

United States District Court,
D. Oregon.

SEIKO EPSON CORPORATION; Epson America, Inc.; Epson Portland, Inc,
Plaintiffs.

v.

**PRINT-RITE HOLDINGS, LTD.; Multi-Union Trading Co., Ltd.; Print-Rite Management Services
Co.; Dynamic Print USA, Inc.; and Does 1-10,**
Defendants.

No. CV 01-500-BR

March 3, 2005.

David Axelrod, Denise M. Graves, Schwabe, Williamson & Wyatt, P.C ., Portland, OR, Harold A. Barza, Steven M. Anderson, Quinn Emanuel Urquhart Oliver & Hedges, LLP, Los Angeles, CA, for Plaintiffs Seiko Epson Corporation; Epson America, Inc.; and Epson Portland, Inc. (hereinafter referred to collectively as Epson).

Randolph C. Foster, Steven T. Lovett, Stoel Rives, LLP, Portland, OR, Scott D. Baker, Morgan W Tovey, Doyle B. Johnson, Adaline J. Hilgard, Reed Smith Crosby Heafey, LLP, San Francisco, CA, for Defendants Multi-Union Trading Co., Ltd., and Dynamic Print USA, Inc. (hereinafter referred to collectively as Multi-Union). FN1

FN1. On March 28, 2002, this Court dismissed with prejudice Epson's claims against Defendants Print-Rite Holdings, Ltd., and Print-Rite Management Services Co.

OPINION AND ORDER

BROWN, J.

This matter comes before the Court on Epson's Motion for Summary Judgment (# 353) of Infringement of Utility Patents 5,158,377 ('377) and 5,622,439 ('439), Multi-Union's Cross-Motion for Summary Judgment (# 380) of Non-Infringement of Utility Patents '377 and '439, and Multi-Union's Motion for Summary Judgment (# 381) for Invalidity of Claim 83 of Utility Patent '377 and Claims 18 and 32 of Utility Patent '439.

In addition, Multi-Union filed Objections to Evidence in Opposition to Epson's Motion for Summary Judgment (# 387) and Objections to the Declaration of Expert Gerald Murch re Invalidity of Epson Patents (# 420). FN2

FN2. Also pending are a Joint Motion for Leave to File Additional Dispositive Motions (# 433) and Multi-Union's Motion to Strike Portions of the Expert Report and Disclosures of Gerald Murch (# 435) that do not specifically address the issues raised in the Motions for Summary Judgment now before the Court. The

Court will resolve those Motions at a Rule 16 conference to be held at 1:30 p.m. on Wednesday, March 9, 2005.

For the reasons that follow, the Court GRANTS Epson's Motion for Summary Judgment of Infringement of Claim 83 of Utility Patent '377 and Claims 18 and 32 of Utility Patent '439, DENIES Multi-Union's Cross-Motion for Summary Judgment of Non-Infringement of Claim 83 of Utility Patent '377 and Claims 18 and 32 of Utility Patent '439, and DENIES Multi-Union's Motion for Summary Judgment for Invalidity of Claim 83 of Utility Patent '377 and Claims 18 and 32 of Utility Patent '439.

BACKGROUND

1. Parties' Claims and Defenses.

Epson alleges Multi-Union manufactured and sold 26 models of ink cartridges that infringe 15 utility and 13 design patents issued to Epson. FN3 In their Motions for Summary Judgment, the parties address claims for infringement of two "Suzuki" utility patents: Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439. The "Suzuki" Patents are named after one of the inventors.

FN3. On August 13, 2004, Epson moved to amend its Claims Chart to include 41 additional lines of infringing cartridges. On September 16, 2004, the Court denied Epson's Motion.

Epson asserts the Claims at issue describe ink cartridges designed for use in dot matrix printers that include nonimpact ink jet printers. Epson argues Multi-Union's accused ink cartridges infringe each of the internal elements described in Epson's Claims. Multi-Union, however, contends its ink cartridges do not infringe Epson's patents at issue because Epson's Claims describe an ink-supply system designed for use with an impact ink dot wire matrix printer. Multi-Union argues its ink cartridges are designed for use with a "completely different" nonimpact ink jet printer system. Multi-Union also asserts Epson's Claims are invalid because they violate the written-description requirement and new-matter prohibition of 35 U.S.C. s.s. 112 and 132(a) respectively.

