United States District Court,
C.D. California.

In re TURN-KEY-TECH MATTERS and All Consolidated Actions.

This Document Relates to: All Action,
This Document Relates to: All Actions.

No. CV 01-4158 LGB (MCx)

Jan. 18, 2002.

Boris Zelkind, Knobbe Martens Olson & Bear, San Diego, CA, David R. Fairbairn, Paul P. Kempf, Kinney & Lange, Mineapolis, MN, for Plaintiffs.

Olivier A. Taillieu, Zuber and Taillieu, Beverly Hills, CA, for Defendant.

William J. O'Brien, Alschuler Grossman Stein and Kahan, Santa Monica, CA, for Defendant/Counter Claimant.

David R. Melton, Michael O. Warnecke, Mayer Brown & Platt, Douglas M. Eveleigh, Steven G. Steger, Mayer Brown Rowe & Maw, Chicago, IL, William J. Robinson, Foley and Lardner LLP, Gerald Joseph Miller, Theodore Oringher Miller & Richman, Los Angeles, CA, for Defendants/Counter Defendants.

Mark C. Holscher, Kirkland and Ellis, Mark Alan Samuels, O'Melveny & Myers, Mark C. Scarsi, Milbank Tweed Hadley and McCloy LLP, Los Angeles, CA, Boris Zelkind, Knobbe Martens Olson & Bear, Michael J. Kaler, Turn-Key-Tech, San Diego, CA, for Counter Claimants.

ORDER CONSTRUING CLAIMS OF U.S. PATENT 4,422,998 (" 'THE 998 PATENT")

LOURDES G. BAIRD**, District Judge.**

I. INTRODUCTION

In these consolidated cases, Turn-Key-Tech ("Turn-Key") accuses National Film Laboratories, Inc. d.b.a. Crest National Optical Media ("Crest"), Concord Disc Manufacturing Corporation ("Concord"), Music City Optical Media Inc., ("MC"), and Hollywood Records of patent infringement. Specifically, it alleges that these Defendants have been practicing a process claimed in U.S. Patent 4,422,998 (" 'the 998 patent") which was issued to Jens Ole Sorensen on December 27, 1983. FN1 Turn-Key brings the instant actions as the exclusive licensee of the ' 998 patent which expires on April 22, 2002. This matter is before the Court for purposes of the interpretation of disputed claims of the ' 998 patent.

FN1. Turn-Key also accuses Defendants of contributory infringement and have also named certain Doe

Defendants in their complaints. Defendants, in turn, have filed counter-claims for declaratory judgment of non-infringement and invalidity and unenforceability of the '998 patent. Krauss-Maffei Corporation ("KM") has also brought an action against Turn-Key for declaratory judgment of non-infringement, invalidity and unenforceability of the '998 patent, common law tortious interference with existing business relationships, common law trade disparagement and injurious falsehood, and unfair competition. These claims stem from KM's licensing of certain patents relating to an optical disc manufacturing process and its sale of manufacturing systems utilizing the licensed technology because Turn-Key has alleged that the manufacture of optical discs using KM's equipment infringes the '998 patent. Turn-Key answered KM's complaint and brought counterclaims for contributory infringement and active inducement of infringement vis-a-vis KM.

II. THE '998 PATENT

For purposes of the Court's claim instruction endeavor here, it suffices to note that Turn-Key accuses Defendants of violating the '998 patent. The ' 998 patent entitled "Controlled Ejection Method for Injection Molding" was issued to Sorensen on December 27, 1983 and relates to the field of injection molding plastics. Injection molding is a manufacturing process used to make plastic products by injecting fluid plastic into a mold cavity and allowing the plastic to solidify into the general shape of the mold cavity to produce the plastic part. Once the product is removed from the mold, the process continuously repeats.

Sorensen stated that the method protected by the '998 patent constituted an improvement from prior art in terms of the orientation, speed of injection, and the sterility involved. '998 patent at Col. 1. ll. 27-30. The method, moreover, could be performed basically without the need of auxiliary moving parts or vulnerable stationary elements such as pins and blades. Id. at ll. 30-34. Claims 1, 2, 5, and 6 of the '998 patent are specifically at issue. Claim 1 is the only independent claim in the '998 patent.

III. CLAIM INTERPRETATION LAW

In Markman v. Westview Instruments, Inc., 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), the Supreme Court held that the interpretation of a patent claim-the portion of the patent document that defines the scope of the patentee's rights-is a matter of law exclusively within the scope of the court and is not a factual question for the jury Id. at 372. The *Markman* decision suggested that a trial court could consider various types of evidence when interpreting a patent, including expert testimony. *See id*. at 388-90. Shortly after the Supreme Court handed down *Markman,* the Federal Circuit, in Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed.Cir.1996), expanded on the Court's dicta concerning evidence available to a trial court in interpreting patent claims. *See* id. at 1581-83. The Federal Circuit held that if intrinsic evidence can, by itself, resolve ambiguity in a patent term, then a court may not rely on extrinsic evidence, such as expert testimony, to construe the term. *See* id. at 1583. A trial court may only use extrinsic evidence when intrinsic evidence fails to illuminate the meaning of the disputed claim. *Id*. Moreover, extrinsic evidence cannot broaden the reach of a claim or contradict explicit language. *Id*. The policy rationale supporting this evidentiary limitation is that prospective patentees must have access to public records concerning the patent to "design around" a prior art. *Id*. If expert testimony or other extrinsic evidence were permitted to alter the record, then this public benefit would be frustrated. *Id*. Thus, a court can only examine extrinsic evidence if the evidence does not contradict the claim language, the specification, or the prosecution history but instead supplements it. *Id*. at 1584-85.

