

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF IOWA
CENTRAL DIVISION

STEVEN W. SABASTA and SIOUX	*	
FALLS INSULATION SUPPLY, INC., a	*	4:06-cv-180
South Dakota corporation, d/b/a SIOUX	*	
CITY INSULATION & SUPPLY, INC.,	*	
	*	
Plaintiffs,	*	
	*	
v.	*	
	*	
BUCKAROOS, INC.,	*	
	*	ORDER
Defendant.	*	
	*	

Before the Court is Defendant's, Buckaroos, Inc. ("Defendant" or "Buckaroos"), Motion for Summary Judgment of Non-Infringement of Claim 23, filed May 29, 2009. Clerk's No. 110. Plaintiffs, Steven W. Sabasta and Sioux Falls Insulation Supply, Inc. ("Plaintiffs" or "Sabasta"), filed a resistance to the motion on July 1, 2009. Clerk's No. 137. Buckaroos filed a Reply on July 22, 2009. Clerk's No. 182. The matter is fully submitted.

I. FACTUAL BACKGROUND

Plaintiffs filed the present action for patent infringement on April 17, 2006. Clerk's No. 1. Plaintiffs' Complaint alleges that Sabasta is the original inventor of a roll-bending die used to make saddles for pipe insulation. Compl. ¶ 2. Sabasta was granted United States Patent No. 6,751,995 ("the '995 Patent") on June 22, 2004. According to the Complaint, Defendant has commercially exploited Sabasta's invention since March 2005 "by manufacturing and selling

certain pipe insulation saddles¹ that were made with a process that infringes upon the ‘995 Patent.” *Id.* ¶ 7.

On July 18, 2008, the Court denied motions for summary judgment filed by both parties with regard to Buckaroos’ claim that the ‘995 Patent is invalid, but it granted Plaintiffs’ request for summary judgment on the question of whether Buckaroos could assert the First Inventor defense, pursuant to 35 U.S.C. § 273. Clerk’s No. 97. On February 13, 2009, the Court entered an order construing the following language in Claim 23 of the ‘995 Patent:²

A roll bending die for being used with a roll bending machine for producing rib reinforced rolled material, the roll bending die comprising . . . a pair of clamp members selectively engaging an end face of each of said opposing ends of said body members, each of said clamp members being adapted for engaging the roll tube of the roll bending machine such that said clamp members are for securing said body member to the roll tube of the roll bending machine.

Clerk’s No. 106 at 3. The Court’s final determination on the construction of Claim 23 was that Claim 23 would be read as follows:

[T]wo clamps, which are able, at the operator’s discretion, to engage an end face of each of the opposing ends of said body member, each of the clamps is designed to engage the roll tube of the roll bending machine, such that the clamp members function to secure the body member to the roll tube of the roll bending machine.

Id. at 14. Buckaroos now requests partial summary judgment with respect to Claim 23.

Specifically, Buckaroos requests that the Court rule as a matter of law that Buckaroos’ two

¹ Pipe saddles are essentially bent or curved pieces of metal designed to support hanging pipes, with or without insulation. The metal saddle shape is commonly produced using a “roll-bending” process, whereby a blank piece of metal is run through a machine that forms the metal into an arcuate shape. Pipe saddles often have flared ends, and some pipe saddles have radial “ribs” in them, intended to strengthen the saddle and inhibit the hanger from sliding.

² The parties resolved all other matters of claim construction without the Court’s intervention. *See* Clerk’s No. 106 at 4.

“large die” arrangements do not infringe Claim 23.

Buckaroos contends that it has used two “large die” arrangements, namely, its “Single Welded Collar” arrangement and its “Single Welded Collar + Single Clamp” arrangement. Def.’s Material Facts ¶ 4. Both of these arrangements are made from a hollow pipe, which slides over and around a cylindrical roll tube of a two-roll bending machine. *Id.* ¶ 5. The roll tube has a fixed outer diameter and is mounted to rotate around a stationary axle of the machine. *Id.* ¶ 5. With respect to the Single Welded Collar arrangement, the roll-bending machine has a single collar welded onto the roll tube of the roll-bending machine. *Id.* ¶ 7. The welded collar is a ring of steel that is permanently mounted in place adjacent to the inner end of the roll tube assembly. *Id.* In the Single Welded Collar + Single Clamp arrangement, the same welded collar assembly is used on the inner end of the roll tube assembly, but an optional clamp can be placed on the outer end of the roll tube assembly. *Id.* ¶ 8. The screws in the clamp can be tightened so that the clamp can be attached to the roll tube assembly.³ *Id.*

