner wall" in Claim 1 be construed to mean "a portion of the 'housing' that helps to form a chamber inside the 'housing.'" McKay Acquisition's Motion, at 16; JCCC, at 3; *see* Larson Affidavit, at para. 8 (defining "inner wall" as "a wall portion of the housing of the drill that is located within or at an interior point of the drill"); Briggs Affidavit, at para. 8 (same). McKay Acquisition relies on the specification and the ordinary meaning of the words "inner wall." McKay Acquisition's Motion, at 16.

Defendants propose that the phrase "Housing Inner Wall (56)" means " 'the housing upper C-shaped wall (56)' as described in the text of the specification." JCCC, at 3. Defendants argue that "[t]he *housing wall (56)* is a wall defined within, though apart from the housing (14).... Defendants' Motion, at 7 (underlined emphasis in Defendants' Motion). Defendants argue that the "inner wall (56) defines the distinction between chamber (18) and space (74)." *Id.* They also argue that "the inner wall (56) is a necessary element apart from the remainder of housing (14) in that such an inner wall is required to define the also mandatory claim element, opening (54)...." *Id.* Finally, Defendants argue that the inner wall is C-shaped, a part of the construction that is "critical in defining [the inner wall's] relationship to the 'cover means (72)' and in its contribution to the definition of the 'space (74).'" *Id.*

Defendants' proposed definition is, admittedly, taken directly from the specification. *See* '503 Patent, col. 3, l.31 ("housing upper C-shaped wall (56) ... "). In fact, it is taken from the section of the '503 Patent labeled "Description of the Preferred Embodiment." *Id.* at col.3 & col. 4. Although the preferred embodiment has a C-shaped inner wall, *see also* *id.* at Fig. 2, such language appears nowhere within Claim 1 itself. The claim language requires a "wall," but Claim 1 does not require that the wall be any particular geometric shape or size or have any particular orientation. Construing the language in Claim 1 to require a C-shaped wall would import a limitation from the specification into the claim, and the Federal Circuit Court of Appeals warns against such construction. Laitram Corp., 163 F.3d at 1348.

The phrase "inner wall (56)" is found in three places in Claim 1. *See* ' 503 Patent, col.4, ll.8, 26 & 35-36. In

two of those three instances, the inventor uses the words "housing inner wall (**56**).²" *Id.* at ll.25-26 & 35-36. The dictionary definition of the adjective "inner" is "located within, contained near the center." *New Lexicon*, at 499; *see also* Larson Affidavit, at para. 8 & Ex. B (defining "inner" as "situated within or farther within; interior"). The dictionary definition of "wall" is "a usually vertical structure ... built to enclose, support, divide, protect, retain etc." *New Lexicon*, at 1107; *see also* American Heritage Dictionary, at 1442 ("An upright structure of masonry, wood, plaster, or other building material serving to enclose, divide, or protect an area; specifically a vertical construction forming an inner partition or exterior siding of a building ... [or][s]omething resembling a wall in appearance, function, or construction, as the exterior surface of a bodily organ or part...."). Therefore, the meaning of the term "inner wall (**56**)," as used in Claim 1 of the '503 Patent, is a "structure within the interior of the housing that partially forms the chamber."

D. "Space "

McKay Acquisition relies on the ordinary meaning and specification and proposes that the term "space" in Claim 1 means "a volume or area." McKay Acquisition's Motion, at 16; JCCC, at 3; Briggs Affidavit, at para. 9. Defendants propose that the term "space" be construed as an "'enclosed space (**74**) between the housing upper C-shaped wall (**56**) and the space between the [motor (**36**) which includes] motor wall (**62**) and the enclosure plates (**60**) and (**66**)' all as described in the text of the specification." JCCC, at 3 (brackets and bracketed text added by Defendants in JCCC); Defendants' Motion, at 6. Defendants argue that the construction of the term is "dependent upon the other elements and structures that define space (**74**).³" Defendants' Motion, at 7.

