United States District Court,
W.D. Texas, San Antonio Division.

Eric WASINGER,
Plaintiff.
v.
LEVI STRAUSS & Co., et. al,
Defendants.

Civil Action No. 01-CA-1056-EP

Jan. 15, 2003.

Eric W. Cernyar, Benjamin F. Youngblood, III, Bernard W. Fischman, Attorney at Law, Richard E. Tinsman, Tinsman, Scott & Sciano, Inc., San Antonio, TX, Bryan Douglas Wright, Williams Mullen, Charlottesville, VA, for Plaintiff.

Peter H. Goldsmith, Townsend, Townsend, Crew LLP, Virginia S. Medlen, Medlen & Carroll, L.L.P., San Francisco, CA, Robert A. McFarlane, J. Donald Best, Micael Best & Friedrich LLP, John Mitchell Jones, Medlen & Carroll L.L.P., Thomas W. Brown, John C. Scheller, Michael Best & Friedrich, Llp, Madison, WI, Peter G. Carroll, Medlen & Carroll, L.L.P., Quincy, MA, for Defendants.

ORDER

EDWARD C. PRADO **District Judge.**

In this patent case, the parties requested a *Markman* hearing so that the Court could construe a disputed term in U.S. Patent No. 5,366,510 (the '510 patent). A Markman hearing was held on December 20, 2002. After considering the parties' briefs and the testimony of the attorneys at the hearing, the Court finds that "desizing" means "the removal of size from fabrics."

Introduction and Procedural History

Plaintiff has sued Defendant for patent infringement and seeks to prohibit Levi Strauss from infringing, manufacturing, and selling jeans manufactured with the process and inventions embodied in the '510 patent: "Process for Desizing and Color Fading Garments." Plaintiff is the inventor who owns the ' 510 patent as well as number of other patents concerning the treatment of denim for clothing. In March 1998, Levi Strauss licensed the '510 patent from Plaintiff, but the license was terminated by Levi Strauss in March 1999. After termination of the license, Plaintiff discovered that Levi Strauss was importing and selling jeans in the United States, allegedly using his process. The parties voluntarily dismissed Sears, Roebuck from the suit without prejudice in November 2002.

Markman Hearing

Claims 1-8 and 12-13 of the '510 patent are asserted by Plaintiff in this case. Generally, the parties agree on the construction of the terms which appear in these claims. However, the parties dispute the meaning of the term "desize" or "desizing" as used in the '510 patent. The parties requested a *Markman* hearing so that the Court could review the relevant evidence and determine the meaning of the claims as a matter of law.

Claim Construction

"Patent infringement occurs when a device (or composition or method), that is literally covered by the claims or is equivalent to the claimed subject matter, is made, used, or sold, without the authorization of the patent holder, during the term of the patent." Multiform Desiccants, Inc. v. Medzam, Ltd., 133 F.3d 1473, 1476 (Fed.Cir.1998) (citing 35 U.S.C. s.s. 271). Before determining whether a device infringes a patent, the Court must construe the claim to determine its scope and meaning. Only after the claim is construed, can the Court compare the claim to the accused device or process. Carroll Touch, Inc. v. Electro Meek Sys., Inc., 15 F.3d 1573, 1576 (Fed.Cir.1993); *see also* Wang Labs., Inc. v. Am. Online, Inc., 197 F.3d 1377, 1380 (Fed.Cir.1999); EMI Group N. Am., Inc. v. Intel Corp., 157 F.3d 887, 891 (Fed.Cir.1998). Claim construction is a matter of law, Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1456 (Fed.Cir.1998) (en banc).

Courts must apply the canons of claim interpretation, which are "the tools that permit resolution of disputes as to the correct meaning of claim language." Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1341 (Fed.Cir.2001). The Court must first examine the "intrinsic evidence" when construing the meaning of a patent claim. Intrinsic evidence includes the claim itself, the specification, and the prosecution history of the patent. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed .Cir.1996).

