IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

- -

JOHN MEZZALINGUA ASSOCIATES, INC.
d/b/a PPC, INC.,

OPINION AND ORDER

Plaintiff,

03-C-353-C

v.

ARRIS INTERNATIONAL, INC.,

Defendant.

- -

The parties in this case are competitors in the business of manufacturing and selling coaxial cable connectors. Plaintiff John Mezzalingua Associates, Inc. d/b/a PPC, Inc. contends that defendant Arris International, Inc. has been selling cable connectors that infringe U.S. Patent No. 6,558,194, which is owned by plaintiff and issued on May 6, 2003. Jurisdiction is present under 28 U.S.C. §§ 1331 and 1338.

After a hearing on July 23, 2003, I granted plaintiff's motion to preliminarily enjoin defendant from selling its Digicon ® "S" connector because I concluded that plaintiff had shown a likelihood of success on the merits, that plaintiff would be irreparably harmed if the injunction did not issue and that the public interest would not be disserved by the issuance

of an injunction. In addition, I concluded that the potential harm to defendant in issuing the injunction was not so great that it outweighed the other factors. See July 25, 2003 Op. and Order, dkt. #41. I denied defendant's motion for reconsideration in an opinion and order dated August 6, 2003.

In September 2003, plaintiff filed a motion to amend its complaint to add another claim. Plaintiff alleged that defendant had begun selling a Digicon® "T" cable connector that was essentially the same as the "S" connector and also infringed the '194 patent. I granted the motion to amend in an opinion and order dated September 22, 2003.

Presently before the court are a motion to construe several terms in the '194 patent and defendant's motion for summary judgment. Neither party has moved for summary judgment on the issue whether the Digicon® "S" or "T" cable connectors sold by defendant infringe the '194 patent. Instead, defendant has filed a motion for summary judgment on the ground that the '194 patent is invalid under 35 U.S.C. § 282. Further, it appears that defendant has abandoned the position it advanced in opposing plaintiff's motion for a preliminary injunction that the '194 patent is invalid for obviousness. Its sole argument in support of its summary judgment motion is that both of the claims in the '194 patent are invalid because they were anticipated by Randall Holliday in U.S. Patent No. 5,863,220.

With respect to the motion on claim construction I construe (1) "rotatably engaging" to mean "holding the tubular post fast in place, while allowing the tube to rotate"; (2)

"proximate" to mean "very near"; (3) "commensurate" to mean "large enough to extend over the cylindrical sleeve while compressing the deformable rear end portion of the cylindrical sleeve"; (4) "internal bore" to include an "internally threaded bore"; (5) "non-tapered internal bore" to mean "a bore that does not gradually diminish in one direction, subject to the inherent limitations of the materials and processes used in the manufacture of the compression ring"; (6) "constant diameter internal bore" to mean "a bore with a diameter that does not vary, subject to the inherent limitations of the materials and processes used in the manufacture of the compression ring"; (7) "end" to mean "concluding part"; (8) "rear end portion" to mean "the portion of the cylindrical sleeve beginning at the sleeve's rear extreme edge or tip and comprising at least the portion of the cylindrical sleeve that is deformable"; (9) "cylindrical sleeve" to include "the portion of the cylindrical body member that is inside the compression ring when the compression ring is fully installed"; and (10) "advanced axially" to mean "moved forward on or along an axis."

With respect to defendant's motion for summary judgment, I conclude that defendant has failed to show that no reasonable jury could find in favor of plaintiff on the question whether the Holliday '220 patent anticipated the '194 patent. Accordingly, I will deny defendant's motion for summary judgment.

From the parties' proposed findings of fact and the record, I find the following facts to be material and undisputed.

UNDISPUTED FACTS

A. Prosecution History of the '194 Patent

On July 21, 2000, Noah Montena, an employee of plaintiff, filed U.S. Patent Application No. 09/621,975, which was a continuation of U.S. Patent Application No. 08/910,509. Several weeks later, Montena submitted a preliminary amendment, which added new claims 2-14. In a decision dated April 30, 2001, the patent examiner rejected many of the claims as being anticipated by U.S. Patent No. 5,863,220, a patent filed in November 1996, issued in January 1999 and owned by inventor Randall Holliday. The examiner rejected other claims as obvious.

Montena filed two amendments in response to the examiner's decision, in which he argued that Holliday's invention and patent did not include every element in his proposed invention. Specifically, Montena argued that Holliday's "cylindrical 'internally threaded portion 50' leading from the 'inwardly tapered wall 54' . . . is clearly NOT 'of a diameter commensurate with the first predetermined diameter of the outer wall of said open rear end portion of said cylindrical sleeve' as claimed in each of independent claims 2, 10, 11 and 13." In a decision dated November 13, 2001, the examiner adhered to her previous conclusion that the Holliday '220 patent anticipated plaintiff's claim 2.

