

**2020-1065**

**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

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AVENUE INNOVATIONS, INC.,  
*Appellant-Plaintiff,*

v.

E. MISHAN & SONS, INC.,  
*Appellee-Defendant.*

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Appeal from the United States District Court for the Southern District  
of New York in No. 1:16-cv-03086-KPF, Judge Katherine Polk Failla

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**AVENUE INNOVATIONS, INC.'S  
CORRECTED PETITION FOR PANEL REHEARING AND  
REHEARING EN BANC**

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**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF INTEREST**

**Case Number** 20-1065

**Short Case Caption** Avenue Innovations, Inc. v. E. Mishan & Sons, Inc.

**Filing Party/Entity** Avenue Innovations, Inc.

**Instructions:** Complete each section of the form. In answering items 2 and 3, be specific as to which represented entities the answers apply; lack of specificity may result in non-compliance. **Please enter only one item per box; attach additional pages as needed and check the relevant box.** Counsel must immediately file an amended Certificate of Interest if information changes. Fed. Cir. R. 47.4(b).

I certify the following information and any attached sheets are accurate and complete to the best of my knowledge.

Date: 01/06/2021

Signature: /s/ Peter J. Corcoran III

Name: Peter J. Corcoran III

<p><b>1. Represented Entities.</b> Fed. Cir. R. 47.4(a)(1).</p>	<p><b>2. Real Party in Interest.</b> Fed. Cir. R. 47.4(a)(2).</p>	<p><b>3. Parent Corporations and Stockholders.</b> Fed. Cir. R. 47.4(a)(3).</p>
<p>Provide the full names of all entities represented by undersigned counsel in this case.</p>	<p>Provide the full names of all real parties in interest for the entities. Do not list the real parties if they are the same as the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>	<p>Provide the full names of all parent corporations for the entities and all publicly held companies that own 10% or more stock in the entities.</p> <p><input checked="" type="checkbox"/> None/Not Applicable</p>
<p>Avenue Innovations, Inc.</p>		

Additional pages attached

**4. Legal Representatives.** List all law firms, partners, and associates that (a) appeared for the entities in the originating court or agency or (b) are expected to appear in this court for the entities. Do not include those who have already entered an appearance in this court. Fed. Cir. R. 47.4(a)(4).

None/Not Applicable  Additional pages attached

Noam Joseph Kritzer Bakos & Kritzer LLP	Edward Paul Bakos Bakos & Kritzer LLP	

**5. Related Cases.** Provide the case titles and numbers of any case known to be pending in this court or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. Do not include the originating case number(s) for this case. Fed. Cir. R. 47.4(a)(5). See also Fed. Cir. R. 47.5(b).

None/Not Applicable  Additional pages attached


**6. Organizational Victims and Bankruptcy Cases.** Provide any information required under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees). Fed. Cir. R. 47.4(a)(6).

None/Not Applicable  Additional pages attached


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## **RULE 35(b) STATEMENT**

1. Based on my professional judgment, I believe the panel decision is contrary to the following precedents of this Court and the U.S. Supreme Court:

A. Indefiniteness: *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014); *HZNP Medicines LLC v. Actavis Labs. UT, Inc.*, 940 F.3d 680 (Fed. Cir. 2019); *Tinnus Enterprises, LLC v. Telebrands Corp.*, 733 F. App'x 1011 (Fed. Cir. 2018); *One-E-Way, Inc. v. Int'l Trade Comm'n*, 859 F.3d 1059 (Fed. Cir. 2017); *Cox Commc'ns, Inc. v. Sprint Commc'n Co. LP*, 838 F.3d 1224 (Fed. Cir. 2016); *Dow Chem. Co. v. Nova Chemicals Corp. (Canada)*, 803 F.3d 620 (Fed. Cir. 2015); *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335 (Fed. Cir. 2015).

B. Claim construction: *Eon Corp. IP Holdings LLC v. Silver Spring Networks, Inc.*, 815 F.3d 1314 (Fed. Cir. 2016); *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

2. Based on my professional judgment, I believe this appeal requires an answer to precedent-setting questions of exceptional importance:



A. Whether this Court and a district court may ignore the Supreme Court's instructions for determining if the patent claim as a whole, not particular claim terms, read in light of the specification and the prosecution history, fail to inform with reasonable certainty those skilled in the art about the scope of the invention.

