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Cartner v. Alamo Group, Inc.

Decided June 17, 2009

During claim construction, the claim language, the specification, and the prosecution history will be taken into account before extrinsic evidence is consulted

The Federal Circuit reversed the U.S. District Court for the Northern District of Ohio. Cartner sued Alamo for infringing several claims of U.S. Patent No. 5,197,284, which was directed to a deceleration circuit for a hydraulic motor. During a Markman hearing, the District Court determined that the specification was not instructive and that the statements in the prosecution history were "not explanatory." The District Court thus adopted Alamo's proposed construction, which was based on a dictionary definition. The District Court interpreted the claimed term "said flow control orifice being constantly operative" to mean "the flow control orifice continuously slows fluid when the first control valve is in the open or closed position." The parties stipulated that, according to the District Court's claim construction, the claims at issue were invalid for failure to meet the written description requirement of 35 U.S.C. § 112.

The Federal Circuit concluded that the District Court erred in its claim construction, and thus vacated the finding of invalidity. The Federal Circuit reasoned that both the specification and the prosecution history were highly explanatory about the proper construction of the claim terms at issue. The Federal Circuit thus revised the interpretation of the claim terms at issue to mean "the flow control orifice continuously slows fluid flow when there is fluid flow in the third fluid line, whether the first control valve is in the open or closed position."

Practice Tip: Ensure that terms used in the specification and prosecution history are consistent with the intended meaning.