

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

**ART LEATHER MANUFACTURING CO., INC,**  
Plaintiff.

v.

**ALBUMX CORP., Kambara USA, Inc., Gross Manufacturing Corp. d/b/a Gross-Medick-Barrows,  
and Albums Inc,**  
Defendants.

No. 94 CIV. 6013 (LLS)

**Feb. 14, 1997.**

## **OPINION AND ORDER**

**STANTON, District Judge.**

Plaintiff Art Leather Manufacturing Company sues AlbumX Corporation, Kambara USA, Inc., Albums Inc., and Gross Manufacturing Corporation, alleging infringement of United States Patent Nos. 4,825,573 ("the '573 patent") and 5,044,100 ("the '100 patent"). FN1 Plaintiff claims that defendants manufacture or distribute photograph-mounting devices that infringe both of those patents, except that the devices manufactured by Gross Manufacturing Corporation infringe only the '100 patent.

FN1. The inventors have assigned to plaintiff the rights to those patents.

Plaintiff moves for summary judgment that the devices infringe its patents. Defendants cross-move for summary judgment that their devices do not infringe the patents.

## **BACKGROUND**

### **A. The field**

High-quality photographic products are typically sold to professional photographers for resale with their photographs of events such as weddings. The newly married couple, for example, may wish the photographs to be contained in an album whose pages present mats displaying pictures in a variety of styles -- oval, rectangular, octagonal, etc. -- and in differing arrangements and positions on the pages. To provide all possible variations, the manufacturers must inventory an enormous number of pages: plaintiff avers that 10 mats styles require 55 page combinations, 20 mat styles require 210, and 100 mat styles require 5,050 page combinations.

Various solutions have been employed, each with particular drawbacks of which the present products are claimed to be free.

The designs at issue use pages whose structures consist of layers provided with a horizontal slot through which a removable mat containing the photographs (mounted in appropriate configurations as desired) may be slid so that each page in the album can display a different style of mat presenting the photographs, and provide a professional and finished result.

## **B. The devices**

The basic structure of defendants' photograph-mounting devices is undisputed. The following is a lay, non-technical description, intended only to aid understanding of the products.

The devices are pages for a photograph album. Since the essential structure of each side of the album page is similar, we need describe only one side of the page.

We start with the page FN2 itself. Onto the page are attached two layers of material of the same dimensions as the page, but with most of their center portions removed, almost to the edges of the page. The two layers create a low wall that runs around the outer edge of the page, leaving inside the wall a rectangular open area or window space over most of the center part of the page. The wall is slit along one side, so that a rectangular mat bearing photographs may be slid through the wall and thus occupy the rectangular window space in the center. In this way, each page can display any one of a variety of mats with different styles of framing and grouping the photographs.

FN2. In plaintiff's patent, the page is called a "cover means."

The window space in the top layer is slightly smaller than the window space in the middle layer. Thus, the inner edge of the top layer slightly overhangs that of the middle layer. The combination provides a groove, which helps retain the mat in place: when the mat is within the window space, its outer edges fit snugly within the groove.

## **C. The claims**

Plaintiff claims that those devices infringe claim 1 of the '573 patent and claim 1 of the '100 patent. Those patents both relate to a system for mounting photographs with a mat inserted into a device for holding a mat. Claim 1 of the '100 patent states:

"What is claimed is:

1. A photograph mounting system, comprising, at least one frame member including

cover means having opposed inner and outer sides and a cover peripheral edge,

a rim member secured to said inner side of said cover and having a rim inner peripheral edge and a rim outer peripheral edge, said rim outer edge being generally coextensive with said cover peripheral edge, said rim inner peripheral edge and said inner side defining a space,

a card member secured to said rim member and having card inner and outer edges, said card outer edge being generally coextensive with said rim outer edge, said card inner edge being configured the same as and

extending less inwardly than said rim inner edge, said rim inner edge, said card member, and said inner side of said cover means forming an inner peripheral recess,

said inner peripheral recess extending around the entire length of the cover means,

mat means for holding the photograph for viewing said mat means having a peripheral edge and being adapted to be received within said space and positioned in locking relationship with said rim inner peripheral edge, said cover means providing a backing for said mat means,

slot means formed between said cover means and said rim member for allowing passage of said mat means to and from said space, and

the entire peripheral edge of the mat matching and snugly mating with the entire length of the inner peripheral recess,

whereby said mat is locked into place along its entire peripheral edge within said inner peripheral recess."

