

United States District Court,
E.D. Michigan, Southern Division.

SYMANTEC CORPORATION,
Plaintiff.

v.
COMPUTER ASSOCIATES INTERNATIONAL, INC,
Defendant.

No. 02-CV-73740-DT

March 16, 2005.

OPINION AND ORDER CONSTRUING PATENT CLAIMS

PAUL J. KOMIVES, United States Magistrate Judge.

I. Introduction

In this patent case, plaintiff Symantec Corporation, the successor-in-interest to Hilgraeve Corporation (the original owner of the patent and the original plaintiff in this case), brings infringement claims against defendant Computer Associates International, Inc., alleging that several of defendant's products violate U.S. Patent No. 5,319,776 ("the '776 patent"), which was issued on June 7, 1994, and which is entitled "In Transit Detection of Computer Virus with Safeguard." The patent discloses twenty method claims, two of which, Claims 1 and 18, are independent claims and the remainder of which are dependent claims. As briefly described by the Federal Circuit in a prior case involving the '776 patent, "[t]he claimed invention scans a body of data during its transfer, *i.e.*, before storage of the data with potential viruses on the destination storage medium. If the program detects signs of a virus during the scan, the program automatically blocks storage." *Hilgraeve Corp. v. McAfee Assocs., Inc.*, 224 F.3d 1349, 1350 (Fed.Cir.2000) (*Hilgraeve I*); *see also*, *Hilgraeve Corp. v. Symantec Corp.*, 265 F.3d 1336, 1339 (Fed.Cir.2001) (*Hilgraeve II*).

The parties dispute a number of terms used in the claims of the '776 patent. On December 8, 2004, the parties each submitted a claim construction brief with voluminous documentary exhibits. On December 15, 2004, the Court conducted a claim construction hearing, at which the parties presented oral argument but no additional evidence in support of their claim construction contentions.

II. Preliminary Matters

Before addressing the parties' contentions regarding claim construction, it is appropriate to address three preliminary matters.

A. Magistrate Judge Jurisdiction

This matter is before me on a general order of reference entered by Chief Judge Friedman referring the

matter to me for the purpose of conducting all pretrial proceedings. Thus, I must initially determine whether I may resolve the claim construction issues through an order pursuant to 28 U.S.C. s. 636(b)(1)(A), or rather am limited to issuing a recommended disposition pursuant to s. 636(b)(1)(B). I conclude that it is appropriate to resolve these matters by order rather than by recommendation.

Under s. 636(b)(1)(A),

a judge may designate a magistrate judge to hear and determine any pretrial matter pending before the court, except a motion for injunctive relief, for judgment on the pleadings, for summary judgment, to dismiss or quash an indictment or information made by the defendant, to suppress evidence in a criminal case, to dismiss or permit maintenance of a class action, to dismiss for failure to state a claim upon which relief can be granted, and to involuntarily dismiss an action.

28 U.S.C. s. 636(b)(1)(A). With respect to the excepted matters explicitly set forth in subparagraph (A), a magistrate judge's authority is limited to issuing "proposed findings of fact and recommendations for the disposition" of the motion. 28 U.S.C. s. 636(b)(1)(B).

A claim construction is not a specifically enumerated exception to a magistrate judge's jurisdiction to hear and determine pretrial matters, and thus would appear to be amenable to determination by a magistrate judge. On the other hand, however, claim construction is an issue of law and, as discussed below, the first step in a two-step inquiry when patent infringement is alleged. Thus, claim construction is somewhat in the nature of a partial summary judgment, which is a specifically enumerated exception. There appear to be no cases discussing a magistrate judge's authority with respect to claim construction.

Nevertheless, it is unnecessary to resolve this question. Under s. 636 and FED.R.CIV.P. 72, a district judge reviews *de novo* a recommended disposition, but may set aside a magistrate judge's determination only if "clearly erroneous or contrary to law." *See* 28 U.S.C. s. 636(b)(1); FED.R.CIV.P. 72(b). Here, however, the standard of review is the same regardless of whether I proceed by way of determination or recommendation. "[T]he phrase 'contrary to law' indicates plenary review as to matters of law." *Haines v. Liggett Group, Inc.*, 975 F.2d 81, 91 (3d Cir.1992). Thus, although review of magistrate's determination is for clear error with respect to factual findings, "[a] contrary to law review amounts to a *de novo* review of the magistrate judge's legal conclusions." *In re MTI Tech. Corp. Sec. Litig. II*, No. SACV 00-745, 2002 WL 32344347, at (C.D.Cal. June 13, 2002); *see also*, *Thomas v. Ford Motor Co.*, 137 F.Supp.2d 575, 579 (D.N.J.2001); *Smith v. Smith*, 154 F.R.D. 661, 665 (N.D.Tex.1994); *Gandee v. Glaser*, 785 F.Supp. 684, 686 (S.D.Ohio 1992), *aff'd*, 19 F.3d 1432 (6th Cir.1994). Because the standard of review is the same, I will determine this matter, leaving it to Chief Judge Friedman's discretion to treat this Order as a Report and Recommendation if he concludes that is appropriate.

B. Judicial Estoppel

Throughout its brief defendant repeatedly notes that many of its proposed constructions are identical to the constructions advanced by plaintiff in the *Hilgraeve* case, when plaintiff was defending against claims of infringement under the '776 patent. It is unclear whether defendant points this out merely as persuasive support for its position, or is arguing that plaintiff is estopped from taking a contrary position here. To the extent that defendant is arguing the latter, its argument is without merit.

"Judicial estoppel 'generally prevents a party from prevailing in one phase of a case on an argument and

then relying on a contradictory argument in another phase.' " Valentine-Johnson v. Roche, 386 F.3d 800, 811 (6th Cir.2004) (quoting New Hampshire v. Maine, 532 U.S. 742, 749, 121 S.Ct. 1808, 149 L.Ed.2d 968 (2001) (internal quotation omitted)); *see also*, United States v. Owens, 54 F.3d 271, 275 (6th Cir.1995). FN1 To successfully assert judicial estoppel, however, it is not enough for the party asserting estoppel to show that the party sought to be estopped took a contrary position in earlier litigation. It must also show that "the prior court adopted the contrary position 'either as a preliminary matter or as part of a final disposition.' " Eubanks v. CBSK Fin. Group, Inc., 385 F.3d 894, 897 (6th Cir.2004) (quoting Teledyne Indus., Inc. v. National Labor Relations Bd., 911 F.2d 1214, 1218 (6th Cir.1990)); *see also*, Valentine-Johnson, 386 F.3d at 811; Browning v. Levy, 283 F.3d 761, 775 (6th Cir.2002).

FN1. As noted below, *see infra* n. 3, this Court is bound by the decisions of the Federal Circuit with respect to matters within that court's exclusive jurisdiction. For procedural matters, however, the Federal Circuit applies the law of the circuit court—here the Sixth Circuit—in which an appeal would lie but for the patent claims. Judicial estoppel is such a procedural matter, *see* U.S. Philips Corp. v. Sears Roebuck & Co., 55 F.3d 592, 596 n. 3 (Fed.Cir.1995); Water Tech. Corp. v. Calco, Ltd., 850 F.2d 660, 665 n. 3 (Fed.Cir.1988), and thus Sixth Circuit law controls the resolution of this issue.

