

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

CORTLAND LINE COMPANY, INC,
Plaintiff.

v.

THE ORVIS COMPANY, INC,
Defendant.

Oct. 7, 1998.

Hancock & Estabrook, LLP, Syracuse, New York, for Plaintiff, James R. Muldoon, of counsel.

Brown, Pinnisi & Michaels, P.C., Ithaca, New York, for Defendant, Paul E. Wagner, of counsel.

Vickers, Daniels & Young, Cleveland, Ohio, Thomas E. Young, of counsel.

MEMORANDUM-DECISION and ORDER

MUNSON, Senior J.

Defendant The Orvis Company, Inc. ("Orvis") manufactures and sells the "Rocky Mountain Reel," an interchangeable cartridge reel used in fly fishing. Plaintiff Cortland Line Company, Inc. ("Cortland") likewise manufactures an interchangeable cartridge reel, patented under U.S. Patent No. 5,120,003 ("the '003 patent"), and marketed under a registered trademark, "Cassette." As explained more fully, *supra*, Cortland alleges Orvis has infringed upon the '003 patent and misused the Cassette trademark.

Orvis previously moved to dismiss Cortland's claims, but the court denied its motion on January 5, 1998. *See Cortland Line Co., Inc. v. Orvis Co., Inc.*, No. 97-CV-1294, 1997 WL 808608 (N.D.N.Y. Jan.5, 1997). FN1 In denying Orvis' motion to dismiss, the court held Cortland stated a *prima facie* infringement case. Given the nature of the motion, the court refused to consider certain documents Orvis had attached to its motion, including the prosecution history of the '003 patent. The court did not convert the motion into one for summary judgment because Orvis had not filed an answer and neither party had engaged in discovery. Now that Orvis has filed an answer and the parties have engaged in discovery, Orvis has filed a detailed motion for summary judgment, which Cortland opposes.

FN1. The citation service erroneously states the court decided its previous decision on January 5, 1997.

BACKGROUND

Cortland did not invent the '003 patent, but acquired the rights and interest to it from STH Reels, Inc. ("STH") on January 25, 1996. In the same transaction, it also acquired the rights and interests to a registered

trademark, "Cassette," which STH had used to market the '003 patent. As Cortland explains, the advent of the interchangeable cartridge reel revolutionized fly fishing. An important element of fly fishing is the fly line, for different fishing conditions may call for different fly lines, varying in density and weight. Prior to the invention of the interchangeable cartridge reel, if a fly fisherman cast his fly line unsuccessfully at his favorite spot and thought a change in fly line might bring him better luck, typically he could change his fly line in two ways: either unwind the line on the reel and replace it with new line, which was time consuming and unwieldy, or replace the spool he was using with a spare, which was a fairly expensive alternative. The great advantage of an interchangeable cartridge fishing reel is that it allows a fly fisherman to use fishing line of different weights and densities within the spool of a single reel. Ward Decl. at para. para. 4-6.

Since its transaction with STH, Cortland has marketed its own successful line of interchangeable cartridge reels, embodying the design of the '003 patent, under the Cassette trademark. The Cassette trademark and goodwill associated with it are valuable property rights and have become synonymous with the source and quality of goods and services that Cortland sells.

As noted above and in this court's previous decision, the gravamen of this lawsuit is twofold: first, Cortland claims Orvis has infringed upon the '003 patent; and second, Cortland alleges Orvis has violated federal trademark law, 15 U.S.C. s. 1114, the Lanham Act, 15 U.S.C. s. 1051, *et seq.*, and related New York state law through misuse of the Cassette trademark. On the one hand, Cortland alleges the Rocky Mountain Reel is similar in design and operation to the '003 patent, its interchangeable cartridge reel. On the other, it raises four trademark claims, arguing that Orvis has: (1) infringed on its federal trademark in violation of 15 U.S.C. s. 1114 by using the Cassette trademark without consent in connection with the sale or marketing of fishing reels; (2) violated the Lanham Act, 15 U.S.C. s. 1125(a), by falsely representing the Cassette trademark in connection with its Rocky Mountain Reel; (3) committed common law trademark infringement by misappropriating the Cassette trademark; and (4) violated New York General Business Law s. 368-d, the state's anti-dilution statute. FN2 Cortland seeks injunctive relief, damages and attorney's fees.

FN2. New York General Business Law s. 368, including s. 368(d), was repealed effective January 1, 1997. Cortland's complaint was filed subsequent to the repeal date, therefore it has no cause of action under that statute.