'100 patent, col. 6, l. 62 to col. 7, l. 28.

Claim 1 of the '573 patent is essentially the same; its differences are not material for the purposes of this opinion. All references in this opinion to the "claim" are to claim 1 of the '100 patent, but apply equally to the '573 patent.

## DISCUSSION

Plaintiff argues that every element, or "limitation," of the claim can be found in the accused devices. Defendants contend that their devices lack a "frame member," a "cover means having opposed inner and outer sides," and a "rim member secured to said inner side of said cover." Defendant Gross claims, in addition, that the slit that allows insertion of the mat into its device is in a different location than the "slot means formed between said cover means and said rim member" claimed in the patents.

There are two steps in determining infringement. "The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly construed claims to the device accused of infringing." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (internal citations omitted), *aff'd*, 116 S. Ct. 1384 (1996).

### I. Claim Interpretation

The interpretation of a patent claim is "a matter of law exclusively for the court." *Markman*, 52 F.3d at 970-71. "First, and most importantly, the language of the claim defines the scope of the protected invention." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 619 (Fed. Cir. 1995). The court may also consider the "specification," which is a description that precedes the patent claims, and the "prosecution history," which is the administrative record leading to the patent's issuance. *York Products, Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572 (Fed. Cir. 1996). Those additional sources "may provide context and clarification about the meaning of claim terms." *Id.*

The locations of the "slot means formed between said cover means and said rim member" and the "rim member secured to said inner side of said cover" depend on the relative location of the "cover means," the

"rim member," and the "card member." Accordingly, the relative location of those elements is addressed first.

### **A. The claim**

The claim describes three layers: a "cover" or "cover means," a "rim" or "rim member," and a "card" or "card member." It states that the rim is "secured to said inner side of said cover," and that the card is "secured to said rim member." The claim does not state that the layers are secured in any manner other than directly, so the natural implication is that the cover is adjacent to the rim, and the rim is adjacent to the card, in that order. In other words, the cover is the bottom layer, the rim is the middle layer, and the card is the top layer.

The card and rim are each described in the claim as having an inner peripheral edge. That means that each of those layers has an opening, or window, in its center. The claim describes the card's inner edge as "being configured the same as and extending less inwardly than said rim inner edge." The card therefore has a larger window than the rim. Thus, if viewed from above, the claimed device would look like a window within a window: the cover, on the bottom, would be visible through the small window of the rim (the middle layer), and part of the rim would be visible through the larger window of the card (the top layer).

That configuration does not show how those layers form the "peripheral recess" recited in the claim. The claim describes "said rim inner edge, said card member, and said inner side of said cover means forming an inner peripheral recess." However, such a recess would be formed only if the top layer's window were smaller than the middle layer's window, so that the top layer partly overlaid the window of the middle layer. Because the claim describes the card's window as larger than the rim's window, the claimed device would have a peripheral recess only if the rim, rather than the card, were the top layer.

### **B. The specification**

The specification of the patents FN3 describes a configuration where a top layer has a smaller window than the window of the middle layer below it. The "Summary of the Invention" refers to a "card that overlies the quadrilateral rim portions" and to an "overlying stiff card member secured to the rim member," which forms "a recess with the inside of the cover." *See* '100 patent, col. 2, 11. 25, 37-38. In all of the embodiments described in the specification, the inner edge of the top layer overlies the inner edge of the middle layer, forming a recess below. That configuration is depicted in five separate drawings showing cross-sections of different embodiments.

FN3. Because the specification of the '100 patent and the specification of the '573 patent are essentially identical, references in this opinion to the "specification" apply to both patents.

However, the specification does not determine the scope of the patent. "Claims, not the specification embodiments, define the scope of the protection." *American Permahedge, Inc. v. Barcana, Inc.*, 1997 WL 35428, at (Fed. Cir. Jan. 31, 1997); *see Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed. Cir. 1988) ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations"). Because "the claims provide the concise formal definition of the invention," it is "to those wordings that one must look to determine whether there has been infringement." *E.I. DuPont de Nemours & Co. v. Phillips Petroleum Corp.*, 849 F.2d 1430, 1433 (Fed. Cir.) (quoting *Autogiro Co. of America v. United States*, 384 F.2d 391, 395-96 (C.C.P.A. 1967)), *cert. denied*, 488 U.S. 986, 109 S. Ct. 542

(1988). "It is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim," but that "is not to be confused with adding an extraneous limitation appearing in the specification, which is improper." E.I. DuPont, 849 F.2d at 1433. Rather, the specification "acts as a dictionary when it expressly defines terms used in the claims and when it defines terms by implication," Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996), although "any special definition given to a word must be clearly defined in the specification." Markman, 52 F.3d at 980.