B. Whether a district court exceeds its proper role in claim construction by overruling the parties' agreed-upon construction and not considering competent and unrebutted expert testimony about how one of ordinary skill would understand the agreed-upon construction.

By: /s/ Peter J. Corcoran III  
Peter J. Corcoran III

*Counsel for Appellant-Plaintiff,  
Avenue Innovations, Inc.*

### **RULE 40(a)(2) STATEMENT**

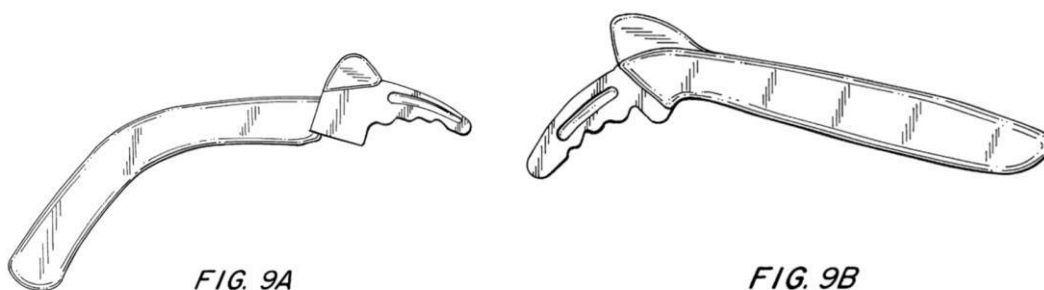
By summarily affirming, without opinion, the district court's rulings on indefiniteness and summary judgment of no infringement, this Court endorsed the district court's legal and fact-finding errors of not following Supreme Court and this Court's binding precedent when determining the indefiniteness of claims 1 and 2 in view of the term "operative position most convenient to the user," rewriting the parties' agreed-to claim construction for the term "exteriorly of the vehicle," and not providing a proper review of unrebutted expert testimony of how a person of ordinary skill in the art would apply the parties' agreed-to construction in an infringement analysis.

## BACKGROUND

### I. The Patented Invention And The Infringing Car Cane

U.S. Patent No. 6,340,189 (“the ’189 patent”) issued in 2002 (pre-AIA) to Dr. William Pordy. Appx71–86. The claimed invention of the ’189 patent put simply is a universal device that is inserted into a vehicle door striker with a handle that a person can use to push or pull on while safely entering and exiting the vehicle.

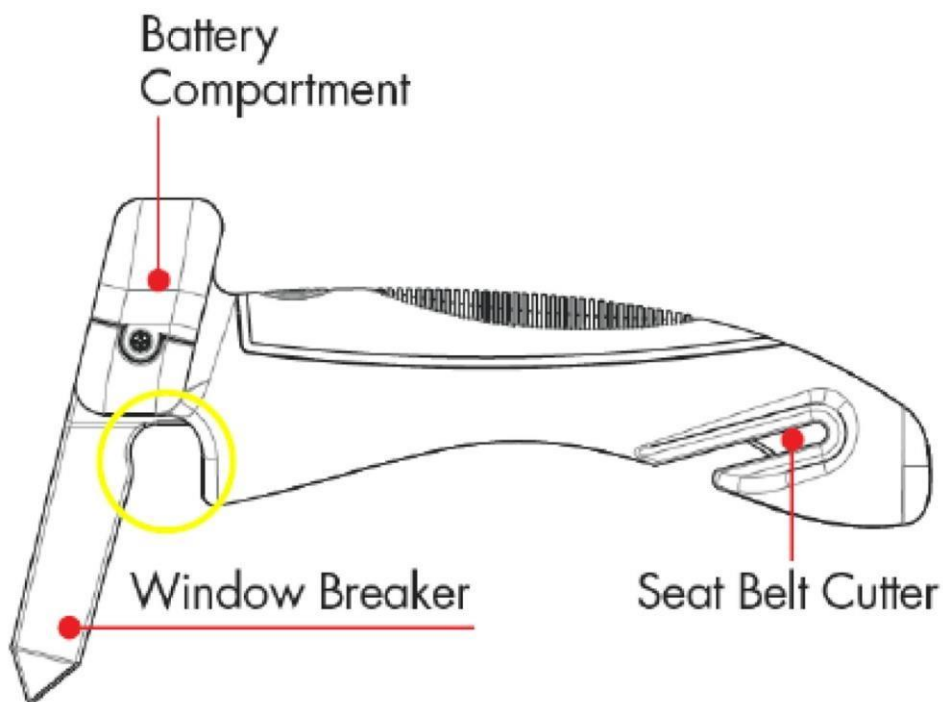
Two configurations of Dr. Pordy’s invention are shown below.



