

United States District Court,
N.D. Illinois, Eastern Division.

INTERSTORE TRANSFER SYSTEMS,
LTD Plaintiff.

v.

HANGER MANAGEMENT, INC., an Illinois corporation, and Richard Simmerman,
Defendants.

Feb. 10, 1997.

MEMORANDUM OPINION AND ORDER

ANDERSEN, District Judge.

On November 7, 1996, Magistrate Judge Edward A. Bobrick filed and served on the parties his Report and Recommendation concerning the parties' cross-motions for summary judgment in this case concerning allegations of patent infringement, both literal and under the doctrine of equivalents. The Magistrate Judge recommended that plaintiff's motions for summary judgment on both issues be denied. He recommended that defendants' motion for summary judgment on the issue of literal infringement be granted, but recommended denial of defendants' motion for summary judgment on the issue of infringement under the doctrine of equivalents, recommending instead that the issue be tried.

After carefully considering the above-referenced motions for summary judgment, the applicable memoranda of law, other relevant pleadings, the Magistrate Judge's Report, and the parties' objections thereto, this Court hereby adopts the report and recommendations of the Magistrate Judge concerning the parties' motions for summary judgment.

BACKGROUND

This case concerns hanger bar assemblies designed for retail clothing industry workers to use to collect and store empty clothes hangers efficiently. The patent on plaintiff's device, U.S. Patent No. 4,753,355 ('355 Patent), was issued in 1988. The patent on the accused device, U.S. Patent No. 5,509,542 ('542 Patent), was issued in 1996. Each device consists of, among other things, a tubular hanger bar, with polygonal end caps, on which clothes hangers can be hung by their hooks, a retainer bar that can be pushed down toward the hanger bar in order to keep the hangers in place, and means to keep the retainer bar away from the hanger bar and also to keep it near the hanger bar, depending on the user's needs.

Plaintiff filed this suit after learning that defendant Simmerman, president of defendant corporation HMI and former president of plaintiff's Wisconsin operation, intended to introduce the accused device in April 1996 at an industry trade show. Knowing that defendants planned to market the accused device at a lower price than that of plaintiff's commercial embodiment and fearing a loss of business, plaintiff, in addition to filing an infringement claim, sought, and was denied, a temporary restraining order to prevent Simmerman

from presenting the accused device at the trade show.

Plaintiff asserts that the accused device infringes claims 4, 6, 7, 13, 14, 16, 18, 22, 23, and 24 of plaintiff's patent, both literally and under the doctrine of equivalents. Those claims concern the manner in which the hanger and retainer bars and their supporting members move in relation to one another, the manner in which the latching means relates to the retainer bar, and the polygonal shape of the hanger bar's end caps.

Plaintiff's claims 4, 6, 7 (6 and 7 being dependent on claim 4), 13, 14 (dependent on claim 13), 18, 22, 23, 24 (23 and 24 being dependent on claim 22) each require:

... a plurality of supporting members connected to and projecting from the hanger bar that slidably guide and support the retainer bar between a position away from the hanger bar and a position near the hanger bar [by which the retainer bar clamps] the interposed hanger hooks onto the hanger bar....

('355 Patent).

Claim 16 requires:

... a plurality of support[ing] members connected to and projecting from a hanger bar through the aperture in the retainer bar, said supporting members slidably guiding and supporting the retainer bar between a position away from the hanger bar and a position near the hanger bar, clamping the interposed hanger hooks onto the hanger bar, said supporting members including a plurality of slots for supporting said retainer bar....

('355 Patent).

Thus, each of the aforementioned claims requires "a plurality of supporting members connected to and projecting from" a "hanger bar, that slidably guide the retainer bar." ('355 Patent.)

Independent claims 4, 13, 16, 18, and 22 also require a "[latching] means for engaging and securing the retainer bar" into "[a] hanger clamping position securing the hangers on the hanger bar," with the latch being "releasable." ('355 Patent.)

Independent Claims 4, 16 and 22 require a "biasing means interposed between the hanger bar and retainer bar that urges the retainer bar into a position away from the hanger bar." ('355 Patent.)

Dependent claim 6 requires that each end cap include a "stop tab" to keep the hanger bar, held by clips to a bracket, in place ('355 Patent). Dependent claims 7 and 14 require that the bracket clips and end caps be polygonal in shape; dependent claim 23 requires that the hanger bar be rotatable, and dependent claim 24 requires that the end caps be polygonal in shape ('355 Patent).

