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UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF CALIFORNIA

ADVANCED STEEL RECOVERY, LLC,

Plaintiff/Counter-defendant,

v.

X-BODY EQUIPMENT, INC., JEWELL
ATTACHMENTS, LLC, J.D.M.L., INC.
dba STANDARD INDUSTRIES, and
ALLSTATE PAPER & METAL
RECYCLING CO., INC.,

Defendants/Counterclaimants.

No. 2:16-cv-00148-KJM-EFB

ORDER

Plaintiff Advanced Steel Recovery (ASR) sues defendants X-Body Equipment, Inc. and Jewell Attachments, LLC,¹ alleging defendants' "Acculoader" product infringes ASR's patent. On February 1, 2018, the court conducted a hearing in accordance with *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). Mark Nielsen and C. Wood Pak appeared for ASR, and Robert Harkins appeared for defendants. Through this order, based on the entirety of the record before it, the court construes the disputed words and phrases found in claims 1, 4, 5 and 7 of the patent-in-suit, U.S. Patent No. 9,056,731 (the '731 Patent).

¹ ASR also sues Standard Industries and Allstate Paper & Metal Recycling Co., but these parties have been independently severed from the present case, and proceedings have been stayed with respect to both Standard and Allstate. ECF No. 23.

1 I. BACKGROUND

2 A. First Amended Complaint

3 On August 23, 2016, ASR filed its First Amended Complaint, alleging defendants'
4 “Acculoader” infringes plaintiff’s ‘731 Patent. First Am. Compl. (FAC) ¶¶ 18, 24, ECF No. 44.

5 The ‘731 Patent, titled “Container Packer System and Method,” was filed on
6 November 22, 2011. ‘731 Patent, ECF No. 79-1, Ex. B. The ‘731 Patent is based on a
7 continuation-in-part (CIP) application following U.S. Patent No. 8,061,950 (the ‘950 Patent),
8 which itself was a CIP application of U.S. Patent No. 7,744,330 (the ‘330 Patent). *Id.* A
9 “continuation-in-part” application is a new patent application filed by the original patent
10 applicant, which repeats a substantial part of the earlier application, but adds to or subtracts from
11 claims disclosed in a substantially similar earlier application. 35 U.S.C § 120; *Phigenix, Inc. v.*
12 *Genentech Inc.*, 238 F. Supp. 3d 1177, 1180 (N.D. Cal. 2017). The ‘950 Patent was filed on June
13 29, 2010. ECF No. 28-1, Ex. 2. The ‘330 Patent was filed on June 13, 2008. *Id.* Ex. 1.²

14 ASR alleges “claims 1, 4, 5, and 7 of the [‘]731 [P]atent . . . are entitled to an
15 effective filing date of June 13, 2008, which is the filing date of the application for the ‘330
16 Patent.” FAC ¶ 22. “Effective filing date” is a synonym for priority date, which can include the
17 filing date of a substantially similar earlier application. 35 U.S.C. § 100 (“effective filing date”
18 includes “the earliest application for which the patent or application is entitled”). ASR also
19 alleges “disclosures in both the application for the ‘330 Patent and the application for the ‘950
20 Patent are sufficient to comply with the written description requirement with respect to all of the
21 limitations contained in at least claims 1, 4, 5, and 7 of the ‘731 Patent.” FAC ¶ 22. Under the
22 written description requirement, the patent specification at issue “must clearly allow persons of
23 ordinary skill in the art to recognize that the inventor invented what is claimed.” *Ariad Pharm.,*
24 *Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (internal citations and
25 alterations omitted); *see* 35 U.S.C. § 112 (“The specification shall contain a written description of
26

27 ² The court judicially notices these patent applications. *See GeoVector Corp. v. Samsung*
28 *Elecs. Co.*, 234 F. Supp. 3d 1009, 1016 n.2 (N.D. Cal. 2017) (courts may take judicial notice of
patents in pertinent part because they are publicly available government records).

1 the invention, and of the manner and process of making and using it, in such full, clear, concise,
2 and exact terms as to enable any person skilled in the art to which it pertains, or with which it is
3 most nearly connected, to make and use the same, and shall set forth the best mode contemplated
4 by the inventor or joint inventor of carrying out the invention.”). Here, ASR alleges certain
5 limitations in the earlier ‘950 and ‘330 Patents complied with the written description requirement
6 applicable to the ‘731 Patent because they adequately disclosed several limitations carried over
7 into the ‘731 Patent. FAC ¶ 22.

8 The First Amended Complaint alleges defendants began to infringe the ‘731 Patent
9 by making and selling the Acculoader in or about August 2011, after the “effective filing date” of
10 the ‘731 Patent, “which is June 13, 2008.” *Id.* ¶ 25.

11 B. Procedural History

12 On September 12, 2017, the court issued an order denying defendants’ motion to
13 dismiss, defendants’ motion for summary judgment, and defendants’ motion for sanctions. ECF
14 No. 73 at 1. As part of that order, the court identified an issue precluding summary judgment:
15 “the proper construction of the claim term ‘structural rails.’” *Id.* at 12. “Because there is a
16 genuine dispute of material fact regarding the proper scope and meaning of the term ‘structural
17 rails,’ a *Markman*³ hearing [was required] before a motion for summary judgment is ripe.” *Id.* at
18 13.

19 ASR has submitted an opening brief on claim construction. Pl.’s Br., ECF No. 88.
20 Defendants submitted their own claim construction brief, Defs.’ Br., ECF No. 90, and ASR
21 replied, Reply, ECF No. 92. ASR also submitted a notice of supplemental authority. Pl.’s
22 Notice. Suppl. Auth., ECF No. 100, asserting the “authority may be helpful” to the court in
23 deciding claim construction issues. *Id.* at 2. Defendants did not file a response to ASR’s notice
24 of supplemental authority.

25 The court now construes the disputed words and phrases found in claims 1, 4, 5
26 and 7 of the ‘731 Patent. The parties have submitted numerous evidentiary objections along with

27 ³ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (en banc), *aff’d*
28 517 U.S. 370 (1996)

1 their briefs. *See* ECF No. 90-6, 92-2. The court addresses any evidentiary objections to evidence
2 relied on below, as necessary to clarify the record. To the extent any declaration statements offer
3 legal conclusions, the court disregards those statements.

4 II. LEGAL STANDARD

5 The court construes patent claims as a matter of law based on the relevant intrinsic
6 and extrinsic evidence. *See Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).
7 “Ultimately, the interpretation to be given a term can only be determined and confirmed with a
8 full understanding of what the inventors actually invented and intended to envelop with the
9 claim.” *Id.* at 1316 (internal quotation marks, citation omitted). Accordingly, a claim should be
10 construed in a manner that “stays true to the claim language and most naturally aligns with the
11 patent’s description of the invention.” *Id.*

12 In construing disputed terms, a court looks first to the claims themselves, for “[i]t
13 is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the
14 patentee is entitled the right to exclude.’” *Id.* at 1312 (quoting *Innova/Pure Water, Inc. v. Safari*
15 *Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). Generally, the words of a
16 claim should be given their “ordinary and customary meaning,” which is “the meaning that the
17 term[s] would have to a person of ordinary skill in the art in question at the time of the
18 invention.” *Id.* at 1312-13. A “person of ordinary skill is a hypothetical person who is presumed
19 to be aware of all the pertinent prior art.” *Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc.*,
20 807 F.2d 955, 962 (Fed. Cir. 1986). In some instances, the ordinary meaning to a person of skill
21 in the art is clear, and claim construction may involve “little more than the application of the
22 widely accepted meaning of commonly understood words.” *Phillips*, 415 F.3d at 1314.