On February 7, 2002, plaintiff added new claims 21-34. Claim 21 included a new limitation that the first end of the compression ring must have a "non-tapered" first internal

bore. Claim 22 added a similar limitation that the first end of the compression ring must have a first internal bore with a "constant diameter." The examiner allowed claims 21 and 22 on January 7, 2003, with plaintiff's authorization to cancel all other pending claims. The examiner wrote: "Claims 21 and 22 contain allowable subject matter. The prior art does not show or teach a connector having a tubular post, nut, cylindrical body, and compression ring as claimed wherein the compression ring has a non-tapered internal bore (claim 21) or a first constant diameter internal bore (Claim 22)." Claims 21 and 22 became claims 1 and 2 of the '194 patent.

Claim 1 reads as follows:

> A connector for coupling an end of a coaxial cable to a threaded port, the coaxial cable having a center conductor surrounded by a dielectric, the dielectric being surrounded by a conductive grounding sheath, and the conductive grounding sheath being surrounded by a protective outer jacket, said connector comprising:
>
> a. a tubular post having a first end adapted to be inserted into an exposed end of the coaxial cable around the dielectric thereof and under the conductive grounding sheath thereof, said tubular post having an opposing second end;
>
> b. a nut having a first end for rotatably engaging the second end of said tubular post and having an opposing second end with an internally threaded bore for theadedly engaging the threaded port;
>
> c. a cylindrical body member having a first end and second end, the first end of said cylindrical body member including a cylindrical sleeve having an outer wall of a first diameter and an inner wall, the inner wall bounding a first central bore extending about said tubular post, the second end of said cylindrical body member engaging said tubular post proximate the second end thereof, said cylindrical sleeve having an open rear end portion for receiving the outer jacket of the coaxial cable, said open rear end portion being deformable;
>
> d. a compression ring having first and second opposing ends and having a

central passageway extending therethrough between the first and second ends thereof, the first end of said compression ring having a first non-tapered internal bore of a diameter commensurate with the first diameter of the outer wall of said cylindrical sleeve for allowing the first end of said compression ring to extend over the first end of said cylindrical body member, the central passageway of said compression ring including an inwardly tapered annular wall leading from the first internal bore and narrowing to a reduced diameter as compared with the first diameter; and

e. said inwardly tapered annular wall causing said rear end portion of said cylindrical sleeve to be deformed inwardly toward said tubular post and against the jacket of the coaxial cable as said compression ring is advanced axially over the cylindrical body member toward the second end of said cylindrical body member.

Claim 2 is identical to claim 1, with the exception that in element (d), the word "non-tapered" in claim 1 is replaced by the words "constant diameter" in claim 2.

The '194 patent has three preferred embodiments, each of which is shown below.

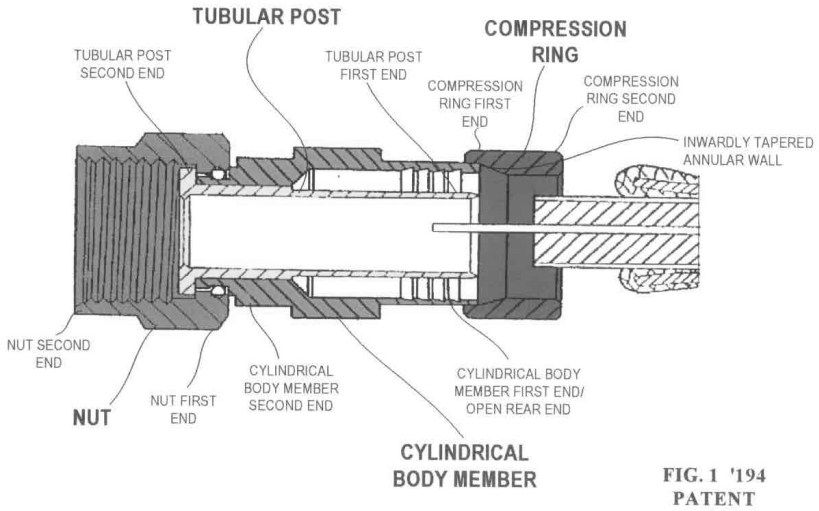
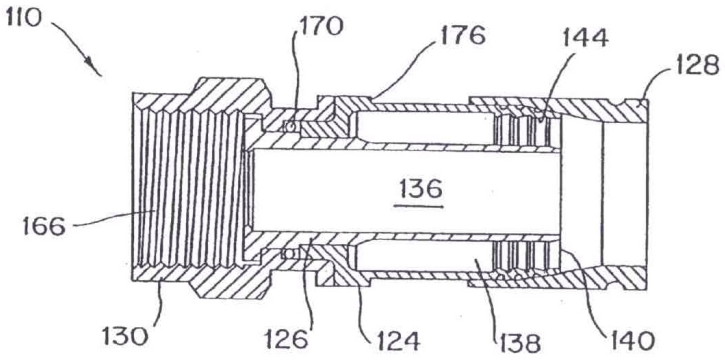
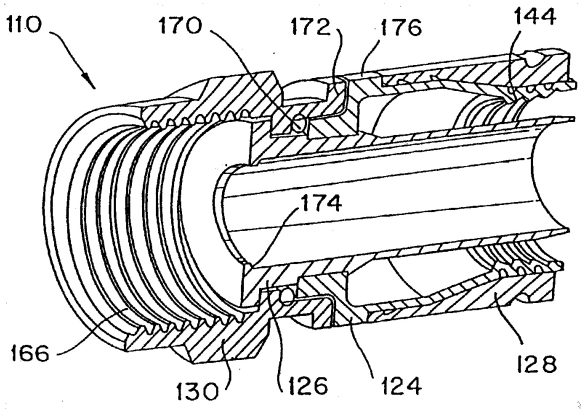


