

United States District Court,
N.D. California.

CHIP-MENDER, INC,
Plaintiff.

v.

The SHERWIN-WILLIAMS COMPANY,
Defendant.

No. C 05-3465 PJH

Oct. 16, 2006.

Background: Patentee brought action against competitor, alleging infringement of its patents for an automotive touch-up pen. Court heard argument regarding the construction of nine disputed claim terms.

Holdings: The District Court, Hamilton, J., held that:

- (1) "painted surface of a vehicle" meant "any vehicle surface with paint," and was not limited to the painted surface of an automobile;
- (2) "nib" used to transfer or apply paint to the painted surface of the vehicle did not include nibs that were porous or fibrous;
- (3) term "nib slidably located in said passageway" in patent for an automotive touch-up pen meant a slidable nib located in the channel such that the nib was located or positioned in the passageway or channel and moved, or slid within the passageway; and
- (4) term "squeezing said housing" meant "squeezing said housing."

Ordered accordingly.

6,254,299, 6,283,663. Construed.

Stefani E. Shanberg, Dieter H. Hellmoldt, Kenneth B. Wilson, Perkins Coie LLP, San Francisco, CA, for Plaintiff.

Peter Nels Larson, Jones Day, San Francisco, CA, Anthony Thomas Jacono, Regan Joseph Fay, Jones Day, Cleveland, OH, for Defendant.

ORDER CONSTRUING CLAIMS

HAMILTON, District Judge.

Plaintiff Chip-Mender, Inc. ("Chip-Mender"), owns two utility patents for paint applicator systems used to apply automotive touch-up paint to cover chips and scratches on the painted surface of vehicles. The patents are U.S. Patent No. 6,254,299 B1 ("the '299 patent") and U.S. Patent No. 6,283,663 B1 ("the '663 patent"). The inventor is Timothy M. Russo, who is also the president of Chip-Mender, to whom he assigned the patents.

Chip-Mender filed this action on August 26, 2005, alleging that defendant The Sherwin-Williams Company ("Sherwin-Williams") had infringed Chip-Mender's patents. On May 5, 2006, pursuant to the local rules of this court, the parties filed a joint claims construction statement. Chip-Mender has given Sherwin-Williams a broad covenant not to sue with regard to the '633 patent, and now asserts only certain claims of the '299 patent.

On September 13, 2006, following the filing of briefs by the parties, the court heard argument regarding the construction of nine disputed terms in the claims of the '299 patent. Chip-Mender appeared by its counsel Kenneth B. Wilson and Dieter Hellmoldt, and Sherwin-Williams appeared by its counsel Regan J. Fay, Peter N. Larson, and Anthony T. Jacono. At the conclusion of the hearing, the court took the matter under submission, and now rules as follows.

BACKGROUND

At the time the complaint was filed, Chip-Mender was in the business of selling automotive touch-up pens, based on the system described in the patents-in-suit. It had two employees-Russo and his wife. Chip-Mender ceased operations in mid-2006.

Russo filed the application that led to the issuance of the '299 patent, which is entitled "Paint Applicator System," on November 29, 1999. The original application contained 11 claims (1 independent claim and 10 dependent claims), which were broader than, but similar to, the 22 claims that ultimately issued. In his November 29, 1999, identification of prior art, Russo disclosed 10 prior art references.

On August 16, 2000, the PTO issued an initial Office Action in which it rejected each of the original 11 claims, based on 35 U.S.C. s. 103(a), on the ground that they were unpatentable in light of certain prior art. The examiner found that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the same paint composition described in two of the prior art references ("Kremer in view of Saad" and "in further view of Nakai").

On February 9, 2001, Russo submitted a written response to the August 16, 2000, Office Action, and also submitted amended claims. In the written response, Russo challenged the rejection of claims 1 through 11 on the basis that both the paint composition described in the Saad reference and that described in the Nakai reference contained a catalyst, which, if used in the paint composition in the Paint Applicator System, would turn the liquid compound into a solid material and render the applicator useless. Russo also asserted that the paint composition described in the Nakai reference contained an acid that could not be used in conjunction with the automotive paint composition in the Paint Applicator System without severely damaging the paint composition in the applicator and the painted surface.

In addition, Russo amended independent claim 1 as follows. He modified the preamble, "A paint applicator system for repairing a painted body, comprising ...," to read, "A paint applicator system for applying automotive touch-up paint to the painted surface of a vehicle, comprising...." He changed "paint

composition" to "automotive paint composition," and changed "said paint at said nib intended to be transferred to said body" to "said paint at said nib intended to be transferred to the painted surface of a vehicle." Russo also added new independent claim 12, a method claim that includes the same new "automotive paint" and "surface of a vehicle" limitations, plus 14 additional claims (claims 13-26) that depended from new independent claim 12.

The Examiner issued a Notice of Allowability on March 29, 2001, with an amendment stating that "[c]laims 1-22 are allowed," but that the application had been amended to "[c]ancel claims 23-26." The Examiner's reason for allowance of claims 1-22 was that

the prior art of record does not render obvious the claimed device containing the claimed paint composition because the prior art paint compositions having the viscosity adjusted via addition of a solvent as claimed include a catalyst, and such compositions would harden while stored in the applicator rendering the applicator inoperative.

The prosecution history is silent with regard to the Examiner's reasons for cancelling claims 23-26. Chip-Mender speculates that they were likely cancelled due to patent drafting errors, as each of those claims depended from more than one claim, which violates certain provisions of the Manual of Patent Examining Procedure. Claims 12 through 22 were all allowed as written with no modifications requested by the Examiner or made by Russo.

In 2002, Russo became aware of Sherwin-Williams' automotive touch-up pen, the Dupli-Color Scratch Fix 2-in-1 Pen, while attending an automotive trade show in Las Vegas. According to Chip-Mender, up until that time, Sherwin-Williams' automotive touch-up products were primarily brush-and-cap based, and employed the systems of the prior art. Russo subsequently advised Sherwin-Williams that he had two patents that he believed covered Sherwin-Williams' products, and offered to license his patents to Sherwin-Williams, but Sherwin-Williams refused.

DISCUSSION

A. Legal Standard

Patent infringement analysis involves a two-step process. First, the court must determine as a matter of law the correct scope and meaning of disputed claim terms. Second, the properly construed claims are compared to the accused device to see whether the device contains all the limitations (literally or by equivalents) in the claims at issue. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 384, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

"[T]he claims of a patent define the invention to which the patentee is entitled the right to exclude." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed.Cir.2005), *cert. denied*, 546 U.S. 1170, 126 S.Ct. 1332, 164 L.Ed.2d 49 (2006). (citation and quotation omitted); *see also* *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed.Cir.1998) (claim construction "begins and ends" with the actual words of the claims). "The terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed.Cir.2002) (citations omitted).

[1] "In 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." *Phillips*, 415 F.3d at 1314. In such cases, claim construction

"involves little more than the application of the widely accepted meaning of commonly understood words." Id. When, however, the court is required to examine terms that have a particular meaning in a field of art, "the court looks to those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean." Id. (citing *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed.Cir.2004)). Those sources include "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." Id.

