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8 UNITED STATES DISTRICT COURT
9 WESTERN DISTRICT OF WASHINGTON
10 AT SEATTLE

11 CONRAD O. GARDNER,

12 Plaintiff,

13 v.

14 TOYOTA MOTOR CORPORATION, et
15 al.,

16 Defendants.

Case No. C 08-0632 RAJ

ORDER

17
18 **I. INTRODUCTION**

19 This matter comes before the Court on Defendants' motion for partial summary
20 judgment (Dkt. # 70). After careful consideration of the parties' briefing and
21 supporting evidence, and the oral argument of counsel, the court GRANTS the
22 Defendants' motion (Dkt. # 70).

23 **II. BACKGROUND**

24 **A. The '627 Patent**

25 United States Patent 7,290,627 ("the '627 patent") issued on November 6, 2007,
26 to Plaintiff Conrad Gardner from application No. 08/896,514 ("the '514 application"),

1 which was filed on June 23, 1997. The '514 application's ancestry includes two
2 continuation-in-part applications (08/273,114 and 08/140,507) and one continuation
3 application (07/867,412).

4 The subject of the motion for partial summary judgment before the Court is
5 claim 6 of the '627 patent, which reads as follows:
6

7 6. A hybrid motor vehicle comprising in combination:
8 an engine;
9 an electric motor;
10 a storage device;
11 said electric motor power said hybrid motor at lower speeds;
12 said engine powering said vehicle at high speeds; and said engine
13 operatively connected through a charging path for charging said battery
14 at lower speeds
15 wherein said speed demands do not drop below 40 mph for
16 predetermined time periods of 45 seconds.

17 Ferrill Decl (Dkt. # 74), Ex. 1.

18 **B. The Prosecution History of Claim 6 of the '627 Patent**

19 The prosecution history of the '514 application is rather long, spanning
20 numerous office actions, amendments, and two appeals to the Board of Patent Appeals
21 and Interferences ("the Board"). The prosecution history of claim 6 — the only claim
22 at issue in the instant motion — can be traced to independent claims 50 and 51 and
23 dependent claim 52 of the '514 application, which read as follows:
24

25 50. A hybrid motor vehicle comprising in combination:
26 An electric motor propulsion system which shifts to combustion
engine propulsion for vehicle operation when cruise mode is reached;
said cruise mode occurring when rapidly shifting power and speed
demands are not occurring for predetermined periods of time.

51. A hybrid motor vehicle comprising in combination:
an engine;
an electric motor;

1 a storage device;
2 said electric motor power said hybrid motor at lower speeds;
3 said engine powering said vehicle at high speeds; and said engine
4 operatively connected through a charging path for charging said battery
5 at lower speeds.

6 52. A hybrid vehicle according to Claim 50 wherein said speed
7 demands do not drop below 40 mph for predetermined time periods of 45
8 seconds.

9 Ferrill Decl. (Dkt. # 74), Ex. 3-H at 89¹ (claim 50); Ex. 3-J at 103 (claim 51); Ex. 3-K
10 at 107 (claim 52).

11 During prosecution the Examiner of the '514 application stated that claim 52
12 would be allowable if rewritten in independent form to include all of the limitations of
13 claim 50, its parent claim. However, subsequent to the Examiner's statement, and after
14 an appeal to the Board, the Examiner then stated that claim 52 would be allowable if
15 rewritten incorporating the limitations of independent claim 51. The prosecution
16 history of the '514 application does not reveal a reason for this change. While the
17 reason for the change remains unclear, there is no dispute that Mr. Gardner submitted a
18 new claim based on the combination of claims 51 and 52 just before the issuance of the
19 '627 patent. This newly submitted claim ultimately issued as claim 6 in the '627
20 patent.

