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NOT FOR PUBLICATION

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

MARK L. MCHUGH, an individual,

Plaintiff,

No. C 07-03677 JSW

v.

CLAIM CONSTRUCTION ORDER

HILLERICH & BRADSBY CO., a private
company,

Defendant.

_____ /

The Court has been presented with a technology tutorial and briefing leading up to a hearing pursuant to *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). This Order construes the eight claim terms selected by the parties, which appear in the patent at issue in this case, United States Patent No. 5,806,091 (the “’091 Patent”), entitled “Hand Grip Aid.”

BACKGROUND

Plaintiff Mark L. McHugh is an inventor of a hand grip aid for use with sports equipment, exercise equipment, manual work equipment, or any other equipment that has a handle. (’091 Patent, 1:7-9.) The ’091 Patent is directed to the field of technologies that prevent hand damage and discomfort when such handles are gripped for prolonged periods of time. The patent asserts that the prior art solutions for this damage and discomfort range from thick gloves to pads that protect a person’s hand. (1:21-23.) However, the patent asserts that the prior art solutions reduce the tactile feel of the hand. (1:25.) The ’091 Patent claims to be an improvement over the prior art because it provides a support to distribute the force from a

1 hand-held device onto the entire hand. (1:43-45.) Thus, the patent asserts that advantages of
2 the invention include reduced hand damage, improved comfort, a good tactile feel, and the
3 ability of the invention to be worn with a glove or without a glove. (1:57-62.) Hillerich &
4 Bradsby Co. (“H&B”) is a company that manufactures gloves which McHugh alleges embody
5 the claimed technology of the ’091 Patent.

6 ANALYSIS

7 A. Legal Standard.

8 “It is a bedrock principle of patent law that the claims of a patent define the invention to
9 which the patentee is entitled the right to exclude.” *Innova/Pure Water, Inc. v. Safari Water*
10 *Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004). The interpretation of the scope and
11 meaning of disputed terms in patent claims is a question of law and exclusively within the
12 province of a court to decide. *Markman*, 517 U.S. at 372. The inquiry into the meaning of the
13 claim terms is “an objective one.” *Innova/Pure Water*, 381 F.3d at 1116. As a result, when a
14 court construes disputed terms, it “looks to those sources available to the public that show what
15 a person of skill in the art would have understood the disputed claim language to mean.” *Id.* In
16 most cases, a court’s analysis will focus on three sources: the claims, the specification, and the
17 prosecution history. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995)
18 (en banc), *aff’d*, 517 U.S. 370 (1996). However, on occasion, it is appropriate to rely on
19 extrinsic evidence regarding the relevant scientific principles, the meaning of technical terms,
20 and the state of the art at the time at the time the patent issued. *Id.* at 979-981.

21 The starting point of the claim construction analysis is an examination of the specific
22 claim language. A court’s “claim construction analysis must begin and remain centered on the
23 claim language itself, for that is the language that the patentee has chosen to particularly point
24 out and distinctly claim the subject matter which the patentee regards as his invention.”
25 *Innova/Pure Water*, 381 F.3d at 1116 (internal quotations and citations omitted). Indeed, in the
26 absence of an express intent to impart a novel meaning to a term, an inventor’s chosen language
27 is given its ordinary meaning. *York Prods., Inc. v. Cent. Tractor Farm & Family Center*, 99
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1 F.3d 1568, 1572 (Fed. Cir. 1996). Thus, “[c]laim language generally carries the ordinary
2 meaning of the words in their normal usage in the field of the invention.” *Invitrogen Corp. v.*
3 *Biocrest Mfg., L.P.*, 327 F.3d 1364, 1367 (Fed. Cir. 2003); *see also Renishaw v. Marposs*
4 *Societa’ per Azioni*, 158 F.3d 1243, 1248 (Fed. Cir. 1998) (recognizing that “the claims define
5 the scope of the right to exclude; the claim construction inquiry, therefore, begins and ends in
6 all cases with the actual words of the claim”). A court’s final construction, therefore, must
7 accord with the words chosen by the patentee to mete out the boundaries of the claimed
8 invention.

