

United States District Court,
D. Delaware.

MOORE NORTH AMERICA, INC., Plaintiff,
Counter-Defendant.

v.

POSER BUSINESS FORMS, INC., Defendant,
Counter-Claimant.

No. CIV.A.99-570-SLR

Sept. 29, 2000.

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N. Richard Powers, Esquire and Patricia Smink Rogowski, Esquire of Connolly, Bove, Lodge & Hutz, Wilmington, Delaware. Counsel for defendant, counter-claimant. Thomas H. Young, Esquire and Stephen D. Bell, Esquire of Dorsey & Whitney, Denver, Colorado. Of counsel for defendant, counter-claimant.

MEMORANDUM OPINION

ROBINSON, Chief J.

I. INTRODUCTION

Plaintiff Moore North America, Inc. filed this patent infringement action on August 24, 1999 against defendant Poser Business Forms, Inc., alleging that defendant infringes U.S. Patent No. 4,928,875 ("the '875 patent") and U.S. Patent No. 5,513,795 ("the '795 patent"). Both plaintiff and defendant are engaged in the business of manufacturing and selling preformed, paper mailers. The '875 patent is directed to the construction of a "one-piece mailer" which is a single sheet of paper that can be printed, folded, sealed, and mailed without the need for a separate envelope. The '798 patent is directed toward adhesive patterns on mailer forms which avoid interference with printer rollers.

Defendant denied infringement of both patents-in-suit and filed a counterclaim for declaratory judgment of noninfringement, invalidity, and unenforceability. (D.I.10) The same parties are currently involved in a pending matter before this court relating to different patents and accused products.

Plaintiff is incorporated under the laws of Delaware and has its principal place of business in New York. (D.I.5, para. 1) Defendant is a Delaware corporation with its principal place of business in Alabama. (D.I.5, para. 2) The court has jurisdiction over this action under 28 U.S.C. s.s. 1331 and 1338. Venue is proper in this judicial district by virtue of 28 U.S.C. s.s. 1391(c) and 1400(b).

Currently before the court is plaintiff's motion for partial summary judgment of infringement of claims 1 and 2 of the '875 patent. (D.I.29) Both parties submitted extensive briefs on these issues, and oral arguments were heard on September 28, 2000. For the following reasons, the court denies plaintiff's motion.

II. BACKGROUND

The '875 patent, entitled "Eccentric 'Z' Fold Mailer With Nesting Capabilities," discloses a form construction which requires printing on one side only and which also accommodates nested inserts. Plaintiff contends that defendant markets a mail form that infringes claims 1 and 2 of the '875 patent.

Claims 1 and 2 of the '875 patent read as follows:

1. A mailer comprising a sheet having front and rear surfaces and having top, bottom and side edges, the top and bottom edges parallel to one another and the side edges parallel to one another,

first and second fold lines located between and parallel to the top and bottom edges,

an address area between the top edge and the first fold line,

a text area between the first fold line and the bottom edge,

the distance between the top edge and the first fold line being substantially less than the distance between the first and second fold lines,

a first strip of adhesive on the front surface adjacent one side edge between the bottom edge and the second fold line,

a second strip of adhesive on the front surface adjacent the other side edge between the bottom edge and the second fold line,

a third strip of adhesive on the front surface of the sheet adjacent the bottom edge,

respective strips of adhesive on the rear surface adjacent to each side edge between the top edge and the first fold line,

the arrangement being such that the sheet may be Z-folded to place the text area on the inside and the address area on the outside of the mailer, and

when activated the strips of adhesive will seal the mailer along the edges.

2. A mailer as in claim 1 and further including a strip of adhesive on the rear surface of the sheet adjacent to the top edge, to further seal the top edge of the mailer when the adhesive is activated.

('875 patent, col. 3, lns. 6-28 to col. 4, lns. 4) (emphasis added). The parties agree that the accused form contains nearly every claim element with the exception of the one in boldface. Defendant argues that the phrase "substantially less" should be given a numerical limit not to exceed one-third, while plaintiff argues

that the term should be defined as a functional limitation.

The accused form is divided into three panels by two transverse fold lines. The bottom two panels are about the same size (approximately 8 1/2" x 5 1/4"). The topmost panel is shorter (as measured from the top edge to the first fold line) and measures 8 1/2" x 3 7/16". At oral argument, neither party disputed these measurements. Neither did the parties dispute whether the other claim elements were found in the accused form.

Claim 1 requires "the distance between the top edge and the first fold line [to be] substantially less than the distance between the first and second fold lines." The parties agree that this means that the height of the topmost panel must be "substantially less" than the height of the middle panel. The issue is whether the topmost panel of the accused form is "substantially less" than the middle panel when it is 34.5% shorter.