FIG. 1 '194 PATENT

(Fig. 1)


110
170
176
144
128
136
166
130
126
124
138
140

(Fig. 7)


110
170
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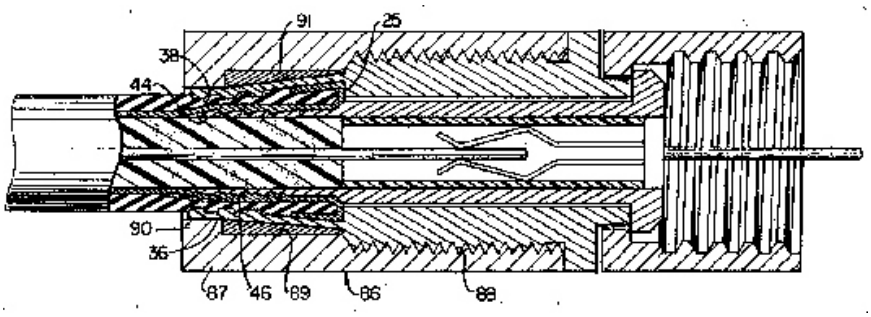
128

(Fig. 13)

B. Holliday '220 Patent

The Holliday '220 patent is prior art to the '194 patent. The Holliday patent discloses a connector for coupling the end of a coaxial cable. The connector includes: (a) a tubular post with a first end that is inserted into the end of a cable; (b) a nut that rotatably engages the second end of the tubular post and has internal threads for engaging a threaded port; (c) a cylindrical body member with a sleeve and an open rear end portion at the first end and a second end that engages the tubular post at the post's second end; (d) a compression ring with an inwardly tapered annular wall that causes deformation of the sleeve.

The preferred embodiment of the '220 patent is shown below:



(Fig. 5)

OPINION

I. CLAIM CONSTRUCTION

Before considering the merits of defendant's invalidity defense, it is necessary to construe the claims of the '194 patent. Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1351 (Fed. Cir. 2001). The meaning of a term in a claim is a question of law that is determined by the court rather than the finder of fact. Herbert v. Lisle Corp., 99 F.3d 1109, 1117 (Fed. Cir. 1996). Recently, in Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1201-05 (Fed. Cir. 2002), the Court of Appeals for the Federal Circuit clarified and confirmed several principles of claim construction:

- claim construction begins with the language of the claims themselves
- there is a "heavy presumption" that claim terms have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art
- dictionaries are "particularly useful resources" in determining the ordinary meaning of words because they are "unbiased reflections of common understanding not influenced by expert testimony"
- when a term has multiple dictionary definitions, the court should consult the intrinsic record (the specification and the prosecution history) to determine which definition or definitions are consistent with the patent
- the presumption in favor of a dictionary definition may be overcome if the

patentee has clearly set forth his or her own meaning of the term in the patent

- terms should not be limited to the embodiments in the specification if a person of ordinary skill in the relevant art would not understand the term to be so limited
- a court may rely on expert testimony to determine the meaning of a term only when the intrinsic evidence is ambiguous

The parties discuss ten terms in their claim construction briefs: "rotatably engaging," "proximate," "commensurate," "bore," "non-tapered," "constant diameter," "end," "rear end portion," "cylindrical sleeve" and "advanced axially." With the exception of the terms "constant diameter" and "non-tapered," which are used in one claim only, the parties agree that each term has the same meaning in both claims.

A. Rotatably Engaging

In the July 25 opinion and order, I preliminarily construed the term "rotatably engaging" to mean "holding the tubular post fast in place, while allowing the tube to rotate." Plaintiff agrees with this definition. It is not clear whether defendant agrees or disagrees. Defendant does not argue that the court's initial construction was incorrect; it does not even acknowledge that I construed this term in the July 25 opinion and order. Also, in its reply brief, defendant identifies the terms "engage" and "engaging" as ones on which the parties agree. Nevertheless, in its opening claim construction brief, defendant offers a definition of

"engaging" as meaning "to come into gear with; as, the teeth of one cogwheel engage those of another, or one part engages another part." This definition appears to conflict with the court's initial construction because it would require the two objects to come into physical contact with each other. Plaintiff offered no argument to support its definition, either in its brief or during the claim construction hearing, even though I asked defendant to clarify its position on this term. Thus, it appears that defendant has conceded that the court's initial construction is correct or it has waived any argument that the construction was incorrect because it failed to develop the point. Either way, I adhere to the initial construction of "rotatably engaging" to mean "holding the tubular post fast in place, while allowing the tube to rotate."

