



**USFC2004-1609-03**

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# **JOINT APPENDIX**

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04-1609, 05-1141,-1202

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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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GOLDEN BLOUNT, INC.

Plaintiff-Appellee,

v.

ROBERT H. PETERSON CO.,

Defendant-Appellant.

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APPEAL FROM THE UNITED STATES DISTRICT COURT FOR THE  
NORTHERN DISTRICT OF TEXAS IN 3:01-CV-127-R

JUDGE JERRY BUCKMEYER

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NON-CONFIDENTIAL JOINT APPENDIX

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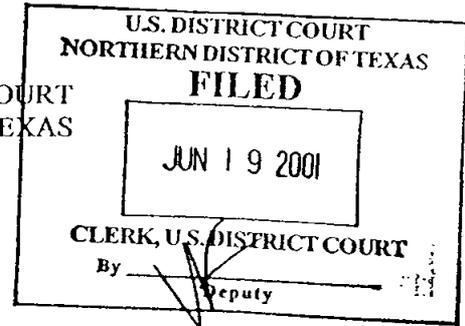
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Doc #827599

ORIGINAL

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

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Civil Action No. 3-01CV0127-R



PROTECTIVE ORDER

Upon motion of all the parties for a Protective Order pursuant to Fed. R. Civ. P. 26(c),  
It is hereby ORDERED that:

1. All Classified Information produced or exchanged in the course of this litigation shall be used solely for the purpose of preparation and trial of this litigation and for no other purpose whatsoever, and shall not be disclosed to any person except in accordance with the terms hereof.

2. "Classified Information," as used herein, means any information of any type, kind or character which is designated a "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") by any of the supplying or receiving parties, whether it be a document, information contained in a document, information revealed during a deposition, information revealed in an interrogatory answer or otherwise. In designating information as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only"), a party will make such designation only as to that information that it in good faith believes contains confidential information. Information or material which is available to the public, including catalogues, advertising materials, and the like shall not be classified.

3. "Qualified Persons," as used herein means:

(a) Attorneys of record for the parties in this litigation and employees of such attorneys to whom it is necessary that the material be shown for purposes of this litigation;

(b) Actual or potential independent technical experts or consultants, who have been designated by twenty (20) days written notice to all counsel prior to any disclosure of

Classified Information (i.e., "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information) to such person, and who have signed the undertaking attached as Exhibit A. Such signed undertaking shall be filed with the Clerk of this Court by the attorney retaining such person. If during the notice period a party objects to the disclosure of Classified Information to a particular expert or consultant, the objecting party shall set forth all such objections in writing. The objected to expert or consultant shall not receive classified information until the parties so agree or until the Court directs;

(c) The party or one (1) "in-house" corporate officer or employee of a corporate party representative (in cases where the party is a legal entity) who shall be designated in writing by the corporate party prior to any disclosure of "Confidential" information to such person and who shall sign the undertaking attached as Exhibit A. Such signed undertaking shall be filed with the Clerk of this Court by the party designating such person; and

(d) If this Court so elects, any other person may be designated as a Qualified Person by order of this Court, after notice and hearing to all parties.

4. Documents produced in this action may be designated by any party or parties as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information by marking each page of the document(s) so designated with a stamp stating "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only").

In lieu of marking the original of a document, if the original is not produced, the designating party may mark the copies that are produced or exchanged. Originals shall be preserved for inspection.

5. Information disclosed at (a) the deposition of a party or one of its present or former officers, directors, employees, agents or independent experts retained by counsel for the purpose of this litigation, or (b) the deposition of a third party (which information pertains to a party) may be designated by any party as "Confidential" or "For Counsel Only" ("or Attorneys' Eyes Only") information by indicating on the record at the deposition that the testimony is "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") and is subject to the provisions of this Order.

Any party may also designate information disclosed at such deposition as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") by notifying all of the parties in writing within thirty (30) days of receipt of the transcript of the specific pages and lines of the transcript which

should be treated as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") thereafter. Each party shall attach a copy of such written notice or notices to the face of the transcript and each copy thereof in his possession, custody or control. All deposition transcripts shall be treated as "For Counsel Only" (or "Attorneys' Eyes Only") for a period of thirty (30) days after the receipt of the transcript.

To the extent possible, the court reporter shall segregate into separate transcripts information designated as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only"), with blank, consecutively numbered pages being provided in a non-designated main transcript. The separate transcript containing "Confidential" and/or "For Counsel Only" (or "Attorneys' Eyes Only") information shall have page numbers that correspond to the blank pages in the main transcript.

6. (a) **Information designated as "For Counsel Only" (or "Attorneys' Eyes Only") shall be restricted in circulation to Qualified Persons described in Paragraphs 3(a) and (b) above.**

(b) "Confidential" information shall not be disclosed or made available by the receiving party to persons other than Qualified Persons.

(c) Copies of "For Counsel Only" (or "Attorneys' Eyes Only") information provided to a receiving party shall be maintained in the offices of outside counsel for Plaintiff(s) and Defendant(s). Any documents produced in this litigation, regardless of classification, which are provided to Qualified Persons of Paragraph 3 (b) above, shall be maintained only at the office of such Qualified Person and only working copies shall be made of any such documents. Copies of documents produced under this Protective Order may be made, or exhibits prepared by independent copy services, printers or illustrators for the purpose of this litigation.

(d) Each party's outside counsel shall maintain a log of all copies of "For Counsel Only" (or "Attorneys' Eyes Only") documents which are delivered to any one or more Qualified Person of Paragraph 3 above.

7. Documents previously produced shall be retroactively designated by notice in writing of the designated class of each document by Bates number within thirty (30) days of the entry of this order. Documents unintentionally produced without designation as "Confidential" may be retroactively designated in the same manner and shall be treated appropriately from the date written notice of the designation is provided to the receiving party. Documents to be inspected shall be treated as "For Counsel Only" (or "Attorneys' Eyes Only") during inspection. At the time of copying for the receiving parties, such inspected documents shall be stamped prominently "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") by the producing party.

8. Nothing herein shall prevent disclosure beyond the terms of this order if each party designating the information as "Confidential" or "For Counsel Only" (or Attorneys' Eyes Only) consents to such disclosure or, if the court, after notice to all affected parties, orders such disclosures. Nor shall anything herein prevent any counsel of record from utilizing "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information in the examination or cross examination of any person who is indicated on the document as being an author, source or recipient of the "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information, irrespective of which party produced such information.

9. A party shall not be obligated to challenge the propriety of a designation as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") at the time made, and a failure to do so shall not preclude a subsequent challenge thereto. In the event that any party to this litigation disagrees at any stage of these proceedings with the designation by the designating party of any information as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only"), or the designation of any person as a Qualified Person, the parties shall first try to resolve such dispute in good faith on an informal basis, such as production of redacted copies. If the dispute cannot be resolved, the objecting party may invoke this Protective Order by objecting in writing to the party who has designated the document or information as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only"). The designating party shall be required to move the Court for an order preserving the designated status of such information within fourteen (14) days of receipt of the written objection, and failure to do so shall constitute a termination of the restricted status of such item.

The parties may, by stipulation, provide for exceptions to this order and any party may seek an order of this Court modifying this Protective Order.

10. Nothing shall be designated as "For Counsel Only" (or "Attorneys' Eyes Only") information except information of the most sensitive nature, which if disclosed to persons of expertise in the area would reveal significant technical or business advantages of the producing or designating party, and which includes as a major portion subject matter which is believed to be unknown to the opposing party or parties, or any of the employees of the corporate parties. Nothing shall be regarded as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information if it is information that either:

(a) is in the public domain at the time of disclosure, as evidenced by a written document;

(b) becomes part of the public domain through no fault of the other party, as evidenced by a written document;

(c) the receiving party can show by written document that the information was in its rightful and lawful possession at the time of disclosure; or

(d) the receiving party lawfully receives such information at a later date from a third party without restriction as to disclosure, provided such third party has the right to make the disclosure to the receiving party.

11. In the event a party wishes to use any "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information in any affidavits, briefs, memoranda of law, or other papers filed in Court in this litigation, such "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information used therein shall be filed under seal with the Court.

12. The Clerk of this Court is directed to maintain under seal all documents and transcripts of deposition testimony and answers to interrogatories, admissions and other pleadings filed under seal with the Court in this litigation which have been designated, in whole or in part, as "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information by a party to this action.

13. Unless otherwise agreed to in writing by the parties or ordered by the Court, all proceedings involving or relating to documents or any other information shall be subject to the provisions of this order.

14. Within one hundred twenty (120) days after conclusion of this litigation and any appeal thereof, any document and all reproductions of documents produced by a party, in the possession of any of the persons qualified under Paragraphs 3(a) through (d) shall be returned to the producing party, except as this Court may otherwise order or to the extent such information was used as evidence at the trial. As far as the provisions of any protective orders entered in this action restrict the communication and use of the documents produced thereunder, such orders shall continue to be binding after the conclusion of this litigation, except (a) that there shall be no restriction on documents that are used as exhibits in Court unless such exhibits were filed under seal, and (b) that a party may seek the written permission of the producing party or order of the Court with respect to dissolution or modification of such protective orders.

15. This order shall not bar any attorney herein in the course of rendering advice to his client with respect to this litigation from conveying to any party client his evaluation in a general way of "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information produced or exchanged herein; provided, however that in rendering such advice and otherwise communicating with his client, the attorney shall not disclose the specific contents of any "Confidential" or "For Counsel Only" (or "Attorneys' Eyes Only") information produced by another party herein, which disclosure would be contrary to the terms of this Protective Order.

16. Any party designating any person as a Qualified Person shall have the duty to reasonably ensure that such person observes the terms of this Protective Order and shall be responsible upon breach of such duty for the failure of any such person to observe the terms of this Protective Order.

SIGNED AND ENTERED this 19 day of June 2001.

  
UNITED STATES DISTRICT JUDGE  
*Magistrate*

**MINUTE ORDER**

**UNITED STATES DISTRICT COURT NORTHERN DISTRICT OF TEXAS**

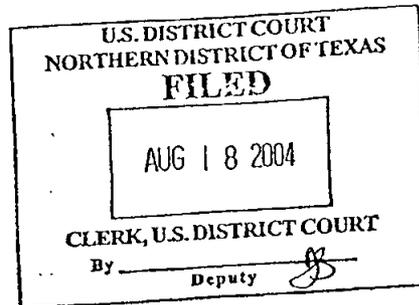
**PLACE: Dallas JUDGE: Jerry Buchmeyer DATE: August 18, 2004**

**REPORTER: Joe Belton COURTROOM DEPUTY : Tannica Stewart**

**INTERPRETER: CSO : Present COURT TIME: 2.0**

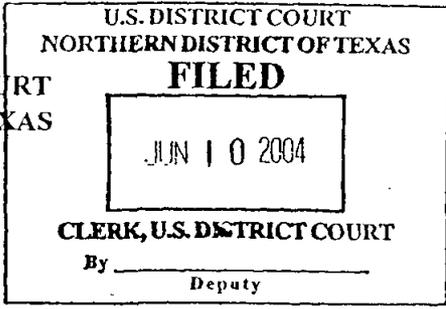
**CIVIL ACTION**

<u>TIME</u>	<u>CASE NUMBER &amp; STYLE</u>	<u>TYPE OF HEARING</u>	<u>ATTYS PRESENT</u>
10:00 a.m.	3:01-CV-127-R Golden Blount, v. Peterson	Motion Hearing	P - Charles Gaines D - Leland Hutchinson
		Dft's findings of fact and conclusions of law VACATED....Plaintiff's findings of fact and conclusions of law adopted.	
11:40 a.m.		Court adjourned	



*K Walsh*

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
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§  
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§

Civil Action No.

3-01CV0127-R

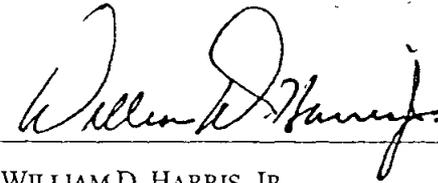
GOLDEN BLOUNT, INC.'S PROPOSED  
FINDINGS OF FACT AND CONCLUSIONS OF LAW

Pursuant to this Court's Order of May 11, 2004, directing the parties to submit proposed findings of fact and conclusions of law on the issues of literal infringement, contributory infringement, induced infringement, infringement under the doctrine of equivalents, willfulness, the exceptional nature of the case, and damages, Plaintiff, Golden Blount, Inc., submits these Proposed Findings of Fact and Conclusions of Law.

This Court did not specifically require the parties to include in its Proposed Findings of Fact and Conclusions of Law any reference to the patent-in-suit not being invalid, as well as claim construction. For completeness, however, Plaintiff has included those sections in its Proposed Findings of Fact and Conclusions of Law. In view of the Federal Circuit affirming this Court's original Findings of Fact and Conclusions of Law on those two issues, Plaintiff fully understands if this Court wishes to dispense with those sections. To facilitate the ease of removal or addition to the Proposed Findings of Fact and Conclusions of Law submitted by Plaintiff, Plaintiff is also providing this Court with an electronic copy of this document in WordPerfect format.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.

A handwritten signature in cursive script, reading "William D. Harris, Jr.", written over a horizontal line.

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ATTORNEYS FOR PLAINTIFF

JT-APP 0003

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

FINDINGS OF FACT AND CONCLUSIONS OF LAW

This Court has conducted a bench trial on plaintiff Golden Blount Inc.'s claims against defendant Robert H. Peterson for a finding of infringement of U.S. Patent No. 5,988,159 and permanent injunction, and on Peterson's counterclaims of invalidity and non-infringement. In accordance with FED. R. CIV. P. 52(a) and consistent with the Court of Appeals for the Federal Circuit's Opinion<sup>1</sup> decided April 19, 2004, the Court enters the following findings of fact and conclusions of law.<sup>2</sup>

**FINDINGS OF FACT**

1. This is an action for patent infringement. The Court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1338(a). The Court has personal jurisdiction over the parties. Venue in this judicial district is

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<sup>1</sup> While the Appellate Court held that the patent was not invalid, and that the defense of unenforceability was waived, this Court includes general reference to these elements for completeness.

<sup>2</sup> This order contains both findings of fact ("Findings") and conclusions of law ("Conclusions"). To the extent that any Findings may be deemed conclusions of law, they shall also be considered Conclusions. To the extent that any Conclusions may be deemed findings of fact, they shall also be considered Findings. See *Miller v. Fenton*, 474 U.S. 104, 113-14, 88 L. Ed. 2d 405, 106 S. Ct. 445 (1985).

proper under 28 U.S.C. § 1391.

2. Plaintiff Golden Blount, Inc. ("Blount") is a United States corporation having a principal place of business in Addison, Texas.

3. Defendant Robert H. Peterson Co. ("Peterson") is a United States corporation having its principal place of business in City of Industry, California.

4. Blount is the owner by assignment of U.S. Patent No. 5,988,159 ("the '159 patent"), entitled "Gas-Fired Artificial Logs and Coals-Burner Assembly," which issued on November 23, 1999. The '159 patent expires on November 23, 2016.

5. Blount filed this suit for infringement of the '159 patent under 35 U.S.C. §§ 271(a) to 271 (c) on January 18, 2001.

6. On March 19, 2001, Peterson filed its Answer and Counterclaim. Peterson denied infringement and asserted counterclaims for noninfringement and invalidity of the '159 patent.

7. A bench trial, by agreement of the parties, commenced on July 29, 2002, and ended on July 31, 2002.

8. Claims 1, 2, 5, 7-9, 11-13 and 15-17 are at issue in this case. Claims 1 and 17 are independent claims. All the other claims at issue are dependent on claim 1.

9. Claim 1 of the '159 patent reads as follows:

A gas-fired artificial logs and coals-burner assembly for fireplace comprising:  
an elongated primary burner tube including a plurality of gas discharge ports;  
a secondary coals burner elongated tube positioned forwardly of the primary burner tube;

a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube;

the secondary coals burner elongated tube including a plurality of gas discharge ports;

the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary

elongated coals burner tube is fed through the primary burner tube and the tubular connection means;

a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and

the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.

10. Claim 2 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the support means for the primary burner tube is comprised of an open frame pan for supporting the primary burner tube in an elevated position relative to the fireplace floor.

11. Claim 5 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is substantially parallel to the primary burner tube and has a smaller inside diameter than the primary burner tube with the valve adjusting gas flow for coals burn and forwarding heat radiation from the fireplace.

12. Claim 7 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the elongated primary burner tube and the secondary coals burner elongated tube are spaced apart on different planes at from about four to about eight inches.

13. Claim 8 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is of a smaller diameter than the primary burner tube which allows for a lower profile of coals and sand coverage.

14. Claim 9 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube.

15. Claim 11 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary and secondary burner tubes have apertures of from about 1/32 inch to about 1/8 inch.

16. Claim 12 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the gas flow adjustment valve has a removable handle, the gas flow adjustment allowing a variety of settings from full closed to full open.

17. Claim 13 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the connection means is comprised of a connector attached to the terminal end of the primary burner tube at a first end of a connector and attached to the secondary coals burner elongated tube to a connector second end with the valve interposed between the primary burner tube and the secondary burner tube.

18. Claim 15 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open frame pan and primary elongated burner tube is positioned under an artificial logs and grate support means.

19. Claim 16 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary elongated burner tube is covered with sand and the secondary elongated burner tube is covered with sand, mica, and fibrous materials which simulate coals and ember burn.

20. Claim 17 of the '159 patent reads as follows:

A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:

a secondary coals burning elongated tube;

a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube being in gas flow communication with the primary burner tube being the connection means, a gas distribution ports of the secondary burner tube directed away from the fireplace opening.

21. At the time the patent issued, Blount's commercial structure under the '159 patent had been marketed for approximately six years. (Trial Transcript, hereafter referred to as "Tr.", vol. 1, pg. 158). Plaintiff's Trial Exhibit 9 gives an element by element comparison of Peterson's manufactured product and Blount's commercial structure with both structures compared to the claim elements, and thus establishes that Blount's manufactured product is representative of the '159 patent.

22. Blount's sales of its commercial structure grew significantly during the time spanning the filing of the

application that resulted in the '159 patent and the issuance of the '159 patent. (Tr., vol. 1, pg. 36-37).

23. In late 1996 or early 1997, Peterson began manufacturing, advertising and selling a device that was strikingly similar to, if not a virtual copy of, Blount's commercial structure. (Tr., vol. 2, pg. 76 and pg. 172).

24. Blount's '159 patent issued on November 23, 1999. (Plaintiff's Ex. No. 1).

25. Blount notified Peterson of the existence of the '159 patent and Peterson's infringing activities on December 16, 1999, using a certified letter postmarked December 10, 1999, from Mr. Dan Tucker (attorney for Blount) to Peterson's president, Mr. Leslie Bortz. (Plaintiff's Ex. No. 10).

26. This first certified letter included a copy of the '159 patent, and informed Peterson that Blount was prepared to take whatever steps were reasonable and necessary to prevent infringement. Blount requested a response regarding this matter from Peterson by January 14, 2000. (Plaintiff's Ex. No. 10).

27. On December 17, 1999, Mr. Tod Corrin (Peterson's Vice President) forwarded the December 10, 1999, certified letter onto Peterson's patent counsel, Mr. William McLaughlin. Mr. Corrin wrote, in a cover letter included with the copy of the first certified letter, "[e]nclosed is a *patent infringement* letter we received from Golden Blount's Attorney." (Plaintiff's Ex. No. 17, emphasis added).

28. On December 30, 1999, Peterson responded to Blount's letter of December 10, 1999, explaining that Peterson had forwarded the December 10, 1999, letter to its attorneys and that Peterson would get back with Blount as soon as possible. Given the December Holidays, as well as the New Year, Peterson informed Blount that Blount's January 14, 2000, response date was unreasonable. (Plaintiff's Ex. No. 11).

29. After receiving no response from Peterson for more than four months, Blount sent a second certified letter to Peterson on May 3, 2000, again informing Peterson of its patent infringement. The May 3, 2000, letter advised Peterson that Blount "will take [the] necessary steps to stop any such *infringement*." (Plaintiff's Ex. No. 12, emphasis added).

30. Peterson, not its Patent Attorney, responded to the May 3, 2000, letter on May 16, 2000, asking that Blount explain to Peterson, in detail, the basis upon which Blount believed that Peterson was infringing the patent. (Plaintiff's Ex. No. 13). This Court finds that the May 3, 2000, letter was written simply for the purpose of delay, or even with the hope that the infringement matter would go away. Moreover, the May 3, 2000, letter was from the Company, and not their attorney. Additionally, at the time of the May

3, 2000, letter Peterson's attorney had at most been nominally consulted. This Court concludes that the request was not genuine.

31. Blount did not respond to Peterson's May 16, 2000, but on January 18, 2001, over a year after Peterson received its first notice of infringement letter, Blount filed suit. (Plaintiff's Ex. No. 14). Blount's initial notice letter of December 10, 2001, met the notice requirements under 35 U.S.C. § 287(a), and therefore, Peterson's additional information request did not relieve Peterson of its obligation to determine if it was infringing the '159 patent.

32. Blount sent a final letter on January 19, 2001, to Peterson advising Peterson that suit was brought in view of its failure to respond or indicate in any manner its intentions with respect to its infringing product. (Plaintiff's Ex. No. 14).

33. Peterson made no efforts to cease its infringing activities either in the time period spanning the December 10, 1999, letter and the January 19, 2001, letter, or for that matter, up and until the commencement of this trial. (Plaintiff's Ex. No. 17 & Updated Sales Figures provided by Peterson in response to this Court's request).

34. During the period between December 16, 1999, and September 19, 2002, Peterson sold 3,723 ember flame burner units ("ember burners"). (Tr., vol. 2, pg. 181 and Peterson Company's Objection to Golden Blount's Motion for Updated Damages filed on September 18, 2002).

35. Peterson's ember burner is intended to be attached to its G-4 series burner system or G-5 series burner system. (Joint Pretrial Order--Stipulations, pg. 6).

36. The G-4 and G-5 series burner systems are identical except that Peterson pre-assembles the G-5 burner system according to certain Canadian Gas Association specifications. (Tr., vol. 2, pg. 179).

37. At least 10 of the 3,723 Ember burners sold by Peterson were included on the pre-assembled G-5 series burner systems. (Oct. 5, 2001, deposition of Mr. Leslie Bortz, pg. 154-55).

#### LITERAL INFRINGEMENT-DIRECT

38. The construction of the claims appears under paragraphs 113 thru 116 of the Conclusions of Law section. The determination of infringement based on the construed claims is factual and is therefore organized here under the Findings of Fact.

39. The analysis with respect to the literal infringement of claim 1 is as follows:

The first element of claim 1 reads: “an elongated primary burner tube including a plurality of gas discharge ports.” Based upon the totality of the evidence, including unrebutted testimony of Mr. Golden Blount and this Court’s own observations of the accused device, it is this Court’s finding that the primary burner tube is the fundamental burner tube used in a majority of all gas operated fireplaces. Similarly, the plurality of gas discharge ports allow the flammable gas to escape from the primary burner tube and be ignited to provide a flame. Blount presented unrebutted testimony in the form of an infringement chart<sup>3</sup>, (Plaintiff’s Exhibit No. 9), as well as oral testimony by Mr. Blount that Peterson’s manufactured products include a primary burner tube having gas discharge ports therein. (Tr., vol. 1, pg. 45-50). In addition to this unrebutted testimony, this Court had the opportunity to closely observe an assembled version of Peterson’s manufactured product, wherein this Court observed Peterson’s manufactured product having the primary burner tube including two or more gas discharge ports. (Tr., vol. 2, pg. 28). Further, Peterson never presented any evidence that its manufactured products did not contain the aforementioned claimed element. Thus, Peterson’s manufactured products meet the first limitation of claim 1, which reads: “an elongated primary burner tube including a plurality of gas discharge ports.”

40. The second element of claim 1 reads: “a secondary coals burner elongated tube positioned forwardly of the primary burner tube.” Given the claim interpretation as set forth by the Court of Appeals for the Federal Circuit and based upon the totality of the evidence, the secondary coals burner elongated tube is positioned toward the opening of the fireplace, at least as compared to the primary burner tube, and is designed to provide a realistic flame, likened to a flame that might emanate from burning coals. Blount again presented testimony in the form of an infringement chart, (Plaintiff’s Exhibit No. 9), as well as oral testimony by Mr. Blount, that Peterson’s manufactured products include a secondary coals burner elongated tube, and that it is positioned forwardly of the primary burner tube. (Tr., vol. 1, pg. 45-50). Based on this Court’s close observation of Peterson’s manufactured product, this Court finds that Peterson’s manufactured products contain the claimed secondary coals burner elongated tube and that it was positioned forwardly the primary burner tube. (Tr., vol. 2, pg. 28). Further, Peterson never presented

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<sup>3</sup> This Court includes, as a supporting Exhibit A to its Findings and Conclusions, an Infringement Chart. (Plaintiff’s Ex. No. 9).

evidence that conclusively established that its manufactured products did not contain the aforementioned claimed element. Thus, Peterson's manufactured products meet the second limitation of claim 1, which reads: "a secondary coals burner elongated tube positioned forwardly of the primary burner tube."

41. The third element of claim 1 reads: "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position[ed] secondary coals burner elongated tube." The previous two paragraphs already demonstrate that Peterson's manufactured products include both the elongated primary burner tube and the forwardly positioned secondary coals burner elongated tube. The only additional limitation added by this element is that a support means holds the elongated primary burner tube in a raised level relative to the secondary coals burner elongated tube. Peterson's manufactured products include a support means that holds the primary burner tube. Actually, Peterson's support means, which is an industry standard pan, is substantially identical if not completely identical, in shape and function to the support means illustrated in the '159 patent. (Tr., vol. 1, pg. 47). The question for this Court to rule on is whether Peterson's support means holds Peterson's elongated primary burner tube in a raised level relative to its secondary coals burner elongated tube. As affirmed by the Court of Appeal for the Federal Circuit, this Court construes the term "raised level" to mean that the top of the primary burner tube is at a raised level with respect to the top of the secondary burner tube. In support of the tops test, Blount offered evidence in the form of Blount's Trial Exhibit 22, which illustrated that measurements taken at three different locations along the lengths of Peterson's burner tubes (i.e., A, B and C) established that the tops of Peterson's primary burner tubes are higher than the tops of Peterson's secondary coals burner elongated tubes. Blount offered further testimony by demonstrating, using a carpenter's level laid across the tops of the tubes of Peterson's manufactured product, that Peterson's primary burner was raised with respect to its secondary burner. (Tr., vol. 2, pg. 28). Even Peterson's own patent attorney, Mr. McLaughlin, admitted during the demonstration that "assuming the table is level, the top of the front burner is below the top of the rear burner." (Tr., vol. 2, pg. 29). Also Peterson's executive Mr. Bortz admitted the top of the ember burner was lower than the top of the primary burner. (Tr., vol. 2, pg. 42). Similarly, Mr. Corrin testified that the tube is below the top of the main burner tube. (Tr., vol. 2, pg. 173 and Defendant's Ex. No. 8). The above evidence was, for the most part, unrebutted because Peterson based the majority of its case in chief on the argument that the relative height of the primary burner tube with respect to the

secondary coals burner elongated tube should be measured from the bottoms of the respective tubes, or the ports. Peterson actually offered to this Court, (Defendant's Exhibit 30), which it argued was provided to customers and installers to illustrate how to properly install the assembly. While Defendant's Exhibit 30 was offered in an attempt to establish non-infringement based upon Peterson's asserted bottoms test that Peterson was proposing, the instructions clearly illustrate that Peterson's preferred installation has the tops of the primary burner tube being in a raised level with respect to the tops of the secondary coals burner elongated tube. Thus, given the above discussed interpretation, and in view of the evidence presented, Peterson's manufactured products meet the third limitation of claim 1, which reads: "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position[ed] secondary coals burner elongated tube."

42. The fourth element of claim 1 reads: "the secondary coals burner elongated tube including a plurality of gas discharge ports." Blount again presented testimony in the form of an infringement chart, (Plaintiff's Exhibit No. 9), as well as oral testimony by Mr. Blount that the secondary coals burner elongated tube of Peterson's manufactured products include a plurality of gas discharge ports. (Tr., vol. 1, pg. 45-50). Further, this Court's close observation of Peterson's manufactured product established that Peterson's secondary coals burner elongated tube includes a plurality of gas discharge ports. (Tr., vol. 2, pg. 28). Peterson never presented any evidence that its manufactured products did not contain the aforementioned claimed element. Thus, Peterson's manufactured products meet the fourth limitation of claim 1, which reads: "the secondary coals burner elongated tube including a plurality of gas discharge ports."

43. The fifth element of claim 1 reads: "the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means." Blount presented testimony in the form of an infringement chart, (Plaintiff's Exhibit No. 9), as well as oral testimony by Mr. Blount, that Peterson's manufactured products include the tubular connection means and that the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and tubular connection means. (Tr., vol. 1, pg. 45-50). Additionally, this Court physically observed this claimed element in Peterson's manufactured product. (Tr., vol. 2, pg. 28). Further, Peterson never presented any evidence that its manufactured products did not contain the aforementioned claimed element.

Thus, Peterson's manufactured products meet the fifth limitation of claim 1, which reads: "the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means."

44. The sixth element of claim 1 reads: "a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means." The evidence as established by Blount's infringement chart, (Plaintiff's Exhibit No. 9), as well as oral testimony by Mr. Blount and this Court's own inspection of Peterson's manufactured product, confirms the presence of the valve. (Tr., vol. 1, pg. 45-50 and vol. 2, pg. 28). Further, Peterson never presented any evidence that its manufactured products did not contain the aforementioned claimed element. Thus, Peterson's manufactured products meets the sixth limitation of claim 1, which reads: "a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means."

45. The seventh element of claim 1 reads: "the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube." Blount again presented testimony in the form of an infringement chart, (Plaintiff's Exhibit No. 9), as well as oral testimony by Mr. Blount that the primary burner tube of Peterson's manufactured products would ultimately be coupled to a gas source with a gas flow control means therein for controlling gas flow into the primary burner tube. (Tr., vol. 1, pg. 45-50). Furthermore, the parties stipulated prior to the commencement of the trial that "Robert H. Peterson Co.'s ember burner is intended to be attached to its G-4 series burner system or G-5 series burner system and the combined unit comprises a primary burner pipe, an ember pan that supports the primary burner pipe, a secondary burner tube and a valve that controls a flow of gas between the primary burner pipe and the secondary burner tube, and that an end user *would* connect the primary burner pipe to a gas source having a valve associated therewith." (Joint Pretrial Order--Stipulations, pg. 6). Thus, Peterson's manufactured products would ultimately meet the seventh limitation of claim 1, which reads: "the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube."

46. This Court finds that the evidence establishes direct infringement by Peterson and by the ultimate purchasers of Peterson's products of claim 1. Peterson's direct infringement of claim 1 is established by

the testimony of Messrs. Bortz and Corrin, both corporate officers of Peterson, who testified that on multiple occasions, Peterson assembled and operated the infringing device for distributors so they had the opportunity to see how the item worked. (Tr., vol. 2, pg. 65-66 and 199). Direct infringement by the ultimate purchasers of claim 1 is established by the evidence that proves that Peterson supplied installation instructions (see infra), (Defendant's Ex. No. 30), to its ultimate purchasers. It is these instructions that undoubtedly were used by these purchasers to assemble the ember burner, its associated components, and connect it to a gas source as stipulated by the parties. (Tr., vol. 1, pg. 45-50). These facts provide this Court with sufficient evidence to find that direct infringement did indeed occur of claim 1.

47. Therefore, Blount has clearly established direct infringement on the part of Peterson and the ultimate purchaser of claim 1 the '159 patent.

48. This Court further concludes that in addition to directly infringing independent claim 1 of the '159 patent, Peterson and the ultimate purchasers directly infringe independent claim 17 of the '159 patent.

49. With the exception of a few additional elements included in independent claim 17 not included in independent claim 1, and a few elements included within independent claim 1 that are not included within independent claim 17, claims 1 and 17 are substantially similar.

50. Independent claim 17 does not include the claim limitation of independent claim 1 that the primary burner is in communication with a gas flow control means. Thus, this element need not be found in Peterson's manufactured products to find direct infringement by Peterson of independent claim 17.

51. The first element of independent claim 17 recites: "a secondary coals burning elongated tube," and is similar to the fourth element of independent claim 1. Accordingly, the discussion above with respect to the fourth element of independent claim 1 may be applied to the first element of independent claim 17. Thus, Peterson's manufactured products will ultimately meet the first limitation of claim 17, which reads: "a secondary coals burning elongated tube."

52. The second element of independent claim 17 recites: "a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube being in gas flow

communication with the primary burner tube being the connection means, gas distribution ports of the secondary burner tube directed away from the fireplace opening.”

53. Independent claim 17, however, does require that the gas distribution ports of the secondary burner tube be directed away from the fireplace opening. As affirmed by the Court of Appeals for the Federal Circuit, this Court previously construed the term “directed away from” to mean that the gas ports of the secondary burner tube may be positioned in any direction that does not include a horizontal component pointed toward the vertical plane of the fireplace opening. (Opinion of the Court of Appeals for the Federal Circuit dated April 19, 2004, pg. 7-8). Blount presented testimony in the form of an infringement chart, (Plaintiff’s Ex. No. 9), as well as oral testimony by Mr. Blount, that the gas ports of Peterson’s manufactured products are positioned directly down, which according to the above-referenced interpretation, are away from the fireplace opening. (Tr., vol. 1, pg. 45-50). In addition to this testimony, this Court closely observed an assembled version of Peterson’s manufactured product, wherein it observed the manufactured product having the gas ports directed away from the fireplace opening. (Tr., vol. 2, pg. 28). Because Peterson believed the term “directed away from” would ultimately be construed to mean that the ports must be directed at least partially toward the back of the fireplace, Peterson went so far as to require the ports of its secondary burner tube to be positioned directly downward. Given the claim construction, however, this required configuration results in a device that meets the “directed away from” limitation of claim 17.

54. As the other claimed elements of the second limitation of independent claim 17 have been found in Peterson’s manufactured products, as established above with respect to paragraphs 39 thru 44, this Court finds that the evidence establishes direct infringement by Peterson and by the ultimate purchasers of Peterson’s products of claim 17. Moreover, the evidence establishes that Peterson itself directly infringed claim 17 when Peterson assembled the G-5 series burner systems and then sold them to customers.

55. Therefore, this Court finds that Peterson and the ultimate purchaser infringed both claims 1 and 17, as construed under paragraphs 113 thru 116 below, of the ‘159 patent.

LITERAL INFRINGEMENT-CONTRIBUTORY

56. Blount established at trial, through stipulation, that Robert H. Peterson Co.'s ember burner is intended to be attached to its G-4 series burner system or G-5 series burner system and the combined unit comprises a primary burner pipe, an ember pan that supports the primary burner pipe, a secondary burner tube and a valve that controls a flow of gas between the primary burner pipe and the secondary burner tube, and that an end user would connect the primary burner pipe to a gas source having a valve associated therewith. (Joint Pretrial Order--Stipulations, pg. 6).

57. Peterson was made aware of the '159 patent as early as December 16, 1999, by the letter from Mr. Tucker, which is referenced above. (Plaintiff's Ex. No. 10). Given these facts, it is clear that Peterson was aware that the combination for which its components were especially made was patented and infringing, as required by 35 U.S.C. § 271(c).

58. Blount further established through the testimony of Mr. Bortz that Peterson's ember burner had no substantially non-infringing uses. (Tr., vol. 2, pg. 67). The Court also finds the testimony of Mr. Bortz and Mr. Corrin, as well as Mr. Blount and all the evidence, to support the fact that the ember burner was not a staple article of commerce.

59. As discussed above, this Court finds that direct infringement existed. For those units covered by stipulation for hookup, they were normally hooked up by professional installers or persons from the dealer. With their experience and relation to Peterson and with all of Peterson's literature (including Defendant's Exhibit No. 30) one can count on proper installations. Thus, each installation is a direct infringement. (Tr., vol. 2, pg. 189). To some extent circumstantial evidence is involved in this analysis, however, the circumstantial evidence is very solid. Blount has clearly proven contributory infringement on the part of Peterson of claims 1 and 17 for those units.

LITERAL INFRINGEMENT-INDUCEMENT

60. The record establishes that Peterson sold the ember burner. In addition, the record also establishes that Peterson sold the G-4, which includes the primary burner and support pan, and sold the G-5, ten at least of which, had the ember burner attached. Further, given the stipulation that the ultimate assembly would be connected to a gas source, there is sufficient basis to conclude that Peterson knew or should have

known that this ultimate configuration would infringe independent claims 1 and 17. (Joint Pretrial Order--Stipulations, pg. 6).

61. Peterson was made aware of the '159 patent as early as December 16, 1999, by the letter of December 10, 1999, from Mr. Tucker, which is referenced above. (Plaintiff's Ex. No. 10). Given these facts, it is clear that Peterson was aware that the combination for which its components were especially made was patented and infringing. Also Peterson fully assembled an entire infringing structure and hooked it up to a gas source to demonstrate it and its use to independent distributors. This Court finds this to be a substantial inducement.

62. The record is also clear that Peterson provided literature and assembly instructions to consumers detailing how to install the components in a preferred configuration, which induced its customers to install the components in an infringing manner. (Tr., vol. 2, pg. 173-174). Also, Peterson fully assembled and hooked up in a fireplace an accused structure and demonstrated it and its use to independent distributors, which this Court finds to be a substantial inducement.

63. Because Peterson provided the consumers with detailed instructions, (Defendant's Ex. 30), how to assemble the parts in an infringing manner, Peterson knew or should have known that such actions would induce direct infringement, and executive Corrin testified either the consumer would hire an installer or the dealer would provide the service for the store. Thus there is little doubt that the installation was in fact done in accordance with Peterson's directions. Invariably, infringement occurred. Whether this is viewed as direct or circumstantial evidence, it is very strong. (Tr., vol. 2, pg. 189).

64. As found by this Court in paragraphs 39 thru 54 above, there was direct infringement by Peterson or its ultimate purchasers of claims 1 and 17 of the '159 patent.

65. Accordingly, this Court finds that in those instances where direct infringement by Peterson was not proven, Blount has clearly proven induced infringement on the part of Peterson of claims 1 and 17 for those units.

66. In view of this Court's literal infringement findings, because Peterson's manufactured products literally infringe claims 1 and 17 of the '159 patent, it infringes the patent. Thus, comparison of Peterson's product to the remaining claims depending from independent claim 1 is generally unnecessary. The Court nonetheless concludes that Peterson's product infringes (under any one of or the combination of 35 U.S.C.

§§ 271(a) to 271(c)) the claims dependent on claim 1, because, as supported by the testimony of Blount and the accompanying claim infringement chart, the elements of these dependent claims are also present in Peterson's manufactured products. The literal infringement of dependent Claim 15 is particularly important because Claim 15 includes the artificial logs and the grate support means.

#### INFRINGEMENT-DOCTRINE OF EQUIVALENTS

67. Blount offered unrebutted testimony at trial that every element of Peterson's manufactured products perform substantially the same function in substantially the same way to obtain the same result as the claimed elements of the '159 patent. (Tr., vol. 1, pg. 59-60).

68. Blount further offered unrebutted testimony by Mr. Blount at trial that any difference between Peterson's manufactured products and the claim elements were insubstantial at best. Mr. Blount actually testified that they were an exact copy. (Tr., vol. 1, pg. 30, 37, 46, 48, 56 and 60).

69. Based on the evidence presented to it, this Court finds that there is no prosecution history estoppel that limits the range of equivalents regarding the claimed elements. Moreover, attorney McLaughlin testified that he did not rely on estoppel in his infringement analysis. (Tr., vol. 1, pg. 186).

70. Thus, this Court finds that in those instances where literal infringement does not exist, there is infringement of the claims of the '159 patent under the doctrine of equivalence.<sup>4</sup>

71. In summation, this Court concludes that Peterson literally infringes (e.g., directly, by inducement, or contributorily) or infringes under the doctrine of equivalents independent claims 1 and 17 of the '159 patent, as well as claims 2, 5, 7-9, 11-13 and 15-16 that depend from independent claim 1.

#### DAMAGES

72. Mr. Blount testified for Blount at trial as to the demand that existed for the product during the period in question. (Tr., vol. 1, pg. 61). Thus, Blount has conclusively established the first required element of *Panduit*.<sup>5</sup>

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<sup>4</sup> The Equivalence Chart presented by Blount at trial supports this finding.

<sup>5</sup> See the Conclusions of Law section, paragraph 139, where the *Panduit* factors are set forth.

73. In addition to establishing a demand for the patented product during the period in question, Blount established an absence, during the period of infringement, of acceptable non-infringing substitutes. (Tr., vol. 1, pg. 63-65).

74. The facts of the present case establish a two-supplier market. Blount offered evidence through the testimony of Mr. Blount that Blount and Peterson together held approximately 95 percent or more of the market associated with Ember burners similar to that covered by the '159 patent. (Tr., vol. 1, pg. 64). While Peterson attempted to impeach Mr. Blount's testimony on this point, it unfortunately did not present any evidence to the contrary, which is surprising in view of Peterson's many years in the market and the knowledge Peterson must have acquired about the market. Therefore, this Court finds that Mr. Blount's testimony is sufficient to establish a two supplier market. The supposed 5 percent of the market that Blount and Peterson did not hold is de minimus, and therefore, for damage calculations a two-supplier market still exists.

75. Peterson argued that this is not a two-supplier market, and that other acceptable non-infringing substitutes exist.

76. Here the patented product offers quite unique and novel results. (Tr., vol. 1, pg. 28-30). The so called "acceptable non-infringing substitutes" Peterson has introduced are either not acceptable, or they too infringe.

77. Blount established at trial that Peterson's front flame director was not an acceptable substitute. (Tr., vol. 2, pgs. 184, 195). Peterson's own Vice President, Mr. Corrin, testified that the front flame director lacked the valve for adjusting the height of the front flame. Even more telling, Mr. Corrin testified that the front flame director was not as good as their ember burner. (Tr., vol. 2, pgs. 184, 195).

78. As the valve to adjust the height of the front flame is one of the particular features available only from the patented product, under the law set forth in *Standard Havens*, the front flame director, lacking that valve or any adjustment means, is not an acceptable non-infringing substitute.

79. Peterson further argues that Blount admitted at trial that at least five products on the market perform roughly the same function as Blount's patented device. (Tr., vol. 1, pg. 63). The record is clear that those five products were infringing substitutes and not acceptable non-infringing substitutes. (Tr., vol. 1, pg. 63). In fact, the record indicates that Blount sent the manufactures of those five products the identical notice of

infringement letter at the same time it sent Peterson its letter. (Tr., vol. 1, pg. 63). No evidence exists in the record that the aforementioned five instances of infringement continued after the notice of infringement letters were received. In fact, Mr. Blount's testimony indicates that while the other companies were moving in and were interested in the outcome of this trial, none were still infringing after receipt of their notice of infringement letter. (Tr., vol. 1, pg. 62-64).

80. Therefore, this Court believes that Blount provided sufficient evidence to support the finding that there were no acceptable non-infringing substitutes that could have decreased the market share Blount and Peterson together held. Thus, Blount has conclusively established the second required element of *Panduit*.

81. Blount also offered sufficient evidence through Mr. Blount's testimony that Blount had more than enough manufacturing and marketing capability to promote the device. (Tr., vol. 1, pgs. 62, 66). Thus, Blount has conclusively established the third required element of *Panduit*.

82. This Court now only needs to determine a detailed computation of the amount of profit Blount would have made, to meet the final required element of *Panduit*.

83. In a two-supplier market, to determine the actual damage amount in a lost profit case, the Court should multiply Blount's per unit profit times the number of infringing devices that Peterson sold.

84. To do this, however, the Court must determine the device upon which lost profits are to be calculated.

85. Using two different approaches, Blount has established that the device for calculating lost profits includes the entire burner assembly (including the secondary burner and valve), the grate, and a full set of artificial logs.

86. Dependent claim 15, which was established as literally infringed above, for instance recites that the gas-fired artificial logs and coals-burner of claim 1 are positioned under artificial logs and a grate support means. Because the artificial logs and the grate support means are positively claimed in dependent claim 15, the artificial logs and the grate support means should be included in the device upon which damages for direct infringement as well as lost profits are to be calculated.

87. Accordingly, the device for calculating lost profits includes the entire burner assembly (including the secondary burner and valve), the grate and a full set of artificial logs, which must be the case here, because apart from the artificial logs and grate, the coals burner unit has no purpose or function.

88. Given the circumstances, the entire market value rule is appropriate here as the second approach. Evidence was offered at trial by Peterson's own officer, Mr. Corrin, that Peterson used the ember burner to entice customers to come back to the store to purchase newer log sets, and at the same time, purchase Peterson's ember burner, which improved the overall appearance of the fireplace. (Tr., vol. 2, pg. 177-79). These facts are sufficient to establish that the ember burner is the basis for the customer's demand, as set forth by *TWM*.

89. Blount also offered evidence that the glowing embers from the ember burner are what draws a customer's attention to a particular log and burner set, and what ultimately makes the sale. (Tr., vol. 1, pg. 157-63).

90. Blount also offered testimony at trial that the elements of independent claims 1 and 17 constitute a functional unit with the artificial logs and the grate support.

91. Plaintiff, Blount's case-in-chief presented a third-party witness retailer with extensive sales experience with gas fireplaces and ember burner and gas log sets. He testified that 97 ½ percent of the time that he sells an ember burner, he also sells an entire burner assembly and log set with it. (Tr., vol. 1, pg. 160). In addition, Mr. Blount testified that they are "always to go with the log set" and that he had "never known of any one ember burner set sold by itself." (Tr., vol. 1, pg. 68). Peterson had no testimony to quantify even in a general way when the two would not ultimately be sold together.

92. Peterson failed to rebut Blount's evidence because it did not offer any numerical evidence regarding how often it sells one of its Ember burners with the entire burner and log set.

93. In summation of this point, Blount introduced testimony as to the standard practice in the industry for selling the ember burner, and Peterson failed to introduce its own testimony to rebut Blount's testimony.

94. Because the evidence establishes that 97 ½ percent of the sales of the ember burner would also encompass the sale of the entire burner assembly and log set, the record supports a proration of the damage amount based upon this percentage.

95. Based on the record, of the 3,723 EMB's sold by Peterson, 2 ½ percent (i.e., 94 EMB's) were sold without an associated burner assembly and log set, and the remaining 97 ½ percent (i.e., 3,629) were sold with an associated burner assembly and log set.

96. Blount established at trial that its profit on the ember burner alone is \$14.09 per unit and its profit

on the ember burner, entire burner assembly and full set of logs is \$117.92 per unit. (Plaintiff's Ex. No. 18).

97. This Court finds, based on the percentages and profits established in the paragraphs above, that the total actual damages amount to \$429,256.

#### WILLFULNESS / EXCEPTIONAL CASE

98. Having carefully reviewed the record herein, the Court concludes that Peterson's minimal attempt to attain a competent opinion is permeated by a lack of due care. The record is quite clear that Peterson's supposed oral opinion was an incompetent, conclusory opinion to be used only as an illusory shield against a later charge of willful infringement, rather than in a good faith attempt to avoid infringing another's patent.

99. Throughout the 2½ years from the time the first notice letter was sent, Peterson simply never obtained a single written opinion suggesting that their commercial embodiment avoided infringement. Also, the denial that the first letter related to notice of infringement is shown unlikely by Mr. Corrin's own characterization of it as an "*infringement letter*" in his correspondence with his patent counsel. (Tr., vol. 2, pg. 192). Also, this Court finds it disingenuous for Peterson to argue at trial that the interrogatories answered well after suit was filed and during discovery, form the written opinion upon which they relied.

100. The first time Peterson spoke to Mr. McLaughlin was on or about December 30, 1999, however, Mr. McLaughlin did not have the accused infringing device at this time. (Tr., vol. 1, pg. 181). The record establishes that Mr. McLaughlin, at this time, only had a picture of the accused infringing device. (Tr., vol. 1, pg. 181). Neither did Mr. McLaughlin have the prosecution history of the '159 patent at this time, which is an important element of any competent opinion. (Tr., vol. 1, pg. 202-03).

101. This non-substantive conversation in no way can be construed to be an opinion upon which Peterson could reasonably rely because it was based solely on a supposition. This supposition amounted to a representation on the part of Mr. Bortz that the invention had been around 20 to 30 years. (Tr., vol. 2, pg. 55-56). Mr. McLaughlin, with only the evidence listed above, said that "if we *could* prove that the invention had been around for 20 to 30 years then it *would* be a strong argument of invalidity." (Tr., vol. 2, pg. 55-56, emphasis added). This "if this, then that" statement plainly does not amount to an opinion upon which a prudent person could reasonably rely.

102. Peterson made no further efforts to determine whether it was truly infringing or not, until after suit was filed, almost a year and two months after receiving the first notice letter. (Tr., vol. 1, pg. 202-03).

103. Peterson argues that it did nothing further because it was awaiting “additional information or further explanation from Blount’s attorney.” This Court finds this argument lacking merit. Blount does not, after sending multiple notice of infringement letters to Peterson, owe Peterson any obligation with regard to advising Peterson how they actually were infringing.

104. Nevertheless, Blount’s failure to respond to Peterson’s additional information request did not relieve Peterson of its obligation to determine if it was willfully infringing the ‘159 patent. To the contrary, Peterson continued its infringing activities even after May 16, 2000, and actually even through the trial proceedings. (Tr., vol. 2, pg. 181 and Peterson Company’s Objection to Golden Blount’s Motion for Updated Damages filed on September 18, 2002). This reflects an egregious disregard for the ‘159 patent.

105. It was not until after the lawsuit was filed in January 2001 that Peterson finally became concerned, not with the damages associated with the infringing activity, but apparently with the attorney’s fees that Peterson might be required to pay as a willful infringer. (Tr., vol. 2, pg. 60-62). By Mr. Bortz’ own admission, he told Mr. McLaughlin that this was not a very meaningful case “dollar wise” but that he heard a person might have to pay attorneys’ fees if he loses a patent lawsuit, and he asked Mr. McLaughlin what he should do. (Tr., vol. 2, pg. 60-62 & Dec. 19, 2001, deposition of Mr. Leslie Bortz, pg. 60). Mr. McLaughlin told him that one way that attorney’s fees could be avoided was by obtaining an opinion. (Id).

106. At no time when Mr. McLaughlin gave Mr. Bortz advice did Mr. McLaughlin ever see the actual accused structure. (Tr., vol. 1, pg. 181). While some advertisements of Peterson’s structure were shown, detailed drawings were never provided to Mr. McLaughlin, including the installation instructions that were apparently sold with the device. Thus, Mr. McLaughlin never had a full understanding of the accused structure. (Tr., vol. 1, pg. 200).

107. While Peterson argues that three oral consultations occurred, this Court finds that only one oral opinion of counsel, if it can even be called that, was rendered. This oral opinion was rendered by Mr. McLaughlin on or about May 1, 2001, about 4 months after suit had been filed and 2½ years after Peterson was first noticed of its infringing activity. (Tr., vol. 1, pg. 179-83).

108. This Court believes that Peterson did get what it asked for, a statement that there was no

infringement. Peterson's primary desire, however, was to avoid paying attorneys' fees or increased damages, and this appears to have been the sole reason for consultation with counsel, and these actions showed a willful and egregious disregard for the '159 patent.

109. In summary, this Court finds that Peterson had three consultations with Peterson's Attorney. All were oral. Only the last oral consultation by phone approached what was needed to determine infringement and validity issues, and even it was made with a search limited to the company's own records and with there having been no accused structure shown the patent attorney and without even a single meeting. This third consultation occurred a number of months after suit had been filed and was motivated by the apprehension of Peterson having to pay attorneys' fees, and not for a concern of infringement of the '159 patent.

110. Peterson's cavalier attempt to obtain an opinion and the non-persuasive trial testimony of Peterson's witnesses are classic examples of conduct that clearly and convincingly demonstrates willfulness, which serves as a basis for an exceptional case.

111. This Court therefore finds that the infringement of Peterson was willful, thus the actual damages are trebled, totaling \$1,287,766.

112. Given Peterson's conduct and its overall willful disregard for the '159 patent, such an award is appropriate here. The Court finds that as a result of Peterson's continued infringement, without a reasonable basis for believing that it had a right to make, use or sell its product prior to the expiration of the '159 patent, Blount has been compelled to prosecute an infringement claim at great expense. Under these circumstances, an award of attorneys' fees is proper.

113. This Court therefore finds this to be an exceptional case under 35 U.S.C. § 285, thus reasonable attorneys' fees in the amount of \$332,349 are awarded to Blount.

## CONCLUSIONS OF LAW

### CLAIM CONSTRUCTION

114. The parties dispute the meaning of two terms in the claims of the patent in suit, namely the phrase "raised level," as recited in claim 1, and the term "below" and the phrase "away from the fire place

opening,” as recited in claim 17.

115. As affirmed by the Court of Appeals for the Federal Circuit in its opinion dated April 19, 2004, this Court construes that the term “at a raised level” in claim 1 refers to the top of the two burner tubes, and that the tops of the tubes should be used to determine whether the primary burner tube is held at a raised level with respect to the secondary burner tube as recited in claim 1. This Court also construes that the term “below” in claim 17 refers to the tops of the two burner tubes, and that the tops of the tubes should be used to determine whether the secondary burner tube is positioned below the primary burner tube as recited in claim 17. (Opinion of the Court of Appeals for the Federal Circuit dated April 19, 2004, pg. 7-8).

116. As affirmed by the Court of Appeals for the Federal Circuit in its opinion dated April 19, 2004, this Court construes the term “away from the fireplace opening” to mean that the gas ports may be positioned in any direction that does not include a horizontal component pointed toward the vertical plane of the fireplace opening. (Opinion of the Court of Appeals for the Federal Circuit dated April 19, 2004, pg. 7-8).

117. All the other terms in the claims at issue are construed to have a plain and ordinary meaning, which appears not to have been contested at trial.

#### VALIDITY

118. A validity analysis begins with the presumption of validity. An issued patent is presumed valid. 35 U.S.C. § 282.

119. An “accused infringer who raises patent invalidity as a defense bears the burden of showing invalidity by facts supported by clear and convincing evidence.” *Robotic Vision Systems, Inc. v. View Engineering, Inc.*, 189 F.3d 1370, 1377 (Fed. Cir. 1999); *Weatherchem Corp. v. J.L. Clark, Inc.*, 163 F.3d 1326, 1334-35 (Fed. Cir. 1998).

120. As affirmed by the Court of Appeals for the Federal Circuit on April 19, 2004, this Court concludes that Peterson has failed to prove by clear and convincing evidence that the ‘159 patent is invalid for obviousness. This Court therefore finds the ‘159 patent not to be invalid. (Opinion of the Court of Appeals for the Federal Circuit dated April 19, 2004, pg. 12).

LITERAL INFRINGEMENT-DIRECT

121. The claims define the metes and bounds of the invention, and only they may be infringed. *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988); *Corning Glass Works v. Sumitomo Elec. USA, Inc.*, 868 F.2d 1251 (Fed. Cir. 1989).

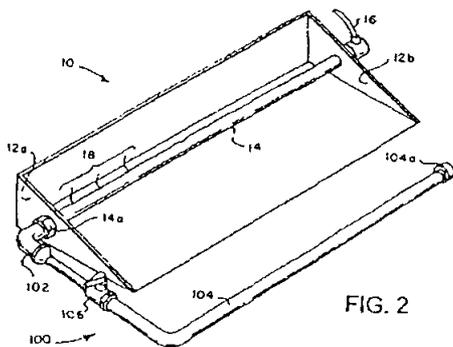
122. The patentee's burden is to show literal infringement by a preponderance of the evidence. *Braun v. Dynamics Corp.*, 975 F.2d 815 (Fed. Cir. 1992).

123. A patent claim is literally infringed if the accused product or process contains each element of the claim. *Tate Access Floors v. Maxcess Techs.*, 222 F.3d 958, 964 (Fed. Cir. 2000); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1054 (Fed. Cir. 1988). If each element is present, literal infringement exists and "that is the end of it." *Graver Tank v. Linde Co.*, 339 U.S. 605, 607, 94 L. Ed. 1097, 70 S. Ct. 854, 1950 Dec. Comm'r Pat. 597 (1950).

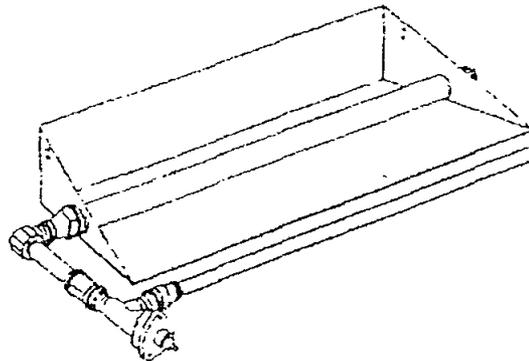
124. In determining infringement, the accused product is compared to the patent claims, not the patentee's product. *Zenith Laboratories, Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1423 (Fed. Cir. 1994); *Glaxo Inc. v. TorPharm Inc.*, 153 F.3d 1366, 1373 (Fed. Cir. 1998).

125. Infringement of a single claim is infringement, *Panduit Corp. v. Dennison Mfg. Co. Inc.*, 836 F.2d 1329, 1330 n.1 (Fed. Cir. 1987); *Intervet America v. Kee-Vet Laboratories*, 887 F.2d 1050, 1055 (Fed. Cir. 1989), and entitles the patentee to the full panoply of statutory remedies. *Intervet*, 887 F.2d at 1055.

126. This Court understands that in determining infringement, the accused product is compared to the patent claims, not the patentee's product. However, FIG. 2 of the '159 patent is representative of the claims of the '159 patent and the claims may be read on the FIG. 2 structure. For this reason a comparison of one of Blount's devices and Peterson's manufactured product is highly instructive for purposes of this Court's analysis, and is, therefore, provided.



**Blount's Patented Device**  
FIG. 2 of the '159 Patent



**Peterson's Manufactured Product**  
Figure 2 of Peterson's Installation Instructions

127. The findings in the sections above make out a clear case of direct infringement on all of the devices sold.

#### LITERAL INFRINGEMENT-CONTRIBUTORY

128. Contributory infringement liability arises when one "sells within the United States . . . a component of a patented machine . . . constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantially noninfringing use." 35 U.S.C. § 271(c) (2002).

129. Thus, Blount must show that Peterson "knew that the combination for which its components were especially made was both patented and infringing." *Preemption Devices, Inc. v. Minn. Mining & Mfg. Co.*, 803 F.2d 1170, 1174 (Fed. Cir. 1986).

130. An appropriate infringement notice letter from the patentee to the accused infringer provides the requisite knowledge required by 35 U.S.C. § 271(c). *Aro Manufacturing Co., Inc. v. Convertible Top Replacement Co.*, 377 U.S. 476, 490 (1964).

131. Further, Blount must show that Peterson's components have no substantially noninfringing uses, while meeting the other elements of the statute. *Alloc, Inc. v. ITC*, 342 F.3d 1361, 1374 (Fed. Cir. 2003).

132. The findings in the sections above make out a clear case of Contributory infringement on all of the devices sold.

#### LITERAL INFRINGEMENT-INDUCEMENT

133. In order to find Peterson liable for inducing infringement under 35 U.S.C. § 271 (b), Blount must show that Peterson took action that actually induced infringement. *Met-Coil Sys. Corp. v. Korners Unlimited, Inc.*, 803 F.2d 684, 687 (Fed. Cir. 1986) (“There can be no inducement of infringement without direct infringement by some party.”)

134. Further, Blount must show that Peterson knew or should have known that such actions would induce direct infringement. *Micro Chem. Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250 (Fed. Cir. 1999).

135. The findings in the sections above make out a clear case of induced infringement on all of the devices sold.

#### INFRINGEMENT-DOCTRINE OF EQUIVALENTS

136. Infringement under the doctrine of equivalents occurs when a claimed limitation and the accused product perform substantially the same function in substantially the same way to obtain the same result. See *Warner-Jenkinson Co. v. Hilton-Davis Chem. Co.*, 520 U.S. 17, 39-40, 137 L. Ed. 2d 146, 117 S. Ct. 1040 (1997).

137. Infringement under the doctrine of equivalents also requires that any difference between the claim elements at issue and the corresponding elements of the accused product be insubstantial. *Id.*

138. This Court finds alternatively (or cumulatively) that there was infringement under the doctrine of equivalents.

#### DAMAGES

139. To recover lost profit damages, the patentee need only show causation and the factual basis for causation between the infringement and the lost profits. *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 1065, 219 U.S.P.Q. 670 (Fed. Cir. 1983).

140. To do this, *Panduit* established that the patent owner need only demonstrate:

- 1) a demand for the product during the period in question;
- 2) an absence, during that period, of acceptable non-infringing substitutes;
- 3) its own manufacturing and marketing capability to meet or exploit that demand; and
- 4) a detailed computation of the amount of the profit it would have made.

*Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156, 197 U.S.P.Q. 726 (6th Cir. Mich. 1978); *Radio Steel & Mfg. Co. v. MTD Prods., Inc.*, 788 F.2d 1554, 1555, 229 U.S.P.Q. 431 (Fed. Cir. 1986).

141. In a two-supplier market it is reasonable to assume, provided the patent owner has the manufacturing capabilities, that the patent owner would have made the infringer's sales but for the infringement. *State Indus. v. Mor-Flo Indus.*, 883 F.2d 1573, 1578, 12 U.S.P.Q.2d 1026 (Fed. Cir. 1989).

142. The "[m]ere existence of a competing device does not make that device an acceptable substitute." *TWM Mfg. Co., Inc. v. Dura Corp.*, 789 F.2d 895, 901, 229 U.S.P.Q. 525 (Fed. Cir. 1986), *cert. denied*. A product on the market that lacks the advantages of the patented product can hardly be termed a substitute acceptable to the customer who wants those advantages. *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1373, 21 U.S.P.Q.2d 1321 (Fed. Cir. 1991), *cert. denied*. If purchasers are motivated to purchase because of particular features available only from the patented product, products without such features would most certainly not be acceptable non-infringing substitutes. *Id.*

143. Also, courts have generally held that an infringer's acceptable substitute argument is of "limited influence" when it [the infringer] ignores those substitutes while selling the patented invention. (emphasis added). *TWM*, 789 F.2d at 902. This is exactly what Peterson did.

144. In an alternative approach, however, the "entire market value rule" may be used to determine the device for calculating lost profits. In *Beatrice Foods*, the Court stated that the law does not bar the inclusion of convoyed sales in an award of lost profits damages. *Beatrice Foods Co. v. New England Printing & Lithographic Co.*, 899 F.2d 1171, 1175, 14 U.S.P.Q.2d 1020 (Fed. Cir. 1991).

145. The "entire market value rule" allows for the recovery of damages based on the value of an entire

apparatus containing several features, even though only one feature is patented. *Paper Converting Machine Co., v. Magna-Graphics, Corp.*, 745 F.2d 11, 33, 223 U.S.P.Q. 591 (Fed. Cir. 1984).

146. The “entire market value rule” further permits recovery of damages based on the value of the entire apparatus containing several features, when the patent-related feature is the basis for customer demand. See *TWM*, 789 F.2d at 901.

147. The “entire market value rule” is appropriate where both the patented and unpatented components together are analogous to components of a single assembly, parts of a complete machine, or constitute a functional unit. See *Rite-Hite v. Kelly Co.*, 56 F.3d 1538, 1550, 35 U.S.P.Q.2d 1065 (Fed. Cir. 1995).

#### WILLFULNESS / EXCEPTIONAL CASE

148. In addition to requiring “damages adequate to compensate for the infringement,” Section 284 of the Patent Act authorizes a district court to “increase damages up to three times the amount found or assessed.” 35 U.S.C. § 284.

149. The Federal Circuit has interpreted this provision of Section 284 as requiring a two-step process: “First the fact-finder must determine whether an infringer is guilty of conduct upon which increased damages may be based.” *Jurgens v. CBK, Ltd.*, 80 F.3d 1566, 1570, 38 U.S.P.Q.2d 1397 (Fed. Cir. 1996). “If so, the Court then determines, exercising its sound discretion, whether, and to what extent, to increase the damage award given the totality of the circumstances.” *Id.*

150. “An act of willful infringement satisfies this culpability requirement, and is, without doubt, sufficient to meet the first requirement to increase a compensatory damages award.” *Id.* Thus, once a proper willfulness finding is made, the first step in determining whether damages should be enhanced is complete. *Id.* At that point, the Court need consider only whether, and to what extent, the compensatory damages awarded by the fact finder should be increased, in light of “the egregiousness of the Defendant’s conduct based on all the facts and circumstances of the case.” *Id.*

151. “A potential infringer having actual notice of another’s patent rights has an affirmative duty of care.” *Spindelfabrik Suessen-Schurr, Stahlecker & Grill GmbH v. Schubert & Salzer Maschinenfabrik Aktiengesellschaft*, 829 F.2d 1075, 1084 (Fed. Cir. 1987). An act of infringement is thus deemed willful when the infringer is aware of another’s patent and fails to exercise due care to avoid

infringement. *Electro Medical Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1056 (Fed. Cir. 1994); *Rolls-Royce Ltd. v. GTE Valeron Corp.*, 800 F.2d 1101, 1109 (Fed. Cir. 1986). This standard of care typically requires an opinion from competent patent counsel prior to engaging in any potentially infringing activities. *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389-90 (Fed. Cir. 1983). To establish willfulness, Blount must demonstrate by clear and convincing evidence, considering the “totality of the circumstances,” that Peterson willfully infringed its patent. *Electro Medical*, 34 F.2d at 1056.

152. The prosecution history of a patent in question is an important element of any competent opinion. *Underwater Devices*, 717 F.2d at 1389-90.

153. A holding of willful infringement is usually sufficient to make a case exceptional and entitles the opposing party to its attorney’s fees. 35 U.S.C. § 285 (2002); *Avia Group Intl. Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1567 (Fed. Cir. 1988).

## CONCLUSION

For the reasons set forth above, the Court concludes that Peterson's manufactured products infringe the claims of the '159 patent. Blount is entitled to actual damages from Peterson in the amount of \$429,256. The infringement of Peterson was willful, thus the actual damages are trebled, totalling \$1,287,766. Blount is also awarded prejudgment interest, which shall be calculated on a simple rather than compound basis, on the actual damages of \$429,256 at the rate of 5.0% for the period from December 16, 1999, to August 9, 2002. This is an exceptional case under 35 U.S.C. § 285, thus reasonable attorneys' fees in the amount of \$332,349 are awarded to Blount. Blount is further awarded postjudgment interest, calculated pursuant to 28 U.S.C. § 1961, on the sum of the trebled damages and attorney's fees at the rate of 1.88% from the date of the final judgment. Costs in the amount of \$10,031.04 shall be taxed against Peterson. Based upon the fact that infringement causes irreparable harm, an injunction is granted against Peterson.

It is so ORDERED

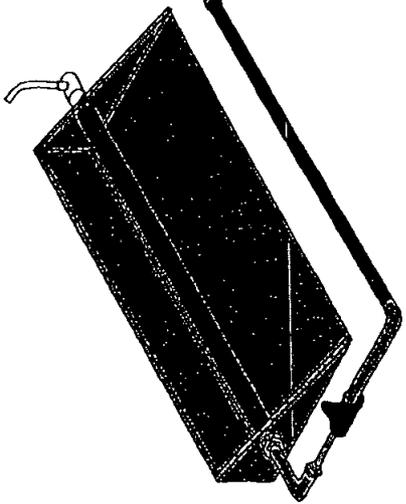
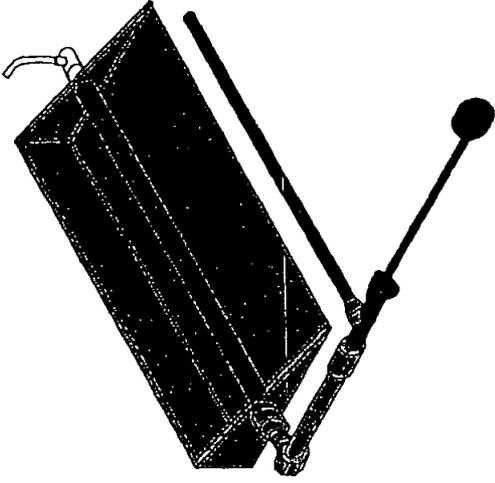
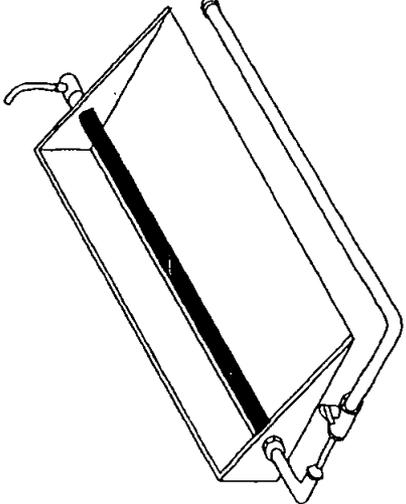
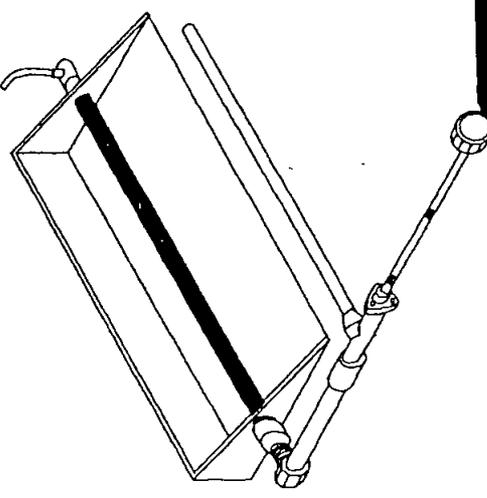
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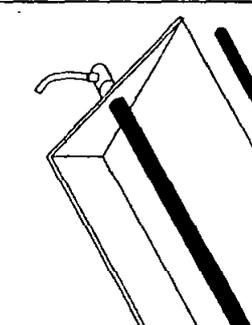
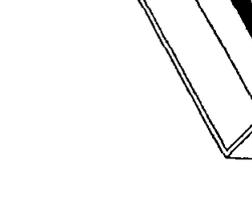
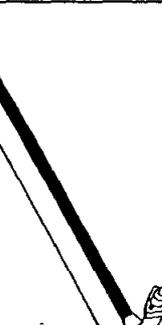
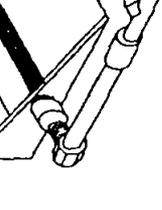
JUDGE JERRY BUCHMEYER  
UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS

EXHIBIT A

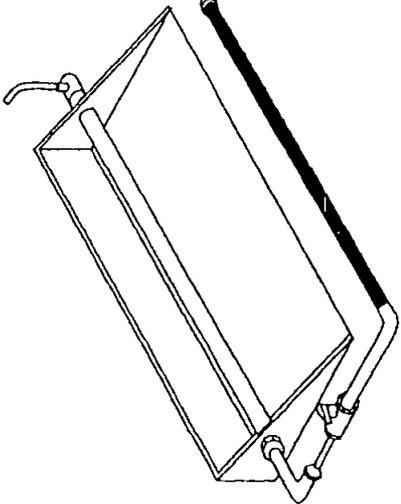
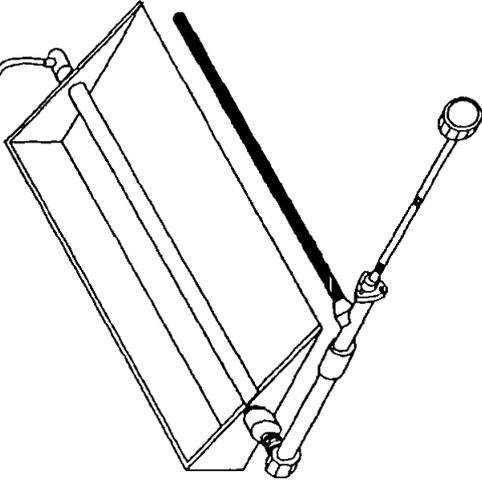
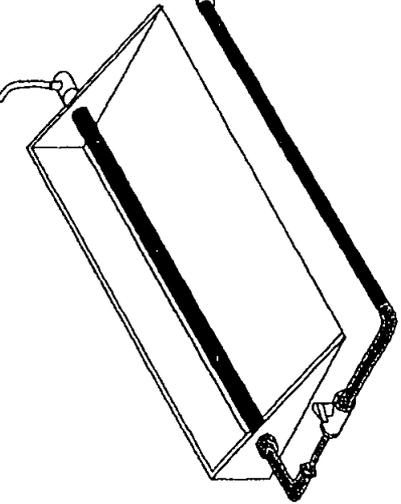
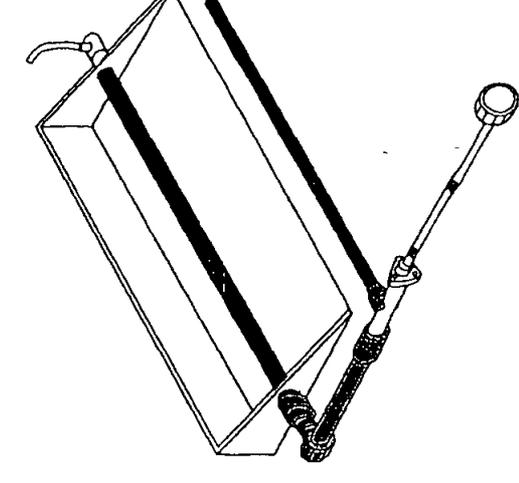
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>1. A gas-fired artificial logs and coals-burner assembly for fireplace comprising:</p>	
	<p>an elongated primary burner tube including a plurality of gas discharge ports;</p>	

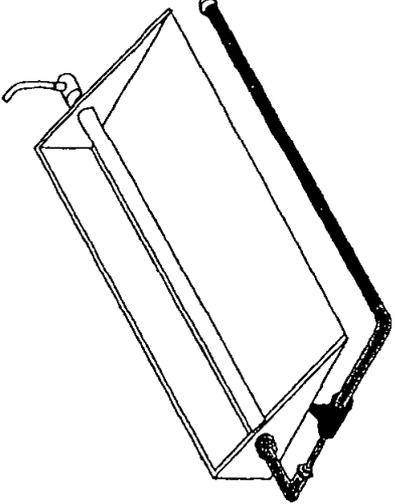
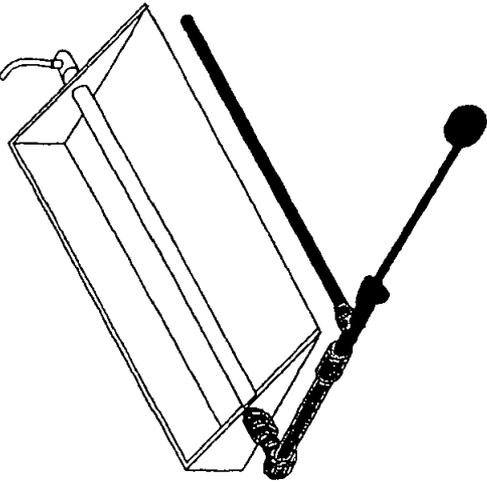
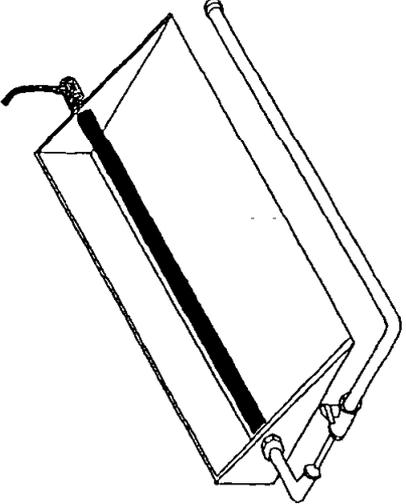
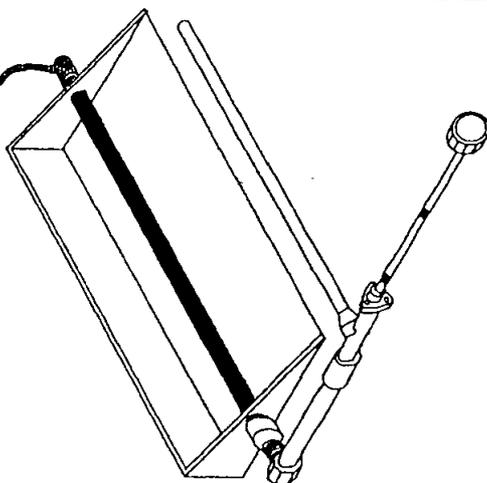
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>a secondary coals burner elongated tube positioned forwardly of the primary burner tube;</p>	
	<p>a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube;</p>	

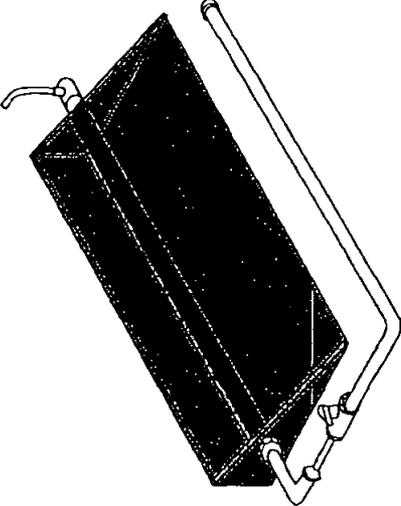
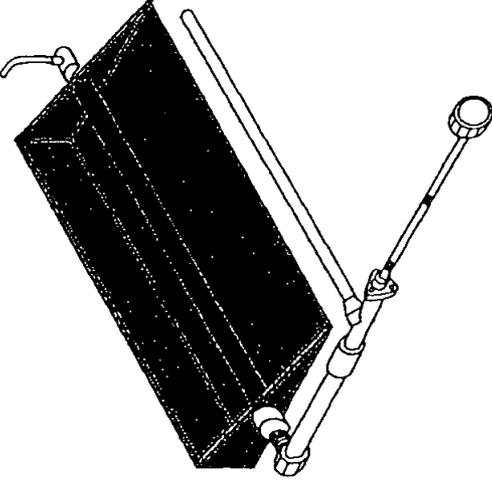
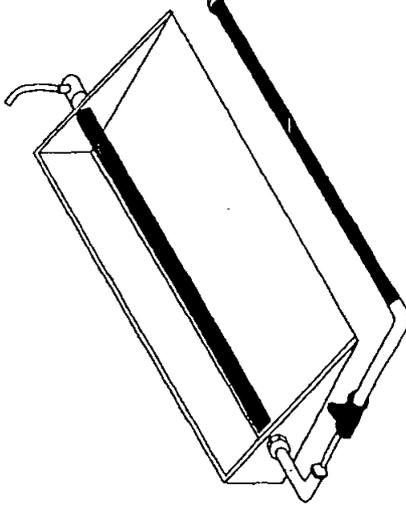
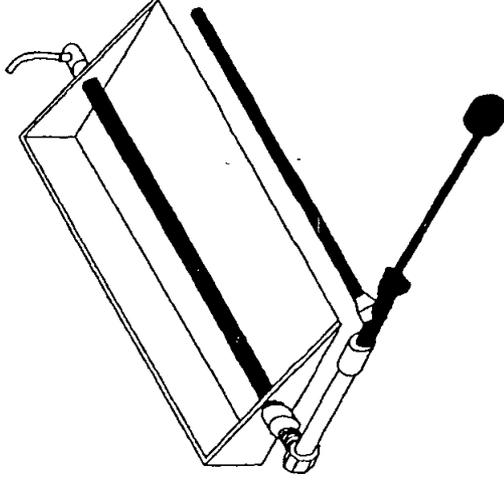
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>the secondary coals burner elongated tube including a plurality of gas discharge ports;</p>	
	<p>the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means;</p>	

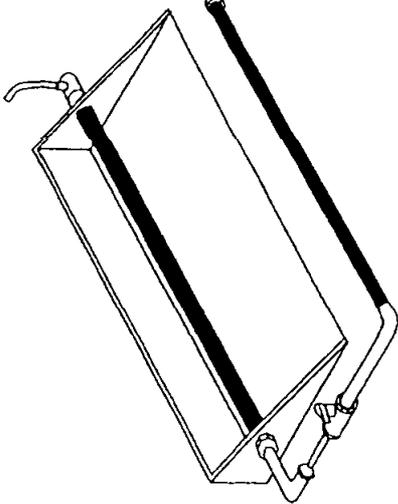
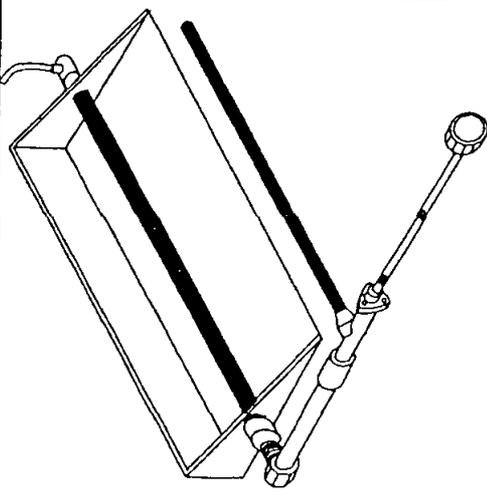
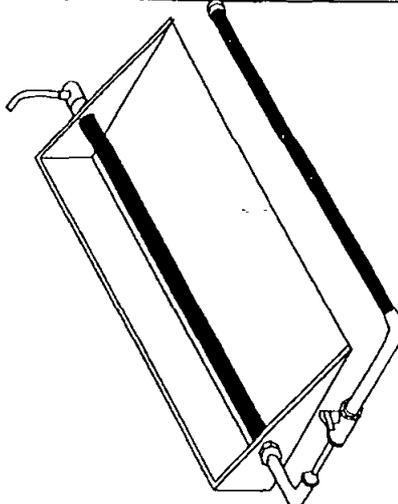
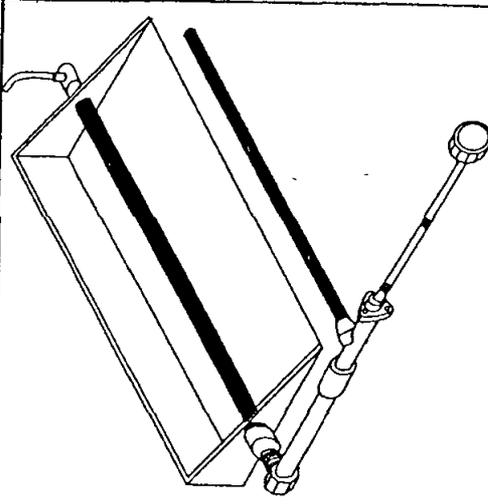
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and</p>	
	<p>the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.</p>	

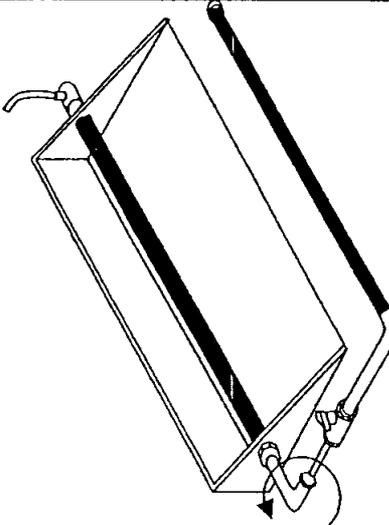
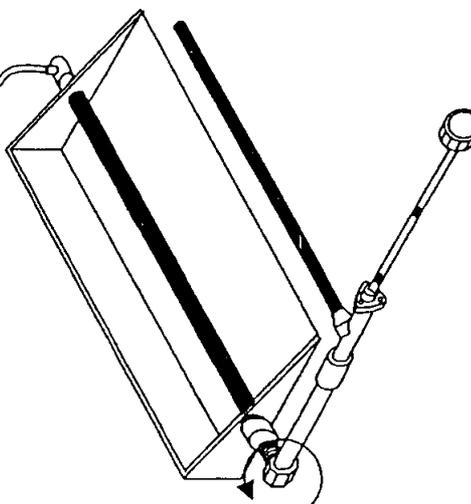
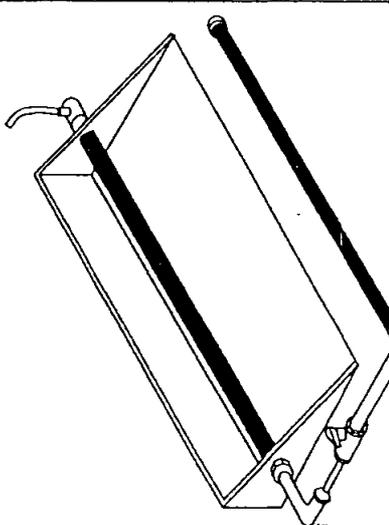
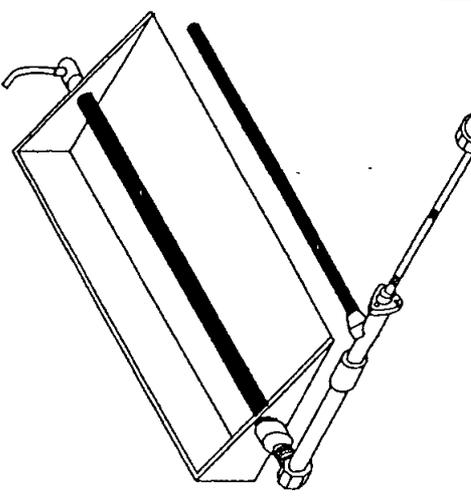
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>2. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the support means for the primary burner tube is comprised of an open frame pan for supporting the primary burner tube in an elevated position relative to the fireplace floor.</p>	
	<p>5. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is substantially parallel to the primary burner tube and has a smaller inside diameter than the primary burner tube with the valve adjusting gas flow for coals burn and forwarding heat radiation from the fireplace.</p>	

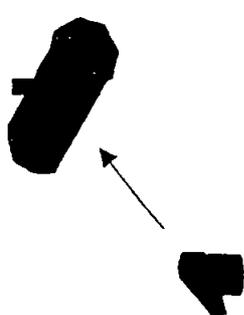
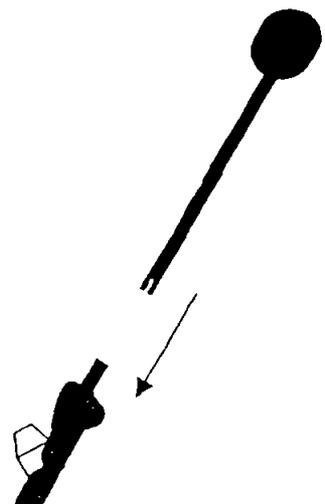
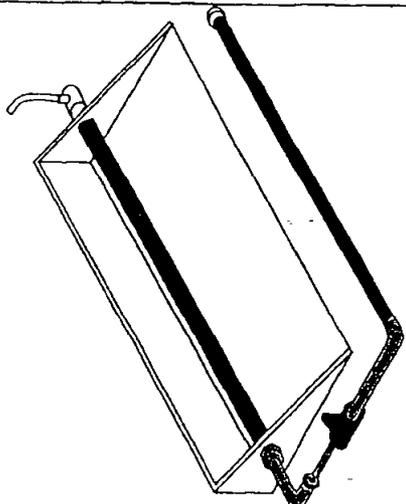
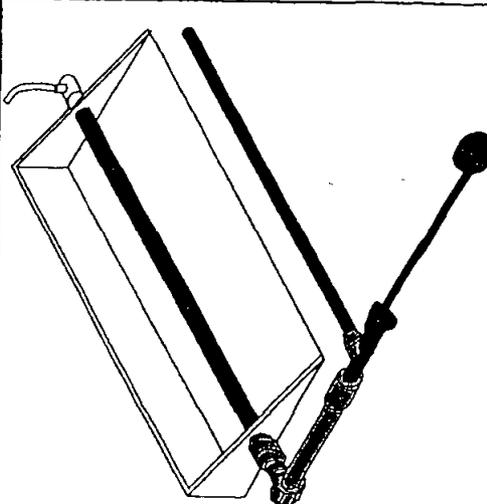
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>7. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the elongated primary burner tube and the secondary coals burner elongated tube are spaced apart on different planes at from about four to about eight inches.</p>	
	<p>8. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is of a smaller diameter than the primary burner tube which allows for a lower profile of coals and sand coverage.</p>	

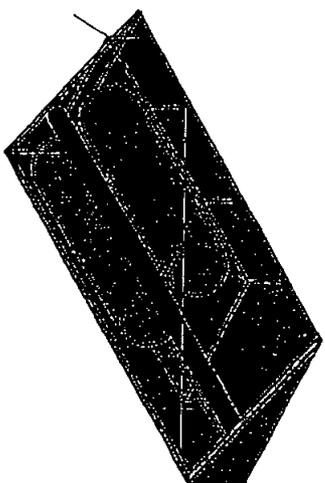
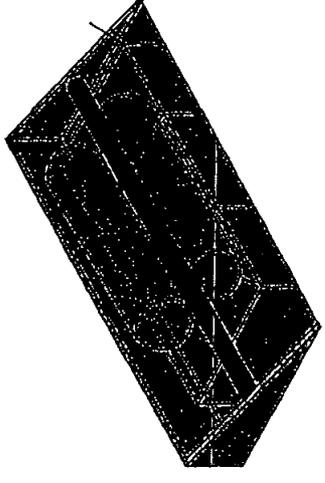
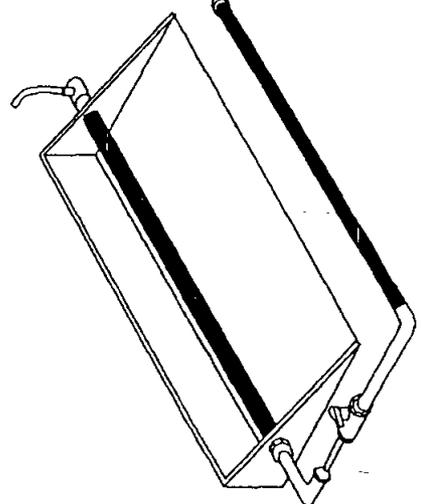
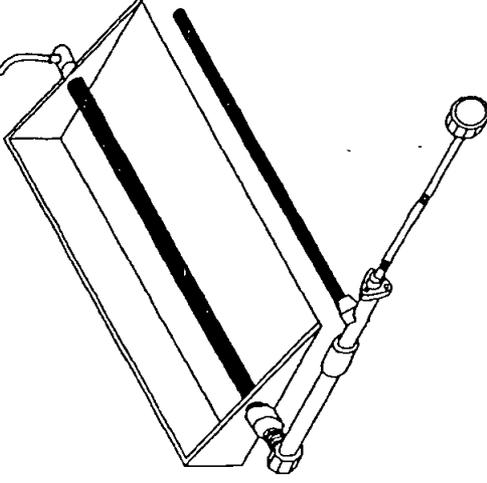
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>9. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube.</p>	
	<p>11. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary and secondary burner tubes have apertures of from about 1/32 inch to about 1/8 inch.</p>	

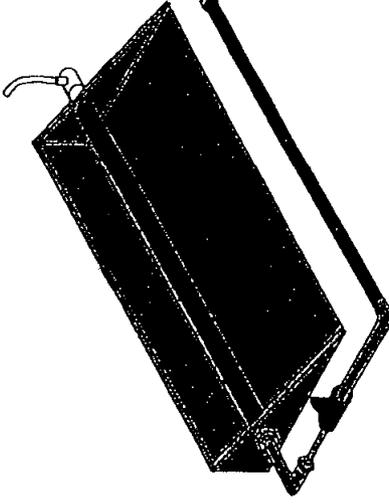
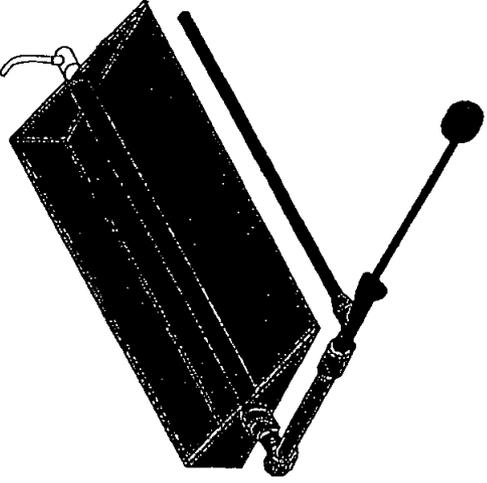
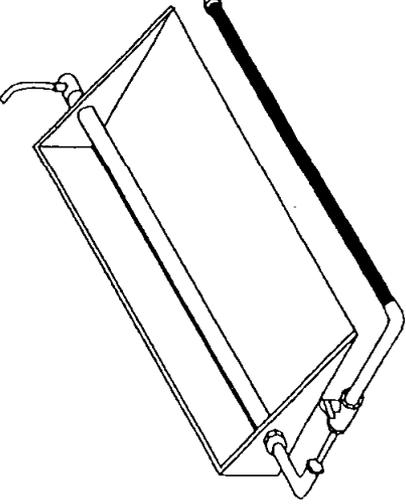
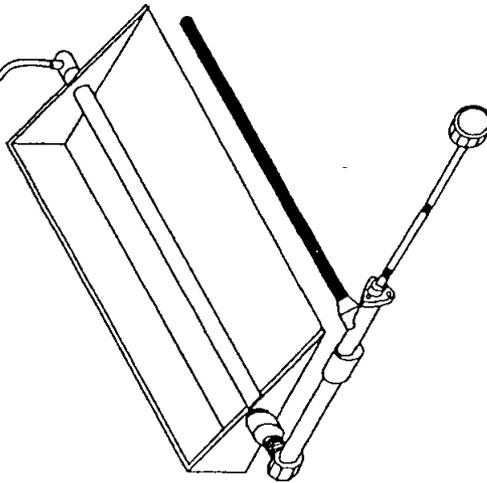
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
 <p>A diagram showing two components of the plaintiff's claimed device. On the left is a rectangular burner assembly with a handle. On the right is a separate elongated tube with a valve. An arrow points from the burner assembly to the tube, indicating they are parts of the same device.</p>	<p>12. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the gas flow adjustment valve has a removable handle, the gas flow adjustment allowing a variety of settings from full closed to full open.</p>	 <p>A diagram showing a burner assembly with a handle and a separate elongated tube with a valve. An arrow points from the burner assembly to the tube, indicating they are parts of the same device.</p>
 <p>A diagram showing a burner assembly with a handle and a separate elongated tube with a valve. An arrow points from the burner assembly to the tube, indicating they are parts of the same device.</p>	<p>13. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the connection means is comprised of a connector attached to the terminal end of the primary burner tube at a first end of a connector and attached to the secondary coals burner elongated tube to a connector second end with the valve interposed between the primary burner tube and the secondary burner tube.</p>	 <p>A diagram showing a burner assembly with a handle and a separate elongated tube with a valve. An arrow points from the burner assembly to the tube, indicating they are parts of the same device.</p>

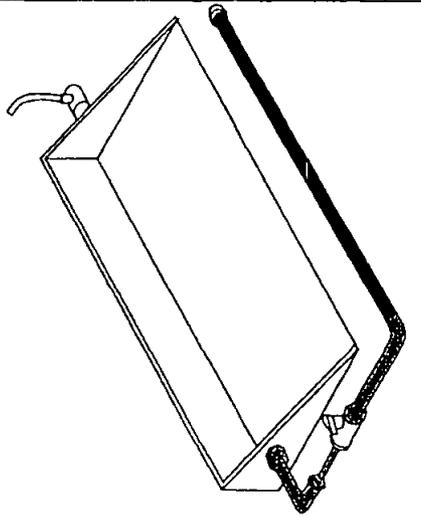
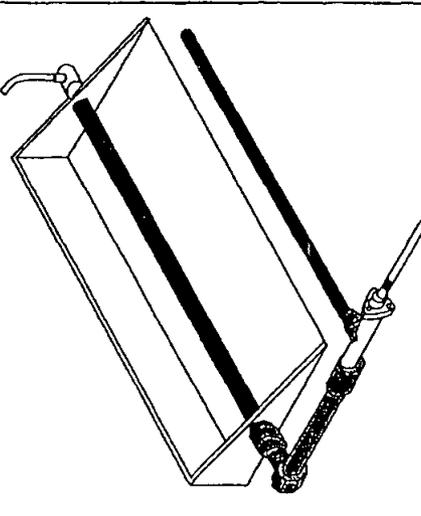
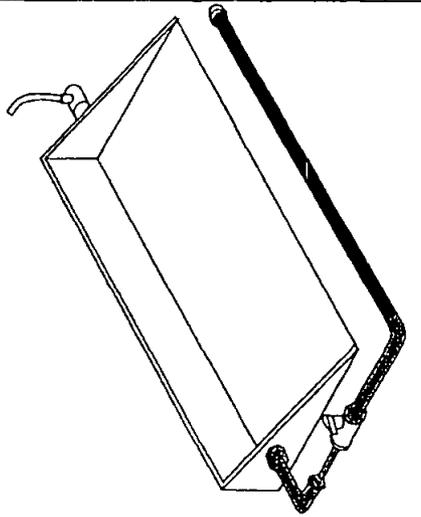
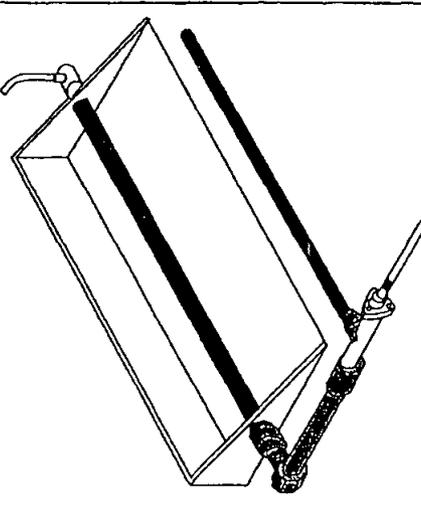
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>15. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open frame pan and primary elongated burner tube is positioned under an artificial logs and grate support means.</p>	
	<p>16. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary elongated burner tube is covered with sand and the secondary elongated burner tube is covered with sand, mica, and fibrous materials which simulate coals and ember burn.</p>	

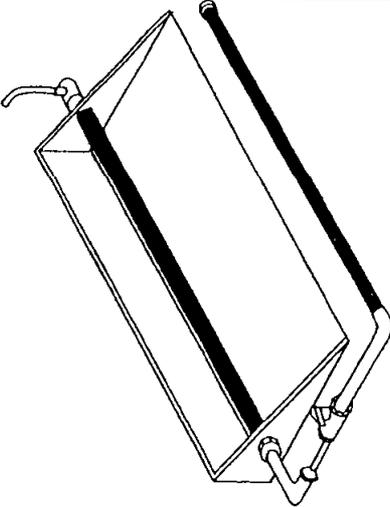
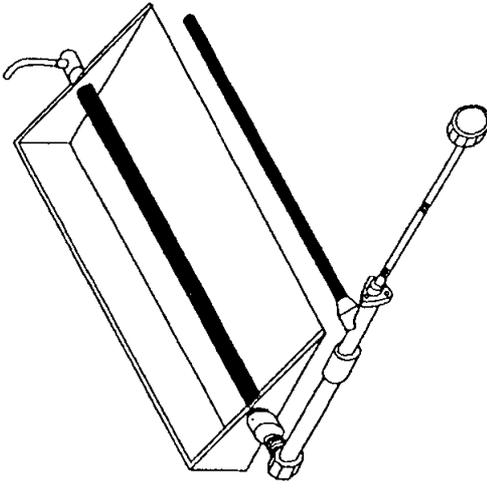
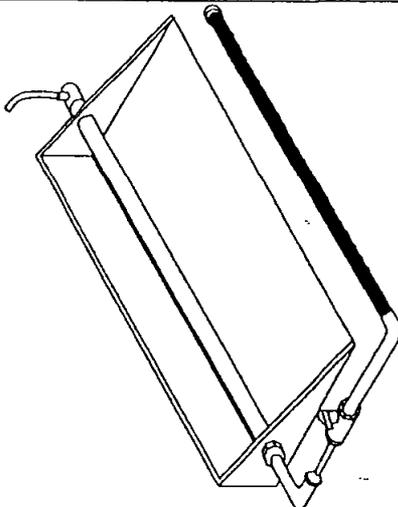
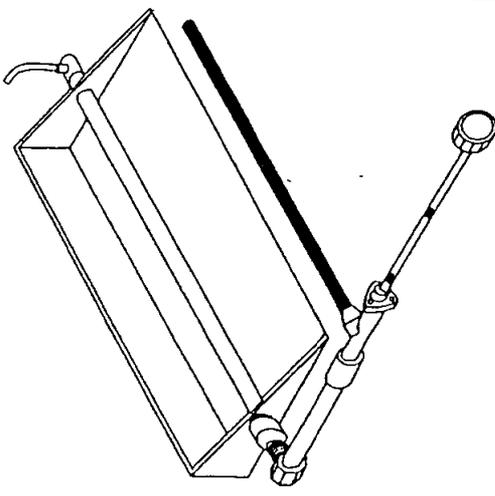
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>17. A gas-fired artificial coals- and embers- burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:</p>	
	<p>a secondary coals burning elongated tube;</p>	

# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube</p>	
	<p>the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve,</p>	

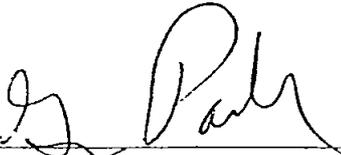
# LITERAL INFRINGEMENT CHART

Plaintiff's Claimed Device	Claims/Elements	Defendant's Sold Device
	<p>primary and secondary burner tubes having a plurality of gas discharge ports,</p>	
	<p>a gas distribution ports of the secondary burner tube directed away from the fireplace opening.</p>	

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Golden Blount, Inc.'s Proposed Findings of Fact and Conclusions of Law was served on the following counsel of record on June 10, 2004, by first class mail and facsimile:

Jerry R. Selinger  
Jenkins & Gilchrist  
1445 Ross Avenue, Suite 3200  
Dallas, Texas 75202  
214/855-4500 (Telephone)  
214/855-4300 (Facsimile)

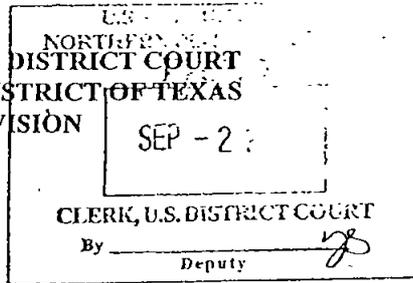


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Greg H. Parker

JT-APP\_0047

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.,  
Plaintiff,

v.