DISCUSSION

I. Summary Judgment

Rule 56(c) of the Federal Rules of Civil Procedure provides that summary judgment shall be rendered "if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Fed.R.Civ.P. 56(c); *Salima v. Scherwood South. Inc.*, 38 F.3d 929, 932 (7th

Cir.1994). A genuine issue for trial exists only when "the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986).

The moving party bears the burden of demonstrating an absence of evidence to support the position of the nonmoving party, *Doe v. R.R. Donnelley & Sons Co.*, 42 F.3d 439, 442-43 (7th Cir.1994), and all reasonable inferences are drawn in favor of the party opposing the motion. *Associated Milk Producers, Inc. v. Meadow Gold Dairies, Inc.*, 27 F.3d 268, 270 (7th Cir.1994).

In making its determination, the Court's sole function is to determine "whether there is any material dispute of fact that requires a trial." *Waldrige v. American Hoechst Corp.*, 24 F.3d 918 (7th Cir.1994). Credibility determinations, weighing evidence, and drawing reasonable inferences are jury functions, not those of a judge when deciding a motion for summary judgment. *Anderson*, 477 U.S. at 255.

When, as here, cross-motions for summary judgment have been submitted, the Court is not obliged to grant judgment as a matter of law for one side or the other. *California Union Ins. Co. v. Liberty Mut. Ins. Co.*, 920 F.Supp. 908, 918 (N.D.Ill.1996) (*citing* *Heublein, Inc. v. United States*, 996 F.2d 1455, 1461 (2nd Cir.1993)). The Court must evaluate each party's motion on its own merits, resolving all factual uncertainties and drawing all reasonable inferences against the party whose motion is under consideration. *Id.*; *Buttitta v. City of Chicago*, 803 F.Supp. 213, 217 (N.D.Ill.1992), *aff'd*, 9 F.3d 1198 (7th Cir.1993). With these factors in mind, we assess the parties' motions.

II. Infringement

A determination of infringement requires a two-step analysis. First, the court must construe as a matter of law the claims asserted to be infringed in order to determine their meaning and scope. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, ----, 116 S.Ct. 1384, 1393, 134 L.Ed.2d 577 (1996). Second, the claims as construed are compared to the accused device. *Id.* In order for the accused device to be found to infringe literally, it must contain every limitation asserted in the claims. *Texas Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1563 (Fed.Cir.1996). Should no literal infringement be found, infringement may nevertheless be found under the doctrine of equivalents if the differences between the claimed invention and the accused device are deemed insubstantial. *Id.* at 1563-64.

A. Literal Infringement

1. "Connected to" Claims

Plaintiff's patent, in claims 4, 6, 7, 13, 16, 18, 22, 23, and 24, requires the presence of "supporting members connected to and projecting from the hanger bar that slidably guide the retainer bar." The parties' interpretations of that claim differ. Defendants move, and plaintiffs cross-move, for summary judgment on the issue of literal infringement.

Defendants maintain that, because the supporting members [pins] of its device are affixed to the retainer bar, rather than to the hanger bar, they are not "connected to" the hanger bar. Defendants assert that "connected to" means "fixed or secured to." (Mem. in Supp. of Defs.' Mot. for Summ.J. at 10.)

Plaintiff contends that the supporting members are indeed connected to the hanger bar, asserting that "connected to" means that the pins and the hanger bar are "in physical contact with [each other] ... and

cannot be separated without physical modification" or, that they are "connected to" one another because they are "linked together." (Pl.'s Opp'n to Defs.' Mot. at 12).

The parties' asserted meanings of "connected to" range from indirect to direct connections between objects. The Court's task is to construe the meaning of the disputed term. In *Vitronics Corp. v. Conceptronic. Inc.*, 90 F.3d 1576 (Fed.Cir.1996), the court laid out the applicable rules of claim construction:

the court should look first to intrinsic evidence of record, *i.e.*, the patent itself, including the claims, the specification and, if in evidence, the prosecution history....

First, we look to the words of claims themselves, both asserted and nonasserted, to define the scope of the patented invention. Although the words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history....

Thus, second, it is always necessary to review the specification to determine whether the inventor has used any terms inconsistent with their ordinary meaning.

Id. at 1582 (citations omitted).

