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

13 POLYCITY ENTERPRISE LIMITED,

14 Plaintiff,

15 v.

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

18 Defendants.

CASE NO: CV04-6899 GPS (SHx)

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

HEARING: September 7, 2004;
Courtroom 7-2d Floor; 1:30 P.M.

The Hon. George P. Schiavelli

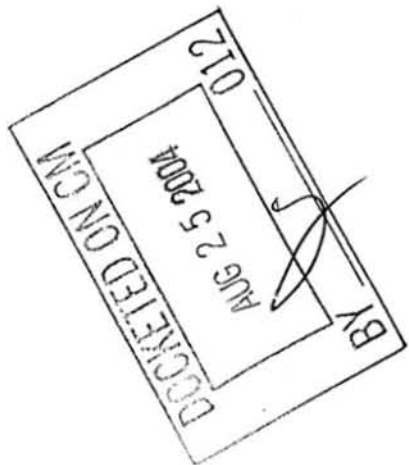


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INTRODUCTION

The invention claimed in the '625 patent made one—and only one—improvement to the mounting frames of striker wheel safety lighters found in the prior art: taking the holes through which the striker wheel was mounted to the frame in the prior art and replacing them with slots. The intrinsic evidence is controlling, and is definitive on this point. The '625 patent does not cover lighters in which the striker wheel is mounted to the frame through holes. Defendants presented uncontroverted evidence that their striker wheel safety lighters use holes, not slots.¹ Consequently, they cannot infringe the '625 patent as a matter of law.

To avoid summary judgment on this ground, PolyCity must show either that it would be proper for the Court to construe the claimed mounting slots to have the same shape as the holes found in the prior art and accused products, or PolyCity must proffer evidence that the defendants' lighters do not use holes. Any other argument is a red herring.

Although PolyCity's Memorandum in Opposition to Defendants' Motion for Summary Judgment of Noninfringement makes several arguments, none of them establishes that it would be proper for the Court to construe the claimed mounting slots to cover holes. Nor has PolyCity pointed to any evidence sufficient to raise a genuine issue of material fact indicating that Defendants' striker wheel safety lighters use a structure other than holes. That is because there is no such argument, and there is no such evidence. Summary judgment of noninfringement is therefore not merely allowable—it is the only proper result.

¹ See Declaration of George Fang a/k/a Ming Fang In Support of Defendants' Motion for Summary Judgment of Noninfringement ("Fang Decl."), ¶¶5-11; *see also* the lodged EDL001 lighter having the windshield, striker wheel, and lighter fluid removed.

ARGUMENT

I. The Issues Presented In This Motion Are Issues Of Law For The Court To Resolve Based On The Intrinsic Evidence And The Undisputed Physical Structure of Defendants' Products

Patent infringement requires each and every limitation of the asserted claims to be present in the accused device, either literally or equivalently.² Thus, there can be no infringement where a limitation required by every asserted claim is not present literally or equivalently in the accused device.³

In this case, the “mounting slots” limitation required by every claim of the ‘625 patent is not present—literally or equivalently—in Defendants’ products.⁴

² *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1323 (Fed. Cir. 2002); *Jurgens v. McKasy*, 927 F.2d 1552, 1560 (Fed. Cir. 1991).

³ *Lockheed Martin Corp. v. Space Sys./Loral, Inc.*, 324 F.3d 1308, 1321 (Fed. Cir. 2003) (“Under the all elements rule, there can be no infringement under the doctrine of equivalents if even one limitation of a claim or its equivalent is not present in the accused device.”); *Elkay Mfg. Co. v. Ebco Mfg. Co.*, 192 F.3d 973, 980 (Fed. Cir. 1999) (“If even one limitation is missing or not met as claimed, there is no literal infringement.”) (quoting *Mas-Hamilton Group v. LaGard, Inc.*, 156 F.3d 1206, 1211 (Fed. Cir. 1998)).