The Federal Circuit detailed a hierarchy of specific types of evidence that a court may consider. Thus, when interpreting a patent, a trial court must first look at the language of the claim itself. *See id*. at 1582. Courts

should typically construe terms by their common, customary meaning, but a patentee is allowed to define her own terms in the specification section of the patent. *See id*. Therefore, courts must always review the specification, which, when setting forth an embodiment of the invention, frequently provides explicit definitions of the claim terms. *See id*. The language in the specification is dispositive, and "it is the single best guide to the meaning of the disputed term." *Id*. However, a patent's claims are not limited to the specification's best mode, preferred embodiment, specific objects, or illustrative examples, and it is erroneous to read limitations from the specification into the claims. *See* Laitram Corp. v. Cambridge Wire Cloth Co., 863 F.2d 855, 865 (Fed.Cir.1988) ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations."); Rolls-Royce Ltd. v. GTE Valeron Corp., 800 F.2d 1101, 1108 (Fed.Cir.1987) ("Reference to an object does not constitute in itself a limitation in the claims."). In addition, a court may consider the prosecution history of the patent as evidence of meaning. *Id*. This history contains the complete record of all the filings and examinations before the Patent and Trademark Office, including representations made by the applicant regarding the significance of claims and terms. *Id*. The history also limits the interpretation of terms by recording the exclusion of any term definition disclaimed during the prosecution. *Id*.

IV. CLAIM INTERPRETATION AND ANALYSIS

The parties have agreed to construe the language contained in the preamble of Claim 1, "[a] method of cyclic injection molding of plastic," as requiring "a repeating cycle involving the introduction of plastic under pressure into a mold to form plastic objects." Corrected Joint Claim Construction Statement ("Joint Statement") at 2. In addition, they also have agreed to construe language contained in Claim 3, "[a] method according to claim 1, wherein step (a) comprises the step of: (g) Combining the two mold parts in a horizontal direction," as requiring that "one or both of the two mold parts moves towards the other in a direction parallel to the plane of the earth's surface pursuant to the parties' respective constructions of step (a) of Claim 1." *Id*. at 2-3. The remaining language of Claims 1, 2, 5, and 6 in the '998 patent is disputed.

A. Claim 1 of '998 Patent

1. The Preamble

The preamble of Claim 1 of the '998 patent states that the invention comprises "[a] method of cyclic injection molding of plastic where the mold comprises two parts which are separated by a parting surface and at least one cavity situated internally to the boundaries of the parting surface, and wherein each production cycle comprises the steps of ...." The parties disagree on the interpretation of the following three terms/phrases contained in the preamble:

a. "Two mold parts"

Turn-Key argues that this limitation must be construed to require that the two mold parts are a first mold part and a second mold part including all of their respective components. It asserts that these components can include mold plates, cavity inserts, alignment components, screws, heating and cooling assemblies, ejector assemblies, pins, blades, guide assemblies, etc. Pl's Opening Brief at 5. Conversely, Defendants argue that the two mold parts referred to are "not just any parts, but the two mating halves of an injection mold" and that though the mold "may have other components ... these should not be confused with the two mold halves to which this claim term is intended to refer." Crest's Responsive Brief at 11. The parties thus appear to agree that the phrase "mold comprises two parts" signifies the mating halves of a mold and that the mold parts themselves may contain individual components. Crest's Responsive Brief at 11; Pl's Opening

Brief at 5. The dispute is whether the phrase refers to the mold halves as wholes or whether it includes specific auxiliary parts.

The Court agrees with Defendants that though the mold halves can possess component parts, the "mold comprises two parts" language should be interpreted as "referring to the two mating halves of the mold as wholes, and not to their individual components." Crest's Responsive Brief at 11. This interpretation comports with the ordinary and customary meaning of the phrase which solely refers to "two parts" and the specification does not show that Sorenson, as patentee, intended to define the phrase in his own terms rather than by the terms' common, customary meaning. *See* Vitronics, 90 F.3d at 1584-85.

b. "Parting surface"

Turn-Key argues that this limitation must be construed as referring to the surfaces of the two mold parts between the two mold parts that either touch or lie adjacent to the other mold part before the mold parts separate, excluding the product molding cavity(ies) that is situated internally to the parting surfaces. In so arguing, Turn-Key specifically objects to the "additional limitations" of Defendants' interpretation. Pl's Opening Brief at 7-8. Defendants argue that a parting surface consists of those faces of each of the two mold parts that touch each other when the mold is closed and that oppose each other when the mold is open. They, however, note that portions of these faces may be slightly relieved so that they do not touch each other when the mold is closed but face each other in close proximity and with no intervening structure. Crest's Responsive Brief at 11-13; KM, MC & Concord's Brief at 5. The dispute over the interpretation of "parting surface" thus centers around (1) whether the faces of the mold parts must touch each other, (2) whether the faces must oppose each other when the mold is "open," and whether (3) there can be no intervening structure. FN2

FN2. Here, Defendants utilize the term "open" to refer to the position of the mold parts during the "separating" process described in Element (b). *See* IV.A.3.

The Court construes "parting surface" to signify the faces of the two mold parts that either touch or lie adjacent when the mold parts are brought together in the "combining" process described in Element (a). *See supra* at Section IV.A.2. In applying the ordinary and customary meaning of "combining" as the act of bringing into or joining in a close union or whole, the Court finds that not all of the faces of the two mold parts are required to actually touch each other; they need to be only in some proximity to each other. Random House Webster's College Dictionary at 261. Having said that, however, the Court notes that there must be at least some point at which the faces of the two mold parts touch other, thus preventing the fluid from leaking out of the cavity before it is molded into the plastic product. The Court declines to construe the mold parts as "opposing" each other when they are being kept apart in the "separating" process described in the first portion of Element (d) on the grounds that it adds an extra limitation not present in the claim language. *See supra* Section IV.A.5.a. FN3 In addition, the Court further declines to construe this claim as requiring an absence of an intervening structure on the grounds that it adds an extra limitation not present in the claim language.