For purposes of these Motions, Epson submits as exhibits two types of ink cartridges manufactured by Epson and Multi-Union for comparative illustration of the issues: single-color ink cartridges that have one ink tank and multi-color ink cartridges that have five tanks. The parties agree the ink-cartridge exhibits are representative of Epson's ink cartridges described in the patents at issue and Multi-Union's accused ink cartridges.

2. Court's Construction of Epson's Patent Claims.

When construing a claim, the court determines the meaning and scope of the claims in a patent application. *Kemco Sales v. Control Papers Co.*, 208 F.3d 1352, 1359 (Fed.Cir.2000). On July 8, 2003, following a *Markman* hearing, the Court issued an order construing Claim 83 of '377 and Claims 18 and 32 of '439 in relevant part as follows:

1. The term "dot matrix printer" shall be construed as "any type of printer which causes a matrix of ink dots to be placed on an ink-receiving surface to form a character, figure, graphic image, or the like."

2. The term "dot matrix printer head" shall be construed as "the print head of any type of printer which causes a matrix of ink dots to be placed on an ink-receiving surface to form a character, figure, graphic image, or the like."

3. The term "ink jet type recording apparatus" shall be construed as a "printer that causes ink droplets to be sprayed or ejected onto an ink-receiving surface to form a character, figure, graphic image, or the like."

3. *Issues.*

The pending summary judgment motions raise the following issues: (1) whether Epson's Claim 83 for Utility Patent '377 and Claims 18 and 32 for Utility Patent '439 are valid, and (2) if so, whether Multi-Union's accused ink cartridges infringe those Claims.

EVIDENTIARY ISSUES

1. *Multi-Union's Objection to Evidence (# 387)*

Multi-Union objects to Epson's evidence pertaining to (1) nonaccused ink cartridges, (2) an allegedly faulty definition of "elongated member," and (3) the alleged lack of foundation regarding photographs of the accused ink cartridges.

As to nonaccused ink cartridges, the Court notes Epson's evidence pertains to the nonaccused cartridges included in Epson's Motion to Amend Claim Charts to Add New Lines of Infringing Cartridges and to Supplement the Complaint. The Court, however, denied Epson's Motion to Amend. Accordingly, the Court has not considered evidence pertaining to any nonaccused ink cartridges.

The Court overrules Multi-Union's objection to the admissibility of Epson's allegedly faulty definition of "elongated member." At the *Markman* hearing, the Court found the term "elongated member" required no construction. Whether Epson's definition of "elongated member" is faulty goes to the weight the Court gives to the evidence rather than to its admissibility.

Finally, the Court overrules Multi-Union's objection to the admissibility of photographs of the ink cartridges based on lack of foundation. The photographs are attached as an exhibit to the Declaration of Epson's attorney, William G. Berry, who asserts he has personal knowledge of what is depicted in the photographs. The Court, therefore, finds an adequate foundation has been laid for the admissibility of this evidence.

2. *Multi-Union's Objections to Declaration of Expert Gerald Murch, Ph.D., re Invalidity of Epson Patents (# 420).*

Expert Gerald Murch, Ph.D., submitted a Declaration on October 22, 2004, in support of Epson's opposition to Multi-Union's Motion for Summary Judgment re Invalidity of Claim 83 of the '377 Patent and Claims 18 and 32 of the '439 Patent in which he opined those Claims would be applicable to ink jet printer art.

Multi-Union objects to Dr. Murch's opinion on the grounds that (1) it lacks foundation because Dr. Murch did not review the prior art that existed before 1984 when he rendered his opinion and (2) Dr. Murch's October 2004 opinion contradicts his prior deposition testimony of March 28, 2003, in which he opined the 1984 Suzuki Patents did not describe a functioning ink jet cartridge.

a. *Dr. Murch's Expert Qualifications.*

Dr. Murch has a doctoral degree in Natural Sciences with dual majors in Physics and Psychophysics. Dr. Murch was a Professor of Physics and Psychophysics at Portland State University until 1980 when he left to become Chief Scientist at Tektronix. In 1990 he became Senior Director of Apple Computer's Printing Image Division. In 1994 Dr. Murch led Xerox's Ink Jet Business Unit and was responsible for the technical design, development, and manufacturing of Xerox's ink jet technology. In addition, Dr. Murch asserts he is "readily familiar" with the prior art.