Orvis counters that as a matter of law its Rocky Mountain Reel does not literally infringe Cortland's '003 patent because the reel lacks elements embodied in that patent. Citing the patent's prosecution history, Orvis submits its reel does not infringe on the '003 patent under the doctrine of equivalents because: (1) any construction of the claims of the '003 patent that would encompass the Rocky Mountain Reel also would read on the prior art; and (2) prosecution history estoppel limits the scope of equivalents Cortland may assert. As for Cortland's trademark claims, Orvis argues: (1) it does not use "cassette" in a trademark sense and therefore its fair use is protected under 15 U.S.C. s. 1115(b)(4); and (2) the term "cassette" as it is applied to fly fishing reels is generic and therefore no longer eligible for trademark protection. The court examines these arguments *seriatim*.

DISCUSSION

I. Standard for Summary Judgment

Summary judgment is as appropriate in a patent case as any other case. *Eagle Comtronics v. Northeast Filter Co.*, 816 F.Supp. 152, 155 (N.D.N.Y.1993) (McCurn, C.J.) (*citing* *Avia Group Int'l, Inc. v. L.A. Gear Cal.*,

Inc., 853 F.2d 1557, 1561 (Fed.Cir.1988)). The standard for summary judgment is well-settled: Rule 56 allows for summary judgment where the evidence demonstrates that "there is no genuine issue of any material fact and the moving party is entitled to judgment as a matter of law." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 2510, 91 L.Ed.2d 202 (1986). A motion for summary judgment may be granted when the moving party carries its burden of showing that no triable issues of fact exist. *Thompson v. Gjivoje*, 896 F.2d 716, 720 (2d Cir.1990). A dispute regarding a material fact is genuine "if evidence is such that a reasonable jury could return a verdict for the non-moving party." *Anderson*, 477 U.S. at 248, 106 S.Ct. at 2510.

Any inferences to be drawn from the facts must be viewed in the light most favorable to the non-moving party. *Id.*; *United States v. Diebold, Inc.*, 369 U.S. 654, 655, 82 S.Ct. 993, 994, 8 L.Ed.2d 176 (1962) (*per curiam*). If the moving party meets its burden, the burden shifts to the non-moving party to come forward with "specific facts showing that there is a genuine issue for trial." Fed.R.Civ.P. 56(e). The non-moving party "must do more than simply show that there is some metaphysical doubt as to the material facts," however, to defeat a motion for summary judgment. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986). Finally, if reasonable minds could not differ as to the import of the evidence, then summary judgment is proper. *Id.*, at 250-251, 106 S.Ct. at 2511.

II. Is Summary Judgment Premature?

Initially, Cortland contends summary judgment is premature because-in its words-"there has been virtually no substantive discovery." Dft's Mem. at 4. It notes that Fed.R.Civ.P. 56(f) provides:

Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the application for judgment or may order a continuation to permit affidavits to be taken or discovery to be had or may make such other order as is just.

The affidavit of the non-movant who seeks additional time for discovery to aid in its opposition to summary judgment must comport with four requirements. It must: (1) include the nature of the uncompleted discovery; (2) show how the facts sought are reasonably expected to create genuine issues of material fact; (3) detail what efforts the affiant has made to obtain those facts; and (4) explain why those efforts were unsuccessful. *Burlington Coat Factory Warehouse Corp. v. Esprit De Corp.*, 769 F.2d 919, 926 (2d Cir.1985).

In asserting Orvis has been unnecessarily dilatory throughout discovery, Cortland levels a host of allegations. *Inter alia*, Cortland charges Orvis with filing a procedurally improper motion to dismiss; asserting facially deficient affirmative defenses and counterclaims; substituting counsel on the eve of the parties' Rule 16 conference; failing to respond to its requests for document production and interrogatories for two months after these responses were due; and selectively producing some documents while omitting others. At a minimum, Cortland argues, it requires depositions from key Orvis personnel and complete responses to its discovery demands to respond adequately to Orvis' instant motion.

Orvis counters that Cortland has not explained how the additional discovery it seeks is "reasonably expected to create genuine issues of material facts." *Id.* It contends a plain reading of the first claim of the '003 patent ("Claim One"), as well as its specification and prosecution history, demonstrates as a matter of law that the Rocky Mountain Reel does not infringe upon the '003 patent either literally or through the doctrine of

equivalents. As to Cortland's trademark claim, Orvis makes two arguments. First, it submits the Cassette trademark has become generic, obviating any relevance in its use of that term. Second, James LePage, an Orvis manufacturing engineer, affirms that Orvis has produced "all documents in Orvis's possession or control that use the term 'cassette' to refer to the Rocky Mountain Reel or any other fishing reel manufactured by Orvis." LePage Reply Aff. at para. 2. Given the limited nature of how it used the word "cassette," Orvis argues its use constituted statutory fair use and did not infringe on the trademark. In short, Orvis posits further discovery would be superfluous because the court can find summary judgment is appropriate even with the limited evidence now before it.

