

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

**SAEILO, INC., D/B/A Kahr Arms,**  
Plaintiff.

v.

**COLT'S MANUFACTURING COMPANY, INC,**  
Defendant.

**COLT'S MANUFACTURING COMPANY, INC,**  
Counterclaim-Plaintiff.

v.

**SAEILO, INC., D/B/A Kahr Arms,**  
Counterclaim-Defendant.

No. 98CIV.3548(LMM)

**Nov. 29, 2000.**

Stephen W. Feingold, Whitman Breed Abbott & Morgan, New York, Thomas H. Shunk, Baker & Hostetler, LLP, Cleveland, Ohio, for Plaintiff/Counterclaim-Defendant.

Glenn F. Ostrager, Joshua S. Broitman, Ostrager Chong Flaherty & Onofrio, P.C., New York, for Defendant/Counterclaim-Plaintiff.

## **MEMORANDUM & ORDER**

**DUFFY, District J.**

This patent infringement suit involves two firearm manufacturers who each produce double action, semi-automatic, low profile handguns, Saeilo, Inc., d/b/a Kahr Arms ("Saeilo") and Colt's Manufacturing Company, Inc. ("Colt"). At issue is Patent No. 5,415,075, (" '075 Patent") a patent on a staggered camming mechanism for a firearm. This patent was assigned to Saeilo in 1997. Saeilo has moved for summary judgment of infringement. Colt has cross-moved for summary judgment of non-infringement. For the following reasons, Saeilo's motion is denied and Colt's motion is granted.

### **Background**

A brief description of semi-automatic handguns is useful to fully understand the nature of this dispute. In general, semi-automatic handguns use the energy of exploding ammunition to eject the spent cartridge, load a new cartridge, and reposition the components of the handgun for the next firing. When the ammunition is exploded, the barrel must be tightly sealed at all sides except the barrel's muzzle. The automatic reloading of the barrel, however, requires that the ammunition be able to enter the barrel through some entrance other than the muzzle. Therefore, the barrel must be "locked" tightly against the firing mechanism during

ammunition explosion, and then "unlocked" from the mechanism so that new ammunition can enter the barrel.

Immediately after the ammunition explodes, the barrel, locked to a slide by way of a ridge on the barrel and a notch on the slide, begins moving backward. As the barrel moves, an enlarged part of the back end of the barrel, called the lug, encounters the camming pin. The camming pin works with a slot in the barrel's lug to stop the barrel's backward movement and also to tilt the muzzle end of the barrel slightly upwards. The portion of the barrel that interacts with the camming pin is referred to as the barrel's "cam lug." At this stage, the barrel is "unlocked." This permits the slide to continue moving backward without the barrel, separating the back end of the barrel from the slide and creating an opening in the rear of the barrel for introduction of the next round of ammunition. A recoil spring which is compressed during the backward motion of the slide returns the slide to its original position after the new ammunition has been moved into place.

Most breech-locking guns include a feature like the barrel cam lug. This feature makes designing a low-profile FN1 handgun difficult, as the barrel lug can interfere with the trigger if the barrel is too near the trigger. When pulled, the trigger pivots on the trigger pin, thereby pulling the trigger bar. As the barrel moves backwards and slightly downwards during operation, its movement may be obstructed by the trigger.

FN1. The term "low-profile" denotes a handgun that can be easily concealed.

The '075 Patent provides a particular design for the barrel cam lug that allows a compact fitting of all the components together inside the receiver of the handgun. This design permits the trigger and trigger bar to slide past the lug during operation, by having the axis of the lug off-set inside the receiver frame, thereby creating a space for the trigger bar to move. This allows for a handgun with an extremely low profile.

The '075 Patent was published on May 16, 1995. According to the inventor, this patent was intended to "provide a compact low profile handgun, particularly in a semi-automatic, breech-locking barrel gun design." ('075 Patent, col. 1, 11. 51-54.) With the instruction of this patent, Saeilo has manufactured and sold a line of nine millimeter and .40 caliber pistols (respectively the "K-9" and "K-40" pistols).

In late 1996, Colt began making and selling the Colt Pony. The Pony Pocketlite was introduced soon thereafter, and in early 1999 Colt began making and selling the Pony Pocket Nine. As the mechanism in question is the same in each of these pistols (the "Pony models"), I will consider them together for purposes of this memorandum and order. Like Saeilo's "K-9" and "K-40" pistols, which are taught by the '075 Patent, the Pony models are low-profile handguns in a semi-automatic, breech-locking barrel gun design. The barrel cam in the Pony models has a notch cut into its lower rear end to allow for the free movement of the barrel and trigger.

