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 Counterclaimant Activision, Inc.

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13 UNITED STATES DISTRICT COURT
 14 NORTHERN DISTRICT OF CALIFORNIA

16	THE MAGNAVOX COMPANY, a corpora-)	No. C 82 5270 CAL
	tion, and SANDERS ASSOCIATES,)	
17	INC., a corporation,)	PRETRIAL STATEMENT OF
)	ACTIVISION, INC. REGARDING
18	Plaintiffs,)	DISPUTED POINTS OF LAW
)	<u>(Local Rule 235-7(g))</u>
19	vs.)	
)	
20	ACTIVISION, INC., a corporation,)	
)	
21	Defendant.)	Pretrial
)	Conference: Dec. 13, 1984
22	_____)	
23	AND RELATED CROSS-ACTION.)	
	_____)	

25 Defendant and Counterclaimant Activision, Inc. submits the
 26 following concise statement of disputed points of law pursuant to

1 Local Rule 235-7(g). A more extensive legal argument will be con-
2 tained in Activision's trial brief.

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1. Direct Infringement. There is no direct literal infringement of a patent unless the item alleged to infringe is literally and clearly covered by the "claims" of the patent. For the purposes of direct literal infringement, the "claims" of a patent are limited to the literal "claim" language contained in the patent and are the sole measure of the patent.

See Graver Tank & Manufacturing Co. v. Linde Air Products Co., 339 U.S. 605, 607 (1950); Cimiotti Unhairing Co. v. American Fur Refining Co., 198 U.S. 399, 410 (1905); 35 U.S.C. §271(a).

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2. Identity of means, operation and result between patent and accused device. Mere application of claim phraseology or a word by word correspondence is not enough, nor is similarity of result--there must be real identity of means, operation and result in order to find direct literal infringement.

See, e.g., Reese v. Elkhart Welding & Boiler Works, Inc.,
447 F.2d 517, 527 (7th Cir. 1971).

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4. Sale of component is not direct infringement. The sale of a component of any patented combination does not in itself constitute direct infringement, as there is no direct infringement unless all of the elements of a patented combination are used by the alleged infringer. There is no direct infringement other than literal direct infringement and direct infringement based on the doctrine of equivalents.

See Aro Manufacturing Co. v. Convertible Top Replacement Co., 365 U.S. 336, 339-40 (1961) ("Aro I"); Cimiotti Unhairing Co. v. American Fur Refining Co., 198 U.S. 399, 410 (1965).

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5. Contributory infringement defined. . Contributory infringement is established only when an unpatented component of a patented device is a material part of the invention which is essential to the inventive character of the patented combination, the manufacturer knows that the component is especially made or adapted for use in infringement of the patent, and the component is not a staple article or commodity of commerce suitable for substantial noninfringing use.

35 U.S.C. §271(c). See generally Dawson Chemical Co. v. Rohm & Haas Co., 448 U.S. 176 (1980); Wilbur-Ellis Co. v. Kuther, 377 U.S. 422 (1964).

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6. Component must be described in claims or equivalent.

There is no contributory infringement of a valid patent for sale of a component not literally described in the patent claims and not the substantial equivalent of some component described in the patent.

See 35 U.S.C. §271(c).

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7. Ideas not patentable. All ideas are part of the public domain and cannot be patented. Only particular physical embodiments of ideas are subject to patenting if such physical embodiments meet the statutory requirements.

See, e.g., Gottschalk v. Benson, 409 U.S. 63, 67 (1972); Jones v. Hardy, 727 F.2d 1524 (Fed. Cir. 1984); RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1445 n.5 (Fed. Cir.) cert. dismissed sub nom. RCA Corp. v. Hazeltine Corp., -- U.S. --, 53 U.S.L.W. 3160 (Aug. 29, 1984); Panduit Corp. v. Stahlin Bros. Fibre Works, 575 F.2d 1152, 1159 n.7 (6th Cir. 1978).

