

United States District Court,
D. Minnesota.

BERNARD DALSIN MANUFACTURING,
Plaintiff.

v.

RMR PRODUCTS, INC,
Defendant.

No. Civ. 98-1149(JRT/FLN

Sept. 14, 1999.

Daniel J. Maertens, Fredrikson & Byron, Minneapolis, MN, for plaintiff.

Scott A. Wold, Henningson & Snoxell, MN; and Richard M. Johnson, Ladas & Parry, Los Angeles, CA, for defendant.

MEMORANDUM OPINION AND ORDER ON DEFENDANT'S MOTIONS FOR SUMMARY JUDGMENT

TUNHEIM, J.

Plaintiff Bernard Dalsin Manufacturing Co. ("Dalsin") brought this action against defendant RMR Products, Inc. ("RMR"), alleging RMR infringed its patent by making, using and selling an "Icebreaker" chimney cap-damper ("the Icebreaker") and a "Universal" chimney top damper ("Universal"). Specifically, Dalsin contends that these two products infringe upon claim 1 of U.S. Patent No. 4,554,863 ("the '863 patent"), which is entitled "Chimney Damper."

This matter is before the Court on RMR's three motions for summary judgment. It moves for partial summary judgment on the issue of limitations on potential damages and summary judgment on the issues of non-infringement and invalidity. For the reasons set forth below, RMR's motion relating to non-infringement is granted, and its motions as to damages and invalidity are denied as moot.

BACKGROUND

Dalsin, a Minnesota corporation, obtained the '863 patent in November 1985. The patent covers a type of chimney damper attachable to the top of a chimney flue. RMR, a company based in California, also manufactures chimney products.

Claim 1 of the '863 patent is the only claim at issue in this litigation. The claim states as follows:

1. A chimney damper attachable to a chimney flue having an upwardly facing, generally planar peripheral

surface defining an upwardly open flue opening, comprising:

- (a) a frame mountable to the open periphery of a chimney flue and having a superior portion oriented to extend above said flue opening;
- (b) flue cover means comprising a thin, generally rectangular metal plate having a generally planar peripheral portion to seal against the upwardly facing surface of a flue opening;
- (c) mounting means for mounting the flue cover means to the chimney flue
- (d) spring means extending between the flue cover means and the superior portion of the frame for spring biasing the flue cover means upwardly away from the flue opening, the flue cover means serving to protect the spring means from heated gases emanating from the flue opening; and
- (e) control means for urging the flue cover means downwardly, in opposition to the spring means into sealing contact with a flue opening, the control means including lock means for maintaining the flue cover in its sealing position. FN1

FN1. In interpreting the elements of claim 1, the Court will discuss the other relevant claims in the patent and necessary portions of the specifications.

James McKendrick is the President of RMR and is the principal designer of the Icebreaker and the Universal. Prior to starting RMR, McKendrick worked as a chimney sweep and, in that capacity, had installed the Dalsin CHIM-A-LATOR chimney cap-damper. RMR had actual knowledge of the '863 patent at least as early as 1991, when the patent was cited as part of a rejection of RMR's patent application for a "Chimney Top System." In part, the Patent Office Examiner who rejected the patent stated "it would have been obvious at the time the invention was made to a person having ordinary skill in the art to provide the cowl of The German patent with the gasket and springs of Dalsin...."

It is undisputed that Dalsin's chimney cap-damper products have not been marked with the '863 patent number. In 1998, Dalsin became aware of RMR's activities and requested that it cease selling products that infringe the '863 patent. RMR therefore was on actual notice of the alleged infringement-at the very latest-on or about January 28, 1998.

After Dalsin instituted this action, RMR served upon Dalsin a set of interrogatories. In Interrogatory in, RMR requested, *inter alia*, the identification of all RMR products charged with infringement; the identification of all claims alleged to be infringed; the identification of where, in the patent's specification, elements of the accused devices are disclosed; and a statement as to how each element in the accused devices is "equivalent to each claimed element." In its initial response, RMR disclosed the two allegedly infringing products but refused to identify which claims were alleged to be infringed or to provide any further information. Dalsin objected that the interrogatory called for legal conclusions and stated that such information only be provided in conjunction with an expert's report filed in compliance with the Court's scheduling order. After RMR expressly requested a more complete response, Dalsin provided a supplemental answer on October 23, 1998. In this answer, Dalsin stated that it was alleging a violation only of claim 1, and described the various elements therein. RMR's Interrogatory 8, served on March 2, 1999 as part of RMR's second set of interrogatories, sought the specific location of "each and every component" of

certain "means" elements in the specification. On April 1, Dalsin responded by stating that each of the elements identified must be interpreted in light of the entire specification, taken as a whole. It then lists where each of the means can be found in the specification.

