United States District Court,
W.D. Wisconsin.

TRU-FIRE CORPORATION,
Plaintiff.
v.
TOMORROW'S RESOURCES UNLIMITED, INC,
Defendant.

No. 01-C-0619-C

Oct. 18, 2002.

Joseph A. Kromholz, for Plaintiff.

James R. Cole, Quarles & Brady, Madison, WI, for Defendant.

OPINION AND ORDER

CRABB**, J.**

This is a civil case in which plaintiff Tru-Fire Corporation contends that defendant Tomorrow's Resources Unlimited, Inc. has infringed plaintiff's U.S. Patent No. 5,357,939, which is directed to a "bow string release with continuous loop wrist strap and reversible trigger mechanism." Presently before the court are defendant's motion for clarification of the court's May 31, 2002 claim construction opinion and order; plaintiff's motion for summary judgment; defendant's motions for partial summary judgment of non-infringement and patent invalidity; and plaintiff's cross-motion for partial summary judgment that claims 15, 16 and 24 of the "9 patent are valid or, more correctly, are not invalid. I will consider defendant's motion for clarification of the May 31, 2002 claim construction opinion and order before taking up the parties' various summary judgment motions.

MOTION FOR CLARIFICATION

Although defendant terms its motion as one for "clarification" of the court's May 31, 2002 claim construction opinion and order, in fact defendant is asking the court to construe certain terms relating to the structural limitations of paragraph "c" of claim 15 that were not addressed in the May 31 order. Claim 15 describes a bow string release mechanism. Paragraph "c" reads as follows:

at least one of said sear elements being mounted for pivotal movement in said body, intermediately of said inner and outer ends, the sear elements further including an arcuate tab positioned adjacent the pivot point of one sear element and projecting outwardly from said one sear element toward the other sear element, said other sear element including a mated receptacle for receiving said tab.

Defendant asks the court to declare that 1) the claimed "arcuate tab" must be arched or curved in profile; 2) the term "mated receptacle for receiving said tab" means that the receptacle must have a profile that is arched or curved in a complementary manner and that the arcuate tab and mated receptacle must be in contact with each other along their mated arcuate surfaces; and 3) claim 15 does not require that each sear element have both an arcuate tab and a mated receptacle. In response, plaintiff maintains that defendant waived the opportunity to seek "clarification" of these issues because it did not raise them in its original claim construction briefs. A review of those briefs convinces me that defendant flagged these issues sufficiently during the initial round of claim construction to avoid waiver of its right to raise these issues at this time.

A. *Arcuate Tab*

Defendant argues that the plain meaning of "arcuate" is "arched or curved; bow shaped." I agree. *See McGraw-Hill Dictionary of Scientific and Technical Terms* 125 (5th ed.1994); *Webster's New World College Dictionary* 74 (4th ed.2001) (defining "arcuate" as "curved like a bow; arched"). Therefore, the claimed "arcuate tab" must be arched or curved like a bow. This definition is consistent with the patent specification. *See* North American Vaccine v. American Cyanamid Co., 7 F.3d 1571, 1576 (Fed.Cir.1993) ("When the meaning of a claim term is in doubt, we look to the specification for guidance."); SciMed Life Systems v. Advanced Cardiovascular Systems, Inc., 242 F.3d 1337, 1341 (Fed.Cir.2001) (one purpose for examining specification is to determine whether patentee limited scope of claims). All of the relevant figures in the "9 patent show tabs and receptacles that are distinctly semi-circular in design. This makes sense, given the "9 patent's teaching that the arcuate tabs are integral to the inventors' desire to "eliminate the need for separate spherical bearing elements used in many prior art configurations." "9 Pat. at col. 8, lines 61-63 (emphasis added). In response, plaintiff argues essentially that a structure of any configuration is arcuate if it has one or more arcuate surfaces, but such an interpretation is far too broad to be consistent with the patent specification. *See* North American Vaccine, 7 F.3d at 1577 ("A patent applicant cannot disclose and claim an invention narrowly and then, in the course of an infringement suit, argue effectively that the claims should be construed to cover that which is neither described nor enabled in the patent.").