Defendants have used a recursive definition of the term "space." The court agrees that the term "space" is somewhat dependent on the other elements and structures that define it, but the ordinary and customary meaning of the term "space" is useful. *See* Phillips, 415 F.3d at 1322-23 (stating that courts may "rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict the definition found in or ascertained by a reading of the patent documents"). The term "space" is defined in one dictionary as "the distance between two points or the area or volume between specified boundaries." *American Heritage Dictionary*, at 1236; *see* Random House Dictionary, *available at* <http://dictionary.reference.com/browse/space>, definition 2 (defining space, in part, as "extent or room in three dimensions"). Nothing about the specification alters the term's ordinary meaning. Here, though, there is no dispute that the term "space" is more than two dimensional, therefore, the phrase "the distance between two points" is inapplicable.

The court construes the term "space," as it is used in Claim 1 of the '503 Patent, as an "area or volume."

E. "Cover means "

McKay Acquisition argues that the phrase "cover means" should be construed as "something that is placed over or about another thing." JCCC, at 4; *see* McKay Acquisition's Motion, at 16; *see also* Larson Affidavit, at para. 8 (defining "cover means" as a "structure that is placed over or about something"); Briggs Affidavit, at para. 8 (same). McKay Acquisition relies on the ordinary meaning of the word "cover" and the '503 Patent specification. McKay Acquisition argues that the phrase "cover means" is not a means-plus-function element, because "[t]he word 'cover' is a noun that recites sufficient structure to accomplish this function" and it overcomes the s. 112, para. 6 presumption. McKay Acquisition's Reply, at 8. It argues that "[t]he function associated with the 'cover means' in element 'f' of Claim 1 is 'enclosing the space.'" *Id.* Additionally, McKay Acquisition argues that Claim 1 provides a "detailed recitation of the structure and its location." *Id.*

On the other hand, Defendants propose that the phrase "cover means" "is the 'plate (**72**)' as described in the text of the specification." JCCC, at 4; Defendants' Motion, at 5. Defendants rely on the stated purpose of the

invention, that is, for the

"power cord (50) [to be] in a protected enclosure at all times, whereby operators of the machine cannot at any time get a hold of said motor power cord (50) and put a strain on the same so as to break the electric connection between the electrical control panel (20) and the electric motor (36)."

Defendants' Motion, at 5 (alteration in Motion, quoting '503 Patent, col.3, l.33-col.4, l.1). Defendants state that this is a means-plus-function claim term, and, therefore, it covers nothing more than the " 'corresponding structure ... disclosed in the specification, as well as equivalents thereto.' " *Id.* (quoting s. 112, para. 6). Defendants finally argue that such an "equivalent" is the "flat plate." *Id.* Defendants argue that McKay Acquisition "ignores the specification definition of the cover means (72) as a 'plate (72)' or 'suitable plate (72),' " and it argues that McKay Acquisition's definition is "impractically over inclusive," because the cover means "cannot be made of something insubstantial, such as gauze or paper, and still perform the required function." Defendants' Response, at 7.

The phrase "cover means" is not in the means-plus-function format. Although the inventor used the word "means," Claim 1 recites sufficient structure to rebut the s. 112, s. 6 presumption. *See Personalized Media Commc'ns*, 161 F.3d at 704 (stating that one of two ways that the presumption may be overcome is if the claim "recites sufficiently definite structure to avoid the ambit of s. 112, para. 6"). The term "cover" is a structural term. *See Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1365 (Fed.Cir.2000) ("The term 'baffle' itself is a structural term."); *see also Mass. Inst. of Tech. & Elecs. for Imaging, Inc. v. Abacus Software*, 462 F.3d 1344, 1354 (Fed.Cir.2006) ("The generic terms 'mechanism,' 'means,' 'element,' and 'device,' typically do not connote sufficiently definite structure."); *Personalized Media Commc'ns*, 161 F.3d at 704 (determining that the term "detector" recited sufficient structure to avoid s. 112, para. 6, but the terms "means," "element" and "device" did not). Moreover, element 'f' of Claim 1 describes, in detail, the location of the "cover means" and its extent. Its location is adjacent to the "space" and "on the electric drive motor ... and the housing inner wall ." '503 Patent, col.4, ll.33-36. Its extent is "between said cord enclosure means...." '503 Patent, col.4, ll.33-34. This "cover means" element cannot, therefore, "meet the requirements of [s. 112, para. 6]," because it is a detailed structural recitation. *Cole*, 102 F.3d at 531.

