

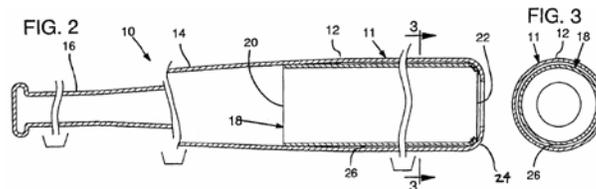
Keywords: Claim construction; infringement; context; accused device

General: Federal district court erred in construing patent for softball bat without supplying any information about accused infringing devices, since, without description of accused bats, reviewing court lacks full context of infringement action and claim construction component of infringement, and without that additional context, reviewing court cannot fully and confidently review infringement judgment, including its claim construction component; although accused product or process may not be used as form of extrinsic evidence to supply limitations for patent claim language, that rule of claim construction does not forbid awareness of accused product or process to supply parameters and scope of infringement analysis, including its claim construction component.

Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.
78 U.S.P.Q.2d 1382 (Fed. Cir., 2006)
Decided March 23, 2006

I. Facts

Wilson Sporting Goods Co. (Wilson) owns U.S. Patent No. 5,415,398 (the ‘398 Patent). The ‘398 is directed to a softball bat that has an improved impact response due to an insert being placed within the body of the bat. The bat and the insert are illustrated in Figs. 2 and 3 reproduced below.



According to the specification of the ‘398 patent, element 26 represents a “narrow, uniform gap...between the insert 18 and the inner wall of the impact portion 12. The gap extends uniformly around the insert...and along the length of the insert between the first and second ends 20 and 22 thereof.” The insert is separated from the tubular frame by a gap except at its ends, where the insert and the frame are adjoined. Upon impact with a ball, the outerwall 11 and the insert 18 jointly act as a spring, which elastically deflects and stores energy from the impact with the ball. As the bat and insert rebound, energy from the initial deflection returns to the ball.

Wilson sued Hillerich & Bradsby Co. (H&B) in the Northern District of Illinois (district court) alleging infringement of claims 1, 15, and 18 of the ‘398 Patent. In a *Markman* hearing, the district court construed the terms of claims 1, 15, and 18. In particular, the court construed “gap” in all claims to mean “a single continuous space or void between the interior of the frame and the exterior of the insert great enough to allow for deflection across the gap,” precluding contact between the bat frame and the insert at any point along the length of the insert before impact. Additionally, the court construed “insert” in all claims to mean a “rigid, circular, hollow tube having an outer diameter less than the inner diameter of the tubular frame of the impact portion.”

In a stipulated Rule 54 judgment, the court dismissed the infringement action with prejudice, granted H&B’s declaratory action that its bats do not infringe the ‘398 patent, and dismissed H&B’s cause of action for declaratory judgment of invalidity of the ‘398 patent. It is from the Rule 54 judgment that this appeal was taken.

II. Issue

Did the district court properly construe the claims of the '398 patent?

III. Discussion

No. The Federal Circuit determined that there were several flaws in the claim construction provided by the district court. In particular the Federal Circuit found that there was a lack of context for construction of the claims. “[I]n reviewing claim construction in the context of infringement, the legal function of giving meaning to claim terms *always* takes place in the context of a specific accused infringing device or process.” The Federal Circuit recognized that the court should not tailor a “claim construction to fit the dimensions of the accused product or process and to reach a preconceived judgment of infringement or non-infringement,” but stated that “awareness of the accused product is necessary to establish the parameters and scope of the infringement analysis, including its claim construction.” Without the context of the accused product, therefore, the Federal Circuit states that the record is incomplete and it cannot assess the accuracy of the infringement or validity determination.

Despite the limited record, in remanding the case, the Federal Circuit offers some analysis to guide the trial court in construing the claims. Specifically, the Federal Circuit construes the claim terms at issue, as well as several other terms, relying on standard claim construction principles, and without any reference to the accused products. Following their construction of the claims, the Federal Circuit stated:

To reiterate, this court has discussed the claim interpretation based solely on the claim language and the context of the patent. Unfortunately this court lacked the full context of this infringement action and the claim construction component of infringement because the record on appeal contains no description of the accused infringing devices. Without that additional context, this court cannot fully and confidently review the infringement judgment, including its claim construction component.

Accordingly, because of the limited record, the Federal Circuit vacated the decision of the district court and remanded the case back to the district court for further proceedings.