21 **C. Procedural History of this Lawsuit**

22 Mr. Gardner filed this suit in April 2008, claiming that products made and sold
23 by Defendants Toyota Motor Corporation and Toyota Motor Sales U.S.A., Inc.
24 (collectively referred to hereinafter as "Toyota") infringed claims 1-6 of the '627
25 patent. In this motion, Toyota contends that claim 6 of the '627 patent (1) is indefinite
26 because it fails to meet the requirements of 35 U.S.C § 112 ¶ 2; and (2) is invalid per se

¹ There are multiple page-numbering schemes visible on the exhibits attached to the Ferrill Declaration. This order will refer to the page number in the middle of the footer on each exhibit page.

1 under 35 U.S.C. § 131 because it was never examined on the merits by the United
2 States Patent and Trademark Office.

3 III. ANALYSIS

4 A. Legal Standards.

5 Summary judgment is appropriate "if the pleadings, depositions, answers to
6 interrogatories, and admissions on file, together with the affidavits, if any, show that
7 there is no genuine issue as to any material fact and that the moving party is entitled to
8 a judgment as a matter of law." Fed. R. Civ. P. 56(c). An issue of fact is "genuine" if it
9 constitutes evidence with which "a reasonable jury could return a verdict for the
10 nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A
11 genuine issue of fact is "material" if it "might affect the outcome of the suit under the
12 governing law." *Id.*

13 The determination of the definiteness of a claim is a legal conclusion based on
14 the court's duty to construe patent claims. *Datamize, LLC v. Plumtree Software, Inc.*,
15 417 F.3d 1342, 1347 (Fed. Cir. 2005). As such, the definiteness of a claim is a
16 question of law and appropriate for resolution at summary judgment. *See id.* (affirming
17 summary judgment on indefiniteness grounds). A definiteness determination is made
18 in light of a patent's presumption of validity. *See* 35 U.S.C. § 282. As such, a finding
19 of indefiniteness must be shown by clear and convincing evidence. *Datamize*, 417
20 F.3d at 1348.

21 The specification of a patent "shall conclude with one or more claims
22 particularly pointing out and distinctly claiming the subject matter which the applicant
23 regards as his invention." 35 U.S.C. § 112. A patentee's claims must be sufficiently
24 definite so that the metes and bounds of what the patentee regards as the exclusive right
25 granted by the patent are known to the public. *Halliburton Energy Servs. v. M-I LLC*,
26 514 F.3d 1244, 1249 (Fed. Cir. 2008). Specifically, if a claim is such that a person of

1 ordinary skill in the art cannot determine whether a particular product infringes a given
2 claim, then the claim is indefinite. *Geneva Pharm., Inc. v. GlaxoSmithKline PLC*, 349
3 F.3d 1373, 1384 (Fed. Cir. 2003). The determination of a claim’s definiteness is
4 necessarily tied to the process of claim construction by a court. *Datamize*, 417 F.3d at
5 1348. As such, the definiteness of a claim is determined with respect to the claims
6 themselves, the intrinsic evidence (specification, prosecution history) of the patent,
7 and, if necessary, any extrinsic evidence (expert testimony). *Id.* If a claim is “not
8 amenable” to construction by the court or is “insolubly ambiguous,” then the claim is
9 indefinite. *Id.* at 1347. Conversely, if a claim is amenable to being construed, it cannot
10 be invalid on grounds of indefiniteness. *Id.* Further, even if a claim term lacks express
11 antecedent basis, the whole of the claim is not automatically rendered indefinite. *See*
12 *Manual of Patent Examining Procedure* § 2173.05(e); *Energizer Holdings v. ITC*, 435
13 F.3d 1366, 1370-71 (Fed. Cir. 2006). Rather, where a term lacks express antecedent
14 basis, such antecedent basis may be found by implication elsewhere in the patent.
15 *Energizer*, 435 F.3d at 1370-71.

16 **B. Claim 6 Contains At Least One Indefinite Claim Element.**

17 Toyota argues Claim 6 is invalid because it contains three indefinite claim
18 elements, specifically: 1) “said speed demands”; 2) “lower speeds”; and 3) “higher
19 speeds.”

20 Toyota argues that the term “said speed demands” is indefinite because it lacks
21 express or implicit antecedent basis and that the term bears no logical relationship to
22 the rest of claim 6. Toyota theorizes that the reason for this disjunction is that the “said
23 speed demands” element was improperly grafted onto application claim 50 during the
24 application process.

