

**PUBLIC VERSION**

UNITED STATES INTERNATIONAL TRADE COMMISSION  
Washington, D.C.

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In the Matter of	)	
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CERTAIN LENS-FITTED	)	Investigation No. 337-TA-406
FILM PACKAGES	)	Advisory Opinion Proceedings II
	)	
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Initial Advisory Opinion

This is the administrative law judge's initial advisory opinion, under Commission rule 210.79(a). The administrative law judge, after a review of the record developed, determines that the camera model M-201 sought to be imported into the United States by CS Industries, Inc. would not infringe claim 1 of U.S. Patent No. 4,954,857, claim 1 of U.S. Patent No. 4,972,649, claim 25 of U.S. Patent No. 5,381,200 or claim 1 of Re 34,168 and therefore, would not be covered by any general exclusion order or any cease and desist order.

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## ABBREVIATIONS

CPost	Fuji's initial post-hearing brief
CPX	Exhibit from previous proceedings
CRPost	Fuji's reply brief
CSI Post	CSI's initial post-hearing brief
CSI RPost	CSI's reply brief
CPXAP2	Fuji's physical exhibit
CXAP2	Fuji's exhibit
EID	Enforcement Initial Determination in Consolidated Enforcement and Advisory Opinion Proceedings which issued May 2, 2002
EID FF	Finding Of Fact of EID
FF	Finding Of Fact
ID	Initial Determination in original investigation which issued February 24, 1999
ID FF	Finding of Fact of ID
JX	Joint exhibit
RAP2	CSI's physical exhibit
SPost	Staff's initial post-hearing brief
SRPost	Staff's reply brief

## I. Procedural History

On September 3, 2003, the Commission issued a “Notice Of Commission Determination To Institute Advisory Opinion Proceedings And To Deny A Request For Institution Of Enforcement Proceedings.” The Commission, in the accompanying Order dated September 3, stated that pursuant to Commission rule 210.79(a), an advisory opinion proceeding is instituted to determine whether certain cameras (camera model M-201) sought to be imported into the United States by CS Industries, Inc. (CSI), which requested the advisory opinion, are covered by either the general exclusion order issued by the Commission on June 2, 1999, or the cease and desist order directed to CSI which was issued by the Commission on May 15, 2003.<sup>1</sup> In its Order, for the purposes of the advisory opinion proceeding so instituted, the Commission named as the parties CSI, Fuji and the staff. The Commission in its Order further certified to this administrative law judge CSI’s request for the advisory opinion for conducting the appropriate proceedings and for the issuance, as expeditiously as practicable from the date of publication of notice of the Order in the Federal Register, of an Initial Advisory Opinion (IAO). The Order stated that the administrative law judge may, in his discretion, conduct any proceedings he deems necessary, including taking evidence and ordering discovery.

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<sup>1</sup> On July 31, 2001, the Commission instituted formal enforcement and advisory opinion proceedings at the request of Fuji Photo Film Co., Ltd. (Fuji). 66 Fed. Reg. 40,721 (Aug. 3, 2001). CSI was named as a party respondent to the enforcement proceeding, and was also named as a party to the advisory opinion proceedings. 66 Fed. Reg. 40,721 (Aug. 3, 2001). At the conclusion of the consolidated proceedings, the Commission issued cease and desist orders against several respondents, including CSI, that were found to have violated the general exclusion order issued in the original investigation. 68 Fed. Reg. 28,254 (May 23, 2003).

The Commission, in its September 3, 2003 order, also stated that the IAO should be consistent with the Commission's findings in the underlying investigation and related proceedings and should also rule on the question of whether the camera model M-201 that CSI sought to be imported into the United States infringes claim 1 of U.S. Patent No. 4,954,857 (the '857 patent), claim 1 of U.S. Patent No. 4,972,649 (the '649 patent), claim 25 of U.S. Patent No. 5,381,200 (the '200 patent), or claim 1 of Re 34,168 (the '168 patent), and is, therefore, covered by either the general exclusion order, or the cease and desist order directed to CSI.

Order No. 110, which issued on September 26, 2003, set a procedural schedule which included hearing dates of November 24 and 25. Order No. 119, which issued on November 18, granted CSI's Motion No. 406-172 to exclude Fuji's expert Bellows from testifying regarding the '649 patent or the '168 patent. Order No. 122, which issued on November 21, denied CSI's Motion No. 406-175 to preclude Bellows' deposition testimony relating to the '857 patent.

On November 19, 2003, the administrative law judge received a letter from counsel for CSI which reported that all parties had reached a stipulation which eliminated the need for the hearing scheduled to start on November 24. The letter included a stipulation signed by counsel for CSI and Fuji, and which stipulation indicated approval by the staff. The administrative law judge, after receipt of the November 19 letter, initiated a telephone conference with all parties and ruled that, as a result of the stipulation, there would be no hearing.

On November 20, 2003, the administrative law judge received an unopposed motion for entry of the stipulation and alteration of the scheduling order.

Order No. 124, which issued on November 21, 2004, ruled on the admissibility of certain proffered exhibits, and further granted CSI's unopposed motion received on November 20, which

included the stipulation. The stipulation reads in pertinent part:

**It is hereby agreed to**, by and between Fuji and CSI, with the approval of OUII, with respect to two embodiments of a CSI camera, designated the “M201 camera”, of record in this proceeding only, as follows:

A. U.S. Patent No. 5,381,200 (the “200 patent”)

The parties stipulate that: (1) one prototype of the M201 camera has a completely flat shutter blade, without any rim of any shape, and (2) another prototype of the M201 camera has a shutter blade with a generally semi-circular rim.

B. U.S. Patent No. Re. 34,168 (the “168 patent”)

The parties stipulate that, in both prototypes: (1) the taking lens of the M201 camera extends into the space defined by the bulge surrounding the lens hole in the front cover, but the taking lens does not extend into the lens hole in the front cover; and (2) no part of the film transport mechanism or shutter mechanism extends into either the thickness of the front cover defining the hole in the front cover or said bulge.

C. U.S. Patent No. 4,972,649 (the “649 patent”)

The parties stipulate that CSI intends to import cameras that are loaded by either the pancake method or the black box method as those terms have been described in the EID in the consolidated related Advisory and Enforcement Proceeding.

D. U.S. Patent No. 4,954,857 (the “857 patent”)

The parties stipulate that in both prototypes, the cameras in issue utilize a double cassette system (DCS) in which the unexposed film is surrounded by and contained within a secondary container, of the type marked at the deposition of Terry White. Mr. White can load the M201 DCS cartridge into the camera substantially as he did on videotape at his deposition.

#### Additional Procedures

The parties agree that a hearing is not necessary or desirable, and that this proceeding should be decided by the ALJ based upon this stipulation and the submissions of the parties. The parties agree that as part of their submissions, and notwithstanding the rules regarding use of deposition testimony, they may use the previously identified exhibits and portions of the depositions taken in this case (Terry White and Alfred Bellows), including the videotape of Mr. White’s deposition, and any and all exhibits utilized therein. Notwithstanding the foregoing, nothing herein is intended to limit a party’s right to object to any

evidence being considered on any evidentiary ground, such as hearsay, relevance, etc. To the extent that CSI's pending motions in limine are decided such decision shall apply to the evidence that is usable in this proceeding. The foregoing is intended only to agree to submit whatever evidence is admissible by way of deposition transcript, documents, and physical exhibits, rather than live testimony, subject to all the same objections as if it were live.

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Nothing herein is intended to limit any party's right to use, in its submission, any other admissible evidence such as the file wrappers, document production, or any other document that would properly be admissible if a hearing had taken place, subject to all proper objections. The parties contemplate, base and condition this stipulation on an assumption that a hearing as scheduled will not take place, but that the ALJ will decide the issues and enter findings of fact and conclusions of law based on this stipulation and the evidence after taking briefs, reply briefs and proposed findings of fact and conclusions of law into consideration, with a briefing schedule as set forth herein. In the event the ALJ orders a hearing, this stipulation shall be null and void.