Judge Scullin of this district recently addressed similar discovery issues in *Canton Bio-Medical, Inc. v. Integrated Liner Technologies, Inc.*, No. 97-CV-467, 1998 WL 480864, ---- F.Supp.2d ---- (N.D.N.Y. Aug. 13, 1998), which was also a patent infringement case. In *Canton Bio-Medical, Inc.*, the plaintiff lodged a Rule 56(f) objection on the grounds it needed more discovery to defend against the defendant's motion for summary judgment. As Judge Scullin reasoned:

the two material issues in this motion are (1) claim construction of the Plaintiff's patent, and (2) the applicability of prosecution history estoppel to preclude the Plaintiff from asserting infringement under the doctrine of equivalents. Both of these issues are questions of law[,] which are determined based upon the patent application, specifications and the prosecution history of the patent. If the Court does require additional extrinsic evidence to construe the Plaintiff's claims it may rely on dictionaries, treatises, and if needed, expert opinion. [Footnote omitted] Thus, the Plaintiff's requested further discovery should not affect the Court's decision on this motion.

Id. at *4. Whether Cortland requires more discovery to defend against summary judgment on its trademark infringement claim is another matter, which the court addresses *supra*; but in relation to its patent infringement claim, *Canton Bio-Medical, Inc.* clearly negates Cortland's Rule 56(f) objection because the '003 patent's claim, specification and prosecution history are properly before the court. Accordingly, the court turns to the merits of Cortland's patent infringement claim.

III. Standing

In its papers, Orvis contends Cortland lacks standing to prosecute this case; but subsequent to the filing of its motion, Orvis informed the court it would not challenge Cortland's standing. Briefly, Orvis had argued Cortland lacked legal title to the '003 patent because former holder of the patent improperly conferred the right to it to Cortland. Unquestionably, under 35 U.S.C. s. 100(d) (1994), a proper assignee to a patent enjoys the right to bring suit in its own name, but a suit for infringement "must ordinarily be brought by a party holding legal title to the patent." *Enzo APA & Son. Inc. v. Geapag A.G.*, 134 F.3d 1090, 1093 (Fed.Cir.1998). Orvis had claimed there was no evidence reflecting any assignment of the rights to the '003 patent from its holder to Cortland, but-as it appears to have acknowledged-it was mistaken.

On January 25, 1996, Cortland entered into an agreement with the named inventor of the '003 patent, Roberto Sacconi, and the "Steelhead group"-Steelhead Argentina, S.R.L., an Argentina corporation; STH Reels USA, Inc., a Florida corporation; and America Fly Reels Inc., also a Florida corporation-that assigned, transferred and conveyed "all their right, title and interest in and to U.S. Patent No. 5,120,003, and U.S. Trademark Registration No. 1,693,273" to Cortland. FN3 Ward Decl. at Ex. A, para. 2. Notwithstanding Cortland's failure to register the assignment of the '003 patent rights, the assignment was valid and Cortland has standing to bring this action. *See Cor Marketing & Sales, Inc. v. Greyhawk Corp.*,

994 F.Supp. 437, 444 (W.D.N.Y.1998) (assignment of patent rights held valid despite fact assignment never registered with U.S. Patent and Trademark Office).

FN3. The trademark registration number refers to the "Cassette" trademark.

IV. Standard for Patent Infringement Claims

A patent infringement analysis entails two steps: (1) determining the meaning and scope of the patent claims asserted to be infringed; and (2) comparing the properly construed claims to the device accused of infringing. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed.Cir.1995) (en banc), *aff'd* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). The construction of patent claims is a matter of law for the court to determine. *Id.* at 979. The question of infringement usually is a question of fact. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1573 (Fed.Cir.1997); *accord* *Southwall Technologies, Inc. v. Cardinal IG Company*, 54 F.3d 1570, 1575 (Fed.Cir.), *cert. denied*, 516 U.S. 987, 116 S.Ct. 515, 133 L.Ed.2d 424 (1995).

To determine the proper construction of a patent claim, courts first analyze intrinsic evidence, which comprises three things: its claims, specification and prosecution history. *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996); *accord* *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed.Cir.1991). Intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language. *Vitronics*, 90 F.3d at 1582.