B. *Mated Receptacle for Receiving Said Tab*

Defendant argues that the term "mated receptacle for receiving said tab" means that the receptacle receiving the arcuate tab must have a profile that is arched or curved in a more or less identical manner and that the surfaces of the arcuate tab and mated receptacle must necessarily contact each other along their mated arcuate surfaces. Defendant's argument hinges primarily on the definition of the term "mate." As defendant notes, "mate" is defined as "to put in close association: join closely together." Dft.'s Clarification Mem, dkt. # 39, at 6 (citing *Webster's Third New International Dictionary* at 1392); *see also Random House Dictionary of the English Language Unabridged* 1185 (2d ed.1987) (defining "mate" as "to join, fit, or associate suitably"). Defendant argues that this definition "confirms that the ordinary meaning of 'mated' requires some form of direct contact between the claimed tab and receptacle along their mated arcuate surfaces." (Emphasis in original). I disagree. To put an item "in close association" with another item does not suggest that the two items must actually come into contact. For instance, an airplane passenger flying coach is certainly "put in close association" with the passenger seated next to her, even though the two passengers may never make physical contact with one another. Moreover, to join items *closely* together emphasizes proximity rather than direct contact. I conclude that the use of the word "mated" does not require the patented invention's tabs and receptacles to come into direct contact and that the better definition of the phrase "mated receptacle for receiving said tab" is "a space provided to receive at least a portion of a tab."

C. *The Sear Elements Further Including an Arcuate Tab*

Defendant argues that claim 15 does *not* require that each sear element have both an arcuate tab and a mated receptacle. Plaintiff counters that claim 15 does require that each sear element have an arcuate tab, that the tab of each sear element project outwardly toward the other sear element and that each sear element have a mated receptacle for receiving the opposing tab. The relevant language appears in paragraph "c" of claim 15: "the sear elements further including an arcuate tab positioned adjacent the pivot point of one sear element and projecting outwardly from said one sear element toward the other sear element, said other sear element including a mated receptacle for receiving said tab." Although this language is not crystal clear, I am persuaded that plaintiff's proposed construction is correct. The relevant language of paragraph "c" refers to the sear elements, plural, as "including an arcuate tab." This suggests that both sear elements contain arcuate tabs and receptacles. Indeed, other portions of paragraph "c" confirm this understanding, as the patent drafters referred specifically to "at least one of said sear elements" when describing requirements that only one sear must meet. This interpretation is also consistent with the patent specification. *See* U.S. Pat. No. 5,357,939 at Fig. 9. Defendant argues that this interpretation of the relevant language conflicts with the doctrine of claim differentiation because claim 17, which depends from claim 15, requires "*a second arcuate tab* positioned adjacent the pivot point of one sear element and projecting outwardly from said other sear element toward said one sear element, said one sear element including a *second mated receptacle* for receiving said second tab." Dft.'s Clarification Mem., dkt. # 39, at 10 (emphasis in original). Defendant argues that claim 17 is thus indistinguishable from plaintiff's proposed interpretation of claim 15, but, as plaintiff points out, "[c]laim 17 of the "9 Patent is differentiated from claim 15 in that each sear element is required to have two arcuate tabs, and two receptacles." Plt.'s Br. in Opp. to Dft.'s Mot. for Partial Summ. J. of Invalidity, dkt. # 64, at 17-18 n. 4. In other words, claim 15 requires that each sear element have a tab and receptacle and claim 17 requires that each sear element have two tabs and two receptacles. Accordingly, I conclude that claim 15 requires that each sear element have an arcuate tab; that the tab of each sear element project outwardly toward the other sear element; and that each sear element have a mated receptacle for receiving the opposing tab.