The Court must first consider the words of the claims themselves, "both asserted and unasserted, to define the scope of the patented invention." Id. at 1582; *see also* Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1248 (Fed.Cir.1998). The words are generally given their customary and ordinary meaning. *See* Rexnord, 274 F.3d at 1342 ("As we have often stated before, as a general rule, all terms in a patent claim are to be given their plain, ordinary and accustomed meaning to one of ordinary skill in the relevant art."); Vitronics, 90 F.3d at 1582.

However, the Court must also consider the written description to determine whether the inventor has "employed any terms or words in a manner that is inconsistent with their plain and ordinary meaning." Vitronics, 90 F.3d at 1582. The Court must follow the definition of terms intended by the patentee if his or her special definition is clearly delineated in the specification or file history. *See* id. at 1583; Hoechst Celanese Corp. v. BP Chemicals, Ltd., 78 F.3d 1575, 1578 (Fed.Cir.1996).

Consideration of the written description is also crucial to ensure that the Court's construction of the claim limitations include the disclosed preferred embodiment. *See* Rexnord, 274 F.3d at 1342 ("[B]ecause a claim construction that would exclude the preferred embodiment 'is rarely, if ever, correct and would require highly persuasive evidentiary support,' a court mindful of this canon of construction would need to examine the written description and the drawings to determine whether the preferred embodiment falls within the scope of a construed claim.") (citations omitted).

The Court may also review the prosecution history of the patent, if admitted into evidence. Vitronics, 90 F.3d at 1582. This history is "the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by the applicant regarding the scope of the claims." *Id*. It

also includes prior art, which is cited in the file history. *Id*. at 1583.

The Court may resort to extrinsic evidence only if the intrinsic evidence is considered and there still remains some ambiguity as to the scope or meaning of the claim. Vitronics, 90 F.3d at 1583. This extrinsic evidence can include any evidence outside the patent and prosecution history such as prior art documents, dictionaries, technical treatises, articles, expert testimony, and inventor testimony. Id. at 1584. However, "extrinsic evidence in general, and expert testimony in particular, may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language." *Id*.

Construction of "Desizing"

Plaintiff has set forth several definitions for "desizing" including (1) a continuous process during wet processing and (2) a chemical or mechanical process to remove an amount of sizing to a degree so the fabric is susceptible to particular use or feel. At the *Markman* hearing, Plaintiff simplified his definition and argued that "desizing" is simply the removal of size from fabrics. Defendant maintains that "desizing" is a preliminary step in wet processing of fabric and garments for removing sizing from unfinished, fully-sized (i.e., greige or gray) fabric or garments so that any residual sizing that may remain does not interfere with subsequent, conventional finishing steps such as, for example, stone washing, treatment with cellulase enzymes, oxidizers, bleaches, or reducing agents. The main issue of contention is whether, as Defendant claims, desizing is an initial process, or whether it can occur at any time, as Plaintiff claims.

Because there is more than one dictionary definition of "desizing," the Court must consult the intrinsic record of the '510 patent. The intrinsic record must be consulted in addition to dictionaries to "identify which of the different possible dictionary meanings of the claim term in issue is most consistent with the use of the words by the inventor." Texas Digital Sys., Inc., v. Telegenix, Inc., 308 F.3d 1193, 1203 (Fed.Cir.2002); *see also* Dow Chem. Co. v. Sumitomo Chem. Co., 257 F.3d 1364, 1372-73 (Fed.Cir.2001). Defendant argues that desizing must occur as a preliminary step, but to construct desizing this way would exclude the preferred embodiment of "simultaneously desizing and decolorizing a dyed fabric or dyed garment." '510 patent, col. 6, 1n. 1-2. Defendant also argues that "desizing" must occur on gray goods or goods that have not undergone processing such as dyeing, which would exclude the above embodiment where a dyed garment is desized. As a result, the Court finds that "desizing" means "the removal of size from fabrics." This definition is consistent with the patent language.

Defendant may be correct in asserting that the '510 patent requires the desizing to occur before other processing steps. *See* '510 patent at col. 2, ln. 39-40, ('510 patent applies to "... dyed fabrics and garments which are required to be desized before undergoing further processing"). However, this limitation is accomplished through the language of the patent, not the definition of desizing.

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