⁴ PolyCity’s Opposition at page 5 states that “Defendants’ motion only disputes the presence of a single element of Claim 1 of the ‘625 patent in Defendants’ safety lighters,” and concludes that therefore, for purposes of this motion, the Court must assume Defendants’ safety lighters contain all the other elements of claim 1 and all other claims. Both the premise and the conclusion are inaccurate. First, as pages 2-3 of the Memorandum in Support of Defendants’ Motion for Summary Judgment of Noninfringement (“Defendants’ Memorandum”) explains, the mounting slots limitation at issue in this motion is required by every claim of the ‘625 patent. Claims 1-6 require a lighter that includes them. Claims 7-12 require a method for manufacturing a lighter that includes them. This motion applies to all claims—it is not limited to Claim 1. Second, as explained in footnote 34 of Defendants’ Memorandum, in addition to lacking the claimed “mounting slots,” the AA-1 and SDL765 lighters do not infringe the ‘625 patent because those models lack the “unrecessed lateral portions having smooth surfaces” limitation required by every claim, and every other model lighter sold by Defendants is electric, and therefore not only fails to mount a striker wheel to the lighter frame through the claimed slots, but also lacks the “striker wheel” limitation required by every claim. See also Fang Decl. ¶¶ 10-11. Finally, because PolyCity has not moved for summary judgment of *infringement*, the presence of claim elements that are not implicated

1 Defendants' striker wheel safety lighters mount the striker wheel to the lighter
2 frame through holes instead of slots. PolyCity has not proffered any evidence to
3 the contrary.

4 Moreover, PolyCity's assertion in footnote 3 of its Opposition that the Court
5 can properly deny this motion for summary judgment of noninfringement to allow
6 additional discovery under Rule 56(f) is incorrect. This is so for two reasons.

7 First, no additional discovery is needed to resolve this motion.⁵ Defendants'
8 lighters are relatively inexpensive products sold publicly in the United States,
9 which PolyCity had a duty to assess before accusing of infringement.⁶ If evidence
10 sufficient to create a genuine issue of material fact existed—it does not—and if
11 PolyCity conducted an adequate pre-suit investigation, PolyCity was in a position
12 to do one of two things: 1) submit evidence demonstrating a genuine issue of
13 material fact regarding the structure and operation of the accused products; or 2) as
14 a meritorious Rule 56(f) motion requires, submit declarations showing that
15
16
17

18 by this motion for summary judgment of noninfringement is not presumed—rather,
19 their presence or absence is simply irrelevant. Defendants are not conceding the
20 presence of any limitations, and reserve the right to levy additional
21 noninfringement arguments in contexts other than this motion.

22 ⁵ Defendants disagree with PolyCity's description of the "Background," contained
23 at page 3 of the Opposition. Defendants will not rehash the details of the dispute
24 (which is close to resolution), but note that PolyCity's statement that it has not
25 "received any significant discovery on Defendants' products," is inaccurate.
26 Defendants produced samples of their striker wheel models, as well as the
27 schematic depicting the structure of the holes in the mounting frame of those
28 lighters, on July 15, 2004. The discovery dispute relates primarily to the treatment
of financial information.

26 ⁶ *Q-Pharma, Inc. v. Andrew Jergens Co.*, 360 F.3d 1295, 1300-01 (Fed. Cir. 2004)
27 ("In the context of patent infringement actions, we have interpreted Rule 11 to
28 require, at a minimum, that an attorney interpret the asserted patent claims and
compare the accused device with those claims before filing a claim alleging
infringement.").

1 additional discovery would uncover specific facts that would preclude summary
2 judgment.⁷ PolyCity did neither.

3 In *More U.S.A., Inc. v. Standard Register Co.*, the Federal Circuit rejected
4 arguments that the district court should have denied a motion for summary
5 judgment of noninfringement to allow additional discovery even though
6 depositions and document production had not occurred, and interrogatory answers
7 were incomplete, and explained:

8 We have reviewed Moore's declarations under Rule 56(f) and
9 conclude that the district court correctly refused to allow Moore to
10 conduct "fishing expeditions" in hopes of finding products that might
11 be infringing to oppose summary judgment. Contrary to Moore's
12 contentions, its Rule 56(f) declarations did not indicate how additional
13 discovery would enable Moore to create a genuine issue of material
14 fact regarding SRC's noninfringement of the three patents.⁸

15 The same is true here. PolyCity would not be entitled to a Rule 56(f) continuance
16 even if such a motion was properly before the Court on the merits.

17 But PolyCity has not properly placed Rule 56(f) before the Court on the
18 merits. This is a second reason why Rule 56(f) is not a basis for denying summary
19 judgment. The Ninth Circuit has explained that:

20 References in memoranda and declarations to a need for discovery do
21 not qualify as motions under Rule 56(f). Rule 56(f) requires affidavits
22 setting forth the particular facts expected from the movant's

23 ⁷ The Federal Circuit applies the law of the regional circuit in which the district
24 court sits—here, the ninth—on procedural issues that are not unique to patent law,
25 such as discovery under Rule 56(f). *Biotec Biologische Naturverpackungen v.*
26 *Biocorp, Inc.*, 249 F.3d 1341, 1355, n.4 (Fed. Cir. 2001). In the Ninth Circuit,
27 "[t]he burden is on the party seeking additional discovery to proffer sufficient facts
28 to show that the evidence sought exists, and that it would prevent summary
judgment." *Nidds v. Schindler Elevator Corp.*, 113 F.3d 912, 921 (9th Cir. 1997).
⁸ 229 F.3d 1091, 1116 (Fed. Cir. 2000) (citation and internal quotation marks
omitted).