Initially, courts review the claim, particularly the language that defines the scope of the claim's protection. *Bell Communications Research, Inc. v. Vitalink Communications Corporation*, 55 F.3d 615, 619 (Fed.Cir.1995). This language is ascribed its "ordinary meaning[,] unless it appears the inventor used [it] otherwise." *Id.* at 620; *see also* *Hoechst Celanese Corp. v. BP Chems, Ltd.*, 78 F.3d 1575, 1578 (Fed.Cir.1996); *Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1196 (Fed.Cir.1994) (unless specification or "file history indicate that the inventor intended otherwise, a claim term will be accorded its ordinary and accustomed meaning"). In other words, the court determines "what one of ordinary skill in the art at the time of the invention would have understood the term to mean." *Markman v. Westview Instruments, Inc.*, 52 F.3d at 986.

Courts also review the patent specification to determine whether the inventor has used any terms in a manner not consonant with their ordinary meaning. The specification contains a written description of the invention and operates "as a sort of dictionary, which explains the invention and may define terms used in the claims." *Id.* at 979. It is the single best guide to the meaning of a disputed term. *Vitronics*, 90 F.3d at 1582.

If available, courts consider the patent's prosecution history. *Graham v. John Deere*, 383 U.S. 1, 33, 86 S.Ct. 684, 701-02, 15 L.Ed.2d 545 (1966). The prosecution history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims. Separate and apart from the concept of prosecution history estoppel, statements made by an applicant during the application process may confirm and define a claim term. *Southwall Technologies, Inc.*, 54 F.3d at 1578. Courts do not accord the prosecution history or specification the same weight as the claim itself, but instead consult these sources to give the necessary context to the claim language. *See Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547,

1555 (Fed.Cir.1997). Accordingly, like the specification, the prosecution history "cannot 'enlarge, diminish, or vary' the limitations in the claims." *Markman*, 52 F.3d at 980 (citation omitted).

Often, the intrinsic evidence alone is enough to resolve any ambiguity in a disputed claim term and courts need look no further. *See Vitronics*, 90 F.3d at 1583 (if intrinsic evidence "unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper"). Yet, on occasion, courts need assistance in determining the meaning or scope of technical terms in the claims. In such instances, courts may rely upon extrinsic evidence to understand better the meaning of the language and relevant technology at issue. *Markman*, 52 F.3d at 980; *Pall Corp. v. Micron Separations, Inc.*, 66 F.3d 1211, 1216 (Fed.Cir.1995). Typically, extrinsic evidence includes expert witness testimony, such as evidence of how those skilled in the art would interpret the claims. *Fonar Corp. v. Johnson & Johnson*, 821 F.2d 627, 631 (Fed.Cir.1987). Although extrinsic evidence may serve a useful purpose, it cannot vary the clear meaning of the terms in the claims: it only may provide background evidence to assist the court in its task of assigning particular meanings to the claims at issue. *Id.* at 981.

a. Construing the scope of the '003 claim

The patentee bears the burden of proving infringement by a preponderance of the evidence. *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1161 (Fed.Cir.1997). Moreover, to succeed in a patent infringement case, the patentee must show every limitation set forth in a patent claim is found in an accused product or process exactly or by a substantial equivalent. *Becton Dickinson and Company v. C.R. Bard, Inc.*, 922 F.2d 792, 796 (Fed.Cir.1990); *Valmont Industries, Inc. v. Reinke Manufacturing Company, Inc.*, 983 F.2d 1039, 1043 n. 2 (Fed.Cir.1993) (if accused device lacks any limitation or equivalent, it does not infringe the claim). If, as Orvis contends, the claim limitation set forth in Claim One or its equivalent is missing from the Rocky Mountain Reel, there is no infringement. *London v. Carson Pirie Scott & Company*, 946 F.2d 1534, 1539 (Fed.Cir.1991).

Claim One reads:

What is claimed is:

1. A fishing reel that provides for an interchangeable line bearing cartridge spool comprising:

a housing, said housing including a flat wall, said housing having a rigid first spool receiving shaft affixed thereto and protruding away from said wall;

a cartridge spool;

first spool means for mounting said cartridge spool, said first spool means comprising a first end plate, a first spool axle attached rigidly to said first end plate, a second end plate, and means for connecting said end plate to said first spool axle, said first spool receiving shaft;

means attached to said first spool means for manually rotating said first spool means;

said cartridge spool comprising two end plates and a central cartridge spool axle unitarily connected therebetween, said cartridge spool axle being fitted over and mounted upon said first spool axle, said cartridge spool carrying a supply of fishing line, whereby said cartridge spool can be installed on or

removed from said first spool.

