

2008-1415

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IN THE  
**UNITED STATES COURT OF APPEALS**  
FOR THE FEDERAL CIRCUIT

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NORGREN, INC.,

*Appellant,*

v.

INTERNATIONAL TRADE COMMISSION,

*Appellee,*

and

SMC CORPORATION AND SMC CORPORATION OF AMERICA,

*Intervenors.*

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**On Appeal from the United States International Trade Commission  
in Investigation No. 337-TA-587.**

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**BRIEF OF INTERVENORS**  
**SMC CORPORATION AND SMC CORPORATION OF AMERICA**

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## CERTIFICATE OF INTEREST

Counsel for intervenors SMC Corporation and SMC Corporation of America  
certify the following:

1. The full name of every party or amicus represented by me is:

SMC Corporation  
SMC Corporation of America

2. The names of the real parties in interest (if the parties named in the caption are not the real parties in interest) represented by me is:

N/A

3. All parent corporations and any publicly held companies that own 10% or more of the stock of the parties represented by me are:

SMC Corporation is the parent corporation of SMC Corporation of America

4. The names of all law firms and the partners or associates that appeared for the parties or amicus now represented by me in the trial courts or agencies or are expected to appear in this court are:

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## STATEMENT OF RELATED CASES

A district court action by Norgren Inc. (“Norgren”) against SMC Corporation and SMC Corporation of America (collectively “SMC”), *Norgren Inc. v. SMC Corp. et al.*, No. 06-cv-00533-EWN-PAC in the U.S. District Court for the District of Colorado, filed more than six months prior to this action before the U.S. International Trade Commission (“ITC”), was stayed pursuant to 28 U.S.C. § 1659.

## PRELIMINARY STATEMENT

Norgren accuses SMC of infringing Norgren's '392 patent (5,372,392) entitled CONNECTING DEVICES. Industrial pneumatic lines often include filters, regulators and lubricators ("FRLs") to condition the line. At first, FRLs were piped directly into a line and there were no connectors between each F, R or L. In 1984, SMC introduced a modular FRL unit consisting of an F-connector-R-connector-L unit which could be placed in a line with only two connections to the line (one at each end of the modular unit). Each F, R or L included two "mounting ears" on opposite sides thereof which could be received by a connector to join the F to the R and (by another connector) to join the R to the L. Each connector was designed to receive the mounting ears.

Prior to SMC's modular FRL unit, similar connectors were commonly used to connect two pipes together in the same fashion. For example, two pipes, each with a circular flange at its end, could be connected by a connector which would receive both circular flanges. The connector would be designed to be circular in order to receive the circular flanges. The connector would consist of two sections so that they could be opened to receive the two flanges and, after receiving the flanges, could be closed and secured by screws, bolts or the like. The two sections of the connector could be connected by a hinge to facilitate opening and closing and to make two sections into one unit.

Both SMC and Norgren market their own line of FRLs as well as a connector for their FRLs, although Norgren did not make its connector until the mid-1990s. In SMC's FRL line, the FRLs have mounting ears and SMC's connector is designed to receive them. In Norgren's FRL line, the FRLs have rectangular ported flanges (rather than mounting ears) and Norgren's connector is designed to receive them.

Norgren's '392 patent (filed in 1993) is directed to a connector for use in Norgren's F-connector-R-connector-L modular unit. The '392 specification states that the benefit of the invention is that the side of the connector (which opens and closes) is hinged so that there are no loose parts which could be lost. After the '392 application was rejected by the examiner, Norgren argued patentability on the basis of the combination of a rectangular flange (which Norgren did not dispute was known) to be received by the connector and a hinged connection (to prevent any loose parts).

The 1984 SMC connector noted above (also referred to as its old-style connector) is prior art. In 2003, SMC introduced a new FRL line with a new connector which still connects SMC's FRLs with mounting ears and, in fact, can connect SMC's FRLs made in the 1980s. However, SMC's 2003 connector (also referred to as its new-style connector) does not infringe for two reasons. First, the 2003 connector connects SMC's mounting ears, not Norgren's rectangular ported

flanges. Second, SMC's 2003 connector includes no hinged connection. To the contrary, SMC's 2003 connector was designed so that one side could be removed (a loose part) to facilitate insertion of the FRLs.

The Administrative Law Judge ("ALJ") found non infringement since SMC's connector does not receive rectangular ported flanges.

As an alternative ground for supporting the judgment, although the '392 specification states that the benefit of the invention is no loose parts, the ALJ declined to construe "pivotally mounted" to require no loose parts.

As a further alternative ground for supporting the judgment, Norgren does not dispute that its connector is a combination of old elements with no new result. Nonetheless, the ALJ declined to find the '392 invention obvious although he inferred that it would be so if Norgren's rejected construction of "rectangular ported flange" were adopted.

The ITC adopted the ALJ's decision.

### **STATEMENT OF THE ISSUES**

1. Whether the ITC's non infringement finding is supported by substantial evidence.
2. As an alternative ground for supporting the ITC's decision, whether the "pivotally mounted" claim limitation should be construed to require a hinged connection (no loose parts).

3. As a further alternative ground for supporting the ITC's decision, whether the '392 invention would have been obvious.

## **STATEMENT OF THE CASE**

Norgren appeals the ITC's final determination of no violation of 19 U.S.C. § 1337. Norgren alleged that SMC's connector infringed claims 1-5, 7, and 9 of the '392 patent. An evidentiary hearing was held before ALJ Charneski on November 27-29, 2007.

The ALJ's Initial Determination ("ID") found no violation of Section 337 on the basis of no infringement. (A0003-85). Norgren petitioned the ITC for review. (A3403-3432). SMC also petitioned the ITC for review. (A3433-3452). The ITC declined to review the ALJ's ID and terminated its investigation with a finding of no violation of 19 U.S.C. § 1337. (A0001-2).

## **STATEMENT OF FACTS**

### **A. Background of the Technology**

Filters, regulators, and lubricators ("FRLs") have been used for many years to condition the air in industrial pneumatic systems. They are relatively inexpensive and are considered to be commodity items. (A1528). Since at least the mid-1980s, routine maintenance has been accomplished without removing the FRL unit from the line through the use of removable bowls on filter and lubricator units. (A1510-1511). Most FRL units are changed infrequently. Indeed, the '392

inventors confirmed that, in some instances, FRL units can go for twenty to thirty years without replacement. (A1422-1424).<sup>1</sup>

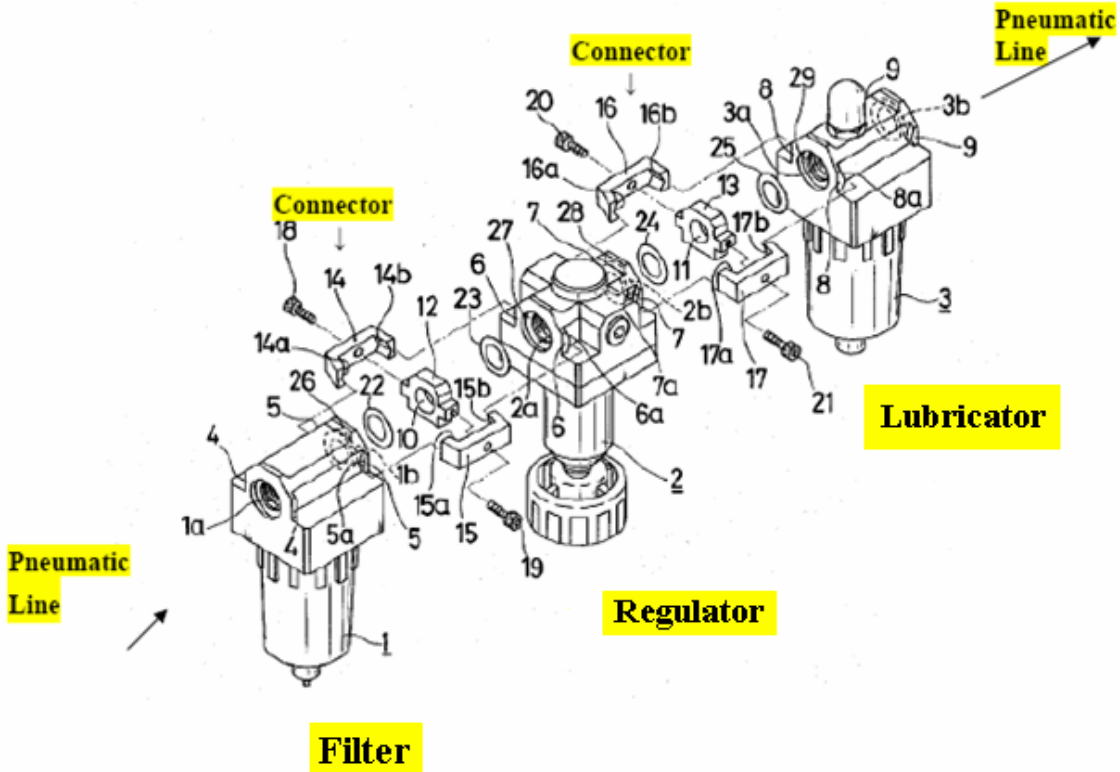
### **B. SMC's Prior Art 1984 Connector**

Initially, FRLs were piped into pneumatic lines as individual units, typically using simple pipe nipples. In the 1980s, SMC was the first in the FRL industry to introduce a connector-based modular FRL line. (A1510-1511). In 1985, SMC received a patent on an FRL modular unit. (U.S. patent 4,533,020 (the “‘020 patent”) (A7000-7003)). SMC still sells this early connector, referred to as its 1984 connector (or its old-style connector). (A1539-1540).