ANALYSIS

I. Standard of Review

Rule 56 of the Federal Rules of Civil Procedure governs motions for summary judgment, stating in pertinent part:

[Summary] judgment shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.

Fed.R.Civ.P. 56(c). Summary judgment is to be granted only where the evidence is such that no reasonable jury could return a verdict for the non-moving party. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 250, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986).

Initially, the movant bears the burden of bringing forward sufficient evidence to establish that there are no genuine issues of material fact and that the movant is entitled to judgment as a matter of law. *Celotex Corp. v. Catrett*, 477 U.S. 317, 322, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). In evaluating the movant's showing, the evidence offered by the non-moving party is to be believed and all justifiable inferences therefrom are to be drawn in the light most favorable to that party. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986). Where a moving party makes and supports a motion for summary judgment in accordance with Rule 56, a party opposing the motion may not rest upon the allegations or denials of its pleadings; rather, the nonmovant must "set forth specific facts showing that there is a genuine issue for trial." *Liberty Lobby*, 477 U.S. at 256; *Krenik v. County of Le Sueur*, 47 F.3d 953, 957 (8th Cir.1995).

II. Non-Infringement

RMR contends it is entitled to summary judgment because the Icebreaker and Universal do not infringe on claim 1 of the '863 patent as a matter of law. Dalsin argues that disputed facts preclude summary judgment on the issue of infringement.

In evaluating whether the Icebreaker and Universal infringe claim 1 of the '863 patent, a two-step inquiry is required. The Court first must determine the meaning of the language of claim 1, which is a question of law. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 391, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). The inquiry then turns to whether the accused products infringe the claim, once construed, which is a question of fact. *See, e.g.* *Markman*, 517 U.S. at 384. When there is no literal infringement, infringement can still be found under the "doctrine of equivalents," if the differences between the accused product and the claimed invention are "insubstantial." *See, e.g.*, 35 U.S.C. s. 112; *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 24, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997); *Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214, 1222 (Fed.Cir.1996), *cert. denied*, 521 U.S. 1104, 117 S.Ct. 2480, 138 L.Ed.2d 989 (1997). The accused products infringe claim 1 of the patent only if they include *every* limitation of the claim, either literally or by equivalents. *See, e.g.*, *Warner-Jenkinson*, 520 U.S. at 29; *Southwall Techs. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed.Cir.), *cert. denied*, 516 U.S. 987, 116 S.Ct. 515, 133 L.Ed.2d 424

(1995); *Builders Concrete, Inc. v. Bremerton Concrete Prods. Co.*, 757 F.2d 255, 257 (Fed.Cir.1985).

In construing the language of the claim, the Court should construe it so that each of the limitations of the claim has both meaning and effect. *See, e.g.*, *Environmental Instruments v. Sutron Corp.*, 877 F.2d 1561, 1564 (Fed.Cir.1989). Whenever possible, absent contrary intent manifested in the patent, terms in the patent are to be given their ordinary meaning to one skilled in the art. *See, e.g.*, *Digital Biometrics, Inc. v. Indentix, Inc.*, 149 F.3d 1335, 1344 (Fed.Cir.1998). If the meaning of the words is not plain, the Court should look first to intrinsic evidence, which includes the claims, the specification, and the prosecution history file. *See, e.g.*, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). The drawings or figures that are part of the specification may be considered in understanding the meaning of the claim. *See, e.g.*, *Bradshaw v. Igloo Prods. Corp.*, 912 F.Supp. 1088, 1094 (N.D.Ill.), *aff'd in part, vacated in part*, 101 F.3d 716 (Fed.Cir.1996). Resort to extrinsic evidence is only necessary if the Court cannot ascertain the meaning of terms through the use of intrinsic evidence and must refer to outside sources for guidance on the meaning of technical terms and terms of art. *See Markman*, 52 F.3d at 979.

