

United States District Court,  
D. Delaware.

**MOORE NORTH AMERICA, INC., Plaintiff,**  
Counter-Defendant.

v.

**POSER BUSINESS FORMS, INC., Defendant,**  
Counter-Claimant.

No. CIV.A.97-712-SLR

**Sept. 29, 2000.**

Thomas P. Preston, Esquire of Reed, Smith, Shaw & McClay, Wilmington, Delaware. Counsel for plaintiff, counter-defendant. Robert A. Vanderhye, Esquire, James D. Berquist, Esquire, and Robert A. Rowan, Esquire of Nixon & Vanderhye, Arlington, Virginia. Of counsel for plaintiff, counter-defendant.

N. Richard Powers, Esquire and Patricia Smink Rogowski, Esquire of Connolly, Bove, Lodge & Hutz, Wilmington, Delaware. Counsel for defendant, counter-claimant. Thomas H. Young, Esquire and Stephen D. Bell, Esquire of Dorsey & Whitney, Denver, Colorado. Of counsel for defendant, counter-claimant.

## **MEMORANDUM OPINION**

**ROBINSON, Chief J.**

### **I. INTRODUCTION**

Plaintiff Moore North America, Inc. filed this patent infringement action on December 30, 1997 against defendant Poser Business Forms, Inc., alleging that defendant infringes U.S. Patent No. 4,918,128 ("the '128 patent"); U.S. Patent No. 5,201,464 ("the '464 patent"); and U.S. Patent No. 5,253,798 ("the '798 patent"). Both plaintiff and defendant are engaged in the business of manufacturing and selling preformed, paper mailers. (D.I.158) Both the '464 and '798 patents are directed to the construction of a "one-piece mailer" which is a single sheet of paper that can be printed, folded, sealed, and mailed without the need for a separate envelope. (D.I. 139 at 4) The '128 patent is directed toward a pressure-sensitive adhesive that holds different mailers together.

Defendant denied infringement of all three patents-in-suit and filed a counterclaim for declaratory judgment of noninfringement, invalidity, and unenforceability. Defendant subsequently filed additional counterclaims including: (1) unfair competition under the Lanham Act, 15 U.S.C. s. 1125 (1994); (2) common law unfair competition; and (3) violations of the Delaware Uniform Deceptive Trade Practices Act, Del.Code Ann. tit. 6, s. 2532 (1974).

Plaintiff is incorporated under the laws of Delaware and has its principal place of business in Illinois. (D.I.1,

para. 1) Defendant is a Delaware corporation with its principal place of business in Alabama. (D.I.158, para. 2) The court has jurisdiction over this action under 28 U.S.C. s.s. 1331 and 1338. Venue is proper in this judicial district by virtue of 28 U.S.C. s.s. 1391(c) and 1400(b).

Currently before the court is plaintiff's motion for partial summary judgment of infringement of claim 1 of the '464 patent. (D.I.196) Both parties submitted extensive briefs on these issues, and oral arguments were heard on September 28, 2000. Although plaintiff originally alleged that two different forms marketed by the defendant infringed the '464 patent, plaintiff has limited its motion to literal infringement of only one form. For the following reasons, the court denies plaintiff's motion.

## II. BACKGROUND

The '464 patent, entitled "Pressure Seal C-Fold Two-Way Mailer," discloses a form construction with an integral return envelope that allows a user to incorporate a return mail piece with an outgoing piece of mail. Plaintiff contends that defendant markets a return mail form under the product code RC814BA that infringes claim 1 of the '464 patent.

Claim 1 of the '464 patent reads as follows:

1. A mailer type business form intermediate, comprising:

a sheet of paper having a first face, adapted to provide the majority of the interior of the mailer when constructed, and a second face, adapted to provide the majority of the exterior of the mailer when constructed;

said sheet having first and second opposite, parallel longitudinal edges extending the entire length thereof, and opposite ends;

first and second longitudinal lines of weakness formed in said sheet parallel to and adjacent, but spaced from, said first and second longitudinal edges, respectively, said lines of weakness defining, with said longitudinal edges, longitudinal marginal portions;

first and second longitudinal strips of adhesive disposed in said first and second longitudinal marginal portions, respectively, of said first face, extending the majority of the lengths of said longitudinal marginal portions, and parallel to said first and second longitudinal edges;