Appx77.

The device has an elongate member with a handle at one end suitable for being gripped by the passenger or driver. Appx81 (6:64–66). The other end of the elongate member has an engaging or securing member designed for inserting into and engaging or securing a vehicle’s striker. Appx81–82 (6:66–7:2). A vehicle’s striker is a U-shaped latch device that is mounted. Appx82 (7:15–19).

Appellant Avenue Innovations (“Avenue”) licensed and sold the patented invention as the “Handy Bar” and “Metro Car Handle.” Appx945. Avenue’s competitor, Appellee E. Mishan & Sons, Inc. (“Mishan”), took note of Avenue’s products and began selling its own version of the invention called the “Car Cane.” Appx1003–1004. Mishan’s Car Cane is shown below.



Appx5.

Avenue sued Mishan, and the district court ruled that claims 1 and 2 are indefinite because of the claim phrase “operative position most convenient to the user.” Appx35.

The district court also granted summary judgment of no infringement of claims 3–8 and 20. Appx1. The district court’s summary judgment ruling nominally adopted the parties’ agreed-upon construction of “exteriorly of the vehicle” as “outside the vehicle,” while at the same time invoking differing permutations of the claim language. Appx18–21. The primary infringement issue was whether the accused Car Cane’s handle is “outside the vehicle,” as required by the agreed-upon claim construction.

The district court also did not substantively address Avenue’s un rebutted expert testimony, which established that “exteriorly of the vehicle” necessarily meant outside the “cabin seal” of the vehicle. Appx20. Avenue’s expert offered a straight-forward explanation that the “cabin seal” of a vehicle “defines the separation between the interior of the vehicle and the exterior.” Appx93. In other words, “[t]he definition of ‘interior’ in the automotive industry is the passenger compartment with the dividing line defined by the cabin seal.” *Id.*

Based on that explanation, Avenue’s expert further depicted how the accused Car Cane infringes under the agreed-upon claim construction:

<p><b>Photo From Dr. Hoekstra’s Declaration Identifying Cabin Seal</b></p>	<p><b>Photo from Dr. Hoekstra’s Declaration Showing Infringing Configuration</b></p>
	
<p>Appx96.</p>	<p>Appx96.</p>

The district court’s summary judgment opinion does not substantively address Dr. Hoekstra’s declaration or his analysis. *See* Appx90–98. All the district court stated was that his declaration “does nothing to alter the Court’s claim construction (or the effect of the parties’ stipulation).” Appx20.

Mishan never disputed Dr. Hoekstra’s expertise in the field of automotive design. Nor did Mishan offer its own expert testimony to rebut Dr. Hoekstra’s sworn declaration, even though it had an expert for claim construction in the district court and for its unsuccessful IPR petition against Avenue’s patent. *See* Appx1315; Appx1796; Appx1969.

This Appeal was argued before Judges Lourie, Chen, and Stoll on November 3, 2020. On November 10, 2020, the panel affirmed the district court's judgment with a Rule 36 order. *See Addendum.*

## **II. The Panel's Rule 36 Affirmance Adopts the District Court's Rejection of Supreme Court Precedent**

Claim 1 as an exemplar of claims 1 and 2 of the '189 patent recites:

A device for facilitating movement into and out of a seat, comprising an elongate member having a handle at one end suitable for being gripped by an individual, and securement means cooperating with the other end of said elongate member for securing said elongate member to a fixed surface proximate to a seat to enable said elongate member to extend away from the seat and position said handle at a point remote from the seat during use for providing support to the user independently of whether the user pulls on said handle in a direction generally upwards or pushes on said handle in a direction generally downwards, said securement means mounting said elongate member for limited movements within a plane substantially parallel to the fixed surface to at least one *operative position most convenient to the user* when pulling or pushing on said handle.

