

United States District Court,  
N.D. Georgia, Atlanta Division.

**ROMALA STONE,**  
INC. Plaintiff.

v.

**HOME DEPOT U.S.A., INC,**  
Defendant.

No. Civ.A. 104CV02307RWS

**April 2, 2007.**

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## **SPECIAL MASTER'S REPORT AND RECOMMENDATION ON CLAIM CONSTRUCTION**

**PETERSON, J.**

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## I.

### Introduction

## **A. Background**

Romala Stone, Inc. ("Romala Stone") alleges, *inter alia*, that Home Depot U.S.A., Inc. ("Home Depot") has infringed, literally or under the doctrine of equivalents, claims 1, 3, 4, 6-9, and 11-14 of U.S. Patent No. 6,594,973 (the '973 patent) entitled "Method of Packaging and Selling Natural Stone. " The '973 patent issued on July 22, 2003, to Arnold L. Alpert and Lawrence E. Coffman, and the face of the patent indicates that it was assigned to Romala Stone. Romala Stone's complaint also asserts state law claims for unfair competition and deceptive trade practices under O.C.G.A. s.s. 10-1-370 et seq. , common law unfair competition, breach of a written contract, misappropriation of confidential information and trade secrets under O.C.G.A. s.s. 10-1-760 et seq. , and for recovery of litigation costs and attorneys' fees under O.C.G.A. s. 13-6-11.

On September 23, 2005, the parties submitted their Joint Claim Construction Statement [Docket No. 82] ("JCC"). On November 10, 2005, the parties filed their respective opening claim construction briefs, *i.e.*, Romala Stone filed Plaintiff's Opening Claim Construction Brief [Docket No. 88] ("Romala Stone's Brief") and Home Depot filed its Opening Brief of Claim Construction of Defendant [Docket No. 85] ("Home Depot's Brief"). On December 1, 2005, the parties filed their responsive Briefs, *i.e.*, Romala Stone filed its Plaintiff's Claim Construction Response Brief [Docket No. 94] ("Romala Stone's Response") and Home Depot filed its Response of Defendant Home Depot U.S.A., Inc., in Opposition to Plaintiff's Opening Claim Construction Brief [Docket No. 93] ("Home Depot's Response").

## **B. Referral to the Special Master**

By order dated June 14, 2006, the above captioned cause was referred to the special master to conduct a Markman FN1 bearing, and to prepare a report and recommendation to the Court concerning construction of disputed terms and phrases in the patents-in-suit. In accordance with that order, a *Markman* hearing was held on August 17, 2006, in the Courtroom of the Honorable Richard W. Story, and a record of that hearing has been filed with the Court.

FN1. *Markman v. Westmen Instruments, Inc.*, 517 U.S. 370 (1996).

After reviewing the transcript of that hearing as well as the exhibits and briefs offered by both parties, and pursuant to the foregoing Order and Rule 53, Federal Rules of Civil Procedure, the master issues the following report and recommendation on claim construction.

## **II.**

### **Claim Construction Principles**

#### **A. Overview**

A patent is a fully integrated written instrument. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 978 (Fed.Cir.1995) ( *en banc* ), *aff'd*, 517 U.S. 370 (1996). A patent, by statute, must provide a written description of the invention, a disclosure that would enable one of ordinary skill in the art to make and use

the invention, and a disclosure of the best mode known to the inventor for practicing the invention. 35 U.S.C. s. 112(1).FN2 A patent must also contain claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. s. 112(2).FN3 The claims of a patent provide the measure of a patentee's right to exclude others from practicing the claimed invention. 35 U.S.C. s. 154.FN4

FN2. 35 U.S.C. s. 112(1) provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

FN3. 35 U.S.C. s. 112(2) provides:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

FN4. 35 U.S.C. s. 154(a)(1) provides:

Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, of the right to exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States, and, if the invention is a process, of the right to exclude others from using, offering for sale or selling throughout the United States, or importing into the United States, products made by that process, referring to the specification for the particulars thereof.

## **B. Claims**

Primary claim construction principles are discussed and explained in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed.Cir.2005) ( *en banc* ).

Among those are that "[i]t is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude.'" *Phillips*, 415 F.3d at 1312, quoting *Innova/Pure Water, Inc. v. Sajart Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed.Cir.2004), and citing *Vitronus Corp. v. Conceptra, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). *See also* *Renishaw PLC v. Marposs Societal per Azont*, 158 F.3d 1243, 1248 (Fed.Cir.1998) (claim construction "begins and ends" with the actual words of the claims). "That principle has been recognized since at least 1836, when Congress first required that the specification include a portion in which the inventor 'shall particularly specify and point out the part, improvement, or combination, which he claims as his own invention or discovery.'" *Phillips*, 415 F.3d at 1312.

"[T]he words of a claim 'are generally given their ordinary and customary meaning,'" and "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in

the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." *Id.* at 1313. "That starting point is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art." *Id.* at 1313. "Importantly, the person of ordinary skill in the art is deemed to read the claim term not only to the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Id.*

"In some cases, the ordinary meaning of claim language as understood by a person of skill in the art may be readily apparent even to lay judges, and claim construction in such cases involves little more than the application of the widely accepted meaning of commonly understood words." *Id.* at 1314. Thus, in some instances, "general purpose dictionaries may be helpful," but, as the court explained, "[i]n many cases that give rise to litigation \* \* \* determining the ordinary and customary meaning of the claim requires examination of terms that have a particular meaning in a field of art." *Id.* "Because the meaning of a claim term as understood by persons of skill in the art is often not immediately apparent, and because patentees frequently use terms idiosyncratically, the court looks to 'those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean.'" ' *Id.*, quoting *Innova*, 381 F.3d at 1116. "Those sources include 'the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art.'" ' *Phillips*, 415 F.3d at 1314.

Thus, the claim construction process begins with the language used in the claims because "[q]uite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms." *Id.* "Other claims of the patent in question, both asserted and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim term. Because claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims." *Id.* (citation omitted).

"Differences among claims can also be a useful guide in understanding the meaning of particular claim terms." *Id.* That is referred to as "claim differentiation." "For example, the presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim." *Id.* at 1314-15. However, claim differentiation is a guide, not a rigid rule, and there are exceptions, as discussed below.

### **C. Specification**

The specification nevertheless remains important in claim construction. "The claims, of course, do not stand alone. Rather, they are part of 'a fully integrated written instrument,' consisting principally of a specification that concludes with the claims. For that reason, claims 'must be read in view of the specification, of which they are a part.' \* \* \* [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.* at 1315.

In particular, "[c]onsistent with that general principle," the cases recognize that (1) "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs," and (2)[i]n other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor. In that instance as well, the inventor has dictated the correct claim scope, and the inventor's intention, as expressed in the specification, is regarded as dispositive." *Id.* at 1316.

However, two claim construction principles are (1) claims are read in light of the specification, but (2) limitations from the specification must not be read into the claims. The line between the two is not always clear. *See Comark Communications, Inc. v. Harrts Corp.*, 156 F.3d 1182, 1186-87 (Fed.Cir.1998) ( "there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification"). In *Phillips*, the Federal Circuit advised that the "line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms. For instance, although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. That is not just because section 112 of the Patent Act requires that the claims themselves set forth the limits of the patent grant, but also because persons of ordinary skill in the art rarely would confine their definitions of terms to the exact representations depicted in the embodiments." *Phillips*, 415 F.3d at 1316 (citations omitted).

The Federal Circuit also advised. "To avoid importing limitations from the specification into the claims, it is important to keep in mind that the purposes of the specification are to teach and enable those of skill in the art to make and use the invention and to provide a best mode for doing so. One of the best ways to teach a person of ordinary skill in the art how to make and use the invention is to provide an example of how to practice the invention in a particular case. Much of the time, upon reading the specification in that context, it will become clear whether the patentee is setting out specific examples of the invention to accomplish those goals, or whether the patentee instead intends for the claims and the embodiments in the specification to be strictly coextensive. The manner in which the patentee uses a term within the specification and claims usually will make the distinction apparent." *Id.* at 1323 (citations omitted).

Nevertheless, the Federal Circuit has acknowledged that "[i]n the end, there will still remain some cases in which it will be hard to determine whether a person of skill in the art would understand the embodiments to define the outer limits of the claim term or merely to be exemplary in nature. While that task may present difficulties in some cases, we nonetheless believe that attempting to resolve that problem in the context of the particular patent is likely to capture the scope of the actual invention more accurately than either strictly limiting the scope of the claims to the embodiments disclosed in the specification or divorcing the claim language from the specification." *Id.* at 1323-24.

#### **D. Prosecution History**

The words in the claim may also be interpreted in light of the prosecution history, if in evidence. *Teleflex, Inc. v. Fuosa N. Am. Corp.*, 299 F.3d 1313, 1324 (Fed.Cir.2002).

"Like the specification, the prosecution history provides evidence of how the PTO and the inventor understood the patent. Furthermore, like the specification, the prosecution history was created by the patentee in attempting to explain and obtain the patent." *Phillips*, 415 F.3d at 1317 (citations omitted).

"Yet because the prosecution history represents an ongoing negotiation between the PTO and the applicant, rather than the final product of that negotiation, it often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Id.* "Nonetheless, the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the

inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be. *Id.*

### III.

#### U.S. Patent No. 6,594,973-the '973 Patent

##### A. Overview

The abstract of the '973 patent-in-suit explains that "[t]his invention comprises [1] a unique method for the sale of natural stone, [2] special packaging for the stone and [3] a method of doing business to make the stone available in high volume stores to the average consumer" '973 patent, abstract. Romala Stone urges that "[i]t is important to note that the '973 Patent is a patent for a unique business method, *not* for a product." Romala Stone's Brief at 3.

The abstract further explains that "[t]he method comprises [1] pre-fabricating the stone into slabs at or near the location where it is quarried, [2] into sizes and shapes which are common, and often standard, in household bathrooms and kitchens. The stone slabs may, or may not, include cut-outs for sinks and faucets of various standard size. [3] The pre-fabricated stone is then packaged in a box or carton which is designed to specially protect the stone, especially at the corners where most damage occurs, and [4] shipping the packages to high volume, do-it-yourself consumer outlets." '973 patent, abstract. In short, (1) pre-fabricating, (2) into sizes, (3) packaging, and (4) shipping.

The specification using almost identical language explains that the method comprises (1) "pre-fabricating the stone at or near the location where it is quarried," (2) that the prefabrication is "into sizes and shapes which are common, and often standard, in household bathrooms and kitchens," and "may, or may not, include cut-outs for sinks of various standard size," (3) packaging the pre-fabricated stone "in a box or carton which is designed to specially protect the stone, especially at the corners where most damage occurs," and (4) "shipping the packages to high volume stores, such as Home Depot and the like, for high volume sales." The result, according to the specification, is to bring "down the price of the stone to the consumer to very attractive levels \* \* \* " '973 patent, col. 2, lines 43-55.

Tabular or graphic material set at this point is not displayable.

The packaging includes an outer box 10 and an inner box 22. Outer box 10 has closing panels 12, 14, 18 and 20, and an opening or window 16 Inner box 22 also has a matching cut-out or window 32. Those cut-outs allow customers to see and feel the stone. Inner box 22 has folding corners 34, 36, 38, and 40, which serve to protect the corners of the stone slab from damage. Box 40 holds a backsplash cut from matching stone.

The '973 patent further explains that "a plastic container of epoxy" is included in the package "to be used by the do-it-yourselfer to install a sink in the countertop." The '973 patent explains that "[t]he epoxy comprises two separate liquid chemicals which, when mixed together, form an epoxy glue strong enough to hold the sink in place under the stone countertop. This epoxy is sold commercially, such as 'EPOWELD' a registered trademark of Hardman, a Division of Harcros Chemicals, Incorporated." '973 patent, col. 4, lines 60-65.

In particular, the '973 patent explains that:

Applicants, use a unique container for the two liquid components, which is particularly applicable for use with Applicants' packaging. The two liquids are placed in a single plastic container with an external plastic divider holding the two liquids apart. To use the epoxy the user slides the divider off of the plastic container which allows the two liquids to mix and the user kneads the plastic package until the two liquids are well mixed. The epoxy glue is now ready to use. The user then cuts a corner off of the plastic container and applies the epoxy to the undersurface of the stone slab, after marking the location of the sink, which will be attached under the stone countertop, at the prefabricated hole cut to accommodate it. Thus, the do-it-yourselfer can put the slab in place on a base in the bathroom or kitchen and attach the sink using the epoxy. This is all accomplished in a minimum amount of time since everything is pre-cut to a standard size and all elements are provided in the packaging.

'973 patent, col. 4, line 66-col. 5, line 16.

## **B. Disputed Terms**

As noted above, Romala Stone asserts claims 1, 3, 4, 6-9, and 11-14 of which claims 1 and 9 are independent, and provide (with paragraphing added and boldface indicating the disputed terms) FN5

FN5. Terms such as "pre cut" are sometimes hyphenated in the record, and sometimes not. To the extent possible, this report and recommendation preserves the original form.

1 A method for providing a pre cut non man made, non custom ordered stone top to enable assembly line production and sale of the top at a price affordable to an average consumer, the method comprising the steps of

pre cutting non man made stone into the pre cut top suitable for installation by the average consumer, wherein the pre-cut top defines cut outs to accommodate at least one sink and/or faucet,

packaging the pre-cut top for protecting the pre-cut top from breakage and scratching,

packaging fastening means with the pre-cut top, and

shipping a plurality of the packaged pre-cut tops to a retailer for sale to and installation by the average consumer

9 A method for providing a pre cut non man made stone top which can be installed by an average consumer and is not custom ordered by the average consumer, the method enabling assembly line production of the top and sale of the top at a price affordable to the average consumer, the method comprising the steps of

pre cutting non man made stone into the pre cut top, wherein the pre cut top defines at least one cut out to accommodate at least one of a sink or a faucet,

packaging the pre cut top for protecting the pre cut top from breakage and scratching.

packaging fastening means with the pre cut top, and



shipping a plurality of the packaged pre cut tops to a retailer for sale to the average consumer wherein the packaged pre cut top can be installed by the average consumer [Emphasis added.]

Dependent claims 4 and 13 call for "packaging a back splash with the pre cut top" and the parties initially disputed the meaning of that phrase as well, although it is unclear whether the parties currently dispute the meaning of that phrase.

#### IV.

**"average consumer," "price affordable to an average consumer," "suitable for installation by the average consumer" and "can be installed by the average consumer"**

#### A. The Parties' Proposed Construction

The parties' respective proposed constructions are as follows:

Claim Term	Romala Stone's Proposed Construction	Home Depot's Proposed Construction
"average consumer"	An individual that purchases supplies for a home improvement task from a retail outlet and performs the home improvement task himself or herself, regardless of whether the individual has any professional training in that task	This limitation requires construction by the Court. However, this limitation is not amenable to construction because none of the claim language, written description, prosecution history, or extrinsic evidence provides an objective standard that allows that [ sic "the"] public to determine the scope of the claimed invention.
	JCC Brief at A1-1 & B-1	To the extent that the Court determines that this term is capable of construction, Home Depot contends that it should be construed to mean "ordinary consumer."
	Plf CC Brief at 13	JCC Brief at A2-1 and B-1
		Def CC Brief at 13-14 & Exh. A at A-1
"price affordable to an average consumer"	A price at which a product is made available at a retail outlet directly to an individual that purchases supplies for a home improvement task from a retail outlet and performs the home improvement task himself or herself, regardless of whether the individual has any professional training in that task	This limitation requires construction by the Court. However, this limitation is not amenable to construction because none of the claim language, written description, prosecution history, or extrinsic evidence provides an objective standard that allows that [ sic "the"] public to determine the scope of the claimed invention.
	JCC Brief at A1-2 & B-1	To the extent that the Court determines that this

term is capable of construction, Home Depot contends that it should be construed to mean "a price that an average consumer can afford."

Plf CC Brief at 13

JCC Brief at A2-2 & B-1

		Def CC Brief at 14-15 & Exh. A at A-1
"suitable for installation by the average consumer"	Capable of being installed by an individual that purchases supplies for a home improvement task from a retail outlet and performs the home improvement task himself or herself, regardless of whether the individual has any professional training in that task	Thus limitation requires construction by the Court. However, this limitation is not amenable to construction because none of the claim language, written description, prosecution history, or extrinsic evidence provides an objective standard that allows that [ sic "the"] public to determine the scope of the claimed invention

JCC Brief at A1-3 to -4 & B2

To the extent that the Court determines that this term is capable of construction, Home Depot contends that it should be construed to mean "capable of being installed by an average consumer."

Plf CC Brief at 13

JCC Brief at A2-3 to -4 & B2

		Def CC Brief at 15 & Exh. A at A-1
"can be installed by the average consumer"	Capable of being installed by an individual that purchases supplies for a home improvement task from a retail outlet and performs the home improvement task himself or herself, regardless of whether the individual has any professional training in that task	This limitation requires construction by the Court. However, this limitation is not amenable to construction because none of the claim language, written description, prosecution history, or extrinsic evidence provides an objective standard that allows that [ sic "the"] public to determine the scope of the claimed invention.

JCC Brief at A1-5 & B2

To the extent that the Court determines that this term is capable of construction, Home Depot contends that it should be construed to mean "capable of being installed by an average consumer."

Plf CC Brief at 13-14

JCC Brief at A2-4 & B2

		Def CC Brief at 15 & Exh. A at A-2
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There are two questions (1) whether those claim terms render the claims indefinite under s. 112(2), and (2) if not, what is the meaning of those claim terms.

### **B. Parties' Arguments- "average consumer"**

Beginning with "average consumer," Romala Stone urges that support for its construction is found in the specification and prosecution history. *See* Romala Stone's Brief at 14-15, and Exhibit A1-1-2. For example, Romala Stone notes that the specification explains that the countertops "can be installed easily by the lay person in less than one hour," '973 patent, col. 3, lines 2-3, the packaging "allow[s] for shipping to stores and placement into inventory, easily displayed on shelves, and transported home by customers without breaking chipping or scratching. Installation has been made easily accomplished by the 'do-it-yourself customer," col. 3, lines 13-17, installation is accomplished by the do-it-yourself homeowner "in a minimum amount of time since everything is cut to standard size and all elements are provided in the packaging," col. 5, lines 11-16, and that "the object [of the invention] is to provide a package for the do-it-yourself homeowner, so that he or she can install a stone countertop in a bathroom or kitchen, something normally only done by a professional craftsman." June 20, 2001 Response at 4, lines 23-26. Romala Stone also relies on various dictionary definitions, including definitions for "average" and "consumer."

Home Depot, on the other hand, urges that (1) Romala Stone's reliance on dictionary definitions ignores the court's holding in *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed.Cir.2005), that a claim term may render a claim indefinite even though the term may be found in a dictionary, (2) Romala Stone's proposed construction is inconsistent with the specification, *i.e.*, the claims call for an "average consumer" not a "do-it-yourself consumer," and the specification does not describe a "do-it-yourselfer" as a "average consumer," (3) there is no support for Romala Stone's proposed construction "regardless of whether the individual has any professional training in that [home improvement] task," *i.e.*, an object of the invention is to enable a homeowner to do "something normally only done by a professional craftsman," and thus the '973 patent cannot be construed to encompass sales to professionals in home improvement industries, yet each purchases "home improvement supplies" from retail sales outlets and "performs the home improvement task himself or herself," and (4) "adopting Romala's constructions would not alleviate the indefinite nature of the phrases at issue because a wide range of individuals, from a broad economic spectrum and representing a range of abilities, purchase supplies for home improvement tasks." Home Depot's Response at 10-12.

### **C. Discussion- "average consumer"**

Home Depot is correct that simply finding dictionary definitions for terms such as "average" and "consumer" is not decisive. In *Datamize*, the claim-at-issue, drawn generally to an electronic kiosk system and more particularly to "a method for defining custom interface screens," called for, *inter alia*, "wherein each said element type permits limited variation in its on-screen characteristics in conformity with a desired uniform and *aesthetically pleasing* look and feel for said interface screens on all kiosks of said kiosk system." [Emphasis added]. Although "aesthetic" and "pleasing" are common words found in dictionaries, those terms are inherently subjective. Moreover, in finding the claim indefinite, the court noted that "Datamize has offered no objective definition identifying a standard for determining when an interface screen is 'aesthetically pleasing.'" ' 417 F.3d at 1350 The Federal Circuit explained that "[a] purely subjective construction of 'aesthetically pleasing' would not notify the public of the patentee's right to exclude since the meaning of the claim language would depend on the unpredictable vagaries of any one person's opinion of the aesthetics of interface screens." *Id.* That is, although one knows what "aesthetically pleasing" means, that meaning is nevertheless subjective.

The situation here is not analogous. The claims, specification and prosecution history provide an objective perspective for determining the scope of the claims.

