

United States District Court,
D. Massachusetts.

AMESBURY GROUP, INC,
Plaintiff.

v.
The CALDWELL MANUFACTURING COMPANY,
Defendant.

Civil Action No. 08-10171-DPW

Dec. 17, 2008.

Douglas J. Kline, Safraz W. Ishmael, Goodwin Procter, LLP, Boston, MA, for Plaintiff.

David J. Edwards, Laura W. Smalley, Neal L. Slifkin, Paul J. Yesawich, III, Harris Beach, PLLC, Pittsford, NY, David E. Lurie, Thomas E. Lent, Lurie & Krupp, LLP, Boston, MA, for Defendant.

MEMORANDUM AND ORDER

DOUGLAS P. WOODLOCK, District Judge.

Amesbury Group, Inc. filed this patent infringement suit against Caldwell Manufacturing Company alleging that Caldwell has infringed two of Amesbury's patents: U.S. Patent No. 6,877,187 (filed May 7, 2003) (the "'187 Patent") and U.S. Patent No. 7,353,567 (filed Nov. 27, 2006) (the "'567 Patent"). These two patents involve a type of "window balance," a device used to offset the weight of a window sash (the structure enclosing the window pane(s)) so that the sash can move easily and maintain its position when opened. Amesbury is asserting infringement of claims 17, 18, 20, and 21 of the '187 Patent, and claims 1-17 and 19-23 of the '567 Patent.

Determining patent infringement is "a two-step process, wherein the court first construes the claims and then determines whether every claim limitation, or its equivalent, is found in the accused device." *Roche Palo Alto LLC v. Apotex, Inc.*, 531 F.3d 1372, 1377 (Fed.Cir.2008). The parties are currently presenting claim construction, the first stage of the process. After discussing the background of the case and the relevant legal principles, I construe each of the claim terms said to be disputed.

I. BACKGROUND

The disputed patents in this matter, the '187 and '567 Patents, are continuation patents based on Amesbury's original patent, U.S. Patent No. 6,598,264 (filed Mar. 16, 2001) (the "'264 Patent"). The '264 patent issued on July 29, 2003. The '187 continuation patent issued on April 12, 2005. A second continuation patent, U.S. Patent No. 7,155,778 (filed January 4, 2005) (the "'778 Patent"), not in dispute in this case, issued on

January 2, 2007. The '567 continuation Patent issued on April 8, 2008.

Amesbury's patents involve improvements for window balances, which are used to facilitate the travel of window sashes up and down in what are called "hung windows." Hung windows, which are common in residential and commercial buildings, generally consist of a window frame (the structure that supports the entire window unit) and two window sashes. The sides of the window frame are called window jambs; the jambs contain tracks in which the window sashes slide up and down. Window balances are used to offset the weight of each window sash, so that heavy sashes can move easily up and down in the window jambs, and maintain their position when they are raised.

The '187 and '567 Patents describe window balances that allow the window sash to slide a greater distance than prior art, thereby increasing the maximum size of the window opening. The patented device has a rigid U-shaped channel, which contains a spring at one end and a series of pulleys at the other end. (@567 Patent, 1:56-58.) The pulleys have a cord that is anchored to the window jamb by a jamb mounting hook (or some other similar device). As the window sash travels along the length of the jamb, the spring inside the channel counters the weight of the window sash. ('187 Patent, 5:63-65.)

Window sashes that utilized prior art were limited in their range of travel because some of the pulleys located in the rigid channel interfered with the jamb mounting hook that attaches the window balance to the window jamb. ('187 Patent, 1:31-35.) The '187 and '567 Patents teach mounting the roller lower in the balance so that it does not interfere with the jamb mounting hook. ('187 Patent, 2:1-22.)

This is Amesbury's second patent infringement suit brought in this Court against Caldwell. The first, docketed as Civil Action No. 05-10020-DPW, involved, *inter alia*, allegations that Caldwell's Series 86xt block and tackle window balance infringed the '264 Patent. In that case, I issued summary judgment for Amesbury that Caldwell's device infringed the '264 Patent and denied Amesbury's motion for summary judgment establishing patent validity, leaving that question for trial. *Amesbury Group v. Caldwell Mfg. Co.*, No. 05-10020, 2006 WL 3196747 (D.Mass. Nov.2, 2006). The parties then settled the litigation. Caldwell thereafter modified its design and developed the Series 861xt window balance. Amesbury contends that this new device has infringed the '187 and '567 Patents.

