

UNITED STATES DISTRICT COURT
DISTRICT OF NEVADA

AEVOE CORP., a California corporation,)
)
Plaintiff,)
vs.)
AE TECH CO., LTD., a Taiwan corporation;)
S&F Corporation dba SF PLANET)
CORPORATION, a Minnesota corporation,)
and GREATSHIELD INC., a Minnesota)
corporation,)
Defendants.)

Case No.: 2:12-cv-00053-GMN-RJJ

ORDER

Pending before the Court are the proposed claim constructions submitted by Plaintiff Aevoe Corp. (“Plaintiff”) and Defendants AE Tech Co., Ltd., S&F Corporation, and GreatShield, Inc. (collectively, “Defendants”). Plaintiff filed its Opening Brief on November 19, 2012. (ECF No. 157.) Defendants also filed a brief styled as an Opening Brief on November 19, 2012. (ECF No. 159.) Subsequently, on December 5, 2012, Defendants filed a Response to Plaintiff’s Opening Claim Construction Brief. (ECF No. 171.) In response, on December 12, 2012, Plaintiff filed a Motion to Strike Defendants’ Unauthorized Opening Claim Construction Brief because it was not authorized by Local Rule 16.1-16. (ECF No. 182) On December 12, 2012, Plaintiff also filed its Reply Brief. (ECF No. 183.) The Court subsequently denied Plaintiff’s Motion to Strike and construed Defendants’ “Opening Brief” as its Responsive Brief. (See ECF No. 186.) Thus, the Court will not consider Defendant’s Response Brief. A Markman Claim Construction Hearing was held on February 5, 2013.

This is an Order construing the disputed terms of the claims in United States Patent No. 8,044,942 (“the ’942 Patent”). The parties have submitted nine (9) terms and phrases for construction. (See Joint Statement 2:13-5:22, ECF No. 120.) In addition, the parties agree on

1 the interpretation of six (6) additional terms. (See *id.* at 2:3-10.) The Court will adopt the
2 proposed claim construction for the six terms on which the parties agree, as reflected herein.

3 After consideration of the briefs and material submitted by the parties, the arguments of
4 counsel at the claim construction hearing, and the record before the Court, the Court issues this
5 Order construing the disputed claim terms.

6 **I. BACKGROUND**

7 Plaintiff Aevoe Corp. (“Plaintiff”) is the sole owner of the ’942 Patent entitled “Touch
8 Screen Protector.” (Am. Compl. ¶¶ 13-14, ECF No. 44.) Plaintiff is a California corporation (*id.*
9 at ¶ 6) that “markets and sells products embodying the ’942 Patent throughout the United States”
10 (*id.* at ¶ 15). The invention of the ’942 Patent relates to a touch screen protector for hand-held
11 electronic devices. U.S. Patent No. 8,044,942, at [57] (filed June 14, 2011). Specifically, the
12 ’942 Patent discloses to a touch screen protector that does not physically contact the touch
13 screen portion of the device. *Id.* Additionally, the touch screen protector disclosed in the ’942
14 Patent is “easily attached and removed” from the hand held device. ’942 Patent, col.1, ll.10-13.

15 In this action, Plaintiff alleges that three defendants infringed the ’942 Patent. First,
16 Plaintiff alleges that Defendant AE Tech (“AE Tech”) is a Taiwan corporation (*id.* at ¶ 7) that
17 “manufactures, imports, advertises, sells, and offers to sell products . . . that infringe the ’942
18 Patent” (*id.* at ¶ 16). Second, Plaintiff alleges that Defendant S&F Corporation (“S&F”) is a
19 Minnesota corporation that does business as SF Planet Company (“SF Planet”) (collectively,
20 “S&F Defendants”). (*Id.* at ¶¶ 7-8.) The S&F Defendants allegedly “import, advertise, sell, and
21 offer to sell products . . . that infringe the ’942 Patent.” (*Id.* at ¶ 17.) Third, Plaintiff alleges that
22 Defendant GreatShield is a Minnesota corporation that is a corporate affiliate of the S&F
23 Defendants. (*Id.* at ¶¶ 11-12.) Plaintiff further alleges the S&F Defendants “operate an
24 Amazon.com storefront” through which they sell the AE Tech products that allegedly infringe
25 the ’942 Patent. (*Id.* at ¶¶ 30-31.)

1 In response to the Defendants' allegedly infringing activities, Plaintiff filed the instant
2 action on January 11, 2012, alleging infringement of the '942 Patent. (See Compl., ECF No. 1.)
3 Plaintiff filed a motion for preliminary injunction. (ECF No. 3.) The Court granted that motion
4 and entered a Preliminary Injunction on January 24, 2012. (ECF No. 16.) Subsequently, on
5 March 14, 2012, Plaintiff filed its First Amended Complaint. (See Am. Compl., ECF No. 44.)

6 **II. LEGAL STANDARD**

7 The resolution of patent infringement actions generally requires two distinct steps. First,
8 the Court engages in a claim construction analysis to "determin[e] the meaning and scope of the
9 patent claims asserted to be infringed." *Markman v. Westview Instruments, Inc.*, 52 F.3d 967,
10 976 (Fed. Cir. 1995) (en banc), aff'd 517 U.S. 370 (1996). Only once the claims are properly
11 construed does the action proceed to the second step, in which the factfinder compares those
12 properly construed claims to the accused device to determine, as a matter of fact, whether all of
13 the claim limitations are present in the accused device. *Id.* At the current stage of this patent
14 infringement action, the Court focuses only on the first step.

15 **A. Claim Construction**

16 "It is a bedrock principle of patent law that the claims of a patent define the invention to
17 which the patentee is entitled the right to exclude." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312
18 (Fed.Cir.2005) (en banc) (citations and internal quotation marks omitted). The interpretation of
19 the scope and meaning of disputed terms in patent claims is a question of law and exclusively
20 within the province of a court to decide. *Markman*, 517 U.S. at 372. When construing disputed
21 claim terms, the Court must give each disputed term "the meaning that the term would have to a
22 person of ordinary skill in the art at the time of the invention," unless the patentee clearly
23 intended a different definition. *Phillips*, 415 F.3d at 1312-13. Furthermore, "the person of
24 ordinary skill in the art is deemed to read the claim term not only in the context of the particular
25 claim in which the disputed term appears but in the context of the entire patent, including the

1 specification.” Id. at 1313.

2 In certain cases, “the ordinary meaning of claim language as understood by a person of
3 skill in the art may be readily apparent even to lay judges, and claim construction in such cases
4 involves little more than the application of the widely accepted meaning of commonly
5 understood words.” Id. at 1314. In other instances, the claim term may have a particular
6 meaning in the field of art that is not immediately clear. Id. In such cases, the Federal Circuit
7 has instructed that a court’s analysis should focus on the intrinsic evidence, including “the words
8 of the claims themselves, the remainder of the specification, the prosecution history, and
9 extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and
10 the state of the art.” Id. at 1314. “[T]he claims themselves provide substantial guidance as to the
11 meaning of particular claim terms.” Id. “Other claims of the patent in question, both asserted
12 and unasserted, can also be valuable sources of enlightenment as to the meaning of a claim
13 term.” Id. Specifically, differences between the claims often provide useful guidance in
14 understanding the meaning of the claim terms. Id. “For example, the presence of a dependent
15 claim that adds a particular limitation gives rise to a presumption that the limitation in question
16 is not present in the independent claim.” Id. at 1314–15.