In 1998 Saeilo brought this suit, alleging patent infringement by Colt as evidenced by the design of the Pony models. Specifically, Saeilo asserts that the Colt-designed barrel cam lug, which provides enough room to allow free movement of the trigger and the cam lug, infringes the '075 Patent. Colt answered the complaint and filed a counterclaim against Saeilo. On February 18, 2000, by way of a Joint Stipulation and Order, Judge Lawrence M. McKenna, United States District Court for the Southern District of New York, entered an order dismissing claims two and three of the Colt counterclaim. Both parties have filed motions for summary judgment pursuant to Fed.R.Civ.P. 56. After a review of the papers submitted, I find that the

central question is one of claim construction. Claim 1 of the '075 Patent reads:

A firearm having an elongate upward open receiver including opposing laterally spaced apart sidewalls, a breech locking barrel having a bore extending axially therethrough and including a muzzle end and a breech end, said barrel having a depending cam lug spaced in an axial direction from said muzzle end and extending downwardly within said receiver and between said sidewalls, said cam lug being laterally offset relative to the axis of said bore and defining a cam surface, a barrel camming pin mounted on said receiver and having a laterally extending camming pin axis, said camming pin engaging said cam surface to support said barrel for forward and rearward movement longitudinally of said receiver and for pivotal movement relative to said receiver between locked and unlocked positions, an operating slide for moving said barrel between said locked and unlocked positions and for releasably securing said barrel in said locked position, and a firing mechanism including an operating trigger mounted in said receiver below said barrel camming pin and disposed below said cam lug when said barrel is in its locked position, a portion of said trigger being disposed generally adjacent said laterally offset cam lug and between said cam lug and an associated one of said sidewalls when said barrel is in its unlocked position.

('075 Patent, col. 3, 11. 31-55.) In particular, a determination of the term "laterally offset relative to the axis of said bore" in Claim 1 will be dispositive.

## **Legal Standard**

Summary judgment should be granted when "there is no genuine issue as to any material fact." Fed.R.Civ.P. 56(c). The court must determine whether "the evidence is such that a reasonable jury could return a verdict for the non-moving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). In making this determination, all facts are to be viewed, and all reasonable inferences drawn, in favor of the nonmoving party. *See id.*

## **Discussion**

Patent infringement claims require a two-step analysis. "First, the claim must be properly construed to determine its scope and meaning." *Johns Hopkins Univ. v. Cellpro, Inc.*, 152 F.3d 1342, 1353 (Fed.Cir.1998). This first step is a question of law. *See Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388 (1996). "Second, the claim as properly construed must be compared to the accused device or process." *Johns Hopkins*, 152 F.3d at 1353. This second determination is a question of fact. *See Id.*

In the context of summary judgment, the burden of proof lies with the patent owner, who must show by a preponderance of the evidence that the accused device infringes the patent claims. *See CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146, 1161 (Fed.Cir.1997), *cert denied*, 118 S.Ct. 1039 (1998). To satisfy this burden, Saeilo must show that Colt's handguns contained every claim element exactly or by a substantial equivalent. *See S. Bravo Sys. Inc. v. Containment Techs. Corp.*, 96 F.3d 1372, 1376 (Fed.Cir.1996).

### ***A. Claim Construction***

As explained by the Federal Circuit, both intrinsic and extrinsic evidence may be properly used for guidance in claim construction. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (1996). Intrinsic evidence consists of the patent itself: the claims, the specification, and the prosecution history, if in evidence. Extrinsic evidence includes expert testimony, inventor testimony, dictionaries, treatises, and prior art not cited in the prosecution history. *See Zodiac Pool Care, Inc. v. Hoffinger Indus., Inc.*, 206 F.3d 1408,

1414 (Fed.Cir.2000). It is well-settled that the court should look first to the intrinsic evidence of record. *See Vitronics*, 90 F.3d at 1582.

In their papers the parties focus on the term "laterally offset relative to the axis of said bore." Saeilo's proposed statement of the claim interpretation reads:

The term "laterally offset relative to the axis of said bore" means "having a cross-section in the region where the trigger will pass by the lug the central axis of which is off-set laterally from the central axis of the bore."

