

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF WISCONSIN

FRANKLIN ELECTRIC CO., INC.,

Plaintiff,

v.

DOVER CORPORATION,
d/b/a OPW FUELING COMPONENTS

Defendant.

MEMORANDUM AND ORDER
05-C-598-S

Plaintiff Franklin Electric Co., Inc. commenced this patent infringement action alleging that defendant Dover Corporation manufactures and sells fuel tank components which infringe its United States Patents Nos. 5,085,257 ('257 patent) and 6,840,549 B1 ('549 patent). Jurisdiction is based on 28 U.S.C. § 1338. The matter is presently before the Court on defendant's motion for summary judgment of non-infringement. Also pending are defendant's alternative motion for judgment on its anticipation defense to the '549 infringement claim and plaintiff's motion for summary judgment on defendant's inequitable conduct defense. The following is a summary of relevant undisputed facts.

FACTS

The patents in suit are directed to components which attach to riser pipes from underground fuel storage tanks and facilitate

filling the tanks while protecting against spills and water infiltration. The '549 patent claims an adapter which threads onto the top of a riser pipe creating a liquid tight seal between the riser pipe and the structure which attaches above it. The '257 patent claims a containment assembly which attaches to the top of a containment sump surrounding the riser pipes and protects against spills during the filling process and water infiltration into the system. Defendant manufactures and sells components which perform functions similar to those of the patented devices. Following is a more detailed discussion of the patents in suit and the accused devices.

The '549 Patent

The '549 patent includes two claims, claim 1 being the only independent claim:

1. In combination:

a hollow riser leading to an underground liquid storage tank, said riser having a riser liquid passageway, an externally threaded upper riser end with external tapered threads and an upper rim defining a riser opening communicating with said riser liquid passageway;

a structure disposed above said riser, said structure defining a structure interior and having a lower, open structure end communicating with said structure interior, said structure further having internal straight pipe threads, extending upwardly from said lower, open structure end and terminating at an inwardly projecting shoulder of said structure.

An annular seal in fluid-tight engagement with said inwardly projecting shoulder above the internal straight pipe threads of said structure; and

a threaded riser adaptor of integral construction having an upper externally threaded riser adaptor portion including external straight pipe threads in threaded engagement with the internal straight pipe threads of said structure and forming a first liquid-tight seal therewith and a lower internally threaded riser adaptor portion including internal tapered threads receiving the external tapered threads of said externally threaded upper riser end and securing the threaded riser adaptor to said riser, said threaded riser adaptor defining a riser adaptor liquid passageway communicating with both the riser liquid passageway and the structure interior to allow the flow of liquid therebetween, and the external tapered threads of said externally threaded upper riser end and the internal tapered threads of said lower internally threaded riser adaptor portion being in fluid-tight engagement and forming a second liquid-tight seal therebetween without the upper rim of the riser abutting against the threaded riser adaptor, said upper externally threaded riser adaptor portion having a distal end surrounding the riser adaptor liquid passageway, said distal end being circular-shaped and having a smooth bearing surface bearing against said annular seal and in fluid-tight relationship therewith, said threaded riser adaptor and seal cooperable to maintain a fluid-tight interconnection between said riser and said structure even if the riser is damaged or irregular at or closely adjacent to the rim thereof.

Figure 2 of the '549 patent depicts a preferred embodiment of the claimed invention:

