

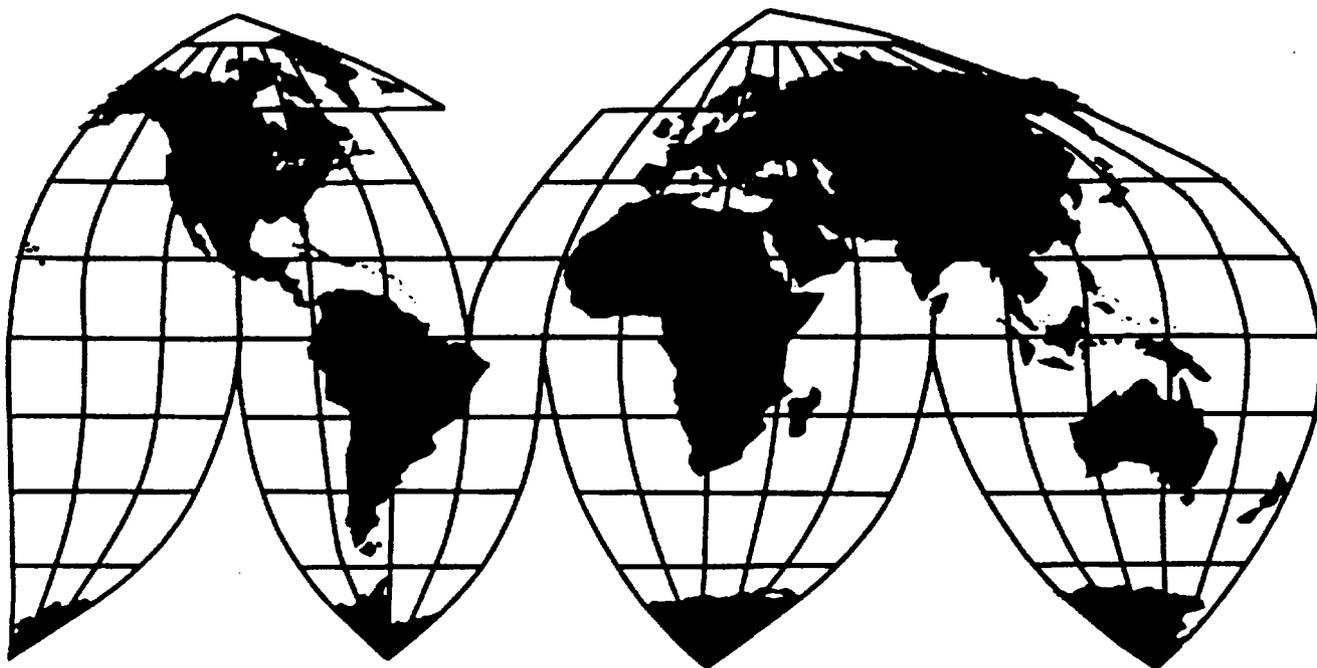
Certain Gel-Filled Wrist Rests and Products Containing Same

Investigation No. 337-TA-456

Publication 3573

January 2003

U.S. International Trade Commission



Washington, DC 20436

U.S. International Trade Commission

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Washington, DC 20436**

U.S. International Trade Commission

Washington, DC 20436

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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, DC 20436

In the Matter of

**CERTAIN GEL-FILLED WRIST RESTS
AND PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-456

02 NOV 25 09 37

OFFICE OF THE SECRETARY
U.S. INTERNATIONAL TRADE COMMISSION

**NOTICE OF FINAL DETERMINATION OF NO VIOLATION OF SECTION 337 OF
THE TARIFF ACT OF 1930**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined that there is no violation of section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337, in the above-captioned investigation.

FOR FURTHER INFORMATION CONTACT: Timothy P. Monaghan, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone 202-205-3152. Copies of all nonconfidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone 202-205-2000. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on 202-205-1810. General information concerning the Commission may also be obtained by accessing its Internet server (<http://www.usitc.gov>). The public record for this investigation may be viewed on the Commission's electronic docket (EDIS-ON-LINE) at <http://dockets.usitc.gov/eol/public>.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on May 17, 2001, based on a complaint filed on behalf of Minnesota Mining and Manufacturing Company (now called 3M Company) and 3M Innovative Properties Company (collectively complainants), both of St. Paul, Minnesota. 66 *Fed. Reg.* 27535 (2001). The complaint, as supplemented, alleged violations of section 337 of the Tariff Act of 1930 in the importation, sale for importation, and sale after importation of certain gel-filled wrist rests and products containing

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same that infringe certain claims of U.S. Letters Patent 5,713,544 ("the '544 patent"). The Commission named as respondents Velo Enterprise Co. Ltd., Taiwan; Aidma Enterprise Co. Ltd. ("Aidma"), Taiwan; Good Raise Chemical Industry Co., Ltd. ("Good Raise"), Taiwan; ACCO Brands, Inc., Lincolnshire, Illinois; Curtis Computer Products Inc. ("Curtis"), Provo, Utah; Allsop, Inc. ("Allsop"), Bellingham, Washington; American Covers Inc., Draper, Utah; and Gemini Industries ("Gemini"), Clifton, New Jersey. The complaint and notice of investigation were later amended to add Crown Vast Development Ltd. and Hornleon Company, Ltd. ("Hornleon") both of Taiwan as respondents.

On October 22, 2001, the presiding administrative law judge ("ALJ") issued an initial determination ("ID"), Order No. 6, granting complainants' unopposed motion to terminate the investigation with respect to respondent Gemini on the basis of a consent order. On January 9, 2002, the ALJ issued an ID, Order No. 12, finding respondents Good Raise and Aidma in default. On May 15, 2002, the ALJ issued an ID, Order No. 15, granting complainants' unopposed motion to terminate the investigation with respect to respondent Curtis on the basis of a consent order. On May 21, 2002, the ALJ issued an ID, Order No. 16, granting complainants' unopposed motion to terminate the investigation with respect to respondent Allsop on the basis of a consent order. None of these IDs was reviewed by the Commission.

The ALJ held an evidentiary hearing from January 14, 2002 to January 18, 2002.

On July 24, 2002, the ALJ issued his final ID in which he found no infringement of the claims of the '544 patent at issue, and hence no violation of section 337. He also found that complainants had failed to demonstrate satisfaction of the technical prong of the domestic industry requirement of section 337 for the '544 patent, and that the claims in issue of the '544 patent are invalid due to obviousness and failure to disclose the best mode of practicing the invention. The ALJ also found that the claims in issue of the '544 patent are not invalid due to anticipation, indefiniteness, lack of a written description or the lack of enablement, or improper joinder or non-joinder of inventors; that the '544 patent is not unenforceable due to inequitable conduct before the U.S. Patent and Trademark Office; and that complainants are not barred from asserting the '544 patent due to equitable estoppel. The ALJ noted that respondent Hornleon did not respond to the complaint and notice of investigation or provide written discovery in this investigation, although a representative of the firm appeared and testified at a deposition. Hornleon neither appeared at the hearing nor filed briefs. However, complainants did not move to find Hornleon in default. The ALJ thus found no violation of section 337 with respect to Hornleon, and no party contested that finding.

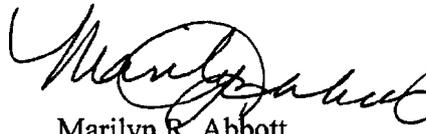
All parties filed petitions for review and subsequently responded to each other's petitions.

On September 9, 2002, the Commission determined to review: (1) the ID's construction of the asserted claims of the '544 patent; (2) the ID's infringement conclusions; (3) the ID's validity conclusions with regard to obviousness and failure to disclose best mode of practice; and (4) the ID's conclusion with respect to the technical prong of the domestic industry requirement. The Commission determined not to review the remainder of the ID.

In accordance with the Commission's instructions, the parties filed their main briefs on September 23, 2002, and reply briefs on September 30, 2002. Having examined the record in this investigation, including the briefs and the responses thereto, the Commission determined that there is no violation of section 337. More specifically, the Commission found that the domestic products of complainants do not practice any claim of the '544 patent, and thus the technical prong of the domestic industry requirement of section 337 is not met in this investigation. The Commission also found that the accused imported wrist rests, except the Jelly Mouse product, infringe the asserted claims of the '544 patent, and that the '544 patent is not invalid due to obviousness or failure to disclose the best mode of practicing the invention.

This action is taken under the authority of section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337, and sections 210.45-210.51 of the Commission's Rules of Practice and Procedure, 19 C.F.R. §§ 210.45-210.51.

By order of the Commission.

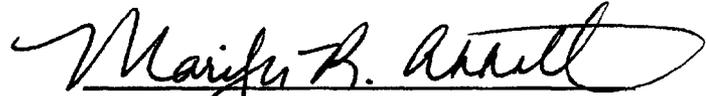


Marilyn R. Abbott
Secretary to the Commission

Issued: November 25, 2002

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF FINAL DETERMINATION OF NO VIOLATION OF SECTION 337 OF THE TARIFF ACT OF 1930**, was served upon the following parties, via first class mail and air mail where necessary on **November 25, 2002**.



Marilyn R. Abbott, Secretary
U.S. International Trade Commission
500 E Street, SW - Room 112
Washington, DC 20436

**ON BEHALF OF COMPLAINANT 3M
INNOVATIVE PROPERTIES COMPANY AND
MINNESOTA MINING AND
MANUFACTURING COMPANY:**

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LTD., AMERICAN COVERS INC., ACCO
BRANDS, INC., CROWN VAST
DEVELOPMENT, LTD.:**

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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C. 20436

In the Matter of

CERTAIN GEL-FILLED WRIST RESTS

Inv. No. 337-TA-456

000018

ORDER

03 JAN 23 P 2:36

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US INT'L TRADE COMM

The Commission instituted this investigation on May 17, 2001, based on a complaint filed on behalf of Minnesota Mining and Manufacturing Company (now called 3M Company) and 3M Innovative Properties Company (collectively complainants), both of St. Paul, Minnesota. 66 *Fed. Reg.* 27535 (2001). The complaint, as supplemented, alleged violations of section 337 of the Tariff Act of 1930 in the importation, sale for importation, and sale after importation of certain gel-filled wrist rests and products containing same that infringe certain claims of U.S. Letters Patent 5,713,544 (“the ‘544 patent”). The Commission named as respondents Velo Enterprise Co. Ltd., Taiwan; Aidma Enterprise Co. Ltd. (“Aidma”), Taiwan; Good Raise Chemical Industry Co., Ltd. (“Good Raise”), Taiwan; ACCO Brands, Inc., Lincolnshire, Illinois; Curtis Computer Products Inc. (“Curtis”), Provo, Utah; Allsop, Inc. (“Allsop”), Bellingham, Washington; American Covers Inc., Draper, Utah; and Gemini Industries (“Gemini”), Clifton, New Jersey. The complaint and notice of investigation were later amended to add Crown Vast Development Ltd. and Hornleon Company, Ltd. (“Hornleon”) both of Taiwan as respondents.

