

United States District Court,
D. Oregon.

MICHAELS OF OREGON CO., an Oregon Corporation,
Plaintiff.

v.

CLEAN GUN, LLC, a Texas Limited Liability Company,
Defendant.

July 9, 2002.

FINDINGS AND RECOMMENDATION ON CLAIM CONSTRUCTION

STEWART, Magistrate J.

INTRODUCTION

On July 27, 2001, plaintiff, Michaels of Oregon Co. ("Michaels"), filed this action against defendant, Clean Gun, LLC ("Clean Gun"). On June 18, 2002, Michaels filed its First Amended Complaint (docket # 61), alleging infringement of two of its patents for gun barrel cleaning devices in violation of 35 USC s. 271. FN1 Accordingly, Michaels seeks: (1) a declaratory judgment that U.S. Patent No. 5,871,589 (" '589") and U.S. Patent No. 5,972,125 (" '125") are valid and infringed by Clean Gun; (2) a permanent injunction prohibiting Clean Gun's infringement; (3) damages and an accounting; (4) prejudgment and postjudgment interest on the damages; (5) costs and disbursements; and (6) attorney fees.

FN1. In light of 35 USC s. 271(h) ("As used in this section, the term 'whoever' includes any State ... [and] shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity"), the Supreme Court has held that "the Patent Remedy Act cannot be sustained under s. 5 of the Fourteenth Amendment." *Florida Prepaid Postsecondary Educ. Expense Bd. v. College Sav. Bank*, 527 U.S. 627, 647 (1999). Since no party to this case is a state, this court assumes that 35 USC s. 271 remains the appropriate statute for Michaels' patent infringement claims.

This court has federal jurisdiction under 28 USC s.s. 1331 and 1338(a). Michaels and Clean Gun consented to allow a Magistrate Judge to enter final orders and judgment in this action in accordance with FRCP 73 and 28 USC s. 636(c). However, after the claim construction hearing, this court granted Michaels' motion to file an Amended Complaint to add defendants. Those newly added defendants have not yet appeared and consented to a Magistrate Judge, necessitating the issuance of these Findings and Recommendation.

The parties have requested construction of certain claim language in the two patents. Both parties filed briefs and orally argued their differing interpretations of the disputed claim terms.

CLAIM CONSTRUCTION

I. Overview of Technology

The two patents in this case are directed toward, among other things, a method for cleaning a gun barrel in one pass using a rope-like device. The method for cleaning the inside of a gun barrel involves dropping an

end of the gun barrel cleaning device into a first end of the gun barrel. The gun barrel cleaning device is then pulled through the inside of a gun barrel by the first end of the gun cleaning device. The inside surface of the gun barrel is scrubbed with the brush as the gun barrel cleaning device is pulled through. Once scrubbed, the inside surface of the gun barrel is then cleaned with a cleaning section that is connected to and aligned with the length of the gun barrel cleaning device.

The inventions claimed in the '589 and '125 Patents have their genesis in the difficulties encountered when using prior art for gun barrel cleaning devices. Some prior art involves the use of a sectional rod requiring assembly, disassembly, and changes of attachments. These attachments include a wire brush or a slotted metal tool into which a cloth patch or swab is fitted. Another prior art device utilizes a cord which is pulled through the barrel, dragging a cloth patch. Cloth patches and swabs compress and clean unevenly. The inventor of the '589 and '125 patents FN2 sought to provide a method for cleaning a gun barrel which avoided the inconvenience of assembly, disassembly and changes of attachment, as well as uneven cleaning.

FN2. The inventor is Bruce Hedges from whom Michaels purchased the patents.

II. Disputed Terms

The '589 and '125 Patents each contain both device (or apparatus) FN3 claims and method (or process) FN4 claims for rope-like gun barrel cleaning devices, as well as drawings of four different variations (or preferred embodiments) FN5 of the devices. The device claims of the '589 Patent (claims 1-20) are directed to one of the four device drawings (Figs. 10 and 10A) and the device claims of the '125 Patent (claims 1-7) are directed to another device drawing (Fig. 1 and, although it is unclear, perhaps also Figs. 13 and 14). Michaels admits that Clean Gun's gun barrel cleaning device does not infringe on any of these device claims.

FN3. Device (or apparatus) claims patent a device, such as an automatic bread maker.

FN4. Method (or process) claims patent a method, such as the steps for baking bread.

FN5. A preferred embodiment is a detailed description of the invention, including the best modes for carrying out the invention.

However, three method claims of the '589 Patent (claims 21-23) FN6 and one method claim of the '125 Patent (claim 8) describe a method for using the described gun barrel cleaning device. It is these method claims ("the asserted claims") for which Michaels alleges infringement by Clean Gun. The asserted claims read as follows:

FN6. Claim 24 is a fourth method claim which the parties do not directly challenge, but apparently challenge by implication, since claim 24 contains the same disputed terms.

Claim 21:

A method for cleaning the inside of a gun barrel in one pass with a gun barrel cleaning device having a first end and a second end which comprises the steps of:

dropping the first end of the gun barrel cleaning device into a first end of the gun barrel;

pulling the gun barrel cleaning device through the inside of the gun barrel by the first end of the gun barrel cleaning device;

scrubbing the inside surface of the gun barrel with a brush connected to and aligned with the length of the gun barrel cleaning device, as the gun barrel cleaning device is pulled through the inside of the gun barrel, loosening debris from the inside of the gun barrel;

cleaning the inside surface of the gun barrel with a cleaning section connected to and aligned with the length of the gun barrel cleaning device, as the gun barrel cleaning device is pulled through the inside of the gun barrel, absorbing and removing debris from the inside of the gun barrel.

Claim 22 (dependent on claim 21):

The method for cleaning the inside of a gun barrel in one pass of claim 21 comprising the additional step of applying a solvent to the cleaning section for assisting the loosening of debris from the inside of the gun barrel.

Claim 23 (dependent on claim 21):

The method for cleaning the inside of a gun barrel in one pass of claim 21 comprising the additional step of applying a gun oil to an oiling wick attached to the gun barrel cleaning device for oiling the inside of the gun barrel.

Claim 8:

A method for cleaning the inside of a gun barrel in one pass with a gun barrel cleaning device having a first end and a second end which comprises the steps of:

dropping the first end of the gun barrel cleaning device into a first end of the gun barrel;

pulling the gun barrel cleaning device through the inside of the gun barrel by the first end of the gun barrel cleaning device;

scrubbing the inside surface of the gun barrel with a brush connected to and aligned with the length of the gun barrel cleaning device; and cleaning the inside surface of the gun barrel with a cleaning section connected to and aligned with the length of the gun barrel cleaning device.

The parties dispute the construction of the following terms contained in the asserted claims: (1) cleaning the inside of a gun barrel; (2) in one pass; (3) gun barrel cleaning device; (4) connected to and aligned with the length of the gun barrel cleaning device; (5) cleaning section; and (6) oiling wick.

The specifications FN7 of the '589 and '125 Patents are nearly identical because the '125 Patent issued as a continuation of the '589 Patent application. The parties agree that claim terms used more than once or in more than one asserted claim in either the '589 Patent, '125 Patent, or both, have the same meaning and are used consistently throughout.

