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BROWDY AND NEIMARK, P.L.L.C.
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Attn: Mr. Roger L. Browdy

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BROWDY & NEIMARK

September 1 , 2000

Our Ref: Infg.US.200(SF)

URGENT

Re: Infringement and Validity Study and Opinion
In re: U.S. Pat. No. 5897168

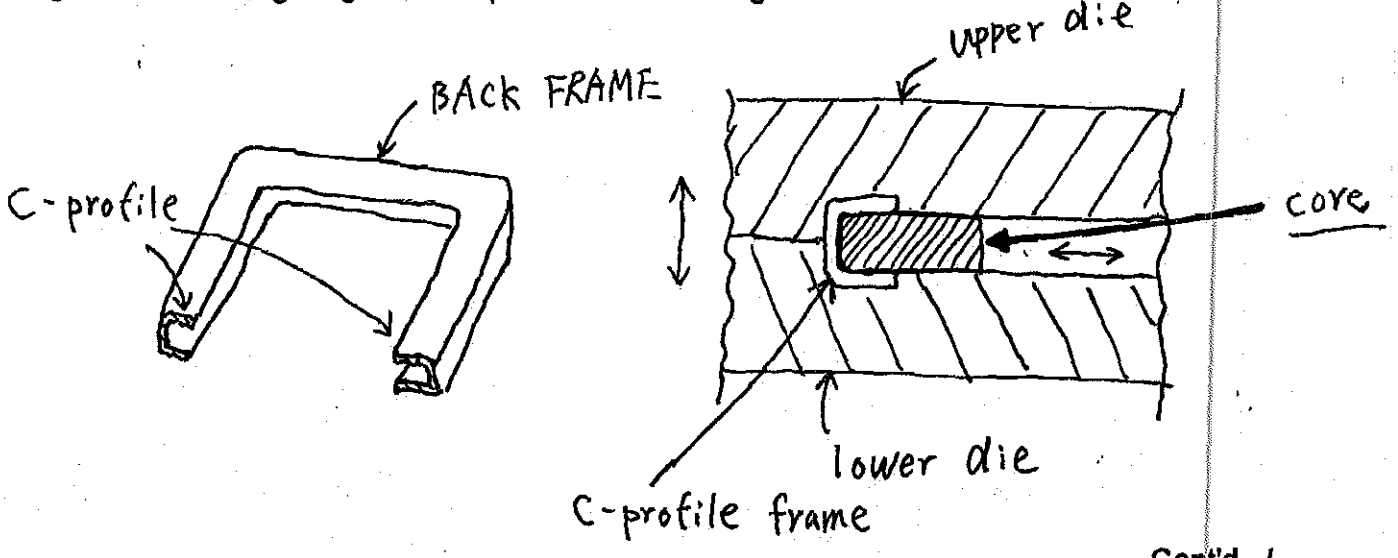
Dear Mr. Browdy:

We refer to your opinion letter of July 21, 2000.

Our clients offer the following opinions on the die casting and indicates some suspicions to the allowed claims of U.S. Pat. '168. We would like you to IMMEDIATELY reply to the following points, free of charges, since we simply need your personal answer, not via official legal opinion. Your response before September 15, 2000 BY FAX will be appreciated.

!!

Regarding the "core" used in the casing die, our clients firstly point to the introductory portion of the U.S.'168, at Column 1, lines 39-43, which states the conventional use of cores in the C-profile back frame. From this passages, you should have noticed that the core is needed to die cast the C-profile frame, while on the other hand, the basic formation of Z-profile frame does not require such core. Technically stated, our clients give the following diagram of C-profile frame casting.



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From the above diagram, you will see that the core is set in the upper and lower dies to aid in forming the inward side of C-profile frame, and also see that the core is slidable in the lateral directions within the two dies. This is necessary in both starting the die casting and removing a resultant frame from the dies. In a sense, the core might imply a kind of lateral side. In the ordinary operation of dies, the upper and lower dies are used to form a basic die construction for forming a predetermined whole shape of frame, which therefore uses vertically movable dies. The "core", in this context, refers to a separate die element which is movable in a different direction relative to such vertical movement of upper and lower dies. The "lateral slide" refers to a die element movable in the lateral directions relative to the vertical movement of upper and lower dies.

In view of the above our clients' opinion, we wish you to notice that Claim 11 of U.S.'168 is a kind of declaration or support to indicate no use of such core that has been used in the C-profile frame. This will lead you to notice that the same goes for the Z-profile frame of Nishiyama. That is, it is obvious to a person skill in the art that the Nishiyama also requires no core in its die casting operation, due to its Z-profile frame. Further, it is apparent that the Claim 11 is indispensable to Claim 1 in terms of clarifying the substantial nature of die casting of U.S.'168. Accordingly, if the Claim 1 is invalid from the Nishiyama, the Claim 11 is also invalid. Do you agree ?

With respect to your question on the extensions of lateral slide die in our clients' invention (as in Fig. 1(d)), our clients say that they are only for the purpose of forming holes for bolts or the like. Whether such extensions as well as lateral slide per se constitutes a core or not is not the subject matter of our clients' invention. It is a kind of matter to be described in sub claim. Thus, the generic main scope of our clients' invention is directed to a Z-profile frame and a method for forming the same, which obviously means that no core is required due to its nature of Z-profile.

Regarding Claim 12 of U.S.'168, considering the foregoing opinion, it would follow that the lateral slide stated in the claim 12 can include or can be equivalent to the conventional core used in the C-profile frame. In that sense, our clients suspect that this Claim 12 has no relation with the Z-profile frame and that it is strange that such Claim 12 is incorporated as one integral part of claims of U.S.'168 and any search has not been conducted as to its patentability. Only based on this assertion, is it possible to invalidate this Claim 12 ? Or, do you think that the Claim 12 has clear relation with the Z-profile frame as in Claim 1 because the "multiplicity of forms" can be made in the Z-profiled frame, using the additional lateral slides ? (considering the fact that the claim 12 is dependent from the claim 1 that clearly relates to Z-profile of frame.)

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Besides the above our clients' opinion, my personal view is that the Examiner in charge of U.S. '168 appears to have easily allowed its claims without any careful consideration on the Nishiyama and validity of Claim 12. In particular, the Claim 12 itself would have been cancelled if the Examiner pointed out no support about it in the description and no illustration thereof in the drawings. Thus, it can not be said that the Claim 12 will cover the lateral slide of our clients' invention. Neither, it can not be said that the patentee of U.S. '168 can bring an infringement suit in that particular respect. As you know, all the claims must show their specific structures and steps in the drawings and description under the U.S. patent laws. Apparently, an error of the Examiner is found as to his allowing the Claim 12. Under these circumstances, I presume that reexamination can be filed to cancel Claim 12. Also, the reexamination be filed to invalidate Claim 1 and sub claims of U.S. '168 on the basis of all the pinions given above (e.g. obviousness from Nishiyama) and your opinion. Do you think the same way ? Or, is there any other way of action to effectively invalidate the claims of U.S. '168 ?

Since we cannot bill to our clients on this matter, we would appreciate your response to the above points in a simple way, free of charges , VIA FAX BEFORE SEPTEMBER 15, 2000. Thank you for your kind cooperation. Note that there are some new U.S. patent applications which we will ask you to file on October, 2000.

With best regards,

Yours very truly,

M. Gocho, Director,
Overseas Section

MG/rs:OS.PASCO