United States District Court,
D. Massachusetts.

Carl J. CONFORTI,
Plaintiff.
v.
TIMEX CORPORATION and the Ocean Group, Inc,
Defendants.

Civil Action No. 06-10513-GAO

Sept. 18, 2008.

Joseph H. Silvia, Saulino & Silvis, P.C., Fall River, MA, Brett N. Dorny, Law Office of Brett N. Dorny, Northboro, MA, for Plaintiff.

Robert D. Fine, Douglas J. Emanuel, Chace Ruttenberg & Freedman, Providence, RI, David Lesht, Cook, Alex, McFarron, Manzo, Cummings & Mehler, Ltd., Chicago, IL, for Defendants.

OPINION AND ORDER

O'TOOLE**, District Judge.**

I. Background

The plaintiff, Carl Conforti, has brought suit against the defendants Timex Corporation ("Timex") and The Ocean Group ("Ocean Group"). Conforti is the owner of U.S. Patent No. 6,886,979 (the '979 Patent) for an ear thermometer equipped with a light to enable use in the dark. The complaint alleges direct patent infringement (Count I), active inducement of infringement (Count II), and breach of a certain non-disclosure agreement (the "NDA") and attendant misappropriation of a trade secret (Count III). Counts I and II are asserted against both defendants; Count III is asserted only against Ocean Group.

On June 18, 2002, Conforti met with Jeffrey Jacober (the "Conforti meeting"), formerly the President and CEO of Ocean Group as well as MEDport, Inc. ("MEDport"). Jacober signed the relied-upon NDA, and Conforti disclosed to Jacober his purported inventions relating to ear thermometers. The presentation materials included reference to a "large LCD display and optional led [light emitting diode] lamp for night use." (*See* Mem. in Supp. of Defs.' Mot. for Summ. J. of Invalidity of the Asserted Claims from U.S. Patent No. 6,886,979 as Anticipated and/or Obviousness by Published Prior Art Ex. 45 [hereinafter Defs.' Ex.].) Conforti displayed a model of "an illuminator and cartridge dispenser with an IR [infrared] thermometer." (Defs.' Ex. 6 at 23.) Jacober told Conforti that he had no interest in what Conforti had disclosed.

In 2003, MEDport began selling the Timex Illuminator, a thermometer with an attached light. The product

bears the "Timex" trademark by virtue of a licensing agreement between MEDport and Timex Licensing, a wholly-owned subsidiary of Timex. In May 2003, Conforti sent Jacober a letter reminding him of his obligations under the NDA. Jacober replied reiterating his lack of interest in Conforti's disclosures. Conforti also at this time filed a patent application which in 2005 resulted in the issuance of the '979 Patent. There was some further correspondence between Conforti and Jacober, and Jacober informed Conforti that the concept of a thermometer with a light had been presented to Jacober by Lindon Development Group ("Lindon") prior to the date of Conforti's meeting with Jacober. In response to Conforti's citation of a section of the NDA providing an exception to the non-disclosure obligations for information that Jacober and his related entities could show by written records was previously in their possession, Jacober's assistant sent papers purporting to support Jacober's position that the idea for a thermometer with a light came from a meeting with Lindon pre-dating the Conforti meeting in June 2002. MEDport continued to sell the Timex Illuminator, and on May 22, 2006 Conforti filed this action.

There are cross-motions for summary judgment. The plaintiffs have moved for partial summary judgment as to the claim for direct infringement. Both defendants have brought counterclaims seeking a declaratory judgment of invalidity, unenforceability, and non-infringement, and have moved for summary judgment on Counts I and II on those bases. I conclude that the relevant claims of the '979 Patent are invalid as anticipated and/or obvious, and the defendants are entitled to summary judgment on Count I (direct infringement) and Count II (inducement). Ocean Group has also moved for, and is entitled to, summary judgment on Count III because the information disclosed by Conforti to Jacober was publicly known, not a trade secret, and therefore expressly excepted from the NDA's confidentiality obligation.

