United States District Court,
C.D. California.

Edward L. GUSSIN,
Plaintiff.
v.
NINTENDO OF AMERICA, INC,
Defendant.

No. CV 93-4308 LGB (BX)

Oct. 6, 1994.

ORDER GRANTING SUMMARY JUDGMENT

LOURDES G. BAIRD**, District Judge.**

I. INTRODUCTION

Defendant's motion for summary judgment of noninfringement came on regularly for hearing before this Court on September 26, 1994. After reviewing the materials submitted by the parties and considering argument of counsel as well as all other matters presented to the Court, it is hereby ORDERED that Defendant's motion is GRANTED.

II. FACTUAL AND PROCEDURAL BACKGROUND

Edward L. Gussin is the patentee and owner of U.S. Patent no. 4,782,335, which was issued on November 1, 1988 ('335 Patent) and issued upon reexamination on September 21, 1993 (B1 '335 Patent). This patent describes the protected invention as "[a] video art electronic system for drawing and coloring on a conventional color television video monitor [that] includes a first joystick for drawing and a second joystick for coloring. The operation is in real time and is simple enough for a child to use." ('335 Patent, Abstract.) The '335 Patent consists of sixteen claims, three of which (1, 2, and 14) are independent.

Nintendo of America, Inc. manufactures the Super Nintendo Entertainment System (SNES), which is described as a multipurpose, programmable video game system. (Def.'s Hem. Supp. Summ. J. at 1.) Nintendo also manufactures "Mario Paint," a home video game program for use with the SNES. (Id.) The SNES/Mario Paint combination, inter alia, "permits a user to compose music and animate pictures ... as well as to draw and manipulate complex images with a single, multifunction 'mouse' control." (Id. at 3.) The Mario Paint game is in the form of a cartridge that is inserted into the console of the SNES. (*See* Ward Decl. para.para. 18-19.)

In the instant action, Gussin contends that the SNES, when used in conjunction with Mario Paint, infringes on the '335 Patent. For the present purposes only, Nintendo assumes the '335 Patent is valid over prior art. (Def.'s Mem. Supp. Summ. J. at 2 n. 2.)

Gussin filed his complaint for infringement on July 21, 1993. Nintendo answered and counterclaimed on September 1, 1993. This Court has jurisdiction over these claims pursuant to 28 U.S.C. s. 1338(a).

Nintendo brings the instant motion for summary judgment on the basis of noninfringement alone. FN1

FN1. Nintendo addresses only claims 1 and 2 of the '335 Patent since claims 3-13 and 15-16 are dependent claims, and since independent claim 14 is narrower than claims 1 and 2. Any claim limitations that apply to claims 1 or 2 will also apply to any dependent or narrower claims. *See* London v. Carson Pirie Scott & Co., 946 F.2d 1534, 1539 (Fed.Cir.1991); 37 C.F.R. s. 1.75(c).

III. SUMMARY JUDGMENT STANDARD

A. IN GENERAL

It is the burden of the party who moves for summary judgment to establish that there is "no genuine issue of material fact, and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c); British Airways Bd. v. Boeing Co., 585 F .2d 946 951 (9th Cir.1978), *cert. denied*. 440 U.S. 981 (1979). If the moving party has the burden of proof at trial (the plaintiff on a claim for relief, or the defendant on an affirmative defense), the moving party must make a showing sufficient for the court to hold that no reasonable trier of fact could find other than for the moving party. Calderone v. United States, 799 F.2d 254, 259 (6th Cir.1986) (quoting W. Schwarzer, Summary Judgment Under the Federal Rules: Defining Genuine Issues of Material Fact, 99 F.R.D. 465, 487-88 (1934)). Furthermore, if the moving party has the burden of proof at trial, that party must establish peradventure *all* of the essential elements of the claim or defense to warrant judgment in that party's favor. Fontenot v. Upjohn Co., 780 F.2d 1190, 1194 (5th Cir.1986).

If the opponent has the burden of proof at trial, then the moving party has no burden to negate the opponent's claim. Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1985). In other words, the moving party does not have the burden to produce *any* evidence showing the absence of a genuine issue of material fact. Id. at 325. "Instead, ... the burden on the moving party may be discharged by 'showing'-that is, pointing out to the district court-that there is an absence of evidence to support the nonmoving party's case." *Id*.

Once the moving party satisfies this initial burden, "an adverse party may not rest upon the mere allegations or denials of the adverse party's pleadings.... [T]he adverse party's response ... *must set forth specific facts* showing that there is a genuine issue for trial." Fed.R.Civ.P. 56(e) (emphasis added). A genuine issue of material fact exists only when the nonmoving party makes a sufficient showing to establish an essential element to that party's case, and on which that party would bear the burden of proof at trial. Celotex, 477 U.S. at 322-23. "The mere existence of a scintilla of evidence in support of the plaintiff's position will be insufficient; there must be evidence on which a reasonable jury could reasonably find for plaintiff." Anderson v.. Liberty Lobby, 477 U.S. 242, 252 (1986). The evidence of the nonmovant is to be believed, and all justifiable inferences are to be drawn in its favor. Id. at 248.

B. IN PATENT LITIGATION

Although older cases may suggest or even state the contrary, recent decisions of the federal circuit have "repeatedly emphasized that summary judgment is as appropriate in a patent case as in any other." Avia Group Int'l. Inc. v. L.A. Gear California, 853 F.2d 1557, 1561 (Fed.Cir.1988) (internal quotation marks

omitted). And, as with any other case, summary judgment is appropriate in patent litigation when there is no genuine dispute as to any material fact. *Id.;* Winner Int'l Corp. v. Wolo Mfg. Corp., 905 F.2d 375, 376 (Fed.Cir.1990). "Thus, the motion of an accused infringer for judgment on the ground of non-infringement of a patent may be granted where the patentee's proof is deficient in meeting an essential part of the legal standard for infringement." Johnston v. IVAC Corp., 885 F.2d 1574, 1577 (Fed.Cir.19S9).

IV. ANALYSIS

A. PROCEDURAL DEFICIENCIES IN PLAINTIFF'S PAPERS

As an initial consideration, the procedural deficiencies in Plaintiff's papers alone warrant granting summary judgment for Defendant. The moving Defendant has complied with Local Rule 7.14.1 by filing a Statement of Uncontroverted Facts and Conclusions of Law, which contains citations to the evidence upon which it relies. Plaintiff's Statement of Genuine Issues of Material Fact, however, falls far short of what is contemplated by the rules.