The language of the specification generally will not be construed to add limitations to claim. *See, e.g.*, *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 987 (Fed.Cir.1988). In addition, examples disclosed in the preferred embodiment may aid in the proper interpretation of a claim term, but the scope of the claim is not necessarily limited by such examples. *See Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed.Cir.1988), *cert. denied*, 490 U.S. 1068, 109 S.Ct. 2069, 104 L.Ed.2d 634 (1989). However, resort to the terms of the specification is necessary if the claims contain "means-plus-function" elements. *See* 35 U.S.C. s. 112. Under s. 112, a means-plus-function element must "be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." Thus, if the patentee employs means-plus-function language in a claim, it "must set forth in the specification an adequate disclosure showing what is meant by that language." *In re Donaldson Co.*, 16 F.3d 1189, 29 U.S.P.Q.2d 1845, 1850 (Fed.Cir.1994).

Finally, in construing patent claims, the Court must adhere to the doctrine of "claim differentiation." The Federal Circuit summarized this doctrine as follows:

There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims. To the extent that the absence of such differences in meaning and scope would make a claim superfluous, the Doctrine of Claim Differentiation states that presumption that the difference between the claims is significant. Where some claims are broad and others narrow, the narrow claim limitations cannot be read into the broad whether to avoid invalidity or to escape infringement.

United States v. Teletronics, Inc., 857 F.2d 778, 783-84 (Fed.Cir.1988) (citations omitted), *cert. denied*, 490 U.S. 1046, 109 S.Ct. 1954, 104 L.Ed.2d 423 (1989). Thus, limitations contained in those claims dependent on claim 1 in the '863 patent-claims 2 through 5-cannot be read into claim 1.

Applying these principles, the Court finds that Dalsin cannot establish literal infringement or infringement under the doctrine of equivalents because it has failed to create a dispute of material fact as to whether the Icebreaker and Universal infringe element (c) of claim 1. Although this single element is dispositive, the Court begins its analysis with the preamble and elements (a) and (b), because the meaning of some of the terms in these elements are necessary for interpreting element (c).

The Preamble

The preamble to claim 1 states as follows:

A chimney damper attachable to a chimney flue having an upwardly facing, generally planar peripheral surface defining an upwardly open flue opening, comprising....

RMR asks the Court to construe the terms "chimney damper," "chimney flue," and "flue opening." Dalsin argues that the preamble should not be viewed as a limitation because it merely states the intended purpose of the invention. *See Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed.Cir.1995). However, RMR points out that terms appearing in the preamble may be deemed limitations of the claim when they give meaning to the claim and properly define the invention. *See, e.g., In re Paulsen*, 30 F.3d 1475, 1479 (Fed.Cir.1994).

The Court finds that the preamble does limit the claim to some extent. First, the preamble makes clear, as RMR contends, that the chimney damper-the claimed product-must be separate from the chimney flue. In other words, the chimney flue is a structure separate from the damper. In addition, given its ordinary meaning, the chimney flue is part of the chimney structure. The peripheral surface defining the flue opening obviously is also part of the flue, not the damper. The chimney damper therefore is a separate product attachable to a chimney flue having an upwardly facing flue opening.FN2

FN2. As to the limitations set forth in the preamble, the Court finds that there are issues of material fact that would preclude summary judgment as to whether the Icebreaker and Universal literally infringe the patent or infringe under the doctrine of equivalents. Dalsin has provided evidence that both products are chimney dampers attachable to a chimney flue having an upwardly facing flue opening. The fact that the flue is a separate structure from the damper is relevant for interpreting later claims.

Element (a)

Element (a) of claim 1 reads "a frame mountable to the open periphery of a chimney flue and having a superior portion oriented to extend above said flue opening." RMR contends that the "frame" must be in the form of an inverted "V" because this is how the frame is disclosed in the illustrations in the specification. The Court disagrees. "Frame" plainly means some structure that gives support or shape to the invention. While the inverted "V" is one possible configuration for the frame, and perhaps the preferred configuration, it certainly is not the only possible shape of a frame. Again, the specification cannot be construed to add limitations to the claim. *See, e.g., Specialty Composites*, 845 F.2d at 987.

Likewise, the Court rejects RMR's contention that the "superior portion" of the frame refers only to the apex of the frame. Read in context, the ordinary meaning of "superior" portion is the upper portion of the structure. Thus, element (a) describes a frame (an inverted "V" or otherwise) that is mountable to the periphery of a chimney flue having a superior (or upper) portion that extends above the flue opening.FN3

FN3. Material fact disputes regarding both accused products would preclude summary judgment on the issue of infringement as to this element. There is a fact question whether both the Icebreaker and Universal have a frame: the Icebreaker's mesh cage and cape lid arguably comprise a frame, and the Universal's cage and support bar arguably serve a frame. Also, the superior portions of both products' frames extend above the flue opening when mounted on the flue. In addition, even if these products do not literally infringe element

(a), the evidence suggests that the differences between them and the claimed product are insubstantial.

