

United States District Court,
C.D. California.

PONICA INDUSTRIES CORPORATION,

v.

WESTVACO CORPORATION.

Nos. ED CV 02-1218 RT (SGLx), ED CV 03-842 RT (SGLx)

Sept. 3, 2004.

Proceedings Court's Construction of Certain Claims In U.S. Patent No. 5,788,068.

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CIVIL MINUTES-GENERAL

ROBERT J. TIMLIN, Judge.

The court, Judge Robert J. Timlin, has read and considered plaintiffs/counter-defendants Ponica Industries Corporation ("Ponica"), Finest International Co, Ltd ("Finest"), and defendant/counter-claimant Westvaco Corporation a/k/a Meadwestvaco Corporation ("Westvaco")'s opening claim construction brief for construction of the patent m suit, U S Patent No 5,788,068 (the '068 patent"), each party's opposition to the opening claim construction briefs, and each party's reply brief to those oppositions

On July 9, 2004, the court presided over a hearing pursuant to Markman v. Westview Instruments, Inc., 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), *aff'g* 52 F.3d 967 (Fed.Cir.1995)(enbanc), concerning the proper construction of certain claims of the '068 patent The parties were represented at the hearing by counsel, and the court heard argument FN1 Based on consideration of the written briefs and supporting evidence, as well as counsel's argument, the court concludes as follows

I.

BACKGROUND

On December 11, 2000, Westvaco filed an action against Ponica and Finest for infringement of the '068 patent m the United States District Court, Southern District of New York, case no 00-9399 On November 2, 2002, Po ni ca and Finest filed an action in this court, case no ED CV 02-1218 ("Ponica action"), seeking declaratory judgment regarding the invalidity, non-infringement, and unenforceability of the '068 patent Westvaco's earlier patent infringement action was transferred to this court by the District Court in the

Southern District of New York on May 15, 2003 As case no ED CV 03-842 in this court, it was consolidated with the Ponica action for discovery purposes only

II.

APPLICABLE LAW

A. Markman Claim Construction

The construction of a patent claim is a matter of law for the Court *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996) To determine the meaning of a patent claim, the Court considers three sources the claims, the specification, and the prosecution history *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995) (en banc), *aff'd*, *Markman*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 *Markman*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577

First, the court looks at the words of the claims *Vitronics Corp. v. Conceptor, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996) "[T]he analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to particularly point out and distinctly claim the subject matter which the patentee regards as his invention " *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1201-2 (Fed.Cir.2002)(internal quotations and citations omitted) The Federal Circuit imposes a " heavy presumption that the claim term carries its ordinary and customary meaning " *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed.Cir.2002), *Nellcor Puritan Bennett, Inc. v. Masimo Corp.*, 300 F Supp 2d 923, 928 (C.D.Cal.2004) Dictionaries, encyclopedias, and treatises are "particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms" *Texas Digital*, 308 F.3d at 1202

Second, it is always necessary to review the specification to determine if the presumption of ordinary meaning is rebutted *Texas Digital*, 308 F.3d at 1204 The presumption is only rebutted in situations where "the inventor (1) acting as his own lexicographer, clearly set forth an 'explicit definition' of the term that is different from its ordinary mean in g, or (2) has disavowed or disclaimed scope of coverage by using words of 'manifest exclusion or restriction' " *Stephen Key Design. LLC v. Lego Systems, Inc.*, 261 F Supp 2d 1196, 1198 (N.D.Cal.2003), citing *Texas Digital*. 308 F.3d at 1204 However, "if the mean in g of the words themselves would not have been understood to persons of skill in the art to be limited only to the examples or embodiments described in the specification, reading the words in such a confined way would mandate the wrong result and would violate our proscription of not reading limitations from the specification into the claims" *Id*

Third, the court may consider the prosecution history of the patent, if in evidence *Vitronics*, 90 F.3d at 1582 "Although the prosecution history can and should be used to understand the language used in the claims, it too cannot enlarge, diminish, or vary the limitations in the claims" *Markman*, 52 F.3d at 980 (internal quotations and citations omitted)

Extrinsic evidence should be used only if needed to assist in determining the meaning or scope of technical terms in the claims, and may not be used to vary or contradict the terms of the claims *Stephen Key Design*, 261 F Supp 2d at 1198, *Markman*, 52 F.3d at 981, However, the court is free to consult reference materials, such as dictionaries, for assistance in determining the ordinary meaning of a claim term and such sources

are not considered extrinsic evidence Texas Digital Systems. 308 F.3d at 1202-03

Finally, "[t]he subjective intent of the inventor when he used a particular term is of little or no probative weight in determining the scope of a claim (except as documented in the prosecution history)" Markman, 52 F.3d at 985 (citation omitted) "Rather the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean" Id at 986