Here, defendant has not shown that the claim construction positions taken by plaintiff in the *Hilgraeve* case were adopted by this Court or the Federal Circuit. On the contrary, to the extent that the claim construction issues were addressed at all by those courts, it appears that they rejected plaintiff's position. More fundamentally, there was no judicial acceptance of plaintiff's position in that case because the case resulted in a settlement. As the Sixth Circuit has repeatedly explained, "[w]hen an ordinary civil case is settled, there is no 'judicial acceptance' of anyone's position and thus there can be no judicial estoppel in a later proceeding." Reynolds v. Commissioner of Internal Revenue, 861 F.2d 469, 473 (6th Cir.1988); *accord* Teledyne, 991 F.2d at 1219; Edwards v. Aetna Life Ins. Co., 690 F.2d 595, 599 (6th Cir.1982); *see also*, In re Bankrest Capital Corp., 375 F.3d 51, 60 (1st Cir.2004); Bates v. Long Island R.R. Co., 997 F.2d 1028, 1038 (2d Cir.1993). FN2 Accordingly, plaintiff is not judicially estopped from taking claim construction positions here which conflict with its positions in the *Hilgraeve* case.

FN2. A narrow exception, not applicable here, exists for settlements in cases in which the court must approve the settlement as being fair and equitable, such as bankruptcy cases and state court divorce and custody proceedings. *See* Reynolds, 861 F.2d at 473.

C. Defendant's Supplemental Brief

On January 10, 2005, defendant submitted a supplemental claim construction brief based on the Rule 30(b)(6) deposition of plaintiff by Michael Schallop, a patent attorney and director of plaintiff. In its supplemental brief, defendant asserts that Mr. Schallop's testimony supports several of the positions defendant has taken on claim construction. Briefly stated, defendant contends that Mr. Schallop admitted that: (1) the Federal Circuit's construction of "storage" in *Hilgraeve II* is not the ordinary meaning of the word; (2) the phrase "screening the data as it is being transferred" was added to Claim 1 to overcome the prior art; (3) the preamble of claim 18 provides antecedent basis for the terms "computer" and "storage medium"; and (4) defendant has "flip-flopped" on construction now that is a plaintiff.

On January 12, 2005, plaintiff filed an opposition to the defendant's supplemental brief. In addition to

arguing the merits of defendant's claims in the supplemental brief, plaintiff contends that the brief is inappropriate because (a) no court rule or order authorized defendant to file such a brief, and (b) it is unfair given that defendant has as of yet failed to provide further deposition testimony on its own claim construction contentions. Defendant filed a reply on January 13, 2005.

The Court need not consider whether defendant's supplemental brief is proper because, in the end analysis, it does not in any way affect the Court's analysis. With respect to defendant's argument that Mr. Schallop admitted that plaintiff has changed its claim construction arguments since the *Hilgraeve* case, as explained above defendant has failed to establish that judicial estoppel applies here, and thus any admission by Schallop regarding a change in position is irrelevant. *See supra* part II.B. The Court will discuss the remaining contentions of the supplemental brief in footnotes appended to the relevant portions of the claim construction analysis. *See infra* nn. 6, 9, 11.

III. Law Governing Claim Construction

Patent infringement actions require the court to perform a two-step analysis. "First, the claims must be correctly construed to determine the scope of the claims. Second, the claims must be compared to the accused device." *CAE Screenplates Inc. v. Heinrich Fiedler GmbH & Co.*, 224 F.3d 1308, 1316 (Fed.Cir.2000) (quoting *Kahn v. General Motors Corp.*, 135 F.3d 1472, 1476 (Fed.Cir.1998)); *accord Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1247-48 (Fed.Cir.1998).FN3

FN3. Any appeal from the Court's judgment in this case lies exclusively in the United States Court of Appeals for the Federal Circuit. *See* 28 U.S.C. s. 1295(a)(1). Accordingly, in construing the claims this Court is controlled by the jurisprudence of the Federal Circuit as to those matters which relate to the Federal Circuit's exclusive jurisdiction. *See Kudlacek v. DBC, Inc.*, 115 F.Supp.2d 996, 1019 (N.D.Iowa 2000); *Sample v. United States*, 838 F.Supp. 373, 375 (N.D.Ill.1993) ("United States Court of Appeals, Federal Circuit, jurisprudence controls since the case would be appealed to the Federal Circuit."), *aff'd*, 65 F.3d 939 (Fed.Cir.1995).

In *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 116 S.Ct. 1384, 134 L.Ed.2d 577 (1996), the Supreme Court held that "the construction of a patent, including terms of art within its claims, is exclusively within the province of the court." *Id.* at 372. Much as with the case of statutory construction, "[c]laim construction starts with the language of the claim itself," *CAE Screenplates*, 224 F.3d at 1316, and "throughout the interpretation process the focus remains on the meaning of claim language." *Thermalloy, Inc. v. Aavid Eng'g, Inc.*, 121 F.3d 691, 693 (Fed.Cir.1997). The goal of the interpreting court is to arrive at what Justice Holmes called the "felt meaning" of the claim. *See United States v. Johnson*, 221 U.S. 488, 496, 31 S.Ct. 627, 55 L.Ed. 823 (1911)) (citations omitted) (footnote omitted). In interpreting the language of a claim, there is a "heavy presumption" that the terms "mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202 (Fed.Cir.2002). Further, "dictionaries, encyclopedias and treatises are particularly useful resources to assist the court in determining the ordinary and customary meanings of claim terms." *Id.*

In addition to the claim language, it is also appropriate to consider when necessary the "intrinsic evidence," that is, "the specification, and, if in evidence, the prosecution history." *Desper Prods., Inc. v. QSound Labs, Inc.*, 157 F.3d 1325, 1333 (Fed.Cir.1998); *accord Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582

(Fed.Cir.1996).FN4 The specification in particular is "highly relevant to the claim construction analysis," as it is "the single best guide to the meaning of a disputed term." Vitronics, 90 F.3d at 1582 Extrinsic evidence outside of the PTO record may be considered if necessary to understand the underlying art or the patent claims, "but may not be used to vary or contradict the otherwise unambiguous meaning of the claim." Desper Prods., 157 F.3d at 1333. "In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence." Vitronics, 90 F.3d at 1583.

FN4. The specification contain[s] a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and ... set[ting] forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. s. 112.

In addition to these basic principles, several other rules guide a court's construction of claim terms. First, "a construction that excludes a preferred embodiment 'is rarely, if ever, correct.'" C.R. Bard, Inc. v. United States Surgical Corp., 388 F.3d 858, 865 (Fed.Cir.2004) (quoting Vitronics, 90 F.3d at 1583). On the other hand, however, "a patent claim term is not limited merely because the embodiments in the specification all contain a particular feature." *Id.* Second, the consistency principle provides that "a claim term should be construed consistently with its appearance in other places in the same claim or in other claims of the same patent." Rexnord Corp. v. Laitram Corp., 274 F.3d 1336, 1342 (Fed.Cir.2001). The flip-side of this principle, the doctrine of claim differentiation, provides that "[w]here claims use different terms, those differences are presumed to reflect a difference in the scope of the claims." Forest Labs., Inc. v. Abbott Labs., 239 F.3d 1305, 1310 (Fed.Cir.2001). Finally, claim terms must be "construed without reference to the accused device." SRI Int'l v. Matsushita Elec. Corp. of Am., 775 F.2d 1107, 1118 (Fed.Cir.1985) (en banc); *see also*, Neomagic Corp. v. Trident Microsys., Inc., 287 F.3d 1062, 1074 (Fed.Cir.2002).

IV. Construction of the Claims FN5

FN5. Defendant has identified significantly more terms in need of construction than has plaintiff. For this reason, in the discussion that follows the Court has organized the terms in the order presented in defendant's claim construction brief.

As noted above, the patent contains two independent claims, Claims 1 and 18. Of the remaining claims, Claims 2-17 are dependent on Claim 1, and claims 19-20 are dependent on Claim 18. For this reason, the bulk of the disputed claim terms appear either in Claim 1 or Claim 18, and it is useful to set out the entire language of these claims before proceeding to the disputed terms. Claim 1 claims the following:

In a system for transferring digital data for storage in a computer storage medium, a method of screening the data as it is being transferred and automatically inhibiting the storage of screened data containing at least one predefined sequence, comprising the steps of:

causing a quantity of digital data resident on the source storage medium to be transferred to a computer system having a destination storage medium;

receiving and screening the transferred digital data prior to storage on the destination storage medium to determine if at least one of a plurality of predefined sequences are present in the digital data received; and

in response to said screening step:

(a) automatically causing the screened digital data to be stored on said destination storage medium if none of the plurality of predefined sequences are present, and

automatically inhibiting the screened digital data from being stored on said destination storage medium if at least one predefined sequence is present.