[2] [3] [4] A patentee is presumed to have intended the ordinary meaning of a claim term in the absence of an express intent to the contrary. *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572 (Fed.Cir.1996). The ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Phillips*, 415 F.3d at 1313. The person of ordinary skill in the art is "deemed to read the claim term not only in the context of the particular claim ... but in the context of the entire patent, including the specification." Id.

The words in the claim may also be interpreted in light of the prosecution history, if in evidence. *Teleflex, Inc. v. Ficosa North Am. Corp.*, 299 F.3d 1313, 1324-25 (Fed.Cir.2002) (citations omitted). "[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Phillips*, 415 F.3d at 1317.

[5] Extrinsic evidence such as dictionaries also "may be considered if the court deems it helpful in determining the true meaning of the language used in the patent claims," id. at 1318 (quotations omitted), provided the court "attach[es] the appropriate weight ... to those sources in light of the statutes and policies that inform patent law," id. at 1324.

[6] Only if an analysis of the intrinsic evidence fails to resolve any ambiguity in the claim language may the court then rely on other extrinsic evidence, such as expert declarations. *York Prods*, 99 F.3d at 1573 ("In those cases where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper."). Extrinsic evidence may never be relied upon to vary or contradict the clear meaning of terms in the claims. *Apex, Inc. v. Raritan Computer, Inc.*, 325 F.3d 1364, 1371 (Fed.Cir.2003).

B. The '299 Patent and the Asserted Claims

The '299 patent discloses a paint applicator system utilizing a paint reservoir that is connected to a slidable nib which permits paint to pass through the reservoir to the exterior of the nib. The '299 patent has 22 claims, of which two-claims 1 and 12-are in independent form. Dependent claims 2 through 7 depend from independent claim 1, and dependent claims 8 through 11 depend from dependent claim 7. Dependent claims 13 through 18 depend from independent claim 12, and dependent claims 19 through 22 depend from dependent claim 18.

Chip-Mender asserts claims 2, 3, 4, 6, 7, 9, 11, 12, 13, 14, 15, 17, 18, 20, and 22 against Sherwin-Williams. However, the disputed terms appear only in independent claims 1 and 12. The first seven disputed terms appear in both claims 1 and 12, and the last two disputed terms appear only in claim 12.

Claim 1 recites

A paint applicator system for applying automotive touch-up paint to the **painted surface of a vehicle**, comprising:

a. a housing including a passageway;

b. reservoir located in said housing, **said passageway communicating with said reservoir**;

c. a **nib supported by said housing**, said **nib slidably located in said passageway** communicating with said reservoir, said **nib** including a portion extending from said passageway, said housing, reservoir, and **nib** comprising an applicator unit; and

d. an **automotive paint composition**, said composition including a pigment and a sufficient amount of solvent to determine the viscosity of said paint between 25 and 115 centipoise, measured at 22 degrees Celsius, said paint composition positioned in said reservoir to allow **flow of said paint through said passageway, to said nib**, said paint at said **nib** intended to be transferred to the **painted surface of a vehicle**.

Claim 12 recites

A paint application method of applying automotive touch-up paint, or to repair the **painted surface on a vehicle** comprising[FN1];

FN1. This appears to be a typo. The word in the amended claims, which were allowed without amendment by the Examiner, was "comprising."

[a] providing a paint applicator comprising;

[b] a housing including a passageway;

[c] a reservoir located in said housing, **said passageway communicating with said reservoir**;

[d] **nib supported by said housing**, said **nib slidably located in said passageway** communicating with said reservoir, said **nib** including a portion extending from said passageway, said housing, reservoirs, and **nib** comprising a paint applicator;

[e] an **automotive paint composition** placed in said paint applicator, said composition including a pigment and a sufficient amount of solvent to determine the viscosity of said paint between 25 and 115 centipoise, measured at 22 degrees Celsius, said paint composition positioned in said reservoir to allow **flow of said paint through said passageway, to said nib**, said paint at said **nib** intended to be transferred to the **painted surface of a vehicle**;

[f] by placing said applicator on painted surface and **applying a slight pressure to force said nib upward allowing it to open and permit said paint to flow by gravity from said reservoir through said passageway to said nib and transferring to the painted surface of the vehicle**;

[g] or by placing said applicator on painted surface and applying slight pressure to force said **nib** upward permitting paint to flow and **squeezing said housing** to increase flow of said paint from said reservoir through said passageway to said **nib** and transferring to the **painted surface of the vehicle**.

C. The Construction of the Disputed Terms

The parties seek an order construing nine disputed terms.

1. painted surface of a vehicle

[7] The term "painted surface of a vehicle" appears in claim 1 and claim 12. In the joint claims construction statement and in the papers filed in connection with the hearing on claims construction, Chip-Mender argues that "painted surface of a vehicle" means "*painted surface of an automobile*," while Sherwin-Williams asserts that "painted surface of a vehicle" means "*any vehicle surface with paint, regardless of whether the surface is metal, plastic, or otherwise, including any self-painted surface of a self-propelled land vehicle such as a car or a motorcycle*."

Chip-Mender proposes no construction for "painted surface," presumably intending that the phrase have its ordinary meaning,^{FN2} while Sherwin-Williams contends that "painted surface" means "any ... surface with paint," which simply re-phrases the term "painted surface." Sherwin-Williams adds that the "surface" can be metal, plastic, or "otherwise," while Chip-Mender does not specify the composition of the "surface." Sherwin-Williams provides no support for its proposed limitation regarding the type of surface, simply asserting that because there are vehicles made of materials other than metal—such as the 1950s Corvettes, made of fiberglass—the correct construction must specify that the "surface" can be any material, so long as it is "painted."

FN2. In its proposed construction for disputed term No. 8, below, Chip-Mender defines "painted surface" as "painted body."

Nevertheless, there appears to be no real dispute regarding the construction of "painted surface." Moreover, the court finds nothing in the patent claims or specification which requires that the construction include a limitation as to the composition of the "surface" that is "painted."

The only real dispute reflected in the papers involves the meaning of "vehicle." Sherwin-Williams asserts that "vehicle" is not limited to passenger cars, but also includes any "self-propelled land vehicle" that has a "surface" with paint, such as motorcycles, trucks, vans, sport utility vehicles (SUVs), farm equipment, trailers, and trains. The court interprets this as an argument that "vehicle" not be construed as "automobile." Although Chip-Mender argues in its moving papers that "vehicle" means "automobile," counsel for Chip-Mender stated at the hearing that he would be "happy" to construe "vehicle" as "vehicle" instead of "automobile." Moreover, Chip-Mender asserts in its reply brief that the invention of the '299 patent is not limited to application of automotive touch-up paint to "passenger cars," and argues that the term "automobile" includes all modes of transportation normally associated with that term, including pick-up trucks and SUVs.