This Stipulation shall not affect the applicability of Rule 210.79 or any other rule and the parties shall have whatever rights they would have had in the event an actual hearing occurred. For example, CSI will have whatever protection against the Commission proceeding against it with any enforcement measures as is set forth in Rule 210.79. Also, Fuji and OUII shall have the full right to later argue that either of the two prototypes infringes any of the patent claims in issue if the claim construction is altered.

(Stipulation at 1-4.)

Order No. 129, which issued on December 2, 2003, granted Fuji's Motion No. 406-188 for reconsideration/clarification of Order No. 124 to the extent that objection to CXAP2-13 was overruled insofar as it related to questions and answers 18-24, 26-28, 30-41, 44-48 and 51-53. In addition, questions and answers 43, 49 and 50 were admitted in the form attached to Motion No. 406-188 and questions 25, 29 and 54 were admitted insofar as those questions related only to the '857 and '200 patents. Motion No. 406-188 was denied as it related to question 42 of CXAP2-13.

The administrative law judge has received a letter dated December 18, 2003 from CSI's counsel enclosing "pages 50, 51 and 70" of Bellows' deposition transcript and "pages 62 and 83" of White's deposition transcript and stating that those pages "should have been included in CSI's portion of the Joint Designations previously sent." Said portions of the White transcript, however, form a portion of Fuji's CXAP2-12 which is already in evidence. Said page 70 of the Bellows' transcript forms a portion of JX-2.<sup>2</sup> Hence the administrative law judge is not including said page 70 (Bellows) and said pages 62 and 83 (White) in any joint exhibit. In view of the fact that neither Fuji nor the staff objected to said letter of December 18, the administrative law judge has included said pages 50 and 51 (Bellows) at the end of JX-2 in the Commission set of exhibits. In addition the sample inner packaging for the M-201 (CPXAP2-1) lacks the label CPXAP2-5 so identified by Fuji. Hence the administrative law judge has identified the sample of the inner packaging in the Commission set of exhibits as "CPXAP2-5."

The final post-hearing submissions were filed in mid-December 2003. Hence the matter is ready for decision.

This IAO is based on the record compiled including the exhibits admitted into evidence. Proposed findings of fact submitted by the parties not herein adopted, in the form submitted or in substance, are rejected as either not supported by the evidence or as involving immaterial matters and/or as irrelevant. Certain findings of fact included herein have reference to supporting evidence in the record. Such references are intended to serve as guides to the testimony and exhibits supporting the findings of fact. They do not necessarily represent complete summaries

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<sup>2</sup> Consistent with footnote 1 of Order No. 124, JX-1 and JX-2 are received into evidence.

of the evidence supporting said findings.

II. Parties

See FF 1-2.

III. The Product In Issue

The product at issue is an M-201 camera that CSI seeks to import and sell in the United States. (CSI Request for Advisory Opinion Proceeding.) During discovery in this proceeding, CSI produced two prototypes of the M-201 to Fuji for inspection, viz. CPXAP2-6 which CSI represented was the first prototype delivered to Fuji (CSI Post at 2) and CPXAP2-1. As stipulated by the parties, CPXAP2-6 has a generally semi-circular rim around the shutter blade while CPXAP2-1 has a completely flat shutter blade. (Stipulation at A.)

CSI represented that CPXAP2-6 “likely infringes Claim 1 of the ‘200 patent”; that this model was “inadvertently” sent to Fuji; and that CSI “is not seeking an advisory opinion on this camera, which it does not plan to import.” (CSI Post at 2.)

Fuji, relying on Certain Reclosable Plastic Bags and Tubing, Inv. No. 337-TA-266, Unreviewed Initial Advisory Opinion (July 1989) (Bags), argued that the M-201 camera in issue is at “too theoretical a stage” for any advisory opinion; that the “Commission should deny CSI’s request for an advisory opinion until it presents the actual camera it intends to import, assembles it the way it will be assembled and makes replacement film available with its actual process.” (CPost at 4, 23-24.) Fuji argued that one prototype of the M-201 camera has a shutter blade with a semi-circular rim, while another prototype has a flat shutter blade; that some of the prototype M-201 cameras are preloaded double cartridge cameras; that some M-201 cameras are lacking film altogether; that the production models to be used in the commercial embodiment are

different that those used to produce the prototypes, which will result in the parts fitting together differently; that a necessary component of the M-201 camera, the replacement film cartridge, is not available; and that the manufacturing company may or may not have the equipment necessary to load the M-201 camera in the manner for which the opinion is sought. (CRPost at 1.) Fuji further argued that given all the “open” issues, CSI will not be able to rely on any advisory opinion issued based on the prototypes in order to import the commercial embodiment of the M-201 camera when it becomes available; that the cameras that are the basis for the IAO are not the same as the cameras CSI intends to import; that CSI could have properly avoided this problem by producing the first run of the M-201 camera commercial line so that the IAO would actually have meaning; and that in the end, CSI’s request for the IAO was premature, as any findings made based on the prototypes will have to be re-visited once the commercial embodiment to be imported becomes available. (CRPost at 2.)

The staff argued that the M-201 camera is not “too theoretical” and that the IAO is warranted. (SRPost at 1-4.)

The Commission has determined that CSI’s request for an advisory opinion “complies with the requirements for institution of an advisory opinion proceeding under Commission rule 210.79(a).” (Commission Notice at 2 (September 3, 2003).) Also the Commission, in its September 3 Order, has determined that this administrative law judge should issue an IAO which shall rule on the question of whether CSI’s camera model M-201 infringes certain claims of the ‘857 patent, the ‘649 patent, the ‘200 patent and the ‘168 patent. Thus this IAO is not “premature.” In view of CSI’s representation that CSI is seeking an advisory opinion only on

camera model M-201 (CPXAP2-1),<sup>3</sup> this IAO will be limited to said model.

Fuji complains that CSI has not embarked on commercial manufacture, importation and sale in the United States. (CPost at 1-3.) However, one acceptable reason for instituting an advisory opinion proceeding is the “obvious risk of building a production facility for the manufacture of an article which may or may not be covered by a United States patent.” Certain Surveying Devices, Inv. No. 337-TA-68, Advisory Opinion at 3, USITC Pub. 1178 (August 1981). In addition any advisory opinion issued by the Commission will be limited to the embodiment actually presented to it for determination, viz. M-201 (CPXAP2-1). If the commercial embodiment that CSI manufactures and imports is materially different from its M-201, the advisory opinion will not provide CSI any protection and in fact could be asserted as evidence of bad faith in any subsequent enforcement proceeding. Also, CSI’s counsel could be required to notify the Commission if there is any change in what is imported as compared to M-201 (CPXAP2-1).

The administrative law judge rejects Fuji’s argument (CPost at 23-24) that M-201 (CPXAP2-1) in issue is “at too theoretical a stage” for any advisory opinion and that Bags is precedent for any such finding. In Bags in issue, inter alia, was whether an accused KPM process would infringe claim 5 of U.S. Patent No. 3,945,872 (the ‘872 patent). Said claim 5 recited in its paragraph 1:

In the method of making plastic film with shaped profiles on the surface comprising the steps of: extruding a continuous length of an interlocking profile from a die opening with the profile having a precise shape for interlockingly engaging with another profile. . .

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<sup>3</sup> Referenced hereafter as “M-201(CPXAP2-1)” or “M-201.”

It was undisputed that the accused process of requester KPM, was covered by paragraph 1 of claim 5. However, at issue was the second paragraph of claim 5, viz.:

and directing a flow of coolant against the heated profile and adjusting the pressure of coolant flow for controlling the cooling rate and shape of the profile.