On October 22, 2001, the presiding administrative law judge (“ALJ”) issued an initial determination (“ID”), Order No. 6, granting complainants’ unopposed motion to terminate the investigation with respect to respondent Gemini on the basis of a consent order. On January 9, 2002, the ALJ issued an ID, Order No. 12, finding respondents Good Raise and Aidma in default. On May 15, 2002, the ALJ issued an ID, Order No. 15, granting complainants’ unopposed motion to terminate the investigation with respect to respondent Curtis on the basis of a consent order. On May 21, 2002, the ALJ issued an ID, Order No. 16, granting complainants’ unopposed motion to terminate the investigation with respect to respondent Allsop on the basis of a consent order. None of these IDs was reviewed by the Commission.

The ALJ held an evidentiary hearing from January 14, 2002 to January 18, 2002.

On July 24, 2002, ALJ issued his final ID in which he found no infringement of the claims of the ‘544 patent at issue, and hence no violation of section 337. The ALJ also found that complainants had failed to demonstrate satisfaction of the technical prong of the domestic industry requirement of section 337 for the ‘544 patent, and that the claims in issue of the ‘544 patent are invalid due to obviousness and failure to disclose the best mode of practicing the invention. The ALJ also found that the claims in issue of the ‘544 patent are not invalid due to anticipation, indefiniteness, lack of a written description or the lack of enablement, or improper joinder or non-joinder of inventors; that the ‘544 patent is not unenforceable due to inequitable conduct before the U.S. Patent and Trademark Office; and that complainants are not barred from asserting the ‘544 patent due to equitable estoppel. The ALJ noted that respondent Hornleon did not respond to the complaint and notice of investigation or provide written discovery in this investigation, although a representative of the firm appeared and testified at a deposition.

Hornleon neither appeared at the hearing nor filed briefs. However, complainants did not move to find Hornleon in default. The ALJ thus found no violation of section 337 with respect to Hornleon, and no party contested that finding.

All parties filed petitions for review and subsequently responded to each other's petitions.

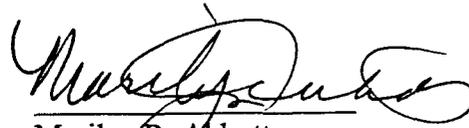
On September 9, 2002, the Commission determined to review: (1) the ID's construction of the asserted claims of the '544 patent; (2) the ID's infringement conclusions; (3) the ID's validity conclusions with regard to obviousness and failure to disclose best mode of practice; and (4) the ID's conclusion with respect to the technical prong of the domestic industry requirement. The Commission determined not to review the remainder of the ID.

In accordance with the Commission's instructions, the parties filed their main briefs on September 23, 2002, and reply briefs on September 30, 2002.

Having examined the record in this investigation, including the briefs and the responses thereto, it is hereby ORDERED THAT:

1. The investigation is terminated with a finding of no violation of section 337 of the Tariff Act of 1930 (19 U.S.C. §1337).
2. The Commission finds that no domestic industry exists with respect to the '544 patent.
3. The Commission finds that the accused imported wrist rests, except for the Jelly Mouse product, infringe claims 1, 3, 6, and 7 of the '544 patent.
4. The Commission finds that claims 1, 3, 6, and 7 of the '544 patent are not invalid due to obviousness.
5. The Commission finds that claims 1, 3, 6, and 7 of the '544 patent are not invalid for failure to disclose the best mode of practicing the invention.
6. The Secretary shall serve copies of this Order, and the Commission Opinion in support thereof, on the parties of record and on the Department of Health and Human Services, the Department of Justice, and the Federal Trade Commission, and publish notice thereof in the *Federal Register*.

By order of the Commission.

A handwritten signature in black ink, appearing to read "Marilyn R. Abbott", written in a cursive style.

Marilyn R. Abbott
Secretary

Issued: January 23, 2003.

Nunc Pro Tunc November 25, 2002

**CERTAIN GEL-FILLED WRIST RESTS AND
PRODUCTS CONTAINING SAME**

337-TA-456

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ORDER**, was served upon the following parties, via first class mail and air mail where necessary on January 23, 2003.



Marilyn R. Abbott, Secretary
U.S. International Trade Commission
500 E Street, SW - Room 112
Washington, DC 20436

**ON BEHALF OF COMPLAINANT 3M
INNOVATIVE PROPERTIES COMPANY AND
MINNESOTA MINING AND
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RESPONDENT:

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Hsichih
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Taiwan 221, R.O.C.

PUBLIC VERSION

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C. 20436

03 JAN 23 09:19

RECEIVED
OFFICE OF THE SECRETARY
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In the Matter of

**CERTAIN GEL-FILLED WRIST RESTS
AND PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-456

0011102

COMMISSION OPINION

On July 24, 2002, the presiding administrative law judge ("ALJ") issued his final initial determination ("ID") in the above-captioned investigation finding no violation of section 337 of the Tariff Act of 1930 by the respondents in the importation, sale for importation, and sale within the United States after importation of certain gel-filled wrist rests and products containing same. On September 9, 2002, the Commission determined to review the final ID in part. *67 Fed. Reg.* 58074 (September 13, 2002). This investigation is now before the Commission for final disposition of the issues under review and, if necessary, for determinations on remedy, the public interest, and bonding. We find no violation of section 337 of the Tariff Act of 1930, and therefore need not consider the issues of remedy, the public interest, and bonding.

I. BACKGROUND

The investigation was instituted on May 17, 2001, based on a complaint filed on behalf of

PUBLIC VERSION

3M Innovative Properties Company and Minnesota Mining & Manufacturing Company (now called 3M Company), both of St. Paul, Minnesota (collectively “complainants”). 66 *Fed. Reg.* 27535 (May 17, 2001). The complaint alleged violations of section 337 in the importation, sale for importation, and sale within the United States after importation of certain gel-filled wrist rests and products containing same by reason of infringement of claims 1, 3, 6, 7, or 8 of U.S. Patent No. 5,713,544 (“the ’544 patent”). The complaint named eight respondents: Velo Enterprise Co., Ltd. (“Velo”), Taiwan; Aidma Enterprise Co. (“Aidma”), Taiwan; Good Raise Chemical Industry Co., Ltd. (“Good Raise”), Taiwan; ACCO Brands, Inc. (“ACCO/Kensington”), Lincolnshire, Illinois; Curtis Computer Products, Inc. (“Curtis”), Provo, Utah; Allsop, Inc. (“Allsop”), Bellingham, Washington; American Covers, Inc. (“ACI”), Draper, Utah; and Gemini Industries, Inc. (“Gemini”), Clifton, New Jersey. The complaint and notice of investigation were later amended to add Crown Vast Development Ltd. (“Crown Vast”) and Hornleon Company, Ltd. (“Hornleon”), both of Taiwan, as respondents.

On January 7, 2002, complainants and respondents filed a “Stipulation Concerning Domestic Industry,” stipulating and agreeing to certain facts relating to the establishment of the economic prong of the domestic industry. An evidentiary hearing was held from January 14, 2002, through January 18, 2002. On October 22, 2001, the presiding administrative law judge (“ALJ”) issued an ID (ALJ Order No. 6) granting complainants’ unopposed motion to terminate the investigation with respect to respondent Gemini, on the basis of a consent order. On January 9, 2002, the ALJ issued an ID (ALJ Order No. 12) finding respondents Good Raise and Aidma in default. On May 15, 2002, the ALJ issued an ID (ALJ Order No. 15) granting complainants’

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unopposed motion to terminate the investigation with respect to respondent Curtis, on the basis of a consent order. On May 21, 2002, the ALJ issued an ID (ALJ Order No. 16) granting complainants' unopposed motion to terminate the investigation with respect to respondent Allsop, on the basis of a consent order. None of those IDs was reviewed by the Commission.

On July 24, 2002, the ALJ issued his final ID in which he found no infringement of the claims at issue, and hence no violation of section 337. He further found that complainants had failed to demonstrate satisfaction of the domestic industry requirement of section 337 for the '544 patent, and that the '544 patent is invalid due to obviousness and for failure to disclose the best mode of practicing the invention. Finally, the ALJ found that the '544 patent is not invalid due to anticipation, indefiniteness, lack of a written description or the lack of enablement, or improper joinder or non-joinder of inventors; that the '544 patent is not unenforceable due to inequitable conduct before the U.S. Patent and Trademark Office ("PTO"); and that complainants are not barred from asserting the '544 patent due to equitable estoppel. ID at 217-18.¹

On September 9, 2002, the Commission determined to review: (1) the ID's construction of the asserted claims of the '544 patent; (2) the ID's infringement conclusions; (3) the ID's validity conclusions with regard to obviousness and failure to disclose best mode of practice; and (4) the ID's conclusion with respect to the technical prong of the domestic industry requirement.

¹ In the ID, the ALJ noted that respondent Hornleon did not respond to the complaint and notice of investigation or provide written discovery in this investigation, although a representative of the firm appeared and testified at a deposition. Hornleon neither appeared at the hearing nor filed briefs. However, complainants did not move to find Hornleon in default. The ALJ thus found no violation of section 337 with respect to Hornleon, and no party has contested that finding. ID at 2 n.2.

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The Commission determined not to review the remainder of the ID.

In accordance with the Commission's instructions, the parties filed their main briefs on September 23, 2002, and reply briefs on September 30, 2002.

Having examined the record in this investigation, including the briefs and the responses thereto, we determine that there is no violation of section 337. More specifically, we find no domestic industry with respect to the '544 patent. We also find that the accused wrist rests, except ACI's Jelly Mouse product, infringe the asserted claims of the '544 patent, and that the '544 patent is not invalid due to obviousness or failure to disclose the best mode of practicing the invention.²

H. VIOLATION ISSUES

The Products and Patent at Issue

The patent in issue, the '544 patent, entitled "Wrist Rest Assembly," was issued on February 3, 1998. The inventors assigned the '544 patent to complainant 3M Innovative Properties Company, which licensed it to complainant 3M Company. The products at issue are gel-filled wrist rests for use in conjunction with a computer keyboard or mouse. These products are used to prevent carpal tunnel syndrome and similar ailments by providing a resilient and flexible wrist support.

