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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

MARK L. McHUGH,

Plaintiff,

No. C 07-03677 JSW

v.

HILLERICH & BRADSBY CO.,

Defendant.

**ORDER DENYING PLAINTIFF’S
MOTION FOR SUMMARY
JUDGMENT AND GRANTING
DEFENDANT’S CROSS-MOTION
FOR SUMMARY JUDGMENT**

_____ /

INTRODUCTION

Now before the Court is the motion for summary judgment of infringement filed by Mark L. McHugh (“McHugh”), and the cross-motion for summary judgment of non-infringement or, alternatively, summary adjudication of laches and willfulness filed by Hillerich & Bradsby Co. (“H&B”). Having considered the parties’ papers, relevant legal authority, the record in this case, and having had the benefit of oral argument, the Court **HEREBY DENIES** McHugh’s motion and **GRANTS** H&B’s motion for summary judgment of non-infringement.¹

BACKGROUND

A. Procedural History.

Plaintiff McHugh filed suit alleging that Defendant H&B infringes U.S. Patent No. 5,806,091 (filed Nov. 14, 1996) (the “’091 Patent”). The ’091 Patent relates to a hand grip aid

¹ In light of the Court’s ruling on the issue of non-infringement, the Court does not reach the merits of H&B’s motion for summary adjudication on the basis of laches and willfulness.

1 for use with sports equipment, exercise equipment, manual work equipment, or any other
2 equipment that has a handle. ('091 Patent col.1 ll.7-9.)

3 McHugh accuses H&B's Bionic Gloves of infringing the '091 Patent. Dr. James M.
4 Kleinert, a hand surgeon employed by H&B, designed the Bionic Gloves with pads ("Bionic
5 finger pads") at anatomically significant positions throughout the hand. The location of those
6 bionic finger pads is the focus of the dispute presented by this lawsuit.

7 The Court held a claim construction hearing, pursuant to *Markman v. Westview*
8 *Instruments, Inc.*, 517 U.S. 370 (1996). On March 31, 2009, the Court issued its Claim
9 Construction Order, in which it construed several of the disputed claim terms in the '091 Patent.
10 The disputed claim terms and the Court's claim constructions are as follows:

11 Disputed Claim Term	Claim Construction
12 "member" or "elongated resilient member"	"long and thin component which returns to its original shape following a deformation in shape"
13 "configured to fit"	"designed to fit"
14 "base of the user's fingers"	"the location where the palm joins the fingers"
15 "adjacent to the base of the user's fingers"	"near the proximal phalanx A2 pulley region of the user's fingers"
16 "in a gap" or "in a gap between a palm of the user's hand and the base of the user's fingers"	17 "in the proximal digital crease of the user's hand"
18 "retainer" or "a retainer connected to the member"	19 "hand grip element for positioning and retaining the member"
20 "attachment"	"a strap or long thin pocket or other similar retainer."
21 "includes a plurality of sub-members"	"is composed of two or more sub-members"

22
23 (See Claim Construction Order ("CCO") at 9:21-22, 10:5-6, 11:20-21, 12:22-24, 13:19-20,
24 15:12-13, 16:11-12, 17:9-10.)

25 For the purposes of this motion, the Court need only address the location of the
26 elongated resilient member because the Court finds that the Bionic Gloves do not contain a
27 member "configured to fit at a base of the user's fingers in a gap between a palm of the user's
28 hand and the base of the user's fingers." ('091 Patent col.5 ll.14-17.) This Court has construed

1 this term as requiring the member be designed to fit at the location where the palm joins the
2 fingers in the proximal digital crease of the user’s hand. (*See* CCO at 10:5-6, 11:20-21, 13:19-
3 20.) McHugh asserts Bionic Gloves have pads located in this location. H&B asserts they do
4 not.

5 It is undisputed that the Bionic finger pads are located in the A2 pulley region of a
6 user’s hands. However, the parties dispute whether pads located in the A2 pulley region are, by
7 necessity, located “in the proximal digital crease of the user’s hand.” The parties also dispute
8 whether the member limitation or the retainer limitation of Claim 1 dictates the location of the
9 member. There are no genuine issues of material fact for a jury. This is a question of law based
10 on the Court’s claim construction and, as such, is appropriate for disposition on summary
11 judgment.

