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6 IN THE UNITED STATES DISTRICT COURT
7 FOR THE DISTRICT OF ARIZONA

9 James Jeffery Caron and Spellbinders Paper
10 Arts Company, LLC, an Arizona limited
liability company,

11 Plaintiffs,

12 vs.

13 QuicKutz, Inc., a Utah corporation,

14 Defendant.

No. CV-09-02600-PHX-NVW

ORDER

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16 Before the Court is QuicKutz's Motion for Reconsideration of Claim Construction
17 Order or in the Alternative Motion for Clarification of Claim Construction Order [Dckt.
18 No. 176] (Doc. 186).

19 QuicKutz contends that the Court erred by including the phrase "intended to be
20 used for" or "intended to be used to" in the following constructions:

- 21 • "embellishing template" (claims 28, 35) shall be construed as "a die having
22 features intended to be used for cutting, embossing, and/or stenciling on
23 sheet media";
- 24 • "embellishing wall" (claim 28) shall be construed as "a solid projection
25 from the body of the die or template intended to be used to form an
26 embossed impression in sheet media, or to cut sheet media, or both"; and
- 27 • "media embossing aperture" (claim 18) shall be construed as "an opening
28 in the die capable of, and intended to be used for, embossing sheet media."

1 (Doc. 176.) For each of these terms, Spellbinders’ proposed constructions included the
2 adjective “predetermined” to modify “shape” or “pattern.” The Court found that “the
3 entire thrust of the patent is that these openings have intentionally defined shapes, and
4 that an end-user would purchase a die because the user can emboss[, cut, or stencil] the
5 die’s intentionally defined pattern into paper or similar materials.” (*Id.*) However, the
6 Court also found that “predetermined” does not adequately exclude other intentional
7 features that may also be capable of forming random or inadvertent cutting, embossing,
8 or stenciling, even though not intended for that purpose. (*Id.*)

9 First, QuicKutz contends that intent cannot be the basis for determining
10 infringement or anticipation. Plaintiffs agree that the intent to infringe is not an element
11 of proving infringement or anticipation.

12 QuicKutz also contends that because the term “media embossing aperture” is
13 recited functionally, not structurally, “the appropriate inquiry is whether an aperture is
14 capable of embossing, not whether the aperture was intended to emboss.” However, both
15 parties agree that a patent applicant is free to recite features of an apparatus either
16 structurally or functionally and may assume the risks associated with defining an element
17 functionally. *See In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997).

18 Relying on authority applying the doctrine of equivalents, QuicKutz further
19 contends that a system can infringe if it is *capable of* performing an infringing function
20 even if the infringing function is not an intended use of the system. *See Intel Corp. v.*
21 *U.S. Int’l Trade Comm’n*, 946 F.2d 821, 832 (Fed. Cir. 1991); *Vulcan Eng’g Co. v. Fata*
22 *Aluminum, Inc.*, 278 F.3d 1366, 1375 (Fed. Cir. 1990) (“When the claimed function is
23 performed in the accused system, by the same or equivalent structure, infringement of
24 that claim element is established.”). Here, however, replacing “intended to be used for”
25 with “capable of” would make the constructions overbroad because almost any tangible
26 object is capable of making some accidental or unintended cut, mark, or three-
27 dimensional impression in paper or card stock. In the context of the ’634 Patent,
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1 therefore, it is inappropriate to use the phrase “capable of” instead of “intended to be used
2 for” in the constructions of the terms “media embossing aperture,” “embellishing
3 template,” and “embellishing wall.” See *Koito Manuf’g Co., Ltd. v. Turn-Key-Tech, LLC*,
4 381 F.3d 1142, 1150 n.2 (Fed. Cir. 2004) (noting that an element of forethought and
5 planning was “a logically essential part of the patent”).


6 Second, QuicKutz contends that a claim term is indefinite if intent is required.
7 More specifically, QuicKutz contends that the disputed constructions including the
8 phrase “intended to be used for” are indefinite because they lack an objective standard.

9 A patent specification must “conclude with one or more claims particularly
10 pointing out and distinctly claiming the subject matter which the inventor or a joint
11 inventor regards as the invention.” 35 U.S.C. § 112(b). “[C]laims are construed as one
12 skilled in the art would understand them in light of the specification of which they are a
13 part.” *Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1340-41 (Fed. Cir. 2003). “[A]
14 patentee need not define his invention with mathematical precision in order to comply
15 with the definiteness requirement.” *Id.* at 1341. The definiteness requirement “does not
16 compel absolute clarity,” and “[o]nly claims ‘not amenable to construction’ or ‘insolubly
17 ambiguous’ are indefinite.” *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342,
18 1347 (Fed. Cir. 2005). “Whether a claim is invalid for indefiniteness requires a
19 determination whether those skilled in the art would understand what is claimed when the
20 claim is read in light of the specification.” *Morton Int’l, Inc. v. Cardinal Chem. Co.*, 5
21 F.3d 1464, 1470 (Fed. Cir. 1993); see also *SmithKline Beecham Corp. v. Apotex Corp.*,
22 403 F.3d 1331, 1340-41 (Fed. Cir. 2005) (the test for indefiniteness depends on whether
23 the claim delineates to a skilled artisan the bounds of the invention). To be definite,
24 however, “[t]he scope of claim language cannot depend solely on the unrestrained,
25 subjective opinion of a particular individual purportedly practicing the invention,” but
26 must provide some objective standard. *Datamize*, 417 F.3d at 1350.

1 Here, the constructions using the phrase “intended to be used for” are not
2 ambiguous or without objective standard. As previously found, “the entire thrust of the
3 patent is that these openings have intentionally defined shapes, and that an end-user
4 would purchase a die because the user can emboss[, cut, or stencil] the die’s intentionally
5 defined pattern into paper or similar materials.” It is not necessary to decide who must
6 exhibit the requisite intent, when intent is determined, whether intent can change, and
7 what showing is required to establish intent. It can be determined objectively whether a
8 person skilled in the art would conclude that a die has an opening or projection that will
9 cut, emboss, and/or stencil in an intended shape or pattern.

10 IT IS THEREFORE ORDERED that QuicKutz’s Motion for Reconsideration of
11 Claim Construction Order or in the Alternative Motion for Clarification of Claim
12 Construction Order [Dckt. No. 176] (Doc. 186) is denied.

13 Dated this 16th day of October, 2012.

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18 Neil V. Wake
19 United States District Judge
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