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11 UNITED STATES DISTRICT COURT
12 CENTRAL DISTRICT OF CALIFORNIA—SOUTHERN DIVISION

13 POLYCITY ENTERPRISE LIMITED,

14 Plaintiff,

15 v.

16 FUNLINE INDUSTRIES, INC. and EASTON
17 ENTERPRISES, INC.

18 Defendants.

CASE NO: SACV04-202 JVS (SHx)

MEMORANDUM IN SUPPORT OF
DEFENDANTS' MOTION FOR
SUMMARY JUDGMENT OF
NONINFRINGEMENT

HEARING: AUGUST 30, 2004;
Courtroom 10C; 1:30 P.M.

The Hon. James V. Selna

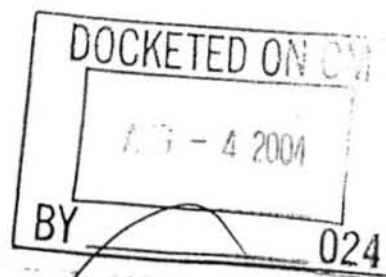


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INTRODUCTION

In this litigation, PolyCity Enterprise Limited ("PolyCity") has sued FunLine Industries, Inc. ("FunLine") and Easton Enterprises, Inc. ("Easton Enterprises") (together, "Defendants"), alleging infringement of U.S. Patent No. 5,769,625 (the "'625 patent," or the "patent-in-suit").¹ The '625 patent relates to "[a] safety lighter with an improved striker wheel and striker wheel mounting frame."² Every claim of the '625 patent requires the lighter to contain a striker wheel whose axis is mounted to the lighter frame through "a complimentary pair of mounting slots."³

Defendants' products do not contain mounting slots. Defendants sell cigarette lighters in which the striker wheel axis is mounted to the lighter frame through holes instead. The patent makes clear that holes and slots are different. Because Defendants' products lack the "mounting slots" required by every claim of the '625 patent, no reasonable fact-finder could conclude that Defendants' products infringe. Summary judgment of noninfringement is therefore appropriate.

BACKGROUND

I. The Patent-in-Suit

A. Claims

The '625 patent relates to "[a] safety lighter with an improved striker wheel and striker wheel mounting frame."⁴ A conventional striker wheel lighter

¹ See Statement of Uncontroverted Facts and Conclusions of Law In Support of Defendants' Motion for Summary Judgment of Noninfringement (hereinafter "Statement of Uncontroverted Facts and Conclusions of Law"), ¶ 1. The '625 patent is attached as Exhibit 1 to the Declaration of Elizabeth I. Rogers In Support of Defendants' Motion for Summary Judgment of Noninfringement (hereinafter "Rogers Decl.").

² Rogers Decl. Ex. 1 ('625 patent, abstract); *see also* Statement of Uncontroverted Facts and Conclusions of Law, ¶ 2.

³ Rogers Decl. Ex. 1 ('625 patent, claims 1-12); *see also* Statement of Uncontroverted Facts and Conclusions of Law, ¶ 3.

⁴ Rogers Decl. Ex. 1 ('625 patent, abstract) *see also* Statement of Uncontroverted Facts and Conclusions of Law, ¶ 2.

1 generates sparks when a user turns the wheel with his or her thumb.⁵

2 The '625 patent claims a lighter (or method for manufacturing a lighter) in
3 which the striker wheel axis is mounted to the frame through mounting slots that
4 allow the striker wheel axis to move between two positions. One slot position
5 allows the lighter to ignite. In the other slot position, rotating the striker wheel
6 does not generate enough friction to spark the flame.⁶ An adult can exert enough
7 force to move the striker wheel axis to the slot position that allows ignition; a child
8 cannot.⁷

9 The patent contains twelve claims: six directed toward a safety lighter itself,
10 and six directed toward a method of manufacturing a safety lighter. Only claims 1
11 and 7 are independent. Every claim requires the striker wheel axis to be mounted
12 to the frame through "a complimentary pair of mounting slots."⁸

13 Claim 1, with emphasis placed on the limitation at issue in this motion, reads
14 as follows:

- 15 1. A lighter comprising:
16 a lighter body having a top end;
17 a striker wheel, said striker wheel having an axis, and an outer annular
18 surface, said outer annular surface of said striker wheel having
19 an annular recessed center portion with a rough surface formed
20 thereon, and annular unrecessed lateral portions disposed beside
21 said annular recessed center portion, said annular unrecessed
22 lateral portions having smooth surfaces;
23 a mounting frame attached to the top end of the lighter body, *said*

24
25 ⁵ See Rogers Decl. Ex. 1 ('625 patent, col. 1, ll. 15-36); *see also* Declaration of
26 George Fang a/k/a Ming Fang In Support of Defendants' Motion for Summary
27 Judgment of Noninfringement (hereinafter "Fang Decl."), ¶ 4.

28 ⁶ See Rogers Decl. Ex. 1 ('625 patent, col. 5, ll. 2-10).

⁷ See Rogers Decl. Ex. 1 ('625 patent, col. 5, ll. 11-31).

⁸ See Rogers Decl. Ex. 1 ('625 patent, claims 1-12); *see also* Statement of
Uncontroverted Facts and Conclusions of Law, ¶ 3.

1 *mounting frame having*

2 *a complimentary pair of mounting slots formed therethrough to*
3 *rotatably receive said axis of said striker wheel in a first position*
4 *and in a second position, and a spring receptacle; and*

5 a flint;

6 the spring exerting a compressive force against the flint and forcing
7 the flint into contact with the rough surface of the annular recessed
8 center portion of the striker wheel, the compressive force exerted by
9 the spring being insufficient to cause the flint to generate sparks when
10 the axis of the striker wheel is in the first position and the compressive
11 force exerted by the spring being sufficient to cause the flint to
12 generate sparks when the axis of the striker wheel is in the second
13 position.

