United States District Court,
E.D. Pennsylvania.

**CONNECTEL, LLC,**
Plaintiff.
v.
**ITXC, INCORPORATED,**
Defendant.

**March 17, 2004.**

Frederick A. Tecce, Anthony J. Dimarino, III, On behalf of plaintiff Connectel, LLC.

Jeffrey I. Kaplan, Eugene Hamill, Joseph A. Mcginley, Timothy X. Gibson, On behalf of defendant ITXC, Incorporated.

***OPINION***

GARDNER**, J.**

This matter is before the court on the Motion for Summary Judgment Declaring Certain Claims in Issue Invalid and/or Not Infringed filed by defendant on October 17, 2002. FN1 On February 10, 2004, the undersigned conducted a hearing and argument upon the issues of claim construction raised in defendant's motion. FN2

FN1. On October 17, 2002, defendant filed a brief in support of its motion. On October 22, 2002, Plaintiff Connectel, LLC's Brief in Opposition to Defendant ITXC, Inc.'s Motion for Summary Judgment of Non-Infringement and Invalidity was filed. On November 18, 2002, ITXC's Reply Brief in Support of Its Claim Construction and Motion for Summary Judgment was filed.

FN2. Although we labeled the February 10, 2004 hearing a *Markman* hearing, *see* Markman v. Westview Instruments, Inc., 52 F.3d 967 (Fed.Cir.1995), we utilized the hearing for the limited purpose of learning about the patent technology. *See* Elkay Manufacturing Company v. EBCO Manufacturing Company, 192 F.3d 973, 977 (Fed.Cir.1999).

At the invitation of the court, Connectel, LLC's Three Page Submission regarding the Doctrine of Equivalents and a letter brief concerning the doctrine of equivalents from ITXC were submitted February 17, 2004. The Reply of Connectel, LLC to ITXC, Inc.'s Submission concerning the Scope of ITXC's Motion for Summary Judgment was filed February 20, 2004. On February 25, 2004, ITXC's Combined Motion to File Reply on Waiver, Brief in Reply on Waiver, and Motion to Strike the Testimony of Regis J. Bates from the Record, in which defendant seeks "to address Connectel's improperly filed 'reply' brief" by filing one of its own, was filed. We consider each of these documents herein.

In its motion, defendant seeks to have the court construe three phrases in United States Patent Number 6,016,307 ("the '307 patent"), FN3 seeks summary judgment on infringement, and seeks summary judgment on whether the '307 patent is valid. Because we conclude that the specification and the prosecution history of the '307 do not permit the meaning which plaintiff seeks to attribute to the phrases "property of the data file" and "measuring of said parameters", we grant defendant's motion for claim construction. Because we conclude that resolution of the motion for summary judgment upon the issues of infringement and patent validity requires a hearing upon *Daubert* FN4 issues and upon alleged violations of Rule 26(a) of the Federal Rules of Civil Procedure, we deny defendant's motion for summary judgment without prejudice to refile pending a hearing on those issues. Accordingly, we grant defendant's request for a hearing regarding the testimony of Regis J. Bates Jr., and permit defendant to reassert its motion for summary judgment on the issue of validity after the hearing.

FN3. Defendant seeks to have the following phrases construed: "property of the data file", "measuring of said parameters", and "determining which of said paths". In response to defendant's motion, plaintiff agreed with defendant's contentions regarding the meaning of "determining which of said paths". Furthermore, plaintiff agreed that defendant's device did not infringe upon plaintiff's device based upon this aspect of the '307 patent. Accordingly, we do not address this phrase below.

FN4. Daubert v. Merrell Dow Pharmaceuticals, Inc., 509 U.S. 579, 113 S.Ct. 2786, 125 L.Ed.2d 469 (1993).

## *PROCEDURAL HISTORY*

The within civil action was initiated on May 23, 2000 by a one-count Complaint. Plaintiff avers that defendant is infringing upon the '307 patent, which is owned by Connectel, by assembling, offering to sell, or selling a device that falls within one or more of the claims expressed in the '307 patent without paying Connectel a licensing fee or royalty. FN5 On July 11, 2000, defendant answered the Complaint and filed a counterclaim which alleged that the '307 patent is invalid. *See* 35 U.S.C. s. 102.

FN5. *See* 35 U.S.C. s.s. 271-296.

This matter is before the court on federal question jurisdiction. *See* 28 U.S.C. s.s. 1331, 1338. Venue is proper in the United State District Court for the Eastern District of Pennsylvania because acts of patent infringement allegedly occurred within the judicial district. *See* 28 U.S.C. s.s. 118, 1391(b), 1391(c); 28 U.S.C. s. 1400(b). Both parties have made a jury demand.

