

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

**A & E PRODUCTS GROUP, L.P,**  
Plaintiff.

v.

**MAINETTI USA INC., et al,**  
Defendants.

No. 01 Civ. 10820(RPP)

**Dec. 18, 2002.**

Patent infringement suit was brought. Following a *Markman* hearing, the District Court, Patterson, Jr., J., held that: (1) patents for "Hanger With Irremovable Information Tab" required a hanger including a tab which is substantially irremovable with a finger purchase; (2) the word "irremovable" did not have an equivalent meaning to "removal-resistant," which appeared only in claim preambles; and (3) the Court would interpret the term "removable-resistant" in accordance with its ordinary meaning and not as a limitation.

So ordered.

Within patent for a "Garment Hanger With Locking Information Tab," the term "essentially triangular cross-section" means "having a triangular or arrowhead shape in which a corner of the triangle or arrowhead has been cut off; the word "resilient" means that "the information tab is made of material which recoils back to its original shape; and the word "lock" means that "the internal resilient finger engages the underside of the ledge or base of the first triangle or arrowhead to lock on the tab on the holder and prevents manual removal."

Amster, Rothstein & Ebenstein, New York, NY, Attn: Kenneth P. George, Ira E. Silfin, for Plaintiff.

Carella, Byrne, Bain, Gilfillan, Cecchi, Stewart & Olsen, Roseland, NJ, Attn: Francis C. Hand, Dennis Gleason, Morrison, Cohen, Singer & Weinstein, LLP, New York, NY, Attn: Arthur J. Ciampi, for Defendants.

## **OPINION AND ORDER**

**PATTERSON, J.**

After receipt of briefs from the parties, the Court conducted a *Markman* hearing in this case on July 23, 2002. The parties also submitted post-motion briefs on claims interpretations.

## I. History

### *Background*

In today's retail clothing industry, garment manufacturers supply large retailers with garments, pre-hung on hangers and ready for display to consumers. The retailer specifies the type of hanger that the garment manufacturer must use, including the hanger's style, size and color. Often, the retailers specify that the hangers must include a separate tab which displays size information. This tab is placed on a special receptacle (tab holder) on the neck of the hanger for size identification.

Plaintiff, A & E Products Group, L.P. ("A & E"), is the owner of U.S. Patent Nos. 5,383,583 ("the '583 Patent"); 5,485,943 ("the '3 Patent"); 5,613,629 ("the '629 Patent"); 5,819,995 ("the '995 Patent"); and 6,145,713 ("the '713 Patent") (collectively, the "Zuckerman Patents"); and U.S. Patent No. 5,096,101 ("the '101 Patent"). (Plaintiff's Opening Brief ("Pl.Op.Br.") at 2.) These patents cover improvements for the attachment of sizing tabs on garment hangers on which retailers display clothing. The improvements make the sizing tabs safer for consumers by preventing children from removing and swallowing the tabs and customers from slipping on dislodged tabs.

Andrew Zuckerman filed an application for a patent entitled, "Hanger With Irremovable Information Tab," on October 9, 1990. None of the claims in this application were allowed. On November 22, 1991, Mr. Zuckerman filed a continuation application entitled, "Garment Hanger With Irremovable Information Tabs," pursuant to 35 U.S.C. s. 120, which resulted in the issuance on April 6, 1993 of U.S. Patent No. 5,199,608 ("the '608 Patent"). A & E has not asserted the '608 Patent in this action. FN1 On April 5, 1993, Mr. Zuckerman filed a divisional application to the '608 Patent pursuant to 35 U.S. .C. s. 121. A terminal disclaimer to avoid double patenting was filed under 37 C.F.R. 1.321(b) and on January 24, 1995 the '583 Patent issued. (Declaration of Francis C. Hand, dated August 19, 2002 ("Hand Decl. II"), Exs. 1-2.) On January 24, 1995, Mr. Zuckerman filed a divisional of the '583 Patent application and, after terminal disclaimer was filed, the '3 Patent issued on January 26, 1996. ( *Id.*, Exs. 3-4). Another divisional application was filed on January 22, 1996, and after a terminal disclaimer was filed ( *id.*, Exs. 5-6), the '629 Patent issued on March 25, 1997. A continuation application was filed on February 26, 1997; a terminal disclaimer was filed ( *id.* Exs. 7-8.) resulting in the issuance of the '995 Patent on October 13, 1998. That same day, still another continuation application was filed, and a terminal disclaimer filed, resulting in the issuance of the '713 Patent on November 14, 2000. ( *Id.*, Exs. 9-10).

FN1. Mainetti USA Inc., Mainetti, S.P.A. and Mainetti (HK) LTD. (collectively "Mainetti" or "defendant") has sought a declaratory judgment of non-infringement and/or invalidity of the '608 Patent. By letters dated April 10, 2002 and April 25, 2002, counsel for A & E (i) advised Mainetti's counsel that A & E has not claimed that Mainetti infringed the '608 Patent and (ii) represented that A & E unconditionally agreed to not bring action or proceeding against Mainetti as to any claim of the '608 Patent based upon the products currently manufactured and sold by Mainetti. In view of this representation, there is no case or controversy between A & E and Mainetti with respect to the '608 Patent. *See Super Sack Mfg. Corp. v. Chase Packaging Corp.*, 57 F.3d 1054 (Fed.Cir.1995).

In accordance with the provisions of title 35 U.S.C. s. 120 of the United States Code and the rules of the United States Patent and Trademark Office, no changes were made in the specification on any of the Zuckerman Patents. Accordingly, the only difference between the Zuckerman Patents is the language used in the claims. In view of the terminal disclaimer filed, all of the Zuckerman Patents will expire on November

22, 2011 at the end of the '608 Patent period.

Plaintiff also charges infringement of the '101 Patent which was issued on March 17, 1992 entitled, "Garment Hanger With Locking Information Tab." This patent has been assigned by the inventors to the plaintiff.

### ***Introduction***

The parties have cited numerous cases as to the correct approach on claims construction. Defendant Mainetti argues that all of the Zuckerman Patents relate to inventions for a garment holder to which an information tab is attached so that the tab cannot be removed manually or without a tool. Defendant bases its argument on the titles of the patents, e.g., "Garment Hanger With Irremovable Tabs," and the preamble to the claims which uniformly describes the tab as "removal-resistant," a term defendant states gives, "life, meaning and vitality to the claims." *Perkin Elmer Corp. v. Computervision*, 732 F.2d 888, 896 (Fed.Cir.1984). The term "removal-resistant" is not defined in the specification of any of the Zuckerman Patents. The defendant interprets "removal-resistant" as "irremovable" a term defined in the specification but which is not used in any claim in the Zuckerman Patents. (Def. Reply brief at 2-3). "Irremovable" is defined in the specification of each Zuckerman Patent as a tab "which cannot easily be removed by an adult, and cannot be removed by a child of an age likely to ingest a tab, without the use of a tool."

Plaintiff A & E argues that defendant Mainetti is attempting to limit the claims by resorting to the specification and preamble claim language of the patents, (Pl. Op. Br. at 6), when the use of "irremovable" in the specification is in fact referring to a preferred embodiment of the claim (*id.*), and that the claims should be read more broadly. A & E asserts that the terms in the claims all either take their ordinary meaning or a meaning clearly set forth in the specification. In particular, the plaintiff argues that the terms in the claims become readily understood when reference is made to the figures in the specification (*id.* at 9-10), and that "[b]ecause of this, the prosecution histories are not necessary to determine the meaning of any of the claim terms." (*Id.* at 10).