third and fourth longitudinal strips of adhesive disposed parallel to said first and second strips, and disposed adjacent said first and second lines of weakness on the opposite side thereof from said first and second strips, on said first face, said third and fourth longitudinal strips disposed closer to one end of said ends than the other, and extending a distance substantially less than the extent of said first and second strips;

fifth and sixth longitudinal strips of adhesive parallel to said first and second longitudinal edges and disposed in said first and second marginal portions, respectively, on said second face, said fifth and sixth strips located adjacent the same end of said sheet as said third and fourth strips, and having a longitudinal extent at the most equal to said [third] and fourth strips;

means defining a transverse adhesive strip on said first face, perpendicular to said third and fourth strips,

longitudinally spaced from said third and fourth strips; and

means defining a line of weakness adjacent said transverse strip, on the opposite side thereof from said third and fourth strips, to allow ready separation of the paper at that line.

('464 patent, col. 10, lns. 40-68 to col. 11, lns. 1-18) The parties agree on a "majority" of the claim language, but dispute the terms in boldface. The parties also dispute whether the claims read on the defendant's accused product.

The accused form differs from the illustration of the patent's preferred embodiment in one primary way. To seal the outer margins of the mailer, the accused form uses a series of triangle-shaped spots of adhesive while the preferred embodiment in the '464 patent depicts rectangles of adhesive with discontinuities. One issue is whether the series of triangles constitute a "strip of adhesive." Plaintiff claims that a strip of adhesive is a "pattern of adhesive that may be a continuous or discontinuous pattern, such as spaced individual elements, of any size, or shape, such as discontinuous blocks or polygons." (D.I. 138 at 8) Plaintiff contends that the discontinuities between the segments of adhesive are part of the "strips" of adhesive. Defendant agrees that "strips of adhesive" can be discontinuous, but disagrees with plaintiff's position that the discontinuities between individual adhesive segments are counted as part of the "strips." (D.I. 148 at 12)

## **II. STANDARD OF REVIEW**

A court shall grant summary judgment only 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 judgment as a matter of law." Fed.R.Civ.P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. *See Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 586 n. 10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." *Horowitz v. Federal Kemper Life Assurance Co.*, 57 F.3d 300, 302 n. 1 (3d Cir.1995) (internal citations omitted). If the moving party has demonstrated an absence of material fact, the nonmoving party then "must come forward with 'specific facts showing that there is a genuine issue for trial.'" *Matsushita*, 475 U.S. at 587 (quoting Fed.R.Civ.P. 56(e)). The court will "view the underlying facts and all reasonable inferences therefrom in the light most favorable to the party opposing the motion." *Pennsylvania Coal Ass'n v. Babbitt*, 63 F.3d 231, 236 (3d Cir.1995). The mere existence of some evidence in support of the nonmoving party, however, will not be sufficient for denial of a motion for summary judgment; there must be enough evidence to enable a jury reasonably to find for the nonmoving party on that issue. *See Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 249 (1986). If the nonmoving party fails to make a sufficient showing on an essential element of its case with respect to which it has the burden of proof, the moving party is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 322 (1986).

## **III. CLAIM CONSTRUCTION**

### **A. The Legal Standard**

Before addressing the arguments raised in the motion for summary judgment, the court must first construe the disputed claim language. It is the court's "power and obligation to construe as a matter of law the meaning of language used in the patent claim." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979

(Fed.Cir.1995), *aff'd*, 517 U.S. 370 (1996). The principles of claim construction are well established. The exercise begins with the claim language, which defines the scope of the claim. *See* York Prods., Inc. v. Central Tractor Farm & Family Ctr., 99 F.3d 1568, 1572 (Fed.Cir.1996). In analyzing claim language, the court must employ "normal rules of syntax," Eastman Kodak Co. v. Goodyear Tire & Rubber Co., 114 F.3d 1547, 1553 (Fed.Cir.1997) for "[a] claim must be read in accordance with the precepts of English grammar." *In re Hyatt*, 708 F.2d 712, 714 (Fed.Cir.1983). The court also must ascribe to any technical term used in a claim "the meaning that it would be given by persons experienced in the field of the invention, unless it is apparent from the patent and the prosecution history that the inventor used the term with a different meaning." *Hoechst Celanese Corp. v. BP Chems., Ltd.*, 78 F.3d 1575, 1578 (Fed.Cir.1996).