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1 8. Adaption of patented device is not contributory
2 infringement. There is no contributory infringement of a valid
3 patented combination for sale of a component used in connection with
4 the patented device which adapts the patented device to a related
5 use, where the adaptation does not go to the heart of the invention.

6 See Wilbur-Ellis Co. v. Kuther, 377 U.S. 422 (1964);
7 General Electric Co. v. United States, 572 F.2d 745, 785 (Ct. Cl.
8 1978); Thompson-Houston Electric Co. v. Kelsey Electronic Railway
9 Specialty Co., 75 F. 1005 (2d Cir. 1896); 35 U.S.C. §271(c). See
10 generally Dawson Chemical Co. v. Rohm & Haas Co., 448 U.S. 176
11 (1980). Cf. Motion Picture Patents Co. v. Universal Film Manufac-
12 turing Co., 243 U.S. 502 (1917) (holding that various motion picture
13 films did not constitute contributory infringement of the movie
14 projector patent, where film was not literally described in the
15 patent in suit).

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1 9. No contributory infringement unless reconstruction of
2 patented device. There is no contributory infringement of a valid
3 patented combination for sale of a component used in connection with
4 the accused device unless the component constitutes reconstruction
5 of the patented device or the accused device is unlicensed.

6 See 35 U.S.C. §271(c); Dawson Chemical Co. v. Rohm & Haas
7 Co., 448 U.S. 176, 217-18 (1980); Aro Manufacturing Co. v. Convert-
8 ible Top Replacement Co., 377 U.S. 476 (1964) ("Aro II"); Wilbur-
9 Ellis Co. v. Kuther, 377 U.S. 422 (1964); Aro Manufacturing Co. v.
10 Convertible Top Replacement Co., 365 U.S. 336 (1961) (Aro I). See
11 generally Brown, The Manufacture and Sale of Unpatented Parts, 18 J.
12 Pat. Off. Soc'y 573 (1936).

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1 10. Replacement or reconstruction. In determining
2 whether the sale of an unpatented component of a patented combina-
3 tion is a contributory infringement, the court should consider
4 whether the component is a replacement or whether the sale of the
5 component constitutes a reconstruction of the patented device. A
6 true reconstruction of a patented combination is limited to the
7 making of a new article after the patented combination has become
8 spent. In order to call the patent monopoly into play for a second
9 time, the component must constitute a second creation of the
10 patented combination.

11 See Aro Manufacturing Co. v. Convertible Top Replacement
12 Co., 365 U.S. 336, 345-46 (1961) (Aro I); Wells Manufacturing Corp.
13 v. Littelfuse, Inc., 547 F.2d 346 (7th Cir. 1976). See generally
14 Comment, Combination Patents: The Right to Prohibit Sales of
15 Replacement Parts, 70 Yale L.J. 649 (1961).

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1 11. Interchangeable addition to patented device is not
2 contributory infringement. There is no contributory infringement of
3 a valid patented combination for sale of a component used in connec-
4 tion with the patented device as an addition to the patented device
5 which can be interchanged with a component of a licensed patented
6 combination, unless the patented device is unlicensed, or the compo-
7 nent goes to the heart of the invention.

8 See Aro Manufacturing Co. v. Convertible Top Replacement
9 Co., 377 U.S. 476 (1964) (Aro II); Beckman Instruments, Inc. v.
10 Technical Development Corp., 730 F.2d 1076, 1085-86 (7th Cir.),
11 cert. denied, -- U.S. -- 53 U.S.L.W. 3239 (Oct. 1, 1984). See
12 generally Comment, Combination Patents: The Right to Prohibit Sales
13 of Replacement Parts, 70 Yale L.J. 649 (1961).

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12. Primary market or replacement market for components of patented device. In determining whether the sale of an unpatented component of a patented combination is a contributory infringement, the court should consider whether the component is to be used in the "primary" market for the patented combination or a "replacement" market. If the component is used in the "replacement" market, the issue is whether the component constitutes reconstruction of the patented combination. If the component is used in the "primary" market, the issue is whether the component is a staple item of commerce.