By way of background, Sabasta points out, when it was developing its large dies, it discovered that, “because of the tremendous pressure exerted by the roll bending machines on the dies and sheet metal, the large dies had a tendency to move, or ‘walk,’ toward one end of the

³ Buckaroos points out that the only difference between the Single Welded Collar arrangement and the Single Welded Collar + Single Clamp arrangement is the use of the clamp in the latter arrangement. Def.’s Material Facts ¶ 9 (“Buckaroos’ Single Welded Collar arrangement is identical to the Welded Collar + Single Clamp arrangement except that the ‘smooth clamp’ [] is never placed on the device. Rather, the large die slides over the roll tube and abuts the Welded Collar, and the device is operated *without* any clamp opposite the Welded Collar.”). Sabasta does not dispute the distinction between the two arrangements, but contends that “there is a genuine issue of material fact regarding whether Buckaroos ever operates its roll bending machine with a roll tube and large die without a clamp, given the likelihood that the device will not work for its intended purpose in an efficient manner without [the clamp].” Pls.’ Resp. to Def.’s Material Facts ¶ 9.

roll tube or the other.” Pls.’ Br. at 5. Eventually, this “walking” would cause the ribs and flares being pressed into the sheet metal to be improperly aligned. *Id.* To resolve this problem, Sabasta placed clamps on each end of the large die to secure it to the roll tube in one location. *Id.* at 6. Sabasta claims that “Claim 23 of the ‘995 Patent describes the function and purpose of the[se] clamps.” *Id.* According to Sabasta, Buckaroos has used infringing systems other than the identified “Single Welded Collar” and “Single Welded Collar + Single Clamp” systems to secure its large dies to the roll tube to prevent “walking.” *Id.* While Buckaroos insists that it has only used the two identified large die arrangements, Sabasta contends that record evidence supports a finding that Buckaroos has used at least two additional large die arrangements.

II. STANDARD FOR SUMMARY JUDGMENT

Summary judgment “shall be rendered forthwith 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). An issue is genuine “if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.” *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A fact is material if the dispute over it might affect the outcome of the suit under the governing law. *Id.* The moving party has the burden of demonstrating the absence of a genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Anderson*, 477 U.S. at 248. In meeting its burden, the moving party may support his or her motion with affidavits, depositions, answers to interrogatories, and admissions. *See Celotex Corp.*, 477 U.S. at 323. Once the moving party has carried its burden, the nonmoving party must go beyond the pleadings and, by affidavits, depositions, answers to interrogatories, or admissions

on file, designate the specific facts showing that there is a genuine issue for trial. *See* Fed. R. Civ. P. 56(e); *Celotex Corp.*, 477 U.S. at 322-23; *Anderson*, 477 U.S. at 257. In order to survive a motion for summary judgment, the nonmoving party must present sufficient evidence for a reasonable trier of fact to return a verdict in his or her favor. *Celotex Corp.*, 477 U.S. at 322-23. On a motion for summary judgment, a court is required to “view the evidence in the light most favorable to the nonmoving party and give that party the benefit of all reasonable inferences.” *See United States v. City of Columbia*, 914 F.2d 151, 153 (8th Cir. 1990) (citing *Woodsmith Pub. Co. v. Meredith Corp.*, 904 F.2d 1244, 1247 (8th Cir. 1990)). A court does not weigh the evidence or make credibility determinations. *See Anderson*, 477 U.S. at 252. A court only determines whether there are any disputed issues and, if so, whether those issues are both genuine and material. *Id.*

A court must keep in mind that summary judgment is not a paper trial. Accordingly, a “district court’s role in deciding the motion is not to sift through the evidence, pondering the nuances and inconsistencies, and decide whom to believe.” *Waldridge v. Am. Hoechst Corp.*, 24 F.3d 918, 920 (7th Cir. 1994). In a motion for summary judgment, this Court has but one task, to decide, based on the evidence of record as identified in the parties’ moving and resistance papers, whether there is any material dispute of fact that requires a trial. *See id.* (citing *Anderson*, 477 U.S. at 249 and 10 Charles A. Wright & Arthur R. Miller, *Federal Practice and Procedure* § 2712 (3d ed. 1998)). The parties then share the burden of identifying the evidence that will facilitate this assessment. *Waldridge*, 24 F.3d at 921. Nevertheless, “[s]ummary judgments in favor of parties who have the burden of proof are rare, and rightly so.” *Turner v. Ferguson*, 149 F.3d 821, 824 (8th Cir. 1998). In matters of patent infringement, “[s]ummary

judgment is appropriate when it is apparent that only one conclusion as to infringement could be reached by a reasonable jury.” *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1323 (Fed. Cir. 2001).