14 Claims 2 through 6 depend from claim 1.⁹ Consequently, they also contain
15 the limitation at issue.¹⁰

16 Claim 7, the sole independent method claim, also requires that the accused
17 method for manufacturing a safety lighter include the mounting slots limitation. It
18 claims a method for manufacturing a safety lighter comprising, among other
19 things, “forming a *complimentary pair of mounting slots* through the mounting
20 frame.”¹¹ Claims 8-12 depend from claim 7, and therefore also contain this
21 limitation.

22 B. Specification

23 The ‘625 patent specification describes and depicts the claimed mounting
24 slots, and distinguishes the improved striker wheel mounting frame in which the
25

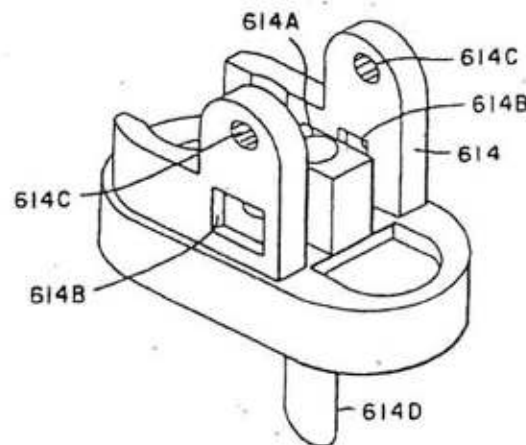
26 ⁹ See Rogers Decl. Ex. 1 (‘625 patent, col. 6, l. 54 to col. 7, l. 7).

27 ¹⁰ *Whapeton Canvas Co. v. Frontier, Inc.* 870 F.2d 1546, 1552 n.9 (Fed. Cir. 1989)
28 (“One who does not infringe an independent claim cannot infringe a claim
dependent on (and thus containing all the limitations of) that claim.”).

¹¹ Rogers Decl. Ex. 1 (‘625 patent, col. 7, ll. 26-27) (emphasis added).

1 claimed slots appear from prior art lighters whose mounting frames contained
2 holes instead of slots. The abstract explains that the invention relates to “[a] safety
3 lighter with an improved striker wheel and striker wheel mounting frame,”¹² and
4 that “the striker wheel is mounted to the lighter in slots.”¹³

5 The specification states that Figures 2-4 illustrate the prior art lighter.¹⁴ This
6 prior art lighter contains a mounting frame 614.¹⁵ “The striker wheel 620 is
7 mounted on frame 614 with the wheel’s axis 620A fitting into holes 614C.”¹⁶ The
8 relevant portion of Figure 2 depicts the prior art lighter, including holes 614C, as
9 follows:¹⁷



16 Next, the specification discusses the present invention. It states that:

17 FIGS. 5 through 15 illustrate the present invention. As can be seen,
18 the difference between the present invention and the prior art lighter is
19 in the structure of the striker wheel *and the mounting frame*. All other
20 elements of the lighters are the same and are assembled and operated
21 the same way.¹⁸

22 ¹² Rogers Decl. Ex. 1 (‘625 patent, abstract).

23 ¹³ *Id.*

24 ¹⁴ Rogers Decl. Ex. 1 (‘625 patent, col. 3, ll. 49-50 (“Illustrated in FIGS. 2, 3 and 4,
25 are elements forming a prior art lighter.”)).

26 ¹⁵ *Id.*, at col. 3, ll. 29, 50.

27 ¹⁶ Rogers Decl. Ex. 1 (‘625 patent, col. 3, ll. 57-59).

28 ¹⁷ Figures 3 and 4 also depict prior art lighters. Although Figures 3 and 4 depict
circular openings in the mounting frame, these openings are not labeled with any
number.

¹⁸ Rogers Decl. Ex. 1 (‘625 patent, col. 4, ll. 29-34) (emphasis added).

1 The specification then explains that:

2 Another feature of the preferred embodiment of the invention is found
3 in the *changes to the holes 614C of the prior art lighter*. In the
4 preferred embodiment, *these holes are replaced by slots 714E*.¹⁹

5 This is the only change to the mounting frame discussed in the patent—a change in
6 the openings through which the striker wheel axis is mounted from holes to slots.

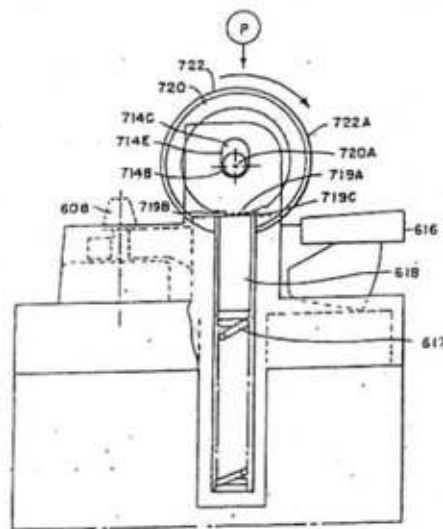
7 The specification goes on to explain that this change from holes to mounting
8 slots allows the axis of the striker wheel to be in one of two slot positions—a
9 position that allows a user to ignite the lighter, and one that does not:

10 Slots 714E permit striker wheel 720 to *translate along the length of*
11 *the slots*, which length is substantially parallel to spring 617. By
12 virtue of this configuration, as annular unrecessed lateral portions 722
13 of striker wheel 720 are depressed, *the striker wheel's axis 720A is*
14 *moved from slot position 714C to slot position 714B*. As the striker
15 wheel is thus moved, spring 617 is compressed and exerts an
16 increased force against flint 618, which in turn exerts an increased
17 force against protuberances 719A of the striker wheel's annular
18 recessed center portion 719. *When striker wheel axis 720A is in slot*
19 *position 714C, the force exerted by spring 617 against flint 618, and*
20 *in turn the force exerted by flint 618 against protuberances 719A is*
21 *insufficient to create sparks when striker wheel 720 is rotated by the*
22 *user. However, when striker wheel axis 720A is in slot position 714B,*
23 *the increased force exerted by spring 617 against flint 618, and in turn*
24 *the increased force exerted by flint 618 against protuberances 719A is*
25 *sufficient to create sparks when striker wheel 720 is rotated by the*
26 *user*.²⁰

27
28 ¹⁹ Rogers Decl. Ex. 1 ('625 patent, col. 4, ll. 56-59) (emphasis added).

²⁰ Rogers Decl. Ex. 1 ('625 patent, col. 4, l. 59 to col. 5, l. 11) (emphasis added).

Figures 7-9, which illustrate the claimed invention, depict slots 714E. These figures show that the mounting slots are shaped differently than the prior art holes; the slots are longer, not round. The claimed mounting slots allow the axis of the striker wheel to have two positions along their length. Position 714C, depicted in Figure 8, does not allow the striker wheel to be rotated with force sufficient to cause sparks. In contrast, when the axis of the striker wheel is in slot position 714B, depicted in Figure 9, the user can create sparks sufficient to ignite the flame. The specification makes clear that “[t]o generate sparks which light the lighter’s flame,” a user must exert force on the striker wheel sufficient to “move axis 720A from position 714C to position 714B.”²¹ Figure 9 appears as follows:



No figure of the ‘625 patent ever depicts the mounting slots of the invention in anything other than a shape long enough to allow the striker wheel axis to move from an upper to a lower position. As in Figures 7-9, Figures 5, 6 and 10 through 15 show slots 714E as an opening longer than the round holes shown in prior art Figure 2. Figures 5, 6, and 10-15 erroneously show slots 714E as also being labeled with the numbers 614C and 614B; however, even assuming it was not an error to label these openings with the 614C reference number—which it was²²—

²¹ Rogers Decl. Ex. 1 (‘625 patent, col. 5, l. 11-18).

²² Labeling slots 714E in Figures 5, 6, and 10 through 15 with the additional numbers 614C and 614B was an error. This is so because the specification states that “[t]he same reference numeral will be used to identify identical elements

Figures 5, 6, and 10 through 15 refer to *the present invention*, not the prior art lighter,²³ and the openings they depict are identical to the properly labeled mounting slots 714E in Figures 7-9, which are long enough to allow the striker wheel axis to be in the two positions described in the specification. No figure illustrating the present invention shows the claimed mounting slots having the shape of the holes 614C of the prior lighter—those holes are shown and labeled only in Figure 2.

C. Prosecution History

As its front page indicates, the '625 patent is a continuation-in-part of an earlier application, Ser. No. 583,214 (the "'214 parent application"), which was filed on January 4, 1996, and subsequently abandoned.²⁴ The '214 parent application stated that the sole difference between the invention applied for and the prior art was the structure of the striker wheel.²⁵ It also stated that "[t]he striker wheel is mounted on frame 614 with the wheel's axis 620A fitting into holes

throughout the drawings." Rogers Decl. Ex. 1 ('625 patent, col. 3, ll. 20-22). As the specification explains, and as Figure 2 properly shows, the "[n]ozzle actuating lever 616 is mounted on the frame with pivots 616A inserted into slots 614B." *Id.*, col. 3, ll. 52-53. The "slots 614B" element is supposed to refer to an entirely different element than the element through which the striker wheel axis goes. But Figures 5, 6, and 10 through 15 leave the openings through which the nozzle actuating lever is mounted unlabeled, and instead mistakenly draw a line from "614B" to the slots 714E, the openings through which the striker wheel axis is mounted. Similarly, the specification states, and Figures 2, and 7-9 properly show, that in the prior art lighter the openings for the striker wheel axis are holes 614C, and in the claimed invention, slots 714E replace those holes. *Id.*, col. 4, ll. 56-59. The prior art holes 614C and slots 714E are different elements. Therefore, the figures labeling the same element with the numbers 714E, 614C, and 614B are erroneously drawn.

²³ Rogers Decl. Ex. 1 ('625 patent, col. 4, l. 29) ("FIGS. 5 through 15 illustrate the present invention.").

²⁴ Rogers Decl. Ex. 1 ('625 patent, Related U.S. Application Data).

²⁵ The prosecution history of the '214 parent application is attached as Exhibit 2 to the Rogers' declaration. See Rogers Decl. Ex 2 ('214 parent application prosecution history, at p. 8, ll. 4-7 (FUN/EE00025)).

1 614C.”²⁶ Figure 7 of the ‘214 parent application, which illustrated the invention
2 claimed in that application, showed the openings in the mounting frame as
3 identical to the prior art holes depicted in Figures 2 and 6 of the ‘214 parent
4 application.²⁷

5 The two claims submitted in the ‘214 parent application did not mention
6 “slots” or any other openings through which the striker wheel was mounted to the
7 frame—rather, the claims claimed essentially a prior art lighter improved by having
8 a striker wheel with smooth portions.²⁸ The examiner rejected claims 1 and 2 under
9 35 U.S.C. § 103 for being unpatentable over United States Patent No. 4,822,276 to
10 Bisbee (“Bisbee”), and also as being unpatentable over United States Patent No.
11 4,687,437 issued to Springer in light of United States Patent No. 5,096,414 issued to
12 Zellweger.²⁹

13 Instead of responding directly to the rejection, the applicant allowed the ‘214
14 parent application to go abandoned.³⁰ The applicant prosecuted the continuation-
15 in-part application that issued as the ‘625 patent-in-suit,³¹ which for the first time
16 purported to improve the mounting frame of the lighter, and added the “slots”
17 limitation that the applicant distinguished from the holes used in the prior art.