See Dawson Chemical Co. v. Rohm & Haas Co. 448 U.S. 176,

220 (1980).

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1 13. Implied license to replace components of patented
2 device. The user of a patented combination which is licensed has an
3 implied license to use of the patented device in a manner which is
4 reasonably contemplated, including replacement of component parts or
5 other accessories necessary for full use of the equipment. The user
6 does not have such an implied license to reconstruct the patented
7 combination so as in fact to make a new article.

8 See Beckman Instruments, Inc. v. Technical Development
9 Corp., 730 F.2d 1076, 1085-86 (7th Cir.), cert. denied, -- U.S. --,
10 53 U.S.L.W. 3239 (Oct. 1, 1984). See generally Dawson Chemical Co.
11 v. Rohm & Haas Co., 448 U.S. 176, 184 (1980); Aro Manufacturing Co.
12 v. Convertible Top Replacement Co., 377 U.S. 476, 484 (1964)
13 (Aro II); Aro Manufacturing Co. v. Convertible Top Replacement Co.,
14 365 U.S. 336, 345-46 (1961) (Aro I); United States v. Univis Lens
15 Co., 316 U.S. 241, 249-50 (1942); Adams v. Burke, 84 U.S. (17 Wall.)
16 453, 456 (1873). Cf. Sony Corp, of America v. Universal City
17 Studios, Inc., -- U.S. --, 52 U.S.L.W. 4090, 4095 n.19 (Jan. 17,
18 1984) (noting similarity of copyright and patent law, and holding
19 that use of video recorder to copy television programs covered by
20 copyright was a "fair use").

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14. First sale exhausts patent monopoly. The first sale by a patentee or licensee of an article embodying the invention exhausts patent rights in that article.

See United States v. Univis Lens Co., 316 U.S. 241, 250-52 (1942); United States v. Masonite Corp., 316 U.S. 265, 277-78 (1942).

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1 15. Equivalents. The doctrine of equivalents allows a
2 finding of direct infringement even if the allegedly directly-
3 infringing device is not literally disclosed in the valid patent,
4 only if the allegedly directly-infringing device accomplishes the
5 same end as the patent by use of a substantially equivalent means,
6 function and principle. "Substantially equivalent" means has been
7 interpreted as unimportant or slight variations to conceal the
8 infringement of the patent. The essence of the doctrine is that one
9 may not practice a fraud on the patent.

10 See, e.g., Graver Tank & Manufacturing Co. v. Linde Air
11 Products Co., 339 U.S. 605 (1950); American Hospital Supply Corp. v.
12 Travenol Laboratories, Inc., No. 83-1401, slip. op. (Fed. Cir.
13 Sept. 26, 1984); Hughes Aircraft Co. v. United States, 717 F.2d
14 1351, 1361 (Fed. Cir. 1983); Thomas & Betts Corp. v. Litton Systems,
15 Inc., 720 F.2d 1572, 1579-80 (Fed. Cir. 1983); Hale Fire Pump Co. v.
16 Tokai, Ltd., 614 F.2d 1278 (C.C.P.A. 1980). Cf. RCA Corp. v.
17 Applied Digital Data Systems, Inc., 730 F.2d 1440, 1446 (Fed. Cir.),
18 cert. dismissed sub nom. RCA Corp. v. Hazeltine Corp., -- U.S. --,
19 53 U.S.L.W. 3160 (Aug. 29, 1984) (finding certain digital circuitry
20 not a "mere substitution" for analog circuitry).

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16. Equivalents--File Wrapper Estoppel. Application of the doctrine of equivalents is limited by file wrapper estoppel, which precludes a patentee from obtaining a claim construction effectively resurrecting subject matter surrendered during prosecution of the patent application.

See, e.g., Thomas & Betts Corp. v. Litton Systems, Inc., 720 F.2d 1572, 1579 (Fed. Cir. 1983); Hughes Aircraft Co. v. United States, 717 F.2d 1351, 1362 (Fed. Cir. 1983). See generally Graham v. John Deere Co., 383 U.S. 1, 33-34 (1966).