FN7. Every patent includes a "specification." The specification is the detailed description of the invention which appears before the claims and serves a number of purposes, including to describe the invention in sufficient detail to allow one to make and use the invention. 35 USC s. 112. A specification usually includes a description of one or more "preferred embodiments" of the invention, and frequently includes detailed drawings of those embodiments. *See SRI Int'l. v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1121-22 (Fed Cir1985).

III. Law of Claim Construction

"[T]he construction of a patent, including terms of art within its claim, is exclusively within the province of the court." *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996). While the court adopts the parties' agreed construction of claims where possible, claims are construed independently and not simply as a choice between the parties' constructions. *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F3d 1553, 1555 (Fed Cir1995), *cert denied*, 518 U.S. 1020 (1996). Because claim construction "is not an obligatory exercise in redundancy," the court need not restate every claim. *United States Surgical Corp. v. Ethicon, Inc.*, 103 F3d 1554, 1568 (Fed Cir), *cert denied*, 522 U.S. 950 (1997).

"[C]laims should be so construed, if possible, as to sustain their validity. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577 (Fed Cir1984) (citations omitted). The claim language specifies "the subject matter which the applicant regards as his invention." ' *Markman*, 517 U.S. at 373, quoting 35 USC s. 112.

To construe a patent claim, courts first look to the language of the claims in the patent itself, the description in the patent's specification, and the prosecution history of the patent, all of which constitute a record "on which the public is entitled to rely." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F3d 1576, 1583 (Fed Cir1996); *see also* *Dow Chem. Co. v. Sumitomo Chem. Co., Ltd.*, 257 F3d 1364, 1372 (Fed Cir2001). Claim language is given its "ordinary and accustomed meaning as understood by one of ordinary skill in the art." *Dow Chem. Co.*, 257 F3d at 1372 (citation omitted). Courts cannot rewrite claims, but must "give effect to the terms chosen by the patentee." *K-2 Corp. v. Solomon S.A.*, 191 F3d 1356, 1364 (Fed Cir1999) (citation omitted).

In most cases, the court should be able to resolve ambiguous claim terms by analyzing only the intrinsic evidence. *Vitronics Corp.*, 90 F3d at 1583. If the intrinsic evidence is inconclusive, however, the court may look to extrinsic evidence, including "expert testimony, inventor testimony, dictionaries, and technical treatises and articles." *Id* at 1583-84.

IV. Analysis

Claim construction of a patent which includes both device and method claims presents a particularly difficult challenge. When used to describe the steps used by a mechanical device, as in this case, a method claim may encompass different embodiments of devices which perform the described method. In that event, the utility of device claims seem questionable because they are redundant. If a patent includes both device and method claims, it is tempting to construe them identically to describe only the device covered by the device claim and its intended use. However, given the absence of case law on construing device and method claims in the same patent, this court will follow the well-established steps for a proper claim construction analysis.

The parties posit competing claim constructions of a number of terms in the asserted claims. However, the overriding dispute between the parties is whether certain features of a preferred embodiment, namely Figure 4, are incorporated in the asserted claims. Clean Gun argues that due to a restriction requirement FN8 imposed during the prosecution of the '589 Patent, the asserted claims are limited to only the features of the one device shown in Figures 10 and 10A. Michaels responds that the asserted claims encompass all of the features of the devices shown as preferred embodiments, including Figure 4. Because resolution of this issue impacts all other claim construction issues, it is addressed first.

FN8. Restriction requirements are issued by the PTO when a patent application improperly attempts to claim more than one invention. In response, the applicant is required to restrict the application to a single

invention by choosing only one of the multiple inventions identified by the Patent Examiner ("Examiner"). If the applicant wishes to obtain patent protection for the other inventions, a separate "divisional" patent application can be filed for each such invention.

A. Disclaimers During Prosecution

Prosecution history of a patent with the United States Patent and Trademark Office ("PTO") "limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance." *Jonsson v. Stanley Works*, 903 F.2d 812, 817 (Fed Cir1990) (internal quotations and citations omitted). Any statements or actions made in the prosecution history by the patentee characterizing what the claimed invention includes or excludes provide notice to the public as to the scope of the claims and are therefore binding on the construction of the claims. *See, e.g., Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F3d 951, 957 (Fed Cir2000) (allowing patentee to erase actions in the prosecution history would be "inimical to the public notice function provided by the prosecution history."); *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F3d 1570, 1576-77 (Fed Cir1995) (finding that applicant's statement made during prosecution that "sputter-deposited dielectric" could only be formed by a one-step process precluded claims from including a two-step process).

1. History of Applications

A proper construction of the asserted claims, particularly in relation to the Examiner's restriction requirement, necessitates a discussion of the history of these applications.

a. Original Application

The original patent application in the chain of applications leading to the '589 and '125 Patents was filed on September 25, 1996. Def's Ex 4, p. A52. This application illustrated two distinct rope-like gun barrel cleaning devices. *Id* at A80 (Fig.1), A82 (Fig.4). The first of those devices (Fig.1) is a tubular fabric sheath with a "brush" encased within the sheath, exposing soft bristles, located between two short, thicker "cleaning sections" created by foam inserts also encased within the sheath. The second gun barrel cleaning device (Fig.4) is made of sections including vinyl flexible tube sections, thicker cleaning sections, and a section having an exposed wire brush. Each of the sections include threaded connections for assembly and disassembly of the device.

On March 21, 1997, the PTO received the applicant's request to amend four of the claims. *Id* at A90. On August 8, 1997, the Examiner noted that the application claimed two different devices and, because every patent must be limited to a single invention, issued a restriction requirement. *Id* at A94-95. In particular, the Examiner stated that:

This application contains claims directed to the following patentably distinct species of the claimed invention: Fig.1 and Fig.4.

Applicant is required under 35 U.S.C. [s.] 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Id at A95.

On March 11, 1998, the Examiner sent the applicant a notice of abandonment for failing to respond to this restriction requirement. *Id* at A98.

b. '589 Application

On January 28, 1997, the applicant filed a continuation-in-part ("CIP") FN9 application of the original patent application. Def's Ex 5, p. A100. This '589 Application illustrated the same two gun barrel cleaning devices as the original application and added two more devices. Id at A134 (Fig.1), A136 (Fig.4), A138 (Fig. 10 and 10A), A141(Figs. 13 and 14).

FN9. A CIP application typically includes all of the disclosure of a parent application and adds additional disclosure.

On April 21, 1997, the PTO received an amendment for this patent. Id at A149-53. The amendment requested to alter the language of seven claims and added a new claim. On June 20, 1997, the Examiner again noted that the '589 Application claimed multiple devices and issued a restriction requirement for the applicant to elect a single device to which the application would be restricted. Id at A154-56. Specifically, the Examiner again stated:

This application contains claims directed to the following patentably distinct species of the claimed invention: 1) Fig.1, 2) Fig.4, 3) Figs. 10, 10A, 4) Figs. 13,14.

Applicant is required under 35 U.S.C. s. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently no claim is generic.

Id at A155.

