United States District Court,
E.D. Missouri, Eastern Division.

CLIPPS, INC,
Plaintiff(s).
v.
CLEANER'S SUPPLY COMPANY,
Defendant(s).

Aug. 13, 2002.

Named Expert: Gregory Upchurch
Stephen R. Matthews, Charles B. Haverstock, Haverstock and Garrett, St. Louis, MO, for Plaintiff.

Robert L. Epstein, James and Franklin, LLP, New York, NY, John H. Quinn, III, Partner, Armstrong Teasdale, LLP, St. Louis, MO, for Defendant.

Bruce E. Burdick, Haverstock and Garrett, St. Louis, MO.

MEMORANDUM AND ORDER

TERRY I. ADELMAN**, United States Magistrate Judge.**

This matter is before the undersigned on the parties' cross motions for summary judgment on the issue of patent infringement, and motions by both parties to exclude each other's expert testimony on the matter of claim construction. The parties consented to the jurisdiction of the undersigned pursuant to 28 U.S.C. s. 636(c).

Plaintiff is the manufacturer of a plastic clip used by the dry-cleaning industry to hold fabric on hangers. The Patent relates to a "U" clip with opposing members connected by an arcuate portion. Locking arms extend inwardly from the members and are engagable to lock the clip. During the patent application process, plaintiff's claims were repeatedly rejected by the patent examiner as reading on the prior art of three other clips, referred to herein as "Durham" (DX-2), "Smith" (DX-3), and "Reimels" (DX-4). Durham, a medical clamp, has thumb and finger pieces which are "knurled" to provide a more secure grip for the user. (DX-2, col.3). Smith, a surgical fabric clamp, has raised fingerpads with grooves to provide a resilient grip (DX-3, cols.2, 5). The drawings of the Smith clip reveal that the fingerpads are slightly concave (DX-3, figures 1-9). Reimels, a one-piece plastic towel clamp for use during surgical procedures, has thumb and finger pads are smooth and concave (DX-4).

On November 3, 1992, plaintiff obtained a patent on the clip (U.S. Patent Number 5,159, 730, entered into the record as DX-1, the "Radvin Patent") by amending its claims to add a limitation that the exterior surfaces opposite from the projections be "generally smooth and planar." Since about May of 2000, defendant has offered for sale a plastic clip which plaintiff contends infringes on claims 1, 7, and 11 of

plaintiff's patent.

Both parties seek summary judgment. Plaintiff seeks an order ruling that defendant has infringed plaintiff's patent, dismissing with prejudice defendant's affirmative defenses and counterclaims, finding defendant's infringement willful, awarding plaintiff compensatory damages, awarding treble damages, and limiting the issue for trial to the amount of damages due to plaintiff. Defendant seeks a ruling that defendant did not infringe on plaintiff's patent, or, alternatively, that the patent is invalid.

The court held a hearing in which each party urged the court to accept its claim construction and to exclude the testimony of the other's expert witness.

Plaintiff avers that defendant's clip infringes on claims 1, 7, and 11 of the Radvin Patent. The relevant portions of each claim read as follows:

CLAIM 1:

A clip comprising:

... a first projection located on the exterior surface of one of the opposing members and located between the first locking arm and one of the jaws, the first projection having a first surface against which a finger of an operator is positioned in which to lock the locking arms and a second surface against which the finger of the operator is positioned in which to lock the locking arms and a second surface against which the finger of the operator is repositioned to unlock the locking arms, *the exterior surface of one of the opposing members from the first locking arm opposite from the first projection being generally smooth and planar;* and

a second projection located on the exterior surface of the other one of the opposing members and located between the second locking arm and the arcuate portion, the second projection having a first surface against which a second finger of the operator is positioned in which to lock the locking arms and a second surface against which the second finger fo the operator is repositioned to unlock the locking arms, *the exterior surface of the other one of the opposing members from the second locking arm opposite from the second projection being generally smooth and planar*.

CLAIM 7

A clip comprising:

... a first projection on the first exterior surface on the U-shaped member located completely between the first locking member and one of the jaw portions, the first projection having a first surface against which a finger of an operator is positioned in which to engage the locking members and a second surface against which the finger of the operator is repositioned to disengage the locking members, *the first exterior surface extending from the first locking member being generally smooth and planar;* and

a second projection on the second exterior surface of the U-shaped member located between the second locking member and the arcuate portion, the second projection having a first surface against which a second finger fo the operator is positioned in which to engage the locking members and a second surface against which the second finger of the operator is repositioned to disengage the locking member, the *second exterior surface extending from the second locking member opposite from the second projection being*

generally smooth and planar.