FN3. The Court agrees with Turn-Key that with a "clam" model mold, the parting surfaces would not "oppose" each other like paired opposites upon opening their book-like hinges. Pl's Reply Brief at 19.

c. "Cavity"

Turn-Key argues that the limitation "cavity situated internally to the boundaries of the parting surface" must be construed as referring to "at least one product molding cavity that is surrounded by the parting surface." Pl's Opening Brief at 8. Defendants, conversely, assert that the "cavity" is a space that is surrounded by a parting surface in all directions (i.e., all directions in the plane of that parting surface). In so arguing, they specifically object to Turn-Key's inclusion of the cavity walls of the mold which form the cavity into the definition of "cavity." KM, MC & Concord's Brief at 5; Pl's Opening Brief at 8. Turn-Key, by contrast, objects to Defendants' description of the cavity as being surrounded in the "plane of that parting surface" on the grounds that this wording leads to the "erroneous conclusion that the parting surface is only in one plane." Pl's Opening Brief at 8. The Court finds that Defendants' briefs do not make any argument about the cavity being surrounded in the "plane of that parting surface" and as such, considers this interpretation to be waived. Consequently, the only dispute concerns whether the cavity walls should be included in the definition of the term "cavity."

The Court construes "cavity" according to its ordinary and customary meaning, thus signifying a hollow space, Random House Webster's College Dictionary at 209, and specifically construes "cavity" within the context of the '998 patent as a hollow space that is surrounded by a parting surface. In keeping with this interpretation, the Court declines to construe the "cavity" to include the cavity walls which actually form the hollow space. Nothing in the specification suggests that Sorenson, as patentee, intended to define "cavity" in his own terms rather than by its ordinary, customary meaning.

2. Element (a)

Element (a) states that the invention requires "[c]ombining the two mold parts by moving, in a predetermined direction, the mold parts in relation to each other." Turn-Key argues that this limitation must be construed to require "combining the two mold parts by moving one or both of the mold parts in a direction toward the other." Pl's Opening Brief at 8-9. In so arguing, Turn-Key states that "combining" has no special or uncommon meaning and should not be substituted with language that may change the meaning and scope of Claim 1. Id. Defendants argue that the limitation should be construed as "[c]losing the mold by moving the two mold parts" and that "[i]n closing the mold, one or more of the two mold parts is moved towards the other mold part along a straight path running between the two parts." Joint Statement at 25. The dispute over this portion of the claim language thus centers around whether "[c]losing" should be substituted for "[c]ombining" and whether the movement of the mold parts must be along a straight path.

The Court finds "combining," as previously mentioned, to be utilized in its ordinary and customary sense here, thus signifying the act of bringing into or joining in a close union or whole, and that it would therefore be inappropriate to substitute other terms to further define it. In particular, the Court declines to substitute "closing" because it represents an extra limitation that is not present in the claim's language. FN4 The Court also declines to adopt the construction that the mold parts must move along a straight path on the grounds that it adds an extra limitation not present in the patent's language. For instance, in a "clam" model mold, the two mold parts would not move in a straight path but rather in an almost half-circular motion. Thus, the Court finds that Element (a) only requires that the movement of the mold parts towards each other occur in a predetermined direction, as stated by the claim language.

FN4. The Court has already noted that not all of the faces of the mold parts (i.e. parting surfaces) have to touch each other during the "combining" process but only that they touch at *some* point to ensure that no liquid plastic leaks out before the plastic is converted into a molded product. "Closing," on the other hand,

signifies the act of stopping or obstructing all gaps. Random House Webster's College Dictionary at 247.

3. Element (b)

Element (b) states that the invention requires "Injecting plastic in a fluid state into a cavity situated within the par-ting surface." Turn-Key's construction follows the plain language of the claim on the grounds that no rewording is necessary to interpret the language since the inventor's choice of words is clear. Pl's Opening Brief at 9. Defendants argue that this limitation should be construed as requiring that "[p]lastic that is sufficiently liquid to flow is forcefully introduced into the mold cavity." Joint Statement at 26.

The dictionary defines "fluid" to be a "substance, as a liquid or gas, that is capable of flowing and that changes its shape at a steady rate when acted upon by a force." Random House Webster's College Dictionary 500. Applying this definition to the limitation "plastic in a fluid state," the Court reads the limitation to mean plastic "that is capable of flowing." In addition, the Court finds that the parties' agreement to construe the limitation, "[a] method of cyclic injection molding of plastic," contained in the preamble of Claim 1 as "a repeating cycle involving the introduction of plastic under pressure into a mold to form plastic objects," Joint Statement at 2, binds them to a construction of "injecting" in the Element (b) limitation as the process of "forcefully introducing." Defendants and Turn-Key have agreed to define "injection" as "the introduction of plastic under pressure" and the Court finds that the essence of "under pressure" is equally expressed by the ordinary and customary meaning of the term "forcefully."