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18. Invalidity--order of proof. The party asserting
invalidity must proceed first to establish a prima facie case of
invalidity.

See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530
(Fed. Cir. 1983).

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1 19. A patent is presumed valid, and the patent challenger
2 must come forth with countervailing evidence tending to establish
3 invalidity. The question is whether all the evidence establishes
4 that the patent challenger has carried its burden so as to have
5 persuaded the decisionmaker that the patent can no longer be
6 accepted as valid. Thus, the statutory presumption is of no effect
7 when wholly dissipated by rebutting considerations.

8 See Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530,
9 1534 (Fed. Cir. 1983); Stukenborg v. Teledyne, Inc., 441 F.2d 1069,
10 1072 (9th Cir. 1971); 35 U.S.C. §282.

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1 20. Public policy--construe patents narrowly. Public
2 policy requires that in contributory infringement cases the monopoly
3 granted to an inventor by the patent laws be construed narrowly.
4 The primary purpose of the patent laws is not the creation of pri-
5 vate fortunes for the owners of patents, but is to promote the
6 progress of science and the useful arts.

7 See, e.g., Sony Corp. of America v. Universal City
8 Studios, Inc., -- U.S. --, 52 U.S.L.W. 4090, 4096 (Jan. 17, 1984);
9 Motion Picture Patents Co. v. Universal Film Manufacturing Co., 243
10 U.S. 502 (1917). See generally U.S. Const. art. I, §8.

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21. De minimis infringement not actionable. There is no liability for patent infringement if the accused device incorporates the patented invention in a trivial or de minimis fashion.

Cf., e.g., Georgia-Pacific Corp. v. United States Plywood Corp., 318 F. Supp. 1116 (S.D.N.Y. 1970), modified on other grounds, 446 F.2d 295 (2d Cir.), cert. denied, 404 U.S. 870 (1971) (recognizing that the extent to which an infringer has made use of the invention is relevant to a determination of the amount of damages).

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22. Obviousness defined. In order to determine when a patented device is obvious and therefore invalid, the Court should determine the (i) scope and content of the prior art; (ii) differences between the prior art and the claims at issue; and (iii) the level of ordinary skill in the pertinent art.

See Graham v. John Deere Co., 383 U.S. 1, 17-18 (1966).
See generally Note, Subtests of "Nonobviousness": A Nontechnical Approach to Patent Validity, 112 U. Pa. L. Rev. 1169 (1964).

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23. Obviousness--ordinary skill in the art. A patent may not be obtained and one issued will not be found valid if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertained.

35 U.S.C. §103.

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1 24. Obviousness--prior art defined by disciplines relat-
2 ing to the nature of the problem. In determining whether an inven-
3 tion would have been obvious to one of ordinary skill in the art at
4 the time the claimed invention was made, the "art" is not limited to
5 a single discipline, but rather includes disciplines which relate to
6 the nature of the problem confronting the would-be inventor.

7 See, e.g., In re Wood, 599 F.2d 1032 (C.C.P.A. 1979);
8 Louis A. Grant, Inc. v. Keibler Industries, Inc., 191 U.S.P.Q. 424,
9 426 (7th Cir. 1976).

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25. Obviousness--prior art and equivalents. In determin-
ing whether a claimed invention is obvious in light of the prior
art, the prior art must be evaluated in light of its equivalents.
The broad scope of equivalents accorded a pioneer patent should be
considered when determining if a claimed invention is obvious in
light of the prior art which includes a pioneer patent.

See generally Thomas & Betts Corp. v. Litton Systems,
Inc., 720 F.2d 1572, 1579-80 (Fed. Cir. 1983).

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26. Prior art--anticipation by previous invention. A patent is anticipated, and therefore invalid, if the claims of the patent or its equivalent, read on something disclosed in the prior art. The claims of the patent are deemed to read on the prior art if all limitations of the claim are found fully met by the prior art.

