

United States District Court,  
C.D. California.

**TOKAI CORP., etc., et al,**  
Plaintiffs.

v.

**EASTON ENTERPRISES, INC., etc., et al,**  
Defendants.

No. EDCV 07-883-VAP (FMOx)

**June 2, 2009.**

Olga Kay, R. Joseph Trojan, Trojan Law Offices, Beverly Hills, CA, for Plaintiffs.

Ivan M. Posey, Lisa A. Karczewski, Raymond Chan, Thomas T. Chan, Chan Law Group, Kirk William Hermann, Graves Law Office PC, Los Angeles, CA, for Defendants.

## **CLAIM CONSTRUCTION ORDER**

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

The Court conducted a hearing on January 23, 2009, on the parties' proposed construction of certain terms in the three Patents in Suit: Claim 1 of the '775 Patent and Claim 1 of the '308 Patent; Claim 10 of the '308 Patent; and Claim 1 of the '017 Patent, pursuant to *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir.1995) (en banc) *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (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.

### **I. INTRODUCTION**

Plaintiffs Tokai Corporation, Scripto-Tokai Corporation, and Calico Brands, Inc. hold the three patents at issue in this suit, U.S. Patent Nos. 5,697,775, ("the '775 Patent"), 5,897,308 ("the '308 Patent"), and 6,093,017 ("the '017 Patent"). All three patents relate to safety devices on utility lighters designed to prevent accidental lighting.

Plaintiffs sued Defendants Easton Enterprises, Inc. and Fun Line Industries, Inc. on July 17, 2007, alleging infringement of the patents-in-suit. In this context, the parties seek construction of certain terms in the three patents.

### **II. LEGAL STANDARD**

Claim construction is a legal question for the Court. *Markman*, 517 U.S. at 390; *Cyborg Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed.Cir.1998) (en banc). To construe the claim, a court may consider the

claim, the specifications, and the prosecution file history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed.Cir.2005) (en banc).

The Court begins its construction of a patent claim with the words of the claim itself, which "are generally given their ordinary and customary meaning ..., the meaning that the term would have to a person of ordinary skill in the art in question ... as of the [patent's] effective filing date." *Phillips*, 415 F.3d at 1312-13.

The Court looks to the patent specifications when construing "the meaning of a claim term as it is used by the inventor in the context of the entirety of his invention...." *Comark Comm. v. Harris Corp.*, 156 F.3d 1182, 1187 (Fed.Cir.1998). Furthermore, in the *Phillips* case, the Federal Circuit emphasized the specification's critical importance: it "is always highly relevant to the claim construction analysis. Usually it is dispositive; it is the single best guide to the meaning of a disputed term." *Phillips*, 415 F.3d at 1315 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996)).

The prosecution history, like the specifications, provides evidence of how the Patent Officer and the inventor understood the patent. *Phillips*, 415 F.3d at 1317 (citing *Lemelson v. Gen. Mills, Inc.*, 968 F.2d 1202, 1206 (Fed.Cir.1992)). The prosecution history "represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Id.* (citing *Inverness Med. Switz. GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1380-82 (Fed.Cir.2002); *Athletic Alternatives, Inc. v. Prince Mfg., Inc.*, 73 F.3d 1573, 1580 (Fed.Cir.1996)). The prosecution history, however, is important because it can present evidence "whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.* (citing *Vitronics*, 90 F.3d at 1582-83; *Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed.Cir.2005)).

In *Phillips*, the Federal Circuit also addressed the use of dictionaries in claim construction, reiterating 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*, 415 F.3d at 1314 (citing *Brown v. 3M*, 265 F.3d 1349, 1352 (Fed.Cir.2001)). With these principles in mind, the Court turns to the terms at issue.

## II. CLAIM CONSTRUCTION

**A. Claim 1 of the '775 Patent: "A locking member having an engagement section, which interferes with a portion of the operation member and thereby locks the lighting operation of the operation member"**

**Claim 1 of the '308 Patent: "A locking member, which interferes with the operation member and thereby locks the lighting operation of the operation member"**

The dispute between the parties over the construction of both these disputed claim terms centers on whether or not "interferes" necessarily denotes direct physical contact.