## 1. Claims and Specification

Beginning with the claim language, and turning first to the preamble of claim 1:

1 A method for providing a pre cut non man made, non custom ordered stone top to enable assembly line production and sale of the top at a price affordable to an average consumer, the method comprising the steps of

that preamble first describes the method as one for providing a "pre cut," "non man made," "non custom ordered," "stone top." As noted above, the perspective for determining claim definiteness is that "of a person of ordinary skill in the art at the time of the patent application," and "[t]he definiteness of a patent claim depends on whether one skilled in the art would understand the bounds of the claim when read in light of the specification." *Howmedria Osteonus Corp. v. Trangutl Prospects, Ltd.*, 401 F.3d 1367, 1371 (Fed.Cir.2005). The parties have not provided evidence, on the present record, of how such a "person of ordinary skill in the art" would view those terms. Nevertheless, one is told the characteristics of that "stone top," *i.e.*, it is "pre cut," "non man made," and "non custom ordered." The parties do not dispute the meaning of those terms. Thus, it must be assumed that the parties agree that one of ordinary skill in the art would understand the meaning of a "pre cut," "non man made," "non custom ordered," "stone top."

Second, the preamble says that the method is "to enable" two results, namely (1) "assembly line production"-the parties do not dispute the meaning of that phrase-and (2) "sale of the top at a price affordable to an average consumer." The parties dispute the meaning of "at a price affordable to an average consumer" and "average consumer," but the claim does not end after "average consumer." Rather, the claim continues by defining the claimed method in four (4) steps ("the method comprising the steps of"), those steps being (1) "pre cutting \* \* \*," (2) "packaging \* \* \* for protecting \* \* \*," (3) "packaging fastening means \* \* \*," and (4) "shipping \* \* \*," namely:

pre cutting non man made stone into the pre cut top suitable for installation by the average consumer, wherein the precut top defines cut outs to accommodate at least one sink and/or faucet,

packaging the precut top for protecting the pre cut top from breakage and scratching,

packaging fastening means with the precut top, and

shipping a plurality of the packaged precut tops to a retailer for sale to and installation by the average consumer.

The parties separately dispute the meaning of "fastening means" for reasons not significant to the present issue. The three remaining steps thus are (1) "pre cutting \* \* \*," (2) "packaging \* \* \* for protecting \* \* \*," and (3) "shipping \* \* \* " The '973 patent abstract similarly says that the invention comprises three steps, namely "[t]he method comprises [1] pre-fabricating the stone \* \* \*, into sizes and shapes which are common, and often standard, in household bathrooms and kitchens \* \* \* [2] The pre-fabricated stone is then packaged in a box or carton \* \* \*, and [3] shipping the packages to high volume, do-it-yourself consumer

outlets."

Thus, at least at first blush, the step of "pre cutting" appears to relate to what the abstract refers to as "pre-fabricating." The specification and prosecution history, as discussed below, further confirm that is the case.

The first method step of both claims 1 and 9 refers to "pre cutting non man made stone into the pre cut top." Claim 1 adds "suitable for installation by the average consumer." The preamble of claim 9 likewise refers to "a pre cut non man made stone top which can be installed by an average consumer."

In the phrase "pre cutting," which, again, the parties do not dispute, the "pre" connotes some earlier or antecedent action. *See* MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY (10th ed 1999) at 915 ("1 a(1) either than prior to before \* \* \* (2) preparatory or prerequisite \* \* \* b in advance beforehand \* \* \* 2 in front of \* \* \* ")

The record does not give a full explanation, but it appears that at least two (and possibly more) "cutting" steps are required before a piece of granite or other natural stone is "cut from" or quarried from the earth and later installed as, for example, a counter top. The first is "cutting" or quarrying a stone from the earth. The second is "cutting" that stone to a size and shape for use as, *inter alia*, a countertop. The thrust of the specification is that in the prior art, a customer would select a quarried stone, *i.e.*, after the first step and before the second step, and then would be required to engage a skilled stone cutter to perform the second step. Doing so added cost, and it was that cost that the invention sought to avoid.

For example, the specification, like the abstract, explains that "[t]he method comprises prefabricating the stone at or near the location where it is quarried, into sizes and shapes which are common, and often standard, in household bathrooms and kitchens." '973 patent, col. 3, lines 43-55. "[P]re-fabricating \* \* \* into sizes and shapes" suggests that natural stone "cut from" or quarried from the earth is then secondly cut into smaller sizes. The specification further, for example, refers to "assembly line cutting of the natural stone at, or near the site of the quarry, into standard sized slabs " '973 patent, col. 4, lines 47-49.

All that becomes clearer in light of the prosecution history:

## **2. Prosecution History**

### **a) Original Claims**

The original application was filed with 20 claims. Original claim 1 called for:

1 A method of selling natural stone to the average consumer, comprising cutting the natural stone, at or near the location where the stone is quarried, into prefabricated standard sized slabs, packaging the stone in a box which protects the stone from damage, shipping large numbers of the boxes containing the stone slabs to a high volume retailer, for sale to the consumer [Emphasis added.]

Claims 2-7 were dependent on claim 1

Original claim 8 called for:

8 A package designed to protect and ship a slab of natural stone comprising an outer box having a cut-out in the front thereof, an inner-box to hold the stone slab, said inner box having a cut-out that matches the cut-

out of the outer box, said inner box having four foldable corners to protect the corners of the stone slab.

Original claim 16 called for

16 A package designed to protect and ship a slab of natural stone comprising an outer box having a cut-out in the front thereof, an inner box to hold the stone slab, said inner box having a cut-out that matches the cut-out of the outer box, said inner box having four foldable corners to protect the corners of the stone slab, each foldable corner comprising five sections adapted to fold around a corner of the inner box

Home Depot's Declaration of Thomas C Lundin Jr. ("Lundin Decl.") Exh. B at B-18-20.

### **b) First Office Action-April 2, 2001**

In a first Office action filed April 2, 2001, the examiner required "restriction" between what the examiner viewed as two distinct inventions. In general, under the authority of 35 U.S.C. s. 121, Rule 141(a), 37 C.F.R. s. 1.141(a), provides that "[t]wo or more independent and distinct inventions may not be claimed in one national application, \* \* \* " Rule 142(a), 37 C.F.R. s. 142(a), provides that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division)." Rule 142(b), 37 C.F.R. s. 142(b), provides that "[c]laims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled."

The examiner viewed the invention of Group I, claims 1-7, which the examiner viewed as being drawn to a "method," and the invention of Group II, claims 8-20, which the examiner viewed as being drawn to "a package," as independent and distinct inventions. The prosecution history indicates that, in accordance with standard practice, there was a telephone conference between the examiner and the applicants' attorney that resulted in an election of claims 1-7 for prosecution Lundin Decl. Exh B at B-80.

On the merits, the examiner rejected claim 1 (and dependent claims 2-7) under s. 112(2) contending that the phrase "standard sized" slabs rendered the claims indefinite. The examiner also rejected claims 1-7 under s. 112(2) asserting that "the average consumer," "the location," and "the stone," lacked antecedent basis. Lundin Decl. Exh. B at B-81. In general, a claim may be indefinite "where a claim refers to 'said lever' or 'the lever,' where the claim contains no earlier recitation or limitation of a lever and where it would be unclear as to what element the limitation was making reference." MANUAL OF PATENT EXAMINING PROCEDURE s. 1273.05(e) (8th ed., rev.5, August 2006). "[H]owever, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite." *Id.* See also *Energizer Holdings v. United States Int'l Trade Comm'n*, 435 F.3d 1366, 1370-71 (Fed.Cir.2006) (same).

The examiner also rejected, *inter alia*, claim 1 over U.S. Patent No. 6,006,735 to Schlough *et al* (and a secondary reference) contending that Schlough *et al* disclosed a method for cutting and shaping various stone materials. In fact, Schlough *et al* disclosed an automated stoneworking system and method such as illustrated in Fig. 1 below.

Tabular or graphic material set at this point is not displayable.

Claim 1, of course, called for "cutting the natural stone, at or near the location where the stone is quarried." The examiner contended that "[r]egarding to [ sic ] the location where the stone is quarried, it is irrelevant as far as the patentability concern [ sic ], for it is a business decision to find a location to minimize the production cost and to increase the profit. Lundin Decl. Exh. B at B-82. During prosecution, claims are given their broadest reasonable interpretation on the rationale that it "serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified." In re Yamamoto, 740 F.2d 1569, 1571 (Fed.Cir.1984).

### **c) Response-June 20, 2001**

In a Response filed June 20, 2001, the applicants amended claim 1 as follows (deleted terms in brackets, added material underlined).

1 (amended) A method of selling natural stone to a [the average] consumer, said natural stone quarried at a location, comprising, cutting the natural stone, at or near the location where the stone is quarried, into prefabricated [standard sized] slabs, packaging the stone in a box which protects the stone from damage, shipping large numbers of the boxes containing the stone slabs to a high volume retailer, for sale to the consumer.

The response indicates that those amendments were made in response to the rejection under s. 112(2). With respect to the rejection over Schlough *et al.*, the applicants argued that "Schlough *et al* has absolutely nothing to do with a method for selling stone." Lundin Decl. Exh. B at B-92. The applicants also argued that the examiner was wrong in asserting that the location where the stone was quarried was irrelevant to patentability. "In a method of doing business, the combination of the location where the stone is quarried and the location where it is prefabricated are necessary factors in the business method. No one has previously made it possible to merchandise prefabricated natural stone directly to the consumer. Up until Applicants' invention, natural stone has always been shipped in bulk and fabricated to size by stone craftsman [ sic ], after a piece has been selected by the consumer. This has not only been very expensive, but it has made it unavailable for sale directly to the consumer. Applicants' solution is not simply to reduce production costs and increase profits, but to make a product available to the do-it-yourself homeowner, which has not previously been available." *Id.* at B-92 to-93.

In that response, the applicants also added several claims, for example claim 21 which provided.

21. A method of selling natural stone, to a retail consumer, said natural stone being quarried at a quarry, comprising cutting the natural stone at or near the location where the stone is quarried, into prefabricated slabs, packaging each stone slab in a box which protects the stone slab from damage, shipping a plurality of the boxes, each box containing a stone slab, to a high volume retailer, for sale to the consumer.

All of the added claims called for "cutting the natural stone at or near the location where the stone is quarried, into prefabricated slabs." And, of course, claim 1 and its dependent claims called for the same.

### **d) Second Office Action-September 5, 2001**

The subsequent prosecution history indicates that the applicants' arguments *vis-a-vis* the location where the stone was quarried and the location where it was "prefabricated" took root with the examiner. To a second Office action filed September 5, 2001, the examiner again rejected all pending claims, but the principal

reference this time was U.S. Patent No. 4,962,967 to Hinkle. The examiner viewed Hinkle as disclosing "cutting the natural stone at or near the location where the stone is quarried, into prefabricated slabs."

As noted above, original claim 1 had called for "standard sized slabs," but was amended to delete "standard sized" in response to the examiner's rejection under s. 112(2). The then pending claims did not include any "size" limitation, other than by implication. Added claim 22, for example, called for "cutting openings in each stone slab to accommodate the placement of sinks and faucets," which might suggest that the "stone slab" was countertop size. And the claims called for "packaging the stone in a box which protects the stone from damage," and then "shipping" the boxes, which might imply-but does not expressly call for-a size that permits such packaging and shipping.

Thus, although the specification referred to "pre-fabricating the stone at or near the location where it is quarried, *into sizes and shapes which are common, and often standard, to household bathrooms and kitchens,*" the claims did not so require-at least not expressly. And the examiner's subsequent consistent rejection of the claims based on Hinkle as a primary reference likewise indicates that the examiner did not view the claims as including any "size" restriction.

The disclosure in Hinkle related to quarrying stone and, indeed, to quarrying large preces of stone. For example, Hinkle disclosed that "[c]utting and removing stone from the earth is an ancient art Within the last one and a half centuries, various motor-driven machines have been formulated to facilitate man's ability to extract large, single preces of stone from the earth. The object of these various devices is often to increase the length of the cutting device so as to enable larger blocks of stone to be cut. In addition, a further object has been to cut the stone as quickly and easily as possible. \* \* \* There is a need for a new improved machine for cutting slots into stone that has a sufficiently long cutting element to enable large blocks of stone to be cut. " '967 patent, col. 1, lines 9-29.

Hinkle disclosed a machine said to accomplish those objectives. Hinkle's specification explains that. The present invention is utilized to cut or grind a slot or channel in natural or artificial stone, marble, granite or like material, for the purpose of quarrying and removing the cut stone. The machine generally employs a high speed rotating arbor unit using diamonds or other suitable material, as a cutting surface, in which the arbor unit is secured to a reciprocating carriage unit. The high speed totaling arbor cuts a slot in the stone as the arbor unit is reciprocated. The arbor is pivotable about an axis at the end of the arbor thereby allowing the arbor to be swung or pitched to a particular desired position" '967 patent, col. 2, lines 9-19.

Tabular or graphic material set at this point is not displayable.

The examiner rejected all pending claims based on Hinkle in combination with various secondary references. According to the examiner, Hinkle disclosed "a method of cutting natural stone \* \* \* for the purpose of quarrying and removing the cut stone \* \* \* into prefabricated slabs." Lundin Decl. Exhibit B at B-102.

As noted above, the pending claims also called for "packaging the stone in a box which protects the stone from damage," and then "shipping" the boxes. The examiner viewed U.S. Patent No. 5,522,502 to Orr *et al* as disclosing "a method of packaging [the] container [ sic ] for shipping and displaying an article for sale comprising stone slab 38, back splash 42, and viewing window 27 ." According to the examiner, "it would have been obvious to one having ordinary skill in the art. at the time applicant's invention was made, to apply the teaching of Orr *et al.*'s packaging method to safely package the stone slab for shipping and displaying the product for sale to the consumer." *Id.*



The patent to Orr *et al.* was drawn generally to corrugated containers and methods of storing, shipping and displaying sinks. Fig 1 of Orr *et al.*, the figure that the examiner referred to, illustrates the following:

Tabular or graphic material set at this point is not displayable.

In general terms, Orr *et al.* disclosed a container 10 for holding a vanity sink 11. The examiner rejected all pending claims based on the principal combination of Hinkle and Orr *et al.*

#### **e) Response-January 16, 2002**

The problem, of course, was that Hinkle expressly disclosed cutting "large blocks of stone" and Orr *et al.* disclosed packaging small vanity sized sinks. There was little in common between the references. And that was the applicants' argument. In particular, the applicants emphasized that the claims were drawn to "prefabricated slabs". In the Response, the applicants argued that "Hinkle does not disclose quarrying and removing cut stone in 'prefabricated slabs'" [Emphasis added] Rather, the applicants argued, Hinkle described the "cut stone" as "large blocks of stone."

The applicants urged that (1) "[n]owhere does Hinkle describe cutting the stone into usable [ sic ] sized slabs," and (2)[n]owhere does Hinkle disclose anything about a business method of selling prefabricated stone slabs to consumers for 'do-it-yourself' installation in consumer's [ sic ] homes." The applicants argued that "[l]arge blocks of stone have historically been cut from a quarry and shipped world wide to stone dealers and craftsmen, which is the reason that natural stone has long been prohibitively expensive to the consumer," and that "[a]pplicants have solved that problem." Lundin Decl. Exh. B at B-116.

The applicants further argued that "Hinkle, the primary reference, simply shows a machine for cutting large pieces of stone out of a quarry, and fails completely to disclose the idea of cutting the stone at or near the quarry, into prefabricated slabs ready for the consumer to utilize, without the cost of further cutting by skilled craftsmen." Id. at B-119 to -120.

With respect to Orr *et al.*, the applicants argued that "it would not be obvious to combine the teachings of Hinkle and Orr *et al.*, where Hinkle cuts large blocks of stone and Orr *et al.* is packaging and stacking cultured marble sinks." Id. at B-117.

It thus seems clear that the applicants viewed "prefabricated slabs" in the claims as defining something that could be installed without further cutting, *i.e.*, "useable sized slabs," "prefabricated slabs ready for the consumer to utilize, without the cost of further cutting by skilled craftsmen." It is also clear, though, that the examiner did not view the term or phrase "prefabricated slabs" as *per se* so limiting the claims-or, at least, not in a manner that defined patentably over Hinkle. But again, examiners are instructed to give claims their broadest reasonable construction during prosecution on the rationale that claims may be amended.

#### **f) Third Office Action-April 23, 2002**

In the next Office action dated April 23, 2002, the examiner again rejected all pending claims based on the principal combination of Hinkle and Orr *et al.* and for the same reasons as in the prior Office action. In response to the applicants' argument that Hinkle did not disclose "prefabricated slabs," the examiner reasoned that "Hinkle discloses \* \* \* a machine that cutting [ sic ] the natural stone, at the location where the stone is quarried, and removing the cut stone from the earth. It is an obvious choice of the one of the

skill in the art to dictate the size of the cutting [ *sic* ] stone depending on the nature of the need in the art." Lundin Decl. Exh. B at B-133.

### **g) RCE and Response-September 3, 2002**

The applicants then filed a Request for Continued Examination (RCE) on September 3, 2002, with a Response that cancelled claims 1-29, and added claims 30-56. *Id.* at B-146 to -154. At this stage, the prosecution history becomes a bit confusing.FN6 What is clear, however, is that the applicants presented new claims that no longer referred to "cutting the natural stone at or near the location where the stone is quarried, into prefabricated slabs," but rather to "pre-cutting the non man made stone into a pre-cut top suitable for installation by a lay person." For example, new claim 30 provided.

FN6. For example, the next Office action dated October 16, 2002, contains a restriction requirement between Group I, claims 30-43, [with handwritten illegible correction] 54 and 55, which, according to the examiner, are drawn to "a method for providing a non man-made stone top, classified in class 53, subclass 435, and Group II, claims 44-52 [with handwritten illegible correction]. 53 and 56, which, according to the examiner, are drawn to "an item for installation, classified in class 206, subclass 320." Lundin Decl. Exhibit B at B-157. The file next contains a Supplemental Response that was filed October 17, 2002. That Response is said to be supplemental to the "Response filed August 23, 2002." *Id.* at B-160. However, the "Contents" page of the prosecution history discloses no response filed August 23, 2002. The context of the supplemental response suggests that it is supplemental to the Response filed September 3, 2002. Apparently, the supplemental response is referring to the certificate of mailing date on the September 3, 2002, response. The file next contains a Response filed November 18, 2002, which is said to be responsive to the Office action dated October 16, 2002, *i.e.*, the restriction requirement. That Response added claims 57-66, and amended claim 47. *Id.* at B-191. "Remarks" in that response refer to a different set of claims in Group II, *i.e.*, the examiner included claims 44-52, 53 and 56 in Group II, whereas the applicants' response refers to claims 40-52, 53 and 56, as being drawn to "an item for installation." That response further says that "Applicant hereby provisionally restricts the application to the claims for an item for installation," *i.e.*, Group II. With respect to the newly added claims, the response says that "[f]urther, the claims herein added are drawn to this item for installation." The response says that "[c]laims 57-59 find support throughout the application and in particular support can be found in preceding claim 56." Claim 56 is part of Group II. However, new claims 57-59 are drawn to "[a] piece of non man-made stone." The response further says that "[c]laims 60-66 find support in the application in last filed claims 30, 37, 39, 54 and 55." Those claims, however, were part of Group I, *i.e.*, the non-elected group. *Id.* at B-193 to -194. On the other hand, new claims 60-62 are dependent from claim 46, which was part of Group II (but while claim 46 (dependent on claim 44) calls for "[a]n item for installation," new claims 60-62 are drawn to "[a] method for providing a non man-made stone \* \* \*"). New claims 63-66 were also dependent on claim 44 (Group II), but claims 63-65, in contrast to claim 44, are drawn to "[a] method for providing a non man-made stone \* \* \*," while new claim 66, also dependent on claim 44, is drawn to "[a] method for providing an item." The prosecution history next contains a Supplemental Response filed January 28, 2003, which was entered as amendment E. That amendment included amendments to claims 31, 36, 37, 55, and 66, and added claims 67-75. The response says that "[a]ll other claims in this application are canceled without prejudice." *Id.* at B-199. Claims 55 and 66, as amended, became the "base" claims and ultimately issued as patent claims 1 and 9. The examiner subsequently entered a Notice of Allowability mailed February 13, 2003, allowing claims 31, 36, 37, 55 and 66-75.

