Pagination
* BL

Majority Opinion >

UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF NEW YORK

THE TOPPS COMPANY, INC., Plaintiff, -against- KOKO'S CONFECTIONERY & NOVELTY, a division of A & A GLOBAL INDUSTRIES, INC., Defendant.

16 Civ. 5954 (GBD)

June 12, 2019, Filed June 12, 2019, Decided

For The Topps Company, Inc., Plaintiff: Steven J. Rizzi, King & Spalding LLP, New York NY USA.

For Koko's Confectionery & Novelty, a Division of A & A Global Industries, Inc., Defendant: David H. Levitt, LEAD ATTORNEY, Hinshaw & Culbertson LLP (IL), Chicago IL USA; Brent Matthew Reitter, Hinshaw & Culbertson LLP (NYC), New York NY USA; Kyle Matthew Medley, Hinshaw & Culbertson LLP, New York NY USA; Roger M. Masson, PRO HAC VICE, Hinshaw & Culbertson LLP (IL), Chicago IL USA.

GEORGE B. DANIELS, United States District Judge.

GEORGE B. DANIELS

MEMORANDUM DECISION AND ORDER

GEORGE B. DANIELS, United States District Judge:

Before this Court are competing requests for claim construction of U.S. Patent No. 6 , 660 ,316 by Plaintiff The Topps Company, Inc. ("Topps") and Defendant Koko's Confectionery & Novelty Inc. ("Koko's"). The disputed claim terms are to be construed as follows:

Claim 1, Part 1: "a housing defining an upper chamber and a lower chamber" is construed to mean *"a housing with two compartments, where one compartment is above the other."*

Claim 1, Part 2: "a candy holder for supporting a piece of candy and including a handle at its lower end, said candy being receivable within said lower chamber to close the chamber" is construed to mean *"a structure with a handle at its bottom that holds apiece of candy*, said candy being receivable within the lower chamber to close the chamber."

Claim 3: "a nipple extending through the upper end of said housing" is construed to mean *"a nipple extending through the top of the housing."*

I. PROCEDURAL HISTORY

Topps initiated this action for patent and trade dress infringement against Koko's on July 26, 2016. (*See* Compl., ECF No. 1.) On November 22, 2016, Koko's moved to dismiss Topps's First Amended Complaint. (Mot. to Dismiss the Am. Compl., ECF No. 18.) This Court granted Koko's first motion to dismiss with leave to amend the complaint, which Topps did on January 17, 2017. (*See* Order, ECF No. 28; Second Am. Compl. ("SAC"), ECF No. 29.) On February 10, 2017, Koko's filed a second motion to dismiss, which was denied following oral argument on June 7, 2017. (*See* ECF No. 44.) Pursuant to *Local Patent Rule 11* , the parties filed Claim Construction Statements on April 16, 2018. (*See* Pl.'s Submission of Claim Terms Chart Pursuant to *Loc. Pat. R. 11* ("Pl. Claim Terms"), ECF No. 83; Def.'s Submission of Claim Terms Chart Pursuant to *Lo. Pat. R. 11* ("Def. Claim Terms"), ECF No. 84, at 3.)

The parties filed competing claim construction briefs between April 16, 2018 and July 6, 2018. (*See* Topps' Opening Claim Const. Br. ("Pl. Opening Br."), ECF No. 102; Koko's Responsive Claim Const. Br. ("Def. Response Br."), ECF No. 126; Topps' Reply Claim Const. Br. ("Pl. Reply"), ECF No. 132; Topps' Not. of Supp. Ev. in Supp. of its Prop. Claim Const. ("Pl. Supp."), ECF No. 151.) This Court held a *Markman* hearing on July 10, 2018 to determine the proper construction of the disputed terms in the '316 Patent .