'776 patent, col. 17. Claim 18 claims:

A method of preventing the spread of computer viruses to a computer having a storage medium, comprising the steps of:

simultaneously searching for a plurality of virus signatures, each of which comprising an identifiable digital sequence, while said computer is receiving a stream of digital data for storage on said storage medium;

providing an indication of the detection of a virus from said searching step; and

automatically inhibiting the storage of said digital stream on said storage medium if any of said virus signatures have been detected.

'776 patent, col. 18.

A. "A Method of Screening the Data as It Is Being Transferred"

The parties first dispute the meaning of the phrase "a method of screening the data as it is being transferred" as used in the preamble of Claim 1 (and which, of necessity, constitutes part of dependent claims 2-17).

Defendant proposes that this term be construed as "a method of screening the data while it is being moved or copied and before the data is written to the computer storage medium." Joint Claim Construction Statement ("JCCS"), Appx. A, at 3 (term 8). Plaintiff proposes that the phrase be construed as "a method of screening the data prior to storage." *Id.* Preliminarily, however, plaintiff contends that this phrase is part of the claim preamble, and because the preamble ordinarily does not limit the claim it is not necessary to construe this term.

1. Whether the Phrase Needs to Be Construed

Plaintiff argues that the phrase "a method of screening the data as it is being transferred" is, as part of the preamble to Claim 1, not a limitation on the claimed invention. As plaintiff correctly notes, if the preamble is not limiting, " 'then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.' " *Schumer v. Laboratory Computer Sys., Inc.*, 308 F.3d 1304, 1310 (Fed.Cir.2002) (quoting *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1373-74 (Fed.Cir.2001)). Thus, the Court must first determine whether this language of the preamble has any limiting effect on the claimed invention.

In general, "a preamble is not limiting 'where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention.'" *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed.Cir.2002) (quoting *Rowe v. Dorr*, 112 F.3d 473, 478 (Fed.Cir.1997)); *see also*, *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed.Cir.1999). "No litmus test defines when a preamble limits claim scope." *Catalina Mktg.*, 289 F.3d at 808 (Fed.Cir.2002). Rather, "[w]hether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the invention described in the patent." *Storage Tech. Corp. v. Cisco Sys., Inc.*, 329 F.3d 823, 831 (Fed.Cir.2003); *see also*, *Poly-America, L.P. v. GSE Lining Tech., Inc.*, 383 F.3d 1303, 1309 (Fed.Cir.2004). Nevertheless, "[s]ome guideposts ... have emerged from various cases discussing the preamble's effect on claim scope." *Catalina Mktg.*, 289 F.3d at 808. These guideposts establish three general situations in which language in the preamble may have limiting effect.

First, "[w]hen limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." *Eaton Corp. v. Rockwell Int'l Corp.*, 323 F.3d 1332, 1339 (Fed.Cir.2003); *see also*, *Catalina Mktg.*, 289 F.3d at 808. Second, and relatedly, "a preamble generally limits the claimed invention if it 'recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.'" *NTP Inc. v. Research in Motion, Ltd.*, 392 F.3d 1336, 1358 (Fed.Cir.2004) (quoting *Catalina Mktg.*, 289 F.3d at 808); *see also*, *Poly-America, L.P.*, 383 F.3d at 1309. Finally, "because such reliance indicates use of the preamble to define, in part, the claimed invention," *Catalina Mktg.*, 289 F.3d at 808, preamble language is limiting if there is " 'clear reliance on the preamble during prosecution to distinguish the prior art.'" *Intirtool, Ltd. v. Texar Corp.*, 369 F.3d 1289, 1295 (Fed.Cir.2004) (quoting *Catalina Mktg.*, 289 F.3d at 808).

Defendant contends that the language at issue was added during patent prosecution in order to distinguish the claimed invention from the prior art. The Court agrees. As originally submitted, the preamble to Claim 1 read: "In a data transfer system for receiving a transmission of digital data for storage in a computer storage medium, a method of identifying and inhibiting the storage of data containing at least one predefined sequence, comprising:" Def.'s Claim Construction Br. ["Def.'s Br."], Ex. 4, Amendment filed 11/21/91, at 2. On November 21, 1991, in part to overcome the prior art, the inventors amended the preamble to read: "In a system for transferring digital data for storage in a computer storage medium, a method of inhibiting the storage of data containing at least one predefined sequence, comprising the steps of:" *Id.*; *see also, id.* at 6-7 (explaining reason for amendment). After the application was again rejected, the inventors amended the application once more, altering the preamble to read: "In a system for transferring digital data for storage in a computer storage medium, a method of *screening the data as it is being transferred* and automatically inhibiting the storage of screened data containing at least one predefined sequence, comprising the steps of:" Def.'s Br., Ex. 15, Amendment filed 8/26/92, at 1 (emphasis added).

Importantly, counsel for the inventors explained that this amendment was sufficient to overcome the prior art. Counsel explained that "the art relied upon does not teach or suggest a method or apparatus for *screening the data as it is being transferred (on the fly)*...." *Id.* at 5 (emphasis added). Thus, counsel indicated that the prior art was distinguishable because it did not "screen the data as it is being transferred," the precise language added to the preamble by the amendment. "This language shows a clear reliance by the patentee on the preamble to persuade the Patent Office that the claimed invention is not anticipated by the prior art. As such, the preamble is a limitation of the claims." *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1348 (Fed.Cir.2002); *see also*, *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 327 F.3d 1364, 1370 (Fed.Cir.2003); *Middleton, Inc. v. Minnesota Mining & Mfg. Co.*, No. 99-1201, 1999 WL 1072246, at (Fed.Cir. Nov.16, 1999). *See generally*, *Catalina Mktg.*, 289 F.3d at 808 ("[C]lear reliance on the preamble

during prosecution to distinguish the prior art transforms the preamble into a claim limitation because such reliance indicates use of the preamble to define, in part, the claimed invention.").

This conclusion is buttressed by the language of the specification. The specification notes that the problem with the then-existing technology was that it only allowed for scanning of files already on the destination storage medium, when the virus has already corrupted that medium. *See* '776 patent, col. 1, lns. 45-54. As stated by the specification, the invention disclosed constitutes an improvement over the prior art because it solves this problem "by performing an *in transit* detection of computer viruses," '776 patent, col. 1, ln. 56 (emphasis added), and notes that the invention "is able to test for viruses 'on the fly.'" '776 patent, col. 1, lns. 59-60. "The specification therefore indicates that the inventors believed their invention to be" a method for screening the data during transfer, as recited in the preamble to Claim 1. *Cruciferous Sprout Litig.*, 301 F.3d at 1347. Thus, "both the specification and the prosecution history indicate that the phrase ["a method of screening the data as it is being transferred"] helps to define the claimed invention and is, therefore, a limitation of Claim 1 [and the claims that are dependent upon Claim 1]." *Id.*

This conclusion is not altered by *Bristol-Myers Squibb Co. v. Immunex Corp.*, 86 F.Supp.2d 447 (D.N.J.2000), *aff'd in relevant part sub nom.* *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1373-74 (Fed.Cir.2001), upon which plaintiff relies. As plaintiff notes, the *Bristol-Myers* court noted that the fact "[t]hat the examiner insisted on including certain language ... does not automatically make the claims' preambles limitations." *Id.* at 451. However, as the Federal Circuit explained on appeal, in that case the language which was added to the preambles was not added for the purpose of distinguishing the prior art, and was added voluntarily by the patentee after the claim had already been allowed. *See* *Bristol-Myers*, 246 F.3d at 1375. In other words, the patentee did not rely on the preamble language during prosecution to distinguish the prior art. Here, as explained above, the patentees did just that, and under the cases discussed above this renders the language added to the preamble a limitation on the claim. Accordingly, the Court finds it necessary to construe the phrase "a method of screening the data as it is being transferred." FN6

FN6. Because the prosecution history and specification lead to this conclusion, the Court need not consider the effect of Mr. Schallop's deposition testimony and the additional argument based on that testimony in defendant's supplemental brief.