18
19 ²⁶ Rogers Decl. Ex 2 (‘214 parent application prosecution history, at p. 6, ll. 12-13
20 (FUN/EE00023)).

21 ²⁷ Rogers Decl. Ex 2 (‘214 parent application prosecution history, at FIG 2.
22 (FUN/EE00029), FIGs 6-7 (FUN/EE00033), and p. 8, l. 4 (FUN/EE00025)).

23 ²⁸ See Rogers Decl. Ex 2 (‘214 parent application prosecution history, application
24 claims 1 and 2, at p. 9, l. 11 to p. 10 (FUN/EE00026-27)).

25 ²⁹ Rogers Decl. Ex 2 (‘214 parent application prosecution history, at, June 11, 1996
26 Office Action (FUN/EE00046-48)).

27 ³⁰ Rogers Decl. Ex 2 (‘214 parent application prosecution history, at January 16,
28 1997 Notice of Abandonment (FUN/EE00055)).

29 ³¹ Rogers Decl. Ex 2 (‘214 parent application prosecution history, at November 15,
30 1996 Amendment in Parent Case (FUN/EE00054). A continuation-in-part
31 application shares some common subject matter with its parent, but also contains
32 new matter. *Univ. of W. Va. Bd. Of Trustees v. VanVoorhies*, 278 F.3d 1288, 1297
(Fed. Cir. 2002).

II. The Defendants' Products

Defendants have not made, used, sold, or offered for sale in the United States any cigarette lighters in which a striker wheel is mounted to the frame through slots. Defendants have sold several models of safety lighters after the June 23, 1998 issue date of the patent-in-suit; however, in every model having a striker wheel,³² the openings in the mounting frames are the same as the "holes 614C of the prior art lighter," which the '625 patent expressly distinguished from the claimed mounting slots.³³

The holes in Defendants' striker wheel safety lighters are identically shaped in all of their models.³⁴ They are round holes that have been used in the prior art, including Defendants' own lighters, for many years.³⁵

³² Defendant Easton Enterprises has also sold certain electric lighters that it does not believe PolyCity has accused of infringement. These electric models cannot infringe the '625 patent because, in addition to lacking the claimed mounting slots, they also do not have a striker wheel, which is another limitation required by every claim. *See* Fang Decl., ¶ 11.

³³ Fang Decl., ¶ 9; *see also* Statement of Uncontroverted Facts and Conclusions of Law, ¶¶ 4-5.

³⁴ *See* Fang Decl., ¶¶ 6, 9-10. Since approximately February 2003, FunLine has sold to Easton Enterprises, and Easton Enterprises has sold in the United States, three models of lighters that have a striker wheel: EDL001; EDL002; and EDL003. *Id.*, ¶ 5. The only differences between these models are the shape and size of the chambers containing lighter fluid—the mounting frames are identical. *Id.*, ¶ 6. From the June 23, 1998 issue date of the patent-in-suit to approximately February of 2003, Easton Enterprises also sold in the United States two other lighter models having a striker wheel: AA-1, and SDL765. *Id.*, ¶ 10. The AA-1 and SDL765 used holes in the mounting frames having the same shape as the holes found in the EDL001, EDL002, and EDL003, and in prior art lighters. *Id.* In addition to lacking the claimed mounting slots, the AA-1 and SDL765 models cannot infringe the '625 patent as a matter of law, because their striker wheels do not have any smooth portions, and therefore lack the "unrecessed lateral portions having smooth surfaces" required by every claim. The EDL001, EDL002, EDL003, AA-1, and SDL765, all of which have identical holes through which the striker wheel axis is mounted, are the only lighter models containing a striker wheel that either Defendant has ever made, used, sold, or offered for sale in the United States. *Id.*, ¶ 11.

1 The document bearing bates number FUN/EE00390 is the schematic
2 diagram used to create the molds for the mounting frames of Defendants' EDL001,
3 EDL002, and EDL003 lighters.³⁶ As can be seen from FUN/EE00390, as well as
4 from the sample EDL001 lodged with the Court (from which the lighter fluid has
5 been removed), the holes used to mount the striker wheel axis in Defendants'
6 lighter products are indistinguishable from "holes 614C of the prior art lighter"
7 shown in the '625 patent.³⁷

8 ARGUMENT

9 I. There Is No Literal Infringement As A Matter of Law Because 10 Defendants' Striker Wheel Safety Lighters Use Holes Instead of The 11 Claimed "Mounting Slots"

12 The Court should grant summary judgment of no literal infringement
13 because Defendants' striker wheel safety lighters unquestionably use holes instead
14 of the claimed mounting slots. Where, as here, there is no dispute regarding the
15 physical structure of the accused product, the question of literal infringement
16 collapses into an issue of law. *General Mills, Inc. v. Hunt-Wesson, Inc.*, 103 F.3d
17 978, 983 (Fed. Cir. 1997); *see also ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 540
(Fed. Cir. 1998).

18 "Summary judgment of noninfringement is appropriate where the patent
19 owner's proof is deficient in meeting an essential part of the legal standard for
20 infringement, since such failure will render all other facts immaterial." *Telemac*
21 *Cellular Corp. v. Topp Telecom, Inc.*, 274 F.3d 1316, 1323 (Fed. Cir. 2001).³⁸ For
22
23
24

25 ³⁵ Fang Decl., ¶ 9.

