United States District Court,
N.D. Illinois, Eastern Division.

David H. SITRICK,
Plaintiff.
v.
NINTENDO OF AMERICA, INC,
Defendant.

March 12, 1997.

MEMORANDUM OPINION AND ORDER

ANN CLAIRE WILLIAMS**, District Judge.**

On December 11, 1995, Plaintiff David H. Sitrick ("Sitrick") filed an amended complaint against Defendant Nintendo of America Inc. ("Nintendo"). Sitrick alleges that Nintendo infringed numerous claims within United States Patent No. 4,572,509 ("the '509 patent"), issued to Sitrick on February 25, 1986. Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Nintendo moves this court for summary judgment on some of these claims. FN1 For reasons set forth below, the court denies the motion.

FN1. Sitrick alleges that Nintendo "has for a long time past been and still is infringing claims 1, 2, 8, 24, 25, 32, 33, 35, and 37-46 of the ' 509 patent." (Sitrick Amended Complaint at 2.) However, only claims 40 through 46 are the subject of Nintendo's motion for summary judgment.

Background

In February 1986, the United States Patent and Trademark Office issued the ' 509 patent to Sitrick. (Blank Dec., Ex. 1.) Issued with 47 claims, the ' 509 patent is entitled "Video Game Network" and describes "a distributed game system comprising a plurality of video game apparatus, selectively interlinkable to form a homogeneous single identity game system." (Nintendo 12(M) para. 1; Sitrick 12(N) para. 1.) FN2 In addition, the ' 509 patent describes a system that allows interactive or stand-alone play for the same game. (Sitrick 12(N) para. 1.)

FN2. Throughout this Memorandum Opinion, the term "12(M)" refers to the statement of material facts submitted by the movant pursuant to Rule 12(M)(3) of the Local Rules of this court. The term "12(N)" refers to a response to the movant's statement submitted by the non-movant pursuant to Rule 12(N)(3) of the Local Rules of this court.

Written in a "means-plus-function" format, Claim 40 of the '509 patent describes a system that contains means for selectively interlinking individual game devices, means for coupling data among selected game

devices, and means for repetitively transferring data in the memory of selected game devices. (Nintendo 12(M) para. 3; Sitrick 12(N) para.para. 3, 5.) Although Claim 40 describes a structure that allows selective interlinking among devices, it does not specify how that selection should occur. (Bilbrey Dec. para. 14.) In addition, even though a "master controller" may perform some functions in Claim 40, the claim does not require that the controller be a physically separate device. (Sitrick 12(N) para.para. 6, 9.) Furthermore, claim 40 includes two additional claim limitations-the "audiovisual presentation locally generated" limitation and the "individual game apparatus" limitation. (Bilbrey Dec. para.para. 17-18.)

Nintendo's Game Boy is a handheld video game device. Users of Game Boys may play in two-player mode or four-player mode. (Nintendo 12(M) para.para. 4, 7; Sitrick 12(N) para.para. 4, 7.) In the two-player mode, users manually connect their selected Game Boys using a Game Link cable. (Sitrick 12(N), Fact 2; Nintendo Response to Fact 2.) FN3 In the four-player mode, users manually connect their selected Game Boys using a Game Link cable that connects to a Communication Adaptor. (Sitrick 12(N) Fact 3; Nintendo Response to Fact 3; Bilbrey Dec. para.para. 40-41.) The Communication Adaptor allows users to connect two, three, or four Game Boys together. (Sitrick 12(N) Fact 3; Bilbrey Dec. para.para. 40-41.) Once users connect their Game Boys, the Game Link cable and the Communication Adaptor transfer data between the interlinked Game Boys. (Bilbrey Dec. para. 44.)

FN3. "Fact" refers to Sitrick's "Statement of Additional Facts Which Require the Denial of Summary Judgment" at the end of his 12(N) statement. "Nintendo Response" refers to Nintendo's response to Sitrick's "Statement of Additional Facts Which Require the Denial of Summary Judgement." *See infra* note 4.

