

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE

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ISCO INTERNATIONAL, INC.,	)	
	)	
Plaintiff	)	
	)	
v.	)	C.A. No. 01-487 GMS
	)	
CONDUCTUS, INC., AND	)	
SUPERCONDUCTOR	)	
TECHNOLOGIES, INC.,	)	
	)	
Defendants.	)	

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**MEMORANDUM AND ORDER**

**I. INTRODUCTION**

The plaintiff, ISCO International, Inc. (“ISCO”), filed the above-captioned suit against Conductus, Inc. (“Conductus”) and Superconductor Technologies, Inc. (“STI”) (collectively “the defendants”) on July 17, 2001. In its complaint, ISCO alleges that Conductus and STI are infringing U.S. Patent No. 6,263,215 (“the ‘215 patent”). Presently before the court is Conductus’ Motion for Summary Judgment of Non-Infringement of the ‘215 patent (D.I. 201). In addition, because some of the issues raised are duplicative, the court also will address Conductus’ Motion for Summary Judgment of Invalidity of All Asserted Claims for Causes of Action Existing Prior to the Date of Issuance of a Certificate of Correction and of Invalidity of Claim 13 (D.I. 205). For the reasons that follow, the court will grant in part and deny in part the motion regarding non-infringement, and deny the motion regarding the certificate of correction and claim 13.

**II. STANDARD OF REVIEW**

Summary judgment is appropriate in patent suits as in other civil actions. *Rains v. Cascade*

*Industries, Inc.*, 402 F.2d 241, 244 (3d Cir. 1968). The court may grant summary judgment “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 judgment as a matter of law.” FED. R. CIV. P. 56(c); *see also Boyle v. County of Allegheny Pa.*, 139 F.3d 386, 392 (3d Cir. 1998). Thus, summary judgment is appropriate only if the moving party shows there are no genuine issues of material fact that would permit a reasonable jury to find for the non-moving party. *Boyle*, 139 F.3d at 392. A fact is material if it might affect the outcome of the suit. *Id.* (citing *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-248 (1986)). An issue is genuine if a reasonable jury could possibly find in favor of the non-moving party with regard to that issue. *Id.* In deciding the motion, the court must construe all facts and inferences in the light most favorable to the non-moving party. *Id.*; *see also Assaf v. Fields*, 178 F.3d 170, 173-74 (3d Cir. 1999).

With these standards in mind, the court will briefly describe the facts that led to the motion presently before the court.

### **III. BACKGROUND**

The invention of the ‘215 patent is a “receiver front end” for receiving telecommunications signals. A receiver front end is a system including filters, which transmit certain signals and attenuate others, and amplifiers, which strengthen the desired signals. Telecommunications systems divide geographic areas into “cells,” each of which is supported by a base station. Each base station has preassigned radio frequency (RF) carriers for the communication channels. Wireless signals from mobile telephones arrive at these base stations, which monitor and process the incoming signals. For various reasons including safety concerns and conservation of battery power, mobile

telephones transmit signals at limited power. Therefore, the signals arriving at the base stations tend to be weak, causing the cell to become “reverse link limited.” Most of the known solutions to this problem are unappealing or impractical. At the same time, additional demand by mobile telephone users requires more and more frequency channels and base stations. Thus, there was a need for base station front end receivers with increased sensitivity to incoming signals (by limiting losses and noise generated in the base station receiver) and selectivity (to allow more channels to be accommodated). The invention at hand purports to meet these needs.

As the patent specification provides, the receiver front end itself includes:

(1) a plurality of filtering means for spectrally filtering a plurality of RF signals to form a plurality of filtered RF signals; (2) a plurality of amplifying means, in communication with the plurality of filtering means, for amplifying the plurality of filtered RF signals; and (3) cooling means for cryogenically cooling the filtering means and the amplifying means. . . . At least one of the plurality of filtering means and plurality of amplifying means comprises a superconducting material. . . . Switching means can be used to bypass the RF signal around the receiver front end in the event of malfunction of [the] receiver front end. Monitoring means for monitoring remotely the operation of the various components of the receiver front end can be used to activate the switching means.

