

United States District Court,
D. Oregon.

TOM HAYDEN ENTERPRISES, INC,
Plaintiff.

v.

SOUTHERN OREGON HOT BIKES, INC,
Defendant.

No. Civ. 03-3034-CO

April 29, 2004.

Thomas F. Armosino, Frohnmayer Deatherage Pratt Jamieson, Clark & Moore, P.C., Medford, OR, Timothy B. McCormack, Delbert J. Barnard, Barnard, Loop & McCormack LLP, Seattle, WA, Thomas E. Loop, Barnard, Loop & McCormack LLP, Renton, WA, for Plaintiff.

Jay A. Zollinger, Perkins Coie LLP, Portland, OR, Norbert Stahl, Paul Andre, Perkins Coie, LLP, Menlo Park, CA, for Defendant.

FINDINGS AND RECOMMENDATION

COONEY, Magistrate J.

Plaintiff brings this action alleging that defendant is infringing its patent, United States Patent No. 5,049,114 (the "114" patent), entitled, "self-adjusting chain guide tensioner." Defendant counterclaims for a declaratory judgment of invalidity, non-infringement, violation of s. 43(a) of the Lanham Act, unlawful trade practices under ORS s. 646.608(h), intentional interference with economic relations, and negligent interference with economic relations.

The court conducted a *Markman* FN1 hearing on the issue of claim construction of the patent in issue on February 27, 2004. After consideration of the filings, materials, and argument, the court recommends the following construction of the disputed patent claim language.

FN1. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

LEGAL STANDARDS

The analysis of a patent infringement action involves two steps: 1) the proper construction of the asserted claim; and 2) a determination of whether the accused method or product infringes the claims as properly construed. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). "[T]he construction of a patent, including terms of art within its claim, is exclusively within the

province of the court." *Id.* at 372, 375-91.

The court should construe only those terms of a claim which are in dispute. *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed.Cir.1999). Patent claims are construed without reference to the accused device. *NeoMagic Corp. v. Trident Microsystems, Inc.*, 287 F.3d 1062, 1074 (Fed.Cir.2002) ("It is well settled that claims may not be construed by reference to the accused device."); *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1118 (Fed.Cir.1985) (en banc). Claims should be interpreted, when reasonably possible, to preserve their validity. *Modine Mfg. Co. v. United States Int'l Trade Comm'n*, 75 F.3d 1545, 1556 (Fed.Cir.1996). A claim term should generally be read so as not to exclude the inventor's device or the inventor's preferred embodiment. *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1581 (Fed.Cir.1996); *Modine Mfg.*, 75 F.3d at 1550.

"In interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history." *Vitronics Corp.*, 90 F.3d at 1582; *Bell & Howell Document Mgmt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 705 (Fed.Cir.1997).

The court should first examine the words of the claims themselves in order to define the scope of the patented invention. *Vitronics Corp.*, 90 F.3d at 1582; *Dow Chem. Co. v. Sumitomo Chem. Co.*, 257 F.3d 1364, 1372 (Fed.Cir.2001); *K-2 Corp. v. Salomon S.A.*, 191 F.3d 1356, 1363 (Fed.Cir.1999). The claim language specifies "the subject matter which the applicant regards as his invention." *Markman*, 517 U.S. at 373 (quoting 35 U.S.C. s. 112).

Claim language is given its "ordinary and accustomed meaning as understood by one of ordinary skill in the art." *Dow Chem.*, 257 F.3d at 1372. Courts cannot rewrite claims, but must "give effect to the terms chosen by the patentee." *K-2 Corp.*, 191 F.3d at 1364. Terms in a claim are given their ordinary meaning to one skilled in the art unless it appears from the patent and prosecution history that the inventor used them differently. A patentee may be his own lexicographer, but any special definition given to a word must be clearly defined in the specification or file history. *Vitronics Corp.*, 90 F.3d at 1582.

After an examination of the claims themselves, the court should review the patent specification "to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." *Id.* at 1582. The specification is highly relevant in construing patent claims. The specification is "the single best guide to the meaning of a disputed term." *Id.* However, "[t]hat claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims." *SRI Int'l*, 775 F.2d at 1121 (internal quotations omitted); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed.Cir.1995) (en banc), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996) ("The written description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims."). It is improper to import, or "read in" to a claim, a limitation from the specification's general discussion, embodiments, and examples. *Intel Corp. v. United States Int'l Trade Comm'n*, 946 F.2d 821, 836 (Fed.Cir.1991); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed.Cir.1988).