## *CLAIM CONSTRUCTION*

Before we may determine whether summary judgment is appropriate on the issues of infringement or patent invalidity, we must construe the disputed claims of the patent. *See* Vitronics Corporation v.. Conceptronics, Inc., 90 F.3d 1576, 1581-1582 (Fed Cir.1996). The parties dispute the meaning the inventor attributes to the phrases "property of the data file" and "measuring of said parameters" in the claims of the '307 patent.

The '307 patent contains 28 claims, two of which, claims 1 and 14, are independent claims. Claim 1, which is the independent claim at issue, reads:

In a telecommunications switching system comprising a plurality of interfaces, each of said interfaces interconnected with an associated telecommunications path capable of transferring a data file from a first memory to a remote destination, each of said telecommunications paths having predetermined parameters associated therewith stored in a second memory in said switching system and variable parameters associated therewith, a method of determining which of said plurality of telcommunications paths should be utilized for transferring the data file from said first memory, said method comprising the steps of:

a) analyzing a property of the data file to be transferred;

b) measuring said variable parameters and said predetermined parameters;

c) analyzing said measured variable and said predetermined parameters; and

d) determining which of said paths provides an optimal set of characteristics for transferring the file to the remote destination in accordance with said analyzed variable parameters and predetermined parameters and said analyzed data file property.

Complaint, Exhibit A.

***Standard of Review***

"It is well-settled that, in interpreting an asserted claim, the court should look first to the intrinsic evidence of record, *i.e.*, the patent itself, including the claims, the specifications and, if in evidence, the prosecution history." Vitronics, 90 F.3d at 1582. These sources are the most important evidence of not only the applicant's intended meaning, but also serves "as an official record that is created in the knowledge that its audience is not only the patent examining officials and the applicant, but the interested public." Biogen, Inc. v. Berlex Laboratories, Inc., 318 F.3d 1132, 1140 (Fed Cir.2003). An assertion or disavowal of specific meanings in any of these sources weighs heavily on the meaning attributed to the words found within the claims.

In determining the meaning of the disputed claims, we begin with the words found within the claims themselves. "Words in a claim are generally given their ordinary and customary meaning". Vitronics, 90 F.3d at 1582. However, "a patentee may choose to be his own lexicographer and use terms in a manner other than their ordinary meaning, as long as the special definition of the term is clearly stated in the patent specification or file history." *Id*.

After reviewing the words in the claims, we then evaluate the patent's specification. "Although it is improper to read a limitation from the specification into the claims, Comark Communications, Inc. v. Harris Corporation, 156 F.3d 1182, 1186 (Fed, Cir.1998), 'claims must be read in view of the specifications, of which they are a part." ' Microsoft Corporation v. Multi-Tech Systems, Inc., Civ No. 03-1138, 03-1139, 2004 U.S.App. LEXIS 1595, *16, 2004 WL 191013 (Fed.Cir. February 3, 2004) ( *quoting* Markman, 52 F.3d at 979). "[I]t is ... necessary to review the specification to determine whether the inventor has used any terms in a manner inconsistent with their ordinary meanings. The specification acts as a dictionary when it expressly defines terms in the claims or when it defines terms by implication." Vitronics, 90 F.3d at 1582.

Finally, we may consider the prosecution history of the patent. "This history contains the complete record of all the proceedings before the Patent and Trademark Office, including any express representations made by

the applicant regarding the scope of the claims." Vitronics, 90 F.3d at 1582. "We cannot construe ... claims to cover subject matter broader than that which the patentee itself regarded as comprising its invention and represented to the PTO." *Microsoft,* Civ No. 03-1138, 03-1139, 2004 U.S.App. LEXIS 1595, *24, 2004 WL 191013; Spring Window Fashions, LP, Shade-O-Matic LTD. v. Novo Industries, L.P., 323 F.3d 989, 994 (Fed.Cir.2003) ("It is well established that 'the prosecution history limits the interpretation of claim terms so as to exclude any interpretation that was disclaimed during prosecution ." ') (citations omitted); *see* Elkay, 192 F.3d 973, 978 (Fed.Cir.1999) ("The prosecution history gives insight into what the applicant originally claimed as the invention, and often what the applicant gave up in order to meet the Examiner's objections") (citations omitted).

If the meaning of the patent is not apparent from the intrinsic evidence, then the court may consider extrinsic evidence. Vitronics, 90 F.3d at 1583. Because we conclude that the meaning of the phrases "property of the data file" and "measuring of said parameters" may be determined from the intrinsic evidence, we need not consider any extrinsic evidence.

