

United States District Court,
S.D. New York.

DRI MARK PRODUCTS INC,
Plaintiff.

v.
NATIONAL INK INC. and DIXON TICONDEROGA CO,
Defendants.

No. 01 CIV.6541(HB)

April 11, 2002.

OPINION & ORDER

BAER, District J.

Plaintiff Dri Mark Products Inc. ("Dri Mark") brought an action against its competitors, defendants National Ink, Inc. ("National Ink") and Dixon Ticonderoga Co. ("Dixon") for patent infringement with respect to metallic ink markers. The parties contest various terms of the patent claims, including the scope of the term "anti-settling agent." Based on their proposed claim construction, the defendants additionally move for summary judgment. In accordance with *Markman v. Westview Instruments*, 52 F.3d 967 (Fed.Cir.1995), *aff'd*, 517 U.S. 370 (1996), the court construes the term "anti-settling agent" as "an anti-settling agent that is both ionic and derived from a polycarboxylic acid." In light of this construction, the defendants' motion for summary judgment is GRANTED.

I. FACTS

When these parties first appeared for a pre-trial conference in September, 2001, counsel for the plaintiff predicted this case would likely boil down to the meaning of the term "anti-settling agents." Unfortunately for the plaintiff, I agree.

On October 12, 1999, Dri Mark applied for U.S. Patent No. 6,224,284 (" '284"), which was eventually issued on May 1, 2001. In short, Dri Mark's innovation can be described as a wick type writing instrument, or marker, that uses metallic ink vis a vis, among other things, an "anti-settling agent." '284 Pat. col. 1:42-44. Metallic ink, which is able to leave distinct writing on dark surfaces, shiny surfaces or glass, contains metal particles that tend to clog and settle in the interior parts of conventional markers. To accommodate this problem, metallic ink markers prior to Dri Mark's invention utilized a system of valves or pumps that required the user to shake the marker in order to disburse the settled particles. '284 Pat. col. 1:8-17. Without the shaking or the valves, the ink was traditionally unable to properly flow through the writing instrument, thereby preventing the user from writing with an even consistency. In contrast, Dri Mark's marker requires no shaking, valves or pumps. Instead, it delivers the metallic ink via "capillary action" that is possible, in part, because Dri Mark utilizes "an anti-settling agent to keep aluminum flakes in suspension." '284 Pat. col.

On April 2, 2002, I held a joint Markman Hearing and oral argument on the defendants' motion for summary judgment. FN1 Dri Mark alleges infringement on four claims in the '284 patent, specifically, claims 1, 2, 18 and 19. FN2 The defendant National Ink is a manufacturer of ink and defendant Dixon makes markers and is a customer of National Ink. The parties dispute several terms contained in the patent claims, including the term "anti-settling agent," which is referenced in all four of the contested claims. FN3 Claim construction, however, is necessary only with respect to the anti-settling agent since the court's construction of this term resolves the defendants' motion. *See Vivid Technologies, Inc. v. American Science & Engineering, Inc.*, 200 F.3d 795, 803 (Fed.Cir.1999) ("[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.").

FN1. The Markman Hearing consisted of only the arguments of counsel. While I had conveyed to the parties prior to the Markman Hearing and again on April 2, 2002, that I was willing to hear any testimony or other evidence that they felt was necessary to best support their arguments, the parties had earlier agreed that no live testimony would be necessary. (Markman Hearing Tr. 54:20-55:8).

FN2. Dri Mark originally asserted infringement with respect also to claim 20 but withdrew this claim at the Markman Hearing. (Markman Hearing Tr. 74:23-75:2).

FN3. The defendants additionally seek to construe several other terms and phrases contained in the aforementioned claims, including, "a densely packed polyester fiber reservoir," "an ink system in the reservoir," "the ink system including a color pigmented dispersion," "a metallic dispersion pigment of a particle size that is not greater than about 12 microns," "an aluminum pigmented dispersion," "aqueous," and "a binder to bind the aluminum pigments together."