II. FACTUAL BACKGROUND

On December 9, 2003, U.S. Patent Application No. 10/027,521 matured into the '316 Patent , and it was

assigned **[*2]** to Topps by Daniel Hart and Gary Weiss. U.S. Patent No. 6 , 660 ,316 (the "316 Patent") (filed Dec. 20, 2001). The '316 Patent 's Abstract provides a brief description of the product as follows:

> [A] candy product according to the invention comprises a housing having [s]eparate chambers for holding a piece of hard candy and a compressible juice bottle containing a flavored liquid. The hard candy is secured to a candy holder which can be placed in the lower chamber of the housing and removed for consumption. The juice bottle is made of a pliable material which is accessible through openings in the housing so that an external squeezing force can be applied to the bottle to dispense liquid droplets onto the candy.

Id . at [57]. The '316 Patent makes six claims, but the parties only ask this Court to construe two parts of Claim 1, and all of Claim 3. The contested language is as follows:

Claim 1, Part 1: "a housing defining an upper chamber and a lower chamber."

Claim 1, Part 2: "a candy holder for supporting a piece of candy and including a handle at its lower end."

Claim 3: "a nipple extending through the upper end of said housing."

III. LEGAL STANDARD

The Federal Circuit's decisions in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (*en banc*), and *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (*en banc*) substantially guide this Court's claim construction analysis. Claim construction is an issue of law properly decided by district courts. *See Markman*, 52 F.3d at 970-71 . "It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude." *Phillips*, 415 F.3d at 1312 (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111 , 1115 (Fed. Cir. 2004)). "[I]n all aspects of claim construction, 'the name of the game is the claim." *Apple Inc. v. Motorola, Inc.*, 757 F.3d 1286 , 1298 (Fed. Cir. 2014) (quoting *In re Hiniker Co.*, 150 F.3d 1362 , 1369 (Fed. Cir. 1998)).

This Court relies on intrinsic evidence to determine the meaning of a patent's claims. *See Phillips*, 415 F.3d at 1313 ; *C.R. Bard, Inc. v. U.S. Surgical Corp.*, 388 F.3d 858 , 861 (Fed. Cir. 2004) (collecting cases). Intrinsic evidence includes the claims themselves, the specification, and the prosecution history. *See Phillips*, 415 F.3d at 1314 ; *C.R. Bard, Inc.*, 388 F.3d at 861 . Generally, each claim term is construed according to its "ordinary and customary meaning," which "is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application." *Phillips*, 415 F.3d at 1312-13 ; *see also Alloc, Inc. v. Int'l Trade Comm'n*, 342 F.3d 1361 , 1368 (Fed. Cir. 2003). "There is a heavy presumption that claim terms carry their accustomed meaning in the relevant community at the relevant time." *Azure Networks, LLC v. CSR PLC*, 771 F.3d 1336 , 1347 (Fed. Cir. 2014), *vacated on other grounds by CRS PLC v. Azure Networks, LLC*, No. 14-976, 135 S. Ct. 1846 (Mem) (2015).

There are "only two exceptions to [the] general rule" that claim terms are construed according to their ordinary and customary meaning: "(1) when a patentee sets out a definition and acts as his own lexicographer, or (2) when the patentee disavows the full scope of the claim term either in the specification or during prosecution." *Golden Bridge Tech., Inc. v. Apple Inc.*, 758 F.3d 1362 , 1365 (Fed. Cir. 2014) (quoting *Thorner v. Sony Computer Ent. Am. LLC*, 669 F.3d 1362 , 1365 (Fed. Cir. 2012)); *see also GE Lighting* ***[*3]*** *Solutions, LLC v. AgiLight, Inc.*, 750 F.3d 1304 , 1309 (Fed. Cir. 2014) ("[T]he specification and prosecution history only compel departure from the plain meaning in two instances: lexicography and disavowal."). The standards for finding lexicography or disavowal are "exacting." *GE Lighting Solutions*, 750 F.3d at 1309 .

As the Federal Circuit in *Phillips* noted, courts are wary of adding limitations by way of specification or prosecution history. *See* 415 F.3d at 1312 . But to clarify disputed terms, the specification is usually "dispositive; it is the single best guide to the meaning of a disputed term." *Phillips*, 415 F.3d at 1315 . "The close kinship between the written description and the claims is enforced by the statutory requirement that the specification describe the claimed invention in 'full, clear, concise, and exact terms.'" *Id* . (quoting *35 U.S.C. § 112(a)*). Moreover, "[b]ecause claim terms are normally used consistently throughout the patent,

the usage of a term in one claim can often illuminate the meaning of the same term in other claims." *Phillips*, 415 F.3d at 1314 .

