

United States District Court,  
C.D. California.

**INTERNATIONAL E-Z UP, INC., a California corporation; and Mark C. Carter, an individual,**  
Plaintiff.

v.

**NORTH POLE (US) LLC, A DELAWARE CORPORATION,**  
Defendants.

No. EDCV 04-858-VAP (RNBX)

**Dec. 19, 2005.**

David J. Pitman, James W. Paul, John K. Fitzgerald, Fulwider Patton Lee & Utecht, Los Angeles, CA, for  
Plaintiff.

Brian S. Tobin, John M. Halan, Thomas W. Cunningham, Brooks Kushman, Southfield, MI, Mark B.  
Mizrahi, Belasco Jacobs & Townsley, Los Angeles, CA, for Defendants.

## **ORDER CONSTRUING CLAIMS AFTER *MARKMAN* HEARING**

**VIRGINIA A. PHILLIPS, District Judge.**

The Court conducted a hearing on August 30, 2005, on the parties' proposed constructions of certain claims in the five patents-in-suit, FN1 pursuant to *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir.1995) (en banc) *aff'd*, 517 U.S. 370 (1996). Having considered the written submissions from both parties, as well as the arguments presented at the hearing, the Court now issues its claim construction order.

FN1. These patents are U.S. Patent Nos. 5,632,293, 5,797, 412, 6,076,312, 6,240,940, and 6,431,193, and are attached to the Declaration of Douglas Peterson as Exhibits A through E, respectively.

### **1. "Flexible"**

Plaintiffs assert this term should be construed as "capable of being bent or flexed by an applied force." [Plaintiffs' Opening Memorandum in Support of Plaintiffs' Motion for Claim Construction ("Pls.' Op. Mem.") at 9.] Defendant urges the Court to construe it to mean "capable of bowing in a curve." [Claim Construction Brief of Defendant ("Def.'s Br.") at 9. In other words, the parties dispute whether "flexible" should be construed as limited to "bowing" of a link member or whether it also encompasses "bending" at a joint in the link member.

The Federal Circuit recently reiterated that "[i]n some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction

in such cases involves little more than the application of the widely accepted meaning of commonly understood words ... In such circumstances, general purpose dictionaries may be helpful." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed.Cir.2005) (citing *Brown v. 3M*, 265 F.3d 1349, 1352 (Fed.Cir. 2001)). Both sides claim the ordinary meaning of the term itself sufficiently supports their respective proposed constructions, citing to two widely accepted dictionaries for their differing definitions. Thus, the ordinary meaning of "flexible" as understood by a person of skill in the art is not readily apparent, and the Court examines the intrinsic evidence and other sources cited by the parties. In claim construction, the court follows "the general rule that words in patent claims are given their ordinary meaning in the usage of the field of the invention, unless the text of the patent makes clear that a word was used with a special meaning." *Toro Co. v. White Consol. Ind., Inc.*, 199 F.3d 1295, 1299 (Fed.Cir.1999) (citations omitted).

Defendant argues that the prosecution history of Plaintiffs' patents-in-suit favors its proposed construction, pointing in particular to the USPTO's rejection of certain pending claims during the prosecution of the '293 patent. [Def.'s Br. at 12.] That history includes, of course, Plaintiffs' description of the invention as one with a canopy that " 'can *bend* and collapse in strong winds....' " [ *Id.* at 13, quoting Feb. 23, 1996 Preliminary Amendment, p. 165 (Ex 9 to Halan Decl.) ]

Defendant relies also upon the specifications, noting various figures and descriptions of the canopy and canopy members as "bowed ." [Def.'s Br. at 10.] Taken as a whole, however, the specifications do not support Defendant's argument that the term "flexible" should be limited to "bowing in a curve." In fact, Defendant itself states that the pole members depicted in Figure 8 of the '312 patent are described to be bowed and shown "in a curved configuration indicative of *bending* or bowing." (Def.'s Br. at 11.)

Accordingly, the Court adopts Plaintiffs' proposed construction of the term "flexible." FN2

FN2. Plaintiff also sought construction of two other terms, "flexible collapsible canopy" and "flexible elongated members." *See* Pl.'s Claim Cons.Brief at 10-13. Defendant offered no competing construction for these terms. The Court finds neither of these terms requires construction. The Court has already construed the term "flexible", and the term "collapsible" requires no construction. The Court also finds the term "portion" requires no construction.