ROBERT H. PETERSON CO.,  
Defendant.

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Civil Action No.  
3-01CV0127-R

ORDER

This Court, consistent with its ruling at the conclusion of the Oral Hearing on August 18, 2004, hereby VACATES Defendant's Findings of Fact and Conclusions of Law previously adopted on June 22, 2004. The Court, also consistent with its ruling at the conclusion of the Oral Hearing on August 18, 2004, is of the opinion that the Plaintiff's Findings of Fact and Conclusions of Law submitted on August 31, 2004, are correct, and they are hereby ADOPTED as the Findings and Conclusions of this Court.

IT IS SO ORDERED.

ENTERED: this 2 day of Sept., 2004.

\_\_\_\_\_  
JERRY BUCHMEYER  
SENIOR UNITED STATES DISTRICT JUDGE  
NORTHERN DISTRICT OF TEXAS

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

U.S. DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
SEP - 2 2004  
CLERK, U.S. DISTRICT COURT  
By \_\_\_\_\_ Deputy *[Signature]*

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

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Civil Action No.

3-01CV0127-R

ORDER

This Court, consistent with its ruling at the conclusion of the Oral Hearing on August 18, 2004, hereby VACATES Defendant Robert H. Peterson's Application for Attorneys' Fees previously adopted on August 11, 2004.

IT IS SO ORDERED.

ENTERED: this 2 day of Sept., 2004.

*[Signature]*  
JERRY BUCHMEYER  
SENIOR UNITED STATES DISTRICT JUDGE  
NORTHERN DISTRICT OF TEXAS

IN THE UNITED STATES DISTRICT COURT  
 FOR THE NORTHERN DISTRICT OF TEXAS  
 DALLAS DIVISION

U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF TEXAS  
 FILED  
 SEP - 2 2004  
 CLERK, U.S. DISTRICT COURT  
 By \_\_\_\_\_ Deputy *[Signature]*

GOLDEN BLOUNT, INC.,  
 Plaintiff,

v.

ROBERT H. PETERSON CO.,  
 Defendant.

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Civil Action No.  
 3-01CV0127-R

**FINDINGS OF FACT AND CONCLUSIONS OF LAW**

This Court has conducted a bench trial on plaintiff Golden Blount Inc.'s claims against defendant Robert H. Peterson for a finding of infringement of U.S. Patent No. 5,988,159 and permanent injunction, and on Peterson's counterclaims of invalidity and non-infringement. In accordance with FED. R. CIV. P. 52(a) and consistent with the Court of Appeals for the Federal Circuit's Opinion<sup>1</sup> decided April 19, 2004, the Court enters the following findings of fact and conclusions of law.<sup>2</sup>

**FINDINGS OF FACT**

I. This is an action for patent infringement. The Court has subject matter jurisdiction under 28 U.S.C. §§ 1331, 1338(a). The Court has personal jurisdiction over the parties. Venue in this judicial district is proper under 28 U.S.C. § 1391.

<sup>1</sup> While the Appellate Court held that the patent was not invalid, and that the defense of unenforceability was waived, this Court includes general reference to these elements for completeness. *Golden Blount, Inc. v. Robert H. Peterson Co.*, 365 F.3d 1054 (Fed. Cir. 2004).

<sup>2</sup> This order contains both findings of fact ("Findings") and conclusions of law ("Conclusions"). To the extent that any Findings may be deemed conclusions of law, they shall also be considered Conclusions. To the extent that any Conclusions may be deemed findings of fact, they shall also be considered Findings. See *Miller v. Fenton*, 474 U.S. 104, 113-14, 88 L. Ed. 2d 405, 106 S. Ct. 445 (1985).

2. Plaintiff Golden Blount, Inc. ("Blount") is a United States corporation having a principal place of business in Addison, Texas.

3. Defendant Robert H. Peterson Co. ("Peterson") is a United States corporation having a principal place of business in City of Industry, California.

4. Blount is the owner by assignment of U.S. Patent No. 5,988,159 ("the '159 patent"), entitled "Gas-Fired Artificial Logs and Coals-Burner Assembly," which issued on November 23, 1999. The '159 patent expires on November 23, 2016.

5. Blount filed this suit for infringement of the '159 patent under 35 U.S.C. §§ 271(a) thru 271(c) on January 18, 2001.

6. On March 19, 2001, Peterson filed its Answer and Counterclaim. Peterson denied infringement and asserted counterclaims for noninfringement and invalidity of the '159 patent.

7. A bench trial, by agreement of the parties, commenced on July 29, 2002, and ended on July 31, 2002.

8. Claims 1, 2, 5, 7-9, 11-13 and 15-17 are at issue in this case. Claims 1 and 17 are independent claims. All the other claims at issue are dependent on claim 1.

9. Claim 1 of the '159 patent reads as follows:

A gas-fired artificial logs and coals-burner assembly for fireplace comprising:  
an elongated primary burner tube including a plurality of gas discharge ports;  
a secondary coals burner elongated tube positioned forwardly of the primary burner tube;

a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube;

the secondary coals burner elongated tube including a plurality of gas discharge ports;

the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means;

a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and

the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.

10. Claim 2 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the support means for the primary burner tube is comprised of an open frame pan for supporting the primary burner tube in an elevated position relative to the fireplace floor.

11. Claim 5 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is substantially parallel to the primary burner tube and has a smaller inside diameter than the primary burner tube with the valve adjusting gas flow for coals burn and forwarding heat radiation from the fireplace.

12. Claim 7 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the elongated primary burner tube and the secondary coals burner elongated tube are spaced apart on different planes at from about four to about eight inches.

13. Claim 8 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is of a smaller diameter than the primary burner tube which allows for a lower profile of coals and sand coverage.

14. Claim 9 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube.

15. Claim 11 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary and secondary burner tubes have apertures of from about 1/32 inch to about 1/8 inch.

16. Claim 12 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the gas flow adjustment valve has a removable handle, the gas flow adjustment allowing a variety of settings from full closed to full open.

17. Claim 13 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the connection means is comprised of a connector attached to the terminal end of the primary burner tube at a first end of a connector and attached to the secondary coals burner elongated tube to a connector second end with the valve interposed between the primary burner tube and the secondary burner tube.

18. Claim 15 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open frame pan and primary elongated burner tube is positioned under an artificial logs and grate support means.

19. Claim 16 of the '159 patent reads as follows:

The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary elongated burner tube is covered with sand and the secondary

elongated burner tube is covered with sand, mica, and fibrous materials which simulate coals and ember burn.

20. Claim 17 of the '159 patent reads as follows:

A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:

a secondary coals burning elongated tube;

a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube being in gas flow communication with the primary burner tube being the connection means, a gas distribution ports of the secondary burner tube directed away from the fireplace opening.

21. At the time the patent issued, Blount's commercial structure covered by the '159 patent had been marketed for approximately six years. (Trial Transcript, hereafter referred to as "Tr.", vol. 1, pg. 158). The invention covered by the '159 patent is a simple yet very useful device that is to be used in artificial gas fireplaces. The general idea is that the device has two tubes, with the main or primary burner tube being higher than the ember burner tube to allow for artificial embers and sand to be fanned out over the tubes with a decreasing depth of materials to simulate a natural angle of repose of coals in a real fireplace. A secondary valve controls the flow of gas from the primary burner tube to the ember burner to allow for an adjustment of flame from the ember burner. Thus, with the presence of the ember burner forward the primary burner tube, more flame can be provided out front of the gas logs to better simulate a real fireplace and thereby make the artificial fireplace more aesthetically pleasing. Evidence presented at trial establishes that Peterson's accused device fulfills exactly the same purpose. (Tr. vol. 2, pg 175; Defendant's Ex. No. D-33).

22. Blount's sales of its commercial structure grew significantly during the time spanning the filing of the application that resulted in the '159 patent and the issuance of the '159 patent. (Tr., vol. 1, pg. 36-37).

23. In late 1996 or early 1997, Peterson began manufacturing, advertising and selling a device that was strikingly similar to, if not a virtual copy of, Blount's commercial structure. (Tr., vol. 2, pg. 76 and pg. 172).

24. Blount's '159 patent issued on November 23, 1999. (Plaintiff's Ex. No. 1).

25. Blount notified Peterson of the existence of the '159 patent and Peterson's infringing activities on December 16, 1999, using a certified letter postmarked December 10, 1999, from Mr. Dan Tucker (attorney for Blount) to Peterson's president, Mr. Leslie Bortz. (Plaintiff's Ex. No. 10).

26. This first certified letter included a copy of the '159 patent, and informed Peterson that Blount was prepared to take whatever steps were reasonable and necessary to prevent infringement. Blount requested a response regarding this matter from Peterson by January 14, 2000. (Plaintiff's Ex. No. 10).

27. On December 17, 1999, Mr. Tod Corrin (Peterson's Vice President) forwarded the December 10, 1999, certified letter onto Peterson's patent counsel, Mr. William McLaughlin. Mr. Corrin wrote, in a cover letter included with the copy of the first certified letter, "[e]nclosed is a *patent infringement* letter we received from Golden Blount's Attorney." (Plaintiff's Ex. No. 17, emphasis added). Given the letter from Blount's attorney and this acknowledgment by Mr. Corrin, this Court finds that Peterson had knowledge of its infringement of the '159 patent as of December 16, 1999.

28. On December 30, 1999, Peterson responded to Blount's letter of December 10, 1999, explaining that Peterson had forwarded the December 10, 1999, letter to its attorneys and that Peterson would get back with Blount as soon as possible. Given the December Holidays, as well as the New Year, Peterson informed Blount that Blount's January 14, 2000, response date was unreasonable. (Plaintiff's Ex. No. 11).

29. After receiving no response from Peterson for more than four months, Blount sent a second certified letter to Peterson on May 3, 2000, again informing Peterson of its patent infringement. The May 3, 2000, letter advised Peterson that Blount "will take [the] necessary steps to stop any such *infringement*." (Plaintiff's Ex. No. 12, emphasis added).

30. Peterson responded to the May 3, 2000, letter on May 16, 2000, that it disagreed with Blount's assertion that Peterson was marketing a device that was substantially similar to the burner assembly claimed in the '159 patent. Peterson further asked that Blount explain to it, in detail, the basis upon which Blount believed that Peterson was infringing the patent. (Plaintiff's Ex. No. 13).

This Court finds that Peterson's disagreement lacks any serious credibility, since a simple comparison of the device as illustrated in the '159 patent with Peterson's product would have revealed to any reasonable person that infringement was highly likely. Moreover, the record before this Court reveals that Peterson did not have any documents before it or its attorney at this time that provides a reasonable basis for this statement. Even though Blount did not give any explanation to Peterson, this did not relieve Peterson of its obligation to investigate in good faith whether it was in fact infringing the '159 patent. This Court further finds that the May 3, 2000, letter was written simply for the purpose of delay, or even with the hope that the infringement matter would go away. This Court, therefore, concludes that the request was not genuine.

31. On January 18, 2001, over a year after Peterson received its first notice of infringement letter, Blount filed suit. (Plaintiff's Ex. No. 14). Blount's initial notice letter of December 10, 1999, met the notice requirements under 35 U.S.C. § 287(a), and therefore, Peterson's additional information request did not relieve Peterson of its obligation to determine if it was infringing the '159 patent.

32. Blount sent a final letter on January 19, 2001, to Peterson advising Peterson that suit was brought in view of its failure to respond or indicate in any manner its intentions with respect to its infringing product. (Plaintiff's Ex. No. 14).

33. Peterson made no efforts to cease its infringing activities either in the time period spanning the December 10, 1999, letter and the January 19, 2001, letter, or for that matter, up and until the commencement of this trial. (Plaintiff's Ex. No. 17 & Updated Sales Figures provided by Peterson in response to this Court's request).

34. During the period between December 16, 1999, and September 19, 2002, Peterson sold 3,723 ember flame burner units ("ember burners"). (Tr., vol. 2, pg. 181 and Peterson Company's Objection to Golden Blount's Motion for Updated Damages filed on September 18, 2002).

35. Peterson's ember burner is intended to be attached to its G-4 series burner system or G-5 series burner system. (Joint Pretrial Order--Stipulations, pg. 6). In addition to selling the ember

burner, Peterson also sells log sets that can be used with the ember burner and often uses the ember burner to entice their customers to come back in and buy new log sets. (Tr. vol. 2, pg 178).

36. The G-4 and G-5 series burner systems are substantially identical except that Peterson pre-assembles the G-5 burner system according to certain Canadian Gas Association specifications. (Tr., vol. 2, pg. 179).

37. At least 10 of the 3,723 Ember burners sold by Peterson were included on the pre-assembled G-5 series burner systems. (Oct. 5, 2001, deposition of Mr. Leslie Bortz, pg. 154-55).

38. At trial, Blount introduced Plaintiff's Exhibit No. 4A, which is one of Peterson's manufactured products including a Peterson G-4 burner pan with Peterson's ember burner attached to it. Blount properly laid foundation for this Plaintiff's Exhibit No. 4A through the testimony of one of Peterson's own witnesses, Mr. Jankowski, who stated that he recognized Plaintiff's Exhibit No. 4A as Peterson's products. (Tr. vol. 2, pg. 145). Also, Mr. Blount, whose business competes with Peterson's, identified Plaintiff's Exhibit No. 4A as being Peterson's competing product. (Tr. vol. 1, pg. 144). This Court also finds that foundation for this device is further established because the Court finds it to be virtually identical to the picture on page 3 of Peterson's own general installation instructions (introduced at trial by Peterson as Defendant's Ex. No. D-34), except for the valve knob, which is not at issue.

#### LITERAL INFRINGEMENT-DIRECT

39. The construction of the claims appears under paragraphs 120 thru 123 of the Conclusions of Law section. The determination of infringement based on the construed claims is factual and is therefore organized here under the Findings of Fact.

40. The analysis with respect to the literal infringement of claim 1 is as follows:

The first element of claim 1 reads: "an elongated primary burner tube including a plurality of gas discharge ports." Based upon the totality of the evidence, including unrebutted testimony of Mr. Golden Blount and this Court's own observations of the accused device, it is this Court's finding that the primary burner tube is the fundamental burner tube used in a majority of all gas operated fireplaces. Similarly, the plurality of gas discharge ports allow the flammable gas to escape from the primary burner tube and be ignited to provide a flame. Blount presented the unrebutted oral testimony of Mr. Blount, who using an infringement chart (Plaintiff's Ex. No. 9) as a guide, testified

that Peterson's manufactured products include a primary burner tube having gas discharge ports therein. (Tr., vol. 1, pg. 45-50). In addition to this un rebutted testimony, this Court had the opportunity to closely observe an assembled version of Peterson's manufactured product<sup>3</sup>, wherein this Court observed Peterson's manufactured product having the primary burner tube including two or more gas discharge ports. (Tr., vol. 2, pg. 28). Peterson even admitted and stipulated to the presence of this element in its device. (Tr., vol. 2, pg. 173; Joint Pretrial Order--Stipulations, pg. 6). Further, Peterson never presented any evidence that its manufactured products did not contain the aforementioned claimed element. Thus, Peterson's manufactured products meet the first limitation of claim 1, which reads: "an elongated primary burner tube including a plurality of gas discharge ports."

41. The second element of claim 1 reads: "a secondary coals burner elongated tube positioned forwardly of the primary burner tube." Given the claim interpretation as set forth by the Court of Appeals for the Federal Circuit and based upon the totality of the evidence, the secondary coals burner elongated tube is positioned toward the opening of the fireplace, at least as compared to the primary burner tube, and is designed to provide a realistic flame, likened to a flame that might emanate from burning coals. Blount again presented evidence in the form of oral testimony of Mr. Blount, that Peterson's manufactured products include a secondary coals burner elongated tube, and that it is positioned forwardly of the primary burner tube. (Tr., vol. 1, pg. 45-50). Based on this Court's close observation of Peterson's manufactured product<sup>4</sup>, this Court finds that Peterson's manufactured products contain the claimed secondary coals burner elongated tube, which in Plaintiff's Exhibit No. 4A is Peterson's Ember Flame Booster (ember burner), and that it was positioned forwardly the primary burner tube. (Tr., vol. 2, pg. 28). Peterson even admitted and stipulated to the presence of this element in its device. (Tr., vol. 2, pg. 173; Joint Pretrial Order--Stipulations, pg. 6). Further, Peterson never presented evidence that conclusively established that its manufactured products did not contain the aforementioned claimed element. Thus, Peterson's manufactured products meet the second limitation of claim 1, which reads: "a secondary coals burner elongated tube positioned forwardly of the primary burner tube."

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<sup>3</sup> See Finding of Fact No. 38, discussed above.

<sup>4</sup> See Finding of Fact No. 38, discussed above.

42. The third element of claim 1 reads: "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position[ed] secondary coals burner elongated tube." The previous two paragraphs already demonstrate that Peterson's manufactured products include both the elongated primary burner tube and the forwardly positioned secondary coals burner elongated tube. The only additional limitation added by this element is that a support means holds the elongated primary burner tube in a raised level relative to the secondary coals burner elongated tube. Peterson's manufactured products include a support means that holds the primary burner tube. Actually, Peterson's support means, which is an industry standard pan, is substantially identical if not completely identical, in shape and function to the support means illustrated in the '159 patent. (Tr., vol. 1, pg. 47). The question for this Court to rule on is whether Peterson's support means holds Peterson's elongated primary burner tube in a raised level relative to its secondary coals burner elongated tube. As affirmed by the Court of Appeal for the Federal Circuit, this Court construes the term "raised level" to mean that the top of the primary burner tube is at a raised level with respect to the top of the secondary burner tube. Blount offered evidence at trial that the top of Peterson's primary burner tube was higher than the top of Peterson's ember burner tube, by demonstrating before this Court, using a carpenter's level laid across the tops of the tubes of Plaintiff's Exhibit No. 4A, that Peterson's primary burner tube was raised with respect to its secondary burner. (Tr., vol. 2, pg. 28). Even Peterson's own patent attorney, Mr. McLaughlin, admitted during the demonstration that "assuming the table is level, the top of the front burner is below the top of the rear burner." (Tr., vol. 2, pg. 29). Also, Peterson's executive Mr. Bortz admitted that the top of the ember burner was lower than the top of the primary burner. (Tr., vol. 2, pg. 42). Similarly, Mr. Corrin testified that the tube is below the top of the main burner tube. (Tr., vol. 2, pg. 173 and Defendant's Ex. No. 8). The above evidence was, for the most part, un rebutted because Peterson based the majority of its case in chief on the argument that the relative height of the primary burner tube with respect to the secondary coals burner elongated tube should be measured from the bottoms of the respective tubes, or the ports. This Court further observed a general set of instructions included within the box of each ember burner, (Defendant's Ex. No. D-34 at pg. 3), which instructs the person assembling the device to tighten the Ember Flame Booster (ember burner) so that the valve faces forward and flush with the burner pan. According to the testimony of Mr. Bortz, the normal configuration is to have the valve resting on the fireplace floor because it serves as a support

for the ember burner. (Leslie Bortz Deposition, vol. 1, pg. 70-71). At trial, and as observed by this Court, when the valve was resting on the table flush with the pan, the top of the primary burner was above the top of the ember burner. Additionally, Peterson actually offered to this Court, (Defendant's Ex. No. D-30), which it stated was provided to customers and installers to illustrate how to properly install the assembly. (Tr. vol. 2, pg. 183). While Defendant's Exhibit No. D-30 was offered in an attempt to establish non-infringement based upon Peterson's asserted bottoms test that it was proposing, the instructions clearly illustrate that Peterson's preferred installation has the tops of the primary burner tube being in a raised level with respect to the tops of the secondary coals burner elongated tube. Thus, given the above discussed interpretation, and in view of the evidence presented, Peterson's manufactured products meet the third limitation of claim 1, which reads: "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position[ed] secondary coals burner elongated tube."

43. The fourth element of claim 1 reads: "the secondary coals burner elongated tube including a plurality of gas discharge ports." Blount again presented oral testimony of Mr. Blount that the secondary coals burner elongated tube of Peterson's manufactured products include a plurality of gas discharge ports. (Tr., vol. 1, pg. 45-50). Further, this Court's close observation of Peterson's manufactured product<sup>5</sup> established that Peterson's secondary coals burner elongated tube includes a plurality of gas discharge ports. (Tr., vol. 2, pg. 28). Peterson also admitted to the presence of a plurality of gas discharge ports or jets, (Tr., vol. 2, pg. 174), and mentions this claimed element in its installation instructions. (Defendant's Ex. No. D-34). Further, Peterson never presented any evidence that its manufactured products did not contain the aforementioned claimed element that successfully rebuts Blount's evidence on this point. Thus, Peterson's manufactured products meet the fourth limitation of claim 1, which reads: "the secondary coals burner elongated tube including a plurality of gas discharge ports."

44. The fifth element of claim 1 reads: "the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means." Blount presented the oral testimony of Mr. Blount that Peterson's manufactured

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<sup>5</sup> See Finding of Fact No. 38, discussed above.

products include the tubular connection means and that the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and tubular connection means. (Tr., vol. 1, pg. 45-50). Additionally, this Court physically observed this claimed element in Peterson's manufactured product<sup>6</sup>, (Tr., vol. 2, pg. 28), and again notes that the illustration in Defendant's Exhibit No. D-34 shows this tubular connection means. Moreover, Peterson never presented any evidence that its manufactured products did not contain the aforementioned claimed element. Thus, Peterson's manufactured products meet the fifth limitation of claim 1, which reads: "the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means."

45. The sixth element of claim 1 reads: "a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means." The evidence as established by Mr. Blount's testimony, Peterson's general instructions (Defendant's Ex. No. D-34), and this Court's own inspection of Plaintiff's Exhibit No. 4A, confirms the presence of the valve. (Tr., vol. 1, pg. 45-50 and vol. 2, pg. 28). Peterson even admitted and stipulated to the presence of this element in its device. (Tr., vol. 2, pg. 173; Joint Pretrial Order--Stipulations, pg. 6). Further, Peterson never presented any evidence that its manufactured products did not contain the aforementioned claimed element. Thus, Peterson's manufactured products meet the sixth limitation of claim 1, which reads: "a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means."

46. The seventh element of claim 1 reads: "the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube." Blount again presented the oral testimony of Mr. Blount that the primary burner tube of Peterson's manufactured products would ultimately be coupled to a gas source with a gas flow control means therein for controlling gas flow into the primary burner tube. (Tr., vol. 1, pg. 45-50). Furthermore, the parties stipulated prior to the commencement of the trial that "Robert H. Peterson Co.'s ember burner is intended to be attached to its G-4 series burner system or G-5 series burner system and the combined unit comprises a primary burner pipe, an ember pan that supports the

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<sup>6</sup> See Finding of Fact No. 38, discussed above.

primary burner pipe, a secondary burner tube and a valve that controls a flow of gas between the primary burner pipe and the secondary burner tube, and that an end user *would* connect the primary burner pipe to a gas source having a valve associated therewith." (Joint Pretrial Order--Stipulations, pg. 6). Thus, Peterson's manufactured products would ultimately meet the seventh limitation of claim 1, which reads: "the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube."

47. This Court finds that the above evidence is substantial and it clearly establishes that Peterson's accused device contains each and every element of claim 1 of the '159 patent.

48. The evidence presented at trial establishes that Peterson provided its customers with two sets of installation instructions. One set was a general set of instructions, (Defendant's Ex. No. D-34 at pg. 3), which instructs the person assembling the device to tighten the Ember Flame Booster (ember burner) so that the valve faces forward and flush with the burner pan. According to the testimony of Mr. Bortz, the normal configuration is to have the valve resting on the fireplace floor because it serves as a support for the ember burner. (Leslie Bortz Deposition, vol. 1, pg. 70-71). At trial, and as observed by this Court, when the valve is resting on the table flush with the pan, the top of the primary burner is above the top of the ember burner. The other set of instructions, (Defendant's Ex. No. D-30), was very specific in the way in which the ember burner was to be oriented with respect to the primary burner. When the device is installed pursuant to these instructions, Defendant's Exhibit No. D-30 clearly shows that the top of the primary burner is above the top of the ember burner. Thus, both of these instructions consistently show that when the G-4 or the G-5 and the ember burner of Peterson's accused device are installed pursuant to these instructions, it would result in an infringing configuration.

49. Although Peterson did not make this argument at any time during trial, Peterson asserts on remand that Blount has not established direct infringement by it or its customers because Blount never directly proved how the devices were actually assembled. Peterson, instead relied on its case-in-chief that it did not infringe because of its urged claim construction and that the '159 patent was invalid, both of which this Court and the Federal Circuit rejected. Moreover, Peterson's position is against the weight of the evidence, both direct and circumstantial, in this case. This Court finds that the evidence clearly supports a case of direct infringement, not only by Peterson, but by its customers as well. Case law holds that when instructions are provided with an infringing device, it can be

circumstantially inferred that the customer follows those instructions with respect to the accused device. Thus, it is reasonable for this Court to conclude that both Peterson and its customers would have assembled the devices in the way set forth in both sets of Peterson's assembly instructions. Peterson's direct infringement of claim 1 is established by the testimony of Messrs. Bortz and Corrin, both corporate officers of Peterson, who testified that Peterson assembled and operated the infringing device for distributors so they had the opportunity to see how the item worked. (Tr., vol. 2, pg. 65-66 and 199). In addition, Peterson itself assembled and sold at least 10 G-5 devices with a preassembled ember burner, which are the same as the G-4 except for being preassembled to comply with ANSI regulations. Mr. Bortz testified that he was sure that the ember burner was used with the G-5 because Peterson preassembled it and put it together, presumably in accordance with its own instructions. (Leslie Bortz Deposition, vol. 1, pg. 36). There has been no reasons given to this Court why Peterson didn't assemble these devices in accordance with its own instructions. Thus, the record establishes direct infringement on the part of Peterson itself.

50. Direct infringement by the ultimate purchasers of claim 1 is established by the evidence that proves that Peterson supplied all the required elements of claims 1, 15 and 17 of the '159 patent, as well as installation instructions, (Defendant's Ex. Nos. D-34 & D-30; Tr. vol. 2, pg. 177, 183), to its ultimate purchasers. It is reasonable to conclude that these instructions were used by Peterson's ultimate customers to assemble the ember burner, its associated components, and connect it to a gas source as stipulated by the parties. (Tr., vol. 1, pg. 45-50). These facts provide this Court with both direct and circumstantial evidence to find that direct infringement of claim 1 did indeed occur by Peterson's ultimate consumers.

51. Therefore, Blount has clearly established direct infringement on the part of Peterson and the ultimate purchaser of claim 1 of the '159 patent.

52. Dependent claim 15 includes all of the elements of independent claim 1 plus the element that "the open frame pan and primary elongated burner tube is positioned under an artificial logs and grate support means." Literal infringement of dependent claim 15 is particularly important because claim 15 includes the artificial logs and the grate support means. As set forth above, Peterson also manufactures and sells logs and other accessory items that can be sold with its G-4 or G-5 and the ember burner, and in fact uses the ember burner to entice customers to come back and buy new logs. (Tr., vol. 2, pg 178).

53. Sufficient evidence exists in the record to establish that Peterson's burner will ultimately be positioned under an artificial logs and grate support means. Therefore, Blount has clearly established direct infringement on the part of Peterson and the ultimate purchaser of claim 15 of the '159 patent.

54. This Court further concludes that in addition to directly infringing independent claims 1 & 15 of the '159 patent, Peterson and the ultimate purchasers directly infringe independent claim 17 of the '159 patent.

55. With the exception of a few additional elements included in independent claim 17 not included in independent claim 1, and a few elements included within independent claim 1 that are not included within independent claim 17, claims 1 and 17 are substantially similar.

56. Independent claim 17 does not include the claim limitation of independent claim 1 that the primary burner is in communication with a gas flow control means. Thus, this element need not be found in Peterson's manufactured products to find direct infringement by Peterson of independent claim 17.

57. The first element of independent claim 17 recites: "a secondary coals burning elongated tube," and is similar to the fourth element of independent claim 1. Accordingly, the discussion above with respect to the fourth element of independent claim 1 may be applied to the first element of independent claim 17. Thus, Peterson's manufactured products will ultimately meet the first limitation of claim 17, which reads: "a secondary coals burning elongated tube."

58. The second element of independent claim 17 recites: "a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube being in gas flow communication with the primary burner tube being the connection means, gas distribution ports of the secondary burner tube directed away from the fireplace opening."

59. Thus, independent claim 17 requires that the gas distribution ports of the secondary burner tube be directed away from the fireplace opening. As specifically construed and affirmed by the Court of Appeals for the Federal Circuit, this Court previously construed the term "directed away from" to mean that the gas ports of the secondary burner tube may be positioned in any direction that does not include a horizontal component pointed toward the vertical plane of the fireplace opening.

*Golden Blount, Inc. v. Robert H. Peterson Co.*, 365 F.3d 1054, 1059-60 (Fed. Cir. 2004). Blount presented oral testimony of Mr. Blount that the gas ports of Peterson's manufactured products are positioned directly down, which according to the above-referenced interpretation, are away from the fireplace opening. (Tr., vol. 1, pg. 45-50). In addition to this testimony, this Court closely observed an assembled version of Peterson's manufactured product<sup>7</sup>, wherein it observed the manufactured product having the gas ports directed away from the fireplace opening. (Tr., vol. 2, pg. 28). Because Peterson believed the term "directed away from" would ultimately be construed to mean that the ports must be directed at least partially toward the back of the fireplace, Peterson went so far as to require the ports of its secondary burner tube to be positioned directly downward. Given the claim construction as construed and affirmed by the Federal Circuit, this required configuration results in a device that meets the "directed away from" limitation of claim 17.

60. As the other claimed elements of the second limitation of independent claim 17 have been found in Peterson's manufactured products, as established above with respect to paragraphs 40 thru 46, this Court finds that the evidence establishes direct infringement by Peterson and by the ultimate purchasers of Peterson's products of claim 17. Moreover, the evidence establishes that Peterson itself directly infringed claim 17 when Peterson assembled the G-5 series burner systems and then sold them to customers.

61. Therefore, this Court finds that Peterson and the ultimate purchaser directly infringed at least claims 1, 15 and 17, as construed under paragraphs 120 thru 123 below, of the '159 patent.

#### LITERAL INFRINGEMENT-CONTRIBUTORY

62. Blount established at trial, through stipulation, that Robert H. Peterson Co.'s ember burner is intended to be attached to its G-4 series burner system or G-5 series burner system and the combined unit comprises a primary burner pipe, an ember pan that supports the primary burner pipe, a secondary burner tube and a valve that controls a flow of gas between the primary burner pipe and the secondary burner tube, and that an end user would connect the primary burner pipe to a gas source having a valve associated therewith. (Joint Pretrial Order--Stipulations, pg. 6).

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<sup>7</sup> See Finding of Fact No. 38, discussed above.

63. Peterson was made aware of the '159 patent as early as December 16, 1999, by the letter from Mr. Tucker, which is referenced above. (Plaintiff's Ex. No. 10). Given these facts, it is clear that Peterson was aware that the combination for which its components were especially made was patented and infringing, as required by 35 U.S.C. § 271(c).

64. Blount further established through the testimony of Mr. Bortz that Peterson's ember burner is especially adapted for use in an infringement of the '159 patent, had no substantial non-infringing uses, and that it was intended to be used with both the G-4 and G-5 burner pans. (Tr., vol. 2, pg. 67; Leslie Bortz Deposition, vol. 1, pg. 36). Thus, the Court also finds that the testimony of Mr. Bortz and Mr. Corrin, as well as Mr. Blount, supports the fact that the ember burner was not a staple article of commerce.

65. As discussed above, this Court finds that direct infringement existed. For those units covered by stipulation for hookup, they were normally hooked up by professional installers or persons from the dealer. With their experience and relation to Peterson and with all of Peterson's literature (including Defendant's Ex. Nos. D-34 & D-30) one can count on proper installations pursuant to Peterson's installation instructions as discussed above. Thus, each installation ultimately results in a direct infringement. (Tr., vol. 2, pg. 189). Blount has clearly proven contributory infringement on the part of Peterson of claims 1, 15 and 17 for those units.

#### LITERAL INFRINGEMENT-INDUCEMENT

66. The record establishes that Peterson sold the ember burner. In addition, the record also establishes that Peterson sold the G-4, which includes the primary burner and support pan, and sold the G-5, ten at least of which, had the ember burner attached. Further, given the stipulation that the ultimate assembly would be connected to a gas source, there is sufficient basis to conclude that Peterson knew or should have known that this ultimate configuration would infringe independent claims 1 and 17. (Joint Pretrial Order--Stipulations, pg. 6).

67. Peterson was made aware of the '159 patent as early as December 16, 1999, by the letter of December 10, 1999, from Mr. Tucker, which is referenced above. (Plaintiff's Ex. No. 10). Given these facts, it is clear that Peterson was aware that the combination for which its components were especially made was patented and infringing.

68. The record is also clear that Peterson provided literature and assembly instructions to consumers, as discussed above, detailing how to install the components in a preferred configuration, which induced its customers to install the components in an infringing manner. (Tr., vol. 2, pg. 173-174, 177, 183; Defendant's Ex. Nos. D-34 & D-30). Also, Peterson fully assembled and hooked up in a fireplace an accused structure and demonstrated it and its use to independent distributors, which this Court finds to be a substantial inducement.

69. Because Peterson provided the consumers with detailed instructions, (Defendant's Ex. Nos. D-34 & D-30), how to assemble the parts in an infringing manner, and given the fact that Peterson had knowledge of the '159 patent by way of the notice letter of December 16, 1999, Peterson knew or should have known that such actions would induce direct infringement. Thus, there is little doubt and almost a certainty that the installation was in fact done in accordance with Peterson's published installation instructions. The demonstrations of a properly connected device to distributors further shows inducement because this information was passed on to dealers and ultimately to assemblers and customers. Invariably, infringement occurred. (Tr., vol. 2, pg. 189).

70. As found by this Court in paragraphs 40 thru 61 above, there was direct infringement by Peterson or its ultimate purchasers of claims 1, 15 and 17 of the '159 patent.

71. Accordingly, this Court finds that in those instances where direct infringement by Peterson was not conclusively established on a unit by unit basis, Blount has clearly proven induced infringement on the part of Peterson of claims 1, 15 and 17 for those units.

72. Because Peterson's manufactured products literally infringe claims 1, 15 and 17 of the '159 patent, they infringe the patent. Thus, comparison of Peterson's product to the remaining claims depending from independent claim 1, whether it be in determining direct infringement, contributory infringement or induced infringement, is generally unnecessary and is therefore not addressed herein.

#### INFRINGEMENT-DOCTRINE OF EQUIVALENTS

73. Blount offered un rebutted testimony at trial that every element of Peterson's manufactured products perform substantially the same function in substantially the same way to obtain the same result as the claimed elements of the '159 patent. (Tr., vol. 1, pg. 59-60).

74. Blount further offered un rebutted testimony by Mr. Blount at trial that any difference between Peterson's manufactured products and the claim elements were insubstantial at best. Mr. Blount

actually testified that they were an exact copy. (Tr., vol. 1, pg. 30, 37, 46, 48, 56 and 60). In addition, through this Court's own observance of the accused product 4A, this Court finds that there was a substantial equivalent of each and every element of at least claims 1, 15 and 17 in Peterson's accused products.

75. Based on the evidence presented to it, this Court finds that there is no prosecution history estoppel that limits the range of equivalents regarding the claimed elements.

76. Thus, this Court finds that in those instances where literal infringement might not exist, there is infringement of the claims of the '159 patent under the doctrine of equivalence.

77. In summation, this Court concludes that Blount established literal infringement (e.g., directly, by inducement, or contributorily) or infringement under the doctrine of equivalents, each of claims 1, 15 and 17 of the '159 patent, by Peterson by at least a preponderance of the evidence.

#### DAMAGES

78. Damages have been determined using the *Panduit* factors. Mr. Blount testified for Blount at trial as to the demand that existed for the product during the period in question. (Tr., vol. 1, pg. 61). Thus, Blount has conclusively established the first required element of *Panduit*.<sup>8</sup>

79. In addition to establishing a demand for the patented product during the period in question, Blount established an absence, during the period of infringement, of acceptable non-infringing substitutes. (Tr., vol. 1, pg. 63-65).

80. Peterson argued that other acceptable non-infringing substitutes exist.

81. Here the patented product offers quite unique and novel results. (Tr., vol. 1, pg. 28-30). The so called "acceptable non-infringing substitutes" Peterson has introduced are either not acceptable, or they too infringe, although no third party infringing device was offered by either side.

82. Blount established at trial that Peterson's front flame director was not an acceptable substitute. (Tr., vol. 2, pgs. 184, 195). Peterson's own Vice President, Mr. Corrin, testified that the front flame director lacked the valve for adjusting the height of the front flame. Even more telling, Mr. Corrin testified that the front flame director was not as good as their ember burner. (Tr., vol. 2, pgs. 184, 195).

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<sup>8</sup> See the Conclusions of Law section, paragraph 151, where the *Panduit* factors are set forth.

83. As the valve to adjust the height of the front flame is one of the particular features available only from the patented product, under the law set forth in *Standard Havens*, the front flame director, lacking that valve or any adjustment means, is not an acceptable non-infringing substitute.

84. Peterson further argues that Blount admitted at trial that at least five products on the market perform roughly the same function as Blount's patented device. (Tr., vol. 1, pg. 63). The record is clear that those five products were infringing substitutes and not acceptable non-infringing substitutes. (Tr., vol. 1, pg. 63). In fact, the record indicates that Blount sent the manufactures of those five products the identical notice of infringement letter at the same time it sent Peterson its letter. (Tr., vol. 1, pg. 63). No evidence exists in the record that the aforementioned five instances of infringement continued after the notice of infringement letters were received. In fact, Mr. Blount's testimony indicates that while the other companies were moving in and were interested in the outcome of this trial, none were still infringing after receipt of their notice of infringement letter. (Tr., vol. 1, pg. 62-64).

85. Therefore, this Court finds that Blount provided sufficient evidence to support the finding that there were no acceptable non-infringing substitutes that could have decreased the market share Blount and Peterson together held. Thus, Blount has conclusively established the second required element of *Panduit*.

86. Blount also offered sufficient evidence through Mr. Blount's testimony that Blount had more than enough manufacturing and marketing capability to promote the device, thus entitling Blount to actual damages. (Tr., vol. 1, pgs. 62, 66). Thus, Blount has conclusively established the third required element of *Panduit*.

87. Because the *Panduit* factors have been established, it is reasonable for this Court to infer that the lost profits claimed were in fact caused by Peterson's infringing sales. This Court now only needs to determine a detailed computation of the amount of profit Blount would have made, to meet the final required element of *Panduit*.

88. In addition, however, the Court also finds that the facts of the present case establish a two-supplier market. Blount offered evidence through the testimony of Mr. Blount that Blount and Peterson together held approximately 95 percent or more of the market associated with ember burners similar to that covered by the '159 patent. (Tr., vol. 1, pg. 64). While Peterson attempted to impeach Mr. Blount's testimony on this point, this Court finds that Peterson failed to do so.

Therefore, this Court finds that Mr. Blount's testimony is sufficient to establish a two supplier market. The supposed 5 percent of the market that Blount and Peterson might not have held is de minimus, and therefore, for damage calculations a two-supplier market has been found to exist in this case. Therefore, causation may be inferred, that is, "but for" Peterson's infringing activities, Blount would have made the sales it normally would have made.

89. To determine the actual damage amount in a lost profit case, the Court can multiply Blount's per unit profit times the number of infringing devices that Peterson sold.

90. To do this, however, the Court must determine the device upon which lost profits are to be calculated.

91. Using two different approaches, Blount has established that the device for calculating lost profits includes the entire burner assembly (including the secondary burner and valve), the grate, and a full set of artificial logs. This Court finds that Blount ultimately lost the sale of the entire burner assembly (including the secondary burner and valve), the grate, and a full set of artificial logs.

92. Dependent claim 15, which was established as literally infringed above, recites that the gas-fired artificial logs and coals-burner of claim 1 are positioned under artificial logs and a grate support means. Because the artificial logs and the grate support means are positively claimed in dependent claim 15, the artificial logs and the grate support means should be included in the device upon which damages for direct infringement as well as lost profits are to be calculated.

93. Accordingly, the device for calculating lost profits includes the entire burner assembly (including the secondary burner and valve), the grate and a full set of artificial logs, which must be the case here, because apart from the artificial logs and grate, the coals burner unit has no purpose or function.

94. Given the circumstances, the entire market value rule is appropriate here as an alternative, second approach. Evidence was offered at trial by Peterson's own officer, Mr. Corrin, that Peterson used the ember burner to entice customers to come back to the store to purchase newer log sets, and at the same time, purchase Peterson's ember burner, which improved the overall appearance of the fireplace. (Tr., vol. 2, pg. 177-79). These facts are sufficient to establish that the ember burner is the basis for the customer's demand, as set forth by *TWM*, see *infra*.

95. Blount also offered evidence that the glowing embers from the ember burner are what draws a customer's attention to a particular log and burner set, and what ultimately makes the sale. (Tr., vol. 1, pg. 157-63).

96. Blount also offered testimony at trial that the elements of independent claims 1 and 17 constitute a functional unit with the artificial logs and the grate support.

97. Blount presented a third-party witness retailer, Mr. Charlie Hanft of Atlanta, with extensive sales experience with gas fireplaces and ember burner and gas log sets. He testified that 97 ½ percent of the time that he sells an ember burner, he also sells an entire burner assembly and log set with it. (Tr., vol. 1, pg. 160). Peterson did not successfully rebut Blount's evidence on this point because Peterson presented no testimony to quantify even in a general way when the two would not ultimately be sold together.

98. Peterson failed to rebut Blount's evidence because it did not offer any numerical evidence regarding how often it sells one of its Ember burners with the entire burner and log set.

99. In summation of this point, Blount introduced testimony as to the standard practice in the industry for selling the ember burner, and Peterson failed to introduce its own testimony to rebut Blount's testimony.

100. Because the evidence establishes that 97 ½ percent of the sales of the ember burner would also encompass the sale of the entire burner assembly and log set, the record supports a proration of the damage amount based upon this percentage.

101. Based on the record, of the 3,723 EMB's sold by Peterson, 2 ½ percent (i.e., 94 EMB's) were sold without an associated burner assembly and log set, and the remaining 97 ½ percent (i.e., 3,629) were sold with an associated burner assembly and log set.

102. Blount established at trial that its profit on the ember burner alone is \$14.09 per unit and its profit on the ember burner, entire burner assembly and full set of logs is \$117.92 per unit. (Plaintiff's Ex. No. 18).

103. This Court finds, based on the percentages and profits established in the paragraphs above, that the total actual damages amount to \$429,256.

WILLFULNESS / EXCEPTIONAL CASE

104. Having carefully reviewed the record herein, the Court concludes that Peterson's minimal attempt to attain a competent opinion is permeated by a lack of due care and was willful, which leads this Court to find that the case is exceptional. Blount has established by clear and convincing evidence that Peterson's supposed oral opinion was an incompetent, conclusory opinion to be used only as an illusory shield against a later charge of willful infringement, rather than in a good faith attempt to avoid infringing another's patent.

105. Throughout the 2½ years from the time the first notice letter was sent, Peterson simply never obtained a single written opinion suggesting that their commercial embodiment avoided infringement. Also, the denial that the first letter related to notice of infringement is shown unlikely by Mr. Corrin's own characterization of it as an "*infringement letter*" in his correspondence with his patent counsel. (Tr., vol. 2, pg. 192). Also, this Court finds it disingenuous for Peterson to argue at trial that the interrogatories answered well after suit was filed and during discovery, form the written opinion upon which they relied.

106. The first time Peterson spoke to Mr. McLaughlin was on or about December 30, 1999, however, Mr. McLaughlin did not have the accused infringing device at this time. (Tr., vol. 1, pg. 181). The record establishes that Mr. McLaughlin, at this time, only had a picture of the accused infringing device. (Tr., vol. 1, pg. 181). Neither did Mr. McLaughlin have the prosecution history of the '159 patent at this time, which is an important element of any competent opinion. (Tr., vol. 1, pgs. 183, 202-03).

107. This non-substantive conversation cannot be construed to be an opinion upon which Peterson could reasonably rely because it was based solely on a supposition. This supposition amounted to a representation on the part of Mr. Bortz that the invention had been around 20 to 30 years. (Tr., vol. 2, pg. 55-56). Mr. McLaughlin, with only the evidence listed above, said that "if we *could* prove that the invention had been around for 20 to 30 years then it *would* be a strong argument of invalidity." (Tr., vol. 2, pg. 55-56, emphasis added). This "if this, then that" statement plainly does not amount to an opinion upon which a prudent person could reasonably rely.

108. Importantly, this Court has found that Peterson made no further efforts to determine whether it was truly infringing or not, until after suit was filed, almost a year and two months after receiving the first notice letter. (Tr., vol. 1, pg. 202-03).

109. Peterson argues that it did nothing further because it was awaiting "additional information or further explanation from Blount's attorney." This Court finds this argument lacking merit. Blount did not, after sending multiple notice of infringement letters to Peterson under the law, owe Peterson any obligation with regard to advising Peterson how they actually were infringing.

110. Nevertheless, Blount's failure to respond to Peterson's additional information request did not relieve Peterson of its obligation to determine if it was willfully infringing the '159 patent.<sup>9</sup> To the contrary, Peterson continued its infringing activities even after May 16, 2000, and actually even through the trial proceedings. (Tr., vol. 2, pg. 181 and Peterson Company's Objection to Golden Blount's Motion for Updated Damages filed on September 18, 2002). This reflects an egregious and willful disregard for the '159 patent.

111. It was not until after the lawsuit was filed in January 2001 that Peterson finally became concerned, not with the damages associated with the infringing activity, but apparently with the attorney's fees that Peterson might be required to pay as a willful infringer. (Tr., vol. 2, pg. 60-62). By Mr. Bortz' own admission, he told Mr. McLaughlin that this was not a very meaningful case "dollar wise" but that he heard a person might have to pay attorneys' fees if he loses a patent lawsuit, and he asked Mr. McLaughlin what he should do. (Tr., vol. 2, pg. 60-62 & Dec. 19, 2001, deposition of Mr. Leslie Bortz, pg. 60). Mr. McLaughlin told him that one way that attorney's fees could be avoided was by obtaining an opinion. (Id). This set of facts underscores Peterson's true intentions with respect to its willful disregard of the '159 patent, that it was concerned more with having to pay attorneys' fees than it was with its own infringement. The Court finds that this constitutes an intentional disregard for the '159 patent on the part of Peterson.

112. At no time when Mr. McLaughlin gave Mr. Bortz advice did Mr. McLaughlin ever see the actual accused structure. (Tr., vol. 1, pg. 181). While some advertisements of Peterson's structure were shown, detailed drawings were never provided at this time to Mr. McLaughlin, including the installation instructions that were apparently sold with the device. Thus, Mr. McLaughlin never had a full understanding of the accused structure, (Tr., vol. 1, pg. 200), and Mr. McLaughlin should have known that his opinion would not be reasonable without such an understanding.

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<sup>9</sup> See also, Finding of Fact No. 30.

113. While Peterson argues that three oral consultations occurred, this Court finds that only one oral opinion of counsel, if it can even be called that, was rendered. This oral opinion was rendered by Mr. McLaughlin on or about May 1, 2001, about 4 months after suit had been filed and 2½ years after Peterson was first noticed of its infringing activity. (Tr., vol. 1, pg. 179-83).

114. This Court believes that Peterson did get what it asked for, a statement that there was no infringement. Peterson's primary desire, however, was to avoid paying attorneys' fees or increased damages, and this appears to have been the sole reason for consultation with counsel, and these actions show a willful and egregious disregard for the '159 patent.

115. In summary, this Court finds that Peterson had three consultations with its Attorney. All were oral. Only the last oral consultation approached what was needed to determine infringement and validity issues, and even it was made with a search limited to the company's own records and with there having been no accused structure shown the patent attorney. This third consultation occurred a number of months after suit had been filed and was motivated by the apprehension of Peterson having to pay attorneys' fees, and not for a concern of infringement of the '159 patent.

116. Peterson's cavalier attempt to obtain an opinion and the non-persuasive trial testimony of Peterson's witnesses are classic examples of conduct that clearly and convincingly demonstrates an exceptional case, an indication of which is gross willfulness.

117. This Court therefore finds that the infringement of Peterson was willful, thus the actual damages are trebled, totaling \$1,287,766.

118. Given Peterson's conduct and its overall willful disregard for the '159 patent, such an award is appropriate here. The Court finds that as a result of Peterson's continued infringement, without a reasonable basis for believing that it had a right to make, use or sell its product prior to the expiration of the '159 patent, Blount has been compelled to prosecute an infringement claim at great expense. Under these circumstances, an award of attorneys' fees is proper in addition to the enhanced damage award.

119. This Court therefore finds this to be an exceptional case under 35 U.S.C. § 285, thus reasonable attorneys' fees are awarded to Blount.

## CONCLUSIONS OF LAW

### CLAIM CONSTRUCTION

120. The parties dispute the meaning of two terms in the claims of the patent in suit, namely the phrase "raised level," as recited in claim 1, and the term "below" and the phrase "away from the fire place opening," as recited in claim 17.

121. As affirmed by the Court of Appeals for the Federal Circuit in its opinion dated April 19, 2004, this Court construes that the term "at a raised level" in claim 1 refers to the top of the two burner tubes, and that the tops of the tubes should be used to determine whether the primary burner tube is held at a raised level with respect to the secondary burner tube as recited in claim 1. This Court also construes that the term "below" in claim 17 refers to the tops of the two burner tubes, and that the tops of the tubes should be used to determine whether the secondary burner tube is positioned below the primary burner tube as recited in claim 17. *Golden Blount, Inc. v. Robert H. Peterson Co.*, 365 F.3d 1054, 1059-60 (Fed. Cir. 2004).

122. As affirmed by the Court of Appeals for the Federal Circuit in its opinion dated April 19, 2004, this Court construes the term "away from the fireplace opening" to mean that the gas ports may be positioned in any direction that does not include a horizontal component pointed toward the vertical plane of the fireplace opening. *Id.*

123. All the other terms in the claims at issue are construed to have a plain and ordinary meaning, which appear not to have been contested at trial.

### VALIDITY

124. A validity analysis begins with the presumption of validity. An issued patent is presumed valid. 35 U.S.C. § 282.

125. An "accused infringer who raises patent invalidity as a defense bears the burden of showing invalidity by facts supported by clear and convincing evidence." *Robotic Vision Systems, Inc. v. View Engineering, Inc.*, 189 F.3d 1370, 1377 (Fed. Cir. 1999); *Weatherchem Corp. v. J.L. Clark, Inc.*, 163 F.3d 1326, 1334-35 (Fed. Cir. 1998).

126. As affirmed and determined by the Court of Appeals for the Federal Circuit on April 19, 2004, this Court concludes that Peterson has failed to prove by clear and convincing evidence that

the '159 patent is invalid. This Court therefore finds the '159 patent not to be invalid. *Golden Blount, Inc.* at 1061-62.

#### LITERAL INFRINGEMENT-DIRECT

127. The claims define the metes and bounds of the invention, and only they may be infringed. *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 882 (Fed. Cir. 1988); *Corning Glass Works v. Sumitomo Elec. USA, Inc.*, 868 F.2d 1251 (Fed. Cir. 1989).

128. The patentee's burden is to show literal infringement by a preponderance of the evidence. *Braun v. Dynamics Corp.*, 975 F.2d 815 (Fed. Cir. 1992).

129. A patent claim is literally infringed if the accused product or process contains each element of the claim. *Tate Access Floors v. Maxcess Techs.*, 222 F.3d 958, 964 (Fed. Cir. 2000); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1054 (Fed. Cir. 1988). If each element is present, literal infringement exists and "that is the end of it." *Graver Tank v. Linde Co.*, 339 U.S. 605, 607, 94 L. Ed. 1097, 70 S. Ct. 854, 1950 Dec. Comm'r Pat. 597 (1950).

130. In determining infringement, the accused product is compared to the patent claims, not the patentee's product. *Zenith Laboratories, Inc. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1423 (Fed. Cir. 1994); *Glaxo Inc. v. TorPharm Inc.*, 153 F.3d 1366, 1373 (Fed. Cir. 1998).

131. Infringement of a single claim is infringement, *Panduit Corp. v. Dennison Mfg. Co. Inc.*, 836 F.2d 1329, 1330 n.1 (Fed. Cir. 1987); *Intervet America v. Kee-Vet Laboratories*, 887 F.2d 1050, 1055 (Fed. Cir. 1989), and entitles the patentee to the full panoply of statutory remedies. *Intervet*, 887 F.2d at 1055.

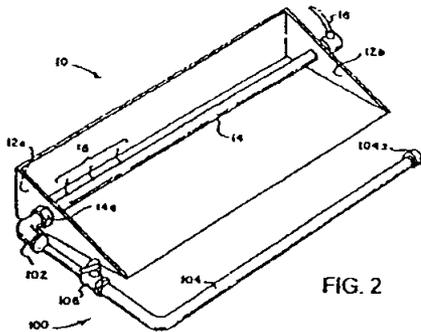
132. If one is arguing that proof of inducing infringement or direct infringement requires *direct*, as opposed to *circumstantial evidence*, the Federal Circuit disagrees. It is hornbook law that direct evidence of a fact is not necessary. "Circumstantial evidence is not only sufficient, but may also be more certain, satisfying and persuasive than direct evidence." *Metabolite Laboratories, Inc. v. Laboratory Corp. of America*, 370 F.3d 1354, 1365 (Fed. Cir. 2004) (citing *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1272 (Fed. Cir. 1986)).

133. In determining whether a product claim is infringed, the Federal Circuit has held that an accused device may be found to infringe if it is reasonably capable of satisfying the claim limitations,

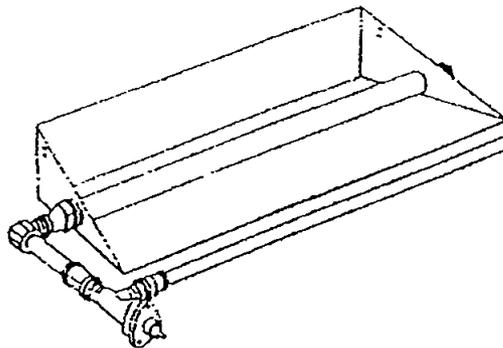
even though it may also be capable of non-infringing modes of operation. See, *Intel Corp. v. United States Int'l Trade Comm'n*, 946 F.2d 821, 832, 20 USPQ2d 1161, 1171 (Fed.Cir.1991); *Key Pharms., Inc. v. Hercon Labs. Corp.*, 981 F.Supp. 299, 310 (D.Del.1997), *aff'd*, 161 F.3d 709, 48 USPQ2d 1911 (Fed.Cir.1998); *Huck Mfg. Co. v. Textron, Inc.*, 187 USPQ 388, 408 (E.D.Mich.1975) ("The fact that a device may be used in a manner so as not to infringe the patent is not a defense to a claim of infringement against a manufacturer of the device if it is also reasonably capable of a use that infringes the patent."); cf. *High Tech Med. Instrumentation, Inc. v. New Image Indus., Inc.*, 49 F.3d 1551, 1556, 33 USPQ2d 2005, 2009 (Fed.Cir.1995).

134. Circumstantial evidence of product sales and instructions indicating how to use the product is sufficient to prove third party direct infringement. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1272 (Fed. Cir. 1986).

135. This Court understands that in determining infringement, the accused product is compared to the patent claims, not the patentee's product. However, FIG. 2 of the '159 patent is representative of the claims of the '159 patent and the claims may be read on the FIG. 2 structure. For this reason a comparison of one of Blount's devices and Peterson's manufactured product is highly instructive for purposes of this Court's analysis, and is, therefore, provided.



**Blount's Patented Device**  
FIG. 2 of the '159 Patent



**Peterson's Manufactured Product**  
Figure 2 of Peterson's Installation Instructions  
without the control knob shown

136. The findings in the sections above make out a clear case of direct infringement on all of the devices sold.

#### LITERAL INFRINGEMENT-CONTRIBUTORY

137. Contributory infringement liability arises when one "sells within the United States . . . a component of a patented machine . . . constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantially noninfringing use." 35 U.S.C. § 271(c) (2002).

138. Thus, Blount must show that Peterson "knew that the combination for which its components were especially made was both patented and infringing." *Preemption Devices, Inc. v. Minn. Mining & Mfg. Co.*, 803 F.2d 1170, 1174 (Fed. Cir. 1986).

139. An appropriate infringement notice letter from the patentee to the accused infringer provides the requisite knowledge required by 35 U.S.C. § 271(c). *Aro Manufacturing Co., Inc. v. Convertible Top Replacement Co.*, 377 U.S. 476, 490 (1964).

140. Further, Blount must show that Peterson's components have no substantially noninfringing uses, while meeting the other elements of the statute. *Alloc, Inc. v. ITC*, 342 F.3d 1361, 1374 (Fed. Cir. 2003).

141. It is not necessary for a plaintiff to make the direct infringer a party defendant in order to recover on a claim of contributory infringement. It is enough for the plaintiff to prove, by either circumstantial or direct evidence, that a direct infringement has occurred. *Amersham International PLC v. Corning Glass Works*, 618 F. Supp. 507 (D. Mich., 1985).

142. The findings in the sections above make out a clear case of Contributory infringement on all of the devices sold.

#### LITERAL INFRINGEMENT-INDUCEMENT

143. In order to find Peterson liable for inducing infringement under 35 U.S.C. § 271 (b), Blount must show that Peterson took actions that actually induced infringement. *Met-Coil Sys. Corp. v. Korners Unlimited, Inc.*, 803 F.2d 684, 687 (Fed. Cir. 1986) ("There can be no inducement of infringement without direct infringement by some party.")

144. Further, Blount must show that Peterson knew or should have known that such actions would induce direct infringement. *Micro Chem. Inc. v. Great Plains Chem. Co.*, 194 F.3d 1250 (Fed. Cir. 1999).

145. Dissemination of instructions along with sale of the product to an ultimate consumer is sufficient to prove infringement by an inducement. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1272 (Fed. Cir. 1986). Thus, Blount has met its burden of showing infringement under section 35 U.S.C. 271(b).

146. The findings in the sections above make out a clear case of induced infringement on all of the devices sold.

#### INFRINGEMENT-DOCTRINE OF EQUIVALENTS

147. Infringement under the doctrine of equivalents occurs when a claimed limitation and the accused product perform substantially the same function in substantially the same way to obtain the same result. See *Warner-Jenkinson Co. v. Hilton-Davis Chem. Co.*, 520 U.S. 17, 39-40, 137 L. Ed. 2d 146, 117 S. Ct. 1040 (1997).

148. Infringement under the doctrine of equivalents also requires that any difference between the claim elements at issue and the corresponding elements of the accused product be insubstantial. *Id.*

149. This Court finds alternatively (or cumulatively) that there was infringement under the doctrine of equivalents.

#### DAMAGES

150. To recover lost profit damages, the patentee need only show causation and the factual basis for causation between the infringement and the lost profits. *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 1065, 219 U.S.P.Q. 670 (Fed. Cir. 1983).

151. To do this, *Panduit* established that the patent owner need only demonstrate:

- 1) a demand for the product during the period in question;
- 2) an absence, during that period, of acceptable non-infringing substitutes;
- 3) its own manufacturing and marketing capability to meet or exploit that demand; and
- 4) a detailed computation of the amount of the profit it would have made.

*Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156, 197 U.S.P.Q. 726 (6th Cir. Mich. 1978); *Radio Steel & Mfg. Co. v. MTD Prods., Inc.*, 788 F.2d 1554, 1555, 229 U.S.P.Q. 431 (Fed. Cir. 1986).

152. In a two-supplier market it is reasonable to assume, provided the patent owner has the manufacturing capabilities, that the patent owner would have made the infringer's sales but for the infringement. *State Indus. v. Mor-Flo Indus.*, 883 F.2d 1573, 1578, 12 U.S.P.Q.2d 1026 (Fed. Cir. 1989).

153. The "[m]ere existence of a competing device does not make that device an acceptable substitute." *TWM Mfg. Co., Inc. v. Dura Corp.*, 789 F.2d 895, 901, 229 U.S.P.Q. 525 (Fed. Cir. 1986), *cert. denied*. A product on the market that lacks the advantages of the patented product can hardly be termed a substitute acceptable to the customer who wants those advantages. *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1373, 21 U.S.P.Q.2d 1321 (Fed. Cir. 1991), *cert. denied*. If purchasers are motivated to purchase because of particular features available only from the patented product, products without such features would most certainly not be acceptable non-infringing substitutes. *Id.*

154. Also, courts have generally held that an infringer's acceptable substitute argument is of "limited influence" when it [the infringer] ignores those substitutes while selling the patented invention. (Emphasis added). *TWM*, 789 F.2d at 902. This is exactly what Peterson did.

155. In an alternative approach, however, the "entire market value rule" may be used to determine the device for calculating lost profits. In *Beatrice Foods*, the Court stated that the law does not bar the inclusion of conveyed sales in an award of lost profits damages. *Beatrice Foods Co. v. New England Printing & Lithographic Co.*, 899 F.2d 1171, 1175, 14 U.S.P.Q.2d 1020 (Fed. Cir. 1991).

156. The "entire market value rule" allows for the recovery of damages based on the value of an entire apparatus containing several features, even though only one feature is patented. *Paper Converting Machine Co., v. Magna-Graphics, Corp.*, 745 F.2d 11, 33, 223 U.S.P.Q. 591 (Fed. Cir. 1984).

157. The "entire market value rule" further permits recovery of damages based on the value of the entire apparatus containing several features, when the patent-related feature is the basis for customer demand. See *TWM*, 789 F.2d at 901.

158. The "entire market value rule" is appropriate where both the patented and unpatented components together are analogous to components of a single assembly, parts of a complete machine, or constitute a functional unit. See *Rite-Hite v. Kelly Co.*, 56 F.3d 1538, 1550, 35 U.S.P.Q.2d 1065 (Fed. Cir. 1995).

#### WILLFULNESS / EXCEPTIONAL CASE

159. In addition to requiring "damages adequate to compensate for the infringement," Section 284 of the Patent Act authorizes a district court to "increase damages up to three times the amount found or assessed." 35 U.S.C. § 284.

160. The Federal Circuit has interpreted this provision of Section 284 as requiring a two-step process: "First the fact-finder must determine whether an infringer is guilty of conduct upon which increased damages may be based." *Jurgens v. CBK, Ltd.*, 80 F.3d 1566, 1570, 38 U.S.P.Q.2d 1397 (Fed. Cir. 1996). "If so, the Court then determines, exercising its sound discretion, whether, and to what extent, to increase the damage award given the totality of the circumstances." *Id.*

161. "An act of willful infringement satisfies this culpability requirement, and is, without doubt, sufficient to meet the first requirement to increase a compensatory damages award." *Id.* Thus, once a proper willfulness finding is made, the first step in determining whether damages should be enhanced is complete. *Id.* At that point, the Court need consider only whether, and to what extent, the compensatory damages awarded by the fact finder should be increased, in light of "the egregiousness of the Defendant's conduct based on all the facts and circumstances of the case." *Id.*

162. "A potential infringer having actual notice of another's patent rights has an affirmative duty of care." *Spindelfabrik Suessen-Schurr, Stahlecker & Grill GmbH v. Schubert & Salzer Maschinenfabrik Aktiengesellschaft*, 829 F.2d 1075, 1084 (Fed. Cir. 1987). An act of infringement is thus deemed willful when the infringer is aware of another's patent and fails to exercise due care to avoid infringement. *Electro Medical Sys., S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 1056 (Fed. Cir. 1994); *Rolls-Royce Ltd. v. GTE Valeron Corp.*, 800 F.2d 1101, 1109 (Fed. Cir. 1986). This standard of care typically requires an opinion from competent patent counsel prior to engaging in any potentially infringing activities. *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1389-90 (Fed. Cir. 1983). To establish willfulness, Blount must demonstrate by clear and convincing

evidence, considering the "totality of the circumstances," that Peterson willfully infringed its patent. *Electro Medical*, 34 F.2d at 1056.

163. The prosecution history of a patent in question is an important element of any competent opinion. *Underwater Devices*, 717 F.2d at 1389-90.

164. A holding of willful infringement is usually sufficient to make a case exceptional and entitles the opposing party to its attorney's fees. 35 U.S.C. § 285 (2002); *Avia Group Intl. Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 1567 (Fed. Cir. 1988).

### CONCLUSION

For the reasons set forth above, the Court concludes that Peterson's manufactured products infringe the claims of the '159 patent. Blount is entitled to actual damages from Peterson in the amount of \$429,256. The infringement of Peterson was willful, thus the actual damages are trebled, totaling \$1,287,768. Blount is also awarded prejudgment interest, which shall be calculated on a simple rather than compound basis, on the actual damages of \$429,256 at the rate of 5.0% for the period from December 16, 1999, to August 9, 2002. This is an exceptional case under 35 U.S.C. § 285, thus reasonable attorneys' fees are awarded to Blount. Blount is further awarded post judgment interest, calculated pursuant to 28 U.S.C. §1961, on the sum of the trebled damages and attorney's fees at the highest rate allowed by the law from the date of August 9, 2002, to April 19, 2004, and resuming from the date of the signing of the final judgment. Based upon the fact that infringement causes irreparable harm, an injunction is granted against Peterson.

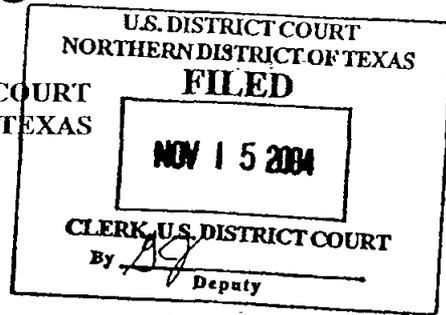
It is so ORDERED

SIGNED: 2 day of September, 2004.

  
JUDGE JERRY BUCHMEYER  
UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS

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BF  
ORIGINAL

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

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Civil Action No. 3:01-CV-0127-R

ORDER

Pursuant to the District Court's Order of Reference, entered September 16, 2004, Plaintiff Golden Blount, Inc.'s ("Plaintiff") Application for Attorney Fees, filed September 8, 2004, and Plaintiff's Application for Costs, filed September 9, 2004, (collectively "Applications") have been referred to the United States Magistrate Judge for hearing if necessary and determination. Having considered Plaintiff's Applications, Defendant Robert H. Peterson's ("Defendant") Opposition to Plaintiff's Applications for Attorneys' Fees and Costs ("Opposition"), Plaintiff's Reply to Defendant's Opposition to Plaintiff's Applications for Attorney's Fees and Costs and Objection to Defendant's Untimely Filing of Notice of Appeal ("Reply"), and the applicable law, Plaintiff's Applications are **GRANTED in part and DENIED in part**.

Specifically, this Court grants Plaintiff's request for attorney fees in the amount of \$622,015.00 and Plaintiff's request for costs in the amount of \$3,679.83. Plaintiff's request for costs in the amount of \$6,351.21 is denied. On September 2, 2004, the District Court adopted Plaintiff's Findings of Fact and Conclusions of Law ("Findings and Conclusions"), filed August 31, 2004, which awards Plaintiff post judgment interest on attorney fees from August 9, 2002 to April 19, 2004, and resuming from the date the final judgment is signed. Therefore, Plaintiff's

request for post judgment interest on attorney fees from September 2, 2004 is denied, because the District Court has already determined that the post judgment interest should resume from the date the final judgment is signed.

**I. Background<sup>1</sup>**

The District Court issued a judgment favorable to Plaintiff on August 9, 2002. On April 19, 2004, the United States Court of Appeals for the Federal Circuit remanded the case to the District Court to issue more specific findings regarding the patent infringement, willfulness, the exceptional nature of the case, and the damages amount. On May 11, 2004, the District Court ordered the parties to submit proposed findings of fact and conclusions of law. The District Court adopted Defendant's Findings and Conclusions on June 22, 2004 ("June 22, 2004 Order"). Plaintiff filed its Request for Reconsideration of Adoption of Defendant's Findings of Fact and Conclusions of Law, Alternative Motion for New Trial ("Motions for Reconsideration and New Trial") on July 6, 2004. At a hearing on August 18, 2004, the District Court decided to vacate its previous adoption of Defendant's Findings and Conclusions and to adopt Plaintiff's Findings and Conclusions, and ordered Plaintiff to provide the necessary findings and final judgment ("August 18, 2004 Minute Order"). On September 2, 2004, the District Court entered an Order vacating Defendant's Findings and Conclusions and adopting Plaintiff's August 31, 2004 Findings and Conclusions ("September 2, 2004 Order").

In the Findings and Conclusions adopted by the District Court on September 2, 2004, Plaintiff was awarded reasonable attorney fees under 35 U.S.C. § 285, and post judgment

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<sup>1</sup> The background information comes from Defendant Robert H. Peterson Co.'s Opposition to Plaintiff's Applications for Attorney Fees and Costs, filed September 17, 2004, and Plaintiff's Memorandum in Support of Golden Blount, Inc.'s Application for Attorneys' Fees, filed September 8, 2004.

interest, calculated pursuant to 28 U.S.C. § 1961, on attorney fees at the highest rate allowed by the law from August 9, 2004, to April 19, 2004, and resuming again on the date the final judgment is signed. Plaintiff subsequently filed its Applications on September 8, 2004 and on September 9, 2004. Defendant disputes the District Court's jurisdiction to entertain Plaintiff's Applications on the basis that the August 18, 2004 Minute Order constituted the final judgment, and therefore, Plaintiff's Applications, filed September 8, 2004, and September 9, 2004, were untimely under the Federal Rules of Civil Procedures 52(b) and 54(d).

## II. Analysis

### A. Timeliness of Plaintiff's Applications

#### 1. Plaintiff's Motion for New Trial

The District Court has jurisdiction to entertain Plaintiff's Applications, because they were timely filed under the Federal Rules. Defendant asserts that since the District Court's August 18, 2004 Minute Order disposed of Plaintiff's Motions for Reconsideration and a New Trial, under Federal Rule of Civil Procedure ("FRCP") 58(a)(1)(D), a separate document is not required for the entry of judgment. However, a "'judgment' [is] defined as 'a decree or any order from which an appeal lies.'" *Freudensprung v. Offshore Tech. Servs.*, 379 F.3d 327, 336 (5th Cir. 2004) (quoting *Theriot v. ASW Well Serv.*, 951 F.2d 84, 88 (5th Cir. 1992)). Further, under Federal Rule of Appellate Procedure ("FRAP") 4(a)(4)(A), "If a party timely files in the district court any of the following motions under the Federal Rules of Civil Procedure, the time to file an appeal runs for all parties from the entry of the order disposing of the *last such remaining motion*."<sup>2</sup>

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<sup>2</sup> See also FRAP 4(a)(4)(B)(i) ("If a party files a notice of appeal after the court announces or enters a judgment—but before it disposes of any motion listed in FRAP 4(a)(4)(A)—the notice becomes effective to appeal a judgment or order, in whole or in part, when the order disposing of the last such remaining motion is entered.").

(emphasis added). The provisions of FRAP 4(a)(4)(A)(iv) and FRAP 4(a)(4)(A)(v) list the identical motions set out in FRCP 58(a)(1)(D).<sup>3</sup> Since an appeal does not lie until the District Court enters an order disposing of both Plaintiff's Request for Reconsideration and Plaintiff's Motion for New Trial, and since there is nothing on the docket disposing of Plaintiff's Motion for a New Trial, there is no judgment. *See* FED. R. CIV. P. 58(b)(1) (If a separate document is not required under FRCP 58(a)(1), a judgment is deemed entered when it is entered in the civil docket in accordance with FRCP 79(a)).

Even if this Court were to accept Defendant's argument that the District Court adopted Plaintiff's June 10, 2004 Findings and Conclusions at its August 18, 2004 hearing and that the adoption disposed of Plaintiff's Request for Reconsideration of Adoption of Defendant's Findings of Fact and Conclusions of Law when the minute entry of that hearing was entered on the docket, Plaintiff's Alternative Motion for New Trial is still pending. Therefore, Plaintiff's Applications were timely filed, because the time to file motions under FRCP 52(b) and FRCP 54(b) do not start running until a judgment is entered, and the judgment is not entered for Plaintiff's Motions for Reconsideration and New Trial until the District Court enters an order disposing of Plaintiff's Motion for New Trial.

Also, even if the District Court's August 18, 2004 Minute Order could be considered a judgment, Plaintiff's applications would still be timely filed "because the ... order lacked a

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<sup>3</sup> The motions enumerated in FRAP 4(a)(4)(A)(i) through FRAP4(a)(4)(A)(vi) track the motions listed in FRCP 58(a)(1)(A) through FRCP 58(a)(1)(E) as exceptions to the separate document requirement. In fact, the Advisory Committee Notes for 2002 after FRCP 58 specifically state that the amendments to FRCP 58(a)(1) were made in order to address the problems that arise under FRAP 4. *See also Freudensprung*, 379 F.3d at 334 ("Certain Amendments, effective December 1, 2002, were made to resolve uncertainties concerning how Rule 4(a)(7)'s 'definition of when a judgment or order is deemed entered interacts with the requirement in [Rule] 58 that, to be effective, a judgment must be set forth on a separate document.'" (internal quotations omitted) (quoting Notes of Advisory Committee on Rules 2002 Amendments, following Rule 4)).

required separate document, under amended Rules 4 and 58(b), the order was not deemed 'entered' – and the time to file notice of appeal did not begin to run ....” *Freudensprung*, 379 F.3d at 337. Under FRCP 58(b)(2)(B), a judgment is also considered entered, even where it is lacking a required separate document, when 150 days have run from its entry on the docket pursuant to FRCP 79(a). However, this does not apply here because 150 days from August 18, 2004 is January 15, 2005.

**2. Plaintiff's Request for Reconsideration**

Plaintiff's Applications were also timely filed because the District Court's August 18, 2004 Minute Order did not dispose of Plaintiff's Request for Reconsideration under FRCP 58(a)(1)(D) as a "motion to alter or amend the judgment." The District Court's June 22, 2004 adoption of Defendant's Findings of Fact and Conclusions of Law is not an entered judgment until it is set forth on a separate document, and no such separate document exists. *See* FED. R. CIV. P. 58(b)(2)(A); *see also* *Freudensprung*, 379 F.3d at 334 (“[A] judgment or order is deemed 'entered' within the meaning of Rule 4(a) when it is set forth on a separate document in compliance with Federal Rules of Civil Procedure 58(a)(1) and entered on the district court's civil docket as required by Federal Rules of Civil Procedure 79(a).”). The Provisions of FRCP 58(b)(2)(B) also do not apply here because 150 days from June 22, 2004 is November 19, 2004.

Further, the District Court's June 22, 2004 Order cannot be considered “an order disposing of a motion” and hence cannot fit under the exception to the separate document requirement in FRCP 58(A)(1). Defendant's Findings and Conclusions, adopted in the District

Court's June 22, 2004 Order, do not constitute a motion.<sup>4</sup> "[The document] was not styled as a motion. The writing did not 'state with particularity the grounds' ..."of the motion.<sup>5</sup> Defendant's Opposition ("Def.'s Opp.") at 4 (quoting FED. R. CIV. P. 7(b)(1)). However, even if Defendant's Findings and Conclusions could be considered a motion, they do not fall under the enumerated motions listed in FRCP 58(a)(1)(A) through FRCP 58(a)(1)(E).<sup>6</sup>

### 3. The District Court's Instructions and Adoption

Contrary to Defendant's assertion, the District Court's order at the August 18, 2004 hearing for the Plaintiff "to present [the Court] with the necessary findings and necessary final judgment ..." clearly shows that the District Court did not make a final decision regarding which version of the findings it was going to adopt. (Pl.'s Rep. at 3). Therefore, the District Court's August 18, 2004 Minute Order did not dispose of Plaintiff's motions under FRCP 58(a)(1)(D), making Plaintiff's Applications timely under FRCP 52(b) and FRCP 54(d). The District Court's instruction to Plaintiff was not "language calculated to conclude all claims before the court." (Def.'s Opp. at 5 (citing *Moreau v. Harris County*, 158 F.3d 241, 244 (5th Cir. 1998))). At the August 18, 2004 hearing, the District Court only made the decision to vacate Defendant's

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<sup>4</sup> A motion is defined as a "written or oral application requesting a court to make a specified ruling or order." BLACK'S LAW DICTIONARY 458 (2d pocket ed. 2001). Defendant's proposed findings and conclusions was not an "application requesting" the Court to make a certain ruling or an order.

<sup>5</sup> This was the reasoning put forth by Defendant as to why Plaintiff's August 31, 2004 Findings and Conclusions do not constitute a proper FRCP 52(b) motion. (Def.'s Opp. at 4).

<sup>6</sup> Defendant's Findings and Conclusions do not fit (1) under FRCP 58(a)(1)(A) as a motion for judgment under FRCP 50(b), which discusses renewing a motion for judgment after trial or an alternative motion for a new trial; (2) under FRCP 58(a)(1)(B) as a motion to amend or make additional findings of fact under FRCP 52(b); (3) under FRCP 58(a)(1)(C) as a motion for attorney fees under FRCP 54, which states that claims for attorneys' fees and related non-taxable expenses shall be made by a motion; (4) under FRCP 58(a)(1)(D) as a motion for a new trial or to alter or amend the judgment under FRCP 59; (5) under FRCP 58(a)(1)(E) as a motion for relief under FRCP 60, which states that relief may be granted for mistakes, inadvertence, excusable neglect, newly discovered evidence, etc..

findings and to adopt Plaintiff's instead, and it did not adopt Plaintiff's June 10, 2004 findings as the Defendant asserts. If that was the District Court's intent, it would not have instructed Plaintiff to submit the necessary findings since the June 10, 2004 version had previously been submitted to the District Court. It is apparent from the facts that the District Court's decision regarding which version of the findings and conclusions it wished to adopt was not finalized until September 2, 2004.

Defendant states that the "August 31 [v]ersion [of Plaintiff's findings and conclusions] contains significant additional findings and conclusions which alter and amend those set forth in the June 10 [f]indings." (Def.'s Opp. at 3). The District Court's September 2, 2004 adoption of those findings without any indication that it is vacating the adoption of the June 10, 2004 findings, also makes it clear that the District Court never adopted Plaintiff's June 10, 2004 Findings and Conclusions at its August 18, 2004 hearing. The District Court's September 2, 2004 Order states, "[C]onsistent with its ruling at the conclusion of the Oral Hearing on August 18, 2004, [the District Court] is of the opinion that the Plaintiff's Findings of Fact and Conclusions of law submitted on August 31, 2004, are correct, and they are hereby adopted as the Findings and Conclusions of this Court." (emphasis omitted). This Order clearly shows that the District Court only adopted the August 31, 2004 version of Plaintiff's findings and conclusions. The District Court waited for the version of the findings that Plaintiff submitted pursuant to its request, and after reviewing it and finding it to be satisfactory, the District Court adopted it on September 2, 2004.

**B. Reasonableness of the Plaintiff's Requested Attorney Fees and Costs**

**1. Attorney Fees**

The District Court has already determined that under 35 U.S.C. § 285, this is an exceptional case entitling Plaintiff to attorney fees. Therefore, the issue left before this Court is whether the amount of attorney fees requested by Plaintiff is reasonable. The Federal Circuit's precedent governs the substantive interpretation of 35 U.S.C. § 285. *Pharmacia & Upjohn Co. v. Mylan Pharms., Inc.*, 182 F.3d 1356, 1359 (Fed. Cir. 1999). However, "[t]he methodology of assessing a reasonable award under 35 U.S.C. § 285 is within the discretion of the district court." *Mathis v. Spears*, 857 F.2d 749, 754 (Fed. Cir. 1988) (citing *Lam, Inc. v. Johns-Manville Corp.*, 718 F.2d 1056, 1068 (Fed. Cir. 1983)). This Court applies the lodestar analysis. The lodestar amount is determined by multiplying the number of hours reasonably spent on the litigation by a reasonable hourly rate. *Green v. Adm'rs of the Tulane Educ. Fund*, 284 F.3d 642, 661 (5th Cir. 2002) (quoting *Rutherford v. Harris County, Tex.*, 197 F.3d 173, 192 (5th Cir. 1999)). The factors set out in *Johnson v. Georgia Highway Express, Inc.* are considered in analyzing the reasonableness of the hours expended and the hourly rates requested. 488 F.2d 714, 717-19 (5th Cir. 1974).<sup>7</sup> Further, the work performed by paralegals should be legal work, not clerical tasks, for their fees to be recoverable as attorney fees. *Vela v. City of Houston*, 276 F.3d 659, 681 (5th Cir. 2001) (citing *Allen v. United States Steel Corp.*, 665 F.2d 689, 697 (5th Cir. 1982)). "Otherwise, paralegal expenses are separately unrecoverable overhead expenses." *Allen*, 665

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<sup>7</sup> The factors set out in *Johnson* are: (1) the time and labor required; (2) the novelty and difficulty of the issues involved; (3) the skill required to litigate the case; (4) the ability of the attorney to accept other work; (5) the customary fee for similar work in the community; (6) whether the fee is fixed or contingent; (7) time limitations imposed by the client or the circumstances of the case; (8) the amount involved and results obtained; (9) the experience, reputation, and ability of the attorneys; (10) the "undesirability" of the case; (11) the nature and length of the attorney-client relationship; and (12) awards in similar cases. *Johnson*, 488 F.2d at 717-19.

F.2d at 697 (citing *Jones v. Armstrong Cork Co.*, 630 F.2d 324, 325 & n.1 (5th Cir. 1980)).

Plaintiff seeks attorney fees for the three law firms that represented it throughout the course of this case. Plaintiff seeks compensation for: 80.15 hours for the services of the Locke, Liddle & Sapp, L.L.P. ("Locke") attorneys who served as counsel before the case was turned over to Hitt Gaines, P.C. ("Hitt"), and Schultz, & Associates, P.C. ("Schultz"); 66.5 hours for the services of the Hitt's paralegals and 2,185.1 hours for the services of the Hitt attorneys; and 171.7 hours for the services of the Schultz attorneys. Plaintiff seeks compensation for its counsel at hourly rates ranging from \$135.00 to \$375.00, and for Hitt's paralegals at hourly rates ranging from \$65.00 to \$90.00.<sup>8</sup>

This Court has considered the *Johnson* factors, as well as Plaintiff's Application for Attorney Fees, Memorandum in Support of Plaintiff's Application for Attorney Fees, and Appendix in Support of Plaintiff's Application for Attorney Fees. The number of hours that Plaintiff seeks compensation for are reasonable for this case, and Plaintiff's requested hourly rates are reasonable for this case in this community. Plaintiff has also sufficiently shown that the work done by Hitt's paralegals is "work traditionally done by an attorney," and thus the paralegals' hours are recoverable as the prevailing party's attorney fees. *Allen*, 665 F.2d 689 at 697. Defendant has not contested the reasonableness of the number of hours or the hourly rates Plaintiff is requesting for its counsel and paralegals. Taking into consideration Plaintiff's requested hourly rates and the number of hours for which Plaintiff seeks compensation, Plaintiff

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<sup>8</sup> On page 6 of Plaintiff's Application for Attorney fees, and on page A-112 of the Appendix in Support of Plaintiff's Application for Attorney Fees ("Attorney Fees Appendix"), attorney Charles Phipps' billing rate is listed as \$130.00. However, in the Appendix at page A-87, his billing rate is listed as \$230.00. It appears from Locke's statements itemizing its services that Charles Phipps' billing rate is \$230.00. Therefore, this Court assessed the reasonableness of Plaintiff's request for attorney fees for the services rendered by Charles Phipps at the hourly rate of \$230.00.

is awarded attorney fees at the following rates for the following number of hours: \$249.39 per hour for 2,180.04 hours for the services rendered by Hitt; \$71.57 per hour for 66.34 hours for the services rendered by Hitt's paralegals; \$318.11 per hour for 171.7 hours for the services rendered by Schultz; and \$236.65 per hour for 80.15 hours for the service rendered by Locke. In sum, Plaintiff is awarded a lodestar amount of \$622,015.00.<sup>9</sup>

Once the lodestar has been determined, it may be adjusted upward or downward, if the *Johnson* factors, not "already considered in calculating the lodestar," warrant such an adjustment. *Shipes v. Trinity Indus.*, 987 F.2d 311, 320 (5th Cir. 1993) (citing *Von Clark v. Butler*, 916 F.2d 255, 258 (5th Cir. 1980)). However, the lodestar is presumptively reasonable and should be modified only in exceptional cases. *Watkins v. Fordice*, 7 F.3d 453, 457 (5th Cir. 1993), *on remand*, 852 F. Supp. 542 (S.D. Miss. 1994), *aff'd*, 49 F.3d 728 (5th Cir. 1995) (citing *City of Burlington v. Dague*, 505 U.S. 557, 562 (1992), *on remand*, 976 F.2d 801 (2d Cir. 1991)). Plaintiff does not seek a fee enhancement and Defendant does not dispute the reasonableness of the amount of fees requested by Plaintiff. Therefore, this Court determines that the lodestar amount should not be adjusted.