30. A method for providing a non man-made stone top comprising the steps of pre-cutting the non man made stone into a pre-cut top suitable for installation by a lay person, and packaging the pre-cut top in a box for protecting said pre-cut top from breakage [Emphasis added]

New claim 55 provided

55. A method for providing a non man made stone top comprising the steps of pre-cutting the non man made stone into a pre-cut top suitable for installation, wherein said pre-cut top defines cutouts to accommodate sinks and/or faucets.

packaging the pre-cut top in a box for protecting said pre-cut top from damage wherein said box defines a cut-out which allows a customer to see and touch said pre-cut top,

packaging a container of an epoxy with said pre-cut top, wherein the container of epoxy comprises two sections separated by a removable separator in which a different reactive liquid is contained in each section,

packaging instructions for installation of the pre-cut top in said box,

packaging a backsplash with said pre-cut top in said box, and

shipping said box to a high volume retailer for sale to a lay person wherein the sink can be installed by the lay person [Emphasis added].

Lundin Decl. Exh. B at B-148 to -151.

Other claims were drawn to "[a]n item for installation comprising a pre-cut non man-made stone top which can be installed by a lay person." *See* claims 44-51, and 56 ("A [ sic ] item for installation comprising a pre-cut non man-made stone top \* \* \* said stone top being installable by a lay person."). Claim 52 was drawn to "[a] method of making the pre-cut non man made stone top of claim 44 comprising the steps of pre-cutting a piece of non man made stone into a top suitable for use as a table or countertop and installable by said lay person in less than one hour \* \* \*." Claim 53 was drawn to "[a] pre-cut non man-made top, \* \* \*, said top being installable by a lay person."

But all newly presented claims referred to "pre-cutting" or a "pre-cut" top, and all newly presented claims (with the exception of claim 54) referred to "for installation by a lay person" (or similar language, *e.g.*, "which can be installed by a lay person," "installable by a lay person," *etc.*

In remarks accompanying that response, the applicants argued that the newly presented claims were drawn to

"[P]re-cutting a non man-made stone top or a pre-cut non man-made stone top, which is a novel and unobvious idea. None of the prior art of record is pertinent because the art does not pertain to pre-cutting a non man-made stone top or a pre-cut natural stone top. As an example \* \* \* Schlough, discloses a machine for cutting stone. However, Schlough is silent about whether or not this cut stone is ready for installation by a lay person. The Applicant's [ sic ] are not aware of any pre-cut non man-made stone tops that were suitable for installation, especially by a lay person, before they produced their product."

Lundin Decl. Exh. B at B-152. Thus, the applicants drew a link between "pre-cut" and "suitable for installation, especially by a lay person."

## **h) Supplemental Response-October 17, 2002**

In a Supplemental Response filed October 17, 2002, *id.* at B-160, the applicants submitted a Rule 132 (37 C.F.R. s. 1132) affidavit from Arnold L. Alpert, one of the co-inventors of the '973 patent. Mr. Alpert avers, *inter alia*.

4. \* \* \* The present invention involves a non man-made stone slab pre-cut for installation as a sink top, countertop, tabletop and the like. \* \* \* The pre-cutting of these non man-made tops is a new and unobvious feature in non man-made stone. It allows for the packaging, purchase, and installation of pre-cut non man-made stone tops by the do-it-yourself or average consumer. Thus is because the tops are cut into sizes for immediate installation, eliminating the need and cost for specially qualified stonecutters to cut the stone \* \* \*.

5. \* \* \* Prior to the subject pre-cut non man-made stone top no one had thought to prepare natural stones in this way. Instead slabs of stone were simply sold to skilled craftspeople to prepare for installation. Thus, the need for an easy to-install affordable natural stone top was present. The subject pre-cut non man-made stone top has satisfied that need.

Lundin Decl. Exh. B at B-164.

## **i) Summary**

Thus, throughout prosecution, the applicants consistently emphasized that the non man-made stone top of their invention was one that could be installed without further cutting, *i.e.*, "useable sized slabs," "prefabricated slabs ready for the consumer to utilize, without the cost of further cutting by skilled craftsmen." Leading up to the filing of the RCE, the applicants viewed "prefabricated slabs" in the claims as defining the same. After all, "prefabricate" connotes an antecedent step of manufacture that facilitates later assembly. *See, e.g.*, MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY (10th ed 1999) at 918 ("to fabricate the parts of at a factory so that construction consists mainly of assembling and uniting standardized parts.").FN7 But the examiner did not view "pre-fabricated slabs" as defining patentably over Hinkle.

FN7. The Federal Circuit in *Phillips* cautioned against the indiscriminate use of dictionaries in claim construction, but also noted that "we do not intend to preclude the appropriate use of dictionaries. Dictionaries or comparable sources are often useful to assist in understanding the commonly understood meaning of words and have been used both by our court and the Supreme Court in claim interpretation." 415 F.3d at 1322. And that is the use here.

New claims 30-56 filed with the RCE (and claims 57-66 added later) took a different approach in terms of claim language, but the underlying substance was the same. Those newly presented claims referred to "pre-cutting" or a "pre-cut" top, and (with the exception of claim 54) to "for installation by a lay person" (or similar language, *e.g.*, "which can be installed by a lay person," "installable by a lay person," *etc.*, instead of "prefabricated slabs." However, the applicants continued to urge that "pre-cutting a non man-made stone top or a pre-cut non man-made stone top" that was "suitable for installation" by a "lay person," Lundin Decl. Exh. B at B-152, was not disclosed in the prior art, which parallels the earlier argument that the prior art did not disclose cutting large pieces of stone out of a quarry "into prefabricated slabs ready for the consumer to utilize, without the cost of further cutting by skilled craftsmen." *Id.* at Exh. B, B-119 to -120.

At this stage, a further facet of the amended claims should be explained. As noted above, in response to the restriction requirement in the Office action of April 2, 2001 ( *id.* at Exh. B, B-79), the applicants elected to prosecute original claims 1-7, which were drawn to "[a] method of *selling* natural stone to the average consumer." *Id.* at Exh. B, B-18 to -19 (emphasis added). The Response of June 20, 2001, amended claim 1 to read "a consumer," and presented new claims 21-28 drawn to "[a] method of *selling* natural stone to a retail consumer." *Id.* at Exh. B, B-89 to -90 (emphasis added). Prior to the filing of the RCE, the examiner contended that the claims were indefinite because the body of the claims did not recite a step of "selling" *per se*. The examiner suggested that the preamble be amended to a "method of packaging." *See* Office action of September 5, 2001, *id.* at Exh. B, B-101. The applicants disagreed urging that each of the claims included "for sale to the consumer." However, the applicants also added new claim 29 which provided that "said high volume retailer sells each said box to the retail consumer." *Id.* at Exh. B, B-115. Nevertheless, the examiner maintained the rejection, *see id.* at Exh. B, B-128, contending that the claim bodies did not include a step of "selling," *Id.* at Exh. B, B-133. Whether as a result or not, claims such as claim 30 (and its dependent claims) and other claims presented with and after the filing of the RCE were changed to "[a] method for providing." Other claims, such as claim 44, referred to "[a]n item of installation."

As a result, the claims presented with the filing of the RCE were subject to a restriction requirement, *id.* at Exh. B, B-157, however, the prosecution history indicates that the finally issued claims in the '973 patent were presented following a telephone interview with the examiner. Response filed January 28, 2003, *id.* at Exh. B, B-199 ("This is to formally present the claims which during a telephone conference between the undersigned and yourself [the examiner] were today agreed upon as allowable."). All of the finally amended claims were drawn to "[a] method for providing."

### **i) Amendments to Application Claims 55 and 66 Resulting in Patent Claims 1 and 9**

Patent claim 1 resulted from the following amendments to application claim 55, with underlining indicating additions and brackets indicating deletions.

55 (amended) A method for providing a pre cut non man made, non custom ordered stone top to enable assembly line production and sale of the top at a price affordable to an average consumer, the method comprising the steps of

pre cutting [the] non man made stone into [a] the pre cut top suitable for installation by the average consumer, wherein [said] the precut top defines cut outs to accommodate at least one sink[s] and/or faucet[s],

packaging the precut top [in a box] for protecting [said] the pre cut top from [damage] breakage and scratching [wherein said box defines a cut out which allows a customer to see and touch said pre cut top],

packaging fastening means with the precut top [a container of an epoxy with said pre cut top, wherein the container of epoxy comprises two sections separated by a removable separator in which a different reactive liquid is contained in each section],

[packaging instructions for installation of the pre cut top in said box,]

[packaging a back splash with said pre cut top in said box,] and

shipping [said box] a plurality of the packaged precut tops to a [high volume] retailer for sale to and installation by the average consumer [a lay person wherein the sink can be installed by the lay person]

Application claim 66, which became patent claim 9, was amended as follows with underlining indicating additions and brackets indicating deletions.

66 (amended) A method for providing [an item as claimed in claim 44] a pre cut non man made stone top which can be installed by an average consumer and is not custom ordered by the average consumer, the method enabling assembly line production of the top and sale of the top at a price affordable to the average consumer, the method comprising the steps of

pre cutting [said] non man made stone into [a] the pre cut top [suitable for installation], wherein [said] the pre cut top defines at least one cut out to accommodate at least one of a sink or a faucet,

packaging [said] the pre cut top for protecting the [said] pre cut top from [damage] breakage and scratching [, wherein said packaging defines a portion which allows a customer to at least see said pre cut top],

packaging fastening means with [an adhesive with said] the pre cut top,

[packaging a back splash with said pre cut top], and

shipping [said] a plurality of the packaged [item] pre cut tops to a [high volume] retailer for sale to [a lay person] the average consumer wherein [said item] the packaged pre cut top can be [purchased and] installed by [said] the average consumer

## **k) Conclusions**

Several questions are answered by the foregoing. First, it is plain that the applicants used the terms "average consumer," "lay person," and "do-it-yourself" customer interchangeably. The specification, for example, refers to "[a]pplicants' slabs are designed for the 'do-it-yourself' home improvement market," "[t]he slabs can be installed easily by the lay person in less than one hour," "[i]nstallation has been made easily accomplished by the 'do-it-yourself' customer," "[t]he cutting, packaging and sale of natural stone, such as marble and granite, in this way, allows, for the first time, the purchase and installation of natural stone, by the do-it-yourself consumer," "[i]t is an object of this invention to provide an improved method to package and sell natural stone \* \* \* so that it is available to the average consumer, particularly the do-it-yourself homeowner," "[t]his invention comprises a unique method for the sale of natural stone, special packaging for the stone and a method of doing business to make the stone available \* \* \* to the average consumer." Although application claims 55 and 66 were amended to, *inter alia*, change the reference from "lay person" to "average consumer," the parties have pointed to nothing in the specification or prosecution history indicating that the applicants intended to distinguish between the two phrases. And, upon independent examination, none has been found.

Second, it appears that the applicants used those terms to refer to someone other than a person trained in stonecutting. From the specification and the foregoing prosecution history, there seems to be no dispute that prior to the invention of the '973 patent, natural stone was quarried in blocks that were thereafter shipped to locations where consumers could choose a stone for a countertop and the like, but that stone would then

need to be cut into shapes and sizes that could be installed. Such cutting required the services of someone skilled in stonecutting which added to the cost. It was that added cost that the method of the '973 patent sought to avoid. That is apparent from both the specification and the prosecution history.

For example, the specification explains that in the prior art, natural stone countertops and the like were custom ordered. "Genuine stone slabs, used for countertops or table tops, made of natural stone such as granite, are considered a very high cost luxury item that are only affordable by the affluent, and always custom made to order," "Applicants have created an assembly line approach to a product that until now has solely been considered 'a custom-made-to-order product,' \* \* \* " And that the "[t]he method comprises pre-fabricating the stone" which "brings down the price of the stone to the consumer to very attractive levels, because the cutting of stone today is done by specially trained persons on a custom basis which is very expensive."

During prosecution, the applicants similarly urged that "[u]p until Applicants' invention, natural stone has always been shipped in bulk and fabricated to size by stone craftsman [ sic ], after a piece has been selected by the consumer. This has not only been very expensive, but it has made it unavailable for sale directly to the consumer," Lundin Decl. Exh. B at B-92 to -93, "[l]arge blocks of stone have historically been cut from a quarry and shipped world-wide to stone dealers and craftsmen, which is the reason that natural stone has long been prohibitively expensive to the consumer," and "[a]pplicants have solved that problem," Id. at B-116, "Hinkle \* \* \* simply shows a machine for cutting large pieces of stone out of a quarry, and fails completely to disclose the idea of cutting the stone at or near the quarry, into prefabricated slabs ready for the consumer to utilize, without the cost of further cutting by skilled craftsmen," Id. at B-119 to -120.

The applicants attempted to capture that distinction over the prior art in claims filed prior to the RCE through the phrase "prefabricated slabs," but in the face of the examiner's continuing rejections turned to the terms "pre-cutting" and "pre-cut." In claim 1, that distinction over the prior art is further emphasized by the terms "non custom ordered" stone top, and in claim 9, a stone top that is "not custom ordered."

Thus, when application claim 55 was amended to become patent claim 1 by providing the method step of "pre cutting non man made stone into the pre cut top suitable for installation by the average consumer," and application claim 66 was amended to become patent claim 9 by similarly providing "a pre cut non man made stone top which can be installed by an average consumer" and "pre cutting non man made stone into the pre cut top, \* \* \* wherein the packaged pre cut top can be installed by the average consumer," it is plain that "average consumer" was intended to mean someone without special training in stonecutting.

Similarly, when application claim 55 was amended to become patent claim 1 by providing "to enable assembly line production and sale of the top at a price affordable to an average consumer," and application claim 66 was amended to become patent claim 9 by providing "the method enabling assembly line production of the top and sale of the top at a price affordable to the average consumer," it is apparent that "price affordable to an average consumer" was not intended to mean that a court must resolve what an "average consumer" could afford, but rather that the "pre cut top" did not require a purchaser to incur the additional costs of engaging the services of someone skilled in stonecutting. That is the "price" or "cost" referenced in the specification and prosecution history.

Likewise, when claim 1 refers to "for sale to and installation by the average consumer," and claim 9 refers to "for sale to the average consumer wherein the packaged pre cut top can be installed by the average consumer," that, in the context of the specification and prosecution history, is not a restriction on who is

allowed to purchase the product, but rather that the top has been "pre cut," packaged and shipped according to the method steps and made available for purchase and installation by someone without special training in stonecutting.

### 3. Comments on Parties' Proposed Construction- "average consumer"

In *Exxon Chemical Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1556 (Fed.Cir.1995), the court explained that "it is likely that the adversaries will offer claim interpretations arguably consistent with the claims, the specification and the prosecution history that produce victory for their side," and that "the judge's task is not to decide which of the adversaries is correct. Instead the judge must independently assess the claims, the specification, and if necessary the prosecution history, and relevant extrinsic evidence, and declare the meaning of the claims." However, the Federal Circuit has also advised that while courts have the authority to adopt claim constructions that have not been proposed by either party, "we should be hesitant to do so." *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1319 (Fed.Cir.2006). Here, doing so is required.

Home Depot's contention that, insofar as the claims may be construed, "average consumer" should be construed as "ordinary consumer," offers no help in resolving the dispute.

Romala Stone's proposed construction, *i.e.*, [a]n individual that purchases supplies for a home improvement task from a retail outlet and performs the home improvement task himself or herself, regardless of whether the individual has any professional training in that task," likewise offers no help and misses the mark. And perhaps most importantly provides further uncertainty, rather than clarification, to the claim language.

The last clause of Romala Stone's proposed construction, "regardless of whether," is essentially meaningless. The preceding clause says that an "average consumer" must both (1) "purchase[ ] supplies for a home improvement task from a retail outlet," *and* (2) perform[ ] the home improvement task himself or herself." According to that proposed construction, if an individual purchases supplies for a home improvement task, but not from "a retail outlet," such an individual would not be an "average consumer" even if the individual performs the task himself or herself. And what is the scope of "supplies" and "home improvement task"-terms not used in the claims? Similarly, according to that proposed construction, if an individual purchases "supplies" for a "home improvement task" from a "retail outlet" (assuming agreement on what those terms mean), such an individual would not be an "average consumer" if that individual did not perform the task himself or herself-according to Romala Stone's proposed construction. Neither the invention nor the claims of the '973 patent, however, turns on those factors.

As discussed above, the point made in the specification and throughout prosecution is that the subject stone tops are "pre cut" (and then packaged and shipped) such that a purchaser need not incur the additional cost of engaging the services of someone skilled in stonecutting in order to install the stone top. There is no restriction on who the purchaser must be or who the installer must be.

For example, claim 9 calls for a "method for providing a pre cut non man made stone top *which can be installed by an average consumer*," not that it *must* be installed by an average consumer. Similarly, claim 9 refers to "shipping \* \* \* to a retailer for sale to the average consumer wherein the packaged pre cut top *can be installed* by the average consumer," which in context means that the top has been "pre cut," packaged and shipped according to the method steps and made available for purchase and installation by someone without special training in stonecutting-not that someone with special training in stonecutting is precluded from purchasing and installing the same.



In claim 1, "pre cutting non man made stone into the pre cut top suitable *for installation by the average consumer*," in light of the specification and prosecution history, clearly means that the "pre cutting" permits "installation by the average consumer," *i.e.*, one without special training in stonecutting, but does not *require* the "average consumer" to actually perform the installation. In claim 1, like in claim 9, "shipping a plurality of the packaged precut tops to a retailer *for sale to and installation by the average consumer*" means in context that the top has been "pre cut," packaged and shipped according to the method steps and made available for purchase and installation by someone without special training in stonecutting-not that someone with special training in stone-cutting is precluded from purchasing and installing the same.

In short, the claimed method is directed to "[a] method for providing," and thus focuses on the objective characteristics of what is "provided" rather than the characteristics of an actual purchaser.

That construction is consistent with objects of the invention as explained in the '973 specification, *i.e.*, [1]. "It is an object of this invention to provide an improved method to package and sell natural stone through high volume stores, such as Home Depot, *so that it is available* to the average consumer, particularly the do-it-yourself homeowner," [2] "It is a further object of this invention to provide unique packaging for natural stone which protects the stone, so that it *can be sold* in high volume stores, yet have it well protected from damage," and [3] "A further object of the invention is to provide a method of selling natural stone to the consumer at prices lower than ever before possible, making it *available to* the average consumer" [Emphasis added] '973 patent, col. 2, lines 16-28. Those objects focus on the objective characteristics of the product that is "provided" rather than the characteristics of an actual purchaser. The point is that the product is such that it "can be sold" in high volume stores, not necessarily whether it is actually sold in such stores, and is made "available to" the average consumer, through performance of the claimed method steps, not that an "average consumer" must actually buy the product and install it.

That construction is also consistent with, and even more "in tune with," the remainder of the specification, *i.e.*, "[t]his method brings down the price of the stone to the consumer to very attractive levels, because the cutting of stone today is done by specially trained persons on a custom basis which is very expensive." [Emphasis added] '973 patent, col. 2, lines 43-55. "Genuine stone slabs, used for countertops or table tops, made of natural stone such as granite, are considered a very high cost luxury item that are only affordable by the affluent, and always custom made to order Never before has natural stone (granite, marble, etc.) been prefabricated and packaged to allow it to be sold in retail outlets. Applicants' invention *allows the consumer to buy these stone countertops off the shelf*" '973 patent, col. 2, lines 56-63. Again, the method steps "allow" a consumer to buy the stone tops, but do not restrict sale (or installation) to a "consumer."

And all of the foregoing, of course, was intended to differentiate the invention from the prior art in which (1) natural stone was quarried in blocks that were thereafter shipped to locations where consumers could choose a stone for a countertop or the like, (2) that stone would then need to be cut into shapes and sizes that could be installed, (3) such cutting required the services of someone skilled in stonecutting which added to the cost, and (4) it was that added cost that the method of the '973 patent sought to avoid. According to the claims of the '973 patent, that method did so by "pre cutting," packaging, and shipping pursuant to the method steps to enable sale to and installation by one who did not have training in stonecutting.

#### **D. "price affordable to an average consumer"**

Turning to the additionally proposed constructions, Romala Stone contends that "price affordable to an

average consumer" means "[a] price at which a product is made available at a retail outlet directly to an individual that purchases supplies for a home improvement task from a retail outlet and performs the home improvement task himself or herself, regardless of whether the individual has any professional training in that task." Home Depot contends that, to the extent that the phrase is subject to construction, "it should be construed to mean 'a price that an average consumer can afford.'" '

Those proposed constructions must also be rejected. Turning first to Home Depot's proposed construction, there is nothing in the specification, or prosecution history supporting, much less requiring, a construction that would depend on the subjective determination whether a price was one "an average consumer can afford." The claim language divorced from the specification and prosecution history might suggest such a construction, but that is not the correct analysis. As noted above, when there is an assertion that claim language is indefinite, "general principles of claim construction apply." *Datamte*, 417 F.3d at 1348, one of which is that the "ordinary meaning" of a term is not viewed in a vacuum, but rather one "must look at the ordinary meaning in the context of the written description and the prosecution history." *Phillips*, 415 F.3d at 1313, quoting *Medrad, Inc. v. MRI Devices Corp.*, 401 F.3d 1313, 1319 (Fed.Cir.2005). "Claim definiteness is analyzed 'not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.'" *Energizer Holdings*, 435 F.3d at 1370.