9 The court should also look to intrinsic evidence, including the written description, the
10 drawings, and the prosecution history, if included in the record, to provide context and
11 clarification regarding the intended meaning of the claim terms. *Teleflex, Inc. v. Ficosa N. Am.*
12 *Corp.*, 299 F.3d 1313, 1324-25 (Fed. Cir. 2002). The claims do not stand alone. Rather, “they
13 are part of ‘a fully integrated written instrument.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315
14 (Fed. Cir. 2005) (en banc) (quoting *Markman*, 52 F.3d at 978). The specification “may act as a
15 sort of dictionary, which explains the invention and may define terms used in the claims.”
16 *Markman*, 52 F.3d at 979. The specification also can indicate whether the patentee intended to
17 limit the scope of a claim, despite the use of seemingly broad claim language. *SciMed Life Sys.,*
18 *Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001) (recognizing
19 that when the specification “makes clear that the invention does not include a particular feature,
20 that feature is deemed to be outside the reach of the claims of the patent, even though the
21 language of the claims, read without reference to the specification, might be considered broad
22 enough to encompass the feature in question”).

23 Intent to limit the claims can be demonstrated in a number of ways. For example, if the
24 patentee “acted as his own lexicographer,” and clearly and precisely “set forth a definition of
25 the disputed claim term in either the specification or prosecution history,” a court will defer to
26 that definition. *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002). In
27 order to so limit the claims, “the patent applicant [must] set out the different meaning in the
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1 specification in a manner sufficient to give one of ordinary skill in the art notice of the change
2 from ordinary meaning.” *Innova/Pure Water*, 381 F.3d at 1117. In addition, a court will adopt
3 an alternative meaning of a term “if the intrinsic evidence shows that the patentee distinguished
4 that term from prior art on the basis of a particular embodiment, expressly disclaimed subject
5 matter, or described a particular embodiment as important to the invention.” *CCS Fitness*, 288
6 F.3d at 1367. For example the presumption of ordinary meaning will give way where the
7 “inventor has disavowed or disclaimed scope of coverage, by using words or expressions of
8 manifest exclusion or restriction, representing clear disavowal of claim scope.” *Gemstar-TV*
9 *Guide Int’l Inc. v. ITC*, 383 F.3d 1352, 1364 (Fed. Cir. 2004). Likewise, the specification may
10 be used to resolve ambiguity “where the ordinary and accustomed meaning of the words used in
11 the claims lack sufficient clarity to permit the scope of the claim to be ascertained from the
12 words alone.” *Teleflex*, 299 F.3d at 1325.

13 However, limitations from the specification (such as from the preferred embodiment)
14 may not be read into the claims, absent the inventor’s express intention to the contrary. *Id.* at
15 1326; *see also CCS Fitness*, 288 F.3d at 1366 (“[A] patentee need not ‘describe in the
16 specification every conceivable and possible future embodiment of his invention.’”) (quoting
17 *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001)). To protect against this
18 result, a court’s focus should remain on understanding how a person of ordinary skill in the art
19 would understand the claim terms. *Phillips*, 415 F.3d at 1323.

20 If the analysis of the intrinsic evidence fails to resolve any ambiguity in the claim
21 language, a court then may turn to extrinsic evidence, such as expert declarations and testimony
22 from the inventors. *Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1367 (Fed. Cir. 2003)
23 (“When an analysis of *intrinsic* evidence resolves any ambiguity in a disputed claim term, it is
24 improper to rely on extrinsic evidence to contradict the meaning so ascertained.”) (emphasis in
25 original). When considering extrinsic evidence, a court should take care not to use it to vary or
26 contradict the claim terms. Rather, extrinsic evidence is relied upon more appropriately to
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1 assist in determining the meaning or scope of technical terms in the claims. *Vitronics Corp. v.*
2 *Conceptronic, Inc.*, 90 F.3d 1576, 1583-84 (Fed. Cir. 1996).

3 Dictionaries also may play a role in the determination of the ordinary and customary
4 meaning of a claim term. In *Phillips*, the Federal Circuit reiterated that “[d]ictionaries or
5 comparable sources are often useful to assist in understanding the commonly understood
6 meanings of words...” *Phillips*, 415 F.3d at 1322. The *Phillips* court, however, also
7 admonished that district courts should be careful not to allow dictionary definitions to supplant
8 the inventor’s understanding of the claimed subject matter. “The main problem with elevating
9 the dictionary to ... prominence is that it focuses the inquiry on the abstract meaning of the
10 words rather than on the meaning of claim terms within in the context of the patent.” *Id.* at
11 1321. Accordingly, dictionaries necessarily must play a role subordinate to the intrinsic
12 evidence.

