

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA**

LAMBETH MAGNETIC STRUCTURES,)
LLC,)
)
Plaintiff,) Civil Action No. 16-538
)
v.) Judge Cathy Bissoon
)
SEAGATE TECHNOLOGY (US))
HOLDINGS, INC., *et al.*,)
)
Defendants.)

LAMBETH MAGNETIC STRUCTURES,)
LLC,)
)
Plaintiff,) Civil Action No. 16-541
)
v.) Judge Cathy Bissoon
)
WESTERN DIGITAL CORPORATION,)
et al.,)
)
Defendants.)

MEMORANDUM ORDER

These are patent infringement cases in which Plaintiff Lambeth Magnetic Structures, LLC, alleges, in two separate civil action numbers, 16-538 and 16-541 respectively, that Seagate Technology (US) Holdings and Seagate Technology, LLC (collectively, the “Seagate Defendants” or “Seagate”); and Western Digital Corporation, Western Digital Technologies, Inc., Western Digital (Fremont), LLC, Western Digital (Thailand) Company Limited, Western Digital (Malaysia) SDN.BHD and HGST, Inc. (collectively the “Western Digital Defendants” or “Western Digital”) infringe Plaintiff’s patent, United States Patent No. 7,128,988 (the “988 patent”).

In each action, the parties filed a Joint Disputed Claim Terms Chart identifying the six terms requiring construction. Chart Setting Forth Each Disputed Term (Civil Action No. 16-538, Doc. 46-1); Am. Joint Disputed Claim Terms Chart (Civil Action No. 16-541, Doc. 60-1).

On March 20, 2017, the parties presented a technology tutorial to the Court. The following day, March 21, 2017, the Court held a Markman claim construction hearing.¹ See Claim Construction Hearing Transcript (Civil Action No. 16-538, Doc. 73; Civil Action No. 16-541, Doc. 78) [hereinafter “Hearing Transcript”]. The matters were consolidated for purposes of the claim construction hearing.

Legal Standard

The general principles of claim construction are without dispute. The proper construction of a patent’s claims is a question of law. Teva Pharm. USA, Inc. v. Sandoz, Inc., 135 S.Ct. 831, 837 (2015) (citing Markman v. Westview Instruments, Inc., 517 U.S. 370, 388-91 (1996)). “It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc., 381 F.3d 1111, 1115 (Fed. Cir. 2004)). The words of a claim “are generally given their ordinary and

¹ These two actions were preceded by a third civil action, Lambeth Magnetic Structures, LLC, v. Toshiba Corporation, et al., 14-1526. All three civil actions were consolidated for purposes of claim construction. The Defendants in the Toshiba Corporation action (“the Toshiba Defendants” or “Toshiba”) fully briefed claim construction and participated fully in the Technology Tutorial and Markman hearing. Plaintiff dismissed its action against the Toshiba Defendants shortly thereafter. See Order Approving Stipulation of Dismissal (Civil Action No. 14-1526, Doc. 180). Given the Toshiba Defendants’ involvement, the Court has chosen, where relevant, to refer to their proposed constructions and reasoning. To distinguish between the Toshiba Defendants and the active Defendants, the Court refers herein to Seagate and Western Digital, collectively, as “remaining Defendants.”

customary meaning,” which “is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” Id. at 1312-13 (citing Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996)); Innova/Pure Water, 381 F.3d at 1116). In arriving at this meaning, a court is to look first and foremost to the “intrinsic evidence,” which consists of the patent’s claim language, the specification and written description, and the prosecution history, to determine the meaning of disputed claim terms. Phillips, 415 F.3d at 1311-17; Medrad, Inc. v. MRI Devices Corp., 401 F.3d 1313, 1319 (Fed. Cir. 2005). The specification is the single best guide to the meaning of a disputed term, and is “usually...dispositive.” Phillips, 415 F.3d at 1315 (citing Vitronics, 90 F.3d at 1582).

