United States District Court,
S.D. California.

DIMENSION ONE SPAS, INC., a California corporation,
Plaintiff.
v.
COVERPLAY, INC., an Oregon corporation,
Defendant.
Coverplay, Inc, an Oregon corporation,
Counterclaimant.
v.
Dimension One Spas, Inc, a California corporation,
Counterdefendant.

Civil No. 03cv1099-L(AJB)

Dec. 2, 2005.

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ORDER CONSTRUING CLAIMS

M. JAMES LORENZ**, District Judge.**

This matter came on for claim construction hearings in accordance with Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370 (1996).

FACTUAL BACKGROUND

Plaintiff Dimension One Spas, Inc. is the assignee of U.S. Patent No. 5,131,102 ("the '102 Patent") entitled "Spa Cover Lift Assembly," which concerns a spa cover lift device. (Complaint para. 8.) The patent issued on July 21, 1992. This device is intended to facilitate removal of a spa cover from atop a spa. Plaintiff alleges Defendant Coverplay, Inc. has infringed the ' 102 patent by making, using, offering for sale, selling, and/or importing spa cover lifts, including a spa cover lift known as the "Cover*Up!," embodying the patented invention. Id. para. 9. On June 2, 2003, Plaintiff filed this patent infringement action. Defendant has filed a counterclaim seeking a declaratory judgment that the '102 patent is invalid, unenforceable, and not infringed. (Counterclaim para. 1.)

APPLICABLE PATENT LAW

There is patent infringement if any one of a patent's claims covers the alleged infringer's product or process. SmithKline Diagnostics, Inc. v. Helena Labs. Corp., 859 F.2d 878, 889 (Fed.Cir.1988). Before determining whether a patent covers an alleged infringing device, it is necessary to conduct a claim construction hearing; *i.e.,* to determine what the terms of the claim mean. Novartis Pharms. Corp. v. Abbott Labs., 375 F.3d 1328, 1332 (Fed.Cir.2004); SuperGuide Corp. v. DirecTV Enters., Inc., 358 F.3d 870, 874 (Fed.Cir.2004). "A claim in a patent provides the metes and bounds of the right which the patent confers on the patentee to exclude others from making, using, or selling the protected invention." Corning Glass Works v. Sumitomo Elec. U.S.A ., Inc., 868 F.2d 1251, 1257 (Fed.Cir.1989). " 'The construction of claims is simply a way of elaborating the normally terse claim language in order to understand and explain, but not to change, the scope of the claims.' " Terlep v. Brinkmann Corp., 418 F.3d 1379, 1381 (Fed.Cir.2005) (quoting Embrex, Inc. v. Serv. Eng'g Corp., 216 F.3d 1343, 1347 (Fed.Cir.2000)).

Under *Markman,* the court as a matter of law must construe the claims of the patent at issue. Markman, 52 F.3d at 979; Terlep, 418 F.3d at 1381-82. "Interpreting the asserted claims entails a review of the intrinsic evidence, which consists of the claim language, the written description, and the prosecution history ." Terlep, 418 F.3d at 1382. " '[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.' " *Id*. (quoting Phillips v. AWH Corp., 415 F.3d 1303, 1314 (Fed.Cir.2005) (en banc)) (alteration in *Terlep*). However, the written description is not a substitute for, nor can it rewrite, the claim terms. SuperGuide, 358 F.3d at 875. " 'Specifications teach. Claims claim.' " *Id*. (quoting SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1121 n. 4 (Fed.Cir.1985) (en banc)). Although the written description may assist in understanding the claim terms, "it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment." *Id*.

The court next considers the prosecution history "to determine whether the patentee relinquished claim coverage by amendment or through argument to overcome or distinguish a reference." Novartis, 375 F.3d at 1335; SuperGuide, 358 F.3d at 875. The history includes the complete record of proceedings before the U.S. Patent and Trademark Office ("PTO"). Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). Further, the prosecution history includes any express representations the applicant made regarding the scope of the claims and prior art cited in the file history. Id. at 1582-83. " 'Although [it] is correct that the prosecution history is always relevant to claim construction, it is also true that the prosecution history may not be used to infer the intentional narrowing of a claim absent the applicant's clear disavowal of claim coverage.' " SuperGuide, 358 F.3d at 875 (*quoting* Amgen Inc. v. Hoechst Marion Roussel, Inc ., 314 F.3d 1313, 1327 (Fed.Cir.2003)) (alteration in *SuperGuide*).

Courts can also use extrinsic evidence such as expert testimony, treatises, and dictionaries, to assist in reaching a correct conclusion as to the claims' language. Novartis, 375 F.3d at 1335; CCS Fitness, Inc. v. Brunswick Corp., 288 F.3d 1359, 1366 (Fed.Cir.2002). In *Phillips,* the Federal Circuit recently admonished courts to attach the appropriate weight to extrinsic evidence such as dictionaries. Phillips, 415 F.3d at 1324. In so doing, the Federal Circuit criticized the methodology set forth in Texas Digital Systems, Inc. v. Telegenix Inc., 308 F.3d 1193 (Fed.Cir.2002), which held that dictionary definitions govern unless contradicted by intrinsic evidence. Tex. Digital, 308 F.3d at 1201-05. The *Phillips* court found "the methodology [*Texas Digital*] adopted placed too much reliance on extrinsic sources such as dictionaries, treatises, and encyclopedias and too little on intrinsic sources, in particular the specification and prosecution

history." Phillips, 415 F.3d at 1320. Nevertheless, *Phillips* does not preclude all uses of dictionaries, but courts must ensure that any reliance on dictionaries comports with the intrinsic evidence. *Id*. at 1322-24.

The words used in a claim are generally given their "ordinary and customary meaning;" *i.e.,* "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention." *Id*. at 1313. However, the presumption that the patentee intended the ordinary and customary meaning of claim terms is rebutted when the patentee has chosen to be his own lexicographer and set forth an explicit definition of the terms different from their ordinary and customary meaning. *Id*. at 1316; CCS Fitness, 288 F.3d at 1366. In addition, the presumption is rebutted if "a claim term lacks such clarity that there is 'no means by which the scope of the claim may be ascertained from the language used.' " Novartis, 375 F.3d at 1334 (quoting Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 990 (Fed.Cir.1999)); *see* CCS Fitness, 288 F.3d at 1367. Finally, "as a matter of statutory authority, a claim term will cover nothing more than the corresponding structure or step disclosed in the specification, as well as equivalents thereto, if the patentee phrased the claim in step- or means-plus function format." CCS Fitness, 288 F.3d at 1367; 35 U.S.C. s. 112 para. 6.

DISPUTED CLAIM TERMS

The parties dispute several terms used claim in Claim 1, the only independent claim. Claim 1 reads:

A spa cover lift removal and support assembly for a hinged spa cover which covers the top of a spa and includes at least two cover sections connected by a hinge whereby said sections are foldable in overlapping relation comprising:

a pair of pivoting supports;

pivot means, adapted to be secured adjacent one side of a spa, and having a common pivot axis for facilitating pivoting said pair of pivoting supports about said common axis;

each pivoting support having a first end pivotally attached to said pivot means to pivot about said common axis, and each having a second end;

an upper bridge arm connected to said second ends of said pair of pivoting supports, said upper bridge arm pivotable to a first position adjacent and parallel to said hinge of said spa cover when covering said spa and to a second position clear of said spa whereby said cover sections are folded over said upper bridge arm and said upper bridge arm is pivoted to said second position to remove said cover from said spa and support said cover to one side of said spa.

('102 Patent, col. 5, 1. 60 col. 6, 1. 15.)

The parties dispute the meaning of the terms "pivot means," "adapted to be secured adjacent one side of a spa," "a pair of pivoting supports," and "upper bridge arm." The parties further disagree on whether the preamble imposes any limitations on Claim 1. Plaintiff contends the contested terms should be given their ordinary meaning and that it is not necessary to define them. Rather, the Court should, for example, define a "pair of pivoting supports" as "a pair of pivoting supports." Plaintiff, however, has cited no authority for the proposition that no construction is necessary when the meaning is obvious to one of the parties. The Federal Circuit has held that claim construction is necessary " 'when the meaning or scope of technical terms and

words of art is unclear and in dispute and requires resolution to determine' the issue before the court.' " Eli Lilly & Co. v. Aradigm Corp., 376 F.3d 1352, 1360 (Fed.Cir.2004) (quoting United States Surgical Corp. v. Ethicon, Inc., 103 F.3d 1554, 1558 (Fed.Cir.1997)). "The very fact that the meaning of a particular limitation is disputed suggests that the meaning is not entirely clear from the language used in the patent and that the Court must construe the term." Information Tech. Innovation, LLC v. Motorola, Inc., 391 F.Supp.2d 719, 723 (N.D.Ill.2005). Thus, while some of the terms "may not require elaborate interpretation," the "suggestion that entire limitations in dispute do not require construction is at odds with the purpose of claim construction." Id. at 723-24. The Court therefore turns to the disputed terms.

