United States District Court,
C.D. California.

WINN, INC,
v.
COMPGRIP USA CORP.

No. SA CV 06 66 VBF MLGX

April 23, 2007.

Darrell L. Olson, Lynda J. Zadra-Symes, Paul A. Stewart, Sean M. Murray, Knobbe Martens Olson & Bear, Irvine, CA, for Plaintiffs.

Steve T. Tsai, Steve T. Tsai Law Offices, Irvine, CA, for Defendant.

CIVIL MINUTES-GENERAL

FAIRBANK**, J.**

Rita Sanchez	None Present
Courtroom Deputy	Court Reporter

ATTORNEYS PRESENT FOR PLAINTIFFS:	ATTORNEYS PRESENT FOR DEFENDANTS:
None Present	None Present

PROCEEDINGS (IN CHAMBERS):	ORDER ON PLAINTIFFS' MOTION FOR [PARTIAL] SUMMARY JUDGMENT

After reading Plaintiffs' Motion for [Partial] Summary Judgment, the Opposition and Reply papers, and after considering counsels' oral arguments at the hearing on 4/23/07, the Court hereby GRANTS Plaintiffs' Motion pursuant to the grounds set forth in the Moving Party Plaintiffs' papers. The Court finds that Plaintiffs have met their burden of establishing that Compgrip's MF5 golf grips infringe Claim 1 of U.S. Patent No. 6,857,971 ("the '971 Patent"). Fed. R. Civ. Proc. Rule 56(d). The moving party has established that every limitation of the asserted patent claim is in the accused device.

Plaintiffs' [Proposed] Statement of Uncontroverted Facts and Conclusions of Law is supported by competent evidence demonstrating that they are entitled to summary judgment as a matter of law. Defendants do not present any facts or evidence that create a triable issue.

On April 9, 2007, Defendants filed a Supplemental Memorandum of Points & Authorities in Opposition to Plaintiffs' Motion for Summary Judgment. Procedurally, this Supplemental Opposition is not proper and is untimely. Nevertheless, the Court has read and considered the Supplemental Opposition. It does not change the Court's tentative ruling. On page 2 n. 3 of the Supplemental Opposition, Defendants also ask the Court to *sua sponte* grant summary judgment in Defendants' favor. This request is procedurally and substantively without merit and is denied for reasons set forth in this tentative order.

I. *Claim Construction*

Defendant Compgrip's non-infringement arguments are based on four claim construction contentions that are incorrect as a matter of law. The first dispute pertains to the limitation: "a polyurethane outside layer bonded to a felt inside layer." (Ex. 2, at 8:6-7.) Defendants assert that this language should be construed to prohibit the presence of any polyurethane within the felt layer. (Opp., at 11:5-15.) As Plaintiffs respond, Defendants' contention is completely unsupported and without merit. (*See* Reply, at 6:4-21 and the evidence set forth therein, as well as the discussion below.)

A. "*Felt*"

Defendants' proposed construction of the term "felt" is also wrong as a matter of law. (*See* Reply, at 6:22-12:5.) There is nothing in the language of Claim 1 or the patent's specification to suggest a particularized definition of "felt" that differs from the term's ordinary meaning, as follows: a fabric made directly from fibers, in which the fibers are held together through the physical entanglement of the fibers, chemical bonding, or thermal bonding, rather than through knitting or weaving. (*See* Ex. 2; Ex. 19 [Fairchild's Dictionary of Textiles]; Ex. 20 [Dictionary of Fiber & Textile Technology published by KOSA]; Ex. 21 [Textile Institute's Textile Terms & Definitions]; Ex. 22 [American Society for Testing Materials]; Ex. 23 [IWDA Nonwovens Glossary]; Ex. 24 [Needlepunch Nonwoven Primer].) FN1

FN1. For purposes of construing the disputed terms of Claim 1 of the '971 Patent, the Court has avoided reliance upon expert declarations in light of the following legal principle: it is "only when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence," that a trial court may resort to "extrinsic evidence" to further elucidate the claims' meanings. Bell & Howell Doc. Management Products Co. v. Altek Systems, 132 F.3d 701, 706 (Fed.Cir.1997). Such extrinsic evidence is that evidence which is external to the patent such as expert testimony. Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1584 (Fed.Cir.1996). In the instant case, the disputed claim term language (i . e. felt, adhere, etc.) is not ambiguous from viewing the claim itself and the specification. This finding is further supported by reference to dictionaries.