## 2. Costs

Plaintiff seeks \$10,031.04 in costs. Costs other than attorney fees may be awarded to the prevailing party under FRCP 54(d)(1). *Gaddis v. United States*, 381 F.3d 444, 452 (5th Cir. 2004) (quoting *Coats v. Penrod Drilling Corp.*, 5 F.3d 877, 891 (5th Cir. 1993)). "28 U.S.C. § 1920 defines recoverable costs, and a district court may decline to award the costs listed in the

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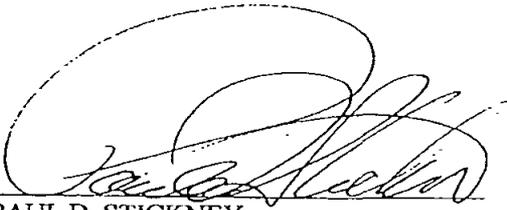
<sup>9</sup> See Plaintiff's Attorney Fees Appendix for the specific hourly rates and the number of hours requested.

statute but may not award costs omitted from the list.”<sup>10</sup> *Id.* Although Defendant has not disputed the reasonableness of Plaintiff’s requested costs, upon reviewed of Plaintiff’s Bill of Costs, this Court determines that Plaintiff should only be awarded \$3,679.83 in costs. It is not apparent that the other costs requested, in the amount of \$6,351.21 for postage, facsimile, courier services, on-line search expenses, trial supplies, obtaining patents, taxi and airfare for a deposition, parking for and in preparation of trial fit within 28 U.S.C. § 1920 as recoverable costs. *See Coats*, 5 F.3d at 891 (Travel expenses, costs incurred for “blow ups” used at trial, and video technician fees for a deposition are not recoverable as costs, because they are not expenses included in 28 U.S.C. § 1920.).

**III. Conclusion**

Based on the above, Plaintiff’s Application for Attorneys’ Fees and Plaintiff’s Application for Costs are **GRANTED in part and DENIED in part**. Defendant is ordered to pay Plaintiff the above mentioned amounts within 30 days from the District Court’s entry of the final judgment.

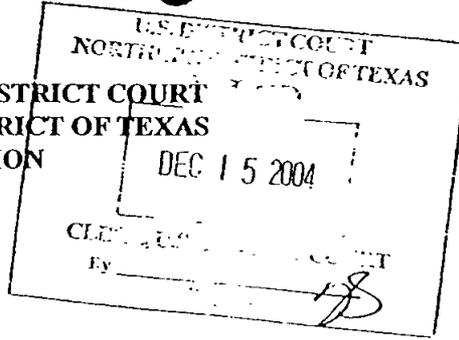
SO ORDERED. November 12, 2004.

  
PAUL D. STICKNEY  
UNITED STATES MAGISTRATE JUDGE

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<sup>10</sup> The costs listed in 28 U.S.C. § 1920 are: (1) fees of the clerk and marshal; (2) fees of the court reporter for stenographic transcript necessarily obtained for use in the case; (3) fees and disbursements for printing and witnesses; (4) fees for exemplification and copies of papers necessarily obtained for use in the case; (5) docket fees under 28 U.S.C. § 1923; (6) compensation of court appointed experts, compensation of interpreters, and salaries, fees, expenses, and costs of special interpretation services under 28 U.S.C. § 1828.

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
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§  
§  
§

Civil Action No.

3-01-CV-0127-R

FINAL JUDGMENT

Pursuant to Rule 58 of the Federal Rules of Civil Procedure and the Court's Findings of Fact and Conclusions of Law entered September 2, 2004, it is hereby **ORDERED** that judgment is entered for Plaintiff. It is further **ORDERED** that Plaintiff recover damages, as set forth in the Court's Findings of Fact and Conclusions of Law of September 2, 2004, and reasonable attorneys fees and costs, as set forth in the Court's Order Granting Attorney's Fees and Costs of November 15, 2004. Moreover, it is **ORDERED** that interest shall run on the damages, attorney's fees and costs, as set forth in the Court's Findings of Fact and Conclusions of Law of September 2, 2004. Based upon the fact that infringement causes irreparable harm, it is additionally **ORDERED** that Defendant be permanently enjoined from making, using, offering to sell, selling or importing into the United States the device found to infringe the adjudicated claims of United States Patent No. 5,988,159, or colorable variations thereof.

**IT IS SO ORDERED.**

ENTERED: this 15 day of Dec., 2004.

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JERRY BUCHMEYER  
SENIOR UNITED STATES DISTRICT JUDGE  
NORTHERN DISTRICT OF TEXAS

APPEAL, CLOSED, JURY, MREF, STICKNEY

**U.S. District Court  
Northern District of Texas (Dallas)  
CIVIL DOCKET FOR CASE #: 3:01-cv-00127**

Golden Blount, Inc, et al v. Robert H Peterson Co  
Assigned to: Judge Jerry Buchmeyer  
Demand: \$0  
Cause: 35:271 Patent Infringement

Date Filed: 01/18/2001  
Jury Demand: Plaintiff  
Nature of Suit: 830 Patent  
Jurisdiction: Federal Question

**Plaintiff**

**Golden Blount, Inc**

represented by **Roy W Hardin**  
Locke Liddell & Sapp - Dallas  
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*TERMINATED: 09/24/2001*  
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*ATTORNEY TO BE NOTICED*

**Defendant**

**Robert H Peterson Co**

represented by **Jerry R Selinger**  
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**JT-APP 0095**

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**F William McLaughlin**  
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**Leland W Hutchinson, Jr**  
Freeborn & Peters - Chicago  
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Chicago, IL 60606  
312/360-6000

Golden Blount, Inc

Counter Claimant

Robert H Peterson Co

represented by **Jerry R Selinger**  
(See above for address)  
**LEAD ATTORNEY**  
**ATTORNEY TO BE NOTICED**

JT-APP 0096

Date Filed	#	Docket Text
1/18/2001	<u>1</u>	COMPLAINT FOR PATENT INFRINGEMENT filed; Filing Fee \$ 150.00 Receipt # 135399 (14) (vdf) (Entered: 01/19/2001)
1/18/2001	<u>1</u>	DEMAND for jury trial by plaintiff Golden Blount (vdf) (Entered: 01/19/2001)

01/18/2001		PRELIMINARY ASSIGNMENT TO Magistrate Judge Paul Stickney (vdf) (Entered: 01/19/2001)
01/23/2001	2	CERTIFICATE OF INTERESTED PERSONS by plaintiff Golden Blount, Inc (1) (vdf) (Entered: 01/24/2001)
03/19/2001	3	ANSWER to Complaint and COUNTERCLAIM by defendant Robert H Peterson Co against Golden Blount, Inc (4) (vdf) (Entered: 03/20/2001)
03/20/2001	4	SCHEDULING ORDER setting Amending of Pleadings on 7/17/01 ; Discovery cutoff 9/14/01 ; Deadline for filing of dispositive motions 10/26/01 ; Pretrial materials due on 2/15/02 Pretrial conference for 10:00 3/1/02 ; Docket call set for 3/4/02 (SEE ORDER FOR SPECIFICS) ( Signed by Chief Judge Jerry Buchmeyer ) Copies to counsel: 03/21/01 Page(s): 11 (vdf) (Entered: 03/21/2001)
03/20/2001	4	STATUS REPORT ORDER. Joint Status report due on 5/18/01 ( Signed by Chief Judge Jerry Buchmeyer ) Copies to counsel: 03/21/01 Page(s): 11 (vdf) (Entered: 03/21/2001)
03/23/2001	5	ORDER REGARDING JUDGE BUCHMEYER'S SCHEDULING ORDER (SEE ORDER FOR SPECIFICS) ( Signed by Magistrate Judge Paul D. Stickney ) Copies to counsel: 03/23/01 Page(s) 2 (vdf) (Entered: 03/23/2001)
05/18/2001	6	JOINT STATUS REPORT by defendant Robert H Peterson Co, plaintiff Golden Blount, Inc (3) (vdf) (Entered: 05/18/2001)
06/14/2001	7	JOINT MOTION for protective order by defendant Robert H Peterson Co, plaintiff Golden Blount, Inc. (10) (lmr) (Entered: 06/15/2001)
06/19/2001	8	PROTECTIVE ORDER granting [7-1] joint motion for protective order (SEE ORDER FOR SPECIFICS) ( Signed by Magistrate Judge Paul D. Stickney ) Copies to counsel: 06/20/01 Page(s) 7 (vdf) (Entered: 06/20/2001)
09/13/2001	9	JOINT MOTION to extend discovery cut-off by plaintiff Golden Blount, Inc, defendant Robert H Peterson Co (2) (vdf) (Entered: 09/14/2001)
09/17/2001	10	ORDER granting [9-1] joint motion to extend discovery cut-off reset discovery due for 10/5/01 ( Signed by Chief Judge Jerry Buchmeyer ) Copies to counsel: 09/17/01 Page(s) 1 (vdf) (Entered: 09/17/2001)
09/21/2001	11	MOTION by Roy W. Hardin, attorney for plaintiff Golden Blount, Inc., for Roy W. Hardin and Locke Liddell & Sapp LLP, to withdraw as attorney . (3) (jaw) (Entered: 09/24/2001)
09/24/2001	12	ORDER granting [11-1] motion for Roy W. Hardin and Locke Liddell & Sapp LLP, to withdraw as attorney (Terminated attorney Roy W. Hardin). ( Signed by Magistrate Judge Paul D. Stickney ) Copies to counsel: 09/25/01 Page(s) 1 (jaw) (Entered: 09/26/2001)
09/26/2001	13	NOTICE of attorney appearance for plaintiff Golden Blount, Inc. by William D. Harris. (2) (jaw) (Entered: 09/26/2001)
09/26/2001	14	NOTICE of attorney appearance for plaintiff Golden Blount, Inc. by Charles Wayne Gaines. (2) (jaw) (Entered: 09/26/2001)
10/12/2001	15	MOTION by plaintiff Golden Blount, Inc in limine or in the alternative motion to enforce the agreement of opposing attorneys . (2) (jaw) (Entered: 10/15/2001)
10/12/2001	16	MEMORANDUM by plaintiff Golden Blount, Inc. in support of [15-1] motion in limine or in the alternative motion to enforce the agreement of opposing attorneys. (8)(Exhibits

		not imaged.) (jaw) Modified on 10/15/2001 (Entered: 10/15/2001)
0/18/2001	<u>17</u>	ORDER OF REFERENCE: [15-1] Plaintiff's motion in limine or in the alternative motion to enforce the agreement of opposing attorneys, is referred to Magistrate Judge Paul D. Stickney for hearing, if necessary, and recommendations or determination, to this Court. See order for specifics. ( Signed by Chief Judge Jerry Buchmeyer ) Copies to counsel: 10/18/01 Page(s): 1 (jaw) (Entered: 10/18/2001)
0/23/2001	<u>18</u>	ORDER setting hearing: Motion hearing set for 11:00 11/14/01 in the Magistrate's courtroom 15C22, 1100 Commerce Street, Dallas, Texas, for [15-1] motion in limine or in the alternative motion to enforce the agreement of opposing attorneys ( Signed by Magistrate Judge Paul D. Stickney ) Copies to counsel: 10/24/01 Page(s): 2 (djd) (Entered: 10/24/2001)
1/01/2001	<u>19</u>	RESPONSE by defendant Robert H Peterson Co. in opposition to [15-1] motion in limine or, in the alternative, motion to enforce the agreement of opposing attorneys. (11) (Exhibits not imaged.) (jaw) (Entered: 11/01/2001)
1/13/2001	<u>20</u>	REPLY by plaintiff Golden Blount, Inc. to response to [15-1] motion in limine or in the alternative motion to enforce the agreement of opposing attorneys. (6) (jaw) (Entered: 11/14/2001)
1/14/2001	<u>21</u>	ORDER RESETTING HEARING: Motion hearing set for 11:00 a.m. on 11/26/01 for [15-1] motion in limine or in the alternative motion to enforce the agreement of opposing attorneys . See order for specifics. ( Signed by Magistrate Judge Paul D. Stickney ) Copies to counsel: 11/14/01 Page(s): 2 (jaw) (Entered: 11/14/2001)
1/26/2001		Motion hearing held re: [15-1] plaintiff's motion in limine or in the alternative motion to enforce the agreement of opposing attorneys. (jaw) (Entered: 11/26/2001)
1/26/2001	<u>22</u>	Minute order: Motion hearing held before Magistrate Judge Paul D. Stickney; Court Reporter: Gladys Janssen. Order to enter. (1) (jaw) (Entered: 11/26/2001)
1/26/2001	<u>23</u>	ORDER denying [15-1] plaintiff's motion in limine. ,,the defendant will produce Mr. McLaughlin and the attorney upon whose advice the defendant is relying in Dallas and at the defendant's cost. The defendant will pay the cost of the Court reporter to attend the deposition, and each party is to pay for its own deposition transcripts. Plaintiff's request for attorneys' fees is denied as to the motion and deposition. See order for specifics. ( Signed by Magistrate Judge Paul D. Stickney ) Copies to counsel: 11/27/01 Page(s) 1 (jaw) (Entered: 11/27/2001)
2/05/2001	<u>24</u>	TRANSCRIPT filed Court Reporter: Electronic. Date(s): 11/26/01 Volume(s): 1 Type of proceeding: Hearing on Motion in Limine. (15+)(USC/Not imaged- bound document.) (jaw) Modified on 12/05/2001 (Entered: 12/05/2001)
2/28/2001	<u>25</u>	ANSWER by plaintiff Golden Blount, Inc. to [3-2] counterclaim. (3) (jaw) (Entered: 01/02/2002)
1/22/2002	<u>26</u>	Witness list by plaintiff Golden Blount, Inc. (5) (jaw) (Entered: 01/23/2002)
1/22/2002	<u>26</u>	Exhibit list by plaintiff Golden Blount, Inc. (5) (jaw) (Entered: 01/23/2002)
1/22/2002	<u>27</u>	Exhibit list by defendant Robert H Peterson Co. (6) (jaw) (Entered: 01/23/2002)
1/22/2002	<u>28</u>	Witness list by defendant Robert H Peterson Co. (4) (jaw) (Entered: 01/23/2002)
2/05/2002	<u>29</u>	RESPONSE by defendant Robert H Peterson Co in opposition to [26-1] exhibits list, [26-1] witness list (5) (cxj) (Entered: 02/06/2002)

02/05/2002	<u>30</u>	RESPONSE by plaintiff Golden Blount, Inc in opposition to [28-1] witness list, [27-1] exhibits list (4) (cxj) (Entered: 02/06/2002)
02/19/2002		Letter confirming extension of time by plaintiff Golden Blount, Inc. Deadline for submission of pretrial materials extended to 2/20/02. (3) (jaw) (Entered: 02/20/2002)
02/20/2002	<u>31</u>	Proposed issues and jury instructions by defendant Robert H Peterson Co (15+) (tem) (Entered: 02/22/2002)
02/20/2002	<u>32</u>	PETERSON CO's PROPOSED Special Verdict Form and Special Interrogatories by defendant Robert H Peterson Co (10) (tem) (Entered: 02/22/2002)
02/20/2002	<u>33</u>	Proposed voir dire questions by defendant Robert H Peterson Co (3) (tem) (Entered: 02/22/2002)
02/20/2002	<u>34</u>	Exhibit list by defendant Robert H Peterson Co (5) (tem) (Entered: 02/22/2002)
02/20/2002	<u>35</u>	Witness list by defendant Robert H Peterson Co (4) (tem) (Entered: 02/22/2002)
02/20/2002	<u>36</u>	PRETRIAL MATERIAL by plaintiff Golden Blount, Inc (15+) (Attachments not imaged) (tem) (Entered: 02/22/2002)
02/22/2002	<u>37</u>	Joint Proposed pre-trial order from plaintiff Golden Blount, Inc, defendant Robert H Peterson Co (attachment not imaged) (15+) (tem) (Entered: 02/25/2002)
02/26/2002	<u>38</u>	MOTION by defendant Robert H Peterson Co for protective order to preclude testimony of F. William McLaughlin . (2) (jaw) (Entered: 02/27/2002)
02/26/2002	<u>39</u>	MEMORANDUM by defendant Robert H Peterson Co in support of [38-1] motion for protective order to preclude testimony of F. William McLaughlin. (5) (jaw) (Entered: 02/27/2002)
02/27/2002	<u>40</u>	JOINT AGREED MOTION by plaintiff Golden Blount, Inc, defendant Robert H Peterson Co to motion for trial by the Court sitting without a jury . (2) (jaw) (Entered: 02/27/2002)
02/27/2002	<u>41</u>	UNOPPOSED MOTION by plaintiff Golden Blount, Inc for 60-day continuance . (3) (jaw) (Entered: 02/27/2002)
02/27/2002	<u>42</u>	MEMORANDUM by plaintiff Golden Blount, Inc in support of [41-1] motion for 60-day continuance. (2) (jaw) (Entered: 02/27/2002)
02/27/2002	<u>43</u>	Amended SCHEDULING ORDER setting Docket call set for 5/6/02 ; Pretrial materials due on 4/19/02 Pretrial conference for 10:00 5/3/02...see order. ( Signed by Judge Jerry Buchmeyer ) Copies to counsel: 2/28/02 Page(s): 2 (jrb) (Entered: 02/28/2002)
02/27/2002	<u>44</u>	ORDER granting [41-1] motion for 60-day continuance...pretrial conference scheduled for 3/1/02 will still be held. ( Signed by Judge Jerry Buchmeyer ) Copies to counsel: 2/28/02 Page(s) 1 (jrb) (Entered: 02/28/2002)
03/05/2002	<u>45</u>	ORDER granting [40-1] motion to motion for trial by the Court sitting without a jury ( Signed by Judge Jerry Buchmeyer ) Copies to counsel: 3/6/02 Page(s) 1 (jrb) (Entered: 03/06/2002)
03/15/2002	<u>46</u>	RESPONSE by plaintiff Golden Blount, Inc to [38-1] motion for protective order to preclude testimony of F. William McLaughlin. (6) (jaw) (Entered: 03/18/2002)
04/19/2002	<u>47</u>	PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW by defendant Robert H Peterson Co (16) (aat) (Entered: 04/22/2002)

4/19/2002	<u>48</u>	ISSUE DIRECTED TRIAL BRIEF by plaintiff Golden Blount, Inc (10) (aat) (Entered: 04/22/2002)
4/19/2002	<u>49</u>	SUBSTITUTE LIST OF EXHIBITS by plaintiff Golden Blount, Inc (4)-(aat) (Entered: 04/22/2002)
4/19/2002	<u>50</u>	FINDINGS OF FACT AND CONCLUSIONS OF LAW by plaintiff Golden Blount, Inc (9) (aat) (Entered: 04/22/2002)
4/22/2002	<u>51</u>	SUPPLEMENTAL JOINT PRETRIAL ORDER pursuant to Local Rule 16.4 filed. (Signed by Judge Jerry Buchmeyer) Copies to counsel: 4/23/02 Page(s): 8 (aat) (Entered: 04/23/2002)
4/22/2002	<u>52</u>	ORDER OF REFERENCE: Peterson Co.'s [38-1] motion for protective order to preclude testimony of F. William McLaughlin is referred to Magistrate Judge Paul D. Stickney for hearing, if necessary, and recommendations or determination, to this Court. ( Signed by Judge Jerry Buchmeyer ) Copies to counsel: 4/23/02 Page(s): 1 (aat) (Entered: 04/23/2002)
5/03/2002		Pre-trial conference held. (mlh) (Entered: 05/06/2002)
5/03/2002	<u>53</u>	Minute order: Pretrial conference held before Judge Jerry Buchmeyer. Court Reporter: Not on record. (mlh) (Entered: 05/06/2002)
5/17/2002	<u>54</u>	OPENING CLAIM CONSTRUCTION/TRIAL BRIEF by plaintiff Golden Blount, Inc. (15+) (Exhibits not imaged.) (cxb) (Entered: 05/20/2002)
5/23/2002	<u>55</u>	ORDER setting hearing: Motion hearing set for 10:00 5/31/02 for [38-1] motion for protective order to preclude testimony of F. William McLaughlin . See order for specifics. ( Signed by Magistrate Judge Paul D. Stickney ) Copies to counsel: 05/24/02 Page(s): 2 (jaw) (Entered: 05/24/2002)
5/28/2002	<u>56</u>	RESPONDING BRIEF REGARDING CLAIM CONSTRUCTION by defendant Robert H Peterson Co. (15+)(Exhibits not imaged.) (jaw) (Entered: 05/29/2002)
5/31/2002		Motion hearing held re: [38-1] motion for protective order to preclude testimony of F. William McLaughlin. Motion denied; order to enter. (jaw) (Entered: 06/03/2002)
5/31/2002	<u>57</u>	Minute order: Motion hearing held before Magistrate Judge Paul D. Stickney; Court Reporter: Gladys Janssen. (1) (jaw) (Entered: 06/03/2002)
5/03/2002	<u>58</u>	REPLY by plaintiff Golden Blount, Inc in opposition to [56-1] defendant's responsive claim construction brief. (14) (jaw) (Entered: 06/04/2002)
5/04/2002	<u>59</u>	ORDER denying [38-1] motion for protective order to preclude testimony of F. William McLaughlin. ( Signed by Magistrate Judge Paul D. Stickney ) Copies to counsel: 6/5/02 Page(s) 1 (cxb) (Entered: 06/05/2002)
5/26/2002	<u>60</u>	35 USC SECTION 282 NOTICE of by defendant Robert H Peterson Co (3) (svc) (Entered: 06/27/2002)
7/25/2002	<u>61</u>	SUPPLEMENTAL DOCUMENT to [60-1] exhibit list by plaintiff Golden Blount, Inc. (2) (jaw) (Entered: 07/25/2002)
7/29/2002		Bench trial held- First day. (jaw) (Entered: 07/31/2002)
7/29/2002	<u>63</u>	Minute order: First day of bench trial held before Judge Jerry Buchmeyer; Court Reporter: Janet Wright. Court adjourned until 7/30/02 at 9:00 a.m. (A) (jaw) Modified on 07/31/2002 (Entered: 07/31/2002)

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07/30/2002		Bench trial held- Second day. (jaw) (Entered: 07/31/2002)
07/30/2002	<u>64</u>	Minute order: Second day of bench trial held before Judge Jerry Buchmeyer; Court Reporter: Janet Wright. Court adjourned until 7/31/02 at 9:00 a.m. (1)(jaw) Modified on 07/31/2002 (Entered: 07/31/2002)
07/31/2002	<u>62</u>	MOTION with memorandum in support by plaintiff Golden Blount, Inc. to disregard the testimony of John Palaski . (6) (jaw) (Entered: 07/31/2002)
07/31/2002	<u>65</u>	APPLICATION AND ORDER for F William McLaughlin to appear pro hac vice . ( Signed by Judge Jerry Buchmeyer ) Copies to counsel: 08/01/02 Page(s) 3 (jaw) (Entered: 08/01/2002)
07/31/2002	<u>66</u>	APPLICATION AND ORDER for Dean A Monco to appear pro hac vice ( Signed by Judge Jerry Buchmeyer ) Copies to counsel: 08/01/02 Page(s) 3 (jaw) (Entered: 08/01/2002)
07/31/2002		Bench trial held. (jaw) (Entered: 08/05/2002)
07/31/2002	<u>67</u>	Minute order: Bench Trial held before Judge Jerry Buchmeyer; Court Reporter: Janet Wright. Bench trial ends; Findings will be entered. (1) (jaw) (Entered: 08/05/2002)
08/09/2002	<u>68</u>	FINDINGS OF FACT AND CONCLUSIONS OF LAW ...Based on the foregoing Findings of Fact and Conclusions of Law, this Court finds for the Plaintiff. Plaintiff's request for injunctive relief is granted. See Findings of Fact for specifics. (Signed by Judge Jerry Buchmeyer) Copies to counsel: 08/09/02 Page(s): 8 (jaw) (Entered: 08/09/2002)
08/09/2002	<u>69</u>	JUDGMENT Pursuant to Rule 58 of the Federal Rules of Civil Procedure and the Court's Findings of Fact and Conclusions of Law, entered 8/9/02, it is hereby ordered that judgment is entered for the Plaintiffs. It is further ordered that Plaintiff recover damages and reasonable attorneys fees as set forth in the Court's Findings of Fact and Conclusions of Law. (Signed by Judge Jerry Buchmeyer ) Copies to counsel: 08/09/02 Page(s): 1 (jaw) (Entered: 08/09/2002)
08/09/2002		Case closed (jaw) (Entered: 08/09/2002)
08/20/2002	<u>70</u>	RESPONSE by defendant Robert H Peterson Co to [62-1] motion to disregard the testimony of John Palaski. (8) (jaw) (Entered: 08/21/2002)
08/23/2002	<u>71</u>	MOTION by defendant Robert H Peterson Co for leave to file under seal Peterson Company's First Motion to Amend Findings of Fact, Conclusions of Law and Judgment in accordance wuth Rule 52(b) FRCP . (3) (jaw) Modified on 08/26/2002 (Entered: 08/26/2002)
08/23/2002	<u>72</u>	SECOND MOTION by defendant Robert H Peterson Co to amend [68-1] findings of fact order, [69-1] judgment order under Rule 52(b), or, for new trial under Rule 59(a), FRCP . (3) (jaw) Modified on 08/26/2002 (Entered: 08/26/2002)
08/23/2002	<u>73</u>	MEMORANDUM by defendant Robert H Peterson Co in support of [72-1] motion to amend [68-1] findings of fact order, [69-1] judgment order under Rule 52(b), or, for new trial under Rule 59(a), FRCP. (15+)(Exhibits not imaged.) (jaw) (Entered: 08/26/2002)
08/23/2002	<u>74</u>	MOTION with memorandum in support by plaintiff Golden Blount, Inc to include updated damages and pre and post judgment interest . (15+)(Exhibits not imaged.) (jaw) Modified on 09/05/2002 (Entered: 08/26/2002)

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08/23/2002	<u>75</u>	APPLICATION/MOTION by plaintiff Golden Blount, Inc for attorney fees . (5) (jaw) (Entered: 08/26/2002)
08/23/2002	<u>76</u>	MEMORANDUM by plaintiff Golden Blount, Inc in support of [75-1]-motion for attorney fees. (15+) (jaw) (Entered: 08/26/2002)
08/23/2002	<u>77</u>	APPENDIX by plaintiff Golden Blount, Inc in support of [75-1] motion for attorney fees. (15+)(Not imaged.) (jaw) Modified on 08/26/2002 (Entered: 08/26/2002)
08/23/2002	<u>78</u>	Bill of costs. (15+)(Exhibits not imaged.) (jaw) (Entered: 08/26/2002)
08/27/2002		Costs \$10,031.04. taxed for plaintiff Golden Blount, Inc. (jaw) (Entered: 08/27/2002)
09/04/2002	<u>79</u>	REPLY by plaintiff Golden Blount, Inc to response to [62-1] motion to disregard the testimony of John Palaski. (4) (jaw) (Entered: 09/05/2002)
09/09/2002	<u>80</u>	JOINT MOTION for one-week extension of time to respond to post-trial motions by plaintiff, defendant. (3) (jaw) (Entered: 09/09/2002)
09/12/2002	<u>81</u>	ORDER granting [80-1] joint motion for one-week extension of time to respond to post-trial motions. Response to motion reset to 9/19/02 for [75-1] motion for attorney fees; [74-1] motion to include updated damages and pre and post judgment interest; and for [72-1] motion to amend [68-1] findings of fact order, [69-1] judgment order under Rule 52(b), or, for new trial under Rule 59(a), FRCP. Response to motion reset to 9/23/02 for first motion to amend Findings of Fact, Conclusions of law. See order for specifics. (Signed by Judge Jerry Buchmeyer ) Copies to counsel: 09/13/02 Page(s) 1 (jaw) (Entered: 09/13/2002)
09/19/2002	<u>82</u>	OBJECTIONS/RESPONSE by defendant Robert H Peterson Co in opposition to [75-1] motion for attorney fees. (15+)(Exhibits not imaged.) (jaw) Modified on 09/20/2002 (Entered: 09/20/2002)
09/19/2002	<u>83</u>	OBJECTIONS/RESPONSE by defendant Robert H Peterson Co in opposition to [74-1] motion to include updated damages and pre and post judgment interest. (15+)(Exhibits not imaged.) (jaw) (Entered: 09/20/2002)
09/19/2002	<u>84</u>	RESPONSE by plaintiff Golden Blount, Inc to [72-1] motion to amend [68-1] findings of fact order, [69-1] judgment order under Rule 52(b), or, for new trial under Rule 59(a), FRCP. (15+)(Exhibits not imaged.) (jaw) (Entered: 09/20/2002)
09/23/2002	<u>85</u>	RESPONSE by plaintiff Golden Blount, Inc. to Peterson Company's First Motion to Amend Findings of Fact, Conclusions of Law and Judgment in accordance with Rule 52 (b) FRCP. (3) (jaw) (Entered: 09/24/2002)
10/04/2002	<u>86</u>	REPLY by plaintiff Golden Blount, Inc to response to [74-1] motion to include updated damages and pre and post judgment interest. (9)(Exhibit not imaged.) (jaw) Modified on 10/04/2002 (Entered: 10/04/2002)
10/04/2002	<u>87</u>	REPLY by plaintiff Golden Blount, Inc to response to [75-1] motion for attorney fees. (15+)(Exhibits not imaged.) (jaw) (Entered: 10/04/2002)
10/04/2002	<u>88</u>	REPLY by defendant Robert H Peterson Co to response to [72-1] motion to amend [68-1] findings of fact order, [69-1] judgment order under Rule 52(b), or, for new trial under Rule 59(a), FRCP. (15+)(Exhibits not imaged.) (jaw) (Entered: 10/04/2002)
10/04/2002	<u>89</u>	PROFFER TO THE COURT FOR IN CAMERA REVIEW by plaintiff Golden Blount, Inc. (3) (jaw) (Entered: 10/07/2002)
2/07/2003	<u>90</u>	ORDER denying [62-1] motion to disregard the testimony of John Palaski; granting [71-

		1] motion for leave to file under seal Peterson Company's First Motion to Amend Findings of Fact, Conclusions of Law and Judgment in accordance with Rule 52(b) FRCP; denying [72-1] Second Motion to amend [68-1] findings of fact order, [69-1] judgment order under Rule 52(b), or, for new trial under Rule 59(a), FRCP; granting [74-1] motion to include updated damages and pre and post judgment interest, granting [75-1] motion for attorney fees. Plaintiff's Application for Attorney's Fees is hereby granted. Plaintiff is awarded reasonable attorney's fee sin the amount of \$332,349.00. Plaintiff's Motion for Updated Damages and Pre and Post Judgment Interest is hereby granted to the extent that the award of damages is updated to cover the period between May 1st and August 9, 2002. Defendant is ordered to provide this Court, within 10 calendar days of the date of this Order, with sales figures for the ember flame unit for the period from 5/1/02 to May 9, 2002. See order for specifics. ( Signed by Judge Jerry Buchmeyer ) Copies to counsel: 02/07/03 Page(s) 2 (jaw) (Entered: 02/07/2003)
02/07/2003	91	SEALED DOCUMENT placed in sealed area (svc) (Entered: 02/10/2003)
02/07/2003	92	SEALED DOCUMENT placed in sealed area (svc) (Entered: 02/10/2003)
02/18/2003	93	AGREED MOTION for a one-week extension of time by Golden Blount, Inc., Robert H Peterson Co. (jaw) (Entered: 02/18/2003)
02/19/2003	94	ORDER granting 93 Motion to Extend Time...the deadline for Robert H. Peterson Co. to provide sales figures for the ember flame unit for the period from 5/1/02 to 8/9/02 is extended from 2/17/03 until and including 2/24/03. (Signed by Judge Jerry Buchmeyer on 02/19/03) (jaw, ) (Entered: 02/20/2003)
02/24/2003	95	RESPONSE to Order re 90 Order of 2/6/03 filed by Robert H Peterson Co. (jaw, ) (Entered: 02/27/2003)
02/28/2003	96	NOTICE To the Court that Defendant Peterson Company's Response to the Court's Order of 2/6/03 Contains Volunteered and Non-Responsive Information by Golden Blount, Inc. (jaw, ) (Entered: 03/03/2003)
03/06/2003	97	NOTICE OF APPEAL TO FEDERAL COURT OF APPEALS as to 90 Order,,,, 69 Judgment, by Robert H Peterson Co. (jmr, )cc:Judge.; NO FEE PAID. TO MAILED. (attachments not imaged.) Modified on 3/11/2003 (jmr, ). (Entered: 03/07/2003)
03/07/2003		Transmission of Notice of Appeal and Docket Sheet to US Court of Appeals re 97 Notice of Appeal (jmr, ) (Entered: 03/07/2003)
03/10/2003	98	ORDER: Pursuant to this Court's post-trial Order (entered 2/7/03), the Final Judgment (entered 8/9/02) is hereby amended as follows: Plaintiff is awarded actual damages in the amount of \$439,016, and actual damages are trebled, totaling \$1,317,048. Plaintiff is awarded prejudgment interest, which shall be calculated on a simple rather than compound basis, on the actual damages of \$439,016 at the rate of 5.0% for the period from 12/10/99 to 8/9/02 Plaintiff is awarded reasonable attorney's fees in the amount of \$332,349. Plaintiff is awarded postjudgment interest... at the rate of 1.88% from the date of the Final Judgment. Costs shall be taxed against Defendant. (Signed by Judge Jerry Buchmeyer on 03/10/03) (jaw, ) (Entered: 03/11/2003)
03/18/2003	99	AMENDED NOTICE OF APPEAL TO US. FEDERAL CIRCUIT COURT OF APPEALS as to 90 Order,,,,, 69 Judgment,, 98 Order,,,, 68 Findings of Fact & Conclusions of Law, by Robert H Peterson Co. TOOC Receipt # 192347.(jmr, )cc:Judge (Entered: 03/19/2003)
03/19/2003		Transmission of Notice of Appeal and Docket Sheet to US Federal Circuit Court of Appeals re 99 Notice of Appeal (jmr, ) (Entered: 03/19/2003)

3/25/2003		US Federal Court of Appeals Case Number 03-1298 for <u>97</u> Notice of Appeal filed by Robert H Peterson Co. (jmr, ) (Entered: 03/25/2003)
3/31/2003	<u>100</u>	TRANSCRIPT REQUEST by Robert H Peterson Co for proceedings held on 7/29-31/02 Bench Trial before Judge Buchmeyer, re <u>97</u> Notice of Appeal, <u>99</u> Notice of Appeal. to US Federal Court of Appeals (jmr, ) (Entered: 03/31/2003)
5/08/2003	<u>101</u>	AGREED ORDER Pursuant to Local Rule 67.1, and by agreement of the parties, it is hereby ordered that Defendant may deposit cash in the registry of the Court in the amount of \$2,061,710.00 in lieu of (but with the same legal effect as) giving a supersedeas bond pursuant to FRCP 62. (Signed by Judge Barefoot Sanders for Judge Jerry Buchmeyer on 05/08/03) (jaw) (Entered: 05/09/2003)
4/23/2004	<u>102</u>	JUDGMENT/MANDATE of USCA: Affirmed in part, vacated in part, and remanded. No costs; as to <u>99</u> Notice of Appeal filed by Robert H Peterson Co, <u>97</u> Notice of Appeal filed by Robert H Peterson Co. Issued as Mandate: 4/19/04. (jmr) (Entered: 04/27/2004)
5/11/2004	<u>103</u>	ORDER: The parties shall submit proposed findings of fact and conclusions of law on the issues of literal infringement, contributory infringement, induced infringement, infringement under the doctrine of equivalents, willfulness, the exceptional nature of the case, and damages by 6/10/04. (Signed by Judge Jerry Buchmeyer on 5/11/04) (aat, ) (Entered: 05/12/2004)
5/17/2004	<u>106</u>	Opinion of USCA: Affirmed in part, vacated in part and remanded; no costs; (certified copy) in accordance with USCA judgment re <u>97</u> Notice of Appeal filed by Robert H Peterson Co. (jmr) (Entered: 05/24/2004)
5/17/2004	<u>107</u>	JUDGMENT/MANDATE of USCA: Affirmed in part, vacated in part, remanded; as to <u>99</u> Notice of Appeal filed by Robert H Peterson Co, <u>97</u> Notice of Appeal filed by Robert H Peterson Co. Issued as Mandate: 5/10/04. (jmr) (Entered: 05/24/2004)
5/18/2004	<u>104</u>	MOTION for immediate return of cash security by Robert H Peterson Co (aat, ) (Entered: 05/19/2004)
5/18/2004	<u>105</u>	MEMORANDUM in support re <u>104</u> motion for immediate return of cash security filed by Robert H Peterson Co. (aat, ) (Entered: 05/19/2004)
6/07/2004	<u>108</u>	MEMORANDUM in opposition re <u>104</u> motion for immediate return of cash security filed by Golden Blount, Inc. (aat, ) (Entered: 06/08/2004)
6/09/2004	<u>109</u>	ORDER granting <u>104</u> motion for immediate return of cash security. (Signed by Judge Jerry Buchmeyer on 6/9/04) (aat, ) (Entered: 06/09/2004)
6/10/2004	<u>110</u>	PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW by Golden Blount, Inc. (aat, ) (Entered: 06/14/2004)
6/10/2004	<u>111</u>	PROPOSED FINDINGS OF FACT AND CONCLUSIONS OF LAW by Robert H Peterson Co. (aat, ) (Entered: 06/14/2004)
6/22/2004	<u>112</u>	***VACATED PER 9/2/04 ORDER***ORDER ADOPTING <u>111</u> proposed findings of fact filed by Robert H Peterson Co (Signed by Judge Jerry Buchmeyer on 6/22/04) (aat, ) (Entered: 06/23/2004)
6/28/2004	<u>113</u>	Application and Order for Admission Pro Hac Vice by David S Becker for Robert H Peterson Co. (Signed by Judge Jerry Buchmeyer on 6/28/04) Copy to Becker.(aat, ) (Entered: 06/29/2004)
5/28/2004	<u>114</u>	Application and Order for Admission Pro Hac Vice by Leland W Hutchinson for Robert

		H Peterson Co. (Signed by Judge Jerry Buchmeyer on 6/28/04) Copy to Hutchinson (aat, ) (Entered: 06/29/2004)
07/06/2004	<u>115</u>	REQUEST/MOTION for reconsideration of adoption of defendant's findings of fact and conclusions of law, alternative MOTION for new trial and REQUEST for oral hearing by Golden Blount, Inc (aat, ) (Entered: 07/07/2004)
07/06/2004	<u>116</u>	MOTION to amend its findings of fact and conclusions of law by Golden Blount, Inc (aat, ) (Entered: 07/07/2004)
07/06/2004	<u>117</u>	BRIEF in support re <u>115</u> request/motion for reconsideration of adoption of defendant's findings of fact and conclusions of law, alternative motion for new trial and request for oral hearing filed by Golden Blount, Inc. (aat, ) (Entered: 07/07/2004)
07/08/2004	<u>118</u>	ORDER as to <u>116</u> motion to amend its findings of fact and conclusions of law. Motion hearing set for 8/4/2004 at 10:00 AM before Judge Jerry Buchmeyer. (Signed by Judge Jerry Buchmeyer on 7/8/04) (aat, ) (Entered: 07/08/2004)
07/22/2004	<u>119</u>	APPLICATION for attorneys' fees by Robert H Peterson Co (aat, ) (Entered: 07/23/2004)
07/22/2004	<u>120</u>	MEMORANDUM in support re <u>119</u> application for attorneys' fees filed by Robert H Peterson Co. (aat, ) (Entered: 07/23/2004)
07/22/2004	<u>121</u>	DECLARATION of Jerry R. Selinger in support of <u>119</u> application for attorneys' fees. (aat, ) (Entered: 07/23/2004)
07/22/2004	<u>122</u>	DECLARATION of F. William McLaughlin in support of <u>119</u> application for attorneys' fees. (aat, ) (Entered: 07/23/2004)
07/22/2004	<u>123</u>	DECLARATION of Leland W. Hutchinson, Jr. in support of <u>119</u> application for attorneys' fees. (aat, ) (Entered: 07/23/2004)
07/23/2004	<u>124</u>	RESPONSE in opposition re <u>115</u> motion for reconsideration and for a new trial and <u>116</u> motion to amend findings filed by Robert H Peterson Co. (aat, ) (Entered: 07/26/2004)
07/23/2004	<u>125</u>	ORDER as to <u>116</u> motion to amend it's findings of fact and conclusions of law. Hearing reset for 8/18/2004 at 10:00 AM before Judge Jerry Buchmeyer. (Signed by Judge Jerry Buchmeyer on 7/23/04) (aat, ) (Entered: 07/26/2004)
08/09/2004	<u>126</u>	REPLY to Defendant's opposition to Motion <u>115</u> amend findings, for reconsideration and for a new trial filed by Golden Blount, Inc. (svc, ) (Entered: 08/10/2004)
08/11/2004	<u>127</u>	***VACATED PER 9/2/04 ORDER***ORDER granting <u>119</u> motion for attorney fees. (Signed by Judge Jerry Buchmeyer on 8/11/04) (aat, ) (Entered: 08/11/2004)
08/18/2004	<u>128</u>	Minute Entry for proceedings held before Judge Jerry Buchmeyer : Motion hearing held on 8/18/04 re <u>115</u> motion for reconsideration filed by Golden Blount, Inc. Defendant's findings of fact and conclusions of law vacated, plaintiff's findings of fact and conclusions of law adopted. (Court Reporter Joe Belton.) (aat, ) (Entered: 08/19/2004)
08/31/2004	<u>129</u>	Proposed Findings of Fact and Conclusions of Law by Golden Blount, Inc. (svc, ) (Entered: 09/01/2004)
09/02/2004	<u>130</u>	ORDER: The Court vacates defendant Robert H. Peterson's application for attorneys' fees previously adopted on 8/11/04. (Signed by Judge Jerry Buchmeyer on 9/2/04) (aat, ) (Entered: 09/02/2004)
09/02/2004	<u>131</u>	ORDER: The Court vacates defendant's findings of fact and conclusions of law

		previously adopted on 6/22/04. The Court adopts plaintiff's findings of fact and conclusions of law submitted 8/31/04. (Signed by Judge Jerry Buchmeyer on 9/2/04) (aat, ) (Entered: 09/02/2004)
9/02/2004	<u>132</u>	FINDINGS OF FACT AND CONCLUSIONS OF LAW. Blount is entitled to actual damages from Peterson of \$429,256. The infringement of Peterson was willful, thus the actual damages are trebled, totaling \$1,287,768. Blount is also awarded prejudgment interest on the actual damages of \$429,256 at the rate of 5.0% for the period from 12/16/99 to 8/9/02. Reasonable attorneys' fees are awarded to Blount. Blount is awarded post judgment fees at the highest rate allowed by the law from 8/9/02 to 4/19/04, and resuming from the date of the signing of the final judgment. (Signed by Judge Jerry Buchmeyer on 9/2/04) (aat, ) (Entered: 09/03/2004)
9/08/2004	<u>133</u>	APPLICATION for attorneys' fees by Golden Blount, Inc (aat, ) (Entered: 09/09/2004)
9/08/2004	<u>134</u>	MEMORANDUM in support re <u>133</u> application for attorneys' fees filed by Golden Blount, Inc. (aat, ) (Entered: 09/09/2004)
9/08/2004	<u>135</u>	APPENDIX in support re <u>133</u> application for attorneys' fees filed by Golden Blount, Inc. (aat, ) (Entered: 09/09/2004)
9/09/2004	<u>136</u>	APPLICATION for costs by Golden Blount, Inc (aat, ) (Entered: 09/10/2004)
9/16/2004	<u>137</u>	ORDER OF REFERENCE: <u>133</u> Motion for attorney fees filed by Golden Blount, Inc. and <u>136</u> application for for costs filed by Golden Blount, Inc. are referred to US Magistrate Judge Stickney. (Signed by Judge Jerry Buchmeyer on 9/16/04) (aat, ) (Entered: 09/17/2004)
9/17/2004	<u>138</u>	NOTICE OF APPEAL as to <u>132</u> Findings of Fact & Conclusions of Law, <u>130</u> Order vacating defendant Peterson's application for attorney's fees adopted 8/11/04, <u>131</u> Order vacating defendant's findings of fact and conclusions of law adopted 6/22/04, by Robert H Peterson Co. (jmr) (Entered: 09/20/2004)
9/17/2004	<u>139</u>	Opposition to Plaintiff's <u>133</u> MOTION for Attorney Fees, <u>136</u> MOTION for costs filed by Robert H Peterson Co. (lmr, ) (Entered: 09/20/2004)
9/17/2004	<u>140</u>	Appendix in Support <u>136</u> Application for Attorney Fees and Costs filed by Robert H Peterson Co. (lmr, ) (Entered: 09/21/2004)
9/20/2004		Transmission of Notice of Appeal and Docket Sheet to US Federal Court of Appeals re <u>138</u> Notice of Appeal. (jmr) (Entered: 09/20/2004)
9/21/2004		USCA Appeal Fees received \$ 255 receipt number 211323 re <u>138</u> Notice of Appeal, filed by Robert H Peterson Co (ddb, ) (Entered: 09/21/2004)
9/23/2004	<u>141</u>	REPLY to response to motion re <u>133</u> and <u>136</u> application for attorneys' fees and costs and OBJECTION to defendant's untimely filing of notice of appeal filed by Golden Blount, Inc. (aat, ) (Entered: 09/24/2004)
9/23/2004	<u>142</u>	TRANSCRIPT REQUEST by Robert H Peterson Co for proceeding held on 8/18/04 Motion Hearing before Judge Buchmeyer, re <u>138</u> Notice of Appeal. Court Reporter: Joe Belton. (jmr) (Entered: 09/24/2004)
0/01/2004		USFCA Case Number 04-1609 for <u>138</u> Notice of Appeal, filed by Robert H Peterson Co. (jmr) (Entered: 10/12/2004)
0/28/2004	<u>143</u>	JOINT MOTION to approve supersedeas bond and stay execution by Golden Blount, Inc, Robert H Peterson Co (aat, ) (Entered: 10/29/2004)

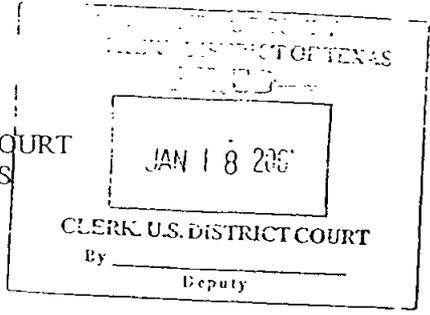
10/29/2004	<u>144</u>	AGREED ORDER granting <u>143</u> joint motion to approve supersedeas bond and stay judgment. Defendant shall file a supersedeas bond of \$2,372,649. (Signed by Judge Jerry Buchmeyer on 10/29/04) (aat, ) (Entered: 11/01/2004)
11/04/2004	<u>145</u>	Supersedeas Bond in the amount of \$2,372,649 posted by Robert H Peterson Co. (aat, ) (Entered: 11/05/2004)
11/15/2004	<u>146</u>	TRANSCRIPT filed for date of 8/18/04 before Judge Buchmeyer re <u>138</u> Notice of Appeal. Court Reporter: Joe Belton. (jmr) (Entered: 11/15/2004)
11/15/2004	<u>147</u>	ORDER granting in part and denying in part <u>133</u> motion for attorney fees and granting <u>136</u> motion for costs. The Court grants plaintiff's request for attorney fees in the amount of \$622,015.00 and plaintiff's request for costs of \$3,679.83. (Signed by Judge Paul D Stickney on 11/12/04) (aat, ) (Entered: 11/17/2004)
11/15/2004	<u>148</u>	BILL OF COSTS by Golden Blount, Inc. (aat, ) (Entered: 11/17/2004)
11/17/2004		Costs Taxed in amount of \$ 3,679.83 against Robert H. Peterson Co. (aat, ) (Entered: 11/17/2004)
12/08/2004	<u>149</u>	SUBMISSION of final judgment and order dismissing remaining pending motions by Golden Blount, Inc (aat, ) (Entered: 12/09/2004)
12/09/2004	<u>150</u>	NOTICE OF APPEAL as to <u>132</u> Findings of Fact & Conclusions of Law, <u>147</u> Order on Motion for Attorney Fees, Order on Motion for Miscellaneous Relief, <u>127</u> Order on Motion for Attorney Fees, <u>130</u> Order vacating Motion for Attorneys Fees, <u>131</u> Order vacating Findings of Fact and Conclusions of Law, by Robert H Peterson Co. Filing fee \$ 255, receipt number 214044. TOOC. (jmr) (Entered: 12/13/2004)
12/13/2004		Transmission of Notice of Appeal and Docket Sheet to US Federal Court of Appeals re <u>150</u> Notice of Appeal. (jmr) (Entered: 12/13/2004)
12/15/2004	<u>151</u>	ORDER DISMISSING REMAINING PENDING MOTIONS. (Signed by Judge Jerry Buchmeyer on 12/15/04) (aat, ) (Entered: 12/16/2004)
12/15/2004	<u>152</u>	FINAL JUDGMENT. Plaintiff recovers damages as set forth in the findings of fact and conclusions of law of 9/2/04, and reasonable attorneys fees and costs as set forth in the Court's order granting attorney's fees and costs 11/15/04. Interest shall run on the damages, attorney's fees and costs as set forth in the 9/2/04 findings. (Signed by Judge Jerry Buchmeyer on 12/15/04) (aat, ) (Entered: 12/16/2004)
01/13/2005	<u>153</u>	NOTICE of Docketing Notice of Appeal from USFCA re <u>150</u> Notice of Appeal, filed by Robert H Peterson Co. USFCA Case Number 05-1141. (jmr) (Entered: 01/13/2005)
01/14/2005	<u>154</u>	NOTICE OF APPEAL as to <u>132</u> Findings of Fact & Conclusions of Law, <u>147</u> Order on Motion for Attorney Fees, Order on Motion for Miscellaneous Relie, <u>152</u> Judgment, <u>130</u> Order, <u>131</u> Order, by Robert H Peterson Co. Filing fee \$ 255, receipt number 215143. TOOC. (jmr) (Entered: 01/18/2005)
01/18/2005	<u>155</u>	Transmission of Notice of Appeal and Docket Sheet to US Federal Court of Appeals re <u>154</u> Notice of Appeal. (jmr) (Entered: 01/18/2005)
01/31/2005	<u>156</u>	ORDER of USFCA as to <u>150</u> Notice of Appeal, filed by Robert H Peterson Co, <u>154</u> Notice of Appeal, filed by Robert H Peterson Co. The appeals are consolidated. The case number is 05-1141,-1202. (jmr) (Entered: 01/31/2005)

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<b>PACER Service Center</b>			
<b>Transaction Receipt</b>			
04/20/2005 10:31:04			
<b>PACER Login:</b>	fp0009	<b>Client Code:</b>	22148-0003
<b>Description:</b>	Docket Report	<b>Search Criteria:</b>	3:01-cv-00127
<b>Billable Pages:</b>	10	<b>Cost:</b>	0.80

JT-APP 0108

IN THE UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.

Plaintiff,

v

ROBERT H. PETERSON CO.

Defendant.

§  
§  
§  
§  
§  
§  
§  
§

2-01070127-R  
Civil Action No.

(JURY TRIAL DEMANDED)

COMPLAINT FOR PATENT INFRINGEMENT AND JURY DEMAND

TO THE HONORABLE UNITED STATES DISTRICT COURT:

Plaintiff, Golden Blount, Inc. ("Golden Blount"), by its attorneys, complains against Defendant, Robert H. Peterson Co. ("Peterson"), as follows:

PARTIES, JURISDICTION AND VENUE

1. Plaintiff Golden Blount is a corporation organized and existing under the laws of the State of Texas, having a place of business at 5310 Harbor Town, Dallas, Texas 75287.

2. On information and belief, Defendant Peterson, is a corporation organized and existing under the laws of the State of California. On information and belief, Peterson has been, and is now, directly and through its agents and intermediaries, doing business continuously and systematically in this judicial district and elsewhere in Texas.

3. This Court has original and exclusive jurisdiction pursuant to Title 28 United States Code, Sections 1331 and 1338(a) because this action arises under the Patent Laws of the United States (Title 35 United States Code, Section 1 et seq.) for

SECRET

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infringement of a United States Patent. Venue in this Judicial District is proper pursuant to Title 28 United States Code, Sections 1400(b) with 1391(c).

CLAIM FOR PATENT INFRINGEMENT

4. United States Patent No. 5,988,159 (“159 Patent”), entitled “GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY”, was duly and legally issued on November 23, 1999 for an inventive gas fired artificial logs and coals-burner assembly. Golden Blount is the owner of the ‘159 Patent. A copy of the ‘159 Patent is attached hereto as Exhibit A.

5. The Defendant Peterson has, within the six years next preceding the filing of this Complaint, infringed the ‘159 Patent in violation of Title 35 United States Code, Section 271(a), through its making, using, offering to sell, and selling the “Ember Flame Booster” accessory (a picture of the device is attached hereto as Exhibit B), to the damage and injury of Golden Blount.

6. On information and belief, Peterson will continue its infringing conduct, and its conduct which induces or contributes to infringement, unless enjoined by this Court.

7. Peterson’s infringing activities are being conducted without right, license or permission from Golden Blount.

PRAYER AND RELIEF

WHEREFORE, Golden Blount petitions this Court for a judgment:

A. That the ‘159 Patent is valid and that the claims thereof have been infringed by Peterson;

B. Preliminarily and permanently enjoining Peterson, its directors, officers, employees, attorneys, agents and all other person in active concert or participation with any of the foregoing from further acts of infringement, contributory infringement or inducement infringement of the '159 Patent;

C. For an accounting and an award of damages adequate to compensate Golden Blount for infringement of the '159 Patent by Peterson, but in no event less than a reasonable royalty for the use made of the invention, together with interest thereon;

D. Awarding to Golden Blount its costs and attorney fees; and

E. Awarding to Golden Blount such other and further relief as this Court deems proper and just.

JURY DEMAND

Plaintiff demands a trial by jury of all issues triable by a jury.

Dated: January 18, 2001

Respectfully submitted,



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ATTORNEYS FOR PLAINTIFF



A

JT-APP 0113



US005988159A

# United States Patent [19]

Blount

[11] Patent Number: 5,988,159

[45] Date of Patent: Nov. 23, 1999

[54] GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY

5,033,455	7/1991	Eilber et al.	126/512
5,052,370	10/1991	Karabin	126/512
5,081,981	1/1992	Beal	126/92 R
5,263,852	11/1993	Beck	431/125

[76] Inventor: Golden Blount, 5310 Harbor Town, Dallas, Tex. 75287

Primary Examiner—Larry Jones  
Attorney, Agent, or Firm—L. Dao Tucker

[21] Appl. No.: 08/626,498

[22] Filed: Apr. 2, 1996

[57] ABSTRACT

### Related U.S. Application Data

[63] Continuation-in-part of application No 08/276,894, Jul. 19, 1994, abandoned, which is a continuation-in-part of application No 08/061,727, May 17, 1993, abandoned.

[51] Int. Cl.<sup>6</sup> F23C 1/18

[52] U.S. Cl. 126/512; 126/500; 126/540; 431/125

[58] Field of Search 431/125; 126/512; 126/500; 524; 540; 503

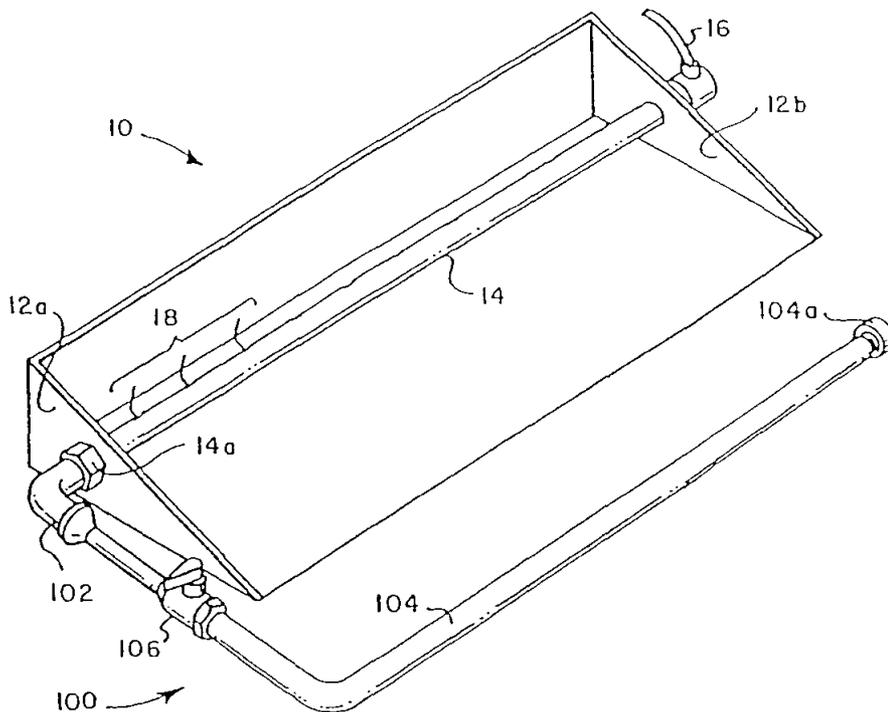
A gas-fired artificial logs and coals-burner assembly is provided for fireplace use in cooperation with decorative gas logs, and artificial coals and embers decorative items by placement forward of the gas logs in the fireplace arrangement, a secondary elongated coals- and embers-burner tube apparatus. The assembly provides gas-fired artificial logs, coals- and embers-burner apparatus for fireplaces wherein gas flow through primary burner tube is the source of gas flow to a secondary coals- and embers-burner tube positioned forward and below the primary burner tube with multiple discharge ports in the secondary tube directed away from the front of the fireplace, thus enhancing the natural burn in cooperation of the fireplace draft as well as the aesthetic beauty of the imitation burning logs, coals and embers.

### [56] References Cited

#### U.S. PATENT DOCUMENTS

3,042,109	7/1962	Peterson	126/512
3,871,355	3/1975	Henry	431/125 X
5,000,162	3/1991	Shimck et al.	126/512

19 Claims, 3 Drawing Sheets



JT-APP 0114

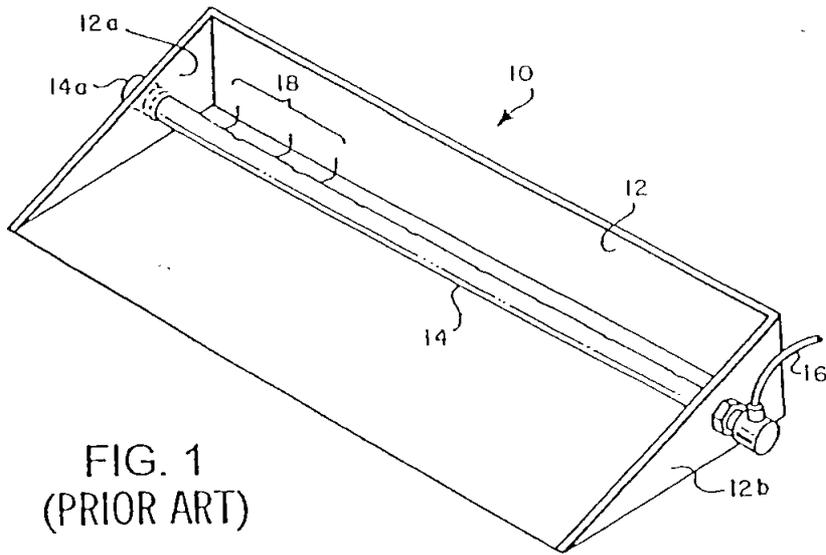


FIG. 1  
(PRIOR ART)

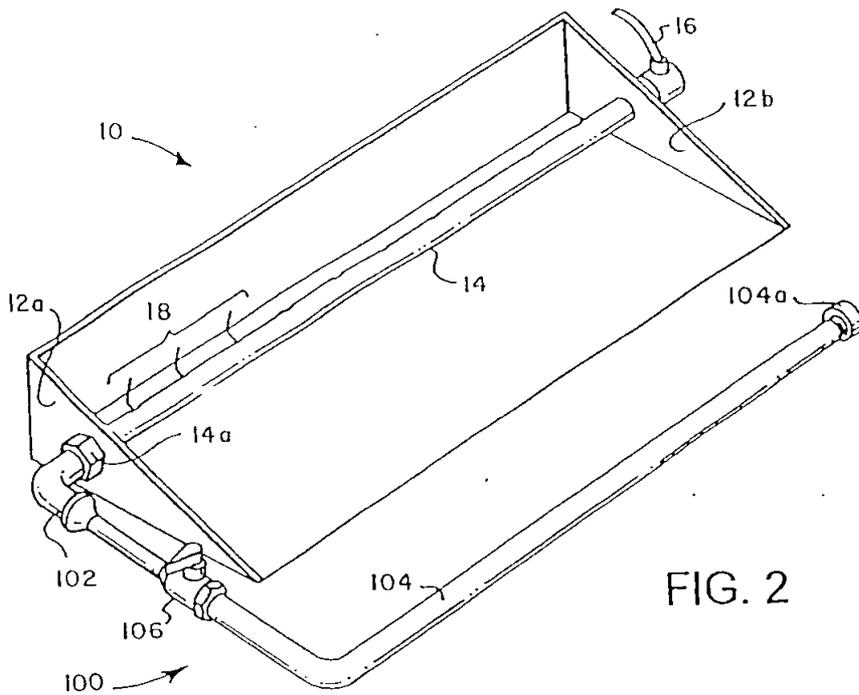


FIG. 2

FIG. 3

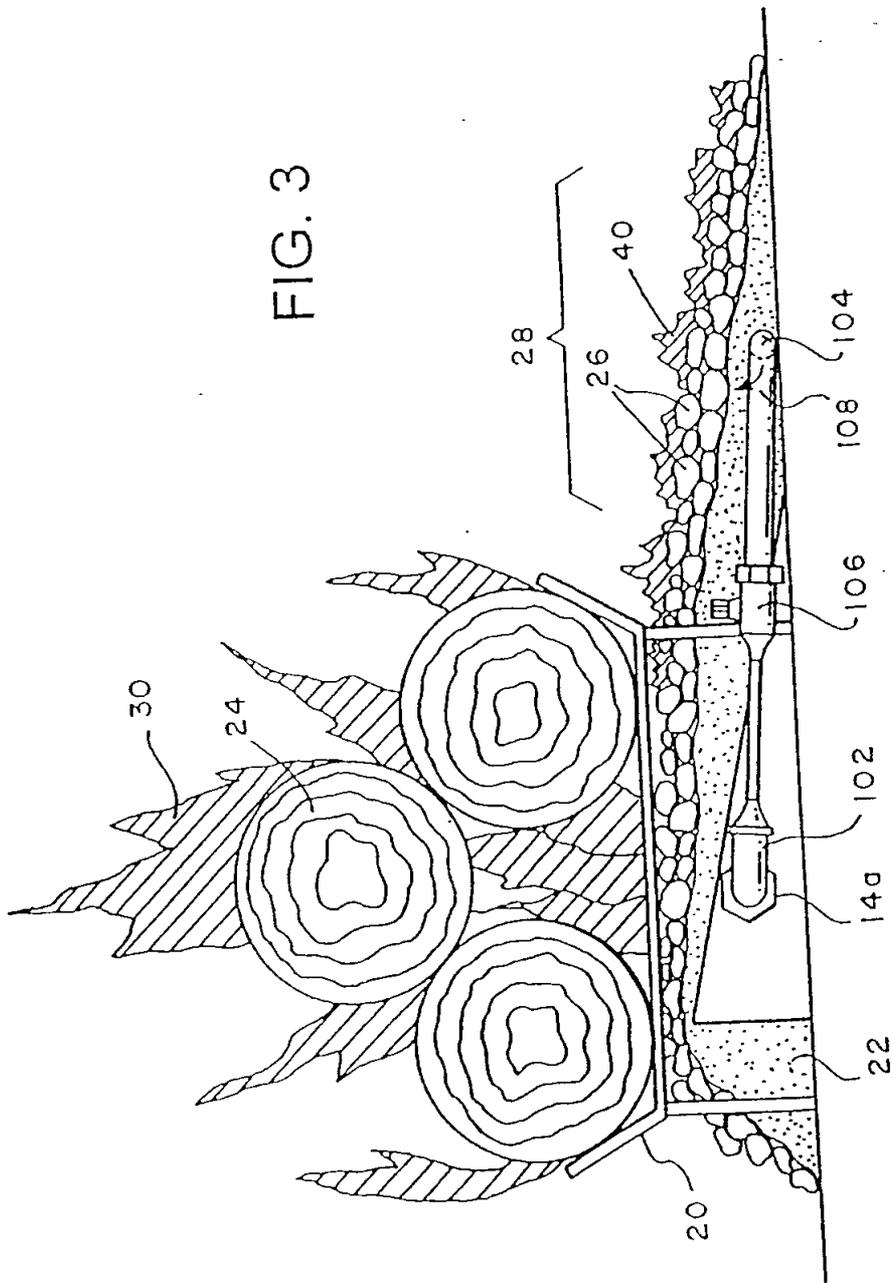
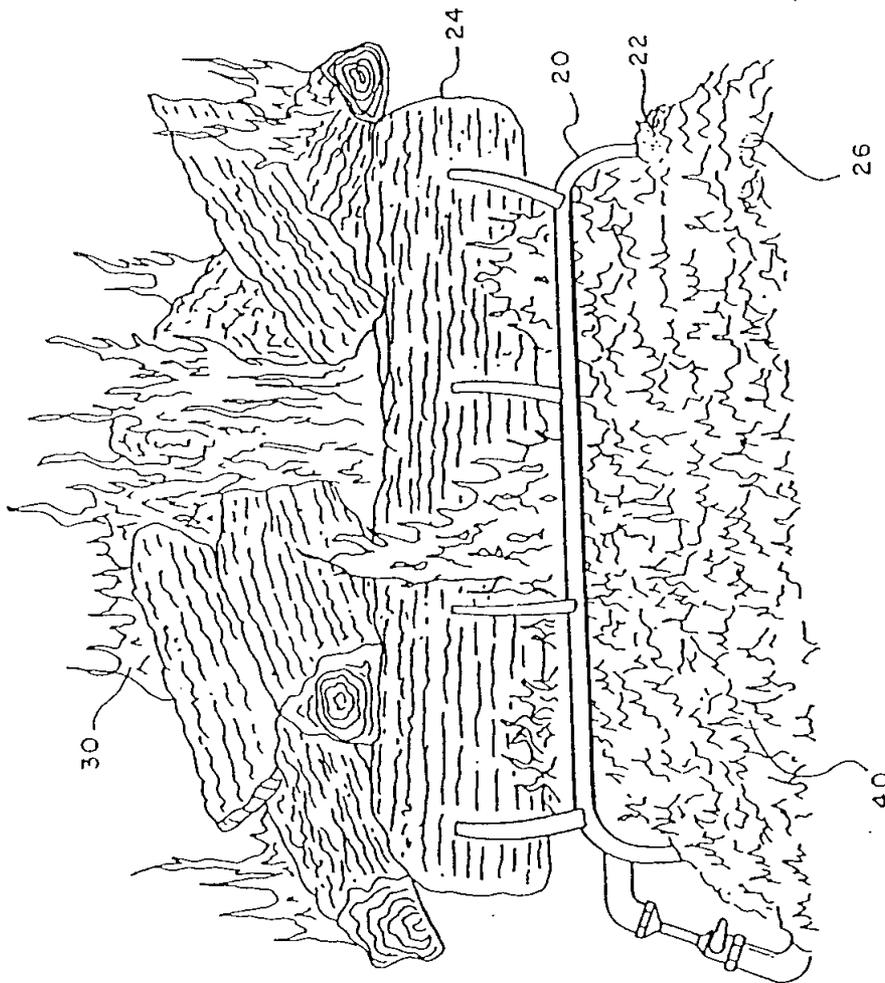


FIG. 4



## GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY

The present application is a continuation-in-part application of U.S. patent application Ser. No. 08/276,894, filed Jul. 19, 1994, now abandoned, entitled "A Supplemental Burner for Retrofitting to an Existing Gas Log Burner Assembly" which is a continuation-in-part application of U.S. patent application Ser. No. 08/061,727, filed May 17, 1993, entitled "Controlled Ember Bed Burner" which is now abandoned.

### TECHNICAL FIELD OF THE INVENTION

The present invention relates to a gas-fired artificial logs and coals-burner assembly for a fireplace to be used with decorative gas logs and coals or embers decorative items placed forward of the gas logs in the fireplace arrangement. In another aspect, the invention relates to coals- and embers-burner apparatus suitable for attaching to a terminal end of a gas-fired primary artificial burner, the coals- and embers-burner assembly utilizing a valve between the primary artificial logs burner and the coals- and embers-burner.

In yet another aspect, the invention relates to a gas-fired artificial logs, coals- and embers-burner assembly for fireplace wherein gas flow through a primary burner tube is the source for gas flow to a secondary coals burner tube positioned forward and below the primary burner tube with the multiple discharge ports in the secondary tube directed away from the front of the fireplace.

The present further relates to efficient gas burners for burning natural gas, manufactured gas and propane gaseous fuels within a fireplace environment. In addition, the invention provides an efficient burner system for burning gaseous fuels in a manner which provides decorative flames and decorative coals and embers which simulate wood burning.

Gas logs are usually made of a fire resistant ceramic material; however, when gas flames are directed against such ceramic materials, the gas flame is cooled by the artificial logs and many times produces a highly inefficient and dirty yellow flame. Such a flame further indicates incomplete burn of the gaseous materials due to a lack of sufficient burn temperature and oxygen supply thus creating excessive soot and carbon monoxide. Various attempts have been made in correcting these decorative fireplace gas log deficiencies.

Further it is known that gas burners or gas nozzles can be buried below a level of sand and vermiculite. These burner systems are referred to as sand pan burners which disburse the gasses through the fireproof material and permit the gas permeating through the porous material to ignite upon entering the atmosphere. Such systems allow disbursement of the flames over a large area or bed of material. Such disbursement of flames creates a more efficient burn which further simulates the action of burning wood, ashes and embers in a fireplace.

Prior art burner systems for artificial decorative logs and sand pan type burners are incorporated in various prefabricated fireplaces or existing masonry fireplaces; however, such systems are required to meet the ANSI emission standards which have been adapted by the American Gas Institute. Accordingly, it is very desirable to provide a clean burning gas-fired artificial logs and coals-burner assembly which meet the present ANSI emission standards.

Gas logs are increasingly popular in homes. Decorative artificial logs are placed on a grate which is located over a gas burner. The burner is typically a tube with spaced

apertures. Sand is poured over the gas burner to hide it from sight. Artificial embers are then spread across the sand. In use, gas flows through the burner and escapes through the spaced apertures. The gas filters up through the sand underneath the artificial logs. The gas is ignited and creates flames between the logs. The height of the flame is controlled by a primary valve which can be manipulated by the user.

Gas logs can, under these conditions, provide a great deal of heat to a room. Also, gas logs require virtually no effort to light. Natural logs, on the other hand, must be properly cured before burning. Even then, kindling is usually needed. And once lit, it is difficult to control the rate of burning. Beyond convenience, gas logs are also aesthetically pleasing. However, the standard gas logs burner only creates flames around the artificial logs. Natural logs, when burned will break apart to produce beautiful burning embers in front of the main log stack. A need exists to produce a more realistic aesthetic burn with gas logs.

Due to the popularity of gas logs, a number of advances have been patented. For example, U.S. Pat. No. 5,000,162 to Shimck et al. discloses a "Clean Burning Glowing Ember and Gas Log Burner System." This unit is marketed under the trademark Heat-N-Glow as the Model 5000GDVMH as a self-contained fireplace and wall heater for mobile homes. The system is a low-BTU system whose main objective is to minimize carbon monoxide creation and soot deposit on the logs. A burner system is provided with a first branch and a second branch. The first branch is supported on a prefabricated grate between a first and second decorative log. The second branch is forward of the logs and is protected under a metal mesh. A very light layer of special ember material is spread on top of the mesh. Shimck et al. '162 is only sold as a complete system of logs, burner and special ember material. It cannot be fitted to existing pan burners which are by far the most common burner in use, the combination resulting in the assembly of the invention. Thus, the Shimck burner system is an expensive option.

The Shimck burner system provides a metal trim piece or refractory material in front of the second burner pipe branch so that it is not easily viewed by a person standing in front of the fireplace. The second branch only illuminates a thin line of ember material. Neither the first or second branch can be covered by sand as is common in other units. The gas apertures in the branches are located on the upper surface of both branches. Thus, sand could easily clog the apertures. Moreover, the flow of gas into the second branch cannot be regulated.

U.S. Pat. No. 5,052,370 to Karabin discloses a "Gas Burner Assembly Including Emberizing Material." The gas burner comprises a first and second gas-burner assembly. The first gas-burner assembly is formed by a pair of parallel burner tubes connected by a third burner tube. The second gas-burner assembly is located forward of the first assembly and is generally T-shaped. The second burner only illuminates a thin line of ember material. A single gas source supplies both burner assemblies. An igniter is provided to ignite the gas from the main burner assembly. The flame from that burning gas ignites the gas from the second burner assembly. As with the Shimck et al. burner assembly, the flow of gas to the second burner assembly cannot be controlled.

Finally, U.S. Pat. No. 5,081,981 to Beal discloses yet another burner and is entitled "Yellow Flame Gas Fireplace Burner Assembly." The Beal reference is primarily concerned with producing a clean yellow flame. The burner assembly includes a U-shaped burner tube. The front portion

of the burner tube is forward of the artificial logs and provides flame for ember material. However, as with the Shimck reference above, the forward portion of the burner tube is hidden from view by a portion of the grate. The Beal system does not contemplate the present assembly. Furthermore, as with both the Shimck and Karabin references, there is no means provided to control separately the flow of gas into the front burner tube.

A need exists for an inexpensive assembly for improving the performance and aesthetic appeal of pan-type gas burners. The assembly should distribute gas under artificial coals or embers in front of the gas-fired logs. The assembly should also provide a method of controlling the flow of gas to a secondary burner, thus controlling the height of the coals and embers bed flames and the amount of heat radiated into a room. A need further exists for an assembly which can safely operate even if completely covered by sand and enhances gas burn of both primary log burner and secondary coals and embers burner by gas flow control and burn direction.

These present and long-felt needs for gas logs and glowing coals- and embers-burner systems will burn clean and closely simulate the natural flames produced by burning wood logs have not yet been met by the art. Therefore, it is desirable to produce a reliable and efficient gas logs and glowing coals- and embers-burner assembly which produces the desired efficiency of burn while providing decorative flames that closely simulate burning wood logs while at the same time providing useable heat and still meet EPA regulations and the ANSI emissions and safety standards.

#### SUMMARY OF THE INVENTION

It is a primary object of the present invention to provide a highly efficient gas-burner assembly for use with artificial, decorative logs and glowing coals and embers wherein the assembly provides control for the glowing coals and embers independently of the gas logs burn.

It is another primary object of the present invention to provide a novel burner assembly which closely simulates the flames, embers and coals of natural wood logs burn.

It is another principle object of the present invention to provide a novel burner assembly which has low carbon monoxide emission characteristics.

It is yet another object of the present invention to provide an efficient low carbon monoxide emission burner assembly that combines long decorative gas flames with short or low smoldering glowing embers and coals in the same assembly.

It is another object of the present invention to provide a gas flow communicating primary and secondary burner tubes with the gas distribution ports of the secondary burner tube directed away from the opening of the fireplace and utilizing the natural draft of the fireplace to enhance the overall efficiency of the burn of the two burners.

The present burner assembly is the combination of an inexpensive primary gas logs burner assembly in gas flow communication with a secondary coals- and embers-burner tube positioned forward and below the primary burner which operates to enhance the natural draft of the fireplace to improve efficiency of burn and aesthetic appeal of the gas-fired artificial logs, coals- and embers-burner assembly. The secondary burner can distribute gas under artificial coals and embers in front of the gas logs with control of the gas flow to the secondary burner being readily adjustable by a valve in the connection means between the primary and secondary burners. The secondary burner receives gas through the primary burner, the connection means, and the gas flow is regulated selectively by the valve which is

interposed between the primary and secondary burners in the connection means. The control of gas flow thus controls the height of the coals and embers bed flames and the amount of radiant heat which is produced in the front of the fireplace and is distributed into the room. The amount of radiant heat can be enhanced by utilizing the control valve for increasing the amount of gas being burned in the secondary burner or the utilization of even a tertiary burner along with the secondary burner which are provided forward of the gas logs arrangement in the fireplace. The secondary burner can operate efficiently when completely covered with sand and artificial coals and embers materials, there being no need for a new grate to hide the secondary burner.

The ability to regulate the flow of gas to the secondary burner is an especially important feature. In addition, the gas flow from the secondary burner away from the opening of the fireplace and, in effect, toward the primary burner is also of special importance because of the utilization of the fireplace natural draft and direction of flames to more completely burn the gas, avoid any pockets of gas in front of the gas logs. The direction of the gas dispersion from the secondary burner ensures that through the action of the natural draft of the fireplace and the burning logs from the primary burner that complete and total combustion in an efficient manner will be achieved of the gas flowing from the secondary burner which is positioned somewhat forward of the primary burner.

People buy gas logs primarily for convenience, but this does not mean that they want to give up on the beauty of burning real logs. Standard pan burners only provide part of that beauty. Having roaring flames throughout the logs is greatly complemented by lower flames in front of the gas logs throughout a coals and embers bed. None of the prior art references above feature or even suggest a variable control means for accomplishing lower flames in the coals and embers bed. Moreover, every fireplace drafts differently. Such differences in fireplace construction and drafting, i.e., fireplace draft, as well as sizing and manufacture of present artificial fireplace burner apparatus dictates that variable control of the secondary burner, the coals and embers burner which operates independently of the primary logs burner is necessary. Volume and velocity of air entering the firebox varies according to the size of the room, height of the ceilings, and size of the firebox. None of the prior art references compensate for the varying drafts of fireplaces and therefore fail to accommodate all fireplaces while attempting to provide the maximum aesthetic beauty desired and efficiency of burn.

Most importantly, the gas-fired artificial logs, coals- and embers-burner assembly through the secondary burner control afforded by the valve, allows the user to selectively increase the amount of gas being burned forward of the artificial logs. This control also affords a greater introduction of radiant heat to the room as desired on colder days. As previously discussed, artificial gas logs can act as a heat sink and absorb heat produced by the flames. The heat generated by the secondary burner is largely radiant and is projected into the room, which affords quick heating of the room while also providing the aesthetic beauties of a gas-fired artificial logs, coals- and embers-burner assembly operation.

#### BRIEF DESCRIPTION OF THE DRAWINGS

For a more complete understanding of the present invention, and for further details and advantages thereof, reference is now made to the following Detailed Description taken in conjunction with the accompanying drawings, in which:

FIG. 1 provides a perspective view of a prior art pan burner used with artificial gas logs;

FIG. 2 provides a gas-fired artificial logs primary pan tube burner and secondary coals and embers tube burner;

FIG. 3 illustrates the effect of the present assembly in providing logs, coals and embers flames; and

FIG. 4 is a front view of the assembly illuminating the coals and embers bed and gas logs flames.

#### DETAILED DESCRIPTION OF THE DRAWINGS

The present assembly provides a number of advantages over the burner assemblies disclosed in the prior art. FIG. 1 illustrates a standard pan burner 10 which is used in the vast majority of artificial log sets. The pan burner 10 has an open frame 12 which supports a burner tube 14. An inlet 16 is connected to a gas source (not shown). A plurality of apertures, as evidenced by gas plumes 18, are spaced along the length of the burner tube 14. Gas escapes through the apertures and filters through sand (not shown). Gas which escapes from the sand is initially ignited to create flames. These flames are continually fed by the escaping gas. The burner tube 14 is supported by the side walls 12a, 12b of the frame 12. The burner tube 14 extends beyond the side wall 12a and is capped.

FIG. 2 illustrates a secondary burner apparatus 100 which embodies the present invention in combination with primary burner tube 14. The secondary burner apparatus 100 can be retrofitted to the terminal end 14a of the burner tube 14 in the pan burner 10. The cap must be removed from the terminal end 14a. A connector 102 is then attached to the uncapped end of burner tube 14. The connector 102 is fitted to the secondary burner tube 104 creating an enclosed fluid path for the gas. The connections between the connector 102 and the terminal end 14a should be adequately sealed to prevent leakage. Likewise, the connection between the connector 102 and the secondary burner tube 104 should also be properly sealed. A valve 106 is interposed in this fluid path. The valve 106 can be variably positioned to give the user the ability select the amount of gas entering the secondary burner. The secondary burner tube 104 is generally parallel to the primary burner tube 14. The terminal portion of the secondary burner tube 104a is closed. The primary and secondary burner tubes are typically made of steel.

A plurality of apertures 108 are along the length of the secondary burner tube 104. The apertures 108 can be evenly spaced or clustered. The apertures 108 are typically between  $\frac{1}{8}$  and  $\frac{1}{4}$  inch in diameter, but are preferably  $\frac{1}{16}$  of an inch in diameter. More importantly, the apertures are located along the radial edge of the secondary burner tube 104, below the upper ridge of the tube. By avoiding the upper ridge, the apertures are less likely to be clogged by sand. Gas passing through the valve 106 enters the secondary burner tube 104 and escapes through the spaced apertures. The apertures can be evenly spaced or clustered.

These various spaced apertures or gas discharge ports are most important in their position in regard to both the primary and secondary tube burners. In the secondary burner tube 104, the gas is discharged in a direction away from the opening of the fireplace or in another aspect is directed somewhat toward or directly toward the primary burner tube 14. The effects of such gas burn direction enhances the aesthetic beauty of the overall logs, coals, and embers burn, but, more importantly, provide several safety features of the gas-fired artificial logs, coals- and embers-burner assembly. First, the natural draft of the fireplace provides a more efficient burn of the gas and avoids high or intolerable levels

of carbon monoxide. Even more importantly is that the backward direction of gas flow direction toward the primary burner from the secondary burner avoids creation of pockets of gas in the sand and other coverage material of these burners which could possibly create a flash explosion due to accumulated gas. For example, if the gas is directed from the secondary burner 104 toward the opening of the fireplace, then two independent sources of gas pocketing occurs—one on the gas logs primary burner which may or may not be covered by granular materials as well as that generated by the secondary burner which is removed from about four to eight or ten inches in front of the primary burner. Lighting of such gas distribution pockets would be hazardous and uniformity of coordinated burn utilizing natural draft of the fireplace would be lost. If the secondary burner 104 discharges gas in a vertical direction, apertures in the sand or coverage granular material will occur and one would lose the aesthetic beauty of the applications of distribution of gas for burning and creating flame coals' and embers' appearance.

In the gas-fired artificial logs, coals- and embers-burner assembly of the invention, the primary elongated burner tube can be comprised of a one-half inch pipe while the secondary coals- and embers-burner elongated tube can be of a one-quarter inch pipe. These dimensional relationships can be varied depending on the needs for gas volume and the size of the fireplace. The spacing between the primary and secondary burner tubes can also be varied within reasonable lengths of from about four to eight or ten inches depending on the size and depth of the coals and embers bed one requires. The secondary elongated burner tube can also have adjustments for height, meaning distance elevated from the floor of the fireplace, again depending on the depth and size of the coals and embers fire bed. In all of these dimensional relationships, the present invention provides an adjustable burn facility for the secondary elongated burner tube which controls the amount of coals and embers flame and glow, again depending on the individual's desires, size of the room, size of the fireplace and the amount of natural draft through the fireplace.

FIGS. 3 and 4 illustrate the effect of the secondary burner apparatus 100 once connected to the pan burner 10. As discussed, a grate 20 is located above the pan burner which is covered with sand 22. The grate 20 can hold at least one artificial log 24. Artificial ember material 26 which glows when heated can be strewn under and around the artificial logs and on top of the sand. Flames 30 fed by gas from the primary burner tube 14 rise through the artificial logs 24. Flames 40 fed by gas from the secondary burner tube 104 can rise through the artificial ember bed 28. As illustrated, the flames 40 can be lower than the flames 30, thus providing an aesthetically pleasing sight.

Although preferred embodiments of the invention have been described in the foregoing Detailed Description and illustrated in the accompanying drawings, it will be understood that the invention is not limited to the embodiments disclosed, but is capable of numerous rearrangements, modifications, and substitutions of parts and elements without departing from the spirit of the invention. Accordingly, the present invention is intended to encompass such rearrangements, modifications, and substitutions of parts and elements as fall within the scope of the invention.

What is claimed is:

1. A gas-fired artificial logs and coals-burner assembly for fireplace comprising:
  - an elongated primary burner tube including a plurality of gas discharge ports;

a secondary coals burner elongated tube positioned forwardly of the primary burner tube;

a support means for holding the elongated primary burner tube in a raised level relative to the forwardly positioned secondary coals burner elongated tube;

the secondary coals burner elongated tube including a plurality of gas discharge ports;

the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means;

a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and

the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.

2. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the support means for the primary burner tube is comprised of an open frame pan for supporting the primary burner tube in an elevated position relative to the fireplace floor.

3. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube discharge ports are directed toward the primary burner elongated tube at an angle of from about 5 to about 75 degrees based on the plane of the fireplace floor.

4. The gas-fired artificial logs and coals-burner assembly according to claim 3 wherein the secondary coals burner elongated tube discharge ports directed toward the primary burner tube utilizes the fireplace natural draft in achieving combustion of both gas sources in sufficient air to maintain satisfactory levels of CO.

5. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is substantially parallel to the primary burner tube and has a smaller inside diameter than the primary burner tube with the valve adjusting gas flow for coals burn and forwarding heat radiation from the fireplace.

6. The gas-fired artificial logs and coals-burner assembly according to claim 4 wherein the primary burner tube is comprised of a standard half-inch pipe and the secondary burner tube is comprised of a standard quarter-inch pipe.

7. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the elongated primary burner tube and the secondary coals burner elongated tube are spaced apart on different planes at from about four to about eight inches.

8. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is of a smaller diameter than the primary burner tube which allows for a lower profile of coals and sand coverage.

9. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube.

10. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein at least two secondary coal burner elongated tubes are utilized for artificial coal burn and radiant heat generation.

11. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary and secondary burner tubes have apertures of from about  $\frac{1}{32}$  inch to about  $\frac{1}{4}$  inch.

12. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the gas flow adjustment valve has a removable handle, the gas flow adjustment allowing a variety of settings from full closed to full open.

13. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the connection means is comprised of a connector attached to the terminal end of the primary burner tube at a first end of a connector and attached to the secondary coals burner elongated tube to a connector second end with the valve interposed between the primary burner tube and the secondary burner tube.

14. The gas-fired artificial logs and coals-burner assembly according to claim 13 wherein the connector generally is shaped outward from the first end connected to the primary burner tube, directed generally perpendicular to the burner tubes alignment and inward to the second end connected to the secondary burner tube, the valve and connector being positioned generally exterior of the primary and secondary burner tube fire zones.

15. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open frame pan and primary elongated burner tube is positioned under an artificial logs and grate support means.

16. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary elongated burner tube is covered with sand and the secondary elongated burner tube is covered with sand, mica, and fibrous materials which simulate coals and ember burn.

17. A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:

a secondary coals burning elongated tube;

a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube being in gas flow communication with the primary burner tube being the connection means, a gas distribution ports of the secondary burner tube directed away from the fireplace opening.

18. The gas-fired artificial coals- and embers-burner apparatus according to claim 1, wherein the gas distribution ports of the secondary burner tube are directed toward the primary burner tube at from about 5 degrees to about 75 degrees elevation from the fireplace floor.

19. A gas burner assembly for use in a fireplace comprising:

a primary burner tube having a first end and a second end, said first end adapted to be connected to a gas source with a gas flow control means for controlling the amount of gas flowing into said primary burner tube;

a second burner tube;

a connector tube attached to said second end of said primary burner tube and to said second burner tube to provide fluid communication between said primary burner tube and said second burner tube; and

a valve disposed in said connector tube for selectively controlling the flow of gas from said primary burner tube into said second burner tube.



B

JT-APP 0122

### Glowing Embers Burner (G4 and GX4 Series)

The Peterson Real-Fyre Glowing Embers Burner remains the most popular of our burner systems. This system creates dancing, wood-fire-like flames and a remarkably authentic glowing ember bed beneath the logs.

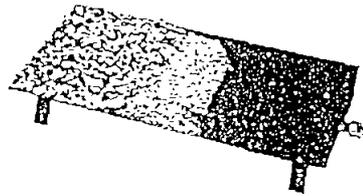
The G4-Series burner system is available in sizes 12" to 60". It is compatible with most Real-Fyre Gas Log styles. The burner system includes a wood-fire style grate, Glowing Embers Burner Pan, connector kit, Glowing Embers, granules (select sand or vermiculite), grate clips and damper clamp. The G4 Series will accommodate all Peterson controls, including the remote control systems, and the Warm Air Circulator.

The Real-Fyre G4 burner pan is engineered to provide the maximum in performance, safety and durability. The burner portholes are precisely sized and spaced to ensure a natural, balanced flame presentation. It also provides quick ignition and quiet operation. The fuel injector/air mixer allows only the required amount of fuel, ensuring the ultimate in performance while conserving gas. The pan is constructed of high quality steel covered with a heat-resistant paint. It is securely welded to prevent gas from escaping.

The G4 Series is available to burn Natural or Propane Gas (a safety pilot system is required for burners using Propane Gas). Radco listed on units up to 96,000 BTU's. Also available for See-Thru and Peninsula fireplaces.

### The Front Flame Burner System\* (F Series)

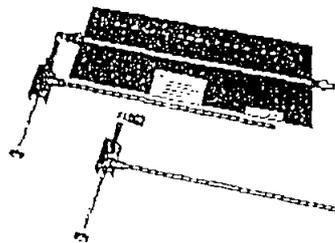
features a patented burner design that provides dramatic flames to the front of the logs, as well as flickering fire through the log stack. Speciall designed flame baffles bring prominent flames around the bottom front log for a dramatic presentation. This burner system is RADCO approved and compatible with most Real-Fyre Gas Log styles. Available for natural and propa gas in sizes 12" to 60". Burner system includes Front Flame burner, custom grate and connecto kit. The Front Flame Burner System is availabl in see-through and circular formats.



### Flame Pan Burner (P Series)

The Flame Pan Burner System is designed to provide a unique setting for your fireplace. The Pan includes special baffles that allows the flames to erupt over the entire pan surface, surrounding your Real-Fyre Logs. This makes the Flame Pan Burner System ideal for see-through, peninsular or island fireplaces. The le of the pan burner are removable, which allows you to set the pan low on the hearth, bury it wit embers and create a campfire effect

The Flame Pan Burner System is available for natural or propane gas in sizes 16" to 42". It is compatible with most Real-Fyre Gas Log style and Peterson control systems.



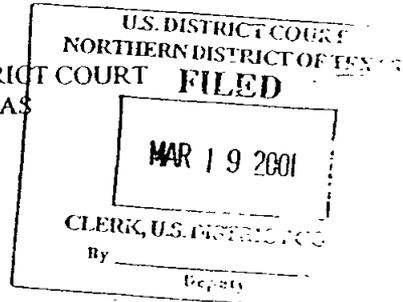
### Ember Flame Booster (see example)

As an accessory for you G4 Series Burner System. Model # EMB-18, EMB-24, EMB-30 or Order pre-assembled on your G-5 Series (AGA Design Certified) Log Set.

The Realism and excitement of your Real-Fyre Gas Log set is amplified by the Ember Flame Booster (EMB Series). This easy-to-install accessory adds dramatic front flames to your gas log set

JT-APP 0123

IN THE UNITED STATES PATENT DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.

Plaintiff,

v.

ROBERT H. PETERSON CO.

Defendant.

§  
§  
§  
§  
§  
§  
§  
§

Civil Action No. 3-01CV0127-R

ANSWER AND COUNTERCLAIM

Defendant, Robert H. Peterson Co. ("Peterson"), by its attorneys answers Plaintiff's, Golden Blount, Inc. ("Golden Blount"), complaint as follows:

1. Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations of Paragraph 1, and therefore deny the same.
2. The allegations of Paragraph 2 are admitted.
3. In response to the allegations of Paragraph 3, Defendant denies that venue is proper pursuant to Title 28 United States Code, Section 1400(b), and denies that it has done anything improper. The remaining allegations are admitted.
4. In response to the allegations of Paragraph 4, Defendant admits that U. S. Patent No. 5,988,159 was issued by the U. S. Patent and Trademark Office and that a copy of the '159 patent was attached to the Complaint as Exhibit "A". Defendants deny that the '159 patent was duly and legally issued. Defendants are without knowledge or information

sufficient to form a belief as to the truth of the remaining allegations of Paragraph 4 and therefore deny the same.

5. The allegations of Paragraph 5 are denied.
6. The allegations of Paragraph 6 are denied.
7. The allegations of Paragraph 7 are denied.

AFFIRMATIVE DEFENSE

8. The '159 patent, and each of the claims allegedly infringed by Defendant, are invalid for failure to comply with one or more of the requirements of Title 35, United States Code.

COUNTERCLAIM

9. The allegations of Paragraph 8 of Defendant's affirmative defense are repeated and realleged herein.

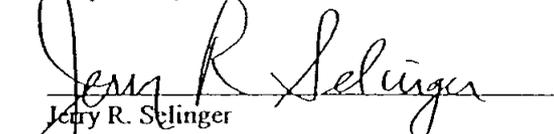
10. This counterclaim seeks a declaratory judgment of invalidity of United States Patent No. 5,988,159. The Court has subject matter jurisdiction in accordance with 28 U.S.C. Sections 2201, 2202 and 1338(a).

11. The '159 patent is invalid for failure to comply with one or more of the requirements of Title 35, United States Code.

WHEREFORE, Defendant Robert H. Peterson Co. prays for judgment against Golden Blount, Inc., as follows:

- A. A judgment in favor of Defendant and against Plaintiff with no award to Plaintiff of any damages, costs, or fees;
- B. A declaratory judgment that U. S. Patent No. 5,988,159 is invalid;
- C. An order awarding Defendant its costs in addition to its attorneys' fees in accordance with 35 U.S.C. Section 285; and
- D. Such other and further relief as the Court may deem just and equitable.