## 1. "Card" and "rim"

Plaintiff argues that the specification defines the "rim" as a top layer, and the "card" as a middle layer. However, the specification does not define those terms or use them consistently in that way. While it calls the top layer the "rim" and the middle layer the "card" in describing some embodiments, it calls the top layer the "card" and the middle layer the "rim" in describing others.

There are numerous instances where the specification calls the top layer a "card." For example, in the very first part of the specification, the "Summary of the Invention," the top "overlying" layer is called a "card member," and the middle layer is called a "rim member." '100 patent, col. 2, 11. 30-41. Later, in describing the embodiment shown in Figures 4, 5, and 6, the specification again uses the word "card" in referring to the top layer. It refers to two layers, a "card rim" and a "stiff rim," and then suggests that the top, overhanging layer is the "card rim" by saying that the "card rim 72 ... overlays mat." See '100 patent, col. 5, 11. 17-18. FN4

FN4. Because there are no drawings showing a cross-section of that embodiment, it is not absolutely clear that the "card rim" is the top layer and the "stiff rim" the middle layer. There is a contrary suggestion: the specification states that the "stiff rim" is "analogous to stiff rim 12 of the embodiment shown in Figs. 1-3." See '100 patent, col. 5, 11. 14-15. That analogy suggests that the "stiff rim" in Figures 4-6 may be the top layer, since "rim 12" is shown in Figure 3 as the top layer.

The specification again calls a top layer a "card" when it describes the embodiment shown in Figures 7 and 8. It refers to a "rim" and a "card," and the figures show that the "card" is the top layer. The written description confirms that the "card" is on top: it says that the mat is under the "card," not under the "rim." See col. 5, 11. 37-38 (the mat can be "placed under card 94 into the stiff locking rim").

In fact, one of the inventors, Mark Roberts, testified that the specification erroneously uses the term "card" to refer to the top layer. When asked about Figures 7 and 8, he saw that the specification clearly called the top layer a "card," even though, in his opinion, that was an "error":

Q: Would you identify the card of the photo frame shown in figures 7 and 8 with the yellow color.

A. I believe as I'm reading 7 and 8, or figure 7, that they've erroneously interchanged the terms card and rim here.

Q. Okay. Well, can you identify in yellow the card --

A. The card is not shown.

Q. Okay. And you are saying that this portion of the 573 patent is in error, correct?

A. That is correct. Quite obviously in error.

\* \* \*

A. ... I'm saying that the terms card and rim were obviously interchanged here.

Q. Okay. So in other words, according to your testimony, the way this sentence FN5 should read --

FN5. Which reads "... can be reversed and placed under *card* 94 into the stiff locking *rim* (not shown) ..."*573 patent, col. 5, 11. 35-36 (emphasis added).*

\* \* \*

... It should read, "can be reversed and placed under rim 94" --

A. No.

Q. "Into the stiff locking card," parens, "not shown." Is that the way it should read?

A. Yes, that's correct.

Q. That's the way it should read, according to your testimony?

A. That's right.

\* \* \*

Q. ... It says -- it talks about it [the mat] being placed under card 94.

A. Okay. I believe we've already said that the card should be rimmed [rim].

Q. Okay. But let's assume that it is not incorrect.

A. How can I assume that when it obviously is?

\* \* \*

Q. Okay. Now, what does it mean when it says the mat is placed under the card?

A. Sir, I've already told you that this is an error. It is obviously an error, and we should reverse the words card and rim. So not reversing them, it is impossible to give you an answer."

(Roberts dep. at 457-58, 461-62.)

Although the inventor thinks the specification is "obviously" incorrect, it clearly uses the term "card" to refer to the top layer. That usage discredits plaintiff's contention that the specification defines "rim" as the top layer and "card" as the middle layer.