25 Mr. Gardner does not respond directly to Toyota’s claim of the lack of express
26 antecedent basis. Instead, Mr. Gardner’s response offers multiple constructions of the

1 term “said speed demands.” First, in the Joint Claim Construction Chart, Mr. Gardner
2 construes “said speed demands” as “[t]he invention operating at a steady state cruise
3 speeds above 40 mph for steady state periods greater than 45 seconds.” *See* Notice of
4 Joint Claim Construction Chart (Dkt. # 52) at 25. Second, in his response brief to
5 Toyota’s motion for summary judgment, Mr. Gardner offers the following construction
6 of the “said speed demands” element:

7
8 [T]he threshold of the hybrid vehicle’s low speed and high speed control
9 modes is a vehicle speed of about 40 miles per hour, during which the
10 engine continues operating the vehicle so long as rapidly shifting power
and speed demands are not occurring for 45 second periods of time.

11 Pltf.’s Opp’n (Dkt. # 86) at 18. Third, during oral argument on this motion, when
12 asked by the Court to identify the antecedent basis for “said speed demands,” counsel
13 for Mr. Gardner directed the Court to both the “lower speeds” and “high speeds” terms
14 in claim 6. Thus, Mr. Gardner has presented at least three different interpretations of
15 the “said speed demands” claim term.

16 Mr. Gardner’s first construction fails because he substitutes the term “cruise” for
17 “said speed demands.” As stated in the specification of the ‘627 patent, “[c]ruise mode
18 occurs when rapidly shifting power and speed demands are not occurring for
19 predetermined periods of time.” While “cruise mode” may comprise “speed demands,”
20 speed demands are not sufficient for “cruise mode.” Furthermore, the concept of
21 “cruise mode” is not expressly present in claim 6. The existence of “lower speed” and
22 “high speed” elements in claim 6 does not provide for the concept implicitly. The
23 wording of the low-speed and high-speed elements restricts the powering of the vehicle
24 by two different engines. Cruise mode, or any equivalent, does not exist in claim 6 and
25 any a construction that imports it as a term goes beyond the Court’s ability to construe
26 a claim.

1 Mr. Gardner’s second construction fails for similar reasons. While the term
2 “cruise” is not used, Mr. Gardner instead uses a definition of cruise mode (*e.g.*, rapidly
3 shifting power and speed). While the terminology has changed slightly, the result is
4 the same. New limitations that do not exist in claim 6 are added. Indeed, the ordinary
5 meaning of the term “speed demands” does not include any “rapidly shifting power”
6 requirement. Thus, like Mr. Gardner’s first construction, this second construction also
7 fails.

8 Mr. Gardner’s third construction argues that “high speeds” and “lower speeds”
9 provide express antecedent basis, but such a construction would result in a contorted
10 construction of the “said speed demands” element of claim 6. *Both* the lower and high
11 speed elements would then be subject to the terminology that they “do not drop below
12 40 mph for predetermined time periods of 45 seconds.” Such a construction would be
13 “insolubly ambiguous.” *Datamize*, 417 F.3d at 1347.

14 Despite these different interpretations presented by Mr. Gardner, it is
15 nonetheless the duty of the court to interpret the meaning of the claims and determine
16 whether they are indefinite under 35 U.S.C. § 112 ¶ 2. *Datamize*, 417 F.3d at 1347-48.
17 Even if experts in a case disagree on the construction of a claim, a court may still find
18 the claims to be definite. *See, e.g., Medtronic Vascular, Inc. v. Abbott Cardiovascular*
19 *Sys., Inc.*, 614 F. Supp. 2d 1006, 1030-31 (N.D. Cal. 2009) (despite expert
20 disagreement regarding the scope of “U-shaped,” the court found the term to be not
21 indefinite).

22 When construing a claim, the intrinsic evidence of a patent — which consists of
23 the wording of the claims, the specification, and the prosecution history — provides a
24 roadmap used to determine the meaning of the patent’s claim terms. *See Phillips v.*
25 *AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005).