23 In many cases, however, the meaning of a term to a person skilled in the art will
24 not be readily apparent, and a court must look to other sources to determine the term's
25 meaning. *See id.* Under these circumstances, a court should consider the context in which the
26 term is used in an asserted claim or in related claims and bear in mind that “the person of ordinary
27 skill in the art is deemed to read the claim term not only in the context of the particular claim in
28 which the disputed term appears, but in the context of the entire patent, including the

1 specification.” *Id.* at 1313. The specification “is always highly relevant” and “[u]sually
2 . . . dispositive; it is the single best guide to the meaning of a disputed term.” *Id.* at 1315
3 (quotation omitted). Indeed, “the only meaning that matters in claim construction is the meaning
4 in the context of the patent.” *Trs. of Columbia Univ. v. Symantec Corp.*, 811 F.3d 1359, 1363
5 (Fed. Cir. 2016). Where the specification reveals that the patentee has given a special definition
6 to a claim term that differs from the meaning it would ordinarily possess, “the inventor’s
7 lexicography governs.” *Phillips*, 415 F.3d at 1316. Likewise, where the specification reveals an
8 intentional disclaimer or disavowal of claim scope by the inventor, the inventor’s intention as
9 revealed through the specification is dispositive. *Id.* However, while the specification may
10 describe a preferred embodiment, the claims are not necessarily limited only to that
11 embodiment. *Id.* at 1323; *see also Prima Tek II, L.L.C. v. Polypap, S.A.R.L.*, 318 F.3d 1143, 1151
12 (Fed. Cir. 2003) (“The general rule, of course, is that claims of a patent are not limited to the
13 preferred embodiment, unless by their own language.”).

14 In addition to the specification, a court may also consider the patent’s prosecution
15 history, which consists of the complete record of proceedings before the U.S. Patent and
16 Trademark Office (“PTO”) and includes the cited prior art references. The prosecution history
17 “can often inform the meaning of the claim language by demonstrating how the inventor
18 understood the invention and whether the inventor limited the invention in the course of
19 prosecution, making the claim scope narrower than it would otherwise be.” *Phillips*, 415 F.3d at
20 1317.

21 A court is also authorized to consider extrinsic evidence in construing claims, such
22 as “expert and inventor testimony, dictionaries, and learned treatises.” *Markman v. Westview*
23 *Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc), *aff’d*, 517 U.S. 370 (1996). Expert

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1 testimony may be particularly useful in providing

2 background on the technology at issue, . . . explain[ing] how an
3 invention works, . . . ensur[ing] that the court’s understanding of the
4 technical aspects of the patent is consistent with that of a person of
5 skill in the art, or . . . establish[ing] that a particular term in the
6 patent or the prior art has a particular meaning in the pertinent field.

7 *Phillips*, 415 F.3d at 1318. Although a court may consider evidence extrinsic to the patent and
8 prosecution history, such evidence is considered “less significant than the intrinsic record” and
9 “less reliable than the patent and its prosecution history in determining how to read claim
10 terms.” *Id.* at 1317-18 (internal quotation marks and citations omitted). Thus, while extrinsic
11 evidence may be useful in claim construction, ultimately “it is unlikely to result in a reliable
12 interpretation of patent claim scope unless considered in the context of the intrinsic
13 evidence.” *Id.* at 1319. Any expert testimony “that is clearly at odds with the claim construction
14 mandated by the claims themselves, the written description, and the prosecution history” will be
15 significantly discounted. *Id.* at 1318 (internal quotation marks, citations omitted).

16 III. DISCUSSION

17 A. Terms For Which Construction Agreed Upon

18 The parties have agreed on the appropriate construction for three claim terms and
19 have requested the court to construe those terms as follows:

20 Claim Term	21 Claims Implicated	22 Agreed-Upon Construction
23 Transport container	24 1, 4, 5 and 7	a container for moving material from one geographic location to another (such as a commercial shipping container)
25 adapted for / 26 configured for	27 1 and 4	designed to allow, facilitate, or cause a component to perform or accomplish a stated function
28 extended position	1 and 4	a position extending at least partially from said transfer base distal end

25 The court accepts these constructions and construes the above claim terms as
26 described.

1 B. Preamble

2 Defendants contend the preamble of claim 1 and the preamble of claim 4⁴ are
3 limiting, or a requirement of those claims. Defs.’ Br. at 11-14. Defendants argue subparts of
4 claims 1 and 4 use the phrase “said transport container,” referring back to the term’s first use with
5 “a” or “an” in the preamble of claim 1 and preamble of claim 4. *Id.* at 12. “[W]ithout the
6 preamble being a meaningful part of the claims, there would be no antecedent basis.” *Id.* at 12-
7 13. Defendants refer to the prosecution history as further evidence, given that “[t]he patent
8 examiner rejected claims specifically because the preamble set forth the transport container,
9 which was required to serve as an antecedent basis for other parts of the claims.” *Id.* at 13 (citing
10 ASR’s Request for Judicial Notice (Pl.’s RJN), ECF No. 88-1, Ex. 8 at 2⁵).

11 ASR contends these preambles are not limiting because “the transport container is
12 merely an environmental feature to provide context in which the claimed invention is to be used.”
13 Pl.’s Br. at 6. Further, “[t]he body of the claim sets forth a structurally complete invention.” *Id.*
14 The system comprises a “transfer base” and “container packer,” each comprising smaller
15 components. The patent specification, detailed description of the preferred embodiments and
16 figures all support the transport container being a feature of the environment that explains “the
17 purpose of the container packer being in the extended position.” *Id.* at 6-8. Lastly, ASR disputes
18 the relevance of defendants’ cited prosecution history because “the preamble was not relied upon
19 to distinguish over the prior art.” *Id.* at 8-9. Although ASR concedes “the claim body does rely
20 on the preamble for antecedent basis,” ASR argues three other factors weigh against the preamble
21 as limiting.

22
23 ⁴ Claim 1 and claim 4 have identical preambles: “A system for packing bulk material in a
24 transport container through an end opening of the transport container, which system comprises
25” ‘731 Patent, col. 10:56-59 (claim 1 preamble), 13:31-33 (claim 4 preamble).

26 ⁵ The court takes judicial notice of this document under Federal Rule of Evidence 201 as a
27 matter of public record. Here, the document was “obtained through the publicly available PAIR
28 [Patent Application Information Retrieval] system on the United States Patent and Trademark
Office website.” Pl.’s RJN at 3; *see Lee*, 250 F.3d at 689; *Preciado v. Wells Fargo Home
Mortgage*, No. 13–00382, 2013 WL 1899929, at *3 (N.D. Cal. May 7, 2013) (taking judicial
notice in part because the information was “obtained from a governmental website”).