‘215 patent, col. 2, lns. 49-65; col. 5, ln. 65 to col. 6, ln. 3. Of the various patent claims, ISCO alleges that the defendants are infringing independent claim 10 and dependent claims 12 through 17, and 19.

#### **IV. DISCUSSION**

Conductus contends that ISCO cannot establish infringement of the ‘215 patent for several reasons. The court will address each of these issues in turn.

##### **A. Correspondence between Filters and Amplifiers**

Conductus first argues that certain language of claim 10<sup>1</sup> requires a one-to-one correspondence between the number of filters and the number of amplifiers. Because “the vast majority” of their accused products do not embody such a one-to-one correspondence, Conductus asserts, infringement cannot be established as to claim 10.

This argument is moot in light of the court’s order of October 30, 2002 in which it construed the claims of the patent. “Planar filters” has been construed to mean “two or more non-cavity resonator, essentially flat surface, film devices for separating, according to radio frequency, signals received on the communication pathways, each communication pathway having a pre-assigned radio frequency.” In addition, the phrase “a corresponding plurality of amplifiers for amplifying the plurality of filtered RF signals” has been construed to mean “two or more devices for strengthening two or more radio frequency signals, each device associated with *one or more* filters.” (emphasis added). Thus, a one-to-one correspondence between the number of filters and amplifiers is not required. Because Conductus’ present motion “presume[d] and relie[d] upon the construction of the relevant claim terms that Conductus . . . assert[ed] in connection with the [*Markman* claim construction] proceedings,” Opening Brief at 1-2, and because Conductus presumed only a construction requiring a one-to-one correspondence, its argument is now inapplicable, and summary judgment is inappropriate on these grounds.

## **B. Planar Filters**

As stated earlier, the term “planar filters” means “two or more non-cavity resonator,

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<sup>1</sup> Claim 10 requires “a plurality of planar filters for filtering a corresponding plurality of RF signals corresponding to a plurality of channels to form a corresponding plurality of filtered RF signals; [and] a corresponding plurality of amplifiers for amplifying the plurality of filtered RF signals.”

essentially flat surface, film devices for separating, according to radio frequency, signals received on the communication pathways, each communication pathway having a pre-assigned radio frequency.” Conductus urges that its products do not infringe because the filters used in the accused products are three-dimensional rather than flat. The defendant contends that the presence of tuning pins and three-dimensional chambers in its filters reveals so clearly that the accused products do not infringe that summary judgment is appropriate. The court cannot agree.

ISCO has produced evidence that the filters used in Conductus’ products have a thickness “on the order of microns.” Answer Brief at 21. There is other evidence that Conductus described its own filters as “planar devices” or “planar filters” in internal memoranda, submissions to the Securities and Exchange Commission, and other publications. *Id.* at 21-24. In short, there is evidence that suffices to raise a genuine issue of material fact as to whether Conductus’ filters are planar, *i.e.*, “non-cavity resonator, essentially flat surface, film devices,” or non-planar.

### **C. Bypass Circuit**

The defendant next moves for summary judgment on the grounds that the circuitry in its accused products differs from the circuitry required by the patent claims.

Claim 10 requires a circuit that, depending on operational parameters, routes the RF signals through either filters and amplifiers in the cryogenic cooler, or a bypass circuit. Specifically, the patent requires a bypass circuit whereby:

in a first mode when the one or more sensors measure acceptable operational parameters the bypass circuit is unswitched such that RF signals pass through the plurality of filters and amplifiers in the cryogenic cooler and not through the bypass circuit and in a second mode when the one or more sensors measure at least one unacceptable operational parameter the bypass circuit is switched and RF signals pass through the bypass circuit and not through the plurality of filters and amplifiers in the cryogenic cooler.

'215 patent, col. 20, lns. 55-65.