Defendants' contention that a felt requires roughly equal numbers of fibers pointing in all directions, and that it be of roughly equal strength in all directions, lacks support and is without merit. Defendants rely on a single source, the website of Resil Chemicals Private Limited of Bangalore India. (Ex. 53, at 9, 29; Ex. 30, at 2.) As Plaintiffs assert, the definition provided on the Resil website refers specifically to wool felts. Moreover, the definition on which Defendants rely specifically states that the fibers of a felt are "non-directional," i.e. the fibers point in all directions. (Ex. 30, at 2.) A reading of the definition nowhere requires an *equal number* or approximately equal number of fibers to point in all directions. Instead, the language makes specific reference to *some* fibers pointing in all directions. (Ex. 30, at 2.) Moreover, none of the six technical dictionary definitions on which Plaintiffs rely require that the fibers in felt point in roughly equal

numbers in all directions (Exs.19-24); and Defendants do not challenge any of the dictionary sources relied on by Plaintiffs.

Defendants also assert that felt that has been saturated in polyurethane is no longer felt. (Ex. 51, at 107:15-25.) However, none of the definitions of felt provided by either party include any restriction on the materials that may be incorporated among the fibers of a felt. (*See* Exs. 19-24, 30.) To the contrary, the source dictionaries relied on by Plaintiffs explain that felt may include binders among the fibers to both bind the fibers and increase the strength of the felt. (Exs.19, 23, 24.) Moreover, none of the intrinsic or extrinsic evidence excludes as felt materials that have been saturated in polyurethane or other materials. In fact, both parties agree that felt saturated in asphalt is still felt. (Vaughn Decl. para.para. 6, 36-41; Exs. 19-24, 31; Ex. 51, Meirowitz Depo., at 107:7-15; 108:23-109:7.)

The '971 Patent does not suggest a particularized definition of felt that differs from the term's ordinary meaning. The patent does not, for example, require or even suggest that a felt must have a roughly equal number of fibers oriented in all directions. (Ex. 2.) The patent also does not suggest that a felt may *not* be saturated in another material, such as polyurethane. (Ex. 2.) Defendants attempt to limit the construction of the term "felt" in ways that do not comport with either the intrinsic or extrinsic evidence. Accordingly, the Court adopts the standard and widely accepted industry definitions that provide for a general construction of felt as a fabric made directly from fibers without weaving or knitting; and the Court construes the term without limitations on fiber number, orientation, or incorporation with other materials, as neither the intrinsic nor extrinsic evidence support such constructions.

B. "*Adhere*"

The '971 Patent does not give the term "adhere" a special meaning. As Plaintiffs assert, the term should be given its ordinary meaning. Ormco Corp. v. Align Tech., Inc., 463 F.3d 1299, 1306 (Fed.Cir.2006); Atofina v. Great Lakes Chem. Corp., 441 F.3d 991, 996 (Fed.Cir.2006). The ordinary meaning of adhere is: "to hold fast or stick by or as if by gluing, suction, grasping, or fusing." (Ex. 54 to Stewart's Decl. [citing Webster's Third New Int'l Dictionary]; *see also* Ex. 55 [citing Hackh's Chemical dictionary].)

Defendants assert that the term "adhere" requires a particular degree of strength of attachment and requires an adhesive substance that bonds more strongly with the items adhered together than it does with itself. Specifically, Defendants allege that the MF5 grip fails to "adhere" the grip's anti-slip sheet to its rubber sleeve for two reasons: (1) its adhesive does not create a strong enough bond between the panel and the sleeve to satisfy the "adhered to" limitation (Ex. 52, Meirowitz Expert Report, at 10); and (2) "adhesive" must bond to the sleeve and the panel more strongly than it does to itself, so that when the panel is pulled apart from the sleeve, adhesive material remains attached to both components. (Ex. 51, Meirowitz Depo., at 70:10-75:25.)

