

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF PENNSYLVANIA**

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|-----------------------------------|---|---------------------|
| CLARENCE J. VENNE, INC. | : | CIVIL ACTION |
| | : | |
| vs. | : | |
| | : | |
| STUART ENTERTAINMENT, INC. | : | NO. 98-2943 |

ORDER AND FINDINGS OF FACT AND CONCLUSIONS OF LAW

ORDER

AND NOW, to wit, this 3rd day of January, 2000, upon consideration of Plaintiff's Motion For Claim Interpretation and Partial Summary Judgment of Infringement (Doc. No. 47, filed June 14, 1999), Defendant's Motion for a Markman Determination and for Summary Judgment of Patent Non-Infringement (Doc. No. 46, filed June 14, 1999), Plaintiff's Memorandum in Opposition to Defendant's Motion for a Markman Determination and Summary Judgment of Patent Non-Infringement and Reply Memorandum in Support of its Motion for Claim Interpretation and Partial Summary Judgment of Infringement (Doc. No. 50, filed June 21, 1999), Defendant's Response to Plaintiff's Motion For Claim Interpretation and Partial Summary Judgment of Infringement (Doc. No. 48, filed June 21, 1999), Plaintiff's Proposed Findings of Fact and Conclusions of Law (Doc. No. 54, filed July 16, 1999), and Defendant's Proposed Findings of Fact and Conclusions of Law (Doc. No. 53, filed July 16, 1999), following a Markman hearing to address issues of claim construction and oral argument on the Motions for Summary Judgment on the issue of infringement following the hearing on July 2, 1999, **IT IS ORDERED**, for the reasons set forth in the following Findings of Fact and Conclusions of Law, that Plaintiff's Motion For Claim Interpretation and Partial Summary Judgment and Defendant's Motion for a Markman Determination and for Summary Judgment of Patent Non-Infringement

are **GRANTED IN PART** and **DENIED IN PART**, as follows:

A. Plaintiff's Motion for Claim Interpretation and Defendant's Motion for a Markman Determination

1. This case involves issues of claim interpretation and infringement of U.S. Patent Number 5,713,681 (the "'681 patent") which describes a certain type of ink marker bottle designed to apply ink to bingo cards and other surfaces.

2. Plaintiff, Clarence J. Venne, Inc. ("Venne"), claims that an ink marker bottle designed and marketed by defendant, Stuart Entertainment, Inc. ("Stuart"), literally infringes Claims 1-6, 8, and 9 of the '681 patent. The parties have agreed, however, that construction of Claim 1 is determinative of the issue of infringement and thus it is the only claim the Court must construe.

3. Claim 1 of the '681 patent reads:¹

A game card ink applicator bottle, said bottle being formed of a moldable plastic material and comprising

a hollow body having a central longitudinal axis, said hollow body being arranged to hold a colored ink therein for marking a game card, said body including

a shoulder portion,

a central recessed portion, and

a base portion,

said shoulder portion being located above said central recessed portion and including a top wall having an opening therein,

said base portion being located below said central recessed portion and including a bottom wall,

¹Claim 1 has been separated into segments for purposes of clarity.

said should portion including a sidewall portion of circular periphery having a first predetermined outside diameter measured perpendicularly from said central longitudinal axis,

said central recessed portion including a smooth continuous oval sidewall having a major outside diameter and a minor outside diameter, said major outside diameter being less than approximately 2 inches (50.8 mm) and the same dimension as said first predetermined outside diameter measured perpendicularly from said central longitudinal axis, said minor outside diameter being approximately 1 inch (25.4 mm) measured perpendicularly from said central longitudinal axis,

said opening having an ink applicator mounted thereon for receipt of ink from the interior of said bottle,

said central recessed portion of said body merging with said sidewall portion of said shoulder portion at an upper flared surface, said upper flared surface being shaped to comfortably receive the thumb and index finger of one hand of a person to enable the person to hold said bottle so that said minor axis of said recessed portion of said bottle is located within the crook formed between the person's thumb and index finger to enable said bottle to be readily inverted to orient said applicator downward.

