United States Court of Appeals for the Federal Circuit

01-1614

B&W CUSTOM TRUCK BEDS, INC.,

Plaintiff-Appellant,

v.

METALCRAFT, INC.,

Defendant-Appellee.

DECIDED: May 22, 2002

Before LOURIE, GAJARSA, and PROST, Circuit Judges.

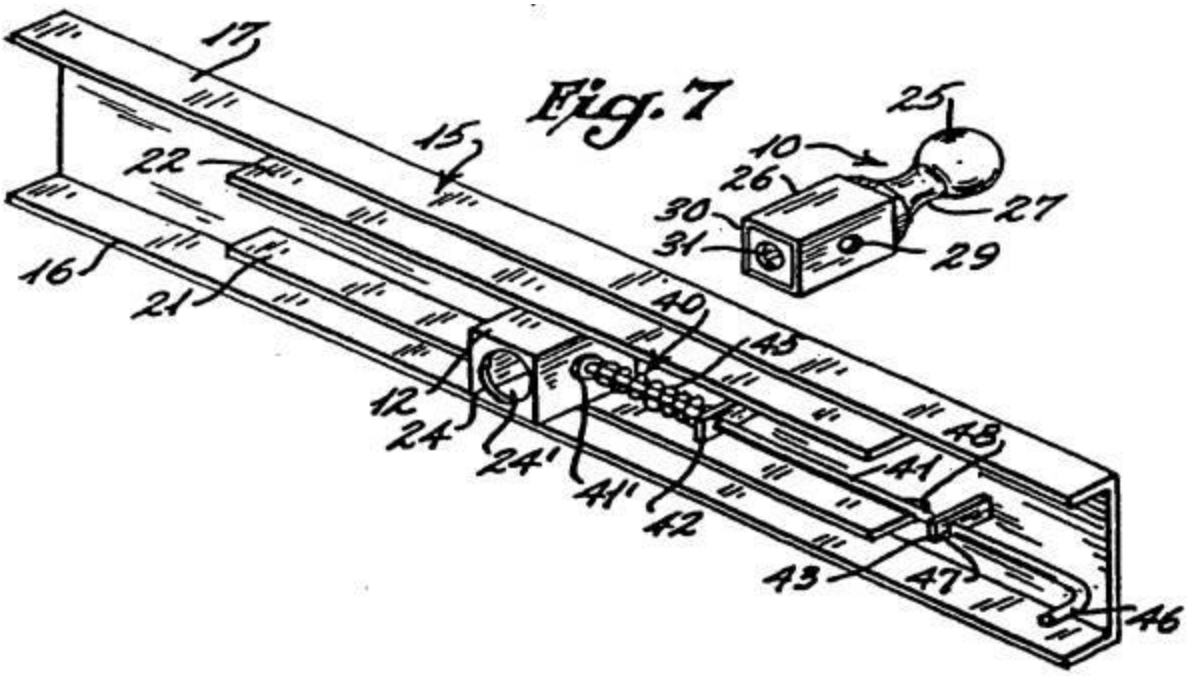
LOURIE, Circuit Judge.

DECISION

B&W Custom Truck Beds, Inc. appeals from the decision of the United States District Court for the District of Kansas granting Metalcraft, Inc.'s motion for summary judgment of noninfringement of B&W's U.S. Patent 5,016,898. B&W Custom Truck Beds, Inc. v. Metalcraft, Inc., No. 01-2087-JWL (D. Kan. July 23, 2001) ("B&W"). Metalcraft moves this court on appeal to award attorney fees and costs based on what it argues is a frivolous appeal brought by B&W. Because the district court did not reversibly err, we affirm. In addition, we deny Metalcraft's motion for attorney fees and costs because we conclude that B&W's appeal is not frivolous.