Plaintiffs propose the following construction for Claim 1 of the '775 Patent:

A part of the locking member that hinders movement of a part of the operation member and thereby locks

the lighter. [para.] The engagement section and the operation member do not have to come into direct contact with each other so long as the locking member hinders movement of the operation member by intersecting the path of the operation member.

They propose the following construction for Claim 1 of the '308 Patent:

A locking member that hinders movement of the operation and thereby locks the lighter. [para.] The locking member and the operation member do not have to come into direct contact with each other so long as the locking member hinders movement of the operation member by intersecting the path of the operation member.

Joint Claim Construction and Prehearing Statement ("Jt. Cl. Con. and Preh'g St.") at 3.

Plaintiffs claim their proposed construction is supported by the plain language of the claim and the specifications, and urge the Court to reject Defendants' proposed construction because, *inter alia*, it imports a limitation from a preferred embodiment, a "cardinal sin" in claim construction. Plaintiffs' Opening Brief ("Pls.Op.Br.") at 2-3.

Defendants propose the Court construe Claim 1 of Patent '775 as follows:

The engagement section of the locking member is in direct contact with a portion of the operation member, and thereby locks the lighting operation by the operation member.

Their proposed construction of Claim 1 in Patent '308 reads:

The locking member is in direct contact with the operation member, and thereby locks the lighting operation of the operation member.

Jt. Cl. Con. and Preh'g St. at 3.

They argue the Court should accept their proposed construction rather than Plaintiffs' for three reasons: Plaintiffs should be judicially estopped from asserting their proposed construction; the ordinary meaning of "interfere" denotes direct contact; and the context in which it appears, i.e., the specifications in the patents, indicates direct contact. Defendants' Claim Construction Brief ("Defts' Cl. Con. Br.") at 1.

## **1. Judicial Estoppel**

In addition to the discussion contained in the pre-hearing briefs, both sides submitted post-hearing briefs on the issue of whether or not Plaintiffs' position in earlier litigation constitutes a sufficient basis to invoke the doctrine of judicial estoppel as to Claim 1 of the '775 Patent. In their Supplemental Brief, Plaintiffs argue judicial estoppel should not apply to bar their proposed construction because the earlier case in which they urged a different construction, *Tokai Corp., et al. v. Newell Rubbermaid, Inc., et al.*, Case No. LACV 06-1067 PA, ended in an out-of-court resolution, with no ruling or decision on any motion or disputed proceeding. *Id.* at 1. In particular, they rely on the principles set forth by the United States Supreme Court in *New Hampshire v. Maine*, 532 U.S. 742, 750, 121 S.Ct. 1808, 149 L.Ed.2d 968, including the requirement that the first court relied on or accepted the party's previous, inconsistent, position. *Id.* at 3. FN1 Although they acknowledge that a settlement on favorable terms "can constitute judicial reliance," *id.* at 4, Plaintiffs

argue the *Newell* settlement nevertheless does not qualify as such because there was no nexus between the stipulated judgment in that case and Tokai's statements in its summary judgment motion relating to the construction of the term "interferes." *Id.*

FN1. The Supreme Court identified the following three factors as relevant in determining whether to invoke judicial estoppel: (1) whether a party's later position is "clearly inconsistent with its earlier position"; (2) whether the party successfully persuaded a court to accept its earlier position; and (3) whether the party would derive an unfair advantage if not estopped. 532 U.S. at 750-51.

Defendants contend, *inter alia*, that the second factor identified by the Supreme Court in *Maine*, successful assertion of the earlier position, is satisfied here. Although Defendants correctly point out that resolution by a stipulated judgment or settlement may support invocation of the judicial estoppel doctrine, *see Risetto v. Plumbers and Steamfitters Local 343*, 94 F.3d 597, 604-05 (9th Cir.1996), its application is not warranted under the facts present here.

