

United States District Court,  
S.D. California.

**ADELBERG LABORATORIES, INC., a California Corporation, and Marvin Adelberg, an Individual,**  
Plaintiffs.

v.

**IVAC CORPORATION, a Delaware Corporation,**  
Defendant.

**IVAC CORPORATION, a Delaware Corporation,**  
Counterclaimant.

v.

**ADELBERG LABORATORIES, INC., a California Corporation, and Marvin Adelberg, an Individual,**  
Counterdefendants.

No. 88-1447-S (P)

**March 26, 1992.**

## **FINDINGS OF FACT AND CONCLUSIONS OF LAW**

**SCHWARTZ, J.**

In this matter, counsel have presented a case of considerable complexity with a myriad of issues and sub-issues. The Court will attempt to reduce and simplify the matters necessary to determine the case on the basis of the controlling issues presented by the pleadings and the evidence in the case.

This litigation was commenced on September 21, 1988, by the Plaintiffs, Dr. Marvin Adelberg (the patentee) and Adelberg Laboratories, Incorporated, with the filing of their complaint against the Defendant, IVAC Corporation.

The central allegations are that the accused device in this case, the IVAC clamp, infringes the Adelberg reissue patent number RE31584, filed August 10, 1981, granted May 15, 1984, on an original patent number 3,685,787 filed September 8, 1969, and granted August 22, 1972.

IVAC denies the infringement and asserts various defenses including laches, estoppel, invalidity, and inequitable conduct by the inventor of the patent in suit, Dr. Marvin Adelberg. Such defenses appear to be fairly standard in patent infringement litigation.

The Court has considered all of the evidence presented on all issues of this litigation; and although there are numerous issues, nevertheless, infringement presents itself as the central issue between the disputing parties in this case.

In order to succeed on the issue of infringement, the Plaintiff has the burden to show by a preponderance of the evidence that the defendant infringed plaintiffs' patent and the damages, if any, caused by the infringement.

The Plaintiff in a patent suit starts with a legal presumption of validity of its patent. The presumption of validity can only be overcome by the defendant by proving countervailing facts by clear and convincing evidence.

In this case, the defendant has presented evidence of allegedly invalidating prior art and of inequitable conduct on the part of Dr. Adelberg at the interference proceeding and at the reissue proceeding, among others.

### **DEFENSES OF INVALIDITY AND INEQUITABLE CONDUCT**

While the evidence indicates a fairly close identity between the prior art Grifols-Lucas patent (Spanish Utility Model 103,209 of 1964) and the Adelberg patent, and that some questionable representations may have been made in the reissue proceeding, the Court is not persuaded that the evidence rises to the level of clear and convincing to invalidate the Adelberg patent or to hold patentee Adelberg guilty of inequitable conduct. Hence, the inquiry as to infringement will start with the finding that Adelberg reissue patent number 31584 is a valid and enforceable patent.

### **INFRINGEMENT**

In discussing the issue of infringement, no attempt will be made to cover the intricacies of the evidence that has been presented in this trial. However, in considering the evidence which has been presented, largely through expert witnesses, regard must be had as to which evidence and which witnesses are the more convincing.

The Court has gone over its trial notes very carefully; and has examined some of the crucial transcript of the trial. It appears that the testimony of Dr. Adelberg on the issue of infringement was somewhat perfunctory. It amounted to little more than an unsupported recital of alleged points of infringement by IVAC of the Adelberg patent claims.

Checking back in the transcript discloses that the total testimony of Dr. Adelberg on the issue of infringement comprised only about 13 pages out of a transcript which totals in excess of 2,000 pages. That is not to say that Adelberg's testimony was the only testimony with regard to infringement that was advanced on behalf of the Plaintiff, and not the only evidence that was brought forward by the Plaintiff.

On the other hand, the countervailing testimony of IVAC's expert witnesses was detailed, logical, and well supported and convincing. The reference here is primarily to the witnesses Charles McPhee and Ralph King.

The Plaintiffs first allege literal infringement against the defendant. In its consideration of literal infringement, the Court has construed the claims of the Adelberg patent in the light of the prior art, the file wrapper history, including the original patent proceeding, the McPhee interference proceeding and the reissue proceeding. The Court has also considered all the other evidence received in the course of the trial.

