United States District Court,
D. Massachusetts.

Kaplesh KUMAR,
Plaintiff.
v.
OVONIC BATTERY CO., INC., Energy Conversion Devices, Inc., and Stanford Ovshinsky,
Defendants.

No. 01-CV-11247-MEL

July 8, 2002.

Kaplesh Kumar, pro se.

Kaplesh Kumar, Wellesley, MA, W.P. Colin Smith, Winchester, MA, Anil Kumar, for Plaintiff.

Ovonic Battery Co., Inc., for Defendant.

H. Joseph Hameline, Mintz, Levin, Cohn, Ferris, Glovsky & Popeo, PC, Boston, MA, Patrick J. Coyne, Collier Shannnon Scott, PLLC, Washington, DC, Energy Conversion Devices, Inc., for Defendant.

H. Joseph Hameline, Patrick J. Coyne, (See above for address), Ovonic Battery Co., Inc., for Claimant.

H. Joseph Hameline, Patrick J. Coyne, (See above for address), Energy Conversion Devices, Inc., for Claimant.

H. Joseph Hameline, Patrick J. Coyne, (See above for address), Kaplesh Kumar, for Defendant.

Kaplesh Kumar, Gale Sober, Content Acquisition Specialist, Thomson West, Government Relations & Information Acquisition, Eagan, MN, pro se.

MEMORANDUM AND ORDER

LASKER**, J.**

This patent infringement case concerns the technology behind Nickel Metal Hydride ("NiMH") batteries, rechargeable batteries that are commonplace in commerce today. Kaplesh Kumar is an inventor who asserts that he devised the critical technology in 1980. Kumar alleges that Ovonic Battery Co., Inc. ("OBC"), and Energy Conversion Devices, Inc. ("ECD"), are directly and contributorily infringing his United States Letters Patent No. 4,565,686 (the " '686 patent"), and actively inducing others to infringe. Kumar sues for violation of M.G.L. ch. 93A as well.

OBC and ECD have filed a counterclaim, seeking declaratory judgment that they are not infringing the '686 patent and alleging that Kumar has misused his patent and thereby violated the Sherman Act, 15 U.S.C. s. 2, by attempting to monopolize the market.

The defendants move for an order construing the '686 patent and for summary judgment. The motion for an order construing the '686 patent is granted in part and denied in part, and the motion for summary judgment is granted. FN1

FN1. Kumar filed two motions as well, which are resolved as follows: (1) Kumar's motion to stay *Markman* procedures is denied; and (2) Kumar's motion for an order construing the defendants' patents is denied as moot.

Additionally, Kumar asserts *inter alia* in his papers that he needs additional discovery before the pending motions could be addressed properly. Construing these protestations as intending to invoke Fed.R.Civ.P. 56(f), the implicit motion is denied as improperly made and insufficiently definite. *See* Filiatrault v. Comverse Technology, Inc., 275 F.3d 131, 138 (1st Cir.2001) ("a party who seeks to invoke the prophylaxis of Rule 56(f) must articulate some plausible basis to support a belief that discoverable material exists which, if available, would suffice to raise a trialworthy issue").

I.

The factual background relevant for deciding this motion is limited. Kumar discovered that the properties of certain "rare earth transition metal alloys" are ideal for use in rechargeable batteries that now power countless appliances and devices in the world. He applied for a patent to protect his invention. The United States Patent and Trademark Office eventually issued the '686 patent, but only after Kumar amended his application by surrendering a subset of the metal alloys he had originally sought to patent. Later, Kumar assigned the '686 patent to The Charles Stark Draper Laboratory, Inc., based in Cambridge, Massachusetts, which in turn granted back to Kumar an exclusive license to the '686 patent.

OBC, the assignee of United States Letters Patent No. 5,840,440 (the " '440 patent"), and ECD, the assignee of United States Letters Patent No. 4,623,597 (the " '597 patent"), produce and license others to produce batteries under their patents. Both of the defendants' patents cover related battery technologies, and were filed later than Kumar's '686 patent. Stanford Ovshinsky is the inventor listed in the '440 and '597 patents, and although he was named as a defendant, the parties have dismissed him without prejudice from this matter.