III. LAW AND ANALYSIS

“Patent infringement occurs when a device [] that is literally covered by the claims or is equivalent to the claimed subject matter, is made, used, or sold, without the authorization of the patent holder, during the term of the patent.” *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1476 (Fed. Cir. 1998) (citing 35 U.S.C. § 271). To determine whether an accused device infringes upon a patent claim, the Court must engage in a two-step analysis. *See Cybor Corp. v. FAS Tech., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998). First, the claims must be construed to determine their scope. *Telemac*, 247 F.3d at 1323. Second, the construed claims (as opposed to the commercial embodiment of the patented invention) must be compared to the accused device. *Id.*; *see also SRI Int’l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (en banc) (“Infringement, literal or by equivalence, is determined by comparing an accused product not with a preferred embodiment described in the specification, or with a commercialized embodiment of the patentee, but with the properly and previously construed claims in suit.”). While the first step, claims construction, is determined as a matter of law, infringement, whether literal or under the doctrine of equivalents, is a question of fact. *See Telemac*, 247 F.3d at 1323-24 (“Whether the accused device contains an element corresponding to each claim limitation, or its equivalent, is a question of fact . . .”).

In this case, the Court has already completed the first step of the patent infringement analysis. As noted, the Court has determined as a matter of law that the disputed portion of

Claim 23 will be read as follows:

[T]wo clamps, which are able, at the operator's discretion, to engage an end face of each of the opposing ends of said body member, each of the clamps is designed to engage the roll tube of the roll bending machine, such that the clamp members function to secure the body member to the roll tube of the roll bending machine.

Clerk's No. 106 at 14. Accordingly, the Court turns to an examination of whether either Buckaroos' Single Welded Collar arrangement or its Single Welded Collar + Single Clamp arrangement infringe, either literally or under the doctrine of equivalents, on Claim 23 as construed by the Court.

"Literal infringement exists if each of the limitations of the asserted claim(s) read on, that is, are found in, the accused device." *Baxter Healthcare Corp. v. Spectramed, Inc.*, 49 F.3d 1575, 1583 (Fed. Cir. 1995); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1575 (Fed. Cir. 1995) (stating that literal infringement requires that "every limitation set forth in a claim must be found in an accused product, exactly"). A finding of literal infringement will be precluded where there is any deviation between the accused device and the literal claim language. *See Telemac*, 247 F.3d at 1330. Under the doctrine of equivalents, on the other hand, the inquiry is whether the accused device contains elements identical or equivalent to each of the limitations in a patent's claims. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 40 (1997) (finding the following to be the "essential inquiry" under the doctrine of equivalents: "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?"). "Under the doctrine of equivalents, an accused product that does not literally infringe a structural claim may yet be found an infringement 'if it performs substantially the same function in substantially the same way to

obtain the same result’ as the claimed product or process.” *Hughes Aircraft Co. v. United States*, 717 F.2d 1351, 1361 (Fed. Cir. 1983) (quoting *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 608 (1950)). The doctrine of equivalents is “judicially devised to do equity. ‘Courts have . . . recognized that to permit imitation of a patented invention which does not copy every literal detail would be to convert the protection of the patent grant into a hollow and useless thing.’” *Id.* (quoting *Graver*, 339 U.S. at 607).

A. *The Single Welded Collar Arrangement*

Buckaroos first seeks summary judgment on any claim by Plaintiffs that its “Single Welded Collar” arrangement infringes on the ‘995 Patent. As noted, the “Single Welded Collar” arrangement has “one collar welded onto the roll tube” on the inner side of the roll bending machine. Def.’s Material Facts ¶ 7. No clamp or other artifice is used to secure the outer end of the large die to the roll tube. It is clear to the Court that the Single Welded Collar arrangement cannot infringe on Claim 23, either literally or by the doctrine of equivalents, because the Single Welded Collar arrangement does not even arguably have “two clamps” or the equivalent of “two clamps,” as required by Claim 23. Indeed, Sabasta concedes that the Single Welded Collar arrangement does not infringe Claim 23: “[Sabasta] does not dispute that to the extent Buckaroos now uses its “welded collar” system without a removable clamp or collar, it cannot possibly infringe the ‘995 Patent, whether literally or under the Doctrine of Equivalents.” Pls.’ Br. at 22. Accordingly, Buckaroos’ Motion for Summary Judgment is granted with regard to its “Single Welded Collar” arrangement.⁴

⁴ Sabasta argues that the fact the Single Welded Collar arrangement “cannot possibly infringe” the ‘995 patent does not mean that Buckaroos is entitled to summary judgment. In particular, Sabasta argues that a jury must still decide whether alternate arrangements used by Buckaroos

B. The Single Welded Collar + Single Clamp Arrangement

Buckaroos next contends that its Single Welded Collar + Single Clamp arrangement does not infringe, either literally or under the doctrine of equivalents, on the '995 Patent because: 1) the welded collar is not a clamp; and 2) neither the welded collar nor the single clamp interlock or engage with the body member, i.e., the large die.⁵ Def.'s Br. at 16-17.