1 The preamble for claim 1 and preamble for claim 4 identify “[a] system for
2 packing bulk material in a transport container through an end opening of the transport container,
3 which system comprises” ‘731 Patent, col. 10:56-59, col. 13:31-33. Multiple subparts of
4 claims 1 and 4 use the phrase “said transport container.” For instance, claim 1[i] states, “said
5 transfer base being configured for placement with said transfer base distal end positioned adjacent
6 to said transport container end opening.” *Id.* col. 11:22-23. Claim 1[j] refers to a transport
7 container directly, stating, “said transport container being configured for receiving at least a
8 portion of said container packer with said container packer in its extended position.” *Id.* col.
9 11:25-27. And claims 1[k] and 4[j] refer to “said push blade assembly . . . configured for
10 compacting bulk materials in said transport container.” *Id.* col. 11:28-35, col. 13:64-14:4.

11 “Whether to treat a preamble as a limitation is a determination ‘resolved only on
12 review of the entire[] . . . patent to gain an understanding of what the inventors actually invented
13 and intended to encompass by the claim.’” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*,
14 289 F.3d 801, 808 (Fed. Cir. 2002) (citation omitted). “In general, a preamble limits the
15 invention if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and
16 vitality’ to the claim.” *Id.* (citation omitted). However, “a preamble is not limiting ‘where a
17 patentee defines a structurally complete invention in the claim body and uses the preamble only to
18 state a purpose or intended use for the invention.’” *Id.* (citation omitted).

19 Although “[n]o litmus test defines when a preamble claim limits scope. . . . [s]ome
20 guideposts . . . have emerged from various cases discussing the preamble’s effect on claim
21 scope.” *Id.* (citations omitted). These guideposts include: (1) when the claim body depends “on a
22 particular disputed preamble phrase for antecedent basis”; (2) “when the preamble is essential to
23 understand limitations or terms in the claim body”; (3) “when reciting additional structure or
24 steps underscored as important by the specification”; or (4) “clear reliance on the preamble during
25 prosecution to distinguish the claimed invention from the prior art.” *Id.* at 808-09; *see also*
26 *USHIP Intellectual Properties, LLC v. United States*, 98 Fed. Cl. 396, 410, *aff’d*, 714 F.3d 1311
27 (Fed. Cir. 2013). “[A]s a general rule preamble language is not treated as limiting.” *Aspex*
28 *Eyewear, Inc. v. Marchon Eyewear, Inc.*, 672 F.3d 1335, 1347 (Fed. Cir. 2012).

1 The court considers each of the four guideposts below.

2 1. Antecedent Basis

3 Discussing the preambles of claims 1 and 4, which as noted above are identical,
4 ASR concedes “the claim body does rely on the preamble for antecedent basis,” but contends
5 defendants provide no authority “for the proposition that where a term in a preamble serves as
6 antecedent basis for the same term later in the claim, [] the preamble is therefore limiting as a
7 matter of law.” Reply at 5.

8 There appears to be no authority supporting a single guidepost identified in
9 *Catalina Marketing* as sufficient to find a preamble limiting. Applying the test laid out in
10 *Catalina Marketing*, the court does not find a “transport container” to be an “essential structure”
11 for the invention described in the claim body. *See Catalina Mktg.*, 289 F.3d at 808. The patent
12 specification, under the detailed description of the preferred embodiments, distinguishes “[a]
13 transport container 8”⁶ from “the container packer 6” and “[t]he system 2” which “generally
14 comprises a transfer base 4 reciprocally and slidably mounting a container packer 6.” ‘731
15 Patent, col. 3:49-54. The detailed description headings do not signal the transport container to be
16 an essential structure, either: the headings include “Introduction and Environment,” “Transfer
17 Base 4,” “Container Packer 6,” “Operation,” and “Alternative Embodiment or Aspect Container
18 Packer System 102.” *Id.* col. 3:27, 56; *id.* col. 4:20; *id.* col. 5:4, 48-49. Figures also show system
19 2 pointing directly at the transfer base 4 and container packer 6, but away from the transport
20 container 8. ‘731 Patent, Figs. 1, 2. Moreover, the patent’s “abstract” does not describe the
21 transport container as part of the invention. *E.g.*, ‘731 Patent, ECF No. 79-1 at 21 (“A container
22 packer system includes a transfer base, which receives a container packer adapted for movement
23 longitudinally between retracted and extended positions with respect to the transfer base.”); *see*
24 *also id.* col. 1:57-61 (summary of invention, stating in part “a container packer system is provided
25 with a transfer base, which receives a container packer adapted for movement longitudinally
26 between retracted and extended positions with respect to the transfer base”).

27 _____
28 ⁶ As explained in the ‘731 Patent, numerals, such as “8,” serve as references to locations
identified by number in the design drawing figures. ‘731 Patent, col. 3:49-50.

1 Although the “container packer 6” is listed at one point in the detailed description
2 as including in part “the transport container 8,” this one reference in the detailed description does
3 not rebut the multiple distinctions between “the system 2” and “the transport container 8.” *See*
4 ‘731 Patent, col. 4:22-25; *but see id.* col. 3:49-54 (distinguishing both “container packer 6” and
5 “[t]he system 2” from “transport container 8”); *id.* Figs. 3-4, 6-8 (depicting container packer 6
6 without showing transport container 8); *id.* Fig. 5 (depicting container packer 6 traveling toward a
7 transport container 8 not depicted); *id.* Fig. 10 (depicting container packer 6 and transport
8 container 8 as distinct). The court applies these observations in considering the remaining
9 guideposts below.

10 2. Preamble Essential to Understanding Limitations or Terms

11 Defendants assert “the preamble of claims 1 and 4 add a necessary component of
12 the claimed invention, and the body of the claim does not set out the complete invention if the
13 preamble is disregarded.” Defs.’ Br. at 12. Specifically, “claim 4 never discusses the transport
14 container having an end opening through which the bulk material is received for packing, so the
15 claim is not complete without the preamble.” *Id.* And “[c]laim 1 also refers to the preamble, so it
16 too requires the preamble to give complete meaning to the claim.” *Id.* ASR replies that the
17 preamble “is not essential to understanding the claim body.” Reply at 6.

18 The court does not find the preamble essential to understanding the claims. Claim
19 1’s reference to the preamble does not render the preamble essential to understanding claim 1.
20 The body of claim 4, omitting that the transport container has an end opening, is not essential to
21 understanding the components of the transfer base and container packer, or to understanding that
22 “compacting bulk material in said transport container” would require “said transport container” to
23 have some form of opening for bulk material.

24 3. Additional Structure or Steps Underscored as Important by the
25 Specification

26 Defendants maintain “the transport container is clearly a critical part of the claims
27 as well,” stating “the entire purpose of the invention is ‘for packing bulk material in a transport
28 container.’” Defs.’ Br. at 15. ASR replies the preamble “merely states the purpose of the

1 invention and is not actually part of the invention” and “the specification does not identify the
2 transport container to be important.” Reply at 6.

3 Here, *Catalina Marketing* is instructive: “[A] preamble is not limiting ‘where a
4 patentee defines a structurally complete invention in the claim body and uses the preamble only to
5 state a purpose or intended use for the invention.’” 289 F.3d at 808. In this case, the claim
6 preamble states a purpose “for” the system before describing that system: “packing bulk material
7 in a transport container through an end opening of the transport container.” ‘731 Patent, col.
8 10:56-59, col. 13:31-33. Although claim 1[j] refers to a transport container “configured for
9 receiving at least a portion of said container packer within its extended position,” the patent
10 specification does not indicate the properly configured transport container is anything more than a
11 proper environment for the invention. *See id.* col. 3:27, col. 49-54, 56; *id.* col. 4:20; 5:4, 48-49;
12 *id.* col. 11:25-27; Figs. 1-8, 10. In other words, “[o]n review of the entire[] . . . patent,” the court
13 finds the claim body “defines a structurally complete invention.” *Catalina Mktg.*, 289 F.3d at 808
14 (citations omitted).

