United States District Court,
D. Maine.

Romana ACOSTA-BANUELOS,
Plaintiff.
v.
SAUNDERS MANUFACTURING CO., INC,
Defendant.

CIV. No. 87-0317-B

Jan. 18, 1990.

Bruce B. Brunda, Kit M. Stetina, Laguna Hills, Cal., John W. Ballou, Mitchell & Stearns, Bangor, Maine, for plaintiff.

David M. Lipman, Sumner H. Lipman, Joseph V. Campbell, Lipman & Katz, P.A., Augusta, Maine, for defendant.

GENE CARTER**, Chief Judge.**

MEMORANDUM AND ORDER DENYING PLAINTIFF'S MOTION FOR PARTIAL SUMMARY JUDGMENT AND DEFENDANT'S CROSS MOTION FOR SUMMARY JUDGMENT

In this patent action Plaintiff moves for partial summary judgment pursuant to Fed.R.Civ.P. 56, alleging that the record shows that there are no genuine issues of material fact concerning whether Defendant has infringed claims 2, 4, 7, 8 and 9 of Plaintiff's patent. Plaintiff also moves for the imposition of sanctions against Defendant under Fed.R.Civ.P. 37. Defendant moves for summary judgment on the ground that the undisputed facts demonstrate that the patent is invalid. On the record made on these motions, the Court denies all motions.

A motion for summary judgment must be granted if:

[T]he pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.

Fed.R.Civ.P. 56(c).

In 1972 F. Carlos DeWitt, a police officer with the Los Angeles County Sheriff's Office, invented a combination clipboard and storage box for use by on-duty police officers. The clipboard unit, called "the Posse Box," consists primarily of a top cover, which serves as a writing surface, two inner compartments for storage of paper and reports, and a single axis hinge holding the three components together. Between 1972

and 1974 DeWitt sold early versions of the clipboard to fellow police officers, modifying the invention at least twice during that time. DeWitt states in his deposition that he finalized the design of the clipboard in the form of the patented construction in April 1974, at which time commercial exploitation of the device commenced.

DeWitt filed an application for a patent on February 3, 1975. The patent examiner rejected the original application, and DeWitt submitted an amended application on February 11, 1976. In the amended application, DeWitt made changes in the claim language "in order to even more specifically point out the differences between the present invention and the prior art cited by the Examiner...." The examiner modified the amended application on February 19, 1976, approving it on the condition of DeWitt's acceptance of the changes. DeWitt consented and the patent was granted on August 31, 1976. DeWitt assigned his rights under the patent to Banuelos on April 29, 1987.

Plaintiff alleges that Defendant infringed the Posse Box patent between 1981 and 1987 by producing and selling a clipboard unit called "the Cruiser Mate." After receiving written objection from the holder of the patent, Defendant modified the Cruiser Mate, principally by altering the spatial relationship between the upper and lower compartments and by adding a latch to the front of the unit. Plaintiff alleges that the modified Cruiser Mate also infringes the Posse Box patent.

Plaintiff's Motion for Partial Summary Judgment

Defendant has admitted that the original Cruiser Mate encompasses all the elements defined in claim 2 of the patent with one exception. FN1 The one disputed element concerns the hinge mechanism. Plaintiff contends that claim 2 of the patent defines a hinge that merely permits the clipboard surface to move beyond the vertical, while Defendant construes the claim as requiring a hinge that also holds the clipboard in an open position. The parties do not dispute that the hinges on both the original and modified Cruiser Mates do not hold the clipboards open. The question thus turns on the proper construction of claim 2. If claim 2 requires a hinge capable of holding the unit open, neither the original nor the modified Cruiser Mate literally infringes the patent; FN2 a factual question would be generated as to whether the accused products infringe Plaintiff's patent under the doctrine of equivalents. FN3 While claim interpretation is ultimately a legal issue, the proper construction of a claim may, as here, rest on factual underpinnings. Because the Court finds that there are material issues of fact concerning the proper construction of the patent, Plaintiff's motion will be denied.FN4