1. *Is the welded collar a clamp?*

Claim 23 indisputably requires "two clamps." Buckaroos argues that the welded collar is not a clamp. Buckaroos further argues that the welded collar is not the equivalent of a clamp, such that the elements of Claim 23 are not satisfied either literally or equivalently. At the claims construction phase of the proceedings, the parties agreed that Claim 23's requirement for a "pair of clamp members selectively engaging an end face of each of said opposing ends of said body member" referred to "two clamps." The parties did not argue the meaning or definition of "clamp," focusing instead on the meaning to be given the phrase "selectively engaging."

The welded collar in this case is a ring of steel that is permanently mounted in place adjacent to the inner end of Buckaroos' roll tube assembly. Def.'s Material Facts ¶ 7.

infringe the '995 Patent and whether the "Single Welded Collar + Single Clamp" arrangement infringes the '995 Patent. The Court agrees that summary judgment in favor of Buckaroos would not be proper on these other large die arrangements without an independent examination of each arrangement. The need for an independent examination of alternate large die arrangements, however, does not obviate the Court's conclusion that summary judgment is proper in favor of Buckaroos with respect to any claim by Sabasta that Buckaroos' Single Welded Collar arrangement infringes Claim 23 and, in turn, the '995 Patent.

⁵ Defendant also argues that neither the welded collar nor the single clamp function to "secure" the large die in place around the roll tube. The Court need not discuss this contention in depth because it finds that Plaintiffs have failed to offer adequate proof of other portions of Claim 23. Nonetheless, the requirement that the clamps operate to "secure" the large die is explored to some extent in the Court's discussion of the "engagement" requirement of Claim 23.

Buckaroos argues that the welded collar is not a “clamp” as that term is ordinarily understood. Sabasta counters that “Buckaroos’ welded ‘shaft collar’ is nothing more than a clamp that has been permanently affixed to the roll bending machine and roll tube.” Pls.’ Br. at 15.

Oxford English Dictionary defines the term “clamp” as: “A brace, clasp, or band, usually of iron or other rigid material, used for giving strength and support to flexible or movable objects, or for fastening two or more things securely together.” Oxford English Dictionary (2d ed. 1989). Similarly, Plaintiffs’ own expert witness, Dr. Abhijit Chandra, when asked why the patent description called a particular item a clamp, stated: “Because you have this screw adjustment. You can tighten it, and it grabs onto something. It attaches something to something. So that is why it is called a clamp.” Def.’s App. at A.6-A.7. Indeed, Dr. Chandra explicitly testified that Buckaroos’ “Single Welded Collar” arrangement “did not involve a clamp member, because they welded the part to the machine.” *Id.* at A.8 (“So when I saw it in operation for the large die, they did not use a clamp.”). Regardless, the Court finds that a determination of whether the welded collar is a clamp hinges not on physical features, but on function. That is, an object, regardless of how it is termed, could be a clamp if it operates to “fasten two or more things securely together.” In this case, that determination is inextricably intertwined with the question of whether the welded collar merely touches the die or “engages” it such that the welded collar serves functionally to “secure [the die] to the roll tube of the roll bending machine.” Since there are genuine issues of material fact on the question of whether the welded collar operates as a clamp with respect to die, the Court will turn to an evaluation of the “engagement” limitation of Claim 23. In so doing, the Court will presume, for purposes of analysis only, that the welded collar is a clamp.

2. *Assuming the welded collar is a clamp, is either the welded collar or the removable clamp “able, at the operator’s discretion, to engage an end face of each of the opposing ends of” the large die?*

Claim 23 requires that the clamps “selectively engag[e] an end face of each of said opposing ends of said body member.” The Court has construed this language as a requirement that each of the clamps be “able, at the operator’s discretion, to engage an end face of each of the opposing ends” of the large die. Clerk’s No. 106 at 14. The term “engage” was construed by the Court as “requir[ing] more than mere touching, though not necessarily interlocking.” *Id.* at 13.