13 In addition, a court has the discretion to rely upon prior art, whether or not cited in the
14 specification or the file history, but only when the meaning of the disputed terms cannot be
15 ascertained from a careful reading of the public record. *Vitronics*, 90 F.3d at 1584. Referring to
16 prior art may make it unnecessary to rely upon expert testimony, because prior art may be
17 indicative of what those skilled in the art generally understood certain terms to mean. *Id.*

18 **B. Claim Construction.**

19 **1. “member” or “elongated resilient member”**

20 Claim 1 of the ’091 Patent recites a “hand grip configured to fit in a user’s hand and for
21 use with a handled instrument, comprising: an elongated resilient member having an average
22 width of approximately 4-15 mm and an average thickness of approximately 1-10 mm.” (5:11-
23 15.) The word “member” also appears in Claims 5, 12, and 13. H&B argues that the entire
24 phrase “elongated resilient member” must be construed by this Court and that it should be
25 construed to mean “a long and narrow grip having a length greater than three times an average
26 width made of plastic, rubber, or other flexible material that extends across two or more
27 fingers.” (Joint Claim Construction and Pre-hearing Statement (“Statement”), Ex. A.)
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1 McHugh, on the other hand, argues that only the word “member” needs to be construed and that
2 it should be construed to mean “component.” (*Id.*) In the alternative, McHugh argues that the
3 phrase “elongated resilient member” should be construed to mean “long and thin elastic
4 component.” (*Id.*) Thus, because both parties offer proposed constructions for the term
5 “elongated resilient member,” the Court will construe this term.

6 Both parties contest each of the three words in the term “elongated resilient member.”
7 As always, the Court begins with an examination of the specific claim language of the patent to
8 determine the subject matter which the patentee regards as his invention. Claim 1 recites a
9 “hand grip ... comprising: an elongated resilient member ... and a retainer connected to the
10 member.” (5:11-18.) In the patent claim context the term “comprising” is well understood to
11 mean “including but not limited to.” *Cias, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1361
12 (Fed. Cir. 2007). Therefore, while McHugh’s hand grip must include a member and a retainer,
13 it may include other parts as well. However, if this Court were to adopt H&B’s proposed
14 construction that “member” means “grip,” then a reading of the patent would indicate that the
15 grip requires a grip and a retainer, which does not make sense because an object cannot be
16 defined as itself plus something else. In construing the meaning of a term in the claim we must
17 look at its context within the whole claim. *See ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082,
18 1088 (Fed. Cir. 2003) (the context of the surrounding words of the claim also must be
19 considered in determining the ordinary and customary meaning of those terms). Here, McHugh
20 chose to label it as a “member” in the claim language, not a “grip.” Reading the term “member”
21 in the context of the whole claim leads to the conclusion that “member” cannot mean “grip.”

22 Additionally, H&B directs the Court’s attention to several passages in the written
23 description which purportedly show that “member” should mean “grip.” (Opp. Br. at 19.) For
24 example, the patent in one part recites that the elongated resilient member has an undulated side
25 and in another part that the grip has one side with an undulating surface. (1:46-47; 2:46.)
26 However, this could mean that the grip has an undulating side *because* the member has an
27 undulating side. This interpretation would make sense if, as here, the grip is comprised of
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1 mostly a member and a retainer to keep the member attached to the hand. That both the
2 member and the grip have an undulating side does not necessarily mean the member and the
3 grip are the same thing. In any event, even if there were ambiguity in the specification as to
4 whether “member” meant “grip,” the clear language of the claims themselves indicate that
5 “member” does not mean “grip.” Furthermore, the specific claim language is more significant
6 that the specification in construing claim terms. “The written description part of the
7 specification itself does not delimit the right to exclude. That is the function and purpose of
8 claims.” *Markman*, 52 F.3d at 980. *See also Merrill v. Yeomans*, 94 U.S. 568 (1876) (holding
9 that the claims are of primary importance “in the effort to ascertain precisely what it is that is
10 patented”). Therefore, the Court finds that “member” does not mean “grip.”