12 **B. Prosecution of the ’091 Patent.**

13 The facts pertaining to the prosecution history of the ’091 Patent are not disputed.
14 Claim 1 of the ’091 patent originally claimed: “an elongated member configured to fit adjacent
15 to a user’s superficial transverse metacarpal ligament and adjacent to a user’s finger.”
16 (Declaration of Laura A. Wytsma (“Wytsma Decl.”) Ex. 2 at 8.) The application went through
17 several rejections, amendments, and interviews. The applicable amendments are as follows:

18 After issuing a non-final office action, the Examiner agreed to “reconsider the claims in
19 view of language that clarified the structure of the invention and how it is placed in the hand.”
20 (*Id.* Ex. 4 at 3.) McHugh amended Claim 1 to specify the member be “configured to fit into a
21 gap adjacent to a user’s superficial transverse metacarpal ligament and adjacent to a user’s
22 finger to space skin from the user’s palm from the user’s fingers.” (*Id.* Ex. 4 at 2 (emphasis in
23 original).) In that response, McHugh further argued that the prior art did not teach that a
24 “portion of the grip accommodates a ‘gap’ between the user’s palm and the base of the user’s
25 fingers.” (*Id.* at 3.)

26 After another rejection, in a telephonic interview, McHugh and the Examiner discussed
27 claim limitations that might define a patentable claim. In particular, they discussed “language
28 that clarifies how the hand grip is arranged in a wearer’s hand.” (*Id.* Ex. 8.) Finally, McHugh

1 amended Claim 1 to require the member be configured to fit “at a base of the user’s fingers” in
2 “a gap between the palm of the user’s hand” and “the base of the user’s fingers.” (*Id.* Ex. 9 at 1
3 (emphasis in original).) In this amendment, McHugh also added the retainer limitation. (*Id.* at
4 6.) Following that final amendment, the patent issued on September 15, 1998. (*Id.* Ex. 1.)

5 The Court shall discuss additional facts as necessary in the analysis.

6 ANALYSIS

7 **A. Legal Standards Applicable to Motions for Summary Judgment.**

8 Summary judgment is appropriate when there is no genuine issue as to any material fact
9 and the moving party is entitled to judgment as a matter of law. *Union States Gypsum Co. v.*
10 *Nat’l Gypsum Co.*, 74 F.3d 1209, 1212 (Fed. Cir. 1996). The burden of demonstrating the
11 absence of any genuine issue of material fact rests with the moving party. *SRI Int’l v.*
12 *Matsushita Elec. Corp.*, 775 F.2d 1107, 1116 (Fed. Cir. 1985). In order to defeat summary
13 judgment, the non-moving party must do “more than simply show that there is some
14 metaphysical doubt as to the material facts.” *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*,
15 475 U.S. 574, 586 (1986). Rather, the non-moving party must set forth “specific facts showing
16 that there is a genuine issue for trial.” Fed. Cir. R. Civ. P. 56(e); *Matsushita Elec.*, 475 U.S. at
17 587.

18 **B. H&B’s Motion for Summary Judgment is Granted.**

19 There are two steps in an infringement analysis: (1) construing the claims of the patent
20 in suit; and (2) comparing the properly construed claims to the accused products. *Cybor Corp.*
21 *v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (*en banc*); *see also SafeTCare Mfg.,*
22 *Inc. v. Tele-Made, Inc.*, 497 F.3d 1262, 1268 (Fed. Cir. 2007). The Court has construed the
23 claims. Now the Court must determine whether, under its construction, H&B’s accused devices
24 fall within the scope of those claims.

25 To meet its burden on the second prong of the infringement analysis, McHugh ““must
26 show the presence of every element or its substantial equivalent in the accused device.”” *Terlep*
27 *v. Brinkman Corp.*, 418 F.3d 1379, 1384 (Fed. Cir. 2005) (quoting *Wolverine World Wide, Inc.*
28 *v. Nike, Inc.*, 38 F.3d 1192, 1199 (Fed. Cir. 1994)). McHugh bears the burden of proving

1 infringement, either literally or under the doctrine of equivalents, by a preponderance of the
2 evidence. *See, e.g., Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir.
3 2000).