Resolution of Plaintiff's motion rests in part on the proper construction of claim 2.FN5 It is well settled that in determining infringement a two-step analysis is used: first, the court must construe the language of the claim as a matter of law to determine its scope; and second, the trier of fact must resolve the factual question of whether the accused product reads on the properly construed claim. *See* Texas Instruments Inc. v. United States International Trade Commission, 805 F.2d 1558, 1562 (Fed.Cir.1986). Although claim interpretation ultimately is a question of law, that interpretation may rest on factual underpinnings. Tandon Corp. v. United States International Trade Commission, 831 F.2d 1017, 1021 (Fed.Cir.1987). "When the meaning of key terms of claims is disputed ... extrinsic evidence may be adduced including testimony of witnesses, and reference may be had to the specification, the prosecution history, prior art, and other claims." *Id*.

The prosecution history of the Posse Box patent application shows that the portion of claim 2 upon which the parties place differing interpretations was added at the request of the patent examiner as a condition to

patentability. The examiner had rejected the original application, and thereafter DeWitt submitted an amended application "to even more specifically point out the differences between [the Posse Box] invention and the prior art cited by the examiner." *See* Defendant's Response to Plaintiff's Motion for Partial Summary Judgment, Appendix 5. The examiner deleted dependent claim 7 from the amended application and incorporated that claim into independent claim 2, resulting in the amendment upon which the parties disagree. The amendment states:

said hinge means being so configured and constructed as to permit the clipboard portion to pass through a perpendicular position relative to the first storage portion and the second storage portion to a position beyond the vertical whereby the clipboard portion, will, when open, normally remain open;

The applicant's attorney stated in the amended application that the feature described in claim 7 permits the clipboard to pass beyond a perpendicular position relative to the first storage portion, which "facilitates the use of the first storage portion," a feature "not shown in the Examiner's principal reference ... [nor] in the remaining references...." *See* Appendix 5 to Defendant's Response to Plaintiff's Motion for Partial Summary Judgment. There is no explanation as to why the phrase "whereby the clipboard portion will, when open, normally remain open" was included, nor is it clear from the record that the phrase was part of the old claim 7. Moreover, an issue of fact is generated as to whether the hinge in the old claim 7 had the capability to hold the clipboard upright in order to "facilitate[ ] the use of the first storage portion." *See* Appendix 5 to Defendant's Response to Plaintiff's Motion for Partial Summary Judgment. In short, the record made on this motion does not adequately disclose whether a holding function was critical to differentiating claim 2 from prior art references cited by the examiner.

The court finds, *inter alia,* the existence of issues of material fact necessary to a proper interpretation of claim 2, precluding summary judgment. Because claims 4, 7, 8 and 9 of the patent at issue are dependent upon claim 2, Plaintiff's motion for summary judgment with respect to those claims is precluded as well. In light of this conclusion Plaintiff's motion for sanctions under Rule 37 likewise will be denied.

Defendant's Cross Motion for Summary Judgment

Defendant contends that Plaintiff's patent is invalid and thus it is entitled to summary judgment based on two related arguments: first, that the specification in the patent is inadequate under 35 U.S.C. s. 112; and second, that the patent is invalid because, in an amendment to claim 2 made during prosecution of the Posse Box patent, DeWitt introduced new matter not described in the original disclosure.

A patent is presumed to be valid, and "the burden of establishing the invalidity of a patent or any claim thereof ... rest[s] on the party [challenging the patent]." 35 U.S.C. s. 282. *See also* Buildex, Inc. v. Kason Industries, Inc., 849 F.2d 1461, 1463 (Fed.Cir.1988). A challenger must prove the invalidity of a patent by clear and convincing evidence. *Id.*

Claim 2 of the Posse Box patent contains the following subparagraph:

a first intermediate open top storage portion in the form of a bin for holding a pad of paper, said first storage portion underlying said clip board and covered thereby; said first storage portion extending beyond said second storage portion on at least one side;

Defendant contends that the patent specification is deficient in that it does not describe the overhand defined

in claim 2, nor its intended purpose. Plaintiff asserts that the overhang is described in the specification, in slightly different terms than what appears in the claim, at column 5, lines 15 to 25, which provides in part: "A ledge is formed by the curved portion of the shank which extends around and under the intermediate tray to secure the intermediate tray to the bottom of the writing surface." Plaintiff also alleges that the overhang feature is shown in the drawings in the specification.

