

United States District Court,
N.D. California.

The TONYTAIL COMPANY, INC., a Delaware corporation,
Plaintiff.

v.

CONAIR CORPORATION, a Delaware corporation, Scunci Intl., Ltd., a Delaware corporation, Rite Aid, a Delaware corporation, L & N Sales & Marketing, Inc., a Pennsylvania corporation, and Does 1-10, inclusive,
Defendant.

No. C 07-05895 WHA

May 30, 2008.

Anne-Leith Ferguson W. Matlock, Matlock Law Group, A Professional Corporation, Walnut Creek, CA, for Plaintiff.

Thomas F. Fitzpatrick, Goodwin Procter LLP, Menlo Park, CA, Aron Mark Oliner, Duane Morris, LLP, San Francisco, CA, for Defendant.

CLAIM CONSTRUCTION ORDER

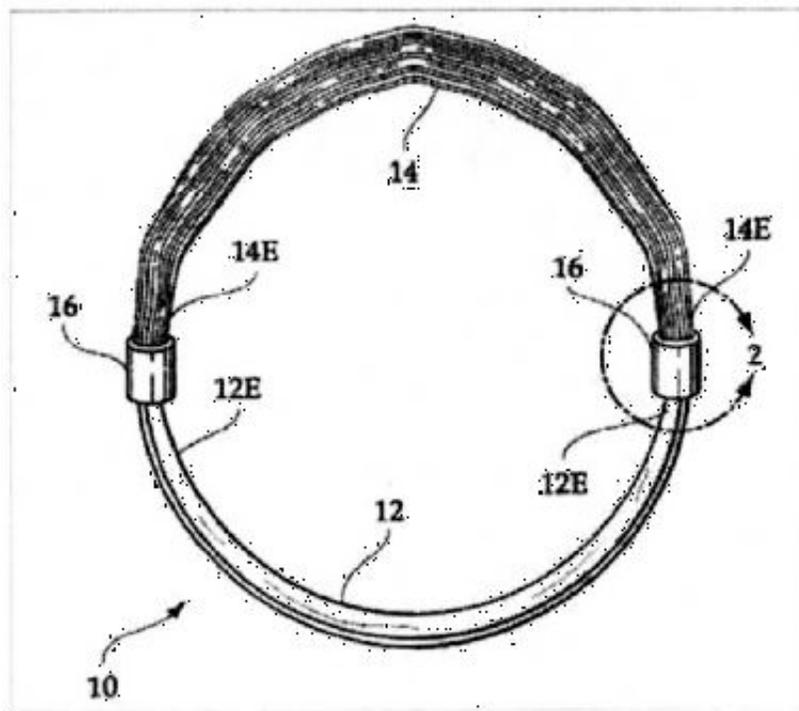
WILLIAM ALSUP, District Judge.

INTRODUCTION

This is a claim construction order for United States Patent No. 6,263,884 B1. This order addresses five phrases selected for construction by the parties. A technology tutorial, as well as a full round of briefing and a hearing, preceded this order.

STATEMENT

The '884 patent was filed by inventor Mia Minnelli along with related design patents U.S. Design Patent No. D413,693 and U.S. Design Patent No. D413, 693. Minnelli later assigned all three patents to plaintiff The Tonytail Company, Inc. The '884 patent itself is directed to an apparatus and method for binding a ponytail- *i.e.*, a ponytail holder. Prior art ponytail holders included "elastic bands," "hair clips," and "ribbons" (col.1:10-18). The main disadvantage of the prior art ponytail holders was their "unnatural appearance"- *i.e.*, they were always noticeable when in the hair (col.1:27). The '884 patent teaches an improved ponytail holder which has a natural hair appearance.



The device disclosed in the invention has two main parts that are connected together with connectors 16: an elastic band 12 and synthetic fibers 14. The synthetic fibers are selected such that they match the color and texture of the user's hair. The user places the ponytail holder around their hair and subsequently twists the elastic band to form a secondary loop that is also placed around the user's hair (col.2:64-3:4). This process is repeated until the device is wrapped tightly around the user's hair. The synthetic fibers may then be pulled over the elastic band to cover the elastic band and connectors. The desired end result is a ponytail hairstyle bound by what appears to be the user's natural hair (col.3:20-22).

This action was filed on November 20, 2007, alleging that defendants infringed the 'D693 and 'D239 patents and induced infringement of the '884 patent. A technology tutorial and hearing was held on May 28, 2008. Trial is set for February 2, 2009.