11 H&B further argues that if the Court construes “member” to mean “component,” that
12 construction could potentially encompass pads, which H&B claims the ’091 Patent teaches
13 against. (Opp. at 20.) In this case, if the specification were to disparage all pads generally, the
14 claims could not be construed to encompass all pads generally. *See Honeywell Int’l, Inc. v. ITT*
15 *Indus., Inc.*, 452 F.3d 1312, 1319 (Fed. Cir. 2006) (where the specification makes clear that the
16 invention does not include a particular feature, that feature is deemed to be outside the reach of
17 the claims of the patent, even though the language of the claims, read without reference to the
18 specification, might be considered broad enough to encompass the feature in question).
19 However, the ’091 Patent does not disparage all pads, but merely pads that protect a person’s
20 palm. (1:23.) The invention here is designed to fit between the palm of the user’s hand and the
21 base of the user’s fingers. (5:16-17.) Thus, H&B’s argument here is without merit.

22 Next, H&B argues that an “elongated” member means that the member is “long and
23 narrow” and its length is “greater than three times an average width” such that the member
24 “extends across two or more fingers.” (Statement, Ex. A.) Conversely, McHugh argues that
25 “elongated” should mean “long and thin.” Again, the Court looks to the specific claim language
26 in the patent first. Here, the claim language indicates that “elongated” does not necessarily
27 mean what H&B suggests. In Claim 1, even though “elongated” is used, Claim 1 does not have
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1 a specific length limitation. However, in Claim 16, the member is described as “elongated” but
2 the claim does include a specific length requirement of “a total length greater than three times
3 an average thickness and greater than three times an average width.” (6:19-21.) Thus, the
4 claim language indicates that the term “elongated” is not tied to a specific length limitation.

5 Next, the Court may look to the specification to provide insight as to how to construe the
6 claim terms. *See Markman*, 52 F.3d at 979. The written description indicates that in other
7 embodiments of the invention, the grip may fit next to one, two, or three fingers rather than
8 four. (4:21-22.) “This embodiment may be useful where a handle grip area is particularly small
9 and where only a small grip 30 can be accommodated.” (4:24-26.) Thus, the written
10 specification suggests that it is possible for an embodiment of the invention to be fitted for use
11 under the smallest finger, where the length of the grip may be shorter than three times the
12 average thickness and three times the average width. Further, the specification describes an
13 embodiment that may be used on one finger, which contradicts H&B’s requirement that the
14 member extend across two or more fingers.

15 H&B argues that during the prosecution of the patent McHugh narrowed his claims in
16 order to avoid prior art and therefore he should not now be allowed to broaden his claims to
17 capture abandoned subject matter. Specifically, H&B points out that in prosecution of the
18 patent, McHugh stated that “elongated member” means that the member has a total length
19 greater than three times an average thickness and greater than three times an average width.
20 (Opp. Br., Ex. 8.) Meanwhile, McHugh points out that in a response to an Office Action,
21 McHugh stated that “elongated” means “long and narrow.” (Reply at 5.) Ultimately, McHugh
22 abandoned the length limitation language for the current width and thickness limitations at the
23 recommendation of the examiner. (Brief, Ex. 9.) In this case, the Court does not need to look
24 to the prosecution history because the claim language and the written description are sufficient
25 to determine what “elongated” means.