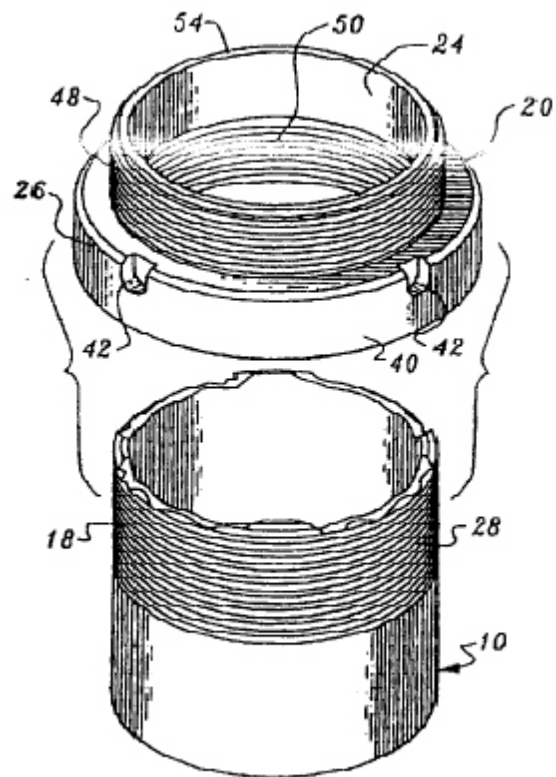


Fig. 2

Figure 5A shows the relationship between the adapter and the structure with which it is sealed in a preferred embodiment employing a seal.

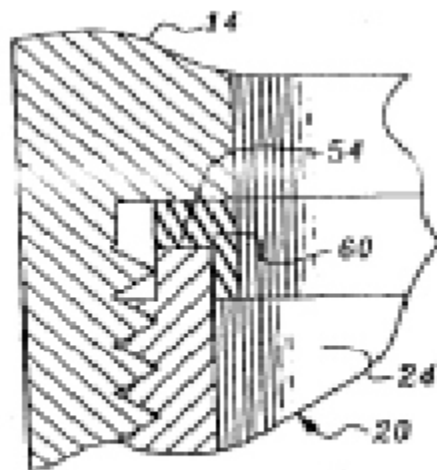


Fig. 5A

The specification describes the threading arrangement of the upper portion of the adapter and its relationship with the structure above it:

The threaded riser adaptor has an upper externally threaded riser adaptor portion 24 for threaded engagement with internal threads of structure 14 with the upper end of the adaptor forming a liquid-tight seal with the structure. The threads of the upper externally threaded riser adaptor portion are straight pipe threads corresponding to straight internal pipe threads of the structure.