Epson asserts, and this Court agrees, Dr. Murch's education, training, and work experience qualify him to offer expert testimony regarding the use of impact ink cartridge applications with ink jet printers. In addition, the Court finds Epson has presented sufficient evidence to establish Dr. Murch's qualifications to render an expert opinion in this matter. Finally, the Court finds Dr. Murch's failure to review the prior art specifically in connection with this litigation does not render his opinion unreliable.

The Court, therefore, overrules Multi-Union's objection to Dr. Murch's testimony for lack of foundation.

b. *Dr. Murch's Prior Deposition Testimony.*

Multi-Union asserts Dr. Murch's opinion in his October 2004 Declaration that the Suzuki Patents apply to ink jet printer art is inconsistent with and contradicted by Dr. Murch's prior deposition testimony in March 2003 in which he stated that additional elements would be necessary for the ink cartridge described in the Suzuki Patents to function well in an ink jet printer. According to Multi-Union, Dr. Murch's prior deposition testimony does not support Epson's argument that the Suzuki Patents describe an ink cartridge system for use with ink jet printers.

Here Dr. Murch's opinion is limited to the elements of Epson's Suzuki Claims; *i.e.*, an ink-absorbing member that substantially fills the ink-supply tank and projections on the inside walls of the ink-supply tank that provide a space for air in addition to pushing and compressing the sponge towards an elongated member that receives and transmits ink towards the supply port for delivery to the printer. Dr. Murch concludes these elements are compatible with ink jet printers even though additional elements such as a robust sealing, an ink-supply guide, and a system using gravity to transfer the ink from the ink-supply tank of the ink cartridge to the printer would be necessary to allow the ink cartridge to function well with an ink jet printer.

The Court finds Dr. Murch's opinion regarding those elements that are present in the Suzuki Patents is not inconsistent with or contradicted by his opinion that additional elements may be necessary to provide an effective ink-delivery system to ink jet printers. The Court also finds Dr. Murch's opinion is not inconsistent with the claim construction adopted by the Court that the elements of Epson's ink cartridges found in Claim 83 of '377 and Claims 18 and 32 of '439 are applicable to "dot matrix printers" that include ink jet printers. Finally, the court concludes Multi-Union's objection to Dr. Murch's Declaration actually seeks to address the heart and substance of Multi-Union's defense of noninfringement; *i.e.*, that Epson's Suzuki Patents '371 and '439 do not describe, either expressly or inherently, an ink cartridge system for use with ink jet printers and, in fact, "teaches away" from use in an ink jet system. The Court considers the merits of that defense in its discussion of the parties' summary judgment motions and responses. Accordingly, the Court overrules Multi-Union's objections to Dr. Murch's Declaration.

1. Summary Judgment.

Fed.R.Civ.P. 56(c) authorizes summary judgment if no genuine issue exists regarding any material fact and the moving party is entitled to judgment as a matter of law. The moving party must show the absence of an issue of material fact. *Leisek v. Brightwood Corp.*, 278 F.3d 895, 898 (9th Cir.2002). In response to a properly supported motion for summary judgment, the nonmoving party must go beyond the pleadings and show there is a genuine issue of material fact for trial. *Id.*

An issue of fact is genuine " 'if the evidence is such that a reasonable jury could return a verdict for the nonmoving party.' " *Villiarmo v. Aloha Island Air, Inc.*, 281 F.3d 1054, 1061 (9th Cir.2002) (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). The court must draw all reasonable inferences in favor of the nonmoving party. *Id.* A mere disagreement about a material issue of fact, however, does not preclude summary judgment. *Jackson v. Bank of Haw.*, 902 F.2d 1385, 1389 (9th Cir.1990). When the nonmoving party's claims are factually implausible, that party must come forward with more persuasive evidence than otherwise would be required. *Blue Ridge Ins. Co. v. Stanewich*, 142 F.3d 1145, 1147 (9th Cir.1998) (citation omitted).