Summary Judgment

Nintendo moves the court to enter summary judgment on its behalf under Rule 56 of the Federal Rules of Civil Procedure. The court will render summary judgment only if the factual record shows "that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." Bratton v. Roadway Package Sys., Inc., 77 F.3d 168, 173 (7th Cir.1996) (quoting Fed.R.Civ.P. 56(c)). Summary judgment is as appropriate in a patent case as any other. Paragon Podiatry Lab., Inc. v. KLM Labs., Inc., 984 F.2d 1182, 1190 (Fed.Cir.1993). The court will not render summary judgment if "a reasonable jury could return a verdict for the nonmoving party." Sullivan v. Cox, 78 F.3d 322, 325 (7th Cir.1996) (citing Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986)). In ruling on a motion for summary judgment, the court views the facts in the light most favorable to the nonmoving party. Bratton, 77 F.3d at 171 (citation omitted); Sullivan, 78 F.3d at 325 (citation omitted).

On a motion for summary judgment, the moving party "bears the initial burden of showing that no genuine issue of material fact exists." Hudson Ins. Co. v. City of Chicago Heights, 48 F.3d 234, 237 (7th Cir.1995) (citing Celotex Corp. v. Catrett, 477 U.S. 317, 323, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986)). Then the burden shifts to the nonmoving party, which "must set forth specific facts showing that there is a genuine issue for trial." Fed.R.Civ.P. 56(e); *accord,* NLFC, Inc. v. Devcom Mid-America, Inc., 45 F.3d 231, 234 (7th Cir.1995) (citations omitted), *cert. denied,* 515 U.S. 1104, 115 S.Ct. 2249, 132 L.Ed.2d 257 (1995).

These burdens are reflected in Rule 12 of the Local General Rules for the Northern District of Illinois. Waldridge v. American Hoechst Corp., 24 F.3d 918, 921-22 (7th Cir.1994). Under Rule 12(M)(3), the moving party must submit a statement of material facts in the form of short numbered paragraphs supported

by specific references to the factual record. Under Rule 12(N)(3), the nonmoving party must submit a response to each such paragraph, including (in the case of disagreement) specific references to the factual record. FN4

FN4. Rule 12(N)(3) further instructs the nonmoving party to submit a statement of any additional facts requiring denial of summary judgment, in the form of short numbered paragraphs supported by specific references to the factual record. In turn, Rule 12(M)(3) instructs the moving party to submit a concise reply to any such additional facts, including (in the case of disagreement) specific references to the factual record.

Analysis

Nintendo claims that its Game Boy product does not infringe the '509 patent under 35 U.S.C. s. 112, either literally or under the doctrine of equivalents. In addition, Nintendo asserts that the '509 patent is invalid under 35 U.S.C. s. 102 because prior art anticipates it.

I. INFRINGEMENT

The determination of infringement involves two steps. General American Transp. Corp. v. Cryo-Trans, Inc., 93 F.3d 766, 769 (Fed.Cir.1996). First, the court construes the patent's claims to determine their scope and meaning. *Id*. (citing Carroll Touch, Inc. v. Electro Mechanical Sys., Inc., 15 F.3d 1573, 1576 (Fed.Cir.1993)). Second, the court determines whether the accused device falls within the scope of the properly construed claim. *Id*. (citing Carroll Touch, 15 F.3d at 1576). The court may find patent infringement if the accused device embodies every limitation of the claim, either literally or by an equivalent. Carroll Touch, 15 F.3d at 1576.

A. Claim Construction

As a matter of law reserved for the courts, claim construction involves ascertaining the true meaning and scope of each claim. Markman v. Westview Instruments, Inc., 517 U.S. 370, ----, 116 S.Ct. 1384, 1387, 134 L.Ed.2d 577 (1996). The court must interpret claims in light of the claim language and specification,FN5 the prosecution history, the other claims in the patent, the prior art, and the interpretation that those skilled in the art would give the claim. Carroll Touch, 15 F.3d at 1577. The court cannot read into a claim a limitation that appears in the specification but not in the claim itself. Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1566 (Fed.Cir.1992); *see also* Sjolund v. Musland, 847 F.2d 1573, 1582 (Fed.Cir.1988) ("the general principle is that limitations from specification are not to be read into the claims"). Thus, references to a preferred embodiment-such as those in the specifications or drawings-are not claim limitations. Laitram Corp. v. Cambridge Wire Cloth Co., 863 F.2d 855, 865 (Fed.Cir.1988), *cert. denied,* 490 U.S. 1068, 109 S.Ct. 2069, 104 L.Ed.2d 634 (1989).