In response, on July 21, 1997, the applicant amended four claims and added three new method claims (claims 26-28). Id at A159-63. Moreover, "the applic [ant] elect[ed] the embodiment of the invention shown in Figs. 1 and 2 for prosecution on the merits." Id at A163. Because of the three new method claims, the applicant was required to pay an additional \$33.00. Id at A165. On December 6, 1997, the Examiner sent a notice of abandonment for failure to pay the \$33.00. Id at A167. On January 20, 1998, the PTO received the applicant's petition to revive the abandoned patent application and \$33.00 for the "additional three dependent claims." Id at A168-69.

On April 23, 1998, the applicant cancelled all claims 1-28 and added claims 29-56 FN10 "simply to clean up the Claim language and to bring the form of the Claims more closely in line with the Claims as filed in the co-pending ... application." Id at A174-79. On May 28, 1998, the Examiner again required that all claims be subject to a restriction or election requirement. Id at A181-83. As before, he stated that:

FN10. Claims 53-55 were later renumbered as claims 21-23, the asserted claims.

This application contains claims directed to the following patentably distinct species of the claimed invention: 1) Fig.1, 2) Fig.4, 3) Figs.10,10A, 4) Figs.13,14.

Applicant is required under 35 U.S.C. [s.]121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Id at A181.

Additionally, the Examiner stated as follows:

In the election filed September 3, 1997, Applicant elected the species of Figs. 1 and 2 and recited that claims 1-9, 11-17, 20-23 and 25-28 read on the elected species. In the Preliminary Amendment filed April

23, 1998, Applicant has now cancelled claims 1-28 and added new claims 29-56. Applicant should reconfirm the election of species requirement and also provide the new claims readable on the elected species.

Id at A182.

On May 28, 1998, the applicant responded by deleting claims 42, 43, 44, and 45, and specifically elected to pursue the device embodiment illustrated in Figures 10 and 10A. Id at A185. The applicant further stated that all of the remaining pending claims, including the method claims at issue in this case, were readable on Figures 10 and 10A. Id. The applicant did not correct or take issue with the Examiner's statement that no pending claim was generic.

On August 28, 1998, the Examiner held an interview with the applicant by telephone. Id at A188. They agreed to amend claims 32, 36, 37, 40, 52, and 56 "to overcome minor 35 USC 112, second paragraph deficiencies." Id at A190-91. On September 3, 1998, the Examiner sent the applicant a "Notice of Allowability" on claims 29-41 and 46-56. Id at A189. On October 26, 1998, the PTO received the applicant's "new" drawings, which are unaltered drawings of the four devices previously submitted. Id at A206.

On November 9, 1998, the Examiner conducted another interview by telephone. Id at A204. The parties discussed the language of claims 29-34 FN11 to distinguish from newly discovered prior art as anticipated in Arnold, Patent No. 4,167,192. Id. The Examiner agreed that adding "tubular fabric sheath" to these claims would make the patent allowable. Id. In response, on November 10, 1998, the applicant filed another supplemental amendment, indicating that:

FN11. The Examiner's notes refer to both claims 29-34 and claims 29-36. Because the applicant only refers to and modifies claims 29-34, this court assumes that these are the claims that required modification.

The amendment of Claims 29 through 34 has been made to modify the term "tubular sheath" to include a limitation requiring that the "tubular sheath" be formed of a fabric. Inasmuch as Claim 34 depends from Claim 35 which depends from Claim 34 which in turn depends from Claim 29, Claims 35 and 36 now also include the limitation that the "tubular sheath" be formed of a fabric.

These amendments do not constitute new matter as they are consistent with the existing specification and claims. Applicant respectfully requests withdrawal of the above stated grounds for rejection.

Id at A199-200.

Thus, on November 13, 1998, the Examiner issued a second Notice of Allowability on claims 29-41 and 46-56. Id at A205. This Application then issued as the '589 Patent on February 16, 1999. Def's Ex 1, p. A1.

c. '125 Continuation Application

On September 17, 1998, the applicant filed a "continuation" of the CIP Application ('589 Patent Application). Def's Ex 6, pp. A220-243. The '125 Application's method claim is nearly identical to method claim 21 in the '589 Application. Id at A242-43. Additionally, the applicant again filed the same diagrams depicting all four of the devices. Id at A249, A251, A253, A256.

On November 17, 1998, the Examiner provisionally rejected claims 1-9 "under the judicially created doctrine of double patenting over claims 29-41 and 46-56 of copending ['589 Patent] Application...." FN12 Id at A262-63. The Examiner went on to explain:

FN12. Just as a patent can be directed to only a single invention, an invention can typically be given only a

single patent. Otherwise, if multiple patents for a single invention were allowed, the temporary monopoly afforded by a patent could be improperly extended. An exception to this rule is made, as in this case, where the applicant files a "terminal disclaimer" of the later issued patent so that it will expire on the same day as the earlier issued patent.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A gun barrel cleaning device for cleaning an inside surface of a gun barrel comprising a tubular sheath, a brush enclosed within the tubular sheath, the brush including bristles extending through the wall of the tubular sheath, a cleaning section also enclosed within the sheath, as well as a method for cleaning the inside of a gun barrel in one pass with a gun barrel cleaning device having a first end and a second end. Id at A263-64.

The Examiner also rejected claim 1 as being "anticipated by Arnold '192." ' Id at A264. Meanwhile, the Examiner indicated that claims 2-9 were allowable upon the filing of a terminal disclaimer. Id at A265. On March 12, 1999, the applicant responded by deleting claim 1 and filed a terminal disclaimer two days later. Id at A268-71. On April 30, 1999, the Examiner issued a "Notice of Allowability." Id at A273.

The '125 Application issued as the '125 Patent on October 26, 1999. Def's Ex 1, p. A16. This final '125 Patent essentially: (1) restates claims 1 and 21 of the '589 Patent (claims 1 and 8); (2) reinserts claims 42-45 which had been deleted from the '589 Patent (claims 2-5); and (3) adds two new claims (claims 6 and 7). In essence, then, the '125 Patent merely added claims 42-45, which are the very same claims that the Examiner required the applicant delete from the '589 Patent.

2. Effect of Restriction

As discussed above, during prosecution of the '589 Patent, the Patent Examiner required the applicant "to elect a single disclosed species for prosecution" and to restrict its claims to one of the four different devices disclosed in the application. In response, the applicant elected to patent the device in Figures 10 and 10A of the application, thus disclaiming the other three devices. Clean Gun contends that Michaels is bound by the election taken during prosecution and cannot now seek a claim construction of the asserted claims that would encompass any surrendered device, such as the one shown in Figure 4.

Restriction requirements do not constitute a substantive claim construction doctrine. Instead, restriction practice is a procedural tool that may be implemented when the PTO finds that an applicant has two distinctly patentable inventions in the same application. Unlike a rejection for obviousness or anticipation, the inclusion of two or more inventions in the same application does not render the inventions unpatentable. "There is nothing inherently wrong or evil about joining two separate inventions in one patent; it is not against the law so long as the claims have been properly examined." 3.1 KAYTON & P. GARDNER, PATENT PRACTICE, 14.1 (7th ed 2001). Restriction practice: (1) facilitates administration in the PTO; and (2) allows the PTO to obtain additional filing and maintenance fee revenue that would be lost if an applicant were always permitted to obtain a patent covering any number of distinct inventions. Id. Importantly, "[t]he validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention." 35 USC s. 121.

