

United States District Court,
N.D. Ohio, Eastern Division.

AVERY DENNISON CORPORATION,
Plaintiff.

v.

WHITLAM LABEL CO., INC,
Defendant.

Sept. 24, 2003.

Jay R. Campbell, Todd R. Tucker, Mark C. Johnson, Renner, Otto, Boisselle & Sklar, Cleveland, OH, for Plaintiff.

Ernest I. Gifford, Mark D. Schneider, Gifford Krass Groh Sprinkle Anderson, Birmingham, MI, Thomas A. Meehan, Emch Schaffer Schaub & Porcello, Toledo, OH, for Defendant.

MEMORANDUM OF OPINION AND ORDER

PAUL R. MATIA, Chief Judge.

Plaintiff, Avery Dennison Corporation brings this action against defendant Whitlam Label Co., for infringement of its patents covering "Thermal Transfer Laminates", designated as U.S. Patent. Nos. 6,228,486 and 6,461,722 (the '486' and '722' patents respectively). The parties dispute the meanings of several terms used in the patents-at-issue. Accordingly, the Court held a hearing on August 27, 2003, pursuant to *Markman v. Westview Instruments*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), to determine the meaning of the patents' claims as a matter of law.

Prior to this hearing, the parties highlighted the agreed upon and disputed terms of the patents in their joint claims construction brief (Doc. 29). Both parties have also filed briefs supporting their preferred definitions of the terms at issue (Docs. 31, 32, and 34). The Court has considered the arguments presented in these filings, and sets forth its analysis below. The following table summarizes the Court's findings.

CLAIM CONSTRUCTIONS FOR THE CLAIMS OF THE '486 AND '722 PATENTS

Claim	Disputed Term	Construction
1 and 24 ('486) 1 and 17 ('722)	Adhesion-promoting layer	A layer that increases the adhesion of coatings to a film substrate including radiation-curable, solvent-based, or water-based primers.
1 and 24 ('486) 17 ('722)	Heat-activatable adhesive layer	An adhesive or thermoplastic film generally having a lower melting point than the other layers of the laminate.
1 and 24 ('486) 1 and 17 ('722)	Abrasion resistant transparent coating layer	Any transparent coating material designed to provide abrasion resistance.

Claim	Disputed Term	Construction
2 ('486) 18 ('722)	Carrier Sheet	A paper, polymer film, or combination thereof upon which a number of additional layers of a laminate are at least temporarily disposed.
1, 20, and 24 ('486) 18 and 34 ('722)	Another adhesive layer	any other adhesive layer
6 and 14 ('486) 2, 10, 20, and 28 ('722)	Corona treated	The discharge of a high voltage field onto a surface to raise the surface energy of the surface treated.
5 ('486) 1 ('722)	Substrate	A material suitable for receiving a thermal transfer laminate such as a seatbelt or automotive visor.

Claim	Disputed Term	Construction
20 ('486) 34 ('722)	Removable pressure-sensitive adhesive material	An adhesive that can stick to a layer, yet is removable.
20 ('486) 34 ('722)	Radiation-cured adhesive material	An adhesive cured by radiation such as ultra-violet radiation

I. LEGAL STANDARDS FOR CLAIMS CONSTRUCTION

The determination of the construction of a patent is the first step in any infringement action, and it is an issue for the Court to decide as a matter of law. *Markman v. Westview Instruments*, 52 F.3d 967, 976. It is the responsibility of the trial court to construe as a matter of law the language of the patent, and "as such, a patent covers the invention or inventions which the court, in construing its provisions, decides that it describes and claims." *Id.*, at 979.

In determining the meaning of claims, the Court will look to three sources: the claims themselves, the specification, and the prosecution history. *Id.*, at 979 *citing* *Unique Concepts, Inc. v. Brown*, 939 F.2d 1558, 1561 (Fed.Cir.1991). Of these three sources the language of a claim is given the most weight in determining its meaning. The specification and prosecution history play a secondary role, thus "a construing court does not accord the specification, prosecution history and other relevant evidence the same weight as the claims themselves, but consults these sources to give the necessary context to the claim language." *Eastman Kodak Co. v. Goodyear Tire and Rubber Co.*, 114 F.3d 1547, 1552 (Fed.Cir.1997) *abrogated on other grounds by* *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454-55 (Fed.Cir.1998).