II. DISCUSSION

A. Claim Construction

The construction of a patent claim is a matter of law, *see Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970-71 (Fed.Cir.1995), *aff'd*, 517 U.S. 370 (1996). Claim construction is a two-step process, first, the claims are construed by the court without reference to the accused product, second, the claims, as construed, are applied to the accused products. *See IMS Technology, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1429 (Fed.Cir.2000).

In construing the claims, the Court may examine both intrinsic evidence (*e.g.*, the patent, its claims, the specification and file history) and extrinsic evidence (*e.g.*, expert reports and testimony, and anything else). However, "it is well-settled that ... the court should look first to the intrinsic evidence ..." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed.Cir.1996). Extrinsic evidence is considered only where the intrinsic evidence does not provide a sufficient description of the scope of the claim. *See Id.*

With respect to the '284 patent, claims 1, 2, 18 and 19 all include reference, either directly or indirectly, to an anti-settling agent. Claim 1 describes "[a] writing invention, comprising ... an anti-settling agent to keep the particles of the metallic dispersion in suspension." '284 Pat. col. 7:1-12. Claim 2, a dependent claim,

incorporates claim 1 by reference and therefore includes all the terms and limitations of claim 1. *See Wolverine World Wide, Inc., v. Nike, Inc.*, 38 F.3d 1192, 1199 (Fed.Cir.1994). Claim 18 describes "[a] writing instrument, comprising ... an anti-settling agent to keep aluminum particles from settling out ..." '284 Pat. col. 8:47-55. Claim 19 is dependant on claim 18.

The defendants argue that the term anti-settling agent is ambiguous and therefore requires certain limitations. Specifically, the defendants propose a construction that narrows the scope of the patent so as to protect only those anti-settling agents that are "both electronically charged [*ie.*, ionic] and derived from a polycarboxylic acid." (National Ink Mem. p. 13).

Dri Mark challenges the proposed limitations and asserts that its patent includes an ink composition with any anti-settling agent and not limited to only those that contain polycarboxylic and ionic elements. Dri Mark contends that "anti-settling agent" is a term well understood by those of ordinary skill in the art and therefore requires no explanation or limitation. *See, e.g.*, *Vitronics*, 90 F.3d at 1582 (noting that a term used in a patent document is interpreted as having the meaning given by persons experienced in the field of the invention). In support of this assertion, Dri Mark points to extrinsic evidence, in particular the deposition testimony of defendant National Ink's senior chemist, Luis Chavez and National Ink's vice president, Bruce Gindelberger, who indicated that they are familiar with the term "anti-settling agent" and do not know the term to be limited to polycarboxylic acid or ionic chemicals. (Chavez Dep. at 77-78; Gindelberger Dep. at 9-11; 81-82).

I am not persuaded by the plaintiff's argument. While the Federal Circuit in *Vitronics*, one of the few cases cited by the plaintiff in support of its claim construction, stated that "words in a claim are generally given their ordinary and customary meaning," the court additionally qualified that language by writing "it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning." *Vitronics*, 90 F.3d at 1582 ("The specification acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication."). It belies common sense to presume that the scope of patent '284 was intended to reach all types of anti-settling agents, a range that would include those, as the plaintiff suggested at the Markman Hearing, that can separate oil and water to others that act on metallic particles in the marker at issue here. (Markman Hearing Tr. 8:10-15). As discussed below, the specification and prosecution history add credence to this view.

It is certainly not an uncommon principle to narrow the construction of a claim or term in light of the written description in the patent's specification. *See e.g.*, *Scimed Life Systems, Inc. v. Advanced Cardiovascular Systems, Inc.*, 242 F.3d 1337, 1340-1341 (Fed.Cir.2001) (citing cases that hold that the scope of the claim is limited to the preferred embodiment expressed in the written description). In particular, I find the facts of *Cultor Corp. v. A .E. Staley Manufacturing Co.*, 224 F.3d 1328 (Fed.Cir.2002) to be strikingly similar to the instant case. The patents at issue in *Cultor* concerned the process of improving the taste of polydextrose, a low-calorie sugar and flour substitute. While the patent claims generally described this process as accomplished via a "water-soluble polydextrose," the specification further explained that the "water-soluble polydextrose" as used in the invention was produced with "citric acid." As a consequence of this language in the specification, the court denied infringement since the defendant's product was produced with an acid that was phosphoric, rather than citric. The district court reasoned that the inventors of the patent "had repeatedly distinguished their invention" as one achieved through the use of citric acid. *Cultor*, 224 F.3d at 1330.

