United States District Court,
W.D. Louisiana, Alexandria Division.

MARTCO LIMITED PARTNERSHIP and,
v.
J.M. HUBER CORPORATION.

Civil Action No. 03-CV-0209-A

Aug. 16, 2004.

Charles S. Weems, III, Edward E. Rundell, Raymond L. Brown, Jr., Stephen A. Lafleur, Gold Weems et al, Alexandria, LA, for Martco Limited Partnership and Glenn Robell.

Joseph W. Looney, Elizabeth Anderson Roussel, Adams & Reese, New Orleans, LA, Albin A. Provosty, Provosty Sadler et al, Alexandria, LA, Jeffrey S. Ginsberg, Richard L. Delucia, Thomas J. Meloro, Kenyon & Kenyon, New York, NY, Warren E. Byrd, II, Adams & Reese, Baton Rouge, LA, for J.M. Huber Corporation.

Judgment Regarding Claim Construction

F.A. LITTLE, JR.**, District Judge.**

Today, we write on the construction, as a matter of law, of a patent held by plaintiff Glenn Robell ("Robell") and licensed to plaintiff Martco Limited Partnership. The plaintiffs allege infringement by defendant J.M. Huber Corporation. A decision of this nature is not an easy one. In fact, the sea of patent law is murky, uncertain, and studded with obstructions that make analysis difficult indeed. We are not unmindful of a report that indicates that nearly 40% of claim constructions given by district courts are modified or overturned by the Federal Circuit on appeal. TM Patents, L.P. v. Int'l Bus. Machs., 72 F.Supp 2d 370, 378 (S.D.N.Y .1999). We are nonetheless intrepid in proceeding with our analysis.

As we observed, plaintiffs, Martco Limited Partnership and Glenn Robell, have brought suit against Defendant, J.M. Huber Corporation, for infringement of United States Patent Number 6,115,926 ("'926"). U.S. Patent No. 6,115,926 (issued Sept. 12, 2000). Patent infringement cases involve two elements: "construing the patent and determining whether infringement occurred." Markman v. Westview Instruments, Inc., 517 U.S. 370, 384 (1996). It is with the first of these elements that this judgment is concerned.

Construction of the patent claim is a matter of law to be decided by the court. *Id*. In construing a patent, there is a "heavy presumption" that the terms used in the patent claim have the ordinary meaning that a person skilled in the relevant art would attribute to them. Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202-02 (Fed.Cir.2002). This ordinary meaning may be determined by referencing dictionaries or other resources that are publicly available when the patent is issued and that are considered to be "reliable sources of information on the established meanings" of the terms used in the claim. Id. at 1203. After

determining the ordinary meaning of the terms used in the patent claim, the court should then review the intrinsic evidence-the patent specification and the prosecution history-to ensure that the presumption in favor of ordinary meaning has not been rebutted. *Id*.

The heavy presumption in favor of ordinary meaning may be rebutted in at least two ways. First, the presumption may be rebutted if, in the intrinsic record, the patentee used a term in a manner that is clearly inconsistent with the ordinary meaning of the term. *Id*. at 1204. Second, the presumption may be rebutted if, in the intrinsic record, the patentee has acted as his own lexicographer, i.e. if the patentee has defined the term. *Id*.

In this case, the parties disagree as to the construction of certain essential terms in the patent. Before the constructions of these individual terms may be addressed, however, there is a preliminary issue that must be addressed: whether language used in the preamble to claim 14 of '926 should be considered a limitation of that patent's claim.

a. Does The Preamble To Claim 14 Limit That Claim's Scope?

The preamble of a patent claim is the introductory portion of the claim proceeding the body of the claim. There is no litmus test for determining if a preamble limits the scope of a claim. Catalina Mktg. Int'l v. Coolsavings.com. Inc., 289 F3d 801, 808 (Fed.Cir.2002). The United States Court of Appeals for the Federal Circuit ("Federal Circuit"), however, has recognized a number of guideposts for assisting trial courts in determining whether to construe the preamble as limiting the scope of a patent's claim. *Id*. The Federal Circuit has held that "clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." *Id*.

In this case, it is clear that the patent office considered aspects of the claimed invention embodied in the preamble necessary to distinguish '926 from the prior art. The patent prosecutor dealing with the Robell invention stated that:

unlike any system or concept encountered so far, and certainly different from the above referenced newly discovered prior art, is the present invention with its visually precise building materials which incorporates the use of a grid system within a grid system, *in combination with a visually precise perimeter measurement means* .

Amendment to U.S. Patent Application No. 08/599,986, Patent No. 5,673,489 (filed May 16, 1997) ("1997 Amendment") (emphasis added). It is the visually precise measurement means, not the plethora of markings creating a grid, that makes the Robell invention worthy of a patent. Because language limiting claim 14 to visually precise measurement means is found only in the preamble, and this language was relied upon in distinguishing '926 from the prior art, the court holds that the preamble must be considered a part of the claim limitation.

Plaintiffs have argued that it is improper to consider the 1997 Amendment in this case because that amendment was to the application for U.S. Patent No. 5,673,489 ("'489"). Patent '926, however, is derived from patent '489. Plaintiffs argue that because '489 is limited to measurement markings along the perimeter but '926 is not, these patents contain different claim limitations and the court, therefore, should not consider amendments to '489 in construing '926. The court finds this argument unpersuasive. The claim limitation at

issue is a limitation in both patents. The fact that '926 does not describe its measurement markings as being along the perimeter of the construction material is not sufficient to distinguish it from '489. In both instances, it is the visually precise measurement means that distinguish the claimed invention from the prior art. Therefore, it is proper for the court to consider the 1997 Amendment in deciding whether to include the preamble as a part of the limitations of claim 14 of '926. *See* Jonsson v. Stanley Works, 903 F.2d 812, 818-19 (Fed.Cir.1990).

