

United States District Court,
N.D. Illinois, Eastern Division.

AXIA INCORPORATED,
Plaintiff.

v.

JARKE CORPORATION,
Defendant.

April 20, 1989.

MEMORANDUM AND ORDER

MORAN, District Judge.

Plaintiff Axia Incorporated (Axia), owner of U.S. Patent No. 3,762,343 ('343), sued defendant Jarke Corporation (Jarke) claiming that a storage rack manufactured by defendant infringed the '343 patent. Defendant now moves for summary judgment, arguing that its storage racks do not literally infringe the '343 patent because the lower support members in the Jarke racks differ from what is claimed in the '343 patent. Defendant further argues that plaintiff is precluded by the doctrine of prosecution history estoppel from asserting infringement under the doctrine of equivalents. For the reasons hereinafter stated, we grant defendant's motion in part and deny it in part.

BACKGROUND

A. The '343 Patent

This patent describes storage racks which can be stacked on top of each other and can be nested with one another when stored. The storage racks described in the patent specification and drawings have inverted V-shaped rigid members at the top and bottom of the racks. The bottom members of one rack fit on top of the top members of another rack, allowing racks to be stacked. Claim 1, the independent claim, specifies the lower support members as

lower support members at the level of the bottom of the corner post comprising inverted V-shape members *linaly extending continuously* one along each side of the container from front to rear.... (Emphasis added)

'343 patent, column 6, lines 26-30. The interpretation of this clause is critical to determining whether or not the Jarke storage racks infringe Axia's patent.

B. Prosecution History

Plaintiff's assignor filed patent application serial no. 195,175 on November 3, 1971, and filed a continuation in-part application, serial no. 231,472, on March 3, 1972. On September 15, 1972 the patent examiner rejected all claims of application no. 231,472 under 35 U.S.C. s. 103, as obvious in light of the prior art. A different examiner rejected all claims of the parent application on October 10, 1972, for the same reason.

On December 13, 1972, the patentee amended application no. 231,472 as a response to the September 15 Office Action. The changes in claim 1 generally concern the upper V-shaped members. No changes were made to the portion of claim 1 describing the structure of the lower support members. The next day the parent application was abandoned. The examiner issued a final rejection of the remaining application (no. 231,472) on January 23, 1973, again for obviousness. In explaining the rejection, the examiner stated in part:

Skubic [prior art] discloses applicant's claimed combination including the continuous "V" shaped support received in a matching "V" for stacking purposes.

Following this rejection, and an interview with the examiner, the patentee amended claim 1 a second time on March 5, 1973. The portion of the amendment most relevant to this case modified the description of the lower V-shaped rigid members. The twice-amended claim 1-which was ultimately allowed-described the lower V-shaped members as "linearly extending continuously ... from front to rear." Other changes in the claims included changing the description of upper and lower support points to upper and lower support members. In the remarks section, the patentee's attorney emphasized the strength of the structure. The attorney also argued that the examiner was incorrectly combining prior art references to reject the application for obviousness.

C. Jarke's Storage Racks

Defendant manufactures storage racks that are claimed to be fully compatible with the racks which plaintiff sells and which are protected under the '343 patent. The material difference between the two racks-and the only difference at issue for this motion-is that the lower inverted V-shaped rails on the Jarke racks are interrupted and non-continuous between the front and the back of the rack, while Axia's racks contain continuous uninterrupted lower V-shaped members. As mentioned above, the claims of the '343 patent describe the lower V-shaped members as continuous from front to back of the rack.

DISCUSSION

A. Summary Judgment

As in other cases, a party in a patent case is entitled to summary judgment "where there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law," *Hi-Life Prods., Inc. v. American Nat'l Water-Mattress Corp.*, 842 F.2d 323, 325, 6 U.S.P.Q.2d 1132, 1133 (Fed.Cir.1988); *Estate of Stoller v. Ford Motor Co.*, No. 87 C 3729, slip op. at 6, (N.D.Ill., April 18, 1989) (citing cases). Courts must resolve all doubts about whether a genuine issue of fact exists in favor of the party opposing the summary judgment motion and must draw all reasonable inferences in favor of the non-movant. *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656, 229 U.S.P.Q. 992, 994 (Fed.Cir.1986). Additionally, the Federal Circuit has warned that courts should approach with care granting summary judgment on the issue of infringement. *See id.* at 656, 229 U.S.P.Q. at 994. *See also Caddock v. Hy-Meg Corp.*, 668 F.Supp. 1179, 1180, 5 U.S.P.Q.2d 1293, 1293 (N.D.Ill.1987) (citing Seventh Circuit precedent).