1 discovery. Failure to comply with the requirements of Rule 56(f) is a
2 proper ground for denying discovery and proceeding to summary
3 judgment.⁹

4 In response to Defendants' motion for summary judgment, PolyCity
5 presented no such affidavits, and proffered no evidence. Consequently, there is no
6 genuine issue of material fact about the structure of Defendants' lighters—the
7 undisputed evidence demonstrates that Defendants mount the striker wheel to the
8 lighter frame through holes—holes that are indistinguishable from holes 614C in
9 Figure 2 of the prior art lighter.¹⁰ No reasonable juror could conclude otherwise.

10 PolyCity states that “[w]hether an accused device infringes a patent is an
11 ultimate issue of fact for the jury,” *see* Opposition to Defendants' Motion for
12 Summary Judgment of Noninfringement (“Opposition”), at p. 4, but that is not so
13 in this case. Here, there is no genuine issue of material fact about the structure of
14 Defendants' lighters, and therefore nothing to preclude summary judgment of
15 noninfringement. The noninfringement determination rests on the resolution of
16 one or more of the following three issues of law:

17 1) whether the “mounting slots” limitation properly can be construed to
18 cover holes;¹¹

19 2) whether the ‘625 patent relinquished coverage of the prior art holes;¹² and

20
21 ⁹ *Barona Group of the Capitan Grande Band of Mission Indians v. Am. Mgmt. &*
22 *Amusement, Inc.*, 824 F.2d 710, 716 (9th Cir. 1987) (quoting *Brae Transp., Inc. v.*
23 *Coopers & Lybrand*, 790 F.2d 1439, 1443 (9th Cir. 1985)).

24 ¹⁰ *See* Fang Decl., ¶¶ 5-11; *see also* the lodged EDL001 lighter having the
25 windshield, striker wheel, and lighter fluid removed.

26 ¹¹ If so, there can be no literal infringement as a matter of law. *General Mills, Inc.*
27 *v. Hunt-Wesson, Inc.*, 103 F.3d 978, 981 (Fed. Cir. 1997) (“General Mills has not
28 identified a material factual dispute related to the issue of infringement; the
controlling issue, therefore, regarding infringement in this case is one of law.”).

¹² If so, there can be no infringement literally or under the doctrine of equivalents
as a matter of law. *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*,
242 F.3d 1337, 1345-46 (Fed. Cir. 2001) (affirming summary judgment of no
literal infringement and no infringement under doctrine of equivalents because

1 3) whether prosecution history estoppel provides another reason why holes
2 cannot be equivalent to the claimed mounting slots.¹³

3 The Court can and should answer these questions based on the intrinsic
4 evidence—the patent including the claims and specification, and the prosecution
5 history. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582-83 (Fed.
6 Cir. 1996); *see also* Opposition, at p. 5.

7 **II. “Mounting Slots” Cannot Properly Be Construed To Cover The Holes**
8 **Used In The Prior Art And Defendants’ Products**

9 Defendants have proposed construing the term “slot” as “a narrow opening,
10 a slit or groove,” consistently with the term’s plain meaning evidenced by
11 dictionary definitions.¹⁴ Defendants continue to believe that this definition is
12 appropriate; however regardless of the particular words used to construe the
13 claimed “mounting slots,” the intrinsic evidence makes clear that they cannot
14 properly be construed to include the holes found in prior art lighters and the
15 accused products.

16 PolyCity contends that Defendants’ construction conflicts with the patent,
17 because slots 614B, the slots for receiving the nozzle actuating lever, are square.¹⁵
18 In addition to being different slots than the “mounting slots” at issue in this motion
19

20 claims could not be interpreted to cover disclaimed structure, making summary
21 judgment of no literal infringement appropriate, and because by defining a claim in
22 a way that excludes certain subject matter, the patent implicitly disclaimed the
23 excluded subject matter, barring the patentee from asserting that it was equivalent
24 under the doctrine of equivalents).