Respectfully submitted,

  
Jerry R. Selinger  
State Bar No. 18008250  
JENKENS & GILCHRIST, A P.C.  
1445 Ross Avenue, Suite 3200  
Dallas, Texas 75202  
214/855-4776 (Telephone)  
214/855-4300 (Facsimile)

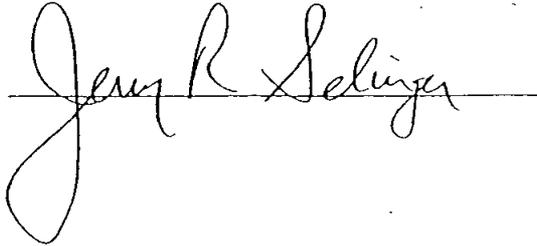
ATTORNEYS FOR  
ROBERT H. PETERSON CO.

OF COUNSEL:

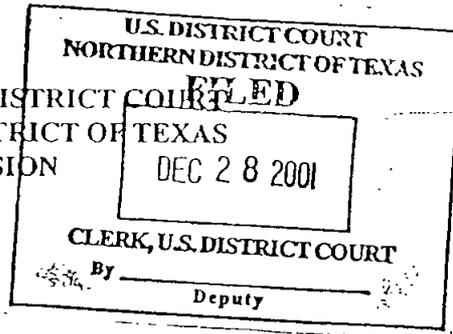
Dean A. Monco  
F. William McLaughlin  
WOOD, PHILLIPS, VANSANTEN,  
CLARK & MORTIMER  
500 West Madison Street, Suite 3800  
Chicago, Illinois 60661-2511  
Telephone: 312.876-1800  
Facsimile: 312.876-2020

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing Answer and Counterclaim has been served on all counsel of record by first-class mail, postage prepaid, on this 19<sup>th</sup> day of March, 2001.

A handwritten signature in cursive script, reading "Jerry R. Selinger", is written over a horizontal line.

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC., §  
Plaintiff, §  
v. §  
ROBERT H. PETERSON CO., §  
Defendant. §

Civil Action No.  
3-01CV0127-R

PLAINTIFF'S REPLY TO DEFENDANT'S COUNTERCLAIM

Plaintiff, Golden Blount, Inc. ("Golden Blount"), by its attorneys replies to Defendant's, Robert H. Peterson Co. ("Peterson"), counterclaim as follows:

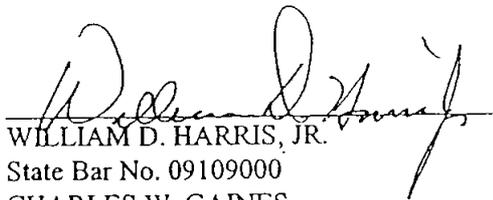
1. Paragraph 9 fails to contain factual allegations, however, in any event the allegations of Paragraph 9 are denied.
2. In response to the allegations of Paragraph 10, Plaintiff admits that the counterclaim seeks a declaratory judgment of invalidity of the patent in suit, as well as Plaintiff admits that the subject matter jurisdiction is mandated by 28 U.S.C. Sections 2201, 2202 and 1338(a).
3. Plaintiff denies the allegations of Paragraph 11

PRAYER AND RELIEF

WHEREFORE, Golden Blount petitions this court for a judgment against Peterson on this declaratory judgment count and that the relief set forth in the complaint be extended to Plaintiff.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



WILLIAM D. HARRIS, JR.

State Bar No. 09109000

CHARLES W. GAINES

State Bar No. 07570580

Hitt Gaines & Boisbrun, P.C.

225 University Plaza

275 West Campbell Road

Richardson, Texas 75080

972/480-8800 (Telephone)

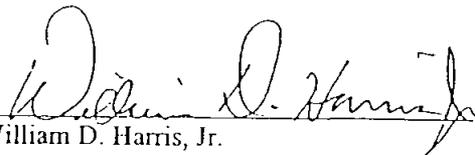
972/480-8865 (Facsimile)

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Plaintiff's Reply to Defendant's Counterclaim was served on the following counsel of record on December 28, 2001, by first class mail and facsimile:

Jerry R. Selinger  
Jenkins & Gilchrist  
1445 Ross Avenue, Suite 3200  
Dallas, Texas 75202  
214/855-4500 (Telephone)  
214/855-4300 (Facsimile)

F. William McLaughlin  
Dean A. Monco  
Wood, Phillips, VanSanten,  
Clark & Mortimer  
500 W. Madison Street, Suite 3800  
Chicago, IL 60611-2511  
312/876-1800 (Telephone)  
312/876-2020 (Facsimile)

  
William D. Harris, Jr.

JF-APP 0130

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
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§  
§

Civil Action No.

3-01CV0127-R

PLAINTIFF'S PRETRIAL DISCLOSURE  
PURSUANT TO F.R.C.P. 26(a)(3)

This Pretrial Disclosure is submitted in accordance with, and pursuant to, F.R.C.P. 26(a)(3).

A. WITNESSES

1. Expected Witnesses

Golden Blount  
4301 Westgrove  
Addison, Texas 75001  
(972) 250-3113

Charlie Hanft  
2316 Main Street  
Tucker, Georgia 30084  
(770) 934-8646

Greg H. Parker  
275 West Campbell Rd., Suite 225  
Richardson, Texas 75080  
(972) 480-8800  
(used to provide formal identification of demonstrative materials referred to below)

2. **Possible Witnesses**

Leslie Bortz  
President Robert H. Peterson Co.  
(address and telephone number well known by Defendant)

F. William McLaughlin  
500 W. Madison Street, Suite 3800  
Chicago, Illinois 60611  
(312) 876-1800

Steve Blount  
4301 Westgrove  
Addison, Texas 75001  
(972) 250-3113

Daryl Webster  
Webco Distributing  
12012 N. Lamar Blvd.  
Austin, Texas 78753  
512-836-8476

B. **DEPOSITION WITNESSES**

Leslie Bortz  
President Robert H. Peterson Co.  
(address and phone number well known by Defendant)

F. William McLaughlin  
500 W. Madison Street, Suite 3800  
Chicago, Illinois 60611  
(312) 876-1800

C. **EXHIBITS**

1. **Expected Exhibits**

- Document Bates Number B1213
- Document Bates Number B1554
- Document Bates Numbers B1555-B1559
- Document Bates Number 000015
- Document Bates Number 000016
- Document Bates Number 000050

- Document Bates Numbers 000051-000053
- Various Boards, Charts or Computer Animation Illustrating:
  - An illustration of elements (and structures) of Defendant's device versus the claim language of the '159 Patent, and also including an illustration and comparison of the elements (and structures) of the Plaintiff's device. Annotated drawings may be used to illustrate aspects of the foregoing.
  - Total sales (number and dollar amount) of Plaintiff's log sets/assembly burner sets/secondary coals (ember) burner sets.
  - Total sales (number and dollar amount) of Defendant's log sets/assembly burner sets/secondary coals (ember) burner sets.
  - An illustration representing the actual damages (number of devices sold by Defendant multiplied by Plaintiff's profit per device).
  - Video demonstration of Defendant's working log and assembly burner set with and without secondary coals (ember) burner set, as well as Plaintiff's working log and assembly burner set with and without secondary coals (ember) burner set.
  - A comparison of Defendant's log and assembly burner set with the secondary coals (ember) burner set to Defendant's log and assembly burner set without the secondary coals (ember) burner set (illustrations taken directly from Defendant's website).
- Plaintiff's Commercial Device Covered by the Claims of the '159 Patent
- Defendant's Commercial Device that Allegedly Infringes the '159 Patent

2. **Possible Exhibits**

- Document Bates Numbers B0001-B0726
- Document Bates Number 000017
- Document Bates Numbers 000018-000019
- Document Bates Numbers 000033-000034
- Certified File Wrapper of the '159 Patent
- Current Sales Brochure Illustrating Defendant's Marketed Device

- Claim Chart Showing Claim Interpretation (As Decided by the Court)

This Pretrial Disclosure has been drafted and formulated in accordance with F.R.C.P.  
26(a)(3).

Respectfully submitted,  
For Plaintiff Golden Blount, Inc.



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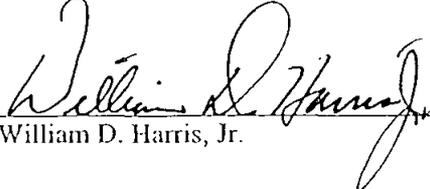
WILLIAM D. HARRIS, JR.  
State Bar No. 09109000  
CHARLES W. GAINES  
State Bar No. 07570580  
Hitt Gaines & Boisbrun, P.C.  
225 University Plaza  
275 West Campbell Road  
Richardson, Texas 75080  
972/480-8800 (Telephone)  
972/480-8865 (Facsimile)

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Plaintiff's Pretrial Disclosure Pursuant To F.R.C.P. 26(a)(3) was served on the following counsel of record on January 22, 2002, by first class mail and facsimile:

Jerry R. Selinger  
Jenkins & Gilchrist  
1445 Ross Avenue, Suite 3200  
Dallas, Texas 75202  
214/855-4500 (Telephone)  
214/855-4300 (Facsimile)

F. William McLaughlin  
Dean A. Monco  
Wood, Phillips, VanSanten,  
Clark & Mortimer  
500 W. Madison Street, Suite 3800  
Chicago, IL 60611-2511  
312/876-1800 (Telephone)  
312/876-2020 (Facsimile)

  
William D. Harris, Jr.

U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF TEXAS  
**FILED**  
 JAN 22 2002  
 CLERK, U.S. DISTRICT COURT  
 By \_\_\_\_\_  
 Deputy

IN THE UNITED STATES DISTRICT COURT  
 FOR THE NORTHERN DISTRICT OF TEXAS  
 DALLAS DIVISION

GOLDEN BLOUNT, INC., )  
 )  
 Plaintiff, )  
 )  
 v. )  
 )  
 ROBERT H. PETERSON CO., )  
 )  
 Defendant. )

Civil Action No.: 3:01-CV-0127-R

**ROBERT H. PETERSON CO.'S  
PRETRIAL DISCLOSURE LIST OF EXHIBITS**

The following exhibits are likely to be used at trial:

<u>Exhibit No.</u>	<u>Description (Production Nos.)</u>
1	Blount U.S. Patent No. 5,988,159
2	File history for Application No. 08/061,727 (000122-000157)
3	File history for U.S. Application No. 08/276,894 (00158-00257)
4	File history for Application No. 08/626,498, now Patent No. 5,988,159, (000258-00333)
5	Peterson, U.S. Patent No. 3,042,109 (000114)
6	Henry, U.S. Patent No. 3871,355 (000115)
7	Shimek, et al., U.S. Patent No. 5,000,162 (000116)

8 Eiklor, et al., U.S. Patent No. 5,033,455 (000113)  
9 Karabin, U.S. Patent No. 5,052,370 (000117)  
10 Beal, U.S. Patent No. 5,081,981 (000118)  
11 Beck, U.S. Patent No. 5,263,852 (000119)  
12 Reserved  
13 Reserved  
14 Reserved  
15 Reserved  
16 Tucker letter to Robert H. Peterson Co. dated  
December 10, 1999 (00121)  
17 Corrin letter to McLaughlin dated December 17,  
1999 (000120)  
18 Corrin letter to Tucker dated December 30, 1999  
(B1469)  
19 Tucker letter to Corrin dated May 3, 2000  
20 Stone letter to Tucker dated May 16, 2000 (B1467)  
21 Hardin letter to Corrin dated January 19, 2001  
(B1462-3)  
22 Bortz letter to McLaughlin dated February 9, 2001,  
with attachments (000089-000096)  
23 Bortz fax to McLaughlin dated March 16, 2001,  
with attachments (000097-000112)  
24 Reserved  
25 Reserved  
26 Reserved

- 27 Reserved
- 28 Reserved
- 29 Reserved
- 30 Reserved
- 31 Robert H. Peterson Co. sample G4 burner, model GG-24
- 32 Robert H. Peterson Co. sample Ember Flame Booster, model AMB-24
- 33 Peterson Real-Fyre® Ember Flame Booster advertisement (00015)
- 34 Ember Flame Booster installation and operating instructions (00016)
- 35 Photograph of G4 burner and Ember Flame Booster (000017)
- 36 Ember booster assembly drawing (000018)
- 37 Flame tube drawing 18"(000019)
- 38 Flame tube drawing 24" (000020)
- 39 Flame tube drawing 30" (000021)
- 40 Valve shield drawing (000022)
- 41 V-17 valve drawing (000023)
- 42 Burner Systems International letter to Boekeloo with attachments (000024-000028)
- 43 Drawing of Hook up for Circular G4 burners (000029)
- 44 Operation instructions for hearth elbow (000030)

- 45 Installation instructions for Real-Fyre Hearth Logs  
with front flame burner (000031)
- 46 Installation instructions (000032)
- 47 Burner assembly drawing dated July 1, 1983  
(000033)
- 48 Burner assembly drawing dated July 1, 1983  
(000034)
- 49 Peterson list price sheet effective March 1, 1977  
(000035)
- 50 Real-Fyre auxiliary valves and burner parts  
advertisement (000036)
- 51 Real-Fyre F3 series circular burner advertisement  
(000037)
- 52 Gas log warmth from Peterson Real-Fyre  
advertisement (000038-000049)
- 53 Summary of ember booster sales (000051-000053)
- 54 Engineering bill of materials dated October 4, 2001  
(000087)
- 55 Robert H. Peterson Co. Fireplace Decor Accessories  
ad (000088)
- 56 Declaration of John Palaski
- 57 Declaration of Darryl R. Dworkin
- 58 Complaint for Patent Infringement and Jury Demand
- 59 Answer and Counterclaim
- 60 Plaintiff's Reply to Defendant's Counterclaim
- 61 Defendant's Answers to Plaintiff Golden Blount,  
Inc.'s First Set of Interrogatories

- 62 Defendant's Responses to Plaintiff Golden Blount,  
Inc.'s First Set of Document Requests
- 63 Plaintiff Golden Blount, Inc.'s Response to  
Defendant's First Set of Document Requests
- 64 Plaintiff Golden Blount, Inc.'s Answers and  
Objections to Defendant's First Set of  
Interrogatories
- 65 Original executed page for Interrogatories (B1441)

Defendant also reserves the right to use demonstrative exhibits corresponding to  
the above Exhibits.

Respectfully submitted,

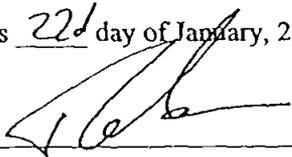
Jerry R. Selinger / by permission   
Jerry R. Selinger  
Texas Bar No. 18008250  
JENKENS & GILCHRIST, A Professional Corporation  
1445 Ross Avenue  
Suite 3200  
Dallas, Texas 75202  
Telephone: (214) 855-4500  
Facsimile: (214) 855-4300

OF COUNSEL:

F. William McLaughlin  
WOOD, PHILLIPS, VANSANTEN,  
CLARK & MORTIMER  
500 West Madison Street  
Suite 3800  
Chicago, Illinois 60661  
Telephone: (312) 876-1800  
Facsimile: (312) 876-2020

**CERTIFICATE OF SERVICE**

This certifies that a copy of the foregoing ROBERT H. PETERSON CO.'S PRETRIAL DISCLOSURE LIST OF EXHIBITS was served by first class mail, postage prepaid, to counsel for Plaintiff, William D. Harris, Jr., Esq., Hitt Gaines & Boisbrun, P.C., P.O. Box 832570, Richardson, Texas 75083, this 22<sup>d</sup> day of January, 2002.

  
\_\_\_\_\_

U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF TEXAS  
**FILED**  
 JAN 22 2002  
 CLERK, U.S. DISTRICT COURT  
 By \_\_\_\_\_  
 Deputy

IN THE UNITED STATES DISTRICT COURT  
 FOR THE NORTHERN DISTRICT OF TEXAS  
 DALLAS DIVISION

GOLDEN BLOUNT, INC., )  
 )  
 Plaintiff, )  
 )  
 v. )  
 )  
 ROBERT H. PETERSON CO., )  
 )  
 Defendant. )

Civil Action No. 3:01-CV-0127-R

**ROBERT H. PETERSON CO.'S  
PRETRIAL DISCLOSURE LIST OF WITNESSES**

The following persons are likely to be witnesses at trial:

<u>Name</u>	<u>Address</u>
Leslie Bortz	Robert H. Peterson Co 2500 West Arthington Street Chicago, Illinois 60612
Todd Corrin	Robert H. Peterson Co 14724 East Proctor Avenue City of Industry, California 91746
Vince Jankowski	Robert H. Peterson Co. 14724 East Proctor Avenue City of Industry, California 91746
F. William McLaughlin	Wood, Phillips, VanSanten, Clark & Mortimer 500 West Madison Street Suite 3800 Chicago, Illinois 60661

Darryl Dworkin

D.N.V., Inc.  
Summit-Fyreside  
911 First Avenue  
Asbury Park, New Jersey 07712-7207

John Palaski

500 Oak Glen Road  
Howell, New Jersey 07731

The following persons may testify at trial:

Donald Waldman

RADCO  
3220 East 59th Street  
Long Beach, California 90805

Don Henry

To be supplied

Ted Rasmussen

Rasmussen Iron Works  
12028 East Philadelphia Street  
Whittier, California 90601

Fred Eiklor

Eiklor Flame  
282 E. Pivot Point  
Paoli, IN 47454

Scott Eiklor

Eiklor Flame  
282 E. Pivot Point  
Paoli, IN 47454

Respectfully submitted,

Jerry R. Selinger / by permission 

Jerry R. Selinger  
Texas Bar No. 18008250  
JENKENS & GILCHRIST, A Professional Corporation  
1445 Ross Avenue  
Suite 3200  
Dallas, Texas 75202  
Telephone: (214) 855-4500  
Facsimile: (214) 855-4300

OF COUNSEL:

F. William McLaughlin  
WOOD, PHILLIPS, VANSANTEN,  
CLARK & MORTIMER  
500 West Madison Street  
Suite 3800  
Chicago, Illinois 60661  
Telephone: (312) 876-1800  
Facsimile: (312) 876-2020

CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing ROBERT H. PETERSON CO.'S  
PRETRIAL DISCLOSURE LIST OF WITNESSES was served by first class mail,  
postage prepaid, to counsel for Plaintiff, William D. Harris, Jr., Esq., Hitt Gaines &  
Boisbrun, P.C., P.O. Box 832570, Richardson, Texas 75083, this 22 day of January,  
2002.

  
\_\_\_\_\_

IN THE UNITED STATES PATENT DISTRICT COURT  
 NORTHERN DISTRICT OF TEXAS  
 DALLAS DIVISION

U.S. DISTRICT COURT  
 DISTRICT OF TEXAS  
 FEB - 5 2002  
 U.S. DISTRICT COURT  
 By \_\_\_\_\_  
 Deputy

GOLDEN BLOUNT, INC., )  
 )  
 Plaintiff, )  
 )  
 v. )  
 )  
 ROBERT H. PETERSON CO., )  
 )  
 Defendant. )

Civil Action No.: 3.01-CV-0127-R

**ROBERT H. PETERSON CO.'S OBJECTIONS  
 TO PLAINTIFF'S PRE-TRIAL DISCLOSURE**

Defendant Robert H. Peterson Co. ("PETERSON CO.") respectfully submits its objections under Fed. R. Civ. P. 26(3) to the following designated plaintiff's exhibits.

**Peterson Co.'s List of Objection  
 Abbreviations for Blount's Trial Exhibits<sup>1</sup>**

- \_\_\_\_\_ No objection.
- "H" Hearsay, Rule 802, F.R. Evid.
- "NR" Not relevant, Rule 402, F.R. Evid.
- "I" Incomplete, Rule 106, F.R. Evid.
- "A" Lack of authenticity, Rule 901, F.R. Evid.
- "R" Peterson Co. reserve the right to object until a copy of the proposed exhibit has been provided and examined.

**RECEIVED**  
 FEB 11 2002  
 WOOD, PHILLIPS, ET AL

<sup>1</sup> Any objection stated against an exhibit applies to all duplicate copies, including enlargements, of that exhibit.

- “III” Illegible.
- “NP” Not produced and/or identified during the discovery period.
- “LF” Lack of foundation
- “PV” Probative value substantially outweighed by danger of unfair prejudice; confusion of issues; waste of time; considerations of undue delay; misleading nature of exhibit or testimony; needless presentation of cumulative evidence, Rule 403, F.R. Evid
- “AC” Attorney-client privilege and/or work product exclusion.
- “BE” Best evidence rule, Rule 1002-1004, F.R. Evid.
- “AH” Lack of authenticity as to handwritten portion, Rule 901, F.R. Evid.
- “NI” Not properly marked or properly identified on Blount’s Trial Exhibit List.
- “LS” Lack of specific identification of individual exhibit and/or production documents  
Peterson Co. reserves the right to object upon proper identification of exhibit

**I. Plaintiff’s Expected Exhibits**

<u>Plaintiff Exhibit #</u>	<u>Production #</u>	<u>Objection</u>
	B 1213	—
	B 1554	H, LF, AH
	B 1555 - 1559	H, LF, AH, NR
	B 000015	H, LF, NR, I
	B 000016	H, LF, NR, I
	B 000050	H, LF, NR, I
	B 000051 - 53	H, LF, NR, I

Physical Ex. - illustration of elements (and structures) of Defendant's devices versus claim language of '159 patent and comparison of elements (and structures of) of Plaintiff's device.

R, NR, PV, LF

Total sales (number and dollar amount) of Plaintiff's log sets/assembly burner sets/secondary coals (ember) burner sets.

R, NR, LF

Total sales (number and dollar amount) of Defendant's log sets/secondary coals (ember) burner sets.

R

An illustration representing the actual damages (number of devices sold by Defendant multiplied by Plaintiff's profit per device).

R, I, NR, NP, LF

Video demonstration of Defendant's working log and assembly burner set with and without secondary coals (ember) burner set, as well as Plaintiff's working log and assembly burner set with and without secondary coals (ember) burner set.

R, NR, NP, LF, PV

A comparison of Defendant's log and assembly burner set with the secondary coals (ember) burner set to Defendant's log and assembly burner set without the secondary coals (ember) burner set.

R, NR, NP, LF, PV

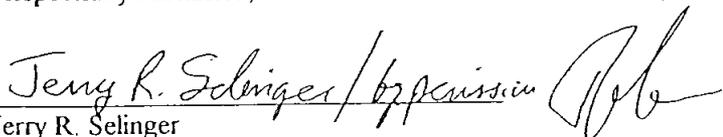
Plaintiff's commercial devices covered by the claims of the '159 patent.

R, NR, PV, LF

**II. Plaintiff's Possible Exhibits**

<u>Plaintiff Exhibit #</u>	<u>Production #</u>	<u>Objection</u>
	B 00001 - 726	LS
	B 000017	H, LF, NR, I
	B 000018 - 19	H, LF, NR, I
	B 000033 - 34	H, LF, NR, I
	Certified File Wrapper of the '159 Patent.	—
	Current Sales Brochure Illustrating Defendant's Marketed Device.	R
	Claim Chart Showing Claim Interpretation (as decided by the Court).	R

Respectfully submitted,

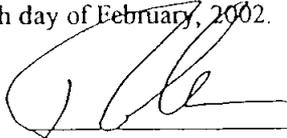
  
Jerry R. Selinger  
Texas Bar No. 18008250  
JENKENS & GILCHRIST, A Professional Corporation  
1445 Ross Avenue  
Suite 3200  
Dallas, Texas 75202  
Telephone: (214) 855-4500  
Facsimile: (214) 855-4300

OF COUNSEL:

F. William McLaughlin  
WOOD, PHILLIPS, VANSANTEN,  
CLARK & MORTIMER  
500 West Madison Street  
Suite 3800  
Chicago, Illinois 60661  
Telephone: (312) 876-1800  
Facsimile: (312) 876-2020

CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing ROBERT H. PETERSON CO.'S OBJECTIONS TO PLAINTIFF'S PRE-TRIAL DISCLOSURE was served by facsimile and first class mail, postage prepaid, to counsel for Plaintiff, William D. Harris, Jr, Esq., Hitt Gaines & Boisbrun, P.C., P O. Box 832570, Richardson, Texas 75083, this 5th day of February, 2002.



---

IN THE UNITED STATES DISTRICT COURT  
 FOR THE NORTHERN DISTRICT OF TEXAS  
 DALLAS DIVISION

RECEIVED  
 FEB 11 2002

GOLDEN BLOUNT, INC., §  
 §  
 Plaintiff, §  
 §  
 v. §  
 §  
 ROBERT H. PETERSON CO., §  
 §  
 Defendant. §

WOOD, PHILLIPS, ET AL

Civil Action No.

3-01CV0127-R

GOLDEN BLOUNT, INC.'S OBJECTIONS  
TO DEFENDANT'S PRE-TRIAL DISCLOSURE

Plaintiff Golden Blount, Inc. ("Golden Blount") respectfully submits its objections under Fed. R. Civ. P. 26(3) to the following designated Defendant's exhibits and witnesses.

<u>Defendant</u> <u>Objected Exhibit #</u>	<u>Ground of Objection</u>
17	Hearsay, Rule 802, F.R. Evid.; Lack of Foundation.
18	Hearsay, Rule 802, F.R. Evid.; Lack of Foundation.
20	Hearsay, Rule 802, F.R. Evid.; Lack of Foundation.
22	Hearsay, Rule 802, F.R. Evid.; Lack of Foundation; Irrelevant; Best evidence rule, Rule 1002-1004, F.R. Evid.; Insufficient Identification; Portions Illegible.
23	Hearsay, Rule 802, R.F. Evid.; Lack of Foundation; Irrelevant; Portions Illegible; Not produced or identified during discovery period; Produced after close of discovery.
31	Lack of Foundation; Plaintiff's reserve right to reject after inspection.

JT-APP 0151

32 Lack of Foundation; Plaintiff's reserve right to reject after inspection.

33 Hearsay, Rule 802, F.R. Evid.; Lack of Foundation.

42 Hearsay, Rule 802, F.R. Evid.; Lack of Foundation; Lack of authenticity, Rule 901, F.R. Evid.; Irrelevant.

43 Hearsay, Rule 802, F.R. Evid.; Lack of Foundation; Lack of authenticity, Rule 901, F.R. Evid.; Irrelevant.

44 Lack of Foundation; Irrelevant; Lack of authentication, Rule 901, F.R. Evid.

47 Hearsay, Rule 802, F.R. Evid.; Lack of Foundation; Lack of authentication, Rule 901, F.R. Evid., as to handwritten portions; Best evidence rule, Rule 1002-1004, F.R. Evid.

48 Hearsay, Rule 802, F.R. Evid.; Lack of Foundation; Lack of authentication, Rule 901, F.R. Evid., as to handwritten portions; Best evidence rule, Rule 1002-1004, F.R. Evid.

56 Hearsay, Rule 802, F.R. Evid.; Lack of Foundation; Lack of authentication, Rule 901, F.R. Evid., as to handwritten portions; Best evidence rule, Rule 1002-1004, F.R. Evid.; Not produced or identified during discovery.

57 Hearsay, Rule 802, F.R. Evid.; Lack of Foundation; Lack of authentication, Rule 901, F.R. Evid., as to handwritten portions; Best evidence rule, Rule 1002-1004, F.R. Evid.; Not produced or identified during discovery.

59 Hearsay, Rule 802, F.R. Evid.; Irrelevant; Not proper evidence except to the extent that judicial admissions or exceptions may be involved.

60 Hearsay, Rule 802, F.R. Evid.; Irrelevant; Not proper evidence except to the extent that judicial admissions or exceptions may be involved.

61 Hearsay, Rule 802, F.R. Evid. except to the extent that admissions may be involved.

62 Hearsay, Rule 802, F.R. Evid. except to the extent that admissions may be involved.

**Defendant**

**Objected Witnesses**

Todd Corrin & Vince Jankowski

Darryl Dworkin & John Palaski

Donald Waldman, Don Henry  
Ted Rasmussen, Fred Eiklor &  
Scott Eiklor

**Ground of Objection**

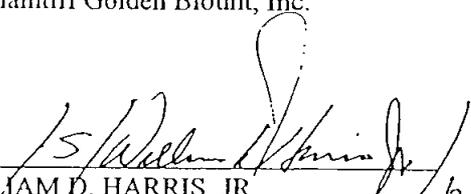
Information expected from witnesses was not given during the Discovery in response to a 30(b)(6) designation that covered the subject matter about which these witnesses are expected to testify.

Witnesses were not identified until long after the Discovery Period; Witnesses testimony is expected to encompass primarily Hearsay.

Plaintiff has not recieved timely notice in that these witnesses' identities were not made known to Plaintiff until long after the close of the Discovery Period

Respectfully submitted,

For Plaintiff Golden Blount, Inc.

  
WILLIAM D. HARRIS, JR.

State Bar No. 09109000

CHARLES W. GAINES

State Bar No. 07570580

Hitt Gaines & Boisbrun, P.C.

225 University Plaza

275 West Campbell Road

Richardson, Texas 75080

972/480-8800 (Telephone)

972/480-8865 (Facsimile)

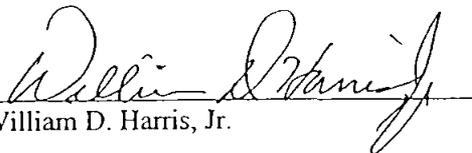
JL-APP 0153

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed ~~Plaintiff's Pretrial Disclosure Pursuant To~~  
F.R.C.P. 26(a)(3) Golden Blount, Inc.'S Objections to Defendant's Pre-trial Disclosure was  
served on the following counsel of record on February 5, 2002, by first class mail and facsimile:

Jerry R. Selinger  
Jenkins & Gilchrist  
1445 Ross Avenue, Suite 3200  
Dallas, Texas 75202  
214/855-4500 (Telephone)  
214/855-4300 (Facsimile)

F. William McLaughlin  
Dean A. Monco  
Wood, Phillips, VanSanten,  
Clark & Mortimer  
500 W. Madison Street, Suite 3800  
Chicago, IL 60611-2511  
312/876-1800 (Telephone)  
312/876-2020 (Facsimile)

  
William D. Harris, Jr.

JT-APP 0154

U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF TEXAS  
 DALLAS  
 FEB 20 2002  
 CLERK, U.S. DISTRICT COURT  
 By \_\_\_\_\_  
 Deputy

IN THE UNITED STATES DISTRICT COURT  
 FOR THE NORTHERN DISTRICT OF TEXAS  
 DALLAS DIVISION

GOLDEN BLOUNT, INC., )  
 )  
 Plaintiff, )  
 )  
 v. ) Civil Action No.: 3:01-CV-0127-R  
 )  
 ROBERT H. PETERSON CO., )  
 )  
 Defendant. )

**ROBERT H. PETERSON CO.'S  
LIST OF EXHIBITS**

The following exhibits are to be used at trial:

<u>Exhibit No.</u>	<u>Description (Production Nos.)</u>
1	Blount U.S. Patent No. 5,988,159
2	File history for Application No. 08/061,727 (000122-000157)
3	File history for U.S. Application No. 08/276,894 (00158-00257)
4	File history for Application No. 08/626,498, now Patent No. 5,988.159, (000258-00333)
5	Peterson, U.S. Patent No. 3,042,109 (000114)
6	Henry, U.S. Patent No. 3871,355 (000115)
7	Shimek, et al., U.S. Patent No. 5,000,162 (000116)
8	Eiklor, et al., U.S. Patent No. 5,033,455 (000113)

9 Karabin, U.S. Patent No. 5,052,370 (000117)  
10 Beal, U.S. Patent No. 5,081,981 (000118)  
11 Beck, U.S. Patent No. 5,263,852 (000119)  
12 Pulone U.S. Patent No. 3,583,845  
13 Reserved  
14 Reserved  
15 Reserved  
16 Tucker letter to Robert H. Peterson Co. dated  
December 10, 1999 (00121)  
17 Corrin letter to McLaughlin dated December 17,  
1999 (000120)  
18 Corrin letter to Tucker dated December 30, 1999  
(B1469)  
19 Tucker letter to Corrin dated May 3, 2000  
20 Stone letter to Tucker dated May 16, 2000 (B1467)  
21 Hardin letter to Corrin dated January 19, 2001  
(B1462-3)  
22 Bortz letter to McLaughlin dated February 9, 2001,  
with attachments (000089-000096)  
23 Bortz fax to McLaughlin dated March 16, 2001,  
with attachments (00097-000112)  
24 Reserved  
25 Peterson List Price sheet dated March 1, 1992  
26 Peterson brochure on Front Flame Director  
27 Reserved  
28 Reserved

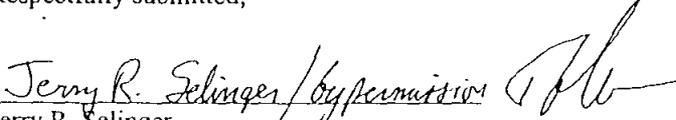
- 29 Golden Blount brochure  
(B 1409-10)
- 30 Sketch showing relative height of G4 burner tube  
and Ember Flame Booster burner tube
- 31 Robert H. Peterson Co. sample G4 burner, model  
GG-24
- 32 Robert H. Peterson Co. sample Ember Flame  
Booster, model AMB-24
- 33 Peterson Real-Fyre® Ember Flame Booster  
advertisement (00015)
- 34 Ember Flame Booster installation and operating  
instructions (00016)
- 35 Photograph of G4 burner and Ember Flame Booster  
(000017)
- 36 Ember booster assembly drawing (000018)
- 37 Flame tube drawing 18"(000019)
- 38 Flame tube drawing 24" (000020)
- 39 Flame tube drawing 30" (000021)
- 40 Valve shield drawing (000022)
- 41 V-17 valve drawing (000023)
- 42 Burner Systems International letter to Boekeloo  
with attachments (000024-000028)
- 43 Drawing of Hook up for Circular G4 burners  
(000029)
- 44 Operation instructions for hearth elbow (000030)
- 45 Installation instructions for Real-Fyre Hearth Logs  
with front flame burner (000031)
- 46 Installation instructions (000032)

- 47 Burner assembly drawing dated July 1, 1983  
(000033)
- 48 Burner assembly drawing dated July 1, 1983  
(000034)
- 49 Peterson list price sheet effective March 1, 1977  
(000035)
- 50 Real-Fyre auxiliary valves and burner parts  
advertisement (000036)
- 51 Real-Fyre F3 series circular burner advertisement  
(000037)
- 52 Gas log warmth from Peterson Real-Fyre  
advertisement (000038-000049)
- 53 Summary of ember booster sales (000051-000053)
- 54 Engineering bill of materials dated October 4, 2001  
(000087)
- 55 Robert H. Peterson Co. Fireplace Decor Accessories  
ad (000088)
- 56 Declaration of John Palaski
- 56a Demonstrative exhibit of burner shown in Ex. 56
- 57 Declaration of Darryl R. Dworkin
- 57a Demonstrative exhibit of burner shown in Ex. 57
- 58 Complaint for Patent Infringement and Jury  
Demand
- 59 Answer and Counterclaim
- 60 Plaintiff's Reply to Defendant's Counterclaim
- 61 Defendant's Answers to Plaintiff Golden Blount,  
Inc.'s First Set of Interrogatories

62	Defendant's Responses to Plaintiff Golden Blount, Inc.'s First Set of Document Requests
63	Plaintiff Golden Blount, Inc.'s Response to Defendant's First Set of Document Requests
64	Plaintiff Golden Blount, Inc.'s Answers and Objections to Defendant's First Set of Interrogatories
65	Original executed page for Interrogatories (B1441)
66	Reserved
67	Reserved
68	Reserved
69	Reserved
70	Reserved

Defendant also reserves the right to use demonstrative exhibits corresponding to the above exhibits.

Respectfully submitted,

  
Jerry R. Selinger  
Texas Bar No. 18008250  
JENKENS & GILCHRIST, a Professional Corporation  
1445 Ross Avenue, Suite 3200  
Dallas, Texas 75202  
Telephone: (214) 855-4500  
Facsimile: (214) 855-4300

OF COUNSEL:

F. William McLaughlin  
WOOD, PHILLIPS, VANSANTEN,  
CLARK & MORTIMER  
500 West Madison Street, Suite 3800  
Chicago, Illinois 60661  
Telephone: (312) 876-1800

Facsimile: (312) 876-2020

CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing ROBERT H. PETERSON CO.'S LIST OF EXHIBITS was served by hand delivery to counsel for Plaintiff, William D. Harris, Jr., Esq., Hitt Gaines & Boisbrun, P.C., P.O. Box 832570, Richardson, Texas 75083, this 20<sup>th</sup> day of February, 2002.

Gloria Parker

JT-APP 0160

RECEIVED IN DROP BOX  
FEB 28 1994  
CLERK OF COURT  
NORTHERN DISTRICT OF TEXAS

JT-APP 0161

U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF TEXAS  
 FILED  
 FEB 20 2002  
 U.S. DISTRICT COURT

IN THE UNITED STATES DISTRICT COURT  
 FOR THE NORTHERN DISTRICT OF TEXAS  
 DALLAS DIVISION

GOLDEN BLOUNT, INC., )  
 )  
 Plaintiff, )  
 )  
 v. )  
 )  
 ROBERT H. PETERSON CO., )  
 )  
 Defendant. )

Civil Action No.: 3:01-CV-0127-R

**ROBERT H. PETERSON CO.'S  
LIST OF WITNESSES**

The following persons are probable witnesses at trial:

<u>Name</u>	<u>Address</u>
1. Leslie Bortz	Robert H. Peterson Co. 2500 West Arthington Street Chicago, Illinois 60612
Expected Testimony:	General background of Robert H. Peterson Co. and its products; background of market for dual burner fireplace burner systems; timing and characteristics of allegedly infringing burner systems; and notice of litigation and reliance on advice of counsel regarding issues of non-infringement and invalidity of the '159 Blount patent.
2. Tod Corrin	Robert H. Peterson Co. 14724 East Proctor Avenue City of Industry, California 91746
Expected Testimony:	Matters relating to timing and characteristics of allegedly infringing burner systems, sales and profits of the allegedly infringing burner systems.

3. Darryl Dworkin D.N.V., Inc.  
Summit-Fyreside  
911 First Avenue  
Asbury Park, New Jersey 07712-7207

Expected Testimony: Matters relating to the scope and content of prior art for gas fireplace dual burner systems including intermediate valves.

4. John Palaski 500 Oak Glen Road  
Howell, New Jersey 07731

Expected Testimony: Matters relating to the scope and content of prior art for gas fireplace dual burner systems including intermediate valves.

The following persons are possible witnesses at trial:

5. Vince Jankowski Robert H. Peterson Co.  
14724 East Proctor Avenue  
City of Industry, California 91746

Expected Testimony: General background of Robert H. Peterson Co. and its products; background of market for dual burner fireplace burner systems; timing and characteristics of allegedly infringing burner systems regarding issues of non-infringement and invalidity of the '159 Blount patent.

6. Donald Waldman RADCO  
3220 East 59th Street  
Long Beach, California 90805

Expected Testimony: Matters relating to the scope and content of prior art for gas fireplace dual burner systems including intermediate valves.

7. Don Henry To be supplied

Expected Testimony: Matters relating to the scope and content of prior art for gas fireplace dual burner systems including intermediate valves.

8. Scott Eiklor

Eiklor Flame  
282 E. Pivot Point  
Paoli, IN 47454

Expected Testimony:

Matters relating to the scope and content of  
prior art for gas fireplace dual burner  
systems including intermediate valves.

Respectfully submitted,

*Jerry R. Selinger / by permission* 

Jerry R. Selinger  
JENKENS & GILCHRIST  
1445 Ross Avenue  
Suite 3200  
Dallas, Texas 75202  
Telephone: (214) 855-4500  
Facsimile: (214) 855-4300

OF COUNSEL:

F. William McLaughlin  
WOOD, PHILLIPS, VANSANTEN,  
CLARK & MORTIMER  
500 West Madison Street  
Suite 3800  
Chicago, Illinois 60661  
Telephone: (312) 876-1800  
Facsimile: (312) 876-2020

CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing PETERSON CO.'S LIST OF WITNESSES was served by hand delivery to counsel for Plaintiff, William D. Harris, Jr., Esq., Hitt Gaines & Boisbrun, P.C., P.O. Box 832570, Richardson, Texas 75083, this 20<sup>th</sup> day of February, 2002.

Blair Parker

JT-APP 0165

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

**PLAINTIFF GOLDEN BLOUNT, INC'S  
PRETRIAL MATERIALS**

The following Pretrial Materials are made to comply with paragraph 11 of the Court's Scheduling Order.

**A. JOINT PRETRIAL ORDER**

1. The Joint Pretrial Order is being filed as an individual motion in and of itself, and therefore, it is not included herewith.

**B. PLAINTIFF'S LIST OF WITNESSES**

1. Plaintiff's list of witnesses is attached hereto as Section B.

**C. PLAINTIFF'S LIST OF EXHIBITS**

1. Plaintiff's list of exhibits is attached hereto as Section C.

**D. PLAINTIFF'S DESIGNATION OF PORTIONS OF DEPOSITIONS**

1. Plaintiff's designations of portions of depositions is attached hereto as Section D.

**E. PLAINTIFF'S REQUESTED JURY INSTRUCTIONS AND ISSUES AND PROPOSED VOIR DIRE QUESTIONS**

At the outset Plaintiff points out that, if permission be granted, it is withdrawing its jury request. We have come to appreciate that the issues are such that the trial could be conducted much more quickly without a jury and without a massive infusion of instructions.

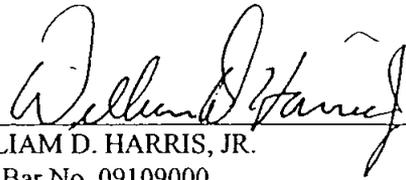
Defendant did not make a jury demand and it is the undersigned's understanding that defendant does not have any objection in moving the case from the jury docket to the bench docket. This matter could be directed by a formal motion, if necessary, but a simple concurrence from the Defendant would seem adequate under these circumstances.

Reluctantly we submit herewith our jury instructions and issues and proposed voir dire. This mass paper could be boiled down into some relative single findings of fact and conclusions of law, in the event the Court handles this as a bench trial.

Accordingly, enclosed herewith are the following:

1. Plaintiff's proposed voir dire questions are attached hereto as section E-1.
2. Plaintiff's requested jury instructions and issues are attached hereto as section E-2.
3. Plaintiff's requested jury questions are attached hereto as section E-3.

Respectfully submitted,  
For Plaintiff Golden Blount, Inc.



WILLIAM D. HARRIS, JR.

State Bar No. 09109000

CHARLES W. GAINES

State Bar No. 07570580

Hitt Gaines & Boisbrun, P.C.

225 University Plaza

275 West Campbell Road

Richardson, Texas 75080

972/480-8800 (Telephone)

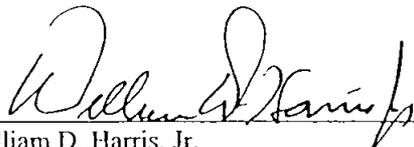
972/480-8865 (Facsimile)

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Plaintiff's Pretrial Materials was served on the following counsel of record on February 20, 2002, by Express Mail:

Jerry R. Selinger  
Jenkins & Gilchrist  
1445 Ross Avenue, Suite 3200  
Dallas, Texas 75202  
214/855-4500 (Telephone)  
214/855-4300 (Facsimile)

F. William McLaughlin  
Dean A. Monco  
Wood, Phillips, VanSanten,  
Clark & Mortimer  
500 W. Madison Street, Suite 3800  
Chicago, IL 60611-2511  
312/876-1800 (Telephone)  
312/876-2020 (Facsimile)

  
\_\_\_\_\_  
William D. Harris, Jr.

JT-APP 0168

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

**B. GOLDEN BLOUNT, INC.'S  
LIST OF WITNESSES AND BRIEF  
STATEMENT OF EXPECTED TESTIMONY**

The following designations are Plaintiff's effort to comply with paragraph 11.b. of the Court's Scheduling Order (each party's list of the witnesses):

**A. WITNESSES**

**I. Probable Witnesses**

Golden Blount  
4301 Westgrove  
Addision, Texas 75001  
(972) 250-3113

Expected Testimony:

General background of gas log industry, Golden Blount, Inc. and its ability to deliver product to market, background of invention and its development and need in the industry. Matters regarding notice to Robert H. Peterson Co. of its infringement of U.S. Patent No. 5,988,159 and reasons for sending the notice. Matters relating to claims at issue of U.S. Patent No. 5,988,159, how they read on Robert H. Peterson Co.'s Ember Flame Booster and its G-4 and G-5 series log sets, how they cover Golden Blount, Inc.'s commercial device, and its similarity to Robert H. Peterson Co.'s devices. Matters relating to the establishment and amount of damages incurred by Golden Blount, Inc. as a result of Robert H. Peterson Co.'s infringement.\*

JT-APP 0169

\*As chief executive officer of a small company, Mr. Blount is in fact custodian of the records, and may serve that function in the introduction of his companies documents.

Charlie Hanft  
2316 Main Street  
Tucker, Georgia 30084  
(770) 934-8646

Expected Testimony:

His general background and experience in the industry. General background of his business and his business relationship with Robert H. Peterson Co.'s products during the years extending from 1991 through 1997. His initial and continuing impressions of Golden Blount, Inc.'s commercial ember burner as covered by U.S. Patent No. 5,988,159. How it has addressed a need in the industry for promoting a more realistic looking gas log set-up by placing a flame adjacent to the front ember bed and enhancing the appearance of the embers

Greg H. Parker  
275 West Campbell Rd., Suite 225  
Richardson, Texas 75080  
(972) 480-8800

Expected Testimony:

Preparation and formal identification of demonstrative materials previously identified.

2. Possible Witnesses

Leslie Bortz  
President of Robert H. Peterson Co.  
(address and telephone number known by Robert H. Peterson Co.)

Expected Testimony:

Since Mr. Bortz is an adverse witness, the full extent to which Golden Blount, Inc. knows such testimony is limited and depends on the testimony that Mr. Bortz will give on behalf of Robert H. Peterson Co. Nevertheless, Golden Blount, Inc. expects to cover the following areas with Mr. Bortz if he appears at trial.

Matters relating to the oral opinion he obtained from William McLaughlin, including the timing in obtaining the opinion and the circumstances surrounding his need to obtain an opinion,

the oral nature of the opinion given, the incomplete information supplied to him, and the casual telephone advice like circumstances under which the opinion was given. Matters relating to asserted prior art devices, including their development and the extent of their use in the marketplace. Matters relating to the number of units of Ember Flame Boosters and number of G-4 and G-5 gas log sets sold by Robert H. Peterson Co. Matters relating to advertising, marketing and distribution of the Ember Flame Booster.

F. William McLaughlin  
500 W. Madison Street, Suite 3800  
Chicago, Illinois 60611  
(312) 876-1800

Expected Testimony:

Since Mr. McLaughlin is an adverse witness, the full extent to which Golden Blount, Inc. knows such testimony is limited and depends on the testimony that Mr. McLaughlin will give on behalf of Robert H. Peterson Co. Nevertheless, Golden Blount, Inc. expects to cover the following areas with Mr. McLaughlin if he appears at trial.

Matters relating to the oral opinions he gave to Robert H. Peterson Co., including the timing of such opinions, the lack of information he possessed on which to base a complete opinion, the casual telephone circumstances under which his opinion/advice was given, the content of such opinions and his analysis in reaching his opinions.

Steve Blount  
4301 Westgrove  
Addision, Texas 75001  
(972) 250-3113

Expected Testimony:

General background of gas log industry and Golden Blount, Inc. and its ability to deliver product to market and the general state of the art prior to the invention claimed in U.S. Patent No. 5,988,159 .

Daryl Webster  
Webco Distributing  
12012 N. Lamar Blvd.  
Austin, Texas 78753  
(512) 836-8476

Expected Testimony:

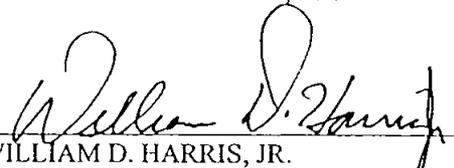
His general background and experience in the industry. General background of his business. His impressions of Golden Blount, Inc.'s commercial ember burner as covered by U.S. Patent No. 5,988,159. How it has addressed a need in the industry for promoting a more realistic looking gas log set-up by placing a flame adjacent to the front ember bed and enhancing the appearance of the embers.

**B. RECORD CUSTODIANS**

- I. Golden Blount  
4301 Westgrove  
Addision, Texas 75001  
(972) 250-3113

\* See brief statement concerning Golden Blount in the probable witnesses category above.

Respectfully submitted,  
For Plaintiff Golden Blount, Inc.

  
WILLIAM D. HARRIS, JR.

State Bar No. 09109000

CHARLES W. GAINES

State Bar No. 07570580

Hitt Gaines & Boisbrun, P.C.

225 University Plaza

275 West Campbell Road

Richardson, Texas 75080

972/480-8800 (Telephone)

972/480-8865 (Facsimile)

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

C. PLAINTIFF GOLDEN BLOUNT INC.'S  
LIST OF EXHIBITS

The following list is Plaintiff's effort to comply with paragraph 11.c. of the Court's Scheduling Order (each party's list of exhibits).

- Document Bates Number B1213
- Document Bates Number B1554
- Document Bates Numbers B1555-B1559
- Document Bates Number 000015
- Document Bates Number 000016
- Document Bates Number 000050
- Document Bates Numbers 000051-000053
- Various Boards, Charts and Video Tape as follows:
  - Trial Board Exhibit or overheads illustrating elements (and structures) of Defendant's device versus the claim language of the '159 Patent, and also

including an illustration and comparison of the elements (and structures) of the Plaintiff's device.

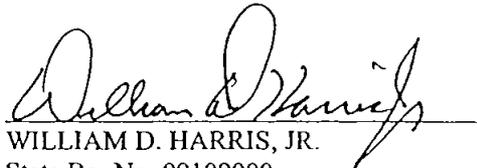
Annotated drawings may be used to illustrate aspects of the foregoing.

- Trial Board Exhibits or overheads illustrating total sales in number and dollar amount of Plaintiff's log sets/assembly burner sets/secondary coals (ember) burner sets.
  - Trial Board Exhibits or overheads illustrating total sales in number and dollar amount of Defendant's log sets/assembly burner sets/secondary coals (ember) burner sets.
  - Trial Board Exhibits or overhead illustrating the actual damages in number of devices sold by Defendant multiplied by Plaintiff's profit per device.
  - Video demonstration of Plaintiff's working log and assembly burner set with and without secondary coals (ember) burner set.
  - A comparison of Defendant's log and assembly burner set with the secondary coals (ember) burner set to Defendant's log and assembly burner set without the secondary coals (ember) burner set (illustrations taken directly from Defendant's website).
- Plaintiff's Commercial Device Covered by the Claims of the '159 Patent
  - Defendant's Commercial Device that Allegedly Infringes the '159 Patent
  - Document Bates Numbers B0001-B0726
  - Document Bates Number 000017
  - Document Bates Numbers 000018-000019
  - Document Bates Numbers 000033-000034

- Certified File Wrapper of the '159 Patent
- Current Sales Brochure Illustrating Defendant's Marketed Device
- Defendant's 97/98 Sales Catalog
- Claim Chart Showing Claim Interpretation (As Decided by the Court)

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



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JT-APP 0175

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

**D. PLAINTIFF GOLDEN BLOUNT, INC.'S  
LIST OF DESIGNATION OF PORTIONS OF DEPOSITIONS**

The following designations are Plaintiff's effort to comply with paragraph 11.d. of the Court's Scheduling Order (each party's designation of portions of depositions).

**A. DEPOSITION DESIGNATIONS**

**1. Pages Designated from Leslie Bortz 30(B)(6) Volume 1  
October 5, 2001:**

Page 3; Lines 1-21  
Page 11; Line 11 through Page 12; Line 1  
Page 19; Lines 15-21  
Page 21; Line 20 through Page 22; Line 24  
Page 25; Lines 5-16  
Page 27; Lines 2-8  
Page 28; Line 5 through Page 29; Line 8  
Page 29; Line 13 through Page 31; Line 9  
Page 32; Lines 4-22  
Page 35; Lines 5-12  
Page 36; Lines 11-24  
Page 38; Lines 10 through Page 39; Line 21  
Page 43; Lines 21 through Page 44; Line 19  
Page 47; Lines 15-20  
Page 48; Lines 10-20  
Page 52; Lines 12-24

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Page 53; Line 24 through Page 54; Line 15  
Page 56; Lines 13 through Page 59; Line 10  
Page 65; Lines 10-13  
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Page 69; Lines 1 through Page 71; Line 23  
Page 73; Line 11 through Page 74; Line 6  
Page 74; Line 14 through Page 75; Line 7  
Page 78; Line 20 through Page 79; Line 2  
Page 117; Line 1-5  
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Page 128; Lines 9-21  
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Page 174; Line 18 through Page 176; Line 4  
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Page 183; Lines 2-7  
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2. **Pages Designated from Leslie Bortz, Vol. 2  
December 19, 2001:**

Page 1; Lines 1-25  
Page 4; Lines 6-9  
Page 16; Lines 13-24  
Page 18; Lines 16-25  
Page 19; Lines 1-2  
Page 20; Lines 9-21  
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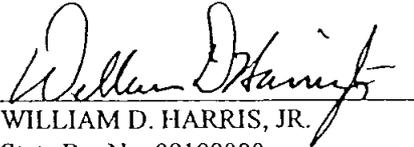
**3. Pages Designated from William McLaughlin  
December 19, 2001:**

Page 1, Lines 1-25  
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Page 7, Line 1  
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Page 72; Lines 7-25  
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Respectfully submitted,

For the Plaintiff Golden Blount, Inc.



---

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IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

**E-1. PLAINTIFF GOLDEN BLOUNT INC.'S  
PROPOSED VOIR DIRE QUESTIONS**

The following list of voir dire questions is made to comply with paragraph 11.e. of the Court's Scheduling Order.

1. What is your occupation?
2. Do you know the plaintiff company, Golden Blount, Inc. or Mr. Golden Blount? Please describe.
3. Do you know the defendant, Robert H. Peterson Co.? Please describe.
4. Have you or any member of your family ever engaged Mr. William Harris or the law firm of Hitt, Gaines and Boisbrun? Please describe.
5. Have you or any member of your family ever engaged Mr. Roy W. Hardin, Mr. L. Dan Tucker or the law firm Locke, Liddell & Sapp? Please describe.
6. Have you or any member of your family ever engaged Jerry R. Selinger or the law firm of Jenkins & Gilchrist? Please describe.
- 6.a. Have any of you engaged the law firm of Woods et al. or William McLaughlin in Chicago? Please describe.
7. How many of you were born and raised in Texas?

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- 7.a. How many here have lived in Chicago more than 5 years?
8. Have you previously served on a jury? Please describe.
9. Have you ever been a party to a lawsuit? Please describe.
10. Does your home or office have a fireplace? Please describe. Gas?
11. Have you ever sought or owned a patent?
12. Have you felt someone has copied an idea of yours or of someone you know?
13. Do you believe that the U.S. patent system is capable to building creation and inventions?
14. Would you say that you are mechanically inclined or do you like to work with your hands? Please describe.
15. Have you or any member of your family worked for the Federal Government? Please describe.
16. The plaintiff in this case received a patent from the U.S. Patent & Trademark Office. If the evidence presented in this case by the defendant is sufficient to show the patent was invalid, would any of you have any difficulty in finding a patent issued by the U.S. Patent & Trademark Office to be invalid?
17. Would you find a patent issued by the United States Patent & Trademark Office invalid if it appears the government made no mistake in granting the patent and that the patent has not been shown to be invalid by clear and convincing evidence?
18. Have any of you purchased a gas fireplace which did not work properly?
19. Have you or anyone you know ever suffered any property damage or personal injuries as a result of a defective gas fireplace? Please describe.

Respectfully submitted,  
For Plaintiff Golden Blount, Inc.

  
\_\_\_\_\_  
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JT-APP 0183

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
§  
§  
§  
§  
§  
§

Civil Action No.

3-01CV0127-R

E-2. PLAINTIFF GOLDEN BLOUNT INC.'S  
PROPOSED JURY INSTRUCTIONS

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PLAINTIFF'S PROPOSED  
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PLAINTIFF'S PROPOSED  
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PLAINTIFF'S PROPOSED  
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PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

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PLAINTIFF'S PROPOSED  
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PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

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PLAINTIFF'S PROPOSED  
 JURY INSTRUCTIONS

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JT-APP 0191

PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

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JT-APP 0192

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 1  
PRELIMINARY INSTRUCTIONS  
DUTY OF JURY

Ladies and gentlemen: You now are the jury in this case, and I want to take a few minutes to tell you something about your duties as jurors and to give you some instructions. At the end of the trial I will give you more detailed instructions. Those instructions will control your deliberations.

It will be your duty to decide from the evidence what the facts are. You, and you alone, are the judges of the facts. You will hear the evidence, decide what the facts are, and then apply those facts to the law which I will give to you. That is how you will reach your verdict. In doing so, you must follow that law whether you agree with it or not. The evidence will consist of the testimony of witnesses, documents, and other things received into evidence as exhibits and any facts on which the lawyers agree or which I may instruct you to accept.

You should not take anything I may say or do during the trial as indicating what I think of the evidence or what your verdict should be.

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 2  
PRELIMINARY INSTRUCTIONS  
WHAT IS NOT EVIDENCE

The following things are not evidence, and you must not consider them as evidence in deciding the facts of this case:

1. Statements and arguments of the attorneys;
2. Questions and objections of the attorneys;
3. Testimony that I instruct you to disregard;
4. Anything you may see or hear when the Court is not in session even if what you see or hear is done or said by one of the parties or by one of the witnesses.

PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

2

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JT-APP 0194

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 3  
PRELIMINARY INSTRUCTIONS  
EVIDENCE FOR LIMITED PURPOSE**

Some evidence may be admitted for a limited purpose only. When I instruct you that an item of evidence has been admitted for a limited purpose, you must consider it only for that limited purpose, and for no other.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 4  
PRELIMINARY INSTRUCTIONS  
DIRECT AND CIRCUMSTANTIAL EVIDENCE**

Evidence may be direct or circumstantial. Direct evidence is direct proof of a fact, such as testimony by a witness about what that witness personally saw, heard or did. Circumstantial evidence is proof of one or more facts from which you could find another fact. You should consider both kinds of evidence. The law makes no distinction between the weight to be given to either direct or circumstantial evidence. It is for you to decide how much weight to give to any evidence.

PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

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JT-APP 0196

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 5  
PRELIMINARY INSTRUCTIONS  
RULING ON OBJECTIONS**

There are rules of evidence which control what can be received into evidence. When a lawyer asks a question or offers an exhibit into evidence and a lawyer on the other side thinks that it is not permitted by the rules of evidence, that lawyer may object. If I overrule the objection, the question may be answered or the exhibit received. If I sustain the objection, the question cannot be answered, and the exhibit cannot be received. When I sustain an objection to a question, you must ignore the question and must not guess what the answer might have been.

Sometimes I may order that evidence be stricken from the record and that you disregard or ignore the evidence. That means that when you are deciding the case, you must not consider the evidence which I told you to disregard.

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 6  
PRELIMINARY INSTRUCTIONS  
CREDIBILITY OF WITNESSES

In deciding the facts in this case, you may have to decide which testimony to believe and which testimony not to believe. You may believe everything a witness says, or part of it, or none of it.

In considering the testimony of any witness, you may take into account:

1. The opportunity and ability of the witness to see, hear or know the things testified to;
2. The witness' memory;
3. The witness' manner while testifying;
4. The witness' interest in the outcome of the case and any bias or prejudice;
5. Whether other evidence contradicted the witness' testimony;
6. The reasonableness of the witness' testimony in light of all the evidence; and
7. Any other factors that bear on believability.

The weight of the evidence as to a fact does not necessarily depend on the number of witnesses who testify.

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 7  
PRELIMINARY INSTRUCTIONS  
CONDUCT OF THE JURY

I will now say a few words about your conduct as jurors.

First, do not talk to each other about this case or about anyone who has anything to do with it until the end of the case when you go to the jury room to decide on your verdict.

Second, do not talk with anyone else about this case or about anyone who has anything to do with it until the trial has ended and you have been discharged as jurors. "Anyone else" includes members of your family and your friends. You may tell them that you are a juror, but don't tell them anything about the case until after you have been discharged by me.

Third, do not let anyone talk to you about the case or about anyone who has anything to do with it. If someone should try to talk to you, please report it to me immediately.

Fourth, do not read any news stories or articles or listen to any radio or television reports about the case or about anyone who has anything to do with it.

Fifth, do not do any research, such as consulting dictionaries or other reference materials, and do not make any investigation about the case on your own.

Sixth, if you need to communicate with me, simply give a signed note to the [marshal] [bailiff] [clerk] [law clerk] to give to me.

Seventh, do not make up your mind about what the verdict should be until after you have gone to the jury room to decide the case and you and your fellow jurors have discussed the evidence. Keep an open mind until then.

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 8  
PRELIMINARY INSTRUCTIONS  
NO TRANSCRIPT AVAILABLE TO JURY

At the end of the trial, you will have to make your decision based on what you recall of the evidence. You will not have a written transcript to consult, and it is difficult and time-consuming for the reporter to read back lengthy testimony. I urge you to pay close attention to the testimony as it is given.

PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

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PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 9  
PRELIMINARY INSTRUCTIONS  
TAKING NOTES

If you wish, you may take notes to help you remember what witnesses said. If you do take notes, please keep them to yourself until you and your fellow jurors go to the jury room to decide the case. Do not let note-taking distract you so that you do not hear other answers by witnesses. When you leave, your notes should be left in the [courtroom] [juryroom] [envelope in the jury room].

Whether or not you take notes, you should rely on your own memory of what was said. Notes are only to assist your memory. You should not be overly influenced by the notes.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 10**  
**PRELIMINARY INSTRUCTIONS**  
**THE NATURE OF THE ACTION AND THE PARTIES**

This is a patent infringement case. The patent involved in this case relates to a burner assembly for a gas fireplace. During the trial, the parties will offer testimony to familiarize you with this technology.

The United States Patent and Trademark Office has granted a patent to Golden Blount for inventions relating to this technology. Golden Blount, Inc. is currently the owner of the patent, which is identified by the Patent Office by number: 5,988,159 (which may be called "the '159 Patent"). This patent may also be referred to as "the Blount patent."

A. The United States Patent

The patent laws promote creative thought and the progress of ideas by giving true inventors the right to exclude others from making, using, offering to sell or selling the patented invention within the United States, its territories, and its possessions. In return for the right of exclusion, the patent laws impose upon the inventor a requirement of complete disclosure, to ensure adequate and full disclosure so that upon the expiration of that period, the knowledge of the invention inures to the people, and stimulates further thinking during that period.

I will briefly describe and the parties will offer testimony to familiarize you with how one obtains a patent from the United States Patent and Trademark Office (sometimes referred to as "the PTO"), as well as with the contents of a patent, including the specification or written description and the claim or claims by which the applicant defines the subject matter of his or her invention.

I will briefly describe some of the terms for you so that you have some background in the patent terminology. The Patent and Trademark Office, the PTO, is in the Washington, D.C. area and is an agency of the Federal Government. It has more than a thousand technically educated examiners who examine applications for patents.

The application is the initial set of papers filed with the PTO by the applicant. In addition to some other papers, such as the inventor's oath, the application includes a specification, which must have a written description of the invention telling what the invention is, how it works, and how to make and use it so as to enable others skilled in the art to do so. The specification concludes with one or more numbered sentences. These are the claims. The purpose of the claims is to particularly point out what the applicant regards as his or her invention. When the patent is eventually issued by the PTO, the claims define the scope of the patent owner's exclusive rights during the life of the patent. In a few minutes, I will describe for you the meaning of the claim[s] of the '159 Patent.

After the applicant files the application, a PTO patent examiner reviews (or examines) the patent application to determine whether the claims are patentable and whether the specification adequately describes the invention claimed. In examining a patent application, the patent examiner makes a search of the PTO records for prior art to the patent application claims. The examiner considers, among other things, whether each claim defines an invention that is new, useful, and not obvious in view of this prior art. The prior art is defined by statute and I will give specific instructions as to what constitutes prior art to the '159 Patent after the close of the evidence. However, prior art generally is technical information and knowledge that was known to the public either before the invention by the applicant or more than a year before the effective filing date of the

application.

Following the prior art search and examination of the application, the patent examiner then advises the applicant in writing what the examiner has found and whether he has "allowed" any claim. This writing from the PTO examiner is called an office action. More often than not, the initial office action by the examiner rejects one or more of the claims. The applicant then responds to this, and sometimes changes the claims or submits new claims. This process may go back and forth between the patent examiner in the PTO and the applicant for several months, or even for years, until the examiner is satisfied that the application and claims meet the conditions for patentability.

The papers generated during this time of corresponding back and forth between the PTO patent examiner and the applicant is what is called the prosecution history. This history of written correspondence is contained in a file in the PTO, and consequently some people over the course of the trial may call this history the file wrapper.

B. Patent Litigation

A company is said to be infringing on claims of a patent when they, without permission from the patent owner, make, use, import, offer to sell or sell the patented invention, as defined by the claims, within the United States before the term of the patent expires. A company is also said to be infringing on claims of a patent when they induce infringement or contribute to infringement. Inducement occurs when a company influences, encourages, or assists a third party to make, use, import, or offer to sell a patented invention. Contributory infringement occurs when a company offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in

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practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent.

A patent owner that believes someone is infringing on his or her exclusive rights under a patent may bring a lawsuit like this to stop the alleged infringing acts and recover damages. The patent owner has the burden to prove infringement of the claims of the patent. The patent owner also has the burden to prove damages caused by that infringement, which are adequate to compensate for the infringement. Damages may be measured by the patent owner's lost profits caused by the infringement. Damages may not be less than a reasonable royalty for the use made of the invention.

A person sued for allegedly infringing a patent can deny infringement, and can also defend by proving the asserted claims of the patent are invalid. The accused infringer has the burden to prove invalidity by clear and convincing evidence. In evaluating infringement or invalidity, each claim is to be evaluated independently. I will now briefly explain the parties' basic contentions in more detail.

C. Contentions of the Parties

In this case, the plaintiff contends that the defendant makes, uses or sells a product, a secondary coals burner sold as an ember flame booster, and tells its customers how to use the ember flame booster, which infringes claims of the '159 Patent. Plaintiff has the burden of proving that the defendant infringes the patent by a preponderance of the evidence. That means that the plaintiff must show that more likely than not, the defendant's product infringes the claims of the '159 Patent.

There are two ways in which a patent claim can be directly infringed. First, a claim can be literally infringed. Second, a claim can be infringed under what is called the "doctrine of

equivalents," which I will address shortly.

To determine literal infringement, you must compare the accused product with each claim that the plaintiff asserts is infringed. It will be my job to tell you what the patent claims mean. You must follow my instructions as to the meaning of the patent claims.

A patent claim is literally infringed only if defendant's product includes each and every element of that patent claim. If defendant's product does not contain one or more elements recited in a claim, defendant does not literally infringe that claim. You must determine literal infringement with respect to each patent claim individually. If elements are not present, there may still be inducement to infringe or contributory infringement if the defendant induces another to infringe or if there is contributory infringement, as I defined earlier.

Apart from inducement and contributory infringement, you may find that defendant's product directly infringes a claim of plaintiff's patent, even if not every element of that claim is present in defendant's product. However, to do so, you must find that there is an equivalent component or part in defendant's product for each element of the patent claim that is not literally present in the defendant's product. This is called infringement under the doctrine of equivalents. The plaintiff has the burden of proving by a preponderance of the evidence that the defendant's product contains the equivalent of each element of the claimed invention that is not literally present in the defendant's product.

The defendant denies that it is infringing the asserted claims of the '159 Patent, either directly or by inducement or contributory infringement. The defendant also contends that the '159 Patent is invalid because the invention was either anticipated by the prior art or was obvious from the prior

art.

Invalidity is a defense to infringement. Therefore, even though the PTO examiner has allowed the claims of the '159 Patent to issue, you the jury, have the ultimate responsibility for deciding whether the claims of the patent are valid. The defendant bears the burden of proving invalidity by clear and convincing evidence. This is a much stricter or higher burden than a preponderance of the evidence; on the other hand, this does not require proof beyond a reasonable doubt. It will be your job, at the end of this trial, to determine whether the defendant has met its burden of proving the invalidity of the asserted claims of the '159 Patent. Clear and convincing evidence is evidence that produces in your mind an abiding conviction that the claims are invalid.

D. Trial Procedure

We are about to commence the opening statements in the case. Before we do that, I want to explain to you a little bit about the procedures that we will be following during the trial and the format of the trial. This trial, like all jury trials, comes in six general states or phases. We have already been through the first phase, which is to select you as jurors. We are now about to begin the second phase, the opening statements. The opening statements of the lawyers are statements about what each side expects the evidence to show. The opening statements are not evidence in the case.

The evidence comes in the next phase, the third phase, when the witnesses will take the witness stand and the documents will actually be offered and admitted into evidence. In the third phase, the plaintiff goes first in calling witnesses to the witness stand. These witnesses will be questioned by the plaintiff's counsel in what is called direct examination. After the direct examination of a witness is completed, the opposing side has an opportunity to cross-examine the

witnesses. Subsequently, the defendant will call its witnesses, who will also be examined and cross-examined.

The evidence often is introduced somewhat piecemeal, so you as jurors need to keep an open mind as the evidence comes in. Wait until all the evidence comes in before you make any decision. In other words, keep an open mind throughout the entire trial.

After we conclude the third phase and the evidence has been presented, the lawyers again have an opportunity to talk with you in what's called closing arguments, which is the fourth phase. Again, what the lawyers say is not evidence. The lawyers' closing arguments are for the purpose of helping you in making your determination.

After that phase, we reach the fifth phase of the trial, which is when I read you the jury instructions. In that phase, I will instruct you on the law. I have already explained a little bit about the law to you. But later, in this fifth phase of the trial, I will explain the law in much more detail.

Finally, in the sixth phase of the trial it will be time for you to deliberate. You can then evaluate the evidence, discuss the evidence among yourselves and make a determination in the case. Remember that it will be your duty to find what the facts are from the evidence as presented at the trial. You, and you alone, are the judges of the facts. You have to apply those facts to the law and the patent claims that I will advise you of at the close of the evidence.

You are the judges of the facts. I will explain to you the rules of law which apply to this case, and I will also explain to you the meaning and scope of the patent claims. You must follow that law and claims interpretation whether you agree with it or not. Nothing I say or do during the course of the trial is intended to indicate what your verdict should be.

Authority: Adapted from AIPLA's Guide to patent Jury Instructions; U.S. Const., art I § 8, cl. 8; 35 U.S.C. § 102, 103. Adapted from *Micron Motion v. Exac*, 686 F.Supp. 789, U.S.P.Q.2d 1957 (N.D. Cal. 1987), aff'd, 876 F.2d 1574, U.S.P.Q.2d 1070 (Fed. Cir. 1989). *Oshkosh Truck Corp. v. Lockheed Missiles & Space Co., Inc.*, 678 F.Supp. 809, 4 U.S.P.Q.2d 1404 (N.D. Cal. 1987); Modern Federal Jury Instructions - Civil.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 11**  
**GENERAL INSTRUCTIONS AFTER CLOSE**  
**DUTIES OF JURY TO FACTS AND FOLLOW LAW**

Members of the jury, now that you have heard all the evidence, it is my duty to instruct you on the law which applies to this case. A copy of these instructions will be available in the jury room for you to consult if you find it necessary.

It is your duty to find the facts from all the evidence in the case. To those facts you will apply the law as I give it to you. You must follow the law as I give it to you whether you agree with it or not. You must not be influenced by any personal likes or dislikes, opinions, prejudices, or sympathy. That means that you must decide the case solely on the evidence before you. You will recall that you took an oath promising to do so at the beginning of the case.

In following my instructions, you must follow all of them and not single out some and ignore others; they are all equally important. You must not read into these instructions or into anything the court may have said or done as to what verdict you should return-that is a matter entirely up to you.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 12**  
**GENERAL INSTRUCTIONS AFTER CLOSE**  
**USE OF NOTES**

You may use notes taken during trial to assist your memory. Notes, however, should not be substituted for your memory, and you should not be overly influenced by the notes.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 13**  
**GENERAL INSTRUCTIONS AFTER CLOSE**  
**WHAT IS EVIDENCE**

The evidence from which you are to decide what the facts are consists of:

1. The sworn testimony of witnesses, on both direct and cross-examination, regardless of who called the witness;
2. The exhibits which have been received into evidence; and
3. Any facts to which all the lawyers have agreed or stipulated.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 14**  
**GENERAL INSTRUCTIONS AFTER CLOSE**  
**WHAT IS NOT EVIDENCE**

In reaching your verdict, you may consider only the testimony and exhibits received into evidence. Certain things are not evidence, and you may not consider them in deciding what the facts are. I will list those things that are not considered evidence for you:

1. Arguments and statements by lawyers are not evidence. The lawyers are not witnesses.

What they have said in their opening statements, closing arguments, and at other times is intended to help you interpret the evidence, but it is not evidence. If the facts as you remember them differ from the way the lawyers have stated them, your memory of them controls.

2. Questions and objections by lawyers are not evidence. Attorneys have a duty to their clients to object when they believe a question is improper under the rules of evidence.

You should not be influenced by the objection or by the court's ruling on it.

3. Testimony that has been excluded or stricken, or that you have been instructed to disregard, is not evidence and must not be considered. [In addition some testimony and exhibits have been received only for a limited purpose; where I have given a limiting instruction, you must follow it.]

4. Anything you may have seen or heard when the court was not in session is not evidence.

You are to decide the case solely on the evidence received at the trial.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 15**  
**GENERAL INSTRUCTIONS AFTER CLOSE**  
**DIRECT AND CIRCUMSTANTIAL EVIDENCE**

Evidence may be direct or circumstantial. Direct evidence is direct proof of a fact, such as testimony by a witness about what the witness personally saw, heard or did. Circumstantial evidence is proof of one or more facts from which you could find another fact. You should consider both kinds of evidence. The law makes no distinction between the weight to be given to either direct or circumstantial evidence. It is for you to decide how much weight to give to any evidence.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 16**  
**GENERAL INSTRUCTIONS AFTER CLOSE**  
**CREDIBILITY OF WITNESSES**

In deciding the facts in this case, you may have to decide which testimony to believe and which testimony not to believe. You may believe everything a witness says, or part of it, or none of it.

In considering the testimony of any witness, you may take into account:

1. The opportunity and ability of the witness to see or hear or know the things testified to;
2. The witness' memory;
3. The witness' manner while testifying;
4. The witness' interest in the outcome of the case and any bias or prejudice;
5. Whether other evidence contradicted the witness' testimony;
6. The reasonableness of the witness' testimony in light of all the evidence; and
7. Any other factors that bear on believability.

The weight of the evidence as to a fact does not necessarily depend on the number of witnesses who testify.

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 17  
GENERAL INSTRUCTIONS AFTER CLOSE  
OPINION EVIDENCE

You have heard testimony from persons who, because of education or experience, are permitted to state opinions and the reasons for their opinions.

Opinion testimony should be judged just like any other testimony. You may accept it or reject it, and give it as much weight as you think it deserves, considering the witness' education and experience, the reasons given for the opinion, and all the other evidence in the case.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 18**  
**GENERAL INSTRUCTIONS AFTER CLOSE**  
**CHARTS AND SUMMARIES NOT RECEIVED IN EVIDENCE**

Certain charts and summaries that have not been received in evidence have been shown to you in order to help explain the contents of books, records, documents, or other evidence in the case. They are not themselves evidence or proof of any facts. If they do not correctly reflect the facts or figures shown by the evidence in the case, you should disregard these charts and summaries and determine the facts from the underlying evidence.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 19**  
**GENERAL INSTRUCTIONS AFTER CLOSE**  
**CHARTS AND SUMMARIES IN EVIDENCE**

Certain charts and summaries have been received into evidence to illustrate information brought out in the trial. Charts and summaries are only as good as the underlying evidence that supports them. You should, therefore, give them only such weight as you think the underlying evidence deserves.

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**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 20  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
DESCRIPTION OF A PATENT**

A patent is a document issued by the United States Patent Office that consists of a specification; a claim or claims, which are part of the specification; a drawing; and an oath supplied by the applicant. A drawing is required when it is necessary to understand the subject matter sought to be patented. The oath requires the applicant to swear that he or she is the original and first and true inventor of that for which the applicant seeks the patent.

The specification is essentially a description of the invention. The law requires that the specification of a patent give a written description of the invention that is clear, concise and exact, so that a person skilled in the art to which the patent pertains could make and use the invention.

The specification must conclude with one or more claims. The claims are numbered paragraphs which define, in words, the inventor's rights by marking the limits or boundaries of the invention claimed to have been invented. The claims of the patent must define the particular thing stated to have been invented with precision so that the public will know what that thing is, and so be able to avoid infringing the patent.

The claims are also important because only the claim of a patent can be infringed. Each of the claims must be considered individually. The law permits a patent owner to define his or her invention in more than one way in order to permit him or her to adequately protect his or her contribution to the art to which his or her invention pertains. Each claim is presumed to be valid independent of the validity of the other claims in the patent. It takes infringement of only one claim

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of a patent for the patent to be infringed.

In this case, plaintiff contends that the defendant infringed upon claim numbers 1, 2, 5, 7-9, 11-13, and 15-17 of the '159 Patent.

Authority: 35 U.S.C. §§ 111-113, 115; *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Sterner Lighting, Inc. v. Allied Electrical Supply, Inc.*, 431 F.2d 539 (5th Cir. 1970), *cert. denied*, 401 U.S. 909 (1971); adapted from the charge of Judge Martin in *Construction Technology, Inc. v. Lockformer Co.*, 86 Civ. 0457, 88 Civ. 0742 (S.D. N.Y. 1991); Modern Federal Jury Instructions - Civil.

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PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 21  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
SUBJECT MATTER OF CLAIMS

The phrase which is used from time to time in these instructions, "the subject matter of the patent in suit," means that which is covered by the claims of the patent, or that which falls within the scope of legal protection.

Authority: Adapted from *Electronic Data Systems Corp. v. Sigma Systems Corp.*, CA No. 73-1676 (N.D. Tex. 1973) *aff'd*, 500 F.2d 241, 183 U.S.P.Q. 327 (5th Cir.), *cert. denied*, 184 U.S.P.Q. 129 (1974).

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 22  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
FUNCTION OF THE CLAIMS

The subject matter of the claims may describe a product or device, sometimes called a "product claim" or an "apparatus claim," or a method of achieving a particular result, sometimes called a "method claim."

Claims 1, 2, 5, 7-9, 11-13, and 15-17 of the '159 Patent are "product" or "apparatus" claims.

There are no claims in the '159 Patent that take the form of "method" claims.

Authority: Adapted from *Regents of the University of Michigan v. Learjet*, CA 87-1719 PHX SMM (D.C. Ariz. 1991).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 23**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**DEPENDENT AND INDEPENDENT CLAIMS**

There are two different types of patent claims. The first type is called an independent claim. An independent claim does not refer to any other claim of the patent. An independent claim must be considered separately and without regard to any other claim because an independent claim, by itself, defines a separate invention. Claims 1 and 17 of the '159 Patent asserted against defendant are independent claims.

On the other hand, a dependent claim includes a reference to another claim in the patent. A dependent claim incorporates all of the limitations or words of the claims to which the dependent claim refers. Thus, for each dependent claim at issue, you must consider all of the limitations in the other claims from which it depends when resolving the question of infringement or invalidity. Claims 2, 5, 7-9, 11-13, and 15-16 of the '159 Patent are dependent claims.

Authority: Adapted from AIPLA Guide, p. 9; 35 U.S.C. § 112; *Fromson v. Advance Offset Plate, Inc.*, 720 F.2d 1565, 1570 (Fed. Cir. 1983); *Shatterproof Glass Corp. v. Libbey Owens Ford Co.*, 758 F.2d 613, 625, 626 (Fed. Cir. 1985); *Kloster Speed Steel AB v. Crucible, Inc.*, 793 F.2d 1565 (Fed. Cir. 1985).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 24**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**PATENTEE NEED NOT DISCLOSE EVERY**  
**EMBODIMENT COVERED BY THE CLAIMS**

The claims of a patent are not limited to the particular element of the invention described in the patent specification. The patent laws require that the patent specification and drawings teach one skilled in the art how to practice the invention and disclose to one skilled in the art the best way known to the inventor of practicing the invention. The patent laws do not require that the applicant describe in the specification every conceivable and possible future embodiment of the invention. This would be impossible. Accordingly, the claims of a patent are not limited to the preferred embodiment of the invention described in the patent specifications and drawings.

Authority: Adapted from *Micro Motion v. Exac*, 686 F.Supp. 789, 5 U.S.P.Q. 2d 1957 (N.D. Cal. 1987), *aff'd*, 876 F.2d 1574, 11 U.S.P.Q.2d 1070 (Fed. Cir. 1989).

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 25  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
COMBINATION CLAIM

A combination claim is a claim composed of two or more old or new elements which in combination produce new, different, or additional functions as compared with those previously performed or produced. In a combination claim, it is not necessary that there exist any single element that is in itself new. The invention may be found to reside in a new combination or arrangement of individually old and well-known elements.

Authority: 35 U.S.C. 101 *et. seq.*; *Kinnerar-Weed Corp. v. Humble Oil and Refining Co.*, 150 F.2d 143 (E.D. Tex. 1956), *aff'd*, 259 F.2d 398 (5th Cir. 1958), *reh. den.*, 266 F.2d 352, *cert. denied* 361 U.S. 903, 4 L.Ed.2d 158 (1959); *Leeds & Catlin Co. v. The Victor Talking Machine Co.*, 213 U.S. 325, 53 L.Ed. 816 (1909).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 26**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**THE TERM "COMPRISING" MEANS OPEN-ENDED**

Several of the patent claims in suit, including claims 1, 2, 13 and 17 of the '159 Patent, use the term "comprising" or "comprised." For example, claim 1 of the '159 Patent begins with the phrase "[a] gas-fired artificial logs and coals-burner assembly for fireplace comprising." In a patent claim, "comprising" is interpreted the same as "including" or "containing," that is, "comprising" means that the claims are open-ended. As such, the claims are not limited to only the components or parts recited in the claims. Based on this explanation, if you find that defendant's product includes all of the components, parts or steps in any one of plaintiff's patent claims and, in addition, defendant's product includes additional components or parts or steps, defendant's product still infringes the claim. The presence of additional components or functions in the accused product does not mean that the product does not infringe a patent claim. Infringement cannot be avoided by adding features or functions beyond those set forth in the claims. Infringement cannot be avoided by the mere fact that the accused device may be more or less efficient or performs additional functions.

Authority: Adapted from *Wang Laboratories v. Toshiba Corp.*, 26 U.S.P.Q.2d 1767 (E.D. Va 1992);  
*Dragan v. Caulk*, 12 U.S.P.Q.2d 1081 (D. Del. 1989).

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 27  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
MEANS CLAIM

Where claims in plaintiff's patent define a component of the invention as a means for doing something, such as in Claim 1 which includes the language "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube," the claimed element must be interpreted to cover the corresponding structure, material, or acts described in the patent specification, as well as any equivalent structure, material, or acts for that element. In other words, the "means plus function" element is not limited to the particular structure disclosed in the specification, but includes equivalent elements which perform the same function as the structure described in the patent specification.

Patentees are not required to disclose or predict every possible means of accomplishing the function set forth in the "means plus function" limitation. The patent laws were written precisely to avoid a holding that a means plus function limitation must be read as covering only the structure disclosed in the specification.

In contrast, elements which do not contain a "means plus function" limitation are to be construed consistent with the specification and as they would be construed by those of ordinary skill in the art.

Authority: Adapted from *Beckman Instruments v. LKB Produkter AB*, 703 F.Supp. 408, 8 U.S.P.Q.2d 1065 (D. Md. 1988), *aff'd in part, vac'g in part, rem'g* 892 F.2d 1547, 13 U.S.P.Q.2d 1301 (Fed. Cir. 1989).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 28**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**RIGHTS AS AN ASSIGNEE**

In this case, the relevant patent obtained by the inventor Golden Blount was assigned to the plaintiff Golden Blount, Inc.. As an assignee of the invention, Golden Blount, Inc. holds the same rights and interests in the patent as were held by the inventor. Golden Blount, Inc. therefore holds the patent, subject to all defenses of unenforceability and invalidity which could have been raised against the inventor.

Authority: 35 U.S.C. § 261; Modern Federal Jury Instructions - Civil, ¶ 86.01.

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**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 29**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**BURDEN OF PROOF**

As I instructed you earlier, there are two burden of proof standards by which you must weigh the evidence in this case: preponderance of the evidence and clear and convincing evidence.

As I informed you earlier, to establish a fact by a preponderance of the evidence means to prove that the fact is more likely true than not true. A preponderance of the evidence means the greater weight of the evidence. It refers to the quality and persuasiveness of the evidence, not to the number of witnesses or documents. In determining whether something has been proved by a preponderance of the evidence, you may consider the relevant testimony of all witnesses, regardless of who may have called them, and all the relevant exhibits received in evidence, regardless of who may have produced them. Plaintiff has the burden of establishing infringement of the claims of their patent by a preponderance of the evidence.

If you find that the credible evidence on a given issue is evenly divided between the parties -- that it is equally probably that one side is right as it is the other side is right -- then you must decide that issue against the party having this burden of proof. That is because the party bearing this burden must prove more than a simple equality of evidence -- he or she must prove the element at issue by a preponderance of the evidence. On the other hand, the party with this burden of proof need prove no more than a preponderance. So long as you find that the scales tip, however slightly, in favor of the party with this burden of proof -- that what the party claims is more likely true than not true -- then that element will have been provided by a preponderance of the evidence.

As I told you earlier, clear and convincing proof is so strong that it leaves no substantial doubt in your mind. It is proof that establishes in your mind, not only that the proposition at issue is probable, but also that it is highly probable. It is enough if the party with the burden of proof establishes its claim beyond any "substantial doubt"; the party does not have to dispel every "reasonable doubt." Clear and convincing evidence is a more exacting standard than proof by a preponderance of the evidence, where you need believe only that the party's claim is more likely true than not true. On the other hand, clear and convincing proof is not as high a standard as the burden of proof applied in criminal cases, which is proof beyond a reasonable doubt.

In patent cases such as this one, the alleged infringer has the burden of establishing that the patent was invalid by clear and convincing evidence. The burden of clear and convincing evidence placed upon the alleged infringer in establishing invalidity is a much stricter burden than the preponderance of the evidence burden placed upon the patent holder in establishing infringement.

Other facts beyond that of invalidity, must be established by clear and convincing evidence. For example, willful infringement, which I will discuss in more detail in a moment, also must be proven by clear and convincing evidence.

Authority: 35 U.S.C. § 282; *Symbol Technologies, Inc. v. Opticon, Inc.*, 935 F.2d 1569 (Fed. Cir. 1991); *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1238 (Fed. Cir.), *cert. denied*, 493 U.S. 853 (1989); *Smithkline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878 (Fed. Cir. 1988); *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613 (Fed. Cir.) *cert. denied*, 474 U.S. 976 (1985); Modern Federal Jury Instructions - Civil.

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 30  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
INFRINGEMENT - INTRODUCTION

Plaintiff claims that the defendant has infringed its patent.

Any person or business entity which makes, uses, offers for sale or sells, without the owner's permission, any product or apparatus legally protected by at least one claim of a patent within the United States before the patent expires, infringes the patent. There are three ways to infringe a patent. One may:

1. Directly infringe a patent;
2. Induce others to infringe a patent, in which case the inducer is liable for infringement in the same way as a direct infringer; or
3. Contribute to the infringement of a patent by another by supplying a component specially designed for the invention, in which case the contributory infringer will be liable for patent infringement the same way as the direct infringer.

Plaintiff alleges that defendant has directly infringed claims 1, 2, 5, 7-9, 11-13, and 15-17 of the '159 Patent by making, using, offering for sale and selling defendant's Ember Flame Booster.

Plaintiff also alleges that defendant has induced others to infringe and contributorily infringed by selling defendant's Ember Flame Booster to them and instructing them how to use the device.

Authority: 35 U.S.C. § 271; Modern Federal Jury Instructions - Civil, ¶ 86.02.

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 31  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
CLAIM CONSTRUCTION

To decide the questions of infringement and validity, you must first understand what the claims of the patent cover, that is, what they prevent anyone else from doing. It is my function, as a matter of law, to tell you how the claims are to be interpreted. You are to follow the interpretation I give you to decide whether one or more of the defendant's devices infringe the claims, as I have construed them.

Authority: *SmithKline Diagnostics, Inc. v. Helena Labs. Corp.*, 859 F.2d 878, 8 U.S.P.Q.2d 1468 (Fed. Cir. 1988); *Structural Rubber Prods. Co. v. Park Rubber Co.*, 749 F.2d 707, 223 U.S.P.Q. 1264 (Fed. Cir. 1984); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 34 U.S.P.Q.2d 1321 (Fed. Cir. 1995).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 32**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**TWO TYPES OF DIRECT INFRINGEMENT; LITERAL INFRINGEMENT**

There are two ways in which a patent claim can be directly infringed. First, a claim can be literally infringed. Second, a claim can be infringed under what is called the "doctrine of equivalents," which I will address shortly after I explain literal infringement.

To determine literal infringement, you must compare the accused product with each claim that plaintiff asserts is infringed, using my instructions as to the meaning of the patent claims.

A patent claim is literally infringed only if defendant's product includes each and every element in that patent claim. If defendant's product does not contain one or more elements recited in a claim, defendant does not literally infringe that claim. You must determine literal infringement with respect to each patent claim individually, following the construction I have provided on what the claim means in law.

You must be certain to compare defendant's accused product with each claim it is alleged to infringe. It should be compared to the inventions described in the patent claim, not to plaintiff's preferred or commercial embodiment of the claimed invention.

Authority: *Martin v. Barber*, 755 F.2d 1564, 1567, 225 U.S.P.Q. 233, 234-35 (Fed. Cir. 1985); *Amstar Corp. v. Envirotech Corp.*, 730 F.2d 1476, 1484, 221 U.S.P.Q. 649, 655 (Fed. Cir.), cert. denied, 469 U.S. 924 (1984); *Mannesmann Demag Corp. v. Engineered Metal Prods. Co.*, 793 F.2d 1279, 1281-82, 230 U.S.P.Q. 45, 46 (Fed. Cir. 1986).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 33**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**LITERAL INFRINGEMENT OF MEANS PLUS FUNCTION CLAIMS**

I have previously instructed you that claims 1, 2, 13, 15, & 17 of the '159 Patent are a special form called means plus function. Literal infringement of a means plus function claim is shown if plaintiff can prove by a preponderance of the evidence that the function recited in each element of the claim is identically performed in the accused device, and the structure in the accused device which performs that function is the same or the equivalent of the structure disclosed in the patent for performing the function of that element of the claim.

Equivalent structure is defined as one which performs the function recited in the element of the claim in substantially the same way. What constitutes equivalency in this sense can be determined from the patent, the teaching of the prior art and the circumstances of the case. Equivalence in patent law is not determined by a rigid formula, and it is not considered in a vacuum. It does not require complete identity for every purpose and every respect. You must consider the reason the means was put in the invention at the start and the function it is intended to perform. A factor for your consideration is whether or not persons skilled in the art would consider the support means, connection means, gas flow control means, and grate support means in the patent, and the support means, connection means, gas flow control means, and grate support means of defendant's device to be interchangeable and still perform the same function.

Authority: Adapted from *Ivac Corp. v. Terumo Corp.*, 18 U.S.P.Q.2d 1637 (S.D. Cal. 1990); *DMI*

*Inc. v. Deere & Co.*, 225 U.S.P.Q.2d 236 (Fed. Cir. 1985), *aff'd*, 802 F.2d 421 (1986).

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**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 34**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**DOCTRINE OF EQUIVALENTS**

You may find that defendant's product infringes a claim of plaintiff's patent, even if not every element of that claim is literally present in defendant's product. To do so, you must find that there is an equivalent component or part in defendant's product for each element of the patent claim that is not literally present in the defendant's product. This is called infringement under the doctrine of equivalents. It is your job to make this factual determination.

Under the doctrine of equivalents, you may find infringement if the plaintiff establishes by a preponderance of the evidence that such product contains elements identical or substantially equivalent to each element of the patented invention.

In order to make such a finding under the doctrine of equivalents, you must find that there are not substantial differences between the elements of the patented product and the elements of the alleged infringing product. In this regard, you may consider whether the defendant's element performs (1) substantially the same function (2) in substantially the same way (3) to produce substantially the same result when compared to the plaintiff's element, even though they may differ in name, shape or form.

An accused product does not infringe under the doctrine of equivalents if its elements perform the function and achieve the result in a substantially different way than the claimed invention.

The doctrine of equivalents does not involve the application of a formula and is not an

absolute to be considered in a vacuum. Rather, the question of whether one or more component of the allegedly infringing device are equivalent to elements in the patented claim is a factual matter. It requires you to consider the context of the entire claim. You should view the evidence from the perspective of a person of ordinary skill in the art, that is, whether a person of ordinary skill in the art would have considered the differences insubstantial. Your answer will depend upon the drawings and written description, the patent application history, the prior art and all the circumstances of this case. All of this you should consider as questions of fact.

Authority: *Werner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S. Ct. 1040, 137 L.Ed.2d 146 (1997); *Graver Tank & Manufacturing Co. v. Linde Air Products Co.*, 339 U.S. 605, 70 S.Ct. 854, 90 L.Ed. 1097 (1950); Modern Federal Jury Instructions - Civil, ¶ 86-02.