Prosecution history can also limit a claim. As part of the intrinsic evidence, the prosecution history may "inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be." *Phillips*, 415 F.3d at 1317 . However, the prosecution history "often lacks the clarity of the specification and thus is less useful for claim construction purposes." *Id* . "[C]lear reliance on the preamble during prosecution to distinguish the claimed invention from the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention." *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801 , 808 (Fed. Cir. 2009).

The Federal Circuit did not set out an order of authorities for a district court to follow when it construes disputed claim language. *See* id. at 1323-25 . Instead, *Phillips* held that a court must give appropriate weight to the intrinsic sources offered by the parties to support a proposed claim construction, mindful that, as a general rule, the claims themselves delineate the scope of the patent grant. *See* id. at 1312 .

IV. THE CONSTRUCTION OF THE DISPUTED TERMS

1. Claim 1, Part 1: "housing defining an upper chamber and a lower chamber"

The parties interpret this language very differently. Topps proposes the construction: "housing with two compartments, where one compartment is above the other *in at least one orientation of the housing."* (Pl. Claim Terms at 3 (emphasis added).) Koko's proposes the construction: "[t]he housing has two compartments with one compartment (the lower) being physically situated below the other compartment (the upper)." (Def. Claim Terms at 3.)

Critically, the parties' offer conflicting interpretations of the spatial positioning meant by the words "upper" and "lower" in Claim 1. Although Topps acknowledges that one of the compartments is above the other in at least one orientation, it opposes an interpretation whereby the "upper" compartments is always understood to be **[*4]** above the "lower" compartment. (*See* Def. Claim Terms at 3.) Koko's argues that these terms should be interpreted to mean that one compartment (the "upper") is *always* physically situated above the other (the "lower") and that Topps' interpretation is inconsistent with the '316 Patent 's prosecution history. (*See* Def. Response Br. at 14.) Because the parties contest the claim language itself, this Court turns to the patent specification and the prosecution history to interpret this claim.

The '316 Patent frequently uses directional language to specify the orientation of the product's housing compartments.1 In the Abstract, the housing "defines upper and lower [compartments.]" '316 Patent , at [57]. The Abstract also states that "the housing is *inverted"* when using the product, which implies that the housing starts in one position, and then the user turns it over to consume the candy. *Id* . (emphasis added). Furthermore, other portions of the '316 Patent explain that "in use. . . the housing is *turned"* and the liquid is *"dropped onto* the candy." *Id* . at col. 2, 1. 43-46 (emphasis added). Accordingly, the language of the '316 Patent underlines that the definitional orientation of the housing compartments does not change when they are rotated in use, because the housing still "defines upper and lower chambers." *Id* . at [57].

In the "Description of Preferred Embodiments," the '316 Patent states that the *"bottom* of shell 10 is open and receives a candy holder[.]" *Id* . at col. 1, 1. 63 (emphasis added). Shell 10 "forms about three quarters of the housing and includes an internal shelf 14." *Id* . at col. 1, 1. 60-61. The preferred embodiment goes on to describe "a juice bottle" which is "mounted within the housing *above* shelf 14." *Id* . at col. 2, 1. 9-10 (emphasis added). While it may be true that a user can disconnect the housing from the candy holder and rotate the housing, the preferred embodiment of the claim describes a fixed position for the candy holder *below* the fixed shelf within the housing. By separating the compartments, shelf 14 also "provides a *lower* compartment" which is described as the *"bottom* of shell 10[.]" *Id* . col. 1, 1. 62-63 (emphasis added). It is obvious that the '316 Patent does not define "an *upper* chamber and a *lower* chamber" arbitrarily. Instead, each chamber has specific functional qualities that depend on its position—the lower chamber has the "bottom" opening for the candy holder and the upper

chamber has the mounted juice bottle *"above* shelf 14." *Id* . col. 1, 1. 63, col. 2, 1. 11. Therefore, in light of the patent specification, "upper" and "lower" do not lose their spatial position as the housing is rotated.