Claim language guides a court’s construction of claim terms. Phillips, 415 F.3d at 1314. Yet, the “claims cannot enlarge what is patented beyond what the inventor has described as the invention.” Abbott Laboratories v. Sandoz, Inc., 566 F.3d 1282, 1288 (Fed. Cir. 2009) (citing Biogen, Inc. v. Berlex Labs., Inc., 318 F.3d 1132, 1140 (Fed. Cir. 2003)). The context in which a term is used not only in the asserted claims, but also in any claims that are not being asserted in a particular lawsuit, can be highly instructive because “terms are normally used consistently throughout the patent.” Phillips, 415 F.3d at 1314. “The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.” Renishaw PLC v. Marposs Societa per Azioni, 158 F.3d 1243, 1250 (Fed. Cir. 1998).

Claims are always to be read in view of the specification, of which they are a part. Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), aff’d, 517 U.S. 370 (1996). “The person of ordinary skill in the art is deemed to read the claim term not

only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” Phillips, 415 F.3d at 1313. Moreover, “where the ordinary and accustomed meaning of the words used in the claims lack sufficient clarity to permit the scope of the claim to be ascertained from the words alone[,]” the specification can provide clarity. Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1325 (Fed. Cir. 2002). In the specification, a patentee may define his own terms, or give a claim term a different meaning than it otherwise would possess. Id. at 1316. Although a court generally presumes that terms possess their ordinary meaning, this presumption can be overcome when the patentee acts as his own lexicographer. Irdeto Access, Inc. v. EchoStar Satellite Corp., 383 F.3d 1295, 1301 (Fed. Cir. 2004).

“Although the specification may aid the court in interpreting the meaning of disputed language in the claims, particular embodiments and examples appearing in the specification will not generally be read into the claims.” Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 (Fed. Cir. 1988); see Phillips, 415 F.3d at 1323. Nonetheless, “[a] claim interpretation that excludes a preferred embodiment from the scope of the claim ‘is rarely, if ever, correct.’” Globetrotter Software, Inc. v. Elam Computer Grp. Inc., 362 F.3d 1367, 1381 (Fed. Cir. 2004) (quoting Vitronics Corp., 90 F.3d at 1583). Even if a patent describes only a single embodiment, the claims of the patent must not be construed as being limited to that embodiment unless the patentee has demonstrated a clear intention to limit the claim scope using “words or expressions of manifest exclusion or restriction.” Phillips, 415 F.3d at 1323; Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 906 (Fed. Cir. 2004) (citing decisions); Teleflex, 299 F.3d at 1327. The purpose of the specification is “to teach and enable those of skill in the art

to make and use the invention” and sometimes, the best way to do that is to provide an example. Teleflex, 299 F.3d at 1327.

Although the Court of Appeals for the Federal Circuit acknowledges that “the distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim can be a difficult one to apply in practice,” it instructs courts to maintain their focus on how a person of ordinary skill in the art would understand the claim terms. Id. In order to do so, the “claims of the patent must be read in light of the specification’s consistent emphasis on [the] fundamental features of the invention.” Praxair, Inc. v. ATMI, Inc., 543 F.3d 1306, 1324 (Fed. Cir. 2008).

The prosecution history is another tool that supplies the proper context for claim construction. Home Diagnostics Inc. v. LifeScan, Inc., 381 F.3d 1352, 1356 (Fed. Cir. 2004). Because the file history “represents an ongoing negotiation between the [United States Patent and Trademark Office (“PTO”)] and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful in claim construction proceedings.” Phillips, 415 F.3d at 1317. Nevertheless, the prosecution history is intrinsic evidence that is relevant to the determination of how the inventor understood the invention and whether the inventor limited the invention during prosecution by narrowing the scope of the claims. Id. Where an applicant limits claim scope during prosecution through a “clear disavowal of claim coverage, such as an amendment to overcome a rejection,” the well-established doctrine of prosecution disclaimer “preclud[es] patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.” Amgen Inc. v. Hoechst Marion Roussel, Inc., 314 F.3d 1313, 1327 (Fed. Cir. 2003) (citing York Prods., Inc. v. Central Tractor Farm & Fam. Ctr., 99 F.3d 1568, 1575 (Fed. Cir. 1996)); see Omega Eng’g Inc. v.

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