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**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 35**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**INFRINGEMENT OF OPEN ENDED OR "COMPRISING" CLAIMS**

When you analyze infringement, bear in mind that the presence of additional components of steps or additional functionality in defendant Robert H. Peterson Co.'s product does not mean that the defendant's product does not infringe a patent claim. The term "comprising" permits the inclusion of other elements or materials in addition to the elements or components specified in the claims. As such, the claims are not limited to only the components or parts recited in the claims. Therefore, if you find that defendant's product includes all of the components of any of the claims of the patent in suit and, in addition, includes additional components or additional functionality, the product still infringes such claim or claims. One cannot avoid patent infringement by doing more than is required by a patent's claims.

Authority: Adapted from AIPLA Guide, p. 13; Dow Chemical Co. v American Cyanamid Co., 908 F. 2d 931, 945 (Fed. Cir. 1990), cert. denied, 11 S. Ct. 296 (1990).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 36**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**INFRINGEMENT DESPITE DEFENDANT'S IMPROVEMENTS**

You may find that defendant's Ember Flame Booster represents an improvement over one or more of the inventions defined in the claims of the '159 Patent. However, as long as defendant's accused product includes all of the elements of at least one of the claims of the '159 Patent, or if defendant's product is found to be equivalent under the doctrine of equivalents to the invention defined in one or more of the claims of the '159 Patent, then that claim is infringed by defendant's product, despite the existence of such improvements.

Authority: AIPLA Guide, p. 17; Atlas Powder Co. v. E. I. DuPont de Nemours & Co., 750 F. 2d 1569, 1580-81 (Fed. Cir. 1984).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 37**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**INCLUSION OF ADDITIONAL NON-CLAIMED ELEMENTS DOES NOT AVOID**  
**INFRINGEMENT**

Similarly, a product which is capable of an infringing use or can reasonably be used in an infringing manner must be considered by you to be an infringement, even if the product is not always operated in an infringing manner. This means, for example, if you find, by a preponderance of the evidence, that under at least some conditions, the use of the Ember Flame Booster satisfies all the elements of any claim, you must find that claim infringed.

Authority: Adapted from FMC Corp. v. H. & K. Machine, 718 F. Supp. 1403, 12 U.S.P.Q.2d 1554 (D. Wisc. 1989), aff'd, 15 U.S.P.Q.2d 1830 (Fed. Cir. 1990); Bell Comm. Research v. Vitalink Comm. Corp., 55 F. 3d 615 (Fed. Cir. 1995).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 38**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**CONTRIBUTORY INFRINGEMENT**

A second form of indirect infringement is contributory infringement. Plaintiff also alleges that contributory infringement has occurred with respect to the device claims. Contributory infringement of a device claim is established when one offers for sale a component of a device which may be and ordinarily is used and is sold with intention of being used as a component of the claimed device. That is, the plaintiff must establish that a component for use with the claimed device was sold, and that the seller knew that the component was especially made for that purpose and not a staple article suitable for a substantial noninfringing use. To establish contributory infringement, plaintiff must prove the following by a preponderance of the evidence:

1. That defendant Robert H. Peterson Co. sold or supplied a product;
2. That the product sold or supplied by defendant is not a staple article of commerce capable of a substantial non-infringing use;
3. That defendant sold or supplied the product with knowledge that the product was made for use as a component of the claimed device; and
4. That the product is actually assembled by another to infringe the claim.

In determining whether defendant's product is a staple article, you may consider whether there is evidence of an established trade in the article for uses which do not infringe the patent in question, that is that the product of Robert H. Peterson Co. is actually sold for some other purpose

than an infringing purpose.

Proof of contributory infringement may be based on circumstantial evidence you have heard in this case, rather from direct evidence of infringement.

Authority: 35 U.S.C. § 271(c); adapted from Johns Hopkins University v. CellPro, 894 F. Supp. 819, 836 (D. Del. 1995)

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JT-APP 0242

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 39**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**INDUCING INFRINGEMENT**

Plaintiff also contends that the defendant is liable because the defendant actively induced infringement of the patent claims by another person.

I instruct you that whoever induces infringement of a patent is liable as an infringer. In order to find that the defendant is liable for inducing infringement, plaintiff must prove by a preponderance of the evidence each of the following elements:

1. The accused product infringed one or more of plaintiff's claims;
2. That the defendant actively induced the infringement; that is, that the defendant knowingly induced the infringement. In other words, it is the plaintiff's burden to prove by a preponderance of the evidence that the defendant intended that his actions would induce actual infringement by someone else. It does not matter whether the defendant actually knew the someone else who ultimately acted to infringe.

Proof of inducing infringement and the underlying direct infringement by persons allegedly induced to infringe may be based on circumstantial evidence you have heard in this case, rather than from direct evidence of infringement.

Authority: 35 U.S.C. § 271(b); Water Technologies Corp. v. Calco, Ltd., 850 F. 2d 660 (Fed. Cir.), cert. denied, 488 U.S. 968 (1988); Ninth Circuit Model Civil Jury Instruction 16.04.04; Johns Hopkins University v. CellPro, 894 F. Supp. 819, 835-836 (D. Del. 1995); Modern Federal Jury Instructions - Civil.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 40**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**WILLFUL INFRINGEMENT - - GENERAL**

In this action, plaintiff asserts that any infringing acts that defendant Robert H. Peterson Co. may have committed were acts of willful infringement of the '159 Patent. You must determine both if defendant has infringed any of the claims of the patent, and, if so, whether it was willful infringement. I will now instruct you on how to determine if infringement is willful.

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JT-APP 0244

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 41**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**WILLFUL INFRINGEMENT: TOTALITY OF CIRCUMSTANCES - SPECIAL FACTORS**

A potential infringer with knowledge of a patent has an affirmative duty to exercise due care to determine whether it is infringing valid patent rights before initiating or continuing its potentially infringing activity. The test to be applied is whether, under all the circumstances, a reasonable person would prudently conduct himself with confidence that a court might hold the patent invalid or not infringed.

Several factors have been viewed as having special significance in this inquiry. These include: whether the infringer deliberately copied the ideas or design of another, whether the infringer, when he knew of the other's patent protection, timely investigated the scope of the patent and formed a good faith belief that the patent was invalid or that it was not infringed; and the infringer's behavior as a party to the litigation. Copying, for the purposes of the willfulness analysis, does not require an identical copy. If you find that defendant Robert H. Peterson Co. based the Ember Flame Booster design on plaintiff's secondary coals burner of the '159 Patent, then you may find that defendant copied.

Authority: *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 1428 (Fed. Cir. 1988); *Rolls-Royce Limited v. GTE Valeron Corp.*, 800 F.2d 1101, 1110 (Fed. Cir. 1986); *Power Lift, Inc. v. Lang Tools, Inc.*, 774 F. 2d 478, 481 (Fed. Cir. 1985); *Stickle v. Heublein, Inc.*, 716 F. 2d 1550, 1565 (Fed. Cir. 1983); *Central Soya Co. v. Geo. A. Hormel & Co.*, 732 F. 2d 1573, 1576-1577 (Fed. Cir. 1983); *Lam, Inc. v. Johns-Manville Corp.*, 668 F. 2d 462, 475 (Fed. Cir. 1982), cert. denied, 456 U.S. 1007 (1982); *Milgo Electronic v. United Bus. Communications*, 623 F. 2d 645, 666 (10<sup>th</sup> Cir.) cert. denied, 449 U.S. 1066 (1980); *Bott v. Four Star Corp.*, 807 F. 2d 1567, 1572 (Fed. Cir. 1986).

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JT-APP 0245

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 42**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**WILLFULNESS: LEGAL ADVICE OR OPINION**

The affirmative duty required of a potential infringer may include, among other things, the duty to seek and obtain legal advice from a competent patent attorney regarding its possible infringing activity.

Such an opinion must be based on more than mere conclusory and unsupported statements. The following factors may be considered in determining whether such an opinion is adequate:

1. Whether the opinion was given by an attorney whom defendant Robert H. Peterson could reasonably have believed was competent and knowledgeable in the field;
2. Whether the opinion was based upon review of the patent file history;
3. Whether the invalidity opinion contains an analysis of the prior art in connection with the patent claims;
4. Whether any infringement opinion contains a comparison between the patent claims and the accused product;
5. Whether the conclusions reached are based upon an accurate view of the facts;
6. Whether the opinion was requested and/or obtained in a timely fashion;
7. Whether the opinion was a formal written opinion, or just an informal oral opinion.

Authority: Rite-Hite Corp. v. Kelley Co. Inc., 819 F. 2d 1120, 1125 (Fed. Cir. 1987); Underwater Devices Inc. v. Morrison-Knudson Co., 717 F. 2d 1380, 1389-90 (Fed. Cir. 1983); Del Mar

Avionics, Inc. v. Quinton Instrument Co., 836 F. 2d 1320, 1328 (Fed. Cir. 1987); McDermott v. Omid International Inc., 723 F. Supp. 1228, 1233 (S. D. Ohio 1988), aff'd, 883 F. 2d 1026 (Fed. Cir. 1989); Spindelfabrik Suessen-Schurr v. Schubert & Salzer, 829 F. 2d 1075, 1084 (Fed Cir. 1987); Minnesota Mining and Mfg. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1580 (Fed. Cir. 1992).

PLAINTIFF'S PROPOSED  
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JT-APP 0247

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 43**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**WILLFULNESS - - RELIANCE**

Only opinions of counsel upon which defendant Robert H. Peterson Co. actually relied on in good faith may be considered when determining whether they willfully or intentionally infringed the '159 Patent. Opinions which defendant obtained merely to ratify its alleged non-infringement of the patent must be disregarded.

While an opinion of counsel is evidence to be weighed toward a determination of good faith, it is not conclusive. It is necessary to look at the totality of the circumstances presented in the case when determining willful infringement, including the timing, competence, and completeness of the advice of counsel, and also whether it was a written or oral opinion.

Authority: Kloster Speed Steel AB v. Crucible Inc., 793 F. 2d 1565, 1578 (Fed. Cir. 1986); Central Soya Co., Inc. v. Geo A. Hormel & Co., 723 F. 2d 1573, 1576-1577 (Fed. Cir. 1983); Modine Manufacturing Co. v. Allen Group, Inc., 14 U.S.P.Q.2d 1210, 1217 (N.D. Cal. 1989); H.B. Fuller Co. v. National Starch and Chemical Corp., 689 F. Supp. 923, 952-953 (D. Minn. 1988); Berger & Gorin, Inc. v. Gary Plastic Packaging Corp., 691 F. Supp. 740, 752 (S. D. N. Y. 1988); Shiley, Inc. v. Bentley Laboratories, Inc., 601 F. Supp. 964, 968 (C.D. Cal. 1985) aff'd 794 F. 2d 1563, 1568 (Fed. Cir. 1986).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 44**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**THE PRESUMPTION OF VALIDITY**

If you find that plaintiff has established by a preponderance of the evidence that defendant Robert H. Peterson Co. infringed one or more claims, you must then determine if the patent is valid. Any patent granted by the Patent and Trademark Office is presumed, under the patent laws, to be valid, and any person challenging the validity of a patent bears the burden of proving facts showing invalidity of the patent by clear and convincing evidence, as I have previously defined that term to you. This is known as the "presumption of validity."

The reason for the presumption of validity of an issued patent is that the law presumes that the Patent Office has properly discharged its duty. A patent can be obtained only after the consideration of the patent application by the United States Patent Office. Deference must be given to the Patent Office as a qualified government agency that is presumed to have properly done its job. The patent examiners are experts in interpreting the references and are familiar from their work with the level of skill in the art. An Examiner's duty is to issue only valid patents after they are satisfied that an application sets forth an invention in a manner which fully complies with all of the legal prerequisites for patentability.

This presumption means that the subject matter claimed in the '159 Patent is presumed to be new, useful, and not obvious to a person having ordinary skill in the art, at the time the invention or discovery was made, and that all other requirements necessary to obtain a patent have been met. Moreover, each claim of the '159 Patent is presumed valid, independent of every other claim in that

patent, until it is proven otherwise. These presumptions can be overcome only by a showing of clear and convincing evidence to the contrary.

Authority: 35 U.S.C. § 282; *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F. 2d 1530, 1534 (Fed. Cir. 1983); *Kaufman Co. v. Lantech, Inc.*, 807 F. 2d 970, 973 (Fed. Cir. 1986); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.* 802 F. 2d 1367, 1375 (Fed. Cir. 1986); *N. V. Akzo, Aramide Maatschappij v.o.f. v. E.I. DuPont De Nemours*, 808 F. 2d 1471, 1479 (Fed. Cir. 1986); *T.P. Laboratories, Inc. v. Professional Positioners, Inc.*, 724 F. 2d 965, 971 (Fed. Cir. 1984), cert. denied, 105 S. Ct. 108 (1984); *Blonder-Tongue Laboratories v. University of Illinois Foundation*, 402 U.S. 313, 335 (1971); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F. 2d 1555, 1574 (Fed. Cir. 1992); *American Hoist & Derrick Co. v. Sowa & Sons*, 725 F. 2d 1350, 1359 (Fed. Cir. 1984).

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**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 45  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
PRESUMPTION OF VALIDITY -- BURDEN OF PROOF**

As a result of the presumption of validity, defendant Robert H. Peterson Co., when asserting invalidity of a claim of the '159 Patent, must show by clear and convincing evidence that the Patent Office acted erroneously in issuing that claim.

On the other hand, as the result of this presumption of validity, plaintiff has no burden of proof with respect to validity. Plaintiff must come forward with evidence, if at all, only if defendant has put before you clear and convincing evidence of invalidity.

The presumption of patent validity, and defendant's burden to overcome that presumption by clear and convincing evidence, are constant. Neither the burden of persuasion nor the presumption of validity are affected, for example, by the presentation of prior art that was not considered by the Patent Office.

The presumption of validity of the '159 Patent is a requirement which places upon defendant the burden of coming forward with clear and convincing evidence of facts, which if established, might show that the patent is invalid. The presumption of validity in itself is not evidence.

If defendant presents art that was before the Patent Office, deference should be given to the Patent Office's decision to issue the patent, but no such deference is due to prior art that the Patent Office did not consider. However, if the new prior art is merely cumulative to, or the same as, the prior art that the Patent Office did consider, then the same deference is due to the Patent Office's

determination. Therefore, when you consider the prior art which was not before the Patent Office, you should compare it with the prior art before the Patent Office and then determine what weight to give the Patent Office's determinations.

Authority: *Carella v. Starlight Archery and Pro Line Co.*, 804 F. 2d 135, 138 (Fed. Cir. 1986); *American Hoist & Derrick Co. v. Sowa & sons, Inc.*, 725 F. 2d 1350, 1360 (Fed. Cir. 1984); *ACS Hosp. Sys., Inv. V. Montefiore Hosp.*, 732 F. 2d 1572, 1574-75 (Fed. Cir. 1984); *Lear Siegler, Inc. v. Aeroquip Corp.*, 733 F. 2d 881, 885 (Fed. Cir. 1984); *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F. 2d 1555, 1574 (Fed. Cir. 1992); *Mendenhall v. Cedarapdics, Inc.*, (Fed. Cir. 1993).

PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

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JT-APP 0252

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 46**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**SCOPE AND CONTENT OF PRIOR ART**

Several of defendant Robert H. Peterson Co.'s contentions of invalidity involve assertions based on "prior art." The term "prior art" as used in patent law, means knowledge that was in the possession of the public before the date of the invention.

The prior art potentially includes devices and materials similar to the invention, that were:

1. ~~Known or used by others in the United States before the date of invention by the inventors, wherein the term known or used requires knowledge or use by the general public; or~~
2. Patented or described by others in a printed publication in the United States or abroad before the date of invention; or
3. Patented or described in a printed publication in the United States or abroad more than one year prior to the effective filing date of the patent application; or
4. Publicly used or on sale in the United States more than one year prior to the effective filing date of the patent application; or
5. Described in another United States patent, the application of which was filed before the date of the invention.

Prior art in certain circumstances may be shown by oral testimony of witnesses, as well as by patents and publications. Oral testimony, however, concerning alleged prior art must be received and considered by you with special care. In considering such testimony, you should take into account the length of time that has passed since the alleged prior art was used, whether there are documents or

tangible support to corroborate the testimony, and whether the testifying witness has any bias or interest in this case. In some circumstances, not common, unsupported oral testimony can be sufficient to prove prior knowledge or use. However, unsupported oral testimony is to be regarded with suspicion and subjected to close scrutiny. The burden of proof is such that it must be "clear and convincing evidence", and not simply by a preponderance of the evidence.

Authority: *Kimberly-Clark Corp. v. Generation II & Generation II*, 745 F.2d 1437, 1453-54 (Fed. Cir. 1984); 35 U.S.C. § 102; *The Barbed Wire Patent*, 143 U.S. 275 (1891); *Carella v. Starlight Archery*, 804 F. 2d 135, 138-139 (Fed. Cir. 1986).

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IT-APP 0254

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 47  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
PRESUMPTION THAT CITED ART DOES NOT TEACH THE PATENT IN SUIT

The prior art patents and publications considered by the Patent Office are presumed not to teach the invention of that patent and therefore are presumed not to be invalidating printed publications. If defendant Robert H. Peterson Co. offers prior art which is no more pertinent than that considered by the Patent Office, then it has the burden of overcoming the presumption that the Patent Office properly did its job correctly.

If defendant offers prior art which is more pertinent than that which was considered by the Patent Office, it must prove by "clear and convincing evidence" that the claimed invention would have been obvious.

One prior art reference is more pertinent than another if it is more closely related to either the problem addressed by the invention or the elements of the invention.

Authority: Hewlett-Packard Co. v. Bausch & Lomb, Inc., 909 F. 2d 1464, 1467 (Fed. Cir. 1990); Kaufman Company, Inc. v. Lantech, Inc., 807 F. 2d 970, 973 (Fed. Cir. 1986); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F. 2d 1367, 1375 (Fed. Cir. 1986); Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571 (Fed. Cir. 1986).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 48**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**DIFFERENCES OVER THE PRIOR ART**

You must consider the differences between each claim of each patent in suit and the prior art. Each claim must be considered in its entirety and separately from the other claims. Although it is proper for you to consider the differences between the claimed invention and the prior art, you must not consider those differences as though they were the essence of the invention; the test is whether the claimed invention as a whole would have been obvious to one of ordinary skill over all of the prior art.

Even though there may be superficial similarities between the claimed subject matter and the prior art, a patentable invention may be present when none of the prior art achieved the critical result achieved by the invention of the patent in suit.

Authority: AIPLA guide, p. 29; *Graham v. John Deere*, 383 U.S. 1, 17, 15 L. Ed.2d 545, 556 (1966); *Gillette Co. v. S.C. Generation II & Son, Inc.*, 919 F.2d 720, 724 (Fed. Cir. 1990); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F. 2d 1367, 1383 (Fed. Cir. 1986); *Santa Fe-Pomeroy, Inc. v. P&Z Co.*, 569 F. 2d 1084, 1095 (9th Cir. 1978).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 49**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**INVALIDITY - LACK OF NOVELTY**

Defendant Robert H. Peterson Co. argues that the patented claim is invalid because it lacks novelty because the patented claim was anticipated by prior art. In order to prevail on this defense, the defendant must prove anticipation by clear and convincing evidence.

In order for a potential claim to have been anticipated, you must find that the earlier invention completely embodied the same product as the patented claim and that all of the elements recited in the patented claim were previously found in exactly the same situation and united in the same way to perform the identical function. Put another way, each and every element of the patented claim must have been either inherent or expressly disclosed in a single prior invention or in a single prior art reference.

You may not combine two or more items of prior art to establish anticipation.

If these requirements have not been met, then the patented claims are not invalid by reason of anticipation.

By contrast, if these requirements have been met, you should next consider whether the defendant has satisfied its burden of proving how the patented claims were anticipated.

Authority: *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F. 2d 1565 (Fed. Cir. 1991); *Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226 (Fed Cir. 1989) ; *Constant v. Advanced Micro Devices, Inc.*, 848 F.2d 1560 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); *Tights, Inc. v. Acme-McCrary Corp.*, 541 F. 2d 1047 (4th Cir.), cert. denied, 97 S.Ct. 493 (1976); *Roberts v. Sears, Roebuck & Co.*, 723 F.2d 1324 (7th Cir. 1983) (en banc); Modern Federal Jury Instructions - Civil.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 50**

PLAINTIFF'S PROPOSED  
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JL-APP-0257

**SPECIFIC INSTRUCTIONS AFTER CLOSE  
PRINTED PUBLICATIONS**

Defendant claims that the patent previously appeared in a printed publication and therefore is invalid for lack of novelty.

I instruct you that if you find that the defendant has provided by clear and convincing evidence that the invention was described in a prior publication in this country or in a foreign country before it was invented by the patentee (or more than one year prior to the filing date of his application), then the patent is invalid.

There are three components to the prior publication that the defendant must prove.

First, that the publication occurred before the plaintiff invented the invention (or more than one year before plaintiff filed his application for the patent claim of the invention.)

Second, that the prior publication was at least reasonably available to at least some segment of the public. In this respect, it is not necessary that the prior publication be available to every member of the public. It must be available, without restriction, to that segment of the public most likely to avail itself of the publication's contents.

Finally, the prior publication must make a meaningful disclosure of the invention. To be meaningful, the disclosure must enable a person of ordinary skill in this art to understand the invention. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete,, enabling and meaningful, you should take into account what would have been within the knowledge of a person of ordinary skill in the art to make, construct and practice the invention.

Authority: 35 U.S.C. §§102(a), (b); Modern Federal Jury Instructions - Civil

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JT-APP 0259

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 51**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**NON-OBVIOUSNESS**

The defendant contends that the patent is invalid because the invention was "obvious."

I instruct you that a patent is invalid if the defendant establishes by clear and convincing evidence that the subject matter as a whole would have been obvious to a person of ordinary skill in the pertinent art at the time the invention was made.

The question of whether the invention was obvious ultimately is a question for me to decide. However, I will decide that question based upon whether you find the following facts to have been proved by clear and convincing evidence.

1. What was the scope and content of the prior art at the time the product was invented?
2. What the differences are between each claim of the patent and the prior art?
3. What was the level of ordinary skill in the prior art at the time the invention was made?
4. Whether there are secondary considerations that negate defendant's claim of obviousness?

Authority: *Graham v. John Deere Co.*, 383 U.S. 1, 86 S.Ct.684, 18 L.Ed 2d 545(1966); *B.F. Goodrich Co. v. Aircraft Braking Systems Corp.*, 72 F.3d 1577 (Fed. Cir. 1996); *Ryko Manufacturing Co. v. NuStar, Inc.*, 950 F.2d 714 (Fed. Cir. 1991); *Continental Can Co., U.S.A., Inc. v. Monsanto Co.*, 948 F. 2d 1264 (Fed Cir. 1991); *Panduit Corp. v. Dennison Manufacturing Co.*, 810 F.2d 1561 (Fed. Cir.), cert. denied, 481 U.S. 1052 (1987); *Modern Federal Jury Instructions - Civil*.

PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

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JT-APP 0260

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 52**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**DIFFERENCES BETWEEN PRIOR ART AND INVENTION**

In making your determination concerning obviousness, you must focus upon the total claimed invention. The claim should be read as a whole, not element by element, in order to determine whether the claimed invention is obviousness or unobvious. Your focus must be directed to the time at which the invention was made by the patentee.

In making your evaluation, hindsight is to be avoided. Obviousness, within the meaning of the patent law, does not mean that one skilled in the art can perceive the solution after it has been found and pointed out by someone else. The teaching of the '159 Patent cannot be used as a guide through the prior art references, combining them in the right way so as to achieve the results of the patent. This use of hindsight must be avoided.

Authority: Hybritech v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383-84 (Fed. cir. 986); Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 447-449 (Fed. Cir. 1986); Loctite Corp. v Ultraseal Ltd., 781 F.2d 861 874 (Fed. Cir. 1985); Interconnect Planning Corp. v Feil, 774 F.2d 1132, 1138-1139 (Fed. Cir. 1985); Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 1090-1096 (Fed. Cir. 1985), vacated on other grounds, 475 U.S. 809, 89 L.Ed.2d 817 (1986) and on remand 810 F.2d 1561, 1568 (Fed. Cir. 1987).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 53**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**LEVEL OF ORDINARY SKILL**

I have referred in these instructions to a person of ordinary skill in the art. What do I mean by such a person? The person of ordinary skill is a hypothetical person who is presumed to be one who is aware of all pertinent prior art. The skill of the actual inventor is irrelevant, because inventors may possess something which sets them apart from the workers of ordinary skill in the art.

In reaching your determination as to whether or not the claimed invention was obvious, you should consider the level of ordinary skill of one who works in the art of gas log fireplaces. The parties agree that a person of ordinary skill in the art at the time of the invention would have a variety of educational backgrounds with hands-on experience with gas log fireplaces. It is not necessary that such a person have a professional education such as an engineering degree. One can be a person of ordinary skill in the art even without formal schooling in this area, as long as that person has hands-on practical experience in the field of gas log fireplaces, although many skilled in the area are engineers.

When you decide the issue of obviousness, you are not deciding whether or not the Blount inventions were something obvious or not obvious to the inventor himself, but rather you must decide whether or not the invention would have been obvious to one having this ordinary level of skill in gas log fireplaces.

Authority: Adapted from *Medical Designs Inc. v. Medical Technology, Inc.*, 786 F.Supp 614, 625 (N.D. Tex, 1992); *Norbin Inc. v. International Machines Corp.*, 453 F.Supp. 1072 (D. Colo. 1978), aff'd, 625 F.2d 357 (10th Cir. 1980).

PLAINTIFF'S PROPOSED  
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JT-APP 0263

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 54  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
OBVIOUSNESS -- ANALOGOUS ART

Obviousness must be judged against the relevant or analogous art available "at the time the invention was made." You must determine whether the prior art offered by defendant Robert H. Peterson Co. is in fact analogous art.

To decide whether prior art in an analogous field is pertinent, you must first determine whether the prior art is from the same field of endeavor, regardless of the problem addressed by the prior art. If you find it is from the same field of endeavor, then it is analogous art to be considered in your obviousness determination. However, if you determine that the prior art is not within the field of endeavor of the inventor, you must then determine if the prior art was reasonably pertinent to the particular problem which the inventor Mr. Blount was confronted with. If the answer is "yes" then the art in question is analogous art to be considered in your obviousness determination.

Authority: 35 U.S.C. §103; *In re Clay*, 966 F.2d 656, 658-659 (Fed. Cir. 1992).

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JT-APP 0264

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 55  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
OBVIOUSNESS – "COMBINATION" INVENTION**

The fact that individual elements of a claimed combination invention may be old is neither dispositive nor controlling when you evaluate obviousness. The law, instead, requires that obviousness be determined by a consideration of the claimed invention as a whole. A valid patent may issue on a combination of old or known elements if the old or known elements are assembled or combined in such a way to produce a new combination, which would not have been obvious. Virtually all patents contain claims to inventions formed from combinations of previously known elements.

Authority: United States v. Adams, 383 U.S. 39, 51-52 (1966); Lear Siegler, Inc. v. Aeroquip Corp., 733 F.2d 881, 890 (Fed. Cir. 1984); Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1462 (Fed. Cir. 1984); Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1575 (Fed. Cir. 1987).

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 56  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
OBVIOUSNESS – NUMBER OF REFERENCES

Reliance on a number of prior art references may be an indication that the claimed invention is non-obvious. If you find that the number of references relied upon by defendant Robert H. Peterson Co. is large, you may use that finding as indicative of non-obviousness.

Authority: Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc., 298 F.2d 36, 38 (7<sup>th</sup> Cir. 1961); Bela Seating Co. v. Poloron Prods., Inc., 297 F.Supp. 489, 508 (N.D. Ill. 1968), aff'd 438 F.2d 733 (7<sup>th</sup> Cir.), cert. denied, 403 U.S. 922 (1971).

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 57  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
OBVIOUSNESS -- COMBINING REFERENCES

Obviousness may be based upon a combination of separate prior art references. Not all combinations of references, however, are proper.

To combine prior art references, they must include a clear suggestion, either expressly or by implication, for the combination of their teachings. If no clear suggestion of motivation for such combinations appears, the combination is improper and you may not base your consideration thereon.

Obviousness also must be determined from a consideration of the entire combination of each claim as a whole against the scope and content of the prior art at the time of the invention. Before you find any claim invalid based on obviousness, you must conclude that the entire combination of all steps of the claim were included or clearly suggested in the prior art. If a clear suggestion of motivation for combination appears in the prior art, you must then consider whether the claimed invention results in something more than the combination suggested. If so, the patent would not be obvious.

A combination of references is improper if an express statement that teaches away from a desired combination of references appears in one or more of the references sought to be combined. This is strong evidence of non-obviousness. A combination of references is also improper when the claimed invention recognizes and solves a problem that was not delineated in any of the references.

If you find that a combination of particular references is proper and provides a basis for determining obviousness, the law prohibits you from picking and choosing among elements in a

reference, either individually or in that combination. The reference as a whole must always be considered. Thus, you cannot disregard disclosures in the reference that teach away from the claimed invention.

Authority: ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 (Fed. Cir. 1984); Medtronic v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1573-74 (Fed. Cir. 1983); W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1551 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); Carella v. Starlight Archery, 804 F.2d 135, 140 (Fed. Cir. 1986); Gillette Co. v. S.C. Generation II & Son, Inc., 919 F.2d 720, 723-724 (Fed. Cir. 1990).

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PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 58  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
OBVIOUSNESS -- "OBVIOUS TO TRY"

The evidence might indicate to you that what the inventors did was obvious to try. "Obvious to try," however, is not the standard to be used and it is improper for you to find a patent invalid for obviousness because you believe it was obvious to try. Rather, it is whether the invention as a whole would have been obvious to those of ordinary skill in the inventor's field at the time the invention was made.

The fact that a solution to a problem is simple or appears so when reviewed in retrospect does not mean that the solution was obvious when it was conceived. The fact that the invention is simple and that at the present time it seems as if it might have been obvious to the workers in the art, does not militate against its validity. Many of the most useful inventions depend upon equally simple changes.

Authority: Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379-80 (Fed. Cir. 1986); Jones v. Hardy, 727 F.2d 1524, 1530 (Fed. Cir. 1984); Ellipse Crop. V. Ford Motor Co., 452 F.2d 163, 169 (7<sup>th</sup> Cir. 1971), cert. denied, 406 U.S. 948, reh'g denied, 409 U.S. 898 (1972); General Electric Co. v. Hill-Wright Electric Co., 174 F. 996, 998 (2d Cir. 1909); Gillette Co. v. S.C. Generation II & Son, Inc., 919 F.2d 720, 725 (Fed. Cir. 1990).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 59**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**OBJECTIVE EVIDENCE OF NON-OBVIOUSNESS**

In determining whether a claimed invention is obvious, you must consider the following objective evidence of non-obviousness, called "secondary considerations", so long as there is a connection to the claimed invention involved. Such items need not all be present; indeed, one may provide material insight:

1. Prior or contemporaneous failure by others to solve the problem at issue;
2. Commercial success of the claimed invention. This may be established by proof of commercial sales by licensees of the patent, such as Golden Blount, or by defendant Robert H. Peterson's sales of products covered by the claims of the patent;
3. Filling of a long-felt need in the industry;
4. Copying by defendant;
5. The inventor's departure from recognized principles;
6. The invention's superiority over previously available solutions;
7. The inventor's solution and insight in solving the problem was contrary to the understanding and expectation of the art; and
8. Adoption of the invention by a substantial part of the industry upon disclosure by the patentee.

The absence of any or all of these considerations does not mean that the invention would have

been obvious. However, if you find that one or more of these factors has been shown, then that is proof that the invention was not, in fact, obvious.

Authority: *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1097 (Fed. Cir. 1985); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1524, 1530-31 (Fed. Cir. 1984); *Carl Schenk AG v. Nortron Corp.*, 713 F.2d 782, 785 (Fed. Cir. 1983); *Leesona Corp. v. United States*, 185 U.S.P.Q. 156, 161 (Ct. Cls. 1975), *aff'd*, 530 F.2d 896 (Ct. Cls. 1976); *Demaco Corp. v. F. Von Lansdorff Licensing Ltd.*, 851 F.2d 1387, 1391 (Fed. Cir. 1988).

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 60  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
COMMERCIAL SUCCESS

If you find that the apparatus taught by the '159 Patent achieved commercial success, that fact will be objective evidence of non-obviousness if the success is due to the novel features of the invention rather than other considerations such as advertising and promotion. In order for evidence of extensive use of the invention to be considered as evidence of non-obviousness, plaintiff need shown only that the use was of the invention. To negate such evidence, it is defendant Robert H. Peterson's burden to show that extensive use of the invention was due to factors other than the merits of the invention, such as advertising or promotion.

Authority: Damaco Corp. v. F. Von Langsdorff Licensing, Ltd., 851 F.2d 1387, 1392 (Fed. Cir. 1988); Gillette Co. v. S.C. Generation II & Sons, Inc., 919 F.2d 720, 725-26 (Fed. Cir. 1990); Coleman v. Holly Mfg. Co., 233 F.2d 71, 80 (9<sup>th</sup> Cir. 1956), cert. denied, 352 U.S. 952, 111 U.S.P.Q. 467 (1956); Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1383 (Fed. Cir. 1986).

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 61**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**LONG FELT NEED**

Long-felt but unsolved needs, failures of others, and subsequent success and acceptance is evidence of non-obviousness. For example, a problem in the field which long remained unsolved despite efforts conducted by others is indicative of non-obviousness. Substantial efforts by others in the art which failed to accomplish the result achieved by the patented invention can also be persuasive indication of non-obviousness.

Authority: *Stratoflex, Inc. v. Aeorquip Corp.*, 713 F.2d 1530, 1540 (Fed. Cir. 1983); *In re Dow Chemical Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988); *Under Sea Industries, Inc. v. Dacor Corp.*, 833 F.2d 1551, 1559 (Fed. Cir. 1987); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1380, 1382 (Fed. Cir. 1986); *Reeves Instrument Corp. v. Beckman Instruments, Inc.*, 444 F.2d 263, 272 (9<sup>th</sup> Cir. 1971), cert denied, 404 U.S. 951 (1971); *Santa Fe-Pomeroy, Inc. v. P & Z Co.*, 569 F.2d 1084, 1098 (9<sup>th</sup> Cir. 1978).

PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 62  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
COPYING OF THE INVENTION

Copying of an invention by another is evidence of the value of an invention. Specifically, evidence that defendant Robert H. Peterson Co. copied the patented apparatus rather than develop its own product or copy a product within the public domain, is indicative of non-obviousness. The actions of an alleged infringer are often the best indication of the importance of an invention.

Authority: Panduit Corp. v. Dennison Mfg. Co., 774 F.2d 1082, 1099 (Fed. Cir. 1985); Windsurfing International, Inc. v. AMF, Inc., 782 F.2d 995, 1000 (Fed. Cir. 1986); Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 679 (Fed. Cir. 1988); Specialty Composites v. Cabot Corp., 845 F.2d 981, 991 (Fed. Cir. 1988).

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**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 63**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**DAMAGES**

If you find that the defendant has infringed any of the claims of the plaintiff's patent and that those claims are valid, then you should consider the amount of money the plaintiff should be awarded as damages.

In this respect, it is the plaintiff's burden to proving by a preponderance of the evidence the amount of damages caused by the infringer.

The fact that I will now turn to the issue of how you should measure damages should not be taken by you to mean that the Court believes that there was infringement or that the patent is valid. There are issues for you to resolve consistent with the instructions I have given you. I am instructing you on damages so that you will have guidance should you decide that the plaintiff is entitled to recovery. You may consider relevant testimony as an aid to your determination of damages.

Authority: Adapted from Modern Federal Jury Instructions - Civil, ¶ 86.04.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 64**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**OBVIOUSNESS – COMBINING REFERENCES**

When the amount of the damages cannot be ascertained with precision, any doubts regarding the amount are to be resolved against the infringer.

Authority: Adapted from Modern Federal Jury Instructions - Civil, ¶ 86.04.

**PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 65**  
**SPECIFIC INSTRUCTIONS AFTER CLOSE**  
**DAMAGES -- COMPENSATION**

Damages are compensation for all losses suffered as a result of the infringement. The owner of a valid patent which has been infringed is entitled to recover enough money so that he will be compensated for the infringement, but in no event less than a reasonable royalty for the use which the infringer made of the invention. The measure of damages is the amount needed to return the plaintiff to the position it would have been in had there been no infringement. In other words, the plaintiff is to be placed in as good a position as it would have been if no infringement had occurred. Thus, the question you must consider is, had defendant Robert H. Peterson Co. not infringed, how much money would plaintiff had made.

Authority: 35 U.S.C. §284; State Industries, Inc. v. Mor-Flo Industries, Inc., 883 F.2d 1573, 1577 (Fed. Cir. 1989), cert. denied 493 U.S. 1022 (1089); TWM Mfg. Co. v. Dura Corp., 789 F.2d 895 (Fed. Cir. 1986).

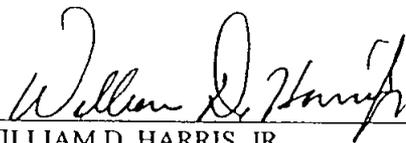
PLAINTIFF'S PROPOSED JURY INSTRUCTION NO. 66  
SPECIFIC INSTRUCTIONS AFTER CLOSE  
LOST PROFITS DEFINED

The plaintiff has argued that they should be awarded the amount of profits lost because of the alleged infringement.

Lost profits may be in the form of diverted sales, eroded prices or increased expenses. In this respect, it is the plaintiff's burden to establish by a reasonable probability that the infringement caused their lost profits. In order to satisfy this burden, you must find that the plaintiff would have made the sales that the infringer made, charged higher prices, and/or incurred lower expenses "but for" the infringement. In other words, had the infringer not infringed, what would the plaintiff have made.

Authority: *Fonar Corp v. General Electric Co.*, 107 F.3d 1543, 1553 (Fed. Cir. 1997); *Hebert v. Lisle Corp.*, 99 F.3d 1109 (Fed. Cir. 1996); *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360 (Fed. Cir. 1991), cert. denied, 113 S.Ct. 60 (1992); *Kaufman CO. v. Lentech, Inc.*, 926 F.2d 1136 (Fed. Cir. 1991); *Modern Federal Jury Instructions - Civil.*

Respectfully submitted,  
For Plaintiff Golden Blount, Inc.



WILLIAM D. HARRIS, JR.  
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Richardson, Texas 75080  
(972) 480-8800 Attorneys for Plaintiff

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PLAINTIFF'S PROPOSED  
JURY INSTRUCTIONS

87

William D. Harris, Jr. (Bar No. 09109000)  
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275 West Campbell Road, Suite 225  
Richardson, Texas 75080  
(972) 480-8800 Attorneys for Plaintiff

JP-APP 0279

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
§  
§  
§  
§  
§  
§

Civil Action No.

3-01CV0127-R

E-3. PLAINTIFF GOLDEN BLOUNT INC.'S  
PROPOSED JURY QUESTIONS

The following list of jury questions is made to comply with paragraph 11.e. of the Court's Scheduling Order.

(Answer All Questions unless instructed to the contrary)

**DIRECT INFRINGEMENT** (The instructions specific to this question are found at pages \_\_\_\_-\_\_\_\_.)

1. Has Golden Blount proven by a preponderance of the evidence that any of the products Robert H. Peterson Co. has made, sold or offered to sell after November 23, 1999, in the United States literally infringe any of the following claims of the Blount patent?

Check "yes" or "no" for each of the following claims:

Yes   No

(a) Claim 1    \_\_\_    \_\_\_

If you answered "No" for claim 1, you must answer "No" for claims 2, 5, 7, 8, 9, 11, 12, 13, 15, and 16.

- (b) Claim 2    \_\_\_    \_\_\_
- (c) Claim 5    \_\_\_    \_\_\_
- (d) Claim 7    \_\_\_    \_\_\_
- (e) Claim 8    \_\_\_    \_\_\_
- (f) Claim 9    \_\_\_    \_\_\_
- (g) Claim 11   \_\_\_    \_\_\_
- (h) Claim 12   \_\_\_    \_\_\_
- (i) Claim 13   \_\_\_    \_\_\_
- (j) Claim 15   \_\_\_    \_\_\_
- (k) Claim 16   \_\_\_    \_\_\_
- (l) Claim 17   \_\_\_    \_\_\_

**INFRINGEMENT UNDER DOCTRINE OF EQUIVALENTS** (The instructions specific to this question are found at pages \_\_\_-\_\_\_.)

2. Has Golden Blount, Inc. proven by a preponderance of evidence that any of the products Robert H. Peterson Co. has made, sold or offered to sell after November 23, 1999, in the United States infringe any of the following claims of the Blount patent under the "doctrine of equivalents"?

Check "yes" or "no" for each of the following claims:

Yes    No

- (a) Claim 1    \_\_\_    \_\_\_

If you answered "No" for claim 1, you must answer "No" for claims 2, 5, 7, 8, 9, 11, 12, 13, 15, and 16.

- (b) Claim 2    \_\_\_    \_\_\_
- (c) Claim 5    \_\_\_    \_\_\_

- (d) Claim 7    \_\_\_    \_\_\_
- (e) Claim 8    \_\_\_    \_\_\_
- (f) Claim 9    \_\_\_    \_\_\_
- (g) Claim 11   \_\_\_    \_\_\_
- (h) Claim 12   \_\_\_    \_\_\_
- (i) Claim 13   \_\_\_    \_\_\_
- (j) Claim 15   \_\_\_    \_\_\_
- (k) Claim 16   \_\_\_    \_\_\_
- (l) Claim 17   \_\_\_    \_\_\_

**INFRINGEMENT BY INDUCEMENT** (The instructions specific to this question are found at pages

3. Has Golden Blount, Inc. proven by a preponderance of evidence that after November 23, 1999, Robert H. Peterson has intentionally induced its distributors to infringe any of the following claims of the Blount patent?

Check "yes" or "no" for each of the following claims:

Yes    No

- (a) Claim 1    \_\_\_    \_\_\_

If you answered "No" for claim 1, you must answer "No" for claims 2, 5, 7, 8, 9, 11, 12, 13, 15, and 16.

- (b) Claim 2    \_\_\_    \_\_\_
- (c) Claim 5    \_\_\_    \_\_\_
- (d) Claim 7    \_\_\_    \_\_\_
- (e) Claim 8    \_\_\_    \_\_\_
- (f) Claim 9    \_\_\_    \_\_\_

(g) Claim 11 \_\_\_ \_\_\_

(h) Claim 12 \_\_\_ \_\_\_

(i) Claim 13 \_\_\_ \_\_\_

(j) Claim 15 \_\_\_ \_\_\_

(k) Claim 16 \_\_\_ \_\_\_

(l) Claim 17 \_\_\_ \_\_\_

**ANTICIPATION** (The instructions specific to this question are found at pages \_\_\_-\_\_\_.)

4. Has Robert H. Peterson Co. proven by clear and convincing evidence that the subject matter of claims 1, 2, 5, 7-9, 11-13 and 15-17 was anticipated by any single reference in the prior art?

Check "yes" or "no" for each of the following claims:

	<u>Yes</u>	<u>No</u>
(a) Claim 1	___	___

(b) Claim 2	___	___
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(c) Claim 5	___	___
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(d) Claim 7	___	___
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(e) Claim 8	___	___
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(f) Claim 9	___	___
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(g) Claim 11	___	___
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(h) Claim 12	___	___
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(i) Claim 13	___	___
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(j) Claim 15	___	___
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(k) Claim 16	___	___
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JL-APP 0283

(l) Claim 17    \_\_\_    \_\_\_

**OBVIOUSNESS** (The instructions specific to this question are found at pages \_\_\_ - \_\_\_.)

5.     Has Robert H. Peterson Co. established by clear and convincing evidence that the differences, if any, between the subject matter defined by claims 1, 2, 5, 7-9, 11-13 and 15-17 of the Blount patent and the prior art are such that the subject matter of those claims, as a whole, would have been obvious to a person having ordinary skill in the art at the time the invention was made?

Check "yes" or "no" for each of the following claims:

- |              | <u>Yes</u> | <u>No</u> |
|--------------|------------|-----------|
| (a) Claim 1  | ___        | ___       |
| (b) Claim 2  | ___        | ___       |
| (c) Claim 5  | ___        | ___       |
| (d) Claim 7  | ___        | ___       |
| (e) Claim 8  | ___        | ___       |
| (f) Claim 9  | ___        | ___       |
| (g) Claim 11 | ___        | ___       |
| (h) Claim 12 | ___        | ___       |
| (i) Claim 13 | ___        | ___       |
| (j) Claim 15 | ___        | ___       |
| (k) Claim 16 | ___        | ___       |
| (l) Claim 17 | ___        | ___       |

**WILLFUL INFRINGEMENT** (The -instructions specific to this question are found at pages

7. Has Golden Blount, Inc. proven by clear and convincing evidence that Robert H. Peterson Co.'s infringement, if any, of the patent in suit was willful?

ANSWER: Yes \_\_\_ or No \_\_\_

**DAMAGES - LOST PROFITS** (The instructions specific to this question are found at pages \_\_\_ - \_\_\_.)

8. What amount of money, if paid now in cash, would represent a reasonable payment to Golden Blount, Inc. for the lost profits caused to Golden Blount, Inc. by the sale or use of products by Robert H. Peterson, from the time it was properly notified of infringement?

Answer in dollars and cents, if any, for such damages.

\$ \_\_\_\_\_

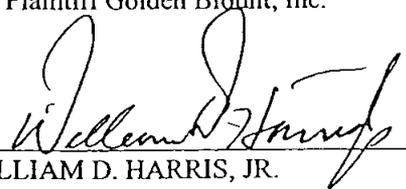
**DAMAGES - REASONABLE ROYALTY** (The instructions specific to this question are found at pages \_\_\_ - \_\_\_.)

9. What amount of money, if paid now in cash, would represent a reasonable royalty to Golden Blount, Inc. for the sale or use of products by Robert H. Peterson, from the time it was properly notified of infringement?

Answer in dollars and cents, if any, for such damages.

\$ \_\_\_\_\_

Respectfully submitted,  
For Plaintiff Golden Blount, Inc.

  
\_\_\_\_\_  
WILLIAM D. HARRIS, JR.  
State Bar No. 09109000

JT-APP 0285

CHARLES W. GAINES  
State Bar No. 07570580  
Hitt Gaines & Boisbrun, P.C.  
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Richardson, Texas 75080  
972/480-8800 (Telephone)  
972/480-8865 (Facsimile)

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

JOINT PRETRIAL ORDER  
PURSUANT TO LOCAL RULE 16.4

This Pretrial Order is submitted in accordance with the Court's Scheduling Order and Local Rule 16.4 of the Local Rules for the United States District Court for the Northern District of Texas.

A. SUMMARY OF CLAIMS AND DEFENSES OF EACH PARTY

1. A summary of the claims and defenses of Golden Blount, Inc. are attached hereto as Section A-1.
2. A summary of the claims and defenses of Robert H. Peterson Co. are attached hereto as Section A-2.

B. STATEMENT OF STIPULATED FACTS

1. A statement of stipulated facts is attached hereto as Section B.

C. LIST OF CONTESTED ISSUES OF FACT

1. A list of contested issues of fact by Golden Blount, Inc. is attached hereto as Section C-1.
2. A list of contested issues of fact by Robert H. Peterson Co. is attached hereto as

Section C-2.

**D. LIST OF CONTESTED ISSUES OF LAW**

1. A list of contested issues of law by Golden Blount, Inc. is attached hereto as Section D-1.
2. A list of contested issues of law by Robert H. Peterson Co. is attached hereto as Section D-2.

**E. ESTIMATE OF LENGTH OF TRIAL**

1. The parties acting jointly estimate 4 days of trial. (This would be shortened if the case is a bench trial).

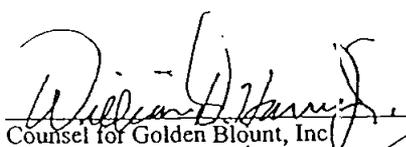
**F. LIST OF ANY ADDITIONAL MATTERS THAT WOULD AID IN THE DISPOSITION OF THE CASE**

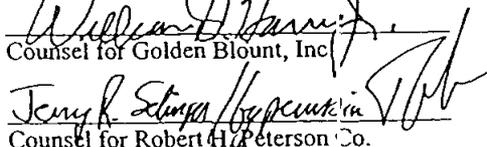
1. A list of any additional matters that would aid in the disposition of the case is attached hereto as Section F.

Date: Feb. 20, 2002

Date: 20 Feb, 02

Date: \_\_\_\_\_

  
Counsel for Golden Blount, Inc.

  
Counsel for Robert H. Peterson Co.

\_\_\_\_\_  
Judge Jerry Buchmeyer

A-1

JT-APP 0289

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
§  
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§  
§  
§  
§

Civil Action No.

3-01CV0127-R

A-1. GOLDEN BLOUNT, INC.'s  
CLAIMS AND DEFENSES

Plaintiff Golden Blount, Inc. ("Golden Blount") respectfully submits the following claims and defenses.

1. Defendant is infringing claims 1, 2, 5, 7-9, 11-13 and 15-17, of the Blount Patent 5,988,159, issued November 23, 1999.

2. Plaintiff contends that the patent claims at issue are literally infringed; but if not literally infringed, Plaintiff contends the claims are infringed through the doctrine of equivalents.

3. The infringement is direct, and if not direct, most certainly induced (35 USC 271(b)) and contributory (35 USC 271(c)).

4. The claims at issue are valid, and under the law to invalidate is Defendant's burden, which must be established by clear and convincing evidence.

5. Plaintiff has suffered damages as a result of Defendant's infringement. Plaintiff's damages include lost profits, and in no event less than a reasonable royalty. In this case, lost profits are applicable and more appropriate than a reasonable royalty.

6. Plaintiff further claims that the infringement of Defendant is willful under the law and that this is an exceptional case for attorney's fees (35 USC 285) and an appropriate case for triple damages (35 USC 284).

7. Plaintiff is entitled to an injunction against further infringement.

A-2

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

A-2. PETERSON CO.'s  
CLAIMS AND DEFENSES

Defendant Robert H. Peterson Co. ("PETERSON CO.") respectfully submits the following claims and defenses.

1. The claims at issue, claims 1, 2, 5, 7-9, 11-13 and 15-17 of Blount U.S. Patent No. 5,988,159, are invalid as anticipated under 35 USC § 102 or obvious under 35 USC § 103.
2. Defendant is not literally infringing, directly, by inducement or contributorily, any of claims 1, 2, 5, 7-9, 11-13 and 15-17 of the '159 patent.
3. Defendant is not infringing under the Doctrine of Equivalents, directly, by inducement or contributorily, any of claims 1, 2, 5, 7-9, 11-13 and 15-17 of the '159 patent.
4. Plaintiff has suffered no damage as a result of Defendant's alleged infringement and if it prevails is entitled to no more than a reasonable royalty.
5. If Plaintiff is entitled to any lost profits, those lost profits are limited to profits from the sales of the secondary burners only.
6. The alleged infringement by Defendant is not willful.

B

JT-APP 0294

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
§  
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§  
§

Civil Action No.

3-01CV0127-R

B. STATEMENT OF STIPULATED FACTS

Plaintiff Golden Blount, Inc. ("Golden Blount") and Defendant Robert H. Peterson Co. ("PETERSON CO.") respectfully submit the following statement of facts.

1. The parties, Golden Blount, Inc. and Robert H. Peterson Co., stipulate that copies of United States Patent No. 5,988,159 will be accepted as a true and correct copy of the original patent as issued by the United States Patent Office.

2. The parties stipulate that Golden Blount, Inc., is a Texas corporation and is the present owner of the entire interest of United States Patent No. 5,988,159, together with the right to sue and recover for past infringement.

3. The parties stipulate that copies of all brochures, websites or catalogs of Robert H. Peterson Co., will be accepted as true and correct copies of their originals as distributed by Robert H. Peterson Co., and likewise the same shall apply to the brochures, websites or catalogs of Golden Blount, Inc.

4. The parties stipulate that copies of the assignment from Golden Blount to Golden Blount, Inc., will be accepted as a true and correct copy of the assignment filed with the United

States Patent Office.

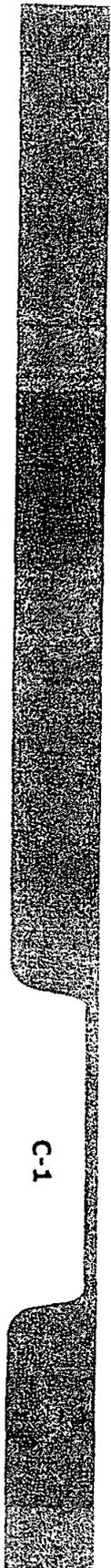
5. The parties stipulate that copies of the documents produced by either party to the other during the initial discovery period are true and correct copies as produced by the producing party and that they may be treated as originals, unless error may appear.

6. The parties stipulate that Robert H. Peterson Co.'s Ember Flame Booster is intended to be attached to its G-4 series burner system or G-5 series log set and the combined unit comprises a primary burner pipe, an ember pan that supports the primary burner pipe, a secondary burner tube and a valve that controls a flow of gas between the primary burner pipe and the secondary burner tube, and that an end user would connect the primary burner pipe to a gas source having a valve associated therewith.

7. The parties stipulate that the claims that are at issue in this action are 1, 2, 5, 7-9, 11-13 and 15-17.

8. The parties stipulate that the copies of the prosecution history of U.S. Patent No. 5,988,159, including any or all continuations thereof, as well any parents thereof, will be accepted as true and correct copies of the prosecution history as kept by the United States Patent Office, unless error may appear.

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C-1

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
§  
§  
§  
§  
§  
§

Civil Action No.

3-01CV0127-R

**C-1. GOLDEN BLOUNT, INC.'s STATEMENT OF  
CONTESTED ISSUES OF FACT**

Plaintiff Golden Blount, Inc. ("Golden Blount") respectfully submits the following statement of contested issues of fact.

1. Whether claims 1, 2, 5, 7-9, 11-13 and 15-17, individually or as a group, are infringed by the accused Peterson structure, either by direct infringement, contributory infringement or inducement to infringement ( 35 USC 271). (It is submitted that the interpretation of the claims is strictly for the Court; the application of those interpreted claims to the accused device or structure is for the jury).

2. Whether claims 1, 2, 5, 7-9, 11-13 and 15-17 are valid and enforceable. (It is submitted that the ultimate determination of validity and enforceability is for the Court; there may be certain underlying facts that are for the jury).

3. Whether the patented invention, as defined by one or more claims thereof was a commercial success.

4. Whether the patented invention, as defined by one or more claims thereof met a long

recognized or felt need.

5. That the Defendant's auxiliary burner was intended strictly for use with an artificial log set and that distributors sold a Peterson log set with each sale of an auxiliary burner.

6. That Peterson acted irresponsible in not promptly obtaining an opinion covering whether or not it violated the patent in suit after being accused of infringement by the Plaintiff.

7. That the ultimate opinion obtained by Peterson did not come till over a year after Peterson had notice of infringement from Blount - - - that during that entire period after its initial consideration Peterson did nothing to obtain an opinion and only sought one after it was sued.

8. That the ultimate opinion was only oral, and based on telephone conferences with Peterson's representative.

9. That the attorney had never seen an actual accused structure or device made by Peterson but relied strictly on catalog/advertisement information (even though a Peterson facility was only a short distance away in the Chicago area, where the attorney offices), and that neither the attorney nor the client made a thorough independent investigation.

10. That the oral opinion given was not adequate under the circumstances described above.

11. That the infringing conduct of Defendant was not only intentional, but wilful.

12. That the accused device was sold and offered for sale within the United States and it constitutes a component of one or more of claims 1, 2, 5, 7-9, 11-13 and 15-17 of the patent in suit (combination claims) and constitutes a material part of the patented invention claim(s); that the sales and offering for sale were made knowing the accused structures were especially made or especially adapted for use in an infringement of such patent claim(s); that the accused device was not a staple article or commodity of commerce suitable for substantial non infringing use.

13. Peterson actively induced infringement of one or more of claims 1, 2, 5, 7-9, 11-13 and 15-17. This was accomplished by advertisements, catalogs and presentations showing how to infringe and by offers for sale and sale of devices that necessarily infringed when used.

14. That Peterson knew about the patent while it engaged in its infringing conduct.

15. That the accused Peterson device appears to be a substantial copy of the patented device sold by Blount and that such accused device was not marketed until after the Blount device had been on the market for several years.

16. That Golden Blount, Inc., has been damaged to the extent at least of lost profits for all of the sales of infringing products made by Peterson, and that Golden Blount Inc.'s damages include sales of related products made by Peterson because of the sale of the patented structure.

17. There is no prosecution history estoppel, as was admitted by attorney McLaughlin during his deposition.

C-2

JT-APP 0301

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

**C-2. PETERSON CO.'s STATEMENT OF  
CONTESTED ISSUES OF FACT**

Defendant Robert H. Peterson Co. ("PETERSON CO.") respectfully submits the following contested issues of fact.

1. The accused burner assemblies that employ secondary burners from PETERSON CO. have gas discharge ports in the secondary burners which are positioned above the height of the gas discharge ports on the primary burner.
2. The accused burner assemblies that employ secondary burners from PETERSON CO. have gas discharge ports in the secondary burners which are directed vertically downwardly.
3. At least as early as 1977, PETERSON CO. has sold gas fireplace assemblies in which the primary burner was an ember burner.
4. More than one (1) year prior to the filing date of the '159 patent, Golden Blount and/or Golden Blount, Inc. sold gas fireplace assemblies in which the primary burner was an ember burner.
5. At least as early as 1977, PETERSON CO. manufactured and sold gas fireplace

assemblies having primary and secondary burners in which separate gas valves controlled the flow of gas to the primary and secondary burners.

6. More than one (1) year prior to the filing date of the '159 patent, one or more third parties manufactured and/or sold gas fireplace assemblies having primary and secondary burners in which separate gas valves controlled the flow of gas to the primary and secondary burners.

7. The use of valves to control gas flow in gas fireplaces was well known in the art long prior to the filing date of the '159 patent.

8. PETERSON CO.'s sales of the accused Ember Flame Booster are as an accessory for retrofitting to an existing PETERSON CO. G4 Series Burner System, as an accessory for a new G4 Series Burner System, or pre-assembled in a G5 Series Log Set that includes a G4 Series Burner System.

9. PETERSON CO. was not notified of the alleged infringement of the '159 patent until on or about May 9, 2000, and therefore damages may not be recovered before that date.

D-1

JT-APP 0304

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

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Civil Action No.

3-01CV0127-R

**D-1. GOLDEN BLOUNT, INC's STATEMENT OF  
CONTESTED ISSUES OF LAW**

Plaintiff Golden Blount, Inc. ("Golden Blount") respectfully submits the following statement of contested issues of law.

1. How the claims at issue are to be interpreted.
2. To the extent a question of law may be involved, whether the claims are infringed.
3. Whether the claims at issue are valid.
4. Whether as a matter of law damages should be increased by the Court under 35 USC 284, and if so, by how much.
5. As a mixed question of law and fact, whether this case qualifies as an exceptional case under 35 USC 285 so as to give Plaintiff reasonable attorneys fees, and what are reasonable attorneys fees in this case.

D-2

JT-APP 0306

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

D-2. PETERSON CO.'s STATEMENT OF  
CONTESTED ISSUES OF LAW

Defendant Robert H. Peterson Co. ("PETERSON CO.") respectfully submits the following contested issues of law.

1. The scope of the claims at issue in the '159 patent is limited to burner systems having a primary burner tube and a second burner tube in which the secondary burner tube is entirely below the primary burner tube.

2. The scope of the claims at issue in the '159 patent is limited to burner systems having a primary burner tube and a second burner tube in which the gas discharge ports of the secondary burner tube are below the gas discharge ports of primary burner tube.

3. The scope of claim 17 of the '159 patent is limited to burner systems having a primary burner tube and a secondary burner tube in which the gas discharge ports of the secondary burner tube are directed toward the primary burner tube and not directed vertically.

4. If the accused PETERSON CO. product infringes any claim of the 159 patent, then each infringed claim in the 159 patent is invalid as anticipated under 37 U.S.C. §102 by prior art fireplace

assemblies known or used by others or sold more than one (1) per year prior to the filing date of the '159 patent by PETERSON CO.

5. Each and every claim in issue in the '159 patent is rendered obvious under 35 U.S.C. §103 by prior art fireplace assemblies described in patents cited during the prosecution of the '159 patent in view of prior art fireplace assemblies sold by PETERSON CO. and one or more third parties.

6. Because there are a substantial number of third parties selling non-infringing alternatives to the '159 patent product as well as fireplace assemblies using the secondary burner sold by PETERSON CO., plaintiff Golden Blount, Inc. is not entitled damages of lost profits.

7. If Golden Blount, Inc. is found to be entitled to lost profits because of PETERSON CO.'s infringement of the '159 patent, those lost profits should be limited to profits generated only from the sale of secondary burners.

8. Under the facts of this case, Golden Blount, Inc. is entitled only to a reasonable royalty on the sale of secondary burners.

9. Because limitations were added to every claim in issue during the prosecution of the '159 patent, including its parent applications, plaintiff Golden Blount, Inc. is precluded from arguing infringement under the Doctrine of Equivalents regarding the relative height of primary and secondary burners, or the relative direction of the gas distribution ports of the secondary burner.

10. Because the only apparent structural difference between the cited prior art and the claimed subject matter of the '159 patent was the use of a valve between the primary and second burners, and the use of such valves was commonly known, secondary considerations such as commercial success and fulfillment of a long felt need are to be given little or no weight.



JT-APP 0309

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

**F. LIST OF ADDITIONAL MATTERS  
THAT WOULD AID IN THE DISPOSITION OF THE CASE**

The parties may consider asking Judge Buchmeyer to try the case without a jury, with a Markman hearing sometime prior to trial. The parties may also consider asking Judge Buchmeyer for a Court supervised settlement conference after the Markman hearing. In any event, the Defendant requests a Markman hearing whether or not the case is bench tried. The exact language provided by Defendant is as following:

"Independent claims 1 and 17 of the patent at issue include limitations that Robert H. Peterson Co. contends are not present in the accused product. These limitations relate to the relative height of a primary burner tube and a secondary burner tube and to the orientation of gas discharge ports of the secondary burner tube. Robert H. Peterson Co. requests that the Court conduct a Markman hearing (*Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996)) prior to trial to interpret claims 1 and 17 to determine the scope and meaning of these limitations. The Court could set a relatively short briefing schedule followed by a hearing, if necessary, for the Court to interpret the limitations. The Markman determination is necessary for trial and the outcome could resolve the case without a trial. To the extent the Markman hearing does not fully resolve the case, Robert H. Peterson Co. suggest that a Court

ordered settlement conference or mediation be held which could aid  
in the disposition of the case."

The parties are not in agreement to try the case before the Magistrate Judge.

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

RECEIVED  
MAR 18 2002

GOLDEN BLOUNT, INC.,

Plaintiff,

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
§  
§  
§  
§

Civil Action No. 3-01 CV0127-R

WOOD, PHILLIPS, ET AL

PLAINTIFF'S RESPONSE TO DEFENDANT PETERSON CO.'S  
MOTION TO PRECLUDE TESTIMONY OF F. WILLIAM McLAUGHLIN

The facts are simple. The Defendant has elected to give advice (or opinions) of counsel as an element of defense against willful infringement and against the awarding of attorneys fees (35 U.S.C. 284 and 285). The Defendant has also given deposition testimony through a corporate officer (Mr. Leslie Bortz) under Rule 30(b)(6), as well as deposition testimony of the lawyer (F. William McLaughlin) who gave the advice and opinion of counsel. No attorney-client privilege was asserted in these depositions, the advice and opinion of counsel being the very subject of the depositions. Now, Defendant Peterson wants to assert advice of counsel as a defense, yet block the testimony of Mr. McLaughlin who gave the advice entirely orally.

At the outset, it is important to understand that all of the legal advice or opinions given by Mr. McLaughlin were oral - - absolutely no advice or opinions were written. For this reason the importance of the oral advice and opinions given by Mr. McLaughlin becomes quite important, there being no documentation of Mr. McLaughlin's words or acts.

Earlier in the case it appeared Defendant was going to keep the advice and opinions secret under the cloak of the attorney/client privilege. Of course this would have been a permissible action. If the advice is kept secret, however, the law will not permit seeking the advice or opinions of counsel

as a defense against wilful infringement. This is believed clearly and universally the law:

"To rebut the charge of wilful infringement, an accused infringer may present evidence of reliance on the opinion of counsel as to the issues of invalidity, non-infringement and/or unenforceability. *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380, 1390 (Fed. Cir. 1983). Of course, reliance on opinion of counsel waives the attorney-client privileged communication as to the opinion rendered, as well as the facts surrounding the opinion. *Hercules, Inc. v. Exxon Corp.*, 434 F.Supp. 136, 156 (D. Del. 1977)." (emphasis added)

Indeed Defendant's filings admit the law is such. Namely, the above quote is from Defendant's own memo in support of its motion, at page 2.

After promising in writing not to use advice of counsel as an element of defense, in the final minutes of the first deposition of Mr. Bortz, Mr. Bortz of Peterson reneged on the prior decision not to use advice of counsel as a defense. This action caused Plaintiff to file a motion in limine or in the alternative to require Defendant's corporate officer to come to Dallas to testify in deposition, at Peterson's expense, about the attorneys opinions, and also to require Mr. McLaughlin who gave the opinions to come to Dallas for his deposition on the subject. Magistrate Judge Stickney elected to order Mr. Bortz and Mr. McLaughlin to come to Dallas and pay the costs of the depositions. Both Mr. Bortz and Mr. McLaughlin were deposed - - and in certain instances, there were material differences in their testimony regarding the advice and opinions given by counsel, and additionally, the memory of Mr. Bortz was vacant in many areas where Mr. McLaughlin had recollections.

In the depositions, the privilege was waived and there was testimony by Mr. Bortz about the advice of counsel. Likewise there was rather extensive testimony regarding the attorney/client opinions by Mr. McLaughlin, who gave the advice. To the Plaintiff, this made it absolutely certain that Defendant had waived the privilege in favor of testimony concerning the advice and opinions of counsel, and it was expected that Defendant was going to use the advice and opinions in its defense against wilfulness.

We are amazed, however, to find the Defendant now desires to have its cake and eat it too. Citing *Thorn EMIN. America, Inc. v. Micron Technology, Inc.*, Defendant is asking that the attorney

who gave the advice and opinions be stricken from the witness list and that his deposition not even be allowed for introduction into evidence. This we find to be unprecedented and extremely hard to swallow.

To the extent there are any limitations imposed by *Thorn* cited in Defendant's memorandum, it must be realized that those limitations relate quite strictly and narrowly to work product not communicated to the client, as opposed to the attorney/client relationship as involved in the advice and opinions given. In the present case there is only oral advice and opinions, and we do not see that any work product is at issue. All of the contacts and work involved by the lawyer in conveying information to the Defendant was strictly by word of mouth and interchange of discussions between them.<sup>1</sup>

Additionally, arguing, that a scintilla of work product is present, the *Thorn* holding is narrowly tailored to protecting work product not communicated to the client, which as evidenced by the oral advice and opinion, is certainly not the case. Likewise, even if the facts were such that a minute amount of subject matter in the deposition was work product, and further that such subject matter was not communicated to the client, Mr. McLaughlin's appearance at the deposition without an objection, would constitute a waiver to that minute amount of subject matter. Finally, even if a scintilla of work product could be identified in Mr. McLaughlin's deposition, it seems incredible that this would vitiate the deposition for all it is worth at trial.

One specific reason given by Defendant Peterson for preventing Mr. McLaughlin's testimony, is that if such testimony were allowed, the Defendant's firm (Wood, Phillips, VanSanten, Clark & Mortimer), or at least Mr. McLaughlin, might be disqualified. Under the present circumstances and the following representation, this argument is moot. We represent that we will not move for disqualification of the individual attorney or his firm. Because of the firms' long background with the Defendant, we accept local Rule 83.15(b) in permitting the Chicago firm to try the case.

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<sup>1</sup> If, however, one had problems with making the work product distinctions of *Thorn*, within the same U.S. District Court for the District of Delaware, an opposite result was reached. *Mosel Vitelic Corp., v. Micron Technology, Inc.*, 162 F.Supp 307 (D. Del. 2000). Two cases within the same district with opposite results, the more recent of which supports the Plaintiff's position, will certainly tell us very little, if we even need to be told at all.

Another reason given by Defendant for omitting Mr. McLaughlin's testimony, is that Mr. Bortz can testify to getting the advice of counsel. However, after comparing the depositions of Mr. Bortz and Mr. McLaughlin, it is clearly apparent that Mr. Bortz remembers a fraction of what Mr. McLaughlin remembers regarding the advice and opinions of counsel. Further, given that all of the advice and opinions were oral, without a single backup document, the only way to decipher any part of what really happened is through Mr. McLaughlin's testimony.

It must be appreciated that the law relating to asserting defense against wilfulness by advice of counsel is clear, in that the nature, character and thoroughness of the advice is of utmost importance.

The conclusion that must emerge is that the testimony by deposition of Mr. McLaughlin must be subject to introduction and that Mr. McLaughlin not be stricken from any witness list!

A direct quote from a case cited and quoted in Defendant's brief tells the reader that a counsel's opinion must pass muster ("be thorough enough") for it to have weight in defense of wilfulness:

*"Rather, counsel's opinion must be thorough enough as combined with other factors, to instill a belief in the infringer that a Court might reasonably hold the patent is invalid, not infringed or unenforceable. 959 F.2d at 944"* (underlined emphasis added by Defendant--italicized emphasis added by the undersigned).

At this late date, Defendant again wants to see-saw.<sup>2</sup> If so, we suggest it must do so at the price of the exclusion of all testimony of any nature on advice and opinions of counsel, and of course, of any reliance thereon.

In conclusion, the motion of Defendant should be denied, or in the alternative, the Defendant should be ordered not to tender any evidence concerning advice and opinions of

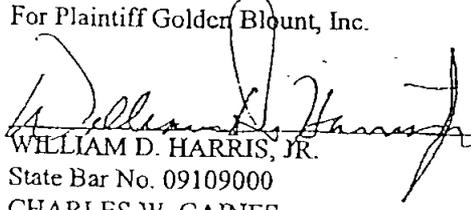
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<sup>2</sup> Note 1 from page 2 of the Peterson Co.'s Motion For Protective Order reads: "PETERSON Co. filed a Pre-trial Disclosure List of Witnesses on January 22, 2002. Mr. McLaughlin was inadvertently listed as a witness (emphasis added). That error was corrected when filing a List of Witness with the Pre-trial Materials on February 21, 2002." Just what kind of a see-saw game is this? "On again, off again, gone again McLaughlin," to borrow a phrase from an old Irish ditty.

counsel or reliance thereon.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



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CHARLES W. GAINES

State Bar No. 07570580

Hitt Gaines & Boisbrun, P.C.

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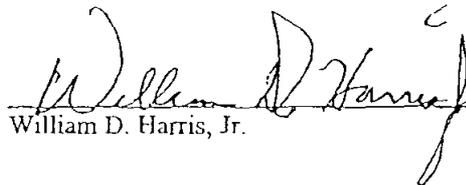
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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the enclosed Plaintiff's Response To Defendant Peterson Co.'s Motion To Preclude Testimony Of F. William McLaughlin was served on the following counsel of record on March 15, 2002 by first class mail and facsimile:

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Dean A. Monco  
Wood, Phillips, VanSanten,  
Clark & Mortimer  
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Chicago, IL 60611-2511  
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312/876-2020 (Facsimile)

  
William D. Harris, Jr.

WOOD, PHILLIPS, ET AL  
MAY 1 1964  
R E G I S T E R E D  
U S P A T E N T A N D  
T R A D E M A R K O F F I C E

JT-APP 0318

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

PLAINTIFF'S FINDINGS OF FACT AND CONCLUSIONS OF LAW

The proposed findings of fact and conclusions of law are submitted to comply with Paragraph 2.d. of the Amended Scheduling Order of February 27, 2002.

A. FINDINGS OF FACT

1. The Plaintiff Golden Blount, Inc. is the owner of U.S. Patent 5,988,159, assigned it by Mr. Golden Blount, the named inventor for the patent (hereinafter "the patent," "the patent in suit," or the "Blount patent"). The Plaintiff has sued Peterson Co. (Defendant)
2. The field of the invention is fireplace burners and associated equipment.
3. The Defendant contends that the patent is invalid under 35 U.S.C. 102 and 35 U.S.C. 103. The Defendant also contends that it does not infringe.
4. At the time the patent issued, the Plaintiff's commercial structure under the patent had been marketed for approximately six years, i.e., from about the time Plaintiff originally filed its patent application. Its sales grew significantly and it is a commercial success.
5. Defendant is unable to establish when it commenced design of its accused structure, but it was long after the Plaintiff placed its device on the market. There is a lack of explanation of why the first marketed accused structures were not fabricated and

placed on the market till after Plaintiff's device had established a market. Also there is no showing that the Defendant's device went through any significant design or development. The Defendant's structure is very similar to Plaintiff's. The foregoing gives inference of copying.

6. There had been a need for a burner device to give the appearance of the burning of natural logs by creating an area of subdued flames out front of the artificial logs, and to create the appearance of fiery hot embers out front, as would be present with the burning of real logs. The need for such a burner device to enhance the artificial fireplace's operation had existed for long before the invention occurred. The patented device met the aforementioned need.
7. The prior art relied on by the Defendant does not show the same concepts that the Plaintiff's claims include, and proof of the actual existence and/or sales of the prior art relied upon is lacking, as will be noted just below.
8. A recent sketch, made long after the patent was filed, was made to illustrate that which Defendant is trying to establish was prior art in the eighties. Defendant says it went off the market long ago. The sketch was made long after the fact, to illustrate a device allegedly made public or sold by a third party in the eighties. The recent sketch was made with the inputs and assistance of the Defendant's personnel.
9. The alleged prior art, shown in the sketch, was not sufficiently proved to consider it as meeting the standard of being shown "by clear and convincing evidence." Even if it did, it was for quite a different purpose than the patented device, and further, the end use has not been shown.
10. Turning to the evidence of burner configurations of Production No. 33 and Production No. 34, again their existence, their use, and their actual sale or marketing is vague. The Defendants say the alleged structures were not marketed (or not further sold) since around 1990. The only evidence offered were sketches of uncertain origin. Also, if these devices were viable prior art, it would seem that Defendant would have used them to compete with Plaintiff, rather than market the copycat structure presently sold.

11. The main tube and the auxiliary tube of Production Nos. 33 and 34 are of the same diameter and on a vertical level. No support means is provided or suggested.
12. From the facts found and reasons stated above, I do not believe the evidence pertaining to the alleged prior art of Production Nos. 33 and 34 have established by clear and convincing evidence their prior use or sale. Moreover, I find substantial differences between the alleged devices of Production Nos. 33 and 34. Note that the level of skill in the art is not high and giant inventive steps likely would not be made as readily as if this were astrophysics.
13. The other alleged art offered by Defendant is not nearly as similar as Production Nos. 33 and 34, and each fail to show significant pertinence.
14. There are 12 claims in issue. They are claims 1, 2, 5, 7-9, 11-13 and 15-17. Claims 1 and 17 are independent claims. All other claims at issue are dependent on Claim 1, that is, they refer to another claim as a beginning point of the structure they claim.
15. As a matter of law, the Court must construe the claims before literal infringement of the accused structure may be addressed. (Claim construction appears in the Conclusions of Law, infra.)
16. Applying the claim construction referred to in the Conclusions of Law; There is literal infringement of independent Claim 1, literal infringement of Claim 17 and literal infringement of dependent Claims 2, 5, 7-9, 11-13 and 15-16.
17. It could be argued that the above is somewhat misstated in that an independent valve, such as each residential fireplace has, is absent from the structure sold. However, the parties previously stipulated in effect that the Defendant's structure is used in the environment of the valve already being in the standard fireplace setup. Everything else is provided by Defendant (and by Plaintiff) to the ultimate customer, normally through a distributor. The evidence is that there is no other use for the patented structure. It is sold with knowledge that it will be used as per its intended use in a gas fireplace with artificial logs. It is not a staple article of commerce. Certainly it is a most significant part of the patented product, in fact, essentially all of it. Hence if there is not element by element literal infringement, there is contributory infringement.

[35 U.S.C. 271(d)].

18. It is further found that the Defendant advertises and provides instructions, such that the installer or the ultimate customer following the advertising and instructions provided by Defendant will constitute infringement. It is further found that demonstrations and sales meetings are held where distributors are shown how to practice the patented invention with Defendants equipment. The distributors pass this onto customers and to installers. By this conduct, Defendant induces infringement (35 U.S.C. 271(c)).
19. In the alternative to literal direct infringement, elements of the claims in suit are present in the accused structure. In each instance, element by element, and also considering the accused structure as a whole, there is insubstantial differences from the Defendant's accused structure and the claims at issue. Moreover, element by element, and as a whole, the accused structure does the same thing (the same function) in the same way to give the same result. While this is repeated under Conclusions of Law, it constitutes infringement under the doctrine of equivalent.
20. After the Defendant received a cease and desist letter, an attorney (Mr. McLaughlin) was called by phone to seek some advice. Mr. McLaughlin was provided only the letter and some advertising brochures or papers. Mr. McLaughlin was not asked for an opinion in the real sense of the word, but was told by Mr. Bortz, the Defendant's executive, that things very similar to the patented structure had existed in the past as early as the eighties. The only advice given by the attorney was that, if that were so, some of the claims would be invalid, depending on just what the prior art devices were, and that he would not have to be concerned about those claims.
21. Attorney McLaughlin was not even provided with the Defendant's accused device at that time, nor any alleged prior art. He was never provided the accused device until long after his oral opinion was given and after suit was filed.
22. In the final analysis, the only opinion given was oral and it was based on some sketches provided that did not include information or details of when they were sold or made available to the public, nor any aspect of their authenticity, detail or history.

The art provided to the attorney clearly did not render the patent claims invalid.

23. The oral opinion, rendered more than a year after the first cease and desist letter and even after suit was filed, did not inform the client that there was no estoppel during prosecution and that the doctrine of equivalents would have to be dealt with. It is uncertain how far the oral opinion went, but it was meager.
24. The Defendant's executive did get what he asked for, a statement that there was no infringement. The Defendant's apparent desire was to avoid paying attorneys fees or increased damages, and this appears to have been the sole reason for consultation with counsel, as shown both by his testimony on why he consulted Mr. McLaughlin by phone and also by Mr. McLaughlin's testimony as to the stated reason for the consultation. Note that at no time before his deposition was taken, did the Defendant's executive Mr. Bortz ever have a face-to-face meeting with Mr. McLaughlin concerning the cease and desist letter, even though he and Mr. McLaughlin were both in Chicago and had offices only a short distance apart. Never before Mr. Bortz's deposition was there an accused structure shown to Mr. McLaughlin. While some advertisements of Defendant's structure were shown, detailed drawings were not provided to attorney McLaughlin. Thus, he never had a full picture of the accused structure. For example, his testimony as to whether or not his auxiliary burner was below the main burner shows that, even then, he had not been able to understand pertinent points of the accused structure.
25. I find that the Defendant merely went through the motion of obtaining an opinion to protect itself and that it did not acquire a timely, well-considered opinion. I find that Defendant knew it was being very casual or cursory concerning the opinion and that the Defendant surely must have know that its opinion was more of a bargain basement job than was needed.
26. As a finding of fact, it is found that the conduct above is wilful.
27. It is found that the following factors exist in the present case: (1) demand for the patented product; (2) absence of acceptable non-infringing substitutes; (3) manufacturing and marketing capability to exploit the demand; and (4) the amount of

the profit it would have made. These are the factors that are referred to in the case of *Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156, 197 U.S.P.Q. (BNA) 726 (6th Cir. 1978).

28. Log sets and grate support means are included in the computation of lost profits. This takes into consideration Claim 15 as well as considering the convoy of the log sets together with each auxiliary burner unit. The individual burner units are often sold alone to distributors, but the distributors ultimately sell these with a log set.

## B. CONCLUSIONS OF LAW

1. The Plaintiff owns all right, title and interest in U.S. Patent No. 5,988,159, including the right to sue and recover for past infringement.
2. Claim interpretation applied by the Court is focused on a paragraph by paragraph analysis of each claim in suit, with those paragraphs not believed to require any comment for interpretation being marked such:

### CLAIM 1:

- a) The preamble requires a gas environment as opposed to a wood burning environment;
- b) The terms used herein are self-explanatory;
- c) The word coals is meant to cover the secondary coals burner elongated tube that is designed or adapted to make the coals or embers enhanced in appearance;
- d) The elongated primary burner tube is held up by the side of the pan through which the elongated primary burner tube extends. The elongated primary burner tube is at a raised level with respect to the secondary coals burner elongated tube (e.g., with respect to the centerline).
- e) The terms used herein are self-explanatory;
- f) The terms used herein are self-explanatory;
- g) The valve is located between the connection to the elongated primary burner tube and the connection to the secondary coals burner elongated tube;
- h) The gas flow control means is the common valve in every gas fed fire place.

CLAIM 2: The terms used herein are self-explanatory.

CLAIM 5: The terms used herein are self-explanatory.

CLAIM 7: The terms used herein are self-explanatory.

CLAIM 8: The terms used herein are self-explanatory.

CLAIM 9: The terms used herein are self-explanatory.

CLAIM 11: The terms used herein are self-explanatory.

CLAIM 12: The terms used herein are self-explanatory.

CLAIM 13: The valve is located between the connection to the elongated primary burner tube and the connection to the secondary coals burner elongated tube;

CLAIM 15: The terms used herein are self-explanatory.

CLAIM 16: The terms used herein are self-explanatory.

CLAIM 17: Away from includes any direction that does not include a horizontal component pointed toward the vertical plane of the fireplace opening, with the exception that the plurality of gas discharge ports should not point substantially vertically upward because sand and embers may fall therein.

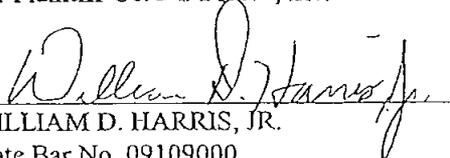
3. U.S. Patent No. 5,988,159 is infringed, if not literally, thru inducement and contributory infringement by Defendant. 35 U.S.C. 271(b) and (c), respectfully. Any one of these makes Defendant liable as an infringer.
4. There is no prosecution history estoppel, per the admission of the Defendant's counsel when under oath.
5. The infringement occurs through the doctrine of equivalents if not directly and/or literally, based on the facts found relating to equivalence.
6. The alleged prior uses, sales, and other art do not render any of the claims in suit as anticipated under 35 U.S.C. 102, nor make any in suit obvious under 35 U.S.C. 103.
7. The claims of the patent are valid.
8. Damages are awarded to Plaintiff from Defendant, from the time Defendant received notice under the law through its receipt of Plaintiff's notice letter on Dec 1999.
9. The *Panduit* factors are met. Thus, compensatory damages include lost

include conveyed items that interact and are essential to the operation of the patented subject matter. *Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 197 U.S.P.Q. (BNA) 726 (6th Cir. 1978). See also, *State Industries v. Mor-Flo Industries, Inc.*, 883 F.2d 1573, 12 U.S.P.Q.2D (BNA) 1026 (1989) or *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538 (Fed. Cir. 1995). The total damages are \$ \_\_\_\_\_

10. The infringement of Defendant was willful. Damages are tripled under 35 U.S.C. 284.
11. This is an exceptional case under 35 U.S.C. 285, and reasonable attorneys fees are awarded Plaintiff.
12. All of the findings of fact and conclusions of law stated above are hereby incorporated together with the usual rule in patent infringement cases, that infringement causes irreparable harm and will be abated. Therefore, an injunction is granted against Defendant. The injunction against infringement is separately set forth and decreed, by this Court.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.

  
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CHARLES W. GAINES

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Hitt Gaines & Boisbrun, P.C.

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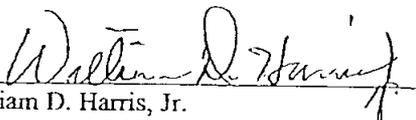
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Findings of Fact and Conclusions of Law was served on the following counsel of record on April 19, 2002, by first class mail and facsimile:

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JT=APP 0328

U.S. DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS

**FILED**

APR 19 2002

CLERK, U.S. DISTRICT COURT

By \_\_\_\_\_ Deputy

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC., )  
 )  
 Plaintiff, )  
 )  
 v. )  
 )  
 ROBERT H. PETERSON CO., )  
 )  
 Defendant. )

Civil Action No.: 3:01-CV-0127-R

**RECEIVED**  
APR 26 2002  
WOOD PHILLIPS, ET AL

**ROBERT H. PETERSON CO.'S PROPOSED  
FINDINGS OF FACT AND CONCLUSIONS OF LAW**

The following proposed findings of fact and conclusions of law are submitted to comply with Paragraph 2.d. of the Amended Scheduling Order of February 27, 2002.

**PROPOSED FINDINGS OF FACT**

1. Plaintiff, Golden Blount, Inc. ("Blount") is a corporation organized and existing under the laws of the State of Texas and having a place of business in Dallas, Texas.
2. Prior to 1993, Blount made, used and sold gas log sets including a pan burner, grate, ceramic logs and simulated embers. Such gas log sets were adapted to be installed in a fireplace with the pan burner, comprising an open frame pan supporting a primary burner tube, positioned below the grate, with the grate supporting the ceramic logs. The pan burner was covered with the simulated embers. The pan burner was connected to a gas source with a gas flow valve for controlling gas flow into the primary burner tube to produce flame in the simulated embers and proximate the ceramic logs.
3. In about 1993, Blount developed an optional accessory for its gas log sets, referred to as a Controlled Ember-Bed Burner, comprising a connector tube for connecting

to the pan burner, with a gas control valve positioned in the connector tube, and a secondary burner tube adapted to be positioned forward of and below the primary burner tube. The secondary burner tube produced a flame forwardly of the primary burner tube.

4. On May 17, 1993, Blount filed United States application number 08/061,727 entitled "Controlled Ember Bed Burner." That application describes a secondary burner for optional use with an artificial log system. The secondary burner is positioned in front of and below the log system. The claims of the '727 application were rejected and the application was abandoned.

5. Prior to abandonment of the '727 application, Blount filed United States patent application number 08/276,894 entitled "Supplemental Burner for Retrofitting to an Existing Gas Log Burner Assembly" as a continuation-in-part of the '727 application. The '894 application included 18 claims. Claim 1 specified a supplemental burner for retrofitting to an existing gas log burner assembly having a primary burner tube with a terminal end, the supplemental burner comprised a connector attached to the terminal end of the primary burner tube; a supplemental burner tube attached to the connector; and a valve interposed between the supplemental burner tube and the connector. All of the claims were rejected as obvious over Eiklor, et al., U.S. Patent No. 5,033,455 in view of Peterson, U.S. Patent No. 3,042,109 and Henry, U.S. Patent No. 3,871,355. Blount submitted a declaration of Golden Blount, the inventor, alleging commercial success of the invention. In an advisory action mailed April 30, 1996, the United States Patent and Trademark Office indicated that the applicant's arguments were not persuasive noting that

"This combination of references when compared to the claims at issue leaves very little to differ over. Thus, the secondary

considerations when considered in the light of this difference carries much less weight in affecting a decision of patentability.”

A notice of abandonment of the '894 application was mailed on May 30, 1996.

6. On April 2, 1996, Blount filed U.S. application number 08/626,498 as a continuation-in-part of the '894 application.

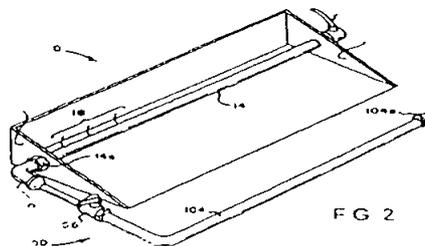
7. In an amendment filed on July 10, 1998, in connection with the '498 application, Blount argued against rejection of the claims as follows:

“Thus, as now claimed in amended claims 1-17, the assembly includes a flow control means for controlling gas flow into the primary burner tube with an additional valve for adjusting gas flow to the secondary burner tube.”

In distinguishing over the cited Eiklor, et al., Peterson and Henry references, Blount stated that:

“However, this combination of references in no way suggests the incorporation of an additional valve between the primary and the secondary burner tubes . . . Even if all of the references are combined as suggested by the Examiner, there is still no valve disposed between the primary and secondary burner to control gas flow into the secondary burner.”

8. The '498 application ultimately issued as U.S. Patent No. 5,988,159, the patent at issue herein. The following figure illustrates the burner:



9. Independent Claim 1 of the '159 patent differed from the rejected claims of the '894 application, in part, in specifying:

(a) a support means for holding a primary burner tube in a raised level relative to a forwardly positioned secondary burner tube;

(b) the secondary burner tube including gas discharge ports directed away from the fireplace opening; and

(c) a valve for adjusting gas flow to the secondary burner tube being positioned in a tubular gas connection means.”

Independent claim 17 of the '159 patent differed from the rejected claims of the parent '894 application, in part, in specifying:

(a) a secondary burner tube being positioned substantially parallel, forward and below a primary burner tube;

(b) a connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve; and

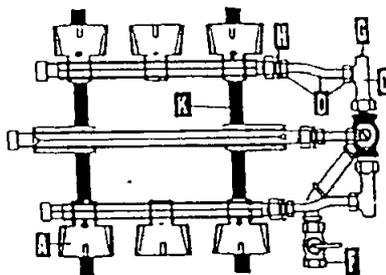
(c) gas distribution ports of the secondary burner tube being directed away from the fireplace opening.

10. Blount does not make, use or sell a gas log set preassembled with the Controlled Ember-Bed Burner. Blount sells the Controlled Ember-Bed Burner as an optional accessory for its gas log sets.

11. Defendant Robert H. Peterson Co. (“Peterson”) is a corporation organized under the laws of the State of California and has its principal place of business in City of Industry, California.

12. Since about 1949 Peterson and its predecessors have manufactured and sold gas log sets, including burners, grates and ceramic logs. Since about 1970, Peterson has manufactured and sold gas log sets including a grate, ceramic logs, simulated embers and a glowing embers burner referred to as the G4 burner system. The G4 burner system includes a grate, burner pan and simulated embers. The burner pan includes a pipe having downwardly directed openings. The burner pan is adapted to be connected via a control valve to a gas source. The G4 burner system is generally as described in Pulone, U.S. Patent No. 3,583,845, issued June 8, 1971.

13. In the 1960's, Peterson began to develop see-thru and circular (3-sided) gas log sets first using Peterson's F burner (called Front Flame or Tri-Flame). The F burner directs the flame to the front of a gas log set. This burner system was used in combination with various gas flow control valves including valves referred to as hearth elbows. The following figure is one example:



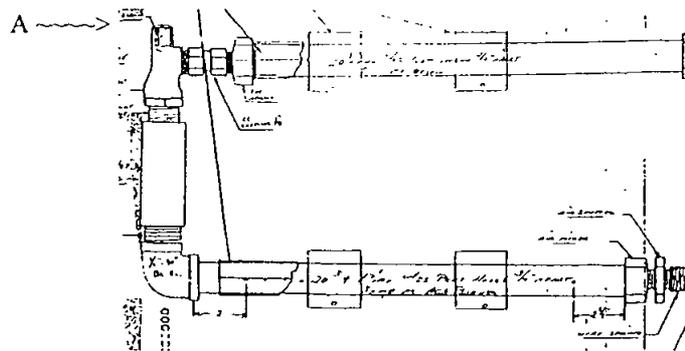
All of these valves/hearth elbows, one of the two shown is labeled G in the figure, are adjustable either with a handle or an internal screw which regulates the flow of a burner.

Peterson used these valves /hearth elbows in combinations depending on whether the unit was single-face, see-thru or circular, and on how many burners were most marketable, while retaining safety certification or testing. Peterson used several burners in one gas log set hooked up together, from the main gas supply along with several valves/hearth elbows (sometimes two for one individual burner), to direct and adjust flame and to control noise.

14. P Flame Pan burners became popular in the early to mid-70's. The P flame pan burner consisted of a burner pan supporting a pipe covered with granules and glowing embers to allow flame to erupt over the entire pan surface surrounding the gas log. Some individual Flame Plans had two pipe burners.

15. To certify for use in certain areas of the United States, certain combustion requirements must be met. This was accomplished on a P Flame Pan burner system with burner pipes or tubes in the front, middle, and back of the unit. Some versions were tested and listed or certified by either AGA, CGA, GAL or RADCO. Peterson also put single P burners together in sequence for special fireplace situations. In all of these cases, valves or hearth elbows were used to regulate the flow of gas.

16. Peterson developed a U-shaped burner for see-thru fireplaces, peninsula, and certain open free-standing fireplaces in the early 1980's. In about 1983, Peterson manufactured and sold gas fireplace assemblies having a U burner with primary and secondary burners in which a gas valve in the form of a hearth elbow was disposed between the primary and secondary burners with an opposite end of the primary burner to be connected to a gas source. This version, illustrated below, enabled adjusting the flame higher or lower to the front by using the hearth elbow valve A.



17. Peterson's J burner system (with upper and lower burners) began development in the early 1990's. During this period and for a few years before 1990, several gas log and/or gas fireplace manufacturing companies began to market dual and triple burner gas log sets. Many have valves or elbows to regulate flow.