DISCUSSION

B&W is the assignee of the '898 patent, which is directed to a fifth-wheel trailer hitch assembly for use in pickup trucks and flat-bed vehicles. Figure 7 of the '898 patent depicts an embodiment of the claimed invention:



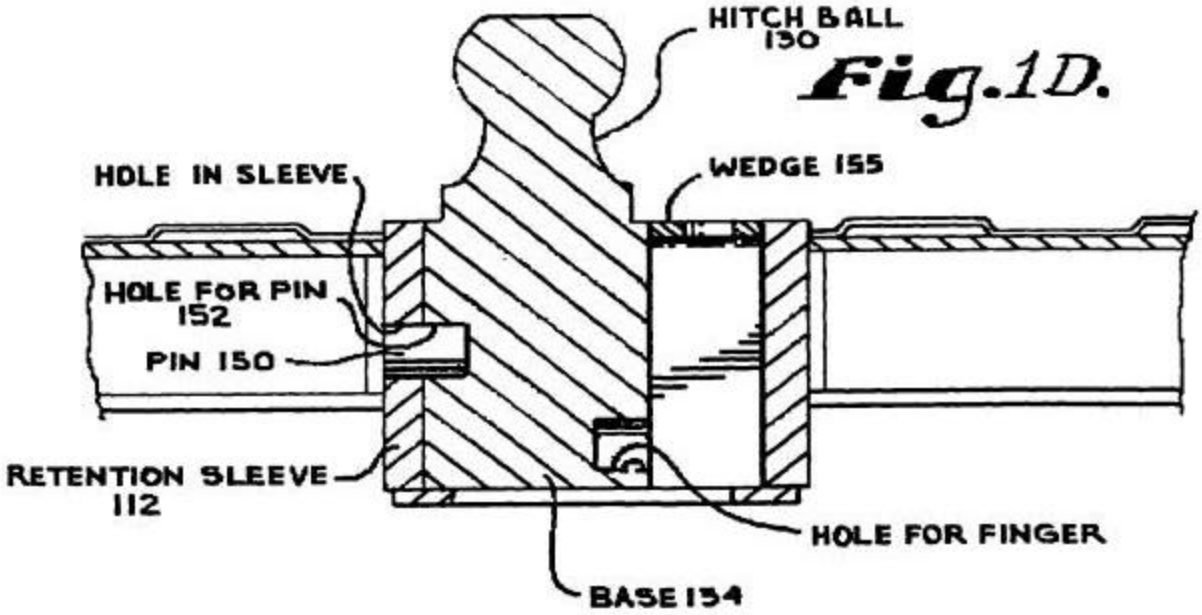
The claimed hitch assembly is comprised of a hitch ball **10** that has a base **26** and a ball element **25**. '898 patent, col. 6, ll. 56-60. The hitch ball is received by a retention sleeve **12**, which is mounted through an opening made in the load bed of the vehicle. Id. at col. 5, l. 64 to col. 6, l. 2. The hitch ball is selectively invertible between an upright position, in which the hitch ball extends above the bed of the truck so as to enable it to be used for towing, and an inverted position, in which the base of the hitch ball is generally flush with the bed of truck when the hitch ball is not in use. Id. at col. 1, ll. 16-39. Once configured in the desired orientation, the hitch ball is held in place by a securing mechanism, which in the case of the hitch assembly illustrated in Figure 7 consists of, inter alia, a locking rod or pin **41** and a spring **45**. Id. at col. 7, ll. 21-34.

Claim 1 is the only independent claim in the '898 patent, and it contains two limitations that are relevant to this appeal. That claim, with the limitations at issue underlined, reads as follows:

> 1. A fifth wheel trailer hitch assembly for use with vehicles having load beds wherein the load bed is provided with an opening therein comprising a reinforcing frame, said reinforcing frame being mounted to the under side of the vehicle load bed so as to extend outwardly with respect to the opening in the vehicle bed, a retention sleeve mounted to said reinforcing frame, said retention sleeve having upper and lower ends, a first opening in said lower end of said retention sleeve and having a first dimension, a second opening in said upper end of said retention sleeve, generally flush with the load bed, a hitch ball means, said hitch ball means including a ball element and a base portion having an end opposite said ball element, said base portion being selectively receivable within said retention sleeve so that said ball element extends through the second opening in the retention sleeve and upwardly with respect to the load bed of the vehicle, said ball element being of a second dimension which is slightly less than said first dimension of said first opening in said retention sleeve, said hitch ball being selectively invertable [sic] with respect to said retention sleeve so that said ball element passes through said first opening in said retention sleeve wherein said base portion is generally flush with said load bed, and means for securing said hitch ball means within said retention sleeve.