The substantive law governing a claim or a defense determines whether a fact is material. *Addisu v. Fred Meyer, Inc.*, 198 F.3d 1130, 1134 (9th Cir.2000). If the resolution of a factual dispute would not affect the outcome of the claim, the court may grant summary judgment. *Arpin v. Santa Clara Valley Transp. Agency*, 261 F.3d 912, 919 (9th Cir.2001).

2. Patent Infringement.

A device or process can infringe a patent literally or under the doctrine of equivalents. *See Amhil Enter., Ltd. v. Wawa, Inc.*, 81 F.3d 1554, 1562-63 (Fed.Cir.1996). A patent holder has the right to "exclude others from making, using, offering for sale, or selling the invention throughout the United States or importing the invention into the United States." 35 U.S.C. s. 154(a)(1). A party infringes the patent if, "without authority," it "makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent." 35 U.S.C. s. 271(a).

The boundaries of an invention are defined by patent claims contained in a "specification." 35 U.S.C. s. 112. The specification must "conclude with one or more claims particularly pointing out or distinctly claiming the subject matter which the applicant regards as his invention." *Id.*

Claims may be written in independent or dependent form. *Id.* A dependent claim "shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed" and "shall be construed to incorporate by reference all the limitations of the claim to which it refers." *Id.* Ordinarily "if an accused infringer does not infringe an independent claim, it cannot infringe claims that depend on that independent claim." *Streamfeeder, LLC v. Sure-Feed Sys., Inc.*, 175 F.3d 974, 984 (Fed.Cir.1999) (citation omitted).

An infringement analysis requires two distinct steps: (1) "[T]he court determines the scope and meaning of the patent claims asserted" through claim construction and (2) "then the properly construed claims are compared to the allegedly infringing device." *Cybor Corp. v. FAS Tech., Inc.*, 138 F.3d 1448, 1454 (Fed.Cir.1998) (citations omitted).

Whether infringement has occurred is ordinarily a question of fact for literal infringement and infringement under the doctrine of equivalents. *Instituform Tech., Inc. v. Cat Contracting, Inc.*, 161 F.3d 688, 692 (Fed. Cir.1998), *cert. denied*, 526 U.S. 1018 (1999).

3. Literal Infringement.

Literal infringement of a claim exists "when every limitation recited in the claim is found in the accused device." *Enercom GmbH v. Int'l Trade Comm'n*, 151 F.3d 1376, 1385 (Fed.Cir.1998), *cert. denied*, 526 U.S. 1130, *reh'g denied*, 527 U.S. 1054 (1999) (citation omitted).

4. Infringement under the Doctrine of Equivalents.

If the accused device does not literally infringe, it may infringe under the doctrine of equivalents if each limitation of the claim is met in the accused device. *Cybor Corp.*, 138 F.3d at 1459-60 (citations omitted). An element in the accused product is equivalent to a claim limitation if the difference between the two is insubstantial to one of ordinary skill in the art. *DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1331-32 (Fed.Cir.2001) (citations omitted). To evaluate the doctrine of equivalents, "the following test is often used: if the 'function, way, or result' of the assertedly substitute structure is substantially different from that described by the claim limitation, equivalence is not established." *Odetics, Inc. v. Storage Tech. Corp.*, 185 F.3d 1259, 1267 ((Fed.Cir.1999) (citations omitted).

5. Noninfringement under the Reverse Doctrine of Equivalents.

"Under the reverse doctrine of equivalents, an accused product or process that falls within the literal words of a claim nevertheless may not infringe if the product or process 'is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way.'" ' *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1352 (Fed.Cir.2003). The "doctrine is equitably applied based upon underlying questions of fact when the accused infringer proves that, despite the asserted claims literally reading on the accused device, 'it has been so changed it is no longer the same invention.'" ' *Id.* (citation omitted).

6. "Written-Description" Requirement.

A specification in an application for a patent must contain "a written description of the invention, and of the manner and process of making and using it...." 35 U.S.C. s. 112. Although the specification "does not have to describe exactly the subject matter claimed, ... the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63 (Fed.Cir.1991) (citations omitted). "[T]he test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" ' *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed.Cir.1985) (citations omitted). Compliance with the written-description requirement of s. 112 is a question of fact. *Vas-Cath*, 935 Fed. Cir. at 1563.

7. "New-Matter" Prohibition.