Whether the description required by 35 U.S.C. s. 112 is adequate is a question of fact. In re Smythe and Shamos, 480 F.2d 1376, 1382 (C.C.P.A.1973). The Court finds that a genuine issue of material fact exists as to whether the overhang feature in claim 2 is described in the specification, thus precluding summary judgment on that issue.

Defendant's second argument appears to invoke the holding of Muncie Gear, Inc. v. Outboard Manufacturing Company, 315 U.S. 759 (1942). The great weight of authority construes that case as "an application of the statutory prohibition [35 U.S.C. s. 132] against introducing by amendment after the filing date of additional disclosure in an application and of claims directed thereto." Westphall v. Fawzi, 666 F.2d 575, 577 (C.C.P.A.1981). The proper inquiry is therefore whether the amendment introduced "new matter." If the amendment finds support in the original disclosure, no new matter has been added.

The amendment to claim 2, which Defendant alleges introduced new matter, defines the overhang of the first storage compartment over the second storage compartment. The clause defines the same overhang that Defendant contends is inadequately described in the specification. As indicated in response to Defendant's indefiniteness argument, whether that overhang is described in the specification generates a material issue of fact. Because this issue is critical to Defendant's argument, its motion for summary judgment must be denied.

Accordingly, Plaintiff's Motions for Partial Summary Judgment and for Sanctions, and Defendant's Cross Motion for Summary Judgment, are hereby *DENIED*.

FN1. Defendant has also admitted that both the original and modified Cruiser Mates are encompassed by claims 4, 7, 8 and 9 of Plaintiff's patent. Because those claims are dependent on claim 2, this opinion will focus only on claim 2.

FN2. Literal infringement requires that "the accused product embody every element of the claim." Builders Concrete, Inc. v. Bremerton Concrete Products Co., 757 F.2d 255, 257 (Fed.Cir.1985).

FN3. Infringement may be found under that doctrine if an accused device performs substantially the same overall function, in substantially the same way, to obtain substantially the same overall result as the claimed invention. Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (Fed.Cir.1987). Infringement under the doctrine of equivalents is normally a question of fact. Townsend Engineering Co. v. Hitec Co., 829 F.2d 1086, 1089 (Fed.Cir.1987).

FN4. Defendant also contends that the modified Cruiser Mate does not infringe claim 2 of the patent because there is no overhang between the first and second storage compartments, a feature clearly defined in claim 2.

FN5. Initially the Court notes its reluctance to read a holding function into the hinge described in claim 2 because of the doctrine of claim differentiation. That doctrine holds that a specific limitation found in one claim of a patent may not be engrafted onto a less specific claim in the same patent. SRI International v. Matsushita Electric Corp. of America, 775 F.2d 1107, 1122 (Fed.Cir.1985). In the Posse Box patent, dependent claim 3 defines one possible means of constructing the hinge mechanism using a pair of hinge pins set in elongated apertures. The specification states that the purpose of this structure is to allow the axis of pivoting to migrate when the clipboard is opened beyond the vertical "such that it will stay up when lifted." In Remarks submitted with the amended application DeWitt stated that "[n]one of the references show this feature, nor has the Examiner made any specific reference to this feature which permits the writing surface portion of the present invention to move beyond the vertical position to remain open during use of the intermediate compartment." Defendant's Response to Plaintiff's Motion for Partial Summary Judgment, Appendix 5, at 8. Claim 3 therefore defines a hinge with a holding function, and "[i]t is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement." *SRI International, supra,* at 1122. In order to find that the hinge described in claim 2 possesses a holding function, therefore, the Court must conclude that claim 2 defines a hinge with the capability to hold the clipboard open, but does not define the means by which it accomplishes that function; further, it must conclude that claim 3 describes but one possible structure for accomplishing that function.

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