As can be seen from the figure from the ‘020 patent (reproduced below, annotations are highlighted), two SMC 1984 connectors can be used to connect an F, R and L as one modular unit. Each F, R and L has two projections (“mounting ears”) on each of the two opposed sides which are received by the connector. The 1984 connector is designed to receive these mounting ears to connect two FRLs to each other. The connector has a bolt in its middle which is loosened to open the connector to receive the mounting ears of the FRL units and then tightened to close and seal the two units together.

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<sup>1</sup> In its brief (at 10), Norgren asserts that “[b]efore the introduction of the ‘392 clamp, also known as the ‘Quikclamp,’ assembly lines had to be shut down for considerable lengths of time to allow for a worker to unbolt the non-functioning units or take apart a connecting device in order to remove a unit.” However, Norgren cites to nothing in the record to support this assertion. Further, FRLs are designed to be maintained without being removed from the line. (A1510-1511).



### C. Other Prior Art Connectors

Connectors have long been used in the piping and plumbing fields. U.S. patent 4,400,018 (the “‘018 patent” or “Abbes”) issued in 1983, and discloses a clamp to connect pipes together. (A5000-5005). This clamp (figure 2 of the ‘018 patent is reproduced below) is formed of two semi-circular half shells to receive two circular flanges, one at the end of each pipe to be connected. The clamp can be opened and closed through the use of two bolts. Although the Abbes clamp is circular-shaped, the ‘018 specification discloses that the clamping device “can have different constructional shapes.” (A5004, col. 3:54-57).

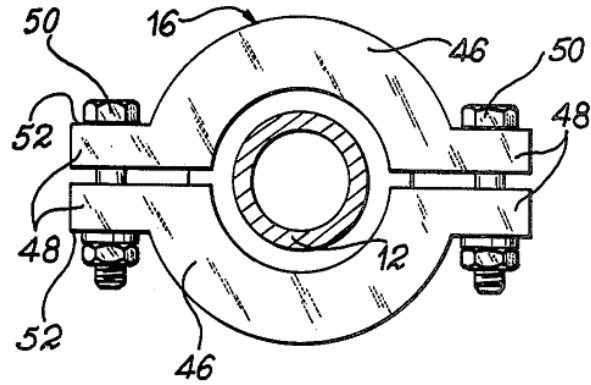
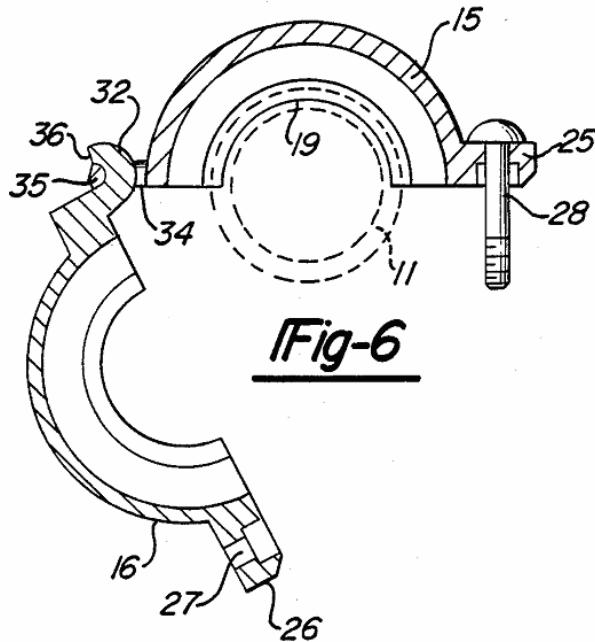


FIG. 2

U.S. patent 4,915,418 (the “‘418 patent” or “Palatchy”) issued in 1990 and discloses a hinged clamp for receiving (like Abbes) two circular flanges. (A2047-2054). The ‘418 clamp (figure 6 from the ‘418 patent is reproduced below) is formed of two semi-circular segments (also like Abbes), hingedly connected together. The ‘418 specification discloses that the hinged portion is integral, and that the invention permits the coupling of the two circular flanges with one hand. (A2050, col. 1:38-67).



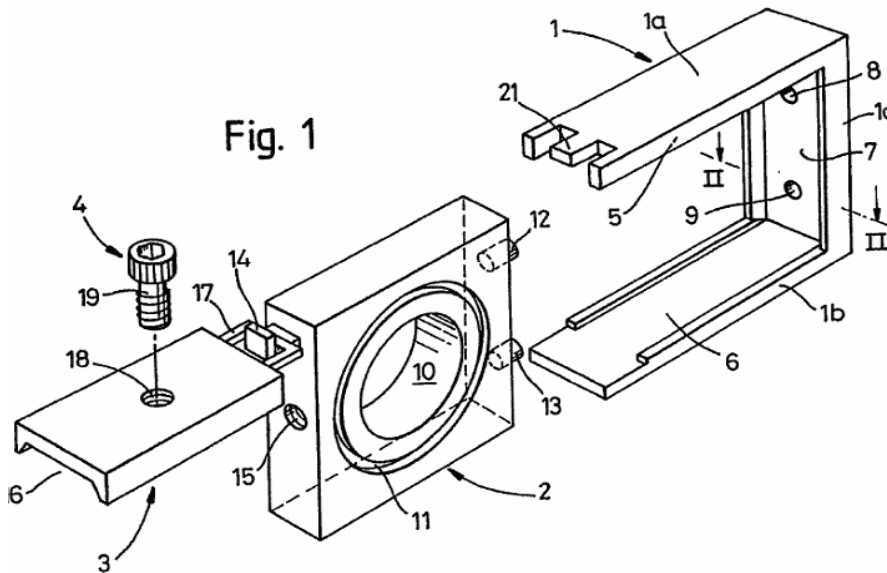
#### **D. Norgren's QuikClamp and '392 Patent**

As noted above, SMC introduced the first connector-based modular FRL line in the mid-1980s. (A1510-1511). Norgren, on the other hand, did not sell a connector-based modular FRL line until ten years later when it introduced its Excelon series in 1994 and, in particular, its connector which it called the QuikClamp. (A1248). Norgren's '392 patent on its connector was granted in 1994.

##### **1. The '392 patent**

The '392 patent is directed to a device or clamp for receiving and connecting together fluid flow elements, such as FRLs, for use in compressed air systems. (A154, col. 1:6-10). The '392 patent describes the patented connecting device as a four-sided generally rectangular clamp that can receive the generally rectangular ported flanges of the fluid flow elements (FRLs) that are provided for this purpose.

The generally rectangular ported flange is described as a flange that is square or rectangular, and has projections on all four sides of the flange, *i.e.*, its outer periphery is square or rectangular. (A151-152, Figs. 3-4; A1601). The clamp is able to receive the flanges on the FRLs since a fourth side of the clamp is hingedly mounted so that the clamp can be opened and closed. (A150, Figs. 1-2; A154-155, col. 2:35-3:20; A1607-1608). Figure 1 of the '392 patent is reproduced below.



As set forth in the Summary of the Invention, the purpose of hingedly mounting the fourth side is so that “the connecting means of the invention may be *a unitary structure* in the sense that it has *no loose parts* that might otherwise get lost by the user.” (A154, col. 2:5-8) (emphasis added).

## 2. The ‘392 Prosecution History

As filed, the ‘392 application included original claims 1-9. (A2023-2024). Claims 1-8 were directed to a “connecting means” (the connector or clamp, not the FRLs). Claim 9 was directed to an “installation” (the FRL-connector combination) with a “first compressed air-conditioning unit” and a “second air-conditioning unit.” (A2023-2024; A1718-1720). “Air-conditioning” refers to “conditioning” the pneumatic line, not any cooling from an air conditioner.

The examiner rejected claims 1-8 under 35 U.S.C. § 112, ¶ 2 because it was unclear as to whether the FRLs were part of the claimed combination, and further rejected claims 1-3 and 6-9 as obvious in view of the prior art. (A2036-2039). The examiner stated that “Edmaier and Abbes disclose applicants’ joint [clamp] with the exception of *the clamp means and flanges being of rectangular shape* and the clamp means [being] provided with a pivoting portion [hinge].” (A2037, emphasis added). The examiner further stated that “the rectangular shape is common in the pipe joint field.” *Id.*

In response (A2083-2089), Norgren amended independent claim 1 to overcome the rejection under § 112 and argued:

[T]he connecting structure comprises a clamp adapted to engage the pair of ported flanges of the fluid flow elements. The fluid flow elements and flanges defined in the preamble of claim 1 are not part of the claimed combination.

(A2086, emphasis by Norgren). Norgren also amended claim 1 to include the limitation that the flange was “a generally rectangular ported flange” (A2083-2084) and referred to this limitation in both the preamble and the body of claim 1. Norgren also amended claim 9 so that it no longer was directed to an “installation” but, rather, was directed to a “connecting structure according to claim 1” (the connector). (A2085). Norgren also argued:

Neither of the primary references, Edmaier and Abbes, discloses *a clamp of rectangular shape wherein one of the sides is pivotally mounted* so that it can be pivoted out of its operative position in order to fit the clamp over flanges of fluid flow elements.

