

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

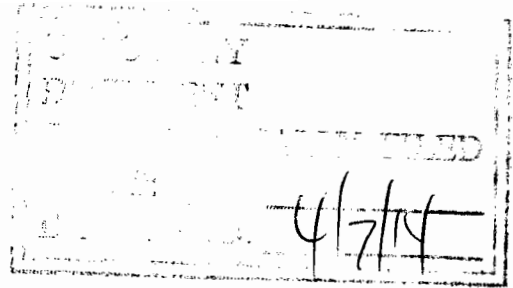
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COGNEX CORPORATION; COGNEX  
TECHNOLOGY & INVESTMENT LLC,

Plaintiffs,

-v-

MICROSCAN SYSTEMS, INC.; THE CODE  
CORPORATION,

Defendants.  
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13 Civ. 2027(JSR)

MEMORANDUM ORDER

JED S. RAKOFF, U.S.D.J.

Plaintiffs Cognex Corporation and Cognex Technology & Investment, LLC (collectively, "Cognex") sue defendants Microscan Systems, Inc. and The Code Corporation for patent infringement. Cognex alleges that Microscan's Mobile Hawk Direct Part Mark Reader product ("Mobile Hawk"), which is designed and sold by the defendants, infringes U.S. Patent No. 7,874,487 (the "'487 patent").

On December 31, 2013, this Court granted defendants' motion for summary judgment determining that plaintiffs cannot collect damages incurred prior to actual notice of infringement, awarded defendants' costs and reasonable attorneys' fees associated with their motion for sanctions for spoliation, fined plaintiffs \$25,000, and denied the parties' four remaining motions, three of which were for summary judgment. See Memorandum Order, Dec. 31, 2013 ("SJ Order"), at 26.

Then, on January 31, 2014, defendants requested leave to file an additional motion for summary judgment in their favor that claims 1 and 30 of the '487 patent are invalid for indefiniteness under 35 U.S.C. Section 112, Paragraph 2. The Court granted leave to defendants and set a schedule for full briefing on the motion.

Since defendants base the instant motion largely on the Court's denial of their previous motion for summary judgment that their accused product does not infringe claims 1 and 30 of the '487 patent, the Court reviews that portion of its previous Memorandum Order briefly. Defendants had argued that their accused Mobile Hawk technology does not infringe the asserted claims of the '487 patent both because the Mobile Hawk does not have the claimed "light pipe" and because that light is not "internally reflected along the pipe." See '487 patent, claims 1 & 30. The Court denied defendants' motion for summary judgment in their favor finding noninfringement because genuine disputes remained as to whether the accused product's "light prism," at least as depicted in the illustrations provided to the Court, constituted a "light pipe." See SJ Order, at 11-12. These same genuine disputes also precluded the Court from concluding whether the light transmitted through the light prism was "internally reflected along the pipe." *Id.* at 12-13. As a result, the Court

denied defendants' motion for summary judgment and could not find noninfringement of the '487 patent as a matter of law.

Relying on the Court's previous denial of summary judgment, defendants argue on the instant motion that claims 1 and 30 of the '487 patent are invalid for indefiniteness. Their argument proceeds as follows: Since the Court has construed the relevant claim terms of the '487 patent – "light pipe" and "internally reflected along the pipe," see Memorandum Order, Sept. 16, 2013 ("Claim Constr. Order"), at 3, and the Court has recognized that there is no dispute as to the structure of the relevant "light prism" in the accused product, see SJ Order, at 3, defendants argue that the Court should have been able to conclude whether the accused product infringes, which is generally a question of fact, as a matter of law. In this case though, the Court did not reach any conclusion as to infringement as a matter of law, at least on defendants' motion for summary judgment finding noninfringement. See SJ Order, at 11-13. Defendants contend that the Court's inability to reach such a conclusion means that the claims at issue lack a "discernible boundary" and are therefore invalid as indefinite. *E.g., Wellman, Inc. v. Eastman Chem. Co.*,

642 F.3d 1355, 1367 (Fed. Cir. 2011); see also 35 U.S.C. § 112, ¶ 2 (2006).<sup>1</sup>

Having reviewed the parties' submissions and having considered defendants' arguments, the Court denies defendants' pending motion for summary judgment for the following reasons:

The central question for the Court in assessing the definiteness of a patent's claims is whether the claims are "not amenable to construction" or are "insolubly ambiguous," both of which are matters of claim construction. *Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.*, 537 F.3d 1357, 1371 (Fed. Cir. 2008) (internal quotation marks omitted). In arguing that definiteness is connected with a potential infringer's ability to ascertain whether its products infringe the claims of a patent, defendants rely on "the purpose of the definiteness requirement[, which] is to ensure that the claims delineate the scope of the invention using language that adequately notifies the public of the patentee's right to exclude." *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 783 (Fed. Cir. 2010) (internal quotations marks omitted). However, Federal Circuit precedent makes clear that "[t]he test for indefiniteness does not depend

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<sup>1</sup> In 2011 Congress passed the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112-29, 125 Stat. 284 (2011), which modified 35 U.S.C. § 102. Since the new statute does not apply to patents with effective filing dates predating the law's effective date of March 16, 2013, see *id.* at 293, the Court relies on the pre-AIA version of the statute.

on a potential infringer's ability to ascertain the nature of its own accused product to determine infringement, but instead on whether the claim delineates to a skilled artisan the bounds of the invention." *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1340-41 (Fed. Cir. 2005). Therefore, the question of indefiniteness does not turn on whether an *accused product* can be easily categorized as infringing or not.

In this case, the Court "reduced [the claim terms] to words," and one of ordinary skill in the art can "translate the definition into [a] meaningfully precise claim scope." *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1251 (Fed. Cir. 2008). The definition of a "light pipe" – a "hollow cylinder or tube that transmits light" – gives the term a "meaningfully precise claim scope." Claim Constr. Order, at 3; *Halliburton Energy Servs., Inc.*, 514 F.3d at 1251. The same can be said of the claim phrase, "internally reflected along the pipe," which the Court did not further construe. Claim Constr. Order, at 3.

In fact, it would be unusual if a claim that can be construed definitely could suddenly become indefinite because an accused product came close to infringing but left the possibility of its noninfringement. A party should not be able to invalidate another's patent solely by coming close enough to infringing that

a Court cannot determine infringement, a question of fact, as a matter of law on a motion for summary judgment.

In addition, defendants miss a critical step in their analysis of infringement. Even if the Court has construed a patent's claims and the parties agree to the exact parameters of the accused product, the finder of fact must determine whether the accused product actually meets the requirements of the claim. This is a factual determination that should go to a jury unless there is no genuine dispute as to whether the accused product infringes. Here, factual disputes precluded the Court from concluding that the accused product did not infringe.

Moreover, the Court based its denial of defendants' motion for summary judgment on the issue of infringement on the evidence before it, which consisted primarily of a textual description of the product and two two-dimensional depictions of the product. Therefore, contrary to defendants' contentions, the Court did not conclude that infringement was dependent on the perspective from which the accused product was viewed. See Memorandum in Support of Defendants' Motion for Summary Judgment that Claims 1 and 30 of U.S. Patent No. 7,874,487 Are Invalid for Indefiniteness, Feb. 6, 2014, at 8-9. Rather, the Court simply could not find noninfringement, as a matter of law, based on the materials submitted to the Court in support of defendants' motion for summary judgment. Based on this evidence alone – and without



seeing the product itself, for example – the Court could not ascertain whether defendants' product infringes the asserted claims of the patent-in-suit. Since the Court's inability to ascertain infringement was not due to an infirmity in the written description of the patent's claims, but rather due to the insufficient evidence presented, the Court cannot conclude that the asserted claims of the '487 patent are invalid as indefinite based on its previous denial of defendants' motion for summary judgment on infringement.

Accordingly, the Court hereby denies defendants' motion for summary judgment in their favor finding indefiniteness, especially in light of defendants' burden to demonstrate invalidity by clear and convincing evidence. *See Haemonetics Corp.*, 607 F.3d at 783. Trial will commence, as previously scheduled, on April 21, 2014. The Clerk of the Court is directed to close document 143 in the docket of this case.

SO ORDERED.

Dated: New York, New York  
April 4, 2014

  
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JED B. RAKOFF, U.S.D.J.