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**IN THE UNITED STATES DISTRICT COURT
DISTRICT OF UTAH**

Really Right Stuff, LLC

Plaintiff,

v.

Field Optics Research, Inc.

Defendant.

**DEFENDANT'S RESPONSE TO
PLAINTIFF'S CROSS-MOTION FOR
CLAIM CONSTRUCTION**

CASE NO: 2:20-cv-00345-DBB

Judge: David B. Barlow

Magistrate Judge: Dustin B. Pead

Pursuant to Local Patent Rule 4.2, Defendant Field Optics Research, Inc. (“Field Optics Research”) enters this Response to Plaintiff’s Cross-Motion for Claim Construction.

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I. BACKGROUND

The Plaintiff has asserted three patents against the Defendant:

- a. U.S. Patent No. 6,773,172 (the ‘172 patent) entitled “Quick-Release Clamp for Photographic Equipment”, hereinafter “the ‘172 patent”;
- b. U.S. Patent No. 10,612,718 (the ‘718 patent) entitled “Dual Clamping Device”, hereinafter “the ‘718 patent”; and
- c. U.S. Patent No. 10,585,337 (the ‘337 patent) entitled “Panoramic Camera Mount”, hereinafter “the ‘337 patent”.

Cross-motions for claim construction were filed relating to two terms of the ‘337 patent and five terms of the ‘172 patent. The Defendant’s claim construction positions are supported by clear intrinsic evidence from the patent specification and prosecution history, whereas the Plaintiff merely makes conclusory statements, such as the specification or prosecution history provide no guidance on claim construction, or evidence of clear disavowal. The Defendant reiterates below the multiple instances within the specification and prosecution history which supports the Defendant’s claim construction position.

Regarding the ‘337 patent, the Plaintiff appears to argue the recited “not releasable” element is functional with sufficient structural support recited in the claim to avoid a construction under 35 USC § 112, sixth paragraph. However, the structural elements identified by the Plaintiff have nothing to do with performing the “not releasable” function. The Plaintiff then appears to argue the “not releasable” element is not functional and therefore not governed by 35 USC § 112, sixth paragraph. However as explained below, the term “not releasable” is functional as a matter

of law. In addition, the Defendant demonstrates below how construing “not releasable” as not functional would render every functional claim element, through a simple trick of claim drafting, not governed by 35 USC § 112, sixth paragraph. This is an illogical result not intended by Congress or the Courts that, after decades of adjudication, have time and again rejected the attempt to elevate form over substance.

II. LEGAL STANDARD

Claim terms are generally construed under the “ordinary meaning” standard:

“The ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application. . . . The inquiry into how a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation. . . . Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005).

There are two exceptions to the rule that claim terms are construed according to their ordinary meaning: (1) when a patentee sets out a definition and acts as his own lexicographer, or (2) when the patentee disavows the full scope of the claim term either in the specification or during prosecution, either impliedly or explicitly. *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1365 (Fed. Cir. 2014). For prosecution history disavowal to attach, a patentee must clearly and unmistakably disavow the full scope of a claim term. *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008). A patentee could do so, for example, by clearly

characterizing the invention in a way to try to overcome rejections based on prior art.” *Computer Docking Station*, 519 F.3d at 1374.

“When the parties raise an actual dispute regarding the proper *scope* of these claims, the court, not the jury, must resolve that dispute. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (holding that claim construction is a matter of law). *O2 Micro Intern. v. Beyond Innov*, 521 F.3d 1351, 1360 (Fed. Cir. 2008) (emphasis added). When a claim is construed as ordinary meaning, the Federal Circuit in *Phillips* emphasized “the proper judicial construction of a claim and its terms is from the viewpoint of a person of ordinary skill in the field of the invention; the court must determine how such a person would understand the claim in the context of the particular technology and the description in the specification, with due reference to the prosecution history.” To that end, the court in *Phillips* at 1313 reiterated “[T]he person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.” Quoting *On Demand Machine v. Ingram Industries*, 442 F.3d 1331, 1337 (Fed. Cir. 2006). Further, in *Phillips* at 1315: “The claims, of course, do not stand alone. Rather, they are part of ‘a fully integrated written instrument,’ consisting principally of a specification that concludes with the claims... For that reason, claims ‘must be read in view of the specification, of which they are a part.’” (citing *Markman v. Westview Instruments*, 52 F.3d 967, 978 (Fed. Cir. 1995) (internal citations omitted)). Also, the Court further reiterates: “As we stated in *Vitronics*, the specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” *Phillips* at 1315, citing *Vitronics Corp. v. Conceptronic* 90 F.3d 1956, 1582 (Fed. Cir. 1996). “The construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be,

in the end, the correct construction.” *Phillips* at 1316. From this, concludes the Court: “It is therefore entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims.” *Phillips* at 1317.

The claims may also be construed using intrinsic evidence based on the interpretive prosecution history: “[T]he prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005).