The language of a claim will be interpreted in light of its plain and ordinary meaning, unless the patentee has expressly stated otherwise. There is a "heavy presumption that claim terms carry their ordinary meaning as viewed by one of ordinary skill in the art." *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed.Cir.2003), *citing* *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed.Cir.2002). This presumption can be overcome in the case where a patentee specifically redefines a term used in a claim. When a patentee acts as his own lexicographer, "to specifically define terms of a claim contrary to their ordinary meaning, the written description in such a case must clearly redefine a claim term so as to put a reasonable competitor or one reasonably skilled in the art on notice that the patentee intended to so redefine that claim term." *Elekta Instrument S.A. v. O.U.R. Sci. Int'l, Inc.*, 214 F.3d 1302, 1307 (Fed.Cir.2000) (*quoting* *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357 (Fed.Cir.1999)).

In the case of a patentee-defined term, the specification of the patent must be consulted, and it is a general rule of construction that a claim should be read in light of its specification. *Vitronics Corp. v. Conceptronic*,

Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). Although the specification should be consulted, it cannot be used to limit the scope of a claim to any specific example or preferred embodiment. *See Ekchian v. Home Depot*, 104 F.3d 1299, 1303 (Fed.Cir.1997)("while examples disclosed in the preferred embodiment may aid in the proper interpretation of a claim term, the scope of the claim is not necessarily limited by such examples"); *Intervet America, Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053 (Fed.Cir.1989)("limitations appearing in the specification will not be read into claims, and ... interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper' ") (citation omitted).

A court may also look to the prosecution history of a patent to assist in construing its claims. *Markman*, 52 F.3d at 980. The prosecution history can and should be used to construe the claims, but it cannot enlarge, diminish or vary the limitations in the claims. *Id.* In this case, the prosecution history is very sparse, because the patents were allowed without amendment, and thus prosecution history does not help significantly in determining the meaning of the terms in dispute.

One final consideration in claim construction is the doctrine of claim differentiation. Claim differentiation is not a "hard and fast rule of construction," *Kraft Foods, Inc. v. International Trading Co.*, 203 F.3d 1362, 1369 (Fed.Cir.2000). It is a doctrine that presumes there is a difference in meaning and scope when different words or phrases are used in separate claims. *Unites States v. Telectronics, Inc.*, 857 F.2d 778, 783 (Fed.Cir.1988). A further presumption of this doctrine is that claims should not be construed so similarly as to make a claim superfluous. *Id.* at 784. Although it creates the presumption that each claim in a patent has a different scope, "it does not mean that every limitation must be distinguished from its counterpart in another claim, but only that at least one limitation must differ." *Kraft Foods*, 203 F.3d 1368.

With these doctrines of construction in mind the Court has analyzed the parties' proposed definitions. The proposed definitions will be addressed in three sections. First, the meaning of "adhesion promoting layer," which is the main point of contention between the parties. Second, those proposed definitions which sought to include limitations from examples contained in the specifications. Third, those definitions in which the parties essentially agreed as to the meaning, but differed on the exact wording of a definition.

II. CLAIM CONSTRUCTION

A. "Adhesion Promoting Layer"

Both the '486 and the '722 patents include the term "adhesion promoting layer" in the following context: "A thermal transfer laminate, comprising ... an adhesion-promoting layer overlying said upper surface of said first layer" ('486 Claim 1, '722 Claim 1).

The parties have proposed two divergent definitions of the term "adhesion promoting layer." Avery's proposed definition, presented at the claim construction hearing is: "A layer or treated layer, that increases the adhesion of coatings to a film substrate including radiation-curable, solvent-based, or water-based primers as well as a layer treated by corona treatments." In contrast, Whitlam suggests that an adhesion promoting layer should be defined as "a transparent layer of a radiation-curable, solvent-based, or water-based primer designed to increase the adhesion of coatings to a film substrate." The parties agree that layers of radiation-curable, solvent-based or water-based primers that act to increase the adhesion of coatings to a film substrate would qualify as an adhesion promoting layer. Therefore, the issue to be decided is whether a layer formed by corona treatment should also qualify as an adhesion promoting layer. This Court finds that it does not.

The Court looks first to the plain meaning of a term to seek its definition. *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363 (Fed.Cir.2003). Unless the patentee has specifically redefined a term, it will be defined according to the ordinary meaning as viewed by one of ordinary skill in the art. *Id.* In this case, the term has not been specifically redefined by the patentee, and therefore it will be given its ordinary meaning. The plain meaning of adhesion promoting layer, however, is ambiguous. Avery has suggested that corona treatment creates a layer of treated film, which increases adhesion, and therefore meets the criteria of a plain definition of adhesion promoting layer. Viewed in the context of other portions of the patents' claims and specifications, this argument fails.