I. " *Pivot Means* "

A. Applicable Law Regarding Means-Plus-Function Elements

As background to this disputed claim term, it is necessary to first discuss "means-plus-function" elements under 35 U.S.C. s. 112 para. 6. A means-plus-function limitation recites a function to be performed rather than a defined structure. Lockheed Martin v. Space Sys./Loral, Inc., 324 F.3d 1308, 1318 (Fed.Cir.2003). As a general principle of claim construction, limitations found only in the specification of a patent should not be read into a claim. SuperGuide, 358 F.3d at 875. However, under 35 U.S.C. s. 112 para. 6, FN1 an element in a patent claim that is described as a means or a step for performing a specified function is construed to cover the corresponding "structure, material or acts described in the specification" and their "equivalents." 35 U.S.C. s. 112 para. 6. The scope of a means-plus-function element is therefore restricted to structures disclosed in the specifications and equivalent structures that perform the same function. *See* Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 1535-36 (Fed.Cir.1991). To determine whether 35 U.S.C. s. 112 para. 6 applies, the court must first ascertain if the element is truly a "means-plus-function" element. An element is a "means-plus-function" element if the claim recites a specific function without any definite structure. *See* Phillips, 415 F.3d at 1311 ("Means-plus-function claiming applies only to purely functional limitations that do not provide the structure that performs the recited function."). "An element with ... a detailed recitation of its structure, as opposed to its function, cannot meet the requirements of the statute." Cole v. Kimberly-Clark Corp., 102 F.3d 524, 531 (Fed.Cir.1996). When a claim uses the term "means" to describe a limitation, the court presumes " 'that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses.' " Altiris, Inc. v. Symantec Corp., 318 F.3d 1363, 1375 (Fed.Cir.2003) (quoting Sage Prods., Inc. v. Devon Indus., Inc., 126 F.3d 1420, 1427 (Fed.Cir.1997)). "The use of the term 'means' is 'central to the analysis.' " Lighting World, Inc. v. Birchwood Lighting, Inc ., 382 F.3d 1354, 1358 (Fed.Cir.2004) (quoting Personalized Media Communications, LLC v. Int'l Trade Comm'n, 161 F.3d 696, 703 (Fed.Cir.1998)). However, the presumption that the term "means" invokes s. 112 para. 6 is rebutted when the claim recites no function corresponding to the means. Allen Eng'g Corp. v. Bartell Indus., Inc., 299 F.3d 1336, 1347 (Fed.Cir.2002); Rodime PLC v. Seagate Tech., Inc., 174 F.3d 1294, 1302 (Fed.Cir.1999). In addition, " 'even if the claim element specifies a function, if it also recites sufficient structure or material for performing that function, s. 112, para. 6 does not apply.' " Allen Eng'g, 299 F.3d at 1347 (quoting Rodime, 174 F.3d at 1302).

FN1. That paragraph states:
An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

35 U.S.C. s. 112 para. 6.
If the court finds a claim term is a "means-plus-function" element, it must identify the specific function recited by the claim. Omega Eng'g, Inc. v. Raytek Corp., 334 F.3d 1314, 1321 (Fed.Cir.2003); Altiris, 318 F.3d at 1375. Then, the court must look at the specifications to define the structure, material or acts which correspond to the claimed function. Omega Eng'g, 334 F.3d at 1321; Altiris, 318 F.3d at 1375. A corresponding structure is one which "the specification or prosecution history clearly links or associates ... to the function recited in the claim." B. Braun Med., Inc. v. Abbott Labs., 124 F.3d 1419, 1424 (Fed.Cir.1997); *accord* Altiris, 318 F.3d at 1375. Alternative structures specifically mentioned in the specification are also included in the scope of the patent. *See* Serrano v. Telular Corp., 111 F.3d 1578, 1583 (Fed.Cir.1997).

B. Judge Miller's Order

In 1998, Plaintiff filed a patent infringement action against one of the ' 102 Patent's co-inventors. In ruling on a summary judgment motion in that action, Judge Miller construed the terms of Claim 1 of the '102 Patent. Judge Miller held that Claim 1:

encompasses a spa cover removal system with a pair of "pivoting supports." The "first end" of these "pivoting supports," *i.e .*, the outermost portion of these supports is secured to the sides of a spa so that they pivot about a common axis. The second outermost portion of these "pivoting supports" is "connected to," *i.e.*, joined with, an "upper bridge arm" over which the sections of the spa cover are folded. Because the "upper bridge arm" is joined with the "pivoting supports," the court concludes that the pivoting supports' are separate from the "upper bridge arm ." The "upper bridge arm" spans or extends across the spa cover. Thus, the upper bridge arm must be a continuous structure.

In sum, Claim 1 contains three elements: (1) a pair of pivoting supports; (2) a means for pivoting that is attached to the first outermost point of the pivoting supports; and (3) a structure that continuously extends across the full width of the spa cover, that structure being separate from and connected to the second outermost point of the pivoting supports.

(*Dimension One Spas, Inc. v. Ouellette et al.,* 98cv0877-JM(POR), 04/07/99 Order at 4) (internal footnotes omitted).

Defendant argues Plaintiff is precluded under the law of the case doctrine FN2 from asserting that the "pivot means" element is not a means-plus-function limitation because Judge Miller already construed Claim 1 as a means-plus-function limitation. Defendant argues that in the case before Judge Miller, Plaintiff was represented by its same counsel, and the controlling facts and applicable law are the same in the previous action and in this case. Defendant further maintains that in the earlier action, Plaintiff argued for the construction that Judge Miller ultimately adopted. The Court disagrees.

FN2. At the first *Markman* hearing, Plaintiff referenced RF Delaware, Inc. v. Pacific Keystone Technologies, Inc., 326 F.3d 1255, 1261 (Fed.Cir.2003) to argue collateral estoppel does not apply in this case because Judge Miller did not construe the "pivot means" element in the earlier action. Defendant argues in supplemental briefing that collateral estoppel is not the issue in this case, but rather the doctrine of the law of the case is what precludes Plaintiff for arguing for a different construction of "pivot means."

As an initial matter, the Court is not persuaded that Judge Miller concluded the term "pivot means" is subject to s. 112 para. 6. Although Judge Miller used means-plus-function language when holding that Claim 1 encompasses "a means for pivoting that is attached to the first outermost point of the pivoting supports," Judge Miller did not proceed through the necessary steps of defining the function and identifying the structure of a means-plus-function element for the "pivot means."

More importantly, as noted by Plaintiff, the law of the case doctrine is inapplicable because it applies to decisions a court makes *within that case* before final judgment. *See* Arizona v. California, 460 U.S. 605, 618 (1983) ("[T]he [law of the case] doctrine posits that when a court decides upon a rule of law, that decision should continue to govern the same issues in subsequent stages in the same case."); United States v. Miller, 822 F.2d 828, 832 (9th Cir.1987) (" 'In the absence of statute the phrase, law of the case, as applied to the effect of previous orders on the later action of the court rendering them in the same case, merely expresses the practice of courts generally to refuse to reopen what has been decided, not a limit to their power.' ") (quoting Messinger v. Anderson, 225 U.S. 436, 444 (1912)). Because Judge Miller's order was in a case procedurally unrelated to this one, the law of the case does not limit Plaintiff's right to advance its argument that "pivot means" is not subject to s. 112 para. 6, nor does it bind this Court. Accordingly, this Court must address the merits of the parties' arguments regarding the applicability of s. 112 para. 6.

C. Whether "Pivot Means" Is a Means-Plus-Function Element

The parties dispute whether "pivot means" is a means-plus-function element. Plaintiff concedes that the term "means" raises the presumption that s. 112 para. 6 applies, but maintains the presumption is rebutted because: (1) there is no function corresponding to the "pivot means," and (2) the term "pivot" is a structural term that itself connotes sufficient structure to perform any recited function, as confirmed by the claim language surrounding the term "pivot means."

1. Whether a Function is Linked to the "Pivot Means"

A claim term is not bound by s. 112 para. 6 notwithstanding use of the term "means" if it fails to recite a function corresponding to the means. Allen Eng'g, 299 F.3d at 1347. Plaintiff maintains Claim 1 does not recite a function performed by the "pivot means" and therefore the presumption that s. 112 para. 6 applies is rebutted. Plaintiff argues the only function recited in the claim is that of "facilitating pivoting," but according to Plaintiff, that function must grammatically correspond to the "common pivot axis." Defendant, in turn, contends that "pivot means" is linked to the function of facilitating pivoting of the pivoting supports about a common axis.

The Court agrees with Defendant. The patent does not teach how the common axis is the structure that can facilitate the pivoting of the pivoting supports. Rather, the common axis is a limitation on the manner in which the pivoting supports pivot. In other words, the pivoting supports must pivot about a common axis, but that pivoting is not facilitated by the common axis itself. Instead, Claim 1 specifies the pivoting supports are attached to the pivot means, and the pivot means is what causes the pivoting supports to pivot: "each pivoting support having a first end pivotally attached *to said pivot means to pivot about* said common axis." ('102 Patent, col. 6, ll. 3-5) (emphasis added).

The specification also provides support for this conclusion. Nowhere in the specification is the "facilitating pivoting" function performed by the common axis. Rather, the specification discloses pivot blocks and corner bars as providing pivotal support for the pivoting supports. *See, e.g.,* id. col. 2, ll. 29-31, 43-45, id. col. 4, ll. 21-26. For example, the written description states that "[a] pivot block 27 is typically a two piece

or one piece structure having a bore 37, when assembled, extending completely there through. The diameter of bore 37 will be greater than the outside diameter of corner bar 29 in order that one portion of corner bar 29 may extend through and be rotatably supported by pivot block 27." Id. col. 4, ll. 21-26. In one part of the specification, the patent describes various methods by which the pivot blocks may be secured to the side of the spa. Id. col. 4, ll. 27-45. The description then confirms the function of the pivot blocks is to provide "pivotal support to the pivoting supports 33 and the [optional] bridge arm 32." Id., col. 4, ll. 45-48. From this description, it is clear that a common pivot axis is not the structure that performs the function of facilitating pivoting. Rather, the pivoting of the pivoting supports is facilitated by the "pivot means," which in the embodiment discussed above is comprised of pivot blocks and corner bars.