4 **1. McHugh Cannot Demonstrate that H&B’s Accused Devices Literally**
5 **Infringe the ’091 Patent.**

6 The parties dispute whether several claim elements are literally infringed. The Court
7 finds it unnecessary to discuss all claim limitations because literal infringement requires the
8 patentee to prove the accused device contains each and every limitation of the asserted claim.
9 *See Bayer AG*, 212 F.3d at 1247. The Bionic Gloves are not “configured to fit at a base of the
10 user’s fingers in a gap between a palm of the user’s hand and the base of the user’s fingers.”
11 (’091 Patent col.5 ll.14-17.) McHugh also attempts to argue that this limitation is not the
12 correct limitation to define the location of the member in a user’s hand. The Court does not
13 agree.

14 **a. The Bionic finger pads are not “configured to fit at a base of the**
15 **user’s fingers in a gap between a palm of the user’s hand and the**
16 **base of the user’s fingers.”**

17 Claim 1 requires the member be “configured to fit at a base of the user’s fingers in a gap
18 between a palm of the user’s hand and the base of the user’s fingers.” (’091 Patent col.5 ll.14-
19 17.) Under the Court’s claim construction, the member must be designed to fit at the location
20 where the palm joins the fingers in the proximal digital crease of the user’s hand. (*See CCO* at
21 10:5-6, 11:20-21, 13:19-20.) H&B argues that McHugh cannot demonstrate that the pads in the
22 Bionic Gloves are designed to fit in the proximal digital crease of the user’s hand. McHugh
23 argues that, because both the proximal digital crease and the Bionic finger pads are located in
24 the proximal phalanx A2 pulley region, therefore the bionic finger pads are located at the
25 proximal digital crease. “Literal infringement requires the patentee to prove that the accused
26 device contains each limitation of the asserted claim(s). ... If any claim limitation is absent from
27 the accused device, there is no literal infringement as a matter of law.” *Bayer AG*, 212 F.3d at
28 1247 (citation omitted).

1 Neither party contests that both the proximal digital crease and the Bionic finger pads
2 are located in the proximal phalanx A2 pulley region of the user’s fingers. Both parties have
3 also submitted evidence, through various anatomical figures, showing that the proximal phalanx
4 A2 pulley generally covers the middle portion of the proximal phalanx and extends above
5 (distal) and below (proximal) the proximal digital crease where the palm joins the fingers.
6 McHugh even stated in oral argument that the pulley is quite long and extends above and below
7 the proximal digital crease. McHugh claims these facts are dispositive. H&B asserts they are
8 irrelevant.

9 McHugh concludes that, because both the Bionic finger pads and the proximal digital
10 crease of the user’s hand are located in the proximal phalanx A2 pulley region, the pads must be
11 located in the proximal digital crease of the user’s hand. Accordingly, McHugh argues that,
12 under the Court’s claim construction, the pads are located “in a gap between a palm of the
13 user’s hand and the base of the user’s fingers.”² Such logic is unsound because it parallels the
14 classic fallacy of the undistributed middle.

15 H&B contends that, while the pads in H&B’s bionic gloves are located in the A2 pulley
16 region, they are above (distal) the proximal digital crease. The Court agrees. Both parties cite
17 to the same anatomy textbook that indicates that the proximal digital crease is a line located at
18 the same level as the hand’s “webbing” between the fingers. (*See* Declaration of Christopher P.
19 Grewe (“Grewe Decl.”) Ex. F, Fig. D; *see also* Wytsma Decl. Ex. 25, Fig. D.) The Bionic
20 finger pads, by contrast, are plainly located above this crease and the webbing. (*See* Wytsma
21 Decl. Ex. 21; *see also* Grewe Decl. Ex. R.) From these pictures, and upon examining the
22 gloves, it is apparent that the lower (proximal) stitching which attaches the bionic finger pads to

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24
25 ² While discussing elements of the *retainer* limitation, this Court said: “[m]ost
26 importantly, if the member is located ‘near the proximal phalanx A2 pulley region of the
27 user’s fingers,’ this placement specification is broad enough to allow the member to fit in the
28 gap between the base of the user’s fingers and the palm of the hand.” (CCO 12:18-21.)
McHugh purports to use this language as a construction for “a gap between a palm of the
user’s hand and the base of the user’s fingers,” rather than the express claim construction
given by the Court. The Court was simply clarifying that the claim construction for the
retainer limitation is not mutually exclusive with the claim construction for the *member*
limitation.