MOTION FOR SUMMARY JUDGMENT

Presently pending before the court are plaintiff's motion for summary judgment that defendant's accused devices infringe claims 15, 16 and 24 of plaintiff's U.S. Patent No. 5,357,939 and defendant's motions for partial summary judgment of non-infringement and invalidity of claims 15, 16 and 24 of the "9 patent. Plaintiff has also cross moved for partial summary judgment that claims 15, 16 and 24 of the "9 patent are valid. Because I conclude that defendant's accused devices do not infringe claims 15, 16 and 24 of the "9 patent, either literally or by equivalence, plaintiff's motion for summary judgment of infringement will be denied and defendant's motion for partial summary judgment of non-infringement will be granted. Because there is no infringement, defendant's motion for partial summary judgment of invalidity will be dismissed as moot and plaintiff's motion for partial summary judgment that claims 15, 16 and 24 are valid will be denied.

Before laying out the parties' proposed facts and considering their arguments, a word on terminology is necessary. As will become clear, the term "arcuate tab" is critical in determining whether defendant's accused devices infringe the "9 patent. Plaintiff maintains that the accused devices have arcuate tabs and defendant maintains they do not. Therefore, in describing the accused devices in both their proposed findings of fact and their legal arguments, the parties use different names to refer to the same standard component of the accused devices. Employing the language of the "9 patent, plaintiff refers to the component as an "arcuate tab." Defendant refers to the same component as a "spring biasing lever." I explain this only to avoid confusion. Ultimately the varying terminology makes no difference for purposes

of infringement analysis.

From the facts proposed by the parties, I find the following facts to be material and undisputed.

A. *Undisputed Facts*

Plaintiff Tru-Fire Corporation is a Wisconsin corporation located in North Fond du Lac, Wisconsin. Plaintiff manufactures and sells bow hunting accessories, including bow string releases. Plaintiff is owner by assignment of U.S. Patent No. 5,357,939. Defendant Tomorrow's Resources Unlimited, Inc., is a Virginia corporation located in Madison Heights, Virginia. Defendant manufactures and sells bow hunting accessories including bow string releases, among other things. Plaintiff commenced this action on October 13, 2001, asserting infringement of the "9 patent.

Defendant has had actual knowledge of the "9 patent since at least January 1, 1996. The "9 patent relates to a bow string release used by archery enthusiasts to improve their accuracy and pulling ability. The release works by grasping the bow string and applying a pulling force to it, allowing the archer to release it at the desired time. Typically, the release is either hand-held or strapped to the archer's wrist and equipped with a trigger mechanism that permits the archer to activate a bowstring retaining and releasing mechanism. The "9 patent claims sear (or jaw) elements that include an arcuate tab and mated receptacle that allow the jaws of the patented device to be manufactured as a unit. The patent contains 24 claims. Plaintiff asserts claims 15, 16 and 24 of the "9 patent against defendant. Claim 15 of the "9 patent includes elements "a," "b" and "c". Paragraph "c" reads as follows:

c. at least one of said sear elements being mounted for pivotal movement in said body, intermediately of said inner and outer ends, the sear elements further including an arcuate tab positioned adjacent the pivot point of one sear element and projecting outwardly from said one sear element toward the other sear element, said other sear element including a mated receptacle for receiving said tab.

Claim 16 of the "9 patent claims:

The bow string release of claim 15, wherein each sear element is of a predetermined thickness and thickness dimension of the tab and the receptacle is less than half the thickness of the sear elements.

Claim 24 of the "9 patent claims:

The bow string release of claim 15, wherein both of said elongated sear elements is mounted for pivotal movement within the body.