According to Buckaroos, both the welded collar and the removable clamp have smooth surfaces that merely touch, and do not “engage,” the large die. Def.’s Material Facts ¶ 7 (“The collar has smooth, flat sides. The welded collar merely touches the large die.”); *id.* ¶ 8 (“The optional smooth clamp merely touches the large die.”).⁶ Sabasta denies that the welded collar “merely touches” the large die, contending that the welded collar would not serve the purpose of preventing the large die from walking back and forth if it merely touched the die.⁷ Accordingly,

⁶ Sabasta admits that the welded collar “has a ring of steel which is permanently mounted in place adjacent to the roll tube.” Pls.’ Resp. to Def.’s Material Facts ¶ 7. Sabasta does not specifically admit or deny that the welded collar has smooth, flat sides. Accordingly, Sabasta has admitted the fact for purposes of the present motion. *See* L.R. 56(b) (“The failure to respond, with appropriate citations to the appendix, to an individual statement of material fact constitutes an admission of that fact.”).

⁷ Sabasta’s only support for its contention that a collar that merely touches a large die would not serve to prevent the die from “walking” is the following affidavit statement by Steven Sabasta: “To be effective, these clamps have to do more than ‘merely touch’ the dies. They need to be engaged with the dies to prevent them from moving, despite the tremendous pressure exerted by the roll-bending machine.” Pls.’ App. at 51. This statement and the other evidence in the record only demonstrates that Sabasta was unsatisfied with the level of walking that occurred when it did not use clamps that engaged with the die. It does not demonstrate that Buckaroos’ large die arrangements suffered from the same problems, to the same extent, particularly given the existence of variations between Sabasta’s and Buckaroos’ large die setups. *See* Def.’s Reply at 4 n.2 (“Sabasta’s demonstration arrangement does not include a welded collar at one end, which

Sabasta asserts that the welded collar “interfaces with a groove in the end of the large die.” Pls.’ Br. at 15. Specifically, Sabasta claims that the welded collar “extends in to the cavity of Buckaroos’ large dies, as evidenced by the groove at the ends of Buckaroos’ large dies, and by the photographs of the large dies engaged with it.” Pls.’ Additional Facts ¶ 20. Sabasta further argues that “Buckaroos’ own admission” establishes that the removable clamp “engages the opposite end face of the large die.” Pls.’ Br. at 15.

A photograph of Buckaroos’ large die in Plaintiffs’ Appendix shows an end view of Buckaroos’ large die. Pls.’ App. at 29. The inner “ring” of the die appears somewhat indented or “grooved” as Plaintiffs contend. *Id.* Another photograph shows the welded collar with the large die pushed up against it. *Id.* at 30. Sabasta contends that this photograph shows how the welded collar “engages” the large die, by essentially sitting slightly inside the large die in the “grooved” area. *Id.*; *see also* Pls.’ Additional Facts ¶ 22 (“The welded collar engages with the die, as shown by the fact that the collar turns in unison with the die, and the fact that the collar ‘protrudes’ into the ‘cavity’ of the die.”). Buckaroos counters that the “groove” is nothing more than a worn area on the interior edge of the die, presumably where the welded collar has pushed into the end face of the die during use. Def.’s Resp. to Pls.’ Additional Facts ¶ 20 (“Buckaroos admits that its welded collar touches a worn area on the end of its large dies.”)). Having

Buckaroos’ arrangement does have. Furthermore, Sabasta’s large die arrangement differs structurally from both Buckaroos’ large die arrangement and from the arrangement shown in the ‘995 Patent. For example, Sabasta’s large die includes internal spacers or ‘donut rings’ which he calls ‘weldments’ welded within the die between the die and the roll tube to space the die from the roll tube. These welded rings are not shown in the ‘995 Patent. Buckaroos’ large dies also do not have such rings and instead have an inner diameter which rolls directly on the roll tube of the roll bending machine.”). Likewise, Sabasta’s statement does not discount the possibility that Buckaroos had a higher threshold for the occurrence of walking than did Sabasta.

reviewed the submitted evidence, including the photographs and videos submitted by Sabasta, the Court believes that there is a genuine issue of material fact regarding whether the welded collar “merely touches” an interior face of the die or whether the welded collar “engages” the die in a more substantial way. Both explanations are plausible on the evidence now before the Court and summary judgment is, therefore, improper on the question of whether the welded collar “engages” the die. This finding does not end the inquiry, however, because Claim 23 requires evidence that each of the two clamps “engage” the die. Accordingly, the Court turns to an evaluation of whether a genuine issue of material fact exists with respect to Buckaroos’ removable clamp.

