United States District Court,
N.D. Texas, Dallas Division.

ASPEX EYEWEAR, INC,
Plaintiff-counterdefendant.
v.
E'LITE OPTIK, INC,
Defendant-counterplaintiff.

No. CIV.A. 3:98-CV-2996D

Feb. 27, 2001.

MEMORANDUM OPINION AND ORDER

FITZWATER**, District J.**

In this patent case, defendant-counterplaintiff E'Lite Optik, Inc. ("E'Lite") seeks judicial construction of the claim language contained in the U.S. Patent No. 5,568,307 ("the '207 patent"). Plaintiff-counterdefendant Aspex Eyewear, Inc. ("Aspex") contends that E'Lite is infringing the '207 patent. E'Lite maintains that the patent is not infringed and is invalid. For the reasons that follow, the court grants E'Lite's February 25, 2000 motion to construe claims, FN1 and in part construes the claims as E'Lite contends and in part declines to do so.

FN1. As the court explains *infra* at s. I, after E'Lite filed this motion, the court stayed this case pending resolution of an interference proceeding. The instant motion became ripe again on December 19, 2000 when the court reinstated it on the pleadings and correspondence on file. *See* Dec. 19, 2000 Order at 2.

I

The technology at issue in this case involves spectacle frames that support an auxiliary frame, enabling the user to securely fasten a second set of lenses (often sunglass lenses) onto the primary frame (often holding prescription lenses). Previous mechanisms for attaching additional lenses to eyeglasses relied either on clips or magnets mounted on the front of the primary frames. The design described by the '207 patent allows for a more stable, secure attachment of the auxiliary frame through a structural arrangement included in the frames. This arrangement involves projections on the rear and side portions of the primary frames and arms on the side portions of the auxiliary frames. Magnets secured in the projections of the primary frame engage with magnets secured in the arms of the auxiliary frames when the auxiliary frame's arms are extended over and supported on the upper side portions of the primary frames. This ensures that the auxiliary frames will not move downward relative to the primary frames.

By assignment from inventor Richard Chao ("Chao"), Contour Optik, Inc. ("Contour") owns the '207 patent.

Aspex holds the exclusive rights to a license to sell in the United States eyeglass frames protected by the '207 patent. E'Lite also sells eyeglasses that allow the user to attach an auxiliary frame to a primary eyeglass frame. Aspex alleges that E'Lite's eyeglasses infringe the '207 patent. After E'Lite moved to construe the claims of the '207 patent, the court stayed this case pending resolution of an interference proceeding before the United States Patent and Trademark Office ("PTO"), in which E'Lite argued that Chao was not the first person to invent the device disclosed in the patent. Aspex moved to lift the stay after the interference proceeding established its right to recover under the patent-in-suit. The court granted the motion on December 19, 2000, *see supra* note 1, and now considers E'Lite's proposed claim construction.

II

As a preliminary matter, Aspex argues that the court's construction of the claims of the '207 patent would be premature at this point in the litigation. It notes that discovery has not concluded, resulting in an incomplete record. Furthermore, Aspex suggests that before construing the claims, the court should conduct a *Markman* hearing. *See* Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996); Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995) (en banc). The court disagrees. The Federal Circuit has explicitly refused to adopt a uniform rule requiring district courts to wait until the end of discovery to construe claims. *See* Vivid Techs., Inc. v. Am. Science & Eng'g, Inc., 200 F.3d 795, 803 (Fed.Cir.1999). Instead, it has noted that the determination of when claim construction should occur "may vary with the issues, their complexity, the potentially dispositive nature of the construction, and other considerations of the particular case." *Id*. In the present case, Aspex has not identified any specific reason why it would be prejudiced by claim construction at this time. Moreover, Aspex argues that "the language of the '207 patent is clear and the invention is sufficiently described to enable one to determine" the proper scope of the claims. P. Br. 3. In light of the apparent clarity of the claims, therefore, the court will proceed with claim construction.

These same considerations lead the court to conclude that a *Markman* hearing is unnecessary. In many cases, a hearing prior to claim construction allows the court to question and evaluate attorney argument and/or witness testimony regarding the competing claim constructions. Such a process is particularly helpful when the claims are ambiguous or the technology is complex. Nothing, however, mandates the use of a *Markman* hearing because courts retain the discretion to construe the claims on the basis of a paper record alone. *See* Interactive Gift Express, Inc. v. Compuserve Inc., 1998 WL 247485, at n. 3 (S.D.N.Y. May 15, 1998) ("The court notes at the outset the no *Markman* hearing is needed in this case because the court does not require expert or other testimony to aid it in its claim construction."). In cases such as this one, where the technology is accessible to the court and the claims are relatively straightforward, a *Markman* hearing is unnecessary. Accordingly, the court now considers the proposed claim constructions.