As in *Cultor*, the '284 patent, while referring generally in the claims to the use of an "anti-settling agent,"

distinguishes in the specification the nature of the anti-settling agent utilized in the invention and does so in the following language:

The anti-settling agent additive is of particular importance because of the aluminum flakes readiness to settle out. The *ionically charged sites* on the additive bond themselves to the aluminum flakes suspending them in solutions for extended periods and keeping them tightly adhered to the surfaces of the colored pigments.

'284 Pat. col. 4:28-34 (emphasis added).

Further, the specification continues to differentiate the anti-settling agent utilized in Dri Mark's marker, citing three examples of possible additives: "The anti-settling agent utilized in this invention is *ionic in nature* and derived from a *polycarboxylic acid*. Examples are phthalic acid, adipic acid and tri-metallic acid." '284 Pat. col. 4:39-45 (emphasis added).

The parties agree that all three examples of anti-settling agents referenced above contain ionic and polycarboxylic properties. It therefore becomes apparent that the inventors of the '284 patent explicitly limited the subject matter of their claim to an anti-settling agent with ionic and polycarboxylic qualities. *See* Cultor, 224 F.3d at 1331 (finding that the explicit limitation in the specification "effected a disclaimer," and "claims are not correctly construed to cover what was expressly disclaimed").

The prosecution history that underlies the '284 patent serves only to reinforce the idea that the inventors sought to emphasize the particular nature of the invention's anti-settling agent. I refer to the statements made to the United States Patent and Trademark Office ("PTO") by Chhman Sukhna, one of the co-inventors of the Dri Mark marker, upon the application for the patent.

Patent '284 was initially rejected by the PTO Examiner with respect to claims 1-21 on the basis, in part, that it was too similar to prior art. In an effort to distinguish the '284 patent from prior art—an effort that ultimately proved successful—Sukhna made the following statement to the PTO on October 12, 1999:

I believe that I am the first to have brought to the market or to have described a writing implement in which metallic particle based ink compositions are carefully worked with various constituents to achieve a true 'suspension' *in a sense that is described in my instant patent specification and as set forth in the claims*. One of those constituents is *an anti-settling agent that I have derived and prepared after much experimentation and effort* in order to achieve true effectivity and long term shelf life for the writing implement.

(Dec. David LaSpaluto, Ex. D at p. 2.) (Emphasis added).

In light of Sukhna's statement, I am mindful that "by distinguishing the claimed invention over the prior art, an applicant is indicating what the claims do not cover." *Spectrum Int'l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1379 (Fed.Cir.1998) (citation and internal quotations omitted). Further, "[c]laims may not be construed [by the patentee] one way in order to obtain their allowance and in a different way against accused infringers." *Id.*

i. Application of 35 U.S.C. s. 112, para. 6

The defendants additionally argue that the anti-settling agent is a means-plus-function term that should be

interpreted by the language of the specification in accordance with 35 U.S.C. s. 112, para. 6. Although this argument was first raised in the defendants' reply brief, it was amply explored at the Markman Hearing.

35 U.S.C. s. 112, para. 6 provides:

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.

While the claims in the '284 patent do not employ the classic means-plus function language, the absence of such language is not dispositive. *Isogon Corp. v. Amdahl Corp.*, 47 F.Supp.2d 436, 449 (S.D.N.Y.1998) (Scheindlin, J.) (citing *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 530 (Fed.Cir.1996) (noting that merely because an element does not include the word "means" does not automatically prevent that element from being construed as a means-plus-function element).

However, the failure to use the word "means" in a claim element creates a rebuttable presumption that s. 112, para. 6 does not apply. *See Watts, v. XL Systems Inc.*, 232 F.3d 877, 880 (Fed.Cir.2001). The presumption may be rebutted by showing that the claim element recited a function without reciting sufficient structure for performing that function. *See Id.* As I suggested above, and from a review of the specification and prosecution history, the use of the term anti-settling agent is more akin to a description of function rather than a conveyance of structure.

