United States District Court,
C.D. California.

REVOLUTION EYEWEAR, INC., a California corporation,
Plaintiff.
v.
ASPEX EYEWEAR, INC., a Delaware corporation, and Nonu Ifergan, an individual,
Defendants.

No. CV 03-05965 FMC (MANx)

Aug. 12, 2004.

Ary Chang, Dylan C. Dang, John Richard Carr, R. Joseph Trojan, Trojan Law Offices, Beverly Hills, CA, Joyce E. Crucillo, American Apparel, Roy A. Kim, Sedgwick, Detert, Moran and Arnold, Los Angeles, CA, for Plaintiff.

Barry J. Schindler, Michael A. Nicodema, Greenberg Traurig, New York, NY, Jon E. Hokanson, Josephine A. Brosas, Lewis, Brisbois, Bisgaard and Smith, for Defendants.

ORDER CONSTRUING CLAIMS OF U.S. PATENT NO. 6,550,913

FLORENCE-MARIE COOPER**, District Judge.**

This action arises out of the alleged infringement of Plaintiff Revolution Eyewear, Inc.'s ("Revolution") U.S. Patent No. 6,550,913 (the "'913 patent") by Defendants Aspex Eyewear, Inc. ("Aspex") and Nonu Ifergan. This matter is before the Court for the purpose of interpreting the disputed claims of the '913 patent. The matter came on for Markman hearing on August 9, 2004. Following oral argument, the matter was taken under submission.

I. Factual and Procedural Background

The technology at issue in this case involves a primary eyeglass frame that supports an auxiliary eyeglass frame, enabling the user to securely fasten a second set of lenses onto the primary frame. The '913 patent is directed to a "bottom-mounted" design, wherein appendages on the auxiliary frame fit beneath the temple extensions on the primary frame to hold the auxiliary frames in place from the bottom. Magnets are mounted in the temple extensions of the primary eyeglass frame and in sockets formed on the appendages of the auxiliary eyeglass frame. The magnets engage to automatically align the auxiliary frame and the primary frame, and the orientation of the magnets is such that the maximum magnetic force between them is parallel to the lenses of the aligned frames.

Pursuant to the Joint Statement, Claims 1 and 4 of the '913 patent contain terms that are disputed by the parties. FN1 Claim 1 provides:

FN1. The disputed terms are shown in bold.

A method of attaching auxiliary eyeglasses to conventional eyeglasses comprising;
forming sockets on **temple extensions on either side of said conventional eyeglasses;**

mounting **magnets** in said sockets on said conventional eyeglass temple extensions;

forming **appendages extending from either side of said auxiliary eyeglasses** constructed and arranged to fit below said temple extensions of said conventional eyeglasses;

forming sockets on said appendages on said auxiliary eyeglasses;

mounting **magnets** in said sockets on said auxiliary eyeglass appendages;

orienting said magnets in said sockets on said conventional eyeglass temple extensions and said magnets in said sockets on said auxiliary eyeglass appendages with the maximum magnetic attractive force approximately parallel to the plane of lenses in said conventional eyeglasses when said auxiliary eyeglasses are mounted on said conventional eyeglasses;

positioning said appendages on said auxiliary eyeglasses below said extensions on said conventional eyeglasses so said magnets in said appendages mate with said magnets on said conventional eyeglass extensions;

whereby said auxiliary eyeglasses are prevented from moving downward and being becoming detached when mounted on said conventional eyeglasses by a maximum attractive force between said magnets on said auxiliary eyeglasses and said conventional eyeglasses.

('913 Patent; Trojan Decl. at Ex.1; Joint Statement.)
Claim 4 provides:

Apparatus for attaching auxiliary eyeglasses to conventional eyeglasses comprising;

temple extensions attached to either side of a frame of said conventional eyeglasses for attaching hinged temple pieces;

a socket attached to each of said temple extensions;

a **magnet** mounted in each of said sockets;

an appendage attached to each side of said auxiliary eyeglasses;

a socket attached to each of said appendages;

a **magnet** mounted in each of said sockets;

said appendages constructed and arranged to fit below said temple extensions on said conventional eyeglasses with said magnets in said sockets on said appendages mating with said magnets in said sockets on said extension of said conventional eyeglass frame;

said magnets on said auxiliary eyeglasses and said magnets on said conventional eyeglasses being oriented with their maximum magnetic attractive force parallel to lenses in said conventional eyeglasses;

whereby said magnets on said auxiliary eyeglasses when mated with said magnets on conventional eyeglasses provide maximum resistance to downward movement of said auxiliary eyeglasses thereby preventing accidental detachment of said auxiliary eyeglasses from said conventional eyeglasses.