Cortland contends each and every element of Claim One literally reads in the Rocky Mountain Reel. According to Cortland, the Rocky Mountain Reel features: (1) a "housing" including "flat wall ... having a rigid first spool receiving shaft ... protruding away from said wall"; (2) "a cartridge spool"; (3) a "means attached to said first spool means for manually rotating said first spool means," which comprises the handle attached to the first end plate opposite the spool axle; (4) the sub-element limitations defining the cartridge spool "comprising two end plates and a central cartridge spool axle unitarily connected therebetween, said cartridge spool being fitted over and mounted upon said first axle"; and (5) all the sub-elements comprising the "first spool means for mounting said cartridge spool." Plf's Mem. of Law at 12-13.

Cortland analogizes each of these latter sub-elements as follows. The "first end plate" of Claim One corresponds to "the outer reel housing of the Orvis reel [e.g., Rocky Mountain Reel] having a handle and counter weight." The "first spool axle attached rigidly to the first end plate" corresponds to "the spool axle of the Orvis reel connected to the inner face of the outer reel housing of the Orvis reel." The "second end plate," which is the most hotly contested sub-element, corresponds to "the flanged rubber grommet either alone or, in the alternative, in combination with the black plastic insert at the base of the receiving shaft that has two slots for receiving the matching prongs on the end of the first spool axle ." If the court should consider the "rubber grommet alone" as the second end plate, then the "means for connecting the second plate to the first spool axle" described in Claim One is "the interference fit of the rubber grommet to the slightly tapered end of the first spool axle"; but, Cortland informs the court, if the second end plate is defined as "the combination of the rubber grommet and the black insert," then the "connecting means" corresponds to "the interference fit of the rubber grommet on the tapered end of the first spool axle *and* the insertion of the two prongs of the first spool axle in the receiving slots of the plastic insert at the base of the receiving shaft." Finally, the "said first spool axle having a hollow aperture which is fitte[d] over said first spool receiving shaft" corresponds to "the hollow aperture of the first spool axle of the end plate of the Orvis reel for acceptance of the spool receiving shaft of the Orvis reel." *Id.*

Not surprisingly, Orvis disagrees with Cortland's interpretation and responds that its Rocky Mountain Reel differs considerably from Claim One of the '003 patent. There is no similarity between the '003 patent and the Rocky Mountain Reel, Orvis posits, based upon the latter's literal and equivalent lack of a first spool means, connecting means and—especially—a second end plate. The absence of a second end plate appears to be the thrust of Orvis's claim: e.g., because there is no second end plate or equivalent, *a fortiori* the first spool means and connecting means described in Claim One, or their equivalents, cannot be present.

b. Literal infringement

Is there a second end plate in Orvis's Rocky Mountain Reel? If not, there is no literal infringement of the '003 patent.

If the Rocky Mountain Reel features a second end plate, clearly it does not mirror the second end plate on the '003 patent. The disc-shaped first and second end plates in the '003 patent, though visually distinguishable, are approximately equal in diameter and circumference. The diameter and circumference of the Rocky Mountain Reel's first end plate, however, absolutely dwarfs the diameter and circumference of the flanged rubber grommet, the putative second end plate. Aside from obvious differences in dimensions, the second end plate in the '003 patent does not resemble the flanged rubber grommet on the Rocky Mountain Reel in another way: it features a male threaded connector mounted in its center that locks both

end plates in place when it is screwed clockwise into the female threaded connector of the first end plate. The flanged rubber grommet lacks such a connector and it "alone" cannot be considered a second end plate.

Nor does the combination of the rubber grommet and the black insert equate to a second end plate. Aside from the reasons just elaborated, the '003 patent' s prosecution history clearly delineates the first spool means for mounting said cartridge spool as a "primary reel spool that functions in a *conventional* way." (Emphasis supplied). Surely the word "conventional" adds context to the claim language, Eastman Kodak Co., 114 F.3d at 1555, and surely no one would label the combination of the rubber grommet and the black insert, in conjunction with the shaft and the first end plate, as a "conventional" spool. Again, literal infringement requires that the accused product or method contain each limitation of the claim exactly; any deviation from the claim precludes a finding of literal infringement. Litton Sys., Inc. v. Honeywell, Inc., 140 F.3d 1449, 1454 (Fed.Cir.1998). The Rocky Mountain Reel has no second end plate, therefore it does not literally infringe upon the '003 patent.