B Means-Plus-Function Construction

The United States Code, 35 U S C s. 112, para. 6 (" s. 112, para. 6") allows patent applicants to claim an element functionally, without reciting structures for performing those functions If a claim element contains the word "means" and recites a function, the court presumes that element is a means-plus-function element under s. 112, para. 6 *See Al- Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1318 (Fed.Cir.1999), *Envirco Corp. v. Clestra Cleanroom, Inc.*, 209 F.3d 1360, 1365 (Fed.Cir.2000) That presumption falls if the claim itself recites sufficient structure to perform the claimed

Construction of a means-plus-function limitation involves two steps *Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 296 F.3d 1106, 1113-14 (Fed.Cir.2002) The first step in construing a means-plus-function claim limitation is to define the function of the claim limitation *Golight, Inc. v. Wal-Mart Stores, Inc.*, 355 F.3d 1327, 1334 (Fed.Cir.2004), *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed.Cir.2001) The court must construe the function of a means-plus-function limitation to include only the limitations contained in the claim language *Cardiac Pacemakers, Inc.*, 296 F.3d at 1113 It is improper to narrow the scope of the function beyond the claim language, or to broaden the scope of the claimed function by ignoring clear limitations in the claim language *Id* Ordinary principles of claim construction govern interpretation of the claim language used to describe the function *Id*

The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function *Golight*, 355 F.3d at 1334 "Under this second step, 'structure disclosed in the specification is "corresponding" structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim' " *Med Instrumentation & Diagnostics Corp. v. Elekta AB.*, 344 F.3d 1205, 1210 (Fed.Cir.2003) This inquiry is undertaken from the perspective of a person of ordinary skill in the art *Atmel Corp. v. Info Storage Devices, Inc.*, 198 F.3d 1374, 1378-79 (Fed.Cir.1999)

III.

CLAIM CONSTRUCTION

Applying the applicable law as stated above, the court hereby construes as a matter of law the following terms and phrases in the claims for which claim construction is sought by the parties

A. Markman Claim Construction

- 1) The court concludes the phrase "base portion," as used in claims 1, 23, 27, and 28, has its ordinary and customary meaning
- 2) The court concludes the phrase "at least 2 inwardly extending radial arms," has its ordinary, and customary meaning

3) The court construes the phrase "disk engaging member," as used in claims 1 and 27, to mean

"a structure that engages with the disk and is formed by the inner ends of the arms and

receivable in the central hole of the disk" In construing this phrase, the court has not applied the means-plus-function test, because it concludes that this phrase does not fall within the ambit of s. 112, para. 6

4) The court construes the phrase "means for depressing at least the centre of a compact disk," as used in claims 1 and 27, to mean

"means for depressing at least the center of the disk comprising lips arranged to retain the disk by engaging on the outwardly surface of the disk"

In construing this phrase, the court has not applied the means-plus-function test, because it concludes that this phrase does not fall within the ambit of s. 112, para. 6

5) The court concludes the phrase "generally concave outer surface," has its ordinary and customary meaning

6) The court concludes the phrase "radially outward from centre of the base portion," has its ordinary and customary meaning

7) Pursuant to the agreement of the parties, the court construes phrase "integral plastics molding," as used in claim 20, to mean

"the base portion, disk-engaging member, radial arms and lips are formed as a one piece structure of plastic by molding"

B. Means-plus-Function Construction

1) The court construes the phrase "resilient ejection means," as used in claims 8 and 9, as follows

a The claimed function, as agreed upon by the parties

Claim 8 "to urge the disk out of out engagement with the disk-engaging member upon disengagement of the lips from the outwardly facing surface of the disk"

Claim 9 "(1) to urge the disk out of out engagement with the disk-engaging member upon disengagement of the lips from the outwardly facing surface of the disk, and (2) to resiliently support the disk away from the base when the disk is held by the disk-engaging member

b The court construes the following as the corresponding structure

"the arms 17 or 34, or one or more pieces of compressible material such as foam, and equivalents thereof"

2) The court construes the phrase "disk-engaging means," as used in claims 23 and 28, as follows

a The claimed function, as agreed upon by the parties

Claim 23 "for releasably engaging the central hole of the disk and supporting the centre of the disk away from the base portion"

Claim 28 "for releasably engaging the central hole of the disk"

b The court construes the following as the corresponding structure

"inwardly extending radial arms 15 or 32, including the button-like member 16 or 33, segments 20, and capping rim or lip 23 and equivalents thereof"

3) The court construes the phrase "disk support means," as used in claims 23 and 28, as follows

a The claimed function, as agreed upon by the parties "supporting the disk at positions away from the central hole"

b The court construes the following as the corresponding structure "disk support means 35, arms 17 or arms 34 and equivalents thereof"

4) a The *court* concludes the phrase "means for flexing," as used in claims 23 and 28, has its customary and ordinary meaning

b The court construes the following as the corresponding structure "the combination of the lips or runs disclosed in the '068 patent, the disk support means, and equivalents thereof"

FN1. The court also heard the sworn testimony of an expert witness, Jason Small However, the court's claim construction determinations were not influenced by said *testimony*

C.D.Cal.,2004.

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