

United States District Court,
N.D. California.

APPLIED MATERIALS, INC,
Plaintiff.

v.

ADVANCED SEMICONDUCTOR MATERIALS AMERICA, INC., et al,
Defendants.

No. C-91-20061-RMW(EAI)

Nov. 25, 1992.

Don W. Marten of Knobbe, Martens, Olson & Bear, Newport Beach, Cal., for plaintiff.

Matthew D. Powers of Orrick, Herrington & Sutcliffe, San Francisco, Cal., for defendant.

**ORDER DENYING DEFENDANTS' MOTION FOR PARTIAL SUMMARY JUDGMENT OF NON-
INFRINGEMENT OF U.S. PATENT NOS. 4,047,496 AND 4,081,313**

WHYTE, District Judge.

The motion of defendants Advanced Semiconductor Materials America, Inc. and Epsilon Technology, Inc., doing business as ASM Epitaxy, ("defendants") for partial summary judgment of noninfringement of U.S. Patent Nos. 4,047,496 and 4,081,313 came on regularly for hearing on October 23, 1992. The court has read the moving and responding papers and heard the oral argument of counsel. Good cause appearing therefor, the court denies defendants' motion.

This action arises from plaintiff's allegations, contained in its complaint, that defendants have infringed six United States patents owned by plaintiff relating to chemical vapor deposition ("CVD") reactors and methods of using CVD reactors. Two of these six patents are the subject of this motion. These patents are U.S. Patent No. 4,047,496 ("the 496 patent") and U.S. Patent No. 4,081,313 ("the 313 patent"). The 496 is an apparatus patent and covers a CVD reactor. The 313 patent covers a method of processing wafers using a CVD reactor. The accused device is ASM's Epsilon One reactor, which is a CVD reactor for processing a single wafer at a time.

Defendants contend that plaintiff cannot sustain its burden of proof with respect to its claim that their product infringes the 496 and 313 patents because the claims of both patents require the processing of a plurality of wafers simultaneously. Defendants assert that their product processes only a single wafer at a time. Therefore, defendants assert that the Epsilon One reactor does not infringe the 496 and 313 patents.

Summary judgment of noninfringement is appropriate where the patent claims do not read on the accused product to establish literal infringement and the prosecution history precludes infringement under the

Doctrine of Equivalents. *Townsend Engineering Co. v. HiTec Co.*, 829 F.2d 1086, 1089 (Fed.Cir.1987); *Chemical Engineering Corp. v. Esfef Industries, Inc.*, 795 F.2d 1565, 1571-73 (Fed.Cir.1986). Determination of a patent infringement claim is a two-step process. The first step is interpreting the claims to determine their scope. The second step is determining whether the properly interpreted claims encompass the accused product. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1269-70 (Fed.Cir.1986). Infringement is found where every limitation of a patent claim is met by the accused product exactly or by a substantial equivalent. *Lemelson v. U.S.*, 752 F.2d 1538, 1551 (Fed.Cir.1985).

In order for an accused device to literally infringe a patent claim, the accused device must literally meet each limitation of that claim. *Hi-Life Products, Inc. v. American National Water-Mattress Corp.*, 842 F.2d 323, 325 (Fed.Cir.1988). Even if there is no literal infringement, however, infringement may be found under the Doctrine of Equivalents if an accused device performs substantially the same overall function, in substantially the same way, to obtain substantially the same overall result as the claimed invention. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed.Cir.1987).

The starting point of a claim interpretation analysis is the language of the claims themselves. *Intervet America, Inc. v. Kee-Vet Laboratories, Inc.*, 887 F.2d 1050, 1053-54 (Fed.Cir.1989). The first claim of the 496 patent provides, in part, for a "cool wall radiation heated reactor for effecting epitaxial and like chemical vapor deposition reactions therein on heated substrate *s* positioned therein and heated thereby" (emphasis added). The first claim of the 313 patent provides, in relevant part, for "(a) method for heating a *plurality of substrate members* ... said method comprising the steps of: ... heating the *substrate members* and the susceptor body directly and *simultaneously* in an unfocused, substantially uniform field of radiant heat energy...." (emphasis added).