II. STANDARD OF REVIEW

A court shall grant summary judgment only if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 n. 10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." *Horowitz v. Federal Kemper Life Assurance Co.*, 57 F.3d 300, 302 n. 1 (3d Cir.1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" *Matsushita*, 475 U.S. at 587 (quoting Fed.R.Civ.P. 56(e)). The court will "view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion." *Pennsylvania Coal Ass'n v. Babbitt*, 63 F.3d 231, 236 (3d Cir.1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

III. CLAIM CONSTRUCTION

A. The Legal Standard

Before addressing the arguments raised in the motion for summary judgment, the court must first construe the disputed claim language. It is the court's "power and obligation to construe as a matter of law the meaning of language used in the patent claim." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995), *aff'd*, 517 U.S. 370 (1996). The principles of claim construction are well established. The exercise begins with the claim language, which defines the scope of the claim. *See York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572 (Fed.Cir.1996). In analyzing claim language, the court must employ "normal rules of syntax," *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114 F.3d 1547, 1553 (Fed.Cir.1997) for "[a] claim must be read in accordance with the precepts of English grammar." *In re Hyatt*, 708 F.2d 712, 714 (Fed.Cir.1983). The court also must ascribe to any technical term used in a claim "the meaning that it would be given by persons experienced in the field of the invention, unless it is

apparent from the patent and the prosecution history that the inventor used the term with a different meaning." *Hoechst Celanese Corp. v. BP Chems., Ltd.*, 78 F.3d 1575, 1578 (Fed.Cir.1996).

In order to give context to the claim language, the court also must review the specification. The Federal Circuit has explained that

the specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication As we have repeatedly stated, "claims must be read in view of the specification, of which they are a part." ... The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. Thus, the specification is always relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of the disputed term.

Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996).

The last source of intrinsic evidence relevant to claim construction is the prosecution history of the patent where it is in evidence. 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." *Id.* at 1583. The prosecution history, therefore, "is often of critical significance in determining the meaning of the claims." *Id.* Extrinsic evidence of claim meaning, on the other hand, is improper in most instances. *See id.* Extrinsic evidence includes expert testimony.

B. Analysis

In support of its position, defendant points to the language in the specification that provides: "As shown in FIG. 1, the distance between the top edge 14 and the fold line 54 is less than one-third that of the distance between the first and second fold lines 54 and 52 which define the test area 28." ('875 patent, col. 2, lns. 53-56) Defendant claims that the '875 patent is otherwise silent as to the meaning of "substantially less" and, using the specification in place of a dictionary, the term "substantially less" means, "at most, one-third or less."

Plaintiff argues that the phrase "substantially less" requires no special, numerical definition. Plaintiff claims that all the references in the prosecution history and specification to "one-third" refer to the preferred embodiment and that limitations from the preferred embodiment may not be read into the claims.

Plaintiff also argues that the reference to one-third in the specification refers to the invention of claim 4, not claim 1. Claim 4 reads as follows:

4. A mailer as in claim 2, wherein the distance between the top edge and the first fold line is about one-third the distance between the first and second fold lines.

(*Id.*, col.4, lns.8-11) Plaintiff argues that the doctrine of claim differentiation prohibits reading into broad claims the limitations of narrow claims. Since claim 4 specifically requires that the topmost panel be one-third the height of the middle panel, plaintiff contend that defendant's definition of "at most, one-third or less" is wrong.

Plaintiff further argues that the term "substantially less" must be read in light of the function of the '875

patent's top panel. Plaintiff points to two claimed benefits of the '875 patent. One is to accept nested inserts. The other is to increase surface area for confidential text. The '875 patent invention achieves those benefits, plaintiff argues, by having a top panel that is smaller in height than the other two panels. Plaintiff contends that even a 10% difference between the size of the top and middle panels is "substantial" because even that minimal reduction permits the use of larger nested inserts or an increase in the amount of confidential text that can be printed.

The Federal Circuit has recognized the validity of such "functional" definitions in other contexts. For example, in *Bausch & Lomb, Inc. v. Barnes-Hind / Hydrocurve, Inc.*, 796 F.2d 443, 450 (Fed.Cir.1986), the court determined (with respect to a patent related to contact lenses) that "smooth means smooth enough to serve the inventor's purposes." *See also* *Wright Med. Tech., Inc. v. Osteonics Corp.*, 122 F.3d 1440, 1443 (Fed.Cir.1997); *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 858 (Fed.Cir.1988)(defining "slightly greater" spacing in terms of its purpose); *Reed Corp. v. Portec, Inc.*, 970 F.2d 816, 823 (Fed.Cir.1992); *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1303 (Fed.Cir.1997)("conductive" means sufficiently conductive to perform its function).

Based on basic principles of claim construction, the court declines to impose the numerical limitation related to the preferred embodiment and dependent claim 4 onto the broad claim language of claim 1. The court is not entirely comfortable, however, with a functional definition, as it does not seem to constitute a claim limitation at all; to wit, "substantially less" means "to a large enough degree to permit the acceptance of nested inserts and an increase in the amount of confidential text that can be printed."

Even if the court were to accept plaintiff's concept, it concludes that the issue of whether defendant's accused topmost panel is "substantially less" than its middle panel is a question of fact for the jury.

IV. CONCLUSION

Based on the record presented, therefore, plaintiff's motion for summary judgment of literal infringement of claims 1 and 2 of the '875 patent is denied. FN1

FN1. As is its practice, the court will render its final claim construction at the time of trial.

D.Del.,2000.

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