See, e.g., Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772 (Fed. Cir. 1983), cert. denied, -- U.S. --, 52 U.S.L.W. (Feb. 21 1984); Tate Engineering, Inc. v. United States, 477 F.2d 1336, 1342 (Ct. Cl. 1973); 35 U.S.C. §102.

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1 27. Prior art not considered by Patent Office--effect on
2 presumption of validity. When relevant prior art is not considered
3 by the Patent and Trademark Office prior to issuance of a patent,
4 the party challenging the validity of a patent is more likely to
5 carry its burden of persuasion.

6 See Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d
7 1563, 1566 (Fed. Cir. 1983).

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28. Estoppel from urging broad interpretation of patent claims. If a patentee argues to the Patent Office a narrow construction of claims, the patentee is precluded from arguing a broader construction for purposes of infringement.

See Coleco Industries v. United States International Trade Comm., 573 F.2d 1247, 1257 (C.C.P.A. 1978); SRI International v. Matsushita Electric Corp. of America, 591 F. Supp. 464 (N.D. Cal. 1984).

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29. A foreign patent application, which claims as its priority filing date the date of application in the United States, must describe and claim the same invention for which a patent is sought in the United States.

International (Paris) Convention for the Protection of Industrial Property (1883), as revised at Brussels on December 14, 1900, at Washington on June 2, 1911, at The Hague on November 6, 1925, at London on June 2, 1934, at Lisbon on October 31, 1958, and at Stockholm on July 14, 1967.

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30. Combination claim limited to disclosed structure.

When the elements of a combination claim are expressed as means for performing specific functions, such claim is construed to cover only the corresponding structure described in the specification or its mechanical equivalent.

See 35 U.S.C. §112.

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31. Pioneer patents. A pioneer patent is a patent covering a function never before performed, a wholly-novel device, or one of such novelty and importance as to make a distinct step in the progress of the art, as distinguished from a mere unanticipated and nonobvious improvement or perfection of previous technology.

See Westinghouse v. Boyden Power Brake Co., 170 U.S. 537, 561-62 (1898); Ziegler v. Phillips Petroleum Co., 483 F.2d 858, 870 (5th Cir.), cert. denied, 414 U.S. 1079 (1973); Connell v. Sears, Roebuck & Co., 559 F. Supp. 229 (N.D. Ala.), aff'd in part and modified in part and vacated in part on other grounds, 722 F.2d 1542 (Fed. Cir. 1983).

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32. Patent marking. Patentees may give notice to the public that a patented article or combination is patented by marking the patented article or combination with the patent number, or by otherwise giving notice of infringement. In the event of failure to so mark or notify, no damages shall be recovered by the patentee in any action for infringement, except on proof that the infringer was notified of the infringement and continued to infringe, in which event damages may be recovered only for infringement occurring after such notice.

35 U.S.C. §287.

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1 PROOF OF SERVICE

2 I, MARIE SPIEGL, declare as follows:

3 1. I am a resident of the City and County of San
4 Francisco, over the age of eighteen years and not a party to the
5 within action. My business address is Three Embarcadero Center,
6 Suite 700, San Francisco, California.

7 2. On December 3, 1984 I served the following document:
8 PRETRIAL STATEMENT OF ACTIVISION, INC. REGARDING DISPUTED POINTS
9 OF LAW as follows:

10 By FEDERAL EXPRESS, a true and correct copy in a sealed
11 envelope addressed as follows:

12 James T. Williams, Esq.
13 NEUMAN, WILLIAMS, ANDERSON & OLSON
14 77 W. Washington Street
Chicago, IL 60602

15 By HAND DELIVERY, by causing a true and correct copy to
16 be personally delivered addressed as follows:

17 Robert L. Ebe, Esq.
18 McCUTCHEN, DOYLE, BROWN & ENERSEN
19 3 Embarcadero Center
Twenty-eighth Floor
San Francisco, CA 94111

20 I declare under penalty of perjury that the foregoing
21 is true and correct.

22 Executed this 3rd day of December 1984 at San Francisco,
23 California.

24
25 
26 MARIE SPIEGL

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