Plaintiff's claim requires not only that the supporting members be "connected to" the hanger bar, but also that they "project from" the hanger bar. The term "connected to," therefore, has been modified, and must be interpreted in conjunction with the limitation that the members also "project from" the hanger bar. Looking at the specification, the Court finds no special definition of "connected to," "projecting from," or "connected to and project[ing] from" that would mandate attributing unusual meanings to the terms. Therefore, the Court construes the terms according to their ordinary meanings. The ordinary meaning of "connected" is "joined or linked together." *Webster's Ninth New Collegiate Dictionary* 278. The ordinary meaning of "project," with regard to concrete objects rather than ideas, is "to throw or cast forward: thrust" or "to cause to protrude." *Id.* at 940. Synonyms for "projecting" include "jutting," "protruding," and "protuberant." *Webster's New World Thesaurus* 591.

While the term "connected" would permit an indirect relation between objects, the necessity that the supporting members also "project from" the hanger bar compels a more direct relation. We agree with Magistrate Judge Bobrick that the language mandates that the pins be affixed to the hanger bar. For example, a hat and the head on which it rests are "connected," but one would not ordinarily state merely because of that connection that one's head projected from the hat, rather than from one's neck. Rather, a protruding object, such as a pin, ordinarily projects from something to which it is affixed, not necessarily from something to which it is merely somehow connected. One might argue that a pin that has been stuck into a pin cushion projects from the cushion. In that example, however, there is only one object from which the pin could project. Where, as here, the pin is situated between two bars, it would be more accurate to differentiate the relation of the pin to the two bars by stating that it projects from the bar to which it is affixed. In the accused device, the supporting members are affixed (by screws) to and project from the retainer bar. and the supporting members and the retainer bar move as one object—a rigid assembly—in relation to the hanger bar, which remains static. Plaintiff's patented claims, on the other hand, disclose a device in which the supporting members are affixed to the hanger bar, those two pieces constituting a rigid assembly that remains static in relation to the moving retainer bar. In a way, the accused device and

plaintiff's claimed invention are mirror images.

This Court finds no ambiguity in the language of plaintiff's claim. Plaintiff has assigned no special meanings in his specification to the disputed terms. Therefore, this Court, as a matter of law, construes the patented claim that the supporting members are connected to and project from the hanger bar to mean that the supporting members must be affixed to the hanger bar. The supporting members of the accused device are affixed to the retainer bar. Thus, this Court finds no literal infringement of plaintiff's "connected to" claims.

Defendants' motion for summary judgment on the issue of literal infringement is granted. Plaintiff's cross-motion is denied.

B. Doctrine of Equivalents

We now consider the parties' arguments regarding the doctrine of equivalents. Defendants move for summary judgment on this issue; plaintiff responds that the issue's resolution requires factual determinations that render summary judgment inappropriate.

Infringement under the doctrine of equivalents is often determined by the resolution of questions of fact, such as may be ascertained through application of the "function-way-result" test, i.e., whether the accused device performs substantially the same function in substantially the same way to achieve substantially the same result as the claimed invention. *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1583 (Fed.Cir.1996). "Like any issue of fact, final determination requires a balancing of credibility, persuasiveness, and weight of evidence." *Hilton Davis Chemical Co. v. Warner-Jenkinson Co., Inc.*, 62 F.3d 1512, 1520 (Fed.Cir.1995), *cert. granted sub nom. Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, - --U.S. ----, 116 S.Ct. 1014, 134 L.Ed.2d 95 (1996) (*quoting* *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605, 609-10, 70 S.Ct. 854, 857, 94 L.Ed. 1097 (1950)). These exercises are beyond the province of the court in a summary judgment proceeding. *Liberty Lobby*. 477 U.S. at 249-50, 106 S.Ct. at 2511; *Waldrige v. American Hoechst Corp.*, 24 F.3d 918, 920 (7th Cir.1994) (citations omitted).

In *Hilton Davis*, the court explained that:

a finding of infringement under the doctrine of equivalents requires proof of insubstantial differences between the claimed and accused products or processes. Often the function-way-result test will suffice to show the extent of the differences. In such cases. the parties will understandably focus on the evidence of function, way, and result, and the fact-finder will apply the doctrine based on the evidence. Other factors, however, such as evidence of copying or designing around, may also inform the test for infringement under the doctrine of equivalents.