An examination of the Patent itself demonstrates that there is no basis for limiting the term "adhere" in the ways suggested by Defendants. Defendants fail to provide support for reading the term to include the limitations they advocate. Moreover, none of the definitions provided contain a requirement relating to the strength of the bond or the disposition of the adhesive after the bond is broken. There is also no requirement within the term that an adhesive be used to adhere the panel and sleeve together. To the contrary, the Webster's Third New International Dictionary allows for adhesion by means not only of sticking and gluing, but also of suction, grasping, or fusing. (Ex. 54.) In other words, the term "adhere" does not require any particular adhesive, or any adhesive at all; if the component parts are attached to one another, they are

adhered to one another.

The '971 Patent never gives the term "adhere" a special meaning, and it is therefore appropriate to rely on the dictionary to determine the ordinary meaning of the term. Ormco, 463 F.3d at 1306; Atofina, 441 F.3d at 996. Both standard and technical dictionaries indicate that items are adhered if they are held together. (*See* Exs. 54-55.) Because nothing in the intrinsic evidence or ordinary meaning of the term "adhere" limits the terms in the manner Defendants suggest, their attempt to import these limitations into Claim 1 is improper. *See Phillips,* 415 F.3d at 1323 (warning against importing limitations without justification); Hoganas AB v. Dresser Indus., 9 F.3d 948, 950 (Fed.Cir.1993) (disapproving the importation of "extraneous" limitations).

C. *Adhesive*

Defendants set forth two arguments with respect to the construction of the final element of Claim 1 (i.e. "with the side edges of the panel abutting one another and being adhered together to define a longitudinal seam extending from the interior surface of the panel to the exterior surface of the polyurethane layer"). First, they allege that the adhesive must extend from the interior surface of the panel to the exterior surface of the polyurethane layer absent any air gaps. Second, Defendants urge that the only permissible adhesive is one composed of polychloroprene and toluene. (Def. Opp., at 13-14; Ex. 2, at 6:18-39.)

Defendants' construction errs in three respects. First, the phrase "extending from the interior surface of the panel to the exterior surface of the polyurethane layer" modifies the word "seam," not "adhered." Thus, the Court adopts Plaintiffs' construction that while the seam in the panel must extend from the panel's inner surface to its outer surface, the claim does not require that the side edges be adhered at all points along the seam. (Pl. MSJ, at 24.) Second, Plaintiffs contend, and Defendants do not dispute, that the specification of the '971 Patent contemplates the presence of air gaps in the panel's seam. (Pl. MSJ, at 24.) Third, the form of adhesive referenced in the preferred embodiment of the '971 Patent is not exclusive to polychloroprene and toluene because it is the claims of the patent, not the specification, that are the measure of the invention. SRI Int'l v. Matsushita Elec. Corp. of America, 775 F.2d 1107, 1121 (Fed.Cir.1985).

Defendants' argument that the side panels be adhered without air gaps is, according to Plaintiffs, inconsistent with the specification of the '971 Patent. (Pl. MSJ, at 24.) The preferred embodiment described in the specification of the '971 Patent contemplates the use of an adhesive composed of polychloroprene and toluene. (Ex. 2, at 6:18-39.) Plaintiffs assert that one of skill in the art would understand that this composition is a solvent-based adhesive that, once hardened, typically contains air gaps that correspond to the evaporated solvent. (Pl. MSJ, at 24.) Defendants do not dispute this assertion. Accordingly, the polychloroprene-toluene adhesive expressly included in the patent's embodiment considers and provides for the presence of air gaps in the seam. Because Defendants' construction of Claim 1 would preclude air gaps, it would prevent the claim from covering the patent's preferred embodiment, constituting an inaccurate construction. *See* MBQ Labs., Inc. v. Becton, Dickinson & Co., 474 F.3d 1323, 1333 (Fed.Cir.2007) (holding that a claim construction that excludes the preferred embodiment "is rarely, if ever, correct").