First, Plaintiff's Statement of Genuine Issues does not set forth specific facts that are claimed to be disputed. Rather, Plaintiff offers up nine vague interrogatories, several of which are repetitive. FN2 The Federal Rules require the party against whom the notion is made to "set forth the *specific facts* showing that there is a genuine issue for trial." Fed. R. civ. P. 56(e) (emphasis added); *see also* Local Rule 7.14.2.

FN2. For example, Plaintiff queries:

Shouldn't the jury as the trier of fact decide whether Dr. Ward [Nintendo's consultant] should be given any credibility since he admits he has been paid over $380,000 by Nintendo over the past five years, and presently earns at least $8,000 per month from Nintendo, whether he does any work or not?

(Pl.'s Statement of Genuine Issues para. 7.)
More importantly, Plaintiff's statement sets forth *no evidence* tending to show a factual dispute; in fact there is not a single citation to evidentiary matter in Plaintiff's statement as is required by the local rules. *See id.;* Nilsson, Robbins, Dalgarn, Berliner, Carson & Wurst v. Louisiane Hydrolec, 854 F.2d 1538, 1545 (9th Cir.1988). The purpose of the statement of genuine issues is to educate, not interrogate, the Court.

When an opposing party fails to make a sufficient evidentiary showing, a properly supported motion for summary judgment should be granted. *Id*. Even if opposition papers are filed, failure to comply with the local rule requirements governing the filing of a separate statement of disputed facts r.ay be a sufficient basis for granting the motion. *Id*. (affirming summary judgment for, inter alia, nonmovant's failure to comply with "a pertinent local rule expressly indicat[ing] that [nonmovants] had an affirmative burden to list genuine issues with appropriate record citations in order to withstand the motion"); *see also* Local Rules 7.9, 7.14.3. Additionally, the genuine issues and supporting evidence must be identified *without the assistance* of the district judge. Nilsson, 854 F.2d at 1545.

Ordinarily, this Court would not favor granting summary judgment on a mere technicality; in this case, however, the shortcomings appear to be caused by a lack of evidence in support of Plaintiff's complaint. The Court is neither required nor inclined to comb the voluminous material submitted by the parties in search of such evidenced.

In light of these circumstances, the Court ORDERS that summary judgment be GRANTED in favor of Defendant for Plaint ff's failure to specifically identify, in an intelligible manner, those facts asserted to be disputed and specific evidence in support of those assertions. For the benefit of the parties, the Court will not rely solely on this ground to support its Order and will evaluate Defendant's motion on its merits as follows.

B. INFRINGEMENT ANALYSIS

The law is well established that determining whether patent claims have been infringed requires a two-step analysis. Carroll Touch. Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1576 (Fed.Cir.1993). In the first step, the patent claims are construed to determine their scope and meaning; this step is a question of law for the court. Id. at 1576-77. In the second step, the patent claims, as properly construed, are compared to the accused device or process. Id. at 1576. "A claim covers [or 'reads on'] an accused device if the device embodies *every limitation* of the claim, either literally or by an equivalent." *Id*. (emphasis added); *see also* Johnston, 885 F.2d at 1577 & n. 3 (discussing this "All Elements Rule"); Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1259 (Fed.Cir.1989) (same). The burden is on the patent owner to prove infringement by a preponderance of the evidence. Carroll Touch, 15 F.3d at 1578,

1. LITERAL INFRINGEMENT

Nintendo contends that the '335 Patent, properly construed in light of the literal claim and specification language and the prosecution history, contains four essential limitations that are not present in the accused device; to wit, (1) Gussin's patent is limited to a "dedicated hardware device," whereas the accused device is a "programmable computer" that is dependent upon software; (2) the Gussin invention is limited to a device containing a specific "pixel memory" configuration, which is not present in Nintendo's combination; (3) the Gussin device is limited to "two dedicated" joysticks, whereas the accused combination uses a computer mouse; and (4) Gussin's invention requires a "dedicated draw switch," which is also absent from Nintendo's product. Under the All Elements Rule, *supra,* the absence of any one of these limitations in the accused device is a sufficient basis for granting summary judgment based on noninfringement.

Nintendo claims that these limitations and distinctions are clear from the literal claim language and were made by Gussin in order to survive examination and reexamination. Nintendo asserts that, in order to show infringement, Gussin must both interpret his claims in a manner inconsistent with the literal language of the patent and rely on subject matter relinquished during initial prosecution and reexamination. The Court agrees.

It is clear that "a patentee should not be able to obtain, through litigation, coverage of subject matter' relinquished during prosecution." Haynes Int'l, Inc. v. Jessop Steel Co., 8 F.3d 1573, 1577 (Fed, Cir.1993). "The legal standard for determining what subject matter was relinquished is an objective one, measured from the vantage point of what a competitor was reasonably entitled to conclude, from the prosecution history, that the applicant gave up to procure issuance of the patent." Id. at 1578, Additionally, "an inventor may not be heard to proffer an interpretation that would alter the undisputed public record (claim, specification, prosecution history) and treat the claim as a 'nose of wax.' " Senmed, Inc. v. Richard-Allan Medical Indus., Inc., 888 F.2d 815, 819 n. 8 (Fed.Cir, 1989) (quoting White v. Dunbar, 119 U.S. 47, 51-52 (1886)). FN3

FN3. The analysis of prosecution history
essentially applies to both literal infringement and infringement under the doctrine of equivalents. For

purposes of literal infringement, the prosecution history is used to interpret the claims in a manner consistent with [the patentee's] representations during prosecution. In the context of the doctrine of equivalents, the prosecution history acts as formal estoppel to prevent the patent owner from obtaining a scope of equivalency that would resurrect subject matter surrendered during prosecution.