1 the gloves is level with the portion of the gloves which corresponds to the webbing between the
2 fingers.

3 The tighter the glove fits, the closer the outline of the glove conforms to the shape of the
4 human hand and the closer the bionic finger pads are to the proximal digital crease. If a glove is
5 too large for its wearer, the bionic finger pads will be further above (distal) the proximal digital
6 crease. By contrast, the tightest a glove can possibly be worn is when the portion of the gloves
7 which corresponds to the webbing between fingers fits flush or tightly against the webbing
8 between the fingers. Because the bionic finger pads do not extend below the portion of the
9 glove which corresponds to the webbing between the fingers, the bionic finger pads cannot
10 extend below the webbing between the fingers. At most, the bionic finger pads *touch* the
11 proximal digital crease, but they are not located *in* the proximal digital crease. The location of
12 the pads relative to the proximal digital crease of the Bionic Gloves is similar to the location of
13 a page in a book relative to the binding, or crease, of the book. Pages in a book *touch* the
14 binding, and in fact a very small portion of the page could be considered “in” the binding, but
15 one would not say the page itself is *in* the binding of the book.

16 This interpretation is also supported by Dr. Kleinert’s deposition, which McHugh cites
17 in his opening brief. Dr. Kleinert is the developer and designer of the Bionic Gloves. In his
18 deposition, Dr. Kleinert identifies that he believed it was important that “the pads were not
19 close to the joints so that the hand could bend freely.” (Grewe Decl., Ex. QQ (Kleinert 6/23/09
20 Depo., 70:8-10).) This description is consistent with the overall design of the Bionic Gloves,
21 which includes “flex zones” at each joint in the hand made of thinner material than the rest of
22 the glove to ensure that the joints can bend properly. (Declaration of James M. Kleinert, M.D.
23 (“Kleinert Decl.”), Ex. 5.)

24 McHugh asserts that, even if the bionic finger pads are located above the proximal
25 digital crease when the hand is in the open position, that, by necessity, the pads must be located
26 in the proximal digital crease when the hand is in the partially flexed position. McHugh cites
27 Dr. Kleinert’s deposition testimony as evidence that he designed the gloves to be used in the
28 partially flexed position. (Grewe Decl., Ex. QQ (Kleinert 6/23/09 Depo., 71:6-18).) H&B does

1 not contest that the gloves were designed to be used in the partially flexed position. However,
2 McHugh has brought forward no evidence that indicates that the pads somehow change location
3 relative to the hand when the hand moves. Furthermore, when fingers are flexed, the location of
4 the crease does not change relative to the webbing between the fingers. Therefore, because the
5 bionic finger pads cannot extend below the webbing of the fingers, it is illogical to suppose that
6 the bionic finger pads could shift position and be located over the proximal digital crease in a
7 partially flexed position.

8 Accordingly, H&B is entitled to summary judgment of no literal infringement because
9 no reasonable juror could find that the Bionic Gloves meet each and every limitation of the '091
10 Patent.

11 **b. The member limitation, not the retainer limitation, specifies the location of**
12 **the member.**

13 McHugh asserts that it is the *retainer* limitation, not the *member* limitation, that
14 specifies the actual location of the *member* in the user's hand for an accused product. By
15 contrast to the *member* limitation, the *retainer* limitation requires that the retainer must "retain
16 the member in the user's hand adjacent to the base of the user's fingers." ('091 Patent col.5
17 ll.20-21.) The Court has construed this language to require that the retainer "retain the member
18 in the user's hand near the proximal phalanx A2 pulley region of the user's fingers." (CCO
19 12:23-24.)

