

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

BRIGGS & RILEY TRAVELWARE, LLC,
Plaintiff.

v.

PARAGON LUGGAGE, INC,
Defendant.

No. 01 Civ.3448 GEL

Dec. 13, 2002.

Owner of patent for expandable travel bag sued competitor for infringement. Construing claims, the District Court, Lynch, J., held that: (1) requirement that rigid plate be "separable from" frame member for movement to various positions "in juxtaposition" with frame member, meant only that plate had to be placeable near or close to frame member, and (2) function of fastening means was to removably secure rigid plate to frame member when plate was in second position.

Claims construed.

"Fastening means," called for in patent for expandable travel bag, had function of removably securing rigid plate to frame member when plate was in second position, and was limited to structures described in specification and their equivalents. 35 U.S.C.A. s. 112, para.6.

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OPINION AND ORDER

LYNCH, J.

On May 9, 2000, the Patent and Trademark Office issued United States Letters Patent No. 6,059,078 (" '078 Patent"), entitled "Expandable Bag with Stiffening Member," to Mainland Marketing, who subsequently assigned all of its intangible assets including patents to Briggs & Riley Travelware, LLC ("Briggs & Riley"). Briggs & Riley filed this patent infringement action on April 24, 2001, claiming that Paragon Luggage, Inc. ("Paragon") made and sold infringing travel bags. The parties having filed briefs and appeared for a *Markman* hearing on November 13, 2002, FN1 to discuss the disputed terms ("rigid plate," "separable from." "in juxtaposition," and "fastening means"), the action is now before the Court on claim construction.

FN1. All citations to "Tr." in this Order refer to the record of the November 13 proceeding.

"[A] patent must describe the exact scope of an invention and its manufacture," as defined by the claims. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 373, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). "[C]onstruction of a patent ... is exclusively within the province of the court." *Id.* at 372. The Court's purpose is to determine "what the words in the claim mean." *Id.* at 374. A simple patent action has two phases, "construing the patent and determining whether infringement occurred." *Id.* at 385. "The first is a question of law, to be determined by the court, construing the letters-patent, and the description of the invention and specification of claim annexed to them." *Id.* (internal citation omitted). It is to that task the Court now turns.

In undertaking claim construction, "[i]t is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history." *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). The Court should "look to the words of the claims themselves," giving them "their ordinary and customary meaning" unless the patent itself clearly provides otherwise. *Id.*; *see also* *Dow Chem. Co. v. Suminomo Chem. Co. Ltd.*, 257 F.3d 1364, 1372 (Fed.Cir.2001) (disputed terms are given "their ordinary and accustomed meaning as understood by one of ordinary skill in the art"). "[A] patentee is free to be his or her own lexicographer and thus may use terms in a manner contrary to or inconsistent with one or more of their ordinary meanings." *Vitronics*, 90 F.3d at 1582. Therefore, "it is always necessary to review the specification to determine whether the inventor used any terms in a manner inconsistent with their ordinary meaning. The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication." *Id.*

If intrinsic evidence resolves disputes over meaning, it is improper to look at extrinsic evidence. *Id.* at 1583-85. However, dictionaries hold a "special place" and even though they are extrinsic (and courts are cautioned against the use of non-specialized dictionaries for technical terms and against the use of dictionary definitions where they contradict any definition in the patent documents), dictionaries may be considered along with intrinsic evidence when determining ordinary meanings of claim terms. *Dow Chem. Co.*, 257 F.3d at 1372-73; *see also*, *Vitronics*, 90 F.3d at 1584. This is a sensible rule, since dictionaries are to some extent the repositories of the "ordinary and customary meanings" of words. and can document, confirm, supplement, or call into question a judge's own sense of the ordinary meanings of English words. This Order construes the disputed terms pursuant to these legal standards.

I. Background

The '078 Patent protects expandable travel bags that can be adjusted from a contracted to an expanded position, with a specific focus on retaining the stiffness between the stationary and movable portions of the bag when expanded. (*See, e.g.*, col. 1, lines 4-20.) It contains twenty-two claims, but for purpose of claim construction, the parties agree that the Court need only consider claim one. (Pl. Mem. at 4; Def. Reply Mem. at 1-2; Tr. at 1) The relevant language of that claim reads:

An expandable bag movable between a contracted position and an expanded position comprising a body enclosing a space, the body having top and bottom walls, front and rear walls and left and right walls, handle means mounted on the body, at least one of the top and bottom and left and right walls including first and second substantially rigid frame members movable toward and away from each other during

contraction and expansion of the bag, a *rigid plate* having first and second end portions and first fastening means for securing the first end portion of the plate to the first frame member, the second end portion of the plate being *separable from* the second frame member for the movement between a first position *in juxtaposition* with the second frame member when the bag is in the contracted position and a second spaced-apart position *in juxtaposition* with the second frame member when the bag is in the expanded position, and second *fastening means* for removably securing the second end portion of the plate to the second frame member when the plate is in the second position so that the plate provides a substantially rigid framework for the bag in the expanded position.