Appx85 (col.13 ll.48–61 (emphasis added)).

In violation of the Supreme Court's vacatur and remand instructions in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014), this Court's Rule 36 affirmance of the district court's opinion and order adopts the district court's singular focus on the phrase "operative position most convenient to the user" to the exclusion of the

overwhelming remainder of the claim language of claims 1 and 2 when ruling that the claims are indefinite.

The district court begins its erroneous analysis by quoting language that the Supreme Court expressly rejected in *Nautilus*: “Indefiniteness is a matter of claim construction, and the same principles that govern claim construction are applicable to determining *whether allegedly indefinite claim language is subject to construction.*” *Praxair, Inc. v. ATMI, Inc.*, 543 F.3d 1306, 1319 (Fed. Cir. 2008) (emphasis added) (quoting *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1348 (Fed. Cir. 2005), *abrogated by Nautilus*, 572 U.S. 898). Appx41. Similarly, this Court before its vacatur and remand in the Supreme Court held, “[a] claim is indefinite only when it is ‘not amenable to construction.’” *Biosig Instruments, Inc. v. Nautilus, Inc.*, 715 F.3d 891, 898 (Fed. Cir. 2013) (citing *Datamize*, 417 F.3d at 1347).

But the Supreme Court clearly instructs that the dispositive question in an indefiniteness inquiry is whether the claim as a whole, not select claim terms, “read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable



certainty, those skilled in the art about the scope of the invention.”  
*Nautilus*, 572 U.S. at 901.

Instead, the district court, and presumably this Court with its Rule 36 affirmance, minimally analyzed the context of the patent specification and prosecution history when it held: “[T]he language of Claims 1 and 2, even when read as a whole, does little to set objective boundaries on the ‘operative position’ phrase.” Appx45. The district court further incorrectly opined that “the prosecution history does not shed light on the contours of what is meant by ‘convenient’ . . . the phrase ‘operative position most convenient to the user’ was added to overcome the patent examiner’s rejection of Claims 1 and 2 on the basis of prior art [and] there was no discussion of the definiteness of the phrase during prosecution.” Appx48.

The district court and this Court overlooked that a lengthier and much more substantive claim limitation, “*said securement means mounting said elongate member for limited movements within a plane substantially parallel to the fixed surface to at least one operative position most convenient to the user when pulling or pushing on said handle,*” was

added by amendment in response to a Non-final Office Action from the PTO. Appx335–336. Supporting the amendment, the applicant stated,

[C]laims 1 and 2 have been amended to now more fully define the device in accordance with the invention to define the securement means as mounting the elongate member for limited movements within a plane substantial[ly] parallel to the fixed surface, to . . . at least one operative position most convenient to the user when pulling or pushing on the handle. This is exemplified, for example, in Figs. 2 and 6 of this application, in which two separate operative positions are shown, and where the device is shown in two operative positions, for pushing and pulling the device, respectively.

Appx332. The district court instead focused on the phrase “operative position most convenient to the user” only, and not the claim language as a whole, when ruling that the phrase is “critical to defining the scope of the invention, and with it the boundaries of the patentee’s rights.”

Appx51.

First, by not fully considering the overall claim language and the prosecution history, the district court and this Court did not see that the phrase “operative position most convenient to the user” is only partly necessary for defining the scope of the claimed invention; the phrase is only a fraction (seven words) of the total language that was added by amendment (thirty-seven words) and an even smaller fraction of the claims as a whole (144 words for claim 1; 198 words for claim 2). Appx85.

For example, claim 22, which is similar in claim scope to claims 1 and 2, has 237 words. Appx86. The term “operative position” appears near the end of claim 22 as it does in claims 1 and 2, but the term “most convenient to the user” is omitted. Using claim 22 as an example, therefore, the panel and district court should have ruled that the term “most convenient to the user” has little to no effect on the overall claim scope of claims 1 and 2.