Advanced Cardiovascular Sys. Inc. v. C.R. Bard Inc., 26 U.S.P.Q.2d 1304, 1307 n. 5 (N.D.Cal.1992); *see also* Johnston. 885 F.2d at 1579; Moleculon Research Corp. v. CBS. Inc., 793 F.2d 1261, 1270 (Fed.Cir.1986), *cert. denied*. 479 U.S. 1030 (1987).

a. DEDICATED HARDWARE

Nintendo first asserts that the '335 Patent is limited to coverage of a "dedicated hardware" system; that is, a "single use" system that does nothing other than create video art. (Def.'s Mem. Supp. Summ. J. at 4, 14.) In contrast, argues Nintendo, the accused system is a programmable multi-use computer system that allows for the use of many different game cartridges, such as Mario Paint, and therefore is not covered by the patent-in-suit.

In the specification of the '335 Patent, Gussin distinguished his invention from the prior art. (*See* '335 Patent, col. 1, lines 16-61.) He stated that the prior art disclosed "two general groups of electronic systems for drawing on a video monitor." (Id. at 16-18.) In the first group, "a video monitor ... is used with a computer such as a personal computer and computer software." (Id. at 18-21.) The second group of such systems "requires a computer such as a personal computer, computer software, and a special video monitor responsive to an external stimuli." (Id. at 37-39.)

Nintendo contends that the SNES system is a computer system and was thus specifically distinguished from Gussin's invention. In deposition, Kenji Imai, Nintendo's Rule 30(b)(6) designee, testified that the SNES "is a computer [and] depending on the kind of software you use with it, the operations can be simple ... or complex." (Norgaard Decl., Ex. A at 4.) Additionally, Nintendo's consultant Stephen A. Ward testified in deposition that the SNES "is a computer system that is, as I said, specialized by playing games." (Id. Ex. 8 at 49.)

In response, Plaintiff argues that "Nintendo's 'expert' Dr. Ward admitted that the MARIO PAINT combination is a 'low-end' hardware/firmware device, i.e. a console/cartridge device, and not a computer as did Nintendo's spokesman Imai." (Pl.'s Opp'n Mtn. Summ. J. at 11 (citations omitted).) In light of the deposition testimony cited immediately *supra,* Plaintiff's contention that Dr. Ward and Mr. Imai "admitted" the SNES is not a computer is simply not accurate. Plaintiff also cites deposition testimony in which Hard and Imai state that aspects of the Mario Paint cartridge could be considered "firmware," but Plaintiff does not offer sufficient evidence to controvert Defendant's assertion that the SNES is a computer. Upon consideration of the entirety of the evidence proffered by the parties, the Court concludes that there is no genuine underlying issue of material fact as to this matter. *See Johnston,* 885 P.2d at 1579.

Nintendo also contends that the prosecution history shows that Gussin limited his claims to a dedicated, single-purpose device after his patent application was rejected based on the inventions taught in prior patents.

By Examiner's Action mailed June 10, 1987, the Patent and Trademark Office (PTO) rejected Gussin's patent application FN4 for claims l through 16 "as being unpatentable over Burson [FN5] in view of

Tsunehiro et al.[[FN6]]" (Sender Decl., Ex. 3 at 58.) Therein, Gussin responded to this rejection with an application Amendment, received December 2, 1987. (*Id.,* Ex. 5 at 89.) Gussin distinguished Burson by stating that "[w]hereas Burson appears to have joysticks for controlling the position and color of a cursor, that effect depends on the particular game cartridge used." (*Id.* at 92.). Gussin also wrote that "[t]he effect of movement of (the) joystick ... depends on the cartridge inserted into the main module." (*Id.*) Thus, the Court finds as a matter of law that Gussin, in order to achieve patentability, specifically limited his invention to single-use hardware by distinguishing Burson, which was a multi-use system in which the effect of its joysticks depended upon the cartridge used.

FN4. Serial no. 925,653.

FN5. U.S. Patent no. 4,180,805, issued December 25, 1979.

FN6. U.S. Patent no. 4,642,625, issued February 10, 1987.

The SNES/Mario Paint combination is analogous to Burson in that it consists of a main programmable console and a software cartridge. (*See* Ward Decl. para.para. 18, 19 (" *Mario Paint* is only one of hundreds of cartridges that can be used with SNES."); Norgaard Dec l., Ex. A at 4, Ex. B at 49.)

In response, Gussin states that "Dr. Ward admitted that Gussin's patent attorneys *never* amended Gussin's claims 1 and 2 to exclude console/cartridge systems," (Pl.'s Opp'n Mtn. Summ. J. at 11), and "that the PTO never rejected claim 2 for any reason," (id.).

Gussin's argument is unavailing. First, by disavowing cartridge-based systems as taught in Burson following rejection of his initial patent application, Gussin excluded video art systems consisting of a console and multiple cartridges from coverage by the '335 Patent. "[T]he prosecution history ... limits the interpretation of claims so as to exclude any interpretation that may have been disclaimed or disavowed during prosecution in order to obtain claim allowance." Jonsson v. Stanley Works, 903 F.2d 812, 817 (Fed.Cir.1990). Second, the fact that Gussin never amended the claims to specifically exclude cartridge-based systems is of no moment since "for the purposes of literal infringement, the prosecution history is used to interpret the claims in a manner consistent with [the inventor's representations during prosecution." Advanced Cardiovascular Sys. Inc. v. C.R. Bard Inc., 26 U.S.P.Q.2d 1304, 1307 n. 5 (N.D.Cal.1992); *see also* Texas Instruments v. United States Int'l Trade Comm'n, 988 F.2d 1165, 1174-75 ("Amendment of a claim in light of a prior art reference, however, is not the *sine qua non* ....").

In conclusion as to the dedicated hardware limitations, the accused device does not infringe on the '335 Patent since the SNES/Mario Paint combination is both a multi-use, cartridge-based system and a computer as contrasted to the single-use, dedicated system invented by Gussin. Plaintiff's arguments to the contrary are contradicted by the plain language of the patent specification or by the prosecution history of the patent. viewed objectively from the vantage point of a what a competitor would reasonably believe, Gussin limited his claims as described above and should not now be able to obtain protection for relinquished subject matter. Haynes, 8 F.3d at 1577-78.

Gussin's self-serving and conclusory declarations to the contrary do not raise *genuine* issues of fact FN7

sufficient to avert summary judgment. Johnston, 885 F.2d at 1580 ("Conflicting opinions on the meaning of a term which are merely conclusory do not create [sufficient] evidentiary conflict."); Senmed, 888 F.2d at 819 n. 8 (where words are given their ordinary meaning in the specification and prosecution history, the inventor's "self-serving, *post hoc* opinion testimony" is of little if any significance).