In brief, having carefully reviewed the patent, the Court concludes the pivot means is linked to the function of facilitating pivoting, and rejects Plaintiff's argument that no function corresponds to that term. Having so concluded, the Court must turn to Plaintiff's second argument that the claim recites sufficient structure.

2. Whether the Claim Recites Sufficient Structure

As noted above, a claim element that uses the word "means" can escape the limitations of s. 112 para. 6 even if it specifies a function " 'if it also recites sufficient structure or material for performing that function.' " Allen Eng'g, 299 F.3d at 1347 (quoting Rodime, 174 F.3d at 1302). Plaintiff argues Claim 1 recites sufficient structure because the term "pivot" itself is structural. Plaintiff also contends the language following the term "pivot" indicates the construction and location of the "pivot" structure and establishes the element is not subject to s. 112 para. 6. Defendant responds that "pivot" is a verb descriptor modifying the word "means" and the claim does not describe the particular structure of the particular pivot.

a. Whether the Term "Pivot" Connotes Sufficient Structure

When analyzing whether a term recites sufficient structure, the Federal Circuit has "held that it is sufficient if the claim term is used in common parlance or by persons of skill in the pertinent art to designate structure, even if the term covers a broad class of structures and even if the term identifies the structures by their function," Lighting World, 382 F.3d at 1359-60; *see* CCS Fitness, 288 F.3d at 1369 ("To help determine whether a claim term recites sufficient structure, [courts] examine whether it has an understood meaning in the art."). Examples of cases in which the Federal Circuit found a claim term recited sufficient structure can be found in *Cole* and Envirco Corp. v. Clestra Cleanroom, Inc., 209 F.3d 1360 (Fed.Cir.2000).

In *Cole,* a patent for easily removable toilet training pants for toddlers contained the phrase "perforation means extending from the leg band means to the waist band means through the outer impermeable layer means for tearing the outer impermeable layer means for removing the training brief in case of an accident by the user." Cole, 102 F.3d at 530. The Federal Circuit determined that the "perforation means" element did not meet the requirement of s. 112 para. 6 because it described a definitive structure-perforations-that supported the function of tearing, and also described the location and extent of the structure. *Id.* at 531. Similarly, in *Envirco,* a patent covering a centrifugal fan and filter assembly for clean room environments contained a limitation reciting a "second baffle means." Envirco, 209 F.3d at 1363. The Federal Circuit found the claim recited sufficient structure because it used the word "baffle," which itself is a structural term to describe a "plate, wall, or screen," and the claim "described the particular structure of this particular baffle." Envirco, 209 F.3d at 1365. In particular, the claim described the structure of the baffle as being disposed radially outward from the centrifugal fan, with inner surfaces for directing airflow. *Id.*

Courts may look at dictionary definitions to determine whether a disputed term has an understood meaning

to one knowledgeable in the art. *See* Lighting World, 382 F.3d at 1360 ("In *Greenberg* and subsequent cases, [the Federal Circuit has] looked to the dictionary to determine if a disputed term has achieved recognition as a noun denoting structure, even if the noun is derived from the function performed."). Plaintiff presents two dictionary definitions of the term "pivot" to support its argument the term recites sufficient structure. In *Webster's Third New International Dictionary,* "pivot" is defined as:

1a: a usu. short shaft or pin whose pointed end forms the fulcrum and center on which something turns about, oscillates, or balances: (1): the pin of a hinge (2): an axle on which a wheel turns (3): the shaft on which the hands of a timepiece turn (4): the pin on which a pointer (as of a compass) is balanced and turns b(1): the pointed end of such a shaft or pin (2): a real or apparent point or position on which something turns about, oscillates, or balances ...

Webster's Third New Int'l Dictionary 1726 (1986). The *Oxford English Dictionary* similarly defines "pivot" as: "A short shaft or pin, usually of metal and pointed, forming the fulcrum and centre on which something turns or oscillates; as the pin of a hinge, the end of an axle or spindle, or the arbor on which the hands of a timepiece turn; a pintle, gudgeon." *Oxford English Dictionary* 933 (2d ed.1989).

These definitions reveal the term "pivot" has a well-understood meaning as a name for a structure. However, to end the inquiry here would give too much weight to external sources and contravene *Phillips*' mandate that substantial weight be given to the intrinsic evidence. As the *Phillips* court noted, a claim term's ordinary meaning "is its meaning to the ordinary artisan after reading the entire patent." Phillips, 415 F.3d at 1321. While *Phillips* allows courts to rely on dictionaries "to assist in understanding the commonly understood meaning of words," *id*. at 1322, the case also warns that "heavy reliance on the dictionary divorced from the intrinsic evidence risks transforming the meaning of the claim term to the artisan into the meaning of the term in the abstract, out of its particular context, which is the specification." *Id*. at 1321.

The dictionary definitions for the terms at issue in *Cole* and *Envirco*-perforation and baffle, respectively-imparted structures capable of performing the corresponding functions recited in the claims. In contrast, as Defendant points out, neither the claim, specification, nor prosecution history of the ' 102 Patent refer to a generic "pivot" structure as defined by Plaintiff's proffered dictionaries. A review of the intrinsic evidence does not support the conclusion that a generic "pivot" structure as defined above is capable of performing the function of facilitating pivoting. One definition advanced by Plaintiff does not have any structure at all; it states that a pivot can be "an apparent point or position in which something turns about, oscillates, or balances." The claim does not support that definition of a "pivot." If the pivot means is an "apparent point or position" as opposed to a real structure, it cannot be secured adjacent one side of a spa nor be pivotally attached to the pivoting supports. Further, there is no support in the specification for the proposition that the pivot is intended to be an apparent point or position. Similarly, the definitions of a pivot as "a pointed end of a short shaft or pin," the "pin of a hinge," a "gudgeon" are not found in the claim itself nor shown in the specification to be the structures that can perform the function of facilitating pivoting of the pivoting supports. Plaintiff maintains that the specification uses "pivot" in the structural sense by describing pivot blocks. The Court is not persuaded. The specification's discussion of "pivot blocks" and its drawings of the pivot blocks reveal structures unlike those described in the dictionary definitions proffered by Plaintiff Accordingly, the Court finds the term "pivot," by itself, does not recite sufficient structure to perform the function claimed.

b. Whether The Claim Language Surrounding the Term "Pivot" Connotes Sufficient Structure

The Federal Circuit has found the presumption raised by use of the term "means" may be rebutted when additional language in the claim describes the structure that performs the recited function. For example, in Searfoss v. Pioneer Consolidated Corp., 374 F.3d 1142 (Fed.Cir.2004), the Federal Circuit reviewed a patent for moveable cover systems for truck beds that contained the term "actuation means." The Federal Circuit concluded the term "actuation means" was not subject to s. 112 para. 6 because the claim specifically recited the structure that performed the claimed function: "said actuation means including first and second pivot connections respectively between said first and second tension bail legs and a midpoint on said respective first and second extension bail legs." Searfoss, 374 F.3d at 1149. Similarly, in Turbocare Division of Demag Delaval Turbomachinery Corp. v. General Electric Co., 264 F.3d 1111, 1120 (Fed.Cir.2001), the claim contained the phrase "radial positioning means." The Federal Circuit concluded the presumption raised by the word "means" was rebutted because the claim recited two structures for achieving the function: (1) a compressed spring means and (2) working fluid, and also described how those structures act to achieve the claimed function. Turbocare, 264 F.3d at 1120.

In *Rodime,* the claim element began, "positioning means for moving said transducer means between the concentrically adjacent tracks on said micro hard-disk." Rodime, 174 F.3d at 1302. The Federal Circuit found the claim recited sufficient structure to overcome the presumption raised by the term "means" because the claim provided a list of the structure underlying the means: "said positioning means including: two support arms ... a pivot shaft ... a positioning arm ... a bearing assembly ... a stepper motor ... means for operating said stepper motor ... and a tensioned steel band." Id. at 1303 (internal quotations omitted) (alterations in original). The claim also recited the specific location and interconnection of the structural sub-elements. Id. at 1303-04.