Although the specifications of a patent are not afforded the same authority as the claim terms, they are helpful in determining the necessary context of the claim language. *Eastman Kodak Co. v. Goodyear Tire and Rubber Co.*, 114 F.3d 1547, 1552 (Fed.Cir.1997). The specifications of both patents indicate that corona treatment is not what Avery had in mind when it used the term adhesion promoting layer in the patent. The specification relating to the adhesion promoting layer from the '722 patent is as follows:

The adhesion promoting layers 130 and 135 may be made from any radiation-curable, solvent-based or water-based primer designed to increase the adhesion of coatings to a film substrate. The layer 130 is transparent and the layer 135 is preferably transparent. The adhesion promoting layer material is typically comprised of a lacquer and a diluent. The lacquer is typically comprised of one or more polyolefins, polyamides, polyesters, polyester copolymers, polyurethanes, polysulfones, polyvinylidene chloride, styrene-maleic anhydride copolymers, styrene-acrylonitrile copolymers, ionomers based on sodium or zinc salts of ethylene methacrylic acid, polymethyl methacrylates, acrylic polymers and copolymers, polycarbonates, polyacrylonitriles, ethylene-vinyl acetate copolymers, and mixtures of two or more thereof. Examples of the diluents that can be used include ethanol, isopropanol, butanol, ethyl acetate, propyl acetate, butyl acetate, toluene, xylene, acetone, methyl ethyl ketone, heptane, and mixtures thereof. The ratio of lacquer to diluent is dependent on the viscosity required for application of the adhesion-promoting layer, the selection of such viscosity being within the skill of the art. Examples of the adhesion-promoting layers that can be used include CLB04275F-Prokote Primer (a product of Sun Chemical Corporation identified as a solvent based primer useful with inks and coatings). The adhesion promoting layers 130 and 135 typically have thicknesses in the range of about 1 to about 4 microns, and in one embodiment about 2 microns.

Nowhere in this general description of the adhesion promoting layer is the use of corona treatment mentioned. Without interposing any specific limitations on the claims, this language from the specification contemplates a layer deposited on the surface of the substrate of a solvent-born polymer. It would have been possible, if Avery considered corona treating to be an adhesion promoting layer, for the specification to include language to that effect. Regardless of whether corona treating produces a layer of treated material for adhesion purposes, the general description of the invention envisions a separate, chemically different layer applied over the facestock as the adhesion promoting layer.

In addition to the language of the specification, the doctrine of claim differentiation also weighs against a finding that corona treatment should be considered a part of an adhesion promoting layer. The doctrine of claim differentiation creates a presumption that claims should not be construed so similarly as to make a claim superfluous. *United States v. Teletronics, Inc.*, 857 F.2d 778, 784 (Fed.Cir.1988). The adhesion promoting layer is first set forth in independent claim one of both patents. Following this independent claim, there are dependent claims that place limitations on it. In the '722 patent, dependent claim 2 states, "The composite of claim 1 wherein said upper surface of said first layer is corona treated." In the '486 patent,

dependent claim six puts the same limitation on independent claim one. If it is accepted that an adhesion promoting layer includes corona treating, then it is superfluous to include the dependent claims that specifically call for corona treating of the facestock. However, if adhesion promoting layer is construed not to include corona treating, then these dependent claims are reasonable limitations on the patent, and still foreclose a competitor from using a corona treatment on the upper surface of the facestock. This case is analogous to *RF Delaware Inc. v. Pacific Keystone Technologies, Inc.*, 326 F.3d 1255 (Fed.Cir.2003), which held it was error to import limitations from a narrower dependent claim into a broad independent claim. The use of corona treating is given in a dependent claim as a treatment to be applied to the facestock. It is inconsistent and superfluous to say that it should also be included in the definition of an adhesion promoting layer. For the forgoing reasons, the Court adopts the following definition of adhesion promoting layer: "A layer that increases the adhesion of coatings to a film substrate including radiation-curable, solvent-based, or water-based primers."

