United States District Court,
N.D. Texas.

ULTRAK, INC,
Plaintiff.
v.
KUSTOM SIGNALS, INC,
Defendant.

No. Civ. 3:96-CV-1569-H

Aug. 18, 1997.

MEMORANDUM OPINION AND ORDER

SANDERS**, Senior Judge.**

Before the Court are Defendant's Motion for Summary Judgment, filed May 7, 1997; Plaintiff's response, filed May 30, 1997; and Defendant's reply, filed June 13, 1997.

I. Factual Background

The United States issued patent number 4,107,611 (the " '611 patent" or the "patent-in-suit"), entitled a "Police Protection Method and Apparatus," on August 15, 1997. Ultrak claims to own this patent by virtue of an assignment from Westinghouse Electric Corporation. Ultrak brought this suit alleging that Defendant Kustom's EYEWITNESS patrol car surveillance system infringed or induced infringement of Claim 1 of the '611 patent. The '611 patent expired on May 31, 1996. Ultrak's suit seeks recovery of damages for past infringement only.

Both the patented system and the accused EYEWITNESS system enable recording of a police officer's interrogations and interactions by using a wireless microphone transmitter to transmit the officer's conversations to a recording device located in the officer's patrol car. In the patented device, when the microphone transmitter is not in use, it is generally stored in a recharging holder in the police car. When the officer exits the vehicle, he removes the transmitter from its holder and places it in his pocket. Removing the transmitter from its holder automatically initiates transmission and recording. The transmitter has an "override" switch that allows it to be removed from the holder and moved without transmitting.

In the accused EYEWITNESS system, the microphone transmitter is worn continuously on the officer's belt. To begin recording, the officer must manually turn on the transmitter by moving a switch to the appropriate transmission frequency. The transmitter in the accused device is battery-powered and cannot be recharged.

Ultrak argues that use of the accused device violates Claim 1 of the '611 patent. FN1 Claim 1 covers "a method for providing the record of interrogation and activity by police officers, ... including: a. replacement

of an automatically activated transmitter in the officer's clothing...." Kustom moves for summary judgment to establish noninfringement on the basis that the accused device does not involve the "replacement" of an "automatically activated transmitter" on an officer's person.

FN1. In its Reply to Defendant's First Requests for Admission, Ultrak admits that Kustom does not directly infringe the '611 patent by manufacturing or selling the EYEWITNESS device. *See* Def. Reply Ex. E.

II. Summary Judgment Standard

In proper circumstances, awarding summary judgment is not disfavored in the federal courts: "Summary judgment reinforces the purpose of the Rules, to achieve the just, speedy, and inexpensive determination of actions, and, when appropriate, affords a merciful end to litigation that would otherwise be lengthy and expensive." Fontenot v. Upjohn Co., 780 F.2d 1190, 1197 (5th Cir.1986); *see also* Lujan v. National Wildlife Federation, 497 U.S. 871, 888 (1990). Summary judgment is appropriate when the movant is able to demonstrate that the pleadings, affidavits, and other evidence available to the Court establish that no genuine issue exists as to any material fact, and that the moving party is entitled to judgment or partial judgment as a matter of law. FED.R.CIV.P. 56. *See also* Celotex Corp. v. Catrett, 477 U.S. 317, 323-25 (1986). The threshold inquiry is whether there are "any genuine factual issues that properly can be resolved only by a finder of fact because they may reasonably be resolved in favor of either party." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 251 (1986). Of course, "the substantive law will identify which facts are material." Id. at 248.

