United States District Court,
C.D. California.

ASPEX EYEWEAR,
INC. et al. Plaintiffs.
v.
MIRACLE OPTICS, INC,
Defendant.

No. CV 01-10396 LGB

Feb. 14, 2003.

Ako S Williams, Rutan and Tucker, Costa Mesa, CA, Lead Attorney, Attorney to be Noticed, Barry J Schindler, Greenberg Traurig, New York, NY, Lead Attorney, Attorney to be Noticed, for Aspex Eyewear Inc., Plaintiff.

ORDER CONSTRUING CLAIMS OF U.S. PATENTS RE 37,545 and 6,109,747

BAIRD**, J.**

I. INTRODUCTION

This action arises out of defendant Miracle Optics, Inc.'s ("Miracle" or "Defendant") alleged infringement of plaintiffs Aspex Eyewear, Inc. ("Aspex"), Manhattan Design Studio ("MDS"), Contour Optik, Inc. ("Contour") and Asahi Optical Co., LTD.'s ("Asahi"), FN1 U.S. Patents No. RE 37,545 E (the " '545 Patent") and No. 6,109,747 (the " '747 Patent"). This matter is before the Court for the purpose of interpreting the disputed claims of the '545 and '747 patents.

FN1. Aspex, MDS, Contour and Optical are collectively referred to as "Plaintiffs."

II. FACTUAL AND PROCEDURAL HISTORY

For purposes of the instant motion, the Court finds the following facts to be relevant. FN2 The technology at issue in this case involves a spectacle frame that supports an auxiliary frame, enabling the user to securely fasten a second set of lenses (e.g., sunglass lenses) onto the primary frame (often holding prescription lenses). Plaintiffs' '545 Patent, which issued on February 12, 2002, is directed to a spectacle frame that supports an auxiliary lens frame through an arrangement using magnetic members. The '545 is a reissue of Plaintiffs' original U.S. Patent No. 5,568,207 (the " '207 Patent"), which has now been surrendered. Plaintiffs' '747 patent, which issued on August 29, 2000, is a species of the broader invention covered by the '207 Patent, now surrendered in favor of the '545 Patent. The '747 patent is directed to a "back-mounted" design, wherein the auxiliary frame arms extend over the primary frame, and include flanges formed with magnetic materials for engaging corresponding magnetic materials secured to the rear

and side portions of the primary frame.

FN2. The Court recognizes that Defendant has submitted the declaration of its expert, Katherine McGuire, in support of its claim construction brief and that Plaintiffs object to said declaration. The Court finds that a consideration of extrinsic evidence, especially expert evidence, is unnecessary given the clear and unambiguous claim language of the patents at issue, read in light of the specification and the prosecution history; and as such, the Court only refers to evidence that establishes "facts" which are crucial for purposes of the Court's claim construction. *See* Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1583 (Fed.Cir.1996).

For purposes of the Court's claim construction endeavor here, it suffices to note that Plaintiffs accuse Defendant of infringing the '545 and the '747 patents. Pursuant to the Court's June 13, 2002 Order, the parties submitted a Joint Claim Construction Statement on June 17, 2002 ("Joint Statement" or "JS"). Plaintiffs filed their Opening Claim Construction Brief ("Pls.' Opening") on June 24, 2002. Defendants filed their Opposition to Pls.' Opening on July 1, 2002 ("Def.'s Opposition"). Plaintiffs filed their Reply ("Pls .' Reply") on July 8, 2002. Defendant filed its Surreply on July 25, 2002 ("Def.'s Surreply"). Plaintiffs filed their response to Defendant's Surreply on July 31, 2002 ("Pls.' Response to Surreply"). FN3

FN3. By Minute Order dated July 18, 2002, the Court granted Defendant's *ex parte* application to file a surreply brief and Plaintiffs' *ex parte* application to file a response to Defendant's surreply brief.

III. LEGAL STANDARDS

In Markman v. Westview Instruments, Inc., 517 U.S. 370 (1996), the Supreme Court held that the interpretation of a patent claim-the portion of the patent document that defines the scope of the patentee's rights-is a matter of law exclusively within the scope of the court and is not a factual question for the jury. Id. at 372. The *Markman* decision suggested that a trial court could consider various types of evidence when interpreting a patent, including expert testimony. *See id.* at 388-90. Shortly after the Supreme Court handed down *Markman,* the Federal Circuit, in Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576 (Fed.Cir.1996), expanded on the Court's dicta concerning evidence available to a trial court in interpreting patent claims. *See* id. at 1581-83. The Federal Circuit held that if intrinsic evidence can, by itself, resolve ambiguity in a patent term, then a court may not rely on extrinsic evidence, such as expert testimony, to construe the term. *See* id. at 1583. A trial court may only use extrinsic evidence when intrinsic evidence fails to illuminate the meaning of the disputed claim. *Id.* Moreover, extrinsic evidence cannot broaden the reach of a claim or contradict explicit language. *Id.* The policy rationale supporting this evidentiary limitation is that prospective patentees must have access to public records concerning the patent to "design around" a prior art. *Id.* If expert testimony or other extrinsic evidence were permitted to alter the record, then this public benefit would be frustrated. *Id.* Thus, a court can only examine extrinsic evidence if the evidence does not contradict the claim language, the specification, or the prosecution history but instead supplements it. *Id.* at 1584-85.

The Federal Circuit detailed a hierarchy of specific types of evidence that a court may consider. Thus, when interpreting a patent, a trial court must first look at the language of the claim itself. *See id.* at 1582. Courts should typically construe terms by their common, customary meaning, but a patentee is allowed to define her own terms in the specification section of the patent. *See id.* Therefore, courts must always review the

specification, which, when setting forth an embodiment of the invention, frequently provides explicit definitions of the claim terms. *See id*. The language in the specification is dispositive, and "it is the single best guide to the meaning of the disputed term." *Id*. However, a patent's claims are not limited to the specification's best mode, preferred embodiment, specific objects, or illustrative examples, and it is erroneous to read limitations from the specification into the claims. *See* Laitram Corp. v. Cambridge Wire Cloth Co., 863 F.2d 855, 865 (Fed.Cir.1988)("References to a preferred embodiment, such as those often present in a specification, are not claim limitations."); Rolls-Royce Ltd. v. GTE Valeron Corp., 800 F.2d 1101, 1108 (Fed.Cir.1987) ("Reference to an object does not constitute in itself a limitation in the claims."). In addition, a court may consider the prosecution history of the patent as evidence of meaning. *Id*. This history contains the complete record of all the filings and examinations before the Patent and Trademark Office ("PTO"), including representations made by the applicant regarding the significance of claims and terms. *Id*. The history also limits the interpretation of terms by recording the exclusion of any term definition disclaimed during the prosecution. *Id*.

B. Analysis

1. The claims in dispute

Pursuant to the Joint Statement, the following claims of the '545 and the '747 patents contain terms that are disputed by the parties. FN4 *See* JS at 2:1-11.

FN4. The disputed terms are shown in bold.

a. Disputed claims in the '545 Patent

Claim 12:

An eyeglass device reciting:

a primary spectacle frame having two side portion extensions, each of said extensions having a front side, a rear side and a first magnetic member secured to said rear side,

an auxiliary spectacle frame including two side portions each having an arm extended therefrom for extending toward and beyond said rear side, each of said arms containing a second magnetic member, and

said arms and said first and second magnetic members cooperating to stably support said auxiliary spectacle frame on said primary spectacle frame.

'545 Patent, Declaration of Dave B. Koo in Support of Def.'s Opposition ("Koo Decl."), Exh. 1, Col. 4, 11. 63-Col. 5, 11. 7.

Claim 16:

An eyeglass device comprising:

a primary spectacle frame having two side portion extensions each of said extensions having a front side and a rear side with a first magnetic member secured to said rear side, and an auxiliary spectacle frame

including two side portions, each of said side portions having an arm extended therefrom for extending beyond said rear side, said arms containing corresponding second magnetic members, said arms and said first and second magnetic members supporting said auxiliary spectacle frame on said primary spectacle frame.

Id., Col. 5, 11. 28-40.

Claim 24:

An eyeglass device comprising:

an auxiliary spectacle frame for supporting auxiliary lenses therein, said frame including a front side, a rear side, and oppositely positioned side portions, each of said side portions having an arm extended therefrom, each of said arms having a rearwardly directed end for securing a magnetic member, a pair of magnetic members respectively located at said ends of said arms, each of said ends further including a downwardly extended end portion for hooking onto a primary spectacle, said arms and said pair of magnetic members adapted to extend across respective side portions of a primary spectacle frame so that said pair of magnetic members can engage corresponding magnetic members on a primary spectacle frame.

