

Keywords: claim construction; infringement; doctrine of equivalents; prosecution history estoppel; intrinsic evidence; extrinsic evidence

General: The term “clear” was construed to mean “transparent” or “having the property of transmitting light without appreciable scattering,” and was distinguished from “translucent.” The construction was supported by the written description, the prosecution history, and dictionary definitions.

Terlep v. Brinkmann Corp.
76 U.S.P.Q.2d 1053 (Fed. Cir. 2005)
Decided August 16, 2005

I. Facts

Terlep is the inventor and owner of U.S. Patent No. 5,594,433 (“the ‘433 patent”), which is generally directed to omni-directional LED lamps. The disclosed lamps include a spherical or semi-spherical reflector which is positioned with respect to an LED such that the light emitted by the LED is reflected over a full range of 360 degrees. Among other things, claim 1 recites a first LED, “a first *semi-spherical* reflector ... mounted *above* the first LED...; and a first *clear* plastic tubular holder for tightly holding the first semi-spherical reflector oriented *directly above* the first LED” (emphasis added).

In November 1997, shortly after the ‘433 patent issued, Terlep filed suit against Brinkmann Corp. in the U.S. District Court for the Western District of Arkansas. The suit alleged that solar-powered landscaping lamps produced by Brinkmann infringed certain claims of the ‘433 patent, including independent claim 1. The accused products have an LED and a convex reflector that is positioned below the LED during operation. Additionally, the accused products include a ribbed holder to position the reflector with respect to the LED.

Brinkmann denied infringement and filed a counterclaim alleging invalidity of the ‘433 patent. During claim construction, among other terms, the district court construed “clear” as meaning “transparent” or “having the property of transmitting light without appreciable scattering so that bodies lying beyond are seen clearly.” Based at least in part on the construction of the term “clear,” the district court granted summary judgment of noninfringement to Brinkmann. Terlep appealed to the Federal Circuit in April 2004, but this appeal was premature as Brinkmann’s invalidity counterclaim had not been finally decided by the lower court. Following a stipulation by the parties, the district court dismissed the remaining invalidity counterclaim and, in March 2005, Terlep moved for reinstatement of the appeal.

II. Issues

- A. Was the claim construction of the term “clear” by the district court correct?
- B. Was the district court correct in granting summary judgment of noninfringement under the doctrine of equivalents to Brinkmann?

III. Discussion

- A. Yes. Terlep argued that the term “clear” should be broadly construed as simply permitting the passage of light, while Brinkmann, for obvious reasons, supported the district court’s interpretation of this term. After citing *Phillips* and reaffirming the importance of intrinsic evidence in claim interpretation, the panel referred to several passages of the specification that provide guidance for construing the term “clear.” Particularly, the panel noted that the background section of the ‘433 patent discusses previous attempts by others in the art to diffuse the light emitted from an LED to increase the viewing angle. The panel also compared this disclosure in the background section with the summary of the invention section, which states that an object of the invention is to provide “an omni-directional LED lamp that does not use [a] diffusion lens over the LEDs.” In its decision, the panel stated that these two statements suggest an implicit distinction between lenses or holders that diffuse light and those that transmit light without obstruction, which supported the construction provided by the district court.

Terlep further argued that the written description is also consistent with a “translucent” holder, relying upon a portion of the specification dealing with an alternative embodiment including a lens cover that diffuses light. The panel quickly dismissed this argument, however, noting that the lens cover of the alternative embodiment is not the same structure as the recited “clear plastic tubular holder” of the first embodiment. The panel also noted that Terlep had added the “clear plastic tubular holder” element during prosecution to distinguish over prior art that disclosed sandblasting the edges of an LED to cause diffusion of the light emitted therefrom. The panel found that, because the limitation was added to distinguish the claimed invention from the prior art, the prosecution history also supported the exclusion of plastic holders that are translucent or otherwise diffuse light from an LED.

Finally, the panel addressed the use of extrinsic evidence by the district court in construing the term “clear.” The panel noted that one of the dictionaries relied upon lists “transparent” and “translucent” as synonyms, but provides an express distinction between these two terms regarding the extent to which vision is obstructed. Interestingly, in its opinion, the panel explicitly stated that the district court had “attached appropriate weight” to the dictionary definitions, as admonished by *Phillips*, in construing the claims. For these reasons, the panel affirmed the construction of the term “clear” by the district court.

- B. Yes. As will be appreciated, under *Festo*, a narrowing amendment to a claim gives rise to a rebuttable presumption that a patentee surrendered the subject matter between the original claim and the amended claim. This presumption may be overcome by showing: 1) that the alleged equivalent was unforeseeable at the time of the amendment, 2) that the alleged equivalent was tangential to the purpose of the amendment, or 3) that the patentee could not be reasonably expected to have described the insubstantial substitute in question. Terlep argued that the addition of the term “clear” was for the mere purpose of describing the material of the recited plastic holder, and that the addition of this term is not directly relevant to the accused equivalent. The panel summarily dismissed this argument, stating that the amendment was not tangential to the accused equivalent because Terlep had argued patentability of claim 1 based on the diffusion characteristics of the prior art devices and the absence of such diffusion in the claimed “clear plastic tubular holder.” For this reason, the panel affirmed the grant of summary judgment of noninfringement to Brinkmann.