The Supreme Court has explained that a movant for summary judgment need not support the motion with evidence negating the opponent's case; rather, once the movant establishes that there is an absence of evidence to support the nonmovant's case, the burden shifts to the nonmovant to make a showing sufficient to establish each element as to which that party will have the burden at trial. *See* Celotex, 477 U.S. at 322-25. If the movant fails to meet its initial burden, the motion must be denied, regardless of the nonmovant's response. Little v. Liquid Air Corp., 37 F.3d 1069, 1075 (5th Cir.1994). If the movant does meet its burden, the nonmovant must go beyond the pleadings and designate specific facts showing that a genuine issue of material fact exists for trial. Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 587 (1986). A party opposing summary judgment may not rest on mere conclusory allegations or denials in its pleadings. FED.R.CIV.P. 56(e); *see also* Hightower v. Texas Hosp. Ass'n., 65 F.3d 443, 447 (5th Cir.1995). In addition, a party must do more than simply show some "metaphysical doubt as to the material facts." Matsushita, 475 U.S. at 586.

In determining whether a genuine issue exists for trial, the Court must view the evidence introduced and all factual inferences from the evidence in the light most favorable to the party opposing summary judgment. Eastman Kodak v. Image Technical Services, 504 U.S. 451, 456-58 (1992); *see also* Bodenheimer v. PPG Indus., Inc., 5 F.3d 955, 956 (5th Cir.1993). "If the record, taken as a whole, could not lead a rational trier of fact to find for the non-moving party, there is no genuine issue for trial." Friou v. Phillips Petroleum Co., 948 F.2d 972, 974 (5th Cir.1991). Summary judgment is appropriate in a patent case as in any other where no genuine issue of material fact is present and the movant is entitled to judgment as a matter of law. Brenner v. United States, 773 F.2d 306, 307 (Fed.Cir.1985).

III. Plaintiff's Discovery Complaints

In addition to its other arguments, discussed below, Ultrak suggests that summary judgment is inappropriate

at this time because Ultrak has not had the opportunity to examine the accused EYEWITNESS system in connection with this suit. The Court is unsympathetic to this argument. Ultrak has not filed a motion under Rule 56(f) for additional time in which to respond to Kustom's motion. Nor has Ultrak previously made the Court aware of any difficulties in discovery, although discovery had been on-going for several months before Kustom filed its motion. FN2 Moreover, Ultrak has had access to an owner's manual for the accused device in the course of these proceedings and, the parties represent, Ultrak has had some access to the device itself in connection with contemporary litigation between the parties in Kansas. Under the circumstances, the Court considers Kustom's motion for summary judgment ripe for determination and will proceeds to the merits of the motion.

FN2. The time for discovery expired July 7, 1997. *See* Court's Scheduling Order, filed August 19, 1996.

IV. Analysis

A patent may be infringed in one of two ways: literal infringement or infringement under the doctrine of equivalents.

A. Literal Infringement

Analysis of a literal infringement claim is a two-step process. First, the Court construes the patent claims to define the scope of the patent-holder's rights as a matter of law. Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71 (Fed.Cir.1995), *aff'd,* 116 S.Ct. 1384 (1996). The second step requires a comparison of the properly construed claims to the device accused of infringing. Id. at 976. At the second stage, the issue of whether a patent has been infringed is a question of fact.

At the claim construction stage, the Court interprets claims in light of the text of the patent, the claims, the specification, and the prosecution history. Id. at 978-979. Absent a special definition stated in the patent or its file history, the words of a claim are to be given their ordinary and customary meaning. Vitronics Corp. v. Conceptronic Inc., 90 F.3d 1576, 1582 (Fed.Cir.1996).

Here, the patent-in-suit is limited to police recording devices involving the "replacement of an *automatically activated* transmitter in the officer's clothing." The parties propose significantly different constructions of the term "automatically activated." Kustom suggests that, as used in the patent, the term "automatically activated" refers to the feature of the patented system that the transmitter begins sending a signal to the recorder immediately upon removal from its holder, without the officer having to switch the unit on. Under this construction, Kustom's EYEWITNESS system does not include an "automatically activated transmitter" because the officer must manually switch on Kustom's transmitter in order to start recording. By contrast, Ultrak argues that the "automatically activated" term of the patent signifies only that the officer is not required to push a button in order to record particular words. Ultrak suggests that the patent uses "automatic" to distinguish the patented device's "hands-free" transmitter from walkie-talkie-type "push-to-talk" transmitters that had been the subject of other patents for police devices. Both sides rely extensively on the portions of the '611 patent's prosecution history to support their proposed constructions.