26 The plain meaning of the words in claim 6 and the other claims of the ‘627

1 patent provide little or no guidance for construing the scope of the term “said speed
2 demands.” Admittedly, “speed” is easily understood by a person of ordinary skill in
3 the art: it is a distance traveled over a given time. Further, the rest of the “speed
4 demands” element defines specific parameters for speed demands, namely “40 mph”
5 for “45 seconds.” However, none of this gets the Court much closer to defining the
6 scope of claim 6 in the ‘627 patent, with regard to the meaning of “wherein said speed
7 demands do not drop below 40 mph for predetermined time periods of 45 seconds.”

8 As noted by Mr. Gardner’s counsel during oral argument, “wherein” is a
9 reference back to a previous paragraph² in claim 6. Thus, a person of ordinary skill in
10 the art would understand the “said speed demands” element to be referring to an earlier
11 claim element in claim 6. It is this reference to something earlier in claim 6 that is a
12 source of the ambiguity of the “said speed demands” element. Claim 6 includes both a
13 “lower speed” element and a “high speed” element. As noted above, a construction
14 involving both “lower speed” and “high speed” as a foundation for “said speed
15 demands” results in claim 6 being insolubly ambiguous. Nothing in claim 6 directs one
16 of ordinary skill in the art as to which of the two earlier recited speeds provides the
17 antecedent basis for “said speed demands.”

18 As the claims fail to provide any concrete guidance for one of ordinary skill in
19 the art to determine the scope of claim 6, the Court next turns to the specification and
20 the prosecution history of the ‘627 patent for guidance in construing the “said speed
21 demands” element.

22 The specification sheds some light on the meaning of the “said speed demands”
23 element because it recites “said speed demands” as part of the described cruise mode
24 operation. Ferrill Decl. (Dkt. # 74), Ex. 1, col 1:65-67. Further, the specification

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26 ²“When you use the word ‘wherein’ that is a reference back to the previous paragraph. It’s a
subordinate clause. That is grammar. The speed demands they’re talking about are high
speeds and lower speeds.” Transcript of Oral Argument (Sept. 18, 2009) at 33.

1 describes the “said speed demands” in the context of a “cruise mode logic output
2 signal.” The “cruise mode logic output signal” triggers if a vehicle is above 40 mph for
3 45 seconds. *Id.*, Ex. 1, col 3:39-45. However, neither the “cruise mode” nor “a cruise
4 mode logic output signal” is mentioned in claim 6.

5 A close reading of the prosecution history of the ‘627 patent provides further
6 support that “said speed demands” relates to a cruise mode operation. The “said speed
7 demands” element originated in the March 23, 1999 amendment of the ‘514 application
8 as claim 52. In the remarks section of the amendment, Mr. Gardner stated that, “More
9 importantly, the specification at page 9, lines 23-28 and also page 10 lines 9-15 and 27-
10 29 referring to Fig. 2 and further illustrative of electric to combustion engine cruise
11 mode control defined in claims 50 and more specifically in added dependent claim 52.”
12 Ferrill Decl. (Dkt. # 74), Ex. 3-K at 108. Additionally, the prosecution history further
13 provides support for interpreting the rest of claim 6. When Mr. Gardner added claim
14 51, he made no mention of a cruise control feature in the remarks accompanying the
15 addition of claim 51, but instead stated:

16
17 Added independent claim 51 readable on the species of Figure 1 is
18 believed necessary to round out the protection of the present invention
19 which includes the features that the present system includes a mode of
20 operation where the system is operating in a series configuration where
21 engine power can be utilized to charge the storage device at lower speeds
22 or idle when propulsion is by the electric motor e.g. in city driving is
utilized, and the engine can also be utilized to power the vehicle in
parallel configuration with the wheels for providing power at higher
speeds.

23 Ferrill Decl. (Dkt. # 74), Ex. 3-J at 104. Thus, not only does the prosecution history
24 provide support that the “said speed demands” element relates to the cruise mode
25 feature, but it also supports the fact that the rest of claim 6 does not implicitly include
26 the cruise mode feature.