FN7. "To create a genuine issue of fact, the nonmovant must do more than present *some* evidence on an issue it asserts to be disputed ." Avia Group, 853 F.2d at 1560. "Instead, the nonmovant's evidence must present a question of material fact, which requires submission to a jury." Jonsson, 903 F.2d at 816 (emphasis added).

At the hearing on this motion, Plaintiff's counsel insisted that the Court was engaging in fact finding, which is clearly improper on summary judgment, by "swallowing" the Ward declaration and ignoring the declarations proffered by Plaintiff. The Court disagrees. Rather, the Court has determined that the Gussin and Brunton declarations do not raise genuine issues of fact since they are wholly conclusory and contrary to the prosecution history, which the Court must rely on to interpret the patent-in-suit. As the Johnston court stated, " '[g]eneral assertions of fact issues, general denials, and conclusory statements are insufficient to shoulder the non-movent's burden.' " 885 F.2d at 1578 (quoting Chemical Eng'g v. Essef Indus., Inc., 795 F.2d 1565, 1571 (Fed.Cir.1986)). Additionally, and based on the same reasoning, the Court rejects the argument that the Gussin declaration was discounted simply because it was made by the inventor and patentee.

The Court finds that claims 1 and 2 of the '335 Patent, properly construed based on the literal claim and specification language as well as prosecution history, do not read on the accused device for the separate reasons described above. Thus, Nintendo's motion for summary judgment of noninfringement must be GRANTED on this second separate ground.

b. PIXEL MEMORY

Nintendo also contends that "Gussin limited his invention to a device containing a 'pixel memory' that stores actual color data for each element of the image displayed on the television screen." (Def.'s Mem. Supp. Summ. J. at 4.) Nintendo argues that the accused combination does not infringe since it does not utilize a similar pixel memory configuration.

The Gussin invention teaches a pixel FN8 memory system, in which "[i]nformation as to a picture to be displayed on [the] video monitor ... is represented electronically by data words stored in the pixel memory ... at addresses corresponding to the address of the pixels of the video monitor." ('335 Patent, col. 6, lines 16-20.) Thus, the ' 335 Patent's pixel memory storage locations store actual color data for each corresponding pixel of an image. (Id., lines 12-36.)

FN8. The image on a television screen is formed by an array of dots or picture elements ("pixels" for short). When activated, individual pixels emit visible light of a particular color and intensity. When all the pixels of a television screen are viewed together, a visible color image appears on the screen. (Ward Decl. para. 11.)

The literal language of claims 1 [FN9] and 2 [FN10] of the ' 335 Patent requires that the invention use a pixel memory. ('335 Patent, col. 9, lines 49-58; B1 ' 335 Patent, col. 2, lines 23-35.)

FN9. In pertinent part, claim 1 requires:
A video art electronic system for drawing an coloring on a conventional color television video monitor ... comprising:
....
a pixel memory comprising a random access memory (RAM) having digital memory addresses corresponding to the pixels and adapted to be read in correspondence with the conventional horizontal and vertical scanning of the video monitor;

first connecting means operative when the draw switch is in its first position to connect said first and second digital signals to said pixel memory *so that the color and position of the cursor on the video monitor are written into said pixel memory ....*

('335 Patent, col. 9, lines 34-37, 49-58 (emphasis added).)
FN10. Claim 2, as amended after reexamination, requires:
A video art electronics system for drawing and coloring on a conventional color television video monitor....
....
said system further comprising:

....
a *pixel memory comprising a random access memory,*

and means operative in said first mode *to store the commanded color of the cursor in said pixel memory ....*

(Patent B1 4,782,335, issued on reexamination September 21, 1993, col. 1, lines 20-22, col. 2, lines 17, 23-25 (emphasis altered).)
Additionally, the prosecution history discloses that Gussin distinguished his invention over the prior art on the basis of the pixel memory. In the Amendment filed by Gussin after rejection of his initial patent application, described *supra,* he further distinguished Burson by stating that "[a]ll of [my] claims now pending in the application include ... a pixel memory ... for retaining the image drawn that can be scanned so as to produce modulation signals in a television set. Such structure is not found in the cited art." (Sender Decl., Ex. 5 at 93.)

Moreover, Gussin further narrowed his claims as a result of a reexamination proceeding prompted by discovery of additional relevant prior art. In the PTO's Order Granting Request for Reexamination, mailed November 20, 1992, the examiner indicated that reexamination of the '335 Patent had been granted on the basis of anticipation and obviousness by the prior art of Hill,FN11 and others. (Sender Decl., Ex. 8 at 102-03.) In his Patentee's Response to Office Action in Reexamination, received February 2, 1993, Gussin distinguished the ' 335 Patent's pixel memory from the Hill color palette system. Gussin stated,

FN11. United States Patent no. 4,200,867. The examiner noted specifically that claim 2 of the '335 Patent was fully anticipated by Hill and that claim 1 was obvious by Hill and others. (Sender Decl., Ex. 8 at 103.) Claim 14 and all dependent claims (3-13 and 15-16) were, of course, also found to be obvious by Hill and others. (Id.)

In [my] claim 1, the pixel memory receives and stores digital signals representing the actual color of the cursor. In Mr, Hill's color palette systems, the pixel memory does not receive or store a signal representing the actual color of the cursor. Instead, Mr. Hill's pixel memory receives, and stores a color pointer, namely a signal representing the address of a color in the separate color memory of Hill's color palette systems. (Sender Decl., Ex. 14 at 201-02.) Based, inter alia, on Gussin's distinction of his pixel memory, the PTO confirmed claims 1 and 3-16, as noted in the Office Action in Reexamination, mailed March 10, 1993. (Id., Ex. 15 at 211.) Therein, the examiner stated that the referenced claims were allowed over the prior art since none of the references, Hill or [others], teach a "random access memory" wherein the " *color* and position of the cursor on the video monitor are written into said *pixel memory*." Hill does not store color data into the pixel memory, rather he uses the pixel memory to address a second memory which acts as the color palette.