As noted above, the cost that the method of the '973 patent seeks to avoid is the cost of engaging the services of someone skilled in stonecutting in order to install the stone top. In the context of the specification and prosecution history, it is plain that "price affordable to an average consumer" was not intended to mean "a price that an average consumer can afford," *i.e.*, requiring a court to resolve what an "average consumer" could afford. Rather, the clause means in context that the "pre cut top" does not require a purchaser to incur the additional costs of engaging the services of someone skilled in stonecutting in order to install the top.

Romala Stone's proposed construction must also be rejected. Once again, the last clause of that proposed construction, "regardless of whether," provides no help in resolving the dispute. The preceding clause in the proposed construction likewise offers no help. Saying that the disputed clause means "[a] price at which a product is made available at a retail outlet directly to an individual" literally means any price. Adding that the "individual" is one "that purchases supplies for a home improvement task from a retail outlet and performs the home improvement task himself or herself" suffers from the same problems discussed above, and provides no reasonable gauge for determining the scope of the claim.

#### **E. "suitable for installation by the average consumer" and "can be installed by the average consumer"**

Turning next to "suitable for installation by the average consumer" and "can be installed by the average consumer," Romala Stone says that both phrases mean "[c]apable of being installed by an individual that purchases supplies for a home improvement task from a retail outlet and performs the home improvement task himself or herself, regardless of whether the individual has any professional training in that task," while Home Depot says that both phrases mean, to the extent those phrases can be construed, "capable of being installed by an average consumer." Again, both proposed constructions must be rejected.

As discussed above, the claims of the '973 patent are drawn to a method for providing a product. The product in terms of both claims 1 and 9 is initially described as a "pre cut" "non man made" "stone top."

Both claims also add that the top is not custom ordered (claim 1 "non custom ordered," claim 9 "not custom ordered"). Once again, the parties do not dispute the meaning of those terms, and thus presumably agree how one of ordinary skill in the art would distinguish between a "pre cut" "non man made" "stone top" that is "non custom ordered" or "not custom ordered," and one that is custom ordered. The parties have not advised on what their agreed (or uncontested), meanings are, but presumably the parties have those in hand.

In all events, the prosecution history makes clear that the patentees contended that prior to their invention, large blocks of stone were quarried and then shipped to stone dealers and craftsmen. In context, the argument was that blocks of stone were not in a form suitable for installation without further cutting. Rather, after a consumer chose a particular stone, that stone required further cutting to make it suitable for installation as a countertop and the like. That further cutting required the services of someone skilled in stonecutting. The principal reference, Hinkle, was drawn to quarrying the large blocks of stone, yet the examiner did not view "prefabricated slabs" in the claims preceding the filing of the RCE as distinguishing over Hinkle. The applicants then presented claims during the prosecution of the RCE using the terms "pre-cutting" and "pre-cut." The terms "non custom ordered" and "not custom ordered" further emphasized the distinction over the prior art.

When application claim 55 was amended to provide the method step of "pre cutting non man made stone into the pre cut top suitable for installation *by the average consumer*," and application claim 66 was amended to similarly provide "a pre cut non man made stone top *which can be installed by an average consumer*" and "pre cutting non man made stone into the pre cut top, \* \* \* wherein the packaged pre cut top can be installed by *the average consumer*," it is clear that "average consumer" was intended to mean someone without special training in stonecutting. Namely, that the stone top was "pre cut" and thus installation did not require further cutting and consequently the services of someone with special training in stonecutting.

The proposed constructions by both Romala Stone and Home Depot begin with "[c]apable of being installed" followed by proposed descriptions of the putative installer. And perhaps phrases such as "which can be installed by an average consumer" in claim 9, when divorced from the specification and prosecution history, invite such proposed constructions. But again, claims are viewed in the context of the specification and prosecution history as a whole.

The problem with "[c]apable of being installed by" is that the phrase encourages or at least permits an evaluation of the overall capabilities of an installer. That is not the point of the invention, nor what the claims were intended to mean. The actual installation of a stone countertop and the like may require several types of abilities. The invention of the '973 patent, and the invention defined by claims 1 and 9, though, is a method for providing a "pre cut" "non man made" "stone top" that is "non custom ordered" or "not custom ordered" in which the stone top may be installed without further cutting and consequently requiring the services of someone with special training in stonecutting. Once again, the claimed method is directed to "[a] method for providing," and focuses on the objective characteristics of what is "provided" rather than the characteristics of an actual purchaser.

Objectively, if a product is a "pre cut" "non man made" "stone top" that is "non custom ordered" or "not custom ordered" and that product may be installed without further cutting requiring the services of someone with special training in stonecutting, then it is one "which can be installed by an average consumer" (claim 9) or "for installation by the average consumer" (claim 1).

It should also be noted once again that the claims do not define the method in terms of any actual purchaser or installer, and likewise do not define the method in terms of any actual installation. For example, a particular installation for one reason or another may require further cutting. That a particular installation requires such cutting does not preclude a "stone top" from being one "which can be installed by an average consumer" (claim 9) or "for installation by the average consumer" (claim 1). On the other hand, if every installation required such cutting, then perhaps a different conclusion may be justified. Or perhaps such product would not constitute a "stone top" or a "pre cut" "stone top" as used in the claims pursuant to apparently agreed meanings for those terms.

The point is that the foregoing conclusions are reached on the basis of the '973 patent and its prosecution history and may or may not resolve specific issues of infringement. Questions of infringement and claim scope require an analysis of all terms in a claim. The prosecution history indicates that in the prior art, large blocks of stone were quarried and then later cut by a stone craftsman to make the stone suitable for installation as a countertop and the like. The record does not reflect how "large" such quarried stones typically were, but presumably even "large" quarried stones could be "installed" in some form in some location without further cutting, but such stones would not necessarily meet the requirements for being "pre cut," or otherwise meet the method steps of "precutting," packaging, shipping *etc.* Overall, though, questions of claim construction, as well as definiteness, are directed to, and analyzed through the eyes of, one of ordinary skill in the art—in this case, one having knowledge of the prior art methods of quarrying and later cutting stone tops, as well as knowledge of the specification and prosecution history of the '973 patent. It is believed that the claim language, coupled with the specification and prosecution history, would allow one of ordinary skill in the art to determine the scope of the asserted claims.

## **F. Definiteness.**

### **1. Background**

Section 112(2) provides that "[t]he specification shall conclude with one or more claims [1] particularly pointing out and distinctly claiming the subject matter [2] which the applicant regards as his invention." The statute thus imposes two requirements "first, it must set forth what 'the applicant regards as his invention,' and second, it must do so with sufficient particularity and distinctness, *i.e.*, the claim must be sufficiently 'definite.'" *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1377 (Fed.Cir.2000). Only definiteness is at issue here.

Although the Federal Circuit has held that a party "cannot avoid a full-blown validity analysis by raising the specter of invalidity during the claim construction phase," *Rbine v. Casto, Inc.*, 183 F.3d 1342, 1346 (Fed.Cir.1999), the Federal Circuit has also held that "[t]he question of whether the claims meet the statutory requirements of s. 112 para. 2 is a matter of construction of the claims, and receives plenary review on appeal." *§3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364, 1367 (Fed.Cir.2001). *See also* *Energizer*, 435 F.3d at 1368 ("An analysis of claim indefiniteness under s. 112 para. 2 is 'inextricably intertwined with claim construction,'" quoting *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1379 (Fed.Cir.1999)).

The court has so held despite that the analysis may involve questions of fact. *See Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1376 (Fed.Cir.2001) ("We adhere to the principle that 'determination of claim indefiniteness is a legal conclusion that is drawn from the court's performance of its duty as the construer of patent claims,'" quoting *Personalized Media Communications, L.L.C. v. United States Int'l Trade Comm'n*, 161 F.3d 696, 705 (Fed.Cir.1998)).

Accordingly, the issue of indefiniteness addressed below will be in the context of claim construction. However, doing so should not be construed as any comment or recommendation concerning any pending or later filed motions for summary judgment or otherwise on the issue of indefiniteness. *See Barry Fiala, Inc. v. Stored Value Sys., Inc.*, 2006 U.S. Dist. LEXIS 63056 (W.D. Tenn 2006) (a *Markman* ruling does not necessarily preclude an indefiniteness challenge).

In *Datamize*, the Federal Circuit explained that "[b]ecause the claims perform the fundamental function of delineating the scope of the invention, the purpose of the definiteness requirement is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude. According to the Supreme Court, '[t]he statutory requirement of particularity and distinctness in claims is met only when [the claims] clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise,' " 417 F.3d at 1347, quoting *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 236 (1942).

"The definiteness requirement, \* \* \*, does not compel absolute clarity." *Datamize*, 417 F.3d at 1347. "Only claims 'not amenable to construction' or 'insolubly ambiguous' are indefinite." *Id.* *See also* *Marley Mouldings, Ltd. v. Mikron Indus.*, 417 F.3d 1356, 1360 (Fed.Cir.2005) (When a claim "is not insolubly ambiguous, it is not invalid for indefiniteness") (citation and quotation omitted), *Bancorp Servs., L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1371 (Fed.Cir.2004) ("We have held that a claim is not indefinite merely because it poses a difficult issue of claim construction, if the claim is subject to construction, *i.e.*, it is not insolubly ambiguous, it is not invalid for indefiniteness.").

"Thus, the definiteness of claim terms depends on whether those terms can be given any reasonable meaning. Furthermore, a difficult issue of claim construction does not *ipso facto* result in a holding of indefiniteness" *Datamize*, 417 F.3d at 1347. "If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which reasonable persons will disagree, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds." ' *Id.*, quoting *Exxon Research & Engineering*, 265 F.3d at 1375. "In this regard it is important to note that an issued patent is entitled to a statutory presumption of validity. 'By finding claims indefinite only if reasonable efforts at claim construction prove futile, we accord respect to the statutory presumption of validity and we protect the inventive contribution of patentees, even when the drafting of their patents has been less than ideal.' " ' *Datamize*, 417 F.3d at 1347-48 (citation omitted), quoting *Exxon Research & Engineering*, 265 F.3d at 1375. "In this way we also follow the requirement that clear and convincing evidence be shown to invalidate a patent." *Datamize*, 417 F.3d at 1348.

"Claim definiteness is analyzed 'not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.' " *Energizer Holdings*, 435 F.3d at 1370, quoting *In re Moore*, 439 F.2d 1232, 1235 (C.C.P.A.1971). "The definiteness inquiry 'focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification.' " *Energizer Holdings*, 435 F.3d at 1370, quoting *Union Pac Res Co. v. Chesapeake Energy Corp.*, 236 F.3d 684, 692 (Fed.Cir.2001).

Accordingly, "[i]n the face of an allegation of indefiniteness, general principles of claim construction apply. Intrinsic evidence in the form of the patent specification and file history should guide a court toward an acceptable claim construction. And while 'we have emphasized the importance of intrinsic evidence in claim construction, we have also authorized district courts to rely on extrinsic evidence,' such as expert testimony.

In constructing claims, 'what matters is for the court to attach the appropriate weight to be assigned to those sources in light of the statutes and policies that inform patent law.' ' Datamize, 417 F.3d at 1348 (citations omitted). And "[t]he reviewing tribunal must determine whether a person experienced in the field of the invention would understand the scope of the claim when read in light of the specification." Energizer Holdings, 435 F.3d at 1369. *See also* Howmedua, 401 F.3d at 1371 (citation omitted) ("The perspective of a person of ordinary skill in the art at the time of the patent application governs the definiteness analysis. The definiteness of a patent claim depends on whether one skilled in the art would understand the bounds of the claim when read in light of the specification.").

## 2. The Showing of Indefiniteness In This Case

Home Depot's contention that the disputed terms are not amenable to construction because none of the claim language, written description, prosecution history, or extrinsic evidence provides an objective standard that allows the public to determine the scope of the claimed invention, is not persuasive.

First, terms such as "average consumer" do not make a claim *per se* indefinite. Claim construction is a question of law, and the law is replete with instances in which the standard for determining a legal outcome is a hypothetical person. For example, s. 103 of the patent statute requires that validity in terms of obviousness be judged by reference to "a person having ordinary skill in the art." *See* Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1566 (Fed.Cir.1987) ("With the involved facts determined, the decisionmaker confronts a ghost, *i.e.*, a person having ordinary skill in the art,' not unlike the 'reasonable man' and other ghosts in the law").

Design patent infringement is based on an "ordinary observer". *See* Amint Innovation Corp. v. Anthony Cal., Inc., 439 F.3d 1365, 1371 (Fed.Cir.2006) (alteration in original) ("An ordinary observer test governs design patent infringement. '[I]f in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive an ordinary observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.").

Trademark law employs a "reasonably prudent person," or "reasonably prudent consumer," or, in some instances, a "discriminating purchaser." *See* Weiss Assois, Inc. v. HRL Assois, Inc., 902 F.2d 1546, 1548 (Fed.Cir.1990) ("In making purchasing decisions regarding 'expensive' goods, the reasonably prudent person standard is elevated to the standard of the 'discriminating purchaser." ). *Nautilus Group, Inc. v. Lion Health & Fitness, Inc.*, 372 F.3d 1330, 1334 (Fed.Cir.2004) ("Under Ninth Circuit law, the core element of trademark infringement is whether the 'reasonably prudent consumer' is likely to be confused 'as to the origin of the good or service bearing one of the marks." ).

Standards such as "a person having ordinary skill in the art," "an ordinary observer," "a reasonably prudent person," "a reasonable man" and the like are not as concise as say a number or some other term that carries a precise definition. Nevertheless, such standards are deemed "objective" because those standards do not depend on the subjective beliefs of the parties. *See, e.g.*, *United States v. Brown*, 441 F.3d 1330, 1347 (11th Cir.2006), *cert. denied sub nom Brown v. United States*, 2007 U.S. LEXIS 1213 (2007) (citation omitted) ("Whether Brown was in custody prior to his formal arrest 'depends on whether under the totality of the circumstances, a reasonable man in his position would feel a restraint on his freedom of movement to such extent that he would not feel free to leave.' 'The test is objective the actual, subjective beliefs of the defendant and the interviewing officer on whether the defendant was free to leave are irrelevant" ), Trevino

v. Johnson, 168 F.3d 173, 178 (5th Cir.1999) ("The recusal standard is objective, the relevant inquiry is whether a reasonable man, were he to know all the circumstances, would harbor doubts about the judge's impartiality."), *In re Cmty Bank of N, Va Mortg Lending Practices* Litig., 418 F.3d 277, 320 (3d Cir.2005) (same), *Advantage Consulting Group, Ltd v. ADT Sec Sys., Inc .*, 306 F.3d 582, 589 (8th Cir.2002) ("a party's 'satisfaction' will be determined under an objectively-reasonable-man standard, and not on the basis of the contracting party's own subjective standard").

When the Federal Circuit in *Datamize* referred to the lack of any "objective definition" for "aesthetically pleasing," the court was using "objective" in the foregoing sense, *i.e.*, not dependent on the subjective beliefs of the parties. According to the court, "Datamize believes a reasonable construction of 'aesthetically pleasing' in the context of the claims involves the intent, purpose, wish, or goal of a person practicing the invention that person simply must intend to create an 'aesthetically pleasing' interface screen, whether that person actually succeeds is irrelevant. In other words, Datamize suggests we adopt a construction of 'aesthetically pleasing' that only depends on the subjective opinion of a person selecting features to be included on an interface screen. Indeed, Datamize argues that the district court erred by requiring an objective definition for the phrase 'aesthetically pleasing.'" ' 417 F.3d at 1349. In response, the court remarked. "The scope of claim language cannot depend solely on the unrestrained, subjective opinion of a particular individual purportedly practicing the invention." *Id.* at 1350.

Also, the Federal Circuit noted in *Datamize* that neither the specification nor the prosecution history provided any non-subjective standard for "aesthetically pleasing." With respect to the specification, the Federal Circuit commented that:

The description of the advantages of the invention indicates that there are 'good standards of aesthetics,' which of course implies that there are also standards of aesthetics that are 'not good.' The inventor does not attempt to explain what distinguishes the two, except to say that experts, specialists, and academics may have views that are influential in determining what aesthetic standards are good. \* \* \* There is no indication, however, other than by referring to 'the considered opinions of aesthetic design specialists, database specialists, and academic studies on public access kiosk systems and user preferences and problems,' how to determine what button styles, sizes, and placements, for example, are 'aesthetically pleasing.' Moreover, whatever the considered opinions of unnamed people and studies say is altogether unclear. \* \* \* [O]ne skilled in the art reading the specification is left with the unhelpful direction to consult the subjective opinions of aesthetic design specialists, database specialists, and academic studies.

417 F.3d at 1352 (paragraphing omitted).

With respect to the prosecution history, the Federal Circuit in *Datamize* noted that statements by the prosecuting attorney likewise failed to delineate the claimed invention. According to the court, "[b]y arguing that 'aesthetically pleasing' does not depend on any standard of aesthetics other than a purely subjective standard held by any person who steps into the role of the system creator, the prosecuting attorney would eliminate any objective meaning for the phrase 'aesthetically pleasing' As discussed, this would be improper." 417 F.3d at 1353.

Datamize also relied on extrinsic evidence, namely a declaration by its expert that "[t]he terms 'aesthetic' and 'aesthetically pleasing' in the patent serve to make it clear that the motivation of limiting selection is to allow the system creator to enforce his/her will regarding the "look and feel" and aesthetic aspects rather than solely functionality." ' The expert also provided a list of "generally accepted" parameters that

contributed to a display getting high marks from users for being "aesthetically pleasing." The expert testified that in his opinion "one of ordinary skill in the art of soft-ware development of kiosks and computer user interfaces would understand the claims and be able to determine whether their own work was or was not covered by the claims in question."

The Federal Circuit rejected that testimony noting that "while indefiniteness does not depend on the difficulty experienced by a particular person in comparing the claims with the prior art or the claims with allegedly infringing products or acts, even the expert could not determine whether the look and feel of particular interface screens are 'aesthetically pleasing' using the parameters he specified, instead testifying that whether an interface screen is 'aesthetically pleasing' is a 'multidimensional question' that is 'not amenable to a single-word answer.' The inability of the expert to use the parameters he himself identified to determine whether an interface screen is 'aesthetically pleasing' militates against the reasonableness of those parameters as delineating the metes and bounds of the invention." *Id.* at 1353-54 (citation omitted).

In contrast to *Datamize*, here both the specification and the prosecution history leave little doubt that "average consumer" means someone without special training in stonecutting, *i.e.*, an objective standard *per se*, in addition to being one divorced from the parties or one practicing the invention. Similarly, it is clear that "price affordable to an average consumer" does not mean what such language might imply to one reading the same divorced from the specification and prosecution history, but rather that the "pre cut top" does not require a purchaser to incur the additional costs of engaging the services of someone skilled in stonecutting. For the same reasons, "for sale to and installation by the average consumer," in claim 1, and "for sale to the average consumer wherein the packaged pre cut top can be installed by the average consumer," in claim 9, in the context of the specification and prosecution history, clearly are not restrictions on who is allowed to purchase the product, but rather mean that the top has been "pre cut," packaged and shipped according to the method steps and made available for purchase and installation by someone without special training in stonecutting.

Second, relative terms "such as 'approach each other,' 'close to,' 'substantially equal,' and 'closely approximate' are ubiquitously used in patent claims and [ ] such usages, when serving reasonably to describe the claimed subject matter to those of skill in the field of the invention and to distinguish the claimed subject matter from the prior art, have been accepted in patent examination and upheld by the courts." *Anchor Wall Sys, Inc. v. Rockwood Retaining Walls, Inc.*, 340 F.3d 1298, 1311 (Fed.Cir.2003) (describing holding in *Andrew Corp. v. Gabriel Elecs, Inc.*, 847 F.2d 819, 821-22 (Fed.Cir.1988)). "[W]hile ideally, all terms in a disputed claim would be definitively bounded and clear, such is rarely the case in the art of claim drafting." *Anchor Wall Systems*, 340 F.3d at 1311. The Federal Circuit has found terms of approximation such as "generally parallel," *id.* at 1310-11, "substantially constant wall thickness," *Verve, LLC v. Crane Cams, Inc.*, 311 F.3d 1116, 1119-20 (Fed.Cir.2002), and "substantially uniform," *Ecolab, Inc. v. Envirochem, Inc.*, 264 F.3d 1358, 1367 (Fed.Cir.2001), to be sufficiently definite when considered in the context of the intrinsic evidence and extrinsic evidence.