Element (b)

Element (b) provides as follows:

(b) flue cover means comprising a thin, generally rectangular metal plate having a generally planar peripheral portion to seal against the upwardly facing surface of a flue opening....

As an initial matter, the parties dispute whether this is a means-plus-function element. Although it is worded differently than elements (c), (d), and (e), the Court finds that (b) plainly is a means-plus-function element. The means is the "flue cover," and the function is "to seal" against the upwardly facing surface of a flue opening.

The parties dispute the meaning of "flue cover means" and "the upwardly facing surface of a flue opening." Turning first to the flue cover means, Dalsin contends that the this term describes a thin generally rectangular metal plate, while RMR argues that the flue cover means must include, along with the plate, a stem, a stem plate, bolts or other pins, and compression springs. This presents a close issue. Dalsin's interpretation comports with the language of element (b).FN4 Also, the specification describes how this means performs the function of sealing against the surface of the flue opening: the cover plate seals the flue opening simply by engaging the upwardly facing surface of the flue, preventing air from entering or exiting the chamber.FN5

FN4. The Court rejects RMR's contention that the use of the word "comprising" establishes that the meaning of "flue cover means" is open-ended, and thus, that there must be other components of this structure. A structure may be "comprised" of only one component or many components.

FN5. How the plate is moved from above the flue surface onto that surface is described in element (e), describing the control means.

In addition, the Court agrees with Dalsin that the "described linkage"-comprising the stem and other components RMR believes are part of the flue cover means-may not be a necessary feature of the flue cover means. Much of the described linkage is claimed in dependent claims 2 and 3:

2. The chimney damper of claim 1 wherein the mounting means further comprises a generally rigid elongated stem moveable vertically in response to the spring means and the control means, respectively, a generally horizontal stem plate carried at the upper end of the stem for engagement with the bottom surface of the metal plate of the flue cover means, and spring attachment means resiliently biasing said plates toward each other but allowing resilient tilting of the flue cover plate with respect to the stem plate.

3. The apparatus of claim 2 wherein the spring attachment means comprises one or more compression springs located generally equiangularly of the stem, and a pin corresponding to each spring, each pin being carried by one plate, extending through an orifice in the other plate, and terminating in a spring seat, the corresponding spring extending from the spring seat to the nearer plate and urging the two plates together.

The doctrine of claim differentiation therefore counsels in favor of not finding these to be necessary components of the flue cover means, because such an interpretation would render meaningless claim 2 and probably claim 3.

RMR points out that such an interpretation would conflict with the specification's discussion of the interaction between the flue cover means and the "mounting means" described in element (c). The Court agrees with RMR that the specification's language raises doubts about Dalsin's interpretation. Nevertheless, for the limited purpose of deciding this non-infringement motion, the Court will assume that the "flue cover means" may comprise only the metal plate.

Turning to the function of sealing, element (b) provides that the seal shall be against the "upwardly facing surface of a flue opening." RMR argues that the flue cover means must seal against the surface of the flue rather than against part of the damper. The Court agrees because the preamble to claim 1 makes clear that the damper and the flue are two separate structures, and the surface of the flue opening obviously is part of the flue, not the damper. However, the specification expressly contemplates adding a gasket to the upwardly facing surface of the flue to enhance the seal. Thus, the seal described in element (b) must be between the flue cover and the flue, but the upwardly facing surface of the flue opening may be improved by the use of gasket or its equivalent.FN6

FN6. If the Court were to accept Dalsin's interpretation of "flue cover means," fact disputes would preclude summary judgment on the issue of whether the Universal literally infringes element (b). The Universal features a thin, generally rectangular "damper plate" which is used as a seal to prevent gases from escaping the flue. Also, whether the gasket against which the plate seals constitutes a component part of the Universal or of the flue remains an open question. While the gasket may be installed at the same time as the Universal, the Court could not find as a matter of law that it does not constitute an enhancement to the surface of the flue opening. Moreover, there exists a clear question of fact whether the Icebreaker infringes this element under the doctrine of equivalents.

