United States District Court,
D. Utah, Central Division.

Thomas W. NIELSON,
Plaintiff.
v.
A.T. CROSS COMPANY, a Rhode Island Corporation,
Defendant.

No. 2:03 CV 586 TC

May 11, 2005.

Barnard N. Madsen, Mark D. Stubbs, Fillmore Spencer LLC, Victoria W. Romney, Kunzler & Associates, Monte Neil Stewart, Marriage Law Foundation, Provo, UT, Brick G. Power, Trask Britt PC, Salt Lake City, UT, Nyle B. Smith, Portland, OR, for Plaintiff.

Angelo Notaro, Notaro & Michalos PC, Orangeburg, NY, Julianne P. Blanch, Snow Christensen & Martineau, Salt Lake City, UT, John Zaccaria, Notaro & Michalos PC, Orangeburg, NY, for Defendant.

AMENDED ORDER

TENA CAMPBELL**, District Judge.**

Plaintiff Thomas W. Nielson is the owner of United States Patent No. 4,974,982 ("the '982 Patent"). The '982 Patent discloses a pocket pen that can be attached to a key ring. The Defendant A.T. Cross Company ("Cross") is in the business of manufacturing and selling writing instruments. Mr. Nielson has brought this lawsuit alleging that the Ion Pen, manufactured by Cross, infringes the claims of the '982 Patent. In addition, Mr. Nielson alleges that Cross is liable for misappropriation of trade secrets, conversion, and unfair competition.

The matter is now before the court for construction of the disputed terms as required by Markman v. Westview Instruments. Inc., 517 U.S. 370 (1996).

ANALYSIS FN1

FN1. At the oral argument on claim construction, the parties agreed that only four terms remained in dispute. These four terms are found in claim 1 of the '982 Patent.

Claim construction begins with "the intrinsic evidence of 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), *quoted in* Liquid Dynamics Corp. v. Vauehan Co., Inc., 355 F.3d 1361, 1367

(Fed.Cir.2004). A court must look first to the claim language to determine its ordinary meaning, then to the written description, and finally, to the prosecution history, if available. Liquid Dynamics, 355 F.3d at 1367. A court must also examine the intrinsic record to determine if the patentee has acted as his own lexicographer and defined a term differently from the ordinary meaning. Texas Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1203 (Fed.Cir.2003).

If "an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term ... it is improper to rely on extrinsic evidence." Vitronics Corp., 90 F.3d at 1583. Extrinsic evidence, such as expert testimony, ' "may not be used to vary or contradict the claim language' or 'the import of other parts of the specification.' " Riverwood Intern. Corp. v. R.A. Jones & Co., Inc., 324 F.3d 1346, 1358 (Fed.Cir.2003) (quoting Vitronics, 90 F.3d at 1584).

The question of when a court should look to the specification for guidance in construing claim terms is of particular importance here. Mr. Nielson argues that Cross' proposed constructions improperly read limitations from the specifications into the claim language. Cross takes the position that it has appropriately read claim 1 in light of the specification.

With these principles in mind, the court turns to the disputed terms of claim 1 of the '982 Patent.

Claim 1 of the '982 Patent

1. "A three piece pen"

Claim Term	**Plaintiff Nielson's Definition**	**Defendant Cross' Definition**
A three piece pen	A pen with three separable components-a short cap, a pen holder and a tubular barrel. The penholder and tubular barrel are removable from the short cap. Three piece pen refers to the "pieces" that a user would manipulate during normal use when converting the pen from the closed position to the open or writing position or, conversely, from the open or writing position to the closed position.	A pen with three separable components-a short cap, a pen holder and a tubular barrel. The penholder and tubular barrel are removable from the short cap. The two removed components-penholder and barrel-may be disengaged from each other and re-engaged in an extended length. Three piece pen refers to the "pieces" that a user would manipulate during normal use when converting the pen from the closed position to the open or writing position or, conversely, from the open or writing position to the closed position.

The parties disagree only on whether the language proposed by Cross-"the two removed components-penholder and barrel-may be disengaged from each other and re-engaged in an extended length"-is appropriate. According to Mr. Nielson, Cross' proposed construction violates the well-established principle of claim construction that prohibits reading a limitation from the specification into the claim. Moreover, according to Mr. Nielson, the claim language has a commonly understood meaning and, therefore, the proper construction should go no further than the claim language.

