

Keywords: Claim construction; prosecution history; willful infringement; doctrine of prosecution disclaimer.

General: Limitation in claim directed to remote-controlled search light, which recites “horizontal drive means for rotating said lamp unit in a horizontal direction,” is not limited to device capable of rotating horizontally through 360 degrees, despite written description’s disclosure of assembly capable of such rotation, since nothing in written description requires limiting function to rotation through any particular angle.

Golight Inc. v. Wal-Mart Stores Inc.
69 U.S.P.Q.2d 1481 (Fed. Cir.)
Decided January 20, 2004

I. Facts

Inventors Gerald Gohl and Al Gebhardt were granted two patents on a remote-controller portable search light. The first patent, U.S. Patent 5,490,046, which is herein referenced as “the ‘046 patent,” is directed to a portable search light that could be mounted on a vehicle and controlled inside or outside the vehicle. The second patent, U.S. Patents 5,673,989, which is herein referenced as “the ‘989 patent,” is directed to a wireless, remote-controlled portable search light, which is sold as the Radio Ray.

In 1997, Wal-Mart began to sell a portable wireless remote-controlled search light through Sam’s Club. This search light was identical to the Radio Ray in all aspects, except for the inclusion of a stop piece that limited the rotation to between 340° and 351°. Accordingly, Golight sent Wal-Mart a cease and desist letter on December 11, 1998, regarding the belief that the search light sold by Wal-Mart infringed the ‘989 patent. Then, Golight filed a patent infringement suit on January 14, 2000, against Wal-Mart and North Arkansas Wholesale Co. After a three day bench trial, the district court held that Wal-Mart infringed claim 11 of the ‘989 patent by importing the infringing product, that the claim 11 of the ‘989 patent is valid, that the infringement of claim 11 by Wal-Mart is willful, and that Golight was entitled to damages of \$464,280 plus attorney fees. Wal-Mart appeals this holding. Specifically, Wal-Mart challenges the construction of claim 11 of the ‘989 patent. However, if the construction of claim 11 is upheld, Wal-Mart concedes infringement, but argues that claim 11 is invalid because it is obvious. Finally, Wal-Mart argues that the court abused discretion in finding willful infringement.

II. Issues

- A. Is the construction by the district court of claim 11 of the ‘989 patent proper?
- B. Is the claim 11 of the ‘989 patent invalid?
- C. Is the holding of willful infringement proper?

III. Discussion

- A. Yes. The only dispute regarding the construction of claim 11 of the ‘989 patent relates to the limitation that the search light being capable of 360° rotation. Wal-Mart argued that the claim limitation is implicitly required by the claim language for three reasons. First, Wal-Mart argued that the written description of the ‘989 patent requires that claim 11 be construed to include a limitation of rotation through 360°. Wal-Mart asserted that the claim cannot exceed

the specification, which describes that the search light rotates through 360°. However, in construing claims, the analytical focus must begin and remain centered on the language of the claims themselves. *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1331 (Fed. Cir. 2001). The written description may, however, restrict the scope of the claims if “the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope.” *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002). In the written description of the ‘989 patent, no clear definition or disavowal of claim scope is present. The court held that the rotation of 360° is one of many advantages that does not have to be incorporated into the claim. Further, the court held that the single embodiment of the ‘989 patent is not determinative of the scope of the claimed term and does not limit the claim term to a narrower meaning. As a result, the court held that claim 11 of the ‘989 patent does not include the limitation that the search light being capable of 360° rotation

Secondly, Wal-Mart argued that in the prosecution history, the patentees provided a special meaning for the term “rotating” and disavowed certain meanings relating to the rotation under the doctrine of prosecution disclaimer. Specifically, Wal-Mart relied upon specific assertions in the prosecution history that the rotation is not pivotal and that the claims in issue have been amended to include the 360° rotation limitation. While the court agreed that the Wal-Mart interpretation is reasonable, the court held that the assertions are open to multiple reasonable interpretations. For instance, the assertions in the prosecution history may only apply to the other claims that specifically include the cited limitation. As a result, the court held that the prosecution history does not provide a clear and unmistakable departure from the ordinary meaning of the term.

Thirdly, Wal-Mart argued that the means plus function language requires the claim language be limited to 360° rotation. To determine the scope of the means plus function claim, the court first construed claim 11 to not include the limitation of being capable of 360° rotation. Then, the court looked to the specification to identify the corresponding structure. The court held that structure did not limit the claim to being capable of 360° rotation. Accordingly, the court found that the specification did not require this limitation to be incorporated into the claim language. As such, the construction of claim 11 by the district court was upheld.

- B. No. Wal-Mart argued that claim 11 is invalid because of the court’s claim construction. Specifically, Wal-Mart argued that claim 11 is rendered obvious if it does not include the limitation of the being capable of 360° rotation or a shoe limitation. Wal-Mart’s arguments are based upon the rejections in the prosecution history, which may be divided into prior art rejections and the judicially created doctrine of obviousness-type double patenting. To begin, with regard to the prior art rejections, Wal-Mart did not specifically cite a combination of references that rendered claim 11 obvious, but inferred that the prior art rendered the claim 11 obvious. In fact, Wal-Mart did not present any evidence at trial on this point. Accordingly, the court has to rely on the prosecution history to determine this point. In the prosecution history, the Examiner discontinued a particular rejection, which combined the cited references because of a lack of motivation to combine the references. The prosecution history along with the lack of evidence is a critical defect of the Wal-Mart argument.

With regard to the judicially created doctrine of obviousness-type double patenting rejections, Wal-Mart asserted that claim 11 of the ‘989 patent is not distinct from the claims of the ‘046 patent. However, Wal-Mart ignores the recitations that relate to the wireless, remote-controlled features of claim 11, which are not in the ‘046 patent. Further, in the prosecution history, the Examiner subsequently acknowledged that claim 11 was allowable without the terminal disclaimer. Accordingly, the court upheld the finding of the district court that claim 11 is valid.

- C. Yes. The court upheld the willful infringement because Wal-Mart did not take any action after it received the cease and desist letter. Wal-Mart asserted that it received assurances from the manufacturer that the products were not infringing and that no one in Wal-Mart knew about the '989 patent until the lawsuit. However, no evidence was admitted in trial that supported Wal-Mart's assertions that the product did not infringe. Further, Wal-Mart continued to sell the remaining stock after the receipt of the letter. As such, the district court was upheld on willful infringement.

Dissent:

Judge Archer dissented in-part, arguing that the claim limitation that the search light is capable of 360° rotation should be included in the construction of claim 11. To support this position, Judge Archer relied upon the special meaning of the term "rotating," which is discussed in the prosecution history, as noted above. Specifically, in the response to the rejection of the Lipman reference, the patentees asserted that Lipman would "not be rotatable through 360° or greater as achieved by the applicants' invention." Judge Archer held that this language in response to the rejection provides a special meaning to the term "rotate." Further, Judge Archer stated that the majority did not address the applicants' characterization of the invention in the prosecution history. Accordingly, in the dissent's view, the claim construction should include the limitation that the search light is capable of 360° rotation, which would result in non-infringement by Wal-Mart.