Id. at col. 9, ll. 10-32 (emphases added).

Metalcraft's hitch is also a fifth-wheel, invertible hitch that is used in flat-bed vehicles. The following figure illustrates Metalcraft's accused product:



As is the case with the hitch assembly claimed in the ’898 patent, a hitch ball **130** can be inserted into a retention sleeve **112** in either an upright or an inverted position. The securement mechanism in Metalcraft’s product, however, is different from the one described in the embodiment of the ’898 patent discussed above. Specifically, the retention sleeve is significantly wider than the hitch ball, which enables the hitch ball to be first inserted and then moved laterally within the retention sleeve toward a pin **150** extending from one of the sidewalls of the retention sleeve. The pin acts to secure the hitch ball using a hole **152** located on either side of the base of the hitch ball. A wedge **155** is then used to fill the space between the hitch ball and the side wall of the retention sleeve opposite the pin.

B&W sued Metalcraft in the district court, alleging that Metalcraft’s hitch infringed the ’898 patent. B&W, slip op. at 1. After holding a “Markman” hearing, the district court determined that the phrase “means for securing said hitch ball means within said retention sleeve” (hereinafter, the “means for securing” limitation) is a means-plus-function limitation subject to 35 U.S.C. § 112, ¶ 6, and interpreted that limitation to mean “a rod that may be extended through or withdrawn from openings in the retention sleeve and hitch ball and is urged through the openings by a spring.” Id. at 9. Based on that claim construction, the court granted Metalcraft’s motion for summary judgment of

noninfringement. Id. at 13. The court concluded that no reasonable jury could find infringement because although Metalcraft's hitch performed the "securing" function, the pin in that device "is not extended through or withdrawn from openings in the retention sleeve and hitch ball and the product does not use a spring to urge the pin through the openings." Id. at 10-11. The court also concluded that no reasonable jury could find that the securement means of the accused product is equivalent to that in the claimed hitch assembly because: (1) the securement means of that product is contained entirely within a box, whereas a substantial portion of the claimed hitch assembly is exposed to the underside of a truck bed; and (2) the accused product utilizes a wedge, rather than a spring, to hold the pin within the hitch ball. Id. at 11-12.

B&W appeals from the district court's grant of summary judgment of noninfringement. Metalcraft moves on appeal for attorney fees and costs based on what it alleges is a frivolous appeal brought by B&W. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(1).

Summary judgment is appropriate "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56 (c). "The evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in his favor." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 255 (1986). We review a district court's grant of a motion for summary judgment de novo. Ethicon Endo-Surgery, Inc. v. United States Surgical Corp., 149 F.3d 1309, 1315, 47 USPQ2d 1272, 1275 (Fed. Cir. 1998).

A determination of infringement requires a two-step analysis. "First, the court determines the scope and meaning of the patent claims asserted . . . and then the properly construed claims are compared to the allegedly infringing device." Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1454, 46 USPQ2d 1169, 1172 (Fed. Cir. 1998) (en banc) (citations omitted). Claim construction is an issue of law, Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71, 34 USPQ2d 1321, 1322 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370 (1996), that we review de novo, Cybor, 138 F.3d at 1456, 46 USPQ2d at 1172. Determination of infringement, whether literal or under the doctrine of equivalents, is

a question of fact. SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1125, 227 USPQ 577, 589 (Fed. Cir. 1985) (en banc).