(A2086-2087) (emphasis added). Norgren did not dispute the examiner’s statement that “the rectangular shape is common in the pipe joint field.”<sup>2</sup>

### **3. The ‘392 Patent Claims**

The sole independent claim, claim 1, recites:

1. Connecting structure for contiguously connecting together a pair of fluid-flow elements, each fluid flow element including a generally rectangular ported flange so as to define a pair of ported flanges associated with the fluid-flow elements, said connecting structure comprising:

a four-sided, generally rectangular clamp adapted, in its operative clamping position, to engage, in parallel relationship with one another, the pair of ported flanges, one of said sides of the clamp being pivotally mounted so that said one side can be

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<sup>2</sup> In response to Norgren’s amendment, the examiner allowed the application. (A149). A later filed certificate of correction corrected several printing errors in the patent including a significant printing error in claim 1. (A2101-2103).

pivoted out of said operative clamping position in order to permit reception of said flanges into the clamp and then pivoted back into said operative clamping position,

sealing means for establishing fluid-tight communication between the respective ports formed in said flanges, and

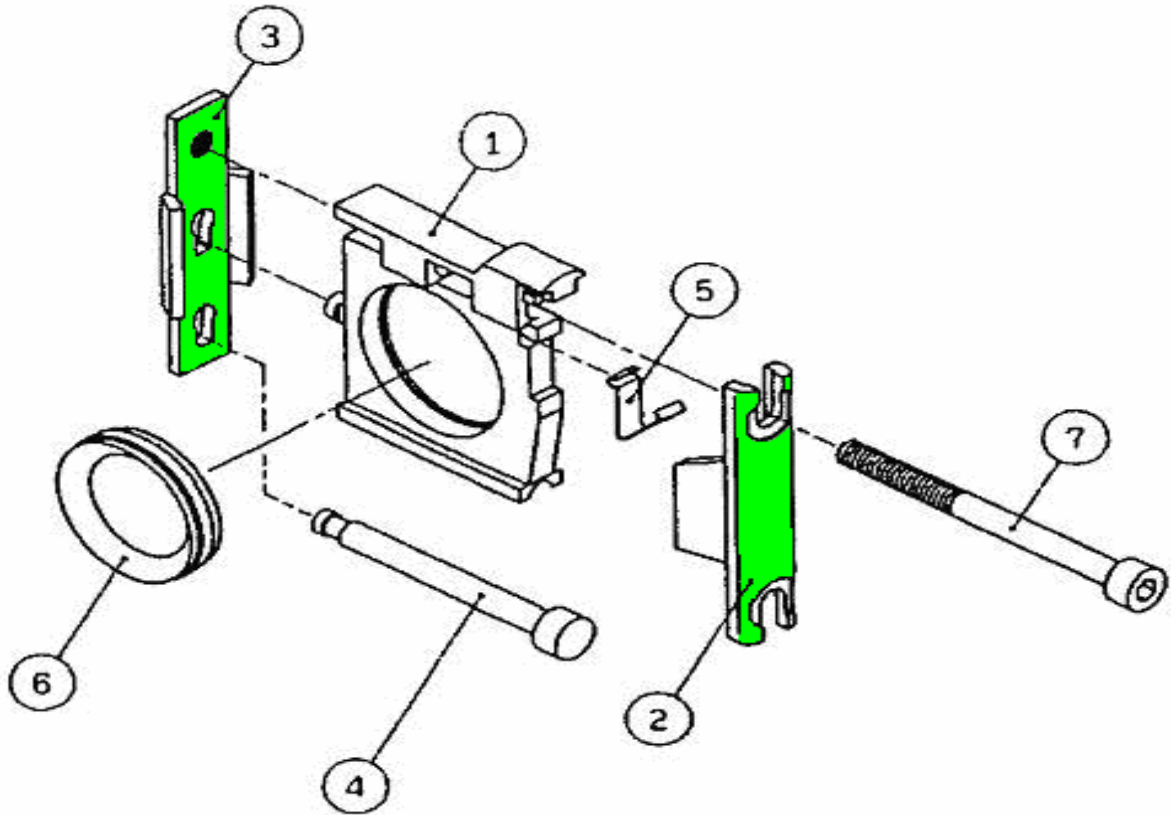
locking means for releasably locking said one side in said operative clamping position, in which position the clamp urges the flanges towards one another thereby establishing together with said sealing means, said fluid-tight communication between said ports.

(A155, col. 4:44-57; A2103).

#### **E. SMC's 2003 Connector**

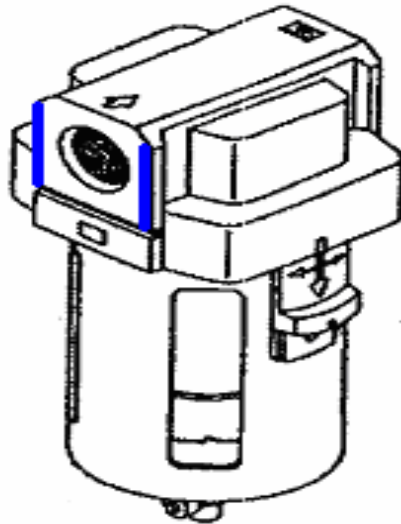
In 2003, SMC introduced a new FRL line with a new connector. (A1527; A7104). As shown in the figure below, this connector has retaining clips on the front (2) and back (3) of the connector. (A1577-1578).

## SMC's 2003 Connector



SMC's connector, like its prior art 1984 connector, is designed to connect FRLs using their mounting ears which have been provided for this purpose. These mounting ears are shown in blue in the figure below.

## SMC's Mounting Ears



The FRLs to be connected are forced together by corresponding wings on the two retaining clips (2, 3) when the bolt (7) is tightened to seal the assembly. (A1577-1578). The front retainer clip (2) is designed to be removable (to be a loose part) to facilitate insertion of an FRL from the front. (A1578-1580). The 2003 connector is interchangeable with the 1984 connector which is still sold since some customers prefer it. (A1544-1546). Both connectors can connect all SMC FRL units with mounting ears. (A1578).

## F. The Evidentiary Hearing

At the evidentiary hearing (or trial), four witnesses testified on behalf of Norgren, including its expert witness, John Wiskamp.<sup>3</sup> Wiskamp is a long-time Norgren salesman who is not an engineer and, indeed, has never even taken an engineering class. (A1229). Wiskamp admitted during cross-examination that he (1) did not review the prosecution history of the '392 patent nor did he understand its purpose (A1428); (2) did not consider whether his interpretation of the '392 patent was inconsistent with the prosecution history (A1428); and (3) did not understand the difference between literal infringement and the doctrine of equivalents. (A1431-1433). Although SMC did not seek to preclude Wiskamp from testifying at all, primarily because the technology was so simple, it was apparent from his *voir dire* (A1227-1229) that he was, at best, only marginally and minimally qualified to testify. Further, and most importantly, it was evident (and held in the ID at A0030-31 and A0051-52) that his testimony regarding, among other things, claim construction and alleged infringement under the doctrine of equivalents should be given little weight.

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<sup>3</sup> Five witnesses testified on behalf of SMC including its technical expert, Dr. David Trumper, a mechanical engineering professor at MIT.

## **G. The ALJ's Initial Determination**

### **1. The Infringement Issue**

As noted above, the ALJ found no infringement. (A0003-85). Regarding the construction of the disputed claim term “generally rectangular ported flange,” the ALJ considered the ‘392 claims, specification, and prosecution history and construed this claim term to mean “a flange of rectangular shape with projections on all four sides and a hole in the middle that is used as a port.” (A0020-34). The ALJ determined that SMC’s connector is not adapted to connect a fluid-flow element having “a generally rectangular ported flange” as required by claim 1, and thus did not infringe any claim of the ‘392 patent, either literally or under the doctrine of equivalents. (A0046-48; A0051-52).

As to the “pivotally mounted” limitation which SMC asserts as an alternative basis to support the ITC’s “no violation” determination, the ALJ stated that “pivotally mounted” means “placed or fastened in [a] way that allows an object to move about a point.” (A42). The ALJ stated that a “hinge-like mounting with no loose parts is not required.” *Id.* The ALJ’s construction of “pivotally mounted” is erroneous because it ignores the design goal set forth in the ‘392 patent of a connector with no loose parts susceptible of being lost by the user and, further, ignored the testimony from SMC’s expert that a person of ordinary skill in the art would understand pivotally mounted to mean hinged with no loose parts. If

the phrase “pivotally mounted” is construed to require a hinged connection (no loose parts), it is not disputed that SMC’s connector does not infringe.

## **2. The Invalidity Issue**

As to invalidity which SMC asserts as an alternative basis to support the ITC’s “no violation” determination, the ALJ determined (at A0058-61) that the ‘392 patent was not invalid as obvious. However, the ALJ failed to adequately consider the undisputed trial testimony, including the testimony from Norgren’s own expert, that the connector described in the ‘392 patent is only a combination of old elements with no new or unpredictable result and a hinged connector (no loose parts) is disclosed in the prior art. The ALJ’s determination in this respect is, therefore, contrary to the seminal case on obviousness, *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007).

Although the ALJ found that the claims were not obvious, he indicated that this was only because he adopted SMC’s construction for the term “generally rectangular ported flange” which resulted in a finding of non infringement. (A59-60). The ALJ inferred that, if Norgren’s proposed broad construction of “generally rectangular ported flange” were adopted (the construction Norgren asserts in its brief), the claims of the ‘392 patent would have been obvious.

## SUMMARY OF THE ARGUMENT

The ITC's determination of no violation is supported by substantial evidence and should be affirmed. The ITC's determination that SMC's connector is not adapted to receive a rectangular ported flange as required by claim 1 (and the remainder of the asserted claims) is supported by substantial evidence. Further, the ITC's construction of "a rectangular ported flange" is correct, *i.e.*, the flange must be rectangular and it must be ported.

As an alternative ground for supporting the ITC's determination of no violation, the "pivotally mounted" limitation should be construed to require a hinged connection (no loose parts) since the specification states that no loose parts is the design goal of the invention and each of the preferred embodiments includes such a connection. With this construction, there can be no infringement.

As a further alternative ground for supporting the ITC's determination of no violation, under *KSR*, the asserted claims would have been obvious. There is no dispute that the asserted claims are directed to a combination of old elements with no new or unpredictable result and the prior art discloses a hinged connector with no loose parts.

Norgren's brief includes many new arguments which were not presented to the ITC in Norgren's petition to review the ALJ's initial determination (many were also not even presented to the ALJ). The ITC cannot be faulted for not reviewing

arguments that were not presented to it. These new arguments should not be considered.