## **2. "Movable Between a Normal Raised Position and a Lowered Position"**

Plaintiffs seek the following construction of this term: "Able to be deformed or deflected from a normally raised position to a lower position by an externally applied force when the truss is in an extended position." (Pls.' Op. Mem. at 10.) Defendant proposes that it be construed to mean "a position in which members will remain without outside force being applied." (Def.'s Br. at 14.) The dispute between the parties over this term turns-on whether "position" is limited to configurations in which the members will remain stable without outside force being applied, or in other words, whether there are multiple positions or only two configurations.

Both sides point to the prosecution history of the patent, *see Phillips*, 415 F.3d at 1317 ("a court 'should also consider the patent's prosecution history, if it is in evidence.' ") (citing *Markman*, 52 F.3d at 980 and *Graham v. John Deere Co.*, 383 U.S. 1 (1966)), but reach opposing conclusions regarding its impact on the construction of this claim. According to Defendant, Plaintiff Mark Carter, as the inventor of the patented device, took the position during the patent's prosecution that the Lynch canopy, which is semi-rigid, did not

anticipate his invention because that canopy is not movable to positions in which it will remain-unlike Plaintiffs' device, which is movable to such fixed positions.

Plaintiffs dispute this interpretation of the patent prosecution history, arguing that both the prosecution history and the specification support their proposed construction, i.e., "a meaning that the lower position is simply *relative* to the normal raised position...." [Plaintiffs' Memorandum in Support of Plaintiffs' Opposition to North Pole (US) LLC's Claim Construction Brief ("Pls.' Reply Mem.") at 6; emphasis in original.] In particular, they contend the Lynch canopy's design does not allow it to flex and move from a raised to a lowered position, unlike Plaintiffs' device. (*Id.*)

In its presentation during the *Markman* hearing and in its claim construction briefs on this issue, Defendant cited language from the patent specification regarding the positions of the canopy. *See* Def.'s Br. at 14-15 citing Ex. 1 to Declaration of John Halan, ('293 patent) col. 1, II. 53-57, col. 5, II. 59-67, col. 6, II. 34-39. The latter two citations provide particularly strong support for Defendant's proposed construction of this term.

For example, the specification describes two positions:

"the pole members forming the canopy will typically [1] be bowed downwardly, and can be pushed upward to snap into [2] an upwardly bowed, normal canopy configuration. The pole members forming the canopy can also flex and move from the [1] normal raised position 106 to a[2] lowered position 108 by pulling the pole members down, or by exertion of a downward force on the top of the canopy."

In other words, the canopy is not only described as having only two positions, the downward position from which it can "snap" into an upward, open position, but the use of that verb suggests that these two positions are fixed, not simply two of multiple possible positions.

Defendant's third citation to the specification is equally compelling. It also describes but two positions for the canopy: "a raised position providing more headroom and a lowered position presenting a reduced profile...."

The first portion of the specification to which Defendant cites is consistent with these latter descriptions, describing an invention consisting of a "collapsible shelter with a flexible collapsible canopy framework that can be raised to provide increased headroom ... and ... lowered to provide a reduced profile to the wind." Nothing in any of them provides support for Plaintiff's proposed construction, describing multiple configurations.

Plaintiffs accuse Defendants of improperly ignoring the embodiment of Figure 17, an illustration of the canopy buffeted by a gust of wind. (Pls.' Reply Mem. at 5.) Although Defendant discusses this embodiment solely in relation to its proposed construction of the term "flexible," Plaintiffs rely in vain on its omission in the briefing on the construction of the multiple configurations issue. As Defendant points out, the patent describes Figure 17 as "an illustration of the flexing of the collapsible canopy when exposed to strong winds." (Def.'s Br. at 11, quoting '293 patent, p. 11, col. 3, II. 48-49 (Ex. 1 to Halan Decl.)) This description, and the illustration itself, provide scant or no support for Plaintiffs' proposed construction of this term. Accordingly, the Court adopts Defendant's proposed construction.

### **3. "Reinforcing Plug" and "Reinforcing Member"**

Plaintiffs urge the Court to give "reinforcing plug" and "reinforcing member" the following construction: "A strengthening structure that is placed at an end of a link member." (Pls.' Op. Mem. at 10.) Defendant proposes the terms be construed to mean "A structure inserted into a member to strengthen the member and prevent deformation." (Def.'s Br. at 20.)

Plaintiffs rely in part on the embodiment, Figure 16, which illustrates a plug inserted into the opening of the link member but with a portion of it remaining external to the hollow link member. (Pls.' Op. Mem. at 6.) In response, however, Defendant argues that the plug or member must be used at the end of the link member, that the plug or member must strengthen, that according to the specification, a purpose of the reinforcing plug or member is to *reinforce* or *strengthen* the end of the link members, and most importantly, the strengthening aspect of the plug only comes from that portion of it which is inserted into the link member. (Def.'s Br. at 20-23.)