III. CONSTRUCTION OF CLAIM TERMS

One Skilled in the Art

The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. *In re GPAC, Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995). The "hypothetical 'person having ordinary skill in the art' to which the claimed subject matter pertains would, of necessity have the capability of understanding the scientific and engineering principles applicable to the pertinent art." *Ex parte Hiyamizu*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Inter. 1988). In the present case, a person having ordinary skill in the art would have had, through education or practical experience, at least the equivalent of a bachelor's degree in mechanical engineering, or a related field, and would have understood the basics of designing and manufacturing clamping devices (e.g., screws, levers, and other related hardware). This characterization is supported by the prior art of record which in this case reflects the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

US 10,585,337

Patent no. Claim no.	Term	Plaintiff's Definition	Defendant's definition
10,585,337 – Claim 1(d) and 25(d)	“said first clamp member and said second clamp member not releasable from said base by movement of said second member”	Plain meaning	Construed under 35 USC § 112, sixth paragraph, “Means-plus-function”: Function: retaining the first clamp member and the second clamp member to the base. Structure in Spec: the plug 22 and retaining member 24 shown in FIG. 1 of ‘337 patent. See also col. 2, lines 61-64, of ‘337 patent.

The text of claims 1 and 25 of the ‘337 patent (emphasis added):

1. An integrated panoramic device comprising:

(a) a base having a lower surface suitable for supporting said base;

(b) a first clamp member secured for rotation to said base and comprising a first clamp surface rotatable about a single axis substantially normal to said lower surface, said panoramic device being free from and incapable of said first clamp surface being rotatable about an axis other than said single axis substantially normal to said lower surface;

(c) a second clamp member including a second clamp surface slidably secured to said first clamp member and movable as a result of movement of a first member to approach said second clamp surface relative to said first clamp surface to clamp an article therebetween and movable as a result of movement of said first member to separate said second clamp surface relative to said first clamp surface to release an article clamped between said first clamp surface and said second clamp surface;

(d) a second member as a result of movement to selectively impede relative rotation of said first clamp member and said base, **said first clamp member and said second clamp member not releasable from said base by movement of said second member**, said first clamp member rotatable through 360 degrees with respect to said base; and

(e) wherein said first member is engaged with said first clamp member, wherein said first member passes through a portion of said second clamp member.

25. An integrated panoramic device comprising:

(a) a base having a lower surface suitable for supporting said base;

- (b) a first clamp member secured for rotation to said base and comprising a first clamp surface rotatable about a single axis substantially normal to said lower surface, said panoramic device being free from and incapable of said first clamp surface being rotatable about an axis other than said single axis substantially normal to said lower surface;
- (c) a second clamp member including a second clamp surface slidably secured to said first clamp member and movable as a result of movement of a first member to approach said second clamp surface relative to said first clamp surface to clamp an article therebetween and movable as a result of movement of said first member to separate said second clamp surface relative to said first clamp surface to release an article clamped between said first clamp surface and said second clamp surface;
- (d) a second member as a result of movement to selectively impede relative rotation of said first clamp member and said base, **said first clamp member and said second clamp member not releasable from said base by movement of said second member**, said first clamp member rotatable through 360 degrees with respect to said base;
- (e) wherein said second member is engaged with said base and wherein said second member includes a knob attached thereto.

“Congress struck a balance in allowing patentees to express a claim limitation by reciting a function to be performed rather than by reciting structure for performing that function, while placing specific constraints on how such a limitation is to be construed, namely, by restricting the scope of coverage to only the structure, materials, or acts described in the specification as corresponding to the claimed function and equivalents thereof.” *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1347 (Fed. Cir. 2015).

The Plaintiff asserts the claims recite sufficient structure to avoid a construction under 35 USC § 112, sixth paragraph. In particular, the Plaintiff points to the following structural elements in the claim: the “base,” “first clamp member,” “second clamp member,” and the “second member” (Dkt. 112, p. 11). However, these structural elements have nothing to do with performing the “not releasable” function (i.e., the function of retaining the clamp body to the base). The structural elements for performing the “not releasable” function are clearly described in the specification of the ‘337 patent at col. 2, lines 61-64 (Joint Appendix p. 119): “A retaining member 24 is secured

to the plug 22 in such a manner to maintain the panning base and the body 12 together with the desired ability to freely rotate.” Further, the Plaintiff admitted that these structural elements (retaining member 24 and plug 22) are what perform the “not releasable” function in their initial Responsive Claim Construction Brief (Dkt. 69, p. 9).

The retaining member 24 and plug 22, which are shown below in FIG. 1 of the ‘337 patent, are clearly not included in the claims in any manner, nor is there any structure recited in the claims for performing the “not releasable” function. Therefore, the Plaintiff’s assertion the claim includes sufficient structure to avoid a construction under 35 USC § 112, sixth paragraph, is completely erroneous as well as contrary to their own previous admissions.