4. The parties agree that all of the elements contained in Claim 1 of the '681 patent are found in the Stuart bottle, with the exception that Stuart contends that its bottle does not contain an "upper flared surface" that is shaped "to comfortably receive the thumb and index finger of one hand of a person," as Stuart construes those terms. '681 patent, Col. 5-6.

5. The parties have agreed that the only aspect of Claim 1 of the '681 patent that requires interpretation is the reference to the term "flared". No other part of Claim 1, and no other claims, require interpretation.

6. The term "flared" as used in Claim 1 of the '681 patent is interpreted to mean "a surface that spreads outward" without any further limitation on that meaning.

B. Plaintiff's Motion for Partial Summary Judgment of Infringement and Defendant's Motion for Summary Judgment of Patent Non-Infringement

1. Plaintiff's Motion for Partial Summary Judgment is **GRANTED** with respect to the question whether the bottle designed by Stuart has an upper flared surface. The Court concludes that the Stuart bottle has an "upper flared surface".

2. Plaintiff's Motion for Partial Summary Judgment on the issue of infringement is **DENIED** with respect to whether the "upper flared surface [of the Stuart bottle is] . . . shaped to comfortably receive the thumb and index finger of one hand of a person . . ." because the submissions of the parties present a genuine issue of material fact with respect to that aspect of the case.

3. In all other respects, Plaintiff's Motion for Partial Summary Judgment of Infringement and Defendant's Motion for Summary Judgment of Patent Infringement are **DENIED**.

FINDINGS OF FACT

A. BACKGROUND

1. Plaintiff Clarence J. Venne, Inc. ("Venne") is a Pennsylvania corporation with its principal place of business at 1425 Hanford Street, Levittown, PA 19057.

2. Defendant Stuart Entertainment, Inc. ("Stuart") is a Delaware corporation with its principal place of business at 3211 Nebraska Avenue, Council Bluffs, IA 51501.

3. Both Venne and Stuart are in the business of designing, manufacturing, and selling ink marker bottles that are used to apply ink to bingo cards, and are longtime competitors in this market.

4. Venne is the owner of United States Patent No. 5,713,681 (“the ‘681 patent”), which describes a certain type of ink marker bottle designed to apply ink to bingo cards and other surfaces.

5. On June 8, 1998, Venne brought this action against Stuart for, inter alia, direct infringement of the ‘681 patent by an ink marker bottle designed by Stuart (“the Stuart bottle”). Stuart has denied infringement and has challenged the validity of the ‘681 patent.

6. Venne and Stuart agreed to bifurcate the issue of patent infringement from the issue of patent invalidity and the other issues involved in the case, and the Court approved that procedure. On June 14, 1999, Stuart moved for summary judgment of non-infringement of the ‘681 patent, and Venne moved for summary judgment of infringement.

7. A Markman hearing to address issues of claim construction and oral argument on the Motions for Summary Judgment on Stuart’s alleged infringement were held on July 2, 1999.

8. The Findings of Fact and Conclusions of Law that follow address only the issues of claim construction and Stuart’s alleged infringement, and do not address the validity of the ‘681 patent.

B. CLAIM CONSTRUCTION

1. Venne’s invention of the ‘681 patent was intended to be an improvement over existing ink marker bottles from the standpoint of economics of manufacture, ergonomics of handling, and effectiveness of labeling. ‘681 patent, Col. 1, lines 7-20

2. Claim 1 is the only independent claim of the ‘681 patent. Claims 2 through 15 are all dependant upon Claim 1.

3. While Venne claims that the Stuart bottle literally infringes Claims 1-6, 8, and 9 of the

'681 patent, the parties have agreed that the construction of Claim 1 is determinative of the issue of infringement and thus it is the only claim the Court must construe.

