United States District Court,
E.D. California.

Joseph V. KAPUSTA,
Plaintiff.
v.
GALE CORPORATION,
Defendant.

No. CIV S.03-1232 LKK KJM

Aug. 5, 2004.

Chris Gibson, Boutin, Dentino, Gibson, Di Giusto Hodell, Inc., Sacramento, CA, David Aldrich, Gene Winter, Steven Simonis, Saint Onge, Steward, Johnston and Reens, Stamford, CT, for Plaintiff.

Kathleen E. Finnerty, Greenberg, Traurig, LLP, Sacramento, CA, for Defendant.

[PROPOSED] CLAIM CONSTRUCTION ORDER FOR U.S. PATENT NO. 6,043,663

LAWRENCE K. KARLTON**, Chief Judge.**

This matter came on for a claim construction hearing on June 29, 2004. Plaintiff Joseph V. Kapusta ("Kapusta") was represented by Steve Simonis of St. Onge, Steward, Johnston & Reens, LLC and Chris Gibson of Boutin, Dentino, Gibson, Di Giusto, Hodell, Inc. Defendant Gale Corporation ("Gale") was represented by Kathleen E. Finnerty and Scott M. Plamondon of Livingston & Mattesich. Pursuant the parties' stipulation, only the term "hand-grip size case" contained in U.S. patent number 6,043,663 (the "'663 patent") required construction. After having considered the parties' arguments and the evidence presented, for the reasons set forth below, the Court rules as follows:

BACKGROUND FN1

FN1. The Background facts are taken from the Parties' moving papers.

The '663 patent relates to a hand-held electrical apparatus for testing the integrity of coaxial cables. The device consists of a common circuit contained in a rectangular-shaped "hand-grip size" box (commonly referred to as a "project box") with dimensions of approximately three inches in length, two inches in width, and one inch in thickness.

THE '663 PATENT

The '663 patent describes the invention as "primary and secondary instruments, which constitute the entire apparatus, for quickly and reliably checking cable components for short-circuits and conductivity...." The

device tests a length of wire to determine if low voltage current from a battery can successfully pass through it, and is connected to a cable using common coaxial connectors which have been in wide use for several decades. The device covered by the '663 patent is a simple continuity test circuit contained in a common rectangular box, described by Kapusta as a "hand-grip size case".

LEGAL STANDARD

Under Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995), affirmed 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), the court "has the power and obligation to construe as a matter of law the meaning of language used in the patent claim." The meaning of claims is ascertained principally through consideration of three sources: the claim language, the patent specification, and the prosecution history. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996). In conducting a "Markman hearing", a judge does not interpret the claims in a vacuum. Just as in any litigation, the parties determine the claims that are at issue, and the words of a particular claim that are at issue, and the court makes a determination of the disputes aspects of claim construction. Vivid Tech, Inc. v. American Science & Engineering, Inc., 200 F.3d 795, 803 (Fed.Cir.1999). No party bears the burden of proof in these proceedings; apparently the burden of correct interpretation lies with the Court. Level One Communication v. Seeq Tech., 987 F.Supp. 1191, 1196 (N.D.Cal.1997).

In construing the meaning of claim language, the court should look first at the claims themselves, then use the specifications to aid in defining the terms used in the claims, and finally, turn to the prosecution history if necessary and if in evidence. *Vitronics* at 1582-83. Unless claim terms are given a different meaning by the patentee, patent language is understood to convey its ordinary meaning to one skilled in the art. *Southwall,* 54 F.2d at 1578 (citing Intellical, Inc. v. Phonometrics, Inc., 952 F.2d 1384, 1387 (Fed.Cir.1992)). Courts are to construe disputed claim language according to "an objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean." Markman, 52 F.3d at 986. However, more often than not, one cannot be sure that the ordinary meaning of words delimits the interpretation of patent claims, because the words' meanings are often shaped by the context of the patent specifications. Courts are instructed to look to the specifications to clarify ambiguous claim terms, but must avoid reading "limitations appearing in the specification ... into [the] claims." Intervet Am., Inc. v. Kee-Vet Lab., Inc., 887 F.2d 1050, 1053 (Fed.Cir.1989).

It is well accepted that claims must be construed so as to sustain their validity. Carman Indus., Inc., v. Wahl, 724 F.2d 932, 937 n. 5 (Fed.Cir.1983).