II. The Patent Claims

A. Claim Construction

To assess either infringement claims or invalidity defenses, the first step is to construe the relevant claims. *See* Interactive Gift Express v. Compuserve, Inc., et al, 256 F.3d 1323, 1330 (Fed.Cir.2001); Beachcombers v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1160 (Fed.Cir.1994). The claims "define the invention to which the patentee is entitled...." Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed.Cir.2005). The starting point in interpreting a claim is the language of the claim itself, which is to be given "its ordinary meaning as understood by persons skilled in the relevant art." Tex. Digital Sys., Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed.Cir.2002).

Conforti argues that the Timex Illuminator infringes independent claims 1 and 19, and dependent claims 2 and 3 of the '979 Patent. The parties agree that the claim terms "do not have any special meaning in the field of art ... and each and every claim term element is interpreted in accordance with its plain meaning." (Defs.' Joint Statement of Undisputed Material Facts in Supp. of Summ. J. of Invalidity and in Supp. of Summ. J. of Non-breach of Contract and Non-misappropriation of Trade Secrets and in Supp. of Summ. J. for Timex para. 110.)

1. Claim 1

Claim 1 of the '979 Patent claims:

1. A temperature measuring device comprising:

a housing including a main portion configured to be grasped by a person;

a temperature probe attached to the housing and configured to sense temperature, the probe extending from the main portion of the housing in a configuration for insertion into an orifice or within close proximity of a surface area on a patient's body where temperature is to be measured; and

a light source coupled to the housing and configured to provide visible light *in a vicinity of the probe;*

wherein the light source is configured to provide visible light external to the housing, externally *illuminating a region in front of and behind the tip of the probe* outside the housing to provide a means for the person taking the temperature measure to position the probe to a desired area on the patient's body.

'979 Patent col 4 ll. 15-32 (emphasis added).

The parties mildly dispute what it means for the light source to provide light "in a vicinity of the probe," and "illuminating a region in front of and behind the tip of the probe...." In the context of the claimed device and its intended function, visible light "in a vicinity" of the temperature probe that illuminated "a region in front of and behind the tip of the probe" would, by the diffusion of the light, also necessarily illuminate the tip of the probe, even if indirectly and to a lesser degree. It would be correct to point out that the claim language does not require the tip of the probe to be the focus of the illumination, and indeed, the claim seems rather to take pains not to say that. The "in front of and behind the tip" language is a strangely oblique way to describe indirect illumination of the tip.

Indeed, that language seems to have another purpose, either to persuade the Patent Office to grant the patent over close prior art and/or to defeat defenses of invalidity by reason of anticipation or obviousness. Any light useful to achieve the functional purpose of the invention would necessarily provide some degree of useful illumination "in a vicinity" of the tip of the probe-and to some degree both "in front of and behind" the tip-so that the probe could be maneuvered successfully by a user into the ear cavity. Because any illuminated temperature probe would have to illuminate the tip, directly or indirectly, that putative element, however expressed, fails to distinguish the plaintiff's claimed device from any other useful illuminated temperature probe, specifically including those the plaintiff must seek to avoid in order to defeat a defense of anticipation or obviousness, discussed in more detail below.

2. Claims 2 and 19

Claims 2 and 19 both relate to turning on and off the temperature probe and light source:

2. The device of claim 1 wherein the temperature probe is independently selectively operable to sense temperature and wherein the light source is selectively operable to provide the light independent of actuation of the temperature probe sensor.

....

19. A temperature measuring device comprising:

a housing including a main portion configured to be grasped by a person;

a temperature probe attached to the housing and configured to sense temperature, the probe extending from

the housing in a configuration for insertion into onto [sic] a surface area of a patient's body where the desired body temperature is to be measured; and

a light source attached to the housing and configured to provide visible light in a vicinity of the probe;

wherein the light source is configured to be activated by an independent switch;

wherein the light source is configured to provide visible light external to the housing, externally illuminating a region in front of and behind the tip of the probe outside the housing to provide a means for a person taking temperature measure to position the probe to a desired location on the patients body.

'979 Patent col. 4 ll. 33-37; col. 6 ll. 29-46.