The Court's construction of those claims which plaintiff claims defendant's products infringe is based upon (1) a review and analysis of each of the patents, and the patents from which they issued; (2) the file history of each patent; (3) the briefs submitted to the Court by counsel for the plaintiff and counsel for the defendant, as well as the arguments presented at the *Markman* hearing held on July 23, 2002; and (4) a review of the transcript and exhibits referred to therein, as well as a review of the relevant cases issued by the U.S. Court of Appeals, Federal Circuit ("Federal Circuit").

## **II. Principles of Claim Construction**

The Federal Circuit has issued a large number of opinions since the U.S. Supreme Court decision in *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), *aff'd*, 52 F.3d 967 (Fed.Cir.1995) (*en banc*), which instruct lower courts on the correct approach to claim construction. The general rules of claim construction are as follows:

### **1. Determine the Meaning of Claim Terms According to the Viewpoint of One of Ordinary Skill in the Art**

As a general rule, the construing court interprets words in a claim as one of ordinary skill in the art at the time of the invention would understand them. *Eastman Kodak Co. v. Goodyear Tire & Rubber Co.*, 114

F.3d 1547, 1555 (Fed.Cir.1997) *overruled on other grounds* by *Cybor Corp., v. FAS Tech. Inc.*, 138 F.3d 1448, 1454-1455 (Fed.Cir.1999) ( *en banc* ). A technical term used in a patent document is interpreted as having the ordinary and accustomed meaning that it would be given by persons experienced in the field of the invention at the time the application was filed, unless it is apparent from the patent and the prosecution history that the inventor used the term with a different meaning. *National Recovery Technologies, Inc. v. Magnetic Separation*, 166 F.3d 1190, 1195 (Fed.Cir.1999); *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1572 (Fed.Cir.1996).

## **2. Rely Primarily on the Intrinsic Record**

### **3. The Claims Preambles**

In its claims construction, a court should treat a preamble in a claim as a limitation "only after review of the entire patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim." *Catalina Marketing Int'l, Inc. v. CoolSavings.Com, Inc.*, 289 F.3d 801 (Fed.Cir.2002); *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251 (Fed.Cir.1989).

The general rule is that "a preamble limits the invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim." *Rowe*, 112 F.3d 473, 478 (Fed.Cir.1997). Conversely, a preamble is not limiting where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention. *Id.*

When the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615 (Fed.Cir.1995).

Further, when reciting additional structure or steps underscored as important by the specification, the preamble may operate as a claim limitation. *Corning Glass*, 868 F.2d at 1256 (limiting claim scope to "optical waveguides" rather than all optical fibers in light of specification); *General Electric Co. v. Nintendo Co.*, 179 F.3d 1350, 1361-62 (Fed.Cir.1999) (limiting claim scope to a "raster scanned display device" rather than all display systems in view of specification's focus on the prior art problem of displaying binary data on a raster scan display device); *Rowe*, 112 F.3d at 479-80; *Applied Materials*, 98 F.3d at 1573.

Moreover, clear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention. *See generally* *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1375 (Fed.Cir.2001) (a preamble may limit when employed to distinguish a new use of a prior art apparatus or process). Without such reliance, however, a preamble generally is not limited when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention. *IMS Tech, Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434 (Fed.Cir.2000) (preamble phrase "control apparatus" does not limit claim scope where it merely gives a name to the structurally complete invention). Thus, preamble language merely extolling benefits of features of the claimed invention does not limit the claim scope without clear reliance on those benefits of features as patentably significant. *STX, LLC v. Brine, Inc.*, 211 F.3d 588, 591 (Fed.Cir.2000) (preamble stating that invention provides "improved playing and handling characteristics" is not a limitation); *Bristol-Myers*, 246 F.3d at 1375 (steps of claimed method are performed the same way regardless of whether, as stated in the preamble, a reduction of hematologic toxicity occurs).

Moreover, preambles describing the use of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure. In *re Gardiner*, 36 C.C.P.A. 748, 171 F.2d 313, 315-16 (CCPA 1948) (statements of intended use or asserted benefits in the preamble may, in rare instances, limit apparatus claims, but only if the applicant clearly and unmistakably relied on those uses or benefits to distinguish prior art.)

#### **4. Interpretation of Claims in Light of the Specification**

To resolve disputes in the meaning of claim terms, the court should look first to the intrinsic evidence, namely, the patent claims, the specification and, if in evidence, the prosecution history. *Vitronics*, 90 F.3d at 1582 (citations omitted); *Accord Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed.Cir.1995) (*en banc*), *aff'd*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996). "These documents have legal as well as technological content, for they show not only the framework of the invention as viewed by the inventor, but also the issues of patentability as viewed by the patent examiner." *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed.Cir.1998). If the meaning of the claims is sufficiently clear from the intrinsic record, resort to extrinsic evidence, such as treatises, technical references, and expert testimony should not be necessary. *Digital Biometrics, Inc. v. Identix, Inc.*, 149 F.3d 1335, 1344 (Fed.Cir.1998).

Claims are understood in light of the specification of which they are a part. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 540 (Fed.Cir.1999). The specification is always relevant to the claim construction analysis. *Vitronics*, 90 F.3d at 1582. "Usually, it is dispositive; it is the single best guide to the meaning of a disputed claim term" *Id.* It is proper to use the specification in order to determine what the inventor meant by the terms and phrases contained in the claims. *Laitram v. Morehouse Industries, Inc.*, 143 F.3d 1456, 1462 (Fed.Cir.1998).

Although claims must be read in view of the specification, of which they are a part, particular embodiments appearing in the specification will not *generally* be read into the claims. *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 987 (Fed.Cir.1988). These two canons of construction lay out the general relationship between the claims and the specification and provide the "guideposts" for the use of the specification to define the claims. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1248 (Fed.Cir.1998). In order to overcome the presumption in favor of the ordinary meaning of claim language, a party wishing to use statements in the written description to confine a patent's scope must point to a term or terms that draw in those statements. *Id.* There are two situations where a sufficient reason exists to require the entry of a definition of a claim term or terms other than its ordinary and accustomed meaning: (1) where a patent applicant elects to be a lexicographer by providing an explicit definition in the specification for a claim term; and (2) where the term or terms so deprive the claim of clarity that the scope of the claims cannot be ascertained from the language used. *Johnson Worldwide Associates, Inc. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed.Cir.1999). Reliance on the specification is justified when a claim term lacks clarity. *Eastman Kodak*, 114 F.3d at 1555 (looking past claim language because of lack of clarity); *North American Vaccine, Inc. v. American Cyanamid Co.*, 7 F.3d 1571, 1576 (Fed.Cir.1993), *cert. denied* 511 U.S. 1069, 114 S.Ct. 1645, 128 L.Ed.2d 365 (1994) (using the specification for guidance "when the meaning of the claim term is in doubt"). Absent an explicit definition or a lack of clarity in the meaning of a claim term, the terms in the claims mean what they say and the court must give full effect to the ordinary and accustomed meaning of the claim terms. *Johnson Worldwide Associates*, 175 F.3d at 989; *York Prods.*, 99 F.3d at 1572.