The problem posed in this case is that when issuing the restriction, the Examiner referred to all claims, which implies that all claims, including the asserted claims, needed to be restricted. Clean Gun argues that because the restriction requirement referred to all claims, the applicant's response must be interpreted similarly to refer to all claims. Michaels disagrees, pointing to the limited nature of the applicant's response to the restriction requirement and the subsequent amendments to the patent. As discussed below, this court rejects Clean Gun's argument.

The applicant responded to the '589 Application restriction requirement by deleting device claims 42-45 and leaving the method claims unchanged. Other than the minor requirement that the applicant insert the term "tubular sheath" on method claim 56 (which is now claim 24), the Examiner did not require any other change to the method claims and allowed the '589 Patent to issue. Thus, despite the broad scope of the initial restriction requirement, the subsequent prosecution history reveals that the applicant did not in fact disclaim, and the Examiner did not in fact restrict, the method claims (claims 53-56, now claims 21-24). The only claims that were restricted, or amended, were the device claims (claims 29-52, now claims 1-20).

Nevertheless, Clean Gun interprets as fatal the applicant's acquiescence to the Examiner's statement that no claims were generic. However, Clean Gun improperly conflates method and generic claims, which are two separate and distinct types of claims.

A method claim may "read on," or encompass, more than one device. If a method can be practiced without the specific tools claimed or described in the specification, then the method claim is not limited to any particular device. *See, e.g., Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F3d 1339, 1349 (Fed Cir2000) (holding that the method claim was not limited to the specific tool described in the specification, even though the PTO issued a restriction requirement and the applicant narrowed the claims at issue to the method claim). In other words, a method claim is not necessarily limited to the specific apparatus device or embodiment in the patent specification. A method claim can be infringed by the practice of the method with a device claimed in the patent, described in the specification, or any other device. A determination of infringement of a method claim does not depend on the particular device used, but rather depends on the method practiced.

Although a method claim may apply to more than one device, it is not necessarily "generic." A "generic claim" is an entirely different concept in that it encompasses more than one species. "In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species." MANUAL OF PATENT EXAMINING PROCEDURE s. 806.04(d) (7th ed 2000) ("MPEP"). Moreover,

it is necessary that such a claim "read on" or encompass all the disclosed species or embodiments of the invention. However, this is not sufficient. For example, a claim to an element or subcombination will read on a number of different combinations, but such is not considered a generic claim.

4 CHISUM ON PATENTS s. 12.03[3][b] (1991) (footnotes and citations omitted).

In other words, generic claims must relate to a species of the same type of claim. Method claims and device claims are not the same species. Thus, if a *method* claim is generic, it relates to a number of species *methods*; a generic *method* claim does not relate to a number of species *devices*. Or using a biological analogy, a genus of mammals may include a number of mammal species, but not a number of reptile species.

Here, the method claims are clearly a different species than the device claims because they include additional material elements, such as dropping, pulling, scrubbing, and cleaning. As a result, they cannot be generic to the device claims. *See In re Bronson*, 168 F.2d 548, 550-51 (USPQ 1948) (holding that a claim for a process was not generic to an apparatus suitable for carrying out that process). The applicant's failure to take issue with the Examiner's statement that no claim was generic was appropriate because it was indisputable. The applicant simply elected Figures 10 and 10A for prosecution on the device claims and continued to prosecute the co-pending method claims as non-generic claims.

Even though the Examiner imposed a restriction requirement, he clearly never required a substantive change in any of the method claims and ultimately allowed the patents to issue with the method claims virtually unchanged. An Examiner is required under MPEP s. 2111 to give the claim language the "broadest

reasonable interpretation" before passing on the allowability of the requested language. If the requested language may be interpreted more broadly than the prior art permits, then the Examiner must require that the applicant amend or narrow the claim language. Had the Examiner determined that the co-pending method claims were limited to a single device, namely Figures 10 and 10A as contended by Clean Gun, then he would have required further amendment to reflect that explicit limitation. He did not do so even though the Examiner and applicant bantered the same four drawings back and forth numerous times.

Furthermore, if the Examiner intended to restrict both the device and method claims in one patent, then he was required to notify the applicant of one-way distinctiveness:

The mere fact that there are separate apparatus and method claims in the same application is not grounds for a restriction.... The PTO correctly recognizes these may be just two different ways of claiming the same invention. [U]nder the PTO guidelines for restricting claims covering an apparatus and method of using the apparatus, the examiner must show one way distinctiveness. That is, either the apparatus or method must be capable of being practiced without the other.... In addition, the examiner must give a reason why it would be a burden to examine both sets of claims ... If both criteria are met, then the examiner may issue a restriction requirement.

4 CHISUM ON PATENTS s. 12.03[3][d] (Supp 2001) (footnotes and citations omitted).

Here the Examiner gave no "reason why it would be a burden to examine both sets of claims," *id*, leading to the reasonable inference that despite his reference to all claims, he did not intend to restrict the co-pending method claims. Indeed, this inference is buttressed by the fact that the '125 Patent issued with nearly the same method claims and with the previously deleted device claims from the '589 Patent. If the method claims in the '589 Patent were restricted only to the device shown in Figures 10 and 10A, then the method claims should have been excluded from the '125 Patent which patents another device.

In sum, the applicant made no statements during the prosecution history narrowing the asserted claims. Instead, the prosecution history reveals only that the Examiner issued a restriction that forced the applicant to elect one species of device. This court is unwilling to conclude that a restriction requirement to elect one species of device automatically limits a co-pending method claim to the practice of the invention only with the elected device.

B. Disclaimers Within Specification

Clean Gun also argues that the specifications of the patents criticize shortcomings of prior art for gun barrel cleaning devices and touts specific features of the invention that eliminate or avoid these shortcomings. By so doing, Clean Gun contends that the patents disclaim claim constructions that do not require the touted features or that include certain criticized features.

1. Legal Standard

"The actual words of the claim are the controlling focus." *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F3d 1335, 1344 (Fed Cir1998), citing *Thermalloy, Inc. v. Aavid Eng'g, Inc.*, 121 F3d 691, 693 (Fed Cir1997). There is a "heavy presumption" that a claim term carries its "ordinary and customary meaning" and any party seeking to convince a court that a term has some other meaning "must, at the very least, point to a term or terms in the claim with which to draw...." *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F3d 985, 989 (Fed Cir1999) (internal quotations and citations omitted). This may be accomplished in two ways: (1) if "a different meaning is clearly and deliberately set forth in the intrinsic materials" of the patent; or (2) if use of "the ordinary and accustomed meaning ... would deprive the claim of clarity...." *K-2 Corp.*, 191 F3d at 1363. In making this assessment, the court should approach the issue using common sense and "the understanding of those of ordinary skill in the art" of the patent at issue, unless the patent history supplies

another meaning. Id at 1365; Digital Biometrics, 149 F3d at 1344.