26 ³⁶ Fang Decl., ¶ 7.

27 ³⁷ Fang Decl., ¶¶ 7-9; *see also* Statement of Uncontroverted Facts and Conclusions
28 of Law, ¶ 6.

³⁸ *See also Avia Group Int'l, Inc.*, 853 F.2d 1557, 1561 (Fed. Cir. 1988) ("[T]his
court has repeatedly emphasized that summary judgment is as appropriate in a
patent case as in any other.") (quotation marks and citations omitted).

1 literal infringement, each and every limitation of an asserted claim must be present
2 in the accused product.³⁹

3 Defendants' products cannot literally infringe the '625 patent because they
4 lack the "complimentary pair of mounting slots" required by every claim. A "slot"
5 is a narrow opening, a slit or groove.⁴⁰ The holes through which the striker wheel
6 axis is mounted to the frames in Defendants' products are different. They are
7 round, circular openings. The claimed mounting slots are missing. Consequently,
8 Defendants' products cannot literally infringe the '625 patent.⁴¹

9 **II. Infringement—Both Literal and Under the Doctrine of Equivalents—Is**
10 **Precluded As a Matter of Law Because The '625 Patent Expressly**
11 **Relinquished Coverage of the Holes Used In Defendants' Products**

12 Even if the ordinary meaning of "slots" included openings having the shape
13 of the holes found in the prior art and Defendants' products—which it does not—
14 the "mounting slots" limitation in the '625 patent cannot be construed to cover
15 holes because the patent expressly relinquished that subject matter. The intrinsic
16 evidence leaves no room for doubt that "mounting slots" are different than holes.⁴²

17 ³⁹ *Telemac*, 247 F.3d at 1330 (explaining that "[a]ny deviation from the claim
18 precludes such a finding").

19 ⁴⁰ *See, e.g.*, Meriam-Webster Online Dictionary, www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=slot, (defining "slot" as "a narrow opening or
20 groove"); Dictionary.com, www.yourdictionary.com/ahd/s/s0481000.html,
21 (defining "slot" as "A narrow opening; a groove or slit"); *see also Unitherm Food*
22 *Sys., Inc. v. Swift-Ekrich, Inc.*, ___ F.3d ___, 2004 WL 1543286, at *7 (July 12,
23 2004) ("We have often noted that judges '[judges may] rely on dictionary
24 definitions when construing claim terms, so long as the dictionary definition does
25 not contradict any definition found in or ascertained by a reading of the patent
26 documents.'") (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584,
27 n. 6 (Fed. Cir. 1996) (brackets in *Unitherm*); *see also* Statement of Uncontroverted
28 Facts and Conclusions of Law, ¶ 7.

⁴¹ *See* Statement of Uncontroverted Facts and Conclusions of Law, ¶ 8.

⁴² In *Vitronics*, the Federal Circuit explained that in interpreting an asserted claim,
the court should look first to the intrinsic evidence, "i.e., the patent itself, including
the claims, the specification and, if in evidence, the prosecution history," that the
intrinsic evidence "is the most significant source of the legally operative meaning
of disputed claim language," and that the specification is usually dispositive; "it is

1 Because the '625 patent disclaimed coverage of holes, the claimed "mounting
2 slots" cannot properly be interpreted to include openings having the same shape as
3 the holes found in prior art lighters and the accused products. *Cultor Corp. v. A.E.*
4 *Staley Mfg. Co.*, 224 F.3d 1328, 1331 (Fed. Cir. 2000) ("Claims are not correctly
5 construed to cover what was expressly disclaimed.").

6 Nor, as a matter of law, can holes be held equivalent to the claimed
7 mounting slots. Where the patent clearly excludes certain subject matter, the
8 patentee is barred from asserting that any disclaimed subject matter infringes under
9 the doctrine of equivalents. *Scimed Life Sys., Inc. v. Advanced Cardiovascular*
10 *Sys., Inc.*, 242 F.3d 1337, 1345-46 (Fed. Cir. 2001).⁴³ The doctrine of equivalents
11 does not extend to an accused product containing structure specifically excluded by
12 the patent. *Weiner v. NEC Elecs., Inc.*, 102 F.3d 534, 541 (Fed. Cir. 1996); *Dolly,*
13 *Inc. v. Spalding & Evenflo Cos.*, 16 F.3d 394, 400 (Fed. Cir. 1994) ("[T]he concept
14 of equivalency cannot embrace a structure that is specifically excluded from the
15 scope of the claims.").

16 In this case, a clear surrender of coverage occurs at column 4, lines 56-59 of
17 the '625 patent, which states:

18 Another feature of the preferred embodiment of the invention is found
19 in the *changes to holes 614C of the prior art lighter. In the preferred*
20 *embodiment, these holes are replaced by slots 714E.* (emphasis
21 added).

22
23
24 the single best guide to the meaning of a disputed term." (citation omitted). 90
25 F.3d at 1582.

26 ⁴³ In *Scimed*, the Federal Circuit affirmed a finding of summary judgment of
27 noninfringement, reviewed pertinent cases, and explained that "[i]n each of these
28 cases, by defining the claim in a way that clearly excluded certain subject matter,
the patent implicitly disclaimed the subject matter that was excluded and thereby
barred the patentee from asserting infringement under the doctrine of equivalents."
242 F.3d at 1346.

1 Figure 2 of the '625 patent is the only figure illustrating the prior art lighter labeled
2 with holes 614C—it shows round, circular openings.

