

United States District Court,
District of Columbia.

INTEX RECREATION CORP,
Plaintiff.

v.

METALAST, S.A. Sociedad Unipersonal,
Defendant.

No. Civ.A. 01-1213(JDB)

May 20, 2005.

William Charles Casano, Greenstein, Delorme & Luchs, P.C., Washington, DC, David N. Makous, Thomas S. Kidde, Daniel C. DeCarlo, Lewis Brisbois Bisgaard & Smith LLP, Los Angeles, CA, for Plaintiff.

John E. Curtin, Fairfax, VA, Martin G. Raskin, Joshua L. Raskin, Steinberg & Raskin, PC, New York, NY, for Defendant.

MEMORANDUM OPINION

BATES, J.

This matter is before the Court on cross-motions for summary judgment regarding the alleged infringement of a patent on a ladder designed mainly for use in swimming pools. Plaintiff Intex Recreation Corp. ("Intex") moves for summary judgment that its accused ladder does not literally infringe on the patent. Defendant and counter-claimaint Metalast, S.A., Sociedad Unipersonal ("Metalast") moves for summary judgment that the Intex ladder design literally infringes on its patent or, alternatively, that the ladder design infringes under the doctrine of equivalents. Metalast also moves for summary judgment on the issue of patent validity under 35 U.S.C. s.s. 102(b) and 112.

BACKGROUND

Metalast, a Spanish corporation, is the owner of U.S. Patent No. 5,547,041 ("the '041 patent") directed to the means for attachment of the steps of a ladder to the vertical uprights. The object of the invention is to obtain a ladder at a reasonable price that is also easy to assemble by dispensing with the conventional assembly of the rungs to the uprights using screws and nuts. *See* '041 Patent Abstract (Metalast's Mot. for Summ. J., Ex. 1). A characteristic trait of the ladder includes, *inter alia*, tubular apertures near the ends of each rung defined by a sleeve for receiving the vertical uprights. *Id.*

During the selling seasons for the years 2000 and 2001, Intex sold a swimming pool ladder that Metalast asserts infringes this patent. In response to Metalast's assertions, Intex brought this action seeking a declaratory judgment pursuant to 28 U.S.C. s. 2201 that the '041 patent has not been infringed by Intex, and

that the '041 patent is invalid and unenforceable under the Patent Act, 35 U.S.C. s.s. 102(b) and 112. Metalast filed a counter-claim seeking a declaratory judgment that the accused ladders infringe the '041 patent under 35 U.S.C. s. 271, and that the '041 patent is valid and enforceable.

The issues of patent infringement and validity turn on the meaning of the phrase "uninterrupted inner surfaces"-a phrase used in Claim 1 of the '041 patent to describe the inner surfaces of the rung sleeves. FN1 The Court held a claim construction hearing on October 11, 2002, pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). The Court subsequently entered an Order stating that "the term 'uninterrupted inner surfaces' in the '041 patent shall be construed as meaning 'smooth' or 'uniform' inner surfaces." *Intex Recreation Corp. v. Metalast, S.A.*, 245 F.Supp.2d 65, 79 (D.D.C.2003). The Memorandum Opinion accompanying the Order explained in more detail that the Court, in reaching this interpretation, had rejected the interpretation of "uninterrupted" as a "unitary" one-piece rung sleeve-the competing interpretation advanced by Metalast-and instead concluded that Intex's interpretation focusing on the "smooth" or "uniform" character of the inner surfaces was more consistent with the claim language, context, drawings, dictionary definitions, and expert testimony. *Id.* at 71, 78-79. The Court stated throughout its opinion that an "uninterrupted" inner surface, thus defined by reference to the definitions of "smooth" or "uniform," was a surface "having no gaps, protrusions, or recesses." *Id.* at 71, 72, 73. The pending arguments on infringement and validity are presented in light of the Court's construction of Claim 1.

FN1. Claim 1 states in full that:
What is claimed is:

1. A ladder comprising two elongated and vertically extending, rigid uprights, each having at least one axially extending recess portion;
at least one rung extending horizontally between said two uprights and having apertures defined by sleeves having *uninterrupted inner surfaces* for receiving therethrough said rigid uprights; and
a means for securing said rungs to said uprights comprising an elongated split sleeve in coaxial alignment around one of said uprights, said split sleeve having a protrusion on an inner edge for engaging with said axially extending recess portion and wherein said sleeve of said rung slides over said split sleeve aligned on around said upright, to secure said rung in position along the length of said rigid upright.

'041 Patent, col. 2, lines 26-39 (emphasis added).

STANDARD OF REVIEW

Summary judgment is appropriate when the pleadings and the evidence demonstrate that "there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c). The party seeking summary judgment bears the initial responsibility of demonstrating the absence of a genuine dispute of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). The moving party may successfully support its motion by "informing the district court of the basis for its motion, and identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any,' which it believes demonstrate the absence of a genuine issue of material fact." *Id.* (quoting Fed.R.Civ.P. 56(c)).