## **ARGUMENT**

### **A. Standard of Review**

Although this Court “review[s] *de novo* the ITC’s legal determinations, including those relating to claim interpretation and patent validity” (*Checkpoint Sys., Inc. v. Int’l Trade Comm’n*, 54 F.3d 756, 760 (Fed. Cir. 1995)), factual findings must be upheld if supported by substantial evidence. *Corning Glass Works v. Int’l Trade Comm’n*, 799 F.2d 1559, 1566 (Fed. Cir. 1986). Substantial evidence “is the same as the stringent standard applicable to a trial court in taking a case from a jury or in review of a jury verdict” and is satisfied by “such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Id.*

### **B. The ITC Correctly Found That There Was No Infringement**

The ALJ correctly found that SMC’s connectors do not connect generally rectangular ported flanges and, therefore, cannot infringe either literally or under the doctrine of equivalents. SMC asserts as an alternative basis to support the ITC’s “no violation” determination that the “pivotally mounted” limitation should be construed to require no loose parts since the ‘392 specification states that this goal is the primary purpose of the ‘392 invention.

## **1. The ALJ Correctly Concluded That SMC's Connector Is Not Adapted to Receive a Generally Rectangular Ported Flange**

The ALJ correctly construed the claim term “a generally rectangular ported flange” and properly concluded that the asserted claims are not infringed either literally or under the doctrine of equivalents.

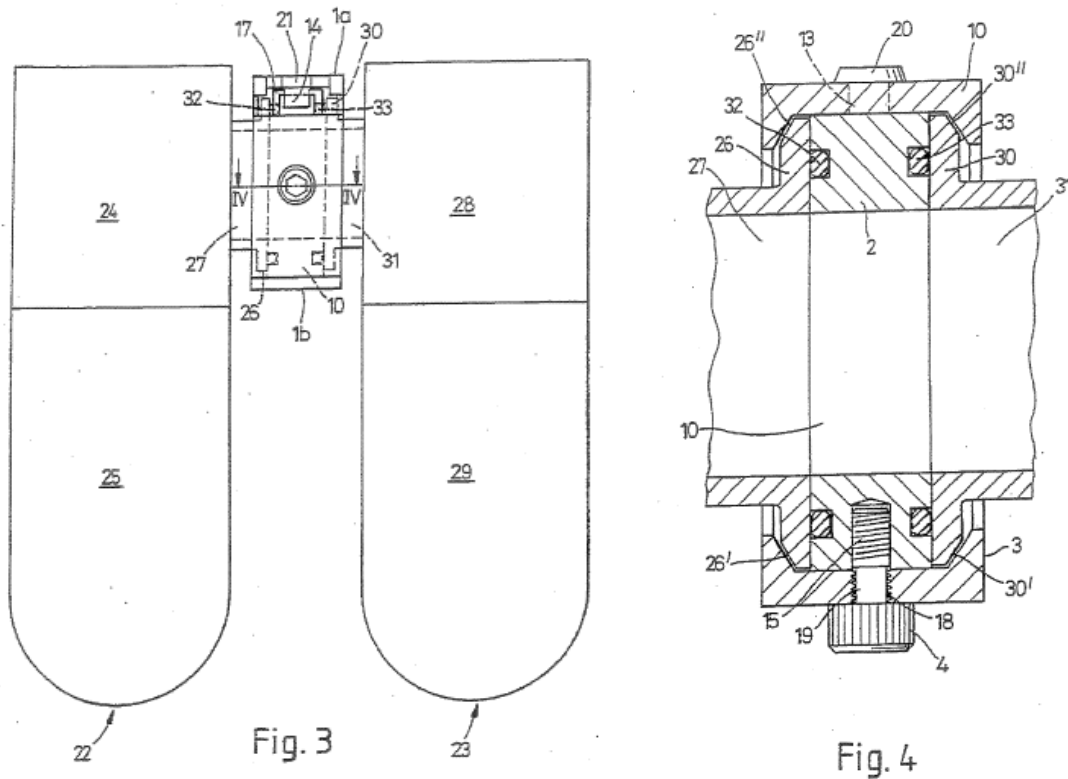
As stated in the ID (at A27), the claim term “a generally rectangular ported flange” should be construed to mean “a flange of rectangular shape with projections on all four sides and a hole in the middle that is used as a port.” The ‘392 specification does not impart any special meaning to this claim term. Rather, the specification states with reference to figures 1 and 2 that the rectangular clamp surrounds the periphery of a generally rectangular ported flange which is received by the clamp:

[t]he sections 1a, 1b and 1c define, internally, respective channels 5, 6, 7 the walls of which, in use, receive between them and the spacer 2 the periphery of a *ported, rectangular flange* formed on each of the conditioning units to be joined together...

(A2005, col. 2:41-46, emphasis added; *see also* A2001 (Fig. 1.)). Figures 3 and 4 show the rectangular ported flanges (26 and 30) from a front view (figure 3) and a top view (figure 4). *Id.* These figures, reproduced below, show that the generally rectangular ported flange has projecting rims on the top and bottom (figure 3) and on the front and rear (figure 4), for a total of four projections to form a rectangle.

*Id.*

**Figures 3 and 4 of the '392 Patent Showing A Generally Rectangular Ported Flange Having Four Projecting Rims (26, 26', 30, and 30')**



SMC's expert, Dr. Trumper, testified that, as used in the '392 patent, a person of ordinary skill in the art would understand a generally rectangular ported flange to be rectangular in shape and to have projecting rims on each of the four sides (to form a rectangle) and a hole in the middle. (A1601; *see also* A24). This construction stays true to the claim language and most naturally aligns with the patent's description of the invention. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005) (*en banc*); *see also SafeTCare Mfg. Co. v. Tele-Made, Inc.*, 497 F.3d 1262, 1269-70 (Fed. Cir. 2007) (specification relied on to understand what the

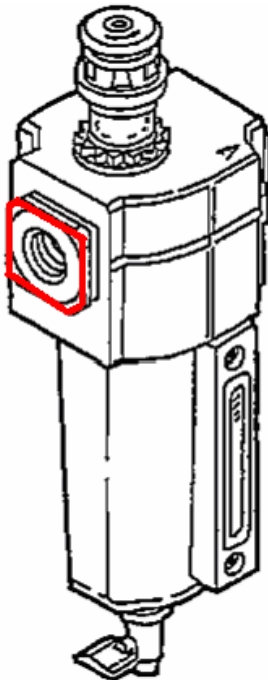
patentee had claimed and disclaimed); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) (the specification “is the single best guide to the meaning of a disputed term” and is usually dispositive).

Moreover, this construction is consistent with the positions taken by Norgren during prosecution. Specifically, Norgren amended claim 1 to more restrictively define each fluid-flow element as “including a generally rectangular ported flange.” (A2083-2089). Thus, Norgren cannot now argue that the term “a generally rectangular ported flange” covers flanges that are not generally rectangular or are not ported. *See Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1323-28 (Fed. Cir. 2003) (holding that a claim cannot be construed to encompass subject matter that was disavowed during prosecution to obtain allowance).

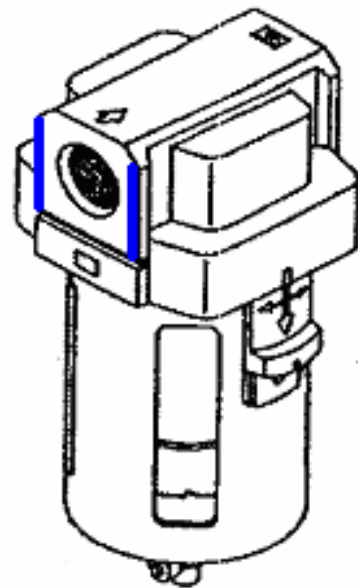
In contrast, Norgren’s expert Wiskamp proffered only a construction that he based on “jargon for [the] industry.” (A1442; *see also* A30). Norgren’s “jargon-based” construction is improper because it ignores the context of the claims and the intrinsic evidence of the ‘392 patent. *Phillips*, 415 F.3d at 1313. Further, Wiskamp did not cite to the ‘392 patent and, further, did not review or even understand whether the prosecution history was inconsistent with his construction. (A1428).

Since SMC's connector is not adapted to connect fluid-flow devices having rectangular flanges, but rather, is adapted to engage mounting ears on SMC's fluid-flow devices (A46-48; *see also* A1605-1607), there cannot be any infringement. The reproduced figures below highlight the differences between SMC's mounting ears and the generally rectangular ported flange of the '392 patent.<sup>4</sup>

#### **A Generally Rectangular Ported Flange**



#### **SMC's Mounting Ears**

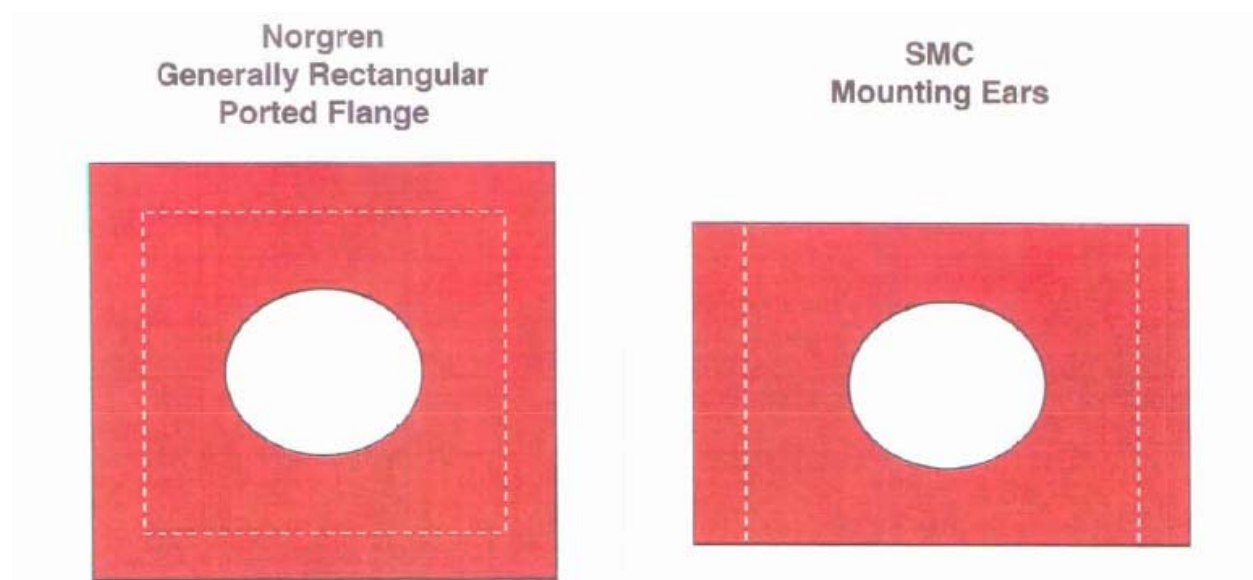


The differences between the “generally rectangular ported flange” described in the '392 patent and the “mounting ears” of SMC's FRL units was explained by

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<sup>4</sup> Photographs of a Norgren connector and the FRL units to which it connects (A7018-7020), a SMC 2003 connector and the FRL units to which it connects (A7013-7017) and a SMC 1984 connector (A7011-7012) (which connects to the same SMC FRL units as the 2003 connector) will be included in the joint appendix. Further, counsel for SMC expects to use one or more of these physical exhibits at oral argument.