Defendant manufactures and sells at least 31 different models of bow string releases fitted with the "standard caliper jaw" heads at issue in this case, including, at a minimum, the following release models: Hunter Glove, Hunter Rope, Hunter Velcro, Pro Hunter, 3-D Hinge Fire 2 Finger, 3-D Hinge Fire 3 Finger, 3-D Hinge Fire 4 Finger, 3-D Hinge Fire Pro TNT, 3-D Thumb Pull, T.R.U. Wild Thing, "X"-Terminator, The XTreme, Little XTreme, Pinky XTreme, Little Boss, Pinky Boss, Chappy Boss, King George, Pro Diamond, T-Handle Pinky, T-Handle Thumb, T.R.U. Accu-Touch, T.R.U. Tornado Glove, T.R.U. Tornado Velcro, T.R.U. Tornado Buckle, T.R.U. Deluxe Tornado Velcro, T.R.U. Deluxe Tornado Buckle, RackMaster Buckle, RackMaster Velcro, T.R.U. Stinger Velcro, T.R.U. Stinger Buckle and any other releases that have been discontinued or introduced, having jaws identical to the jaws of a release designated

by defendants as "TTBR."

All standard caliper jaw releases manufactured or sold by defendant are bow string releases that have a body and two elongated sear elements. The sear elements are identical and are both mounted in the body. The two elongated sear elements have an inner end within the body and an outer end extending beyond the body and a string retaining notch for receiving a bow string, the string retaining notches being adjacent the outer ends of the sear elements. All of defendant's standard caliper jaw releases have at least one of the two elongated sear elements mounted for pivotal movement in the release's body intermediately of the inner and outer ends of the sear elements. The outer ends of the sear elements are movable between an abutting or closed string retaining relationship and a separated or open string releasing relationship. All of defendant's standard caliper jaw releases have a trigger that is associated with the sear elements adjacent the inner end of the elements that is adapted for selectively engaging and locking the sear in the closed, string retaining position and for unlocking and releasing the sear in order to release the bow string. All of these releases have two elongated sear elements that have a predetermined thickness. Both the tab thickness and the receptacle thickness of defendant's standard caliper jaw releases are less than half the thickness of the sear elements.

The "9 patent describes "arcuate tabs" and "receptacles" on the sear elements. All of the relevant figures in the "9 patent show arcuate tabs and receptacles that are semicircular in design. At least one of the surfaces of the accused products' "arcuate tabs" (as plaintiff calls them) or "spring biasing levers" (as defendant calls them) has a .060" radius of curve. On the accused products, each tab or lever is positioned adjacent the pivot point of one sear element and projects outwardly from one sear element toward the other sear element. As the accused jaws are cut during manufacturing they develop very sharp edges. Defendant places the jaws in a machine that vibrates and tumbles the jaws with small pieces of ceramic to remove these sharp edges.

The two jaws in each of defendant's accused standard caliper releases have a biasing lever or tab that is integral with the jaw and is located approximately midway between the forward and rear ends of the jaw. When the jaws are assembled in the housing, the biasing lever of one jaw projects toward and overlaps with a cut-away space in the other jaw. One purpose of the biasing lever is to provide a rear-facing, lateral abutment surface for contacting engagement with a helical compression spring. Each jaw has a raised platform at its rear end and a longitudinal groove that extends from just behind the biasing lever to the rear end of the jaw, including the raised platform. The end of the helical compression spring opposite the biasing lever end is in contacting engagement with a steel ball or sphere. The "9 patent does not describe a similar ball. The ball is constrained to move within the grooves in the housing interior, as if on a track. The ball moves between a locking position, when it is between the opposed raised platforms, and a release position, when it is forward of the raised platforms. When the ball is positioned between the platforms, the jaws are locked in the closed position because the ball interferes with the jaws and prevents them from pivoting about their respective mounting pins to the open position. The jaws are normally in the closed or locked position. When the ball is positioned forward of the raised platforms, it no longer interferes with the jaws but still controls and coordinates the relative rotation of the jaws. When the trigger of a release is not being pulled or squeezed, the biasing force of the spring positions the ball between the opposed, raised platforms. When the trigger is pulled, the ball is pushed forward from between the opposed raised platforms, unlocking the jaws and allowing them to pivot to an open position. After the bow string is released and the arrow fired, the trigger is released to permit the spring to push the ball back, guided by the housing grooves, into position between the opposed raised platforms at the rear end of the jaws.