4. Element (c)

Element (c) states that the invention requires "Solidifying the injected plastic in the cavity, thereby creating a plastic product." Turn-Key's construction follows the plain language of the claim on the grounds that there are no additional words of special or uncommon meaning that need to be additionally defined. Joint Statement at 7; Pl's Opening Brief at 9. Defendants argue that the limitation should be construed as requiring that "The liquid plastic hardens in the mold cavity to create a hardened plastic product. The cavity imparts a predetermined shape to the liquid plastic and thus to the molded plastic product." Joint Statement at 27. Turn-Key objects to Defendants' usage of the term "harden" on the grounds that it "unnecessarily limits the claim because the hardness of the product is a function of the polymer used and certain materials (e.g. rubbery plastic) remain quite soft after they solidify." Pl's Opening Brief at 9.

The dictionary defines "solidify" as: 1. To make solid; make into a hard or compact mass; change from a liquid or gaseous to a solid form. 2. To unite firmly or consolidate. 3. To form into crystals; to make crystallized. 4. To become solid. 5. To form into crystals; become crystallized. Random House Webster's College Dictionary at 1229. In light of the previous limitation that the plastic, as first injected, is in a state where it is capable of flowing, the Court finds that the ordinary and customary meaning of "solidify" within the context of the '998 patent is to "change from a liquid or gaseous to a solid form." The Court construes the ordinary and customary meaning of "solid," in turn, as having relative firmness, coherence of particles, or persistence of form. Random House Webster's College Dictionary at 1229. In doing so the Court agrees that "harden" adds a limitation not present in the claim language.

5. Element (d)

a. The first portion

The first portion of Element (d) requires "[s]eparating the two mold parts by moving, in a direction opposite to the predetermined direction, said mold parts in relation to each other to create a substantially enclosed guide conduit." Joint Statement at 7.

i. "Separating the two mold parts by moving, in a direction opposite to the predetermined direction, said mold parts in relation to each other"

Turn-Key argues that this portion must be construed as "Separating the two mold parts by moving one or both of the mold parts away from the other, in the opposite direction to the combining direction." Joint Statement at 8. Defendants argue that this limitation must be construed as "[o]pening the mold by moving one or both of the two mold parts away from the other along the same path along which one or both of the mold parts were moved in closing the mold." Joint Statement at 28.

The Court finds "separating" to be utilized in its ordinary and customary sense here, thus signifying the act of keeping apart or dividing, Random House Webster's College Dictionary at 1179, and that it would be inappropriate to substitute other terms to further define it. In particular, the Court declines to substitute "opening" because it represents an added limitation not present in the claim language. The Court further declines to adopt the construction of "along the same path along which one or both of the mold parts were moved in closing the mold" on the grounds that it does not convey the ordinary and customary meaning of "in a direction opposite to the predetermined direction" and that it adds an extra limitation which does not appear in the claim language itself. *See supra* Section IV.A.2.

ii. "[T]o create a substantially enclosed guide conduit"

Turn-Key argues that this part of Element (d) must be construed to require that the process described above "form[s] a substantially enclosed guide conduit by the configuration or shaping of the mold parts." Joint Statement at 8. Defendants argue that this portion of Element (d) requires that "the motion of the two mold parts brings into existence a substantially enclosed guide conduit, which does not exist when the mold is closed." Joint Statement at 29; Crest's Responsive Brief at 11; KM, MC, & Concord's Brief at 6. The Court construes this portion of the claim language to signify that the result of the process of bringing apart the molds in the fashion described in the previously discussed claim language is a substantially enclosed conduit. The separation of the mold parts thus results in something-the conduit-that was not there when the mold parts were in the process of being brought together.

Turn-Key argues that the phrase "substantially enclosed guide conduit" must be construed as "a passageway through which the molded product is guided and transported that is formed within and substantially enclosed by the surfaces of the two mold parts." Joint Statement at 9. Defendants argue that this phrase must be construed as "a duct or channel for conveying material" and that the insertion of the term "guide" means that the conduit "directs the motion of material that passes through it, including molded plastic products as set forth below, thus determining, at least in part, the path of such material." Joint Statement at 29.

The Court construes "conduit" in its ordinary and customary sense, thus signifying a tube or channel for carrying or taking materials from one place to another. Random House Webster's College Dictionary at 275. In addition, the Court construes "guide" in its ordinary meaning, thus signifying something that helps to direct an object's travel or its progressive motion. Id. at 577. The Court consequently construes the "guide conduit" to be a tube or channel that carries materials from one place to another and that helps to direct the materials' progressive motion. The Court rejects TurnKey's argument that the construction of the "guide conduit" as helping to direct the travel of the molded plastic product here in Claim 1 renders Claim 2 which

specifically requires the orientation of the molded plastic product to be directed by the contours of the "guide conduit" superfluous. Claim 1 is an independent claim which merely introduces the guide conduit and Claim 2, a dependent claim, describes the guide conduit's role in one of the steps of the patented process. It is inconsistent for Turn-Key to concede that the guide conduit plays a role in directing the molded plastic product's orientation on the one hand and then to reject a definition of the conduit taking that role into consideration on the other hand. FN5

FN5. During oral argument, counsel for Crest requested that the Court construe "guide conduit" to be a tube or channel that carries materials from one place to another and that *solely* helps to direct the materials' progressive motion. The Court, however, rejects this position because it is ultimately based upon Defendants' mistaken belief that the '998 patent cannot be used with the auxiliary parts that Sorensen criticized in the abstract and Objects of the Invention sections of his patent. This position misreads Sorensen's criticism of the parts and has already been rejected by the Court. *See supra* Section IV.A.1.a; *see also* Rolls-Royce, 800 F.2d at 1108 ("Reference to an object does not constitute in itself a limitation in the claims."). The case cited by Crest's counsel during oral argument, O.I. Corp. v. Tekmar Co. Inc., 115 F.3d 1576 (Fed.Cir.1997), does not sway the Court to the contrary because there, the Federal Circuit found that the written description in the patent "expressly distinguishes over prior art passages by stating that those passages are generally smoothwalled." Id. at 1581. Here, in contrast, the abstract and objects section of the '998 patent does not expressly distinguish Sorensen's invention over prior art by stating that auxiliary moving parts cannot be used but only that they need not be used. Though Crest's counsel argues that all three preferred embodiments in the specification show the guide conduit as being the sole mechanism that directs the movement of the molded product, the Court once again notes that it is the claim which measures the invention, not the specification. *See SRI,* 775 F.2d at 1121.

