

United States District Court,
D. Massachusetts.

SIPEX CORPORATION,

v.

MAXIM INTEGRATED PRODUCTS, INC.

No. Civ.A. 99-10096-RWZ

May 24, 2002.

ORDER REGARDING CLAIM CONSTRUCTION

ZOBEL, J.

Maxim Integrated Products, Inc. ("Maxim") is the assignee of U.S. Patent No. 5,649,210 ("the '210 Patent"). This patent discloses a communications interface circuit (a circuit used to establish connections between a computer system and peripheral devices such as mice, printers, or floppy disk drives) that detects and can internally suspend power to portions of the circuitry not connected to a peripheral device, thereby reducing power consumption. Sipex Corporation ("Sipex"), a semiconductor company, has filed this action for a declaratory judgment that its products do not infringe the '210 Patent held by Maxim. Maxim, in turn, counterclaims that certain of Sipex's products do infringe the '210 patent.

The parties have requested a construction of certain claim language in the '210 Patent. *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed.Cir.1995). Both parties filed briefs offering suggested interpretations of the disputed claim terms. At the *Markman* hearing, they reached an agreement as to certain terms, advocated their respective interpretations of other terms, and identified two over-arching issues of claim construction for the court to consider. They ask first, whether certain preambles should be construed as claim limitations; and second, whether all means-plus-function claims should automatically be construed as including not only the specified means of performing the function but also any "equivalents thereof." I address these issues first.

Maxim identifies two preambles that, it argues, should be construed as claim limitations: "a communications interface unit" (preamble to Claims 1 and 11) and "a method for interfacing two communications systems" (preamble to Claim 21). The Federal Circuit has held that a preamble may be read as a claim limitation when it is "necessary to give life, meaning and vitality" to that claim, *Pitney Bowes, Inc. v. Hewlett-Packard Company*, 182 F.3d 1298, 1305 (Fed.Cir.1999) (citing *Kropa v. Robie*, 187 F.2d 150, 152 (C.C.P.A.1951)), such that any reading of the claim which did not include that limitation "would be divorced from reality," *Corning Glass Works v. Sumitomo Electric U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed.Cir.1989). Here, the invention claimed in the '210 patent must necessarily be situated at the connection point between two communications systems in order to achieve its purpose; any interpretation of the patent which does not involve two interfacing communications systems would indeed be divorced from reality. Thus, the preambles are limitations on the respective claims they modify. Maxim also urges the court to further define

"communications systems." I decline to do so. Whether a particular device constitutes a "communications system" within the meaning of the patent is a question of fact which will be decided at trial.

The parties further disagree whether the means-plus-function provisions of Claim 1 (specifically, "means for providing a Master Invalid signal" and "monostable means for generating a Master Invalid signal") should, as a matter of law, be construed to include all equivalent means of accomplishing the described function. Federal statutory law provides that any means-plus-function claim "should be construed to cover the corresponding structure, material, or acts described in the specification *and equivalents thereof*." 35 U.S.C. s. 112 (2002) (emphasis added). Thus, it is typically appropriate for the construction of a means-plus-function claim to include the phrase "or equivalents thereof" because an equivalent structure that performs the same function can literally infringe the claim. However, there are several well-recognized exceptions to this rule. First, equivalent infringement is not available for structures which were known to the patent applicant at the time of his application but were not disclosed in the patent. *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.*, 145 F.3d 1303, 1310-1311 (Fed.Cir.1998). Second, if a claim limitation has been amended during prosecution for reasons related to patentability, the patent holder is foreclosed from claiming equivalent infringement of that limitation. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed.Cir.2000). But the question whether or not these exceptions apply to the '210 patent is premature at this juncture. Accordingly, the means-plus-function claims at issue do include "equivalents thereof," at least, until such time as Sipex can demonstrate that equivalents are unavailable.

Following is the meaning of the disputed terms. For purposes of clarity, I include both the terms which the parties agreed upon at the hearing and the disputed terms.

Construction of Terms in the '210 Patent: Terms Agreed Upon by the Parties
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"Master Invalid Signal"	The Master Invalid Signal means a single invalid signal generated in response to the presence of all the individual invalid signals from signal detectors.
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Construction of Terms in the '210 Patent: Terms Construed by the Court
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"Means for Providing a Master Invalid Signal"	The structures described in the specification that are capable of performing the specified function include AND gate 66, shown in Figure 2 and discussed in the corresponding text, and equivalents thereof.
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"Stabilized Master Invalid Signal"	Stabilized Master Invalid Signal means the signal that is the output of monostable means, e.g. monostable circuit 68, and that indicates that the interface is disconnected, but only after the predetermined time which allows for mistakes to occur to keep it from disconnecting.
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"Monostable Means"	The structures described in the specification that are capable of performing the specified function, including monostable circuit 68, shown in Figure 2 and discussed in the corresponding text, and equivalents thereof.
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"Monostable
Circuit"

Monostable circuit means a circuit that maintains its present output until conditions for a different output exist for a predetermined period of time.

"Predetermined
Period of
Time"

Predetermined period of time means a period of time, determined by the selection of circuit component values, that is sufficient to prevent the Stabilized Master Invalid signal from being asserted in response to temporary conditions that might falsely indicate that the communications interface circuit is disconnected.

D.Mass.,2002.

Sipex Corp. v. Maxim Integrated Products, Inc.

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