United States District Court,
D. Kansas.

Mark A. FREEMAN and Timothy K. Stringer,
Plaintiffs.
v.
THE FIRST YEARS, INC,
Defendant.

No. 99-2058-KHV

Nov. 23, 1999.

MEMORANDUM AND ORDER

VRATIL**, J.**

Plaintiffs filed suit against defendant The First Years, Inc., asserting that it willfully infringed plaintiffs' U.S. Patent No. 5,187,347 [the '347 patent] by manufacturing and selling a child's "sippy cup." This matter comes before the Court pursuant to Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995), *aff'd,* 517 U.S. 370 (1996). The parties ask the Court to construe Claims 1(f), 7(f), and 14(f) of the '767 patent as a matter of law. *See Plaintiffs' Summary Brief on Claim Construction* (Doc. # 81) filed October 26, 1999 and *The First Year's Statement Of Principles And Positions On Construction Of Freeman* '347 Patent *Under* Markman (Doc. # 78) filed October 22, 1999. FN1 Consistent with the evidence presented at a *Markman* hearing on October 29, 1999, the Court finds as a matter of law that Claims 1(f), 7(f), and 14(f) of the '347 patent have the meaning and scope set forth below.

FN1. In ruling on claim construction, the Court has also considered the parties' arguments contained in *The First Years Inc.'s Memorandum In Support Of Its Motion For Summary Judgment Of Noninfringment And Invalidity* (Doc. # 67) filed September 17, 1999, *Plaintiffs' Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment And Invalidity* (Doc # 73) filed October 7, 1999, *The First Years Inc.'s Reply In Support Of its Motion For Summary Judgment Of Noninfringment And Invalidity* (Doc. # 79) filed October 22, 1999, and *Plaintiff's [sic] Surreply To The First Years, Inc.'s Reply In Support Of Its Motion For Summary Judgment Of Noninfringment And Invalidity* (Doc. # 84) filed October 29, 1999. In this memorandum and order the Court addresses only the issue of claim construction.

Claim Construction Standards

The construction of a patent is a question of law for the Court. Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996).

Background

On October 15, 1991, plaintiffs applied to the United States Patent and Trademark Office (the "PTO") for a patent for a "Spill-Proof Closure" for a child's trainer cup or "sippy cup." *See Plaintiffs' Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment and Invalidity* (Doc. # 73) filed October 7, 1999, Ex. J. The proposed device described a valved closure-a slit through a membrane which is normally closed but which opens in response to suction to allow fluid to flow from the container. When the suction is released, the slit re-closes.

The patent examiner interviewed plaintiff Freeman over the telephone, and informed him that the claims required an amendment to clearly define over prior art, specifically, the Coy patent. The Coy patent discloses a valve with downwardly converging walls that meet at an apex to form an opening. The user opens the Coy valve by applying opposed lip pressure along a line parallel to the opening. Specifically, the Coy patent claims in pertinent part:

[Claim] 1. A valved spout for controlled dispensing of a liquid from a container, said spout comprised of an outer resilient member having inlet and outlet ends and a body segment which defines the exterior of said spout and an inner member having downwardly depending opposed portions that close the outlet end of said outer member and terminate in an apex valve. [Claim] 2. The valved spout of claim 1 wherein said apex valve is opened by the application of force in a direction edgewise to said opposed portions.

Plaintiffs' Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment and Invalidity (Doc. # 73) filed October 7, 1999, Ex. B.

