

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF TEXAS  
CORPUS CHRISTI DIVISION

MAGNUM OIL TOOLS  
INTERNATIONAL, L.L.C.,

Plaintiff,

VS.

TONY D. MCCLINTON, *et al*,

Defendants.

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CIVIL ACTION NO. 2:12-CV-99

**ORDER**

On May 3, 2014, the Court conducted a Markman hearing: a presentation to the Court on the issue of interpreting the claims of a patent. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). After considering the materials offered and the arguments of counsel, as well as the parties' briefs, the Court issues the following Order construing the claims of the patents in question.

**I. Jurisdiction**

This Court has subject-matter jurisdiction over this suit pursuant to 28 U.S.C. § 1331 (federal question) and 28 U.S.C. § 1338(a) (patents).

**II. Factual and Procedural Background**

Magnum Oil Tools International, L.L.C. (Magnum) sues as the owner of the patent rights represented by U.S. Patent No. 8,459,346 (the '346 Patent), entitled "Bottom Set Downhole Plug" (D.E. 233-2) and originally issued to W. Lynn Frazier on June 11, 2013, and assigned to Magnum. The patent involves a plug for isolating a wellbore. D.E. 233-

2. Magnum brought this action against Tony D. McClinton, Jaycar Energy Groups, L.L.C., Surf Frac Wellhead Equipment Company, Inc., McClinton Energy Group, L.L.C., Motor Mills Snubbing, L.L.C., and Stan Keeling (Defendants) alleging, *inter alia*, that each has infringed all 38 claims of the '346 Patent. D.E. 233-2.

### III. Discussion

#### A. Patent Claim Construction Standards

The Court construes the scope and meaning of disputed claim terms as a matter of law. *Markman*, 52 F.3d at 979. “[T]he construction of a patent, including terms of art within its claim, is exclusively within the province of the court.” *Markman*, 517 U.S. at 372. The courts are to view claim construction as a form of the construction of a written instrument, in which the definition of claim terms is solely a question of law, over which judges are uniquely qualified to rule due to specialized training in legal analysis. *Id.* at 388-90. Claim construction orders are “solely a question of law subject to de novo review . . . including any allegedly fact-based questions relating to claim construction.” *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448, 1456 (Fed. Cir. 1998).

All claim terms in dispute must be defined as a matter of law by the court, no matter how common they appear. “A determination that a claim term ‘needs no construction’ or has the ‘plain and ordinary meaning’ may be inadequate when a term has more than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.” *02 Micro Internat’l Ltd. v. Beyond Innovation Technology Co.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008). Although “district courts are not (and should not be) required to construe every limitation present in a patent’s asserted

claims, when the parties present a fundamental dispute regarding the scope of a claim term, it is the court's duty to resolve it." *Id.* at 1362. A claim construction hearing is held to determine the definition of all disputed terms.

In construing patent claims, the court looks first to the intrinsic evidence of record, meaning the patent itself, including the claims, specifications, and the prosecution history. Such intrinsic evidence is the most significant and reliable source of the legally operative meaning of disputed claim language. *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). "In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper. The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely." *Id.* at 1583.

### **1. Intrinsic Evidence**

Intrinsic evidence includes the words of the patent itself (including the claim language and specification) and the patent prosecution history where the court interprets the meaning of all terms as the "ordinary and customary" meaning that "would be given by persons experienced in the field of the invention, unless it is apparent from the patent and the prosecution history that the inventor used the term with a different meaning." *Id.* at 1582 (quoting *Hoechst Celanese Corp. v. BP Chemicals, Ltd.*, 78 F.3d 1575, 1578 (Fed. Cir. 1996)). The meaning of a claim must also take into consideration the state of the art, language, and technology as of the patent application's filing date. *PC Connector*

*Solutions LLC v. SmartDisk Corp.*, 406 F.3d 1359, 1363 (Fed. Cir. 2005). The Federal Circuit has described the following hierarchy of review of intrinsic evidence:

First, the court considers the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention.

Second, the court reviews the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.

Third, the court may also consider the prosecution history of the patent, if in evidence.

*Vitronics*, 90 F.3d at 1582. “Claims must be read in view of the specification, of which they are a part. The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims.” *Markman*, *supra* at 979 (citations omitted).

Like the actual language of the patent, the specification and the prosecution history are created by the patentee in an attempt to explain and obtain the patent, and the court uses these resources if the disputed term is not defined by the patentee or the ordinary and customary analysis. However, “because the [patent] prosecution history represents an ongoing negotiation between the [Patent and Trademark Office] and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the

specification and thus is less useful for claim construction purposes.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005).

## **2. Extrinsic Evidence**

A court should look to the extrinsic evidence only in order to clear up some genuine ambiguity in the claims. Extrinsic evidence “is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles;” “extrinsic evidence in general, and expert testimony in particular, may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language.” *Vitronics*, 90 F.3d at 1584. Because “extrinsic evidence can help educate the court regarding the field of the invention and can help the court determine what a person of ordinary skill in the art would understand claim terms to mean, it is permissible for the district court in its sound discretion to admit and use such evidence.” *Phillips*, 415 F.3d at 1318.

## **3. Dictionary or Technical Treatise**

Although dictionaries and technical treatises are extrinsic evidence, these resources can be used to determine the ordinary and customary meaning of a term during analysis of intrinsic evidence or its context. However, dictionaries and technical treatises should be used only so long as they do not contradict definitions found in or ascertained by a reading of the patent documents. *Phillips*, 415 F.3d at 1318. Such sources should be viewed as a starting point for an analysis carefully centered around and focused upon the intrinsic record. *Old Town Canoe Co. v. Confluence Holdings Corp.*, 448 F.3d 1309, 1316 (Fed. Cir. 2006).

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