With regard to the removable clamp, the Court finds that Sabasta has failed to demonstrate that Buckaroos’ removable clamp “engages” the large die in any way, as required by Claim 23. Sabasta contends that Buckaroos’ removable clamp is “attached to the roll tube and engaged with the large die to ensure that the large die remains secured in one location on the roll tube.” Pls.’ Additional Facts ¶ 23. In support of the contention that the removable clamp “engages” the large die, Sabasta states that “Buckaroos’ own admission” establishes that the removable clamp “engages the opposite end face of the large die.” Pls.’ Br. at 15. Specifically, Plaintiffs point to the following deposition testimony of Kevin Romsey, an employee of Buckaroos, as establishing the admission:

Q. Okay. So let’s do this with 81 [Pls.’ App. at 31 (a photo of Buckaroos’ roll bending machinery)], again. Can you show me where on here the shaft collar would go?

A. If the die stopped here, it would be right next to it.

Q. So go ahead and draw where the die would end. I’m not expecting it to be of scale.

A. (Drawing on Exhibit 81).

Q. Okay. So if the die ended here and the shaft collar ends here, this would be the shaft collar?

A. Yeah, the other end of it. It would butt up to the die.

Pls.’ App. at 23. The Court fails to see how the cited testimony establishes an “admission” that there is engagement between the die and the removable clamp. Indeed, immediately prior to the cited testimony, Romsey specifically stated that the removable clamp abuts the die, but denied that the removable clamp attached to the die in any way. *Id.* at 22-23 (“Q. So with the shaft collars [removable clamp], when you put them on the end of the die where do they connect? Do they connect to the die? A. No. Q. How do they interface with the die? A. They block them off so they can’t move.”); *see also id.* at 19-20 (“Q. So when you use one of these shaft collars with a large OD setup . . . show me where . . . that shaft collar would go? A. Well, it would slide on the end of the tube and then it would go butted up next to the die.”).

Buckaroos asserts that it has only ever used a smooth faced clamp as part of its Welded Single Collar + Single Clamp arrangement. Buckaroos has provided the Court with the actual physical clamp it uses in the arrangement to support its assertion that the clamp merely touches the large die and cannot possibly “engage” the die as required by Claim 23. *See* Def.’s App. Ex. A.16. Upon examining the clamp, the Court agrees with Buckaroos that there is nothing about the clamp that would permit it to “engage” the die. The clamp provided to the Court, at best, operates as a block, preventing the die from moving laterally on the roll tube. Outside of the mischaracterized Romsey testimony discussed above, Sabasta has offered no legitimate evidence that would support a conclusion that the smooth-faced removable clamp provided to the Court by Buckaroos “engages” Buckaroos’ large die. Accordingly, the Court finds that Sabasta has failed to generate a factual question as to whether the removable clamp literally “engage[s] an end

face” of the large die.

Sabasta urges that, if the Court should find no literal infringement of Claim 23, that it find infringement under the doctrine of equivalency. Sabasta’s entire argument of equivalency with regard to the clamps engaging the die follows:

As noted in the exhibits attached, and the deposition testimony of Buckaroos’ representatives, Buckaroos slides its large dies onto the roll tube until they are engaged with the welded collar on the roll bending machine. (P. App. 032). A second clamp, or “collar,” is then slid on the roll tube to the die until the parts are engaged, and the collar is then anchored in place through the use of tightening screws. (Docket No. 110). Pictures of the dies reveal a groove that allows the collars to do more than simply “touch” the dies. (P. App. 029, 030.). Consequently, Buckaroos’ welded collar and removable clamp, like a pair of removable clamps, achieves the same result in the same way for the same purpose as the ‘995 Patent, i.e., to prevent the die from moving back and forth.

Pls.’ Br. at 21. The Court finds Sabasta’s arguments of equivalency unconvincing. First, the photo of Buckaroos’ die revealing a “groove” shows only the end of the die that potentially engages with the welded collar; the photo does not even show the end of the die that allegedly “engages” with the removable clamp.⁸ Indeed, Sabasta has not offered any evidence in support of the bald assertion that “a second clamp . . . is slid on the roll tube to the die . . . *until the parts*

⁸ As Defendant aptly points out in its Reply Brief:

Buckaroos’ welded collar has an outer diameter of 3 3/4" while its smooth clamp, currently on deposit with the Court, has an outer diameter of 4 3/4". The photos Sabasta relies upon show a worn portion corresponding in size to the welded collar; however, no such photos are shown for Buckaroos’ clamp and such type of engagement is not even alleged by Sabasta. Physically, the larger diameter smooth clamp could not engage a worn portion which corresponds in size to the collar. Sabasta does not raise a genuine factual basis for concluding that the touching by Buckaroos’ smooth clamp engages a worn area on the opposite end of the die, and therefore “engages” within the meaning of the Claim.

