

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. (“STP”) (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 STI’s Motion for Summary Judgment of Non-Infringement (D.I. 208). For the reasons that follow, the court will grant in part and deny in part the motion.

**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).

### **III. DISCUSSION**

#### **A. “Planar Amplifiers”**

STI first moves for summary judgment of non-infringement on the grounds that its accused products lack “planar amplifiers” as required by claim 10 of the patent-in-suit. As discussed in the court’s order regarding Conductus’ motion for summary judgment on the same issue,<sup>1</sup> STI’s argument is moot because the court will disregard the obvious typographical error which resulted in the insertion of the phrase “planar” in claim 10. The relevant language reads “amplifiers” only. Summary judgment as to this issue is denied.

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

The movant urges that summary judgment is appropriate because its accused products do not include a one-to-one correspondence between the filters and amplifiers, as required by claim 10. As discussed in the court’s order regarding Conductus’ motion for summary judgment on the same

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<sup>1</sup> See the court’s order of today regarding Conductus’ Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 6,263,215 (D.I. 201).

issue, this argument fails because it presumes a construction of “correspondence” whereby only one filter is associated with only one amplifier. In fact, the court has construed the relevant language of claim 10 to mean “two or more devices for strengthening two or more radio frequency signals, each device associated with *one or more* filters.” (emphasis added). Summary judgment of non-infringement on this basis is not appropriate.

### **C. Bypass Circuit**

STI next moves for summary judgment on the grounds that its accused products contain no functional automatically controlled bypass circuit, no bypass circuitry at all, or bypass switches that operate in “the opposite manner” as the bypass switches required by claim 10. The court will address these arguments in turn as they apply to certain accused products.

#### **1. SuperFilter PCS Products**

STI maintains that its SuperFilter PCS Products lack a bypass circuit altogether. ISCO responds that the product has been offered for sale on STI’s Internet web site with a switched bypass circuit. Because “an offer for sale” constitutes infringement, 35 U.S.C. § 271(a), ISCO urges that STI’s offering of its SuperFilter PCS product for sale with a bypass circuit satisfies the requirement of claim 10. STI counters that any information on its website regarding its products does not constitute an offer to sale for purposes of § 271(a).

Web site pages or “advertisements” are considered offers for sale if they include pricing and/or other ordering information; web sites containing product descriptions only, and no pricing or ordering information, do not constitute offers to sell. *Lucent Tech., Inc. V. Newbridge Networks*

*Corp.*, 168 F. Supp. 2d 181, 229 (D. Del. 2001) (citing cases). Neither the movant nor the non-movant addresses the issue of whether the information on STI's website included pricing details and/or other ordering information. Thus, even accepting the non-movant's allegation that Superfilter PCS products contained a bypass circuit, there remains a question of material fact as to whether those products were offered for sale. Summary judgment as to this issue is inappropriate.

## **2. SuperFilter I and II Products**

STI contends that its SuperFilter I and II products do not include bypass circuits that operate in the manner described by the patent claims. The court addressed this same issue as to the defendant Conductus' products in connection with Conductus' Motion for Summary Judgment of Non-Infringement. The court refers the parties to that order, as the analysis and conclusion there is identical to the disposition of STI's present argument. Essentially, STI cannot support its motion for summary judgment by merely showing that its products contain the same circuitry as that required by claim 10, and perform the same functions required by claim 10, but in a reverse order. In addition, STI bases its argument on 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). STI 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. *See, e.g., Overhead Door Corp. v. Chamberlain Group, Inc.*, 194 F.3d 1261, 1270 (Fed. Cir. 1999) (finding that the claim language “memory selection switch” is not limited by the “way” the mechanical switch accomplishes the memory selection function). Therefore, STI is not entitled to judgment as a matter of law on the grounds asserted.

