

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

TULIP COMPUTERS)	
INTERNATIONAL B.V.)	
Plaintiff)	
)	
v.)	Civil Action No. 00-981-###
)	
DELL COMPUTER CORPORATION,)	
Defendant)	
)	

MEMORANDUM OPINION

Steven J. Balick, Esquire and John G. Day, Esquire, Ashby & Geddes, Wilmington, Delaware.

Of Counsel: Dirk D. Thomas, Esquire, Robert A. Auchter, Esquire, William A. Marino, Esquire, and Marc N. Henshke, Esquire, Robins, Kaplan, Miller & Ciresi, L.L.P. Washington, D.C.; counsel plaintiff Tulip Computers International B.V.

Frederick L. Cottrell, III, Esquire and Chad M. Shandler, Esquire, Richards, Layton & Finger, Wilmington, Delaware.

Of Counsel: Scott F. Partridge, Esquire, Howard L. Speight, Esquire, and Maria Wyckoff Boyce, Esquire, Baker Botts L.L.P., Houston, Texas; counsel for defendant Dell Computer Corporation.

Wilmington, Delaware
December 12, 2002

Thynge, U.S. Magistrate Judge

I. INTRODUCTION

This is a patent infringement case. On November 24, 2000, Tulip Computers International B.V. (“Tulip”)¹ filed its complaint (D.I. 1) alleging infringement of its U.S. patent No. 5,594,621 (“the ‘621 patent”) by specific systems in defendant Dell Computer Corporation’s (“Dell”)² OptiPlex line of computers. On January 19, 2001, Dell filed its answer (D.I. 6) denying Tulip’s allegations and alleging that the ‘621 patent is invalid, unenforceable, and not infringed. On August 15, 2002, this court entered an amended scheduling order (D.I. 281) pursuant to which the parties filed a joint submission of disputed claim terms on September 20, 2002 (D.I. 308). Simultaneous briefing on the parties’ respective claim interpretations was completed on October 25, 2002. Case dispositive pretrial summary judgment motions were filed on October 11, 2002³ and briefing on those motions was completed on November 1, 2002. Pursuant to *Markman v. Westview Instruments, Inc.*⁴ and local practice, oral argument was held November 7, 2002 on the parties’ claim interpretations and motions for summary judgment. On December 9, 2002 this court issued its opinion construing the disputed claim terms (D.I. 411).

In support of its motion for partial summary judgment of validity under 35 U.S.C. § 112 (D.I. 336), Tulip argues that it is entitled to a grant of summary judgment that claims

¹ Tulip is a Dutch corporation with its principal place of business in the Netherlands.

² Dell is a Delaware corporation with its principal place of business in Texas.

³ Tulip’s motion for partial summary judgment of validity under 35 U.S.C. § 112 (D.I. 336), Tulip’s motion for partial summary judgment of literal infringement (D.I. 338), Tulip’s motion for partial summary judgment of no inequitable conduct (D.I. 341), Dell’s motion for partial summary judgment on failure to mark and noninfringement (D.I. 344), Dell’s motion for summary judgment of unenforceability due to inequitable conduct (D.I. 347), and Dell’s motion for summary judgment on invalidity (D.I. 350).

⁴ 52 F.3d 967 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

1 and 2 of the '621 patent satisfy the requirements of 35 U.S.C. § 112, ¶ 2 and are not invalid. This is the court's determination of that motion.

II. POSITIONS OF THE PARTIES

The '621 patent, entitled "Motherboard for a Computer of the AT Type, and a Computer of the AT Type Comprising Such Motherboard," describes and claims a personal computer having a novel motherboard form factor.⁵ The invention concerns the placement of a riser card connector at a specific location on a motherboard and the arrangement of expansion board connectors on a riser card to achieve certain purported benefits recited in the patent specification. The claims at issue in this litigation, claims 1 and 2 of the '621 patent, each recite identical references to the location of the connector for receiving the riser card as being "adjacent and parallel to a peripheral side edge"⁶ of a computer's motherboard.

Not having the benefit of the court's claim construction when briefing their respective positions on Tulip's motion for partial summary judgment regarding the definiteness of the phrase "peripheral side edge," the parties reiterate many of the arguments made in support of their competing claim constructions when presenting their respective positions on this motion. Due to the court's determination of the effect of its claim construction opinion on the question of definiteness, the parties' competing positions are not discussed in detail.