Finally, as discussed at the *Markman* Hearing, Topps' proposed interpretation of the word "upper" gives it different meanings in Claims 1 and 3. (Markman Hearing Tr., July 10, 2018 ("Markman Hearing"), 17:7-10, 20:5-6.) Topps' proposed construction of "upper" in Claim 1 would allow flexible orientation between "upper" and "lower" chambers—essentially meaning "opposite"—while in Claim 3, the same word "upper" would, by its plain and ordinary meaning, relate to the "top" of the housing. As the Federal Circuit in *Phillips* noted, "[b]ecause claim terms are normally **[*5]** used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims." *Phillips*, 415 F.3d at 1314 . Following Topps' proposed interpretation would contravene *Phillips* by giving the word "upper" different meanings in Claims 1 and 3. Accordingly, this Court will construe the word "upper" consistently to mean *"top"* throughout the '316 Patent .2

After reviewing the parties' arguments and the intrinsic evidence, this Court construes "a housing defining an upper chamber and a lower chamber" to mean *"a housing with two compartments, where one compartment is above the other."*

2. Claim 1, Part 2: "candy holder for supporting a piece of candy and including a handle at its lower end *said candy being receivable within said lower chamber to close the chamber"*

As an initial matter, the parties disagree on which language of Claim 1, Part 2 that this Court should construe. Topps only includes the first clause: "a candy holder for supporting a piece of candy and including a handle at its lower end." (Pl. Opening Br. at 18-19.) Koko's adds the clause that follows: "a candy holder for supporting a piece of candy and including a handle at its lower end, *said candy being receivable within said lower chamber to close the chamber."* (Def. Claim Terms at 3 (emphasis added).) Accordingly, Topps proposes the construction: "structure with a handle at one end that holds up a piece of hard candy," while Koko's proposes the construction: "[s]tructure for holding in position a piece of candy and having a handle at its lower end, the structure being receivable within the compartment (the lower) that is physically situated below the other compartment (the upper)." (Pl. Claim Terms at 3; Def. Claim Terms at 3.)

Again, the parties principally disagree on whether the candy holder's spatial position is fixed. On the one hand, Topps' construction reduces the meaning of the term "lower end" to "an end," which means that the candy holder has no specific position. (Pl. Claim Terms at 3; Pl. Opening Br. at 18-19.) On the other hand, Koko's construction specifies that the candy holder is below the upper compartment where a juice bottle is mounted, which means that the candy holder must be positioned at the bottom of the housing. (Def. Claim Terms at 3; '316 Patent col. 2, 1. 9.)

Topps relies on hypothetical rewrites of the '316 Patent to argue that it could have "opted to claim the invention far more narrowly." (Pl. Opening Br. at 20.) But even Topps' proposed construction says that the candy holder *"holds up* a piece of hard candy." (Pl. Claim Terms at 3 (emphasis added).) Topps attempts to minimize this language as simply stemming from the dictionary definition of the word "support."3 (Pl. Opening Br. at 18 n.4.) Even if that is true, it doesn't change the fact that the plain meaning of Topps' proposed construction is that the candy holder is *below* the candy, holding it *up*. Furthermore, the specification of the '316 Patent supports this construction. For example, it describes the candy holder as "[t]he *bottom* of shell [10] is open and receives a candy holder comprising a handle [20] and two *upstanding* prongs [22]."'316 Patent col. **[*6]** 1, 1. 62-64 (emphasis added). Similarly, it specifies that "[a] juice bottle is mounted within the housing *above* shelf [14]. An *upstanding* nipple [32] is friction fit into the neck of bottle." *Id* . col. 2, 1. 9-11.

After reviewing the parties' arguments, as well as the intrinsic and extrinsic evidence, this Court construes "a candy holder for supporting a piece of candy and including a handle at its lower end" to mean *"a structure with a handle at its bottom that holds a piece of candy*, ..."