* * *

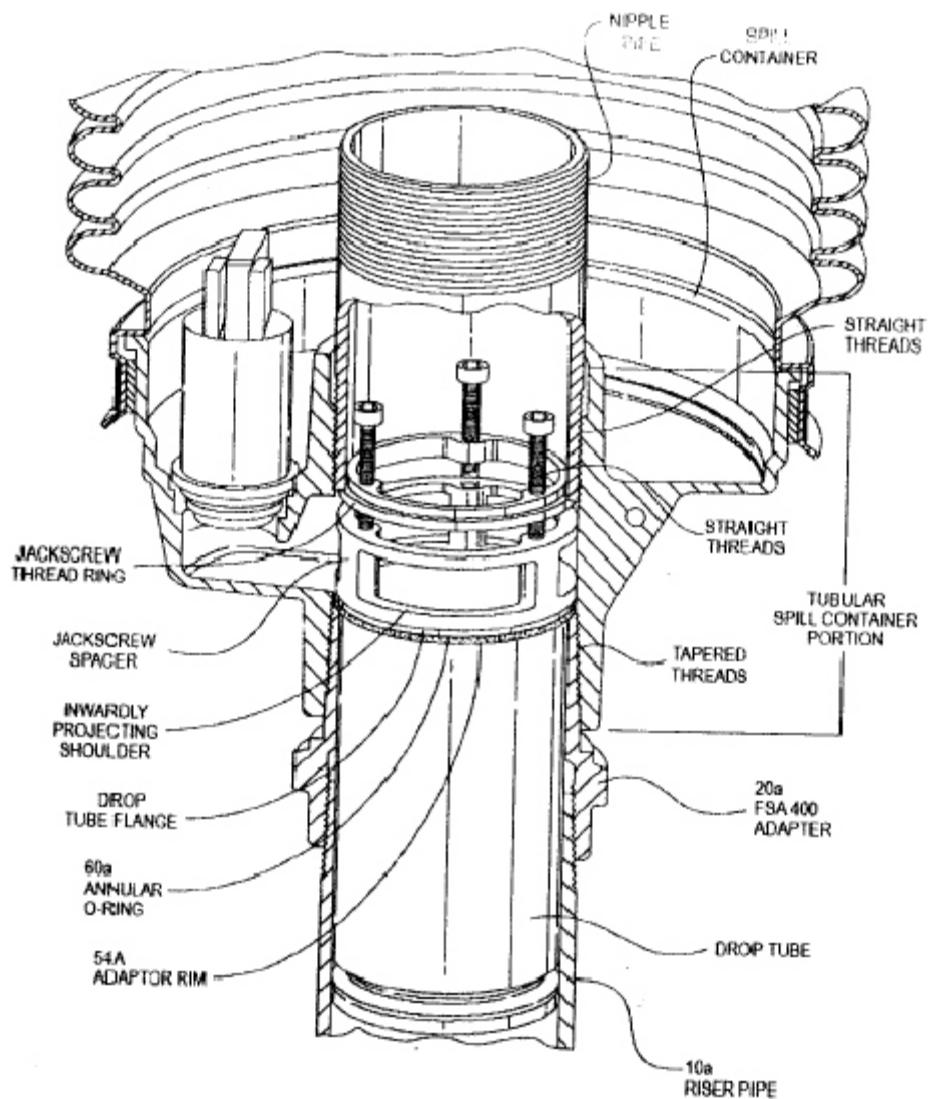
The distal end or rim 54 of the upper externally threaded riser adaptor portion 24 surrounds the liquid passageway 30, the distal end 54 being circular-shaped and having a smooth bearing surface for cooperation with structure 14 to form the liquid-tight seal between the upper externally threaded riser adaptor portion and the structure.

If desired, an O-ring such as O-ring 60 in FIG. 5A may be employed between the distal end 54 and the structure 14. However, direct engagement between the distal end 54 and the structure 14, as shown in FIG. 5B, can also result in creation of a fluid-tight seal.

Defendant's Riser Adapter

Defendant manufactures and sells a riser adapter the upper portion of which includes external tapered threads, designed to engage with internally tapered threads of the structure above it. The tapered threads of the two components form a liquid tight seal between the riser and the structure. In defendant's configuration a second liquid tight seal is formed between the upper distal end

of the adapter and the flange of a drop tube which is inserted into the riser. A liquid tight seal is accomplished by placing an o-ring between the tube flange and the upper end of the adapter and exerting downward pressure by tightening the bolts of a jack screw mechanism. The illustration below accurately depicts defendant's riser adapter as employed with other components of the filling and containment system.



OPW ADAPTOR ASSEMBLY

The '257 Patent

The '257 patent claims a sump cover containment assembly which protects surrounding soil from contamination during the filling and evacuating of underground petroleum storage tanks and prevents water from entering to avoid contamination of the tank contents.

Claim 1 is the only independent claim:

1. A sump cover containment assembly for use with a containment sump which has a top end with a hole therein, comprising:

- a substantially hollow frame having an open top end and an open bottom end sized, shaped and oriented so that said bottom end fits around said top end of said containment sump;

- a sump cover positionable over said top end of said frame, having at least one downward extension and at least one access hole extending through said at least one downward extension, said at least one access hole being of proper size, shape and orientation to facilitate positioning of a spill collector therein;

- a lid for covering each of said at least one access holes in said sump cover;

- first sealing means for sealing said lid to said sump cover;

- second sealing means for sealing said sump cover to said frame to minimize intrusion of surface water into said substantially hollow frame; and

- a sump shield substantially covering said top end of said containment sump, having a downward lip which extends downward about said containment sump between said frame and said containment sump, and an upward extension having a hole therein sized, shaped and oriented to mate with said at least one downward extension of said sump cover and to facilitate positioning of said spill collector therein.