2. Construction of the Phrase

As noted above, defendant proposes that this term be construed as "a method of screening the data while it is being moved or copied and before the data is written to the computer storage medium." JCCS, Appx. A, at 3 (term 8). Plaintiff proposes that the phrase be construed as "a method of screening the data prior to storage." *Id.* The Court concludes that defendant's construction is correct.

Plaintiff's construction merely equates "prior to storage" with transfer. It may ultimately be, as plaintiff argues, that everything between sending and "storage" constitutes transfer, and thus the terms mean the same thing. This cannot be resolved, however, without independently construing each term. As used in Claim 1, the phrase "a method of screening data as it is being transferred" by its plain terms contemplates screening while the data is being moved or copied. This conclusion is buttressed by the specification and the prosecution history, both of which point up the method's ability to detect viruses "on the fly" as central to the merits of the claimed method. Whether this construction of the phrase adds any limitation which is not already encompassed by other terms in the claims need not be decided here. Accordingly, the Court

concludes that the phrase "a method of screening the data as it is being transferred" means "a method of screening the data while it is being moved or copied and before the data is stored FN7 to the computer storage medium."

FN7. The Court has substituted the word "stored" here in placed of "written" as set forth in defendant's proposed construction. This use of "written" assumes that the Court adopts defendant's definition of "storage," which is discussed below, *see infra* part IV.D.1. It is enough in construing this term to used the word "stored," with "stored" taking the further meaning discussed below.

B. "Causing a Quantity of Digital Data Resident on a Source Storage Medium to Be Transferred to a Computer System Having a Destination Storage Medium"

The parties next dispute the meaning of the phrase "causing a quantity of digital data resident on a source storage medium to be transferred to a computer system having a destination storage medium," which represents the first of the three steps of the method described in Claim 1. *See* '776 Patent, col. 17, lns. 14-16. The parties agree that the phrase "a quantity of digital data" means "an amount of digital data," and that the phrase "source storage medium" means a "computer storage medium that is the point of origin of the data being transferred." *See* JCCS, Appx. A, at 4 (terms 14-15). Within this phrase, the parties principally dispute the meaning of the terms "causing," "computer system," and "destination storage medium."

1. "Causing"

Defendant defines "causing" as used in Claim 1 as "effecting by command or request." JCCS, Appx. A, at 4 (term 13). Plaintiff defines "causing" as "effecting by command, authority, or force." *Id.* Plaintiff contends that defendant's proposed definition is truncated, and that an effect can be "caused" even if there is no explicit command or request. Defendant argues that plaintiff, through its proposed definition, is attempting to interpret "causing" so as to include actions by either the user of the software described in the patent or a computer other than the destination computer.

Defendant's concerns, in so far as claim construction is concerned, are misplaced. Neither proposed definition speaks to who or what is doing the "causing." Indeed, even under defendant's proposed definition a user or computer other than the destination computer may be able to "command" or "request" a certain result. Whether the limitations of the claims as a whole require the "causing" step to be initiated by the destination computer is simply not affected by either party's proposed construction of "causing." That being the case, defendant's proposed construction is adopted, as that construction is consistent with the ordinary definition of the term. *See* MERRIAM-WEBSTER ONLINE (available at [www.m-w.com/cgi-bin/dictionary?book=Dictionary & va=causing](http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=causing)); OXFORD ENGLISH DICTIONARY (2d ed.1989) (online edition available at www.dic tionary.oed.com/cgi/entry/50034905?query_ type=word & queryword=causing & first).

2. "Computer System"

The parties also dispute the meaning of the term "computer system." Plaintiff contends that the appropriate definition of this term is "any combination of hardware, software, documentation, and manual procedures that are combined to perform a specific function." JCCS, Appx. A, at 4 (term 17). Defendant contends that the appropriate definition is simply a "personal computer or workstation." *Id.* The Court adopts defendant's proposed construction of this term.

The specification clearly contemplates a "computer system" in accord with defendant's proposed definition. In setting forth the preferred embodiment, the specification describes a computer system as comprising a bus to which are connected a central processing unit, random access memory, a serial port, and a data storage medium (such as a hard disk)- *i.e.*, a single personal computer or computer workstation. *See* '776 Patent, col. 3, lns. 18-31. This constitutes the complete description of the computer system. Importantly, the specification describes data transmission occurring between two such systems through modems which, although attached to each computer system, are outside of the system. *See id.*, lns. 32-38.FN8 This construction also makes sense in light of the claim limitations, which discuss transfer of data to a computer system that has a destination storage medium- *i.e.*, a hard disk or similar storage device.

FN8. The specification's reference to the possibility that the modules described in the patent could be implemented directly in hardware, "as in the form of add on circuitry for a 'virus free' modem," '776 Patent, col. 10, lns. 26-27, does not alter this conclusion. Nothing in this brief sentence leads to the conclusion that a modem is itself a "computer system" as that term is used in the patent, and any such conclusion is belied by the explicit description of such a system earlier in the specification.

The extrinsic evidence also supports this construction. In his rebuttal report, plaintiff's expert Eugene Spafford states that the term "computer system" encompasses various systems other than a simple personal computer or workstation, including interconnected computer systems, channel processors, and distributed computer systems. *See* Pl.'s Br., Ex. 11, Decl. of Professor Eugene H. Spafford, Appx. 1, Rebuttal Expert Report of Professor Eugene H. Spafford, para. para. 18-21 [hereinafter "Spafford Rebuttal Report"]. In his deposition, however, Dr. Spafford testified that the specification's use of "computer system" referred to a single computer, *see* Def.'s Br., Ex. 12, Deposition of Eugene Spafford, at 68-69 [hereinafter "Spafford Dep."], and that a modem as referred to in the specification and as understood in 1990 would not be considered either part of a computer system or such a system in its own right, *see id.* at 69. He also conceded that the patent nowhere mentions the terms "channel processors," "interconnected computer systems," or "distributed computer systems," other types of systems which Spafford contends in his report are types of "computer systems" as used in the patent. *See id.* at 99-100. Further, Dr. Stephen Melvin, plaintiff's expert in the *Hilgraev* case, opined in his report on plaintiff's behalf in that case that

[t]he only type of system that is described in the '776 Patent is a personal machine.... Generally speaking, this class of computer systems is the only type that needs protection from viruses. There are other types of computer systems, such as unattended servers, that typically don't need this protection. They are used to simply relay information, they are not under the control of an ordinary user and they don't execute any software except pre-installed applications. There is no support to indicate that the patentees intended to cover these types of systems. Furthermore, there is no figure, and no teaching of how to apply the claims to an unattended server.

Def.'s Br., Ex. 13, Expert Report of Dr. Stephen W. Melvin in *Hilgraev Corp. v. Symantec Corp.*, at 8 [hereinafter "Melvin Expert Report"]. Dr. Melvin further notes that, as used in Claim 1, "[t]he computer system is a desktop personal computer or workstation[.]" *Id.*

Accordingly, the Court adopts defendant's proposed construction of the term "computer system."

