United States District Court,
D. Oregon.

Raymond Keith FOSTER, Keith Mfg. Co., Inc., and Keith Sales Co,
Plaintiffs.
v.
HALLCO MANUFACTURING CO., INC., and Olof A. Hallstrom,
Defendants.

Civ. Nos. 88-959-JU, 89-161-JU

Jan. 11, 1991.

Martin Sharp, Gresham, Or., Delbert J. Barnard, Barnard, Pauly & Kaser, P.S., Seattle, Wash., for plaintiffs.

J. Pierre Kolisch, Peter E. Heuser, David A. Fanning, Kolisch, Hartwell & Dickinson, Portland, Or., for defendants.

OPINION

FRYE**, District Judge:**

The matter before the court is the objections of defendants Hallco Manufacturing Co., Inc. and Olof A. Hallstrom (collectively "Hallco"), to the Findings and Recommendation of the Honorable George E. Juba, United States Magistrate, issued on September 11, 1990.

BACKGROUND

Plaintiffs, Raymond Keith Foster, Keith Mfg. Co., Inc., and Keith Sales Co. (collectively "Foster"), manufacture and sell a reciprocating floor conveyer known as the Running Floor II. Hallco also manufactures and sells a reciprocating floor conveyor under U.S. Patent No. 4,184,587 (patent '587), which is held by Hallstrom. Hallstrom alleges that the Running Floor II, manufactured and sold by Foster, infringes claims 1 and 2 of patent '587. Judge Juba, finding that there was no infringement of claims 1 and 2 of patent '587, recommends that this court grant summary judgment in favor of Foster. Hallco objects to Judge Juba's Findings and Recommendation.

APPLICABLE STANDARD

This matter is before the court pursuant to 28 U.S.C. s. 636(b)(1)(B) and Fed.R.Civ.P. 72(b). When either party objects to any portion of a magistrate's Findings and Recommendation, the district court must make a *de novo* determination of that portion of the magistrate's report. 28 U.S.C. s. 636(b)(1); McDonnell Douglas Corp. v. Commodore Business Machines, Inc., 656 F.2d 1309, 1313 (9th Cir.1981), *cert. denied,* 455 U.S. 920 (1982).

ANALYSIS AND RULING

Hallco raises five objections to the Findings and Recommendation of Judge Juba. The court will address these objections.

1. ***Interpretation of the term "main frame" in claims 1 and 2.***

Claim 1 of patent '587 is for a modular slat drive unit for use "with an elongated main conveyor frame having longitudinal side beams and longitudinally spaced transverse beams and a plurality of elongated conveyor slats of substantially the same length as the main frame." Findings and Recommendation, p. 5.

Hallco argues that Judge Juba limited the meaning of "main frame" in claims 1 and 2 of patent '587 to the preferred embodiment shown in the drawings of patent '587, and that if this court agrees with Judge Juba, the only device that could infringe patent '587 is one which is identical to the preferred embodiment. Hallco contends that any frame having longitudinal side beams and longitudinally spaced, transverse beams infringes claims 1 and 2 of patent '587.

Foster argues that Judge Juba did not limit the meaning of "main frame" in claims 1 and 2 of patent '587 by reference *solely* to the preferred embodiment. Foster contends that Judge Juba first construed claims 1 and 2 of the patent in light of the language of the claims, the prosecution history of the claims, and the specifications of the claims, and then applied claims 1 and 2 to Foster's Running Floor II conveyor and concluded that there was no infringement.

The court finds that Judge Juba properly construed and interpreted claims 1 and 2 of patent '587 in determining the meaning of the term "main frame." The court adopts the Findings and Recommendation of Judge Juba on this issue.

2. ***Failure to address whether the accused device has a structural equivalent to the claimed attachment means.***

Hallco argues that Judge Juba failed to determine whether the attachment means of Foster's Running Floor II is the structural equivalent to the claimed attachment means of patent '587 as required by 35 U.S.C. s. 112.

Foster contends that it was not necessary for Judge Juba to reach the issue of whether the attachment means of its device is structurally equivalent to the attachment means of Hallco's device under 35 U.S.C. s. 112 because Judge Juba found that the second function of the attachment means of the claimed device was not performed by any structure in the Running Floor II conveyor.

The element of "means" in a claim is the disclosed structure for performing the exact same function. Judge Juba concluded that the only disclosed structure corresponding to the attachment means claimed by patent '587 was an angle iron, bolt and weld structure that connects the side portions of the framework to the side beams of the main frame. A claimed function of the "attachment means" was to incorporate the unitary framework into a portion of the main frame. Judge Juba found that Foster's Running Floor II does not incorporate a unitary framework into a main frame. He, therefore, concluded that the Running Floor II did not include any type of attachment means for performing the claimed incorporating function. The court adopts the Findings and Recommendation of Judge Juba on this issue.

3. ***Did Judge Juba improperly read additional limitations into the claims when he required the attachment means to connect to a side beam of the main frame and required a physical connection between the main frame and the unitary framework?***

The court adopts the finding of Judge Juba that in light of the disclosed structure and the file history, the attachment means in patent '587 must connect to a side beam of the main frame and that there must be a physical connection between the main frame and the unitary framework.

4. ***Are there factual issues which preclude summary judgment?***

Claim interpretation is a question of law for the court. SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1118 (Fed.Cir.1985). Although disputed factual issues may require extrinsic evidence and thus preclude the entry of summary judgment, the facts relating to the construction of the conveyor of Foster's Running Floor II are undisputed, and Hallco has produced no probative evidence that creates a question of fact as to the interpretation of the claims of patent '587.

5. ***Did Judge Juba improperly apply the doctrine of equivalents?***

If an accused device does not literally infringe a patent, it can infringe under the doctrine of equivalents. To infringe under the doctrine of equivalents, "the claimed invention [must] perform substantially the same function in substantially the same way to give substantially the same result." Locite Corp. v. Ultraseal Ltd., 781 F.2d 861, 869 (Fed.Cir.1985).

Judge Juba found two exceptions to the doctrine of equivalents which prevent the application of the doctrine of equivalents to the Running Floor II. First, the doctrine of equivalents does not apply when an element essential to the claim has been omitted. Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 935 (Fed.Cir.1987), *cert. denied,* 485 U.S. 961; 485 U.S. 1009 (1988). Judge Juba found that Hallco had omitted several elements essential to the claim, thus precluding application of the doctrine of equivalents. Second, the doctrine of equivalents is not applicable when claims are amended to overcome a prior art rejection and claims of a broader scope are surrendered. Judge Juba found that amendments that Hallstrom was required to make to its claims in order to overcome objections raised by the examiner relating to prior art constituted a surrender of claims of a broader scope. In light of the amendments that Hallco had made, Judge Juba found that Hallco could not now use the doctrine of equivalents to recapture the claims which it had been forced to surrender. This court agrees and adopts the Findings and Recommendation of Judge Juba on this issue.

CONCLUSION

The court adopts the Findings and Recommendation of Judge Juba in its entirety. Foster's motion for summary judgment (# 195) is granted.

ORDER

IT IS HEREBY ORDERED that the Findings and Recommendation of the Honorable George E. Juba, United States Magistate, of September 11, 1990 is adopted by this court in its entirety. Plaintiffs' motion for summary judgment (# 195) is granted.

D.Or.,1991.

Foster v. Hallco Mfg. Co., Inc.

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