Based on the claim language and the specification, the court finds that the term "vehicle" is not a "technical term[] of art, and do[es] not require elaborate interpretation," *see* Brown v. 3M, 265 F.3d 1349, 1352 (Fed.Cir.2001), as the parties agree that "vehicle" is a commonly understood word with a widely accepted meaning. *See* Phillips, 415 F.3d at 1314. Thus, in light of the parties' arguments, the court finds that "painted surface of a vehicle" means "any vehicle surface with paint."

2. said passageway communicating with said reservoir

[8] The term "said passageway communicating with said reservoir" appears in claim 1 and claim 12. Chip-Mender contends that it means "*said channel open to said reservoir.*" Sherwin-Williams asserts that it means "*a passageway [28] from the reservoir [22] that separates this fluid storage body from the nib and that allows paint to flow from the fluid storage body to the upper part of the nib.*"

According to Chip-Mender, the parties originally agreed on the definition of "passageway" as "channel," but Sherwin-Williams changed its proposed construction back to the undefined "passageway." In its papers, Chip-Mender asserts that it is not important whether "passageway" is construed as "channel," or simply left as "passageway." At the hearing, counsel for Chip-Mender stated that "channel" and "passageway" are the same term.

Chip-Mender bases its proposed construction of "communicating with said reservoir" on the specification, including Figure 2, and on the language of claims 1 and 12. In particular, Chip-Mender argues that the "passageway" must be "open" to the "reservoir." Chip-Mender asserts that the specification makes clear that the paint flows from the reservoir through the passageway to the nib. *See* '299 patent, col. 2, ll. 7-12. Chip-Mender also contends that extrinsic evidence also supports this construction, citing an Internet dictionary definition of "passageway" as "a path or channel or duct along which something may pass."

In its opposition, Sherwin-Williams argues that the plain and ordinary meaning of "passageway" does not require a structure that is always "open," and that Chip-Mender's proposed construction is inconsistent with the other claim language and the specification. Sherwin-Williams bases its proposed construction on the description of Figure 2. *See* '299 patent, col. 3, ll. 48-60. In particular, Sherwin-Williams notes that the "passageway ... permits the paint composition to flow." Sherwin-Williams contends that because the upper part of the nib is shown as residing inside the passageway, the "passageway" depicted in Figure 2 is not always unobstructed and is therefore not "always open."

Sherwin-Williams argues that the term "said passageway communicating with said reservoir" does not prohibit a flow regulator or valve in the passageway, based on the fact that the claims require that the passageway include a part of the nib, and also based on the specification, which depicts a passageway including a structure in the passageway that would restrict flow (the nib).

The court finds that "said passageway communicating with said reservoir" means "said channel open to said reservoir." According to the claim language and the specification, the paint flows from the reservoir to the nib through the passageway. *See* '299 patent, col. 5, ll. 35-37; col. 6, ll. 24-26; col. 2, ll. 7-10, 27-30. Therefore, the passageway must at some point be "open to the reservoir." There is no requirement in the patent claims and specification that the passageway be "always open," just that it be "open" in the sense that "when a force is applied to the paint composition in the reservoir either by gravity or by squeezing the housing," the paint "flows from the reservoir to the passageway and outwardly from the housing at the nib." *Id.*, col. 2, ll. 7-10.

3. nib

[9] This term appears numerous times in claim 1 and claim 12. Chip-Mender argues that "nib" means "*nib*" -that the term does not require independent construction because the common meaning will suffice. Sherwin-Williams argues for the common meaning of "nib"-a small projecting point-but asserts that the term should be construed as "*the fibrous or solid structure of a fluid applicator that contacts and transfers fluid to a surface.*"

Chip-Mender asserts that nib is used throughout the patent to describe the structure that seals the applicator, regulates paint flow from the applicator, and applies automotive paint composition to the painted surface of the vehicle in need of repair. Chip-Mender contends that the language of the claims makes it clear that the "nib" cannot be porous, citing specifically to "the flow of said paint through said passageway, to said nib," which appears in both claim 1 and claim 12, *see* col. 5, ll. 37; col. 6, ll. 19-20; and to "applying a slight pressure to force said nib upward allowing it to open and permit said paint to flow by gravity from said reservoir through said passageway to said nib and transferring to the painted surface of the vehicle," which appears in claim 12, *see* col. 6, ll. 23-27.

In opposition, Sherwin-Williams asserts that Chip-Mender cannot point to any claim language in the '299 patent that excludes fibrous structures from the ordinary and customary meaning of "nib," which Sherwin-Williams notes is defined in the *McGraw-Hill Dictionary of Scientific and Technical Terms* as "a small projecting point." Sherwin-Williams argues that because "nib" is not defined by its structural composition, it should be construed broadly, without any structural limitation.

Sherwin-Williams submits that the '299 patent describes "nib" as both porous and solid because it references three prior art patents, each of which discloses a pen system or device using a porous nib. In the "Background" section, the '299 patent states that "pen nib systems" are shown in U.S. Patent Nos. 5,468,082 ("the '082 patent"-"Hori") and 4,838,723 ("the '723 patent"-"Suzuki"), and that "pen devices using nibs" are described in U.S. Patent No. 4,923,317 ("the '317 patent"-"Bishop"). Sherwin-Williams notes that the '082 patent discloses a paint maker "with a felt tip as a nib"-i.e., a fibrous nib-and also discloses a solid "nib or ball tip;" that the '723 patent discloses a nib that is both porous and fibrous; and that the '317 patent discloses a "porous plastic wear-resistant tip."

Sherwin-Williams contends that because Russo used the Hori, Suzuki, and Bishop references to describe "nib" in the '299 patent, those prior art references are intrinsic evidence. Relying on *Kumar v. Ovonic Battery Co., Inc.*, 351 F.3d 1364 (Fed.Cir.2003), Sherwin-Williams argues that such prior art references may be of "particular value" in construing a disputed claim term because it may indicate not only the meaning of the term to persons skilled in the art, but also that the patentee intended to adopt that meaning.

The court finds that "nib" means "nib" or "a small projecting point." The term "nib" is not explicitly defined in the claims, the specification, or the prosecution history. The nib is identified in claims 1 and 12 as an essential element of the applicator unit. '299 patent, col. 5, ll. 27-31; col. 6, ll. 8-12. The claims also describe the location of the nib-"slidably located in [the] passageway ... [and] including a portion extending from said passageway." *Id.* col. 5, ll. 27-30; col. 6, ll. 8-11. In addition, the claims and specification state that the nib transfers the paint to the painted surface of the vehicle. *Id.*, col. 5, ll. 35-39; col. 6, ll. 17-21; col. 2, ll. 25-28. Thus, in the context of the '299 patent, the nib is the structure of the applicator that contacts and transfers the paint to the surface. There is no dispute regarding the size or shape of the nib, and no dispute that the purpose of the nib is to transfer or apply paint to the painted surface of the vehicle.