Id., Col. 7, 11. 6-20.

b. Disputed claim in the '747 Patent

Claim 12:

A primary frame adapted to support an auxiliary frame, which includes a first bridge and two sides, each side having an extension and each extension including a rear end having a first flange extended downward, each flange, itself not being a magnet, including a magnetic material, the primary frame comprising:

a second bridge; and

two sides, each having a stud, each stud including a magnetic material;

wherein when the primary frame is supporting the auxiliary frame,

each magnetic material of the primary frame magnetically engages in a lateral manner with one of the magnetic materials of the auxiliary frame for securing said auxiliary frame to said primary frame;

each stud is extended over by one of the extensions, and can support that extension to prevent the auxiliary frame from moving downward relative to the primary frame; and

the flanges are located behind the studs to further secure the auxiliary frame to the primary frame, and to reduce the likelihood of the auxiliary frame from being disengaged from the primary frame if the auxiliary frame is being pulled forward relative to the primary frame.

2. The disputed terms

The Court first considers the disputed claim terms in the '545 Patent, followed by the disputed terms in the

'747 Patent.

a. Disputed terms in the '545 Patent

The following terms or combination of terms are in dispute:(1) "eyeglass device" (claims 12, 16 and 24), (2) "primary spectacle frame" (claims 12, 16 and 24), (3) "two side portion extensions" (claims 12 and 16), (4) "magnetic member" (12, 16 and 24), (5) "secured to said rear side" (claims 12 and 16), (6) "auxiliary spectacle frame", (7) "two side portions" of the auxiliary spectacle frame (claims 12, 16 and 24), (8) "an arm extended therefrom for extending toward and beyond said rear side" (claim 12), (9) "an arm extended therefrom for extending beyond said rear side" (claim 16), (10) "arms having a rearwardly directed end" (claim 24), (11) "said arms and said second magnetic members cooperating to stably support said auxiliary spectacle frame on said primary spectacle frame" (claim 12), (12) "said arms and said first and second magnetic members supporting said auxiliary spectacle frame on said primary spectacle frame" (claim 16), (13) "each of said ends further including a downwardly extended end portion for hooking onto a primary spectacle" (claim 24), and (14) "said arms and said pair of magnetic members adapted to extend across respective side portions of a primary spectacle frame so that said pair of magnetic members can engage corresponding magnetic members on a primary spectacle frame" (claim 24). The Court now addresses each of these disputed terms.

(1) "eyeglass device" (claims 12, 16 and 24)

Plaintiffs argue that the term "eyeglass device" in claim 12, 16 and 24 is a preamble term that does not require construction. Pls .' Opening at 5:9-15. Conversely, Defendant argues that "eyeglass device" should be construed to mean "an eyeglass device includes [sic] a primary frame and an auxiliary sunglass frame having the following components." JS, Exh. D at 1.

The term "eyeglass device" is in the preamble of claims 12, 16 and 24. The Federal Circuit has held that "[i]f the body of the claim sets out the complete invention, and the preamble is not necessary to give 'life, meaning and vitality' to the claim, 'then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation." ' Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc., 246 F.3d 1368, 1373-74 (Fed.Cir.2001) (internal citations omitted). In this case, Defendant has not shown -or even argued-that the bodies of claims 12, 16 and 24 do not set the complete invention and that the preamble is necessary to give "life, meaning and vitality" to the claims in question. The Court also finds that the body of each of the three claims in dispute sets out the complete invention. Therefore, the Court shall not construe the term "eyeglass device."

(2) "primary spectacle frame" (claims 12, 16 and 24)

Plaintiffs argue that "primary spectacle frame" means "the entirety of the primary eyeglass frame with the exception of the lenses, the plastic nose pieces (which touch the upper sides of the wearers's nose), and the legs ... which extend back over the wearer's ears." JS, Exh. B at 1. Plaintiffs further state that the primary spectacle frame "includes the lens rims (if provided), nose bridge, extensions, projections (if provided), and first magnetic member." *Id.*

Defendant does not dispute the components which Plaintiffs contend are included in the primary spectacle frame. Instead, Defendant contends that the primary spectacle frame also includes "two lens rims of a continuous eye-loop type to secure eyeglass lenses as depicted in Figures 1 and 3" of the patent. JS, Exh. D at 1. Defendant's proposed construction infers that the primary spectacle frame cannot include rim locks.

FN5 Defendant points to a statement that David Chao, the inventor of the '747 patent, made during the prosecution of patent application 847,710 (the " '710 Application"). FN6 Def. Opposition at 6:9-13. Specifically, David Chao stated that "[t]he [Richard] Chao ['207] Patent has not explicitly described using rim locks to attach primary frames to auxiliary frames. In fact, there is no discussion of rim locks in the Chao Patent." Prosecution File History of the '207 Patent, Declaration of Dave B. Koo ("Koo Decl."), Exh. O at 1459.

FN5. A "rim lock" is a structure built in the lens rim of the spectacle frame, which allows the spectacle frame to be opened so that lenses can be easily inserted. The rim lock usually includes an upper and a lower member, each with a hole for engaging with a fastener. *See e.g.,* U.S. Patent Application No. 847,710, Koo Decl., Exh. O at 1398 and 1404 (describing a spectacle frame with rim locks).

FN6. Patent Application No. 847,710, filed on April 28, 1997, was directed to an eyeglass assembly wherein the spectacle frame includes rim locks. *See* Koo Decl., Exh. O at 1396. The application was deemed abandoned by the PTO on August 16, 1999, after the applicant failed to timely respond to a PTO office action. *See* PTO Notice of Abandonment, *Id*. at 1471-72.

The PTO examiner, however, was not persuaded by David Chao's attempt to distinguish the '207 Patent on the basis of rim locks. Specifically, in a subsequent and final Office Action dated January 3, 1999, the PTO examiner stated:

Claims 1-2 [of the '710 Application] are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of [the '207 Patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention in claims 1-2 is substantially similar to that in claim 1 of Chao '207 [P]atent.

Koo Decl., Exh. O at 1466.

In addition, since the patentee is not required to describe in the specification every conceivable embodiment of his or her invention, the '545 Patent did not need to include a discussion or drawings of primary frames with rim locks for the claims to cover that particular embodiment. *See* Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1344 (Fed.Cir.2001) (stating that a patentee "is not required to describe in the specification every conceivable and possible future embodiment of his invention.").

Therefore, the court declines to limit the definition of a "primary spectacle frame" to a continuous eye-loop type. Instead the Court construes "primary spectacle frame" to mean the entirety of the primary eyeglass frame with the exception of the lenses, the plastic nose pieces (which touch the upper sides of the wearers's nose), and the legs, which extend back over the wearer's ears; thus, the primary spectacle frame includes the lens rims (if provided), nose bridge, extensions, projections (if provided), the first magnetic member and conceivably rim-locks.

(3) "two side portion extensions" of the primary spectacle frame (claims 12 and 16):

Plaintiffs contend that "two side portion[s]" means "those portions of the primary spectacle frame beginning at the point where a line drawn through the midpoints of the lenses and lens rims (if supplied) would

intersect the top and bottom of the primary spectacle frame, and terminating at the pivot point where the legs are attached to the extensions." JS, Exh. B at 4. Additionally, Plaintiffs state that "extensions" means "those portions of the primary spectacle frame which extend outwardly and rearwardly of the lenses or lens rims (if provided) to pivotally connect to the legs and which secure the first magnetic members." *Id.,* Exh. B at 7.

Conversely, Defendant construes the phrase "two side portion extensions" as "essentially bars which extend outward from the outer edge of the lens rims." *Id.,* Exh. D at 1.

In this case, the two side portion extensions are described as follows in the specification of the '545 Patent: "The primary spectacle frame 10 includes two side portions each having an extension 11 extended rearward therefrom for pivotally coupling leg 12 thereto." Koo Decl., Exh. B, Col. 2, 11. 33-36. The Court finds Defendant's use of the term "bar" to describe each side portion extension to be somewhat vague. Additionally, Plaintiffs' use of the midpoints of the lenses and lens rims to define the instant phrase is also vague and confusing. FN7 Moreover, the Court does not find it necessary to bifurcate the construction of the instant phrase as Plaintiffs suggest. Instead, and based on the specification and the drawings of the '545 Patent, the Court construes "two side portion extensions" to mean those portions of the primary spectacle frame which extend outwardly and rearwardly of the lenses or lens rims (if provided) to pivotally connect to the legs.

FN7. Specifically, Plaintiffs define the starting point of each side as follows: where a line drawn through the midpoint of the lens and lens rims (if provided) would intersect the top and bottom of the frame. The Court notes that since each lens is, geometrically speaking, not a line or an arc, it is not clear where its midpoint would be (or that of the lens rim). *See* Webster's Encyclopedic Unabridged Dictionary of the English Language, defining "midpoint" as "a point at or near the middle of or equidistant from both ends as of a line," and "the point on a line segment or an arc that is equidistant when measured along the line or the arc from both endpoints."