Turn-Key argues that "substantially enclosed" must be construed to mean that the conduit is "almost entirely enclosed or non-open from the outside environment along its length." Joint Statement at 10; Pl's Opening Brief at 11-12. Defendants argue that "substantially enclosed" must be construed to mean that the conduit has "no significant openings except for an inlet and outlet ." Joint Statement at 29; Crest's Responsive Brief at 10; KM, MC, & Concord's Brief at 6-7. The Court construes the phrase "substantially enclosed" according to its ordinary and customary meaning, thus signifying a conduit that is almost entirely closed in from the outside environment. The Court declines to construe the phrase as requiring an inlet and an outlet on the grounds that it adds an extra limitation present in neither the claim language nor in the essence of the term "conduit." *See* Random House Webster's College Dictionary at 275. Though it is true that the drawings of the preferred embodiments depict two openings, it is the claim which measures the invention, not the specification. *See* SRI International v. Matsushita Electric Corp., 775 F.2d 1107, 1121 (Fed.Cir.1985). Thus, the Court focuses on the claim's language. The Court agrees with Turn-Key that a conduit, in its ordinarysense, need not possess two major openings. FN6 Taking into account the specification, the Court notes that Defendants' contention that the inlet is necessary to allow for the introduction of air to transport the product, KM, MC, & Concord's Brief at 6, is belied by the first and second preferred embodiments which do not use a stream of air.

FN6. For example, a thermometer is described as a sealed glass tube which contains a column of liquid, as mercury, that expands and contracts with temperature changes. See Random House Webster's College Dictionary at 1336. On a basic level, a thermometer is thus a "conduit" which carries liquid from one place to another.

b. The second portion of Element (d)

The second portion of Element (d) of the invention requires a substantially enclosed guide conduit "having contours defined by the regions of the parting surface and the internally positional cavity/ies that are exposed subsequent to separation." Turn-Key argues that this portion of Element (d) requires that the conduit, "at minimum, has contours substantially defined by regions of the parting surface and internally positioned cavity/ies that are exposed to the void within the mold after the mold parts separate." Joint Statement at 11; Pl's Opening Brief at 12-14. Defendants argue that this portion of Element (d) must be construed as requiring all internal surfaces of the guide conduit to be formed only by areas of the parting surfaces and of the mold cavity. Crest's Responsive Brief at 13-14; KM, MC fit Concord's Brief at 7-9.

The Court construes "contours" according to its ordinary and customary meaning, thus signifying the outline of a figure or body, Random House Webster's College Dictionary at 287, and "define" according to its ordinary and customary meaning, thus signifying to determine or fix the boundaries or extent of. Random House Webster's College Dictionary at 346. In applying these meanings, the Court thus construes this portion of Element (d) to require that the outlines of the body of the conduit be determined or fixed by the regions of the parting surface and cavity surfaces; in other words, the contours are formed only by these regions. The prosecution history supports this plain language reading of the claim as it records the exclusion of the term "substantially" which was disclaimed by Turn-Key during the prosecution. *See* Rolls-Royce, 800 F.2d at 1108; Exhibit B to Decl. of Gaffin at 29, 55, 63 (showing that the claim language of the "contours of said conduit, substantially being defined by regions of the parting surface and the internally positioned cavity/ies, which are exposed subsequent to separation" was amended to "a substantially enclosed guide conduit having contours defined by the regions of the parting surface and the internally positioned cavity/ies that are exposed subsequent to separation and leading in a direction substantially perpendicular to said predetermined direction").

Specifically, the history shows that the Examiner rejected Sorensen's patent application, in part, because "[t]he invention, as does the prior art utilized an air ejection of molded plastic articles from mold cavities upon opening of the mold parts. The conduit of the prior art is thus 'substantially defined' by the opened mold parting surfaces." Exhibit B7 to Decl. of O'Brien at 110. In a June 2, 1983 Examiner Interview Summary Record, the Examiner writes that Sorensen's counsel, Edward Callan

pointed out that separate mold part define the guide conduit in which artic [le][is] transported. Examiner suggested that amendment of claim to positively recite formation of such guide conduit by configuration (shaping) of such mold parts defines and is allowable over art of record.

Exhibit B8 to Decl. of O'Brien at 112. The final language of Element (d) reflects this suggested change. The Court finds that this history defeats Turn-Key's position that the amendment broadened, rather than narrowed, the claim language with respect to the description of the contours of the guide conduit. Pl's Reply at 10-11. FN7 For though the claim language had previously required that the contours of the conduit be mostly determined by the regions of the parting and cavity surfaces ("substantially being defined by"), the final language requires that the contours be determined by those regions ("having contours defined by").