B&W argues that the district court erred in granting summary judgment of noninfringement because it improperly included the spring in defining the structure that corresponds to the "means for securing" limitation. B&W asserts that the "means for securing" limitation is properly construed as simply a pin or a rod that extends into a hole in the base of the hitch ball, and that Metalcraft's hitch assembly literally satisfies that limitation. B&W argues that the specification teaches that the spring performs a function independent of "securing," viz., "urging" the rod into the hole in the hitch ball base to prevent accidental withdrawal, and thus asserts that the spring is not part of the structure corresponding to the "means for securing" limitation. B&W contends that the dependent claims make this distinction clear because the spring corresponds to a separate "resilient means" limitation recited in claim 5 that is "mounted adjacent" to the locking rod, which B&W argues is defined in claim 4 as alone corresponding to the "means for securing." B&W also argues that, even under the district court's construction of the "means for securing" limitation, the securement mechanism in Metalcraft's hitch assembly is equivalent under § 112, ¶ 6 to the structure disclosed in the '898 patent that corresponds to that limitation. Finally, B&W argues that it is entitled to summary judgment of infringement because the accused product satisfies the remaining limitations in claim 1, including the "retention sleeve" limitation, as a matter of law.

Metalcraft responds that the district court properly construed the "means for securing" limitation to include the spring and correctly entered summary judgment of noninfringement. Metalcraft argues that without some sort of biasing means, such as a spring, to keep the pin inserted in the hole of the retention sleeve in a locked position, the hitched ball is not "secured" because the pin may withdraw. Metalcraft contends that the specification of the '898 patent supports that argument, as it uses the term "lock" when referring to the engagement of the pin within the hitch ball and retention sleeve and the term "secure" when referring to the utilization of a spring to ensure the fastness of the connection. Metalcraft thus argues that because its product does not use a spring or its equivalent to secure the hitch ball within what B&W alleges is the "retention sleeve" of its product, it does not infringe the '898 patent

as a matter of law. Metalcraft alternatively argues that summary judgment of noninfringement is proper because its product does not satisfy the "retention sleeve" limitation as a matter of law, as the rectangular box that houses the hitch ball in its device lacks the conformal relationship with the hitch ball required by that limitation. Finally, Metalcraft argues that because the "retention sleeve" limitation was amended during prosecution for reasons relating to patentability, B&W has no access to the doctrine of equivalents regarding that limitation.

We conclude that the district court erred in construing the "means for securing" limitation. Although the district court properly determined that the "means for securing" limitation is subject to 35 U.S.C. § 112, ¶ 6, the court erred in identifying the structure in the specification corresponding to that limitation. Structure disclosed in the specification is "corresponding" structure within the meaning of § 112, ¶ 6, "only if the specification or the prosecution history clearly links or associates that structure to the function recited in the claim." B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1424, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997). Here, neither the specification nor the prosecution history "clearly links or associates" the spring with the "securing" function recited in the "means for securing" limitation.

Both the "Field of the Invention" and the "Summary of the Invention" sections of the specification mention only the locking rod or pin when referring to the function of "securing" the hitch ball within the retention sleeve. See '898 patent, col. 1, ll. 16-23 ("The base portion of the hitch ball includes side openings . . . so that a locking pin may be selectively aligned and extended therethrough to thereby secure the hitch ball in a fixed relationship with respect to the retention sleeve . . . .") (emphases added); id. at col. 4., ll. 6-14 ("[T]he base portion of the hitch ball is inserted within the sleeve so that a locking rod assembly may be extended through the aligned openings to secure the hitch ball relative to the sleeve . . . .") (emphases added). In the "Description of the Preferred Embodiment" section, the locking rod is again associated with the function of "securing" the hitch ball with the retention sleeve without mention of the spring:

> In order to insure that the hitch ball is locked in an assembly position within the retention sleeve, a locking assembly **40** is provided. The lock assembly includes an elongated rod **41** which is mounted through a pair of guide members **42** and **43** so as to be in alignment

with the openings **23** in the retention sleeve.

Id. at col. 7, ll. 21-26 (emphases added). In a separate paragraph following the above passage, the spring is referenced for the first time in the specification, but with respect to the separate function of "urging" the locking rod toward the openings in the retention sleeve and hitch ball: "The locking rod **41** is resiliently urged towards seated engagement with the opening **23** by a spring element **45** which is positioned intermediate a flange **41'** formed along the rod and and [sic] guide element **42**." Id. at ll. 29-32 (emphases added).