***Discussion***

The parties dispute whether the phone number to which a file is sent is itself a "property of the data file". Plaintiff contends that there is nothing in the claim or specification that gives a specialized meaning of the phrase such that a phone number could not be interpreted as a "property of the data file". Defendant contends that plaintiff disavowed such an interpretation in the prosecution history. In support of its contention, defendant employs the following logic.

In its response to the examiner's initial rejection of the '307 application, the applicant distinguished his invention from the prior art, Kobayashi (U.S. Patent No. 5,337,352), by stating that the prior art had not examined a "property of the data file" when determining how to route a file. However, it is undisputed that Kobayashi analyzed a phone number in determining how to route phone calls. Therefore, defendant asserts that if Kobayashi analyzed a phone number and the applicant for the '307 patent distinguished his invention from Kobayashi by claiming that Kobayashi did not analyze a property of the data file, then a phone number cannot be a property of the data file. In other words, defendant claims that the applicant expressly disclaimed the meaning which plaintiff now seeks to attribute to the '307 patent. For the following reasons, we agree with defendant.

We begin our analysis with the language in the claims. There is only one reference to the "property of the data file" phrase in the remainder of the claims. Claim 27 states "The method of claim 1 wherein the data file property analyzed is the data file type." FN6 This language does not narrow the construction of the "property of the data file" as defendant suggests.

FN6. Complaint, Exhibit A. Claims 25 and 26 also make reference to a "data file property", but these references are particularized to Claim 14. Nevertheless, claim 25 states that a data file property is the data file type. Claim 26 states that a data file property is the data file size. Neither of these claims includes a reference to a phone number being a "property of the data file to be transferred" and we conclude that these references are not dispositive on the issue of whether such an interpretation was disavowed by the applicant.

Next, we turn to the specifications. At Column 4, line 58, of the specification, the applicant cites as an example, but not as a limitation, that the invention examines the size of the file to be transmitted. There is

no other language within the specification to give further context to the applicant's definition of the "property of the data file". Accordingly, we conclude that neither the claims nor the specification limit the phrase as defendant suggests.

However, an examination of the prosecution history requires a different result. The '307 patent application was initially rejected by the examiner because of deficiencies in claims 2-8, 11, 13 and 14-23 and because claims 1-24 were deemed unpatentable in light of Kobayashi and Derby (U.S. Patent No. 5,274,625). The applicant responded to the rejection by amending some of the claims and distinguishing the prior art.

Of relevance here, the applicant amended the phrase "property of the data file" to "property of the data file to be transferred". The applicant also distinguished the definition of the "property of the data file" in the '307 applicant from the meaning the examiner read into Kobayashi and Derby. In so doing, the applicant represented to the patent office and interested public that Kobayashi does not examine a "property of the data file" as that term was defined in the '307 application. Rather, the applicant's response to the patent examiner reads, in pertinent part:

the present invention is a system wherein predetermined static parameters regarding the telecommunications paths, measured variable parameters, and parameters specific *to the data file itself* are used by the system to define the method of a data file transfer from a source location to a destination.... The Applicants [sic] invention provides for the storage of the data file and a processor means to analyze the data file properties to help determine the optimum path for that particular file. The data file properties are used in conjunction with predetermined parameters which define the telecommunications paths and the variable parameters associated with the telecommunications path to determine the appropriate path for the data file transfer. In order to more clearly define the invention with respect to the prior art, claim 1 has been amended to incorporate the limitation that *a property of the file to be transferred* is analyzed to determine the most suitable path for the file.... It is not taught or suggested by Kobayashi to utilize ... a property of the data file itself.... In particular Kobayashi does not disclose the need to look at *the file itself* since the nature of that invention was to connect phone calls and not to transfer a data file as in the present invention. Even if Kobayashi was extended (as the Examiner seems to suggest in his rejection) to include a line terminal instead of a phone, there is no teaching of the desirability of *analyzing the file to be transferred* in order to determine the path to take.

Motion for Summary Judgment Declaring Certain Claims in Issue Invalid and/or Not Infringed, Exhibit D, *Amendment,* pages 6-7 (emphasis in original).

The applicant's representations to the patent examiner clearly indicate that the applicant did not include a phone number within the meaning of the phrase "property of the data file to be transferred". At its base level, without any extension, Kobayashi routes telephone calls on a Public Switch Telephone Network ("PSTN"). The only feature upon which Kobayashi can determine how to route calls is the phone number. Kobayashi does not examine whether a call is voice or data because either is irrelevant to the selection of the transmission medium or path. Thus, the applicant's unequivocal statement that the '307 application was distinguishable from Kobayashi because Kobayashi did not analyze a property of the data file, precludes the phone number from being included within the meaning of the '307 patent. To hold otherwise would render it impossible for the public to determine the meaning of the '307 patent.