It is at least troubling that the inventor found it impossible to testify to what that part of the specification means in its published form.

## 2. "Secured"

Even if plaintiff's contention that the rim is the top layer were accepted, that would call into question how the rim is "secured to said inner side of said cover," since the cover is clearly on the bottom and therefore adjacent to the middle layer, not the top layer. Plaintiff contends that "secured to" should be interpreted to mean only that the rim is connected to the cover "via" the card.

That interpretation of "secured" is not supported by the specification. The specification's description of how elements of the claimed device may be secured to one another suggests that "securing" is direct, not via other elements:

"It should also be recognized that the securing means for bonding the various elements of the mounting leaf together may comprise one of more conventional means for attaching, such as adhesives, stitching, and the like."

'100 patent, col 4, 11. 20-23. In describing the embodiments, the specification describes various layers as "secured" by direct means such as gluing. The accompanying drawings depict the "secured" layers as adjacent.

Only twice does the specification seem to describe layers that are secured to others via other layers. One instance is clear. In discussing the embodiment shown in Figures 1-3, it describes the top "rim portions" as "secured to" the "backing" or bottom layer, even though those two layers are shown in a drawing not as adjacent but as separated by "card portions," which are shown as middle layers and are described as "suitably adhesively secured to rim portions 12." '100 patent, col. 3, 11. 25-32 & Fig. 3. The other instance is less clear. The description of the embodiment shown in Figures 4-6 somewhat suggests that a top layer may be "attached to" a bottom layer despite the existence of a middle layer. As discussed earlier, the specification appears to refer to the top layer in that embodiment as the "card rim" and the middle layer as the "stiff rim." It also states that "A quadrilateral, stiff card rim 72 is attached by suitable means such as gluing to the inner surface of cover 68." '100 patent, col. 4, 11. 59-61. If the "stiff card rim" refers to the "card rim," the specification is describing a top layer as "attached to" a bottom layer. However, it is not clear what "stiff card rim" means. It could refer to the card rim and the stiff rim considered together as a unitary layer. If so, its connection to the cover is direct, not via an intermediate layer.

Although those two instances may suggest that the term "secured" is broad enough to cover the indirect connection of nonadjacent layers, the specification generally uses "secured" to refer to the direct connection of adjacent parts. Accordingly, the specification, considered as a whole, does not clearly define "secured to" to mean the connection of nonadjacent layers via intermediate layers. *See* Markman, 52 F.3d at 980 (any special meaning for terms must clearly be set forth in the specification); Burlington Industries, Inc. v. Dayco

Corp., 849 F.2d 1418, 1421 (Fed. Cir. 1988) (an inventor "must use his words consistently in the claims and in the specification").

### **C. The prosecution history**

The prosecution history FN6 shows that the inventors intended the rim to be the top layer and the card to be the middle layer. They explained that the "rim" overlies the "card," and amended the specification to make its use of those terms consistent:

FN6. References in this opinion to the "prosecution history" apply equally to the '573 patent and '100 patent. The inventors made the statements quoted here during their prosecution of the '573 patent, which issued first. The '100 patent issued later from an application that was a "divisional" of the application that led to the issuance of the '573 patent. Those applications were prosecuted in succession before the same patent examiner.

"The specification has been amended on pages 11, 12, 13 and 14 to correct a minor inconsistency, wherein feature '130' should always refer to the 'rim' and wherein feature '140' or feature '154' should always refer to the card. As shown in Fig. 3 ... the rim 12 is the laminated layer which overlays substrate card layer 16. As shown in Figs. 9 to 12, the rim 130 covers card 140. As shown in Figs. 13A, 13B, 13C and 13D, rim 130 overlays card 154. These amendments make this terminology consistent throughout the specification." (Kerry Miller Aff. at 276-78.)

However, their understanding is contradicted by the claims and the specification. For example, one of the inventors concedes that the specification sometimes calls the top layer a "card." The inventors never explained that contradictory language to the examiner. Nor did they explain why the claim describes the rim as "secured to" the cover, rather than the card, even though the specification describes "securing" as done by direct means; nor why the specification describes an "overlying card" above a middle "rim"; nor why it refers to the top layer in the embodiment shown in Figures 4 to 6 as a "card rim."