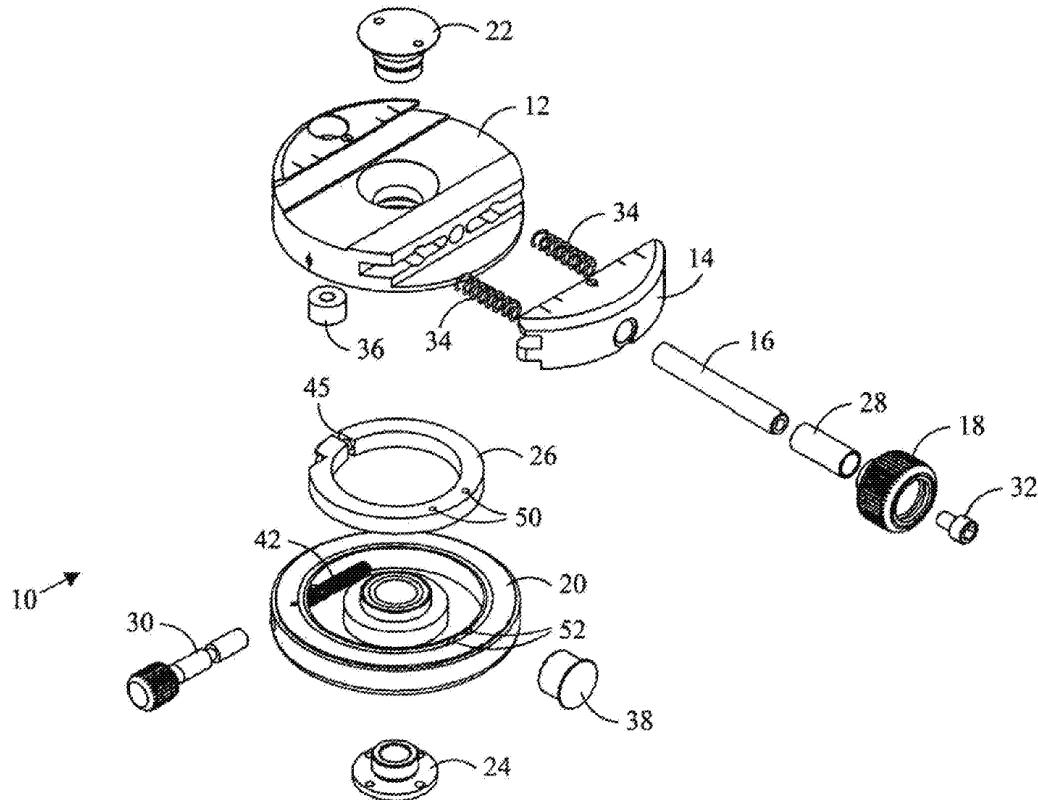


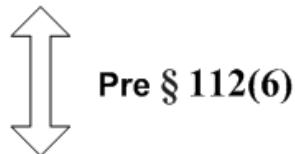
FIG. 1

**FIG. 1 of ‘337 patent
(Joint Appendix p. 107)**

The Plaintiff also asserts the “not releasable” element is not functional but a characteristic of the recited structural elements. The Plaintiff recites no case law to support their contention, whereas in *Schreiber*, the Federal Circuit stated an apparatus is claimed by reciting “features of an apparatus either *structurally or functionally*.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997)(emphasis added). Accordingly, every “feature” or “characteristic” of an apparatus is either structural or functional, and since “not releasable” is not structural, it must be functional. Similarly in *Swinehart*, the Federal Circuit stated functional language defines an apparatus “by what it *does* rather than by what it *is* (as evidenced by specific structure or material[s], for example).” *Application of Swinehart*, 439 F.2d 210, 212 (C.C.P.A. 1971). Again since “not releasable” does not define specific “structure or material,” it must be functional as it defines the apparatus in terms of “what it does” (i.e., it retains the clamping members to the base independent of the second element).

Further, the effect of Plaintiff’s contention is that through a simple trick of claim drafting, functional language can be converted into non-functional language, an illogical result not intended by Congress or the Courts as it would elevate form over substance. Consider the following two claim elements which provide the same coverage (same scope) when asserted against an accused infringer:

said first clamp member and said second clamp member not releasable from
said base by movement of said second member



means for not releasing said first clamp member and said second clamp
member from said base by movement of said second member

Prior to enacting 35 USC § 112, sixth paragraph, both of the above claim elements could be asserted to preclude the function of not releasing the clamp body from the base using any means

possible. In other words, regardless of which claim element is enforced, either one will result in the patentee preventing an accused infringer from performing the “not releasable” function recited in the claim. The Supreme Court held purely functional language, such as in the above two examples, renders a claim invalid under 35 USC § 112, second paragraph, *Halliburton Co. v. Walker*, 329 U.S. 1, 8 (1946) which is why Congress enacted 35 USC § 112, sixth paragraph.

After Congress enacted 35 USC § 112, sixth paragraph, according to the Plaintiff a simple trick of claim drafting somehow renders their claim not “means-plus-function”:

 said first clamp member and said second clamp member not releasable from
 said base by movement of said second member



 means for not releasing said first clamp member and said second clamp
 member from said base by movement of said second member

Clearly this is not the result intended by Congress or the Courts. A patent practitioner cannot employ a simple trick of claim drafting in order to deceive the Court into believing functional language is not actually functional as this would elevate form over substance. The above two claim elements are equivalent in scope before and after Congress enacted 35 USC § 112, sixth paragraph, and therefore both claim elements should be construed as “means-plus-function” covering the corresponding structure disclosed in the specification and equivalents thereof (thereby avoiding a finding of invalidity under *Halliburton*).

The Plaintiff’s erroneous assertion that “not releasable” is a characteristic and not a function is further demonstrated using a few examples:

An apparatus for flying to the moon is functional covered by § 112(6); but

An apparatus that is flyable to the moon is a “characteristic” not covered by § 112(6)?