4. Claim 1 of the '681 patent reads:¹

A game card ink applicator bottle, said bottle being formed of a moldable plastic material and comprising

a hollow body having a central longitudinal axis, said hollow body being arranged to hold a colored ink therein for marking a game card, said body including

a shoulder portion,

a central recessed portion, and

a base portion,

said shoulder portion being located above said central recessed portion and including a top wall having an opening therein,

said base portion being located below said central recessed portion and including a bottom wall,

said should portion including a sidewall portion of circular periphery having a first predetermined outside diameter measured perpendicularly from said central longitudinal axis,

said central recessed portion including a smooth continuous oval sidewall having a major outside diameter and a minor outside diameter, said major outside diameter being less than approximately 2 inches (50.8 mm) and the same dimension as said first predetermined outside diameter measured perpendicularly from said central longitudinal axis, said minor outside diameter being approximately 1 inch (25.4 mm) measured perpendicularly from said central longitudinal axis,

said opening having an ink applicator mounted thereon for receipt of ink from the interior of said bottle,

said central recessed portion of said body merging with said sidewall portion of

¹Claim 1 has been separated into segments for purposes of clarity.

said shoulder portion at an upper flared surface, said upper flared surface being shaped to comfortably receive the thumb and index finger of one hand of a person to enable the person to hold said bottle so that said minor axis of said recessed portion of said bottle is located within the crook formed between the person's thumb and index finger to enable said bottle to be readily inverted to orient said applicator downward.

5. The part of Claim 1 of the '681 patent central to Venne's claim of infringement provides, inter alia, that "said recessed portion of said body merging with said sidewall portion of said shoulder portion at an upper flared surface, said upper flared surface being shaped to comfortably receive the thumb and index finger of one hand of a person to enable the person to hold said bottle so that said minor axis of said recessed portion of said bottle is located within the crook formed between the person's thumb and index finger to enable said bottle to be readily inverted to orient said applicator downward." '681 patent, Col. 5-6

6. The parties agree that all of the elements contained in Claim 1 of the '681 patent are found in the Stuart bottle, with the exception that Stuart contends that its bottle does not contain an "upper flared surface," that is shaped "to comfortably receive the thumb and index finger of one hand of a person," as Stuart construes those terms.

7. The parties agree that the inventors did not intend to give any terms in the '681 patent any particular meaning outside their common usage.

8. The Stuart bottle has a finger support which extends transversely from the applying end of the bottle and terminates at the central recessed portion of the bottle. See Doc. No. 50, Exhibit C.

9. Venne contends that the Stuart bottle's finger support flares as described in the '681 patent. Dictionary definitions of the term "flare" offered in evidence by Venne include: "to open

or spread outward flare at the bottom,” in *WWWebster Dictionary* (visited June 7, 1999) <wysiwyg://7/http://www.m-w.com/cgi-bin/dictionary> (Memorandum of Law in Support of Plaintiff’s Motion for Claim Interpretation and Partial Summary Judgment of Infringement, Exhibit G); “To open or spread outwards; to project beyond the perpendicular; as, the sides of a bowl flare; the bows of a ship flare,” in *Hypertext Webster Gateway* (citing *Webster’s Revised Unabridged Dictionary* © 1913) (visited June 7, 1999) <http://work.ucsd.edu:5141/cgi-bin/...webster?isindex=flare&method=exact> (Memorandum of Law in Support of Plaintiff’s Motion for Claim Interpretation and Partial Summary Judgment of Infringement, Exhibit H).

10. Stuart contends that the finger support on its bottle does not “flare” because “flare” means to open or spread outward, in the shape of the bell of a trumpet or bell-bottomed pants and its bottle does not do so. Dictionary definitions of the term "flare" offered in evidence by Stuart include: “gradual widening, esp. of a skirt or trousers,” in *Oxford Essential Dictionary, American Edition* © 1998; “to spread gradually outward, as the end of a trumpet, the bottom of a wide skirt, or the sides of a ship,” in *Random House Unabridged Dictionary, Second Edition* © 1993; “To expand or open outward in shape, as a skirt,” in *The American Heritage Dictionary, Third Edition* © 1994.

11. The Court notes the following additional definitions of the word "flare": “To expand or open outward in shape, as a skirt,” in *Webster’s II New Riverside Dictionary* © 1984; “A gradual swell or bulging outward (orig. In *Shipbuilding*); a gradual widening or spreading outward (esp. of a skirt etc.); that part which widens or spreads,” in *The New Shorter Oxford English Dictionary, Fourth Edition* © 1993.