(4) "magnetic member" (claims 12, 16 and 24)

Plaintiffs argue that the term "magnetic member" in claims 12, 16 and 24 means "a magnet or magnetically attractive material." JS, Exh. B at 10, 19, 33, 42 and 51. Conversely, Defendant argues that the phrase "magnetic member" is limited to a magnet. *Id.,* Exh. D at 1, 2, 4, 5 and 6.

Defendant contends that the magnetic members must be magnets because "[t]he specification requires that the magnetic members attract towards one another ..." and "[o]n [sic] FN8 two magnets magnetically attract each other." Def. Response at 7:9.

FN8. Presumably, Defendant intended to say "Only."

As counsel acknowledged at Oral Argument on February 7, 2003, the construction of the phrase "magnetic member" is heavily contested by the parties. Preliminarily, the Court finds it helpful to re-state the applicable law on claim construction. In the seminal case of *Vitronics,* the Federal Circuit established a three-tiered hierarchy of intrinsic evidence that a court must first consider in construing claim terms. *See* Vitronics, 90 F.3d at 1581-83.

First a court must "look to the words of the claims themselves, both asserted and nonasserted, to define the scope of the patented invention." Id. at 1582. In this case, claims 12, 16 and 24 of the '545 Patent do not expressly define the phrase "magnetic members." The ordinary meaning of "magnetic" is "having the properties of a magnet" and "capable of being magnetized or *of being attracted by a magnet*." Webster's II New College Dictionary ("Webster's"), Declaration of Michael A. Nicodema in Support of Plaintiffs' Opening Brief ("Nicodema Decl."), Exh. 5 at 140 (emphasis added). Additionally, dependent claim 13 states that the magnetic members are magnets. *See* Koo Decl., Exh. B, Col. 5, 11. 8-9. Under the doctrine of claim differentiation, where some claims are broad and others are narrow, the narrow claim limitations cannot be read into the broad claims. Yarway Corp. v. Eur-Control USA, Inc. 775 F.2d 268, 274-75 (Fed.Cir.1985). On the basis of that doctrine, the construction of the phrase "magnetic member" includes a magnet but cannot be limited to only a magnet. Thus, based on the ordinary meaning of the claim terms and on the doctrine of claim differentiation, the Court initially construes the phrase "magnetic member" to be a magnet, a material with the properties of a magnet or a material capable of being attracted by a magnet.

Second, "it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning. The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication." Vitronics, 90 F.3d at 1582. In this case, the specification of the '545 Patent does not expressly or impliedly define the phrase "magnetic member" in a manner inconsistent with its ordinary meaning-here, a magnet, a material with the properties of a magnet or a material capable of being attracted by a magnet.

Third, "the court may also consider the prosecution history of the patent, if in evidence. This history contains 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. at 1582 (internal citations omitted). During the prosecution of the '545 Patent, the applicant's attorney acknowledged that the magnetic members 14 and 22 are magnets which couple to each other. *See* Koo Decl., Exh. E, Pros. History, at 375 (the applicant's attorney stated to the PTO: "[a]s clearly shown in Figure 7 of the '207 patent, the two magnetic members 14 and 22 are in proximity of, coupled to, but not in contact with each other. Magnets are coupled to each other when they are in proximity of each other."). However, and as Plaintiffs' counsel pointed out during Oral Argument, that portion of the prosecution history dealt with the issue of whether magnetic engagement "without contact" was new matter, *see* id., and not with the construction of the phrase "magnetic member." Thus, there was no clear intent on the part of the patentee to limit magnetic members to magnets. *See* Schumer v. Lab. Computer Systems, Inc., 308 F.3d 1304, 1313 (Fed.Cir.2002) ("the prosecution history limits even clear claim language so as to exclude any interpretation that was surrendered during prosecution, *but only where ... the patentee surrendered that interpretation with reasonable clarity and deliberateness*.") (emphasis added).

Additionally, Plaintiffs' counsel argued at Oral Argument that the Court should consider U.S. Patent No. 5,416,537 (the "Sadler Patent") in construing the instant phrase. In *Vitronics,* the Federal Circuit stated that "[i]ncluded within an analysis of the file history, [*i.e..,* in the third tier of intrinsic evidence to consider during claim construction], may be an examination of the prior art cited therein." Vitronics, 90 F.3d at 1583; *see also* In re Cortright, 165 F.3d 1353, 1358 (Fed.Cir.1999) (stating that "[p]rior art references may be indicative of what all those skilled in the art generally believe a certain term means."). In this case, not only was the Sadler Patent referenced in the '545 Patent, *see* '545 Patent, Koo Decl., Exh. B, Col. 1, ll. 22-23, but it was also cited by the examiner during the prosecution of the '545 Patent and a copy of the patent itself was incorporated in the file wrapper of the '545 Patent. *See* July 15, 1999 Office Action, Koo Decl., Exh. E

at 173-179. Thus, and consistent with *Vitronics,* the Court now considers the extent to which the Sadler Patent sheds light on the construction of the phrase "magnetic member."

The Sadler Patent discloses "magnetic means for securing auxiliary lenses to eyeglasses." *See* the Sadler Patent, Koo Decl., Exh. E at 174. Like the '545 Patent, the Sadler Patent employs the phrase "magnetic members" to refer to the "first" member in the primary frame and to the "second" member in the auxiliary frame. *See* the Sadler Patent, Koo Decl, Exh. E, Col. 2, 11. 43-54. Additionally, the Sadler Patent defines "magnetic member" as being made of permanent magnetic material or a ferromagnetic material.FN9 *See id.* at Col. 3, ll. 21-23. However, "[a]t least one of the first and second magnetic members must be made of a permanent magnetic material in order for a magnetic attraction to exist." FN10 *Id.* at Col. 3, 11. 23-25. Additionally, the Sadler Patent contains a dependent claim, claim 2, that narrows the construction of "magnetic member" to a permanent magnet. Thus, the phrase "magnetic member" in the Sadler Patent is clearly construed to be a permanent magnet or a ferromagnetic member, but at least one of the first or second magnetic members must be a permanent magnet.

FN9. A ferromagnetic material is a material that is attracted by a permanent magnet, *e.g.,* iron, nickel and cobalt. *See* A Review of Magnets and Magnetism at *http://my.execpc.com/~rhoadley/magencyc.htm.* (hereafter "A Review of Magnets and Magnetism").

FN10. This, of course, makes sense since two pieces of ferromagnetic material, *e.g.,* two pieces of iron, will not attract each other.

As stated above, the Court initially construed the phrase in question to mean a magnet, a material with the properties of a magnet or a material capable of being attracted by a magnet. The first two parts of this construction, a magnet or a material with the properties of a magnet, are for all practicable purposes the same, a permanent magnet. The last part of this definition, a material capable of being attracted by a magnet, is but another way to describe a ferromagnetic material. However, the Court finds the use of the term "ferromagnetic" to be more precise and definite.FN11 Therefore, the Court construes the phrase "magnetic member" to mean a permanent magnet or a ferromagnetic member, but at least either the first or second magnetic members must be a permanent magnet.FN12

FN11. A ferromagnetic material is not the only material that exhibits attraction to a permanent magnet. For example, a paramagnetic material, *e.g.,* aluminum, also exhibits such attraction. However that attraction is much weaker than the one between a ferromagnetic material and a permanent magnet, and thus is inapplicable to the technology at issue here. *See* A Review of Magnets and Magnetism at 2.

FN12. Defendant argues that Plaintiffs should be judicially estopped from asserting that the phrase "magnetic members" is anything other than magnets based on statements made by Plaintiffs' counsel in their appeal brief to the Federal Circuit in the case of *Aspex Eyewear, Inc. v. Revolution Eyewear, Inc.* *See* Def.'s Surreply at 2:2-6:20. The Court disagrees. Statements by an attorney do not override the meaning of the claims as finally worded and issued. *See* Intervet America, Inc. v. Kee-Vet Labs., 887 F.2d 1050, 1055 (Fed.Cir.1989).

(5) "secured to said rear side" (claims 12 and 16):

Plaintiffs contend that the phrase "secured to said rear side" in claims 12 and 16 "means that each first magnetic member is connected to the rear side of the corresponding extension in a manner such that the connection is not likely to fail or give away. The first magnetic member may also be secured to other portions of the primary spectacle frame (e.g., the lens rims) in addition to the extension." JS, Exh. B at 11.

Conversely, Defendant argues that the phrase in question "should be interpreted to require that each of the two first magnetic members of the primary frame are secured or attached to the back side of the extension, but *not* attached to the lens rim." Def. Opposition at 8:12-14; *see also* JS, Exh. D at 4.