62 F.3d at 1521-22.

Thus, here, whether the accused device performs substantially the same function in substantially the same way with substantially the same result as the claimed invention, despite there being no literal infringement, is an issue to be resolved by a fact-finder. Plaintiffs have proffered substantial evidence that the accused device may be the equivalent of the claimed invention. Each device has a hanger bar, retainer bar and supporting members. Each device clamps hangers between the hanger bar and the retainer bar. Each device uses a spring to keep the hanger bar and retainer bar apart, and each uses a latch to keep the bars together. Each device has polygonal end caps. (Pl.'s Resp. to Defs.' Stmt. of Unconst'd Facts, para. para. 10-12, Ex.

1.) This evidence would suffice to support a finding of infringement under the doctrine of equivalents by a reasonable trier of fact. "When there is substantial evidence to support a factual conclusion, summary judgment to the contrary is improper." *Lifescan, Inc. v. Home Diagnostics, Inc.*, 76 F.3d 358, 362 (Fed.Cir.1996).

Defendants' motion for summary judgment on the issue of infringement under the doctrine of equivalents is denied.

III. Objections

Both parties urge the Court to make further rulings with regard to subparagraphs of the asserted claims covering the latch means and the guiding method. We decline.

"To establish infringement, every limitation set forth in a patent claim must be found" in the accused device. *The Laitram Corp. v. Rexnord, Inc.*, 939 F.2d 1533, 1535 (Fed.Cir.1991). In *Laitram*, the plaintiff asserted infringement of claim 21 and the defendant asserted that its device failed to meet four out of seven subparagraphs of that claim. The Federal Circuit focused on one subparagraph and found that the plaintiff had failed to prove that the accused device satisfied the limitations asserted therein. The failure of a device to meet a single limitation of an asserted claim is sufficient to negate literal infringement of that claim. *Id.*

We have found that the accused device does not literally infringe the claimed invention because the supporting members in the accused device are affixed to the retainer bar, rather than to the hanger bar. All of the asserted claims, either independently or by incorporation, assert that the claimed invention contains supporting members that are connected to and project from the hanger bar. Having found that the accused device fails to meet one limitation set forth in the asserted claims and thus does not literally infringe, the Court has limited its analysis accordingly, *Laitram*, 939 F.2d. at 1535, and will not rule on issues presented in other subparagraphs of the asserted claims.

Defendants also object, for three reasons, to Magistrate Judge Bobrick's recommendation to try the issue of infringement under the doctrine of equivalents. First, defendants imply that the mere issuance of their patent indicates that the accused device does not infringe, citing *Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1571 (Fed.Cir.1996) (citations omitted): "The nonobviousness of the accused device, evidenced by the grant of a United States patent, is relevant to the issue of whether the change therein is substantial." We disagree with defendants' argument.

"The grant of a separate patent on the accused device does not automatically avoid infringement, either literal or by equivalency." *National Presto Industries, Inc. v. West Bend Co.*, 76 F.3d 1185, 1191 (Fed.Cir.1996). Here, neither party has submitted the file history on the accused device. Without the file history, we cannot discern which feature of defendant's claimed invention the patent examiner deemed patentable. There is, therefore, no evidence before us that the patent examiner found defendant's claimed invention to differ significantly from plaintiff's asserted claims. *See Id.* at 1192.

Defendants further criticize Magistrate Judge Bobrick's analysis of whether defendant Simmerman copied plaintiff's invention or designed around it, noting that he discussed the relation between the commercial embodiment of the asserted claims and the accused device, rather than the relation between the asserted claims and the accused device. Defendants state that the shape of the end caps on the commercial embodiment is irrelevant to any of the independent asserted claims. Defendants also argue that no

reasonable jury could find for plaintiff under the function-way-result test. We agree that the proper comparison is between the patented claims and the accused device. We note, however, that we reach the result recommended by Magistrate Judge Bobrick: we deny defendants' motion for summary judgment on the issue of infringement under the doctrine of equivalents. The plaintiff has submitted sufficient evidence of equivalency to withstand defendants' motion. Lifescan, 76 F.3d at 362.

IV. Conclusion

For the foregoing reasons, we grant defendants' motion for summary judgment on the issue of literal infringement, but deny their motion for summary judgment on the issue of infringement under the doctrine of equivalents. We deny plaintiff's cross-motion for summary judgment on the issue of literal infringement.

It is so ordered.

N.D.Ill.,1997.

Interstore Transfer Systems, Ltd. v. Hanger Management, Inc.

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