Conductus concedes that its products include bypass circuits, sensors for measuring operational parameters, and mechanisms for diverting the RF signals from one pathway to another depending on the operational data received. *See, e.g.*, Opening Brief at 22-23. Conductus argues, however, that its circuits differ from those required by the patent-in-suit because in the default or unswitched status the Conductus products route the RF signals through the bypass circuit, whereas claim 10 requires that in the default or unswitched status the RF signals are routed through the filters and amplifiers in the cryogenic cooler. This is supported, Conductus argues, by the language of claim 10, which requires “a *first* mode” in which the RF signals pass through the cryogenic cooler, and “a *second* mode” in which the RF signals are directed through the bypass circuit. (emphasis added). Because in the accused products’ “first mode” the RF signals pass through the bypass circuit and in their “second mode” the signals pass through the cryogenic cooler, Conductus urges that summary judgment of non-infringement is appropriate. The court disagrees.

In its argument, Conductus assumed a claim construction whereby “unswitched” could refer to the mode in which the RF signals are routed through the bypass circuit. The term “unswitched,” however, has been construed by the court to mean “the mode in which the bypass is off or not utilized,” and “switched” as “the mode in which the bypass is on or utilized.” Given this construction, the defendant’s purported distinction does not exist, and its argument cannot support a summary judgment of non-infringement.

Moreover, even if such distinctions could preclude a finding of literal infringement, they may not preclude a finding of infringement per the doctrine of equivalents. Equivalent infringement is

found when there are “insubstantial differences” between the patent claim and the accused product, or when an element of an accused product “performs substantially the same function, in substantially the same way, to achieve substantially the same result,” as the claim limitation. *Dawn Equip. Co. v. Kentucky Farms*, 140 F.3d 1009, 1015 (Fed. Cir. 2001). Conductus has not shown that there is no material fact at issue regarding whether its products perform substantially the same function, in substantially the same way, to achieve substantially the same result, as the claimed invention. Therefore, Conductus is not entitled to judgment as a matter of law on the grounds asserted.

#### **D. Planar Amplifiers**

Conductus next moves for summary judgment on the ground that the term “planar amplifiers” of claim 10 is “a clear error” with no meaning and, therefore, the accused products cannot be said to contain “planar amplifiers.” The court agrees that the inclusion of the word “planar” was a clear error, and therefore shall be disregarded. Because Conductus’ argument that its product cannot contain planar amplifiers is moot, summary judgment regarding the issue is inappropriate. Similarly, Conductus’ contention that the term “planar amplifiers” renders claim 10 indefinite is irrelevant and cannot sustain a summary judgment of non-infringement.

In this case, as with most, the parties agree on little. One issue about which they seem to wholeheartedly agree is that the term “planar amplifiers” is senseless to any person skilled in the relevant art. The plaintiff has referred to the term as “obvious typographical error,” Answer Brief at 5, and offered as support a Certificate of Correction issued by the Patent and Trademark Office on February 19, 2002 and correcting the term to read “amplifiers” only. Likewise, the defendant Conductus has described the term “planar amplifiers” as “clear error” and cites the deposition testimony of one of the named inventors for support. Opening Brief at 24. As Conductus points out,

this inventor testified that he has no idea what the term “planar amplifiers” means, and did not know of anyone in the industry who used the term. *Id.* (citing Deposition Transcript of Dr. R. Yandrofski, dated 6/28/02, Exh. B-7 743:24-744:18). In addition, the court notes that the term “amplifier” is introduced in claim 10 without the preceding modifier “planar.”<sup>2</sup> Documents in the file history also reveal that the word “planar” was inserted inadvertently as the result of a printing error. *See, e.g.*, March 29, 2001 Interview Summary. Finally, the PTO issued a Certificate of Correction pursuant to 35 U.S.C. § 254, “Certificate of correction of Patent and Trademark Office mistake.” Although the Certificate is not effective for purposes of this litigation because it issued after the suit was filed,<sup>3</sup> it is further evidence that the word “planar” was included in claim 10 as a result of a clear typographical error only.<sup>4</sup>

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<sup>2</sup> Claim 10 reads, in relevant part, “a plurality of amplifiers,” and, later, “the plurality of planar amplifiers.”

<sup>3</sup> *See* the court’s order of November 8, 2002.

