**UNITED STATES DISTRICT COURT**
**FOR THE EASTERN DISTRICT OF TEXAS**
**TYLER DIVISION**

| | | |
|---|---|---|
| **GEORGETOWN RAIL EQUIPMENT COMPANY, a Texas corporation,** | § | |
| | § | |
| **Plaintiff** | § | |
| | § | |
| **v.** | § | **No. 6:13-cv-366-JDL** |
| | § | |
| **HOLLAND L.P., an Illinois corporation** | § | |
| | § | |
| **Defendant** | § | |

**MEMORANDUM OPINION AND ORDER**

Before the Court is Georgetown Rail Equipment Company's ("Georgetown") Motion *in Limine* Number Three ("MOTION") (Doc. No. 192). Defendant Holland L.P. ("Holland") filed a response ("RESPONSE") (Doc. No. 196). The Court heard arguments regarding the Motion on October 30, 2014. Georgetown moves the Court to prohibit Holland from presenting any evidence or arguments at trial regarding the weight of the preamble to claim 16 or any theories of non-infringement based upon the preamble to claim 16. Having considered the arguments before the Court and for the reasons set forth herein, Georgetown's motion *in limine* is hereby **GRANTED** (Doc. No. 192).

**BACKGROUND**

On May 1, 2013 Georgetown filed a complaint against Holland seeking damages and a permanent injunction against Holland's manufacture, use, sale, or offer for sale of Holland's Rail Vision Systems (the "Accused Products") and any other Holland products or systems that infringe any claims of United States Patent No. 7,616,329 (the "'329 Patent") (Doc. No. 1 at 3). On February 14, 2014, the Court held an early *Markman* Hearing addressing three terms. (*See*

Doc. No. 103) ("February Hr'g Tr."). On March 20, 2014, the Court held a second *Markman* Hearing addressing six additional terms.

Holland and Georgetown dispute whether the phrase in the preamble "to be mounted on a vehicle for movement along the railroad track," should read as a claim limitation. Holland argues the preamble should be read as a claim limitation which requires the processor to be mounted on a vehicle. Georgetown argues that the preamble is not a claim limitation and moves to prohibit Holland from presenting any evidence or argument at trial regarding the weight of the preamble to claim 16 or any theories of non-infringement based upon the preamble to claim 16. The parties agree that this motion is a claim construction issue for the Court to decide.

## THE PATENT

The patent-in-suit generally relates to a system and method for inspecting railroad track using lasers, cameras, and a processor. *See* '329 Patent col. 2:14-34. Specifically at issue in this case is a system for inspecting tie plates. (Doc. No. 21 at 1). Figure 2, below, shows how a tie plate (14) secures the rail (12) to the crosstie (10) or "sleeper."

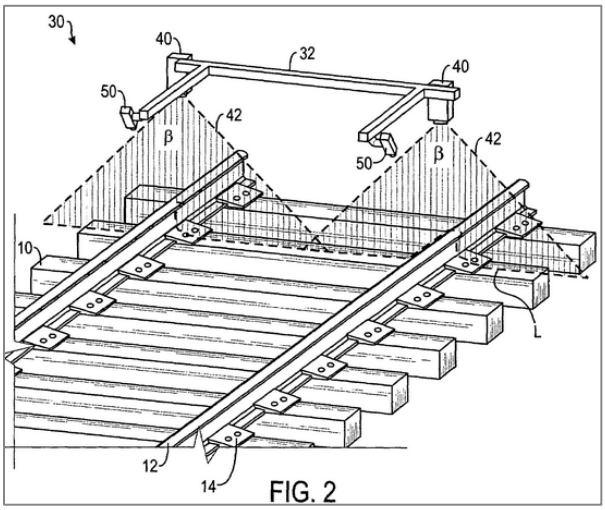

FIG. 2

'329 Patent Figure 2.

At issue in this case is a system for inspecting tie plates. The only asserted claim is claim 16. It recites in its entirety:

> 16. A system for inspecting a railroad track bed, including the railroad track, to be mounted on a vehicle for movement along the railroad track, the system comprising:
>
> at least one light generator positioned adjacent the railroad track for projecting a beam of light across the railroad track bed; at least one optical receiver positioned adjacent the railroad track for receiving at least a portion of the light reflected from the railroad track bed and generating a plurality of images representative of the profile of at least a portion of the railroad track bed; and at least one processor for analyzing the plurality of images and determining one or more physical characteristics of the said portion of the railroad track bed, the one or more physical characteristics comprising at least a geographic location of the plurality of images along the railroad track bed, wherein the processor includes an algorithm for detecting a misaligned or sunken tie plate of the railroad track bed, the algorithm comprising the steps of:
>
> (a) analyzing a frame of the plurality of images, the frame comprising a region of interest;
> (b) determining whether the region of interest contains a tie plate;
> (c) if a tie plate is present, determining a crosstie contour and a tie plate contour;
> (d) comparing an orientation of the crosstie contour and an orientation of the tie plate contour; and
> (e) determining whether the tie plate is misaligned or sunken based upon the comparison.

'329 Patent col. 11:31-12:2.

## LEGAL STANDARD

"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)). In claim construction, courts examine the patent's intrinsic evidence to define the patented invention's scope. *See id.*; *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858, 861 (Fed. Cir. 2004); *Bell Atl. Network Servs., Inc. v. Covad Commc'ns Group, Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001). This intrinsic evidence includes the claims themselves, the

specification, and the prosecution history. *See Phillips*, 415 F.3d at 1314; *C.R. Bard, Inc.*, 388 F.3d at 861.