3. "Destination Storage Medium"

The parties next disagree about the meaning of the term "destination storage medium." Plaintiff contends that the term means "a computer storage medium that is the intended endpoint of the transfer of digital data." JCCS, Appx. A, at 4 (term 18). Defendant counters that the term should be defined as "a computer storage medium that is the target of the transfer of data as a result of the causing step." *Id.*

The Court finds that defendant's proposed construction should prevail. As defendant correctly notes, construing destination storage medium as plaintiff does would permit the invention to operate outside of the computer system. For instance, the source storage medium could transfer the data to the computer, which would then transfer the data to a peripheral storage device such as a thumb drive. Under plaintiff's proposed construction, only the thumb drive would be the "destination storage medium," even though it is only connected to, but not part of, the computer system identified in the patent. Plaintiff's construction would allow two separate transfers of data to be collapsed into only one transfer, and for the destination storage medium to be located outside of the "computer system" identified in the patent. The language of the patent does not permit this interpretation. *See* '776 Patent, col. 3, lns. 38-44 ("It will further be assumed that the data to be transmitted is initially stored on storage medium 24a of system 12 and after transmission will also be stored on storage medium 24b of system 14. Thus, storage medium 24a may be considered the source storage medium while storage medium 24b may be considered the destination medium."); *id.*, col. 6, lns. 17-21 (emphasis added) ("In this regard, the local [computer] system 14 has the capacity for causing a transmission of digital data resident on the remote system 12 (e.g., hard disk storage medium) to be transmitted *to the local system*).

Accordingly, the Court adopts defendant's construction of this term.

4. The Phrase as a Whole

In light of the construction given the individual terms above, the complete phrase "causing a quantity of digital data resident on a source storage medium to be transferred to a computer system having a destination storage medium" means: "effecting by command, authority, or force, the transfer of digital data resident on a source storage medium to a personal computer or workstation having a computer storage medium which is the target of the transfer of data as a result of the 'causing' step."

C. "Receiving and Screening the Transferred Digital Data"

The parties next dispute the meaning of the phrase "receiving and screening the transferred digital data." Plaintiff contends that the phrase should be construed as "receiving and screening the digital data resulting from the transfer." JCCS, Appx. A, at 5 (term 21). Defendant contends that the phrase means "the computer system having a destination storage medium acquires and examines the digital data resulting from the transfer." *Id.*

Defendant correctly notes that plaintiff's proposed construction does not actually construe the language; it merely restates the phrase. Plaintiff nevertheless contends that the phrase is unambiguous, and that defendant's proposed construction improperly attempts to limit the claim by requiring the receiving and screening step to be performed by a single computer. As explained above, however, the Court has concluded that the term "computer system" as used in the patent means a personal computer or workstation. And the patent makes clear that it is in this "computer system having a destination storage medium" that the receiving and screening occurs. *See* '776 Patent, col. 4 lns.7-13. Thus, regardless of whether there is some other destination ultimately intended by the user, for purposes of the patent it is the computer system which

is doing the "receiving" and "screening." Accordingly, the Court adopts defendant's proposed construction of this phrase.

D. "In a System for Transferring Digital Data For Storage in a Computer Storage Medium"

1. "Storage"

The parties next dispute the meaning of the term "storage" as used throughout the patent. Plaintiff, relying on the Federal Circuit's construction of the term in *Hilgraeve II*, contends that "storage occurs when the incoming digital data is sufficiently present on the destination storage medium and accessible by the operating system or other programs so that any viruses contained in the data can spread and infect the computer system." JCCS, Appx. A, at 2 (term 5); *see also*, *Hilgraeve II*, 265 F.3d at 1342. Defendant contends that plaintiff's construction is too broad, and that storage consists only in "writing data to a computer storage medium for preservation and later use." JCCS, Appx. A, at 2 (term 5). Defendant also contends that this Court is not bound by the Federal Circuit's construction of the term in *Hilgraeve II*.

The Court concludes that the Federal Circuit's definition of "storage" in *Hilgraeve II* is binding on the Court as a matter of *stare decisis*. The doctrine of *stare decisis* generally requires that a court "abide by, or adhere to, decided cases." *Planned Parenthood of S.E. Pa. v. Casey*, 505 U.S. 833, 954, 112 S.Ct. 2791, 120 L.Ed.2d 674 (1992) (Rehnquist, C.J., concurring in part and dissenting in part) (internal quotation omitted). At a minimum, the doctrine " 'compels lower courts to follow the decisions of higher courts on a question of law.' " *Brewster v. County of Shasta*, 112 F.Supp.2d 1185, 1191 (E.D.Cal.2000), *aff'd*, 275 F.3d 803 (9th Cir.2001) (quoting 18 MOORE'S FEDERAL PRACTICE s. 134.01[1]). As noted above, questions of claim construction present issues of law. As such, the Federal Circuit's construction of a patent claim is accorded *stare decisis* effect, and binds lower courts in subsequent cases involving that patent. *See Phonometrics, Inc. v. Westin Hotel Co.*, 350 F.3d 1242, 1244 (Fed.Cir.2003); *Key Pharm. v. Hercon Labs. Corp.*, 161 F.3d 709, 716 (Fed.Cir.1998); *cf.* *Markman*, 517 U.S. at 391 (noting that treating claim construction as an issue of law will promote uniformity in the enforcement of patents through *stare decisis*).

Defendant offers several reasons why *stare decisis* does not apply here, none of which are persuasive. First, defendant argues that the Federal Circuit's construction of "storage" was clearly wrong, and relatedly that the Federal Circuit does not strictly apply *stare decisis*. In support of this second argument, defendant points to *CVI/Beta Ventures, Inc. v. Tura LP*, 112 F.3d 1146 (Fed.Cir.1997), in which the court declined to be bound by a construction given by an earlier panel of the Federal Circuit. *CVI/Beta Ventures*, however, will not bear the load defendant seeks to place on it. In the first place, the previous claim construction had been tentative, having occurred only in the context of determining a likelihood of success for purposes of a preliminary injunction. *See id.* at 1160 n. 7. Second, even assuming that *CVI/Beta Ventures* stands for the proposition for which it is cited by defendant, it is simply irrelevant here. It is true that there are a number of reasons why a court may decline to give *stare decisis* effect to its own prior decisions, among them that the prior decision was patently wrong. *See* 18 MOORE'S FEDERAL PRACTICE, *supra*, s. 134.06[1][b]. This does not mean, however, that a lower court is permitted correct wrongly decided higher court cases. On the contrary, a district court is obliged to follow binding precedent from the relevant court of appeals, and "[t]his obligation is not dependent upon the correctness of the Circuit's decision." *Brewster*, 112 F.Supp.2d at 1185. Thus, "[t]his court enjoys no discretion to disregard the authoritative pronouncements of a superior court, but must apply the law as written, even if it is wrong, foolish, or poorly written." *United States v. Real Property Located at Incline Village*, 958 F.Supp. 482, 491 (D.Nev.1997); *see also*, *Hutto v. Davis*, 454 U.S. 370, 375, 102 S.Ct. 703, 70 L.Ed.2d 556 (1982) (per curiam) ("[A] precedent of this Court must be followed by the lower federal courts no matter how misguided the judges of those courts may think it to be."); *United States*

ex rel. *Shore v. O'Leary*, 833 F.2d 663, 667 (7th Cir.1987) ("A lower court owes deference to those above it; ordinarily it has no authority to reject a doctrine developed by a higher court.").FN9

FN9. Because the wrongness of the Federal Circuit's decision is not a basis for this Court to decline to apply the construction adopted by the Federal Circuit, Mr. Schallop's testimony that the Federal Circuit's construction of the term "storage" does not accord with the ordinary meaning of the word is irrelevant, as is the argument based on this testimony in defendant's supplemental brief.