(Id. at 222 (quoting '335 patent) (citation omitted).) The examiner's reliance on the pixel memory distinction was confirmed in the PTO's Supplemental Notice of Intent to Issue Reexamination Certificate, mailed July 26, 1993. (Id., Ex. 20, at 265.) As noted in the Reexamination Interview Summary Form, filed April 1, 1993, claim 2 was also amended FN12 after rejection upon reexamination to require the described pixel memory system. (Id., Ex. 17 at 237.)
FN12. *See supra* note 10 for pertinent text of amended claim 2.

Based on these limitations, Nintendo argues that the '335 Patent does not read on the accused combination. (Def.'s Mem. Supp. Summ. J. at 20.) The SNES, when used with Mario Paint, has no pixel memory that stores actual color data for each pixel of the image. Ward Decl. para. 23. Rather, the SNES stores, in a first memory, information (the so called pointers or addresses) used to select or locate actual color information in a separate, second color-palette memory. (Id.)

In response, Gussin argues that neither the patent's claims nor specification require the pixel memory to store actual color data. (Pl.'s Opp'n Mtn. Summ. J. at 12.) As to all claims other than claim 2, this is erroneous in light of Gussin's response to the order of reexamination and the examiner's clearly stated reasons for confirming patentability, both of which are quoted immediately *supra*. As to claim 2, the plain language and history of the agreed-upon amendment forecloses Gussin's argument.

Gussin also apparently contends, based on the declaration of attorney Brunton, that the PTO would have required additional limiting language to be included in the claims if the claims were to be limited as Nintendo suggests. (Pl.'s Opp'n Mtn. Summ. J. at 12-14; Brunton Decl. para. 12.) This is of no moment since the prosecution history, as set forth *supra,* clearly shows that Gussin by his own statements limited his claims to the single, pixel-memory system, as described *supra*. Again, it is clear that the public is entitled to rely on a patentee's statements to the PTO in determining the scope of claim coverage. Haynes, 8 F.3d at 1577-78; Jonsson, 903 F.2d at 817. Again, that Gussin never specifically amended claims 1 and 3-16 after his disavowments is of no moment. Texas Instruments, 988 F.2d at 1174-75; Advanced cardiovascular, 26 U.S.P.Q.2d at 1307 n. 5.

Based on an objective view of the clear language of the '335 Patent (including the amendment to claim 2) and of Gussin's statements to the PTO regarding exclusion of two-memory systems as taught in the prior art, the Court construes the patent-in-suit to be clearly limited to the pixel memory configuration described above. See Haynes, 8 F.3d at 1577-78; Jonsson, 903 F.2d at 817. As it appears beyond genuine controversy that the SNES/Mario Paint combination does in fact utilize a two-memory configuration with pointers or addresses and not color data stored in the pixel memory, the accused device does not infringe on the '335 Patent. Gussin's self-serving and conclusory declarations, which proffer interpretations that would alter the clear public record, do not raise a genuine issue of fact. Senmed, 888 F.2d at 819 n. 8; Johnston, 885 F.2d at 1580.

The Court therefore finds that claims 1 and 2 of the '335 Patent, properly construed based on the literal claim and specification language as well as the prosecution history, do not read on the accused device for the additional reasons described above. Thus, Nintendo's motion for summary judgment of noninfringement must be GRANTED on this third separate ground.

c. DEDICATED JOYSTICKS

Nintendo makes a similar argument with respect to the joystick configuration of Gussin's invention. Nintendo contends that the '335 Patent requires the presence of two joysticks, operating in "real time," to control the video art; it then argues that this configuration is absent from the accused combination. (Def.'s Hem. Supp. Summ. J. at 20-25.)

(i) CLAIM ONE

The literal language of claim 1 of the '335 Patent requires two separate joysticks,FN13 one to control the position of the cursor on the video screen, and the other to control the color of the cursor. ('335 Patent, col. 9, lines 42-48.)

FN13. Claim 1 states:

A video art electronic system for drawing and coloring on a conventional color television monitor ... comprising:
....
means *including a first joystick* to produce first digital signals representing the "X" and "Y" coordinates of a pixel position of a cursor on the video monitors;

means *including a second joystick* to produce second digital signals representing the color of the cursor on the video monitor ....

('335 Patent, col. 9, lines 34-37, 42-48 (emphasis added).)
The prosecution history reveals that claim 1 was not so limited in the original patent application. (*See* Sender Decl., Ex. 2 at 51.) This application merely specified "means to produce" the two sets of digital signals described in the claim. (Id.) The February 25, 1988 Examiner's Amendment, which was issued in response to Gussin's application, indicates that the "means to produce" language was specifically rejected

and amended to read "a first joystick" and "a second joystick." (Id., Ex. 6 at 97.)

Additionally, during the reexamination of the '335 Patent in light of Hill, as described *supra,* Gussin clearly distinguished his invention by stating in his Patentee's Response that "Mr. Hill elected not to use a joystick to mix, adjust, store or select colors.... Thus, Mr. Hill's '867 patent points away from Gussin's claims." (Id., Ex. 14 at 209.) Gussin thus distinguished Hill by shoving that Hill used only a single joystick (to control cursor mover.ent) whereas Gussin required two. (*See* id.)

Thus, the literal claim language of the '335 Patent as well as the prosecution history indicate that the Gussin invention requires two joysticks under claim 1. The Nintendo combination, in contrast, employs a single mouse in the place of the two joysticks. (Ward Decl. para. 20.)

Gussin argues, based on his own declaration, that claim 1 does not "state that the joysticks ... must be 'single function', 'separate', 'independent' or dedicated'." (Pl.'s Opp'n Mtn. Summ. J. at 14.) This ignores and contradicts the claim language and prosecution history cited immediately *supra*. Gussin also argues that he distinguished the prior art by pointing out both that the '335 invention, unlike Burson, used a "draw/no draw" switch and that Gussin's design, unlike Hill's, had "pre-mixed colors." (Pl.'s Opp'n Mtn. Summ. J. at 14.) Assuming, arguendo, that Gussin's contentions are accurately supported by the record, they do not change the fact that Gussin *also* distinguished the prior art based on the joystick configuration. Gussin cannot reclaim that which he disavowed, and *all* distinctions (not just the ones he believes to be important) limit the coverage of his patent. *Haynes,* 8 P.3d at 1577; Senmed, 888 F.2d at 819 n. 8.