The parties agree that claims 2 and 19 each require the operator to be able to turn the temperature probe on without turning the light on, and vice versa. The defendants are correct that the claims do not require that there be a separate mechanical, as opposed to electrical, switch for each operation. One button could execute each function independently.

3. Claim 3

Claim 3 of the '979 Patent states:

3. The device of claim 1 wherein the light source is a light-emitting diode.

'979 Patent col. 4 ll. 38-39. The parties agree that claim 3 requires the light source to be a LED.

B. Validity

For the reasons discussed below, I conclude that claims 1, 2, 3 and 19 of the '979 patent are invalid as anticipated and obvious.

1. Anticipation

A claim is invalid as anticipated "if a single prior art reference discloses each and every limitation of the claimed invention." Schering Corp. v. Geneva Pharm., 339 F.3d 1373, 1377 (Fed.Cir.2003). In light of two prior art references, Japanese Publication No. H7-286905, published October 31, 1995 ("Casio") and UK Publication No. 2,356,052, published May 9, 2001 ("Draco"), claims 1, 2, 3, and 19 of the '979 Patent are anticipated.

Casio discloses a thermometer with a light mounted in the top part of the case. The light is mounted "so that it can emit light along the detection direction of a temperature sensor." (Defs.' Ex. 2 at 12.) Figure 6 of Casio depicts a housing being grasped by a hand, consisting of a probe with a parallel, but shorter, light source slightly above it. (*See* id. at 22.) Like the light source in claim 1, Casio's light source would illuminate the tip of the probe as well as an area in front of and behind it. (*See* id.) Accordingly, all of the elements of claim 1 of the '979 patent are contained in Casio.

Draco discloses a hand-held ear thermometer with additional features including a bulb driving circuit to emit light to illuminate the ear canal. (*See* Defs.' Ex. 3 at 2.) It discloses separate keys to independently

select "LIGHT" and "SCAN" functions, and therefore anticipates claims 2 and 19. (*See* id. at 15.) Draco also expressly states that the light source can be an LED, and therefore anticipates claim 3. (*See* id. at 20.)

Accordingly, because every element of claims 1, 2, 3 and 19 of the '979 can be found in prior art, these claims are invalid as anticipated under 35 U.S.C. s. 102.

2. Nonobviousness

Even without reference to Casio, Draco, or indeed any other specific piece of prior art, the relevant claims of the '979 Patent would be invalid as obvious. A claim is invalid as obvious "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." 35 U.S.C. s. 103(a).

The combination of a light with a thermometer is obvious because it " 'simply arranges old elements with each performing the same function it had been known to perform' and yields no more than one would expect from such an arrangement...." *KRS* Int'l Co. v. Teleflex Inc., 550 U.S. 398, 127 S.Ct. 1727, 1740, 167 L.Ed.2d 705 (2007) (quoting Sakraida v. Ag Pro, Inc., 425 U.S. 273, 282, 96 S.Ct. 1532, 47 L.Ed.2d 784 (1976)). The Supreme Court stated in *KRS* that "if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person's skill." *Id*. Attaching a light to any device that one might want to use in the dark would be one such obvious technique, and is far afield from the "useful Arts" that a patent monopoly seeks to promote. *See* U.S. Const. art. I, s. 8, cl. 8; Graham v. John Deere Co. of Kan. City, 383 U.S. 1, 6, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966) ("Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of ... useful Arts.' This is the standard expressed in the Constitution and it may not be ignored.")

The additional limitations included in the other claims are similarly obvious. An LED was a known light source, and using either one or two switches to operate two separate functions independently and selectively is the predictable result of combining a light and a thermometer, each originally with a separate switch, into one casing.

The claims 1, 2, 3, and 19 of the 'Patent are invalid as obvious under 35 U.S.C. s. 103(a).

C. Infringement

Because the relevant claims of the '979 Patent are invalid, the defendants could not have directly infringed, nor induced others to infringe, upon those claims. *See* Specialty Rental Tools & Supply, Inc. v. Boyd's Bit Serv., Inc., 84 Fed. Appx. 90, 92 (Fed.Cir.2003); Viskase Corp. v. Am. Nat'l Can Co., 261 F.3d 1316, 1323 (Fed.Cir.2001); Richdel, Inc. v. Sunspool Corp., 714 F.2d 1573, 1580 (Fed.Cir.1983). Accordingly, the defendants are entitled to summary judgment on Counts I and II of the complaint.