An apparatus for driving is functional covered by § 112(6); but

An apparatus that is drivable is a “characteristic” not covered by § 112(6)?

When taken to its logical conclusion, according to the Plaintiff every claim that has been deemed to recite functional language by the Courts could have avoided a construction under § 112(6) by using the simple trick of replacing the adjective “for verb-ing” with the adjective “that is verbable.” Obviously neither Congress nor the Courts contemplated such an outcome.

Patent no. Claim no.	Term	Plaintiff’s Definition	Defendant’s definition
10,585,337 – Claim 1(d) and 25(d)	“not releasable”	Plain meaning	Not intended for release

The term “not releasable” has multiple “ordinary” meanings as conceded by the Plaintiff (Dkt. 69, p. 9), including “not easily removed and replaced” or the Defendant’s construction “not intended for release.” *TheFreeDictionary.com*. The Federal Circuit has adjudicated: “A determination that a claim term ‘needs no construction’ or has the ‘plain and ordinary meaning’ may be inadequate when a term has more than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute.” *O2 Micro International, Ltd. v. Beyond Innovation Technology Co.*, 521 F.3d 1351, 1361 (Fed.Cir.2008). Accordingly, the Court should render a decision other than “ordinary meaning,” and in this case, construing “not releasable” as “not intended for release” is most true to the claim language and most naturally aligns with the patent’s description of the invention. *Phillips* at 1316.

The Plaintiff asserts the term “not releasable” should be construed to have “plain meaning; that is, the ordinary meaning that one skilled in the art would understand these terms to mean, as evidenced by the specification itself.” (Dkt. 112, p. 10). The Plaintiff asserts the construction “not intended for release” is not supported by the specification of the ‘337 patent (Dkt. 112, p. 11); however, the Defendant disagrees. The ‘337 patent shows in the above FIG. 1 a plug 22 and

retaining member 24 which are intended to retain the clamp body 12 and the base 20 together without any intention of release by movement of the second member 30. These elements are described in the ‘337 patent at col. 2, lines 61-64 (Joint Appendix p. 119):

“A retaining member 24 is secured to the plug 22 in such a manner to maintain the panning base and the body 12 together with the desired ability to freely rotate.”

One skilled in the art would construe this sentence as meaning the “intent” of the invention is to retain the body 12 (clamping members) to the panning base 20 independent of the second member 30 which enables the “desired ability to freely rotate.”

US 6,773,172 (Side, Around, & Handle)

Patent no. Claim no.	Term	Plaintiff’s Definition	Defendant’s definition
6,773,172 – Claim 29(b)	“side”	Plain meaning	A flat outer surface of an object
6,773,172 – Claim 29(c)	“around”	Plain meaning	Wrap-around

The text of claim 29 in the ‘172 patent (emphasis added):

29. An apparatus for engaging photographic equipment to a support, said apparatus comprising:
- (a) a member defining a channel having a first side wall capable of lateral movement with respect to a second side wall;
 - (b) **a lever capable of causing said lateral movement and movable between a first position and a second position, said lever engaged on a side of said member, said side defining opposed first and second corners; and**
 - (c) **a handle portion of said lever where said handle portion extends beyond said first corner when in said first position and extends beyond and around said second corner when in said second position.**

“When the parties raise an actual dispute regarding the proper scope of these claims, the court, not the jury, must resolve that dispute. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) holding that claim construction is a matter of law.”¹ In this case, the

¹ *O2 Micro Intern. v. Beyond Innov.*, 521 F.3d 1351, 1360 (Fed. Cir. 2008).

scope of the terms “side” and “around” are clearly disputed by the parties as evidenced in multiple of the previous filings.² In addition, because the patentee disavowed claim scope during prosecution of the patent application as explained below, the Court should construe these claim terms consistent with the disavowal.³

The Plaintiff asserts the terms “side” and “around” should be construed to have “their plain meaning; that is, the ordinary meaning that one skilled in the art would understand these terms to mean, as evinced by the specification itself.” (Dkt. 112, p. 10). Although the Defendant agrees the ordinary meaning is determined in view of the specification, it is also determined in view of other intrinsic evidence, such as the prosecution history.⁴

Referring to the above standard of law, there are three types of intrinsic evidence the Court may consider when rendering a decision on claim construction: the teachings of the patent specification, the interpretive prosecution history, and prosecution history disavowal. Although in their claim construction brief the Plaintiff makes conclusory statements there is no intrinsic evidence to support the Defendant’s claim construction, the Defendant has provided multiple examples of intrinsic evidence which the Plaintiff has failed to address.

Patent Specification

Phillips at 1315: “The claims, of course, do not stand alone. Rather, they are part of ‘a fully integrated written instrument,’ consisting principally of a specification that concludes with the claims... For that reason, claims ‘must be read in view of the specification, of which they are a part.’” The ‘172 patent specification discloses a single embodiment⁵ of the claimed clamping

² Dkt 58 p. 4-5; Dkt 69 p. 5-6; Dkt 72 p. 3-6; Dkt 59 p. 6-7; Dkt 70 p. 6-7; and Dkt 75 p. 9-8.