From this definition I am supposed to understand that the claim is met so long as the lug is offset in the area where it passes by the trigger. This definition, however, is not evident from an examination of the intrinsic evidence.

An examination of the claim itself requires a review of the precise words chosen by the patentee. Although the patentee may choose to be his own lexicographer, words in a claim are usually given their ordinary meaning. *See Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1578 (Fed.Cir.1996). In this case, the patentee has not provided special definitions for any of the words in question. Where a technical term is used, such term "is interpreted as having the meaning that it would be given by persons experienced in the field of the invention." *Id.*

"Laterally offset" refers to the gun's "lug," and is defined in relation to the central axis of the barrel's bore. These words do not indicate the meaning sought by Saeilo, to wit: merely a portion of the lug may be offset. Rather, their plain meaning indicates that the lug is laterally offset for the entire length of the bore. As the axis of the barrel's bore naturally runs the entire length of the bore, and the lateral offset is defined in relation to this axis, without further specificity, it follows that the lateral offset is intended to run the full length of the lug. As correctly pointed out by Colt, if the inventor intended this language to describe an offset in a portion of the lug rather than extending the entire lug length, the claims should have been written more broadly. *See Sage Prods., Inc. v. Devon Indus., Inc.*, 126 F.3d 1420, 1425 (Fed.Cir.1997)("[A]s between the patentee who had a clear opportunity to negotiate broader claims but did not do so, and the public at large, it is the patentee who must bear the cost of its failure to seek protection for this foreseeable alteration of its claimed structure.").

Although my review of the claim alone would be determinative in this instance, the specification "is the single best guide to the meaning of a dispatched term." *Vitronics*, 90 F.3d at 1583. Moreover, the Federal Circuit has held that questions of claim construction require an examination of the specification. *See id.* at 1582 (holding that "it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning"). The specification functions so well as a guide because it is meant to describe the invention in less technical terms. *See Markman*, 52 F.3d at 979 ("The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention.").

In this instance, the specification includes detailed drawings of a handgun employing the '075 Patent. The specification further describes the preferred embodiment of the '075 Patent by way of reference to these drawings. For instance, the specification reads, "the barrel cam lug 28 is staggered or laterally offset relative to the axis of the barrel bore 18 as shown in FIG. 2." This drawing clearly depicts a recess running the full length of the lug. FN2 Saeilo has requested that I consider the words of the specification rather than solely the referenced drawings. In particular, Saeilo points to the description of the lateral offset:

FN2. Figure 2:

The lateral offset of the barrel cam lug 28 provides a space or notch 37 between an associated one of the inner surfaces 29 and an opposing face 39 on the barrel cam lug 28.

Despite inclusion of the word "notch," the specification does not convey that Claim 1 of the '075 Patent provides for the barrel cam lug to be laterally offset for any length less than the full length of the lug. For Saeilo to succeed in this patent infringement action, Claim 1 must be construed to include *any* offset which provides sufficient space for the trigger and cam lug to pass unobstructed. I do not read the plain language of the claim in this manner, however, even in view of the specification.

Saeilo is correct when it points out that not everything in the specification is required to be read into the claims.FN3 *See SRI Int'l v. Matsushita Elec. Corp.*, 775 F.2d 1107, 1121 (Fed.Cir.1985)(stating that purpose of claims is defeated if everything in specification is required to be read into claims); *Markman*, 52 F.3d at 979 (stating that "claims must be read in view of specification, of which they are a part"). Nonetheless, nothing in the specification suggests that the inventor has used terms in the claim in a manner inconsistent with their ordinary meaning. In fact, my review of the specification confirms my determination under the exact words of the claim.

FN3. Although Saeilo is technically correct, the manner in which it addressed this issue was disingenuous. On page five of Saeilo's reply brief, in an attempt to convince me that Claim 1 should not be limited to the specific embodiment shown in the drawings, Saeilo inaccurately quoted the Federal Circuit's decision in *Markman*: "The specification does not limit the right to exclude." The actual language of *Markman* reads: "*The written description part of the specification does not delimit the right to exclude.*" 52 F.3d at 980 (emphasis added). Such omissions ought to be indicated.