26 Lastly, both parties dispute the meaning of “resilient.” McHugh argues for a proposed
27 construction of only the term “elastic” and H&B argues for a proposed construction of “plastic,
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1 rubber, or other flexible material.” On this point, neither party’s arguments are very persuasive.
2 McHugh refers to extrinsic evidence such as dictionaries to support its proposed construction,
3 without referring to any intrinsic evidence. H&B argues that the specification provides insight
4 as to how “resilient” should be construed. The patent summary states that the “member can be
5 constructed of plastic, rubber, or other material that provides flexibility and easily
6 accommodates the user’s fingers.” (1:52-54.) Further, the written description states that “[a]ny
7 type of resilient material, such as plastic or rubber, can be used for the invention.” (2:64-65.)
8 H&B attempts to hybridize these two statements to show that “resilient” means “plastic, rubber,
9 or other flexible material.” However, a close reading of the written description demonstrates
10 that this interpretation is incorrect. First, limiting “resilient” to plastic or rubber is an improper
11 limitation of the claim language. “Limitations from the specification (such as from the
12 preferred embodiment) may not be read into the claims, absent the inventor’s express intention
13 to the contrary.” *Teleflex*, 299 F.3d at 1326; *see also CCS Fitness*, 288 F.3d at 1366. Secondly,
14 the patentee does describe “resilient material” in the specification, but does not mention
15 anything about “flexible material.” Thus, the specification does not clearly set forth what
16 “resilient” materials are. McHugh offers several dictionary definitions for resilient, such as
17 “that which returns to its original shape following a deformation in shape.” (Brief at 9.) In the
18 absence of clear language in intrinsic evidence, the Court may look to external evidence for
19 guidance. Surveying many dictionaries, McHugh finds a general consensus as to how a person
20 would interpret “resilient,” and the Court adopts this definition.

21 Accordingly, the Court construes the term “member” to mean: “long and thin
22 component which returns to its original shape following a deformation in shape.”

23 **2. “configured to fit”**

24 McHugh asserts that this term does not require construction, while H&B asserts that it
25 does. H&B contends that whether or not there is an ultimate finding of infringement of the ’091
26 Patent depends at least partly on a determination of what “configured to fit” means. “Victory in
27 an infringement suit requires a finding that the patent claim covers the alleged infringer’s
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1 product or processes, which in turn necessitates a determination of what the claim terms mean.”
2 *Markman*, 517 U.S. at 374. Thus, this Court will construe the term “configured to fit.”

3 Although McHugh asserts that this term does not require construction, to the extent that
4 it does, McHugh argues that “configured to fit” should mean “designed to fit.” H&B also agrees
5 to this construction. Accordingly, the Court adopts both parties’ proposed construction and
6 construes the term “configured to fit” to mean: “designed to fit.”

7 **3. “base of the user’s fingers”**

8 McHugh asserts that this term does not require construction, while H&B asserts that it
9 does. Nevertheless, because there is a controversy regarding this term, this Court will construe
10 the term “base of the user’s fingers.” *See Markman*, 517 U.S. at 374.

11 Claim 1 of the patent recites a hand grip comprising an elongated resilient member that
12 is “configured to fit at a base of the user’s fingers in a gap between the palm of the user’s hand
13 and the base of the user’s fingers.” (5:15-17.) McHugh’s proposed construction for “base of
14 the user’s fingers” is “over the proximal phalanx A2 pulley region of the user’s fingers.”
15 H&B’s proposed construction is “the location where the palm joins the fingers.”

16 The primary controversy regarding this term is whether “base of the user’s fingers”
17 refers to the specific location where the palm joins the fingers or whether “base” should be
18 construed more broadly to include the entire area over the proximal phalanx A2 pulley region of
19 the user’s fingers. The location where the palm joins the fingers is within the area over the
20 proximal phalanx A2 pulley region of the finger. (Brief at 21.) As always, the Court begins its
21 analysis with the language of the claim itself. The claim states that the elongated resilient
22 member is supposed to fit “at the base of the user’s fingers ... in a gap between a palm of the
23 user’s hand and the base of the user’s fingers.” (5:15-17.) Here, the claim language indicates
24 that the gap is not a separate location apart from the base of the user’s fingers or the palm of the
25 user’s hand. Instead, the gap is formed by an interaction of the fingers and the palm. This
26 conclusion is further supported by the written description. The written description states that
27 when users grip any equipment with a handle, the superficial transverse “metacarpal ligament,
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1 along with associated muscle and skin tissue, [is] forced over the fingers.” (1:50-51.) When the
2 skin above the superficial transverse metacarpal ligament rubs the skin near the base of the
3 fingers, the skin “often becomes blistered or callused with repetitive use of hand-held
4 equipment.” (2:40-41.) The invention is designed to fill this gap and prevent the ligament and
5 associated muscle and skin tissue from being forced over the fingers.

6 The Court finds that H&B’s construction is more persuasive, as its construction is
7 supported by the written description. The written description indicates that the patented
8 invention “fits in the user’s hand near where the palm joins the fingers.” (1:43-44.) As the
9 claim states that the elongated member is configured to fit at the base of the user’s fingers, this
10 is clear evidence that the base of the fingers is where the palm joins the fingers.

