

**UNITED STATES DISTRICT COURT**  
**DISTRICT OF MAINE**

**WHEELABRATOR CLEAN** )  
**WATER SYSTEMS, INC.,** )  
 )  
                  **PLAINTIFF** )  
 )  
**v.** )  
 )  
**LONGWOOD MANUFACTURING** )  
**CORP.,** )  
 )  
                  **DEFENDANT** )

**Civil No. 95-415-P-H**

**ORDER ON DEFENDANT’S MOTION TO AMEND  
PURSUANT TO RULE 59 OR FOR ORDER CERTIFICATION**

Longwood Manufacturing Corp.’s (“Longwood”) motion for certification is **DENIED**.

The motion to amend judgment is **GRANTED IN PART** and **DENIED IN PART** as follows.

All references in the court’s order captioned “Partial Judgment on Infringement and Damages Issues” of December 18, 1996, that state that the newly-designed sensor is partially in and partly on a recess are amended. The new temperature sensor is not in a recess at all, but is exclusively within the cover plate, which is then attached to the wall of the bin.<sup>1</sup> The fact that the newly-designed sensors are attached to the wall and are not located in a recess, even partially, however, does not affect my reasoning or conclusion.

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<sup>1</sup> My earlier reference to the sensor as partly in and partly on a recess derived the from the fact that I was attending to the connections that the sensor had within the wall as demonstrated on Exhibit K. I now recognize that the references to “sensor” as used by the parties do not include any of those connections.

The motion to amend judgment is otherwise **DENIED** for the following reasons. First, as I pointed out in the decision of December 18, 1996, the parties asked me to rule on independent claim 9 of the '877 patent, but never addressed the specifics of claim 9 in their arguments. Order of Dec. 18, 1996, at 5 n.2. Now, Longwood presents extensive prosecution history concerning claim 9 and its predecessor claims. See Def.'s Mot. to Amend J. and/or Certification at 3-5 [hereinafter "Def.'s Mot."]. These arguments were **WAIVED** by Longwood's failure to make them when this case was presented to the court on a stipulated record for partial judgment. When lawyers present a case to the court for judgment they are expected to present all their arguments. A judge cannot be expected to re-visit an issue every time a lawyer comes up with an argument the lawyer previously overlooked.

Longwood also complains of my statement that "the examiner was persuaded of the facility's patentability because of his new understanding that prior art had counseled away from placing the sensor anywhere near the frame of the bay (much less within it)." Order of Dec. 18, 1996, at 7-8. Longwood states that "no prior art of record actually provides any such 'counseling' and plaintiff cites none. This statement is a reflection of mere attorney argument presented to the examiner and to this Court." Def.'s Mot. at 7 n.\*. Unfortunately for Longwood, its stipulation goes farther than that. The stipulation states: "In the prior art, it was known to manually check the temperature of the material in the bins with a hand-held temperature probe." Joint Stip. Facts ¶ 3. The stipulation also declares that the patent examiner *gave as a reason for allowing the claim*: "Applicant and applicant's representative argued that the prior art of record (Kuter, et al.) actually teaches away from placing the temperature sensors in recesses in the side wall of the apparatus." Id. ¶ 18. That statement was elaborated upon in paragraph 19 where the applicant's argument (which paragraph 18 stated was accepted by the examiner) is quoted at length as follows:

As Dr. Kuter explained in the interview, *Kuter, et al.* actually teaches away from the present invention. This is because this reference suggests that . . . the temperature sensor should be located away from the frame or sidewall of a composting bay. . . . Thus, one of ordinary skill in the art would not be lead [sic., led] to control the compost temperature by sensing the temperature of the compost in the area adjacent the reactor sidewall.

Id. ¶ 19. Thus, the stipulation is that this argument was credited by the examiner.

Second, in a footnote in its motion, Longwood advances for the first time a reason for its new sensor design. Now and belatedly Longwood informs the court that the new design “substantially increas[es] its thermal surface area and relocat[es] the plate in the compost itself, to improve the accuracy of temperature managements.” Def.’s Mot. at 9 n.\*. This argument, too, is **WAIVED** for failure to present it in a timely fashion.

Next, Longwood makes a new argument of file wrapper estoppel in connection with the ‘877 patent. Id. at 9-14. This argument, too, is **WAIVED**. The sole argument in this respect made in the original briefing is at the bottom of page 17 of Longwood’s memorandum of law in support of its motion under Rule 56(b) for partial summary judgment. There Longwood states broadly: “If a patent applicant narrows his claims by amendment to meet the objectives of a patent examiner as to patentability, he nor his assigns may not later ‘recapture’ the scope of the claims that was previously surrendered.” Mem. Supp. Def.’s Mot. Under Rule 56(b) for Partial Summ. J. at 17. Absolutely no specifics are provided for this argument in the original brief; in fact, nothing more is said about it. The new details are thus clearly an afterthought.

Lest there be any doubt what has happened here if this matter is appealed ultimately to the Federal Circuit, I reiterate what has taken place procedurally. The parties first presented me with cross-motions for summary judgment asking me as the judge to define the scope of the patent. It

appeared that there were no genuine issues of material fact, but in argumentative fashion the lawyers were attacking each other's statement of facts. I therefore directed the parties to file stipulated facts so that I could make a ruling on the record without the difficulties summary judgment creates. See Order of Oct. 21, 1996, at 1 (quoting Boston Five Cents Sav. Bank v. HUD, 768 F.2d 5, 12 (1st Cir. 1985)). Consequently, when the stipulated record was presented to me for judgment on the issue of the scope of the patent, it was ready for my final decision on that issue. Any arguments not presented at that time, therefore, are properly treated as waived. Any other conclusion would permit a losing litigant to come back to the court time after time with newly thought out arguments he had failed to make the first time. If Longwood's new arguments were meritorious, they should have been raised at the outset.

Finally, I express my concern, once again, at how this case is being litigated. See id. at 2. I refer not only to Longwood's procedures, but I am also distressed to read in Wheelabrator's response filed on January 21, 1997, the following statement: "In the Joint Stipulation of Facts, Wheelabrator had conceded that the retrofit avoided infringement of the '196 patent." Pl.'s Mem. Opp'n Def.'s Mot. to Amend J. and/or Certification at 2. No such concession was ever brought to my attention in the previous briefing of this case and I spent substantial hours in working through the law and the record in order to reach a conclusion that there was no infringement because I believed from the briefs that it was a contested issue. If this case is to go to trial on any issues, the lawyers shall be ready at the final pretrial conference to identify *specifically* and *finally* what issues are in dispute. Any lack of preparation on that subject will be met with sanctions. I will probably insist upon an active role by local counsel in any trial and pretrial proceedings because of the history of this litigation to date so that I can be sure that the matter is being responsibly presented.

**SO ORDERED.**

**DATED THIS 5<sup>TH</sup> DAY OF FEBRUARY, 1997.**

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**D. BROCK HORNBY**  
**UNITED STATES CHIEF DISTRICT JUDGE**