

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF PENNSYLVANIA

BASIC FUN, INC., : CIVIL ACTION  
 : No. 97-2051  
Plaintiff, :  
 :  
v. :  
 :  
CAP TOYS, INC., ET. AL., :  
 :  
Defendants. :

MEMORANDUM AND ORDER

**AND NOW**, this 13th day of **June, 2001**, upon consideration of Defendants' Motion for Summary Judgment (doc. no. 68) and Plaintiff's Memorandum of Law in Opposition (doc. no. 70), it is hereby **ORDERED** that Defendants' Motion for Summary Judgment (doc. no. 68) is **GRANTED**. The court's order is based on the following reasoning:

The parties are manufacturers of competing motorized gum dispensers. The products at issue, when loaded with long, flat strips of chewing gum, dispense the gum through openings contained in each respective product. Plaintiff contends that defendants' product infringes on plaintiff's patent for its device. Before the court is defendants' motion for summary judgment.

The parties agree that the question presented by defendants' motion is whether the switch featured on defendants' product infringes, either literally or under the doctrine of

equivalents, the switch described in claims #1 and #3 of the patent for plaintiff's product, U.S. Patent No. Re. 36,143 (issued Mar. 16, 1999) (the "'143 patent"). According to those claims, the switch can be moved linearly into one of three positions. In the middle position, the motor is "not energized" (the "off" position). If the switch is moved in one direction from the middle position, the motor "is energized," and advances the gum out of the product's opening (the "on" position). When the switch is moved in the opposite direction from the "energized position," the "severing means" is activated, thus causing a length of gum protruding from the product's opening to be severed (the "cut" position).<sup>1</sup> See Pl.'s Mem. of Law at 4-5 (Fig. 4, 5A, 5B).

The parties agree that defendants' motion turns on the question of how many linear positions the switch on defendants' product features. If the switch only moves between two linear

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<sup>1</sup>Claim #1 describes a

dispenser having . . . a manually actuated switch for causing said motor means and said severing means to operate, said switch being mounted in said slot of said housing and being arranged to linearly slide into any one of three positions, said switch having a first position wherein said motor means is not energized, a second position wherein said motor means is energized, and a third position, said severing means being mounted on said switch such that movement of said switch from said second position to said third position causes said food product to be severed.

Defs.' Mot. for Summ. J. Ex. A, col. 6, lines 37-48.

positions, defendants are entitled to summary judgment because plaintiff is barred under the doctrine of prosecution history estoppel from claiming that the scope of their patent extends to dispensers featuring only two linear positions.<sup>2</sup> See Wang Laboratories, Inc. v. Mitsubishi Elec., 103 F.3d 1571, 1577-78 (Fed. Cir. 1997) ("Prosecution history estoppel . . . preclud[es] a patentee from regaining, through litigation, coverage of subject matter relinquished during prosecution of the application for the patent."). On the other hand, if defendants' switch moves between three linear positions, as plaintiff claims that it does, defendants are not entitled to summary judgment.

The parties agree that defendants' switch has an "on" position, where the motor is energized, and an "off" position, where the switch lies if no pressure is exerted on it in any direction. They also agree that defendants' switch can be fixed in a non-linear position, which is engaged by sliding the switch first in an upward (linear) motion, stopping short of engaging the motor, and then moving the switch perpendicular to the linear

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<sup>2</sup>The Patent Office initially rejected plaintiff's application for a patent because it was obvious in light of previously issued patents. See Defs.' Mem. of Law in Support of Mot. for Summ. J. Ex. B at 3 (discussing how the claims as written are unpatentable in light of the prior art featured in Ream, U.S. Patent No. 5,133,980 (issued Jul. 28, 1992), and Postolowski, U.S. Patent No. 3,494,235 (issued Feb. 10, 1970). Plaintiff subsequently distinguished those patents to the Patent Office by arguing that they "do[] not disclose or suggest a three-position switch," id. Ex. D at 5, but instead only feature a two-position switch.

track. The switch can then be settled into a notch that holds the switch in that fixed position (the "notched position").

