

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

AD IN THE HOLE INTERNATIONAL INC. : CIVIL ACTION  
 :  
 v. :  
 :  
 NAPEX, et al. : No. 97-CV-600

M E M O R A N D U M

Ludwig, J.

February 25, 1999

Defendants NAPEX, Robert E. Porter, and Brian Kirsch move for summary judgment as to non-infringement of plaintiff's patent under the doctrine of literal infringement and the doctrine of equivalents. Fed. R. Civ. P. 52.<sup>1</sup> Jurisdiction is federal question, 28 U.S.C. § 1331, and is exclusive in patent actions, 28 U.S.C. § 1338(a).

The patent claims in question involve an insert located at the bottom of a golf cup, where it is visible to anyone standing nearby or reaching in to pluck out a recumbent little white ball. As plaintiff's name suggests – Ad in the Hole International Inc. – the purpose of the insert is to display an advertisement that may be of interest to golfers. In 1990, plaintiff was issued U.S. Patent No. 4,928,417 ('417 patent). It now contends that golf cups

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<sup>1</sup>"[A] literal infringement issue is properly decided upon summary judgment when no issue of material fact exists, in particular, when no reasonable jury could find that every limitation recited in the properly construed claim either is or is not found in the accused device. A claim under the doctrine of equivalents may [also] be decided on summary judgment." Bai v. L&L Wings, Inc., 160 F.3d 1350, 1353 (Fed. Cir. 1998) (citation omitted). "Where the evidence is such that no reasonable jury could determine two elements to be equivalent, district courts are obliged to grant partial or complete summary judgment." Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, \_\_\_, 117 S.Ct. 1040, 1053 n.8, 137 L.Ed.2d 146 (1997).

made by defendants infringe the '417 patent. Independent claims one and nine are at issue.

The accused device is also a golf cup that displays small advertisements in its bottom receptacle. Both cups – plaintiff's and defendants' – are hollow cylinders with substantially horizontal bottoms and a hole for the flag stick. In plaintiff's device, the advertising appears on inserts that are easily removable. The receptacle in the accused product has two trapezoidal pockets, with sealed, watertight transparent covers that protect the advertising and are not easily removable.<sup>2</sup> There are also four holes to provide drainage. It is undisputed that both devices generally have the same advertising function.

An infringement action consists of two steps. First, the claims in question must be construed for scope and meaning. See Markman, 517 U.S. 370, 371, 116 S.Ct. 1384, 1387, 134 L.Ed.2d 577 (1996). Second, it must be determined whether the claims, as construed, cover the accused device or process. See Serrano v. Telular Corp., 111 F.3d 1578, 1582 (Fed. Cir. 1997).

The objective of claims construction analysis is to ascertain the meaning that a person of ordinary skill in the art would give to the claims in dispute. See Wiener v. NEC

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<sup>2</sup>The covers can be removed but only, it appears, by using an instrument, which then allows the advertisements to be changed. Defendants maintain that this structural difference materially distinguishes their device from the patent. According to defendants, the purpose of the fixed structure is to avoid abrasion when the flag stick is inserted, provide a watertight seal over the graphics, and inhibit pilfering of the advertisements. Defs.' br. at 10.

Electronics, Inc., 102 F.3d 534, 539 (Fed. Cir. 1997); Haynes Int'l, Inc. v. Jessop Steel Co., 8 F.3d 1573, 1578 n.4 (Fed Cir. 1993). The operative time is the date of the application to the Patent and Trademark Office – here, June 10, 1988. See Randomex, Inc. v. Scopus Corp., 849 F.2d 585, 587 (Fed. Cir. 1988). In construing an asserted claim, the first and paramount precept is to look to the intrinsic evidence of record, *i.e.*, the patent itself together with the prosecution history before the Patent and Trademark Office. See Phillips Petroleum Co. v. Huntsman Polymers Corp., 157 F.3d 866, 870 (Fed. Cir. 1998). Intrinsic evidence is “the most significant source of the legally operative meaning of disputed claim language.” Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). “In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term.” *Id.* (citing Pall Corp. v. Micron Separations, Inc., 66 F.3d 1211, 1216 (Fed. Cir. 1995)).

Here, having reviewed the intrinsic evidence, it appears to be unnecessary – and unjustifiable – to go beyond the proffered record. The intrinsic evidence is legally sufficient for claims construction in this case.

Claim 1 requires:<sup>3</sup>

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<sup>3</sup>The analysis of claim 1 is generally applicable to independent claim 9, which reads:

A method for displaying an advertisement in a golf cup comprising the steps of:  
providing a substantially doughnut-shaped ring member which coaxially fits into a conventional golf cup;

(continued...)

An advertising device for a golf cup comprising:

a golf cup;

a substantially doughnut-shaped annular ring member having a center opening and having an external peripheral portion dimensioned to co-axially fit into said golf cup; and

advertising display means coupled to said ring member for displaying an advertisement visible to a golfer when adjacent to said golf cup.