### **3. Superfilter III Products<sup>2</sup>**

STI argues that its SuperFilter III products do not infringe the patent-in-suit because their automatic bypass circuits have been disabled. ISCO has adduced evidence, however, that as manufactured, these products contain functional automatically switched bypass circuits as contained in the SuperFilter I and II products. By disconnecting a plug from one receptacle in the product and plugging it into a different receptacle in the product before shipping it to customers, the bypass

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<sup>2</sup> This product remains in the case because “STI has permitted discovery concerning SuperFilter III.” Opening Brief at 20 n.60. Frankly, the court is disappointed that STI has permitted this unpleasant matter to remain in the case, but thanks STI for having disabused the court of the notion that it is solely the court’s role, and not the defendant’s, to determine the scope of discovery.

circuit is merely temporarily disabled. The bypass circuit hardware remains in the product, and is capable of being re-enabled. Indeed, ISCO has pointed to evidence that STI offered to re-enable the bypass circuit if one of its customers so desired.

When a patented invention is made, used, or offered for sale, the patent is infringed. 35 U.S.C. § 271; *see also Radio Corp. of America v. Andrea*, 90 F.2d 612, 613 (2d Cir. 1937) (finding infringement where defendant tested completed product and then removed a part, but included it in the same shipping carton as the product). ISCO has offered evidence that STI manufactured, tested, and offered for sale a product containing an automatically controlled bypass circuit. Given the non-movant's factual contentions, summary judgment of non-infringement as to the SuperFilter III products is not warranted on the grounds asserted, namely, that they do not include the required bypass circuitry.

#### **D. Correspondence between Filters and Channels**

STI moves for summary judgment on the grounds that its accused products lack the required correspondence between the planar filters and channels. It bases this contention on a claim construction whereby “corresponding” requires a one-to-one relationship, and whereby “channels” means “the range of electromagnetic frequency over which a telephone call is transmitted.” In construing a portion of claim 10, the court determined “corresponding” to require merely an association between two elements and not a one-to-one correspondence. In addition, the court has construed “channels” to mean “communication pathways, each having a pre-assigned frequency, over which cellular telecommunications signals are carried.” Because STI’s argument rested on

incorrect claim constructions, the argument is moot and summary judgment must be denied.

### **E. Dependent Claims**

STI 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.

In the alternative, STI maintains that its products do not infringe the dependent claims for several reasons. The court will address these in turn.

#### **1. Claim 12**

The plaintiff has withdrawn its assertion that STI's SuperFilter products infringe claim 12. Answer Brief at 1 n.1.

#### **2. Claim 13: "Mounted on an Elevated Structure"**

STI urges that its accused products do not infringe claim 13 because they are not mounted on an elevated structure. ISCO maintains that "STI has offered the SuperFilter products for sale with outdoor enclosures to permit the products to be installed on elevated structures." Answer Brief at 36. In addition, ISCO claims that STI has "made its customers aware" that outdoor enclosures are available, which enclosures would render the products more suitable for mounting on an elevated structure. *Id.*

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. 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, summary judgment of non-infringement of claim 13 is appropriate.

### **3. Claim 17: Amplifier and Filter in the Bypass Circuit**

Claim 17 requires a bypass circuit that includes an amplifier and filter. STI urges that summary judgment is warranted as to the SuperFilter I and II products because they lack an amplifier and filter in the bypass circuit. STI maintains that, even in the bypass mode, the RF signals pass



through parts of the RF path other than the circuit between the bypass switches. ISCO responds that during the bypass mode, the RF signals pass through the conventional filter and amplifier and do not pass through the plurality of filters and amplifiers in the cryogenic cooler. The parties essentially debate how the products operate. In short, there is enough of a factual dispute as to how the products operate and whether such operation constitutes infringement, literal or equivalent, to forestall summary judgment as to this issue until a full hearing of the facts.

#### **IV. CONCLUSION**

Based on the evidence before it, the court concludes that summary judgment is inappropriate as to every claim except claim 13.

For the foregoing reasons, IT IS HEREBY ORDERED that:

1. STI's Motion for Summary Judgment of Non-Infringement of U.S. Patent No. 6,263,215 (D.I. 208) is GRANTED as to claim 13 and DENIED as to each of the other asserted claims.

Date: February 10, 2003

Gregory M. Sleet  
UNITED STATES DISTRICT JUDGE