³ *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1365 (Fed. Cir. 2014).

⁴ *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005).

⁵ A single, preferred embodiment may limit the scope of a claim term. In *Apple Inc. v. Andrea Elecs. Corp.*, 949 F.3d 697, 707 (Fed. Cir. 2020), the claim term “periodically” was limited to “regular interval of time” (and excluded

apparatus which is illustrated in FIG. 4 (Joint Appendix p. 8):

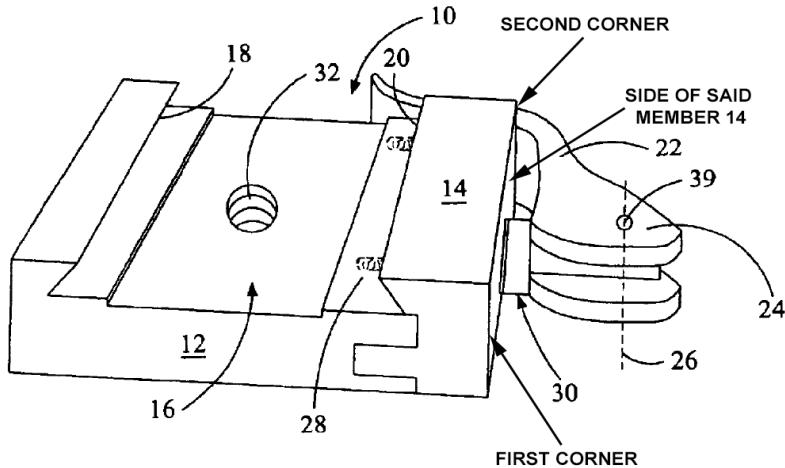


FIG. 4

**FIG. 4 of '172 patent
(Joint Appendix p. 8)**

In this single embodiment as shown in FIG. 4, the “side” of said member is a flat outer surface defining opposing first and second corners. In addition, the ‘172 specification describes the “side” of related prior art clamps as “an *outer lateral side* of the clamp.” (Col. 1, line 65; Joint Appendix p. 19). Accordingly, one skilled in the art would construe the term “side” as a “flat outer surface” that defines opposing corners when discerning the scope of claim 29.

Further, the single embodiment of the ‘172 patent (e.g., FIG. 4) shows the handle portion of the lever wrapping around the second corner (i.e., literally curving around the contours defined by the second corner). One skilled in the art would therefore construe the term “around” in claim 29 as “wrap-around” since this is the only embodiment described by the ‘172 patent. The patentee described the handle portion at col. 6, lines 16-21 (Joint Appendix p. 19):

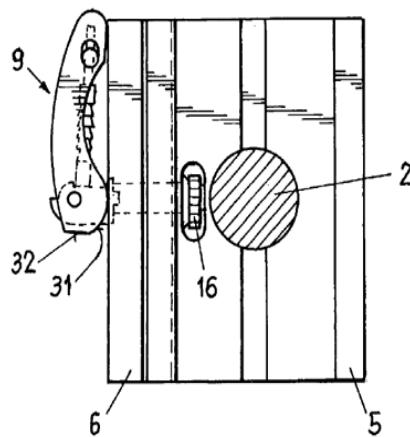
“The handle portion 56 is elongate and has a sufficient length to extend beyond, *and curve around, a lateral corner* 61 of the clamp 10 when the cam lever is in the second, or locked position as seen in FIG. 4.”

“from time to time”) because this was the only embodiment disclosed in the specification. See also *The Medicines Company v. Mylan, Inc.*, 2015-1113 (Fed. Cir. 2017).

Accordingly, one skilled in the art would construe the term “around” as “wrap-around” (or curving around the contours of the second corner) as shown in the above FIG. 4 of the ‘172 patent and as described by the patentee in the specification.

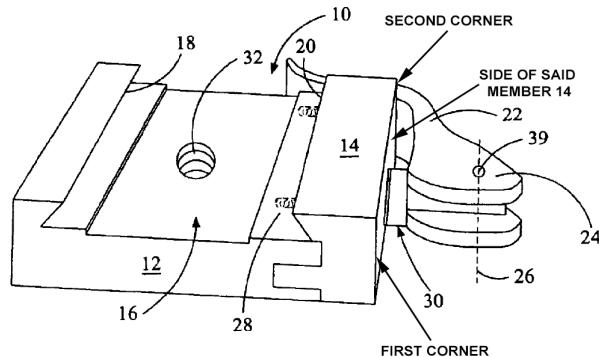
Interpretive Prosecution History

The claims may also be construed using intrinsic evidence based on the interpretive prosecution history: “The prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) The prosecution history of the ‘172 patent supports the construction of “side” as a “flat outer surface” and “around” as “wrap-around” since the examiner rejected claim 29 under 35 USC § 102 as anticipated by FIG. 3 of US 6,435,738 (Exhibit 1 p. 3):



**FIG. 3 of '738 patent
(Exhibit 1 p. 3)**

Fig. 3



**FIG. 4 of '172 patent
(Joint Appendix p. 8)**

The examiner asserted FIG. 3 of the ‘738 patent shows a clamp that anticipates claim 29 of the ‘172 patent, including a “side” that is a “flat outer surface” defining first and second opposing

corners,⁶ except that the handle portion (end portion) of the lever 9 does not extend beyond *and wrap-around* the second corner of the clamp (Joint Appendix p. 51).⁷ The patentee overcame the rejection by amending claim 29 (Joint Appendix p. 45, 47) to recite the handle portion of the lever extends beyond *and around* the corner of the clamp as shown in FIG. 4 of the ‘172 patent. Having amended claim 29 in this manner to overcome the rejection based on the ‘738 patent, one skilled in the art would construe the phrase “extends beyond and around the second corner” to mean the handle portion extends beyond and *wraps-around* the second corner as shown in FIG. 4 of the ‘172 patent as compared to the handle portion of the lever 9 shown in FIG. 3 of the ‘738 patent (prior art).