B. Proximate

Claims 1(c) and 2(c) of the '194 patent require the second end of the cylindrical body member to engage the tubular post "proximate" to the second end of the tubular post. The ordinary meaning of "proximate" means "very near" or "immediately preceding or following." See July 25, 2003 Op. and Order, dkt. #41 (citing Merriam-Webster Dictionary online at http://www.m-w.com/cgi.bin/dictionary). In the July 25 opinion and order, I concluded that a definition of "immediately preceding or following" would be inconsistent with the patent because, in the second preferred embodiment, there is an O-ring and a small

portion of the nut that separates cylindrical body member from the very end of the tubular post. Using the specification to choose between multiple definitions is an accepted method of claim construction. See Texas Digital, 308 F.3d at 1203 ("Because words often have multiple dictionary definitions, some having no relationship to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor."); Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed. Cir. 1995) ("an interpretation [excluding the preferred embodiment] is rarely, if ever, correct and would require highly persuasive evidentiary support").

Although I rejected defendant's position in the July 25 opinion and order, it continues to argue that the "ordinary meaning of proximate does not permit anything to come between one thing and another thing." Dft.'s Cl. Constr. Br., dkt. #103, at 30. However, it fails to explain why a definition of "next to" is preferable to "very near." Further, defendant does not even attempt to reconcile its proposed construction with the second preferred embodiment. I adhere to my conclusion in the July 25 opinion and order that the term "proximate" means "very near."

C. Commensurate

Claims 1(d) and 2(d) disclose a first internal bore of the compression ring with a

diameter that is "commensurate" with the first diameter of the outer wall of the cylindrical sleeve "for allowing the first end of said compression ring to extend over the first end of said cylindrical body member." The ordinary meanings of "commensurate" include "equal in measure or extent," "proportionate," "adequate" or "corresponding in size, extent, amount or degree." See July 25, 2003 Op. and Order, dkt. #41, at 10 (citing Merriam-Webster Dictionary online and Oxford English Dictionary online). In the context of the claims, I concluded in the July 25 opinion and order that "commensurate" means "just slightly larger than the cylindrical sleeve" so that it can "slide over the cylindrical sleeve encasing the tubular post."

Defendant contends that the full definition of "commensurate" should be "just slightly larger." However, such a definition would be incomplete. At the very least, the meaning of commensurate requires that there be a relationship or correspondence between the two diameters. A definition of "just slightly larger" would eliminate any such requirement.

At the same time, I recognize that there are ways that two diameters could correspond besides a situation in which one is just large enough to slide over the other. Defendant takes this observation one step further, seizing on the language "to extend over" to argue that there is no limitation in claims 1(d) and 2(d) that the compression ring *slide* over the cylindrical sleeve. I agree with defendant that defendant the claims do not contain a sliding limitation,

but I do not agree that the phrase "extend over" should be read in isolation. The claims describe a *compression* ring that extends over a sleeve that is "deformable." The parties do not suggest that a "compression ring" is anything but what it sounds like, namely, a ring that compresses the cylindrical sleeve. There are a limited number of ways that the diameter of a compression ring could be commensurate with the diameter of the object it compresses or deforms. Accordingly, I construe the term "commensurate" to mean that the diameter of the first internal bore of the compression ring is "large enough to extend over the cylindrical sleeve while compressing the deformable rear end portion of the cylindrical sleeve." As plaintiff points out, this construction is consistent with each of the preferred embodiments in the specification, which all refer to the compression ring as being "press-fitted" or "securely-attached" to the cylindrical body member. See Pat. '194, col. 2, lines 48-49; id. at col. 7, line 54-55; id. at col. 10, line 1-3.

D. Internal Bore

I did not construe this term, or any of the remaining terms at issue in this case, in the July 25 opinion and order. The dispute regarding the term "internal bore" is whether it encompasses an "internally threaded bore." Plaintiff argues that it does not because the ordinary meaning of "bore" connotes something that is hollow and smooth. Defendant disagrees, pointing out that one of the examples of a bore that plaintiff discusses in its brief,

the bore of a firearm barrel, is not smooth. Regardless of the ordinary meaning of bore, however, the patent uses the term "threaded bore" to describe the inside of a nut. This suggests that, in the patentee's lexicon, a "bore" can be threaded or smooth. If the patentee did not want "bore" to encompass threaded objects, he should have used a word other than "bore" to describe the inside of a nut. Alternatively, if he wanted to limit the compression ring to smooth objects, he should have used the term "internally smooth bore."

As defendant points out, it is a basic principle of logic that a genus necessarily includes one of its species. Thus, the genus "bore" must encompass the species "threaded bore." Plaintiff cannot escape the effect of this basic principle by arguing that all of the preferred embodiments have a compression ring with a smooth internal bore. It is well-settled that a court may not read limitations from the specification into the claims. Anchor Wall Systems, Inc. v. Rockwood Retaining Walls, Inc., 340 F.3d 1298, 1308 (Fed. Cir. 2003); Specialty Composites v. Cabot Corp., 845 F.2d 981, 986-87 (Fed. Cir. 1988) (patent that used term "plasticizer" covered both "internal plasticizers" and "external plasticizers" even though the patent provided examples of "external plasticizers" only). An "internally threaded bore" is an "internal bore."

