

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

BIC CORPORATION,
Plaintiff.

v.

THAI MERRY CO., LTD,
Defendant.

No. 98 Civ. 2113(DLC)

Sept. 2, 1999.

Jonathan A. Marshall, John J. Normile, John D. Garretson, Pennie & Edmonds LLP, New York, NY, for plaintiff.

R. Joseph Trojan, Trojan Law Offices, Beverly Hills, CA, for defendant.

OPINION AND ORDER

COTE, J.

On March 23, 1998, BIC Corporation ("BIC") filed this action alleging that the disposable lighters manufactured by Thai Merry Co. ("Thai") sold under the names Calico and King infringe its U.S. patent no. 5,096,414 ("414 patent"). The parties have filed cross motions for summary judgment. The motions essentially require this Court to construe one disputed passage in the 414 patent claims. The plaintiff's motion is granted and the defendant's motion is denied for the reasons set forth below.

BACKGROUND

The 414 patent contains five claims, two of which are independent-claims 1 and 5. The patent describes a child resistant lighter with a "manually actuated ignition device" that includes an "actuating member being rotatable relative to [two] projecting portions" on either side of it. This element appears in both claims 1 and 5 and is the clause at issue in this lawsuit. Claim 5 adds that the two projecting portions are comprised of "discs carried by a stud on which said actuating member is mounted." Consequently, when read together, claim 1 allows the two projecting portions of the lighter to be either movable or not, while claim 5 specifies that the two projecting portions on either side of the "actuating member" (that is, the part of the lighter that strikes the flint and ignites the flame), are also rotating discs.

The child resistance feature created by the lighter works as follows. Because an adult's thumb is fleshier than a child's, when it is pressed with sufficient force against the two projecting portions on either side of the recessed "actuating member" it will also press down on and rotate the actuating member. The patent works on the assumption that a child's thumb simply does not have enough flesh to accomplish this task.

A portion of the patent file is missing from the Patent and Trademark Office. The file does reflect, however, that the original application was rejected because the Examiner concluded that the two projecting portions of the lighter recited in the applicant's claims were identical to two thumb wheels disclosed in a reference which is called the Chernock reference. Interpreting the actuating member described in the application to be fixed to the projecting portions, as was true in the Chernock reference, resulted in an actuating member that would always rotate when the projecting portions rotated. Consequently, the Examiner made the following observations on the application:

As for the use of the structure such does no[t] carry any patentable weight in the apparatus claim. Furthermore, whether a child's finger can reach between the two projecting portions is dependent on the size of the child and can vary greatly. Also *unless the projecting portions are claimed as being freely rotatable relative to the actuating member then the size of the child's finger to that of an adult is meaningless as the rotation of the projecting portions would also rotate the actual member.*

(Emphasis supplied.) The applicant eventually proposed the description of the actuating member now contained in claims 1 and 5; this was accepted and the patent issued. FN1

FN1. The defendant's effort to put material in evidence through the submission of its attorney's affidavit must be rejected. An attorney without personal knowledge is not competent to present such evidence. *See* Rule 56(e), Fed.R.Civ.P.; *Beyah v. Coughlin*, 789 F.2d 986, 989-90 (2d Cir.1986).

Each of the defendant's lighters, sold under the names Calico and King, is a modified conventional butane lighter with a recessed actuating member that rotates against a flint to produce a spark that ignites the lighter. The actuating member is permanently fixed between two wheels so that all three rotate by necessity together. There are also two larger wheels on either side that also rotate and are structured to rotate independently of the recessed actuating member. The lighter is also designed to be child resistant: it only ignites when the thumb is pressed with sufficient force to move not just the independent outside rotating wheels, but also the recessed rotating actuating member.

One other patent requires discussion since the defendant relies upon it in arguing that it anticipated the 414 patent under the doctrine of inherency. U.S. patent no. 3,719,447 ("447 patent") was issued for an improvement in the mechanism for opening the burner valve in a cigarette lighter. The description of the lighter includes the instruction that "[i]f desired ... a pair of discs having serrated edges can be fixed to opposite sides of the flint wheel ... to assist in the rotation of the flint wheel." The claim does not refer to these discs.

In the competing motions for summary judgment the defendant has relied principally on two arguments: an interpretation of the actuating member element in the claims, and an attack on the validity of the 414 patent based on the existence of the 447 patent. The defendant does not contest that summary judgment is appropriate on the other defenses it asserted in its pleadings.