In determining whether there exists a genuine issue of material fact sufficient to preclude summary judgment, the court must regard the non-movant's statements as true and accept all evidence and make all inferences in the non-movant's favor. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). A non-moving party, however, must establish more than the "mere existence of a scintilla of evidence" in support of its position. *Id.* at 252. By pointing to the absence of evidence proffered by the non-moving party, a moving party may succeed on summary judgment. *Celotex*, 477 U.S. at 322. "If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted." *Anderson*, 477 U.S. at 249-50 (internal citations omitted). Summary judgment is appropriate if the non-movant fails to offer "evidence on which the jury could reasonably find for the [non-movant]." *Id.* at 252.

DISCUSSION

A. Literal Infringement

Both parties seek summary judgment on the issue of literal infringement. "Literal infringement requires that each and every limitation set forth in a claim appear in an accused product." *V-Formation, Inc. v. Benetton Group Spa*, 401 F.3d 1307, 1312 (Fed.Cir.2005). The basis for Intex's claim of noninfringement is that its ladders do not have the claim limitation "sleeves having uninterrupted inner surfaces" because the rung sleeve contains a grooved recess (also referred to as a keyway) in order to receive a "key" from another component (the split sleeve) that prevents the uprights from rotating within the rung sleeve. *See Metalast's Mot.*, Exhibit 3 (physical sample of Intex ladder); *Metalast's Mot.*, Exhibit 5, INT0029 (illustration of Intex ladder indicating groove in rung sleeve at point A). *Metalast* counters that it is entitled to summary judgment on literal infringement because the inner surfaces of the rung sleeves are nonetheless "smooth" and "uniform"-and thus, "uninterrupted"-based on the aspect of the definition of "smooth" that focuses on the *texture* of a surface. It submits the two declarations of its expert in ladder design, Harold Stillman, who states that one skilled in the art of ladder design would attribute a meaning to "smooth" consistent with the first two definitions in the *American Heritage Dictionary*-that is, "having a surface free from irregularities, roughness or projections" or "having a fine texture." FN2 *See First Stillman Decl.* para. 13. In his opinion, the existence of the keyway does not result in an inner surface of the sleeve that is "not smooth (i.e., rough)" because the surface defining the keyway is part of the inner surface of the rung sleeve. In other words, because the inner surface of the keyway is smooth, and the inner surface of the rest of the rung sleeve is smooth, the entire inner surface of the rung sleeve is smooth. *Id.* para. 14. The keyway does not detract from the ease with which the uprights are able to slide through the rung sleeves-one of the functions described in Claim 1. *Id.* para. 15. Thus, in his opinion, "the inner surfaces of the Intex rung sleeves, including the portions defining the keyway, are smooth." *Id.* para. 16.

FN2. For ease of reference, the declarations are cited in this Opinion as the First Stillman Decl. (Attachment 1 to *Metalast's Mot. for Summ. J.* filed Oct. 18, 2004) and Second Stillman Decl. (Attachment 1 to *Metalast's Reply* filed Jan. 12, 2005). Intex moved to exclude the declarations on the ground that Stillman's recitation of dictionary definitions does not aid the trier of fact on the infringement issues and is contrary to the Court's claim construction opinion. Intex also argues that Stillman lacks the expertise to render opinions on patent validity under Section 112. The Court denied Intex's motion from the bench at the motions hearing, but stated that it would consider the objections in weighing the value of Stillman's testimony. Hearing Tr. at 3 (Apr. 15, 2005) ("Tr."). For example, Stillman's testimony is not instructive to the extent it is inconsistent with the Court's claim construction opinion, but is relevant to determining patent validity under Section 112 as to those elements for which the Court must consider the opinion of one skilled in the art, as discussed in Section C.

Intex moves for summary judgment on the ground that the presence of the grooved recess on the inner surface of the rung sleeve prevents the inner surface from being "smooth" or "uniform," as described in the Court's claim construction opinion. Intex argues that Metalast's expert focuses only on the definitions of "smooth" and "uniform" relating to the texture of the inner surface, and improperly ignores those aspects of the definition of "smooth" that would require the surface to be "free from irregularities" and "even throughout." According to its expert in ladder design, Jon Ver Halen, the grooves which run the length of the inner surfaces of the rung sleeves "interrupt" the surfaces, preventing them from being "smooth" or "uniform" throughout. *See* First Ver Halen Decl. para. 8-10.FN3 He cites those aspects of the Court's claim construction opinion which describe "uninterrupted inner surfaces" as being without "protrusions, gaps, or recesses." *Id.* In his opinion, it follows from that description that the grooved recess, or keyway, is necessarily an "interruption" of the inner surface. *Id.* para. 10. Metalast counters that Intex's argument should be rejected because interpreting "uniform" to mean "even throughout" would result in the irrational limitation that the claim covers only inner surfaces having an unvarying curvature-that is, "perfectly circular" apertures. Second Stillman Decl. para. 7-15.

FN3. The Court refers to three Ver Halen declarations in this opinion-two submitted in the course of the summary judgment briefing and one from the previous round of briefing on claim construction. For ease of reference, the declarations are cited in this Opinion as follows: First Ver Halen Decl. (Ex. 1 to Intex's Mot. for Summ. J. filed Nov. 15, 2004); Second Ver Halen Decl. (Ex. A to Intex's Reply Br. filed Jan. 31, 2005); and Ver Halen Claim Construction Decl. (Ex. F. to Intex's Opening Mem. filed Sept. 23, 2002).