Def.’s Reply at 8.

are engaged.” Pl.’s Br. at 21 (emphasis added). Second, as discussed above, the removable clamp provided to the Court clearly can do no more than abut the die to hold it laterally in place. This “mere touching” is insufficient to satisfy the engagement requirement of Claim 23, as discussed in the Court’s order on claim construction. *See* Clerk’s No. 106.

Finally, Plaintiffs’ contention that Buckaroos’ Single Welded Collar + Single Clamp arrangement “achieves the same result in the same way for the same purposes as the ‘995 Patent” construes the equivalency doctrine too broadly. “A claim element is equivalently present in an accused device if only insubstantial differences distinguish the missing claim element from the corresponding aspects of the accused device.” *Allen Eng’g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1345 (Fed. Cir. 2002). Thus, in a situation where one or more claim elements are literally absent, the doctrine of equivalents may nonetheless permit a finding of infringement if, and only if, every element is still present by an equivalent. *See Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 949 (Fed. Cir. 1987) (en banc) (abrogated on other grounds). Here, Plaintiffs request that the Court adopt its position that the clamps need not have any engagement with the body member so long as they ultimately achieve the purpose of preventing the die from “walking” on the roll tube. This position, however, effectively reads the engagement requirement out of Claim 23 altogether. *See Warner-Jenkinson Co.*, 520 U.S. at 29 (“It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety.”); *Zodiac Pool Care, Inc. v. Hoffinger Indus., Inc.*, 206 F.3d 1408, 1416 (Fed. Cir. 2000) (concluding that an equivalency that reads “clear structural limitations” out of claims is improper because it reduces the claims to “nothing more than ‘functional abstracts, devoid of meaningful structural

limitations on which the public could rely” (quoting *Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1424 (Fed. Cir. 1997)). That is, while Buckaroos’ clamp arrangement arguably achieves the same practical function and result as the ‘995 Patent arrangement, it does so in a fundamentally different way; namely, the removable clamp merely blocks the die from moving laterally on the roll tube, but does not “engage” the die in such a way as to “secure” it to the roll tube, as required by the elements of Claim 23. Such a fundamental difference in the way the clamp achieves the desired result is not an “insubstantial difference” that would permit a finding of equivalency under the doctrine of equivalents.

Moreover, Plaintiffs interpret the “function” of the clamps far too broadly. Nowhere in the ‘995 Patent, let alone in Claim 23, does it state that the purpose or function of the clamps is to prevent the die from “walking” on the roll tube. Rather, the function of the pair of clamps is clearly articulated in Claim 23 and in the Court’s construction of Claim 23, that is, by engaging both the “end face[s]” of the die and by engaging “the roll tube of the roll bending machine,” the clamps “function to secure the body member to the roll tube of the roll bending machine.” While one end result of this function, no doubt, is to prevent the die from “walking,” the fact remains that the function of the clamps identified in Claim 23 is to “secure the [die] to the roll tube.”⁹ It is clear that a clamp that functions merely to prevent the die from moving laterally *on* the roll tube does not perform a function equivalent to a clamp that “secures the body member *to* the roll tube.” See *Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1533 (Fed.

⁹ This determination is consistent with the ordinary rule that it is the patent claims themselves, and not a plaintiff’s embodiment thereof, that governs the infringement analysis. See *Allen Eng’g Corp.*, 299 F.3d at 1351 (“Infringement is determined by comparing the accused devices not with products made by the patentee but with the claims of the patent as properly construed”),

Cir. 1987) (“To be a[n] . . . ‘equivalent,’ the element substituted in the accused device for the element set forth in the claim must not be such as would substantially change the way in which the function of the claimed invention is performed.”).

C. Other Roll Bending Arrangements Sabasta Alleges Infringe on the ‘995 Patent

Sabasta urges that summary judgment is improper because Buckaroos’ prior testimony contradicts its present assertion that it has never used any non-smooth-faced clamps. Sabasta points to a system Buckaroos allegedly employed that used “two ‘collars,’ which it affixes to holes drilled into the roll tube of the roll-bending machine using screws” (hereinafter the “two collar” arrangement). Pls.’ Br. at 11. Plaintiffs’ only evidence supporting such an arrangement is Romsey’s testimony that, at one point, Buckaroos “had [a collar] attached to this side, and then we screwed the other [collar] on the other side.” Pls.’ App. at 24. According to Romsey, “[t]hat wasn’t working, so we welded a piece on this side [the welded collar] for a stop.” *Id.*

Sabasta also points to testimony by Romsey in support of its conclusion that Buckaroos’ “own testimony indicates that it has used two-tiered clamps with lips, as Buckaroos asserts Claim 23 requires” (hereinafter the “two-tiered clamp with lips”). *Id.* at 17. Specifically, Sabasta contends that, when shown a picture of Sabasta’s clamp, which clearly has a “lip” portion extending outward from the clamp, and asked “[I]s that what a shaft collar looks like when it is all together?,” Romsey replied, “Yes.” Pls.’ Br. at 17 (citing Pls.’ App. at 20-21, 32, 33).