CLAIM 11

A clip comprising:

..a first projection located at a first position on the exterior surface of one of the opposing members and located between the first locking arm and one of the jaws, *the exterior surface of one of the opposing members extending from the first locking arm opposite from the first projection being generally smooth and planar;* and

a second projection located at a second position on the exterior surface of the other one of the opposing members and located between the second locking arm and the arcuate portion, the first position being at a different location than the second position with respect to the arcuate portion, *the exterior surface of the other one of the opposing members extending from the second locking arm opposite from the second projection being generally smooth and planar*.

In order to determine whether defendant's clip directly infringes on plaintiff's patent, the court must engage in a two step analysis. First, the court must define, or construe, the claim. Second, the trier of fact must determine whether the claims, as construed by the court, cover the accused product. The patent holder bears the burden of proving infringement by a preponderance of the evidence. *See* SmithKline Diagnostics v. Helena Laboratories Corp., 859 F.2d 878, 889 (Fed.Cir.1988).

Claim Construction

Claim construction begins with the language of the claim. Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305 (Fed.Cir.1999). The words of the claims are given their ordinary meaning, unless the file specification or file history indicate that the inventor intended a different meaning. Young Dental Manufacturing Co. v. Q3 Special Products, Inc., 891 F.Supp. 1340, 1343 (E.D.Mo.1995) (citing Carroll Touch, Inc. v. Electro Mechanical Systems, Inc., 15 F.3d 1573, 1577 (Fed.Cir.1993). As an aid to claim construction, the court may refer to the specification, the prosecution history, and prior art. *Ibid.; see also* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996).

The dispute at the *Markman* hearing in this case centered on the meaning of the phrase "generally smooth and planar" in relation to the exterior surfaces opposite the projections. Since plaintiff did not define the terms in its specification, the court will rely on their ordinary meanings. Plaintiff urges the court to rely on its hypothetical claim construction, "to make the case more comprehensible for the Court and Jury." The court finds that reliance on the hypothetical is unnecessary and inappropriate, as the court and jury may rely on the ordinary meaning of the terms.

Webster's Dictionary defines the word "generally" as, "1. For the most part: WIDELY. 2. As a rule: USUALLY; 3. In disregard of particular instances and details."

"Smooth" is defined as "1. Having a surface free from roughness, irregularities, or projections: EVEN."

"Planar" is defined as "1. Of, pertaining to, or located on a plane. 2. Flat."

Having heard the arguments and reviewed the briefs of the parties in addition to studying the specification

and prosecution history FN1, the undersigned construes the disputed portions of the claims as follows:

FN1. The undersigned allowed each party to present expert testimony regarding claim construction. The court found this testimony helpful in understanding the purpose for which the clips were created and how they used. Accordingly, the parties' motion to exclude expert testimony will be denied. The court notes, however, that the undersigned did not rely on the expert testimony in the actual construction of the disputed terms.

-> **"Generally smooth" is construed to mean having a surface which is for the most part free from roughness, irregularities, or projections.**
-> **The word "generally" is construed to modify "planar,"** since one of the exterior surfaces on plaintiff's clip (identified in DX-1 as ref. 38) has a curve on one side. The court notes, however, that plaintiff's arguments regarding the examiner's comments (at prosecution history, pp. 76, 78-79) about curvature and concave surfaces do not bear on the claims because those comments were made in regard to the projections/protrusions (i.e.ref.50) and not the exterior surfaces opposite the projections.

-> **"Generally planar" is construed to include irregular deviations from a mostly flat surface,** such as the curve on the end of ref. 38 where it meets ref. 50. *See* Arvin v. Industries, Inc. v. Berns Air King Corp., 525 F.2d 182 (7th Cir.1975) (ruling that use of the word "generally" to modify "planar" does not negate the meaning of planar, but allows for some deviation from a perfectly flat surface).

-> **The first and second surfaces** described in the claims are the exterior surfaces located on either side of the projections (refs. 48 and 50).

Summary Judgment

Having construed the relevant claims, the undersigned considers the question of infringement. Whether the claims, as construed, read on defendant's clip is an issue of fact. Therefore, summary judgment for either party is appropriate only "if, after viewing all the facts in the light most favorable to the non-movant, there is no genuine issue whether the accused device is encompassed by the claims." Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1304 (Fed.Cir.1999). Although the parties differ in their interpretations of the prosecution history and in their view of how those interpretations bear on the construction of the claims, none of these disputes is material to the court's application of its claim construction to the accused product.

