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The Magnavox Company and  
10 Sanders Associates, Inc.

11  
12 UNITED STATES DISTRICT COURT FOR THE  
13 NORTHERN DISTRICT OF CALIFORNIA

14 THE MAGNAVOX COMPANY, a corporation, )  
15 and SANDERS ASSOCIATES, INC., )  
a corporation, ) No. C 82 5270 CAL  
16 Plaintiffs, )  
17 ) PLAINTIFFS' PRETRIAL  
PROPOSED  
18 v. ) CONCLUSIONS OF LAW  
19 )  
ACTIVISION, INC., a corporation, )  
20 Defendant. )

21 1. The burden of establishing invalidity of a patent  
22 or any claim thereof rests on the party asserting invalidity and  
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25 PLAINTIFFS' PRETRIAL PROPOSED CONCLUSIONS OF LAW  
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1 the burden is never shifted to the patentee to prove validity.  
2 That is, 35 U.S.C. §282 mandates not only a presumption placing  
3 the burden of going forward in a purely procedural sense, but also  
4 places the burden of persuasion on the party who asserts that the  
5 patent is invalid, regardless of whether the most pertinent prior  
6 art was or was not considered by the United States Patent and  
7 Trademark Office (PTO) or any other factor. American Hoist &  
8 Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1358, 1360, 220  
9 U.S.P.Q. 763, 769, 771 (Fed. Cir. 1984), cert. denied, 53 U.S.L.W.  
10 3236 (1984); SSIH Equipment S.A. v. U.S. International Trade  
11 Commission, 718 F.2d 365, 375, 218 U.S.P.Q. 678, 687 (Fed. Cir.  
12 1983); Leinoff v. Louis Milona & Sons, Inc., 726 F.2d 734, 738,  
13 220 U.S.P.Q. 845, 847-49 (Fed. Cir. 1984).

14           2. The statutory presumption of validity (35 U.S.C.  
15 §282) places the burden on the party attacking validity to  
16 overcome the presumption by establishing appropriate facts with  
17 clear and convincing evidence. Perkin-Elmer Corp. v.  
18 Computervision Corp., 732 F.2d 888, 894, 221 U.S.P.Q. 669, 674  
19 (Fed. Cir. 1984); American Hoist & Derrick Co. v. Sowa & Sons,  
20 Inc., 725 F.2d 1350, 1358-60, 220 U.S.P.Q. 763, 769-71 (Fed. Cir.  
21 1984), cert. denied, 53 U.S.L.W. 3236 (1984); Raytheon Co. v.  
22 Roper Corp., 724 F.2d 951, 960, 220 U.S.P.Q. 592, 599 (Fed. Cir.  
23 1983), cert. denied, 53 U.S.L.W. 3225 (1984).

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1           3.    A prior holding reaffirming patent validity in  
2 spite of attacks upon validity by infringers should be given  
3 weight in a subsequent suit again challenging validity. Stevenson  
4 v. Sears, Roebuck & Co., 713 F.2d 705, 711, 218 U.S.P.Q. 969, 974  
5 (Fed. Cir. 1983).

6           4.    The particular weight given a prior holding  
7 reaffirming patent validity despite an attack on validity by an  
8 infringer will vary depending on the prior art or other evidence  
9 on patentability not before the prior court that is produced in  
10 the subsequent suit. Stevenson v. Sears, Roebuck & Co., 713 F.2d  
11 705, 711, 218 U.S.P.Q. 969, 974 (Fed. Cir. 1983).

12           5.    If the attack upon the validity of a patent in a  
13 subsequent suit is on substantially the same basis as in an  
14 earlier suit, the court will give the prior holding stare decisis  
15 effect. Stevenson v. Sears, Roebuck & Co., 713 F.2d 705, 711, 218  
16 U.S.P.Q. 969, 974 (Fed. Cir. 1983).