Freeman agreed to amend the patent application as suggested by the examiner, in order to distinguish the Coy prior art. On February 16, 1993, the PTO issued the '347 patent. In doing so it approved Claims 1, 7, and 14, including the amendments to the claims which are set forth in italics below:

[Claim] 1. A controllable valved closure for use in dispensing a beverage from a container, said closure comprising:

(a) a substantially planar cover portion conforming in shape to the opened end of said container;

(b) attachable means for selectively maintaining said closure in covering relation with said container;

(c) a spout having an outer end, said spout extending upwardly and outwardly from said cover portion;

(d) an elongated opening located near said outer end of said spout, said opening providing communication between the interior and exterior of said spout, and said opening being completely contained within the user's mouth during operation of the closure;

(e) a thin membrane having attachable means for attaching said thin membrane to an inner surface of said spout, said thin membrane covering said opening in said spout, said thin membrane being made of an elastomer which can be repeatedly stressed and unstressed and retain memory of its original position; and

(f) a single slit through *a planar section of* said thin membrane, said slit being straight and parallel to *a* [the] long axis of said opening, said slit functioning to provide an opening through said thin membrane when suction is applied to said thin membrane and reseal, as a result of said thin membrane being biased to its manufactured position, when suction is removed from said thin membrane.

* * *

[Claim] 7. A controllable valved closure for use in dispensing a beverage from a container, said closure comprising:

(a) a substantially planar cover portion conforming in shape to the opened end of said container;

(b) attachable means for selectively maintaining said closure in covering relation with said container;

(c) an elongated passageway having an outer end, said passageway extending upwardly and outwardly from said cover portion;

(d) an opening located near said outer end of said passageway, said opening providing communication between the interior and exterior of said passageway, and said opening being completely contained within the user's mouth during operation of the closure;

(e) a thin membrane having attachable means for attaching said thin membrane to an inner surface of said closure; said thin membrane covering said opening in said passageway; and

(f) a slit through *a planar section of* said thin membrane, said slit functioning to provide an opening through said thin membrane when an external negative pressure exists and remains closed when internal and external pressures are equal;

* * *

[Claim] 14. A controllable valved closure for use in dispensing a beverage from a container, said closure comprising:

(a) a substantially planar cover portion conforming in shape to the opened end of said container;

(b) attachable means for selectively maintaining said closure in covering relation with said container;

(c) an elongated passageway having an outer end, said passageway extending upwardly and outwardly from said cover portion;

(d) an opening in said closure which communicates between the interior and exterior of said passageway;

(e) a thin membrane having attachable means for attaching said thin membrane to the inner surface of said closure; and

(f) a disjoined portion within [*a planar section of*] said thin membrane, said disjoined portion functioning to provide a flow passage through said thin membrane when said thin membrane is stressed and said disjoined portion forming a seal when said thin membrane is unstressed. FN2

FN2. Due to an apparent error at the PTO, the phrase "a planar section of" does not appear in Claim 14 of the printed patent. Plaintiffs filed a certificate of correction with the Patent Office, and the PTO "presumably" issued the correction on September 14, 1999. *See The First Years Inc.'s Memorandum In Support Of Its Motion For Summary Judgment Of Noninfringment and Invalidity* (Doc. # 67) filed September 17, 1999, Ex. 5.

Plaintiffs' Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment and Invalidity (Doc. # 73) filed October 7, 1999, Ex. J.

Claim Construction

In construing patent claims, the Court looks first to the intrinsic evidence of record, i.e., the patent claims, the specification and, if in evidence, the prosecution history. Sextant Avionique, S.A. v. Analog Devices, Inc., 172 F.3d 817, 825 (Fed.Cir.1999); Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996) (citing Markman, 52 F.3d at 979). The Court must determine how the claim would be interpreted by one of ordinary skill in the art at the time the patent was issued. Markman, 52 F.3d at 986.

Claim construction begins with the words of the claims. The language of the claim is to be given its ordinary meaning to a person of ordinary skill in the relevant art, unless it appears from the patent and the file history that the terms were used differently by the inventor. Intellicall, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387 (Fed.Cir.1992). Thus, a patentee is not limited to ordinary dictionary definitions of terms, but is free to be his or her own lexicographer. Fromson v. Advance Offset Plate, Inc., 720 F.2d 1565, 1569 (Fed.Cir.1983).