Dr. Trumper using the demonstrative RDX-1 (A7010) reproduced below. (A1606-1607). The dotted lines indicate the inner periphery of the claimed generally rectangular ported flange and the inner periphery of SMC's mounting ears. As Dr. Trumper noted, the projecting rims of the generally rectangular ported flange is the area that one can put one's "fingernails behind." (A1604).



Notably, SMC's 2003 connector is designed to be interchangeable with SMC's 1984 connector in that both connectors are designed to engage SMC's FRL units having two mounting ears, no matter when manufactured. (A1578).

Revealingly, Norgren admits, albeit unintentionally, in its brief (at 5) that SMC's mounting ears and connectors cannot infringe since Norgren states that "[t]he connecting devices made and imported into the United States by SMC employ a *uniquely formed* receptor so that only SMC fluid-flow air compression units

(modular FRL units) will fit the connectors.” Emphasis added. The claim term “generally rectangular ported flange” cannot be met by mounting ears that have no projections on the top or bottom. (A1605-1607).<sup>5</sup>

Accordingly, SMC’s 2003 connector is not adapted to connect fluid-flow elements having generally rectangular ported flanges as required by claim 1 of the ‘392 patent and, therefore, SMC’s 2003 connector cannot infringe.

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<sup>5</sup> Norgren argues in its brief (at 33) that CPX-8 “proves that [the] SMC connector is also adapted to engage this type of flange,” *i.e.*, a flange with four projecting rims. This argument is baseless. CPX-8 was fraudulently and deceptively modified by Norgren by machining the flange to make it smaller to try to fit it into an SMC connector. Norgren then camouflaged the machining of the flange by re-painting it since the machining had removed the paint. When confronted with the fraudulently modified FRL, Wiskamp testified that he did not do the machining, he did not know who did it, he did not know what the modifications were, and he had no idea why the modification was camouflaged by re-painting the flange. (A1433-1436). Norgren offered no other testimony regarding CPX-8. The ALJ found that “[t]his exhibit and Norgren’s related testimony have no probative value” because Norgren was unable to explain how the Norgren FRL unit was modified, who made the modification, or why the FRL had been repainted. (A46-47). The ALJ also found that, because Norgren had to modify the Norgren FRL unit in order to attach it to SMC’s connector, “[t]his modification demonstrates that the connector is not in fact adapted to engage a generally rectangular ported flange.” (A47).

Norgren also waived this argument concerning infringement since, in its petition to review the ALJ’s ID, Norgren made no argument whatsoever that the SMC connector would infringe under the ALJ’s construction of “generally rectangular ported flange,” and did not even mention CPX-8. Accordingly, this argument has been waived, and should not be considered. *Broadcom Corp. v. Int’l Trade Comm’n*, 542 F.3d 894, 900-901 (Fed. Cir. 2008).

## **2. The ALJ Correctly Concluded That SMC's Connector Does Not Infringe Under the Doctrine of Equivalents**

The ALJ correctly concluded (at A51) that Norgren failed to carry its burden of proof on the doctrine of equivalents. Norgren presented no testimony, let alone the particularized testimony or linking argument on a limitation-by-limitation basis, as is required. *See Motionless Keyboard Co. v. Microsoft Corp.*, 486 F.3d 1376, 1382-83 (Fed. Cir. 2007). Moreover, Norgren's expert Wiskamp acknowledged that he did not understand the difference between literal infringement and infringement under the doctrine of equivalents. (A1431-1433; A51-52).

In addition, the ALJ correctly concluded (at A49-52) that Norgren is estopped from asserting doctrine of equivalents infringement as to the "generally rectangular ported flange" limitation under *Festo* since there was a narrowing amendment with no attempt to rebut the *Festo* presumption. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 122 S.Ct. 1831, 1842 (2002).

More particularly, original claim 1 was rejected by the examiner under § 112 because it was unclear as to whether the FRLs were part of the claimed combination. (A2037). In response, Norgren amended claim 1 to add, *inter alia*, the generally rectangular ported flange limitation. (A2083).

In its brief (at 33-34), Norgren ignores its lack of any attempted proof and, instead, relies upon attorney argument, which is improper. *See Estee Lauder, Inc.*

*v. L'Oreal, S.A.*, 129 F.3d 588, 595 (Fed. Cir. 1997) (arguments of counsel cannot take the place of evidence lacking in the record).

### **3. The ALJ Incorrectly Concluded That SMC's Connector Has A Pivotaly Mounted Side**

As an alternative basis for supporting the judgment, SMC submits that the ALJ (and ITC) should have construed the claim term “pivotaly mounted” to require no loose parts (a hinged connection) as emphasized in the ‘392 specification. The ALJ construed “pivotaly mounted” to mean “placed or fastened in [a] way that allows an object to move about a point” (A42) and stated that a “hinge-like mounting with no loose parts is not required.” *Id.* However, this construction is erroneous because the design goal of the ‘392 invention is a connector with no loose parts susceptible of being lost by the user. (A2005, col. 1:4-36). Specifically, the ‘392 specification states in the Background of the Invention that the problem addressed by the invention is that prior art connectors include loose parts that may be lost:

Several connecting means have over the years been developed and commercialized but, whilst technically satisfactory, many have been relatively expensive to produce and/or have consisted of *loose parts that have to be assembled by the user, some of which are susceptible to being lost.*

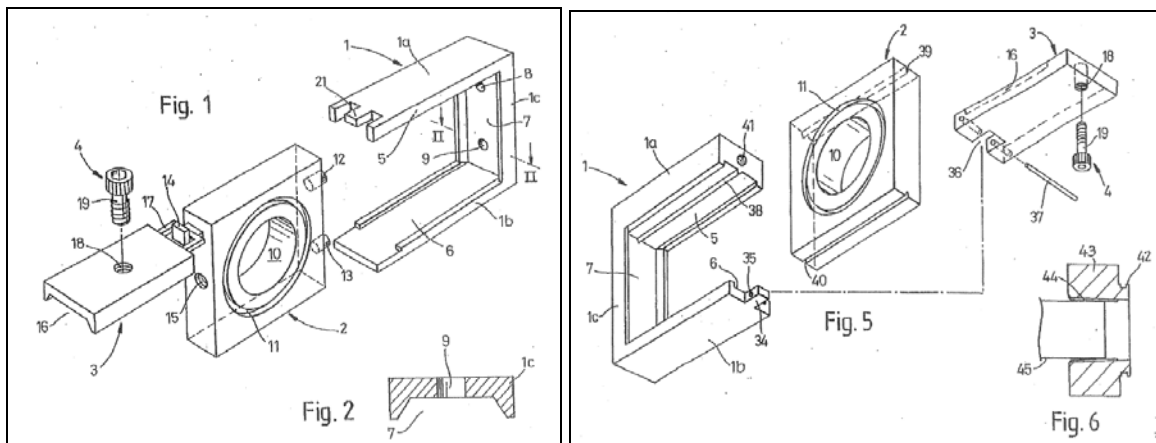
(A2005, col. 1:26-31) (emphasis added).

To address this problem, the ‘392 inventors designed a unitary rectangular clamp that included a hinged side that could open and close without any possibility

that it could become separated and become a loose part which could be lost. (A2005, col. 1:38 – col. 2:8). Specifically, the Summary of the Invention describes the invention as a connector that “has no loose parts that might otherwise get lost by the user.” (A2005, col. 2:7-8). In furtherance of this objective, and as acknowledged by the ALJ (at A40 n.18), the connector is consistently described throughout the ‘392 patent as including a side that “is pivotally mounted on the spacer or on an adjacent side of the clamp by means of a *hinge-like mounting*.” (A2005, col. 2:1-4, emphasis added; *see also* A2006, col. 3:65 (“hingedly mounted”); A2006, col. 4:14 (“hinge-like fashion”)). The Background of the Invention and Summary of the Invention make clear that the pivotally mounted side is hinged (or hinge-like) so that there are no loose parts. *See SafeTCare Mfg. Co. v. Tele-Made, Inc.*, 497 F.3d 1262, 1269-70 (Fed. Cir. 2007) (construing claims in view of statements made in “Background” and “Summary” sections so as to understand what was claimed and disclaimed).

The ‘392 specification describes two embodiments of a hinged side for a rectangular clamp, shown in figures 1 and 5 (reproduced below), in each of which the fourth side (3) is mounted so that it cannot fall off and become a loose part. (A2005-2006, col. 2:32 – col. 4:42; A 2001, 2004 (Figs. 1, 5); A1610).