3 To replace such openings with slots in the preferred embodiment, as this
4 passage makes clear the invention does, “slots” must be different than holes. *See*
5 *Fantasy Sports Properties, Inc. v. Sportsline.com, Inc.*, 287 F.3d 1108, 1114 (Fed.
6 Cir. 2002) (construing “bonus points” limitation to mean points awarded in addition
7 to the points given for that scoring play in an actual football game, where
8 specification stated “[c]omputerized football points are awarded for touchdowns,
9 field goals, and points awarded after touchdowns,” and that “[b]onus points are *also*
10 awarded based upon the difficulty of the play”) (emphasis in original).

11 Because the specification states that holes are replaced by slots, the surrender
12 of subject matter occurs wherever the patent uses the term “slots” to describe the
13 openings through which the striker wheel is mounted to the frame of the lighter.
14 Every claim in the '625 patent requires “a complimentary pair of mounting slots,”
15 through which the striker wheel axis is mounted. There is no claimed embodiment
16 with language broad enough to cover openings in the shape of the holes found in
17 prior art lighters. In every claim, those holes have been replaced by slots, and the
18 '625 patent never describes the claimed mounting slots 714E as having the shape of
19 the holes found in prior art lighters. The surrender of coverage from the claim term
20 “mounting slots” is consistent and complete. *See Bell Atl. Network Servs. v. Covad*
21 *Communications Group, Inc.*, 262 F.3d 1258, 1271-73 (Fed. Cir. 2001) (interpreting
22 “mode” limitation narrowly where the patent consistently used the terms “mode”
23 and “rate” “to refer to two separate and distinct concepts”).⁴⁴

24 The remainder of the intrinsic evidence confirms that the '625 patent
25 completely surrendered coverage of the holes found in the mounting frames of prior
26 art lighters—as in *Bell Atlantic*, the patent consistently indicates that “holes” are
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⁴⁴ *See also* Statement of Uncontroverted Facts and Conclusions of Law, ¶ 12.

1 separate and distinct from the claimed “mounting slots.”⁴⁵ Four additional sources
2 of intrinsic evidence make clear that the disclaimer applies to the claimed invention
3 across the board, and is not limited to a preferred embodiment.

4 First, the abstract states that the invention has “an improved striker wheel *and*
5 *striker wheel mounting frame*.”⁴⁶ This statement indicates that the invention has
6 improved the prior art mounting frame in some manner. The abstract then describes
7 a single difference relating to the mounting frame, *viz.* “the striker wheel is mounted
8 to the lighter in slots.” Thus, from the outset, the ‘625 patent identifies the mounting
9 slots as the difference that improves upon the mounting frames of prior art lighters.
10 *Cf. Scimed*, 242 F.3d at 1342 (analyzing abstract in support of finding disclaimer of
11 subject matter).

12 Second, the figures of the ‘625 patent consistently depict the openings for the
13 striker wheel axis in the present invention as being shaped differently than the
14 circular holes illustrated in the prior art lighter. The patent states that “FIGS. 2, 3
15 and 4 are elements forming a prior art lighter,” and that “FIGS. 5 through 15
16 illustrate the present invention.”⁴⁷ Figure 2 illustrates holes 614C of the prior art
17 lighter. The holes are round.

18 No figure illustrating any embodiment of the present invention depicts slots
19 714E as having a round shape. Figures 5-15 all illustrate the mounting slots as
20 having an identical shape, which differs from holes. Thus, patent consistently shows
21 that the claimed mounting slots are not round holes. *See Alloc, Inc. v. Int’l Trade*
22 *Comm’n*, 342 F.3d 1361, 1369-70 (Fed. Cir. 2003) (holding that claims included
23 “play” limitation and noting that “all the figures and embodiments disclosed in the
24 asserted patents imply play, or, as in the case of Figure 1b, expressly disclose play”);
25 *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1581 (Fed. Cir. 1997) (rejecting argument
26 that “passage” limitation should include smooth-walled structures where written

27 ⁴⁵ See Statement of Uncontroverted Facts and Conclusions of Law, ¶ 9.

28 ⁴⁶ Rogers Decl. Ex. 1 (‘625 patent, abstract).

⁴⁷ Rogers Decl. Ex. 1 (‘625 patent, at col. 3, ll. 49-50, col. 4, l. 29).

1 description distinguished prior art passages by noting that they were generally
2 smooth-walled, and where all the “passage” structures contemplated by the written
3 description of the invention were all either non-smooth or conical).

4 Third, the specification states—with no restriction to particular
5 embodiments—that “the difference between the present invention and the prior art
6 lighter is in the structure of the striker wheel *and the mounting frame*,” and that
7 “[a]ll other elements of the lighters are the same and are assembled and operated the
8 same way.”⁴⁸ The only change to the mounting frame mentioned anywhere in the
9 ‘625 patent is the change in the openings through which the striker wheel axis is
10 mounted from the holes used in prior art lighters to the claimed mounting slots. *See*
11 *Ekchian v. Home Depot, Inc.*, 104 F.3d 1229, 1304 (Fed. Cir. 1997) (“Since, by
12 distinguishing the claimed invention over the prior art, an applicant is indicating
13 what the claims do not cover, he is by implication surrendering such protection.”).

14 Fourth, the prosecution history underscores that improving the mounting
15 frame by replacing holes with the claimed mounting slots was crucial to allowance
16 of the claims.⁴⁹ The mounting slots limitation, the statements in the specification
17 about the improvement in the mounting frame, and the replacement of holes found in
18 the prior art lighter with slots, were absent from the specification as originally filed
19 in the ‘214 parent application.