In order to give context to the claim language, the court also must review the specification. The Federal Circuit has explained that

the specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication .... As we have repeatedly stated, "claims must be read in view of the specification, of which they are a part." ... The specification contains a written description of the invention which must be clear and complete enough to enable those of ordinary skill in the art to make and use it. Thus, the specification is always relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of the disputed term.

*Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996).

The last source of intrinsic evidence relevant to claim construction is the prosecution history of the patent where it is in evidence. The prosecution history contains the complete record of all the proceedings before the Patent and Trademark Office, "including any express representations made by the applicant regarding the scope of the claims." *Id.* at 1583. The prosecution history, therefore, "is often of critical significance in determining the meaning of the claims." *Id.* Extrinsic evidence of claim meaning, on the other hand, is improper in most instances. *See id.* Extrinsic evidence includes expert testimony.

## **B. Analysis**

The first disputed term is "strips of adhesive." It is undisputed that the accused form uses adhesive. The parties dispute what constitutes a "strip" of adhesive.

A "strip" is "a narrow piece of about even width." *Webster's Third New International Dictionary* 2264 (1993) (" *Webster's* "). This definition shall serve as the default because nothing in the specification suggests that the patentee chose to be his own lexicographer. *See* *Multiform Desiccants, Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477 (Fed.Cir.1998). The prosecution history shows that the applicant originally used the word "strips" throughout the specification interchangeably with "strips of adhesive" or "adhesive strips." (D.I. 138, Ex. D at D18-D26) The examiner objected to the disclosure because of the inconsistent use of that terminology ( *id.* at D41), and the applicant amended the specification accordingly. ( *Id.* at D53) The prosecution history does not, however, shed any light on what constitutes a "strip."

Neither party submitted extrinsic evidence to show what one of ordinary skill in the art would understand "strips of adhesive" to encompass. Since both parties' proposed definitions were drafted with an eye toward the accused product, the court will use the dictionary definition. Thus, based on the current record, a "strip of adhesive" is a narrow piece of glue of about even width. FN1

FN1. At oral argument counsel referred the court to, *inter alia*, the '798 patent specification which was filed less than six months after the application for the '464 patent was filed. That patent describes "patterns of adhesive" as "discontinuous strips." ('798 patent, col. 4, lns. 14-45) The patent also uses the terms "adhesive patterns/strips" and "longitudinal strips/patterns" in the specification. ( *Id.*, col. 5, lns. 3-5) The court also notes that the specification of another Moore mailer patent involved in a pending case before the court provides:

It will be understood that the strips of adhesive adjacent the respective side edges may be placed anywhere along the edges so long as there will be adequate adhesive to properly seal the mailer 10 when completed to satisfy users and postal authorities. In other words, the adhesive may be intermittent, such as dots. When "strip" of adhesive is used in the appended claims such intermittent coverage is included.

(U.S.Pat. No. 4,928,875, col.2, lns.17-24) ("the '875 patent") The application for that patent was filed more than two years before the application for the '464 patent. Absent evidence that the above explanations were understood by persons of ordinary skill in the art, the court is left with the conclusion that the inventors of the '798 and '875 patents chose to be their own lexicographers; the inventor of the '464 patent did not. The accused device uses a series of triangle-shaped spots of glue. The court cannot conclude that the series of triangles satisfies the "first and second longitudinal strips of adhesive" element of claim 1. To be liable for literal infringement under section 35 U.S.C. s. 271(a), the accused device must be shown to include every element of the claim. *See Builders Concrete, Inc. v. Bremerton Concrete Prods. Co.*, 757 F.2d 255, 257 (Fed.Cir.1985). Because plaintiff failed to show one element, the court cannot find that the accused form literally infringes claim 1. Moreover, since plaintiff failed to show that one claim element read on the accused form, there is no need to discuss the other disputed claim elements.

#### **IV. CONCLUSION**

Based on the record presented, plaintiff's motion for summary judgment of literal infringement of claim 1 of the '464 patent is denied. FN2

FN2. As is its practice, the court will render its final claim construction at the time of trial.

D.Del.,2000.

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