FN5. "The specification contains a written description of the invention that must enable one of ordinary skill in the art to make and use the invention." Markman v. Westview Instruments, Inc., 52 F.3d 967, 979 (Fed.Cir.1995), *aff'd,* 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996).

Courts should give the words of the claim their ordinary and accustomed meaning, unless it appears that the inventor used them differently. ZMI Corp. v. Cardiac Resuscitator Corp., 844 F.2d 1576, 1579 (Fed.Cir.1988). The court must neither narrow the scope of a claim nor broaden it to give the patentee

something different than that he has set forth. E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed.Cir.), *cert. denied,* 488 U.S. 986, 109 S.Ct. 542, 102 L.Ed.2d 572 (1988).

A means-plus-function limitation allows a patentee to express an element in a combination claim as a means for performing a function, without reciting a structure, material, or act that performs the specified function. Valmont Indus., Inc. v. Reinke Mfg. Co., Inc., 983 F.2d 1039, 1042 (Fed.Cir.1993). In addition to reciting the means for performing a function in the patent claim, a patentee must describe some structure in the patent specifications that performs the specified function. *Id.* A patentee need not describe or predict every possible means of accomplishing that function. D.M.I., Inc. v. Deere & Co., 755 F.2d 1570, 1574 (Fed.Cir.1985).

However, the patentee is limited to the structure, material, or acts in the specifications and their equivalents. Valmont, 983 F.2d at 1042. Consequently, the court must construe functional claim language "to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. s. 112, para. 6 (1994).

In this case, Sitrick asserts that Nintendo's Game Boy product infringes Claims 40 through 46 FN6 of the ' 509 patent. Because Claim 40 is a means-plus-function claim, it need not recite a structure, material, or act that performs the described function. The first element of claim 40 describes a "distributed video game system" possessing "means for selectively interlinking a plurality of individual [devices]." The claim does not specify how the selective interlinking should occur; it only requires a structure that permits connection of the devices. Similarly, the second and third elements of claim 40, "means for coupling data among selected [devices]" and "means for repeatedly transferring data for storage in said memory of selected [devices]" do not require a device itself to select or choose which devices to connect. Although the limitations refer to selected devices, they do not specify the manner of selection. Thus, the limitations in claim 40 merely require a structure that allows selection.

FN6. Claims 41 through 46 are claims that depend from Claim 40. By definition, these dependent claims contain all of the limitations recited in Claim 40-including selectivity. 35 U.S.C. s. 112, para. 4 (1994) ("A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.").

The interpretation of "means" as merely requiring a structure that allows selective interlinking-rather than a device that selectively links with other devices-is consistent with the patent specification. For instance, the illustrations in the '509 patent do not show any device as a "selector." The ' 509 patent does not include a "selector" that chooses to interlink devices, couple data among them, or transfer data to storage within them. Instead, users accomplish the selection within the system by using "coins, tokens, or other control access means, such as on/off switches, etc." (Blank Dec., Ex. 1 at col. 5, lines 29-31.) Once a user makes a selection by activating specified apparatus, the master controller transfers data for storage in the selected devices. Because system users select which devices to interlink, the '509 patent does not require a device itself that interlinks. Rather than specify how selection should occur, the '509 patent merely describes a structure that allows selective interlinking.

Furthermore, Claim 40 does not include a reference to a separate central controller. Indeed, Claim 40 does not even contain the words "separate," "central," or "controller" in its text. Although these limitations appear in the specification, the court cannot read them into Claim 40. Although a "master controller" may perform

some functions in Claim 40, the claim does not require the controller be physically separate from the devices in the system. Thus, Claim 40 does not require a separate controller.