**Figures 1 and 5 of the '392 Patent Showing Pivotally Mounted Fourth Side (3)**



It would be directly contrary to the '392 specification for the connector to have a removable part. Sole independent claim 1 of the '392 patent recites that the clamp has one side that is “pivotally mounted.” No other language in claim 1 is directed to the feature that the connector has no loose parts. Further, Norgren’s expert Wiskamp did not disagree with the testimony of a '392 inventor that the term “pivotally mounted” in claim 1 means hinged. (A1735-1738).

The ALJ’s erroneous construction arose from his incorrect conclusion that figure 1 does not show a hinge-like mount. The ID states (at A40) that the “device depicted in Figure 1 [] utilizes ‘a generally U-shaped stirrup 17 pivotally hung on the L-shaped projection 14,’ attached to a spacer (labeled as item 2).” However, the ALJ failed to consider that, when the connector is assembled, the projection 21 on the three-sided generally U-shaped member 1 will entrap the U-shaped stirrup 17 by covering and coming into contact with the L-shaped projection 14 to provide a hinge like mounting. There is no '392 embodiment that includes a “pivotally

mounted” side *other than* one with a “hinge-like mount with no loose parts.” A construction that is contrary to the preferred embodiments “is rarely, if ever, correct and would require highly persuasive evidentiary support, which is wholly absent in this case.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996).

To further support his construction of “pivotally mounted,” the ALJ (at A41-42) relies on claim differentiation without recognizing the significant limits of this doctrine. The doctrine is not a hard and fast rule of construction, and cannot be used to broaden claims beyond their correct scope which must be determined in light of the specification. *Seachange Int’l, Inc. v. C-Cor Inc.*, 413 F.3d 1361, 1368-69 (Fed. Cir. 2005). Here, since the specification compels a construction precluding a loose part, the *limited* claim differentiation doctrine cannot compel a contrary conclusion.

Further, to construe “pivotally mounted” to be a “hinge-like mount with no loose parts” does not render claims 5 and 7 superfluous. Claim 5 differs in scope from claim 1 because it further describes, *inter alia*, the coating means for capturing the fourth side. (A1661). Similarly, claim 7 differs in scope from claim 1 because it specifies a mounting point for the fourth side. (A1636-1637).

If the claim term “pivotally mounted” is properly construed, there can be no infringement. (A1610-1611). SMC’s connector does not have a hinge-like mount

but, to the contrary, has a loose part that is designed to be loose. (A1611). Taku Tomita, the designer of SMC's 2003 connector, testified that the front retainer clip (2) is designed to be removable to facilitate insertion of FRL units into the front of the connector. (A1578-1580; 1610-1611).

### **C. The ITC Incorrectly Concluded That the '392 Invention Would Not Have Been Obvious**

As a further alternative basis for supporting the judgment, SMC also submits that the ALJ (and ITC) should have found that the subject matter of asserted claims 1-5, 7, and 9 would have been obvious. The ALJ's validity finding fails to adequately consider the undisputed testimony that the '392 connector is only a combination of old elements with no new or unpredictable result and the design goal of the '392 patent (no loose parts) is plainly shown by the prior art Palatchy patent. *See KSR*, 127 S. Ct. 1727 (2007).

#### **1. The ALJ Incorrectly Concluded That the Asserted Claims Are Not Merely a Combination of Old Elements With No New Result**

The ALJ acknowledged (at A60) that the elements of claim 1 were known in the prior art in, for example, Abbes and Palatchy, and that "[i]t might be tempting to suggest that one skilled in the art would have modified Abbes in view of Palatchy to arrive at the connecting structure of claim 1." The ALJ failed to do so, however, because "both of those references were before the examiner during prosecution." *Id.* However, the examiner did not have the benefit of Trumper's

testimony or Wiskamp's cross-examination and, in any event, the examiner does not have the final word on validity. *Iron Grip Barbell Co. v. U.S.A. Sports, Inc.*, 392 F.3d 1317, 1319 (Fed. Cir. 2004) (claims held obvious over prior art considered during prosecution).

The examiner did not apply the correct obviousness standard under *KSR* but, rather, rigidly applied the teaching-suggestion-motivation ("TSM") test. (A2083-2092, issuing a Notice of Allowability after Norgren's argument that "the invention ... is neither *taught* nor *suggested* by the combination of references cited by the Examiner") (emphasis added). The holding in *KSR* rejected a rigid application of the TSM test. *KSR* at 1742-43 ("Rigid preventative rules that deny factfinders recourse to common sense, however, are neither necessary under our case law nor consistent with it.").

The ALJ failed to follow the *KSR* admonition that "[t]he combination of *familiar* elements according to *known* methods is likely to be obvious when it *does no more than yield predictable results*."<sup>6</sup> 127 S.Ct. at 1739 (emphasis added).

Further, Norgren never asserted any new or unpredictable result. In fact, Norgren

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<sup>6</sup> Since *KSR*, this Court has held that a patent claim directed to a combination of known elements with no new or unpredictable result would have been obvious. *See, e.g., Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1163 (Fed. Cir. 2007); *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007).

did not even cross-examine Dr. Trumper as to the prior art. Nor did Norgren have Wiskamp testify to any deficiencies in the prior art.

The ALJ stated that the prior art does not disclose a four-sided generally rectangular clamp adapted to engage a generally rectangular ported flange. However, Abbas, a circular clamp (two clamshell halves to receive circular flanges), states that the clamp “can have different constructional shapes” (A5004, col. 3:54-57) and the examiner stated (and Norgren did not disagree) that “the rectangular shape is common in the pipe joint field.” (A2038).

Dr. Trumper testified that it would have been obvious to use a rectangular shape (or another shape like a circular shape) for the flange (A1618-1619) as a simple matter of design choice. (A1624; 1627; and 1613-1614). As set forth in *KSR*, “design incentives and other market forces can prompt variations” of the prior art. 127 S.Ct. at 1740. Moreover, the “person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 1742. “When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.” *Id.*<sup>7</sup> Further, Norgren

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<sup>7</sup> In *In re Sovish*, 769 F.2d 738 (Fed. Cir. 1985), this Court affirmed an obviousness rejection because the difference between what was taught by the prior art and the claim was simply a “matter of design choice.” *Id.* at 741; *see also In re Kuhle*, 526 F.2d 553, 555 (CCPA 1975) (since the placement of a contact provided

states in its brief (at 12) that “flanges of the type described [in the ‘392 patent] were well-known in the art.”

Further, there was significant testimony as to whether in 1993, if it were desired to have no loose parts, it would have been obvious to add a hinge to SMC’s 1984 connector. As the ALJ acknowledged (at A58-60), this was an appropriate inquiry since Wiskamp acknowledged during cross-examination that SMC’s 1984 connector contained all of the elements of claim 1 except for the pivotally mounted side. (A1331-1346).

There was no assertion by Norgren that it had discovered the cause of a problem. More particularly, if there were a loose parts problem, the user would have been aware of the problem and its solution (a hinged connection) would have been obvious. (A1612-1614). Palatchy specifically discloses such a hinged connection. (A1617-1618). The ITC Staff stated that “[t]he evidence at trial also showed that in 1993 the use of a hinge to pivotally mount one side of the clamp was well within the capabilities of one skilled in the art.” (A3251).<sup>8</sup>

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no novel or unexpected result, it was “an obvious matter of design choice within the skill of the art”).

<sup>8</sup> Wiskamp stated without any attempted justification whatsoever that it would not have been obvious to add the hinge. (A1362) (“But with my deep understanding, when I saw it for the first time, it was very unique, and it was something that I would not have considered. From my perspective, it is not at all obvious.”). However, his testimony on this point should be given little weight because he has no qualifications as an engineer. He never took an engineering course, and has been in a sales position for the last 18 years. (A1227-1229).

*KSR* held that “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions,” 127 S.Ct. at 1740, and emphasized that common sense is paramount in making such a determination. “Common sense teaches, however, that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *Id.* at 1742.

The ALJ incorrectly stated (at A61) that a patent challenger *must* identify a “reason” to make the combination. The ALJ cites *PharmaStem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342 (Fed. Cir. 2007). However, in *PharmaStem*, this Court reversed the jury verdict and held the two patents in suit invalid as obvious while further stating “*see also KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740 (a combination of elements ‘must do more than yield a predictable result’ ... ).” *PharmaStem*, 491 F.3d at 1360. Thus, this Court’s statement in *PharmaStem* concerning a “reason” for the combination was not intended to detract from *KSR*’s holding that, to be nonobvious, a combination of elements “must do more than yield a predictable result.”

Moreover, *KSR* did not state that such a “reason” *must* be provided to prove obviousness. In fact, *KSR* stated just the opposite. “Helpful insights, however, need not become rigid and mandatory formulas ...” *Id.* at 1741 (emphasis added).

As to the asserted dependent claims, the ALJ noted that Norgren did not assert patentability independent of claim 1 (A62) and concluded that “if claim 1 were found to be obvious, all of the asserted dependent claims should similarly be found invalid.” *Id.*

The ALJ also found that Norgren’s arguments concerning secondary considerations was “scant” and “entitled to little weight” (A62-64) and concluded that “[i]n the event that the prior art would have otherwise rendered the claims obvious, secondary considerations, or objective indicia of nonobviousness, would have provided little support for the validity of the claims.” (A64).