(ii) CLAIM TWO

The literal language of claim 2 of the '335 Patent is not specifically limited to two joysticks; it does, however, requires a "first and second member positionably movable by an operator [sic], the drawing and coloring being by way of real time positional and color correspondence of a cursor." ('335 Patent, col. 10, lines 4-7.) "Real time" is defined by the patentee as "drawing and coloring which occur essentially instantaneously with selected commands corresponding thereto." (Id., col. 1, lines 33-35.) Gussin distinguished his invention by stating that the prior art did not allow real time drawing. (Id., lines 31-32.)

During reexamination of the '335 Patent in light of Hill, discussed *supra*. Gussin again distinguished his invention's use of a moveable member for real-time command of colors from a system in which color selection is made from a color palette. (Sender Decl ., Ex. 14 at 190; id., Ex, 18 at 243.) In Gussin's invention, the position of the second moveable member directly corresponds to (or "commands") a fixed color. (Id., Ex. 14 at 190; id., Ex. 18 at 243.)

Thus, based on the claim and specification language, as well as the prosecution history, the Court construes claim 2 of the '335 patent to require two moveable members that allow for realtime drawing and color command based on the position of the second moveable member. Nintendo points out that, like Hill, the SNES/Mario Paint combination uses a color palette system that does not "command" colors based on the position of a second moveable member. (Ward Decl. para.para. 20-22.)

In response, Gussin argues that the "movable members" specified in claim 2 are not limited to joysticks. (Pl.'s Opp'n Mtn. Summ. J. at 15.) This is unavailing since Nintendo has not made that argument; rather, Nintendo has show that claim 2 covers a system that employs two movable members with a specified relationship (real time drawing and color command based on the position of the second member). Nintendo

has also shown that, even if the SNES mouse is viewed as two movable members, the *position* of the second member *does not* command a fixed color. (Ward Decl. para.para. 20-22.)

In conclusion as to the combined dedicated-joystick limitations, the accused device does not infringe claim 1 since it lacks the two joysticks specified therein and as made clear by the prosecution history. Additionally, the Nintendo product does not infringe claim 2 since it does not employ two moveable members with the interrelationship as defined by the patent and the prosecution history.

Gussin again has proffered an interpretation that "would alter the undisputed public record," Senmed, 888 F.2d at 819 n. 8, and has attempted to disavow his prior limitations and relinquishments, Haynes, 8 F.3d at 1577, Again, self-serving and conclusory declarations do not create genuine issues of fact. Senmed, 888 F .2d at 819 n. 8; Johnston, 885 F.2d at 1580.

Therefore, the Court further finds that claims 1 and 2 of the '335 Patent, properly construed based on the literal claim and specification language and the prosecution history, do not read on the accused device for the additional reasons described above. Thus, Nintendo's motion for summary judgment of noninfringement roust be GRANTED on this fourth separate ground.

d. DEDICATED DRAW SWITCH

Lastly, Nintendo argues that claims 1 and 2 of Gussin's patent require a dedicated "draw switch," which is absent in the SNES/Mario Paint system. (Def,' s Mem. Supp. Summ. J. at 26.)

The literal language of claims 1 FN14 and 2 FN15 of the ' 335 Patent require a draw switch that can be positioned for drawing or not drawing. ('335 Patent, col. 9, lines 38-41, col. 10, lines 30-34.) When "draw" is selected on this switch, the cursor draws lines on the monitor; when "not draw" is selected, the cursor moves over the screen without leaving a line. (Ward Decl. para. 10.)

FN14. Claim 1 provides:

A video art electronic system for drawing and coloring on a conventional color television video monitor ... comprising:
a *draw switch* having a *first position* for drawing and coloring on the video monitor and a *second position* for not drawing and coloring on the video monitor....

('335 Patent, col. 9, lines 34-41 (emphasis added).)
FN15. Claim 2 provides:

A video art electronics system for drawing and coloring on a conventional color television video monitor ...

....
said system further comprising:

a *draw switch* having a *first position* for invoking said first mode of drawing and coloring on the video monitor and a *second position* for invoking said second mode or not drawing and coloring on the video monitor....

('335 Patent, col. 10, lines 1-3, 29-34 (emphasis added).)
The prosecution history again shows that Gussin distinguished his invention from the prior art on the basis of this switch. In his Amendment, received by the PTO December 2, 1987, discussed *supra,* Gussin remarked that all of his claims "include a switch that determines whether to draw or not to draw" and that "[s]uch structure is not found in the [prior] art." (Sender Decl., Ex. 5 at 93.)

The Court thus construes claims 1 and 2 to require the described two-position draw switch. Nintendo contends that, based on such a construction, the '335 Patent does not cover the accused device since such a switch is absent. (Def.'s Mem. Supp. Summ. J. at 27.) With the Nintendo system, the draw/no draw selection is made with the mouse, which Nintendo states is a multifunction (as apposed to two-position) control unit that also allows for selection of colors, shapes, and the like. (Ward Decl. para.para. 20-22.)

In a terse response to Nintendo's argument, Gussin contends that his patent does not require that the draw switch be "separate" or "dedicated." (Pl.'s Opp'n Mtn. Summ. J. at 15-16.) "Dedicated" or not, an objective view of the claim the prosecution history reveals that a two-position switch is required ("a draw switch *having* a first position ... *and* a second position"). Gussin also contends that Nintendo's mouse configuration embodies the required switch. (Id. at 19.) Again, since Nintendo's mouse does not have a "first position" and a "second position," it is not covered by the '335 Patent.

Gussin's declarations, which proffer interpretations that would alter the clear public record, again do not raise a genuine issue of fact. See Haynes, 8 F.3d at 1577-78; Jonsson, 903 F.2d at 817; Senmed, 888 F.2d at 819 n. 8; Johnston, 885 F.2d at 1580.

The Court further finds that claims 1 and 2 of the '335 Patent, properly construed based on their literal language and prosecution history, do no read on the accused device for the additional reasons described above. Thus, Nintendo's notion for summary judgment for noninfringement must be GRANTED on this fifth separate ground.