ANALYSIS

1. LEGAL STANDARD.

Claim construction is a matter of law to be decided by a judge, not a jury. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 388, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). Courts must give words in the claims their ordinary and customary meaning, which "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 v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed.Cir.2005) (en banc).

Where this ordinary and customary meaning is not immediately clear, courts must primarily look to intrinsic evidence (*i.e.*, the claims, the specification, and the prosecution history) to determine the meaning. *Id.* at 1314. With respect to the specification, although a difficult task, a court must distinguish "between using the specification to interpret the meaning of a claim and importing limitations from the specification into the claim." *Id.* at 1323. The latter is not permissible.

Although courts have the discretion to consider extrinsic evidence, including expert and inventor testimony, dictionaries and scientific treatises, such evidence is "less significant than the intrinsic record in determining the legally operative meaning of claim language." *Id.* at 1317 (citation omitted). "The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." *Id.* at 1315. "Nonetheless, any articulated definition of a claim term ultimately must relate to the infringement questions it was intended to answer." *E-Pass Tech., Inc. v. 3Com Corp.*, 473 F.3d 1213, 1219 (Fed.Cir.2007) (citing *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1326 (Fed.Cir.2006)).

2. DISPUTED CLAIM TERMS AND PHRASES.

Plaintiff and defendants did not stipulate to any definitions prior to the hearing. The parties jointly selected five phrases for construction at this time. Those five phrases are: (1) "an elastic band having a pair of elastic band ends;" (2) "synthetic hair fibers having an appearance similar to the ponytail and having a pair of synthetic hair fiber ends;" (3) "the synthetic hair fiber ends joined to the elastic band ends;" (4) "to form a closed loop;" (5) "covering the elastic band with the synthetic hair fibers so that the outward appearance of the device is formed solely by the synthetic hair fibers." Each of the disputed phrases appeared in claim 4, which recited (col 4:15-29):

A hair binding method, for use by a person having a ponytail having a ponytail end, for securing said ponytail, using a device comprising *an elastic band having a pair of elastic band ends, synthetic hair fibers having an appearance similar to the ponytail and having a pair of synthetic hair fiber ends, the synthetic hair fiber ends joined to the elastic band ends to form a closed loop*, comprising the steps of:

encircling the ponytail with the device by inserting the ponytail end through the closed loop of said device;

tensioning the device around the ponytail by doubling up the device; and

covering the elastic band with the synthetic hair fibers so that the outward appearance of the device is formed solely by the synthetic hair fibers.

Because the parties' dispute over claim construction essentially boils down to a disagreement over the terms "the synthetic hair fiber ends joined to the elastic band ends" and "to form a closed loop," this order will address those terms first.

A. "The Synthetic Hair Fiber Ends Joined to the Elastic Band Ends" and "To Form a Closed Loop."

Defendants propose the term "the synthetic hair fiber ends joined to the elastic band ends" should mean "wherein one of the elastic band ends is permanently joined with one of the synthetic hair fiber ends, and the other of the elastic bands is permanently joined with the other of the synthetic hair fiber ends." Plaintiff contends the term should mean "the synthetic hair fiber ends joined to the elastic band ends."

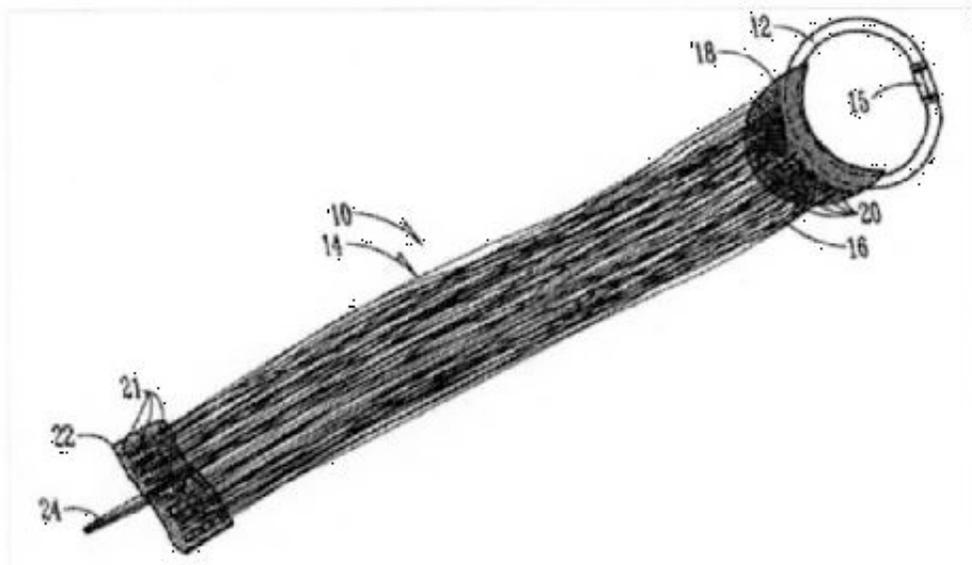
With respect to the term "to form a closed loop," defendants say it should mean "to form a single unbroken ring" while plaintiff proposes the term should mean "to take on a closed loop shape." For the reasons discussed below, plaintiff's constructions are entirely unsupported by the intrinsic evidence and must therefore be rejected.