Chip-Mender argues that the common meaning of "nib" applies, and that the term requires no construction. The common meanings of "nib" are "the point of a pen" and "a sharp tip or point." *Webster's II New Riverside University Dictionary* (1988). Sherwin-Williams asserts that a "nib" is "a small projecting point." The dictionary definition-"a sharp tip or point"-combined with the language in claims 1 and 12-"including a portion extending from said passageway"-equates with "a small projecting point." The court concludes that both parties agree that the commonly understood meaning applies.

The primary dispute between the parties is whether the nib must be solid or whether it can also be made of a material that is porous or fibrous. The patent does not specify whether the nib is solid or fibrous, and, as noted above, the claims do not define "nib." Sherwin-Williams contends that the nib can be porous or fibrous, based solely on the fact that certain prior art uses the word "nib" to refer to structures that are porous/fibrous.

The court finds, however, that the nib in the '299 patent should not be construed as "porous" or "fibrous," because the specification states that the nib "serves as a regulator of the flow rate of paint composition." '299 patent, col. 2, ll. 10-12. Absent a clear definition in the claims, the specification is "the single best guide to the meaning of a disputed term." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). A porous/fibrous nib would not be effective in regulating the flow of paint, because it would have to absorb paint before it could transfer paint to effectuate the repair to the painted surface. Further support for this construction is found below, in the discussion of disputed terms Nos. 7 and 8.

The court disagrees with Sherwin-Williams' argument that under *Kumar*, the *Hori*, *Suzuki*, and *Bishop* references that disclose "pen nib systems" or "fluid pen devices" with porous and/or fibrous nibs must be taken into account as evidence that Russo intended the '299 patent to include a nib made of a porous/fibrous material. In *Kumar*, the Federal Circuit found a prior art reference cited during the prosecution history of the patent at issue to be controlling, on the grounds that the applicant and the examiner considered the reference to be highly pertinent, and that the reference was discussed extensively and distinguished during the prosecution of the patent. *See* 351 F.3d at 1368. In the present case, however, Sherwin-Williams has not demonstrated that Russo discussed the *Hori*, *Suzuki*, or *Bishop* references extensively during the prosecution of the '299 patent or that Russo embraced those references as applying specifically to the claims at issue. The prosecution history reflects only a discussion regarding whether claims 1-4, 6-9, and 11 were obvious in light of *Kremer* in view of *Saad*, and whether claims 5 and 10 were obvious in light of *Kramer* in view of *Saad*, and further in view of *Nakai*.

4. nib supported by said housing

[10] The term "nib supported by said housing" appears in claim 1 and claim 12. Chip-Mender asserts that it means "*nib confined to said housing*." Sherwin-Williams argues that it means a "*nib in contact with the housing that may or may not be confined to the housing and/or be non-removable*." The parties dispute the meaning of the phrase "supported by." They also dispute whether the nib is removable from the housing or not.

Chip-Mender contends that "supported by" means "confined to," based on the specification—"The nib is preferably constructed to confine the nib to the housing yet permit the nib to slide or float." '299 patent, col. 2, ll. 5-7. Chip-Mender argues that there is no suggestion in the patent that the nib is removable, and asserts that the applicator would not work if the nib were removed, because the paint would flow out of the reservoir and through the passageway and onto the floor if the nib were not there to stop it. Chip-Mender also refers to the prosecution history, and its cancelled claim 26 ("[t]he method of using a sealed paint applicator of claim 12 for the purpose of applying said paint composition of claim 18 to repair the painted surface of the vehicle"), and argues that this cancelled claim shows Russo's intent that the applicator be "sealed" by the nib, which is therefore not removable.

In opposition, Sherwin-Williams asserts that Chip-Mender is attempting to alter the plain meaning of a term

("supported by") through substitution of a narrower term ("confined to"). Sherwin-Williams contends that the plain meaning of "nib supported by said housing" does not require the nib to be "confined" by a housing, and that the term should be construed as also permitting the nib to be removed from the applicator. Sherwin-Williams claims that Chip-Mender is attempting to re-write this claim term by importing a preferred embodiment from the specification.

Sherwin-Williams notes that the '299 patent uses both "support" and "confine" to describe how the nib is housed in the paint applicator. The specification states, "A nib is also found in the present invention, and is slidably *supported by the housing*. The nib is located in the passageway which communicates with the reservoir. The nib is preferably *constructed to confine the nib to the housing* yet permit the nib to slide or float." '299 patent, col. 2, ll. 3-7 (emphasis added). Sherwin-Williams contends that this language discloses that any and all paint applicators described in the '299 patent have a nib that is "supported" by a housing, but that some of those applicators could be further enhanced-i.e., "preferably constructed"-to "confine" the nib in the housing. Sherwin-Williams claims that a person skilled in the art would not view "supported" nibs as synonymous with "confined" nibs, but rather, would view "confined" nibs as a sub-set of "supported" nibs.

With regard to Chip-Mender's citation to the prosecution history, Sherwin-Williams contends that it is impermissible to pursue a claim construction that is equivalent to a cancelled claim. Sherwin-Williams cites *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 312 U.S. 654, 61 S.Ct. 235, 85 L.Ed. 132 (1940), for the proposition that a patentee is not "free to gain the supposed advantage of the rejected claims by a construction of the allowed claims as equivalent to them." *Id.* at 221-22, 312 U.S. 654, 61 S.Ct. 235. Sherwin-Williams asserts that "this axiom was recently reaffirmed" in *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314 (Fed.Cir.2003).

The court finds that "nib supported by said housing" means "nib held in place by said housing." In the portion of the specification cited by the parties, the nib is first described as "slidably supported by the housing" and as "located in the passage way which communicates with the reservoir." '299 patent, col. 2, ll. 3-5. The nib is then described as "preferably constructed to confine the nib to the housing yet permit the nib to slide or float." *Id.*, col. 2, ll. 5-7. The use of the word "preferably" in this portion of the specification does not necessarily identify "confined to the housing" as a preferred embodiment, while allowing for alternative embodiments such as "removable from the housing." "Preferably constructed" refers not just to "confine the nib to the housing," but to the conjunctive, "confine the nib to the housing yet permit the nib to slide or float."

[11] Descriptions of the invention that appear in the specification section are relevant to the construction of the patent. *See SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1342-43 (Fed.Cir.2001). Read together with the previous two sentences, which describe the nib as "slidably supported by the housing" and as "located in the passageway" (which passageway is located inside the housing), with no addition of the word "preferably," these portions of the specification lead to the conclusion that the reference in claims 1 and 12 to a "nib supported by said housing" simply means that the nib is held in place by the housing.

Moreover, there is no indication anywhere in the claims or the specification that the nib is "removable," and Sherwin-Williams has offered no compelling support for its own proposed construction of "nib supported by said housing" as meaning "nib may not be confined to the housing and/or be non-removable." Indeed, the nib would be unable to perform the functions required of it-sealing the applicator and regulating paint flow-

if it were removable.