Ordinarily, the intrinsic evidence found within the claim language, specifications, and prosecution history should be sufficient to resolve any ambiguities and determine the meaning of the claims. *Vitronics* at 1583. If the claims remain unclear after resort to the specifications, or if the court requires confirmation of what appears to be a likely definition, one may look to the prosecution history of the patent to determine whether a patentee intended the claims to have a certain meaning. Interactive Gift Express, Inc. v. CompuServe, Inc., 256 F.3d 1323, 1331 (Fed.Cir.2001). The words of unclear claims take on a clearer meaning when viewed in light of the back-and-forth between patent counsel and the PTO.

If the intrinsic evidence is insufficient for determining the scope of the disputed claims, the court may then rely on extrinsic evidence, such as dictionaries and expert testimony, in "coming to the proper understanding of the claims." *Vitronics* at 1583. In addition, extrinsic evidence "may be accepted by the court to enhance its understanding of the technology." Gart v. Logitech, Inc., 254 F.3d 1334 (Fed.Cir.2001); *see also* Pitney

Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1308 (Fed.Cir.1999) ("It is entirely appropriate, perhaps even preferable for a court to consult trustworthy extrinsic evidence to ensure that the claim construction ... is not inconsistent with clearly expressed, plainly, apposite and widely held understandings in the pertinent technical field"). In referring to these additional sources, the focus, of course, "remains on the meaning of claim language." *Gart* at 1340. Stated another way, the court may consider extrinsic evidence to the extent it helps illuminate the language of the patent documents. Markman, 52 F.3d at 979-81. "The district court's claim construction, enlightened by such extrinsic evidence as may be helpful, is still based upon the patent and prosecution history." Id. at 981.

Extrinsic evidence, of course, may not be used to vary or contradict the claim language. *Id*. However, the Federal Circuit in *Vitronics* did show a clear preference for some types of documentary extrinsic evidence, such as dictionaries and prior art documents, when used properly by the court to illuminate how a person skilled in the art would interpret particular ambiguous terms. *Vitronics* at 1585. Qualified expert testimony is also often helpful in determining such interpretation.

DISCUSSION

The parties disagree about what it means for a device to be contained within a "hand-grip size case." Gale asserts that the use of this term is ambiguous and must therefore be interpreted with both intrinsic and extrinsic evidence, namely prior art patents, the deposition testimony of inventor Joseph Kapusta, and the expert testimony of Mr. Mark Scheitrum, the electrical engineer proffered by the Gales, each of which was admitted into evidence without objection. Gale claims that such evidence demonstrates that the term is properly defined as having both upper and lower size limits, while Kapusta argues, without presenting any witnesses or evidence other than the patent grant and the devices in question, that the term is bounded in scope only by an upper size limit as defined in his responses to the various amendments made during the prosecution history.

This Court is mindful of the fact that it must interpret only claim terms, not specification language, and of the fact that it must not employ extrinsic evidence unless the language of the claims and specifications do not fully answer the questions at hand, the latter being the case here. *Vitronics* at 1584-85. At the same time, it would be nonsensical, and hardly efficacious, for this Court to employ a term that was itself materially ambiguous in construing claim language.

The Court has determined that the term "hand-grip size case" is ambiguous. A device contained in a "hand-grip size case" is of uncertain size and shape. Nothing in the '663 patent's claim language offers the Court assistance in determining the metes and bounds of the size or shape of a "hand-grip size case." Nothing in the specification articulates the meaning of the phrase "hand-grip size case," other than the description of the case in the one preferred embodiment described in the specifications and shown in the drawings, namely a one inch by two inch by three inch rectangular "project box." The specification is thus of little help in defining the meaning of a "hand-grip size case."

The prosecution history is in evidence and has been considered. However, the prosecution history also fails to define, either explicitly or by reasonable inference, the specific meaning of the term "hand-grip size case." Thus, the Court finds that extrinsic evidence is needed and helpful to interpret the meaning of this term.

In light of, *inter alia,* the evidence presented regarding the existence of continuity test devices of the

"pocket-size" variety in the prior art, any construction of the term "hand-grip" must be construed narrowly so that the ' 663 patent can be interpreted in a manner that sustains its validity. Based on the existence of the admitted prior art, and the other extrinsic evidence presented at the hearing, the term "hand-grip" cannot be construed so broadly as to encompass circuit test devices contained in pocket-size cases.

CONCLUSION

Kapusta suggested that the term is bounded only by an upper limit on size, and that any device that can be held in one's hand in any manner may be considered a "hand-grip size" device. The Court rejects this interpretation of the disputed term, and chooses instead to adopt the following claim construction which teaches an upper and lower limit, and causes the patent to be construed in a manner that sustains its validity:

The Court construes the term "hand-grip size case" to mean a case in which a device is contained with a lower size limit that is: **"no smaller than the width of an adult palm, so that it can be grasped firmly in one's hand; and no smaller than 1 inch in width" and "of a rectangular shape".**

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