17 The claims, however, are not read in isolation, but are read in light of the entire
18 specification, of which the claims are a part. Id. In fact, the specification is “the single best
19 guide to the meaning of a disputed term.” *Vitronics Corp. v. Conceptronc, Inc.*, 90 F.3d 1576,
20 1582 (Fed. Cir. 1996). Courts can also look to the prosecution history as part of “intrinsic
21 evidence” to determine how the Patent Office and the inventor understood the patent. *Phillips*,
22 415 F.3d at 1317. However, the prosecution history lacks the clarity of the specification and
23 more often is less useful for claim construction purposes. Id.

24 Finally, extrinsic evidence may also be relevant to claim construction. Id. Extrinsic
25 evidence “consists of all evidence external to the patent and prosecution history, including

1 expert and inventor testimony, dictionaries, and learned treatises.” Markman, 52 F.3d at 980.
2 Although such evidence may aid the Court in construing claim terms, “it is unlikely to result in a
3 reliable interpretation of patent claim scope unless considered in the context of the intrinsic
4 evidence.” Phillips, 415 F.3d at 1319. Thus, “while extrinsic evidence can shed useful light on
5 the relevant art, . . . it is less significant than the intrinsic record in determining the legally
6 operative meaning of claim language.” Phillips, 415 F.3d at 1317 (citations and internal
7 quotation marks omitted).

8 **B. Doctrine of Claim Differentiation**

9 In Phillips, the Federal Circuit also instructed that “[d]ifferences among claims can also
10 be a useful guide in understanding the meaning of particular claim terms.” 415 F.3d at 1314
11 (citation omitted). “The doctrine of claim differentiation stems from ‘the common sense notion
12 that different words or phrases used in separate claims are presumed to indicate that the claims
13 have different meanings and scope.’” *Seachange Int’l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1368
14 (Fed. Cir. 2005) (quoting *Karlin Tech. Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72
15 (Fed.Cir.1999)). The doctrine of claim differentiation frequently arises when a party attempts to
16 construe a claim term that appears in an independent claim in a way that includes a limitation
17 that is claimed in a dependent claim. See 35 U.S.C. § 112(d) (“[A] claim in dependent form shall
18 contain a reference to a claim previously set forth and then specify a further limitation of the
19 subject matter claimed”). However, when a limitation is introduced in a dependent claim, courts
20 presume that the same limitation is absent from the independent claim from which the dependent
21 claim depends. Phillips, 415 F.3d at 1314 (citation omitted); *Liebel-Flarsheim Co. v. Medrad,*
22 *Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004) (citations omitted). In fact, in *Liebel-Flarsheim*, the
23 Federal Circuit expressly stated that “[i]n such a setting, where the limitation that is sought to be
24 ‘read into’ an independent claim already appears in a dependent claim, the doctrine of claim
25 differentiation is at its strongest.” 358 F.3d at 910; see also *Baldwin Graphic Sys., Inc. v.*

1 Siebert, Inc., 512 F.3d 1338, 1345-46 (Fed. Cir. 2008) (refusing to “bootstrap a temporal
2 restraint” on a method step when no such limitation was expressed in either independent claim,
3 but was instead featured in a dependent claim).

4 **III. CONSTRUCTION OF THOSE TERMS ON WHICH THE PARTIES AGREE**

5 In their Joint Claim Construction and Prehearing Statement, the parties submitted agreed
6 upon proposed constructions for six (6) claim terms. (Joint Statement 2:2-10, ECF No. 120.)

7 The Court hereby adopts those proposed constructions as follows:

8 ***“Touch screen”*** shall be construed as “an interactive screen with both input and display
9 functionality that a user touches in order to operate an electronic device.”

10 ***“Touch screen portion”*** shall be construed as “the operable portion of the touch screen.”

11 ***“Hand held electronic device”*** shall be construed as “an electronic device designed to be
12 operated while being held in the hand.”

13 ***“Interference patterns”*** shall be construed as “optical artifacts such as Newton rings and
14 color changes caused by interference.”

15 ***“Non-functional band”*** shall be construed as “the area that surrounds a touch screen
16 portion of a hand held electronic device which is made of a different material or made of the
17 same material as a touch screen but is not touch sensitive.”

18 ***“Adhesively mounted”*** shall be construed as “attached or adhered by an adhesive.”

19 **IV. CONSTRUCTION OF THE DISPUTED CLAIM TERMS**

20 The parties dispute the construction of nine (9) terms: (1) spacer; (2) continuously
21 surrounding; (3) transparent window; (4) enclosed air space; (5) removably mounting;
22 (6) provided along the outer perimeter; (7) coating; (8) micro-particles; and (9) adhesive strip.

23 Terms one through six are present in independent Claim 1. The disputed claim terms are
24 highlighted below. Claim 1:

25 A touch screen protector for a hand held electronic device having a front face that
includes a touch screen portion and an outer perimeter comprising:

1 a plastic film having front and back sides, an outer perimeter that corresponds
2 to that of the device, and a transparent window that corresponds in size to the
3 touch screen portion; and
4 a spacer provided along the outer perimeter of the plastic film continuously
5 surrounding the transparent window, having a thickness sufficient to space
6 the plastic film near but not in contact with the touch screen portion, and an
7 exposed adhesive for removably mounting the protector upon the outer
8 perimeter of the front face to form an enclosed air space between the
9 transparent window of the plastic film, the spacer and the touch screen
10 portion of the device;
11 wherein the window can be pressed against the touch screen portion for
12 operation of the electronic device while preventing direct contact of a user's
13 fingers with the touch screen portion and without producing visible
14 interference patterns during use.

15 Term seven, "coating," is present only in dependent Claim 15, which depends from Claim 1.

16 The disputed claim term is highlighted below. Claim 15:

17 The touch screen protector of claim 1, wherein the transparent window is clear but
18 includes a coating that provides a matte effect or a privacy screen feature.

19 Term eight, "micro-particles," is present in dependent Claim 5 and dependent Claim 6. Claim 5
20 depends from Claim 1 and Claim 6 depends from Claim 5. The disputed claim term is
21 highlighted below. Claim 5:

22 The touch screen protector of claim 1, wherein micro-particles are present on the
23 back side of the plastic film at a density which is sufficiently high to provide an
24 anti-static effect without adversely affecting quality of images viewed through the
25 window.

Claim 6:

The touch screen protector of claim 5, wherein the plastic film also includes
micro-particles adhered to the front side of the window in an amount effective for
providing anti-glare and anti-static effects to the window.

Term nine, "adhesive strip," is present only in dependent Claim 8, which depends from Claim 5.

The disputed claim term is highlighted below. Claim 8:

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1 The touch screen protector of claim 5, wherein the spacer includes at least one
2 adhesive strip that is applied onto the plastic film, wherein the adhesive strip is
3 opaque.

4 **A. “Spacer”**

5 **Proposed Constructions¹**

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|---------------------|--|
| 6 Plaintiff | “an element or elements located on the back of the plastic film of the touch screen protector having a thickness sufficient to space the plastic film near but not in contact with the touch screen portion” |
| 7 Defendants | “a structure provided along the outer perimeter of the plastic film continuously surrounding the transparent window, this structure having a thickness sufficient to space the plastic film near but not in contact with the touch screen portion of a hand held electronic device, and this structure containing an exposed adhesive for removably mounting the protector upon the outer perimeter of the front face of a hand held electronic device to form an enclosed air space between the transparent window of the plastic film and the touch screen portion of the hand held electronic device. The spacer may consist of one or more layers, The layers may include a first strip of material adhered to the plastic film by an adhesive, a second strip of material adhered to the first strip by an adhesive and an exposed adhesive on the second strip of material.” |

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17 The term “spacer” appears in Claims 1, 3, 4, 7-9, and 11 of the ’942 Patent.