Finally, the court is not persuaded by Chip-Mender's argument that the court should look at cancelled claim 26 as part of the prosecution history, to establish Russo's intent that the nib be confined in the housing.FN3 The prosecution history is silent with regard to the Examiner's reasons for cancelling claims 23-26, and the Federal Circuit disfavors using ambiguous comments or silence on the part of the examiner or the patentee as evidence to support any particular construction of a claim term. *See Omega Eng'g*, 334 F.3d at 1323-25 (*explicit* statements made by patentee or examiner during patent prosecution may be used to narrow claims); *see also DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1326-27 (Fed.Cir.2001) (refusing to rely on ambiguity surrounding examiner's silence or patentee's lack of argument during prosecution to construe claim terms). Thus, the court does not find that the cancelled claims can serve as intrinsic evidence to support a particular construction of the disputed terms.

FN3. On the other hand, Sherwin-Williams' argument that Chip-Mender is precluded from proposing a claim construction that is the "equivalent" of the cancelled claim is even less meritorious. The purpose of the doctrine of "prosecution disclaimer" is to prevent a patentee from recapturing through claim interpretation meanings he disclaimed during prosecution. *SanDisk Corp. v. Memorex Prods., Inc.*, 415 F.3d 1278, 1286 (Fed.Cir.), *cert. denied*, 546 U.S. 1076, 126 S.Ct. 829, 163 L.Ed.2d 707 (2005). However, prosecution history "cannot be used to limit the scope of a claim unless the applicant took a position before the PTO that would lead a competitor to believe that the applicant had disavowed coverage of the relevant subject matter." *Schwing Gmbh v. Putzmeister A.G.*, 305 F.3d 1318, 1324 (Fed.Cir.2002). Moreover, the applicant's disclaimer must be clear and unambiguous. *See Omega*, 334 F.3d at 1325-26. The Supreme Court's decision in *Schriber-Schroth* is not to the contrary. *See* 311 U.S. at 218, 61 S.Ct. 235 ("Where the patentee in the course of his application in the patent office has, by amendment, canceled or surrendered claims, those which are allowed are to be read in light of those abandoned and an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed."). Here, Russo did not amend, withdraw, or cancel any claims after his initial response to the Examiner's notice of claim rejections.

5. nib slidably located in said passageway

[12] The term "nib slidably located in said passageway" appears in claim 1 and claim 12. Chip-Mender argues that this term means "*slideable nib located in said channel.*" Sherwin-Williams argues that it means "*a rod-shaped structure that moves longitudinally and not rotationally, which may or may not operate in conjunction with a valve and which may or may not be a unitary part.*"

Chip-Mender asserts that the term should be construed using the ordinary meaning of the words. Chip-Mender contends that its proposed construction is consistent with the claims, the specification, and the prosecution history of the '299 patent.

Sherwin-Williams claims that Chip-Mender is attempting to narrow the scope of the claims by excluding any passageway that operates in conjunction with, or as, a valve. Sherwin-Williams contends that the claims do not *exclude* a valve in the passageway, and furthermore, that the specification shows that the nib located in the passageway operates as a "flow-restricting valve."

Sherwin-Williams also argues that figure 2 from the '299 patent is "essentially a copy" of figure 8 from U.S. Patent No. 4,812,071 ("the '071 patent" or "Batra"-a patent for a "Correction Fluid Pen," cited by Russo in

the '299 patent as prior art). He notes that the '071 patent explains that the pressing of the applicator against the page to be corrected "helps constrict any additional flow of fluid through orifice 133 to avoid the discharge of too much fluid." Citing Kumar, 351 F.3d at 1368, Sherwin-Williams contends that the '071 patent is intrinsic evidence. Sherwin-Williams suggests that since '071 patent specification applies to the functioning of a "valve," and since it is similar to the description of the functioning of the invention disclosed in the '299 patent, a person skilled in the art would not read the claim language to exclude a valve structure in the passageway of the '299 patent.

Sherwin-Williams also argues that "slidably located" excludes spherical nibs. Sherwin-Williams asserts that Chip-Mender's '663 patent-the continuation-in-part patent-removed the term "slidably" to broaden the claim language, added new disclosure describing a nib that may be "cylindrical, conical, spherical, or any suitable shape." Sherwin-Williams argues that the effect of this broadening only after describing a spherical nib proves that "slidably located" in the '299 patent excludes such spherical nibs.

The court finds that "nib slidably located in said passageway" means "slidable nib located in said channel." "Slidably located" in the passageway means that the nib is located or positioned in the passageway or channel, and that it moves, or "slides," within the passageway. The court finds no indication in the claims, the specification, or the prosecution history that any meaning other than the ordinary meaning should apply.

Although Sherwin-Williams previously argued that a nib is "a small projecting point," it now attempts to add limitations ("rod-shaped structure that moves longitudinally and not rotationally" and "which may or may not operate in conjunction with a valve," and "which may or may not be a unitary part"). As discussed above, the usage of "nib" and "passageway" in the claims and specification shows that those terms require no construction beyond their ordinary dictionary definitions. The specification indicates that the nib operates as "a regulator of the flow rate of paint composition." '299 patent, col. 2, ll. 10-12. However, apart from Russo's mention of the '071 patent as prior art (one of three "fluid pen devices using nibs"), there is no other support in the claims, the specification, or the prosecution history for the addition of limitations regarding the nib operating "in conjunction with a valve," or possibly being a "unitary part."

Finally, with regard to the '071 patent reference, the court is not persuaded by Sherwin-Williams' argument. As noted above, Kumar found a prior art reference cited during the prosecution history of the patent at issue to be controlling, on the grounds that the applicant and the examiner considered the reference to be highly pertinent, and that the reference was discussed extensively and distinguished during the prosecution of the patent. *See* 351 F.3d at 1368. As with the Hori, Suzuki, and Bishop references, there is no indication in the prosecution history that Russo discussed the Batra reference extensively during the prosecution of the '299 patent or that Russo embraced that reference as applying specifically to the claims at issue.

6. automotive paint composition

[13] The term "automotive paint composition" appears in claim 1 and claim 12. Chip-Mender asserts that it means *paint composition made for use on automobiles*. Sherwin-Williams contends that it means "*Pigment and solvent. The pigment of the paint composition may be of any type sufficient to provide a coating property for repair or damage to a painted surface. That is to say, the pigments may provide a decorative function to contribute to opacity, color, and gloss control. In addition, pigments also provide protective qualities to the final paint composition after it has hardened. In this regard, pigments may be of any class, including white hiding pigments, extender pigments, black pigments, and any other color pigments known in the art. The automotive paint composition includes both lacquers and enamels, i.e., paint composition with a*

catalyst or drying agent."

Chip-Mender argues that the term "automotive" appears throughout the claims, the specification, and the file history of the '299 patent because it is part of the claimed invention. Chip-Mender complains that Sherwin-Williams' proposed construction would convert the simple "automotive paint composition" of the '299 patent into essentially any paint composition to be used on any surface. Chip-Mender accuses Sherwin-Williams of attempting to broaden the claims of the patent to read on a variety of prior art references, such as correction fluid pens.