The intrinsic evidence and, in some cases, the extrinsic evidence, can shed light on the meaning of the terms

recited in a claim, either by confirming the ordinary meaning of the claim terms or by providing special meaning for claim terms. *Vitronics*, 90 F.3d at 1583. "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." *Renishaw*, 158 F.3d at 1250. "The best source for understanding a technical term is the specification from which it arose, informed, as needed by the prosecution history." *Multiform Desiccants*, 133 F.3d at 1478. When the specification explains and defines a term used in the claims, without ambiguity or incompleteness, there is no need to search further for the meaning of the term. *Id.*

## **5. Consult and Rely On the Prosecution History Where Applicable**

In interpreting claims, the court may also consider the prosecution history of the patent, if in evidence, as it is in this case. *Markman*, 52 F.3d at 980; *Vitronics*, 90 F.3d at 1582. 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.* These representations are part of the prosecution history on which the examiner, the courts and the public are entitled to rely. *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1303 (Fed.Cir.1997).

Arguments and amendments made during the prosecution of a patent application and other aspects of the prosecution history, as well as the specification and other claims, must be examined to determine the meaning of terms in the claims. *Southwall Technologies, Inc.*, 54 F.3d at 1576. Notice is an important function of the patent prosecution process and absent qualifying language, the remarks and arguments made to obtain allowance are relevant to interpreting all claims in the same patent. *Digital Biometrics*, 149 F.3d at 1347. Statements made during the prosecution of a patent to distinguish the claimed invention indicate what the claims do not cover and can be the basis for a court to interpret the scope of the claims of a granted patent. *Eckhian*, 104 F.3d at 1304.

## **6. Use "Extrinsic" Evidence Only Where Appropriate**

Extrinsic evidence is considered only if there is still some genuine ambiguity in the claims after consideration of all the available intrinsic evidence. *Phillips Petroleum Co. v. Huntsman Polymers Corp.*, 157 F.3d 866, 876 (Fed.Cir.1998). Thus, there are limitations on the evidence that the court may actually rely upon in construing the claims. *See, e.g., Bell & Howell Doc. Mgmt. Prods. Co. v. Altek Sys.*, 132 F.3d 701, 707 (Fed.Cir.1997). In particular, the Federal Circuit has set forth certain guidelines on the use of "extrinsic" evidence (e.g., expert testimony, inventor testimony, learned treatises, dictionaries and prior art), in interpreting the meaning of claim terminology:

(a) Extrinsic evidence may be used to inform the court about the language in which the patent is written, which is directed to those of ordinary skill in the art. *Markman*, 52 F.3d at 979, 986. Where the public record unambiguously describes the scope of the patented invention, however, reliance on extrinsic evidence to deviate from that claim scope is improper. *Vitronics*, 90 F.3d at 1583.

(b) The testimony of one skilled in the art regarding the meaning of claim terms at the time of the invention "will almost always qualify as relevant evidence." *Eastman Kodak Co.*, 114 F.3d at 1555. Such testimony, however, "may be used only to help the court come to the proper understanding of the claims; it may not be used to vary or contradict the claim language." *Vitronics*, 90 F.3d at 1584 (emphasis added). *Accord Markman*, 52 F.3d at 981.

(c) Although technical treatises and dictionaries are also "extrinsic" evidence, the Federal Circuit has

acknowledged that they are "worthy of special note." *Vitronics*, 90 F.3d at 1584 n. 6. Technical treatises may be consulted "at any time in order to better understand the underlying technology." *Id.* Similarly, dictionary definitions may be relied upon when construing claim terms "so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." *Id.*; *see also* *Quantum Corp. v. Rodime PLC*, 65 F.3d 1577, 1581 (Fed.Cir.1995), *cert. denied*, 517 U.S. 1167, 116 S.Ct. 1567, 134 L.Ed.2d 666 (1996). In other words, a common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure, should not be given dominant weight; else, it would produce "absurd results." *Renishaw*, 158 F.3d at 1250 (citations omitted). "Thus, where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meaning." *Id.*

(d) In addition, a court in its discretion may admit and rely on prior art proffered by one of the parties, whether or not cited in the specification or the file history. This prior art can often help demonstrate how a disputed term is used by those skilled in the art; however, use of such prior art is improper if the disputed terms can be understood from a careful reading of the public record. *Vitronics*, 90 F.3d at 1584.

Use of "extrinsic evidence" in the process of learning the background of the technology and the context of the patent is not subject to the same limitations when used to gain understanding of the state of the art at the time the invention was made. *See Eastman Kodak Co.*, 114 F.3d at 1555 (acknowledging the discretion of the trial judge to gauge the relevance and need for additional evidence to explicate claim terms).

## **7. Construe Claims to Preserve Their Validity**

Courts must construe claims so as to sustain their validity, if possible, short of actually redrafting the claims. *See Quantum Corp.*, 65 F.3d at 1584; *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 937 n. 5 (Fed.Cir.1983). The principle of construing claims to preserve their validity also applies in the context of interpreting the prosecution history of a patent. *See Eastman Kodak*, 114 F.3d at 1555 (Fed.Cir.1997).

## **8. Construe Claim Terms in Light of the Enabling Disclosure**

In construing a claim, the court should consider if the construction requested is enabled. *National Recovery Technologies*, 166 F.3d at 1196 ("[t]he scope of the claims must be less than or equal to the scope of the enablement.") If the court is presented with an equal choice between a broad interpretation and a narrow one and there is an enabling disclosure indicating that the applicant is at least entitled to a claim having the narrower meaning, the court should adopt the narrower meaning. *Athletic Alternatives, Inc., v. Prince Manufacturing, Inc.*, 73 F.3d 1573, 1581 (Fed.Cir.1996). In that situation, "we consider the notice function of the claim to be best served by adopting the narrower meaning." *Id.* "Because the applicant has the burden to 'particularly point [ ] out and distinctly claim [ ] the subject matter which the applicant regards as his invention,' 35 U.S.C. s. 112, para. 2 (1994), if the claim is susceptible to a broader and a narrower meaning, and the narrower one is clearly supported by the intrinsic evidence while the broader one raises questions of enablement under Section 112, para. 1, we will adopt the narrower of the two." *Digital Biometrics*, 149 F.3d at 1344.

## **9. The Doctrine of Claim Differentiation Is a Guideline Rather than a Rigid Rule**

Claims in the same patent should be interpreted with reference to one another, *see Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1579 (Fed.Cir.), *cert. denied*, 516 U.S. 987, 116 S.Ct. 515, 133 L.Ed.2d 424 (1995), and each claim must be considered as a whole. *General Foods Corp. v.*

Studiengesellschaft Kohle mbH, 972 F.2d 1272, 1274 (Fed.Cir.1992). Under the "doctrine of claim differentiation," if "some claims are broad and others narrow, the narrow claim limitations cannot be read into the broad whether to avoid invalidity or to escape infringement." *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1054-55 (Fed.Cir.1988), *cert. denied*, 488 U.S. 825, 109 S.Ct. 75, 102 L.Ed.2d 51 (1988). To find otherwise would result in a claim interpretation that is presumptively unreasonable, as it would result in two claims having the same meaning. *Beachcombers v. Wildewood Creative Prods., Inc.*, 31 F.3d 1154, 1162 (Fed.Cir.1994).