Bags, at 14 (emphasis added). This second paragraph required that the separate integrity of a flow of coolant, as it is directed from the source, must be maintained, as an air jet, at the point of the air's impact upon the profile. Thus if it was found that KPM had established that the air was not so controlled, claim 5 was not infringed. Bags, at 14. Complainant Minigrip Inc. had argued that the KPM air rings emanate jets of air that strike the profile. This administrative law judge however found that Prof. Charles A. Garris conducted a detailed and expert mapping test under conditions representative of the conditions of the accused process and showed that in the accused process the air flow before the air's impact upon said profile of the KPM air ring underwent a transition from laminar to turbulent flow before the air's impact upon said profile; that under any conceivable definition of the word "jet", while separate jets initially emanated from the air ring orifices, it was impossible to conclude that any jet existed in the area of the KPM air ring; and that the air in the region adjacent to the tubing could only be described as a peripherally homogeneous turbulent churning stream. He thereafter found that the accused process would not infringe claim 5 of the '872 patent. Id. at 15-16.

As seen from the facts in Bags, a critical issue for determining infringement was whether the separate integrity of a flow of coolant, as the coolant was directed from a source, was maintained, as an air jet, at the point of the air's impact upon a profile. The administrative law judge finds no comparable issue regarding claim readability in this proceeding. While Fuji

argued, as to the '649 patent, that CSI has not provided any evidence as to the loading process that CSI will actually use for any commercial embodiment, Fuji admitted that CSI has stated that the M-201 will be loaded by either the pancake method or the black box method as those terms have been described in the EID. (CRPost at 2.) Moreover, it has been so stipulated. (Stipulation at C.) While Fuji argued, as to the '857 patent, that Bellows testified that the M-201 could not be readily loaded and reloaded by the ordinary consumer, it has been stipulated that White can load the M-201 DCS cartridge into the camera substantially as he did on videotape at his deposition. (CRPost at 5; Stipulation at D.)<sup>4</sup> While Fuji further argued that replacement film needed to use with the M-201 is currently not available, both Fuji and the staff petitioned the Commission with regard to the finding in the EID that the Highway Holdings camera did not satisfy the “must be destroyed” limitation, based in part on the absence of available replacement film, and the Commission upheld the EID’s conclusion that the Highway Holdings camera did not meet this limitation.<sup>5</sup> (CRPost at 5-6.) While Fuji argued, as to the '168 patent, that there is no evidence “as to how the parts will fit together in the commercial embodiment that is to be imported”, the parties stipulated that: (1) the taking lens of the M-201 extends into the space defined by the

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<sup>4</sup> Fuji relies on deposition testimony of White that, as to the '857 patent, the final product would be molded and constructed differently than the “prototypes.” (White Dep. Tr. at 83:6-19 and 116:7-12; CPost at 24-25.) While Tr. 83:6-19 does not form a portion of JX-1, it is a portion of CXAP2-12 which was received into evidence in Order No. 124. The administrative law judge agrees that a prototype mold is not, and differs from, a production format mold. (Tr. at 116:7-12, CPost at 25.) However, a prototype is “the original or model on which something is based or formed.” The Random House College Dictionary at 1064 (1980).

<sup>5</sup> Fuji has appealed this finding to the Federal Circuit. However, unless and until the Federal Circuit reverses the Commission’s determination, Fuji’s argument regarding the availability of replacement film is not pertinent.

bulge surrounding the lens hole in the front cover, but the taking lens does not extend into the lens hole in the front cover; and (2) no part of the film transport mechanism or shutter mechanism extends into either the thickness of the front cover defining the hole in the front cover or said bulge. (CRPost at 7; Stipulation at B.) While Fuji argued, as to the '200 patent, that there is no way for customs to tell, without opening the cameras, whether a CSI camera has a flat or a narrowed shutter blade (CRPost at 8), it has been stipulated that the M-201 in issue has a completely flat shutter blade. (Stipulation at A.) Hence the administrative law judge has rejected Fuji's "at too theoretical a stage" argument.

#### IV. The '857 Patent

In issue is claim 1 of the '857 patent which reads:

1. A lens-fitted photographic film package having an externally operable member for effecting an exposure, comprising:

a light-tight casing having an opening through which said exposure is made when said externally operable member is operated;

a roller [sic - rolled] unexposed film disposed on one side of said opening in an unexposed film roll receiving chamber in said light-tight casing with its outermost turn exposed to side walls of said chamber and its inner-most turn surrounding an empty space; [and] ...

a removable light-tight film container having a film winding spool therein disposed on the opposite side of said opening in said light-tight casing from said rolled film, one end of said rolled film being attached to said film winding spool;

means for winding said rolled film into said light-tight film container and around said film winding spool; and

means defining a film passage in said light tight casing, wherein said light-tight casing must be destroyed to expose said film passage.

(CXAP2-16.)

A. Claim Interpretation

In issue for claim interpretation is the claimed language:

a roller [sic - rolled] unexposed film disposed on one side of said opening in an unexposed film roll receiving chamber in said light-tight casing with its outermost turn exposed to side walls of said chamber and its inner-most turn surrounding an empty space...

Claim construction is a question of law to be decided by the administrative law judge.

Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed. Cir. 1995), aff'd, 517 U.S. 370, 376 (1996) (Markman). The construction of the language of a claim should be made independently of what is being alleged to infringe the claim. See Donald S. Chisum, Patents § 18.03.

As for proper claim construction:

It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record i.e., the patent itself, including the claims, the specification and, if in evidence, the prosecution history. Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.

Vitronics Corp. v. Conceptor Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996) (citation omitted) (emphasis added) (Vitronics). To construe the claims of a patent “a court principally consults the evidence intrinsic to the patent, including the claims, the written description, and the relevant prosecution history.” Watts v. XL Sys. Inc., 232 F.3d 877, 882 (Fed. Cir. 2000) (emphasis added), citing Vitronics, 90 F.3d at 1582.

In considering claim language, in the absence of any ambiguity and where the specification and/or prosecution history does not teach otherwise, the “ordinary and customary meaning of a disputed claim term is presumed to be the correct one.” See K-2 Corp. v. Salomon,

S.A., 191 F.3d 1356, 1362-63 (Fed. Cir. 1999). “[T]he focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean.” Markman, 52 F.3d at 986. Also, a claim term must be given the same interpretation whenever it is employed in the claims, i.e., the meaning of a claim term should not vary from claim element to claim element or from claim to claim. Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579 (Fed. Cir. 1995) (Southwall).

The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention. For claim construction purposes, the written description may act as a dictionary, which explains the invention and may define terms used in the claims. A patentee is free to be his own lexicographer, although any special definition given to a word must be clearly defined in the specification. Markman, 52 F.3d at 980 (noting special definition given to claim term must be defined in specification); see also, e.g., Biovail Corp. Int’l v. Andrx Pharm., Inc., 239 F.3d 1297, 1300-01 (Fed. Cir. 2001) (requiring review of specification and applicable prosecution history to determine whether patentee defined claim term inconsistent with its ordinary meaning); Hockerson-Halberstadt, Inc. v. Avia Group Int’l, Inc. 222 F.3d 951, 955 (Fed. Cir. 2000) (“The court, therefore, must examine a patent’s specification and prosecution history to determine whether the patentee has given the term an unconventional meaning.”); Vitronics, 90 F.3d at 1582 (concluding patentee may employ terms inconsistent with their ordinary meaning as long as term is clearly defined in specification or file history).

The prosecution history is of “critical significance in determining the meaning of the claims.” Vitronics, 90 F.3d at 1582 (emphasis added). “The prosecution history limits the

interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution.” *Id.* at 1583 (emphasis added), quoting *Southwall*, 54 F.3d at 1576. Thus, claims may not be construed one way in order to obtain their allowance and in a different or inconsistent way against accused infringers. Recently, the Federal Circuit commented on the rationale underlying this principle of claim interpretation:

The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during the prosecution of the patent. A patentee may not state during prosecution that the claims do not cover a particular device and then change position and later sue a party who makes that same device for infringement. ‘The prosecution history constitutes a public record of the patentee’s representations concerning the scope and degree of the claims, and competitors are entitled to rely on those representations when ascertaining the degree of lawful conduct...’.