Claim Construction

Infringement and validity analyses proceed on a claim-by-claim basis. *Amazon.Com, Inc.*

² Any factual findings of the ALJ that support this opinion are hereby adopted and any factual findings that are inconsistent with this opinion are rejected.

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v. BarnesandNoble.Com, Inc., 239 F.3d 1343, 1351 (Fed. Cir. 2001). The first step is to interpret, or construe, the proper scope and meaning of the claims in issue. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). Claim language is construed in view of the understanding of one of ordinary skill in the relevant art. *See, e.g., Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1379 (Fed. Cir. 1999). “Although words in a claim are generally given their ordinary and customary meaning, a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history.” *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996).

The starting point for claim construction is the claim language. Claims are construed in light of the “intrinsic evidence,” which consists of the language of the claims, the patent’s specification, and the patent’s prosecution history before the PTO. *Markman*, 52 F.3d at 979-80. The claim must be read in light of the specification, which may serve as a sort of dictionary to explain the invention and claim terms. *Id.* Similarly, the patent’s prosecution history, which is the record of the PTO proceedings leading to issuance of the patent, can be used to understand the language of the claim. *Id.* at 980. For example, the prosecution history limits the claims to exclude any interpretation that the patent applicant disclaimed during prosecution. *Southwall Techs., Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995).

“Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises. This evidence may

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be helpful to explain scientific principles, the meaning of technical terms, and terms of art that appear in the patent and prosecution history.” *Markman* at 980. Where the intrinsic evidence unambiguously defines the disputed claim language, extrinsic evidence may not be used to contradict the intrinsic evidence. *Bell & Howell Document Management Products Co. v. Altek Sys.*, 132 F.3d 701, 707 (Fed. Cir. 1997) (“[b]ecause the intrinsic evidence unambiguously defines the disputed claim limitation, the district court’s reliance on [expert testimony] to contradict the intrinsic evidence when interpreting the claims was error”); *see also Key Pharm. v. Hercon Labs. Corp.*, 161 F.3d 709, 716 (Fed. Cir. 1998) (“a trial court is quite correct in hearing and relying on expert testimony on an ultimate claim construction question in cases in which the intrinsic evidence (*i.e.*, the patent and its file history – – the ‘patent record’) does not answer the question,” but “if the meaning of a disputed claim term is clear from the intrinsic evidence – – the written record – – that meaning, and no other, must prevail”).

The Claims at Issue

The claims in issue of the ’544 patent (claims 1, 3, 6, and 7)³ read as follows:

1. *A wrist rest assembly* for use along the front edge of an input device to be operated by a person’s hands or fingers, said wrist rest assembly comprising:

a base having an upper surface and an opposite bottom surface adapted to be supported on a horizontal surface along the front edge of the device; and

a pad comprising a layer of stable elastomeric block polymer gel, said pad having opposite top and bottom surfaces, opposite longitudinally spaced ends, the bottom surface of said pad being supported on the upper surface of said base, said

³ Although claim 8 of the ’544 patent was included in the Notice of Investigation, complainants did not assert that claim in their post-hearing briefs. ID at 5.

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pad having the physical properties of *flexibility* and *compressibility* in the range of flexibilities and compressibilities of stable elastomeric block polymer gels made by mixing 4 to 10 parts of U.S.P. mineral oil with one part styrene-isoprene-styrene block copolymer and heating that mixture to approximately 149 degrees C while agitating vigorously until the polymer appears visually dissolved, and a sufficient thickness between said top and bottom surfaces and width between said edges to afford supporting a user's wrists on said top surface with a portion of the layer of gel beneath and conforming to the supported wrists and to *afford significant motion* of the top surface of the pad with the supported wrists relative to the bottom surface of the pad in a horizontal plane.

- 3. A wrist rest assembly according to claim 1 wherein said assembly further includes an outer layer over the top surface of the pad of soft comfortable material adapted for comfortable contact with a user's wrists.

* * *

- 6. A wrist rest assembly according to claim 1 wherein said pad is in the range of about 1/8 inch to 5 inches thick between said top and said bottom surfaces and said top surface is in the range of about 1/2 inch to 10 inches wide between said edges.
- 7. A wrist rest assembly according to claim 1 wherein the motion of said top surface of said pad with a supported wrist relative to said bottom surface of said pad in a plane generally parallel to the supported surface of the base allows that wrist to move in any direction in a generally circular area having a diameter of at least one half inch.

'544 patent, col. 7:19-54, col. 8:8-14 (emphasis added to highlight the claim limitations at issue).

Limitations at issue in claim 1 call for "a pad comprising a layer of stable elastomeric block polymer gel . . . said pad having the physical properties of flexibility and compressibility" between those of two reference gels, and the pad further affording "significant motion of the top surface of the pad with the supported wrists relative to the bottom surface of the pad in a horizontal plane." '544 patent, col. 7:25-44. The claim sets up a testing protocol that compares

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the physical properties of the stable elastomeric block polymer gel of the wrist rest in question with the physical properties of two reference gels, both made from a specific type of block polymer gel. One reference gel has four parts oil to one part polymer (the “4:1” reference gel), and the other has ten parts oil to one part polymer (the “10:1” reference gel). Measurements taken from these two reference gel samples provide the boundaries for the flexibility and compressibility limitations of claim 1 of the ’544 patent.

We affirm the ALJ’s finding that the “pad comprising a layer of stable elastomeric block polymer gel” of claim 1 must include a layer of stable elastomeric block polymer gel, but may include other features as well, such as the “tubular layer” of claim 2 or the “outer layer” or cover of claim 3. As discussed more fully below, although the preferred embodiment of the ’544 patent includes a cover as part of the “pad,” there is no basis for reading the cover of the preferred embodiment into claim 1 as a limitation.

The prior art Lindlof patent is mentioned twice in the specification of the ’544 patent.⁴ ’544 patent, col. 1:55 through col. 2:8. Lindlof provides a standard for understanding the stable elastomeric block polymer properties of gels covered by the ’544 patent. Lindlof is also listed as one of many prior art references cited during prosecution of the ’544 patent.⁵ Respondents argue that the claim term “block polymer gel” must be construed to mean a gel containing styrene

⁴ The Lindlof patent (U.S. Patent No. 3,676,387) is mentioned in the ’544 patent at col. 1:56 and its British counterpart (British Patent No. GB 1,268,431) is mentioned at col 2:67. FF 535

⁵ The PTO rejected certain pending claims of the application that matured into the ’544 patent as obvious over prior art showing a wrist support (the Sereboff patent) in view of prior art showing stable elastomeric block polymer gels (the Lindlof patent). FF 82.

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crystalline domains and oil. Both styrene crystalline domains and U.S.P. mineral oil are components of the gel to be used in the preferred Lindlof embodiment of the invention, *i.e.*, gels “[p]referably” like those disclosed in Lindlof. ’544 patent, col. 4:49-53. However, while the specification of the ’544 patent states that the gels to be used in connection with the claimed wrist rest assembly are “[p]referably” like the gels described in the Lindlof patent, it does not indicate that the claims of the ’544 patent are limited to the gels disclosed in Lindlof. We agree with the ALJ that there is no basis for using the discussion in the ’544 patent specification about the preferred gels disclosed in the Lindlof patent to limit the claims of the ’544 patent to only the gels disclosed in Lindlof. *Northern Telecom Ltd. V. Samsung Elecs. Co.*, 215 F.3d 1281, 1293 (Fed. Cir. 2000) (“This Court consistently declines to construe claim terms according to the preferred embodiment.”).

Other parts of the ’544 patent specification also make clear that the polymer block gel need not contain styrene crystalline domains, *e.g.*, ’544 patent col. 2:4-9, noting that the block polymers described in U.S. Patent No. 3,265,765, which are of many different types and chemical compositions, “are quite suitable in the practice of the present invention.” The specification also teaches the use of liquids other than mineral oil within the gels, *e.g.*, ’544 patent, col. 5:5-7, “to retain the gel 19 within the tubuar layer and provide a flexible barrier to the escape of mineral oil or other liquids from within the gel 19.” Respondents’ construction, which seeks to limit the gels of the claims at issue to Lindlof gels having styrene crystalline domains, is inconsistent with the intrinsic evidence.

As to the prosecution history, we find that the characterization of the prosecution history

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advanced by the ALJ, complainants, and the Commission investigative attorney (“IA”) is the most reasonable one. During prosecution, the applicants discussed the prior art and attempted to show the PTO examiner why the combination of solid Lindlof gels with the Sereboff wrist rest, with its liquid gel, would not be obvious. RX-2 at 68-71. In the original application, the specification stated that preferably “the gel is a stable elastomeric block polymer gel similar to the gel described” in the Lindlof patent. RX-2 at 012. While the ’544 patent, as finally issued, included a lengthier discussion of the gels, the language added to the specification in the amendment still does no more than state that the gels are preferably similar to the Lindlof gel. ’544 patent, col.1:55-56. The amendment does not state or suggest that the block polymer gel used in the claimed invention must be the gel disclosed in the Lindlof patent. The amendment only states that the block polymer gels of the ’544 patent are “preferably” polymer-oil combinations such as described in the Lindlof patent. Consequently, we agree with the ALJ that there is no basis in the prosecution history to find that the gel to be used in practicing the ’544 patent claims must be identical to the Lindlof gel, or that the ’544 claim terms must conform to the block polymer gel of the Lindlof patent.

We affirm the ALJ’s finding that neither the specification nor the prosecution history limit the claim term “block polymer gel.” It is possible for a patentee to define a term in the specification or in the prosecution history in such a way as to limit the scope of the claim.

Honeywell Inc. v. Victor Company of Japan, 2002 WL 176605 at *5 (Fed. Cir.). *Vitronics Corp.*, 90 F.3d at 1582-83. However, it must be clear that any such departure from common usage would be so understood by a person of ordinary skill in the art. *See, e.g., Markman*, 52 F.3d at

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982 (limitation in specification also in claim language); *Northern Telecom*, 215 F.3d at 1293 (entire specification expresses preference for gas plasma etching over ion bombardment, but suggestion in description of preferred embodiment that steps “should” be taken falls short of excluding methods that include such steps altogether); *Teleflex, Inc. v. Ficosa North America Corp.*, 2002 WL 1358720 (Fed. Cir.) at 9 (just because the specification discloses only one preferred embodiment does not automatically limit claim to the disclosed embodiment). *Markman*, 52 F.3d at 980. (“Although the prosecution history can and should be used to understand the language used in the claims, it too cannot ‘enlarge, diminish, or vary’ the limitations in the claims.”)