20 The examiner rejected the claims in the ‘214 parent application as obvious in
21 light of the prior art including, *inter alia*, Bisbee.⁵⁰ Although the written description
22 in Bisbee does not directly discuss the shape of the openings in its lighter, Figure 1
23 shows a perspective view of the lighter, including its mounting frame, and illustrates
24 that the opening in the mounting frame is the same shape as the striker wheel axle; in
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27 ⁴⁸ Rogers Decl. Ex. 1 (‘625 patent, col. 4, ll. 30-33).

⁴⁹ *See* Statement of Uncontroverted Facts and Conclusions of Law, ¶ 10.

28 ⁵⁰ Rogers Decl. Ex. 2 (‘214 parent application prosecution history, at June 11, 1996 Rejection); Statement of Uncontroverted Facts and Conclusions of Law, ¶ 11.

1 other words, Bisbee illustrates a lighter in which the striker wheel is mounted to the
2 frame through a hole.⁵¹

3 This prior-art rejection was not overcome until the patentee added the
4 “mounting slots” limitation, and distinguished those slots from the holes found in
5 prior art lighters. Consequently, the prosecution history shows that adding the
6 “mounting slots” limitation allowed the applicant to overcome a prior art rejection,
7 which is further evidence of a disclaimer of the prior art structure. *See Springs*
8 *Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 993-94 (Fed. Cir. 2003)
9 (finding clear disclaimer of subject matter based on amendment to claims adding a
10 limitation the applicant argued distinguished the invention from a prior art
11 reference).

12 The applicant added the “mounting slots” limitation after a prior art-based
13 rejection, and stated in the specification that these slots replaced holes used in prior
14 art lighters. “Mounting slots” therefore cannot be construed to cover holes without
15 improperly eviscerating a distinction on which the applicant relied to obtain issuance
16 of the ‘625 patent. As the Federal Circuit explained in *Springs Window Fashions*,
17 PolyCity should be held to the distinction reflected in the patent and prosecution
18 history:

19 The public notice function of a patent and its prosecution history
20 requires that a patentee be held to what he declares during the
21 prosecution of his patent. A patentee may not state during prosecution
22 that the claims do not cover a particular device and then change
23 position and later sue a party who makes that same device for
24 infringement. The prosecution history constitutes a public record of
25 the patentee’s representations concerning the scope and the meaning
26

27 ⁵¹ Bisbee is attached as Exhibit 3 to the Rogers Decl. *See also* Bisbee, col. 3, ll. 1-
28 4 (stating that the flint contacts a “friction wheel 20 that may rotate about an axle
30 to generate sparks”).

1 of the claims, and competitors are entitled to rely on those
2 representations when ascertaining the degree of lawful conduct. . . .
3 323 F.3d at 995 (citations and quotation marks omitted).

4 In sum, the intrinsic evidence allows but one conclusion: the '625 patent
5 does not cover lighters in which the striker wheel axis is mounted to the frame
6 through holes. Where, as here, the intrinsic evidence is clear, the inquiry should
7 come to an end.⁵²

8 "A patentee may not proffer an interpretation for the purposes of litigation
9 that would alter the indisputable public record consisting of the claims, the
10 specification and the prosecution history, and treat the claims as a nose of wax."
11 *Southwall Tech., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1578 (Fed. Cir. 1995)
12 (internal citation and quotation marks omitted). But that is what PolyCity would
13 have to do to establish that Defendants' lighters contain the "mounting slots"
14 limitation required by every claim of the '625 patent.

15 The intrinsic evidence specifically excludes the holes used in Defendants'
16 products from the scope of that limitation. Summary judgment of
17 noninfringement—both literally and under the doctrine of equivalents—is
18 therefore warranted. *Springs Window Fashions*, 323 F.3d at 994 (affirming grant
19 of summary judgment of noninfringement, and stating "[g]iven that the Pluber
20 reference and Novo's device are nearly identical with respect to the arrangement of
21 their cutting edges, it is clear that the applicant disclaimed coverage of Novo's
22 device"); *see also Gaus v. Conair Corp.*, 363 F.3d 1284, 1291-92 (Fed. Cir. 2004)
23 (reversing denial of JMOL where accused device could not infringe because it
24 contained structure the patent disavowed); *AK Steel Corp. v. Sollac*, 344 F.3d
25 1234, 1238-41 (Fed. Cir. 2003) (affirming grant of summary judgment of
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27 ⁵² *Vitronics* at 1583 ("In most situations, an analysis of the intrinsic evidence alone
28 will resolve any ambiguity in a disputed claim term. In such circumstances, it is
improper to rely on extrinsic evidence.").

1 noninfringement, and stating “AK Steel’s attempt to distance itself from the clear
2 limiting statements in its specification is unavailing).

3 **III. Prosecution History Estoppel Also Precludes Infringement Under the**
4 **Doctrine of Equivalents**

5 Defendants’ products also cannot infringe the ‘625 patent under the doctrine
6 of equivalents for the additional reason that the doctrine of prosecution history
7 estoppel bars PolyCity from asserting that holes are equivalent to the claimed
8 mounting slots.⁵³ Prosecution history estoppel “preclude[s] a patentee from
9 regaining, through litigation, coverage of subject matter relinquished during
10 prosecution of the application for the patent.” *Festo Corp. v. Shoketsu Kinzoku*
11 *Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002).