The Court concludes that "automatically activated" should be construed to mean a transmitter that begins transmitting device without the officer having to separately turn it on. It is clear from the prosecution history and the patent itself that two central features of the "automatic" operation of the transmitter were 1) that the system began to transmit and record immediately, without the officer having to take any special action, and

2) that it did not enable the officer (intentionally or otherwise) to turn the transmitter off and on easily to selectively record. Moreover, considering ordinary meaning of the term, "automatically activated" is naturally construed to mean that a device begins operating without being specially turned on.

There is no summary judgment evidence to indicate that Kustom's accused recording system makes use of an "automatically activated" transmitter within the meaning of the patent. To the contrary, the summary judgment evidence establishes that Kustom's transmitter must be manually activated each time an officer desires to record a specific encounter. Since there is no summary judgment evidence that the accused device includes an automatically activated transmitter within the meaning of Claim 1, there exists no fact issue on Ultrak's claim for literal infringement of the '611 patent.

B. Infringement by the Doctrine of Equivalents

The doctrine of equivalents comes into play only if literal infringement is not found. The doctrine may allow a patentee to recover for infringement, even though the accused device falls outside the literal scope of the patent claims, if the differences between the claimed invention and the accused device are insubstantial. Wang Lab., Inc. v. Mitsubishi Elec. America, Inc., 103 F.3d 1571, 1577 (Fed.Cir.1997), *petition for cert. filed,* 65 U.S.L.W. 3827 (U.S. June 10, 1997) (No. 96-1960). Infringement under the doctrine of equivalents is a question of fact.

The doctrine of equivalents is, however, subject to limitations under the theory of prosecution history estoppel. Prosecution history estoppel precludes a patent-holder from regaining through litigation coverage of subject matter that was relinquished during prosecution of the patent application. Wang, 103 F.3d at 1577-78. Whether the estoppel applies is an issue of law. Id. at 1578. In determining whether prosecution history estoppel applies, the Court examines the statements and actions of the applicant before the Patent and Trademark Office (PTO). Arguments and amendments made to secure allowance of a claim give rise to prosecution history estoppel. *Id*. The patentee may not recover for infringement where that infringement would require an equivalence between a claim element and an aspect of the accused device that falls within the scope of the estoppel. *Id*.

Here, the original application for the '611 patent was not limited to transmitters that are automatically activated. (Def.Ex. B-27). After the original application was rejected by the PTO, the applicant submitted an amendment limiting its claim to a system including an automatically activated transmitter. (Def.Ex. B-43). In a subsequent brief before the PTO Board of Appeals, the applicant pointed out that the revised claim was intended to cover an automatic transmitter which is already activated when replaced in an officer's clothing. (Def.Ex. B-57). At other points during the prosecution of the '611 patent, the applicant emphasized that the automatic activation of the transmitter was an essential step in insuring that an officer's interrogations and activities were fully and properly recorded. (*See, e.g.,* Def.Ex. B-50, B-82, B-85).

Based on the prosecution history, the Court believes that a competitor may reasonably have concluded that, in order to secure issuance of the patent, the applicant for the '611 patent surrendered any claim to a manually activated transmission system. Wang, 103 F.3d at 1578. Therefore, the doctrine of prosecution history estoppel precludes Ultrak from recovering for infringement by a device that includes a manually activated transmitter. Accordingly, Kustom's EYEWITNESS system cannot infringe Ultrak's patent under the doctrine of equivalents.

V. Conclusion

For the reasons stated above, Kustom's motion for summary judgment of noninfringement of Claim 1 of the patent-in-suit is **GRANTED.** As the Court understands the parties' pleadings, this ruling disposes of Ultrak's claim against Kustom for direct infringement, leaving Ultrak's claim for inducement to infringe. Counsel are currently under a deadline to file a status report by ***September 2, 1997.*** If counsel have not submitted dismissal papers by the reporting deadline, that report should include a statement of issues remaining for trial.

SO ORDERED.

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