"[N]o amendment [to a previously rejected patent application] shall introduce new matter into the disclosure of the invention." 35 U.S.C. s. 132(a). For purposes of determining whether a patent applicant is improperly introducing "new matter" into an application by way of an amendment or continuing application, new matter

consists of a departure from or addition to an original disclosure. *Stearn v. Superior Distrib. Co.*, 674 F.2d 539 (6th Cir.1982).

The fundamental inquiry is whether the material added by amendment was inherently contained in the original application. *See Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1438 (Fed.Cir.1984). Accordingly, the new-matter prohibition is closely related to the adequate disclosure requirements of 35 U.S.C. s. 112. *See Pennwalt Corp. v. Akzona Inc.*, 740 F.2d 1573, 1578, (Fed.Cir.1984). Thus, to avoid the new-matter prohibition, an applicant must show its original application supports the amended matter. *See Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1539 (Fed.Cir.1997).

EPSON'S MOTION FOR SUMMARY JUDGMENT AS TO MULTI-UNION'S ALLEGED INFRINGEMENT OF UTILITY PATENTS '377 AND '439

Epson alleges Multi-Union's 26 accused ink cartridges literally infringe the elements described in Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439.

1. Claim 83 of the '377 Patent-Literal Infringement.

The preamble to Claim 83 describes the '377 Patent as "[a]n ink supply system for a dot matrix printer." The Claim describes three elements:

[1] [A]n ink-supply tank system formed with an ink-supply delivery port having an opening for the passage of ink from said ink-supply tank; [2] an ink absorbing member formed of a porous material mounted within said tank, said ink absorbing member having a region facing said opening and being compressingly contained by the ink-supply tank against the ink-supply delivery port so that at least the region of the ink absorbing member facing said opening is compressed relative to at least another region of the ink absorbing member; and [3] said ink absorbing member substantially filling said ink-supply tank, said ink-supply tank including an inner wall surface having projections to provide a space between said ink absorbing member and said wall surface.

Based on the Court's construction and his opinion that a printer that "causes a matrix of ink dots ... includes ink jet printers," Dr. Murch opines Multi-Union's 26 accused ink cartridges infringe each of the three elements described in Claim 83.

In any event, Multi-Union concedes its 26 accused ink cartridges literally contain the three elements described in Claim 83. Based on Dr. Murch's opinion and the Court's visual comparison of Epson's ink cartridges and Multi-Union's accused ink cartridges, the Court concludes no genuine issue of material fact exists as to whether Multi-Union's accused ink cartridges literally infringe Claim 83 of Epson's '377 Patent.

Accordingly, the Court holds Multi-Union's accused ink cartridges literally infringe Claim 83 of the '377 Patent.

2. Claim 18 of the '439 Patent-Literal Infringement.

Claim 18 of the '439 Patent has the same preamble as Claim 83 of the '377 Patent. The Claim describes three elements:

[1] [A]n ink-supply tank having a first and a second wall extending substantially in a perpendicular

direction to said first wall, said first wall having a length as viewed in a direction therealong extending from said second wall; [2] an ink absorbing member mounted within the ink-supply tank; and [3] an ink receiving and transmitting member comprising an elongated member extending from said first wall into the interior of said tank at a position between the midpoint of said length of said first wall and said second wall, said elongated member being formed with an opening at the distal end thereof and with a passage extending longitudinally therealong from said opening along the length of said elongated member defining at least said opening and a portion of said passage being defined by a non-porous material, said elongated member engaging a portion of said ink absorbing member at least in the region of said ink absorbing member facing said opening.

Dr. Murch opines Multi-Union's accused ink cartridges literally infringe each of the three elements described in Claim 18. Although Multi-Union concedes its accused ink cartridges literally infringe the first two elements of Claim 18, Multi-Union asserts its accused ink cartridges do not literally infringe the third element of Claim 18 because the elongated member described in Claim 18 also includes "an arm-like structure ... that connects into the ink supply port ... of the ink tank and has grooves ... for capillary action."