B. Infringement

To prevail on this motion, Jarke must show that its device does not literally infringe the '343 patent nor does it infringe under the doctrine of equivalents. Jarke argues that the lack of continuity in the lower support members of its racks avoids literal infringement. Before we can decide whether or not Jarke is correct, we

must construe the claims of the '343 patent. See *United States v. Teletronics, Inc.*, 857 F.2d 778, 781, 8 U.S.P.Q.2d 1217, 1219 (Fed.Cir.1988), *pet. for cert.* filed, 57 U.S.L.W. 3590 (U.S. Feb. 21, 1989) (No. 88-1397); *Moeller*, 794 F.2d at 656, 229 U.S.P.Q. at 994; *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 866, 228 U.S.P.Q. 90, 93 (Fed.Cir.1985).

1. *Claim Construction*

Interpretation of patent claims is a matter of law. *Moeller*, 794 F.2d at 656, 229 U.S.P.Q. at 994. To construe claims, courts may look at the language of the claims at issue, the prosecution history, the prior art, and the specifications, but not the alleged infringing device. *SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1118, 227 U.S.P.Q. 577, 583 (Fed.Cir.1985) (*en banc*). Claims should be construed as they would be by one of ordinary skill in the art. *Loctite*, 781 F.2d at 867, 228 U.S.P.Q. at 93. Furthermore, words in claims should be given their ordinary meaning unless the inventor used the words differently, *ZMI Corp. v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1571, 6 U.S.P.Q.2d 1557, 1560 (Fed.Cir.1988), such as where the inventor acted as his own lexicographer. See *Loctite*, 781 F.2d at 867, 228 U.S.P.Q. at 93.

The portion of the claim at issue is the phrase that describes the structure of the lower inverted V-shaped members as "linearly extending continuously one along each side of the container from front to rear." Plaintiff does not argue that the word "continuous" in this portion of the claim has any meaning other than the commonly understood interpretation of "uninterrupted." Rather, Axia contends that the lower support members on Jarke's racks are continuous rails which simply change elevation from front to rear of the rack, looking much like a rectangular pulse (??). However, plaintiff's argument is premature. As we just stated, claims must be construed prior to comparing the claims to the infringing device, and the alleged infringing device is not looked at to interpret the claims.

Neither the claims themselves, the prosecution history, the prior art, nor the drawings and specifications, give any indication of the word "linearly" that would support an interpretation of crooked or bent lower support members. On the other hand, where the patentee desired to define or clarify terms, he set out such definitions in the specifications (*see* '343 patent, column 4, lines 50-56 ("short lengths"), *id.* at column 5, lines 66-67; column 6, lines 1-5 ("V-shape members")). Consequently, we must draw the conclusion that the patentee intended the phrase "linearly extending continuously" to have its ordinary meaning as construed by one of ordinary skill in the art. There appears to be no factual dispute that the clause at issue should be construed as calling for uninterrupted straight V-shaped support members. We agree.

2. *Literal Infringement*

With the claims properly interpreted, we may now compare the Jarke rack to the claims. See *Moeller*, 794 F.2d at 656, 229 U.S.P.Q. at 994. Literal infringement requires that the alleged infringing device contain every element of the claim. *Teletronics*, 857 F.2d at 784, 8 U.S.P.Q.2d at 1222; *Mannesmann Demag Corp. v. Engineered Metal Prods. Co.*, 793 F.2d 1279, 1282, 230 U.S.P.Q. 45, 46 (Fed.Cir.1986); *Builders Concrete, Inc. v. Bremerton Construction Prods. Co.*, 757 F.2d 255, 257, 225 U.S.P.Q. 240, 241 (Fed.Cir.1985). While the parties dispute whether the Jarke rack literally infringes on the '343 patent, we believe the subject matter at issue is simple enough to make the comparison without additional expert testimony. See *Chore-Time Equipment v. Cumberland Corp.*, 713 F.2d 774, 779, 218 U.S.P.Q. 673, 676 (Fed.Cir.1983). But cf. *Moeller*, 794 F.2d at 657, 229 U.S.P.Q. at 995 (device at issue not simple enough for court to understand without experts).

Making this comparison, we find no literal infringement. First, the lower V-shaped members on the Jarke rack are bent. Furthermore, lower members on the Jarke structure are not continuous but more complicated (??) than the pulse-like shape argued by Axia. Clearly, the structure is not a straight, uninterrupted support member. Consequently, we find no literal infringement.