12. Because there are no special conditions identified in the specification, claims or

prosecution history, and the parties agree that the inventors did not intend to give any terms in the '681 patent any particular meaning outside their common usage, the Court concludes that the term "flared" must be given its ordinary meaning.

13. The Court finds that Stuart's definition of "flared" as "to open or spread outward, like the bell of a trumpet or bell-bottomed pants", is excessively narrow. Numerous dictionary definitions set forth a broader definition of "flare," most commonly defining the word as "to expand or open outward in shape" or a close variant of that phrase. See, e.g., Webster's II New Riverside University Dictionary, © 1984.

14. The specification of the '681 patent does not limit the configuration of the upper flared surface to any one specific configuration. Because there is no limitation in the specification of the shape of the flare, the Court finds that the term "flared surface" as used in Claim 1 of the '681 patent means "a surface that spreads outward" without any further limitation on that meaning.

C. PATENT INFRINGEMENT

1. The Court has examined the structure of the Stuart bottle and has determined that the upper finger support which extends transversely from the applying end of the bottle and terminates at the central recessed portion of the bottle does "flare" within the meaning of Claim 1 of the '681 patent and thus that the Stuart bottle has an "upper flared surface".

2. The specification of the '681 patent states, inter alia, that ease of holding and use were central to the design of the Venne bottle, '681 patent, Col. 1, lines 31-32, and that the ergonomic construction would facilitate holding the bottle like a pencil or pen, '681 patent, Col. 2, lines 60-65; Col. 3, lines 64-67.

3. Claim 1 of the '681 patent states that the upper flared surface is shaped to "comfortably receive" the thumb and index finger of the user.

4. At the Markman hearing, Stuart argued that the Stuart bottle is meant to be held in the crook of the user's hand formed by the user's thumb and index finger, but that it is not designed to comfortably receive the thumb and index finger as described in the '681 patent; rather, Stuart contends that its bottle is best used, as demonstrated in an advertisement received in evidence, with the index finger extended along the spine of the bottle, with the thumb and curved middle finger resting against the finger supports.

5. In response, Venne contends that Stuart's instructions on how to use the Stuart bottle are irrelevant because the Stuart bottle is still capable of being held in the manner set forth in Claim 1 of the '681 patent. Venne argues that because the Stuart bottle can be held comfortably in the same manner as the '681 patent specifies, and it contains an "upper flared surface" which is shaped to "comfortably receive" the thumb and index finger, it literally infringes Claim 1 of the '681 patent.

6. Because there are no special conditions identified in the specification, claims or prosecution history, and the parties agree that the inventors did not intend to give any terms in the '681 patent any particular meaning outside their common usage, the Court concludes that all terms relating to the requirement that the upper flared surface of the bottle "comfortably receive" the thumb and index finger must be given their ordinary meaning.

7. Because ergonomics, in this case the question of whether the upper flared portion of the Stuart bottle is shaped to "comfortably receive" the thumb and forefinger in a particular way, is a technical question, the Court will consider evidence in the form of the affidavit of David A.

Rose, CPE, CIE, Stuart's ergonomics expert, and the report of patent attorney William H. Murray, Venne's expert on patent infringement.

8. Mr. Rose opined that the Stuart bottle is not designed to comfortably receive the thumb and index finger when the bottle is located within the crook formed between the person's thumb and index finger; rather, he stated: "The Stuart bottle, by virtue of the transverse convex curved area connecting the shoulder and recessed mid portion of the bottle, provides a distinctly different grip geometry than the Venne bottle. The orientation of the curved region eliminates the need for a pinch grip . . . [t]he design of the Stuart bottle does not allow for it to be effectively held using a pinch grip in a manner similar to that used when holding a pen or pencil."

Declaration of David A. Rose, at 5-6.

9. Mr. Murray opined that "[t]he upper flared surface [of the Stuart bottle] extends outwardly from the recessed portion and is shaped to comfortably receive the thumb and index finger of one hand of a person . . .". Report of William H. Murray, at 12.