Second, defendant contends that it cannot be bound by the Federal Circuit's construction in *Hilgraeve II* on due process grounds, because it was not a party to that case. Defendant correctly notes that the Court so held in connection with its motion for a claim construction hearing. However, the issue addressed there is distinct from the issue addressed here.FN10 Due process concerns limit the effect of *res judicata* and collateral estoppel, doctrines which bind *parties* to decisions reached in previous cases involving those parties. *Stare decisis*, however, has nothing to do with parties; rather, "stare decisis is a doctrine that binds *courts* to follow their own earlier decisions or the decisions of a superior tribunal." National Org. of Veterans' Advocates, Inc. v. Secretary of Veterans Affairs, 260 F.3d 1365, 1373 (Fed.Cir.2001); *see also*, Bethesda Lutheran Homes & Servs., Inc. v. Born, 238 F.3d 853, 858 (7th Cir.2001) (discussing distinction between *res judicata* and *stare decisis*). Indeed, "[t]he existence of different parties is assumed by the doctrine, rather than being something that takes a case outside its reach." Bethesda Lutheran, 238 F.3d at 858. Thus, while defendant is not bound by the claim constructions from *Hilgraeve II*, this Court is so bound and must apply the claim constructions adopted there. *See* Veterans' Advocates, 260 F.3d at 1374 (noting that *stare decisis* "does not bind parties not to challenge those decisions, at least where the issues remain unresolved at the highest level," but that the court is nevertheless "bound to follow earlier decisions"); Wang Labs., Inc. v. Oki Elec. Indus. Co., Ltd., 15 F.Supp.2d 166, 176 (D.Mass.1998) (district court bound by Federal Circuit's claim construction in prior case even though party did not have opportunity to participate in the prior case). In short, defendant is free to argue to the Federal Circuit that its claim construction was wrong and should not be followed, or to petition the United States Supreme Court for a writ of *certiorari* on this question. This Court, however, must follow the rule of law established by the Federal Circuit until such time as it is overturned, regardless of how the Court would resolve the merits of the issue on its own.

FN10. For this reason, the Court's prior order does not, as defendant contends, constitute law of the case on the *stare decisis* issue.

Accordingly, the Court adopts the definition of "storage" adopted by the Federal Circuit in *Hilgraeve II*, to wit- " 'storage' occurs 'when the incoming digital data are sufficiently present on the destination storage medium and accessible by the operating system or other programs so that any viruses contained in the data can spread and infect the computer system.' " *Hilgraeve II*, 265 F.3d at 1342 (quoting *Hilgraeve I*, 224 F.3d at 1351).

2. "Computer Storage Medium"

The parties also dispute the meaning of the term "computer storage medium." In *Hilgraeve II*, the Federal Circuit construed this term in line with its construction of "storage," concluding that " 'storage medium' refers to any storage medium of the computer system, if the data, when stored on the medium, are accessible to the operating system or other programs, such that viruses in the data can spread and infect the computer

system." Hilgraeve II, 265 F.3d at 1342 n. 1 As with the definition of "storage," this construction of the term is binding on the Court, and is accordingly adopted.

E. "*Prior to Storage on the Destination Storage Medium*"

The parties next dispute the meaning of the phrase "prior to storage on the destination storage medium." The parties' proposed constructions are derivative of their constructions of "storage" and "storage medium." *See* JCCS, Appx. A, at 5 (term 22). In light of the above construction of those two terms, this phrase means "before the incoming digital data is sufficiently present on the destination storage medium and accessible by the operating system or other programs so that any viruses contained in the data can spread and infect the computer system."

F. "*Simultaneously Testing to Determine if at Least One of at Least Two Predefined Sequences Are Present in the Digital Data Received*"

In Claim 6, the patent claims "[t]he method of claim 1 wherein said screening step includes simultaneously testing to determine if at least one of at least two predefined sequences are present in the digital data received." '776 Patent, col. 17, lns. 42-45. The parties dispute the meaning of this claim.

1. "*Simultaneously Testing*"

Plaintiff contends that "simultaneously testing" means testing for at least two predefined sequences "at the same time." JCCS, Appx. A, at 9 (term 37). Defendant contends that simultaneous testing does not require testing for at least two predefined sequences at the same instant of time, but rather requires testing "in one pass over the digital data[.]" *Id.*

Plaintiff's construction of the phrase accords with the ordinary dictionary definition of "simultaneously." *See* OXFORD ENGLISH DICTIONARY (2d ed.1989) (online edition available at [www.dictionary.oed.com/cgi/entry/50225198?query_type=word & queryword=simultaneously](http://www.dictionary.oed.com/cgi/entry/50225198?query_type=word&queryword=simultaneously)); MERRIAM-WEBSTER ONLINE (online edition available at [www.m-w.com/cgi-bin/dictionary?book=Dictionary & va=simultaenously](http://www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=simultaenously)). Nothing in the specification indicates an intent by the patentee to adopt a different definition. Although the description of the preferred embodiment does indeed show a simultaneous testing in which it appears that only one pass over the digital data occurs, that same description also shows a testing protocol in which the various predefined sequences are tested at the same time. *See* '776 Patent, col. 4, lns. 59-64. Nothing in the specification or the claims indicates that the former aspect was meant to define the term "simultaenously." Further, despite its argument that plaintiff's construction would render the claims unworkable, defendant does not indicate why testing for multiple predefined sequences cannot be done at the same instant in time. Accordingly, the Court adopts plaintiff's proposed construction.

2. "*To Determine if at Least One of at Least Two Predefined Sequences Are Present*"

Plaintiff contends that, under this claim, the simultaneous testing must test "for the presence of at least two predefined sequences." JCCS, Appx. A, at 9 (term 37). Defendant contends that the phrase should be construed exactly as it is written, requiring testing only for at least one of multiple predefined sequences. *See id.* Defendant argues that plaintiff's construction implies that the search must *find* at least two predefined sequences, whereas the language of the claim requires only that the *search* encompass at least two predefined sequences.

It does not appear to the Court that there is any significant difference between the parties' constructions. Plaintiff's proposed construction requiring "testing for the presence of at least two predefined sequences" implies nothing about the results of that search. Nevertheless, the Court does agree with defendant that its proposed construction is more complete, as well as consistent with both the plain language of the claim and the specification. *See* '776 Patent, col. 4, lns. 59-64. Accordingly, the Court will adopt defendant's proposed construction.

G. "Telecommunications Link"

In Claim 14, the patent claims "[t]he method of claim 1 wherein said source storage medium is in the domain of a first central processing unit and the destination storage medium is in the domain of a second central processing unit." '776 Patent, col. 18, lns. 20-23. Claim 16, in turn, claims "[t]he method of claim 14 wherein said first and second central processing units communicate over a telecommunications link and wherein said digital data is sent over said link." *Id.*, lns. 29-32. The parties agree that a telecommunications link is a "line or channel for sending data." JCCS, Appx. A, at 14 (term 55). Defendant would leave the term at that, while plaintiff adds that the line or channel is for sending data "over a distance." *Id.*

Plaintiff is correct that the ordinary dictionary definition of "telecommunications" encompasses communication, usually through electronic or electric means, over long distances. *See* OXFORD ENGLISH DICTIONARY (2d ed.1989) (online edition available at dictionary.oed.com/cgi/entry/50248394?single=1&query_type=word&queryword=telecommunication); MERRIAM-WEBSTER ONLINE (online edition available at www.m-w.com/cgi-bin/dictionary?book=Dictionary&va=telecommunication). This makes sense in the ordinary course of everyday life: for instance, there is no need to use the telephone to talk to someone sitting in the same room as you; ordinary "communication" suffices. This common sense "over a distance" definition of telecommunications does not necessarily hold when referring to data transmission between individual computer systems. Indeed, other dictionaries, both lay and technical, refer to telecommunications as any data transmission, without any distance limitation. *See* COMPUTERUSER.COM HIGH TECH DICTIONARY (available online at compute.ruser.com/resources/dictionary/definition.html?look-up=7078) ("transmission of information over a communications line."); WEBOPEDIA (available online at www.pcwebopedia.com/TERM/T/telecommunications.html) (telecommunications "refers to all types of data transmission."); ENCARTA WORLD ENGLISH DICTIONARY (available online at encarta.msn.com/encnet/features/dictionary/DictionaryResults.aspx?refid=1861718821); CAMBRIDGE DICTIONARY OF AMERICAN ENGLISH (available online at dictionary.cambridge.org/define.asp?key=telecommunication*1+0&dict=A). Thus, the dictionary definition is of little help in determining how the term would have been understood by persons skilled in the art in 1990.