17           6.    Once there has been a judicial determination  
18 reaffirming patent validity in spite of an attack on validity by  
19 an infringer, the party challenging validity in a later action has  
20 the burden of presenting "persuasive new evidence" of invalidity  
21 and demonstrating that there is a "material distinction" between  
22 the cases on the issue of validity. American Photocopy Equipment  
23 Co. v. Rovico, Inc., 384 F.2d 813, 815-16, 155 U.S.P.Q. 119, 120  
24 (7th Cir. 1967), cert. denied, 390 U.S. 945, 156 U.S.P.Q. 720  
25 (1968); Illinois Tool Works, Inc. v. Foster Grant Co., Inc., 547  
26 F.2d 1300, 1302-03, 192 U.S.P.Q. 365, 366-67 (7th Cir. 1976),  
27 cert. denied, 431 U.S. 929, 194 U.S.P.Q. 576 (1977); Mercantile

1 National Bank of Chicago v. Howmet Corp., 524 F.2d 1031, 1032, 188  
2 U.S.P.Q. 353, 354 (7th Cir. 1975), cert. denied, 424 U.S. 957, 189  
3 U.S.P.Q. 256 (1976).

4 7. The statutory presumption of validity accorded to a  
5 patent by 35 U.S.C. §282 is greatly enhanced when it has been held  
6 sufficient on the issue in a prior decision following an attack  
7 upon validity by an infringer at a trial on the merits and the  
8 prior adjudication sustaining validity will be followed unless the  
9 court is convinced of a "very palpable error in law or fact."

10 Skil Corp. v. Lucerne Products, Inc., 684 F.2d 346, 351, 216  
11 U.S.P.Q. 371, 374 (6th Cir. 1982), cert. denied, 459 U.S. 991  
12 (1982).

13 8. The ultimate question of patent invalidity based on  
14 obviousness and the question of obviousness are, under 35 U.S.C.  
15 §103, questions of law based on factual inquiries and factual  
16 evidence. Graham v. John Deere Co., 383 U.S. 1, 17, 148 U.S.P.Q.  
17 459, 467 (1966); Stevenson v. International Trade Commission, 612  
18 F.2d 546, 549, 204 U.S.P.Q. 276, 279 (C.C.P.A. 1979).

19 9. In determining the sufficiency or insufficiency of  
20 an infringers proofs of obviousness of patented subject matter,  
21 pursuant to 35 U.S.C. §103, a court must remain aware that a  
22 patent shall be presumed valid and that the burden of persuasion  
23 is and always remains upon the party asserting invalidity, as  
24 mandated by 35 U.S.C. §282. Stevenson v. International Trade  
25 Commission, 612 F.2d 546, 551, 204 U.S.P.Q. 276, 281 (C.C.P.A.  
26 1979); Hughes Aircraft Co. v. United States, 717 F.2d 1351, 1359,  
27 219 U.S.P.Q. 473, 478 (Fed. Cir. 1983).

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1           10.    "Secondary considerations" of nonobviousness, may  
2 be the most pertinent, probative, and revealing evidence available  
3 to aid a Court in reaching a conclusion on the  
4 obviousness/nonobviousness issue. Simmons Fastener Corp. v.  
5 Illinois Tool Works, Inc., 739 F.2d 1573, 1575-76, 222 U.S.P.Q.  
6 744, 746-47 (Fed. Cir. 1984).

7           11.    Though it is proper to note the difference existing  
8 between the claimed invention and the prior art, because that  
9 difference may serve as one element in determining the  
10 obviousness/nonobviousness issue mandated by 35 U.S.C. §103, it is  
11 improper merely to consider the difference as the invention. The  
12 "difference" may appear to be slight, but it can be the key to  
13 success of the invention as a whole which is an advancement in the  
14 art. Jones v. Hardy, 727 F.2d 1524, 1528, 220 U.S.P.Q. 1021, 1024  
15 (Fed. Cir. 1984).

16           12.    It is irrelevant in determining obviousness that  
17 all or all but one or two of the aspects of the claimed invention  
18 are well known in the art, in a piecemeal manner, since virtually  
19 every patent can be described as a "combination patent" or a  
20 combination of old elements. Jones v. Hardy, 727 F.2d 1524, 1528,  
21 220 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984).

22           13.    The statutory provisions of 35 U.S.C. §103 require  
23 that the invention as claimed be considered "as a whole" when  
24 considering whether the invention would have been obvious at the  
25 time the invention was made. Jones v. Hardy, 727 F.2d 1524, 1528,  
26 220 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984).