"An accused infringer may overcome this 'heavy presumption' and narrow a claim term's ordinary meaning, but he cannot do so simply by pointing to the preferred embodiment or other structures or steps disclosed in the specification or prosecution history." CCS Fitness, Inc. v. Brunswick Corp., 288 F3d 1359, 1366 (Fed Cir2002), citing Johnson Worldwide, 175 F3d at 989-90; Burke, Inc. v. Bruno Indep. Living Aids, Inc., 183 F3d 1334, 1340 (Fed Cir1999). As clarified by the Federal Circuit:

[A] court may constrict the ordinary meaning of a claim term in at least one of four ways. First, the claim term will not receive its ordinary meaning if the patentee acted as his own lexicographer and clearly set forth a definition of the disputed claim term in either the specification or prosecution history.... Second, a claim term will not carry its ordinary meaning if the intrinsic evidence shows that the patentee distinguished that term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention.... Third ... a claim term also will not have its ordinary meaning if the term "chosen by the patentee so deprive[s] the claim of clarity" as to require resort to the other intrinsic evidence for a definite meaning.... Last, as a matter of statutory authority, a claim term will cover nothing more than the corresponding structure or step disclosed in the specification, as well as equivalents thereto, if the patentee phrased the claim in step- or means-plusfunction format.

CCS Fitness, Inc., 288 F3d at 1366-67 (internal citations omitted).

"[C]laims are always construed in light of the specification, of which they are a part." Network LLC v. Centraal Corp., 242 F3d 1347, 1352 (Fed Cir2001). "That claims are interpreted in light of the specification does not mean that everything expressed in the specification must be read into all the claims." SRI Int'l, 775 F.2d at 1121 (internal quotations and citation omitted). It is improper to import, or "read in" to a claim, a limitation from the specification's general discussion, embodiments, and examples. *See, e.g.* Enercon GmbH v. International Trade Comm'n, 151 F3d 1376, 1384 (Fed Cir1998), *cert denied*, 526 U.S. 1130 (1999) (noting that "[t]his court has repeatedly stated that while claims are to be construed in light of the specification, they are not necessarily limited by the specification."); Intel Corp. v. United States Int'l Trade Comm'n, 946 F.2d 821, 836 (Fed Cir1991) (internal quotation and citation omitted) (emphasis in original) (holding that "[w]here a specification does not *require* a limitation, that limitation should not be read from the specification into the claims."); Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1571 (Fed Cir1988) (citations omitted) (finding that "[a]lthough the specification may aid the court in interpreting the meaning of disputed language in the claims, particular embodiments and examples appearing in the specification will not generally be read into the claims.").

Still, "[c]laims are not interpreted in a vacuum." Slimfold Mfg. Co. v. Kinkead Indus., Inc., 810 F.2d 1113, 1116 (Fed Cir1987). "[T]he specification is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term." Vitronics, 90 F3d at 1582. Thus, it is improper to eliminate, ignore, or "read out" a claim limitation in order to extend a patent to subject matter disclosed, but not claimed. *See, e.g.*, Ethicon Endo-Surgery, Inc. v. United States Surgical Corp., 93 F3d 1572, 1582-83 (Fed Cir1996).

Moreover, claims cannot "enlarge what is patented beyond what the inventor has described as the invention." Network, LLC, 242 F3d at 1352. For example, when the patent specification describes the invention as including a feature, the claims should be construed to require that feature. *See, e.g.*, Watts v. XL Sys., Inc., 232 F3d 877, 883 (Fed Cir2000) (interpreting claims to require varying taper angles because specification stated that "the present invention utilizes [the varying taper angle] feature"). Similarly, when the specification criticizes or disclaims certain features in the prior art, the claims should not be read to encompass the criticized features. SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc., 242 F3d 1337, 1341 (Fed Cir2001) (finding that the criticism of one type of "lumen" in patent excluded that type from construction of the claim term).

Finally, claims should not be limited to the preferred embodiment. *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F3d 1146, 1158 (Fed Cir1997); *see also Amhil Enter., Ltd. v. Wawa, Inc.*, 81 F3d 1554, 1559 (Fed Cir1996) (holding that "[a] preferred embodiment ... is just that, and the scope of a patentee's claims is not necessarily or automatically limited to the preferred embodiment"). Instead, the court may consider the prosecution history of the patent, which includes the complete records of the proceedings before the PTO, including any re-examination proceedings, and any representations made by the applicant about the scope of the claims. *See Vitronics*, 90 F3d at 1582-83.

2. Analysis

The two asserted independent claims, claim 21 of the '589 Patent and claim 8 of the '125 Patent, both contain the same disputed terms and should be construed identically. Clean Gun urges the court to import "disclaimers" it contends the inventor asserted during prosecution of the patents. Accordingly, this court will carefully consider any specification where the applicant "distinguished [a] term from prior art on the basis of a particular embodiment, expressly disclaimed subject matter, or described a particular embodiment as important to the invention." *CCS Fitness, Inc.*, 288 F3d at 1366-67. The need for an express disclaimer necessarily eliminates nonlimiting language in the specification, such as "may then optionally apply," "preferred method," "can be accomplished," and "may be realized."

a. "A method for cleaning the inside of a gun barrel"

Michaels argues that the phrase "cleaning the inside of a gun barrel" has its ordinary meaning because this phrase appears as a preamble to the method claims and is without any limiting language. Michaels suggests that this phrase simply refers to a procedure further defined subsequently in the claim by the steps of "dropping," "pulling," "scrubbing," and "cleaning" as recited. *See* Col 5, lines 17-52; Col 9, line 51 to Col 10, line 11.FN13

FN13. As have both parties, this court cites to only the '589 Patent because the identical language appears in the '125 Patent.

Clean Gun counters that Michaels' broad interpretation is improper because the applicant made many distinctions in the specification between this and prior gun cleaning devices. Clean Gun suggests that a proper claim construction of this phrase is:

(1) removal of environmental debris from the barrel prior to and separate from the use of a bore brush; (2) distribution of cleaning solvent onto the inner surface of the barrel; (3) scrubbing the barrel with a brush; (4) absorbing solvent and picking up residues loosened by the brush; and (5) distributing a thin layer of light gun oil in the barrel.

See Col 3, lines 36-47; Col 3, line 64 to Col 4, line 8; Col 4, lines 30-33; Col 6, lines 48-63; Col 9, line 52 to Col 10, line 11.

Moreover, Clean Gun argues that this claimed method excludes the following structures and techniques expressly criticized and/or disclaimed by the applicant in the original application:

- (a) use of a sectional device that requires assembly and disassembly,
- (b) use of a cleaning section whose contact with the inner surface of the gun barrel is uneven,
- (c) use of a device with any exposed steel or hard metal parts that may possibly damage sensitive barrel

areas,

(d) use of a device with connections (e.g., crimped connections) on the device, and

(e) use of a long cleaning section that contacts the inner surface of the gun barrel along all or almost all of its surface.FN14

FN14. Clean Gun adds (f) to its argument, "use of device that does not have a section to remove environmental debris from the barrel prior to and separate from the use of a brush," but fails to include it in the Joint Claim Construction Brief. Inclusion of this section has no bearing on this court's analysis.