Second, the applicant in his remarks regarding the amendments twice focused on the claim term “operative position” as illustrated in Figures 2 and 6 of the file history. Appx332. Figures 1, 8, 9, and 10 further provide objective examples of operative positions that a user and a person of ordinary skill in the art may use when pushing or pulling on the handle. Appx72; Appx75–76; Appx78. The applicant nowhere emphasized that the claim term “most convenient to the user” was conjoined to the term “operative position,” or that it was necessary and critical for defining the scope of the invention. Appx332. Figures 1, 2, 6, 8, and 9 show that any “operative position most convenient to the user” is limited to movement of pushing or pulling on the handle while entering and exiting a vehicle. Figure 10 in particular shows that the device is

locked into place when inserted into the striker so that any “operative position most convenient to the user” is strictly limited to minimal pushing and pulling on the handle. Appx78; Appx84 (12:9–30).

Third, the term “most convenient to the user” is not used or described significantly in the specification; it is at most referenced at column 4, lines 1–4, of the specification. Appx80 (“It is still a further object of the present invention to provide a universal device of the type under consideration which can be readily and conveniently adjusted to accommodate a specific passenger, and automobile.”).

At oral argument before this Court’s panel, Judge Lourie questioned the indefiniteness of the claim term “operative position most convenient to the user” only, without asking how or if the term made all of claims 1 and 2 indefinite. Oral Argument Audio (“Oral Arg.”) at 9:05–10:20<sup>1</sup> (“Operative position most convenient to the user. That sounds indefinite. Different users have different conveniences.”). Judge Stoll correctly pointed out that the district court did not adequately address the full prosecution history surrounding the applicant’s claim

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<sup>1</sup> [http://oralarguments.cafc.uscourts.gov/Audiomp3/20-1065\\_11032020.mp3](http://oralarguments.cafc.uscourts.gov/Audiomp3/20-1065_11032020.mp3)

amendment, Appx335–336, and whether the applicant’s remarks at Appx332 shed any objective light on the definiteness of claims 1 and 2 as a whole. Oral Arg. at 20:18–26:38. Mishan admitted that it “shorthanded the limitation.” *Id.* at 32:44. Clearly the district court did too.

Judge Stoll opined that “said securement means mounting said elongate member for limited movements within a plane substantially parallel to the fixed surface to at least one operative position most convenient to the user when pulling or pushing on said handle” could reasonably mean:

You can move the elongate member (the handle the person can hold onto) within a plane. It’s only within a particular plane parallel to the fixed surface . . . So within that limited range of movement within the plane substantially parallel to the fixed surface, a user can move the elongate member to a position most convenient for him or her to push or pull while standing.

Oral Arg. at 10:23–12:47. In other words, the elongate member (or handle) when mounted (to the striker) in an operative position for a user may have limited movements (in the striker) within a plane substantially parallel to the fixed surface when pulling up or pushing down on the handle as shown in Figures 1, 2, 6, 8, 9, and 10. Judge Stoll also

questioned what effects if any the phrase “operative position most convenient to the user” would have on claims 1 and 2 because they are device claims. Oral Arg. at 31:10–31:30. Thus, functional limitations should have a minimal indefiniteness impact on device claims because device claims do not necessarily rely on functional limitations for their description.

Before the panel, Mishan argued that the district court correctly relied on this Court’s abrogated *Datamize* case when analogizing “most convenient to the user” with the term “aesthetically pleasing” at issue in *Datamize*. Oral Arg. at 27:20–28:00. Mishan specifically argued that “Appellant raises a similar argument to what this Court dismissed in *Datamize* . . . . This Court flatly rejected . . . Appellant’s argument that we must look at the claim in a fulsome manner.” *Id.* Of course, the Supreme Court in *Nautilus* specifically abrogated this Court’s analysis in *Datamize* and “flatly rejected” this Court’s not looking at claims in a “fulsome manner.” *Nautilus*, 572 U.S. at 901.

In *Datamize*, the term “aesthetically pleasing” appeared at least three times throughout the affected independent claim. 417 F.3d at 1344–45. Conversely, the term “most convenient to the user” appears a

single time only at the end of claims 1 and 2 and was not substantively relied upon to overcome the prior art. Appx332. Moreover, the claims as a whole in view of the specification and figures strictly limit an “operative position most convenient to the user” by the nature of the limited upward and downward movement of the device once it is secured in a striker. Judge Lourie himself suggested that the term “most convenient to the user . . . doesn’t seem to be quantitatively an important part of the claim.” Oral Arg. at 30:51.