20 Both parties argue that the other reads the phrase "configured to fit" out of Claim 1.
21 H&B argues that the clear language of Claim 1 specifies where the member must be designed to
22 fit in the hand and the retainer simply clarifies the retainer's function. McHugh argues that the
23 member limitation only determines how the product is "designed," and the retainer limitation
24 determines where the member is actually located. Unfortunately, the parties stipulated
25 definition of "claimed to fit" as meaning "designed to fit" is not much clearer than the claimed
26 language. McHugh argues at length that "configured to fit" does not mean "precisely located
27 at," but provides little argument about what "configured to fit" actually means. McHugh argues
28 that the Bionic Gloves need only be *designed to fit* in the proximal digital crease, even if not

1 *actually located* in the proximal digital crease. However, McHugh has failed to show that the
2 gloves actually are designed to fit in the proximal digital crease.

3 McHugh essentially reads out the entire member location from Claim 1 because he
4 asserts that this Court should look only to the retainer limitation when determining the location
5 of the member. To this end, McHugh argues that the broader retainer definition, which
6 encompasses a region, rather than a specific location, defines the location of the member. The
7 Court has clearly stated that the “base of the user’s fingers is not a region, but rather a specific
8 location on the hand.” (CCO 11:17-18.) However, as already addressed, it is clear that the
9 bionic finger pads were both designed to, and actually fit, above (distal) to the proximal digital
10 crease.

11 McHugh also appears to argue that the Bionic Gloves need only be “capable” of filling
12 the gap. However, neither the claimed term, nor the claim construction, support a definition
13 that the Bionic Gloves be “capable” of filling the gap. Few courts have wrestled with the
14 definitions of “configured to fit” and “designed to fit.” This district has, however, determined
15 that the term “‘configured to’ embraces the concept of a device intentionally and specifically
16 made to act in a certain way.” *Boston Scientific v. Cordis Corp.*, 2006 WL 3782840, at *2
17 (N.D. Cal. Dec. 20, 2006). In that matter, the Court construed the claimed “adapted to” as
18 “configured to fit,” rather than “suitable for.” *Id.* Similarly, this Court finds that “configured to
19 fit” and “designed to fit” both refer to an intentional design.

20 Whether defined as “configured to fit” or “designed to fit,” such language cannot
21 abrogate the Court’s clear construction that the “base of the user’s fingers is not a region, but
22 rather a specific location on the hand.” (CCO 11:17-18.) The plain language of Claim 1 is
23 clear that the *member* limitation specifies the actual location of the *member*.

24 In addition, the prosecution history of the ’091 Patent indicates that the member
25 limitation was intended to designate where the member was designed to fit in the hand.
26 Throughout the prosecution of the ’091 Patent, McHugh made several limiting amendments
27 designed to clarify the location of the member before adding the retainer limitation. If the
28 *retainer* limitation was designed to clarify the location of the *member*, McHugh could have

1 included that limitation much earlier in the prosecution history when asked by the Examiner.
2 By contrast, McHugh waited to include the retainer limitation until the end of prosecution. (*See*
3 *Wytmsa Decl.*, Ex. 9 at 6.)

4 As evidenced by the plain language of Claim 1 and the prosecution history of the '091
5 patent, there is simply no merit to McHugh's contention that the *retainer* limitation was
6 intended to specify the location of the *member*, rather than the *member* limitation itself.

7 Under the Court's construction of the claims, the Court finds that no reasonable jury
8 could conclude that H&B's Bionic Gloves are "configured to fit at a base of the user's fingers in
9 a gap between a palm of the user's hand and the base of the user's fingers." ('091 Patent col.5
10 ll.14-17.) Accordingly, H&B is entitled to summary judgment in its favor.

11 **2. McHugh Cannot Show that H&B's Accused Devices Infringe the '091**
12 **Patent Under the Doctrine of Equivalents.**

13 "Under the doctrine of equivalents, 'a product or process that does not literally infringe
14 upon the express terms of a patent claim may nonetheless be found to infringe if there is
15 equivalence between the elements of the accused product or process and the claimed elements
16 of the patented invention.'" *Freedman Seating Co. v. Am. Seating Co.*, 420 F.3d 1350, 1357
17 (Fed. Cir. 2005) (quoting *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 21
18 (1997)).