II. CLAIM CONSTRUCTION PRINCIPLES

A "bedrock principle" of patent law is 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) (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Systems, Inc.*, 381 F.3d 1111, 1115 (Fed.Cir.2004)). The construction of these claims is a question of law to be determined by a judge. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384, 390-91, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

A court is to give claim terms "their ordinary and customary meaning." *Phillips*, 415 F.3d at 1312 (quoting *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996)). This is the meaning that a term would have to a person of "ordinary skill in the art in question at the time of the invention." *Phillips*, 415 F.3d at 1313. A party can overcome this presumption of ordinary meaning by demonstrating the patentee's "intent to deviate" from this meaning, as suggested by a redefinition of the term found in the intrinsic record. *Teleflex, Inc., v. Ficosa North Am. Corp.*, 299 F.3d 1313, 1324 (Fed.Cir.2002).

The most significant source of the meaning of the disputed claim terms is the intrinsic evidence—the patent

itself, the specification, and the prosecution history if offered into evidence. Vitronics Corp., 90 F.3d at 1582. A court should interpret the claims in light of the entire patent, including the specification. Phillips, 415 F.3d at 1313. Limitations from the specification, however, should not be read into the claims. Comark Commc'ns v. Harris Corp., 156 F.3d 1182, 1186 (Fed.Cir.1998). If the meaning of a term is still ambiguous after consulting intrinsic evidence, then the court can turn to extrinsic evidence such as dictionaries, treatises, and testimony by experts or inventors. Phillips, 415 F.3d at 1317. Extrinsic evidence, however, while useful, is "less significant than the intrinsic record in determining the legally operative meaning of claim language." *Id.* (internal citations omitted).

III. DISPUTED TERMS

Four claim terms initially identified as disputed terms have not in fact been construed in either of the parties' Claim Construction Briefs, and therefore shall be understood as having their ordinary meaning: "second end," "bottom guide roller," "engaged with the second end of the channel," and "rotatably mounted relative to and located within the bottom guide." I construe the remaining disputed claim terms according to the legal principles of claim construction.

A. "bottom guide"

The claim term "bottom guide" appears in both the '187 Patent and the '567 Patent. Each party offers a definition for the term's use in both patents. Although some claims in which "bottom guide" appears are not asserted by Amesbury, a claim term that appears in more than one claim must be construed consistently. Inverness Med. Switzerland GmbH v. Princeton Biomeditech Corp., 309 F.3d 1365, 1371 (Fed.Cir.2002).

Amesbury defines the term as a "structure, located toward the bottom part of the balance, for directing movement of the balance within a window jamb." Caldwell defines the term as a "structure attached to the end of the balance and extending below the end of the channel, used for guiding the movement of the balance within a window jamb and housing the bottom guide roller." Both parties therefore incorporate structural and functional elements into their claim constructions.

I first discuss the structural aspects of the proposed constructions. Amesbury's structural definition, a "structure, located toward the bottom part of the balance," suffers from a degree of vagueness that would prevent a person with ordinary skill in the art from identifying the bottom guide. The claims themselves provide more specificity. The language of the claims makes clear that the bottom guide is not just "located toward" the bottom part of the balance, but is in fact attached to the channel. Claim 1 of the '187 Patent describes the bottom guide as "connected to the second end of the channel." ('187 Patent, 6:38.) According to the independent claims in the '567 Patent, the bottom guide is "secured to the channel with a fastener" ('567 Patent, Claim 1, 6:56-60); the bottom guide is "located on the channel" ('567 Patent, Claim 11, 7:27). Caldwell's construction using "attached to" is therefore more appropriate than Amesbury's construction using "located toward." But, I do not agree with Caldwell's reference to the "end of the *balance*." The claims consistently refer to attachment to the "channel," not to the "balance." It does not appear appropriate to describe the balance as a separate structure to which the bottom guide is attached, given that the balance is the entire device and comprises the bottom guide. ('187 Patent, 6:36-40; '567 Patent, 6:52-64.)