III

Claim construction is a matter of law, and claims are construed by the court as they would be understood by persons of ordinary skill in the field of the invention. *See* Markman, 52 F.3d at 979. The court starts with the claim itself, read in light of the specification. *See* Vivid Techs., 200 F.3d at 804. Using these tools, the court construes only the claims that are in controversy, and only to the extent necessary to resolve the dispute. Id. at 803.

The '207 patent has two claims. Claim 1 is an independent claim and states:

An eyeglass device comprising:

a primary spectacle frame for supporting primary lenses therein, said primary spectacle frame including two side portions each having an extension extended therefrom for pivotally coupling a leg means thereto, said primary spectacle frame including two rear and side portions each having a projection secured thereto, said primary spectacle frame including an upper side portion,

a pair of first magnetic members secured in said projections respectively,

an auxiliary spectacle frame for supporting auxiliary lenses therein, said auxiliary spectacle frame including two side portions each having an arm extended therefrom for extending over and for engaging with said upper side portion of said primary spectacle frame, and

a pair of second magnetic members secured to said arms respectively for engaging with said first magnetic members of said primary spectacle frame so as to secure said auxiliary frame to said primary spectacle frame,

said arms being engaged with and supported on said upper side portion of said primary spectacle frame so as to allow said auxiliary spectacle frame to be stably supported on said primary spectacle frame and so as to prevent said auxiliary spectacle frame from moving downward relative to said primary spectacle frame and so as to prevent said auxiliary spectacle frame from being disengaged from said primary spectacle frame.

Claim 2 is a dependent claim and includes limitations on claim 1, stating:

An eyeglass device according to claim 1, wherein said projections and said first magnetic members are arranged lower than said upper side portion of said primary spectacle frame, said second magnetic members are extended downward toward said projections for hooking on said primary spectacle frame so as to further secure said auxiliary spectacle frame to said primary spectacle frame.

'207 patent, col. 3-4.

In addition to the claim language, the prosecution history is "often helpful in understanding the intended meaning as well as the scope of technical terms." Vivid Techs., 200 F.3d at 804. The prosecution history includes the record of interference proceedings. *See* Phillips Petroleum Co. v. Huntsman Polymers Corp., 157 F.3d 866, 872 (Fed.Cir.1998). In particular, the prosecution history is relevant in determining whether the patentee intends the language of the patent to be understood in its ordinary meaning. Although a court should generally give such terms their ordinary meaning, "a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history." Vitrionics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). When this intrinsic evidence unambiguously describes the scope of a patented invention, reliance on extrinsic evidence is improper. *See* id. at 1583. The Federal Circuit has cautioned that extrinsic evidence, including expert testimony, "is not to be relied upon for purposes of claim interpretation, other than to aid the judge in understanding the technology[.]" FN2 EMI Group of North Am., Inc. v. Intel Corp., 157 F.3d 887, 892 (Fed.Cir.1998). In the present case, where the technology involved is uncomplicated and the claims are unambiguous, expert testimony is unnecessary.

FN2. Because the claim language is unambiguous and expert testimony on the technology is unnecessary,

the court will not consider the expert report of Harry F. Manbeck for purposes of claim construction. *See* P.App. 4-50.

IV

E'Lite interprets the '207 patent claims to require that (1) the claims cover a top-mounted design and cannot cover a back-mounted design; (2) the claims require magnet-independent stable support of the auxiliary frame by the primary frame; and (3) the auxiliary frame arms must touch the upper side portion of the primary frame. Although Aspex suggests that the ordinary language of the patent covers both a top-mounted and a back-mounted frame, it does not offer any complete claim interpretation. The court therefore considers whether E'Lite's proposed claim interpretation is in accordance with the meaning of the claim language.

A

E'Lite argues that the '207 patent claims cover only a top-mounted design, not a back-mounted design. To support this contention, it cites the deposition testimony of inventor Chao. In distinguishing the prior art, which relied on front-mounted, vertical magnet engagement, Chao states that his invention uses horizontal magnets to better withstand the effect of gravity. D.App. 25-26. This testimony, however, constitutes extrinsic evidence that is unnecessary to construe the claims of the '207 patent.