It is also improper to eliminate, ignore, or "read out" a claim limitation from a claim in order to extend a patent to subject matter disclosed, but not claimed. *Ethicon Endo-Surgery, Inc. v. United States Surgical Corp.*, 93 F.3d 1572, 1582-83 (Fed.Cir.1996); *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1562 (Fed.Cir.1991).

Further, claims are not limited to the preferred embodiment. *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1158 (Fed.Cir.1997); *Amhil Enters., Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1559 (Fed.Cir.1996).

The third type of intrinsic evidence that the court may consider is the prosecution history of the patent. The prosecution history includes the complete records of the proceedings before the Patent and Trademark Office ("PTO"), including any re-examination proceedings, and any representations made by the applicant about the scope of the claims. *Vitronics Corp.*, 90 F.3d at 1582-83.

Finally, when the intrinsic evidence is unambiguous, it is improper for the court to rely on extrinsic evidence to contradict the meaning of the claims. *Pitney Bowes, Inc., v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308-09 (Fed.Cir.1999). This limitation is required so that competitors may rely on the public records to determine the scope of the patentee's claimed invention. *Vitronics Corp.*, 90 F.3d at 1582-83. If, after considering the intrinsic evidence, a claim term is ambiguous, a court may look to extrinsic evidence to assist in determining the meaning or scope of terms in a claim. *Id.* at 1584. "Extrinsic evidence is that evidence which is external to the patent and file history, such as testimony, inventory testimony, dictionaries, and technical treatises and articles." *Id.* While dictionaries are also considered "extrinsic," they "hold a 'special place' and may sometimes be considered along with the intrinsic evidence when determining the ordinary meaning of claim terms." *Dow Chem. Co.*, 257 F.3d at 1372. Extrinsic evidence cannot, however, alter the clear meaning of a claim arising from the patent or prosecution history. *Vitronics Corp.*, 90 F.3d at 1584.

DISCUSSION

Defendant's oral motion to strike

As an initial matter, the court will consider defendant's oral motion to strike "Plaintiff's Memorandum of New Authority," made by defendant at the claim construction hearing. This memorandum was filed by plaintiff on February 26, 2004, offering additional argument on a disputed claim without leave of court. Defendant's oral motion to strike is granted.

Claim construction

The abstract of the '114 patent states:

A self-adjusting chain tensioning device comprising a spring loaded rubbing block in continuous contact with said chain. Shims are used to preload or pre-compress said spring or springs. The rubbing block and shims are horizontally fixed but vertically slideable [sic] within an inner slide plate and an outer slide plate. Means to fixably position the inner slide plate and outer slide plate are provided.

(Patent at 1.) Plaintiff asserts claims 1 and 2 of four claims which are set forth below, with the language in controversy highlighted:

1. A chain tensioning device comprising:

a) *means for containing within one axis a rubbing block in contact with a movable chain* where said means comprise;

i) *a slotted plate* fixably attached to a case;

ii) a carriage bolt with a carriage bolt head *vertically movable* within a slot of said slotted plate;

iii) an inner slide plate, top block and outer slide plate fixably attached to said carriage bolt *by a nut*; and

b) *means for movably positioning on another axis said rubbing block in contact with said movable chain.*

2. The chain tensioning device of claim 1 where said rubbing block comprises *prongs adjacent to said inner slide plate and rubbing block outer slide plate indentation through which said outer slide plate fits.*

In construing the disputed language of the claims, the parties' references to defendant's device in their briefs and at the hearing will not be considered by the court. *See* NeoMagic Corp., 287 F.3d at 1074.

Claim 1(a)(I)- "a slotted plate"

Plaintiff proposes that claim 1(a)(I) means, "a plate attached to a case that includes a slot." (Pl. Mem. Claim Chart at 7.) Defendant proposes the following: "A flat piece of metal with a slot that is stably fastened to a container." (Def. Brief Addendum B.) The court agrees with defendant that plaintiff's interpretation indicates that the slot is in the "case" rather than in the "plate" as stated in the claim. The court recommends the following construction of claim 1(a)(I): "a plate with a slot that is stably attached to a case."

Claim 1(a)(ii)- "vertically movable"

Plaintiff does not include this phrase in its interpretation of claim 1(a)(ii), proposing that this subsection means, "a carriage bolt head fits in the slot in the slotted plate." (Pl. Mem. Claim Chart at 7.) Defendant argues that plaintiff attempts to eliminate the element of "vertically movable" from its claim. Defendant proposes that this subsection should be interpreted as, "A carriage bolt with a head that is free to move vertically in the slot of the flat piece of metal." (Def. Brief Addendum B.)