E. Constant Diameter Internal Bore/Non-tapered Internal Bore

These terms appear to be the most hotly contested in this case. The parties agree on

their literal meaning: a "non-tapered" bore is one that does not gradually diminish in one direction and a "constant diameter" bore is one that has a diameter that does not vary from one end of the bore to the other. However, the parties disagree on how an ordinary person of skill in the art would understand the terms in the patent. Defendant argues that the words "non-tapered" and "constant diameter" are non-technical terms that should be given their ordinary, literal meaning. Plaintiff argues that one of ordinary skill in the art would not give the terms their literal meaning, but would understand that the terms were subject to the inherent limitations of the materials and processes used in manufacturing.

Defendant is correct that there is a heavy presumption that terms in a claim should be given their ordinary meaning, particularly when the terms are non-technical. See Middleton, Inc. v. Minnesota Mining and Manufacturing Co., 311 F.3d 1384, 1387-88 (Fed. Cir. 2002). However, at the claim construction hearing, experts for both sides admitted that it would be impossible to create a compression ring with a perfectly constant diameter. In addition, both experts addressed the necessity of using draft angles when making compression rings out of plastic, one of the materials used in the preferred embodiments of the '194 patent. See Pat. '194, col. 3, lines 31-35 (stating that parts of cable connectors in preferred embodiments may be made of plastic). Although the experts disagreed on the degree of the appropriate draft angle for plastic parts in a cable connector, they did agree that it would be almost impossible to make a perfectly non-tapered plastic

compression ring. Thus, if the terms "constant diameter" and "non-tapered" were limited to mean *perfectly* constant and *perfectly* non-tapered, the '194 patent would not cover its own preferred embodiments. Moreover, claim 2 would not apply to *any* products in the real world because no cable connectors have parts with perfectly constant diameters.

The principles of claim construction do not require such an absurd result. Courts may reject a literal definition if doing so is necessary to remain consistent with the object of the invention as expressed in the specification. See Bausch & Lamb, Inc. v. Barnes-Hind/Hyrdocurve, Inc., 796 F.2d 443, 450 (Fed. Cir. 1986) (rejecting definition of "smooth" as "absolutely ridge-free" because one of ordinary skill in art would understand that "smooth means smooth enough to serve the inventor's purposes"); see also Quantum Corp. v. Rodime, 65 F.3d 1577, 1581 (Fed. Cir. 1995) (assuming that one of ordinary skill in relevant art would understand "600 tpi" to mean "approximately 600 tpi").

It is true, as the Court of Appeals for the Federal Circuit has recognized, that the appropriate manufacturing tolerances for a particular product should be determined by contract and not through claim construction. Middleton, 311 F.3d at 1389; Senmed, Inc. v. Richard-Allan Medical Industries, Inc., 888 F.2d 815 (Fed. Cir. 1989). In accordance with these cases, I agree with defendant that plaintiff is not entitled to read into the claims its chosen manufacturing tolerances. However, the question before the court is not what the appropriate manufacturing tolerances are but whether one of ordinary skill in the art would

take into account real world constraints when defining terms. When it is impossible to create a completely flat or unvarying surface, it is not difficult to surmise, even without expert testimony, that one of ordinary skill in the art would understand the terms "non-tapered" and "constant diameter" to include not only the perfect manifestations of these terms, but also objects that are as close to perfection as available technology can reasonably achieve.

Further, I disagree with defendant's suggestion that, under this approach, competitors would not have fair notice whether they are infringing. By necessity, companies that employ a particular material in manufacturing will know that material's inherent limitations. So long as the scope of the term extends only as far as necessary to accommodate the *inherent limitations* of the materials (rather than what is cost effective, see Senmed, 888 F.2d at 820 n.10), potential competitors will not be left to guess what infringes and what does not.

In sum, I am persuaded that one of ordinary skill in the art would know that cable connectors are manufactured in the real world and not in the mind of God. Accordingly, I construe "non-tapered internal bore" to mean a "a bore that does not gradually diminish in one direction, subject to the inherent limitations of the materials and processes used in the manufacture of the compression ring." I construe "constant diameter internal bore" to mean "a bore with a diameter that does not vary, subject to the inherent limitations of the materials and processes used in the manufacture of the compression ring."

F. End

By itself, the term "end" is undeniably ambiguous. Merriam Webster Online offers more than a dozen definitions for the noun form of the word. Plaintiff's definition is "concluding part." Initially, defendant's proposed definition was narrower, "the outside or extreme edge or physical limit; a boundary." In its reply brief and at the claim construction hearing, defendant wavered slightly, arguing that an "end" must at least *include* the extreme edge or tip, or what plaintiff refers to as the "very end."

There does not appear to be any dispute that the concluding part of an object includes the extreme edge or tip. However, to the extent that defendant adheres to its initial proposed construction, I agree with plaintiff that it is too narrow. To be sure, in some of the embodiments, the patentee appears to equate the "end" of a part with its extreme edge. See Pat. '194, col. 11, lines 57-59 (equating "first end" with "first opening" in Fig. 17). However, the claim language itself demonstrates that an "end" in the '194 patent may include more than just the extreme edge. For example, claims 1(c) and 2(c) disclose "a cylindrical body member having a *first end* and a *second end,* the first end of said cylindrical body member *including a cylindrical sleeve*." Thus, one "end" of the cylindrical body member includes the cylindrical sleeve, which the parties agree encompasses more than just the extreme edge of the cylindrical body member.