The Icebreaker, to the contrary, does not literally infringe element (b), because although it has a metal "damper plate" which is used to prevent gases from escaping from the flue, this plate undisputedly does not seal against part of the flue. Rather, it seals against a fiberglass sill that is part of the damper's structure. RMR therefore would be entitled to summary judgment on the issue of the Icebreaker's literal infringement of claim 1. Nevertheless, there still would be a fact dispute whether the Icebreaker infringes this element under the doctrine of equivalents.

Element (c)

Element (c) requires "mounting means for mounting the flue cover means to the chimney flue." The parties agree that this is a means-plus-function element.

The portion of the specification that discusses the mounting means provides as follows:

Referring to FIGS 8 and 9, a preferred means of mounting (33) the stem to the chimney flue (16) is shown. The stem (33) is carried in a stem guide (34) which allows only vertical movement of the stem (33). In a preferred embodiment, the stem guide (34) includes upper and lower spaced shoulders, rigidly connected, having aligned, stem-receiving slots formed therein. The stem guide in turn, is rigidly carried by a pair of rods (30) and (31) which are secured to the flue (16) by means of mounting brackets (23). As can be seen in

FIG. 8, the mounting brackets (23) are generally "C-shaped," the distance between the opposing legs of the "C" being somewhat greater than the thickness of the flue wall (16). At least a pair of spaced mounting screws are threadingly received with the inner leg of the bracket (23) and secure the bracket against the flue wall (16). FN7

FN7. The specification goes on to discuss in greater detail the brackets, bolts, stem, and stem guide.

Dalsin agrees that the mounting structure disclosed in the specification calls for mounting screws, but contends that the rest of the apparatus is unnecessary. Indeed, relying again on the doctrine of claim differentiation, Dalsin points to dependent Claim 5, which claims some of the apparatus discussed in the specification. FN8 Dalsin then argues that, under the proper interpretation of means-plus-function clauses under s. 112, the patentee is entitled to a claim covering the specified structure-mounting screws-and its equivalents, which would include other types of screws, rivets, bolts, glue, or silicone.

FN8. Claim five provides as follows:

5. The chimney damper of claim 2 wherein the mounting means includes:

- (a) mounting brackets attachable to opposite sides of a chimney flue, each bracket having a cantilever portion positioned to lie at the interior of the flue, and rods extending between and joined to the cantilever portions of the opposing bracket; and
- (b) stem guide means carried by the rods for securing the stem against rotational and horizontal movement while allowing vertical movement thereof.

However, Dalsin's proposed interpretation is based on a flawed premise. Critical to Dalsin's analysis and its reliance on "equivalents" such as bolts, glue, or silicone, is its focus on mounting the damper to the flue. Indeed, throughout Dalsin's memorandum-including its discussions of McKendrick's deposition and its analysis of whether the accused products actually infringe this element-and in counsel's presentation at oral argument, it focused on equivalents for mounting the chimney damper or its frame to a chimney flue. But element (c) does not address mounting or attaching the *chimney damper* or the *frame* to the flue; rather, element (c) describes the function of mounting the *flue cover means* to the flue. While the chimney damper and frame certainly are attached or mounted to the chimney flue, as referenced in the preamble and claim (a), the limitation contained in claim (c) addresses an entirely different subject.

As the discussion of element (b) indicates, the "flue cover means" has one of two meanings. It either comprises just the metal cover plate, as Dalsin contends, or the metal plate plus the stem and related components, as RMR asserts. Either way, the mounting means must comprise more than screws, rivets, bolts, glue, or silicone. Such means cannot mount the flue cover means-which is movable-to the flue. Thus, while the exact components set forth in the specification are preferred but not necessarily required, the "equivalents" Dalsin offers clearly are inadequate to constitute the mounting means. The mounting means therefore comprises some set of components equivalent to the screws, springs, brackets, rods, and stem guide apparatus described in the specification which together serve the function of mounting the flue cover means to the inside of the chimney flue.

Turning to the issue of infringement, the Court finds that there is no dispute of material fact as to whether the Icebreaker or the Universal literally infringe element (c). In its memorandum, Dalsin claims the

Icebreaker includes "a mounting means comprising screws that attaches the chimney cap-damper to the flue" and the Universal includes "a mounting means comprising silicone glue that fastens the chimney cap-damper to the flue." For the reasons set forth above, these means, which merely attach the cap-damper to the flue, are not the same as the mounting means set forth in the patent and do not serve the same function.