The "cover means" language is similar to the claim language in *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 530 (Fed.Cir.1996). There, the Federal Circuit Court of Appeals affirmed the district court's ruling that "the claimed 'perforation means ... for tearing' [w]as not a means-plus-function element under s. 112, para. 6...." *Id.* (quoting claim language). The Federal Circuit Court of Appeals noted that the drafter of the claim was "clearly enamored of the word 'means,' " and it stated that "the 'perforation means.. for tearing' element of [the] claim fail[ed] to satisfy [s. 112, para. 6] because it describe[d] the structure supporting the tearing function (i.e., perforations)." *Id.* at 531. There, the claim described "not only the structure that support[ed] the tearing function, but also its location (extending from the leg band to the waist band) and extent (extending through the outer impermeable layer)." *Id.* The Federal Circuit Court of Appeals determined that the element had a "detailed recitation of its structure" and, therefore, could not meet the requirements of s. 112, para. 6. *Id.* Here, too, the drafter of Claim 1 used the word "means," but the word does "nothing to diminish the precise structural character" of the "cover means" element. *Id.*

Accordingly, the court will construe the phrase "cover means" according to the dictionary definition of the word "cover." The dictionary definition of the noun "cover" is "something which extends over a thing, e.g. a top or lid...." *New Lexicon*, at 224; *American Heritage Dictionary*, at 306 (defining the noun "cover" as "[s]omething that covers or is laid, placed, or spread over or upon something else"). *Cf. Larson Affidavit*, at para. 8 (citing the definition of the verb "cover" as follows: "to place something over or upon, as for protection, concealment, or warmth"). The court construes "cover means (72)" as used in Claim 1 of the '503 Patent as "something that extends over another thing."

F. "Enclosure means "

McKay Acquisition "proposes to interpret the element 'enclosure means' as a 'surrounding structure.' " McKay Acquisition's Motion, at 16; JCCC, at 4; Larson Affidavit, at para. 8; Briggs Affidavit, at para. 8. It, again, relies on the specification and the ordinary meaning of the word "enclosure." McKay Acquisition's Motion, at 16. Defendants rely on the specification, extrinsic evidence and the rules for means-plus-function claim terms. Defendants' Motion, at 3-5. Defendants argue that the phrase "enclosure means" should be defined as "a combination of flat plates connected together in rectangular relation to each other," *id.* at 5, and they argue that the "claim term is the combination of the respective 'enclosure plates **60, 66** and **68**' as described in the text of the specification," JCCC, at 4. Defendants argue that "the specification and drawings clearly define the 'enclosure means **60, 66, 68**' as a combination of flat plates connected together in rectangular relation to each other." Defendants' Motion, at 5.

The court must determine whether the phrase "enclosure means (**60, 66, 68**)" is a means-plus-function limitation, as contemplated by s. 112, para. 6. *IMS Tech.*, 206 F.3d at 1429-30. The inventor used the word "means" in Claim 1, therefore, there is a presumption that s. 112, para. 6 applies. *Personalized Media Commc'ns*, 161 F.3d at 703-04. As stated previously, though, the presumption may be overcome if (1) "a claim element ... uses the word 'means' but recites no function corresponding to the means," *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294, 1302 (Fed.Cir.1999), or (2) the claim "recites sufficiently definite structure to avoid the ambit of s. 112, para. 6," *Personalized Media Commc'ns*, 161 F.3d at 704.