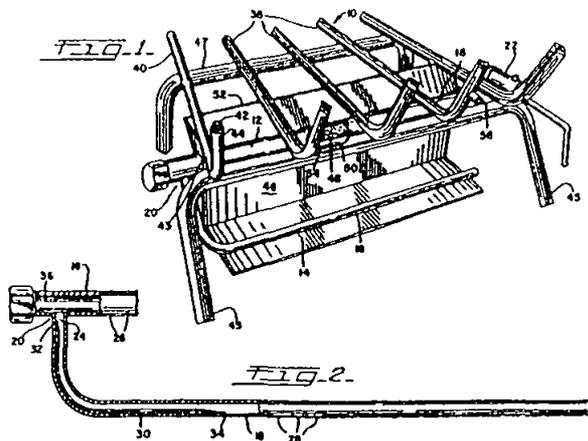
18. Peterson continued to improve its double and triple burners, especially the J burner. Peterson began experimenting with further burner systems, similar to the Ember Flame Booster, at the request of customers, in the early 1990's, especially those in the

Southeastern United States. Several prototypes were developed. In 1997, Peterson decided to offer the Ember Flame Booster as a catalog product and therefore had it certified by AGA and listed by RADCO.

19. The Ember Flame Booster is sold as an accessory for a G4 burner system or preassembled in a G5 series log set. Peterson's G4 burner system with the Ember Flame Booster has gas discharge ports in the secondary burner tube of the Ember Flame Booster which are positioned above the height of the gas discharge ports on the primary burner pipe of the G4 burner system.

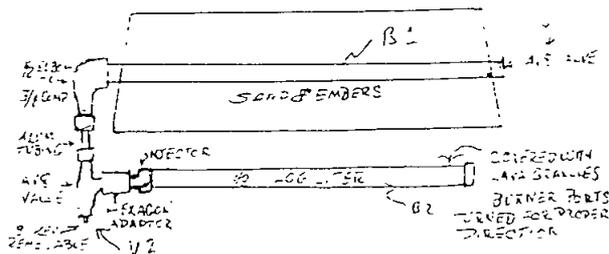
20. The Peterson G4 burner system with the Ember Flame Booster has gas discharge ports in the burner tube of the Ember Flame Booster which are directed vertically downwardly.

21. Eiklor, et al., U.S. Patent number 5,033,455 discloses a gas fired artificial log burner including a grate for supporting gas logs, a primary burner tube 16 including a plurality of gas discharge ports and a secondary burner tube 18.



A grate holds the primary burner tube in a raised level above the forward position of the secondary burner tube. The secondary burner tube includes a plurality of gas discharge ports. The primary burner tube and secondary burner tube communicate through a tubular connection. The tubular connection has a regulatory orifice 24 selected from one of two different sizes to control volume and pressure of gas being fed into the secondary burner tube. The primary burner tube is in communication with a gas source having a gas flow control means for controlling gas flow into the primary burner tube. In use, silica sand covers the secondary burner tube so that resulting flames create the illusion of a conventional, wood-burning fireplace with glowing embers on the sand.

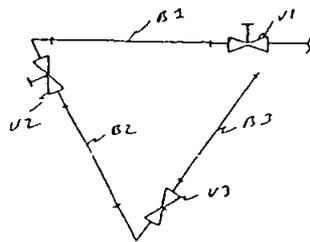
22. During the late 1970's, a dual burner system was known and in public use at the Fyreside Shopp, Inc. in New Jersey consisting of first and second burners and first and second valves, below.



The first burner B1 consisted of a Peterson G4 burner system. The second burner B2 consisted of a starter burner in front of the first burner. The first valve V1 was connected between a gas inlet connector and the first burner. The conventional end cap for the G4 burner system was removed and an elbow, an adapter and a second valve V2 were connected

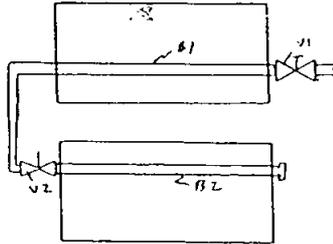
between the first burner and the second burner. The first valve controlled the amount of gas flowing into the first burner. The second valve controlled the flow of gas from the first burner to the second burner to separately control the front flame.

23. Between at least 1987 and 1993, a triangular burner system and a dual burner system were known and in public use at a company now known as Summit-Fyreside in New Jersey. The triangular burner system included three individual burners connected in a series in a triangular configuration with a control valve connected at the inlet to each burner.



The three burners typically consisted of Peterson G4 burner systems in which a burner pipe was covered with simulated embers. Thus, the first valve V1 controlled the amount of gas flowing into the first burner B1. The second valve V2 controlled the flow of gas from the first burner B1 into the second burner B2. The third valve V2 controlled the flow of gas from the second burner B2 into the third burner B3.

24. The dual burner system of Summit-Fyreside consisted of first and second Peterson G4 burner system and first and second valves, below.



The first valve V1 was connected between a gas inlet connector and the first burner B1. The conventional end cap for the G4 burner systems was removed and the second valve V2 connected between the first burner B1 and the second burner B2. Thus, the first valve controlled the amount of gas flowing into the first burner. The second valve controlled the amount of gas flowing from the first burner to the second burner.

25. Peterson first learned of the existence of the '159 patent in December 1999 when it received a letter from a firm representing Blount.

26. Peterson was not notified of alleged infringement of the '159 patent until on or about May 9, 2000, when it received another letter from the attorney for Blount.

27. On or about December 29, 1999, Peterson received an opinion of counsel that if it could prove that Peterson had been selling a burner system substantially similar to the G4 burner system and Ember Flame Booster for about 20 or 30 years, then Peterson would not be liable for any possible infringement of the '159 patent.

28. On or about February 14, 2001, Peterson received an opinion of counsel that it did not literally infringe any claims of the '159 patent, and that at least some of the claims

were invalid based on obviousness.

29. On or about May 10, 2001, Peterson received an opinion of counsel that the Ember Flame Booster in combination with the G4 burner system did not infringe, literally or under the Doctrine of Equivalents, any of claims 1 through 18 of the '159 patent.

30. Peterson has, since prior to 1999, made, used, and sold a front flame director for use with the G4 burner system for directing flame over the front of the gas log set.

#### PROPOSED CONCLUSIONS OF LAW

31. The scope of the claims at issue in the '159 patent is limited to burner systems having a primary burner tube and a secondary burner tube in which the secondary burner tube is positioned entirely below the primary burner tube. Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed. Cir 1995), aff'd 517 U.S. 370 (1996).

32. The scope of the claims at issue in the '159 patent is limited to burner systems having a primary burner tube and a secondary burner tube in which the gas discharge ports of the secondary burner tube are positioned below the gas discharge ports of primary burner tube. Markman

33. The scope of claim 17 of the '159 patent is limited to burner systems having a primary burner tube and a secondary burner tube in which the gas discharge ports of the secondary burner tube are directed rearwardly toward the primary burner tube and not directed vertically. Markman

34. Claim amendments made to independent claims 1 and 17 of the '159 patent with respect to rejected claims of parent application number 08/626,498 creates prosecution

history estoppel with regard to amended claim elements and there is no range of equivalents available for the amended claim elements. The application of the Doctrine of Equivalents to the amended claim elements is completely barred. Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., 234 F.3d 558, 569 (Fed. Cir. 2000).

35. Because limitations were added to every claim in issue during the prosecution of the '159 patent, including its parent applications, Blount is precluded from arguing infringement under the Doctrine of Equivalents regarding the relative height of primary and secondary burners, or the relative direction of the gas distribution ports of the secondary burner. Id.

36. Each claim in the '159 patent is invalid as anticipated under 35 U.S.C. § 102(a) by prior art fireplace assemblies known or used by others in the United States before the invention of Blount, and under 35 U.S.C. § 102(b) by prior art fireplace assemblies in public use and on sale in the United States, particularly including those of Peterson and its distributors, more than one (1) per year prior to the filing date of the '159 patent. Advanced Display Sys. v. Kent State Univ., 212 F.3d 1271, 1282 (Fed. Cir. 2000); PPG Indus., Inc. v. Indus. Corp., 75 F.3d 1558, 1566 (Fed. Cir. 1996); Lewmar Marine, Inc. v. Barient, Inc., 827 F.2d 744, 747 (Fed. Cir. 1987); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1379 (Fed. Cir. 1986); Polaroid Corp. v. Eastman Kodak Co., 789 F.2d 1556, 1573 (Fed. Cir. 1986).

37. The only apparent structural difference between the prior art cited during prosecution and the claimed subject matter of the '159 patent was the use of a valve between the primary and secondary burners, and the use of such valves was commonly known.

There is no apparent causal connection between secondary factors and the claimed invention and the secondary factors are to be given little or no weight. United States Surgical Corp. v. Ethicon, Inc., 103 F.3d 1554, 1563-65 (Fed. Cir. 1997); Ashland Oil, Inc. v. Delta Resins & Refractories, 776 F.2d 281, 306 (Fed. Cir. 1985), cert. denied 475 US 1017 (1986).

38 The prior art cited during prosecution of the '159 patent, particularly the Eiklor, et al. '455 patent, substantially showed the claimed invention, including a primary burner tube and a secondary burner tube mounted in front of and below the primary burner tube. In Eiklor, et al., a regulatory orifice 24 is selected from one of two different sizes to control volume and pressure of gas flow from the primary burner tube 16 to the secondary burner tube 18. The prior art burner systems of Peterson and one or more third parties show that use of valves for controlling gas flow to individual burners was commonly known prior to Blount's alleged invention. By definition, a valve is an adjustable orifice. Blount distinguished the Eiklor et al. patent because it did not show an additional valve to the secondary burner. Such additional valves were commonly used for the same purpose by Peterson and other third parties. There is therefore a suggestion to combine the prior additional valves, i.e., adjustable orifices, with the burner system of Eiklor, et al., to make the selectable orifice adjustable. Each and every claim in issue in the '159 patent is rendered obvious under 35 U.S.C. § 103 by prior art fireplace assemblies described in patents cited during the prosecution of the '159 patent in view of prior art fireplace assemblies sold by Peterson and one or more third parties. Graham v. John Deere Co., 383 U.S. 1 (1966).

Oil, Inc. v. Delta Resins & Refractories, 776 F.2d 281 (Fed. Cir. 1985), cert. denied 475 US 1017 (1986).

39. Blount did not provide notice to Peterson that its activities were infringing until on or about May 9, 2000, and therefore may not recover damages prior to that date. 15 U.S.C. § 287; Nike v. Wal-Mart Stores, Inc., 138 F.3d 1437, 1446 (Fed. Cir. 1998); Maxwell v. J. Baker, Inc., 86 F.3d 1098 (Fed. Cir. 1996); Armsted Industries, Inc. v. Buckeye Steel Castings Co., 24 F.3d 178, 187 (Fed. Cir. 1993); American Medical Systems, Inc. v. Medical Engineering Corp., 6 F.3d 1523 (Fed. Cir. 1993); Refac Electronics Corp. v. A&B Beacon Business Machines Corp., 695 F.Supp. 753 (S.D.N.Y. 1988).

40. Because there are a substantial number of parties selling acceptable non-infringing alternatives to the '159 patent product Blount is not entitled to damages of lost profits. Under the facts of this case, Blount's damages are limited to a reasonable royalty from the sale of secondary burners only. Panduit Corp. v. Stahlin Bros. Fibre Works, Inc., 575 F.2d 1152 (6th Cir. 1978); Gyromat Corp. v. Champion Spark Plug Co., 735 F.2d 549 (Fed. Cir. 1984).

41. Because artificial log systems with primary burners have separate usefulness without optional secondary burners, the entire market value of artificial log systems with secondary burners is not attributable to the patented features and Blount's damages are limited to sales only of secondary burners. Rite-Hite Corp. v. Kelley Co., 56 F.3d 1538, 1549 (Fed. Cir. 1995).

42. Because Peterson independently designed the accused product; the closeness of the legal and factual questions presented by Blount's allegations of patent infringement; and Peterson obtained and followed competent legal advice in a timely fashion, Peterson did not willfully infringe the '159 patent. SRI Int'l v. Advanced Tech Laboratories, 127 F.3d

1462, 1464-1465 (Fed. Cir. 1997); National Presto Indus. v. West Bend Co., 76 F.3d 1185, 1193 (Fed. Cir. 1996); BIC Leisure Products v. Windsurfing Int'l, 1 F.3d 1214, 1223 (Fed. Cir. 1993); E.I. DuPont De Nemours and Co. v. Monsanto Co., 903 F.Supp. 680, 742 (D. Del. 1995).

Respectfully submitted,

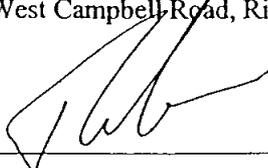
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CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing document was served by first-class mail, postage prepaid, to counsel for Plaintiff, William D. Harris, Jr., Hitt Gaines Boisbrun, P.C., 225 University Plaza, 275 West Campbell Road, Richardson, Texas 75080, this 19<sup>TH</sup> day of April, 2002.



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JT-APP 0345

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	Civil Action No.
	§	
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

PLAINTIFF'S ISSUE DIRECTED TRIAL BRIEF

The following is abbreviated to address what are deemed principal issues in the hope of achieving brevity and clarity. Only the significant areas for decision will be addressed:

(A) SUMMARY

The patent in suit is United States Patent No. 5,988,159 (the '159 Patent), entitled "GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY." The '159 Patent was filed as a continuation in part on April 2, 1996, basing its priority on a patent application originally filed on May 17, 1993. The '159 Patent issued on November 23, 1999. One Golden Blount is the inventor of the '159 Patent, and presently, the '159 Patent is assigned to Golden Blount, Inc.

The '159 Patent is directed to, and claims, a highly efficient artificial logs and coals-burner assembly for use with artificial, decorative logs and glowing coals and embers. The artificial logs and coals-burner assembly provides control for the glowing coals and embers independently of the gas logs burn. The '159 Patent accomplishes this by attaching and positioning a secondary coals burner

elongated tube forward and below a primary burner tube. The secondary coals burner elongated tube provides a flame out in front of the artificial logs where it lies at a level to inflame small artificial embers and sand on the front hearth portion. This effect more closely approximates the look of a wood burning fireplace. In fact, the artificial coals or embers appearance is greatly enhanced.

The '159 Patent also suggests (i.e., claims) providing a valve between the primary burner tube and the secondary coals burner elongated tube. The valve allows the user to selectively increase the amount of gas being burned forward the artificial logs. This control makes available a greater introduction of radiant heat to the room, than might be afforded using only a conventional primary burner tube. Consequently, the '159 Patent provides an efficient artificial logs and coals burner assembly that provides a flame out in front of the artificial logs, which more closely approximates the look of a wood burning fireplace, as well as provides a greater amount of radiant heat to the room in which it is located.

The Defendants were made aware of the '159 Patent on December 16, 1999, by a letter of December 10, 1999, from L. Dan Tucker (attorney for Plaintiff) to the President of Robert H. Peterson Company. The Defendants responded to the letter of December 16, 1999, but merely sent a put-off letter from Tod M. Corrin to L. Dan Tucker on December 30, 1999. The Defendants have continued to market, manufacture, sell and offer to sell the infringing device since receiving the letter from L. Dan Tucker on December 16, 1999. They did not seek a legal opinion until after suit was filed.

(B) CLAIM INTERPRETATION

The claims of the invention are to be interpreted as a matter of law. *Markman v. Westview*

*Instruments, Inc.*, 52 F.3d 967, 34 U.S.P.Q.2d 1321 (Fed. Cir. 1995). The following interpretation is believed proper in the areas of question, with those areas believed to be fully self-explanatory containing no formal interpretation:

CLAIM 1:

- a) The preamble requires a gas environment as opposed to a wood burning environment;
- b) The terms used herein are self-explanatory;
- c) The word coals is meant to cover the secondary coals burner elongated tube that is designed or adapted to make the coals or embers enhanced in appearance;
- d) The elongated primary burner tube is held up by the side of the pan through which the elongated primary burner tube extends. The elongated primary burner tube is at a raised level with respect to the secondary coals burner elongated tube (e.g., with respect to the centerline).
- e) The terms used herein are self-explanatory;
- f) The terms used herein are self-explanatory;
- g) The valve is located between the connection to the elongated primary burner tube and the connection to the secondary coals burner elongated tube;
- h) The gas flow control means is the common valve in every gas fed fire place.

CLAIM 13: The valve is located between the connection to the elongated primary burner tube and the connection to the secondary coals burner elongated tube;

CLAIM 17: Away from includes any direction that does not include a horizontal component pointed toward the vertical plane of the fireplace opening, with the exception that the plurality of gas discharge ports should not point substantially vertically upward because sand and embers may fall therein.

(C) INFRINGEMENT

- (1) Literal Infringement requires that every element of a claim be included in the infringing device. 35 U.S.C. 271(a) Every element of the claims at issue may be found in the Defendant's infringing device. Consequently, the Defendant is infringing the '159 Patent under 35 U.S.C. 271(a).
- (2) Whoever actively induces infringement of a patent shall be liable as an infringer. 35 U.S.C. 271(b) *Fromberg v. Thornhill*, 315 F.2d 407 (5th Cir.

1963). The Defendant has induced distributors and consumers to infringe the '159 Patent. Consequently, the Defendant is infringing the '159 Patent under 35 U.S.C. 271(b).

- (3) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer. 35 U.S.C. 271(c) *Dawson Chemical Co. v. Rohm and Haas Co.*, 448 U.S. 176, 100 S.Ct. 2601, 65 L.Ed. 696 (1980). As the Defendant knew, the device sold by the Defendant has no use other than an infringing use, it not a staple article of commerce, and it is especially adapted to infringe, and it is a material and essential part of the invention. Consequently, the Defendant is infringing the '159 Patent under 35 U.S.C. 271(c).

- (4) Infringement under the doctrine of equivalence. If there are any departures from literal infringement they are slight indeed. They are insubstantial. *Graver Tank v. Linde Air Products*, 339 U.S. 605, 70 S.Ct. 854, 94 L.Ed 1097 (1950). The doctrine is available because there is no prosecution history estoppel, per the admission of the Defendant's counsel when under oath.

## (D) VALIDITY

- (1) There is/are no prior use, prior sale or prior art that invalidates the patent.
- (2) No pertinent documents exist of any kind, except perhaps of recent reconstruction or fabrication. Those recently constructed documents only include sketches of an alleged prior art product, the sketches of which were made by a distributor at the direction of an employee of Defendant and with the assistance of the employee. The nature and the structure of the prior product is speculative and vague. Such alleged prior product and its sales do not meet the standard of clear and convincing evidence to qualify as prior art.
- (3) Additionally, the illustrated structures that bear Production No. 33 and Production No. 34 are but sketches and they are not really of items that are analogous to the ember (coals) burner of the claimed invention. The alleged prior art burners are each of the same size, and moreover, there is no support means shown or suggested. Each of the burners have center lines that are level with respect to one another. Also the deposition testimony of Defendant suggests that these alleged prior art burners were used for a so-called "see through" fireplace, where like burner effects was wanted on each side. As to all the purported art referred to above, it is not believed proved by clear and convincing evidence. It is much like the barb wire case, where many many witnesses sought to show prior structures and sales, but the inventor's patent stood up against the multitude because of lack of solid proof. *The Barbed Wire Patent*, 143 U.S. 275, 12 S.Ct. 443, 36 L.Ed. 154 (1892).

- (4) The other prior art offered is simply not considered in point, although it is considered anyway in the statement just below.
- (5) Considering all of the art, there is no anticipation of the patent claims in suit. There is no one qualified reference that within its four corners is substantially the same as the invention.
- (6) The prior art does not render the invention obvious to one of ordinary skill in the art, as will be analyzed in paragraph 7 below, applying the time proven test of *Graham v. John Deere*: determine the scope and content of the prior art; identify the differences between the invention and the prior art; determine the level of skill in the prior art; and address whether or not the differences are obvious. *Graham v. John Deere*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). All this analysis should be done realizing that patents are presumed valid and that the burden to overturn them is substantial—requiring clearly convincing evidence.
- (7) (a) The claimed invention is quite different from any of the references cited. As an example, the claimed burner assembly is configured with an auxiliary front burner, which co-functions with the main burner, and is structured and adapted to extend outwardly to enliven artificial material on the hearth to make it appear as glowing embers or coals at the front of the logs. Such a system attempts to closely approximate the appearance of a wood burning fireplace.
- (b) The level of skill in the art is modest; a person with only several years

experience, perhaps 5 years, would approximate this level - - This

becomes a definition of a person of ordinary skill in the art.

(c) It is believed that the differences would not be obvious to one of ordinary skill in the art.

(8) As secondary factors, the Plaintiff's commercial embodiment of the invention has been a commercial success since its introduction in about 1994. It has met a need that has long existed. Further, it has been imitated by Defendant. The foregoing secondary factors bolster the case for validity.

(9) Clear and convincing evidence is required to invalidate the pertinent patent claims. Such evidence has not been presented. The pertinent claims are therefore valid.

(10) The patent is valid and infringed

(E) WILLFUL INFRINGEMENT

(1) Defendant was given notice by letter of December 10, 1999, received on December 16, 1999.

(2) Defendant made a less than earnest effort to obtain a prompt opinion.

(3) After being reminded a second time by Plaintiff, Defendant took no steps to stop its infringement or to get a definitive opinion.

(4) Defendant did not get an opinion until after suit was filed in January, 2001, which was over a year after notice. Additionally, the opinion was oral and was given without the attorney inspecting the accused product. This was the

case even though the Company officer following the matter was also located in Chicago, and located only a short distance from the attorney's office. Amazingly, the Company office and the attorney never saw each other until depositions were taken in the suit. In short, the attorney was furnished with inadequate information, and the Defendant did not make a substantial effort to provide the adequate information required to render a reasonable opinion. In actuality, the Company officer merely sought an opinion of counsel (per deposition testimony) because he had heard that such an opinion could protect him from attorneys fees (or other damages).

- (5) The similarity of the Defendant's product to the patented product, as well as the timing of Defendant's product entry into the market (i.e., after Plaintiff's product had already entered the market), raises an inference of copying.

#### F. DAMAGES

- (1) Damages are assessed from December 16, 1999, the date of which Defendant was made aware of the patent and their infringement. The damages are the lost profits of Plaintiff. *Panduit Corp. v. Stahlin Bros. Fibre Works, Inc.*, 575 F.2d 1152, 197 U.S.P.Q. (BNA) 726 (6th Cir. 1978). See also, *State Industries v. Mor-Flo Industries, Inc.*, 883 F.2d 1573, 12 U.S.P.Q.2D (BNA) 1026 (1989) or *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538 (Fed. Cir. 1995). The figures will be proved at the trial. Note that the damages include the lost profits on so-called "convoyed" products, also known as the entire market

value rule.

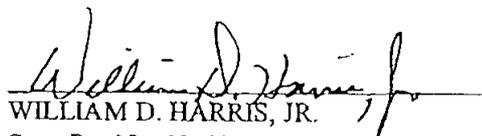
- (2) The damages should be trebled under 35 U.S.C. 285, [or 284]
- (3) This being an exceptional case, reasonable attorneys fees should be awarded to Plaintiff.

(G) INJUNCTION

- (1) As is usually the case where the Plaintiff has prevailed in a patent case, the infringing Defendant is enjoined from further infringement. 35 U.S.C. 283 *Smith International, Inc. v. Hughes Tool Co.*, 718 F.2d 1573 (Fed Cir. 1983), *cert. denied*, 104 S.Ct. 493 (1988). For permanent injunctions in a patent and infringement case, the injunctive relief is considered a matter of right.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



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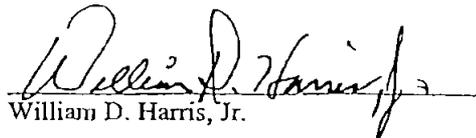
972/480-8865 (Facsimile)

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Plaintiff's Issue Directed Trial Brief was served on the following counsel of record on April 19, 2002, by first class mail and facsimile:

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William D. Harris, Jr.

WOOD, PHILLIPS, ET AL

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JT-APP 0356

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

PLAINTIFF GOLDEN BLOUNT INC.'S  
SUBSTITUTE LIST OF EXHIBITS

The following list is Plaintiff's effort to comply with paragraph 2.c. of the Court's Amended Scheduling Order (each party's list of exhibits) dated February 27, 2002. Please note, the only difference between plaintiff's substitute list of exhibits and plaintiff's original list of exhibits is the inclusion of a video comparison of plaintiff's and defendant's devices.

- Document Bates Number B1213
- Document Bates Number B1554
- Document Bates Numbers B1555-B1559
- Document Bates Number 000015
- Document Bates Number 000016
- Document Bates Number 000050
- Document Bates Numbers 000051-000053
- Various Boards, Charts and Video Tape as follows:

- Trial Board Exhibit or overheads illustrating elements (and structures) of Defendant's device versus the claim language of the '159 Patent, and also including an illustration and comparison of the elements (and structures) of the Plaintiff's device.

Annotated drawings may be used to illustrate aspects of the foregoing.

- Trial Board Exhibits or overheads illustrating total sales in number and dollar amount of Plaintiff's log sets/assembly burner sets/secondary coals (ember) burner sets.
- Trial Board Exhibits or overheads illustrating total sales in number and dollar amount of Defendant's log sets/assembly burner sets/secondary coals (ember) burner sets.
- Trial Board Exhibits or overhead illustrating the actual damages in number of devices sold by Defendant multiplied by Plaintiff's profit per device.
- Video demonstration comparing Plaintiff's working log and assembly burner set (with and without its secondary coals (ember) burner operating) to Defendant's working log and assembly burner set (with and without its secondary coals (ember) burner operating).
- A comparison of Defendant's log and assembly burner set with the secondary coals (ember) burner set to Defendant's log and assembly burner set without the secondary coals (ember) burner set (illustrations taken directly from Defendant's website).

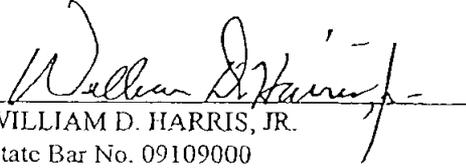
- Plaintiff's Commercial Device Covered by the Claims of the '159 Patent
- Defendant's Commercial Device that Allegedly Infringes the '159 Patent

JT-APP-0358

- Document Bates Numbers B0001-B0726
- Document Bates Number 000017
- Document Bates Numbers 000018-000019
- Document Bates Numbers 000033-000034
- Certified File Wrapper of the '159 Patent
- Current Sales Brochure Illustrating Defendant's Marketed Device
- Defendant's 97/98 Sales Catalog
- Claim Chart Showing Claim Interpretation (As Decided by the Court)

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



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CHARLES W. GAINES

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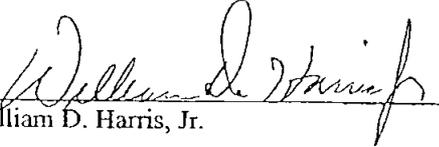
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Plaintiff Golden Blount Inc.'s Substitute List of Exhibits was served on the following counsel of record on April 19, 2002, by first class mail and facsimile:

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F. William McLaughlin  
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500 W. Madison Street, Suite 3800  
Chicago, IL 60611-2511  
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312/876-2020 (Facsimile)

  
\_\_\_\_\_  
William D. Harris, Jr.

WOOD PHILLIPS ET AL  
ATTORNEYS AT LAW  
DALLAS TEXAS

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

U.S. DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
**FILED**  
APR 22 2002  
CLERK, U.S. DISTRICT COURT  
By Deputy  
Civil Action No.

GOLDEN BLOUNT, INC., §  
Plaintiff, §  
v. §  
ROBERT H. PETERSON CO., §  
Defendant. §

3-01CV0127-R



**SUPPLEMENTAL JOINT PRETRIAL ORDER  
PURSUANT TO LOCAL RULE 16.4**

This Supplemental Joint Pretrial Order is submitted in accordance with the Court's Amended Scheduling Order dated February 27, 2002. For simplicity, Plaintiff, Golden Blount, Inc. and Defendant, Robert H. Peterson Co., only submit the following substituted sections: Substituted Statement of Stipulated Facts (substituted Section B) and Substituted Statement of Contested Issues of Fact by Golden Blount, Inc. (substituted Section C-1). Please note, the only difference between substitute Section B and original Section B, is that paragraph 9 has been added. Additionally, the only difference between substitute Section C-1 and original Section C-1, is that paragraphs 18 and 19 have been added.

Respectfully submitted,

Date: 4/19/02

*William D. Harris*  
Counsel for Golden Blount, Inc.

Date: 4/19/02

*William McLaughlin / William D. Harris Jr.*  
Counsel for Robert H. Peterson Co. *By Permission*

Date: 4/22/02

*Jerry Buchmeyer*  
Judge Jerry Buchmeyer

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
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§  
§  
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§  
§  
§  
§

Civil Action No.

3-01CV0127-R

B. SUBSTITUTE STATEMENT OF STIPULATED FACTS

Plaintiff Golden Blount, Inc. ("Golden Blount") and Defendant Robert H. Peterson Co. ("PETERSON CO.") respectfully submit the following statement of facts.

1. The parties, Golden Blount, Inc. and Robert H. Peterson Co., stipulate that copies of United States Patent No. 5,988,159 will be accepted as a true and correct copy of the original patent as issued by the United States Patent Office.

2. The parties stipulate that Golden Blount, Inc., is a Texas corporation and is the present owner of the entire interest of United States Patent No. 5,988,159, together with the right to sue and recover for past infringement.

3. The parties stipulate that copies of all brochures, websites or catalogs of Robert H. Peterson Co., will be accepted as true and correct copies of their originals as distributed by Robert H. Peterson Co., and likewise the same shall apply to the brochures, websites or catalogs of Golden Blount, Inc.

4. The parties stipulate that copies of the assignment from Golden Blount to Golden Blount, Inc., will be accepted as a true and correct copy of the assignment filed with the United States Patent Office.

5. The parties stipulate that copies of the documents produced by either party to the other during the initial discovery period are true and correct copies as produced by the producing party and that they may be treated as originals, unless error may appear.

6. The parties stipulate that Robert H. Peterson Co.'s Ember Flame Booster is intended to be attached to its G-4 series burner system or G-5 series log set and the combined unit comprises a primary burner pipe, an ember pan that supports the primary burner pipe, a secondary burner tube and a valve that controls a flow of gas between the primary burner pipe and the secondary burner tube, and that an end user would connect the primary burner pipe to a gas source having a valve associated therewith.

7. The parties stipulate that the claims that are at issue in this action are 1, 2, 5, 7-9, 11-13 and 15-17.

8. The parties stipulate that the copies of the prosecution history of U.S. Patent No. 5,988,159, including any or all continuations thereof, as well any parents thereof, will be accepted as true and correct copies of the prosecution history as kept by the United States Patent Office, unless error may appear.

9. The parties stipulate that the following letters, as set forth below, are admissible as evidence:

- A. December 10, 1999, letter from L. Dan Tucker to the President of Robert H. Peterson Company (Bates No. B1197-1198----Received on December 16, 1999);

- B. December 30, 1999, letter from Tod M. Corrin to L. Dan Tucker (Bates No. B1469-1170---Received shortly after the date upon which it was sent);
- C. May 3, 2000, letter from L. Dan Tucker to Tod M. Corrin (Bates No. B1213---Received shortly after the date upon which it was sent);
- D. May 16, 2000, letter from Terrell A. Stone to L. Dan Tucker (Bates No. B1467---Received shortly after the date upon which it was sent);
- E. January 19, 2001, letter from Roy Hardin to Tod M. Corrin (Bates No. B1462---Received shortly after the date upon which it was sent);

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GOOD PHILLIPS, ET AL.

JT-APP 0366

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

C-1. GOLDEN BLOUNT, INC's SUBSTITUTE STATEMENT OF  
CONTESTED ISSUES OF FACT

Plaintiff Golden Blount, Inc. ("Golden Blount") respectfully submits the following statement of contested issues of fact.

1. Whether claims 1, 2, 5, 7-9, 11-13 and 15-17, individually or as a group, are infringed by the accused Peterson structure, either by direct infringement, contributory infringement or inducement to infringement ( 35 USC 271). (It is submitted that the interpretation of the claims is strictly for the Court; the application of those interpreted claims to the accused device or structure is for the jury).

2. Whether claims 1, 2, 5, 7-9, 11-13 and 15-17 are valid and enforceable. (It is submitted that the ultimate determination of validity and enforceability is for the Court; there may be certain underlying facts that are for the jury).

3. Whether the patented invention, as defined by one or more claims thereof was a commercial success.

4. Whether the patented invention, as defined by one or more claims thereof met a long recognized or felt need.

5. That the Defendant's auxiliary burner was intended strictly for use with an artificial log set and that distributors sold a Peterson log set with each sale of an auxiliary burner.

6. That Peterson acted irresponsible in not promptly obtaining an opinion covering whether or not it violated the patent in suit after being accused of infringement by the Plaintiff.

7. That the ultimate opinion obtained by Peterson did not come till over a year after Peterson had notice of infringement from Blount - - - that during that entire period after its initial consideration Peterson did nothing to obtain an opinion and only sought one after it was sued.

8. That the ultimate opinion was only oral, and based on telephone conferences with Peterson's representative.

9. That the attorney had never seen an actual accused structure or device made by Peterson but relied strictly on catalog/advertisement information (even though a Peterson facility was only a short distance away in the Chicago area, where the attorney offices), and that neither the attorney nor the client made a thorough independent investigation.

10. That the oral opinion given was not adequate under the circumstances described above.

11. That the infringing conduct of Defendant was not only intentional, but wilful.

12. That the accused device was sold and offered for sale within the United States and it constitutes a component of one or more of claims 1, 2, 5, 7-9, 11-13 and 15-17 of the patent in suit (combination claims) and constitutes a material part of the patented invention claim(s); that the sales

and offering for sale were made knowing the accused structures were especially made or especially adapted for use in an infringement of such patent claim(s); that the accused device was not a staple article or commodity of commerce suitable for substantial non infringing use.

13. Peterson actively induced infringement of one or more of claims 1, 2, 5, 7-9, 11-13 and 15-17. This was accomplished by advertisements, catalogs and presentations showing how to infringe and by offers for sale and sale of devices that necessarily infringed when used.

14. That Peterson knew about the patent while it engaged in its infringing conduct.

15. That the accused Peterson device appears to be a substantial copy of the patented device sold by Blount and that such accused device was not marketed until after the Blount device had been on the market for several years.

16. That Golden Blount, Inc., has been damaged to the extent at least of lost profits for all of the sales of infringing products made by Peterson, and that Golden Blount Inc.'s damages include sales of related products made by Peterson because of the sale of the patented structure.

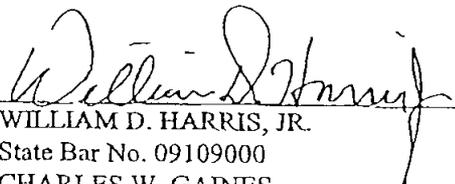
17. There is no prosecution history estoppel, as was admitted by attorney McLaughlin during his deposition.

18. Each and every element of the claims in suit, as interpreted as a matter of law, are present in the Defendant's accused structure and the claims are infringed.

19. The Defendant had notice of the Plaintiff's patent and its purported relevance to Defendants accused product as of December 16, 1999, by a letter from Plaintiff's attorney of December 10, 1999.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



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WOOD, PHILLIPS, L. A.

REPLY

JT-APP 0371

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

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Civil Action No.

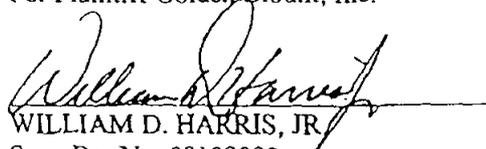
3-01CV0127-R

PLAINTIFF, GOLDEN BLOUNT, INC.'s  
OPENING CLAIM CONSTRUCTION BRIEF

Pursuant to the Court's request of May 3, 2002, Plaintiff Golden Blount submits its  
Claim Construction Brief, and supporting documents.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



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ATTORNEYS FOR PLAINTIFF

**PLAINTIFF, GOLDEN BLOUNT, INC.'s**  
**OPENING CLAIM CONSTRUCTION BRIEF**

**PREFACE**

Plaintiff, Golden Blount, Inc.'s ("Blount's") Claim Construction Brief (Markman Brief) contains several parts, which, taken together, identify and support Blount's proposed claim definitions: (1) Blount's Claim Construction Memorandum; (2) Table of Claim Terms and Blount's Proposed Constructions (attached hereto as Appendix A); (3) Table Correlating Terms and Structures Supporting Those Terms (attached hereto as Appendix B); and (4) A copy of United States Patent No. 5,988,159, the patent in suit.

The Claim Construction Memorandum is itself divided into three major sections. The Claim Construction Memorandum first recites the legal principles governing claim construction issues. It next provides a brief overview of the technology at issue, and it concludes by providing a detailed explanation supporting Blount's proposed constructions.

The Table of Claim Terms and Blount's Proposed Construction (Appendix A) provides a comprehensive list of all claims and terms, together with: (1) a listing where a discussion of each term can be found in the '159 Patent, (2) a formal discussion of each term, and (3) Blount's proposed construction of each term.<sup>1</sup>

The Table Correlating Terms and Structures Supporting Those Terms (Appendix B) is a pictorial representation of the claim language applied to the various components of the device as disclosed in the specification of Blount's patent. Its use is optional.

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<sup>1</sup> While the Plaintiff believes that only certain claim terms are in issue (each of which include a detailed discussion in the Claim Construction Memorandum), a comprehensive list of claim terms and their meaning has been provided for clarity.

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A. Proper Claim Interpretation for the '159 Patent ..... 7

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- "secondary coals burner elongated tube" ..... 8
- "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube" ..... 9
- "tubular connection means" ..... 10

2. Claim 15 of the '159 Patent ..... 11

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TABLE OF AUTHORITIES

FEDERAL CASES

*Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001) ..... 2, 3, 5

*Bell Comm. Res., Inc. v. Vitalink Comm. Corp.*, 55 F.3d 615, 621 (Fed. Cir. 1995) ..... 3

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*Enercon GmbH v. United States Int'l Trade Comm'n*, 151 F.3d 1376, 1384 (Fed. Cir. 1998), *cert. denied*, 526 U.S. 1130 (1999) ..... 2

*Hockerson-Halberstadt, Inc. v. Avia Group Intern., Inc.*, 222 F.3d 951, 955 (Fed. Cir. 2000) ... 3

*Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1332 (Fed. Cir. 2001) ..... 5

*Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1426 (Fed. Cir. 1997) ..... 2

*Kopykake Enterprises, Inc. v. Lucks Co.*, 264 F.3d 1377, 1383 (Fed. Cir. 2001). .... 2

*Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996). .... 1

*Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) ..... 5

*Pall Corp. v. PTI Technologies, Inc.*, 259 F.3d 1383, 1393 (Fed. Cir. 2001) ..... 3, 4

*Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999) ..... 2

*Renishaw PLC v. Marposs Societa' per Aziona*, 158 F.3d 1243, 1249-50 (Fed. Cir. 1998) ..... 3

*Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995) ..... 4

*Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996) ..... 2-5

*Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1197 (Fed. Cir. 1994) ..... 3

*York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1575 (Fed. Cir. 1996) . 4

*Zenith Lab. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir.), *cert. denied*, 513 U.S. 995 (1994). ..... 1

**FEDERAL STATUTES**

35 U.S.C. § 112, ¶ 6 ..... 5

## I. SCOPE OF THE BRIEF

The text of this brief is directed to construing terms that may be in dispute and to terms that would benefit from overall clarity if construed. Appendix A is a detailed analysis, term by term, covering matters believed to be in issue and matters not in issue. It is presented for purposes of consideration and for the minimal possibility that the Court may want to consult it for a term that was not covered in the text of the brief. Appendix B is a pictorial representation of the claim language applied to the various components of the device, and according to the Court's discretion, may or may not be used.

## II. INTRODUCTION

A United States Patent includes a specification that contains a written description and drawings explaining and generally describing the invention, and concludes with numbered paragraphs called "claims." These claims set "the metes and bounds of the invention entitled to the protection of the patent system."<sup>2</sup> In certain cases, the words in a claim may be susceptible to different meanings. The process by which the proper meaning of a claim term is determined is called claim construction, and because claim construction is a legal determination, it must be conducted by the trial court (typically at what is called a Markman hearing).<sup>3</sup>

The Federal Circuit has carefully defined the process by which a court should construe patent claim terms. The analysis always begins with a review of the language of the claims and an assessment of what those terms typically mean to one of ordinary skill in the relevant technology. The Federal Circuit also proclaims that courts should examine the rest of the intrinsic evidence—the patent specification (which includes the drawings) and prosecution history—to determine whether the inventor has defined, expressly or by implication, terms used in the claims. The process ends here if there is no doubt as to the terms meaning. On occasion when the court needs a tutorial or some added understanding of the subject matter, the court may turn to evidence extrinsic to the patent documents (e.g., expert testimony). However, a court may never use such extrinsic evidence to vary or contradict what the intrinsic evidence teaches.

<sup>2</sup> *Zenith Lab. v. Bristol-Myers Squibb Co.*, 19 F.3d 1418, 1424 (Fed. Cir.), cert. denied, 513 U.S. 995 (1994).  
<sup>3</sup> *Markman v. Westview Instruments, Inc.*, 517 U.S. 370 (1996).

The Plaintiff, Blount, proposes definitions that are consistent with the disclosure contained within the patent and its prosecution history. Because Blount applies legally correct and well-settled claim construction principles mandated by the Federal Circuit, the Court should adopt Blount's proposed claim definitions. In the present case, it is believed that the claim construction may be completed with intrinsic evidence only.

### III. LEGAL CONSIDERATIONS IN INTERPRETING PATENT CLAIMS

Patent claims should be construed from the vantage point of one of ordinary skill in the art at the time the patent was filed.<sup>4</sup> Two types of evidence usually arise during claim construction—intrinsic evidence and extrinsic evidence. Intrinsic evidence consists of the patent's claims, its specification (including drawings), and its prosecution history (including cited art), whereas extrinsic evidence is "evidence which is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles."<sup>5</sup>

When construing claim terms, courts should refer to all of the intrinsic evidence.<sup>6</sup> Such intrinsic evidence is the "most significant source of the legally operative meaning of disputed claim language."<sup>7</sup> In most instances the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In those cases, it is improper to refer to extrinsic evidence.

By way of contrast, courts may only rely on extrinsic evidence to ensure that the claim construction is consistent with clearly expressed, plainly apposite, and widely held understandings in the pertinent technical field.<sup>8</sup> Extrinsic evidence can never be the source of a claim construction that varies, contradicts, expands, or limits a definition that is expressed, even by implication, in the intrinsic evidence.<sup>9</sup>

<sup>4</sup> *Kopykake Enterprises, Inc. v Lucks Co.*, 264 F.3d 1377, 1383 (Fed. Cir. 2001).

<sup>5</sup> *Vitronics Corp. v. Conceptoronic, Inc.*, 90 F.3d 1576, 1584 (Fed. Cir. 1996); *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1308 (Fed. Cir. 1999), *Kegel Co. v. AMF Bowling, Inc.*, 127 F.3d 1420, 1426 (Fed. Cir. 1997).

<sup>6</sup> *Vitronics*, 90 F.3d at 1582; *Bell Atlantic Network Services, Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001); *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1324 (Fed. Cir. 2001).

<sup>7</sup> *Vitronics*, 90 F.3d at 1582.

<sup>8</sup> *Pitney Bowes*, 182 F.3d at 1309

<sup>9</sup> *Bell Atlantic*, 262 F.3d at 1269

A. Claim Construction Must Follow All of the Intrinsic Evidence

Claim terms are “to be interpreted so as to give the terms their ordinary meaning, absent some clear special definition.”<sup>10</sup> Courts cannot, however, look at the ordinary meaning (if one in fact exists) of a claim term in a vacuum; rather, courts review the ordinary meaning in the context of the written description (including drawings) and, if necessary, the prosecution history of the patent at issue to determine a claim term’s proper construction.<sup>11</sup> Indeed, “[i]t is legal error to construe a claim by considering it in isolation. A claim must be read in view of the specification of which it is a part.”<sup>12</sup> Such analysis is necessary because “a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning....”<sup>13</sup> and when the specification defines a claim term either expressly or implicitly, that definition controls.<sup>14</sup>

Thus, “it is always necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meaning [because the specification] acts as a dictionary when it expressly defines terms [or]...defines terms by implication.”<sup>15</sup> Moreover, there need not be “an explicit statement of redefinition,” because the patentee can redefine a term by implication. “[W]hen a patentee uses a claim term throughout the entire patent specification, in a manner *consistent with only a single meaning*, he has defined that term ‘by implication.’”<sup>16</sup> When a claim term possesses “means-plus-function” language, 35 U.S.C. § 112, ¶ 6 should be used to construe the term. In such instances, courts must refer to the specification (and perhaps the prosecution history), since this intrinsic evidence is the exclusive source for determining how the patentee chose to define those terms.

<sup>10</sup> *Enercon GmbH v. United States Int'l Trade Comm'n*, 151 F.3d 1376, 1384 (Fed. Cir. 1998), *cert. denied*, 526 U.S. 1130 (1999), *see also Vitronics*, 90 F.3d at 1582.

<sup>11</sup> *DeMarini*, 239 F.3d at 1324.

<sup>12</sup> *Bell Comm. Res., Inc. v. Vitalink Comm. Corp.*, 55 F.3d 615, 621 (Fed. Cir. 1995)

<sup>13</sup> *Vitronics*, 90 F.3d at 1582 (citation omitted); *accord Wolverine World Wide, Inc. v. Nike, Inc.*, 38 F.3d 1192, 1197 (Fed. Cir. 1994), *see also Hockerson-Halberstadt, Inc. v. Avia Group Intern., Inc.*, 222 F.3d 951, 955 (Fed. Cir. 2000).

<sup>14</sup> *Renishaw PLC v. Marposs Societa' per Aziona*, 158 F.3d 1243, 1249-50 (Fed. Cir. 1998).

<sup>15</sup> *Vitronics*, 90 F.3d at 1582; *see also Bell Atlantic*, 262 F.3d at 1268.

<sup>16</sup> *Bell Atlantic*, 262 F.3d at 1271 (quoting *Vitronics*, 90 F.3d at 1582) (emphasis added).

**B. The Prosecution History May Influence Claim Construction**

As discussed above, the Court should examine all of the intrinsic evidence—including the prosecution history—in construing disputed claim terms. The prosecution history is important intrinsic evidence because it “constitutes a public record of the patentee’s representations concerning the scope and meaning of the claims.”<sup>17</sup>

The Federal Circuit has consistently held that arguments and amendments made during the prosecution of a patent application and other aspects of the prosecution history may be examined to determine the meaning of the terms in the claims.<sup>18</sup> This is in contrast to prosecution history estoppel, which comes up for consideration only when the so called “doctrine of equivalents” is in issue. The prosecution history may clarify the interpretation of claim terms, for example so as to consider any interpretation that was asserted during prosecution.<sup>19</sup> However, “[u]nless [one is] altering claim language to escape an examiner rejection, a patent applicant only limits claims during prosecution by clearly disavowing claim coverage.”<sup>20</sup> The matter of estoppel does not arise under the Markman claim construction, which is for literal interpretation, as opposed to the factual finding of differences under the doctrine of equivalents. Here the ultimate findings for “equivalents,” view the record of prosecution in a somewhat different light.

**C. Extrinsic Evidence May Only be Used to Confirm Construction and Construe Ambiguous Terms**

Extrinsic evidence includes anything that is external to the patent and file history, such as expert testimony, inventor testimony, dictionaries, and technical treatises and articles.<sup>21</sup> Although technical treatises and dictionaries are considered extrinsic evidence, the Federal Circuit considers them “worthy of special note” in that

<sup>17</sup> *Hockerson-Halberstadt*, 222 F.3d at 957 (citing *Vitronics*, 90 F.3d at 1583); see also *Pall Corp. v. PTI Technologies, Inc.*, 259 F.3d 1383, 1393 (Fed. Cir. 2001) (public notice function of patents requires review of the prosecution history and prohibits a claim construction that would include any interpretation that was disclaimed during prosecution).

<sup>18</sup> *Id.*; *Elkay Manufacturing Co. v. Ebco Manufacturing Co.*, 192 F.3d 973, 978-79 (Fed. Cir. 1999); *Southwall Technologies, Inc. v. Cardinal IG Co.*, 54 F.3d 1570, 1576 (Fed. Cir. 1995).

<sup>19</sup> *Southwall Technologies*, 54 F.3d at 1576.

<sup>20</sup> *York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1575 (Fed. Cir. 1996).

<sup>21</sup> *Vitronics*, 90 F.3d at 1584.

[j]udges 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 so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.<sup>22</sup>

Expert testimony, on the other hand, is considered the weakest form of extrinsic evidence. “As compared to expert testimony, which often only indicates what a particular expert believes a term means, prior art references may be more indicative of what those skilled in the art generally believe a certain term means.”<sup>23</sup>

Extrinsic evidence may only be relied upon to construe the claim terms themselves “when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence.”<sup>24</sup> Moreover, if the meaning of the claim limitations is apparent from the totality of the intrinsic evidence, then the claim has been construed.

While extrinsic evidence may be relied on to ensure that the Court’s understanding of the underlying technology generally conforms to that of one of ordinary skill in the art, it “may not be used to vary, contradict, expand, or limit the claim language from how it is defined, even by implication, in the specification or file history.”<sup>25</sup>

#### **D. Construction of Means-Plus-Function Claims**

Several of the claims asserted by Blount contain means-plus-function language and are thus subject to 35 U.S.C. § 112, ¶ 6.<sup>26</sup> Under 35 U.S.C. § 112, ¶ 6 “means-plus-function” language, an element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.<sup>27</sup> Nevertheless, because it is not believed that there is an issue regarding 35 U.S.C. § 112, ¶ 6, it will not be detailed any further.

<sup>22</sup> *Id.* at 1584 n.6.

<sup>23</sup> *Id.* at 1584.

<sup>24</sup> *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1332 (Fed. Cir. 2001).

<sup>25</sup> *Bell Atlantic*, 262 F.3d at 1269; *see also Vitronics*, 90 F.3d at 1584-85; *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 981 (Fed. Cir. 1995), *aff’d*, 517 U.S. 370 (1996).

<sup>26</sup> 35 U.S.C. § 112, ¶ 6.

<sup>27</sup> *Id.*

#### IV. OVERVIEW OF THE PATENT-IN-SUIT

Before reviewing the construction of each of the disputed claim terms, it is first necessary to understand the context or technology in which they appear. In recent years artificial fireplaces have gained wide recognition as a desirable alternative to wood burning fireplaces. An artificial fireplace, in contrast to its wood burning counterpart, has the ability to quickly and easily bring heat and aesthetic beauty to a home. For instance, where a wood burning fireplace might take a homeowner upwards of 30 to 45 minutes to generate a flame capable of providing the desired heat and aesthetic beauty, an artificial fireplace can create a similar flame in minutes. This ease of use, as well as instant gratification, has made the artificial fireplace industry extremely popular.

While artificial fireplaces are currently widely used by homeowners, there is still a systematic push in the artificial fireplace industry to provide the most realistic and appealing artificial fireplace set-up. One of the most significant challenges in the field of artificial fireplaces is the problem of producing a realistic looking flame desirably with coals and embers, i.e., a flame such as provided by a wood burning fireplace.

Upon recognizing this challenge, and realizing that nobody at the time had devised an artificial fireplace capable of creating a realistic looking flame, Mr. Golden Blount invented the device, as well as obtained the patent, that forms the basis for this Claim Construction Brief. The patent in suit is United States Patent No. 5,988,159 (the '159 Patent), entitled "GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY." The '159 Patent is directed to, and claims, a highly efficient artificial logs and coals-burner assembly for use with artificial, decorative logs and glowing coals and embers. An advantage of Blount's patented artificial logs and coals-burner assembly, is that it provides control for the flame of the coals and embers independent of the flame of the gas logs. Blount's patent accomplishes this by attaching and positioning a secondary coals burner elongated tube forward and below a primary burner tube. The secondary coals burner elongated tube provides a flame out in front of the artificial logs where it lies at a level to inflame small artificial embers and sand on the front hearth portion. This effect more closely approximates the look of a wood burning fireplace. In fact, the coals or embers appearance is greatly enhanced, and some of this effect is forward of the log assembly and, thus, creates an appearance that would actually be obtained from a wood burning assembly.

Blount's patent also suggests (i.e., claims) providing a valve between the primary burner tube and the secondary coals burner elongated tube. The valve allows the user to selectively increase the amount of gas being burned forward the artificial logs. This control makes available a greater introduction of radiant heat to the room, than might be afforded using only a conventional primary burner tube. Consequently, the '159 Patent provides an efficient artificial logs and coals burner assembly that provides a flame out in front of the artificial logs, which more closely approximates the look of a wood burning fireplace, as well as provides a greater amount of radiant heat to the room in which it is located.

V. **THE PROPER CONSTRUCTION OF INDIVIDUAL CLAIM TERMS IN PLAINTIFF'S PATENT**

The parties have identified a number of disputed claim terms. These disputed terms are grouped below according to the claims in which they appear. For ease in understanding, a number of the disputed claim terms will begin with an illustration (most of which are pulled directly from the specification of the '159 Patent) highlighting the structure of that term.

A. **Proper Claim Interpretation for the '159 Patent**

1. **Claim 1 of the '159 Patent**

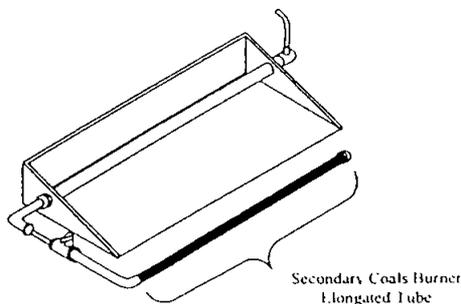
Claim 1 of the '159 Patent reads in its entirety, as follows:

1. A gas-fired artificial logs and coals-burner assembly for fireplace comprising:
  - (a) an elongated primary burner tube including a plurality of gas discharge ports;
  - (b) a secondary coals burner elongated tube positioned forwardly of the primary burner tube;
  - (c) a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube;
  - (d) the secondary coals burner elongated tube including a plurality of gas discharge ports;
  - (e) the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the

secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means;

- (f) a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and
- (g) the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.

• **“secondary coals burner elongated tube”**



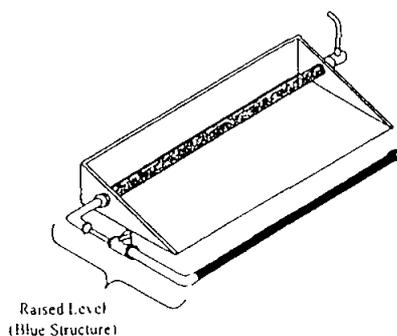
The claim term “secondary coals burner elongated tube” has a plain and common meaning and should be interpreted to mean a tube that is configured to provide a flame under artificial coals located in front of gas logs. Examining the specification indicates that this plain and common meaning of “secondary coals burner elongated tube” is consistent with the description contained in the specification. In particular, the paragraph beginning on column 6, line 41, recites that the “[f]lames 40 fed by gas from the secondary burner tube 104 can rise through the artificial ember bed.” From this description, it is clear that the claim term “secondary coals burner elongated tube” has a plain and common meaning and should be interpreted to mean a tube that is configured to provide a flame under artificial coals located in front of gas logs.

FIG.s 3 & 4 of the specification clearly and consistently illustrate how the “secondary coals burner elongated tube” is positioned under the artificial ember bed 28, and provides the flame 40. This conclusively corroborates the interpretation advanced above. Thus, both the written description and the FIG.s are consistent with the Plaintiff’s proposed definition.

### REQUESTED INTERPRETATION

The term "secondary coals burner elongated tube" should be interpreted to mean a tube that is configured to provide a flame under artificial coals located in front of gas logs.

- "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube"



The support means is the primary item in this phrase. The support means holds the elongated primary burner tube at a "raised level" with respect to the secondary coals burner elongated tube. The term "raised level" has a plain and common meaning and should be interpreted to mean that the upper most portion of the primary burner tube is higher than the upper most portion of the secondary coals burner elongated tube. Examining the specification indicates that this plain and common meaning of "raised level" is consistent with the description contained in the specification.

The specification teaches that the covering materials cover the top of the primary burner elongated tube and fan out to a lesser thickness to also cover the top of the secondary coals burner elongated tube. From this teaching, the point of reference is taken from the tops of the respective tubes. This is further supported where the specification recites that "[t]he secondary elongated burner tube can also have adjustments for height . . . depending on the depth and size of the coals and embers fire bed." (See column 6, lines 30-35 of the '159 Patent). Clearly, the specification intends the reference point to be from the tops of the respective tubes. Finally, in

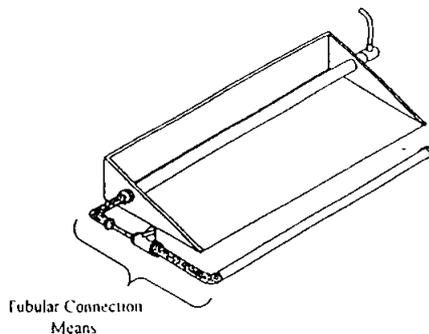
common parlance, when one item is raised with respect to another, the highest point of the two items is compared.

Accordingly, it is clear that the claim term "raised level" has a plain and common meaning and should be interpreted to mean that the upper most portion of the primary burner tube is higher than the upper most portion of the secondary coals burner elongated tube.

#### **REQUESTED INTERPRETATION**

The phrase "a support means for the e in a raised level relative to the forwardly position secondary coals burner elongated tube" should be interpreted to mean that a support structure holds the upper most portion of the primary burner tube higher than the upper most portion of the secondary coals burner elongated tube.

• **"tubular connection means"**



The claim term "tubular connection means" may be construed under 35 U.S.C. §112, ¶ 6. As recited in the law section above, construing a means-plus-function claim requires determining the function performed by the claimed "means," and subsequent thereto, determining the corresponding structure disclosed in the specification that performs the stated function of the claimed "means."

The function of the "tubular connection means" is to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube. The specification clearly supports this function.

Further, the structure disclosed in the specification for performing the stated function includes a collection of tubes and fittings. In column 5, lines 25-44, the specification described

how the connector 102 is fitted to the uncapped end of the burner tube 14, as well as fitted to the secondary coals burner elongated tube 104. Further, FIG.s 2-4 illustrate the connection means comprising a collection of tubes and fittings.

Accordingly, the function is to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube, and the structure for accomplishing that function is a collection of tubes and fittings, and equivalents thereof.

#### REQUESTED INTERPRETATION

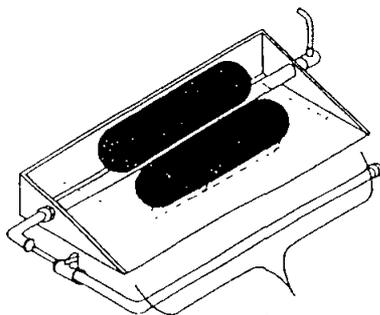
The term "tubular connection means" should be interpreted to mean a collection of tubes and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube, and equivalents thereof.

#### 2. Claim 15 of the '159 Patent

Claim 15 of the '159 Patent reads in its entirety as follows:

15. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open frame pan and primary elongated burner tube is positioned under an artificial logs and grate support means.

• "positioned under an artificial logs and grate support means"



Positioned Under An  
Artificial Logs and  
Grate Support Means

The claim term "positioned under an artificial logs and grate support means" has a plain and common meaning and should be interpreted to mean that a set of artificial logs and a grate support are positioned over the open frame pan and the primary burner elongated tube.

Examining the specification indicates that this plain and common meaning of “positioned under an artificial logs and grate support means” is consistent with the description contained in the specification. In particular, the paragraph beginning on column 6, line 41, recites that, “[a]s discussed, a grate 20 is located above the pan burner which is covered with sand 22. The grate 20 can hold at least one artificial log 24.” From this description, it is clear that the claim term “positioned under an artificial logs and grate support means” has a plain and common meaning and should be interpreted to mean that a set of artificial logs and a grate support are positioned over the open frame pan and the primary burner elongated tube.

Further, FIG.s 3 & 4 of the specification, teach how the artificial logs 24 and the grate support 20 are positioned over the open frame pan. This clearly corroborates the interpretation advanced above. Thus, both the written description and the FIG.s are consistent with Plaintiff’s proposed definition.

#### **REQUESTED INTERPRETATION**

The term “positioned under an artificial logs and grate support means” should be interpreted to mean that a set of artificial logs and a grate support are positioned over the open frame pan and the primary burner elongated tube.

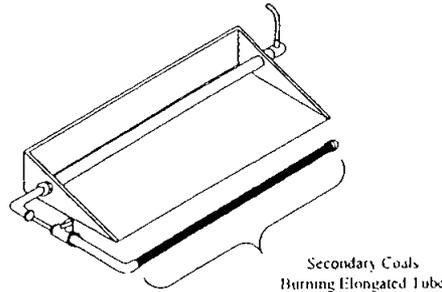
#### **3. Claim 17 of the ‘159 Patent**

Claim 17 of the ‘159 Patent reads in its entirety as follows:

17. A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:
  - (a) a secondary coals burning elongated tube;
  - (b) a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube
  - (c) the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve,
  - (d) primary and secondary burner tubes having a plurality of gas discharge ports,

- (e) a gas distribution ports of the secondary burner tube directed away from the fireplace opening.

• “secondary coals burning elongated tube”

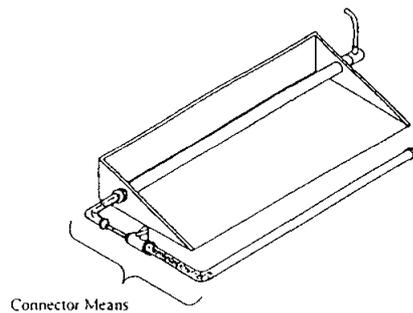


The claim term “secondary coals burning elongated tube” should be construed similar to the term “secondary coals burner elongated tube” of Claim 1. Accordingly, the term “secondary coals burning elongated tube” should be interpreted to mean a tube that is configured to provide a flame under artificial coals located in front of gas logs. Information pertaining to how Plaintiff interpreted the term “secondary coals burning elongated tube” may be found in the detailed discussion above with respect to Claim 1.

**REQUESTED INTERPRETATION**

The term “secondary coals burning elongated tube” should be interpreted to mean a tube that is configured to provide a flame under artificial coals located in front of gas logs.

• “connector means”

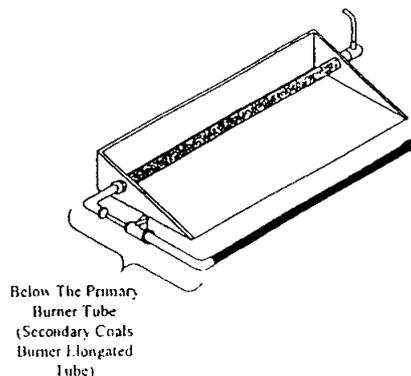


The claim term "connector means" should be construed similar to the term "tubular connection means" of Claim 1. Accordingly, the term "connector means" should be interpreted to mean a collection of tubes and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube, and equivalents thereof. Information pertaining to how Plaintiff interpreted the term "connector means" may be found in the detailed discussion above with respect to Claim 1.

#### REQUESTED INTERPRETATION

The term "connector means" should be interpreted to mean a collection of tubes and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube, and equivalents thereof.

- "below the primary burner tube"



The term "below the primary burner tube" has a plain and common meaning and should be interpreted to mean that the upper most portion of the secondary coals burner elongated tube is lower than the upper most portion of the primary burner tube. Examining the specification indicates that this plain and common meaning of "below the primary burner tube" is consistent with the description contained in the specification.

The specification teaches that the covering materials cover the top of the primary burner elongated tube and fan out to a lesser thickness to also cover the top of the secondary coals burner elongated tube. From this teaching, the point of reference is taken from the tops of the

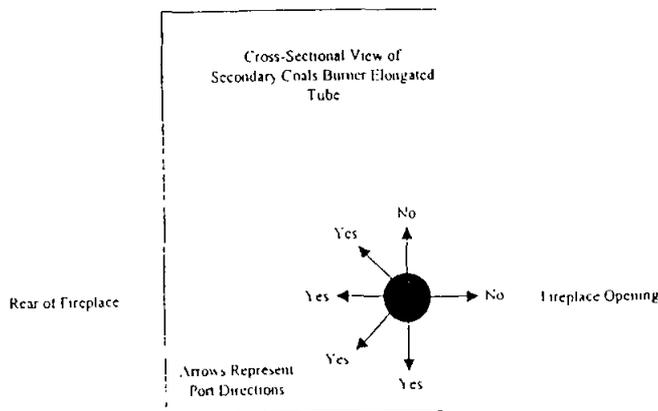
respective tubes. This is further supported where the specification recites that “[t]he secondary elongated burner tube can also have adjustments for height . . . depending on the depth and size of the coals and embers fire bed.” (See column 6, lines 30-35 of the '159 Patent). Clearly, the specification intends the reference point to be from the tops of the respective tubes. Finally, in common parlance, when one item is below another, the highest point of the two items is compared.

Accordingly, it is clear that the claim term “below the primary burner tube” has a plain and common meaning and should be interpreted to mean that the upper most portion of the secondary coals burner elongated tube is lower than the upper most portion of the primary burner tube.

**REQUESTED INTERPRETATION**

The phrase “below the primary burner tube” should be interpreted to mean that the upper most portion of the secondary coals burner elongated tube is lower than the upper most portion of the primary burner tube.

- **“directed away from the fireplace opening”**



The term “directed away from the fireplace opening” has a plain and common meaning and should be interpreted to mean that the gas discharge ports of the secondary coals burning elongated tube may be directed from vertically down, to any position approaching 179 degrees in

the clockwise direction, but may not be located vertically upward. Examining the specification indicates that this plain and common meaning of “directed away from the fireplace opening” is consistent with the description contained in the specification.

In particular, the specification recites that “[i]n the secondary burner tube 104, the gas is discharged in a direction away from the opening of the fireplace[,] or in another aspect[,] is directed somewhat toward or directly toward the primary burner tube 14.” (*emphasis added*) (See column 5, lines 58-62 of the '159 Patent). The specification further recites that “if the secondary burner 104 discharges gas in a vertical direction, apertures in the sand or coverage granular material will occur and one would lose the aesthetic beauty of the applications of distribution of gas for burning and creating flame coals' and embers' appearance.” (See column 6, lines 14-20 of the '159 Patent). In further support of this vertical direction analysis, the specification states that “[b]y avoiding the upper [vertical] ridge, the apertures are less likely to be clogged by sand.” (See column 5, lines 50-52 of the '159 Patent). The specification clearly supports the interpretation that the gas discharge ports of the secondary coals burning elongated tube may be directed from vertically down, to any position approaching 179 degrees in the clockwise direction. Nevertheless, the gas discharge ports may not be located vertically upward.

#### **REQUESTED INTERPRETATION**

The phrase the term “directed away from the fireplace opening” should be interpreted to mean that the gas discharge ports of the secondary coals burning elongated tube may be directed from vertically down, to any position approaching 179 degrees in the clockwise direction, but may not be located vertically upward.

#### **VI. CONCLUSION**

For the foregoing reasons and based on the intrinsic evidence relied upon, Plaintiff, Golden Blount, Inc. respectfully requests that the Court adopt the following proposed claim construction:

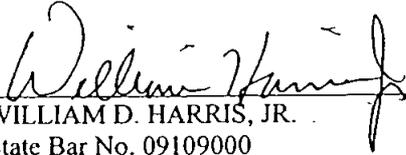
#### **REQUESTED CONSTRUCTION RESTATED**

- The term “secondary coals burner elongated tube” should be interpreted to mean a tube that is configured to provide a flame under artificial coals located in front of gas logs.

- The phrase “a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube” should be interpreted to mean that a support structure holds the upper most portion of the primary burner tube higher than the upper most portion of the secondary coals burner elongated tube.
- The term “tubular connection means” should be interpreted to mean a collection of tubes and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube, and equivalents thereof.
- The term “positioned under an artificial logs and grate support means” should be interpreted to mean that a set of artificial logs and a grate support are positioned over the open frame pan and the primary burner elongated tube.
- The term “secondary coals burning elongated tube” should be interpreted to mean a tube that is configured to provide a flame under artificial coals located in front of gas logs.
- The term “connector means” should be interpreted to mean a collection of tubes and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube, and equivalents thereof.
- The phrase “below the primary burner tube” should be interpreted to mean that the upper most portion of the secondary coals burner elongated tube is lower than the upper most portion of the primary burner tube.
- The phrase the term “directed away from the fireplace opening” should be interpreted to mean that the gas discharge ports of the secondary coals burning elongated tube may be directed from vertically down, to any position approaching 179 degrees in the clockwise direction, but may not be located vertically upward.

Respectfully submitted,

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EXHIBIT A

JT-APP-0396

CLAIM INTERPRETATION CHART FOR U.S. PATENT NO. 5,988,159

Claims	Support in Specification	Terms	Interpretation
<p>1. A gas-fired artificial logs and coals-burner assembly for fireplace comprising:</p> <p>an elongated primary burner tube including a plurality of gas discharge ports;</p>	<p>Generally in the ABSTRACT, TECHNICAL FIELD OF THE INVENTION, SUMMARY OF THE INVENTION, DETAILED DESCRIPTION OF THE DRAWINGS, as well as illustrated in FIGURES 2-4.</p> <p>FIG. 2 shows a burner tube 14. The term burner tube 14, as used in the specification, is synonymous with the term elongated primary burner tube, as used in the claims. A corresponding written description of the burner tube 14 is provided at Column 5, line 10 to Column 6, line 63 of the '159 Patent.</p> <p>FIG. 2 further shows a plurality of apertures, as evidenced by the gas plumes 18. The term plurality of apertures 18, as used in the specification, is synonymous with the term plurality of gas discharge ports, as used in the claims. A corresponding written description of the plurality of apertures 18 is provided at Column 5, lines 5-25 of the '159 Patent.</p>	<p>The term gas-fired artificial logs and coals-burner assembly is a collection of elements, including the artificial logs and coals, that work in conjunction with a gas source to enhance the aesthetic beauty of artificial burning logs, coals and embers. (Abstract)</p> <p>The term burner assembly is defined in such a manner that it is capable of providing a flame under both the artificial logs as well as the artificial coals.</p> <p>It is expected for purposes of claim interpretation that the term an elongated primary burner tube is a tube that is configured to be connected to a gas source and provide a flame under artificial logs located there over.</p> <p>It is expected for purposes of claim interpretation that the term plurality of gas discharge ports, as used in conjunction with the elongated primary burner tube, includes apertures located in the elongated primary burner tube that are configured to allow gas to escape therefrom and provide a flame in front of the artificial logs located there behind.</p>	<p>A burner assembly for providing a gas flame to both the artificial logs and artificial coals.</p> <p>A burner tube having holes located therein that is used to provide a flame under artificial logs located there over.</p>
<p>a secondary coals burner elongated tube positioned forwardly of the primary burner tube;</p>	<p>FIG. 2 shows a secondary burner tube 104. The term secondary burner tube 104, as used in the specification, is synonymous with the term secondary coals burner elongated tube, as used in the claims. A corresponding written description of the secondary burner tube 104 is provided at Column 5, line 25 to Column 6, line 20 of the '159 Patent.</p> <p>FIGs 2 and 3 further show the secondary burner tube 104 positioned forwardly of the burner tube 14.</p>	<p>It is expected for purposes of claim interpretation that the term secondary coals burner elongated tube is a tube that is configured to provide a flame under artificial coals located in front of the gas logs.</p>	<p>A secondary coals burner tube configured to provide a flame under artificial coals located in front of gas logs.</p>

<p>a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube;</p>	<p>FIGs. 2 and 3 of the '159 Patent show a pan 12 having side walls 12a and 12b that support the burner tube 14 in a raised level with respect to the secondary burner tube 104 at Column 5, lines 10-25</p>	<p>The phrase support means should be construed under 35 U.S.C. § 112, ¶6. Under such a construction and in further view of claim differentiation that appears in dependent claims, the support means would be expected to be construed to mean that a support structure holds the upper most portion of the primary burner tube higher than the upper most portion of the secondary coals burner elongated tube.</p> <p>The phrase raised level is not specifically defined in the specification and should, therefore, take on the meaning given to it by one of ordinary skill in the art having an understanding of the teachings disclosed in the specification. In such instances, one of ordinary skill in the art, based on the disclosure, would be expected to construe the phrase raised level to mean that the upper most portion of the primary burner tube is higher than the upper most portion of the secondary coals burner elongated tube; or alternatively, it is noted that the phrase could also be expected to be construed to mean that the center line of the primary burner tube taken along its longitudinal axis is higher than the center line of the secondary coals burner elongated tube taken along its longitudinal axis.</p>	<p>Construed according to § 112, ¶6 Function: supporting the primary tube in a raised level with respect to the secondary coals burner elongated tube. Structure: a support structure that holds the upper most portion of the primary burner tube higher than the upper most portion of the secondary coals burner elongated tube.</p>
<p>the secondary coals burner elongated tube including a plurality of gas discharge ports;</p>	<p>FIG.3 illustrates a plurality of apertures 108 along the length of the secondary burner tube 104. Various embodiments thereof are disclosed at Column 5, lines 45-55 in the '159 Patent</p>	<p>The phrase plurality of gas discharge ports, as used in conjunction with the secondary burner tube, includes apertures located in the secondary coals burner elongated tube that are configured to allow gas to escape therefrom and provide a flame out in front of artificial logs located there over. No specific direction of the discharge ports is required by this claim.</p>	<p>A secondary coals burner elongated tube including a plurality of gas discharge ports.</p>
<p>the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means;</p>	<p>FIGs. 2 and 3 illustrate a connector 102 that is attached to an uncapped end of the burner tube 14 and that is fitted to the secondary burner tube 104 to create a fluid path for the gas from the burner tube 14 to the secondary burner tube 104, as discussed at Column 5, lines 25-44.</p>	<p>The phrase communicating through given the disclosure and general discussion would be expected to have its plain and ordinary meaning.</p> <p>The phrase tubular connection means should be construed under 35 U.S.C. § 112, ¶6. Under such a construction, the tubular connection means would be expected to be construed to mean a collection of tubes and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube and equivalent structures thereof.</p>	<p>Construed according to § 112, ¶6. Function: Provide a path for gas from the elongated primary burner tube to the secondary coals burner elongated tube. Structure: a collection of tubes and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube.</p>

<p>a valve for adjusting gas flow to the secondary coals burner tube positioned in the tubular gas connection means; and</p>	<p>FIGs. 2 and 3 illustrate a valve 106 interposed in the fluid path that can be variably operated to give a user the ability to select the amount of gas entering the secondary burner tube 104 from the burner tube 14</p>	<p>The term valve refers to adjustable gas valves that are configured to control a flow of gas therethrough. The phrase positioned in would be expected to be construed to mean that the valve is positioned in the fluid path such that the gas passes through the valve and ultimately to the secondary coals burner elongated tube.</p>	<p>A valve for adjusting gas flow to the secondary coals burner elongated tube and that is positioned in the tubular gas connection means.</p>
<p>the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.</p>	<p>FIGs. 1 and 2 illustrate the burner tube 14 being connected to an inlet 16 that is connected to a gas source not shown. The gas flow into the burner tube 14 is controlled by a primary burner valve as discussed in Column 2, lines 5-16 and Column 5, lines 10-20.</p>	<p>The phrase gas flow control means is a gas valve, and as such, is well understood by one of ordinary skill in the art. These gas valves are typically present in many homes having gas fireplaces and are configured to control a flow of gas into the primary burner tube.</p>	<p>The primary burner tube is in communication with a gas source with a gas flow control valve that controls a gas flow into the primary burner tube.</p>
<p>2. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the support means for the primary burner tube is comprised of an open frame pan for supporting the primary burner tube in an elevated position relative to the fireplace floor.</p>	<p>FIGs. 2 and 3 of the '159 Patent shows an open frame pan 12 having side walls 12a and 12b that support the burner tube 14 in a raised level with respect to the secondary burner tube 104, as discussed at Column 5, lines 10-25.</p>	<p>The phrase open frame pan is a standard burner support pan, and as such is well understood by one of ordinary skill in the art. The phrase elevated level is not specifically defined in the specification and should, therefore, take on the meaning given to it by one of ordinary skill in the art having an understanding of the teachings disclosed in the specification. In such instances, one of ordinary skill in the art, based on the disclosure, would be expected to construe the phrase elevated position to mean that the bottom of the primary burner tube is located above a plane formed by the fireplace floor.</p>	<p>An open frame pan configured to support the bottom of the primary burner tube in an elevated position with respect to the fireplace floor.</p>
<p>5. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is substantially parallel to the primary burner tube and has a smaller inside diameter than the primary burner tube with the valve adjusting gas flow for coals burn and forwarding heat radiation from the fireplace.</p>	<p>FIG. 2 shows a secondary burner tube 104. The term secondary burner tube 104, as used in the specification, is synonymous with the term secondary coals burner elongated tube, as used in the claims. A corresponding written description of the secondary burner tube 104 is provided at Column 5, line 25 to Column 6, line 20 of the '159 Patent. FIGs. 2 and 3 further show the secondary burner tube 104 positioned substantially parallel to the burner tube 14. Additionally, FIG. 3 shows the secondary burner tube 104 having a smaller inside diameter than the burner tube 14.</p>	<p>The phrase substantially parallel is well understood by one of ordinary skill in the art. The phrase smaller inside diameter is also well understood by one of ordinary skill in the art.</p>	<p>The secondary coals burner elongated tube is located in a position that is substantially parallel to a position of the primary burner tube, and has an inside diameter less than the inside diameter of the primary burner tube.</p>

<p>7. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the elongated primary burner tube and the secondary coals burner elongated tube are spaced apart on different planes at from about four to about eight inches.</p>	<p>FIGs 2 and 3 show the secondary burner tube 104 and the burner tube 14 spaced apart by a distance. A corresponding written description of the spaced apart distance is provided at Column 6, lines 20-40 of the '159 Patent.</p>	<p>The phrase different planes is not specifically defined in the specification and should, therefore, take on the meaning given to it by one of ordinary skill in the art having an understanding of the teachings disclosed in the specification. In such instances, one of ordinary skill in the art, based on the disclosure, would be expected to construe the phrase different planes to mean a first vertical plane taken through a centerline of the primary burner tube and a second vertical plane taken through a centerline of the secondary burner tube.</p> <p>The phrase spaced apart means the spacing of the first vertical plane with respect to the second vertical plane.</p>	<p>The first vertical plane taken through the primary burner tube is separated from the second vertical plane taken through the secondary coals burner elongated tube by a distance from about four to about eight inches.</p>
<p>8. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is of a smaller diameter than the primary burner tube which allows for a lower profile of coals and sand coverage.</p>	<p>FIG. 3 shows the secondary burner tube 104 having a smaller outside diameter than the burner tube 14.</p> <p>FIG. 3 also shows the lower profile of coals and sand coverage over the secondary burner tube 104 than the burner tube 14.</p>	<p>The phrase smaller outside diameter is well understood by one of ordinary skill in the art.</p> <p>The phrase lower profile is not specifically defined in the specification and should, therefore, take on the meaning given to it by one of ordinary skill in the art having an understanding of the teachings disclosed in the specification. In such instances, one of ordinary skill in the art, based on the disclosure, would be expected to construe the phrase lower profile to mean the height of coals and sand required to cover the secondary coals burner elongated tube is lower than the height of coals and sand required to cover the primary burner tube.</p>	<p>The secondary coals burner elongated tube has an outside diameter less than an outside diameter of the primary burner tube, thus, allowing the coals and sand located over the secondary coals burner to have a reduced height.</p>
<p>9. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube.</p>	<p>FIGs 2 and 3 show that the secondary burner tube 104 is adjustable in height to the floor of the fireplace and the burner tube 14, via the connector 102 coupled to the terminal end 14a.</p>	<p>The phrase adjustable in height relative to the floor of the fireplace and the elevated primary burner tube is well understood by one of ordinary skill in the art.</p> <p>The phrase, however, is subject to the requirement of claim 1 that the upper most portion of the primary burner tube is higher than the upper most portion of the secondary coals burner elongated tube, or if that construction is not given, that the center line of the primary burner tube taken along its longitudinal axis is higher than the center line of the secondary coals burner elongated tube taken along its longitudinal axis.</p>	<p>The secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and elevated primary burner tube, but subject to the positional relationship of the secondary coals burner elongated tube and primary burner tube established in claim 1.</p>
<p>11. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary and secondary burner tubes have apertures of from about 1/32 inch to about 1/8 inch.</p>	<p>A written description for the apertures having of from about 1/32 inch to about 1/8 inch diameter is provided at Column 5, lines 45-55 of the '159 Patent.</p>	<p>The phrase apertures having of from about 1/32 inch to about 1/8 inch diameter is well understood by one of ordinary skill in the art.</p>	<p>The diameter of the apertures range from about 1/32 inch to about 1/8 inch.</p>

<p>12. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the gas flow adjustment valve has a removable handle, the gas flow adjustment allowing a variety of settings from full closed to full open.</p>	<p>A comparison of FIGs. 2 and 3 shows that the handle is removable.</p>	<p>The phrase removable handle is well understood by one of ordinary skill in the art. The phrase allowing a variety of settings from full closed to full open is also well understood by one of ordinary skill in the art.</p>	<p>The handle may be removed from the valve, wherein the valve may adjust the gas flow from full closed to full open.</p>
<p>13. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the connection means is comprised of a connector attached to the terminal end of the primary burner tube at a first end of a connector and attached to the secondary coals burner elongated tube to a connector second end with the valve interposed between the primary burner tube and the secondary burner tube.</p>	<p>FIGs. 2 and 3 illustrate a connector 102 that is attached to an uncapped end of the burner tube 14 and that is fitted to the secondary burner tube 104 to create a fluid path for the gas from the burner tube 14 to the secondary burner tube 104 and is discussed in Column 5, lines 25-44 of the '159 Patent.</p>	<p>The phrase tubular connection means should be construed under 35 U.S.C. § 112, ¶6. Under such a construction, and in view of the additional elements of claim 13, the tubular connection means would be expected to be construed as a connector having a first end and a second end, wherein the first end is connected to the terminal end of the primary burner tube, and the second end is connected to the secondary coals burner elongated tube, and an equivalent structure thereof. The phrase the valve interposed between the primary burner tube and the secondary burner tube would be expected to be construed to mean that the valve is interposed between the terminal end of the primary burner tube and the secondary coals burner elongated tube.</p>	<p>Construed according to § 112, ¶6. Function: Provide a path for gas from the elongated primary burner tube to the secondary coals burner elongated tube. Structure: A connector connected to the terminal end of the primary burner tube and the secondary coals burner elongated tube, with a valve in the connector and interposed between the terminal end of the primary burner tube and the secondary coals burner elongated tube.</p>
<p>15. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open frame pan and primary burner tube is positioned under an artificial logs and grate support means.</p>	<p>FIGs. 3 and 4 illustrate an open frame pan and primary elongated burner tube located under artificial logs 24 and a grate 20. A written description for the artificial logs 24 and the grate 20 is provided at Column 6, lines 40-52 of the '159 Patent.</p>	<p>The phrase artificial logs is well understood by one of ordinary skill in the art. The grate support would be expected to be construed as any grate configured to position artificial logs over the open frame pan and the primary burner elongated tube.</p>	<p>A set of artificial logs and a grate support that are positioned over the primary burner tube and its support means.</p>
<p>16. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary elongated burner tube is covered with sand and the secondary elongated burner tube is covered with sand, mica, and fibrous materials which simulate coals and ember burn.</p>	<p>FIGs. 3 and 4 illustrate the burner tube 14 covered by sand 22, as well as the secondary burner tube 104 covered by sand 22 and artificial ember material 26. A written description for the coverage of the burner tube 14 and secondary burner tube 104 with the sand 22 and artificial ember material 26 is provided at Column 6, lines 40-52 of the '159 Patent.</p>	<p>The term covered is well understood by one of ordinary skill in the art. The phrase sand, mica and fibrous material is well understood by one of ordinary skill in the art. The phrase simulate coals and ember burn would be expected to be construed to mean that the sand, mica and fibrous material covering the secondary coals elongated burner tube emulate the look of coals and embers in a wood burning fireplace.</p>	<p>The primary burner tube is covered with sand, and the secondary coals burner elongated tube is covered with sand, mica, and fibrous material, the secondary coals burner elongated tube causing the sand, mica, and fibrous material to emulate the look of coals and embers of a wood burning fireplace.</p>

<p>17. A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:</p>	<p>Generally in the ABSTRACT, TECHNICAL FIELD OF THE INVENTION, SUMMARY OF THE INVENTION, DETAILED DESCRIPTION OF THE DRAWINGS and well as illustrated in FIGURES 1-4.</p>	<p>The term gas-fired artificial logs and coals- and embers- burner apparatus is a collection of elements that work in conjunction with a gas source and artificial logs and coals to enhance the aesthetic beauty of artificial burning logs, coals and embers. (Abstract)</p> <p>The term burner apparatus is defined in such a manner that it is capable of providing a flame under both the artificial logs as well as the artificial coals.</p>	<p>A burner assembly for providing a gas flame to both the artificial logs and artificial coals.</p>
<p>a secondary coals burning elongated tube;</p>	<p>FIG. 2 shows a secondary burner tube 104. The term secondary burner tube 104, as used in the specification, is synonymous with the term secondary coals burner elongated tube, as used in the claims. A corresponding written description of the secondary burner tube 104 is provided at Column 5, line 25 to Column 6, line 20 of the '159 Patent.</p>	<p>It is expected for purposes of claim interpretation that the term secondary coals burner elongated tube is a tube that is configured to provide a flame under artificial coals located in front of the gas logs.</p>	<p>A tube that is configured to provide a flame under artificial coals located in front of gas logs.</p>
<p>a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube</p>	<p>FIGS. 2 and 3 illustrate a connector 102 that is attached to an uncapped end of the burner tube 14 and that is fitted to the secondary burner tube 104 to create a fluid path for the gas from the burner tube 14 to the secondary burner tube 104 and is discussed in Column 5, lines 25-44.</p> <p>FIGS. 2 and 3 further show the secondary burner tube 104 positioned substantially parallel, forward and below the burner tube 14.</p>	<p>The phrase tubular connection means should be construed under 35 U.S.C. § 112 ¶6. Under such a construction, the tubular connection means would be expected to be construed to mean a collection of tubes and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube and equivalent structures thereof.</p> <p>The phrase substantially parallel is well understood by one of ordinary skill in the art.</p> <p>It is expected for purposes of claim interpretation that the term forward means that the secondary coals burning elongated tube is positioned closer to the fireplace opening than the elongated primary burner tube.</p> <p>The phrase below is not specifically defined in the specification and should, therefore, take on the meaning given to it by one of ordinary skill in the art having an understanding of the teachings disclosed in the specification. In such instances, one of ordinary skill in the art, based on the disclosure, would be expected to construe the phrase below to mean that the upper most portion of the secondary coals burning elongated tube is lower than the upper most portion of the primary burner tube; or alternatively, it is noted that the phrase below would also be expected to be construed to mean that the center line of the secondary coals burning elongated tube taken along its longitudinal axis is lower than the center line of the primary burner tube taken along its longitudinal axis.</p>	<p>A collection of tube and fittings configured to provide a path for gas to travel from the elongated primary burner tube to the secondary coals burner elongated tube and equivalent structures thereof and the secondary coals burner elongated tube is positioned substantially parallel, forward and lower with respect to the primary burner tube.</p>

<p>the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve,</p>	<p>FIGs. 2 and 3 illustrate a valve 106 interposed in the fluid path that can be variably operated to give a user the ability to select the amount of gas entering the secondary burner tube 104 from the burner tube 14.</p>	<p>The term valve includes gas valves that are configured to control a flow of gas therethrough. The phrase interposed between would be expected to be construed to mean that the valve is positioned in the fluid path between the primary burner tube and the secondary coals burning elongated tube, such that the gas passes through the valve and ultimately to the secondary coals burning elongated tube.</p>	<p>A valve for adjusting gas flow to the secondary coals burning elongated tube, wherein the valve is positioned between the primary burner tube and the secondary coals burning elongated tube and in the connector means.</p>
<p>primary and secondary burner tubes having a plurality of gas discharge ports,</p>	<p>FIGs. 2 and 3 illustrate a plurality of apertures 18 and 108 located along the length of the primary burner tube and secondary burner tube 104, respectively. A corresponding written description of the plurality of apertures 18 and 108 is provided at Column 5, lines 45-55 in the 159' Patent.</p>	<p>The phrase plurality of gas discharge ports, as used in conjunction with the primary burner tube and the secondary coals burning elongated tube, includes apertures located in the primary burner tube and the secondary coals burning elongated tube that are configured to allow gas to escape therefrom and provide a flame.</p>	<p>A primary burner tube and a secondary coals burning elongated tube each including a plurality of gas discharge ports.</p>
<p>a gas distribution ports of the secondary burner tube directed away from the fireplace opening.</p>	<p>FIG 3 illustrates the plurality of apertures 108 directed away from the fireplace opening. A corresponding written description of the plurality of apertures 108 is provided at Column 5, line 45 thru Column 6, line 20 in the 159' Patent.</p>	<p>The phrase away from the fireplace opening is not specifically defined in the specification and should therefore, take on the meaning given to it by one of ordinary skill in the art having an understanding of the teachings disclosed in the specification. In such instances, one of ordinary skill in the art, based on the disclosure, would be expected to construe the phrase away from the fireplace opening to mean that the gas discharge ports of the secondary coals burning elongated tube may be directed from vertically down, to any position within 179 degrees in the clockwise direction but may not be located vertically upward.</p>	<p>The gas discharge ports of the secondary coals burning elongated tube may be located at any position from vertically down to 179 degrees in the clockwise direction, but may not be located vertically upward.</p>

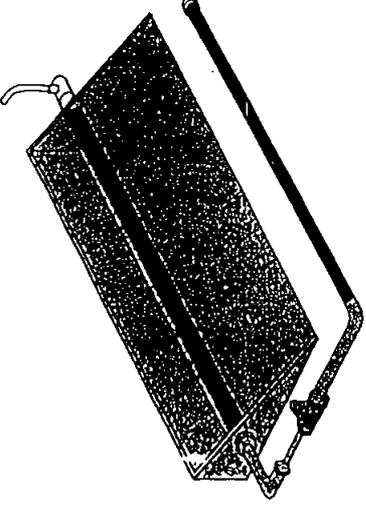
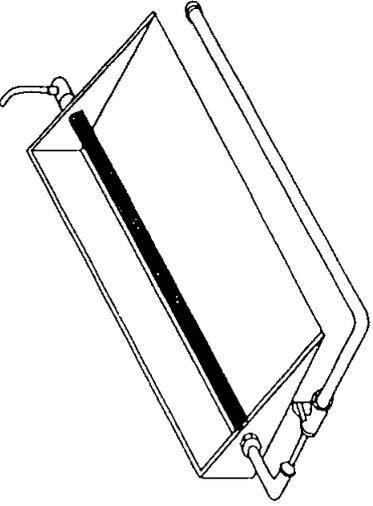
EXHIBIT B

JT-APP 0404

# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

Claims/Elements

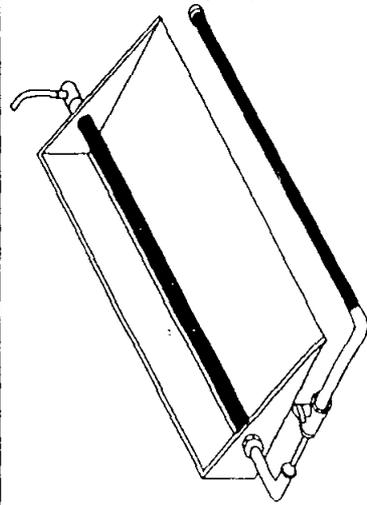
	<p>1. A gas-fired artificial logs and coal-burner assembly for fireplace comprising:</p>
	<p>an elongated primary burner tube including a plurality of gas discharge ports;</p>

JT-APP 0405

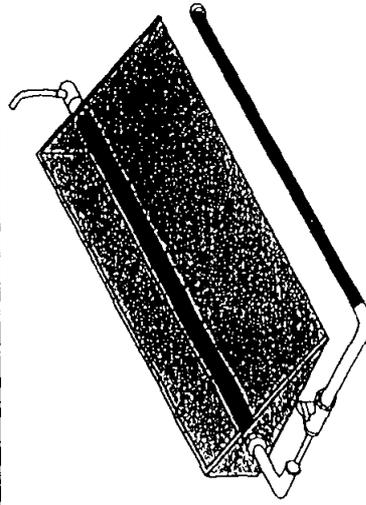
# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

Claims/Elements



a secondary coals burner elongated tube positioned forwardly of the primary burner tube;



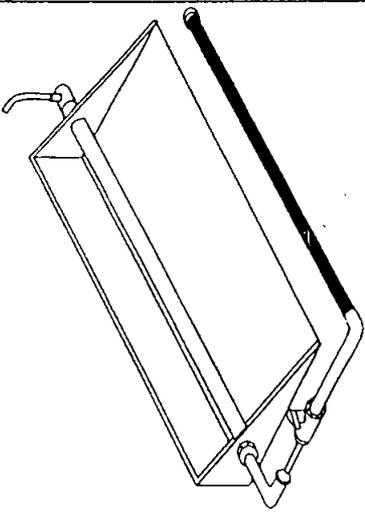
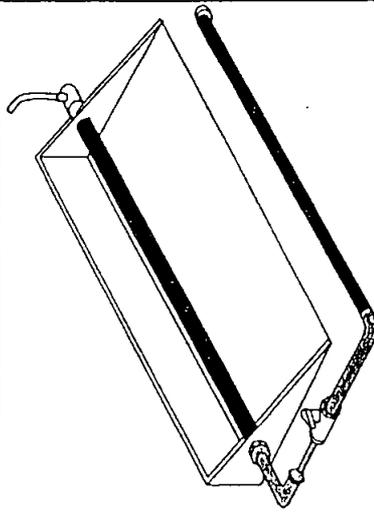
a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube.