B. *Infringement*

Infringement analysis involves a two-step process. First, the court interprets the patent claims to determine their meaning and acope. Markman v. Westview Instruments, Inc., 52 F.3d 967, 967 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). Second, the properly construed claims are compared to the device accused of infringement. *Id*. The first step is a question of law and the second a question of fact. Johnson Worldwide Associates, Inc. v. Zebco Corp., 175 F.3d 985, 988 (Fed.Cir.1999). A device infringes a patent claim if it contains every limitation of that claim, either literally or by equivalence. *Id*.

1. ***Literal infringement***

"To establish literal infringement, every limitation set forth in a claim must be found in an accused product, exactly." Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1575 (Fed.Cir.1995); *see also* Allen Engineering Corp. v. Bartell Industries, Inc., 299 F.3d 1336, 1345 (Fed.Cir.2002) ("Literal infringement of a claim exists when each of the claim limitations 'reads on,' or in other words is found in, the accused device."). Plaintiff maintains that it is entitled to summary judgment of infringement because defendant's accused products infringe independent claim 15 of the "9 patent as well as claims 16 and 24, which depend from independent claim 15 and therefore include all the limitations of claim 15. In response, defendant has moved for partial summary judgment of non-infringement. Defendant does not dispute that paragraphs "a" and "b" of claim 15 read on the accused devices. Indeed, the parties are in agreement that the infringement analysis hinges entirely on paragraph "c" of claim 15. *See* Dft.'s Mem. in Supp. of Mot. for Partial Summ. J. of Non-Infringement, dkt. # 49, at 1; Plt.'s Br. in Opp'n to Dft.'s Mot. for Partial Summ. J. of Non-Infringement, dkt. # 62, at 1. Again, paragraph "c" reads as follows:

c. at least one of said sear elements being mounted for pivotal movement in said body, intermediately of said inner and outer ends, the sear elements further including an arcuate tab positioned adjacent the pivot point of one sear elementand projecting outwardly from said one sear element toward the other sear element, said other sear element including a mated receptacle for receiving said tab.

Moreover, with respect to paragraph "c," defendant does not dispute that the accused devices have at least one sear element mounted for pivotal movement in the bow string release body intermediately of the element's inner and outer ends or that the accused devices' tabs (or "spring biasing levers") project outwardly from one sear element toward the other sear element. However, defendant argues that paragraph "c" of claim 15 does not read on its accused devices for several reasons. Of most significance is defendant's argument that paragraph "c" calls for tabs that are genuinely arcuate in their entirety and that the accused products do not contain such tabs. As explained below, I agree with defendant that no reasonable fact finder could conclude that the accused devices have arcuate tabs. Therefore, I conclude the devices do not literally infringe claims 15, 16 and 24 of the "9 patent.

If the accused devices' sear elements, or jaws, do not have arcuate tabs, then there can be no literal infringement because one of claim 15's limitations requires "sear elements ... including an arcuate tab." Pictured below is the standard jaw that is incorporated in the accused devices.

TABULAR OR GRAPHIC MATERIAL SET AT THIS POINT IS NOT DISPLAYABLE
The arrow indicates what plaintiff maintains is an arcuate tab and what defendant refers to as a non-arcuate spring biasing lever. The question is whether this portion of the jaw can fairly be described as "arcuate."

As I determined earlier in addressing defendant's motion for clarification, "arcuate" means arched or curved

like a bow. *See McGraw-Hill Dictionary of Scientific and Technical Terms* 125 (5th ed.1994); *Webster's New World College Dictionary* 74 (4th ed.2001) (defining "arcuate" as "curved like a bow; arched"). Plaintiff does not maintain that the tab in question is arcuate as a whole. Rather, as indicated in the following figure taken from plaintiff's infringement summary judgment brief, plaintiff points to five surfaces on the pictured tab that are curved or rounded to a greater or lesser degree and argues that these five distinct curves make the tab arcuate.