The court finds that the phrase "enclosure means (**60, 66, 68**)" in the '503 Patent is not in a s. 112, para. 6 means-plus-function format. *Accord Digital Angel Corp. v. Datamars, Inc.*, No. Civ. 04-4544 ADMJSM, 2006 WL 1425465, (D.Minn. May 22, 2006) (stating that "the term 'enclosure' is used similarly to 'encapsulation means' and 'means encapsulating' in the claims, but is not a means-plus-function element"). The claim language does not have a function associated with the words "enclosure means ." *See Rodime PLC*, 174 F.3d at 1302. The word "enclosure" is a noun that has a structural character. *Envirco*, 209 F.3d at 1365; *see Random House Dictionary* (defining the noun "enclosure" variously as "something that encloses," "something that is enclosed" and "the state of being enclosed"); *Larson Affidavit*, at para. 8 (defining the phrase "enclosure means" as "a surrounding structure" by relying on the dictionary definition of the word "enclose"); *see also Cole*, 102 F.3d at 531 ("Here, the claim drafter's perfunctory addition of the word 'means' did nothing to diminish the precise structural character of this element ."). Additionally, element 'e' of Claim 1 describes the location of the "enclosure." It states:

(e) said electric motor power control cord (**50**) having an upper end fixedly supported on the electric drive motor (**36**) in an enclosure means (**60, 66, 68**) mounted on said drive motor (**36**), and said cord (**50**) being operatively connected to the drive motor (**36**)....

'503 Patent, col.4, ll.27-32 (emphasis in original). Therefore, the enclosure must be located *on* the drive motor. Because Claim 1 recites the structure and location of the "enclosure," it is not set forth in a means-plus-function format. *See Cole*, 102 F.3d at 531.

The inventor has used the phrase "enclosure means" in a manner that is consistent with the ordinary meaning of the term "enclosure ." *Vitronics*, 90 F.3d at 1582. The court must, however, also read the claim in view of the specification to arrive at a correct construction. *Markman*, 52 F.3d at 979; *Phillips*, 415 F.3d at 1315. Here, there is a dispute about the meaning of the claim term "enclosure," therefore, the court shall look to the specification, as it is "the single best guide to the meaning of the disputed term." *Vitronics*, 90 F.3d at 1582. The court notes that, although the specification uses terms like "enclosure walls," "enclosure plate" and "pair of vertical enclosure plates," the term "plate" and "wall" do not appear in Claim 1 itself. *See '503 Patent*, col.4, ll.6-36. The court cannot read a limitation into Claim 1 from the specification. *Laitram Corp.*, 163 F.3d at 1348. The terms "plate" and "wall" are "extraneous limitations" that appear in the

specification but not in Claim 1. *Id.* A person of ordinary skill in the art would understand the term "enclosure means" as nothing more than "a surrounding structure." It need not consist of flat plates or plates adhered to each other in a rectangular fashion, as the specification suggests, because that is merely the preferred embodiment. *KJC Corp.*, 223 F.3d at 1356. "Absent some clear intent to the contrary, [the Federal Circuit Court of Appeals] does not import examples from the specification into the claims." *In re Omeprazole Patent Litig.*, 483 F.3d 1364, 1372 (Fed.Cir.2007). No such clear intent is present in the '503 Patent.

The court constructs the phrase "enclosure means (**60, 66, 68**)" as meaning "a surrounding structure."

VI. CONCLUSION

The court has construed various disputed terms in Claim 1 of the patent-in-suit, as set forth herein. McKay Acquisition's Motion (docket no. 22) is **GRANTED IN PART AND DENIED IN PART**. Defendants' Motion (docket no. 20) is **DENIED**.

IT IS SO ORDERED.

S.D.Iowa,2008.

McKay Acquisition, Inc. v. Rockies Global Marketing, LLC

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