Chip-Mender asserts that the claims and specification of the '299 patent, as well as the prosecution history, all require that the disclosed paint composition be made for or designed for use on automobiles. Chip-Mender argues that there is no suggestion in the intrinsic evidence that the claimed paint composition be made for anything other than an automobile.

In opposition, Sherwin-Williams argues that Russo admitted that he did not invent any new paint composition, and that the paint described in the '299 patent is commercially available. Thus, Sherwin-Williams asserts, Russo's amendment of the claims (following the initial rejection) by adding the terms "automotive" or "vehicle" did not distinguish over prior art paint compositions.

Sherwin-Williams also notes that the specification of the '299 patent defines the automotive paint composition generically as "pigment" and "solvent" (citing '299 patent, col. 2, ll. 12-14), and also contains the following description, which Sherwin-Williams has incorporated into its proposed construction:

The pigment of the paint composition may be of any type sufficient to provide a coating property for repair of damage to a painted surface. That is to say, the pigments may provide a decorative function to contribute opacity, color, and gloss control. In addition, pigments may also provide protective qualities to the final paint composition after it has hardened. In this regard, pigments may [be] of any class, including white hiding pigments, extender pigments, black pigments, and any other color pigments known in the art.

Id., col. 2, ll. 40-48.

Sherwin-Williams contends that although Russo argued during the prosecution that his paint composition excluded catalysts, the '299 patent discloses an "enamel" paint as an example of the claimed automotive paint composition (citing "Example 1" in the '299 patent, col. 4, ll. 41-42). Sherwin-Williams claims that enamel paints include those that harden by a catalytic reaction in which a drying agent in the paint reacts with air. Thus, Sherwin-Williams asserts, the '299 patent inherently discloses an automotive paint composition with catalysts and driers.

The court finds that "automotive paint composition" means "paint composition formulated for use on vehicles." Sherwin-Williams' proposed addition of "pigment and solvent" is unnecessary, as both claim 1 and claim 12 include the limitation "including ... pigment and ... solvent" immediately following the term "automotive paint composition." Thus, including "pigment and solvent" as part of the construction would be redundant.

The remainder of Sherwin-Williams' proposed construction is unnecessary. The portion of the proposed construction that is taken from the specification, col. 2, ll. 40-48, describes the decorative function and protective qualities of the pigments, and states that the pigments "may be of any class," including "any color

pigments known in the art." A person skilled in the art would understand "automotive paint" to have certain decorative function and protective qualities, and to include many classes and colors.

With regard to the question whether "automotive paint" includes catalysts, the court notes that the prosecution history indicates that Russo disclaimed paint compositions including catalysts, and that the claims were allowed on that basis. Prosecution History, CM 00061, 00069-70. In addition, in discussing the viscosity of paint composition, the specification states in the "Preferred Embodiments" that "driers, typically used in paints, hinder the free flow of paint from [the] applicator." The reference in Example 1 to "enamel paint" is not explained in the patent, and neither party provides any documentary extrinsic evidence regarding the composition of "enamel paint." It appears, however, that the device described in Example 1 did not effect an acceptable repair to the chipped surface of the automobile. Thus, it is questionable whether the reference to "enamel paint" in Example 1 is of consequence in determining the proper construction of "automotive paint."

There is no indication in the claims or specification that the "automotive paint" in the '299 patent is different than ordinary automotive paint, except with regard to the use of paint of a particular viscosity range (not at issue in the present proceeding), as described in the claims and specification. It is not necessary for the court to construe "automotive paint" as anything other than "paint composition formulated for use on vehicles."

7. flow of said paint through said passageway, to said nib

[14] The term "flow of said paint through said passageway, to said nib" appears in claim 1 and claim 12. Chip-Mender argues that the term means "*flow of said paint through said channel to, not through, said nib.*" Sherwin-Williams asserts that it means "*flow of paint through said passageway and to said nib. The paint may then travel through and/or around the nib in being transferred to the painted surface of a vehicle.*"

The parties do not dispute the plain meaning of "flow of said paint through," and while Chip-Mender defines "passageway" as "channel," and Sherwin-Williams stays with the original "passageway," the distinction between "passageway" and "channel" is not a point of contention. The only dispute is whether "flow ... to said nib" means "flow ... to, not through" the nib, or "flow ... to said nib [and] then ... through and/or around the nib."

Chip-Mender argues that "to the nib" means exactly what it says, and that defining "to the nib" as "to and/or through the nib" would be inconsistent with the claims and the specification of the '299 patent, because it might suggest that the claimed "nib" could be porous or that paint could flow "through" it. Chip-Mender also contends that the wording of the claim elements is controlling—noting that when the patent applicant meant "through," he said "through," not "to" (*e.g.*, specifying "through said passageway" in element (d) of claims 1 and 12, rather than "to said passageway").

Chip-Mender asserts further that the language of element (e) of claim 12—"allowing it to open"—indicates that the nib must be non-porous, because something that is porous is already "open" by definition, and need not be "opened" to allow paint to flow. Thus, Chip-Mender argues, the nib must be non-porous in order that it can be "opened" to allow the paint to flow. Accordingly, nothing can flow "through" it. Chip-Mender asserts that the fact that the nib must be able to open and must regulate paint flow is established throughout the specification of the '299 patent (citing '299 patent, col. 2, ll. 8-12, a description of the nib serving "as a regulator of the flow rate of paint composition"). Chip-Mender notes that the phrase "to the nib" appears

repeatedly in the specification, without a single suggestion that what is really meant is "through the nib."

Finally, Chip-Mender points again to its cancelled claims 23-26, referring to the claim limitations "mov[ing] said nib from closed position to open" and "method of using sealed paint applicator." Chip-Mender also contends that its related Canadian patent explains in its abstract that the patent discloses "[a] paint applicator system utilizing a paint reservoir which is connected to a moveable nib which permits paint to pass through the reservoir to the exterior of the nib said nib serving to start and stop the flow of paint composition out of the reservoir, through the output end of the passageway onto the painted body."

In opposition, Sherwin-Williams relies on dictionary definitions of "to" from the *American Heritage Dictionary*- "in a direction toward; so as to approach or come near; in the direction of, so as to reach or terminate in; reaching as far as; through or terminating in"-and argues, based on these definitions, that the ordinary meaning of "to" does not exclude "through." Sherwin-Williams claims, for example, that driving "to" San Francisco does not exclude driving "through" San Francisco. Sherwin-Williams also argues that even if "to" does not expressly include "through," as in the idiomatic phrase "rotten to the core," the word "to" clearly does not exclude paint flowing "through" the nib. Sherwin-Williams contends that "to said nib" does not limit paint flow after the paint reaches or comes into contact with the nib, arguing that the claim term requires only that paint flow through the passageway and to the nib, with no limitation as to whether the paint also travels through and/or around the nib in being transferred to the painted surface.