1           14.    The mere fact that the disclosures or teachings of  
2 the prior art can be combined for purposes of determining the  
3 obviousness/nonobviousness issue (35 U.S.C. §103) does not make  
4 the combination of the teaching obvious unless the art also  
5 suggests the desirability of the combination or the inventor's  
6 beneficial results from the combination or the advantage to be  
7 derived from combining the teachings. In re Sernaker, 702 F.2d  
8 989, 995-96, 217 U.S.P.Q. 1, 6-7 (Fed. Cir. 1983); Lindemann  
9 Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d  
10 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984); In re Gordon,  
11 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984); In re  
12 Imperato, 486 F.2d 585, 587, 179 U.S.P.Q. 730, 732 (C.C.P.A.  
13 1973).

14           15.    A prior art reference which merely describes a  
15 product or a process without disclosing how to make it or carry it  
16 out does not support a holding of obviousness under 35 U.S.C. §103  
17 unless there is some known or obvious way, to a person having  
18 ordinary skill in the art to which the invention pertains, to make  
19 the patented product or to carry out the patented process at the  
20 time the invention was made by patentee. In re Hoeksema, 399 F.2d  
21 269, 273-74, 158 U.S.P.Q. 596, 600-01 (C.C.P.A. 1968); In re  
22 Brown, 329 F.2d 1006, 1010-11, 141 U.S.P.Q. 245, 248-49 (C.C.P.A.  
23 1964); In re Samour, 571 F.2d 559, 562, 197 U.S.P.Q. 1, 3, 4  
24 (C.C.P.A. 1978).

25           16.    The reliance by defendant on a large number of  
26 references as prior art is indicative of patentable invention in  
27 the claims that are under attack. Minneapolis-Honeywell Reg. Co.  
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1 Beckman Instruments, Inc., 218 U.S.P.Q. 881, 896 (C.D. Cal. 1983),  
2 aff'd, 727 F.2d 1540, 221 U.S.P.Q. (Fed. Cir. 1984); In re Sasse,  
3 629 F.2d 675, 681-82, 207 U.S.P.Q. 107, 111-12 (C.C.P.A. 1980); In  
4 re Samour, 571 F.2d 559, 562, 197 U.S.P.Q. 1, 3, 4, (C.C.P.A.  
5 1978).

6           19. The statutory presumption of validity (35 U.S.C.  
7 §282) places the burden on the party raising prior art bars under  
8 35 U.S.C. §102 in an attack on validity to overcome the  
9 presumption by establishing appropriate facts with clear and  
10 convincing evidence. Accordingly, the defenses of prior invention  
11 or knowledge by another and prior use or on sale must be  
12 established by the clearest proof. In re Reuter, 670 F.2d 1015,  
13 1021-22, 210 U.S.P.Q. 249, 255-56 (C.C.P.A. 1981); TP Laboratories  
14 v. Professional Positioners, Inc., 724 F.2d 965, 971 n.3, 200  
15 U.S.P.Q. 577, 582 n.3 (Fed. Cir. 1984), cert. denied, 53 U.S.L.W.  
16 3236 (1984); Stevenson v. International Trade Commission, 612 F.2d  
17 546, 550, 204 U.S.P.Q. 276, 280 (C.C.P.A. 1979); Lockheed Aircraft  
18 Corp. v. United States, 553 F.2d 69, 75, 193 U.S.P.Q. 449, 454  
19 (Ct. Cl. 1977); E.I. duPont de Nemours & Co. v. Berkley & Co.,  
20 Inc., 620 F.2d 1247, 1261, 205 U.S.P.Q. 1, 11 (8th Cir. 1980);  
21 Jones Knitting Corp. v. Morgan, 361 F.2d 451, 455-56, 149 U.S.P.Q.  
22 659, 662-63 (3rd Cir. 1966).