Finally, in TI Group Automotive Systems (North America), Inc. v. VDO North America, L.L.C., 375 F.3d 1126 (Fed.Cir.2004), the patent was directed to fuel pump assembly technology. TI Group, 375 F.3d at 1130. Claim 2 recited a "pumping means for pumping fuel into the reservoir, said means being located within the reservoir in the region of the opening and including a nozzle and a venturi tube in alignment with the nozzle, the passage of fuel out of the nozzle and through the venturi tube causing fuel to be entrained through the opening into the interior of the reservoir." Id. at 1131. The Federal Circuit found that although the term "means" gave rise to a presumption that s. 112 para. 6 applies, the claim recited sufficient structure to rebut the presumption. *Id.* at 1135. In particular, the court held that the claim recited structure ("including a nozzle and a venturi tube in alignment with the nozzle"), location ("being located within the reservoir in the region of the opening"), and operation ("the passage of fuel out of the nozzle and through the venturi tube causing fuel to be entrained through the opening into the interior of the reservoir"). *Id.* The Federal Circuit thus concluded that the proper construction of "pumping means" is "a pump including a nozzle and a venturi tube in alignment with the nozzle." *Id.*

In contrast to these cases, in *Alitiris,* the Federal Circuit determined a claim did not recite sufficient structure to rebut the presumption that s. 112 para. 6 applied. There, the patent concerned the use of computer software for enabling a network administrator to remotely access network computers from a server as the computers are booted in order to, for example, update or install software. Altiris, 318 F.3d at 1366. Claim 8 of the patent read in part, "a means for booting said digital computer, said means of booting including a first set of commands, said first set of commands resident on said storage device of said digital computer for booting said digital computer, and a second set of commands resident on a storage device external to said digital computer for booting said digital computer." Id. at 1375. The plaintiff argued the patent's recitation of the first and second set of commands was sufficient structure in the form of software that will boot the computer. Id. at 1376. The Federal Circuit disagreed, finding that while "commands" represent structure in

the form of software, it was not sufficient structure to perform the entirety of the function, and it was necessary to refer to the specification to determine the structure of those commands. *Id*. The court noted that in cases where sufficient structure was recited, "the claim language specifies a specific physical structure that performs the function." *Id*. (citing *Envirco, Rodime,* and *Cole*).

Plaintiff here contends the clause containing the "pivot means" element clarifies the structural use of the word "pivot," much like the claim language in the "means" elements in *Searfoss, Turbocare, Rodime,* and *TI Group*. FN3 In particular, Plaintiff argues the terms "common pivot axis" and "pivotally attached" connote the structure of the pivot. Plaintiff further contends the phrase "adapted to be secured adjacent one side of a spa" recites the location of the pivot. Defendant agrees the phrase "adapted to be secured adjacent one side of a spa" designates location, but maintains that is insufficient to rebut the presumption raised by use of the term means. Defendant further contends the phrases "pivotally attached" and "common pivot axis" do not describe what the pivot structure is, but rather is additional functional language.

FN3. Plaintiff also argues the means clause in Claim 1 is similar to the means clause in *Phillips*. The Court disagrees. As an initial matter, while the claim in *Phillips* did contain a means clause, the Federal Circuit was analyzing whether the term "baffles" was subject to means-plus-function limitations. Phillips, 415 F.3d at 1311. The appellate court noted "that the term 'baffles' is not means-plus-function language that invokes 35 U.S.C. s. 112, paragraph 6." *Id*. The court explained that because "the reference to 'baffles' does not use the word 'means,' " there was a rebuttable presumption that s. 112 para. 6 did not apply. *Id*. In contrast, here, the term "pivot means" raises the presumption that s. 112 para. 6 *does* apply.

Further, the Federal Circuit found the claim implied baffles were structures by characterizing them as extending inwardly from the steel shell walls, and the specification referred to "steel baffles" as particular internal wall structures. *Id*.
As this Court found above, the intrinsic evidence does not indicate a generic pivot, as defined in the dictionaries presented by Plaintiff, is capable of performing the function of facilitating pivoting of the pivoting supports. Further, based on a review of the above-discussed cases, it is apparent that something more than a minimal recital of structure is necessary to overcome the presumption raised by the claim's use of the term "means." The Court is not persuaded the additional language cited to by Plaintiff adds sufficient structural information to rebut the presumption. The recitation of some structure is not sufficient to preclude the applicability of s. 112 para. 6 when that structure "merely serves to further specify the function of [the] means." Laitram, 939 F.2d at 1536. Thus, even assuming "a common pivot axis" connotes some structure to the pivot- *i.e.,* the pivot must have a common pivot axis-that structure only serves to clarify the function of facilitating pivoting. *Cf. id*. (finding the presumption raised by the term "means" not rebutted because "[t]he recited structure tells only what the means-for-joining *does,* not what it *is* structurally"). In other words, when the pivot means facilitates pivoting, it must do so in a manner that the pivoting supports pivot about a common axis and not on different axes. Further, the information that the pivot means is "pivotally attached" to the pivoting supports also fails to recite sufficient structure; instead, it indicates the relationship of the pivot means to another claim element: the pivoting supports.

Thus, the "pivot means" element in Claim 1 is similar to the one analyzed in a district court decision cited by Defendant, Nonin Medical, Inc. v. BCI, Inc., 2004 WL 442894 (D.Minn. Mar. 8, 2004). In *Nonin Medical,* the plaintiff owned the rights to a patent that described a finger clip pulse oximeter. The patent claimed a "gripping means for releasably gripping a finger, the gripping means comprising first and second housings interconnected by a *pivot means* which allows the first and second housings to pivot relative to one another to releasably grip a finger inserted between the first and second housings, the first and second

housings being in electrical communication with each other." Nonin Med., 2004 WL 442894, at *1 (emphasis added). The parties disputed whether the term "pivot means" was subject to means-plus-function analysis. The Minnesota district court concluded that it was. *Id.* at * 5. In so holding, the court found that the "pivot means" in the patent was something "which allows the first and second housings to pivot." *Id.* (internal quotations omitted). Further, the claim did not use the term "pivot" in such a way to indicate the exact structure used to accomplish the function of pivoting; instead, one needed to look at the specification "for an adequate understanding of the structure used to accomplish the function of pivoting." *Id.*

In brief, like *Altiris* and *Nonin Medical,* Claim 1 gives little indication of the particular structure that can accomplish the function of facilitating pivoting the pivoting supports about a common axis. It is necessary to review the specification for an adequate understanding of that structure. Therefore, the Court finds the presumption raised by use of the term "means" is not rebutted and that s. 112 para. 6 applies.

D. Identification of the Function and Structure of the "Pivot Means"

1. Function

Having determined the "pivot means" element is written in means-plus-function format, the next step is to determine what function the claimed means performs. *See* Omega Eng'g, 334 F.3d at 1321. Federal Circuit caselaw requires that the function come from the claim language itself, and courts "must exercise great caution to prevent impermissibly adopting a function other than that explicitly recited in the claim." Bausch & Lomb Inc. v. Moria S.A ., 222 F.Supp.2d 616, 630 (E.D.Pa.2002); *see* Omega Eng'g, 334 F.3d at 1321 (stating the court must identify the claimed function "staying true to the claim language and the limitations expressly recited by the claims"); Lockheed Martin, 324 F.3d at 1319 ("In identifying the function of a means-plus-function claim, a claimed function may not be improperly narrowed or limited beyond the scope of the claim language.").

Plaintiff argues that if the element is subject to s. 112 para. 6, the function is "facilitating pivoting." Defendant in turn, contends the function is "facilitating pivoting said pair of pivoting supports about said common axis." The Court agrees with Defendant's identification of the function claimed. Plaintiff's proposed definition is too broad, suggesting there are no limitations to what the pivot means facilitates pivoting. Claim 1, however, specifies that the pivoting movement being facilitated is that of the pair of pivoting supports about a common axis. Accordingly, the Court finds the proper identification of function for the pivot means is: facilitating pivoting the pivoting supports about a common axis.

2. Structure

The next step is to determine the corresponding structures. "A disclosed structure is corresponding 'only if the specification or the prosecution history clearly links or associates that structure to the function recited in the claim.' " Omega Eng'g, 334 F.3d at 1321 (quoting B. Braun Med., 124 F.3d at 1424). "In other words, the structure must be necessary to perform the claimed function." *Id.*

Plaintiff argues that if this Court construes "pivot means" as a "means-plus-function" element, the corresponding structure is the bore 37 and its equivalents.FN4 At the supplemental *Markman* hearing and in supplemental briefs, Defendant argued the corresponding structures are: (1) a pair of pivot blocks and a pair of lower corner bars; (2) a single pivot block (length not limited) and a pair lower corner bars; (3) a pair of pivot blocks, a pair lower corner bars, and a lower bridge arm; (4) a single pivot block (length not limited), a pair of lower corner bars, and a lower bridge arm; (5) any of the above embodiments further including a

kick stand.

FN4. In earlier briefing Plaintiff argued the corresponding structure is a "pivot," and provided the dictionary definitions referred to above. However, in supplemental briefing and at the supplemental *Markman* hearing Plaintiff argued the corresponding structure is bore 37 and its equivalents. Accordingly, the Court finds Plaintiff has abandoned its earlier position that the corresponding structure is a "pivot."

The Court disagrees with both parties. Plaintiffs identification of the proposed structure is insufficient. A bore, by itself, cannot perform the function of facilitating pivoting the pivot supports about a common axis, nor can it be secured to one side of a spa as required by Claim 1.

In each of the embodiments, the structure corresponding to the facilitating pivoting function is: (1) a single or a pair of pivot blocks; and (2) lower corner bars. The first embodiment discloses a structure wherein "[a] pair of pivot blocks are attached to one of the side walls 23 of spa 21, and each rotatably support one portion of a pair of lower corner bars 29." ('102 Patent, col. 2, 11. 29-31.) The specification further teaches that a single block can be used. Id. col. 2:40. No other structures are necessary to perform the function of facilitating pivoting the pivot supports.