25 ¹³ Prosecution history estoppel is also a question of law for the court. *Festo Corp.*
26 *v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1368 (Fed. Cir. 2003)
27 (*en banc*) (“Questions relating to the application and scope of prosecution history
28 estoppel thus fall within the exclusive province of the court.”).

26 ¹⁴ *See* Defendants’ Memorandum, at pp. 10-11.

27 ¹⁵ Contrary to PolyCity’s statement at Opposition page 6, Defendants do not
28 contend it was an error to call element 614B slots; rather, in certain figures, slots
614B are improperly labeled as pointing to a different part of the lighter frame.
See Defendants’ Memorandum, at p. 6 n.22.

1 (through which the striker wheel is mounted), slots 614B appear rectangular, not
2 square, narrower than they are long, and therefore not inconsistent with
3 Defendants' proposed construction. Most importantly, even if slots 614B show
4 that "slots" in the lexicon of the patent can be square, they certainly don't show
5 that "slots" can be round holes.

6 PolyCity's proposed alternative construction, in which the term "slot" means
7 "an opening in a wall," *see* Opposition, at p. 7, is improper. First, PolyCity's
8 construction is inconsistent with inclusion of the mounting slots limitation in the
9 claims. If "mounting slots" could be any opening, the limitation would be
10 unnecessary. As the specification makes clear, prior art lighters already mounted
11 the striker wheel to the frame through one sort of openings (holes). If these
12 openings would do, the patentee would not have had to specify that the openings
13 used in the claimed invention were "slots."

14 PolyCity's proposed construction, under which mounting slots can be any
15 opening including holes, is also inconsistent both with the dictionary definition
16 PolyCity cites in support, which defines slot as "a suitable position or niche," and
17 with the use of the term "slot" in the '625 patent.¹⁶ As discussed in Defendants'
18 Memorandum at page 5, the slots through which the striker wheel axis is mounted
19 must be elongated enough to allow the striker wheel axis to move between two
20 positions, one of which does not allow the lighter to ignite, the other of which
21 does.¹⁷

22 _____
23 ¹⁶ It is proper to consult dictionary definitions as evidence of a terms plain meaning
24 to a person of ordinary skill in the art, but not if the dictionary definition
25 contradicts the patent. *Unitherm Food Sys., Inc. v. Swift-Ekrich, Inc.*, 375 F.3d
26 1341, 1351 (Fed. Cir. 2004).

27 ¹⁷ The creative contention at pages 12-13 of PolyCity's Opposition that the axis of
28 the striker wheel is an imaginary line through the center of the striker wheel rather
than the physical part by which the striker wheel is mounted to the frame is
absolutely inconsistent with the '625 patent. Claim 7, for example, makes clear
that the axis is the physical part through which the striker wheel is mounted to the
frame. Claim 7 claims a method for manufacturing a lighter including, *inter alia*,

1 It is not the case that any opening in the mounting frame is a “suitable
2 position or niche,” as PolyCity’s dictionary definition requires. Round holes are
3 not suitable openings because they merely allow the striker wheel to rotate.¹⁸ The
4 specification explains that:

5 Another feature of the preferred embodiment of the present invention
6 is the manner in which the striker wheel is attached to the lighter. The
7 striker wheel is mounted to the mounting frame of the lighter by *a*
8 *pair of slots which allow translation of the striker wheel toward and*
9 *away from the lighter’s flint, in addition to the regular rotation of the*
10 *striker wheel.*¹⁹

11 Slots must be long enough to allow for translation in addition to rotation.

12 Therefore, even if the Court opts to construe the “mounting slots” limitation
13 with the aid of the “suitable position or niche,” dictionary definition suggested by
14 PolyCity, the “mounting slots” cannot be construed to include round holes. The
15

16 mounting the axis of the striker wheel in the complimentary pair of mounting
17 slots.” Element 720A of Figure 5, which illustrates the present invention, also
18 shows that the axis is a physical object, not a theoretical line. *See also* Opposition
19 Ex. 1 (‘625 patent, col. 4, ll. 37-40 (“*Elements . . . 720A of striker wheel 720 each*
20 *has the same form and function as corresponding elements . . . 620A, respectively,*
21 *of striker wheel 620.*”) (emphasis added)).

22 ¹⁸ *See* Fang Decl. ¶ 9 (explaining that the holes used in Defendants’ striker wheel
23 safety lighters are identical to holes used in the prior art for many years, and allow
24 the striker wheel to rotate about its axis); *see also* the lodged EDL001 lighter
25 having the windshield, striker wheel, and lighter fluid removed.