TABULAR OR GRAPHIC MATERIAL SET AT THIS POINT IS NOT DISPLAYABLE

In response, defendant contends that the adjective "arcuate" modifies the noun "tab," "indicating that the entire surface of the tab ... must be arched, not just one or more isolated edge portions found somewhere on the tab." Dft.'s Mem. in Opp'n to Plt.'s Mot. for Summ. J., dkt. # 57, at 11. Certainly the edges labeled two, three and four in plaintiff's diagram cannot make the tab in question arcuate. These are little more than beveled corners that have been smoothed by tumbling the jaws with pieces of ceramic in order to remove sharp edges created during the manufacturing process. As defendant points out, to conclude that the mere presence of beveled edges renders an otherwise linear structure arcuate would sap the term "arcuate" of any distinctive meaning. The portions of the accused tabs identified "1" and "5" in plaintiff's diagram have a more significantly curved profile. However, I am persuaded that the presence of such curved edges joining two flat surfaces is insufficient to render the tabs arcuate.

Plaintiff disputes this conclusion by contending that defendant is "essentially argu[ing] that it can add straight portions to an arcuate tab, and that the straight portions excuse the fact that the remainder[ ] of the tabs are arcuate." Rather, the opposite is true. Defendant's common-sense argument is that it can take the sharp angles off the corners of a generally linear tab by adding beveled edges and curved intersections without rendering the entire tab arcuate. Plaintiff chose to define the claimed structure as an "arcuate tab" rather than simply a "tab" or even a "tab incorporating one or more arcuate surfaces." Plaintiff cannot expand the scope of claim 15 by arguing that any otherwise linear structure containing beveled edges or isolated curves is an "arcuate tab." Such an expansive definition of "arcuate tab" would render nearly any hardware component with beveled or small radius edges "arcuate." A reasonable finder of fact could not conclude that the tabs or levers pictured above are curved like a bow. Indeed, the top portions of the levers are indisputably flat.

Finally, all of the relevant figures in the "9 patent show tabs and receptacles that are semi-circular in design and thus genuinely arcuate. This supports the conclusion that the term "arcuate" requires a structure that is substantially curved or bow shaped, if not entirely so. No reasonable jury could conclude that the accused devices contain "arcuate tabs." Therefore, the accused devices do not literally infringe claim 15 of the "9 patent. Because claims 16 and 24 depend from claim 15 and therefore contain all the limitations of claim 15, the accused products do not infringe those claims. *See* Wahpeton Canvas Co., Inc. v. Frontier, Inc., 870 F.2d 1546, 1552 n. 9 (Fed.Cir.1989) ("One who does not infringe an independent claim cannot infringe a claim dependent on ... that claim.").

A finding of literal infringement requires that every limitation set forth in a claim be found in an accused product. Southwall, 54 F.3d at 1575. Because I have determined that the "arcuate tab" limitation of claims 15, 16 and 24 does not read on defendant's accused products, I need not consider defendant's additional arguments for finding that the claims in issue do not read on those products.

2. *Doctrine of equivalents*

Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." Warner-Jenkinson Co. v. Hilton Davis Chemicals Co., 520 U.S. 17, 21, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). The doctrine requires plaintiff to demonstrate more than a broad, overall equivalence between an accused product and a patented invention. Rather, "[e]ach element contained in a patent claim is deemed material to defining the scope of a patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole." Id. at 29. "An element in the accused product is equivalent to a claim limitation if the differences between the two are 'insubstantial' to one of ordinary skill in the art. Insubstantiality may be [established by showing that] the accused device 'performs substantially the same function in substantially the same way to obtain the same result' as the claim limitation." Catalina Marketing Int'l v. Coolsavings.com, Inc., 289 F.3d 801, 812-13 (Fed.Cir.2002) (citations omitted).