It is apparent, then, that the parties still disagree over the construction the Court ascribed to the phrase "uninterrupted inner surfaces" in its claim construction opinion. That decision makes it abundantly clear, however, that the phrase means "smooth" or "uniform," which in turn means a surface that is "without gaps, protrusions, or recesses." Intex, 245 F.Supp.2d at 71, 72, 73. The discussions of the meaning of "smooth" or "uniform" stated, for example, that "[v]iewing the three words in isolation, an uninterrupted inner surface would appear to be one having *no gaps, splits, protrusions, ridges, or recesses-i.e., a surface that is smooth and uniform.*" *Id.* at 71 (emphasis added). Another passage compared related terms in the '041 patent: "[T]he sleeves in the rungs are differentiated from the split sleeves, which have gaps and protrusions, by the term 'uninterrupted inner surfaces,' *meaning without gaps, protrusions or recesses (i.e., smooth).*" *Id.* at 72 (emphasis added). Notwithstanding Metalast's position, nothing in the Court's earlier decision requires that an inner surface have an unvarying curvature yielding "perfectly circular" apertures. The meaning of "smooth" or "uniform" is focused not on perfect circles, but rather on a surface without protrusions, gaps, or recesses. Because the grooved keyway is, by definition, a "recess" in the inner surface, no reasonable trier of fact could conclude that the inner surface is literally "uninterrupted" consistent with the Court's claim construction opinion. The grooved recess "interrupts" the inner surface of the rung sleeve. FN4

FN4. Furthermore, the sudden and sharp nature of the groove-a groove cut into the surface at a near ninety degree angle-creates a "gap" in the surface as well as an uneven edge, which does not appear consistent even with Metalast's textural definition of smooth. *See* First Ver Halen Decl. para. 7; Second Ver Halen Decl. para. 8.

The Court notes that consideration of the inner surface forming the keyway separate and apart from the rest

of the inner surface, as Metalast urges, would mean that as long as each individual surface of a rung sleeve is smooth and even, a rung sleeve can have any number of protrusions and recesses (for example, a star shape, or a shape with 97 points and hundreds of inserted squares) and yet the inner surface of the rung sleeve would still be considered "uninterrupted." Metalast conceded this point at the motions hearing. Tr. at 20, 26. The Court is not persuaded that this position makes logical sense. Moreover, the law of the case is that an uninterrupted inner surface is one without such recesses—a meaning which comports with the dictionary definitions of "uninterrupted," "smooth," and "uniform." *Id.* No reasonable trier of fact could conclude that a surface with a grooved recess is "smooth" or "uniform." FN5

FN5. Metalast's approach to literal infringement relies heavily—indeed, almost exclusively—on the language in Claim 1 describing the function of the inner surfaces to be "for receiving therethrough said rigid uprights." The problem with this approach is that placing disproportionate weight on the language regarding receipt of the uprights gives too little recognition to the claim limitation for "uninterrupted inner surfaces."

Metalast attempts to persuade the Court otherwise by pointing to examples showing that the "smoothness" of a surface can be a matter of degree and thus the focus should be on individual surfaces rather than the presence of a recess. For example, if the aperture forming the rung sleeve were "slightly pear-shaped," instead of a circle with a sudden groove, the inner surface of the rung sleeve could more readily be described as "smooth," despite the slight change in shape that Intex would label a recess. *See* Metalast's Reply at 6-7. That, and similar examples proffered by Metalast, certainly demonstrate the limitations of language in describing the scope of a patent with precision, which is the very reason that the doctrine of equivalents was developed—to capture those cases where there is only a minor or insubstantial change in details, in recognition of the fact that "[t]he language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty." *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731, 122 S.Ct. 1831, 152 L.Ed.2d 944 (2002). FN6 Thus, the Court also examines in this case whether infringement occurred under the doctrine of equivalents (*see* Section B, *infra*). However, for the claim of *literal* infringement, the Court considers only whether the limitation, as set forth in the claim, is present in the accused product—not whether the design differs in some small degree that could be considered insubstantial. Here, that claim is for "uninterrupted inner surfaces," which the Court has construed as "smooth" or "uniform," which in turns means without a gap or recess. In light of the undisputed grooved recess in the inner surface of the Intex rung sleeve, the Court finds that there is no literal infringement.

FN6. As the Supreme Court noted, "the nature of language makes it impossible to capture the essence of a thing in a patent application," which fact has given rise to the doctrine of equivalents. *Festo*, 535 U.S. at 731.

B. Infringement under the Doctrine of Equivalents

Metalast also moves for summary judgment asserting that Intex's accused ladders infringe on the '041 patent under the doctrine of equivalents. Under this doctrine, a claim limitation not literally met may nonetheless be infringed upon by an element of the accused product based on equivalent identity of elements if the differences between the two are "insubstantial to one of ordinary skill in the art." *Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1351 (Fed.Cir.2003); *see Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 39-40, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). "Each element

contained in a patent claim is deemed material to defining the scope of the patented invention, and thus the doctrine of equivalents must be applied to individual elements of the claim, not to the invention as a whole." Warner-Jenkinson, 520 U.S. at 29. While no particular linguistic framework controls the inquiry (*id.* at 40), the "insubstantial differences" inquiry may be guided by determining "whether the element in the accused device performs substantially the same function in substantially the same way to obtain the same result as the claim limitation"-also referred to as the function-way-result test. Boehringer Ingelheim Vetmedica, 320 F.3d at 1351 (internal citations and quotations omitted).