2. DOCTRINE OF EQUIVALENTS

Under the doctrine of equivalents, "infringement may be found if an accused device [1] performs substantially the sane function [2] in substantially the same way [3] to achieve substantially the same result." London v. Carson Pirie Scott & Co., 946 F.2d 1534, 1538 (Ped.Cir.1991) (citing Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608 (1950); Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (Fed.Cir.1987), *cert. denied*. 485 U.S. 961 (1988)). The doctrine is equitable in nature and involves balancing the competing policies of, on one hand, requiring patent claims to be particular and distinct so that competitors can avoid infringement, and on the other hand, protecting patentees from competitors who appropriate the essence of an invention while barely avoiding the literal language of the claim. *Id*. (citing *Laitram Corp. v. Cambridge Wire Cloth Co.,* 803 F.2d 855, 856-57 (Fed.Cir.1988), *cert. denied,* 490 U.S. 1068 (1989)).

It must be stressed that "[a]pplication of the doctrine of equivalents is the exception, however, not the rule."

Id. Overzealous application of the doctrine is problematic and must be avoided as, otherwise, "[c]ompetitors will never know whether their actions infringe a granted patent." *Id.; see also* International Visual Corp. v. Crown Metal Mfg. Co., 991 F.2d 768, 773-74 (Fed.Cir.1993) (Lourie, J., concurring) (describing the doctrine as "much troubled" and counseling against its mechanical application).

Although the three-step formula for application of the doctrine of equivalents appears straightforward, it "does not mean that one can ignore claim limitations." FN16 Pennwalt, 833 F.2d at 935. Thus, a patent owner may not " 'under the guise of applying the doctrine of equivalents, erase a plethora of meaningful structural and functional limitations of the claim on which the public is entitled to rely in avoiding infringement.' " *Id*. (quoting Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1532-33 (Fed.Cir.1987)). And, as with literal infringement, " '[i]t is ... well settled that each element of a claim is material and essential, and that in order for a court to find infringement, the plaintiff must show the presence of ... the substantial equivalent [of every element] in the accused device.' " *Id*. (first omission in original) (internal quotation marks omitted) (quoting Perkin-Elmer, 822 F.2d at 1532-33).

FN16. *See supra* note 3.

Lastly, to meet the requirement of being a substantial equivalent, as is required, " 'the element substituted in the accused device for the element set forth in the claim must not be such as would *substantially change* the way in which the claimed invention is performed.' " *Id*. (emphasis added) (quoting Perkin-Elmer, 822 F.2d at 1532-33).

Gussin argues that the doctrine of equivalents should prevent Nintendo from prevailing on the instant motion. First, Gussin contends that determination of equivalence is "entirely factual, and is therefore for the jury, not the Court, for [sic] decide." (Pl.'s Opp'n Mtn. Summ. J. at 21.) As support, Plaintiff cites Ninth Circuit Model Jury Instruction 16.02.04, which merely sets forth the three basic *Graver* elements cited above. (*Id*.) This, of course, is nonsense. when there is no *genuine issue* of fact, the Court is perfectly capable of deciding equivalence on summary judgment. *E.g.,* London, 946 F.2d at 1541 ("[B]ecause the evidence presented showed that [the accused product] did not meet the limitations in the asserted claims, literally or *equivalently,* [Defendant] was properly entitled to summary judgment as a matter of law." (emphasis added)); Johnston. 885 F.2d at 1578 (affirming district court's finding, on summary judgment, of no literal or equivalent infringement).

Next, Gussin cites his own declaration as evidence of triable issues regarding equivalence. (Pl.'s Opp'n Mtn. Summ. J. at 21-25.) He runs through his familiar litany of arguments: the accused combination is not a computer and is thus the same as his invention, Nintendo's two-stage memory is the same as his pixel memory, the joysticks perform the same function as a mouse, and the mouse performs the same function as the draw switch. For at least the following reasons, these arguments are equally flawed under equivalence analysis.

First, Gussin consistently interprets the equivalence criteria far too broadly. He contends, for example, that the accused product infringes since " '[t]he result is the same as with my claimed systems, the production of a user's drawing and painting on the screen of a color TV set.' " (Pl.'s Opp'n Mtn, Summ. J. at 21 (quoting Gussin Decl. para. 20).) By this reasoning, Gussin ignores all of the prior art (Hill, Burson, Tsunehiro) discussed above that also yielded the result of drawing and painting on a television screen. Additionally, and as discussed above, Gussin's; self-serving and conclusory declaration does not create a genuine factual

issue.

Second, in the guise of applying the doctrine of equivalents, Gussin ignores the plethora of significant claim limitations and distinctions, set forth *supra,* that estop him from claiming the expansive coverage and equivalency he asserts. His conclusory declaration also fails to set forth any genuine facts that, *with these claim limitations in mind,* could show substantial similarity to the protected claims. *See* Lear Siegler, Inc. v. Sealy Mattress Co., 873 F.2d 1422, 1425 (Fed.Cir.1989) (stating that, to raise a genuine issue of fact, the patent owner must introduce evidence of substantial identity of function, means, *and* result). Gussin's mere conclusions, for example, that a joystick is the same as a mouse and that there is a dispute as to words such as "computer," do not create material issues. *See* Senmed, 888 F.2d at 819 n. 8 (where words are given their ordinary meaning in the specification and prosecution history, the inventor's "self-serving, *post hoc* opinion testimony" is of little if any significance).

Lastly, Gussin apparently contends that since Nintendo conceded the validity of the patent for purposes of the instant motion, file wrapper estoppel-for some unexplained reason-does not apply. Rather, it is clear that "[u]nmistakeable assertions made ... to the [PTO] in support of patentability, whether or not required to secure allowance of the claim, also may operate to preclude the patentee from asserting equivalency between a limitation of the claim and a substituted structure or process step." Texas Instruments, 988 F.2d at 1174.

In short, Gussin's arguments are no more availing with respect to the doctrine of equivalents than with respect to literal infringement, and he has presented no evidence that would favor applying this exceptional, equitable doctrine. Gussin simply may not claim equivalency with subject matter he specifically relinquished during prosecution. Additionally, the Court finds that the differences between the Nintendo configuration and Gussin's invention, as set forth *supra,* are "not insubstantial," thus counseling against equivalency.

Based on the foregoing, the Court finds that this is not a proper case for application of the doctrine of equivalents and reiterates its findings, detailed *supra,* that no claims of the '335 Patent have been infringed.