19 The doctrine of equivalents thereby recognizes that:

20 [t]he language in the patent claims may not capture every nuance of the
21 invention or describe with complete precision the range of its novelty. If
22 patents were always interpreted by their literal terms, their value would be
23 greatly diminished. Unimportant and insubstantial substitutes for certain
24 elements could defeat the patent, and its value to inventors could be
destroyed by simple acts of copying. For this reason, the clearest rule of
patent interpretation, literalism, may conserve judicial resources but is not
necessarily the most efficient rule. The scope of a patent is not limited to
its literal terms but instead embraces all equivalents to the claims described.

25 *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 731 (2002) ("*Festo*
26 *VIII*").

27 Although a patentee is entitled to argue that an accused device is equivalent to his or her
28 claimed invention, the doctrine is not without limitations. H&B argues that the doctrine of

1 equivalents does not apply in this case because: (1) the Bionic finger pads do not serve the same
2 gap-filling function or achieve the same result as the member claimed in the '091 Patent; (2) a
3 finding that the finger pads infringe the '091 Patent would vitiate the claimed member's
4 location in the hand; and (3) prosecution history estoppel bars any claim of infringement by
5 equivalents. McHugh argues: (1) H&B has not submitted any admissible evidence to support
6 their contention that the bionic finger pads do not serve the same gap-filling function or achieve
7 the same result as the member claimed in the '091 Patent; and (2) the underlying rationale of the
8 narrowing amendment bore no more than a tangential relation to the equivalent at issue.

9 **a. Function-Way-Result Test.**

10 If an accused element “performs substantially the same function in substantially the
11 same way to obtain the same result,” then it is said to be equivalent to the claim limitation.
12 *Warner-Jenkinson Co.*, 520 U.S. at 38. H&B asserts that the Bionic finger pads do not serve
13 the same gap-filling function or achieve the same result as the member claimed in the '091
14 Patent. McHugh once again points to Dr. Kleinert's deposition, which identifies that both the
15 bionic finger pads and the proximal digital crease are located above the proximal phalanx A2
16 pulley. (Grewe Decl., Ex. QQ (Kleinert 6/23/09 Depo., 12:17-13:1, 17:6-18:7).) However, it
17 does not follow that the bionic finger pads must be located in the proximal digital crease. For
18 the same reasons discussed regarding literal infringement, Bionic finger pads are located above
19 (distal) the proximal digital crease.

20 During claim construction, this Court found that “McHugh's construction is too broad
21 because the proximal phalanx A2 pulley region encompasses not only the location where the
22 gap is formed, but the part of the finger above that location as well.” (CCO 11:13-15.) This
23 Court construed “base of the user's fingers” to mean “the location where the palm joins the
24 fingers.” (*Id.* at 11:21.) The patent explicitly states in several places that the grip is successful
25 because it is designed to fill a gap and prevent the ligament and associated muscle and skin
26 tissue from being forced over the fingers. ('091 Patent col.3 ll.19-22, col.1 ll.48-52, col.4 ll.49-
27 53; *see also* CCO 11:4-5.) “If the member were above both the palm and the base of the
28 fingers, it would not be able to separate the superficial transverse metacarpal ligament from the

1 fingers.” (CCO 11:15-16.) Because the Court has found that the Bionic finger pads rest *above*
2 the base of the fingers, the pads are unable to separate the superficial transverse metacarpal
3 ligament from the fingers.

4 Accordingly, the Bionic Gloves do not provide the same function as the subject matter
5 claimed by the '091 Patent.

6 **b. McHugh’s theory of equivalents vitiates the member element.**

7 H&B also asserts that the “all elements” rule limits the doctrine of equivalents in this
8 case because McHugh’s theory of equivalents vitiates the member element. “The ‘all elements’
9 rule attempts to balance the doctrine of equivalents with the basic patent law principle that
10 claim language defines the scope of an invention and every limitation is material.” *DePuy*
11 *Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 469 F.3d 1005, 1016 (Fed. Cir. 2006). Because
12 each element is material to defining the scope of an invention, the “doctrine of equivalents must
13 be applied to individual elements of the claim, not to the invention as a whole.” *Warner-*
14 *Jenkinson*, 520 U.S. at 29. Thus, the all elements rule mandates that a doctrine of equivalents
15 analysis “be assessed on a limitation-by-limitation basis, rather than from the perspective of the
16 invention as a whole, and that no limitation be read completely out of the claim.” *DePuy Spine*,
17 469 F.3d at 1016 (citing *Freedman Seating Co.*, 420 F.3d at 1358.). Thus, “under the particular
18 facts of a case, ... if a theory of equivalence would entirely vitiate a particular claim element,
19 partial or complete judgment should be rendered by the court.” *Warner-Jenkinson*, 520 U.S. at
20 39 n.8.