Dell argues that the phrase "peripheral side edge" is ambiguous and does not adequately inform the public of the scope of the claimed invention. Dell notes that the

⁵ The term "form factor" refers to the shape and configuration of the components on a motherboard. See D.I. 411 for the court's construction of disputed claim terms and a more extensive discussion of the background of the technology and the patented invention that is the subject of this litigation.

⁶ '621 at 5:67-6:1 (claim 1); *Id.* at 6:39-40 (claim 2).

phrase “peripheral side edge” was not recited in the ‘621 patent application as filed. That phrase was included in new claims added by an amendment to the ‘621 patent application which replaced originally filed claims cancelled by the applicant after an obviousness rejection by the patent examiner. Dell maintains that the prosecution history does not help to definitely define the phrase “peripheral side edge” as the phrase is not used anywhere other than the amended claims (claims 1 and 2 as issued) and was not defined or discussed by the applicant in connection with the amendment adding those claims. Dell also points out that the ‘621 patent specification never uses “peripheral side edge” to describe the patent drawings. Dell argues that even if the drawings are themselves adequate to inform one skilled in the art that the particular embodiments depicted in the drawings are covered by Tulip’s patent, the bounds of the claimed invention would still be uncertain and, therefore, claims 1 and 2 fail to satisfy the requirements of 35 U.S.C. § 112 ¶ 2.⁷

Tulip states that a fundamental tenet of patent law is that claims should be construed to uphold their validity and urges this court to so construe the ‘621 patent claims at issue in this case. Tulip contends that a definite meaning of the phrase “peripheral side edge” may be understood by combining the ordinary meanings of the individual words of that phrase as suggested in its *Markman* briefing. Tulip responds to Dell’s comment that the phrase “peripheral side edge” is not recited in the ‘621 patent specification by arguing that

⁷ See *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., LTD.*, 122 S.Ct. 1831, 1937, 535 US 722, 152 L.Ed.2d 944 (2002) (“A patent holder should know what he owns, and the public should know what he does not. For this reason, the patent laws require inventors to describe their work in ‘full, clear, concise, and exact terms,’ 35 U.S.C. § 112, as part of the delicate balance the law attempts to maintain between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor’s exclusive rights.” (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989))).

history provides additional definiteness to the phrase “peripheral side edge” as the applicant noted that disadvantages of prior art were purportedly avoided “[b]y virtue of locating riser card 23 to the side of motherboard 21.”¹¹ By consulting the relevant portions of the intrinsic record, Tulip argues, the scope of the invention claimed in claims 1 and 2 of the ‘621 patent would be understood by one of ordinary skill in the art at the time the patent issued and, therefore, the phrase “peripheral side edge” does not make those claims indefinite.

III. STANDARD OF REVIEW

A grant of summary judgment pursuant to Fed. R. Civ. P. 56(c) is appropriate “if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.”¹² A Rule 56(c) movant bears the burden of establishing the lack of a genuinely disputed material fact by demonstrating “that there is an absence of evidence to support the nonmoving party’s case.”¹³ The nonmovant must be given the benefit of all justifiable inferences and the court must resolve any disputed issue of fact in favor of the nonmovant.¹⁴

IV. ANALYSIS

The second paragraph of 35 U.S.C. § 112 requires a patent’s claims to “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” This is the so-called “definiteness” requirement. In considering whether a

¹¹ D.I. 383 at 21 (Amendment to ‘621 patent application).

¹² Fed. R. Civ. Pro. 56(c).

¹³ *Celotex Corp. v. Catrett*, 477 U.S. 317, 325, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986).