The doctrine of claim differentiation, however, is a guide; not a rigid rule; *ATD v. Lydall*, 159 F.3d 534, 541 (Fed.Cir.1999) (citations omitted); and only creates a presumption that there is a difference in meaning and scope of a claim when different words or phrases are used. *Comark Communications v. Harris*, 156 F.3d 1182, 1187 (Fed.Cir.1998). The doctrine "cannot broaden claims beyond their scope, determined in light of the specification and the prosecution history and the relevant extrinsic evidence." *Multiform Desiccants*, 133 F.3d at 1480. Claims that are written in different words may ultimately cover substantially the same subject matter. *Id.* If a claim will bear only one interpretation, similarity with another claim will have to be tolerated. *Laitram v. Morehouse Industries*, 143 F.3d 1456, 1463 (Fed.Cir.1998).

### **10. Avoid Reference to the Accused Products Except for Contextual Purposes**

In claim construction, the words of the claims are construed without regard to the accused product. *Jurgens v. McKasy*, 927 F.2d 1552, 1560 (Fed.Cir.1991). But that is not to say that the accused product is ignored; rather, as the Federal Circuit has explained: "[o]f course, the particular product (or process) is kept in mind, for it is efficient to focus on the construction of only the disputed elements or limitations of the claims." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 1580 (Fed.Cir.1991).

### **III. Construction of the Claims**

The challenging task is to apply the law which most closely relates to the facts of this case. In particular, the first claim construction rule that must be discussed relates to the issue of whether the disputed terms must be given a "broad interpretation" or a "narrow interpretation." According to A & E, the claims language should be given a broad interpretation, whereas Mainetti seeks a narrow approach. The correct approach is set forth in *Netword, LLC v. Central Corp.*, 242 F.3d 1347, 1353 (Fed.Cir.2001).

The role is neither to limit nor to broaden the claims, but to define as a matter of law, the invention that has been patented. The claims are always construed in the light of the specification, of which they are a part. *See Slimfold Mfg. Co. v. Kinkead Indust., Inc.*, 810 F.2d 1113, 1118 (Fed.Cir.1987). The role of the specification includes presenting a description of the technologic subject matter of the invention, while the role of claims is to point out with particularity the subject matter that is patented. *See* 35 U.S.C. s. 12, para. 1, 2. 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. Thus, the claims are construed to state the legal scope of each patented invention, on examination of the language of the claims, the description in the specification and the prosecution history. *See Renishaw PLC*, 158 F.3d at 1250 ("[t]he interpretation to a given term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim.") *Id.* at 1353.

Because the Zuckerman Patents result from divisional and continuation applications, the prosecution history of all the patent applications, including the '608 Patent application, is relevant to the Court's determination of what the inventors actually invented and intended to envelop with the claims. Similarly, review of the



'608 Patent claims gives assistance to a determination of the scope of the claims in the subsequent patents issued to Zuckerman, which are patents plaintiff claims were infringed in this lawsuit (the Zuckerman Patents).

### *The '608 Patent*

The prosecution history of the '608 Patent makes clear that the patentee differentiated the prior art in the Phillips Patent No. 4,115,940 ("Phillips") issued in 1978 and the Petrou Patent No. 4,997,114 ("Petrou") issued in 1991 for a "Garment Hanger With Size Indication" by calling the examiner's attention to the Zuckerman invention as including, "means for rendering said tab resistant to both accidental and intentional manual removal;" and differentiating the Phillips and Petrou Patents as only claiming the tabs to be "secure against accidental removal," while enabling prior tabs which were "easily" (Petrou) or "readily" (Phillips) intentionally removable. (Declaration of Francis C. Hand, dated July 22, 2002 ("Hand Decl. I"), Ex. 2 at 9.)

The '608 Patent is entitled, "Garment Hanger With Irremovable Information Tabs." (Hand Declaration dated August 19, 2002 ("Hand Decl. II") Ex 13). The preamble to the one independent claim in the '608 Patent reads: "[a] garment hanger including a removal-resistant tab, comprising:" The hanger is described in the first limitation of claim 1, as "a hanger including a body and a hook member attached to said body." (Col. 4, lines 3-4). Review of the specification shows that the terms "garment hanger," "body" and "hook member" are broad terms. The garment hanger can be planar or contoured and formed of any suitable material (col. 2, lines 40-42) and refers to hangers for clothing as well as hangers for non-clothing items. (Col. 2, lines 30-32). The hook member may take any shape. (Col. 2, lines 33-34).

The tab holder as defined in the second limitation in claim 1 of the '608 Patent requires "a tab holder formed integrally with said hanger, said tab holder having two opposite sides and a free edge, a first ridge disposed along said free edge and extending from two opposing sides, and a second ridge extending from said two opposing sides and spaced from said first ridge...." (Col. 4, lines 5-10). Thus the hanger and tab holder are formed of one piece; the tab holder must have a front side and a back side; and the first and second ridge must extend from the two opposite sides; and the front ridge must be spaced from the free edge. A free edge, as described in the specification, is an edge which is not connected to the hanger body or hook. (Col. 1, lines 62-63).

The tab is defined in the third limitation of claim 1 of the '608 Patent as having "a face member and two opposing sides, each of said two opposing tab sides extending from said face member and terminating in a foremost edge opposite said face member." (Col. 4, lines 13-17). The specification states that the face member constitutes the place for displaying information (col. 1, lines 61-62) and makes clear that the two opposing sides are synclindrical and are resilient or are spring loaded (col. 1, line 68) caused by plastic memory to grip the tab holder (col. 1, lines 67-68) (see claim 10). Resilient is interpreted to refer to "the quality of recoiling back to an original shape." *Webster's Third New International Dictionary* (1986). Claim 1 requires "opposing tab sides have a rib disposed on the inner surface of each for cooperatively engaging said first ridge (of the tab holder) to lock said tab to said tab holder." (Col. 4, lines 17-20). The term "lock" thus means to "fasten" or to "make fast." *Webster's Third New International Dictionary* (1986). Thus, the ribs on the tab sides cooperatively engage the front ridge of the tab holder to obstruct removal by pulling on the tab while the resiliency or spring load of the tab sides hold the tab sides against the surface of the tab holder. The third limitation of claim 1 also requires "said opposing tab sides extend from said face member sufficiently such that said foremost edges of said opposing tab sides border the near side of said second ridge, without engaging said second ridge, when said ribs cooperatively engage said first ridge." (Col. 4,

lines 20-25).

The fourth limitation of claim 1 of the '608 Patent requires that "said second ridge [of the tab holder] be configured and dimensioned to obstruct access to said foremost edges of said opposing tab sides and, thereby, to essentially prevent both accidental and intentional manual removal of said tab from said tab holder." (Col. 4, lines 26-30). Thus, the second ridge extends the length of the foremost edges of the tab's opposing sides to obstruct access to those edges to prevent the foremost edges of the tab sides from being loosened by being pushed or pried up. The terms "obstruct" and "access" are used in their ordinary meaning.