Defendant contends that the prosecution history of the '545 Patent mandates their construction of the phrase in question. *See* Def. Opposition at 8:17. Specifically, Defendant states that "[i]n the original reissue application, proposed claims 12, 16, 20, 34 and 35 included limitations where projections or first magnetic members were attached to the side portions of the primary frame." *Id*. at 8:17-20. Defendant goes on to say that "the Examiner rejected these claims, indicating: 'Regarding claims 12, 16, 18, 20, 34, 35, the subject matter of securing the magnetic members to the side portions of the primary spectacle frame and of the auxiliary frame is not supported in the original specification. Therefore, it is new matter.' " *Id*. at 8:20-9:2 citing the prosecution history of the '545 Patent, Koo Decl., Exh. E at 167-169.

Defendant's characterization of the prosecution history of the '545 Patent is incomplete. Subsequent to the Examiner's rejection cited by Defendant, an interview with the Examiner was conducted on April 4, 2001, wherein the Examiner expressly withdrew his rejection. *See* Koo Decl., Exh. E, 476-77. Additionally, the Court notes that one of the preferred embodiments of the invention shown in Figure 3 illustrates magnetic members 14 secured to the extensions *and* to the edges of the lens rims. *See* Koo Decl., Exh. B at 11.

Based on the above, the Court construes the phrase "secured to said rear side" in claims 12 and 16 of the '545 Patent to mean that each first magnetic member is connected to the rear side of the corresponding extension or to other portions of the primary spectacle frame in a manner such that the connection is not likely to fail or give away. *See* Webster's, Nicodema Decl., Exh. 5 at 150 (defining "secure" as "not likely to fail or give away").

(6) "auxiliary spectacle frame" (claims 12, 16 and 24)

Plaintiffs argue that the phrase "auxiliary spectacle frame" means "the entirety of the auxiliary frame with the exception of the lenses. The auxiliary spectacle frame includes the lens rims (if provided), the auxiliary frame magnetic members, the nose bridge, and the arms which secure the auxiliary frame magnetic members." JS, Exh. B at 12-13.

Defendant does not dispute the components which Plaintiffs contend are included in the "auxiliary spectacle frame"; instead, Defendant argues that the auxiliary frame is limited to a frame that secures "sunglass lenses." JS, Exh. D at 5; Def.'s Opposition at 9:9-12. In support of its proposed limitation, Defendant cites to the specification of the '545 Patent at Col. 2, 11. 38-48. Def.'s Opposition at 9:12. However, there is no such limitation in that section of the specification cited by Defendant or in any other part of the '545 Patent. *See* Koo Decl., Exh. B at 13. As such, the Court declines to limit the auxiliary spectacle frame to one securing "sunglass lenses."

Therefore, the Court construes "auxiliary spectacle frame" to mean the entirety of the auxiliary frame with

the exception of the lenses and including the lens rims (if provided), the auxiliary frame magnetic members, the nose bridge, and the arms which secure the auxiliary frame magnetic members.

(7) "two side portions" of the auxiliary spectacle frame (claims 12, 16 and 24)

Plaintiffs argue that the phrase "two side portions" means "those portions of the auxiliary spectacle frame beginning at the point where a line drawn through the midpoints of the lenses and lens rims (if provided) would intersect the top and bottom of the auxiliary spectacle frame, and terminating at the outer edges of the lenses or lens rims." JS, Exh. B at 14. As discussed above, *see supra* note 6, Plaintiffs' proposed use of such construction is vague and confusing.

Defendant argues that the phrase in question "refers to two elements extending from the lens rims, each having an arm which extends back and magnets secured therein...." Def.'s Opposition at 9:14-16; *see also* JS, Exh. D at 2.

In this case, the two side portions are described as follows in the specification of the '545 Patent: "An auxiliary spectacle frame 20 is provided for supporting the auxiliary lenses therein and includes two side portions each having an arm 21 extended rearward therefrom for extending over and for engaging with the upper portion of the primary spectacle frame 10 (FIGS. 5 and 6)." Koo Decl., Exh. B, Col. 2, 11. 38-43. Based on the specification and the drawings, the Court construes the phrase "two side portions" to mean those portions of the auxiliary spectacle frame each having an arm extending rearward from the sides of the lens or the lens rim (if provided).

(8) "an arm extended therefrom for extending toward and beyond said rear side" (claim 12)

Plaintiffs contend that the term "arm[s]" means those portions of the auxiliary spectacle frame that extend outwardly and rearwardly of the side portions of the frame and secure the second magnetic members." JS, Exh. B at 15. Plaintiffs also contend that the phrase "extending toward and beyond" means that "at least some portion of each arm reaches in the direction of and past the rear side of the corresponding extension." *Id*. at 17.

Defendant argues that "an arm extended therefrom for extending toward and beyond said rear side" means "an arm which extends back from the auxiliary spectacle frame over to the rear side of the side portion extension of the primary frame." JS, Exh. D at 2. Defendant's construction of the instant phrase requires that the arms not extend "past the rear edge of the projection containing the magnetic members...." Def.'s Opposition at 9:20-22. Defendant argues that its construction is supported by the prosecution history which, according to Defendant, reveals that the inventor canceled proposed Figure 8 (showing the arms extending past the projections) in response to a new matter rejection by the Examiner, and "eliminated all claims" encompassing that subject matter. *Id*. at 9:23-10:10. Plaintiffs argue that Defendant misreads the prosecution history because the Examiner ultimately withdrew his rejection. Pls.' Reply at 6:12-17.

In this case, during the April 4, 2001 interview, "the Examiner clarified his objection by stating that he was not objecting to a downwardly extending end portion *per se,* but to the fact that the end portion extends laterally past the rear edge of the projection [of the primary spectacle frame]." Interview Summary,FN13 Koo Decl., Exh. E at 477. The Interview Summary then goes on to state why the applicant thinks "the original specification supports new Figure 8." *Id*. at 478. It then concludes by stating:

FN13. The Interview Summary was prepared by the applicant's patent counsel.

In any event, during the interview, the Examiner indicated that claims directed to the feature, "the end portion of the arm of the auxiliary spectacle frame extended downwards towards the projection [of the primary spectacle frame] for hooking on the primary spectacle frame," are supported by the original disclosure, and would not require a separate drawing figure to show this feature. Thus, the Examiner expressly waived the requirements of 37 CFR 1.83 with respect to this feature. Accordingly, Figure 8 and its corresponding description in the specification have been deleted.
Id.

Based on the above, it is clear that the applicant, in canceling Figure 8, never overcame the Examiner's objection with regard to the end portion extending beyond the rear edge of the projection of the primary frame. Instead, the applicant accepted that limitation with the understanding that the arm could extend downward-but still not past the rear edge of the projection of the primary spectacle frame.FN14 *See also* Koo Decl., Exh. E at 460 (showing the annotations and the initials of the Examiner, H. Mai, with regard to Figure 8); Koo Decl., Exb. B at 12 (Figure 7 of the '545 Patent showing the arm not extending beyond the rear edge of the projection of the primary spectacle frame).

FN14. On February 13, 2003, Plaintiffs filed an *Ex Parte* Application for Leave to File Supplemental Brief on Claim Construction. In their proposed supplemental brief, Plaintiffs argue that the Federal Circuit's decision in Ethicon Endo-Surgery, Inc. v. United States Surgical Corp., 93 F.3d 1572 (Fed.Cir.1996), counsels against relying on the prosecution history to limit the claims as the Court has done in this instance. *See* Pls.' Proposed Supplemental Brief at 9-12. In *Ethicon,* the patent examiner had stated during the reissue proceedings that the "lockout mechanism" cannot be mounted on the "stapler," and that the original patent had disclosed a "lockout mechanism" mounted on the "cartridge." *Id*. at 1582 fn. 7. The district court erroneously interpreted the examiner's statement to mean that the "lockout mechanism" can *only* be mounted on the "cartridge." *Id*. The Federal Circuit disagreed and held that:
[c]laim 1 was properly rejected because it recited an element not supported by Fox's disclosure, i.e., a lockout 'on the stapler.' It does not follow, however, that Fox's disclosure could not support claims sufficiently broad to read on a lockout off the cartridge.

Id.

The instant case is completely distinguishable. Here, the patent examiner held that the original disclosure did not support an end portion extending beyond the rear edge of the projection of the primary frame, but that it supported a downwardly extending end portion. By accepting the limitation imposed by the examiner, the patentee surrendered any matter that was covered by the examiner's limitation-here, an end portion extending beyond the rear edge of the projection of the primary frame. *See* Schumer, 308 F.3d at 1313. Put differently, the patent examiner in *Ethicon* had stated that "X" cannot be "A," but can be "B." The district court held that "X" can *only* be "B" (and thus cannot be "A," "C," "D," etc.). In disagreeing with the district court, the Federal Circuit held the fact that "X" can be "B" but not "A" does not mean that "X" cannot be "C," "D," or even a "pink elephant," as along as such interpretation was not excluded by the prior art or prior disclosure. Here, the examiner stated that "X" cannot be "A," but can be "B," and the Court is simply holding that "X" cannot be "A."