Defendant's proposed construction adding a lower bridge arm and kick stand violates the rule against incorporating structure from the written description beyond what is necessary to perform the function as stated in the claim. In particular, it is not necessary for the pivot means to include a lower bridge arm; indeed, the specification states that a lower bridge arm is "optional." ('102 Patent, col. 2, l. 39.) Nor is it necessary for the pivot means to include a kick stand. Rather, one embodiment of the invention provides that a kick stand can be used so that "part of the force necessary to lift the cover 25 is supplied using the weight of the user." Id. col. 4, ll. 51-53, 57-65; id. Fig. 8. However, there is nothing in the claims or the specification indicating a kick stand is an essential part of the structure necessary to perform the function of facilitating pivoting of the pivot supports about a common axis. Accordingly, the Court declines to define the structure as requiring a lower bridge arm or kickstand.

Plaintiff argues that the structure cannot be pivot blocks because Claim 3 recites "[t]he assembly of claim 1 wherein said pivot means further comprises a pair of pivot blocks; and, a pair of lower corner bars, each said corner bar connected to one of said pair of pivot blocks." Id. col. 6, ll. 20-23, Claim 7 also discloses pivot blocks, together with a lower bridge arm. Id. col. 6, ll. 32-34. According to Plaintiff, if "pivot means" in Claim 1 is construed to encompass the structure of a pair of pivot blocks, Claims 3 and 7 would be rendered redundant. Plaintiff maintains the doctrine of claim differentiation prohibits this result.

The Court disagrees. The doctrine of claim differentiation prohibits construing terms from independent claims to include express limitations from the dependent claims. Innova/Pure Water v. Safari Water Filtration, 381 F.3d 1111, 1123 (Fed.Cir.2004). However, the Court's interpretation that "pivot means" includes pivot blocks (as well as lower corner bars) comes from the written description, not from dependent Claims 3 and 7, and therefore, "the prohibition against reading limitations from a dependent claim into the independent claim is not violated." Laitram, 939 F.2d at 1538; *accord* NOMOS Corp. v. Brainlab USA, Inc., 357 F.3d 1364, 1368 (Fed.Cir.2004). In *Laitram,* the disputed claim limitation was a "means for joining" a plurality of link ends for a conveyer belt. Laitram, 939 F.2d at 1535 n. 3. The corresponding structure in the specification consisted of link elements and cross members. Id. at 1536. The Federal Circuit rejected the patentee's argument that claim differentiation prevented limiting the claimed means to cross members

because a dependent claim specifically required a cross member:

[T]he interpretation of the 'means for joining' to include a cross member comes from the specification via section 112(6), not from [the dependent claim]. Thus, the prohibition against reading limitations from a dependent claim into the independent claim is not violated. Laitram's argument that [the dependent claim] prevents [the independent claim] from being interpreted as statutorily mandated by section 112(6) must be rejected.... Simply stated, the judicially developed guide to claim interpretation known as "claim differentiation" cannot override the statute. A means-plus-function limitation is not made open-ended by the presence of another claim specifically claiming the disclosed structure which underlies the means clause or an equivalent of that structure. If Laitram's argument were adopted, it would provide a convenient way of avoiding the express mandate of section 112(6). We hold that one cannot escape that mandate by merely adding a claim or claims specifically reciting such structure or structures.

Id. at 1538.

In addition, a finding that Claim 1 covers pivot blocks does not give it the exact same scope as Claim 3 or 7, and thus claim differentiation is maintained. Claim 1 is broader than Claims 3 or 7 because Claim 1 literally covers the structures described in the specification and equivalents thereof; however, Claims 3 and 7 do not literally cover equivalents of pivot blocks and lower corner bars. *Cf. id*. ("Claim 21 remains broader than claim 24. *Literally,* claim 21 covers the structure described in the specification *and equivalents* thereof. [citation] Dependent claim 24 does not *literally* cover equivalents of cross members.").

Accordingly, the corresponding structure is: (1) one pivot block and a pair of lower corner bars; (2) a pair of pivot blocks and a pair of lower corner bars; (3) equivalents of structures (1) and (2).

E. Number of Pivot Means

The parties dispute whether there can be more than one pivot means. Defendant maintains there can be only one pivot means. Plaintiff, in contrast, maintains there is no limit on the number of pivot means. The Court agrees with Defendant.

In patent parlance, the indefinite article "a" or "an" generally means "one or more." KCJ Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351, 1356 (Fed.Cir.2000); Abtox, Inc. v. Exitron Corp., 122 F.3d 1019, 1023 (Fed.Cir.1997). Only when the claims and specification indicate the inventor intended the term "a" to have its normal singular meaning does the court impose the singular meaning. KCJ, 223 F.3d at 1356; Abtox, 122 F.3d at 1023.

At the first *Markman* hearing, Plaintiff argued there is a silent "a" before "pivot means," and therefore the Court should find there can be one or more pivot means. (Tr. of Afternoon Session, Oct. 1,2004, at 36:21-25.) The Court is not persuaded. The Court has construed the term "pivot means" to be a means-plus-function element, and it has a corresponding structure that is made up of multiple components. For example, the entire pivot means structure can be made up of a pair of pivot blocks and a pair of lower corner bars. (*See, e.g.,* '102 Patent, col. 2, 11. 29-31.) Having so defined the "pivot means" structure, the intrinsic evidence allows for only one pivot means. Claim 1 does not suggest the function of facilitating pivoting of the pivoting supports can be accomplished by more than one "pivot means" structure. To the contrary, Claim 1 states the pivoting supports are "attached to *said* pivot means." ('102 Patent, col. 6, ll. 3-4.) This language reinforces the singular nature of the pivot means. *Cf.* Abtox, 122 F.3d at 1024 ("This term itself,

'said chamber,' reinforces the singular nature of the chamber."). Further, construing the claim as providing for only one pivot means does not impermissibly read out a preferred embodiment of the invention, as neither the text of the specification nor the drawings disclose the use of more than one pivot means. *See* Vitronics, 90 F.3d at 1583. Accordingly, the Court finds the patent discloses only one "pivot means."

II. " *Adapted to Be Secured Adjacent One Side of a Spa* "

The original patent application for the '102 Patent did not include this phrase, and read in relevant part, "pivot means, having a common pivot axis for facilitating pivoting about a common axis." (Redmann Decl. Ex. 2, '102 Patent and file wrapper at DIMI 0000028.) During prosecution of the patent, the "pivot means" element was changed to read: "pivot means, *adapted to be secured adjacent one side of a spa, and* having a common pivot axis for facilitating pivoting said pair of pivoting supports about said common axis." ('102 Patent, col. 5, l. 5-col. 6, l. 2) (emphasis added).

A. "Adapted"

Plaintiff argues the term "adapted" does not have a specialized meaning and should be given its dictionary definition, which is "suited by nature, character, or design to a particular use, purpose, or situation," *Webster's Third New Int'l Dictionary* 24 (1986), or "fitted; fit; suitable." *Oxford English Dictionary* 139 (2d ed.1989). Defendant does not offer a different definition for the term "adapted," and therefore appears to concede the term should be given the ordinary meaning Plaintiff has proffered.

The '102 Patent does not confer a specialized meaning to the term "adapted." Rather, it uses the term consistent with the dictionary definition set forth by Plaintiff. The Court therefore construes the term "adapted" to be: "suited by nature, character, or design to a particular use, purpose, or situation," or "fitted; fit; suitable."

B. "Secured"

Plaintiff argues the term "secured" does not have a specialized meaning and should be given its dictionary definition that is relevant to this context. Plaintiff argues the appropriate definition is "to make fast," "tie down," *Webster's Third New Int'l Dictionary* 2053 (1986), and "firmly fastened." *Oxford English Dictionary* 853 (2d ed.1989). Defendant's proposed construction is not materially different, and is "fastened or attached."

Like the term "adapted," the '102 Patent has not assigned a specialized meaning to the term "secured." Instead, Claim 1 uses the word in a manner consistent with common usage dictionary definitions presented by the parties. Accordingly, the Court construes the term "secured" as: "to make fast," "tie down," "firmly fastened," "fastened or attached."

C. "Adjacent"

The parties agree the dictionary definitions for the term "adjacent" are: "to lie near, border on, ... **1a:** not distant or far off <the city square and the ~ streets>: nearby but not touching, <the islands and the ~ mainland coast> b: relatively near and having nothing of the same kind intervening: having a common border: ABUTTING, TOUCHING: living nearby or sitting or standing relatively near or close together," *Webster's Third New Int'l Dictionary* 26 (1986), "lying near or close *(to);* adjoining; contiguous, bordering (Not necessarily *touching,* though this is by no means precluded)." *Oxford English Dictionary* 155 (2d

ed.1989). Defendant argues that proper construction of the term requires there be nothing intervening between the pivot means and the spa. Defendant's proposed definition of "adjacent" is "alongside or next to, without anything intervening" in the sense of immediately following with an absence of anything in between. Plaintiff responds nothing in the patent or its file wrapper impose such a limitation. The Court agrees with Plaintiff.