At the *Markman* hearing, Multi-Union urged a construction that Claim 18 does not pertain to a dot matrix printer that includes an ink jet printer. Multi-Union, however, acknowledges this Court did not construe the third element of Claim 18 to have the features described by Multi-Union. As noted, in its claims construction following the *Markman* hearing, the Court found the term "elongated member" "requires no construction." Nevertheless, Multi-Union invites this Court to revisit its construction of the preamble to Claim 18 and to conclude Claim 18 does not pertain to ink jet printers. Multi-Union, however, has not offered any new argument in support of its construction. The Court, therefore, declines to reconsider its *Markman* rulings.

The Court, therefore, concludes no genuine issue of material fact exists as to whether Multi-Union's accused ink cartridges literally infringe Claim 18 of Epson's '439 Patent. Accordingly, the Court holds Multi-Union's accused ink cartridges literally infringe Claim 18 of the '439 Patent.

3. Claim 32 of the '439 Patent-Literal Infringement.

Claim 32 of the '439 Patent has the same preamble as Claims 18 and 83 of the '377 Patent. The Claim describes the following element:

The ink-supply tank claim of 31, wherein said further wall of said ink-supply tank facing said elongated member is a cover bearing on said ink absorbing member when assembled to said ink-supply tank to at least in part apply a compressive force to affect compression of said ink absorbing member, at least a portion of said projections extending from the inner wall surface of said cover.

The validity of Claim 32 depends on the validity of Claim 18. Again, Multi-Union relies on its proposed reconstruction of the term "elongated member" in Claim 18 to support its contention that its accused ink cartridges do not literally infringe Claim 32. Because the Court rejects Multi-Union's requested reconstruction of Claim 18, the Court finds no genuine issue of material fact exists as to whether Multi-Union's accused ink cartridges literally infringe Claim 32 of Epson's '439 Patent.

Accordingly, the Court holds Multi-Union's accused ink cartridges literally infringe Claim 32 of the '439 Patent.

MULTI-UNION'S CROSS-MOTION FOR PARTIAL SUMMARY JUDGMENT AS TO NONINFRINGEMENT

Even if its accused ink cartridges literally infringe Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439, Multi-Union asserts it is entitled to partial summary judgment as to noninfringement based on the "Reverse Doctrine of Equivalents" defense. Multi-Union argues application of the doctrine is appropriate because Multi-Union's accused ink cartridges are "so far changed in principle that [they] perform[] the same or similar function in a substantially different way." Multi-Union's argument is based on its overarching contention that its ink cartridges are intended to function as an "ink jet delivery system for use with nonimpact ink jet printers" and, in contrast, Epson's ink cartridges as described in Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439 are intended to function as an "ink-supply system for use with impact ink wire dot matrix printers."

The "substantially different operation" between Epson's ink cartridges and Multi-Union's accused ink cartridges pertains to the manner in which ink is delivered to the printer from the elongated member in the ink-tank systems of both Epson and Multi-Union's ink cartridges. Epson's ink cartridges rely on a capillary action to deliver ink from the ink tank to the printer; *i.e.*, ink is supplied via such capillary action from the elongated member to the distal ends of a wire from which the ink impacts on the printer paper. In contrast, Multi-Union's ink cartridges rely on a piezoelectric system; *i.e.*, a nonwire delivery system to transport ink from the elongated member in the ink tank to the printer.

Initially, Epson points out that the capillary method of delivering ink from its ink cartridges to printers is not described in either Claim 18 or Claim 32 of Patent '439 and, therefore, is not covered by that patent. In addition, Epson argues Multi-Union relies on other features not found in Claims 18 and 32 (such as a sturdy seal to prevent air bubbles and hydrodynamics relating to the drop rate and viscosity of the ink used by Multi-Union in the accused ink cartridges) to establish noninfringement based on the substantially different operation of the parties' ink cartridges.

The Court notes the Federal Circuit has never affirmed a defense of noninfringement based on the Reverse Doctrine of Equivalents and, in addition, has referred to the doctrine as an "anachronistic exception, long mentioned, but rarely applied." *Tate Access Floors, Inc. v. Interface Architectural Res., Inc.*, 279 F.3d 1357, 1368 (Fed.Cir.2002). Moreover, the doctrine applies only when a product "precisely described in a patent claim" is so far changed in principle that it performs in a substantially different way. *SRI Int'l v. Matsushita Elec. Corp. of Am.*, 775 F.2d 1107, 1123 (Fed.Cir.1985). "One who takes a claimed structure and merely uses it in a way that differs from that in which a specification-described embodiment uses it, does not thereby escape infringement." *Id.*

Here, as noted, Epson's invention as described in Claim 83 of '377 and Claims 18 and 32 of '439 pertains to the ink-tank structure and the ink-supply system to the delivery port rather than the ink-delivery system from the ink tank to the printer. To establish noninfringement, Multi-Union depends on additional features not described in Epson's Claims. The addition of features, however, does not avoid infringement if all the elements of the patent claim have been adopted. *N. Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 945 (Fed.Cir.1990).