Third, cases decided in the wake of *Datamize* have generally concluded that claims are not rendered indefinite if the meaning of a disputed term or phrase is reasonably discernable from the intrinsic and extrinsic record. *See Sienna LLC v. CVS Corp.*, 2007 U.S. Dist. LEXIS 2 (S.D.N.Y.2007) (finding that "excessive manual force" did not render claims indefinite even though not all individuals are equally strong). *Wireless Agents, L.L.C. v. Sony Ertisson Mobile Communications AB*, 2007 U.S. Dist. LEXIS 6888 (N.D.Tex.2007) ("generally parallel" did not render claims indefinite), *Aventis Pharma Deutschland GmbH v. Lupin Ltd.*, 2006 U.S. Dist. LEXIS 31960 (E.D.Va.2006) (finding that "substantially free of other



isomers" did not render claims indefinite), *Star Lock Sys., Inc. v. Dixte-Narvo, Inc.*, 455 F.Supp.2d 723, 731 (S.D.Ohio 2006) ("axial cinching force" did not render claim indefinite despite that term did not appear in the specification), *Computer Docking Station Corp. v. Dell, Inc.*, 2006 U.S. Dist. LEXIS 58388 (W.D.Wis.2006) ("one of each of" did not render claim indefinite where meaning was clear from the prosecution history), *Superior Graphite Co. v. Timcal SA*, 2006 U.S. Dist. LEXIS 29935 (N.D.Ill.2006) ("bulk volume" not indefinite based on extrinsic evidence), *Goff v. Harrah's Operating Co.*, 412 F.Supp.2d 1090, 1103-04 (D.Nev.2005) ("substantially equal" did not render claims indefinite where the specification provided a basis for determining what degree of equality was required), *Medtronic Xomed, Inc. v. Gyrus ENT LLC*, 440 F.Supp.2d 1300, 1327 (N.D.Fla.2006) ("remains essentially within the instrument" in the court's claim construction order did not render claim indefinite), *Billingnetwork Patent, Inc. v. Cerner Physician Practice, Inc.*, 2006 U.S. Dist. LEXIS 5995 (M.D.Fla.2006) ("appropriate application software" did not render claim indefinite based on the claim language and specification).

Cases in which claims were found indefinite were those in which the meaning of a disputed term or phrase was not reasonably discernable from the intrinsic and extrinsic record. In *Halliburton Energy Services v. MI, LLC*, 456 F.Supp.2d 811 (E.D.Tex.2006), for example, the court concluded that it could not construe "fragile gel drilling fluid" or "fragile gel" such that those terms would have a meaning that was not purely subjective. In *E-Watch, Inc. v. March Networks Corp.*, 2006 U.S. Dist. LEXIS 54366 (E.D.Tex.2006), dependent claims referred to "the server". The parent claim recited at least two servers, and it was uncertain which "the server" referred to. The court referred to the choice as a "toss-up" and held the claims indefinite. Other claims referring to "said sensor" were likewise held indefinite where the parent claim(s) called for at least two sensors and it was unclear which sensor "said sensor" referred to.

In *Young v. Luments, Inc.*, 2005 U.S. Dist. LEXIS 27792 (S.D.Ohio 2005), one of the claims-at-issue, drawn to a surgical method, called for "forming a first circumferential incision in the epiderms *near* the edge of the unguis crest of the claw". The court found that "near" did not distinguish the claim from the prior art, and therefore rendered the claim indefinite.

In *Leggett & Platt, Inc. v. VUTEk, Inc.*, 2006 U.S. Dist. LEXIS 93024 (E.D.Mo.2006). L & P was the owner of a patent drawn to cold UV printing technology used to print heat-sensitive substrates such as poster board, foam board or rigid plastics without deforming the substrate. VUTEk argued, *inter alia*, that the district court's reference to "acceptable print quality" in its *Markman* definition of "deform, deforming or deformation" rendered the claims indefinite because print quality was subjective. The district court had construed "deform, deforming, and deformation" to mean "a change in the shape or form of a substrate which degrades print quality such that the print is unacceptable for its intended purpose". The district court noted that "[t]he parties here agree that acceptable print quality always requires a level of subjectivity." The court concluded that "[t]his, like 'aesthetically pleasing,' is too indefinite to meet the requirement of s. 112. Yet I continue to conclude that no more precise definition of 'deform' is reasonable. As a result, the claim terms deform, deforming, and deformation are not capable of reasonable construction, and the claims are indefinite."

In *Fargo Elecs., Inc. v. Ins. Ltd., Inc.*, 2005 U.S. Dist. LEXIS 34493 (D.Minn.2005), the claim-at-issue called for "the second supports other than the." The district court concluded that the claim contained a mistake that was not correctable under *Novo Industries, L.P. v. Micro Molds Corp.*, 350 F.3d 1348 (Fed.Cir.2003). Accordingly, the court concluded that the claim was not susceptible to a reasonable construction and was indefinite.

In *Raikable Systems, Inc. v. Super Micro Computer, Inc.*, 2006 U.S. Dist. LEXIS 81432 (N.D.Calif.2006), the court concluded that "front" as used in one of the patents-in-suit, and "components requiring intermittent physical access" rendered the claims indefinite because "both terms-'periodic' and 'intermittent'-suggest time frames, and a certain regularity that depends on a user's purpose."

In *Aiatia Media Technologies Corp. v. New Destiny Internet Group*, 405 F.Supp.2d 1127 (N.D.Calif.2005), the court held that the coined terms "sequence encoder" and "identification encoder" rendered the claims indefinite. The term "sequence encoder" was not defined in the specification and was not referenced during prosecution. Based on the specification and claim language, the court could not discern a reasonable meaning for the term. The term "identification decoder" was referenced in the specification in terms of function, but, according to the court, there was no description of any structure. The court wrote that "[c]laiming an apparatus using only a block diagram with functional description is indefinite when the patentee names the device using a coined term and the various functions could be performed by an indefinite variety of devices." *Id.* at 1140.

Accordingly, the master concludes that the asserted claims are not "insolubly ambiguous" or not amenable to a reasonable construction in light of the specification and prosecution history. However, the master reaches that conclusion in the context of claim construction on a record that is perhaps different from that of a motion for summary judgment of invalidity based on claim indefiniteness. Accordingly, nothing should be taken in herein as deciding that the claims are-or are not-indefinite and therefore invalid (or valid) under s. 112(2).

## **G. Recommendation**

Accordingly, the master recommends that the Court construe

- (1) "average consumer" to mean one without special training in stonecutting,
- (2) "price affordable to an average consumer" to mean that a "pre cut" "non man made" "stone top" in accordance with other terms in the claims does not require a purchaser to incur the additional costs of engaging the services of someone skilled in stonecutting in order to install the top,
- (3) "suitable for installation by the average consumer" and "can be installed by the average consumer" to mean a "pre cut" "non man made" "stone top" in accordance with other terms in the claims that is "non-custom ordered" or "not custom ordered" also in accordance with other terms in the claims, and that product may be installed without requiring the services of someone with special training in stonecutting.

## **V.**

**"packaging the precut top for protecting the pre cut top from breakage and scratching"**

### **A. The Parties' Proposed Construction**

The parties' respective proposed constructions are as follows:

Claim Term	Romala Stone's Proposed Construction	Home Depot's
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		Proposed Construction
"packaging the precut top for protecting the pre cut top from breakage and scratching"	Packaging the pre-cut top by a method disclosed in order to protect the pre-cut top from breakage and scratching	Placing the precut top into a box
	JCC Brief at A1-5 and B-3	JCC Brief at A2-5 and B-3
	Plf CC Brief at 20	Def CC Brief at 16 & Ex. A at A-2

## B. Discussion

### 1. Claims

Beginning with the claim language, claim 1 calls for "packaging the precut top for protecting the pre cut top from breakage and scratching." Claim 9 calls for "packaging the pre cut top for protecting the pre cut top from breakage and scratching."

The claims do not call for a "box," and, although Home Depot changed its argument somewhat during the *Markman* hearing (an issue that is discussed below), it appears that the parties' sole dispute in terms of the foregoing proposed constructions is whether the claims should nevertheless be limited to placing the pre-cut top "into a box." Home Depot argues that one of ordinary skill in the art would construe the phrase as it proposes because that is the only method disclosed. Home Depot's Response at 22-23. Romala Stone, on the other hand, urges that the Federal Circuit has "repeatedly warned against limiting the scope of patent claims to only those embodiments disclosed in the specification." Romala Stone's Response at 10.

### 2. Single Embodiment Specifications

In *Philips*, the Federal Circuit explained that "although the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments. In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment. That is not just because section 112 of the Patent Act requires that the claims themselves set forth the limits of the patent grant, but also because persons of ordinary skill in the art rarely would confine their definitions of terms to the exact representations depicted in the embodiments." 415 F.3d at 1323 (citations omitted). *See also* Liebel-Flarsheim Co. v. Medrad, Inc., 358 F.3d 898, 906 (Fed.Cir.2004) ("Even when the specification describes only a single embodiment, the claims of the patent will not be read restrictively unless the patentee has demonstrated a clear intention to limit the claim scope using 'words or expressions of manifest exclusion or restriction.' ")

However, the Federal Circuit has also explained that " '[w]hether a claim must, in any particular case, be limited to the specific embodiment presented in the specification, depends in each case on the specificity of the description of the invention and on the prosecution history.' " *Id.* at 907, quoting *Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1331 (Fed.Cir.2000). And the Federal Circuit has written that "the characterization of [a limitation] as part of the 'present invention' is strong evidence that the claims should

not be read to encompass the opposite structure." *SaMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343 (Fed.Cir.2001).

On the other hand, the Federal Circuit has noted that "there is sometimes a fine line between reading a claim in light of the specification, and reading a limitation into the claim from the specification." *Comark*, 156 F.3d at 1186-87, but that "the line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms." *Phillips*, 415 F.3d at 1323. Nevertheless, that is an issue that has divided the court. *See, e.g., I'entana Med. Sys., Inc. v. Brogenex Labs., Inc.*, 473 F.3d 1173, 1185 (Fed.Cir.2006) (Lourie, J., dissenting).

Turning first to the specification, the abstract explains that "[t]his invention comprises [1] a unique method for the sale of natural stone, [2] special packaging for the stone and [3] a method of doing business to make the stone available in high volume stores to the average consumer." '973 patent, abstract (brackets added). That, of course, suggests that the "invention" has three aspects of which "special packaging" is one.

The abstract continues by explaining that "[t]he method comprises pre-fabricating the stone \* \* \*," and that "[t]he pre-fabricated stone is then packaged in a box or carton which is designed to specially protect the stone, especially at the corners where most damage occurs, and shipping the packages to high volume, do-it-yourself consumer outlets." '973 patent, abstract. That suggests that "[t]he method" disclosed includes packaging "in a box or carton which is designed to specially protect the stone, especially at the corners where most damage occurs." 37 C.F.R. s. 1.72(b) ("A brief abstract of the technical disclosure in the specification \* \* \* "). The purpose of an abstract, according to the PTO rules of practice, "is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure ." Specifically, the abstract refers to the "technical disclosure," which may or may not be commensurate with the claims. *See M.P.E.P. s. 608.01(p)* (8th ed., rev.5, August 2006). Nevertheless, the Federal Circuit has held that it has "frequently looked to the abstract to determine the scope of the invention." *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 1341 n. 1 (Fed.Cir.2000).

Under the heading "Objects of the Invention," the first listed "object" is "[i]t is an object of this invention to provide an improved method to package and sell natural stone through high volume stores, such as Home Depot, so that it is available to the average consumer, particularly the do-it-yourself homeowner." '973 patent, col. 2, lines 16-19. That, of course, does not limit the "packaging" to a box or carton.

The second listed "object" is "[i]t is a further object of this invention to provide unique packaging for natural stone which protects the stone, so that it can be sold in high volume stores, yet have it well protected from damage. " '973 patent, col. 2, lines 20-24. That, consistent with the abstract, suggests that the disclosure may include more than one "invention," of which the "special packaging" (abstract) or "unique packaging" (specification) is one.

The specification, under the heading "Summary of the Invention," says that "[t]his invention comprises a unique method for the sale of natural stone which includes [1] special packaging and [2] a method of doing business \* \* \* " '973 patent, col. 2, lines 32-35 (brackets added). That once again suggests that the disclosure may include more than one "invention," of which the "special packaging" is one.

The specification, though, in the same location explains that "[t]he pre-fabricated stone is then packaged in a

box or carton which is designed to specially protect the stone, especially at the corners where most damage occurs, \* \* \* " '973 patent, col. 2, lines 47-50. That is in a context of describing "[t]he method."

The specification further explains that "[t]he unique packaging system developed by Applicants allows for shipping to stores and placement into inventory, easily displayed on shelves, and transported home by customers without breaking, chipping or scratching Installation has been made easily accomplished by the 'do-it-yourself' customer." '973 patent, col. 3, lines 13-18. That again suggests that the disclosure includes more than one invention of which the "unique packaging" is one.

The drawings in the '973 patent are entirely devoted to the packaging. For example, under the heading "Brief Description of the Drawings," the '973 patent lists:

FIG 1 is a perspective view of the outer container of this invention,

FIG 2 is a perspective view of the total package, opened out,

FIG 3 is a top plan view of the insert opened out,

FIG 4 is a perspective view of the insert assembled,

FIG 5 is a top plan view of the inner container, opened out,

FIG 6 is a perspective view of the inner container closed,

FIG 7 is a perspective view of the first fold of one corner of the inner container,

FIG 8 is a perspective view of the second fold of the corner,

FIG 9 is a perspective view of the third fold of the corner, and

FIG 10 is a perspective view of the corner fully folded.

all of which refer to "this invention." But again, the disclosure describes at least two inventions, of which the "unique packaging" is one. In context, "this invention" in describing the drawings refers to that packaging.

### **3. Prosecution History**

Turning to the prosecution history, the application maturing into the '973 patent originally presented 20 claims, of which claims 1, 8 and 16 were independent. Claim 1 (and its dependent claims 2-7) was drawn to "[a] method of selling natural stone to the average consumer." Original claim 1 called for, *inter alia*, "packaging the stone *in a box* which protects the stone from damage." [Emphasis added] Original claims 8 and 16 were drawn to "[a] package designed to protect and ship a slab of natural stone comprising *an outer box* \* \* \* " [Emphasis added] As discussed above, the examiner required restriction between Group I, claims 1-7, and Group II, claims 8-20. The applicants chose Group I. Although claims 1-7 did not recite the details of the packaging with the specificity of claims 8-20, those claims all called for "packaging the stone *in a box* which protects the stone from damage." [Emphasis added].

As also discussed above, in response, the applicants, *inter alia*, added claims 21-28. Claim 21 called for "packaging each stone slab *in a box* which protects the stone slab from damage." [Emphasis added.]. The language in the other independent claims, *i. e.*, claims 22 and 28, was the same. The examiner, in rejecting the claims, relied on Orr *et al.* as disclosing "a method of packaging container [ *sic.*] for shipping and displaying an article for sale \* \* \*." The applicants argued that Orr *et al.*, disclosed packages for a sink, and that. 'Applicants' invention specifically does not include a sink." Lundin Decl. Exh. B at B-116.

When the applicants filed their RCE they presented new claims 30-56. Independent claim 30 called for "packaging the pre-cut top *in a box* for protecting said pre-cut top from breakage." [Emphasis added.] Claim 44 was drawn to "[a]n item for installation," and did not call for any packaging. However, dependent claim 49 called for "wherein said stone top is prepackaged for protecting said top from breakage," *i. e.*, the claim did *not* call for "in a box" Claim 52 similarly called for "packaging said stone top to protect it from breakage," *i. e.*, not necessarily "in a box." Independent claim 53 was drawn to "[a] pre-cut non man-made top," and did not call for any packaging. Independent claim 54 was drawn to "[a] method for providing a countertop," and also did not call for any packaging. Independent claim 55 called for "packaging the pre-cut top *in a box* for protecting said pre-cut top from damage, \* \* \*." [Emphasis added.] Claim 56 called for "*a box* for packaging said pre-cut top \* \* \*." [Emphasis added.]

Thus, throughout the prosecution up to this point, most, *but not all*, pending claims called for packaging "in a box." At least some claims were not restricted to "in a box."

The applicants later filed new claims 57-66. New claim 60 called for "packaging said pre-cut top to protect said pre-cut top from breakage." The packaging was not restricted to "in a box." New claim 60 was dependent from claim 46 which in turn was dependent from claim 44 which, as noted above, did not call for any packaging. However, claim 61, dependent from claim 60, called for "packaging a backsplash for use with said pre-cut top in *said box*." [Emphasis added.] There was no antecedent basis for "said box." New claim 66 called for "packaging said pre-cut top for protecting said pre-cut top from damage \* \* \*," *i. e.*, the packaging was not restricted to "in a box."

Claim 55 was then amended and became patent claim 1, as discussed above. One of the amendments to claim 55, "packaging the precut top [] for protecting [] *the* pre cut top from [] *breakage and scratching* []," deleted "in a box." Claim 31 was amended to depend from claim 55 and was further amended to delete "said box." Claim 37 was also amended to depend from claim 55, and was amended to delete "in said box." Lundin Decl. Exh. B at B-201 to -203.

Claim 66 was amended, "packaging [] *the* pre cut top for protecting *the* [] pre cut top from [] *breakage and scratching* []," to change "damage" to "breakage and scratching," and to delete "wherein said packaging defines a portion which allows a customer to at least see said pre cut top," which refers to what other claims referred to as a "cut-out," Earlier claims drawn to the "cut-out" referred to a "box," *e.g.*, original claim 7 called for "in which a cut-out is provided *in each box* which allows the consumer to see and touch the natural stone confined therein," claim 27 called for "cutting an opening *in each box* which allows the consumer to see and touch the natural stone contained therein," claim 28 had similar language, and claim 31, prior to amendment, called for "wherein *said box* defines a cut-out which allows a customer to see and touch said pre-cut top." [Emphasis added.]

The prosecution history thus strongly suggests that the deletion of "in a box" from the claims as issued was

deliberate and intentional. That change was also made in connection with the backplash. Claim 37 originally called for "wherein in the step of packaging further comprises packaging a backplash with said pre-cut top *in said box*." [Emphasis added.] Claim 37 was amended to depend from claim 55, and to delete reference to "in said box," *i.e.*, "wherein [in] the step of packaging further comprises packaging a backplash with [] *the* pre-cut top []."

#### 4. Conclusion

This case is analogous to *Liebel-Flarsheim*, 358 F.3d 898. The question there was whether the asserted claims to certain powered fluid injectors, used to inject fluids into patients during medical procedures, required "pressure jackets." The accused products did not have such "pressure jackets." The asserted claims likewise did not expressly recite such "pressure jackets," but the district court construed the claims as requiring the same and granted summary judgment of non-infringement. On appeal, the Federal Circuit reversed.

The specification in *Liebel-Flarsheim* disclosed only embodiments having such "pressure jackets," but did not, according to the Federal Circuit, disclose that such jackets were required. "The asserted claims do not expressly require pressure jackets, and the common specification does not state that a pressure jacket is a required component of the inventions." 358 F.3d at 903.

"Moreover," the court reasoned, "even if the original disclosure supported Medrad's contention that the invention, as originally conceived, required the use of a pressure jacket, the prosecution history of the [patents-in-suit] makes clear that the patentee drafted the asserted claims specifically to cover injectors lacking pressure jackets. *In light of the applicants' clearly stated intention to cover jacketless injectors, any question regarding the support or lack of support for the claims in the original disclosure bears on the issues of priority and validity, not on the issue of claim construction.* Accordingly, for the reasons more fully set forth below, we conclude that the district court erred by construing the asserted claims to require pressure jackets." [Emphasis added.] *Id.*

Specifically, the court in *Liebel-Flarsheim* noted that "the prosecution history of the [parents-in-suit] is squarely contrary to [the] contention that all the claims of those two patents require injectors that use pressure jackets." During prosecution, the applicants had replaced claims that had included references to a pressure jacket with new claims, many of which did not include the pressure jacket limitation. According to the court, "[t]he omission of reference to a pressure jacket in many of the claims of the applications that matured into the [patents-in-suit] is a strong indication that the applicants intended those claims to reach injectors that did not use pressure jackets." 358 F.3d at 909.

The situation here is similar. Although the specification clearly discloses a box or carton as part of its "special" or "unique" packaging, the examiner viewed that packaging as an invention distinct from the presently claimed invention. Although the specification plainly touts the benefits of using that packaging, the specification does not "require" that "special" or "unique" packaging for the presently claimed invention, and also does not more broadly "require" that the packaging consist of a box or carton. Although it is possible, perhaps, that boxes or cartons, as opposed to other types of packaging, are in essence required by the nature of the goods, such evidence is not of record.