First, Defendants insist the *Newell* court adopted Plaintiffs' position, i.e., their proposed construction of "interferes," because it entered a (stipulated) judgment of validity of the '775 Patent. While it is undisputed that the settlement terms in *Newell* included a judgment of validity, Defendants offer no evidence for the rest of their proposition: that the judgment of validity of the '775 Patent was "supported by [Plaintiffs'] position on 'interfere' in that case." Defendants' Supplemental Claim Construction Brief Re: Application of Judicial Estoppel Against Plaintiffs at 4.

The judgment on its face certainly contains no specific support for such a proposition. Its text, a scant two paragraphs long, states only that the Patents in Suit are valid, that the asserted prior art, alone and in combination, "are not sufficient to invalidate the asserted claims of the Patents in Suit," and "[a]fter discovery, Defendants did not find a basis for proving that the inventions described in the Patents in Suit were ever publicly disclosed or on sale prior to one year before the priority date claimed in each Patent in Suit." *Jt. Cl. Con. and Preh'g St., Easton Exh. 2* (Stipulated Judgment, Case No. LACV 06-1064 PA (PJWx)). Finally, the judgment includes a provision that Defendants admit no liability for infringement but agree to cease using any technology covered by the Patents in Suit for a period of time covered by the parties' Settlement Agreement. *Id.*

The *Newell* Court neither ruled on the pending summary judgment motion nor issued a claim construction order adopting Tokai's proposed construction of the disputed claim term. In light of the language in the judgment, finding validity of the Patents in Suit, focusing on the prior art defense, and containing no finding of infringement, the Court finds there is no basis to find Tokai successfully persuaded the *Newell* court to adopt its construction of the claim term disputed here. Accordingly, it declines to find Plaintiffs should be judicially estopped from asserting their proposed construction.

## **2. Construction**

Apart from the issue of judicial estoppel, which applies only to Claim 1 of the '775 Patent, the parties make the same arguments regarding Claim 1 of the '775 and '308 Patents, and the Court addresses them together, below.

As to Claim 1 of both the '775 and the '308 Patents, the plain language of the patent claim supports

Plaintiffs' proposed construction. As noted above, the Court begins the claim construction process by giving the words of the claim itself "their ordinary and customary meaning ..., the meaning that the term would have to a person of ordinary skill in the art in question ... as of the [patent's] effective filing date." Phillips, 415 F.3d at 1312-13. To construe the disputed term as Defendants propose, that is, to require "direct contact," would violate this requirement because the ordinary and customary meaning of "interferes" does not include direct or physical contact. Rather, the ordinary and customary meaning of the term, is broader than the narrowed construction Defendants propose, and is captured by "hinder," as Plaintiffs suggest.

We turn next to the specification, "the single best guide to the meaning of a disputed term," Phillips, 415 F.3d at 1315 (citations omitted). According to Defendants, "the specification of the '775 Patent clearly shows that the inventor used the term 'interfere' to denote direct contact." Defts.' Cl. Con. Br. at 9.

In so contending, however, Defendants rely on but two of the preferred embodiments. Defts.' Cl. Con. Br. at 10-11. Therefore, to the extent they argue that "the term 'interfere' is used to denote direct contact *throughout the specification*," (Defts.' Cl. Con. Br. at 9; emphasis added), Defendants misstate the evidence. As Plaintiffs point out, the specification (in both the '775 and '308 Patents) uses other terms, including "may interfere with," "can interfere with," and "obstructs the movement of the operation member" in describing the remaining embodiments. Declaration of Joseph Trojan ("Trojan Decl."), Exh. 1 ('775 Patent) (col. 2, ll. 44-49 (first safety device); col. 4, ll. 20-24 (third safety device); col. 5, ll. 31-40 (fourth safety device); col. 15, ll. 36-40 (third preferred embodiment); col. 18, ll. 56-59 (fourth preferred embodiment); col. 23, ll. 6-7 (fifth preferred embodiment)); Exh. 2 ('308 Patent) (col. 2, ll. 48-54 (first safety device); col. 4, ll. 27-31 (third safety device); col. 5, ll. 41-50 (fourth safety device); col. 13, ll. 52-57 (second preferred embodiment); 15, l. 66-col. 16, l. 2 (third preferred embodiment); col. 19, ll. 18-21 (fourth preferred embodiment); col. 23, ll. 37-38 (fifth preferred embodiment)).