3. *Doctrine of Equivalents*

Even if defendant's racks do not literally infringe plaintiff's patent, they may still infringe the patent under the equitable doctrine of equivalents. ZMI, 844 F.2d at 1581, 6 U.S.P.Q.2d at 1562. Hughes Aircraft Co. v. United States, 717 F.2d 1351, 1361, 219 U.S.P.Q. 473, 480 (Fed.Cir.1983). For a product to infringe a claim under the doctrine of equivalents, the alleged infringing product must "perform substantially the same function in substantially the same way to obtain the same result" as what is claimed. Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608, 85 U.S.P.Q. 328, 330 (1950) (quoting Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 42, 3 U.S.P.Q. 40, 44 (1929)); ZMI, 844 F.2d at 1581, 6 U.S.P.Q.2d at 1562.

The doctrine of equivalents is an equitable doctrine judicially derived to prevent an infringer from making minor changes to escape infringement liability. See Graver Tank, 339 U.S. at 607-608, 85 U.S.P.Q. at 330; Hughes Aircraft, 717 F.2d at 1361, 219 U.S.P.Q. at 480. However, the doctrine of equivalents is limited by the doctrine of prosecution history estoppel, which prevents the patentee from claiming as an equivalent to a literal reading of the claims that which he or she gave up during prosecution. FN1 Loctite, 781 F.2d at 870, 228 U.S.P.Q. at 96. Thus, if the patentee narrowed the claims of the '343 patent to overcome the examiner's rejection, Axia may not now expand the claims to recapture what was given up. See Hi-Life Products, 842 F.2d at 325, 6 U.S.P.Q.2d at 1134; Mannesmann, 793 F.2d at 1285, 230 U.S.P.Q. at 48.

However, not all amendments made during prosecution will result in estoppel. Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 939 n. 2, 4 U.S.P.Q.2d 1737, 1743 n. 2 (Fed.Cir.1987 (*en banc*), *cert. denied*, 108 S.Ct. 1226, 1474 (1988)); Mannesmann, 793 F.2d at 1285, 230 U.S.P.Q. at 48; Hughes Aircraft, 717 F.2d at 1362, 219 U.S.P.Q. at 481. For example, where an amendment is made to clarify a claim, prosecution history estoppel is not appropriate. See Andrew Corp. v. Gabriel Elecs., Inc., 847 F.2d 819, 825, 6 U.S.P.Q.2d 2010, 2016 (Fed.Cir.), *cert. denied*, 109 S.Ct. 312 (1988). Even where amendments are made to avoid prior art references, prosecution history estoppel will not prevent application of the doctrine of equivalence for parts of the invention that were not of concern to the examiner. See Datascope Corp. v. SMEC, Inc., 776 F.2d 320, 325, 227 U.S.P.Q. 838, 842 (Fed.Cir.1985). Furthermore, when a patentee adds a limitation to avoid a prior art rejection, a court should analyze the prior art to determine the allowable range of equivalents. Labounty Mfg., Inc. v. United States Int'l Trade Comm'n, 867 F.2d 1572, 1576, 9 U.S.P.Q.2d 1995, 1999 (Fed.Cir.1989) (per curiam). There is also support for not applying prosecution history estoppel where a claim is amended in response to an examiner's incorrect rejection. See Great Northern Corp. v. Davis Core & Pad Co., 782 F.2d 159, 166, 228 U.S.P.Q. 356, 359 (Fed.Cir.1986).

Consequently, courts applying prosecution history estoppel should perform their analysis on a case-by-case basis and look at the facts of the case. See Loctite, 781 F.2d at 871 n. 7, 228 U.S.P.Q. at 96 n. 7. Courts should consider the reasons for the amendments, the prior art that was distinguished, and which objections the amendments overcame. Mannesmann, 793 F.2d at 1285, 230 U.S.P.Q. at 48.

Jarke claims that both the December 13, 1972 and the March 5, 1973 amendments limited the structure of lower support members to uninterrupted or continuous in order to overcome the examiner's prior art rejection FN2 (def. mem. in sup. of mo. for sum. jdgmt. (def. mem.) at 10-12; def. reply in sup. of mo. for

sum. jdgmt. (def. reply) at 6-7). Axia, on the other hand, argues that the purpose of the March 5, 1973 amendment was to clarify the strength of the claimed structure (pl. opp. to def. mo. for sum. jdgmt. at 12-13). Furthermore, Axia contends that the prior art disclosed continuous support members and thus the March 5 amendment could not have been submitted to narrow the claims to avoid this property in the prior art.FN3 *Id.* at 13.