26 ¹⁹ Opposition Ex. 1, (‘625 patent, col. 2, ll. 9-15) (emphasis added). Although this
27 statement describes a feature of the preferred embodiment, it explains that in the
28 preferred embodiment, the striker wheel is mounted through a pair of slots. Every
claim includes this “mounting slots” limitation. There is no claimed embodiment
in which the striker wheel is mounted through another kind of opening. *See Alloc,*
Inc. v. Int’l Trade Comm’n, 342 F.3d 1361, 1370 (Fed. Cir. 2003) (explaining that
the court must determine “whether the specification refers to a limitation only as a
part of less than all possible embodiments or whether the specification read as a
whole suggests that the very character of the invention requires the limitation to be
a part of every embodiment).

1 claimed slots must be longer than the holes used in prior art lighters. There is not a
2 shred of intrinsic evidence to support construing “mounting slots” to include
3 openings having the shape of the holes found in prior art lighters and Defendants’
4 striker wheel safety lighters. Doing so would also be improper in light of the
5 abstract, figures, statements in the specification, and prosecution history discussed
6 below. *See Novartis Pharmaceuticals Corp. v. Eon Labs.*, 363 F.3d 1306, 1309-11
7 (Fed. Cir. 2004) (resolving conflict between dictionary definitions based on
8 statements in specification, and concluding that the claimed “hydrosol” must
9 necessarily be prepared outside the body because the specification described it as a
10 pharmaceutical compound and made no mention of the term “hydrosol” in any
11 other context).

12 **III. Regardless Of Any Construction That Would Otherwise Be Proper, The**
13 **‘625 Patent Relinquished Coverage of Holes, Precluding Literal**
14 **Infringement And Infringement Under The Doctrine Of Equivalents As**
15 **A Matter of Law**

15 In *Scimed*, the Federal Circuit explained that:

16 Where the specification makes clear that the invention does not
17 include a particular feature, that feature is deemed to be outside the
18 reach of the claims of the patent, even though the language of the
19 claims, read without reference to the specification, might be
20 considered broad enough to encompass the feature in question.²⁰

21 That rule applies here, because the specification of the ‘625 patent makes clear that
22 the invention does not include the holes used to mount the striker wheel in prior art
23 lighters. Summary Judgment of noninfringement—both literally and under the
24 doctrine of equivalents—is therefore warranted.²¹ PolyCity’s Opposition does not
25 challenge this proposition of law, just its applicability in the present case.

26 ²⁰ 242 F.3d at 1341.

27 ²¹ The numerous Federal Circuit cases cited in pages 12-17 of Defendants’
28 Memorandum, make clear that there can be no infringement as a matter of law
where the patent clearly disclaims the structure used in the accused products. *See*,

1 The decisive question is whether the '625 patent clearly disclaimed coverage
2 of holes. The intrinsic evidence must be considered as a whole, and as a whole, it
3 makes clear that the claimed mounting slots—whatever they are—are not holes.

4 The patent draws a clear distinction between the slots through which the
5 striker wheel is mounted in the claimed invention and the holes used in prior art
6 lighters. Column 4, lines 56-59 of the '625 patent states:

7 Another feature of the preferred embodiment of the invention is found
8 in the changes to holes 614C of the prior art lighter. In the preferred
9 embodiment, these holes are replaced by slots 714E.²²

10 PolyCity would have the Court read this statement to mean that although slots
11 714E are different from holes, the claimed slots can also *be holes*. But nothing in
12 the patent states that slots can be holes, and that interpretation contravenes the
13 abstract, figures, and other statements contained in the specification. The patent
14 makes a clear and consistent distinction between the holes used in the prior art and
15 the slots used in the claimed invention. *See Bell Atl. Network Servs. v. Covad*
16 *Communications Group, Inc.*, 262 F.3d 1258, 1271-73 (Fed. Cir. 2001)
17 (interpreting “mode” limitation narrowly where the patent consistently used the
18 terms “mode” and “rate” “to refer to two separate and distinct concepts”).

19 PolyCity contends that Defendants are asking the Court to commit a cardinal
20 sin of patent law by reading a limitation from the preferred embodiment into the
21 claims. That is not so.

22 Defendants are not contending that slots must be construed to have the exact
23 same shape as that shown in 714E. Rather, Defendants contend that the “changes
24 to holes 614C of the prior art lighter,” are the one and only improvement the '625
25

26
27 *e.g. Cultor Corp. v. A.E. Staley Mfg. Co.*, 224 F.3d 1328, 1331 (Fed. Cir. 2000);
28 *see generally Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242
F.3d 1337 (Fed. Cir. 2001) (reviewing other pertinent cases).

