United States District Court,
E.D. Texas, Marshall Division.

Walter SOLOMON and Wonderduck Decoys,
Plaintiffs.
v.
OVERTON'S INC. d/b/a Herter's, et al,
Defendants.

Civil Action No. 2-02-CV-60 (TJW)

Dec. 9, 2003.

Michael Charles Smith, Carl R. Roth, The Roth Law Firm, P.C., Marshall, TX, D. Scott Hemingway, Malcolm Wade Pipes, Hemingway LLP, Dallas, TX, for Plaintiffs.

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MEMORANDUM OPINION AND ORDER

T. JOHN WARD**, District Judge.**

I. Background

This is a dispute involving decoys used by waterfowl hunters to attract waterfowl to a particular body of water or to a particular location in a body of water. Plaintiffs (collectively referred to as "Wonderduck") filed an action for patent infringement charging defendant Cabela's Inc. ("Cabela's) with infringement of their U.S. Patent No. 6,339,894 ("the '894 patent") issued on January 22, 2002. The parties filed a joint claim construction statement as well as claim construction briefs. Additionally, the Court heard argument concerning the parties' proposed claim constructions at the *Markman* hearing. After considering the submissions and the arguments of counsel, the court issues the following claim construction opinion.

II. Law Governing Claim Construction

"A claim in a patent provides the metes and bounds of the right which the patent confers on the patentee to exclude others from making, using or selling the protected invention." Burke, Inc. v. Bruno Indep. Living Aids, Inc., 183 F.3d 1334, 1340 (Fed.Cir.1999). Claim construction is an issue of law for the court to decide. Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71 (Fed.Cir.1995) (en banc), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

To ascertain the meaning of claims, the court looks to three primary sources: the claims, the specification, and the prosecution history. Markman, 52 F.3d at 979. Under the patent laws, the specification must contain

a written description of the invention that enables one of ordinary skill in the art to make and use the invention. A patent's claims must be read in view of the specification, of which they are a part. Markman, 52 F.3d at 979. For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims. *Id*. "One purpose for examining the specification is to determine if the patentee has limited the scope of the claims." Watts v. XL Sys., Inc., 232 F.3d 877, 882 (Fed.Cir.2000).

Nonetheless, it is the function of the claims, not the specification, to set forth the limits of the patentee's claims. Otherwise, there would ne no need for the claims. SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121 (Fed.Cir.1985) (en banc). The patentee is free to be his own lexicographer, but any special definition given to a word must be clearly set forth in the specification. Intellical, Inc. v. Phonometrics, 952 F.2d 1384, 1388 (Fed.Cir.1992). And, although the specification may indicate that certain embodiments are preferred, particular embodiments appearing in the specification will not be read into the claims when the claim language is broader than the embodiments. Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1054 (Fed.Cir.1994).

To assess the ordinary meaning of claim terms, a court may properly rely on dictionary definitions. The Federal Circuit recently endorsed the use of such sources in Texas Digital Systems, Inc. v. Telegenix, Inc., 308 F.3d 1193, 1202 (Fed.Cir.2002). In that case, the court noted that "[i]t has long been recognized in the precedent of our predecessor court, the Court of Customs and Patent Appeals, that dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meaning of claim terms." *Id*. The court reasoned that such sources are objective resources that serve as reliable sources of information on the established meanings that would have been attributed to the terms of the claims by those of skill in the art. *Id*. at 1202-03. According to the court, dictionaries, encyclopedias and treatises "constitute unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation." *Id*. at 1203.

Another claim construction doctrine, the doctrine of prosecution history estoppel, is at issue in this case. During prosecution, an examiner might determine that an invention does not meet the statutory requirements for patentability and reject the claims. An applicant's arguments to the contrary, should they ultimately persuade the examiner, may inform the scope of the issued claims, depending on the context of the statements. *See, e.g.,* Advance Transformer Co. v. Levinson, 837 F.2d 1081, 1083 (Fed.Cir.1988) ("Positions taken in order to obtain allowance of an applicant's claims are pertinent to an understanding and interpretation of the claims that are granted by the PTO, and may work an estoppel as against a subsequent different or broader interpretation."). Statements made during prosecution which clearly disclaim a particular claim interpretation will limit the scope of the claims. Ballard Medical Products v. Allegiance Healthcare Corp., 268 F.3d 1352, 1359-60 (Fed.Cir.2001); Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576 (Fed.Cir.1995). Thus, prosecution history estoppel may prohibit the patentee from recovering claim scope surrendered during the prosecution of the patent. The Court now turns to the disputed terms of the patent-in-suit.