Figure 7 of the '257 patent depicts a preferred embodiment of the invention.

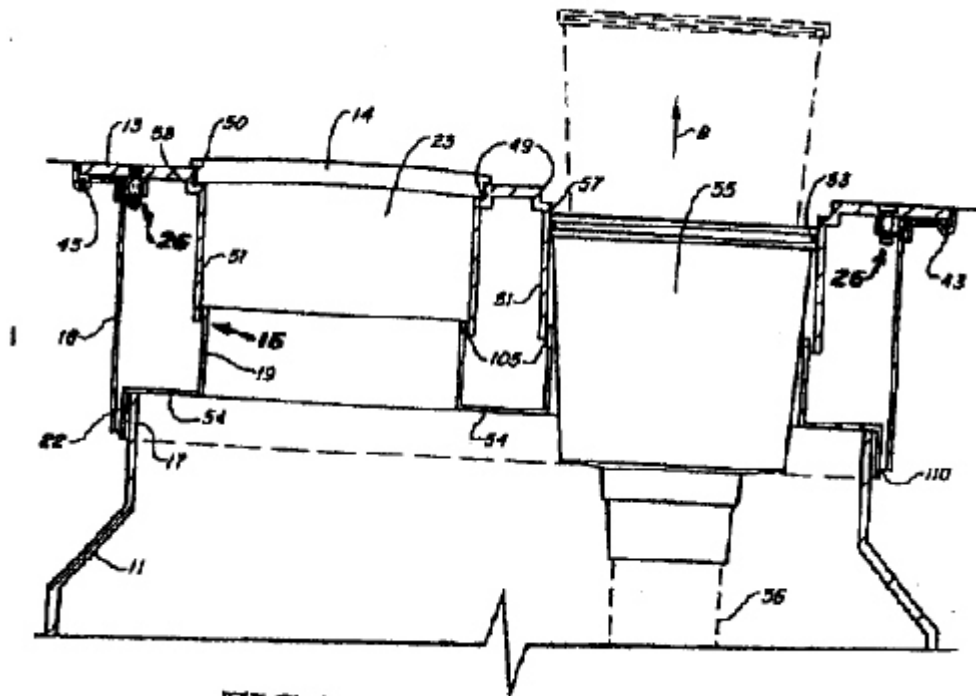


FIG. 7

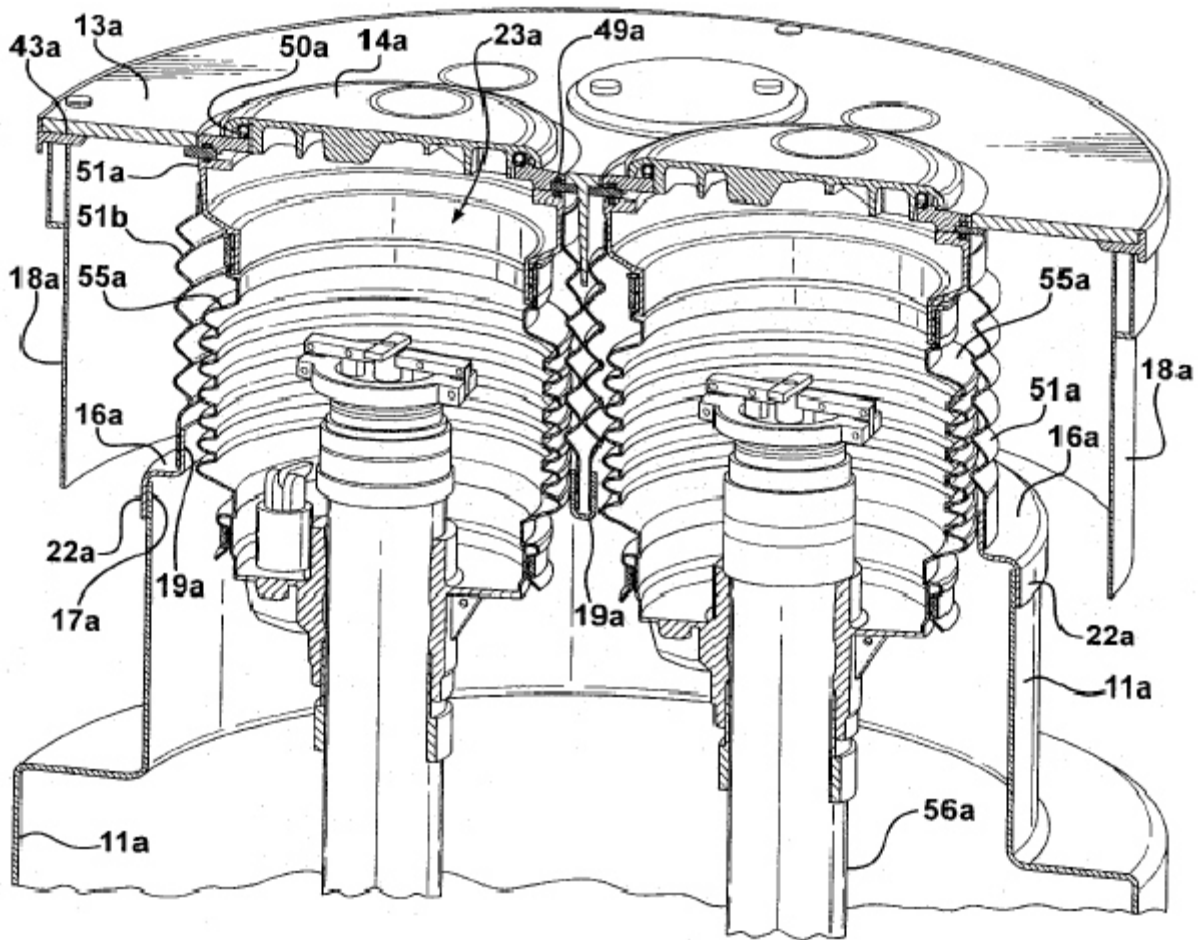
The patent application which ultimately led to the issuance of the '255 patent was initially rejected in its entirety by the examiner as obvious. To overcome the rejection certain amendments were made to claim 1 including the addition of the phrase "to facilitate positioning of a spill collector therein" in two places. The remarks accompanying the amendment included the following:

Claim 1 has been amended to include further clarifying and limiting language which clearly distinguishes claim 1 as amended from the prior art of record. More specifically, claim

1 now includes clarification of the sump cover as accepting a spill collector in one of its downward extensions, as well as clarification of the sump shield as substantially covering the top end of the containment sump while accepting a spill collector in one of its upward extensions.... Thus, the containment assembly of amended claim 1 is capable of much more than is the prior art of record. It acts as a housing for containing and supporting a spill collector, as well as acting as a secondary containment system which facilitates access for maintaining a spill collector utilized therewith. Thus, the spill collector no longer needs to be concreted into the ground as was previously required.

Defendant's Containment Assembly

Defendant manufactures and sells a containment system which attaches to the top of a sump above an underground fuel tank. The system includes a composite or metal tray which is attached to an adapter on the riser. A metal ring attaches a bellows-like spill container made of molded plastic to the tray. The spill container extends upward and connects to a second metal ring which is attached to the sump cover. A second, optional, soft pliable bellows-like boot called the water shroud boot can be placed over the spill container. It is attached at the top to the same metal ring used to attach the spill container and at the bottom to a cover that is placed over the sump called the water shroud. The diagram below accurately depicts the defendant's accused containment assembly:



OPW MULTI-PORT (MPWS)