15 4. Clear Reliance on the Preamble During Prosecution to Distinguish Claimed
16 Invention from Prior Art

17 Defendants assert “[t]he patent examiner rejected claims specifically because the
18 preamble failed to set forth the transport container, which was required to serve as antecedent
19 basis for other parts of the claims.” Defs.’ Br. at 13 (citing Pl.’s RJN, Ex. 8 at 2). ASR concedes,
20 as discussed above, the amendment to the preamble for antecedent basis. Reply at 5. However,
21 ASR contends “the preamble was not relied upon during the patent prosecution.” *Id.* at 6.
22 Specifically, “the preamble was amended for antecedent basis issues, which is basically a
23 formality.” *Id.*

24 Defendants’ citation to the prosecution history reveals a change in terminology
25 from “shipping container” to “transport container.” Pl.’s RJN, Ex. 8 at 2. Yet the document
26 making the amendment indicates that none of the preamble amendments discussed above was
27 relied on to distinguish the invention from prior art. Pl.’s RJN at 13, 16 (acknowledging
28 amending claim 1 “to provide proper antecedent basis for ‘said transport container’ and ‘said

1 transport container end opening” and noting claim 4 “was not rejected based on art.”). Thus, the
2 court finds no clear reliance during prosecution on the claim preamble to distinguish prior art.

3 Because the claim preamble at issue does not recite essential structure or steps, the
4 preamble merely describes the purpose of the invention and the claim body describes a
5 structurally complete invention, the court finds the preamble does not limit the claims.

6 C. Collateral Estoppel

7 ASR contends defendants are collaterally estopped from arguing for claim
8 construction of four disputed terms. Pl.’s Br. at 1, 9-10 & n.3, 14, 16, 18-19, 25-26. These
9 disputed terms are “distal end with an opening,” “interior,” “compacting said bulk material in said
10 transport container” and “retracted position.” *Id.* at 1-2. In support of its position, ASR refers to
11 a prior district court opinion construing the ‘950 Patent. *See, e.g., id.* at 9 (citing Pl.’s RJN, Ex.
12 1); *Advanced Steel Recovery, LLC v. X-Body Equip., Inc.*, No. 2:12-CV-01004-GEB, 2013 WL
13 4828152, at *1 (E.D. Cal. Sept. 9, 2013).

14 Defendants argue the ‘731 Patent did not exist when the prior district court opinion
15 issued; the ‘731 Patent is only a continuation-in-part patent with new figures and text; defendants
16 were not entitled to appeal the claim construction order separately after prevailing on
17 noninfringement at summary judgment; and the Federal Circuit declined to reach defendants’
18 claim construction arguments because it affirmed summary judgment on noninfringement. Defs.’
19 Br. at 10.

20 In reply, ASR asserts “[t]he disclosures in the patents in the [p]rior [l]itigation are
21 subsumed within the disclosure of the ‘731 Patent in this case.” Reply at 2. ASR also asserts the
22 ‘731 Patent’s status as a CIP application “is not dispositive regarding collateral estoppel.” *Id.*
23 Last, ASR rebuts defendants’ argument about the lack of an opportunity to appeal.

24 Courts “apply the law of the regional circuit to the issue of collateral estoppel” of
25 claim construction orders. *Novartis Pharm. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1333 (Fed.
26 Cir. 2004) (citation omitted); *see In re Freeman*, 30 F.3d 1459, 1465-69 (Fed. Cir. 1994);
27 *Internat’l Gamco, Inc. v. Multimedia Games, Inc.*, 732 F. Supp.2d 1082, 1090 (S.D. Cal. 2010).
28 In the Ninth Circuit, collateral estoppel applies in a patent case if: “(1) the issue necessarily

1 decided at the previous proceeding is identical to the one which is sought to be relitigated; (2) the
2 first proceeding ended with a final judgment on the merits; and (3) the party against whom
3 collateral estoppel is asserted was a party or in privity with a party in the first proceeding.” *Neev*
4 *v. Alcon Labs., Inc.*, No. SACV 15–00336 JVS(JCGx), 2016 WL 9051170, at *12 (C.D. Cal. Dec.
5 22, 2016); *see Hydranautics v. FilmTec Corp.*, 204 F.3d 880, 885 (9th Cir. 2000).

6 “Collateral estoppel also applies to common issues in actions involving different
7 but related patents.” *Mycogen Plant Sci., Inc. v. Monsanto Co.*, 252 F.3d 1306, 1310 (Fed. Cir.
8 2001), *overruled on other grounds*, 535 U.S. 1109 (2002); *Nestle USA, Inc. v. Steuben Foods,*
9 *Inc.*, 884 F.3d 1350, 1352 (Fed. Cir. 2018) (holding collateral estoppel applied to claim
10 construction for new patent where “[n]either party” pointed “to any material difference between
11 the two patents or their prosecution histories that would give rise to claim construction issues in
12 this appeal different from those raised in the prior appeal”). Courts have applied collateral
13 estoppel in instances in which “the parties are asking the court to construe the same term already
14 . . . construed by other judges with respect to related patents.” *Nazomi Commc’ns, Inc. v. Nokia*
15 *Corp.*, No. C-10-04686 RMW, 2013 WL 2951039, at *5 (N.D. Cal. June 14, 2013), *aff’d sub*
16 *nom. Nazomi Commc’ns, Inc. v. Microsoft Mobile Oy*, 597 F. App’x 1075 (Fed. Cir. 2014).

17 As a threshold matter, regarding the first collateral estoppel element, defendants’
18 reliance on *e.Digital Corp. v. Futurewei Techs., Inc.*, 772 F.3d 723, 727 (Fed. Cir. 2014), is
19 unavailing. There, the Federal Circuit held “a court cannot impose collateral estoppel to bar a
20 claim construction dispute solely because the patents are related.” *Id.* However, the Federal
21 Circuit acknowledged “[e]ach case requires a determination that each of the requirements for
22 collateral estoppel are met, including that the issue previously decided is identical to the one
23 sought to be litigated.” *Id.* The Federal Circuit explicitly contemplated “[a] continuation-in-part”
24 as an example, stating a CIP application “may disclose new matter that could materially impact
25 the interpretation of a claim, and therefore require a new claim construction inquiry.” *Id.*
26 Defendant has not provided any examples of the ‘731 Patent’s introduction of new matter that
27 would affect the prior court’s construction of the words “distal end with an opening,” “interior,”
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1 “compacting said bulk material in said transport container” or “retracted position.” The court
2 itself has not located any instances of new matter.

3 The court does find the second and third elements of collateral estoppel—a final
4 judgment on the merits and the same parties against whom estoppel is asserted in the previous
5 proceeding—satisfied here. *See Advanced Steel Recovery, LLC v. X-Body Equip., Inc.*, No. 2:12-
6 CV-1004-GEB-DAD, 2014 WL 3939356, at *7 (E.D. Cal. Aug. 11, 2014), *aff’d*, 808 F.3d 1313
7 (Fed. Cir. 2015) (granting summary judgment); *Advanced Steel Recovery*, 2013 WL 4828152, at
8 *1 (X-Body Equipment, Inc. and Jewell Attachments, LLC as named defendants in claim
9 construction order); *see also Mpoyo v. Litton Electro-Optical Systems*, 430 F.3d 985, 988 (9th
10 Cir. 2005) (summary judgment dismissal considered decision on merits). The court therefore
11 continues to analyze the first element, to determine whether the issues decided in the previous
12 proceeding were identical to those sought to be relitigated here.