²² Opposition Ex. 1 ('625 patent, col. 4, ll. 56-59).

1 patent made to the mounting frame of the lighter.²³ Slots cannot be an
2 improvement over holes unless they are different than holes. The “mounting slots”
3 limitation is *in every claim*—every claim replaces the prior art holes with slots.
4 Thus, there is no need to import limitations *absent* from the claims, nor does
5 Defendants’ argument require ignoring the reference to the “preferred
6 embodiment.” In contrast, construing “slots” to include holes would require
7 ignoring the abstract, figures, and other statements in the specification.

8 This case is therefore factually distinct from *Teleflex*, cited at pages 8-9 of
9 PolyCity’s opposition. *Teleflex* recognized that claims of a patent do not take on
10 their broad ordinary meaning where, as here, the patentee “characterize[ed] the
11 invention in the intrinsic record using *words or expressions of manifest exclusion*
12 *or restriction, representing a clear disavowal of claim scope.*”²⁴ The intrinsic
13 evidence in this case disavows holes from the scope of the claimed invention,
14 making this case more like the facts considered by the Federal Circuit in *Alloc, Inc.*
15 *v. International Trade Commission*,²⁵ than the facts at issue in *Teleflex*.

16 In *Alloc*, the Federal Circuit held that based on the specification’s
17 description of the invention and the figures and embodiments disclosed in the
18 patents-at-issue, every claim included a “play” limitation.²⁶ It so held even though
19 “none of the asserted patent claims recites the term play.”²⁷ Nevertheless, the
20 specification read as a whole led to the “inescapable conclusion that the claimed
21 invention must include play in every embodiment.”²⁸ This case is even stronger
22 than *Alloc* because every claim of the ‘625 patent expressly contains the “mounting
23 slots” limitation. It is similar to *Alloc*, however, in that the specification yields the
24 inescapable conclusion that the claimed slots differ from holes.

25 ²³ See also Opposition Ex. 1 (‘625 patent, col. 2, ll. 9-15).

26 ²⁴ 299 F.3d at 1327 (emphasis added).

27 ²⁵ 342 F.3d 1361 (Fed. Cir. 2003).

²⁶ *Id.* at 1370.

28 ²⁷ *Id.* at 1368.

²⁸ *Id.* at 1370.

1 From the outset, the abstract makes clear not only that “the striker wheel is
2 mounted to the lighter in slots,” but also that the invention has “an *improved* striker
3 wheel *and striker wheel mounting frame*.”²⁹ PolyCity is wrong that “there is
4 nothing in the abstract about ‘slots’ other than their existence in the mounting
5 frame.”³⁰ The abstract also makes clear that the invention improves the mounting
6 frame. To be an improvement over the holes used in the prior art lighters, slots—
7 which are the only change to the mounting frame mentioned in the patent—must
8 be different than holes.³¹

9 Likewise, the specification states:

10 FIGS. 5 through 15 illustrate the present invention. As can be seen,
11 *the difference between the present invention and the prior art lighter*
12 *is in the structure of the striker wheel and the mounting frame.* All
13 other elements of the lighters are the same and are assembled and
14 operated the same way.³²

15 The figures illustrate the present invention, not merely the preferred embodiment,
16 and they never depict the mounting slots (or any other slots) as having the round
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20 ²⁹ Opposition Ex. 1 (‘625 patent, abstract) (emphasis added).

21 ³⁰ Opposition, at p. 10. PolyCity is also wrong that 37 C.F.R. § 1.72(b) makes it
22 inappropriate for the Court to consult the abstract in determining whether the
23 patent relinquished subject matter. *Hill-Rom Co. v. Kinetic Concepts, Inc.*, 209
24 F.3d 1337, 1341, n* (Fed. Cir. 2000) (explaining that section 1.72(b) applies to
25 patent examiners in examining applications, that the rule “does not address the
26 process by which courts construe claims in infringement actions,” and noting that
27 “[w]e have frequently looked to the abstract to determine the scope of the
28 invention,” and “we are aware of no legal principle that would require us to
disregard that potentially helpful source of intrinsic evidence. . . .”) (citations
omitted).

27 ³¹ *Cf. Alloc*, 342 F.3d at 1369 (analyzing the specification’s description of “the
28 invention”).

³² Opposition Ex. 1 (‘625 patent, col. 4, ll. 30-33).