During the course of the litigation, plaintiff has advanced several somewhat inconsistent theories in its attempt to divine a third linear position, in addition to the "on" and "off" positions, out of defendants' switch. One of plaintiff's co-inventors, Michael Kind, testified at his deposition that the third position is the notched position.<sup>3</sup> See Kind Dep. at 147 (describing the notched position as the first position, the "on" position as the second position, and the "off" position as the third position). The parties now agree, however, that because the notched position requires nonlinear manipulation of the switch, it cannot be considered a third linear position.

Mr. Kind's declaration attached to plaintiff's reply brief, see doc. no. 70, omits any reference to the notch position as the third linear position. Instead, Mr. Kind contends that the third position is a "cut" position, which can be achieved by moving the switch from the "off" position in a direction opposite the "on" position. This contention is flawed for two reasons.

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<sup>3</sup>Plaintiff relies significantly on Mr. Kind's analysis of defendants' product in a declaration attached to its reply brief to defendants' motion. Therefore, the court deems Mr. Kind's deposition statements regarding defendants' product to be representative of plaintiff's position. Mr. Kind's co-inventor, Alan Dorfman, also testified in his deposition that the third position on defendants' product is the notched position. See Dorfman Dep. at 170-71.

First, it is contrary to Kind's deposition testimony, wherein he describes the "off" and "cut" positions as one and the same. See Kind Dep. at 147 ("[The] third position would be to move the switch completely down to disengage the motor and cut off the gum."). A party's affidavit that contradicts that party's earlier deposition "without explaining the contradiction or attempting to resolve the disparity" should not be given any weight in deciding a motion for summary judgment. Cleveland v. Policy Mgmt. Sys. Corp., 526 U.S. 795, 806 (1999). Second, unlike plaintiff's product, defendants' product does not have a separate "cut" position.<sup>4</sup>

At oral argument, plaintiff advanced a third theory as to where the third position on defendants' product lies. Plaintiff now contends that the third position is an

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<sup>4</sup>On defendants' product, a spring returns the switch from the "on" to the "off" position when the user releases the switch. If some length of gum is protruding from the dispensing slot, the tab that ordinarily would cover that slot comes to rest on the piece of gum. The tab does have a beveled edge, so that if the switch is pressed downwards, the tab, if it were sharp enough, would sever the length of gum protruding from the opening. The tab is not sharp enough, however, to cut the gum, and instead only makes an indentation on the gum. Although defendants may have contemplated making the tab sharp enough to cut the gum, see Pl.'s Supp. Submission Ex. C, they did not do so, and the directions accompanying the product direct the user to tear the protruding length of gum manually, see Defs.'s Supp. Submission Ex. L. Although it is possible in some instances to actually cut the gum by exerting a significant amount of pressure on the switch, depending on the consistency of the particular length of gum, defendants' product is not designed to feature a separate "cut" position.

"intermediate position" in between the "off" and "on" positions, where the switch was moved up far enough so that it can be slid perpendicularly into the notched position, but not far enough so to as to engage the motor. See Hr'g Tr. (5/30/01) at 12. This "intermediate position," however, is merely a point along the switch's linear track at which the user moves the switch either perpendicularly into the notched position or linearly into the "on" position, depending upon whether the user wants to load the dispenser or activate the motor. Plaintiff's argument is analogous to arguing that a light switch contains a third position because the switch can be fixed in a position between the "on" and "off" positions. Furthermore, it is entirely unsupported by any evidence in the record before the court.

The court thus finds that defendants' switch only moves between two linear positions, an "off" position and an "on" position. Because the doctrine of prosecution history estoppel precludes plaintiff from arguing that a dispenser featuring a switch that moves between two linear positions infringes upon plaintiff's patent, defendants' product does not literally infringe on the claims of the patent. Accordingly, defendants' motion for summary judgment is granted.

**AND IT IS SO ORDERED.**

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**EDUARDO C. ROBRENO,**

**J.**