18 **1. Defendants’ Proposed Construction**

19 Defendants’ construction uses 143 words to define the term “spacer.” (Defs.’ Br. 8:26-
20 9:6, ECF No. 159.) However, Defendants have failed to adequately support such a verbose
21 construction of a simple word. Furthermore, even where Defendants have attempted to support
22 their proposed construction with the words of the patent, the Court finds these arguments
23 unpersuasive. Defendants contend that their construction is consistent with the “claims,

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25 ¹ Throughout this Order, Plaintiff’s proposed constructions are taken from its Opening Claim Construction Brief. (See ECF No. 157.) Similarly, throughout this Order, Defendants’ proposed constructions are taken from its Opening Claim Construction Brief (see ECF No. 159), which the Court construes as its Responsive Claim Construction Brief (see ECF No. 186.)

1 specification, drawings and the prosecution history of the '942 patent, along with the way in
2 which the term is used in the art.” (Id. at 9:17-19.) Specifically, Defendants rely on Figure 3,
3 “an expanded partial sectional view of the touch screen protector,” and the words of the
4 specification associated therewith. (Id. at 9:19-10:12 (quoting '942 Patent col.3 ll.3-4).) From
5 this Figure, Defendants first assert that the spacer consists of “a structure that includes the
6 exposed adhesive.” (Defs.’ Br. 10:2-3.) Next, Defendants contend that the spacer must have a
7 “thickness sufficient to space the plastic film near but not in contact with the touch screen
8 portion, and an exposed adhesive” (Defs.’ Br. 10:4-6 (quoting '942 Patent col.2 ll.1-3).)
9 Defendants further argue that the spacer “may also consist of one or more layers.” (Defs.’ Br.
10 10:12.) To support this argument, Defendants rely on language in the written description that
11 explains that the spacer may consist of a first strip adhered to the plastic film and a second strip
12 adhered to the first strip, (Defs.’ Br. 10:8-12 (citing '942 Patent col.7 ll.14-19).) Despite
13 Defendants’ attempts to base their proposed construction in the language of the '942 Patent, for
14 the reasons discussed below, the Court declines to adopt Defendants’ proposed construction.

15 First, the Court agrees, and it appears that Plaintiff does not dispute, that the spacer must
16 have “a thickness sufficient to space the plastic film near but not in contact with the touch screen
17 portion of a hand held electronic device.” However, Defendants’ proposed construction is still
18 problematic. Specifically, most of Defendants’ proposed construction uses terms that appear
19 elsewhere in the claims. Many of these claim terms are the subject of claim construction
20 disputes that are discussed in later sections of this Order. In fact, the parties have requested that
21 the Court construe “provided along the outer perimeter,” “continuously surrounding,”
22 “transparent window,” “removably mounting,” and “enclosed air space.” Nevertheless,
23 Defendants have used each of these terms in their proposed construction of “spacer.”
24 Furthermore, Defendants’ proposed construction incorporates the term “exposed adhesive.”
25 This term, although not disputed, does appear in Claims 1, 2, and 8-11. Because these claim

1 terms appear elsewhere in the claims, the Court finds that it is improper and unhelpful to
2 incorporate these terms in the definition of “spacer.” See *Z4 Techs., Inc. v. Microsoft Corp.*, 507
3 F.3d 1340, 1348 (Fed. Cir. 2007) (rejecting a claim construction that incorporated a term found
4 elsewhere in the claim because such a construction would conflict with the words of the claim).

5 The Court also finds that the words of the specification do not require that the “the spacer
6 may also consist of one or more layers.” Specifically, the Federal Circuit has held that “the
7 presence of a dependent claim that adds a particular limitation raises a presumption that the
8 limitation in question is not found in the independent claim.” *Liebel-Flarsheim Co. v. Medrad,*
9 *Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004). In the ’942 Patent, dependent Claim 9 adds the
10 limitation that the spacer “comprises at least two strips.”² In fact, the concept of a spacer made
11 up of layers is wholly absent from the words of Claim 1. See ’942 Patent col.8 ll.28-48. Thus,
12 Defendants’ proposed construction attempts to add a limitation from dependent Claim 9 into
13 independent Claim 1. Under *Liebel-Flarsheim*, such a construction is impermissible unless
14 Defendants provide a persuasive argument based on the intrinsic evidence that overcomes the
15 presumption. Defendants have provided no such basis for overcoming the *Liebel-Flarsheim*
16 presumption. Accordingly, this portion of Defendants’ proposed construction is also
17 impermissible.

18 **2. Plaintiff’s Proposed Construction**

19 Plaintiff’s construction, on the other hand, uses 36 words to define the term “spacer.”³
20 Consistent with the “fundamental rule of claim construction” that “claims must be construed so
21 as to be consistent with the specification, of which they are a part,” *Phillips*, 415 F.3d at 1316

22 ² Claim 9 depends from Claim 6. Claim 6, in turn, depends from Claim 5. Finally, Claim 5 depends from
23 Claim 1. Therefore, Claim 9 ultimately incorporates all the limitations of Claims 1, 5, and 6.

24 ³ Plaintiff originally proposed a more verbose construction in the Joint Claim Construction and Prehearing
25 Statement. (See ECF No. 120.) However, Plaintiff later correctly noted that its original proposed construction
improperly used other claim terms to define the term “spacer.” (Pl.’s Br. 7 n.3, ECF No. 157 (citing *Z4 Techs.,*
Inc. v. Microsoft Corp., 507 F.3d 1340, 1348 (Fed. Cir. 2007)).) For that reason, Plaintiff amended its proposed
construction to the current proposal.

1 (quoting *Merck & Co. v. Teva Pharms. USA, Inc.*, 347 F.3d 1367, 1371 (Fed. Cir. 2003)),
2 Plaintiff supports its proposed construction with the words of the specification of the '942
3 Patent. Plaintiff first contends that the spacer must have “a thickness sufficient to space the
4 plastic film near but not in contact with the touch screen portion’ of the device to which the
5 patented invention is attached.” (Pl.’s Br. 8:4-6 (citing '942 Patent col.3, ll.34-35).) As
6 discussed above in Section IV.A.1, above, neither party appears to dispute that some version of
7 this language should be included in the final construction of this term. Second, Plaintiff asserts
8 that the spacer “must be on the back side of the touchscreen protector.” (Pl.’s Br. 8:9-10 (citing
9 '942 Patent col.7, ll.12-13).) Plaintiff supports this assertion with language from column 7 of
10 the '942 Patent that expressly states that “[t]he spacer is on the back side of the plastic film . . .”
11 '942 Patent col.7, ll.12-13.

12 With one exception, the Court finds that Plaintiff’s construction is correct. Specifically,
13 both Plaintiff’s and Defendants’ construction unwisely uses the term “space” in their proposed
14 constructions. For this reason, the Court will adopt a modified version of Plaintiff’s proposed
15 construction. Thus, the Court construes the term “spacer,” as used in the '942 Patent, as “an
16 element or elements located on the back of the plastic film of the touch screen protector having a
17 thickness such that the protector is close to, but not in contact with, the touch screen portion.”

18 **3. The Court’s Construction**

19 After looking first to the words of the claim and then the remaining parts of the
20 specification, the Court finds that a person of ordinary skill in the art would understand the term
21 “spacer,” as used in the '942 Patent to mean “an element or elements located on the back of the
22 plastic film of the touch screen protector having a thickness such that the protector is close to,
23 but not in contact with, the touch screen portion.” Therefore, the Court construes the term
24 “spacer” as “an element or elements located on the back of the plastic film of the touch screen
25 protector having a thickness such that the protector is close to, but not in contact with, the touch

1 screen portion.”

