

United States District Court,
S.D. New York.

Carl B. BAI,
Plaintiff.

v.

L & L WINGS, INC., d/b/a WINGS, ELUFA FASHIONS,
INC. and GREAT WORLD CO. OF NEW YORK LTD. Defendants.

No. 95 CIV. 10824 (LMM)

Aug. 22, 1997.

MEMORANDUM AND ORDER

McKENNA, District Judge.

I. Introduction

Defendant L & L Wings, Inc., d/b/a Wings (hereinafter "defendant"), moves, in this patent infringement action, for summary judgment of non-infringement, and plaintiff cross-moves for summary judgment of infringement.

Summary judgment is appropriate when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. Thus, summary judgment may be granted when no "reasonable jury could return a verdict for the nonmoving party." In determining whether there is a genuine issue of material fact, the evidence must be viewed in the light most favorable to the party opposing the motion, with doubts resolved in favor of the nonmovant.

Mark I Marketing Corp. v. R. R. Donnelley & Sons Co., 66 F.3d 285, 289 (Fed. Cir. 1995), *cert. denied*, 116 S. Ct. 917 (1996) (quoting Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986)) (other citations omitted).

Plaintiff alleges defendant's infringement of his United States Patent 4,017,076 (the "'076 Patent"), issued on April 12, 1977. The '076 Patent contains three claims (the second and third of which are dependent on the first, and not relevant on the present motions). The first claim reads as follows:

A target game including: a glove formed of a hemispherical dish-shaped rigid plastic member; a strap mounted on the rear side of the plastic member to enable the glove to be held on the palm of the hand of a player; a sheet of fabric material mounted on the glove and extending across the front face of the dish-shaped rigid plastic member to constitute a target for a missile thrown thereagainst, said sheet of fabric material being mounted on the plastic member in spaced relationship with the inner surface thereof so as to present a resilient surface which is deflectable inwardly when struck by the missile.

(Rubinstein Aff., Ex. A.) Defendant argues that there is no literal infringement of the '076 patent by the accused product; plaintiff responds that there is, and that, even if there is not, the accused product infringes under the doctrine of equivalents; defendant replies that there can be no infringement under the doctrine of equivalents because prosecution history estoppel limits the scope of equivalents plaintiff may assert.

II. Literal Infringement

A literal infringement analysis requires two separate steps. First, the asserted claims must be interpreted by the court as a matter of law to determine their meaning and scope. In the second step, the trier of fact determines whether the claims as thus construed read on the accused product. To establish literal infringement, every limitation set forth in a claim must be found in an accused product, exactly.

Infringement, both literal and under the doctrine of equivalents, is an issue of fact.

Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1575 (Fed. Cir.), *cert. denied*, 116 S. Ct. 515 (1995). FN1

FN1. In *Markman v. Westview Instruments, Inc.*, the Supreme Court confirmed that "the construction of a patent, including terms of art within its claim, is exclusively with the province of the court." 116 S. Ct. 1384, 1387 (1996).

Defendant's argument that there is no literal infringement is simple:

Defendant's product does not literally infringe the single independent claim of the '076 patent because the plastic glove member of the accused structure is *not* "hemispherical" nor is the fabric stretched across the front of the plastic member in "spaced relationship" with the inner surface. Since the product of defendant does not meet these limitations of the claim, there is no literal infringement.

(Def. Mem. at 15.)

Defendant's product (Pl. Ex. MC) is plainly not "hemispherical." FN2 Plaintiff argues, however, that examination of the specification and prosecution history, *see Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (in banc), *aff'd*, 116 S.Ct. 1384 (1996), shows that defendant's "conclusion that 'hemispherical' means one-half of a full sphere... is patently incorrect." (Pl. Mem. at 19.)

FN2. In a geometrical sense, a "sphere" is defined as "a body or space bounded by one surface all points of which are equally distant from a point within that constitutes its center." *Webster's Third New International Dictionary of the English Language Unabridged* at 2193 (1986). A "hemisphere," in the geometrical sense, is "either of two half spheres formed by a plane through a sphere's center." *Id.* at 1055.