The parties also dispute the meaning of the phrase "measuring said variable parameters". Defendant contends that the '307 patent requires that the measuring of the said variable parameters must occur in real

time at or near the time of transfer. Plaintiff contends that there is no aspect of the phrase into which a time limitation could be read.

The applicant does not give specific context to the phrase within the other claims. Claim 18 states: "The switching system of claim 16 in which said data transfer speed measurement is performed by a ping test." FN7 While this claim requires a measurement by a ping test, a nearly instantaneous measurement of network path availability, it does not state a framework requirement for when the ping test must be completed prior to file transfer.

FN7. Complaint, Exhibit A.

In the specification, however, the applicant attributes a specialized meaning to the phrase. The specification reads, in pertinent part:

The present invention recognizes that the selection of the optimal route for data transmission at a given time is a dynamic analysis that must be done in real-time ... (Column 2, lines 10-12.)

* * *

It is an object of the present invention to provide a system and method for selecting an optimal telecommunications path for connecting a call to a remote location for the transfer of a data file thereover by analyzing on a real time basis a set of multiple protocols. (Column 2, lines 42-46.)

* * *

Data regarding the predetermined parameters are stored in a memory 22 in the switching system 10, while data regarding the measurable parameters must be collected by a path analysis block 24 from each interface in real time at or about the time the file is to be transferred in order for the routing methodology to make a proper analysis. (Column 4, lines 17-23.)

* * *

It is an even further object of the present invention to provide such a system and method for multi-protocol route optimization which analyzes various factors regarding the route on a real-time basis in determining the optimal route for the call. (Column 2, lines 52-56.)

* * *

That is, by employing the multi-protocol routing optimization of the present invention, the path chosen for transmission of a data file takes into account parameters which vary in real time, thus not relying on a simple preprogrammed look-up table of low cost providers as in the prior art. (Column 5, lines 3-8.)

* * *

The second component utilized by the routing methodology of the present invention is based in part upon real-time parameters that may exhibit a wide variance due to numerous reasons, some of which may be beyond the control of the user. (Column 5, lines 30-34.)

Complaint, Exhibit A. These passages clearly indicate that the applicant choose to attribute a specific real time requirement to the phrase "measuring said variable parameters". This reading is mandated by the unequivocal language employed by the applicant. In Column 2, lines 10-12, the applicant claims that the measurement "must" be done in real time.

Not only did the applicant foreclose the possibility of another meaning, but he differentiated his invention from the previous art on the basis of the real time measurement. For instance, in the specification, the applicant represented that:

This system [ (U.S. Patent # 5,337,352) ] is static, and not changeable on a real time basis since each tenant must predetermine the priority of specific providers to utilize. (Column 2, lines 29-31.)

Complaint, Exhibit A. The applicant repeated this contrast in his representations to the patent examiner after the initial rejection of the '307 patent. *See* Motion for Summary Judgment Declaring Certain Claims in Issue Invalid and/or Not Infringed, Exhibit D, *Amendment,* page 5.

Because the applicant used unequivocal language in the specification to apply a specific "real time at or about the time the file is to be transferred" requirement to the phrase and because the applicant differentiated his art from the previous art based upon the real time requirement, we conclude that the phrase "measuring said variable parameters" in claim 1 of the '307 patent requires a real time measurement at or near the time of file transfer.

## *SUMMARY JUDGMENT*

Defendant moves for summary judgment on the issues of infringement and patent validity. In response, plaintiff asserts that there are material issues of material fact that prevent the imposition of summary judgment. In support of its contention, plaintiff submits the testimony and expert report of Mr. Bates. Defendant counters that Mr. Bates' testimony and expert report are not supported by any evidence, are inadmissible based on *Daubert,* and violate Rule 26(a) of the Federal Rules of Civil Procedure. Because we determine that disposition of the motion for summary judgment requires a *Daubert* hearing and a hearing to determine whether portions Mr. Bates' expert report should be excluded on the basis of alleged violations of Rule 26(a) of the Federal Rules of Civil Procedure, we deny defendant's motion for summary judgment without prejudice to resubmit following a hearing scheduled June 9, 2004.

## *CONCLUSION*

For the foregoing reasons, we grant defendant's motion for claim construction and deny defendant's motion for summary judgment upon the issues of infringement and patent validity. Because we determine that a necessary precondition to the filing of defendant's motion for summary judgment is a *Daubert* hearing and a hearing to resolve alleged violations of Rule 26(a) of the Federal Rules of Civil Procedure, we deny defendant's motion for summary judgment without prejudice for defendant to refile after the hearing

scheduled June 9, 2004.

E.D.Pa.,2004.
Connectel, LLC v. ITXC, Inc.

Produced by Sans Paper, LLC.