The prosecution history of the patent, to the degree that it has been entered into evidence, reveals that the claims filed with the original patent application did not include "laterally offset" language.FN4 The original claim was rejected by the Patent Examiner under 35 U.S.C. s. 102(b) as structurally readable on prior art.FN5 The revised claim, as it now appears in the patent, was accepted without further comment. Saeilo asserts that Claim 1 was not amended so as to avoid confusion over prior art. Rather, it alleges that the inventor successfully argued this point with the Examiner. According to Saeilo, the fact that the Examiner refrained from further comment on the subject of prior art indicates the success of Saeilo's argument. I do not find this persuasive. What is clear to me is that the revised Claim 1 does not include any of the language that the Examiner found objectionable. In his original application, the inventor used the term "notch." That term does not appear in the revised Claim 1, and instead is replaced by the troublesome term "laterally offset." As there is no evidence of the Examiner's acceptance of the term "laterally offset" to mean "notch," I am unwilling to import that meaning at this time.

FN4. The original Claim 1 of the application reads:

In a semi-automatic handgun, with a breech locking barrel, a trigger and a trigger bar, a structure which eliminates potential interference between the trigger bar and the barrel and provides a compact handgun, comprising camming lugs for providing rotation of said barrel, said lugs defining a notch, said trigger bar being attached to one side of said trigger, trigger bar and barrel to be positioned in close proximity to each other.

FN5. In particular, this prior art is (1) Patent No. 3,756,120 and the limited-circulation Colt pistol based on that design ("Roy Patent"), and (2) Patent No. 1,618,510 and the Browning pistol based on that design ("Browning Patent").

The sum of intrinsic evidence instructs that the claim term in question, "laterally offset relative to the axis of said bore," be read as describing a lateral offset running the full length of the lug. The "axis of said bore" runs the full length of the lug, and it is this element to which the offset is "relative." Any attempt now to expand the claim to include partial offsets, or notches, runs counter to the purpose of the patent review process. *See Vitronics*, 90 F.3d at 1583 ("[C]ompetitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention."); *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed.Cir.1995)("A patentee may not proffer an interpretation for the purposes of litigation that would alter the indisputable public record consisting of the claims, the specification and the prosecution history, and treat the claims as a 'nose of wax.'" (quoting *Senmed, Inc. v. Richard-Allan Med. Indus., Inc.*, 888 F.2d 815, 819 n. 8 (Fed.Cir.1989))).

In this case, as in most, an analysis of the intrinsic evidence resolves the ambiguity of the disputed claim term. It is therefore unnecessary, and even improper, to review extrinsic evidence. *See Vitronics*, 90 F.3d at 1583 (stating that "the claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely.").

## ***B. Infringement***

### ***1. Literal***

Having construed the claim to require an offset running the full length of the cam, it is clear that no question of fact remains with respect to literal infringement. Literal infringement requires that the accused device contain every element of the patented device exactly. *See SmithKline Diagnostics v. Helena Laboratories Corp.*, 859 F.2d 878, 889 (Fed.Cir.1988). The Pony models do not contain an offset cam running the full length of the lug. The design of the Pony models has improved upon that of the '075 Patent, and contains only a notch which allows the trigger to pass unobstructed. As a matter of law, the Pony models do not literally infringe the '075 Patent. *See Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1199 (Fed.Cir.1994)("If an express claim limitation is absent from the accused product, there can be no literal infringement as a matter of law."). I therefore grant summary judgment of no literal infringement in favor of Colt. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986)(stating that the plain language of Fed.R.Civ.P. 56(c) mandates the entry of summary judgment against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial).

### ***2. Doctrine of Equivalents***

Even where a device does not literally infringe a claim, that device may infringe under the doctrine of equivalents, which requires that every element in the claim is literally or equivalently present in the accused device. *See Sage*, 126 F.3d at 1423. "Although equivalence is a factual matter normally reserved for a fact finder," summary judgment is appropriate where no reasonable fact finder could find equivalence. *Id.*