It is true, of course, that:

Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). Here, the only definition "by

implication," *id.*, that can be found in the specification of the '076 patent must be derived from the drawings, most particularly Figure 2, which shows a rigid glove that is less than a hemisphere, but is, nevertheless, a part of a sphere. FN3 The rigid glove component of defendant's product, on the other hand, is not part of a sphere, having a perceptibly flattened surface. Therefore, this Court holds that there has been no literal infringement of Claim 1 of Bai's '076 patent as the rigid plastic member of defendant's product cannot be considered to be hemispherical in shape.

FN3. "It is beyond question that each of Figures 1-4 in the '076 patent show a glove that is concave *and* substantially symmetrical about its center." (Plaintiff's Reply Mem. at 6.)(emphasis in original).

III. Doctrine of Equivalents

Although there has been no literal infringement, plaintiff argues in the alternative that there has been infringement under the doctrine of equivalents. Under this doctrine, a product or process that does not literally infringe a patent may nevertheless be found to have infringed if there is "equivalence" between the elements of the accused product or process and the claimed elements of the patented invention. Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 117 S. Ct. 1040, 1045 (1997). In determining what constitutes equivalence

[c]onsideration must be given to the purpose for which an ingredient is used in a patent, the qualities it has when combined with the other ingredients, and the function which it is intended to perform. An important factor is whether persons reasonably skilled in the art would have known of the interchangeability of an ingredient not contained in the patent with one that was.

Graver Tank & Mfg. Co., Inc. v. Linde Air Products Co., 339 U.S. 605, 609 (1950).

Defendant argues that any claim of infringement under the doctrine of equivalents is barred by the application of prosecution history estoppel. Prosecution history estoppel "bars a patentee from construing its claims in a way that would resurrect subject matter previously surrendered during prosecution of the patent application ... if those structures were excluded by claim limitations added in order to avoid prior art." Mannesmann Demag Corp v. Engineered Metal Prods. Co., 793 F.2d 1279, 1284 (Fed Cir. 1986); *see also* Hogan AB v. Dresser Indus., Inc., 9 F.3d 948, 951-52 (Fed. Cir. 1993). In instances where the reason for an amendment is not related to avoiding prior art, the change does not necessarily preclude infringement by the doctrine of equivalents. Warner- Jenkinson, 117 S. Ct. at 1051.

The Supreme Court has recently articulated a rebuttable presumption in favor of the application of prosecution history estoppel in cases where a patentee has added a limiting element to his claim. Warner-Jenkinson, 117 S. Ct. at 1051. The burden rests on the patent holder to establish the reason for an amendment made during patent prosecution. *Id.* It is the Court's role to then determine whether the reason proffered is sufficient to overcome the presumption of prosecution history estoppel as a bar to the application of the doctrine of equivalents to the element added by that amendment. *Id.* If no explanation is established, the Court should presume that the U.S. Patent and Trademark Office (the "PTO") had a substantial reason relating to patentability for including the limiting element added by the amendment. *Id.*

Bai initially submitted 5 claims in his application, claim 2 defining the glove as being "formed of a rigid plastic material and ha[ving] a dish shape." (Rubinstein Aff., Ex. B.) In rejecting claims 1 through 5,

pursuant to 35 U.S.C. s. 103, the PTO referenced numerous patents containing prior art which would make Bai's product, as originally described, unpatentable. (Rubinstein Aff, Ex. C.) One of these patents was the Hartel patent No. 3,378,260 for an aerial dart catching game which in one form comprises "a bowl or dish shaped member provided with a smooth curvealinear surface." (Cohen Aff., Ex. G.) In addressing Bai's original application, the PTO stated it would be "obvious to provide dish-shaped structure" of the Hartel game behind the target of a Lemelson patent No. 3,857,566 (Rubinstein Aff., Ex. C.), which is a "target game...composed of a missile and a target...so constructed that a portion thereof is yieldable..." (Cohen Aff., Ex. F.)

In response to the PTO's rejection of their patent application, Bai submitted an amended application for its target game. (Rubinstein Aff., Ex. E.) As amended, the claim stated that it was "[a] target game including: a glove *formed of a hemispherical dish-shaped rigid plastic member.*" (*Id.*)(emphasis in original). The amendment therefore, further clarified the structure of Bai's game by adding the phrase "hemispherical" as well as other terms to its description. This description is the one used in the '076 patent eventually issued to Bai on April 12, 1977.