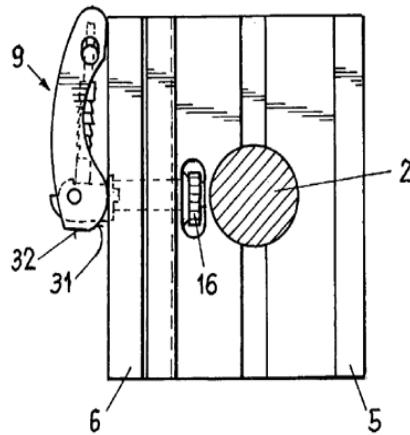
Prosecution History Disavowal

For prosecution history disavowal to attach, a patentee must clearly and unmistakably disavow the full scope of a claim term. *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1374 (Fed. Cir. 2008). “A patentee could do so, for example, by clearly characterizing the invention in a way to try to overcome rejections based on prior art.” *Computer Docking Station*, 519 F.3d at 1374. In this case, prosecution history disavowal prevents the patentee from broadening the meaning of the terms “side,” “first corner,” “second corner,” and “around.” As described above, claim 29 was allowed by the examiner only after the patentee amended the claim to clarify that the handle portion of the lever extends beyond *and around* said second corner when in said second position (locked position) as shown in FIG. 4 (Joint Appendix p. 45, 47). The patentee pointed to page 8 of the specification (Joint Appendix p. 80-81) of the ‘172 patent for the benefit of this amendment that supported the allowability contention: “The cam lever 22 is

⁶ The ‘172 specification describes the “side” of related prior art clamps as “an *outer lateral side* of the clamp.” Col. 1, line 65; Joint Appendix p. 19.

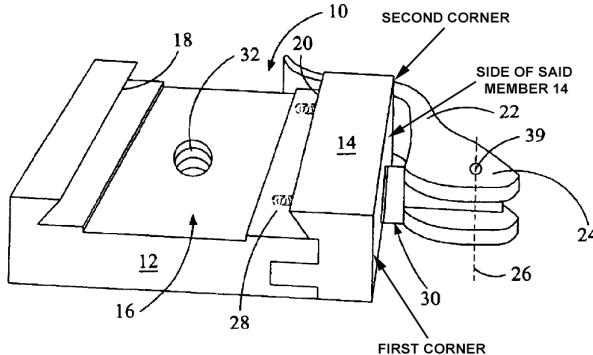
⁷ “The claimed ‘handle portion’ is met by the end of lever 9, which, as shown in drawings figures 3 and 5, extends beyond the corners.” Examiner Gray, Office Action Mailed 08/20/2003, Joint Appendix p. 51.

therefore easily accessible even though a camera body is secured to the clamp [when in the locked position].” In other words, the patentee identified a problem inherent with prior art clamps having a flat outer side that defines opposing corners such as the prior art clamp disclosed in FIG. 3 of the ‘738 patent:



**FIG. 3 of '738 patent
(Exhibit 1 p. 3)**

Fig. 3



**FIG. 4 of '172 patent
(Joint Appendix p. 8)**

The problem, identified by the patentee on page 8 of the specification (Joint Appendix p. 80), is that the lever 9 is not easily accessible when in the locked position. The claimed invention overcomes this problem by providing a lever 22 that extends beyond and wraps-around the corner of the flat outer side when in the locked position as shown in the above FIG. 4 of the ‘172 patent (Joint Appendix p. 80-81).⁸ Having relied on this benefit to assert patentability, prosecution history disavowal prevents the patentee from later asserting a broader interpretation of the claim.⁹

In addition, when the patentee disavows the full scope of a claim term during prosecution, it may be either impliedly or explicitly. *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1365 (Fed. Cir. 2014). Accordingly, given the patentee at least impliedly disavowed the full claim

⁸ A claim term may be limited by the problem solved by the invention. In *Kaken Pharm. Co. v. Iancu*, 2018-2232, 2020 U.S. App. LEXIS 8018 (Fed. Cir. Mar. 13, 2020), the claim term “onychomycosis” was limited to a human or animal “nail” in part because the invention solved a “disease of the nail.”

⁹ *Computer Docking Station*, 519 F.3d at 1374-1375.

scope by amending claim 29 to overcome the rejection based on the prior art together with remarks that point to a benefit of the invention that supports patentability (i.e., non-obviousness), one skilled in the art would construe the term “side” as a “flat outer surface” and construe the term “around said second corner” as the handle “wraps-around said second corner” as shown in the single embodiment disclosed in the ‘172 patent (e.g., FIG. 4).