This Court’s Rule 36 affirmance and the district court’s analysis and ruling directly contradict the Supreme Court’s instructions in *Nautilus*. A court’s focus must be on the *entirety of the claim language* and not on cherry-picked words and phrases that could render a whole claim indefinite, regardless of how the remaining claim language may constrain the allegedly indefinite phrase. *See, e.g., Cox Commc’ns, Inc. v. Sprint Commc’n Co. LP*, 838 F.3d 1224, 1231–32 (Fed. Cir. 2016) (“[T]he dispositive question in an indefiniteness inquiry is whether the ‘claims,’ not particular claim terms, ‘read in light of the specification delineating the patent, and the prosecution history, fail to inform, with reasonable certainty, those skilled in the art about the scope of the

invention.”) (citing *Nautilus*, 572 U.S. at 901) (emphasis added); *see also HZNP Medicines LLC v. Actavis Labs. UT, Inc.*, 940 F.3d 680, 693 (Fed. Cir. 2019) (citing *Nautilus* and stating that indefiniteness is a test for the overall claim, not individual allegedly subjective claim terms); *Tinnus Enterprises, LLC v. Telebrands Corp.*, 733 Fed. App’x 1011, 1017 (Fed. Cir. 2018) (same); *One-E-Way, Inc. v. Int’l Trade Comm’n*, 859 F.3d 1059, 1063 (Fed. Cir. 2017) (same); *Dow Chem. Co. v. Nova Chemicals Corp. (Canada)*, 803 F.3d 620, 625 (Fed. Cir. 2015) (same); *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 789 F.3d 1335, 1340 (Fed. Cir. 2015) (same).

For these reasons, this Court should grant a panel rehearing or rehearing en banc of the panel’s Rule 36 affirmance of the district court’s indefiniteness ruling.

### **III. The Affirmance Disregards the Parties’ Agreed-Upon Construction and the Expert Testimony**

This Court has held that, after a claim has been construed “with whatever specificity and precision is warranted by the language of the claim and the evidence bearing on the proper construction, the task of determining whether the construed claim reads on the accused product is for the finder of fact.” *PPG Indus. v. Guardian Indus. Corp.*, 156 F.3d 1351, 1355 (Fed. Cir. 1998). “[A] sound claim construction need not



always purge every shred of ambiguity.” *Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 806 (Fed. Cir. 2007). Indeed, “courts should not resolve questions that do not go to claim scope, but instead go to infringement.” *Eon Corp. IP Holdings LLC v. Silver Spring Networks, Inc.*, 815 F.3d 1314, 1319 (Fed. Cir. 2016) (citing *Lazare Kaplan Int’l, Inc. v. Photoscribe Techs., Inc.*, 628 F.3d 1359, 1376 (Fed. Cir. 2010))

In the present case, the panel’s affirmance enables a district court to exceed its proper role in construing claims. With this affirmance, district courts will be permitted to look past agreed-to claim constructions. The affirmance enables a district court to convert a fact dispute about an agreed-to claim construction into an opportunity to re-construe the claims or an opportunity to re-construe the claims without any consideration of unrebutted expert testimony about infringement under the agreed-to claim construction.

The question before the district court and the panel was whether a reasonable jury could find infringement based on the agreed-upon construction of “outside the vehicle.” This question should have been one for the fact-finder. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247–48 (1986); *HZNP Medicines*, 940 F.3d at 699 (Fed. Cir. 2019). Instead, the

district court found no dispute of material fact under the guise of re-constructing the claim, without any proper consideration of Avenue's un rebutted expert testimony. Appx20.

Here, at the summary judgment stage, the parties agreed that "exteriorly of the vehicle" means "outside the vehicle." Rather than apply that construction, the district court reworded the agreed construction into various verbal formulations: "beyond the car's exterior metal paneling," "beyond the exterior walls of the car," not "within the well of the car door," and not "within the exterior walls of the car." Appx18; Appx21.

Each of these permutations may have slightly different meanings, and the district court should not have tried "to purge every shred of ambiguity" from the construction to which the parties agreed. *See Acumed LLC v. Stryker Corp.*, 483 F.3d 800, 806 (Fed. Cir. 2007).