In sum, it appears that the patentee did not use the term "end" to mean the exact

same length with respect to each object. Rather, depending on the context, an "end" could be as small as the tip of an object or as large as half of the object. The only definition of "end" that would be consistent with these different lengths is one similar to plaintiff's definition, which includes the extreme edge but is not limited to that portion. Accordingly, I construe the term "end" to mean "the concluding part."

G. Rear End Portion

The parties appear to agree that "rear end portion" means "the portion of the cylindrical sleeve beginning at the sleeve's rear extreme edge or tip and comprising at least the portion of the cylindrical sleeve that is deformable."

H. Cylindrical Sleeve

Defendant defines this term to mean "a non-tapered cylinder into which an object or device fits." This proposed construction has multiple problems. First, it is not useful because it fails to define the term "cylindrical sleeve" in the context of the '194 patent. Also, defendant attempts to read in a "non-tapered" limitation that is not included in the claims. Defendant argues that the ordinary meaning of "cylindrical" excludes objects that are tapered, but defendant's own definition of "cylindrical" demonstrates the fallacy of this argument. Citing the American Heritage Dictionary, defendant defines "cylindrical" to mean

"of, relating to, or having the shape of a cylinder, especially of a circular cylinder." Nothing in this definition, which is substantially the same as the one provided by Merriam-Webster, requires "cylindrical" objects to be perfect circular cylinders. A tapered object can still be "cylindrical." Even if the ordinary meaning of "cylindrical" required a perfect cylinder, it is clear that the patentee did not intend this definition to apply in the context of the '194 patent. The patent also discloses a "cylindrical body member," but it is clear from the various figures in the specification that the cylindrical body member is not a perfect cylinder; each of them has various irregularities. Thus, so long as the object is cylinder-like, it is still "cylindrical" within the meaning of the term as it is used in the '194 patent.

Defendant also points to the prosecution history of the '194 patent to support its construction. Defendant notes that, at one point, the application for the '194 patent included a claim describing a cylindrical sleeve with a "tapered section," but this limitation was absent from the patented claims. See Aff. of Jeffrey Morgan, dkt. #94, exh. #2, at 89-90 (July 21, 2000 Preliminary Amendment, at claim 11). Although accurate, this observation does little to further defendant's position. It does not follow from the absence of a *requirement* for a tapered cylindrical sleeve that the '194 patent *prohibits* a tapered sleeve. Without any language in the claims limiting the cylindrical sleeve to one that is non-tapered, I cannot infer such a limitation, particularly when one of the preferred embodiments includes a tapered cylindrical sleeve. See Pat. '194, col. 9, lines 30-32 ("As shown in Fig. 9,

the connector body or cylindrical body member wall tapers as at 145 to facilitate the generally radial movement of the connector body.")

Plaintiff defines "cylindrical sleeve" as "the portion of the connector body that is not in contact with the tubular post," but this definition has potential problems as well. Plaintiff points to the specification's description of the second preferred embodiment (Fig. 7), which provides: "The inner surface of connector body 124 includes a cylindrical sleeve which is radially spaced from post member 126 to define a first outer cavity 138 at a first end accessible via opening 140." Pat. '194, col. 9, lines 10-15. However, this definition does not match the one provided by plaintiff. The specification states that the *inner surface* of the connector body includes a cylindrical sleeve; plaintiff's definition of cylindrical sleeve includes both the inner and outer wall of the connector body.

To complicate matters further, there is another definition of "cylindrical sleeve" suggested in the description of the first embodiment (Fig. 1): "the inner surface or inner wall of the connector body 24 or the cylindrical sleeve." Pat. '194, col. 7, line 5-6. Again, this description suggests that the cylindrical sleeve includes only the inner wall of the cylindrical body member. (The patent uses the terms "cylindrical body member" and "connector body" interchangeably. See Pat. '194, col. 6, lines 48-50.) In addition, this definition suggests that the cylindrical sleeve encompasses the *entire* inner wall of the cylindrical body member and not just the portion of it that is "radially spaced" from the tubular post.

Despite these two descriptions in the specification, it is understandable that plaintiff would not limit its definition of "cylindrical sleeve" to include only the inner wall of the connector body. To do so would contradict the claims themselves, which disclose a cylindrical sleeve with both an "inner wall" *and* an "outer wall." However, the claims do not further define "cylindrical sleeve," with the exception that claims 1(c) and 2(c) state that the "first end" of the cylindrical body member "include[s]" the cylindrical sleeve.

Neither party addresses any of these apparent inconsistencies between the claims and the specification. Of course, to the extent that the specification contradicts the claims, it is the language in the claims that controls. See RF Delaware, Inc. v. Pacific Keystone Technologies, Inc., 326 F.3d 1255, 1265 (Fed. Cir. 2003) ("courts may not use the teaching of the specification to contradict the clear language of the claims"). If the definitions in the specification are rejected in favor of the claim language, this leaves unresolved the precise location of the cylindrical sleeve. However, this lack of certainty does not appear to be a problem for the purposes of this case. The central dispute between the parties regarding this term is whether the cylindrical sleeve may be tapered. I have concluded that the patent permits either a tapered or non-tapered cylindrical sleeve. The parties agree that the "cylindrical sleeve" includes at least the portion of the cylindrical body member that overlaps with the compression ring. Accordingly, I construe the term "cylindrical sleeve" as including "the portion of the cylindrical body member that is inside the compression ring when the

compression ring is fully installed." To the extent that the parties believe this definition is incomplete, they may seek to supplement it at trial.