Patent no.	Claim no.	Term	Plaintiff's Definition	Defendant's definition
6,773,172 – Claim 29(c)		“handle portion”	Plain meaning	End portion of lever

One skilled in the art would construe “handle portion” recited in claim 29(c) as the “end portion of the lever” (see handle portion 56 of the lever 22 in FIG. 8A of the ‘172 patent) which “wraps-around” the second corner as shown in FIG. 4:

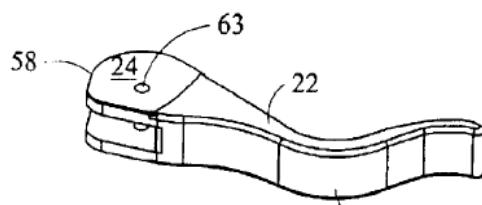


FIG. 8A

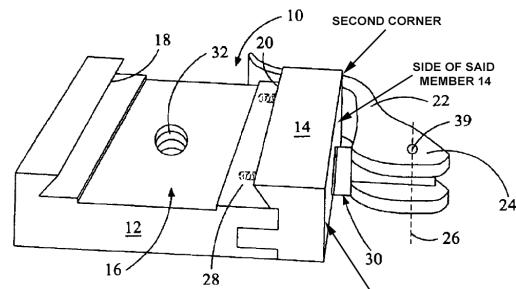


FIG. 4

**FIG. 8A of '172 patent
(Joint Appendix p. 12)**

**FIG. 4 of '172 patent
(Joint Appendix p. 8)**

Again FIG. 4 is the only disclosed embodiment and nothing in the specification would suggest a different construction of the term “handle portion” other than the “end portion” of the lever.” Further, a broader interpretation would render claim 29 invalid under 35 USC § 112, first paragraph, since the specification does not enable a broader interpretation of the claim (i.e., an interpretation broader than the embodiment shown in FIG. 4). Even the examiner construed the

“handle portion” of the lever to mean “the end of the lever” (Office Action mailed on 08/20/2003; Joint Appendix p. 51).

US 6,773,172 (First and Second Position)

Patent no. Claim no.	Term	Plaintiff's Definition	Defendant's definition
6,773,172 – Claim 29(c)	“first position”	Plain meaning	Unlocked position of the clamp
6,773,172 – Claim 29(c)	“second position”	Plain meaning	Locked position of the clamp

In the ‘172 patent, the patentee provided a specific definition of the term “first position” and “second position” in the patent specification, as well as disavowed scope of the terms during prosecution of the patent application, and therefore the Court should construe the terms accordingly.¹⁰

Definitions in Specification

The Plaintiff asserts there is no evidence the patent applicant defined the terms “first position” and “second position” in the specification; however, the Defendant has identified multiple instances within the specification where these terms were defined which the Plaintiff has failed to address. Further, the Defendant’s position is supported by well established case law: using the abbreviation “i.e.” is often definitional. *Edwards Lifesciences LLC v. Cook Inc.*, 582 F.3d 1322, 1334 (Fed. Cir. 2009) (“[U]se of ‘i.e.’ signals an intent to define the word to which it refers.”); *see also Abbott Labs. v. Novopharm Ltd.*, 323 F.3d 1324, 1330 (Fed. Cir. 2003)(holding that a patentee “explicitly defined” a term by using “i.e.” followed by an explanatory phrase). In addition, using the conjunction “or” as well as using a comma is grammatically equivalent to using the abbreviation “i.e.” Also, “repeated and definitive remarks in the written description could restrict a claim limitation to a particular structure.” *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1374

¹⁰ *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362, 1365 (Fed. Cir. 2014).

(Fed. Cir. 2008). Referring to the following sections of the ‘172 patent:

“The lever 22 may be a cam lever that includes a cam portion 24 that rotates about a pivot axis 26 as the cam lever is moved between *a first, unlocked position* (shown in FIG. 1) and *a second, locked position* (shown in FIG. 4).” (Col. 3, lines 3-15; Joint Appendix p. 18).

“The outwardly directed force applied by the springs 28 on the adjustable arm 14 is at a maximum when the lever 22 is in *the second position, i.e. when the channel 16 is intended to grip photographic equipment.*” (Col. 3, lines 16-19; Joint Appendix p. 18).

“The handle portion 56 is elongate and has a sufficient length to extend beyond, and curve around, a lateral corner 61 of the clamp 10 when the cam lever is in *the second, or locked position* as seen in FIG. 4.” (Col. 6, lines 16-20; Joint Appendix p. 19).

Accordingly, considering the specification’s explicit and repeated definition of the terms “first position” and “second position,” particularly when using the definitional identifier “i.e.” and equivalents such as “or” and a comma, the claim term “first position” should be construed as the unlocked position of the clamp, and the claim term “second position” should be construed as the locked position of the clamp.

Patent Specification

In addition to the patent specification defining “first position” as the locked position and “second position” as the unlocked position, construing these terms according to these definitions is also consistent with the drawings of the patent specification. That is, the terms “first position” and “second position” are repeatedly and consistently described with reference to the drawings as

being the unlocked position of the clamp and the locked position of the clamp.¹¹ Further, the specification describes a single embodiment (e.g., FIG. 4) wherein the “first position” is the unlocked position and the “second position” is the locked position.¹² Nothing in the patent specification would suggest to one skilled in the art that “first position” is anything other than the unlocked position and that “second position” is anything other than the locked position.