13 1. Distal End with an Opening

14 The parties dispute the same term construed by the court in the previous litigation:
15 “distal end with an opening.” *See Advanced Steel Recovery*, 2013 WL 4828152, at *8-9; ECF
16 No. 79-1, Ex. A at 2-5. In the previous litigation, ASR proposed a “[p]lain and ordinary
17 meaning,” and ASR—the plaintiff in both actions—takes that position again now. *Advanced*
18 *Steel Recovery*, 2013 WL 4828152, at *8; ECF No. 79-1, Ex. A at 2. The issue decided here is
19 therefore identical to the previous litigation. *See Neev v. Alcon Labs., Inc.*, No. SACV 15–00336
20 JVS(JCGx), 2016 WL 9051170, at *12 (C.D. Cal. Dec. 22, 2016) (finding “issues decided at
21 [previous] proceeding are identical” where previous court previously construed same terms).

22 Additionally, the intrinsic evidence previously analyzed by the court in the claim
23 language and patent specification is similar if not identical to that in the patent-in-suit. *Compare*
24 ‘950 Patent, col. 4:62-63 (stating in claim 1[a] “a transfer base including proximate and distal
25 ends”) *with* ‘731 Patent, col. 13:34 (same); *compare* ‘950 Patent, col. 5:4 (stating in claim 1[c]
26 “said transfer base distal end”) *with* ‘731 Patent, col. 10:67 (same); *compare* ‘950 Patent, col.
27 5:34-35, 42-43, Figs. 1, 2 *with* ‘731 Patent, col. 11:30, col. 12:52-54, Figs. 1, 2. The previous
28 court order construing “distal end with an opening” relied on the foregoing ‘950 Patent citations.

1 *See Advanced Steel Recovery*, 2013 WL 4828152, at *8-9. Defendants even advance the same
2 argument rejected by the court in the previous litigation, that “distal end with an opening” must
3 be a “structure.” *See* Defs.’ Br. at 16-17; *Advanced Steel*, 2013 WL 4828152, at *8; *see also*
4 *Nazomi Commc’ns*, 2013 WL 2951039, at *5-6 (applying collateral estoppel despite “claims of
5 the[] patents differ[ing]” because “all of the patents share a common specification”).

6 To the extent the ‘731 Patent includes any new embodiments, the ‘731 Patent
7 includes the same disclaimer made in the ‘950 Patent, that embodiments are merely examples.
8 *Compare* ‘950 Patent, col. 4:55-58 (“It is to be understood that while certain embodiments and/or
9 aspects of the invention have been shown and described, the invention is not limited thereto and
10 encompasses various other embodiments and aspects.”) *with* ‘731 Patent, col. 3:29-32; *see also*
11 *Advanced Steel Recovery*, 2013 WL 4828152, at *9.

12 Thus, collateral estoppel applies to this issue, and the court adopts the same
13 construction as the previous court: “The disputed claim term ‘distal end with an opening’ is
14 readily understood when given its plain and ordinary meaning Therefore, this claim term
15 need not be construed.” *Advanced Steel Recovery*, 2013 WL 4828152, at *9.

16 2. Interior

17 Parties dispute the term “interior” construed by the court in the previous litigation,
18 citing to the same claim language in both the ‘950 Patent and the ‘731 Patent. *Compare*
19 *Advanced Steel Recovery*, 2013 WL 4828152, at *9-10 (“A container packer including a
20 proximate end, a distal end with an opening, opposite sidewalls, a floor and an interior”), *with*
21 ECF No. 79-1, Ex. A at 6 (“A container packer including a proximate end, a distal end with an
22 opening, opposite sidewalls, a floor and an interior adapted for receiving bulk material.”).
23 Moreover, the detailed descriptions in the previous litigation patent and the patent-in-suit both
24 refer to “container packer interior 46” with identical depictions in embodiments. *Compare* ‘950
25 Patent, col. 3:35, 42, 49-50, 57; *id.* col. 4:42; *id.* Figs. 5, 8 *with* ‘731 Patent, col. 4:29, 43, 50-51;
26 *id.* 5:24-25, 33-34; *id.* Figs. 5, 8. Collateral estoppel therefore applies to this issue as well, and
27 the court adopts the same conclusion as the previous court: “[T]he disputed claim term ‘interior’
28 does not require construction and therefore need not be construed.” *Advanced Steel Recovery*,

1 2013 WL 4828152, at *10 (citing *Aero Prods. Int’l, Inc. v. Intex Recreation Corp.*, 466 F.3d
2 1000, 1011 n.5 (Fed. Cir. 2006)).

3 3. Compacting Bulk Material in Said Transport Container

4 The parties also dispute the same term construed by the court in the previous
5 litigation: “compacting bulk material in said [transport] container.” *Compare Advanced Steel*
6 *Recovery*, 2013 WL 4828152, at *12-16, 19 *with* ECF No. 79-1, Ex. A at 10. The court in the
7 previous litigation rejected defendants’ proposed reliance on the ‘330 Patent’s prosecution history
8 to support defendants’ construction of another term featuring the phrase “compact the entire
9 volume of bulk material” as “[c]ompletely compress the bulk material.” *Advanced Steel*
10 *Recovery*, 2013 WL 4828152, at *14-16. Here, defendants rely on the same quoted language in
11 the ‘330 Patent prosecution history to propose a construction of “[c]rushing bulk material together
12 between structures to make a smaller, condensed bundle inside the transport container.” ECF
13 No. 79-1, Ex. A at 10; *compare* ECF No. 79-1, Ex. A at 11 (citing ‘330 Patent prosecution
14 history) *with Advanced Steel Recovery*, 2013 WL 4828152, at *14 (same); *see also* Pl.’s RJN, Ex.
15 7 at 9 (‘330 Patent prosecution history). As the court in the previous litigation observed, the ‘330
16 Patent prosecution history did not distinguish from prior art “based on the degree to which the
17 invention’s blade compacts the bulk material,” but rather based on filling “the entire volume of
18 the container packer” and that the push blade “can move the entire volume of bulk material in one
19 full extension of its hydraulic arm.” *Advanced Steel Recovery*, 2013 WL 4828152, at *15
20 (citation omitted). That court concluded the prosecution history supported ASR’s argument that
21 the claim term “does not define the degree to which th[e] bulk material would have to be
22 compressed,” *id.* at *15, and declined to adopt defendants’ offered construction using the word
23 “compress,” *id.* at *16.

24 Because collateral estoppel applies here as well, the court declines to adopt
25 defendants’ proposed construction using the word “[c]rushing.” However, the court in the
26 previous litigation clarified the language in dispute with the following construction: “. . .
27 compacting bulk material in the [transport] container for moving material from one geographic
28 location to another.” *Id.* at *14, 19. The court therefore adopts this construction as well. *See*

1 *Nazomi Commc'ns*, 2013 WL 2951039, at *5-6 (applying collateral estoppel despite “claims of
2 the[] patents differ[ing]” because “all of the patents share a common specification”).