23           20. Oral testimony alone has been held insufficient to  
24 prove a statutory prior art bar under 35 U.S.C. §102. Unsupported  
25 or uncorroborated oral testimony can be sufficient to prove a  
26 statutory prior art bar under 35 U.S.C. §102 but must be regarded  
27 with suspicion, subjected to very close scrutiny and should prove  
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1 such a bar beyond a reasonable doubt. Zachos v. Sherwin-Williams  
2 Co., 177 F.2d 762, 763, 83 U.S.P.Q. 408, 408-09 (5th Cir. 1949);  
3 The Barbed Wire Patent, 143 U.S. 275, 284-85 (1892); Deering v.  
4 Winona Harvester Works, 155 U.S. 286, 300-01 (1894); Eibel Process  
5 Co. v. Minnesota & Ontario Paper Co., 261 U.S. 45, 60 (1923);  
6 Symington Co. v. National Castings Co., 250 U.S. 383, 386 (1919);  
7 Adamson v. Gilliland, 242 U.S. 350, 352-53 (1917); In re Reuter,  
8 670 F.2d 1015, 1021-22, 210 U.S.P.Q. 249, 255-56 (C.C.P.A. 1981);  
9 Lockheed Aircraft Corp. v. United States, 553 F.2d 69, 75, 193  
10 U.S.P.Q. 449, 454 (Ct. Cl. 1977); Stevenson v. International Trade  
11 Commission, 612 F.2d 546, 550, 204 U.S.P.Q. 276, 280 (C.C.P.A.  
12 1979); E.I. duPont de Nemours & Co. v. Berkley & Co., Inc., 620  
13 F.2d 1247, 1261, 205 U.S.P.Q. 1, 11 (8th Cir. 1980).

14 21. The term "known," as used in 35 U.S.C. §102(a), is  
15 knowledge of an invention which is "accessible to the public" and  
16 applies only to activities of others than the inventor. In re  
17 Borst, 345 F.2d 851, 854, 145 U.S.P.Q. 554, 556 (C.C.P.A. 1965).

18 22. The disclosure presented as constituting prior  
19 knowledge under 35 U.S.C. §102(a) should be sufficient to enable  
20 one skilled in the art at the time the invention of the patent was  
21 made to reduce the disclosed invention to practice. In re Borst,  
22 345 F.2d 851, 855, 145 U.S.P.Q. 554, 557 (C.C.P.A. 1965). See  
23 Coffin v. Ogden, 85 U.S. 120, 124 (1873).

24 23. A printed publication which discloses the claimed  
25 subject matter would constitute a bar under 35 U.S.C. §102(b) only  
26 if its description is sufficient to have placed the claimed  
27 invention "in the possession of the public." In re Samour, 571

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1 F.2d 559, 562, 197 U.S.P.Q. 1, 3, 4 (C.C.P.A. 1978); In re Sasse,  
2 629 F.2d 675, 681-82, 207 U.S.P.Q. 107, 111-12 (C.C.P.A. 1980); In  
3 re Coker, 463 F.2d 1344, 1348, 175 U.S.P.Q. 26, 29 (C.C.P.A.  
4 1972).

5           24. A demonstration in confidence or not in a sales  
6 context of a prototype device does not establish an offer to sell  
7 or placing the invention on sale under 35 U.S.C §102(b). Poole v.  
8 Mossinghoff, 214 U.S.P.Q. 506, 509-10 (D.D.C. 1982).

9           25. The provisions of 35 U.S.C. §112 require that the  
10 specification of a patent application or patent set forth the  
11 "best mode" contemplated by the inventor of carrying out his  
12 invention at the time the application was filed. Even if there is  
13 a better mode, the inventor's failure to disclose it in his patent  
14 will not invalidate the patent (35 U.S.C. §112) if the inventor  
15 did not, at the time of the filing of his application for patent,  
16 believe that it was, in fact, the best mode. It is enough that  
17 the inventor acted in good faith in his patent disclosure as of  
18 the time his application for patent was actually filed. Benger  
19 Laboratories, Ltd. v. R. K. Laros Co., 209 F. Supp. 639, 644, 135  
20 U.S.P.Q. 11, 15-16 (E.D. Pa. 1962), aff'd per curiam, 317 F.2d  
21 455, 137 U.S.P.Q. 693 (3rd Cir. 1963), cert. denied, 375 U.S. 833  
22 (1963); In re Gay, 309 F.2d 769, 772-73, 135 U.S.P.Q. 311, 315-16  
23 (C.C.P.A. 1962).