*Springs Window Fashions LP v. Novo Industries, L.P.*, 323 F.3d 989, 995 (Fed. Cir. 2003), quoting *Hockerson-Halberstadt, Inc.*, 222 F.3d at 957. When a patentee has distinguished the claimed invention over the prior art, the applicant “is indicating what the claims do not cover, [and] he is by implication surrendering such protection.” *Ekchian v. Home Depot, Inc.*, 104 F.3d 1299, 1304 (Fed. Cir. 1997).

The administrative law judge may, in his discretion, receive extrinsic evidence to aid him in coming to a correct conclusion as to the true meaning of language employed in a patent. *Markman*, 52 F.3d at 981, 986. Extrinsic evidence consists of all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries and learned treatises.<sup>6</sup> Extrinsic evidence is not to be used for the purpose of clarifying ambiguities in claim

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<sup>6</sup> “Although technical treatises and dictionaries fall within the category of extrinsic evidence, as they do not form a part of an integrated patent document, they are worthy of special note. Judges are free to consult such resources at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms,

terminology. Markman, 52 F.3d at 986. Moreover, neither the patentee nor the alleged infringer may alter the scope of the claims. Thus,

where the public record unambiguously describes the scope of the patented invention, reliance on any extrinsic evidence is improper. The claims, specification, and file history, rather than extrinsic evidence, constitute the public record of the patentee's claim, a record on which the public is entitled to rely.

Vitronics, 90 F.3d at 1538-39.

Only the disputed claim elements need be interpreted by the administrative law judge.

See In the Matter Certain Hardware Logic Emulation Systems and Components Thereof, Inv. No. 337-TA-383 (Unreviewed Initial Determination) (July 31, 1997) (Hardware Logic); In the Matter of Certain Ion Trap Mass Spectrometers and Components Thereof, Inv. No. 337-TA-393, Initial Determination at p. 24-25 (February 25, 1998).<sup>7</sup>

Fuji argued that there exists no limitation in the '857 patent that excludes the presence of a multi-wall film roll chamber secondary cartridge around the film roll; that the plain words of claim 1 do not specify the number of walls of the film roll chamber; and that CSI has not specified any portion of the specification of the '857 patent that defines the number of walls the film roll chamber must have. (CPost at 13, 17; CRPost at 3.) It is further argued that Fuji's

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so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents." Vitronics, 90 F.3d at 1584, n.6.

<sup>7</sup> This course of action has been sanctioned by the Court of Appeals for the Federal Circuit, which, referring to Hardware Logic, stated that "[b]y agreement, the appeal turns on the proper construction of certain disputed terms in the three asserted claims. The operation and structure of the accused device are neither uncertain nor disputed. In sum, we adopt the claim construction of the Commission which was correct and derived according to our case law on appropriate methodology." Mentor Graphics Co. v. United States International Trade Commission, 124 F.3d 226 (Fed. Cir. 1997) (unpublished disposition per Federal Circuit Rule 47.6(a)).

expert Bellows testified that the language of claim 1, on its face, does not preclude the presence of a secondary cartridge and thus the “ordinary meaning” of the language supports Fuji’s position. (CPost at 13.)

CSI argued that while Fuji’s position is that a small secondary container in which the unexposed roll of film is kept meets the outermost turn limitation, any such secondary container used to hold the unexposed roll of film separates and prevents the outermost turn of the unexposed film from being exposed to the sidewalls of the chamber. Hence CSI argued that any double cassette system in which the unexposed roll of film is contained within a secondary container can not meet the claimed language in issue because the sidewalls of the film chamber and the unexposed film are separated by a plastic secondary container, thus preventing exposure of the outermost turn of the unexposed roll of film to the film chamber. (CSI Post at 5.)

The staff argued that the claim language in issue cannot be properly construed to encompass the use of a secondary cartridge surrounding the roll of unexposed film, which interpretation is supported by the figures and written description in the specification. It is argued that there is nothing in the claims or the specification that expressly points away from such a construction. The staff further argued that the file history requires exclusion of a secondary cartridge surrounding the roll of unexposed film. (SPost at 21.)

Looking at the plain language in issue of claim 1, this language simply requires an “unexposed film roll receiving chamber” to be present in a light-tight casing. Moreover, none of the other claims of the ‘857 patent refine the requirement for an “unexposed film roll receiving chamber.” However the language in issue is not without ambiguity. Thus even Fuji’s Bellows acknowledged at his deposition that the claim language in issue, a roll of “unexposed film

disposed on one side of said opening in an unexposed film roll receiving chamber in said light-tight casing with its outermost turn exposed to side walls of said chamber,” is subject to different meanings:

Q: Mr. Bellows, can you tell me if it’s possible in your opinion to have a camera that meets the language of a roll of unexposed film disposed on one side of said opening in an unexposed film roll receiving chamber in said light-tight casing but which does not have its outermost turn exposed to side walls of said chamber, is that possible in your opinion?

A: Well, as I said before I would want a clear definition of what you mean by exposed.

Q: The same definition that you used when you did your infringement analysis of claim one of the ‘857 patent.

A: Well, there’s a problem with that.

Q: Because?

A: The word “exposed” could mean both touching or it could mean in view of.

(JX-2, Bellows Dep. Tr. at 34-35 (emphasis added).)

Referring to the ‘857 patent, the abstract and summary of the invention state that the receiving chambers are “formed in a main body section of the lens-fitted photographic film package.” (CXAP2-16, abstract, col. 2, ll.62-64 (emphasis added).) The use of the intransitive verb “formed” along with the preposition “in” supports an interpretation that it is the main body section of the LFFP which gives shape to or comprises the film roll receiving chamber.<sup>8</sup> A film

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<sup>8</sup> The Random House College Dictionary, Revised Ed. (1980) defines “in” as:

1. (used to indicate inclusion within space, a place, or limits): *walking in the park*.
2. (used to indicate inclusion within something immaterial): *in politics; in the autumn*.
3. (used to indicate inclusion within or occurrence during a period or limit of time): *in ancient times; a task done in ten minutes*.
4. (used to indicate limitation or qualification, as of situation, condition, relation, manner, action,

roll receiving chamber according to this description is shown as item 11 in Figures 3 and 4 and as item 56 in Figure 8 of the '857 patent. (CXAP2-16, col. 4, ll.32-36, col. 5, ll.48-50, col. 7, ll.35-37.) Further, this definition of a receiving chamber is consistent with that of the complementary receiving chamber, the "film patrone receiving chamber," which is located on the opposite side of the exposure opening from the "film roll receiving chamber." The "film patrone receiving chamber" is also formed by the main body section of the LFFP and is shown as item 12 in Figures 3 and as item 55 in Figure 8 of the '857 patent. (CXAP2-16 col. 4, ll.32-36, col, 7, ll.35-37). If a "receiving chamber" can be construed to include a secondary film cartridge, then the administrative law judge finds that a "film patrone receiving chamber" is redundant because Fuji has specifically identified a chamber to include unexposed, rolled film (film roll receiving chamber) and a separate film patrone receiving chamber which collects exposed film inside the patrone. In addition the specification consistently distinguishes between the receiving chamber for the unexposed roll of film, which is the "film roll receiving chamber," and the receiving chamber for the film patrone or light-tight film container which is, the "film patrone receiving chamber" or "film container receiving chamber." (See, e.g., CXAP2-16, col. 4, ll.33-35, col. 4,

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etc.): *to speak in a whisper; to be similar in appearance.* **5.** (used to indicate means): *sketched in ink; spoken in French.* **6.** (used to indicate motion or direction from outside to a point within); into: *Let's go in the house.* **7.** (used to indicate transition from one state to another): *to break in half.* **8.** (used to indicate object or purpose): *speaking in honor of the event.*

To "form," used as an intransitive verb means:

*v.i.* **30.** to construct or frame. **31.** to make or produce. **32.** to serve to make up; serve as; compose; constitute. **33.** to place in order; arrange; organize. **34.** to frame (ideas, opinions, etc.) in the mind. **35.** to contract (habits, friendships, etc.) **36.** to give form or shape to; shape; fashion. **37.** to give a particular form or shape to; fashion in a particular manner. **38.** to mold by discipline or instructions.

ll.47-50, col.7, ll.18-21, col.7, ll.35-39, col. 9, ll. 40-48, col. 11, ll.35-41, col. 11, ll.50-61, col. 12, ll.1-17, col. 13, ll.22-27, col. 13, ll.54-63.) Thus the administrative law judge finds that several portions of the specification teach away from the presence of a secondary cartridge.