3 4. Retracted Position

4 The parties dispute the term “retracted position,” also involving the same claim
5 language construed by the court in the previous litigation. *Compare Advanced Steel Recovery*,
6 2013 WL 4828152, at *10, with ECF No. 79-1, Ex. A at 7. In the previous litigation, the court
7 applied the ‘950 Patent’s embodiment disclaimer to reason that Figure 1’s depiction of the
8 container packer fully on the transfer base was merely one example of the retracted position. *See*
9 *Advanced Steel Recovery*, 2013 WL 4828152, at *11. The same patent specifications are present
10 here. *See* ‘731 Patent, col. 3:29-32, Fig. 1. As in the previous litigation involving the ‘950
11 Patent, the ‘731 Patent contains “no reference to the size of the transfer base relative to the size of
12 the container packer.” *Advanced Steel Recovery*, 2013 WL 4828152, at *11. Thus, collateral
13 estoppel applies, and the court does not adopt defendants’ proposed construction here, that a
14 retracted position “is not extended at least partially beyond the transfer base distal end.” *See id.*;
15 *see also* ECF No. 79-1, Ex. A at 7. Because the prior court construed “retracted position on said
16 transfer base” as “retracted position at least partially on said transfer base,” the court does so here
17 as well.

18 Finding collateral estoppel applies to all four claims, the court construes the claims
19 as construed in the previous litigation for the reasons explained above. The court next construes
20 the remaining three disputed words and phrases.

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1 D. Mounted

2 The parties dispute the use of the word “mounted.” Each party offers its own
3 construction:

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Claim Term	Claims Implicated	ASR’s Proposed Construction	Defendants’ Proposed Construction
Mounted	1, 4, 5 and 7	ASR believes that the plain and ordinary meaning of this claim language is clear on its face and does not require construction. If, however, this term is construed, ASR proposes the following construction: “positioned about or being supported by”	“Attached.”

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12 1. The Claim Language

13 Claims 1 and 4 contain the word “mounted” in two locations: once involving “a
14 material transfer assembly mounted in said container packer interior,” and another time involving
15 “a pair of structural rails each mounted on a respective container packer sidewall interior face.”
16 ’731 Patent, col. 11: 5-6, 38-40; *id.* col. 13:48-49; *id.* col. 14:7-9. Claims 5 and 7 refer to “an
17 hydraulic power source mounted on said transfer base.”

18 ASR argues the use of “mounted on” shows “that ‘mounted’ does not necessarily
19 require a physical attachment or fixation between two components.” Pl.’s Br. at 21. ASR
20 contrasts “mounted language” with the use of “affixed” elsewhere in the patent. *Id.* at 21-22;
21 ’731 Patent, col. 11:12-13. According to ASR, “mounted” therefore does not require fixation or
22 attachment. Pl.’s Br. at 22. Defendants assert one of ordinary skill in the art would understand
23 “mounted” in this context means “attached.” Defs.’ Br. at 24.

24 Examining the claim language, the court finds, as explained below, defendants’
25 proposed construction could contradict at least some instances of the claim language’s use of
26 “mounted.” Although defendants’ construction could apply to some uses of “mounted,” notably
27 when components are “mounted in” another component, the word “attached” does not cover all
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1 instances of “mounted on,” a relationship between components that does not necessarily require
2 attachment.

3 2. The Patent Specification

4 ASR contends “[i]n each instance the term ‘mounted’ is used, one component is
5 supported by another component.” Pl.’s Br. at 22. Because “the same term must be construed in
6 the same manner, the construction of the term ‘mounted’ must be consistently applicable to all
7 uses in the ‘731 Patent” absent reason to depart from this maxim. *Id.* (footnote and citations
8 omitted). ASR cites multiple uses of “mounted.” *Id.* Defendants observe “[t]he term ‘mounted’
9 is used more than a dozen times in the ‘731 patent specification” and assert “in each instance
10 [mounted] refers to something attached and not simply positioned.” Defs.’ Br. at 25.

11 The court notes multiple uses of “mounted” in the patent specification: “movably
12 mounted in,” “slidably mounted by,” “mounted on” and “mounted in.” ‘731 Patent, col. 2:2-5; *id.*
13 col. 3:51-55; *id.* col. 4:22-63; *id.* col. 6:54-48. Adopting defendants’ proposed construction of
14 “attached” would create an inconsistency with the usage of “mounted” throughout the patent
15 specification, especially in examples such as the transfer base “reciprocally and slidably mounting
16 a container packer.” *Id.* col. 3:52-53; *see Georgia-Pac. Corp. v. U.S. Gypsum Co.*, 195 F.3d
17 1322, 1331 (Fed. Cir. 1999), *opinion amended on reh’g*, 204 F.3d 1359 (Fed. Cir. 2000) (“Unless
18 the patent otherwise provides, a claim term cannot be given a different meaning in the various
19 claims of the same patent.”). On review of the patent specification, the court discerns no “special
20 meaning” to the term “mounted.” *See Summit 6, LLC v. Samsung Elecs. Co.*, 802 F.3d 1283,
21 1291 (Fed. Cir. 2015).

22 3. Prosecution History

23 ASR asserts, “[t]here does not appear to be anything in the file history . . . that
24 would warrant a narrowing or deviation from the plain and ordinary meaning of the claim
25 language.” Pl.’s Br. at 23. Defendants also do not direct the court to any prosecution history.
26 *See* Defs.’ Br. at 24-26.

1 4. Extrinsic Evidence

2 ASR argues extrinsic evidence is not required to construe this claim term. Pl.’s Br.
3 at 23. However, to the extent the court considers extrinsic evidence, ASR offers the expert
4 declaration of Fred Smith. *Id.* (citing Smith II Decl. ¶ 18, ECF No. 88-3). Smith discusses the
5 relationship between mounting and a component’s degrees of freedom: “When a first component
6 is mounted on a second component, at least one of the six degrees of freedom of the first
7 component has been limited.” Smith II Decl. ¶ 18.⁷ “Specifically, a free component can translate
8 in three dimensions (front-back, up-down, and side-to-side), and it can rotate about three separate
9 axes (yaw, pitch, and roll).” *Id.* Smith provides one simple example of “anyone that has mounted
10 a horse” having “at least the up-down degree of freedom restricted, but would also know they are
11 [*sic*] not attached to the horse.” *Id.*

12 Smith’s explanation highlights the varied uses of “mounted,” including “mounted
13 in,” “mounted on,” “movably mounted,” and “slidably mounted” found in the claim language and
14 the patent specification. And dictionary definitions of “mount” include “to seat or place oneself
15 on,” “to put or have in position,” “to set on something that elevates,” “to attach to a support” and
16 “to arrange or assemble for use or display.” *See* Merriam-Webster Dictionary “Mount” (n.d.
17 Web. July 16, 2019); *see Schaefer Fan Co. v. J & D Mfg.*, 265 F.3d 1282, 1288–89 (Fed. Cir.
18 2001) (approving district court use of dictionaries to determine ordinary meaning). Smith’s
19 explanation of mounting as restricting at least one of the “six degrees of freedom” comports with
20 these dictionary definitions and different uses of “mounted” in the ‘731 Patent.