Kumar alleges that the defendants have infringed and are continuing to infringe his '686 patent. He contends that tests of several batteries manufactured by licensees of the defendants reveal that they contain the metal alloys protected by the '686 patent. The defendants deny that they are infringing, and instead assert that Kumar is improperly attempting to monopolize the market by asserting that the '686 patent's coverage is much broader than its properly construed scope.

The issue is clear: whether Kumar, during the prosecution of his patent, ceded the materials that the defendants patented, produce, and license.

II.

A. Infringement

The major thrust of the defendants' motion is that Kumar was forced to cede certain claims he made during his patent prosecution for what eventually became the '686 patent, and that the products that the defendants produce and license fall within the ceded areas.FN2 Therefore, the defendants conclude that they cannot be infringing Kumar's '686 patent because it does not cover their products. Their related argument is that under Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd., 535 U.S. 722, 122 S.Ct. 1831 (2002), Kumar should be barred from asserting that they infringe under the doctrine of equivalents.

FN2. The defendants also argue that they are not liable for infringement, contributory infringement, or inducing others to infringe because they do not meet the statutory requirements set out in 35 U.S.C. s. 271, which requires an infringer to "make[ ], use[ ], offer[ ] to sell, or sell[ ] any patented invention" to be liable. There are disputes of material facts on this issue, to wit, whether the defendants have actively induced others to make infringing batteries and whether the defendants are contributorily infringing. Accordingly, summary judgment is not granted on the basis of this argument.

Kumar denies that he gave up the subject matter as to which the defendants are licensing products. He also asserts that the patents that the defendants obtained for their inventions were acquired by omitting reference to his earlier '686 patent, and are therefore invalid.

As indicated above, the heart of the debate is as to exactly what Kumar surrendered during his patent prosecution. Again, at issue here are metal alloys that have useful properties for making batteries in varying degrees: each metal alloy has more or less of these properties as compared to others. There are two competing descriptions of these metal alloys, which require explanation.

First, one can describe metal alloys using a continuum of words which denote how orderly the molecules comprising them are aligned. On one side of the continuum are metal alloys whose molecules have no order, and are therefore called "completely amorphous." Far to the other side are metal alloys whose molecules are structured so well that they are described as "crystalline." Between the extremes are designations that denote varying levels of orderliness: "partially crystalline" and "metastable crystalline" reflect metal alloys whose molecules are more ordered than "completely amorphous" and less ordered than "crystalline." Within this spectrum are a subset of metal alloys called "nonequilibrium alloys," which comprises "amorphous," "partially crystalline," and "metastable crystalline" alloys. It is these "nonequilibrium alloys" that are in dispute in this case.

The defendants argue that Kumar, who from the outset sought only to patent "nonequilibrium alloys," surrendered "partially crystalline" and "metastable crystalline" alloys to obtain the '686 patent, leaving him with the right to patent only "amorphous" alloys. Since the defendants exclusively produce or license batteries with "metastable crystalline" metal alloys, they assert that they do not and cannot infringe the '686 patent.

Kumar disagrees with the above analysis. He argues that his patent was a "pioneering" patent, which means that the language being used at the time he patented his invention was less clearly defined than it is today. In fact, Kumar contends what he patented is what the defendants patented and are producing and licensing. He asserts that at the time he patented his invention, the term "amorphous" referred to the size of the ordered regions in the metal alloys. That is, a metal alloy has pockets of ordered molecules which are in varying sizes. As the sizes get larger, the alloy is increasingly ordered and therefore more "crystalline." Kumar argues that he claimed everything that was less than "long range order," which has since been defined to be

regions of ordered molecules with sizes greater than 100 nanometers. The defendants, Kumar alleges, have patented, produced, and licensed metal alloys with ordered regions far below 100 nanometers in size, and therefore, Kumar concludes that the defendants are infringing the '686 patent.