The distinction between "securing" the hitch ball within the retention sleeve and "urging" the pin or rod toward the openings in the hitch ball and retention sleeve is further delineated in a subsequent passage in the specification:

> [T]he locking rod **41** may be allowed to pass through the aligned openings **23** and **29** through the retention sleeve and base portion of the hitch ball to secure the hitch ball within the retention sleeve. Accidental withdrawal of the retention rod will be prevented by the spring element **45** continuously urging the retention rod into its locked position with regard to the retention sleeve and hitch ball.

Id. at col. 8, ll. 20-27 (emphases added). The specification therefore clearly links or associates the locking assembly, which is comprised of, inter alia, the locking rod, with the "securing" function, and the spring with the "urging" function.

The dependent claims of the '898 patent confirm that "securing" and "urging" are separate functions performed by distinct structures in the claimed hitch assembly. Dependent claims 4 and 5 read as follows:

> 4. The fifth wheel trailer hitch assembly of claim 2 in which . . . said means for securing said hitch ball means within said retention sleeve means includ[es] a locking rod extendable through said first and second aligned openings.

> 5. The fifth wheel trailer hitch assembly of claim 4 including resilient means mounted adjacent said locking rod for normally urging said locking rod through said first

and second aligned openings.

'898 patent, col. 10, ll. 7-22 (emphases added). Thus, claim 4 states that the "means for securing" includes the locking rod or pin, and claim 5 sets forth an additional means-plus-function limitation, viz., "resilient means . . . for normally urging said locking rod through said first and second aligned openings" (the "resilient means for urging" limitation). Id. at ll. 19-20. Because the doctrine of claim differentiation "normally means that limitations stated in a dependent claim are not to be read into the independent claim from which they depend," Karlin Tech., Inc. v. Surgical Dynamics, Inc., 177 F.3d 968, 971-72, 50 USPQ2d 1465, 1468 (Fed. Cir. 1999), the "resilient means for urging" limitation must be held to be distinct from the "means for securing" limitation. Furthermore, as discussed above, the specification makes clear that the spring performs the function of "urging" the locking rod or pin into the opening in the retention sleeve, and thus that structure corresponds to the "resilient means for urging" limitation within the meaning of § 112, ¶ 6. Because one would need clear language in the specification indicating that a particular structure performs more than one function, and because the opposite is the case here, the specification requires us to conclude that the spring cannot constitute structure performing two functions, that of "securing" and that of "urging." Consequently, the spring is not properly part of the structure that corresponds to the "means for securing" limitation.

Moreover, claim 5 requires that the "resilient means," viz., the spring, be "mounted adjacent" to the locking rod, which claim 4 defines as the structure corresponding to the "means for securing" limitation. Metalcraft's claim construction therefore involves a contradiction. The spring cannot constitute structure corresponding to the "means for securing" limitation because it cannot be "mounted adjacent" to itself. Accordingly, because neither the specification nor any relevant prosecution history clearly links or associates the spring with the function of "securing" the hitch ball within the retention sleeve, but rather clearly links that structure to the separate "resilient means for urging" limitation of claim 5, the district court erred in determining that the spring forms a part of the structure corresponding to the "means for securing" limitation.

We nevertheless conclude, however, that the district court did not err in granting summary

judgment of noninfringement because, regardless whether Metalcraft's hitch assembly has a "means for securing" under the proper construction of that limitation, no reasonable jury could find that that product satisfies the "retention sleeve" limitation. Claim 1 of the '898 patent requires that the "ball element be[] of a second dimension which is slightly less than said first dimension of said first opening in said retention sleeve . . . ." '898 patent, col. 9, ll. 27-29 (emphasis added). Thus, in order for Metalcraft's hitch assembly to infringe, the rectangular box that B&W asserts serves as the retention sleeve in that product must be dimensioned such that the ball element portion of the hitch ball is only "slightly less" than the opening in that structure.