The claims also refer to the bottom guide as located at the *end* of the channel: The bottom guide is "connected to the second end of the channel" ('187 Patent, Claim 1, 6:39-40); the bottom guide is "located proximate the bottom end of the channel" ('567 Patent, Claim 19, 8:22-25). The Summary of the Invention section for the '187 Patent states that the "top and bottom guides are connected to opposite ends of the

channel." ('187 Patent, 1:45-46.) Amesbury argues that the term "bottom" does not limit the claims to guides located at the farthest extremity of the channel, and that the purpose of the word "bottom" is merely to distinguish the bottom guide from the top guide. To support this construction, Amesbury cites only the specification of '567, which, according to Amesbury, appears to locate the bottom guide's fastener 316 at the bottom portion of the balance, rather than at the extremities of the balance channel. ('567 Patent, 4:47-49, Fig. 4A.) Amesbury, however, does not and cannot persuasively argue that fastener 316 in Fig. 4A is not "connected to the second end" of the channel, as described in Claim 1 of the '187 Patent. ('187 Patent, 6:39-40.) Moreover, Amesbury's construction-that a bottom guide is structurally defined as being "toward" the bottom part of the balance-would arguably include any guide located closer to the bottom part than to the top part. Such a broad construction is not supported by any intrinsic or extrinsic evidence.

Caldwell further construes "bottom guide" in structural terms as "extending below the end of the channel." To support this construction Caldwell cites the specifications of both the '187 Patent and '567 Patent, which both describe the bottom guide as extending beyond the channel. ('187 Patent 1:63-65, 4:47-50; '567 Patent 2:3-5, 4:58-61.) These descriptions, however, are only embodiments in the specification, and thus cannot be used as a limitation upon the claims. *Comark Commc'ns*, 156 F.3d at 1186. Caldwell cites case law observing that "the patentee's choice of preferred embodiments can shed light on the intended scope of the claims." *Astrazeneca AB v. Mut. Pharm. Co., Inc.*, 384 F.3d 1333, 1340 (Fed.Cir.2004). Unlike the patent in *Astrazeneca*, however, the specification language here does not use universal language that operates in a definitional capacity. *See id.* at 1339 (pointing out, when construing "solubilizer," the specification's limiting language, such as "*the solubilizer* suitable for the preparations according to the invention" and "the solubilizers ... *are defined below*").

Lacking similar definitional language in the '187 and '567 specifications, Caldwell has not persuaded me that the claims in fact are limited to bottom guides that extend beyond the channel. Therefore, in structural terms, the "bottom guide" is a "structure attached to the end of the channel."

With respect to the functional meaning of the term, the parties agree that the bottom guide is for "guiding" or "directing" the "movement of the balance within a window jamb." But Caldwell adds an additional functional construction, that the bottom guide is for "housing the bottom guide roller." The only sources Caldwell cites for this are specifications that identify the bottom guide as a frame for housing the bottom guide roller. ('187 Patent, 1:54-56, 4:44-47; '567 Patent, 1:49-54, 4:55-59.) Again, lacking specification language that expresses a definitional function, as in *Astrazeneca*, these embodiments cannot limit a claim term. *Astrazeneca*, 384 F.3d at 1339-40; *Eolas Techs. Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1337 (Fed.Cir.2005) (affirming that the Federal Circuit "consistently declines to construe claims according to the preferred embodiment").

I therefore construe "bottom guide" to mean "structure attached to the end of the channel used for directing the movement of the balance within a window jamb."

B. "guide roller"

The term "guide roller" appears in Claims 1, 2, 5, 9, 10, 11, 14, 15, and 18 of the '567 Patent. (Claim 18 is not asserted in this litigation.) Amesbury construes the term to mean the "roller located proximate the second end of the channel for dispensing the cord." Caldwell's construction is "roller for dispensing the cord located within the bottom guide." Both parties agree that the roller is for dispensing the cord, but they construe the guide roller's location differently. In particular, the parties disagree over whether the roller must

be located within the bottom guide.