"Claims must be read in view of the specification, of which they are a part." Markman, 52 F.3d at 979. The specification includes a written description of the invention and a best mode or preferred embodiment of the invention. *Id.* "The specification must enable a hypothetical person having ordinary skill in the art to make and use the invention, and so is typically drafted in some sense as an interpretive guide in reading the claims." Mediacom Corp. v. Rates Tech., Inc., 4 F.Supp.2d 17, 25 (D.Mass.1998). The limitations in particular embodiments should not be read into the claims, although the Court may use the embodiments as definitional guides for words in the claims. Ethicon Endo-Surgery, Inc., v. U.S. Surgical Corp., 93 F.3d 1572, 1574-76 (Fed.Cir.1996).

The Court should also consider the prosecution history or "file wrapper," if in evidence, to ascertain the meaning of any claim. Markman, 52 F.3d at 979. The construction of the patent may be confirmed by the inventor's understanding of the claimed invention. *Id.* "Although the prosecution history can and should be used to understand the language used in the claims, it too cannot enlarge, diminish, or vary the limitations in the claims." *Id.* (further quotations and citations omitted).

Finally, the Court may consider extrinsic evidence, including publications, dictionaries, and expert testimony, if necessary to assist in determining the meaning or scope of terms in the claims. Vitronics Corp., 90 F.3d at 1583. Extrinsic evidence "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." Markman, 52 F.3d at 981. "But this evidence is not for the purpose of clarifying ambiguity in claim terminology." Id. at 986. The claims themselves set the metes and bounds of the inventor's right to exclude others from practicing the invention.

Adhering to the above legal principles, the Court received evidence at the *Markman* hearing. The '347 patent claims a sippy cup which uses an elastomer membrane in the spout of the lid, with a slit through a planar section of the membrane. The parties focus their dispute around the meaning of the terms "planar section" in Claim 1, 7, and 14, which provide:

1. (f) a single slit through a planar section of said thin membrane, said slit being straight and parallel to a long axis of said opening, said slit functioning to provide an opening through said thin membrane when suction is applied to said thin membrane and reseal, as a result of said thin membrane being biased to its manufactured position, when suction is removed from said thin membrane.

7. (f) a slit through a planar section of said thin membrane, said slit functioning to provide an opening through said thin membrane when an external negative pressure exists and remain closed when internal and external pressures are equal.

14. (f) a disjoined portion within a planar section of said thin membrane, said disjoined portion functioning to provide a flow passage through said thin membrane when said thin membrane is stressed and said disjoined portion forming a seal when said thin membrane is unstressed.

Plaintiffs' Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment and Invalidity (Doc. # 73) filed October 7, 1999, Ex. J.

Plaintiffs contend that in Claims 1 and 7, the language "slit through a planar section of said thin membrane" means "a thin membrane with a slit having edges that meet in-plane to form a seal." *Plaintiffs' Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment And Invalidity* (Doc. # 73) filed October 7, 1999. Defendant argues that the reference to "a single slit through a planar section of said thin membrane" means a slit through "a flat section of the thin membrane." *The First Years Inc.'s Memorandum In Support Of Its Motion For Summary Judgment Of Noninfringment and Invalidity* (Doc. # 67) filed September 17, 1999, at 15. Plaintiffs counter that the slit must pass through a portion of the membrane "sufficiently flat" to achieve an in-plane seal.

Defendant contends that the term "planar" must be given its common and ordinary meaning because the specification does not provide clear support for a different meaning. As the Federal Circuit recently set out:

[T]he ordinary and accustomed meaning of disputed term is presumed to be the correct one, subject to the following. First, a different meaning clearly and deliberately set forth in the intrinsic materials-the written description or the prosecution history-will control. Second, if the ordinary and accustomed meaning of a disputed term would deprive the claim of clarity, then further reference must be made to the intrinsic-or, in some instances, extrinsic-evidence to ascertain the proper meaning. In either case, the party wishing to alter the meaning of a clear claim term must overcome the presumption that the ordinary and accustomed meaning is the proper one, demonstrating why such an alteration is required.