In this regard, the Federal Circuit's decision in *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1213 (Fed.Cir.1998) is instructive. In *Mas-Hamilton*, a patent infringement case with respect to a type of combination lock, the court determined that the term "lever moving element" did not have a "generally understood structural meaning in the art." *Id.* The inquiry as to whether a term is structural rather than a means-plus-function element "is not whether a term has a commonly understood definition ... but rather whether the commonly understood definition, if one exists, connotes sufficient structure." *Apex Inc. v. Raritan Computer, Inc.*, 2002 WL 287754, at (S.D.N.Y. Feb. 25, 2002) (Pollack, S.J.).

Just as the court in *Mas-Hamilton* reasoned that the plaintiff's claim "cannot be construed so broadly to cover every conceivable way or means to perform the function of moving a lever," *Mas-Hamilton*, 156 F.3d at 1214, Dri Mark's claim similarly cannot be construed to cover every type of anti-settling agent.

I find therefore that s. 112, para. 6 applies to limit the "anti-settling agent" to structures disclosed in the specification and equivalents that perform the identical function. However, even if s. 112, para. 6 were not to apply, I find, as discussed above, that there is nevertheless sufficient justification to narrow the scope of the term in light of the specification and prosecution history. I therefore construe the term "anti-settling agent" as "an anti-settling agent that is both ionic and derived from a polycarboxylic acid."

B. Summary Judgment

In light of the court's claim construction with respect to the anti-settling agent, the plaintiff concedes that its lawsuit for patent infringement does not survive. (Markman Hearing Tr. 57:7-58:19). Additionally, the plaintiff's papers in opposition to the summary judgment motion never addresses the possibility that the court would adopt the defendants' proposed claim construction. While the parties contest the precise

composition of the defendants' ink product, they agree that any anti-settling ingredients that may be present in the defendants' ink do not include ionic and polycarboxylic elements. (Markman Hearing Tr. 58:13-19). The plaintiff therefore cannot make out a claim for literal infringement. *See Lemelson v. United States*, 752 F.2d 1538, 1551 (Fed.Cir.1985) (stating that to establish literal infringement, the plaintiff must show that every limitation of the asserted claim is present in the accused device). Additionally, the plaintiff has failed to raise a genuine issue of material fact-nine months after filing its complaint and now less than two months from trial-as to how the defendants' product infringes under the doctrine of equivalents. *See Warner-Jenkinson v. Hilton Davis*, 520 U.S. 17,21 (1997) (noting that a finding of infringement under the doctrine of equivalents requires a fact-finder to determine whether the structural differences between the particular elements of the accused device and the asserted claim's limitations are insubstantial). Nor can the plaintiff prevail pursuant to the similar, yet distinct, s. 112, para. 6 equivalence test. *See Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303, 1308 (Fed.Cir.1998) (noting that the equivalence analysis under s. 112, para. 6 is whether the difference between two structures is insubstantial). Simply put, the record is devoid of any testimony or other evidence that the ingredients of the defendants' ink are substantially similar or equivalent to that of Dri Mark's. It is therefore not surprising that the plaintiff agreed at oral argument that if the court were to adopt the defendants' proposed claim construction as to the anti-settling agent, any infringement claim under the doctrine of equivalents must fail for "lack of proof." (Markman Hearing Tr. 58:16-19). Finally, the plaintiff's claim for indirect infringement must similarly fail without a showing of direct infringement. *See Joy Technologies v. Flakt*, 6 F.3d 770, 774 (Fed.Cir.1993).

III. CONCLUSION

For the foregoing reasons, the court construes the term "anti-settling agent" as "an anti-settling agent that is both ionic and derived from a polycarboxylic acid." As the plaintiff has failed to show that the defendants' anti-settling agent consists of both an ionic or polycarboxylic element, or raise a genuine issue of material fact as to the equivalence of the defendants' product with its own, the defendants' motion for summary judgment is GRANTED. The clerk of the court is directed to close any pending motions, close this case and remove it from my docket.

SO ORDERED

S.D.N.Y.,2002.

DRI Mark Products, Inc. v. National Ink Inc.

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