<sup>4</sup> The court is mindful of the conflict implicit in federal caselaw which indicates, on the one hand, that Certificates of Correction correcting typographical, printing, or other errors of the applicants or the PTO have prospective effect only and, on the other hand, that obvious typographical errors in patent claims may be disregarded by courts, with or without such a Certificate of Correction. The court, however, is persuaded that the nature of the particular correction at issue in this case calls for the application of the latter approach. First, the mistake at issue is minor, entailing the disregarding of one word only. This is in stark contrast to certain cases in which courts would not retroactively apply a Certificate of Correction to add, for example, an entire appendix to the patent. *See Southwest Software, Inc. v. Harlequin, Inc.*, 226 F.3d 1280 (Fed. Cir. 2000). In addition, the court’s ruling does not offend the policy considerations underlying *Southwest* and its progeny, *i.e.*, to allow “reasonable competitors” to “conduct[] their affairs” according to a reasonable understanding of the claim terms. *Id.* at 1295. Here, the evidence shows that the parties agree that the insertion of the word “planar” was a clear error which anyone skilled in the art would recognize as such, especially because the phrase “planar amplifiers” occurs nowhere else in the patent claims. Thus, a reasonable competitor would know that a mere typographical error had occurred, and would conduct its affairs accordingly. It would be illogical for *reasonable* competitors to rely upon an inadvertent error such as the one at issue here as the sole basis for avoiding a patent infringement lawsuit or a



As to the legal effect of the error, the parties disagree. ISCO contends that the error is clearly typographical in nature and, therefore, may be disregarded by the court. Conductus urges that the error renders claim 10 indefinite. As already stated, the court is convinced that the inclusion of the word “planar” was a typographical error that may be disregarded by the court. Typographical errors are regularly disregarded by courts when the error is apparent in light of the claims, specification, or file history. For example, the Federal Circuit construed a claim to include the word “toy” when the omission of the word was clearly “an inadvertent error.” *Lemelson*, 968 F.2d at 1204 n.3. Other examples of this approach are numerous. *See, e.g., EMI Group North America, Inc. v. Cypress Semiconductor Corp.*, 68 F. Supp. 2d 421, 438 (D. Del. 1999), *aff’d in relevant part*, 268 F.3d 1342 (Fed. Cir. 2001) (reading claim without two “typographical errors” where the “printing error[s] are apparent from the file history”); *Brandt, Inc. v. William Crane*, 558 F. Supp. 1339, 1341 (N.D. Ill. 1983) (construing claim to include two words that, after “examination of the entire patent materials,” court concluded had been omitted by typographical error); *Baily v. Dart Container Corp. of Michigan*, 157 F. Supp. 2d 110, 124 n.7 (D. Mass. 2001) (disregarding typographical error when error clear to one skilled in the art); *University of Florida Research Foundation, Inc. v. Orthovita, Inc.*, 1998 WL 34007129, at \*14 n.15 (N.D. Fla. 1998), *aff’d*, 217 F.3d 854 (Fed. Cir. 1999) (“This Court is unwilling to base its construction of these claims on what is obviously a typographical error . . . .”); *Johns Hopkins University v. Cellpro*, 931 F. Supp. 303, 310 (D. Del. 1996), *aff’d in relevant part*, 152 F.3d 1342 (Fed. Cir. 1998) (omitting three sections from claim where “it appear[ed] from the prosecution history” that the portion of the claim “was incorrectly kept in the claims as the result

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finding of infringement as to that claim. *See, e.g., Lemelson v. General Mills, Inc.*, 968 F.2d 1202, 1204 n.3 (Fed. Cir. 1992) (including the word “toy” in patent claim because its omission was clearly an error).

of a typographical error”); *Ethyl Molded Products Co. v. Betts Packaging, Inc.*, 9 U.S.P.Q. 2d 1001, 1019, 1988 WL 122168, at \*70 (E.D. Ky. 1988) (“[The defendant] cannot avoid infringement because of what is clearly a typographical error.”).

Because the patent claims, file history, and testimony submitted by both parties reveal that the inclusion of the word “planar” was the result of a typographical error, and because such error is apparent to someone skilled in the art, the court will disregard the error.<sup>5</sup> Conductus’ arguments in its motions for summary judgment of non-infringement (D.I. 201) and of invalidity (D.I. 205) that are premised on the phrase “planar amplifiers,” are moot.