K-2 Corp. v. Salomon S.A., 191 F.3d 1356, 1362 (Fed.Cir.1999) (internal citations omitted). *See also* Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989 (Fed.Cir.1999) (noting the heavy presumption in favor of ordinary meaning of claim language); Renishaw PLC v. Marposs Societa Per Azioni, 158 F.3d 1243, 1249 (Fed.Cir.1998). Defendant asserts that the common and ordinary meaning of "planar" is "flat," citing Webster's II New College Dictionary at 842. The Court notes, however, that Webster's Third New International Dictionary Unabridged defines "planar" as "of or relating to a plane;

lying in one plane; having a flat two-dimensional quality," *id*. at 1730, and in turn, defines "plane" as "a surface such that the straight line that joins any two of its points lies wholly in that surface: a two dimensional extent of zero curvature; a flat or level material surface."

Defendant also asserts that the Federal Circuit has accepted the common and ordinary meaning of "planar" as "flat." *See* American Permahedge, Inc. v. Barcana, Inc., 105 F.3d 1441, 1445 (Fed.Cir.1997); State Indus. Inc. v. Rheem Mfg. Co., 769 F.2d 762, 762 (Fed.Cir.1985). The cases that defendant relies upon, however, are not particularly applicable. In *American Permahedge,* the Federal Circuit construed the phrase "planar array" to refer to filament means forming a flat plane. The court relied in part on an explanation of the term in the specification: "A plurality of mini-leaves or flat privets ... extend essentially laterally of a respective stem .. as shown. Similar to element 10, element 510 has, when viewed edgewise, a flat, planar construction." 105 F.3d at 1445. In *State Industries,* (not a claim construction case), the court merely commented that a "flat bracket without walls" was referred to in the claims as a "horizontal, planar platform surface member."

Defendant further argues that the '347 patent specification supports the construction of "planar" as "flat." The figures show what appears to be a flat membrane. Of course, the figures in a patent do not limit the language of the claims. *See* Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1054 (Fed.Cir.1994).

Plaintiffs argue that defendant's construction would mean that the entire membrane must be completely flat, and assert that one skilled in the art would conclude that such a construction would be incorrect, given the inherent properties of thin membranes. Plaintiffs' expert, Dr. Sorem, testified at the Markman hearing that it is nearly impossible to manufacture a membrane which is perfectly uniform in geometry, because membranes have undulations in their surface. The Court, however, sees the argument whether membranes can ever be "completely flat" as a red herring; the disputed claims do not state that the membrane itself must be planar or flat.

More on point, plaintiffs assert that the Court must construe the term "planar section" in the context of the Coy reference, which was the reason the inventors agreed to add the limitation. A review of the file history is particularly relevant where words were added to the claim to overcome specific prior art. *See* Lemelson v. General Mills Inc., 968 F.2d 1202, 1206 (Fed.Cir.1992). At the suggestion of the patent examiner, plaintiffs agreed to add the "planar section" limitation to clearly distinguish the claims over Coy. The Court agrees with plaintiffs that the Coy reference must be evaluated to give meaning to the phrase "planar section." The Coy patent discloses a valve with downwardly converging walls that meet at an apex to form an opening. The user opens the Coy valve by applying opposed pressure along a line parallel to the opening. Plaintiffs assert that the converging walls of the Coy valve form an "out-of-plane seal," in that the sides of the walls form the seal and the edges of the wall project outwardly out-of-plane. In contrast, the membrane valve of the '347 patent form an in-plane seal, that is, the edges of the slit meet in-plane to form the seal.

Given the language of the claims in question, and the intrinsic evidence, particularly the prosecution history that plaintiffs added the disputed term "planar section" in response to the examiner's suggestion in order to distinguish the '347 patent over the Coy reference, the Court finds as follows: The term "planar section of said thin membrane" does not refer to the shape or the properties of the membrane itself. Rather, it clearly refers to the fact that *the membrane is held in a fixed plane through means which attach it to the inner surface of the spout*. The membrane here cannot be rigid-by definition it is flexible and the shape and configuration are changeable at different points in time. The only reference to the structure of the membrane

in the '347 patent is that the membrane is "biased to its manufactured position." *Plaintiffs' Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment and Invalidity* (Doc. # 73) filed October 7, 1999, Ex. J, Claim 1(f).