See Col 1, line 36 to Col 2, line 41; Col 2, line 62 to Col 3, line 63; Col 4, lines 9-25; Col 6, lines 58-63.

It is well-settled that "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation." *Rowe v. Dror*, 112 F3d 473, 478 (Fed Cir1997) (citations omitted). A preamble does not "disclaim," but may limit the scope of the claims. See, e.g., *STX, LLC v. Brine, Inc.*, 211 F3d 588, 591 (Fed Cir2000). The effect of limiting statements depends on whether certain "language is essential to particularly point out the invention defined by the claims." *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678 (Fed Cir1988). In other words, "[t]he preamble is not given the effect of a limitation unless it breathes life and meaning into the claim." MPEP s. 2111.02.

In this case, the phrase "a method for cleaning the inside of a gun barrel" merits its plain, ordinary meaning because it merely states a purpose or intended use. It is not necessary to breathe any life or meaning into the claim. Rather, it is the description which follows this preamble that limits the scope of the claim. While Michaels is correct that the specification does include some limitations on the claim, as discussed below, these suggested limitations do not attach to this general phrase. Accordingly, this court is unwilling to read into this preamble language any more than exactly what it states.

b. "Performs several functions in one pass"

Both parties agree that the phrase "in one pass" should be afforded its ordinary meaning but disagree as to what is its ordinary meaning. Michaels interprets the phrase to refer to the fact that several cleaning functions are performed in one pass, but are not limited to only a single pass. See Col 3, lines 64-67; Col 6, lines 47-57. In support of this proposed construction, Michaels turns to the specification which states:

[i]n gun barrels which are exceptionally dirty or which have a large accumulation of metal due to heavy use without cleaning, the user may need to perform a "see-saw" action with the gun cleaner. This is accomplished by pulling the cleaning device back and forth in short aggressive strokes while moving the device in an overall direction through the barrel. In effect, the use is performing a multitude of mid-bore directional changes while moving the device in a general direction through the barrel.

Col 10, lines 12-19.

Clean Gun interprets the phrase "in one pass" to require completion of all of the steps in one pass as the device is pulled once through the gun barrel from one end to another. For support, Clean Gun relies on the specification which criticizes prior art in devices that only include one type of cleaning implement (for example, a brush or a cloth), explaining that these prior devices require "time-consuming and complex" changes of attachments and multiple passes through the barrel with each implement. Col 1, lines 59-62; Col 3, lines 55-63. To remedy this perceived problem, the patent explains that "it is an object of the invention to provide a gun barrel cleaning device which performs several cleaning functions with one pass through the

barrel of a gun, thus saving the user a great deal of time and trouble." Col 3, lines 64-67. The patent continues by stating that these different cleaning functions are "accomplished" with one pass through the gun barrel. Col 3, line 67 to Col 4, line 8; *see also* Col 4, lines 30-33; Col 6, lines 48-63; Col 9, line 52 to Col 10, line 11.

This court disagrees with Clean Gun. The specification clearly requires that the cleaning of the inside surface of a gun barrel be completed in one pull through the gun barrel at a time. However, it also states that, if necessary, any "see-saw" action is acceptable because an "object of the invention is to provide a gun barrel cleaning device which eliminates the possibility of broken cleaning rod tips, broken cleaning rods, jammed cleaning utensils, or stuck patches, cloths or brushes by providing for foolproof mid-bore direction changes." Col 4, lines 12-16; *see also* Col 2, lines 30-32, 34-39; Col 3, lines 64-67; Col 5, lines 20-22, 53-58. An object of the invention is in the nature of a disclaimer and should be given greater weight than criticism of prior art upon which Clean Gun relies. The fact that the device may need to be pulled through more than once or used in a "see-saw" action to clean a particularly dirty gun barrel does not detract from its usefulness as one continuous pull-through device that both scrubs with a brush and cleans with a cleaning section. Accordingly, the phrase "in one pass" means performing several cleaning functions completed in one pull through the gun barrel with mid-bore directional changes permitted. Nothing in the specification requires the use of only a single pass.

c. "With a gun barrel cleaning device having a first end and a second end which comprises the steps of"

Michaels argues that the phrase "gun barrel cleaning device" has its ordinary meaning and refers to a flexible tool that has an end that is dropped into and pulled through a barrel to accomplish multiple cleaning functions in one pass. Michaels also argues that it does not require a fabric sheath that may be sectioned and capable of assembly and disassembly. Col 3, lines 64-67; Col 5, lines 17-52; Col 7, lines 45-57; Col 8, lines 33-36; Col 9, lines 10-14; Col 9, line 53 to Col 10, line 11; Fig. 4.

Clean Gun counters that this phrase requires a single, elongated, non-sectioned member, at least part of which is a tubular sheath. The device does not require assembly or disassembly and has no exposed fittings, connections, clamps, wires, push rod tips or other metal parts. *See* Figs. 10 and 10A; Col 1, line 36 to Col 2, line 41; Col 2, line 62 to Col 13, line 63; Col 4, lines 9-25, 30-44, 43-60; Col 5, lines 38-52; Col 5, line 56 to Col 6, line 2; Col 6, lines 58-63; Col 7, lines 46-57; Col 9, lines 14-40.

First, to support its proposed construction that the patents must eliminate assembly and disassembly, Clean Gun points to a criticism in the patent specification of gun cleaning devices that are sectional:

All cleaning devices in use today require assembly, changing of fittings, and/or changing of cloths or patches prior to and during their use. This is always an inconvenience and it can prove to be a detrimental disadvantage under tense circumstances, tight time constraints, bad visibility or severe environmental conditions.

Col 3, lines 55-58; *see also* Col 1, lines 60-62 (criticizing sectional devices that require assembly and disassembly as "time-consuming and complex to use").

Clean Gun's reliance on the patent's criticism of assembly and disassembly alone is not an express disclaimer and warrants no limitation. However, the patent also expresses that an "object of the invention is to provide a gun barrel cleaning device which eliminates assembly, disassembly, changing of parts, changing of patches, etc." Col 4, lines 22-25. In light of this objective, particularly when read with the criticism, this court concludes that the gun barrel cleaning device must be capable of cleaning the gun barrel as a single unit. It does not require any additional steps of taking sections apart and replacing various cleaning sections during the cleaning process.

This claim construction does not foreclose connecting sections. Rather, there is an advantage to having connections for assembly and disassembly prior to or after cleaning a gun barrel. For example, a user may want to eliminate certain cleaning steps or replace or clean certain cleaning segments. Thus, when in use, the gun barrel cleaning device must be connected as one unit to allow the user to clean a gun barrel in one pass, without any other cleaning steps which require assembly and disassembly. When the user is not cleaning a gun barrel, sections may freely be assembled or disassembled by using connectors.

This conclusion is supported by the patent's example of Figure 4. Figure 4 is the only figure in the patent showing a device with exterior metal couplings capable of assembly and disassembly. As discussed above, the restriction requirements on the '589 Patent do not limit the method claim to a particular device. The specification describes Figure 4 as a "second preferred embodiment." Col 9, lines 10-11. Figure 4 plainly has threaded connections which permit assembly and disassembly. Col 9, lines 10-13.