2 **B. “Continuously Surrounding the Transparent Window”**

3 **Proposed Constructions**

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| | “continuously surrounding” | “surrounding on all sides” |
| Plaintiff | “transparent window” | “see-through area of the plastic film corresponding to the touch screen portion of the handheld electronic device to which the protector is intended to be attached” |
| Defendants | “continuously surrounding the transparent window” | “closed in on all sides of the transparent window without interruption, so that an enclosed air space is created between the transparent window of the plastic film” |

10
11 **1. The Parties’ Proposed Constructions**

12 The phrase “continuously surrounding the transparent window” appears only in
13 independent Claim 1. The phrase “transparent window” appears in Claim 15, which depends
14 from Claim 1. Additionally, the ’942 Patent uses the term “window” in Claims 5 and 6.

15 The parties first dispute whether this phrase should actually be construed as two separate
16 phrases. Plaintiff contends that this phrase consists of two separate claim terms, “continuously
17 surrounding” and “transparent window,” each of which is in need of construction. Defendants,
18 on the other hand, assert that “continuously surrounding the transparent window” is one claim
19 term that requires only one construction.

20 Defendants argue that the Court should construe the term “continuously surrounding the
21 transparent window” as a single claim term. Defendants support this argument by stating that
22 “[i]t makes no sense to separately define ‘continuously surrounding’ and ‘transparent window’
23” (Defs.’ Br. 12:9-15, ECF No. 159.) Defendants appear to argue that the phrase must be
24 construed as a single term because transparent window is the object that is being continuously
25 surrounded. (Id.) Defendants actually use the phrase “transparent window” to define

1 “continuously surrounding the transparent window.” Explicitly, Defendants’ propose that this
2 Court construe “continuously surrounding the transparent window” as “closed in on all sides of
3 the transparent window without interruption, so that an enclosed air space is created between the
4 transparent window of the plastic film.” (Defs.’ Br. 11:27-28 (emphasis added).) Conflating the
5 words of the claims in this manner is unhelpful to the finder of fact and violates Federal Circuit
6 precedent. See *Z4 Techs.*, 507 F.3d at 1348. For this reason, the Court declines to adopt
7 Defendants’ proposed construction.

8 Plaintiff, on the other hand, requests that this phrase actually consists of two, separately
9 construable claims: “continuously surrounding” and “transparent window.” Plaintiff first notes
10 that the terms “transparent window” and “window” appear elsewhere in the ’942 Patent and that
11 the ’942 Patent does not consistently connect these terms with the phrase “continuously
12 surrounding.” See ’942 Patent col.8, ll.59-67 (Claims 5 and 6), col.1, ll.17-19 (Claim 15). In
13 fact, the ’942 Patent juxtaposes these two phrases together only once, in Claim 1. Thus,
14 Plaintiff argues that “[b]ecause these phrases appear in different claims and are only juxtaposed
15 once, there is no logical reason that they need to be read and construed together.” The Court
16 agrees and will, therefore, separately construe the terms “continuously surrounding” and
17 “transparent window.”

18 **a. “continuously surrounding”**

19 The term “continuously surrounding” appears only once, in Claim 1, to modify the
20 claimed “spacer.” See ’942 Patent col.8, ll.35-43. Specifically, part of Claim 1 claims “a spacer
21 provided along the outer perimeter of the plastic film continuously surrounding the transparent
22 window” ’942 Patent col.8, ll.35-36.

23 Plaintiff proposes that the Court construe “continuously surrounding” as “surrounding on
24 all sides.” Defendants object to Plaintiff’s construction because it could encompass a “spacer”
25 that has even minute interruptions. Rather, as discussed above in Section IV.B.1, Defendants

1 contend that the Court should construe this phrase as “closed in on all sides of the transparent
2 window without interruption, so that an enclosed air space is created between the transparent
3 window of the plastic film.” (Defs.’ Br. 11:27-28, ECF No. 159.) At bottom, Defendants argue
4 that “continuously surrounding” cannot encompass a structure that has even the smallest of
5 interruptions.⁴ (Id. at 14:1-18.) Although the Court is currently not persuaded by Defendants’
6 arguments, these arguments are ill-suited for the claim construction stage of litigation because
7 they are aimed at the question of infringement. Specifically, it appears to the Court that these
8 arguments are aimed at the question of whether the accused device infringes the ’942 Patent,
9 either literally or under the doctrine of equivalents. Nevertheless, the Court finds that
10 “continuously surrounding,” when read in the context of the ’942 Patent does not require an
11 absolutely uninterrupted quality. For example, a mountain range that continuously surrounds a
12 mountain range will inevitably have some gaps. Similarly, a room can still be said to be
13 continuously surrounded by walls, despite the existence of doors. For these reasons, the Court is
14 not persuaded by Defendants’ arguments that “continuously surrounding” must mean “closed in
15 all sides . . . without interruption.”

16 Defendants’ proposed construction is also problematic because it uses the term “enclosed
17 air space,” a term that appears elsewhere in the claims. In fact, “enclosed air space” is a
18 disputed claim term that is discussed in a later section of this Order. Because the term “enclosed
19 air space” appears elsewhere in the claims, the Court finds that it is improper and unhelpful to
20 incorporate this phrase into the definition of “continuously surrounding.” See *Z4 Techs., Inc. v.*
21 *Microsoft Corp.*, 507 F.3d 1340, 1348 (Fed. Cir. 2007) (rejecting a claim construction that

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23 ⁴ To support their proposal, Defendants rely on an alleged “disclaimer” in the scope of the Patent. (Defs.’ Br. at
24 14:19-15:2.) The ’942 Patent, at column 5, lines 11-13, states that “[i]t is also possible, although not preferred, to
25 include adhesive only upon a portion of the perimeter . . .” From this statement, Defendants conclude that the
’942 Patent disclaims a spacer that has any small interruption as it surrounds the transparent window of the touch
screen protector. However, “continuously surrounding,” as used in Claim 1 modifies the “spacer.” ’942 Patent
col.8, ll.35-36. In contrast, the section of the written description to which Defendants refer describes the location
of the adhesive, not the “spacer.” ’942 Patent col. 5, ll.9-17.

1 incorporated a term found elsewhere in the claim because such a construction would conflict
2 with the words of the claim). Accordingly, the Court declines to adopt Defendants' proposed
3 construction.

4 The Court is also not persuaded by Plaintiff's proposed construction and Plaintiff's
5 corresponding arguments. First, Plaintiff erroneously asserts that the Court has already
6 construed this term in the Court's May 2, 2012 Contempt Order and that, as a result, the alleged
7 construction in that Order is "the law of the case." (Pl.'s Br. 13:23-14:7 (citing Order Grant's
8 Mot. for Order to Show Cause 8:8-17, ECF No. 65).) Contrary to Plaintiff's assertion, the
9 Court's May 2, 2012 Order did not address the issue of construing "continuously surrounding."
10 (See Order Grant's Mot. for Order to Show Cause 8:8-17, ECF No. 65.) In reality, the Court
11 simply found that the allegedly infringing device would likely be found to infringe under the
12 doctrine of equivalents and, thus, a preliminary injunction was warranted because Plaintiff was
13 likely to succeed on the merits. (Id.) Even if the Court had construed this term in the May 2,
14 2012 Order, Defendants correctly note that "[m]any courts have concluded that '[c]laim
15 construction orders are not final and may be altered by the Court prior to or during trial.'" (Def.
16 s.' Br. 12:25-28 (citing *Cisco Sys., Inc. v. Telcordia Techs., Inc.*, 590 F. Supp. 2d 828, 830
17 (E.D. Tex. 2008)).) Therefore, this Court is not bound at this stage by a statement made in the
18 prior order that Plaintiff now interprets as a statement on how this term should be construed.

19 Second, Plaintiff's proposed construction is also problematic because it uses one of the
20 words in the disputed term to define that term. Specifically, "surrounding" is both part of the
21 disputed term, "continually surrounding," and part of the proposed construction of that term,
22 "surrounding on all sides." As stated above in Section IV.B.1, conflating the words of the
23 claims in this manner is unhelpful to the finder of fact and violates Federal Circuit precedent.
24 See *Z4 Techs.*, 507 F.3d at 1348. For these reasons, the Court also declines to adopt Plaintiff's
25 proposed construction.