1 The definition of “said speed demands” provided by the specification and the
2 prosecution history does not, however, result in a properly construed and definite
3 claim. “Even if a claim term's definition can be reduced to words, the claim is still
4 indefinite if a person of ordinary skill in the art cannot translate the definition into
5 meaningfully precise claim scope.” *Halliburton*, 514 F.3d at 1251. Here, while it is
6 clear that the “said speed demands” element relates to the cruise mode control feature,
7 it is unclear how that definition results in a sufficiently defined scope for claim 6.
8 Furthermore, to construe claim 6 in such a manner would essentially rewrite claim 6 to
9 include all of the features of claims 50, 51, and 52.

10 **C. Claim 6 Cannot be Corrected.**

11 A district court has limited authority to rewrite a claim or “fix” mistakes in a
12 patent. *See Group One, Ltd. v. Hallmark Cards, Inc.*, 407 F.3d 1297, 1302-03 (Fed.
13 Cir. 2005) (discussing a printing error by the U.S. Patent and Trademark Office and the
14 court’s power to correct it). The Patent Act provides a means for patent holders to seek
15 corrections from the U.S. Patent and Trademark Office. *See* 35 U.S.C. § 254³ or §
16 255⁴. A district court may only correct a patent if “(1) the correction is not subject to
17 reasonable debate based on consideration of the claim language and the specification;
18 and 2) the prosecution history does not suggest a different interpretation of the claims.”
19 *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1357 (Fed. Cir. 2003). The
20 Federal Circuit in *Novo Industries* further noted that such corrections are only possible
21 if the error is discernible on the face of the patent.

22 Here, both parties have presented reasonable varying constructions of claim 6.
23 Indeed, Mr. Gardner has presented multiple constructions of claim 6 in attempts to
24 correct the language of claim 6. Further, while it is reasonably clear from the
25

26 ³ For mistakes made by the U.S. Patent and Trademark Office.

⁴ For mistakes made by the applicant.

1 specification that the “said speed demands” element relates to the cruise mode control,
2 it is unclear exactly how that relationship affects the scope of claim 6. Only a thorough
3 reading of the prosecution history reveals exactly what the correction of claim 6 would
4 look like. However, the prosecution history is not the “face of the patent.” *See Group*
5 *One*, 407 F.3d at 1302-03 (noting that a claim’s missing language was only visible
6 through examination of the parent’s prosecution history). As such, the Court cannot
7 rewrite claim 6 in order to fix it. If Mr. Gardner wishes to fix these errors, he will have
8 to do so under the relevant statutory provisions.

9 As the Court cannot “fix” claim 6 as Mr. Gardner would like, the “said speed
10 demands” element stands divested from the rest of the claim elements, its effect on the
11 overall claim scope unclear. Further, the lack of express or implicit antecedent basis
12 for the “said speed demands” element, and the multiple competing constructions
13 offered render the claim insolubly ambiguous. Accordingly, the Court finds claim 6 of
14 the ‘627 patent indefinite and therefore invalid. Because the Court resolves the validity
15 of claim 6 with respect to the “said speed demands” element, the Court need not
16 address the other two elements asserted by Toyota as a basis for invalidity, nor
17 Toyota’s 35 U.S.C. § 131 challenge to claim 6.

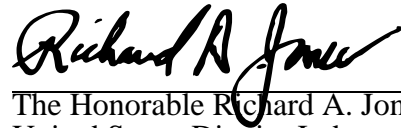
18 Mr. Gardner is correct in saying that “construing the terms of claim 6 is not high
19 level math.” Pltf.’s Opp’n (Dkt. # 86) at 18 (emphasis in original). It is much worse,
20 in that it involves a hopeless attempt to resolve the ambiguities present within the
21 English language. If only such a process were as easy as high level math, it would be
22 both easier on the courts and patent seekers.
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IV. CONCLUSION

For the foregoing reasons, Defendants' motion (Dkt. # 70) is GRANTED.

DATED this 19th day of November, 2009.



The Honorable Richard A. Jones
United States District Judge