Plaintiff bears the burden of proving infringement by a preponderance of the evidence. *Kegel Co. Inc. v. AMF Bowling, Inc .,* 127 F.2d 1420, 1425 (Fed.Cir.1997). Accordingly, to defeat defendant's motion for summary judgment of non-infringement, plaintiff must demonstrate that the evidence is such that a reasonable jury could return a verdict for plaintiff." Pehr v. Rubbermaid, Inc., 87 F.Supp.2d 1222, 1226 (D.Kan.2000) (citing Anderson v. Liberty Lobby, 477 U.S. 242, 248 (1986). Plaintiff has failed to meet this burden.

Plaintiff alleges literal infringement, which requires plaintiff to establish that the accused device contains "each limitation of the claim exactly; any deviation from the claim precludes a finding of literal infringement." Lilton Systems, Inc. v. Honeywell, Inc., 140 F.3d 1449; 1454 (Fed.Cir.1998). Defendant concedes the presence of all elements of each of plaintiff's claims except those which require the first and

second exterior surfaces to be "generally smooth and planar."

Defendant contends that its clip does not infringe on plaintiff's patent because defendant's clip is not "generally smooth and planar," but instead "transversely ribbed" and "concave." Defendant argues that the exterior surfaces of its clip are not smooth because of the slight ribbing covering one half of each exterior surface. Furthermore, defendant suggests that its clip is not planar due to the curvature on its exterior surfaces.

Plaintiff, of course, disputes defendant's interpretation. Plaintiff's primary argument is that "generally smooth and planar" includes "slightly concave," and therefore encompasses defendant's clip. Plaintiff bases its argument on the fact that the examiner approved the "generally smooth and planar" language (in fact, plaintiff claims the examiner suggested this language) after noting that plaintiff's clip had concave surfaces (See.history, pp. 76, 79).

Plaintiff's argument is unpersuasive because the court believes that the examiner's comments cited by the plaintiff actually related to the projections rather than the exterior surfaces opposite the projections which are at issue in this case. The exterior surfaces of the accused clip are not generally planar, as that term has been construed by the court, but are instead concave. Furthermore, the court rejects plaintiff's contention that anything smoother than the Smith clip is included in the phrase "generally smooth." The court has construed "generally smooth" to mean "free from roughness, irregularities or projections." This term does not read on defendant's clip because more than half of each finger pad (i.e., the exterior surface) is textured, not smooth. Therefore, the court finds that the accused clip does not literally infringe on plaintiff's patent.

Plaintiff argues in passing that it has proved infringement under the doctrine of equivalents. "The doctrine of equivalents exists 'to prevent a fraud on the patent when an accused infringer is stealing the benefit of the invention by making insubstantial changes that avoid the literal scope of the claims.' " Pehr, 87 F.Supp.2d at 1235 (quoting EMI Group North America, Inc. v. Intel Corp., 157 F.3d 887, 896 (Fed.Cir.1998). In order to prevail on such a claim, plaintiff must submit evidence demonstrating that the accused device performs substantially the same function in substantially the same way to achieve substantially the same result as *each element* of the claimed invention. Pehr, 87 F.Supp.2d at 1235 (citing Overhead Door Corp. v. Chamberlain Group, Inc., 194 F.3d 1261, 1270 (Fed.Cir.1999). The doctrine "must be applied to individual elements of the claim, not to the invention as a whole. It is important to ensure that the application of the doctrine, even as to an individual element, is not allowed such broad play as to effectively eliminate that element in its entirety." Warner-Jenkinson Co., Inc., 520 U.S. 17, 29, 117 S.Ct. 1040(1997).

The court has reviewed the specifications of each clip and examined the clips themselves. Plaintiff has not met its burden, in fact can not meet its burden, because the two clips operate in a different manner. Plaintiff's clip relies on projections and the repositioning of fingers for opening and closing, while defendant's clip relies on extended finger pads with grooves to hold the fingers in place.

Accordingly,

IT IS HEREBY ORDERED that defendant's Motion for Summary Judgment (# 39) is **GRANTED.**

IT IS FURTHER ORDERED that plaintiff's Motion for Summary Judgment (# 57) is **DENIED.**

IT IS FURTHER ORDERED that both parties' Motions to Exclude (# s 42 and 52) are **DENIED.**

IT IS FURTHER ORDERED that plaintiff's claims are **DISMISSED .**

IT IS FURTHER ORDERED that each party bear its own costs with regard to the deposition of Jack Caulfield as an expert witness.

E.D.Mo.,2002.
Clipps, Inc. v. Cleaner's Supply Co.

Produced by Sans Paper, LLC.