('13 Patent; Trojan Decl. at Ex.1; Joint Statement.)

For purposes of the Court's claim construction endeavor here, it suffices to note that Plaintiff accuses Defendants of infringing the '913 patent. Pursuant to the Court's May 25, 2004 Order, the parties submitted a Joint Claim Construction Statement on June 25, 2004 ("Joint Statement"). Plaintiff filed its Opening Brief on July 9, 2004. Defendants filed their Responsive Claim Construction Brief ("Responsive Brief") on July 23, 2004. Plaintiff filed its Reply to Defendants' Responsive Claim Construction Brief ("Reply Brief") on July 30, 2004. Oral argument was heard on August 9, 2004.

II. Legal Standard for Claim Construction

Patents grant inventors the exclusive right to make and sell their inventions in exchange for full disclosure of the invention. Markman v. West View Instruments, Inc. 517 U.S. 370, 373, 116 S.Ct. 1384, 1387, 134 L.Ed.2d 577 (1996). "It has long been understood that a patent must describe the exact scope of an invention and its manufacture to 'secure to [the patentee] all to which he is entitled, [and] to appraise the public of what is still open to them.' " *Id*. (quoting McClain v. Ortmayer, 141 U.S. 419, 424, 12 S.Ct. 76, 77, 35 L.Ed. 800 (1891)). Two parts of the patent fulfill this function: the specification and the claims. *Id*. The specification must describe the invention "in such full, clear, concise, and exact terms as to enable any person skilled in the art ... to make and use the same." 35 U.S.C. s. 112. The claims must "particularly point out and distinctly claim the subject matter which the applicant regards as his invention." *Id*.

Claim interpretation is a matter of law. Markman v. West View Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995). In construing the scope and meaning of a patent claim, "the court should look first to the intrinsic evidence of the record, i.e., the patent itself, including the claims, the specification, and, if in evidence, the prosecution history." Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996); *see also* Novo Nordisk of N.A., Inc. v. Genetech, Inc., 77 F.3d 1364, 1368 (Fed.Cir.1996) (to determine the meaning and scope of a patent claim, the court shall look to the language of the claim, the specification accompanying the claim, and the prosecution history of the claim.). The *Vitronics* court described such "intrinsic evidence" as "the most significant source of the legally operative meaning of disputed claim language." Vitronics, 90 F.3d at 1582.

Within this general category of intrinsic evidence, there are preferences. Initially, the court should look to the words of the claim itself to define the scope and meaning of the patented invention. *Id*. If the court's review reveals no ambiguity in the terms set forth in the patent claim, then those terms are "generally given their ordinary and customary meaning." *Id*. Often, the ordinary meaning of the claim terms can be determined by looking to their dictionary definition. *See* Optical Disc Corp. v. Del Mar Avionics, 208 F.3d

1324, 1335 (Fed.Cir.2000) ("For such ordinary meaning, we turn to the dictionary definition of the term"); Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed.Cir.2002) ("... dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms"). A patentee, however, can "choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history." *Id*. Therefore, the claim language cannot be considered in isolation. Bell Communications Research, Inc. v. Vitalink Communications Corp. ., 55 F.3d 615, 621 (Fed.Cir.1995).

Both the claim specification and the prosecution history are critical components to be considered by the court in determining the scope and meaning of a patent claim. Vitronics, 90 F.3d at 1582. The specification has particular relevance to the court's determination because "it contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make use of it. Thus, the specification is always highly relevant to the claim construction analysis." *Id*. The court examines the written description and drawings "to determine whether use of [a disputed claim term] is consistent with the ordinary meaning of the term." Prima Tek II, L.L.C. v. Polypap, S.A.R.L., 318 F.3d 1143, 1148 (Fed.Cir.2003). For purposes of claim determination, the specification is "[u]sually dispositive ... and is the single best guide to the meaning of a disputed term." Vitronics, 90 F.3d at 1582.