21 The Federal Circuit has noted that “[t]here is no set formula for determining whether a
22 finding of equivalence would vitiate a claim limitation, and thereby violate the all limitations
23 rule. Rather, courts must consider the totality of the circumstances of each case and determine
24 whether the alleged equivalent can be fairly characterized as an insubstantial change from the
25 claimed subject matter without rendering the pertinent limitation meaningless.” *Freedman*
26 *Seating*, 420 F.3d at 1359.

27 As addressed above, McHugh’s theory of literal infringement and infringement by
28 equivalents seeks to replace limiting language in the member limitation with broader language

1 in the retainer limitation. This Court expressly rejected McHugh’s contention that the member
2 be configured to fit at the proximal phalanx A2 pulley region. (CCO 11:11-19.) However,
3 because the retainer limitation only required that the retainer retain the member “adjacent to the
4 base of the user’s fingers,” this Court construed that term more liberally to mean “near the
5 proximal phalanx A2 pulley region of the user’s fingers.” (*Id.* at 12:22-24.)

6 McHugh may not pick and choose the term that is construed the most broadly to
7 determine the location of the claimed member. Accepting McHugh’s theory would vitiate the
8 limitation that the member be configured to fit “at a base of the user’s fingers” in “a gap
9 between the palm of the user’s hand” and “the base of the user’s fingers.” Accordingly, the
10 Court is not persuaded by McHugh’s argument based on the doctrine of equivalents.

11 **c. McHugh is barred by prosecution history estoppel.**

12 In *Festo VIII*, the Supreme Court noted that the application of the doctrine of equivalents
13 necessarily “renders the scope of patents less certain.” *Festo VIII*, 535 U.S. at 732. “Estoppel
14 is a ‘rule of patent construction’ that ensures that claims are interpreted by reference to those
15 ‘that have been cancelled or rejected.’” *Id.* at 733 (quoting *Schriber-Schroth Co. v. Cleveland*
16 *Trust Co.*, 311 U.S. 211, 220-21 (1940)). The doctrine of prosecution history estoppel therefore
17 works to achieve a balance between a patentee’s right to claim infringement by equivalents and
18 the public’s right to know the scope of a patent. If a “patentee originally claimed the subject
19 matter alleged to infringe but then narrowed the claim in response to a rejection, he may not
20 argue that the surrendered territory comprised unforeseen subject matter that should be deemed
21 equivalent to the literal claims of the issued patent.” *Id.* at 733-34; *see also Festo Corp. v.*
22 *Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1366 (Fed. Cir. 2003) (“*Festo IX*”).

23 Under the teachings of *Festo VIII* and *Festo IX*, prosecution history estoppel applies
24 where an amendment during prosecution narrows the literal scope of the claim. *See Festo IX*,
25 344 F.3d at 1366. “If the amendment was not narrowing, then prosecution history estoppel does
26 not apply.” *Id.* If, however, an “accused infringer establishes that the amendment was a
27 narrowing one, then the second question is whether the reason for that amendment was a
28 substantial one relating to patentability.” *Id.* If the answer to this question is yes, a

1 presumption arises that the patentee has “surrendered all territory between the original claim
2 limitation and the amended claim limitation.” *Id.* at 1367 (citing *Festo VIII*, 535 U.S. at 740).
3 “The standard for determining whether particular subject matter was relinquished is an
4 objective one that depends on what a competitor reasonably would conclude from the patent’s
5 prosecution history.” *Mark I Marketing, Corp. v. R.R. Donnelley & Sons Co.*, 66 F.3d 285, 291
6 (Fed. Cir. 1995); *cf. Festo IX*, 344 F.3d at 1369.