Compgrip erroneously asserts that the term "adhered" requires the exclusive use of a polychloropene-toluene adhesive because that chemical combination is expressly referenced in the preferred embodiment of the '971 Patent's specification. (Def. Opp., at 13-14.) Relying on the ordinary meaning of "adhere," discussed above, two materials are adhered if they "hold fast or stick by as if by gluing, suction, grasping or fusing," (Ex. 54), or if they are "attached to or stick to another substance." (Ex. 55.) The ordinary meaning does not require adhesion solely by way of a polychloroprene-toluene chemical compound. Defendants

assert that Claim 1 should be construed to refer only to this type of adhesive because "no other adhesive is disclosed" in the '971 Patent. (Def. Opp., at 13.) Yet this argument has been expressly disregarded by the Federal Circuit:

Our precedent has emphasized that the disclosure in the written description of a single embodiment does not limit the claimed invention to the features described in the disclosed embodiment.

Gemstar-TV Guide Int'l, Inc. v. ITC, 383 F.3d 1352, 1366 (Fed.Cir.2004) (citing Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 906 (Fed.Cir.2004)). The argument has also been disregarded by the United States Supreme Court:

The specifications ... show a way of using the inventor's method and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention.

Smith v. Snow, 294 U.S. 1, 11, 55 S.Ct. 279, 79 L.Ed. 721 (1935). Accordingly, the term "adhered to" should not be limited in the ways Defendants suggest. A reading of the Patent's specification makes clear that "adhered to" should be construed to include the use of an adhesive that contains air gaps, and should not, as a matter of law, be limited solely to the type of adhesive disclosed in the '971 Patent's embodiment.

II. ***The MF5 Compared to the Elements of Claim 1***

Following the Court's construction of Claim 1, the next step in the Court's infringement analysis is to compare each element of Claim 1 to the MF5 golf grip.

A. "***a resilient underlisting sleeve that is telescopically slipped onto the handle of a golf club;***"

The '971 Patent describes a "resilient underlisting sleeve" as a tube made of rubber, plastic, or another resilient substance. (Ex. 2, at 5:66-6:1.) Compgrip does not dispute that its grips include this element of Claim 1. To the contrary, Compgrip admits that its grips include "a flexible rubber-like inner tube (sleeve body)" that can be "mounted over a rod." (Ex. 44, at 7:9-12.) Moreover, visual inspection of the MF5 grip reveals that the grip has a rubber sleeve beneath the grip panel and that the rubber sleeve is configured to be slipped onto the handle of a golf club. (*see* Pl. Lodged Ex. 57.)

B. "***a single layer panel that includes a polyurethane outside layer bonded to a felt inside layer, such panel having a configuration corresponding to the exterior shape of the resilient sleeve;***"

Compgrip does not dispute that the MF5 includes "a single panel ... having a configuration corresponding to the exterior shape of the resilient underlisting sleeve." What Defendants do dispute, is the presence of a felt inside layer. (Def. Opp., at 11.) Specifically, Defendants contend that (1) the MF5's composite inner layer has a polyurethane matrix throughout, and that Claim 1 specifically excludes this; and (2) the micro-fiber composite used to make the MF5's inside layer is not felt. (Def. Opp. at 11.)

Defendants' first argument is dispensed with following this Court's construction of the term felt. As the intrinsic evidence makes clear, the '971 Patent places no restrictions on the types of materials and/or fibers that can be embedded together to create the felt. (*See* Ex. 2.) Moreover, none of the extrinsic evidence provided by either party includes restrictions on the materials that may be incorporated among the fibers of a felt. (*See* Exs. 19-24, 30.) Thus, following this Court's construction of the term "felt," Defendants'

contention that the MF5's inner layer is not felt because it is combined with a polyurethane binder is without merit.