21 Although defendants offer evidence that “[a]ttached” is the “most commonly
22 used” meaning of “mounted” in mechanical engineering, Defs.’ Br. at 25 (citing to declaration

23 ⁷ Defendants object to Smith’s testimony related to the disputed term “mounted.” *See*
24 ECF No. 90-6 at 16. The court overrules this objection as to the material cited in this order,
25 finding the cited evidence highly relevant in light of the various uses of “mounted” in the claim
26 language and patent specification. Additionally, the court has reviewed Smith’s declaration,
27 including the description of his “30 years of experience in the fields of mechanical engineering,
28 and new product development,” curriculum vitae, list of patents, and previous experience as an
expert witness. *See* Smith II Decl. ¶ 2, Exs. 1-3. The court finds Smith a proper expert witness.
At hearing, the court confirmed the parties did not request voir dire or an opportunity to cross
examine declarants. *See* ECF No. 99.

1 and same dictionary definitions the court reviewed above), the use of the word “attached” cannot
2 account for all uses of “mounted” in the claim language and patent specification. Construing
3 “mounted” as “attached” would contradict the intrinsic evidence considered above.⁸

4 Considering all intrinsic and extrinsic evidence, the court concludes the disputed
5 claim term “mounted” is readily understood when given its plain and ordinary meaning. Thus,
6 the term does not require construction.

7 E. Structural Rails and Rollers

8 The parties dispute the following terms:

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Claim Term	Claims Implicated	ASR’s Proposed Construction	Defendants’ Proposed Construction
pair of structural rails each mounted on a respective container packer sidewall interior face	1 and 4	“structures that run horizontally along the sidewalls of the container packer capable of guiding the push blade assembly through longitudinal movement (or a fore-and-aft direction) from a retracted position to an extended position”	“Two rails that support the structural load of the push blade and are mounted on the inside faces of the two sidewalls of the container packer”

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19 ⁸ ASR “objects to the entirety of the Stevick Declaration” in part because Stevick is too
20 qualified—he is a person of “extraordinary,” not ordinary skill, in the art—and because ASR
21 believes opposing counsel drafted the Stevick Declaration, or that defendants’ counsel directly
22 copied from the Stevick Declaration into defendants’ claim construction brief. *See* ECF No. 92-2
23 at 18-22. ASR has requested striking the entire declaration, that the court issue an order to show
24 cause requiring defendants to make a showing that the Stevick Declaration was driven by Stevick
25 and not counsel, or a “short deposition by ASR to cross-examine” if necessary. *Id.* at 22.
26 Because the court does not rely on the Stevick Declaration, it overrules these objections and
27 denies the request with respect to the instant motion. The court notes, however, that ASR’s
28 objection to Stevick as too qualified is not well-taken. *See Norgren Inc. v. Int’l Trade Comm’n*,
699 F.3d 1317, 1325 (Fed. Cir. 2012) (“Because the person having ordinary skill in the art is a
‘theoretical construct’ and is ‘not descriptive of some particular individual,’ ‘a person
of exceptional skill in the art’ should not be disqualified because he or she is ‘not ordinary
enough.’”) (citing *Endress + Hauser, Inc. v. Hawk Measurement Sys. Pty. Ltd.*, 122 F.3d 1040,
1042 (Fed. Cir. 1997) (emphasis in original)).

<p>1 pair of rollers 2 each 3 engaging a 4 respective 5 container 6 packer 7 structural rail 8 and 9 configured for guiding said push blade</p>	<p>1 and 4</p>	<p>ASR believes the plain and ordinary meaning of this claim language is clear on its face and does not require construction. If, however, this term is construed, ASR proposes the following construction:</p> <p>“rolling devices that are adjacent to and arranged to abut the structural rails to help or facilitate movement of the push blade forward and backward through the container (retracted and extended position)”</p>	<p>“Two rollers apply the load of the push blade assembly to the structural rails, and the rollers are configured to direct the movement of the push blade”</p>
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10 1. The Claim Language

11 Claim 1 and 4 both recite, “said container packer including a pair of structural rails
12 each mounted on a respective container packer sidewall interior face,” and “said push blade
13 assembly further including at least a pair of rollers each engaging a respective container packer
14 structural rail and configured for guiding said push blade through longitudinal movement between
15 its extended and retracted positions.” ‘731 Patent, col. 11:38-45; *id.* col. 14:7-14.

16 ASR contends its proposed construction captures the features of “the location of
17 the structural rails, the purpose or function of the structural rails, and the orientation of the
18 structural rails in light of its purpose.” Pl.’s Br. at 30. ASR contends the plain and ordinary
19 meaning of “[r]ollers” in the above claim language “is readily discernible by a person of ordinary
20 skill in the art.” *Id.* at 35. Defendants argue “[o]ne of skill in the art would understand that the
21 pair of structural rails as appearing in claims 1 and 4 of the ‘731 patent refers to two rails that
22 support the structural load of the push blade” Defs.’ Br. at 32.

23 ASR’s proposed construction does not give force to the word “engaging” for the
24 rollers in the claim language. Rather, its proposed construction, that the rolling devices “are
25 adjacent to and arranged to abut the structural” does not convey any “engaging” of the structural
26 rail. In other words, ASR’s proposed construction effectively eliminates one key aspect of the
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1 claim term and disregards “the basic patent law doctrine that every limitation of a claim is
2 material.” *Flex-Rest, LLC v. Steelcase, Inc.*, 455 F.3d 1351, 1361 (Fed. Cir. 2006).

3 2. The Patent Specification

4 ASR asserts the patent specification reveals “structural rails” and “tracks” to be the
5 same term. Pl.’s Br. at 30-32. Specifically, it says, “[b]ecause the location, function, and
6 orientation of the tracks 49 is the same as the location, function, and orientation of the structural
7 rails, tracks 49 and structural rails must be the same element.” *Id.* at 32. The various depictions
8 in figures of locations for tracks 49, tracks 149, and structural rails 153 are merely examples of
9 structural rails taking on “different forms” and being “located at different positions.” *Id.* at 33.
10 According to ASR, “[u]nless the claims expressly recite these specific locations or forms, the
11 claims are not limited to those specific locations and forms.” *Id.* ASR makes similar arguments
12 in support of its proposed construction of “rollers.” *See id.* at 36-37.

13 Defendants distinguish the references to “structural rails” in the ‘731 Patent from
14 previous patents and from references to “tracks” at other locations in the ‘731 Patent. Defs.’ Br.
15 at 32-34. The structural rails “hold the structure of the push blade in place while it moves, which
16 was never discussed or disclosed prior to the ‘731 patent application.” *Id.* at 34.

17 ASR asserts it is a “physical impossibility” that the structural rails support the
18 structural load of the push blade. Pl.’s Br. at 35 (emphasis removed). ASR also asserts it is “a
19 physical impossibility” for the rollers “to convey the structural load of the push blade to the
20 structural rails” in the embodiment at Figure 12, which “shows rollers 161 underneath structural
21 rail 153 to prevent the push blade 154 from rising upwardly.” *Id.* at 38 (emphasis in original).
22 Defendants respond that rollers could place a load on the structural rails if pushed from below,
23 stating “[i]f matter becomes wedged under the [push] blade, that can cause the load to be applied
24 upward, and the load of the push blade is applied to the rails to stop the upward motion and allow
25 the push blade to move in and out of the transport container.” Defs.’ Br. at 35.