B. Constructions of Disputed Phrases.

As mentioned above, in construing the language of a patent claim, the court must first determine the ordinary meaning of disputed terms by referencing dictionaries and other public, reliable resources that are available at the time that the patent was issued. Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202-03 (Fed.Cir.2002). Second, the court must review the intrinsic evidence to ensure that the patentee has not used the disputed terms in a manner that would overcome the presumption in favor of using their ordinary meaning. *Id*.

1. "a gridded measurement system ... [that] provide[s] a visually precise means for fast and accurate cutting, measuring, fastening, and installing of construction material"

The phrase "a gridded measurement system ... [that] provide[s] a visually precise means for fast and accurate cutting, measuring, fastening, and installing of construction material" is used in the preamble to claim 14 of the '926 patent. The court finds that the phrase should be construed as meaning " *a measurement system comprised of a pattern of regularly spaced horizontal and vertical lines used as a reference for accurately cutting, measuring, fastening, and installing construction material by sight*."

There are three terms in this phrase that require construction: grid, visual, and precise. The pertinent definition of grid in The American Heritage Dictionary is "[a] pattern of regularly spaced horizontal and vertical lines ... used as a reference for locating points." THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 796 (3d ed.1992) [hereinafter AMERICAN HERITAGE]. FN1 The pertinent definition of the term visual is "[o]f or relating to the sense of sight." Id. at 1997. The pertinent definition of precise is "[e]xact, as in performance, execution, or amount; accurate or correct." Id. at 1425. The court's construction of the phrase at issue is simply an amalgamation of these definitions.

FN1. There are no differences between the definitions of the relevant terms in the third and fourth editions of the American Heritage Dictionary. Therefore, concerns as to which of the two definitions was available at the time that '926 was issued are irrelevant.

After determining the ordinary meaning of the phrase, the court reviewed the intrinsic evidence to ascertain whether the terms constituting the phrase at issue had been either defined by the patentee or used by the patentee in a manner inconsistent with their ordinary meaning. The patentee has done neither. Therefore, the terms constituting the phrase "a gridded measurement system ... [that] provide[s] a visually precise means for fast and accurate cutting, measuring, fastening, and installing of construction material" are to be given their ordinary meaning, as above stated.

2. "a plurality of horizontally-extending unit measurement markings"

The phrase "a plurality of horizontally-extending unit measurement markings" is used in the first claim

element of claim 14 of '926. The court holds that this phrase should be construed as meaning " *a large number of horizontally-extending markings that express a precisely specified quantity of measurement*."

There are two terms in this phrase that require construction: plurality and unit. The American Heritage Dictionary defines a plurality as, *inter alia,* "[a] large number or amount; a multitude." AMERICAN HERITAGE at 1394. The pertinent definition of unit is "[a] precisely specified quantity in terms of which the magnitudes of other quantities of the same kind can be stated." Id. at 1953. As with the first phrase, the court's construction of the second phrase is simply an amalgamation of the ordinary meanings of the terms constituting the phrase.

After determining the ordinary meaning of the phrase "a plurality of horizontally-extending unit measurement markings" and reviewing the intrinsic evidence, the court finds that there are no grounds with which it could justify diverging from the ordinary meanings of the constituent terms.

3. "a plurality of vertically-extending unit measurement markings"

The phrase "a plurality of vertically-extending unit measurement markings" is used in the second claim element of claim 14 of '926. The court holds that this phrase should be construed as meaning " *a large number of vertically-extending markings that express a precisely specified quantity of measurement*." The only difference between the second and third phrases to be construed is the substitution of the word vertically for the word horizontally. Therefore, the court bases its construction of the third phrase on the reasons stated above for its construction of the second phrase.

4. "a plurality of horizontally-extending and vertically-extending grid markings"

The phrase "a plurality of horizontally-extending and vertically-extending grid markings" is used in the fourth claim element of claim 14 of '926. The court holds that, based on the ordinary meanings established in connection with the discussion of phrases one and two, this phrase should be construed as meaning "a *large number of horizontal and vertical markings that create a grid*." Again, there is nothing in the intrinsic evidence that would justify diverging from the ordinary meaning of the terms that constitute the fourth phrase.

5. "highlighted markings"

The phrase "highlighted markings" is used in claim 15 of '926. The American Heritage Dictionary states the pertinent definition of the term highlighted as "[t]o make prominent; to emphasize." AMERICAN HERITAGE at 853. Given this definition, the court holds that the phrase "highlighted markings" should be construed as meaning "*prominent or emphasized markings*." There is no basis in the intrinsic evidence for diverging from the ordinary meaning of this phrase.

C. Conclusion.

It is the judgment of this court that, as a matter of law, the disputed claims 14 and 15 of the '926 patent be construed as set forth above in accordance with the law of claim construction promulgated by the Federal Circuit. We will delay consideration of the summary judgment motions pending response from the parties. Immediate appeal of this judgment may be requested.

W.D.La.,2004.

Martco Ltd. Partnership v. J.M. Huber Corp.