

United States District Court,
S.D. New York.

BREHN CORPORATION, a New Jersey Corporation,
Plaintiff.

v.

TASC BV, A FOREIGN CORPORATION, I.C.D. Corporation and U.S. Chess Federation,
Defendants.

No. 95 CIV. 10746(RPP)

Sept. 23, 1997.

Brumbaugh, Graves, Donohue & Raymond, New York, NY, By Richard G. Berkley, Esq., Louis S. Sorell, Esq., Counsel for Plaintiffs.

Winick & Rich, New York, NY, By Terrence B. Berger, Esq., Counsel for Defendant TASC BV.

Schweitzer, Cornman & Gross, New York, NY, By Jay A. Blondell, Esq., Counsel for Defendant I.C.D. Corporation.

Lucas & Just, New York, NY, By David L. Just, Esq., Counsel for Defendant U.S. Chess Federation.

OPINION AND ORDER

PATTERSON, D.J.

Plaintiff moves for an order construing the meaning of the term "transmission lines" as used in United States Patent No. 5,129,654 (the "Patent"), a patent for an electronic game apparatus, in particular a chessboard and pieces. No opposition papers have been filed because the attorneys for TASC BV ("TASC") were relieved of their representation in view of irreconcilable disagreements with their counsel after the motion was filed, and, although defendant TASC had notice of this motion, no attorneys have entered an appearance in their stead, despite the fact that this case is scheduled for trial on October 27, 1997.

Patent claims are to be construed by the court based first on the intrinsic evidence alone, *i.e.*, the patent claims, the specification and the file history. *See* Vitronics Corp. v. Conceptoronic, Inc., 90 F.3d 1576, 1582-83 (Fed.Cir.1996); *see generally* Markman v. Westview Instruments, Inc., 517U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996) (describing the history of patent construction).

The patent in suit contains a total of twenty claims, three of which are independent claims (1, 18 and 19) and the remainder are dependent claims. The scope of each of the claims is to be construed so as to differentiate it from any other claim. *See* United States v. Teletronics, Inc., 857 F.2d 778, 783-84 (Fed.Cir.1988). Furthermore, it is improper to construe a claim by reading "into an independent claim a

limitation explicitly set forth in another claim ." *Environmental Designs, Ltd. v. Union Oil Co. of Cal.*, 713 F.2d 693, 699 (Fed.Cir.1983).

Plaintiff claims that defendant TASC's switchboard, an electronic chessboard, infringes independent claim 1 and dependent claim 11. At issue is whether the term "transmission lines" is limited to a structure which terminates in a characteristic matching resistance, a requirement of claim 15 which is dependent on claim 1. Under the doctrine of "claim differentiations" it is improper to interpret the term "transmission lines" in claims 1 and 11 in a way as to make them identical in scope to claim 15. *See id.* Accordingly, the requirement in claim 15 that "transmission lines are terminated in their characteristic impedance" cannot be read into claims 1 or 11 in which that language does not appear. Thus, "transmission lines" as used in claims 1 and 11 must be construed as encompassing electromagnetic energy conductive elements other than those which terminate in their characteristic impedance.

The Patent's specifications are consistent with this interpretation of "transmission lines" since those specifications define "transmission lines" as "an arrangement of conductive elements (in this case wires) capable of guiding an electromagnetic wave in a prescribed fashion with relatively small loss of signal strength." (Patent, Col. 6, lines 11-15.) That definition does not require the conductive elements (or wires) be terminated in their characteristic impedance.

Nor do the specifications state that to accomplish the functions of chess piece location and piece recognition performed by the transmission lines, it is a necessary element of plaintiff's patented chessboard for the transmission lines to terminate in a characteristic matching resistance. The specifications disclose that its preferred two wire form is utilized primarily to take advantage of the basic high isolation between orthogonally arranged sets of two-wire transmission lines and the effectiveness of transferring energy from one two-wire transmission line to an orthogonal transmission line in the presence of a playing piece containing a resonant circuit, (Patent, Col. 8, lines 25-31); and that although the preferred form of the patent utilizes terminations for the two-wire transmissions lines of a characteristic impedance to inhibit any energy incident on the termination from being reflected back to the source "any such reflection would have a negligible effect on the identification process." (Patent, Col. 11, lines 49-59.)

The Patent's use of matching terminal resistance for transmission lines is described throughout the specifications as a preferred or best mode element of the invention not as an essential element of the Patent, *e.g.*, Col. 6, Line 41-Col. 7, line 5; Col. 8, Lines 1-6 (transmission lines "preferably" of the two-wire type with a termination); Col. 8, Lines 15-18 (termination of the termination line "could be" a resistor with a value which matches the characteristic impedance); Col. 11, Lines 53-56 (terminations 46 "can be" resistors of value Z).

The prosecution history is consistent with this interpretation. In his amended filing the applicant described the transmission lines as "preferably" a pair of balanced two-wire elements that are matched in their characteristic impedance. *Cf.* Declaration of Richard G. Berkley dated August 8, 1997, Exh. 3 at p. 4.

Accordingly, the term "transmission lines" as used in the Patent means an arrangement of conductive elements (wires) capable of conducting electric magnetic energy in a prescribed fashion over the extent of a chessboard which does not require termination of the arrangement in its characteristic matching impedance.

IT IS SO ORDERED.

Dated: New York, New York

September 19, 1997

S.D.N.Y., 1997.

Brehn Corp. v. Tasc BV

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