

United States District Court,
C.D. California.

DBEST PRODUCTS, INC,
v.
STAPLES, INC.

No. CV 07-4895 ODW(MANx)

Nov. 19, 2008.

Attorneys Present for Plaintiff(s): Not Present.

Attorneys Present for Defendant(s): Not Present.

OTIS D. WRIGHT II, District Judge.

Raymond Neal Deputy Clerk

Not Present Court Reporter

n/a Tape No.

Proceedings (In Chambers): Claim Construction Order

Pending before the Court is the claim construction on United States Patent No. 7,066,476 ("the '476 Patent"). The parties filed their respective claim construction briefs on September 2, 2008.

The '476 Patent pertains to a molded lid that fits over the opening of a carrying box on a two-wheeled cart to serve as a cover and a seat. When the lid is not acting as a cover/seat on top of the carrying box, it can be attached to the front of the box for storage and transport. Specifically, the '476 Patent claims a combination cover and seat with protrusions that are "configured" to allow the cover/seat to attach to the front side of a carrying box/cart using a "tight friction fit." The claim construction dispute here focuses on what the term "tight friction fit" means and how the protrusions must be "configured" in order to create a tight friction fit.

I. BACKGROUND

The '476 Patent was issued on June 27, 2006 to inventor Richard Elden for "SIDE ATTACHABLE COVER/SEAT FOR A CART CARRYING BOX." The '476 Patent has 5 claims of invention. Only certain elements of Claims 1 and 5, the only independent claims, are in dispute for claim construction in this Order. FN1 Claim 4 is also at issue, but the parties agree on its construction.

FN1. Claims 1 and 5, in their entirety, read as follows (with the bolded font representing the disputed claim

language):

1. A combination cover and seat for a carrying box having a top opening and a front side hand hole, the combination cover and seat comprising: a rigid planar surface smooth and flat on top conforming in shape to a top opening in a carrying box having a top opening and a front side hand hole to admit a hand of a user for lifting the carrying box, the rigid planar surface fitting securely thereon in a first position over the top opening to serve as a cover and a seat on top of the carrying box, the rigid planar surface having at least two protrusions on a bottom surfaces, ***the protrusions configured to engage the hand hole on the front side of the carrying box with a tight friction fit to enable the rigid planar surface to be secured to the front side of the carrying box with the protrusions engaging the hand hole on the front side of the carrying box with a tight friction fit in a second position*** for securing the rigid planar surface to the front side of the carrying box for storage and transporting.

5. In combination a folding carrying box and a combination cover and seat for the folding carrying box, the combination comprising: a carrying box comprising a bottom, a back side mounted on a two-wheeled hand truck having a pair of back wheels and a long extensible and retractable handle, a front side having a hand hole therein to admit a hand of a user for lifting the carrying box, a pair of opposing side panels between the front side and the back side, the side panels each structured to fold in along a hinged vertical fold line in each of the side panels to collapse the carrying box to fold flat for storage, and a top opening in the carrying box; a rigid planar surface smooth and flat on top conforming in shape to the top opening in the carrying box, the rigid planar surface fitting securely thereon in a first position over the top opening to serve as a cover and a seat on top of the carrying box with the carrying box in a stationary position with the front of the carrying box contacting the ground, the rigid planar surface having at least two protrusions on a bottom surface, ***the protrusions configured to engage the hand hole on the front side of the carrying box with a tight friction fit to enable the rigid planar surface to be secured to the front side of the carrying box with the protrusions engaging the hand hole on the front side of the carrying box with a tight friction fit in a second position for securing the rigid planar surface to the front side of the carrying box*** for storage and transporting so that the rigid planar surface can remain attached to the front side of the carrying box when it is folded flat.

A. The Patent Claims at Issue

As set forth in the Joint Claim Construction Chart filed on August 18, 2008, Plaintiffs and Defendants have agreed upon the construction for the following claim elements:

Claim 1:(a) a rigid planar surface-Both parties agree that this should be construed as "A lid having a flat or level surface that has a fixed outer shape." (b) The element of Claim 1 which reads "the rigid planar surface fitting securely thereon in a first portion over the top opening to serve as a cover and a seat on top of the carrying box"-Both parties agree that this should be construed as "In a first position, the rigid planar surface (i.e. the cover) fits over the top opening of the carrying box so that the cover is the proper size and shape to cover the top opening and rests in a stable condition so that the cover will not move off the carrying box when a person sits on the cover."

With respect to the remaining aspects of Claim 1, all of the other elements require no construction except for

the last element of Claim 1 on which there is a disagreement for which the Court will examine and construe as will be set forth below.

Claim 4: The only element of Claim 4 that the parties wish to clarify is "waffle pattern." Both parties agree that "waffle pattern" should be construed to read "having a grid-like or crisscrossed pattern."