MEMORANDUM

Summary judgment is appropriate when, after both parties have the opportunity to submit evidence in support of their respective positions and the Court has reviewed such evidence in the light most favorable to the nonmovant, there remains no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. Rule 56(c), Fed. R. Civ. P. A fact is material

only if it might affect the outcome of the suit under the governing law. Disputes over unnecessary or irrelevant facts will not preclude summary judgment. A factual issue is genuine only if the evidence is such that a reasonable factfinder, applying the appropriate evidentiary standard of proof, could return a verdict for the nonmoving party. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 254 (1986). Under Rule 56(e) it is the obligation of the nonmoving party to set forth specific facts showing that there is a genuine issue for trial.

Patent infringement analysis consists of two steps. First, the patent claims must be interpreted or construed to determine their meaning and scope. Second, the properly construed claims are compared to the process or product accused of infringing. Markman v. Westview Instruments, Inc., 52 F.3d 967, 976 (Fed. Cir. 1995). The first step of this analysis, claim construction, is a matter of law exclusively for the court. Id. at 970-71. To establish infringement plaintiff must prove that each claim element is present in the accused product, either literally or by equivalence. Dawn Equipment Co. v. Kentucky Farms Inc., 140 F.3d 1009, 1015 (Fed. Cir. 1998). Conversely, defendant can prevail by demonstrating that at least one element of the asserted claim is absent in their product or process.

The well established process for claim construction begins with examination of the claims language. The language is given its

ordinary meaning as it would be understood by one of ordinary skill in the relevant art, given its context and the other patent claims. Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342 (Fed. Cir. 2001). This initial construction is then considered in light of the specification to determine whether the inventor expressed a different meaning for the language, whether the preferred embodiment is consistent with the initial interpretation and whether the inventor specifically disclaimed certain subject matter. Id. at 1342-43. The specification takes on a more important role if the claims language is particularly ambiguous, id., or if the inventor invoked the means plus function language of 35 U.S.C. § 112, ¶ 6 thereby incorporating the specification's embodiment into the claims by reference. Finally, the interpretation is examined for consistency with the patent's prosecution history and any disclaimers made therein. 274 F.3d at 1343.

Assuming one or more elements is literally absent from the accused device, it must be determined whether the device infringes under the doctrine of equivalents. The Supreme Court offered the following guidance for assessing whether an element is present by equivalents:

Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention? ... A focus on individual elements and a special vigilance against allowing the concept of equivalence to eliminate completely any such

elements should reduce considerably the imprecision of whatever language is used. An analysis of the role played by each element in the context of the specific patent claim will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element.

Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 40 (1997).

Infringement - The '549 Patent

Plaintiff concedes that defendant's adapter does not literally infringe the '549 patent. The patent includes the element of "upper externally threaded riser adapter portion including external straight pipe threads in threaded engagement with the internal straight pipe threads of said structure and forming a first liquid tight seal therewith..." Defendant's riser adapter has tapered external pipe threads which engage with the tapered internal threads of the structure. The straight pipe threads element is absent from defendant's product and therefore there is no literal infringement.¹

In an effort to salvage its claim of infringement of the '549 patent plaintiff makes two preposterous arguments. First, that

¹Because the straight pipe thread element is so obviously lacking in the accused device the Court does not address the defendant's arguments that several other '549 claim 1 elements are also absent.

defendant's combination of the o-ring, drop tube and jack screw mechanism is the equivalent of the patent claim element of an external straight pipe thread mating with the internal straight pipe threads of the structure. Second, that even though defendant's product does not infringe, its advertisements make it appear that the product infringes so defendant is offering an infringing product for sale.