I. Advanced Axially

Claims 1(e) and 2(e) disclose a compression ring that is "advanced axially" over the cylindrical body member. Using definitions from Webster's Third New International Dictionary for "advance" and "axial," defendant proposes a construction of the term "advanced axially" to mean "moved forward on or along an axis." Plaintiff does not deny that defendant's definition is an accurate reflection of the ordinary meaning of the phrase. However, plaintiff argues that the "'194 specification repeatedly teaches that the compression ring *slides* over the connector body." Plt.'s Cl. Constr. Reply Br., dkt. #113, at 16. Thus, plaintiff proposes a definition of "advancement along an axis by sliding."

Plaintiff's proposed construction fails because, again, it attempts to read in limitations from the specification that are not present in the claims. Plaintiff's own definition recognizes that sliding is *one* way "advancement along an axis can occur." Although the specification does discuss sliding, the patent does not *limit* the type of movement to sliding. Accordingly, I construe "advanced axially" to mean "moved forward on or along an axis."

II. VALIDITY

Under 35 U.S.C. § 282, all patents are entitled to a presumption of validity. In order to prevail, defendant must overcome this presumption by clear and convincing evidence. State Contracting & Engineering Corp. v. Condotte America, Inc., 346 F.3d 1057, 1063 (Fed. Cir. 2003). Whether a patent is void for anticipation is a question of fact. Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed. Cir. 1991). Therefore, a court may resolve the anticipation question on a motion for summary judgment only if a reasonable jury could reach but one conclusion. Condotte America, 346 F.3d at 1068.

In determining whether a claim is invalid for anticipation, one must ask whether a person skilled in the relevant art would reasonably understand or infer from the teaching of a prior art reference that every claim limitation was disclosed in that single reference. Akamai Technologies, Inc. v. Cable & Wireless Internet Services, Inc., 344 F.3d 1186, 1192 (Fed. Cir. 2003). It is not enough for defendant to show that plaintiff's and Holliday's inventions are substantially similar; a prior art reference does not anticipate an invention unless each limitation in the claim at issue "identically appear[s]" in an earlier reference. Gechter v. Davidson, 116 F.3d 1454, 1457 (Fed. Cir. 1997); see also C.R. Bard, Inc. v. M3 Systems, Inc.,157 F.3d 1340, 1360 (Fed. Cir. 1998) ("'Anticipation' requires that the identical invention was already known to others, that is, that the claimed invention is not

new.") A prior art reference may be found in a publication or in a patent. 35 U.S.C. § 102(a), (d) and (e).

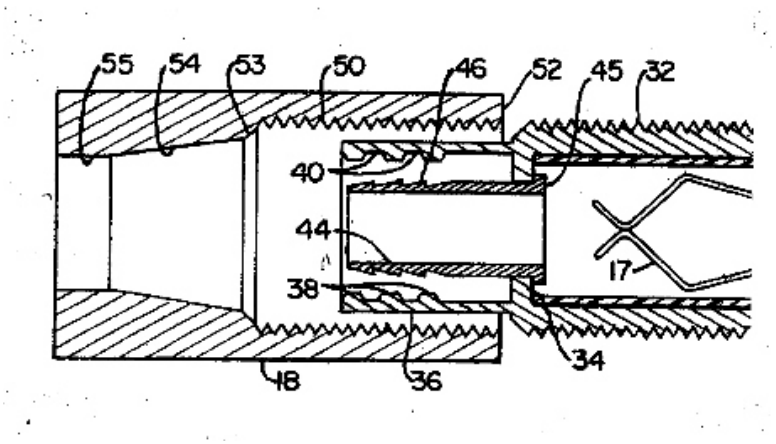
As has been noted often, there is a close connection between anticipation and infringement. The Supreme Court first noted in 1889, "That which infringes, if later, would anticipate, if earlier." Peters v. Active Manufacturing, 129 U.S. 530, 537 (1889). In other words, if under an infringement analysis Holliday would be liable to plaintiff, plaintiff's claims are anticipated by Holliday so long as the '220 patent is prior art to the '194 patent. See Brown v. 3M, 265 F.3d 1349, 1354 (Fed. Cir. 2001) ("because it would not infringe if later, it cannot anticipate though earlier").

The parties agree that the Holliday '220 patent is prior art to the '194 patent. See Plt.'s Resp. to Dft.'s Prop. Find. of Fact, dkt. #31, at ¶31. The parties agree also that the Holliday '220 patent discloses all of the limitations in parts (a),(b),(c) and (e) of both claims 1 and 2 in the '194 patent. Both inventions are coaxial cable connectors having a tubular post, a nut that rotatably engages the tubular post, a cylindrical body member and a compression ring with an inwardly tapered annular wall.