Defendant contends that the phrase "vertically movable" means that the carriage bolt is "free to move vertically." Defendant contends that reference to such vertical movement is made in the specification, citing column 2, lines 10-12 and 30-31. Defendant also refers to the prosecution history as supportive of its contention, (Stahl Decl. Ex. A at 2, 3; B at 4). Plaintiff replies that the patent shows a head on a carriage bolt and a slot in which the head is received. It asserts that "The carriage bolt head 12 slides in the slot during installation and the bolt is then tightened to lock the unit in place," citing column 2, lines 10-13. (Pl. Reply at 3.) In its conclusion, plaintiff states that claim 1 "specifies that the carriage bolt head is vertically movable within a slot of the slotted plate," and defendant rewrites the phrase to require that "the carriage bolt head 'is free to move vertically in the slot.'" (Pl. Reply at 6.) Plaintiff contends that it cannot be said that the carriage bolt is free to move vertically "at all times," but fits into a slot and is movable along the slot until it is positioned where it can be tightened for the purpose of locking the unit in place. In a heading of defendant's reply, defendant states: "the chain tensioner under the patent *must* be vertically movable," and in the body of its reply, defendant contends that, "the bolt holding the chain tensioner can move up and down as is taught in the patent." (Def. Reply at 2.)

At the claim construction hearing, defendant additionally argued that the word "movable" is used three times in claim 1 and the term "movable" in the phrase "vertically movable" should be consistent with its uses describing the chain and the rubbing block as movable; and that the claim distinguishes between "movable"

and "attached," and to adopt plaintiff's revised construction would render the word "attached" meaningless. Defendant further argued that the meaning given must be given to the tensioner unit as completed. Defendant argued that the court must construe the claim to give meaning to the language, "vertically movable," included in the claim. Plaintiff argued at the hearing that the bolt moves in the slot for the same reason it did in the prior art—to allow the initial positioning of the unit, then it is tightened in place by the nut. Plaintiff argued that there is nothing in the patent disclosing that the bolt is vertically movable within the slot during operation of the device, or any reason for a vertical movement.

The court agrees with defendant that meaning has to be given to the phrase, "vertically movable," included in claim 1(a)(ii) and cannot be omitted. The court begins with the claim language, both of asserted claims and of nonasserted claims. *Vitronics Corp.*, 90 F.3d at 1582 ("First, we look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention.") The claim language of claim 1(a)(ii), which is at issue, states that it is the carriage bolt head that is vertically movable. Claim 1(a)(ii) states that a carriage bolt with a carriage bolt head is vertically movable within the slot of "said slotted plate," referring back to the slotted plate stated in (a)(I). Claim 1(a) goes on to state that an inner slide plate, top block, and outer slide plate are "fixably attached" to "said carriage bolt," referring back to the carriage bolt stated in (a)(ii), by a nut. This language and the language of claim 1 as a whole suggests that the tensioning unit as a whole does not move.

In support of their respective positions, both parties cite the language in the specification referring to the prior art, column 2, lines 10-12, where it is stated in pertinent part and in context: "Slotted plate 9 is attached to the case 1 by means of slotted plate fasteners 11. *A carriage bolt 10 with a carriage bolt head 12 slides up and down within the slot 13 of the slotted plate 9.* The carriage bolt 10 is meant to lock unit in place." (Specification column 2, lines 8-13 (portion cited by parties emphasized).) The parties agree that in the prior art, the tensioning unit was fixed in place and did not move vertically. The second reference, column 2, lines 30-31, cited by defendant in support of its construction of the phrase, refers to plaintiff's new chain tensioner, and states: "*Carriage bolt 10 with carriage bolt head 12 within the slot 13 of the slotted plate 9 fits through the inner slide plate hole 26, the top block hole 14, and the outer slide plate hole 25 where it is held by a washer 19 and nut 20.*" (Specification column 2, lines 30-34 (portion cited by defendant emphasized).) In context, the portion of the sentence cited by defendant does not reference movement of any kind, but describes the assembly of the portion of the unit attached to the carriage bolt.

Defendant provides the dictionary meaning of "vertical" as, "[b]eing or situated at right angles to the horizon; upright," and of "movable" as, "[p]ossible to move." (Am. Heritage Talking Dictionary (1997 ed.).) Plaintiff does not comment on these definitions.