In fact, the prosecution history suggests that even the inventors were initially confused about the different layers and the size of their windows. In prosecuting the '573 patent (which issued before the '100 patent), they submitted claims reciting that the card's inner edge was "spaced more inwardly" than the rim's inner edge, then later amended the claims to recite the opposite, that the card's inner edge was spaced "less inwardly" than the rim's. Miller Aff. at 199, 268, 278. FN7

FN7. The examiner later changed the inventors' phrase, "being spaced less inwardly," to the phrase that issued in the patent, "extending less inwardly." Miller Aff. at 305.

The prosecution history therefore shows what the inventors intended by the terms used in the claims, but does not resolve the inconsistent ways those terms are used in the claims and specification. Even where inventors make clear to an examiner what their invention is meant to be, they still must define the terms used in the claims so that the claims describe that invention. That definition, if different from the ordinary meaning, must appear in the specification. *See Lear Siegler v. Aeroquip Corp.*, 733 F.3d 881, 889 (Fed. Cir. 1984) ("an inventor is permitted to define the terms of his claims," but "the place to do so is in the specification"); *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1571 (Fed. Cir.) (although an inventor may be his own lexicographer, "the patent specification must support his asserted definition"), *cert.*



*denied*, 488 U.S. 892, 109 S. Ct. 228 (1988). It is not enough to intend to claim an invention. Rather, "it is the responsibility of patent applicants to define their inventions adequately." *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1578 (Fed. Cir. 1993), *cert. denied*, 114 S. Ct. 1645 (1994). Even if the inventors intended a different invention, the claims must govern:

"[W]e are not free to read the claims as they might have been drafted, even if as drafted they do not accomplish what the inventor may have intended.

"Claim drafting is itself an art, an art on which the entire patent system depends.... The public generally, and in particular, the patentee's competitors, are entitled to clear and specific notice of what the inventor claims as his invention.... There is no room in patent claim interpretation for the equivalent of the *cy pres* doctrine; that would leave the claiming process too indefinite to serve the purposes which lie at the heart of the patent system."

*Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1563 (Fed. Cir.) (Plager, J., concurring), *cert. denied*, 116 S. Ct. 2554 (1996).

## **D. Presumption of Validity**

If a top layer has a larger window than a middle layer, the top layer does not overlie the middle layer's window to create a peripheral recess. Plaintiff argues that the card, which has a larger window than the rim, therefore cannot be the top layer, because that would mean that the "recess" described in the claim is not created, which runs against the principle that "claims are generally construed so as to sustain their validity, if possible." *Whittaker Corp. v. UNR Industries, Inc.*, 911 F.2d 709, 712 (Fed. Cir. 1990).

That principle does not require abandonment of all the ordinary principles of claim construction. *See Texas Instruments, Inc. v. United States Intl. Trade Commn.*, 871 F.2d 1054, 1065 (Fed. Cir. 1989) (the rule that claims should be construed to preserve their validity does not justify reading into a claim a limitation it does not contain). As drafted, the claim, viewed in light of ordinary principles of claim construction, describes a top "card" with a window and a middle "rim" with a smaller window. The specification does not define the claim terms in a way that reasonably shows that the claims should be interpreted to mean that the rim overlies the card.

## **II. Infringement**

All of the accused devices have a peripheral recess formed where the window of the top layer is smaller than, and overlies, the window of the middle layer. Accordingly, they do not infringe claim 1 of the '573 patent or claim 1 of the '100 patent, because those claims describe a structure where the window of the top layer is larger than the window of the middle layer.

Nor do the accused devices infringe under the doctrine of equivalents. Under that doctrine, there is infringement "if, and only if, the differences between the claimed and accused processes are insubstantial." *Hilton Davis Chemical Co. v. Warner Jenkinson Co.*, 62 F.3d 1512, 1517 (Fed. Cir. 1995), *cert. granted*, 116 S. Ct. 1014 (1996). There is a significant difference between the accused devices, which have a recess created by an overlying top layer, and the claimed device, which does not.

## **CONCLUSION**

Defendants' motion for summary judgment of non-infringement of the '573 patent and '100 patent is granted; plaintiff's motion for summary judgment of infringement of those patents is denied.

The Clerk will enter judgment dismissing the complaint. No costs.

So ordered.

S.D.N.Y.,1997.

Art Leather Mfg. Co., Inc. v. AlbumX Corp.

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