

Keywords: claim construction, non-functional claim terms

General: Challenges to claim construction should include how the infringement analysis will be affected.

Superior Industries, Inc. v. Masaba, Inc.,

U.S. Court of Appeals Federal Circuit

2013-1302

Decided January 16, 2014 (non-precedential)

I. Facts

Superior Industries owns a group of patents related to bulk material handling. The patents relate to either the support structure/undercarriage (U.S. No. 7,470,101 and U.S. No. 7,618,231) or a conveyor for handling the bulk material (U.S. No. 7,424,943; U.S. No. 7,607,529; and U.S. No. 7,845,482). Superior sued Masaba for infringing all five patents.

At the District Court, Superior conceded that there was no infringement based on the claim construction established during the *Markman* hearing. Masaba was granted summary judgment of non-infringement, with Superior appealing the claim construction of several terms present in a variety of claims in the patents.

II. Issue

Was there sufficient evidence on the record to determine the factual context for the claim construction issues?

III. Holding

No. The court determined there was insufficient basis for meaningful review. Specifically, the court pointed out that the order from the district court did not provide any detail as to how the claim construction affected the infringement analysis. Moreover, the court pointed out that the briefs of Superior and Masaba also failed to clarify how the construction affected the infringement analysis. Therefore, the court determined there was a risk of issuing an advisory opinion and remanded for clarification.

IV. Chief Judge Rader's Concurrence

Judge Rader concurred that more information was required to determine how the claim construction affected the infringement analysis. However, Judge Rader also issued some guidance to the district court for construing claims on remand. Specifically, Judge Rader pointed out that "a system claim generally covers what the system is, not what the system does." *Hewlett-Packard Co. v. Bausch & Lomb., Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990).

Additionally, Judge Rader also mentioned that “it is usually improper to construe non-functional claim terms in system claims in a way that makes infringement or validity turn on their function.” *Paragon Solutions, LLC v. Timex Corp.*, 566 F.3d 1075, 1091 (Fed. Cir. 2009).

Hewlett-Packard

In *Hewlett-Packard*, HP brought a suit against Bausch & Lomb (B&L) for the infringement of a LaBarre patent related to X-Y plotters. B&L attempted to invalidate the LaBarre patent based on the Yeiser patent.

Both the LaBarre and Yeiser patents include pinch rollers that hold a piece of paper to prevent slippage while the paper is moved. The LaBarre patent teaches pinch wheels covered in “grit” to increase the friction and create indentations in the paper that mate with the grit as the paper is being moved. The Yeiser patent teaches knurled and/or rubberized pinch wheels to create friction between the paper and the pinch rollers.

B&L argued that HP failed to show “operational differences” between grit and a knurled surface and therefore the LaBarre patent should be invalidated. However, the Federal Circuit noted that “apparatus claims cover what a device *is*, not what a device *does*. An invention need not *operate* differently than the prior art to be patentable, but need only *be* different.” (Emphasis in original.) Accordingly, the Federal Circuit affirmed the validity of the LaBarre patent.

It should be noted that independent claim 1 of the LaBarre patent, which the Federal Circuit said was relevant to their opinion, did not contain any “configured to” language. In fact, the claim turned on a “wherein” clause which described the structure of a rough surface as having “a random pattern, size, and height of rough spots.”

Paragon Solutions

In *Paragon Solutions*, Paragon brought suit against Timex for a variety of products related to exercise monitoring systems (e.g., watches) that could track a user’s performance and display it back in “real time.”

The court evaluated “configured to” language when construing both “display unit” and “displaying real-time data.” For the display unit, calling out a display configured to display data from certain sources was sufficient to construe that “[t]he claim unambiguously states that the data provided to the display comes from both the electronic positioning device and the physiological monitor.”

However, when construing “displaying real-time data” the court cautioned against use limitations for structural terms. Specifically, the court mentioned that claims should not be construed so that “the same apparatus might infringe when used in one activity, but not infringe when used in another.” The court noted that “real time” for some activities like walking or snowshoeing may be different for other activities like distance running.

By citing these cases, Judge Rader appears to have suggested to the district court that portions of the Superior patents inclusive of “configured to” elements may not include structural elements. For example, claim 1 of the 7,470,101 patent to Superior is reprinted below:

. . . the first and second channel beams each having a first end configured to pivotally connect to the base frame of the portable conveyor system and a second end configured to receive the second ends of the first and second beams . . .

It is likely that Judge Rader is looking for some evidence of structure that causes the pivoted connection, as opposed to a first end that just happens to be capable of making a pivoted connection, to demonstrate “what the system is, not what the system does.” Additionally, that structural evidence may prevent construction that “makes infringement or validity turn on [the] function” of the components.

V. Conclusion

For the Federal Circuit to provide meaningful review of claim construction, some indication of the affect on the infringement analysis is required. Moreover, Judge Rader is indicating that inherent properties of components may be insufficient to support “configured to” language.