United States District Court,
S.D. New York.

Dr. Harry GAUS,
Plaintiff.
v.
CONAIR CORPORATION,
Defendant.

No. 94 Civ. 5693(KTD)

March 3, 1998.

Charles R. Brainard, Kenyon & Kenyon, New York City, of counsel George E. Badenoch, Patrick J. Birde, Robert F. Perry, Joel N. Bock, for plaintiff.

Paul J. Sutton, Reid & Priest, LLP, New York City, of counsel Anthony Amaral Jr., for defendants.

MEMORANDUM AND ORDER

DUFFY**, J.**

This is a patent infringement action brought by plaintiff Harry Gaus ("Gaus") against defendant Conair Corporation ("Conair"). The patent in question, U.S. Patent No. 4,589,047 entitled "Protective Mechanism In Electrically Operated Devices" (hereinafter, "Gaus Patent"), involves a hazard prevention device that automatically disrupts the flow of electricity when an electrically powered apparatus is immersed in water. Gaus claims infringement based on Conair's manufacture and sale of hair dryers that allegedly use the patented mechanism for electrical shock prevention. Conair has moved for summary judgment arguing for complete dismissal of Gaus' claim based on non-infringement of Claim 12 of the Gaus Patent. FN1

FN1. "The parties have agreed that the outcome of the case will be determined by claim 12 of the Gaus patent." Plaintiff's Memorandum in Opposition to Defendant's Motion for Summary Judgment of Noninfringement, at 1, n. 1.

For the reasons stated below, Conair's motion is granted in part and denied in part.

SUMMARY OF ARGUMENTS

Conair argues that it is entitled to summary judgment for non-infringement of Claim 12. Claim 12 of the Gaus Patent requires, *inter alia:* "[1] A hazard prevention device for an electrical externally powered apparatus comprising ... a housing[,] [2] ... said housing comprising an electrical operating unit and a pair of spaced-apart electrically exposed conductive probe networks, [and] [[[3] ... a fusible electrically conductive

member." Gaus Patent, Column 12, lines 5-20. Conair asserts that "housing" requires the device to be internal to and contained entirely within the housing of the electrically powered apparatus it is intended to protect, that "pair" must be understood to refer to "two corresponding things designed for use together" and that "fusible ... member" must be limited to mean a material that melts or stretches.

Further, Conair asserts that this pair of probe networks referenced in the Gaus Patent functions "independently" of the other voltage carrying portions of the hair dryer and is configured such that the trigger switch circuit responds "before" the penetrating water reaches any other voltage carrying portion of the hair dryer.

According to Conair, therefore, summary judgment is appropriate with respect to Claim 12 because the hazard prevention device in its hair dryers utilizes (1) a single sense wire which (2) functions "in conjunction with" and "dependent on" the other voltage carrying portions of the protected apparatus, (3) is externally connected by a cable to the hair dryer, (4) fractures and/or explodes rather than melts or stretches and (5) responds only "after" the penetrating water bridges any of the other voltage carrying portions of the hair dryer. Conair claims that the Gaus Patent expressly "taught away" from these alternatives, thereby precluding Gaus from challenging their application.

Gaus claims that Conair's interpretations of Claim 12, its specification and file history are too restrictive and limited and therefore, that summary judgment is inappropriate.

DISCUSSION

Summary judgment is appropriate in patent cases as in other cases if, viewing the evidence in a light most favorable to the non-movant, "there is no genuine dispute as to any material fact and the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c); Meyers v. Asics Corp., 865 F.Supp. 177, 179 (S.D.N.Y.1994), *aff'd,* 78 F.3d 605 (Fed.Cir.1996). "If, as to the issue on which summary judgment is sought, there is any evidence in the record from any source from which a reasonable inference could be drawn in favor of the nonmoving party, summary judgment is improper." Chambers v. TRM Copy Centers Corp., 43 F.3d 29, 37 (2d Cir.1994); Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 249-50, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986) (court to inquire whether there is evidence favoring the nonmoving party sufficient for a jury to return a verdict for the party).

On a motion for summary judgment, the moving party may discharge its burden by showing "that there is an absence of evidence to support the nonmoving party's case." Celotex Corp. v. Catrett, 477 U.S. 317, 325, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986). In turn, the nonmoving party must "set forth specific facts showing that there is a genuine issue for trial ." Fed.R.Civ.P. 56(e); Williams v. Smith, 781 F.2d 319, 323 (2d Cir.1986). While the Court must construe all evidence and inferences in favor of the nonmoving party, to sustain its burden, the nonmoving party "must do more than simply show that there is some metaphysical doubt as to the material facts." Matsushita Elec. Indus., Co., Ltd. v. Zenith Radio Corp., 475 U.S. 574, 586-87, 106 S.Ct. 1348, 89 L.Ed.2d 538 (1986); Williams, 781 F.2d at 323 ("Mere conclusory allegations or denials will not suffice.").