3. Mr. Wadalawala's Expert Testimony Is Not Controlling

Topps offers the expert testimony of Mr. Matthew Wadalawala that the spatial positioning of the patent product is not fixed, while Koko's argues that his expert

testimony is not in line with the intrinsic evidence. (Pl. Opening Br. at 14; Def. Response Br. at 19.) This Court may consider the expert testimony of Mr. Wadalawala on the claim construction issues of this case because he is a "person of ordinary skill in the art" ("POSA"). *See Phillips*, 415 F.3d at 1312-13 . However, the Federal Circuit in *Phillips* rejected any approach to claim construction that sacrifices the intrinsic evidence in favor of extrinsic evidence, including expert testimony. Id. at 1319-24 . Therefore, Mr. Wadalawala's expert testimony may be relevant as part of claim construction, but it does not alter this Court's determination based on the intrinsic evidence. *Id* .

4. Claim 3: "a nipple extending through the upper end of said housing"

Koko's construes the claim "a nipple extending through the upper end of said housing" as "a nipple extending through the *top* of the housing." (Def. Claim Terms at 3.) In other words, Koko's replaces the words "upper end" with the word "top." Topps argues that this construction is inappropriate, and instead purports to give this claim its "plain and ordinary meaning." (Pl. Claim Terms at 3.)

First, Topps argues that the two claims of the '316 Patent are distinct from one another and must be construed separately. (*See* Markman Hearing, 17:7-10, 20:5-6.) This is not so. In fact, this Court must read both clauses together because the construction of Claim 1's language should be consistent, under the law, with its construction of Claim 3. *Phillips*, 415 F.3d at 1314 ("Because claim terms are normally used consistently throughout the patent, the usage of a term in one claim can often illuminate the meaning of the same term in other claims."). Moreover, Claim 3 includes the language "[a] packaged candy product according to Claim 2," and Claim 2 includes the language "[a] packaged candy product according to Claim 1." '316 Patent col. 3 l. 6, 9. These references tie the language of Claim 1 to the language of Claim 3. Therefore, when this Court construes the "upper chamber" language in Claim 1 to refer to the chamber "above," that construction is relevant to interpreting the meaning of "upper" in Claim 3.

Second, Topps cites to *Bissell Homecare, Inc. v. Dyson, Inc.* to support a broader interpretation of "upper." No. 08 Civ. 724 (RJJ), [2010 BL 130419], 2010 WL 2384620 , at *6 (W.D. Mich. June 10, 2010). However, Topps ignores that the language "upper portion" at issue in *Bissell* is distinguishable from the "upper end" language here. Unlike in *Bissell*, where the court found "nothing in the patent language **[*7]** suggest[ed] or compel[led] a more limited construction, " Claim 3 here specifies that the nipple "extend[s] through the upper end of said housing," meaning that there must be an upper-most part of the housing for the nipple to pass through. *See Amphenol Corp. v. Maxconn Inc.*, No. 97 Civ. 20603 (SW), [52 U.S.P.Q.2D 1178], 1998 WL 1145597 , at *5 (N.D. Cal. Nov. 20, 1998) (construing "extending through" language to mean that the relevant part went "out through the housing"); *see also K2M, Inc. v. OrthoPediatrics Corp.*, No. 17 Civ. 61 (GMS), [2018 BL 190775], 2018 WL 2426660 , at *1 (D. Del. May 30, 2018) (rejecting the use of the dictionary definition of "through" and construing "through" to mean that one part of the patented product passed through an opening in another part). Additionally, the '316 Patent 's Description of Preferred Embodiments uses the language "upper portion" to describe where the juice bottle is positioned within the housing: *"above* shelf 14."'316 Patent col. 2, 1. 27, col. 2, 1. 9-10 (emphasis added). Taken together, this "additional intrinsic evidence" supports a narrower reading of the term "upper end" to necessarily mean "the top." *Bissell Homecare, Inc.*, [2010 BL 130419], 2010 WL 2384620 at *6.