Prosecution history estoppel, however, may preclude a patentee's assertion of the doctrine of equivalents. *Festo*, 535 U.S. at 727. Prosecution history is the public record of the patent proceedings. *Id.* Estoppel ensures that when the patentee responds to a PTO rejection of his application by narrowing his claims, the prosecution history will estop him from later arguing that the subject matter covered by the original broader claim was nothing more than an equivalent to the patented claim. *Id.* In other words, the patentee may not claim that the surrendered territory should be deemed equivalent to the literal claims of the issued patent. *Id.* at 733-34. Estoppel has been discussed most often in the context of amendments made to avoid prior art. *Id.* at 735. However, *any* narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel with respect to the amended claim limitation. *Id.* at 736.

The patentee bears the burden of establishing that an amendment was not made for reasons related to patentability. *Id.* at 739. "When the patentee is unable to explain the reason for amendment, estoppel not only applies but also 'bar[s] the application of the doctrine of equivalents as to that element.'" *Id.* at 740 (quoting Warner-Jenkinson, 520 U.S. at 33). The patentee also bears the burden of demonstrating that the amendment does not surrender the particular equivalent in question; in the absence of such a demonstration, a rebuttable presumption arises that estoppel bars a finding of equivalence. *Id.* at 740-41. In *Festo*, the Supreme Court explained that the presumption of estoppel is rebuttable because "[t]here are some cases ... where the amendment cannot reasonably be viewed as surrendering a particular equivalent," and described three such situations: "[1] The equivalent may have been unforeseeable at the time of the application; [2] the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or [3] there may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question." *Id.* Whether the patentee has rebutted the presumption of surrender is a question of law for the Court. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1367-68 (Fed.Cir.2003) ("*Festo II*").

Metalast seeks summary judgment on infringement under the doctrine of equivalents on the ground that the accused Intex ladder infringes under the "function-way-result" test. Metalast's motion is premised on the construction of "uninterrupted inner surfaces" as requiring inner surfaces with unvarying curvature and thus sleeves with perfectly circular apertures. Metalast Reply at 16 & n. 12. As a threshold matter, however, Metalast's premise is fundamentally flawed. As discussed above, nothing in this Court's claim construction opinion or in this opinion has expressed or implied a construction of Claim 1 as requiring "perfectly circular" apertures. The construction assigned to Claim 1 is and remains "smooth" or "uniform," which in turn is construed to mean "without protrusions, gaps, or recesses." Because Metalast's argument depends on an incorrect construction of Claim 1, it cannot demonstrate equivalence on this record.FN7

FN7. Intex further contends that it is not possible for Metalast to prove equivalence in light of the Court's construction of "uninterrupted inner surfaces" as without protrusions, gaps, or recesses. Intex's Mem. as to Doctrine of Equivalent at 2. That is, it would be antithetical to state that a surface with a recess is equivalent to an "uninterrupted inner surface" and thus would result in vitiation of the claim limitation. Although Intex

raises a significant issue-one that would be dispositive of Metalast's infringement claim-it would be inappropriate to resolve it without providing Metalast an opportunity to respond. This has not happened because of irregularities in the briefing, discussed above. Metalast has, in other contexts, discussed certain arguably de minimis recesses-such as a "slightly pear-shaped aperture"-that suggest the issue is not as simple as it may at first glance appear to be.

In any event, Metalast faces another significant hurdle in seeking summary judgment under the doctrine of equivalents-that of prosecution history estoppel. The prosecution history of the '041 patent shows that, in response to Metalast's U.S. patent application submitted on August 29, 1994,FN8 the patent examiner rejected the original versions of Claims 1 through 5 under 35 U.S.C. s. 102(b), as being anticipated by U.S. Patent 1,349,125 ("the Full patent"). See PTO letter dated Sept. 11, 1995 (Kidde Decl., Ex. A to Ex. 3, at M00666-67). Metalast then filed an amendment on December 13, 1995 claiming that new prosecution claims 6 through 10 (which became claims 1 through 5 in the issued '041 patent) were patentable over the Full patent, based on a number of distinctions, including rung "sleeves having uninterrupted inner surfaces," which it characterized as contributing, with the other aspects of its design, to simple construction, in contrast to the more complex construction of the Full ladder.FN9 Id. at M00674. It is undisputed that the narrowing amendment was undertaken to satisfy Section 102(b). Indeed, Metalast relied extensively on the prosecution history-and, in particular, changes it made to overcome the Full patent-during the claim construction phase of this litigation to support its interpretation of "uninterrupted inner surfaces" as meaning a unitary one-piece body. Intex, 245 F.Supp.2d at 75-78. Thus, a presumption of prosecution history estoppel applies to Metalast's assertion of the doctrine of equivalents.

FN8. The U.S. application claimed priority from a Spanish application filed on September 21, 1993. See Intex's Mot. for Summ. J., Thomas S. Kidde Decl. ("Kidde Decl."), Ex. A, at M00652.