On the issue of infringement, the first step is to construe the claims. Then, the properly construed claims are

compared to the allegedly infringing device. *Moeller v. Ionetics, Inc.*, 794 F.2d 653, 656 (Fed.Cir.1986); *ZMI Corporation v. Cardiac Resuscitator Corp.*, 844 F.2d 1576, 1579 (Fed.Cir.1988); *Hormone Research Foundation v. Genentech, Inc.*, 904 F.2d 1558, 1562 (Fed.Cir.1990). The Court is mindful that patent claims must be construed the same way for infringement as for validity. *Tandon Corp. v. U.S. Int'l Trade Comm'n*, 831 F.2d 1017, 1021 (Fed.Cir.1990); *Jonsson v. Stanley Works*, 903 F.2d 812, 820-21 (Fed.Cir.1990); *White v. Dunbar*, 119 U.S. 47, 51-52 (1886). The claims cannot be interpreted for purposes of infringement in a way which would make them also read upon the prior art, because "That which infringes, if later, would anticipate, if earlier." *Peters v. Active Mfg. Co.*, 129 U.S. 530, 537 (1889); *Polaroid Corp v. Eastman Kodak*, 789 F.2d 1556, 1573 (Fed.Cir.1986).

With respect to a patentee's attempts during litigation to give special or uncommon meaning to words in his patent claims:

So long as the meaning of an expression is made reasonably clear and its use is consistent within a patent disclosure, an inventor is permitted to define the terms of his claims. Nevertheless, the place to do so is in the specification of the inventor's application, and the time to do so is prior to that application acquiring its own independent life as a technical disclosure through its issuance as a United States patent. The litigation-induced pronouncements of [the inventor], coming nearly at the end of the term of his patent, have no effect on what the words of that document in fact do convey and have conveyed during its term to the public. *Intellicall, Inc. v. Phonometrics, Inc.*, 952 F.2d 1384, 21 U.S.P.Q.2d 1383, 1386 (Fed. Cir.1992, quoting from *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F.2d 881, 889 (Fed.Cir.1984).

It should be stated as well that the Adelberg commercial clamp does not appear to follow the Adelberg patent. The clamp is not made in accordance with the patent claims. Therefore, the comparison should not be made between the Adelberg commercial clamp and the IVAC clamp but rather between the Adelberg patent claims and the IVAC clamp.

Attention has been given to the fact that claims 1 and 6 are independent claims, whereas, claims 2, 4 and 5 are dependent on claim 1, and claims 7, 8 and 9 are dependent on claim 6. Claim 1, by way of example, is reproduced below. FN1

FN1. A flow regulator for controlling the rate of flow of fluid through a flexible plastic tubing comprising:

a body formed with a passage to receive the tubing;

a clamping surface elongated in the direction of the tubing through said body and integrally formed in said body;

a clamping member mounted on said body for translation longitudinally of said body through a given distance above said clamping surface to unyieldingly define a clearance with respect to said clamping surface of substantially twice the nominal wall thickness of the tubing;

and an opening defining an elongated channel extending longitudinally in said clamping surface and into which a portion of the wall in the tubing is forced by said clamping member,

said body, said clamping surface, said clamping member, and said channel together defining a cross-sectional area smaller than the normal cross-sectional area included by the unclamped tubing and which varies between the ends of said channel as said clamping member is moved relative to said channel. Certain words and phrases that appear in the claims are entitled to special attention. The word, "unyieldingly," in claim 1, and, "unyieldably," in claim 6, are taken herein to mean, "unchanging."

The word, "substantially," as in the phrase, "substantially twice," is taken to signify, "about," or "approximately."

The Plaintiff's Complaint charges IVAC with committing acts of infringement by making, using, or selling clamps embodying the invention claimed in claims 1, 2 and 4-9 of the original reissue patents.

There is no need to repeat these claims at this point as they are in evidence, part of the record, and fully familiar through the blowup boards that were used throughout the trial.

Essentially, the claims describe the invention as "a flow regulator for controlling the rate of flow of fluid through a flexible plastic tubing." The evidence presented in the case has indicated that the primary use of Adelberg's commercially sold clamp is in gravity I.V. sets for medical purposes.

The Court finds no literal infringement by the IVAC clamp and makes the following specific findings and conclusions:

1. Independent claims 1 and 6 of the Adelberg patent are restricted to a clearance between the roller and clamping surface of "substantially twice the nominal wall thickness of the tubing."

"Substantially twice," is construed to mean about twice or approximately twice. No perceptible deviation should be allowed except for inadvertent manufacturing imperfections, which appears to have been the probable intended scope of the word "substantially."

The IVAC clamp has a clearance of 1.2 times the nominal wall thickness of the tubing during the major portion of the roller travel and a clearance of .9 times at the lug. FN2 Clearly, the IVAC clamp has a clearance of much less than twice the nominal wall thickness of the tubing.

FN2. The lug is an inclination or protuberance in the clamping surface whose purpose was described in trial testimony. Both the prior art Grifols-Lucas patent and the IVAC clamp have such a lug.