The '102 Patent discloses the pivot means may be located near the spa and not attached to the spa. Specifically, the patent teaches that when the device is installed at ground level, "the ground mounted pivot blocks 27 *may be mounted farther away from the spa 21* to even farther remove the folded cover from the proximity of the spa 21." ('102 Patent, col. 5, ll. 37-40) (emphasis added). This embodiment is depicted in Figure 10, which shows there is ground space between the pivot means and the spa. Id, Fig. 10. Thus, to interpret "adjacent" as "alongside or next to, without anything intervening" would exclude one of the preferred embodiments of the invention. "Such an interpretation is rarely, if ever, correct and would require highly persuasive evidentiary support." Vitronics, 90 F.3d at 1583. There is no evidence in the record to support such an interpretation. Thus, that the specification teaches an embodiment in which the "pair of pivot blocks 27 are attached to one of the side walls 23 of spa 21," ('102 Patent, col. 2, ll. 29-30), does not mandate the term "adjacent" be defined as suggested by Defendant. Limiting the definition of "adjacent" based on this embodiment would improperly incorporate limitations from one of the preferred embodiments into Claim 1 and contravene the prohibition against importing limitations from the specification into a patent's claims. *See* Innova/Pure Water, 381 F.3d at 1117 (stating that "particular embodiments appearing in the written description will not be used to limit claim language that has broader effect"); Karlin Tech. Inc. v. Surgical Dynamics, Inc., 177 F.3d 968, 973 (Fed.Cir.1999) ("The general rule, of course, is that the claims of a patent are not limited to the preferred embodiment, unless by their own language.").

The Court must also guided by the general rule that a claim term is defined consistently throughout the patent. *See* Georgia-Pacific Corp. v. U.S. Gypsum Co., 195 F.3d 1322, 1331 (Fed .Cir.1999) ("Unless the patent otherwise provides, a claim term cannot be given a different meaning in the various claims of the same patent."). The third element of Claim 1 provides for "an upper bridge arm connected to said second ends of said pair of pivoting supports, said upper bridge arm pivotable to a first position *adjacent* and parallel to said hinge of said spa cover when covering the spa and to a second position clear of said spa." ('102 Patent, col. 6, ll. 6-10) (emphasis added). According to Defendant, the term "adjacent" with respect to the third element of Claim 1 is used consistent with the meaning "alongside or next to, without anything intervening" and to interpret it otherwise would create functional problems with the language of Claim 1. In particular, Defendant maintains there would be a problem if there were a space between the upper bridge arm and the axis of fold because it would cause the spa cover to fall down on the upper bridge arm. The Court disagrees.

Defendant's suggestion that functional problems would result from a space between the upper bridge arm and the axis of fold is undermined by the specification, which teaches that in certain circumstances the upper bridge arm may not extend directly above the spa cover hinge. Rather, in certain circumstances, there may be space between the upper bridge arm and the axis of fold:

Cover 25 may or may not have an extended or flexible hinge to accommodate the diameter of upper bridge arm 32. If the hinged connection of the halves of cover 25 forms a sharp angle, *the upper bridge arm 32 may be made to fall somewhat short of a position directly over the hinge axis, but still parallel with it*. In such case, one half of the cover 25 will be foldable over the other half of the cover 25 but will not come to a rest against the other half, and will remain at an acute angle with respect to the other half.

('102 Patent, col. 2, l. 61 col. 3, l. 2) (emphasis added). To construe "adjacent" as precluding any space between the upper bridge arm and the axis of fold would impermissibly exclude that embodiment. *See* Vitronics, 90 F.3d at 1583.

Defendant next maintains that statements made by Roger Ouellette-one of the ' 102 Patent's co-inventors-while prosecuting a related patent confirms Defendant's definition of "adjacent." In particular, Mr. Ouellette stated the ' 102 Patent discloses a pair of lifting arms pivotally mounted along the back wall of a spa. (Redman Decl. para. 6 and Ex. 3, U.S. Patent No. 5,584,081 ("the '081 Patent") col. 1, ll. 22-25.) The later patent application Mr. Ouellette sought to distinguish from the '102 Patent disclosed an adjustable lifting device "having a pair of pivots mounted either in opposed side walls of a spa or in the deck adjacent to the side walls." (Redman Decl. Ex. 3, '081 Patent col. 2:4-6.) To support its argument, Defendant cites Jonsson iv. Stanley Works, 903 F.2d 812 (Fed.Cir.1990).

The Court is not persuaded Mr. Ouellette's statements during prosecution of his own patent affects the analysis of this limitation. "In the absence of an incorporation into the intrinsic evidence, [Federal Circuit] precedent takes a narrow view on when a related patent or its prosecution history is available to construe the claims of a patent at issue and draws a distinct line between patents that have a familial relationship and those that do not." Goldenberg v. Cytogen, Inc., 373 F.3d 1158, 1167 (Fed.Cir.2004). For example, in the case Defendant relies upon, the Federal Circuit used statements from one patent's prosecution history to construe the claims of another patent. Jonsson, 903 F.2d at 818. However, both patents shared a patent application. *Id*.

In contrast, in Abbott Laboratories v. Dey, L.P., 287 F.3d 1097 (Fed.Cir.2002), Abbott owned two patents-the '839 and '301 Patents. The inventor of the '839 Patent was one of the three inventors of the '301 Patent, but the '839 Patent application was not filed as a continuation, continuation-in-part, or divisional application of the '301 application. Abbott Labs., 287 F.3d at 1105. The applications had no formal relationship and were presented to the PTO as patentably distinct inventions. *Id*. Under those circumstances, the Federal Circuit concluded that statements made during the prosecution history of the '301 Patent did not create an estoppel with respect to the '839 Patent. *Id*.

As in *Abbott Laboratories,* although Mr. Ouellette is one of the inventors of the '102 Patent, there is no evidence his '081 Patent has a formal relationship with the '102 Patent. Further, unlike *Jonsson,* the '102 and '081 patents do not share a patent application. Accordingly, the Court finds Mr. Ouellette's statements do not inform the construction of Claim 1 of the '102 patent. *Cf*. Tex. Digital, 308 F.3d at 1211 (stating that an unrelated patent "sheds no light" on the claims in the patent at issue).

In summary, the Court finds the intrinsic evidence supports a broad definition of "adjacent" and defines the term as: "not distant," "near," "nearby" "close to," "border on," "adjoining," "abutting, touching," "contiguous."

D. "One Side of a Spa"

The parties dispute whether Claim 1's limitation "one side of a spa" requires the pivot means to be only on one side of a spa, or whether it allows for the pivot means to be on one or more sides of a spa. Defendant argues the phrase "one side of a spa" means "only one side," and prosecution disclaimer prohibits Plaintiff from contending the pivot means can be attached to more than one side of a spa. Plaintiff responds the

intrinsic evidence does not support Defendant's construction and that prosecution disclaimer is inapplicable.

The doctrine of prosecution disclaimer is "a fundamental precept" in claim construction jurisprudence and precludes "patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution." Omega Eng'g, 334 F.3d at 1323. "As a basic principle of claim interpretation, prosecution disclaimer promotes the public notice function of the intrinsic evidence and protects the public's reliance on definitive statements during prosecution." Id. at 1324. When "the patentee has unequivocally disavowed a certain meaning to obtain his patent, the doctrine of prosecution disclaimer attaches and narrows the ordinary meaning of the claim congruent with the scope of the surrender." *Id*. The standard for showing prosecution disclaimer is high. *N*. Am. Container, Inc. v. Plastipak Packaging, Inc., 415 F.3d 1335, 1345 (Fed.Cir.2005). In cases where the Federal Circuit has applied the doctrine, the prosecution history reveals specific statements by the patentee distinguishing the invention from prior art. *See, e.g., id*. (patent applicant distinguished his invention from another "on the basis of the [earlier patent] disclosing inner walls that are 'slightly concave.' The inescapable consequence of such an argument is that the scope of the applicant's claims cannot cover inner walls that are 'slightly concave.' "); Rheox, Inc. v. Entact, Inc., 276 F.3d 1319, 1325-27 (Fed.Cir.2002) (applying prosecution disclaimer because the prosecution history demonstrated the patent applicant had deleted all references to a compound and explained it did so to distinguish prior art). In contrast, the Federal Circuit has "declined to apply the doctrine of prosecution disclaimer where the alleged disavowal of claim scope is ambiguous." Omega Eng'g, 334 F.3d at 1324; *see, e.g.,* Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1347 (Fed.Cir.2001) (refusing to apply prosecution disclaimer because the file wrapper was inconclusive); *N*. Telecom Ltd. v. Samsung Elecs., Co., 215 F.3d 1281, 1293-95 (Fed.Cir.2000) (finding inventors' remarks amenable to multiple reasonable interpretations and therefore were "far too slender a reed to support the judicial narrowing of a clear claim term").

The application that led to the '102 Patent was filed on June 17, 1991. In relevant part, Claim 1 of the '102 Patent application read:

A spa cover lift removal and support assembly for a hinged spa cover comprising:

pivot means, having a common pivot axis for facilitating pivoting about a common axis;

a pair of pivoting supports, each having a first end pivotally attached to one of said pivot means, and each having a second end;

an upper bridge arm connected between said second ends of said pair of pivoting supports, said upper bridge arm pivotable to a first position adjacent and parallel to a hinge in a spa cover and a second position clear of said spa.

(Redmann Decl. Ex. 2, '102 Patent file wrapper at DIMI 0000028.)

Because patent applications are reviewed in the order they are received, there is a long delay before an examiner first reviews an application, and because Plaintiff was in the midst of negotiations to license the invention covered by the '102 Patent application, Plaintiff filed a petition to make special. (Redmann Decl. Ex 2, '102 Patent file wrapper at DIMI 0000048-52.) Having determined Plaintiff met the criteria, the PTO granted the petition to make special on November 18, 1991 and reviewed the application out of turn. Id. at DIMI 0000058-59.