1 shape of the prior art hole 614C shown in Figure 2. The figures consistently depict
2 the mounting slots, 714E, as having an elongated shape.³³

3 PolyCity's Opposition never addresses that the only change to the mounting
4 frame described or shown in the '625 patent is the use of slots to mount the striker
5 wheel. Interpreting these slots to cover the holes used in prior art lighters would
6 improperly eviscerate the claimed improvement.

7 The prosecution history confirms that the claimed "mounting slots" differ
8 from holes. The '625 patent is a continuation-in-part of an earlier application, the
9 '214 parent application. The two claims of the '214 parent application were also
10 directed toward a striker wheel with smooth portions, but did not disclose a
11 mounting frame having elongated slots. The examiner rejected the claims as being
12 obvious over the prior art including, *inter alia*, the Bisbee patent, which shows a
13 lighter having a striker wheel with smooth portions, and which is mounted to the
14 frame in an opening that has the same shape as the striker wheel axis.³⁴ Thus,
15 improving the mounting frame of the lighter claimed in the '625 patent by using
16 slots instead of holes was not merely an improvement stated in the patent—it was
17 an improvement that allowed the patent to issue over the prior art.

18 Defendants have not argued, as PolyCity suggests, that simply by virtue of
19 being found in the prior art, a structure is immune from infringing any patent;
20 rather, Defendants contend that *this* prior art structure cannot infringe *this* patent,
21 because the patent clearly distinguishes the claimed mounting slots from the holes
22 used in the prior art and Defendants' striker wheel lighters. *See Alloc*, 342 F.3d at
23 1371 (noting that "the specification also distinguished the prior art on the basis of
24 play"); *Springs Window Fashions LP v. Novo Indus., L.P.*, 323 F.3d 989, 994 (Fed.
25 Cir. 2003) ("Given that [the distinguished prior art] Pluber reference and Novo's

26
27 ³³ *Cf. Alloc*, 342 F.3d at 1370 (noting that "all the figures and embodiments
28 disclosed in the asserted patents imply play, or, as in the case of Figure 1b,
expressly disclose play").

³⁴ *See* Defendants' Memorandum at pp. 7-8, 15-16.

1 device are nearly identical with respect to the arrangement of their cutting edges, it
2 is clear that the applicant disclaimed coverage of Novo's device."); *Ekchian v.*
3 *Home Depot, Inc.*, 104 F.3d 1229, 1304 (Fed. Cir. 1997) ("Since, by distinguishing
4 the claimed invention over the prior art, an applicant is indicating what the claims
5 do not cover, he is by implication surrendering such protection."). PolyCity
6 surrendered coverage of holes, precluding infringement literally and under the
7 doctrine of equivalents.

8 **IV. Prosecution History Estoppel Is Another Reason Why Holes Cannot Be**
9 **Equivalent To "Mounting Slots" As A Matter Of Law**

10 PolyCity recognizes that a patentee can be barred from asserting
11 infringement under the doctrine of equivalents, if prosecution history estoppel
12 applies, *see* Opposition, at p. 14 (citing *Festo Corp. v. Shoketsu Kinzoku Kogyo*
13 *Kabushiki Co.*, 535 U.S. 722, 734 (2002)), but contends that prosecution history
14 estoppel does not apply in this case because the application that issued as the '625
15 patent, and the '214 parent application "are directed to entirely different
16 inventions, and are, for practical purposes, unrelated." That is not so.

17 The invention claimed in the '214 parent application claimed an invention in
18 which the striker wheel had smooth surfaces. As PolyCity's Opposition pointed
19 out at pages 15-16, the '214 application did not purport to improve the mounting
20 frame, and did not include the mounting slots 714E of the '625 patent. The
21 examiner rejected the 2 claims applied for in the '214 application as being obvious
22 over the prior art, including Bisbee, which used holes. After the rejection, the
23 applicant allowed the '214 application to go abandoned, and filed the application
24 that issued as the '625 patent as a continuation-in-part application which, for the
25 first time, narrowed the invention by adding the "mounting slots" limitation.

26 PolyCity contends that because the mounting frame with slots was new
27 matter that was not disclosed or claimed in the '214 application, the invention is
28 different and prosecution history estoppel does not apply. Exactly the opposite is

1 true—because the Patent Office did not allow the claims to issue until the applicant
2 added the “mounting slots” limitation, prosecution history estoppel applies. In
3 *Mark I*, the Federal Circuit directly addressed this issue, holding that prosecution
4 history estoppel applied when the applicant filed a continuation-in-part application
5 adding new matter in response to a rejection:

6 Rather than respond to the rejection, Mark I again chose to file a
7 continuation-in-part application with new claims. The claims in the
8 ‘659 application were even narrower than the ‘815 claims, and
9 required that both plates be made by sequentially interposing colored
10 filters.