Block polymers come from many different chemical families. FF 90, 91. A “block polymer gel” is a polymer made up of alternating sections of one chemical composition separated by sections of another chemical composition. FF 413. In light of the absence of a clear indication to limit the claimed block polymer gel to the Lindlof gels or to gels with styrene crystalline domains and oil, we affirm the ALJ’s construction of “stable elastomeric block polymer gel” as block polymer gels “not specific to any particular chemical family or genus.” ID at 22.

The Technical Prong of the Domestic Industry Requirement

As a prerequisite to finding a violation of section 337, complainants must establish that “... an industry in the United States, relating to the articles protected by the patent ... concerned, exists or is in the process of being established.” 19 U.S.C. § 1337(a)(3). The domestic industry requirement of section 337 is traditionally viewed as having two prongs: the economic prong and

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the technical prong. *Certain Variable Speed Wind Turbines and Components Thereof*, Inv. No. 337-TA-376, Comm'n Opinion at 14-17 (1996). To satisfy the economic prong, the domestic industry must involve: (1) significant investment in plant and equipment; (2) significant employment of labor or capital; or (3) substantial investment in its exploitation, including engineering, research and development, or licensing. 19 U.S.C. § 1337(a)(3). To satisfy the technical prong, complainants must show that they practice at least one claim of the patent at issue.

We affirm the ALJ's finding that complainants do not practice the '544 patent, and that the domestic industry requirement of section 337 is therefore not met in this investigation. Of critical importance is the '544 patent's explicit prohibition against the use of certain oils in the claimed invention. The specification of the '544 patent states "[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils." '544 patent, col. 2:64-65. We find that the ALJ did not improperly read this prohibition on naphthenic oils from the specification into the claims; rather, he properly followed the rule that "[c]laims must be read in view of the specification, of which they are a part." *Markman*, 52 F.3d at 979-980. *Teleflex, Inc. v. Ficoso N. Am. Corp.*, 299 F.3d 1313, 1327 (Fed. Cir. 2002). "[C]laim terms take on their ordinary and accustomed meanings unless the patentee demonstrated an intent to deviate from the ordinary and accustomed meaning of a claim term by redefining the term or by characterizing the invention in the intrinsic record using words or expressions of manifest exclusion or restriction, representing a clear disavowal of claim scope." "The claims are directed to the invention that is described in the specification; they do not have meaning removed from the

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context from which they arose.” *Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1351 (Fed. Cir. 2001). “Although the specification need not present every embodiment or permutation of the invention and the claims are not limited to the preferred embodiment of the invention, neither do the claims enlarge what is patented beyond what the inventor has described as the invention.” *Netword*, 242 F.3d at 1352.

In the course of a six-paragraph discussion of preferred gels, preferred elastomeric block copolymers that are “useful in the practice of this invention” (2:9), and preferred paraffin-based petroleum oils that are “suitable in the practice of this invention” (2:60-64), the specification, as noted, makes the general statement that “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils.” ’544 patent, col. 2:64-65. The ALJ was correct in finding that “for the present invention” means for the claimed invention, not for an embodiment of the invention. Neither the statement itself, nor its context, give any indication that “[u]nsuitable for the present invention” in reality means unsuitable for the preferred embodiment. In the midst of the detailed six-paragraph discussion of what gel compositions are “suitable” “in the practice of this invention” (’544 patent col. 2:9, col. 2:11, col. 2:63), the specification unequivocally uses an expression of “manifest exclusion or restriction, representing a clear disavowal of claim scope,”⁶ that certain oils are unsuitable “for the present invention.”

Four paragraphs of the six-paragraph discussion in the specification of preferred and suitable polymer-oil combinations for use in “practice of the present invention” (’544 patent col.

⁶ *Teleflex*, 299 F.3d at 1327.

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2:8-9) are taken, word-for-word, from the prior art Lindlof patent. *Compare* '544 patent col. 2:10-65 *with* RX-7, col. 1:67-2:37 and 2:60-69. The IA argues that five of the six paragraphs in the specification ('544 patent col. 1:55 through col. 2:65) describe the polymer-oil combinations useful in creating a Lindlof gel, and that the sentence “[u]nsuitable for purposes of the present invention are aromatic, naphthenic and cyclic containing oils” is part of the quotation taken directly from the Lindlof patent. Thus, in the IA’s view, that sentence is “nothing more than a description of what oils to use or not to use to make the preferred gels.” IA’s Br., p. 13. However, the IA appears to have read the discussion of preferred and “suitable” polymer-oil combinations with the benefit of hindsight, *i.e.*, knowing that a major portion of this section is taken directly from the Lindlof patent, and knowing that the Lindlof patent is a preferred embodiment. While the sentence in question -- “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils”-- is a direct quote from the Lindlof patent, there is no indication in the '544 patent that it is a direct quote from Lindlof, and even in the Lindlof patent the sentence excludes certain oils from “the present invention,” not from the preferred embodiments.

As noted, the '544 patent specification makes clear that the Lindlof gels represent a preferred embodiment of the invention. The ALJ correctly refused to read the reference to the Lindlof gel as a limitation on claim 1 of the '544 patent since the specification clearly states that “[p]referably” the Lindlof gels are “suitable” for “the present invention.” However, after stating that “[p]referably” the Lindlof gels are “suitable” for “the present invention,” the six-paragraph discussion then goes on to discuss suitable and unsuitable gel combinations for use in “the

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present invention.” The fifth paragraph in the six-paragraph discussion ends with the sentence at issue, *i.e.*, “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils.” There is no indication at this point that reference is being made to the preferable Lindlof gels, *i.e.*, that naphthenic oils are unsuitable for creating the preferred Lindlof gels. In sum, there is no indication or notice in the discussion of polymer-oil combinations surrounding the sentence “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils” that the sentence is referring to the preferred Lindlof gel, nor is there any indication that aromatic, naphthenic, and cyclic containing oils are unsuitable for only for embodiments of the claimed invention. Thus, we find that the statement “[u]nsuitable for the present invention” operates as a limitation on the claims of the ’544 patent.

Complainants argue that the Federal Circuit’s decision in *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558 (Fed. Cir. 1996), is “directly on point” with regard to the issue of “when the specification may suggest that a particular embodiment is not within the scope of the invention.” Complainants’ Br. p. 63. In *PPG*, the claimed invention was a range of compositions for automotive solar control glass. Due to an instrumentation error, the specification erroneously described one example of glass composition that came within the *claimed* ranges as not satisfying the ultraviolet blocking requirement of the claim at issue. The accused infringer argued that the specification error disclaimed that composition even though the composition was covered by the claims. The Federal Circuit held that “even if the inventor’s use of flawed testing equipment led to the belief [from an example in the specification] that glass having composition of competitor’s glass would not satisfy” the ultraviolet transmission

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requirement of the claim at issue, since the claim was not qualified in that manner, the accused device did infringe. *PPG*, 75 F.3d at 1562. However, in the present investigation the sentence “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils” does not describe oils that are merely unsuitable for the preferred embodiment. Rather, the sentence means exactly what it says, *i.e.*, aromatic, naphthenic and cyclic containing oils are unsuitable for “the present invention.”

Both complainants and the IA cite to *Honeywell Inc. v. Victor Co.*, 298 F.3d 1317 (Fed. Cir. 2002), for the proposition that even when a specification disclaims certain subject matter that “the description, when considered in context, was not a disclaimer of subject matter, but simply an explanation of the preferred embodiment of the invention.” IA’s Br. p. 25. The claim at issue in *Honeywell* dealt with an aperture mask for use in a digital camera. The claim recited that the mask must be “contiguous” to a “transparent member,” and the “transparent member” must be “contiguous” to a circuit chip. At issue was whether use of the term “contiguous” in the claim at issue required that those items be in contact or merely near one another. Although the specification taught that the solution of two technical problems required the “transparent member” to be in contact, *i.e.*, on top of the mask, and the mask to be in contact with the circuit chip, the Federal Circuit did not read that limitation into the claims. Since the claim at issue did not require any particular ordering, the Court refused to read “a description of a preferred embodiment” into the claims. *Honeywell*, 298 F.3d at 1325. However, in the present investigation “[u]nsuitable for the present invention” is not simply a disclaimer of subject matter in the preferred embodiment. The prohibition against aromatic, naphthenic and cyclic containing

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oils is a broad, general statement that is not qualified or limited to a particular embodiment of the invention. We hold complainants to the plain meaning of the statement, *i.e.*, “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils.” The specification sets forth a number of embodiments suitable “for the present invention,” but it also expressly restricts “the present invention” to compositions that do not include aromatic, naphthenic and cyclic containing oils.

In both *PPG* and *Honeywell*, the Federal Circuit refused to restrict the claims at issue based on a disclaimer of subject matter in a particular embodiment disclosed in the specification. However, because the sentence at issue uses the phrase “for the present invention,” its import is not limited to a particular embodiment of the invention, but rather relates to the invention of the ’544 patent as a whole. In *SciMed*, the court found that the description of a particular structure that used the words for “the present invention” was “strong evidence that the claims should not be read to encompass the opposite structure.” *SciMed*, 242 F.3d at 1343. Similarly, in *Watts v. XL Sys., Inc.*, 232 F.3d 877 (Fed. Cir. 2000), the court found that “the specification actually limits the invention to structures that utilize misaligned taper angles, stating that ‘[t]he present invention utilizes [the varying taper angle] feature.’” *Watts*, 232 F.3d at 882 (emphasis added). “Where the specification makes clear that *the invention* does not include a particular feature, that feature is deemed to be outside the reach of the claims of the patent, even though the language of the claims, read without reference to the specification, might be considered broad enough to encompass the feature in question.” *Watts*, 232 F.3d at 882 (emphasis added). Similarly, the Federal Circuit in *Modine Manufacturing Co. v. United States International Trade Commission*,

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75 F.3d 1545 (Fed. Cir. 1996), found that “‘where the patentee describes an embodiment as being *the invention itself* and not only one way of utilizing it,’ this description guides understanding the scope of the claims.” *Modine*, 75 F.3d at 1551, citing *Autogiro Co. of America v. United States*, 384 F.2d 391, 398 (Ct. Cl. 1967) (emphasis added). Similarly, we find that the sentence “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils” is “strong evidence” that the claims at issue should not be read to encompass aromatic, naphthenic and cyclic containing oils.