In addition to Chao's statements, E'Lite offers the testimony of David Chao ("D.Chao"), the brother of Chao and a corporate representative of Contour, the patent's owner. During the interference proceeding, D. Chao testified that another design, which was the subject of a later patent application, was not protected by the '207 patent because it was back-mounted. Even assuming *arguendo* that the testimony of a non-inventor during an interference proceeding is appropriate evidence to consider during claim construction, D. Chao's testimony is too brief and ambiguous to inform the court's interpretation of the claims. Although D. Chao asserts that his later design was "back mounted" and different from the design protected by the '207 patent, his only elaboration of the differences between the designs was his suggestion that his drawing did not actually include an extension arm and magnets. *See* D.App. 34. If D. Chao intends the term "back-mounted" to signify the lack of an extension arm and magnets, then he is using it differently than is E'Lite, who uses it to suggest vertical instead of horizontal magnet engagement. Without a more developed record of his testimony, therefore, it is insufficient to change the court's interpretation of the claims.

The plain meaning of the claims does not require the court to restrict them to a horizontal magnet engagement. Claim 1 simply refers to an eyeglass device in which the auxiliary spectacle frame arms extend over and engage with the upper side portion of the primary spectacle frame. This engagement is not restricted to horizontally mated magnets. To the extent that E'Lite means "back-mounted" to refer to the placement of the magnets, the court declines to adopt such an interpretation. If E'Lite is referring instead to the position of the primary frame magnets as being in the back of the temples, *see* D. Br. 3, it has not provided any argument in support of this interpretation. As a result, the court declines to construe the '207 patent to cover only a top-mounted design.

B

E'Lite next argues that the '207 patent claims require magnet-independent stable support of the auxiliary frame by the primary frame. The plain language of the claims, however, does not support this interpretation.

E'Lite cites the penultimate paragraph of claim 1, which describes an engagement between the magnets of the auxiliary frame arms and the magnets of the primary frame. It contends that this magnetic engagement is independent of the engagement described in the last paragraph of claim 1, which refers to auxiliary frame arms "being engaged with and supported on said upper side portion of said primary spectacle frame so as to allow said auxiliary spectacle frame to be stably supported on said primary spectacle frame[.]" '207 patent, col. 4, ll. 18-20. A reading of claim 1 as a whole, however, leads to the conclusion that the magnet engagement is not independent of a stable engagement of the auxiliary frame arm to the upper side portion of the primary frame. Claim 1 first describes the engagement of the auxiliary frame arms to the upper side portions of the primary frame. As E'Lite notes, the penultimate paragraph does describe a separate magnetic engagement. Nevertheless, the claim does not describe either engagement, especially the auxiliary frame arm to primary frame engagement, as being stable. Rather, the stability referred to in the last paragraph is the result of both the magnetic engagement and the engagement of the auxiliary frame arm to the upper side portion of the primary spectacle frame. Therefore, although claim 1 does describe a magnet-independent engagement, it does not require that this engagement alone provide stable support of the auxiliary frame by the primary frame.

The court's construction is consistent with the introductory section of the '207 patent. While explaining the deficiencies of the prior art, which lacked the support mechanism of the '207 patent, the patent states that with the previous devices, "the auxiliary lenses may easily move downward relative to the frames and may be easily disengaged from the frames when the users conduct jogging or jumping exercises." *Id*. at col. 1, 26-29. E'Lite asserts that in light of this language, the claims "should be construed to include magnet-independent stable support to prevent disengagement when the user conducts jogging or jumping exercises." D. Rep. Br. 4. This language, however, does not require that stable support be achieved independent of the magnets. To the contrary, under the claim language, the support mechanism plus the magnetic attraction secures the auxiliary spectacle frames to the primary frames.

C

Finally, E'Lite argues for an interpretation of claim 1 that would require that the auxiliary frame arms touch the upper side portion of the primary frame. In support of this construction, E'Lite notes that the claim describes the auxiliary frame arms as "being engaged with and supported on said upper side portion of said primary spectacle frame." '207 patent, col. 4, ll. 18-19. According to E'Lite, the use of the terms "engage" and "support" imply touching. Aspex does not dispute this construction and does not offer any alternative interpretation. Therefore, because this interpretation is consistent with the claim language, the court construes claim 1 to require that the auxiliary frame arms touch the upper side portion of the primary frame.

* * *

For the reasons set out, the court construes the claims of the '207 patent as follows:

(1) the claims are not restricted so that they cover only a top-mounted design in which the magnets mate vertically;

(2) the claims do not require magnet-independent stable support of the auxiliary frame by the primary frame; and

(3) the auxiliary frame arms must touch the upper side portion of the primary frame.

SO ORDERED.

N.D.Tex.,2001.
Aspex Eyewear, Inc. v. E'lite Optik, Inc.

Produced by Sans Paper, LLC.