Fuji argued that “the ‘857 patent itself describes a sheath (end 42 of retaining member 40) surrounding the film roll, in Figs. 4 and 5, as part of a multi-wall film roll receiving chamber.” (CPost at 13.) However, the identified portions of Figures 4 and 5 do not constitute a secondary cartridge or even a continuous sheath but rather the arms of a cut-away retaining member which is preferably made of a leaf spring attached to the back cover. (See CXAP2-16, col. 6, ll.27-31.) Rather than constituting a continuous wall like a secondary cartridge or sheath, the identified portions hold the film roll “only at the top and bottom” such that “the friction force exerted on the outermost convolution of the film roller is small.” (See CXAP2-16, col. 6, ll.56-59.) The specification further specifies that unlike a secondary cartridge or sheath, the retaining member is largely cut away to allow the teeth of the sprocket wheel to enter the perforations of the film. (See CXAP2-16, col. 6, ll.37-39, 48-50.)

Turning to the prosecution history of the ‘857 patent, claim 1 of the ‘857 patent arose out of claim 6 of the parent patent application (application no. 087,388, now issued as U.S. Patent No. 4,884,087 (the ‘087 patent).) As originally filed on August 20, 1987, claim 6 recited:

A lens-fitted photographic film package having an externally operable member for effecting an exposure, comprising:

a light-tight casing which must be destroyed to open the same, having an opening through which said exposure is made when said externally operable member is operated;

a rolled film disposed on one side of said opening in said light-tight casing;

a removable light-tight film container having a film winding spool therein disposed on the opposite side of said opening in said light-tight casing from said rolled film, one end of said rolled film being attached to said film winding spool; and

means for winding said rolled film around said film winding spool.

(CPX-IV, Original Application at 41-42.) The Patent Office rejected this claim as obvious over a combination of Netherland and Lawther references. (CPX-V, Tab 12, Office Action at 2-3.) In response to the rejection, on February 21, 1989, Fuji amended claim 6 to read:

A lens-fitted photographic film package having an externally operable member for effecting an exposure, comprising:

a light-tight casing which must be destroyed to open the same, having an opening through which said exposure is made when said externally operable member is operated;

a rolled unexposed film disposed on one side of said opening in an unexposed film roll receiving chamber in said light-tight case with its outermost turn exposed to side walls of said chamber;

a removable light-tight film container having a film winding spool therein disposed on the opposite side of said opening in said light-tight casing from said rolled film, one end of said rolled film being attached to said film winding spool, said unexposed film having been drawn from said light-tight film container; and

means for winding said rolled film around said film winding spool.

(CPX-V, Tab 14, Amendment at 1-2 (underlined added by amendment).) In the remarks to this amendment, Fuji told the Examiner:

Claim 6, in turn, has been extensively amended so as to set forth with ample particularity and distinctness a new combination having no counterpart in the cited references, alone or in any proper combination. Specifically:

Claim 6 is drawn to the new and obvious combination of a rolled unexposed film 23 disposed on one side of the exposure opening, and a removable light-tight film container 20 having a winding spool, disposed on the other side of that opening, in a light-tight film casing that must be destroyed to open it. Most

of the unexposed film is disposed in that roll 23. Upon exposure, the film is drawn frame by frame into container 20.

This construction has two principal advantages:

1. The exposed film can be removed when the package is broken open, without the need to do this in a darkroom, because all the exposed film has been drawn into the light-tight container 20.

2. Only one container is needed: the unexposed film in the package as manufactured, prior to use, is disposed in that roll 23 of unexposed film which is disposed on the side of the exposure opening opposite the container for the exposed film. Claim 6 as now drawn makes it plain that there is no container surrounding the unexposed film. The cost of two containers is thus cut in half.

(Id. at 10 (emphasis added).) In addition, Fuji distinguished Lawther stating that Lawther taught a one-container system, “but that one container contains the unexposed film” and “[t]hus, Lawther would lead a person skilled in the art away from the present invention, not toward it.”

(Id. at 11.) The present invention was again characterized as providing “but a single light-tight container in the case and the unexposed film in a roll on the opposite side of the exposure aperture from that container. Claim 6 is drawn to this new and unobvious combination and so is patentable, and with it the claims that depend therefrom.” (Id. (first emphasis added).)

Fuji’s amendments and argument satisfied the Examiner with regard to the combination of Netherland and Lawther references. (See CPX-V, Tab 15, Office Action at 3.) However, the Examiner then “inquired how the subject matter of claim 6 is unobvious in view of any of the SRL cameras [U.K. 2,138,580A in particular] in which the unexposed film is fully withdrawn from the cartridge prior to the first exposure, and then is rewound into the cartridge one frame at a time.” (CPX-IV, Tab 3, Preliminary Amendment at 7.)

On June 19, 1989, Fuji cancelled claim 6 among others to permit issuance of the allowable claims and on September 19, 1989, filed a divisional application (application no. 409, 420, which became the '857 patent in issue) to continue prosecution of claim 6 and other claims. (CPX-V, Tab 18, Amendment at 1; CPX-IV, Tab 2, Divisional Application Transmittal.) In a preliminary amendment, Fuji further modified claim 6 as follows:

A lens-fitted photographic film package having an externally operable member for effecting an exposure, comprising:

a light-tight casing [which must be destroyed to open the same,] having an opening through which said exposure is made when said externally operable member is operated;

a rolled unexposed film disposed on one side of said opening in an unexposed film roll receiving chamber in said light-tight casing with its outermost turn exposed to side walls of said chamber and its innermost turn surrounding an empty space;

a removable light-tight film container having a film winding spool therein disposed on the opposite side of said opening in said light-tight casing from said rolled film, one end of said rolled film being attached to said film winding spool; [and]

means for winding said rolled film into said light-tight film container and around said film winding spool; and

means defining a film passage in said light-tight casing, wherein said light-tight casing must be destroyed to expose said film passage.

(CPX-4, Tab 3, Preliminary Amendment at 1-2 (underlined text added by amendment).) Fuji explained:

[T]he film package of the present invention must be made as simple in structure and hence as inexpensive as possible, so that its cost will be very little more than the cost of an ordinary roll of film. This leads to certain structural expedients which are not at all obvious upon consideration of a standard SRL camera. One of those unobvious measures that have been taken in the present invention is as shown on, for example, the right-hand side of Fig. 2 of our drawings. There, it

will be seen that the unexposed film in the package is wound up in a roll, with the outermost turn of the roll exposed to the side walls of its chamber and its innermost turn surrounding an empty space. This is the simplest and least expensive construction imaginable. It would be utterly impossible in an SRL camera, for how would the unexposed film ever be disposed in the chamber in that configuration? But this arrangement is possible with the present invention, in which the film is first loaded into the open package under darkroom conditions, and then the package is closed and sealed.

(Id. at 8 (emphasis added).) Thereafter, the Examiner, without comment, allowed claim 6 of the application which issued as claim 1 of the '857 patent. (CPX-IV, Tab 5, Notice of Allowability.)

The administrative law judge finds that the prosecution history of the '857 patent excludes the use of a secondary cartridge surrounding the roll of unexposed film. As seen from the foregoing, Fuji, in responding to a prior art rejection, distinguished its invention over the prior art by stating that the amended claim “makes it plain that there is no container surrounding the unexposed film.” (CPX-IV, Tab 14, Amendment at 10.) This language clarifies what the applicant saw as its invention, and is deliberate, clear, and unambiguous. At the time, Fuji thought that the fact that its invention excluded a secondary container surrounding the unexposed film was made “plain” by its amendments to claim 6. Thus Fuji made it plain to the Examiner, and to any competitor reading the prosecution history, that Fuji’s invention, including a “film roll receiving chamber in said light-tight casing with its outermost turn exposed to side walls of said chamber,” did not encompass a secondary cartridge surrounding the unexposed film. The fact that the comments may not have been necessary to distinguish the prior art or that other distinctions could have been made does not negate the fact that Fuji, in the prosecution history, in an effort to obtain allowance, expressly characterized its invention as having no secondary cartridge surrounding the unexposed film. See e.g., Springs Window Fashions LP v. Novo

Indus., L.P., 323 F.3d at 995; Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc., 222 F.3d at 957; Ekchian v. Home Depot, Inc., 104 F.3d at 1304.