Complainants argue that one of ordinary skill in the art would read the statement prohibiting aromatic, naphthenic and cyclic containing oils from “the present invention” “to mean that naphthenic oils cannot be present in such sizeable quantity to prevent formation of a stable, elastomeric gel.” Complainants’ Resp., pp. 26-27. However, complainants do not cite to any testimony of record indicating that one of ordinary skill in the art would read the statement prohibiting aromatic, naphthenic and cyclic containing oils from “the present invention” as prohibiting only large amounts of the oils. There is, however, testimony to the effect that a person of ordinary skill in the art would understand that, when making a gel that meets the limitations of claim 1 of the ’544 patent, one must not use naphthenic oils. Stout Tr. 638:2-12; Hauser Tr. 899:18-902:8 and 970:15-25. The statement “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils” is not merely a prohibition on using large amounts of aromatic, naphthenic and cyclic containing oils in “the present invention.” However, we also do not view the statement as prohibiting even trace or contaminant amounts of naphthenic and cyclic containing oils in “the present invention.” We find that the sentence at

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issue is a prohibition on purposely using “aromatic, naphthenic and cyclic containing oils” “for the present invention” but does not foreclose the use of trace amounts of naphthenic oils.

[

] Kraton D4433 is a polymer containing 23 percent Shellflex 371 oil.

Shellflex 371 oil, in turn, is a blend of oils, including 46 percent naphthenic oil. RX-253 at 3M002236. Thus, Kraton D4433, of which Shellflex is a component, contains a total of about

10.5 percent naphthenic oil. The manufacturer of Superla 31 states that Superla brand oils generally contain “mixtures of saturated paraffinic and naphthenic hydrocarbons.” RX-187.

However, there is no evidence in the record of exactly how much naphthenic oil is in Superla 31.

[

]There is no indication in the

manufacturer’s data in evidence that the naphthenic oil in the Superla 31 mixture is only a trace

amount. As noted, respondents’ expert Hauser stated that he did not know how much

naphthenic oil was in Superla 31. On cross examination, he testified as follows:

Q It may have just a trace amount as far as you’re concerned?

A It has enough such that the manufacturer considers it appropriate to report that, inasmuch as there are 10 different mineral oils on that particular data sheet. I wouldn’t be surprised but it varies from one oil to another.

Hauser Tr. 1009, referring to RX-187, Superla manufacturer’s data sheet.

Co-inventor Wolf testified that “Superla has a small percentage of the naphthenic oil, but

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a large percentage of the paraffinics, that does the swelling of the gels.” Wolf Tr., 114. [

[

]175:19-20 and 177:5-8.

Thus, [

] However, it is clear that both the

Superla 31 oil and the Kraton D4433 polymer in the gel contain more than a trace or contaminant amount of naphthenic oil. Both are “naphthenic containing.”

In conclusion, we find the words “[u]nsuitable for the present invention are aromatic, naphthenic and cyclic containing oils” are words of “manifest exclusion,” excluding more than a trace or contaminant amount of aromatic, naphthenic and cyclic containing oils from “the present invention” and not merely from an embodiment of the invention. [

]

We agree with the ALJ that:

[i]t would be legally untenable to allow the patentees to tell those seeking to understand

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the claimed invention that aromatic, naphthenic and cyclic containing oils are unsuitable, and then to allow the patentees and/or their assigns to show that they are practicing the claimed invention by using an oil from the precise group of oils that are stated to be unsuitable.

ID, p. 120.⁷ We adopt the ALJ's finding that complainants' wrist rests do not practice any claim at issue of the '544 patent, and that complainants have thus failed to establish the domestic industry element of a section 337 violation.

In addition to the prohibition on aromatic, naphthenic and cyclic containing oils, respondents argue that complainants have failed to carry their burden as to domestic industry because they did not present expert testimony or other evidence that their WR-410 wrist rest has a "base" and a "pad" that "has opposite top and bottom surfaces, opposite edges, and sits on the base," and a wrist rest that affords significant motion. Respondents Resp., p. 92. We agree with the IA that the WR-410 wrist rest is itself in evidence, and that it is obvious by visual inspection of the WR-410 that it has a "base" and a "pad" with top and bottom surfaces, opposite edges, and sits on the base. The Federal Circuit has stated that "[w]e have never *required* a party to proffer expert testimony on claim interpretation or on application of claim language to accused devices." *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1270 (Fed. Cir. 1986) (emphasis in original), *cert. denied*, 479 U.S. 1050 (1987). With respect to whether the pad allows significant

⁷ "[C]ompetitors are entitled to review the public record, apply the established rules of claim construction, ascertain the scope of the patentee's claimed invention and, thus, design around the claimed invention." *Vitronics Corp. v. Conceptronics*, 90 F.3d 1576, 1583 (Fed. Cir. 2001); *Markman vs. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (en banc), *aff'd*, 517 U.S. 370 (1996); *Digital Biometrics, Inc. v. Identrix, Inc.*, 149 F.3d 1335, 1347 (Fed. Cir. 1998).

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motion, complainants' expert Thomas testified that he had tested the WR-410 for significant motion, and that it infringed claim 1 of the '544 patent. Thomas, Tr. 519, 595. In the absence of evidence to the contrary, we find that complainants' WR-410 wrist rest meets the "base," "pad" and significant motion limitations of claim 1 of the '544 patent.

Infringement of the '544 Patent

The second step in an infringement analysis is to compare the claim, as construed, with the accused device to determine whether the device is within the scope of the claim. *Electro Med. Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017, 1020 (Fed. Cir. 1994). If the claim covers or "reads on" the accused device, then the claim is "literally" infringed. *See, e.g., Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 532, 41 U.S.P.Q.2d 1001, 1007 (Fed. Cir. 1996) (citing *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1580, 12 U.S.P.Q.2d 1382, 1384 (Fed. Cir. 1989)).

Literal Infringement

We find that all of respondents' accused wrist rests, except the Jelly Mouse product, literally infringe the claims at issue of the '544 patent. We find that all of the accused wrist rests meet the "block polymer gel" and "significant motion" limitations of claim 1 of the '544 patent. However, in view of the infringement test results of Thomas, we find that the Jelly Mouse product falls outside the claimed flexibility range of claim 1 of the '544 patent and thus does not infringe any claim at issue of the '544 patent.

Respondents argue that their products do not contain a "stable elastomeric block polymer gel" containing styrene crystalline domains or oil. However, as explained above, the "stable

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elastomeric block polymer gel” of claim 1 of the ’544 patent need not contain styrene crystalline domains or oil, and thus all the accused wrist rests have the requisite block polymer gel of claim 1 of the ’544 patent.

More significantly, the parties dispute the results of tests for flexibility and compressibility. The ALJ found that complainants did not test the physical properties of the accused products in the way required by the patent claims, *i.e.*, complainants tested only the *gels* of the accused pads rather than testing the gels *including any covering* on the gel. ID at 43. The ALJ found that the pad of claim 1 need not include a cover, but then concluded that if an accused product has a cover, the cover is part of the pad for claim 1. The ALJ found for infringement purposes that the complainants should have tested the gels with the outer covering on the gel. However, the ALJ committed an error of law by employing a different claim construction in his infringement analysis than he employed in his claim construction analysis. The ALJ’s findings of facts state that the “pad of claim 1 comprises a layer of stable elastomeric block polymer gel.” FF 58. In the “Claim Construction” portion of the ID, the ALJ found that claim 1 is broad enough to cover a wrist rest pad assembly with a tubular layer (claim 2) and an outer layer (claim 3), but he specifically rejected respondents’ contention that the “pad” of claim 1 must include a cover. ID at 14. In rejecting that construction, the ALJ noted that no language to support such a limitation was to be found in claim 1. Nor did the ALJ find a reason in the specification for reading a cover into claim 1 as a limitation. ID at 14.

The limitation here at issue calls for “a pad comprising a layer of stable elastomeric block polymer gel . . . said pad having the physical properties of flexibility and compressibility”

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between those of two reference gels, and the pad further affording “significant motion of the top surface of the pad with the supported wrists relative to the bottom surface of the pad in a horizontal plane.” (’544 patent, col. 7:25-44). The term “comprising” means that the pad must include at least a layer of gel, but may include other features. *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501 (Fed. Cir. 1997) (“‘Comprising’ is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.”). The term “comprising” should not be construed to mean that whenever a feature is added to a structure (*e.g.*, a cover over a pad), a new structure is inevitably created (*e.g.*, a covered pad), and infringement can only be determined by evaluating the new structure. Such an interpretation would vitiate the well-established rule that infringement cannot be avoided merely by adding features to an infringing device. *Northern Telecom*, 215 F.3d at 1296-97 (“if a patent requires A, and the accused device or process uses A and B, infringement will be avoided only if the patent’s definition of A excludes the possibility of B”).

Respondents argue that no matter how the claims are construed, “the accused product must be tested as it is intended to be used.” Respondents’ Br., p. 5, 16. Respondents, however, cite to no authority for this proposition. Respondents, in effect, argue for a second claim construction during the infringement stage, *i.e.*, even though the term “pad” is properly interpreted to mean a “layer of stable elastomeric block polymer gel,” if an accused wrist rest has a cover over the gel, infringement testing must be done with the cover on the gel.

A construction of “pad” that does not include the cover also comports with the doctrine of

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claim differentiation because it preserves the differences between claims 1, 2, and 3. Claim 1 speaks of a “pad comprising a layer of gel,” claim 2 speaks of a pad comprised of “an elongate tubular layer of flexible polymeric material around the gel,” and claim 3 speaks of an “assembly” that “further includes an outer layer over the top surface of the pad.” ’544 patent at col. 7:45-53. The construction of “pad” that does not include a cover preserves the differences between claim 1 and claims 2 and 3. *Ecolab, Inc. v. Paraclipse, Inc.*, 285 F.3d 1362, 1375-76 (Fed. Cir. 2002) (presumption of claim differentiation is especially strong where there is a dispute over whether a limitation found in a dependent claim should be read into an independent claim and that limitation is the only meaningful difference between the two); *Dow Chemical Co. v. United States*, 226 F.3d 1334 (Fed. Cir. 2000) (appropriate to give independent claim 1 a broader reading than dependent claim 4 if incorporating claim 4 would render it redundant).

Thus, we find that the term “pad” of claim 1 of the ’544 patent means “a layer of stable elastomeric gel” and that infringement of the claims at issue can be proven by testing the accused gels without any outer coverings on the gels.

As to the tests for infringement, we find that the tests of complainants’ expert Thomas are reliable. Thomas used an American Society for Testing and Materials (“ASTM”) standard test protocol throughout his experiments on the reference gels and the accused gels. Thomas testified that he tested each reference gel sample and each accused infringing gel sample with the same machine, under the same conditions, and using the same test parameters. Thomas, Tr. 342, 1100-1103. Claim 1 of the ’544 patent calls for a relative comparison between the reference gels and an accused gel to determine infringement. Specific parameters such as the particular rate at

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which force is applied compressively or laterally are irrelevant so long as the same rate is maintained when testing all gel samples. Thomas, Tr. 591-592. Thomas systematically tested the gel samples under the same conditions and rates and made a comparison of the compression and flexibility properties of the reference gels and accused gels. Thomas, Tr. 590-591.