DISCUSSION

Summary judgment may not be granted unless the submissions of the parties taken together "show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of

law." Rule 56(c), Fed.R.Civ.P. The moving party bears the burden of demonstrating the absence of a material factual question, and in making this determination the Court must view all facts in the light most favorable to the non-moving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986); *Celotex Corp v. Catrett*, 477 U.S. 317, 323 (1986). When the moving party has asserted facts showing that the non-movant's claims cannot be sustained, the opposing party must "set forth specific facts showing that there is a genuine issue for trial," and cannot rest on the "mere allegations or denials" of his pleadings. Rule 56(e), Fed.R.Civ.P.; *accord Glaverbel Societe Anonyme v. Northlake Marketing & Supply, Inc.*, 45 F.3d 1550, 1560-61 (Fed.Cir.1995). Thus, in determining whether to grant summary judgment, this Court must (1) determine whether a genuine factual dispute exists based on evidence in the record; and (2) determine, based on the substantive law at issue, whether the fact in dispute is material. The Federal Circuit has made clear that even though patent infringement is a fact-intensive inquiry, summary judgment is just as appropriate in a patent case as in other cases. *See Avia Group Int'l, Inc. v. L.A. Gear Cal., Inc.*, 853 F.2d 1557, 1561 (Fed.Cir.1988).

1. Infringement of 414 patent

An infringement analysis is a two-step process in which the Court first determines the correct scope of the claim and then compares the properly construed claim to the accused device to determine whether all of the claim elements are present either literally or by a substantial equivalent. *See Renishaw PLC v. Marposs Soceita' Per Azioni*, 158 F.3d 1243, 1247-48 (Fed.Cir.1998). Where, as here, the parties only disagree as to claim interpretation, the issue of infringement turns solely on the interpretation of the claim, which the Court resolves as a matter of law. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 988-89 (Fed.Cir.1999). *See also ATD Corp. v. Lydall, Inc.*, 159 F.3d 524, 539-40 (Fed.Cir.1998).

The interpretation of the claim "begins and ends in all cases with the actual words of the claim," which are to be given their ordinary and customary meaning. *Renishaw*, 158 F.3d at 1248-49. A court may consult a dictionary to determine that ordinary meaning. *See Karlin Tech., Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971 (Fed.Cir.1999); *Renishaw*, 158 F.3d at 1250. To overcome the presumption in favor of ordinary meaning, "there must be a textual reference in the actual language of the claim with which to associate a proffered claim construction," which may occur where (1) "the patentee has chosen to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term" or (2) "the term or terms chosen by the patentee so deprive the claim of clarity that there is no means by which the scope of the claim may be ascertained from the language used." *Johnson*, 175 F.3d at 990.

In interpreting the claim, a court has broad discretion to consider extrinsic evidence "for background and education on the technology implicated by the presented claim construction issues" or even to assist in the construction of a claim where the patent and its file history do not provide the answer, but may not

use extrinsic evidence to arrive at a claim construction that is clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history, in other words, with the written record of the patent.

Key Pharmaceuticals v. Hercon Labs., 161 F.3d 709, 716-17 (Fed.Cir.1998). *See also Karlin*, 177 F.3d at 971; *Mantech Environmental Corp. v. Hudson Environmental Serv., Inc.*, 152 F.3d 1368, 1372-73 (Fed.Cir.1988).

The plaintiff contends that the plain meaning of the actuating member clause is that the actuating member is

"rotatable", that is, capable of rotating, relative to the projecting portions. The element underscores a central feature of the design, to wit, that the projecting portions are not fixed to the actuating member. The plaintiff further contends that there is no dispute but that the defendant's lighter is constructed in a way that includes every element of the 414 patent, including the actuating member element.

Although the defendant's position has shifted in its various briefs, it relies principally on the argument that the disputed clause means that the actuating member must rotate relative to the protruding discs. This argument can be swiftly rejected. Neither the word rotatable nor the claim when read as a whole bears that meaning. Instead, all that is required is that the actuating member be capable of rotating independently of the projecting portions of the lighter, including the projecting outer wheels described in claim 5. *See In re Wise*, 166 F.2d 301, 302 (C.C.P.A.1948) (interpreting "rotatable" to mean "capable of being rotated").

The defendant also offers another interpretation of the disputed clause. It contends that the element requires the actuating member to rotate at a different speed than the two protruding wheels. Again, this requirement cannot be found in the claim language. All that is required is that the actuating member be capable of rotating relative to the protruding portions, including protruding discs. Given the clear meaning of the claim, it is unnecessary for the Court to address the parties' arguments about their experiments and demonstrations.

There is no dispute that the actuating member in the defendant's lighters is capable of rotating relative to the two protruding outer wheels. Consequently, once the claim is interpreted as set forth above, there is no dispute that the defendant's lighter infringes the plaintiff's patent.

The defendant argues that BIC's claim interpretation causes a limitation within the claim to be superfluous and thus must be rejected. Specifically, Thai argues that under BIC's reading of the actuating member clause, two elements of claim 5 would mean the same thing and would render a portion of claim 5 superfluous. It argues that such a result would run contrary to the principles of claim construction, and as a consequence, must invalidate BIC's reading of the disputed clause.