I find the defendants' version of what Kumar surrendered during the patent prosecution the more persuasive description, and accordingly, summary judgment is granted for the defendants on the infringement count. Construing claims is a question of law for the Court's decision. Markman v. Westview Instruments, Inc., 52 F.3d 967, 977-78 (Fed.Cir.1995), *aff'd,* 517 U.S. 370, 388-90 (1996). I find that the meaning of the word "amorphous" in claims 1 and 6 of the '686 patent is reasonably construed to mean "completely amorphous," and therefore excludes "partially crystalline" and "metastable crystalline" metal alloys. Accordingly, as the defendants do not produce or license "amorphous" metal alloys, they do not infringe.

I find that the meaning of the word "amorphous" in claims 1 and 6 of the '686 patent means "completely amorphous" based on the '686 patent specification, which sheds light on the meaning of the otherwise undefined term. In the specification, the term "amorphous" is repeatedly used as an opposition to "metastable crystalline," implying they do not overlap. *See, e.g.,* '686 patent, col. 1, 11. 62-63; col. 2, 11. 16-24; and col. 3, 11. 42-43. Similarly, the term "partially crystalline" is differentiated from "completely amorphous" and "metastable crystalline." *See, e.g.,* '686 patent, col. 2, 11. 16-24; and col. 4, 11. 33-35. So understood, the only meaning of "amorphous" consonant with its use in the '686 patent claims is "completely amorphous."

Kumar's nanometer-defined construction is unconvincing because it employs a description of "long range order" (greater than 100 nanometers) developed *after* his patent was filed, and therefore cannot be taken to describe accurately what he sought to patent. Moreover, it is clear from the prosecution history that the patent examiner at the Patent and Trademark Office was vigorous and vigilant in disallowing-four times-Kumar's attempts to include "partially crystalline" and "metastable crystalline" metal alloys. Had Kumar sought to define his patent's scope by using other language, he could have. Kumar chose not to describe the metal alloys by reference to the size in nanometers of ordered regions within them, and cannot now have the benefit of that measuring technique. Simply put, because Kumar elected to exclude from his patent's claims everything but "amorphous" metal alloys, he is not entitled to claim more than that.FN3

FN3. Similarly, resort to the doctrine of equivalents fails under Festo, 535 U.S. at _____, 122 S.Ct. at 1842, which held that "the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question" because the "patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." Kumar has not met his burden here, where it is clear that Kumar made narrowing amendments to get his patent approved, and the narrowing amendments clearly concerned the subject matter area that Kumar now seeks to cover.

B. Unfair Business Practices (M.G.L. ch. 93A)

The defendants argue that Kumar's count for unfair business practices should be dismissed because: (1) it is preempted, *see* Hunter Douglas, Inc. v. Harmonic Design, Inc., 153 F.3d 1318, 1335 (Fed.Cir.1998), *overruled on other grounds,* Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356 (Fed.Cir.1999) ("Patent law is completely preempted by federal laws."); and, (2) even if it is not preempted, because summary judgment should enter in their favor on the patent infringement claim, the Court does not have

jurisdiction over the state law count alone.

Kumar replies that the count is not preempted because M.G.L. ch. 93A, s. 2, indicates that courts should be "guided by the interpretation given by the Federal trade Commission and the Federal counts to section 5(1)(1) of the Federal Trade Commission Act (15 U.S.C. s. 45(a)(1)), as from time to time amended." Therefore, Kumar concludes that there is no conflict.

Given the early stage of this litigation, with no discovery having taken place, I decline to exercise supplemental jurisdiction over the unfair business state law claim, and therefore, Count II is dismissed. Given this decision, there is no need to address the preemption challenge.

III.

As indicated above, the defendants' motion for an order construing the '686 patent is granted in part and denied in part, the defendants' motion for summary judgment is granted, and the amended complaint is dismissed.

Remaining in this matter are the counterclaims asserted by the defendants against Kumar. A status conference will be set to determine a schedule for disposition of any remaining issues.

It is so ordered.

D.Mass.,2002.
Kumar v. Ovonic Battery Co., Inc.