

Keywords: negative limitations, written description requirements, 35 U.S.C. § 112, inventor’s testimony, assignor estoppel

General: Limitations in claim for railroad track fastening system, which require use of “adhering material” as “sole means” of adhering abrasion-resistant rail plate to rail tie, are supported by written description that discloses use of closed cell foam pad as “adhering material,” and discloses no alternative means of bonding rail plate to tie.

Pandrol USA LP v. Airboss Railway Products Inc.

76 U.S.P.Q.2d 1524 (Fed. Cir. 2005)

Decided September 19, 2005

I. Facts

Pandrol USA LP and Pandrol Ltd. (hereinafter “Pandrol”) filed suit in U.S. District Court for the Western District of Missouri against Airboss Railway Products Inc., Airboss of America Corp., Robert M. Magnuson, and Jose R. Mediavilla (hereinafter “Airboss”) for patent infringement of U.S. Patent No. 5,110,046 (hereinafter “the ‘046 patent”). The district court granted summary judgment of infringement and dismissed invalidity counter claims. On appeal, the summary judgment of infringement was affirmed and the dismissal of invalidity counterclaims was reversed.

On remand, the district court determined that there was no genuine issue regarding whether the ‘046 patent’s original specification satisfies the written description requirement of 35 U.S.C. § 112 and granted summary judgment that the ‘046 patent is not invalid. Specifically, the district court declined to invalidate claims because the specification includes sufficient disclosure to support the claim terms “adhering material” and “sole means,” which were both added by amendment during prosecution.

Airboss appealed this summary judgment.

II. Issues

- A. Did the district court properly conclude that no reasonable juror could find that the ‘046 patent fails to satisfy the written description requirement of 35 U.S.C. § 112?
- B. Did the district court properly exclude the inventor/assignor of the ‘046 patent from testifying?

III. Discussion

A. Yes. The written description requirement does not require the applicant to describe exactly the subject matter claimed. Rather, the description must clearly allow persons of ordinary skill in the art to recognize that the inventor invented the claims.

It should be noted that during prosecution, amendments were made to both the claims and the specification. For the purposes of written description analysis, the court focuses on the original disclosure. Claims 1 and 3 as issued are as follows:

1. An abrasion resistant rail seat for securing a rail to a concrete rail tie of the type in which the rail has a flange and is secured to a concrete rail tie by elastic rail clamps and an elastomeric rail pad insulates the rail from the rail tie, the improvement comprising interposing an abrasion resistant plate between said rail pad and said rail tie, said abrasion resistant plate forming a water tight seal with said rail tie, said abrasion resistant plate being wider than said rail and extending beyond the flange of said rail, and a layer of *adhering material* between said abrasion resistant rail plate and said rail tie for adhering said plate to said tie, said material being the *sole means* for *adhering* said plate to said tie so that replacement of said abrasion resistant rail plate is facilitated.

3. A rail seat as claimed in claim 2, wherein said *adhering material* is a closed cell foam pad of one to two millimetres [sic] in thickness and of similar shape to said plate.

With respect to the “adhering material” claim limitation, the court found that the original written description of the ‘046 patent describes a closed cell foam pad. Specifically, the court found that passages in the original specification show that one way of providing an effective adhesive between the plate and concrete rail tie is a closed cell foam pad. Portions of the original specification that the court found persuasive with regard to this interpretation are set forth below:

Preferably the abrasion plate may be adhered to the surface of the concrete tie to ensure that ingress of abrasive particles and water onto the surface of the rail tie is avoided.

The plate may be bonded to the rail tie or a resilient gasket can be interposed between the rail tie and the plate.

The plate 10 may be bonded by adhesive (epoxy resin adhesives are preferred) to the tie 1 or an HDPE closed cell foam of 1.5 mm thickness of the same size and shape as plate 10 is fitted between plate 10 and tie 1.

Accordingly, the written description of the '046 patent discloses an "adhering material," as claimed, in sufficient detail to show possession of the full scope of the invention.

With regard to the "sole means" limitation, the court found that the disclosed adherents are the "sole means" for the adhering function. While the '046 patent describes and shows a clamping system that secures some parts mechanically, the clamping system does not "adhere." Indeed, the court found that the record did *not* show that the clamping system caused or contributed to the adhering performed by the HDPE foam. Thus, the disclosed adherents remain the "sole means" for that function.

It should be noted that the court apparently found support for the "sole means" term, a negative limitation, based on the lack of disclosing any other means. However, this is likely due to the deference given an issued patent.

B. Yes. The inventor/assignor was properly excluded from testifying under the doctrine of assignor estoppel and for failure to produce an expert report.

With regard to the doctrine of assignor estoppel, assignor estoppel is appropriate in this case because an assignor should not be permitted to sell something and later assert that what was sold is worthless, all to the detriment of the assignee. Indeed, fair dealing between assignor and assignee of a patent, whereby the assignor will not be permitted to say that what he has sold as patentable was not patentable, is an established principle of American law. Thus, assignor estoppel prevented the assignor from asserting that his own patent is invalid and worthless.

With regard to the failure to produce the expert report, the inventor/assignor was deemed to be providing expert opinion. Airboss did not produce an expert report before trial. Accordingly, Airboss failed to meet the requirements of Federal Rule of Civil Procedure 26(a)(2) and the testimony was properly excluded.