The final component of intrinsic evidence to be relied upon by the court is the prosecution history of the patented claim. The "prosecution history limits the interpretation of claims so as to exclude any interpretation that was disclaimed during prosecution" of the patented claim. CVI/Beta Ventures, Inc. v. Turn LP, 112 F.3d 1146, 1155 (Fed.Cir.1995); *see also* Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed.Cir.1995), cert. denied, 516 U.S. 987, 116 S.Ct. 515, 133 L.Ed.2d 424 (1995). In reviewing the prosecution history, the court will give weight to arguments made by the patentee for purposes of distinguishing its invention from the prior art. CVI/Beta Ventures, 112 F.3d at 1155; *see also* Laitram Corp. v. Morehouse Industries, Inc., 143 F.3d 1456, 1463 (Fed.Cir.1998) (holding that a patent claim could not be construed to cover a feature that the patentee distinguished during prosecution of the claim); Advance Transformer Co. v. Levinson, 837 F.2d 1081, 1083 (Fed.Cir.1988) (holding that the court, in construing patent claims, may rely on a patentee's statements distinguishing his invention from that claimed in another patent).

Despite the requirement that the court rely primarily on intrinsic evidence in its claim construction analysis, the court may rely on certain extrinsic evidence to assist in its determination. ATD Corp. v. Lydall, Inc., 159 F.3d 534, 540 (Fed.Cir.1998). This is because the patent must be viewed from the vantage point of one ordinarily skilled in the art, and the use of some forms of extrinsic evidence, such as treatises, dictionaries, or other prior art references, may reflect the meaning such an individual would ascribe to the disputed terms. Vitronics, 90 F.3d at 1584. The use of extrinsic evidence, however, "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. at 1583.

III. Analysis of Disputed Claim Terms

The parties dispute the meaning of four claim elements: (1) the term "magnet" as used in Claims 1 and 4; (2) the phrase "forming appendages extending from either side of said auxiliary eyeglasses" as used in Claim 1; (3) the phrase "temple extensions on either side of said conventional glasses" as used in Claim 1; and (4) the phrase "temple extensions attached to either side of a frame" as used in Claim 4.

A. "Magnet"

Plaintiff argues that the term "magnet" in Claims 1 and 4 means "either a permanent magnet or a ferromagnetic material capable of acting as a magnet or equivalents." (Joint Statement at p. 5.) Conversely, Defendants argue that the term "magnet" means a permanent magnet. (Joint Statement at p. 14.)

Following *Vitronics,* the Court should first look to the words of the claim itself to define the scope and meaning of the patented invention, then to the patent specification and prosecution history. The claims, specification and prosecution history of the '913 patent do not define the term "magnet;" they simply use the word. The ordinary meaning of "magnet" is "a body having the property of attracting iron and producing a magnetic field external to itself" and "something that attracts." Webster's Ninth New Collegiate Dictionary (1986). (Radparvar Supp. Decl. at Ex.1; Williams Decl. at Ex.A.) "Permanent magnet" is defined as "a magnet that retains its magnetism after removal of the magnetizing force." Merriam-Webster Online Dictionary. (Trojan Decl. at Ex.4.) A "ferromagnetic material" is a material that is attracted by a permanent magnet, *e.g.,* iron, nickel and cobalt. *See Miracle* Claim Construction Order at 19 n. 9. The phrase "ferromagnetic material" is not used in the claims or the specification.

The ordinary meaning of "magnet" is essentially a permanent magnet, a body that attracts other materials and retains that attractive capability after the magnetizing force is removed. The ordinary meaning of "magnet" contrasts with the definition of "ferromagnetic material," which is a material that is attracted by a permanent magnet, rather than a material that attracts certain materials. The Court does not find that the ordinary meaning of magnet should be construed to include ferromagnetic materials.