Claim 13 of the '608 Patent is one of 13 dependent claims to claim 1 of the '608 Patent and requires that the tab holder include "an upper end member formed above said first ridge and a lower end member formed below said first ridge" (col. 4, lines 63-65); that, "said face member and two opposing sides of said tab form an upper edge surface and a lower edge surface" (col. 4, lines 66-68); and that "said upper and lower end members of said tab holder being located relative to the upper and lower edge surfaces of said tab so that when said tab is locked on to said tab holder, said upper and lower end members obstruct access to said respective upper and lower edge surfaces." (Col. 5, lines 1-4; col. 6, lines 1-2). This limitation obstructs access to the edge surfaces to prevent the opposing tab sides from being opened or widened to remove the tab from the tab holder.

The specification of the '608 Patent states, "[t]his invention relates to a hanger having an information tab, more particularly, this invention relates to a garment hanger having a tab holder for receiving an information tab, which once attached to the tab holder cannot be removed by hand." (Col. 1, lines 11-15). It notes the prior art as having tabs connected to the hanger by means of spring clips that are provided with a finger purchase. (Col. 1, lines 30-32). The specification does not use or define the terms "removal-resistant," "lock," "border," "obstruct access" or "means for rendering said tab resistant to both accidental and intentional manual removal from said tab holder."

The specification of the '608 Patent states that (1) the tab holder typically may include end members which prevent a consumer from obtaining a finger purchase on tab sufficient to clear the projecting members (ribs) from the ridge, thereby rendering the tab irremovable once the tab is mounted (col. 3, lines 1-8); FN2 (2) "as used herein" an "irremovable" tab refers to "a tab which cannot be easily removed by an adult, and cannot be removed by a child of an age likely to ingest tab 18, without the use of a tool" (col. 3, lines 8-11); (3) "though the tab has been described as being removable using tools, it is within the scope of this invention to construct a hanger with an information tab which cannot be removed, without breaking the tab, even using a tool" (col. 3, lines 23-27); and (4) "Preferably, the foremost edges of sides 34 and 36 are sufficiently close to ridge 28 to prevent a consumer from inserting a fingernail between the foremost edge of sides 34 and 36 and ridge 28." (Col. 3, lines 56-60). "Thus a garment hanger having an irremovable tab for indicating customer information is provided." (Col. 3, lines 65-67). The claims of the '608 Patent do not use the term "irremovable."

FN2. Only dependent claim 13 of the '608 Patent defines a tab holder with "end members."

The file history of the '608 Patent contains the following statement to the Patent Office in furtherance of obtaining the patent:

Before discussing the cited references with respect to claims 1 and 3, as amended, and new claim 10,

applicant wishes to focus the Examiner's attention on a distinguishing feature of applicant's invention-i.e., the irremovability of the tab by a child or adult once it is mounted, thereby making the applicant's invention childproof. Specifically, once the tab of the subject invention is mounted on to the tab holder, it is secure and cannot be dislodged without the use of a tool.

(Declaration of Francis G. Hand, dated August 27, 2002 ("Hand Decl. III"), Ex. 1 at 3).

[2] The amendment filed January 27, 1992 ( id.), makes clear at pages 3 and 4 that the invention in the '608 Patent requires a hanger including a tab which is substantially irremovable with a finger purchase because access to the foremost edges of the tab is obstructed by a second ridge ( id.) and end members of the tab holders prevent sufficient finger purchase on the upper and lower edge surfaces of the tab ( id.) such that manual removal of the tab is essentially prevented. The "irremovable" tab referred to in the specification ( id., lines 7-22) is claimed in dependent claim 13 of the '608 Patent.

### '583 Patent

Plaintiff charges infringement of claims 14, 16, 20, 21, 22, 23, and 24. Since the '583 Patent, entitled "Hanger With Irremovable Information Tab," is a division of the '608 Patent, its claims should be read in the light of the '608 claims. *AbTox, Inc.*, 131 F.3d at 1010; *Epcon Gas Sys.*, 279 F.3d at 1030. The specification of both patents, as in all the Zuckerman Patents, is the same.

Claim 1 of the '583 Patent first incorporates lines 1-30 of claim 1 of the '608 Patent but in the first, second, third and fourth limitations of the '608 Patent the words "at least" are inserted so that the opposing sides of the tab "at least border" the second ridge of the tab holder. Claim 1 of the '583 Patent next incorporates the text of claim 13 of the '608 Patent, but also requires the upper and lower end members of the tab holder to extend "substantially" the full length of the upper and lower edge surfaces of the tab to preclude a finger purchase on the upper and lower edge surfaces. (Col. 4, lines 30-45).

Since plaintiff has withdrawn, by letter dated August 27, 2002, claims 1, 7, 8, 12 and 13 of the '583 Patent, the Court will not interpret the effect of these modifications of the '608 Patent other than to state that claim 1 of the '583 Patent is removal-resistant (a) by the obstruction of access to the foremost edges of the opposing sides of the tab caused by the second ridge which the foremost edges of the opposing sides of the tab at least border (b) by the ribs on the tab sides which cooperatively engage the front ridge of the tab holder to obstruct removal by pulling on the tab while the resilient tab sides hold the tab sides against the surface of the tab holder and (c) by the end members of the tab holder which obstruct access to the respective upper and lower edge surfaces. The information tab covered by this claim would be difficult to remove without the use of a tool. Thus this claim is a preferred embodiment referred to as "irremovable" in the specification. (Col. 3, lines 7-22).

Claim 14 is the second independent claim of the '583 Patent and is identical to claim 1 of the '583 Patent, except that claim 14(a) does not contain the requirement in the third limitation of claim 1 that the tab be "resistant to both accidental and intentional manual removal from said tab holder;" (b) requires in the second and fourth limitations that the tab holder have a "second ridge means" rather than a "second ridge" (which has no effect on the meaning of the claim); (c) requires in the fifth limitation that the upper end member be "generally above" the first ridge rather than "above" the first ridge; and (d) requires the lower end member to be "generally below" the first ridge rather than "below" the first ridge. The use of the word "generally" allows the article to include a tab holder which has end members which are not entirely above and below

the first ridge.

Claim 16 of the '583 Patent is dependent on claim 14 and adds the limitation, "said second ridge means extends at least partially between said upper and lower end members." Thus, this second ridge may occupy only part of the space between the lower and upper members of the tab holder and the tab is less removal-resistant.

Claim 20 of the '583 Patent is an independent claim and contains the terms used in claim 1 of the '583 Patent, except that the tab holder, although having a first ridge disposed along the free edge and extending from side to side, does not have a second ridge to obstruct access to the foremost edges of the opposing edge tab sides. Claim 20 also requires that "at least one of said opposing tab sides" have "a rib" disposed on its inner surface to engage the first ridge on the tab holder to lock said tab to said tab holder. Thus claim 20 does not have a second ridge on the tab holder and is also different from claim 1 which requires both of the tab's opposing sides to have a rib to engage the first ridge on the tab holder.

The third limitation of claim 20 contains an additional limitation, whereby the end members of the tab holder extend "substantially the full length of the upper and lower edge surfaces of the tab to preclude a finger purchase on the upper and lower edge surfaces" of the tab. All the limitations of claim 20 are subject to a functional limitation, "thereby to render the hanger resistant to both accidental and intentional manual removal of said tab from said tab holder." (Col. 7, lines 5-7).

Claim 21 is dependent on claim 20 and requires the tab holder to be located between the hook member and the body of the hanger.

Claim 22 is also dependent on claim 20 and adds one limitation, namely that the tab holders have a second ridge extending from the two opposing sides to obstruct access to the edges of the foremost edges of the opposing tab sides and together with the end members functionally prevent accidental and intentional manual removal of the tab from tab holder.