Under plaintiff's construction of these terms-as well as all the other disputed terms-the claims would necessarily cover a ponytail holder whose elastic band attaches to only one end of the synthetic fibers. This construction, however, is untenable in light of the '884 specification and its prosecution history. Significantly, the '884 patent expressly cited and distinguished a prior art reference, the Brown '211 patent, which claimed plaintiff's desired construction (col.1:31-40):

U.S. Patent No. 5,899,211 to Brown discloses an apparatus and method for securing a ponytail. Brown uses a device which employs an elastic loop which can secure around a ponytail, and a length of hair which is attached to the elastic loop at one end, but is free at its opposite end.

While these units may be suitable for the particular purpose employed, or for general use, they would not be as suitable for the purposes of the present invention as disclosed hereafter.

Below is a figure of the single embodiment taught in Brown '211 patent.



As shown above, the two ends of the elastic band 12 are connected to one another and the elastic band is only connected to one end of the synthetic hair 14. The Brown patent predated the '884 by roughly two years and plaintiff does not dispute that it was the first reference to teach the use of an elastic band combined with synthetic hair to wrap the user's natural hair.

Plaintiff now maintains that the terms "the synthetic hair fiber ends joined to the elastic band ends" and "to form a closed loop" should be collectively construed to mean that the elastic band need only connect to one end of the synthetic hair "to take on a closed loop shape." It is not entirely clear what plaintiff means by "closed loop shape," but plaintiff does argue that the term does not require the loop to be continuous or unbroken. Plaintiff cites to no support, besides argument, to defend its position. The specification describes only a *single* embodiment of the invention. That embodiment is shown again below.

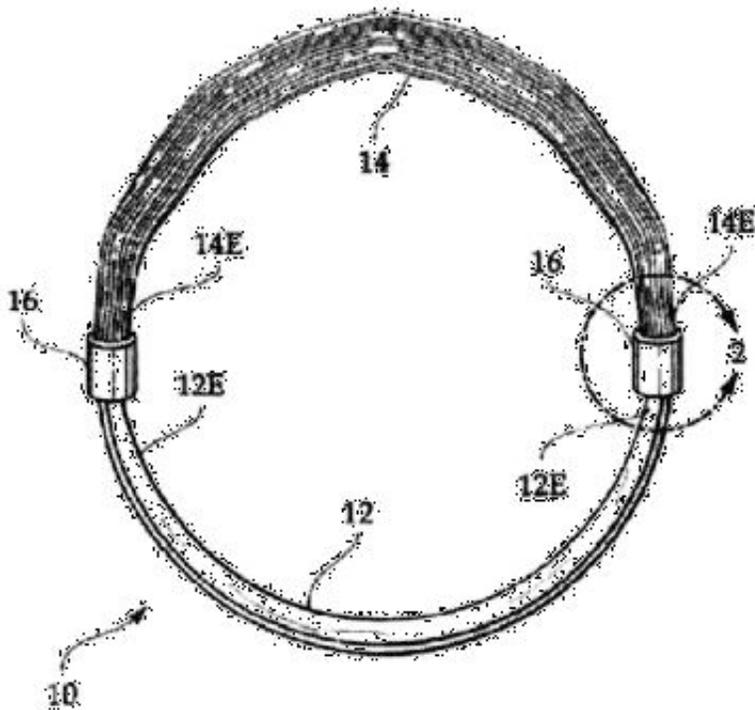


FIG. 1

The specification stated (col.2:24-32):

FIG. 1 illustrates a device for binding a ponytail, comprising an elastic band 12, and a group of synthetic hair fibers 14. The elastic band 12 has a pair of elastic band ends 12E. The synthetic hair fibers 14 are all of substantially the same length, and collectively have a pair of synthetic hair fiber ends 14E. A pair of connectors 16 are used to *permanently join each one of the elastic band ends 12E to one of the hair fiber ends 14E*. Accordingly, the synthetic hair fibers 14 and elastic band 12S together *form a closed loop* (emphasis added).