## **2. Norgren’s Proposed Construction of “Generally Rectangular Ported Flange” Renders the ‘392 Invention Even More Obvious**

As stated by the ALJ (at A59), Wiskamp admitted that “the only difference between prior art such as the old [1984] SMC connector and the claimed invention of the ‘392 patent is the fact that one side of the clamp pivots” and “[a]t the hearing, it was impossible for him to distance himself from that prior testimony.” The ALJ further stated that Wiskamp “had little choice but to make this admission in view of the fact that by the time of the hearing[,] Norgren’s proposed construction of the term ‘generally rectangular ported flange,’ and the four-side clamp limitation (including the ‘adapted’ nature of the clamp) had become extremely broad so as to capture the accused SMC devices.” The ALJ concluded that it would be permissible to look only to the “pivotally mounted” limitation of claim 1 to

determine whether the claim is valid, and, in fact, “if Norgren’s broad interpretation of claim 1 were adopted as the proper construction of the claim *there would be no choice but to do so.*” (A59-60, emphasis added). The next sentence of the ID states – “*However*, when the claim is properly construed to be more limited, . . . the record does not contain clear and convincing evidence of obviousness.” (A60, emphasis added).

Thus, as stated by the ALJ, if Norgren’s proposed construction were adopted, the obviousness issue would be reduced to determining whether it would have been obvious to use a hinged connection if it were desired to have no loose parts. In this regard, the ALJ found that Palatchy “discloses a clamp with a hinge-like connection capable of pivoting.” (A60). The ITC Staff agreed that “[t]he evidence at trial also showed that in 1993 the use of a hinge to pivotally mount one side of the clamp was well within the capabilities of one skilled in the art.” (A3251; *see also* A1617-1618). Accordingly, under Norgren’s proposed construction, the ALJ would have found the asserted claims obvious.

#### **D. Norgren’s New Arguments Were Waived and, In Any Event, Are Baseless**

##### **1. Norgren’s New Arguments Were Waived and Should Not Be Considered**

Norgren’s brief is rife with new arguments not presented below, and not included in its petition to the ITC to review the ALJ’s initial determination.

Norgren’s new arguments have been waived and should not be considered.

It is well settled that “[a] party seeking review in this court of a determination by the Commission must ‘specifically assert’ the error made by the ITC in its petition for review to the Commission.” *Finnigan Corp. v. Int’l Trade Comm’n*, 180 F.3d 1354, 1362 (Fed. Cir. 1999). The *Finnigan* court explained that “courts should not topple over administrative decisions unless the administrative body not only has erred but has erred against objection made at the time appropriate under its practice.” 180 F.3d at 1362-63. As Norgren tries here (*see* brief at 9), the appellant in *Finnigan* attempted to skirt the waiver issue by citing *Cybor Corp. v. FAS Technologies, Inc.*, 138 F.3d 1448 (Fed. Cir. 1998) and asserting that this Court should entertain its new claim construction arguments because claim construction is a question of law that receives *de novo* review on appeal. But this Court rejected *Finnigan*’s assertion and stated that “[a] party’s argument should not be a moving target.” *Finnigan*, 180 F.3d at 1363 (internal citations omitted). For the same reasons, this Court should not consider Norgren’s new claim construction arguments.

Norgren’s proposed claim construction for a “generally rectangular ported flange” has been a moving target since the investigation began. (A20-34). Consistent with this tactic, Norgren presents a fresh claim construction for this

term in its brief, this time based on new extrinsic evidence.<sup>9</sup> In its petition to the Commission, Norgren argued that “flange” means “any general connection feature used to join two faces together.” (A3422). Now, Norgren urges this Court (at 28 and 30) to adopt a new definition of “flange” as “a projecting piece to attach the item to something else.” This new construction was not presented below, and is based on a combination of dictionary definitions which was not relied upon below.

Norgren argues that this new combined dictionary definition “is consistent with the trial testimony of Norgren’s expert, John Wiskamp: *any general connection feature used to join two faces together.*” *Id.* (emphasis by Norgren). However, a new construction is not permitted irrespective of any alleged consistency. Moreover, there is no such consistency. Norgren’s new construction requires something to *project*, while Wiskamp’s proposed definition at trial, and the definition asserted in Norgren’s petition, do not require any such projection.

Norgren also argues (at 20-21) that the ‘392 prosecution history does not support the ALJ’s construction of “generally rectangular ported flange.” In

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<sup>9</sup> In its brief, Norgren (1) furnishes (at 18) a new dictionary definition for the term “periphery” that was not presented below; (2) provides (at 19) new terminology and arguments (including a colorization of the patent figures) for a portion of the flange (*i.e.*, “stems”) that extends outward from the body of the FRL; and (3) relies for the first time (at 30-32) on an unpublished 2004 decision from the U.S. District Court for the Southern District of Indiana. Because Norgren failed to raise these specific arguments before the ALJ or in its petition for review of the ITC’s initial determination, these arguments have been waived by Norgren, and this Court should not consider them. *Finnigan*, 180 F.3d at 1363.

particular, Norgren argues, again for the first time, that statements made by the applicant during prosecution, as well as the figures from the Hallman patent, demonstrate that the ALJ's construction was incorrect. However, this argument was not raised below, and was not raised in Norgren's petition to the ITC. Rather, Norgren's petition included only one sentence (A3425-3426) addressing the '392 prosecution history, stating merely that "the language from the prosecution history, *fit the clamp over the flanges* [is] a long way from a clear and unequivocal statement that all of the flange must fit inside the clamp." No argument based on the Hallman patent was presented.

Accordingly, because Norgren failed to raise these arguments below, the arguments are waived, and this Court should not consider them. *Finnigan*, 180 F.3d at 1363.<sup>10</sup>

## **2. In Any Event, Norgren's Arguments Are Baseless**

Norgren repeatedly asserts that the ALJ's construction of "a generally rectangular ported flange" is improper because it is based on the description of the invention set forth in the '392 specification. However, as held in *Vitronics*, the

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<sup>10</sup> Norgren also waived its argument (at 34-35) concerning infringement of claim 9 of the '392 patent. Specifically, Norgren argues in its brief (at 34) that claim 9 only adds that the "*fluid flow elements* that the patented clamp connects are *compressed air-conditioning units*." (emphasis by Norgren). However, in its petition to the ITC, Norgren made no argument whatsoever regarding SMC's alleged infringement of claim 9. Accordingly, this argument has also been waived, and should not be considered. *See Broadcom Corp.*, 542 F.3d at 900-901.

specification “is the single best guide to the meaning of a disputed term” and is usually dispositive. 90 F.3d at 1582.

Norgren separates its arguments concerning the construction of “generally rectangular ported flange” into two sections, one which it labels “intrinsic evidence” and the other which it labels “extrinsic evidence.”

#### **A. Norgren’s “Intrinsic Evidence” Arguments Are Baseless**

First, Norgren argues (at 15) that nothing in the claim language “compels the addition of four projecting rims.” This argument is specious because the ALJ was requested to construe the term “generally rectangular ported flange,” not “flange.” The ALJ’s construction did not *add* anything, such as four projecting rims – the ALJ merely defined the term in its proper context based on the intrinsic evidence.

Second, Norgren asserts (at 16) that the ALJ improperly reads the passage “reception of the flanges into the clamp” as requiring that the *entire* flange feature be encompassed by the parameters of the clamp. Notably, Norgren does not point to which portion of the ID that corresponds to this alleged error. If Norgren is referring to page 32 (A37) of the ID, that page states no such thing. Instead, this portion of the ID states (at A37) that “the clamp must be adapted so that it fits over the flanges of the FRLs,” and that this necessarily means that the four-sided clamp fits over all four sides of the flange. (A38). The claim language itself provides that the clamp “permit[s] reception of said flanges into the clamp,” which is

supported by and consistent with the ID. *Id.* (“There is nothing in the claim language, the specification, or the prosecution history (quoted above) to indicate that somehow a four-sided clamp fitting over a generally rectangular (*i.e.*, four-sided) flange could fit over only two sides of the rectangle, or how a rectangle could have only two sides.”).<sup>11</sup>

Third, Norgren offers (at 17) a variation of its second argument, asserting that the flanges in the preferred embodiments are not *entirely enclosed* within the clamp. However, as noted above, the ITC made no such finding and it is not a requirement of the claim construction. Norgren tries to elaborate on this argument (at 17-19) by (1) providing red shading to what it refers to as the “L” shaped segments of figures 3 and 4 of the ‘392 patent and labeling them “stems” (a term not used below and found nowhere in the ‘392 patent); (2) citing a portion of the ‘392 specification for the unremarkable fact that the body of the FRL has a rectangular connecting flange; and (3) citing to a new dictionary definition for “periphery” that was not presented below, all for purported support for the proposition that the flanges in the preferred embodiment extend out from the body of the FRL. This argument is irrelevant, new and wrong.

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<sup>11</sup> The ALJ also found (at A29) that “the ‘ported flange’ referred to in the claim must pertain to a structure greater than projecting rims to be engaged by the clamp.” Thus, the ALJ found that the generally rectangular ported flange includes not only the rims of the generally rectangular flange, but also the face, since the face is the portion of the flange that contains the port.

The ALJ correctly found that Norgren’s argument that the flange includes the “entire attachment feature” (which the ALJ noted was “vague”) cannot be correct since it would “include portions of the structure *behind the flange*, which are not received into the clamp” as the claim requires. (A32) (emphasis added). The ALJ further found that Wiskamp admitted that the flange is what is received into the clamp, consistent with the ALJ’s construction. (A32-33, n.16; A1441-1442).

Fourth, Norgren argues (at 20) that the ALJ misread statements made by the applicant during prosecution as requiring that the whole flange must be received by the clamp. As set forth above, this argument was not presented below and, therefore, has been waived. Further, it makes no sense. The ALJ cites to this portion of the prosecution history solely to point out that “the four-sided clamp must engage, or fit over, the flanges of the fluid flow elements, and in doing so it necessarily fits over all four edges of the generally rectangular flanges.” (A37). The ALJ further states that “[t]he applicants did not tell the examiner that the clamp fits over only part of the flange.” *Id.* In other words, the ALJ cites to this portion of the prosecution history for the unremarkable proposition that the four-sided clamp must fit over a flange having four sides, *i.e.*, projections. (A38).