### **E. Dependent Claims**

Conductus argues that, if its products do not infringe independent claim 10, they likewise do not infringe dependent claims 12 through 17 and 19. Because the court has not granted summary judgment regarding non-infringement of claim 10, it need not address this argument.

### **F. Elevated Structure**

#### **1. Motion for Summary Judgment of Invalidity of Claim 13**

In its motion for summary judgment of invalidity (D.I. 205), Conductus urges that claim 13

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<sup>5</sup> The parties are well aware, no doubt, that the court, following a *Markman* claim construction hearing, construed the phrase as “planar amplifiers.” *See* Memorandum and Order of October 30, 2002. At that time, the plaintiff relied solely on the Certificate of Correction for its contention that the word “planar” should be read out of claim 10. Because such a Certificate clearly has prospective effect only, the court refused to give the Certificate effect for purposes of this litigation. *See* Memorandum and Order of November 8, 2002. Per the plaintiff’s request, however, the court subsequently granted supplemental briefing on the issue of the phrase “planar amplifiers,” noting that it would “address any issues arising from the supplemental briefing after having received and reviewed the same.” *Id.* Having the benefit of the supplemental briefing, as well as the submissions of the parties in connection with the present motions, the court believes it has arrived at the only sensible conclusion regarding the term “planar amplifiers,” as outlined above. Of course, to the extent this conclusion is inconsistent with the claim construction order of October 30, 2002, the present order controls.

is invalid for two reasons. First, “it improperly imparts a use limitation on an apparatus claim.” Opening Brief at 7. ISCO responds that “there is no prohibition against using functional limitations in apparatus claims.” Answer Brief at 15. The court finds these arguments irrelevant to the legal questions raised in this motion as to claim 13. Second, Conductus argues that claim 13 is invalid for failing to meet the specification requirements of 35 U.S.C. § 112. Because this determination rests on disputed factual allegations, the court declines to grant summary judgment on the second ground.

The parties spend much wasted time, and ask the court to waste its time, in a debate regarding 1) whether claim 13 is a structural or functional limitation, and 2) whether functional language may be used to limit an apparatus claim. In the interest of clarity, the court will briefly address these misconceived legal arguments.

ISCO’s contention that claim 13 is a structural limitation asks the court to suspend common sense and flies in the face of the relevant caselaw. For example, the court in *In re Venezia*, 530 F.2d 956 (C.C.P.A. 1976), a case cited by ISCO, held that claims describing “[a] splice connector kit having component parts” were not indefinite or incomplete merely because the kit comprised many parts which may be assembled in the future. The court found:

The claimed invention does include present structural limitations on each part, which structural limitations are defined by how the parts are to be interconnected in the final assembly, if assembled. . . . [The claim] also defines present structures or attributes of the part of the “kit” identified as the housing, which limits the structure of the housing to those configurations which allow for the completed connector assembly desired. Again, a present structural configuration for the housing is defined in accordance with how the housing interrelates with the other structures in the completed assembly. We see nothing wrong in defining the structures of the components of the completed connector assembly in terms of the interrelationship of the components, or the attributes they must possess, in the completed assembly.

*Id.* at 958-59. Unlike the connector kit and its many inherent parts, recited in previous claims of the patent, the invention at issue here, a receiver front end, cannot be said to include an elevated structure, nor is an elevated structure a “component[] of the completed” receiver front end structure. Claim 13 recites no additional limitation as to the structure of the claimed apparatus as defined in independent claim 10. To hold “an elevated structure” – any elevated structure – as a structural component of the receiver front end would be extraordinary indeed. The court is unwilling to take such a position.