24           26. Since an applicant for patent is required to  
25 disclose the "best mode" known to or contemplated by him at the  
26 time his application is filed, he is not required to predict  
27 future or post-filing date developments which may enable the  
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1 practice of his invention in substantially the same way and he has  
2 no continuing duty to report modifications for practicing his  
3 invention either before or after a patent actually issues. Hughes  
4 Aircraft Co. v. United States, 717 F.2d 1351, 1362, 219 U.S.P.Q.  
5 473, 481 (Fed. Cir. 1983); W.L. Gore & Associates, Inc. v.  
6 Garlock, Inc., 721 F.2d 1540, 1556-57, 220 U.S.P.Q. 303, 315-16  
7 (Fed. Cir. 1983); Wilden Pump & Engineering Co. v. Pressed &  
8 Welded Products Co., 655 F.2d 984, 988, 213 U.S.P.Q. 282, 286 (9th  
9 Cir. 1981).

10           27. The claims of a patent, not the specification,  
11 measure the invention and the patentee is not confined to a  
12 particular illustrative mode disclosed in the specification.  
13 Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405,  
14 419 (1908); Smith v. Snow, 294 U.S. 1, 11, 24 U.S.P.Q. 26, 30  
15 (1935); Environmental Designs, Ltd. v. Union Oil Co. of  
16 California, 713 F.2d 693, 699, 218 U.S.P.Q. 865, 871 (Fed. Cir.  
17 1983), cert. denied, 104 S.Ct. 709 (1984); Jones v. Hardy, 727  
18 F.2d 1524, 1528, 220 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984).

19           28. The claims of a patent are to be construed in the  
20 light of the specification, and both are to be read with a view to  
21 ascertaining the invention. United States v. Adams, 383 U.S. 39,  
22 49, 148 U.S.P.Q. 479, 482 (1966).

23           29. In construing or interpreting a patent claim, a  
24 whole host of factors (e.g., patent disclosure, the prosecution  
25 history in the PTO, and comparison with other claims) may be  
26 considered. Graham v. John Deere Co., 383 U.S. 1, 32-33, 148  
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1 specification and equivalents thereof. Radio Steel & Mfg. Co. v.  
2 MTD Products, Inc., 731 F.2d 840, 848, 221 U.S.P.Q. 657, 663 (Fed.  
3 Cir. 1984), cert. denied, 53 U.S.L.W. 3237 (1984); Lockheed  
4 Aircraft Corp. v. United States, 553 F.2d 69, 82, 193 U.S.P.Q.  
5 449, 460 (Ct. Cl. 1977); Stearns v. Tinker & Rasor, 252 F.2d 589,  
6 597-98, 116 U.S.P.Q. 222, 228 (9th Cir. 1957).

7           33. Subject matter described in a patent and accused  
8 subject matter are equivalent for the purposes of determining  
9 infringement if they perform substantially the same function in  
10 substantially the same way to obtain substantially the same  
11 result. Graver Tank & Mfg. Co. v. Linde Air Products Co., 339  
12 U.S. 605, 608 (1950); Atlas Powder Co. v. E.I. Du PuPont De  
13 Nemours & Co., 750 F.2d 1569, 1579, 224 U.S.P.Q. 409, 416 (Fed.  
14 Cir. 1984).

15           34. The issue of infringement raises at least two  
16 questions: (1) what is patented, and (2) has what is patented  
17 been made, used or sold by another. The first is a question of  
18 law; the second is a question of fact to be proved by a  
19 preponderance of the evidence. SSIH Equipment S.A. v. U.S.  
20 International Trade Commission, 718 F.2d 365, 376, 218 U.S.P.Q.  
21 678, 688 (Fed. Cir. 1983); Fromson v. Advance Offset Plate, Inc.,  
22 720 F.2d 1565, 1569, 219 U.S.P.Q. 1137, 1140 (Fed. Cir. 1983).

23           35. Infringement cannot be avoided by the mere fact  
24 that the accused device is more or less efficient than the subject  
25 matter claimed or disclosed, or merely performs additional  
26 functions or adds features, or is an improvement. Amstar Corp. v.  
27 Envirotech Corp., 730 F.2d 1476, 1481-82, 221 U.S.P.Q. 649, 653

1 (Fed. Cir. 1984); Radio Steel & Mfg. Co. v. MTD Products, Inc.,  
2 731 F.2d 840, 848, 221 U.S.P.Q. 657, 663-64 (Fed. Cir. 1984),  
3 cert. denied, 53 U.S.L.W. 3237 (1984).