The parties also briefly address the construction of other claim terms. First, they disagree on the meaning of the term "long axis" in Claim 1(f), which provides:

a single slit through a planar section of said thin membrane, said slit being straight and parallel to a long axis of said opening, said slit functioning to provide an opening through said thin membrane when suction is applied to said thin membrane and reseal, as a result of said thin membrane being biased to its manufactured position, when suction is removed from said thin membrane.

Id.

As originally submitted, Claim 1 included the term "*the* long axis." Defendant asserts that the term "long axis" does not have an ordinary and accustomed meaning, but that in the '347 patent the term means "major axis." Defendant relies on the drawings of the '347 patent, figures 1 and 3, which show the slit on or parallel to the major axis of the membrane. Plaintiffs point out that the drawings show a preferred embodiment, but that the claims are not limited to the preferred embodiment. *See* Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1054 (Fed.Cir.1984) (embodiments in specification not read into claims if claim language is broader than such embodiments). Plaintiffs contend that the term "long axis" means any axis lying primarily along the length, rather than the width, of the opening. Plaintiffs point out that the '347 specification states that "Slit 14 is through thin membrane 13 and is shown as a straight line but could be multiple slits and/or a variety of geometric shapes such as a figure 'H', a curved line, etc." *Plaintiffs' Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment and Invalidity* (Doc. # 73) filed October 7, 1999, Ex. J. Plaintiffs further assert that the ordinary and accustomed meaning of the term "long" is inherently relative-that it means a length greater than something else, and that in this case, it means the length, rather than width, of the opening. The Court agrees with plaintiffs' definition, particularly in light of the fact that the revised claim states "a long axis" rather than "the long axis," clearly indicating that more than one such axis may exist.

Defendant also asserts that the claim term "elongated passageway ... extending upwardly and outwardly from said cover portion," recited in Claims 7 and 14, has its ordinary and accustomed meaning-which according to defendant, means exactly what is says. Defendant does not elaborate on this point and plaintiffs do not appear to respond to the assertion. The Court therefore sees no basis on which to resolve any dispute, if one exists.

Finally, the parties ask the Court to construe the term "spout" in Claim 1, which includes the phrase, "spout extending upwardly and outwardly from said cover portion." *See Plaintiff's Memorandum In Opposition To Defendant's Motion For Summary Judgment Of Noninfringment and Invalidity* (Doc. # 73) filed October 7, 1999, Ex. J. Plaintiffs contend that the term "spout" has a common and accustomed meaning-a structure through which liquid is poured. Defendant agrees that the term "spout" has a common and accustomed meaning, but insists that it is a passageway through which liquid is released. The specification, drawing and file history of the '347 patent indicate that in this context the term spout means a structure for guiding the flow of liquid from a container.

In summary, the Court believes that the phrase "through a planar section of said thin membrane" has a plain

meaning in light of the '347 claims, the '347 specification, and the '347 prosecution history. A person of ordinary skill in the art of sippy cup engineering would read the phrase as indicating that *the membrane is held in a fixed plane through means which attach it to the inner surface of the spout*. The phrase does not refer to the shape or the properties of the membrane itself.

The term "a long axis" also has a plain meaning in light of the '347 claims, the '347 specification, and the '347 prosecution history. A person of ordinary skill in the art of sippy cup engineering would read this phrase as meaning an axis lying primarily along the length, rather than the width, of the opening.

The term "spout" in Claim 1(f) of the '347 has a plain meaning in light of the '347 claims, the '347 specification, and the '347 prosecution history. "Spout" means a structure for guiding the flow of liquid from a container.

IT IS THEREFORE ORDERED THAT Claims 1(f), 7(f) and 14(f) of the '347 patent will as a matter of law be construed in a manner consistent with this memorandum and order.

Dated this 22nd day of November, 1999, at Kansas City, Kansas.

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