The specification teaches that lowering the guide roller permits the window sash to travel a greater distance, thereby creating greater space for egress and entry. ('567 Patent, 2:8-10.) But the specification does not explicitly state whether lowering the guide roller signifies moving it into the bottom guide, or instead signifies moving it to any location that is lower than the roller's location in prior art.

Certain language in the specification, however, does provide more guidance. To distinguish this invention from prior art, the specification refers to the guide roller's location in the bottom guide, rather than in the rigid U-shaped channel. In prior art, the window sash is prevented from traveling a greater distance "by the roller, located within the rigid U-shaped channel, hitting the jamb mounting hook." ('567 Patent, 6:25-28.) The Background Information section states that the guide roller's location in the bottom guide rather than in the channel is the reason for the invention's improvements on prior art: "A disadvantage [of prior art] is that the travel distance of the window sash is limited by some of the pulleys located within the rigid channel." ('567 Patent, 1:37-42.) This language does not appear in descriptions of particular embodiments, but rather in general descriptions of the invention and in language disclaiming prior art.

Amesbury contends that the reason for its patent's improvement on prior art is that it is located lower than it was before, not because it is located in the bottom guide. According to Amesbury, the patent uses the term "guide roller" because the roller is near the location of the bottom guide, not because it is located within the bottom guide. The only portion of the specification cited by Amesbury to support this claim is the description of another embodiment of the device, which does not state whether or not the guide roller is located inside the bottom guide. ('567 Patent, 2:23-30.)

Amesbury looks to the patent claims to argue that Caldwell's construction is contrary to the doctrine of claim differentiation. This doctrine is "based on the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope." *Karlin Tech. Inc., v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72 (Fed.Cir.1999). Consistent with this doctrine, a dependent claim's limitations should not be read into the corresponding independent claim. *Id.* at 972. In the '567 Patent, the dependent Claim 18 ("the guide roller is located within the bottom guide") should not then be read into the corresponding Claim 11 ("a guide roller rotatably mounted proximate the bottom end"). Otherwise, Claim 18 would be superfluous.

Amesbury is correct that where a term is ambiguous, its construction should not be based on words used solely in a dependent claim. But the doctrine of claim differentiation "is not a rigid rule." *Karlin*, 177 F.3d at 972 (citing *Comark Commc'ns*, 156 F.3d at 1187). Here, the limitation articulated in Claim 18 is repeated consistently throughout the specification, including the Background Section, all references indicating that, as suggested by the term itself, a guide roller is indeed located within the bottom guide. Although a court must not simply construe claims according to the preferred embodiment in the specification, *Eolas Techs.*, 399 F.3d at 1337, the Federal Circuit has held "that a claim term was properly construed in accordance with a limitation that was 'repeatedly and consistently' described in the specification where [those statements] ... 'more broadly describe the overall inventions' " of the patent. *Gillette Co. v. Energizer Holdings, Inc.*, 405 F.3d 1367, 1379 (Fed.Cir.2005) (citing *Microsoft Corp. v. Multi-Tech Sys., Inc.*, 357 F.3d 1340, 1346-48 (Fed.Cir.2004)). I therefore construe "guide roller" to mean "roller located within the bottom guide for dispensing the cord."

C. "bottom roller"

The term "bottom roller" appears in Claims 19-23 of the '567 Patent. Both parties agree that the term "bottom roller" represents the same structure as the term "guide roller." I therefore construe "bottom roller" to mean "roller located within the bottom guide for dispensing the cord."

D. "channel"

The term "channel" appears in both the '187 and the '567 Patents. Amesbury's construction is a structural one, defining the term as a "structure forming a generally U-shaped cross section throughout." Caldwell adopts a functional construction, a "rigid structure to which the components of the window balance can be secured," citing the patent specifications for support. ('187 Patent, 3:39-41, 4:36-38; '567 Patent, 3:50-52, 4:47-49.) More than one channel function, however, is identified in the specifications: serving as an external frame to which balance components can be secured ('567 Patent, 3:50-52); and keeping components located within the channel free of debris ('567 Patent, 3:52-54). The functions used at any given time may vary, but the structure will remain constant.