For these reasons, the Court concludes the Reverse Doctrine of Equivalents is not a defense to Multi-Union's literal infringement as to Claims 18 and 32 of Epson's Patent '439.

MULTI-UNION'S MOTION FOR SUMMARY JUDGMENT AS TO THE INVALIDITY OF EPSON'S CLAIMS

1. Violation of Written-Description Requirement.

Multi-Union asserts Epson's preambles to Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439 do not adequately define an ink-supply tank for a dot matrix printer that includes ink jet printers because the specific description of the Claims fails to describe ink cartridges suitable for use with ink jet printers. In addition, Multi-Union argues the ink cartridges described in those Claims could not be used in such printers. Accordingly, Multi-Union contends Epson's 1984 Suzuki Patents based on those Claims are invalid because a person of ordinary skill in the art would not conclude Epson had possession of an invention that included ink cartridges with an ink-tank system "and its interface to a print head" appropriate for use in nonimpact ink jet printers. *See* 35 U.S.C. s. 112.

Epson responds that Claim 83 of Patent '377 and Claims 18 and 32 of Patents '439 adequately describe and fully support claims for ink-tank systems intended for use in dot matrix printers, including both impact wire ink dot matrix printers and nonimpact ink jet printers. Epson also points out Multi-Union employs the same elements specifically described in those Claims in its accused ink cartridges, and those ink cartridges are used with nonimpact ink jet printers. In addition, Epson asserts the scope of the Claims at issue and, therefore, the description of the patented invention Epson possesses through those Claims, does not address print heads or a delivery system designed specifically for use with nonimpact ink jet printers. Epson, however, asserts the Claims adequately describe the invention of an ink-tank system for an ink cartridge used with dot matrix printers including both impact ink wire dot printers and nonimpact ink jet printers.

In support of its position, Epson relies on the testimony of Dr. Murch, who opines Epson's Claims are applicable to ink jet printer art:

Based on my analysis ..., the specification of the 1984 patent [Suzuki] application conveys to one of ordinary skill in the art that the inventors were in possession of an ink-supply system and ink-supply tank for dot-matrix printers and ink jet printers. It is my opinion that the specification clearly conveys to a person of ordinary skill in 1984 that the inventors were in possession of the inventions claimed in Claim 83 of the '377 Patent and Claims 18 and 32 of the '439 Patent.

Pls.' Mem. in Opp'n, Murch Decl. at 10.

The Court agrees with Epson that the preamble language and the written descriptions in Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439 filed by Epson with the United States Patent and Trademark Office in 1984 describe fully, clearly, and concisely what a person skilled in the art would understand to be the invention of an ink cartridge tank supply system intended for use in dot matrix printers, and these Claims do not include the invention of a delivery system for effectively transporting the ink from the ink-tank delivery port to a nonimpact ink jet printer.

Accordingly, the Court concludes Multi-Union is not entitled to summary judgment that Epson's Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439 are invalid based on the written-description requirement of 35 U.S.C. s. 112.

2. Violation of the New Matter Provision.

Beginning in 1990 and continuing thereafter, Epson filed with the Patent Office a series of continuation and divisional applications FN4 for the 1984 Suzuki Patents attempting to broaden the scope of the Epson's patent claims explicitly to include ink cartridges that provide an ink-delivery system for use with nonimpact jet printers as well as other types of printers. Multi-Union argues Epson's 1990 and subsequent continuation and divisional applications for the Suzuki Patents are invalid because they improperly included new matter in violation of 35 U.S.C. s. 132(a).

FN4. In a continuation application, the specification is the same as that of the parent application, but the claims may be the same or different from those of the parent application. A divisional application is a continuation application with the same specification but different claims.