III. Discussion

A. Claim 1, Element [c]; Claim 6, Element [c]; Claim 11, Element [c]; Claim 16, Element [c]: "hub."

The Plaintiff's proposed definition is "the central location in a wheel, disk, or connector into which an axle or fan or propeller blade is attached." The Defendant urges the definition as "the center part of a wheel in

which an axle or fan or propeller blades are attached." The dispute concerns the inclusion of the term "connector" in the definition. The Court concludes that the inclusion of the word "connector" defines the term too broadly. In fact, the dictionary definition defines "hub" as "the cylindrical center of any circular, rotating part" and "the part of a wheel or fan into which an axle or blades are attached." *Academic Press Dictionary of Science and Technology* 1050 (1992). These definitions do not include the use of the word "connector." Likewise, the Court does not find any support for limiting the term, as in Defendant's proposed definition, to a wheel. Therefore, the Court defines "hub" to mean "the central location in a wheel or disk."

B. Claim 1, Element [b]; Claim 6, Element [b]; Claim 11, Element [b]; Claim 16, Element [b]: "pair of drive shafts" and "pair of rotatable drive shafts."

The Plaintiffs proposed definition is "a set of two drive shafts." The Defendant urges the definition as "a set of two distinct drive shafts." The dispute over this term concerns whether the word "pair" in the term requires that there be two drive shafts distinct from each other. The Defendant points to the language in the specifications and the figures which indicate that there are two distinct drive shafts. The Plaintiff points to Fig. 13 as showing that the term should not include the word "distinct" because in that figure there appears to be one drive shaft driven by the motor. Fig. 13, however, is mentioned in the portion of the specifications discussing alternative embodiments of the motor itself in the drive assembly, not alternative embodiments of the drive shafts. '894 Patent, Col. 7, ll. 19-40. Specifically, the discussion concerns the use of a transverse orientation of the motor in relation to the longitudinal axis of the body of the decoy in which gears transfer the rotation of the output shaft to a drive shaft. Id. at ll. 37-40. Therefore, the Court finds that the plain language of the claims and the ordinary meaning of the term "pair of (rotatable) drive shafts" require that the term be defined as "a set of two distinct drive shafts."

C. Claim 11, Element [c]; Claim 16, Element [c]: "releasably attach."

The Plaintiff's proposed definition is "components that are configured to be released from wherever they are attached to the decoy assembly." Defendant urges the definition as to "connect or join one part to another in a manner intended to be released, not permanent." The Court adopts the Plaintiff's proposed definition for this term.

D. Claim 1, Element [d]; Claim 11, Element [d]; Claim 16, Element [d]: "said elongated wing rotating without contact to a water level."

The Plaintiff's proposed definition is "the long wing appendage moves around its longitudinal axis without touching the water." The Defendant urges the definition as "the distances between the axis of rotation and the extreme edges of the width of the elongated wing are sufficiently less than the distance between the axis of rotation of the wing and the bottom of the decoy, such that when the decoy is floating on the water, the wings rotate without contacting the water." The issue with this term concerns whether the term is a functional or structural limitation and the limitation's effect on the term's definition.

The Defendant contends that the Plaintiff surrendered part of the scope of some of the claims at issue during prosecution in this case by pointing to an the Interview Summary covering an October 11, 2001, telephonic interview between the patent examiner, Kevin W. Jakel, and the Plaintiff's patent attorney, Scott Hemingway. (Def.'s Brief, Ex. C.) The Interview Summary states that in discussing allowable subject matter, the "Applicant agreed to add a functional clause to the claims indicating the the [sic] elongated wing did not touch the water" and that "[t]his additional limitation places the case in condition for allowance." (Def.'s Brief, Ex. C.) The parties dispute the effect of the prosecution history and this functional language.