Defendant also relies on the prosecution history, which shows that plaintiff apparently agreed with an objection of the PTO examiner, stating in its patent "Amendment" that, in the drawings, "The slotted plate 9 and slot 13 have been changed in Figure 2, 4, 5 and 6 to more clearly show the slotted plate 9," and "These changes show the carriage bolt to be vertically moveable." (Stahl Decl. Ex. A at 2, 3; B at 4.) There is nothing in the prosecution history to support defendant's argument made at the hearing that the PTO "made [plaintiff] put that language in to make it compatible so you have a unit that is movable and not fixed like the prior art." (Feb. 27, 2004, Tr. at 27.)

At the hearing, the court was informed that plaintiff adopted the slotted plate of the prior art, and that the slotted plate comes with the cycle and that the slotted plate and the bolt are utilized in its new tensioner.

Reading the entirety of the claims and the specification does not indicate that plaintiff's chain tensioning unit itself moves up and down. The reference to the prior art indicates that the tensioning unit was locked in place by means of a carriage bolt, and one skilled in the art would understand that the tensioning unit did not move. There is nothing in the summary of invention, description of the preferred embodiment, or the claims read as a whole which indicates that the new tensioning unit moves vertically up and down. The background of the invention notes, "The prior art does not disclose an effective simple mechanism for control of vibration, particularly in motorcycle chains." (Specification, column 1, lines 28-30.) The summary of invention states:

A rubbing block is provided with indentations such that the rubbing block is free to along [sic] the vertical axis but not the horizontal axis. Springs are provided between the base of the rubbing block and shims. The number of shims is adjusted to provide a pre-load compressive force to the springs.

It is an object of this invention to provide an efficient simple chain tensioner.

It is another object to provide an efficient, simple chain tensioner.

It is a final object to provide a chain tensioner which damps the natural vibration in a motorcycle primary chain.

(Specification, column 1, lines 33-45.) The claims and description of the new unit disclose that the inner and outer slide plates, which are attached to the carriage bolt, rest on the bottom of the case. The claims and description disclose that these slide plates contain the rubbing block in contact with the chain which is movable during operation of the cycle. At least one shim-which is not disclosed to be fixably attached or secured to the slide plates-fits between these slide plates, and rests on the bottom of the case. (See Specification, column 2, lines 19-27, 43-48; column 3, lines 4-5; column 4, lines 4-9.) If the claim language was construed as defendant argues-to mean that the tensioning unit moves up and down during operation of the cycle, the unit would be inoperable because it would come apart as the slide plates, attached to the carriage bolt, moved upward. The court cannot give claim language a meaning which would render the invention inoperable. To accept defendant's interpretation and meaning of the phrase "vertically movable" as used in claim 1 would render the new tensioning unit inoperable.

It is clear from the summary of invention, the description of the tensioning unit of prior art, the drawings, and the comments of counsel at the hearing, that the unit of prior art was fixed in place FN2 and, due to vibration over time, the unit would have to be manually adjusted by means of moving the carriage bolt holding the rubbing block up or down in the slot of the slotted plate to contact the chain.FN3 Figures 1 and 2, disclosing the prior art, shows the carriage bolt (with the fixed rubbing block removed) resting toward the bottom of the slot in the slotted plate. And while not determinative, the drawings disclosing the preferred embodiment of the new tensioning unit, Figures 3, 4 and 5, show the carriage bolt holding the sliding plates and the rubbing block at the top of the slot in the slotted plate. With the carriage bolt near at the top of the slot in the slotted plate, and the sliding plates attached to the carriage bolt and resting on the bottom of the case, it does not appear from the disclosures that plaintiff's tensioning unit moves up and down as defendant asserts.

FN2. The description refers to a "fixed rubbing block," and states that, "The carriage bolt 10 is meant to lock unit in place." (Specification column 1, line 66; column 2, lines 10-11.)

FN3. The description of prior art states, "A carriage bolt 10 with a carriage bolt head 12 slides up and down within the slot 13 of the slotted plate 9." (Specification column 2, lines 10-12.)