Fifth, Norgren asserts (at 22) that the function of the flanges in the preferred embodiment only requires two of the four projecting rims. However, Norgren

claimed a generally rectangular ported flange, which necessarily means it has four projections. Further, Norgren acknowledges (at 10), as one of the key features of its “invention,” that “its rectangular shape kept the remaining units in the proper position until a repaired unit or replacement was put in place.”

Sixth, Norgren asserts (at 23) that “flange” is not specially defined in the patent. However, the relevant inquiry is the construction of “generally rectangular ported flange” in the context of the ‘392 patent. This term should be construed according to its ordinary and customary meaning to a person of ordinary skill in the art. Norgren, however, did not have Wiskamp testify as to the ordinary and customary meaning of this term. Rather, Wiskamp merely testified as to the meaning of “flange” based on the “jargon” of the industry. (A1442). In contrast, Dr. Trumper testified according to the principles in *Phillips* as to what “generally rectangular ported flange” meant to one of ordinary skill in the art in the context of the ‘392 patent.

Seventh, Norgren argues (at 24) that there is no disavowal of claim scope for the term “flange.” Again, that is not the appropriate inquiry – the issue is the proper construction of “generally rectangular ported flange” in the context of the ‘392 patent.

Eighth, Norgren argues (at 24) that the doctrine of claim differentiation supports its proposed interpretation. However, this argument is premised on the

flawed assertion that claim 1 of the ‘392 patent does not require a generally rectangular ported flange. As set forth above, both the claim language and the specification make clear that a generally rectangular ported flange includes projections on all four sides (a rectangle) that are received into the four-sided clamp. The only trial testimony regarding claim 4 came from Dr. Trumper. Specifically, he testified without challenge from Norgren that claim 4 differs in scope from claim 1 because it further describes that two sides of the clamp have internally tapered walls that engage the peripheral sections of the ported flanges. (A1634; A2007). Therefore, contrary to Norgren’s assertion, claim 4 is not superfluous under the ALJ’s construction. *See Curtiss-Wright Flow Control Corp. v. Velan Inc.*, 438 F.3d 1374 (Fed. Cir. 2006) (the *limited* doctrine of claim differentiation cannot be used to contradict the clear meaning of the claim as set forth in the specification).

In sum, the ALJ took the proper approach to construing “generally rectangular ported flange.” As set forth in *Phillips v. AWH Corp.*, “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.*” 415 F.3d at 1313 (emphasis added). Both the claim language and the specification make clear that the generally

rectangular ported flange includes projections on all four sides (a rectangle) that are received into the four-sided clamp.

### **B. Norgren's Extrinsic Arguments Are Baseless**

Norgren argues (at 25-26) that the intrinsic evidence is not sufficient for a proper claim construction, and extrinsic evidence must be considered. However, the ITC relied upon the intrinsic evidence to construe “generally rectangular ported flange” and there is no ambiguity necessitating any resort to extrinsic evidence. Further, none of the extrinsic evidence relied upon by Norgren supports its proposed construction.

First, Norgren argues (at 27-28) for a new combination of dictionary definitions, concluding that an appropriate definition for “generally rectangular ported flange” is “a projecting piece to attach the item to something else.” As set forth above, this proposed combination of dictionary definitions is new and should not be considered.

Further, Wiskamp agreed that “a projecting rim” was a fair definition for “flange”. (A1370). Norgren’s original dictionary definition (and the one it offered at the hearing) plainly supports the ALJ’s construction since a projecting rim that is generally rectangular would necessarily project on all four sides of the rectangle. Further, even if a flange is “a projecting piece to attach the item to something else,” a generally rectangular flange projects on all four sides. Also, the ALJ found

that, since the clamp must be four-sided, the flange is engaged on all four of its sides by the clamp. (A34). Thus, Norgren's new combined dictionary definition would not dictate a different result.

Second, Norgren contends (at 28) that the ALJ incorrectly relied upon Dr. Trumper's testimony concerning "generally rectangular ported flange." However, Dr. Trumper provided the meaning of the term to a person of ordinary skill in the art based on the context of the '392 patent. *See Phillips*, 415 F.3d 1313. Thus, Norgren's argument is baseless.

Norgren further argues (at 29) that Dr. Trumper testified that the prior art Ribble patent discloses a generally rectangular ported flange. However, as acknowledged by the ALJ (at A24-25), Dr. Trumper did nothing of the sort. He testified that Ribble discloses a three-sided clamp, and "[i]f you wanted to add a *flange projecting rim on the top and bottom of Ribble* and then add a fourth side that hinges, all of those would be standard mechanical design choices." (A1621, emphasis added). Thus, Dr. Trumper testified that a four-sided generally rectangular flange would be an obvious variation over the Ribble device if it were desired to have a four-sided clamp. Dr. Trumper did not testify that Ribble discloses a "generally rectangular ported flange." Rather, he testified to the contrary. (A24-25).

Third, Norgren relies (at 30-31) for the first time on an unpublished decision in *Stant Mfg., Inc. v. Gerdes, GMBH*, 2004 U.S. Dist. LEXIS 27704 (S.D. Ind. Sept. 27, 2004). This is a new argument not presented below and, therefore, should not be considered. Further, Norgren's reliance upon *Stant* is misplaced. In *Stant*, the district court construed the disputed term "flange" (not the term "generally rectangular ported flange") by relying predominantly on competing dictionary definitions offered pursuant to this Court's holding in *Texas Digital Sys. Inc. v. Telegenix, Inc.*, 308 F.3d 1193 (Fed. Cir. 2002). *See Stant* at \*15-16. However, the claim construction methodology set forth in *Texas Digital* was rejected by this Court's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1319-22 (Fed. Cir. 2005) (determining that the *Texas Digital* claim construction methodology "placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution history"). Indeed, Norgren's assertion (at 30) that its construction "mirrors" the analysis in *Stant* indicates that Norgren's construction fails to comply with the controlling *Phillips* standard.

Moreover, *Stant* does not support Norgren's position. First, the disputed term in this case is "a generally rectangular ported flange," not "flange." Second, the accused infringer's argument in *Stant* to limit the definition of "flange" to "disc-shaped structures" was rejected because, *inter alia*, this construction was

inconsistent with the intrinsic evidence. *Stant*, at \*16. Here, in contrast, the ALJ’s construction of “a generally rectangular ported flange” is consistent with and based on the intrinsic record. Third, *Stant*’s construction of “flange” was “a projecting rim . . .” (*Stant*, at \*20), which is consistent with the ALJ’s construction (and, in fact, is the construction that Norgren now argues against). Fourth, Norgren argues (at 31) that the court in *Stant* “invoked the doctrine of claim differentiation, finding a more specific shape in a non-asserted claim raising a presumption that the more general use of *flange* in the independent claims did not require that specific shape.” (emphasis by Norgren). However, in *Stant*, the court used the limited doctrine of claim differentiation to reject a dictionary definition for “flange” because it was inconsistent with another asserted claim. *Stant*, at \*14, 19-20. No such argument is present here.

### **C. Norgren’s Claim 9 Arguments Are Baseless**

Norgren half-heartedly argues (at 34-35) that claim 9 covers not only the SMC connector, but also the FRLs that it connects. As set forth *supra*, Norgren did not make this argument in its petition to the ITC and, therefore, the argument has been waived.

Further, Norgren’s argument is baseless. Each of the claims of the ‘392 patent (independent claim 1 and dependent claims 2-9) is restricted to a

“connecting structure” (connector) and none is directed to or includes the FRLs to be connected. (A1074-1075; A1637).<sup>12</sup>

Notably, during prosecution, Norgren emphasized to the examiner that the FRLs are not part of the claimed combination:

[C]laim 1 defines connecting structure for connecting together a pair of fluid flow elements. As is clearly defined in claim 1, the connecting structure comprises a clamp adapted to engage the pair of ported flanges of the fluid flow elements. *The fluid flow elements [FRLs] and flanges [of the FRLs] defined in the preamble of claim 1 are not part of the claimed combination.*

(A2086, underlining in original, italics added for emphasis). Claim 9 of the ‘392 patent depends from claim 1 but adds only the minimal distinction that the fluid flow elements referenced in claim 1 are “air-conditioning” units.

Norgren’s attempt to improperly expand the scope of claim 9 to include the FRLs that can be connected is contradicted by the plain language of claim 9 and, further, by Norgren’s clear statement to the examiner that its fluid flow elements (claim 1) or its fluid flow elements which are further defined as air-conditioning units (claim 9 depending from claim 1) “are not part of the claimed combination.” Indeed, as recognized by the ALJ (at A52-55), Norgren cited to no support for a

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<sup>12</sup> In claim 9 as originally filed, not claim 9 as rewritten and subsequently issued, Norgren positively recited the FRLs in combination with the connector. However, Norgren amended this claim so as to not recite the FRLs as part of the claimed combination but, rather, to depend from claim 1 which is directed only to a connector. This change was made at the same time it told the examiner that the FRLs are “not part of the claimed combination.” (A2083-2089; A1718-1720).

broader reading of claim 9, and if such construction were adopted, claim 9 would likely run afoul of § 112 for lack of support in the specification.

### CONCLUSION

For the foregoing reasons, the ITC's finding of no violation should be affirmed.

Dated: December 23, 2008

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that two copies of the foregoing BRIEF OF INTERVENORS SMC CORPORATION AND SMC CORPORATION OF AMERICA were served by overnight courier, next day delivery, this 23rd day of December, 2008 on counsel for appellant Norgren, Inc. and counsel for appellee International Trade Commission as follows:

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## CERTIFICATE OF COMPLIANCE

Pursuant to Fed. R. App. P. 32(a)(7)(C), I certify that the word count of the word processing software used to prepare this brief is 10,867 words.

Dated: December 23, 2008

  
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