Any doubt left from the specification, however, is effectively removed by the prosecution history. It is clear from the prosecution history that claims that required "in a box" and words to that effect were replaced with

at least some claims that did not so require, and ultimately issued claims were specifically amended to delete references to "in a box," not only in the base claims, but in dependent claims as well. As the court reasoned in *Liebel-Flarsheim*, that is "a strong indication" that the claims were not intended to be limited to a "box." FN8 Once again, the Federal Circuit advised in *Phillips* that "the line between construing terms and importing limitations can be discerned with reasonable certainty and predictability if the court's focus remains on understanding how a person of ordinary skill in the art would understand the claim terms." 415 F.3d at 1323.

FN8. In *Liebel-Flarsheim*, there was also evidence that "the applicants learned about Medrad's jacketless injector and sought to omit reference to the pressure jacket in the asserted claims in order to encompass Medrad's injector." 358 F.3d at 909. The record does not reflect whether Romala Stone similarly had notice of Home Depot's alleged infringement during the prosecution of the application maturing into the '973 patent. However, the declaration by co-inventor Alpert refers to alleged infringement by two other comparues. Lundin Decl. Exhibit B at B-166, para. 12. The record does not reflect whether that alleged infringement contributed to the claim amendments or not.

In light of the foregoing, the master concludes that the prosecution history leaves no doubt that the applicants intended that the issued claims should not be limited to packaging "in a box ." Accordingly, Home Depot's proposed construction must be rejected. As the court in *Liebel-Flarsheim* reasoned, the question then becomes one of support in the specification, rather than an issue of claim construction. And, in *Liebel-Flarsheim Co. v. Medrad, Inc. (Liebel II)*, \_\_\_ F.3d \_\_\_ (Fed.Cir.2007), the Federal Circuit, noting "beware of what one asks for," concluded that the asserted claims that had been construed as not requiring a "pressure jacket" were invalid under s. 112(1), for failing to provide an enabling disclosure.

As for Romala Stone's proposed construction, "[p]ackaging the pre-cut top by a method disclosed in order to protect the pre-cut top from breakage and scratching" is not significantly different from the claim language, *i.e.*, "packaging the precut top for protecting the pre cut top from breakage and scratching," except for the addition of "by a method disclosed." The addition of "by a method disclosed," however, detracts, rather than adds, to the clarity of the claim. What is the scope of the "method disclosed"? Which leads to the discussion at the *Markman* hearing.

## 5. Markman Hearing

At the *Markman* hearing, Home Depot urged that what they really meant by "in a box," was the box described in the specification. *Markman*. Tr. at 56-85:

The Special Master \* \* \* And your proposed construction is that the packaging step must be limited to the actual structure of the box disclosed in the specification, is that correct?

Mr. Lundin. That's correct.

Tr. at 85, lines 4-14. Post-hearing briefing on the issue was offered, Tr. at 101-102, however, the parties subsequently declined.

At the hearing. Home Depot argued that "packaging" had a "special meaning in the context of this patent," and that "[y]ou know, the patentee has acted as a lexicographer to apply a particular meaning to packaging."



Tr. at 63-64. That argument is simply misplaced and unpersuasive. In the context of the specification, the patentees plainly did not redefine or give a particular meaning to "packaging." Rather, the patentees referred to the specific "packaging" described in the specification as "designed to specially protect," "unique packaging," "which includes special packaging," "a box or carton which is designed to specially," "unique packaging system."

Second, the prosecution history offers no support for that argument, and, indeed, counsels to the contrary. As originally submitted, claims 1-7 were drawn to "[a] method of selling natural stone" and claim 1 called for "packaging the stone in a box which protects the stone from damage" Claims 8-15 were drawn to "[a] package designed to protect and ship a slab of natural stone" and included the details of the disclosed packaging, for example in claim 8 "an outer box," "an inner box," *etc.* Claims 16-20 were drawn to "[a] package designed to protect and slip a slab of natural stone," also including the details of the disclosed packaging including "an outer box," "an inner box," "said inner box having four foldable corners \* \* \*." *etc.* Thereafter, the applicants elected to prosecute the invention of claims 1-7, and, as discussed above, during the course of doing so, deleted references to "in a box."

To be sure, the patentees regarded the packaging described in the specification as one of their inventions, and regarded that packaging as preferred in practicing the related method, but the specification and prosecution history simply do not support Home Depot's contentions. It is clear from the specification that the patentees did not give a "special meaning" to "packaging," or that the patentees acted as their own lexicographers in redefining "packaging," and the prosecution history plainly indicates that the patentees did not intend for the claims to be limited to a "box," much less the specific "box" disclosed in the specification.

### **C. Recommendation**

In the end, the master believes that the claim language is clear and does not require further construction. To the extent that the parties dispute whether the "packaging" limitation requires a "box," or whether that limitation is restricted to the "box" disclosed in the specification, the foregoing indicates that it is not.

Accordingly, the master recommends that the Court construe the disputed limitation as follows.

"packaging the precut top for protecting the pre cut top from breakage and scratching" does not require packaging in a box or the specific box described in the specification.

## **VI.**

### **"fastening means"**

#### **A. The Parties' Proposed Construction**

The parties' respective proposed constructions are below:

Claim Term	Romala Stone's Proposed Construction	Home Depot's Proposed Construction
"fastening means"	A structure that performs the function of securing a sink to a	An industrial strength epoxy of two separate uncured liquid components to be mixed together by the average

countertop, including an adhesive such as epoxy, metal clips, and other structures that would be known to one of ordinary skill in the art to perform this function

consumer and applied by the average consumer to attach an undermount sink (which is not in the box with the precut top) to an undersurface of the precut top, or an equivalent thereof, which fastening means cannot include "metal clips [needed] to hold the sink in place."

(Parties agree governed by 35 U.S.C. s. 112(6))

JCC Brief at A1-7 and B-3

JCC Brief at A2-7 and B-3

	Plf CC Brief at 18	Def CC Brief at 17 & Ex. A at A-2
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The term appears in the claims as follows:

1. A method for providing a pre cut non man made, non custom ordered stone top to enable assembly line production and sale of the top at a price affordable to an average consumer, the method comprising the steps of

\* \* \*

packaging fastening means with the precut top, and

\* \* \*

6 The method of claim 1 wherein the fastening means is epoxy

9 A method for providing a pre cut non man made stone top which can be installed by an average consumer and is not custom ordered by the average consumer, the method enabling assembly line production of the top and sale of the top at a price affordable to the average consumer, the method comprising the steps of

\* \* \*

packaging fastening means with the pre cut top, and

\* \* \*

11 The method of claim 9 wherein the fastening means is an adhesive

## B. Discussion

### 1. Background- s. 112(6)

The parties have stipulated that "fastening means" is a means-plus-function limitation governed by s. 112(6). *See* JCC, Exh. A-2, at A2 to -7, Exh. B at B3. Under s. 112(6),

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.

Section 112(6) thus allows "an applicant [to] describe an element of his invention by the result accomplished or the function served, rather than describing the item or element to be used \* \* \* " *Warner Jenkinson Co. v. Hilton Davis Chem Co.*, 520 U.S. 17, 27 (1997). "Means-plus-function" limitations are construed, as required by s. 112(6), to cover the corresponding structure, material or acts described in the specification and equivalents thereof. *In re Donaldson*, 16 F.3d 1189 (Fed.Cir.1994) (*en banc*).

The Court must decide as a matter of law whether a particular term or phrase is governed by s. 112(6). *See* *Personalized Media Communications LLC v. United States Int'l Trade Comm'n*, 161 F.3d 696, 702 (Fed.Cir.1998), *Rodime PLC v. Seagate Tech., Inc.*, 174 F.3d 1294 (Fed.Cir.1999), *cert. denied*, 528 U.S. 1115 (2000).

*Markman*-type claim construction of a means-plus-function limitation requires that the Court first identify the stated function and secondly identify the corresponding structure, material, or acts described in the specification that is clearly linked to or associated with that function. Because the parties have stipulated that "fastening means" must be construed as a means-plus-function limitation under s. 112(6), the only remaining tasks are to (1) identify the stated function, and (2) identify the corresponding structure, both of which have been generally treated as questions of law. *See, ICTV Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1087 (Fed.Cir.2003) ("The determination of the claimed function and corresponding structure of a means-plus-function claim limitation is a question of law, reviewed *de novo*." ).

The Federal Circuit has explained that "[w]e consult the claim language to determine the function of the limitation. \* \* \* We then consult the written description to determine the corresponding structure necessary to accomplish the stated function". *See* *Gemstar-TV Guide Int'l, Inc. v. United States Int'l Trade Comm'n*, 383 F.3d 1352, 1361 (Fed.Cir.2004). The stated function is that explicitly recited in the claim. *See* *Micro Chem, Inc. v. Great Plains Chem Co.*, ( *Micro Chemical II* ), 194 F.3d 1250, 1258 (Fed.Cir.1999) (although s. 112(6) "requires both identification of the claimed function and identification of the structure in the written description necessary to perform that function," the "statute does not permit limitation of a means-plus-function claim by adopting a function different from that explicitly recited in the claim," nor "does the statute permit incorporation of structure from the written description beyond that necessary to perform the claimed function."), *Lockbect Martin Corp. v. Space Sys / Loral, Inc.*, 249 F.3d 1314, 1324 (Fed.Cir.2001) (a means-plus-function limitation cannot be broadened by "reading out" a function). *See generally* *Omega Eng'g. Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed.Cir.2003), *Altins, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1375 (Fed.Cir.2003), *Overbead Door Corp. v. Chamberlan Group, Inc.*, 194 F.3d 1261 (Fed.Cir.1999), *Chiuminatta Concrete Concepts, Inc. v. Cardinal Indus., Inc.*, 145 F.3d 1303, 1306 (Fed.Cir.1998).

After determining the claimed function, the Court must then identify the "corresponding structure" in the

specification that is "clearly linked" to the recited function. *See Medtronic, Inc. v. Advanced Cardiovascular Sys., Inc.*, 248 F.3d 1303, 1311 (Fed.Cir.2001) (quotes omitted) ("Structure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim," quoting *B Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed.Cir.1997)). *See also Northrop Grumman Corp. v. Intel Corp.*, 325 F.3d 1346, 1352 (Fed.Cir.2003) ("[u]nder 112, paragraph 6, structure disclosed in the specification is 'corresponding' structure 'only if the specification or the prosecution history clearly links or associates that structure to the function recited in the claim" ), quoting *B Braun*, 325 F.3d at 1424.

The reason is grounded on the language and underlying rationale of s. 112(6). "The record is clear on why paragraph six [of s. 112] was enacted." *In re Donaldson*, 16 F.3d at 1194. In *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946), the Supreme Court held that a claim drafted in means-plus-function format was invalid for failure to recite structure. In *Greenberg v. Ethnon EndoSurgery Inc.*, 91 F.3d 1580, 1582 (Fed.Cir.1996), the Federal Circuit explained that "Congress enacted paragraph six, originally paragraph three, to overrule that holding. In place of the *Halliburton* rule, Congress adopted a compromise solution, one that had support in the pre- *Halliburton* case law Congress permitted the use of purely functional language in claims, but it limited the breadth of such claim language by restricting its scope to the structure disclosed in the specification and equivalents thereof."

The Federal Circuit has advised that the specification must be read as a whole to determine the structure for performing the claimed function. *See Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1379-80 (Fed.Cir.2001) (citations omitted) ("The specification must be read as a whole to determine the structure capable of performing the claimed function. In construing terms used in patent claims, it is necessary to consider the specification as a whole, and to read all portions of the written description, if possible, in a manner that renders the patent internally consistent. In addition, it is important to construe claim language through the 'viewing glass' of a person skilled in the art"). However, the Federal Circuit has also cautioned that structure identified as "corresponding structure" must actually perform the recited function, rather than merely enable the pertinent structure to perform the recited function. *Asyst Techs., Inc. v. Empak, Inc.*, 268 F.3d 1364, 1371 (Fed.Cir.2001) ("The corresponding structure to a function set forth in a means-plus function limitation must actually perform the recited function, not merely enable the pertinent structure to operate as intended \* \* \*").

## 2. Function

In the phrase "fastening means," the stated function is "fastening." Home Depot urges that the claimed function was "fastening a sink to the precut top by the average consumer." Home Depot's Brief at 17. Romala Stone says that the function is "securing a sink to a countertop". JCC at A1-6. Neither is correct. The expressly claimed function is simply "fastening" and the Court may not adopt "a function different from that explicitly recited in the claim." *Micro Chemical II*, 194 F.3d at 1258. Having said that, it is also clear that the only "fastening" disclosed in the specification and prosecution history is fastening an "undermount sink" to a countertop. It is not clear, from the specification and prosecution history, whether "fastening" would be applicable to a sink that is not an "undermount sink," *i.e.*, one that is inserted into a countertop from above and is held to the countertop by flanges overlapping the sink cutout and the force of gravity (and perhaps some plumber's putty) or a free-standing sink that rests on and extends above the countertop.

In any event, the next step is then to consult the specification to determine the "corresponding structure" "clearly linked" to that function.

### 3. Corresponding Structure

#### a) Specification

The specification, *inter alia*, explains that

Applicants have developed the technology for attaching an undermount sink using an industrial strength epoxy, which is included in the package. This has made it a truly "do-it-yourself" product. In the past, metal clips were needed to hold the sink in place and it was very *difficult to install and* could be temporary in nature because clips can loosen up and pull out. Sinks normally would need a professional to install, using existing methods [Emphasis added]

'973 patent, col. 3, lines 5-12. The specification also explains that:

Packaged with the slabs is a plastic container of epoxy to be used by the do-it-yourselfer to install a sink in the countertop. The epoxy comprises two separate liquid chemicals which, when mixed together, form an epoxy glue strong enough to hold the sink in place under the stone countertop. This epoxy is sold commercially, such as "EPOWELD" a registered trademark of Hardman, a Division of Harcros Chemicals, Incorporated

Applicants, use a unique container for the two liquid components, which is particularly applicable for use with Applicants' packaging. The two liquids are placed in a single plastic container with an external plastic divider holding the two liquids apart. To use the epoxy the user slides the divider off of the plastic container which allows the two liquids to mix and the user kneads the plastic package until the two liquids are well mixed. The epoxy glue is now ready to use. The user then cuts a corner off of the plastic container and applies the epoxy to the undersurface of the stone slab, after marking the location of the sink, which will be attached under the stone countertop, at the prefabricated hole cut to accommodate it. Thus, the do-it-yourselfer can put the slab in place on a base in the bathroom or kitchen and attach the sink using the epoxy. This is all accomplished in a minimum amount of time since everything is pre-cut to a standard size and all elements are provided in the packaging.

'973 patent, col. 4, line 58-col. 5, line 16.

### 4. The Parties' Arguments and Discussion

The parties' proposed constructions and their respective arguments indicate that there are two substantive disputes.

The first is whether the "corresponding structure" includes the "metal clips" referenced in the first specification excerpt above. In terms of the proposed constructions, that issue is raised by Home Depot's proposed construction that "which fastening means cannot include 'metal clips [needed] to hold the sink in place.' "

The second is whether the claims encompass a sink in the same package as the pre-cut top Home Depot raises that issue by proposing that the construction include "(which is not in the box with the pre-cut top)."

A third issue, though, is to resolve the differences between the proposed constructions apart from the "metal

clips" and "sink" issues.

a) **"metal clips"**

Turning first to the "metal clips" issue, Home Depot first argues that the "fastening" function is performed "by an average consumer." Home Depot's Brief at 17-18. Home Depot secondly argues that a "container of epoxy" is the only disclosed structure for performing the claimed function, and that the specification teaches away from, and expressly disclaims, using "metal clips to hold the sink in place." *Id.* at 18. Home Depot points to portions of the prosecution history said to support its proposed construction. *Id.* at 21-23.

Romala Stone urges that (1) "it is error for the court to conclude that the means limitations could only cover new elements of the preferred embodiment," citing *Clearstream Wastewater Sys., Inc. v. Hydro-Action, Inc.*, 206 F.3d 1440, 1446 (Fed.Cir.2000), and *Micro-Chemical II*, 194 F.3d at 1260-61, (2) Home Depot's construction is contrary to the doctrine of claim differentiation, and (3) the statements made during prosecution that Home Depot relies on had nothing to do with the "fastening means." Romala Stone's Response at 14-24. The later argument has more to do with the "sink" issues and will be addressed in that context.

Home Depot's argument that the "fastening" function is performed "by an average consumer" is not well-taken. Although claim 1 says that the product provided by the claimed method is a "pre cut top suitable for installation by the average consumer" and claim 9 similarly refers to a "pre cut non man made stone top which can be installed by an average consumer," as discussed above, the claims do not limit the sale of the product to an "average consumer" and do not require that an "average consumer" actually perform the installation. And, once again, the recited function of the "fastening means" limitation is simply "fastening," and even if that refers to fastening a sink (or an undermount sink) to a countertop, that does not require that an "average consumer" actually perform the "fastening". Thus, to the extent that Home Depot urges that claims 1 and 9 are limited to installations by "an average consumer" and, on the premise that using "metal clips" to secure an undermount sink to a countertop requires more than the abilities of an "average consumer," therefore exclude "metal clips," that argument is rejected.

Romala Stone's claim differentiation argument must likewise be rejected. Original claim 2 provided that "each stone slab has prefabricated cut-outs to accommodate standard sized sinks and faucets." Original claim 4, dependent on claim 2, called for "each box further contains a plastic container of an epoxy for attaching a sink to the stone slab." The two primary references that the examiner relied on in rejecting claims in the first Office action were Schlough *et al* and Rowe. In rejecting claim 4, the examiner further relied on U.S. Patent No. 5,425,475 to Clark.

Tabular or graphic material set at this point is not displayable.

Clark explained that epoxy consists of two parts, a "resin" and a "hardener," that must be mixed together immediately before use. According to Clark, in the prior art it was necessary for a user to provide a suitable mixing surface as well as tools for mixing and applying the epoxy. The Clark invention was directed to an epoxy dispenser that permitted mixing and thereafter application of the epoxy. The examiner contended that it would have been obvious "to combine Clark's teaching with Schlough *et al.*, and Rowe to include the epoxy container \* \* \* for attaching a sink to the stone slab \* \* \*." Lundin Decl. Exhibit B at B-84.

The applicants' in response, *inter alia*, added new claims 21-28. Claim 24 provided that "each box further

contains a container of epoxy, for attaching a sink to the stone slab," and claim 25, dependent from claim 24, further defined the epoxy container as comprising "two sections separated by a removable separator, in which a different reactive liquid is contained in each section." *Id.* at B-90. With respect to the rejection based on Clark, the applicants argued that "Clark \* \* \* does not mention anything about the epoxy being useful for natural stone application, nor is there any mention of packaging an epoxy with prefabricated natural stone for sale to retail consumers. \* \* \* No. reference cited even suggests that a sink may be attached to natural stone by an epoxy. Request is made that the Examiner cite a reference to support his contention that this is well known in the art." *Id.* at B-93 to -94.

In the next Office action, all pending claims were again rejected, although this time the primary references were Hinkle and Orr *et al.* However, the examiner again relied on Clark in rejecting those claims calling for "a container of epoxy." In response, the applicants repeated their earlier arguments *vis-a-vis* Clark, and again requested that the examiner cite a reference supporting his contention that it was well known to use epoxy to attach a sink to natural stone. *Id.* at B-118.

In the following Office action, the examiner again repeated the rejections based on Clark. In responding to the applicants' arguments that no reference suggested attaching a sink to natural stone by epoxy, the examiner referred to two references, U.S. Patent No. 5,253,932 to Nesovic and U.S. Patent No. 5,640,947 to Shute, cited in the second Office action /but not specifically applied against the claims) as disclosing "the use of epoxy between stone to stone, and stone to metal." The examiner also cited a Japanese patent as disclosing an "epoxy suitable as binder [ *sic* ] for alloy, stone, sink, *etc.*," and further cited U.S. Patent No. 6,258,190 to Sciarrino *et al.* as disclosing "the use of epoxy to bond between natural stone and kitchen sink [ *sic* ] to stone tiles \* \* \*." *Id.* at B-134 to -135.

The applicants then filed the RCE with new claims 30-56. Claim 33 provided that "the step of packaging further comprises packaging a container of an epoxy with said pre-cut top," claim 34 provided that "the container of epoxy comprises two sections separated by a removable separator in which a different reactive liquid is contained in each section," claim 35 provided that "said container of epoxy is plastic." Claim 55 called for "packaging a container of an epoxy with said pre cut top, wherein the container of epoxy comprises two sections separated by a removable separator in which a different reactive liquid is contained in each section," and claim 56 had similar language. New claims 57-66 were thereafter added. Claim 59 called for "adhesive means to secure said countertop in place," and claim 66 called for "packaging an adhesive with said pre-cut top."