Here, plaintiff adopted the slotted plate and carriage bolt of prior art, in which "A carriage bolt 10 with a carriage bolt head 12 slides up and down within the slot 13 of the slotted plate 9," (Specification column 2, lines 10-12), and "The carriage bolt 10 is meant to lock unit in place," (Specification column 2, lines 12-13.) Plaintiff's construction of the phrase "vertically movable"-that the carriage bolt head moves up and down in the slot during installation to allow initial positioning of the unit-in claim 1(a)(ii), which states in full: "a carriage bolt with a carriage bolt head vertically movable within a slot of said slotted plate," is consistent with the understanding of one skilled in the art and consistent with the disclosures of the patent specification. Plaintiff's construction is not inconsistent with the dictionary meaning of the words.

Accordingly, the court construes the phrase "vertically movable" in claim 1(a)(ii) as, "which can be moved up and down to position the unit prior to operation," so that claim 1(a)(ii) should be construed to read in its entirety: "A carriage bolt with a head which can be moved up and down to position the unit prior to operation within the slot of the slotted plate."

Claim 1(a)(iii)- "by a nut"

Plaintiff proposes that claim 1(a)(iii) be construed to mean: "the carriage bolt is connected to the assembly that includes the inner and outer slide plates and the top block." (Pl. Mem. Claim Chart at 7.) Defendant proposes: "An inner flat piece of metal with pins to join it to a solid piece at the top, an outer flat piece of metal, stably fastened to the bar by a nut." (Def. Brief Addendum B .)

The court agrees with defendant that construction of this portion of the claim should include the attachment by a "nut." Plaintiff does not address this language. The court recommends that claim 1(a)(iii) be construed to mean: "the inner slide plate, top block, and outer slide plate are held in place on the carriage bolt by a nut."

Claim 1(a)- "means for containing within one axis a rubbing block in contact with a movable chain"

Defendant contends that, although some structure is included in claim 1(a), it is a means-plus-function element. Defendant contends that the structure claimed in claim 1(a) is not sufficient to carry out the function of "containing within one axis a rubbing block in contact with a movable chain." Defendant contends that "pins" are required in claim 1(a)(iii) because, without "pins," the function of "containing within one axis" is not fulfilled.FN4 It asserts that without the pins for stability as stated in the specification, the tensioner would swing like a pendulum from the carriage bolt, the single contact point, and the function would be unaccomplished. Plaintiff contends that, although the term "means" is used in the claim, this is not means-plus-function because subsections (i), (ii), and (iii) of the claim sets forth specific structure which contains the rubbing block in one axis in contact with the chain. At the claim construction hearing, plaintiff noted that the reference to pins and stability in the specification is not tied to anything, and pointed out that the use of a standard carriage bolt, which has a square section under the head that fits into the slot, would keep the carriage bolt from moving back and forth.

FN4. Defendant proposes that claim 1(a)(iii) be construed as, "An inner flat piece of metal with pins to join it to a solid piece at the top, an outer flat piece of metal, stably fastened to the bar by a nut." (Def. Brief,

In claim construction,

Under 35 U.S.C. s. 112, para. 6, a claim may express a means for performing a function without specifying the structure or material of the means, called a "means-plus-function" ("MPF") claim.FN5 In *Warner-Jenkinson Co. v. Hilton Davis Chemical*, 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146[] (1997), the Court explained that under s. 112, para. 6 "an applicant can describe an element of his invention by the result accomplished or the function served, rather than describing the item or element to be used (e.g., 'a means of connecting Part A to Part B,' rather than 'a two-penny nail')." 520 U.S. at 27[].

FN5. 35 U.S.C. s. 112, para. 6, provides:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

QSIndustries, Inc. v. Mike's Train House, Inc., 230 F.Supp.2d 1240, 1244 (D.Or.2002) (footnote in original). The court must satisfy itself as an initial matter that the claim limitation is in MPF form. *Id.* (citing *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1361 (Fed.Cir.2000)). Whether the language of a claim is to be interpreted according to s. 112, para. 6 is a matter of claim construction and, thus, is a question of law. *Kemco Sales, Inc. v. Control Papers Co.*, 208 F.3d 1352, 1360 (Fed.Cir.2000). Use of the term "means" creates a presumption that the element is to be construed in accordance with s. 112, para. 6. *Id.* at 1361. The presumption may be rebutted, however, when the claim element recites sufficiently definite structure or material to perform the claimed function. *Id.*

Absence of the term "means" creates a presumption that the element is not to be construed in accordance with s. 112, para. 6. *Watts v. XL Sys., Inc.*, 232 F.3d 877, 880 (Fed.Cir.2000). However, this presumption may be rebutted when the claim element does not recite sufficiently definite structure or material to perform the claimed function. *Id.* at 880-81.