ISCO then argues that even if claim 13 is not a structural limitation, it is a functional one. The plaintiff cites numerous cases for the proposition that functional limitations are not *per se* invalid. *See, e.g., R.A.C.C. Indus. v. Stun-Tech, Inc.*, 49 U.S.P.Q. 2d 1793, 1998 U.S. App. LEXIS 30769, at \*8 (“an apparatus claim may include functional limitations”); *In re Swinehart*, 439 F.2d 210, 213 (C.C.P.A. 1971) (“We are convinced that there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that “functional” language, in and of itself, renders a claim improper.”). The court readily accepts this principle, despite Conductus’ assertions to the contrary.<sup>6</sup>

After having shown, it believes, that claim 13 is a functional limitation, Conductus argues that claim 13 is invalid per 35 U.S.C. § 112. The movant does not elaborate upon or cite any caselaw for this assertion, and ISCO does not address the argument in any way in its briefing.

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<sup>6</sup> The cases cited by Conductus support only the proposition that functional limitations cannot be used to distinguish a claim from prior art. *See, e.g., In re Drissner*, 156 F.2d 164, 165 (“Apparatus claims must, in order to be patentable, distinguish over the prior art in terms of structure.”); *In re Swinehart*, 439 F.2d at 212-13 (“[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art.”). Conductus has not raised, in connection with this motion, an argument that claim 13 fails to distinguish over prior art.

Regardless, the court is unpersuaded by the contention for purposes of this motion.

The fourth paragraph of 35 U.S.C. § 112 requires that a dependent claim “further limit[]” the subject matter claimed in the dependent claim. 35 U.S.C. § 112 para. 4. In the instant case, claim 13 certainly does this. As stated above, it is not *per se* inappropriate to use functional language to limit an apparatus claim. Thus, although stated in functional language, which could render claim 13 vulnerable on other grounds not asserted in this motion,<sup>7</sup> the claim limits the receiver front end by stating that it must be mounted on an elevated structure. For purposes of this motion, and in the absence of any legal argument or supporting evidence or caselaw presented by Conductus on the topic, that is sufficient. In short, the court sees no reason to invalidate claim 13 merely because it may employ functional language.

The second paragraph of 35 U.S.C. § 112 requires that a patent claim “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” 35 U.S.C. § 112 para. 2. The claim is sufficiently definite if ‘one skilled in the art would understand the bounds of the claim when read in light of the specification.’ *Allen Eng'g Corp. v. Bartell Indus.*, 299 F.3d 1336, 1348 (Fed. Cir. 2002) (quoting *Personalized Media Communs., L.L.C. v. ITC*, 161 F.3d 696, 705 (Fed. Cir. 1998)); *see also Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 2003 WL 41993, 2003 U.S. App. LEXIS 118, at \*35 (Fed. Cir. 2003) (“Satisfaction of [the written description] requirement is measured by the understanding of the ordinarily skilled artisan.”). In this inquiry, the court is mindful that “[t]he standard of indefiniteness is somewhat high; a claim is not indefinite

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<sup>7</sup> *See, e.g., supra* note 5; *see also In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (“A patent applicant is free to recite features of an apparatus either structurally or functionally. . . . [y]et choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk.”) (citation omitted).

merely because its scope is not ascertainable from the face of the claims.” *Amgen*, 2003 U.S. App. LEXIS 118, at \*73. However, it is not the court’s function or duty “to rewrite claims to preserve their validity.” *Allen*, 299 F.3d at 1349.

Claim 13 claims “[t]he receiver front end as claimed in claim 10, wherein the receiver front end is mounted on an elevated structure.” The court has construed “elevated structure” according to its plain meaning, *i.e.*, “something constructed, such as a building, raised above the ground.” Thus, an almost infinite number of towers, buildings, benches, bridges, monuments, ramps, arches, tables, planes, platforms, or other constructed formations could constitute an elevated structure. Of course, given the relevant art, the claim may not contemplate each of these things as suitable “elevated structures” to which a receiver front end may be mounted. The scope of the claim does not appear clear from the language of claim 13. As stated above, however, a definiteness inquiry is not determined from a layman’s perspective, but “is measured by the understanding of the ordinarily skilled artisan.” *Amgen*, 2003 U.S. App. LEXIS 118, at \*35. The court is skeptical that a person skilled in the relevant art could presume to know the scope of the phrase “elevated structure.” However, given the disputed assertions of how a person skilled in the art would understand the claim, and given the highly technical nature of the art at issue, the court refrains from granting summary judgment on this ground without a full investigation of the facts underlying the definiteness inquiry. *See, e.g., Amgen*, 2003 U.S. App. LEXIS 118, at \*36 (noting the “fact intensive nature” of an inquiry into the adequacy of written description).