III. The Non-Disclosure Agreement

Conforti alleges he disclosed to Jacober a "trade secret relating to a temperature measuring device which consisted of a design, process, procedure, formula, invention, or improvement...." (Compl.para. 17-19.) Conforti contends that Ocean Group misappropriated this purported trade secret and breached its promise of

confidentiality under the NDA. In moving for summary judgment on this claim, Ocean Group argues that information learned from Conforti was public knowledge, as well as already within its possession as evidenced by written records, and therefore not subject to the promises of confidentiality and non-use. For the same reasons, Ocean Group argues that Conforti's disclosure did not constitute a trade secret.

The NDA provides that "the obligation not to disclose or use shall not apply to the information which: (a) is or becomes publicly known through no wrongful act or omission by the RECIPIENT." (Defs.' Ex. 32.) Ocean Group maintains that the information presented by Conforti was already public knowledge in light of the prior art, Casio and Draco, discussed above. Conforti's response to this is the conclusory assertion that the Timex Illuminator does not follow the design of either Casio or Draco. The design Conforti is referring to, to the extent it differs from the invention claimed in the '979 Patent, he describes only as "a single light positioned above the temperature probe which illuminated the probe and in front of the probe." (*See* Pl.'s Opp. to Ocean Group, Inc.'s Mot. for Summ. J. of Non-breach of Contract and Non-misappropriation of Trade Secrets 2.) Casio discloses just that. (*See* Defs.' Ex. 2.)

Conforti adds that Ocean Group does not contend that it was aware of Casio at the time of the meeting, but Ocean Group's actual knowledge is inconsequential. The plain meaning of "publicly known" precludes such an interpretation. Furthermore, the NDA has a separate provision for information which Ocean Group can show, *by written records,* was in its possession. (*See* Defs.' Ex. 32) Conforti's suggestion would make this provision redundant and render its written records requirement impotent. Because the information disclosed by Conforti was publicly known at the time, it also does not constitute a trade secret.

Ocean Group argues that this "written records" provision also excepts it from the nondisclosure obligation. The NDA states that "the obligation not to disclose or use shall not apply to the information which: ... The RECIPIENT can show by written records was in its possession at the time of the disclosure." (Id.) Ocean Group relies on documents that pre-date the Conforti meeting which relate to a presentation by Lindon involving a thermometer with two lights located on either side of the probe and indicate MEDport's interest, as well as a Timex executive's notes from a meeting and discussions with MEDport about the thermometer designs. Conforti suggests that material facts remain in dispute. As to this exception, Conforti's point regarding the single light design is well taken. Conforti disclosed a thermometer with one light atop the nose, and the evidence put forth by Ocean Group shows only that it was developing a thermometer with two lights, one on either side of the probe. The ultimate product was more like former design than the latter. There is therefore a question of fact as to the application of the NDA's "written records" exception. However, in light of the clear application of the "publicly known" provision, it is immaterial. Ocean Group did not breach the NDA nor misappropriate a trade secret, and is therefore entitled to summary judgment on Count III.

IV. Conclusion

For the foregoing reasons, the plaintiff's Motion for Partial Summary Judgment of Infringement, Validity and Willfulness (dkt. no. 35) is DENIED. The Defendants' Motion for Summary Judgment of Invalidity of the Asserted Claims from U.S. Patent No. 6,886,979 as Anticipated and/or Obviousness by Published Prior Art (dkt. no. 37), The Ocean Group, Inc.'s Motion for Summary Judgment of Non-breach of Contract and Non-misappropriation of Trade Secrets (dkt no. 38) and the Motion for Summary Judgment of Timex Corporation (dkt. no. 41) are GRANTED. Judgment shall enter for the defendants.

It is SO ORDERED.

D.Mass.,2008.
Conforti v. Timex Corp.

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