The significance of this is two-fold. First, these other uses of "interferes" in the specification illustrate the aptness of Plaintiffs' proposed construction, as none of them denote direct contact, much less require it. Furthermore, examination of the other embodiments, which Defendants do not discuss, reveals that their proposed construction runs afoul of one of the fundamental precepts of claim construction, i.e., that the specification should not be used to read limitations into the chosen claim language. Phillips, 415 F.3d at 1319-20 (citing *SciMed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1340 (Fed.Cir.2001) (although court must not read a limitation from the written description into the claims, "claims are not interpreted in a vacuum, but are part of and are read in light of the specification" ).

By focusing on only some of the preferred embodiments and ignoring others, Defendants' interpretation of "interferes" fails to read it in light of the specification as a whole. Furthermore, as the specifications of the two patents read as a whole-not simply in light of the two preferred embodiments Defendants would highlight-do not require "direct contact," the latter's proposed construction would offend claim construction principles by importing a feature present only in two of the embodiments (in each patent) ("comes into contact"; see Trojan Decl., Exh. 1 (col. 4, ll. 53-58 (third safety device); col. 7, ll. 39-46 (same); col. 11, ll. 54-61 (first preferred embodiment)); Exh. 2 (col. 4, ll. 60-65 (third safety device); col. 7, ll. 49-56 (same); col. 12, ll. 14-24 (first preferred embodiment)).

Finally, Defendants begin their discussion of the proposed construction of this term by relying on dictionary definitions. Although it is well-settled that the Court may turn to dictionaries in claim construction, Defendants' use of dictionary definitions to support their proposed construction is flawed. At least one, if not both, of the alternate definitions it failed to include in its citation lends more support to Plaintiffs' proposed

construction, particularly because in most of the embodiments, the term "interferes" is followed by "with." The Court finds Defendants' argument that dictionary definitions support their proposed construction unpersuasive.

### **B. Claim 10 of the '308 Patent '308 and Claim 1 of the '017 Patent: "Prevents"**

Plaintiffs propose the Court construe "prevents" in both Patents to mean "stops." Defendants propose the following construction:

'Prevents' requires direct contact between the locking element and the operation member.

Jt. Cl. Cons. and Preh'g St. at 3.

Defendants' proposed construction needlessly-and improperly-adds a limitation into the claim, i.e., "direct contact ." Reading the claim term in the context of the specifications, as required, its meaning is clear, however, and "direct contact" is not included in that unambiguous meaning.

In Claim 10 of the '308 Patent, it is used to denote one of two positions of the locking element, which is movable between the "locking position" where "it *prevents* motion of the operation member" and the "lock release position" where "it *allows*" such motion. Just as clearly, in Claim 1 of the '017 Patent, the claim term is used to describe one of two positions of the "locking means," one a "locking position where it *prevents* the lighting operation" and the other, the "lock release position," where "it *permits* the lighting operation." Trojan Decl., Exh. 2 (col. 34, ll. 16-22; emphasis added) & Exh. 3 (Col. 44, ll. 58-63; emphasis added).

For the additional reasons set forth in Section A(2), above, with respect to the term "interferes," the Court rejects Defendants' arguments regarding the use of the phrase "comes into contact" in two of the preferred embodiments.

### **C. Claim 1 of the '017 Patent: "Locking means"**

Plaintiffs offer the following proposed construction of this claim term:

the combination of the locking member and the portion of the lighter case on which the locking member is mounted.

Defendants' proposed construction reads as follows:

Construed pursuant to 35 U.S.C. s. 112, 6 (means plus function) and limited to corresponding structure described in specifications and its equivalents.