"No litmus test can be given with respect to when the introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim." *Corning Glass Works v. Simitom Electric U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989). "The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Id.* Although preamble language is often seen as nonlimiting, the Federal Circuit has enumerated some "guideposts" to determine whether the preamble terms limit the claim. *Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed. Cir. 2002). Generally, a preamble is seen as limiting if it "recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." *Id.* (citing *Pitney Bowes, Inc. v. Hewlett–Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999)). Specific instances where a preamble may be construed as a claim limitation include: if "the disputed preamble provides antecedent basis for claim elements," the preamble is "essential to understand limitations or terms in the claim body;" or if the preamble has been relied upon "during prosecution to distinguish the claimed invention from prior art." *Id.* at 808-09; *see also Bicon, Inc. v. The Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006).

## DISCUSSION

### I. Essential Structure that is Necessary to Give Meaning to the Claim

Holland argues, "Where the preamble recites structure, it should be read as a limitation." RESPONSE at 9. As such, Holland argues the preamble limits the claim scope because the preamble states a structure in the phrase "to be mounted on a vehicle."

Holland misinterprets the precedent. "[A] preamble limits the invention if it recites *essential* structure or steps, or if it is 'necessary to give life, meaning, and vitality.' to the claim." *Catalina*, 289 F.3d at 808 (citing *Pitney Bowes*, 182 F.3d at 1305) (emphasis added). A structure recited in the preamble is not essential if the "claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention," *Id.* at 809-10; *see also IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434 (Fed. Cir. 2000); *Intirtool, Ltd. v. Texar Corp.*, 396 F.3d 1289, 1294-96 (Fed. Cir. 2004) (quoting *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A. 1951)). Deleting the preamble phrase "to be mounted on a vehicle for movement along the railroad track," does not change the system described in claim 16. The system comprised of a light generator, an optical receiver, and a processor in which the processor includes an algorithm comprised of a series of steps for detecting a misaligned or sunken tie plate remains unaltered by a deletion of the preamble phrase. According to this analysis, the preamble does not recite an essential structure, and, therefore, does not limit the claim scope.

Furthermore, "[t]he effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Corning Glass*, 868 F.2d at 1257. The patent-in-suit generally relates to a system and method for inspecting railroad track using lasers, cameras, and a processor. *See* '329 Patent col. 2:14-34. Claim 16 recites a system for inspecting tie plates consisting of a light generator, an optical receiver, and a processor wherein the processor includes an algorithm comprised of a series of steps. The specification of the '329 Patent states: "The computer analysis can be performed by the processing device or computer 60 located in the inspection vehicle. Alternatively, the computer analysis can be performed by

another computer system having image processing software known in the art." '329 Patent, col. 7, lines 10-14. As such, the '329 patent instructs that the preamble is not to be read as a limitation.[1] Accordingly, an analysis of the claim 16 in isolation and in the context of the entirety of the '329 Patent indicates that the preamble is not to be read as a claim limitation.

**II. Dependence on a Particular Disputed Preamble Phrase for Antecedent Basis**

''[W]hen the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995) (cited in *Catalina*, 289 F.3d at 808). The claim body, neither in whole nor in part, mentions the phrase "mounted on a vehicle." As such, no word in the preamble phrase provides an antecedent basis for other claim elements. Accordingly, under this analysis, the preamble does not limit the claim scope.

**III. Additional Structure or Steps in the Preamble Phrase Underscored as Important by the Specification**

Holland argues that the preamble phrase is underscored as important by the specification because the invention is described with reference to a system mounted on a vehicle throughout the specification of the '329 Patent. Holland further notes that all three of the independent system claims of the '329 Patent recite the same preamble phrase. However, as noted above, the specification of the '329 Patent states: "The computer analysis can be performed by the processing device or computer 60 located in the inspection vehicle. Alternatively, the computer analysis can be performed by another computer system having image processing software known

[1] Holland attempts to downplay the importance of the specification in this analysis. This argument is contrary to well-settled law. "[C]laims must be read in view of the specification, of which they are a part." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (quoting *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)). "[T]he specification 'is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.'" *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)); *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1325 (Fed. Cir. 2002).

in the art." '329 Patent, col. 7, lines 10-14. As such, the specification indicates that the preamble is not to be read as a limitation. Accordingly, importing a claim limitation on the preamble phrase contradicts the patent specification.

**IV. Clear Reliance on the Preamble During Prosecution**

Holland argues that Georgetown made arguments during prosecution that "indicate the processor must be included on the vehicle." RESPONSE at 9. Holland points to two statements made by Georgetown during prosecution. First, Georgetown, in response to an Office Action dated June 5, 2007, argued that the two references, Shoutaro and Holmes did not disclose the claimed invention: "Shoutaro does not disclose, teach, or even suggest that *the disclosed vehicle* could be used to determine a single characteristic of a railroad track." (emphasis added). Second, Holland points to the statement: "Shoutaro also does not disclose a processor for analyzing the plurality of images." RESPONSE at 9-10.

"Clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." *Catalina*, 289 F.3d at 808. Nowhere in either statement does Georgetown distinguish the claimed invention from the prior art by reference to the system being mounted on a vehicle. Accordingly, under this analysis, the preamble is not seen as a limitation.

**CONCLUSION**

For foregoing reasons the Court **GRANTS** Defendant's Motion *in limine* Number Three (Doc. No. 192). As to the issue of claim construction, the Court construes the preamble of claim 16 to be nonlimiting.

**So ORDERED and SIGNED this 13th day of November, 2014.**

JOHN D. LOVE
UNITED STATES MAGISTRATE JUDGE