Based on the above, the Court construes "an arm extended therefrom for extending toward and beyond said rear side" in claim 12 to mean an arm which extends back from the auxiliary spectacle frame over the rear side of the side portion extension of the primary frame but not past the rear edge of the projection containing the magnetic members of the primary frame.

(9) "an arm extended therefrom for extending beyond said rear side" (claim 16)

Plaintiffs contend that the term "arm[s]" means "those portions of the auxiliary spectacle frame that extend outwardly and rearwardly of the side portions of the frame and secure the second magnetic members." JS, Exh. B at 38. Plaintiffs further construe the phrase "extending beyond" to mean "that at least some portion of each arm reaches past the rear side of the corresponding extension [of the primary frame]." *Id*. at 40.

Conversely, Defendant argues that the phrase in question means "an arm which extends back from the auxiliary spectacle frame over the rear side of the side portion extension of the primary frame." JS, Exh. D at 5.

As in claim 12, the parties dispute whether the construction of the instant phrase requires that the arm not extend past the rear edge of the projection of the primary spectacle frame. As the Court has already held, the applicant never overcame the Examiner's objection that the arm cannot extend past the rear edge of the primary spectacle frame. Therefore, the court construes the phrase "an arm extended therefrom for extending beyond said rear side" in claim 16 to mean an arm which extends back from the auxiliary spectacle frame over the rear side of the side portion extension of the primary frame but not past the rear edge of the projection containing the magnetic members of the primary frame.

10. "arms having a rearwardly directed end for securing a magnetic member" (claim 24)

Plaintiffs argue that "arms" means "those portions of the auxiliary spectacle frame that extend outwardly and rearwardly of the side portions of the frame and secure the pair of magnetic members." JS, Exb. B at 49. Additionally, Plaintiffs construe the term "end" to mean "the outermost or farthest portion of the arms in relation to the location of their attachment with the lenses or lens rims (if provided). The 'ends' of the arms include those portions that secure the pair of magnetic members." *Id*. at 52-53.

Conversely, Defendant construes the instant phrase to mean "arm[s] which extend backward from the side portions of the auxiliary spectacle frame, the arms include an end for securing a magnet." JS, Exh. D at 6. Defendant further argues that the arms cannot extend past the rear edge of the projection of the primary spectacle frame. Def.'s Opposition at 10:15-18.

The Court has already held that the phrase "magnetic member" means a permanent magnet or a ferromagnetic member FN15 and that the arms cannot extend beyond the rear edge of the projection of the primary spectacle frame. Based on this, the Court construes the phrase "arms having a rearwardly directed end for securing a magnetic member" to mean arms which extend backward from the side portions of the auxiliary spectacle frame but not past the rear edge of the projection of the primary frame and which include an end for securing a permanent magnet or a ferromagnetic member.

FN15. It is also to be understood, as the Court already stated above, that at least either the first or second magnetic member must be a permanent magnet.

(11) "said arms and said first and second magnetic members cooperating to stably support said auxiliary spectacle frame on said primary spectacle frame" (claim 12)

Plaintiffs contend that the term "cooperating" means "to work or act together toward a common end or purpose." JS, Exh. B at 21. Plaintiffs also contend that "stably" means "resistant to sudden change in position or condition." *Id*. "Support" is defined by Plaintiffs to mean "to maintain in position so as to keep from falling, sinking or slipping." *Id*. at 22.

Conversely, Defendant construes the entire phrase in question to mean:

the arms extending from the auxiliary spectacle frame must contact and be supported on the upper side of the side portion extensions of the primary spectacle frame and the magnets on the rear side of the extensions of the primary frame are positioned directly below although not in contact with the magnets on the arms of the auxiliary frame to cooperate in holding the arms in place on the extensions to allow the auxiliary spectacle frame to be supported by the primary spectacle frame.

JS, Exh. D at 2.

Defendant seeks to read into the instant phrase the limitation that the arms must contact and be supported on the upper side of the extensions of the primary frame; and that the primary frame magnetic members must be positioned directly below, although not in contact with the auxiliary frame magnetic members. Def.'s Opposition at 11:4-18. Defendant argues that its construction should be adopted because it is supported by "[t]he *only* figure in the '545 Patent [-Figure 7-] illustrating the relationship between the arms and the extension". *Id*. at 11:19-20. The Court rejects Defendant's argument because "the number of embodiments disclosed in the specification is not determinative of the meaning of disputed claim terms." Teleflex, Inc. v. Ficosa North America Corp., 299 F.3d 1313, 1327 (Fed.Cir.2002). The fact that Figure 7 shows a particular embodiment does not, in and of itself, limit the entire patent to such embodiment. *See* Laitram Corp., 863 F.2d at 865.

Defendant further argues that its construction should be adopted under the "recapture doctrine" FN16 because the patentee added the requirement that the arms must contact and be supported on the upper side of the extension during prosecution of the original '207 Patent to secure allowance of claim 1. Def.'s Opposition at 12:1-12. Claim 1, as originally submitted to the PTO, required that the arms be "engaged with and supported on said upper portion" of the primary frame. Koo Decl., Exh. D at 34-35. The only amendment to claim 1 made during the prosecution was by an Examiner's clarifying amendment which added the word "side" between "upper" and "portion." Id. at 49.

FN16. Under the recapture doctrine, claims in a reissue patent "that are broader than the original patent's claims in a manner directly pertinent to the subject matter surrendered during prosecution [of the original patent] are impermissible." Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 1370-71 (Fed.Cir.2001).

Additionally, and as is evident from the claims of the '545 Patent (the reissue patent), that same limiting language appears only in claim 1 and not in claims 12, 16 or 24. To this end, claim 12 of the '545 Patent simply requires that the arms and the magnetic members "cooperat[e] to stably support" the auxiliary frame on the primary frame. Koo Decl., Exh. B at 15, ll. 5-7. FN17

FN17. The court orders in *Aspex Eyewear, Inc., v. E'Lite Optik, Inc.,* 98 CV-2996-D (N.D.Tex.2002), attached as Exh. M to the Koo Decl. and in *Aspex Eyewear, Inc. v. Revolution Eyewear,* 99 CV-1623 LGB (BQRx) (C.D.Cal.2001), attached as Exh. N to the Koo Decl. do not narrow the scope of the asserted claims as Defendant contends. Def.'s Opposition at 12:13-13:3. These Orders only apply to claim 1 of the original '207 Patent and not to the broader claims in the '545 Patent (the reissue patent).

Based on the above, the Court construes the phrase "said arms and said first and second magnetic members cooperating to stably support said auxiliary spectacle frame on said primary spectacle frame" in claim 12 to mean said arms and said first and second magnetic members working together to maintain in position said auxiliary spectacle frame on said primary spectacle frame by resisting sudden change of position. *See* Webster's, Nicodema Decl., Exh. 5 at 126, defining "cooperate" as "to work or act together toward a common end or purpose"; id. at 153, defining "stable" as "resisting sudden change of position or condition"; id. at 155, defining "support" as "to maintain in position so as to keep from falling, sinking or slipping."

(12) "said arms and said first and second magnetic members supporting said auxiliary spectacle frame on said primary spectacle frame" (claim 16)

The parties' arguments with respect to the construction of the phrase "said arms and said first and second magnetic members supporting said auxiliary spectacle frame on said primary spectacle frame" in claim 16 are identical to those made above with regard to the similar phrase in claim 12. *See* Def.'s Opposition at 11. For the reasons stated above, the Court construes the instant phrase in claim 16 to mean said arms and said first and second magnetic members maintaining in position said auxiliary spectacle frame on said primary spectacle frame.

(13) "each of said ends further including a downwardly extended end portion for hooking onto a primary spectacle" (claim 24)

Plaintiffs contend that the phrase "downwardly extending end portion" in claim 24 means "that the ends of the arms further include a portion that extends downwardly relative to the remainder of the arm." JS, Exb. B at 54. Plaintiffs further contend that the phrase "hooking onto" means that the downwardly extending end portions of the arms are bent in a manner so as to connect or catch with portions of the primary spectacle frame as if with a hook." Id. at 57.

Conversely, Defendant argues that the instant phrase means "the ends of the arms each include an end portion extending downward i.e. the magnet, to hook over a primary frame." JS, Exh. D at 6.

The Court disagrees with Defendant's construction of the phrase in question to the extent such construction limits the "downwardly extending end portion" to be the magnetic member itself. Although Figure 7 shows such configuration, it is only a preferred embodiment. *See* Laitram Corp. 863 F.2d at 865.

Based on the above, the court construes the phrase "each of said ends further including a downwardly extended end portion for hooking onto a primary spectacle" in claim 24 to mean each of said ends further including a portion that extends downward relative to the remainder of the arm and where that downward extending portion is bent in a manner to connect or catch with the primary spectacle frame as if with a hook. *See* Webster's, Nicodema Decl., Exh. 5 at 126, defining "hooked" and "hooking" as "to connect or catch with or as if with a hook" and "hook" as a "curved or a sharply bent, usu. metal device used to catch, drag, suspend, attach, or close something."