Claims 2 and 3 require no construction, and the elements of Claim 5 that require construction are the same elements as set forth in Claim 1. Accordingly, this *Markman* hearing is solely focused on interpretation of the last element of Claim 1.

The only claim element that is in dispute and requires claim construction is the last element of Claim 1. A portion of Claim 5 is also in dispute, but the disputed language is identical to the that found in Claim 1. The actual claim language reads as follows:

the protrusions configured to engage the hand hole on the front side of the carrying box with a tight friction fit to enable the rigid planar surface to be secured to the front side of the carrying box with the protrusions engaging the hand hole on the front side of the carrying box with a tight friction fit in a second position for securing the rigid planar surface to the front side of the carrying box for storage and transporting.

Plaintiffs request the Court to construe the claim to read as follows (the underlined portions indicate the parties' disputed construction):

Protrusions that *may have a thickened end remote from the cover* that enable the cover to be secured to the front side of the carrying box by means of the tightness created by protrusions and the sides (or walls) of the hand hole rubbing against one another in a *manner which enables the cover to be removed by a pulling force to overcome the contact of the protrusions against the opposite sidewalls of the hand hole*.

Defendant believes Claim 1 should be construed as follows:

Protrusions that are *devoid of a nib, flange, hook or other interlocking structure or means and that* enable the cover to be secured to the front side of the carrying box solely by means of the tightness created by protrusions and the sides (or walls) of the hand hole rubbing against one another. *In order to be a "tight" friction fit, the cover must be affixed such that it does not move when firmly secured to the front.*

The Court will examine both Plaintiffs' and Defendants' proposed constructions, and will develop a final construction of Claims 1 and 5.

II. LEGAL STANDARD

In an action for patent infringement, the infringement analysis entails two steps: "The first step is determining the meaning and scope of the patent claims asserted to be infringed" and "[t]he second step is comparing the properly construed claims to the device accused of infringement." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed.Cir.1995), *aff'd.*, 517 U.S. 370, 372 (1996). When applying the first step, the meaning of a disputed patent claim term remains a question of law for the Court to decide. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

During the construction, "[t]he words of a [patent] claim are generally given their ordinary and customary

meaning," which is "the meaning that the term would have to a person of ordinary skill in the art in question ... as of the [patent's] effective filing date." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed.Cir.2005). "Importantly, 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." *Id.* The Court then considers whether the ordinary meaning is consistent with the manner in which the patentee used the term in the claims, the specification, and the prosecution history. *Markman*, 52 F.3d at 986; *Phillips*, 415 F.3d at 1313-14. The patent's specification is "the single best guide to [its] meaning." *Id.* at 1315. Thus, "[t]he 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." *Phillips*, 415 F.3d at 1316 (quoting *Renishaw PLC v. Marposs Societa' Per Azioni*, 158 F.3d 1243, 1250 (Fed.Cir.1998)).

After reviewing the language of the claims, the Court should then look to the specification, which "is the single best guide to the meaning of a disputed term." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). The importance of the specification in interpreting a claim term is derived from the statutory requirement, 35 U.S.C. s. 112, that the specification describe the claimed invention in "full, clear, concise, and exact terms." As a result, the specification necessarily "informs the proper construction of the claims." *Phillips*, 415 F.3d at 1316. "[T]he specification may define claim terms by implication such that the meaning may be found in or ascertained by a reading of the patent documents." *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1334-35 (Fed.Cir.2004).

In construing claim terms, a court should also consider any other evidence intrinsic to the patent file, including "the complete record of the proceedings before the PTO [and] the prior art cited during the examination of the patent." *Id.* at 1317. As with the specification, the prosecution history may demonstrate how the PTO and the applicant understood the patent, as well as "whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Id.* However, the file evidence should not be given undue weight because the statements in it are part of "an ongoing negotiation" between the patent office and the inventor and thus "often lack[] the clarity" of the final product. *Id.*

Finally, the Court may also consider relevant extrinsic evidence, which is "all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises." *Id.* The Court uses this type of evidence with caution as the Federal Circuit has explained that evidence is generally "less significant than the intrinsic record in determining the legally operative meaning of claim language." *Id.* (citations omitted). When used, extrinsic evidence cannot "vary or contradict" claim language, *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed.Cir.2003), but it can be useful "for a variety of purposes, such as to provide background [and] to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person with skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field." *Phillips*, 415 F.3d at 1318.

III. DISCUSSION

The task before the Court is to provide the patent's terms "the meaning that [they] would have to a person of ordinary skill in the art in question" in the context of the entire patent. *Phillips*, 415 F.3d at 1313. Claim construction must begin with-and remain centered on-the claim language itself, for that is the language the patentee has chosen to particularly point out and distinctly claim the subject matter which the patentee

regards as his invention. *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1116 (Fed.Cir.2004) (citations omitted) (reaffirmed in *Phillips*, 415 F.3d at 1312). The claim language here does not provide much help in resolving the claim construction issues before the Court, as those issues generally turn on distinctions not made in the claims.