On December 11, 1991, PTO Examiner Keith Kupferschmid conducted a telephonic interview with the inventors' attorney, Greg Lane. Id. at DIMI 0000065. The Examiner Interview Summary Record indicates the parties discussed all of the claims, and reached an agreement regarding all of the amendments. Id. This conversation was memorialized in the Examiner's description: "Examiner proposed language to the claims to put the case in condition for allowance by more definitely claiming the invention without restricting the claims. Applicants Representative authorized these changes via Examiner's amendment." Id. The amendments added the following underlined language and deleted the struck-out text:

1. A spa cover lift removal and support assembly for a hinged spa cover *which covers the top of a spa and includes at least two cover sections connected by a hinge whereby said sections are foldable in overlapping relation* comprising *a pair of pivoting supports:*

pivot means, *adapted to be secured adjacent one side of a spa, and* having a common pivot axis for facilitating pivoting *said pair* of about a *said* common pivoting axis;

each pivoting support *s* having a first end pivotally attached to said pivot means *to pivot about said common axis,* and each having a second end;

an upper bridge arm connected *to* said second ends of said pair of pivoting supports, said upper bridge arm pivotable to a first position adjacent and parallel to *said* hinge *of said* spa cover *when covering said spa* and *to* a second position clear of said spa *whereby said cover sections are folded over said upper bridge arm and said upper bridge arm is pivoted to said second position to remove said cover from said spa and support said cover to one side of said spa*.

See id. at DIMI 0000028, 0000061.

On December 12, 1991, the PTO issued a Notice of Allowability. Id. at DIMI 0000060. The Examiner's statement of reasons for allowance was that:

none of the prior art references of record alone or in combination teach applicant's invention of a spa lift cover having a pair of pivoting supports, a pivot means, and an upper bridge arm as claimed whereby the bridge arm is pivoted between two positions to remove the spa cover from the spa. Additionally, the examiner points out that the claim language in claim 1, that the cover is supported "to one side of said spa" and that the pivot means is "secured adjacent to one side of a spa" covers all of the embodiments shown including figures 4 and 10 where the spa is underground.

Id. at DIMI 0000062.

After issuing the Notice of Allowability, the PTO became aware of United States Patent No. 5,048,153 ("the Wall Patent"). On February 2, 1992, the PTO issued a Second Notice of Allowability, and gave the reasons for allowance as:

The Wall et al. reference alone or in combination with any of the prior art references of record does not teach applicant's invention of a spa cover because the Wall reference does not include a bridge member such that the cover is folded over the bridge arm.

Id. at DIMI 0000066-67. The '102 Patent issued on July 21, 1992. A few months thereafter, the inventors

found a few errors and requested a Certificate of Correction FN5 that was granted.

FN5. A Certificate of Correction is offered by the PTO to correct minor errors in an already issued U.S. Patent:

Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Director may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

35 U.S.C. s. 255.

Defendant argues that by agreeing to the amendments proposed by the Examiner, the inventors adopted all of the reasons for allowability set forth by the Examiner. According to Defendant, because of the disclosures in the Wall Patent and other prior art references, the Examiner determined that the scope of the patentable invention of the '102 Patent was narrower than originally claimed, and so limited the invention in his amendments. Plaintiff responds the Examiner's amendments had no restrictive effect on the originally-filed claims, but instead broadened them.

The Court does not find the doctrine of prosecution disclaimer restricts the term "one side of a spa." That doctrine applies only when "the patentee has unequivocally disavowed a certain meaning to obtain his patent." Omega Eng'g, 334 F.3d at 1324. Such an unmistakable disavowal of the possibility that the pivot means spans more than one side of a spa is absent from the record. The notes in the Examiner's Interview Record Summary do not memorialize any discussion regarding what the prior art teaches regarding the location of the pivot means and how the '102 Patent invention is different from that prior art. The Examiner's statement that the proposed language "more definitively claim[ed] the invention" therefore does not lend itself to the inference that the amendments clearly disavowed any particular subject matter. *Cf.* id. at 1331 (holding there was no disavowal of claim scope in part because "mere statements '[r]esponsive to numerous telephone communications with the Examiner' and 'to clearly define the invention of the prior art' did not disclaim subject matter," and "[t]o conclude otherwise would require an ungrounded leap of logic"). Because the alleged disavowal of claim scope is ambiguous, the Court declines to apply the doctrine of prosecution disclaimer to restrict the construction of the patent.

The Court therefore finds the claim does not limit the pivot means to only one side of a spa.

III. " *A Pair of Pivoting Supports* "

Plaintiff contends the phrase "a pair of pivoting supports" should be afforded the full scope of its ordinary meaning. Defendant, in contrast, maintains the Court should construe the phrase "a pair of pivoting supports" to mean "a pair of pivotal lifting arms or side members that are straight or, for a non-rectangular spa, follow the shape of the spa." In support for its definition, Defendant maintains that in each embodiment of the invention as described and depicted in the drawings, the pivot supports are straight members or follow the shape of the spa. Thus, according to Defendant, the phrase cannot be construed to encompass side members that bend.

Defendant owns a patent for a spa cover lift device that is disclosed in U.S. Patent No. 5,974,599 ("the '599 Patent"). (Redmann Decl. para. 7 and Ex. 4, the '599 Patent and file wrapper). Defendant argues its '599 patent displaces the pivot axis of the side members away from the side of the spa on which the cover is stored, and toward the center of the spa. Through bending of the side members, the pivot axis is shifted thereby improving the travel to lift ratio and easing the task of lifting a cover. Defendant argues that under the doctrine of separate patentability, the "pivot supports" disclosed in Plaintiff's '102 Patent are substantially different structures from the bending side members disclosed in the '599 Patent. Thus, the term "pivoting supports" in Plaintiff's patent should not be construed to include side members that are bent such that the bend enhances the ratio of horizontal movement of the crossmember relative to the vertical displacement when removing the cover. Otherwise, Defendant's '599 Patent would effectively be invalid based on obviousness. Defendant also submits the declarations of two experts-Dr. Vijay Gupta and Michael Gellner-to argue that because the '599 Patent issued, the construction of the "pair of pivoting supports" clause should be narrow.

The Court is not persuaded the pivoting supports must be straight or follow the shape of the spa. The only limitations on the pivoting supports imposed by the claim language and specification is that they be pivotally attached to the pivot means and connected to the upper bridge arm. ('102 Patent, col. 6, ll. 3-4 ("each pivoting support having a first end pivotally attached to said pivot means"); id. col. 6, ll. 6-7 ("an upper bridge arm connected to said second ends of said pair of pivoting supports.") Claim 1 does not specify nor impose any limitations on the shape of the pivoting supports; *i.e.,* the claim does not preclude the pivoting supports from having a bend. Nor does the specification or the prosecution history impose such a limitation on the shape of the pivoting supports. Although the pivoting supports in the preferred embodiments are straight in the case of a rectangularly-shaped spa, (*e.g.,* '102 Patent, col. 2, ll. 42-43; id. Fig. 1), and follow the shape of a spa in a non-rectangularly-shaped spa, (id. Fig. 11.), limiting the pivoting supports to those shapes would violate the rule against importing limitations from the specification into a patent's claims. *See* Innova/Pure, 381 F.3d at 1117 (stating that "particular embodiments appearing in the written description will not be used to limit claim language that has broader effect"); Karlin, 177 F.3d at 973 ("The general rule, of course, is that the claims of a patent are not limited to the preferred embodiment, unless by their own language."). Further, the prosecution history does not indicate the pivoting supports are so limited. There is no exchange between the Examiner and the patent applicants indicating the pivoting supports must be straight or follow the shape of the spa in order to avoid prior art.

The Court also does not find the prosecution history of Defendant's ' 599 Patent compels Defendant's proposed construction. At this juncture of the proceedings, the doctrine of separate patentability is inapplicable. That doctrine is relevant to the issue of infringement.FN6 *See, e.g.,* Zygo Corp. v. Wyko Corp., 79 F.3d 1563, 1570 (Fed.Cir.1996) (applying the doctrine of separate patentability when analyzing infringement under the doctrine of equivalents). Accordingly, the Court finds the issuance of the ' 599 Patent and the expert declarations discussing that patent irrelevant to construction of the term.

FN6. The Court further notes that while the existence of a patent issued over an asserted patent is relevant to infringement, it is not dispositive. *See* Nat'l Presto Indus., Inc. v. West Bend Co., 76 F.3d 1185, 1191-92 (Fed.Cir.1996) ("Improvements of modifications may indeed be separately patentable if the requirements of patentability are met, yet the device may or may not avoid infringement of the prior patent."); Water Techs. Corp. v. Calco, Ltd., 850 F.2d 660, 669 (Fed.Cir.1988) ("[I]t is elementary patent law that a patent may issue on an improvement which infringes another's patent.").

Having reviewed the patent, the Court finds the proper construction of the term "a pair of pivoting supports" is that they are: "a pair of side members or pivotal lifting arms that have one end pivotally attached to the pivot means, and the other end connected to the upper bridge arm."

IV. " *Upper Bridge Arm* "

The dispute between the parties regarding the term "upper bridge arm" is two-fold. First, the parties contest whether the upper bridge arm must be directly attached to the pivoting supports. Second, the parties disagree on whether the upper bridge arm must be external to the spa cover.