11 McHugh’s proposed construction also provides for this placement because the location
12 at which the palm joins the fingers is contained within the proximal phalanx A2 pulley region.
13 However, McHugh’s construction is too broad because the proximal phalanx A2 pulley region
14 encompasses not only the location where the gap is formed, but the part of the finger above that
15 location as well. If the member were above both the palm and the base of the fingers, it would
16 not be able to separate the superficial transverse metacarpal ligament from the fingers. Thus,
17 the claim language and the written description indicate that the base of the user’s fingers is not a
18 region, but rather a specific location on the hand. Most importantly, McHugh’s construction is
19 not supported by the patent claims or the intrinsic evidence of the patent.

20 Accordingly, the Court adopts H&B’s proposed construction and construes the term
21 “base of the user’s fingers” to mean: “the location where the palm joins the fingers.”

22 **4. “adjacent to the base of the user’s fingers”**

23 McHugh asserts that this term does not require construction, while H&B asserts that it
24 does. Nevertheless, as there is a controversy regarding this term, this Court will construe the
25 term “adjacent to the base of the user’s fingers.” *See Markman*, 517 U.S. at 374.

26 Claim 1 further goes on to recite that a “retainer connected to the member ... [retains] the
27 member in the user’s hand adjacent to the base of the user’s fingers.” (5:18-21.) As the Court
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1 has already construed “base of the user’s fingers” to mean “the location where the palm joins
2 the fingers,” it is now up to the Court to determine what it means to be adjacent to “the location
3 where the palm joins the fingers.” McHugh contends that it should mean “near the proximal
4 phalanx A2 pulley region of the user’s fingers” while H&B contends that it should mean “below
5 the base of the user’s fingers.”

6 The claim language indicates that the member is “configured to fit at a base of the user’s
7 fingers ... and a retainer [retains] the member in the user’s hand adjacent to the base of the
8 user’s fingers.” (5:15-21.) H&B’s proposal that the base of the user’s fingers is the location
9 where the palm joins the fingers is adopted by the Court because it allows for the member to sit
10 in the gap formed at the base of the user’s fingers. However, if the Court were to adopt H&B’s
11 proposed construction for “adjacent to the base of the user’s finger,” the member would be both
12 at the base of the user’s fingers and below the base of the user’s fingers. This construction does
13 not make sense.

14 On the other hand, McHugh’s proposed construction is supported by the specification.
15 The specification indicates that “adjacent” should mean “near.” The written description states
16 that the “hand grip fits in the user’s hand near where the palm joins the fingers.” (1:43-44.)
17 Additionally, as stated above the proximal phalanx A2 pulley region encompasses the “location
18 where the palm joins the fingers.” Most importantly, if the member is located “near the
19 proximal phalanx A2 pulley region of the user’s fingers,” this placement specification is broad
20 enough to allow the member to fit in the gap between the base of the user’s fingers and the palm
21 of the hand.

22 Accordingly, the Court adopts McHugh’s proposed construction and construes the term
23 “adjacent to the base of the user’s fingers” to mean: “near the proximal phalanx A2 pulley
24 region of the user’s fingers.”

25 **5. “in a gap” or “in a gap between a palm of the user’s hand and the base of
26 the user’s fingers.”**

27 Claim 1 recites that the elongated resilient member is “configured to fit at a base of the
28 user’s fingers in a gap between a palm of the user’s hand and the base of the user’s fingers.”

1 (5:15-17.) McHugh proposes that “in a gap” should mean “in the proximal digital crease of the
2 user’s hand.” On the other hand, H&B proposes that “in a gap between a palm of the user’s
3 hand and the base of the user’s fingers” should mean “filling the space or void above the palm
4 of the hand and below the base of the fingers to prevent the superficial transverse metacarpal
5 ligament, associated tissue, and skin of the palm extending over the base of the fingers when a
6 handle is grasped.”