The court agrees with Mr. Nielson. The claim language is clear on its face. Nothing in the claim language requires, or justifies, a deviation from the plain language of the claim. *See* Renishaw PLC v. Marposs Societa' Per Azioni, 158 F.3d 1243, 1248-49 (Fed.Cir.1998) (holding that there must be a need to clarify a

claim term before a limitation from the specification may be imported into the claim itself).

Accordingly, the court construes the term as: "A pen with three separable components-a short cap, a pen holder and a tubular barrel. The penholder and tubular barrel are removable from the short cap, 'Three piece pen' refers to the 'pieces' that a user would manipulate during normal use when converting the pen from the closed position to the open or writing position or, conversely, from the open or writing position to the closed position." FN2

FN2. The court notes that much of the construction goes beyond the simple claim language. But because both parties proposed this language, the court will accept it.

2. "Said open ends of said cap and barrel being provided with like internal threads"

Claim Term	Plaintiff Nielson's Definition	Defendant Cross' Definition
Said open ends of said cap and barrel being provided with like internal threads	The open ends of the cap and barrel are provided with like internal threads. The term "threads" should be construed in its usual, broad sense, without an imported limitation of "spiral," given the multitude of structures and configurations commonly defined as threads.	The cap has an open end with internal threads. The barrel also has an open end with internal threads. The internal threads of the cap and barrel are like threads. In order to extend the pen, the internal threads of the cap and the internal threads of the barrel must be alike, that is, the same. Otherwise, it would be impossible to lengthen the pen by unthreading or unscrewing the barrel from the externally threaded zone 32 and re-threadingly engaging or screwing it over externally threaded zone 30 of the penholder from which the cap has been disengaged.

Looking at the plain language of the term, the court concludes that the proper construction of this term is: "The cap has an open end with internal threads. The barrel also has an open end with internal threads. The internal threads of the cap and barrel are like threads, that is, the threads are alike or the same."

3. "Said other end of said pen holder being externally threaded along circumferentially extending zones thereof on both sides of said abutment"

Claim Term	Plaintiff Nielson's Definition	Defendant Cross' Definition
said other end of said pen holder being externally threaded along circumferentially extending zones thereof on both sides of said abutment	The other end of the pen holder is externally threaded along circumferentially extending zones on both sides of the enlarged abutment. The term "threaded" ' should be construed in its usual broad sense, without an imported limitation of "spirally."	There are externally threaded zones circumferentially extending along the pen holder on opposite sides of the abutment.

The court concludes that the claim language is clear. Therefore, the court construes this term as: "There are externally threaded zones circumferentially extending along the pen holder on opposite sides of the abutment."

4. "With threads removably threadingly engagable in each of said open ends"

Claim Term	Plaintiff Nielson's Definition	Defendant Cross' Definition
with threads removably threadingly engagable in each of said open ends	The open ends of the cap and the barrel can be removably, threadingly engaged with the threads on each side of the enlarged abutment. The term "threads" should be construed in its usual broad sense, and the limitation "spirally" should not be imported into the construction of "threadingly." The limitation "interchangeably" should not be imported into the term "removably threadingly engagable." "Removably" should be understood in its usual broad, sense, without the imported limitation of "disconnectably."	The other or second end of the pen holder opposite the pen point end has threads engageable with each of the internal threads of the open ends of the cap and the barrel. The internal threads of the open end of the barrel are removably threadingly engagable with the external threads of both of the threaded zones 30, 32 on the opposite sides of the abutment of the pen holder. The internal threads of the cap are engageable with the external threads of the zone on the side of the abutment adjacent the terminal end. This allows the large barrel to be re-threaded into the threaded zone 30 to replace the short cap on the terminal end side to lengthen the pen.

Again, the court believes that the proper construction is found in the plain language of the claim. Accordingly, the court construes this term as: "The other FN3 end of the pen holder has threads that can be engaged with the internal threads of the open end of the cap and the open end of the barrel."

FN3. Amended pursuant to the parties' stipulation.

D.Utah,2005.
Nielson v. A.T. Cross Co.

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