With respect to patent claims, "infringement is itself a fact issue," SRI Intern. v. Matsushita Elec. Corp. of America, 775 F.2d 1107, 1116 (Fed.Cir.1985), and courts repeatedly emphasize that in such cases, "summary judgment is allowed only with 'great caution.' " Garter-Bare Co. v. Munsingwear, Inc., 650 F.2d 975, 982 (9th Cir.1980), *cert, denied,* 469 U.S. 980, 105 S.Ct. 381, 83 L.Ed.2d 316 (1984) (quoting

Technitrol, Inc. v. Control Data Corp., 550 F.2d 992 (4th Cir.1977), *cert. denied,* 434 U.S. 822, 98 S.Ct. 65, 54 L.Ed.2d 79 (1977)). "A patent is infringed if a single claim is infringed." Intervet America, Inc. v. Kee-Vet Laboratories, Inc., 887 F.2d 1050, 1055 (Fed.Cir.1989).

Analysis of a patent infringement allegation involves two separate steps. The first step-claim interpretation-requires the court to construe the allegedly infringed patent claim and establish its meaning and scope. *See* Markman v. Westview Instruments, Inc., 517 U.S. 370, 116 S.Ct. 1384, 1393, 134 L.Ed.2d 577 (1996). Claim interpretation is a matter to be determined in light of the claims, the specification and the prosecution history. "Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used." Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996) (quoting Fonar Corp. v. Johnson & Johnson, 821 F.2d 627, 631 (Fed.Cir.1987), *cert. denied,* 484 U.S. 1027, 108 S.Ct. 751, 98 L.Ed.2d 764 (1988)). Any extrinsic evidence, however, "is to be used for the court's understanding of the patent, not for the purpose of varying or contradicting the terms of the claims." *Id.* at 981. "When, after considering the extrinsic evidence, the court finally arrives at an understanding of the language as used in the patent and prosecution history, the court must then pronounce as a matter of law the meaning of that language." *Id.* (stating further that this can be accomplished in the jury charge as well as in a judgment as a matter of law).

Under the concept of prosecution history estoppel, "the prosecution history (or file wrapper) limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance." Standard Oil Co. v. American Cyanamid Co., 774 F.2d 448, 452 (Fed.Cir.1985). In reviewing the prosecution history and construing the patent claim, a court must construe the patent from the perspective of one skilled in the art, determining whether such a person would have been put on notice that any term within the claim meant something other than its ordinary meaning. *See* Hoganas AB v. Dresser Indus., Inc., 9 F.3d 948, 951 (Fed.Cir.1993). Where a patentee serves as his own lexicographer, any special definition given to a word must therefore be clearly defined in the specification. Markman, 52 F.3d at 980. If not clearly defined, however, proper recognition of the notice function of claims requires the court to attribute ordinary and, where appropriate, narrow meanings to the disputed terms. *See* Athletic Alternatives, Inc. v. Prince Mfg., Inc., 73 F.3d 1573, 1581 (Fed.Cir.1996).

The second step in analyzing a patent infringement allegation-infringement analysis-requires a comparison of the allegedly infringed patent claim with the infringing product. *See, e.g.,* Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387-89 (Fed.Cir.1992). Infringement may be found under either one of two legal theories-literal infringement or infringement under the doctrine of equivalents. *Id.* Under either legal theory, infringement analysis is a question of fact. Hormone Research Foundation, Inc. v. Genentech. Inc., 904 F.2d 1558, 1562 (Fed.Cir.1990).

To prove literal infringement, every limitation of the allegedly infringed patent claim must be shown to exist in the accused product. *Id.* "Should there exist a genuine dispute concerning any underlying factual matters, summary judgment on the infringement issue would be inappropriate." *Id.* Thus, to prevail on the issue of literal non-infringement, all that is required of Conair is a showing that there is no genuine dispute that at least one limitation of the alleged patent is absent in its device. *See* Teledyne McCormick Selph v. United States, 214 Ct.Cl. 672, 558 F.2d 1000, 1008 (Ct.Cl.1977) (literal infringement requires that each and every element of a claim and its equivalent function be present in the accused device).