The relevant portion of claim 55 (which became patent claim 1) was amended, "packaging *fastening means with the precut top* []," to now refer to "fastening means" for the first time. New claim 68 was added, which became patent claim 6, providing "wherein the fastening means is epoxy." The relevant portion of claim 66 (which became patent claim 9) was amended, "packaging *fastening means with* [] *the pre cut top*," to likewise use the term "fastening means" rather than "adhesive." New claim 72 was added, which became patent claim 11, providing "wherein the fastening means is an adhesive."

It is thus clear that throughout prosecution, the claims, except for the final amendments, were drawn to "a container of an epoxy" (or similar language) or, in the case of claims 59 and 66, "adhesive." It is further clear from the applicants' arguments that they believed that the use of epoxy to attach a sink to natural stone was novel and non-obvious. Even after the examiner cited references purportedly disclosing the same, the applicants continued to call for "a container of an epoxy."

The applicants' amendment of claims 55 and 66 to "fastening means" and the addition of claims 68 and 72 provides at least some indication that the applicants intended "fastening means" to be broader than "epoxy" or "adhesive." And perhaps it is-or possibly so.

The reason is that the applicants chose to use a phrase that they now agree constitutes a means-plus-function limitation governed by s. 112(6). Under the statute, "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification *and equivalents thereof*," (emphasis added) namely *statutory* equivalents for purposes of literal infringement, which, of course, is distinct from seeking recourse to the *doctrine of equivalents*, and may provide an alternative if resort to the doctrine of equivalents is foreclosed. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1375 & n. 5 (Fed.Cir.2003) ( *en banc* ) (Rader, J. concurring) ("In response to the demise of the flexible rule [for the application of the doctrine of equivalents] \* \* \* an applicant must now avoid amendments, \* \* \* [and] resort to less precise functional claims to preserve a statutory equivalent \* \* \*." "35 U.S.C. s. 112, paragraph 6 (2000), includes a statutory equivalent as part of the literal infringement inquiry.").

That is, parent claims that include means-plus-function limitations governed by s. 112(6) do not have the same scope as dependent claims calling for specific structures, even if the "corresponding structure" is the same as the structure recited in the dependent claim. *See Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed.Cir.1991) (emphasis in original) (citations omitted) ("In any event, [the independent and dependent claims] do not \* \* \* thereby have exactly the same scope and, thus, claim differentiation is maintained. [The independent claim] remains broader than [the dependent claim]. *Literally*, [the independent claim] covers the structure described in the specification *and equivalents thereof* [The dependent claim] does not *literally* cover equivalents \* \* \* "). Thus, in that sense, "fastening means" is broader than dependent claims calling for "epoxy" or "adhesive ." The term "fastening means" includes statutory equivalents for literal infringement, while "epoxy" and "adhesive" do not.

In all events, it is clear that the applicants regarded the use of epoxy as a part of their invention ("Applicants have developed the technology for attaching an undermount sink using an industrial strength epoxy, which is included in the package. This has made it a truly 'do-it-yourself' product " '973 patent, col. 3, lines 5-8). It is equally clear that the applicants did *not* regard the use of metal clips as part of their invention ("In the past, metal clips were needed to hold the sink in place and it was very difficult to install and could be temporary in nature because clips can loosen up and pull out Sinks normally would need a professional to install, using existing methods." '973 patent, col. 3, lines 8-12). The use of epoxy provided for a "do-it-yourself" product-the use of metal clips did not.

Romala Stone contends that "corresponding structure" for purposes of s. 112(6) may include prior art structure, citing *Clearstream*. And that is true. In *Clearstream*, the patent-in-suit was drawn to a wastewater treatment apparatus. The prior art aerated the wastewater by pumping air through rigid-conduits, but such conduits were difficult to remove and replace. One of the novel features was inserting flexible hoses into rigid conduits. The disputed limitations were "means for injecting air" and "means for aerating." Hydro-Action's accused wastewater treatment system used only the prior art, rigid-conduct system. Hydro-Action argued that the only possible 'corresponding structure" was the flexible-hose structure. The Federal Circuit disagreed reasoning that "[i]t is well established in patent law that a claim may consist of all old elements, such as the rigid-conduct system, for it may be that the combination of the old elements is novel and patentable. Similarly, it is well established that a claim may consist of all old elements and one new element, thereby being patentable." 206 F.3d at 1445. In *Clearstream*, although the novel flexible-hose structure offered advantages over the prior art rigid-conduits, those advantages related to removing and



replacing the same. In terms of the claimed function, *i.e.*, "injecting air" and "aerating," both the prior art and novel structure provided that function, and apparently did so equally as good. The patent-in-suit did not criticize the prior art rigid-conduits for failing to perform that function as good as the flexible structures, but rather because the prior art conduits were difficult to replace, *i.e.*, for reasons other than the ability to perform the claimed function.FN9

FN9. The patent-in-suit, for example, explained that "[T]he PVC air conduits that are located generally adjacent the outside walls of the tank are very difficult to get out of and to put back in the tank because of the limited space in the opening at the top of the tank," and "[t]hese flexible hoses and the diffusers connected to them can be quickly and easily removed and replaced or repaired." U.S. Patent No. 5,221,470.

*Signtech USA, Ltd. v. Vutek, Inc.*, 174 F.3d 1352 (Fed.Cir.1999), is more directly on point. The patent-in-suit was drawn to ink jet printers for printing large signs. One of the claim terms in dispute was "ink delivery means". The district court had construed the term as a means-plus-function limitation governed by s. 112(6), and the Federal Circuit agreed noting that "ink delivery means" was equivalent to "means for ink delivery" *Id.* at 1356. The stated function was therefore "ink delivery". Both the newly disclosed and prior art ink sprayheads literally performed the function of "ink delivery". However, the newly disclosed ink sprayhead used one pressurized air source to control ink delivery onto the substrate and a second low-volume, high pressure air source to continuously clean the ink nozzle during printing. Prior art ink sprayheads contained only a single, pulse-width modulated air source for delivery of the ink to the substrate and lacked a second, high pressure air source for cleaning the nozzles. The disputed claim term, of course, referred only to "ink delivery," not to "continuously clean[ing] the ink nozzle during printing." Nevertheless, the trial court, after reviewing the specification, concluded that "[b]y consistently describing its invention-in the Abstract, Background of Invention, Summary of Invention, and Detailed Description sections of the specifications-as one that solves the ink accumulation problem inherent in the prior art, the ink delivery means cannot be interpreted apart from the essential, cleaning, high-pressure air source" *Id.* at 1355. The specification explained that the prior art was "incapable of producing an enlarged image having the desired color scheme" because of the lack of a second air source for cleaning the nozzles. *Id.* The trial court limited "ink delivery means" to an ink sprahhead containing a "second, high pressure air source," and the Federal Circuit affirmed that conclusion.

Here, the patentees did not use the word "incapable," but *did* use words to like effect, *e.g.*, "[i]n the past, metal clips were needed to hold the sink in place and it was very difficult to install and could be temporary in nature because clips can loosen up and pull out Sinks normally would need a professional to install, using existing methods". Although the claims are not restricted to who actually installs the product, clearly the consistent theme throughout the specification and prosecution history was that the claimed method provided a product that did not require a consumer to engage the further services of a professional to install.

Secondly, as noted above, "[s]tructure disclosed in the specification is 'corresponding' structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim," *Medtronic*, 248 F.3d at 1311, quoting *B Brann*, 124 F.3d at 1424. In the context of s. 112(6), the Federal Circuit has instructed that it is a "duty of a patentee to clearly link or associate structure with the claimed function," and such "is the *quid pro quo* for allowing the patentee to express the claim in terms of function under section 112, paragraph 6." *Med Instrumentation & Dtagnotus Corp. v. Elekta AB*, 344 F.3d 1205, 1211 (Fed.Cir.2003) ("The public should not be required to guess as to the structure for which the patentee enjoys the right to exclude. The public instead is entitled to know precisely what kind of structure

the patentee has selected for the claimed functions, when claims are written according to section 112, paragraph 6" 344 F.3d at 1220). "The established rules in our case law on section 112, paragraph 6 that structure corresponding to the claimed function must be disclosed in the specification with clear linkage between the structure and the claimed function serve worthy goals. Such rules are intended to produce certainty in result Precision in claiming is not an unreasonable price to pay to gain the benefits of claiming in functional terms under section 112, paragraph 6" 344 F.3d at 1220.

Here, the specification by explaining "[a]pplicants have developed the technology for attaching an undermount sink using an industrial strength epoxy, which is included in the package. This has made it a truly 'do-it-yourself' product," and subsequently "[p]ackaged with the slabs is a plastic container of epoxy to be used by the do-it-yourselfer to install a sink in the countertop," most clearly links such epoxy with the function of "fastening" After all, claims 1 and 9 do not call simply for a "fastening means," but for the method step of "packaging fastening means with the precut top." The only "fastening means" identified in the specification and prosecution history as being "packaged" with the precut top is a "container of epoxy"

Returning to Romala Stone's claim differentiation argument, a similar argument was considered and rejected in *Medtronic*, 248 F.3d at 1313 (alterations in original) (citations omitted).

*Medtronic's* claim differentiation argument cannot mend this lack of a clear link or association. *Medtronic* asserts that under the district court's construction, the literal scope of claims 1 and 11 is the same as that of claims 7 and 18, respectively, which recite an end-to-end belical winding. From this, *Medtronic* argues that (1) the doctrine of claim differentiation requires that independent claims 1 and 11 be construed more broadly than the dependent claims 7 and 18, and (2) claims 1 and 11 must, therefore, be construed to cover the structure of the straight wire, books, and sutures. It is settled law, however, that independent claims containing means-plus-function limitations do not have the same literal scope as dependent claims reciting specifically the structure that performs the stated function. *Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1538 (Fed.Cir.1991) ("In any event, [the independent and dependent claims] do not \* \* \* thereby have exactly the same scope and, thus, claim differentiation is maintained. [The independent claim] remains broader than [the dependent claim]. Literally, [the independent claim] covers the structure described in the specification and equivalents thereof [The dependent claim] does not literally cover equivalents \* \* \* ").

Specifically, "[s]imply 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(b). We hold that one can not escape that mandate by merely adding a claim or claims specifically reciting such structure or structures." *Laitram*, 939 F.2d at 1538. And, as noted above, "fastening means," as a means-plus-function limitation that includes *statutory* equivalents, is inherently broader than a dependent claim calling for "epoxy" or "adhesive."

Accordingly, Home Depot's contention that the recommended construction of "fastening means" should not include "metal clips [needed] to hold the sink in place" is well taken.

**b) "to attach an undermount sink (which is not in the box with the precut top)"**

Home Depot proposes that "fastening means" should be construed as "[a]n industrial strength epoxy \* \* \* to attach an undermount sink (which is not in the box with the precut top) to an undersurface of the precut top

\* \* \* " What Home Depot actually argues, though, is somewhat different. Home Depot argues that "the claimed 'fastening means' cannot encompass attaching a sink to the top before the top is packaged shipped and purchased." Home Depot's Brief at 20 Rather, Home Depot argues, "the fastening means is 'to be used by the do-it-yourselfer to install a sink in the countertop." *Id.* Home Depot argues (1) none of the claims include a step of attaching a sink to a precut top prior to packaging, shipping or sale, (2) the specification explains that "the do-it-yourselfer can put the slab in place on a base in the bathroom or kitchen and attach the sink using the epoxy," (3) during prosecution the applicants argued that the epoxy was "an important factor in selling the product to the consumer" and was "an important factor in the method of selling the prefabricated stone," and (4) the applicants, in distinguishing Orr *et. al.*, during prosecution, urged that "Applicants' invention specifically does not include a sink." *Id.* at 20-23.

Romala Stone urges that (1) the argument that epoxy was important was in the context of urging that "the consumer does not have to purchase it separate and all items necessary for the installation are provided in one package," (2) the arguments made to distinguish Orr *et. al.*, have "absolutely nothing to do with the fastening means," and did not constitute an "express disavowal" of any claim scope. Romala Stone's Response at 18-24.

The term "fastening means" is but one part of the limitation "packaging fastening means with the precut top," which is addressed below. The foregoing arguments are more properly directed to, and addressed in the context of, the entire limitation.

### **c) Comments on the Parties' Proposed Constructions**

Romala Stone's proposed construction, "[a] structure that performs the function of securing a sink to a countertop, including an adhesive such as epoxy, metal clips, and other structures that would be known to one of ordinary skill in the art to perform this function," must be rejected. First, as discussed above, the *quid pro quo* of permitting the use of means-plus-function language is that the applicant must disclose "corresponding structure" clearly linked to the stated function, and, under the terms of s. 112(6), "such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof" Accordingly, construing "fastening means" to cover "[a] structure [ *i.e.*, any structure] that performs the function of securing a sink to a countertop" would be error.

Second, the "corresponding structure" does not include "metal clips" for the reasons discussed above.

Third, Romala Stone's proposed construction alters the statute and established law. Under s. 112(6), means-plus-function limitations are construed to cover the "corresponding structure," which is the task here, "and equivalents thereof" The limits of "equivalents" do not necessarily extend to any "structures that would be known to one of ordinary skill in the art to perform this function." "If it performs the identical function, an accused device literally infringes a claim element under s. 112 para. 6 only if it is *insubstantially* different from the corresponding structure in the patent specification \* \* \* The 'insubstantial difference' analysis requires a determination of 'whether the "way" the accused structure performs the claimed function, and the "result" of that performance, are substantially different from the "way" the claimed function is performed by the "corresponding structure \* \* \* described in the specification," or its "result" " ' [Emphasis added.] Ishida Co., Ltd. v. Taylor, 221 F.3d 1310, 1317 (Fed.Cir.2000), quoting Odetus, Inc. v. Storage Tech Corp., 185 F.3d 1259, 1267 (Fed.Cir.1999). Not all "structures" "known to one of ordinary skill in the art" for "securing a sink to a countertop" would necessarily fall within the scope of statutory "equivalents."

Fourth, the proposed construction attempts to broaden the disclosed "corresponding structure" by providing "including an adhesive such as epoxy." Epoxies are adhesives, but not all adhesives are epoxies. The "corresponding structure" disclosed in the specification is an epoxy, not the broader term "adhesive" which does not appear in the specification. While dependent claim 11 (dependent from claim 9) says that "the fastening means is an adhesive," the Federal Circuit has explained, once again, that "the judicially developed guide to claim interpretation known as 'claim differentiation' cannot override the statute," and "one cannot escape [the] mandate [of s. 112(6)] by merely adding a claim or claims specifically reciting such structure or structures." *Laitram*, 939 F.2d at 1538.

On the other hand, Home Depot's proposed construction, "[a]n industrial strength epoxy of two separate uncured liquid components to be mixed together by the average consumer and applied by the average consumer to attach an undermount sink (which is not in the box with the precut top) to an undersurface of the precut top, or an equivalent thereof, which fastening means cannot include "metal clips [needed] to hold the sink in place," must also be rejected, other than to the extent that proposed construction concludes that "metal clips" are not "corresponding structure."

The specification, as discussed below, discloses "[a]n industrial strength epoxy of two separate uncured liquid components to be mixed together" as one embodiment, but not the sole embodiment, as "corresponding structure."

Second, "to be mixed together by the average consumer and applied by the average consumer to attach an undermount sink \* \* \* to an undersurface of the precut top" attempts once again to read the claims as limited to the "average consumer" doing the installing. As discussed above, the claims are directed to "[a] method for providing a \* \* \* stone top," and are not limited to who buys or installs the stone top.

#### **d) Conclusion**

The "corresponding structure" disclosed in the specification is variously described as an "an industrial strength epoxy," "a plastic container of epoxy," "[t]his epoxy is sold commercially, such as 'EPOWELD,' " and

Applicants, use a unique container for the two liquid components, which is particularly applicable for use with Applicants' packaging. The two liquids are placed in a single plastic container with an external plastic divider holding the two liquids apart. To use the epoxy the user slides the divider off of the plastic container which allows the two liquids to mix and the user kneads the plastic package until the two liquids are well mixed. The epoxy glue is now ready to use

It is not clear from either the specification or the parties' arguments whether that "unique container" was applicants' invention or whether the specification was referring to the commercial EPOWELD product. In any event, "when multiple embodiments in the specification correspond to the claimed function, proper application of s. 112, para. 6 generally reads the claim element to embrace each of those embodiments." *Micro Chemical II*, 194 F.3d 1250, 1258 (Fed.Cir.1999). *See also* *Versa Corp. v. Ag-Bag Int'l Ltd.*, 392 F.3d 1325, 1329 (Fed.Cir.2004). The court is not required to "formulate a single claim interpretation to cover multiple embodiments." *Isbida*, 221 F.3d at 1316.

#### **5. Recommendation**

Accordingly, the master recommends that the Court construe "fastening means" as follows:

The parties have stipulated that "fastening means" is a means-plus-function limitation construed under 35 U.S.C. s. 112(6). The claimed function is "fastening." The "corresponding structure" disclosed in the specification and clearly linked to that function is "an industrial strength epoxy," "a plastic container of epoxy," "[t]his epoxy is sold commercially, such as 'EPOWELD,'" and the following.

Applicants use a unique container for the two liquid components, which is particularly applicable for use with Applicants' packaging. The two liquids are placed in a single plastic container with an external plastic divider holding the two liquids apart. To use the epoxy the user slides the divider off of the plastic container which allows the two liquids to mix and the user kneads the plastic package until the two liquids are well mixed. The epoxy glue is now ready to use.

Under s. 112(6), "fastening means" covers the foregoing structures and equivalents thereof. The "corresponding structure" does not include metal clips.

**VII.**

**"packaging fastening means with the precut top"**

**A. The Parties' Proposed Construction**

The parties' respective proposed constructions are as follows:

Claim Term	Romala Stone's Proposed Construction	Home Depot's Proposed Construction
"packaging fastening means with the precut top"	Including with the pre-cut top a structure that performs the function of securing a sink to a countertop  JCC Brief at A1-7 and B-3	Placing a separate container of the [epoxy] fastening means into the box with the precut top  JCC Brief at A2-11 and B-3
	Plf CC Brief at 13-14	Def CC Brief at 23 & Ex. A at A-2

In context, the phrase appears as follows:

1 A method for providing a pre cut non man made, non custom ordered stone top to enable assembly line production and sale of the top at a price affordable to an average consumer, the method comprising the steps of

\* \* \*

packaging fastening means with the precut top, and

\* \* \*

9 A method for providing a pre cut non man made stone top which can be installed by an average consumer and is not custom ordered by the average consumer, the method enabling assembly line production of the top and sale of the top at a price affordable to the average consumer, the method comprising the steps of

\* \* \*

packaging fastening means with the pre cut top, and

\* \* \*

Home Depot contends that from statements in the specification, *i.e.*, "[p]ackaged with the slabs is a plastic container of epoxy to be used by the do-it-yourselfer to install a sink in the countertop," and "Applicants, [*sic*] use a unique container for the two liquid components, which is particularly applicable for use with Applicants' packaging," a person of ordinary skill in the art, reading the claims and specification, would understand "packaging fastening means with the precut top" to mean "placing a separate container of epoxy into the box with the precut top." Home Depot's Brief at 24.

Romala Stone responds that Home Depot is attempting to read limitations from the specification into the claim. Romala Stone's Response at 24.

## **B. Discussion**

### **1. Meaning of "fastening means" Resolves Narrow Dispute**

First, "fastening means" has been construed above. That construction resolves the dispute between "a structure that performs the function of securing a sink to a countertop," as Romala Stone proposes, and "a separate container of the [epoxy] fastening means," as Home Depot proposes. Also, the foregoing discussion of "packaging the precut top for protecting \* \* \*," resolves the parties' dispute *vis-a-vis* "in a box." With those disputes resolved, "packaging fastening means with the precut top" *per se* is clear on its face. However, to resolve any doubts, the ordinary and customary meaning of the clear language of the claim, "packaging fastening means *with* the precut top," is that the "precut top" and "fastening means" are separate items included in the same package.

### **2. The Broader Dispute- "packaging fastening means with the precut top" in the Context of the Claim as a Whole**

The parties' dispute whether the claims as a whole can be construed to encompass attaching a sink to the top before the top is packaged and shipped, though, remains unresolved. Although the parties raised that issue in connection with the "fastening means" limitation above, the parties' arguments are better addressed in connection with the present limitation and the claim as a whole. *See* Power Mosfet Techs., L.L.C. v. Siemens AG, 378 F.3d 1396, 1412 (Fed.Cir.2004) ("a construction of the claims as a whole would have been beneficial to the litigants"). "The role [of claim construction] is neither to limit nor to broaden the claims, but to define, as a matter of law, the invention that has been patented." *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed.Cir.2001).

## a) Claims and Specification

Beginning as always with the claim language, and using claim 1 as representative on this issue.