Based upon the language contained in these claims, defendants contend that the Epsilon One does not and cannot literally infringe the 496 or the 313 patents because the Epsilon One reactor does not, and cannot, effect deposition on heated substrate *s*. Rather, the Epsilon One effects deposition on one heated substrate at a time, not upon several heated substrates simultaneously.

Plaintiff, on the other hand, contends that its patents do not require that deposition be effected upon more than one substrate *simultaneously*. Rather, plaintiff asserts that its patents cover a product, such as the Epsilon One, which effects deposition upon substrates, whether such deposition occurs serially, as in the Epsilon One, or simultaneously, as in plaintiff's products. Plaintiff contends that "simultaneously" refers to the simultaneous heating of the susceptor body and one or more substrates. The court does not believe the dispute as to the scope of the claims of plaintiff's patents can be resolved without consideration of extrinsic evidence.

"Construction of a claim, a question of law, is necessary to define the metes and bounds of the protection afforded by the claims. If the language of a claim is not disputed, then the scope of the claim may be constructed as a matter of law. [Citations omitted]. But when the meaning of a term in the claim is disputed and extrinsic evidence is necessary to explain that term, then an underlying factual question arises, and construction of the claim should be left to the trier or jury under appropriate instructions." *Palumbo v. Don-Joy Co.*, 762 F.2d 969, 974 (Fed.Cir.1985).

The court disagrees with defendants' contention that, as a matter of law, defendants' interpretation of the claims is the only reasonable one. A review of the specifications of the patents lend some support to plaintiff's position. The specification for the '496 patent refers to "one or more substrates" and the '313

specification uses both the words "substrate" and "substrates". The specifications, therefore arguably describe an apparatus or process that processes wafers either simultaneously or one at a time in serial fashion.

The prosecution history does not unequivocally support defendants' interpretation. Although defendants' view may ultimately prove to be the correct one, the court cannot determine as a matter of law that plaintiff gave up during prosecution the interpretation that it now places on its claims. The trier of fact must evaluate the prior art, the examiner's concerns, and what plaintiff did to distinguish the prior art references. Since material, factual issues exist with respect to the construction of the claims, summary judgment must be denied.

Even if the Epsilon One does not literally infringe plaintiff's patents, it does not necessarily follow that defendants are entitled to summary judgment. Infringement could be found under the Doctrine of Equivalents. *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931 (Fed.Cir.1987).

In this instance, however, defendants assert that plaintiff is estopped from relying upon the Doctrine of Equivalents to establish infringement based upon the Doctrine of Prosecution History Estoppel. The Doctrine of Prosecution History Estoppel limits a patentee's reliance on the Doctrine of Equivalents in litigation if that reliance would be inconsistent with amendments the patentee made before the Patent Office. *Townsend Engineering Co. v. HiTec Co.*, 829 F.2d 1086, 1090-91 (Fed.Cir.1987). The doctrine also applies to arguments submitted during prosecution to obtain the patent. *Coleco Industries, Inc. v. United States International Trade Commission*, 573 F.2d 1247, 1257-58 (C.C.P.A.1978).

Defendants contend that plaintiff submitted arguments and remarks to the Patent Office which clearly indicated that its patents referred to a method and apparatus whereby a plurality of substrates would be heated simultaneously and that defendants gave up any claim that its patents covered an apparatus or process that could only process one wafer at a time. The court does not find the prosecution history as clear as defendants contend. As mentioned earlier, the trier of fact must evaluate the prior art, the examiner's concerns, and what plaintiff did to distinguish the prior art references. The prosecution history and arguments submitted by plaintiff to the patent office, when viewed in context, do not unequivocally show that plaintiff dropped from its claims coverage of any apparatus or process that processes wafers serially in batches without human intervention. Further, as pointed out in *Read Corp. v. Portec, Inc.*, 970 F.2d 816, 824 (Fed.Cir.1992), which involved a somewhat different factual setting, "[e]very statement made by a patentee during prosecution to distinguish a prior art reference does not create a separate estoppel. Arguments must be viewed in context." A triable issue of material fact remains as to whether the Epsilon One infringes under the Doctrine of Equivalents.

N.D.Cal.,1992.

Applied Materials, Inc. v. Advanced Semiconductor Materials America, Inc.

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