Tthis Court construes "a nipple extending through the upper end of said housing" to mean *"a nipple extending through the top of the housing."*

V. CONCLUSION

The disputed claim terms are to be construed as follows:

Claim 1, Part 1: "a housing defining an upper chamber and a lower chamber" is construed to mean *"a housing with two compartments, where one compartment is above the other."*

Claim 1, Part 2: "a candy holder for supporting a piece of candy and including a handle at its lower end, said candy being receivable within said lower chamber to close the chamber" is construed to mean *"a structure with a handle at its bottom that holds apiece of candy*, said candy being receivable within the lower chamber

to close the chamber."

Claim 3: "a nipple extending through the upper end of said housing" is construed to mean *"a nipple extending through the top of the housing."*

Dated: June 12, 2019

New York, New York

SO ORDERED.

/s/ George B. Daniels

GEORGE B. DANIELS

United States District Judge

---

fn 1

The parties use the word "compartment" in their claim construction proposals to refer to the "chamber" in the '316 Patent . (Pl. Claim Terms at 3; Def. Claim Terms at 3.) For clarity, this Court will use the word "compartment" consistently throughout this decision.

fn 2

The '316 Patent 's abstract specifically states that "[t]he bottle includes a nipple which extends through the *top* of the housing." 316 Patent , Abstract (emphasis added).

fn 3

This Court gives little weight to this dictionary definition argument because, under *Phillips*, dictionary definitions are extrinsic evidence that do not displace intrinsic evidence of a claim's meaning, including the language of the claim itself, the specification, and the prosecution history. *See Phillips*, 415 F.3d at 1314 , 1319-24 .

General Information

Judge(s)	GEORGE B. DANIELS
Related Docket(s)	1:16-cv-05954 (S.D.N.Y.);
Topic(s)	Civil Procedure; Patent Law
Industries	Food & Beverage
Parties	THE TOPPS COMPANY, INC., Plaintiff, -against- KOKO'S CONFECTIONERY & NOVELTY, a division of A & A GLOBAL INDUSTRIES, INC., Defendant.
Court	United States District Court for the Southern District of New York

Notes

No Notepad Content Found

Topps Co. v. Koko's Confectionery & Novelty, No. 16 Civ. 5954 (GBD), 2019 BL 228722 (S.D.N.Y. June 12, 2019), Court Opinion

Direct History

1 **Topps Co. v. Koko's Confectionery & Novelty, No. 16 Civ. 5954 (GBD), 2019 BL 228722 (S.D.N.Y. June 12, 2019)**
order entered

2 **Nonparty Subpoenas Duces Tecum, Cahn & Samuels, LLP v. Koko's Confectionary & Novelty, No. 18-MC-468 (GBD)(KNF), 2019 BL 175848 (S.D.N.Y. May 15, 2019)**
motion granted

3 **The Topps Co. v. Koko's Confectionary & Novelty, No. 16 Civ. 5954 (GBD) (KNF), 2019 BL 43282 (S.D.N.Y. Feb. 07, 2019)**
objection denied

4 **Topps Co. v. Lapeyrouse, No. 18-4778 SECTION M (3), 2019 BL 16622, 2019 Us Dist Lexis 8411 (E.D. La. Jan. 17, 2019)**
order entered, motion to dismiss granted

5 **The Topps Co. v. Koko's Confectionary & Novelty, No. 16-CV-5954 (GBD)(KNF), 2018 BL 350695, 2018 WL 5817530 (S.D.N.Y. Sept. 26, 2018)**
reconsideration denied, order entered

6 **Cahn & Samuels, LLP v. The Topps Co., 327 F.R.D. 23 (D.D.C. 2018)**
case dismissed, case transferred

7 **The Topps Co. v. Koko's Confectionary & Novelty, No. 16-CV-5954 (GBD)(KNF), 2018 BL 334775, 2018 WL 4440502 (S.D.N.Y. Sept. 17, 2018)**
order entered, motion for discovery denied (in part), motion for discovery granted (in part)

Direct History Summary	
Caution	0
Negative	0
Total	0

Case Analysis Summary	
Positive	0
Distinguished	0
Caution	0
Superseded	0
Negative	0
Total	0

Case Analysis

No Treatments Found