IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF DELAWARE

TA INSTRUMENTS, INC.,	)	
	)	
Plaintiff and	)	
Counterclaim	)	
Defendant,	)	
	)	
v.	)	Civil Action No. 95-545-SLR
	)	
THE PERKIN-ELMER CORPORATION,	)	
	)	
Defendant and	)	
Counterclaim	)	
Plaintiff.	)	

MEMORANDUM ORDER

At Wilmington this 28th day of March, 2002, on remand from the United States Court of Appeals for the Federal Circuit;[1]

IT IS ORDERED that counterclaim plaintiff Perkin-Elmer Corporation's ("PE's") motion for summary judgment of infringement of U.S. Patent No. 4,246,641 (the "Babil patent") (D.I. 401) and counterclaim defendant TA Instrument's ("TA's") motion for summary judgment of noninfringement of the Babil patent (D.I. 387) shall be denied, for the reasons that follow:

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[1]In previous proceedings before the district court, counterclaim plaintiff Perkin-Elmer ("PE") conceded that it could not establish infringement under the district court's claim construction of U.S. Patent No. 4,246,641 (the "Babil patent") and, accordingly, this court entered final judgment of noninfringement in favor of counterclaim defendant TA Instruments. (D.I. 352) PE appealed. On June 1, 2000, the Federal Circuit vacated this court's claim construction of the Babil patent and remanded to this court for further proceedings consistent with the Federal Circuit opinion. TA Instr., Inc. v. Perkin-Elmer Corp., No. 99-1358, 2000 WL 717094, at *16 (Fed. Cir. June 1, 2000), cert. denied, 121 S. Ct. 571 (2000).

1. **Legal Standards.** A court shall grant summary judgment only if "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). The moving party bears the burden of proving that no genuine issue of material fact exists. See Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 n.10 (1986). "Facts that could alter the outcome are 'material,' and disputes are 'genuine' if evidence exists from which a rational person could conclude that the position of the person with the burden of proof on the disputed issue is correct." Horowitz v. Fed. Kemper Life Assurance Co., 57 F.3d 300, 302 n.1 (3d Cir. 1995) (internal citations omitted).

2. A determination of infringement requires a two-step analysis. First, the court must construe the asserted claims so as to ascertain their meaning and scope. Second, the claims as construed are compared to the accused product. See KCJ Corp. v. Kinetic Concepts, Inc., 223 F.3d 1351, 1355 (Fed. Cir. 2000). Claim construction is a question of law while infringement is a question of fact. See id. To establish literal infringement, "every limitation set forth in a claim must be found in an accused product, exactly." Southwall Tech., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1575 (Fed. Cir. 1995). An accused product

that does not literally infringe a claim may still infringe under the doctrine of equivalents if each limitation of the claim is met in the accused product either literally or equivalently. See Sextant Avionique, S.A. v. Analog Devices, Inc., 172 F.3d 818, 826 (Fed. Cir. 1999).

3. A means-plus-function limitation recites a function to be performed rather than structure or materials that perform the function, and such a limitation therefore must be construed "to cover the corresponding structure, material, or acts described in the specification and equivalents thereof." 35 U.S.C. § 112, ¶ 6 (1994); Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc., 145 F.3d 1303, 1307-8 (Fed. Cir. 1998). For an accused structure to literally infringe a means-plus-function limitation, "the accused structure must either be the same as the disclosed structure or be an 'equivalent,' i.e., (1) perform the identical function and (2) be otherwise insubstantially different with respect to structure." Kemco Sales, Inc. v. Control Papers Co., Inc., 208 F.3d 1352, 1364 (Fed. Cir. 2000). "[S]tructures may be 'equivalent' for purposes of section 112, paragraph 6 if they perform the identical function, in substantially the same way, with substantially the same result." Id.

4. **Claim Construction.** The Federal Circuit construed the "computer means" limitation of Babil patent claim 1 as follows: **"Computer means disposed between said first and second means for**

correcting automatically for discrepancies between oven temperature and desired sample temperatures." Circuitry that performs the function of "correcting automatically for discrepancies between oven temperature and desired sample temperatures." (TA Instruments v. Perkin-Elmer Corporation, No. 99-1358, 2000 WL 717094, at *15 (Fed. Cir. June 1, 2000) ("Opinion")) The structures associated with this function are: (1) the "automatic calibration means" shown in Figure 1 of the Babil patent, which cycles the device through the steps of commanding the oven to reach a selected temperature, permitting the sample temperature to stabilize, and comparing the sample temperature to the selected temperature, etc., until the actual sample temperature reaches the selected temperature (Opinion at *15; Babil patent, col. 3, lns. 40-47; col. 3, ln. 56 to col. 4, ln. 5); and (2) the structure shown in Figure 3, which automatically calculates a corrected temperature for each selected temperature and includes the automatic calibration system of Figure 1, the memory 36 of Figure 1, and a processor that applies the interpolation function to determine the corrected temperature corresponding to each selected temperature (Opinion at *15; Babil patent, col. 5, ln. 36 to col. 6, ln. 13).

5. **Fact Disputes.** The Federal Circuit has found, and the parties do not dispute, that the function disclosed by the "computer means" limitation of claim 1 is "correcting

automatically for discrepancies between oven temperatures and desired sample temperatures." (Opinion at *15) However, TA asserts that the structure of the accused system ("Isotrack") that performs the function is substantially different from the "automatic calibration means" shown in Figure 1 of the Babil patent, which the Federal Circuit has identified as one structure that performs the disclosed function.

6. In particular, TA asserts that Isotrack has no structural equivalent to control 40 of Figure 1. (D.I. 388 at 25-26; D.I. 404 at 2, 10-11) TA argues that control 40 is an integral part of the Babil "automatic calibration means," because it monitors the difference between the actual sample temperature and the desired sample temperature and (1) initiates another iteration of the automatic correction process when the difference is not zero and (2) stops the process when the difference reaches zero. (D.I. 388 at 25-26; D.I. 404 at 7-8, 10; D.I. 424 at 9-11, 51-52; Babil patent, col. 3, lns. 48-55) TA asserts that Isotrack has no identical or equivalent structure because its automatic correction process operates continuously throughout a measurement run, repeating the process every 30 seconds or more regardless of whether the sample temperature and desired temperature are equal or not. (D.I. 388 at 16; D.I. 389, Ex. D, ¶¶ 8-9; D.I. 404 at 10-11; D.I. 424 at 29-30) PE responds that Isotrack "corrects automatically" in substantially the same way,

and with substantially the same result, as the claimed Babil invention, and Isotrack thus infringes the Babil patent. (D.I. 399 at 16-20; D.I. 408 at 4; D.I. 409 at ¶ 16; D.I. 400, Ex. A at ¶¶ 7-10, 13)

7. Based on the record, the court concludes that genuine issues of material fact remain on the issue of infringement and, therefore, summary judgment is inappropriate. In addition, the court anticipates that the issue of invalidity based on prior art (see D.I. 389, Ex. D, ¶¶ 9, 12-18) may be raised again by TA because of the Federal Circuit's revised claim construction.

8. Accordingly, the court shall deny PE's motion for summary judgment of infringement and TA's motion for summary judgment of noninfringement.

Sue L. Robinson
United States District Judge