Claim 23 of the '583 Patent is an independent claim and contains the terms used in claim 1 of the '583 Patent, but requires the tab holder to have a first ridge "disposed adjacent and along said free edge" rather than "disposed along said free edge" as in claim 1 of the '583 Patent. This change does not affect the meaning of the claim. Claim 23 of the '583 Patent also utilizes a detent means, as in claim 17, on the inner surface of at least one of the opposing tab sides to engage the first ridge of the tab holder and lock the tab to the tab holder. A "detent" is a catch or a mechanical stop. *Webster's Third New International Dictionary* (1986). Claim 23 requires the "second ridge of the tab holder to be configured and dimensioned to obstruct access to the foremost edges" of the tab sides to "essentially prevent both accidental and intentional manual removal of the tab from the tab holder."

Claim 24 is dependent on claim 23 and adds the requirement that the foremost edges of the tab sides be bevelled.

"3 Patent

Plaintiff charges infringement by defendant of claims 1, 3, 4, 8, 10, 11, 12, 13, 16, and 17. The "3 Patent is entitled, "Hanger With Irremovable Information Tab," and is a division of the '583 Patent and contains the same specification as the '583 and '608 Patents.

The claims limitations of the '3 Patent do not require that the first ridge on the tab holder be disposed along the free edge of the tab holder as in the '583 Patent. The '3 Patent requires that the opposing tab sides have a rib to cooperatively engage the first ridge of the tab holder; and requires that the opposing tab sides extend sufficiently from the face member so that their foremost edges are adjacent to the near side of the second ridges on the tab holder when the ribs cooperatively engage the first ridges (col. 4, lines 8-13); and that the configuration and dimensions of the second ridges of the tab holder obstruct access to said foremost edges of said opposing tab sides (col. 4, lines 14-16). The term "adjacent" has its ordinary meaning. Claim 1 does not require that a finger purchase be precluded, nor does claim 1 of the '3 Patent require the tab to include "means for rendering said tab resistant to both accidental and intentional manual removal from said tab holder" as in the '583 Patent. Thus it is broader than claim 1 of the '583 Patent.

Claim 3 of the '3 Patent is dependent on claim 1, adding the same limitation as claim 11 of the '583 Patent.

Claim 4 adds to claim 1 of the '3 Patent the requirement that the foremost edges of the tab sides be bevelled.

Claim 8 of the '3 Patent is independent. This claim requires the first ridge means to be "disposed parallel" to the free edge of the tab holder. "Parallel" takes its ordinary meaning. All the remaining terminology used in claim 8 is used in the other claims described above, and this terminology has the same meaning as the terminology for these other claims.

Claim 10 is dependent on claim 8 and requires that the "second ridge means extend at least partially between said upper and lower end members." This limitation is the same as claim 16 of the '583 Patent.

Claim 11 of the '3 Patent is another independent claim which uses the same terminology as previously described. Unlike claim 9 and many of the other claims, claim 11 requires that the tab holder have only one ridge.

Claim 12 depends on claim 11 and adds the same limitation that claim 3 adds to claim 1, which requires that the tab holder be located between the hook member and the body of the hanger.

Claim 13 is also dependent on claim 11. It adds the familiar requirement that the tab holder include a second ridge. Claim 13 is broader than the other claims in that only one of the inner tab sides is required to have a rib to cooperatively engage the first ridge on the tab holder.

Claim 16 of the '3 Patent is independent. It primarily uses the same claim terms. However, claim 16 introduces the phrase:

each of said opposing tab sides having an inwardly projecting portion for engaging said ridge to secure said tab to said tab holder.

Unlike other claims which use the word "ribs," this claim would cover a tab in which the tab has projecting portions which are not in the shape of ribs.

Claim 17 of the '3 Patent is also independent. It is similar to claim 16. However, claim 17 only requires that the tab holder have one ridge on one side (i.e., either the front or the back) and that only one of the tab sides

have a projecting portion.

## '629 Patent

Plaintiff charges infringement of claims 1, 3, 4, 7, 8, and 9. Claim 1 of the '629 Patent, a division of the '3 Patent, is entitled, "Hanger With Information Tab." As in all the Zuckerman Patents, the preamble to claim 1 states, "[a] garment hanger including a removal-resistant tab, comprising:"

[3] The first limitation in claim 1 is the same as the '608, '583 and '3 Patents. The second limitation in claim 1 requires a tab holder "having two opposite sides, a free edge, a longitudinal ridge extending from the two opposite sides with an upper transverse ridge located above the longitudinal ridge and a lower transverse ridge located below the longitudinal ridge." (Col. 3, lines 66-67, col. 4 lines 1-4). The third limitation is "a tab which *may* be locked *onto* said tab holder" (emphasis added) (col. 4, line 6). The fourth limitation requires that when said tab is locked onto said tab holder, the longitudinal ridge extends substantially the full length of and obstructs access to said foremost edges of the tab. The term "lock" means to "fasten" or to "make fast." *Webster's Third New International Dictionary* (1986). It does not mean to "intertwine with" as argued by plaintiff. The longitudinal ridge obstructs access to the foremost edges but the '629 Patent does not claim a first ridge with which to intertwine with any ribs in the opposing tab sides. Indeed, no ribs on the opposing tabs are claimed in claim 1 of the '629 Patent. Thus the term "locked" has the meaning "to fasten" or "make fast." The fifth limitation requires that the upper and lower transverse ridges are so located as to "extend substantially the full length of and obstruct access to the respective upper and lower edge surfaces of said tab when said tab is locked onto said tab." (Col. 4, lines 13-25.) The term "transverse ridges" is not defined in the specification and assumes its ordinary meaning of "crossing" or "extending across." *Webster's Third New World Dictionary* (1986). The "transverse ridges" would perform the same function as end members in the '583 Patent.

Claim 3 depends on claim 1 and requires that the tab holder be located between the hook member and the body. (Col. 4, lines 29-30). Claim 4 also depends on claim 1 and requires that the front edge be bevelled. (Col. 4 lines 31-32).

[4] Claim 7 of the '629 Patent is also dependent on claim 1 and requires that the foremost edges of the opposing tab sides be "proximate" to the near side of said longitudinal ridge where said tab is locked onto said tab holder. The specification of the '629 Patent does not use the term "proximate to" but states that preferably the foremost edges of the opposing sides of the tab holder are sufficiently close to the ridge to prevent a consumer from inserting a fingernail between the foremost edge of sides 34 and 36 and the longitudinal ridge. The term proximate is interpreted to mean "near" but not as close as "adjacent" or "bordering."

Claim 8 of the '629 Patent is dependent on claim 1 of the '629 Patent but substitutes the term "obstruction" for the term "ridge," and the term "transverse obstructions" for the term, "transverse ridges." (Col. 4, lines 50, 52-54, 62, 65; col. 5, lines 1, 5). The term "obstruction" is interpreted to mean any structure which causes an obstruction even if it were not in the shape of a ridge.

Claim 9 is also dependent on claim 1 and requires that the upper and lower transverse ridges be "substantially non-vertical" and "when said tab is locked onto said tab holder" said upper and lower edge surfaces of said tab be "substantially non-vertical." This requirement means that the transverse ridges and upper and lower edge surfaces be slanted.