B. Scope of the Properly Construed Claim

In the second step in the determination of infringement, the trier of fact analyzes whether a claim covers an accused device. Baxter Healthcare Corp., v. Spectramed, Inc., 49 F.3d 1575, 1582 (Fed.Cir.), *cert. denied,* 516 U.S. 906, 116 S.Ct. 272, 133 L.Ed.2d 194 (1995). While the first step is a matter of law, the second step is a question of fact. *Id.* After the court construes the meaning of the patent claim, the trier of fact considers infringement by "comparing the accused product ... with the properly and previously construed claims in suit." C & F Packing Co., Inc. v. IBP, Inc., 916 F.Supp. 735, 743 (N.D.Ill.1995) (quoting SRI Int'l v. Matsushita Elec. Corp. of America, 775 F.2d 1107, 1121 (Fed.Cir.1985) (en banc) (citation omitted)). The trier of fact may find patent infringement if the accused device embodies every limitation of the claim, either literally or by an equivalent. Carroll Touch, Inc. v. Electro Mechanical Systems, Inc., 15 F.3d 1573, 1576 (Fed.Cir.1993).

Literal infringement exists when the accused structure contains every limitation of a claim. Baxter, 49 F.3d at 1582. Because any deviation from the claim precludes a finding of infringement, the accused device must meet each limitation of the claim exactly. Lantech Inc. v. Keip Mach. Co., 32 F.3d 542, 547 (Fed.Cir.1994). Literal infringement of a means-plus-function claim exists only when the accused device "perform[s] the identical function claimed in the patent and incorporates the structure disclosed in the specification or its substantial equivalent, as the means for performing that function." Intellicall, Inc. v. Phonometrics. Inc., 952 F.2d 1384, 1388-89 (Fed.Cir.1992) (citing 35 U.S.C. s. 112 para. 6 (1994)). If the accused device does not perform the required function exactly, or the accused structure is not equivalent to the disclosed structure, there is no literal infringement under section 112. Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 934 (Fed.Cir.1987), *cert. denied,* 485 U.S. 961, 108 S.Ct. 1226, 99 L.Ed.2d 426 (1988).

Even where an accused product does not literally infringe a patent, the doctrine of equivalents provides that an accused product may infringe a claim where the differences between the claimed product and the accused product are insubstantial. Wiener v. NEC Elec., Inc., 102 F.3d 534, 541 (Fed.Cir.1996) (citation omitted). An accused product may infringe under the doctrine of equivalents if "it performs substantially the same function in substantially the same way to obtain the same result." Southwall Technologies, Inc. v. Cardinal IG Co., 54 F.3d 1570, 1579 (Fed.Cir.1995) (quoting Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608, 70 S.Ct. 854, 94 L.Ed. 1097 (1950)). To work in substantially the same way, a process must satisfy all of the limitations of the claim, at least equivalently. Becton Dickinson and Co. v. C.R. Bard, Inc., 922 F.2d 792, 798 (Fed.Cir.1990).

While the doctrine of equivalents does not require exact correspondence between components of the accused device and components of the claimed invention, the accused device must contain every limitation or its substantial equivalent. Dolly, Inc. v. Spalding & Evenflo Cos., Inc., 16 F.3d 394, 398 (Fed.Cir.1994). To qualify as a substantial equivalent, the substituted element "must not ... substantially change the way in which the function of the claimed invention is performed." Pennwalt, 833 F.2d at 935 (quoting Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1533 (Fed.Cir.1987)).

In this case, Sitrick claims that Nintendo's Game Boy-when played in two-player or four-player mode-infringes the '509 patent. Like the devices in the '509 patent, the Game Boy selectively links to other devices in the system. Furthermore, the connected Game Boys couple and transfer data between themselves, much

like the devices in the '509 patent. Thus, a reasonable jury could find that Nintendo's Game Boy, connected to other Game Boys using a Game Link cable alone or in conjunction with the Communication Adaptor, FN7 includes all limitations of Claim 40. Further, a jury could conclude that the interconnected Game Boys perform identical selectivity and data transfer functions claimed in the ' 509 patent and incorporate a similar structure as the ' 509 patent as the means for performing the selectivity and data transfer functions. Because a reasonable jury could find that Nintendo has infringed Claims 40 through 46 of the ' 509 patent, a genuine issue exists for trial.

FN7. The "Communication Adaptor" is a device with four ports that facilitates the exchange of data between individual Game Boy units. A player connects a single Game Boy to the Communication Adaptor using a Game Link cable. (Sitrick 12(N) at 20.)