Fuji argued that its argument regarding a second cartridge in the parent application did not secure allowance inasmuch as there was later another rejection by the Examiner. According to Fuji, the argument was “dropped” in the prosecution of the ‘857 patent. (CPost at 3, 13-15.) However, Fuji’s amendments and comments did result in removal of the obviousness rejection over Netherland and Lawther and so aided in securing ultimate allowance. (See CPX-IV, Tab 12, Office Action at 2-3.) At no time did Fuji expressly retract any of its arguments. Moreover Fuji, in the preliminary amendment to the application which issued as the ‘857 patent, argued that the film package of the invention “must be made as simple in structure and hence as inexpensive as possible” to keep the cost low. See supra. The administrative law judge finds that a double cartridge system would not meet Fuji’s description of its invention in terms of “as simple in structure and hence as inexpensive as possible” because the cost-savings touted amendment would be negated by the use of a double cartridge system.

Fuji argued that arguments in the parent application were not repeated in the divisional application. However, the prosecution of a parent can limit the child claim when the arguments are made only in the parent case. See, e.g., Alloc, Inc. v. Int’l Trade Comm’n, 342 F.3d 1361, 1372 (Fed. Cir. 2003) (concluding applicant’s remarks to examiner in parent application applied to subsequent applications employing same claim term); Omega Eng’g, Inc. v. Raytek Corp., 334 F.3d 1314, 1333-34 (Fed. Cir. 2003) (holding narrowing disclaimer during prosecution of parent applied to patent issued from continuation-in-part of parent application) (Fed. Cir. 2003); Augustine Med., Inc. v. Gaymar Indus, Inc., 181 F.3d 1291, 1300 (Fed. Cir. 1999) (finding

amendments and arguments restricting the scope of claims in the parent application attached to later issued patents containing the same claim limitation). Thus, Fuji's arguments to overcome the obviousness rejection based on the combination of Netherland and Lawther references in application no. 087,388 (now issued as the '087 patent) attach to the same claim limitation in application no. 409,420 (now issued as the '857 patent), a divisional of application no. 087,388.

Based on the foregoing, the administrative law judge finds that the proper construction of the claimed language in issue excludes the use of a secondary cartridge surrounding the roll of unexposed film.

#### B. Infringement

In addition to claim 1 of the '857 patent excluding the use of a secondary cartridge surrounding the roll of unexposed film, said claim 1 has a "must be destroyed" limitation. In the initial investigation, this administrative law judge construed the "must be destroyed" limitation as describing "an LFFP that after a single use has lost light-tightness upon removal of the film cartridge and which cannot be opened and reloaded by the user, like a conventional camera, but must be broken or disassembled in order to retrieve the used film." (ID at 14, 16, 23 and 34.) During the consolidated Enforcement and Advisory Opinion Proceedings, he further clarified that the "must be destroyed" limitation must be construed in the disjunctive - - "i.e., a film casing 'must be destroyed' if it cannot be opened without losing its light tightness, or it cannot be readily be [sic] reloaded like a conventional camera." (EID at 22-23 (emphasis in original).)<sup>9</sup>

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<sup>9</sup> While the EID construed the phrase "must be destroyed" with respect to claims 19 and 22 of the '857 patent (as well as claims 1 and 5 of U.S. Patent No. 4,833,495, and claims 1, 7, 8 and 15 of the '087 patent), a claim term must be given the same interpretation whenever it is

As for whether the M-201 infringes claim 1 of the '857 patent, CSI has the burden of establishing non-infringement. See Bags, at 4. It is undisputed that the M-201 in issue employs a double cassette system in which the unexposed film is surrounded and contained within a secondary container. (Stipulation at D.) As found supra, the phrase "film roll receiving chamber" cannot be properly construed to include a secondary film cartridge, such as that employed in the M-201. Further, if the film roll is encased in a secondary cartridge, as it is in the M-201, the outermost turn of the film roll is exposed to the walls of the secondary cartridge and not exposed to side walls of the film roll receiving chamber. Therefore, the M-201 is missing an element of the claim and would not infringe claim 1 of the '857 patent. As for the "must be destroyed" limitation, Fuji's expert Bellows tested the sample received from CSI with a hand-cut inner cover but without film for light-tightness after reloading it with film. (CXAP2-13 at 23-25.) The results of this testing showed that there "were no apparent light leaks after a total exposure of 20 minutes to sun in four positions." (Id. at 25.) Thus, the M-201 would not lose light-tightness upon removal of a film cartridge. In addition, Bellows devised a method to reload said sample camera using standard 35mm film. (CXAP2-13 at 23-24.) He concluded that devising such a method to reload the M-201 would be "well beyond the capability of the ordinary user." (CXAP2-13 at 25.) However, Bellows confirmed at his deposition that, if provided a light-tight replacement double cassette of film, the M-201 camera could be reloaded in the light of the conference room used for his deposition. (JX-2, Bellows Dep. Tr. at 70-72.) White's videotaped demonstration of reloading shows that the M-201 can be easily reloaded. (See RAP2-P2; see also

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employed in the claims - *i.e.*, the meaning of a claim term should not vary from claim element to claim element or from claim to claim. Southwall, 54 F.3d at 1579.

Stipulation at D.) Moreover, Bellows testified that when compared to the Highway Holdings camera from the consolidated Enforcement and Advisory Opinion Proceedings, the Highway Holdings camera was more difficult to reload compared to the M-201. (JX-2, Bellows Dep. Tr. at 72.)

In his Enforcement Initial Determination, this administrative law judge found that the Highway Holdings camera “can be opened, reloaded, and closed without loss of light tightness by snapping the battery cover into place and can be readily reloaded like a conventional camera.” (EID at 63 (emphasis in original).) Thus, he found that the Highway Holdings camera did not meet the “must be destroyed” limitation.<sup>10</sup> (Id.) In the same manner, the M-201 can be opened and closed without any loss of light tightness, and can be readily reloaded much like a conventional camera. Thus, the administrative law judge finds that the M-201 does not meet the “must be destroyed” limitation and does not infringe claim 1 of the ‘857 patent for a second reason.

Based on the foregoing, the administrative law judge determines that the M-201 would not infringe claim 1 of the ‘857 patent.

#### V. The ‘649 Patent And The ‘168 Patent

Independent claim 1 of the ‘649 patent reads:

1. A method for assembling a lens-fitted photographic film package which comprises a light-tight casing comprising a main body section having an exposure opening therein and a back cover section, a rolled film disposed on one side of said exposure opening, and a light-tight container disposed on the opposite side

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<sup>10</sup> This conclusion was reached with regard to the “must be destroyed” limitation of claim 8 of the ‘087 patent. (Id.) However, this limitation must be construed in the same manner for this patent since the ‘857 patent is a divisional of the ‘087 patent. Southwall, 54 F.3d at 1579.

of said exposure opening from said rolled film, said container having a film winding spool to which is attached one end of said rolled film, said method comprising the steps of:

winding a film withdrawn from said light-tight container in a roll in a darkroom;

loading said film in a roll and said light-tight container from which said film was withdrawn into separate receiving chambers formed in one of said sections of said light-tight casing of said lens-fitted photographic film package; and

fixing said back cover section to said main body section so as to assemble light-tightly said lens-fitting photographic film package.

(CXAP2-17.)