10. The Court finds, based on its examination of the Stuart and Venne bottles, that both bottles can be held and manipulated in a variety of ways of greater and lesser degrees of comfort and ergonomic efficiency.

11. The Court has examined the structure of the Stuart bottle and the evidence on the question whether the upper flared surface of that bottle which it finds to be flared is "shaped to comfortably receive the thumb and index finger of one hand of a person to enable the person to hold said bottle so that said minor axis of said recessed portion of said bottle is located within the crook formed between the person's thumb and index finger." The Court concludes that there is a genuine issue of material fact as to whether the upper flared surface of the Stuart bottle is

“shaped to comfortably receive the thumb and index finger of one hand of a person to enable the person to hold said bottle so that said minor axis of said recessed portion of said bottle is located within the crook formed between the person’s thumb and index finger.” ‘681 patent, Col. 5-6.

CONCLUSIONS OF LAW

A. JURISDICTION

1. The Court has jurisdiction over the parties pursuant to 28 U.S.C. §§ 1121, 1332(a) and 1338(a).

B. CLAIM CONSTRUCTION

1. Venne has moved this Court pursuant to Markman v. Westview Instruments, 116 S.Ct 1384 (1996), for a determination of the meaning and scope of the patent claims asserted to be infringed.

2. Markman requires the Court to engage in claim construction, that is, the Court must determine the meaning and scope of the claims contained in the patent allegedly infringed. Claim construction is solely an issue of law for the Court to decide.

3. The primary focus of claim construction is on the claim language itself. Where words of a claim require interpretation, the court should look first to intrinsic evidence, which includes the language of the patent claims, the specification, and the prosecution history of the patent. Markman, 52 F.3d at 979. In addition, dictionaries, although strictly extrinsic evidence, may be consulted and relied upon “so long as the dictionary definition does not contradict any definition found in . . . the patent documents.” Vitronics Corp. v. Conceptoronic, Inc., 90 F.3d 1576, 1584 n.6 (Fed. Cir. 1996).

4. In claim construction the Court may consider extrinsic evidence, such as expert

testimony, inventor testimony, technical treatises, and articles, but must do so only “if needed to assist in determining the meaning or scope of technical terms in the claims.” Id at 1583. (quoting Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1216 (Fed. Cir. 1995))

5. The Court concludes that the term "flared" as used in Claim 1 of the '681 patent means "a surface that spreads outward" without any further limitation on that meaning.

C. PATENT INFRINGEMENT

1. In deciding the Motions for Summary Judgment, the Court must compare the properly construed patent claims to the actual device which is accused of infringing the patent. The existence of literal infringement is determined by a word-by-word reading of the patent claims onto the accused product. Laitram Corp. v. Rexnord, Inc., 939 F.2d 1533, 1535 (Fed. Cir. 1991). The failure to meet a single claim limitation is sufficient to negate literal infringement of the claim. Id.

2. If the court determines that there is no genuine issue of material fact as to infringement, that is, if each and every claim in the patent clearly either does or does not read on to the accused device, then summary judgment is appropriate. Lantech, Inc. v. Keip Machine Co., 32 F.3d 542, 547 (Fed. Cir. 1994). Literal infringement requires that every limitation of the applicable claim be present in the accused product. See Southwall Technologies, Inc. v. Cardinal IG Co., 15 F.3d 1570 (Fed. Cir. 1995). If there is a genuine issue of material fact as to whether the offending device infringes one or more claims of the patent, such infringement is a question for the jury. Lantech, 32 F.3d at 547.

3. The Court concludes that the upper finger support of the Stuart bottle which extends transversely from the applying end of the bottle and terminates at the central recessed portion

of the bottle does "flare" within the meaning of Claim 1 of the '681 patent.

4. There is a genuine issue of material fact as to whether the upper flared portion of the Stuart bottle is "shaped to comfortably receive the thumb and index finger of one hand of a person to enable the person to hold said bottle so that said minor axis of said recessed portion of said bottle is located within the crook formed between the person's thumb and index finger."

'681 patent, Col. 5-6.

BY THE COURT:

JAN E. DUBOIS, J.