B. Proposed Definitions Seeking to Include Limitations From the Specification

1. Heat-Activatable Adhesive Layer

Avery's proposed definition of heat-activatable adhesive layer is: "An adhesive or thermoplastic film generally having a lower melting point than the other layers of the laminate." Whitlam proposed: "A layer of heat-activatable adhesive or thermoplastic film material with a thickness between 0.1 and 10.0 mils inclusive that may have a lower melting point than any other film layers in the thermal transfer laminate." The only real difference between the two definitions is the inclusion of the thickness limitations in Whitlam's definition. These limitations come directly from the specifications of the '486 and '722 patents. In column 3, line 14 of both patents, the general dimensions of the heat-activatable layer are given: "The thickness of heat activatable adhesive layers 118 and 230 range from about 0.1 to 10 mils." In this case the proposed definition includes a limitation from the specification, which the Federal Circuit has consistently held to be unacceptable. *See e.g. Intervet America, Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053 (Fed.Cir.1989)("limitations appearing in the specification will not be read into claims, and ... interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper' "). Therefore the Court adopts the following definition of heat-activatable adhesive layer: "An adhesive or thermoplastic film generally having a lower melting point than the other layers of the laminate."

2. Abrasion resistant transparent coating layer

An Abrasion resistant transparent coating layer according to Avery should be defined as: "Any coating material designed to provide abrasion resistance." Whitlam's definition was decidedly more complex: "A transparent layer of solvent-based, water-based or radiation curable coating material having a thickness between 1-4 microns inclusive that is designed to provide abrasion resistance." Whitlam's proposed limitations on the composition and thickness of the abrasion resistant transparent coating layer are taken directly from column 10, lines 9-29 of both patents, which state: "The abrasion resistant transparent coating layer may be made from any solvent-based, water-based, or radiation-curable coating material ... This coating layer typically has a thickness of about 1 to about 4 microns." Again, this is clearly an attempt to impermissibly include a limitation from the specification in the definition of a claim term. *See Ekchian v. Home Depot*, 104 F.3d 1299, 1303 (Fed.Cir.1997)("while examples disclosed in the preferred embodiment may aid in the proper interpretation of a claim term, the scope of the claim is not necessarily limited by such examples"). For this reason, the Court adopts the following definition of abrasion resistant transparent coating layer: "Any transparent coating material designed to provide abrasion resistance."

3. Carrier Sheet

Avery's proposed definition for the carrier sheet is: "A paper, polymer film, or combination thereof upon which a number of additional layers of a laminate are at least temporarily disposed." Whitlam proposed: "A paper, polymer film or combination sheet that is transparent and between 0.25 and 10.0 mils thick inclusive and is placed in contact with the 'another adhesive layer' to serve as a release liner." Whitlam's proposed limitations on thickness and transparency are taken verbatim from column 11, lines 31 through 67 of both patents. The relevant portions of these lines read: "The carrier sheet can be comprised of paper, polymer film, or a combination thereof ... It is preferred, however, that the carrier sheet be transparent, to permit visibility of the ink or graphics layer ... The carrier sheet typically has a thickness of about 0.25 to about 10 mils." Whitlam thus seeks to limit a claim by using the language of the specification, a practice which has consistently been found inappropriate. *See* RF Delaware, Inc. v. Pacific Keystone Technologies, Inc., 326 F.3d 1255, 1263 (Fed.Cir.2003)("When a claim is expressed in general descriptive words, it typically will not be limited to a numerical range that may appear in the written description as referring to a particular embodiment"). For this reason, the Court adopts the following definition of a carrier sheet: "A paper, polymer film, or combination thereof upon which a number of additional layers of a laminate are at least temporarily disposed."

4. Another Adhesive Layer

Avery's proposed definition of another adhesive layer is: "any other adhesive layer." Whitlam gave a substantially more complex definition for such a seemingly simple term: "A layer of a removable pressure-sensitive or radiation curable adhesive material, adherent to the 'carrier sheet,' having a thickness between 0.5 and 5.0 microns inclusive, suitable for coating a film substrate." Again, Whitlam's limitations are taken directly from the specifications of the patent. Column 10, line 30 of both patents addresses the composition of another adhesive layer: "adhesive layer 150 may be comprised of any removable pressure-sensitive or radiation curable adhesive." Column 11, line 9 states: "adhesive layer 150 has a thickness that is typically in the range of about 0.5 to about 5 microns." Whitlam's attempt to incorporate limitations from the specifications cannot be adopted. *See e.g.* Intervet America, Inc. v. Kee-Vet Laboratories, Inc., 887 F.2d 1050, 1053 (Fed.Cir.1989)("limitations appearing in the specification will not be read into claims, and ... interpreting what is meant by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper' "). Therefore the Court adopts the following definition of another adhesive layer: "any other adhesive layer".