(14) "said arms and said pair of magnetic members adapted to extend across respective side portions of a primary spectacle frame so that said pair of magnetic members can engage corresponding magnetic members on a primary spectacle frame" (claim 24)

Plaintiffs construe the phrase "adapted to extend across" to mean "that the pair of auxiliary frame magnetic members are capable of or suitable for reaching from one side to the other of the respective side portions of the primary spectacle frame." JS, Exh. B at 57-58. Plaintiffs further define the term "engage" to mean "that surfaces of the auxiliary spectacle frame magnetic members either contact the corresponding surfaces of the primary spectacle frame magnetic members or magnetically attract those corresponding [sic] FN18 without actual contact to attach the auxiliary spectacle frame to the primary spectacle frame." JS, Exh. B at 55.

FN18. Presumably, Plaintiffs meant to say "corresponding surfaces of the primary spectacle frame magnetic members."

Conversely, Defendant construes the instant phrase to mean that:

the arms of the auxiliary spectacle frame must contact and be supported on the upper side of the side portion extension of the primary spectacle frame to allow the magnets on the rear side of the extensions of the primary frame, which are positioned directly below although not in contact with the magnets on the arms of the auxiliary frame and to allow the auxiliary spectacle frame to be supported by the primary spectacle frame.

JS, Exh. D at 6-7.

Defendant's construction seeks to read into the phrase in question that the arms must be in contact and be supported on the upper side of the extensions of the primary frame; and that the primary frame magnetic members must be positioned directly below, although not in contact with the auxiliary frame magnetic members. The Court has already rejected this interpretation. *See* Sections (11) and (12) *supra*.

Based on the above, the Court construes the phrase in dispute here to mean that the arms and the pair of auxiliary frame magnetic members are capable or suitable for reaching from one side to the other of the respective side portions of the primary spectacle frame so that said pair of magnetic members can either contact the corresponding surfaces of the primary spectacle frame magnetic members or magnetically attract those corresponding surfaces of the primary spectacle frame magnetic members without actual contact to attach the auxiliary spectacle frame to the primary spectacle frame. *See* Webster's, Nicodema Decl., Exh. 5 at 130, defining "extend" as "to stretch or spread out at full length;" *Id*. at 123, defining "across" as "from one side to the other;" *Id*. at 129, defining "engage" as "to interlock or cause to interlock: mesh;" *see also,* Koo Decl., Exh. B, the '545 Patent at Col. 3, 11.11-17 (stating that "[i]n one embodiment, as shown in FIG. 7, magnetic members 14 and 22 are engaged with, but not supported on each other. Instead, the arm 21 securing the magnetic member 22 is supported on an upper side portion of the primary spectacle frame 10.").

b. Disputed terms in the '747 Patent

The following terms and combination of terms in claim 12 of the '747 patent are disputed: (1) "primary frame," (2) "auxiliary frame," (3) "two sides," of the auxiliary frame (4) "each side having an extension and

each extension including a rear end having a first flange extended downward," (5) "each flange itself not being a magnet, including a magnetic material," (6) "two sides, each having a stud, each stud including a magnetic material," (7) "wherein when the primary frame is supporting the auxiliary frame, each magnetic material of the primary frame magnetically engages in a lateral manner with one of the magnetic materials of the auxiliary frame," (8) "each stud is extended over by one of the extensions, and can support that extension to prevent the auxiliary frame from moving downward relative to the primary frame," and (9) "the flanges are located behind the studs to further secure the auxiliary frame to the primary frame." The Court now addresses each of these disputed terms.

(1) "primary frame"

Plaintiffs construe "primary frame" to mean "the entirety of the primary eyeglass frame with the exception of the lenses, the plastic nose pieces, (which touch the upper sides of the wearers's nose), and the legs (known in the art as the 'temple pieces'). The primary frame includes the lens rims (if provided), nose bridge, and the studs which each include a magnetic material." JS, Exh. A at 1.

Defendant does not dispute the components which Plaintiffs contend are included in the primary spectacle frame. *See* JS. Exh. C at 107. Defendant, however, contends that the primary frame also includes "a pair of lens rims of a continuous eye-loop type to secure eyeglass lenses...." *Id*. No such limitation is required by the patent documents. Since the claim language is broader, and the specification does not require a particular type of lens rim construction, the requirement that the primary frame have a "continuous eye-loop type" lens rim cannot be read into claim 12. *See* Electro Med. System, S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1054 (Fed.Cir.1994).

Based on the above, the Court declines to adopt the limitation proposed by Defendant.

(2) "auxiliary frame"

Plaintiffs contend that the phrase "auxiliary frame "means the entirety of the auxiliary frame with the exception of the lenses. The auxiliary frame includes the lens rims (if provided), the nose bridge, the extensions, and the first flanges which each include a magnetic material." JS, Exh. A at 2.

Defendant does not dispute the components which Plaintiffs contend are included in the auxiliary spectacle frame, but instead argues that the auxiliary frame must secure "sunglass lenses." JS, Exh. C at 107. In support of its argument, Defendant cites to Figures 1-3 of the '747 Patent and to Column 2, lines 49-50 of the patent itself. Def.'s Opposition at 15:13-16. However, none of the figures or the cited section of the patent specification limits the lenses to sunglass-type lenses. *See* Koo Decl., Exh. C at 18, Col. 2, 11. 49-50 and Figs. 1-3 at 19. Therefore, the Court declines to adopt Defendant's proposed limitation. Instead, the Court construes auxiliary frame to mean the entirety of the auxiliary frame with the exception of the lenses; the auxiliary frame includes the lens rims (if provided), the nose bridge, the extensions, and the first flanges which each include a magnetic material.

(3) "two sides" of the auxiliary frame

Plaintiffs argue that the phrase "two sides" means "those portions of the auxiliary frame beginning at the point where a line drawn through the mid-points of the lens and lens rims (if provided) would intersect the top and bottom of the frame, and terminating at the outer edge of the lenses or lens rims." JS, Exh. A at 3-4. As the Court already noted above, this construction is vague and confusing. *See supra* note 6.

Defendant argues that the instant phrase "should be construed "to mean what is outside of the edge of the lens rims of the auxiliary frame, which are only the extensions based on what is depicted in Figs. 1-3, and on the specification." Def.'s Opposition at 15:18-20.

In this case, the two sides of the auxiliary frame are described in the specification as follows: "An auxiliary frame 20 ... includes a bridge 21 and two extensions 22 disposed in the side portions and extended rearward for engaging over the bridge 11...." Koo Decl., Exh. C at 20, Col. 2, 11. 49-52. Based on the specification and the drawings, the Court construes the phrase "two sides" as those portions of the auxiliary spectacle frame extending rearward from the outer edges of the auxiliary frame.

(4) "each side having an extension and each extension including a rear end having a first flange extended downward"

Plaintiffs construe "first flange" to mean "a portion of the extension which protrudes from the rear end thereof and facilitates attachment of the auxiliary frame to the primary frame." JS, Exh. A at 7. Plaintiffs further contend that the phrase "extended downwards" means that "each first flange reaches in a downward direction relative to the remaining portions of the extension." *Id*. at 9.

Defendant's only apparent point of departure from Plaintiffs' construction is the additional requirement that the first flange "extends downward *to hook over and contact* the rear portion of an extension on the primary frame." JS, Exh. C at 107 (emphasis added). Claim 12 has no such limitation. Instead, Claim 12 simply require that the magnetic materials of the primary frame "magnetically engage ... in a lateral manner" the magnetic materials of the auxiliary frame." Koo Decl., Exh. C at 22, Col. 6, 11. 6-8. The section of the patent describing the summary of the invention is also consistent with this interpretation. *See* Koo Decl., Exh. C at 20, Col. 1, ll. 41-44; Col. 2, 11. 3-5.

Therefore, the Court declines to adopt Defendant's limitation requiring that the flange hook over and contact the rear portion of the extension of the primary frame. Instead, the Court construes the instant phrase to mean that each side having an extension and each extension including a rear end having a portion of the extension which protrudes from the rear end thereof and facilitates attachment of the auxiliary frame to the primary frame and where such portion of the extension reaches in a downward direction relative to the remaining portions of the extension.

(5) "each flange itself not being a magnet, including a magnetic material"

Plaintiffs contend that the phrase "each flange itself not being a magnet, including a magnetic material" means "(respecting the flanges) ... that a portion or segment of each flange is a magnetically attractive substance, such as, for example, a magnet; but the entirety of the flange cannot be a magnet. The magnetic material may be embedded in or secured to the remaining portions of each flange." JS, Exh. A at 11.

Conversely, Defendant construes the entire phrase in question to mean that "the flange is not a magnet, but it includes magnetic material, specifically a magnet." JS, Exh. C at 107.