c. Doctrine of equivalents

If, as here, the moving party raises an equivalency argument, the determination of no literal infringement does not end the infringement inquiry. Becton Dickinson and Company, 922 F.2d at 797. Even if a product does not literally infringe a claim, it may infringe that claim under the doctrine of equivalents "if every element in the claim is literally or equivalently present in the accused device." Sage Products, Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1423 (Fed.Cir.1997); *see also* Warner-Jenkinson Co. v. Hilton Davis Chemical Co., 520 U.S. 17, 117 S.Ct. 1040, 1045, 137 L.Ed.2d 146 (1997). Under the doctrine of equivalents, the accused product may infringe if it "performs substantially the same overall function or work, in substantially the same way, to produce substantially the same overall result as the claimed invention." *See* Dolly, Inc. v. Spalding & Evenflo Cos., 16 F.3d 394, 397 (Fed.Cir.1994). Courts apply the doctrine to the individual elements of the claim, however, and not to the invention as a whole. Warner-Jenkinson Co., 117 S.Ct. at 1049. In other words, the focus of the doctrine of equivalents is: "Does the accused product or process contain elements identical or equivalent to each claimed element of the patented invention?" *Id.*, 117 S.Ct. at 1054.

A claim is "equivalently present" if only "insubstantial differences" distinguish the missing claim element from the corresponding aspects of the accused device. Dawn Equip., Co. v. Kentucky Farms Inc., 140 F.3d 1009, 1016 (Fed.Cir.1998). The Supreme Court offers a caveat, though: the doctrine of equivalents "is not allowed such broad play as to effectively eliminate [an] element in its entirety." Warner-Jenkinson, 117 S.Ct. at 1049. Thus, although equivalence is a factual matter typically reserved for a fact finder, courts should grant summary judgment in cases "where no reasonable fact finder could find equivalence." Sage Prods., 126 F.3d at 1424; *see also* Warner-Jenkinson, 117 S.Ct. at 1053 n. 8.

Again, Orvis contends the Rocky Mountain Reel lacks an equivalent first spool means, second end plate and a connecting means; and again, the real focus of this court's inquiry is the second end plate. Cortland claims that the function of the second end plate, according to the '003 patent, is to ensure same plane rotation for the cartridge spool and the first spool means. Quoting from the patent, Cortland notes:

when the removable end plate from the first spool is threadably engaged tightly with respect to the first spool shaft with the cartridge spool in position, there will be frictional contact between the first cartridge spool end plates which also resist relative rotation between the two spools.

Plf's Mem. of Law at 19-20. Cortland's position is that the interface described above is replicated when the flanged rubber grommet is fitted tightly onto the first spool axle and compressed about the plastic insert about the base of the receiving shaft in the Rocky Mountain Reel. In other words, given the ultimate function of the combination of the flanged rubber grommet and the plastic insert, this combination is the equivalent of a second end plate.

Orvis reiterates that the prosecution history specifically refers to the first spool means as a primary reel spool that functions in a conventional way. Citing *Vehicular technologies Corp. v. Titan Wheel Int'l, Inc.*, 141 F.3d 1084, 1090, Orvis proposes that if a claim limitation must play a role in the context of the specific claim language, then an accused device which cannot play that role, or which plays a substantially different role, cannot infringe under the doctrine of equivalents. Orvis explains that the flanged rubber grommet, which is mounted inside at the end of the cartridge spool axle, "merely provides engagement between the cartridge spool and the cartridge mounting arrangement, retaining the cartridge on the cartridge mounting arrangement as the reel is assembled." Plf's Mem. of Law at 24. Orvis also notes that the connection between the rubber ring and the cartridge mounting axle does not fasten or lock as does the threaded connector in the '003 patent. In other words, whereas in the Rocky Mountain Reel the removable cartridge, into which the flanged rubber grommet is fitted, separates from the cartridge mounting axle when a moderate amount of force, like a quick tug, is applied to it, the threaded connector in the '003 patent does not permit such a separation; instead, to remove the removable cartridge from Cortland's reel, one must first unthread the threaded connector that secures the first and second end plates. No rational jury, Orvis maintains, could find that the Rocky Mountain Reel's flanged rubber grommet is the functional equivalent of the '003 patent's second end plate. The court agrees.

The flanged rubber grommet operates substantially differently when compared to the '003 patent's second end plate, not to mention its threaded connector. Under the doctrine of equivalents, each claim limitation must be met by an equivalent element in an accused device, which is not the case here. Orvis's motion for summary judgment as to Cortland's patent infringement claims is granted. FN4

FN4. Orvis also argues Cortland cannot overcome the doctrine of prosecution history estoppel. Generally, prosecution history estoppel prevents a patentholder from arguing that a feature of an accused product is equivalent if the patentholder was compelled to surrender that feature during the prosecution history in order to obtain the patent. *See, e.g., Jonsson v. Stanley Works*, 903 F.2d 812, 817 (Fed.Cir.1990). However, because the court reaches the merits of Orvis' summary judgment motion on other grounds, it does not address the prosecution history estoppel argument.