C. DISPOSABLE ARGUMENTS

Gussin's makes two disposable arguments, of no avail, that will be touched on only briefly.

1. DR. WARD'S BIAS

Gussin frequently and throughout his opposition makes much of the fact that "Ward [is] a paid Nintendo 'expert' who has received over $380,000 from Nintendo over the past 5 years, and currently is under contract to Nintendo at a minimum monthly retainer of $8,000/month." (Pl.'s Opp'n Mtn. Summ. J. at 2, *see, e.g.,* id. at 12; Pl.'s Statement of Genuine Issues para.para. 2, 7.) Plaintiff urges the Court to disregard the Ward declaration because of this bias.

Bias alone does not create a genuine factual dispute, nor does it otherwise entitle Plaintiff to a jury trial. National Union Fire Ins. Co. v. Argonaut Ins. Co., 701 F.2d 95, 97 (9th cir.1983). In *National,* the "true thrust" of nonmovant's opposition was that the evidence submitted by the movant came from employees of the movant "whose interests [were] identical and biased." *Id.* In discarding this argument, the court stated that "neither a desire to cross-examine an affiant nor an unspecified hope of undermining his or her credibility suffices to avert summary judgment." *Id.*

This Court also notes that, by Plaintiff's reasoning, his own declaration would have to be disregarded on the same grounds: Who could be more self-interested in the outcome of patent litigation than the patent's owner/inventor?

2. GENERIC "ISSUE OF FACT" ARGUMENT

Gussin also argues that factual disputes over claim interpretation preclude summary judgment. Of course, genuine material factual disputes *always* preclude summary judgment; what is missing here is a genuine factual dispute. As noted above, "claim interpretation may be resolved as an issue of law by the court on summary judgment taking into account the specification, prosecution history or other evidence." Johnston, 885 F.2d at 1580.

Gussin contends that when "technical terms" are in dispute, a genuine issue of fact is presented. The authority that he relies on, however, requires that there be a *genuine dispute* or uncertainty as to the meaning of a claim term. Gussin fails to offer evidence, aside from conclusory affidavits, of any genuine dispute or uncertainty as to any technical term here. As stated in *Johnston,* "conflicting opinions on the meaning of a term which are merely conclusory do not create [the required] evidentiary conflict." *Id.*

At the hearing on this matter, Plaintiff's counsel repeatedly invoked the argument that this case raised the specter of a "technical dispute" and that, as such, summary judgment was inappropriate under Palumbo v. Don-Joy Co., 762 F.2d 969 (Fed.Cir.1985). Again, the Court disagrees. In short, the Court views the case at bench to be on all fours with *Johnston,* and is persuaded by the Federal Circuit's reasoning therein.

First, *Palumbo* clearly does not: even attempt to establish a blanket rule that would proscribe summary judgment when a "technical" matter is being adjudicated. Were that the case, district courts would be hamstrung in applying Rule 56 in virtually all patent litigation.

Second, later opinions from the Federal Circuit have disapproved of *Palumbo* and made it clear that "any broad statement in our precedent which could be read to say that a disagreement over the meaning of a term in a claim *ipso facto* raises an issue of fact is not the law of this circuit and may not be invoked or relied on as precedent." Johnston. 885 F.2d at 1580 (discussing Palumbo, 762 F.2d at 974; *Perini America, Inc. v. Paper Converting Machine Co.,* 882 F.2d 581, 584 (Fed.Cir.1987)).

Thus, a mere dispute over the meaning of a term does not itself create an issue of fact. This is true even where the meaning cannot be determined without resort to the specification, the prosecution history or other extrinsic evidence provided upon consideration of the entirety of such evidence the court concludes that there is no genuine underlying issue of material fact.

Id. at 1579. Gussin therefore may not avert summary judgment by simply submitting a declaration in which he offers a contrary opinion as to the meaning of certain terms. Rather, there must be a genuine evidentiary conflict as to that term. *Id.* at 1579. For the reasons set forth repeatedly above, the Court has found that Plaintiff's declarations fail to raise the requisite genuine evidentiary conflict. Absent a genuine evidentiary dispute, " 'claim interpretation in light of [insufficient] evidence remains a question of law.' " *Id.* (quoting Howes v. Medical Components, Inc., 814 F.2d 638, 643 (Fed.Cir.1987)).

Lastly, *Palumbo* is clearly distinguishable on its facts from the matter sub judice. In *Palumbo,* summary

judgment was found to be inappropriate in part since the declaration of the inventor was found not to be conclusory. 762 F.2d at 976. Here, the Court has found exactly to the contrary. Additionally, the inventor's declaration in *Palumbo* was found to be a reasonable interpretation of the claim. *Id*. Here, the Court has determined that the interpretation proffered by Gussin is unreasonable since it is contrary to both the plain language of the patent claims and specification and since it conflicts with the clear prosecution history.

D. MISCELLANEOUS MATTERS

To the limited extent that paragraph nine of Plaintiff's Statement of Genuine Issues, etc.,FN17 could be construed as a declaration requesting additional time for discovery under Federal Rule of Civil Procedure 56(f), that request is hereby DENIED for failure to comply with the procedural requirements of the rule and for failure to show any substantive justification for a continuance.

FN17. The referenced passage reads:

Shouldn't the court refuse to give any weight to Mr. Sender's declaration of to the videotape that Nintendo filed as part of its motion because Nintendo has refused to permit Plaintiff to depose either Mr. Sender, (one of Nintendo's lawyers), or the person(s) who created the videotape?

(Pl.'s Statement of Genuine Issues, etc. para. 9.)

To the limited extent that any of the assertions in Plaintiff's Opposition to Defendant's Motion, etc., could be construed as a motion to strike, or evidentiary objections to, the Declaration of Stephen A. Ward or other declarations, they are hereby DENIED and OVERRULED, respectively.

Based on the Court's analysis and findings of noninfringement, Nintendo's evidentiary objections to the Declarations of Edward L. Gussin and James E. Brunton are hereby deemed MOOT.

V. CONCLUSION

Based on the foregoing, the Court ORDERS that Defendant Nintendo of America, Inc.'s Motion for Summary Judgment on Noninfringement be GRANTED.

SO ORDERED.

C.D.Cal.,1994.
Gussin v. Nintendo of America Inc.

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