1 Having rejected both parties proposed constructions, the Court must now determine the
2 proper construction for the term “continuously surrounding.” After looking to the words of the
3 specification, the Court finds that this term needs no further construction. The term is well
4 understood in the art and by lay persons and does not have any special meaning in the context of
5 the ’942 Patent.

6 **b. “transparent window”**

7 Because Defendants’ proposed construction of “continuously surrounding the transparent
8 window” includes the phrase “transparent window,” the Court finds that Defendants have not
9 provided a proposed construction for this term.

10 Plaintiff, on the other hand, proposes that this term be construed as a “see-through area of
11 the plastic film corresponding to the touch screen portion of the handheld electronic device to
12 which the protector is intended to be attached.” (Pl.’s Br. 11:12-15, ECF No. 157.) To support
13 this proposed construction, Plaintiff first notes that the term “transparent” is commonly
14 understood as “see-through” or “capable of transmitting light so that objects or images can be
15 seen as if there were no intervening material.” (Id. 12:7-9.) Such a definition is consistent with
16 the words of the ’942 Patent, which describes a device that provides protection for the screen of
17 hand-held electronic touch screen devices. ’942 Patent, col.1, ll.10-13. In order for such a
18 device to function, the protector must allow the user of the device to see through the
19 “transparent window” to the screen of the device.

20 Plaintiff further asserts that because the ’942 Patent covers a device designed to protect
21 the touch screen portion of electronic touch screen devices, the “transparent window” must also
22 correspond to the size and shape of the electronic device’s touch screen. The words of the
23 written description support this proposed construction. Specifically, the ’942 Patent states that
24 “the transparent window enables the full operative portion of the touch screen portion [of the
25 electronic device] to be used.” ’942 Patent col.4, ll.64-66. Therefore, the “transparent window”

1 must correspond in size and shape to the touch screen portion of the electronic device.

2 Because Plaintiff’s proposed construction finds support in the specification of the ’942
3 Patent, the Court will construe “transparent window” as “see-through area of the plastic film
4 corresponding to the touch screen portion of the handheld electronic device to which the
5 protector is intended to be attached.”

6 **2. The Court’s Construction**

7 The Court first concludes that “continuously surrounding the transparent window”
8 actually consists of two separate terms: “continuously surrounding” and “transparent window.”
9 After looking first to the words of the claim and then the remaining parts of the specification, the
10 Court finds that a person of ordinary skill in the art would understand “continuously
11 surrounding,” as used in the ’942 Patent, to have its plain and ordinary meaning. The Court
12 finds that the term “continuously surrounding” requires no further construction.

13 The Court also finds that a person of ordinary skill in the art would understand
14 “transparent window,” as used in the ’942 Patent, to mean “see-through area of the plastic film
15 corresponding to the touch screen portion of the handheld electronic device to which the
16 protector is intended to be attached.” Therefore, the Court construes the term “transparent
17 window” as “see-through area of the plastic film corresponding to the touch screen portion of
18 the handheld electronic device to which the protector is intended to be attached.”

19 **C. “Enclosed air space”**

20 **Proposed Constructions**

| | |
|----------------------|---|
| 21 Plaintiff | “the space created between the touch screen and the protector’s transparent window by means of the spacer” |
| 22 Defendants | “a space that is closed on all sides and is between the transparent window of the plastic film formed by the plastic film, spacer and touch screen portion of the hand-held electronic device. The enclosed air space is formed when the spacer is attached to the plastic film and the handheld device by an adhesive and the spacer is continuously surrounding the transparent window” |

1 The term “enclosed air space” appears only in Claim 1 of the ’942 Patent.

2 **1. The Parties’ Proposed Construction**

3 Both parties agree that this “enclosed air space” is created by the transparent window, the
4 spacer, and the touch screen of the electronic device. In fact, Plaintiff simply proposes that
5 “enclosed air space” should be construed as “the space created between the touch screen and the
6 protector’s transparent window by means⁵ of the spacer.” (Pl.’s Br. 15:15-16, ECF No. 157.)
7 Thus, the heart of the dispute focuses on whether this space must be, as Defendants assert,
8 “closed on all sides.”

9 Defendants once again propose a verbose construction for a simple term. Defendants
10 employ sixty-four words to construe this three word term. To support this construction,
11 Defendants rely on the Court’s May 2, 2012 Order and on the words in the specification. First,
12 Defendants note that the Court previously determined the definition of “enclose” as
13 “surrounding on all sides.” (Defs.’ Br. 16:17-22 (citing Order Grant’g Mot. for Order to Show
14 Cause 7:24-8:7, ECF No. 65).) This argument fails for two reasons. First, this prior Order did
15 not actually engage in claim construction and is, thus, not binding on the instant claim
16 construction dispute. Second, in the May 2, 2012 Order, the Court clearly indicated that the
17 term “enclosed” did not require an absolute enclosure or any sort of hermetic seal. Defendants
18 have failed to recognize that the Court also stated in the May 2, 2012 Order that “[s]imply
19 because there are two small openings does not change the fact that air is enclosed between the
20 spacer, the plastic film and the transparent window.” (Order Grant’g Mot. for Order to Show
21 Cause 8:5-7, ECF No. 65.) Therefore, even if the May 2, 2012 Order was binding on this issue,
22 Defendants’ arguments would fail.

23 Defendants also attempt to support their proposed construction by relying on “a related
24

25 ⁵ Because the word “means” has a distinct meaning in patent law, see 35 U.S.C. § 112(f), the Court omits this word from its construction of this term.

1 pending application filed by [Plaintiff] that was published on July 19, 2012.” (Defs.’ Br. 17:7-8,
2 ECF No. 159.) Specifically, Defendants note that this related application originally used the
3 term “enclosed air space,” and Plaintiff later amended the application to employ the term “an air
4 space,” and still later Plaintiff further amended the application to simply use the term “a space.”
5 (See Defs.’ Br. Ex. E, at 2, 4, 7, 9, ECF No. 159-7.) Although this argument is slightly more
6 persuasive than Defendants’ first argument, the Court still finds this insufficient to warrant a
7 wholesale adoption of Defendants’ proposed construction. Despite Plaintiff’s different word
8 choice in this related patent application, “enclosed air space,” as used in the ’942 Patent, does
9 not require a space that is fully enclosed without any interruption.

10 Finally, Defendants’ most persuasive argument relies on statements made by the patentee
11 in the Support Document that the patentee filed with its Request for Accelerated Examination
12 pursuant to 37 C.F.R. § 1.155. In that document, the patentee represented to the USPTO that
13 “the screen protectors disclosed in [the prior art] references are only connected to the display
14 screen or the frame of the screen at certain attachment points without consideration as to the
15 formation of an enclosed air space between the screen protector, the spacer and the touch
16 screen.” (Defs.’ Br. Ex. C, at 12, ECF No. 159-5.) This declaration certainly indicates that the
17 air space claimed in Claim 1 must be more enclosed than the space that would be created from
18 having a few attachment points on the frame of the electronic device. Therefore, the Court
19 concludes that the “enclosed air space” must be a space that is, at minimum, substantially
20 bounded on all sides.

21 Finally, the Court finds that the second sentence of Defendants’ proposed construction is
22 unnecessary and unhelpful. Much like Defendants’ other proposed constructions, the proposed
23 construction for “enclosed air space” employs a separate disputed claim term. Specifically, the
24 second sentence of Defendants’ proposed construction states that “[t]he enclosed air space is
25 formed when the spacer is attached to the plastic film and the handheld device by an adhesive

1 and the spacer is continuously surrounding the transparent window.”⁶ (Defs.’ Br. 18:9-11
2 (emphasis added).) Accordingly, the Court declines to employ this second sentence in its
3 construction of “enclosed air space.”