V. The "Cassette" Trademark

Cortland raises three trademark infringement claims: one pursuant to 15 U.S.C. s. 1114(1), another under 15 U.S.C. s. 1125(a), and a final claim under state common law. Both of the federal statutory trademark claims require proof of essentially the same elements. *See Bi-Rite Enters., Inc. v. Button Master*, 555 F.Supp. 1188, 1192 (S.D.N.Y.1983). Under 15 U.S.C. s. 1114(1), Cortland must show that Orvis, without consent, used in commerce a reproduction, copy or colorable imitation of Cortland's registered mark, as part of the sale or distribution of goods or services, and that this use is likely to cause confusion. *Gruner + Jahr U.S.A. Publ'g v. Meredith Corp.*, 991 F.2d 1072, 1075 (2d Cir.1993). Under 15 U.S.C. s. 1125(a), Cortland must establish that Orvis:

in connection with any goods ... or container for goods uses in commerce any word, term, name, symbol, or device or any combination thereof ... which ... is likely to cause confusion, or to cause mistake, or to deceive ... as to the origin, sponsorship, or approval of his or her goods ... by another person.

15 U.S.C. s. 1125(a) (1994).

The common law trademark infringement claim is similar to the federal trademark claims. To prevail on a common law trademark infringement claim, a party must establish two things: (1) the symbols for which it seeks trademark protection are valid, legally protectable marks; and (2) another's subsequent use of a similar mark is likely to create confusion as to the origin of the product. *Tri-Star Pictures, Inc. v. Leisure Time Productions*, 17 F.3d 38, 43 (2d Cir.1994); *Pirone v. MacMillan, Inc.*, 894 F.2d 579, 581-82 (2d Cir.1990).

Orvis's defenses are twofold. First, it maintains the term "cassette" as applied to fly fishing reels is generic and no longer eligible for trademark protection; and second, it asserts that as it does not use "cassette" in a trademark sense, it is entitled to a "fair use" defense under 15 U.S.C. s. 1115(b)(4). It is the latter defense the court examines first.

As a general rule, fair use allows non-owners of a protected trademark "to describe aspects of their own goods, provided the use is in good faith and not as a mark." *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 270 (2d Cir.1995). To establish a fair use defense, Orvis must demonstrate its use of the word cassette "is a use otherwise than as a mark ... of a term which is descriptive of and use fairly and in good faith only to describe the ... goods or services of such party, or their geographic origin." 15 U.S.C. s. 1115(b)(4). If viable, fair use clearly is a defense to each of Cortland's statutory federal trademark claims. *See, e.g., Wonder Labs, Inc. v. Procter & Gamble Co.*, 728 F.Supp. 1058, 1064 at n. 6 (S.D.N.Y.1990) (holding fair use not only statutory defense to 15 U.S.C. s. 1114(1), but also defense to 15 U.S.C. s. 1125(a)). Moreover, the court finds fair use may be a defense to Cortland's common law trademark infringement claims, too. *Cf. Id.* at 1067 (holding fair use as defense to claim of common law unfair competition and noting "standard for unfair competition under New York law is very similar to the standards of the Lanham Act," *e.g.*, 15 U.S.C. s.s. 1114(1) and 1125(a)).

Although fair use is a mixed question of law and fact, courts in this circuit resolve fair use determinations at the summary judgment stage where there are no genuine issues of material fact. *See Wright v. Warner Books, Inc.*, 953 F.2d 731, 735 (2d Cir.1991); *Leibovitz v. Paramount Pictures Corp.*, 948 F.Supp. 1214, 1217 (S.D.N.Y.1996), *aff'd* 30 C.C.P.A. 1271, 137 F.2d 109 (2d Cir.1998). Cortland, however, contends summary judgment is not appropriate because it has not had sufficient discovery. The court disagrees. James LePage's reply affidavit testimony is that on June 12, 1998, Orvis produced "all documents in [its] possession or control that use the term 'cassette' to refer to the Rocky Mountain Reel or any other fishing reel manufactured by Orvis." *LePage Reply Aff.* at para. 2. Cortland does not refute LePage in any detail, however: it counters generally that Orvis "unilaterally limited the scope" of its discovery demands and "refused to produce relevant documents." Rule 56(f) Decl. of James Muldoon, Esq. at para. 14. Cortland neither sufficiently articulates the nature of the uncompleted discovery it seeks, nor does it show how the facts it seeks are reasonably expected to create genuine issues of material fact. *Burlington Coat Factory Warehouse Corp.*, 769 F.2d at 926. These deficiencies are fatal to its Rule 56(f) argument: the court turns to the fair use defense.