Caldwell's dispute with Amesbury's structural construction is that nothing in the specification requires the channel to be U-shaped throughout its length. In fact, the intrinsic evidence does not specify what portion of the channel must in fact be U-shaped. Given this ambiguity, I turn to extrinsic evidence. *Webster's* defines "channel" as "a metal beam or strip having a U-shaped section." *Webster's Third New International Dictionary* 374 (2002). This definition is consistent with Amesbury's construction, with the exception of Amesbury's qualifier "throughout." I therefore construe the term "channel" to mean a "structure generally forming a U-shaped cross-section."

I note that both parties refer to Caldwell's 861xt series and the metal tabs found at the end of the channel in that device. Knowledge of an accused product may "provide[] meaningful context for the first step of the infringement analysis." *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1326 (Fed.Cir.2006). But I may not "prejudge the ultimate infringement analysis by construing claims with an aim to include or exclude an accused product." *Id.* Consequently, I disregard those construction arguments that are explicitly based on applications to the accused product.

E. "proximate the bottom end of the channel"

The term "proximate the bottom end of the channel" appears in Claim 19 of the '567 Patent. FN1 Claim 19 describes a "bottom guide" and "bottom roller" that are "located proximate the bottom end of the channel, wherein at least a portion of the bottom roller is located below the top end of the bottom guide." ('567 Patent, 8:24-31.) The parties' constructions are very similar. While Amesbury construes the term to mean "close to or near the end of the channel," Caldwell adds another requirement: "near to, *and at least partially below*, the channel." Caldwell defends this additional element by stating that the only feature of the invention that was disclosed in the specification was moving the roller into the bottom guide; accordingly, it contends this feature does not support Amesbury's broad construction.

FN1. Amesbury purports to construe the term "proximate the bottom end," which appears in both Claims 11 and 19 of the '567 Patent as well. Because the Joint Statement of disputed patent terms identified the term as "proximate the bottom end of the channel" (emphasis added), that is the term I will construe here.

Caldwell's argument falls short because Caldwell does not identify language in the specification or

elsewhere that associates a location "at least partially below" the channel with the particular term, "proximate the bottom end of the channel." Caldwell's construction is apparently driven by its interpretation of the roller's location in the device, but this is not sufficient to indicate that the inventor wanted to give special meaning to the term "proximate the bottom end of the channel."

Because I find no ambiguity in the term after looking to the intrinsic evidence, I need not consider the extrinsic dictionary evidence offered by Amesbury. I construe this particular term as "close to or near the bottom end of the channel."

F. "integral with the bottom guide"

Caldwell construes this term to mean "integrated with the bottom guide so that the fasteners are eliminated." This language comes from the specification, which states that as a result of the fixed pulley unit being integral with the bottom guide, "fasteners 337 and 316 can be eliminated because tension of the spring 320 will keep the bottom guide 315 engaged with or connected to the U-shaped channel." ('567 Patent, 5:47-53.) This describes, however, a consequence of being integral with the bottom guide, not the term's meaning.

I will construe the term as "forming as a unit with the bottom guide." Such a construction is not only structurally descriptive, but it also is consistent with the specification. If the fixed pulley unit is "formed as a unit" with the bottom guide, then when the tension of the spring keeps the bottom guide engaged with the channel, the fixed pulley unit will also remain in place.

G. "at least partially disposed in the channel"

The term appears in Claim 1 of the '567 Patent. Amesbury claims that the term need not be construed because its meaning is readily understood. Caldwell responds that the construction must specify that the term includes the requirement of being "not entirely within the channel." Caldwell cites prosecution history of the '187 Patent to support its position, but that history does not pertain to the claims of the '567 Patent. Furthermore, Caldwell is essentially making an argument not about the construction of this particular term, but about the structural requirements of a guide roller. Limiting my analysis here to the construction of the term "at least partially disposed in the channel," I see no need to depart from the term's ordinary meaning.