In addition, although Dalsin now appears to have abandoned this portion of its supplemental answer to defendant's first interrogatory, the components of the Icebreaker and Universal referenced in that answer likewise do not literally infringe element (c). Specifically, the Icebreaker's flange, the center locator, and the s.s. cable, are not means for mounting the alleged flue cover means (the damper plate) to the inside of the flue. Similarly, the Universal's cross-bar, upper portion of the s.s. cable, and chimney cap anchor do not mount the damper plate to the flue.

Finally, the Ice Breaker and Universal do not infringe element (c) under the doctrine of equivalents. The screws and silicon that attach these cap-damper products to the flue obviously are substantially different and serve an entirely different function than the mounting means in the patent. Moreover, while the components highlighted in the interrogatory answer may serve some of the same general purposes as the mounting means in element (c), such as reducing unwanted shifting of the damper plate (flue cover), these features cannot be considered equivalent. These components do not stabilize the damper plate by mounting it to the flue.FN9 Dalsin has offered no evidence from which a finder of fact could reasonably conclude that the Icebreaker and Universal have components that serve substantially the same function as the mounting means in the patent, perform the function in substantially the same way as the mounting means, or will achieve substantially the same results as the mounting means.

FN9. The damper plates in these two products are not mounted to the flue at all, and, with the exception of their spring mechanisms, they do not appear to be otherwise "mounted" even to the cap-damper frame. Although Dalsin does not argue as much, it appears that some stabilization may result from the fact that these products' cords are constrained by their insertion through a hold in the center of the cross bar.

In conclusion, the Icebreaker and Universal are similar to the chimney damper in the patent and obviously serve the same general purpose. Indeed, RMR's products contain some features that are virtually identical to the elements of the patented product. This is not surprising given McKendrick's extensive experience with Dalsin's products. However, such similarities are insufficient to constitute infringement of claim 1 of the patent because no component of these products infringes upon element (c), either literally or by equivalents. For this reason, RMR is entitled to summary judgment, and the Court need not reach RMR's other arguments or motions.FN10

FN10. It is worth noting that if Dalsin's claims were to go forward, it would be barred from receiving damages for alleged infringement prior to January 28, 1998 because it did not mark its damper products-the CHIM-A-LATOR and CHIM-A-LATOR DELUX-with the patent number and did not give RMR actual notice of the alleged infringement until that date. As set forth in 35 U.S.C. s. 287(a), to recover for patent infringement, a patentee must either mark its products as patented or demonstrate that the infringer "was notified of the infringement and continued to infringe thereafter." As to the second prong, RMR arguably had actual notice of the '863 patent and its likely infringement at least as early as February 1, 1991. However, in interpreting the second prong of s. 287(a), courts in the Federal Circuit and District of Minnesota recently have held that the alleged infringer's knowledge of the patent is not enough to constitute notice; the patentee must *affirmatively* act to notify the accused infringer. *See, e.g., Amsted Indus., Inc. v. C.*

Buckeye Steel Casting Co., 24 F.3d 178, 187 (Fed.Cir.1994) ("Actual notice requires the affirmative communication of a specific charge of infringement by a specific accused product or device"); American Med. Says. Inc. v. Buhl, 6 F.3d 1523, 1537 (Fed.Cir.1993), *cert. denied*, 511 U.S. 1070, 114 S.Ct. 1647, 128 L.Ed.2d 366 (1994); Maxwell v. K-Mart Corp., 880 F.Supp. 1323, 1337 (D.Minn.1995) ("Notice must be an affirmative act on the part of the patentee which informs the infringer of its infringement of the patent."). Thus, had Dalsin established infringement, its damages would have been limited to those occurring on or after January 28, 1998.

ORDER

Based on the foregoing, and all of the files, records, and proceedings herein, IT IS HEREBY ORDERED:

1. Defendant's motion for summary judgment on the issue of non-infringement [Docket No. 18] is GRANTED.
2. Defendant's motion for partial summary judgment on the issue of limitation of potential damages [Docket No. 27] and motion for summary judgment on the issue of invalidity [Docket No. 37] are DENIED AS MOOT.
3. Plaintiff's claims are DISMISSED WITH PREJUDICE.

LET JUDGMENT BE ENTERED ACCORDINGLY.

D.Minn.,1999.
Bernard Dalsin Mfg. v. RMR Products, Inc.

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