A reasonable jury could also find that Nintendo has infringed the '509 patent under the doctrine of equivalents. Like the '509 patent, a Game Boy user connects to other Game Boys using a Game Link cable and a Communication Adaptor, if necessary. Because Claim 40 addresses means for selectively interlinking devices generally, the distinction between manual and automatic structures for performing that selection is irrelevant. After the user links the Game Boys, the connected devices then transfer data between themselves. On these facts, a reasonable jury could find that Nintendo's Game Boy-in the two-player or four-player modes-perform substantially the same function in substantially the same way to obtain the same result as the '509 patent. Thus, a reasonable jury could find that Nintendo has infringed Claims 40 through 46 of the '509 patent under the doctrine of equivalents.

II. PRIOR ART

Nintendo also contends that the '509 patent claims in question are invalid under 35 U.S.C. s. 102 as anticipated by prior art. Federal law protects an invention unless it "was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." 35 U.S.C. s. 102(a) (1994). Also, there is no protection for an invention if it "was patented or described in a printe publication in this or a foreign country ... more than one year prior to the date of the application for patent in the United States." 35 U.S.C. s. 102(b) (1994).

Initially, the court must interpret the patent's claims as a matter of law. In re Donaldson Co., 16 F.3d 1189, 1192 (Fed.Cir.1994). The court reads the claims in the context of the patent specification where the claims and invention are described. Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc., 45 F.3d 1550, 1554 (Fed.Cir.1995). If needed to impart clarity or avoid ambiguity, the court may also consult prosecution history and prior art to ascertain whether the patentee's invention is novel or known to others. *Id*. The mere fact that a certain invention may result from a given set of circumstances is insufficient to prove anticipation. *Electro,* 34 F.3d at 1052 (citations omitted).

A patent is presumed valid independent of the validity of any other claims in the patent. 35 U.S.C. s. 282 (1994). This presumption of validity applies not only to the patent as a whole, but also to "[e]ach claim of a patent (whether in independent, dependent, or multiple dependent form)." Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 1534 (Fed.Cir.1983). Thus, "dependent or multiple dependent claims shall be presumed valid even though [dependent] upon an invalid claim." *Id*.

The party challenging the validity of the patent claims must show that they are invalid by clear and

convincing evidence. Electro Medical Sys. S.A. v. Cooper Life Sciences, Inc., 34 F.3d 1048, 1052 (Fed.Cir.1995). One of the things the party challenging validity must demonstrate is identity of invention. Minnesota Mining and Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc., 976 F.2d 1559, 1565 (Fed.Cir.1992) (citations omitted). Identity of invention is a question of fact. *Id.;* Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576 (Fed.Cir.1991) ("Anticipation is a question of fact. "). The party wishing to establish identity of invention must show by clear and convincing evidence "that each element of the claim in issue is found, either expressly or under principles of inherency, in a single prior art reference, or that the claimed invention was previously known or embodied in a single prior art device." Minnesota Mining, 976 F.2d at 1565; Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047 (Fed.Cir.1995). Thus, "the exclusion of a claimed element from a prior art reference is enough to negate anticipation by that reference." Atlas Powder Co. v. E.I. Du Pont De Nemours & Co., 750 F.2d 1569, 1574 (Fed.Cir.1984).

In this case, Nintendo asserts that the '509 patent is invalid because seven instances of prior art anticipate the disputed claims. As stated above, the court construes claim 40 as a claim that merely requires a structure allowing selection and provides for data coupling and transfer. Furthermore, claim 40 includes two additional claim limitations-the "audiovisual presentation locally generated" ("audiovisual") limitation and the "individual game apparatus" ("apparatus") limitation. The audiovisual limitation means devices having both sound and a visual presentation, while the apparatus limitation permits a user to play the game individually. The mere fact that the seven instances of prior art in the aggregate are remotely similar to the ' 509 patent is insufficient to prove any one of the seven anticipated the ' 509 patent. Because a reasonable jury could conclude that each of the seven games Nintendo alleges anticipate Claims 40 through 46 of the '509 patent lack either the audiovisual limitation or the apparatus limitation, a genuine issue exists for trial.

In sum, a reasonable jury could find that Nintendo has infringed Claims 40 through 46 of the '509 patent, either literally or under the doctrine of equivalents. A reasonable jury could also find that the seven previous games cited by Nintendo as prior art do not anticipate Claims 40 through 46 of the ' 509 patent.

Conclusion

For the reasons set forth above, the court denies Nintendo's motion for summary judgment. The court instructs the parties to discuss settlement before the next court date.

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