Defendant relies heavily upon *C.R. Bard v. U.S. Surgical Corp.*, 388 F.3d 858 (Fed.Cir.2004) in support of its proposed construction. In *Bard*, the Federal Circuit affirmed, *inter alia*, the District Court's claim construction order in a patent suit over a mesh plug used in hernia surgeries; the parties disputed whether the claim at issue on appeal should be construed to require that the plug's surface contain pre-formed pleats. *Id.* at 861. The plug was consistently described in the intrinsic record, i.e., the specification, Summary of Invention, and patent prosecution history, as having pleats. Nevertheless, the plaintiff argued that the ordinary and customary meaning of the claim term, including proffered dictionary definitions, did not require pleating; the District Court rejected the invitation to prefer extrinsic evidence over intrinsic, as did the Federal Circuit. *Id.* at 863-64.

According to Defendant, our case bears a critical similarity to *Bard*: in both cases, the Summary of Invention specifically describes the device's disputed restrictive aspects. In *Bard*, the Court pointed out that the Summary "unequivocally" described the plug as having pleats; likewise, the Summary of Invention in our case defines a reinforcing plug or member as inserted *into* the link member.

Defendant argues that the specification describes a "reinforcing plug ... that is inserted in the openings [ ] in the inner ends of each of the first and second link members," and thus, "plug" should be limited to a device that is "inserted into a "hollow end ." (Def.'s Br. at 22.) It also relies on the ordinary meaning of "plug," i.e., "material used or serving to fill a hole." *Id.* at 23.

Plaintiffs respond that neither the specification nor the prosecution history limit the meaning of this disputed term as Defendant suggests. (Pls.'s Reply Mem. at 8-9 (citing *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1347 (Fed.Cir.1998)). Plaintiffs also point out that "reinforcing member" is recited in two of the claims in the '193 patent and one of the claims in the '0 patent, and in each instance the claim recites that "the 'reinforcing member' is 'mounted' on the inner end of the link members," with no other limitations placed on the term. *Id.* at 10.

None of Plaintiffs' arguments suffice to counter the weight of authority, intrinsic evidence and meaning of words of ordinary usage construed in the context of the patent documents in this case.

As discussed above, the intrinsic evidence here, particularly the Summary of Invention and the specification, support Defendant's proposed construction of these terms. Moreover, the dictionary definition of "plug," particularly when construed in the context of the patent documents here, *see Toro*, 199 F.3d at 1299, strongly supports Defendant's position on the construction of these terms.

Defendant cites and relies heavily on the Federal Circuit's holdings in *Toro* and *Wang Lab., Inc., v. America Online, Inc.*, 197 F.3d 1377 (Fed.Cir.1999), arguing that the claims must be "limited to only those embodiments described and enabled by the specification of the patent." (Def.'s Br. at 23.) Plaintiffs retort that these cases are distinguishable on their facts from the present case, and furthermore, that subsequent rulings have limited their reach. (Pls.' Reply Mem. at 10-11.)

The *Toro* Court was careful to note that the case before it was "not a case of limiting the claims to a "preferred embodiment" of an invention that has been more broadly disclosed. It is well established that the preferred embodiment does not limit broader claims that are supported by the written description." *Toro*, 199 F.3d at 1301 ( *citing* *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed.Cir.1988)). In the present case, as Defendant has amply shown, the broader claim that Plaintiffs propose is not supported by the written description, however. In *Wang*, a decision whose import the parties also dispute, the Federal Circuit upheld the district court's claim construction which led to its grant of summary judgment of noninfringement. *Wang* argued, as do Plaintiffs here, that a claim should not be limited to the matters which are specifically illustrated, and the Federal Circuit agreed. *Wang*, 197 F.3d at 1383. Nevertheless, that argument did not serve to rescue *Wang's* claims from the noninfringement finding, in light of the prosecution history, the content of the specification, and the context in which the embodiment was described.

In other words, although Plaintiffs argue correctly that *Wang* does not stand for the principle that claims are drastically limited to the illustrations set forth in the patent, such would be an overstatement of the defense's position in this case. The Federal Circuit's decisions in *Wang* and *Toro* support Defendant's contention that the broad claim Plaintiffs propose is not supported in the patent documents.

Accordingly, the Court adopts Defendant's proposed construction of these terms.

**IT IS SO ORDERED.**

C.D.Cal.,2005.

*International E-Z Up, Inc. v. North Pole (US) LLC, a Delaware Corp.*

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