JL-APP 0406

# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

Claims/Elements

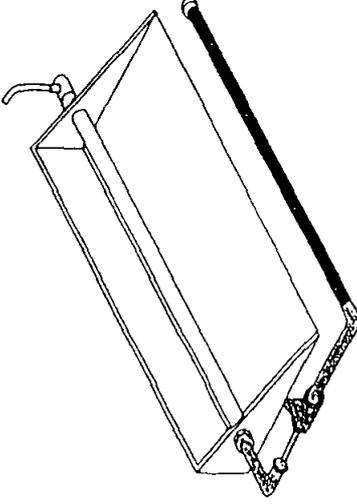
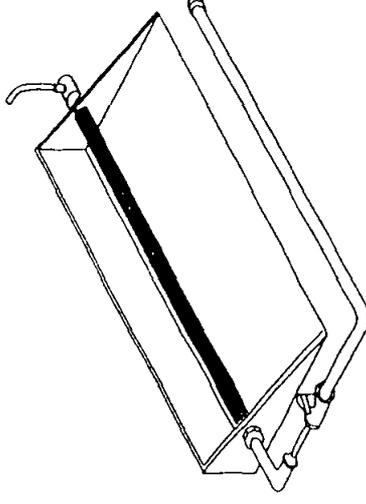
	<p>the secondary coals burner elongated tube including a plurality of gas discharge ports;</p>
	<p>the elongated primary burner tube and the secondary coals burner elongated tube communicating through a gas flow passage wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the</p>

JT-APP 0407

# INTERPRETATION CHART (APPENDIX B)

Claims/Elements

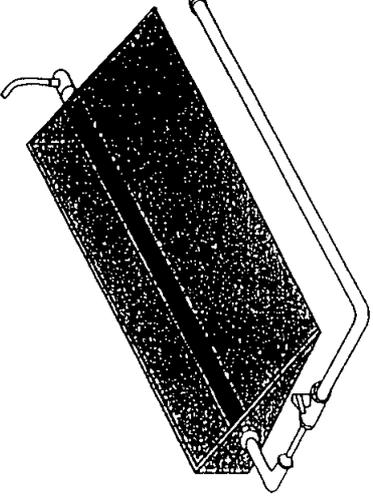
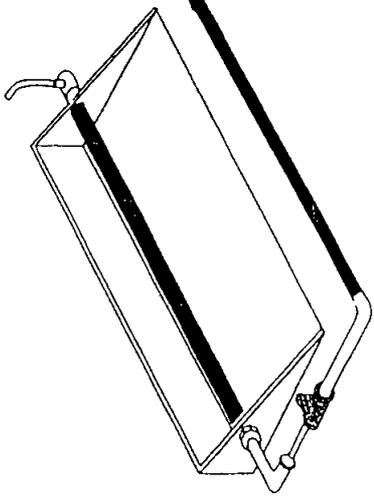
Plaintiff's Claimed Device

	<p>a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the ... and</p>
	<p>the primary burner tube being in communication with a therein for controlling gas flow into said primary burner tube</p>

# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

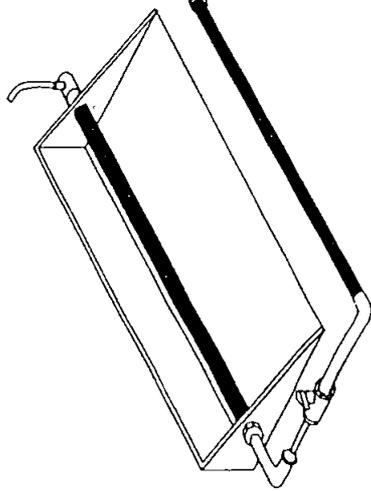
Claims/Elements

	<p>2. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the support means for the primary burner tube is comprised of an open frame pan for supporting the primary burner tube in an elevated position relative to the fireplace floor</p>
	<p>5. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is substantially parallel to the primary burner tube and has a smaller inside diameter than the primary burner tube with the valve adjusting gas flow for coals burn and forwarding heat radiation from the fireplace</p>

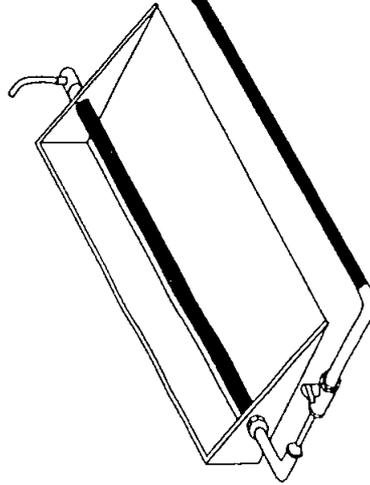
# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

Claims/Elements



7. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the elongated primary burner tube and the secondary coals burner elongated tube are spaced apart on different planes at from about four to about eight inches.

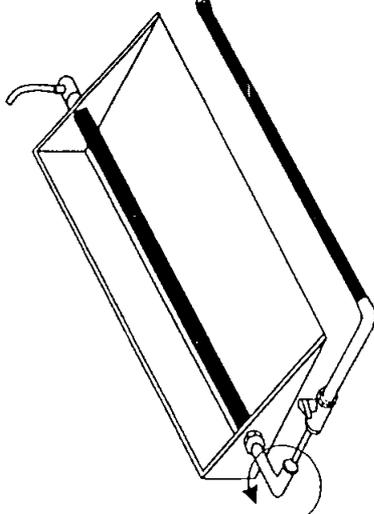
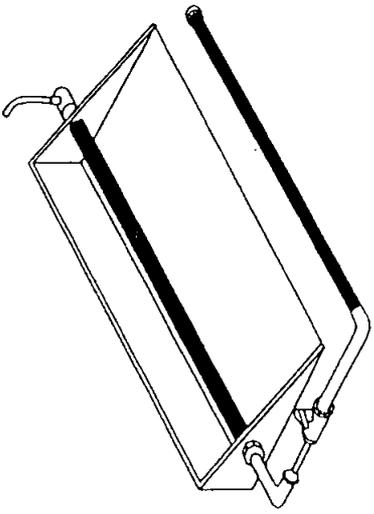


8. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is of a smaller diameter than the primary burner tube which allows for a lower profile of coals and sand coverage

# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

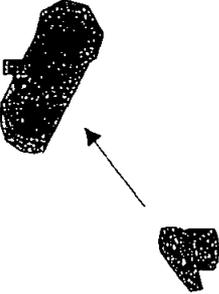
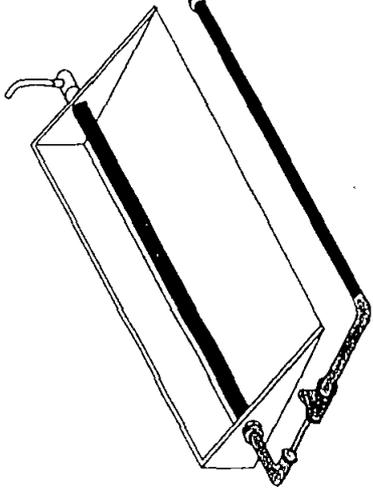
Claims/Elements

	<p>9. The gas-fired artificial logs and coal-burner assembly according to claim 1 wherein the secondary coal burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube.</p>
	<p>11. The gas-fired artificial logs and coal-burner assembly according to claim 1 wherein the primary and secondary burner tubes have apertures of from about 1/32 inch to about 1/8 inch</p>

# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

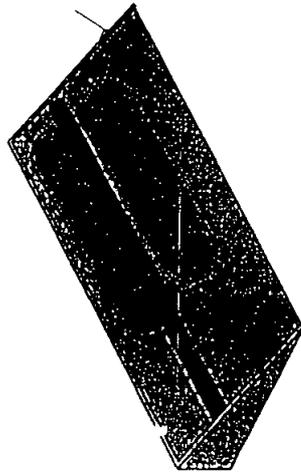
Claims/Elements

 <p>The diagram shows a gas flow adjustment valve with a removable handle. An arrow points from the handle to the valve body.</p>	<p>12. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the gas flow adjustment valve has a removable handle, the gas flow adjustment allowing a variety of settings from full closed to full open</p>
 <p>The diagram shows a gas-fired artificial logs and coals-burner assembly. It includes a primary burner tube at the terminal end of a connector, a secondary coals burner elongated tube, and a valve interposed between the primary burner tube and the secondary burner tube.</p>	<p>13. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the burner tube is comprised of a connector attached to the terminal end of the primary burner tube at a first end of a connector and attached to the secondary coals burner elongated tube to a connector second end with the valve interposed between the primary burner tube and the secondary burner tube</p>

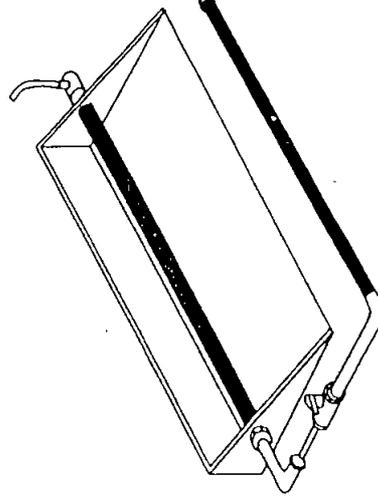
# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

Claims/Elements



15. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open flame pan and primary elongated burner tube is positioned under an artificial logs and grate support means.



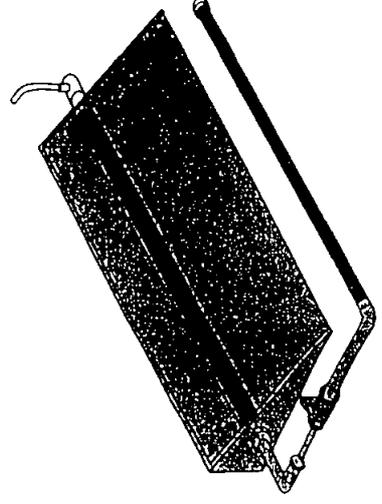
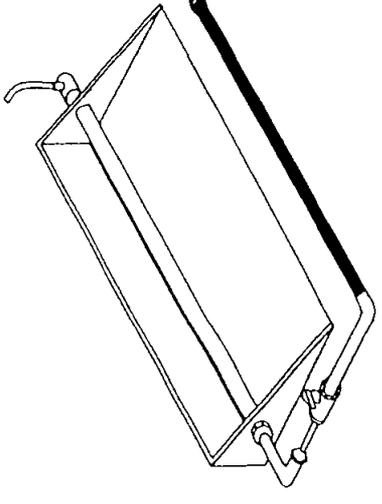
16. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary elongated burner tube is covered with sand and the secondary elongated burner tube is covered with sand, mica, and fibrous materials which simulate coals and ember burn.

JT-APP 0413

# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

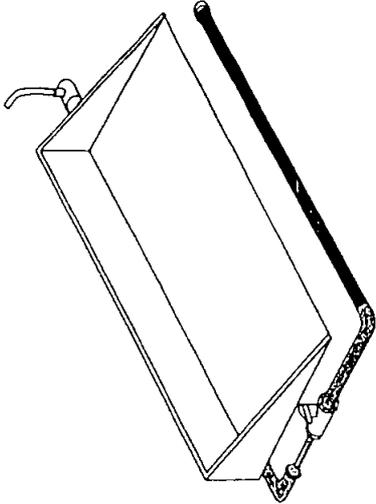
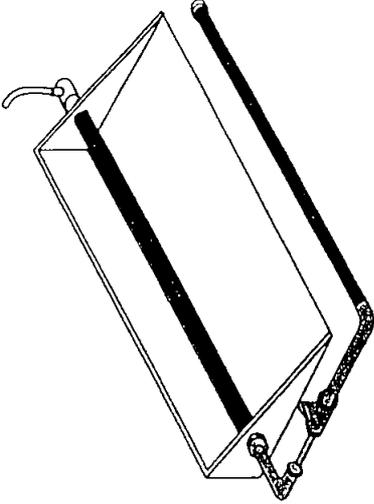
Claims/Elements

	<p>17. A gas-fired artificial coals- and embers- burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:</p>
	<p>a secondary coals burning elongated tube</p>

# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

Claims/Elements

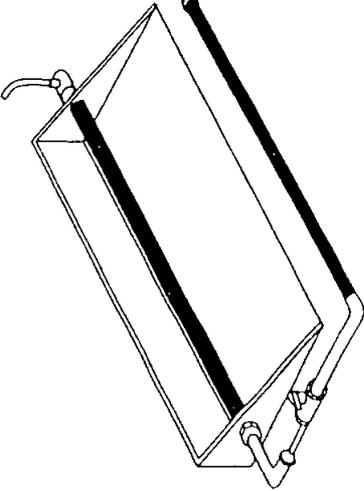
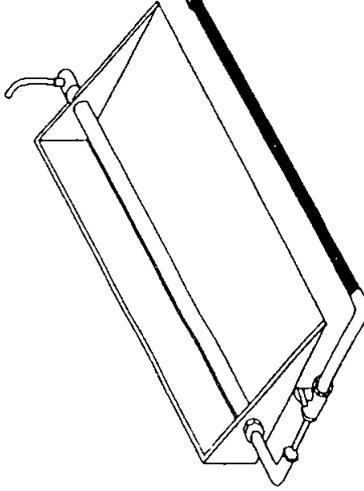
	<p>a tube for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube</p>
	<p>the tube having interposed between the primary and secondary burner tubes a gas flow adjustment valve.</p>

JT-APP 0415

# INTERPRETATION CHART (APPENDIX B)

Plaintiff's Claimed Device

Claims/Elements

 <p>A perspective view of a burner assembly. It consists of a rectangular housing with a front panel. A primary burner tube is shown as a thick black line extending from the front panel towards the back. A secondary burner tube is shown as a thinner black line extending from the back of the housing towards the front panel. The tubes are connected to a gas supply system at the bottom of the housing.</p>	<p>primary and secondary burner tubes having a plurality of gas discharge ports.</p>
 <p>A perspective view of a burner assembly, similar to the one in the first diagram. It shows a rectangular housing with a front panel. A secondary burner tube is shown as a thick black line extending from the back of the housing towards the front panel. The tube is angled away from the front panel. The primary burner tube is not visible. The tubes are connected to a gas supply system at the bottom of the housing.</p>	<p>a gas distribution ports of the secondary burner tube directed away from the fireplace opening</p>

**EXHIBIT C**

**JT-APP 0417**



US005988159A

# United States Patent [19]

Blount

[11] Patent Number: 5,988,159

[45] Date of Patent: Nov. 23, 1999

[54] GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY

[76] Inventor: Golden Blount, 5310 Harbor Town, Dallas, Tex. 75287

[21] Appl. No.: 08/626,498

[22] Filed: Apr. 2, 1996

### Related U.S. Application Data

[63] Continuation-in-part of application No. 08/276,894, Jul 19, 1994, abandoned, which is a continuation-in-part of application No. 08/061,727, May 17, 1993, abandoned.

[51] Int. Cl.<sup>6</sup> ..... F23C 1/18

[52] U.S. Cl. .... 126/512; 126/500; 126/540; 431/125

[58] Field of Search ..... 431/125, 126/512, 126/500, 524, 540, 503

### [56] References Cited

#### U.S. PATENT DOCUMENTS

3,042,109	7/1962	Peterson	126/512
3,871,355	3/1975	Henry	431/125 X
5,000,162	3/1991	Shimick et al	126/512

5,033,455	7/1991	Eiktor et al.	126/512
5,052,370	10/1991	Karabin	126/512
5,081,981	1/1992	Beal	126/92 R
5,263,852	11/1993	Beck	431/125

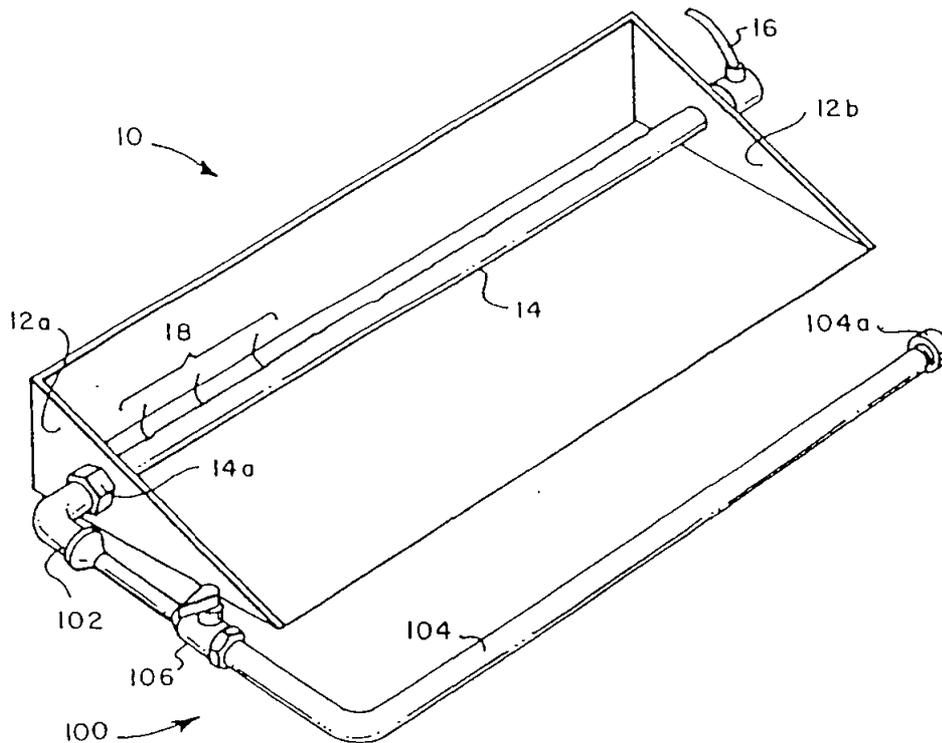
Primary Examiner—Larry Jones

Attorney, Agent, or Firm—L. Dan Tucker

### [57] ABSTRACT

A gas-fired artificial logs and coals-burner assembly is provided for fireplace use in cooperation with decorative gas logs, and artificial coals and embers decorative items by placement forward of the gas logs in the fireplace arrangement, a secondary elongated coals- and embers-burner tube apparatus. The assembly provides gas-fired artificial logs, coals- and embers-burner apparatus for fireplaces wherein gas flow through primary burner tube is the source of gas flow to a secondary coals- and embers-burner tube positioned forward and below the primary burner tube with multiple discharge ports in the secondary tube directed away from the front of the fireplace, thus enhancing the natural burn in cooperation of the fireplace draft as well as the aesthetic beauty of the imitation burning logs, coals and embers.

19 Claims, 3 Drawing Sheets



JT-APP 0418

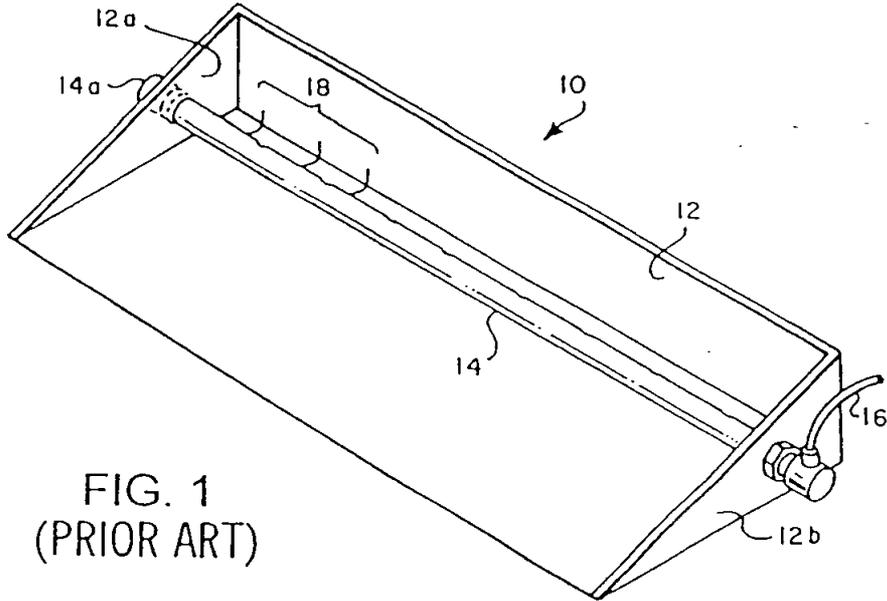


FIG. 1  
(PRIOR ART)

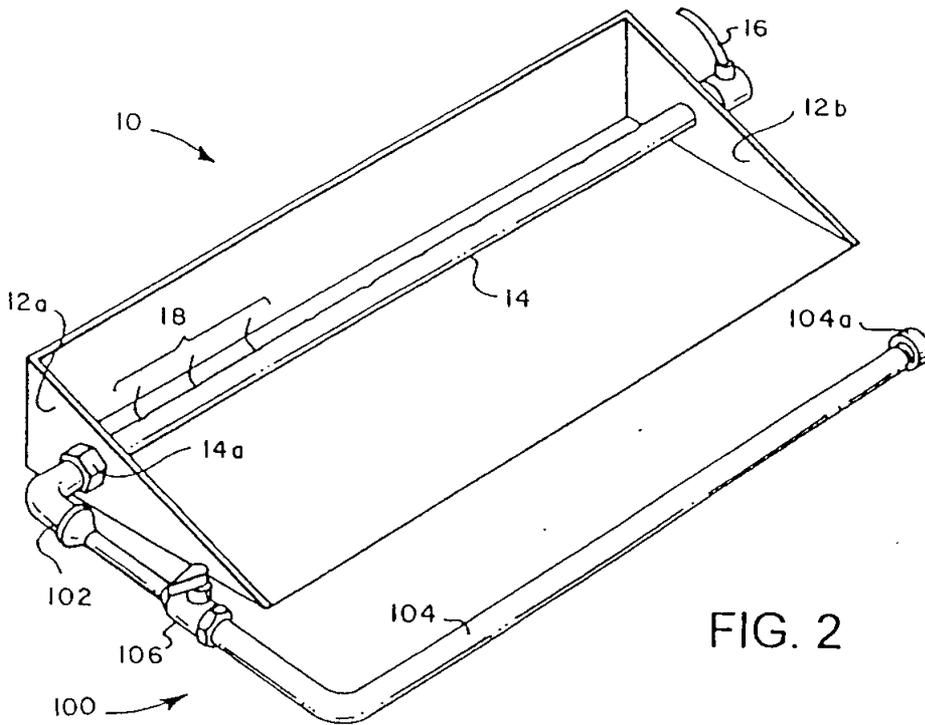
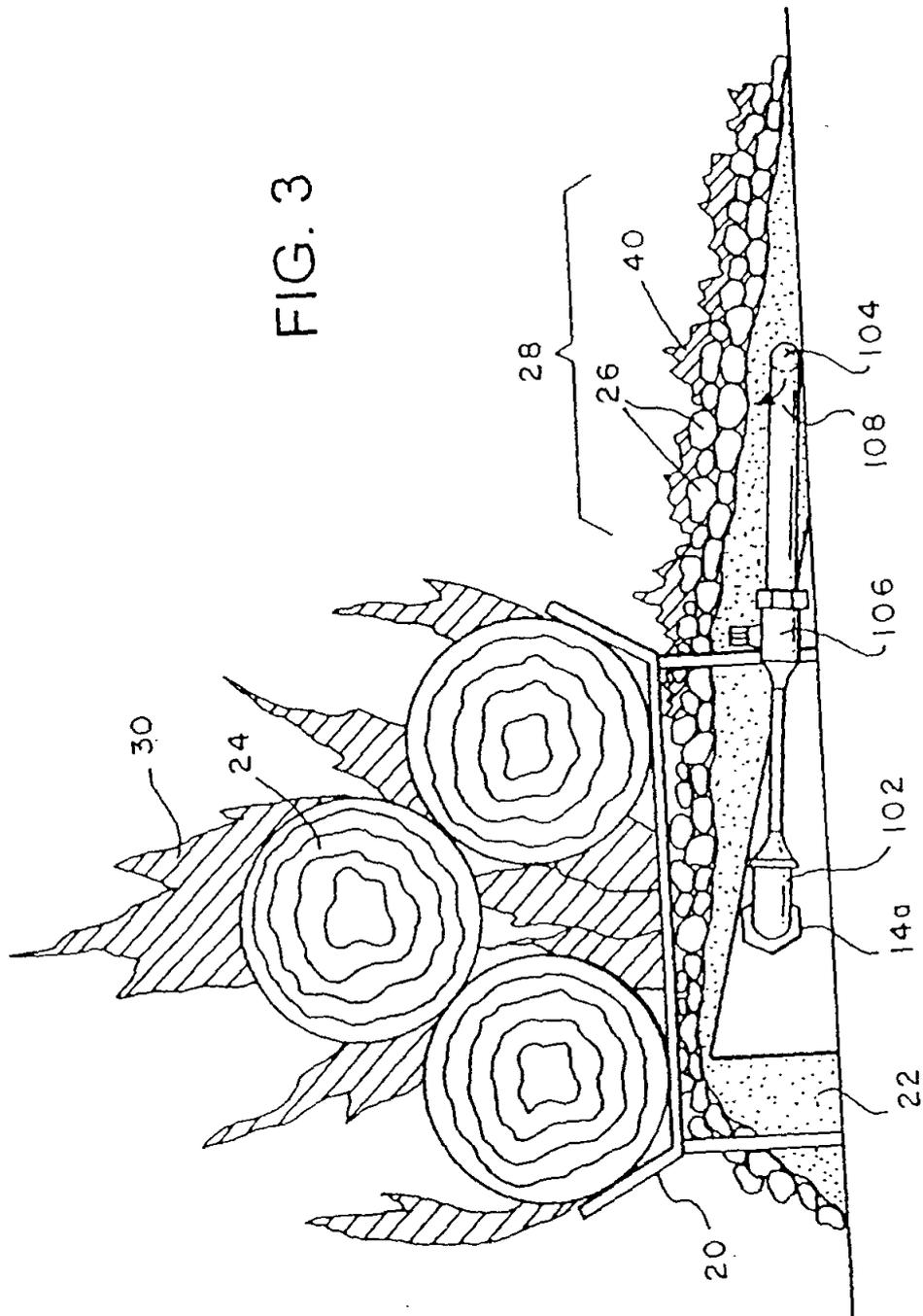


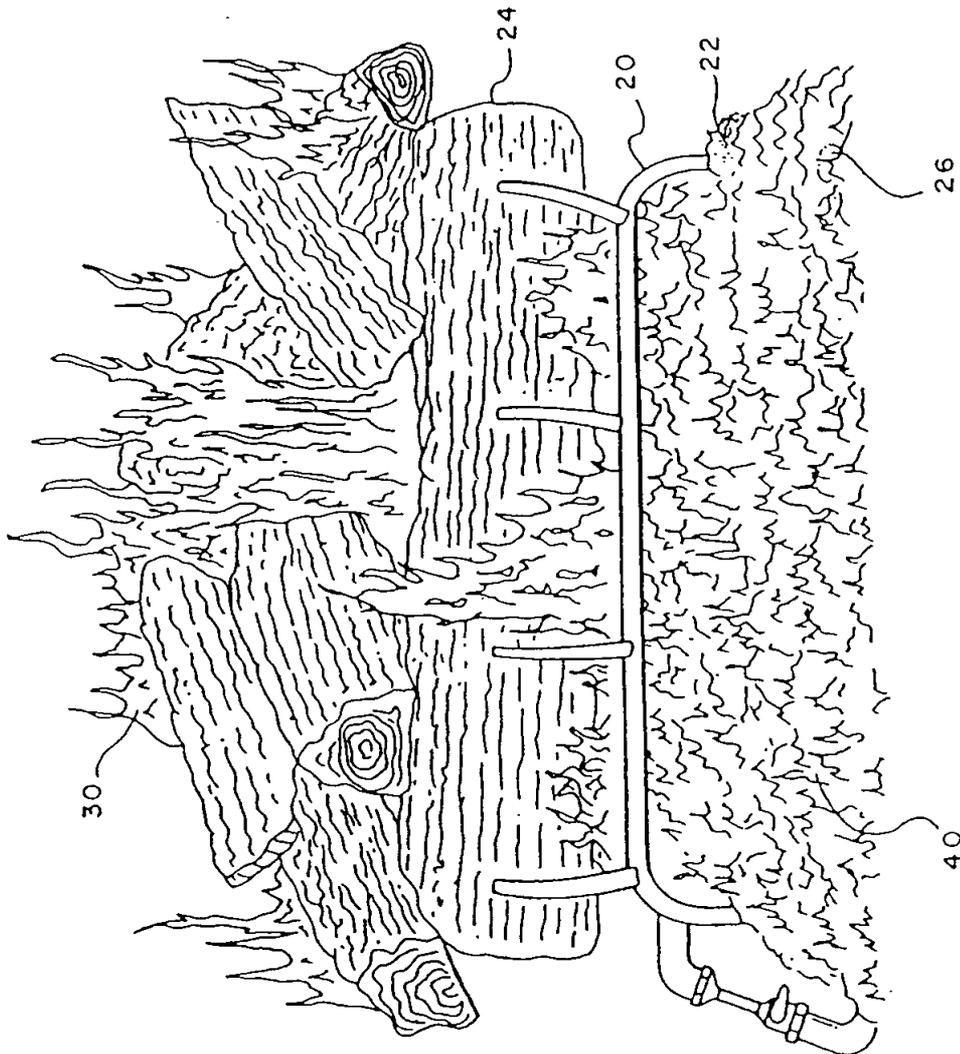
FIG. 2

FIG. 3



JL-APP 0420

FIG. 4



## GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY

The present application is a continuation-in-part application of U.S. patent application Ser. No. 08/276,894, filed Jul. 19, 1994, now abandoned, entitled "A Supplemental Burner for Retrofitting to an Existing Gas Log Burner Assembly" which is a continuation-in-part application of U.S. patent application Ser. No. 08/061,727, filed May 17, 1993, entitled "Controlled Ember Bed Burner" which is now abandoned.

### TECHNICAL FIELD OF THE INVENTION

The present invention relates to a gas-fired artificial logs and coals-burner assembly for a fireplace to be used with decorative gas logs and coals or embers decorative items placed forward of the gas logs in the fireplace arrangement. In another aspect, the invention relates to coals- and embers-burner apparatus suitable for attaching to a terminal end of a gas-fired primary artificial burner, the coals- and embers-burner assembly utilizing a valve between the primary artificial logs burner and the coals- and embers-burner.

In yet another aspect, the invention relates to a gas-fired artificial logs, coals- and embers-burner assembly for fireplace wherein gas flow through a primary burner tube is the source for gas flow to a secondary coals burner tube positioned forward and below the primary burner tube with the multiple discharge ports in the secondary tube directed away from the front of the fireplace.

The present further relates to efficient gas burners for burning natural gas, manufactured gas and propane gaseous fuels within a fireplace environment. In addition, the invention provides an efficient burner system for burning gaseous fuels in a manner which provides decorative flames and decorative coals and embers which simulate wood burning.

Gas logs are usually made of a fire resistant ceramic material; however, when gas flames are directed against such ceramic materials, the gas flame is cooled by the artificial logs and many times produces a highly inefficient and dirty yellow flame. Such a flame further indicates incomplete burn of the gaseous materials due to a lack of sufficient burn temperature and oxygen supply thus creating excessive soot and carbon monoxide. Various attempts have been made in correcting these decorative fireplace gas log deficiencies.

Further it is known that gas burners or gas nozzles can be buried below a level of sand and vermiculite. These burner systems are referred to as sand pan burners which disburse the gasses through the fireproof material and permit the gas permeating through the porous material to ignite upon entering the atmosphere. Such systems allow disbursement of the flames over a large area or bed of material. Such disbursement of flames creates a more efficient burn which further simulates the action of burning wood, ashes and embers in a fireplace.

Prior art burner systems for artificial decorative logs and sand pan type burners are incorporated in various prefabricated fireplaces or existing masonry fireplaces; however, such systems are required to meet the ANSI emission standards which have been adapted by the American Gas Institute. Accordingly, it is very desirable to provide a clean burning gas-fired artificial logs and coals-burner assembly which meet the present ANSI emission standards.

Gas logs are increasingly popular in homes. Decorative artificial logs are placed on a grate which is located over a gas burner. The burner is typically a tube with spaced

apertures. Sand is poured over the gas burner to hide it from sight. Artificial embers are then spread across the sand. In use, gas flows through the burner and escapes through the spaced apertures. The gas filters up through the sand underneath the artificial logs. The gas is ignited and creates flames between the logs. The height of the flame is controlled by a primary valve which can be manipulated by the user.

Gas logs can, under these conditions, provide a great deal of heat to a room. Also, gas logs require virtually no effort to light. Natural logs, on the other hand, must be properly cured before burning. Even then, kindling is usually needed. And once lit, it is difficult to control the rate of burning. Beyond convenience, gas logs are also aesthetically pleasing. However, the standard gas logs burner only creates flames around the artificial logs. Natural logs, when burned will break apart to produce beautiful burning embers in front of the main log stack. A need exists to produce a more realistic aesthetic burn with gas logs.

Due to the popularity of gas logs, a number of advances have been patented. For example, U.S. Pat. No. 5,000,162 to Shimek et al. discloses a "Clean Burning Glowing Ember and Gas Log Burner System." This unit is marketed under the trademark Heat-N-Glow as the Model 5000GDVMH as a self-contained fireplace and wall heater for mobile homes. The system is a low-BTU system whose main objective is to minimize carbon monoxide creation and soot deposit on the logs. A burner system is provided with a first branch and a second branch. The first branch is supported on a prefabricated grate between a first and second decorative log. The second branch is forward of the logs and is protected under a metal mesh. A very light layer of special ember material is spread on top of the mesh. Shimek et al. '162 is only sold as a complete system of logs, burner and special ember material. It cannot be fitted to existing pan burners which are by far the most common burner in use, the combination resulting in the assembly of the invention. Thus, the Shimek burner system is an expensive option.

The Shimek burner system provides a metal trim piece or refractory material in front of the second burner pipe branch so that it is not easily viewed by a person standing in front of the fireplace. The second branch only illuminates a thin line of ember material. Neither the first or second branch can be covered by sand as is common in other units. The gas apertures in the branches are located on the upper surface of both branches. Thus, sand could easily clog the apertures. Moreover, the flow of gas into the second branch cannot be regulated.

U.S. Pat. No. 5,052,370 to Karabin discloses a "Gas Burner Assembly Including Emberizing Material." The gas burner comprises a first and second gas-burner assembly. The first gas-burner assembly is formed by a pair of parallel burner tubes connected by a third burner tube. The second gas-burner assembly is located forward of the first assembly and is generally T-shaped. The second burner only illuminates a thin line of ember material. A single gas source supplies both burner assemblies. An igniter is provided to ignite the gas from the main burner assembly. The flame from that burning gas ignites the gas from the second burner assembly. As with the Shimek et al. burner assembly, the flow of gas to the second burner assembly cannot be controlled.

Finally, U.S. Pat. No. 5,081,981 to Beal discloses yet another burner and is entitled "Yellow Flame Gas Fireplace Burner Assembly." The Beal reference is primarily concerned with producing a clean yellow flame. The burner assembly includes a U-shaped burner tube. The front portion

of the burner tube is forward of the artificial logs and provides flame for ember material. However, as with the Shimck reference above, the forward portion of the burner tube is hidden from view by a portion of the grate. The Beal system does not contemplate the present assembly. Furthermore, as with both the Shimck and Karabin references, there is no means provided to control separately the flow of gas into the front burner tube.

A need exists for an inexpensive assembly for improving the performance and aesthetic appeal of pan-type gas burners. The assembly should distribute gas under artificial coals or embers in front of the gas-fired logs. The assembly should also provide a method of controlling the flow of gas to a secondary burner, thus controlling the height of the coals and embers bed flames and the amount of heat radiated into a room. A need further exists for an assembly which can safely operate even if completely covered by sand and enhances gas burn of both primary log burner and secondary coals and embers burner by gas flow control and burn direction.

These present and long-felt needs for gas logs and glowing coals- and embers-burner systems will burn clean and closely simulate the natural flames produced by burning wood logs have not yet been met by the art. Therefore, it is desirable to produce a reliable and efficient gas logs and glowing coals- and embers-burner assembly which produces the desired efficiency of burn while providing decorative flames that closely simulate burning wood logs while at the same time providing useable heat and still meet EPA regulations and the ANSI emissions and safety standards.

#### SUMMARY OF THE INVENTION

It is a primary object of the present invention to provide a highly efficient gas-burner assembly for use with artificial, decorative logs and glowing coals and embers wherein the assembly provides control for the glowing coals and embers independently of the gas logs burn.

It is another primary object of the present invention to provide a novel burner assembly which closely simulates the flames, embers and coals of natural wood logs burn.

It is another principle object of the present invention to provide a novel burner assembly which has low carbon monoxide emission characteristics.

It is yet another object of the present invention to provide an efficient low carbon monoxide emission burner assembly that combines long decorative gas flames with short or low smoldering glowing embers and coals in the same assembly.

It is another object of the present invention to provide a gas flow communicating primary and secondary burner tubes with the gas distribution ports of the secondary burner tube directed away from the opening of the fireplace and utilizing the natural draft of the fireplace to enhance the overall efficiency of the burn of the two burners.

The present burner assembly is the combination of an inexpensive primary gas logs burner assembly in gas flow communication with a secondary coals- and embers-burner tube positioned forward and below the primary burner which operates to enhance the natural draft of the fireplace to improve efficiency of burn and aesthetic appeal of the gas-fired artificial logs, coals- and embers-burner assembly. The secondary burner can distribute gas under artificial coals and embers in front of the gas logs with control of the gas flow to the secondary burner being readily adjustable by a valve in the connection means between the primary and secondary burners. The secondary burner receives gas through the primary burner, the connection means, and the gas flow is regulated selectively by the valve which is

interposed between the primary and secondary burners in the connection means. The control of gas flow thus controls the height of the coals and embers bed flames and the amount of radiant heat which is produced in the front of the fireplace and is distributed into the room. The amount of radiant heat can be enhanced by utilizing the control valve for increasing the amount of gas being burned in the secondary burner or the utilization of even a tertiary burner along with the secondary burner which are provided forward of the gas logs arrangement in the fireplace. The secondary burner can operate efficiently when completely covered with sand and artificial coals and embers materials, there being no need for a new grate to hide the secondary burner.

The ability to regulate the flow of gas to the secondary burner is an especially important feature. In addition, the gas flow from the secondary burner away from the opening of the fireplace and, in effect, toward the primary burner is also of special importance because of the utilization of the fireplace natural draft and direction of flames to more completely burn the gas, avoid any pockets of gas in front of the gas logs. The direction of the gas dispersion from the secondary burner ensures that through the action of the natural draft of the fireplace and the burning logs from the primary burner that complete and total combustion in an efficient manner will be achieved of the gas flowing from the secondary burner which is positioned somewhat forward of the primary burner.

People buy gas logs primarily for convenience, but this does not mean that they want to give up on the beauty of burning real logs. Standard pan burners only provide part of that beauty. Having roaring flames throughout the logs is greatly complemented by lower flames in front of the gas logs throughout a coals and embers bed. None of the prior art references above feature or even suggest a variable control means for accomplishing lower flames in the coals and embers bed. Moreover, every fireplace drafts differently. Such differences in fireplace construction and drafting, i.e., fireplace draft, as well as sizing and manufacture of present artificial fireplace burner apparatus dictates that variable control of the secondary burner, the coals and embers burner which operates independently of the primary logs burner is necessary. Volume and velocity of air entering the firebox varies according to the size of the room, height of the ceilings, and size of the firebox. None of the prior art references compensate for the varying drafts of fireplaces and therefore fail to accommodate all fireplaces while attempting to provide the maximum aesthetic beauty desired and efficiency of burn.

Most importantly, the gas-fired artificial logs, coals- and embers-burner assembly through the secondary burner control afforded by the valve, allows the user to selectively increase the amount of gas being burned forward of the artificial logs. This control also affords a greater introduction of radiant heat to the room as desired on colder days. As previously discussed, artificial gas logs can act as a heat sink and absorb heat produced by the flames. The heat generated by the secondary burner is largely radiant and is projected into the room, which affords quick heating of the room while also providing the aesthetic beauties of a gas-fired artificial logs, coals- and embers-burner assembly operation.

#### BRIEF DESCRIPTION OF THE DRAWINGS

For a more complete understanding of the present invention, and for further details and advantages thereof, reference is now made to the following Detailed Description taken in conjunction with the accompanying drawings, in which:

FIG. 1 provides a perspective view of a prior art pan burner used with artificial gas logs;

FIG. 2 provides a gas-fired artificial logs primary pan tube burner and secondary coals and embers tube burner;

FIG. 3 illustrates the effect of the present assembly in providing logs, coals and embers flames;

FIG. 4 is a front view of the assembly illuminating the coals and embers bed and gas logs flames.

#### DETAILED DESCRIPTION OF THE DRAWINGS

The present assembly provides a number of advantages over the burner assemblies disclosed in the prior art. FIG. 1 illustrates a standard pan burner 10 which is used in the vast majority of artificial log sets. The pan burner 10 has an open frame 12 which supports a burner tube 14. An inlet 16 is connected to a gas source (not shown). A plurality of apertures, as evidenced by gas plumes 18, are spaced along the length of the burner tube 14. Gas escapes through the apertures and filters through sand (not shown). Gas which escapes from the sand is initially ignited to create flames. These flames are continually fed by the escaping gas. The burner tube 14 is supported by the side walls 12a, 12b of the frame 12. The burner tube 14 extends beyond the side wall 12a and is capped.

FIG. 2 illustrates a secondary burner apparatus 100 which embodies the present invention in combination with primary burner tube 14. The secondary burner apparatus 100 can be retrofitted to the terminal end 14a of the burner tube 14 in the pan burner 10. The cap must be removed from the terminal end 14a. A connector 102 is then attached to the uncapped end of burner tube 14. The connector 102 is fitted to the secondary burner tube 104 creating an enclosed fluid path for the gas. The connections between the connector 102 and the terminal end 14a should be adequately sealed to prevent leakage. Likewise, the connection between the connector 102 and the secondary burner tube 104 should also be properly sealed. A valve 106 is interposed in this fluid path. The valve 106 can be variably positioned to give the user the ability select the amount of gas entering the secondary burner. The secondary burner tube 104 is generally parallel to the primary burner tube 14. The terminal portion of the secondary burner tube 104a is closed. The primary and secondary burner tubes are typically made of steel.

A plurality of apertures 108 are along the length of the secondary burner tube 104. The apertures 108 can be evenly spaced or clustered. The apertures 108 are typically between  $\frac{1}{32}$  and  $\frac{1}{16}$  inch in diameter, but are preferably  $\frac{1}{16}$  of an inch in diameter. More importantly, the apertures are located along the radial edge of the secondary burner tube 104, below the upper ridge of the tube. By avoiding the upper ridge, the apertures are less likely to be clogged by sand. Gas passing through the valve 106 enters the secondary burner tube 104 and escapes through the spaced apertures. The apertures can be evenly spaced or clustered.

These various spaced apertures or gas discharge ports are most important in their position in regard to both the primary and secondary tube burners. In the secondary burner tube 104, the gas is discharged in a direction away from the opening of the fireplace or in another aspect is directed somewhat toward or directly toward the primary burner tube 14. The effects of such gas burn direction enhances the aesthetic beauty of the overall logs, coals, and embers burn, but, more importantly, provide several safety features of the gas-fired artificial logs, coals- and embers-burner assembly. First, the natural draft of the fireplace provides a more efficient burn of the gas and avoids high or intolerable levels

of carbon monoxide. Even more importantly is that the backward direction or gas flow direction toward the primary burner from the secondary burner avoids creation of pockets of gas in the sand and other coverage material of these burners which could possibly create a flash explosion due to accumulated gas. For example, if the gas is directed from the secondary burner 104 toward the opening of the fireplace, then two independent sources of gas pocketing occurs—one on the gas logs primary burner which may or may not be covered by granular materials as well as that generated by the secondary burner which is removed from about four to eight or ten inches in front of the primary burner. Lighting of such gas distribution pockets would be hazardous and uniformity of coordinated burn utilizing natural draft of the fireplace would be lost. If the secondary burner 104 discharges gas in a vertical direction, apertures in the sand or coverage granular material will occur and one would lose the aesthetic beauty of the applications of distribution of gas for burning and creating flame coals' and embers' appearance.

In the gas-fired artificial logs, coals- and embers-burner assembly of the invention, the primary elongated burner tube can be comprised of a one-half inch pipe while the secondary coals- and embers-burner elongated tube can be of a one-quarter inch pipe. These dimensional relationships can be varied depending on the needs for gas volume and the size of the fireplace. The spacing between the primary and secondary burner tubes can also be varied within reasonable lengths of from about four to eight or ten inches depending on the size and depth of the coals and embers bed one requires. The secondary elongated burner tube can also have adjustments for height, meaning distance elevated from the floor of the fireplace, again depending on the depth and size of the coals and embers fire bed. In all of these dimensional relationships, the present invention provides an adjustable burn facility for the secondary elongated burner tube which controls the amount of coals and embers flame and glow, again depending on the individual's desires, size of the room, size of the fireplace and the amount of natural draft through the fireplace.

FIGS. 3 and 4 illustrate the effect of the secondary burner apparatus 100 once connected to the pan burner 10. As discussed, a grate 20 is located above the pan burner which is covered with sand 22. The grate 20 can hold at least one artificial log 24. Artificial ember material 26 which glows when heated can be strewn under and around the artificial logs and on top of the sand. Flames 30 fed by gas from the primary burner tube 14 rise through the artificial logs 24. Flames 40 fed by gas from the secondary burner tube 104 can rise through the artificial ember bed 28. As illustrated, the flames 40 can be lower than the flames 30, thus providing an aesthetically pleasing sight.

Although preferred embodiments of the invention have been described in the foregoing Detailed Description and illustrated in the accompanying drawings, it will be understood that the invention is not limited to the embodiments disclosed, but is capable of numerous rearrangements, modifications, and substitutions of parts and elements without departing from the spirit of the invention. Accordingly, the present invention is intended to encompass such rearrangements, modifications, and substitutions of parts and elements as fall within the scope of the invention.

What is claimed is:

1. A gas-fired artificial logs and coals-burner assembly for fireplace comprising:
  - a elongated primary burner tube including a plurality of gas discharge ports;

- a secondary coals burner elongated tube positioned forwardly of the primary burner tube;
- a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube;
- the secondary coals burner elongated tube including a plurality of gas discharge ports;
- the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means;
- a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and
- the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.
2. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the support means for the primary burner tube is comprised of an open frame pan for supporting the primary burner tube in an elevated position relative to the fireplace floor.
3. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube discharge ports are directed toward the primary burner elongated tube at an angle of from about 5 to about 75 degrees based on the plane of the fireplace floor.
4. The gas-fired artificial logs and coals-burner assembly according to claim 3 wherein the secondary coals burner elongated tube discharge ports directed toward the primary burner tube utilizes the fireplace natural draft in achieving combustion of both gas sources in sufficient air to maintain satisfactory levels of CO.
5. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is substantially parallel to the primary burner tube and has a smaller inside diameter than the primary burner tube with the valve adjusting gas flow for coals burn and forwarding heat radiation from the fireplace.
6. The gas-fired artificial logs and coals-burner assembly according to claim 4 wherein the primary burner tube is comprised of a standard half-inch pipe and the secondary burner tube is comprised of a standard quarter-inch pipe.
7. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the elongated primary burner tube and the secondary coals burner elongated tube are spaced apart on different planes at from about four to about eight inches.
8. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is of a smaller diameter than the primary burner tube which allows for a lower profile of coals and sand coverage.
9. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube.
10. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein at least two secondary coal burner elongated tubes are utilized for artificial coal burn and radiant heat generation.
11. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary and secondary burner tubes have apertures of from about  $\frac{1}{32}$  inch to about  $\frac{1}{4}$  inch.

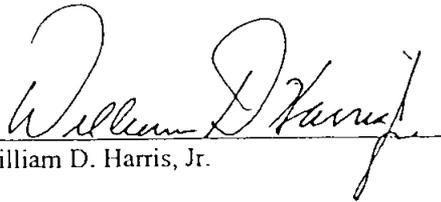
12. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the gas flow adjustment valve has a removable handle, the gas flow adjustment allowing a variety of settings from full closed to full open.
13. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the connection means is comprised of a connector attached to the terminal end of the primary burner tube at a first end of a connector and attached to the secondary coals burner elongated tube to a connector second end with the valve interposed between the primary burner tube and the secondary burner tube.
14. The gas-fired artificial logs and coals-burner assembly according to claim 13 wherein the connector generally is shaped outward from the first end connected to the primary burner tube, directed generally perpendicular to the burner tubes alignment and inward to the second end connected to the secondary burner tube, the valve and connector being positioned generally exterior of the primary and secondary burner tube fire zones.
15. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open frame pan and primary elongated burner tube is positioned under an artificial logs and grate support means.
16. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary elongated burner tube is covered with sand and the secondary elongated burner tube is covered with sand, mica, and fibrous materials which simulate coals and ember burn.
17. A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:
- a secondary coals burning elongated tube;
- a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube being in gas flow communication with the primary burner tube being the connection means, a gas distribution ports of the secondary burner tube directed away from the fireplace opening.
18. The gas-fired artificial coals- and embers-burner apparatus according to claim 1, wherein the gas distribution ports of the secondary burner tube are directed toward the primary burner tube at from about 5 degrees to about 75 degrees elevation from the fireplace floor.
19. A gas burner assembly for use in a fireplace comprising:
- a primary burner tube having a first end and a second end, said first end adapted to be connected to a gas source with a gas flow control means for controlling the amount of gas flowing into said primary burner tube;
- a second burner tube;
- a connector tube attached to said second end of said primary burner tube and to said second burner tube to provide fluid communication between said primary burner tube and said second burner tube; and
- a valve disposed in said connector tube for selectively controlling the flow of gas from said primary burner tube into said second burner tube.

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Plaintiff Golden Blount Inc.'s Opening Claim Construction Brief was served on the following counsel of record on May 17, 2002, by United States Postal Service Express Mail:

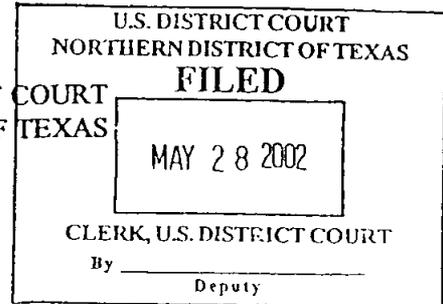
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William D. Harris, Jr.

JJ-APP 0426

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC., )  
 )  
Plaintiff, )  
 )  
v. )  
 )  
ROBERT H. PETERSON CO., )  
 )  
Defendant. )

Civil Action No.: 3:01-CV-0127-R

**DEFENDANT ROBERT H. PETERSON COMPANY'S  
RESPONDING BRIEF REGARDING CLAIM CONSTRUCTION**

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IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,            )  
  )  
                  Plaintiff,            )  
  )  
                  v.                    )     Civil Action No.: 3:01-CV-0127-R  
  )  
ROBERT H. PETERSON CO.,        )  
  )  
                  Defendant.         )

**DEFENDANT ROBERT H. PETERSON COMPANY'S  
RESPONDING BRIEF REGARDING CLAIM CONSTRUCTION**

Defendant Robert H. Peterson Company ("PETERSON CO.") respectfully submits this responding brief regarding the interpretation of disputed claim terms in U.S. Patent No. 5,988,159 ("the '159 patent-in-suit") (Ex. 1).

**I. GENERAL PRINCIPLES OF CLAIM INTERPRETATION**

PETERSON CO. generally agrees with Plaintiff Golden Blount, Inc.'s ("BLOUNT") discussion on claim interpretation under Section III at pages 2-5 of its Opening Claim Construction Brief. One exception is that BLOUNT does not define any standard for one of ordinary skill in the art at the time the patent was filed. PETERSON COMPANY submits a person of ordinary skill in the art would be a tradesman having a high school education and experience in arranging tubing for gas flow for the purpose of constructing fireplace assemblies. A person of ordinary skill would also have experience in the design of non-

complex mechanical structures.<sup>1</sup>

## **II. BACKGROUND OF THE RELEVANT ART**

Gas burning fireplaces have been used as an alternative to wood burning fireplaces for decades. Gas logs, usually made of fire resistant ceramic material, are placed on grates which are located over a gas burner tube ("primary burner tube") having a series of perforations to permit the ignited gas to surround the decorative gas logs (Ex. 1, Col. 5, l. 14-25; Col. 6, l. 47-48). A pan burner is used to support a primary burner tube positioned within openings on the vertical walls of the pan burner. The pan burner with the primary burner is positioned under a grate which supports artificial gas logs. Sand and vermiculite is spread on the pan burner to cover the primary burner tube while at the same time permitting any gas escaping from the primary burner tube to be ignited. This produces a burning embers effect on the sand/vermiculite material, imitating the burning embers of a natural wood fireplace (Ex. 1, Col. 1, l.47-55).

## **III. THE PROSECUTION HISTORY OF THE '159 PATENT-IN-SUIT**

Sometime in 1993, Golden Blount, the named inventor, allegedly developed an optional accessory for gas log sets which he referred to as a Controlled Ember-Bed Burner, which comprised a connector tube for connecting to the primary burner, with a gas control valve positioned in the connector tube, and a secondary burner tube adapted to be positioned forward of and below the primary burner tube. The secondary burner tube produced a flame

---

<sup>1</sup>In its Trial Brief (Ex. 5) at paragraph (7)(b), Blount stated that "The level of skill in the art is modest; a person with only several years of experience, perhaps 5 years, would approximate this level -- this becomes a definition of a person of ordinary skill in the art."

forwardly of the primary burner tube. On May 17, 1993, BLOUNT filed United States Patent Application No. 08/061,727 entitled "Controlled Ember Bed Burner." (Ex. 1, Col. 1, l. 9-10). That application described a secondary burner for optional use with an artificial log system. The secondary burner is positioned in front of and below the log system. The claims of the '727 application were rejected and the application was abandoned. P r i o r t o abandonment of the '727 application, BLOUNT filed United States Patent Application No. 08/276,894 entitled "Supplemental Burner for Retrofitting to an Existing Gas Log Burner Assembly" as a continuation-in-part of the '727 application (Ex. 1, Col. 1, l. 5). The '894 application included 18 claims. Claim 1 specified a supplemental burner for retrofitting to an existing gas log burner assembly having a primary burner tube with a terminal end, the supplemental burner comprised a connector attached to the terminal end of the primary burner; a secondary burner tube attached to the connector; and a valve interposed between the supplemental burner tube and the connector. All of the claims were rejected as obvious over Eiklor, et al., U.S. Patent No. 5,033,455 in view of Peterson, U.S. Patent No. 3,042,109 and Henry, U.S. Patent No. 3,871,355

BLOUNT submitted a declaration alleging commercial success of the invention. In an advisory action mailed April 30, 1996, the U.S. Patent and Trademark Office indicated that the applicant's arguments were not persuasive, noting that:

"This combination of references when compared to the claims at issue leaves very little to differ over. Thus, the secondary considerations when considered in light of this difference carries much less weight in affecting a decision of patentability." (Ex. 2, p. 2-3).

A Notice of Abandonment of the '894 application was mailed on May 30, 1996.

Prior to this abandonment, BLOUNT filed U.S. Application no. 08/626,498 on April

2, 1996 as a continuation-in-part of the '894 application (Ex. 1, p. 1). With an amendment filed on July 10, 1998 in connection with the '498 application, claim 1 specifies, in pertinent part:

“...a support means for holding the elongated primary burner tube in a raised level relative to a forward position secondary coals burner elongated tube;...”.

This limitation was not included in the prior abandoned applications.

After an amendment was made by the examiner to correct antecedent problems, including specifying the secondary coals burner elongated tube as a separate element, the U.S. Patent Office issued a Notice of Allowance on January 19, 1999.

#### **IV. THE CONSTRUCTION OF DISPUTED CLAIM TERMS IN THE '159 PATENT-IN-SUIT**

##### **A. Independent claims 1 and 17.**

The '159 patent-in-suit issued on November 23, 1999, based on application no. 08/626,498 discussed *supra*. The '159 patent issued with 19 claims, of which claims 1, 17 and 19 were independent. Claim 19 is not being asserted in this litigation, and will not be discussed herein. Claims 1 and 17 are set forth below in their entirety, with disputed terms underlined.

1. A gas-fired artificial logs and coals-burner assembly for fireplace comprising:  
an elongated primary burner tube including a plurality of gas discharge ports;  
a secondary coals burner elongated tube positioned forwardly of the primary burner tube;

a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube,

the secondary coals burner elongated tube including a plurality of gas discharge ports;

the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means;

a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and

the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.

17. A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:

a secondary coals burning elongated tube;

a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube being in gas flow communication with the primary burner tube being the connection means, a gas distribution ports of the secondary burner tube directed away from the fireplace opening.

#### **B. The Disputed Claim Terms**

PETERSON CO. will address the disputed claim terms in the order identified in the

BLOUNT opening brief.

**1. "Second Coals Burner Elongated Tube"**

The term "secondary coals burner elongated tube" (claims 1 and 17) refers to a tube that is positioned forward to and below the primary burner tube. This limitation must be construed in combination with the limitation described in paragraph 2. below relative to the limitation of "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly positioned secondary closed burner elongated tube." As noted above, these limitations were separated by the examiner to correct antecedent problems in the claim. The BLOUNT opening brief ignores this relationship and instead tries to interpret the limitation only with respect to providing a flame under artificial coals.

The purpose of the secondary burner tube is to provide more flame to the front of the fireplace. This is best illustrated in Fig. 3 and the description contained in column 6, lines 40-52 of the '159 patent-in-suit (Ex. 1).

The '159 patent-in-suit describes Fig. 3 as follows:

Figs. 3 and 4 illustrate the effect of the secondary burner apparatus 100 once connected to the pan burner 10. As discussed, a grate 20 is located above the pan burner which is covered with sand 22. The grate 20 can hold at least one artificial log 24. Artificial ember material 26 which glows when heated can be strewn under and around the artificial logs and on top of the sand. Flames 30 fed by gas from the primary burner tube 14 rise through the artificial logs 24. Flames 40 fed by gas from the secondary burner tube 104 can rise through the artificial ember bed 28. As illustrated, the flames 40 can be lower than the flames 30, thus providing an aesthetically pleasing sight.

BLOUNT's description of the term "secondary coals burner elongated tube" fails to describe the relative positions of the primary burner and the secondary burner to one another

from a horizontal and a vertical perspective. (BB, p. 8)<sup>2</sup> There is no description of any embodiment pictorially or verbally which illustrates any orientation of the primary burner tube and the secondary burner tube other than the secondary burner tube is forward to and completely below the primary burner tube.

The term "secondary coals burner elongated tube" should be interpreted to mean a secondary burner tube positioned forward to and completely below an elevated primary burner.

2. **"A Support Means For Holding the Elongated Primary Burner Tube in a Raised Level Relative to the Forwardly Positioned Secondary Coals Burner Elongated Tube"**

The term "support means for holding the elongated primary burner tube in a raised level relative to the forwardly positioned secondary coals burner elongated tube" refers to the standard pan burner 10 (Ex 1, Fig. 2) which contains two openings through which the primary burner tube 14 is inserted. This enables the primary burner tube 14 to be held in an elevated position vis a vis the secondary burner tube 104.

The principal dispute between the parties regarding this term revolves around the meaning of "raised level." PETERSON CO. submits that the term "raised level" means that the gas apertures (ports) 18 of the primary burner 14 are positioned above the apertures (ports) 108 contained along the length of the secondary burner tube 104. Repeating the description of Fig. 3 contained in column 6, lines 47-52, the '159 patent (Ex. 1) states:

Flames 30 fed by gas from the primary burner 14 rise through the artificial logs 24. Flames 40 fed by gas from the secondary burner tube 104 can rise through the artificial ember bed 28. As illustrated, the flames 40 can be lower than the flames 30,

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<sup>2</sup>"BB" refers to Blount Brief.

thus providing an aesthetically pleasing sight.

The relative position of the flames from the primary and secondary burner tubes controls the aesthetics of the fire which is achieved and the safety of operation (Ex. 1, Col. 5, l. 55-65). This, according to the '159 patent, is the primary purpose for the secondary burner (Ex. 1, Col. 3, l. 20-30). As such, the term "raised level" refers specifically to the relative orientation of the gas ports of the primary burner and the secondary burner.

In contrast, BLOUNT interprets the meaning of the term "raised level" to mean that:

"The uppermost portion of the primary burner tube is higher than the uppermost portion of the secondary coals burner elongated tube." (BB, p. 9).

This interpretation is incorrect for the simple reason that the relative position of the tops of the burner tubes is irrelevant to any aspect to the invention described and claimed in the '159 patent. It is not the tops of the primary and secondary burner tubes which impact the aesthetic appearance of the flame and ember effect produced in the fireplace. Rather, it is the relative position of the gas ports in the primary and secondary burner tubes which produce the aesthetic effect which the '159 patent claims (Ex. 1, Col. 3, l. 20-30).

To support its position, BLOUNT refers to Column 6, lines 30-35 of the '159 patent-in-suit wherein the specification recites that:

"The secondary elongated burner can also have adjustments for height . . . depending on the depth and size of the coals and embers fire bed."

However, BLOUNT ignores that next sentence in column 6 which explains the primary purpose of any adjustments in the positioning of the secondary burner tube, to wit:

"In all of these dimensional relationships, the present invention provides an adjustable burn facility for the secondary elongated burner tube which controls the amount of coals and embers flame and glow again depending on the individual's

desires, size of the room, size of the fireplace and the amount of natural draft through the fireplace.” (Col. 6, l. 34-40). (Emphasis added).

It is obvious from this description that it is the position of the gas ports of the primary burner tube which are in a raised relationship to the gas ports of the secondary burner tube. Moreover, the depth of the coals and embers fire bed is a limiting factor for height of the secondary burner, not the primary burner. The primary burner need not be at a raised level relative to the secondary burner because of depth of the coals and ember fire bed. The top of the primary burner could be lower than the secondary burner to satisfy the depth concerns.

Since the '159 patent expressly states that the gas ports are not to be positioned on the upper ridge of the secondary burner tube so as to avoid clogging by sand, BLOUNT's interpretation of the term “raised level” is further contradicted by the specification of the '159 patent itself. (Col. 5, l. 49-53).

Furthermore, the term “raised level” is not used in the '159 patent-in-suit. The only analogous term used is “below.” (Ex. 1, Col. 3, l. 54-60). Fig. 2 and 3 show the entire secondary burner tube 104 positioned below the lowermost portion of the primary burner 14. (Also, see Ex. 6). Given this description and illustration, the term “raised level” should also refer to the secondary burner tube being positioned completely below the lowermost portion of the primary burner tube 14.

Moreover, Plaintiff's interpretation of the term “raised level” *vis a vis* the uppermost portions of the primary burner tube and secondary burner tube conflicts with its own interpretation of the term “raised level” submitted to this court in its Findings of Fact and Conclusions of Law on or about April 19, 2002 (Ex. 4, p.6), as well as its Issue Directed Trial Brief submitted the same date (Ex. 5). Specifically, in interpreting Claim 1, BLOUNT stated:

"d) The elongated primary burner tube is held up by the side of the pan through which the elongated primary burner tube extends. The elongated primary burner tube is at a raised level with respect to the secondary coals burner elongated tube, (e.g., with respect to the center line) (emphasis added) (Ex. 4, p. 6).

The term "center line" does not appear anywhere in the '159 patent, nor is it illustrated. Having realized that it had no support in the specification for such an interpretation, BLOUNT has shifted gears and moved its interpretation of the term "raised level" to the relative vertical relationship between the uppermost portions of the primary tube and the secondary burner tube.

Both of BLOUNT's proffered interpretations lack support in the specification, having no import whatsoever in the attainment of the aesthetic effect of ember burning which the '159 patent-in-suit professes to achieve.

Therefore, the term "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly positioned secondary coals burner elongated tube" refers to a burner pan having perforations formed on the burner pan through which the elongated primary burner tube is inserted so as to position the gas ports of the primary burner tube in a raised position vis a vis the gas ports of the secondary coals burner elongated tube. Additionally, the term "raised level" also means that the entire secondary burner tube is positioned below the lowermost portion of the primary burner tube.

### 3. "Tubular Connection Means"

The PETERSON CO. accepts the definition of the term "tubular connection means" contained in BLOUNT's brief (p. 11).

4. **“Positioned Under an Artificial Logs and Grate Support Means”**

PETERSON CO. respectfully submits that this limitation should be given its plain and ordinary meaning, *i.e.*, that the pan and primary burner tube are positioned under artificial gas logs and grate support means, as depicted in Figs. 3 and 4 (Ex. 1). In fact, BLOUNT in its opening brief concurs that the term has a plain and common meaning. However, BLOUNT then twists the claim language 180° to specify that artificial logs and a grate are positioned over the open flame pan. BLOUNT does not explain any reason for twisting the claim language. BLOUNT is apparently attempting to read elements into the claim that are not positively recited in the claim.

5. **“Secondary Coals Burning Elongated Tube”**

PETERSON CO. incorporates by reference the arguments presented in section B.1., supra with respect to this identical term, found in claim 1, and also used in claim 17. Defendant PETERSON CO. requests that the term “secondary coals burning elongated tube” be interpreted to mean:

“secondary coals burner elongated tube” should be interpreted to mean a secondary burner tube positioned forward to and completely below an elevated primary burner. “

6. **“Connector Means”**

PETERSON CO. accepts the definition of the term “connector means” contained in BLOUNT’s brief (p. 14).

7. **“Below the Primary Burner”**

PETERSON CO. incorporates by reference the arguments presented in section B.2., supra, with respect to the term “raised level.” PETERSON CO. submit that the term “below the primary burner tube” (claim 17):

“refers to a burner pan having perforations through which the elongated primary burner tube is inserted so as to position the gas ports of the primary burner tube in a raised position vis a vis the gas ports of the secondary coals burner elongated tube. Additionally, the term “below the primary burner” also means that the entire secondary burner tube is positioned completely below the lowermost portion of the primary burner tube.”

8. **“Directed Away from the Fireplace Opening”**

The term “directed away from the fireplace opening” (claim 17) refers to the direction of gas being emitted from the secondary coals burner elongated tube. PETERSON CO. respectfully submits that this term means that the gas emitting from the secondary coals burner tube are directed away from the front of the fireplace and specifically in the direction of the primary burner tube, i.e., toward the interior of the fireplace. The gas ports of the secondary burner tube cannot be directed either vertically upward or essentially vertically upward because these gas jets would become clogged by the sand and/or other granular material which covers the secondary burner tube. The gas ports of the secondary burner tube cannot be directed either vertically downwardly or essentially vertically downwardly because this would cause the gas emitting from the gas ports to strike the bottom of the fireplace and move in a 90° direction toward the front of the fireplace (Ex. 7). This is prohibited by the patent specification because it will negatively impact the aesthetic effect sought to be produced by the alleged invention disclosed and claimed in the '159 patent-in-suit.

There are several descriptions in the '159 patent specification which define to a person of ordinary skill in the art the meaning of the term "directed away from the fireplace opening,"

to wit:

"More importantly, the apertures are located along the radial edge of the secondary burner tube 104, below the upper ridge of the tube [Fig. 2]. By avoiding the upper ridge, the apertures are less likely to be clogged by sand." (Ex. 1, Col. 5, l. 49-52).

"These various spaced apertures or gas discharge ports are most important in their position in regard to both the primary and secondary tube burners. In the secondary burner tube 104, the gas is discharged in a direction away from the opening of the fireplace or in another aspect is directed somewhat toward or directly toward the primary burner tube 14. The effects of such gas burn direction enhances the aesthetic beauty of the overall logs, coals and ember burn, but, more importantly, provides several safety features of the gas-fired artificial logs, coals and ember burner assembly. First, the natural draft of the fireplace provides a more efficient burn of the gas and avoids high or intolerable levels of carbon monoxide. Even more importantly is that the backward direction or gas flow direction toward the primary burner from the secondary burner avoids creation of pockets of gas in the sand and other coverage material of these burners which could possibly create a flash explosion due to accumulated gas. For example, if the gas is directed from the secondary burner 104 toward the opening of the fireplace, then two independent sources of gas pocketing occurs - one on the gas logs primary burner which may or may not be covered by granular materials as well as that generated by the secondary burner which is removed from about 4 to 8 or 10 inches in front of the primary burner. Lighting of such gas distribution pockets would be hazardous and uniformity of coordinated burn utilizing natural draft of the fireplace would be lost." (Ex. 1, Col. 5, l. 56-col. 6, l. 15). (Emphasis added).

Because directing the flames of the secondary burner tube vertically downwardly to the floor of the pan or fireplace would result in at least a portion of the gas going out toward the front of the fireplace (Ex. 7), the orientation of the gas ports in the secondary burner tube vertically

downwardly is prohibited by the above identified portions of the specification of the '159 patent-in-suit. Given the above-identified description, the term "directed away from the fireplace opening" requires the gas ports of the secondary burner tube to be directed sufficiently toward the primary burner tube to the degree required to prevent any portion of the gas from being directed to the front of the fireplace.

BLOUNT asserts that the term "directed away from the fireplace opening" refers to "gas discharge ports of the secondary coals burning elongated tube [which] may be directed from vertically down, to any position approaching 179° in a clockwise direction." (BB, p. 16). This interpretation directly contradicts the statements contained in the specification of the '159 patent-in-suit quoted above. The primary difference between the interpretations of BLOUNT and the PETERSON CO. regarding this particular term is that the PETERSON CO. interpretation prohibits a vertically downward or essentially vertically downward orientation of the gas jets of the secondary burner tube, and requires, in accordance with the specification portions quoted above, that the gas ports of the secondary burner tube be oriented so that the flames are directed inwardly toward the primary burner for both safety and aesthetic purposes.

In contrast, BLOUNT asserts that the gas ports of the secondary burner tube can be oriented vertically downwardly, but offers no explanation as to the gas which will strike the bottom of the burner pan and/or the floor of the fireplace, with at least a portion of the gas being directed toward the opening of the fireplace, in direct contravention to BLOUNT's own specification (Ex. 7). Consequently, BLOUNT's interpretation of this term, to at least the extent that it permits the gas ports of the secondary burner tube to be oriented vertically downwardly, is prohibited by the specification.

Therefore, the term "directed away from the fireplace opening" refers to gas ports on the secondary coals burner elongated tube which are oriented inwardly toward the primary burner to the degree required to prevent any flames from being directed outwardly toward the front of the fireplace.

### CONCLUSIONS

For the above-stated reasons, the PETERSON CO. respectfully requests that the court adopt its interpretation of the disputed terms as follows:

1. The term "secondary coals burner elongated tube" (claims 1 and 17) refers to a tube that is positioned forward to and completely below the primary burner. The purpose of the secondary burner is to provide more flame to the front of the fireplace.
2. The term "support means for holding the elongated primary burner tube in a raised level relative to the forwardly positioned secondary coals burner elongated tube" refers to a burner pan having perforations through which the elongated primary burner tube is inserted so as to position the gas ports of the primary burner tube in a raised position vis a vis the gas ports of the secondary coals burner elongated tube. Additionally, the term "raised level" also means that the entire secondary burner tube is positioned completely below the lowermost portion of the primary burner tube.
3. The PETERSON CO. accepts the definition of the term "tubular connection means" contained in BLOUNT's brief (p. 11).

4. The term "positioned under an artificial log and grate support means" should be given its plain ordinary meaning, i.e., that the pan burner and primary burner tube are positioned under artificial gas logs and grate support means, as depicted in Figs. 3 and 4 (Ex. 1).
5. The term "secondary coals burner elongated tube" (claims 1 and 17) refers to a tube that is positioned forward to and completely below the primary burner. The purpose of the secondary burner is to provide more flame lower and to the front of the fireplace. See, Interpretation No. 1.
6. PETERSON CO. accepts the definition of the term "connector means" contained in BLOUNT's brief (p. 14).
7. The term "below the primary burner tube" refers to:  
  
"to a burner pan having perforations through which the elongated primary burner tube is inserted so as to position the gas ports of the primary burner tube in a raised position vis a vis the gas ports of the secondary coals burner elongated tube. Additionally, the term "below the primary burner" also means that the entire secondary burner tube is positioned completely below the lowermost portion of the primary burner tube."
8. The term "directed away from the fireplace opening" refers to gas ports on the secondary coals burner elongated tube which are oriented inwardly toward the primary burner to the degree required to prevent any flames from being directed outwardly toward the front of the fireplace.

Respectfully submitted,

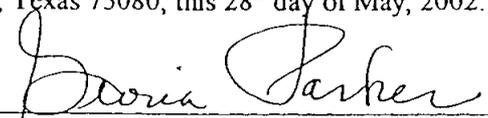
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CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing document was served by hand delivery to counsel for Plaintiff, William D. Harris, Jr., Hitt Gaines Boisbrun, P.C., 225 University Plaza, 275 West Campbell Road, Richardson, Texas 75080, this 28<sup>th</sup> day of May, 2002.

  
Gloria Parker

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

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§  
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Civil Action No.

3-01CV0127-R

PLAINTIFF GOLDEN BLOUNT, INC.'s REPLY TO DEFENDANT  
ROBERT H. PETERSON'S RESPONSIVE CLAIM CONSTRUCTION BRIEF

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I. INTRODUCTION

This is plaintiff's reply to defendant's responsive claim construction brief. On May 17, 2002, plaintiff submitted its opening claim construction brief (with appendix), which covered numerous suggested interpretations, both in the text and in the appendix. Defendant's responsive claim construction brief filed on May 28, 2002, accepted these interpretations except for those which it enumerated (listed below). Accordingly, the only terms that are presently in issue are as follows: A) "secondary coals burner elongated tube," B) "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly positioned secondary coals burner elongated tube," C) "positioned under an artificial logs and grate support means," D) "below the primary burner," and E) "directed away from the fireplace opening."

II. THE PROSECUTION HISTORY OF THE '159 PATENT-IN-SUIT

The Defendant, in its responsive claim construction brief of May 28, 2002, directed an entire section solely to the prosecution history of the '159 Patent. It appears, however, that the defendant is attempting to muddy the water by including such a section. Nowhere in that section, nor any section directed to the claim interpretation, is the defendant asserting that the prosecution history be used to facilitate its claim construction. While the plaintiff agrees wholeheartedly with the defendant that prosecution history exists for the '159 patent, as it would for every patent that issues, it also wholeheartedly agrees that the prosecution history of the '159 Patent is not relevant nor required for the claim construction at hand. Actually, the record of prosecution is noteworthy if not remarkable by how "clean" it is. Exhibits 2 and 3 of defendant's responsive claim construction brief furthers this point, and while file wrapper estoppel (i.e., prosecution history estoppel) is not really germane at this point, its absence of discussion shows how benign the prosecution is. Accordingly, the prosecution history of the '159 Patent is clearly not an issue.

### III. THE CONSTRUCTION OF DISPUTED CLAIM TERMS IN THE '159 PATENT-IN-SUIT

#### A. "Secondary Coals Burner Elongated Tube"

Plaintiff maintains its position that the claim term "secondary coals burner elongated tube" has a plain and common meaning and should be interpreted to mean a tube that is configured to provide a flame under artificial coals. As specifically pointed out in plaintiff's Opening Claim Construction Brief, the specification clearly supports such an interpretation.

Defendant asserts that the purpose of the secondary burner tube is to provide more flame to the front of the fireplace. Defendant supports this assertion using Fig. 3 and the description contained in column 6, lines 40-52, of the '159 patent-in-suit. As defendant pointed out, the '159 patent-in-suit describes Fig. 3 as follows:

FIGS. 3 and 4 illustrate the effect of the secondary burner apparatus 100 once connected to the pan burner 10. As discussed, a grate 20 is located above the pan burner which is covered with sand 22. The grate 20 can hold at least one artificial log 24. Artificial ember material 26 which glows when heated can be strewn under and around the artificial logs and on top of the sand. Flames 30 fed by gas from the primary burner tube 14 rise through the artificial logs 24. Flames 40 fed by gas from the secondary burner tube 104 can rise through the artificial ember bed [i.e., coals] 28. As illustrated, the flames 40 can be lower than the flames 30, thus providing an aesthetically pleasing sight. (Emphasis added)

Plaintiff agrees with defendant that the aforementioned description suggests that the "secondary coals burner elongated tube" is designed to provide a flame toward the front of the fireplace. However, if the defendant were to continue its reading of the same paragraph, it would observe that the aforementioned description also suggests that the "secondary coals burner elongated tube" is designed to provide flames 40 under the artificial ember bed 28 [i.e., coals]. As easily (and properly) as one could read this paragraph to suggest that the "secondary coals burner elongated tube" is designed to provide a flame toward the front of the fireplace, one could read this paragraph to say that the "secondary coals burner elongated tube" is designed to provide a flame under the artificial coals. In furtherance of this, the claim term (opposite the term used in the specification) includes the phrase "coals burner," which furthers plaintiff's construction.

In addition, defendant asserts that plaintiff's description of the term "secondary-coals burner elongated tube" fails to describe the relative position of the primary burner tube and the secondary coals burner tube to one another. Clearly, no position is imparted when using the term "secondary coals burner elongated tube" alone, except that it is designed to burn coals, as the name suggests and the specification supports. While plaintiff agrees that there is an element of Claim 1 that positions the primary burner tube and the secondary burner tube with respect to one another, that element is addressed in the section directly below this one, named "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube."

**REQUESTED INTERPRETATION**

The term "secondary coals burner elongated tube" should be interpreted to mean a tube that is configured to provide a flame under artificial coals.

**B. "A Support Means for Holding the Elongated Primary Burner Tube in a Raised Level Relative to the Forwardly Position Secondary Coals Burner Elongated Tube"**

The principal dispute between the parties regarding this term revolves around the meaning of "raised level". Plaintiff maintains its position, however, that the claim term "raised level" should be interpreted to mean that the upper most portion of the primary burner tube is higher than the upper most portion of the secondary coals burner elongated tube. Additionally, however, plaintiff asserts that the claim term "raised level" should be interpreted to mean that the centerline of the primary burner tube is higher than the centerline of the secondary coals burner elongated tube.<sup>1</sup>

In contrast, defendant interprets the meaning of the term "raised level" to mean that the position of the gas ports of the primary burner tube be at a raised level with respect to the gas ports of the secondary burner tube. To support its belief, defendant refers the Court to column 6, lines 30-40 of the patent-in-suit, wherein the specification recites that:

"The secondary elongated burner tube can also have adjustments for height, meaning distance elevated from the floor of the

---

<sup>1</sup> Defendant noted that plaintiff's pretrial materials asserted the "center line" as a reference point that could be used. Plaintiff finds no problem with this reference point.

fireplace, again depending on the depth and size of the coals and embers fire bed. In all of these dimensional relationships, the present invention provides an adjustable burn facility for the secondary elongated burner tube which controls the amount of coals and embers flame and glow, again depending on the individual's desires, size of the room, size of the fireplace and the amount of natural draft through the fireplace." (Emphasis added)

Defendant incorrectly characterizes to the Court what the phrase "adjustable burn facility for the secondary burner tube which controls the amount of coals and embers flame and glow" means. Defendant argues that the phrase adjustable burn facility is referring to the adjustable position of the gas ports of the secondary burner tube with respect to the primary burner tube. Defendant contends that it is this adjustable position that controls the amount of coals and embers flame and glow. Clearly this is not the case.

The adjustable burn facility, and thus the amount of coals and embers flame and glow, is provided by the adjustable valve 106, not the adjustable position of the gas ports of the secondary burner tube with respect to the primary burner tube. Column 3, line 65 through column 4, line 3, of the '159 Patent recites that "the gas flow is regulated selectively by the valve which is interposed between the primary and secondary burners in the connection means. The control of gas flow thus controls the height of the coals and embers bed flames. Accordingly, it is the valve 106 that provides the adjustable burn facility, and not the adjustable position of the gas ports of the secondary burner tube, as offered by defendant. The defendant's characterization is misleading, and thus, raised level is not measured with respect to the gas discharge ports.

Defendant also argues that the term "raised level" requires that the entire secondary burner tube be positioned below the lowermost portion of the primary burner tube. (Defendant also argued this during its interpretation of the term "secondary coals burner elongated tube"). In support of this, defendant provides its Exhibit 6 (a reproduction of FIG. 3 of the '159 Patent), which shows a line labeled "Level" illustrating how the entire secondary burner tube is positioned below the lowermost portion of the primary burner tube. The defendant, once again, has mischaracterized the teachings of the '159 Patent. Defendant's reproduction of FIG. 3 of the '159 Patent is identical to that shown in FIG. 3 of the '159 Patent, with the exception of one thing: FIG. 3 of the '159 patent shows that the secondary coals burner elongated tube is

positioned on the fireplace floor, wherein the defendant's reproduction of FIG. 3 illustrates that the secondary coals burner elongated tube is elevated off of the fireplace floor.

This distinction is important to the claim interpretation of the term "raised level." As the defendant correctly pointed out, as well as Claim 9 recites, the secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube. Applying the defendant's suggested interpretation that the entire secondary burner tube be positioned below the lowermost portion of the primary burner tube to the actual FIG. 3 of the '159 Patent, would make Claim 9 totally inoperative. The Courts are well settled that an interpretation of a claim that would render two related claims in a patent inconsistent is "presumptively unreasonable."<sup>2</sup>

As previously recited, applying defendant's suggested interpretation that the entire secondary burner tube be positioned below the lowermost portion of the primary burner tube to the actual FIG. 3 renders Claim 9 totally inoperative. In contrast, applying the defendant's suggested interpretation that the entire secondary burner tube be positioned below the lowermost portion of the primary burner tube to defendant's mischaracterized Exhibit 6, doesn't render Claim 9 totally inoperative. It appears that the defendant modified its Exhibit 6 for this reason. Plaintiff's interpretation of the term "raised level" allows the secondary coals burner elongated tube illustrated in FIG. 3 to be adjusted upwards without making Claim 9 totally inoperative. Clearly, this was the intent of the specification and the only way to make Claim 1 and Claim 9 consistent with each other.

Defendant pointed the Court to the fact that plaintiff's Findings of Fact and Conclusions of Law, as well as plaintiff's Issue Directed Trial Brief, referred to the centerline as the reference point. An interpretation that the claim term "raised level" means that the centerline of the primary burner tube is higher than the centerline of the secondary coals burner elongated tube is equally as feasible as an interpretation that the claim term "raised level" means that the upper most portion of the primary burner tube is higher than the upper most portion of the secondary coals burner elongated tube. Of importance, either of the interpretations may be used without

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<sup>2</sup> *Wright Medical Technology, Inc. v. Osteonics Corp.*, 122 F.3d 1440 (Fed. Cir. 1997).

going against the requirements of Claim 9, as happens when defendant's suggested interpretation is used.

**REQUESTED INTERPRETATION**

The phrase "a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube" should be interpreted to mean that a support structure holds the upper most portion of the primary burner tube higher than the upper most portion of the secondary coals burner elongated tube, or alternatively, that a support structure holds the centerline of the primary burner tube higher than the centerline of the secondary coals burner elongated tube.

**C. "Positioned under an Artificial Logs and Grate Support Means"**

Plaintiff maintains its position that the claim term "positioned under an artificial logs and grate support means" has a plain and common meaning and should be interpreted to mean that a set of artificial logs and a grate support are positioned over the open frame pan and the primary burner elongated tube. Defendant contends that plaintiff has twisted the claim language 180°. With the exception of a few words, defendant's suggested interpretation is identical to plaintiff's. The major difference between the two interpretations is that plaintiff uses the term "grate" and defendant uses the term "grate support means."

While plaintiff does not entirely understand defendant's argument about 35 U.S.C. § 112, ¶ 6, it certainly appears that this statute raised no problem. The courts are very clear that when sufficient structure for performing a claim function is provided, no interpretation problem is presented.<sup>3</sup> Plaintiff asserts that the term "grate" provides sufficient structure for performing the claimed function of supporting the artificial logs. Thus, there is no issue.

**REQUESTED INTERPRETATION**

The term "positioned under an artificial logs and grate support means" should be interpreted to mean that a set of artificial logs and a grate support are positioned over the open frame pan and the primary burner elongated tube.

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<sup>3</sup> See *Al-Site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 1318 (Fed. Cir. 1999).

D. "Below the Primary Burner"

Plaintiff incorporates by reference the arguments presented in section B., supra, with respect to the term "raised level."

REQUESTED INTERPRETATION

The phrase "below the primary burner tube" should be interpreted to mean that the upper most portion of the secondary coals burner elongated tube is lower than the upper most portion of the primary burner tube, or alternatively, that the centerline of the secondary coals burner elongated tube is lower than the centerline of the primary burner tube

E. "Directed Away from the Fireplace Opening"

Plaintiff maintains its position that the claim term "directed away from the fireplace opening" has a plain and common meaning and should be interpreted to mean that the gas discharge ports of the secondary coals burning elongated tube may be directed from vertically down, to any position approaching 179 degrees in the clockwise direction, but may not be located vertically upward.<sup>4</sup>

Defendant contends that the term "directed away from the fireplace opening," among other things, means that the gas ports of the secondary burner tube cannot be directed either vertically downwardly or essentially vertically downwardly because this would cause the gas emitting from the gas ports to strike the bottom of the fireplace and move in a 90° direction toward the front of the fireplace. Defendant's interpretation requires that the gas ports of the secondary burner tube be directed sufficiently toward the primary burner tube to the degree required to prevent any portion of the gas from being directed to the front of the fireplace, and thus, prevent any potentially deadly combustion.<sup>5</sup> Defendant uses its Exhibit 7, as well as discussions associated therewith, to support this contention. Plaintiff argues that Exhibit 7, of which defendant relies, is no more than unproven extrinsic evidence.

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<sup>4</sup> Plaintiff respectfully wishes to inform the Court that this term is strictly limited to Claim 17, and should not be imparted on independent Claim 1.

<sup>5</sup> It is realized that this Brief is not intended as an infringement analysis, but defendant's statement that the openings cannot be straight down without creating potential hazard, flies directly in the face of defendant's own device. The apertures of Defendant's own device appear to point vertically downward, and none of the terrible consequences seem to occur.

As the Court is well aware, extrinsic evidence may only be relied upon to construe the claim terms themselves "when the claim language remains genuinely ambiguous after consideration of the intrinsic evidence."<sup>6</sup> Defendant's Exhibit 7, and the arguments concerning it, are improper in that the assumption presented is an extrinsic technical assertion, and only intrinsic evidence should be used. Moreover, defendant's Exhibit 7 is not only extrinsic evidence, but unproven evidence. As it is, Exhibit 7 is an extrinsic lay opinion.

Defendant failed to take one important factor into consideration while rationalizing its interpretation of the claim term "directed away from the fireplace opening." Namely, defendant's supposed logic is flawed because it failed to consider the effect the draft of the fireplace has on the gas exiting the gas discharge ports of the secondary coals burning elongated tube. Column 4, lines 15-21, of the '159 Patent recites that "the gas flow from the secondary burner away from the opening of the fireplace and, in effect, toward the primary burner is also of special importance because of the utilization of the fireplace natural draft and direction of flames to more completely burn the gas, avoid any pockets of gas in front of the gas logs." (Emphasis added) That is, it is the natural draft of the fireplace, in conjunction with the gas discharge ports of the secondary coals burner elongated tube not being directed to the fireplace opening, that brings the gas, and therefore flame, away from the fireplace opening. The undersigned does not know the percentage forward and rearward, but quite evidently the point of the fireplace natural draft has been overlooked or glossed over. Thus, it is the natural draft of the fireplace (a fact that defendant failed to mention) that allows the gas discharge ports of the secondary coals burner elongated tube to be located vertically downward, while minimizing the gas from exiting toward the fireplace opening. Plaintiff's Exhibit 1, which is a modification of defendant's Exhibit 7, schematically illustrates the point herein:

Defendant also failed to take into consideration the significance that the wording of Claim 18 has on the interpretation of the claim term "directed away from the fireplace opening" in Claim 17. Claim 18 recites that the "gas distribution ports of the secondary burner tube are directed toward the primary burner tube at from about 5 degrees to about 75 degrees elevation from the fireplace floor." The doctrine of claim differentiation requires that one must not

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<sup>6</sup> *Marknan v. Westview Instruments*, 52 F.3d 967 (Fed. Cir. 1995).

interpret an independent claim (Claim 17) in such a way that is inconsistent with a claim (Claim 18) which depends from it.<sup>7</sup> The result is that claim differentiation also gives the unspecified angular relationship (“directed away”) in Claim 17 to be broader than the dependent Claim 18. Defendant’s suggested interpretation would render Claim 18 “superfluous,” therefore, it is presumed unreasonable.<sup>8</sup>

#### REQUESTED INTERPRETATION

The phrase the term “directed away from the fireplace opening” should be interpreted to mean that the gas discharge ports of the secondary coals burning elongated tube may be directed from vertically down to any position approaching 179 degrees in the clockwise direction, but may not be located vertically upward.

#### IV. CONCLUSION

For the foregoing reasons and based on the intrinsic evidence relied upon, Plaintiff, Golden Blount, Inc. respectfully requests that the Court adopt the following proposed claim construction:

#### REQUESTED CONSTRUCTION RESTATED

- The term “secondary coals burner elongated tube” should be interpreted to mean a tube that is configured to provide a flame under artificial coals.
- The phrase “a support means for holding the elongated primary burner tube in a raised level relative to the forwardly position secondary coals burner elongated tube” should be interpreted to mean that a support structure holds the upper most portion of the primary burner tube higher than the upper most portion of the secondary coals burner elongated tube, or alternatively that the centerline of the primary burner tube is higher than the centerline of the secondary coals burner elongated tube.

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<sup>7</sup> *Wright Medical Technology, Inc. v. Osteonics Corp.*, 122 F.3d 1440 (Fed. Cir. 1997).

<sup>8</sup> *Athletic Alternatives, Inc. v. Prince Manufacturing, Inc.*, 73 F.3d 1573 (Fed. Cir. 1996).

- The term "positioned under an artificial logs and grate support means" should be interpreted to mean that a set of artificial logs and a grate support are positioned over the open frame pan and the primary burner elongated tube.
- The phrase "below the primary burner tube" should be interpreted similar to the phrase "raised level above."
- The phrase the term "directed away from the fireplace opening" should be interpreted to mean that the gas discharge ports of the secondary coals burning elongated tube may be directed from vertically down, to any position approaching 179 degrees in the clockwise direction, but may not be located vertically upward.

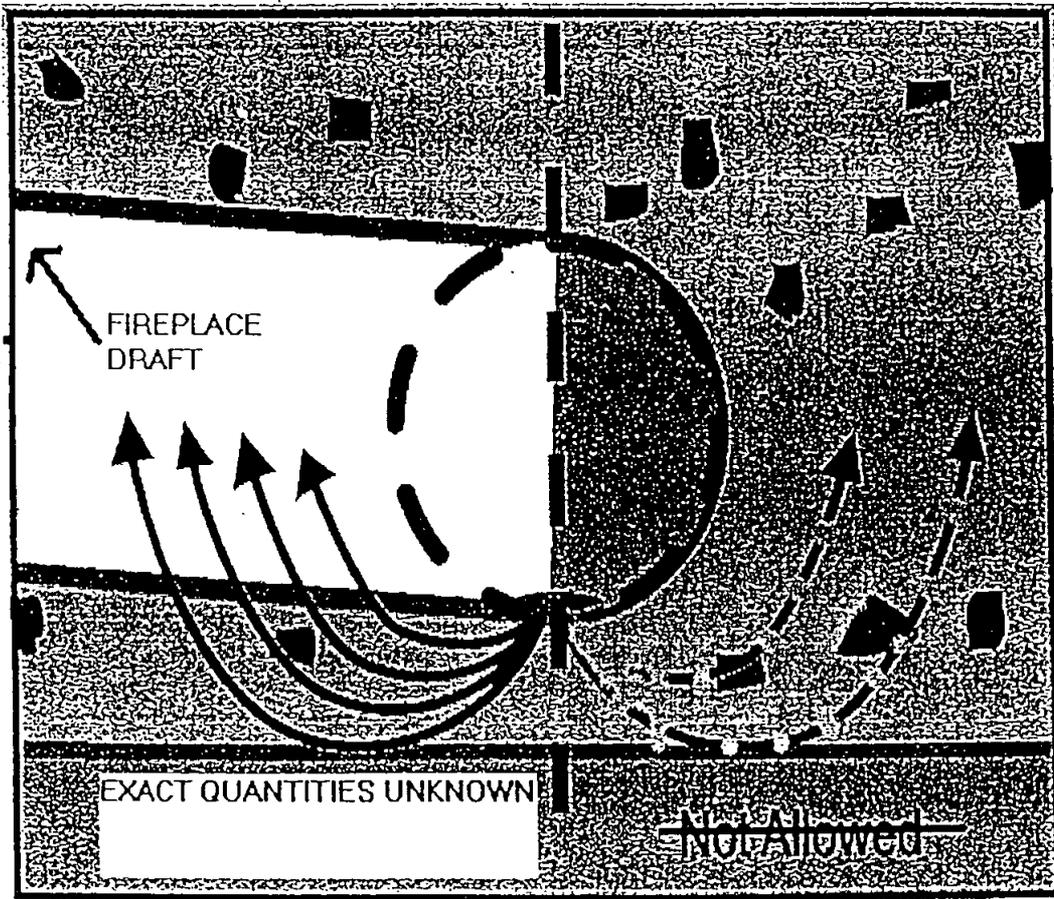
Respectfully submitted,

For Plaintiff Golden Blount, Inc.