Indeed, the district court acknowledged that, under Dr. Hoekstra's industry-accepted definition of "outside the vehicle," "both the striker and the Car Cane, whether it is in the parallel or perpendicular position, are 'exterior' to the vehicle, because they are outside the passenger compartment." Appx20. But neither the district court nor the panel

explained how the summary judgment of non-infringement squares with Dr. Hoekstra's testimony. *See* Appx20. Instead, the district court simply glided past his testimony and asserted that his opinion "does nothing to alter the Court's claim construction (or the effect of the parties' stipulation) that 'outside the vehicle' is the ordinary and customary meaning of the phrase 'exteriorly of the vehicle.'" Appx20.

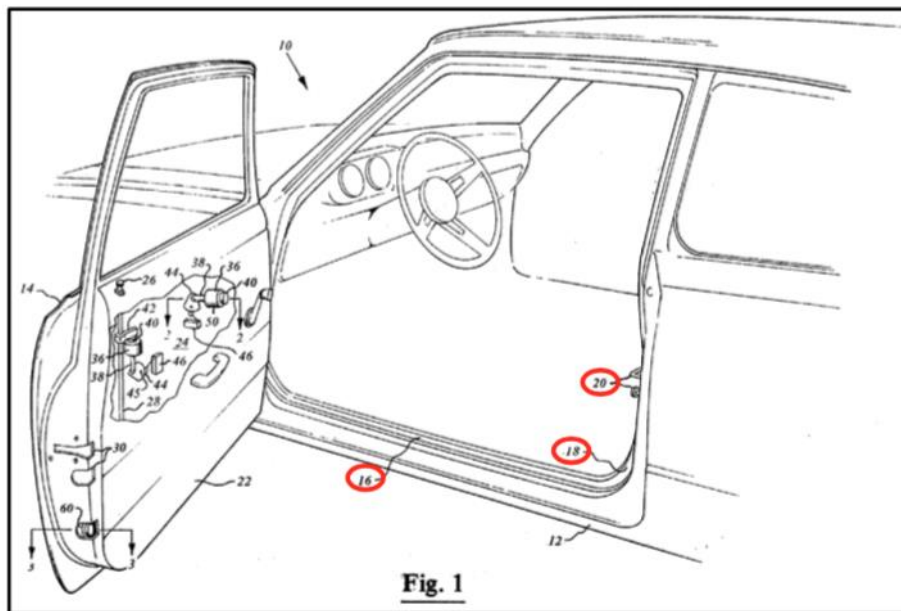
This Court has explained that "all evidence external to the patent and prosecution history, including expert and inventor testimony, dictionaries, and learned treatises," can aid and be incorporated into the district court's claim construction analysis. *Phillips v. AWH Corp.*, 415 F. 3d 1303, 1317 (Fed. Cir. 2005) (en banc) (quotation omitted). Indeed, expert testimony aids the district court in several ways, including "to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art" and "to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field." *Id.* at 1318.

Dr. Hoekstra's testimony did just that, in explaining how the term "outside the vehicle" is understood in the relevant field. Mishan has never challenged Dr. Hoekstra's testimony. Of course, a court need not

blindly adopt expert testimony. *See id.* at 1318 (explaining that a court need not adopt “conclusory, unsupported assertions” or expert testimony “clearly at odds” with the intrinsic record).

Here, Dr. Hoekstra’s declaration was far from conclusory or “clearly at odds” with the intrinsic evidence. The district court did not think so, but rather just disregarded his declaration. Dr. Hoekstra is an experienced expert in the field of automotive design, having consulted with Ford, GM, and Dodge among many more accomplishments. Appx91; Appx99–112.

The panel’s affirmance also does not account for the identified prior art supporting Avenue’s infringement analysis and expert opinion. *See* Avenue Reply Br. 13–18. The prior art—particularly when combined with the teaching of the ’189 patent and Dr. Hoekstra’s testimony—should have precluded summary judgment. For instance, Avenue noted that U.S. Patent No. 4,183,177 (“Kurdziel”) is directed to a similar device and identifies the “threshold” (“16”), as shown in the following figure.



Appx295. The threshold shown in Kurdziel is the same as the “cabin seal” identified by Dr. Hoekstra. Neither the district court nor the panel explained how this evidence permits a conclusion that there is no genuine dispute of material fact about whether the Car Cane—which is outside the cabin seal, as the district court noted—is “outside the vehicle” and thus infringing.