FN7. Turn-Key's position is based upon its argument that "having" is an "open" claim term designating "that the named elements are essential, but [that] other elements maybe added and still form a construct within the scope of the claim." Pl's Reply at 11. "The term 'having' does not mean 'including only' " but means

"including at least." *Id*. Turn-Key thus argues that the sentence, "a car **having** front doors," does not mean that a car can only have front doors. Pl's Opening Brief at 12 (emphasis in original). Rather, "[t]he car can have other doors and still be covered by the claim. The car with front doors would not avoid infringement if it also had wheels, back doors, and a hatchback, for example. The front doors would be an essential element of the claim, but would not exclude any other elements." *Id*. Though Turn-Key's observations about the car example may be valid, the Court finds that the analogy is inapplicable to the case at hand because the phrase at issue here is "having contours defined by." Turn-Key's car example, in contrast, only involves the term "having" and as such, analogizing the car example to the present case necessarily reads the term "defined" out of existence of Element (d) of Claim 1.

The parties also dispute the interpretation of "exposed subsequent to separation"-Turn-Key, on the one hand, argues that this language should be interpreted to refer to the regions of the parting surface and internally positioned cavity/ies that are exposed to the void within the mold after the mold parts separate. Pl's Opening Brief at 14; Pl's Reply Brief at 12-13. Defendants on the other hand, argue that "exposed subsequent to separation" refers to the areas of the parting surface and of the surfaces of the mold cavity that are exposed to the molded plastic part after the mold is opened. Crest's Responsive Brief at 14; KM, MC, & Concord's Brief at 7 n. 7. Turn-Key and Defendants both point to the specification to support their respective interpretations-Turn-Key argues that Figures 3, 5, 7, 9, and 11 show that "only surfaces that are exposed to the void within the mold are designated as contours of the guide conduit," Pl's Opening Brief at 14, and Defendants argue that Figures 3 and 5 "show that all of the indicated contours are exposed to the molded product part (petri dish 6), i.e. not separated from the dish by any intervening structure. The same can be seen in [Figure] 9." Crest's Responsive Brief at 14.

The Court, however, is persuaded by neither of these proposed interpretations because both Plaintiff and Defendants, at bottom, are attempting to read what they perceive to be limitations contained in the preferred embodiments into the claim language. *See* SRI International, 775 F.2d at 1121; *see also* Laitram Corp., 863 F.2d at 865 ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations."). In addition, the Court agrees with Defendants that Turn-Key's interpretation is circular because the "void within the mold" is none other than the guide conduit itself, and the "exposed" contours are themselves the defining features of the guide conduit. Thus, Turn-Key's construction "define[s] the contours of the guide conduit in terms of the conduit itself." Crest's Responsive Brief at 14. The Court, however, also rejects Defendants' construction because it is premised on the proposition that there can be no intervening structures between the contours of the guide conduit and the product. *Id*. This position has already been rejected by the Court. *See* supra III.A.1.b.

The Court looks at the language of the claim itself, as it must, to interpret the phrase "exposed subsequent to separation." Vitronics, 90 F.3d at 1578. The dictionary defines "expose," in part, as "to uncover, bare," "to present to view, exhibit," or to "make known [or] reveal." Random House Webster's College Dictionary at 460. The Court, in applying the ordinary and customary meanings of the word "expose," construes the phrase to refer to the regions of the parting surfaces and the cavity surfaces that are revealed or uncovered after the "separating" process described above, *see supra* Section IV.A.5.a.i, so that they can be viewed by the eye. Nothing in the specification suggests that Sorenson, as patentee, intended to define the phrase in his own terms rather than by the phrase's common, customary meaning. Vitronics, 90 F.3d at 1584-85.

c. The third portion of Element (d)

The third portion of Element (d) of the invention requires that the substantially enclosed guide conduit be "leading in a direction substantially perpendicular to said predetermined direction." Turn-Key argues that this language must be construed to require that the conduit lead in a direction substantially perpendicular to the direction that one or both of the mold parts move toward the other. Joint Statement at 12; Pl's Opening Brief 14. Turn-Key argues that its construction follows the plain language and that no rewording is necessary to interpret the claim. Defendants, on the other hand, argue that "leading in a direction" means "determining a single path that is used for movement of molded plastic products" and that "said predetermined direction" means "the straight path running between the two mold parts, along which they were moved in closing the mold and in opening the mold." Joint Statement at 16. Thus, Defendants conclude that "the guide conduit determines a single path for movement of molded plastic products, which is in a plane substantially perpendicular to the path of mold opening and closing." *Id*.

In line with the Court's construction of Element (a) and the first portion of Element (d), the Court rejects Defendants' attempts to construe "direction" and "predetermined direction" in such a restrictive manner as to signify a "straight path." *See supra* at Section IV.A.2 and IV.A.5 (a)(i). Rather, the Court construes the third portion of Element (d) to require that the substantially enclosed guide conduit lead in a direction almost entirely perpendicular to the predetermined direction that one or both of the mold parts were moving toward the other during the process when they were being brought together. In so construing, the Court finds "perpendicular" to be utilized in its everyday, ordinary sense and concludes that as such, it need not be further defined.

6. Element (e)

Element (e) of Claim 1 requires "Ejecting the plastic product into said guide conduit." Joint Statement at 12. Turn-Key argues that this element must be construed to require "Removing the plastic product from one of the mold parts" into the substantially enclosed conduit. *Id.;* Pl's Opening Brief at 14-15. Defendants conversely argue that the phrase means "forcefully discharging each molded plastic product from a surface of the mold cavity so that it enters the guide conduit and so that it is free to move within the guide conduit and is not held away from the walls of the guide conduit by any intervening structure." Joint Statement at 38; Crest's Responsive Brief at 15-16; KM, MC, & Concord's Brief at 10.