In the underlying investigation, the administrative law judge characterized the method of claim 1 of the '649 patent as requiring a dark room:

With this method, the free end of the film extending from a manufactured film cartridge is, while in a darkroom, wound from the cartridge into a roll. The trailing end remains attached to the spool within the cartridge. The newly formed roll, the now empty cartridge and the film extending therebetween are inserted into respective recesses in the main body section of the LFFP across the exposure opening of the LFFP. The back cover is then installed and sealed to render the entire LFFP-now loaded with unexposed film--light tight.

(ID at 166.) Significantly in the EID, he unequivocally stated that "claim 1 of the '649 patent . . . require[s] that all steps be done in a darkroom." (EID at 29.)<sup>11</sup>

CSI represented that it will use one of two methods to load film into M-201 (CPXAP2-1), *viz.* the black box method and the pancake method. (CXAP2-7 (Request for an Advisory Opinion

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<sup>11</sup> Order No. 119 precluded any testimony construing claim 1 of the '649 patent in a manner other than that previously determined by the administrative law judge and affirmed by the Commission.

dated June 17, 2003); CXAP2-2 (CSI Response to Staff Interrogatory No. 4) at 3; see also Stipulation at C.) In the EID, it was determined that:

The black box method allows the last two steps provided for in claim 1 of the '649 patent - (2) "loading said film in a roll and said light-tight container from which said film was withdrawn into separate receiving chambers formed in one of said sections of said light-tight casing of said lens-fitted photographic film package;" and (3) "fixing said back cover section to said main body section so as to assemble light-tightly said lens-fitting photographic film package" - be performed outside of a darkroom. (Tr. at 1896).

(EID FF 134 at 155.) Since the last two steps of claim 1 of the '649 patent must be performed in a darkroom, the "black box" method, as described, would not infringe claim 1 of the '649 patent because the last two steps of said method are performed outside of a darkroom. (EID at 70.)

CSI's White's description of the preferred "black box" method for loading the M-201 is the same as that described in the consolidated Enforcement and Advisory Opinion Proceedings. (JX-1, White Dep. Tr. at 51-52, 54-55.) Thus, if the M-201 is loaded with film according to the "black box" method, including the performance of the last two steps outside of a darkroom, it is found that the M-201 would not infringe claim 1 of the '649 patent.

In the EID, the pancake method was described as follows:

The process . . . consisted of: (1) cutting the desired length of film from a large roll, (2) inserting one end of the cut film into a machine that winds the film in a roll by wrapping it around a rod-like extension, (3) taking the rolled film off the machine and housing it in a light-tight plastic container (E) that will eventually be inserted in the film roll chamber of a camera (on the opposite side of the camera from the chamber that will house the film cartridge); (4) inserting the end of the film coming out of the plastic container into a spool (E'); and (5) encapsulating the film end and spool into a cartridge (F) that will store the film as pictures are taken and the film is advanced. (CPX-1424; R ACX-1)

(EID FF 133 at 155.) During the consolidated proceeding, Bellows conceded that the pancake method as described would not infringe claim 1 of the '649 patent. (EID at 67 n.34, citing

Enforcement and Advisory Opinion Tr. at 1168.) White's description of the "pancake method" during his deposition confirms that the proposed "pancake method" of loading film into the M-201 is the same as that described in the consolidated Enforcement and Advisory Opinion Proceedings. (JX-1, White Dep. Tr. at 56-59.) Moreover, White's testimony makes clear that in this method, the last two steps are performed in the daylight. (JX-1, White Dep. Tr. at 57-58.) Thus, like the "black box" method supra, an M-201 loaded with film using the preferred "pancake method" would not infringe claim 1 of the '649 patent.<sup>12</sup>

As Bellows testified during his deposition, whether the film in the M-201 to be imported into the United States is being loaded in the light or in the dark can be determined by an analysis of the film developed from a camera sample:

Q: Could an analysis of developed film reveal whether a double cassette system was loaded in a dark room or in the light?

A: With a moderately high confidence level, yes.

(JX-2, Bellows Dep. Tr. at 75.) Thus, Customs may have a method of testing whether the M-201 sought to be imported are being loaded in the manner represented by CSI.

Based on the foregoing the administrative law judge determines that M-201 would not infringe claim 1 of the '649 patent.

Independent claim 1 of the '168 patent, the only claim in issue of said patent, reads:

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<sup>12</sup> As an alternative basis for non-infringement, the "pancake method" of loading film into a camera does not include a step of "winding a film withdrawn from said light-tight container in a roll in a darkroom" as required by claim 1 of the '649 patent. Rather, the film is attached to the film cartridge as the final step in the film assembly and is never withdrawn from the cartridge. Thus, if an M-201 is loaded with film using the pancake method, then it would not infringe claim 1 of the '649 patent.

1. A lens-fitted photographic film package having at least a roll of unexposed photographic film, a taking lens, shutter means and film transporting means, said lens-fitted photographic film package comprising:

a main case section which is open at its front, said main case section mounting at least said shutter means and said film transporting means and containing light-tightly said roll of unexposed photographic film;

a front cover section which is attached to said main case section and closes said open front of said main case section to cover the majority of said taking lens and said shutter means and said film transporting means,

said front cover section being formed with at least one opening for partly receiving therein a member of one of said means, which member projects forwardly beyond surfaces of said main case section which are in contact with an inner surface of said front cover section which said front cover section is securely attached to said main case section.

(CXAP2-19.)

In the EID, the administrative law judge construed certain words in the limitation “front cover section being formed with at least one opening for partly receiving therein a member of one of said means.” (EID at 37-40.) He found that the claim element, “to cover the majority of said taking lens and said shutter means and said film transporting means,” only “requires that the front of the camera cover most of the taking lens, shutter means and film transporting means as a collective whole.” (EID at 34-35.) He further construed “opening” in its ordinary meaning, *viz.* as holes, breaches or apertures, and rejected Fuji’s proposed construction that included bulges or cowlings. (EID at 38.) Also he found that “said means” as used in this claim does not include the taking lens but is limited to the shutter means and the film transporting means. (EID at 38-39.)<sup>13</sup>

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<sup>13</sup> Order No. 119 precluded any testimony construing claim 1 of the ‘168 patent in a manner other than that previously determined by this administrative law judge and affirmed by the Commission.

The central feature at issue is the claim phrase “said front cover section being formed with at least one opening for partly receiving therein a member of one of said means” in claim 1 of the ‘168 patent. The EID found that the term “opening” in claim 1 means a “hole, breach, or aperture” and rejected Fuji’s argument that “opening” includes the bosses and bulges in the front cover. (EID at 37-38.) Further, the EID found that “said means” does not include the taking lens but rather is limited to the shutter means or the film transporting means. (EID at 38-39, 86-87.) Thus, to infringe claim 1 of the ‘168 patent, a portion of the shutter means or film transporting means must extend into a hole, breach, or aperture of the front cover of the camera. Fuji’s expert Bellows admitted in deposition that no portion of the shutter means or film transporting means of the M-201 extends into a hole in the front cover of the camera. (JX-2, Bellows Dep. Tr. at 18.) Accordingly, the M-201 is missing an element of the claim and would not infringe claim 1 of the ‘168 patent.

With regard to whether all the steps of claim 1 of the ‘649 patent must be performed in a darkroom and whether the claim terms “opening” and “said means” in claim 1 of the ‘168 patent include cowlings and bulges and the taking lens, Fuji re-asserts its claim construction arguments that were rejected by this administrative law judge and the Commission in the consolidated enforcement and advisory opinion proceedings. (CPost at 7, 28-35; EID at 29, 38-39; Commission Notice of Review-in-Part, Non-Review-in-Part, and Remand (August 7, 2002) (non-review with respect to the EID’s claim construction determinations).)