(Col. 7, lines 54-67, col. 8, lines 1-7 (emphasis added).) In briefs and at the *Markman* hearing, the parties debated the construction of "rigid plate," "separable from," "in juxtaposition," and "fastening means."

II. Disputed Terms

A. Rigid Plate

[1] An essential component of the Briggs & Riley patent is the "rigid plate" that provides the bag's "substantially rigid framework." Briggs & Riley argues that a "rigid plate" is "a rigid, smooth flat thin piece of material," (Pl. Mem. at 4, 9; Tr. at 8), and more specifically, as articulated in the specification with "a width approximately equal to the width of the walls ... when [the] suitcase ... is in its contracted position" (col. 3, lines 51-53) and with "a length less than the length of the walls" (col. 3, lines 53-54). Paragon advances a broader definition of "rigid plate" and would have the Court eschew all description beyond "rigid," leaving simply "a rigid piece of material." (Tr. at 13.) Paragon argues that as articulated in the specification, the '078 Patent "is broad enough to cover any substantially rigid plate member or strip member ... [that would] provide a rigid link between the frame members ... when the suitcase is so expanded." (Col. 7, lines 28-36; *see also* Def. Reply at 3.) Citing other descriptive words used in the specification for the "rigid plate" component, such as "stiffening member" and "strip member" (*see, e.g.*, col. 5, lines 50-51, 58), Paragon asks the Court to construe "rigid plate" as any rigid link. (Def. Reply at 4; Tr. at 10-11.)

The plain meaning of the words "rigid" and "plate" do not support Paragon's broad construction. The Oxford English Dictionary defines plate much as Briggs & Riley defines it, as "[a] flat, comparatively thin, usually rigid sheet, slice, leaf, or lamina of metal or other substance, of more or less uniform thickness and even surface." Oxford English Dictionary [hereinafter OED], *available at* <http://www.oed.com>. To accept Paragon's construction, the specification must show that the patentee intended to alter the ordinary meaning of "plate." Nothing in the specification suggests that "plate" should be given anything but its ordinary meaning. Neither the plate's purpose of providing a rigid link nor the alternative description of the plate as a "stiffening member" are inconsistent with the ordinary meaning of "plate." While the specification suggests that a "strip member" would also be covered by the Patent, even though a "strip" is generally "a narrow piece ... of approximately uniform breadth," OED *available at* <http://www.oed.com>, "strip member" is not clearly used in the specification to define "plate," but rather is presented as an alternative structure that could perform the plate's function. To the extent that the drafters were overly ambitious in suggesting in the specification that the '078 Patent could cover other shapes besides plate-like structures to provide the required rigid link, it is the "claims, not the specifications, that afford the measure of the grant to the patentee," *Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143, 145-46, 62 S.Ct. 969, 86 L.Ed. 1332 (1942), and the claim covers only a "rigid plate." Alternatives suggested in the specification do not broaden the ordinary and unambiguous meaning of the word "plate." Use of "strip member." while inconsistent, is, at most, presented as an alternative means of providing a rigid link, and comes nowhere near the required

standard of showing that the patentee intended an unconventional or original definition of "plate."

Accordingly, a "rigid plate" is a rigid, flat, comparatively thin piece of material of more or less uniform thickness and even surface with generally wide breadth. Whether a particular "stiffening member" or "strip member" would fit that description, or whether there is something novel about using a "plate" that was not anticipated in prior art, are questions of fact properly reserved for later proceedings on infringement.

B. Separable From and In Juxtaposition

[2] The '078 Patent provides that the "rigid plate" should be "separable from" the second frame member to allow the bag to move from its contracted to its expanded position. (Col. 7, lines 64-67.) Paragon argues that in order to be "separable from" the frame, the plate must be adjacent to the frame. (Def. Reply at 4.) The Court disagrees. Separation is relative, and given its plain meaning, "separable" does not imply attachment nor adjacency. Even if two components are not near each other, they can still be separated further and could be described as "separable." However, "separable from" must be read in context of the entire claim, which states that the plate must be "separable from" the frame between positions in which the plate is "in juxtaposition" with the frame. The real issue is not what "separable from" means but rather what "in juxtaposition" means.

Paragon points to language in the specification that describes the plate as "slidably overl[ying]" the frame members (col. 2, line 11), to figure 7 in the patent that shows plate 82 in relation to the frame members, and to the "side by side" language in dictionary definitions of juxtaposition, and argues that "in juxtaposition" should be read to mean "adjacent and parallel." (Def. Mem. at 6.) Briggs & Riley argues that "in juxtaposition" simply means near or close to, rather than adjacent. (Pl. Mem. at 12.) Paragon would have the Court narrow the ordinary meaning of juxtaposition, while Briggs & Riley generally supports the ordinary meaning.