FN9. Metalast's amendment explained the distinction as follows with regard to the rung sleeve and its inner surfaces:

[The] Applicants submit that the present invention is not anticipated by the Full patent....

The rungs in the Full patent are in the form of two plates 1 which are secured to the ropes or uprights by bolts 5. Each plate 1 has semi-circular recesses 2 in which clamps 8 are set, see col. 2 lines 73-77, which would not constitute the sleeve 9 defined by claim 1 of the present invention.

In the present invention, the rungs have apertures defined by sleeves 9 having uninterrupted inner surfaces for receiving therethrough rigid uprights. The sleeve 9 of the rung slides over the split sleeve 5, which is axially aligned around the rigid upright 1 and engaged by recess 3 and protrusion 8, so as to position the rung 2 along the length of the rigid upright 1.

In the Full patent, clamps 8 are provided with encircling grooves 9 and shoulders 10 for receiving the plates 1. In order to secure the plates 1 to the rope additional securing i.e. other than the groove 9, is required by way of bolts 5. See col. 2 line 98-103.

See Kidde Decl., Ex. A to Ex. 3, at M00673-74 (emphasis added).

Metalast implicitly acknowledges that the presumption of estoppel applies in its discussion of *Festo* as applied to this case. However, Metalast argues that it has rebutted the presumption under *Festo*'s second criterion-that is, the presumption of surrender of the equivalent does not apply where the rationale underlying the amendment bears "no more than a tangential relation to the equivalent in question." *Festo*,

535 U.S. at 740-41; *see also* Festo II, 344 F.3d at 1369 ("this [tangentialness] criterion asks whether the reason for the narrowing amendment was peripheral to, or not directly relevant, to the alleged equivalent"). Metalast characterizes the rationale for the "uninterrupted inner surfaces" amendment as distinguishing its rung sleeves based on "the fewer parts" involved, in contrast to the sleeves of the Full patent, which are formed from two separate inner surfaces that must be bolted together. In other words, the rationale for the underlying amendment was, in Metalast's view, to reduce the number of parts and eliminate the need for nuts and bolts to secure the rungs to the uprights, which bears no relation to the alleged equivalent here—a rung sleeve with a grooved recess.

Intex, on the other hand, asserts that prosecution history estoppel applies because Metalast amended the claim both to overcome the prior art—the Full patent—and to satisfy a requirement of the Patent Act (35 U.S.C. s. 102(b)). It argues that Metalast has failed to produce evidence rebutting the presumption that it has surrendered the equivalent it now seeks—that is, rung sleeves having inner surfaces with a recess. To determine whether the amendment is tangential to the equivalent in question, the Court must look at the prior art: "an amendment made to avoid prior art that contains the equivalent in question is not tangential; it is central to allowance of the claim." Festo II, 344 F.3d at 1369. Here, there is some evidence from which one could reasonably conclude that the prior art contains the equivalent in question, and hence estoppel would apply. The Full patent discloses a ladder design that has rung sleeves with inner surfaces interrupted by gaps. *See* Full Patent at M00687-88 (Ex. 21 to Metalast's Reply). A trier of fact could reasonably conclude that amendment of the '041 patent to claim rung sleeves with "uninterrupted inner surfaces"—defined as smooth or uniform, without protrusions, gaps, or recesses—thereby resulted in Metalast surrendering a claim on rung sleeves that are interrupted by gaps or recesses, including the kind in the accused Intex ladder.

A more significant problem with Metalast's position may be that it essentially relies on a characterization of the prosecution history as showing that the "uninterrupted inner surfaces" amendment was for the purpose of claiming a unitary one-piece rung sleeve inner surface—that is, in Metalast's words, one with fewer parts, and without nuts and bolts—which appears inconsistent with the Court's claim construction opinion rejecting the unitary one-piece definition. During the claim construction phase, the Court reviewed the prosecution history now being relied upon by Metalast and held that while "[t]he more persuasive reading of the prosecution history *may* be that it focuses on distinguishing the '041 patent claim from the Full patent in terms of the simplicity of construction and number of parts ... there is also a plausible reading that it focuses on ease of sliding (i.e., smooth surfaces without protrusion), which is likewise a simpler construction." Intex, 245 F.Supp.2d at 78. The Court then stated that "[m]ore importantly, the relevant prosecution history is subject to some inherent doubt" considering certain weaknesses in the patent attorney's deposition testimony, and ultimately concluded that the prosecution history was not sufficiently clear and unambiguous to prevail over the ordinary meaning of the term. *Id.* Therefore, the Court adopted instead the "smooth" or "uniform" construction, which in turn was defined to mean without gaps, protrusions or recesses.

This earlier claim construction holding has consequences for the Court's analysis of prosecution history estoppel. It would make no sense to reject the unitary one-piece interpretation of "uninterrupted inner surfaces" for the purpose of claim construction—which defines the scope of the patent for determining both literal infringement and the doctrine of equivalents—but then to embrace it for the purpose of determining whether an accused design is equivalent to (and thus infringes) the patented invention based on the same previously rejected prosecution history. That approach would allow the patentee to circumvent the claim construction holding. The Court rejects such an internally inconsistent methodology. The result is that, on this record, Metalast cannot assert the "fewer parts" explanation as the rationale for the amendment

regarding "uninterrupted inner surfaces," and hence has not rebutted the presumption that prosecution history estoppel applies.