Respondents' expert Hauser's durometer tests were conducted with a cover on the accused Velo gels. Those tests are contrary to our claim construction, thus making an accurate comparison with the reference gels impossible. RX-328, Tables 1-2; RX-329, Table 1. Hauser's flexibility and compressibility test also contains unexplained inconsistencies. For example, many of Hauser's tests found that 4:1 and 10:1 reference gels had the same compressibility. RX-329, Table 1. Similarly, Hauser ran flexibility tests on the Velo gels at only one value, and he obtained results for the same gel which differed by as much as 20 to 50 percent. RX-328, Table 2. Thomas' tests, on the other hand, are generally consistent, and show the gels behaving as they would be expected to behave. The results for each type of gel are consistently in the same range and the test results change consistently as more pressure is applied. CX-562C-570C.

As to infringement under Thomas' tests, we do not find that Thomas' results support a conclusion that all of the Velo gels have the requisite physical properties to infringe the claims in issue of the '544 patent. Both complainants and respondents selectively cull data from Thomas' test results to "prove" their various infringement arguments. However, we find that the tables submitted with the IA's brief are the most persuasive. The IA averaged Thomas' test results for

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the Nujol® reference gels and the accused gels.⁸ IA’s Br., p. 17. The IA’s summary of Thomas’ results for the compressibility ACI’s Jelly Mouse reveals that these gels have a compressibility outside the range of the two reference gels. The results of Thomas’ compression tests, averaged by the IA, are set forth in the table below:

Displacement (inches)	Average Compression Results for the 4:1 Reference Gel, in psi	Average Compression Results for the 10:1 Reference Gel, in psi	Compression Results for the ACI Jelly Mouse in psi
0	0	0	0
0.014	0.18	0.06	0.02
0.028	0.42	0.13	0.07
0.043	0.64	0.20	0.13
0.057	0.91	0.28	0.20
0.071	1.21	0.35	0.27
0.085	1.51	0.43	0.37
0.099	1.85	0.52	0.47
0.113	1.97	0.62	0.58

For every value of ACI’s Jelly Mouse product tested by Thomas, the compressibility of the Jelly Mouse product was outside (*i.e.*, below) the claimed range. We therefore find that complainants have not established infringement with respect to the Jelly Mouse products.

Complainants argue that *San Huan New Materials High Tech, Inc. v. International Trade*

⁸ Thomas’ experimental data for Cyber-Gel are presented in tabular form in CX-563C, CX-566C, and in graph form in CX-562C.

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Comm'n, 161 F.3d 1347 (Fed. Cir. 1998), *cert. dismissed*, 528 U.S. 959 (1999), supports a finding that results that are outside a claimed range by small amounts are still sufficient to demonstrate infringement. However, the claim at issue in *San Huan* called for a "permanent magnet alloy, consisting essentially of, in weight percent . . . 6,000 to 35,000 ppm oxygen and balance boron." *Id.* at 1357. The phrase "consisting essentially of" is a patent term of art that allows for small differences in the claimed range amounts. Similarly, in *Jeneric/Pentron*, the claim at issue contained a "mixture of imprecise and precise claim limitations." *Jeneric/Pentron*, 205 F.3d at 1382. Where the claim qualified the claimed chemical range with the term "about," the court allowed for small differences in the claimed range, but where the claimed ranges contained no such qualifiers, the court limited the claimed chemical ranges to the precise claimed range. Claim 1 of the '544 patent does not claim wrist rests using gels having flexibilities or compressibilities "about" or "approximately" or "essentially" between those of the two reference gels. It claims a "pad having the physical properties of flexibility and compressibility in the range of flexibilities and compressibilities" of the two reference gels. There is nothing in the claim that would indicate to one of skill in the art that "close" was "good enough," as complainants argue. Since there is no indication that the claimed ranges of claim 1 of the '544 patent are approximate, we hold complainants to the precise ranges set forth in the claim.

Complainants argue that because the test results for the Jelly Mouse are within experimental error of the reference gels, those results demonstrate infringement. However, in this case, Thomas testified that his instruments were capable of a high degree of precision, particularly when repeated tests are run. Thomas Tr. 576. The evidence shows that Thomas' test

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results, which he chose to measure in hundredths of psi, were accurate at those values. Although Thomas tested only one Jelly Mouse sample, all test results for the Jelly Mouse were outside the claimed range.

As to the Cyber-Gel product manufactured by Velo/Crown Vast and sold by ACI, we find that complainants have established that the flexibility of the Cyber-Gel product falls between that of the claimed reference gels of claim 1 of the '544 patent. Flexibility, as used in the '544 patent, refers to the degree of deflection (under a load placed in contact with the top surface of the gel pad) as a function of the shearing force induced by applying a force parallel to the top surface of the pad. CX-298C, p. 8. Thomas' flexibility tests indicate that the ACI Cyber Gel wrist rest falls outside the range of flexibility described in claim 1 for a displacement of 0 to .284 inches. FF 111, CX-298C at Ex. 1. Thomas testified that flexibility is related to significant motion and significant motion is recited in claim 7 as being a displacement of 0.5 inch diameter (a 0.25 inch radius) and in claim 8 as being a displacement of a 1 inch diameter (a 0.5 inch radius). Thus, Thomas concluded that significant values for his flexibility test *began* at about 0.25 inch radius displacement (from 0.25 inches displacement to 0.5 inches displacement). Thomas Tr. 475-76. The IA submitted a table averaging and summarizing Thomas' flexibility test results for ACI's Cyber-Gel.⁹ IA's Br., p. 18. As can be seen from this table, for displacements greater than 0.284 inches the results for ACI's Cyber-Gel product are within the range for the Nujol® reference gels.

⁹ Thomas' test results for Cyber-Gel are presented in tabular form in CX-563C, CX-564C, and in graph form in CX-562C.

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Displacement (inches)	Average Flexibility Results for the 4:1 Reference Gel, in psi	Average Flexibility Results for the 10:1 Reference Gel, in psi	Average Flexibility Results for the ACI Cyber-Gel, in psi
0	0	0	0
0.057	0.12	0.067	0.32
0.113	0.29	0.13	0.45
0.170	0.49	0.18	0.61
0.227	0.70	0.24	0.77
0.284	0.92	0.30	0.93
0.340	1.11	0.36	1.10
0.397	1.31	0.42	1.31
0.454	1.50	0.47	1.46
0.51	1.71	0.53	1.68

Thus, for a number of significant displacement values ACI's Cyber-Gel product falls within the claimed range for the Nujol® reference gels. Although there are some Cyber-Gel values that are not within the claimed flexibility range, for the most significant flexibility values the Cyber-Gel falls within the claimed range, and we therefore find that ACI's Cyber-Gel product infringes claim 1 of the '544 patent.

With respect to the remainder of the accused products, the evidence shows that those products do have gel pads with flexibility and compressibility characteristics of the claimed ranges of claim 1 of the '544 patent. The results of Thomas' tests in this regard are set forth in CX-562C (chart comparing the test results); CX-563C (data from tests on reference gels); CX-

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567C (data from tests on Kensington Micro-Gel samples); CX-568C (data from tests on Aidma Aidata sample); and CX-569C (data from tests on Gemini AT&T sample).

As to the significant motion claim limitation, we find that all of the Velo gels have the required “significant motion” of claim 1 of the '544 patent. Claims 7 and 8 give examples of what constitutes significant motion as a “diameter of at least one half inch” and “a diameter of about one inch,” respectively. '544 patent, col. 7:8-19. Complainants' expert Thomas correctly tested the gel pad without a cover and found that there was sufficient thickness to move his wrist at least one half inch and up to about one inch in diameter in all directions for some of the samples. Thomas Tr. 414-15, 538-39. This experiment is consistent with Thomas's flexibility tests that also moved the top surface of the gel up to about one inch with small loads. CX 562, CX 564, CX 565, CX 566, CX 567, CX 568, and CX 569.

As to the other claims at issue that depend from claim 1 of the '544 patent: claim 3 recites a cover of a soft conformable material, and all the accused products have such a cover over the gel pads (Thomas, Tr. 416-17); claim 6 recites the pads that are between 1/2 and 5 inches thick and between 1/2 to 10 inches wide, and all the accused products are between those dimensions (Thomas, Tr. 416); and claim 7 recites gel pads that allows a user's wrist to move in a roughly circular area with a diameter of at least 1/2 inch, and all the accused products allow a user's wrist to move in a such a circular area (Thomas, Tr. 417).

We therefore find that the preponderance of the evidence shows that all the accused products, except the Jelly Mouse products, infringe all claims at issue of the '544 patent. Since the Jelly Mouse products fall outside the claimed flexibility range of claim 1 of the '544 patent,

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those products do not infringe the claims at issue of the '544 patent.

Infringement Under the Doctrine of Equivalents

Complainants did not raise the issue of infringement under the doctrine of equivalents in their pre-hearing statement. In addition, no argument relating to the doctrine of equivalents was presented at the hearing. Pursuant to the ALJ's Ground Rule 4(d), this issue has therefore been waived.

Validity of the '544 Patent

Regardless of whether a claim reads on an accused device, no infringement will be found if the claim is found to be invalid. There is a statutory presumption that a patent claim is valid, a presumption that can be overcome only by clear and convincing evidence of invalidity. 35 U.S.C. § 282; *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1459 (Fed. Cir. 1984). Claims must be construed in the same manner in analyzing both invalidity and infringement. *See, e.g., SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 882, 8 U.S.P.Q.2d 1468, 1471 (Fed. Cir. 1988). The Commission has reviewed the invalidity defenses of obviousness and failure to disclose the best mode of practicing the invention.

Obviousness

A claim may be found invalid if there is clear and convincing evidence that the invention would have been obvious to one of ordinary skill in the art in light of the *combined* teachings of two or more items of prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 37 (1966). An analysis of obviousness requires determinations regarding the scope and content of the prior art; the

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differences between the prior art and the claimed invention; the level of ordinary skill in the art; and any so-called “secondary” or “objective” indicia that the invention is nonobvious, such as commercial success, copying, or a long-felt but unmet need. *Graham*, 383 U.S. at 17. In asserting such “secondary” evidence, the patentee must demonstrate a nexus between the invention disclosed and claimed and the commercial success of the product. *Tec Air, Inc. v. Denso Mfg. Michigan Inc.*, 192 F.3d 1535 (Fed. Cir. 1999). In addition, there must be some *suggestion* to combine the references, for it is impermissible to use hindsight to piece the invention together using the patented invention as a template. *See, e.g., Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 U.S.P.Q.2d 1377, 1379-80 (Fed. Cir. 1994). We reverse the ALJ’s finding that the claims in issue of the ’544 patent are invalid due to obviousness.