Considering first the doctrine of equivalents issue, the question is whether the defendant's device includes "a substitute element [that] matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element." 520 U.S. at 40. The devices are so dissimilar that it is difficult even to identify the "substitute element." Plaintiff summarizes its position as follows: "[Defendant] used straight threads and a shoulder to form a seal at the upper rim. It just used straight threads and the shoulder on the jack screw." opposition brief at 28. Apparently the argument is that the entire jack screw mechanism with its three bolts (which have straight threads) is a substitute for straight pipe threads driving the end of the adapter into a fixed stop. The only similarity between those two appears to be that both form a compression seal at the upper end of the riser adapter, arguably achieving the same result. But such a focus on the end result of

the device as a whole is directly contrary to Warner-Jenkinson's admonishment to focus separately on each element.

Even if it could be argued that the jack screw achieves the "result" of a compression seal with the upper riser adapter end the seal and the jack screw perform a different function and do so in a strikingly different way than the patented invention. The function of the mated straight pipe threads of the patent claims is to establish a liquid tight seal between the adapter and the structure. col. 2, ln. 46. In defendant's device, that function is performed by the tapered external pipe threads of the upper adapter which form a liquid tight seal with the tapered internal threads of the structure. In defendant's device a second seal is formed between the drop tube flange (which is not present at all in the patented device) and the upper end of the adapter. Accordingly, the seal formed with the jack screw mechanism does not perform the function of creating a liquid tight barrier between the structure and the adapter.

The "way" in which the seal is achieved is also very different. The patented device achieves its seal by simply threading the riser adapter into the structure until the adapter end is compressed against the structure. Defendant's device uses a relatively elaborate combination of parts to drive a non-fixed component downward by tightening three bolts. The fact that the bolts have straight threads is certainly not sufficient to suggest

that the ways the seals are established the same. Defendant's accused device certainly lacks an "upper externally threaded riser adapter portion including external straight pipe threads" or any equivalent of that element of claim 1 of the '549 patent. Accordingly, its device does not infringe.

Plaintiff's second argument, that even if the device does not infringe, one of ordinary skill in the art might believe that it does based on advertising, requires little discussion. Whether a defendant "makes, uses, offers to sell, or sells," 35 U.S.C. § 271(a), infringement is judged by whether the product itself infringes, not by whether it would infringe if it conformed to some representation made in attempting to sell it. In the absence of an accused product the comparison necessary to assess infringement cannot be performed. Bringing an infringement claim based on advertising alone may constitute sanctionable conduct if the advertised device does not infringe. View Engineering, Inc. V. Robotic Vision Systems, Inc., 208 F.3d 981 (Fed. Cir. 2000). The fact that those of skill in the art might disagree on what product features are represented by an advertisement does not create a material factual dispute whether that product infringes.

Infringement - The '257 Patent

Defendant contends that several '257 claim 1 elements are absent from its accused containment system. Among these contested

elements are the requirements that the downward extension of the sump cover extension and the upward extension of the sump shield "facilitate positioning" of the spill collector. There is no genuine dispute concerning the relationship between the spill collector and the water shroud boot in defendant's device. Accordingly, whether the water shroud boot "facilitates positioning" of the spill collector is exclusively an issue of patent construction which must be resolved as a matter of law. Markman, 53 F.3d at 979.

Beginning with the claim language, the ordinary meaning of the word "facilitate" is to make easier or to assist. Accordingly, unless some other meaning is typical in the art or the inventor evidences an intent to use it differently the upward and downward extensions must assist in positioning the spill collector. The context in which the language is used in the claim itself confirms this meaning: requiring that the opening within the downward extension be "of proper size, shape and orientation to facilitate positioning of a spill collector therein." The language is consistent with the apparent intent of the inventor that the internal surface of the downward extension assist in positioning the spill collector. The claim language similarly requires that the hole in the upward extension be "sized, shaped and oriented to mate with said at least downward extension of said sump cover and to facilitate positioning of said spill collector therein." The

context confirms that the inventor intended the opening formed by the mated extensions play a role in positioning the spill collector.