This conclusion is further supported by inconsistent specifications on exposed metal parts. At one place, the specification recites that an "object of the invention" is to provide a utensil that "is light weight, easily carried under field conditions, and which *reduces* or eliminates the metal parts typically used in a cleaning device." Col 4, lines 17-20 (emphasis added). To "reduce" is not the same as to "eliminate." Yet, at another place, the specification also states that an "object of the invention" is to "eliminate[] the possibility of metal to metal contact with the gun barrel itself." Col 4, lines 9-11. The specification also states that the method claims can be accomplished by all the various devices depicted in Figures 1, 4, 10, and 13. Col 9, line 52. Figure 4 shows a device with connectors and exposed metal parts. The function of protecting the gun barrel may be accomplished by aligning the brush "with the length of the gun barrel cleaning device" as required by the asserted claims. This prevents misalignment of metal parts which cause damage to the inside of the gun barrel.

As Clean Gun has demonstrated, it may be possible for metal connectors to nick the edge of the gun barrel when first being dropped into the gun barrel. However, the specification speaks to reducing or eliminating damage to the inside of the gun barrel during the cleaning process, not while inserting the device into the gun barrel. Accordingly, the phrase "gun barrel cleaning device" consists of a device that is designed such that there may be connecting metal parts (Fig.4), but the connectors cannot be readily exposed during the gun cleaning process.

Second, Clean Gun relies on language describing the brush enclosed in a tubular sheath as a way to eliminate metal-to-metal contact. Clean Gun believes that all of the device claims in the two asserted patents require the brush to be inside the sheath. The patent does detail a "preferred embodiment" of a brush inserted into a sheath so that only the soft bristles extend through the sheath. Col 9, lines 15-37. Additionally, the patent summarizes the beneficial results of this aspect of the invention: "The gun cleaning device can also be made such that no metal components (other than the intended industry standard, soft, phosphor-bronze bristles) can touch the inside surface of the gun barrel, which eliminates scratching, scarring, or uneven abrasion of the crown of the gun barrel, the riflings or other barrel metals." Col 6, lines 58-63.

As discussed above, this court is unwilling to read into its claim construction any nonlimiting language such as "preferred" or "can also." Additionally, Figure 4 does not have a tubular sheath. Accordingly, the gun barrel cleaning device is not limited to a tubular sheath.

d. "Connected to and aligned with the length of the gun barrel cleaning device"

Michaels argues that the phrase "connected to and aligned with the length of the gun barrel cleaning device" should be allowed its ordinary meaning and simply refers to a brush attached to the cleaning device, with its length in line with the rest of the cleaning device. There is no requirement that the brush be enclosed within a sheath. Col 5, lines 17-52; Col 9, lines 18-21; Col 9, line 66 to Col 10, line 5; Fig. 4, elements 14, 32, and

36; *see also* Fig 1 (elements 26 and 28 are connected to and aligned with sheath 12); Fig. 4 (elements 26 and 28 are connected to and aligned with the cable 30 via connectors 32, 34); Figs. 10 and 10A (elements 26, 28, and 48 are connected to and aligned with sheath 12).

In contrast, Clean Gun construes this phrase to mean that the brush must be encased within a length of the tubular sheath, instead of being connected to the device by hard metal parts exposed outside the sheath or by other twisted or crimped connections. Abstract; Figs. 5-10A; Col 2, line 62 to Col 3, line 1-25; Col 4, lines 30-33; Col 4, line 63 to Col 4, line 7; Col 5, lines 33-34; Col 6, lines 58-63; Col 7, line 67 to Col 8, line 13; Col 9, lines 14-40; prosecution history.

For the reasons discussed above, this court finds no reason to adopt Clean Gun's proposed construction. Accordingly, the phrase "connected to and aligned with the length of the gun barrel cleaning device" must be afforded its ordinary meaning, that is, the cleaning section is coupled to the pull cord and extends longitudinally in alignment with the rest of the gun barrel cleaning device.

e. "Cleaning section"

The parties agree that the phrase "cleaning section" has no "ordinary meaning" and must be viewed in light of the patent's specification to exclude structures that the inventor specifically disclaimed. In particular, the inventor disclaimed the use of cloth patches or rags. The parties agree that the term must be construed to exclude a cleaning section which utilizes a separate piece of cloth. They disagree, however, on the length limit and particular construction of the cleaning section.

Michaels asserts that the term "cleaning section" means a thickened integral compressible section attached to the gun barrel cleaning device sized and shaped to evenly contact and clean the inner surface of the gun barrel, and which is ready to use and does not require changing of cloths or patches to use. The phrase "cleaning section" includes foam compressible sections as shown in Figure 1 (elements 26 and 28 aligned with sheath 12) and Figure 4 (elements 26, and 28 detachably coupled to cable 30 via connectors 32 and 34). In another embodiment, the "cleaning section" comprises sections of a fabric sheath folded in on itself, which is shown in Figures 10 and 10A (elements 26, 28, and 48). Col 3, lines 55-61; Col 4, lines 22-25; Col 5, lines 7-9, 25-28, 37-38; Col 7, lines 48-50; Col 7, line 67 to Col 8, line 4; Col 9, lines 8-9; Col 10, lines 38-40. Michaels also asserts that there is no length limit, but the cleaning section cannot encompass the entire device.

Clean Gun proposes that a construction requiring that a short section of the gun barrel cleaning device have an increased diameter, such that the outer surface of the tubular sheath in the cleaning section is pressed firmly and evenly against the inside of the gun barrel as the device is pulled through the inside of the gun barrel, absorbing and removing debris from the inside of the gun barrel. The cleaning section is preceded and followed by sections of the gun cleaning device that have a smaller diameter than the cleaning section and do not press firmly against the inside of gun barrel. The cleaning section is a section of the sheath folded within itself and stitched and must be short in comparison to the gun barrel cleaning device. Abstract; Figs. 10 and 10A; Col 3, lines 24-35; Col 4, lines 30-33; Col 5, lines 7-10, 37-39; Col 6, lines 28-29, 58-63; Col 7, line 67 to Col 8, line 13; Col 9, lines 8-9; prosecution history.

In support of its construction, Clean Gun points to the patent's criticism of long cleaning sections that cause contact between most of the length of the device and the inner surface of the gun barrel:

Some cleaning devices utilize a cord which is pulled through the barrel, and drags a cloth patch, but which does not contain a metal brush feature. These pull-through devices are typically in the nature of a thick woven wick or rope-like cord. Such a wick or rope-like cord contacts the gun barrel along its entire surface. This requires that the resistance along the entire surface of the wick be a fairly low pressure against the inside of a gun barrel. A high pressure would make the wick impossible or difficult to pull through the gun

barrel.

Col 3, lines 26-35.