The amended application also included a remarks section which explained to the PTO the changes to Bai's application and why it should be approved as amended. In particular, Bai specifically discussed the first four patents named by the PTO in its initial rejection and distinguished them from the amended application. Those patents were the Muchnick patent No. 3,953,030, the Craig patent No. 1,633,926 and the Lemelson patents Nos. 3,032,345 and 3,857,566. Although in its initial rejection the PTO cited 11 other patents in support of its rejection, none of those other patents were specifically referenced or distinguished. Instead, Bai's amended application stated that "[t]he other references of record have also been carefully considered, but are likewise believed to have no relevancy to the invention, when these references are considered alone, or in any valid combination." (Rubinstein Aff., Ex. E.)

Therefore, it is this Court's role to determine, not only if the addition of the term "hemispherical" to describe the shape of Bai's product reduced the scope of equivalents protected by its patent, but also whether that limitation was added in order to obtain the patent, particularly in response to the objections made by the PTO based upon prior art. *See Hi-Life Products, Inc. v. American National Water Mattress Corp.*, 842 F.2d 323, 325 (Fed. Cir. 1988). The standard for determining whether particular subject matter was abandoned and was material is an objective one which is to be determined by the Court as a matter of law. *Modine Mfg. Co. v. United States Int'l Trade Commission*, 75 F.3d 1545, 1555 (Fed. Cir.), *cert. denied*, 116 S. Ct. 2523 (1996) ; *see also* *Hoganas AB*, 9 F.3d at 952. The Court is particularly to consider what a competitor would reasonably be expected to conclude to be the scope of patent protection based upon an examination of the prosecution history. *Hoganas AB*, 9 F.3d at 952.

In his memorandum in support of his motion, plaintiff argues that the term "hemispherical" was added to further clarify the product, rather than to respond to the rejection by the PTO based upon the similarity to particular existing patents. However, plaintiff fails to produce any evidence to support that claim. FN4 In *Warner-Jenkinson*, the Supreme Court held that the burden rests on the patent holder to establish the reason for an amendment. 117 S. Ct. at 1051. Where no explanation is established, the Court is to "presume that the PTO had a substantial reason relating to patentability for including the limiting element added by amendment." *Id.* This Court finds that plaintiffs have failed to rebut the presumption that the limiting term "hemispherical" was added to avoid the prior art cited in the initial PTO rejection. Plaintiff's failure to separately distinguish each of the 15 patents cited by the PTO does not in itself imply that the amendments were not made in response to the PTO rejection. Moreover, a competitor could reasonably conclude from

the patent's prosecution history that the addition of the term "hemispherical" limited the equivalents the patent holder would be entitled to assert. *See* Mark I Marketing Corp., 66 F.3d at 291. The doctrine of prosecution estoppel, therefore bars the application of the doctrine of equivalents to the element added by the amendment. Bai's patent protection is limited to equivalent products that are hemispherical in shape.

FN4. Moreover, in its initial rejection, the PTO denied the application pursuant to 35 U.S.C. s. 103, for obviousness when compared with prior art, namely the 15 patents it named in its rejection. Nowhere in the rejection did the PTO state that the application as originally filed was improperly described in violation of 35 U.S.C. s. 112. (*See* Rubinstein Aff., Ex. C.)

As this Court has already determined, defendant's game is clearly not hemispherical in shape. Therefore, although the flattened shape of defendant's product may be the structural "equivalent" to Bai's hemispherical game, Bai cannot claim patent infringement pursuant to its amended '076 patent. Summary judgment is hereby granted in favor of the defendant.

IV. Conclusion

For the foregoing reasons, defendant's motion for summary judgment is granted in its entirety and plaintiff's cross-motion for summary judgment is denied, and the complaint is dismissed as to defendant L & L Wings, Inc.

SO ORDERED.

Dated:

S.D.N.Y., 1997.

Bai v. L & L Wings, Inc.

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