For the foregoing reasons, the Court denies Metalast's motion for summary judgment on the doctrine of equivalents. The Court also declines to enter summary judgment on this issue for Intex, although the case for prosecution history estoppel appears strong, because of the procedural irregularities that occurred during the briefing. Intex did not request summary judgment on the doctrine of equivalents until the filing of its final surreply brief, which resulted in no opportunity for Metalast directly to respond. Metalast also is not without fault-it did not request summary judgment on the doctrine of equivalents until the filing of its final reply brief, which necessitated granting Intex leave to respond with a surreply. Given this lack of briefing on Intex's "motion" for summary judgment, the Court denies Intex's motion without prejudice.

C. Validity of Patent Under Section 112

Metalast moves for summary judgment on Intex's claim that the patent is invalid under Section 112, and on its counterclaim that the patent is valid under the same provision. The parties disagree over whether the patent meets three requirements under Section 112-first, whether the claims in the patent are sufficiently definite; second, whether the patent contains an adequate written description of the invention; and third, whether the patent enables one skilled in the art to make and use the invention.FN10 In determining whether summary judgment is appropriate, the Court gives due weight to the presumption of patent validity under 35 U.S.C. s. 282. However, the Court rejects Metalast's argument (Mot. at 9) that it also should consider whether Intex can prove patent invalidity by clear and convincing evidence at this stage because Intex has not sought summary judgment on this issue. Nonetheless, the Court concludes that Intex has failed to create a genuine issue of material fact as to whether Metalast has demonstrated that the '041 patent meets the three requirements of Section 112 described above.

FN10. These requirements are set forth in paragraphs 1 and 2 of Section 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

35 U.S.C. s. 112.

1. The Definiteness Requirement

The second paragraph of Section 112 requires that the claims of a patent "particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention." Whether the patent claim meets this "definiteness" requirement "is a conclusion 'that is drawn from the court's performance of its duty as the construer of patent claims [and] therefore, like claim construction, is a question of law...." ' Bancorp Servs., L.L.C. v. Hartford Life Ins. Co., 359 F.3d 1367, 1371 (Fed.Cir.2004) (quoting Atmel Corp. v. Info. Storage Devices, Inc., 198 F.3d 1374, 1378 (Fed.Cir.1999)). Thus, the definiteness analysis under Section 112 "is inextricably intertwined with claim construction." FN11 Atmel Corp., 198 F.3d at 1379. In ruling on a claim of patent indefiniteness, a court must determine whether those skilled in the art would understand what is claimed when the claim is read in light of the specification. Bancorp, 359 F.3d at 1371. A claim is not indefinite merely because it poses a difficult issue of claim construction. *Id.* "[I]f the claim is subject to

construction, i.e., it is not insolubly ambiguous, it is not invalid for indefiniteness." *Id.*

FN11. Some courts have ruled upon the indefiniteness issue at or before the claim construction stage, while others have determined that the issue of indefiniteness can be considered only after the claim construction phase has been completed. *Compare* Freeman v. Gerber Prods. Co., 284 F.Supp.2d 1290, 1291 (D.Kan.2003) (consideration of indefiniteness at claim construction stage), *rev'd on other grounds*, 120 Fed. Appx. 322 (Fed.Cir.2005), *and* Exxon Research and Eng. Co. v. United States, 46 Fed. Cl. 278 (Ct.Fed.Cl.2000) (consideration of indefiniteness on motion for summary judgment prior to claim construction hearing), *rev'd on other grounds*, 265 F.3d 1371 (Fed.Cir.2001), *with* Harrah's Entertainment, Inc. v. Station Casinos, Inc., 321 F.Supp.2d 1173, 1176 (D.Nev.2004) (discussing ambiguity within the case law as " 'to whether a finding of indefiniteness should occur during claim construction, or whether it should occur at a later date" ' and concluding that the court must first attempt to determine what a claim means) (quoting ASM America v. Genus, Inc., 2002 WL 1892200, (N.D.Cal.)), *and* Schering Corp. v. Amgen, Inc., 18 F.Supp.2d 372, 379 n. 13 (D.Del.1998) (declining to consider indefiniteness issue during claim construction phase). The Court need not resolve that procedural issue here, in light of its prior determination that the claim is subject to construction, as well as the lack of an objection by Intex to consideration of claim construction prior to resolution of patent invalidity.

Metalast moves for summary judgment on the ground that the Court has already construed the claim term "uninterrupted inner surfaces" to mean "smooth" or "uniform," and thus, as a matter of law, the term has already been found definite. Intex cites the Ver Halen declaration submitted in the *Markman* hearing as evidence that the claim is not sufficiently definite because, in his view, "any person skilled in the art of ladder design would have to guess what the Patent means in Claim 1 when it claims 'sleeves having uninterrupted inner surfaces.'" ' *See* Ver Halen Claim Construction Decl. para. 6. Ver Halen appears to base this view in large part on the fact that "[t]here is no description of what 'uninterrupted inner surfaces' means in this context." *Id.* However, as the Federal Circuit held in *Bancorp.*, if the claim is subject to construction, it is not invalid for indefiniteness. 359 F.3d at 1371; *see also* Aero Prods. Int'l, Inc. v. Intex Recreation Corp., 2004 WL 1557736, (N.D.Ill. July 9, 2004) ("the term has already been construed in a *Markman* proceeding, and, as such, has already been found to be definite"). Because the claim term "uninterrupted inner surfaces" has been construed, the Court finds that, as a matter of law, the claim meets the definiteness requirement of Section 112.