How often Orvis used the term "cassette" and in what context is a matter of some debate. Orvis admits that it used the term in a dealer manual that promoted only its products, but notes: (1) it did not use "cassette" in

the name of its product, as a promotional slogan, or as a logo, but used the term in small print and in a sentence of textual commentary regarding the Rocky Mountain Reel; FN5 (2) it did not capitalize the first letter of "cassette," as Cortland does in its registered trademark; and (3) in using "cassette" to describe the Rocky Mountain Reel, it linked its use with the word "type"- *e.g.*, "cassette type." LePage Aff. at para. para. 21-23.

FN5. The Orvis Spring 1997 Fishing Guide describes the Rocky Mountain Reel as a "[n]ew cassette type reel for inexpensive spool convenience." The Guide is 110 pages long and was distributed to Orvis dealers and sales representatives only. Approximately 1200 copies of the manual were printed and distributed. LePage Aff. at Ex. P, para. 22.

Cortland counters with the declaration of Brian T. Ward, its president, who affirms that while he was at International Fly Tackle Dealers Show held in Denver, Colorado in September 1996, at which show Orvis introduced its Rocky Mountain Reel to the trade, "word of [the] new reel spread among attendees referring to [it] as the 'Orvis Cassette Reel.'" ' Ward Decl. at para. 12. Ward also affirms, "to the best of [his] recollection," that not only did the display of the Rocky Mountain Reel make "prominent reference" to the term "cassette," but also, to the "best of [his] recollection, Orvis passed out to attendees at the trade show a one page Rocky Mountain Reel which referred to the reel with Cortland's trademark CASSETTE." *Id.* at para. 13. He continues that "[c]ontrary to the representations of Mr. LePage, the one page handout and the display were not only given to Orvis dealers, but to all attendees of the trade show including other dealers and the press." *Id.* at para. 14. "Since that time," Ward adds, "many fly tackle dealers and industry publications have started to refer to [the] Rocky Mountain Reel as the 'Orvis Cassette Reel.'" ' *Id.* at para. 15. He concludes, "[u]pon information and belief, [that] people in the fly fishing and sporting goods market now refer to the Orvis Rocky Mountain Reel as the 'Orvis Cassette Reel' due in significant part to the improper manner and use of the CASSETTE trademark by Orvis at the time it introduced its reel." *Id.* at para. 16.

Orvis opines that if people in the fly fishing and sporting goods market now refer to the Orvis Rocky Mountain Reel as the 'Orvis Cassette Reel,' it is due to the descriptive quality of the term "cassette," notwithstanding its registered trademark status. Although trademark rights may be acquired in a word with descriptive qualities, the acquisition of these rights will not prevent others from using the word in good faith in its descriptive sense, and not as a trademark. *See Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 12-13 (2d Cir.1976); *Car-Freshner Corp. v. S.C. Johnson & Son, Inc.*, 70 F.3d 267, 270 (2d Cir.1995). Orvis also contends its use of "cassette" was in good faith.

The court concurs on both suppositions: when, as here, "cassette" is modified by the word "type" to describe an interchangeable cartridge reel, its use is descriptive; and given the context of its use of the term, Orvis acted in good faith. Orvis furnishes a dictionary definition that succinctly illustrates why "cassette" is a descriptive term: "a usu. flat case or container that holds a substance, device, or material which is difficult, troublesome, or awkward to handle and can be easily changed." FN6 That people in the fly fishing and sporting goods market may refer to the Rocky Mountain Reel as the "Orvis Cassette Reel," as Cortland complains, only underscores the descriptive nature of the term "cassette." Moreover, any use of "cassette" was limited: absent its innocuous use at the September 1996 trade show and a not-for-public dealer promotion manual, the term did not appear in further advertisements for the Rocky Mountain Reel. Summary judgment on Cortland's trademark claims is appropriate.FN7

FN6. The definition is taken from *Webster's Ninth New Collegiate Dictionary*. See LePage Aff. at Ex. P.

FN7. The court finds the fair use defense is applicable, therefore it need not reach the issue of whether the term "cassette" as applied to fly fishing reels is generic and no longer eligible for trademark protection.

CONCLUSION

For the aforementioned reasons, the court GRANTS Orvis' motion for summary judgment in its entirety.

IT IS SO ORDERED.

N.D.N.Y., 1998.

Cortland Line Co., Inc. v. Orvis Co. Inc.

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