Despite this clear and unambiguous language, plaintiff now argues that each of the elastic band ends do not have to connect to the ends of the synthetic hair. Even more, plaintiff maintains that the elastic band ends and the synthetic hair ends do not have to be connected to form a closed and continuous loop. These contentions are clearly incorrect. The specification further stated (col.2:45-56):

Referring to FIG. 1, each connector 16 is a sleeve having a pair of connector open ends 18, and one of the synthetic hair fiber ends 14E is inserted into one of the connector open end 18E. Once inside the connector, the synthetic hair fibers and elastic band are *fused* therein using heat, adhesives, chemicals, mechanical friction, or any other suitable means.... As seen in Fig. 1, using two connectors 16 *completes the closed loop* to form the binding device 10 (emphasis added).

Plaintiff's proposed constructions directly contradict this language. The single embodiment taught in the specification describes a ponytail holder with elastic band ends that are permanently joined to synthetic hair fiber ends to form a continuous and closed loop.

The '884 prosecution history is similarly unresponsive of plaintiff's construction. In response to an office action, the patentee amended the term "wherein each of the elastic band ends is permanently joined with one of the synthetic hair fiber ends" of independent claim 1 to recite that "one of the elastic band ends is permanently joined with one of the synthetic hair fiber ends, and the other of the elastic band ends is permanently joined with the other of the synthetic fiber ends ..." (Fitzpatrick Decl. Exh. E). Although the amendment was made in regard to claim 1, "[o]ther claims of the patent in question, both asserted and unasserted, [are] valuable sources of enlightenment as to the meaning of a claim term." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed.Cir.2005). Here, independent claim 1 covers a hair-binding apparatus while independent claim 4 covers a hair-binding method. Although claim 1 is not currently being construed, it only helps to show that plaintiff's construction is unworkable.

Plaintiff next argues that it would be a mistake to limit the claims of the '884 to a single embodiment because the specification in fact describes several possible embodiments of the invention. In support of its argument, plaintiff cites to a single line recited in the "Summary Of The Invention" section of the specification (col.1:53-56):

The invention is a ponytail binding system, for use by a person having a ponytail end, using a device comprising synthetic hair fibers joined to an elastic band to form a closed loop.

Plaintiff maintains that because this sentence does not require the elastic band ends to be connected to the synthetic fiber ends that a number of embodiments of the invention are possible. This argument is most unconvincing. If plaintiff's argument were accepted then nearly all patents would necessarily cover anything liberally construed to fall under the summary regardless of what is actually taught by the specification. Moreover, the '884 specification is a little over one page in length. (For this, we may thank the patentee.) The entire description of the invention centers around a single embodiment. No other embodiments are taught. As the Federal Circuit has held in *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1341 (Fed.Cir.2001):

Where the specification makes clear that the invention does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.

In light of the specification's clear-cut language, plaintiff's constructions must be rejected. Defendants' constructions are heavily supported by all the intrinsic evidence except that their proposed construction of the term "to form a closed loop" unnecessarily is limited to a "ring" when the specification includes no such limiting language. It should also be clear that the claimed invention consists of only one single loop.

Accordingly, this order finds the term "the synthetic hair fiber ends joined to the elastic band ends" means "wherein one of the elastic band ends is permanently joined with one of the synthetic hair fiber ends, and the other of the elastic bands is permanently joined with the other of the synthetic hair fiber ends" and the term "to form a closed loop" means "to form one single unbroken loop."

B. The Remaining Terms.

The disagreement over the remaining disputed terms essentially entails the same debate discussed above.

Beyond that debate, the remaining terms are not complex or technical. This order thus finds that the remaining terms require no further construction and may be sufficiently understood by a layperson.

CONCLUSION

This claim construction order will govern for the remainder of this action.

IT IS SO ORDERED.

N.D.Cal.,2008.

Tonytail Co., Inc. v. Conair Corp.

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