Defendants' second argument is contradicted by the evidence. Defendants urge that the inner layer starting material of the MF5 is roving, not felt. (Ex. 53, Meirowitz Rebuttal Report, at 3.) However, a substantial portion of the evidence cited by Defendants does not support the argument that the inner layer material is not felt. Rather, the evidence attempts to distinguish the MF5's inner layer material from felt based on length and strength attributes. (Def. Statement Genuine Issues No. 7.) These attributes are not provided for in the Claim itself, the specification, or any other intrinsic or extrinsic evidence. Moreover, these attributes are not otherwise supported by the ordinary definition of felt. What is more, Compgrip's own website at one time expressly described the MF5's inner layer as felt. (Ex. 42 to Stewart Decl. [pages of Compgrip's website printed 7/28/06].) Compgrip has since removed these pages from its website. (Stewart Decl. para. 2.)

Additionally, Plaintiffs conducted several tests, all of which revealed that the fibers of the inner layer of the MF5 are neither woven nor knitted; instead the fibers are entangled together without any discernable pattern, and thus in accordance with the ordinary definition of the term "felt." (Stenmark Decl. para.para. 7-19; Vaughn Decl. para.para. 45, 49, and attached exhibit 32, at 1.) Though Defendants' expert disputed the means by which Plaintiffs conducted their initial tests (Ex. 53, at 2), Plaintiffs conducted subsequent tests that responded to Defendants' allegations of testing error, and the results were the same: the fibers in both MF5 samples were entangled together without any discernable pattern. (Stenmark Decl. para.para. 20-30; Vaughn Decl. para.para. 50-51; Exs. 16-17, 33-34.)

Finally, Defendants admit that the single outside layer of the MF5 is made of "special trade secret polyurethane." (Ex. 44, at 6:23-28; *see also* Wilkes Decl., Opening Report, at 4-5, and attached exhibits 3-4.) Accordingly, all aspects of the second element of Claim 1 are included in the MF5.

C. "*the single panel being wrapped about and adhered to the underlisting sleeve;*"

Defendants admit that the MF5's anti-slip sheet is wrapped around the sleeve body. (Ex. 44, at 8.) Defendants argue, however, that the MF5's anti-slip sheet is not "adhered to" the rubber tube/sleeve body. (Def. Opp., at 11-12; Def. Statement Genuine Issues Nos. 9-12.) As support for this contention, Defendants rely exclusively on the declaration of their expert and supporting evidence attached thereto. However, the evidence cited completely contradicts Defendants' own admissions, which Plaintiffs refer to and Defendants neither address nor dispute in their opposition papers. (*See* Ex. 43, at 7; Ex 44, at 7; Ex. 50 at 223:6-14; 230:15-23.)

Defendants' position centers on their contention that the MF5's anti-slip sheet is not adhered to the sleeve body using an adhesive; rather, the sheet is compressed and/or shrink fitted onto the tube. (Meirowitz Decl. para. 25.) Defendants evidence this assertion by relying on a test conducted by their expert that resulted in spontaneous separation between the MF5's rubber tube and anti-slip sheet when cut. (Ex. 52, Meirowitz Expert Report, at 7-8.) However, when Plaintiffs' experts conducted a peel strength test, they determined that an appreciable amount of force was required to separate the anti-slip sheet from the rubber sleeve, thus satisfying the ordinary meaning of "adhere," and eliminating any material factual dispute. (Wilkes Decl., para. 17; Garret Decl., para. 7.)

Furthermore, Compgrip's own admissions contradict Defendants' position that the MF5's anti-slip sheet and rubber sleeve are not adhered together. Defendants expressly refer to the use of an adhesive to adhere the

MF5's panel to its rubber sleeve. (Ex. 43, at 7 [Compgrip's 8/2/06 responses to Winn's first set of interrogatories]; Ex 44, at 7:23-26 [Compgrip's 8/29/06 supplemental responses to Winn's first set of interrogatories]; Ex. 50 at 223:6-14; 230:15-23 [deposition testimony of Compgrip's principal Hong Sung-Chu].) Although Defendants' second set of supplemental responses retracted these earlier admissions, even Defendants' most recent interrogatory responses confirm that the MF5's panel is adhered to its rubber sleeve. (Ex. 45, at 4-6.)