Further, the district court’s analysis became the functional equivalent of completely excluding the expert testimony about the meaning of “outside the vehicle,” as that term would be applied by a person of ordinary skill in the art. In this case, it was an abuse of discretion to improperly exclude expert testimony. *See Apple Inc. v.*

*Motorola, Inc.*, 757 F.3d 1286, 1314 (Fed. Cir. 2014), *overruled on other grounds by Williamson v. Citrix Online, LLC*, 792 F.3d 1339 (Fed. Cir. 2015). As this Court explained, “[a] judge must be cautious not to overstep its gatekeeping role and weigh facts, evaluate the correctness of conclusions, impose its own preferred methodology, or judge credibility, including the credibility of one expert over another.” *Id.* at 1314. “These tasks are solely reserved for the fact finder.” *Id.*

The district court’s analysis and the panel’s judgment also adds to the confusion about the role of fact-finding in claim constructions versus fact-finding in infringement determinations. *See, e.g., Teva Pharms. USA, Inc. v. Sandoz, Inc.*, 574 U.S. 318, 328–33 (2015). Here, because the parties had agreed to the construction of “exteriorly of the vehicle,” any residual imprecision in the agreed-upon construction should have been for the jury to decide based the factual testimony of Dr. Hoekstra as to whether the Car Cane is “outside the vehicle” based on his knowledge and experience in the relevant art. Mishan would have been free to offer competing factual evidence.

Instead, the district court’s analysis further obscures the already-fuzzy line between claim construction and infringement analysis. The

district court's analysis is another step towards eliminating any role for the jury, as factfinder, in patent infringement cases. It is this Court's duty and obligation to correct such missteps.

#### **IV. Conclusion**

For the foregoing reasons, this Court should grant this petition for panel rehearing or rehearing en banc.

Dated: January 6, 2021

Respectfully submitted,

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*Counsel for Appellant,  
Avenue Innovations, Inc.*

# **ADDENDUM**



NOTE: This disposition is nonprecedential.

**United States Court of Appeals  
for the Federal Circuit**

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**AVENUE INNOVATIONS, INC.,**  
*Plaintiff-Appellant*

v.

**E. MISHAN & SONS INC.,**  
*Defendant-Appellee*

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2020-1065

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Appeal from the United States District Court for the Southern District of New York in No. 1:16-cv-03086-KPF, Judge Katherine Polk Failla.

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**JUDGMENT**

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PETER JOSEPH CORCORAN, III, Corcoran IP Law PLLC, Texarkana, TX, argued for plaintiff-appellant. Also represented by MATTHEW JAMES DOWD, Dowd Scheffel PLLC, Washington, DC; EDWARD W. GOLDSTEIN, Goldstein Law, P.L.L.C., Houston, TX.

JAMES M. GLASS, Quinn Emanuel Urquhart & Sullivan, LLP, New York, NY, argued for defendant-appellee. Also represented by EDWARD J. DEFranco, JOHN THOMAS MCKEE.

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THIS CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

PER CURIAM (LOURIE, CHEN, and STOLL, *Circuit Judges*).

**AFFIRMED. See Fed. Cir. R. 36.**

ENTERED BY ORDER OF THE COURT

November 10, 2020  
Date

/s/ Peter R. Marksteiner  
Peter R. Marksteiner  
Clerk of Court

**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS**

**Case Number:** 20-1065

**Short Case Caption:** Avenue Innovations, Inc. v. E. Mishan & Sons, Inc.

**Instructions:** When computing a word, line, or page count, you may exclude any items listed as exempted under Fed. R. App. P. 5(c), Fed. R. App. P. 21(d), Fed. R. App. P. 27(d)(2), Fed. R. App. P. 32(f), or Fed. Cir. R. 32(b)(2).

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Signature: /s/ Peter J. Corcoran III

Name: Peter J. Corcoran III

**UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT**

**CERTIFICATE OF SERVICE**

**Case Number** 20-1065

**Short Case Caption** Avenue Innovations, Inc. v. E. Mishan & Sons, Inc.

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Additional pages attached.

Date: 01/06/2021

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