Nothing in claim 16 or the specification, however, suggests that there is some minimum distance requirement over which the transfer must occur. Further, the "over a distance" limitation is either meaningless or impermissibly vague. Either it really means over *any* distance, in which case it is meaningless because any transfer over a line or channel will involve some distance, no matter how slight, or it means over some minimum distance, in which case it is irreparably vague because there is nothing either within the patent or in common usage to indicate how far is far enough. *See* H C Prods. Co. v. Air Vent, Inc., 468 F.Supp. 750, 755 (C.D.Ill.1979) ("A court must construe a claim in such manner as will render the same not vague and indefinite."). Accordingly, the Court adopts defendant's proposed construction.

H. "Receiving and Substantially Simultaneously Processing the Second Quantity of Digital Data to Determine if at Least One of Said Predefined Sequences is Present in the Second Quantity of Digital"

Data

Claim 17 of the patent claims the method of Claim 1, further comprising two additional steps: first, causing a second quantity of digital data to be transferred, and second, "receiving and substantially simultaneously processing the second quantity of digital data to determine if at least one of said predefined sequences is present in the second quantity of digital data." '776 Patent, col. 18, lns. 40-43. The parties dispute the meaning of this second step. Plaintiff contends that the phrase means that "the second quantity of digital data is received and processed at substantially the same time as the first quantity of digital data (from claim 1) is received and screened." JCCS, Appx. A, at 15 (term 57). Defendant contends that this phrase means that "the computer system of claim 1 receives the second quantity of digital data and, at substantially the same time as the computer system is receiving the second quantity of digital data, the computer system examines the second quantity of data to determine if the data contains at least one predefined sequence." *Id.* In other words, plaintiff construes the term as requiring substantial simultaneity between the receipt and screening of the first quantity of data and the receipt and screening of the second quantity of data, while defendant construes the term as requiring substantial simultaneity between receipt of the second quantity of data and the screening of that data.

Defendant contends that plaintiff's construction is open-ended, and would allow plaintiff to argue that different computers can receive and process the two packets of data. Even if that argument were valid in the abstract, it has little weight here in light of the Court's construction of "computer system" as meaning a personal computer or workstation. Claim 17 is dependent upon Claim 1, and requires the second quantity of data to be transferred to "said computer system"- *i.e.*, to the same computer that receives and screens the first quantity of data. The specification does make clear that what is being taught in the patent is, as defendant argues, multiple data transfers to a single computer system. It also makes clear, however, that Claim 17 relates to simultaneous receipt and screening of overlapping data packets, not merely simultaneity between receipt and screening of one, subsequent quantity of data. *See* '776 Patent, col. 6, lns. 47-52 ("By use of an assignable MachineHandle, the invention is able to support separate simultaneous data transfers which may overlap in time. In other words, the system could be configured with multiple input ports, such as multiple serial ports, all receiving the data at the same time.").

In other words, both parties are partially correct. Defendant is correct that Claim 17 is properly construed as requiring that receipt and screening of the second quantity of data occur in the same computer system as the receipt and screening of the first quantity of data, and plaintiff is correct that simultaneity refers to overlap between the receipt and screening of the two quantities of data. Accordingly, the Court adopts its own construction of the phrase-to wit, the phrase means: "the computer system of claim 1 receives the second quantity of data and the second quantity of data is received and processed at substantially the same time as the first quantity of digital data is received and screened."

I. "A Method of Preventing the Spread of Computer Viruses to a Computer Having a Storage Medium"

Claim 18, the patent's second independent claim, claims "[a] method of preventing the spread of computer viruses to a computer having a storage medium, comprising" three steps. '776 Patent, col. 18, lns. 44-46. The parties dispute both whether this phrase, appearing in the preamble of Claim 18, requires construction at all and, if so, the meaning of the terms.

1. Whether the Phrase Needs to Be Construed

As noted above in connection with the language of the preamble to Claim 1, *see supra* part IV.A.1, the

language of a preamble generally does not have a limiting effect upon the claims. Preamble language is, as a general matter, limiting only in three situations: (1) "[w]hen limitations in the body of the claim rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention," Eaton Corp., 323 F.3d at 1339; (2) if the preamble " 'recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the claim.' " NTP Inc., 392 F.3d at 1358 (quoting Catalina Mktg., 289 F.3d at 808); and (3) if there is " 'clear reliance on the preamble during prosecution to distinguish the prior art.' " Intirtool Ltd., 369 F.3d at 1295 (quoting Catalina Mktg., 289 F.3d at 808).

Unlike with the preamble language of Claim 1, there is no indication that the preamble language of Claim 18 was relied upon by the patentee to distinguish the prior art. Nevertheless, defendant contends that the term "said computer" used in the body of Claim 18 (and necessarily in dependent Claims 19 and 20) finds its antecedent basis in the preamble's use of "computer." The Court agrees. The term "said computer" is meaningless without reference to the computer that has already been "said." "Given the fact that the body of the asserted claim refers to 'said [computer]' ..., it is clear that the phrase '[computer]' can take no other meaning than that explicitly stated in the preamble[.]" Derman v. PC Guardian, No. 95-1263, 1995 WL 746237, at (Fed.Cir. Dec.15, 1995); *see also*, Goldenberg v. Cytogen, Inc., 373 F.3d 1158, 1164 n. 2 (Fed.Cir.2004); Eaton Corp., 323 F.3d at 1339 ("When the body of the claim refers to ' *said* vehicle master clutch (8),' and ' *said* drive train,' it is referring back to the particular clutch and the particular drive train previously described in the preamble."). Accordingly, it is necessary to construe this preamble language.FN11

FN11. Because the language of the patent itself resolves this issue, the Court need not consider the effect of defendant's supplemental brief and the testimony of Mr. Schallop discussed therein.

2. Construction of the Phrase

The parties agree that the meaning of "computer virus" as used in Claim 18 is "malicious computer code, including but not limited to self-replicating code." JCCS, Appx. A, at 16 (term 59). The parties do dispute, however, the meaning of the terms "computer" and "storage medium," and thus the meaning of the phrase as a whole. Specifically, the parties treat "computer" as the equivalent of "computer system," and propose a construction of "computer" that is identical to each of their proposed constructions of "computer system." *Compare id.* (term 58), *with id.* at 4 (term 17). Likewise, both parties adopt a definition of "storage medium" as used in Claim 18 that is identical to the definition of that term as used in Claim 1. *Compare id.* at 16 (term 60), *with id.* at 1 (term 4).

It is generally understood that "if a claim term appears in more than one claim it should be construed the same in each." Dayco Prods., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1371 (Fed.Cir.2003); *see also*, CVI/Beta Ventures, Inc. v. Tura LP, 112 F.3d 1146, 1159 (Fed.Cir.1997). Accordingly, the Court adopts the constructions of "computer" and "storage medium" previously adopted in connection with the use of those terms in Claim 1. Thus, "computer" means "a personal computer or workstation, and "storage medium" means "any storage medium of the computer system, if the data, when stored on the medium, are accessible to the operating system or other programs, such that viruses in the data can spread and infect the computer system." This leads to the further conclusion that the phrase as a whole means "a method of preventing the spread of malicious computer code, including but not limited to self-replication code, to a personal computer or workstation having a 'storage medium', *i.e.*, having any storage medium such that the data, when stored on the medium, are accessible to the operating system or other programs such that viruses in

the data can spread and infect the computer system."