1. A method for providing a pre cut non man made, non custom ordered stone top to enable assembly line production and sale of the top at a price affordable to an average consumer, the method comprising the steps of

pre cutting non man made stone into the pre cut top suitable for installation by the average consumer, wherein the precut top defines cut outs to accommodate at least one sink and/or faucet,

packaging the precut top for protecting the pre cut top from breakage and scratching,

packaging fastening means with the precut top, and

shipping a plurality of the packaged precut tops to a retailer for sale to and installation by the average consumer

the transition phrase is "comprising" which, of course, is open-ended and does not preclude additional steps (in the case of method claims). *See Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed.Cir.1997). Thus, Home Depot's first argument that none of the claims include a step of attaching a sink to a precut top prior to packaging and shipping is not necessarily decisive or persuasive. On the other hand, the actual method steps may serve to limit a claim despite the transition phrase "comprising." *See, e.g., Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1271-72 (Fed.Cir.1986). *See also Spectrum Int'l v. Sterilite Corp.*, 164 F.3d 1372, 1380 (Fed.Cir.1998).

Here, the step of "packaging fastening means with the precut top" means that an accused method, in order to infringe, must perform that step. In the context of the specification, the "fastening means" is used-and only used-for attaching an undermount sink to a countertop. During the *Markman* hearing, for example, counsel for Romala Stone noted that "[t]he context of the patent, it makes it pretty clear that the only fastening that is going on with respect to the sink and the countertop or with respect to the countertop is fastening the sink to the countertop." *Markman* Tr. at 41-42. If a sink was attached to a top before the top was packaged and shipped, in the context of the disclosed invention, there would be no need for including "fastening means" in addition to the "precut top."

Second, the claimed method is drawn to "[a] method for providing \* \* \* to an average consumer," that includes the steps of "pre cutting," "packaging the precut top for protecting," "packaging fastening means," and "shipping". What the consumer is provided with, per the claim language, is (1) "a pre cut non man made, non custom ordered stone top" and (2) "fastening means" in a package. The limitation "packaging fastening means with the precut top" on its face suggests, if not requires, that the "fastening means" be packaged in a package with the "precut top."

Third, the plain language used in the step of "packaging fastening means with the precut top" requires that the "fastening means" be packaged "with the precut top." As noted above, the ordinary and customary meaning of that plain language connotes (or, at least suggests) that the "fastening means" is a separate item from the "precut top." That is also how the specification describes the "fastening means," *i.e.*, "an industrial strength epoxy, which is included in the package," "[p]ackaged with the slabs is a plastic container of

epoxy."

Apparently Romala Stone's contention is that a sink attached to a countertop nevertheless satisfies this limitation "because the fastening means, which happen to be doing the job of the fastening means, holding the sink to the precut top, are in the package or is in the package." *Markman* Tr. at 45.

THE SPECIAL MASTER: Okay. If the sink is attached to the countertop, regardless of how it's attached, does that satisfy your claim limitation, your method step of packaging fastening means with the precut top?

MR BOCKHOP: Yes, because the fastening means, which happen to be doing the job of the fastening means, holding the sink to the precut top, are in the package or is in the package.

In other words, according to Romala Stone, although the "fastening means" is physically holding a sink to a countertop (which, in the case of epoxy, means that the epoxy has been mixed, applied to the respective surfaces of the sink and countertop, and allowed to cure) satisfies the "packaging fastening means with the precut top" limitation because the "fastening means" is literally in the same package as the precut top, albeit cured and serving to hold the sink and precut top together.

That is not what the claims say. Again, the plain language of the claims, giving that language its ordinary and customary meaning, is "packaging \* \* \* with \* \* \* " which connotes that the "precut top" and "fastening means" are separate items included in the same package. Such understanding is confirmed by the specification. The *only* disclosure in the specification and prosecution history is that the "precut top" and "fastening means" are separate items. Nothing in the specification (or prosecution history) suggests that the patentees contemplated attaching a sink to a stone top before packing and shipping. *See Phillips*, 415 F.3d at 1323 ("it was clear from the specification that there was 'nothing in the context to indicate that the patentee contemplated any alternative' embodiment to the one presented," characterizing holding in *Snow v. Lake Shore & Mich. S. Ry Co.*, 121 U.S. 617, 630 (1887)). Nor is there anything in the specification or prosecution history suggesting that "packaging fastening means with the precut top" could (or should) be construed to encompass when the "fastening means" is physically holding a sink and countertop together.

Counsel for Romala Stone in fact conceded that there was no written description that supported its view that this limitation could be satisfied if a sink was already attached to a countertop *Markman* Tr. at 45-46.

THE SPECIAL MASTER: All right. And where is there a written description support for that?

MR. BOCKHOP: I don't think there's any written de-description that specifically states it in that way. And, again, it goes back to there isn't anything in the written description that says in one embodiment the sink is already attached to the countertop. But there's nothing in the specification that would otherwise prevent that construction.

THE SPECIAL MASTER: Well, I mean, you're aware that a specification doesn't only have to exclude things, it has to provide support for claim limitations, right?

MR. BOCKHOP: Well, it does. But, then, at the same time, the claim limit-limitation isn't necessarily limited to the embodiment presented in the-in the specification.

Counsel urged, however, that claims are not necessarily limited to the embodiment disclosed in the



specification. *Id.*

That is true. But "the words of a claim 'are generally given their ordinary and customary meaning,' ' and "the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, *i.e.*, as of the effective filing date of the patent application." Phillips, 415 F.3d at 1312-13. Quite simply, Romala Stone has provided no showing that one of ordinary skill in the art would read "packaging \* \* \* with \* \* \* " in any manner different from what the plain language connotes. Further, Romala Stone points to nothing in the specification or prosecution history that would suggest its current construction to one of ordinary skill in the art.

Also, Romala Stone's focus was on whether the specification or prosecution history "disclaimed" or "disavowed" a particular construction. Although that is certainly important to claim construction, that is only a partial reflection of current law-though, in fairness, some of these cases were decided or confirmed after the *Markman* hearing. In *Nystrom v. TREX Co. ( Nystrom II )*, 424 F.3d 1136, 1144-45 (Fed.Cir.2005), *cert. denied*, 126 S.Ct. 1654, (2006) (citation omitted), for example, the court explained that "Nystrom is not entitled to a claim construction divorced from the context of the written description and prosecution history \* \* \* Nystrom argues repeatedly that there is no disavowal of scope in the written description or prosecution history Nystrom's argument is misplaced. What *Phillips* now counsels is that in the absence of something in the written description and/or prosecution history to provide explicit or implicit notice to the public- *i.e.*, those of ordinary skill in the art-that the inventor intended a disputed term to cover more than the ordinary and customary meaning revealed by the context of the intrinsic record, it is improper to read the term to encompass a broader definition simply because it may be found in a dictionary, treatise, or other extrinsic source."

Although Romala Stone is not relying on a dictionary definition, the principle remains the same. *See Old Town Canoe Co. v. Confluence Holdings Corp.*, 448 F.3d 1309, 1318 (Fed.Cir.2006) (citation omitted) ("Old Town is not entitled to a claim construction divorced from the context of the written description and prosecution history. Nothing in the context of the intrinsic record explicitly or implicitly indicates that one of ordinary skill in the art would consider coalescence to be complete before the particulates have fully melted, flowed together, become cross-linked, and reached optimum stage 5. Thus, there is no basis to conclude that one of ordinary skill would have understood completion of coalescence, as used in claim 9, to mean anything other than reaching an optimum stage"), *On Demand Mach Corp. v. Ingram Indus., Inc.*, 442 F.3d 1331, 1340 (Fed.Cir.2006) (citations omitted) ("[W]hen the scope of the invention is clearly stated in the specification, and is described as the advantage and distinction of the invention, it is not necessary to disavow explicitly a different scope \* \* \* The Ross specification repeatedly reinforces its usage of the term 'customer' as the retail consumer.").

As the foregoing explains, "[i]mportantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." Phillips, 415 F.3d at 1313. That does not mean that limitations from the specification will be read into the claims, "because persons of ordinary skill in the art rarely would confine their definitions of terms to the exact representations depicted in the embodiments." *Id.* at 1323. However, it *does* mean that when a patentee urges a construction broader than what the ordinary and customary meaning of claim language suggests, the public notice function of claims requires some "explicit or implicit notice to the public," and here there is none. *See Netword, LLC*, 242 F.3d at 1352 (Fed.Cir.2001) ("The claims are directed to the invention that is described in the specification, they do not have meaning removed from the context from which they arose.").

In terms of the specification and the current limitation, nothing in the specification suggests that including a separate container of epoxy in the package with the stone top was just a preferred embodiment. *See Honeywell Int'l, Inc. v. ITT Indus. Inc.*, 452 F.3d 1312, 1318 (Fed.Cir.2006) ("[T]he written description does not indicate that a fuel filter is merely a preferred embodiment of the claimed invention. The fuel filter was the only component of an EFI system that the written description disclosed as having a polymer housing with electrically conductive fibers interlaced therein."). The written description of the '973 patent describes the "precut top" and "fastening means" as separate items included in the same package.

## **b) Specification and Prosecution History**

Fourth, during prosecution, the applicants argued that including a container of epoxy was part of their "invention." Prior to filing the RCE, the applicants' claims were drawn to "[a] method of selling natural stone to the average consumer." Original claim 2, dependent from claim 1, called for "in which each stone slab has prefabricated cut-outs to accommodate standard sized sinks and faucets." Original claim 4, dependent from claim 2, called for "in which each box further contains a plastic container of an epoxy for attaching a sink to the stone slab." Original claim 5, dependent from claim 4, further defined the epoxy container as comprising "two sections separated by a removable separator \* \* \*" Lundin Decl. Exh B at B-18. In the initial Office action, claims 4 and 5 were rejected over Schlough *et. al.* in view of Rowe and Clark, with Clark being cited as disclosing the epoxy of claims 4 and 5 *Id.* at Exh. B, B-83 to -84. The applicants responded urging, *inter alia*, that "nor is there any mention [in Clark] of packaging an epoxy with prefabricated natural stone for sale to retail consumers." *Id.* at Exh. B, B-93.

After a second rejection based on Clark (claims 4 and 5, and claims 24 and 24), the applicants argued that "the object of Applicants' business method is to provide a package for the do-it-yourself homeowner \* \* \*. The presence of an epoxy designed to be used in the installation, optimally may be an important factor in selling the product to the consumer, since the consumer does not then have to purchase the epoxy separately, and all items necessary for the installation are provided in one package. This may be an important factor in the method of selling the prefabricated stone." *Id.* at Exh. B, B-118 to -119. Romala Stone points out that the argument that epoxy was important was in the context of urging that "the consumer does not have to purchase it separate and all items necessary for the installation are provided in one package." That is true, but beside the point. The argument was not only that the applicants had discovered that one could use epoxy to mount a sink to a stone top (something that they contended Clark did not show), but that including the epoxy in the package was an aspect of their invention, *i.e.*, providing "all items necessary for installation" in "one package."

Fifth, throughout the specification and prosecution history, it is clear that the applicants' characterized their invention, insofar as attaching a sink is concerned, as providing a package that allowed a do-it-yourselfer to install a stone top, and then attach a sink. For example, the specification explains. "Thus, the do-it-yourselfer can put the slab in place on a base in the bathroom or kitchen and attach the sink using the epoxy," and "Applicants have developed the technology for attaching an undermount sink using an industrial strength epoxy, which is included in the package \* \* \* Sinks normally would need a professional to install, using existing methods." '973 patent, col 5, lines 11-13 and col 3, lines 5-12.

Sixth, there is no disclosure anywhere in the '973 patent or its prosecution history that can be reasonably construed as suggesting that the invention includes attaching a sink to a stone top prior to packaging and shipping-and the prosecution history strongly suggests otherwise. Throughout the specification and

prosecution history, the stone top and a sink were referenced as separate items. The claim language likewise refers to the "precut top" as separate from the sink (as well as separate from a faucet), *i.e.*, "wherein the precut top defines cut outs to accommodate at least one sink and/or faucet." Additionally, claim 1 overall is drawn to [a] method for providing a \* \* \* stone top" one step of which is "packaging fastening means with the precut top" in which the "fastening means" has the sole purpose of fastening a separate sink to the stone top.

Additionally, as discussed above, the examiner during prosecution rejected claims over Hinkle in view of Orr *et. al.* Lundin Decl. Exh. B at B-102. Once again, Orr *et. al.* disclosed.

Tabular or graphic material set at this point is not displayable.

In particular, the examiner cited Orr *et. al.* as disclosing "packaging the stone in a box which protects the stone from damage" (claim 1. similar limitations in other rejected claims). In response, the applicants argued:

Orr *et. al.* describes a package for a cultured marble sink made of a cast polymer \* \* \* It is specially designed so that the sinks may be stacked, where the bowl of the sink in one container enters the cavity defined by the sink in an adjacent container \* \* \* Applicants' invention specifically does not include a sink. The sink is located in the home of the consumer. Applicants' business method is for the consumer to buy the natural stone slab and upgrade his or her home by installing or replacing the existing counter tops with natural stone. If the counter top is in the kitchen or bathroom, the sink must be affixed to the slab using a special epoxy, as claimed in Claim 24 and the like Applicants' invention specifically does not include a sink \* \* \* [Emphasis added.].

Id. at Exh. B, B-116 to -117.

Romala Stone urges that the arguments made to distinguish. Orr *et. al.* have "absolutely nothing to do with the fastening means," and did not constitute an "express disavowal" of any claim scope. Romala Stone's Response at 18-24. Romala Stone's arguments, of course, were in the context of the "fastening means" limitation because that was the context of Home Depot's arguments.

"[E]xplicit statements made by a patent applicant during prosecution to distinguish a claimed invention over prior art may serve to narrow the scope of a claim." Spectrum, 164 F.3d at 1378 "That explicit arguments made during prosecution to overcome prior art can lead to narrow claim interpretations makes sense, because '[t]he public has a right to rely on such definitive statements made during prosecution.' Indeed, 'by distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover.'" ' Id. at 1378-79 (citation omitted).

Once again, the specific claim limitation that the examiner cited Orr *et. al.* as disclosing was "packing the stone in a box which protects the stone from damage" (for example as it appears in claim 1). The applicants could have argued that Orr *et. al.* did not disclose such packaging. But the applicants' did not Rather, the applicants argued that Orr *et. al.* did not disclose their "invention," or their "business method," saying *twice* that "Applicants' invention specifically does not include a sink," and adding that "the sink must be affixed to the slab using a special epoxy, as claimed in Claim 24." Claim 24 called for "in which each box further contains a container of epoxy, for attaching a sink to the stone slab." Lundin Decl. Exh. B at B-90.

Romala Stone argues that the foregoing statements did not "expressly disavow any scope of the claim terms at issue." Romala Stone's Response at 23. But that is not a fair characterization And even if it was, that is not the point-at least insofar as Romala Stone confines those statements to the "fastening means." The statements clearly tell a reader what "Applicants' invention" is not The arguments plainly compared the countertop and sink combination of Orr *et. al.* with "[a]pplicant's invention." Also, the applicants plainly argued that their "business method" was "for the consumer to buy the natural stone slab" and then "the sink must be affixed to the slab using a special epoxy" referencing claim 24. The limitation in claim 24, like the limitation here, referred to packaging the epoxy ("fastening means") with the stone top or "slab."

Romala Stone says that the foregoing statements were "directed at clarifying the invention to the Examiner." Romala Stone's Response at 23. But those are precisely the types of statements that may be limiting. In *Alpex Computer Corp. v. Nintendo Co.*, 102 F.3d 1214, 1219 (Fed.Cir.1996), for example, the patentee during prosecution argued that "Applicants' display system utilizes a random access memory \* \* \* Okuda [a prior art reference], in contrast, does not use a random access memory \* \* \* Okuda contemplates modification of one line of data at a time." The district court disregarded those statements in construing the claims because those statements were made in the context of non-asserted claims. The Federal Circuit reversed holding that those statements were limiting Also, in *Phillips*, the Federal Circuit explained that the "prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention \* \* \* " 415 F.3d at 1317.

Romala Stone's other arguments have been considered, but are not persuasive. As the court wrote in *Phillips*, "[u]ltimately, the interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim. The construction that stays true to the claim language and most naturally aligns with the patent's description of the invention will be, in the end, the correct construction." 415 F.3d at 1316, quoting *Renishaw*, 158 F.3d at 1250.

### **3. Conclusion**

The "construction that stays true to the claim language and most naturally aligns with the patent's description of the invention" is that "packaging fastening means with the precut top" means packaging "fastening means," as above construed, in a package with the precut top. The "precut top" and "fastening means" are separate items included in the same package. The limitation and the claims as a whole do not encompass attaching a sink to a stone top before the stone top is packaged and shipped.

### **C. Recommendation**

Accordingly, the master recommends that the Court adopt the following construction:

The limitation "packaging fastening means with the precut top" means packaging "fastening means," as above construed, in the package with the precut top. The "precut top" and "fastening means" are separate items included in the same package. The limitation and the claims as a whole do not encompass attaching a sink to a stone top before the stone top is packaged and shipped.

## **VIII.**

**"packaging a back splash with the pre cut top"**

## A. The Parties' Proposed Construction

The parties' respective proposed constructions are as follows:

Claim Term	Romala Stone's Proposed Construction	Home Depot's Proposed Construction
"packaging a back splash with the pre cut top"	Packaging [Including] a backsplash with the pre-cut top by a method disclosed	Placing a backsplash into the box with the precut top
	JCC Brief at A1-7 and B-3 Plf CC Brief at 22	JCC Brief at A2-12 and B-3 Def CC Brief (not construed in Brief or Exhibit A)

The phrase appears in dependent claims as follows:

1. A method for providing a pre cut non man made, non custom ordered stone top to enable assembly line production and sale of the top at a price affordable to an average consumer, the method comprising the steps of pre cutting non man made stone into the pre cut top suitable for installation by the average consumer, wherein the precut top defines cut outs to accommodate at least one sink and/or faucet, packaging the precut top for protecting the pre cut top from breakage and scratching, packaging fastening means with the precut top, and shipping a plurality of the packaged precut tops to a retailer for sale to and installation by the average consumer.

\* \* \*

4. The method of claim 1 wherein the step of packaging further comprises packaging a back splash with the pre cut top [Emphasis added.]

\* \* \*

9. A method for providing a pre cut non man made stone top which can be installed by an average consumer and is not custom ordered by the average consumer, the method enabling assembly line production of the top and sale of the top at a price affordable to the average consumer, the method comprising the steps of.

\* \* \*

13. The method of claim 9 wherein the step of packaging further comprises packaging a back splash with the pre cut top [Emphasis added.]

Romala Stone contends that the language of the specification is straightforward, urging that the "preferred embodiment is a discussion of the backsplash box that is inside of an outer box and is designed to hold a

backsplash." Romala Stone's Brief at 22.

Home Depot contends that the phrase "packaging a backsplash with the pre cut top" does not require construction because its meaning would be clear to one of ordinary skill in the art in light of other proposed constructions. Home Depot's Brief at 10 n. 5.

It is not clear that this term is any longer in dispute. Home Depot presented PowerPoint slides at the *Markman* hearing suggesting generally that if Romala Stone's proposed construction "by a method disclosed" was limited to the "unique packaging" disclosed in the specification, then Home Depot would agree to that construction.

If there *is* any dispute between the parties, it apparently is limited to whether the step of "packaging" limits the claims to the specific packaging disclosed in the specification. As discussed above, Home Depot points to nothing in the specification or prosecution history that suggests Romala Stone gave "packaging" any special or lexicographical meaning that would limit "packaging" *per se* to the packaging described in the specification, nor has any been found on independent review. Nor has Home Depot pointed to anything in the context of the claim language that would require such limitation, and nothing has been found on independent review. Nor has Home Depot pointed to anything in the context of the prosecution history that would require such limitation, and nothing has been found on independent review.

## **B. Recommendation**

Accordingly, the master recommends that the Court conclude that, absent further submissions from the parties, "packaging a backsplash with the pre cut top" does not require construction.

## **IX.**

### **Final Report and Recommendation**

This is the master's *final* report and recommendation. Under Rule 53(g)(2), FED. R. CIV. P.:

(2) Time To Object or More. A party may file objections to-or a motion to adopt or modify-the master's order, report, or recommendation no later than 20 days from the time the master's order, report, or recommendation are served, unless the court sets a different time. [Emphasis added.]

Accordingly, the parties are encouraged to determine whether an order from the court modifies the foregoing. Also, the parties are encouraged to review Rule 53(g)(3), (4), FED. R. CIV. P., relating to the Court's *de novo* review of findings of fact and conclusions of law.

Although this is the master's final report and recommendation for purposes of filing objections, or motions to adopt or modify, the parties may, of course, seek further comment or clarification through motions directed to the Court.

SIGNED this 30<sup>th</sup> day of March, 2007, in San Antonio, Texas.

### ***Certificate of Service***

I hereby certify that on the 30th day of March 2007, a true and correct copy of the above and foregoing was

delivered via e-mail and Federal Express to the following parties.

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