The specification, particularly Figure 7, confirms that the inventor intended the extensions to physically assist in the positioning of the spill collector. Figure 7, which is the only depicted embodiment illustrates that the spill collector is inserted into the space formed by the mated extensions where it contacts and is held in position by both the upward and downward extensions. This is consistent with the claim requirement that both extensions facilitate positioning. The related specification language confirms the construction, specifying an o-ring to form a seal where the spill collector contacts the downward extension:

A spill collector 55 ... may be positioned as shown and removed along arrow B. When properly positioned, spill collector communicates with pipe 56 to fill gas tank 12. Such a device includes sealing means 53 such as an o-ring, which prevents intrusion of groundwater between the perimeter thereof and downward extending sleeve 51.

'257 patent col. 4, ln. 61-68. See also col. 5, ln. 15-19.

The inventor used similar language to mean the same thing in a different context at column 5, lines 30-32 in describing the relationship between the sump and the sump shield which rests on it: "Such positioning allows frame 18 to overlap extension 17 of containment sump 11 and facilitates proper positioning of sump shield 16 to effectively eliminate water intrusion into containment

sump 11." As illustrated by figure 7 to which the language refers, "positioning" is "facilitated" by physical contact between the frame, sump and shield in identical manner to the way positioning is facilitated by physical contact between upward extension, downward extension and spill collector.

Examination of the prosecution history further confirms that this meaning was exactly what the inventor intended. It is important to note that the claim language in dispute was not in the original application but was added as an additional limitation to overcome the examiner's rejection based on obviousness. The primary purpose of the additional language was to add a limitation concerning the interaction of the previously claimed features and a spill collector. The argument in support of allowance that the containment assembly "acts as a housing for containing and supporting a spill collector" which would eliminate the prior art need that the collector "be concreted into the ground" leaves no doubt that the limitation was intended to require physical communication between the spill collector and the extensions and that contact between the extensions and the spill collector was a basis on which the device was distinguished from the prior art in order to obtain allowance from the examiner.

Plaintiff's proffered construction, that the term "facilitate positioning" means only that the opening be large enough to "allow" a spill collector to be positioned in the hole fails on every

level. First, the word "facilitate" means more than to "allow," it means to make easier or assist. Second, the only embodiment in the specification shows the extensions physically assisting in the positioning of the collector. Third, the inventor expressly disavowed such a broad interpretation by arguing that the invention required the extensions to facilitate positioning by acting as a housing and support for the spill collector and that this limitation distinguished the invention from the prior art.

There is no question that the claim element requiring the upward and downward extensions to "facilitate positioning" of the spill collector is absent from the accused product. The optional water shroud boot of defendant's containment system is the structure analogous to the mated upward and downward extensions of claim 1.² However, the water shroud boot plays absolutely no role in positioning the spill collector. The water shroud boot is optional and need not be present on the device. When it is included in defendant's containment system it is added only after the spill collector has been fully positioned and installed. It is soft and pliable and does not come into contact with the spill collector. There is no reasonable sense in which the water shroud boot could be said to assist in the positioning of a spill collector. Its presence or absence is irrelevant to the

²the Court makes no finding concerning whether the water shroud boot embodies these additional elements.

positioning of a spill collector. Because defendant's device lacks this element of the only independent claim of the '257 patent its accused containment system does not infringe and it is entitled to summary judgment.

CONCLUSION

Defendant's accused riser pipe adapter and containment systems lack at least one element of the only independent claims of the '549 and '257 patents. Accordingly, defendant is entitled to summary judgment of non-infringement. There is no reason to address the pending motions concerning the defenses of anticipation and inequitable conduct.

ORDER

IT IS ORDERED that defendant's motion for summary judgment is GRANTED.

IT IS FURTHER ORDERED THAT judgment be entered dismissing plaintiff's complaint with prejudice and costs.

Entered this 4th day of May, 2006 .

BY THE COURT:
S/

JOHN C. SHABAZ
District Judge