The dictionary defines "eject" as: 1. To drive or force out; expel. 2. To dismiss, as from office. 3. To evict. 4. To throw out or throw off. 5. To propel oneself from a disabled airplane, especially by an ejection seat. Random House Webster's College Dictionary at 419. In applying this definition to the ' 998 patent, the Court construes Element (e) to require that the plastic product be expelled or otherwise driven into the substantially enclosed conduit. FN8 The Court, however, declines to construe Element (e) as requiring either that the plastic product be free to move within the guide conduit after its ejection or that it is not held away from the walls of the guide conduit by any intervening structure on the grounds that they represent extra limitations not present in the claim language. The patent's language does not disclose a specific ejection method to be utilized and the specification's references to particular methods (i.e. stripper plate) should not be read into the actual claim itself. *See* Laitram, 863 F.2d at 865 ("References to a preferred embodiment, such as those often present in a specification, are not claim limitations."); *see also* ' 998 patent at Col. 5 ll 6-11; ll.15-17; 23-25 ("While the above description contains many specificities, these should not be construed as limitations on the scope of the invention, but rather as an exemplification of one preferred embodiment thereof .... Molds may also be employed which do not have a stripper plate, but where ejection is accomplished by some other means such as pins or sleeves .... [T]he scope of the invention should be determined not by the embodiments illustrated, but by the appended claims and their legal equivalents.").

FN8. During oral argument, Turn-Key insisted that the Court clarify its interpretation of "ejecting" so as to expressly allow for a pulling motion to be encompassed within the definition of the term. Defendants agreed that "ejecting" could encompass a pulling motion as long as force was applied. The Court concludes that "ejecting" can entail a pulling action and that the ordinary meaning of "pull" necessarily involves the application of force. *See* Random House Webster's College Dictionary at 1055. The Court notes that "force" is utilized in a broad sense here so that the application of gravity upon an object would constitute "force," as would the conventional means by which one removes dishes from a dinner table.

7. Element (f)

Element (f) of Claim 1 requires "Guiding and transporting the ejected product from between the mold parts through the guide conduit." '998 patent at Col. 6 ll. 14-16. Turn-Key argues that this element must be construed according to its plain language and defines "guiding" as directing the product's path of travel through the conduit and "transporting" as causing the product to move through the conduit. Joint Statement at 14; Pl's Opening Brief 16-18. Defendants conversely argue that Element (f) requires that each ejected plastic product has its path determined by and is conveyed by the guide conduit until the plastic product has exited the mold completely. In addition, Defendants argue that the ejected plastic product does not interact with any other structure for guiding or conveying it from between the primary mold parts, besides the guide conduit. Joint Statement at 41; Crest's Responsive Brief 17-19; KM, MC & Concord's Brief at 10-11.

The Court construes the term "guiding" according to its ordinary and customary meaning, thus signifying the act of directing, Random House Webster's College Dictionary at 577 and "transporting" in its ordinary and customary meaning, thus signifying the act of carrying. Id. at 1368. The dictionary defines "through" as "in at one end, side, or surface and out at the other." Id. at 1341. The Court therefore construes Element (f) to require the directing and carrying of the ejected plastic product from the space separating the mold parts to the end or to an exit of the guide conduit. The Court finds Defendants' construction requiring that the carrying and directing of the product be accomplished by the conduit itself to be unsupported by the plain language of the claim. The Court's construction does not render "guide" in Element (d) meaningless because, as previously noted, Element (d) merely introduces the conduit and incorporates into its definition the role that it plays in directing the travel of the ejected molded plastic product-none of the parties contest the fact that the conduit plays some kind of role in directing the movement of the product.

The Court's construction also does not render "guiding" in Element (f) meaningless because the construction still requires that the product be directed in its travel from the space between the mold parts to the end or to an exit of the conduit. The claim language does not disclose the method by which the carrying and directing of the product is to be accomplished and as such, the Court declines to require that the product not interact with anything other than the guide conduit during the process described in this claim.

B. Claim 2 of '998 Patent

Claim 2, a dependent claim, provides for "[a] method according to claim 1, wherein step (f) comprises the step of (g) Transporting the ejected product through the guide conduit at an orientation directed by the contours of the guide conduit." '998 patent at Col. 6 at ll. 18-21. Turn-Key argues that this claim must be construed to require the method of claim 1 but that now the product is touching the contours of the substantially enclosed guide conduit during its travel within the conduit. Pl's Opening Brief at 18-19; Pl's Reply Brief at 17-18. Defendants argue that this claim requires that each ejected product is held in a

predetermined alignment by the internal surfaces of the walls of the guide conduit while it is conveyed through the guide conduit and out of the mold. Joint Statement at 43; Crest's Responsive Brief at 19. The Court finds that the parties essentially agree on the interpretation of this claim.

The Court construes "orientation" to be utilized in its ordinary and customary sense, thus signifying a position or alignment in relation to the points of a compass or to a specific place or object. Random House Webster's College Dictionary at 921. The Court thus construes Claim 2 as requiring the molded product to touch the contours of the conduit during its travel within the conduit so that the contours of the conduit themselves send the molded product along a specific alignment or position.

C. Claim 5 of '998 Patent

Claim 5, a dependent claim, provides for "[a] method according to Claim 1, 2, 3, or 4 wherein step (f) comprises the step of (h) Transporting the ejected product through the guide conduit with a stream of air." '998 patent at Col. 6 ll. 30-33. Turn-Key argues that this claim must be construed as requiring the methods of Claims 1, 2, 3, or 4 but that now a stream of air is introduced into the substantially enclosed guide conduit so that the product is transported through the conduit, accompanied by the stream of air. Pl's Opening Brief at 19; Pl's Reply Brief at 19. Defendants argue that this claim must be construed as providing for the method of any of claims 1-4 in which a stream of air provides at least a substantial part of the motive force causing the molded plastic product to move through the guide conduit. Crest's Responsive Brief at 19; KM, MC & Concord's Brief at 12-13.