Although Fuji acknowledged that since this is an ancillary proceeding, the parties are bound by the prior determinations, it nonetheless urged this administrative law judge “to hear testimony and issue findings” under the rejected claim construction. (CPost at 6.) However,

Commission precedent is against permitting re-visiting issues that the Commission has already decided. Certain Amorphous Metal Alloys and Amorphous Metal Articles, Inv. No. 337-TA-143, Views of the Commission (Advisory Opinion Proceedings) at 11-12 (May 8, 1987); Certain Multi-Level Touch Control Lighting Switches, Inv. No. 337-TA-225, Commission Opinion at 4-5 (July 16, 1987); Certain Neodymium-Iron-Boron Magnets, Magnet Alloys and Articles Containing the Same, Inv. No. 337-TA-372, Order No. 38 (Aug. 5, 1996).

Fuji asserted that, inasmuch as the Commission's determination as to the proper construction of claim 1 of the '649 patent and claim 1 of the '168 patent is under appeal at the Federal Circuit, "for purposes of judicial efficiency," this administrative law judge should decide the advisory opinion proceeding in the alternative under Fuji's claim construction. (CPost at 3, 6.) However, the Commission, in its Order of September 3, 2003 instituting this advisory opinion proceeding, specifically stated that the IAO is "to be consistent with the Commission's findings in the underlying investigation and related proceedings." Thus, contrary to Fuji's assertion, this administrative law judge has not been given express authority "to take testimony and issue findings" under the rejected claim construction. Further, if the Federal Circuit reverses or modifies the Commission's construction of claim 1 of the '649 patent and claim 1 of the '168 patent, it will not necessarily adopt Fuji's proffered interpretation. Under such circumstances, the administrative law judge finds that engaging in fact-finding under Fuji's proposed claim construction would be counterproductive.

#### VI. The '200 Patent

Claim 25 of the '200 patent reads:

A lens-fitted photographic film unit having a preloaded photographic film on

which an image is formed through a taking lens system upon depression of a shutter release button, said film unit comprising:

a shutter mount having a flat projection projecting forward along an optical axis of said taking lens system;

a shutter opening formed in said projection on said optical axis of said taking lens system; and

a shutter blade having a claw portion and a masking portion for opening and closing said shutter opening and being swingable between a closed position and an open position, said masking portion having on a surface facing said shutter opening a recess and a semicircular rim, said rim being disposed on the side of a leading edge portion of said masking portion when said shutter blade swings from said closed position to said open position, said projection fitting in said recess when said shutter blade is in said closed position.

(CXAP2-18.)

In the consolidated Enforcement and Advisory Opinion Proceedings, this administrative law judge found:

nothing in the specification and prosecution history that indicates that a semicircular rim precisely 180 degrees is required to of [sic] prevent light from entering through the gap between the shutter blade and the shutter opening, and based on the plain meaning of 'semicircular,' he finds that a rim, approximately a half circle surrounding the leading edge of the masking portion of the shutter blade, and which prevents light from entering the gap between the shutter blade and the shutter opening, meets the semicircular limitation.

(EID at 33-34.)

In said proceedings, it was determined that:

Claim 25 of the '200 patent is directed to a lens-fitted photographic film unit which includes a shutter blade and a masking portion, said masking portion having on a surface facing the shutter opening a recess and a semicircular rim with said rim being disposed on one side of a leading edge portion of said masking portion when the shutter blade swings from a closed position to an open position.

(See EID FF 49 at 81-82 (providing language of claims 1 and 25 of the ‘200 patent).) The M-201 has a completely flat shutter blade. (Stipulation at A.) The EID determined that “the ACH Polaroid does not have a recess on the rim in which the projection on the shutter mount fits as claim 25 of the ‘200 patent requires.” (EID FF 149 at 160, citing CPX-1008.) The EID, accordingly, found that the ACH Polaroid type cameras did not infringe claim 25 of the ‘200 patent. (EID at 84-85.) Likewise, the M-201 does not have a recess on the rim in which the projection on the shutter mount fits and hence the administrative law judge determines that it would not infringe claim 25 of the ‘200 patent.<sup>14, 15</sup>

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<sup>14</sup> CSI requested that the administrative law judge award CSI its legal fees and costs to be paid by Fuji in connection with this proceeding because Fuji has abused the “Commission process.” (CSI RPost at 11-12.) However the Commission instituted the proceeding on CSI’s request and Fuji should have the opportunity, pursuant to Commission rules, to respond, once the proceeding was instituted. Moreover, CSI’s request for legal fees and costs is in essence a motion for sanctions which motion should have been filed on its own. Accordingly CSI’s request is denied.

<sup>15</sup> Fuji appears to concede that the M-201, which uses a flat shutter blade with no rim, does not infringe claim 25 of the ‘200 patent. (CPost at 2-3, 28; see also JX-2, Bellows Dep. Tr. at 64-65.)

VII. Additional Findings

1. CSI is a business entity located in Wisconsin. (EID FF 19.)
2. Fuji is a business entity based in Japan with its primary office in Tokyo and a manufacturing facility in Greenwood, South Carolina. (EID FF 1.) Fuji is the owner of the patents at issue. (ID at 1; ID FF 54.)

VIII. Conclusions of Law

1. The Commission has in rem jurisdiction and subject matter jurisdiction.
2. The M-201 (CPXAP2-1) would not infringe claim 1 of the '857 patent.
3. The M-201 (CPXAP2-1) would not infringe claim 1 of the '649 patent.
4. The M-201 (CPXAP2-1) would not infringe claim 25 of the '200 patent.
5. The M-201 (CPXAP2-1) would not infringe claim 1 of the '168 patent.
6. The M-201(CPXAP2-1) would not be covered by any general exclusion order.
7. The M-201 (CPXAP2-1) would not be covered by any cease and desist order.

IX. Order

Based on the foregoing, and the record as a whole, and having considered all of the filings, it is the administrative law judge's initial advisory opinion that M-201 (CPXAP2-1) would not infringe claim 1 of the '857 patent, claim 1 of the '649 patent, claim 25 of the '200 patent or claim 1 of the '168 patent and hence would not be covered by any general exclusion order or any cease and desist order.

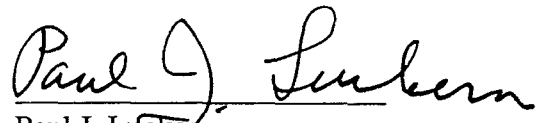
The administrative law judge hereby CERTIFIES to the Commission his IAO together with the record consisting of the exhibits admitted into evidence. The pleadings of the parties filed with the Secretary are not certified, since they are already in the Commission's possession in accordance with Commission rules.

Further it is ORDERED that:

1. In accordance with Commission rule 210.39, all material heretofore marked in camera because of business, financial, and marketing data found by the administrative law judge to be cognizable as confidential business information under Commission rule 201.6(a) is to be given in camera treatment continuing after the date this investigation is terminated.

2. Counsel for the parties shall have in the hands of the administrative law judge those portions of the IAO which contain bracketed confidential business information to be deleted from any public version of said IAO no later than February 27, 2004. Any such bracketed version shall not be served by telecopy on the administrative law judge. If no such bracketed version is received from a party it will mean that the party has no objection to removing the confidential status, in its entirety, from said IAO.

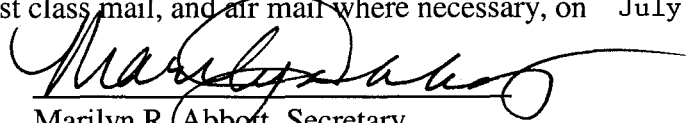
3. The IAO, pursuant to the Commission Order of September 3, 2003, shall become the Commission's advisory opinion within 45 days after service of said opinion, unless the Commission orders review of said opinion or changes the deadline for determining whether to review said opinion. Also pursuant to said Commission Order, any petition for review of the IAO may be filed within ten days after service of said opinion and responses to any such petition may be filed within five days after service of any petition for review.

  
Paul J. Luckern  
Administrative Law Judge

Issued: February 13, 2004

CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **Public Version Initial Advisory Opinion** was served by hand upon Karin J. Norton, Esq. and Rett V. Snotherly, Esq. and upon the following parties via first class mail, and air mail where necessary, on July 19, 2004



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**CERTAIN LENS-FITTED FILM PACKAGES**

**Inv. No. 337-TA-406**

**Advisory Opinion Proceedings II**

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