¹⁴ *Eastman Kodak Co. v. Image Technical Servs., Inc.*, 504 U.S. 451, 456, 112 S.Ct. 2072, 119 L.Ed.2d 265 (1992).

patent claim meets this requirement, the court must determine “whether one skilled in the art would understand the bounds of the claim when read in light of the specification. . . . If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.”¹⁵ When construing disputed patent terms, “the focus is on the objective test of what one of ordinary skill in the art at the time of the invention would have understood the term to mean.”¹⁶ The court’s ability to make that determination answers the question of indefiniteness as to a particular disputed claim term. If the court is able to make a determination of the proper construction of a disputed term by reading the claim in light of the specification, the claim cannot be indefinite solely because of the disputed term. This is true because the court’s construction necessarily represents the court’s legal determination of what one of ordinary skill in the art at the time of the invention would have understood that term to mean.¹⁷

Because this court was able to construe the phrase “peripheral side edge” as meaning “the border of the motherboard which is not the front or rear of the motherboard,”¹⁸ that meaning is, as a matter of law, what the court determines one of ordinary skill in the art would have understood the disputed phrase to mean. Contrary to Dell’s argument, the phrase “peripheral side edge” is not analogous to the phrase “a specific activity of at least about 160,000 IU” discussed in *Amgen, Inc. v. Chugai Pharm. Co.*¹⁹

¹⁵ *Personalized Media Communications, LLC v. International Trade Comm’n*, 161 F.3d 696, 705 (Fed. Cir. 1998) (quoting *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 USPQ 2d 1123, 1126 (Fed. Cir. 1993)).

¹⁶ *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 986 (Fed. Cir. 1995) (*en banc*), *aff’d*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

¹⁷ See *Personalized Media*, 161 F.3d at 705 (stating that “[a] determination of claim indefiniteness is a legal conclusion that is drawn from the court’s performance of its duty as the construer of patent claims”).

¹⁸ D.I. 411 at 40-41.

¹⁹ 927 F.2d 1200 (Fed. Cir. 1991).

There, the Federal Circuit affirmed the trial court's determination, based on a number of facts, that the phrase "at least about 160,000 IU" was indefinite for failing to definitely point out and distinctly claim the invention allegedly being infringed. The *Amgen* court noted that specific activity greater than 160,000 IU was clearly covered by the claim at issue but that it was unclear what activity below 160,000 IU was covered. The claim at issue had been amended during prosecution from claiming "at least 120,000 IU" to reciting "at least about 160,000 IU" in order to avoid being anticipated by a prior publication disclosing an invention having a specific activity of 128,620 IU. Further evidence of ambiguity was found in the fact that the patent owner's partner questioned whether a specific activity value of 138,000 IU for its own product was within the claim coverage of the patent at issue. The trial court found the amended claim to be an attempt to recapture a mean specific activity somewhere between 120,000 IU and 160,000 IU, but that "at least about 160,000 IU" was not definite enough to inform one of skill in the art of the bounds of the invention being claimed.²⁰ The facts concerning the disputed phrase in the *Amgen* case are different than those concerning the phrase "peripheral side edge" presented to this court.

The '621 patent is not concerned with precise numerical limitations as was the case with the patent at issue in *Amgen*. Furthermore, the '621 patent was not amended to add "peripheral" in an attempt to avoid prior art and, therefore, it is not essential that the word "peripheral" creates a further limitation on the phrase "side edge." Unlike the claim at issue in the *Amgen* case, one of ordinary skill in the art is able to understand the bounds of the

²⁰ See *id.* at 1217-1218.

inventions claimed in claims 1 and 2 of the '621 patent.

This court determined that the phrases “peripheral side edge” and “side edge” have the same meaning because the words “peripheral” and “edge” are synonymous references to the boundary of the motherboard. As a result of this court’s claim construction, it is clear that the language of claims 1 and 2 of the '621 patent referencing the location of the riser card connector as being “adjacent and parallel to a peripheral side edge”²¹ of a computer’s motherboard definitely describes the invention claimed. The scope of that invention is limited to one having a riser card connector located near but not touching the border of the motherboard which is not the front or rear of the motherboard and oriented so that the side edge of the motherboard and the riser card connector extend in the same direction with every point the same distance apart and never meeting.²²

V. CONCLUSION

For the reasons stated above, Tulip’s motion for partial summary judgment of validity under 35 U.S.C. § 112 (D.I. 336) is GRANTED to the extent that this court finds that the phrase “peripheral side edge” does not render the '621 patent invalid for failure to definitely claim the subject matter Tulip regards as its invention. An appropriate order consistent with this memorandum will follow.

²¹ '621 at 5:67-6:1 (claim 1); *Id.* at 6:39-40 (claim 2).

²² See D.I. 411 at 58 (reciting this court’s construction of the disputed phrases “adjacent,” “parallel,” and “peripheral side edge”).