Jt. Cl. Con. and Preh'g St. at 3.

The parties dispute whether this term should be construed pursuant to 35 U.S.C. s. 112, para. 6, i.e., as a "means-plus-function" claim limitation. Section 112, para. 6 of Title 35 of the United States Code permits an applicant to express a claim limitation as a means or step for performing a specified function without claiming the structure that performs the function:

An element in a claim for a combination may be expressed as a means or step for performing a specified

function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C s. 112, para. 6.

Defendants point out the use of the word "means" in the claim entitles them to a presumption that 35 U.S.C. s. 112, para. 6 applies. Defts.' Cl. Con. Br. at 14, citing *Biomedino, LLC v. Waters Technologies Corp.*, 490 F.3d 946, 950 (Fed.Cir.2007) (citing *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed.Cir.2003)). Nevertheless, "[t]his presumption can be rebutted when the claim, in addition to the functional language, recites structure sufficient to perform the claimed function in its entirety." *Id.*

According to Defendants, Plaintiffs cannot rebut the presumption that "locking means" should be construed as a "means-plus-function" claim limitation, because there is insufficient structure set forth in the "locking means" claim limitation to perform the claimed function. An examination of the claim reveals Defendants are incorrect.

"Where a claim recites a function, but then goes on to elaborate sufficient structure, material, or acts within the claim itself to perform entirely the recited function, the claim is not in means-plus-function format." *Sage Products, Inc. v. Devon Industries, Inc.*, 126 F.3d 1420, 1427-28 (Fed.Cir.1997). The claim here easily meets this test. The language of the claim itself recites a structure:

- > mounted (supported) on the main body (the lighter case)
- > structured to be rotatable
- > between two positions
- > one a locking position where it prevents the lighting operation of the operation member, and
- > the other a lock release position where it permits the lighting operation
- > and structured to be urged toward the locking position by an urging means.

In light of this detailed recitation, "locking means" cannot be construed as purely a means-plus-function claim limitation. Defendants argue that their opponents' construction is not based on language found with the claim limitation but rather is supported only in the '017 Patent's specification, Defts.' Cl. Con. Br. at 15, but the summary above derives solely from the claim limitation itself. Although Defendants rely on *Biomedino*, there the Federal Circuit examined both the claim and the specification before concluding that insufficient structure was identified to overcome the means-plus-function presumption. The claim in *Biomedino* recited simply "control means for automatically operating said valving" and "said valves," and the specification said only that "unspecified equipment may be used to control the regeneration process." 490 F.3d at 950. Hence, the case is easily distinguished on its facts, and the other authorities cited by the defense are no more persuasive.

For these reasons, the Court declines to adopt Defendants' proposed construction of this claim term, and adopts Plaintiffs' constructions of the claim term "locking means."

### III. CONCLUSION

For the reasons set forth above, the Court adopts the following construction for those claims in the Patents in Suit whose construction is disputed by the parties.

<b>Claim</b>	<b>Construction</b>
Claim 1, '775 Patent: "A locking member having an engagement section, which interferes with a portion of the operation member and thereby locks the lighting operation of the operation member"	A part of the locking member that hinders movement of a part of the operation member and thereby locks the lighter. [para.] The engagement section and the operation member do not have to come into direct contact with each other so long as the locking member hinders movement of the operation member by intersecting the path of the operation member.
Claim 1, '308 Patent: "A locking member, which interferes with the operation member and thereby locks the lighting operation of the operation member"	A part of the locking member that hinders movement of a part of the operation member and thereby locks the lighter. [para.] The engagement section and the operation member do not have to come into direct contact with each other so long as the locking member hinders movement of the operation member by intersecting the path of the operation member.
Claim 10, '308 Patent: 'Prevents' requires direct contact between the locking element and the operation member.	Stops
Claim 1, '017 Patent: 'Prevents' requires direct contact between the locking element and the operation member.	Stops
Claim 1, '017 Patent: "Locking means"	The combination of the locking member and the portion of the lighter case on which the locking member is mounted.

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