26 There are references to “structural rails 153” in both the patent specification and
27 figures. *See* ‘731 Patent, col. 7:25-34; *id.* Fig. 12. The ‘731 Patent also maintains references to
28 “tracks 49” and “tracks 149” that “guide[,]” including a reference to “tracks 149” in the paragraph

1 just before reference to “structural rails 153.” *See, e.g., id.* col. 4:44-45; 7:8-34; *see also* ‘330
2 Patent, col. 3:43, 51 (“tracks 49”). Courts presume different claim terms to have different
3 meanings. *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1382 (Fed. Cir. 2008).
4 Here, “tracks 149” are distinct from the “structural rails 153” as depicted in Figure 12, an
5 embodiment not present in the ‘330 Patent or ‘950 Patent. *See* ‘731 Patent, Fig. 12; ECF No. 28-
6 1, Exs. 1-2 (‘330 Patent and ‘950 Patent). Figure 8, present in all three patents, depicts “tracks
7 49” in the same location as “tracks 149.” Although the claims are not necessarily limited to the
8 single embodiment in Figure 12 or the embodiment in Figure 8, *Phillips*, 415 F.3d at 1323, these
9 embodiments further support the written descriptions in the patent specification as referring to
10 distinct claim terms.

11 Additionally, the ‘731 Patent uses the word “structural” elsewhere. *See* ‘731
12 Patent, col. 4:41; *id.* col. 7:5 (“structural framework”); *id.* col. 6:65-67 (“[s]tructural container
13 packer support beams”); *id.* col. 10:33-34 (“structural cross beams”). Specifically, the detailed
14 description recites, “Structural container packer support beams 222 may be incorporated to
15 strengthen the container packer structure, or the sidewalls of the container packer may be
16 substantially reinforced to eliminate the need of support beams along the top of the packer
17 assembly.” *Id.* col. 6:65-7:3. These uses of “structural” only reinforce the meaning of
18 “structural” in the disputed claim terms as something more than guiding. ASR’s proposed
19 construction does not distinguish between “structural rails” and “tracks,” which conflicts with the
20 claim term language and the patent specification.

21 3. Prosecution History

22 ASR asserts the prosecution history “supports a broader construction” of
23 “structural rails” and “rollers” than ASR has proposed “because the claim containing this
24 limitation was not rejected based on the prior art.” Pl.’s Br. at 33, 37 (citing Pl.’s RJN, Ex. 8 at
25 13). Although ASR is correct about the prosecution history, this fact does not alter the court’s
26 analysis of the claim term language and patent specification above.

1 4. Extrinsic Evidence

2 ASR contends it is not necessary to rely on extrinsic evidence. Pl.’s Br. at 33. If
3 the court does consider such evidence, however, ASR offers a declaration from Fred Smith, in
4 support of the same arguments asserted by ASR above as to patent specification. *See id.* at 33-34,
5 37-38; Smith I Decl. ¶¶ 19, 21-28, ECF No. 58-5.

6 Defendants offer a declaration from Dr. Paul Wright, Ph.D., who contends the
7 “structural rails” limitations and their associated rollers “are based on matter that was . . . not in
8 prior applications,” differing from the use of “tracks” in prior applications. *See* Wright Decl.
9 ¶¶ 17-23, 26-29, ECF No. 51.⁹ Wright distinguishes “guide rails” from “structural rails” as
10 understood by “one of skill in the art” because guide rails “do not have to support a structure;
11 they only need to guide something.” *Id.* ¶ 32.

12 At hearing, defendants also referred to the Maul declaration submitted in support
13 of defendants’ motion to dismiss, motion for summary judgment and motion for sanctions. *See*
14 Maul Decl., ECF No. 50. Maul, who has worked with a different shipping container loader
15 product, explains his personal observations that the Acculoader’s “additional features” were not
16 part of the design of the product with which he was more familiar. *Id.* ¶¶ 3, 5, 7. Specifically,
17 Maul observed the Acculoader’s “use of structural rails and rollers that would engage those
18 structural rails,” resulting in the device’s packer blade working “in conjunction with horizontal
19 structural rails that extended into the interior of the container packer.” *Id.* ¶ 7. Maul reviewed the
20 ‘731 Patent after observing the Acculoader, stating “the Acculoader design kept the packer blade
21 from riding upward and lifting off the floor as it pushed material into the shipping container.” *Id.*
22 ¶ 8. Maul stated the push blade lifting vertically “was a problem” with the other machines with
23 which he was familiar. *Id.* “In the pre-April 2011 design of the [other product], the packer blade
24 was riding up and material was getting jammed between the blade and the floor . . .” *Id.*

25
26 ⁹ The court acknowledges ASR’s objections to the Wright Declaration. *See* ECF No. 58-2
27 at 47-60. As to ASR’s objection to paragraph 18 of the Wright Declaration and ASR’s second
28 and third general objection, the court need not reach those objections given the court’s current
analysis. *See id.* at 48-49, 50-51. The court overrules ASR’s other objection that Wright is
“beyond a person of ordinary skill in an art.” *See id.* at 47-48; *Norgren*, 699 F.3d at 1325.

1 Because the claim language and patent specification distinguishes “structural rails”
 2 from other “tracks” that guide, and because extrinsic evidence further supports this distinction,
 3 the court adopts defendants’ proposed constructions for structural rails and rollers.

4 F. Priority Date

5 Defendants contend the court can determine the ‘731 Patent’s priority date once
 6 the court has conducted its claim construction. Defs.’ Br. at 8. ASR argues priority date analysis
 7 is not properly part of the claim construction phase of proceedings. Reply at 3-4. Although
 8 “[d]etermination of a priority date is purely a question of law if the facts underlying that
 9 determination are undisputed,” *Bradford Co. v. Conteyor N. Am., Inc.*, 603 F.3d 1262, 1268 (Fed.
 10 Cir. 2010), the court finds the single paragraph each party devotes to the issue insufficient to
 11 support resolution at this time. *See* Defs.’ Br. at 8; Reply at 3-4.

12 IV. CONCLUSION

13 For the reasons above, the court construes the preamble as not limiting and the
 14 words and phrases found in claims 1, 4, 5 and 7 of the patent-in-suit as follows:

Claim Term	Claims Implicated	Construction
Transport container	1, 4, 5 and 7	“a container for moving material from one geographic location to another (such as a commercial shipping container)”
adapted for / configured for	1 and 4	“designed to allow, facilitate, or cause a component to perform or accomplish a stated function”
extended position	1 and 4	“a position extending at least partially from said transfer base distal end”
distal end with an opening	1 and 4	The term does not require construction.
interior	1 and 4	The term does not require construction.
compacting bulk material in said transport container	1 and 4	“compacting bulk material in the transport container for moving material from one geographic location to another”
retracted position	1 and 4	“retracted position on said transfer base” is construed as “retracted position at least partially on said transfer base”
mounted	1, 4, 5 and 7	The term does not require construction.

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pair of structural rails each mounted on a respective container packer sidewall interior face	1 and 4	“Two rails that support the structural load of the push blade and are mounted on the inside faces of the two sidewalls of the container packer”
pair of rollers each engaging a respective container packer structural rail and configured for guiding said push blade	1 and 4	“Two rollers apply the load of the push blade assembly to the structural rails, and the rollers are configured to direct the movement of the push blade”

IT IS SO ORDERED.

DATED: July 19, 2019.


UNITED STATES DISTRICT JUDGE