During the prosecution of the ’544 patent, the PTO examiner initially rejected the application on the grounds that the claimed invention was obvious in light of Sereboff, which discloses a wrist rest, and Lindlof, which discloses solid stable elastomeric block polymer gels. RX-2. Nonetheless, the examiner eventually allowed the claims. The ’544 patent was not granted for more than a year after the initial rejection and subsequent discussion regarding the obviousness of the claimed invention in light of Sereboff and Lindlof. In the interim, at least one other prior art reference (Chen) cited by the ALJ in several of his obviousness combinations was also brought to the attention of the examiner. The record indicates that at least two other references cited by the ALJ (Engelhardt and Aldrich) were also before the examiner during prosecution. RX-2 at 100. The various prior art references cited by the ALJ in support of his

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obviousness determination are not much different from those that were before the examiner. All involve some combination of a wrist rest and a broad range of gels.

The ALJ found that the invention of the '544 patent was no more than taking a cushioning material from one known cushioning application and placing it in another. He cited *In re Woodruff*, 919 F.2d 1575 (Fed. Cir. 1990), and *In re Kleinman*, 484 F.2d 1389 (C.C.P.A. 1973), for the proposition that such combinations are obvious. Yet neither *Woodruff* nor *Kleinman* is clearly apposite to the instant situation. In *Woodruff*, a process for inhibiting fungal growth on refrigerated fruit and vegetables was found to be obvious in light of an earlier patent for a process to control bacterial growth and to inhibit deterioration of vegetables. The process in *Woodruff* was essentially identical to that of the earlier patent. The court found that merely discovering and claiming a new benefit of an old process was not patentable. *Woodruff*, 919 F.2d at 1576, 1578. The patentee's stated purpose of the invention, to inhibit fungal growth, was not in fact a new purpose as claimed, since the original invention was intended to inhibit deterioration generally. *Id.* at 1578. *Woodruff*'s invention was essentially identical to the prior patented invention, save for a minor difference in one range, and *Woodruff* had failed to show that the one differing range was critical or provided unexpected results. *Id.* at 1579. Similarly, *Kleinman* involved the straightforward combination of known elements with no significant modifications. *Kleinman*, 484 F.2d at 1391 (Ct. C. P.A. 1973). In the instant case, the claimed invention is somewhat different from the prior art, to the extent that none of the prior art involved this combination of features. Additionally, the claimed invention specifies a range for the gels and describes specific properties for that range. A situation more analogous to the

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present case occurred in *Crown Operations Intern., Ltd. v. Solutia Inc.*, 289 F.3d 1367 (Fed. Cir. 2002), cited by the IA. In that case, the patentees obtained a patent (the '511 patent) for safety/solar control glass for automobiles, consisting of two layers of glass with a solar film between them. Solar control film is typically a substrate coated with metal or metallic elements and laminated with a safety film. Solar control films tend to wrinkle, and the patentee found the wrinkling could be masked by limiting to two percent or less the visible light reflection contribution of the solar film. The accused infringers argued that the '511 patent was anticipated by a prior art patent which disclosed the same structure, thickness, materials, and the same or similar ranges of coatings for the films. They asserted that the prior art patent thus rendered the '511 patent obvious, since the two percent limit was inherent. The Federal Circuit disagreed, finding that complainants had failed to show any combination or motivation in the prior art to reduce the reflectance contribution to two percent. *Id.* at 1370, 1377-78.

The ALJ does not cite in his ID explicit statements in the prior art references demonstrating a teaching, motivation, or suggestion to combine the references in the way that they are combined in the '544 patent. The fact that the elements in a claimed invention were previously known does not automatically render a patent invalid as obvious, and the existence of a range of prior art references does not diminish the requirement for actual evidence of a motivation to combine the references. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). "Determination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention." *Crown Operations*, 289 F.3d at 1376. *Ecolochem, Inc. v. Southern California Edison Co.*, 227 F.3d

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1361, 1371-72 (Fed. Cir. 2000) (holding that obviousness may not be shown by using “the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability”), *cert. denied*, 532 U.S. 974 (2001).

Although the ten different combinations of prior art references certainly show that wrist rests and block polymer gels existed prior to the conception of the ’544 patent, the test for obviousness is not whether elements of the invention existed in the prior art, but whether it would have been obvious to combine them as the inventors did. “There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor.” *Crown Operations*, 289 F.3d at 1376. None of the ten combinations of prior art references relied on by the ALJ contain any suggestion to combine those references so as to select a gel having a specified range of physical properties for use in a wrist rest. In this case, the cited prior art references teach only that gels may be useful in cushioning. The Nwoko patent, for example, recommends the use of “a gel of any type well-known in the elastomer fabrication art” for cushioning (RX-44, col. 4:63-5:7), while the Hargreaves patent merely suggests use of a “self-adhesive, compliant gel.” (RX-50, col. 19:45-46). Nowhere in the record is there any suggestion that anyone before the inventors of the ’544 patent tried to discover what types of gels would be most suitable for use in a wrist rest or that it would have been obvious which gels were suitable. In the absence of clear and convincing evidence of any prior art on the types of gels which have a specified range of physical properties for use in a wrist rest, we determine that the claims at issue

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of the '544 patent are not invalid as obvious.

Best Mode

The first paragraph of 35 U.S.C. §112 requires the inventor to set forth the “best mode” contemplated by the inventor of carrying out his invention. 35 U.S.C. § 112, ¶ 1. Whether an inventor has complied with this requirement is a question of fact. *Northern Telecom*, 215 F.3d at 1286. The best mode analysis has two components. The first question is whether, at the time of filing, the inventor knew of a best mode of practicing the claimed invention that he considered to be better than any other mode. This part of the inquiry is wholly subjective. *Id.* If an inventor did in fact contemplate a preferred mode, the second part of the analysis compares what the inventor disclosed with what the inventor knew, *i.e.*, whether the disclosure is adequate to allow one skilled in the art to practice the best mode. This part of the inquiry is objective. *Id.*

The best mode requirement only applies to the invention that is described in the claims. *Zygo Corp. v. Wyko Corp.*, 79 F.3d 1563, 1567 (Fed. Cir. 1996). An inventor is not required to disclose the best mode for obtaining unclaimed subject matter unless the subject matter is novel and essential for carrying out the best mode of the invention. *Eli Lilly & Co. v. Barr Labs, Inc.*, 251 F.3d 955, 963 (Fed. Cir. 2001). Furthermore, the best mode requirement does not apply to routine details or production details that do not concern the quality or nature of the invention. *Eli Lilly*, 251 F.3d at 963. “What is within the skill of the art need not be disclosed to satisfy the best mode requirement as long as that mode is described.” *Id.* at 966.

The ALJ found that the patentees violated the “best mode” requirement in two ways: (1) by not disclosing that they used Superla 31 oil rather than Nujol® oil to create their test gels, and

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(2) by not disclosing that they had heated the gels to between 150° and 170°C, rather than the “approximately 149°C” disclosed in the specification. We find that the ’544 patent is not invalid due to a failure to disclose the best method of practicing the claimed invention.

The record is lacking evidence to suggest that the use of Superla mineral oil is in fact a superior mode of practicing the invention. There is no evidence of any subjective knowledge on the part of the inventor that there was in fact a superior mode of practicing the invention. “A holding of invalidity for failure to disclose the best mode requires clear and convincing evidence that the inventor both knew of and concealed a better way of carrying out the claimed invention than that set forth in the specification.” *Transco Prods. Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 560 (Fed. Cir. 1994). The testimony of inventor Wolf indicates that, if he did in fact use Superla rather than Nujol®, he did not think it made any difference to the invention. Wolf Tr. 113, 177. Other evidence in the record indicates that Nujol® and Superla are considered equivalents. Thomas Tr. 368; Japuntich Tr. 231, 267-68. As the testimony of Thomas indicates, gels made by complainants with Superla meet the flexibility and compressibility requirements of claim 1, as interpreted by complainants. Thomas Tr. 408.

Similar evidentiary shortcomings exist concerning the failure to disclose the precise heating method used by the inventors. The ALJ found that inventor Wolf’s notebooks indicate that he had a “specific understanding” that the block polymer would dissolve better in mineral oil at between 150 to 160 degrees. ID at 100. However, there is no evidence that mixing the oil and polymer at between 150 to 160 degrees is superior to the temperature disclosed in claim 1, “approximately 149” degrees.

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In addition to the best mode violation found by the ALJ, respondents raise three additional ways in which the patentees allegedly violated the best mode requirement: (1) by not disclosing the patentees' use of antioxidants or a nitrogen blanket in creating their test gels; (2) by not disclosing the use of a "melt-blown" polyurethane for an outer covering; and (3) by not disclosing that others at 3M had told the patentees that Kraton 1111 might be superior to Kraton 1107 in creating a gel for use in the wrist rests. Respondents Br., pp. 100-02. However, the use of antioxidants, as respondents' expert acknowledged, is a routine detail which would be known to one of skill in the art (Hauser, Tr. at 853-54), and thus not part of the best mode. *Teleflex*, 299 F.3d at 1330-33 (holding that unclaimed matter is not part of the best mode). With respect to respondents' contention that the patentees should have disclosed the use of "melt blown polyurethane" as an outer cover, the portion of the record cited by respondents does not state or imply that the inventors believed that melt blown polyurethane was "better" than any other type of covering. FF180, *citing* RX-80C at 19856; Wolf, Tr. at 155-57. Finally, regarding the choice of Kraton 1111 to use in the gel formulation, the choice of Kraton 1111 does not deal with a claimed feature of the invention, *i.e.*, the flexibility and compressibility range of *any* stable elastomeric block polymer gel.

In light of these evidentiary shortcomings, we determine that the '544 patent is not invalid due to a failure to disclose the best method of practicing the claimed invention.

Conclusion

In conclusion, we determine that there is *no violation* of section 337 in this investigation based on a finding that the domestic products of complainants do not practice any claim of the

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'544 patent, and thus the domestic industry requirement of section 337 is not met in this investigation. We also determine that the accused wrist rests, except ACI's Jelly Mouse product, infringe the asserted claims of the '544 patent, and that the '544 patent is not invalid due to obviousness or failure to disclose the best mode of practicing the invention.