J. "*Simultaneously Searching for a Plurality of Virus Signatures ... While Said Computer Is Receiving a Stream of Digital Data for Storage on Said Storage Medium*"

The first of the three steps of Claim 18 consists of "simultaneously searching for a plurality of virus signatures, each of which comprising an identifiable digital sequence, while said computer is receiving a stream of data for storage on said storage medium." '776 Patent, col. 18, lns. 47-52.

1. "*Simultaneously Searching*"

The parties first dispute what the term "simultaneously searching" means. Plaintiff contends that this term means a search "for more than one virus signature at the same time[.]" JCCS, Appx. A, at 17 (term 66). Defendant contends that the phrase means searching a stream of "digital data, in one pass, for two [or] more recognizable arrangements of digital data which are indicative or characteristic of known viruses." Id.

There is no indication that "simultaneously searching" in Claim 18 has a different meaning from that phrase as employed in Claim 1. Thus, the phrase should be given the construction adopted earlier, *supra* part IV.F. 1. Accordingly, "simultaneously searching" in Claim 18 means searching "at the same time."

2. "*Simultaneously Searching ... While Said Computer is Receiving*"

The parties also dispute the import of the limitation that the simultaneous search occur "while said computer is receiving a stream of digital data." Plaintiff contends that this phrase does not require that the searching step be performed by the "computer having a storage medium" that is receiving the digital data. *See* JCCS, Appx. A, at 17 (term 66). Defendant contends that this phrase requires that the receiving and searching be performed on the same computer.

As has been discussed previously, the clear import of the patent claims is an "on-the-fly" screening of computer viruses on one computer. The claim language itself requires that the searching step be carried out while "said computer," *i.e.*, the computer that is the target of the transfer, is receiving the data. Accordingly, the Court concludes that this phrase means that "the computer having a storage medium is searching a stream of digital data."

3. "*Virus Signatures*"

The parties agree that a "virus signature" is "a sequence of digital data which is indicative or characteristic of a known virus." JCCS, Appx. A, at 17 (term 65).

4. "*Storage*" and "*Storage Medium*"

The parties dispute the meaning of these terms based on their constructions of these terms as used previously in the patent. These terms have the same meaning as used here that they do as used in the other patent claims.

5. *The Phrase as a Whole*

In light of the above individual definitions, the phrase as a whole means: "the computer having a storage

medium is searching a stream of digital data, at the same time, for two or more recognizable arrangements of digital data which are indicative or characteristic of known viruses."

K. "Providing an Indication of the Detection of a Virus from Said Searching Step"

Finally, the parties dispute the meaning of the phrase "providing an indication of the detection of a virus from said searching step," '776 Patent, col. 18, lns. 53-54, which comprises the second step of the method claimed in Claim 18. Defendant contends that this phrase means that "the computer provides an alert to the user if a virus has been detected during the searching step." JCCS, Appx. A, at 18 (term 69). Plaintiff counters that this step merely requires "indicating the detection of a virus, not necessarily to the user." *Id.* The Court adopts defendant's construction.

Plaintiff does not explain how the plain meaning of the word "indication" contemplates an alert to anything other than a human user; the alert is meaningless otherwise. Further, because it is the destination computer which on its own initiates the transfer of data under the terms of the patent claims, the only relevant user to be alerted is the user of the destination computer system on which the claimed invention is operating. The specification confirms this reading. *See* '776 Patent, col. 4, lns. 16-19 (emphasis added) ("If a virus signature is detected by the string search routine, *the user* is alerted at step 36, typically by an appropriate warning message displayed on the computer system monitor."); *id.*, col. 7, lns. 3-6 (emphasis added) ("The virus detection function *informs the user* that a virus has been detected and *gives the user* the option to cancel the transfer by setting the VirusDetectedFlag."). Accordingly, the Court adopts defendant's proposed construction of this phrase.

V. Order

In view of the foregoing, it is hereby ORDERED that, as used in the '776 patent:

- > the phrase "a method of screening the data as it is being transferred" means: "a method of screening the data while it is being moved or copied and before the data is stored on the computer storage medium."
- > the term "causing" means: "effecting by command, authority, or force."
- > the term "computer system" means: "a personal computer or workstation."
- > the term "destination storage medium" means: "the computer storage medium which is the target of the transfer of data as a result of the 'causing' step."
- > the phrase "causing a quantity of digital data resident on a source storage medium to be transferred to a computer system having a destination storage medium" means: "effecting by command, authority, or force, the transfer of digital data resident on a source storage medium to a personal computer or workstation having a computer storage medium which is the target of the transfer of data as a result of the 'causing' step."
- > the phrase "receiving and screening the transferred digital" means: "the computer system having a destination storage medium acquires and examines the digital data resulting from the transfer."
- > the term "storage" means: "the incoming digital data are sufficiently present on the destination storage medium and accessible by the operating system or other programs so that any viruses contained in the data

can spread and infect the computer system."

-> the term "computer storage medium" means: "any storage medium of the computer system, if the data, when stored on the medium, are accessible to the operating system or other programs, such that viruses in the data can spread and infect the computer system."

-> the phrase "prior to storage in the destination storage medium" means: "before the incoming digital data is sufficiently present on the destination storage medium and accessible by the operating system or other programs so that any viruses contained in the data can spread and infect the computer system."

-> the term "simultaneously testing" means: "testing for the presence of at least two predefined sequences at the same time."

-> the phrase "to determine if at least one of at least two predefined sequences are present" means: "to determine if at least one of at least two predefined sequences are present in the digital data received."

-> the phrase "simultaneously testing to determine if at least one of at least two predefined sequences are present" means: "testing, at the same time, to determine if at least one of at least two predefined sequences are present in the digital data received."

-> the term "telecommunications link" means: "a line or channel for sending data."

-> the phrase "receiving and simultaneously processing the second quantity of digital data to determine if at least one of said predefined sequences is present in the second quantity of digital data" means: "the computer system of claim 1 receives the second quantity of data and the second quantity of data is received and processed at substantially the same time as the first quantity of digital data is received and screened."

-> the phrase "a method of preventing the spread of computer viruses to a computer having a destination storage medium" means: "a method of preventing the spread of malicious computer code, including but not limited to self-replication code, to a personal computer or workstation having a 'storage medium', *i.e.*, having any storage medium such that the data, when stored on the medium, are accessible to the operating system or other programs such that viruses in the data can spread and infect the computer system."

-> the term "simultaneously searching" means: "searching for more than one virus signature at the same time."

-> the phrase "simultaneously searching ... while said computer is receiving" means: "the computer having a storage medium is searching a stream of digital data."

-> the term "virus signature" means: "a sequence of data which is indicative or characteristic of a known virus."

-> the phrase "simultaneously searching for a plurality of virus signatures ... while said computer is receiving a stream of digital data for storage in said storage medium" means: "the computer having a storage medium is searching a stream of digital data, at the same time, for two or more recognizable arrangements of digital data which are indicative or characteristic of known viruses."

-> the phrase "providing an indication of the detection of a virus from said searching step" means: "the computer provides an alert to the user if a virus has been detected during the searching step."

The attention of the parties is drawn to FED.R.CIV.P. 72(a), which provides a period of ten days from the date of this Order within which to file any written appeal to the District Judge as may be permissible under 28 U.S.C. s. 636(b)(1).

IT IS SO ORDERED.

E.D.Mich.,2005.

Symantec Corp. v. Computer Associates Intern., Inc.

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