2. Written Description Requirement

Under Section 112, the "written description" of the invention "must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563 (Fed.Cir.1991). To fulfill this requirement, the patent's "disclosure must allow one skilled in the art to visualize or recognize the identity of the subject matter purportedly described." Koito Mfg. v. Turn-Key-Tech LLC, 381 F.3d 1142, 1154 (Fed.Cir.2004) (internal quotations omitted). Whether a written description is adequate presents a question of fact. *Id.*

Metalast moves for summary judgment on this issue on the ground that the drawings in the '041 patent as originally filed showed rung sleeves having "uninterrupted inner surfaces," and that such drawings may suffice to fulfill the written description requirement. Intex relies on the First Ver Halen declaration (para. 15) to support its position that the '041 patent fails to describe the limitations of the claim-that is, "uninterrupted inner surfaces"-so that one of ordinary skill in the art would recognize that the applicant

invented what is claimed. Ver Halen states that "the views provided by the original drawings are incomplete and inexact, and therefor[e], requires one skilled in the art to speculate as to the nature of the inner surfaces which are not shown." *Id.*

The Court finds that the drawings in the '041 patent as originally filed satisfy the written description requirement as to the claim term "uninterrupted inner surfaces." It is well-recognized that "drawings alone may provide a 'written description' of an invention as required by s. 112," and Intex does not appear to dispute this point. *Vas-Cath*, 935 F.2d at 1565; *see also* *Koito Mfg.*, 381 F.3d at 1154 (stating that "the written description requirement can be satisfied by words, structures, *figures, diagrams*, formulas, etc." and relying on an illustrative figure in determining that the requirement was satisfied) (emphasis in original). Intex's contention that the drawings are "incomplete and inexact" regarding the nature of the inner surfaces—that is, in showing "uninterrupted inner surfaces," i.e., surfaces that are "smooth" or "uniform"—is not supported by an examination of the drawings themselves.

As set forth in the Stillman Declarations, "[t]he '041 patent's drawings, as originally filed, show the inner surface of the sleeves formed in the rungs to be 'smooth.'" First Stillman Decl. para. 18. Stillman further accurately describes the individual figures as follows: "while Fig. 1 [of the original drawings] shows only a portion of the inner surface of the rung sleeve 9, Fig. 2 clearly shows the entire inner surface." Second Stillman Decl. para. 35. He further notes that "even if one skilled in the art looked at Fig. 1 alone, he or she would undoubtedly understand that the entire inner surfaces of the rung sleeves are smooth. There is nothing in the patent which would lead one skilled in the art to believe that the texture of the portion of the inner surface which is not shown in Fig. 1 is any different than the texture of the portion of the inner surface which is shown." *Id.* para. 36. The Court recognized this as well in its *Markman* opinion, when it stated: "Figure 1 [of the '041 patent] ... shows the 'inner surface' of the sleeve as 'smooth.' Likewise, the axial cut-out in Figure 2, which the patent characterizes as 'illustrat[ing] an elevational cross-section of the attachment of the rung to the upright' ... depicts the inner surface of the sleeve (at 9) as smooth." FN12 Intex, 245 F.Supp.2d at 72. The conclusory statement by Ver Halen that the figures are "incomplete and inexact" regarding the nature of the inner surfaces is insufficient to defeat summary judgment on this issue. *Anderson*, 477 U.S. at 249-50 ("If the evidence is merely colorable, or is not significantly probative, summary judgment may be granted.") (internal citations omitted). A trier of fact could not reasonably conclude that the inner surfaces of the rung sleeves illustrated in the diagrams are anything other than smooth. *See id.* at 252 (summary judgment is appropriate if the non-movant fails to offer "evidence on which the jury could reasonably find for the [non-movant].")

FN12. Figures 1 and 2 of the drawings in the original patent application are virtually identical to Figures 1 and 2 of the '041 patent. *See Exs. 1 and 12 to Metalast's Mot. for Summ. J.*

3. Enablement Requirement

Section 112 also requires that the patent "enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same...." To be enabling, "the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without 'undue experimentation.'" *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 1371 (Fed.Cir.1999). Enablement is determined as of the filing date of the application. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed.Cir.1988).

Metalast moves for summary judgment on the ground that the testimony of its own expert as well as that of Intex's expert, Ver Halen, establishes that one skilled in the art of ladder design would know how to make and use the full scope of the invention based on the drawings in the '041 patent. "In my opinion, if one skilled in the art of ladder design set out to make and use the ladder disclosed and claimed in the '041 patent, he or she could simply copy what is in the drawings. This is a simple mechanical invention...." First Stillman Decl. para. 19. Metalast also quotes Ver Halen's prior deposition testimony as conceding that one skilled in the art of ladder design could make the ladder in the '041 patent simply by copying the ladder design. Ver Halen Depo. at 83 (Ex. 13 to Metalast's Mot.). Intex, on the other hand, argues that one skilled in the art would have to "guess" as to what the figures mean, and further argues that the Ver Halen deposition testimony does not establish enablement because "copying" a design is not the same as enabling one skilled in the art to "make and use the full scope of the invention." *See* Intex Mot. and Opp. at 25.