If the accused product does not literally infringe, it still "may infringe under the doctrine of equivalents if the differences between the claimed invention and the accused device are shown to be 'insubstantial.' "

Maxwell v. J. Baker, Inc., 86 F.3d 1098, 1105 (Fed.Cir.1996), *cert. denied,* 520 U.S. 1115, 117 S.Ct. 1244, 137 L.Ed.2d 327 (1997). This doctrine is intended for "situations where there is no literal infringement but liability is nevertheless appropriate[,] to prevent what is in essence a pirating of the patentee's invention." Hormone Research Foundation, 904 F.2d at 1564 (quoting Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 879 (Fed.Cir.1985)). To prove infringement under this doctrine, the accused product must "perform substantially the same function, in substantially the same way, to give substantially the same result." *Id.* "The doctrine of equivalents, however, is not a tool for redrafting the claims of a patent." *Id.* The public is entitled to rely on the functional limitations of the claim. *See* Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1532 (Fed.Cir.1987).

I cannot agree with Conair's arguments as to the interpretation of the terms "pair" or "fusible". First, what constitutes a "pair of spaced-apart electrically exposed conductive probe networks" may indeed mean "two corresponding things designed for use together" as Conair suggests. It could also mean, however, "a single thing made up of two corresponding parts that are used together *[a pair of pants]*." Webster's New World Dictionary, 3d College Edition (1988). The Gaus Patent specifically states that the "object of the invention ... is achieved ... by a combination of components having [*inter alia*] ... *a probe* at the boundaries of the housing openings and housing gaps, in the form of an open i.e., exposed electrical double conductor". Gaus Patent, Summary of the Invention, Column 3, lines 1-5 (emphasis supplied). The term "pair", therefore, cannot be limited as narrowly as Conair suggests.

Similarly, while in the context of electrical currents, "fusible" does often refer to something that melts, the inevitable result of the melting is a "break" in the electrical circuit. In fact, the Gaus Patent specifically states that once "a current passes through the resistance element, heating the latter to the required melting temperature within fractions of a second, ... the contacts of the protective switch which are under a pre-stressing holding them together *break open,* whereby the voltage to the entire apparatus is cut off." Gaus Patent, Summary of the Invention, Column 3, lines 51-56 (emphasis supplied). Conair's claim, then, that fusible cannot be deemed to mean "fractures" or "explodes" and that its device is therefore different cannot be sustained at this juncture.

In contrast, Conair has properly interpreted the term "housing" with respect to Claim 12. The Claim, the specification and the prosecution history all demonstrate that the Gaus Patent put those skilled in the art on clear notice that "[t]he object of the invention is to devise a protective device of the type of the abovementioned second group of prior art proposals ... that ... are accommodatable *in* standard small electric appliances ." Gaus Patent, Summary of the Invention, Column 2, lines 55-66 (emphasis supplied). In this second group of prior art proposals, "in response to the drawbacks of the external configuration the protective device is *completely integrated into the electrically powered apparatus*." Gaus Patent, Background of the Invention, Column 1, lines 53-56 (emphasis supplied). I cannot agree, therefore, with Gaus' argument that this language "merely characterizes the prior art".

The claim interpretation above mandates summary judgment under only the doctrine of literal infringement, however. The two devices cannot be judged literally the same even if the meaning of the disputed terms in Claim 12 is not what Conair suggests but are defined as otherwise indicated by this Court.

Under the doctrine of equivalents, summary judgment is inappropriate since Gaus has met his required burden and shown through his expert that material issues of disputed fact exist as to not only the structure of Conair's device, but also to its function. FN2 Only a trier of fact should determine these facts and whether any or all of Conair's asserted differences are substantial.

FN2. For purposes of this motion, I credit the declaration of Gaus' expert not for the purpose of claim construction, but only insofar as it raises issues as to the equivalent features of Conair's device. Gaus' expert challenges whether Conair's alleged single sense wire and the voltage carry portions of its hair dryer function equivalently to Gaus' pair of spaced-apart electrically exposed networks, whether Conair's device is also included in a functionally similar "housing" and whether the "fusible member" in the Gaus Patent also causes an electrical discontinuity. *See, e.g.*, Memorandum in Opposition to Defendant's Motion for Summary Judgment, Exh. B, para.para. 28, 30, 45, 55.

CONCLUSION

For the above reasons, defendant Conair's motion for summary judgment is granted with respect to the doctrine of literal infringement and denied with respect to the doctrine of equivalents.

SO ORDERED.

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