Interpretive Prosecution History

The prosecution history of the ‘172 patent supports the construction of “first position” as the locked position and “second position” as the unlocked position. The examiner rejected claim 29 under 35 USC § 102 as anticipated by FIG. 3 of US 6,435,738 (Exhibit 1 p. 3). Claim 29 was allowed by the examiner only after the patentee amended the claim to clarify that the handle portion of the lever extends beyond and around said second corner when in said *second position* (locked position) as shown in FIG. 4. The patentee pointed to page 8 of the specification (Joint Appendix p. 80-81) of the ‘172 patent for support for this amendment (Joint Appendix p. 47, p. 80-81): “The handle portion 56 is elongate and has a sufficient length to extend beyond, and curve around, a lateral corner 61 of the clamp 10 when the cam lever is in *the second, or locked position* as seen in FIG. 4… [t]he cam lever 22 is therefore easily accessible even though a camera body is secured to the clamp [when the clamp is in the second, or locked position].”

Prosecution History Disavowal

The Plaintiff makes the conclusory statement that the Defendant cannot meet the burden of proving “clear disavowal;” however, the Plaintiff also fails to address any of the Defendant’s

¹¹ “[R]epeated and definitive remarks in the written description could restrict a claim limitation to a particular structure.” *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1374 (Fed. Cir. 2008).

¹² A single, preferred embodiment may limit the scope of a claim term. In *Apple Inc. v. Andrea Elecs. Corp.*, 949 F.3d 697, 707 (Fed. Cir. 2020), the claim term “periodically” was limited to “regular interval of time” (and excluded “from time to time”) because this was the only embodiment disclosed in the specification. See also *The Medicines Company v. Mylan, Inc.*, 2015-1113 (Fed. Cir. 2017).

evidence that this burden has in fact been met. It is well established that “clear disavowal” can occur when a patentee clearly characterizes the invention “in a way to try to overcome rejections based on prior art.”¹³ Claim 29 was allowed by the examiner only after the patentee amended the claim to clarify that the handle portion of the lever extends beyond and around said second corner when in said *second position* (locked position) as shown in FIG. 4. The patentee pointed to page 8 of the specification of the ‘172 patent for the benefit of this amendment that supported the allowability contention (Joint Appendix p. 47, p. 80-81): “The cam lever 22 is therefore easily accessible even though a camera body is secured to the clamp [when the clamp is in the second, or locked position].” Having relied on this benefit to assert patentability, prosecution history disavowal prevents the patentee from later asserting a broader interpretation of the claim.¹⁴

‘172 Patent Construction Summary

In view of the overwhelming intrinsic evidence provided by the specification and prosecution history, one skilled in the art would construe the term “first position” as the unlocked position as shown in FIG. 1, and construe the term “second position” as the locked position as shown in FIG. 4 of the ‘172 patent:

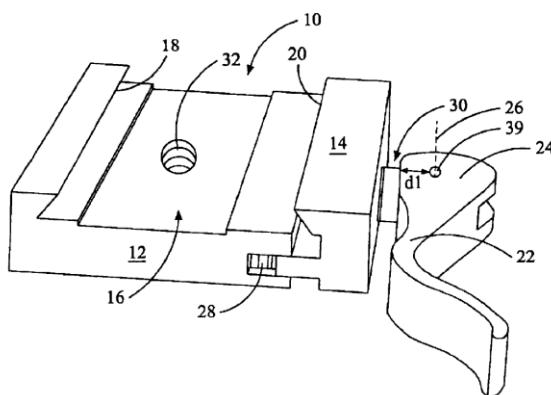


FIG. 1

**FIG. 1 of ‘172 patent
First Position - Unlocked**

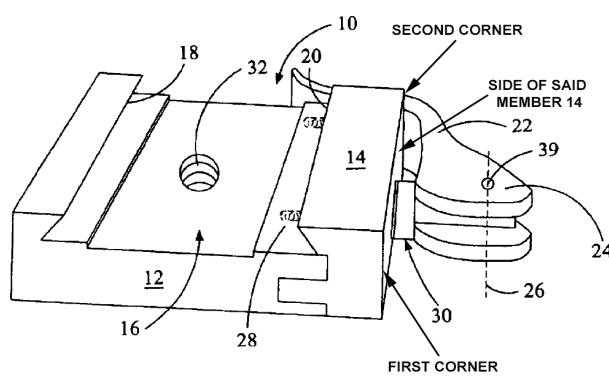


FIG. 4

**FIG. 4 of ‘172 patent
Second Position - Locked**

¹³ Computer Docking Station, 519 F.3d at 1374.

¹⁴ Computer Docking Station, 519 F.3d at 1374-1375.

(Joint Appendix p. 7)

(Joint Appendix p. 8)

IV. CONCLUSION

For the reasons described above, Defendant requests this Court construe the claim terms as asserted by the Defendant and as fully supported by this response claim construction brief.

Dated this 4th day of December, 2022

Respectfully Submitted,

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