H. "terminal end"

The term "terminal end" appears in Claims 17, 19, 20, and 21 of the '187 Patent. While Amesbury contends that "terminal end" should be given its ordinary meaning, Caldwell construes the term to mean "the end of the channel." The only argument presented to support that definition is related to Caldwell's accused product. Such argument is best reserved for the next stage of the litigation. There is no indication that a person with ordinary skill in the art would have difficulty understanding the meaning of "terminal end." As a result, I give "terminal end" its ordinary meaning.

I. "guide roller axle"

The term "guide roller axle" appears in Claims 2, 3, and 4 of the '567 Patent. Amesbury's contention is that the term needs no construction, but Caldwell construes the term as being located "within the bottom guide." To support this construction, Caldwell cites an embodiment in the '567 Patent specification. I find resort to an embodiment in the specification not necessary to construe this term. Claim 2 of the '567 Patent makes clear that the axle is the structure around which the guide roller rotates. ('567 Patent, 6:65-67.) This

corresponds with the ordinary meaning of the term "guide roller axle."

J. "engaged with the second channel end"

The term "engaged with the second channel end" appears in Claim 18 of the '187 Patent, which states that the device of Claim 11 comprises "a bottom guide engaged with the second channel end." (187, 8:39-41.) Amesbury contends that this term does not need construction, but offers a construction ("engaged with the second end portion of the channel") in the event I determine that the term requires construction. Caldwell's construction is "attached to the end of the channel." I agree with Amesbury that the term does not need construction. The term can be understood by its ordinary meaning.

K. Additional Undisputed Terms

Four additional terms that Amesbury has construed are apparently no longer disputed by Caldwell. The term "substantially vertical portion" therefore needs no claim construction beyond the ordinary meaning of the words. I construe the term "secured" to mean "connected to," as proposed by Amesbury. I construe the term "integral" to mean "formed as a unit." And the term "means for guiding the balance device," which appears in Claim 20 of the '567 Patent, will be construed to mean "substantially vertical portions of the top guide and the bottom guide and equivalents thereof."

APPENDIX

Term	Proposed Construction by Amesbury	Proposed Construction by Caldwell	Court Construction
bottom guide	structure, located toward the bottom part of the balance, for directing movement of the balance within a window jamb	structure attached to the end of the balance and extending below the end of the channel, used for guiding the movement of the balance within a window jamb and housing the bottom guide roller	structure attached to the end of the channel used for directing the movement of the balance within a window jamb
guide roller	roller located proximate the second end of the channel for dispensing the cord	roller for dispensing the cord located within the bottom guide	roller located within the bottom guide for dispensing the cord
bottom roller	roller located proximate the second end of the channel for dispensing the cord	roller for dispensing the cord located within the bottom guide	roller located within the bottom guide for dispensing the cord
channel	structure forming a generally Ushaped cross section throughout	rigid structure to which the components of the window balance can be secured	structure generally forming a U-shaped cross-section
proximate the bottom end of the channel	close to or near the bottom end of the channel	near to, and at least partially below, the channel	close to or near the bottom end of the channel
integral with the bottom guide	(none)	integrated with the bottom guide so that the fasteners are eliminated	formed as a unit with the bottom guide

at least partially disposed in the channel	ordinary meaning	at least partially disposed within the channel, but not entirely within the channel	ordinary meaning
terminal end	ordinary meaning	the end of the channel	ordinary meaning
guide roller axle	ordinary meaning	an axle within the bottom guide	ordinary meaning
engaged with the second channel end	engaged with the second end portion of the channel	attached to the end of the channel	ordinary meaning
substantially vertical portion	ordinary meaning	(none)	ordinary meaning
secured	connected to	(none)	connected to
integral	formed as a unit [with]	(none)	formed as a unit
means for guiding the balance device	substantially vertical portions of the top guide and the bottom guide and equivalents thereof	(none)	substantially vertical portions of the top guide and the bottom guide and equivalents thereof
second end	ordinary meaning	(none)	ordinary meaning
bottom guide roller	ordinary meaning	(none)	ordinary meaning
engaged with the second end of the channel	ordinary meaning	(none)	ordinary meaning
rotatably mounted relative to and located within the bottom guide	ordinary meaning	(none)	ordinary meaning

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