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State Bar No. 07570580  
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ATTORNEYS FOR PLAINTIFF

DEFENDANT'S EXHIBIT 7--MODIFIED



PLAINTIFF'S  
EXHIBIT  
1

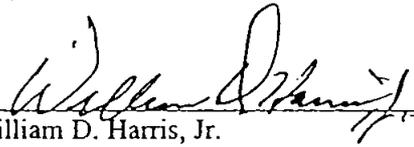
JT-APP 0458

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed PLAINTIFF GOLDEN BLOUNT, INC.'s REPLY TO DEFENDANT ROBERT H. PETERSON'S RESPONSIVE CLAIM CONSTRUCTION BRIEF was served on the following counsel of record on June 3, 2002 by facsimile and first class mail:

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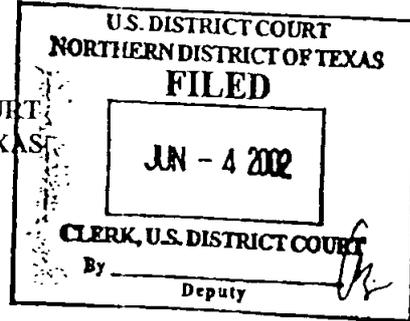
F. William McLaughlin  
Dean A. Monco  
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Clark & Mortimer  
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(by Facsimile and First-class Mail)

  
\_\_\_\_\_  
William D. Harris, Jr.

JT-APP 0459

My ORIGINAL

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
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§  
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§  
§

Civil Action No.

3-01CV0127-R

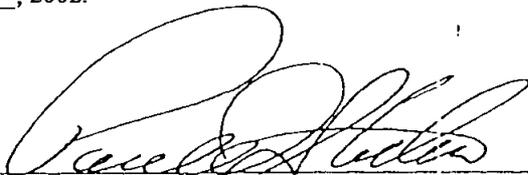


**ORDER DENYING PETERSON CO.'s MOTION  
FOR PROTECTIVE ORDER**

The Court has reviewed the briefing of the parties' counsel relating to Peterson Co.'s Motion For Protective Order to Preclude Testimony of F. William McLaughlin and heard counsel in an appearance on the 31st day of May, 2002. After full consideration of the foregoing, it is found that such Motion should be denied. It is therefore

ORDERED that Peterson's subject motion should be denied in its entirety.

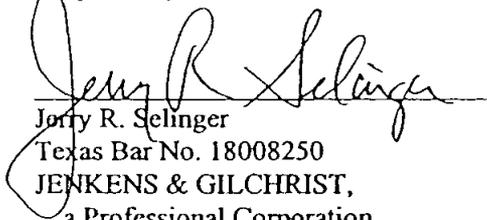
Signed this 4 day of June, 2002.

  
\_\_\_\_\_  
PAUL D. STICKNEY, UNITED STATES MAGISTRATE JUDGE

ORDER DENYING PETERSON CO.'s MOTION FOR PROTECTIVE ORDER

EO

Respectfully submitted,



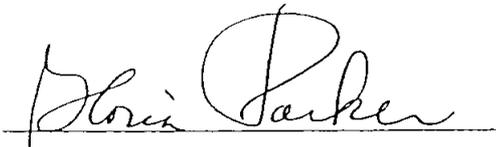
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CERTIFICATE OF SERVICE

This certifies that a copy of the foregoing document was served by first-class mail, postage prepaid, to counsel for Plaintiff, William D. Harris, Jr., Hitt Gaines Boisbrun, P.C., 225 University Plaza, 275 West Campbell Road, Richardson, Texas 75080, this 26<sup>th</sup> day of June, 2002.



RECEIVED

JUN 02 2002

WOOD, PHILLIPS, ET AL

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

U.S. DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
FILED  
JUN 26 2002  
CLERK, U.S. DISTRICT COURT  
By \_\_\_\_\_  
Deputy

GOLDEN BLOUNT, INC., )

Plaintiff, )

v. )

ROBERT H. PETERSON CO., )

Defendant. )

Civil Action No.: 3:01-CV-0127-R

**ROBERT H. PETERSON CO.'S  
35 USC SECTION 282 NOTICE**

Robert H. Peterson Co. hereby gives notice to Golden Blount, Inc. of the country, number, date, name of the patentee of any patent, the title, date and page numbers of any publication to be relied upon as anticipation of the patent in suit or as showing the state of the art, and the name and address of any person who may be relied upon as the prior inventor or as having prior knowledge of or as having previously used or offered for sale the invention of the patent in suit.

**LIST OF PATENTS**

United States Patent No. 3,042,109 issued July 3, 1962, to Peterson;

United States Patent No. 3,871,355 issued March 18, 1975, to Henry;

United States Patent No. 5,033,455 issued July 23, 1991 to Eiklor, et al.; and

United States Patent No. 3,583,845 issued June 8, 1971 to Pulone.

**LIST OF PUBLICATIONS**

Real-Fyre F3 Series Circular Burner (Bates No. 000037), dated 1973;

Installation Instructions Real-Fyre Hearth Logs with Front-Flame Burner (Bates No. 000031), date prior to 1977;

Burner assembly CGA drawing of Robert H. Peterson Co. (Bates No. 000034), dated July 1, 1983;

Burner installation drawing (Bates No. 000100), date about 1975;

Drawing of hook up for circular G4 burners (No. 000029), date prior to 1977; and

Robert H. Peterson Co. brochure "Gas Log Warmth from Peterson Real-Fyre" (Bates Nos. 000038-000049), date prior to 1977.

**PERSONS WHO MAY BE RELIED UPON AS PRIOR  
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IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

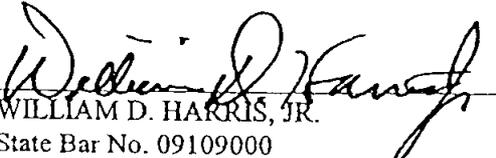
GOLDEN BLOUNT, INC.,	§	
	§	
Plaintiff,	§	
	§	Civil Action No.
v.	§	
	§	3-01CV0127-R
ROBERT H. PETERSON CO.,	§	
	§	
Defendant.	§	

PLAINTIFF, GOLDEN BLOUNT, INC'S  
DESIGNATION OF ADDITIONAL EXHIBITS

In accordance with the provisions of the Court's pre-trial procedure, Plaintiff Golden Blount, Inc. designates herewith additional Trial Exhibits 24 - 26, to be added to Trial Exhibits 1-23 filed with this Court on July -17, 2002. A copy of the additional exhibits is also being served on Defendant Robert H. Peterson Company. For the record, it is noted that these exhibits are the depositions of Leslie Bortz (by 30(b)(6)), in two separate sessions and William McLaughlin. These depositions have previously been designated to use in this lawsuit. Unless directed, these depositions will not be filed at this time nor will the Court be burdened with copies. All of the copies will be available at the trial as needed as will the originals. If the Court or opposing party wants the matter handled otherwise, we solicit an immediate contact. Note that the protective order entered in this case requires special handling.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.

  
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Plaintiff Golden Blount Inc.'s Designation of Additional Exhibits was served on the following counsel of record on July 25, 2002, by facsimile transmission and hand delivery:

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312/876-2020 (Facsimile)

If opposing counsel requires full deposition copies, they will be provided forthwith on notice to Golden Blount, Inc.'s counsel.

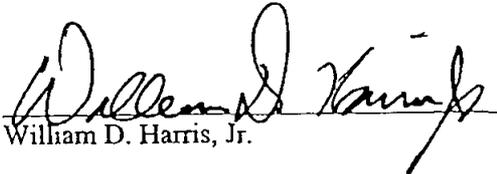
  
William D. Harris, Jr.

EXHIBIT 1

JT-APP 0466



US005988159A

# United States Patent [19] Blount

[11] Patent Number: 5,988,159  
[45] Date of Patent: Nov. 23, 1999

[54] GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY

5,033,455	7/1991	Eiklor et al.	126/512
5,052,370	10/1991	Karabin	126/512
5,081,981	1/1992	Beal	126/92 R
5,263,852	11/1993	Beck	431/125

[76] Inventor: Golden Blount, 5310 Harbor Town, Dallas, Tex. 75287

Primary Examiner—Larry Jones  
Attorney, Agent, or Firm—L. Dan Tucker

[21] Appl. No.: 08/626,498

[22] Filed: Apr. 2, 1996

[57] ABSTRACT

### Related U.S. Application Data

[63] Continuation-in-part of application No. 08/276,894, Jul. 19, 1994, abandoned, which is a continuation-in-part of application No. 08/061,727, May 17, 1993, abandoned.

[51] Int. Cl.<sup>6</sup> F23C 1/18

[52] U.S. Cl. 126/512; 126/500; 126/540; 431/125

[58] Field of Search 431/125; 126/512; 126/500; 524; 540; 503

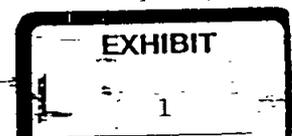
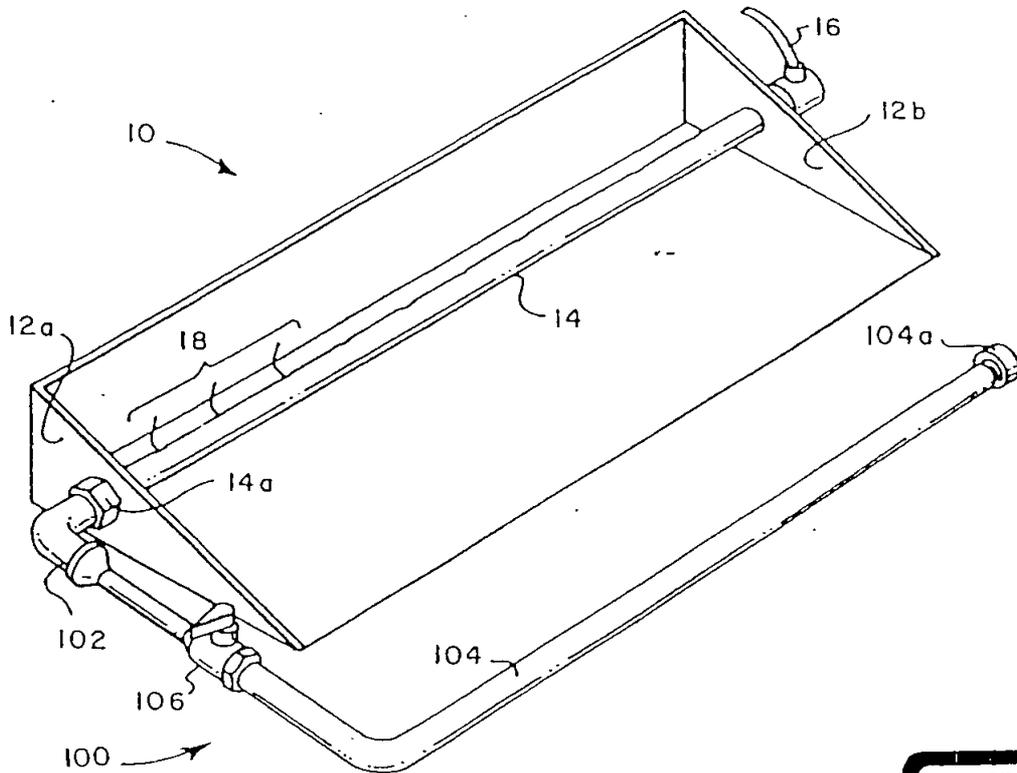
A gas-fired artificial logs and coals-burner assembly is provided for fireplace use in cooperation with decorative gas logs and artificial coals and embers decorative items by placement forward of the gas logs in the fireplace arrangement, a secondary elongated coals- and embers-burner tube apparatus. The assembly provides gas-fired artificial logs, coals- and embers-burner apparatus for fireplaces wherein gas flow through primary burner tube is the source of gas flow to a secondary coals- and embers-burner tube positioned forward and below the primary burner tube with multiple discharge ports in the secondary tube directed away from the front of the fireplace, thus enhancing the natural burn in cooperation of the fireplace draft as well as the aesthetic beauty of the imitation burning logs, coals and embers.

### [56] References Cited

#### U.S. PATENT DOCUMENTS

3,042,109	7/1962	Peterson	126/512
3,871,355	3/1975	Heary	431/125 X
5,000,162	3/1991	Shimck et al.	126/512

19 Claims, 3 Drawing Sheets



JT-APP 0467

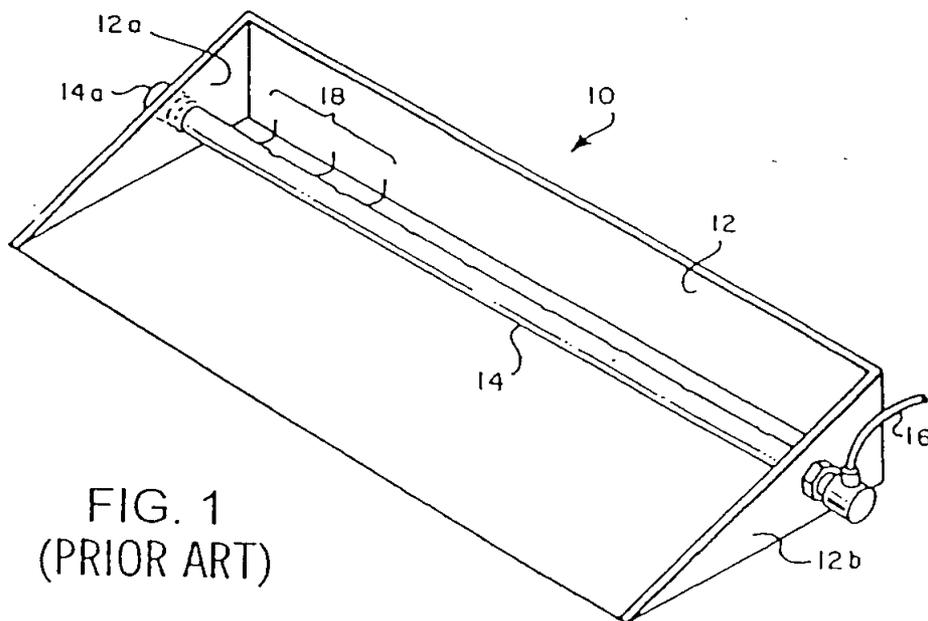


FIG. 1  
(PRIOR ART)

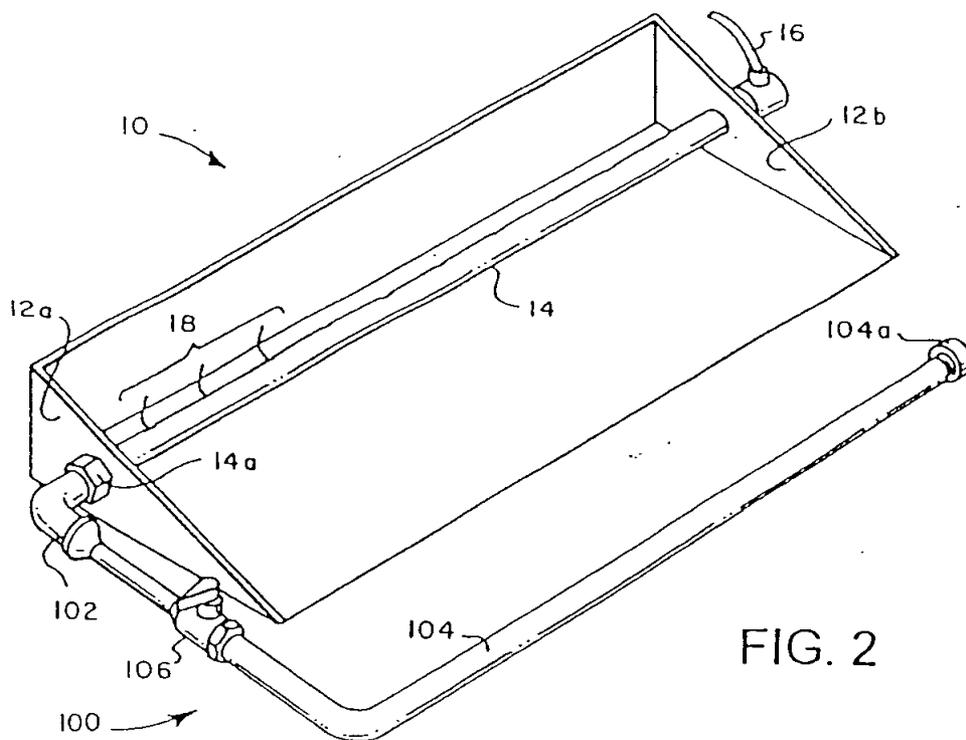


FIG. 2

FIG. 3

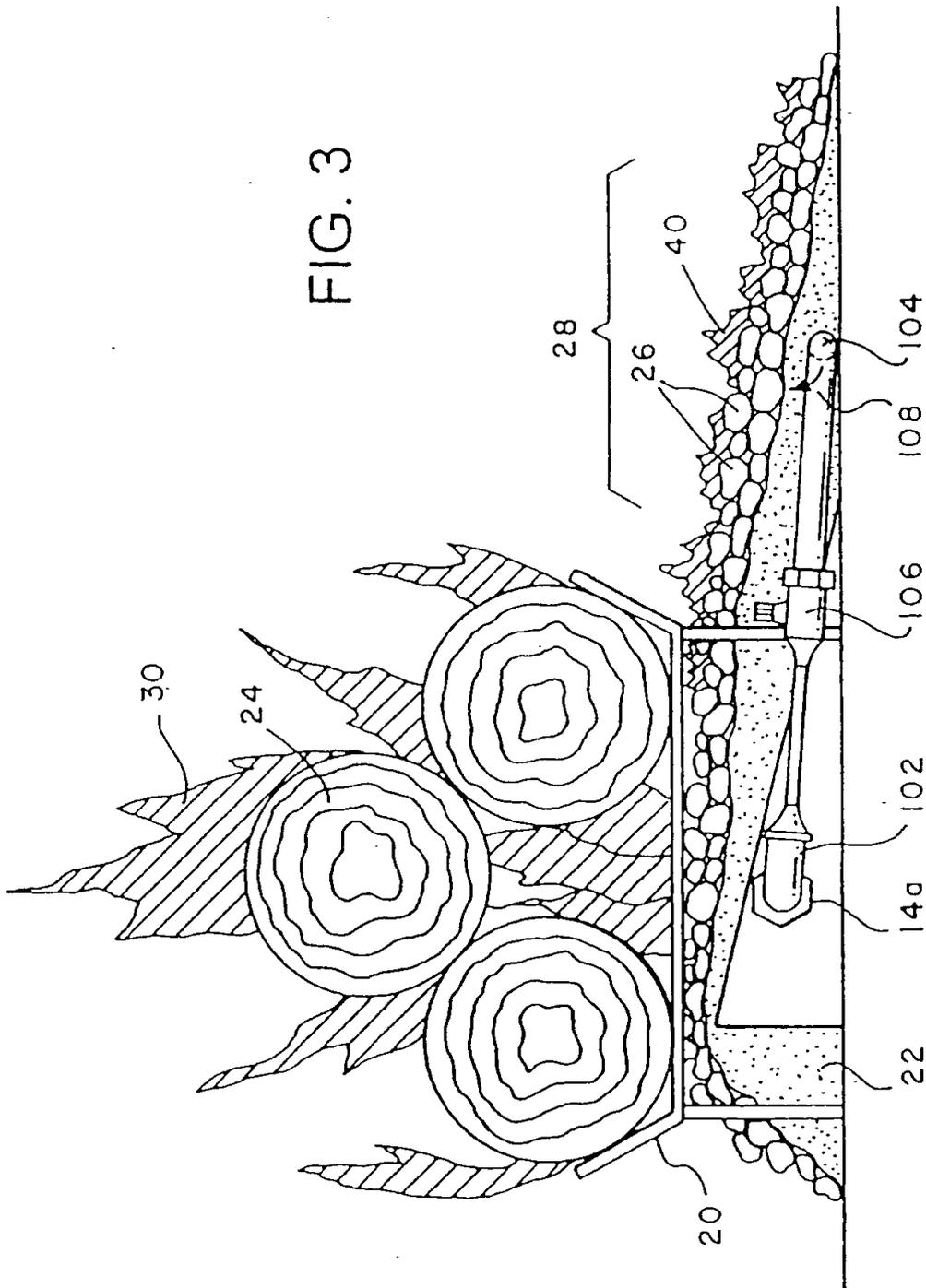
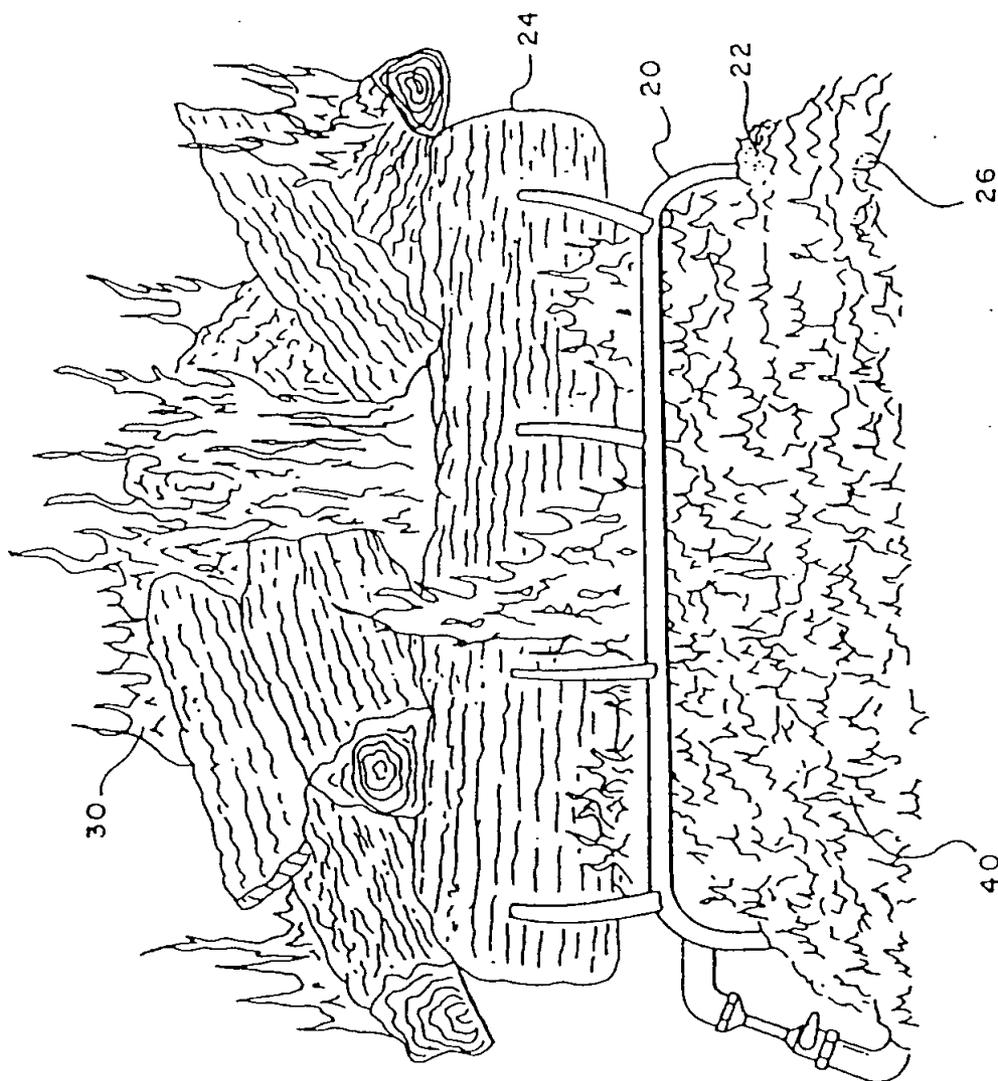


FIG. 4



## GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY

The present application is a continuation-in-part application of U.S. patent application Ser. No. 08/276,894, filed Jul. 19, 1994, now abandoned, entitled "A Supplemental Burner for Retrofitting to an Existing Gas Log Burner Assembly" which is a continuation-in-part application of U.S. patent application Ser. No. 08/061,727, filed May 17, 1993, entitled "Controlled Ember Bed Burner" which is now abandoned.

### TECHNICAL FIELD OF THE INVENTION

The present invention relates to a gas-fired artificial logs and coals-burner assembly for a fireplace to be used with decorative gas logs and coals or embers decorative items placed forward of the gas logs in the fireplace arrangement. In another aspect, the invention relates to coals- and embers-burner apparatus suitable for attaching to a terminal end of a gas-fired primary artificial burner, the coals- and embers-burner assembly utilizing a valve between the primary artificial logs burner and the coals- and embers-burner.

In yet another aspect, the invention relates to a gas-fired artificial logs, coals- and embers-burner assembly for fireplace wherein gas flow through a primary burner tube is the source for gas flow to a secondary coals burner tube positioned forward and below the primary burner tube with the multiple discharge ports in the secondary tube directed away from the front of the fireplace.

The present further relates to efficient gas burners for burning natural gas, manufactured gas and propane gaseous fuels within a fireplace environment. In addition, the invention provides an efficient burner system for burning gaseous fuels in a manner which provides decorative flames and decorative coals and embers which simulate wood burning.

Gas logs are usually made of a fire resistant ceramic material; however, when gas flames are directed against such ceramic materials, the gas flame is cooled by the artificial logs and many times produces a highly inefficient and dirty yellow flame. Such a flame further indicates incomplete burn of the gaseous materials due to a lack of sufficient burn temperature and oxygen supply thus creating excessive soot and carbon monoxide. Various attempts have been made in correcting these decorative fireplace gas log deficiencies.

Further it is known that gas burners or gas nozzles can be buried below a level of sand and vermiculite. These burner systems are referred to as sand pan burners which disburse the gasses through the fireproof material and permit the gas permeating through the porous material to ignite upon entering the atmosphere. Such systems allow disbursement of the flames over a large area or bed of material. Such disbursement of flames creates a more efficient burn which further simulates the action of burning wood, ashes and embers in a fireplace.

Prior art burner systems for artificial decorative logs and sand pan type burners are incorporated in various prefabricated fireplaces or existing masonry fireplaces; however, such systems are required to meet the ANSI emission standards which have been adapted by the American Gas Institute. Accordingly, it is very desirable to provide a clean burning gas-fired artificial logs and coals-burner assembly which meet the present ANSI emission standards.

Gas logs are increasingly popular in homes. Decorative artificial logs are placed on a grate which is located over a gas burner. The burner is typically a tube with spaced

apertures. Sand is poured over the gas burner to hide it from sight. Artificial embers are then spread across the sand. In use, gas flows through the burner and escapes through the spaced apertures. The gas filters up through the sand underneath the artificial logs. The gas is ignited and creates flames between the logs. The height of the flame is controlled by a primary valve which can be manipulated by the user.

Gas logs can, under these conditions, provide a great deal of heat to a room. Also, gas logs require virtually no effort to light. Natural logs, on the other hand, must be properly cured before burning. Even then, kindling is usually needed. And once lit, it is difficult to control the rate of burning. Beyond convenience, gas logs are also aesthetically pleasing. However, the standard gas logs burner only creates flames around the artificial logs. Natural logs, when burned will break apart to produce beautiful burning embers in front of the main log stack. A need exists to produce a more realistic aesthetic burn with gas logs.

Due to the popularity of gas logs, a number of advances have been patented. For example, U.S. Pat. No. 5,000,162 to Shimek et al. discloses a "Clean Burning Glowing Ember and Gas Log Burner System." This unit is marketed under the trademark Heat-N-Glow as the Model 5000GDVMH as a self-contained fireplace and wall heater for mobile homes. The system is a low-BTU system whose main objective is to minimize carbon monoxide creation and soot deposit on the logs. A burner system is provided with a first branch and a second branch. The first branch is supported on a prefabricated grate between a first and second decorative log. The second branch is forward of the logs and is protected under a metal mesh. A very light layer of special ember material is spread on top of the mesh. Shimek et al. '162 is only sold as a complete system of logs, burner and special ember material. It cannot be fitted to existing pan burners which are by far the most common burner in use, the combination resulting in the assembly of the invention. Thus, the Shimek burner system is an expensive option.

The Shimek burner system provides a metal trim piece or refractory material in front of the second burner pipe branch so that it is not easily viewed by a person standing in front of the fireplace. The second branch only illuminates a thin line of ember material. Neither the first or second branch can be covered by sand as is common in other units. The gas apertures in the branches are located on the upper surface of both branches. Thus, sand could easily clog the apertures. Moreover, the flow of gas into the second branch cannot be regulated.

U.S. Pat. No. 5,052,370 to Karabin discloses a "Gas Burner Assembly Including Emberizing Material." The gas burner comprises a first and second gas-burner assembly. The first gas-burner assembly is formed by a pair of parallel burner tubes connected by a third burner tube. The second gas-burner assembly is located forward of the first assembly and is generally T-shaped. The second burner only illuminates a thin line of ember material. A single gas source supplies both burner assemblies. An igniter is provided to ignite the gas from the main burner assembly. The flame from that burning gas ignites the gas from the second burner assembly. As with the Shimek et al. burner assembly, the flow of gas to the second burner assembly cannot be controlled.

Finally, U.S. Pat. No. 5,081,981 to Beal discloses yet another burner and is entitled "Yellow Flame Gas Fireplace Burner Assembly." The Beal reference is primarily concerned with producing a clean yellow flame. The burner assembly includes a U-shaped burner tube. The front portion

of the burner tube is forward of the artificial logs and provides flame and ember material. However, as with the Shimek reference above, the forward portion of the burner tube is hidden from view by a portion of the grate. The Beal system does not contemplate the present assembly. Furthermore, as with both the Shimek and Karabin references, there is no means provided to control separately the flow of gas into the front burner tube.

A need exists for an inexpensive assembly for improving the performance and aesthetic appeal of pan-type gas burners. The assembly should distribute gas under artificial coals or embers in front of the gas-fired logs. The assembly should also provide a method of controlling the flow of gas to a secondary burner, thus controlling the height of the coals and embers bed flames and the amount of heat radiated into a room. A need further exists for an assembly which can safely operate even if completely covered by sand and enhances gas burn of both primary log burner and secondary coals and embers burner by gas flow control and burn direction.

These present and long-felt needs for gas logs and glowing coals- and embers-burner systems will burn clean and closely simulate the natural flames produced by burning wood logs have not yet been met by the art. Therefore, it is desirable to produce a reliable and efficient gas logs and glowing coals- and embers-burner assembly which produces the desired efficiency of burn while providing decorative flames that closely simulate burning wood logs while at the same time providing useable heat and still meet EPA regulations and the ANSI emissions and safety standards.

#### SUMMARY OF THE INVENTION

It is a primary object of the present invention to provide a highly efficient gas-burner assembly for use with artificial, decorative logs and glowing coals and embers wherein the assembly provides control for the glowing coals and embers independently of the gas logs burn.

It is another primary object of the present invention to provide a novel burner assembly which closely simulates the flames, embers and coals of natural wood logs burn.

It is another principle object of the present invention to provide a novel burner assembly which has low carbon monoxide emission characteristics.

It is yet another object of the present invention to provide an efficient low carbon monoxide emission burner assembly that combines long decorative gas flames with short or low smoldering glowing embers and coals in the same assembly.

It is another object of the present invention to provide a gas flow communicating primary and secondary burner tubes with the gas distribution ports of the secondary burner tube directed away from the opening of the fireplace and utilizing the natural draft of the fireplace to enhance the overall efficiency of the burn of the two burners.

The present burner assembly is the combination of an inexpensive primary gas logs burner assembly in gas flow communication with a secondary coals- and embers-burner tube positioned forward and below the primary burner which operates to enhance the natural draft of the fireplace to improve efficiency of burn and aesthetic appeal of the gas-fired artificial logs, coals- and embers-burner assembly. The secondary burner can distribute gas under artificial coals and embers in front of the gas logs with control of the gas flow to the secondary burner being readily adjustable by a valve in the connection means between the primary and secondary burners. The secondary burner receives gas through the primary burner, the connection means, and the gas flow is regulated selectively by the valve which is

interposed between the primary and secondary burners in the connection means. The control of gas flow thus controls the height of the coals and embers bed flames and the amount of radiant heat which is produced in the front of the fireplace and is distributed into the room. The amount of radiant heat can be enhanced by utilizing the control valve for increasing the amount of gas being burned in the secondary burner or the utilization of even a tertiary burner along with the secondary burner which are provided forward of the gas logs arrangement in the fireplace. The secondary burner can operate efficiently when completely covered with sand and artificial coals and embers materials, there being no need for a new grate to hide the secondary burner.

The ability to regulate the flow of gas to the secondary burner is an especially important feature. In addition, the gas flow from the secondary burner away from the opening of the fireplace and, in effect, toward the primary burner is also of special importance because of the utilization of the fireplace natural draft and direction of flames to more completely burn the gas, avoid any pockets of gas in front of the gas logs. The direction of the gas dispersion from the secondary burner ensures that through the action of the natural draft of the fireplace and the burning logs from the primary burner that complete and total combustion in an efficient manner will be achieved of the gas flowing from the secondary burner which is positioned somewhat forward of the primary burner.

People buy gas logs primarily for convenience, but this does not mean that they want to give up on the beauty of burning real logs. Standard pan burners only provide part of that beauty. Having roaring flames throughout the logs is greatly complemented by lower flames in front of the gas logs throughout a coals and embers bed. None of the prior art references above feature or even suggest a variable control means for accomplishing lower flames in the coals and embers bed. Moreover, every fireplace drafts differently. Such differences in fireplace construction and drafting, i.e., fireplace draft, as well as sizing and manufacture of present artificial fireplace burner apparatus dictates that variable control of the secondary burner, the coals and embers burner which operates independently of the primary logs burner is necessary. Volume and velocity of air entering the firebox varies according to the size of the room, height of the ceilings, and size of the firebox. None of the prior art references compensate for the varying drafts of fireplaces and therefore fail to accommodate all fireplaces while attempting to provide the maximum aesthetic beauty desired and efficiency of burn.

Most importantly, the gas-fired artificial logs, coals- and embers-burner assembly through the secondary burner control afforded by the valve, allows the user to selectively increase the amount of gas being burned forward of the artificial logs. This control also affords a greater introduction of radiant heat to the room as desired on colder days. As previously discussed, artificial gas logs can act as a heat sink and absorb heat produced by the flames. The heat generated by the secondary burner is largely radiant and is projected into the room, which affords quick heating of the room while also providing the aesthetic beauties of a gas-fired artificial logs, coals- and embers-burner assembly operation.

#### BRIEF DESCRIPTION OF THE DRAWINGS

For a more complete understanding of the present invention, and for further details and advantages thereof, reference is now made to the following Detailed Description taken in conjunction with the accompanying drawings, in which:

FIG. 1 provides a perspective view of a prior art pan burner used with artificial gas logs;

FIG. 2 provides a gas-fired artificial logs primary pan tube burner and secondary coals and embers tube burner;

FIG. 3 illustrates the effect of the present assembly in providing logs, coals and embers flames; and

FIG. 4 is a front view of the assembly illuminating the coals and embers bed and gas logs flames.

#### DETAILED DESCRIPTION OF THE DRAWINGS

The present assembly provides a number of advantages over the burner assemblies disclosed in the prior art. FIG. 1 illustrates a standard pan burner 10 which is used in the vast majority of artificial log sets. The pan burner 10 has an open frame 12 which supports a burner tube 14. An inlet 16 is connected to a gas source (not shown). A plurality of apertures, as evidenced by gas plumes 18, are spaced along the length of the burner tube 14. Gas escapes through the apertures and filters through sand (not shown). Gas which escapes from the sand is initially ignited to create flames. These flames are continually fed by the escaping gas. The burner tube 14 is supported by the side walls 12a, 12b of the frame 12. The burner tube 14 extends beyond the side wall 12a and is capped.

FIG. 2 illustrates a secondary burner apparatus 100 which embodies the present invention in combination with primary burner tube 14. The secondary burner apparatus 100 can be retrofitted to the terminal end 14a of the burner tube 14 in the pan burner 10. The cap must be removed from the terminal end 14a. A connector 102 is then attached to the uncapped end of burner tube 14. The connector 102 is fitted to the secondary burner tube 104 creating an enclosed fluid path for the gas. The connections between the connector 102 and the terminal end 14a should be adequately sealed to prevent leakage. Likewise, the connection between the connector 102 and the secondary burner tube 104 should also be properly sealed. A valve 106 is interposed in this fluid path. The valve 106 can be variably positioned to give the user the ability select the amount of gas entering the secondary burner. The secondary burner tube 104 is generally parallel to the primary burner tube 14. The terminal portion of the secondary burner tube 104a is closed. The primary and secondary burner tubes are typically made of steel.

A plurality of apertures 108 are along the length of the secondary burner tube 104. The apertures 108 can be evenly spaced or clustered. The apertures 108 are typically between  $\frac{1}{32}$  and  $\frac{1}{16}$  inch in diameter, but are preferably  $\frac{1}{16}$  of an inch in diameter. More importantly, the apertures are located along the radial edge of the secondary burner tube 104, below the upper ridge of the tube. By avoiding the upper ridge, the apertures are less likely to be clogged by sand. Gas passing through the valve 106 enters the secondary burner tube 104 and escapes through the spaced apertures. The apertures can be evenly spaced or clustered.

These various spaced apertures or gas discharge ports are most important in their position in regard to both the primary and secondary tube burners. In the secondary burner tube 104, the gas is discharged in a direction away from the opening of the fireplace or in another aspect is directed somewhat toward or directly toward the primary burner tube 14. The effects of such gas burn direction enhances the aesthetic beauty of the overall logs, coals, and embers burn, but, more importantly, provide several safety features of the gas-fired artificial logs, coals- and embers-burner assembly. First, the natural draft of the fireplace provides a more efficient burn of the gas and avoids high or intolerable levels

of carbon monoxide. Even more importantly is that the backward direction of gas flow direction toward the primary burner from the secondary burner avoids creation of pockets of gas in the sand and other coverage material of these burners which could possibly create a flash explosion due to accumulated gas. For example, if the gas is directed from the secondary burner 104 toward the opening of the fireplace, then two independent sources of gas pocketing occurs—one on the gas logs primary burner which may or may not be covered by granular materials as well as that generated by the secondary burner which is removed from about four to eight or ten inches in front of the primary burner. Lighting of such gas distribution pockets would be hazardous and uniformity of coordinated burn utilizing natural draft of the fireplace would be lost. If the secondary burner 104 discharges gas in a vertical direction, apertures in the sand or coverage granular material will occur and one would lose the aesthetic beauty of the applications of distribution of gas for burning and creating flame coals' and embers' appearance.

In the gas-fired artificial logs, coals- and embers-burner assembly of the invention, the primary elongated burner tube can be comprised of a one-half inch pipe while the secondary coals- and embers-burner elongated tube can be of a one-quarter inch pipe. These dimensional relationships can be varied depending on the needs for gas volume and the size of the fireplace. The spacing between the primary and secondary burner tubes can also be varied within reasonable lengths of from about four to eight or ten inches depending on the size and depth of the coals and embers bed one requires. The secondary elongated burner tube can also have adjustments for height, meaning distance elevated from the floor of the fireplace, again depending on the depth and size of the coals and embers fire bed. In all of these dimensional relationships, the present invention provides an adjustable burn facility for the secondary elongated burner tube which controls the amount of coals and embers flame and glow, again depending on the individual's desires, size of the room, size of the fireplace and the amount of natural draft through the fireplace.

FIGS. 3 and 4 illustrate the effect of the secondary burner apparatus 100 once connected to the pan burner 10. As discussed, a grate 20 is located above the pan burner which is covered with sand 22. The grate 20 can hold at least one artificial log 24. Artificial ember material 26 which glows when heated can be strewn under and around the artificial logs and on top of the sand. Flames 30 fed by gas from the primary burner tube 14 rise through the artificial logs 24. Flames 40 fed by gas from the secondary burner tube 104 can rise through the artificial ember bed 28. As illustrated, the flames 40 can be lower than the flames 30, thus providing an aesthetically pleasing sight.

Although preferred embodiments of the invention have been described in the foregoing Detailed Description and illustrated in the accompanying drawings, it will be understood that the invention is not limited to the embodiments disclosed, but is capable of numerous rearrangements, modifications, and substitutions of parts and elements without departing from the spirit of the invention. Accordingly, the present invention is intended to encompass such rearrangements, modifications, and substitutions of parts and elements as fall within the scope of the invention.

What is claimed is:

1. A gas-fired artificial logs and coals-burner assembly for fireplace comprising:
  - a) an elongated primary burner tube including a plurality of gas discharge ports;

- a secondary coals burner elongated tube positioned forwardly of the primary burner tube;
- a support means for holding the elongated primary burner tube in a raised level relative to the forwardly positioned secondary coals burner elongated tube;
- the secondary coals burner elongated tube including a plurality of gas discharge ports;
- the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means;
- a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and
- the primary burner tube being in communication with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube.
2. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the support means for the primary burner tube is comprised of an open frame pan for supporting the primary burner tube in an elevated position relative to the fireplace floor.
3. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube discharge ports are directed toward the primary burner elongated tube at an angle of from about 5 to about 75 degrees based on the plane of the fireplace floor.
4. The gas-fired artificial logs and coals-burner assembly according to claim 3 wherein the secondary coals burner elongated tube discharge ports directed toward the primary burner tube utilizes the fireplace natural draft in achieving combustion of both gas sources in sufficient air to maintain satisfactory levels of CO.
5. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is substantially parallel to the primary burner tube and has a smaller inside diameter than the primary burner tube with the valve adjusting gas flow for coals burn and forwarding heat radiation from the fireplace.
6. The gas-fired artificial logs and coals-burner assembly according to claim 4 wherein the primary burner tube is comprised of a standard half-inch pipe and the secondary burner tube is comprised of a standard quarter-inch pipe.
7. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the elongated primary burner tube and the secondary coals burner elongated tube are spaced apart on different planes at from about four to about eight inches.
8. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is of a smaller diameter than the primary burner tube which allows for a lower profile of coals and sand coverage.
9. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the secondary coals burner elongated tube is adjustable in height relative to the floor of the fireplace and the elevated primary burner tube.
10. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein at least two secondary coal burner elongated tubes are utilized for artificial coal burn and radiant heat generation.
11. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary and secondary burner tubes have apertures of from about  $\frac{1}{32}$  inch to about  $\frac{1}{4}$  inch.

12. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the gas flow adjustment valve has a removable handle, the gas flow adjustment allowing a variety of settings from full closed to full open.

13. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the connection means is comprised of a connector attached to the terminal end of the primary burner tube at a first end of a connector and attached to the secondary coals burner elongated tube to a connector second end with the valve interposed between the primary burner tube and the secondary burner tube.

14. The gas-fired artificial logs and coals-burner assembly according to claim 13 wherein the connector generally is shaped outward from the first end connected to the primary burner tube, directed generally perpendicular to the burner tubes alignment and inward to the second end connected to the secondary burner tube, the valve and connector being positioned generally exterior of the primary and secondary burner tube fire zones.

15. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the open frame pan and primary elongated burner tube is positioned under an artificial logs and grate support means.

16. The gas-fired artificial logs and coals-burner assembly according to claim 1 wherein the primary elongated burner tube is covered with sand and the secondary elongated burner tube is covered with sand, mica, and fibrous materials which simulate coals and ember burn.

17. A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:

- a secondary coals burning elongated tube;
- a connector means for connecting said terminal end in communication with the secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube being in gas flow communication with the primary burner tube being the connection means, a gas distribution ports of the secondary burner tube directed away from the fireplace opening.

18. The gas-fired artificial coals- and embers-burner apparatus according to claim 1, wherein the gas distribution ports of the secondary burner tube are directed toward the primary burner tube at from about 5 degrees to about 75 degrees elevation from the fireplace floor.

19. A gas burner assembly for use in a fireplace comprising:

- a primary burner tube having a first end and a second end, said first end adapted to be connected to a gas source with a gas flow control means for controlling the amount of gas flowing into said primary burner tube;
- a second burner tube;
- a connector tube attached to said second end of said primary burner tube and to said second burner tube to provide fluid communication between said primary burner tube and said second burner tube; and
- a valve disposed in said connector tube for selectively controlling the flow of gas from said primary burner tube into said second burner tube.

EXHIBIT 2

JT-APP-0475



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY-DOCKET NO.
08/278,894	07/19/94	BLOUNT	G

JONES, J. EXAMINER

3406/0430

DAVID W. CARSTENS  
HARRIS, TUCKER & HARDIN  
13095 NOEL ROAD, STE. 3100  
DALLAS, TX 75240-6604

ART UNIT	PAPER NUMBER
3406	10

Below is a communication from the EXAMINER in charge of this application  
COMMISSIONER OF PATENTS AND TRADEMARKS

DATE MAILED: 04/30/96

ADVISORY ACTION

THE PERIOD FOR RESPONSE:

- is extended to run \_\_\_\_\_ from the date of the Final Rejection
- continues to run \_\_\_\_\_ from the date of the Final Rejection.

It expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the Final Rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

Appellant's Brief is due in accordance with 37 CFR 1.192(a)

Applicant's response to the final rejection, filed January 29, 1996, has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1.  The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because
  - a.  There is no convincing showing under 37 CFR 1.118(b) why the proposed amendment is necessary and was not earlier presented.
  - b.  They raise new issues that would require further consideration and/or search. (See Note)
  - c.  They raise the issue of new matter. (See Note)
  - d.  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal
  - e.  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: The proposed amendment raises a new issue, the patentability of the supplemental burner, valve and connector combination absent the primary burner and the consideration of commercial success as evidenced by the declaration of Mr. Blount.

2.  Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment canceling the non-allowable claims.

3.  Upon the filing of an appeal, the proposed amendment  will be  will not be, entered and the status of the claims in this application would be as follows:

Allowed claims: NONE

Claims objected to: NONE

Claims rejected: 1-18

However:

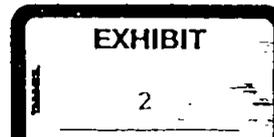
- a.  The rejection of claims \_\_\_\_\_ on references is deemed to be overcome by applicant's response.
- b.  The rejection of claims \_\_\_\_\_ on non-reference grounds only is deemed to be overcome by applicant's response

4.  The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.

5.  The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

The proposed drawing correction  has  has not been approved by the examiner.

Other



000201

JT-APP 0476

**THIS OFFICE ACTION IS RESPONSIVE TO APPLICANT'S  
AMENDMENT, FILED January 29, 1996**

Receipt is acknowledged of the amendment after final and the declaration filed January 29, 1996

REMARKS

Applicant's arguments filed January 29, 1996 have been fully considered but they are not deemed to be persuasive.

The declaration points out the commercial success of what is identified as the claimed invention. The commercial success is noted.

*The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed. 2nd 545 (1966), 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103 are summarized as follows:*

1. *Determining the scope and contents of the prior art;*
2. *Ascertaining the differences between the prior art and the claims at issue; and*
3. *Resolving the level of ordinary skill in the pertinent art.*

Secondary factors such as commercial success are measured in light of the differences between the prior art and the claims at issue. Although applicant proposes to limit the claims to the supplemental burner tube, the connector and valve attached thereto this only serves to open the proposed claims to a different rejection. The essence of the invention is still embodied in the idea of a supplemental burner tube which connects to the remainder of the burner system by way of a connector and which includes a valve to control the flow of gas to the supplemental burner tube. The prior art patent to Eiklor et al shows all of this except a

distinct connector and valve. The additionally applied references to Henry and Peterson teach the combination of a connector and a supplemental burner tube as well as the use of a control valve to control the flow of gas to a burner tube. The use of control valves in combination with gas burner tubes is so well known as to not even require a reference to prove its existence.

This combination of references when compared to the claims at issue leave very little to differ over. Thus the secondary considerations when considered in the light of this difference carries much less weight in affecting a decision of patentability.

Thus the rejection of the claims as presented in the Final Rejection stands. The proposed claims will not be entered as they do not place the application in condition for allowance and they do not place the application in better condition for appeal. The proposed claims raise a new issues (the patentability of the supplemental burner, valve and connector combination absent the primary burner and the consideration of commercial success as evidenced by the declaration of Mr. Blount)

The extended period for response including the additional 3 month extension expired April 2, 1996

#### GUIDE TO COMMUNICATING WITH THE PTO REGARDING THIS APPLICATION

Inquiries regarding this or earlier communications from the Examiner should be directed to me, Larry Jones at telephone number (703) 308-1933. My normal working hours are 9:30 a.m. to 6:00 p.m. (ET), Monday through Friday.

An inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 308-0861. The Receptionist is available 8:30 a.m. to 5:00 p.m. (ET), daily.

UNITED STATES UTILITY PATENT APPLICATION SERIAL NO. 08/276,894  
PART III: DETAILED ACTION

Pg. 4

Fax transmissions may be made to the Art Unit 3406 fax number (703) 308-7764. Any transmitted document should clearly identify the application (by serial number) and the Examiner ( Larry Jones) to whom the document is directed. The fax reception facility is available 24 hours a day.

April 25, 1996



LARRY JONES  
PRIMARY EXAMINER  
ART UNIT 3406

EXHIBIT 3

JT-APP 0480

GLDT B8095CIP2  
09842/60434

# 8/c



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor Application of: Golden Blount  
Serial No: 08/626,498  
Filed: 04/02/96  
For: GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY  
Group Art Unit: 3406  
Examiner: Larry Jones

Assistant Commissioner  
for Patents  
Washington, DC 20231

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on

July 10, 1998  
Sharon L. Underwood  
(Date of Deposit)

Sir:

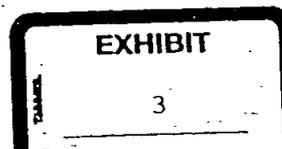
AMENDMENT

In response to the Official Action mailed April 3, 1997, please amend the above identified application as follows:

In the Specification

Page 1, line 1, delete "copending"; and

Page 1, line 2, after "08/276,894" insert -- , now abandoned --.



000309

JT-APP 0481

In the Claims

Please amend Claims 1 and 17 as follows:

1. (Amended) A gas-fired artificial logs and coals-burner assembly for fireplace comprising:

an elongated primary burner tube including a plurality of gas discharge ports;

a support means for holding the elongated primary burner tube in a raised level relative to a forwardly positioned secondary coals burner elongated tube;

the secondary coals burner elongated tube including a plurality of gas discharge ports [directed away from the fireplace opening];

the elongated primary burner tube and the secondary coals burner elongated tube communicating through tubular connection means wherein the gas flow to the secondary elongated coals burner tube is fed through the primary burner tube and the tubular connection means;

a valve for adjusting gas flow to the secondary coals burner elongated tube positioned in the tubular gas connection means; and

the [assembly] primary burner tube being in communication with a gas source [through] with a gas flow control means therein for controlling gas flow into said primary burner tube.

17. (Amended) A gas-fired artificial coals- and embers-burner apparatus suitable for attaching to [a terminal end of] a gas-fired primary artificial log burner tube said primary artificial log burner tube having a terminal end comprising:

a connector means for connecting [the primary burner] said terminal end in communication with <sup>the</sup> a secondary burner tube, the secondary burner tube positioned substantially parallel, forward and below the primary burner tube, the connector means having interposed between the primary and secondary burner tubes a gas flow adjustment valve, the primary and secondary burner tubes having a plurality of gas discharge ports, the secondary burner tube <sup>being</sup> in gas flow communication with the primary burner tube <sup>being</sup> the connection means, <sup>the</sup> gas distribution ports of the secondary burner tube directed away from the fireplace opening.

Please add new Claim 19:

19. A gas burner assembly for use in a fireplace comprising:

a primary burner tube having a first end and a second end, said first end adapted to be connected to a gas source with a gas flow control means for controlling the amount of gas flowing into said primary burner tube;

a second burner tube;

a connector tube attached to said second end of said primary burner tube and to said second burner tube to provide fluid communication between said primary burner tube and said second burner tube; and

a valve disposed in said connector tube for selectively controlling the flow of gas from said primary burner tube into said second burner tube.

000311

JT-APP 0483

REMARKS

This application has been revived pursuant to 37 CFR §1.137(b).

Applicant acknowledges the application was filed with informal drawings. Formal drawings will be forwarded to the Patent and Trademark Office upon a notice of allowance of the claims.

The specification has been amended to show the current status of the parent application.

Claim 1 has been amended to place it in better form for claiming the invention.

Claim 17 has been amended to place it in better form and to supply the proper antecedent basis for the primary artificial log burner terminal end.

Claims 1-17 stand rejected as being unpatentable over Eiklor, et al in view of Peterson and Henry. Applicant must respectfully traverse this rejection and request reconsideration.

The Eiklor, et al reference provides for an upper and lower burner tube that are in fluid communication with each other. However, Eiklor does not in any way suggest a valve for adjusting gas flow to the secondary or lower tube. As specifically claimed in all of the rejected claims, the claimed device requires a valve for adjusting gas flow to the secondary burner. This valve is disposed in the connection portion of the claimed device that connects the primary burner tube to the secondary burner tube. Thus, the valve for adjusting the gas flow to the secondary burner tube is between the primary and the secondary burner tube in the claimed invention.

000312

JT-APP 0484

It should also be noted that the claimed invention provides for the primary burner tube being in connection with a gas source with a gas flow control means therein for controlling gas flow into said primary burner tube. Thus, as now claimed in amended Claims 1-17, the assembly includes a flow control means for controlling gas flow into the primary burner tube with an additional valve for adjusting gas flow to the secondary burner tube. It is submitted that this assembly is in no way disclosed or suggested by Eiklor, et al.

Eiklor, et al have been combined with Peterson and Henry to reject the claims as originally presented. Peterson does provide for a valve for controlling gas flow into a single burner tube. This valve is between the gas source and the single burner tube. Henry does disclose a primary and secondary tube that are joined together with a connector. However, this combination of references in no way suggests the incorporation of an additional valve between the primary and the secondary burner tubes. The only suggestion for the incorporation of the second valve necessarily comes from Applicant's own disclosure. Clearly, by making the combination of references as set forth in the Official Action and concluding the claimed invention is obvious is classic hindsight. Even if all of the references are combined as suggested by the Examiner, there is still no valve disposed between the primary and secondary burner to control gas flow into the secondary burner.

As set forth in the specification, the incorporation of the valve between the primary and the secondary burner gives the user the ability to selectively adjust the amount of gas entering the secondary burner. Applicant has pointed out in the specification that all fireplaces are different and that the volume and velocity of air entering a firebox varies

according to the size of the room, height of the ceilings, and size of the firebox. With these variables, the claimed invention provides for an apparatus to carefully adjust the amount of gas being passed to the secondary burner once the primary burner is properly adjusted. These advantages are important for fine-tuning combustion efficiency as well as providing the desired aesthetic effects of the gas fired artificial log and coal elements of the fireplace.

Newly presented Claim 19 claims only the burner elements with the intermediate control valve between the primary and the secondary burner tubes. As set forth above, such an assembly is in no way suggested by the cited references.

In view of the foregoing, it is respectfully urged that all claims be allowed.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 12-1781.

Respectfully submitted,



L. Dan Tucker  
Registration No. 22,670

Date: July 9, 1998

LOCKE PURNELL RAIN HARRELL  
2200 Ross Avenue, Suite 2200  
Dallas, Texas 75201-6776  
214-740-8000

000317

JT-APP 0486

EXHIBIT 4

JF-APP 0487

BB

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

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Civil Action No.

3-01CV0127-R

PLAINTIFF'S FINDINGS OF FACT AND CONCLUSIONS OF LAW

The proposed findings of fact and conclusions of law are submitted to comply with Paragraph 2.d. of the Amended Scheduling Order of February 27, 2002.

A. FINDINGS OF FACT

1. The Plaintiff Golden Blount, Inc. is the owner of U.S. Patent 5,988,159, assigned it by Mr. Golden Blount, the named inventor for the patent (hereinafter "the patent," "the patent in suit," or the "Blount patent"). The Plaintiff has sued Peterson Co. (Defendant).
2. The field of the invention is fireplace burners and associated equipment.
3. The Defendant contends that the patent is invalid under 35 U.S.C. 102 and 35 U.S.C. 103. The Defendant also contends that it does not infringe.
4. At the time the patent issued, the Plaintiff's commercial structure under the patent had been marketed for approximately six years, i.e., from about the time Plaintiff originally filed its patent application. Its sales grew significantly and it is a commercial success.
5. Defendant is unable to establish when it commenced design of its accused structure, but it was long after the Plaintiff placed its device on the market. There is a lack of explanation of why the first marketed accused structures were not fabricated and

EXHIBIT  
4

placed on the market till after Plaintiff's device had established a market. Also there is no showing that the Defendant's device went through any significant design or development. The Defendant's structure is very similar to Plaintiff's. The foregoing gives inference of copying.

6. There had been a need for a burner device to give the appearance of the burning of natural logs by creating an area of subdued flames out front of the artificial logs, and to create the appearance of fiery hot embers out front, as would be present with the burning of real logs. The need for such a burner device to enhance the artificial fireplace's operation had existed for long before the invention occurred. The patented device met the aforementioned need.
7. The prior art relied on by the Defendant does not show the same concepts that the Plaintiff's claims include, and proof of the actual existence and/or sales of the prior art relied upon is lacking, as will be noted just below.
8. A recent sketch, made long after the patent was filed, was made to illustrate that which Defendant is trying to establish was prior art in the eighties. Defendant says it went off the market long ago. The sketch was made long after the fact, to illustrate a device allegedly made public or sold by a third party in the eighties. The recent sketch was made with the inputs and assistance of the Defendant's personnel.
9. The alleged prior art, shown in the sketch, was not sufficiently proved to consider it as meeting the standard of being shown "by clear and convincing evidence." Even if it did, it was for quite a different purpose than the patented device, and further, the end use has not been shown.
10. Turning to the evidence of burner configurations of Production No. 33 and Production No. 34, again their existence, their use, and their actual sale or marketing is vague. The Defendants say the alleged structures were not marketed (or not further sold) since around 1990. The only evidence offered were sketches of uncertain origin. Also, if these devices were viable prior art, it would seem that Defendant would have used them to compete with Plaintiff, rather than market the copycat structure presently sold.

11. The main tube and the auxiliary tube of Production Nos. 33 and 34 are of the same diameter and on a vertical level. No support means is provided or suggested.
12. From the facts found and reasons stated above, I do not believe the evidence pertaining to the alleged prior art of Production Nos. 33 and 34 have established by clear and convincing evidence their prior use or sale. Moreover, I find substantial differences between the alleged devices of Production Nos. 33 and 34. Note that the level of skill in the art is not high and giant inventive steps likely would not be made as readily as if this were astrophysics.
13. The other alleged art offered by Defendant is not nearly as similar as Production Nos. 33 and 34, and each fail to show significant pertinence.
14. There are 12 claims in issue. They are claims 1, 2, 5, 7-9, 11-13 and 15-17. Claims 1 and 17 are independent claims. All other claims at issue are dependent on Claim 1, that is, they refer to another claim as a beginning point of the structure they claim.
15. As a matter of law, the Court must construe the claims before literal infringement of the accused structure may be addressed. (Claim construction appears in the Conclusions of Law, *infra*.)
16. Applying the claim construction referred to in the Conclusions of Law; There is literal infringement of independent Claim 1, literal infringement of Claim 17 and literal infringement of dependent Claims 2, 5, 7-9, 11-13 and 15-16.
17. It could be argued that the above is somewhat misstated in that an independent valve, such as each residential fireplace has, is absent from the structure sold. However, the parties previously stipulated in effect that the Defendant's structure is used in the environment of the valve already being in the standard fireplace setup. Everything else is provided by Defendant (and by Plaintiff) to the ultimate customer, normally through a distributor. The evidence is that there is no other use for the patented structure. It is sold with knowledge that it will be used as per its intended use in a gas fireplace with artificial logs. It is not a staple article of commerce. Certainly it is a most significant part of the patented product, in fact, essentially all of it. Hence if there is not element by element literal infringement, there is contributory infringement.

[35 U.S.C. 271(d)].

18. It is further found that the Defendant advertises and provides instructions, such that the installer or the ultimate customer following the advertising and instructions provided by Defendant will constitute infringement. It is further found that demonstrations and sales meetings are held where distributors are shown how to practice the patented invention with Defendants equipment. The distributors pass this onto customers and to installers. By this conduct, Defendant induces infringement (35 U.S.C. 271(c)).
19. In the alternative to literal direct infringement, elements of the claims in suit are present in the accused structure. In each instance, element by element, and also considering the accused structure as a whole, there is insubstantial differences from the Defendant's accused structure and the claims at issue. Moreover, element by element, and as a whole, the accused structure does the same thing (the same function) in the same way to give the same result. While this is repeated under Conclusions of Law, it constitutes infringement under the doctrine of equivalent.
20. After the Defendant received a cease and desist letter, an attorney (Mr. McLaughlin) was called by phone to seek some advice. Mr. McLaughlin was provided only the letter and some advertising brochures or papers. Mr. McLaughlin was not asked for an opinion in the real sense of the word, but was told by Mr. Bortz, the Defendant's executive, that things very similar to the patented structure had existed in the past as early as the eighties. The only advice given by the attorney was that, if that were so, some of the claims would be invalid, depending on just what the prior art devices were, and that he would not have to be concerned about those claims.
21. Attorney McLaughlin was not even provided with the Defendant's accused device at that time, nor any alleged prior art. He was never provided the accused device until long after his oral opinion was given and after suit was filed.
22. In the final analysis, the only opinion given was oral and it was based on some sketches provided that did not include information or details of when they were sold or made available to the public, nor any aspect of their authenticity, detail or history.

The art provided to the attorney clearly did not render the patent claims invalid.

23. The oral opinion, rendered more than a year after the first cease and desist letter and even after suit was filed, did not inform the client that there was no estoppel during prosecution and that the doctrine of equivalents would have to be dealt with. It is uncertain how far the oral opinion went, but it was meager.
24. The Defendant's executive did get what he asked for, a statement that there was no infringement. The Defendant's apparent desire was to avoid paying attorneys fees or increased damages, and this appears to have been the sole reason for consultation with counsel, as shown both by his testimony on why he consulted Mr. McLaughlin by phone and also by Mr. McLaughlin's testimony as to the stated reason for the consultation. Note that at no time before his deposition was taken, did the Defendant's executive Mr. Bortz ever have a face-to-face meeting with Mr. McLaughlin concerning the cease and desist letter, even though he and Mr. McLaughlin were both in Chicago and had offices only a short distance apart. Never before Mr. Bortz's deposition was there an accused structure shown to Mr. McLaughlin. While some advertisements of Defendant's structure were shown, detailed drawings were not provided to attorney McLaughlin. Thus, he never had a full picture of the accused structure. For example, his testimony as to whether or not his auxiliary burner was below the main burner shows that, even then, he had not been able to understand pertinent points of the accused structure.
25. I find that the Defendant merely went through the motion of obtaining an opinion to protect itself and that it did not acquire a timely, well-considered opinion. I find that Defendant knew it was being very casual or cursory concerning the opinion and that the Defendant surely must have known that its opinion was more of a bargain basement job than was needed.
26. As a finding of fact, it is found that the conduct above is wilful.
27. It is found that the following factors exist in the present case: (1) demand for the patented product; (2) absence of acceptable non-infringing substitutes; (3) manufacturing and marketing capability to exploit the demand; and (4) the amount of

the profit it would have made. These are the factors that are referred to in the case of *Panduit Corp. v. Stahlin Bros. Fibre Works, Inc.*, 575 F.2d 1152, 1156, 197 U.S.P.Q. (BNA) 726 (6th Cir. 1978).

28. Log sets and grate support means are included in the computation of lost profits. This takes into consideration Claim 15 as well as considering the convoy of the log sets together with each auxiliary burner unit. The individual burner units are often sold alone to distributors, but the distributors ultimately sell these with a log set.

**B. CONCLUSIONS OF LAW**

1. The Plaintiff owns all right, title and interest in U.S. Patent No. 5,988,159, including the right to sue and recover for past infringement.
2. Claim interpretation applied by the Court is focused on a paragraph by paragraph analysis of each claim in suit, with those paragraphs not believed to require any comment for interpretation being marked such:

**CLAIM 1:**

- a) The preamble requires a gas environment as opposed to a wood burning environment;
- b) The terms used herein are self-explanatory;
- c) The word coals is meant to cover the secondary coals burner elongated tube that is designed or adapted to make the coals or embers enhanced in appearance;
- d) The elongated primary burner tube is held up by the side of the pan through which the elongated primary burner tube extends. The elongated primary burner tube is at a raised level with respect to the secondary coals burner elongated tube (e.g., with respect to the centerline).
- e) The terms used herein are self-explanatory;
- f) The terms used herein are self-explanatory;
- g) The valve is located between the connection to the elongated primary burner tube and the connection to the secondary coals burner elongated tube;
- h) The gas flow control means is the common valve in every gas fed fire place.

**CLAIM 2:** The terms used herein are self-explanatory.

**CLAIM 5:** The terms used herein are self-explanatory.

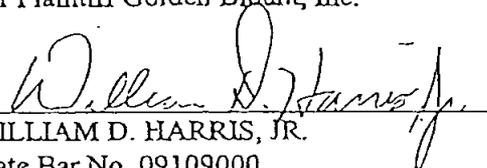
- CLAIM 7: The terms used herein are self-explanatory.
- CLAIM 8: The terms used herein are self-explanatory.
- CLAIM 9: The terms used herein are self-explanatory.
- CLAIM 11: The terms used herein are self-explanatory.
- CLAIM 12: The terms used herein are self-explanatory.
- CLAIM 13: The valve is located between the connection to the elongated primary burner tube and the connection to the secondary coals burner elongated tube;
- CLAIM 15: The terms used herein are self-explanatory.
- CLAIM 16: The terms used herein are self-explanatory.
- CLAIM 17: Away from includes any direction that does not include a horizontal component pointed toward the vertical plane of the fireplace opening, with the exception that the plurality of gas discharge ports should not point substantially vertically upward because sand and embers may fall therein.
3. U.S. Patent No. 5,988,159 is infringed, if not literally, thru inducement and contributory infringement by Defendant. 35 U.S.C. 271(b) and (c), respectfully. Any one of these makes Defendant liable as an infringer.
  4. There is no prosecution history estoppel, per the admission of the Defendant's counsel when under oath.
  5. The infringement occurs through the doctrine of equivalents if not directly and/or literally, based on the facts found relating to equivalence.
  6. The alleged prior uses, sales, and other art do not render any of the claims in suit as anticipated under 35 U.S.C. 102, nor make any in suit obvious under 35 U.S.C. 103.
  7. The claims of the patent are valid.
  8. Damages are awarded to Plaintiff from Defendant, from the time Defendant received notice under the law through its receipt of Plaintiff's notice letter on December 16, 1999.
  9. The *Panduit* factors are met. Thus, compensatory damages include lost profits, which

include conveyed items that interact and are essential to the operation of the patented subject matter. *Panduit Corp. v. Stahlin Bros. Fibre Works, Inc.*, 575 F.2d 1152, 197 U.S.P.Q. (BNA) 726 (6th Cir. 1978). See also, *State Industries v. Mor-Flo Industries, Inc.*, 883 F.2d 1573, 12 U.S.P.Q.2D (BNA) 1026 (1989) or *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538 (Fed. Cir. 1995). The total damages are \$ \_\_\_\_\_

10. The infringement of Defendant was willful. Damages are tripled under 35 U.S.C. 284.
11. This is an exceptional case under 35 U.S.C. 285, and reasonable attorneys fees are awarded Plaintiff.
12. All of the findings of fact and conclusions of law stated above are hereby incorporated together with the usual rule in patent infringement cases, that infringement causes irreparable harm and will be abated. Therefore, an injunction is granted against Defendant. The injunction against infringement is separately set forth and decreed, by this Court.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.

  
WILLIAM D. HARRIS, JR.  
State Bar No. 09109000  
CHARLES W. GAINES  
State Bar No. 07570580  
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Findings of Fact and Conclusions of Law was served on the following counsel of record on April 19, 2002, by first class mail and facsimile:

Jerry R. Selinger  
Jenkins & Gilchrist  
1445 Ross Avenue, Suite 3200  
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F. William McLaughlin  
Dean A. Monco  
Wood, Phillips, VanSanten,  
Clark & Mortimer  
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312/876-2020 (Facsimile)

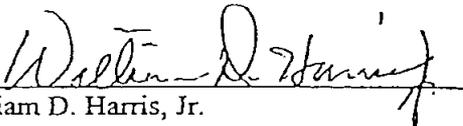
  
William D. Harris, Jr.

EXHIBIT 5

JT-APP 0497

DB

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION

GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

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Civil Action No.

3-01CV0127-R

PLAINTIFF'S ISSUE DIRECTED TRIAL BRIEF

The following is abbreviated to address what are deemed principal issues in the hope of achieving brevity and clarity. Only the significant areas for decision will be addressed:

(A) SUMMARY

The patent in suit is United States Patent No. 5,988,159 (the '159 Patent), entitled "GAS-FIRED ARTIFICIAL LOGS AND COALS-BURNER ASSEMBLY." The '159 Patent was filed as a continuation in part on April 2, 1996, basing its priority on a patent application originally filed on May 17, 1993. The '159 Patent issued on November 23, 1999. One Golden Blount is the inventor of the '159 Patent, and presently, the '159 Patent is assigned to Golden Blount, Inc.

The '159 Patent is directed to, and claims, a highly efficient artificial logs and coals-burner assembly for use with artificial, decorative logs and glowing coals and embers. The artificial logs and coals-burner assembly provides control for the glowing coals and embers independently of the gas logs burn. The '159 Patent accomplishes this by attaching and positioning a secondary coals burner

EXHIBIT  
5

elongated tube forward and below a primary burner tube. The secondary coals burner elongated tube provides a flame out in front of the artificial logs where it lies at a level to inflame small artificial embers and sand on the front hearth portion. This effect more closely approximates the look of a wood burning fireplace. In fact, the artificial coals or embers appearance is greatly enhanced.

The '159 Patent also suggests (i.e., claims) providing a valve between the primary burner tube and the secondary coals burner elongated tube. The valve allows the user to selectively increase the amount of gas being burned forward the artificial logs. This control makes available a greater introduction of radiant heat to the room, than might be afforded using only a conventional primary burner tube. Consequently, the '159 Patent provides an efficient artificial logs and coals burner assembly that provides a flame out in front of the artificial logs, which more closely approximates the look of a wood burning fireplace, as well as provides a greater amount of radiant heat to the room in which it is located.

The Defendants were made aware of the '159 Patent on December 16, 1999, by a letter of December 10, 1999, from L. Dan Tucker (attorney for Plaintiff) to the President of Robert H. Peterson Company. The Defendants responded to the letter of December 16, 1999, but merely sent a put-off letter from Tod M. Corrin to L. Dan Tucker on December 30, 1999. The Defendants have continued to market, manufacture, sell and offer to sell the infringing device since receiving the letter from L. Dan Tucker on December 16, 1999. They did not seek a legal opinion until after suit was filed.

(B) CLAIM INTERPRETATION

The claims of the invention are to be interpreted as a matter of law. *Markman v. Westview*

*Instruments, Inc.*, 52 F.3d 967, 34 U.S.P.Q.2d 1321 (Fed. Cir. 1995). The following interpretation is believed proper in the areas of question, with those areas believed to be fully self-explanatory containing no formal interpretation:

## CLAIM 1:

- a) The preamble requires a gas environment as opposed to a wood burning environment;
- b) The terms used herein are self-explanatory;
- c) The word coals is meant to cover the secondary coals burner elongated tube that is designed or adapted to make the coals or embers enhanced in appearance;
- d) The elongated primary burner tube is held up by the side of the pan through which the elongated primary burner tube extends. The elongated primary burner tube is at a raised level with respect to the secondary coals burner elongated tube (e.g., with respect to the centerline).
- e) The terms used herein are self-explanatory;
- f) The terms used herein are self-explanatory;
- g) The valve is located between the connection to the elongated primary burner tube and the connection to the secondary coals burner elongated tube;
- h) The gas flow control means is the common valve in every gas fed fire place.

CLAIM 13: The valve is located between the connection to the elongated primary burner tube and the connection to the secondary coals burner elongated tube;

CLAIM 17: Away from includes any direction that does not include a horizontal component pointed toward the vertical plane of the fireplace opening, with the exception that the plurality of gas discharge ports should not point substantially vertically upward because sand and embers may fall therein.

## (C) INFRINGEMENT

- (1) Literal Infringement requires that every element of a claim be included in the infringing device. 35 U.S.C. 271(a) Every element of the claims at issue may be found in the Defendant's infringing device. Consequently, the Defendant is infringing the '159 Patent under 35 U.S.C. 271(a).
- (2) Whoever actively induces infringement of a patent shall be liable as an infringer. 35 U.S.C. 271(b) *Fromberg v. Thornhill*, 315 F.2d 407 (5th Cir.

1963). The Defendant has induced distributors and consumers to infringe the '159 Patent. Consequently, the Defendant is infringing the '159 Patent under 35 U.S.C. 271(b).

- (3) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer. 35 U.S.C. 271(c) *Dawson Chemical Co. v. Rohm and Haas Co.*, 448 U.S. 176, 100 S.Ct. 2601, 65 L.Ed. 696 (1980). As the Defendant knew, the device sold by the Defendant has no use other than an infringing use, it not a staple article of commerce, and it is especially adapted to infringe, and it is a material and essential part of the invention. Consequently, the Defendant is infringing the '159 Patent under 35 U.S.C. 271(c).
- (4) Infringement under the doctrine of equivalence. If there are any departures from literal infringement they are slight indeed. They are insubstantial. *Graver Tank v. Linde Air Products*, 339 U.S. 605, 70 S.Ct. 854, 94 L.Ed 1097 (1950). The doctrine is available because there is no prosecution history estoppel, per the admission of the Defendant's counsel when under oath.

## (D) VALIDITY

- (1) There is/are no prior use, prior sale or prior art that invalidates the patent.
- (2) No pertinent documents exist of any kind, except perhaps of recent reconstruction or fabrication. Those recently constructed documents only include sketches of an alleged prior art product, the sketches of which were made by a distributor at the direction of an employee of Defendant and with the assistance of the employee. The nature and the structure of the prior product is speculative and vague. Such alleged prior product and its sales do not meet the standard of clear and convincing evidence to qualify as prior art.
- (3) Additionally, the illustrated structures that bear Production No. 33 and Production No. 34 are but sketches and they are not really of items that are analogous to the ember (coals) burner of the claimed invention. The alleged prior art burners are each of the same size, and moreover, there is no support means shown or suggested. Each of the burners have center lines that are level with respect to one another. Also the deposition testimony of Defendant suggests that these alleged prior art burners were used for a so-called "see through" fireplace, where like burner effects was wanted on each side. As to all the purported art referred to above, it is not believed proved by clear and convincing evidence. It is much like the barb wire case, where many many witnesses sought to show prior structures and sales, but the inventor's patent stood up against the multitude because of lack of solid proof. *The Barbed Wire Patent*, 143 U.S. 275, 12 S.Ct. 443, 36 L.Ed. 154 (1892).

- (4) The other prior art offered is simply not considered in point, although it is considered anyway in the statement just below.
- (5) Considering all of the art, there is no anticipation of the patent claims in suit. There is no one qualified reference that within its four corners is substantially the same as the invention.
- (6) The prior art does not render the invention obvious to one of ordinary skill in the art, as will be analyzed in paragraph 7 below, applying the time proven test of *Graham v. John Deere*: determine the scope and content of the prior art; identify the differences between the invention and the prior art; determine the level of skill in the prior art; and address whether or not the differences are obvious. *Graham v. John Deere*, 383 U.S. 1, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). All this analysis should be done realizing that patents are presumed valid and that the burden to overturn them is substantial—requiring clearly convincing evidence.
- (7) (a) The claimed invention is quite different from any of the references cited. As an example, the claimed burner assembly is configured with an auxiliary front burner, which co-functions with the main burner, and is structured and adapted to extend outwardly to enliven artificial material on the hearth to make it appear as glowing embers or coals at the front of the logs. Such a system attempts to closely approximate the appearance of a wood burning fireplace.
- (b) The level of skill in the art is modest; a person with only several years

experience, perhaps 5 years, would approximate this level - - This becomes a definition of a person of ordinary skill in the art.

(c) It is believed that the differences would not be obvious to one of ordinary skill in the art.

(8) As secondary factors, the Plaintiff's commercial embodiment of the invention has been a commercial success since its introduction in about 1994. It has met a need that has long existed. Further, it has been imitated by Defendant. The foregoing secondary factors bolster the case for validity.

(9) Clear and convincing evidence is required to invalidate the pertinent patent claims. Such evidence has not been presented. The pertinent claims are therefore valid.

(10) The patent is valid and infringed

(E) WILLFUL INFRINGEMENT

- (1) Defendant was given notice by letter of December 10, 1999, received on December 16, 1999.
- (2) Defendant made a less than earnest effort to obtain a prompt opinion.
- (3) After being reminded a second time by Plaintiff, Defendant took no steps to stop its infringement or to get a definitive opinion.
- (4) Defendant did not get an opinion until after suit was filed in January, 2001, which was over a year after notice. Additionally, the opinion was oral and was given without the attorney inspecting the accused product. This was the

case even though the Company officer following the matter was also located in Chicago, and located only a short distance from the attorney's office. Amazingly, the Company office and the attorney never saw each other until depositions were taken in the suit. In short, the attorney was furnished with inadequate information, and the Defendant did not make a substantial effort to provide the adequate information required to render a reasonable opinion. In actuality, the Company officer merely sought an opinion of counsel (per deposition testimony) because he had heard that such an opinion could protect him from attorneys fees (or other damages).

- (5) The similarity of the Defendant's product to the patented product, as well as the timing of Defendant's product entry into the market (i.e., after Plaintiff's product had already entered the market), raises an inference of copying.

#### F. DAMAGES

- (1) Damages are assessed from December 16, 1999, the date of which Defendant was made aware of the patent and their infringement. The damages are the lost profits of Plaintiff. *Panduit Corp. v. Stahl Bros. Fibre Works, Inc.*, 575 F.2d 1152, 197 U.S.P.Q. (BNA) 726 (6th Cir. 1978). See also, *State Industries v. Mor-Flo Industries, Inc.*, 883 F.2d 1573, 12 U.S.P.Q.2D (BNA) 1026 (1989) or *Rite-Hite Corp. v. Kelley Co.*, 56 F.3d 1538 (Fed. Cir. 1995). The figures will be proved at the trial. Note that the damages include the lost profits on so-called "convoyed" products, also known as the entire market

value rule.

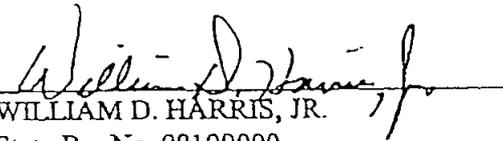
- (2) The damages should be trebled under 35 U.S.C. 285, [or 284]
- (3) This being an exceptional case, reasonable attorneys fees should be awarded to Plaintiff.

(G) INJUNCTION

- (1) As is usually the case where the Plaintiff has prevailed in a patent case, the infringing Defendant is enjoined from further infringement. 35 U.S.C. 283 *Smith International, Inc. v. Hughes Tool Co.*, 718 F.2d 1573 (Fed Cir. 1983), cert. denied, 104 S.Ct. 493 (1988). For permanent injunctions in a patent and infringement case, the injunctive relief is considered a matter of right.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



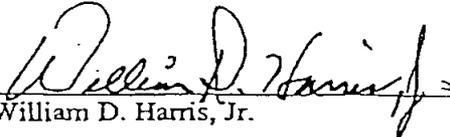
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the enclosed Plaintiff's Issue Directed Trial Brief was served on the following counsel of record on April 19, 2002, by first class mail and facsimile:

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JT-APP 0507

EXHIBIT 6

JT-APP 0508

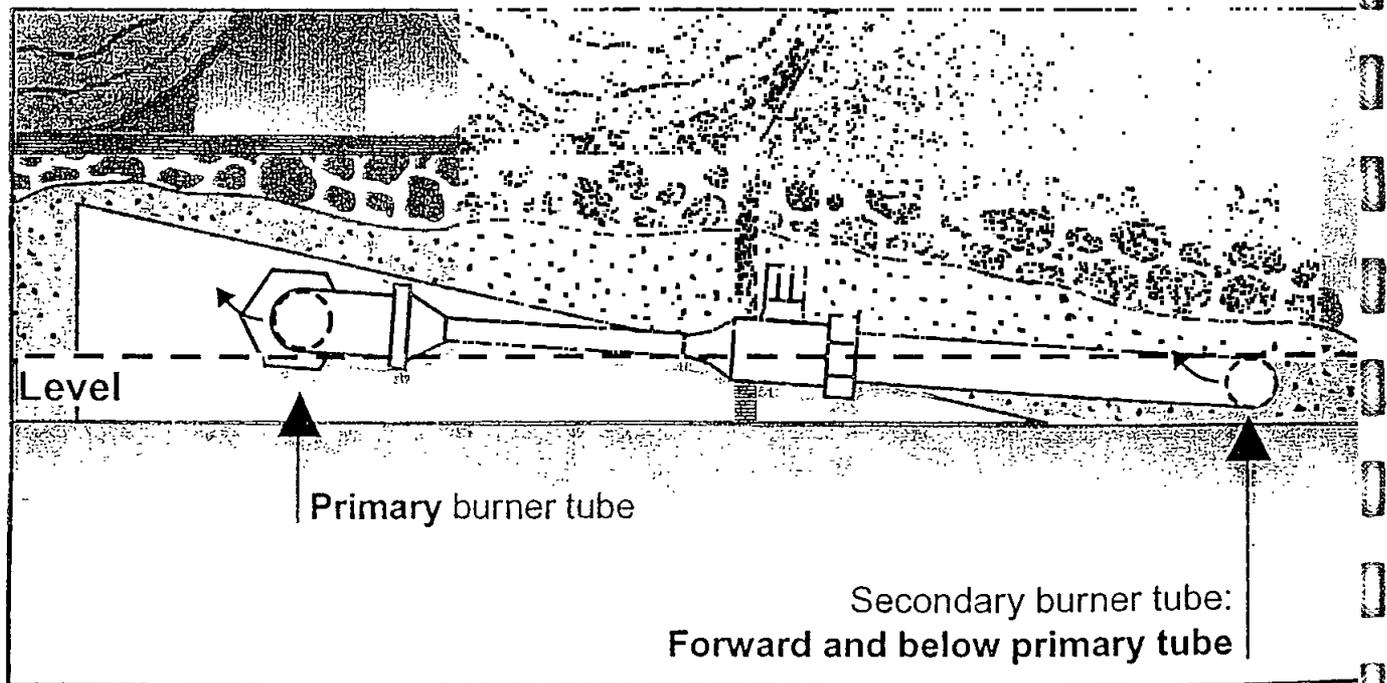
# Position of Burners

## '159 Patent, Claim 1:

a support means for holding the elongated primary burner tube in a *raised level* relative to the forwardly position secondary coals burner elongated tube;

## '159 Patent, Claim 17:

...the secondary burner tube positioned substantially parallel, forward and *below* the primary burner tube...



EXHIBIT

JT-APP 0509

EXHIBIT 7

JT-APP 0510

# Direction of Ports

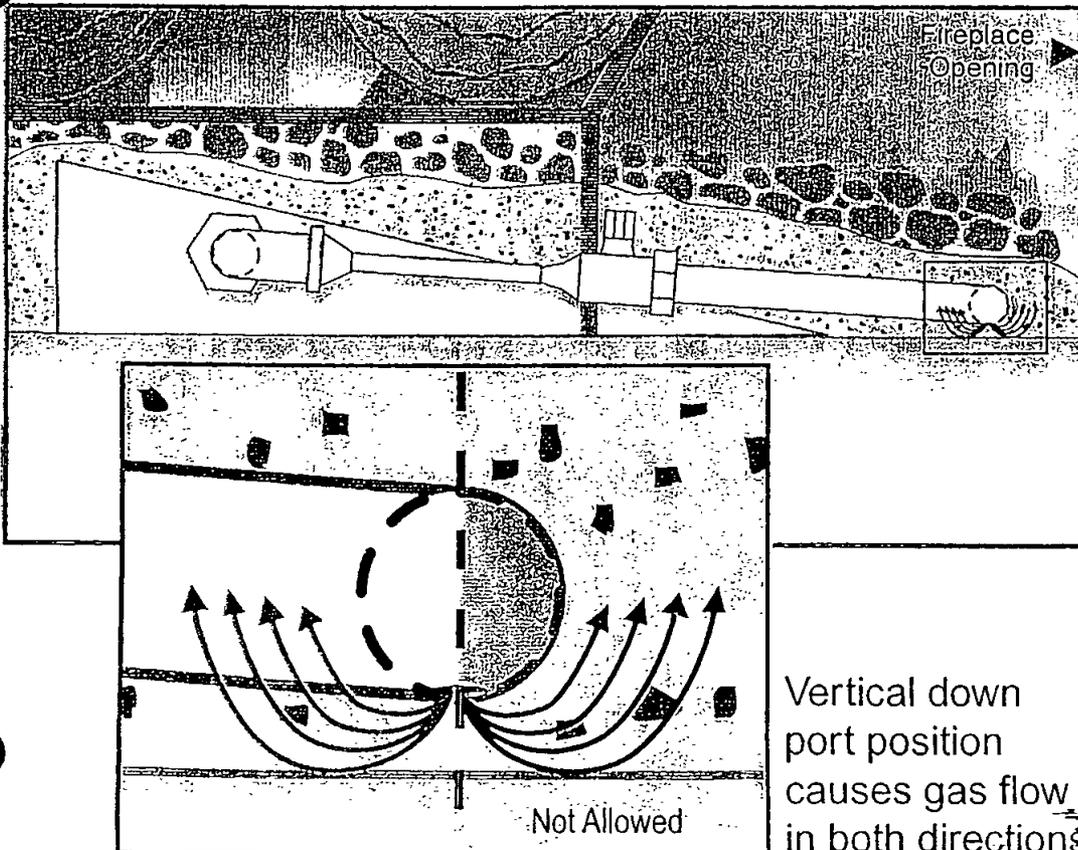
VERTICAL DOWN NOT COVERED BY SPECIFICATION

## '159 Patent, Claim 17:

... gas distribution ports of the secondary burner tube *directed away* from the fireplace opening.

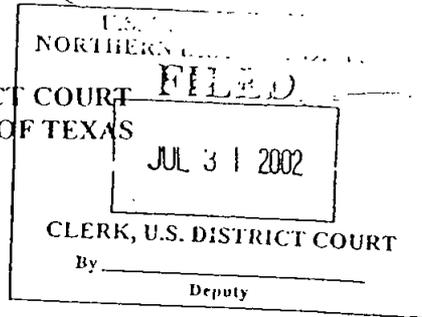
## '159 Patent, Col. 5, Lines 56-61:

These various phased apertures or gas discharge ports are *most important in their position* in regard to both the primary and secondary tube burners. In the secondary burner tube 104, the gas is discharged *in a direction away* from the opening of the fireplace...



EXHIBIT

IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION



GOLDEN BLOUNT, INC.,

Plaintiff,

v.

ROBERT H. PETERSON CO.,

Defendant.

§  
§  
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§  
§

Civil Action No.

3-01CV0127-R

PLAINTIFF GOLDEN BLOUNT INC.'S  
MOTION TO DISREGARD THE TESTIMONY OF  
OF JOHN PALASKI AND BRIEF IN SUPPORT THEREOF

TO THE HONORABLE JUDGE OF SAID COURT:

COME NOW, Plaintiff Golden Blount, Inc. (hereinafter, "Blount" or "Plaintiff") to file this, its motion to disregard the testimony and declaration of Mr. John Palaski as prior art, and its brief in support thereof.

I. INTRODUCTION

Plaintiff filed this lawsuit seeking a judgement against Defendant Robert H. Peterson Co. (hereinafter, "Defendant") in connection with its infringement of United States Patent No. 5,988,159 (hereinafter, the "the '159 patent"). Among other things, Plaintiff seeks a judgment from the Court that the declaration and oral testimony of Mr. John Palaski be disregarded as prior art, and therefore insufficient to establish either anticipation under 35 U.S.C. § 102 or obviousness under 35 U.S.C. § 103.

## II. LEGAL ARGUMENT

Historically, courts have looked with disfavor upon finding anticipation with only oral testimony. In *the Barbed Wire Patent*, 143 U.S. 275, 36 L. Ed. 154, 12 S. Ct. 443, 1892 Dec. Comm'r Pat 299 (1892), the Supreme Court commented on the dangers of invalidating a patent on oral testimony alone. In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury. Courts have not only imposed upon Defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt. Courts have stated that witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information. *Id. at 284.*

The *Barbed Wire Patent* involved a dispute over the novelty of a patent for barbed wire. Twenty-four witnesses testified on behalf of an accused infringer that they had seen an anticipating barbed wire fence exhibited by one Morley at an 1858 or 1859 county fair at Delhi in Delaware County, Iowa. *Id. at 285.* In the *Barbed Wire Patent* case, the district court found that it was unlikely that all twenty-four witnesses were lying, and declared the patent invalid based on their testimony. On appeal, however, the Supreme Court of the United States reversed the district court ruling. The Supreme Court noted:

The very fact ... that almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny.

*The Barbed Wire Patent*, 143 U.S. at 284-85.

The Court later clarified that the high standard of proof required when using oral testimony to prove prior public use was not "beyond a reasonable doubt" as stated in *The Barbed Wire Patent*, but was nevertheless a high threshold. See *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 60 (1923) ("The temptation to remember in such cases and the ease with which honest witnesses can convince themselves after many years of having had a conception at the basis of a valuable patent, are well known in this branch of law, and have properly led to a rule that evidence to prove prior discovery must be clear and satisfactory.").

In light of this high standard, the Court of Custom and Patent Appeals adopted a list of factors for evaluating the credibility of oral statements. In *In re Reuter*, the Court established that for evaluating the credibility of oral statements: (1) delay between event and trial, (2) interest of witness, (3) contradiction or impeachment, (4) corroboration, (5) witnesses' familiarity with details of alleged prior structure, (6) improbability of prior use considering state of the art, (7) impact of the invention on the industry, and (8) relationship between witness and alleged prior user. *In re Reuter*, 670 F.2d 1015, 1021 & n.9 (CCPA 1981). (citing *E I du Pont de Nemours & Co. v. Berkley & Co.*, 620 F.2d 1247, 1261 n.20, 205 USPQ 1, 11 n.20 (8th Cir. 1980))

In further support of this high standard, the Federal Circuit, citing *The Barbed Wire Patent*, has recently held that the testimony of six witness were not sufficient to overcome the clear and convincing standard that is necessary to invalidate a patent. *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728 (Fed. Cir. 2002). In reaching its decision, the court stated that "Historically, courts have looked with disfavor upon finding anticipation with only oral testimony..." after which it referenced the holding in *The Barbed Wire Patent*. *Id.* at 748.

The facts of the present case, especially in view of those factors set forth in *In re Reuter*, weigh heavily in favor of disregarding the incredible oral testimony and declaration of Mr. Palaski as prior art because they fail to overcome the clear and convincing standard.

First, almost 28 years has elapsed between the time Mr. Palaski supposedly first displayed his device and this trial. As was evidenced by Mr. Palaski's forgetfulness and sparse testimony, this considerable amount of time has taken a substantial toll on his ability to remember the facts as they were.

Second, Mr. Palaski appears to be an interested witness. As was testified to by Mr. Janikowski (a 40 year employee of Defendant Robert H. Peterson and extremely good friend of Mr. Palaski<sup>1</sup>), Mr. Palaski was, at the time of owning and operating his Fireside Shop, one of Defendant's highest volume distributors. It goes without saying that such a situation created an indebtedness between the parties. This fact alone, implies that Mr. Palaski is an interested witness.

Third, the testimony Mr. Palaski gave in his direct examination contradicted the testimony he gave in his cross-examination. For instance, on direct examination Mr. Palaski averred that the only difference between the device he manufactured and sold in the mid 1970s and that which Mr. Janikowski had manufactured to resemble Mr. Palaski's drawings, was the type of valve used in the two. In his cross-examination, however, Mr. Palaski contradicted this testimony, stating that in addition to the valve being different, the tubing used to carry the gas from the primary burner to the secondary burner and the fittings were also different.

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<sup>1</sup> Mr. Janikowski testified on cross-examination that he and Mr. Palaski were very good friends, such good friends that on occasions each had been to the others home.

Fourth, nothing exists to substantially corroborate Mr. Palaski's testimony. As established at trial by Mr. Palaski's testimony, Mr. Janikowski and others who visited the shop did not actually observe the complete device because sand and embers covered a substantial portion of the burner system. Furthermore, other than the spur of the moment drawing that Mr. Palaski prepared many months after suit was filed, he failed to produce even one document or other writing that evidenced the prior existence of his device.

Fifth, Mr. Palaski never even sold the complete unit, but instead sold component parts that may or may not have been assembled into the device by the end user. Moreover, Mr. Palaski testified at trial that he didn't know if even one of his devices exists today. Both of these facts clearly indicate that his device had little or no impact on the industry.

Sixth, Mr. Palaski's own personal interest in this matter is significant, given the fact that Mr. Palaski, the witness, was also the same person who supposedly built the device.

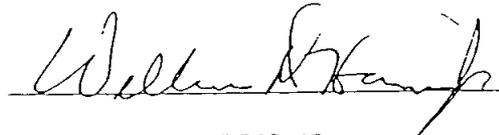
Finally and seventh, when questioned about the relative height of each of the tubes, Mr. Palaski demonstrated less than a perfect recollection to detail, when he stated that he only "thought" that one was higher than the other but was somewhat uncertain until a mock-up of a device made by Mr. Janikowski was referenced.

In view of the fact that all of the *In re Reuter* factors have been established in this case, Mr. Palaski's testimony and declaration do not overcome the clear and satisfactory standard as set forth by the above-referenced case law, and accordingly, Mr. Palaski's testimony is therefore insufficient to invalidate the '159 patent.

Therefore, in view of the precedent set forth in the *Barbed Wire Patent* case and *In re Reuter*, as well as that which was confirmed just recently in the Federal Circuit case of *Juicy Whip, Inc.*, the Plaintiff requests that this Court do as the Courts have done in the past, and disregard the belated oral testimony and declaration of Mr. Palaski as prior art.

Respectfully submitted,

For Plaintiff Golden Blount, Inc.



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