The Court finds Sabasta’s arguments about Buckaroos’ use of a “two collar” arrangement and a “two-tiered clamp with lips” misplaced. With regard to the “two collar” arrangement, Plaintiffs have offered only Romsey’s comment that Buckaroos’ tried an arrangement that “had

[a collar] attached to this side, and then we screwed the other [collar] on the other side.” Pls.’ App. at 24. This statement does not support a conclusion that the collars were capable of “engag[ing] an end face” of the die, let alone that each and every requirement of Claim 23 is satisfied. Likewise, Plaintiffs’ contention that Buckaroos used a “two-tiered clamp with lips” is not supported by the record. Sabasta has reduced its citation of Romsey’s testimony to the point that it fundamentally misrepresents the substance of the testimony as a whole. At the deposition, Romsey was first shown Exhibit 82, which appears to depict the same clamp as the one Buckaroos provided to the Court. *See* Pls.’ App. at 32 (Dep. Ex. 82). Romsey identified Exhibit 82 as representing what Buckaroos’ clamp, or “shaft collar,” looks like. *See id.* at 20. Romsey was then shown Exhibit 83, a photograph of Sabasta’s clamp, which appears nearly identical to Buckaroos’ clamp, except that Sabasta’s clamp has a clearly defined protuberance, or “lip” which is designed to “engage” Sabasta’s large die arrangement. *See id.* at 33 (Dep. Ex. 83). While Romsey did reply “yes” when asked if Exhibit 83 was what a “shaft collar” looked like, his testimony did not end there:

Q. Looking at Exhibit 83, is that what a shaft collar looks like when it is all together?

A. Yes.

Q. Now, going back to Exhibit 79 [a photograph of Buckaroos’ roll machine assembly]. This line here is where the shaft collar goes, where I’m putting an arrow?

A. Yes.

Q. It goes right there?

A. Yes

Q. Exhibit 83, the shaft collars you use of the two-tier design?

A. I don’t know. Is this ours?

Q. I’m just asking you if your shaft collars have a two-tier design like that?

A. I don’t know. If this is ours, then they do.

Q. Have you seen one of these shaft collars before?

A. I have seen them, but it has been a long time since I have picked one up and looked at it.

Pls.’ App. at 21-22. The Court does not believe that Romsey’s testimony can be fairly read as a concession that Buckaroos ever used a “two-tiered clamp.”

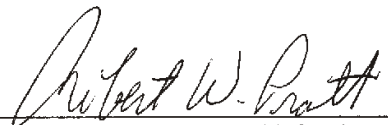
More significantly, even if Buckaroos did, at some point in time, use a “two collar” arrangement or a “two-tiered clamp with lips,” such as that used by Sabasta and depicted in Deposition Exhibit 83, it would have no bearing on the propriety of summary judgment for Buckaroos with regard to the “Single Welded Collar + Single Clamp” arrangement identified in Buckaroos’ present motion. Buckaroos has requested summary judgment on only the “Single Welded Collar” and the “Single Welded Collar + Single Clamp” arrangements, positing to the Court that the latter arrangement employs the clamp actually provided to the Court as Defendant’s Exhibit A.16. It is only these arrangements that are under consideration in the present motion, not any other arrangement that Plaintiffs believe Buckaroos may have used. If Sabasta actually contends that Buckaroos infringed on the ‘995 Patent by using either a “two collar” arrangement or a “two-tiered clamp with lips,” then Sabasta bears the burden to prove its claims by a preponderance of the evidence through the normal litigation process. At this point in time, however, such issues have not been legitimately placed in contention.

IV. CONCLUSION

For the reasons stated herein, Buckaroos’ Motion for Summary Judgment of Non-Infringement of Claim 23 (Clerk’s No. 110) is GRANTED with respect to the identified arrangements.

IT IS SO ORDERED.

Dated this ____16th____ day of December, 2009.


ROBERT W. PRATT, Chief Judge
U.S. DISTRICT COURT