After the court determines that an MPF limitation is stated, the court construes the MPF claim in two parts: (1) determination of the function claimed in the particular element; and (2) determination of what structure or material disclosed in the specification performs the function claimed in that element. *QSIndustries*, 230 F.Supp.2d at 1244; *Kemco Sales.*, 208 F.3d at 1360; *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1430 (Fed.Cir.2000). The Federal Circuit has stated: "[T]he 'means' term in a means-plus-function limitation is essentially a generic reference for the corresponding structure disclosed in the specification. Accordingly, a determination of corresponding structure is a determination of the meaning of the 'means' term in the claim and is thus also a matter of claim construction." *Chiuminatta Concrete Concepts. Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1308 (Fed.Cir.1998). "For a structure to be deemed a 'corresponding structure,' the structure must perform the claimed function and the specification 'must clearly associate the structure with performance of the function.'" *QSIndustries*, 230 F.Supp.2d at 1245 (quoting *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 113 (Fed.Cir.2002)). "[S]tructure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or

associates that structure to the function recited in the claim." B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1424, (Fed.Cir.1997); *see also* Budde v. Harley-Davidson, Inc., 250 F.3d 1369, 1377 (Fed.Cir.2001).

From a review of the patent, the court agrees with plaintiff that claim 1(a) is not an MPF limitation. The court finds that subsections (i)-(iii) as claimed, are sufficient structure to fulfill the function of "containing within one axis a rubbing block in contact with a movable chain." The reference in the description to a "pin" "to provide stability," (Specification, column 2, lines 17-19), does not clearly link to the function of "containing in one axis the rubbing block"; it is unclear from the description and drawings whether the pin that extends out beyond the back side of the inner slide plate extends into the slot of the slotted plate as asserted by defendant.FN6 As claimed, a standard carriage bolt, which has a square portion under the head, fits into the slot of the slotted plate. This, along with the fact that the assembled slide plates, which rest on the bottom of the case, and top block are fixably attached to the carriage bolt by a nut, would prevent any swinging motion of the unit.

FN6. The only reference to pins is in the description at column 2, lines 15-19:

Referring first to Fig. 6, an inner slide plate 14 is joined to top block 16 by pins 29. One of the pins is flush with the back side of the inner slide plate 14. The other pin 29 extends out beyond the back side of inner slide plate 14 to provide stability.

It appears from this description that the pins provide stability to the top block.

Accordingly, the court rejects defendant's proposed construction of claim 1(a)(iii) to include any reference to pins. Claim 1(a)(iii) should be construed as determined above, without reference to pins.

Claim 1(b)- "means for movably positioning on another axis said rubbing block in contact with said movable chain"

Both parties agree that claim (1)(b) is an MPF element. The court agrees. The dispute centers around plaintiff's interpretation of the element to include "at least one spring," whereas defendant construes this element as comprising "springs," i.e., two springs. Defendant also construes the element to include shims. Plaintiff proposes the following construction: "at least one spring urges the rubbing block into contact with the chain." (Pl. Mem. at 7 Claim Chart.) Defendant proposes that the function is "movably positioning on another axis the rubbing block in contact with the movable chain," and the means to implement that function comprise "springs and shims." (Def. Brief Addendum B.)

Defendant contends that the specification in all instances refers only to plural "springs": in the summary of invention and in the description.FN7 Plaintiff relies on the abstract which refers to "spring or springs," and claim 3 which includes "at least one spring." (Specification, column 3, lines 1-6.) Defendant asserts that the abstract cannot be used to construe patent claims, relying on 37 C.F.R. s. 1.72(b), and that claim 3 cannot be used to broaden the scope of claim 1(b) because plaintiff does not assert claim 3 as infringed. FN8

FN7. Defendant also asserts that the PTO rejected a claim with a single spring as unsupported, relying on the rejection of claim 8, which was canceled by plaintiff. Defendant asserts that the claim was rejected because "The embodiment claimed in claim 8 is not shown in the drawings. Correction is required." (Def. Brief at 5, citing Stahl Decl. Ex. A at 3.) Claim 8 stated: "The chain tensioning device of claim 1 where said means for movably positioning on another axis said rubbing block comprises: 1) at least one spring between a shim resting on the top block and a rubbing block." Stahl Decl. Ex. C at 9-10.) In addition to the