The patent's solution to this problem is explained in a preferred embodiment which uses relatively thin body portions and brush area, and short, relatively thick cleaning sections. Col 7, line 67 to Col 8, line 1-13; Figs. 10 and 10A. With only the short thick sections pressing against the barrel, the patent avoids the criticized problem of applying too much pressure along the entire length of the device. Thus, Clean Gun argues that the patent's cleaning sections were designed to avoid these problems by having short cleaning sections with a relatively larger diameter, but with the remaining portions of the device having a relatively smaller diameter. In this way, the patent's cleaning sections are able to wipe the inner surface of the barrel clean, but the remaining sections are thinner so that they pull more easily through the barrel. All of the figures of the patent, including the elected device in Figures 10 and 10A, disclose this characteristic for a cleaning section.

However, the patent discloses two different ways to make such a short, thickened cleaning section. One type, in the embodiments of Figures 1 and 4, uses a foam insert inside the tubular sheath. The patent's other cleaning section, shown in Figures 10 and 10A, is a thickened section created by folding a sheath within itself and stitching it. As discussed above, this court is unwilling to limit the method claims to Figures 10 and 10A.

Accordingly, the phrase "cleaning section" means a thickened integral compressible section attached to the gun barrel cleaning device sized and shaped to contact evenly when cleaning the inner surface of the gun barrel, and which is ready to use and does not require changing of cloths or patches to use. It has no length limit, but cannot encompass the entire device, and can include, but is not limited to, a fabric sheath folded in on itself.

f. "Oiling wick"

Lastly, the method of claim 23 requires, in addition to the steps in claim 21, the step of "applying a gun oil to an oiling wick attached to the gun barrel cleaning device for oiling the inside of the gun barrel." Michaels contends that the phrase "oiling wick" has its ordinary meaning and simply refers to a portion of the device that contacts the inside of the barrel to spread oil. It is not limited to a frayed end, but may be formed from a loop or fold of a fabric sheath. Col 7, lines 55-57.

Clean Gun argues that such an overly broad construction is not supported by the specification. Although the specification indicates that a gun barrel cleaning device might have a wick that is a frayless loop, it also states that the "oiling wick of the invention" is disclosed in Figure 3, which includes the folded sheath with a frayed end. Col 7, lines 13. In addition, the applicant elected Figures 10 and 10A which show a folded and stitched sheath with a frayed end.

Clean Gun ignores the fact that all of the drawings in the application, not just Figure 3, are referred to as preferred embodiments. Even with respect to Figure 3, the specification gives two options by stating that the oiling wick is either "folding in upon itself with its frayed end extending from the insertion," but "can also be formed from a loop or fold of tubular sheath." Col 7, lines 54-57. The specification also states that other structures may be used as an oiling wick, such as the end of the cleaning section as shown in Figure 4. Col 10, lines 21-26.

Since this court does not adopt the scope of the restriction requirement urged by Clean Gun, it must *ipso facto* reject Clean Gun's limited construction of "oiling wick." Accordingly, this court adopts the ordinary meaning of "oiling wick" to refer to a portion of the device that contacts the inside of the barrel to spread oil and may be formed from a loop or fold of a fabric sheath.

g. Other terms

The parties agree that the terms "dropping," "scrubbing," "brush," and "solvent" have their ordinary meanings and do not require construction by the court.

RECOMMENDATION

In light of the foregoing, the court's claim construction should be as follows:

I. '589 Patent

A. Claim 21

<i>CLAIM 21</i>	<i>COURT'S CONSTRUCTION</i>
<i>A method for cleaning the inside of a gun barrel</i>	preamble
<i>in one pass</i>	performing several cleaning functions completed in one pull through the gun barrel with mid-bore directional changes permitted, and not requiring the use of only a single pass.
<i>with a gun barrel cleaning device having a first end and a second end which comprises the steps of:</i>	a lightweight, non-rigid apparatus that is easy to carry, not limited to a tubular sheath that has an end that is dropped into and pulled through a gun barrel to accomplish multiple cleaning functions in one pass. It may be sectional and without a tubular sheath. It must eliminate the possibility of metal-to-metal contact with the gun barrel itself and eliminate assembly or disassembly during cleaning.
<i>connected to and aligned with the length of the gun barrel cleaning device, as the gun barrel cleaning device is pulled through the inside of the gun barrel, loosening debris from the inside of the gun barrel; and</i>	the cleaning section is attached to and coupled with the pull cord and extends longitudinally in alignment with the rest of the gun barrel cleaning device.

cleaning the inside surface of the gun barrel with
a *cleaning section*

a thickened integral compressible section
attached to the gun barrel cleaning device sized
and shaped to evenly contact and clean the inner
surface of the gun barrel, ready to use and
requires no changing of cloths or patches. It has
no length limit, but cannot encompass the entire
device, and may include, but is not limited to a
fabric sheath folded in on itself.

connected to and aligned with the length of the gun barrel cleaning device, as the gun barrel cleaning device is pulled through the inside of the gun barrel, absorbing and removing debris from the inside of the gun barrel.

See above.

B. Claim 22

<i>CLAIM 22</i>	<i>COURT'S CONSTRUCTION</i>
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The method for *cleaning the inside of a gun barrel in one pass* of claim 21 comprising the

See claim 21

additional step of	
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to the *cleaning section* for assisting the loosening of debris from the inside of the gun

See claim 21

barrel.	
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C. Claim 23

<i>CLAIM 23</i>	<i>COURT'S CONSTRUCTION</i>
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The method for *cleaning the inside of a gun barrel in one pass* of claim 21 comprising the

See claim 21

additional step of	
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Applying gun oil to an *oiling wick*

a portion of the device that contacts the inside of

the barrel to spread oil and may be formed from

	a loop or fold of a fabric sheath.
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Attached to the <i>gun barrel cleaning device</i> for oiling the inside of the gun barrel.	<i>See claim 21</i>
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II. '125 Patent

<i>CLAIM 8</i>	<i>COURT'S CONSTRUCTION</i>
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A method for <i>cleaning the inside of a gun</i>	<i>See claim 21</i>
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<i>barrel in one pass</i> with a <i>gun barrel cleaning device</i> having a first end and a second end which comprises the steps	<i>See claim 21</i>
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of: <i>cleaning device</i> into a first end of the <i>gun</i>	<i>See claim 21</i>
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<i>barrel;</i> Pulling the <i>gun barrel cleaning device</i> through the inside of the <i>gun barrel</i> by the first end of the	<i>See claim 21</i>
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<i>gun barrel cleaning device;</i> with a <i>brush</i> connected to and aligned with the length of the <i>gun barrel cleaning device;</i>	<i>See claim 21</i>
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and; <i>Cleaning</i> the inside surface of the <i>gun barrel</i> with a <i>cleaning section</i> connected to and aligned with the length of the <i>gun barrel</i>	<i>See claim 21</i>
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<i>cleaning device.</i>	
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SCHEDULING ORDER

Objections to the Findings and Recommendation, if any, are due July 29, 2002. If no objections are filed, then the Findings and Recommendation will be referred to a district court judge and go under advisement on that date.

If objections are filed, the response is due no later than August 15, 2002. When the response is due or filed, whichever date is earlier, the Findings and Recommendation will be referred to a district court judge and go under advisement.

D.Or.,2002.

Michaels of Oregon Co. v. Clean Gun, LLC.

Produced by Sans Paper, LLC.