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United States District Court For The

Northern District of California

THE MAGNAVOX COMPANY, a corporation, and SANDERS ASSOCIATES, INC., a corporation, Plaintiffs, v. ACTIVISION, INC., a corporation Defendant.	No. C 82 5270 TEH SURREPLY MEMORANDUM IN SUPPORT OF PLAINTIFFS' MOTION TO DISMISS SECOND COUNTERCLAIM

At the January 10, 1983 hearing on plaintiffs' motion to dismiss defendant's second counterclaim, plaintiffs were given leave to file a memorandum responding to defendant's citation at that hearing of two new cases. Those two cases, Corometrics Medical Systems, Inc. v. Berkeley Bio-Engineering, Inc., 193 U.S.P.Q. 467 (N.D. Cal. 1977) and Dresser Industries, Inc. v. Ford Motor Co., 530 F.Supp. 303 (N.D. Texas 1981) were

cited by Activision in support of the contention made in its opposing memorandum (page 7) that the plaintiffs may sue on the original Baer patent 3,728,480 even after that patent is reissued. Plaintiffs pointed out the error of this position in their reply memorandum. Aside from some rather loose language contained in Corometrics and Dresser, these cases simply do not support Activision's position. To the contrary, a close look at them, especially Corometrics, will show that they are consistent with plaintiffs' position.

Section 251 of the patent code, 35 U.S.C., explicitly states that upon granting of a reissue patent, the original patent is surrendered. Since it was the grant of the original patent that permitted the patent owner to bring suit upon it, it is apparent from the language of the statute that the surrender of that patent extinguishes that right. The historic rule has been that the surrender of the original patent completely terminates the right to sue upon it, that the basis for actions for infringement of the patent pending when the reissue is granted is defeated by the surrender, and that the patent owner in such a case must refile a new infringement action based upon the reissue patent. See, for example, Peck v. Collins, 103 U.S. 660, 664 (1880), Moffitt v. Garr, 66 U.S. 273 (1861); Brown v. Hinckley, Fed. Case No. 2,012 (E.D. Mich. 1873); and 3 Chisum, "Patents" (1982) §§15.02[7] and 15.05[1]. The statutory section now appearing at 35 U.S.C. §252 entitled "Effect of Reissue" was enacted to alleviate this anomalous situation in instances where the reissue patent includes

Associates, Inc., herewith state and represent to the Court, that if plaintiffs' motion to dismiss is granted and Activision's second counterclaim is dismissed with prejudice, neither of plaintiffs will sue Activision for infringement of either any claim of the original Baer U.S. Patent No. 3,728,480 or any claim of any reissue of the Baer U.S. Patent 3,728,480 which claim is identical to any claim presently in the original patent for any activity of Activision in relation to its television game cartridges which were on the market prior to October 25, 1982, the dates Activision served its counterclaims upon plaintiffs.

Conclusion

Any residum of reasonable and real apprehension is removed by the immediately proceeding representation. There is simply no need for this court to consider infringement of the original Baer patent claims by Activision, and there will be no need to do so after the Baer patent is reissued. Both parties have submitted affidavits in support of their positions. Pursuant to Rule 12(b), F.R.Civ.P., this motion is now ready to be disposed of as a motion for summary judgment under Rule 56, F.R.Civ.P. Neither party contends that there is any genuine issue of fact material to the motion. This court should conclude that, based on the facts before it, no real