4 **2. The Court’s Construction**

5 For the reasons stated above, after looking first to the words of the claim and then the
6 remaining parts of the specification, the Court finds that a person of ordinary skill in the art
7 would understand the term “enclosed air space,” as used in the ’942 Patent to mean “the area
8 that is formed by the touch screen and the protector’s transparent window and is substantially
9 bounded on all sides by the spacer.” Therefore, the Court construes the term “enclosed air
10 space” as “the area that is formed by the touch screen and the protector’s transparent window
11 and is substantially bounded on all sides by the spacer.”

12 **D. “Removably mounting”**

13 **Proposed Constructions**

| | |
|----------------------|--|
| 14 Plaintiff | “taking the touch screen protector off of the touch screen of the 15 electronic device after it has been placed thereon and attached thereto 16 by its adhesive wherein the protector can be easily removed from the 17 touch screen device” Alternatively: “placing the touch screen protector on the device in such a way that the protector can be easily removed” |
| 18 Defendants | “attaching with sufficient adhesiveness to mount the protector onto the device while enabling its removal” |

19 The term “enclosed air space” appears only in Claim 1 of the ’942 Patent.

20 **1. The Parties’ Proposed Constructions**

21 Plaintiff originally proposed that the Court construe “removably mounting” as “taking the
22 touch screen protector off of the touch screen of the electronic device after it has been placed
23

24 ⁶ As discussed in Section IV.B.1.a, Defendants used the disputed term “enclosed air space” in its proposed
25 construction of “continuously surrounding the transparent window.” Furthermore, “continuously surrounding the
transparent window” now appears in Defendants’ proposed construction of “enclosed air space.” This type of
circular claim construction cannot be correct and is unhelpful to the finder of fact. See *Z4 Techs.*, 507 F.3d at
1348.

1 thereon and attached thereto by its adhesive wherein the protector can be easily removed from
2 the touch screen device.” (Pl.’s Br. 17:6-9, ECF No. 157.) Thereafter, in its Reply Brief,
3 Plaintiff recognized that its original proposed construction “over-emphasize[d] ‘taking . . . off’
4 and under-emphasize[d] ‘mounting.’” (Pl.’s Reply Br. 8:5-6, ECF No. 183.) Consequently,
5 Plaintiff offered an alternative construction that would construe “removably mounting” as
6 “placing the touch screen protector on the device in such a way that the protector can be easily
7 removed.”⁷ (Id. at 7-10.) Defendants, on the other hand, maintain that the Court should construe
8 this term as “attaching with sufficient adhesiveness to mount the protector onto the device while
9 enabling its removal.”

10 Ultimately, the primary difference between Plaintiff’s alternative proposed construction
11 and Defendants’ proposed construction is Defendants’ inclusion of the concept of adhesion in its
12 proposed construction. Defendants’ proposed construction is incorrect. Specifically,
13 Defendants’ proposed construction violates the doctrine of claim differentiation. “[T]he
14 presence of a dependent claim that adds a particular limitation raises a presumption that the
15 limitation in question is not found in the independent claim.” *Liebel-Flarsheim Co. v. Medrad,*
16 *Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004). Here, Claim 2 depends from Claim 1 and additionally
17 requires that the exposed adhesive in Claim 1 “has sufficient adhesiveness to mount the
18 protector onto the device but to enable its removal without leaving adhesive residue on the
19 device.” ’942 Patent col.8, ll.49-53 (Claim 2). Defendants’ proposed construction of
20 “removably mounting,” a term used only in Claim 1, is remarkably similar to the words of
21

22
23 ⁷ Both parties agree, as does the Court, that Plaintiff’s original proposed construction is incorrect because it would
24 render the limitation added in dependent Claim 2 meaningless. Claim 2, which depends from Claim 1,
25 additionally requires that the exposed adhesive “has sufficient adhesiveness to mount the protector onto the device
but to enable its removal without leaving adhesive residue on the device.” ’942 Patent col.8, ll.49-53 (Claim 2).
Because Plaintiff’s original proposed construction over-emphasized this adhesive quality and the ability to
removing the device from the touch screen, it violated the doctrine of claim differentiation. See *Liebel-Flarsheim*
Co. v. Medrad, Inc., 358 F.3d 898, 910 (Fed. Cir. 2004). Thus, the Court rejects Plaintiff’s original proposed
construction.

1 dependent Claim 2. Explicitly, Defendants propose that the Court construe “removably
2 mounting” as “attaching with sufficient adhesiveness to mount the protector onto the device
3 while enabling its removal.” (Defs.’ Br. 18:13-16, ECF No. 159 (emphasis added).) Because of
4 the similarities between the language of Claim 2 and the language of Defendants’ proposal, the
5 Court concludes that Defendants’ proposed construction is a textbook example of impermissibly
6 reading into independent Claim 1 a limitation that appears in dependent Claim 2. See Liebel-
7 Flarsheim, 358 F.3d at 910 (“In such a setting, where the limitation that is sought to be “read
8 into” an independent claim already appears in a dependent claim, the doctrine of claim
9 differentiation is at its strongest”).

10 Plaintiff’s original proposed construction also violated the doctrine of claim
11 differentiation. (Pl.’s Br. 17:6-9, ECF No. 157 (proposing that the Court construe “removably
12 mounting as “taking the touch screen protector off of the touch screen of the electronic device
13 after it has been placed thereon and attached thereto by its adhesive wherein the protector can be
14 easily removed from the touch screen device”).) Plaintiff’s alternative proposed construction,
15 however, eliminates this problem. Specifically, in its Reply Brief, Plaintiff proposed that the
16 Court construe “removably mounting” as “applying the touch screen protector onto the device
17 such that it can be easily removed.” (Pl.’s Reply Br. 8:9-10, ECF No. 183.) However, the Court
18 finds that Plaintiff’s use of the word “removed” is improper in a construction of “removably
19 mounting.” Accordingly, the Court adopts a modified version of Plaintiff’s proposal. The Court
20 construes “removably mounting” as “applying the touch screen protector onto the device such
21 that it can be easily taken off of the device.” The Court finds that this construction is “[t]he
22 construction that stays true to the claim language and most naturally aligns with the patent’s
23 description.” See Phillips v. AWH Corp., 415 F.3d 1303, 1316 (quoting Renishaw PLC v.
24 *Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)) (“The construction that
25 stays true to the claim language and most naturally aligns with the patent’s description of the

1 invention will be, in the end, the correct construction”).

2 **2. The Court’s Construction**

3 For the reasons stated above, after looking first to the words of the claim and then the
4 remaining parts of the specification, the Court finds that a person of ordinary skill in the art
5 would understand the term “removably mounting,” as used in the ’942 Patent to mean “applying
6 the touch screen protector onto the device such that it can be easily taken off of the device.”
7 Therefore, the Court construes the term “removably mounting” as “applying the touch screen
8 protector onto the device such that it can be easily taken off of the device.”