The first term the parties attempt to define is "protrusions." Looking to the patent's specification, there is no definition set forth regarding the protrusions that are on the underside of the lid/cover. In the patent drawings, the protrusions are illustrated as element 21. At column 4, lines 48-51, the specification reads, "[t]he cover/seat 20 has a number of protrusions 21, preferably four, on a bottom surface capable of fitting into the hand hold 31." Then, at column 5, lines 17-22, it states, "the cover/seat 20 fits securely over the opening 35 in the carrying box 30 and may be lifted off, as in FIG. 3, and rotated into a vertical position, as in FIG. 4 for attaching to a front side of the carrying box 30 with the bottom protrusions 21 engaging the hand hole 31 in the carrying box 30." This language does not exactly explain how the "protrusions" are specifically shaped. The prosecution history also does not provide guidance concerning the term "protrusions."

Although the patent's specification does not define "the protrusions," it is necessarily limited by the following language: "the protrusions *configured to engage the hand hole ... with a tight friction fit.*" (emphasis added). Defendants attempt to further limit the term "protrusions" by proposing that the claim be construed as "[p]rotrusions that are devoid of a nib, flange, hook or other interlocking structure or means." This language is simply too limiting, especially in light of the language in the preamble of Claim 1 that states, "the combination cover and seat comprising." In *Medichem v. Rolabo*, the Federal Circuit stated that the transition term "comprising" in the preamble of a method claim "indicates that the claim is open-ended and allows for additional steps." *Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed.Cir.2003). The Federal Circuit noted that if the claim were limited to only the elements presented, the transition term would have been "consisting of" rather than "comprising." *Id.* Therefore, Defendants' first proposal that limits "the protrusions" will not be adopted.

In addition, Plaintiffs' proposed construction states, "[p]rotrusions that may have a thickened end remote from the cover." While this language, because it uses the term "may," is consistent with a comprising claim, it is nonetheless superfluous. Plus, it is not supported by the specification language or the prosecution history. Plaintiffs state their sole support for this language comes from the figure drawings in the patent. This argument is a stretch as the drawings are not technical drawings of the protrusions themselves, but rather drawings to show the entire cover. Further, the Court simply does not see a thickened end illustrated in the drawings. Therefore, the Court will not adopt Plaintiffs' construction in this regard.

The next phrase the parties dispute is "tight" friction fit. Defendants' proposed construction states, "In order to be a 'tight' friction fit, the cover must be affixed such that it does not move when firmly secured to the front." This language is headed in the right direction. The Court, however, takes issue with the term "move" within this language. Defendants even conceded at oral argument that the term "move" may be too restrictive. Therefore, taking into consideration the context of the entire patent, the Court will use the term "detach" in place of "move" in Defendant's construction.

The Court also adds "during storage and transport" to the end of Defendants' proposed language. Throughout the specification, the phrase "tight friction fit" is used to describe the cover's interaction with the cart when it is "storage and transportation" mode.FN2 Therefore, adding this phrase to the end of the claim is consistent with the specification's language. Further, this construction "stays true to the claim language

and most naturally aligns with the patent's description of the invention." Phillips, 415 F.3d at 1316 (quoting Renishaw, 158 F.3d at 1250).

FN2. At oral argument, Defendants' counsel suggested that adding "during storage or transport" would be interpreting the claim as a means-plus-function claim. However, based on the claim's language, it clearly is not to be interpreted as a means-plus-function claim as defined by 35 U.S.C. s. 112, para. 6. Therefore, Defendants' counsel's argument was somewhat of a red herring.

With regard to Plaintiffs' proposed construction of "tight" friction fit, Plaintiffs state there is a tightness created by the protrusions and the sides of the hand hole rubbing against one another "in a manner which enables the cover to be removed by a pulling force to overcome the contact of the protrusions against the opposite sidewalls of the hand hole." This language reiterates a tight friction fit, but, as was raised at oral argument, creates problems. "To be removed by a pulling force" is vague and open to different interpretations. Does this mean the pulling force of a child or the pulling force of a machine? Presumably, many plastic clasps or interlocking pieces could be removed if the pulling force was strong enough. Therefore, this portion of Plaintiffs' proposed construction will not be adopted.

IV. CONCLUSION

Based on the foregoing analysis, the Court's final construction of the disputed portion of Claim 1 is as follows:

Protrusions that enable the cover to be secured to the front side of the carrying box solely by means of the tightness created by protrusions and the sides (or walls) of the hand hole rubbing against one another. In order to be a "tight" friction fit, the cover must be affixed such that it does not detach when firmly secured to the front during storage and transport.

C.D.Cal., 2008.

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