Plaintiff argues that "magnet" should be construed to include ferromagnetic materials because "a review of the entire file history of the ' 913 patent demonstrates that no rejection can be found based upon the type of magnetic material used." (Opening Brief at 7:13-15.) This argument is irrelevant, because the fact that the patent examiner did not issue a rejection based on the type of magnetic material used has no bearing on the interpretation of the term "magnet." FN2

FN2. This argument by Plaintiff was previously rejected in related litigation, *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc. et al.,* No. CV 02-01087 LGB (CWx), Order Construing Claims of U.S. Patents 6,343,858 and RE 37,545, May 5, 2003. The Court stated that "[t]he patent applicant in this case used the term 'magnets' in his application; and the most logical assumption is that the patent examiner simply considered 'magnets' to mean permanent magnets, and thus would have had no reason to consider other interpretations of that term." (Trojan Decl. at Ex.3, 15:8-13.)

Plaintiff relies on the Court's construction of the phrase "magnetic members" in the case of *Aspex Eyewear, Inc. v. Miracle Optics, Inc.,* CV 01-10396, Order Construing Claims of U.S. Patents RE 37,545 and 6,109,747, February 14, 2003 (hereinafter "*Miracle* Claim Construction Order"). (Trojan Decl. at Ex.2). In the *Miracle* Claim Construction Order, the Court interpreted 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." (Trojan Decl. at Ex.2, 20:5-8). The Court explained that the definition of "magnetic" includes "capable of being magnetized or of being attracted by a magnet." *Miracle* Claim Construction Order at 16. Plaintiff argues that based on the *Miracle* Court's construction of "magnetic," the Court should construe the term "magnet" as used in the '913 patent as either a permanent magnet or

ferromagnetic material capable of acting as a magnet.

Plaintiff's reliance on *Miracle* is misplaced, because the words used in the patents at issue in *Miracle* and the '913 patent are different. Nowhere in the *Miracle* Claim Construction Order did the Court state or suggest that it was construing the noun "magnet." In fact, the Court in *Miracle* acknowledged the difference between the words "magnetic" and "magnet," stating "the Court agrees with Plaintiffs that the use of both 'magnet' and 'magnetic material' in the [claim] language [ ] counsels against limiting the phrase 'magnetic material' to a 'magnet.' " (Trojan Decl. at Ex.3, 41; 24-27.) The operative word at issue in the '913 patent is the noun "magnet," not the adjective "magnetic." The only term used to describe the '913 patent in the claims and the specification is "magnet," not "magnetic member" or "ferromagnetic material." The definition of the adjective "magnetic" relied on by the Court in *Miracle* is different from the definition of the noun "magnet." The definition of "magnetic" specifically includes materials that are capable of both being magnetized and being attracted by a magnet. In contrast, the definition of "magnet" states only that the body has the ability to attract certain materials, and includes no reference to the body being attracted by certain materials. For the foregoing reasons, the Court also rejects Plaintiff's assertion that Defendant Aspex is estopped from asserting that the ordinary meaning of the term "magnet" used in the '913 patent claims does not include ferromagnetic materials.

In related litigation, *Revolution Eyewear, Inc. v. Aspex Eyewear, Inc. et al.,* No. CV 02-01087-LGB (CWx), Order Construing Claims of U.S. Patents 6,343,858 and RE 37,545, May 5, 2003, the Court construed the term "magnet" found in Plaintiff's U.S. Patent No. 6,343,858 to mean "permanent magnet" (hereinafter "'858 Claim Construction Order"). (Trojan Decl. at Ex.3.) The ' 858 patent is a continuation-in-part of the application leading to the ' 913 patent, and both the '858 and '913 patents used the term "magnet" in the patent claims and specification. In the '858 Claim Construction Order, the Court distinguished the *Miracle* Claim Construction Order, because the latter construed the term "magnetic," rather than the term "magnet" that was used in the '858 patent. The Court found that the ordinary meaning of "magnet" is essentially a permanent magnet, a "body that attracts certain materials, as iron, by virtue of a surrounding field of force created by the motion of its atomic" and "[o]ne that attracts." (Trojan Decl. at Ex. 3, 14.) In the '858 Claim Construction Order, the Court distinguished the meaning of "magnet" from "ferromagnetic material," finding that the ordinary meaning of "magnet" "cannot be ferromagnetic material because it needs to have the ability to attract certain material like iron" and a ferromagnetic material is a material attracted by a permanent magnet. Id.