Though the dictionary gives the primary definition of "with" as being "accompanied by" or "accompanying," Random House Webster's College Dictionary at 1476, it also defines "with" as "by the use of as a means or instrument" or "using" (i.e. cut with a knife). Id. Consequently, both constructions proffered by Turn-Key and Defendants appear to be supported by the dictionary. Ordinarily, in the phrase, "transporting the ejected product through the guide conduit with a stream of air," the word "with" would usually be understood to mean that the ejected product was transported through the guide conduit by the means of the stream of air. However, the specification of the '998 patent defeats such an interpretation here and, as such, controls the definition of the term "with" in Claim 5. *See* Vitronics, 90 F.3d at 1582 (noting that though courts should typically construe terms by their common, customary meaning, patentees are allowed to define their own terms in the specification and also noting that the specification "is the single best guide to the meaning of the disputed term"). The first and second preferred embodiments disclose that gravity, not air, transports the product down through the guide conduit. ' 998 patent Col. 3 ll. 23-29; Col. 4 ll. 1-6. In addition, the third preferred embodiment contemplates the introduction of air in a direction opposite to the travel of the product, indicating that such air may retard rather than facilitate the product's movement. '998 patent at Col 4. ll. 35-37 ("There is a stream of sterile air also in the product receiver guide conduits 22 but not necessarily in the direction of the arrows 24). Thus, the Court construes Claim 5 as providing for the transportation of the ejected product through the guide conduit, accompanied by a stream of air.

D. Claim 6 of '998 Patent

Claim 6, a dependent claim, provides for "A method according to claim 5 wherein step (h) comprises the step of: (i) Transporting the ejected product through the guide conduit with a stream of sterile air." '998 patent at Col. 6 ll. 34-37. Turn-Key argues that the "stream of sterile air" must be construed as air that is filtered or otherwise treated to improve the purity of the air by reducing contaminants such as dust or other harmful products. Pl's Opening Brief at 20. Defendants, on the other hand, define "sterile air" as air which is free from bacteria or other microorganisms. Crest's Responsive Brief at 20; KM, MC, & Concord's Brief at

13.

The dictionary defines "sterile" as: 1. Free from living germs or microorganisms; aseptic. 2. Incapable of producing offspring; infertile. 3. Barren; not producing vegetation. 4.(a) Noting a plant in which reproductive structures fail to develop. (b) Bearing no stamens or pistils. 5. Not productive of results, ideas, etc.; fruitless. Random House Webster's College Dictionary at 1265. In applying this definition to the '998 patent, the Court thus construes "sterile air" in Claim 6 to signify air that is free from living germs or microorganisms. Consequently, a "stream of sterile air" signifies a current or flow of air that is free from living germs or microorganisms. Nothing in the specification shows that Sorenson, as patentee, intended to define the word in his own terms rather than by the term's common, customary meaning.

V. CONCLUSION

Based on the foregoing, the Court concludes that:

1. "Two mold parts" of the preamble of Claim 1 is construed as the mating halves of a mold as a whole.

2. "Parting surface" of the preamble of Claim 1 is construed as the faces of the two mold parts that either touch or lie adjacent when the mold parts are brought together; however, the faces of the two mold parts must touch each other at some point.

3. "Cavity" in the preamble of Claim 1 is construed as the hollow space that is surrounded by a parting surface.

4. "Combining" of Element (a) of Claim 1 is construed as the act of bringing the two mold halves into or joining the two mold halves in a close union or whole by moving one or both of them towards each other.

5. Element (b) of Claim 1 is construed as an act of forcefully introducing plastic that is capable of flowing into a hollow space surrounded by a parting surface.

6. Element (c) of Claim 1 is construed as the act of changing the fluid plastic to a state where the plastic has relative firmness, coherence of particles, or persistence of form.

7. "Separating" in the first portion of Element (d) of Claim 1 is construed as the act of keeping apart or dividing t he two mold halves by moving one or both of them away from each other.

8. "To create a substantially enclosed guide conduit" in the first portion of Element (d) is construed as the process whereby the result is a substantially enclosed guide conduit.

9. The "substantially enclosed guide conduit" is construed as a tube or channel that is almost entirely closed in from the outside environment, and that carries materials from one place to another and that helps to direct the materials' progressive motion.

10. The second portion of Element (d) of Claim 1 is construed as the requirement that the outlines of the body or figure of the conduit result from the regions of the parting surfaces and cavity surfaces that are revealed or uncovered after the "separating" process so that they can be viewed by the eye.

11. The third portion of Element (d) of Claim 1 is construed as the requirement that the conduit lead in a direction almost entirely perpendicular to the predetermined direction that one or both of the mold parts were moving toward the other during the process when they were being brought together.

12. Element (e) of Claim 1 is construed as expelling or otherwise driving the molded plastic product into the conduit.

13. Element (f) of Claim 1 is construed as the carrying and directing of the product from the space between the mold parts to the end or to an exit of the conduit.

14. Claim 2 is construed as the requirement of the method according to claim 1 but that now the product is touching the contours of the conduit during its travel within the conduit so that the contours of the conduit themselves send the molded product along a specific alignment or position.

15. Claim 5 is construed as providing for the transportation of the ejected product through the guide conduit, accompanied by a stream of air.

16. Claim 6 is construed as requiring a stream of sterile air that is free from living germs or microorganisms.

IT IS SO ORDERED.

C.D.Cal.,2002.
In re Turn-Key-Tech Matters