2. The Adelberg patent defines a clearance of, "unyieldingly", in claim 1, or, "unyieldably," in claim 6 of twice the nominal wall thickness of the tubing. "Unyieldingly," and, "unyieldably," in the context of the Adelberg patent means, "unchangeably," and requires a strictly parallel relationship of the roller to the clamping surface throughout the entire travel of the roller.

The presence of the lug in the IVAC clamp results in a non-parallel travel and structure just as Dr. Adelberg argued was the case with the prior art Lucas patent in the reissue proceeding.

The Court further notes the concluding lines of Adelberg's claim number 6: "said track means being parallel to said clamping surface to unyieldably constrain said roller to movement of said rim in a manner to maintain said clearance."

This phrasing seems to call for a strict application, that is, to require rigid parallel action of the roller as distinguished from the IVAC clamp.

3. Claim 2 of the Adelberg patent specifies a groove or channel with "planar opposite side walls," that, as further specified by claim 4, "are convergent in a direction away from said clamping surface."

The IVAC clamp groove or channel does not have planar opposite side walls nor do the side walls converge. The groove of the IVAC clamp is a curved configuration more like the groove in the prior art Lucas patent.

4. The IVAC clamp does not have the structural configuration specified in claim 8 of the Adelberg patent.

5. The IVAC clamp does not produce the same confinement as does the Adelberg patent clamp. See claim 1, column 8, lines 1-7, and claim 6, column 8, lines 33-36. At trial there was considerable testimony on the matter of confinement and Dr. Adelberg testified that confinement of the edges of the tubing is a necessary part of tube confinement and that a clamp must have confinement to infringe his patent.

It was argued on behalf of Plaintiff that confinement did not include a touching of clamp side walls by the plastic tubing. However, in Defendant's Exhibit B, which is the Adelberg patent, figured 3, 3a, 3b, 7 and 8 of the drawings all depict the tubing touching the side walls of the clamp. Dr. Adelberg testified that such sidewall contact, as further illustrated in Plaintiffs' exhibit 95 easel sketch made at trial, "is very important" (Tr. 844) and that "the key to my patent is the provision of confinement" (Tr. 1260).

Moreover, the reissue file which is Defendant's Exhibit F, at page 31, states "confinement is illustrated by figures 3a and 3b of the patent drawings." And it goes on at that point to say, "however, the tubing is well confined in both instances in the same manner between the roller rim 24, the clamping surface 25, and the lower portions of sidewalls 15." To repeat, for emphasis: "and the lower portion of sidewalls 15." The quote continues: "The above-claimed structural elements and how they interact with each other to produce the new and improved result is neither taught nor even suggested in the Spanish patent."

Mr. McPhee testified that under flow conditions, the tubing does not touch the side walls of the IVAC clamp. The Court concludes that the IVAC clamp does not achieve the same confinement as Adelberg. There is no side wall confinement by IVAC.

Because the IVAC clamp does not infringe either of the independent claims 1 and 6, both of which include the "substantially twice", "unyieldingly" or "unyieldably" and confinement limitations, there can be no infringement of the remaining asserted dependent claims.

With regard to the matter of so-called prosecution history estoppel or file wrapper estoppel, the Court finds that there are instances of prosecution history estoppel against the plaintiff as follows:

1. By cancelling original application claim 9, which specified a clearance of "less than twice," after it was twice rejected on the prior art Dresden patent (which showed a clearance of "slightly less than the double thickness of the wall"), Adelberg is estopped to claim anything other than "substantially twice." This

estoppel is supported in the reissue proceeding by Adelberg's distinction of Lucas as not being substantially twice and his repeated assertions of the criticality of the claimed dimensional relationships.

2. By cancelling claim 16 of the original application, Adelberg agreed with the patent examiner that he was restricted to only structural, as distinguished from functional, claims. The prior art Dresden patent disclosed the function of pinching shut the side edges of the tubing. The Plaintiff is, therefore, effectively estopped from urging a cold flow control claim.

3. By arguing in the interference proceeding for "unyieldingly", i.e., a constant clearance between the roller and the clamping surface floor of the clamp, Adelberg made the distinction between his patent and McPhee's roller clamp (U.S. Patent 3,893,468) FN3 and is estopped to claim any convergence or lug structure such as contained in the IVAC clamp.

FN3. The McPhee patent was involved in an interference with the Adelberg patent. The parties entered a settlement agreement and the interference was later dissolved upon Adelberg's motion.

4. By arguing in the reissue proceedings that his claimed invention had no lug as found in Lucas, that this was a key difference from his patent, Adelberg is estopped to assert infringement by the IVAC clamp, which has a similar lug. Adelberg testified at trial that the Lucas clamping action was not parallel because of the effect of its lug.