A. Whether the Upper Bridge Arm Must be Directly Attached to the Pivoting Supports

Regarding the first dispute, Claim 1 states the upper bridge arm is "connected to" the second ends of the pair of pivoting supports. ('102 Patent, col. 6, ll. 6-7.) The claim language does not specify whether the connection must be direct or indirect. The specification, however, indicates this connection may be indirect. In one of the preferred embodiments, the upper bridge arm is not directly connected to the pivoting supports. Rather, the upper bridge arm is attached to a pair of upper corner bars which are themselves attached to the pivoting supports. Id. col. 2, ll. 32-47. Requiring the upper bridge arm to be directly attached to the pivoting supports would read out one of the preferred embodiments of the claim. Such an interpretation can only be correct if there is persuasive evidentiary support. *See* Vitronics, 90 F.3d at 1583 (stating that an interpretation reading out preferred embodiments "is rarely, if ever, correct and would require highly persuasive evidentiary support").

The evidence Defendant presents in support of its argument is from the prosecution history. The original claim 1 limitation regarding the upper bridge arm stated: "an upper bridge arm connected *between* said second ends of said pair of pivoting supports." This language implied that the upper bridge arm could be non-continuous, or otherwise located between the pivoting supports without actually connecting to the pivoting supports. That limitation was amended to read "an upper bridge arm connected to said second ends of said pair of pivoting supports." The change in the wording from between to "connected to," however, does not mandate the upper bridge arm be directly attached to the pivoting supports. The relevant ordinary and plain meaning of the term "connect" is: "1: to join, fasten, or link together usu. by means of something intervening," "join, unite." *Webster's Third New Int'l Dictionary* 480 (1986). These definitions do not require a direct attachment. In light of the absence of any exchange between the Examiner and the patentees indicating the upper bridge arm must be directly attached to the pivoting supports, and the preferred embodiment demonstrating an indirect connection, the Court finds the full dictionary definition of "connected" is applicable and allows for the upper bridge arm to be either directly or indirectly attached to the pivoting supports.

B. Whether the Upper Bridge Arm Must be External to the Spa Cover

The parties also dispute whether the upper bridge arm must be external to the spa cover. Defendant maintains the upper bridge arm is an external extension that lies outside the spa cover of the '102 Patent, and extends over the spa cover on its outside. Plaintiff disagrees, arguing that nothing in the claim's language requires the upper bridge arm to be outside of the spa cover. The Court concurs with Defendant's construction.

Claim 1 states the upper bridge arm is "pivotable to a first position adjacent and parallel to said hinge of

said spa cover when covering said spa and to a second position clear of said spa." ('102 Patent, col. 6, ll. 7-10.) In other words, the upper bridge arm is lowered and rests on and parallel to the hinge in a first position, and then pivots to a second position away from the spa. To do this, the upper bridge arm must be external.

This construction is supported by the specification. The "Summary of Invention" describes the invention as a whole, and therefore is more likely to be a limitation on the claim. C.R. Bard, Inc. v. U.S. Surgical Corp., 388 F.3d 858, 864 (Fed.Cir.2004). The Summary of the Invention of the '102 Patent states in relevant part:

The utilization of the inventive mechanism does not involve the denigration of the cover integrity. A bridge arm is brought down to a place adjacent the spa cover. The spa cover is folded over the bridge arm, and the bridge arm is then pivoted away from the spa, thus removing the spa cover.

('102 Patent, col. 2, ll. 39-44.) These statements support the limitation that the upper bridge arm be external. As discussed above regarding the language of Claim 1, for a bridge arm to be brought down and placed on the spa cover, it must be external. Second, the statement regarding denigration of the cover further supports a finding the upper bridge arm is external. As explained by Plaintiff in its opening claim construction brief, denigration of the spa cover occurs when the spa cover lift penetrates the spa cover with mounting prongs and thereby exposes the foam insulating material of the spa cover to the high-humidity, high-heat, and caustic chlorine/bromine vapor environment of a spa. (Pl.'s Memo. of P's & A's In Supp. of Claim Construction at 10.) Plaintiff's opening brief went on to explain the novelty of the '102 Patent is that its "inventors replaced the attachment prongs of the Wall Lift with an upper bridge arm.... They recognized that the upper bridge arm of their spa cover lift eliminated the need to physically attach the spa cover lift to the foam core of the spa cover." Id . at 11.

The Court also finds construction of the upper bridge arm as an external member does not impermissibly leave out preferred embodiments of the invention. All of the embodiments disclosed require the upper bridge arm to be external. For example, the specification explains that "[t]he upper bridge arm 32 may be pivoted up and away from the upper surface of the cover 25," ('102 Patent, col. 2, ll. 48-49), "[t]he upper bridge arm 32 is pivoted into contact or proximity with the folding axis of the cover 25." Id., col. 3, ll. 22-24. That the upper bridge arm is pivoted " *into contact or proximity* " of the cover and also *away* from the cover requires it to be external to the cover. The description of one of the preferred embodiment further explains that once the cover is put back on top of the spa, "the user may leave the pivoting support 33 in place or may swing it back to its vertical position for out-of-the-way storage." Id. col. 3, ll. 58-61. Because the pivoting supports are attached to the upper bridge arm, id., col. 6, ll. 6-7, when the pivoting supports are swung back to their vertical position away from the cover, the upper bridge arm also is pivoted back away from the cover. Thus, the upper bridge arm is external in that embodiment.

Finally, the Court agrees with Defendant that the prosecution history supports the limitation requiring the external bridge arm to be external. As discussed by Plaintiff in its opening claim construction brief, the Wall Patent requires the cover lift device to be physically attached to the spa cover. (Miller Decl. Ex. 4, Wall Patent, col. 5, ll. 36-38.) In the Second Notice of Allowability, the Examiner noted "[t]he Wall et al. reference alone or in combination with any of the prior art references of record does not teach applicant's invention of a spa cover because the Wall reference does not include a bridge member such that the cover is folded over the bridge arm." (Redmann Decl. Ex. 2, '102 Patent file wrapper at DIMI 0000067.) The Examiner's specific finding the upper bridge arm is distinguishable from the Wall Patent is further indication that structure must be external to the spa cover.

C. Construction of the Element

For the reasons set forth above, the Court finds the proper construction of "upper bridge arm" to be: "A cross member or arm that spans the cover of the spa and is either directly or indirectly attached to the second ends of the pivoting supports. The upper bridge arm is external to the spa cover."

V. *Patent's Preamble*

The parties dispute whether the patent's preamble requires the spa cover to have at least two cover sections. " 'Whether to treat a preamble as a limitation is a determination resolved only on review of the entire [ ] ... patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.' " Poly-Am., L.P. v. GSE Lining Tech., Inc., 383 F.3d 1303, 1309 (Fed.Cir.2004) (quoting Corning Glass Works, 868 F.2d at 1257) (alteration in *Poly-Am.*). There is no litmus test for determining when a preamble limits the invention. Poly-Am., 383 F.3d at 1309; Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 808 (Fed.Cir.2002). There are, however, some general guidelines. The preamble limits the claims when it "recites essential structure or steps, or if it is 'necessary to give life, meaning, and vitality' to the claim." Catalina Mktg., 289 F.3d at 808 (quoting Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305 (Fed.Cir.1999)); *accord* Poly-Am., 383 F.3d at 1309. But the preamble does not limit when the " 'patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.' " Poly-Am., 383 F.3d at 1310 (quoting Rowe v. Dror, 112 F.3d 473, 478 (Fed.Cir.1997)). Only when the patentee clearly relies on the preamble "during prosecution to distinguish the claimed invention from the prior art" does the preamble transform into a limitation "because such reliance indicates use of the preamble to define, in part, the claimed invention." Catalina Mktg., 289 F.3d at 808.

Defendant argues the '102 Patent's prosecution history establishes the preamble limits Claim 1. The original patent application recited in the preamble "A spa cover lift removal and support assembly for a hinged spa cover comprising:" (Redmann Decl. Ex. 2, '102 Patent and file wrapper at DIMI 0000028.) This was changed to "A spa cover lift removal and support assembly for a hinged spa cover which covers the top of a spa and includes at least two cover sections connected by a hinge whereby said sections are foldable in overlapping relation comprising:" ('102 Patent, col. 5, ll. 60-64.) Defendant argues this structural limitation is part of the claimed invention of Claim 1. The Court disagrees.

The prosecution history of the '102 Patent does not reveal a clear an unmistakable reliance by the part of the inventors on the requirement that the spa cover have at least two cover sections. The Examiner did not raise, nor did the inventors discuss, the necessity of distinguishing prior art by requiring the invention to be used only with spa covers having at least to cover sections. Accordingly, the prosecution history does not mandate such a limitation.

Further, it is not essential to import that limitation to understand Claim 1. The specification teaches that the spa cover does not have be at least two cover sections. For example, the specification states, "[t]he spa covers with which the support assembly and method of the present invention are utilizable may vary, but the present invention works well with two piece foldable covers." ('102 Patent, col. 2, ll. 15-19.) In describing one of the preferred embodiments, the patent explains that "[t]ypically the cover 25 will be of the two-piece foldable type." Id. col. 2, ll. 49-50. The use of the term "typically" indicates the invention may be used with a different type of spa cover.

Accordingly, the Court concludes the preamble does not require the spa cover to have at least two cover

sections.

CONCLUSION

For the foregoing reasons, the disputed terms are interpreted as set forth in this order.

IT IS SO ORDERED.

S.D.Cal.,2005.
Dimension One Spas, Inc. v. Coverplay, Inc.

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