As noted, the new-matter prohibition is closely related to and is a corollary of the written-description requirement in that the claims in the original application must support any continuing and divisional applications. *Kolmes*, 107 F.3d at 1539. Multi-Union maintains the written descriptions in the Claims setting forth Epson's inventions in the 1984 Suzuki Patents "teach away" from an ink-delivery system for use with nonimpact ink jet printers. Accordingly, Epson's continuing and divisional applications, in which Epson attempts to broaden the scope of those patents to include an ink-delivery system to be used with nonimpact ink jet printers that is not inherently found in the original applications, contain new matter. *Litton Sys., Inc.*, 728 F.2d at 1438.

According to Epson, however, its 1990 continuation and divisional applications, which were filed with the Patent Office in 1990 and thereafter, broadened the scope of the inventions inherently contained in the 1984 Suzuki Patents. Epson described the intended use of one of its Amendments set forth in a continuing application pertaining to the '377 Patent as follows:

The claims presented by the accompanying Preliminary Amendment are specifically directed to the ink supply system taught in the application as filed, and to dot matrix printers formed therefrom, as well as the method of delivering ink to a dot matrix printer. The claims are specifically directed to the compression of the ink absorbing member in the vicinity of the ink supply delivery port (also referred to in the claims as the ink receiving and transmitting means). This compression serves to provide a gradation in pore size with smaller pores in the vicinity of the exit to the tank (the above mentioned port or means) so that the ink will tend to gravitate to the exit by increased capillary force in the compressed region, leading to efficient and relatively complete ink delivery, as taught in the specification.

Unlike the claims of the parent applications, the claims of this application are not limited to a wire dot matrix printer.

Pls.' Mem. in Opp'n, Graves Decl., Ex. 5 at 3. The Patent Office accepted Epson's continuation and divisional applications.

During the *Markman* claims construction hearings in May 2003, this Court did not construe the original 1984 utility patent claims as describing ink cartridges that provide ink-delivery systems for nonimpact ink jet printers. The Court, however, concluded Epson's subsequent continuation and divisional applications for those patents did describe such ink-delivery systems. During the course of the *Markman* hearing on May 22, 2003, the Court noted the effect of Epson's continuation and divisional patents, and construed the preamble

to Claims 83 of Patent '377 and Claims 18 and 32 of Patent '439 as describing a "dot matrix printer" that included nonimpact ink jet printers:

The claims, however, as modified after the divisional process no longer contain any limitation that's explicit when referring to a dot matrix printer as only a wire dot matrix printer. *It seems to me inescapable, then, to conclude that the patent examiner that allowed the change was permitting explicitly a broadening of what was being claimed.* The broadening no longer, then, limited the larger meaning of dot matrix printer to a wire dot matrix printer. It eliminated that limitation.

Tr. 161-62 (emphasis added).

The Court adheres to this analysis and agrees with Epson's assertion that the continuation and divisional applications did not contain new matter because they merely broadened the scope of the Suzuki Patents as embodied in Claim 83 of Patent '77 and Claims 18 and 32 of Patent '439 to include all dot matrix printers, including impact ink wire dot printers and nonimpact ink jet printers. Indeed, the Court finds Epson's continuation and divisional applications in fact were based on the original 1984 Suzuki Patents, including Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439.

Accordingly, the Court concludes Multi-Union is not entitled to summary judgment that the continuation and divisional applications as to Epson's Claim 83 of Patent '377 and Claims 18 and 32 of Patent '439 are invalid based on the new-matter prohibition set forth in 35 U.S.C. s. 132(a).

CONCLUSION

For these reasons, the Court GRANTS Epson's Motion for Summary Judgment (# 353) of Infringement of Claim 83 of Utility Patent '377 and Claims 18 and 32 of Utility Patent '439, DENIES Multi-Union's Cross-Motion for Summary Judgment (# 380) of Non-Infringement of Claim 83 of Utility Patent '377 and Claims 18 and 32 of Utility Patent '439, and DENIES Multi-Union's Motion for Summary Judgment (# 381) for Invalidity of Claim 83 of Utility Patent '377 and Claims 18 and 32 of Utility Patent '439.

IT IS SO ORDERED.

D.Or.,2005.

Seiko Epson Corp. v. Print-Rite Holdings, Ltd.

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