Because there remain disputed issues of fact, summary judgment is inappropriate regarding whether claim 13 meets the written description requirements of § 112. Thus, for purposes of this motion, the movant has not shown that it is entitled to judgment as a matter of law. *See* FED. R. CIV.

P. 56(c).

## **2. Motion for Summary Judgment of Non-Infringement of Claim 13**

Finally, in its motion for summary judgment of non-infringement (D.I. 201), Conductus argues that summary judgment is appropriate because its accused products are not mounted on an elevated structure. ISCO maintains that “Conductus has offered the ClearSite products for sale with outdoor enclosures to permit the products to be installed on a rooftop.” Answer Brief at 34. In addition, ISCO claims that Conductus has “made it known to its customers” that the outdoor enclosures would render the products more suitable for mounting on a rooftop. *Id.* Finally, ISCO cites the deposition of an STI employee, Mr. Fenzi, for the assertion that STI knows that one STI customer has mounted a SuperFilter product on a rooftop.

Even if true, none of ISCO’s factual assertions establishes infringement of claim 13. It is self-evident that offering for sale a product that could be mounted on an elevated structure is not equivalent to offering for sale a product that is mounted on an elevated structure. Conceivably, *any* receiver front end could be mounted on an elevated structure. Thus, by the plaintiff’s argument, *any* receiver front end meeting the other claims would infringe claim 13 as well, whether or not it was actually mounted on an elevated structure. Claim 13 either limits the previous claims (in which case ISCO cannot claim any receiver front end which conceivably could be mounted on an elevated structure, as all receiver front ends could conceivably be mounted on an elevated structure) or it does not (in which case the claim is invalid per 35 U.S.C. § 112 for failing to further limit a claim). The patent applicants chose the language of the patent claims, and must be held to that language. Claim 13 does not claim a receiver front end that is intended to be mounted on an elevated structure, or a receiver front end that is capable of being mounted on an elevated structure. ISCO has not adduced

a scintilla of evidence that STI itself has made, used, or offered to sell any “receiver front end as claimed in claim 10, mounted on an elevated structure,” or that there is a relevant material fact in dispute as to this assertion. *See Int’l Ass’n of Heat & Frost Insulators & Asbestos Workers Local Union 42 v. Absolute Envtl. Serv., Inc., et al.*, 814 F. Supp. 392, 402 (D. Del. 1993) (“[When the nonmovant . . . bear[s] the ultimate burden of proof at trial, the nonmovant may withstand summary judgment only by coming forward with evidence sufficient to create a genuine issue of material fact as to every essential element of the nonmovant's claim or defense.”). As such, there is no genuine issue of material fact as to whether STI has infringed claim 13. Summary judgment of non-infringement of claim 13 is granted.

## **V. CONCLUSION**

Based on the evidence before it, the court concludes that there remain genuine issues of material fact with regard to non-infringement. The asserted grounds for summary judgment of invalidity that are based upon the phrase “planar amplifiers,” are moot, because the court will disregard the typographical error in the phrase. Several other of Conductus’ arguments are moot given the court’s construction of the claim terms. Finally, Conductus has not shown that claim 13 is invalid for failure to meet the written description requirement, but the court concludes that there is no genuine issue of material fact as to non-infringement of claim 13.

For the foregoing reasons, IT IS HEREBY ORDERED that:

1. Conductus’ Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 6,263,215 (D.I. 201) is GRANTED as to claim 13 and DENIED as to each of the other asserted patent claims.



2. Conductus' Motion for Motion for Summary Judgment of Invalidity of All Asserted Claims for Causes of Action Existing Prior to the Date of Issuance of a Certificate of Correction and of Invalidity of Claim 13 (D.I. 205) is DENIED.

Dated: February 10, 2003

Gregory M. Sleet  
UNITED STATES DISTRICT JUDGE