**CERTAIN GEL-FILLED WRIST RESTS AND
PRODUCTS CONTAINING SAME**

337-TA-456

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached COMMISSION OPINION, was served upon the following parties, via first class mail and air mail where necessary on January 23, 2003.



Marilyn R. Abbott, Secretary
U.S. International Trade Commission
500 E Street, SW - Room 112
Washington, DC 20436

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UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, DC 20436

In the Matter of)
)
CERTAIN GEL-FILLED WRIST RESTS AND)
PRODUCTS CONTAINING SAME)
)

Inv. No. 337-TA-456

02 SEP 19 09:26

RECEIVED
OFFICE OF THE SECRETARY
U.S. INTERNATIONAL TRADE COMMISSION

NOTICE OF COMMISSION DECISION TO REVIEW PORTIONS OF AN INITIAL
DETERMINATION FINDING NO VIOLATION OF SECTION 337 OF
THE TARIFF ACT OF 1930

AGENCY: U.S. International Trade Commission

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review certain portions of a final initial determination (ID) of the presiding administrative law judge (ALJ) finding no violation of section 337 of the Tariff Act of 1930, as amended, in the above-captioned investigation.

FOR FURTHER INFORMATION CONTACT: Mary Elizabeth Jones, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E St. S.W., Washington, DC 20436, telephone (202) 205-3106. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal at (202) 205-1810. General information concerning the Commission may also be obtained by accessing its Internet server (<http://www.usitc.gov>). Copies of the public version of the ALJ's ID and all other nonconfidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E St. S.W., Washington, DC 20436, telephone (202) 205-2000.

SUPPLEMENTARY INFORMATION: The Commission ordered the institution of this investigation on May 17, 2001, based on a complaint filed on behalf of 3M Innovative Properties Company and Minnesota Mining & Manufacturing Company (now called 3M Company), both of St. Paul, Minnesota (collectively "complainants"). 66 Fed. Reg. 27535 (May 17, 2001). The complaint alleged violations of section 337 in the importation, sale for importation, and sale within the United States after importation of certain gel-filled wrist rests by reason of infringement of claims 1, 3, 6, 7, or 8 of U.S. Letters Patent 5,713,544 ("the '544 patent"). The complaint named eight respondents: Velo Enterprise Co., Taiwan; Aidma Enterprise Co. Ltd., Taiwan; Good Raise Chemical Industry Co., Ltd., Taiwan; ACCO Brands, Inc., Lincolnshire, Illinois; Curtis Computer Products Inc., Provo, Utah; Alsop, Inc., Bellingham, Washington; American Covers Inc., Draper, Utah; and Gemini Industries, Inc., Clifton, New Jersey. *Id.* The complaint and notice of investigation were later amended to add Crown Vast Development Ltd., Taiwan, and Hornleon Company, Ltd., Taiwan, as respondents.

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On January 7, 2002, complainants and respondents filed their "Stipulation Concerning Domestic Industry," stipulating and agreeing to certain facts relating to the establishment of the economic prong of the domestic industry. An evidentiary hearing was held from January 14, 2002, through January 18, 2002. On October 22, 2001, the ALJ issued an ID (ALJ Order No. 6) granting complainants' unopposed motion to terminate the investigation with respect to Gemini Industries, Inc., on the basis of a consent order. On January 9, 2002, the ALJ issued an ID (ALJ Order No. 12) finding respondents Good Raise and Aidma in default. On May 15, 2002, the ALJ issued an ID (ALJ Order No. 15) granting complainants' unopposed motion to terminate the investigation with respect to Curtis Computer Products Inc., on the basis of a consent order. On May 21, 2002, the ALJ issued an ID (ALJ Order No. 16) granting complainants' unopposed motion to terminate the investigation with respect to Allsop, Inc., on the basis of a consent order. None of these IDs were reviewed by the Commission.

On July 24, 2002, the ALJ issued his final ID, concluding that there was no violation of section 337, based on the following findings: (a) complainants have not established that any accused product infringes any asserted claim of the '544 patent; (b) invalidity of the '544 patent due to obviousness has been established by clear and convincing evidence; (c) invalidity of the '544 patent due to a failure to disclose the best mode has been established by clear and convincing evidence; and (d) it has been established that complainants do not practice the '544 patent and that therefore the domestic industry requirement of section 337 is not met. The ALJ also found that: (a) respondents have failed to establish by clear and convincing evidence that the '544 patent is invalid due to anticipation; (b) invalidity of the '544 patent due to the lack of a written description or the lack of enablement has not been established by clear and convincing evidence; (c) invalidity of the '544 patent due to indefiniteness has not been established by clear and convincing evidence; (d) invalidity of the '544 patent due to improper joinder or non-joinder of inventors has not been established by clear and convincing evidence; (e) unenforceability of the '544 patent due to inequitable conduct before the U.S. Patent and Trademark Office has not been established by clear and convincing evidence; and (f) it has not been established by clear and convincing evidence that complainants are barred from asserting the '544 patent due to equitable estoppel. ID at 217-18.

On August 5, 2002, respondents ACCO, American Covers, Inc., Crown Vast Development, Ltd., and Velo Enterprise Co., Ltd. (hereinafter "respondents") filed a petition for review. On August 7, 2002, the Commission investigative attorney ("IA") filed a petition for review. On August 8, 2002, complainants filed a petition for review. On August 12, 2002, complainants filed a response to petitions for review. On August 15, 2002, respondents and the IA filed responses to petitions for review.

Having examined the record in this investigation, including the ID, the petitions for review, and the responses thereto, the Commission has determined to review:

- (1) the ID's construction of the asserted claims of the '544 patent;
- (2) the ID's infringement conclusions;
- (3) the ID's validity conclusions with regard to obviousness and failure to disclose best mode of practice; and
- (4) the ID's conclusion with respect to the technical prong of the domestic industry requirement.

The Commission has determined not to review the remainder of the ID.

The Commission determined to deny complainants' request for oral argument.

On review, the Commission requests briefing based on the evidentiary record on all issues under review and is particularly interested in receiving answers to the following questions, with all answers cited to the evidentiary record:

1. Assuming that the ALJ correctly construed the claim 1 term “pad,” is it an error to conclude that infringement of the ’544 patent can only be proven by testing the pads as they are intended to be used, *i.e.*, with any outer coverings still on the gel? If infringement can be proven by testing the pads without any coverings, please identify the relevant record evidence supporting a finding of infringement or non-infringement.
2. Assuming that the ALJ correctly construed the claim 1 term “stable elastomeric block polymer gel,” is it an error to find that col. 1:55-col. 2:9 are not limitations on claim 1, but col. 2:10-65 do represent limitations on claim 1?
3. Assuming that the ALJ correctly construed the claim 1 term “stable elastomeric block polymer gel” is it an error to require that, in order to satisfy the technical prong of the domestic industry requirement, domestically-made products be made without naphthenic oils?

In connection with the final disposition of this investigation, the Commission may issue (1) an order that could result in the exclusion of the subject articles from entry into the United States, and/or (2) cease and desist orders that could result in respondents being required to cease and desist from engaging in unfair acts in the importation of such articles. Accordingly, the Commission is interested in receiving written submissions that address the form of remedy, if any, that should be ordered. If a party seeks exclusion of an article from entry into the United States for purposes other than entry for consumption, the party should so indicate and provide information establishing that activities involving other types of entry that either are adversely affecting it or are likely to do so. For background information, see the Commission Opinion, *In the Matter of Certain Devices for Connecting Computers via Telephone Lines*, Inv. No. 337-TA-360.

If the Commission contemplates some form of remedy, it must consider the effects of that remedy upon the public interest. The factors the Commission will consider include the effect that an exclusion order and/or cease and desist order would have on (1) the public health and welfare, (2) competitive conditions in the U.S. economy, (3) U.S. production of articles that are like or directly competitive with those that are subject to investigation, and (4) U.S. consumers. The Commission is therefore interested in receiving written submissions that address the aforementioned public interest factors in the context of this investigation.

If the Commission orders some form of remedy, the President has 60 days to approve or disapprove the Commission’s action. During this period, the subject articles would be entitled to enter the United States under a bond, in an amount to be determined by the Commission and prescribed by the Secretary of the Treasury. The Commission is therefore interested in receiving submissions concerning the amount of the bond that should be imposed.

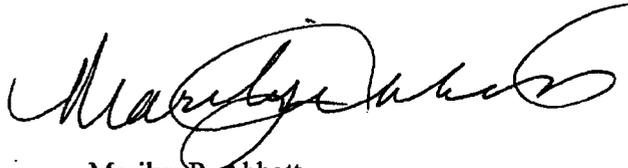
WRITTEN SUBMISSIONS: The parties to the investigation are requested to file written submissions on the issues under review. The submissions should be concise and thoroughly referenced to the record in this investigation, including references to exhibits and testimony. Additionally, the parties to the investigation, interested government agencies, and any other interested persons are encouraged to file written submissions on the issues of remedy, the public interest, and bonding. Such submissions should

address the ALJ's July 31, 2002, recommended determination on remedy and bonding. Complainant and the Commission investigative attorney are also requested to submit proposed remedial orders for the Commission's consideration. The written submissions and proposed remedial orders must be filed no later than the close of business on September 23, 2002, Reply submissions must be filed no later than the close of business on September 30, 2002. No further submissions will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file with the Office of the Secretary the original and 14 true copies thereof on or before the deadlines stated above. Any person desiring to submit a document (or portion thereof) to the Commission in confidence must request confidential treatment unless the information has already been granted such treatment during the proceedings. All such requests should be directed to the Secretary of the Commission and must include a full statement of the reasons why the Commission should grant such treatment. *See* 19 C.F.R. § 201.6. Documents for which confidential treatment is granted by the Commission will be treated accordingly. All nonconfidential written submissions will be available for public inspection at the Office of the Secretary.

This action is taken under the authority of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), and in sections 210.42-45 of the Commission's Rules of Practice and Procedure (19 C.F.R. §§ 210.42-45)

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Marilyn R. Abbott', written in a cursive style.

Marilyn R. Abbott
Secretary to the Commission

Issued: September 9, 2002

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached NOTICE TO REVIEW PORTIONS OF AN INITIAL DETERMINATION, was served upon the following parties, via first class mail and air mail where necessary on September 10, 2002.



Marilyn R. Abbott, Secretary
U.S. International Trade Commission
500 E Street, SW - Room 112
Washington, DC 20436

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MINNESOTA MINING AND
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LTD., AND AMERICAN COVERS:**

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PRODUCTS CONTAINING SAME**

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PUBLIC CERTIFICATE OF SERVICE

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