Defendant urges the court to place a structural limitation on the claims containing this language. Plaintiff contends that this is only a functional limitation of the claim that permits any structure meeting the functional language to be allowed under the claim.

The characterization 'functional,' as used by the Patent Office, indicates nothing more than the fact that an attempt is being made to define something by what it does rather than by what it is. Application of Swinehart, 58 C.C.P.A. 1027, 439 F.2d 210, 212 (C.C.P.A.1971). There is nothing intrinsically wrong with the use of such a technique in drafting patent claims and there is a practical necessity for the use of functional language. *Id*. 'Functional' terminology may, in fact, render a claim quite broad. *Id*. at 213. By its own literal terms a claim employing such language covers any and all embodiments which perform the recited function. *Id*. The opposite may also be true. *Id*. *See also* K-2 Corporation v. Salomon, S.A., 191 F.3d 1356, 1363 (Fed.Cir.1999); Wright Medical Technology, Inc. v. Osteonics Corp., 122 F.3d 1440, 1443-44 (Fed.Cir.1997) (both analyzing functional language as a claim limitation). Indeed, in many cases it will be obvious that only a very limited group of objects will fall within the intended category. *Id*.

In this case, the '894 patent is a continuation-in-part of U.S. Patent No. 6,321,480 ("the '480 patent") issued on November 27, 2001. The ' 480 patent is the subject of a "Self Propelled Waterfowl Decoy." The '894 patent is the subject of a "Waterfowl Decoy with Interchangeable Movable Appendages." In order to distinguish the '894 patent from the prior art of the '480 patent, the patentee agreed to limit the claims such that the appendages did not touch the water and propel the waterfowl decoy except in those claims where the subject matter of the '480 patent was used in conjunction with the new subject mater of the '894 patent. The Defendant argues that the functional languages means that the size of the wing must be limited to a specific size in order to keep it from touching the water. The Plaintiff argues that the functional language merely requires that if the decoy is sitting on the water the size of the wings must be such that they do not touch the water. The functional language would then allow for wings of a greater size if, for instance, the decoy is mounted on a stand above the water or ground. In fact, as opposed to the specifications of the '480 patent, the specifications of the '894 patent discuss the use of the invention on a stand mounted above the water or ground. '894 Patent, Col. 6, ll. 31-54.

The court is convinced that this functional language in the claims limits only what the wings do as opposed to their structure or, more particularly, their size. The Patent Office referred to the language as 'functional' language and the specifications support this finding. Therefore, the Court adopts the Plaintiff's proposed definition of "the long wing appendage moves around its longitudinal axis without touching the water."

E. Claim 3, Claim 8, Claim 13, Claim 19: "interrupter that interrupts the rotation of at least one of said drive shafts" and "interruptable."

The Plaintiff's proposed definition is "an electronic component that intermittently stops the movement of the paddle or wing assembly." The Defendant urges the definition as "a device for intermittently (meaning automatically) interrupting the electric current that powers the rotation of at least one of said shafts." The dispute over this term involves whether the term must include the word automatic, or whether the interruption can be initiated manually. The Court finds no support for limiting the term to automatic interruption and thus adopts the Plaintiff's proposed definition of "an electronic component that intermittently stops the movement of the paddle or wing assembly."

F. Claim 1, Element [c]; Claim 6, Element [c]; Claim 11, Element [c]; Claim 16, Element [c]: "hub aperture."

The Plaintiff's proposed definition is "an opening in the hub where the wing or paddle assemblies are coupled to a rotating shaft." The Defendant urges the definition as "an opening in the center of the hub having an outlet which receives a drive shaft therethrough." The dispute over this term involves whether the opening in the hub must continue all the way through the hub. The Court finds no support for limiting the term to this extent and thus adopts the Plaintiff's proposed definition of "an opening in the hub where the wing or paddle assemblies are coupled to a rotating shaft."

So **ORDERED** and **SIGNED** this *6th* day of December, 2003.

E.D.Tex.,2003.
Solomon v. Overton's Inc.