Sherwin-Williams argues further that "open" in claim 12 does not define "nib" as solid, and that in any event, the term "open" can be applied to applicators with fibrous or porous nibs. Sherwin-Williams contends that it is the applicator that is "open" in claim 12, not the nib, but that even if Chip-Mender is correct that a porous nib is always "open," that would mean that a solid nib is always closed and could never be "open," and claim 12 could never be infringed by a solid nib.

Sherwin-Williams also asserts that the descriptions in the specification of a nib that "serves as a regulator" or that "tends to seal" are preferred embodiments that appear either in the "Preferred Embodiments" section of the specification, or following the "preferably constructed" language in the specification. Sherwin-Williams claims that none of the terms that Chip-Mender cites as support for its "solid nib" appear anywhere in the claim language-"regulator," "tends to seal," "sealed paint applicator," or "moved said nib from closed to open position." Sherwin-Williams argues that all these are terms that the inventor could have used in the claims but chose not to, and asserts that the court must construe the claims as written, not as the patentee wishes he had written them.

Finally, Sherwin Williams argues that cancelled dependent claims 23-26 and the Canadian patent preclude either a solid nib or a seal. Sherwin-Williams claims that the fact that claims 23-26 specifically claimed a seal, but did not issue because they were cancelled, supports the proposition that Chip-Mender forever abandoned the ability to have claims limited to just a sealed applicator. Sherwin-Williams argues that these cancelled claims serve to emphasize that a seal or solid nib could have been, but were not, specified in the claims. Sherwin-Williams claims that under either the doctrine of claim differentiation FN4 or the common law doctrine of *expressio unius est exclusio alterius*, FN5 solid or sealed nibs are not specified or required in the patent.

FN4. Under the doctrine of claim differentiation, two claims of a patent are presumptively of different scope. *Kraft Foods, Inc. v. Int'l Trading Co.*, 203 F.3d 1362, 1366 (Fed.Cir.2000). It isn't clear (and Sherwin-Williams does not elucidate) how the doctrine of claim differentiation applies here with regard to

cancelled claims 23-26.

FN5. This "maxim of interpretation" holds that "to include or express one thing implies the exclusion of the other, or of the alternative.... For example, a rule that 'each citizen is entitled ...' implies that noncitizens do not share in the entitlement." Bryan A. Garner, *A Dictionary of Modern Legal Usage* (Oxford, 2d ed., 2001). Sherwin-Williams does not explain how this maxim applies here.

The court finds that "flow of said paint through said passageway, to said nib" means "flow of said paint through said channel to, not through, said nib." The central argument between the parties with regard to this claim term involves whether the paint flows "through" the nib.

There is no support anywhere in the patent for a construction of "to the nib" as meaning "through the nib." The court notes in particular that where the patentee meant to say "through" in the claims, as in "through the passageway," he said "through." See '299 patent, col. 5, ll. 35-39; col. 6, ll. 17-20 ("flow of said paint through said passageway, to said nib"). Similarly, the specification describes the paint flowing "from the reservoir to the passageway and outwardly from the housing at the nib." *Id.*, col. 2, ll. 9-10. This indicates that the paint flows from the reservoir to the passageway, then continues to the nib-i.e., through the passageway. Once it reaches the nib, flows "outwardly" from the housing.

[15] The preferred embodiment is also consistent with this construction of "to the nib." "[W]hile it is of course improper to limit the claims to the particular preferred embodiments described in the specification, the patentee's choice of preferred embodiments can shed light on the intended scope of the claims." *Astrazeneca AB v. Mut. Pharm. Co.*, 384 F.3d 1333, 1340 (Fed.Cir.2004). A patent applicant need not expressly state "my invention does not include X" to indicate his exclusion of X from the scope of his patent. *Id.*

The "Detailed Description of the Preferred Embodiments" section of the '299 patent describes the operation of the paint applicator unit shown in Fig. 2 as follows:

A passageway 28 is included which permits the paint composition 24 to flow from reservoir 22 to chamber 30, and to a nib or stylus 32 is slidable within chamber 30 and biased downwardly by spring 34 into such a position, nib 32 tends to seal opening 20 to chamber 30. However, when an upward force is applied to the tip of nib 32, force arrow 36, nib slides upwardly and allows paint composition 24 to flow from reservoir 22, through passageway 28 and chamber 30 and outwardly from housing 18, arrows 38 and 40.

This preferred embodiment describes the paint flowing down through the passageway, to the nib and "outwardly" from the housing.

The primary dictionary definition of "to"-"in a direction toward; so as to approach or come near"-is the only definition that is consistent with the intrinsic record. While "to" has literally dozens of meanings-depending on the semantic context or the syntactical structure of a given phrase-when used in conjunction with a verb that expresses movement or action (such as "flow"), it does not have the same meaning as "through." The word "to" when used with a verb that expresses movement (such as "flow") means "in a direction toward." See, e.g., *Websters II New Riverside University Dictionary*. "Through," on the other hand, which also has dozens of meanings, generally signifies "in one side and out the other side of" or "in the midst of" or "by

means of." Id.

8. applying a slight pressure to force said nib upward allowing it to open and permit said paint to flow by gravity from said reservoir through said passageway to said nib and transferring to the painted surface of the vehicle

[16] This lengthy term consists of most of element (e) of claim 12. The only portion of the element that the parties do not include are the first eight words ("by placing said applicator on painted surface and"). However, while there appear to be at least six words or phrases for which the parties offer competing proposed constructions, all have been addressed in the discussions of the previous disputed terms, with the exception of two.

Chip-Mender contends that this term means "*applying a slight pressure to force said nib into the open position to regulate said paint flow by gravity from said reservoir through said channel to, not through, said nib and transferring to the painted body of an automobile.*" Sherwin-Williams argues that it means "*applying a slight pressure to force said nib upward allowing the applicator to open and permit said paint to flow by gravity from said reservoir through said passageway and to said nib. The paint may then travel through and/or around the nib in being transferred to the painted surface of a vehicle.*"

Chip-Mender proposes a construction for six separate words or phrases, while Sherwin-Williams uses the original words for four of those words or phrases, and provides alternatives for two. That is, Chip-Mender construes "permit said paint to flow" as "*regulate paint flow*"; construes "passageway" as "*channel*"; construes "surface" as "*body*"; and construes "vehicle" as "*automobile*," while Sherwin-Williams stays with the original words or phrases ("permit said paint to flow," "passageway," "surface," and "vehicle"). As for the other two phrases, Chip-Mender argues that "allowing it to open" means "*forcing the nib to open*," while Sherwin-Williams claims that it means "*allowing the applicator to open*." Also, Chip-Mender contends that "paint flow to said nib" means "*paint flow to, not through, said nib*," while Sherwin-Williams asserts that it means that the "*paint may travel through and/or around nib*."

There appears to be no dispute that "surface" means "body." The court has already addressed the construction of "passageway" and "painted surface of a vehicle," as well as the dispute regarding whether the paint flows "to" the nib, or flows "to and/or through" the nib. Thus, the only disputes concern the meaning of "upward allowing it to open" and "permit said paint to flow." The parties disagree as to whether the "it" in "allowing it to open" refers to the nib or to the applicator, and whether "permit said paint to flow" means that the nib regulates the paint flow.