The Supreme Court reaffirmed the existence of the doctrine of equivalents, but noted its "concern ... that the doctrine of equivalents ... has taken on a life of its own, unbounded by the patent claims." *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 28-29 (1997). In response to this concern, the courts have developed limitations, formulations, and tests regarding the application of the doctrine of equivalents, resulting in two overarching concepts. *See K-2 Corporation v. Salomon S.A.*, 191 F.3d 1356, 1366 (Fed.Cir.1999). First, the doctrine is limited in the following ways: it cannot allow a patent to encompass subject matter existing in the prior art; it cannot allow coverage of obvious or trivial variations of the prior art; and it cannot be used to vitiate an element from the claim in its entirety. Each of these limitations is a question of law. *See Warner-Jenkinson*, 520 U.S. at 39 n. 8. The second overarching concept is that the doctrine will not allow a patentee to recover subject matter surrendered during prosecution of the patent. *See K-2*, 191 F.3d at 1367. This concept, recognized as prosecution history estoppel, is also a question of law. *See id.* Where these limitations are inapplicable, the doctrine prevents "an infringer from stealing the benefit of an invention." *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 608 (1950)(quoting *Royal Typewriter Co. v. Remington Rand*, 168 F.2d 691, 692 (2d Cir.1948)(Hand, J.)).

Saeilo argues that equivalence is evident in the Pony models, as the Pony lug "performs substantially the same overall function or work, in substantially the same way, to obtain substantially the same overall result" as the '075 Patent. *Wilson Sporting Goods Co. v. David Geoffrey & Assocs.*, 904 F.2d 677, 683 (Fed.Cir.1990) (citations omitted). Saeilo thus relies on the so-called "triple identity" test for determining equivalence. FN6

FN6. The "triple identity" test focuses on "the function served by a particular claim element, the way that element serves that function, and the result thus obtained by that element ...." *Warner-Jenkinson*, 520 U.S. at 39. An alternative approach for determining equivalence is the "insubstantial differences" test. *Id.* Under this test, "[a] claim element is equivalently present in an accused device if only 'insubstantial differences' distinguish the missing claim element from the corresponding aspects of the accused device." *Sage*, 126 F.3d at 1423. In *Warner-Jenkinson* the Court stated that the particular linguistic framework used is less important than a focus on individual elements and special vigilance against allowing the doctrine of equivalence to become overbearing. *See Warner-Jenkinson*, 520 U.S. at 40. According to the Court, the proper approach was "[a]n analysis of the role played by each element in the context of the specific patent claim" and the Federal Circuit was left with the task of refining the formulation of this test for equivalence in the course of case-by-case determinations. *Id.*

Claim 1, as herein construed, requires the barrel cam lug to be laterally offset for the entire length of the lug. To find that the notch provided in the Pony models is equivalent to the lateral offset in the '075 Patent is to read an express limitation out of the claim. This result prohibits application of the doctrine of equivalents as a matter of law. As the Supreme Court has made quite clear, "[i]t is important to ensure that the application of the doctrine ... is not allowed such broad play as to effectively eliminate that element in its entirety." *Warner-Jenkinson*, 520 U.S. at 29. *See also Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1160 (Fed.Cir.1998)("If a theory of equivalence would vitiate a claim limitation ... there can be no infringement under the doctrine of equivalents as a matter of law.").

Colt also argues that Saeilo's application of the doctrine of equivalents is precluded by prosecution history estoppel. Under prosecution history estoppel, "a patentee is unable to reclaim through the doctrine of equivalents what was surrendered or disclaimed in order to obtain the patent." *Loral Fairchild Corp. v. Sony*

Corp., 181 F.3d 1313, 1322 (Fed.Cir.1999). As discussed above, the '075 Patent's original claim was rejected by the Patent Examiner under 35 U.S.C. s. 102 as structurally readable on the Roy Patent. Saeilo asserts that the primary problem with the claim was not one of readability on prior art, but rather one of vagueness, as provided by 35 U.S.C. s. 112. The Federal Circuit has made clear, however, that "[a]n applicant may not avoid the conclusion that an amendment was made in response to prior art by discussing the amendment under the rubric of a clarification due to a s. 112 indefiniteness rejection." Loral, 181 F.3d at 1326.

I am persuaded that the amendments were made for purposes related to patentability in response to prior art, and not solely to correct problems of vagueness. Therefore, prosecution history estoppel precludes Saeilo from reclaiming the subject matter surrendered by that amendment. In this instance, the subject matter is the description of a "notch" defined by the camming lugs. Saeilo cannot therefore assert the doctrine of equivalents against the accused Pony Models.

## **Conclusion**

For the above reasons, Saeilo's motion for summary judgment of infringement is denied, and Colt's motion for summary judgment of non-infringement is granted. The Clerk of Court is hereby ordered to enter judgment and close this case.

So ordered.

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