5. Corona Treatment

The definition proposed by Avery for Corona treatment is: "The discharge of a high voltage field onto a surface to raise the surface energy of the surface treated." Whitlam proposed this definition: "The discharging of up to 10,000 volts of electricity from a ceramic electrode to a ground roll over which a film is passing to alter the surface of the film by raising the surface energy of a film (measured in terms of dyne level) to allow for enhanced printing." Whitlam's proposed definition corresponds almost exactly with the discussion of Corona treatment in the specifications of the patents, column 3, lines 2-8 in both patents. This part of the specification states,

"Corona treating involves discharging up to about 10,000 volts of electricity from a ceramic electrode to a ground roll over which the film is passing. This high voltage field called 'corona' alters the surface of the film. Treating the surface of the film alters the surface energy of the film(measured in terms of dyne level)

and allows for enhanced printing."

This definition would limit the voltage, electrode type, and purpose of Corona treatment as used in this patent. As in the preceding four definitions it is an impermissible attempt to limit a claim by language in the specification. *See e.g.* Intervet America, Inc. v. Kee-Vet Laboratories, Inc., 887 F.2d 1050, 1053 (Fed.Cir.1989). As such, the Court adopts the following definition of Corona treatment: "The discharge of a high voltage field onto a surface to raise the surface energy of the surface treated."

Proposed Definitions In Which Parties Agree As To Meaning, But Differ As To Wording

1. Substrate

The parties essentially agree that a substrate is a material suitable for receiving a thermal transfer laminate. Avery's proposed definition states: "A material suitable for receiving a thermal transfer laminate such as a seatbelt or automotive visor." Whitlam's definition states: "a layer of base material suitable for receiving a thermal transfer laminate that may be made of: metal, plastic, leather, paper, or the like; a woven or non-woven fabric made of natural or synthetic materials. A substrate may comprise an automotive interior surface such as the surface of a seatbelt, visor, dashboard, headrest, seat-back, door panel, etc." Both of these definitions convey the same message, but Whitlam's is excessively verbose. Given the Court's charge to construe claim terms according to their ordinary meanings, *See Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed.Cir.2003), this court finds that an exhaustive list of the types of substrates used is not necessary to convey the ordinary meaning of the term substrate. Therefore, this Court adopts the following definition of substrate: "A material suitable for receiving a thermal transfer laminate, such as a seatbelt or automotive visor."

2. Removable Pressure-Sensitive Adhesive Material

The parties agree that a removable pressure-sensitive adhesive material must be able to stick to a layer but also be removable. Avery succinctly defines this material as: "An adhesive that can stick to a layer, yet is removable." Whitlam would define this material as: "An adhesive that can stick to an underlying layer and be removed without damaging the underlying or a carrier sheet upon which the adhesive is adhered." Claims must be interpreted according to their ordinary meaning. Viewed in this light, a removable-pressure sensitive adhesive must be just that, an adhesive that is also removable, but the definition doesn't extend to any effect that adhesive might have on appurtenant surfaces. For this reason, the Court adopts the following definition of removable pressure-sensitive adhesive layer: "An adhesive that can stick to a layer, yet is removable."

3. Radiation-Cured Adhesive Material

The parties agree that a radiation cured adhesive material is an adhesive cured by radiation, especially ultraviolet radiation. The only difference in the two proposed definitions is Whitlam's attempt to define this material as transparent. The plain meaning of the term, which the Court is required to adopt, is an adhesive cured by radiation. Nothing from that phrase can be used to infer whether this layer is transparent or opaque. The plain meaning of this term, which the Court adopts is: "An adhesive cured by radiation such as ultraviolet radiation."

CONCLUSION

For the reasons stated above, the Court adopts the constructions for the '486 and '722 patents summarized in the table on pages 2 through 4 of this opinion. Having construed the claims, the next step in this litigation is to determine infringement. The parties are hereby reminded that dispositive motions, if any are to be filed in this case, are due on or before *December 15, 2003*. The provisions of the Case Management Plan (Doc. 7) are to be complied with by the parties and lead counsel of record.

IT IS SO ORDERED.

N.D.Ohio,2003.

Avery Dennison Corp. v. Whitlam Label Co., Inc.

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