9 **E. “Provided along the outer perimeter”**

10 **Proposed Constructions**

| | |
|----------------------|--|
| 11 Plaintiff | No claim construction needed; this phrase should be given its plain meaning 12 Alternatively: “located on the area of the plastic film that surrounds the transparent window” |
| 13 Defendants | 14 “located on the area adjacent the edges of the plastic film which does not touch the touch screen portion” |

15 The term “provided along the outer perimeter” appears only in Claim 1 of the ’942
16 Patent.

17 **1. The Parties’ Proposed Constructions**

18 Plaintiff contends that this phrase needs no further construction because the phrase
19 appears only once to explain the location of the spacer and “is easily understandable in plain
20 English.” (Pl.’s Br. 18:27-19:3, ECF No. 157.) In the event that the phrase did need
21 construction, Plaintiff provided an alternate proposed construction. Defendants object to
22 Plaintiff’s proposal and argue that both of Plaintiff’s proposals “ignore[] the words ‘outer
23 perimeter’ as they are used in the context of the claims.” (Def.’s Br. 21:3-5, ECF No. 159.)
24 Defendants attempt to support their proposed construction by referring to Figure 3 of the ’942
25 Patent and the corresponding language in the written description. (Def.’s Br. 21:10-20, ECF No.

1 159.) Specifically, Defendants argue that that their proposed construction should be adopted
2 because it makes it clear that the “outer perimeter” refers to the plastic film itself, not the
3 transparent window of the plastic film. (Id. at 11-20 (citing ’942 Patent col.7, ll.16-18, Figure
4 3).)

5 The Court disagrees that such construction is necessary. First, the Court finds that one of
6 skill in the art would need no further explanation to determine, based on the words of the claim,
7 where the spacer is located in relation to the plastic film and the transparent window.
8 Furthermore, there is no evidence in the words of the ’942 Patent that indicate that the phrase is
9 used in anything other than its ordinary meaning. *See O2 Micro Int’l Ltd. v. Beyond Innovation*
10 *Tech. Co., Ltd.*, 521 F.3d 1351, 1361 (Fed. Cir. 2008) (“A determination that a claim term
11 ‘needs no construction’ or has the ‘plain and ordinary meaning’ may be inadequate when a term
12 has more than one ‘ordinary’ meaning or when reliance on a term’s ‘ordinary’ meaning does not
13 resolve the parties’ dispute”).

14 Second, after looking at the other words in Claim 1 that surround this disputed term, the
15 Court finds that this phrase does not require the construction proposed by Defendant. Plaintiff’s
16 proposed alternative construction is similarly unnecessary. Claim 1 explicitly states that the
17 spacer is “provided along the outer perimeter of the plastic film.” Accordingly, a proper
18 construction of “provided along the outer perimeter” need not include such a limitation; this
19 limitation is already found in the claim language. For these reasons, the Court finds that
20 “provided along the outer perimeter” needs no further construction; this term will be given its
21 plain and ordinary meaning.

22 **2. The Court’s Construction**

23 After looking first to the words of the claim and then the remaining parts of the
24 specification, the Court finds that a person of ordinary skill in the art would understand the ’942
25 Patent to use the phrase “provided along the outer perimeter” in accordance with that phrase’s

1 plain meaning. This phrase needs no further construction.

2 **F. “Coating”**

3 **Proposed Constructions**

| | |
|-------------------|---|
| Plaintiff | No claim construction needed; this term should be given its plain meaning |
| Defendants | “a layer of substance spread over a surface; a covering layer” |

4
5
6
7 The term “provided along the outer perimeter” appears only in Claim 15 of the ’942
8 Patent, which depends from Claim 1. Specifically, Claim 15 claims “[t]he touch screen
9 protector of claim 1, wherein the transparent window is clear but includes a coating that
10 provides a matte effect or a privacy screen feature.” ’942 Patent col.10, ll.17-19 (Claim 15)
11 (emphasis added).

12 **1. Defendants’ Proposed Construction**

13 Defendants propose that the Court construe “coating” as “a layer of a substance spread
14 over a surface.” (Defs.’ Br. 22:3, ECF No. 159.) For the reasons discussed below, the Court
15 finds that Defendants’ proposed construction violates the rules of claim construction and
16 contradicts the language of the intrinsic record.

17 To support their construction, Defendants rely on one embodiment disclosed in the ’942
18 Patent. (Id. at 22:21-23:2.) This embodiment refers to a “surface treatment” or “top layer
19 treatment” coated on the plastic film. ’942 Patent col.4, ll.16-21. From this preferred
20 embodiment, Defendants conclude that “[c]learly, a coating is meant to be understood as a layer
21 of a substance that may be spread over a surface such as the plastic film of a screen protector.”
22 (Defs.’ Br. 22:28-23:2.) However, this reference to a single embodiment followed by such a
23 conclusory statement does not adequately support Defendants’ proposed construction.

24 First, this embodiment provides no evidence that such a “coating” must be a “substance
25 spread over a surface” as provided in Defendants’ proposed construction. In fact, Defendants

1 have failed to provide, and the Court is unable to locate, a single use of the word “spread” in the
2 intrinsic record. Thus, construing this claim term in the manner requested by Defendants would
3 require the Court to arbitrarily insert limitations that are wholly absent from the intrinsic record.

4 Second, even if this embodiment did provide evidence supporting a construction of the
5 term “coating” that required a “layer” that was somehow located only on the “surface” of the
6 plastic film, the Federal Circuit has repeatedly instructed that courts should not limit claim
7 language to a preferred embodiment. See *Kara Tech. Inc. v. Stamps.com Inc.*, 582 F.3d 1341,
8 1348 (Fed. Cir. 2009) (“The claims, not specification embodiments, define the scope of patent
9 protection. The patentee is entitled to the full scope of his claims, and we will not limit him to
10 his preferred embodiment or import a limitation from the specification into the claims”);
11 *Phillips*, 415 F.3d at 1323 (“[A]lthough the specification often describes very specific
12 embodiments of the invention, we have repeatedly warned against confining the claims to those
13 embodiments”). Because the language of the claims and the language of the remainder of the
14 specification do not require that the coating is “a layer of a substance spread over a surface,” the
15 Court cannot impose limitations that might appear in the single embodiment on which
16 Defendants rely.

17 Finally, the words of the specification actually contradict Defendants’ proposed
18 construction. Specifically, the written description contemplates applying a micro-particle
19 treatment over, at least, 5% of the plastic film. ’942 Patent col.4, ll.48-54. The statement in the
20 written description undercuts Defendants’ argument that the “coating” must be a “layer.”
21 Similarly, the ’942 Patent discloses that the coating is not limited to a “layer” because a micro-
22 particle coating on the plastic film “can be of various shapes, such as the column shape and the
23 wave shape.” ’942 Patent col.4, ll.42-44. This disclosure also contradicts Defendants’ argument
24 that “coating” must be a “layer.” Additionally, this language undercuts Defendants’ assertion
25 that the “coating” is “spread” over the plastic film. Lastly, the ’942 Patent also teaches that

1 these micro-particles need not be located on the outer surface, as Defendants' proposed
2 construction would require; the micro-particles can be located on "the inner side of the film."
3 '942 Patent col.4, ll.42-43. This teaching from the written description establishes that the
4 "coating" is not necessarily located on the "surface," as required by Defendants' proposed
5 construction. For these reasons, the Court finds that Defendants' proposed construction is
6 incorrect.

7 **2. Plaintiff's Proposed Construction**

8 Plaintiff, on the other hand, contends that this phrase needs no further construction
9 because the '942 Patent's usage of this term is "perfectly straightforward." (Pl.'s Br. 20:18-19,
10 ECF No. 157.) Additionally, Plaintiff argues, the specification uses the term according to its
11 plain and ordinary meaning; the specification does not suggest an alternate meaning. (Id. at
12 20:19-20.) The Court agrees.

13 Defendants' arguments fail to persuade the Court otherwise. Specifically, Defendants
14 contend that this term needs construction merely because "[although] touch screen protectors
15 may be familiar to many potential jurors, they may not know what is meant by a coating on a
16 touch screen protector because such coatings are easily seen." The Court disagrees that any
17 such construction is necessary. First, the Court finds that one of skill in the art would need no
18 further explanation to understand the concept of a coating on the transparent window that
19 provides a matte effect or a privacy screen feature. Furthermore, there is no evidence in the
20 words of the '942 Patent that indicate that the phrase is used in anything other than its ordinary
21 meaning. *See O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1361
22 (Fed. Cir. 2008) ("A determination that a claim term 'needs no construction' or has the 'plain
23 and ordinary meaning' may be inadequate when a term has more than one 'ordinary' meaning or
24 when reliance on a term's 'ordinary' meaning does not resolve the parties' dispute").