4 36. What constitutes equivalency must be determined  
5 against the context of the patent and the particular circumstances  
6 of the case. Equivalence, in the patent law, is not the prisoner  
7 of a formula and is not an absolute to be considered in a vacuum.  
8 It does not require complete identity for every purpose and in  
9 every respect. Graver Tank & Mfg. Co. v. Linde Co., 339 U.S. 605,  
10 609, 85 U.S.P.Q. 328, 330-31 (1950); Atlas Powder Co. v. E.I. Du  
11 PuPont De Nemours & Co., 750 F.2d 1569, 1579, 224 U.S.P.Q. 409,  
12 416 (Fed. Cir. 1984); Hughes Aircraft Co. v. United States, 717  
13 F.2d 1351, 1361, 219 U.S.P.Q. 473, 480 (Fed. Cir. 1983); Perkin-  
14 Elmer Corp. v. Computervision Corp., 732 F.2d 888, 901, 221  
15 U.S.P.Q. 669, 679 (Fed. Cir. 1984).

16 37. In deterring the question of equivalency, things  
17 for most purposes different may be equivalent for the construction  
18 of a particular patent. Graver Tank & Mfg. Co. v. Linde Co., 339  
19 U.S. 605, 609 (1950).

20 38. A finding of equivalence is a determination of  
21 fact. Proof can be made in any form, including testimony of  
22 experts or others versed in the technology. Graver Tank & Mfg.  
23 Co. v. Linde Co., 339 U.S. 605, 609-10, 85 U.S.P.Q. 328, 331  
24 (1950); Hughes Aircraft Co. v. United States, 717 F.2d 1351,  
25 1363-66, 219 U.S.P.Q. 473, 482-84 (Fed. Cir. 1983); Thomas & Betts  
26 Corp. v. Litton Systems, Inc., 720 F.2d 1572, 1579, 220 U.S.P.Q.  
27 1, 6 (Fed. Cir. 1983).

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1           39.    The use by the accused of an embellishment or  
2 embodiment made possible by technology developed, known or  
3 appreciated after the invention claimed in a patent, that is, made  
4 possible by post-invention technology, or the mere use of a  
5 component that may be more sophisticated than that disclosed by  
6 the patentee, does not allow one to escape an appropriate range of  
7 equivalents or to thereby avoid infringement of the claimed  
8 invention. Hughes Aircraft Co. v. United States, 717 F.2d 1351,  
9 1365-66, 219 U.S.P.Q. 473, 483-84 (Fed. Cir. 1983); Bendix Corp.  
10 v. United States, 600 F.2d 1364, 1382, 204 U.S.P.Q. 617, 631 (Ct.  
11 Cl. 1979).

12           40.    A patentee may be his own lexicographer, i.e., he  
13 is not confined to normal dictionary meanings of words used in his  
14 patent claims; to understand the claims they must be construed in  
15 connection with other parts of the patent. W. L. Gore &  
16 Associates, Inc. v. Garlock, Inc. 721 F.2d 1540, 1557-58, 220  
17 U.S.P.Q. 303, 316-17 (Fed. Cir. 1983); Fromson v. Advance Offset  
18 Plate, Inc., 720 F.2d 1565, 1569-70, 219 U.S.P.Q. 1137, 1140 (Fed.  
19 Cir. 1983).

20           41.    Whoever actively induces infringement of a patent  
21 shall be liable as an infringer. 35 U.S.C. §271.

22           42.    Whoever sells a component of a patented machine,  
23 manufacture, combination or composition constituting a material  
24 part of the invention, knowing the same to be especially made or  
25 especially adapted for use in an infringement of such patent, and  
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1 717 F.2d 1380, 1390, 219 U.S.P.Q. 569, 577 (Fed. Cir. 1983).

2 47. Defendant has failed to establish that the Re. 28,507  
3 patent, or any claim thereof, is invalid.

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