11 Donnelley argues that the prosecution history of the ‘241 patent shows
12 that Mark I surrendered claim coverage for a process not involving
13 sequential interposition of colored filters. We agree. The prosecution
14 history demonstrates that Mark I was unsuccessful in obtaining
15 allowance of the claims until they were narrowed to require that both
16 the first and the second printing plates be made sequentially by
17 interposing particular combinations of colored filters.³⁵

18 The same holds true here—the applicant was unsuccessful in obtaining issuance
19 until the smooth striker wheel claims were narrowed to add the “mounting slots”
20 limitation, which allowed the claims to issue over the prior art.

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24 ³⁵ *Mark I Marketing Corp. v. R.R. Donnelley & Sons Co.*, 66 F.3d 285, 291-92
25 (Fed. Cir. 1995). PolyCity contends that “[i]n *Mark I*, the Federal Circuit did not
26 hold that the prosecution history of a continuation-in-part application was always
27 relevant to a prosecution history analysis,” Opposition, at p. 18, but that is
28 precisely what *Mark I* held. See *Mark I*, 66 F.3d at 291 (explaining that because
the prosecution history must be examined as a whole, the relevant history included
the parent and grandparent applications, of which the patent-in-suit was a
continuation-in-part).

1 Prosecution history estoppel therefore applies to the “mounting slots”
2 limitation. This is not an issue of first impression.³⁶ Nor is PolyCity correct that
3 *Festo* cast doubt on the holding of *Mark I*. *Festo* dealt with the scope of the
4 estoppel that results when prosecution history estoppel applies.³⁷ *Mark I* held
5 that—regardless of the proper scope—prosecution history estoppel applies when
6 the applicant adds new matter to narrow claims in a continuation-in-part
7 application just as it would if the applicant amended the claims directly in the
8 parent application. That happened here, giving rise to a presumption that the
9 applicant surrendered coverage that cannot be recovered through the doctrine of
10 equivalents—a presumption PolyCity has not even tried to rebut.

11 Finally, PolyCity’s opposition at page 19 is incorrect that Defendants have
12 submitted no arguments or evidence about whether the accused lighters would fall
13 into the range of available equivalents. If PolyCity desired to overcome summary
14 judgment on this basis, it needed to present evidence regarding equivalence. *See*
15 *Gen. Mills, Inc.*, 103 F.3d at 985 (holding that district court did not err in granting
16 summary judgment of noninfringement under the doctrine of equivalents because
17 patentee had a duty to submit evidence tending to show equivalence, and failed to
18 proffer any material evidence designed to establish equivalence).

19 ////

20 ////

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22 ////

23 ////

24
25 ³⁶ *Mark I*, 66 F.3d at 292. Although one passage refers generally to “continuing”
26 applications, the ‘659 patent was a continuation-in-part, leaving no doubt that the
27 Federal Circuit’s holding applies to both continuations and continuations-in-part
28 where a parent application is rejected and, instead of directly responding to the
rejection, the applicant prosecutes the continuation or continuation-in-part with
new, narrower claims.

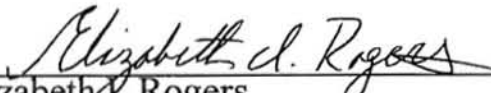
³⁷ *See* 535 U.S. at 727-78.

1 **CONCLUSION**

2 For the foregoing reasons, the '625 patent cannot cover Defendants' lighters.
3 Defendants respectfully request that the Court put an end to this expensive and
4 meritless infringement litigation by granting their motion for summary judgment.
5

6 DATED: August 23, 2004

WILLENKEN WILSON LOH & STRIS LLP

7
8 By 
9 Elizabeth A. Rogers
10 Attorneys for Defendants FunLine
11 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: 725 South Figueroa Street, Suite 1690; Los Angeles, CA 90017.

On August 23, 2004, I served the foregoing document(s) described as: **REPLY IN SUPPORT OF DEFENDANTS' MOTION FOR SUMMARY JUDGMENT OF NONINFRINGEMENT** on the interested parties in this action.

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

Angela C. Agrusa, Esq.
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Executed on **August 23, 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.

YVONNE RAMIREZ
Type or Print Name
(File in Santa Ana)


Signature

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