With regard to the doctrine of equivalents, if file history estoppel is found as in this case, the doctrine of equivalents cannot be invoked. The particular estoppel limitations imposed upon the Plaintiff preclude it from resorting to the doctrine of equivalents with respect to the accused IVAC clamp.

In any event, the Adelberg patent is not a pioneer invention which might be entitled to a broad range of equivalents.

Moreover, there are significant differences between the claims of the Adelberg patent and the IVAC clamp to the extent that the IVAC clamp does not perform substantially the same function in substantially the same way to produce substantially the same results as Adelberg's claimed invention:

1. The IVAC clamp's primary use is in dedicated I.V. sets to be utilized with an infusion pump rather than in gravity sets.

2. The primary concern in IVAC is the prevention of the runaway phenomenon rather than for control of flow or elimination of negative drift as in Adelberg. The way it achieves its results, and the actual performance results data, are substantially different than in Adelberg's claimed invention.

Therefore, there is no infringement under the doctrine of equivalents.

### **DEFENSE OF LACHES**

With regard to laches, which has been urged as a defense by the defendant, the Court finds that Dr. Adelberg knew or should have known of the existence and characteristics of the accused IVAC clamp more than six years before the filing of Plaintiffs' Complaint. Some of the evidence which the Court found

persuasive is discussed below.

Dr. Adelberg knew the IVAC company quite well, even prior to 1980 (Tr. 1241). By March of 1982, Dr. Adelberg knew that IVAC had been manufacturing its own I.V. sets for two years. In May of 1982, Dr. Adelberg was advised that IVAC was coming out with a new clamp which would be test-marketed. Much earlier than that, he knew that IVAC was building a plant to make I.V. sets. At trial, he admitted that he was not claiming that he was unable to find an IVAC clamp between May, 1982 and November, 1984 (Tr. 808-09).

Dr. Adelberg claims that he didn't learn of the allegedly infringing IVAC clamp until 1984. Yet he waited until September 21, 1988 to file Plaintiffs' Complaint.

The evidence clearly supports a finding that Dr. Adelberg had sufficient knowledge by May of 1982 of the existence of a potentially infringing IVAC clamp to put him on notice to investigate. By his own testimony, he maintained a lively interest and militant investigative attitude towards competing clamps. He testified that from 1970 to the present time, hardly a week went by without tests being performed on clamps under his direction.

Dr. Adelberg's wife is a medical doctor, and is an officer of and a major stockholder of Plaintiff corporation. She has on occasion, brought I.V. sets to Dr. Adelberg and could certainly have obtained the new IVAC clamp. Dr. Adelberg's testimony that he couldn't obtain this new clamp because it was a prescription item is not credible.

The Court finds that bringing this suit more than six years after Dr. Adelberg knew or should have known of the accused clamp constitutes laches.

### **IVAC'S CLAIM FOR ATTORNEYS FEES**

The Defendant IVAC, by its answer and counterclaim, seeks attorneys' fees and other litigation expenses because of alleged inequitable conduct on the part of Dr. Adelberg. The Court has made no such finding of inequitable conduct, nor does the Court consider this an exceptional case under the law to support an award of attorney's fees. Hence, no attorneys' fees will be awarded to IVAC.

Judgment in this case will be in favor of the Defendant IVAC and against the Plaintiffs Adelberg Laboratories and Marvin Adelberg for the reasons stated.

In summary, it is concluded that: (1) the patent in suit has not been proven invalid or unenforceable due to inequitable conduct; (2) Defendant IVAC has not infringed such patent; and (3) Plaintiffs' relief for the period prior to the September 21, 1988 filing of the Complaint is barred by laches.

Each party shall bear its own attorney fees. Costs are awarded to the Defendant IVAC as the prevailing party.

### **JUDGMENT**

This action having been tried by the Court, Edward J. Schwartz, United States District Judge, presiding, the issues having been considered and findings of fact and conclusions of law having been made and filed:

IT IS HEREBY ORDERED, ADJUDGED AND DECREED AS FOLLOWS:

1. Judgment on Plaintiffs' Complaint is in favor of Defendant and against Plaintiffs.
2. Plaintiffs' claimed relief for the period prior to the September 21, 1988 filing of the Complaint is barred by laches.
3. Defendant's Counterclaim seeking a declaration of invalidity and unenforceability of Plaintiffs' Reissue Patent No. Re. 31584 is dismissed on the merits, with prejudice.
4. Defendant's Counterclaim seeking a declaration of non-infringement of said patent is granted.
5. Plaintiffs shall take nothing by their Complaint herein, and Defendant shall recover its costs in this action. Each party shall bear its own attorney fees.

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Adelberg Laboratories Inc. v. IVAC Corp.

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