Intex fails to raise a genuine issue of material fact over the issue of enablement. The undisputed testimony establishes that one skilled in the art of ladder design could construct the ladder in the '041 patent by copying the figures. Additionally, this testimony is bolstered by the fact that the ladder is, as Stillman describes it, a "simple mechanical invention"-an assertion Intex does not, and indeed could not, dispute. The Court finds no meaningful distinction between one skilled in the art constructing the invention by "copying" it, and "making and using the full scope of the claimed invention"-the distinction that Intex attempts to draw. Nor does Intex explain what this distinction would be.

Hence, the enablement requirement is satisfied on the record here. Because the Court has concluded that the definiteness requirement is satisfied as a matter of law, and Intex has failed to raise a genuine issue of material fact as to the patent's satisfaction of the written description or enablement requirements, the Court grants Metalast's motion for summary judgment on patent validity under Section 112.

D. Validity of Patent Under Section 102(b)

Lastly, Metalast and Intex each move for summary judgment on Intex's claim that the patent is also invalid under 35 U.S.C. s. 102(b). Pursuant to this provision, a patent is not valid if "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States." Intex contends that Metalast ladders covered by the '041 patent were both included in publications and offered for sale more than one year prior to December 15, 1995-the date of Metalast's amendments to the '041 patent adding the Claim 1 limitation regarding the rung sleeves' "uninterrupted inner surfaces." Intex argues that this later date is properly considered the "date of the application," rather than the earlier filing date of the original Spanish application (September 21, 1993), because the claim for "uninterrupted inner surfaces" added new matter not covered by the original application. Metalast responds that its 1995 amendment adding the claim for "uninterrupted inner surfaces" did not add any new matter because the claim is supported by the original application. If September 21, 1993 is considered the date of application, Intex's claim of invalidity under Section 102(b) would fail because the publication and sale by Metalast of ladders covered by the '041 patent as early as October 1993 (as alleged by Intex) would still be after the date of Metalast's application.

The parties agree that the date of application under Section 102(b) depends on the date a complete application meeting the requirements of Section 112 was filed. *See* Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1437 (Fed.Cir.1984).FN13 Thus, in determining whether the patent has an effective filing date other than the actual filing date, the Court must determine whether the subject matter claimed in the 1995 amendment-"uninterrupted inner surfaces"-was already supported in the previous 1993 application. *See*

Purdue Pharma L.P. v. F.H. Faulding and Co., 48 F.Supp.2d 420, 432 n. 4 (D.Del.1999). "Stated another way, the Court must determine whether the written description requirement is met by the previous application []." *Id.* Thus, both Metalast and Intex agree that the Court's resolution of the written description requirement also resolves the date of application. *See* Intex Cross-Motion at 20; Metalast Opp. and Reply at 31. In light of the Court's determination under Section 112 that the drawings in the 1993 application constituted an adequate written description disclosing the claim limitation at issue (rung sleeves having "uninterrupted inner surfaces"), the application was complete at that time-i.e., September 21, 1993.

FN13. The fact that the initial patent application was a foreign application does not change this approach. *See* In Re Karl Ziegler, 992 F.2d 1197, 1200 (Fed.Cir.1993) ("A foreign patent application must meet the requirement of 35 U.S.C. s. 112, first paragraph, in order for a later filed United States application to be entitled to the benefit of the foreign filing date under 35 U.S.C. s. 119").

Intex proffers one additional argument on the issue of the application's completeness that was not asserted in its arguments as to the written description. Intex argues that the deposition of Joseph Holman, Metalast's patent attorney at the time of the 1995 amendment, establishes that new matter was added, based on Holman's deposition testimony that he added the claim limitation of "uninterrupted inner surfaces" based on what he "thought" he discerned from the drawings, without reading the original Spanish application. *See* Holman Depo. at 65, 77 (Kidde Decl., Ex. B to Ex. 3). From that, Intex concludes that the claim language could not have been based on the original Spanish application. However, Holman's addition of the claim term "uninterrupted inner surfaces" based on the original drawings in the application is fully consistent with the Court's finding above that the diagrams disclose rung sleeves having "uninterrupted inner surfaces." This argument by Intex therefore also is unavailing.

Having determined that the application date is September 21, 1993, Intex's challenge to patent validity under Section 102(b) fails as a matter of law, as the sale and publication events alleged (October 1993 and thereafter) did not occur "more than one year prior to the date of the application for patent."

CONCLUSION

For the foregoing reasons, with respect to the claim for literal infringement, Intex's motion for summary judgment is granted, and Metalast's motion for summary judgment is denied. With respect to the claim for infringement under the doctrine of equivalents, Intex's and Metalast's motions for summary judgment are denied. With respect to the claims under 35 U.S.C. s.s. 102(b) and 112 regarding the validity of the '041 patent, Metalast's motion for summary judgment is granted. Intex's motion to exclude the Stillman declarations is also denied. What remains in this case, then, is solely the infringement question under the doctrine of equivalents. A separate Order will be issued.

D.D.C., 2005.

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