

FEDERAL CIRCUIT PATENT LAW CASE UPDATE

Pandrol USA, LP v. Airboss Ry. Prods., Inc., 04-1069 (Fed. Cir. Sept. 19, 2005) (Rader, J.)

The court affirmed that Pandrol's patent for a rail tie assembly with an abrasion-resistant plate between the tie and the rail was not proven invalid by Airboss for failure to meet the written description requirement. Even though the terms "adhering material" and "sole means" were added by amendment, the original disclosure was sufficient to cover them.

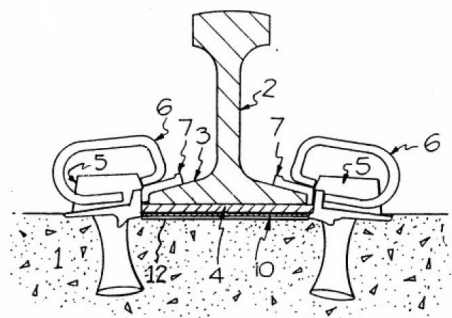
Pandrol owns U.S. Pat. No. 5,110,046.

The '046 patent claims a railroad track fastening system. . . . Specifically, the patent claims a rail seat assembly that resists erosion of the concrete rail tie by interposing an abrasion-resistant plate and a layer of adhering material between the rail pad and the rail. . . .

The district court determined on summary judgment that there was no genuine issue regarding whether the '046 patent's original specification satisfies the written description requirement . . . Specifically, the district court declined to invalidate claims because the specification includes sufficient disclosure to support the claim limitations that include the terms "adhering material" and "sole means," . . . both of which were added by amendment during prosecution. . . .

With respect to the "adhering material" claim limitation, the original written description of the '046 patent describes a closed cell foam pad.

With respect to the "sole means" limitation, claim 1 says that the adhering material is the "sole means" for adhering the abrasion resistant plate to the rail ties. . . . The '046 patent describes and shows "a rail 2 which . . . sits on a rail pad 4 interposed between rail 2 and the concrete tie 1." . . . "The rail is held in place by rail clamp 6 which is held in clamp support 5" and has a toe portion that "bears down on rail flange 3 through



the insulator 7." . . . Those passages, however, do not establish that the mechanical clamping system also performs the adhering function. The patent shows that the clamping system secures or clamps some parts mechanically but does not adhere. . . . The record does not show that the pressure exerted by the railed clips causes or contributes to the adhering performed by the HDPE foam. Thus, the disclosed adherents remain the "sole means" for that function.

In addition, the sole means limitation refers to the specific bonding of the rail tie to the rail pad to prevent erosion of the concrete rail tie with a watertight seal. Thus, the foam gasket primarily prevents erosion. In contrast, the primary purpose of the clamps is to lock or hold the system in place.

The court also affirmed the exclusion of the testimony of Airboss's expert, a Mr. Young, on the basis of assignor estoppel.