statement of rejection cited, the examiner also stated that claim 8 was rejected under 35 U.S.C. s. 112, para. 1 & 2, because the claimed invention was not described so as to enable a person skilled in the art to make and use the invention; and that claim 8 was rejected under 35 U.S.C. s. 102(b) because it was anticipated by Biederman. The examiner also stated that, "In claim 8, the base of the guide housing [118], Fig. 3 is considered to be functionally equivalent to the shim holding the at least one spring." (Stahl Decl. Ex. A at 4.) Nothing in these statements indicates that claim 8 was rejected because it had only one spring. Also, claim 6 referred to "at least one spring." Claim 6 was rejected, as was claim 8, because the claimed invention was not described so as to enable a person skilled in the art to make and use the invention; it was also rejected because it was dependent upon a rejected base claim, but "would be allowable" if rewritten. (Stahl Decl. Ex. A at 3-4.) A review of the language of claim 8 supports plaintiff's contention that the claim was rejected because it claimed the upside down embodiment, which was not illustrated. Accordingly, this ground for rejecting a construction of "at least one spring" is not supported in the record.

FN8. In its first brief, plaintiff states it is presently asserting that defendant's device infringes Claims 1 and 2, and reserves the right to change this assertion to add Claims 3 and 4. (Pl. Brief at 2.)

The function claimed in claim 1(b) is clearly the function as stated by defendant: that of "movably positioning on another axis the rubbing block in contact with the movable chain."

The Federal Circuit has found that the abstract may be considered in determining the scope of the invention. In *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341, n. * (Fed.Cir.2000), the court stated:

Citing 37 C.F.R. s. 1.72(b), which provides that the abstract of the patent "shall not be used for interpreting the scope of the claims," *Hill-Rom* argues that it would be improper for us to consider the abstract in determining whether the district court correctly construed the claims of the '346 patent. Section 1.72(b), however, is a rule of the Patent and Trademark Office that governs the conduct of patent examiners in examining the patent applications; it does not address the process by which courts construe claims in infringement actions. We have frequently looked to the abstract to determine the scope of the invention, *see, e.g., United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1560[] (Fed.Cir.1997); *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 96 F.3d 1409, 1412[] (Fed.Cir.1996); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1269[] (Fed.Cir.1986), and we are aware of no legal principle that would require us to disregard that potentially helpful source of intrinsic evidence as to the meaning of claims.

Here, the abstract refers to "said spring or springs." The patent specification includes the claims. 35 U.S.C. s. 112, para. 1, 2; *FN9 Network, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed.Cir.2001) ("The claims are always construed in light of the specification, of which they are a part."); *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1553 (Fed.Cir.1997) ("The specification, of which the claims are part,"), *overruled on another ground by Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448 (Fed.Cir.1998)); *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 621 (Fed.Cir.1995) ("A claim must be read in view of the specification of which it is a part."); *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed.Cir.1998); *Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed.Cir.1987); *see In re Fuetterer*, 50 C.C.P.A. 1453, 319 F.2d 259, 262 n. 7 (Fed.Cir.1963); *Credle v. Bond*, 25 F.3d 1566, 1576 (Fed.Cir.1994); *Personalized Media Communications, LLC v. Int'l Trade Comm'n*, 161 F.3d 696, 705 (Fed.Cir.1998); *see also Enzo Biochemical, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 972 (Fed.Cir.2002). Thus, the court may consider plaintiff's claims in determining the structure

disclosed which performs the function claimed. There is no prohibition in considering all claims, whether asserted or nonasserted. Vitronics Corp., 90 F.3d at 1582.

FN9. Paragraphs 1 and 2 of 35 U.S.C. s. 112 provide in pertinent part:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, ..., and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Here, claim 3, addressing "The chain tensioning device of claim 1 where said *means for movably positioning on another axis said rubbing block* comprises: ...," (Specification, column 3, lines 1-3) (emphasis added), provides the structure to perform the function of "movably positioning on another axis the rubbing block in contact with the movable chain." Claim 3(C) states that "at least one spring" between a shim and a rubbing block, in addition to elements detailed in subsections (d) through (g), comprise the means to perform the function. FN10 It is true, as defendant asserts, that the patent description refers only to "springs." However, this description is a "detailed description of the preferred embodiment" set forth in the drawings. The drawings disclose a chain tensioner with two springs. However, plaintiff clearly reserved for itself in claim 3 a chain tensioner that utilized one spring to perform the function of movably positioning on another axis the rubbing block in contact with the movable chain.