25 ///

1 Preferably, the micro-particles are made of [polyethylene terephthalate (PET)] so that they are
2 compatible with the film material.” Defendants next quote column four, lines sixteen through
3 twenty-four:

4 In one embodiment, the plastic film is coated to have a ‘matte’ or anti-glare effect.
5 Surface treatment such as EZ- GLIDE™ top layer treatment further allows better
6 touch screen portion maneuverability and effectively reduces finger glide friction
7 on the touch screen portion of the hand held device. EZ-GLIDE™ treatment is a
8 technology in which the outer side of the screen protector, i.e., the side that
9 contacts the hand, has micro-particles that reduce static effects, which allows the
10 hand to move smoothly on the screen protector.

9 From these passages, Defendants conclude that the construction of “micro-particles” must
10 include the language “microscopic particles adhered to the transparent window of a screen
11 protector.”

12 The Court only partially agrees. The Court does agree that the claimed micro-particles
13 are located on the plastic film of the screen protector. However, Defendants have failed to cite
14 to intrinsic evidence to support its assertion that the micro-particles must be adhered to the
15 transparent window. In fact, the claim language dictates just the opposite. Specifically, Claim
16 6, which depends from Claim 5, expressly claims micro-particles that are adhered to the
17 transparent window. Compare ’942 Patent col.8, ll.59-63 (Claim 5) with ’942 Patent col.8,
18 ll.64-67 (Claim 6). Therefore, the “micro-particles” of both Claims 5 and 6 must be broad
19 enough to encompass micro-particles that are adhered to the transparent window and micro-
20 particles that are put on the transparent window by some other mechanism.

21 Furthermore, Defendants have provided insufficient evidence that “micro-particles” refer
22 to microscopic particles, rather than, as Plaintiff contends, small particles. To support its
23 argument, Defendants merely state that “throughout the specification the particles are always
24 identified as ‘micro’ and never identified as being ‘small.’ Consequently, the specification only
25 supports the size requirements in Defendants’ proposed construction.” (Defs.’ Br. 24:5-10, ECF

1 No. 159.) The Court finds this argument unpersuasive. Thus, the Court also declines to adopt
2 the requirement that the “micro-particles” consist of microscopic particles.

3 **2. Plaintiff’s Proposed Construction**

4 Plaintiff, on the other hand, asserts that the Court should construe “micro-particles” as
5 “the small elements resulting from a surface treatment, such as a matte finish, for the plastic film
6 of a screen protector that achieves anti-glare effects and/or anti-static effects.” (Pl.’s Br. 21:16-
7 18.) However, much of this proposed construction is unnecessary because it is redundant of the
8 claim language. Specifically, Claim 5 claims “[t]he touch screen protector of claim 1, wherein
9 micro-particles are present on the back side of the plastic film at a density which is sufficiently
10 high to provide an anti-static effect without adversely affecting quality of images viewed
11 through the window.” ’942 Patent col.8, ll.59-63 (Claim 5) (emphasis added). Similarly, Claim 6
12 claims “[t]he touch screen protector of claim 5, wherein the plastic film also includes micro-
13 particles adhered to the front side of the window in an amount effective for providing anti-glare
14 and anti-static effects to the window.” ’942 Patent col.8, ll.64-67 (Claim 6) (emphasis added).
15 Thus, any reference in the construction of “micro-particles” to anti-glare or anti-static effects is
16 redundant of the actual claim language, and thus, unnecessary.

17 After omitting the references to anti-glare and anti-static effects, the remaining portion of
18 Plaintiff’s proposed construction would define “micro-particles” as “the small elements resulting
19 from a surface treatment, such as a matte finish, for the plastic film of a screen protector.” This
20 construction is still unnecessarily complex and imports the unnecessary concepts of “surface
21 treatment” and “matte finish.” Neither the claims nor the remainder of the specification indicate
22 that these concepts must be included in a proper construction of “micro-particles.” Accordingly,
23 the Court concludes that a better construction for “micro-particles” is “small particles located on
24 the plastic film of a screen protector.”

25 ///

1 than, or differently shaped from the spacer.

2 Plaintiff, on the other hand, contends that “adhesive strip” is a “plain-vanilla phrase” that
3 needs no further construction. (Pl.’s Br. 22:25-23:7, ECF No. 157.) Plaintiff argues that the
4 specification uses the term according to its plain and ordinary meaning; the specification does
5 not suggest an alternate meaning. (Id. at 23:9-11.) The Court agrees that no construction is
6 necessary.

7 Defendants fail to provide a persuasive argument for why a person of ordinary skill in the
8 art would need further explanation to understand the concept of an adhesive strip used to attach
9 the spacer and the plastic film. There is no evidence in the words of the ’942 Patent that
10 indicates that the patentee intended to use this phrase in anything other than its ordinary
11 meaning. *See O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co., Ltd.*, 521 F.3d 1351, 1361
12 (Fed. Cir. 2008) (“A determination that a claim term ‘needs no construction’ or has the ‘plain
13 and ordinary meaning’ may be inadequate when a term has more than one ‘ordinary’ meaning or
14 when reliance on a term’s ‘ordinary’ meaning does not resolve the parties’ dispute”).

15 2. The Court’s Construction

16 After looking first to the words of the claim and then the remaining parts of the
17 specification, the Court finds that a person of ordinary skill in the art would understand the ’942
18 Patent to use the phrase “adhesive strip” in accordance with that phrase’s plain meaning. This
19 phrase needs no further construction.

20 V. CONCLUSION

21 **IT IS HEREBY ORDERED** that the fifteen (15) claim terms submitted by the parties
22 are construed as contained within this Order. The Court construes the primary nine (9) disputed
23 claim terms in U.S. Patent No. 8,044,942 as follows:

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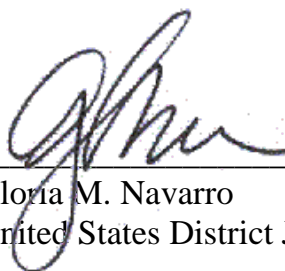
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| | | |
|----|--------------------------------------|--|
| 1 | “spacer” | an element or elements located on the back of the plastic film of the touch screen protector having a thickness such that the protector is close to, but not in contact with, the touch screen portion |
| 2 | | |
| 3 | “continuously surrounding” | plain meaning; no further construction needed |
| 4 | “transparent window” | see-through area of the plastic film corresponding to the touch screen portion of the handheld electronic device to which the protector is intended to be attached |
| 5 | | |
| 6 | “enclosed air space” | the area that is formed by the touch screen and the protector’s transparent window and is substantially bounded on all sides by the spacer |
| 7 | | |
| 8 | “removably mounting” | applying the touch screen protector onto the device such that it can be easily taken off of the device |
| 9 | “provided along the outer perimeter” | Plain and ordinary meaning |
| 10 | “coating” | Plain and ordinary meaning |
| 11 | “micro-particles” | the small elements located on the plastic film of a screen protector |
| 12 | “adhesive strip” | Plain and ordinary meaning |

13 **IT IS FURTHER ORDERED** that this case shall be referred to Magistrate Judge Koppe
14 for the setting of the Post-Claim Construction Order Settlement Conference pursuant to Local
15 Rule 16.1-19(b).

16 **DATED** this 14th day of May, 2013.

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Gloria M. Navarro
United States District Judge