Plaintiff disagrees with the ordinary meaning of magnet as construed in the ' 858 Claim Construction Order. However, this Court agrees with the prior court's construction of the term "magnet." In addition, the Court finds that since the '858 and '913 patents are related, the common term "magnet" should be construed consistently to mean a permanent magnet.

B. "Forming Appendages Extending From Either Side of Said Auxiliary Eyeglasses"

Plaintiff argues that the phrase "forming appendages extending from either side of said auxiliary eyeglasses" refers to "an appendage to each side of the auxiliary eyeglasses." (Opening Brief at 8:5-6.) Defendants argue that the phrase means that "two or more appendages are found on at least one side of the auxiliary eyeglasses." (Responsive Brief at 11:5-6; Joint Statement at p. 15 .) The dispute centers on the interaction between the plural form of "appendages" and the term "either."

The ordinary meaning of the word either is "being the one and the other of two" or "being the one or the

other of two." Webster's Ninth New Collegiate Dictionary (1986); Oxford English Dictionary (2d Ed.) (defining "either" as "each of the two" or "one or the other of two"). Defendants provided only the second definition-being the one *or* the other of two; however, the Court finds that the first definition-being the one *and* the other of two-is appropriate here. Under that first definition, the Oxford English Dictionary provides that when "either" is used with a plural noun, it has the same meaning as "both," *e.g.,* appendages extending from both sides of the auxiliary eyeglasses.

Defendants argue that the claim language unambiguously sets forth limitations that exclude a preferred embodiment, *i.e.,* one appendage on each side of the auxiliary eyeglasses, and the Court cannot alter the ordinary meaning of the words to cover that embodiment. Further, Defendants argue that if Plaintiff wished to claim the preferred embodiment of one appendage on each side in the '913 patent, then Plaintiff had the duty to draft specific and clear claims to that embodiment. In response, Plaintiff argues that Defendants are seeking to create a limitation in requiring two or more appendages on at least one side of the auxiliary eyeglasses; but, the limitation is not identified in the claims, specification, or prosecution history. Plaintiff argues that the language of the claim does not limit it to two or more appendages on one side of the auxiliary eyeglasses.

The Court finds that in order to properly construe this phrase, it must consider the claim specification and the illustrations contained therein, which support the claim and show the embodiment of the claim. The written description and drawings, which indicate what the patent holder is protecting, aid the Court in construing the meaning of disputed claim terms. *See* Prima Tek II, 318 F.3d at 1148. Although the illustrations depict a particular embodiment of the claims, the claims are not limited to that particular configuration. *See* Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc., 222 F.3d 951, 956 (Fed.Cir.2000).

Here, the illustrations indicate one appendage on each side, which the Court finds is a reasonable construction of the claim language and is consistent with the ordinary meaning of the word "either," when used in conjunction with a plural noun. (Trojan Decl. at Ex.A, FIGS. 1-9.) The Court declines to limit the definition of the phrase "forming appendages extending from either side of said auxiliary eyeglasses" to mean at least two appendages extending from each side of the auxiliary eyeglasses.

Based on the specification and the illustrations, the Court construes the phrase "forming appendages extending from either side of said auxiliary eyeglasses" to mean forming at least one appendage extending from each side of the auxiliary eyeglasses.

C. "Temple Extensions on Either Side of Said Conventional Glasses"

For the reasons discussed above, the Court construes this phrase to mean at least one temple extension on each side of the conventional glasses.

D. "Temple Extensions Attached to Either Side of a Frame"

For the reasons discussed above, the Court construes this phrase to mean at least one temple extension attached to each side of a frame.

IV. Conclusion

Based on the foregoing, the Court concludes that:

1. "magnets" in claims 1 and 4 of the '913 patent means permanent magnet;

2. "forming appendages extending from either side of said auxiliary eyeglasses" in claim 1 of the '913 patent means forming at least one appendage extending from each side of the auxiliary eyeglasses;

3. "temple extensions on either side of said conventional glasses" in claim 1 of the '913 patent means at least one temple extension on each side of the conventional glasses; and

4. "temple extensions attached to either side of a frame" in claim 4 of the ' 913 patent means at least one temple extension attached to each side of a frame.

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