In examining the language of the claims, the Court agrees with Plaintiffs that the use of both "magnet" and "magnetic material" in the language of claim 12 counsels against limiting the phrase "magnetic material" to a "magnet." Pls.' Opening at 17:24-27. However, this fact, in and of itself, is not dispositive. Additionally, and as stated above, *see supra* section "III B 2 a(4)," the plain meaning of the term "magnetic" is "having

the properties of a magnet and capable of being magnetized or of being attracted by a magnet." Having considered the language of the claims, the Court now turns to the specification.

In the "Detailed Description of the Preferred Embodiment" section of the '747 Patent, the patentee states that when there is a magnetic attraction between the primary and auxiliary frames, it is achieved through the engagement of magnets as depicted in Figure 3. *See* the '747 Patent, Koo Decl., Exh. C at 19 and 20, Col. 2, 11. 56-60 and 65-67. However, the references to magnets in the descriptions of the preferred embodiment are not claim limitations. Laitram Corp., 863 F.2d at 865. The Court next turns to the prosecution history.

In this case, the Sadler Patent was cited by the applicant in his Information Disclosure Statement ("IDS"),FN19 which was filed with the PTO during the prosecution of the '747 Patent.FN20 See IDS, Prosecution History of the '747 Patent, Koo Decl., Exh. F at 739. As discussed above, *see supra* section "III B 2 a (4)," the Sadler Patent defines the phrase "magnetic member" to be a permanent magnet or a ferromagnetic member, but at least either the first or second magnetic members must be a permanent magnet. Therefore, and consistent with the Court's analysis with regard to similar claim language in the '545 Patent, the Court construes the phrase "magnetic material" to mean a permanent magnet or ferromagnetic material, but at least either the magnetic material in the primary or in the auxiliary frame is a permanent magnet.

FN19. The IDS is a document filed by a patent applicant with the PTO pursuant to 37 C.F.R. s.s. 1.56, 1.97 & 1.98. Such filing is in furtherance of the applicant's duty to disclose to the PTO "information [that] is material to patentability." General Instrument Corp., Inc. v. Scientific-Atlanta, Inc., 995 F.2d 209, 212 (Fed.Cir.1993).

FN20. The Sadler Patent is also listed in the '747 Patent itself as a prior art reference. *See* '747 Patent, Koo Decl., Exh. C.

Therefore, the Court construes the phrase "each flange itself not being a magnet, including a magnetic material" to mean each flange is not a magnet, but it includes a permanent magnet or ferromagnetic material, and at least either the magnetic material in the primary frame or in the auxiliary frame is a permanent magnet.

(6) "two sides, each having a stud, each stud including a magnetic material"

Plaintiffs define "two sides" to mean "those portions of the primary spectacle frame beginning at the point where a line drawn through the midpoints of the lenses and lens rims (if supplied) would intersect the top and bottom of the primary spectacle frame, and terminating at the pivot point where the legs are attached to the studs." JS, Exh. A at 13. Further, Plaintiffs construe "stud" to mean "those portions of the primary spectacle frame which include a magnetic material and extend outwardly and rearwardly of the lenses or lens rims (if provided). The studs pivotally connect to the legs or 'temple pieces." ' *Id*. at 14. Additionally, Plaintiffs contend that the phrase "including a magnetic material" means "(respecting the studs) [,] ... that at least a portion or segment of each stud is a magnetically attractive substance, such as, for example, a magnet. The magnetic material may be embedded in or secured to the remaining portions of each stud." *Id*. at 16.

Conversely, Defendant construes the entire phrase in question to mean "two sides or extensions projecting from the lens rims, each extension has a stud, the portion of the side extending out from the lens rim, the studs of the primary frame each includes a magnetic material, specifically a magnet." JS, Exh. C at 108.

In this case, the terms in question are described in the specification as follows: "an eyeglass combination ... comprises a primary frame 10 for supporting primary lenses 90 and including a bridge 11 formed in the middle and including two studs 12 formed in the side portions. The bridge 11 and the studs 12 each includes a magnet 14 disposed laterally...." Koo Decl, Exh. C at 20, Col. 2, 11. 41-46. Based on the specification and the drawings, the Court construes the phrase "two sides" as those portions of the primary spectacle frame extending outward and rearward from the outer edges of the primary frame. The Court construes "stud" to mean those portions of the two sides of each primary spectacle frame which include a magnetic material and project outwardly and rearwardly of the lenses or lens rims (if provided). *See also* Webster's, Nicodema Decl., Exh. 5 at 154, defining "stud" as "[a] small knob, nail head, or rivet fixed in and slightly projecting from a surface." As already discussed, the Court construes magnetic material to be a permanent magnet or ferromagnetic material.

(7) "wherein when the primary frame is supporting the auxiliary frame, each magnetic material of the primary frame magnetically engages in a lateral manner with one of the magnetic materials of the auxiliary frame for securing said auxiliary frame to said primary frame"

Plaintiffs construe the term "supporting" to mean "that the primary frame maintains the auxiliary frame in position so as to keep the auxiliary frame from falling, sinking or slipping off the primary frame." JS, Exh. A at 18. Plaintiffs further contend that the phrase "magnetically engaging" means "that the magnetic material of the first flanges engages the magnetic material of the corresponding studs either by touching or through magnetic attractive forces without touching." *Id*. at 20. Plaintiffs argue that the phrase "lateral manner" means "that the magnetic engagement between the magnetic material of the primary frame and the magnetic material of the auxiliary frame is in the horizontal plane." *Id*. at 22.

Conversely, Defendant argues that the entire phrase in question means that "when the auxiliary frame is mounted on the primary frame, the magnet of the primary frame is attracted to the magnet on the arms or extensions of the auxiliary sunglasses frame to secure or attach the auxiliary sunglasses frame to the frame of the primary eyeglasses." JS, Exh. C at 109.

Preliminarily, the Court notes that Defendant has not offered any support for its proposed limitation that the auxiliary frame be one securing sunglass lenses. *See* Def.'s Opposition at 16-18. As such, the Court declines to adopt such limitation.

Defendant's construction of the word "supporting" as "mounted on" is limited to a mode of attachment and fails to capture the breadth of the term's ordinary meaning. *See* Webster's, Nicodema Decl., Exh. 5 at 155, defining "support" to mean "[t]o maintain in position so as to keep from falling, sinking, or slipping." As such, the Court adopts Plaintiffs' construction of the term "supporting," which is consistent with the dictionary definition.

As to the phrase "magnetically engages," the Court construes it to mean magnetically attracts or is attracted magnetically, with the magnetic attraction taking place with or without actual physical contact. *See supra* section "III B 2 a(14)," discussing the construction of the term "engage" in the '545 Patent. Defendant does not dispute that "lateral manner" means "in the horizontal plane," and the Court agrees with such

construction. *See* Figures 2 and 3 of the patent. Koo Decl., Exh. C at 19.

Based on the above, the Court construes the phrase in question to mean: wherein when the primary frame is maintaining the auxiliary frame in position so as to keep the auxiliary frame from falling, sinking or slipping off the primary frame, each magnetic material of the primary frame magnetically attracts or is attracted by one of the magnetic materials of the auxiliary frame, with the magnetic attraction taking place with or without actual physical contact and in the horizontal plane.

(8) "each stud is extended over by one of the extensions, and can support that extension to prevent the auxiliary frame from moving downward relative to the primary frame"

Plaintiffs construe the phrase "extended over" to mean "that at least some portion of each of the extensions reaches above and across the corresponding stud." JS, Exh. A at 23. Plaintiffs also contend that the phrase "can support" means "that the studs, either directly or indirectly, are capable of maintaining the extensions in position so as to keep them from falling, sinking or slipping." *Id*. at 25. Plaintiffs further contend that the term "prevent" means "to impede, obstruct or keep from happening." *Id*. at 27.

Conversely, Defendant contends that the entire phrase in question means that "the arms or extensions from the auxiliary frame contact and are supported on the upper side of the extensions [sic] FN21 at the outer edges of the primary frame to prevent the auxiliary frame from moving downward with respect to the primary frame." JS, Exh. C at 109. Defendant's construction seeks to limit the instant phrase by requiring the extensions from the auxiliary frame to "contact" and be supported on the "upper side" of the studs at the "outer edges" of the primary frame.

FN21. Presumably, Defendant meant to say "studs".

In this case, it is clear from the language of claim 12 that the magnetic material in the auxiliary frame is located in the flange that extends downwards. See '747 Patent, Koo Decl., Exh. C, Col. 5, 11, 41-43. The Court has already held that the magnetic attraction between the magnetic material in the auxiliary frame and the magnetic material in the primary frame can take place with or without physical contact. *See supra,* section "III B 2 b (4)". As such, and since there need not be physical contact between the back side of the stud and the downwardly extending flange, there must be physical contact between the upper side of the stud and the extension; otherwise, it would be physically impossible to support the auxiliary frame on the primary frame.FN22

FN22. Here, the Court is construing claim 12. The embodiment described by claim 12 does not include an arm extending from the second bridge of the auxiliary frame to connect with the first bridge of the primary frame, an embodiment that claim 11 appears to cover.