## '995 Patent

Plaintiff charges infringement of claims 1 and 2 of the '995 Patent. Patent '995 is entitled, "Hanger With Information Tab," issued October 13, 1998, and is a continuation of the '629 Patent. The preamble and first limitation are identical to the '608, '583, '3 and '629 Patents.

The second limitation of claim 1 requires a "tab holder having two opposite sides, a free edge and a longitudinal ridge extending from said two opposing sides and spaced from said free edge", like the '629 Patent, only a single longitudinal ridge is required on the tab holder.

The third limitation reads:

an upper transverse ridge located above said longitudinal ridge at the point of joinder of said tab holder to said hook member and a lower transverse ridge located below said longitudinal ridge at the point of joinder of said tab holder to said body;

This limitation requires that the upper transverse ridge of the tab holder meet the longitudinal ridge at the point where the tab holder is joined to the hook and the lower transverse ridge meet the longitudinal ridge at the point of the joinder of said tab holder of the body. The fifth, sixth and seventh limitations of claim 1 of the '995 Patent are substantially similar to the last three limitations of the '629 Patent and are interpreted in the same way.

Claim 2 of the '995 Patent is dependent on claim 1 and requires said transverse ridges of said tab holder to be substantially non-vertical, and when said tab is locked onto said tab holder, edge surfaces of said tab sides are substantially non vertical. Thus it is substantially identical to claim 9 of the '629 Patent.

## '713 Patent

Plaintiff charges infringement of claims 1 and 2 of the '713 Patent. Patent '713, issued November 2000, is entitled, "Hanger With Irremovable Information Tab," and is a continuation of Patent '995. It uses the same terms as used in the '608, '583, '3, '629 and '995 Patent claims and has an identical specification as contained in those Patents.

Claim 1 of the '713 Patent contains the same preamble and first limitation. The second limitation is the same as the second limitation in the '629 and '995 Patents except for what appears to be a typographical error. "[A] longitudinal ridge on said tab holder extending from said two exposing [ sic ] sides and the lower transverse ridge is located substantially below said longitudinal ridge."

The third limitation of claim 1 of the '713 Patent is almost identical to limitations of the '629 Patent except that the transverse ridges are located "substantially" above and below the single longitudinal ridge.

The fourth limitation of claim 1 of the '713 Patent is identical to the fourth limitation in the '995 Patent.

The last two limitations of the '713 Patent do not require that the longitudinal ridge extend substantially the full length of the foremost edges of the tab or that the transverse ridges extend substantially the full length of the edge surfaces of the tab. Thus claim 1 of the '713 Patent is broader than claim 1 of the '629 and '995 Patents.

## '101 Patent

Plaintiff charges infringement of claims 1, 12, 13, and 14 of the '101 Patent. The '101 Patent issued on March 17, 1992 is entitled, "Garment Hanger With Locking Information Tab," and differs substantially from the Zuckerman Patents, although it also requires a garment hanger, including a body having a hook member and tab holder, as well as a tab. Claim 1 reads in full:

A garment hanger comprising a body having a hook member joined to said body at one end thereof, a tab holder formed on said body, said tab holder including a first region having an essentially triangular cross-section and a second region having an essentially triangular cross-section, and an information tab having side walls defining an internal channel including locking means in said channel for locking said information tab on said tab holder, said locking means having at least a first internal resilient finger and second regions to essentially prevent manual removal of said information tab from said holder.

The first clause of claim 1 requires the body of the garment hanger to have a hook member joined to the body at one of its ends. The second clause of claim 1 of the '101 Patent requires that the tab holder be formed on said body and include "a first region having an essentially triangular cross-section, and a second region having an essentially triangular cross-section." (Col. 3, lines 66-68). Thus the claim requires that both the first and second regions of the tab holder have essentially triangular cross-sections .FN3

FN3. In Figure 3, the specification shows that the tab holder has a the first cross-section that is cut off at the top and the second cross-section is cut off on the two sides, but both are essentially triangular.

The third clause of claim 1 of the '101 Patent requires "an information tab having side walls defining an internal channel, including locking means in said channel for locking said information tab on said tab holder when said information tab is coupled to said tab holder, said locking means having at least a first internal resilient finger in said channel which engages and locks intermediate said first and second regions to essentially prevent manual removal of said information tab from said tab holder." (Col. 4, lines 1-8).

The specification describes (a) the tab holder as having a first cross-section described as a triangular arrowhead and a second cross-section terminating as a rib of the hanger which is also a triangular arrowhead; and (b) the information tab as U-shaped in cross-section and includes inwardly projecting fingers which, when the tab is affixed, grab intermediate the first arrowhead (the first triangular region of the tab holder) (col. 2, lines 31-34) and the free ends or legs of the tab curve inwardly and grab the tab holder below the second arrowhead (second triangular region). (Col. 2, lines 35-36). More definitively, the specification states that the information tab is preferably of resilient thermo-plastic material; U-shaped in cross-section and includes opposing legs extending from a top wall upon which information is placed; that the ends of the legs are curved inwardly to define a gap (col. 3, lines 15-24); and that the legs with curved ends will spread apart upon contact with the sidewalls of the upper region of the tab holder and again upon contact with the sidewalls of the lower region of the tab holder (col. 3 lines 27-31); and once past those sidewalls of the lower region of the tab holder will abut against the thin walls of the tab holder (col. 3 lines 31-32); projections in the form of fingers 60 and 62, extend from the inside walls of the tab legs and extend toward the top wall 56 (col. 3, lines 22-25) so that when tab is inserted onto the tab holder, the legs will spread apart upon contact with the sloped walls in the tab holder's upper region and lower region and will abut against the thin wall of the tab holder; that at the same time these inwardly protruding fingers will be



forced toward the tab's legs 52 and 54, as they ride over the sloped sidewalls located in the upper region of the tab holder (col. 3, lines 33-35); that once the fingers pass beyond the sidewall of the upper region, the resilient fingers will move inwardly towards their normal position to lock under the edge of the base of the upper region (first arrowhead) of the tab holder while resting on the sidewalls of the lower region of the tab holder (col. 3, lines 36-40); and that due to the inward curved construction of the ends of the resilient legs of the tab which bear against the wall and rib below the second region of the tab holder and, the resilient fingers of the tab locking under base of the upper region, a doubly secure locking system is provided so that the tab is essentially locked on the tab holder and is, therefore, child proof. (Col. 3, lines 41-46).

Claim 12 of the '101 Patent is an independent claim directed mainly to the information tab. Its preamble reads: "[a] garment hanger information tab for use on a garment hanger having a tab holder, said tab holder including a ledge." Clause 2 of claim 12 requires the information tab to have a U-shaped body with first and second legs, defining a slot and internal channel between the legs. Clause 3 of claim 12 requires the U-shaped body to have a "first internal resilient finger extending inwardly" from the first leg in said channel; said first internal finger extending under said ledge of said tab holder to lock the U-shaped body on said tab holder when the U-shaped body is on the tab holder (Col. 5, lines 3-11). Claim 12 also requires the legs on the information tab with the U-shaped body to have free ends and curve inwardly to define a gap between the legs ( id.; see Fig. 5). The preamble of claim 12 requires only one ledge on the tab holder and is a limitation on the claim. Thus claim 12 has a single ledge on the tab holder instead of two triangular regions as in claim 1. The remainder of claim 12 requires only one internal finger to extend under that ledge.