12 Amending a claim to add a limitation to overcome a rejection related to
13 patentability narrows the claim, and results in a presumption that the applicant
14 surrendered the territory between the original claim limitation and the amended
15 limitation. *Id.* at 736, 741. In this case, the applicant submitted two claims in the
16 ‘214 parent application that are similar to claims 1 and 2 of the ‘625 patent, but that
17 contain fewer limitations. The sole improvement to the striker wheel in the two
18 claims of the ‘214 parent application is also reflected in claims 1 and 2 of the ‘625
19 patent: a striker wheel with “annular unrecessed lateral portions having smooth
20 surfaces.”⁵⁴ But when this improvement to the striker wheel was the sole difference
21 between the invention and the prior art, the Patent Office rejected the claims for a
22 reason related to patentability, *viz.*, that the claims were unpatentable pursuant to 35
23 U.S.C. § 103.⁵⁵

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26 ⁵³ See Statement of Uncontroverted Facts and Conclusions of Law, ¶ 13.

27 ⁵⁴ Compare Rogers Decl. Ex. 1 (‘625 patent, col. 6, ll. 33-34) with Rogers Decl.
Ex. 2 (‘214 parent application prosecution history, at p. 9, claim 1, ll. 16-18).

28 ⁵⁵ Rogers Decl. Ex. 2 (‘214 parent application prosecution history, at June 11, 1996
Rejection).

1 The applicant then allowed the '214 parent application to go abandoned, and
2 prosecuted the application that issued as the '625 patent, which is a continuation-in-
3 part of the '214 parent application. In claims 1 and 2 of the '625 patent, the
4 applicant made the invention narrower by adding limitations, including the
5 "mounting slots" limitation. Even though this occurred in a related application, this
6 was an amendment to which prosecution history estoppel applies. *Mark I Marketing*
7 *Corp. v. RR Donnelley & Sons Co.*, 66 F.3d 285, 292 (Fed. Cir. 1995), *cert. denied*,
8 516 U.S. 1115 (1996) (holding that prosecution history estoppel applies both where
9 an amendment is made directly and where an applicant adds a limitation in a
10 continuation application filed after the examiner rejects claims in the parent
11 application for reasons related to patentability).

12 The addition of the "mounting slots" limitation to the claims of the '625
13 patent therefore gives rise to a presumption that the patentee surrendered the entire
14 territory between the original claim limitation—which did not require the striker
15 wheel axis to be mounted through any particular kind of opening—and the claim as
16 amended, which requires the striker wheel axis to be mounted through slots. To
17 overcome this presumption, PolyCity would have to show that "at the time of the
18 amendment one skilled in the art could not reasonably be expected to have drafted a
19 claim that would have literally encompassed the alleged equivalent," here, the holes.
20 *Festo*, 525 U.S. at 741. This, it cannot do.

21 PolyCity cannot show that the applicant was unable to draft claims that would
22 encompass holes in addition to slots, because the specification explicitly states that
23 holes were known in the prior art. Holes therefore were not unforeseeable, nor was
24 the addition of slots tangential to the claims that issued in the '625 patent. Instead,
25 the applicant told the patent office that the claimed invention differed from the prior
26 art because it used slots where the prior art used holes. Such disclosed but
27 unclaimed subject matter is dedicated to the public. *Johnson & Johnston Assocs.,*
28 *Inc. v. R.E. Serv. Co.*, 285 F.3d 1046, 1054 (Fed. Cir. 2002) (en banc). The public,

1 including FunLine and Easton Enterprises, was entitled to rely on the clear
2 distinction between slots and holes in designing products that avoid infringement.
3 *See id.*

4 CONCLUSION

5 For the foregoing reasons, Defendants respectfully request the Court to grant
6 summary judgment that their products do not infringe the '625 patent literally, or
7 under the doctrine of equivalents.

8 DATED: August 2, 2004

9 WILLENKEN WILSON LOH & STRIS LLP

10
11 By Elizabeth I. Rogers
12 Elizabeth I. Rogers
13 Attorneys for Defendants FunLine
14 Industries, Inc. and Easton Enterprises, Inc.
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PROOF OF SERVICE

**STATE OF CALIFORNIA)
COUNTY OF LOS ANGELES)**

I am employed in the county of Los Angeles State of California. I am over the age of 18 and not a party to the within action; my business address is: APEX; 1055 W. Seventh Street, Suite 250, Los Angeles, CA 90017.

On **August 2, 2004**, I served the foregoing document(s) described as: **MEMORANDUM IN SUPPORT OF DEFENDANTS' NOTICE OF MOTION AND MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT** on interested parties in this action.

☒ By placing ☐ the original ☒ true copies thereof enclosed in sealed envelopes addressed as follows:

Angela C. Agrusa, Esq.
BAKER & HOSTETLER LLP
333 S. Grand Avenue, Suite 1800
Los Angeles, CA 90071

☐ **BY MAIL** I placed such envelope in the mail at Los Angeles, California. The envelope was mailed with postage thereon fully prepaid.

As follows: I am "readily familiar" with the firm's practice of collection and processing correspondence for mailing. Under that practice it would be deposited with U.S. Postal Service on that same day with postage thereon fully prepaid at Los Angeles, California in the ordinary course of business. I am aware that on motion of the party served, service is presumed invalid if postal cancellation date or postage meter date is more than one day after date of deposit for mailing in affidavit.

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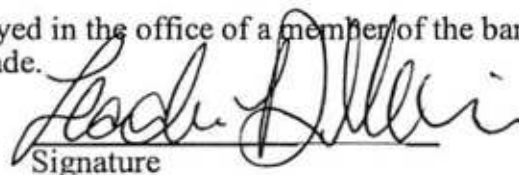
☒ **BY PERSONAL SERVICE** I delivered such envelope by hand to the offices of the addressee(s) listed above:

Executed on **August 2, 2004**, at Los Angeles, California.

☐ (State) I declare under penalty of perjury under the laws of the State of California that the above is true and correct.

☒ (Federal) I declare that I am employed in the office of a member of the bar of this court at whose direction the service was made.

LEANDRO DIMONRIVA
Type or Print Name


Signature