7 This Court adopted H&B’s proposed construction for “base of the user’s finger’ above
8 as “the location where the palm joins the fingers” and that the gap was not below the base of the
9 fingers and above the palm, but rather formed by an interaction between the finger and the
10 palm. This conclusion was supported by the patent’s written description. H&B’s proposed
11 construction for “in gap between a palm of the user’s hand and the base of the user’s fingers” is
12 problematic because there is no “space or void between a palm of the user’s hand and the
13 [location where the palm joins the fingers].” The Court must construe terms so that their usage
14 is consistent throughout the patent. See *Phillips*, 415 F.3d at 1314. Therefore, this Court rejects
15 H&B’s construction of “in a gap between a palm of the user’s hand and the base of the user’s
16 fingers.” On the other hand, the Court finds that McHugh’s description of the gap as the
17 “proximal digital crease of the user’s hand” is more consistent with the Court’s construction of
18 “base of the users finger.”

19 Accordingly, the Court adopts McHugh’s proposed construction and construes the term
20 “in a gap” to mean: “in the proximal digital crease of the user’s hand.”

21 **6. “retainer” or “a retainer connected to the member”**

22 Claim 1 recites an elongated resilient member and a “retainer connected to the member
23 and configured to ... retain the member in the user’s hand adjacent to the base of the user’s
24 fingers.” (5:18-21.) H&B argues that “a retainer connected to the member” should be
25 construed to mean “an elastic band, strap, or T-shaped brace connected to the grip.” McHugh
26 contends that only the word “retainer” needs to be construed, and argues that it should be
27 construed to mean “hand grip element for positioning and retaining the member.”
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1 This Court has found that “member” does not mean “grip.” As it would be lead to a
2 nonsensical construction of the patent terms, this Court cannot adopt H&B’s proposed
3 construction for “a retainer connected to the member.” Additionally, even if the Court replaced
4 “grip” in H&B’s proposed construction with “member,” H&B’s proposed construction would
5 still be incorrect. The controversy regarding this term focuses on whether the patentee intended
6 to limit the scope of his claims through the specification.

7 Dependent Claim 5 recites “A hand grip as in claim 1, wherein: the retainer is a glove
8 configured to secure around user’s fingers and including an attachment to retain the elongated
9 member in a position adjacent to the base of the user’s fingers.” (5:36-40.) In this claimed
10 embodiment, the glove is the retainer and “extend[s] around to the backside of at least one of
11 the user’s fingers.” (1:19-20.) Furthermore, the glove is connected to the member though an
12 attachment to retain and position the member. (5:38-39.) However, H&B argues that the grip
13 must be capable of use with or without a glove because the patent specification states that a key
14 advantage of the invention is the ability to use the grip with or without a glove. (Opp. at 32.)
15 Therefore, H&B contends that “retainer” cannot be construed to include a glove. (*Id.*)

16 It is established case law that when the specification “makes clear that the invention
17 does not include a particular feature, that feature is deemed to be outside the reach of the claims
18 of the patent, even though the language of the claims, read without reference to the
19 specification, might be considered broad enough to encompass the feature in question.” *SciMed*
20 *Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001). In
21 this case, however, it cannot be said that the specification makes clear that the retainer does not
22 include a glove. The summary of the invention states that “[a]nother advantage of the invention
23 is that it can be worn with a glove or without a glove and still achieve the same beneficial
24 results or built directly into a glove or part of a glove for ease of use and convenience.” (1:59-
25 62.) This is not a clear disavowal of the particular feature of use with a glove. Instead, the
26 specification merely states that in one embodiment of the invention, the grip may be worn
27 without glove or under a glove, or as a part of a glove.

1 H&B points to a section in the specification which states that “Grip 20 may also be used
2 with a glove if desired. For example, grip 20 can be placed between a glove and a handle ... or
3 inside the glove closer to the user’s hand.” (3:53-56.) H&B argues that the “grip” (which
4 includes the member and the glove as a retainer) cannot be placed between a glove and a
5 handle, as this would essentially be a glove placed between a glove and a handle. (Opp. Br. at
6 32.) However, H&B conflates two different embodiments of the invention. Here, the patentee
7 merely states that the invention of Claim 1 may be worn outside of or inside of a glove. Thus,
8 “Grip 20 may also be used with a glove, if desired.” (3:53-54.) This embodiment is different
9 from the embodiment where the retainer is a glove. The specification has not made clear that
10 the retainer cannot be a glove and therefore the Court will not limit the explicit language of the
11 claims.