B&W argues that Metalcraft's hitch satisfies the "retention sleeve" limitation because one cross-sectional dimension of the rectangular box that houses the hitch ball in that product is commensurate with the diameter of the ball element portion of the hitch ball. We disagree. Claim 1 requires that the "ball element" be "slightly less" than the bottom "opening" of the retention sleeve. Although that claim uses the term "first dimension" when referring to the opening of the retention sleeve and the term "second dimension" when referring to the ball element, that usage does not mean that only one dimension of the ball element need be "slightly less" than one dimension of the opening. The "opening" in the retention sleeve and the spherical "ball element" are two- and three-dimensional in nature, respectively, and therefore it is reasonable to conclude that in order for the ball element to be "slightly less" than the opening in the retention sleeve, both sides of the retention sleeve that form the opening for receiving the hitch ball must be dimensioned so as to be in general conformance with the size of the ball element portion of the hitch ball.

The specification supports this interpretation of the "retention sleeve" limitation. In the preferred embodiment of the invention, the retention sleeve is comprised of 3" by 3" square tubing and the ball element portion of the hitch ball has a 2 5/16" diameter. Id. at col. 7, ll. 50-61. The retention sleeve is thus sized such that the diameter of the ball element is "slightly less" than the dimensions of both sides of the retention sleeve that form the "opening." Although we are mindful of the rule that embodiments of an invention should not ordinarily be read into the claims, the specification nowhere states that it is sufficient for only one of the dimensions of the retention sleeve to conform to the size of the ball

element. Indeed, regarding the relationship between the base of the hitch ball and the retention sleeve, the specification states that "[t]he dimensions of the base of the hitch ball are just slightly less than the dimensions of the steel retention sleeve so that the base can be slideably received within the retention sleeve . . . ." Id. at ll. 4-7 (emphases added). The plural term "dimensions" and the term "slideably received" clearly denote that the retention sleeve must surround the hitch ball in a generally conformal manner. Furthermore, the specification also states that: "The retention sleeve **12** is shown as being a generally open box channel member . . . . The size of the box channel member is generally just slightly larger than the maximum size of the hitch ball **10** . . . ." Id. at col. 6, ll. 20-25 (emphases added). A "box" and a "ball" are not one-dimensional objects. Thus, the specification consistently describes the size relationship between the retention sleeve and the hitch ball with reference to more than one dimension. We therefore interpret the "retention sleeve" limitation of claim 1 as requiring that the dimensions of both sides of the retention sleeve forming the opening through which the hitch ball is received generally conform to the size of the ball element. Accordingly, because it is undisputed that only one side of the retention sleeve in Metalcraft's hitch assembly is so dimensioned, no reasonable jury could conclude that that product infringes the '898 patent either literally or under the doctrine of equivalents.*

Finally, we deny Metalcraft's motion for attorney fees and costs based on a frivolous appeal. Motions for attorney fees and costs should be reserved for appeals that are: (1) "frivolous as filed," i.e., where "an appellant has raised issues that are beyond the reasonable contemplation of fair-minded people, and no basis for reversal in law or fact can be or is even arguably shown"; or (2) "frivolous as argued," i.e., where "an appellant has not dealt fairly with the court, has significantly misrepresented the law or the facts, or has abused the judicial process by repeatedly litigating the same issue in the same court." Sparks v. Eastman Kodak Co., 230 F.3d 1344, 1345-46, 57 USPQ2d 1158, 1159-60 (Fed. Cir. 2000) (citations omitted). B&W's appeal in this case is not frivolous. Indeed, B&W has prevailed on the merits regarding a key issue in this appeal, viz., the construction of the "means for securing" limitation, and Metalcraft ultimately triumphed only on the basis of a separate claim limitation that was not addressed by the district court in its opinion. We therefore conclude that Metalcraft's motion is

completely without merit. Litigants should not bring frivolous appeal motions in cases involving arguable issues; rather, such motions should be reserved for cases involving truly egregious conduct by their adversaries.

Because the district court did not reversibly err in granting summary judgment that the '898 patent was not infringed, we affirm.

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* Because we conclude that Metalcraft's hitch assembly cannot infringe the '898 patent as a matter of law, we need not address Metalcraft's argument that prosecution history estoppel bars B&W from resorting to the doctrine of equivalents regarding the "retention sleeve" limitation.