With respect to element (d) of claims 1 and 2 in the '194 patent, the parties dispute whether Holliday disclosed a "compression ring" with a first internal bore that is either "non-tapered" or has a "constant diameter." In addition, they dispute whether Holliday's invention discloses an "internal bore" and a compression ring with a diameter that is

"commensurate" with the diameter of the cylindrical sleeve.

The resolution of the first dispute appears to hinge at least in part on what portion of the Holliday invention constitutes a "compression ring" within the meaning of the '194 patent. Below is a drawing of Fig. 1 from the Holliday '220 patent, which focuses on the area of the connector in dispute.



Defendant contends that in this figure, all of 18 is part of the compression ring, including both the threaded portion 50 and the tapered portions 53, 54 and 55. Plaintiff argues that the compression ring consists of the tapered portions 53, 54 and 55 only. If defendant is correct, the first internal bore of the compression ring in Holliday's invention would be threaded and thus "non-tapered." However, if plaintiff is correct, the first internal bore of Holliday's compression ring would be tapered and thus distinct from both claims 1 and 2 of the '194 patent.

The Holliday '220 patent does not use the term "compression ring." Rather, it uses the term "splicing device" for what is labeled 18 in figure 1. The claims in the Holliday '220 patent employ yet another term, "crimping member." The Holliday patent does not use separate terms for the tapered and threaded portions of the device.

As noted above, the patent examiner for the '194 patent was aware of and considered the Holliday '220 patent when she allowed what are now claims 1 and 2 of the '194 patent. In such a case, there is an increased burden on the defendant alleging invalidity. McGinley v. Franklin Sports, 262 F.3d 1339, 1353 (Fed. Cir. 2001); American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1359 (Fed.Cir.1984) (examiners "are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents").

In concluding that claims 1 and 2 were patentable, the examiner wrote that the prior art did not disclose a compression ring with a first "non-tapered" internal bore or first "constant diameter" internal bore. Unfortunately, the examiner did not explain her reasoning in coming to this conclusion. Plaintiff argues that her conclusion is based on a view that the compression ring in the Holliday invention did not include the threaded portion of the "splicing device." In support, plaintiff points to the November 13, 2001 office action. In that communication, the examiner wrote, "It is noted that the threaded portion to the right of the compression ring is seen to be an attachment part of the splicing

device and not a part of the compression ring." See Aff. of Jeffrey Morgan, dkt. #94, exh. #2, at 235 (November 13, 2001 Office Action).

Surprisingly, neither party in this case proposed a construction of the term "compression ring." However, the examiner's view is reasonable. The threaded portion of the splicing device in Holliday's invention does not actually compress anything; it attaches by interlocking with the cylindrical body member. It is only the tapered portion of the splicing device that compresses or "deform[s]" the cylindrical sleeve. Although defendant appears to disagree with the examiner's view, it provides no evidence or argument to support an alternative view.

Defendant makes a half-hearted attempt at the end of its brief to argue that the patent examiner's decision should not be followed because the applicant for the '194 patent made false representations to the examiner regarding the prior art. However, defendant's discussion on this point consists entirely of conclusory assertions that the applicant knew that the Holliday '220 patent disclosed an internal bore that was "non-tapered" and had a "constant diameter." Again, defendant does not explain why the examiner's contrary interpretation of the Holliday patent was incorrect, much less present any evidence that plaintiff was intentionally misleading the examiner.

In short, defendant has failed to meet its burden in showing that the examiner's conclusion was erroneous. If the compression ring of the Holliday invention includes only

the tapered portion of the splicing device, the first internal bore of the compression ring would not be "non-tapered" and it would not have a "constant diameter." The absence of these limitations in the Holliday invention would defeat an argument that Holliday anticipated the '194 patent. It is therefore unnecessary to consider whether the '194 patent includes any other limitations not disclosed in the Holliday '220 patent. Defendant's motion for summary judgment will be denied.

ORDER

IT IS ORDERED that the claims of plaintiff John Mezzalingua Associates, Inc. d/b/a PPC, Inc.'s U.S. Patent No. 6,558,194 are construed as follows:

1. The term "rotatably engaging" means "holding the tubular post fast in place, while allowing the tube to rotate."

2. The term "proximate" means "very near."

3. The term "commensurate" means "large enough to extend over the cylindrical sleeve while compressing the deformable rear end portion of the cylindrical sleeve."

4. The term "internal bore" includes an "internally threaded bore."

5. The term "non-tapered internal bore" means "a bore that does not gradually diminish in one direction, subject to the inherent limitations of the materials and processes used in the manufacture of the compression ring."

6. The term "constant diameter internal bore" means "a bore with a diameter that does not vary, subject to the inherent limitations of the materials and processes used in the manufacture of the compression ring."

7. The term "end" means "concluding part."

8.The term "rear end portion" means "the portion of the cylindrical sleeve beginning at the sleeve's rear extreme edge or tip and comprising at least the portion of the cylindrical sleeve that is deformable."

9. The term "cylindrical sleeve" includes "the portion of the cylindrical body member that is inside the compression ring when the compression ring is fully installed."

10. The term "advanced axially" means "moved forward on or along an axis."

IT IS FURTHER ORDERED that defendant Arris International's motion for summary judgment is DENIED.

Entered this 14th day of November, 2003.

BY THE COURT:

BARBARA B. CRABB
District Judge