Defendants make general allegations that Plaintiffs' evidence mischaracterizes Compgrip's interrogatory responses and Mr. Chu's deposition testimony. (*See* Def. Statement Genuine Issues Nos. 9-11, 14-15.) However, none of the disputed evidence cited by Defendants supports their assertion that an adhesive is not used to join the anti-slip sheet and rubber tube of the MF5. In fact, much of the evidence contradicts this very proposition. Defendants' genuine issue number twelve, though undisputed, states Plaintiffs' evidence represents only the tack, a non-adhesive force resulting from the tendency of rubber to stick to unlike materials; the tack does not indicate the existence of a substance acting as an adhesive. (Def. Statement Genuine Issues No. 12.) The disputed evidence not only fails to support Defendants' proposition that an adhesive is *not* used, but it also contradicts Defendants' expert's report stating that the absence of an adhesive is demonstrated by the spontaneous separation of the anti-slip sheet and rubber tube of the MF5. (Ex. 52, Meirowitz Expert Report, at 7-8.)

Following a review of the evidence, a comparison of the third element of Claim 1 with the MF5 establishes that the MF5 includes a single panel that is wrapped about and adhered to an underlisting sleeve. Defendants fail to present evidence that raises a material factual dispute.

D. "*with the side edges of the panel abutting one another and being adhered together to define a longitudinal seam extending from the interior surface of the panel to the exterior surface of the polyurethane layer.*"

Defendants assert that the side edges of the MF5 do not abut and adhere all the way using a specified adhesive. (Def. Opp., at 13.) Specifically, Defendants contend that the only type of permissible adhesive allowed by the '971 Patent is a polychloroprene and toluene compound, and because the MF5 does not use this specific adhesive, the seams are not adhered together as required by the Patent. (Def. Opp., at 13.) As discussed above, Defendants' proposed construction is wrong as a matter of law. *See* Gemstar, 383 F.3d at 1366; Smith, 294 U.S. at 11.

Defendants also argue that because the MF5 grip contains air gaps between the seams, it is not adhered together along the entire seam. (Def. Statement Genuine Issues No. 15.) Because Defendants' construction of Claim 1 in this way would disregard a preferred embodiment of the '971 Patent that considers the use of an adhesive with air gaps, the argument is without merit *See* MBO Labs., 474 F.3d at 1333. What is more, Defendants argument seems premised on the fact that the MF5 is somehow inferior to the product as described in the '971 Patent. However, as a matter of law, an inferior product does not escape infringement liability merely because it doesn't perform at an optimum level. *See* Paper Converting Machine Co. v. Magna-Graphics Corp., 745 F.2d 11, 20 (Fed.Cir.1984) (concluding that "... imperfect practice of an invention does not avoid infringement.")

Apart from these arguments, Compgrip admits that the MF5's panel is "wrapped around the sleeve body such that the two heat-pressed axial edges are near to, side by side or touching but not overlapping each other." (Ex. 44, at 8:1-5 [Defendants' supplemental responses to Winn's first set of interrogatories].)

Moreover, Compgrip's principal, Mr. Chu, testified in deposition that the side edges are "glued together." (Ex. 50, at 229:2.) Additionally, SEM images prepared by Compgrip's expert confirm the presence of an adhesive substance in the seam of the MF5 grip. (Pl. MSJ, at 22-23; Ex. 52, Meirowitz Expert Report, at 32; Ex. 10, Wilkes Rebuttal Expert Report, para.para. 14-20.)

In light of the evidence, and this Court's construction of Claim 1, the MF5 does contain side edges that abut one another and adhere together along a seam that extends from the interior layer of the grip to the exterior surface of polyurethane layer.

III. ***Defendants' Evidentiary Objections***

The Court's rulings on the evidentiary objections made by defense counsel at the hearing are not determinative. To be complete, however, the Court rules on the objections as follows: the objection to Garrett's Declaration para.para. 5-16 is overruled; and the objection to Wilkes's Declaration is unsupported and overruled.

IV. ***Summation***

The evidence establishes that the MF5 grip contains all four of the elements included in Claim 1 of the '971 Patent. Accordingly, the MF5 grip literally infringes Claim 1 of the '971 Patent and Plaintiffs' Motion for [Partial] Summary Judgment is GRANTED.

The Clerk shall serve a copy of this order on counsel.

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