Therefore, the Court construes the instant phrase to mean that at least some portion of each of the extensions reaches above and across the corresponding stud, and each stud is capable, with direct contact, of maintaining the corresponding extension in position so as to keep it from falling, sinking or slipping and thus prevent FN23 the auxiliary frame from moving downward relative to the primary frame. *See* Webster's, Nicodema Decl., Exh. 5 at 130, defining "extend" as "to stretch or spread out to full length"; *id*. at 144, defining "over" as "[a]bove and across from one end or side to the other," *id*. at 155, defining "support" as

"[t]o maintain in position so as to keep from falling, sinking, or slipping."

FN23. The Court does not find it necessary to construe the term "prevent."

(9) "the flanges are located behind the studs to further secure the auxiliary frame to the primary frame"

Plaintiffs construe the phrase "further secure" to mean "that the location of the flanges behind the studs further maintain the auxiliary frame in position on the primary frame so as to keep it from falling, sinking or slipping." JS, Exh. A at 30.

Defendant construes the instant phrase to mean that "the flanges on the arms or extensions hook over the studs on the primary frame contacting the rear surface of the extensions [sic]." FN24 Defendant's construction seeks to limit the instant phrase by requiring the flanges to hook over and contact the rear surface of the studs on the primary frame.

FN24. Presumably, Defendant meant to say "studs."

In this case, the Court has already held that there need not be physical contact between the downwardly extending flange of the auxiliary frame and the back side of the stud of the primary frame. *See supra* section "III B 2 b(4)". Therefore, the Court construes the instant phrase to mean that the flanges are located behind, but not necessarily in contact with, the rear surfaces of the studs to further fasten the auxiliary frame to the primary frame.

IV. CONCLUSION

Based on the foregoing, the Court concludes that:

1. "primary spectacle frame" in claims 12, 16 and 24 of the '545 Patent means the entirety of the primary eyeglass frame with the exception of the lenses, the plastic nose pieces (which touch the upper sides of the wearers's nose), and the legs, which extend back over the wearer's ears; thus, the primary spectacle frame includes the lens rims (if provided), nose bridge, extensions, projections (if provided), the first magnetic member and conceivably rim-locks;

2. "two side portion extensions" of the primary spectacle frame in claims 12 and 16 of the '545 Patent means those portions of the primary spectacle frame which extend outwardly and rearwardly of the lenses or lens rims (if provided) to pivotally connect to the legs;

3. "magnetic member" in claims 12, 16 and 24 of the '545 Patent means a permanent magnet or a ferromagnetic member, but at least either the first or second magnetic members must be a permanent magnet;

4. "secured to said rear side" in claims 12 and 16 of the '545 Patent means that each first magnetic member is connected to the rear side of the corresponding extension or to other portions of the primary spectacle frame in a manner such that the connection is not likely to fail or give away;

5. "auxiliary spectacle frame" in claim 12, 16 and 24 of the '545 Patent means the entirety of the auxiliary frame with the exception of the lenses and including the lens rims (if provided), the auxiliary frame magnetic members, the nose bridge, and the arms which secure the auxiliary frame magnetic members;

6. "two side portions" of the auxiliary spectacle frame in claims 12, 16 and 24 of the '545 Patent means those portions of the auxiliary spectacle frame each having an arm extending rearward from the sides of the lens or the lens rim (if provided);

7. "an arm extended therefrom for extending toward and beyond said rear side" in claim 12 of the '545 Patent means an arm which extends back from the auxiliary spectacle frame over the rear side of the side portion extension of the primary frame but not past the rear edge of the projection containing the magnetic members of the primary frame;

8. "an arm extended therefrom for extending beyond said rear side" in claim 16 of the '545 Patent means an arm which extends back from the auxiliary spectacle frame over the rear side of the side portion extension of the primary frame but not past the rear edge of the projection containing the magnetic members of the primary frame;

9. "arms having a rearwardly directed end for securing a magnetic member" in claim 24 of the '545 Patent means arms which extend backward from the side portions of the auxiliary spectacle frame but not past the rear edge of the projection of the primary frame and which include an end for securing a permanent magnet or a ferromagnetic member;

10. "said arms and said first and second magnetic members cooperating to stably support said auxiliary spectacle frame on said primary spectacle frame" in claim 12 of the '545 Patent means said arms and said first and second magnetic members working together to maintain in position said auxiliary spectacle frame on said primary spectacle frame by resisting sudden change of position;

11. "said arms and said first and second magnetic members supporting said auxiliary spectacle frame on said primary spectacle frame" in claim 16 of the '545 Patent means said arms and said first and second magnetic members maintaining in position said auxiliary spectacle frame on said primary spectacle frame;

12. "each of said ends further including a downwardly extended end portion for hooking onto a primary spectacle" in claim 24 of the '545 Patent means each of said ends further including a portion that extends downward relative to the remainder of the arm and where that downward extending portion is bent in a manner to connect or catch with the primary spectacle frame as if with a hook;

13. "said arms and said pair of magnetic members adapted to extend across respective side portions of a primary spectacle frame so that said pair of magnetic members can engage corresponding magnetic members on a primary spectacle frame" in claim 24 of the '545 Patent means the arms and the pair of auxiliary frame magnetic members are capable or suitable for reaching from one side to the other of the respective side portions of the primary spectacle frame so that said pair of magnetic members can either contact the corresponding surfaces of the primary spectacle frame magnetic members or magnetically attract those corresponding surfaces of the primary spectacle frame magnetic members without actual contact to attach the auxiliary spectacle frame to the primary spectacle frame;

14. "primary frame" in claim 12 of the '747 Patent means the entirety of the primary eyeglass frame with the

exception of the lenses, the plastic nose pieces, (which touch the upper sides of the wearers's nose), and the legs; the primary frame includes the lens rims (if provided), nose bridge, the studs which each include a magnetic material and conceivably rim locks;

15. "auxiliary frame" in claim 12 of the '747 Patent means the entirety of the auxiliary frame with the exception of the lenses; the auxiliary frame includes the lens rims (if provided), the nose bridge, the extensions, and the first flanges which each include a magnetic material;

16. "two sides" of the auxiliary frame in claim 12 of the '747 means those portions of the auxiliary spectacle frame extending rearward from the outer edges of the auxiliary frame;

17. "each side having an extension and each extension including a rear end having a first flange extended downward" in claim 12 of the '747 Patent means each side having an extension and each extension including a rear end having a portion of the extension which protrudes from the rear end thereof and facilitates attachment of the auxiliary frame to the primary frame and where such portion of the extension reaches in a downward direction relative to the remaining portions of the extension;

18. "each flange itself not being a magnet, including a magnetic material" in claim 12 of the '747 Patent means each flange is not a magnet, but it includes a permanent magnet or ferromagnetic material, and at least either the magnetic material in the primary frame or in the auxiliary frame is a permanent magnet;

19. "two sides, each having a stud, each stud including a magnetic material" in claim 12 of the '747 Patent means: (a) "two sides" means those portions of the auxiliary spectacle frame extending outward and rearward from the outer edges of the auxiliary frame; and (b) "stud" means those portions of the side of each primary spectacle frame which include a magnetic material and project outwardly and rearwardly of the lenses or lens rims (if provided);

20. "wherein when the primary frame is supporting the auxiliary frame, each magnetic material of the primary frame magnetically engages in a lateral manner with one of the magnetic materials of the auxiliary frame for securing said auxiliary frame to said primary frame" in claim 12 of the '747 Patent means: wherein when the primary frame is maintaining the auxiliary frame in position so as to keep the auxiliary frame from falling, sinking or slipping off the primary frame, each magnetic material of the primary frame magnetically attracts one of the magnetic materials of the auxiliary frame, with the magnetic attraction taking place with or without actual physical contact and in the horizontal plane;

21. "each stud is extended over by one of the extensions, and can support that extension to prevent the auxiliary frame from moving downward relative to the primary frame" in claim 12 of the '747 Patent means at least some portion of each of the extensions reaches above and across the corresponding stud, and each stud is capable, with direct contact, of maintaining the corresponding extension in position so at to keep it from falling, sinking or slipping and thus prevent the auxiliary frame from moving downward relative to the primary frame; and

22. "the flanges are located behind the studs to further secure the auxiliary frame to the primary frame" in claim 12 of the 747 Patent means the flanges are located behind, but not necessarily in contact with, the rear surfaces of the studs, to further fasten the auxiliary frame to the primary frame.

IT IS SO ORDERED.

C.D.Cal.,2003.
Aspex Eyewear, Inc. v. Miracle Optics, Inc.

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