'417 pat., col. 3, ll. 60 to col. 4, ll. 3. The parties do not dispute that this claim limitation is stated in a means-plus-function format. See 35 U.S.C. § 112, ¶ 6.

The interpretation of means-plus-function language is not restricted to the particular means in the specifications. See D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 1573-74 (Fed. Cir. 1985). Instead, under 35 U.S.C. § 112, ¶ 6, "the limitation shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." In other words, there is "no requirement that applicants describe or predict every possible means of accomplishing that function." D.M.I., 755 F.2d at 1574. Nevertheless, "the scope of a means-plus-function" claim is not limitless, but is confined to structures expressly disclosed in the specification and

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<sup>3</sup>(...continued)  
providing an advertisement on said ring member; and  
inserting said ring member into a golf cup.  
'417 pat., col. 4, ll. 33-39.

corresponding equivalents." Symbol Techs., Inc. v. Opticon, Inc., 935 F.2d 1569, 1575 (Fed. Cir. 1991). The Federal Circuit has explained the test for literal infringement of a means-plus-function claim:

For literal infringement of a section 112, ¶ 6 limitation, the fact-finder must determine whether the accused device performs an identical function to the one recited in the means-plus-function clause. If the identical function is performed, the fact-finder must then determine whether the accused device utilizes the same structure or materials as described in the specification, or their equivalents.

Mas-Hamilton Group v. LaGard, Inc., 156 F.3d 1206, 1211 (Fed. Cir. 1998) (citation omitted).

As conceded by defendants, in the context of equivalents, their device performs the same function – golf cup advertising – as that of the patent. Defs.' br. at 9.

The next question is whether the accused device employs either the same structure as is disclosed in the patent specification or an equivalent structure. Here, the accused device can not be said to be a replication of the patent. As noted, claim 1 depicts "a substantially doughnut-shaped annular ring member having a center opening and having an external peripheral portion dimensioned to coaxially fit into said golf cup." This ring is designed to be easily fitted into the cup and simple to remove. '417 pat., col. 1, ll. 44-53; abstract of '417 pat. Defendants' product also has an annular component – the cup bottom. But the advertisement holders are not inserted into the cup; instead, they

are affixed by plastic tabs that fit into small holes in the cup's bottom. To remove the holders, the tabs must be pried open. Nevertheless, while the outcome may be questionable, a reasonable fact-finder could find that the accused product contains a place for visual advertisements using a method equivalent to the patent. The accused product has an inverted cone-like structure at the bottom of the cup, which displays graphics in an equivalent manner as the patent when assembled.

Similarly, a reasonable fact-finder could find infringement under the doctrine of equivalents.

Under the doctrine of equivalents, a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is "equivalence" between the elements of the accused product or process and the claimed elements of the patented invention. Infringement may be found under the doctrine of equivalents if every limitation of the asserted claim, or its "equivalent," is found in the accused subject matter, where an "equivalent" differs from the claim limitation only insubstantially. Whether a component in the accused subject matter performs substantially the same function as the claimed limitation in substantially the same way to achieve substantially the same result may be relevant to this determination.

Ethicon Endo-Surgery, Inc. v. United States Surgical Corp., 149 F.3d 1309, 1315 (Fed. Cir. 1998) (citations and quotation omitted); see also Warner-Jenkinson Co. v. Hilton Davis Chem. Co., 520 U.S. 17, \_\_\_, 117 S.Ct. 1040, 1049, 137 L.Ed.2d 146 (1997) (the doctrine of equivalents must be applied on an element-by-element basis). The doctrine is designed "to prevent a 'fraud on the patent,' when

an accused infringer is 'stealing the benefit of the invention' by making insubstantial changes that avoid the literal scope of the claims." EMI Group N. Am., Inc. v. Intel Corp., 157 F.3d 887, 896 (Fed. Cir. 1998) (citation omitted).

The triple-identity test of equivalents may be summarized as follows. The fact-finder must inquire whether the accused product performs substantially the same function, in substantially the same way, to achieve substantially the same result as to each element of the claim. See Dawn Equip. Co. v. Ky. Farms Inc., 140 F.3d 1009, 1016 (Fed. Cir. 1998). Here, the first element is "a golf cup," which is evident and undisputed. The second element is "a substantially doughnut-shaped annular ring member having a center opening and having an external peripheral portion dimensioned to coaxially fit into said golf cup." A reasonable fact-finder could conclude that the accused product's bottom, which is conic with a center opening, is substantially similar to a doughnut-shaped ring that fits into a golf cup. The third element is an "advertising display means coupled to said ring member." If the second element is satisfied, then the third may be as well. As discussed, the bottom of the accused product contains pockets for resilient pads that display advertisements.

The differences in the products – the non-removability and configuration of the receptacle used in the accused device – are arguable. But the significance and effect of these difference presents a triable issue, which, while perhaps a close call, cannot

be resolved at this stage. It is not a "gimme." Accordingly, defendants' motion for summary judgment must be denied.

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Edmund V. Ludwig, J.