12 Accordingly, the Court adopts McHugh’s proposed construction and construes the term
13 “retainer” to mean: “hand grip element for positioning and retaining the member.”

14 **7. “to retain the member”**

15 McHugh asserts that this term does not require construction, while H&B asserts that it
16 does. (Statement at 13.) However, H&B did not provide any argument to support its
17 construction. As it appears that both parties stipulate that no construction is necessary, the
18 Court will decline to provide one.

19 **8. “attachment”**

20 Claim 5 recites a “handgrip as in claim 1, wherein the retainer is a glove configured to
21 secure around the user’s fingers and including an attachment to retain the elongated member in
22 a position adjacent to the base of the user’s fingers.” (5:36-40.) Claim 13 recites a similar
23 usage of the term. McHugh argues that “attachment” should mean “glove component which
24 secures the member to the glove.” Conversely, H&B argues that “attachment” should mean “a
25 strap or long thin pocket.”

26 In determining the meaning of disputed patent terms, as always the Court begins with
27 the claim language first. Here, the patent claim does not support McHugh’s contention that the
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1 attachment secures the member to the glove. Instead, the claim states that the attachment
2 retains the “member to the ... base of the user’s fingers.” (*Id.*) This concept is made clear by
3 the written description, which states that the glove material “includes attachment 52a and 52b to
4 hold grip 20 in place over the base of the fingers.” (4:34-36.) H&B’s construction is more
5 compatible with the claim language as well. Figure 5 of the patent states that “attachments 52a
6 and 52b are elastic straps that retain the grip 20. Alternatively, an attachment can be a single
7 strap, a long thin pocket, or other similar retainer.” (4:36-38.) Here, the Court finds that
8 McHugh was acting as his own lexicographer and, as such, his definition is accepted. H&B’s
9 construction, however, omits the “or other similar retainer” language found in the patent
10 specification. This is an improper limitation of the patent claims.

11 Accordingly, the Court construes the term “attachment” to mean: “a strap or long thin
12 pocket or other similar retainer.”

13 **9. “includes a plurality of sub-members”**

14 McHugh asserts that this term does not require construction, while H&B asserts that it
15 does. Nevertheless, as there is a controversy regarding this term, this Court will construe the
16 term “includes a plurality of sub-members.” *See Markman*, 517 U.S. at 374.

17 Claim 12 of the patent claims a grip as in Claim 1, wherein “the elongated member
18 includes a plurality of sub-members each configure to fit adjacent to the base of the user’s
19 fingers.” (6:1-3.) McHugh argues that no construction is required, but to the extent that a
20 construction is required, it should mean “includes two or more sub-members.” H&B argues
21 that “includes a plurality of sub-members” should mean “includes two or more small grips
22 incorporated into the long and narrow grip.”

23 The Court has already found that “member” does not mean “grip.” However, even
24 substituting “member” for “grip” in H&B’s construction, does not make it more correct. Claim
25 12 refers to an embodiment of the invention wherein the grip is actually segmented into
26 multiple separate grips, each designed to fit at the base of the user’s fingers. In the patent
27 specification, Figure 5B shows a “glove 54 here grip 20 is broken up into four small grips 56a-d
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that provide support to one finger each. This is accomplished by incorporating four grips ... into each of the four fingers of a glove near the base of the fingers, as shown.” (4:39-44.)
Therefore, in this embodiment of the invention, the member is actually composed of two or more sub-members. Both McHugh and H&B offer constructions which state that the member “includes” sub-members, but this is confusing because it is unclear under both proposed constructions whether the member has sub-members attached to it, or whether the member is composed of sub-members. The patent specification clearly indicates that in this embodiment, the member is composed of sub-members. (*Id.*)

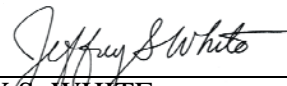
Accordingly, the Court the term “includes a plurality of sub-members” to mean: “is composed of two or more sub-members.”

CONCLUSION

Based on the analysis set forth above, the Court adopts the foregoing constructions of the disputed terms and phrases. The parties are ordered to submit a further joint case management report pursuant to Patent Standing Order ¶ 13 by no later than April 24, 2009.

IT IS SO ORDERED.

Dated: March 31, 2009



JEFFREY S. WHITE
UNITED STATES DISTRICT JUDGE