7 The party asserting prosecution history estoppel has the burden to establish that a
8 patentee made a narrowing amendment. If that party meets its burden, and the presumption of
9 surrender arises, the burden then shifts to the patentee to rebut the presumption of surrender by
10 demonstrating that: (1) an alleged equivalent was not foreseeable at the time of the amendment;
11 (2) the rationale underlying the narrowing amendment bears no more than a tangential
12 relationship to the equivalent in question; or (3) “some other reason suggesting that the patentee
13 could not reasonably be expected to have described the insubstantial substitute in question.”
14 *Festo IX*, 344 F.3d at 1369-70 (citing and quoting *Festo VIII*, 535 U.S. at 738, 740-41.)

15 “Issues relating to the application and scope of prosecution history estoppel, including
16 whether the presumption of surrender of subject matter has arisen and whether it has been
17 rebutted, are questions of law to be decided by the court.” *Biagro W. Sales, Inc. v. Grow More,*
18 *Inc.*, 423, F.3d 1296, 1301-02 (Fed. Cir. 2005) (citing *Festo IX*, 344 F.3d at 1368).
19 Furthermore, although rebuttal of the presumption of surrender may involve factual questions,
20 because those questions pertain to legal issues, the Court can resolve such issues on summary
21 judgment. *See Festo IX*, 344 F.3d at 1368 & n.3; *Biagro*, 423 F.3d at 1302.

22 Here, McHugh repeatedly amended Claim 1 to define the precise location of the member
23 and, therefore, McHugh cannot claim a broader definition based on the doctrine of equivalents.
24 McHugh initially submitted a broad claim that the member be “configured to fit adjacent to a
25 user’s superficial transverse metacarpal ligament and adjacent to a user’s finger.” (Wytsma
26 Decl. Ex. 2 at 8.) When that claim was rejected in light of prior art and the Examiner
27 encouraged McHugh to specify clearly the location of the member, McHugh settled on the final
28 claim language: “at a base of the user’s fingers” in “a gap between the palm of the user’s hand”

1 and “the base of the user’s fingers.” (*Id.* Ex. 9 at 1.) Because the amendments narrowed the
2 scope of Claim 1 to overcome prior art, McHugh has presumptively surrendered the territory
3 between the original Claim 1 and the amended Claim 1. *See Festo IX*, 344 F.3d at 1367
4 (holding that if an amendment narrows the scope of a claim for a reason related to patentability,
5 then the patentee has surrendered all territory between the original claim limitation and the
6 amended claim limitation).

7 McHugh does not appear to contest the presumption of surrender, but instead asserts that
8 the presumption is rebutted because it is the retainer limitation, not the member limitation that
9 defines the actual location of the member. Accordingly, McHugh contends that the narrowing
10 amendments to the member limitation bear no more than a tangential relation to the equivalent
11 at issue. As addressed above, the Court is not persuaded by this argument. It is clear from both
12 the plain language of Claim 1 as well as the prosecution history of the ’091 Patent, that the
13 member limitation defines the location of the member. The claim amendments are directly
14 related to the equivalent at issue.

15 Accordingly, the Court concludes that H&B has established that the *Festo* presumption
16 of surrender arises in this case and McHugh has not met its burden to rebut the *Festo*
17 presumption. Therefore, McHugh is barred from asserting infringement by equivalents.

18 For the foregoing reasons, “the evidence is such that no reasonable jury could determine
19 two elements to be equivalent.” *See Warner-Jenkinson*, 520 U.S. at 39 (citing Fed. R. Civ. P.
20 56; *Celotex*, 477 U.S. at 322-23)). H&B is entitled to summary judgment of non-infringement
21 under the doctrine of equivalents.

22 CONCLUSION

23 For the foregoing reasons, H&B’s motion for summary judgment of non-infringement
24 is GRANTED and McHugh’s motion for summary judgment is DENIED. A separate judgment
25 shall issue.

26 **IT IS SO ORDERED.**

27 Dated: February 24, 2010

28 

JEFFREY S. WHITE
UNITED STATES DISTRICT JUDGE