The primary definition of "juxtaposition" is "the action of placing two or more things close together or side by side, or one thing with or beside another; the condition of being so placed." OED *available at* <http://www.oed.com>. Briggs & Riley is correct that generally stated "juxtaposition" simply means near. Paragon's narrower "adjacent and parallel" definition is not supported by the plain language, the claim, the specification, nor the prosecution history. Adjacent simply means "lying near or close (to); adjoining; continuous, bordering." OED *available at* <http://www.oed.com>. Briggs & Riley objects to "adjacent" to the extent that it implies contact. (*See, e.g.*, Pl. Mem. at 12 (objecting to a requirement of "immediately adjacent to or attached to").) However, the plain meaning of adjacent, while it does not preclude contact, does not require it. To the extent that "adjacent" is consistent with "juxtaposition," it is not objectionable.

The specification makes clear, however, that the plate need not be "parallel" to the frame (and indeed, ordinarily cannot be precisely parallel). The invention requires fastening means such as fastex buckles or velcro and describes how the plate "slidably overlies" these fasteners. (Col. 4, lines 11-40.) The presence of these fastening means between the plate and frame in the bag's contracted position would necessarily raise the plate at a slight angle. By the Patent's terms, the plate need only generally "extend in a plane perpendicular to the frame members." (Col. 3, lines 62-63.) Moreover, contrary to Paragon's suggestion, nothing in the prosecution history requires that the plate be parallel. The amendments made during the patent process to include "slidably overlies" and "in juxtaposition" were designed to distinguish the covered invention from an existing bag whose stiffening members pivoted into the bag's interior to lay flat in the bottom of the case. (Tr. at 28.) These amendments do not require that the plate be exactly parallel to

accomplish the intended improvement over prior art by allowing a user to expand the bag while packed with minimal disturbance to the bag's contents, but need only be secured so as not to pivot except slightly as described in the specification (col. 5, lines 4-10).

Accordingly, the intrinsic evidence dictates that "in juxtaposition" should be given its ordinary meaning of two or more things placed close together or near.

C. Fastening Means

[3] The parties agree that "fastening means" is a means-plus-function claim limitation, meaning that the claim refers to a "means" for performing a given function but does not specify the structure for performing that function in the claim. (Pl. Reply at 9; Def. Mem at 12.) In construing means-plus-function language, the Court must identify the claimed function, construe that function according to ordinary principles of claim construction (without improperly narrowing or limiting the function beyond the scope of the claim language), and determine the corresponding structure disclosed in the specification for performing the function. *See, e.g., Lockheed Martin Corp. v. Space Systems/Loral, Inc.*, 249 F.3d 1314, 1324-25 (Fed.Cir.2001.)

Both Briggs & Riley and Paragon identify the function of the "fastening means" as "removably securing the second end portion of the plate to the second frame member when the plate is in the second position." (Pl. Reply at 10; Def. Mem. at 14.) While Paragon construes that function as "to maintain the expanded bag rigid when in the upright position" (Def. Mem. at 15), this construction is too broad and more accurately describes the function of the "rigid plate." The claim states that "the plate provides a substantially rigid framework for the bag in the expanded position" (col. 8, lines 5-7), while the function of the "fastening means" is only to "removably secur[e]" the plate (col. 8, lines 3-4). There is no dispute about the means identified in the specification, which include hook and loop fabric fasteners, velcro, fastex buckles, and flexible webbing. (Pl. Reply at 11; Def. Mem. at 15.) Thus, the function of the "fastening means" described in the patent is simply to removably secure the second end portion of the plate to the second frame member when in the second position, and the structure for performing this function will include hook and loop fabric fasteners, velcro, fastex buckles, and flexible webbing, and equivalent means.

The remainder of the parties' disagreement as briefed and argued during the *Markman* hearing is not properly before the Court. The disagreement really concerns whether or not Paragon's plastic knobs infringe the claim because they perform the required function and are the equivalent of the means specified in the patent. These are questions of fact to be answered by fact-finders in the infringement phase of this action.

CONCLUSION

For the reasons stated above, the Court construes the disputed terms as follows. A "rigid plate" is a rigid, flat, comparatively thin piece of material of more or less uniform thickness and even surface with generally wide breadth. While "separable from" does not require that the objects be adjacent to each other, "in juxtaposition" requires that the plate and frame be near each other but need not be parallel. The "fastening means" described in the patent serve the function of removably securing the second end portion of the plate to the second frame member when in the second position, a function that can be performed by hook and loop fabric fasteners, velcro, fastex buckles, flexible webbing, and their equivalents.

SO ORDERED.

S.D.N.Y.,2002.

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