FN10. Claim 3 states:

3. The chain tensioning device of claim 1 where said means for movably positioning on another axis said rubbing block comprises:

- c) at least one spring between a shim resting on the bottom of a case and a rubbing block;
- d) an inner slide plate and an outer slide plate attached to said case by means of said carriage bolt and said slotted plate where a rubbing block slideably [sic] fits between said outer slide plate;
- e) prongs from said rubbing block adjacent to said inner slide plate
- f) a rubbing block outer slide plate indentation within said rubbing block which allows said rubbing block to slide up and down on said outer slide plate; and
- g) a shim, resting on the bottom of said case, where said inner slide plate also resting on the bottom of said case is within a shim inner slide plate indentation and where said outer slide plate also resting on the bottom of said case is within a shim outer slide plate indentation.

(Specification, column 3, line 1 through column, line 12.)

The court adopts plaintiff's construction of claim 1(b) to the extent that the means includes "at least one spring" to perform the claimed function.

The court agrees with defendant that shims must be included in the means for performing the claimed function. Claim 3 (and the description) include a shim or shims as part of the means for performing the function of movably positioning on another axis the rubbing block in contact with the movable chain.

Accordingly, the court recommends that claim 1(b) be construed as an MPF element, and that the means to perform the claimed function of "movably positioning on another axis said rubbing block in contact with said movable chain," comprise "at least one spring" and shim or shims.

Claim 2- "prongs adjacent to said inner slide plate and rubbing block outer slide plate indentation

through which said outer slide plate fits"

Defendant contends that plaintiff rewrites claim 2 in its proposed construction. Plaintiff does not address this contention. Plaintiff proposes that the cited portion of claim 2 be construed as: "the inner slide plate fits between two projections from the rubbing block and the outer slide plates sits in an indentation in the slide block." (Pl. Mem. at 7 Claim Chart.) Defendant proposes that the cited language be construed to mean: "Projecting parts next to the inner flat piece of metal and next to a recess in the rubbing block through which the outer flat piece of metal fits." (Def. Brief Addendum B.)

The court agrees that the focus of claim 2 is the rubbing block, and that plaintiff's construction seems to focus on the fitting of the slide plates. The court recommends the following construction of the disputed language of claim 2: "on one side two projections into which the inner slide plate fits and on the opposite side an indentation into which the outer slide plate fits."

RECOMMENDATION

Based on the foregoing, it is recommended that the disputed claim language be construed as follows:

Claim 1(a)(I) should be construed to mean that the slot is in the plate, rather than in the case, so that claim 1(a)(I) means: "a plate with a slot that is stably attached to a case";

Claim 1(a)(ii) should be construed so that the phrase, "vertically movable," does not mean that the chain tensioning unit itself moves vertically up and down, but means that a carriage bolt with a head can be moved up and down to position the unit prior to operation, so that claim 1(a)(ii) means: "A carriage bolt with a head which can be moved up and down to position the unit prior to operation within the slot of the slotted plate";

Claim 1(a)(iii) should be construed to include a nut, so that claim 1(a)(iii) means: "the inner slide plate, top block, and outer slide plate are held in place on the carriage bolt by a nut";

Claim 1(a) should not be construed to be a means-plus-function element, and should not be construed to include any reference to pins in Claim 1(a)(iii);

Claim 1(b) should be construed to be a means-plus-function element, and to mean that the means for movably positioning on another axis said rubbing block in contact with said movable chain is by way of "at least one spring" and shim or shims, referencing Claim 3 as a complete statement of the means for performing the function; and

Claim 2 should be construed to mean: "The chain tensioning device of claim 1 where said rubbing block comprises on one side two projections into which the inner slide plate fits and on the opposite side an indentation into which the outer slide plate fits."

This recommendation is not an order that is immediately appealable to the Ninth Circuit Court of Appeals. Any notice of appeal pursuant to Rule 4(a)(1), Federal Rules of Appellate Procedure, should not be filed until entry of the district court's judgment or appealable order. The parties shall have ten days from the date of service of a copy of this recommendation within which to file specific written objections with the court. Thereafter, the parties have ten days within which to file a response to the objections. Failure to timely file objections to any factual determinations of the Magistrate Judge will be considered a waiver of a party's

right to de novo consideration of the factual issues and will constitute a waiver of a party's right to appellate review of the findings of fact in an order or judgment entered pursuant to the Magistrate Judge's recommendation.

D.Or.,2004.

Tom Hayden Enterprises, Inc. v. Southern Oregon Hot Bikes, Inc.

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