The issue is whether the accused products' spring biasing levers perform substantially the same function as the arcuate tabs disclosed in the "9 patent. "The question of whether an explicit function has been identified with a claim limitation entails an examination of the claim and the explanation of it found in the written description of the patent." Vehicular Technologies Corp. v. Titan Wheel Int'l, Inc., 141 F.3d 1084, 1090 (Fed.Cir.1998). Plaintiff's patent's written description is instructive regarding the role played by the patent's arcuate tabs. The section of the patent devoted to summarizing the invention includes the following:

It is another feature of the subject-invention that the jaw mechanism has been reconfigured to permit elimination of the bearing element required between the pivotal jaws of the prior art. Specifically, an *integral arcuate bearing surface* is provided on one of the jaws and is adapted to be received in a mated arcuate bearing recess provided in the second jaw, assuring a smooth action of the jaw without requiring a separate bearing element.

"9 Pat. at col. 3, lines 48-56 (emphasis added). In addition, in the patent's description of the preferred embodiment, the applicant notes that the arcuate tabs and receptacles "eliminate the need for the separate spherical bearing elements used in many prior art configurations." *Id*. at col. 8, lines 61-63; *see also* col. 8, lines 55-57 (tabs and receptacles are "arcuate for providing a sliding bearing surface permitting the jaws to pivot open and closed"). When the claim language and the specification reveal that "a claim limitation must play a role in the context of the specific claim language, then an accused device which cannot play that role, or which plays a substantially different role, cannot infringe under the doctrine of equivalents." Vehicular Technologies, 141 F.3d at 1090. To demonstrate infringement, therefore, plaintiff must show that the patent's arcuate tabs and the accused devices' spring biasing levers perform similar roles in that they both allow the jaws of a release to pivot open and closed smoothly in the absence of an independent bearing element.

Plaintiff has provided no evidence that the accused products' spring biasing levers are capable of providing a sliding bearing surface allowing the products' jaws to pivot open and closed smoothly. *See* id. at 1091 (if accused structure is incapable of performing key function of claimed limitation, it "strongly suggest[s] that the ... structure is more than insubstantially different from the claimed" limitation). Instead, plaintiff argues that the claimed tabs and the accused biasing levers function identically to perform a different function: to align the jaws of the parties' bow string releases. However, the "doctrine of equivalents prevents an accused infringer from avoiding infringement by changing only minor or insubstantial details of a claimed invention while retaining their essential functionality." Sage Products, Inc. v. Devon Industries, Inc., 126 F.3d 1420, 1424 (Fed.Cir.1997). Plaintiff points to nothing in the relevant claims or the specification suggesting that the

functional essence of the "9 patent's arcuate tabs is to insure proper alignment of the jaws. Rather, the patent makes clear that the tabs are designed to replace a separate spherical bearing element while still providing a sliding bearing surface to insure smooth jaw action. Accordingly, even if I assume that the accused levers perform an alignment function, plaintiff has adduced no evidence that those levers perform the same essential function as the "9 patent's arcuate tabs.

Moreover, although the "9 patent repeatedly disclaims the use of the spherical bearing elements found in the prior art in favor of claim 15's ostensibly superior arcuate tabs, the accused releases all rely on a spherical bearing element to control the function of the release's jaws. An analytically similar case is Scimed, 242 F.3d at 1345, in which the Court of Appeals for the Federal Circuit considered whether the plaintiff's three patents for balloon dilation catheters were infringed under the doctrine of equivalents by a competitor's catheter. The court observed that the three patents' specifications each referred to prior art catheters, noted that these catheters used a certain "dual lumen" configuration and criticized that configuration on various grounds. The defendant's accused catheter used the dual lumen structure. According to the court of appeals, "[h]aving specifically identified, criticized, and disclaimed the dual lumen configuration, the patentee cannot now invoke the doctrine of equivalents to 'embrace a structure that was specifically excluded from the claims." ' *Id*. (citation omitted). Similarly, plaintiff identified and criticized "the bearing element required between the pivotal jaws of the prior art" and touted the virtues of the patent's arcuate tabs as a superior substitute. Plaintiff cannot now rely on the doctrine of equivalents to prove that defendant's releases infringe the "9 patent when they employ spherical bearing elements between pivotal jaws.