With regard to whether "allowing it to open" is intended as a reference to the nib or the applicator, Chip-Mender argues that the reference is to the nib. Chip-Mender points to the '299 patent specification, which states that the "paint flows from the reservoir to the passageway and outwardly from the housing at the nib, which serves as a regulator of the flow rate of paint composition." '299 patent, col. 2, ll. 8-12. Chip-Mender argues that because the specification refers to the nib as the "regulator" of the paint flow, the only possible conclusion is that the nib has an "open" position and a "closed" position.

Chip-Mender also contends that the prosecution history shows that the nib regulates paint flow, pointing to cancelled claims 23-26, which recite "to move said nib from closed position," "moving said nib from closed position to open, and by squeezing said applicator to increase the flow of said paint to fill a chip or scratch and repair the painted surface of a vehicle;" and "[t]he method of using a sealed paint applicator of claim 12

for the purpose of applying said paint composition of claim 18 to repair the painted surface of the vehicle."

In opposition, Sherwin-Williams argues that "allowing it to open" means "allowing the applicator to open." Sherwin-Williams refers to its discussion in the previous section on "flow of said paint through said passageway to said nib," and argues that Chip-Mender is improperly attempting to import limitations from the preferred embodiment. As for Chip-Mender's citation to claims 23-26, Sherwin-Williams notes that those claims, which specifically recited a seal and closed/open positions, were cancelled. Sherwin-Williams also contends that Chip-Mender recognized that the '299 patent did not disclose or claim a "sealed" applicator, and for that reason added that disclosure to the '663 patent, which has been withdrawn from this suit.

The court finds that "allowing it to open" means "moving the applicator into the open position." The parties agree that the nib is a small point that projects from the end of the applicator. It is "supported by" the housing and "slidably located" in the passageway which is inside the housing. When pressure is applied and the nib is forced upward (because pressure is being applied in a downward direction), what "opens" is the end of the applicator, not the nib itself. More accurately, the applicator is forced into an "open position."

At that moment, the paint, which flows from the reservoir through the passageway-either by gravity or because of a squeezing pressure on the housing-is able to continue its flow to the end of the nib, which then transfers the paint to the surface of the vehicle. The transfer of paint to the vehicle surface can be accomplished only when the nib is moved upward because of the pressure applied to it, because the upward movement of the nib creates a space between the nib and the end of the applicator, through which the paint can then continue its flow to the tip of the nib, which is in contact with the vehicle surface.

In addition, for the reasons stated above with regard to "flow of said paint through said passageway, to said nib," the court does not agree that the construction should include the second part of Sherwin-Williams' proposed construction-that the paint "*may then travel through and/or around the nib in being transferred to the painted surface of a vehicle.*"

9. squeezing said housing

[17] The term "squeezing said housing" appears only in element (f) of claim 12. Chip-Mender argues that the term means "*squeezing said housing*" -that no independent construction is required. Sherwin-Williams contends that "squeezing said housing" means "*providing sufficient force by a person's hand to deform the housing and force paint out of the applicator.*"

Chip-Mender argues that the meaning of the term "squeezing said housing" is clear when the term is viewed in the context of the specification. Chip-Mender notes that the specification states that "[t]he housing may be formed of a flexible material such that squeezing or applying pressure to the same also applies pressure to the paint composition found within the reservoir" (citing ' 299 patent, col. 1, ll. 62-col. 2, ll. 2). Chip-Mender also cites the description of the preferred embodiment shown in Fig. 1, (citing *id.*, col. 3, ll. 41-46 and Fig. 1). Chip-Mender asserts that even Sherwin-Williams' '548 patent uses the terms "squeezing" and "housing" in the ordinary way (referring to claim 20 of that patent, "the housing comprises a resilient material capable of being squeezed to apply pressure to paint composition positioned in said reservoir and thereby increase a rate of flow of the paint composition").

In opposition, Sherwin-Williams asserts that Chip-Mender does not dispute that "squeezing said housing"

should be construed to involve a force no greater than a person's hand. Thus, Sherwin-Williams argues, Chip-Mender essentially agrees with Sherwin-Williams' proposed construction.

The court finds that "squeezing said housing" means "squeezing said housing." No construction is necessary, as both sides agree that "squeezing" means "squeezing" or "applying pressure." Sherwin-Williams' proposed limitation-that the squeezing force be applied by a person's hand-is unnecessary. Moreover, there is nothing in the intrinsic record that would require that "squeezing" be limited in this manner.

The '299 patent discloses a small paint-applicator system, designed to touch up small chips or scratches on vehicles such as automobiles. The specification describes the invention as "utiliz[ing] a housing that is preferably of a size and proportion to be hand held." '299 patent, col. 1, ll. 64-65. Despite the use of the word "preferably," there is no indication anywhere in the patent that the applicator is not intended to be hand-held. Nevertheless, Chip-Mender is also correct that the "squeezing by hand" limitation does not appear anywhere in the patent.

In addition, the additional language that Sherwin-Williams proposes- *sufficient force ... to deform the applicator and force paint out of the applicator*-is simply a paraphrase of the limitations that follow "squeezing said housing" in claim 12. That subsection of the claim states, "squeezing said housing to increase flow of said paint from said reservoir through said passageway to said nib and transferring to the painted surface of the vehicle." *Id.*, col. 6, ll. 30-33. Logically, the flow will not increase when the housing is squeezed unless the squeezing "deforms" the housing. If the housing were rigid, the "squeezing" would not have the effect of "increasing the flow" of the paint or forcing the paint out of the applicator. It is unnecessary to add the additional language proposed by Sherwin-Williams, as that meaning is contained in the limitations that follow "squeezing said housing" in claim 12.

CONCLUSION

In accordance with the foregoing, the court construes the disputed terms as follows:

1. "Painted surface of a vehicle" means "**any vehicle surface with paint.**"
2. "Said passageway communicating with said reservoir" means "**said channel open to said reservoir.**"
3. "Nib" means "**nib**" or "**a small projecting point.**"
4. "Nib supported by said housing" means "**nib held in place by said housing.**"
5. "Nib slidably located in said passageway" means "**slidable nib located in said channel.**"
6. "Automotive paint composition" means "**paint composition formulated for use on vehicles.**"
7. "Flow of said paint through said passageway, to said nib" means "**flow of said paint through said channel to, not through, said nib.**"
8. "Applying a slight pressure to force said nib upward allowing it to open and permit said paint to flow by gravity from said reservoir through said passageway to said nib and transferring to the painted surface of the vehicle" means "**applying a slight pressure to force said nib upward so that applicator is in an open**

position, to regulate said paint flow by gravity from said reservoir through said channel to, not through, said nib and transferring to the painted surface of a vehicle."

9. "Squeezing said housing" means "**squeezing said housing.**"

IT IS SO ORDERED.

N.D.Cal.,2006.

Chip-Mender, Inc. v. Sherwin-Williams Co.

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