A review of the reasons for the March 5 amendment, which prior art was distinguished by this amendment and which objections were overcome by this amendment, is inconclusive. While it is true that the patentee, in the remarks following the amended claims, stated that the bottom support members were continuous, these comments simply paraphrased the amended claim. The patentee never stated that the continuous nature of the lower support members was necessary to avoid the prior art. Cf. *Hormone Research Foundation v. Genentech, Inc.*, 8 U.S.P.Q.2d 1377, 1384 (N.D.Cal. Aug. 4, 1988 (patentee explicitly narrowing claims to overcome rejection). Rather, the emphasis of the remarks section appears to be the strength of the claim structure. The affidavit of Dr. Azzi supports this assertion. Furthermore, the examiner's comments on the reasons for rejecting the claims do not state that the non-continuous lower support members were disclosed in the prior art and that narrowing of this element was necessary for allowance.

The evidence submitted for this motion does not include copies of the prior art cited by the examiner, nor any written record, if it exists, of the February 21, 1973 interview between the patent examiner and the patentee's attorney. Thus, we do not know what elements of the prior art were distinguished, or which objections the amendment overcame. The language of the remarks in the March 5 amendment, Dr. Azzi's affidavit, and the requirement that we view the evidence in the light most favorable to the plaintiff and draw all inferences in Axia's favor, see *Moeller*, 794 F.2d at 656, 658, 229 U.S.P.Q. at 994, 995, supports Axia's arguments. Consequently, we find that a factual question exists concerning whether the March 5 amendment was made for the purpose of narrowing the claim to only continuous lower support members to avoid a prior art rejection based on the broader language. See *Caddock*, 668 F.Supp. at 1182, 5 U.S.P.Q.2d at 1294, 1295.

We believe the Federal Circuit *Datascope* decision further supports our conclusion. In *Datascope*, amendments were introduced following repeated rejections, several amendments and examiner/attorney interviews. One of the grounds for rejection was that the original claims were anticipated by the prior art. *Datascope*, 776 F.2d at 328, 227 U.S.P.Q. at 844 (Davis, J., concurring in part and dissenting in part). In spite of this, the majority of the court found prosecution history estoppel not applicable because the defendant was not able to show that the amendments were made to overcome rejections on the specific structural changes at issue. *Id.* at 325, 227 U.S.P.Q. at 841-842; *id.* at 328, 227 U.S.P.Q. at 844 (Davis, J., concurring in part and dissenting in part). With the evidence presented, Jarke has not yet shown that no factual issue exists on the question of whether the addition of the word "continuous" was made to overcome the examiner's rejection. Consequently, we must deny, for now, defendant's motion for summary judgment on the issue of prosecution history estoppel and thus on the ultimate issue of the inapplicability of the doctrine of equivalents.FN4

CONCLUSION

For the reasons herein stated, Jarke's motion for summary judgment on the issue of no literal infringement is granted, but is denied on the question of no infringement under the doctrine of equivalents.

FN1. Another limitation on the doctrine of equivalents is that a court will not extend a claim to cover that which was prior art at the time of prosecution. *Loctite*, 781 F.2d at 870, 228 U.S.P.Q. at 96. This limitation

is not an issue for this motion.

FN2. Jarke argues that the December 13, 1972 amendment is relevant to this issue. That amendment, which among other changes added the word "uninterrupted" to the description of the inverted V-shaped members, applied to the *upper* not lower support members. Defendant twice mischaracterizes this amendment. First, Jarke omits references to the top frame member and inserts ellipses (*compare* def. mem. at 10 with def. exh. E at 28-29 (resp. to 9/15/72 Office Action at 4-5)). Later, defendant directly claims that the December 13, 1972 insertion of "uninterrupted" applied to the lower support members (*see* def. reply at 6). With the information presented to us we do not see the relevance of these changes in the December 13 amendment to the question of equivalence concerning the lower support member and ignore that amendment in our analysis. We do not see the reason for defendant arguing this point.

FN3. While we agree with Axia that the examiner stated in the January 23, 1973 Office Action that the prior art disclosed "the continuous 'V' shaped support," it is not clear that this comment refers to the *lower* support members. This Office Action was sent in response to the December 13, 1972 amendment, which did not yet characterize the lower support members as continuous. The lower support members were first described as continuous in the March 5, 1973 amendment, following this January 23 Office Action. Neither party attached the prior art to which the examiner referred in the January 23 rejection. Thus, we have no way of confirming whether or not the lower support members were continuous in the prior art.

FN4. Alternatively, we deny Jarke's motion with respect to the doctrine of equivalents even assuming some degree of prosecution history estoppel applies. We cannot determine the range of equivalents that might be allowable because neither party introduced evidence of the prior art. See *Labounty*, 867 F.2d at 1576, 98 U.S.P.Q.2d at 1999. Thus, a question of material fact exists making summary judgment inappropriate.

N.D.Ill.,1989.

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