Although the question of equivalence is generally one of fact for the jury, where "the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment." Warner-Jenkinson, 520 U.S. at 39 n. 8. For the foregoing reasons, I conclude that no reasonable jury could find that the accused products' spring biasing levers perform substantially the same function as the arcuate tabs disclosed in the "9 patent. Defendant's motion for summary judgment of non-infringement will be granted.

MOTIONS FOR SUMMARY JUDGMENT OF PATENT "VALIDITY"

Defendant filed a motion for partial summary judgment of patent invalidity to which plaintiff responded with a cross motion for partial summary judgment that claims 15, 16 and 24 of the "9 patent are valid. Because plaintiff's motion for summary judgment of infringement will be denied and defendant's motion for partial summary judgment of non-infringement will be granted, defendant's motion for partial summary judgment of invalidity will be dismissed as moot. *See* Phonometrics, Inc. v. Northern Telecom Inc., 133 F.3d 1459, 1468 (Fed.Cir.1998) (district court "has discretion to dismiss a counterclaim alleging that a patent is invalid as moot where it finds no infringement"); Digital Privacy, Inc. v. RSA Security, Inc., 199 F.Supp.2d 457, 458 (E.D.Va.2002) (same).

Plaintiff's motion for partial summary judgment that claims 15, 16 and 24 are valid will be dismissed for two reasons. First, plaintiff did not submit proposed findings of fact in support of that motion in compliance with this court's "Procedures to be Followed on Motions for Summary Judgment," a copy of which was provided to the parties as part of the preliminary pretrial conference order. Second, and more important, because defendant's invalidity motion will be dismissed as moot, it would be improper to declare the "9 patent "valid." "There is never a need or occasion for ... a declaration [of patent validity]. Patents are born valid and remain so until proven otherwise." Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1555 (Fed.Cir.1985). Rather, courts either declare a patent invalid in response to a successful validity challenge

or hold that the party challenging validity failed to carry its burden. "A patent should not be declared 'valid' by a court because other challengers may be able to prove invalidity using different evidence." Durango Associates, Inc. v. Reflange, Inc., 843 F.2d 1349, 1356 n. 4 (Fed.Cir.1988). Accordingly, plaintiff's motion for partial summary judgment that claims 15, 16 and 24 are valid will be denied.

ORDER

IT IS ORDERED that

1. The term "arcuate tab" in claim 15 of U.S. Patent No. 5,357,939 is construed to mean a tab that is arched or curved like a bow;

2. The term "mated receptacle for receiving said tab" in claim 15 of U.S. Patent No. 5,357,939 is construed to mean "a space provided to receive at least a portion of a tab;"

3. Claim 15 of U.S. Patent No. 5,357,939 is construed to require that each sear element have an arcuate tab; that the tab of each sear element project outwardly toward the other sear element; and that each sear element have a mated receptacle for receiving the opposing tab;

4. Plaintiff Tru-Fire Corporation's motion for summary judgment that defendant Tomorrow's Resources Unlimited, Inc.'s accused devices infringe claims 15, 16 and 24 of U.S. Patent No. 5,357,939 is DENIED;

5. Defendant's motion for partial summary judgment that its accused devices do not infringe claims 15, 16 and 24 of U.S. Patent No. 5,357,939 is GRANTED;

6. Defendant's motion for partial summary judgment that claims 15, 16 and 24 of U.S. Patent No. 5,357,939 are invalid is DISMISSED as moot;

7. Plaintiff's motion for partial summary judgment that claims 15, 16 and 24 of U.S. Patent No. 5,357,939 are valid is DENIED; and

8. The clerk of court is directed to close this case.

W.D.Wis.,2002.
Tru-Fire Corp. v. Tomorrow's Resources Unlimited, Inc.