As BIC correctly points out, however, the two elements of claim 5 on which the defendant relies convey two different ideas. The actuating member clause addresses how the actuating member is capable of behaving relative to the projecting portions: it is rotatable relative to them. This clause does not require the two projecting portions to rotate; they could be fixed or they could rotate. Claim 5 adds an element not found in claim 1 and limits the scope of that claim to projecting portions that are discs and that also rotate. As a consequence, claim five describes only the first embodiment of the patent, while claim 1 covers both the first and second embodiments. Since the construction of the claim on which the Court relies gives meaning to every element of claim 5 and renders no element superfluous, Thai's objection on this ground is unfounded.

2. *Validity of* the 414 patent

There is a presumption that an issued patent is valid. 35 U.S.C. s. 282. A challenger to a patent's validity must prove invalidity by clear and convincing evidence, and summary judgment is not appropriate if a trier of fact applying that standard could find for either party. *Oney v. Ratliff*, No. 98-1591, 1999 WL 604640, at *2 (Fed.Cir.1999).

The defendant argues that the 414 patent is inherently anticipated by the 447 patent. "[A]nticipation requires that a single prior art reference disclose every limitation in a patent claim." *General Electric Co. v. Nintendo*

Co., 179 F.3d 1350, 1356 (Fed.Cir.1999). *See also* Applied Medical Resources Corp. v. U.S. Surgical Corp., 147 F.3d 1374, 1379 (Fed.Cir.1998).

An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention.

ATD Corp. v. Lydall, Inc., 159 F.3d 534, 545 (Fed.Cir.1998). In conducting this inquiry, a claim must be given the same interpretation for validity purposes that it is given for infringement purposes. *See* Kegel Co. v. AMF Bowling, Inc., 127 F.3d 1420, 1429 (Fed.Cir.1997).

The disclosure need not be express, however, and may anticipate by inherency where the missing descriptive material is necessarily present in the thing described by the reference and would be appreciated by one of ordinary skill in the art. *Glaxo Inc. v. Novopharm Ltd.*, 52 F.3d 1043, 1047 (Fed.Cir.1995); *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed.Cir.1991). Nonetheless, inherency may not be established by "probabilities" or "possibilities;" instead, the disclosure must show "that the natural result flowing from the operation as taught would result in the performance of the questioned function." *Continental Can*, 948 F.2d at 1269 (internal quotation omitted). Whether a claim feature is inherent is a question of fact and extrinsic evidence may be submitted to show that a claim feature is inherent. *Hazani v. United States Int'l Trade Comm'n*, 126 F.3d 1473, 1477 (Fed.Cir.1997).

As noted, the defendant's invalidity argument rests on the 447 patent. The plaintiff contends that the only admissible evidence concerning the validity of the 414 patent is the conclusory but undisputed testimony from its expert Dr. Abrahamson FN2 that none of 17 prior art patents that he examined, including the 447 patent, describes the manually actuated ignition device in the 414 patent. The plaintiff points out that Thai chose not to depose Dr. Abrahamson regarding this opinion and did not provide its own expert report on this issue.

FN2. To the extent that Thai attacks the expertise of the plaintiff's expert or his failure to discuss in detail the basis for his opinion regarding the 447 reference, those attacks are unpersuasive. The defendant had refused to identify the references on which it was going to rely for its invalidity argument until the plaintiff asked for the Court to intervene. When it finally made its identification, it listed six references, but produced no expert report with its analysis of the relationship between those references and its invalidity argument. Then it declined to examine the plaintiff's expert on this issue. In these circumstances, and given the substantial credentials of the plaintiff's expert, Thai's attack on the plaintiff's expert and his analysis is rejected.

The defendant tendered in its opposition to the motion for summary judgment a declaration from Mr. Aman Chung. Mr. Chung had been identified as a fact witness during the discovery period, but was never identified by the defendant as an expert. *Cf.* Rule 26(a), Fed.R.Civ.P. Moreover, during Mr. Chung's deposition, Thai's counsel announced that Mr. Chung was *not* being tendered as a Rule 30(b)(6) witness on the "factual underpinnings to Thai Merry's affirmative defenses ... including ... alleged invalidity ... of the '414 patent." Given the failure during the discovery period to provide any expert analysis of the manner in which the 447 patent invalidates the 414 patent, the defendant can not now rely on the Chung affidavit to create an issue of fact. Consequently, the defendant has failed to raise an issue of fact to overcome the strong presumption that the 414 patent is valid.FN3

FN3. Even if the Court were to consider Chung's affidavit, it does not raise an issue of fact requiring resolution at trial. The 447 patent does not teach that the discs which may, if desired, be attached to the flint wheel must be attached in a way that would make the flint wheel "rotatable" relative to those discs. While such a construction might be possible, as the defendant admits, the 447 patent teaches that discs rigidly affixed to the flint wheel are more effective and in fact preferred. If the discs were rigidly attached to the wheel, of course, then the wheel would not be "rotatable" relative to the discs.

CONCLUSION

For the reasons stated, plaintiff's motion for summary judgment is granted and defendant's motion is denied.

SO ORDERED:

S.D.N.Y., 1999.

BIC Corp. v. Thai Merry Co.

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