The preamble to claim 13 of the '101 Patent, an independent claim, is for a garment hanger, for use with a U-shaped information tab, having first and second legs curving inwardly. (Col. 5, lines 15-17). In the second clause of claim 13, the body of the garment hanger is defined as having a hook member and a tab holder formed on the body. (Col. 5, lines 17-18). The third clause of claim 13 requires the tab holder to have a first enlarged region which is essentially triangular shaped in cross-section and a second enlarged region which is essentially triangular shaped in cross-section positioned above the first enlarged region. (Col. 5, lines 19-23). Claim 13 also requires that the curved ends of the legs of the information tab be captured under the first enlarged region on the tab holder when coupled to the tab holder. (Col. 5, line 23, col. 6, lines 1-3). Accordingly, the resilient legs of the tab become captured when they spring back upon passing the first enlarged region. Claim 13 does not require an inwardly projecting resilient finger on the tab as in claim 12.

Claim 14 of the '101 Patent is dependent on claim 13 and also requires the first enlarged region of the tab holder to include first and second sloping sidewalls and a base.

#### **IV. Markman Definitions**

##### ***The Meaning of "Removal-Resistant"***

The Plaintiff maintains that the terms used in the Zuckerman Patents should be interpreted according to their plain meaning or in a few instances in accordance with a clear definition provided by the specification of the patents. Defendant argues that for all the Zuckerman Patents, the preamble of each claim constitutes a limitation and seeks to read limitations from the specification into all of the claims at issue in the Zuckerman Patents.

[5] All the independent claims in the Zuckerman Patents state in the preamble "[a] garment hanger including a removal-resistant tab, comprising:" Defendant argues that the term removal-resistant is necessary to give life and meaning to the claims, (Tr. at 48) and seeks to find the meaning of "removal-resistant tab" in the

specification, which is identical in all the Zuckerman Patents and also common to Zuckerman Patent No., 5,199,608 (the '608 Patent), the first patent issued to Zuckerman for a "Garment Hanger With Irremovable Information Tabs." The specification of the '608 Patent states the patent is for "a garment hanger having a tab holder for receiving an information tab which, once attached to the tab holder cannot be removed by hand." (Col. 1, lines 12-15). The same specification language appears in the '583 Patent entitled, "Hanger With Irremovable Information Tab."

Citing the Rules of the Patent Office, 37 C.F.R. 75(d)(1), the defendant argues that the Court should examine the specification to determine what removal-resistant means and then points out that the term "removal-resistant" does not appear in the specification. (Tr. at 41). Defendant then argued from other language in the specification to the '608 Patent and the Zuckerman Patents relating to the irremovability of the tab once attached to the tab holder, *e.g.*, "[i]t is a further object of this invention to provide a hanger with an information tab which is easily mounted by sales personnel or by an apparel manufacturer, but is not readily removable from the hanger once mounted." (Tr. 44) (col. 1, lines 48-51). "The rib is positioned and sized such that it prevents a person from obtaining a sufficient finger purchase on the information tab to remove the tab from the tab holder" (tr. at 44) (col. 2, lines 2-6), "thereby, rendering the tab irremovable once the tab is mounted." (Col. 3, lines 7-8).

The term "irremovable" is then defined. ( *Id.*) "As used herein an irremovable tab refers to a tab which cannot easily be removed by an adult, and cannot be removed by a child of an age likely to ingest 18, without the use of a tool." (Col. 3, lines 8-11). "Thus a garment hanger having an irremovable tab for indicating customer information is provided." (Col. 3, lines 61-62).

The defendant argues that the term "removal-resistant" as used in the '583 Patent means "irremovable" as defined in the specification and that all the Zuckerman Patents should be so interpreted. (Tr. 46). But in the specification an "irremovable tab" is defined as "a tab which cannot be easily removed by an adult, and cannot be removed by a child, without the use of a tool." The word "irremovable" does not have an equivalent meaning to "removal-resistant" and only one or two of the claims in the Zuckerman Patents would meet that test.

[6] [7] The term "removal-resistant" in the preamble of the '583 Patent is not "necessary to breathe life, meaning and vitality" into the claims. Generally, particular embodiments appearing in the specification will not be read into the claims. *Specialty Composites*, 845 F.2d at 987. In the Zuckerman Patents each of the claim bodies describes a structurally complete invention so that a deletion of the preamble phrase "removal-resistant" does not affect the structure or steps of the claimed invention. *IMS Tech, Inc. v. Haas Automation, Inc.*, 206 F.3d at 1434. As in *Rowe*, 112 F.3d at 478, the term "removal-resistant" is used in the preamble to state the purpose of the invention as stated in the claims which follow. Furthermore, defendant's resort to the specification to provide meaning to the term "removal-resistant" is illogical since nowhere in the specification is the term "removal-resistant" defined. As stated in *Application of Gardiner*, 171 F.2d at 315-16, preambles describing the use or purpose of an invention generally do not limit the claims because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure. The term "removal-resistant" is used in the Zuckerman Patents to cover a large number of claims with varying degrees of resistance to removal.

Accordingly, the Court will interpret the term "removable-resistant" in accordance with its ordinary meaning and not as a limitation.

### ***The Meaning of Other Terms in the Zuckerman Patents***

[8] Similarly, with respect to the terms in dispute in the claims in the Zuckerman Patents, FN4 the Court finds:

FN4. The word "resilient" used in the specification means that the information tab is made of material which recoils or springs back to its original shape.

- 1) the word "lock" means to "fasten" or "make fast;"
- 2) the word "border" means "extending along the edge;"
- 3) the word "purchase" means "a hold on" an article;
- 4) the word "detent" means "a mechanical stop or catch;"
- 5) the term "tab holder" means "a structure designed to hold a tab;"
- 6) the term "free edge" means "an edge which is not connected to the hanger body or hook;"
- 7) the term "foremost edge" of a tab side refers to "the edge of a tab side farthest away from the face of the tab;"
- 8) in claim 23 of the '583 Patent, the limitation "detent means disposed on the corner surface thereof for engaging said first ridge to lock said tab to said tab holder" is subject to 35 U.S.C. s. 112 para. 6. The required function is to secure the tab to the tab holder to prevent the tab from being pulled off. The structure is "a mechanical stop or a catch;" and
- 9) all other words in the Zuckerman Patents take their ordinary meaning.

### ***The Meaning of Terms in the '101 Patent***

With respect to the '101 Patent:

- [9] 1) the term "essentially triangular cross-section" means "having a triangular or arrowhead shape in which a corner of the triangle or arrowhead has been cut off;"
- 2) the word "resilient" means that "the information tab is made of material which recoils back to its original shape;"
  - 3) the word "lock" means that "the internal resilient finger engages the underside of the ledge or base of the first triangle or arrowhead to lock on the tab on the holder and prevents manual removal;"
  - 4) the preamble of claim 1 does not constitute a claim limitation;
  - 5) the preamble of claim 12 does constitute a claim limitation;

6) the preamble of claim 13 also constitutes a claim limitation since it requires a U-shaped information tab having first and second legs with free ends that are curved inwardly; and

7) all other words and terms in the '101 Patent take their ordinary meaning.

IT IS SO ORDERED.

S.D.N.Y.,2002.

A & E Products Group, L.P. v. Mainetti USA Inc.

Produced by Sans Paper, LLC.